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**Adams & Adams  
Practical Guide to  
Intellectual Property in Africa**

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## ***Adams & Adams Practical Guide to Intellectual Property in Africa***

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# **Adams & Adams Practical Guide to Intellectual Property in Africa**

**Compiled and authored by  
Adams & Adams 2012**

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# Preface

The compilation of a comprehensive guide to Intellectual Property Laws and Procedures in Africa has long been a goal for academics and practitioners alike. Over the years this encouraged Adams & Adams to produce handbooks on aspects of the intellectual property laws and procedures in Africa, on a fairly limited scale. However, the rapid development on both the economic and legislative fronts in Africa over the past 10 years prompted us to consider a more detailed publication. This has now been made possible through generous funding by the World Bank, facilitated by the University of Pretoria through the Faculty of Law and the Pretoria University Legal Press.

Some 12 years ago, The Economist Magazine labelled Africa 'the hopeless continent' but rather than shrivel, the continent has experienced one of the fastest economic growth rates in the world. In a recent World Bank report, it was estimated that Foreign Direct Investment in Africa will reach US \$150 billion in 2012, up from US \$84 billion in 2010. Investors are taking a long term view of the prospects in Africa and investing heavily in infrastructure projects on the continent.

Africa is vast, covering in excess of 30 million square kilometres which would accommodate India, USA, Argentina, China and Western Europe including the British Isles. Africa has the world's fastest growing population which is likely to top 1 billion within the next five years and can provide a significant share of the world's future workers. By contrast, in many countries there has been a decline in people of a working age. A number of African countries are urbanising at a rapid rate which is creating significant demand for infrastructure, goods and services. The continent is rapidly emerging as a market driven by commodity and oil prices, stable macro-economic environments, investments from large emerging markets as well as rising internal consumer spending. In addition to the size of the continent, Africa has a large percentage of available arable land and has the potential to develop agricultural resources. The Economist Magazine has forecast that the bulk of the top 10 fastest growing economies in the world over the next five years will emerge from Africa.

Challenges undoubtedly still remain, particularly on the political front. Nevertheless, with a few notable exceptions, most African economies have recorded solid improvements across all the economic, political and social indicators. Developing local laws, protecting the environment, respecting human rights and supporting local entrepreneurs will be central to the continued growth of business in Africa. Crucial to economic development

and investment is a need for African countries to make significant improvements on the legislative front to bring themselves in line with developing and developed nations. Failure to develop local legislation has a profound effect on the prospects of sustained investment. In particular on the intellectual property front, there have been significant improvements in many African territories and thus we believe that it was opportune to highlight the various African Intellectual Property Laws in a consolidated compendium for a better understanding of what is required in order to protect intellectual property rights in Africa.

Despite the legislative developments in most African territories, there are still difficulties in accessing detailed information relating to intellectual property in Africa, which is often as a result of antiquated laws, systems and procedures in some countries and territories. Accordingly, the accuracy of the information in the manual is subject to the constraints of current laws and procedures. In those instances where laws and procedures are possibly incomplete and/or antiquated, our comments are based on practical experience gathered over many years of working in Africa.

Adams & Adams is spending significant time and effort in developing IP law in Africa by assisting Ministries and Registries throughout Africa in developing their laws and procedures, and at the same time working closely with African lawyers throughout the continent. In addition to handling IP cases on a regular basis in all 54 African countries and territories, we have established associated offices in a number of countries and in the two regional IP organisations, ARIPO and OAPI. Plans to establish further associated offices in East, Central and West Africa are at an advanced stage.

We believe and hope that this book will assist in understanding how the various IP laws in Africa operate and afford intellectual property owners the opportunity of successfully protecting their rights.

As with other projects like this one, I was proud to observe the dedication and thoroughness which our partners and colleagues put into the production of the book. It was no easy task to obtain, translate, collate and compile the IP laws of 54 different countries and territories.

Once again, all this occurred under the eagle eye of our Editor and Senior Consultant, Prof Esmé du Plessis. She kept matters under tight control and did a vast amount of writing, correcting and conforming of the drafts. We at Adams & Adams thank the entire team for their hard work and commitment and for putting our name to such a work.

My own belief is that their efforts have resulted in a unique publication which will be used by many who are looking at the opportunities for investment in Africa. Perhaps our colleagues' efforts will contribute in some way to the development of the continent for the benefit of all. We hope so.

Dario Tanziani  
Chairman  
Adams & Adams  
April 2012

# Acknowledgement

Africa is a vast continent, providing a solid substratum for fifty independent continental states and a safe haven for a further five or more independent surrounding island states – each state with its own legal regime, its own often subtle legal peculiarities, also in the area of intellectual property law. This reality came through to me, and the team of Adams & Adams authors, again when we worked on this book on IP in Africa. Although there is a measure of harmonisation of intellectual property laws, remnants on the one hand of earlier colonial occupation and, on the other, through the efforts and initiatives of international organisations such as the World Intellectual Property Organisation (WIPO) and the World Trade Organisation (WTO), many divergences and dissimilarities are present, based on differences in the legal regimes.

The different jurisdictions also have a diversity of indigenous and/or European official languages; this complicated the task.

As Dario Tanziani, the Chairman of Adams & Adams has indicated in the Preface, the firm has over many years made efforts to gather information on the laws and procedures applicable in all of these jurisdictions, mainly for its own reference purposes. This information was in fact compiled into practice manuals which were made available to its professional staff and also to clients and colleagues in Africa and elsewhere. These manuals contained concise summaries of the information. The vision of a more detailed collection and presentation of the laws and procedures remained, not only for our own internal use but for dissemination to persons in, or with an interest in, Africa who require this information. Such an initiative proved to be perfectly in line with similar initiatives of the Faculty of Law of the University of Pretoria, and with certain funding opportunities made available by the World Bank to the University to promote the collection and dissemination of information about the laws of Africa to the people of Africa and to people of other countries with an interest in Africa. We sincerely appreciate the recommendation by the former and the current Deans of the Law Faculty that our project could become part of the other projects of the Faculty in this regard.

This book is the outcome of all of that. We are honoured and grateful that Adams & Adams could in this manner realise its own vision but could also become part of this meritorious initiative.



As our Chairman also indicated, this proved to be an enormous, but at the same time a very rewarding, task. I wish to record my sincere appreciation to the partners of Adams & Adams for entrusting to me the responsibility of overseeing this project.

Not only have I learnt so much about the diversity and complexity of the laws of Africa, but I had the privilege of working with a team of highly qualified and experienced practitioners, all with specific experience in the law and practice in Africa. The team was assisted by a group of young professionals within the firm; although their names cannot all be mentioned, our appreciation for the work and research done by them is recorded. Also, again, a special word of appreciation to Teresa of Adams & Adams for her relentless efforts to render the material into a consistent and accessible format, and for accumulating all of the relevant membership and other information on the international instruments. To Danie and Lizette of the Pretoria University Law Press, a sincere thank you for your patience and support.

Esmé du Plessis  
Managing Editor  
Senior Consultant: Adams & Adams  
April 2012

# Glossary of acronyms and abbreviations

ARIPO	African Regional Intellectual Property Organisation (1976)
Bangui Agreement	Bangui Agreement Relating to the Creation of an African Intellectual Property Organisation, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (1977)
Banjul Protocol	Banjul Protocol on Marks (1993)
Berne Convention	Berne Convention for the Protection of Literary and Artistic Works (1886)
Brussels Convention	Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (1974)
Budapest Treaty	Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (1977)
Geneva Convention	Geneva Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of their Phonograms (1971)
Hague Agreement	Hague Agreement Concerning the International Registration of Industrial Designs (1925)
Harare Protocol	Harare Protocol on Patents and Designs (1982) of ARIPO
IPIC	Treaty on Intellectual Property in Respect of Integrated Circuits (1989)
Lisbon Agreement	Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958)
Locarno Agreement	Locarno Agreement Establishing an International Classification for Industrial Designs (1968)
Lusaka Agreement	Lusaka Agreement on the Creation of the African Regional Industrial Property Organisation (1976)
Madrid Agreement	Madrid Agreement Concerning the International Registration of Marks (1891)

Madrid Protocol	Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989)
Nairobi Treaty	Nairobi Treaty on the Protection of the Olympic Symbol (1981)
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)
OAMPI	African and Malagasy Patent Rights Authority (1962)
OAPI	Organisation Africaine de la Propriété Intellectuelle (African Intellectual Property Organisation) (1977)
Paris Convention	Paris Convention for the Protection of Industrial Property (1883)
PCT	Patent Cooperation Treaty (1970)
Phonograms Convention	Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of Their Phonograms (1971)
PLT	Patent Law Treaty (2000)
Rome Convention	Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (1961)
Singapore Treaty	Singapore Treaty on the Law of Trade Marks (2006)
Strasbourg Agreement	Strasbourg Agreement Concerning the International Patent Classification (1971)
TLT	Trade Mark Law Treaty (1994)
TRIPS	Agreement on Trade-Related aspects of Intellectual Property Rights (1995)
UPOV Convention	International Convention for the Protection of New Varieties of Plants (1961)
Vienna Agreement	Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973)
WCT	WIPO Copyright Treaty (1996)
WIPO Convention	Convention Establishing the World Intellectual Property Organisation (1967)
WPPT	WIPO Performances and Phonograms Treaty (1996)
WTO Agreement	Agreement Establishing the World Trade Organisation (1994)

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# AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANISATION (ARIPO)



## GENERAL INFORMATION

ARIPO was established in 1976 in Lusaka, Zambia through the joint efforts of the UN Economic Commission for Africa (UNECA) and the World Intellectual Property Organisation (WIPO), when the Agreement on the Creation of an African Regional Industrial Property Organisation (ARIPO) was concluded by a group of 15 founding states. The ARIPO Agreement came into force in 1978. ARIPO was initially open to English-speaking countries of Africa, but the membership provisions have since been amended to be open to members of the UN Economic Commission for Africa or the African Union.

**Note:** The title of the organisation was subsequently amended to the African Regional Intellectual Property Organisation.

The current membership is 18 countries:

Botswana (since 1985)	Malawi (since 1978)	Sudan (since 1978)
Gambia (since 1988)	Mozambique (since 2000)	Swaziland (since 1987)
Ghana (since 1978)	Namibia (since 2003)	Tanzania (since 1983)
Kenya (since 1978)	Rwanda (since 2011)	Uganda (since 1978)
Lesotho (since 1987)	Sierra Leone (since 1980)	Zambia (since 1978)
Liberia (since 2009)	Somalia (since 1981)	Zimbabwe (1980)

The headquarters and administrative offices of ARIPO are located in Harare, Zimbabwe.

ARIPO has adopted two Protocols, the Harare Protocol on Patents and Industrial Designs (the Harare Protocol) and the Banjul Protocol on Marks (the Banjul Protocol). Although both of these Protocols provide for the filing of a single application to cover one or more member states designated in the application, a registration which results from such an application does not constitute a regional registration; its effect is that of a national registration in each designated country.

This means that the member countries of ARIPO have retained their national laws on patents, industrial designs and trade marks. As will be shown below, these national laws are applied to determine the registrability, enforcement and other administrative aspects of the relevant right. In this regard, the legal structure of ARIPO differs from that of OAPI, the other African regional organisation (see the chapter on **Organisation Africaine de la Propriété Intellectuelle (OAPI)** below).

Furthermore, unlike the position under OAPI, ARIPO does not provide for copyright protection, nor (at this stage) for plant breeders' rights.

### **International/regional conventions**

ARIPO as a regional organisation is recognised by international organisations of international conventions; however, at present individual ARIPO member states are the members of the various conventions and agreements. For example, ARIPO countries are members of the following international/regional conventions:

- Berne Convention (all countries are members except Mozambique, Sierra Leone, Somalia and Uganda)
- Brussels Convention on Programme-carrying Signals (only Kenya and Rwanda)
- Budapest Treaty (only Botswana is a member)
- Hague Agreement on Designs (only Ghana, Namibia and Rwanda are members)
- Locarno Agreement on Classification of Designs (only Malawi is a member)
- Madrid Agreement on Marks (Kenya, Lesotho, Liberia, Mozambique, Namibia, Sierra Leone, Sudan, Swaziland are members)
- Madrid Protocol on Marks (11 countries are members; Gambia, Malawi, Rwanda, Somalia, Tanzania, Uganda and Zimbabwe are not yet members)
- Nairobi Treaty on Olympic Symbol (only Kenya and Uganda are members)
- Nice Agreement on Classification of Marks (only Tanzania is a member)
- Paris Convention (all countries except Somalia)
- Patent Cooperation Treaty (all countries except Somalia)
- Phonograms Convention (only Kenya is a member)
- Rome Convention (only Lesotho and Liberia are members)
- Strasbourg Agreement on Patent Classification (only Malawi is a member)
- WIPO Convention (all countries are members)
- WIPO Copyright Treaty (only Botswana and Ghana are members)
- WIPO Performances and Phonograms Treaty (only Botswana is a member)
- WTO/TRIPS (all countries are members except Liberia, Somalia and Sudan).

## **TRADE MARKS**

### **Law**

The Banjul Protocol on Marks was adopted in 1993 in Banjul, Gambia and came into force on 6 March 1997. The Protocol is open to all member countries of ARIPO. The Regulations to implement the Protocol were adopted in November 1999.

The current membership of the Banjul Protocol is 9 countries:

- |                        |                        |                         |
|------------------------|------------------------|-------------------------|
| Botswana (since 1985)  | * Malawi (since 1997)  | * Tanzania (since 1999) |
| * Lesotho (since 1985) | * Namibia (since 2004) | * Uganda (since 2000)   |
| Liberia (since 2010)   | * Swaziland (1997)     | Zimbabwe (since 1997)   |

The Banjul Protocol provides for the filing of a single trade mark application, filed either at the ARIPO office, located in Harare, Zimbabwe or at the industrial property office of a member state, to have effect in those member states designated in the application.



\* **Note:** Not all signatories of the Banjul Protocol have incorporated the provisions of the Protocol into their national laws. Those countries marked with \* in the list above have not yet implemented the Banjul Protocol by way of national laws. As such there is doubt as regards the validity in those countries of trade marks registered under the ARIPO system.

### **Trade mark protection**

Once a mark has been registered under the Banjul Protocol, it is protected in each designated state as if the mark had been filed and registered in such state, unless a state has indicated that the registration shall have no effect in that particular state. If the ARIPO office notifies the designated states that an application complies with all formal requirements, a designated state may, before the expiration of 12 months from the date of the notification from the ARIPO office, make a written communication to the ARIPO office to the effect that the registration of the mark will have no effect within its territory (see the section on **Examination/procedure** below).

### **Protection of well-known marks**

No express reference is made to well-known marks.

### **Advantages of trade mark registration**

The registration of a trade mark under the Banjul Protocol has the effect of a national registration in each designated member state unless the Registrar in a member state has indicated, within the stipulated period, that the mark cannot be registered (see the section on **Examination/procedure** below).

### **Types of trade marks**

Provision is made in the Protocol for trade marks in respect of goods and services. No express provision is made for certification or collective marks. Since a trade mark registration has effect in each designated member state as if the mark had been registered in that state, it is possible that provision may be made in some national laws for certification and/or collective trade marks.

### **Definition of a mark**

Although the concept of a 'mark' is not defined, the Protocol mentions that marks could be applied to goods and services, and that colour or shape may constitute a distinctive feature of a mark. In the Regulations issued under the Protocol, reference is made to a mark consisting of letters, words, numerals or punctuation signs, or having special graphic features or other two-dimensional features, or to a mark in three-dimensional form.

The intention appears to be that the national laws of the member countries will determine the definition of a mark and/or a trade mark.

### **Classification**

The International Classification of Goods and Services under the Nice Agreement applies. According to the Regulations issued under the Protocol, goods and/or services belonging to several classes may be included in one and the same application. However, any designated state may declare that

in such a case, the application shall result in two or more registrations. At present, only Botswana, Lesotho, Liberia and Swaziland allow multiple-class registrations.

An ARIPO registration in respect of services will not be enforceable in member states the national laws of which do not make provision for the protection of service marks; at present only Malawi does not recognise service marks.

### **Convention priority**

An applicant of an application under the Banjul Protocol may claim a priority right under the Paris Convention on the basis of an earlier application filed in a convention country not more than six months prior to the ARIPO application.

### **Application**

An application under the Protocol may be filed directly with ARIPO at its Secretariat (referred to as the 'office'), or at the industrial property office of a contracting state. An applicant whose principal place of business is not in the host country (ie Zimbabwe) in the case of a filing at the ARIPO office, or in the relevant country in the case of a filing with the office of a contracting state, must be represented by a patent or trade mark agent or a legal practitioner in such country.

Where an application is filed in a contracting state, the industrial property office of that state must transmit the application to the ARIPO office without delay.

### **Requirements for application**

The following documents and information are required for an application:

- full particulars of the applicant
- power of attorney (simply signed)
- prints of the trade mark (device marks)
- list of the goods and/or services
- contracting states to be designated
- certified copy of the priority document (if priority is claimed).

### **Examination/procedure**

The application may be filed directly with the ARIPO office or with the trade mark office of a member state. The applicant must designate those states in which protection is required. The office where the application is lodged will examine the application as to formal requirements. If formalities are complied with, a filing date is accorded. If the application was filed in a contracting state, the office of such state must transmit the application to the ARIPO office without delay.

The ARIPO office notifies the trade marks office of each designated state of the filing, which office must examine the application in accordance with its national laws. A national office has 12 months to inform the ARIPO office

that the registration will have no effect in its territory. The basis for such a rejection is that the application does not conform to national formalities, or that the mark cannot be registered due to its nature, ie does not comply with substantive requirements. If designated states do not communicate such objections within the 12 months period, the ARIPO office will accept the application and publish a notice of acceptance in the ARIPO Journal. In the absence of opposition (see the section on **Opposition** below), the ARIPO office will confirm the registration, whereupon the registration will have effect in the designated states.

If the ARIPO office refuses an application, the applicant has the option of requesting, within three months of the date of receipt of the refusal, that the application be treated as a national application in any designated state.

### **Opposition**

The Protocol does not provide for oppositions to ARIPO trade mark applications. The Regulations provide that the conditions for the filing and registration of marks will be determined in contracting states by their domestic legislation. Opposition proceedings are therefore conducted in terms of the national laws of the relevant member country. It is relevant to note that the Protocol provides for the publication of a trade mark in the official ARIPO Journal to occur three times: the first publication occurs after filing the trade mark application, the second after acceptance and, finally, the third after registration.

The practical effect of this is that, in the period between the publication for the purposes of acceptance and the publication for the purposes of registration, an opposition period occurs. As the Protocol does not provide for an opposition term, the term is determined by the period between the two publications. Effectively, this means that, in the period before the publication for registration purposes occurs, a notice of opposition, setting out the grounds upon which the opposition is based, based on the national legislation in each of the relevant designated states, must be filed in each designated state, and at the ARIPO office. The ARIPO Registrar is usually the only Registrar who will make a ruling, as many of the designated member states have no enabling legislation. At best, if an opponent is successful, the ARIPO Registrar will refuse the national Zimbabwe application (where the ARIPO office is located).

### **Duration and renewal**

A trade mark registration shall be for a period of 10 years from the date of registration and may be renewed for like periods. The renewal is effected at the ARIPO office; a grace period of six months is provided for the late payment (with a surcharge) of a renewal fee.

### **Use requirement and cancellation**

The Protocol does not specify any use requirements for a registered trade mark, nor does it provide for cancellation of a trade mark registration on the ground of non-use. Accordingly, cancellation of a registration, based on

the ground of non-use or any other ground, is dealt with in terms of the national laws of the member states.

### **Cancellation/removal of a trade mark**

Cancellation of an ARIPO registration is dealt with in terms of the national laws of the member states. The member state must inform the ARIPO office of the cancellation, which then publishes this fact in the Journal and records it in the Register.

### **Assignments**

Assignments are dealt with in terms of the requirements under the national laws of the member states. The Regulations provide for assignments, licences and other similar rights to be registered against a trade mark registration by the national office of a member state; the ARIPO office must be notified of any such registration and provided with full particulars. The ARIPO office may register assignments, licences and other similar rights in respect of designated states the national laws of which do not provide therefor.

### **Licensing/registered users**

The recognition and recording of licences is dealt with in terms of the national laws of the member states. The Regulations recognise that the national laws of a designated state may provide for the registration of assignments, licences and similar rights (eg registered users), and provide that, when such a right is recorded, the relevant contracting state must promptly inform the ARIPO office. The ARIPO office may register licences or other similar rights in respect of designated states the national laws of which do not provide for such registrations.

### **Amendments**

The Protocol itself makes no express provision for the amendment of trade mark registrations. The Regulations provide for the recording of any alteration to registered marks, such as the extension or cancellation of goods or services, changes in the name or address for service of the owner. There is no express reference to alterations to the mark itself.

### **Rights conferred by registration**

The Protocol merely states that, upon registration, a mark shall be protected in each designated state as if the mark had been registered in that state. This means that national laws will apply.

### **Infringement**

The Protocol does not deal with the enforcement and/or the infringement of a registered trade mark. Accordingly, infringement and the proceedings for infringement are dealt with in accordance with the national laws of the member state in which the infringement takes place.

### **Marking of goods**

The Protocol does not provide for the marking of goods. The domestic laws of the contracting states will apply.

## PATENTS

### Law

The Protocol on Patents and Industrial Designs (the Harare Protocol) was adopted in 1982 in Harare, Zimbabwe and entered into force on 25 April 1984. Subsequent amendments were effected in 1987 and 1994. The Protocol is open to all member countries of ARIPO. The Regulations to implement the Protocol were adopted in 1984 and amended in 1994.

The current membership of the Harare Protocol is 17 countries:

Botswana (since 1985)	* Malawi (since 1984)	* Swaziland (since 1988)
Gambia (since 1986)	Mozambique (since 2000)	* Tanzania (since 1999)
Ghana (since 1984)	* Namibia (since 2004)	Uganda (since 1984)
Kenya (since 1984)	* Rwanda (since 2011)	Zambia (since 1986)
Lesotho (since 1987)	* Sierra Leone (since 1999)	Zimbabwe (since 1984)
Liberia (since 2010)		

The Harare Protocol provides for the filing of a single patent application, and the filing of a single design application, to have effect in those member states which are designated in the application. Once granted, the registration of the patent (or design) will have the same effect as a national registration in those member states designated in the application.

\* **Note:** Not all signatories of the Harare Protocol have incorporated the provisions of the Protocol into their national laws. Those countries marked \* in the list above have not yet implemented the Protocol in their national laws. As such, there is doubt regarding the validity in those countries of patents granted under the ARIPO system.

### Patent protection

A patent application is filed either with the industrial property office of a contracting state, or at the ARIPO office in Harare. The application must designate the contracting states in which the patent is sought. When a patent is granted, it extends automatically to those member countries that have been designated in the application, unless a designated country has made a written communication to the ARIPO office that the patent will have no effect in that country (see the sections on **Application** and **Examination/procedure** below). The granted patent is then subject to the respective national laws.

### Types of patents

The Harare protocol provides for:

- conventional patents, where a patent is granted for an invention
- divisional patents, where an application which covers more than one invention is divided into two or more separate applications
- utility model certificates, where an implement of work entails a new configuration or component.

### **Patentable subject matter**

In terms of the Protocol, inventions that are new, involve an inventive step, and are industrially applicable, are patentable. Inventions that are not novel are not patentable.

The Harare Protocol is silent on other criteria for patentability. While examination is conducted centrally at the ARIPO office rather than in the individual states, the national laws of each member state dictate what is not patentable. For example, methods of treatment are not patentable in many ARIPO member states. As such, method of treatment claims must be amended into acceptable form, otherwise they will routinely be rejected.

In the event of a rejection, provision is made for an appeal to the Board of Appeal, whose decision is final. It is also possible to convert an ARIPO application to a national application in selected designated member states, should a rejection be received.

Accordingly, applications for inventions that, for reasons based on domestic law, are not patentable in a particular designated state where protection is sought will be rejected in that state. Such a state has to issue a written communication to that effect to the ARIPO office within a specified period, ie six months after the issuance by the ARIPO office of the notice of acceptance (see the sections on **Application** and **Examination/procedure** below).

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date is the priority date of the first-filed application under the Paris Convention
- a regional phase application based on an international application under PCT designating ARIPO or an ARIPO member state
- a divisional application, where the original application covers more than one invention
- an application for utility model, which may be converted to a patent application.

### **Application**

An application for a patent in terms of the Protocol is filed with the industrial property office of a contracting state or at the ARIPO office in Harare by the applicant or the authorised representative of the applicant. An applicant may be represented by an attorney, an agent or a legal practitioner who has the right to represent applicants before the industrial property office of that state. Where the applicant's residence or principal place of business is outside that country, he must be so represented.

Upon receipt of an application by a contracting state, the industrial property office must, within a period of one month after the filing of the application, transmit the application to the ARIPO office.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (prescribed form; simply signed)
- specification (including claims, drawings and abstract), in English
- indication of the contracting states to be designed
- assignment document (if the applicant is not the inventor)
- certified copy of the priority document (if priority is claimed).

All documents must be in English. However, it is possible to obtain a filing date in ARIPO with a specification, claims and drawings in a foreign language provided the English translation is filed without delay.

### **PCT applications**

The Harare Protocol makes specific provision for PCT applications. An international PCT application which designates ARIPO and those ARIPO countries which are also members of PCT, is considered to be an application for a patent under the Protocol.

The Protocol expressly provides that the ARIPO office may act as receiving office for purposes of PCT; and it must act as the designated office in respect of a PCT application designating an ARIPO state. It must also act as the elected office where a contracting state is elected for purposes of international preliminary examination.

### **Novelty**

An invention is new if it is not anticipated by prior art. Everything made available to the public anywhere in the world by means of written disclosure (including drawings and illustrations) or by use or exhibition, is considered prior art, if it was so made available before the filing date of the ARIPO application or the priority date. A grace period of six months is provided prior to the filing date or priority date, for disclosure of the invention at an official or officially recognised exhibition without affecting the novelty.

### **Certain prior knowledge excused**

As indicated above, prior knowledge derived from a disclosure at an officially recognised exhibition within six months prior to the filing or priority date will not be taken into account.

### **Inventiveness**

The Protocol does not define inventiveness.

### **Convention priority**

Since the member countries of the Harare Protocol are also members of the Paris Convention, priority rights in terms of the Paris Convention may be claimed.

### **Examination/procedure**

The ARIPO office first examines the application in regard to formal requirements. In the case of compliance, a filing date is accorded and the designated states are notified.

The ARIPO office then undertakes, or arranges for, the substantive examination of the application. The applicant may, and must at the request of the ARIPO office, lodge particulars and copies of search and examination reports issued on any corresponding application in another country, to facilitate the examination.

If the ARIPO office, on the basis of the examination, decides to grant the patent, an acceptance notice is issued and the applicant and the office of each designated state are notified. A designated state may, within six months of the notification, make a written communication to the ARIPO office that the patent will have no effect in that country, on the basis that –

- the invention is not patentable in terms of the provisions of the Harare Protocol (at present there are only three requirements for patentability in the Protocol, ie novelty, non-obviousness and industrial applicability), or
- that the invention, by reason of its nature, cannot be patented under the national law of that state (eg methods of medical treatment).

After the expiry of the six months period, the ARIPO office will grant the patent, which will have effect in those designated states which did not make a written communication. Thereafter the patent is published in the ARIPO Journal.

### **Opposition**

The Protocol does not provide for opposition to the grant of a patent by a third party. As indicated above, the industrial property office of a designated state may, within six months after the ARIPO office has issued a notification that the patent will be granted, make a written communication to the ARIPO office to the effect that the patent will have no effect in that state, *inter alia* because the invention is not patentable.

### **Grant and publication**

Once a patent is granted by the ARIPO office, it will have effect in those designated states which have not communicated a rejection. The ARIPO office publishes all granted patents in the ARIPO Journal.

### **Duration/maintenance**

The ARIPO Protocol provides that the duration of a patent in each member country will be 20 years (as required by WTO/TRIPS). However, the national legislation in some ARIPO member countries has not been amended to give effect to this provision, and thus in countries where the national law provides for the duration to be for a different term, the position is uncertain.



Maintenance fees are payable annually on pending patent applications and granted patents. Payment of maintenance fees is calculated from the first anniversary of the ARIPO filing date (for non-PCT applications), and from the international filing date (for PCT applications). Payments are made to the ARIPO office and not in the individual member states.

### **Restoration**

If the annual maintenance fee (referred to above) is not paid, the application is deemed to have been withdrawn, or the patent lapses. No specific provision is made in the Protocol for restoration.

### **Revocation**

No express provision is made in the Protocol for the revocation of a patent. The national laws on revocation/invalidation in each designated state would apply in respect of that state. The Regulations provide that the applicant may withdraw the application during its pendency.

### **Compulsory licences**

National laws determine the position.

### **Assignments and licences**

Assignments and licences must be recorded centrally at the ARIPO registry. The ARIPO office advises the designated states of the changes. The national law of each designated state applies with regard to compulsory licences, forfeiture of a patent, or the use of a patented invention in the public interest.

### **Effect of a patent**

The Protocol does not specify the effects of a patent. Once granted, national laws apply to a patent granted by ARIPO.

### **Infringement**

The Protocol does not deal with infringement. Infringement matters are dealt with at national level, by the courts in the member state where the infringement occurred.

### **Marking**

The Protocol does not deal with the marking of patented goods with the patent information.

### **Working**

Working or commercial exploitation of the invention is subject to the provisions of the applicable national law of each designated country (eg as regards the granting of compulsory licences on the ground of inadequate working). In spite of requirements to prove working in some of the member countries, the ARIPO office does not require any proof of working.

## DESIGNS

### Law

The Protocol on Patents and Industrial Designs (the Harare Protocol) adopted in 1982 and entering into force on 25 April 1984, applies to the registration of industrial designs. The Protocol was amended in 1987 and 1994. The Regulations to implement the Protocol were adopted in 1984 and amended in 1994.

See the section above on **PATENTS** for the current country membership of the Harare Protocol. The Protocol provides for the filing of a single design application to have effect in those member states designated in the application. Once granted, a design registration will have the effect of a national registration in those designated states. As with patents, the legal position is uncertain in those member states which have not implemented the provisions of the Harare Protocol in their national legislation.

### Design protection

A design application is filed with the industrial property office of a contracting state or at the ARIPO office in Harare, designating the states in which protection is sought, whereupon the prescribed procedure and examination will follow.

Once an industrial design is registered, it has effect in those designated states which did not make a written communication rejecting the registration (see the sections on **Application** and **Examination/procedure** below).

### Registrable subject matter

The subject matter which would be registrable as an industrial design is not defined in the Protocol. The Protocol provides that a registered design shall be subject to the national law of each state. Specific reference is made to the requirement of novelty, that the nature of the design must be such as to be registrable, and that a textile design may be the subject of a special register. The Protocol does not define the concept of novelty in respect of designs.

### Classification

No reference is made in the Protocol or Regulations to the classification of designs.

### Types of application

Although no reference is made in the Protocol or Regulations to convention priority in regard to design applications, it is accepted (since the 17 member states of the Harare Protocol are all members of the Paris Convention) that convention priority may be claimed under the Paris Convention.

### Application

An application for the registration of an industrial design in terms of the Protocol is filed with the industrial property office of a contracting state or at the ARIPO office in Harare. As in the case of patents, an applicant may be represented or, where the applicant's residence or principal place of

business is outside that country, must be represented by an agent or a legal practitioner. Only attorneys, agents or legal practitioners who have the right to represent applicants before the industrial property office of a contracting state can represent applicants before ARIPO.

Upon receipt of an application, the industrial property office must, within a period of one month, transmit the application to the ARIPO office.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (prescribed form; simply signed)
- suitable reproductions of the industrial design
- indication of the contracting states to be designated
- assignment if the applicant is not the author of the design
- certified copy of the priority document (if priority is claimed).

### **Applicant**

The Protocol merely requires that the applicant in a design application be identified.

### **Convention priority**

Since the member countries of the Harare Protocol are all members of the Paris Convention, priority rights in terms of the Paris Convention may be claimed.

### **Novelty**

Specific reference is made in the Protocol to the requirement of novelty; however, novelty is not defined.

### **Examination/procedure**

The ARIPO office examines the application in respect of formal requirements, and in the case of compliance the appropriate filing date is accorded. The designated states are notified, and a designated state has six months to make a written communication to the effect that the design, if registered, shall have no effect in that state. The basis of such communication may be –

- that the design is not new
- that the design cannot be registered due to the nature of the design
- that the design, being a textile design, is subject to a special register.

### **Opposition**

No provision is made for opposition.

### **Registration**

After expiry of the six months period, the ARIPO office effects the registration which will have effect in those states which did not make a communication. The ARIPO office also publishes the registration in the ARIPO Journal.

### **Duration and maintenance**

An ARIPO registered design has a term of 10 years. Although this period is prescribed by the Harare Protocol for all member states, there is some uncertainty with regard to those states where designs under the national laws have a duration other than 10 years.

Annual maintenance fees must be paid to the ARIPO office on each anniversary of the filing date; payment is not made to the individual member states.

### **Restoration**

It is presumed that a design registration will lapse if no annual maintenance fee is paid. No specific provision is made for restoration.

### **Revocation**

No express provision is made in the Protocol for the revocation of a design registration.

### **Licences and assignments**

The Protocol does not expressly provide for licences and/or assignments of registered designs, apart from stating that the national laws of each state shall apply in regard to compulsory licences of designs or the use of designs in the public interest.

### **Compulsory licences**

The Protocol provides that national laws will apply in regard to compulsory licences.

### **Effect of a design registration**

The Protocol does not set out the effects of a design registration. Once registered, national laws will apply.

### **Infringement**

The Protocol does not deal with infringement.

### **Marking**

The Protocol does not deal with the marking of articles embodying registered designs.

### **Working**

Any required working of a registered design is in terms of the national laws of the designated states.

## **COPYRIGHT**

### **Law**

The Lusaka Agreement and the ARIPO Protocols address only industrial property rights, despite the change by the Organisation of its name to refer to intellectual property. The ARIPO instruments contain no provisions dealing with copyright.

Accordingly, the national laws of the ARIPO member states will determine the position in regard to the protection of copyright.

## **PLANT BREEDERS' RIGHTS**

### **Law**

Neither the Lusaka Agreement nor the Harare Protocol makes any reference to the protection of plants or plant varieties. Accordingly, the national laws of the member states will determine the position in this regard.

### **New Development**

Recently, a new protocol for regional plant variety protection for ARIPO was proposed. Developments in this regard are awaited.

# ALGERIA

## GENERAL INFORMATION

Algeria became an independent Republic in 1962. Algeria is situated on the north coast of Africa, bordered by Tunisia and Libya on the east, Niger on the southeast, Mali on the southwest, and Mauritania and Morocco on the west.



<b>Area:</b>	2 381 741 km <sup>2</sup>
<b>Population:</b>	35.6 million
<b>Capital:</b>	Algiers
<b>Currency:</b>	Algerian Dinar (DA)
<b>GDP:</b>	\$ 254.7 billion (2010)
<b>Internet domain:</b>	.dz
<b>Languages:</b>	Arabic (official language), French, Berber
<b>Working week:</b>	Sunday - Thursday
<b>Exports:</b>	Petroleum and natural gas; petroleum products
<b>Imports:</b>	Machinery and transport equipment; basic manufactured goods; food

## International/regional conventions

Algeria is a member of the following international agreements:

- Berne Convention (since 1998)
- Lisbon Agreement on Appellations of Origin (since 1972)
- Madrid Agreement on Marks (since 1972)
- Madrid Protocol on Marks (since 1972)
- Nairobi Treaty on Olympic Symbol (since 1984)
- Nice Agreement on Classification of Marks (since 1972)
- Paris Convention (since 1966)
- Patent Cooperation Treaty (since 2000)
- Patent Law Treaty (since 2000)
- Rome Convention (2007)
- WIPO Convention (since 1975)

## IP legislation

Trade marks

- Ordinance no 03-06 of 2003 on Trade Marks
- Executive Decree no 05-277 of 2005 as amended by Executive Decree no 08-346 (Regulations on Trade Marks)
- Ordinance no 76-65 of 1976 on Appellations of Origin, Geographical Indications, Indications of Source

Patents

- Ordinance no 03-07 of 2003 on Patents of Invention
- Executive Decree no 05-275 of 2005 (Regulations on Patents)

- Decree no 93-17 of 1993 on Protection of Inventions (repealed by Ordinance 03-07 of 2003)
- Decree no 99-92 of 1999 on Patent Cooperation Treaty

#### Designs

- Ordinance no 66-86 of 1966 on Industrial Designs
- Ordinance no 03-08 of 2003 on Protection of Layout Designs of Integrated Circuits
- Executive Decree no 05-276 of 2005 (Regulations on Layout Designs of Integrated Circuits)

#### Copyright

- Ordinance no 03-05 of 2003 on Copyright and Neighbouring Rights
- Executive Decree no 05-356 of 2005 (Regulations on Copyright and Related Rights)
- Decree no 97-10 of 1997 on Copyright and Related Rights (all provisions of the 1997 Decree contrary to the 2003 Ordinance were cancelled by the 2003 Ordinance)

#### Related areas

- Ordinance no 05-03 of 2005 on Seeds and Seedlings, Plantations, and the Protection of Plant Varieties

## TRADE MARKS

### Law

- Ordinance no 03-06 of 2003 on Trade Marks
- Executive Decree no 05-277 of 2005 as amended by Executive Decree no 08-346 (Regulations on Trade Marks)
- Ordinance no 76-65 of 1976 on Appellations of Origin, Geographical Indications, Indications of Source

Algeria is a member of the Paris Convention, the Madrid Agreement and the Madrid Protocol, the Lisbon Agreement on Appellations of Origin, and the Nice Classification Agreement.

Trade mark applications may be filed as national applications, in appropriate circumstances claiming convention priority in terms of the Paris Convention; or Algeria may be designated in international applications filed in terms of the Madrid Agreement or Protocol.

### Trade mark protection

Provision is made for the registration of trade marks for goods and for services, and for collective marks. No express provision is made for defensive marks.

### Protection of well-known marks

Marks which are similar or identical to a mark or trade name which is well known in Algeria and which has been used for similar or identical goods, to the extent that confusion is caused, may not be registered. This also applies when the goods and services are not similar or identical, provided the use of the mark will indicate a link with the owner of the well-

known trade mark which will be detrimental to the owner's interests. Similarly, the owner of a well-known mark registered in Algeria shall have the right to prevent others from using this mark without permission in these circumstances, ie on goods or services not identical or similar if such use would indicate a link with the trade mark owner.

### **Advantages of trade mark registration**

The registration of a trade mark gives the owner a right of property in the mark in respect of the relevant goods or services, and the right to assign or license the mark and to prevent others from using the mark without prior permission in certain circumstances (see the section on **Trade mark infringement** below).

### **Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- collective marks.

### **Definition of a trade mark**

Trade marks are defined as all symbols representable in writing, especially words including names, letters and numbers, pictures, forms distinguishing goods or packages for goods, and colours and combinations thereof, used to distinguish goods or services of a person from the goods or services of someone else.

### **Definition of a collective trade mark**

A collective trade mark is defined as a mark used to prove the origin, components, or production of goods and services of various institutions, when such institutions use the mark under the control of its owner.

### **Limitation to colour**

Colours or combinations of colours can constitute trade marks.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

Algeria is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the earlier application, provided the Algerian application is filed within six months of such earlier filing date.

### **Application**

An application is filed with the Algeria Trade Marks Office, administered by the National Algerian Institute for Industrial Property which operates under the supervision of the Ministry of Industry.



The following information and documents are required:

- full particulars of applicant
- power of attorney (simply signed), in French
- representation or print of the trade mark
- list of goods and/or services to be covered
- certified copy of priority document (if applicable), with French translation.

### **Examination/procedure**

An application is examined as to both formal and substantive requirements. Once accepted, the application is published in the Official Gazette. Thereafter a registration certificate will be issued.

The Ordinance sets out the marks that will not be registrable (see the section on **Grounds for cancellation/removal of a trade mark** below). Non-compliance with these requirements may constitute grounds for the cancellation of a registration (see the section on **Cancellation/removal of a trade mark** below).

### **Opposition**

There is no provision for opposition. Registered marks can, however, be retracted, nullified or cancelled on certain grounds (see the section on **Cancellation/removal of a trade mark** below).

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the date of filing, and is thereafter renewable for similar periods subject to payment of the prescribed fee. A grace period of six months is allowed for such payment.

### **Cancellation/removal of a trade mark**

A trade mark registration may be cancelled or nullified on various different grounds.

A trade mark registration is vulnerable to cancellation if the owner fails to use it within three years after the filing date, or if use ceases for a period of three years at any time after registration (see the section on **Use requirement and cancellation** below).

A trade mark registration may also, within five years of its date of registration, be nullified where a ground existed at the time of application in the light of which it should not have been registered; or it may be cancelled at any time where a ground arises after its registration on the basis of which cancellation is justified (see the section on **Grounds for cancellation/removal of a trade mark** below).

A trade mark registration may also be retracted by the owner for all or part of the goods and services for which it has been registered.

**Grounds for cancellation/removal of a trade mark**

The grounds on which a trade mark registration may be nullified or cancelled are as follows:

- the mark does not fulfil the definition of a trade mark as set out in the legislation
- the mark relates to public property or is not distinctive
- the mark represents the form or cover of goods which is required by their nature, function or packaging
- the mark is contrary to public order or morals, or the use thereof is prohibited by national law or bilateral or multinational agreements to which Algeria is a party
- the mark comprises an imitation or simulation of official flags, logos or symbols of a country or intergovernmental organisation
- the mark is likely to mislead the public with regard to the characteristics of the goods or services, including their geographical origin
- the mark is similar or identical to a mark or trade name which is well known in Algeria in relation to identical or similar goods or services and is likely to cause confusion, or which is well known in relation to goods or services which are not similar but where the use will indicate a link with the trade mark owner of the well-known mark to his detriment
- the mark is identical or similar to a mark which is the subject matter of a prior application or registration which includes goods or services identical or similar to those for which the mark has been registered, if such use would result in confusion.

Additional grounds exist for cancellation of collective marks.

**Use requirement and cancellation**

The Ordinance provides that the grant of a trade mark registration shall entail the use of the mark in relation to goods or services. Non-use of the mark shall entail its cancellation, if –

- such non-use continues for three consecutive years without interruption
- the trade mark owner cannot submit evidence in regard to circumstances precluding the use of the mark.

Any interested party may apply for cancellation of a mark on the ground of non-use, but cancellation can only take place by way of an order of court. A cancelled trade mark cannot be registered in the name of a third party unless a period of three years has passed from the date of cancellation.

**Assignment**

Assignments are possible and may be made with or without the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed), in French
- deed of assignment in Arabic or French, or with a certified translation
- approval by the government.

**Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is required in order to be effective against third parties.

Requirements for recordal:

- power of attorney from the proprietor/licensor (simply signed), in French
- power of attorney from the licensee (simply signed), in French
- licence agreement in Arabic or French, or with a certified translation
- approval by the government.

**Amendment**

A trade mark registration may be amended by altering the goods and/or services, by altering the mark as such, by changing the name and/or address of the owner, or by voluntarily cancelling the registration.

Requirements for amendment:

- power of attorney (simply signed), in French
- supporting document, eg certified instrument of change of name and/or address.

**Rights conferred by registration**

The registration of a mark makes the owner entitled to own the proprietary rights in the mark in respect of the relevant goods or services, and gives the owner the right to assign the mark or to license the use thereof, as well as the right to prevent others from making commercial use of the mark without his permission.

**Trade mark infringement**

Trade mark infringement occurs when a third party, without the permission of the owner, commercially uses the mark on identical or similar goods or services, or commercially uses a mark that is confusingly similar to the registered mark on identical or similar goods or services.

Trade mark infringement may give rise to civil as well as criminal action. Infringement proceedings must be brought in a competent court. In the case of civil proceedings, an action must be brought in a civil court where a claim will be heard for compensation for loss and damages suffered as a result of the infringement.

Any infringement of a trade mark is considered counterfeiting and a criminal offence in terms of the legislation. A criminal action will be presided over by a criminal court where confiscation and destruction of the infringing goods will be considered. Seizure procedures are also available.

**Defences to trade mark infringement**

A trade mark registration does not entitle its owner to prevent others from commercially using in good faith –

- their name, address or pseudonym

- true descriptions of the class, quality, quantity, destination, value, place of origin or production period of goods, or performance of services, provided that the use is in accordance with honourable practices in the industrial or commercial field.

### **Relief for trade mark infringement**

Civil remedies include an order to stop the infringing acts and compensation to the trade mark owner for loss suffered. Criminal penalties entail a fine or imprisonment or both.

### **Common law rights**

There is no express provision for common law rights.

### **Marking of goods**

The use of a mark on goods or services is considered compulsory. No trade mark may be used unless it is registered or registration is pending.

Notice of registration of the mark by use of the legend 'Marque Déposée' is optional.

Regulations on marking of origin apply mainly to imported wines, nuts, canned foods, prunes, honey, margarine and various milk products. When imported merchandise bears a trade mark, name or other indication that implies the goods are of Algerian origin, a 'corrective indication of origin' is required. The corrective marking must be indelibly applied in Arabic on the goods, to the outside packing, and near the indication needing correction. Containers for fresh fruits and vegetables have special labelling requirements.

A law introduced in 1992 bans the import of computers, typewriters and other office machines that do not have Arabic characters.

## **PATENTS**

### **Law**

- Ordinance no 03-07 of 2003 on Patents of Invention
- Executive Decree no 05-275 of 2005 (Regulations on Patents)
- Decree no 93-17 of 1993 on Protection of Inventions (repealed by Ordinance 03-07 of 2003)
- Decree no 99-92 of 1999 on Patent Cooperation Treaty

Algeria is a member of the Paris Convention, the Patent Cooperation Treaty and the Patent Law Treaty.

### **Patent protection**

Patent protection is obtainable by way of a national application, in appropriate circumstances claiming convention priority, or by way of an international application under the PCT. Certificates of addition may be obtained for improvements, and divisional patents may be obtained.

### **Types of patents**

The Ordinance provides for the following:

- conventional patents for inventions that are new, inventive and industrially applicable
- certificates of addition in respect of changes, improvements or additions to the principal invention (certificate of addition expires with the main patent; prior to issuance it may be converted to an application for an independent patent)
- divisional patents, where the original application covered more than one invention (dated with effect from the filing date of the original application).

### **Patentable subject matter**

Inventions that are new, that result from inventive activity and that are capable of industrial application may be protected by a patent. An invention may involve a product or a method.

The following are not considered to be inventions:

- scientific principles, theories and discoveries as well as mathematical methods
- plans, principles or methods to perform purely intellectual or entertaining actions
- teaching, organisation, administration or managing systems and methods
- methods of treatment of humans or animals by surgery or therapy as well as diagnostic methods
- presentation of information
- creations having a purely ornamental or decorative character
- computer software.

The following may also not be patented:

- plant varieties or animal species
- biological processes for obtaining plants or animals (with the exception of microbiological processes and products obtained thereby)
- inventions detrimental to the health and life of people, animals or plants, or a threat to the environment
- inventions contrary to morality or public order.

### **Types of applications**

Application for a patent may be in the following manner:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date is the priority date of a first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT, in which Algeria is designated
- a divisional application, where the original application covers more than one invention
- an application for a certificate of addition, to cover improvements or amendments to the invention of an earlier patent.

### **Application**

A patent application is filed with the Algeria Patent Office administered by the National Algerian Institute for Industrial Property, which operates under the supervision of the Ministry of Industry.

Filing requirements for national applications:

- full particulars of the applicant
- power of attorney (simply signed), in French
- specification (including claims, drawings and abstract), in French with an Arabic translation
- abridgement of specification, in French with Arabic translation
- certified copy of priority document, with verified French translation
- deed of assignment (if the applicant is not the inventor).

For the national phase of PCT applications the following are required:

- full particulars of applicant
- power of attorney (simply signed), in French
- specification (including claims, drawings and abstract), in Arabic
- International Search Report on Patentability
- International Preliminary Report on Patentability.

### **Applicant**

The inventor or his successor in title may apply. As indicated above, an assignment document will be required if a successor applies. However, for PCT national phase applications no assignment document is necessary if the applicant of the Algerian national phase application is the same as the applicant in the international application.

### **Novelty**

The invention is considered new if it is not included in the state of the art. This includes all information made available to the public in any way and anywhere in the world. This means that the invention must not have been disclosed by written or oral description, use or any other means before the filing date or priority date.

### **Certain prior knowledge or publication excused**

Novelty is not destroyed by any manufacturing or preparatory work on the invention carried out by the applicant or his predecessor in title, provided the patent application is filed within 12 months from such activity. Disclosure resulting from an abusive act by a third party will also be excused, provided an application is filed within 12 months.

Finally, novelty is not destroyed by display of the invention at an officially recognised exhibition, provided the application is filed within 12 months after the exhibition.

**Inventiveness**

An invention is considered to be inventive if it is not recognised intuitively from the prior art. An invention is industrially applicable if it can be manufactured or used in any type of industry.

**Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the Algerian application is filed within 12 months from the earlier application.

A certified copy of the priority application has to be filed.

**Examination/procedure**

Examination as to formal requirements only takes place. If the patent office refuses to accept the application, the applicant has two months to respond. An appeal against a decision by the Registrar of Patents may be made by way of a petition to a competent court.

If it is found that the application entails more than one invention, one or more divisional applications may be filed.

**Opposition**

There is no provision for opposition.

**Publication**

Publication in the Official Gazette takes place after the acceptance of the application by the Registrar of Patents.

**Duration and maintenance**

A patent is valid for 20 years from the date of application. Maintenance fees are payable in advance, the first fee being payable upon filing and annually thereafter as from the filing date.

**Restoration**

If the annual renewal fee is not paid by the due date, or within a six months grace period (with payment of a surcharge), the patent will be forfeited. There is limited provision for restoration, namely within a six month period of the expiration of the grace period for the payment of the renewal fee.

**Revocation/nullification**

A competent court may, on the request of an interested person, order the complete or partial nullification of a claim or of the patent on any of the following grounds:

- that the subject matter of the patent does not comply with the provisions of the Ordinance
- that the description contained in the specification does not comply with the requirements of the Ordinance
- that the invention is the subject of an earlier patent in Algeria or has benefitted from an earlier filing.

### **Assignments and licences**

Assignments and voluntary licences are provided for and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed), in French
- duly executed deed of assignment or licence contract, with French translation
- original letters patent (patent certificate) for endorsement.

### **Compulsory licences**

The patentee has to put the patent into operation (ie work or exercise the patent) within a period of four years from the date of filing or three years from the date of grant, whichever period last expires, failing which a compulsory licence may be issued under the patent (see the section on **Working** below).

A compulsory licence may also be granted in the case of a dependent patent, ie where a patented invention cannot be exploited without infringing an earlier patent. The second (dependent) patent must entail a clear technological progress, and the owner of the earlier patent is entitled to a reciprocal licence.

### **Amendments**

Changes in the owner's name or address, such as in the case of mergers of companies, must be recorded.

Requirements for recordal:

- power of attorney (simply signed), in French
- duly certified instrument of change of name and/or address or of merger
- original letters patent (patent certificate) for endorsement.

### **Effect of a patent**

A patent makes the owner entitled to the following exclusive rights:

- the right to prevent others, without his authority, from manufacturing, using, selling, offering for sale, or importing the patented product
- where the invention is a method, the right to prevent others from using such method, and from using, selling, importing, etc the product of such method
- the right to assign or transfer, or to license the patent.

The exclusive rights apply to the activities set out above insofar as those activities are for industrial or commercial purposes.

The exclusive rights do not extend to –

- activities concluded only for scientific research purposes
- activities related to products put on the market by the patent owner
- use on a ship or aircraft temporarily within the territory.



**Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. In civil proceedings, damages for losses sustained may be granted; in criminal proceedings (eg in the case of counterfeiting) the relief could include confiscation and destruction of the infringing products, or a fine or imprisonment.

**Marking**

There is no express requirement for patented products to be marked as such.

**Working**

Working is required within four years from the date of filing or three years from the date of grant, in order to avoid compulsory licensing. Importation of patented articles is not considered sufficient working.

**DESIGNS****Law**

- Ordinance no 66-86 of 1966 on Industrial Designs
- Ordinance no 03-08 of 2003 on Protection of Layout Designs of Integrated Circuits
- Executive Decree no 05-276 of 2005 (Regulations on Layout Designs of Integrated Circuits)

Algeria is a member of the Paris Convention.

**Design protection**

Design protection may be obtained by way of a national filing. Since Algeria is a member of the Paris Convention, priority may be claimed (see the section on **Convention priority** below).

**Registrable subject matter**

Industrial designs comprise the following:

- an arrangement of colours or lines which gives a distinctive appearance to an industrial or handicraft object
- any three-dimensional configuration of an industrial or handicraft article which may be used as a model for the manufacture of replicas and which is distinguishable by reason of its configuration
- layout designs (topography), being three-dimensional arrangements, in whatever form, for the elements and connections of integrated circuits.

**Classification of designs**

The articles to which designs may be applied are classified into different classes. The Locarno International Classification of Designs is applied. Separate applications are required for each class.

### **Types of applications**

Application for design registration may be –

- a non-convention application
- a convention application, claiming convention priority.

### **Application**

A design application is filed with the Algeria Designs Office.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in French
- copies or representations of the design (photographs or drawings), or two specimens of the actual design (subject to size limitation)
- deed of assignment (if the applicant is not the creator)
- certified copy of the priority document (if applicable).

### **Applicant**

The author/creator or his assignee may apply for registration.

### **Convention priority**

Priority may be claimed in terms of the Paris Convention provided the application is filed within six months of the basic application. A certified copy of the priority registration is required.

### **Novelty**

A design is new if it has not been created previously. Prior publication does not destroy novelty. Novelty is also not destroyed by exhibition at an officially recognised exhibition, provided the application is filed within six months.

### **Examination/procedure**

Examination takes place as to formal requirements only.

An accepted application will not be published and will be kept secret, unless the proprietor requests otherwise. Generally an application will be published after expiry of the first year, at which time a notice of acceptance is published in the Official Gazette and the certificate of registration will be issued.

### **Opposition**

No provision.

### **Duration and maintenance**

Designs have a term of 10 years from the date of application. The term is divided into a first period of one year (during which the design remains secret), and a second period of nine years (when a renewal fee is payable and the design becomes open to public inspection).

**Restoration**

No express provision.

**Revocation**

No express provision.

**Assignments and licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment/licence signed by both parties, with French translation.

**Compulsory licences**

Compulsory licences may be granted in cases of public interest.

**Effect of a design registration**

The registration of a design gives the owner the sole right to exploit the design so as to derive all economic benefits from the creation thereof, and the right to institute proceedings against other persons who endeavour to derive economic benefits from the design (without the owner's consent).

**Infringement**

In the case of infringement, committed in a manner adverse to the rights of the owner, legal proceedings may be instituted.

**Marking**

Optional.

**Working**

No requirement.

**Layout designs for integrated circuits**

Protection for layout designs for integrated circuits can be obtained under the Ordinance no 03-08 which became effective in November 2003. Registration gives the owner the right to prevent others from performing the following acts without the owner's consent, namely:

- wholly or partially reproducing the protected layout design by incorporating it in an integrated circuit
- importing, selling or distributing, for commercial purposes, a protected layout design.

## COPYRIGHT

### Law

- Ordinance no 03-05 of 2003 on Copyright and Neighbouring Rights
- Executive Decree no 05-356 of 2005 (Regulations on Copyright and Related Rights)
- Decree no 97-10 of 1997 on Copyright and Related Rights (all provisions of the 1997 Decree contrary to the 2003 Ordinance were cancelled by the 2003 Ordinance)

Algeria is a member of the Berne Convention and the Rome Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

The following works, if they are original, qualify for copyright protection, namely intellectual works of a literary or artistic nature, regardless of the underlying purpose of their creation or the manner of expression. These include the following:

- literary works, including written works (such as novels, poems, research reports, computer software) and oral works (such as lectures, speeches)
- theatre plays, drama, musical and rhythmic works
- artistic works
- musical works
- cinematographic and audio-visual works
- works of applied art (such as drawings, paintings, sculpture)
- drawings, diagrams, geometrical models, architecture
- charts, maps, drawings related to topography, geography, science
- photographic works
- translations and adaptations of original musical, literary or artistic works
- broadcasting works
- collections of works, collections of traditional cultural heritage, collections of databases
- clothing innovations.

Also protected are derivative works namely:

- translations and adaptations of works
- collections of works, collections of traditional cultural databases.

Works of traditional cultural heritage also enjoy special protection, including:

- traditional musical works and songs
- anecdotes, poems, folklore and dances
- works of popular arts, such as drawings, sculptures, carvings, pottery
- handcrafts of metal, wood, basket, textiles, jewellery.

Protection in general does not extend to ideas, concepts, principles, techniques, working procedures. Official documents also do not enjoy copyright, such as administrative laws, regulations, administrative contracts, justice rulings, etc.

Works referred to as State works, which are legally made available to the public, may be used freely subject to maintaining the integrity of the work and acknowledging the source. Such works include works produced by State institutions and public entities of an administrative nature.

### **Protection afforded by copyright**

The moral rights of the author are protected, including the right to publish the work, the right to be acknowledged as the author, and the right to preserve the integrity of the work and to prevent mutilation or distortion thereof.

The material rights of the author or his successor in title (ie the copyright owner) are protected, including the right to –

- reproducing the work in any manner
- publishing the work and making it available for public circulation
- conveying the work to the public such as by public performance, broadcasts, circulation by wire or cable media or by wireless diffusion of a broadcast
- translating, adapting, or converting the work to other media.

The National Bureau of Copyrights & Neighbouring Rights has been established and has been assigned the responsibility for the legal protection of copyright and neighbouring rights and for the administration of the system.

### **Duration of copyright**

Protection under the copyright law generally endures for the lifetime of the author plus 50 years. However, the Ordinance provides for many exceptions when the protection will be only 50 years and when the 50 year period commences on the date that the material is first published.

### **Copyright infringement**

The unlicensed or unauthorised use of a copyright work constitutes an infringement.

In the case of infringement, the copyright owner may institute civil or criminal proceedings, depending on the facts of the infringement. In the case of civil proceedings, precautionary measures (such as an interdict or injunction) may be obtained to prevent imminent infringement, and damages may be awarded. The precautionary measures may include seizure of counterfeit goods and materials.

Certain infringing acts, in particular the making or distribution of counterfeit copies, also constitute offences. Criminal proceedings may follow, with the imposition of a fine and/or imprisonment. Infringing products and materials, and revenues generated, may be confiscated.

### **Moral rights**

The moral rights (eg to be recognised as the author) are granted to the author, irrespective of whether the copyright owner is a legal entity or a natural person. Moral rights are not disposable. Moral rights include the right to be recognised as the author and the right to publish the work.

### **General**

The law also provides for neighbouring rights, including performers' rights, recording rights, broadcasting rights; and for the protection of traditional cultural heritage works.

## **PLANT BREEDERS' RIGHTS**

Plant breeders' rights are governed by Algerian Law no 05-03 of 6 February 2005, relating to seeds, plantations and the protection of plants. This law should be viewed in conjunction with Ordinance 03-07 relating to patents, in terms of which patents cannot be obtained in respect of plant varieties or biological methods of producing plants (see the section on **PATENTS** above).

At the time of going to press, no further details are available.

# ANGOLA

## GENERAL INFORMATION

The People's Republic of Angola is located on the west coast of southern Africa, bordered in the north and north-east by the Democratic Republic of Congo, on the east side by Zambia, on the south by Namibia, and on the west by the Atlantic Ocean. It also includes the enclave of Cabinda, which is physically separate from Angola proper and is surrounded on its landward side by the People's Republic of the Congo (Brazzaville) and the Democratic Republic of the Congo.



<b>Area:</b>	1 246 700 km <sup>2</sup>
<b>Population:</b>	13 million
<b>Capital:</b>	Luanda
<b>Currency:</b>	New Kwanza (NKz)
<b>GDP:</b>	\$ 114.1 billion (2010)
<b>Internet domain:</b>	.ao
<b>Languages:</b>	Portuguese (official language), Kimbundu, Kikongo, Chokwe, Umbundu
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Crude oil; diamonds; refined petroleum products; coffee; timber; cotton
<b>Imports:</b>	Machinery and electrical equipment; vehicles and spare parts; medicines; food; textiles and clothing; military supplies

## International/regional conventions

Angola is a member of the following international agreements:

- Paris Convention (since 2007)
- Patent Cooperation Treaty (since 2007)
- WIPO Convention (since 1985)
- WTO/TRIPS (since 1996)

## IP legislation

Trade marks

- Industrial Property Act, Law no 3/92 of 1992, Chapters IV - VII

Patents

- Industrial Property Act, Law no 3/92 of 1992, Chapter II

Designs

- Industrial Property Act, Law no 3/92 of 1992, Chapter III

Copyright

- Copyright Act, Law no 4/90 of 1990 on Authors' Rights
- Decree of 2005 on Videograms and Phonograms

## TRADE MARKS

### Law

- Industrial Property Act, Law no 3/92 of 1992, Chapters IV - VII

Chapters IV – VII deal with marks, so-called awards, business names and emblems, and indications of origin.

Angola is a member of the Paris Convention and of WTO/TRIPS.

### Trade mark protection

Provision is made (chapter IV) for the registration of trade marks for goods and for services, and for collective marks. The Act refers to industrial, trade and service marks without, however, defining these classes of marks.

Express provision is made for the registration in a single registration of a series of marks from the same enterprise or establishment, whether the same or different from one another, and irrespective of the indication of products. No express provision is made for defensive marks.

The Act also provides for the registration of awards (chapter V), of establishment names and emblems (chapter VI), and of indications of origin (chapter VII). See in this regard the section on **Other registrable signs** below.

The Act expressly refers to foreign marks, by stating that foreign marks will be registrable provided the mark relates to trade, industrial or professional activity legitimately carried out in the country of origin.

### Protection of well-known marks

No express provision is made for well-known marks.

### Advantages of trade mark registration

The registration of a trade mark gives the owner the right to institute court proceedings against other persons who use the registered mark without his consent. Unauthorised use of a registered mark also gives rise to a criminal sanction.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- collective marks
- series of marks.

### Definition of a mark

Word and device marks are registrable. The law states that a mark may be composed of signs that are visual, nominative or figurative, ie being visible signs, words, devices or emblems, and capable of distinguishing the products or services, such as patronymical names, geographical names,



arbitrary or fanciful words, monograms, emblems, figures, ciphers, combinations or arrangements of colours, designs, etc.

**Definition of a collective trade mark**

A collective mark is a mark used by an economic group to distinguish the goods manufactured or sold, or the services rendered, by a member of the group.

**Registration of a series of marks**

A series of marks belonging to the same enterprise or establishment, whether the same or different from one another, and irrespective of the indication of products, prices, or quality, may be included in a single registration.

**Limitation to colour**

Provision is made for combinations or arrangements of colours.

**Classification**

Although no express provision is made for classification, the International Classification of Goods and Services (Nice Classification) is applied. In terms of the old Portuguese 5-item rule, a fee is payable for each additional item of goods or services beyond the fifth item.

However, as indicated above, express provision is made in the 1992 Act for the registration of a series of marks, by way of a single registration, from the same enterprise or establishment. This possibility is not further elaborated in the law.

**Convention priority**

Although Angola acceded to the Paris Convention in 2007, no express provision has as yet been made in Angolan law to implement convention priority. However, there is a general provision in the law that an application may contain a statement claiming priority over an earlier application. Accordingly, the Angolan registry appears to permit applications with priority claims.

**Application**

An application is filed with the Angola Trade Marks Office.

Requirements for application:

- full particulars of the applicant
- power of attorney (legalised)
- if the applicant is a company, certified copy of the certificate of incorporation (legalised), with a sworn Portuguese translation
- prints of both word and device marks.

**Examination/procedure**

An application is examined for inherent registrability, and for possible conflict with prior registrations or pending applications.

In particular a trade mark application will be refused if the mark contains the following:

- false indications, or indications likely to mislead the public, eg as regards the nature of the product or service
- false indications concerning geographical origin, manufacture, etc
- symbols and insignia, flags, arms or official signs of the State, international organisations, etc
- business names or emblems that do not belong to the applicant
- a reproduction or imitation of a mark previously registered by another person, which could mislead or cause confusion in the marketplace
- marks contrary to morality or that contravene the law
- names or likenesses of individuals without the authorisation of the relevant person(s).

The registration of a mark that contravenes the provisions of the law will be null and void.

### **Opposition**

Opposition is possible, although it is not expressly provided for under the applicable law.

### **Opposition proceedings**

The Trade Marks Office currently permits an opposition to be lodged within two months of the advertisement of an application. The law expressly provides for the publication of a bulletin in which trade marks are to be published.

### **Grounds of opposition**

The grounds upon which a trade mark application may be refused (see the section on **Examination/procedure** above) are used in practice as grounds upon which to oppose the registration of a mark.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years and, thereafter, is renewable for like periods. The renewal fee may be paid within four months after the expiry of the term. If the renewal is not paid in time, the registration lapses. Revalidation of the mark may be requested within a period of one year from the end of the period of protection, if valid reasons can be shown for the failure to renew.

### **Cancellation/removal of a trade mark**

Cancellation of a trade mark registration can only take place by a judicial decision. Legal proceedings for cancellation may be brought by any person with a direct interest in the registration, or on the initiative of the public prosecutor.

### **Grounds for cancellation/removal of a trade mark**

Although nowhere expressly stated, it is presumed that a registered trade mark could be cancelled on the grounds that it does not satisfy the

requirements of the legislation (see the section on **Examination/procedure** above). Non-use may also be a ground for cancellation (see the section on **Use requirement and cancellation** below).

### **Use requirement and cancellation**

A trade mark must be used in order to avoid cancellation. However, there is no mention of a specific time period within which use is to take place. The law merely provides for cancellation in the case of non-use in consecutive years, unless *force majeure* can be proved.

### **Assignment**

Assignments of trade marks are possible and may be made with or without the goodwill of the business. Collective marks cannot be alienated unless the rules of the relevant body so provide. The transfer of ownership must be recorded in order to be valid as against third parties.

Requirements for recordal:

- power of attorney from the assignee (legalised)
- deed of assignment (legalised), in Portuguese.

### **Licensing/registered users**

Licensing is recognised. A licence agreement must be in writing. Recording of the licence agreement is required in order to be legally binding. A licence cannot be alienated without the express written authorisation of the owner of the mark, unless the licence agreement provides otherwise.

A licensing agreement must provide for quality control by the licensor.

Requirements for recordal:

- power of attorney from the proprietor/licensor (legalised)
- power of attorney from the user (legalised)
- licence agreement (legalised), in Portuguese or with sworn translation.

### **Amendment**

The law does not expressly provide for the amendment of a trade mark registration. There is reference to a new registration to be granted for the purpose of editing or substituting products; and to the lapsing of a registration if the mark has been altered in a manner to prejudice its identity.

### **Effect of a trade mark registration**

The registration of a trade mark gives the owner the right to prevent the unauthorised use by others of the protected mark or an imitation thereof. Unauthorised use of such a mark constitutes an offence.

### **Trade mark infringement**

Illegal use of a mark constitutes an offence, and a person committing such offence may be prosecuted and fined (and/or imprisoned).

The following offences are listed:

- by any means imitating or producing, in whole or in part, a protected mark without the authorisation of the owner
- the use of a counterfeit mark
- the fraudulent use of a collective mark
- the use of a mark with a false indication as to the origin of the products
- the use of a mark in conditions excluded from protection.

### **Defences to trade mark infringement**

There is no express provision for defences to infringement.

### **Relief for trade mark infringement**

There is no express provision for civil remedies in the case of trade mark infringement. As indicated above, a fine is imposed with or without imprisonment.

### **Common law rights**

The law does not provide for rights to a trade mark to arise otherwise than by registration, eg through extended use of a mark.

### **Marking of goods**

Notice of registration of the mark by use of the legend 'Marca Registrada', or suitable abbreviation (eg 'M.R.') or symbol ®, is optional.

Canned goods and foodstuffs must be marked or labelled with net weight and country of origin. Containers of sterilised milk and condensed milk must also be labelled with directions for use in Portuguese.

### **Other registrable signs**

As indicated above, the law also provides for the registration of awards (chapter V), of establishment names and emblems (chapter VI), and of indications of origin (chapter VII). See the sections on **Awards** and **Establishment name and emblem** below.

### **Awards**

Awards are defined as nominative (words), figurative (devices) or emblematic signs granted as a prize, in Angola or abroad, to industrialists with a commendation for their products or services. Awards belong to those entities who receive them and cannot be applied to other products or services.

The registration of an award guarantees the veracity and authenticity of the award, and affords the owner the exclusive right to use the award for an indefinite period. Unregistered awards may not be added to any mark or name or emblem of an entity.

### **Establishment name and emblem**

An establishment name or business name and emblem is defined as a word sign or an emblematic or figurative sign used to designate the establishment by which a commercial, industrial or service activity is carried out.

The following may be used as the name of an establishment:

- fanciful or other names
- the owner's pseudonym or nickname
- the name of the place where the establishment has been set up, combined with a distinctive element.

An establishment emblem (or shop sign) may be formed from any external figurative or emblematic sign, whether simple or combined with other elements, provided it has its own specific overall appearance.

The period of protection of an establishment name or emblem is 20 years; this period may be extended on payment of the appropriate fee within six months of the expiry of the period.

Indication or appellation of origin:

An indication of origin means the expression or sign used to indicate that a product comes from a given country, region or geographical place famous for the production or manufacture of the goods or products.

Once a geographical name has become commonplace for designating the nature or kind of goods or products, it shall not be regarded as an indication of origin.

The right to use such an indication of origin belongs not only to the manufacturers and producers, but also to the purchasers of the product.

## **PATENTS**

### **Law**

- Industrial Property Act, Law no 3/92 of 1992, Chapter II

Angola is a member of the Paris Convention, the PCT, and the WTO/TRIPS.

### **Patent protection**

Patent protection is obtainable by way of a national filing, or via a PCT application.

In the case of a national filing, priority rights should be claimable in terms of the Paris Convention in appropriate circumstances (filing within 12 months). Although the national law of Angola has not yet been amended to implement the provisions of the Paris Convention, the law contains an express provision that an application for a patent may contain a statement claiming priority over a previous application.

Although Angola has acceded to the PCT, the national law has not yet been amended to implement the system and to recognise national phase filings. Although the Act contains a statement that international conventions, to which the country is a party, shall be applicable, a national filing may be preferred so as to ensure enforceable rights.

### **Types of patents**

In Chapter II on Patents, the law only provides for conventional patents in respect of inventions which are novel, entail an inventive step, and are capable of industrial application.

**Note:** In Chapter III on Industrial Designs, provision is also made for utility models. However, it is expressly provided that inventions cannot be protected as utility models (see the section on **Utility models** under **DESIGNS** below.)

### **Patentable subject matter**

An invention is defined as an idea which makes it possible in practice to solve a particular technological problem, in relation either to a product or a process. An invention is patentable if it is new, involves an inventive step and if it is capable of industrial application.

An invention is regarded as being industrially applicable if it may be used in any kind of industry, including agriculture, fishing and handicrafts.

Excluded from patentability are:

- discoveries the use of which would be contrary to public policy or morality, public health or public safety
- ideas that have no practical utility, or that cannot be industrialised by mechanical or physical or chemical methods
- scientific principles or discoveries
- financial plans or programmes, rules of games
- food, pharmaceuticals and chemical products and medicines intended for human and animal use (but processes or apparatus for their manufacture are patentable).

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention filing, where the effective date will be the filing date of the application
- a convention application, where the effective date will be the priority date of the first-filed under the Paris Convention
- a national phase application based on an international application under the PCT in which Angola is designated.

### **Application**

A national application for a patent is filed with the Angola Patent Office, referred to in the law as the body charged with the registration of industrial property rights within the Ministry of Industry.

Requirements for filing:

- full particulars of the applicant
- power of attorney (legalised)
- specification (including claims, drawings and abstract), in Portuguese
- formal drawings, if applicable, referring to the description or claims
- assignment of invention (if applicable; legalised)
- certified copy of the priority document (if applicable).

The application must refer to a single invention or to a group of inventions related in such a way that they constitute a single inventive concept.

Inasmuch as Angolan national law does not yet provide for the national phase filing of PCT applications, the requirements for national filing should be followed and in addition the following should be lodged:

- copy of international publication
- copy of International Search Report
- copy of International Preliminary Report on Patentability.

### **Applicant**

The inventor or his successor in title may apply. As indicated above, an assignment of invention (notarised and legalised up to Angolan Consular level) must be filed where the applicant is not the inventor.

### **Novelty**

An invention is considered to be new if it is not included in prior art. Prior art includes everything that became accessible to the public, inside or outside Angola, before the filing or the priority date of the application, eg by means of a written or oral description, or by disclosure in any other way anywhere in Angola or abroad.

### **Certain prior knowledge or publication excused**

A grace period of six months prior to the date of filing, or the priority date, is available where the disclosure is a result of acts carried out by, or against, the applicant or his predecessor. Thus prior public disclosure by the applicant or his predecessor, or a prior public disclosure as the result of an abuse of rights by a third party, will be excused provided, in both cases, the application is filed within six months of the disclosure.

### **Inventiveness**

An invention is deemed to involve an inventive step if, to a person skilled in the art, the invention does not follow in an obvious manner from the prior art.

### **Convention priority**

As indicated above, Angola has acceded to the Paris Convention so that convention priority should be afforded. Although the national law refers to the claiming of priority, particularly also in the context of patent applications, no specific provisions to implement this feature has as yet been enacted. In the meanwhile the Angolan registry does allow priority

claims, in the light of the general provision in the law that international conventions of which Angola is a contracting party, shall be applicable.

### **Examination/procedure**

Examination is limited to formal examination only. If the application is found to be patentable, acceptance is published in the Official Bulletin.

### **Opposition**

After publication of acceptance, there is provision for a six months opposition period. If no opposition is filed, the registration and publication fees must be paid. The application is then published again and the Certificate of Grant/Letters Patent document is issued.

### **Publication**

Patent applications are required to be published in the Official Bulletin twice; the first time after acceptance, for opposition purposes; the second time for registration purposes. The publication must include the names of the patentee, with a short description (eg the abstract) of the invention.

### **Duration and maintenance**

Patents are valid for 15 years from the date of filing, subject to payment of annual maintenance fees on the anniversary of the filing date. A six month grace period is available for late renewal. Once the 15 year period has expired, the patent falls into the public domain.

### **Restoration**

There is limited provisions for restoration in the Angolan law, namely when the patent has lapsed through non-payment of renewal fees, in which case the owner may within six months apply for restoration.

### **Revocation**

There is no express provision for revocation. However, the law lists a number of cases when a patent will lapse and/or be forfeited, namely:

- on the expiration of the term of protection
- when abandoned by the owner
- when effective exploitation in Angola has not commenced within four years of grant
- when exploitation is interrupted for more than two years, unless *force majeure* can be proved
- when renewal fees have not been paid, unless the patent owner applies for revalidation/restoration within six months of the date on which the fee should have been paid.

The concept 'effective exploitation' means exploitation by the owner or by a third party through a licence.

### **Assignments**

Assignments and licences are permitted.



The law provides that ownership of a patent may be transferred *inter vivos* by means of a deed, or by virtue of testamentary succession. The transfer of ownership must be recorded by the registry in order to be valid as against third parties.

Recording may be requested by any interested party.

Requirements for recordal:

- power of attorney by the assignee (legalised)
- deed of assignment (legalised), with Portuguese translation.

### **Licences**

The owner of a patent may grant a licence for the exploitation of the patent by way of a contract which must set out the conditions for the exploitation. A licence has to be recorded by the registry in order to be valid as against third parties. A licence may not be alienated without the authorisation of the patent owner.

Requirements for recordal:

- power of attorney by the licensor and licensee (legalised)
- licence agreement (legalised), with Portuguese translation.

### **Compulsory licences**

Compulsory licences may be granted in the following circumstances:

- a non-exclusive compulsory licence may be granted in cases of non-working, ie where the owner of the patent has not begun to exploit the invention in Angola within three years of the grant of the patent, or working has been interrupted for a period of more than one year, except if *force majeure* can be proved (see the section on **Working** below)
- the beneficiary of a compulsory licence must commence the effective exploitation of the invention in Angola within two months of grant and may not interrupt exploitation within one year
- where a compulsory non-exclusive licence has fallen into disuse, or where the exploitation does not meet public demands, the licence may be granted to a third party
- where the exploitation of an industrialised invention is substituted by importation, this will not be regarded as effective exploitation
- where it is required in the public interest, particularly in the interest of national security, health or development, the Council of Ministers may decide that the invention should be exploited by the State or by a designated third party
- in all cases the patent owner is entitled to fair remuneration.

### **Amendments**

The law does not expressly provide for amendments of a patent or patent application, but instead provides that the owner of a patent may make alterations to the invention. Such alterations are to be formalised by simple alteration certificates, which shall confer the same rights as the original patent for the duration of the patent.

### **Effect of a patent**

It is provided that a patent means that the legal title is granted to the inventor/owner in respect of the invention and the exclusive right to exploit the invention.

### **Infringement**

As indicated above, a patent is defined as the legal right granted to protect an invention and which confers on the owner the exclusive right to exploit the invention.

The law has express provisions dealing with the violation of these rights, namely that such violations constitute offences and that a person will be liable for prosecution in the following circumstances:

- where he manufactures the goods or products covered by the patent without authorisation by the patent owner
- where he uses the methods or processes covered by the patent without authorisation
- when he imports, sells, or exports for sale a product manufactured in violation of the patent.

### **Marking**

No express provision.

### **Working**

The invention must be worked within three years from the date of grant and working should not be interrupted for longer than one year, except in a case of proven *force majeure*. In the absence of working, or if working has been interrupted for a period of more than one year, or if exploitation is not meeting market demands, a compulsory non-exclusive licence may be granted (see paragraph on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Industrial Property Act, Law no 3/92 of 1992, Chapter III

Angola is a member of the Paris Convention.

This section covers utility models and industrial designs.

### **Design protection**

Design protection or protection for a utility model may be obtained by way of a national filing. Since Angola is a member of the Paris Convention, priority may be claimed (see the section on **Convention priority** below).

Although it is not entirely clear, from the wording of the law, whether all provisions stipulated in respect of industrial designs will also apply to utility models, it seems that a similar registration process and outcomes are contemplated.

The effect of a design registration (and probably also a utility model registration) is to confer on the owner of a design or a model, throughout Angola, the exclusive right to use the design or model by way of the manufacture, sale or exploitation of the article to which the design or model is to be applied.

### **Registrable subject matter**

Registration may be obtained in respect of a utility model or an industrial design.

### **Industrial design**

An industrial design is defined as any shape or form, whether or not it is associated with lines or colours, that may be used in the manufacture of an industrial or handcrafted article. Any new arrangement or set of lines or colours that may be applied in the ornamentation of a product, for an industrial or commercial purpose, by some manual, mechanical or chemical process, will be regarded as an industrial design.

### **Utility model**

A utility model is defined as any new arrangement, shape or form obtained in or introduced into objects such as tools, work implements or utensils, that improves or increases the conditions for using them and their usefulness. Protection is granted exclusively to the new form that makes it possible to increase and improve the usefulness.

The following will not qualify for protection as industrial designs or utility models:

- items which are regarded as inventions
- works of sculpture, engraving, painting, architecture, photography, enamelling or embroidery, or other designs of a purely artistic nature
- industrial designs or models contrary to public policy or morality
- designs that have no practical utility or cannot be industrialised.

### **Classification of designs**

Although there is no express reference in the law to the classification of articles to which a design or utility model is to be applied, the law requires the articles or types of articles to be specified in an application for registration. In practice, the articles to which a design or a utility model may be applied are classified into different classes in accordance with the Locarno International Classification of Designs. Separate applications are required for each class.

### **Types of applications**

Application for the registration of a design or a utility model may be made as –

- a non-convention application, where the effective date is the filing date
- a convention application, claiming priority from a first filed application in a convention country.

### **Application**

The requirements for filing a design application are as follows:

- full particulars of the applicant
- power of attorney (legalised)
- assignment of the design, if the applicant is not the creator of the design or model (legalised)
- sample of the utility model or the design article, or a graphic representation of the model or design
- brief description of the novel and utility features inherent in the utility model, or of the novel features inherent in the industrial design
- indication of the product(s) to which the model or design is to be applied
- certified copy of the priority document (if applicable).

An application for the registration of an industrial design or a utility model may cover only one design or model.

### **Applicant**

The creator of the design may apply, or his assignee.

### **Convention priority**

Although Angola has acceded to the Paris Convention, no express provision has as yet been made in Angolan law to implement convention priority. However, the current law refers in general to an application, including an application for an industrial design, to claim priority over a previous application, so that the Angolan registry does accept priority claims.

### **Novelty**

Only new industrial designs or utility models may be registered, including those that, although composed of known elements, produce original combinations that result in an overall appearance that has its own characteristics (see section on **Registrable subject matter** above).

An industrial design or utility model is new if it has not been disclosed (in Angola or abroad) in such a way that it may be exploited by a person skilled in the art.

A design or model will not be deemed to be new if it has been the subject of a deposit (in Angola or abroad) even though the deposit is void or has lapsed, or if the design or model has been commonly used or has fallen into the public domain.

### **Examination/procedure**

An application is examined to determine whether it complies with the requirements of the law.

It is specifically provided that a registration will be null and void in the following cases:

- if it lacks novelty or does not constitute an original combination with its own characteristics

- if the design or model in fact constitutes an invention
- if the grant was in violation of third party rights
- if some legal step was omitted in the granting procedure.

**Opposition**

There is no provision for opposition.

**Duration and maintenance**

The term for a registered design or utility model is five years from the date of deposit of the application. The term may be renewed for two further consecutive five-year periods upon payment of the prescribed fee. Renewal fees are payable annually.

Furthermore, in order to maintain the registration the design or model must remain unaltered. Any substantive alteration of its original elements requires a new deposit.

**Restoration**

Although no express provision is made for the restoration of models or designs, it does appear as if the owner who fails to pay a renewal fee on time, will have six months in which to pay the fee and restore the registration.

**Revocation**

Although no reference is made to the revocation of model or design registrations, it is provided that a model or design registration will be forfeited in the following circumstances:

- failure to exploit the model or design during a period of one year
- in the case of a waiver on the part of the owner
- in the case of failure to pay prescribed fees.

**Assignments and licences**

The assignment of an industrial design or utility model must be recorded in order to be valid as against third parties. Recording may be requested by any of the interested parties. The requirements for such recordal are not prescribed.

Express provision is made for the exploitation of a design or utility model by way of a licence. A licensed right may not be alienated without the express authorisation of the owner of the registration.

In order to be enforceable against third parties, a licence must be recorded. The requirements for such recordal are not prescribed.

**Compulsory licences**

No express provision.

### **Amendment**

The law does not provide for the amendment of a design registration; instead it provides that an industrial design (and utility model) must remain unaltered for the term of the registration. Any alteration to the original elements of the design or utility model requires a new application, except where the changes relate to the size of the design or its colour or material.

### **Effect of a model or design registration**

The registration of a utility model or design grants the owner the right to its exclusive use within the national territory, by way of manufacture, sale or exploitation of the article to which the model or design is applied.

### **Infringement**

Infringement of a design or model right constitutes an offence, and a person who commits any of the following acts may be prosecuted and fined:

- the exploitation, manufacture or production of deposited utility models, without a licence from the owner
- the importing, sale, or placing on sale of products obtained in violation of a deposited utility model
- the full or partial reproduction or the exploitation of an industrial design, without authorisation by the owner
- the importing, sale, or placing on sale of objects which are copies of an industrial design
- the fraudulent exploitation of a design belonging to another.

### **Marking**

No provision.

### **Working**

Failure to work a registered industrial design or utility model for one year causes the registration to lapse.

## **COPYRIGHT**

### **Law**

- Copyright Act, Law no 4/90 of 1990 on Authors' Rights
- Decree of 2005 on Videograms and Phonograms

Angola is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The law protects original literary, artistic and scientific works.

The following are specifically mentioned:

- books, pamphlets, newspapers and other writings
- lectures, lessons and similar works, whether written or oral
- dramatic and dramatic-musical works
- musical works
- choreographic works
- cinematographic works
- television and audiovisual works
- radiophonic works
- works of drawing, painting, sculpture, engraving, tapestry and architecture
- photographic works
- works of applied art and handicraft
- illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture
- works of folklore
- computer programs.

Derivative works are also protected:

- translations, adaptations, transpositions, arrangements
- compilations of works, anthologies, encyclopaedias.

#### **Registration of copyright**

No registration is required.

#### **Exclusions of copyright**

Certain official works are excluded from protection:

- laws and decisions by judicial and administrative bodies
- public speeches and addresses
- news of the day.

#### **Authorship and ownership of copyright**

The law provides for rights of an economic nature and of a moral nature.

The author is entitled to the moral rights. These include –

- the right to claim authorship
- the right to defend the integrity of the work by opposing distortion or mutilation thereof
- the right to keep the work unpublished.

The moral rights may not be transferred.

The author is also entitled to economic rights; these may be transferred to a subsequent copyright owner and include the right to enjoy the benefit of the work and the exclusive right to –

- publish, reproduce or communicate the work to the public
- translate, adapt or arrange the work, or transform it.

### **Duration of copyright**

The economic rights endure for the lifetime of the author plus 50 years after his death (or 25 years in the case of photographic works and works of applied art).

The moral rights continue to subsist after the death of the author.

### **Copyright infringement**

Anyone who uses a literary, artistic or scientific work without the authorisation of the author/owner shall be deemed to have committed an offence. These offences are punishable by a fine and imprisonment.

Civil proceedings may also be instituted.

### **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Angola.



# BENIN

## GENERAL INFORMATION

The Republic of Benin (formerly the People's Republic of Benin) is an independent state in West Africa. It is bordered in the north by Burkina Faso and Niger, in the east by Nigeria, in the south by the Gulf of Guinea, and to the west by Togo.



<b>Area:</b>	112 622 km <sup>2</sup>
<b>Population:</b>	9 million
<b>Capital:</b>	Porto Novo
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 14.2 billion (2010)
<b>Internet domain:</b>	.bj
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Crude oil; cotton; palm products; cocoa; cashews; seafood
<b>Imports:</b>	Petroleum products; intermediate goods; capital goods; light consumer goods

## International/regional conventions

Benin is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1983)
- Berne Convention (since 1961)
- Hague Agreement on Designs (since 1986)
- Nairobi Treaty on Olympic Symbol (since 2006)
- Nice Agreement on Classification of Marks (since 1979)
- Paris Convention (since 1967)
- Patent Cooperation Treaty (since 1987)
- WIPO Convention (since 1975)
- WIPO Copyright Treaty (since 2006)
- WIPO Performances and Phonograms Treaty (since 2006)
- WTO/TRIPS (since 1996)

## IP legislation

Benin is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. Thus, in order to join OAPI, Benin had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

### **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

### **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# BOTSWANA

## GENERAL INFORMATION

Botswana, formerly a British protectorate, became independent in 1966. It is a landlocked country in southern Africa, bordered by Zimbabwe to the north-east, South Africa to the south-east, and Namibia to the west. The so-called Caprivi Strip of Namibia extends along its northern border.



<b>Area:</b>	581 730 km <sup>2</sup>
<b>Population:</b>	2.0 million
<b>Capital:</b>	Gaborone
<b>Currency:</b>	Pula
<b>GDP:</b>	\$26.5 billion (2010)
<b>Internet domain:</b>	.bw
<b>Languages:</b>	English, Tswana (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Diamonds; copper; nickel; beef; soda ash; textiles
<b>Imports:</b>	Foodstuffs; vehicles and transport equipment; textiles; petroleum products; wood and paper products; metal and metal products

## International/regional conventions

Botswana is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1985)
- Berne Convention (since 1998)
- Hague Agreement on Designs (since 2006)
- Harare Protocol (of ARIPO) (since 1985)
- Lusaka Agreement (ARIPO) (since 1985)
- Madrid Protocol on Marks (since 2006)
- Paris Convention (since 1998)
- Patent Cooperation Treaty (since 2003)
- WIPO Convention (since 1998)
- WIPO Copyright Treaty (since 2005)
- WIPO Performances and Phonograms Treaty (since 2005)
- WTO/TRIPS (since 1995)

## IP legislation

- Industrial Property Act no 8 of 2010 (not yet in force)

### Trade marks

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

### Patents

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

#### Designs

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

#### Copyright

- Copyright Act no 13 of 1966
- Copyright and Neighbouring Rights Act no 8 of 2000
- Copyright and Neighbouring Rights Regulations, 2007

## TRADE MARKS

### Law

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

Botswana is a member of the ARIPO (Banjul Protocol), the Madrid Protocol, the Paris Convention and the WTO/TRIPS.

### Trade mark protection

The Act expressly provides that, by the registration of a trade mark, the owner acquires the exclusive right to the mark, in the sense that only the owner can authorise other persons to use the mark. Provision is made for the registration of trade marks in respect of goods and services, and for collective marks.

Trade mark protection may be obtained by way of a national filing in Botswana; or by way of a convention application claiming the priority of an earlier application in a convention country (see the section on **Convention priority** below); or by way of an ARIPO registration (see the section on **Banjul Protocol** below).

Although Botswana has also acceded to the Madrid Protocol, the current domestic laws have not been amended to provide for trade mark registrations via the Madrid Protocol. Accordingly, it is not certain whether enforceable rights can at this time be obtained in Botswana via a Madrid registration. (The Industrial Property Act, 2010, which has not yet been put into effect, provides for applications under the Madrid Protocol.)

### Protection of well-known marks

A mark will not be registered if it is identical to, or confusingly similar to, a mark which is well known in Botswana for identical or similar goods or services, or if it is well known and registered in Botswana for goods and services not identical or similar to those of the application if, in the latter case, the use of the mark to which the application relates would indicate a connection with the goods or services of the well-known mark and the interests of the owner of the well-known mark are likely to be prejudiced.

### Advantages of trade mark registration

The owner of a registered trade mark has the exclusive right to authorise the use of the mark. The owner also has the right to institute court

proceedings against any person who uses the mark without the authorisation by the owner.

### **Types of trade marks**

Provision is made for trade marks in respect of goods and services, and for collective marks.

### **Definition of a mark**

A mark is defined as any visible sign capable of distinguishing the goods or services of an enterprise.

### **Definition of a collective mark**

A collective mark is defined as any visible sign designated as such in the application for registration and capable of distinguishing the origin or other common characteristic, including the quality, of goods or services of different enterprises which use the sign subject to the control of the registered owner thereof.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

Botswana is a member of the Paris Convention. An applicant for a trade mark who has applied for the same trade mark in another convention country, is entitled to a priority right, to be accorded the same effective date as the first filed application, provided the Botswana application is filed within six months of such earlier filing.

### **Application**

An application is filed at the Botswana Trade Marks Office, administered by the Ministry of Trade and Industry, which operates under the supervision of the Registrar of Companies and Intellectual Property.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- graphic reproductions, eg electronic prints, of the trade mark
- list of the goods or services to be covered
- priority document (certified copy), if priority is claimed.

### **Examination/procedure**

The Registrar examines the application to determine whether it complies with the formal and substantive requirements.

The Registrar shall, if he is satisfied that the application complies with the requirements, accept the application and publish the application for opposition purposes in the Trade Marks Journal. If no opposition is entered, the registration certificate will be issued.

**Opposition**

Any interested person may, within three months from the date of publication, lodge a notice of opposition to the registration of the mark.

Extensions of the opposition period may be requested from the Registrar and may be granted at his discretion. An extension of three months of the opposition term will generally be granted.

**Opposition proceedings**

Opposition proceedings are prescribed by Regulation. A notice of opposition, setting out the grounds of opposition and accompanied by supporting evidence, is filed by the opponent, whereafter a counter-statement must be filed by the trade mark applicant within two months, setting out the grounds relied on in defence of the trade mark. This is followed by a hearing before the Registrar. If no counter-statement is filed, the applicant is deemed to have abandoned the application.

**Grounds of opposition**

Both absolute and relative grounds of opposition are available. These include –

- that the mark does not fall within the definition of a mark
- that the mark is incapable of distinguishing the goods or services of one enterprise or business from those of another enterprise or business
- that the mark is contrary to public order or morality
- that the mark is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics
- that the mark is identical to, or is an imitation of, or contains an armorial bearing, flag or other emblem or name or sign or hallmark of any state, inter-governmental or international organisation
- that the mark is identical to a mark belonging to a different owner and already on the register, or the subject of an application with an earlier filing date or priority date, in respect of the same or closely related goods or services, or so nearly resembles such a mark as to be likely to deceive or cause confusion
- that the mark is identical to, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Botswana for identical or similar goods or services of another enterprise; or if it is well known and registered in Botswana, for goods or services which are not identical or similar to those in respect of which registration is applied for, and the use of that mark in relation to those goods or services would indicate a connection with the owner of the well-known mark, and the interests of the owner of the well-known mark are likely to be prejudiced by such use.

**Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of filing, and thereafter is renewable for like periods. It is possible to effect

the late payment of the renewal fee within a grace period not exceeding the six months granted by the Registrar.

### **Cancellation/removal of a trade mark**

Any interested person may apply in the prescribed manner to the Registrar to remove a mark from the register.

### **Grounds for cancellation/removal of a trade mark**

A trade mark registration may be invalidated and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds of opposition** above), or on the ground of non-use (see the section on **Use requirement and cancellation** below).

Certain further grounds for the invalidation of collective marks are provided.

### **Use requirement and cancellation**

A registered trade mark may be cancelled if it has not been used for a continuous period of three years or more up to one month preceding the date of the request for cancellation, unless circumstances existed which prevented the use of the mark.

### **Assignment**

The rights in a mark may be transferred by cession, assignment, testamentary disposition or by operation of law. An assignment may be made with or without the goodwill of the business. Recordal of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment (original or certified copy).

### **Licensing/registered users**

Licensing of a trade mark is recognised. Recordal of the licence agreement is required in order to be effective against third parties. Any licence agreement must provide for the effective control by the licensor, of the quality of the goods and services of the licensee in connection with which the mark is used.

Requirements for recordal:

- power of attorney by the licensee (simply signed)
- power of attorney by the licensor (simply signed)
- licence agreement (original or certified copy).

### **Amendment**

A trade mark registration may be amended by the registered owner by altering the goods or services, or by altering the mark as such (provided the

change does not affect its identity), or by changing the name and/or address of the owner, or by voluntarily cancelling the registration.

Requirements for amendment:

- power of attorney (simply signed)
- supporting document, eg certified instrument of change of name and/or address
- approval by the Minister (in case of change in ownership of a collective mark).

### **Rights conferred by registration**

The registration of a mark confers on the owner the right to authorise other persons to use the mark. The owner thus has the right to institute court proceedings against any person who infringes the mark by using that mark without the authorisation of the owner.

### **Trade mark infringement**

Proceedings for infringement can be brought by the owner of a trade mark before the court.

The Act provides for three types of infringement:

- use of the mark without the owner's authorisation, or the performing of acts which make it likely that infringement will occur
- the use of a sign similar to the registered mark in relation to goods or services similar to those for which the mark has been registered, where confusion may arise in the public
- the use of a sign which constitutes a reproduction, an imitation or a translation of a registered mark which is well known in Botswana in relation to goods or services which are not similar to those in respect of which the trade mark is registered, if the use of that mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark, and the interests of the owner of the well-known mark are likely to be prejudiced by such use.

The Act also provides that intentional or wilful infringement constitutes a criminal offence.

### **Defences to trade mark infringement**

The rights of a registered trade mark owner do not extend to acts in respect of articles put on the market in Botswana by the owner or with his consent.

No other defences are listed in the Act.

### **Relief for trade mark infringement**

A successful applicant in civil proceedings is usually entitled to the following relief:

- interdict (injunction) ordering the respondent to refrain from further infringement



- delivery-up or destruction of any infringing product or article, or any product of which the infringing product forms an inseparable part
- damages or an account of the profits derived from the infringement.

Criminal action may also be instituted, depending on the nature of the infringement; the penalty is a fine or imprisonment or both.

### **Common law rights**

The Act refers to common law rights to be enforceable only in regard to trade names (ie the name or designation by which a business or enterprise is distinguished), against any unlawful act committed by a third party. Any use which is likely to mislead the public shall be deemed to be unlawful.

### **Banjul Protocol**

Since Botswana is a member of ARIPO and the Banjul Protocol, a trade mark registration may be effected in terms of the Banjul Protocol. A mark in respect of which Botswana is a designated state, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect and enjoy the same protection in Botswana as a mark registered under the Industrial Property Act, 1996, unless the Registrar communicates to ARIPO, within the prescribed period, a decision that the mark shall have no effect in Botswana. For more information refer to the chapter on **ARIPO**.

### **Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg 'Regd. TM') or symbol ® is optional.

## **PATENTS**

### **Law**

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

Botswana is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### **Patent protection**

Botswana has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application. Accordingly, patent protection is currently available by way of a national filing or via an ARIPO application designating Botswana.

Botswana is a member of the Patent Cooperation Treaty (PCT); however, at the present time the domestic laws have not been amended to provide for the PCT. Therefore, although it is possible to file PCT applications designating Botswana, it is not clear whether enforceable rights will at this time be obtained by patents granted on PCT national phase filings in Botswana. The

Industrial Property Act, 2010, which has not yet been put into effect, provides for PCT applications.

### **Types of patents**

The Act provides for conventional patents in respect of inventions that are new, inventive and industrially applicable; and for divisional patents derived from an original application covering more than one invention.

The Act also provides for utility model certificates for inventions that are new and industrially applicable. An application for a utility model certificate may be converted to a patent application, and *vice versa* (see the section on **Utility model certificates** below).

### **Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable. An invention may relate to a product or a process.

The following, even if they are inventions, are not patentable:

- discoveries
- scientific theories or mathematical methods
- literary, dramatic, musical or artistic works or other aesthetic creations
- schemes, rules or methods for doing business, performing a mental act or playing a game
- programs for computers
- methods for the treatment of the human or animal body by surgery
- diagnostic methods practised on the human or animal body.

Although methods for the treatment of the human or animal body and diagnostic methods are not patentable subject matter, the prohibition does not extend to products for use in those methods.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Botswana is designated (see the **Note** below)
- an ARIPO application in which Botswana is designated
- a divisional application, where the original application covers more than one invention
- a utility model application, which may before refusal or grant be converted to a patent application.

**Note:** As indicated above (see the section on **Patent protection** above), Botswana has not yet introduced enabling domestic legislation to provide for PCT applications. The new Industrial Property Act, 2010, which has not yet been put into effect, provides for PCT applications.

## **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Botswana Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor, or a statement by the applicant justifying his right to the invention
- specification (including claims, drawings and abstract), in English
- certified copy of the priority application (if applicable).

Failure to file the priority document within the stipulated time period will lead to the loss of the priority claim (see the section on **Convention priority** below).

## **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

## **Novelty**

Absolute novelty is required; an invention is considered to be new if it does not form part of the prior art. Prior art means anything which has been disclosed to the public, in Botswana or elsewhere, in tangible form or orally or by use or in any other way.

## **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Botswana filing date or priority date (if convention priority is claimed) is provided, during which period prior disclosure of the invention by the inventor or by a third party who obtained the information from the inventor, will not affect the novelty/patentability of the invention.

## **Inventiveness**

An invention is considered to involve an inventive step if, having regard to the prior art, it would not have been obvious to a person having ordinary skill in the art.

## **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Botswana is filed within 12 months from the earlier application.

A certified copy of the priority application has to be filed within three months of the filing date, or the claim to priority will be lost.

### **Examination/procedure**

Applications are subjected to formal examination. In practice, substantive examination of all applications is also conducted and is carried out by the ARIPO examiners on behalf of the Botswana Patent Office. The Act also makes specific provision for the Registrar to call on applicants to provide information on corresponding patent applications in other jurisdictions.

### **Opposition**

The Act does not provide for opposition by third parties to the grant of a patent.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he grants the patent. Granted patents are published in the Botswana Patent Journal.

### **Duration and maintenance**

The duration of a patent is 20 years.

Maintenance fees are payable annually from the filing date, in respect of pending applications and granted patents. A six months grace period for payment is provided. Failure to pay the annual maintenance fees before the deadline or within the six month grace period, leads to the lapsing of the application/patent.

### **Restoration**

The Act does not make any provision for the restoration of a lapsed patent.

### **Revocation**

Revocation is possible by a competent judicial authority on application by an interested person and on specific grounds, namely –

- that the invention is not an invention within the meaning of the term as defined
- that the patentee is not a person entitled to apply for the patent
- that the invention is not patentable, eg lacks novelty or inventiveness
- that the invention is subject matter excluded from patent protection
- that the application did not comply with the requirements laid down in the Act, ie the invention was not fully disclosed, claims not fully supported
- that the applicant failed to inform the Registrar of any corresponding foreign applications or has furnished information which was false
- that the patent was obtained by a misrepresentation.

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### **Assignments and voluntary licences**

Voluntary licences may be granted under a patent. A patent may also be assigned. Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

The Act also provides for the granting of compulsory licences by the High Court, eg in the case of inadequate or non-working of a patent (see the section on **Working** below), or by the Minister in cases of public interest, particularly national security, nutrition or health.

### **Amendments**

Amendments to the specification can be made prior to or even after grant, but any amendment may not go beyond the disclosure of the invention in the application as filed. Although it is not possible to amend a patent in any material manner, the Registrar does have the power to correct any clerical error in any documents filed in support of an application, or an error appearing in the register.

### **Effect of a patent**

The effect of a patent is to grant to the patent owner the exclusive right to authorise other persons to exploit the patented invention in Botswana.

### **Infringement**

No person may exploit in Botswana an invention patented in Botswana without authority, in writing, by the owner of the patent. Exploitation is defined to include:

- making, importing, offering for sale, selling or using a patented product, or stocking that product for purposes of sale
- using a patented process or doing any of the abovementioned acts in respect of a product from that process.

Certain exceptions to infringement are provided for, eg exploitation authorised by the Minister when necessitated by national security, nutrition or health.

The Act also provides that intentional or wilful infringement constitutes a criminal offence.

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement (wilful infringement may constitute an offence). Civil remedies could include an interdict, damages, delivery-up or destruction of the infringing goods, and an account of profits. Criminal sanctions include a fine, a term of imprisonment and also possible confiscation and/or destruction of the infringing products.

### **Marking**

In order for the patent owner to recover damages or to obtain an account of profits, the patented product must be marked with the word 'patent' or 'patented' accompanied by the number of the patent.

### **Working**

At any time after the expiration of three years from the date of grant of a patent, or four years from the filing date of the patent application, whichever is the later, the High Court may grant a compulsory licence on the ground that the market in Botswana for the patented invention is not adequately being supplied, or is not being supplied on reasonable terms.

### **Utility model certificates**

The Act also provides for the registration of utility models and the issuance of utility model certificates in respect of inventions which are new and industrially applicable, ie even though such inventions lack inventiveness.

A utility model certificate expires seven years after the filing of the application. An application for a utility model certificate may, prior to the grant or refusal thereof, be converted to a patent application. A patent application may likewise, prior to grant or refusal, be converted to an application for a utility model certificate.

## **DESIGNS**

### **Law**

- Industrial Property Act no 14 of 1996
- Industrial Property Regulations, 1997

Botswana is a member of the Paris Convention, the ARIPO (Harare Protocol), the Hague Agreement and the WTO/TRIPS.

### **Design protection**

Design protection may be obtained by a national filing or via an ARIPO application designating Botswana. Botswana is a member of the Paris Convention, so that convention priority can be claimed from an earlier application (see the section on **Convention priority** below). Botswana is also a member of ARIPO, and has implemented the Harare Protocol of ARIPO (which regulates patent and design filings in ARIPO) in its national laws, thereby enabling valid design protection for applicants seeking to obtain a design registration via ARIPO.

Botswana is also a member of the Hague Agreement, so that design protection can theoretically be obtained by way of an international application under the Hague Agreement designating Botswana. However, Botswana has not yet introduced enabling domestic legislation to provide for such international applications, so that it is not certain whether enforceable rights can at this time be obtained by way of such an international application. The new Industrial Property Act, 2010, which has not yet been put into effect, provides for applications under the Hague Agreement.

**Registrable subject matter**

An industrial design is defined to mean any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, which composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, provided that it does not consist of anything which serves to obtain a technical result and leaves no freedom as regards arbitrary features of appearance.

**Classification of designs**

The articles to which designs may be applied are classified into different classes. The Locarno International Classification of Designs is applied. Separate applications are required for each class.

**Types of applications**

Application for design registration may be made by way of –

- a non-convention filing
- a convention application claiming priority of the first-filed application in a convention country
- an application filed via ARIPO and designating Botswana
- an international application under the Hague Agreement designating Botswana (see the **Note** below).

**Note:** As indicated above (see the section on **Design protection** above), Botswana has not yet introduced enabling domestic legislation to provide for the Hague applications. The new Industrial Property Act, 2010, which has not yet been put into effect, provides for the Hague registrations.

**Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Botswana Designs Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**. Foreign applicants must have a local address for service.

A single application filed in Botswana may be in respect of two or more designs, provided that the designs relate to the same class of the international classification or the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment document (if applicable)
- drawings, photographs or other graphic reproductions of the article embodying the design
- certified copy of priority document (if applicable).

Where the design is two-dimensional, the application may be accompanied by a specimen of an article embodying the design.

### **Applicant**

The author or creator, or his assignee, may apply.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Botswana is filed within six months from the earlier application.

A certified copy of the priority application has to be filed within three months of the filing date or the claim to priority will be lost.

### **Novelty**

A design shall be considered to be novel if it has not been disclosed anywhere in the world to the public by publication in tangible form, or by use or in any other way, prior to the filing date or priority date (if priority is claimed). However, a 12 month grace period, prior to the filing date or priority date, applies in respect of disclosure of the design by the creator or by a third party who obtained the information directly or indirectly from the creator. Such a disclosure will not affect the registrability of the design.

### **Examination/procedure**

Formal examination is conducted. The Act also provides that examination should be conducted to ensure that the design falls within the definition of a 'registrable' design. The Act further prohibits registration of designs which are contrary to public order or morality.

### **Opposition**

The Act does not provide for opposition by third parties to the registration of a design.

### **Duration and maintenance**

The initial term of the design registration is five years, which term is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration. If the renewal fee is not paid, the design registration expires.

### **Restoration**

No provision for restoration.

### **Revocation/invalidation**

Any interested person may apply to the High Court for the invalidation of a design registration, either wholly or in part in respect of any particular article covered by the registration. Invalidation may be ordered on any of the following grounds, namely –

- that the design was not new



- that the applicant for registration was not the owner of the design
- that the application was made with the intention of defrauding the owner of the design
- on any ground on which the Registrar could have refused to register the design.

### **Assignments and licences**

The right to a design may be transferred, and voluntary licences may be granted. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

No provision is made for compulsory licences for designs in Botswana.

### **Effect of a design registration**

A design registration gives the owner the right to authorise other persons to exploit the design.

The registered owner has the exclusive right, subject to other rights on the register, in Botswana to make, import or sell any article embodying the registered design or a design not substantially different therefrom, when such acts are undertaken for commercial purposes. The rights of the owner do not extend to articles which have been put on the market in Botswana by the owner or with his consent.

### **Infringement**

No person may exploit in Botswana a design registered in Botswana without the written authority of the owner. The term 'exploit' is defined to mean to make, import or sell an article embodying the registered design or a design not substantially different therefrom.

The Act also provides that intentional or wilful infringement constitutes an offence. Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Civil remedies could include an interdict, damages, delivery-up or destruction of the infringing goods, and an account of profits. Criminal sanctions include a fine, a term of imprisonment and also possible confiscation and/or destruction of the infringing products.

### **Marking**

Optional.

### **Working**

No requirements.

## COPYRIGHT

### Law

- Copyright Act no 13 of 1966
- Copyright and Neighbouring Rights Act no 8 of 2000 (the Act was put into effect on 1 October 2006)
- Copyright and Neighbouring Rights Regulations, 2007

Botswana is a member of the Berne Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

Copyright protection applies to 'works', which are defined to include literary and artistic works which are original intellectual creations, as well as derivative works.

Literary and artistic works are defined to include:

- books, pamphlets, articles, computer programs and other writings
- speeches, lectures, addresses, sermons and other oral works
- dramatic, dramatic-musical works, pantomimes, choreographic works and other works for stage productions
- expressions of folklore
- musical works
- works of architecture
- works of drawing, painting, sculpture, engraving, lithography, tapestry and other works of fine art
- photographic works
- works of applied art
- illustrations, maps, plans, sketches and three-dimensional works relating to geography, topography, architecture or science.

Derivative works include:

- translations, adaptations, arrangements and other transformations or modifications of works
- collections of works, collections of mere data (databases), whether in machine readable or other form, and collections of expressions of folklore, provided such collections are original by reason of selection, co-ordination or arrangement.

### Exclusions of copyright

No copyright shall be extended to:

- any idea, procedure, system, method of operation, concept, principle, discovery or mere data, even if expressed or explained or embodied in a work

- any official text of a legislative, administrative or legal nature
- a broadcast that infringes the copyright in another broadcast
- a sound recording or film that is a copy of a previous sound recording or film.

### **Authorship and ownership of copyright**

The author of a work will in general be the owner of the copyright in the work, consisting of the economic rights and the moral rights.

### **Duration of copyright**

Copyright generally endures for the life of the author plus 50 years, except in the case of works of applied art when the duration is 25 years from the making of the work.

### **Protection afforded by copyright**

The economic rights confer on the owner the exclusive right to carry out, or to authorise, the following acts:

- reproduction of the work
- translation of the work
- adaptation, arrangement or transformation of the work
- first public distribution of the work, by sale, rental or otherwise
- rental or public lending of certain types of works
- importation of copies of the work (even copies made with the consent of the copyright owner)
- public display of the original or copy of the work
- public performance of the work
- broadcasting of the work.

The moral rights confer on the author the right –

- to be recognised and indicated as the author
- not to be indicated as the author
- to object to any distortion, mutilation or modification of the work which would be prejudicial to his honour or reputation.

The moral rights may not be transferred during the life of the author.

### **Requirements for subsistence of copyright**

No provision is made for the registration of copyright. A work eligible for protection is protected under the Act by virtue of the sole fact of its creation, irrespective of its mode or form of expression, and of its content, quality and purpose. However, as indicated above, protection will not extend to ideas, procedures, methods of operation, concepts, principles or mere data expressed, described or embodied in a work.

### **Exceptions to copyright protection**

The Act has extensive provisions regarding the exceptions to copyright, including acts such as:

- private reproduction for personal purposes (subject to certain conditions)

- quotations, with acknowledgement of the source and in accordance with fair practice
- reproductions for teaching (subject to certain conditions)
- reprographic reproduction by libraries and archives.

### **Assignment and licensing of copyright**

The economic rights can be assigned or licensed. An assignment or licence must be in writing, in either case signed by both parties.

### **Copyright infringement**

Extensive provision is made for the enforcement of copyright. Civil remedies include injunctions, the impounding of suspected illegal copies, payment of damages, including profits of the infringing party attributable to the infringement, and exemplary damages

Certain infringing acts constitute offences; punishment can be a fine or imprisonment or both.

Provision is also made for a mechanism to conserve evidence by the search for and seizure of documents and other items; and for certain customs measures to deal with the importation of illegal copies.

## **PLANT BREEDERS' RIGHTS**

It has not been possible to establish whether or not protection for plant breeders' rights or other *sui generis* protection for plants is currently available in Botswana.

# BURKINA FASO

## GENERAL INFORMATION

The Republic of Burkina Faso is a landlocked country sharing its borders with six nations, namely Mali to the north and west, Ivory Coast, Ghana, Togo and Benin to the south, and Niger to the east. Burkina Faso lies to the south of the Sahara Desert.



<b>Area:</b>	274 200 km <sup>2</sup>
<b>Population:</b>	16.2 million
<b>Capital:</b>	Ouagadougou
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 20 billion (2010)
<b>Internet domain:</b>	.bf
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cotton; gold; livestock and livestock products (including hides and skins)
<b>Imports:</b>	Machinery and food products; capital goods; petroleum

## International/regional conventions

Burkina Faso is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1983)
- Berne Convention (since 1963)
- Lisbon Agreement on Appellations of Origin (since 1975)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1989)
- Phonograms Convention (since 1988)
- Rome Convention (since 1988)
- WIPO Convention (since 1975)
- WIPO Copyright Treaty (since 2002)
- WIPO Performances and Phonograms Treaty (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

Burkina Faso is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. Thus, in order to join OAPI, Burkina Faso had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

## **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# BURUNDI

## GENERAL INFORMATION

The landlocked Republic of Burundi lies on the eastern shore of Lake Tanganyika in Central Africa. It is bordered by Rwanda to the north, Tanzania to the east and south, and the Democratic Republic of the Congo to the west.



<b>Area:</b>	27 830 km <sup>2</sup>
<b>Population:</b>	9.9 million
<b>Capital:</b>	Bujumbura
<b>Currency:</b>	Burundi Franc
<b>GDP:</b>	\$ 3.4 billion (2010)
<b>Internet domain:</b>	.bi
<b>Languages:</b>	French, Kirundi (official languages), Swahili
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; tea; cotton; hides and skins
<b>Imports:</b>	Capital goods; petroleum products; foodstuffs; consumer goods

## International/regional conventions

Burundi is a member of the following international agreements:

- Paris Convention (since 1977)
- WIPO Convention (since 1977)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Law no 1/13 of 2009 relating to Industrial Property in Burundi

Patents

- Law no 1/13 of 2009 relating to Industrial Property in Burundi

Designs

- Law no 1/13 of 2009 relating to Industrial Property in Burundi

**Note:** Regulations to implement the 2009 Law are still pending. However, the Registrar (referred to in the 2009 Law as the Industrial Property Director) is currently applying the 2009 Law. Accordingly, this chapter is based on that Law.

Copyright

- Law no 1/021 of 2005 relating to the Protection of Copyright and Related Rights in Burundi
- Decree no 100/2011 relating to the Establishment of the Copyright Office of Burundi

## **TRADE MARKS**

### **Law**

- Law no 1/13 of 2009 relating to Industrial Property in Burundi

Burundi is a member of the Paris Convention and the WTO/TRIPS.

### **Trade mark protection**

The Law makes provision for the registration of trade marks for goods and services, collective marks, certification marks, and geographical indications, and for the protection of trade names.

### **Protection of well-known marks**

A mark which is identical or similar to a mark which is well known in Burundi for identical or similar goods, will not be registrable; also if it is identical or similar to a mark which is well known and registered in Burundi for goods or services not identical or similar, if the registration of the mark is likely to harm the interests of the owner of such well-known and registered mark.

### **Types of trade marks**

The following types of trade marks are registrable:

- trade marks for goods and services
- certification marks
- collective marks
- geographical indications.

### **Definition of a mark**

A mark is defined to mean any sign capable of being represented graphically and capable of distinguishing the products or services of a business from those of other businesses, and particularly words, names of persons, motifs, letters, colours or combinations of colours, or figures, or the form or packaging of products, or holograms, sounds, smells or tastes.

### **Definition of a trade mark**

To be registrable as a trade mark, a mark must make it possible to distinguish the products or services of a firm from those of other firms.

### **Definition of a certification trade mark**

Certification marks are signs or combinations of signs suitable for designating any characteristic common to goods or services, particularly quality, origin or method of production, where the use is controlled by the owner of the mark.

### **Definition of a collective trade mark**

Collective marks are any marks belonging to a group such as a cooperative, association or federation of industrialists, producers or merchants.



**Definition of geographical indication**

A geographical indication is an indication used to identify a product as being from the territory of a country, when a quality, reputation or other characteristic of the product can be essentially attributed to the geographical origin.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

**Convention priority**

Burundi is a member of the Paris Convention and it is possible to claim convention priority, provided a corresponding application is filed in Burundi within six months of the filing of the first-filed application.

**Application**

A trade mark application must be filed with the Director of Industrial Property and the following is required:

- full particulars of the applicant
- power of attorney (simply signed), in French
- reproduction of the mark
- certified copy of the priority document (if applicable), in French or with French translation.

**Examination/procedure**

Applications are examined as to formalities as well as substantive requirements and for conflict with prior marks. If the application is found to be acceptable, it must be published in the prescribed manner.

A mark may not be validly registered if –

- it is not capable of distinguishing the goods or services of the applicant from those of other parties
- it is contrary to public order or morality
- it is likely to mislead the public, especially as regards the geographical origin or characteristics of the goods or services
- it imitates coats of arms, flags, names or signs etc of a state or an intergovernmental organisation
- it is identical or similar to a well-known mark (in certain circumstances)
- it is identical or similar to a mark belonging to another person and which is registered or the subject of an earlier application
- the application for registration was filed in bad faith.

**Opposition**

Interested persons may oppose an application for registration within 30 days of its publication.

**Opposition proceedings**

A notice of opposition is lodged with the Industrial Property Director, and the notice of opposition is published in the Official Journal. Within a period

of 90 days the opponent must submit the grounds for the opposition in writing, failing which the opposition is deemed to be abandoned. If the applicant submits a reply, the Industrial Property Director must forward a copy to the opponent. After hearing the parties and examining the case, the Industrial Property Director makes a decision.

### **Grounds for opposition**

The opposition may be based on any one or more of the grounds on which the application could have been refused (see the section on **Examination/procedure** above).

### **Duration and renewal**

A trade mark is valid for a period of 10 years from the filing date, and is thereafter renewable for like periods of 10 years.

Renewal requirement:

- power of attorney (simply signed), in French.

### **Cancellation/removal of a trade mark**

Any interested party may apply to the court for the revocation of the registration of a mark; requests for revocation must be filed within five years of the date of grant (except in cases where the registration was obtained in bad faith).

### **Grounds for revocation/removal of a trade mark**

A registration may be revoked on any one of the grounds on which the registration could have been refused or opposed (see the section on **Examination/procedure** above) in addition to non-use, discussed below.

### **Use requirement and cancellation**

Use of a registered trade mark is a requirement, and non-use for a period of three years or more shall render a trade mark vulnerable to cancellation, except where the proprietor can show that the non-use was due to special circumstances.

### **Assignment**

An assignment must be recorded in order to be binding on third parties.

Requirements for recordal:

- power of attorney by assignee (simply signed), in French
- deed of assignment, with sworn French translation.

### **Licensing/registered users**

Licensing is recognised. A licence must be recorded in order to be binding on third parties.

Requirements for recordal:

- power of attorney by proprietor and licensee (simply signed), in French
- licence agreement, with sworn French translation.

**Amendment**

Provision is made for the correction of any error in translation or other formal oversight.

**Rights conferred by registration**

The owner of a registered trade mark has the exclusive right to prevent any third party from making use, in the course of commercial operations, of identical or similar signs on identical or similar goods or services, where such use would lead to confusion.

**Trade mark infringement**

The owner of a registered trade mark has the exclusive right to prevent third parties from making use, in the course of commercial operations, of identical or similar marks on goods or services which are identical or similar. Additional protection is afforded to well-known registered trade marks, in that the proprietor may restrain the use of an identical or similar mark in relation to goods or services which are not similar to those for which the well-known mark is registered, provided the use of the mark is likely to create a link with the owner of the well-known mark and is detrimental to the interests of the owner.

**Defences to trade mark infringement**

The rights conferred by registration do not extend to acts relating to articles placed on sale in Burundi or any other country by the owner of the registration or with his consent.

**Relief for trade mark infringement**

The trade mark owner may institute proceedings against any party who infringes the mark by using it without consent, or who performs acts likely to constitute infringement. An injunction (interdict) may be obtained to prevent future infringement, and damages may be awarded.

**Common law rights**

The prior user of a mark, even though not registered and not the subject of a pending application, and who has used the mark in good faith for at least six months prior to the application, may in certain circumstances oppose an application by another for registration of the mark or a similar mark on the basis of such prior use.

**Marking of goods**

The Act is silent on the marking of goods.

## PATENTS

### Law

- Law no 1/13 of 2009 relating to Industrial Property in Burundi

Burundi is a member of the Paris Convention and the WTO/TRIPS.

**Note:** As indicated earlier, regulations to implement the 2009 Law are still pending. However, the Registrar (referred to in the 2009 Law as the Industrial Property Director) is currently applying the 2009 Law. Accordingly, this chapter is based on that Law.

### Patent protection

Patent protection is available by way of a national filing. Burundi is a member of the Paris Convention so that convention priority may be claimed (see the section on **Convention priority** below). Burundi is not a member of the PCT so that applications cannot be filed in Burundi via PCT. However, the Law does provide that the Industrial Property Director must take into consideration an international search report and an international preliminary report issued under PCT.

### Types of patents

The Law provides for:

- conventional patents, where a patent is granted for an invention
- divisional patents, where an application which covers more than one invention is divided into two or more separate applications
- patents/certificates of addition, where changes, improvements or additions are made to the invention of the principal patent
- utility model certificates, whereby protection may also be obtained for an invention.

### Patentable subject matter

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- discoveries, scientific theories and mathematical methods
- plans, principles or methods in the field of economic activities, in the performance of purely intellectual activities or in games
- methods of surgical or therapeutic treatment of the human or animal body as well as diagnostic methods (this exclusion does not apply to products used for implementation of one of these methods)
- natural substances, even if purified, synthesised or otherwise isolated in another manner (this provision does not apply to processes making it possible to isolate these natural substances from their original environment)
- known substances for which a new use has been discovered

- plants and animals, including parts thereof, other than microorganisms, and essentially biological processes for the breeding of plants and animals, other than non-biological and microbiological processes
- animal breeds and plant varieties
- inventions the exploitation of which is contrary to public order or morality
- pharmaceutical products, up until 1 January 2016.

**Note:** Process inventions carried out by a computer, and product inventions implemented by a computer are, not excluded from patent protection.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a divisional application, where the original application covers more than one invention
- an application for a certificate of addition, to add improvements or to make changes to the invention
- an application for a utility model, which may be converted into a patent application.

### **Application**

Applications are filed with the Industrial Property Office. Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in French
- assignment from the inventor, or statement by the applicant justifying its right to the invention (if applicable; simply signed), in French or with French translation
- specification (including claims, drawings and abstract), in French
- certified copy of the priority document (if applicable), with French translation.

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it has not been part of the state of the art. The state of the art consists of everything that has been made available to the public, regardless of the place, means or manner, prior to the filing or priority date.

### **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Burundi filing date or priority date (if convention priority is claimed) is provided during which disclosure will not prejudice novelty in the following cases:

- where disclosure of the invention resulted from abuse committed by a third party with regard to the applicant or his predecessor in title
- where the invention was displayed by the applicant or his successor at an official or officially recognised international exhibition.

### **Inventiveness**

An invention is deemed to involve an inventive step if the differences between the claimed invention and the state of the art would not be obvious to a person skilled in the art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Burundi is filed within 12 months from the earlier application.

### **Examination/procedure**

Applications are subjected to formal examination, which takes place automatically. Although the Law provides that applications are to be examined to determine that the invention is new, involves an inventive step, and is industrially applicable, and that no prior pending application concerning the same invention is about to be granted, this provision is not in operation. If the application is found to be in order, it is published.

### **Opposition**

Any interested person may, within 90 days following the publication of the application, on payment of the official fees, file a notice of opposition with the Industrial Property Office. The applicant has 60 days to submit a reply. The matter is heard and decided by the Director.

### **Publication**

The Law requires that the Industrial Property Director must publish the application within 18 months from the filing date.

### **Duration and maintenance**

The duration of a patent is 20 years from the filing date. Maintenance fees are payable annually, starting from the first anniversary of the filing date. A six months grace period is provided subject to payment of surcharges.

**Note:** The Act provides for payment of annual maintenance fees. However, in the absence of any implementing regulations detailing the fees payable, at this stage, it is not practically possible to pay maintenance fees in Burundi.

### **Restoration**

It is possible to request restoration of a lapsed patent due to non-payment of annual fees owing to circumstances outside the patent holder's control.

The request for restoration must be made to the Director, within six months as from the date on which the circumstances ceased to exist, and at the latest within two years as from the date on which the renewal fee should have been paid.

**Revocation**

No provision.

**Assignments**

Assignments are permitted and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney by the assignee (simply signed), in French
- deed of assignment (notarised), with French translation
- original Letters Patent for endorsement purpose.

**Licences**

Voluntary licences may be granted to third parties. The Law requires a licence to be in writing and signed by the parties, and prohibits certain conditions to be included in licences, and also provides for the possibility of sub-licences. A licence must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney by the applicant and licensee (simply signed), in French
- licence agreement (notarised), with French translation
- original Letters Patent for endorsement purpose.

**Compulsory licences**

A compulsory licence may be granted in cases of non-working or of anti-competitive exploitation. At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, any interested party may request the Commercial Court to grant a compulsory licence on the following grounds:

- the public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy, so requires
- the patent holder or his licensee is exploiting the invention in an abusive, anti-competitive manner, or fails to meet reasonable conditions of demand for the protected product in sufficient quality and quantity
- the refusal of the patent holder to grant licences on reasonable commercial conditions and terms
- the establishment or development of industrial or commercial activities suffers unfair or substantial damages by such refusal to grant licences.

A compulsory licence may also be granted in the case of a dependent patent (ie where a dependent invention cannot be worked without infringing an earlier patent).

### **Amendments**

Amendments can be made at any time prior to grant, but shall not go beyond the disclosure of the invention in the application as filed. It appears that, after grant, the patentee can request the Industrial Property Office to make changes to the patent text or drawings designed to limit the scope of the protection granted by the patent.

### **Effect of a patent**

The patent owner has the exclusive right to exploit the patented invention, and to prohibit third parties from such exploitation.

Exploitation is defined to include:

- making, importing, offering for sale, selling or using the product
- holding the product with a view to offering for sale, selling or using it.

The Law places certain limitations on the patent owner's rights, such as use for experimental scientific purposes, and use for gathering information for purposes of marketing authorisation.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis. Remedies available to the patentee include injunction, damages, seizure, confiscation and destruction of the infringing article, removal from commercial channels, and suspension of customs clearance procedure.

### **Marking**

No express provision.

### **Working**

The owner of a patent is required to work the patented invention in Burundi within a period of three years from the date of grant of the patent, or four years of the date of filing, whichever is the later. Failure to work the patent provides a ground for the granting of a compulsory licence (see the section on **Compulsory licences** above).

A compulsory licence will not be granted if the patent holder can provide legitimate grounds to justify his non-working.

### **Utility models**

The Law provides that an invention shall also be registrable as a utility model if it is new, involves a sufficiently inventive step, and is industrially applicable. The requirements for registrability are very similar to those for patents, and the rights conferred by a utility model certificate are likewise similar to those conferred by a patent.

The term of protection is 10 years after the filing date, subject to the payment of an annual fee. An applicant for a patent may, before the grant/rejection of the application, convert the application into an application for a utility model, and *vice versa*.



## DESIGNS

### Law

- Law no 1/13 of 2009 relating to Intellectual Property in Burundi

Burundi is a member of the Paris Convention and the WTO/TRIPS.

**Note:** Although regulations to implement the 2009 Law have not yet been promulgated, the 2009 Law is currently applied by the Registrar.

### Design protection

Design protection is available by way of a national filing. Burundi is a member of the Paris Convention so that convention priority may be claimed.

### Registrable subject matter

An industrial design may consist of any combination of lines or colours or any plastic form, whether or not it is associated with lines or colours, provided this combination or this form gives a special appearance to an industrial or crafts product and can serve as a pattern for the manufacture of an industrial or crafts product, and that it attracts the eye and is judged visually.

**Note:** The 2009 Law also provides for the registration of layout designs for integrated circuits. Specific provisions set out the requirements for registration and the registration procedure. A special register is created for layout designs. The period of protection is 10 calendar years following on the effective date of the protection, being either the date of first commercial exploitation of the layout design (provided the application for protection is filed within two years), or the date of filing the application for registration.

### Classification of designs

The articles to which designs may be applied are classified into different classes. The Locarno International Classification of Designs is applied.

### Types of applications

The application may be a non-convention national filing (without a claim to convention priority), or a convention application filed within six months of an earlier application in a convention country and claiming the priority date of such earlier application.

### Application

Non-convention and convention applications are filed with the office of the Director.

Foreign applicants must have a local address for service.

A single application filed in Burundi may be in respect of two or more designs, provided that the designs relate to the same class of the International Classification or the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in French
- assignment document (if applicable; simply signed), with French translation
- drawings, photographs or other graphic reproductions of the article embodying the design
- certified copy of priority document (if applicable), with French translation.

### **Applicant**

The author or creator or his assignee may apply for registration.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided he provides the Director with the priority details within 12 months of filing the application.

### **Novelty**

Absolute novelty is required, without provision for a grace period. Thus the design must not have been disclosed anywhere in the world, by publication in a tangible form or by use or in any other form, prior to the filing date or priority date.

### **Examination/procedure**

Formal examination is conducted. If the formal requirements have been met, the application is published in the Official Journal.

### **Opposition**

The Law does not provide for opposition to the registration of a design.

### **Duration and maintenance**

The initial term of a registered design is five years from the filing date, extendible on payment of renewal fees for two further five year terms. A six months' grace period is provided for late payment of renewal fees, subject to payment of surcharges. If the renewal fee (plus the surcharge) is not paid within this period, the design registration is invalidated.

### **Restoration**

Invalidated design registrations may not be restored.

### **Revocation**

No express provision.

### **Assignments and licences**

The right to a design may be transferred or licensed. However, changes in ownership or the granting of licences must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney by the applicant (simply signed), in French
- deed of assignment (notarised), with French translation; or
- licence agreement (notarised), with French translation
- original registration certificate for endorsement purpose.

Certain clauses in licence agreements are prohibited, ie clauses which impose on the licensee limitations which do not arise from the design registration as such.

### **Compulsory licences**

The Minister responsible for trade can authorise a third party to import the registered product in cases of failure or insufficiency to satisfy local demand at reasonable prices, or in order to eliminate abusive and anti-competitive practices.

### **Effect of a design registration**

A design registration makes the owner entitled to prevent third parties from exploiting the design in Burundi without his consent. Exploitation means the manufacture, sale or import of goods incorporating the design.

The rights arising from a registration do not cover acts relating to goods placed on sale in Burundi or elsewhere by the registration holder or with his consent.

### **Infringement**

Third parties who exploit the design in Burundi without the necessary consent of the owner, commit an infringement. Exploitation means the manufacture, sale or importation of goods incorporating the design. Infringement proceedings may be brought in a competent court on a civil basis. Remedies available to the owner of the design include an interdict, damages, seizure, confiscation and destruction of the infringing articles, or removal from commercial channels and suspension of customs clearance procedure.

### **Marking**

No express requirement.

### **Working**

If a registered design is not used or is insufficiently used, so that there is a failure to satisfy local demand at reasonable prices, a compulsory licence may be granted (see section on **Compulsory licences** above).

## **COPYRIGHT**

### **Law**

- Law no 1/021 of 2005 relating to the Protection of Copyright and Related Rights in Burundi
- Decree no 100/2011 relating to the Establishment of the Copyright Office of Burundi

Burundi is not a member of the Berne Convention but is a member of the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Registration of copyright**

There is no provision for the registration of copyright in Burundi; there are no formalities to be complied with.

### **Subject matter eligible for protection**

The Law provides protection to the author of a literary or artistic work, or to his successor in title.

The following works are eligible for copyright protection:

- books, brochures and other writings
- speeches, addresses, sermons and other works of a similar nature
- dramatic and dramatico-musical works
- musical works, with or without words
- choreographic works, pantomimes
- audiovisual works
- works of art, including drawings, paintings, architecture, sculpture, gravure, lithography, tapestry
- photographic works
- works of applied art
- illustrations, maps, plans, three-dimensional works related to geography, topography, architecture.

Copyright also extends to –

- translations, adaptations, arrangements of musical and literary and artistic works
- collections and compilations of works and data
- original works inspired by folklore.

### **Exclusions from copyright**

Certain works are excluded from copyright protection, including legislative texts, judicial or administrative decisions; and ideas, procedures, systems, functional methods, concepts, etc.

**Rights conferred**

The author of a protected work enjoys moral rights which are perpetual and inalienable. The author or his successor in title enjoys patrimonial or economic rights, namely the exclusive right to exploit the copyright work or to authorise others to use or exploit the work.

**Duration of copyright**

Copyright endures, in general, for the lifetime of the author plus 50 years. In the case of works of applied art, the duration is 25 years.

**PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Burundi.

# CAMEROON

## GENERAL INFORMATION

Cameroon is an independent state in West Africa. It is bordered on the west by the Atlantic Ocean and Nigeria, on the east by Chad and the Central African Republic, and on the south by the People's Republic of Congo, Gabon and Equatorial Guinea.



<b>Area:</b>	475 440 km <sup>2</sup>
<b>Population:</b>	19.2 million
<b>Capital:</b>	Yaoundé
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 44.6 billion (2010)
<b>Internet domain:</b>	.cm
<b>Languages:</b>	French, English (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Crude oil; petroleum products; lumber; cocoa beans; aluminium; coffee; cotton
<b>Imports:</b>	Machines and electrical equipment; foods; fuel

## International/regional conventions

Cameroon is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1964)
- Paris Convention (since 1964)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1973)
- WTO/TRIPS (since 1995)

## IP legislation

Cameroon is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country,

obtained via an OAPI application and registration procedure. Thus, in order to join OAPI, Cameroon had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

### **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

In Cameroon a national copyright law has been enacted:

- Law no 2000/011 on Copyright and Neighbouring Rights.

### **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

## CAPE VERDE

### GENERAL INFORMATION

The Republic of Cape Verde lies off the west coast of Africa, in the Atlantic Ocean, and is made up of a group of 10 islands and five islets. Cape Verde, which became independent in 1975, is divided into two groups of islands, namely Barlavento (Windward) and Sotavento (Leeward). The main islands of the Windward group include Sao Vicente, Santo Antao, Sao Nicolau, Santa Lusia, Sal and Boa Vista, while the Leewards are made up of Sao Tiago, Fogo, Maio and Brava.



<b>Area:</b>	4 033 km <sup>2</sup>
<b>Population:</b>	0.5 million
<b>Capital:</b>	Cidade de Praia
<b>Currency:</b>	Escudos (CVE)
<b>GDP:</b>	\$ 1.9 billion (2010)
<b>Internet domain:</b>	.cv
<b>Languages:</b>	Portuguese (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Shoes; garments; fish; bananas; hides
<b>Imports:</b>	Foodstuffs; consumer goods; petroleum; industrial products; transport equipment

### International/regional conventions

Cape Verde Islands is a member of the following international agreements:

- Berne Convention (since 1997)
- Rome Convention (since 1997)
- WIPO Convention (since 1997)
- WTO/TRIPS (since 2008)

### IP legislation

Trade marks

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter IV

Patents

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter II

Designs

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter III

Copyright

- Legislative Decree no 1 of 2009, Copyright and Related Rights (Neighbouring Rights)
- Regulatory Decree no 8 of 2007, Copyright and Related Rights (Neighbouring Rights)



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## TRADE MARKS

### Law

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter IV

Cape Verde is not a member of the Paris Convention, but is a member of the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services, for collective marks, for membership marks and for certification marks.

### Protection of well-known marks

Protection is afforded to well-known marks. The registration of a trade mark will be refused if the mark constitutes a reproduction, imitation or translation of another mark which is well known in Cape Verde, if the first mark is to be applied to identical goods or services, or if there is a likelihood of confusion by establishing a connection to the well-known mark.

The registration may also be refused even if the registration is in respect of different goods or services, where the mark sought to be registered will take unfair advantage of the distinctive character or repute of the well-known mark.

### Advantages of trade mark registration

Registration of a trade mark confers on the owner the right of ownership of the mark, and the right to prevent third parties from using the mark without his consent.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- collective marks
- membership marks
- certification marks.

### Definition of a trade mark

Any word or device that is capable of being represented graphically and which is capable of distinguishing the goods or services of one undertaking from another.

### Definition of a collective trade mark

A collective mark is defined as a mark consisting of signs or indications which may serve in trade to designate the geographic origin of products or services. The owners have the right to regulate the marketing of their products.

### **Definition of membership mark**

A membership mark is a specific sign belonging to and registered in the name of an association of persons with a legitimate interest, the members of which are entitled to use the mark on products or services related to the objects of the association.

### **Definition of a certification mark**

A certification mark is a specific sign belonging to a legal entity that controls products or services or sets standards to which the products or services must adhere. The mark is used on the products or in respect of the services to signify such control.

### **Limitation to colour**

The colours of a mark may be a distinctive element when combined with other graphic elements.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A multi-class registration system is applicable.

### **Convention priority**

Although Cape Verde is not a member of the Paris Convention, provision is made for a claim to priority based on a first application in another country. A priority document with Portuguese translation is to be filed in order to claim the benefit of the priority date.

### **Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (legalised), in Portuguese
- prints of the mark if in a logo/device format
- certificate of incorporation (legalised), with Portuguese translation
- certified copy of registration certificate in applicant's home country
- priority document (if applicable), with verified Portuguese translation.

### **Examination/procedure**

An application is examined on formal and substantive grounds. If the mark is found to be registrable, it is published in the Official Bulletin.

### **Opposition**

Opposition may be filed within two months following publication in the Official Bulletin. Extensions are possible (see the section on **Opposition proceedings** below).

### **Opposition proceedings**

A reply to the opposition may be filed by the trade mark applicant within two months of the applicant being notified of the opposition.

At the applicant or opponent's request, the above time periods may be extended by one month and the counter-party must be notified accordingly. Further extensions of the above periods can be granted upon request and proper justification by the interested party.

### **Grounds for opposition**

A mark shall not be registered if:

- it is devoid of distinctive character
- it consists exclusively of a shape which results from the nature of the product, or is necessary to obtain a technical result or gives the product its substantial value
- it consists exclusively of an indication which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, means of production, or other characteristics of the goods or services
- it consists exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade
- it consists of a colour or colours, unless combined with other graphic elements or wording which are distinctive
- it contains State or official flags, emblems, seals or religious symbols
- it contains expressions contrary to morality or which are likely to mislead the public
- it constitutes a reproduction or imitation of a trade mark previously registered by another person for identical or similar products or services, that may mislead or confuse the consumer or result in the risk of association with the already registered trade mark
- it constitutes a reproduction or imitation of a certain external feature, namely packaging or a label, including the form, colouring and layout of wording, medals, awards and other elements, that is used by others with their registered trade marks, provided that application is made to register the relevant element(s) prior to opposition
- it is a reproduction, imitation or translation of whole or part of a well-known trade mark in Cape Verde and is to be applied to identical or similar products or services and may be mistaken for the other trade mark, or establish an association with the holder of the well-known trade mark
- even when it is intended to be used in respect of goods or services which are not identical or similar, it is a translation of, or is identical or similar to, an already existing trade mark that is well known in Cape Verde, and use of the later trade mark seeks to take undue advantage of the distinctive character or repute of the well-known trade mark.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the date of grant, and is renewable for similar periods subject to payment of the prescribed fee.

A declaration of intention to use the mark must be filed every five years from the date of registration.

### **Cancellation/removal of a trade mark**

Any party with an interest in the trade mark may apply for the cancellation of a trade mark registration.

### **Grounds for cancellation/removal of a trade mark**

The grounds for cancellation are:

- non-use for five consecutive years up to a date three months before the application for cancellation
- non-compliance with the requirements for registration (see the section on **Grounds of opposition** above), provided the application for cancellation is made within 10 years of the date of registration, unless the mark was registered in bad faith
- the trade mark has become the usual designation in commerce for the product or service for which it was registered, as a consequence of the activity or inactivity of the proprietor
- the trade mark has become likely to mislead the public, namely as to the nature, quality or geographic origin of the products or services, as a result of the use of the trade mark by the proprietor or by a third party with the proprietor's consent for the products or services for which it was registered
- that the proprietor is not the true proprietor or that any of the rights provided for in the Industrial Property Code have been infringed.

### **Use requirement**

There is a risk of cancellation (see the section on **Grounds for cancellation/removal of a trade mark** above), if the owner does not make serious use of the trade mark for a period of five consecutive years.

### **Assignment**

Assignment of a trade mark is permitted with or without goodwill.

Requirements for recordal:

- power of attorney by assignee (legalised), in Portuguese
- deed of assignment (legalised), with verified Portuguese translation.

### **Licensing/registered users**

Licensing of trade marks is recognised.

Requirements for recordal:

- power of attorney by licensor (legalised), in Portuguese
- licence agreement (legalised), with verified Portuguese translation.

### **Amendment**

The following amendments are permissible:

- changes regarding the goods or services

- amendment of the mark itself (subject to the condition that the change does not materially affect the identity of the trade mark as filed)
- changes in the name and/or address of the trade mark proprietor.

**Rights conferred by registration**

Registration confers on the proprietor the right to prevent third parties from using, without his consent, in the exercise of economic activities, any identical or similar mark in relation to goods which are identical or similar to those for which the trade mark is registered, and where the similarity between the signs and the similarity between the goods or services causes a risk of confusion or association in the mind of the consumer.

**Trade mark infringement**

Any person who uses, without the authority of the registered owner, a registered or similar trade mark in relation to the relevant goods or services and in the exercise of economic activities, in the manner set out above, commits an infringement.

**Defences to trade mark infringement**

The rights conferred by registration shall not permit the proprietor to prohibit the use of the mark on products put on the market in Cape Verde by the proprietor or with his consent, unless they have been altered.

The proprietor of a registered mark may also not prevent others from using, in business, provided this is done in accordance with the rules and established practices of commerce and industry –

- their own name and address
- indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time or means of production of the goods or rendering of the service, or other characteristics of goods or services
- the trade mark where it is necessary to indicate the purpose of a product or service, in particular spare parts and accessories.

**Relief for trade mark infringement**

The Code makes provision for both civil and criminal proceedings and the relief includes the granting of injunctions, seizure of infringing goods and penalties.

**Common law rights**

The law states that a person who freely uses an unregistered mark for a period of not less than six months has the right to register the mark, and to object if another endeavours to register the mark.

**Marking of goods**

Marking of goods with the words ‘Registered Trade Mark’ or an abbreviation thereof is optional.

## **PATENTS**

### **Law**

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter II

Cape Verde is neither a member of the Paris Convention nor of the PCT, but is a member of the WTO/TRIPS.

### **Patent protection**

Patent protection for an invention is available via a national filing.

### **Types of patents**

The Code provides for conventional patents, to protect inventions which are new, involve an inventive step, and are susceptible to industrial application.

Provision is also made for utility models to protect inventions which are new, inventive, and industrially applicable, but by way of a simplified administrative procedure.

Furthermore, provision is made for supplementary protection certificates in respect of medicinal products and pharmaceuticals. Particulars regarding the product and the marketing authorisation must be provided.

### **Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- scientific theories and mathematical methods;
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body
- presentation of information
- material or substances already existing naturally, and nuclear materials
- aesthetic creations
- processes of cloning human beings
- processes for modifying the genetic identity of humans
- procedures for the commercial use of human embryos.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application (see the **Note** below)

- an application for a utility model certificate, which may be converted to a patent application
- an application for a supplementary protection certificate in respect of medicinal products and pharmaceuticals.

**Note:** Cape Verde is not a member of the Paris Convention and has not signed any reciprocity agreements as regards the claiming of priority. However, the Cape Verde Patent Office is prepared to recognise priority claims provided the application is filed within 12 months of the first-filed application.

### **Application**

Patent applications are filed with the office of the Registrar of Patents.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised), in Portuguese
- assignment (if applicable; notarised and legalised), in Portuguese or with a Portuguese translation
- specification (including claims, drawings and abstract), in Portuguese
- certified copy of the priority document (if applicable), with a Portuguese translation.

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is considered new if it is not disclosed in the state of the art. The state of the art comprises everything that has become accessible to the public, inside or outside the country, by description or use or by any other means, before the date of the application. The prior art also includes prior applications in Cape Verde for patents or utility models and not yet published.

### **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the filing date is provided, where the invention was exhibited at an international officially recognised exhibition or the disclosure of the invention was by reason of abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Inventiveness**

An invention is considered inventive if it is not evident to a person skilled in the art from the state of the art.

### **Convention priority**

Although Cape Verde is not a member of the Paris Convention, the patent office is prepared to recognise priority claims, provided the application is filed within 12 months of the first-filed application.

### **Examination/procedure**

The application is subjected to formal examination.

### **Publication**

After the formal examination, if the Registrar is satisfied that the necessary requirements have been met, he shall publish the application.

### **Opposition**

Any interested party can lodge a notice of opposition within two months from the publication of the application.

### **Duration and maintenance**

The duration of a patent is 20 years. Maintenance fees are payable annually from the first anniversary of the filing date. There is no grace period provided. If the fee is not paid on time, the patent lapses.

### **Restoration**

The applicant can request restoration of rights on the basis that failure to act within the provided time frame was due to circumstances beyond his control.

### **Revocation**

A patent can be revoked on the basis that the invention lacks novelty or inventiveness or is not industrially applicable; that the invention is not patentable; that the description is inadequate to allow a person skilled in the art to implement the invention.

### **Assignments and licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney by assignee or licensor (notarised), in Portuguese
- deed of assignment or licence contract (notarised and legalised), with Portuguese translation.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working of the patented invention within four years of the date of application or three years from the date of grant, whichever period expires last; or in the case of refusal by the patent holder to grant voluntary licences on reasonable terms.



The law also provides for compulsory licences for reasons of public interest, eg where the exploitation of the invention is of paramount importance to public health or national defence.

A compulsory licence may also be granted in the case of a so-called dependent patent, where the invention of such a patent cannot be exploited without infringing on an earlier patent. The owner of the earlier patent will be entitled to a cross-licence.

### **Amendments**

Amendments can be made prior to grant.

### **Effect of a patent**

A patent confers on the patent owner the exclusive right to exploit the invention in the national territory. A patent also confers on the owner the right to prevent third parties, not having the consent of the owner, from making, storing, offering for sale, or introducing in trade a product subject to the patent.

Certain limitations are placed in the rights of the owner, such as the preparation of medicines on prescription for individual cases; acts performed solely for testing or experimental purposes; etc.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil and criminal basis. Remedies include imprisonment, seizure and destruction of the infringing article.

### **Marking**

The marking of patented products with the words 'Patented Product' or 'Patent no' or 'Pat no' is optional.

### **Working**

Patents must be worked within three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, to avoid the granting of compulsory licences. (See the section on **Compulsory licences** above)

### **Utility models**

The law provides for inventions which are new, inventive and capable of industrial application to be protected, as an alternative route, as utility models. The administrative procedure is simplified and accelerated. A utility model ceases to have effect upon the grant of a patent for the same invention. Certain subject matter, such as chemical or pharmaceutical substances or processes, is excluded from protection as utility models. The term of duration of a utility model is six years from the date of the application; two extensions of two years each may be requested.

## DESIGNS

### Law

- Legislative Decree no 4 of 2007, Industrial Property Code, Title II Chapter III

Cape Verde is not a member of the Paris Convention; it is a member of the WTO/TRIPS.

### Design protection

Design protection is available by way of a national filing.

### Registrable subject matter

An industrial design means any ornament or aesthetic aspect of an article, including the appearance of the whole or part of a product resulting from the features, in particular, lines, contours, colours, shape, texture or materials of the product itself and its ornamentation.

### Classification of designs

No provision.

### Types of applications

Application may be made by way of a national filing. Although Cape Verde is not a member of the Paris Convention, it recognises a claim to priority based on an earlier application.

### Application

Non-convention and convention applications are filed with the office of the Registrar of Designs.

Foreign applicants must have a local address for service.

A single application filed in Cape Verde may be in respect of two or more designs, provided that the designs relate to the same set or composition of articles.

Filing requirements:

- Full particulars of the applicant
- power of attorney (notarised), in Portuguese
- assignment document (notarised and legalised), in Portuguese or with Portuguese translation
- drawings, photographs or other graphic reproductions of the article embodying the design
- specimen of the article embodying the industrial design
- declaration claiming priority (if applicable)
- certified copy of priority document (if applicable), with a Portuguese translation.

**Applicant**

The author or creator or his assignee may apply for registration of a design.

**Convention priority**

Whilst Cape Verde is not a member of the Paris Convention, the Designs Office is prepared to recognise priority claims, provided the application is filed within six months of the first-filed application.

**Novelty**

A design shall be considered to be novel if it has not been disclosed to the public anywhere in the world by publication in tangible form, or by use or in any other way, prior to the filing date or priority date (if priority is claimed). However, a 12 month grace period from the filing date or priority date is provided, where disclosure of the invention was by reason or in consequence of acts committed by the applicant or his predecessor in title, or disclosure was by reason of abuse committed by a third party with regard to the applicant or his predecessor in title.

**Examination/procedure**

Formalities examination is conducted. Substantive examination may be requested by the applicant, upon payment of the prescribed fee. If the design is found to be registrable, it is published.

**Opposition**

Any interested party may lodge a notice of opposition within two months from the publication of the application.

**Duration and maintenance**

The initial term of the design registration is five years, which term is extendible upon payment of renewal fees for four further five year terms. The term of the registration starts from the date of application for registration.

**Restoration**

No express provision.

**Assignments and licences**

The right to a design may be transferred, and voluntary licences may be granted. However, changes in ownership and licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney by assignee or licensor (legalised), in Portuguese
- deed of assignment or licence contract (notarised and legalised), with Portuguese translation.

**Compulsory licences**

No provision is made for compulsory licences for designs in Cape Verde.

### **Revocation**

Provision is made for the invalidity or nullity of a registration on certain grounds, including:

- that the design does not constitute a design as defined
- that the design is contrary to public policy, public health or morality
- that the design is not new.

### **Effect of a design registration**

The registration of a design confers on the owner the exclusive right to use the design, and to prohibit use by third parties without his consent. Such use includes making, offering for sale, marketing, importing and exporting products incorporating the design or a design not substantially different.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil and criminal basis. Remedies include imprisonment, seizure and destruction of the infringing articles.

### **Marking**

A registered design may be marked with the words 'Model no' or abbreviation thereof.

### **Working**

No requirements.

## **COPYRIGHT**

### **Law**

- Legislative Decree no 1 of 2009, Copyright and Related Rights (Neighbouring Rights)
- Regulatory-Decree no 8 of 2007, Copyright and Related Rights (Neighbouring Rights)

Cape Verde is a member of the Berne Convention and the Rome Convention, and of the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The law provides for copyright in respect of literary, artistic and scientific works, including:

- books, pamphlets, magazines
- lectures, addresses, sermons
- dramatic and dramatico-musical works
- musical works
- choreographic works, pantomimes

- audiovisual works
- works of art, architecture, painting, drawing, sculpture, etc
- photographic works
- works of applied art or craft
- computer programs
- works of folklore
- translations, adaptations, arrangements of works.

**Exclusions from copyright**

Excluded from protection are:

- daily news
- laws and decisions by courts or administrative bodies.

**Registration of copyright**

No requirement for registration.

**Requirements for subsistence of copyright**

To qualify for copyright, the author must be a Cape Verdean citizen or resident, or the work must have been first published in Cape Verde. Since Cape Verde is a member of the Berne Convention, copyright protection is extended to works eligible for copyright under that treaty.

**Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author.

**Duration of copyright**

Copyright generally endures for the lifetime of the author plus 50 years as regards the economic rights entailed therein. The copyright in a photographic work endures for 25 years; for a computer program the period is 50 years.

**Protection afforded by copyright**

Copyright confers on the copyright owner the exclusive right to use and exploit the copyright work, and to authorise the use and exploitation by others.

**Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed.

**PLANT BREEDERS' RIGHTS**

It has not been possible to determine whether or not, currently, plant breeders' rights or other *sui generis* protection for plants is available in the Cape Verde Islands.

# CENTRAL AFRICAN REPUBLIC

## GENERAL INFORMATION

The Central African Republic is an independent landlocked state, previously part of French Equatorial Africa. It is bordered by Chad on the north, Sudan on the east, the People's Republic of Congo and Democratic Republic of Congo on the south, and Cameroon to the west.



<b>Area:</b>	622 984 km <sup>2</sup>
<b>Population:</b>	4.8 million
<b>Capital:</b>	Bangui
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 3.5 billion (2010)
<b>Internet domain:</b>	.cf
<b>Languages:</b>	French, Sango (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Diamonds; cotton; coffee; timber; tobacco
<b>Imports:</b>	Food; textiles; petroleum products; machinery; electrical equipment; motor vehicles; chemicals; consumer goods

## International/regional conventions

Central African Republic is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1977)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1978)
- WTO/TRIPS (since 1995)

## IP legislation

The Central African Republic is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Central African Republic thus had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

## **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# CHAD

## GENERAL INFORMATION

The Republic of Chad is an independent state formerly part of French Equatorial Africa. It is a landlocked country, bordered to the north by Libya, to the east by Sudan, to the south by the Central African Republic, and to the west by Cameroon, Nigeria and Niger.



<b>Area:</b>	1 284 000 km <sup>2</sup>
<b>Population:</b>	10.5 million
<b>Capital:</b>	N'Djamena
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 18.56 billion (2010)
<b>Internet domain:</b>	.ch
<b>Languages:</b>	French, Arabic (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cotton; cattle; textiles
<b>Imports:</b>	Machinery and transportation equipment; industrial goods; petroleum products; foodstuffs

## International/regional conventions

Chad is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1988)
- Berne Convention (since 1971)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1970)
- WTO/TRIPS (since 1996)

## IP legislation

Chad is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country,



obtained via an OAPI application and registration procedure. In order to join OAPI, Chad thus had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

In Chad a national copyright law has been enacted:

- Law no 005/PR/2003 on the Protection of Copyright, Neighbouring Rights and Expressions of Folklore.

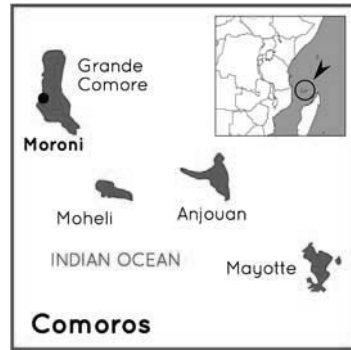
## **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# COMOROS

## GENERAL INFORMATION

The Union of Comoros consists of three Indian Ocean islands, namely Anjouan (Nzwani), Moheli (Mwali) and Grand Comore (Njazidja), of which the latter is the largest. The island group is located at the northern end of the Mozambique Channel, between the east coast of the African mainland and the island of Madagascar. Countries nearest to the Comoros are Mozambique on the mainland to the west, and Madagascar to the southeast.



Formerly under French rule, Comoros was granted self-government by France in 1961 and complete independence in 1976. In 2007, Anjouan attempted to secede from the union; control over the island was restored in 2008.

The island group of Mayotte is geographically a part of the Comoros chain, but is politically independent. In a referendum in 1976, Mayotte elected to remain under French rule; in March 2009, Mayotte voted to become France's 101<sup>st</sup> department; in April 2011 this change became official. Mayotte consists of a main island, Grande-Terre (Mahoré), a smaller island, Petite-Terre (Pamanzi), and several islets.

<b>Area:</b>	1860 km <sup>2</sup> : Grand Comoro (1146 km <sup>2</sup> ), Anjouan (424 km <sup>2</sup> ), Mohéli (290 km <sup>2</sup> ) (Mayotte, not included - 375 km <sup>2</sup> )
<b>Population:</b>	0.8 million
<b>Capital:</b>	Moroni (on Grand Comore)
<b>Currency:</b>	Comorian Franc
<b>GDP:</b>	\$789.4 million (2010)
<b>Internet domain:</b>	.km
<b>Languages:</b>	French, Arabic (official languages), Comorian
<b>Working week:</b>	Monday – Saturday (half-day on Friday and Saturday)
<b>Exports:</b>	Cloves; perfume oil; copra; ylang-ylang trees and products
<b>Imports:</b>	Rice and other foodstuffs; cement; petroleum products; consumer goods; transport equipment

## International/regional conventions

Comoros is a member of the following international agreements:

- Berne Convention (since 2005)
- Paris Convention (since 2005)
- Patent Cooperation Treaty (since 2005)
- WIPO Convention (since 2005)

## IP legislation

### Trade marks

- Act no 64-1360 of 1964 on Trade Marks

**Note:** Although the above legislation was enacted, it does not appear as if this legislation has been put into force.

### Patents

**Note:** The only patent legislation on record is a law of 1844 relating to patents for inventions. This legislation is not in operation at the present time.

### Designs

**Note:** The only design legislation on record is a law of 1909 relating to designs and models. This legislation is not in operation at the present time.

### Copyright

- Act of 1957 on Literary and Artistic Property

**Note:** Although the above legislation was enacted and put into effect by a government order of April 1957, it is not clear whether this legislation is in fact applied at the present time.

## TRADE MARKS

### Law

- No legislation in operation

Comoros is a member of the Paris Convention.

### Trade mark protection and types of marks

The general legal system of the Union of Comoros is a hybrid system based on Islamic law and an inherited French legal code (Napoleonic code). Although the union is a member of the Paris Convention, it does not, at the time of writing, have any legal instrument in place by which to give effect to the rights and obligations envisaged by the Convention, or afford registered trade mark rights.

It is, however, possible to arrange for the publication of cautionary notices in local newspapers, which aim to serve as notifications of a proprietor's trade mark rights. Whilst the legal effect of such notices remain untested in the courts, it does have a deterrent effect against potential infringers. The content of the notices is monitored and it is unlikely that advertisements which cover, for example, alcoholic products or cigarettes, will be allowed.

**Note on Mayotte:** A French national trade mark registration, and a registration in terms of the Madrid Protocol which designates France, will henceforth extend to Mayotte. The European Office for Harmonisation in the Internal Market (Trade Marks and Designs) has advised that Community Trade Mark (CTM) registrations will extend to Mayotte when the territory becomes an Overseas Department of France (which occurred in 2011), and

once the French laws which deal with CTM registrations are changed to accommodate this.

### **Application for publication of cautionary notice**

The following information and documents are required:

- full particulars of the proprietor
- print of the mark
- goods or services of interest.

### **Trade mark infringement**

As indicated above, there is no system for registration of trade marks in the Comoros (except for Mayotte). There is also no legislation providing for trade mark infringement proceedings. Therefore, as indicated above, the best way to attempt to protect a trade mark in the Comoros (except for Mayotte), is to publish a cautionary notice in local newspapers or publications, setting out a representation of the mark in respect of which rights are claimed, and the goods or services of interest to the proprietor. However, the effect of publishing a cautionary notice is uncertain.

**Note on Mayotte:** It is anticipated that a CTM or French national registration will be enforceable in due course, now that Mayotte has become a French department.

### **Marking of goods**

Country of origin should be shown clearly; any mark suggestive of origin/manufacture in France or any other EEC country is prohibited.

## **PATENTS**

### **Law**

- No legislation in operation.

Comoros is a member of the Paris Convention and PCT.

### **Patent protection**

Even though Comoros is a member of the PCT, having deposited its instrument of accession in 2005, the filing of a patent application is not possible at this time as Comoros has no patent legislation. Accordingly, in the absence of any legislation, no patent protection is currently available in this country.

## **DESIGNS**

### **Law**

- No legislation in operation.

Comoros is a member of the Paris Convention.

### **Design protection**

No design protection is currently available in Comoros.

## **COPYRIGHT**

### **Law**

- Act of 1957 on Literary and Artistic Property

Comoros is a member of the Berne Convention.

### **Protection of copyright works**

Although the copyright law was apparently put into effect by a government order, as indicated above, it is unclear whether the law is in fact being applied.

**Note on Mayotte:** Now that Mayotte has become a department of France, it is expected that the laws of France (also as regards copyright protection) will in due course be extended to Mayotte.

## **PLANT BREEDERS' RIGHTS**

No information available.

# CONGO, REPUBLIC OF THE

## GENERAL INFORMATION

The People's Republic of the Congo is an independent state bordered in the north by Cameroun and the Central African Republic, on the east and south by the Democratic Republic of Congo and Cabinda (Angola), and on the west by the Atlantic Ocean and Gabon.



<b>Area:</b>	342 000 km <sup>2</sup>
<b>Population:</b>	4.1 million
<b>Capital:</b>	Brazzaville
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 17.45 billion (2010)
<b>Internet domain:</b>	.cd
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Lumber; plywood; coffee; cocoa; sugar; diamonds; petroleum
<b>Imports:</b>	Capital equipment; construction materials; foodstuffs

## International/regional conventions

The Republic of the Congo is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1962)
- Lisbon Agreement on Appellations of Origin (since 1977)
- Nairobi Treaty on Olympic Symbol (since 1983)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1978)
- Rome Convention (since 1964)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1997)

## IP legislation

The Republic of the Congo is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, The Republic of the Congo thus had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

### **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

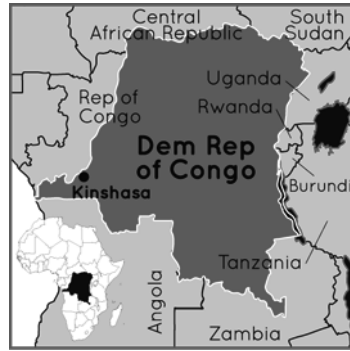
### **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# DEMOCRATIC REPUBLIC OF THE CONGO

## GENERAL INFORMATION

The Democratic Republic of the Congo (formerly Zaire) lies in Central Africa, bordered by the Republic of Congo to the north-west; the Central African Republic and South Sudan to the north; Uganda, Rwanda, Burundi and Tanzania to the east; and Zambia and Angola to the south. There is a short coastline at the outlet of the River Congo on the west coast.



<b>Area:</b>	2 344 858 km <sup>2</sup>
<b>Population:</b>	70.9 million
<b>Capital:</b>	Kinshasa
<b>Currency:</b>	Congolese Franc
<b>GDP:</b>	\$ 22.92 billion (2010)
<b>Internet domain:</b>	.cd
<b>Languages:</b>	French (official language), Lingala, Kongo, Mongo, Swahili
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Copper; petroleum; cobalt; diamonds; coffee; crude oil
<b>Imports:</b>	Consumer goods; foodstuffs; mining and other machinery; transport equipment; fuel.

## International/regional conventions

Democratic Republic of the Congo (DRC) is a member of the following international agreements:

- Berne Convention (since 1963)
- Paris Convention (since 1975)
- Phonograms Convention (since 1977)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1997)

## IP legislation

Trade marks

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

Patents

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

Designs

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

Copyright

- Ordinance Law no 86-033 of 1986 on the Protection of Copyright and Neighbouring Rights



## TRADE MARKS

### Law

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

The Democratic Republic of the Congo (DRC) is a member of the Paris Convention and the WTO/TRIPS.

### Trade mark protection

The Law provides for the registration of trade marks for goods and services, for collective marks, for manufacturing marks, and for national warranty marks. The Law states that the filing of a mark is compulsory for each commercial operator.

Applications may be filed as national applications and, in appropriate circumstances, claiming convention priority in terms of the Paris Convention.

### Protection of well-known marks

There is no express provision to protect well-known marks.

### Types of trade marks

Provision is made for the registration of trade marks for goods and services, and for collective trade marks.

The Law also refers to manufacturing marks and national warranty marks. However, these types of marks are not defined, and there are no specific provisions which relate to their registration or use.

### Definition of a trade mark

A mark is defined to mean a distinctive sign that permits different objects or services of a specific commercial company to be recognised or identified. Signs which may serve as a mark include a name or denomination, letters, figures or a combination of letters and figures, seals, slogans, emblems, piping, edging, combinations or arrangements of colours, drawings, reliefs or mottos.

The following signs will not be registrable:

- signs which would be contrary to public order or decency
- coats of arms, flags or national emblems
- signs or indications likely to mislead the public.

### Definitions of a collective mark

Collective marks are defined as marks which serve to distinguish one or more common characteristics of products or services provided by different undertakings, when the marks are affixed under the control of the group or organisation that is the holder of the mark.

### **Limitation to colour**

The Law expressly refers to combinations or arrangements of colours as registrable marks.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied.

### **Convention priority**

The DRC is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the earlier application.

### **Application**

An application is filed at the Department of Industrial Property or a regional department of government.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed), in French
- list of goods or services to be covered
- reproduction of the mark
- certified copy of priority document (if applicable), with certified French translation.

### **Examination/procedure**

The application is subjected to formal and substantive examination. If the application meets the formal and substantive requirements for registration, it will be published. The applicant will be notified that the application has proceeded to grant.

### **Opposition**

The Industrial Property Law makes no provision for opposition. However, any interested party, including the Public Minister, may invoke the nullity of a mark (see the section on **Grounds for cancellation/removal of a trade mark** below).

### **Duration and renewal**

Trade marks are registered for a period of 10 years from the filing date. A mark registration is renewable upon request for further periods of 10 years, and upon the payment of the prescribed fee. A grace period of six months is allowed for such payment, provided that a penalty is paid.

### **Cancellation/removal of a trade mark**

Any interested party, including the public Minister, can invoke the nullity of a registered trade mark (see the section on **Grounds for cancellation/removal of a trade mark** below).

A trade mark registration is also vulnerable to cancellation if the registered trade mark has not been used within a period of three years from the date of registration (see the section on **Use requirement and cancellation** below).

#### **Grounds for cancellation/removal of a trade mark**

Any interested party can invoke the nullity of a mark if it can be shown that the mark should not have been accepted for registration on the specific grounds set out in the law, including that the mark –

- is not distinctive, is descriptive/generic or purely laudatory
- is contrary to public order or decency
- embodies a protected symbol or coat of arms
- contains indications that are likely to deceive the public
- in the case of a collective mark, the rules and regulations governing the use of the mark concerned were not submitted together with the application.

#### **Use requirement and cancellation**

A mark must be used in the course of trade within three years of the date of its registration, failing which interested persons may apply to cancel the registration.

#### **Reinstatement/restoration**

The Law provides that the holder of a lapsed mark may, within five years of the termination of the mark, apply to have his rights reinstated.

#### **Assignment**

The Law on Industrial Property is silent on the assignment of registered trade marks. However, in practice assignments are recognised.

#### **Licensing/registered users**

The Law on Industrial Property is silent on both the licensing of trade marks and the recording of registered users. Again, in practice licences and licensed users are recognised.

#### **Amendment**

Trade mark registrations may not be amended.

#### **Rights conferred by registration**

The registration of a trade mark gives the owner the right to use and exploit the mark, and to allow others to use and exploit the mark (see the section on **Infringement** below).

#### **Trade mark infringement**

The infringement provisions relating to trade marks are somewhat unclear and may be difficult to apply in practice.

In terms of the law, the rights and obligations of the holder of a mark are, by analogy, the same as those defined in relation to industrial designs and models.

This can most likely be interpreted to mean that the proprietor of a registered trade mark shall be entitled to exploit the trade mark or to allow exploitation by others, and to sell or to allow others to sell, goods bearing the registered trade mark, and to authorise the manufacture, importation, sale, delivery, use or keeping for any of those purposes any product bearing a mark which is identical to the registered trade mark or a mark that has differences that are insignificant.

Any act of knowingly infringing these prohibitions shall constitute an act of counterfeiting.

### **Defences to trade mark infringement**

No specific defences are provided in the legislation.

### **Relief for trade mark infringement**

No specific reference is made in the Law for the relief available to the trade mark owner in the case of infringement of his rights.

### **Common law rights**

No express provisions.

### **Marking of goods**

The Law provides that, under certain circumstances, the bringing of certain marketable products onto the market shall require the prior affixation of the national warranty mark. The purpose of the national mark is to certify the quality of merchandise.

## **PATENTS**

### **Law**

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

The Democratic Republic of the Congo (DRC) is a member of the Paris Convention and the WTO/TRIPS.

### **Patent protection**

Patent protection is available in the DRC by way of a national filing. The DRC is a signatory to the Paris Convention and a national filing can claim convention priority. The DRC is not a member of the PCT, ARIPO, or OAPI. It is to be noted that foreign applicants must be represented by an agent in the DRC.

### **Types of patents**

The Law provides for the grant of different types of patents. These include:

- patents of invention
- patents of importation
- patents of improvement
- divisional patents.

In addition, the Law provides for so-called certificates of encouragement (see the section on **Certificates of encouragement** below).

Patents of invention are granted on convention or non-convention applications filed with the DRC Department of Industrial Property (the IP office).

Patents of importation are registered on the basis of a corresponding granted foreign patent. Patents of improvement are similar to patents of addition that are available in respect of modifications or improvements of the invention.

The Law also recognises divisional patents, where an initial application refers to more than one invention. The Law requires such an application to be divided into different applications. A divisional application is entitled to the same filing or priority date as the original application.

### **Patentable subject matter**

Under the concept invention, the Law includes any subject matter that, as a result of inventive activity, is capable of being used industrially or commercially.

The following subject matter is not regarded as being patentable:

- theoretical or purely scientific principles and conceptions
- creations that are purely ornamental in character
- financial or accounting methods, the rules of games and all other systems having an abstract character, including, in particular, programs or a series of instructions for carrying out the operations of a computer (ie computer programs)
- subject matter, the publication or use of which would be contrary or present a threat to public order, the security of the state or public decency
- the discovery of an object that already exists in nature (in this regard, see the comments below in relation to **Certificates of encouragement**).

Additionally, in order to be patentable, the subject matter for which patent protection is being sought must be new, involve an inventive step and be capable of being used in commerce or industry. The requirement of novelty is discussed in more detail below.

The Law provides that an invention relating to a pharmaceutical invention can only be patented if its object is a product, a substance or a composition that is introduced for the first time in the form of a pharmaceutical.

### **Certificates of encouragement**

It is to be noted that the Law, peculiarly in comparison to other jurisdictions, makes separate provision for protecting discoveries, in that these can be made the subject of a document entitled 'certificate of encouragement'. The Law provides that a certificate of encouragement is issued to the person who made a particular discovery and gives him a right to be rewarded for the discovery in accordance with its exploitability. It

follows that the discovery must be useful in order for a certificate of encouragement to be granted.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, the effective date of which is the filing date of the application
- a convention application, the effective date of which is the filing date of the priority application on the basis of which convention priority is being claimed
- an application for a patent of improvement, the effective date of which is the same as that of the main patent on which it is based
- an application for a patent of importation, the expiry date of which is the same as that of the foreign patent on which it is based
- a divisional application, the effective date of which is the same as the initial application.

### **Application**

For a patent of invention to be granted, the following documents are required:

- full particulars of the applicant
- power of attorney (notarised), in French (a copy of the signed power of attorney is required on the day of filing)
- specification (including claims, drawings and abstract), in French
- international classification
- certified copy of the priority document, with a sworn French translation of the first page thereof
- assignment of invention (notarised; if applicable), in French or with French translation.

For a patent of importation to be granted, the following documents are required:

- full particulars of the applicant
- power of attorney (notarised), in French (a copy of the signed power of attorney is required on the day of filing)
- specification (including claims, drawings and abstract), in French
- the number, filing date, priority details and remaining period of the granted foreign patent on which the patent of importation is to be based
- certified copy of the granted foreign patent and a sworn translation thereof in French
- international classification
- assignment of invention (if applicable; notarised), in French or with French translation.

### **Applicant**

The applicant must be the inventor or his successor in title. An assignment document is required if the applicant is not the inventor. The assignment document must be in French and must be notarised.

### **Novelty**

An invention is regarded as being new if it does not form part of the current state of the art at the effective date of the application. The current state of the art comprises everything that is or has been made available in the public domain before the priority date of the patent application, whether such availability occurred through a written or verbal description, through use or in any other way.

### **Certain prior knowledge or publication excused**

A novelty grace period is provided in that the novelty of an invention is not destroyed by disclosure thereof within a period of six months immediately preceding the effective date of a patent application for the invention, if the disclosure results from:

- use made by the inventor or his predecessor
- on abuse committed against the applicant or his predecessor
- disclosure at an officially recognised exhibition.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided that a DRC application is filed within 12 months of the filing date of the earlier application.

### **Examination/procedure**

Applications are subjected to formal examination. Once all the formal requirements have been complied with, issuance of a DRC patent can be expected within about two to three years after the application filing date.

### **Opposition**

The Law does not make provision for opposing the grant of a patent. However, it is possible to apply to a competent court to nullify a granted patent on the ground that it does not comply with the requirements of the Law.

### **Publication**

Once a patent has been granted, it is published in the Official Gazette. On publication it becomes enforceable against third parties.

### **Duration and maintenance**

Patents of invention are granted for a maximum term of 20 years. Patents of invention relating to pharmaceuticals are granted for a maximum term of 15 years. Both of these periods are calculated from the filing date of the application.

Patents of importation expire at the same time as the foreign patent on which they are based. Patents of improvement expire at the same time as the parent DRC patent on which they are based. Maintenance fees are payable on granted patents and pending applications.

**Restoration**

The patentee of a patent that has lapsed due to the non-payment of a renewal fee by the due date, or within a grace period of six months immediately subsequent to the due date, must apply for reinstatement within two months after the expiry of the grace period. Failure to do so will result in irrevocable lapsing of the patent.

**Revocation**

As indicated above, any person may request a competent court to nullify a patent on the basis of non-compliance with the requirements of the Law.

**Assignments and licences**

Assignments and voluntary licences are permitted. Assignments and licences must be in writing and must be signed by the contracting parties. An originally signed copy thereof must be deposited and registered with the IP office.

**Compulsory licences**

Compulsory (or non-voluntary) licences can be requested, but not before the expiry of a period of five years from the date of filing of the patent application, or three years from the grant of the patent, whichever period is the first to expire (see the section on **Working** below).

The Law also provides for automatic licences, which are non-voluntary licences. Automatic licences can be issued in cases where insufficient exploitation of the patented invention causes prejudice to the country's economic development and the public interest. An automatic licence can be issued to the State or to a third party.

**Amendments**

Amendments to the specification can only be made within a period of five months after the filing date. Thereafter, amendments must be effected by the filing of an application for a certificate of addition, ie a patent of improvement. It is not possible to amend a granted patent.

It is possible to amend and replace the claims of a patent of importation, where the foreign patent on which the DRC patent is based has been amended to replace the claims. Details of the amendment under cover of a certificate from the foreign patent office must be filed with the IP office.

**Effect of a patent**

The holder of a patent shall be entitled to the exclusive rights relating to the exploitation of the patented invention. More specifically the Law provides that the holder of a patent is entitled to prevent third parties from carrying out any of the following activities:

- manufacturing the product that is the object of the patent in question
- using the product, introducing it into the national territory, selling it or offering it for sale or introducing it onto the market in any form with the aim of using it or bringing it onto the market



- employing or using a patented process, or selling or offering to sell it
- supplying or offering to supply the means to implement or use a patented process to a person who is not the holder of a licence.

The holder of a patent is also entitled to carry out exclusively the actions indicated above in relation to a product that has been manufactured directly by a patented process.

The above rights only extend to acts carried out for commercial or industrial purposes, and do not include acts carried out for laboratory research purposes.

### **Infringement**

Any person who carries out any of the abovementioned exclusive rights without the authority of the patent holder, commits an infringement. The holder of the patent is entitled to bring legal action against any person infringing his abovementioned rights by manufacturing products or employing the means contained in the patent.

The improper use of a patented invention is a criminal offence, punishable by a fine or imprisonment.

### **Working**

As indicated above, the invention must be industrially exploited in the DRC within a period of five years of the filing date of the application, or within three years of the grant of the patent, whichever period expires first. Failure to exploit the patented invention provides a ground for the granting of a compulsory licence (see the section on **Compulsory licences** above).

In the case of pharmaceutical patents, the industrial exploitation must occur within four years of the date of grant of the patent.

In the case of patents of importation, exploitation must occur within three years of the filing date of the application. If the invention covered by a patent of importation has already been worked abroad, working in the DRC must commence within two years of the date of filing in the DRC.

A one year extension on the abovementioned time periods is obtainable on request, to be filed prior to the expiration of the said periods.

## DESIGNS

### Law

- Industrial Property Law no 82-001 of 1982
- Industrial Property Regulations, 1989

The Democratic Republic of the Congo (DRC) is a member of the Paris Convention and the WTO/TRIPS.

### Design protection

Protection for industrial designs is available in the DRC only by way of a national filing. As the DRC is a signatory to the Paris Convention, such a national filing can claim convention priority.

### Registrable subject matter

According to the Law, an industrial design is understood to include any assembly of lines and/or colours intended to give any industrial or artistic article a distinctive appearance. It is further understood to include any plastic shape, whether associated with colours or not, and/or any industrial or artistic article that can serve as a model for manufacturing of other similar articles and which can be distinguished from similar articles, either by a distinct or recognisable configuration that gives it a novel character, or by one or more external effects giving it a specific and novel appearance.

It is important to note that the Law provides that, for the purpose of pursuing protection, the same creation cannot be considered as being an invention and also a design or an industrial model. If the same creation has features that could be susceptible both to industrial design and patent protection and these features are inseparable from one another, only those features relating to the invention shall be susceptible to protection.

The following subject matter is regarded as not being susceptible to design protection:

- any industrial design or model that is contrary to public order or decency
- any industrial design or model, the shape of which has been designed for technical or industrial purposes to such an extent that it is inseparable from the desired result
- any reproduction or servile imitation of a natural design or model.

### Classification

The Law includes no provision regarding classification.

### Application

Foreign applicants must be represented by a local agent.

Filing requirements are as follows:

- full particulars of the applicant
- power of attorney (notarised), in French (a copy of the signed power of attorney is required on the day of filing)
- assignment document (if applicable; notarised), in French

- drawings or representations of the design
- certified copy of the priority document (if applicable), with a sworn French translation of the first page thereof.

A single application can cover up to 50 designs.

### **Applicant**

The applicant has to be the author of the design or his successor in title.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the DRC application is filed within six months of the filing date of the earlier application.

### **Novelty**

Novelty is determined on the same basis as for inventions, as outlined in the section on **Novelty** under **PATENTS** above.

### **Examination/procedure**

Applications are examined only as to form.

### **Opposition**

No provision is made for the filing of an opposition to the grant of a design prior to registration thereof.

### **Duration and maintenance**

The initial term of the design registration is five years, being extendible upon payment of renewal fees for a further five year term. The term of the registration starts from the date of application for registration. A six month grace period for paying the renewal fee is provided. If the renewal fee is not paid, the registration lapses.

### **Restoration**

No express provision is made for restoration of a lapsed design registration.

### **Revocation/invalidation**

At any time after registration, an interested party can apply for cancellation of the registered design due to non-compliance with the requirements of the Law.

### **Assignments and licences**

The same principles apply as those outlined in relation to patent protection, namely that assignments and voluntary licences are permitted. Assignments and licences must be in writing and must be signed by the contracting parties. An original signed copy thereof must be deposited and registered with the IP office.

### **Compulsory licences**

No provision is made for the granting of compulsory licences in relation to designs.

### **Amendment**

No amendment of a design registration is permitted.

### **Effect of a design registration**

As in the case of patents, the holder of a design registration acquires the exclusive right to prevent third parties from exploiting the subject matter of the design registration without his authority.

### **Infringement**

The same principles apply as those outlined in relation to patent protection (see the section on **Infringement** under **PATENTS** above).

### **Marking**

Marking is not required. Falsely indicating that a design/model is a registered design subjects the offender to imprisonment and/or a fine.

### **Working**

Working is not required.

## **COPYRIGHT**

### **Law**

- Ordinance Law no 86-033 of 1986 on the Protection of Copyright and Neighbouring Rights

The Democratic Republic of the Congo is a member of the Berne Convention, the Phonograms Convention and WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Law provides for copyright in respect of all works by authors, regardless of the type, the form of expression or the merit, including:

- books, pamphlets, brochures and other writings of a literary, artistic or scientific nature
- lectures, addresses, sermons, commentaries, whether oral or written
- dramatic and dramatico-musical works, including choreographic works, pantomimes
- musical works
- cinematographic and audiovisual works
- works of art, architecture, painting, drawing, sculpture, lithography, etc
- photographic works

- works of applied art or craft
- illustrations, geographical charts, plastic works relating to geography, topography, architecture
- works of folklore
- translations, adaptations, arrangements of works
- collections of works.

#### **Registration of copyright**

No requirement for registration.

#### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author, or his successor in title.

#### **Duration of copyright**

Copyright generally, eg in the case of literary, artistic and scientific works, endures for the lifetime of the author plus 50 years as regards the economic rights entailed therein. The copyright in a photographic work endures for 25 years.

#### **Protection afforded by copyright**

Copyright confers on the author certain moral rights, including the right to be recognised as the author, and the right to object against deformation, mutilation or modification of his work. Copyright also confers on the copyright owner patrimonial or economic rights, including the exclusive right to use and exploit the copyright work, and to authorise the use and exploitation by others.

#### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed; the moral rights not.

### **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Democratic Republic of the Congo.

# DJIBOUTI

## GENERAL INFORMATION

Djibouti is located on the north-east coast of Africa, with the Red Sea to the east, Eritrea to the north, and bordered by Ethiopia to the south and west, and by Somalia to the south-east.



<b>Area:</b>	23 200 km <sup>2</sup>
<b>Population:</b>	0.7 million
<b>Capital:</b>	Djibouti
<b>Currency:</b>	Djibouti Franc
<b>GDP:</b>	\$ 2.1 billion (2010)
<b>Internet domain:</b>	.dj
<b>Languages:</b>	French, Arabic (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Hides and skins; coffee (in transit)
<b>Imports:</b>	Foods and beverages; transport equipment; chemicals and pharmaceuticals; petroleum products; electrical appliances

## International/regional conventions

Djibouti is a member of the following international agreements:

- Berne Convention (since 2002)
- Paris Convention (since 2002)
- WIPO Convention (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property
- Decree no 271/PR/MCI of 2009 on the Industrial Property Djibouti Office (ODPIC)

**Note:** Law no 50/AN/09/6<sup>th</sup> L was enacted in 2009 and was due to come into force six months after publication in the Official Journal. Publication occurred on 25 May 2011 so that the Law has, in theory, become effective on 25 November 2011. However, the Law has as yet not been implemented, as no implementing regulations have been published.

**Note:** Decree no 271/PR/MCI was issued to establish the Industrial Property Office. However, it is understood that the IP office is also not yet fully operational, so that it is not clear to what extent applications, and particularly patent applications, will be processed.

## Trade marks

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property Patents
- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property

Designs

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property Copyright
- Law no 154/AN/06 of 2006 on the Protection of Copyright and Neighbouring Rights

## TRADE MARKS

### Law

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property
- Decree no 271/PR/MCI of 2009 on the Industrial Property Djibouti Office (ODPIC)

**Note:** Law no 50/AN/09/6<sup>th</sup> L was enacted in 2009 and was due to come into force six months after publication in the Official Journal. Publication occurred on 25 May 2011 so that the Law has, in theory, become effective on 25 November 2011. However, the Law has as yet not been implemented.

Djibouti is a member of the Paris Convention and the WTO/TRIPS.

### Trade mark protection

There is provision (under French legislation previously promulgated in Djibouti and in force since independence in 1977), for the registration of trade marks in respect of goods and services. There is also provision for the registration of collective marks.

### Protection of well-known marks

The proprietor of a well-known mark within the meaning of Article 6*bis* of the Paris Convention may request the cancellation of a registered trade mark that is likely to be confused with the well-known mark. However, the cancellation action must be made within five years of the proprietor of the well-known mark becoming aware of the offending registration.

### Advantages of trade mark registration

The registration of a trade mark grants the owner the exclusive right to use, or authorise the use of, the registered mark.

### Types of trade marks

The following types of trade mark are registrable:

- trade marks for goods and services
- collective trade marks.

### Definition of a trade mark

A trade mark includes surnames, pseudonyms, geographic names, emblems, prints, combinations of colours, letters, numerals and in general all signs which serve to distinguish goods, products or services.

### Limitation to colour

Combinations of colours can constitute a trade mark.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

Although Djibouti is a member of the Paris Convention, there is no provision in the Law to claim priority. It is uncertain, therefore, whether it is possible to claim convention priority. However, in practice the Registrar does take priority claims into account.

### **Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed), in French with the words 'BON POUR PROCURATION SPECIALE' handwritten on the form
- prints of the trade mark.

### **Examination/procedure**

Applications are examined as to formal requirements.

### **Opposition**

No provision.

### **Duration and renewal**

A trade mark is valid for 10 years from the date of registration, and thereafter renewable for further like periods of 10 years. A six month grace period for payment of the renewal fee is provided.

Renewal requirement:

- power of attorney (simply signed), in French.

### **Cancellation/removal of a trade mark**

Any person may apply to court to revoke a trade mark.

### **Grounds for cancellation/removal of a trade mark**

The only grounds for revocation that are expressly recognised in terms of the legislation are:

- non-use (see the section on **Use requirement and cancellation** below), and
- cancellation of a mark that is confusingly similar to a well-known mark in terms of the Paris Convention (see the section on **Protection of well-known marks** above).

### **Use requirement and cancellation**

Use of a registered trade mark is a requirement. Non-use for a period of five consecutive years or more renders a trade mark vulnerable to cancellation, except where the proprietor can show that the non-use was due to a legitimate reason.



**Assignment**

Assignments are possible and may be made with or without goodwill and must be recorded.

Requirements for recordal:

- power of attorney by the assignee (simply signed), in French
- deed of assignment, with sworn French translation.

**Licensing/registered users**

Voluntary licensing and registered users of trade marks are recognised and must be recorded.

Requirements for recordal:

- power of attorney from proprietor and licensee (simply signed), in French
- licence agreement, with sworn French translation.

**Amendment**

No information available.

**Rights conferred by registration**

The owner of a registered trade mark has the exclusive right to use or authorise the use of the mark.

**Trade mark infringement**

The infringement provisions in the legislation do not prescribe the legal test for trade mark infringement.

The legislation does, however, contain specific provisions relating to counterfeiting. The owner of a trade mark is entitled to approach the bailiff (a law enforcement officer) to enforce the trade mark, including to seize goods of a certain description that are marketed, delivered or furnished in prejudice of the trade mark proprietor's rights. In terms of the Regulations, the bailiff may only take action with the approval of the court, which must decide if the trade mark proprietor's rights are prejudiced.

**Defences to trade mark infringement**

No specific defences are provided for.

**Relief for trade mark infringement**

The legislation does not prescribe the relief available, save for the relief available in respect of counterfeit goods as set out in the section entitled **Trade mark infringement** above.

**Common law rights**

Trade mark law in Djibouti does not recognise common law rights. The ownership of a mark shall be acquired by the first deposit made validly in terms of the law.

### **Marking of goods**

Notice of registration of the mark by use of the words 'Marque Déposée' is optional.

## **PATENTS**

### **Law**

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property
- Decree no 271/PR/MCI of 2009 on the Industrial Property Djibouti Office (ODPIC)

**Note:** As indicated above, the above law was enacted in 2009 and was due to come into effect six months after publication in the Official Journal. Publication occurred on 25 May 2011; in theory the Law thus became effective on 25 November 2011. However, the Law is as yet not fully effective, since no implementing regulations have been published.

Likewise, although the Industrial Property Office was to be established by the above Decree, it is not clear whether the office is fully operational as yet. Accordingly, it is not clear whether patent protection can be obtained at this time.

Djibouti is a member of the Paris Convention and the WTO/TRIPS.

### **Patent protection**

As indicated above, at the time of writing it was not clear whether the 2009 Law, which will introduce patent protection to Djibouti, had become fully effective. The previous IP legislation in Djibouti only made provision for the filing of trade marks, designs and models. Furthermore, although the Djibouti Industrial Property Office has been established by law, it has apparently not yet become fully operational, so that a formal procedure for obtaining patent protection was not available at the time of writing.

## **DESIGNS**

### **Law**

- Law no 50/AN/09/6<sup>th</sup> L of 2009 on the Protection of Industrial Property
- Decree no 271/PR/MCI of 2009 on the Industrial Property Djibouti Office (ODPIC)

**Note:** As mentioned above, although the 2009 Law has theoretically become effective on 25 November 2011, it seems that it has not yet become fully operational. Accordingly, the Registrar is currently still applying the French Industrial Property (Designs) Act of 1909.

Djibouti is a member of the Paris Convention and the WTO/TRIPS.

### **Design protection**

Design protection is available by way of a national filing.

**Registrable subject matter**

Any assembly of lines or colours, or any form of three-dimensional configuration, associated or not with lines and colours, shall be considered an industrial design, provided that such assembly or such form provide for a special aspect to an industrial or craft product, and can be used as a model for manufacturing an industrial or craft product.

**Classification**

The Locarno Classification is applied.

**Application**

Applications for the registration of design, which may be non-convention or convention applications, are filed with the office of the Registrar of Designs. Since Djibouti is a member of the Paris Convention, convention priority may be claimed from an earlier application filed not more than six months before.

Foreign applicants must have a local address for service. A single application filed in Djibouti may be in respect of two or more designs, provided that the designs relate to the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in French
- specimen of the article embodying the design, or representations of the design
- certified copy of priority document (if applicable), with French translation
- assignment document (if applicable; simply signed), with a French translation.

**Applicant**

The author or creator or his assignee may apply for registration.

**Convention priority**

Djibouti is a member of the Paris Convention. Accordingly, priority can be claimed.

**Novelty**

A design shall be considered to be novel if it has not been disclosed anywhere in the world to the public by publication in tangible form, or by use or in any other way prior to the filing date or priority date (if priority is claimed). However, a 12 month grace period prior to the filing date or priority date is provided, where the invention was disclosed at an internationally recognised exhibition.

**Examination/procedure**

Formalities examination is conducted.

**Opposition**

No information available.

### **Duration and maintenance**

Based on the 1909 Act, a design is valid for a term of 50 years from the filing date, with the first renewal after five years from the filing date, and the second renewal after 20 years from the first renewal.

### **Assignments and licences**

The right to a design may be transferred or licensed. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney from assignee/licensor (simply signed), in French
- deed of assignment or licence contract, with French translation.

### **Compulsory licences**

No provisions.

### **Infringement**

Infringement proceedings may be brought before the Civil and Commercial Court. Civil sanctions can include attachment of the infringing articles and damages.

### **Marking**

No provisions.

### **Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Law no 154/AN/06 of 2006 on the Protection of Copyright and Neighbouring Rights (2006)

Djibouti is a member of the Berne Convention and the WTO/TRIPS so that copyright works are expected to be protected.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. For instance, it is not clear whether the above 2006 Law has been implemented and is being applied in Djibouti. The commentary given below is based on the provisions of the 2006 Law.

### **Subject matter eligible for protection**

The following works are eligible for copyright:

- written works such as books, pamphlets and other literary or scientific works
- oral works such as lectures, speeches, sermons
- stage directions, such as dramatic and dramatic-musical works, choreographic or pantomime works
- musical compositions

- artistic works such as drawings, paintings, engravings, lithography
- works of applied art, such as tapestries, handicrafts
- works of architecture, drawings, models and the building itself
- sculptures, bas-reliefs, mosaics
- photographic works
- cinematographic works
- maps, illustrations, plans, sketches and moulded works relating to geography, topography, etc
- computer programs
- derivative works, such as translations, adaptations, transformations of works and of expressions of folklore
- collections of works and of expressions of folklore.

### **Registration of copyright**

Copyright comes into existence upon the creation of the work. There is no requirement for registration.

### **Exclusions from copyright**

The law provides that copyright protection shall not subsist in respect of the following:

- laws, decisions of courts or of administrative bodies
- news of the day
- ideas, processes, systems, methods of operation, concepts or principles.

### **Authorship and ownership of copyright**

The owner of the copyright in a work shall, generally, be the author of the work. The author of a work is the person who created it. The law provides for certain cases where ownership shall vest in a person other than the author, eg in the case of computer software created by an employee, the ownership shall vest in the employer.

### **Duration of copyright**

The economic rights arising from copyright in most cases endure for the lifetime of the author plus 50 years. In the case of films, the duration is 50 years from the date of making available to the public; in the case of photographs or works of applied art, the period is 25 years.

### **Protection afforded by copyright**

Copyright provides for moral rights and economic rights. The author enjoys moral rights which include:

- the right to decide on the disclosure or publication of the work
- the right to be recognised as author
- the right for the integrity of the work to be respected.

These rights are perpetual rights and cannot be alienated. The author also enjoys economic rights which entail the exclusive right to exploit the work for monetary profit, or to authorise others to do so, by doing the following acts:

- reproducing the work in any material form
- representing, reciting or performing the work in public, including by broadcasting (audio or visual)

- communicating the work to the public
- translating, adapting or transforming the work
- commercial renting or leasing of computer programs.

### **Exceptions to copyright protection**

The law provides for certain exceptions to the protection afforded by copyright, such as to permit reproduction, translation, etc for personal and private use; to permit quotations compatible with fair practice; use for teaching purposes; etc.

### **Assignment and licensing of copyright**

The author or his successor has the right to transfer or license the economic rights inherent in copyright. The moral rights are inalienable.

### **Copyright infringement**

The copyright owner may institute civil proceedings and may apply for measures to prevent imminent infringement or to stop existing infringement. The court may order seizure of infringing copies, seizure of the proceeds of illegal activity, the suspension of illegal activity, etc. The law also provides for criminal sanctions.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Djibouti.

# EGYPT

## GENERAL INFORMATION

The Arab Republic of Egypt, traditionally known as Egypt, is located in north-eastern Africa. It is bordered by the Mediterranean Sea to the north, by Israel and the Red Sea to the east, by Sudan to the south and Libya to the west.



<b>Area:</b>	1 001 450 km <sup>2</sup>
<b>Population:</b>	80.5 million
<b>Capital:</b>	Cairo
<b>Currency:</b>	Egyptian Pound
<b>GDP:</b>	\$ 500.9 billion (2010)
<b>Internet domain:</b>	.eg
<b>Languages:</b>	Arabic (official language), French, English
<b>Working week:</b>	Sunday - Thursday
<b>Exports:</b>	Crude oil and petroleum products; cotton yarn; raw cotton; textiles; metal products; chemicals
<b>Imports:</b>	Machinery and equipment; food; fertilisers; wood products; durable consumer goods; capital goods

## International/regional conventions

Egypt is a member of the following international agreements:

- Berne Convention (since 1977)
- Hague Agreement on Designs (since 1952)
- Madrid Agreement on Goods (since 1952)
- Madrid Agreement on Marks (since 1952)
- Madrid Protocol on Marks (since 2009)
- Nairobi Treaty on Olympic Symbol (since 1982)
- Nice Agreement on Classification of Marks (since 2005)
- Paris Convention (since 1951)
- Patent Cooperation Treaty (since 2003)
- Phonograms Convention (since 1978)
- Strasbourg Agreement on Patent Classification (since 1975)
- Trade Mark Law Treaty (since 1999)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1995)

## IP legislation

- Law on the Protection of Intellectual Property Rights, Law no 82 of 2002
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Books One, Two and Four
- Decree no 497 of 2005, Executive Regulations for implementing Law no 82 of 2002, Book Three (amended by Decree 1241/2006 and 2202/2006)

#### Trade marks

- Law no 82 of 2002, Book Two pertaining to Marks, Trade Names, Geographical Indications, and Industrial Designs
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book Two
- Trade Marks (Consumer Protection) Law no 67 of 2006

#### Patents

- Law no 82 of 2002, Book One pertaining to Patents, Utility Models, Layout Designs for Integrated Circuits, and Undisclosed Information
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book One

#### Designs

- Law no 82 of 2002, Book Two pertaining to Marks, Trade Names, Geographical Indications, and Industrial Designs
- Law no 82 of 2002, Book One pertaining to Patents, Utility Models, Layout Designs for Integrated Circuits, and Undisclosed Information
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Books One and Two

#### Copyright

- Law no 82 of 2002, Book Three pertaining to Copyright and Neighbouring Rights
- Decree no 497 of 2005, Executive Regulations for implementing Law no 82 of 2002, Book Three (amended by Decree no 1241 of 2006, Decree no 2202 of 2006)

#### Related areas

- Law no 82 of 2002, Book Four pertaining to Plant Varieties
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book Four
- Ministerial Decree no 492 of 2003, establishing the Office for the Protection of Plant Varieties
- Ministerial Decree no 807 of 2005, determining plant species protected under Law 82 of 2002

## **TRADE MARKS**

### **Law**

- Law no 82 of 2002, Book Two pertaining to Marks, Trade Names, Geographical Indications, and Industrial Designs
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book Two
- Trade Marks (Consumer Protection) Law no 67 of 2006

Egypt is a member of the Paris Convention, the Madrid Agreement and Protocol, and the WTO/TRIPS.

### **Trade mark protection**

Provision is made for the registration of trade marks for goods and services and for collective marks and certification marks. There is no specific provision for defensive marks.



Trade mark applications may be filed as national applications, in appropriate circumstances claiming priority in terms of the Paris Convention; or Egypt may be designated in international applications in terms of the Madrid Agreement or Protocol.

### **Protection of well-known marks**

Marks which are well known, worldwide and in Egypt, are entitled to the protection conferred by the legislation, even if not registered in Egypt. This protection means that an identical mark cannot be registered by another in respect of identical goods or services and, in certain circumstances, also not in respect of goods or services which are not identical.

### **Advantages of trade mark registration**

The owner of a registered trade mark has the right to use, or to authorise the use of, the registered mark, and the right to institute civil or criminal proceedings in the case of the contravention of a protected right.

### **Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- collective marks
- certification marks (by ministerial authorisation).

### **Definition of a trade mark**

A trade mark is any sign distinguishing goods, whether products or services, and includes in particular names represented in a distinctive manner, signatures, words, letters, numerals, designs, symbols, signposts, stamps, seals, drawings, engravings, a combination of distinctly formed colours and any other combination of these elements if used, or meant to be used, to distinguish the products of a particular industry, agricultural, forest or mining venture or any goods, or to indicate the origin of products or goods, or their quality, category, guarantee, preparation process, or to indicate the provision of any service. In all cases, a trade mark shall be a sign that is recognisable by sight.

### **Definition of certification trade mark**

A minister may, in the interest of the public, authorise natural persons or legal entities involved in the control or examination of products as regards origin, components, methods of manufacture, quality, authenticity or any other distinctive characteristic, to register a mark to certify such control or examination. Such a mark may only be disposed of with special authorisation of the minister.

### **Definition of collective trade mark**

A collective trade mark is used to distinguish a product of a group of persons who belong to a specific entity, even where such entity has no industrial or commercial enterprise of its own. A representative of such entity may submit an application for the registration of the mark.

### **Limitation to colour**

A combination of distinctively formed colours may constitute a trade mark.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is followed. A separate application is required for each class.

### **Convention priority**

Egypt is a member of the Paris Convention which affords applicants who have applied to register a mark in another convention country, the right to claim priority based on the first filing date, provided the Egyptian application is filed within six months of the earlier filing date. The right to claim priority has been extended to apply to a first filing in any member country of the WTO (World Trade Organisation).

### **Application**

Applications are filed with the Trade Registry Department.

The following information and documents are required

- full particulars of applicant
- power of attorney (legalised), in Arabic
- if the applicant is a company, a certificate of incorporation (legalised)
- list of goods and/or services to be covered
- electronic prints of the mark, for each class
- priority document (certified copy; if priority is claimed).

**Note:** If any of the documents is in a foreign language, an Arabic translation must be provided.

### **Examination/procedure**

Applications are examined as to formal requirements, on relative and absolute grounds. In particular the Trade Registry Department may require the applicant to make the necessary modifications to the mark to avoid its confusion with a mark already registered or the subject of a pending application.

Upon acceptance of the application for registration, the Department must publish the acceptance in the Gazette of Trademarks and Industrial Designs.

### **Opposition**

Any person concerned may oppose a trade mark application within 60 days of its publication in the Gazette of Trademarks and Industrial Designs. It is not possible to extend the opposition period.

### **Opposition procedure**

Opposition proceedings are prescribed by Regulation. A notice of opposition is lodged, containing the grounds of opposition, and is forwarded to the trade mark applicant within 30 days. The trade mark applicant must, within 30 days from the date of receipt of the opposition, provide a written

response. Should the trade mark applicant fail to file a response, the trade mark application will be deemed to be abandoned.

Upon receipt of the trade mark applicant's written response, a copy is forwarded to the opponent within 10 days. Upon request by the trade mark applicant or opponent, a single hearing may be convened for the parties to present their arguments. A decision is made and the parties are informed within 10 days.

Where the opposition is unsuccessful, the trade mark applicant shall be allowed 90 days from the date of notification of the decision, to complete the registration procedure, failing which the application shall be deemed to be abandoned. It is possible to appeal the decision to the competent Administrative Court.

### **Grounds of Opposition**

According to the legislation, the following trade marks shall not be registered and, although not specifically stated, these grounds may presumably form the basis of an opposition:

- marks that are devoid of any distinctive character, or composed of signs or statements which are descriptive of the goods, or which are the normal picture or image thereof
- marks that are contrary to public order or morality
- marks that consist of public armorial bearings, flags and other emblems pertaining to the State or any other state, regional or international organisations, as well as any imitations thereof
- marks which are identical with, or similar to, symbols of religious character
- symbols of the Red Cross or Red Crescent, or any other emblem of the same character, as well as any imitations thereof
- the portrait of an individual or his armorial bearings, except with his consent
- designations of honorary degrees, if the applicant is unable to prove his right
- marks and geographical indications which are likely to mislead or confuse the public or which contain false descriptions as to the origin of the products, whether goods or services, or their other qualities, as well as signs that contain an indication of a fictitious, imitated or forged trade name
- marks which are identical to a well-known trade mark (even if not registered in Egypt) and which are intended to be used in relation to goods which are identical to those of the well-known mark
- marks which are identical to a well-known mark (where the well-known mark is registered in a member country of the World Trade Organisation and in Egypt) and which are intended to be used in relation to non-identical goods, but where the use is intended to lead the public to believe that a connection exists between the owner of the well-known mark and those goods and such use may be prejudicial to the interests of the owner of the well-known mark.

The legislation further provides that the Department may require the trade mark applicant to modify the trade mark in question in order to define and clarify the mark, so as to avoid confusion with a mark already registered, or a mark for which an earlier application has been filed.

### **Duration and renewal**

A trade mark registration is valid for an initial period of 10 years, from the date of filing, and is renewable for like periods. The owner of a trade mark may request the renewal of the protection period within six months after the date of its expiry against payment of the prescribed fees as well as an additional amount, failing which the mark shall be cancelled.

### **Cancellation/removal of a trade mark**

Cancellation/removal of a registered trade mark is possible.

### **Grounds for cancellation/removal of a trade mark**

Any interested party may apply to the competent court to cancel a registration if the trade mark in question has not been 'seriously' used for a period of five consecutive years. 'Serious' use of a trade mark is not defined. A mark so cancelled may be re-registered in the name of its previous owner within three years of its cancellation against payment of a prescribed fee and under prescribed conditions. The cancelled mark may also be re-registered in the name of a third party in certain circumstances.

The legislation further provides that the registration of a mark may be challenged at any time where the registration was made in bad faith.

A prior user of a mark which has been registered by another party may challenge its validity within five years of its registration.

### **Use requirement and cancellation**

Use of a registered trade mark is a requirement. A registered trade mark is vulnerable to cancellation if it has not been seriously used for a period of five years (see the section on **Grounds for cancellation/removal of a trade mark** above).

### **Assignment**

Assignments are possible and may be made with or without the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- full particulars of the person making the request and of the transferor
- power of attorney, signed by the assignee (legalised)
- date of transfer of ownership
- deed of assignment, signed by both parties (legalised)
- certified copy of the certificate of incorporation of the assignee company (if applicable; legalised).

**Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is necessary to be effective against third parties.

Requirements for recordal:

- full particulars of the person making the request and of the licensor
- power of attorney, signed by the licensee (legalised)
- licence agreement (legalised)
- certified copy of the certificate of incorporation of the licensee company (if applicable; legalised).

**Amendment**

The owner of a registered mark may request the Registry to introduce any modifications that do not essentially affect the substance of the mark. Deletion of part of the specification of goods/services covered by the registration is also possible. The amendment will be advertised for opposition purposes.

Requirements for amendment:

- power of attorney (legalised)
- supporting document (if any, eg certified certificate of the change of name and/or address).

**Rights conferred by registration**

The legislation recognises the right of the owner of a trade mark registration to prevent third parties from importing, using, selling or distributing products distinguished by such mark. This right does not apply when the owner itself markets these products in any country, or authorises a third party to do so.

**Trade mark infringement**

The legislation envisages the institution of both criminal and civil proceedings in the case of infringement.

The following offences are listed, punishable by a fine or imprisonment:

- counterfeiting a trade mark registered in accordance with the law, or imitating it in a manner which is likely to mislead the public
- fraudulently using counterfeit or imitated trade marks
- fraudulently affixing to products a trade mark belonging to a third party
- knowingly selling, offering for sale or distributing, or acquiring for the purpose of sale, products bearing a counterfeit or imitated mark, or to which the mark has been unlawfully affixed.

The legislation provides that the owner of a well-known trade mark, worldwide and in Egypt, shall have the right to enjoy the protection conferred by the legislation even if such a mark is not registered in Egypt.

**Defences to trade mark infringement**

No specific defences are listed in the legislation.

### **Relief for trade mark infringement**

The legislation envisages various forms of relief in both criminal and civil cases including:

- an order establishing the infringement of a protected right
- seizure, confiscation and/or destruction of the infringing products or other items to which the infringing marks have been applied, the revenue and the returns of such products as well as the implements used in the infringement
- closure of the enterprise used to commit the infringement, for a period not exceeding six months; repeat offenders may be closed permanently
- an order for the compilation of an exhaustive inventory of all the machines and implements used in the infringing actions as well as all products, goods, signboards, packaging, invoices, correspondence and advertisements to which the offending mark has been affixed
- sale of the offending articles, their value deducted from the damages claimed by the plaintiff, or disposal of them by any other appropriate means
- publication of the court's judgment in one or more newspapers at the expense of the infringer.

### **Common law rights**

The law recognises prior user rights, inasmuch as a prior user of a trade mark may, within a period of five years, challenge the validity of a trade mark registration obtained by another party.

### **Marking of goods**

It is not compulsory to use the ® symbol to indicate that the mark has been registered. It is however a criminal offence to indicate that an unregistered mark has been registered.

Where the quantity, dimension, measure, capacity, weight, origin or ingredients of a product constitute a factor in assessing its value, the relevant minister may prohibit the sale, marketing or importation of those goods, unless they bear these indications. These indications must be placed on the product in Arabic.

Trade indications must be factual in all aspects and no mention may be made of medals, diplomas, awards or honorary distinctions except in relation to the products for which such distinctions apply or in relation to the persons/commercial names (or their successors) who have acquired those distinctions.

## PATENTS

### Law

- Law no 82 of 2002, Book One pertaining to Patents, Utility Models, Layout Designs for Integrated Circuits, and Undisclosed Information
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book One

Egypt is a member of the Paris Convention, the PCT and the WTO/TRIPS. The deadline for entering the PCT national phase in Egypt is 30 months from the earliest priority date.

### Patent protection

Patent protection may be obtained by way of a national filing, claiming priority in appropriate circumstances, or by way of an international application under PCT designating Egypt.

### Types of patents

A patent is granted for an invention which is new, inventive, and industrially applicable. An independent patent may also be granted for any modification, improvement or addition to a previously patented invention.

The Law also provides for the granting of utility model patents. An application for a patent may be converted to an application for a utility model patent, and *vice versa*.

### Patentable subject matter

As indicated above, patents are granted for inventions which are new, involve an inventive step, and are industrially applicable.

Patents of invention shall not be granted for the following:

- inventions the exploitation of which may result in prejudice to national security, breach of public order or morality, or damage to the environment or the life or health of human, animal or plant
- scientific theories and discoveries, mathematical methods, programmes and schemes
- diagnosis, therapeutic and surgical methods for man or animal
- plants and animals, whatever the level of rarity or peculiarity thereof, and biological processes for the production of plants or animals; with the exception of micro-organisms and non-biological and microbiological processes for the production of plant or animal
- living organisms, organs, tissues, live cells, natural biological materials, deoxyribonucleic acids (DNA) and genomes.

### Types of applications

Application for a patent may be made in the following manner:

- a non-convention application, where the effective date is the filing date of the application

- a convention application, where the effective date is the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Egypt is designated
- a divisional application, where the original application covered more than one invention
- a utility model application, which may be converted to a patent application.

### **Application**

Filing requirements:

- full particulars of the applicant
- the name, address, nationality, and profession or nature of business of the inventor (not required for PCT national phase applications)
- power of attorney (legalised)
- deed of assignment (legalised) (not required if the Egyptian application is filed in the
- same name as the priority application/international application)
- specification (including claims, drawings and abstract), in Arabic
- certified copy of the priority document (if applicable)
- an extract of the entry of the applicant company in the commercial register, or a copy of the certificate of incorporation (not required for PCT applications).

### **Applicant**

An application for a patent may be made by the inventor or his successor in title. An assignment document is required if the applicant is not the inventor.

Any person having a real and effective activity in any state or member of the World Trade Organisation or any country that treats Egypt on a reciprocal basis, shall have the right to apply for a patent and can enjoy the resulting rights thereof.

### **Novelty**

Absolute novelty is required. Novelty is destroyed by public use or exploitation in Egypt or abroad, or if a description has been disclosed in a manner that those skilled in the art are enabled to use the invention. Novelty is also destroyed if an earlier patent application has been filed for the same invention or part thereof, or a patent had already been granted, within or outside Egypt.

### **Certain prior knowledge or publication excused**

Disclosure at a national or international exhibition in the six months before filing is excused.

### **Inventiveness**

No express definition.



**Convention priority**

If an application for a patent is filed in a member state of the World Trade Organisation or in a country which treats Egypt on a reciprocal basis, the applicant (or its successors in title) may, within one year of the filing date of the first application, apply in Egypt for a patent for the same invention. In such cases, the date of the first application shall be the priority date.

**Examination/procedure**

Applications for patents are subjected to both formal and substantive examination. The examination includes examination for novelty, inventive step and industrial applicability. If the invention fulfils the conditions for patentability, a notification of acceptance will be published in the Patents Gazette.

**Opposition**

Interested parties may oppose the application for grant of the patent within 60 days of the publication in the Patents Gazette. The notice of opposition must be filed with the patent office and must state the reasons for the opposition. Oppositions are examined by a committee established by the Law. The committee is headed by a judge of the Court of Appeal, who is assisted by an assistant judge and three experts. The committee must make a decision within 60 days from the date of filing the petition. Appeals from decisions of the committee can be filed with the Administrative Courts within 60 days of the decision.

**Publication**

Applications for patents are published twice: first for opposition purposes (see the section on **Opposition** above), and secondly on grant. No publication can take place within 12 months from the filing date, as applications are kept confidential for 12 months from filing. After publication for purposes of acceptance, applications become open to public inspection.

**Duration and maintenance**

Patents are valid for a period of 20 years subject to payment of annual maintenance fees. A 12 month grace period is available for payment of the maintenance fee, subject to payment of fines for late renewal.

**Restoration**

Failure to pay the annual maintenance fees before the deadline or within the 12 month grace period, leads to lapsing of the application/patent. There are no provisions for restoration after the expiry of the 12 month grace period.

**Revocation**

Applications for revocation can be made to the Administrative Courts by the Patent Office or any interested parties. Provisions are made for revocation on the grounds of non-working of the patent (see the section on **Working** below), or if the patent should not have been granted because it failed to meet the requirements for patentability or novelty.

**Assignments**

A patent may be assigned or transferred, and may also be mortgaged. Assignments must be recorded to be effective against third parties. Assignments are published in the Patents Gazette.

Requirements for recordal:

- power of attorney from the assignee (legalised)
- assignment document (legalised).

**Voluntary licences**

Although no express provision is made for the patent owner to grant voluntary licences, this right is inherent in the exclusive right granted to the patent owner under a patent.

**Compulsory licences**

The law contains comprehensive provisions for the granting of compulsory licences in very specific circumstances. These circumstances are as follows:

- if the invention is necessary for maintenance of national security, health, safety of the environment, and food security
- in the case of a national emergency
- if the invention is necessary to support national efforts in sectors that are vital for economic, social or technological development
- upon the request of the Minister of Health in the event that insufficient quantities of drugs are available to meet the demands of the country, or if the price is prohibitive
- if the patentee refuses to grant licences on reasonable terms to third parties for exploitation of the patent
- in the absence of sufficient working of the patented invention (see the section on **Working** below)
- if the patentee has embarked on anti-competitive practices, eg overpricing, insufficient supply or supply on unreasonable grounds, failure to satisfy demand, exploiting the patent in a way that prejudices technology transfer, etc
- if the holder of a patent requires a licence under a second patent not held by him, and the first patent will make significant technical progress in the field of that invention.

Different criteria and procedures apply in the different circumstances set out above, some of which involve negotiation/consultation with the patent holder, and some of which do not.

**Amendments**

An applicant may amend his application at any time before acceptance of the application, but the amendment cannot go beyond the scope of the invention as originally filed. The application for amendment must be accompanied by a statement setting out the nature and reasons for the amendment.

**Effect of a patent**

A patent confers on its owner the right to prevent third parties from exploiting the invention by any means, including by importing, using, selling or distributing a patented product. This right is exhausted when the owner commercialises the product in any country or authorises a third party to do so.

**Infringement**

Infringement occurs when a third party exploits the invention without the authority of the patent owner.

Certain acts do not constitute infringement, including:

- activities carried out for scientific research purposes
- where a third party in good faith commenced with the making of a product or use of a process prior to the filing of the patent application; such third party has the right to continue with his activities
- indirect use of the production process in order to obtain other products
- other acts by third parties which do not unreasonably hamper the normal exploitation of the patent and are not unreasonably prejudicial to the legitimate interests of the patent owner.

Infringement proceedings may be brought in a competent court. Civil sanctions (including fines, confiscation and destruction of the infringing goods) apply for first offenders, but repeat offenders may be subject to imprisonment and heavy fines. In all cases, the judgment is advertised in a daily newspaper at the expense of the convicted person.

**Marking**

No express requirement.

**Working**

Working of the patent in Egypt is compulsory. In the event that the owner of a patented invention does not satisfy the stipulated working requirements within three years as from the date of the grant, or within four years from the filing date, whichever period is longer, or if working ceases for one year without an acceptable reason, then the patent will be subject to compulsory licensing. If within two years as from the grant of the compulsory licence, the licensee does not exploit the patented invention, any interested party may apply to the patent office demanding the cancellation of the patent for non-working.

**Utility model patents**

Provision is made in the Law for the granting of utility model patents for any new technical addition to the structure or composition of devices, tools, equipment or their components, or to products, processes or means of manufacturing such devices, etc.

A utility model patent is protected for a non-renewable period of seven years from the filing date. An application for a utility model patent may be converted to a patent application, and *vice versa*.

## DESIGNS

### Law

- Law no 82 of 2002, Book Two pertaining to Marks, Trade Names, Geographical Indications, and Industrial Designs
- Law no 82 of 2002, Book One pertaining to Patents, Utility Models, Layout Designs for Integrated Circuits, and Undisclosed Information
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Books One and Two

Egypt is a member of the Paris Convention and the Hague Agreement and the WTO/TRIPS.

### Design protection

Design protection is obtainable via a national filing; since Egypt is a member of the Paris Convention, priority can be claimed.

Egypt is also a signatory to the Hague Agreement which allows for international registration of industrial designs. Egypt became a signatory to the Hague Agreement in 1952, but it is not clear if Egypt's national laws recognise international registrations designating Egypt, as this issue has not been tested by the courts.

### Registrable subject matter

Any arrangement or composition of lines and any three-dimensional form or embodiment, with or without colour, if it is novel and applicable in industry, shall be considered an industrial design.

The following designs cannot be registered:

- designs the shape of which is due to technical or functional requirements
- designs which include emblems, religious symbols, seals or flags of Egypt or any foreign country
- designs the use of which may undermine public order or offend public morality
- designs that are identical to or resemble a registered trade mark or a well-known mark.

### Classification of designs

The Locarno Classification is not applied.

### Types of applications

The law provides for a national filing. Priority may be claimed from an application, filed not more than six months earlier, in a country which is a member of the Paris Convention or the World Trade Organisation, or a country which applies reciprocity to Egypt.

As indicated above, it is not clear whether an international registration under the Hague Agreement (of which Egypt is a member state), designating Egypt, will have effect in Egypt. No express provision is made for such registrations.

### **Application**

A single application may include up to 50 designs, provided they collectively constitute a coherent unit, eg a set of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- representations (photographs or drawings) of the design
- certified extract of the entry of the applicant company in the Commercial Register or a certified copy of the certificate of incorporation (legalised)
- certified copy of the priority application (if applicable)
- brief description setting out the main features of the design
- assignment from the author/creator to the applicant.

### **Applicant**

The author or creator or his assignee can apply for a design.

Any person having a real and effective activity in any member state of the Paris Convention or of the World Trade Organisation or in any country that treats Egypt on a reciprocal basis, shall have the right to apply for an industrial design and can enjoy the resulting rights derived therefrom.

### **Convention priority**

An applicant who has filed a patent application in a convention country or in a member country of the WTO or in a country which applies reciprocity to Egypt, is entitled to claim priority from such earlier application, provided the application in Egypt is filed within six months from the earlier application.

### **Novelty**

Novelty is destroyed by display or description or use of the design prior to filing in Egypt. However, novelty will not be destroyed if the description or display occurs after the filing of an application in a member state of the Paris Convention or the WTO or in a state with which Egypt enjoys reciprocity, or if the design has been made public at a conference or in a scientific journal, provided an application is filed in Egypt within six months.

The law also states that a design will not be considered to be novel if it is not essentially different in comparison to the prior industrial designs.

Temporary protection can be obtained for designs displayed at officially recognised exhibitions.

### **Examination/procedure**

Examination is conducted to determine that the formal requirements have been met, and to determine that the design falls within the definition of a registrable design (see the section on **Registrable subject matter** above).

An applicant may be called on to correct or modify the application to meet the requirements for registrability. If the applicant does not fulfil the requirements he shall be deemed to have abandoned the application.

Applicants whose applications have been rejected may appeal against the decision within 30 days; the appeal will be heard by a three member committee, and a further appeal is possible to the Administrative Tribunal.

Registration, renewal and cancellation decisions are published in the *Trademarks and Industrial Designs and Models Gazette*.

### **Opposition**

Designs are advertised for opposition purposes. Any interested party may oppose the registration of the design within 60 days of the date of the advertisement in the Gazette.

### **Duration and maintenance**

The initial term of a design registration is 10 years, which is extendible upon payment of a renewal fee for a further five year term. The term of the registration starts from the date of application for registration. Term extension can only be requested within the last year of the initial 10 year term.

There is a three month grace period for payment of the renewal fees.

### **Restoration**

No provision.

### **Revocation**

The Department or any interested party may file a case with the Administrative Tribunal for the revocation of an unlawful design registration. Although this is not expressly provided for, it is presumed that revocation can be requested on any ground on which the application could have been refused.

### **Assignments and licences**

Assignments and licences must be recorded in the register to be enforceable against third parties.

Requirements for recordal:

- power of attorney from the assignee or licensee (legalised)
- assignment or licence document (legalised)
- certified extract of the entry of the assignee or licensee in the commercial register, or a certified copy of the certificate of incorporation (legalised).

### **Compulsory licences**

Provisions are made for the granting of compulsory licences in the public interest and subject to the approval of a Ministerial Committee.

### **Effect of a design registration**

Registration confers on the owner the right to prohibit third parties from using, manufacturing, selling or importing products bearing or incorporating the registered design. The right of the owner is exhausted when he himself markets the products, or licenses a third party to do so.

### **Infringement**

Infringement proceedings may be brought in a competent court. Civil sanctions (including fines, seizure of infringing articles, confiscation and destruction of the infringing goods) apply for first offenders, but repeat offenders are subject to imprisonment and heavy fines. In all cases, the judgment is advertised in a daily newspaper at the expense of the convicted person.

Certain acts are deemed not to constitute infringement:

- activities related to scientific research
- use for teaching and training purposes
- non-commercial activities
- manufacture or sale of parts of such products for the purpose of repair
- other uses which do not conflict with the normal exploitation of the protected right.

### **Marking**

No provisions.

### **Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Law no 82 of 2002, Book Three pertaining to Copyright and Neighbouring Rights
- Decree no 497 of 2005, Executive Regulations for implementing Law no 82 of 2002, Book Three (amended by Decree no 1241 of 2006, Decree no 2202 of 2006)

Egypt is a member of the Berne Convention, the Phonograms Convention, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The law confers copyright on the authors of literary and artistic works. A work is defined to mean any literary, artistic or scientific creation of whatever type or mode of expression. The creative aspect refers to the originality of the work. The following works are specifically included:

- books, articles, bulletins and any other written works
- computer programs
- databases, whether readable by computer or otherwise
- lectures, speeches, sermons and other oral works
- dramatic and dramatic-musical works
- musical works
- audiovisual works
- works of architecture
- drawings, sculpture, lithography
- photographic works
- works of applied art
- derivative works.

Derivative works are derived from existing works, such as translations, re-arrangements, compilations, and collections of expressions of folklore.

### **Exclusions from copyright**

The protection does not cover mere ideas, concepts, procedures, operational methods, etc.

Also excluded are:

- official documents, such as laws, regulations
- news on current events.

### **Authorship and ownership of copyright**

The author or his successor in title shall enjoy the exclusive right to authorise or prevent any form of exploitation of the work. These are the so-called economic rights, and include the right to a share (not more than 10%) in the proceedings of any disposal of the original copy of the work.

### **Duration of copyright**

The economic rights arising from copyright generally endure for the lifetime of the author plus 50 years after his death. The economic rights in a work of applied art expire 25 years after the date on which the work was first published or made available to the public. Sound recordings are protected for 50 years from the date on which the recording was made; broadcasts are protected for 20 years from the date of broadcast.

### **Protection afforded by copyright**

The economic rights enjoyed by the author or his successor in title include the right to –

- reproduce the work
- broadcast or rebroadcast the work
- perform the work in public, or communicate the work to the public
- translate or adapt the work
- rent or lend the work to the public (in regard to certain works).

### **Exceptions to copyright protection**

The law provides for certain restrictions to the economic as well as moral rights arising from copyright.



**Moral rights**

The author also enjoys the moral rights in respect of the copyright work, including the right to make the work available to the public for the first time, the right to claim authorship, and the right to prevent the distortion or mutilation of the work. The moral rights cannot be alienated.

**Assignment and licensing of copyright**

The author or his successor in title has the right to transfer or license the economic rights vested in him.

**Copyright infringement**

In the case of infringement, the copyright owner may institute civil proceedings and will be entitled to certain remedies, including an interdict (injunction), seizure of infringing copies, and an account of income arising from the infringement.

**Criminal offences**

In certain cases, infringement constitutes a criminal offence and is punishable by a fine and imprisonment.

**PLANT BREEDERS' RIGHTS****Law**

- Law no 82 of 2002, Book Four pertaining to Plant Varieties
- Council of Ministers Resolution no 1366 of 2003, Regulations for implementing Law no 82 of 2002, Book Four
- Ministerial Decree no 492 of 2003, establishing the Office for the Protection of Plant Varieties
- Ministerial Decree no 807 of 2005, determining plant species protected under Law 82 of 2002

Egypt is not a member of the UPOV Convention for the Protection of New Varieties of Plants.

**Protection**

Plant Breeders' Rights can be obtained in Egypt. The effect of the protection is that the plant breeder's right holder has an exclusive right to commercial exploitation of the protected variety in any form whatsoever. No production, propagation, circulation, sale, marketing, importing, or exporting of propagating material is allowed without the written consent of the plant breeder's right holder.

**Protectable subject matter**

Protection can, it seems, be obtained for a new variety of any kind of plant.

**Requirements for registrability**

To qualify for registration, and thus for protection under a plant breeder's right, a plant variety must be new, distinct, uniform and stable.

A plant variety is deemed to be new if propagating material thereof has not been exposed or circulated outside Egypt for more than six years (in the

case of trees and vines) or for more than four years (for other crops), or for more than one year inside Egypt.

### **Application**

The requirements for filing an application for a plant breeder's right include the following:

- an application form
- a completed technical questionnaire
- a power of attorney
- a deed of assignment (if applicable)
- propagating material/plant specimens.

### **Denomination of variety**

A variety denomination is required in addition to data such as the scientific name, common name, and genus.

### **Applicant**

The applicant of a plant breeder's right application may be the breeder, or a successor in title to the breeder, eg by means of contract, succession or proxy.

### **Convention priority**

There is no provision for claiming convention priority.

### **Examination/procedure**

Plant breeders' rights applications are filed at the Office of Plant Variety Protection, which is also responsible for the prosecution of the applications.

### **Provisional protection**

Provisional or temporary protection commences from the date of filing of the application and endures up to the date of publication of grant. During this period the breeder is entitled to fair compensation provided that he has given notice to an infringing party.

### **Infringement**

For acts which constitute an infringement of a plant breeder's right, see the section on **Protection**. Certain acts constitute exceptions to infringement, such as use for private or non-commercial purposes, experimental activities, etc.

### **Duration**

Plant breeders' rights are granted for 25 years for trees and vines, and for 20 years for other crops, running from the date of grant.

### **Voluntary licences**

The right holder may grant a voluntary licence to a licensee.

### **Compulsory licences**

The law makes provision for compulsory licences in certain circumstances, eg to combat unfair competition, to safeguard the public interest, etc.

# EQUATORIAL GUINEA

## GENERAL INFORMATION

The Republic of Equatorial Guinea is located on the west coast of Central Africa. It is bordered on the north by Cameroon, on the east and south by Gabon, and on the west by the North Atlantic Ocean.



<b>Area:</b>	28 051 km <sup>2</sup>
<b>Population:</b>	0.7 million
<b>Capital:</b>	Malabo
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 24.66 billion (2010)
<b>Internet domain:</b>	.gq
<b>Languages:</b>	Spanish (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Timber; cocoa; petroleum; methanol
<b>Imports:</b>	Sector equipment; petroleum; food; beverages; clothing; machinery.

## International/regional conventions

Equatorial Guinea is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 2000)
- Berne Convention (since 1997)
- Nairobi Treaty on Olympic Symbol (since 1982)
- Paris Convention (since 1997)
- Patent Cooperation Treaty (since 2001)
- WIPO Convention (since 1997).

## IP legislation

Equatorial Guinea is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

## **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# ERITREA

## GENERAL INFORMATION

Eritrea lies on the north-eastern coast of Africa, bordered on the north-east side by the Red Sea. The country has land borders with Djibouti to the south-east, Ethiopia to the south, and Sudan to the west.



Eritrea existed as an autonomous entity until it federated with Ethiopia in 1952.

This was followed by annexation by Ethiopia in 1962 and a lengthy armed struggle. In 1993, in a referendum supported by Ethiopia, Eritreans voted for independence. Border issues still exist between Eritrea and Ethiopia, which hamper socio-economic development.

<b>Area:</b>	117 600 km <sup>2</sup>
<b>Population:</b>	5.8 million
<b>Capital:</b>	Asmara
<b>Currency:</b>	Nakfa
<b>GDP:</b>	\$ 4.18 billion (2010)
<b>Internet domain:</b>	.er
<b>Languages:</b>	Arabic, Tigriñya, Afar (Danakil), Amharic, English, Italian
<b>Working week:</b>	Monday – Friday
<b>Exports:</b>	Livestock; sorghum; textiles; food; small manufactures
<b>Imports:</b>	Machinery; petroleum products; food; manufactured goods

## International/regional conventions

Eritrea is a member of the following international agreement:

- WIPO Convention (since 1997)

## IP legislation

Trade marks

- No specific legislation

Patents

- No specific legislation

Designs

- No specific legislation

Copyright

- No specific legislation

## **TRADE MARKS**

### **Trade mark protection and types of marks**

After gaining independence from Ethiopia in 1993, Eritrea no longer recognised trade mark rights acquired in terms of Ethiopian law. No legislation has been enacted to remedy the situation and it is, consequently, not possible to obtain registered trade mark rights in Eritrea. The Government of Eritrea, through no official mechanisms, permitted the publication of cautionary notices in government-owned newspapers until August 2009. A moratorium was placed on this practice by the Eritrean Government (specifically the Ministry of Information), for political reasons. It is expected that the situation will change in the not too distant future.

### **Marking of goods**

In the absence of marking requirements, it is prudent to follow the importer's instructions or specific contract specifications.

## **PATENTS**

### **Patent protection**

As indicated above, Eritrea was a province of Ethiopia and became independent of Ethiopia in May 1993. No patent protection is currently available in this country.

## **DESIGNS**

### **Design Protection**

As indicated above, Eritrea was a province of Ethiopia and became independent of Ethiopia in May 1993. No design protection is currently available in this country.

## **COPYRIGHT**

There is no copyright legislation in Eritrea at the present time. Eritrea has also not acceded to the Berne Convention yet, so that there is no certainty about the protection of copyright in Eritrea.

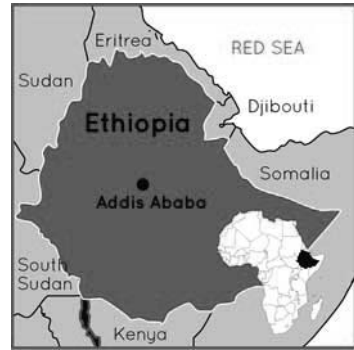
## **PLANT BREEDERS' RIGHTS**

It has not been possible to determine whether or not, currently, plant breeders' rights or other *sui generis* protection for plants are available in Eritrea.

# ETHIOPIA

## GENERAL INFORMATION

Ethiopia is a land-locked country situated in East Africa. Sudan and South Sudan lie to the west of Ethiopia; Kenya to the south; Somalia and Djibouti to the east and Eritrea to the north and beyond these countries the Red Sea.



<b>Area:</b>	1 104 300 km <sup>2</sup>
<b>Population:</b>	88 million
<b>Capital:</b>	Addis Ababa
<b>Currency:</b>	Birr
<b>GDP:</b>	\$ 84 billion (2010)
<b>Internet domain:</b>	.et
<b>Languages:</b>	Amharic (official language), Afar (Danakil), Somali, Tigrīnya, English
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; leather products; gold; oil seed
<b>Imports:</b>	Food and live animals; petroleum and petroleum products; chemicals; machinery; motor vehicles and aircraft

## International/regional conventions

Ethiopia is a member of the following international agreements:

- Nairobi Treaty on Olympic Symbol (since 1982)
- WIPO Convention (since 1998)

## IP legislation

Trade marks

- Proclamation no 501/2006 on Trade Mark Registration and Protection (only partially in force; Regulations not yet promulgated)
- Directive for the Deposit of Trade Marks and the Establishment of a National Trade Mark Register, 1986

**Note:** Until such time as the Regulations have been implemented, a hybrid of the above two system is being applied.

Patents

- Proclamation no 123/1995 on Inventions, Minor Inventions and Industrial Designs
- Regulations no 12/1997 on Inventions, Minor Inventions and Industrial Designs

Designs

- Proclamation no 123/1995 on Inventions, Minor Inventions and Industrial Designs
- Regulations no 12/1997 on Inventions, Minor Inventions and Industrial Designs

### Copyright

- Proclamation no 410/2004 on Copyright and Neighbouring Rights Protection

### Related areas

- Proclamation no 481/2006 on Plant Breeders' Right
- Proclamation no 329/2003 on Trade Practice
- Proclamation no 482/2006 on Access to Genetic Resources and Community Knowledge, and Community Rights

## **TRADE MARKS**

### **Law**

- Proclamation no 501/2006 on Trade Mark Registration and Protection (only partially in force; Regulations not yet promulgated)
- Directive for the Deposit of Trade Marks and the Establishment of a National Trade Mark Register, 1986

Ethiopia is not a member of the Paris Convention, nor of the Madrid Agreement/Protocol nor the WTO/TRIPS.

### **Trade mark protection**

Trade marks may be registered in respect of goods and services. The law also provides for the registration of collective trade marks.

### **Protection of well-known marks**

Although Ethiopia is not a member of the Paris Convention, the Proclamation expressly provides that a trade mark which is entitled to protection as a well-known trade mark under an international convention of which Ethiopia is a party, shall be protected if it is also well known in Ethiopia. The effect of this provision is not entirely clear.

### **Advantages of trade mark registration**

The owner of a registered trade mark has the right to use the mark or to authorise or preclude any other person from using the mark in Ethiopia, in relation to the goods or services in respect of which the mark is registered.

The owner also has the right to preclude others from any use of a mark or sign resembling the registered trade mark in such a way as to be likely to mislead the public, or any use in relation to other goods or services where such use is likely to mislead the public.

The owner further has the right to preclude others from any use of a trade mark resembling the registered mark in circumstances likely to be prejudicial to his interests and other similar acts.

### **Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- collective trade marks.



**Definition of a trade mark**

A trade mark is defined to mean any visible sign capable of distinguishing goods or services of one person from those of other persons. A trade mark may include words, designs, letters, numerals, colours or the shape of goods or their packaging, or a combination thereof.

**Definition of a collective trade mark**

A collective trade mark means a trade mark distinguishing the goods or services of members of an association, which is the owner of the trade mark, from those of other undertakings.

**Limitation to colour**

The law provides that a trade mark may be registered in black-and-white (in which case it is protected in all colour combinations), or in colour (in which case it is only protected in the colour combination in which it is registered).

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied.

An application may cover any number of goods and/or services and any number of classes, but may cover only one trade mark.

**Convention priority**

Although Ethiopia is not a member of the Paris Convention, the Proclamation expressly provides for priority to be claimed, provided the application in Ethiopia is filed within six months from the date of the first-filed foreign application.

**Application**

An application for the registration of a trade mark is filed at the Ethiopian Intellectual Property Office (EIPO).

The following information and documents are required:

- full particulars of the applicant
- power of attorney (legalised), in English and Amharic
- certified copy of the home registration certificate
- copies of the trade mark
- list of goods and services.

An application may cover only one trade mark, but may cover multiple classes.

**Note:** The EIPO also administers a formalised cautionary notice system for purposes of notifying the public of the existence of the proprietary rights in respect of the trade mark.

**Examination**

The Ethiopian Intellectual Property Office (EIPO) examines the application as to form and substance. If the application is found to be acceptable, a notice inviting opposition is published in two newspapers in English and Amharic.

If no opposition is lodged (see the section on **Opposition** below), a registration certificate is issued.

**Opposition**

Opposition may be lodged within 30 days of publication. The EIPO is empowered to grant extensions of time in terms of the legislation.

**Opposition proceedings**

Any person who objects to the registration of a trade mark may file a notice of opposition stating the grounds, together with supporting documentation, at the EIPO. The EIPO sends a copy to the applicant, who may then file a counter-statement within the prescribed period. If the trade mark applicant fails to file a counter-statement, the application shall be deemed to be abandoned. If a counter-statement is filed, the EIPO examines the merits of the case and makes a decision. It is possible to appeal the EIPO's decision to the court.

**Grounds of opposition**

To succeed with an opposition, the opponent must show that the application does not comply with the provisions of the Proclamation.

The following marks are not registrable:

- a mark which is incapable of distinguishing the goods or services of a person
- a mark which consists of a sound or smell
- a mark which is contrary to public order or morality
- a mark that consists exclusively of the surname of the applicant, or the full name of another individual without his consent
- a mark which consists exclusively of signs designating the quality, quantity, intended purpose, value, geographical origin of goods or services, or time of production or other characteristics of the goods or services
- a mark which consists exclusively of a sign which has become customary in the current language or economic and business activities in relation to the goods or services for which registration is applied
- a mark identical to, or an imitation of, the armorial bearing, flag, emblem, name or official sign of any state, intergovernmental or international organisation
- a mark likely to mislead the public, eg as regards the origin of the goods or services
- a mark consisting exclusively of a shape resulting from the nature of the goods or necessary to obtain a technical result

- a mark which is identical with an earlier trade mark registration or application for the same goods or services or closely related goods or services, or if it so nearly resembles such a trade mark as to be likely to deceive or cause confusion
- a mark which is identical with or confusingly similar to, or contains a translation of, a trade mark which is well known or established by use in Ethiopia for identical or similar goods or services of another person
- a mark which is identical with or confusingly similar to, or constitutes a translation of, a trade mark which is well known and registered in Ethiopia for goods or services which are not identical or similar, where the use of the mark would indicate a connection between those goods or services and the interests of the trade mark owner are likely to be damaged by such use
- a mark which contains the characteristic title of another person's protected literary or artistic rights, or another person's right to a photograph or design, without that person's consent.

### **Duration and renewal**

The period of protection is six years from the date of registration. Renewal may be effected for consecutive periods of six years upon payment of the required fees. Upon renewal, no changes may be made to the trade mark, except that goods or services may be removed from the list of goods and services.

Interim cautionary notices are published on the second and fourth anniversaries of the registration date.

### **Cancellation/removal of a trade mark**

The registration of a trade mark may be invalidated upon the written request of any interested person, or upon the initiative of the EIPO itself.

### **Grounds for cancellation/removal of a trade mark**

Any interested person may apply for the invalidation of a trade mark registration if such person can prove that the registration did not comply with the requirements of the law (see the section on **Grounds of opposition** above).

A decision declaring the registration to be invalid is effective from the date of registration of the trade mark.

### **Use requirement and cancellation**

A trade mark may in law be cancelled on the ground that it has not been used in Ethiopia for a continuous period of at least three years. The Proclamation requires use within three years of registration, but this is not applied in practice, and as such, there are no use requirements enforced at present.

**Assignment**

The right to a trade mark may be assigned, with or without the goodwill of the business. Although recording of an assignment is not peremptory, it is advisable for enforcement against third parties.

Requirements for recordal:

- power of attorney (legalised)
- deed of assignment (legalised).

**Licensing/registered users**

The right to a trade mark may be licensed. Recording of a licence is not peremptory but is necessary (currently by way of publication) for enforcement against third parties.

Requirements for recordal:

- power of attorney from owner (legalised)
- power of attorney from licensee (legalised)
- licence agreement (legalised).

**Amendment**

A trade mark registration may be amended to renounce or cancel some of the goods or services covered by the registration. This is again effected by way of publication in the two newspapers.

**Rights conferred by registration**

The owner of a registered trade mark has the right himself to use the trade mark, or to authorise any other person to use the trade mark in relation to goods or services for which it has been registered.

The trade mark owner also has the right to preclude all others from using the trade mark or a mark resembling it in such a way as to be likely to mislead the public, or in circumstances likely to prejudice the interests of the owner.

**Trade mark infringement**

A registered trade mark is infringed by any person who, without authority from the owner or licensee, carries out any of the acts reserved exclusively for the trade mark owner. Although the scope of the protection afforded to well-known marks is not clearly spelled out, the legislation does also envisage action being instituted by the owner of a well-known mark in respect of the unlawful use of a well-known mark.

**Defences to trade mark infringement**

Registration of a trade mark does not confer upon the owner the right to preclude third parties from:

- using the trade mark in relation to the goods lawfully sold in any country under that trade mark, provided the goods have not undergone any change

- the *bona fide* use of their own names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, time of production or supply of their goods or services, provided the use is confined to the purposes of mere identification or information and is not misleading.

### **Relief for trade mark infringement**

The Ethiopian Federal High Court has jurisdiction to decide on cases of trade mark infringement. Both civil and criminal proceedings are available.

In civil proceedings the court may order provisional measures to –

- prevent infringement from occurring, and in particular to prevent infringing articles from entering into the channels of commerce
- preserve relevant evidence in regard to an alleged infringement of a right.

After hearing the case, the court may order an injunction to stop continued infringement, and payment of damages.

Criminal proceedings are available where there has been an intentional violation of a trade mark owner's rights. In such cases, the court may impose punishment in the form of imprisonment. Seizure, forfeiture and destruction of the goods may also be imposed.

### **Common law rights**

Recognition is given to third party common law rights, inasmuch as a trade mark may not be registered if it is identical to, or confusingly similar to, a trade mark of another person that is well known or established by use in Ethiopia. A trade mark may also not be registered if it contains anything that is characteristic of another person's protected literary or artistic rights.

### **Marking of goods**

Marking of goods with notification of registration, eg by use of the words 'Registered Trade Mark' or the symbol ®, is optional. Until the Proclamation is fully in effect, this is not a requirement.

## **PATENTS**

### **Law**

- Proclamation no 123/1995 on Inventions, Minor Inventions and Industrial Designs
- Regulations no 12/1997 on Inventions, Minor Inventions and Industrial Designs

Ethiopia is not a member of the Paris Convention, nor of the PCT or the WTO/TRIPS. However, priority is afforded on the basis of a first-filed application in another country.

**Patent protection**

Patent protection is obtainable by way of a patent granted on a national filing. A patent is granted in respect of an invention which entails patentable subject matter (see the section on **Patentable subject matter** below). A so-called patent of introduction (or importation) is granted to an invention which has been patented in another country where such patent has not yet expired (the period of protection being limited to 10 years). So-called minor (or petty) inventions may be protected by utility model certificates.

**Types of patents**

The law provides for:

- conventional patents, for inventions that are new, inventive and industrially applicable
- patents of introduction (or importation), for inventions which have been patented in another country
- utility model certificates, for minor inventions that are novel and industrially applicable.

**Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

The following inventions are not patentable:

- inventions that are contrary to public order or morality
- plant or animal varieties or essentially biological processes for the production of plants or animals
- schemes, rules or methods for playing games or performing commercial and industrial activities and computer programs
- discoveries, scientific theories and mathematical methods
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body.

**Types of applications**

The Proclamation provides for applications for a patent to be made by way of –

- an application for a patent to protect an invention that is new, involves an inventive step, and is industrially applicable
- an application for a patent of introduction (or importation) to protect an invention already patented in another country
- an application for a utility model certificate to protect a minor (or petty) invention.

**Application**

Patent applications are filed with the Ethiopian Intellectual Property Office (EIPO).

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised and legalised)
- assignment of invention (if applicable; legalised)

- specification (including claims, drawings and abstract), in English and Amharic
- certified copy of the priority document (if applicable; legalised).

**Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

**Novelty**

An invention is considered new if it is not anticipated by prior art. Prior art consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing date or, where appropriate, the priority date.

**Certain prior knowledge or publication excused**

A disclosure to the public shall not be taken into account if –

- it occurred within 12 months preceding the filing date or the priority date and was made by the applicant or his predecessor
- it occurred by reason of an abuse by a third party.

**Inventiveness**

An invention is considered inventive if, having regard to the prior art, it would not have been obvious to a person skilled in the art.

An invention is considered industrially applicable if it can be made or used in handicraft, agriculture, fishery, social service and any other sector.

**Convention priority**

Although Ethiopia is not a member of the Paris Convention, the Ethiopian Intellectual Property Office recognises the right to priority, and affords an application a priority claim on the basis of the first-filed foreign application, provided the Ethiopian application is filed within 12 months of the first filing.

**Examination/procedure**

A formal examination as well as a substantive examination are conducted. The substantive examination follows once all formal requirements have been complied with. Substantive examination can be avoided by a foreign applicant, by filing a copy of a patent granted on a corresponding application in another country to obtain a so-called patent of introduction (or importation).

**Opposition**

No provision.

**Publication**

Upon grant, a reference to the grant is published in the Official Gazette.

### **Duration and maintenance**

The initial term of a patent is 15 years calculated from the filing date, with an option to renew the patent for a further period of five years subject to proof of adequate working in Ethiopia.

For a patent of introduction (or importation) the term expires with the foreign patent on which it is based, but the maximum term is 10 years.

An annual fee is payable as from the first anniversary of filing. A grace period of six months is allowed for the late payment of the annual fee. If the fee is not paid within the grace period, the patent lapses.

### **Restoration**

No provision.

### **Assignments**

No provision.

### **Voluntary licences**

Although no express provision is made for voluntary licences, the law recognises that the patent owner may give his consent to (ie license) a third party to exploit the patented invention.

### **Compulsory licences**

The Proclamation provides for compulsory licences to be granted by the Commission (ie the Ethiopian Science and Technology Commission) in two circumstances:

- where a patent owner cannot work his invention effectively without a licence under an earlier patent or a later patent
- where a patent owner fails, without legitimate reason, to work his invention in Ethiopia after expiration of a period of three years from grant or four years from filing (see the section on **Working** below).

### **Amendments**

No provision.

### **Revocation**

A patent may be invalidated on application to the court by an interested party on the following grounds:

- that the subject matter of the patent is not patentable as required (see the section on **Patentable subject matter** above).
- that the description does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

### **Effect of a patent**

The exclusive rights granted to a patent owner include making, using and exploiting the patented invention.



In the case of a patent of introduction/importation, the patentee does not have an exclusive right to import the products of the patented invention.

There are also certain further limitations on the rights afforded the patent owner, including:

- acts done by others for non-commercial purposes
- use of the patented invention solely for scientific research and experimentation
- acts in respect of patented articles which have been put on the market in Ethiopia by the patentee
- use of the patented invention for national security, nutrition, health or vital economic sector development (subject to payment of equitable remuneration).

### **Infringement**

Infringement of a patent occurs where a third party, without securing the consent of the patent owner, exploits the patented invention.

Enforcement of patent rights takes place by way of a civil action in the Federal Court.

### **Marking**

No express provision.

### **Working**

Working of the patented invention is required before the term of a patent is extended beyond 15 years. Proof of working is also required with annual renewal of a patent of introduction/ importation from the third year after it has been granted.

Furthermore, in order to avoid the grant of a compulsory licence, a patent owner has to work the patented invention in Ethiopia within a period of three years from the date of grant, or four years from the date of filing, whichever period expires last.

### **Utility model certificates**

A utility model certificate protects minor inventions that possess novelty and are industrially applicable. Accordingly, inventions which involve small adaptations of existing technologies and which are new in Ethiopia and industrially applicable can be protected by way of utility model certificates.

A utility model certificate is granted for a period of five years, which period may be extended for a further five years provided that proof is submitted that the minor invention is being worked in Ethiopia.

At any time before grant or refusal, a patent application may be converted to an application for a utility model certificate, and *vice versa*.

## DESIGNS

### Law

- Proclamation no 123/1995 on Inventions, Minor Inventions and Industrial Designs
- Regulations no 12/1997 on Inventions, Minor Inventions and Industrial Designs

Ethiopia is not a member of the Paris Convention nor of the WTO/TRIPS; yet the law and the Ethiopian registry recognises a claim to priority rights provided the application is filed within six months of the first-filed corresponding application (see the section on **Convention priority** below).

### Design protection

Protection may be obtained for an industrial design by way of a design certificate.

Design protection does not extend to any feature of the design which serves only to obtain a technical result.

### Registrable subject matter

An industrial design is defined as any composition of lines or colours, or any three-dimensional form whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft.

Accordingly, a design comprises the original shape or configuration of an article which is industrially applicable. Designs which are contrary to public order or morality are excluded from protection. Design protection does not extend to any feature which serves only to achieve a technical result.

### Classification of designs

No express requirement for classification, apart from a provision that a design application must relate to one design incorporated in one product, or two or more designs incorporated in products belonging to the same class and used in sets.

### Types of applications

An application may be filed as a national application, in appropriate circumstances claiming priority from an earlier filed application.

### Application

Applications for design registrations are filed with the Ethiopian Intellectual Property Office (EIPO).

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- assignment of design (if the applicant is not the creator; legalised)
- graphic representations or drawings

- certified copy of the priority document (if applicable; legalised), with verified English translation (if not in English).

**Applicant**

The creator of the design may apply, or his successor in title.

**Convention priority**

Although Ethiopia has not acceded to the Paris Convention, a priority claim is allowed provided the application is filed within six months of the first-filed foreign application.

**Novelty**

A design must be new and possess practical applicability. A design is considered new when the sum total of its essential features is different from that of another design known in Ethiopia or in another country; and if the design has not been disclosed for more than one year prior to the date of the application, or the priority date (where applicable). A design is deemed to possess practical applicability if it is capable of serving as a model for repeated manufacture of products.

A utility model must be new in Ethiopia.

**Examination/procedure**

A design application is examined for formal requirements (to ensure that it is in the correct form), and for registrability (to ensure that it is new, ie not anticipated by a previously filed design, and has practical applicability).

**Opposition**

No express provision is made for opposition.

**Duration and maintenance**

The term of protection for a design is five years, renewable for two further periods of five years upon payment of the prescribed fee. The term of protection for a utility model is the same as for a design.

**Restoration**

No provision.

**Assignments and licences**

No express provision.

**Compulsory licences**

No provision.

**Revocation**

No provision.

### **Effect of a design registration**

The owner of a design registration has the exclusive right to make, use or otherwise exploit the industrial design.

### **Infringement**

No express provision, except that the patent-related provisions of the law are made applicable, *mutatis mutandis*, to industrial designs.

### **Marking**

No provision.

### **Working**

No provision.

## **COPYRIGHT**

### **Law**

- Proclamation no 410/2004 on Copyright and Neighbouring Rights Protection

The Proclamation provides protection for copyright works, and also protects the rights of performers, producers of phonograms, and of broadcasters.

Ethiopia is not a member of the Berne Convention nor of the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The following works, if they are original and reduced to material form, are eligible for copyright protection:

- literary works, including books, pamphlets, articles and other writings
- oral works, including speeches, lectures, addresses, sermons
- musical works
- dramatic, dramatico-musical works, pantomimes, choreographic works, and other works created for stage production
- sound recordings and audio-visual works
- works of architecture
- works of fine arts, including drawings, paintings, sculpture, engravings, lithography, tapestry
- photographic and cinematographic works
- illustrations, maps, plans, sketches and three-dimensional works related to geography, topography, architecture or science
- computer programs
- derivative works, including translations, adaptations and arrangements
- collections of works, collections of mere data (databases), whether readable by machine or other form.

**Requirements for subsistence of copyright**

Works eligible for copyright are protected automatically; there is no registration requirement.

In order to be eligible for copyright, the following requirements must be satisfied:

- the work must be original
- the work must be written down, recorded, fixed, or otherwise reduced to material form
- the author must be a national of, or have his habitual residence in, Ethiopia
- a work first published in Ethiopia, or first published in another country and then published in Ethiopia within 30 days, is protected
- audio-visual works where the producer has his headquarters or habitual residence in Ethiopia, are protected
- works of architecture erected in Ethiopia, and other artistic works incorporated in a building located in Ethiopia, are protected.

**Authorship and ownership**

The author is generally the first owner of the copyright in the work. Copyright may be assigned.

**Exclusions from copyright**

Certain subject matter is excluded from protection:

- ideas, procedures and systems, methods of operation, concepts, formulas, numerical tables, discoveries, mere data
- official texts of a legislative, administrative or legal nature.

**Duration of copyright**

The term of copyright is as follows:

- literary, artistic and musical works: the life of the author plus 50 years
- performers and producers of sound recordings: 50 years
- broadcasting rights: 20 years
- computer programs: 50 years.

**Exceptions to copyright infringement**

The Proclamation provides for certain limited exceptions, when the copying of a work will not constitute infringement. These include:

- copying of a work for personal use
- copying of a work for the purpose of teaching, or for use in libraries, museums and similar institutions.

**Assignment of copyright**

The economic rights under copyright may be assigned or licensed. Such assignment or licence must be in writing.

**Licensing of copyright**

Unauthorised use of copyright works is prohibited. Authorised use, eg by way of a licence, is permitted.

### **Protection afforded by copyright**

The protection afforded by copyright entails economic rights as well as moral rights.

#### **Economic rights**

The copyright owner has the right to prevent all others from copying the copyright work, and has the exclusive right to utilise the work commercially. In particular the copyright owner has the exclusive right to carry out or authorise the following acts:

- reproduction of the work
- translation, adaptation, arrangement or transformation of the work
- distribution of the work to the public by sale or rental
- importation of original copies of the work
- display of the work
- performance of the work
- broadcasting the work, or communicating it to the public.

#### **Moral rights**

The author of a work has the following moral rights irrespective of whether he owns the economic rights:

- the right to claim authorship, or to remain anonymous
- the right to object against any distortion, mutilation or alteration of the work which would be prejudicial to his honour or reputation
- the right to publish the work.

#### **Copyright infringement**

In the case of infringement, ie the unauthorised use of the copyright work by others, the copyright owner may institute a civil action or a criminal action, depending on the nature of the infringing act.

Civil remedies include an injunction, confiscation of infringing copies, impounding of packaging and implements used for infringement, and damages. Criminal sanctions may include imprisonment.

## **PLANT BREEDERS' RIGHTS**

Law

- Proclamation no 481/2006 to provide for Plant Breeders' Rights

Ethiopia is not a member of the UPOV Convention for the Protection of new Varieties of Plants.

#### **Protection**

The effect of the protection is that the holder of a plant breeder's right has the following exclusive rights:

- to sell, including the right to license other persons to sell, the seed or propagating material of the protected variety
- to produce, including the right to license other persons to produce, propagating material of the protected variety for sale.

Other persons are prohibited from carrying out these activities without the authorisation of the right holder.

**Protectable subject matter**

Protection can be obtained in respect of a new plant variety.

**Requirements for registrability**

A new plant variety is defined to mean a variety that –

- by reason of identifiable characteristics, is distinguishable from other varieties
- is stable in its essential characteristics, in that after repeated reproduction it remains to its description
- is sufficiently homogenous or is a well-defined multi-line
- its material has not been sold or otherwise disposed of for commercial purposes, in Ethiopia or elsewhere, earlier than the specified period before the application (one year in the case of Ethiopia; either four or six years outside Ethiopia, depending upon the variety).

**Application**

Application for a plant breeder's right is made to the Ministry (of Agriculture and Rural Development).

**Applicant**

The applicant for a plant breeder's right may be the breeder, whether or not the breeder is an Ethiopian national or a foreigner, or his successor in title.

**Convention priority**

There is no provision for claiming convention priority.

**Examination/procedure**

The Ministry is responsible for the examination of applications lodged with it and shall grant a plant breeder's right if it is satisfied that –

- the plant variety is new
- there is no ground for refusing the application
- the breeder can prove that he obtained the genetic resource in accordance with the laws on access to genetic resources
- a plant breeder's right has not been granted to another person
- there has been no earlier application in respect of the same variety
- all fees have been paid.

**Provisional protection**

The applicant is deemed to have a plant breeder's right during the period between the date of application and the granting or final rejection of the application. During this period the Ministry must take the necessary measures to prevent the use of the genetic material of the variety for non-research purposes.

### **Infringement**

Infringement occurs when another person carries out any of the exclusive rights afforded the holder of the plant breeder's right without the authorisation of the holder (see the section on **Protection** above). Certain acts are exempted, such as propagating or using a protected variety for purposes other than commerce; selling plants or propagating material for use as food; using plants or propagating material for purposes of developing a new plant variety; etc.

### **Duration**

Plant breeders' rights are granted for a period of 20 years for annual crops, and 25 years for trees, vines and other perennial trees.

### **Voluntary licences**

The right holder may grant voluntary licences.

### **Compulsory licences**

Provision is made for the Ministry to grant compulsory licences if –

- the holder is not producing and selling propagating material in sufficient amounts to meet the needs of the public and has refused to grant voluntary licences on reasonable terms
- there is no condition under which the holder can be expected to give a permit to use his protected variety.

### **Assignment**

A plant breeder's right may be transferred. In order to have effect, a transfer must be recorded in the register of plant breeders' rights.

### **Revocation**

Provision is made for a plant breeder's right to be revoked in certain circumstances.



# GABON

## GENERAL INFORMATION

The Republic of Gabon, formerly part of French Equatorial Africa, lies on the west coast of Africa. It is bordered to the west by the Atlantic Ocean, to the north by Equatorial Guinea and Cameroon and to the east and south by the Congo.



<b>Area:</b>	267 667 km <sup>2</sup>
<b>Population:</b>	1.5 million
<b>Capital:</b>	Libreville
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 22.54 billion (2010)
<b>Internet domain:</b>	.ga
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Crude oil; manganese; timber; uranium
<b>Imports:</b>	Machinery and equipment; foodstuffs; chemicals; petroleum products; construction materials

## International/regional conventions

Gabon is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1962)
- Hague Agreement on Designs (since 2003)
- Lisbon Agreement on Appellations of Origin (since 1975)
- Paris Convention (since 1964)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1975)
- WIPO Copyright Treaty (since 2002)
- WIPO Performances and Phonograms Treaty (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

Gabon is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Gabon thus had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear which of the legal dispensations will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

## **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# GAMBIA, THE

## GENERAL INFORMATION

The Gambia is an independent republic within the British Commonwealth, on the west coast of Africa. Except for its western sea coast on the Atlantic, it is completely surrounded by Senegal.



<b>Area:</b>	11 295 km <sup>2</sup>
<b>Population:</b>	1.8 million
<b>Capital:</b>	Banjul
<b>Currency:</b>	Dalasi
<b>GDP:</b>	\$ 3.4 billion (2010)
<b>Internet domain:</b>	.gm
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Groundnuts and related products; cotton lint; fish and fish products; palm kernels
<b>Imports:</b>	Foodstuffs; manufactures; raw materials; fuel machinery; transport equipment

## International/regional conventions

The Gambia is a member of the following international/regional agreements:

- Berne Convention (since 1993)
- Harare Protocol (of ARIPO) (since 1986)
- Lusaka Agreement (ARIPO) (since 1978)
- Paris Convention (since 1992)
- Patent Cooperation Treaty (since 1997)
- Patent Law Treaty (since 2000)
- WIPO Convention (since 1980)
- WTO/TRIPS (since 1996)

## IP legislation

Trade marks

- Industrial Property Act no 12 of 1989, PART V
- Industrial Property Regulations, 2010

Patents

- Industrial Property Act no 12 of 1989, PART II
- Industrial Property Regulations, 2010

Designs

- Industrial Property Act no 12 of 1989, PART IV
- Industrial Property Regulations, 2010

Copyright

- Copyright Act no 10 of 2004 (in force since 1 January 2011)

## TRADE MARKS

### Law

- Industrial Property Act no 12 of 1989, PART V
- Industrial Property Regulations, 2010

The Gambia is a member of the Paris Convention and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of marks for goods (trade marks) and for services (service marks), as well as for collective marks. The Act also provides for the protection of trade names.

### Protection of well-known marks

A mark cannot validly be registered if it is identical or confusingly similar to, or constitutes a translation of, a mark that is well known in The Gambia for identical goods or services of another enterprise.

### Advantages of trade mark registration

The use of a registered mark by any person other than the registered owner, requires the consent of the owner.

The registered owner of a mark further has the right to institute court proceedings against any person who infringes the mark by using the mark without the authority of the owner.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- collective marks.

### Definition of a trade mark

While the Act does not specifically refer to word and/or device marks, it allows registration of any visible sign capable of distinguishing the goods or services of an enterprise. This would appear to include marks comprised of both words and devices.

### Definition of a collective trade mark

A collective mark is defined to mean any visible sign capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises that use the sign under the control of the registered owner.

### Limitation to colour

No express provision, but permitted in practice.

### Classification

The International Classification of Goods and Services (Nice Classification) is followed. A single application may cover more than one class. However, in

practice, the Registrar will insist on a separate application being filed for each class.

### **Convention priority**

The Gambia is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right, to be accorded the same date as the first-filed application, provided the Gambian application is filed within six months of such earlier filing date.

### **Application**

An application is filed with the office of the Registrar General, headed by the Registrar of Trade Marks and Patents and operated under the supervision of the Ministry for Justice.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic print of the mark
- list of the goods or services
- clear representation of the dimensions of a three-dimensional mark
- translation or transliteration of words not in English, stating to which language each belongs
- certified copy of the priority document (if applicable).

### **Examination/procedure**

The Registrar examines the application as to formalities as well as on relative and substantive grounds. If the Registrar finds that the requirements have been met, he accepts the mark and publishes the mark.

### **Opposition**

Any person may, within three months of publication, or such further time as the Registrar may allow (not exceeding nine months in total), give notice of opposition to the Registrar. Ultimately, however, an opposition must be heard by the High court (see the section on **Opposition proceedings** below).

### **Opposition proceedings**

Opposition proceedings are set out in detail in the Act. In summary, a notice of opposition setting out the grounds of opposition is filed with the Registrar General, who sends a copy to the applicant. The applicant is afforded one month after receipt of the notice (which period may be extended by the Registrar up to three months) within which to file a counter-statement. If the applicant fails to submit a counter-statement, the application is deemed to have been abandoned and he may be liable to the opponent for costs.

If a counter-statement is filed by the applicant, the Registrar will send a copy to the opponent and require him to give security for costs. If the opponent fails to furnish security timeously, the opposition shall be deemed

to be withdrawn. If security is given, the opposition is ready for determination by the High Court. This entails the applicant making application to court, within one month, for an order that, notwithstanding the opposition, the mark should proceed to registration. If the applicant fails to make such application or take other steps, the application shall be deemed to be abandoned.

The court has the power to award any costs order it deems appropriate in these proceedings.

### **Grounds for opposition**

The grounds for opposition are set out in the Act and include:

- that the mark is incapable of distinguishing the goods or services of one enterprise from those of other enterprises
- that the mark is contrary to public order or morality
- that the mark is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics
- that the mark is identical to, or an imitation of, or contains armorial bearings, flags, emblems of any State, inter-governmental organisation, etc
- that the mark is identical to, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in The Gambia for identical or similar goods or services of another enterprise
- that the mark is identical to a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the filing date or the priority date of the application (whichever is the earlier), and is thereafter renewable for like periods of 10 years upon payment of the prescribed renewal fee. The renewal fee should be paid within the six months preceding expiry of the registration, but a grace period of six months is allowed for the late payment of the renewal fee, on payment of the prescribed surcharge.

### **Cancellation/removal of a trade mark**

The legislation does not specifically make provision for cancellation/removal of a trade mark, other than on the grounds of non-use (see the section on **Use requirement and cancellation** below). However, it is presumed that an interested person could make application to court for the removal of a mark on any of the grounds upon which an opposition could have been based.

### **Use requirement and cancellation**

Any aggrieved person may apply to the court for a registered mark to be taken off the register if the proprietor or his predecessor in title had no

*bona fide* intention to use the mark when applying for registration and has indeed not used such mark; or if there was no *bona fide* use of such mark during the five years immediately preceding the application. A mark will not be expunged if the non-use is shown to be due to special circumstances in the trade.

### **Assignment**

Assignments are possible, but shall be invalid where such assignment is likely to deceive or cause confusion in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark is used or proposed to be used. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- copy of the assignment agreement (notarised if it originates from outside The Gambia)
- publication by the Registrar (except in the case of a pending application).

### **Licensing/registered users**

Licensing of a trade mark is recognised. A licensing contract has to be submitted to the Registrar for the licence to be valid. The Registrar must keep the contents (which has to be reasonable and not place undue restrictions on the licensee) confidential, but shall publish a reference to the licence.

A licence contract must provide for effective quality control by the licensor, failing which the licence shall be invalid.

Requirements for recordal:

- power of attorney by the licensor and licensee (simply signed)
- copy of the licensing contract (notarised if it originates from outside The Gambia)
- publication of certain information by the Registrar.

### **Amendments**

Any translation or transcription error, clerical error or mistake in any application or document filed may be corrected by the Registrar. However, no addition to or expansion of the goods or services covered, or any alteration to the representation of a mark, may be occasioned by an amendment. An applicant may also withdraw his application at any time while it is pending.

### **Rights conferred by registration**

The registration of a trade mark requires any person, other than the registered owner, who wishes to use the mark, to obtain the consent of this owner.

Furthermore, the registered owner of a mark is afforded the right to institute court proceedings against any person who infringes the mark by using the mark without the agreement of the owner.

### **Trade mark infringement**

The infringement of a registered trade mark may give rise to either a civil action or a criminal action, or both. Civil proceedings must be brought in the High Court.

The grounds for infringement include the following acts:

- using the registered trade mark in relation to goods or services for which the trade mark has been registered without the registered proprietor's authorisation, or performing any act which makes it likely that such infringement will occur
- using a mark which is similar to the registered trade mark in relation to goods or services similar to those for which the mark has been registered, where confusion may arise in public.

### **Defences to trade mark infringement**

The rights conferred by registration of a trade mark shall not extend to acts in respect of articles which have been put on the market in The Gambia by the registered owner or with his consent. No other specific defences are provided for in the legislation.

### **Relief for trade mark infringement**

A court may grant the following relief in infringement cases:

- an injunction to prevent infringement
- damages
- any other remedy provided for by any other law in force.

In the case of a criminal action, the penalties are a fine or imprisonment, or both.

### **Common law rights**

No express provision.

### **Marking of goods**

Neither the Act nor the Regulations contain any provisions as to how goods may be marked to indicate that the mark has been registered.

## **PATENTS**

### **Law**

- Industrial Property Act no 12 of 1989, PART II
- Industrial Property Regulations, 2010

The Gambia is a member of the Paris Convention, the PCT, ARIPO (Harare Protocol) and the WTO/TRIPS.



**Patent protection**

Patent protection is available via a national filing or via an ARIPO application designating The Gambia. The Gambia has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application.

Although it is possible to file PCT national phase applications in The Gambia, the law has not been amended to provide for the PCT. Accordingly, it is not clear whether enforceable rights will be obtained via PCT national phase filings in The Gambia. However, it might be arguable that protection obtained via PCT national filing in The Gambia is valid, since the Act states that the provisions of any international treaties in respect of industrial property to which The Gambia is a party shall apply, and, in case of conflict with any provisions of the Act, shall prevail over the latter.

**Types of patents**

The Act provides for:

- a patent in respect of an invention that is new, inventive and industrially applicable
- a divisional patent, where the initial application covers more than one invention
- a utility model certificate in respect of an invention that is new and industrially applicable.

**Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

The following inventions are not patentable

- discoveries, scientific and mathematical theories
- plants or animal varieties or essentially biological processes for the production of plants or animals, other than microbiological processes and the products of such processes
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic method practised on the human or animal body (this exclusion does not apply to products for use in any of these methods).

**Types of applications**

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which The Gambia is designated
- an ARIPO application designating The Gambia

- a divisional application, where the original application covers more than one invention
- an application for a utility model, which may be converted to a patent application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via The Gambia Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of invention (if the applicant is not the inventor)
- specification (including claims, abstract and drawings), in English
- certified copy of the priority document (if priority is to be claimed)
- International Preliminary Report on Patentability (for PCT applications).

### **Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

### **Novelty**

An invention is considered new if it is not anticipated by prior art. Prior art consists of everything disclosed to the public anywhere in the world, by publication in tangible form, or in The Gambia by oral disclosure, by use or in any other way, prior to the filing or priority date.

Absolute novelty is thus required.

### **Certain prior knowledge or publication excused**

A grace period of six months immediately preceding The Gambia filing date or priority date (if convention priority is claimed) is provided, where disclosure of the invention was made by the inventor or by his predecessor in title, or if the disclosure was as a result of abuse committed by a third party.

### **Inventiveness**

An invention is considered to involve an inventive step if, having regard to the prior art, it would not have been obvious to a person with ordinary skill in the art.

### **Convention priority**

The Gambia is a member of the Paris Convention and the Act provides that an application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in any state party to a convention to which The Gambia is a party.

### **Examination/procedure**

A formal as well as a substantive examination is conducted. The substantive examination is conducted by the ARIPO office. The regulations may prescribe that some categories of inventions need not be subjected to examination.

### **Opposition**

No provision.

### **Publication**

The Act provides that where the Registrar grants a patent, the Registrar shall publish reference of the grant to the patent in the prescribed manner.

### **Duration and maintenance**

The term of a patent is 15 years from the filing date, which can be extended on application by five years, provided proof of working is furnished. An annual fee is payable as from the first anniversary of filing. A grace period of six months is allowed for the late payment of the annual fee subject to payment of surcharges.

If the annual fee is not paid within the grace period, the patent lapses.

### **Restoration**

No provision.

### **Revocation**

Any interested party may request the court to invalidate a patent, or a claim or part of a claim, on the basis of non-compliance with formal and substantive requirements. Invalidation of a patent can also be requested on the basis that the owner of the patent is not the inventor or the inventor's successor in title.

### **Assignments and licences**

Change in ownership (assignments) and licence contracts will have no effect against third parties until recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

On request of any person who proves his ability to work a patented invention in The Gambia, made to the Registrar General after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the Registrar may, with the approval of the Minister, grant a non-voluntary licence if the patented invention is not worked or is insufficiently worked in The Gambia.

A compulsory licence may also be granted by the Minister to a government agency or a third party where the public interest, particularly national security, health, nutrition, or the development of vital sectors of the economy so requires.

### **Amendments**

The applicant may, up to the time when the application is in order for grant, amend the application, provided the amendments shall not go beyond the disclosure in the initial application.

### **Effect of a patent**

The owner of a patent has the right to authorise the exploitation of the patented invention. Exploitation includes the following acts:

- making, importing, offering for sale, selling and using the patented product
- stocking such product for the purpose of selling or using
- where the patent is a process, using the process and doing any of the above acts in respect of a product of the process.

The patent owner also has the right to institute court proceedings against any person who infringes the patent or who performs acts making it likely that infringement will occur.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include interdict, fine, damages and imprisonment.

### **Marking**

No provision.

### **Working**

A granted patent must be worked within four years from the date of filing of the patent application, or three years from the date of the grant of the patent, whichever period expires last. Inadequate working can form the basis of a compulsory licence (see the section on **Compulsory licences** above).

### **Utility model certificates**

The Industrial Property Act provides that an invention will also qualify for registration as a utility model if it is new and industrially applicable. The requirements for registrability are very similar to those for patents, and the rights conferred by a utility model certificate are likewise similar to those conferred by a patent.

A utility model certificate expires, without any possibility of renewal, at the end of the seventh year after the filing date. An applicant for a patent may, before the grant/rejection of the application, convert the application into an application for a utility model, and *vice versa*.

## DESIGNS

### Law

- Industrial Property Act no 12 of 1989, PART IV
- Industrial Property Regulations, 2010

The Gambia is a member of the Paris Convention, ARIPO (Harare Protocol) and the WTO/TRIPS.

### Design protection

Design protection is available by way of a national filing or via an ARIPO application designating The Gambia. The Gambia has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, thereby giving valid design protection to applicants seeking to obtain a design registration via ARIPO.

### Registrable subject matter

An industrial design is defined as any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

Designs which serve solely to obtain a technical result are excluded from protection. Designs that are contrary to public order or morality are likewise excluded.

### Classification of designs

The Locarno International Classification of Designs is applied.

### Types of applications

Application for a design registration may be made by way of:

- a non-convention application
- a convention application claiming convention priority
- an ARIPO application designating The Gambia.

### Application

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via The Gambia Design Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment document (if applicable)
- representation of the design
- certified copy of the priority application (if applicable).

### **Applicant**

The creator of the design may apply, or his successor in title.

### **Convention priority**

The Gambia is a member of the Paris Convention and the Act provides that an application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in any state party to a convention to which The Gambia is a party.

### **Novelty**

Local novelty is required. The Act provides that a design will be new if it has not been disclosed to the public anywhere in The Gambia, by description, by use or in any other way prior to the filing or priority date.

However, a grace period of six months immediately preceding The Gambia filing date or priority date (if convention priority is claimed) is provided, where disclosure of the invention was made by the inventor or by his predecessor in title, or the disclosure was as a result of abuse committed by a third party.

### **Examination/procedure**

Applications are subjected to both formal and substantive examination.

### **Opposition**

No provision.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. A grace period of six months is allowed for the late payment of the renewal fee subject to payment of surcharges.

### **Restoration**

No provision.

### **Revocation**

Any interested person may request the court to invalidate a design registration. Grounds for invalidation include that the design does not meet the requirements for a registrable design, or lacks novelty.

### **Assignments and licences**

Changes in ownership (assignments) and licence contracts must be recorded at the Registrar's office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

No provision.

### **Effect of a design registration**

The owner of a design registration is afforded the right to authorise other persons to exploit the design. Exploitation of a design means the making, selling or importation of articles incorporating the design.

The registered owner also has the right to institute court proceedings against any person who infringes the design.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include interdict, fine, damages and imprisonment.

### **Marking**

Not required.

### **Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Copyright Act no 10 of 2004 (in force since 1 January 2011)

The Gambia is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works

- musical works
- artistic works
- audiovisual works
- sound recordings
- programme-carrying signals
- derivative works.

Literary works are further defined to include:

- novels, stories, poetic works, letters, reports, memoranda
- plays, stage directions, film scenarios, broadcasting scripts
- textbooks, treatises, essays, articles, encyclopaedias, dictionaries
- lectures, addresses and sermons
- charts, tables and compilations of data
- law reports, excluding court decisions
- computer programs.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, engravings, prints
- maps, plans, diagrams
- works of sculpture, works of architecture
- photographs, works of applied art and handicraft.

Derivative works include:

- translations, adaptations, transformations
- collections of works, collections of folklore.

### **Registration of copyright**

No requirement.

### **Requirements for subsistence of copyright**

For a work to qualify for protection, the work must be original and expressed in a definite medium of expression. The author must be a citizen of The Gambia, or ordinarily resident in The Gambia. Alternatively, the work must be made or first published in The Gambia.

Copyright protection is also extended to works of persons who are citizens of, or domiciled in, a country which is a party of a treaty to which The Gambia is also a party, and which provides for copyright protection; and to works first published by the United Nations, the African Union, or the Economic Community of West African States.

### **Exclusions of copyright**

Copyright protection does not extend to:

- ideas, procedures, systems, concepts, methods of operation



- official texts of a legislative, administrative or legal nature
- news of the day.

### **Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be named as the author, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights may not be transferred during the life of the author, but the author may waive the moral rights.

### **Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years. In the case of all other works, including photographs, the duration is 50 years from the date on which the work was made or was made available to the public.

### **Protection afforded by copyright**

Copyright confers on the owner the exclusive right to do or to authorise of the doing in The Gambia of any of the following acts:

- the reproduction of the work, including the translation or adaptation thereof
- the distribution to the public of the work, by way of sale, rental, lease, hire, loan
- the communication to the public of the work
- the importation of copies of the work
- the public display of the original or a copy of the work
- the public performance of the work
- the broadcasting of the work.

### **Exceptions to copyright protection**

The Act deals extensively with the permitted use of copyright works.

Permitted use includes:

- the making of a single copy for personal use (this exclusion does not apply to a work of architecture, to reprography of books or music, to the whole of a database or a computer program)
- the use of short parts of a work for quotation

- the reproduction of short parts of a work for teaching
- the reproduction by libraries or archives (in certain circumstances).

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

The economic rights inherent in copyright are transferable by way of assignment, and may be licensed.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted in the High Court by the owner; the relief may include damages, injunction, impounding of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences, and a perpetrator is liable to a fine or imprisonment or both.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in The Gambia.

# GHANA

## GENERAL INFORMATION

The Republic of Ghana is an independent republic in West Africa. Ghana is bordered by Burkina Faso to the north, Togo to the east and the Ivory Coast to the west. The Gulf of Guinea of the Atlantic Ocean lies to the south of Ghana.



<b>Area:</b>	238 533 km <sup>2</sup>
<b>Population:</b>	24.3 million
<b>Capital:</b>	Accra
<b>Currency:</b>	Cedi
<b>GDP:</b>	\$ 38.24 billion (2010)
<b>Internet domain:</b>	.gh
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cocoa; gold; timber; manganese; bauxite; aluminium; diamonds; tuna
<b>Imports:</b>	Capital equipment; petroleum; consumer goods; food; intermediate goods

## International/regional conventions

Ghana is a member of the following international/regional agreements:

- Berne Convention (since 1991)
- Hague Agreement on Designs (since 2008)
- Harare Protocol (of ARIPO) (since 1984)
- Lusaka Agreement (ARIPO) (since 1978)
- Madrid Protocol on Marks (since 2008)
- Paris Convention (since 1976)
- Patent Cooperation Treaty (since 1997)
- WIPO Convention (since 1976)
- WIPO Copyright Treaty (since 2006)
- WTO/TRIPS (since 1995)

## IP legislation

### Trade marks

- Trade Marks Act no 270 of 1965 (repealed by Act no 664 of 2004)
- Trade Marks Act no 664 of 2004
- Trade Mark Regulations, 1970 (as amended)
- Geographical Indications Act no 659 of 2003

### Patents

- Patent Law no 305 of 1992 (repealed by Act no 657 of 2003)
- Patents Act no 657 of 2003
- Patent Regulations, 1996 (as amended)

### Designs

- Industrial Designs Act no 660 of 2003
- Layout Designs (Topographies) of Integrated Circuits Act no 667 of 2004

### Copyright

- Copyright Act no 690 of 2005, amended by Copyright (Amendment) Act no 788 of 2009
- Copyright Regulations, 2010

## TRADE MARKS

### Law

- Trade Marks Act no 270 of 1965 (repealed by Act no 664 of 2004)
- Trade Marks Act no 664 of 2004
- Trade Mark Regulations, 1970 (as amended)
- Geographical Indications Act no 659 of 2003

**Note:** Notwithstanding the repeal by the 2004 Act of its predecessor, the 1965 Act, the 2004 Act states that any regulations made under the 1965 Act and in force when the 2004 Act comes into force, shall continue to apply under the corresponding provisions of the 2004 Act until revoked. The 'old' regulations have not yet been revoked and thus remain in force.

Ghana is a member of the Paris Convention and the Madrid Protocol, but there are as yet no implementing provisions. Ghana is also a member of the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services and for collective marks.

### Protection of well-known marks

A trade mark will not be registered if it is identical or confusingly similar to, or constitutes a translation of, a trade mark or trade name that is well known in Ghana for identical or similar goods or services; or a trade mark that is well known and registered in Ghana for goods and services not identical or similar to those in the application but where the use of the trade mark in the application will indicate a connection with the owner of the well-known mark, so that the interests of such owner will be prejudiced.

### Advantages of trade mark registration

The owner of a registered trade mark has the right to prevent all others from using the mark, in relation to the specified goods or services, without his consent. The owner also has the right to institute court proceedings against other persons who use the registered mark without his consent.

### Types of trade marks

The Act provides for the registration of the following marks:

- trade marks for goods
- trade marks for services
- collective trade marks.

**Definition of a trade mark**

A trade mark is defined as any sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods or services of other undertakings, including words such as personal names, letters, numerals and figurative elements.

**Definition of a collective trade mark**

A collective mark is defined as a visible sign capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of a registered owner.

**Limitation to colour**

No express reference is made to the use of colours in a trade mark, but the use of colours is permitted in practice.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A separate application is required for each class.

**Convention priority**

A trade mark application in Ghana may contain a declaration claiming priority of an earlier national or regional application filed by the applicant or its predecessor in title in a member country of the Paris Convention or the World Trade Organisation. A certified copy of the first-filed application must be submitted within three months of filing of the application in Ghana.

**Application**

Trade mark applications are filed with the Registrar of Trade Marks. The Trade Marks Registry is located at the Registrar General's office, which is a department within the Ministry of Justice.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- list of goods or services to be covered
- electronic print of the trade mark
- priority document (certified copy), if priority is claimed.

Applicants not domiciled within Ghana must be represented by an attorney.

**Examination/procedure**

Applications are examined as to formal requirements as well as substantive requirements. If an application is accepted, the acceptance must be advertised.

## **Opposition**

Opposition to the registration of a trade mark is possible within two months of advertisement of the acceptance of the application. The legislation empowers the Registrar to grant extensions of time.

### **Opposition proceedings**

The opponent files a notice of opposition with the Registrar, who sends a copy to the trade mark applicant. The trade mark applicant has two months to file a counter-statement. If the trade mark applicant fails to respond, he shall be deemed to have abandoned the trade mark application.

Within a month of receipt of the trade mark applicant's counter-statement, the opponent may file a statutory declaration containing supporting evidence. The trade mark applicant may then file a statutory declaration, within a month of receipt of the opponent's statutory declaration, with evidence in support of its defence against the opposition.

When the pleadings have closed, the Registrar gives notice to the parties of a date on which he will hear arguments from both parties. Thereafter a decision is made by the Registrar.

### **Grounds of opposition**

Opposition may be based on any ground on which the registration of a mark could have refused. A mark shall not be registrable if:

- it does not fulfil the definition of a trade mark (see the section on **Definition of a trade mark** above)
- it is a trade name
- it is incapable of distinguishing the goods or services of one enterprise from the goods or services of another enterprise
- it is contrary to public order or morality
- it is likely to mislead the public or trade circles as to the geographical origin of the goods or services, their nature or characteristics
- it is identical to or is an imitation of, or contains as an element, an armorial bearing, flag, emblem, name, official sign or hallmark adopted by a state or international organisation, unless authorised by the competent authority of that state or organisation
- it is identical or confusingly similar to, or constitutes a translation of, a trade mark or a trade name which is well known, but not registered, in the country for identical or similar goods or services of another enterprise; or the trade mark is well known and registered in the country for goods or services which are not identical or similar to those under application, but the use of the mark will indicate a connection with the owner of the well-known trade mark and the interests of the owner are likely to be damaged
- the trade mark is identical to a trade mark of another owner already on the register, or identical to a trade mark which is the subject of an application with an earlier filing or priority date for the same or similar goods or services, or if it resembles that trade mark so closely that it is likely to deceive or cause confusion.

**Duration and renewal**

A trade mark registration is valid for an initial period of 10 years from the date of filing and is renewable for like periods of 10 years each, upon payment of the applicable renewal fees. Trade marks registered under the previous Act shall be renewable for 14 years from the date of expiration of the original registration or of the last renewal, and upon renewal shall be reclassified in accordance with the International Classification of goods and services.

**Cancellation/removal of a trade mark**

The High Court can invalidate the registration of a trade mark in the event that any of the requirements of the legislation have not been complied with. In the case of non-use, the Registrar may remove a registration from the Register (see the section on **Grounds for cancellation/removal** below).

**Grounds for cancellation/removal of a trade mark**

The High Court can invalidate the registration of a trade mark if the person applying for the invalidation proves that the requirements of the Act have not been complied with (see the section on **Grounds of opposition** above).

The Court may also invalidate the registration of a trade mark if, due to any act or inactivity of the owner, the mark has become the common name in the trade for the goods or services for which the mark is registered.

The trade mark may also be removed on the ground of non-use (see the section on **Use requirement and removal** below).

**Use requirement and removal**

An interested person may apply to the Registrar for an order removing a trade mark from the register on the basis that the registered trade mark has not been used by its owner or a licensed user, up to one month before the application for removal, for a continuous period of five years, in relation to the goods or services for which the mark was registered.

The trade mark shall not be removed from the register if it is shown that special circumstances existed that have prevented the use of the mark and that there was no intention on the part of the trade mark proprietor to abandon the trade mark.

**Assignment**

Assignments are possible and must be filed in writing with the Registrar of Trade Marks, who must then record and publish the change in ownership. The change of ownership is not valid and enforceable against third parties until it has been filed with the Registrar.

An assignment/change of ownership will not be valid if it is likely to deceive or cause confusion with respect to the nature, origin, manufacturing process, characteristics or suitability for the purpose of the goods or services to which the trade mark or collective mark is applied.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- deed of assignment, signed by both parties (or certified copy).

### **Licensing/registered users**

Licensing of a trade mark is recognised, but a licence contract will not be valid against third parties until it has been filed with the Registrar.

Requirements for recordal:

- power of attorney by the licensor (simply signed)
- licence agreement signed by both parties (or certified copy).

### **Amendments**

The owner of a registered mark or a person authorised by him may apply to the Registrar –

- to correct an error or enter a change in the name, address or description of the registered owner of the trade mark
- to cancel the entry of a trade mark in the register
- to delete any goods or classes of goods from those for which a mark is registered
- to enter a disclaimer or memorandum relating to a trade mark which does not extend the rights given by the existing registration of the mark.

### **Rights conferred by registration**

The registration of a trade mark confers on the owner the exclusive right to authorise the use of the trade mark. The registered owner has the right to institute court action against any person who infringes the trade mark registration.

### **Trade mark infringement**

A person other than the registered owner of a trade mark who uses the mark in relation to any goods or services for which the mark was registered, without the agreement of the owner, commits an infringement.

The registered owner of a trade mark may institute court action against any person who infringes a registered trade mark by –

- using a registered trade mark without permission
- performing acts which make it likely that infringement may occur.

The rights of the registered owner extend to the use of a sign that is similar to the registered trade mark and that is used in relation to goods or services that are similar to those covered by the registered trade mark, where confusion is likely to arise. Where a mark that is identical to a registered trade mark is used in relation to the identical goods or services, a likelihood of confusion is presumed.

An owner of a well-known trade mark, even though not registered, may take action against any person who uses a mark that constitutes a translation or imitation of the well-known mark for identical or similar goods or services. Furthermore, the owner of a well-known trade mark that



is registered may take steps to stop the use of such a mark in relation to goods or services that are not similar or identical to those that are covered by the well-known trade mark, where such use will indicate a connection with the owner of the well-known trade mark and where this use is likely to cause damage to the owner.

### **Defences to trade mark infringement**

The rights conferred by registration of a mark do not extend to acts in respect of articles which have been put on the market in any country by the registered owner or with the consent of the owner. No other specific defences are provided in relation to civil trade mark infringement.

Certain defences in relation to the criminal offences are listed (for example, that the defendant committed the act of infringement without the intent to defraud, or took reasonable steps to prevent the commission of the offence).

### **Relief for trade mark infringement**

Both civil and criminal proceedings are available. It is a criminal offence, punishable by a fine or imprisonment, to knowingly infringe the right of a registered owner of a trade mark by using the mark for goods or services without the consent of the registered owner, or to forge or falsify a trade mark. Various additional offences in relation to counterfeit goods are listed. Forfeiture of the infringing goods can be ordered.

### **Common law rights**

No specific provision.

### **Marking of goods**

There is no provision for the compulsory marking of goods.

## **PATENTS**

### **Law**

- Patent Law no 305 of 1992 (repealed by Act no 657 of 2003)
- Patents Act no 657 of 2003
- Patent Regulations, 1996 (as amended)

Ghana is a member of the Paris Convention, the PCT, ARIPO (Harare Protocol) and the WTO/TRIPS.

### **Patent protection**

Patent protection is available by way of a national filing, or via an ARIPO or a PCT application designating Ghana. Ghana has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application. Ghana has also enacted provisions to implement the PCT, thereby providing valid patent protection to applicants of international applications designating Ghana.

### **Types of patents**

The Act provides for conventional patents, ie where a patent is granted for an invention that is new, involves an inventive step, and is industrially applicable.

The Act also recognises divisional patents, where an initial application covered more than one invention, a divisional application being entitled to the filing date of the initial application.

The Act further provides for utility model certificates in respect of an invention that is new and industrially applicable (see the section on **Utility model certificates**) below).

### **Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

The following inventions are not patentable:

- discoveries, scientific and mathematical theories
- plants and animals other than micro-organisms
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body; this exclusion shall not apply to products for use in any of these methods
- inventions, the prevention of the commercial exploitation of which is necessary to protect public order or morality, which includes the protection of human, animal or plant life or health, or the avoidance of serious prejudice to the environment
- biological processes for the protection of plants or animals other than non-biological and micro-biological processes
- plant varieties.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application, based on an international application under the PCT in which Ghana is designated
- an ARIPO application designating Ghana
- a divisional application, where the original application covers more than one invention
- an application for a utility model, which may be converted to a patent application.

## **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Ghana Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of invention (if the applicant is not the inventor; simply signed)
- specification (including claims, abstract and drawings), in English
- certified copy of the priority document (if priority is to be claimed).

## **Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

## **Novelty**

An invention is considered new if it is not anticipated by prior art. Prior art consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or priority date. Thus, absolute novelty is required.

## **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Ghana filing date or priority date is provided, during which disclosure of the invention will not be taken into account if the disclosure was made by the inventor or by his predecessor in title, or if the disclosure was as a result of abuse committed by a third party.

## **Inventiveness**

An invention is considered to involve an inventive step if, having regard to the relevant prior art, it would not have been obvious to a person having ordinary skill in the art. An invention is considered industrially applicable if it can be made or used in any kind of industry.

## **Convention priority**

Ghana is a member of the Paris Convention. The Act provides that an application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by an applicant in any state party to the Paris Convention, or in any member of the World Trade Organisation.

## **Examination/procedure**

A formal as well as substantive examination is conducted. The substantive examination follows once all formal requirements have been complied with.

For the purposes of conducting substantive examination, the Registrar will take into account the results of any international search report and any international preliminary examination report in relation to the application; a search and examination report relating to a corresponding foreign application; a final decision on refusal to grant a patent on a corresponding foreign application; or a search and an examination report which was carried out upon the request of the Registrar by an external search and examination authority.

**Opposition**

No provision.

**Publication**

The Act provides that where the Registrar grants a patent, the Registrar shall publish reference of the grant of the patent in the prescribed manner.

**Duration and maintenance**

Granted patents are valid for 20 years calculated from the filing date. Maintenance fees are payable in respect of pending patent applications and granted patents. An annual fee is payable as from the first anniversary of filing. A grace period of six months is allowed for the late payment of the annual fee, subject to payment of surcharges. If an annual fee is not paid as provided, the patent lapses.

**Restoration**

No provision.

**Revocation**

Any interested party may request the court to invalidate a patent, or a claim or part of a claim, on the basis of non-compliance with formal and substantive requirements. Invalidation of a patent can also be requested on the basis that the owner of the patent is not the inventor or the inventor's successor in title.

**Assignments and voluntary licences**

Assignment of a patent or patent application and the grant of voluntary licences are recognised. Changes in ownership and licence contracts will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the assignee or licensor (simply signed)
- original or certified copy of the assignment document (simply signed); or
- original or certified copy of the licence agreement (simply signed).

**Compulsory licences**

Compulsory licences may be granted in different circumstances.

On request made to the court after the expiration of a period of four years from the date of filing of the patent application, or three years from the date of the grant of the patent, whichever period expires last, the court may issue a non-voluntary licence if the court is satisfied that the patented invention is not exploited or is insufficiently exploited, by working the invention locally or by importation in the country.

Where the public interest, in particular national security, nutrition or health, or the development of vital sectors of the national economy so requires; or where a judicial or administrative body has determined that the manner of exploitation by the patent owner is anti-competitive, the Minister may grant a compulsory licence.

Where a patented invention cannot be exploited without infringing an earlier patent and the later invention involves an important technical advance, a compulsory licence under the earlier patent may be granted by the court.

### **Amendments**

The applicant may, up to the time when the application is in order for grant, amend the application, provided the amendments shall not go beyond the disclosure in the initial application.

### **Effect of a patent**

A patent grants the right to the patent owner to exploit the patented invention and to authorise others to exploit the invention.

Exploitation means:

- where the patent has been granted in respect of a product, the making, importing, offering for sale, selling and using the product, and stocking the product for any of these purposes
- where the patent has been granted for a process, using the process and doing any of the abovementioned acts in respect of a patent of such process.

A patent also affords the owner the right to institute court proceedings against any person who infringes the patent.

The owner's rights do not extend to:

- articles put on the market in any country by the owner or with his consent
- acts done for experimental purposes
- acts performed by a person in good faith prior to the filing of the application.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include injunction, damages, fine, imprisonment and any other relief provided for in the general law.

### **Marking**

No express provision.

### **Working**

A granted patent must be worked within four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last. Non-working can form the ground for a compulsory licence (see the section on **Compulsory licences** above).

### **Utility model certificates**

The Act provides for the registration of utility model certificates in respect of inventions that are new and industrially applicable, although not necessarily inventive. A utility model certificate expires, without a possibility of renewal, at the end of the seventh year after the date of filing.

A utility model certificate may be invalidated on certain prescribed grounds, *inter alia* that the owner is not the inventor or his successor in title.

At any time before the grant or refusal of a utility model certificate, the application may be converted to a patent application. A patent application may likewise be converted to an application for a utility model certificate.

## **DESIGNS**

### **Law**

- Industrial Designs Act no 660 of 2003
- Layout Designs (Topographies) of Integrated Circuits Act no 667 of 2004

Ghana is a member of the Paris Convention, the Hague Agreement, the ARIPO (Harare Protocol) and the WTO/TRIPS.

Although Ghana has an Industrial Designs Act no 660 of 2003, the implementing regulations have not yet been passed. Accordingly, currently the Registry only accepts and processes applications relating to textile designs. All other designs are not registrable in Ghana by way of national filings pending the implementation of the regulations. Non-textile design applications filed with the Registrar's office are only accepted for onward transmission to ARIPO for processing and registration by the ARIPO office.

Since Ghana has acceded to the Harare Protocol of ARIPO, design protection can be obtained in Ghana via an ARIPO application designating Ghana.

Ghana has also acceded to the Hague Agreement for the international registration of designs. The 2003 Act does not provide for the implementation of the Hague registration system, so that the position in regard to such registrations is not clear.

**Design protection**

Design protection is obtained by way of:

- design registration through ARIPO designating Ghana
- national registration in Ghana (for textile designs only).

As indicated above, registration under the Hague Agreement is uncertain.

**Registrable subject matter**

A design is defined as a composition of lines or colours, any three-dimensional form or any material, whether or not associated with lines or colours.

A textile design is an industrial design where the composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

A design registration does not protect anything which serves only to obtain a technical result to the extent that it leaves no freedom as regards arbitrary features of appearance. A design contrary to public order or public morality is not registrable.

**Classification of designs**

The Locarno International Classification of Designs is applied.

**Types of applications**

Application for a design may be made by way of:

- a non-convention application (in respect of textile designs only)
- a convention application claiming convention priority (in respect of textile designs only)
- an ARIPO application, designating Ghana.

As indicated above, registration under the Hague Agreement is uncertain.

**Application**

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- deed of assignment (if the applicant is not the creator)
- representations of the design
- certified copy of the priority document (if applicable).

**Applicant**

The creator of the design may apply, or his successor in title.

**Convention priority**

Ghana is a member of the Paris Convention. Accordingly, priority can be claimed provided the application is filed within six months from the priority date of an application in a convention member country or in a member country of the World Trade Organisation.

### **Novelty**

In order to be registrable, a design must be new. A design is regarded as new if it significantly differs from known designs or combinations of known design features. A grace period of 12 months preceding the filing date or (where applicable) the priority date of the application is provided, if the disclosure of the design was as a result of acts committed by the applicant or the applicant's predecessor in title, or as a result of an abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Examination/procedure**

Applications are examined as to form and conformity with the novelty provision and definition of a design as contained in the Act.

### **Opposition**

Opposition to the registration of the design can be filed with the Registrar's office on the basis that the design is not new or does not comply with the definition of a design as contained in the Act.

### **Duration and maintenance**

The initial term of the design registration is five years, which period is extendible upon payment of renewal fees for two further five year terms. A grace period of six months is provided for late payment of renewal fees, subject to surcharges.

### **Restoration**

No provision for restoration.

### **Revocation**

Any interested person may apply to the court to cancel the registration of a design, on any grounds on which the application could have been opposed (see the section on **Opposition** above).

### **Assignments and licences**

Assignments and voluntary licences are provided for. Changes in ownership and licence contracts must be recorded at the Registrar's office in order to have legal effect against third parties.

Requirements for recordal:

- power of attorney by the assignee or the licensor (simply signed)
- original or certified copy of the assignment document (simply signed); or
- original or certified copy of the licence agreement (simply signed).

### **Compulsory licences**

No provision.

### **Effect of a design registration**

A design registration confers on the registered owner the right to exploit the design and to authorise others to exploit the design. Exploitation means the making, selling, importing or otherwise distributing for commercial purposes, articles embodying the design or a substantially identical copy thereof.



**Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include injunction, damages, fine, imprisonment and any other relief as the court considers appropriate.

**Marking**

Not required.

**Working**

No provisions.

**COPYRIGHT****Law**

- Copyright Act no 690 of 2005, amended by Copyright (Amendment) Act no 788 of 2009
- Copyright Regulations, 2010

Ghana is a member of the Berne Convention, the WIPO Copyright Treaty and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The following works are eligible for copyright protection:

- literary works
- artistic works
- musical works
- sound recordings
- audio-visual works
- choreographic works
- derivative works
- computer programs
- expressions of folklore.

Copyright does not extend to ideas, concepts, procedures, methods or other things of a similar nature.

**Requirements for subsistence of copyright**

To qualify for copyright protection, a work must be original and must have been fixed in any medium of expression. Furthermore, the work must have been created by a citizen or resident of Ghana or first published in Ghana (or within 30 days of its first publication outside of Ghana). A work in respect of which Ghana has an obligation under an international treaty to protect, will also be granted protection.

### **Copyright extended to Berne Convention countries**

The Act provides that works in respect of which Ghana has an obligation to protect under an international treaty, shall be afforded copyright protection.

### **Exclusions from copyright**

Certain works are excluded from copyright protection:

- enactments
- decisions by a court or tribunal
- reports by a government commission
- news of current events.

### **Authorship and ownership of copyright**

The author is the first owner of the copyright, namely the exclusive economic rights in respect of the work, and the sole moral rights.

The economic rights enable the copyright owner to exploit the copyright work for commercial gain; the moral rights enable the author to be recognised as the author of the work (see the section on **Protection afforded by copyright** below).

### **Duration of copyright**

Copyright endures for the lifetime of the author plus 70 years after his death. In the case of audio-visual works or sound recordings, the period of protection is 70 years. The moral rights endure in perpetuity.

### **Exceptions to copyright protection**

Certain exceptions to copyright protection are provided for, including the making of a reproduction, translation, etc for the exclusive personal use of a person; the use for quotations, provided the source and the author are acknowledged; the use for teaching purposes, etc.

### **Assignment of copyright**

The economic rights may be assigned; the moral rights continue to vest in the author.

### **Licensing of copyright**

The economic rights may be licensed; a licence may be oral, written or inferred from conduct.

### **Protection afforded by copyright**

As indicated above, copyright confers economic and moral rights.

The economic rights include the right to do or authorise:

- the reproduction of the work
- the translation, adaptation or arrangement or transformation of the work
- the public performance, broadcasting, or communication of the work to the public
- the distribution of copies of the work
- the commercial rental to the public of copies of the work.

The moral rights include:

- the right to claim authorship and to be recognised as author
- the right to object to and prevent any distortion, mutilation or modification of the work which would be prejudicial to the author's reputation.

### **Copyright infringement**

The unauthorised doing of any act reserved for the copyright owner constitutes an infringement, and the copyright owner may institute a civil or criminal action.

### **Criminal offences**

The Act also provides that the doing of any act reserved for the copyright owner and certain related acts, where the person knew or had reasonable grounds to know that such action constitutes or facilitates infringement, without the authorisation of the right holder, constitutes an offence which is punishable by a fine and/or imprisonment.

### **Registration of copyright**

A Copyright Administrator is established by the Act; the Administrator shall open and maintain registers for the registration of associations of authors, works and productions. However, it is expressly stated that the existence of copyright protection shall not be dependent on the registration of the work.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Ghana.

# GUINEA

## GENERAL INFORMATION

The Republic of Guinea lies on the west coast of Africa, surrounded on the land side by Guinea-Bissau and Senegal on the north-west, Mali on the north-east, Ivory Coast on the south-east, and Liberia and Sierra Leone on the south.



<b>Area:</b>	245 857 km <sup>2</sup>
<b>Population:</b>	10.3 million
<b>Capital:</b>	Conakry
<b>Currency:</b>	Guinea Franc
<b>GDP:</b>	\$10.6 billion (2010)
<b>Internet domain:</b>	.gn
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Bauxite; alumina; diamonds; gold; coffee; fish; agricultural products
<b>Imports:</b>	Petroleum products; metals; machinery; transport equipment; textiles; grain and other foodstuffs

## International/regional conventions

Guinea is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1990)
- Berne Convention (since 1980)
- Locarno Agreement on Classification of Designs (since 1996)
- Nice Agreement on Classification of Marks (since 1996)
- Paris Convention (since 1982)
- Patent Cooperation Treaty (since 1991)
- Strasbourg Agreement on Patent Classification (since 1997)
- Vienna Agreement on Figurative Elements of Marks (since 1996)
- WIPO Convention (since 1980)
- WIPO Copyright Treaty (since 2002)
- WIPO Performances and Phonograms Treaty (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

Guinea is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states

- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Guinea had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

### **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

### **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

### **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# GUINEA-BISSAU

## GENERAL INFORMATION

The Republic of Guinea-Bissau was the first of the former Portuguese African territories to become independent in 1974. This West African state is bordered to the north by Senegal, to the east and south by Guinea, and to the west by the Atlantic Ocean.



<b>Area:</b>	36 125 km <sup>2</sup>
<b>Population:</b>	1.6 million
<b>Capital:</b>	Bissau
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$1.8 billion (2010)
<b>Internet domain:</b>	.gw
<b>Languages:</b>	Portuguese (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cashew nuts; peanuts; palm kernels; fish; swan lumber
<b>Imports:</b>	Foodstuffs; transport equipment; petroleum products; machinery and equipment

## International/regional conventions

Guinea-Bissau is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1998)
- Berne Convention (since 1991)
- Paris Convention (since 1988)
- Patent Cooperation Treaty (since 1997)
- WIPO Convention (since 1988)
- WTO/TRIPS (since 1995)

## IP legislation

Guinea-Bissau is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

## **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# IVORY COAST (CÔTE D'IVOIRE)

## GENERAL INFORMATION

The Republic of the Ivory Coast (Côte d'Ivoire) is situated in West Africa. It is bordered in the south by the Gulf of Guinea (Atlantic Ocean), to the north by Mali and Burkina Faso, to the east by Ghana, and to the west by Guinea and Liberia. The government officially prefers the French name Côte d'Ivoire.



<b>Area:</b>	322 463 km <sup>2</sup>
<b>Population:</b>	21 million
<b>Capital:</b>	Abidjan (commercial) and Yamoussoukro (political)
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 37.8 billion (2010)
<b>Internet domain:</b>	.ci
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cocoa; coffee; timber; petroleum; cotton; tropical fruit; palm oil; fish
<b>Imports:</b>	Food; capital goods; consumer goods; fuel; transport equipment

## International/regional conventions

Ivory Coast is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1962)
- Hague Agreement on Designs (since 1993)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1991)
- WIPO Convention (since 1974)
- WTO/TRIPS (since 1995)

## IP legislation

Ivory Coast is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.



OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Ivory Coast had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, please refer to the chapter on **OAPI**.

In Ivory Coast, a further copyright law was enacted:

- Law no 96-564 of 1996 on the Protection of Intellectual Works and the Rights of Authors, Performers, and Phonogram and Videogram Producers.

## **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# KENYA

## GENERAL INFORMATION

The Republic of Kenya lies on the Equator in East Africa. It is bordered by the Indian Ocean and Somalia to the east, Ethiopia and South Sudan to the north, Uganda to the west and Tanzania to the south.



<b>Area:</b>	580 367 km <sup>2</sup>
<b>Population:</b>	40 million
<b>Capital:</b>	Nairobi
<b>Currency:</b>	Kenyan Shilling
<b>GDP:</b>	\$ 65.9 billion (2010)
<b>Internet domain:</b>	.ke
<b>Languages:</b>	Swahili, English (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; tea; horticultural products; hides and skins
<b>Imports:</b>	Machinery and transportation equipment; consumer goods; petroleum products; iron and steel

## International/regional conventions

Kenya is a member of the following international/regional agreements:

- Berne Convention (since 1993)
- Brussels Convention on Programme-carrying Signals (since 1979)
- Harare Protocol (of ARIPO) (since 1984)
- Lusaka Agreement (ARIPO) (since 1978)
- Madrid Agreement on Marks (since 1998)
- Madrid Protocol on Marks (since 1998)
- Nairobi Treaty on Olympic Symbol (since 1982)
- Paris Convention (since 1965)
- Patent Cooperation Treaty (since 1994)
- Phonograms Convention (since 1976)
- UPOV Convention for New Varieties of Plants (since 1999)
- WIPO Convention (since 1971)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Trade Marks Act of 1957, Chapter 506, last amended by the Trade Marks (Amendment) Act, 2002
- Trade Marks Rules, 1982

Patents

- Industrial Property Act no 3 of 2001
- Industrial Property Regulations, 2002

Designs

- Industrial Property Act no 3 of 2001
- Industrial Property Regulations, 2002

### Copyright

- Copyright Act no 12 of 2001
- Copyright Regulations, 2004
- Copyright (Amendment) Regulations, 2011

### Related areas

- Seeds and Plant Varieties Act of 1972 (amended in 2002)
- Seeds and Plant Varieties (Plant Breeder's Rights) Regulations, 1994

## TRADE MARKS

### Law

- Trade Marks Act of 1957, Chapter 506, last amended by the Trade Marks (Amendment) Act, 2002
- Trade Marks Rules, 1982

Kenya is a member of the Paris Convention, the Madrid Agreement and Protocol, and the WTO/TRIPS.

### Trade mark protection

Applications for the registration of trade marks may be filed as national applications, in appropriate circumstances, claiming priority in terms of the Paris Convention; or Kenya may be designated in international applications in terms of the Madrid Agreement/Protocol.

Provision is made for the registration of trade marks for goods and services, for collective marks, certification marks, defensive registrations of well-known marks, and for series marks.

The Act provides for registration of a mark in Part A of the register, where the mark must already have acquired distinctiveness; and for registration in Part B of the register, where the mark must only be capable of becoming distinctive.

### Protection of well-known marks

The Act provides that the owner of a well-known trade mark will be entitled to restrain by injunction, the use in Kenya by another person of a trade mark which is identical or similar to the well-known mark in relation to identical or similar goods, where such use is likely to cause confusion. A trade mark may also not be registered if it is likely to impair, interfere with or take unfair advantage of the well-known trade mark.

### Advantages of trade mark registration

The advantage of the registration of a trade mark is that the registered owner gets the exclusive right to use, and to authorise others to use, the registered mark. The owner is also entitled to institute proceedings and recover damages for infringement in terms of the Act.

### **Types of trade marks**

The Act provides for the registration of the following marks:

- trade mark for goods
- trade mark for services
- collective trade marks
- certification trade marks
- defensive registrations
- parts of marks
- series of marks.

### **Definition of a mark**

A mark is defined to include a distinguishing guise, slogan, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof whether rendered in two-dimensional or three-dimensional form.

### **Definition of a trade mark**

A trade mark is defined as a mark proposed to be used –

- in relation to goods to indicate a connection in the course of trade between the goods and a person entitled to use the mark so as to distinguish such goods from the same goods of other persons
- in relation to services to indicate a connection in the course of business with a person providing those services, so as to distinguish those services from the same kind of services provided by other persons.

### **Definition of a certification trade mark**

A certification mark is a mark to be used in relation to goods to distinguish, in the course of trade, goods certified by a person in respect of origin, material, mode of manufacture, quality, etc from goods not so certified. Such a mark is registrable in Part A of the register.

### **Definition of a collective trade mark**

A collective mark is a mark capable of distinguishing, in the course of trade, the goods or services of persons who are members of an association from goods and services of persons who are not members.

### **Limitation to colour**

No express provision is made for the use of colours, but use is permitted in practice.

### **Defensive registrations**

Where a trade mark consisting of an invented word or words has become so well known in respect of goods for which it is registered, that the use thereof in relation to other goods would be likely to be taken as indicating a connection with the owner of the well-known mark, then, notwithstanding that such owner does not propose to use the mark in regard to such other goods, the owner may apply for the trade mark to be registered in respect of such other goods as a defensive trade mark.

**Parts of marks**

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part of the mark, he may register the whole mark and any such part as separate trade marks.

**Series of marks**

Where a person claims to be the proprietor of several trade marks to be used in respect of the same goods or services, which, while resembling each other in material particulars, differ in regard to statements of the goods or services, statements of number, price or quality, colour, or other aspects of a non-distinctive character, these marks may be registered as a series of marks in one registration.

**Classification**

The International Classification of Goods and Services (Nice Classification) is followed. Provision is made for multiple class filings.

**Convention priority**

Kenya is a member of the Paris Convention; thus applicants who have applied to register a mark in another convention country have the right to claim a priority right, to be accorded the same date as the first filed application, provided the Kenyan application is filed within six months of the earlier filing date.

**Application**

Applications are filed with the Kenya Intellectual Property Institute (KIPI).

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- list of goods and/or services to be covered
- prints of the mark
- priority document (if applicable; certified copy).

**Examination/procedure**

Applications are examined as to formal requirements as well as on relative and substantive grounds. If accepted, the mark must be published.

**Opposition**

Interested third parties may oppose the application within 60 days from date of publication. The extension of the opposition period is possible at the discretion of the Registrar for a maximum of 90 days.

**Opposition proceedings**

Opposition proceedings are prescribed by the Act and Regulations.

A notice of opposition, including a statement of the grounds on which the opposition is based, is filed with the Registrar, who sends it to the applicant.

The applicant has 42 days to file a counter-statement, stating the grounds on which he relies in support of his application.

Within 42 days after receipt of the counter-statement, the opponent must file his evidence by way of a statutory declaration. Within 42 days after receipt of the opponent's statutory declaration, the applicant must file his statutory declaration. Within 30 days after receipt of the applicant's statutory declaration, the opponent may file evidence in reply.

The matter is thereafter set down for hearing before the Registrar.

### **Grounds of opposition**

Both absolute and relative grounds of opposition may be used. In particular the trade marks which are not registrable include:

- a mark the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice
- a mark which would be contrary to law or morality, or which includes any scandalous design
- a mark which is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or services, or description of goods or services
- a mark which, or an essential part of which, is likely to impair, interfere with or take unfair advantage of the distinctive character of a well-known trade mark.

### **Duration and renewal**

A trade mark registration is valid for an initial period of 10 years from the date of filing, and is renewable for like periods of 10 years, upon payment of the applicable renewal fees.

### **Cancellation/removal of a trade mark**

Any interested person may apply to the Registrar or the court for an order expunging or varying any entry on the register.

### **Grounds for cancellation/removal of a trade mark**

A trade mark registration may be removed from the Register on the following grounds:

- in the case of entries wrongly made in or remaining on the Register, being contrary to any of the **Grounds of opposition** referred to above
- that the trade mark consists solely of a word (or words) which has become the name or description of an article or substance used by persons in the trade
- that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it would be used in relation to those goods or services, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by the proprietor up to the date one month before the date of the application

- that up to the date one month before the date of the application for removal, a continuous period of five years or longer has elapsed during which the trade mark was a registered trade mark, and during which there was no *bona fide* use thereof in relation to those goods or services by the proprietor
- that there has been a contravention of, or failure to observe, a condition entered on the register in relation to the registered trade mark.

The legislation provides that, after seven years from the date of registration, a registered trade mark shall be taken to be valid in all respects, unless the registration was obtained by fraud or the use of it would be likely to deceive or cause confusion or be contrary to law or morality.

### **Use requirement**

A registered trade mark is vulnerable to cancellation if it has not been used for a continuous period of five years (see the section on **Grounds for cancellation/removal of a trade mark** above).

A proprietor cannot rely on the permitted use by a third party, unless the user is recorded as a registered user.

### **Assignment**

Assignments are possible and may be made with or without the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- date of transfer of ownership
- full particulars and legal status of the assignee
- deed of assignment (simply signed by both parties).

### **Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- full particulars and legal status of the licensee
- licence agreement (simply signed by both parties).

### **Amendments**

The owner of a registered mark may request the Registrar to add to or alter a trade mark in any way which does not substantially affect its identity. Amendment of the specification of goods/services covered by the registration is also possible. Notification of the amendment will be advertised in the Trade Marks Journal.

Requirements for amendment:

- a statement setting out the applicant's interest, the facts upon which the request is based, and the relief sought
- supporting document (if any, eg certified certificate of the change of name and/or address).

### **Rights conferred by registration**

The registration of a trade mark in Part A of the register affords the owner the exclusive right to use the mark in relation to the goods and/or services registered. That right is infringed by any person not having the permission of the owner who uses the identical or a similar mark in respect of identical or similar goods or services.

The registration of a trade mark in Part B of the register affords the owner rights similar to those of Part A registrations, except that the alleged infringer is allowed to prove that there will be no likelihood of deception or confusion.

### **Trade mark infringement**

A registered trade mark is infringed by any person who, not being the proprietor or registered user of a trade mark, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade, or in connection with the provision of any services in respect of which it is registered, and in such manner as to render the use of the mark likely to –

- be taken as being used as a trade mark
- be taken, in a case in which the use is upon the goods, or in physical relation thereto, or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark, or to goods with which such a person is connected in the course of trade
- be taken, in a case where the use is at or near the place where the services are available or performed, or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark, or to services with the provision of which such a person is connected in the course of business
- cause injury or prejudice to the proprietor or registered user of the trade mark.

In addition, the proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well-known trade mark, is entitled to restrain, by injunction, the use in Kenya of a trade mark which (or the essential part of which) is identical or similar to his trade mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.



The Act makes further provision for the infringement of a registered trade mark through the breach of certain contractual conditions (in the case of registered users).

### **Defences to trade mark infringement**

The defences to trade mark infringement provided for in the Act include:

- the *bona fide* use by a person of his or his predecessors' own name or of the name of his place of business
- the use by any person of any *bona fide* description of the character or quality of his goods or services
- the use of a trade mark which has been applied to the goods or used in relation to services by the proprietor or with his authority
- the use of a registered trade mark to describe goods adapted to form part of, or to be accessory to, the proprietor's goods
- the use of a registered trade mark where such use is reasonably necessary in order to describe goods or services
- the use of a trade mark by a third party which has been continuous and which pre-dates the use of the registered trade mark by the proprietor or the registration of the registered trade mark, whichever is the earlier
- the use of a trade mark which is registered.

### **Relief for trade mark infringement**

The Act does not specifically list the relief that may be obtained, but it does by implication allow for an interdict and damages.

Criminal proceedings are also possible. The Act lists certain offences, such as forging a registered trade mark or falsely applying it to goods or services. Relief includes forfeiture of goods, a fine and/or imprisonment.

### **Common law rights**

The Act provides that proceedings for the prevention of, or the recovery of damages for, the infringement of an unregistered trade mark will not be permitted. However, an action for passing-off will not be affected.

Recognition is nevertheless given to common law rights. Thus the Act provides that the owner of a registered trade mark will not be entitled to interfere with or restrain the use by another person of an identical or similar mark, where such use commenced at a date earlier than the date on which the owner commenced using the mark or registered the mark. In the case of honest concurrent use, the court or the Registrar may permit both marks to be registered, subject to such conditions as may be appropriate.

### **Marking of goods**

It is not compulsory to use the ® symbol to indicate that the mark has been registered. It is however a criminal offence to indicate that an unregistered mark has been registered.

## PATENTS

### Law

- Industrial Property Act no 3 of 2001
- Industrial Property Regulations, 2002

Kenya is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### Patent protection

Patent protection is available via a national filing, in appropriate circumstances claiming priority, or an ARIPO application designating Kenya, or an international application under PCT designating Kenya.

Kenya has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application. Kenya has also implemented the PCT in its national law, thereby affording valid protection to applicants making use of the PCT filing system. The deadline for entering the PCT national phase in Kenya is 30 months from the earliest priority date.

The Act places a restriction on persons resident in Kenya to file applications for a patent outside Kenya unless certain requirements are complied with.

### Types of patents

The Act provides for conventional patents to protect an invention which is new, involves an inventive step, and is industrially applicable or is a new use.

The Act also provides for divisional patents, provided that a divisional patent may not go beyond the disclosure in the main patent.

The Act further provides for utility models; patent applications may be converted to utility model applications, and *vice versa* (see the section on **Utility models** below).

### Patentable subject matter

An invention is defined to mean any new and useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, capable of being used or applied in trade or industry.

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following are not patentable:

- discoveries, scientific theories and mathematical methods
- schemes, rules or methods for doing business, performing purely mental acts or playing games

- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised in relation thereto, except products for use in any such methods
- mere presentation of information
- public health related methods of use of any molecule or other substance whatsoever for the prevention or treatment of any disease which the Minister responsible for matters relating to health may designate as a serious health hazard or as a life threatening disease
- plant varieties as provided for in the Seeds and Plant Varieties Act, but not parts thereof or products of biotechnological processes
- inventions contrary to public order, morality, public health and safety, principles of humanity and environmental conservation.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Kenya is designated
- an ARIPO application designating Kenya
- a divisional application, where the original application covered more than one invention
- a utility model application.

### **Application**

Non-convention, convention and PCT national phase applications can be filed with the Kenyan Industrial Property Institute (KIPI).

Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via KIPI, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor, or a statement justifying applicant's right to patent
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document and an English translation thereof (if applicable; not required for PCT national phase applications).

### **Applicant**

The inventor or his successor in title may apply. A statement justifying the applicant's right to the patent is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it has not been anticipated by prior art. Prior art is everything which has been disclosed to the public, anywhere in the world, by publication in tangible form; or in Kenya by oral disclosure, by use or in any other way prior to the filing, or the priority date.

### **Certain prior knowledge or publication excused**

A grace period of 12 months preceding the filing date or the priority date is provided, if the disclosure was by reason of or in consequence of acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Inventiveness**

An invention is considered to involve an inventive step if, having regard to the prior art, it would not have been obvious to a person skilled in the art on the filing or priority date.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Kenya is filed within 12 months from the earlier application.

A certified copy of the priority application can be filed belatedly.

### **Examination/procedure**

Applications are subjected to formal examination. Thereafter KIPIT will call for the filing of a request for substantive examination and payment of the prescribed fees. The request for substantive examination must be filed within three years. Once substantive examination is carried out, the Director notifies the applicant of any objections and invites him to submit his observations and, where applicable, to amend his application. A response to the substantive examination report must be filed within 60 days. This is extendible by a period of 90 days.

### **Opposition**

No provision for filing opposition prior to grant.

### **Publication**

The regulations state that an international application (in which Kenya is designated) shall be published within two months after the application enters the national phase. Similarly, a regional application in which Kenya is designated shall also be published within two months after Kenya is notified of being designated in the regional application under the ARIPO Protocol.

Convention/non-convention applications are published after the expiration of 18 months from the date of filing or the earliest priority date.

**Duration and maintenance**

Patents are valid for a period of 20 years subject to payment of annual maintenance fees. A six month grace period is available subject to payment of fines for late renewal.

Failure to pay the annual maintenance fees before the deadline or within the six month grace period leads to lapsing of the application/patent.

**Restoration**

It is possible to apply for restoration within six months of the expiry of the grace period.

**Revocation**

Provision is made for revocation on numerous grounds, including the following:

- that the owner of the patent is not entitled to apply for the grant of a patent
- that the invention does not relate to an art, whether producing a physical effect or not, process, use, machine, manufacture or composition of matter which is capable of being applied in trade or industry
- that the invention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application
- that the invention, in so far as it is claimed in any claim, is not useful
- that the patent does not fully describe and ascertain the invention and the manner in which it is to be performed
- that the invention is not new.

Applications for revocation can be made within nine months of the publication of the patent for purposes of grant. Applications are made to the Industrial Property Tribunal by any interested party.

**Assignments and licences**

The Act provides for assignments of patents or patent applications, and for voluntary licences. The Act contains extensive provisions regarding voluntary licences, such as the form of a licence contract, prohibited terms in licence contracts, etc. Provision is also made for compulsory licences and licences of right.

Assignments and voluntary licences must be recorded to be effective against third parties.

Requirements for recordal:

- assignment or licence document (simply signed)
- power of attorney from the assignee, or from the licensor/licensee (simply signed).

### **Compulsory licences**

The Act contains provisions for the granting of compulsory licences. These circumstances include failure to work the invention within the stipulated period (see the section on **Working** below).

Another circumstance relates to so-called dependent patents, where a patent cannot be worked without infringing an earlier patent. The owner of the later patent may apply for a compulsory licence, provided the invention of the later patent constitutes an important technical advance over the earlier patent.

### **Amendments**

An applicant may amend his application at any time before acceptance of the application, but the amendment cannot go beyond the scope of the invention as originally filed.

### **Effect of a patent**

The grant of a patent affords the owner the right to preclude any other person from exploiting the patented invention. Thus the owner has the right to preclude other persons from:

- making, importing, offering for sale, selling or using the patented product
- stocking such product for the purpose of selling or using it
- where the patent is for a process, using the process and doing any of the abovementioned acts in respect of a product of the process.

The owner of a patent has the right to institute proceedings against, and to claim relief from, an infringing party.

### **Infringement**

Infringement proceedings may be brought in a competent court. Remedies include an injunction and damages. The Act specifies several exclusions from infringement, including acts done for scientific research, or acts done in respect of articles which have been put on the market by the patent owner (or with his consent) in Kenya, or in any other country and which were imported into Kenya.

### **Marking**

Not compulsory.

### **Working**

Working of the patented invention is required to avoid the grant of a compulsory licence. At any time after four years from the filing date of an application, or three years from the grant of a patent, whichever period expires later, any person may apply for a compulsory licence to exploit the patented invention on the grounds that the market for the patented invention in Kenya is not being supplied on reasonable terms.

**Utility models**

The Act makes provision for the registration of utility models in respect of inventions which are new and industrially applicable. An application for a patent may, before grant, be converted to a utility model application, and *vice versa*.

A utility model certificate expires 10 years after grant.

**DESIGNS****Law**

- Industrial Property Act no 3 of 2001
- Industrial Property Regulations, 2002

Kenya is a member of the Paris Convention, ARIPO (Harare Protocol) and the WTO/TRIPS.

**Design protection**

Design protection is available by way of a national filing, in appropriate circumstances with a claim to convention priority, or via an ARIPO application designating Kenya. Kenya has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby providing for valid design protection to applicants seeking to obtain a design registration via ARIPO.

**Registrable subject matter**

An industrial design means any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

The protection afforded by the Act does not extend to anything in the design which serves to obtain a technical result. Designs which are contrary to public order or morality shall not be registered.

**Classification of designs**

The Locarno Classification is applied.

**Types of applications**

Application for the registration of a design may be by way of:

- a non-convention national application
- a convention application claiming convention priority
- an ARIPO application designating Kenya.

**Application**

The Act states that two or more industrial designs may be the subject of the same application provided they relate to the same class or the same set or composition of articles. However, in practice, applications including multiple embodiments of a single design are refused.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of design or statement justifying the applicant's right to the industrial design
- specimen of the article embodying the industrial design
- certified copy of the priority document, and verified English translation if not in English (if applicable).

### **Applicant**

The author or creator or his assignee can apply for a design registration.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Kenya is filed within six months from the earlier application.

### **Novelty**

An industrial design is registrable only if it is new. An industrial design is deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form, or in Kenya by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration. Disclosure of the design is not taken into consideration if it occurred not earlier than 12 months before the filing date or the priority date of the application and if it was by reason of, or in consequence of, acts committed by the applicant or his predecessor in title, or an evident abuse committed by a third party in relation to the applicant or his predecessor in title.

### **Examination/procedure**

The examination is as to formalities only. If any defects are found in the application, the applicant has two months to rectify the defects.

### **Opposition**

Applications are published in the Kenya Industrial Property Journal and are open to opposition for a period of 60 days from the date of publication. Provided there is no opposition to the application, the design registration certificate is issued in due course.

### **Duration and maintenance**

The initial term of a design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. Renewal fees can only be paid within the last year of the initial five year term.

There is a six month grace period for payment of the renewal fees. If the renewal fee is not paid, the registration lapses.



**Restoration**

Where circumstances beyond the control of the owner of the design registration caused the failure to pay the renewal fee, the owner may apply for the restoration of the registration, within a period of one year from the date on which the renewal was due and upon payment of a surcharge.

**Revocation**

No provision.

**Assignments and licences**

Assignments and licences must be recorded in the register to be enforceable against third parties.

Requirements for recordal:

- assignment or licence document (simply signed by the parties)
- power of attorney from the assignee/licensee (simply signed).

**Compulsory licences**

No provision is made for the granting of compulsory licences.

**Effect of a design registration**

A design registration confers on the owner the right to preclude third parties from performing any of the following acts in Kenya:

- reproducing the design in the manufacture of a product
- importing, offering for sale and selling a product incorporating the protected design
- stocking such products for the purposes of selling.

The rights conferred extend only to acts done for industrial or commercial purposes.

**Infringement**

Infringement proceedings may be brought before the Industrial Property Tribunal. Civil sanctions can include an injunction, damages, delivery up, etc. The Act also provides for criminal sanctions in the case of an intentional infringement. Criminal sanctions can include a fine or imprisonment or both.

**Marking**

No provisions.

**Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Copyright Act no 12 of 2001
- Copyright Regulations, 2004
- Copyright (Amendment) Regulations, 2011

Kenya is a member of the Berne Convention, the Brussels Convention, the Phonograms Convention, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- audiovisual works
- sound recordings
- broadcasts.

Literary works are further defined to include:

- novels, stories, poetic works, letters, reports, memoranda
- plays, stage directions, film scenarios, broadcasting scripts
- textbooks, treatises, essays, articles, encyclopaedias, dictionaries
- lectures, addresses and sermons
- charts, tables and compilations of data
- computer programs.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, engravings, prints
- maps, plans, diagrams
- works of sculpture, works of architecture
- photographs, works of artistic craftsmanship.

### **Requirements for subsistence of copyright**

No requirement for registration. For a work to qualify for protection, the author must be a citizen of Kenya, or domiciled or ordinarily resident in Kenya. Alternatively, the work must have been made or first published in Kenya.

Copyright protection is also extended to persons who are citizens of, or domiciled or resident in, a country which is a party of a treaty of which Kenya is also a party, and which provides for copyright protection.

**Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author also enjoys the moral rights pertaining to the work; these include the right to claim authorship, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights may not be transferred during the life of the author.

**Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years.

In the case of all other works, the duration is 50 years from the date on which the work was made or was made available to the public.

**Protection afforded by copyright**

Copyright confers on the owner the exclusive right to control the doing in Kenya of any of the following acts:

- the reproduction of the work in any material form, including the translation or adaptation thereof
- the distribution to the public of the work, by way of sale, rental, lease, hire, loan
- the communication to the public of the work.

**Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner:

- the doing of any of the listed acts by way of fair dealing for purposes of scientific research, private use, criticism and review
- the reproduction and distribution of copies of an artistic work situated in a public place
- certain usages for teaching in schools or universities.

**Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

**Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, account of profits, delivery up of infringing articles.

### **Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith.

## **PLANT BREEDERS' RIGHTS**

Law

- Seeds and Plant Varieties Act, 1972 (amended in 2002)
- Seeds and Plant Varieties (Plant Breeder's Rights) Regulations, 1994

Plant breeders' rights can be obtained in Kenya under the Seeds and Plant Varieties Act, Chapter 326, Laws of Kenya.

Kenya is a member of the UPOV Convention for the Protection of New Varieties of Plants.

### **Protection**

The effect of protection is that the plant breeder's right holder has an exclusive right to produce reproductive material of the variety for commercial purposes, to offer it for sale, to export it, and to stock it for any of these purposes.

### **Protectable subject matter**

Protection can only be obtained for new varieties of plants that have been specified by the government.

### **Requirements for registrability**

To qualify for registration, and thus for protection under a plant breeder's right, a plant variety must, amongst others, still be new. A plant variety is deemed to be new if propagating material, whole plant or harvested material thereof has not been sold or offered for sale, with the agreement of the owner, for more than six years (woody plants) and four years (non-woody plants) outside Kenya and for more than one year inside Kenya.

### **Application**

The requirements for filing an application for a plant breeder's right include the following:

- an application form
- a completed technical questionnaire

- a power of attorney
- a deed of assignment (if applicable)
- a certified copy of the priority document (if priority is claimed from an earlier application in a UPOV member country).

**Denomination of variety**

A variety denomination can be supplied.

**Applicant**

The plant breeder's right applicant is the person who bred or discovered the plant variety, or his successor in title.

**Convention priority**

Convention priority can be claimed from an earlier application in a UPOV member country.

**Infringement**

Infringements of rights are actionable by the holder, and the relief obtainable includes damages, an injunction and an account. In certain circumstances, there is no right to damages.

**Duration**

Plant breeders' rights are granted for up to 25 years, running from the date of grant. The prescribed protection period for fruit trees and their rootstocks, forest and ornamental trees and grape vines is not less than 18 years from grant. For all other plant materials the prescribed protection period is not less than 15 years from grant.

**Voluntary licences**

The right holder may grant voluntary licences.

**Compulsory licences**

The Act makes provision for compulsory licences in certain circumstances, eg failure to stock the market adequately with propagating material of the variety.

# LESOTHO

## GENERAL INFORMATION

The Kingdom of Lesotho, formerly a British protectorate known as Basotholand, became an independent nation in 1966 and is now a constitutional monarchy. Lesotho is a land-locked country located in Southern Africa and completely surrounded by South Africa.



<b>Area:</b>	30 355 km <sup>2</sup>
<b>Population:</b>	2 million
<b>Capital:</b>	Maseru
<b>Currency:</b>	Maloti
<b>GDP:</b>	\$ 3.31 billion (2010)
<b>Internet domain:</b>	.ls
<b>Languages:</b>	English, Sesotho (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Clothing; footwear; wool; mohair; livestock; food
<b>Imports:</b>	Food; building materials; vehicles; machinery; medicines; petroleum products

## International/regional conventions

Lesotho is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1999)
- Berne Convention (since 1989)
- Harare Protocol (of ARIPO) (since 1987)
- Lusaka Agreement (ARIPO) (since 1987)
- Madrid Agreement on Marks (since 1999)
- Madrid Protocol on Marks (since 1999)
- Paris Convention (since 1989)
- Patent Cooperation Treaty (since 1995)
- Rome Convention (since 1990)
- WIPO Convention (since 1986)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Patents

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Designs

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Copyright

- Copyright Order no 13 of 1989

## TRADE MARKS

### Law

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Lesotho is a member of the Paris Convention, the ARIPO (Banjul Protocol), the Madrid Agreement and Protocol, and the WTO/TRIPS.

### Trade mark protection

The Order provides for the registration of marks in respect of goods and services, and for collective marks.

Since Lesotho is a member of the Paris Convention, it is possible to claim priority on the basis of an earlier application in a convention country. Lesotho has also acceded to the Banjul Protocol of ARIPO, and to the Madrid Agreement and Madrid Protocol of WIPO. However, these treaties have not yet been implemented in the national trade mark laws of Lesotho, so that it is not clear whether valid trade mark protection can be obtained in Lesotho via an ARIPO application or a Madrid application designating Lesotho.

### Protection of well-known marks

Protection is afforded to well-known marks. The registration of a mark which is identical or confusingly similar to a mark that is well known in Lesotho for identical or similar goods or services may be opposed; such a mark cannot validly be registered.

Further, a mark that is identical or similar to, or is a translation of, a trade mark that is well known and registered in Lesotho for goods or services which are not similar, cannot validly be registered if such mark would indicate a connection with the owner of the well-known mark and would damage the interests of such owner. The registration of the mark may be opposed (see the section on **Grounds of opposition** below).

### Advantages of trade mark registration

The registration of a trade mark gives the owner the exclusive right to authorise others to use the trade mark. It also gives the owner the right to institute court proceedings against any person who infringes the mark by using it without the owner's authorisation.

### Types of trade marks

The following types of marks are recognised:

- trade marks for goods and services
- collective marks
- trade names.

### Definition of a mark

A mark is defined as any visible sign capable of distinguishing the goods or services of an enterprise.

A trade name is defined as a name or designation identifying and distinguishing an enterprise.

### **Definition of a collective mark**

A collective mark is defined to mean any visible sign capable of distinguishing the origin or any other characteristic, including quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark.

### **Limitation to colour**

No express provision is made for the use of colours. However, the use of colours is permitted in practice.

### **Classification**

Lesotho has adopted the Nice International Classification of Goods and Services. Lesotho follows a multi-class filing system, ie an application may list more than one class.

### **Convention priority**

The Order provides for the claiming of convention priority in Lesotho. The Lesotho application must be filed within six months of the priority filing date and a certified copy of the priority application must be filed within three months of date of filing of the Lesotho application

### **Application**

An application for registration of a trade mark is filed with the Registrar of Trade Marks, Lesotho.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic print of the mark
- certified copy of the priority document (if applicable).

### **Examination/procedure**

An application is examined as to formalities as well as for compliance with substantive and relative requirements.

### **Opposition**

Once accepted, an application is published for opposition purposes. Opposition may be lodged by any interested person within three months from the date of advertisement of the application in the Official Gazette. In practice, it is possible to obtain an extension of the opposition term by applying to the Registrar of Trade Marks who, in terms of the legislation, has the power to grant extensions of time.

### **Opposition proceedings**

An opposition is lodged by filing a notice of opposition at the office of the Registrar of Trade Marks. Any evidence in support of the opposition would typically accompany the notice of opposition.



The duty to serve the notice of opposition on the trade mark applicant is on the Registrar. After service of the notice of opposition, the trade mark applicant may lodge a counter-statement in defence of the application, together with any evidence in support thereof.

The opponent must apply for a hearing date if the opposition is unopposed, ie if the time period to file a counter-statement has lapsed. If a counter-statement is filed, the Regulations prescribe that application for a hearing date must be made at least one month after the date of filing of a counter-statement and at least one month's notice of the hearing must be given.

At the hearing, the Registrar will hear both parties and make a decision.

### **Grounds of opposition**

In terms of the Order, a mark cannot validly be registered if:

- it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises
- it is contrary to public order or morality
- it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics
- it is identical with, or is an imitation of, or contains an element of, an armorial bearing, a flag or other emblem, a name or official sign or hallmark adopted by a state, intergovernmental or international organisation, unless authorised by the competent authority of that state or organisation
- it is identical with, or confusingly similar to, or constitutes a translation of a mark or trade name which is well known in Lesotho for identical or similar goods or services of another enterprise
- it is identical with a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion
- it is identical with, or confusingly similar to, or constitutes a translation of, a mark which is well known and registered in Lesotho also for goods or services which are not similar, if use of the mark sought to be registered would indicate a connection with the owner of the well-known mark and the interests of such owner are likely to be damaged.

### **Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of filing of the application for registration and, thereafter, renewable for like periods, on the payment of the prescribed fee. A grace period of six months is allowed for late payment of renewal fees, subject to payment of penalty fees.

### **Cancellation/removal of a trade mark**

Any interested person may request the Registrar to invalidate the registration of a mark.

**Grounds for cancellation/removal of a trade mark**

The Registrar may invalidate the registration of a mark if any of the requirements for the registration of the mark is not fulfilled (see the sections on **Definition of a mark** and **Grounds of opposition** above).

In addition, any interested person may request the Registrar to remove a mark from the register in respect of any goods or services for which it is registered, on the grounds that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee for a continuous period of three years or longer, unless special circumstances prevented the use of the mark and there was no intention to abandon it.

**Use requirement/removal for non-use**

Non-use of a registered trade mark in certain circumstances constitutes a ground for the removal of the mark (see the section on **Grounds for cancellation/removal of a mark** above).

**Assignment**

Assignments of registered trade marks are possible and may be made with or without the goodwill of the business. The assignment must be recorded on register in order for it to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment (original or certified copy).

**Licensing/registered users**

The Order provides for the licensing of a mark. Recording of the licence agreement is required to be legally binding. The licence agreement must provide for quality control by the licensor.

Requirements for recordal:

- power of attorney from the proprietor/licensor (simply signed)
- power of attorney from the licensee (simply signed)
- licence agreement (original or certified copy).

**Amendments**

The Order provides for the correction of errors and amendments of applications and registrations, eg in the case of a change of name.

Requirements for amendment:

- power of attorney (simply signed)
- certificate of change of name (if applicable).

**Rights conferred by registration**

Registration of a trade mark confers on the owner the right to authorise the use of the mark in relation to any goods or services in respect of which it has been registered.

In addition, the registered owner is given the right to institute court proceedings against any person who infringes the mark by using the mark without his authority, or who performs any acts that would make it likely for infringement to occur.

The rights conferred do not extend to articles which have been on the market in Lesotho by the owner or with his consent.

### **Trade mark infringement**

In terms of the Order, the use of a registered trade mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner, shall require the agreement of the latter. Use without the consent of the registered owner constitutes infringement.

The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using, without his agreement, the mark, or who performs acts which make it likely that infringement will occur. The right shall extend to use of a sign similar to the registered trade mark and to the use in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in public.

### **Defences to trade mark infringement**

The rights conferred by registration of a mark do not extend to acts in respect of articles which have been put on the market in Lesotho by the registered owner or with his consent. No other specific defences are provided for in the legislation.

### **Relief for trade mark infringement**

Relief includes an interdict and damages. Criminal proceedings, resulting in a fine and/or imprisonment, are also possible.

### **Common law rights**

From an enforcement perspective, Lesotho is a former British Colony and, as such, it recognises that a person who has acquired a reputation in a mark in relation to goods or services may prevent others from misrepresenting that they are associated with the proprietor in a manner that is likely to cause confusion and deception and damage to the person with a reputation (passing-off).

### **Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg 'Regd. Tm.') or symbol ® is optional.

## **PATENTS**

### **Law**

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Lesotho is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### **Patent protection**

Patent protection is available via a national filing or an ARIPO application designating Lesotho. Lesotho has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application.

The Industrial Property Amendment Act, 1997 amended the principal legislation by giving effect to PCT applications in Lesotho, but Regulations to implement the PCT provisions have not yet been promulgated. However, the existing legislation does contain a provision which states that any international treaties in respect of which Lesotho is a signatory shall apply in Lesotho and, in the event of a conflict between the national law and the international treaty, the provisions of the international treaty will apply. This means that international PCT applications, in which Lesotho is designated, may form the basis of national phase applications in Lesotho. Foreign applicants must be represented by an agent.

### **Types of patents**

The law provides for:

- conventional patents in respect of inventions which are new, inventive and industrially applicable
- divisional patents, where the initial application contained more than one invention
- utility model certificates, in respect of inventions which lack inventiveness.

### **Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following are not patentable:

- discoveries, scientific theories and mathematical methods
- plant or animal varieties or essentially biological processes for the production of plants or animals, other than microbiological processes and the products of such processes
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body.

Although methods for the treatment of the human or animal body and diagnostic methods are not patentable subject matter, the prohibition does not extend to products for use in those methods.

### **Types of applications**

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Lesotho is designated
- an ARIPO application designating Lesotho
- a divisional application, where the parent application covers more than one invention
- a utility model application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Lesotho Patent Office in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor, or a statement by the applicant justifying his right to the invention
- copy of the specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

An invention is new if it has not been anticipated by prior art. Prior art is everything that has been disclosed to the public, anywhere in the world, by publication in tangible form; or in Lesotho, by oral disclosure, by use or in any other way, prior to the filing or the priority date.

### **Certain prior knowledge or publication excused**

A grace period of six months preceding the filing date or the priority date is provided if the disclosure was by reason of, or in consequence of, acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Inventiveness**

An invention shall be considered as involving an inventive step if, having regard to the prior art, it would not have been obvious to a person with ordinary skill in the art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Lesotho is filed within 12 months from the earlier application.

A certified copy of the priority application can be filed belatedly. However, if not submitted to the satisfaction of the Registrar, then the claim to priority will be disregarded.

### **Examination/procedure**

An application is subjected to formal examination, and to a more substantive examination which may or may not cover the requirements of novelty and inventive step. Currently, substantive examination of applications filed in Lesotho is being carried out by the ARIPO examiners.

### **Opposition**

No provision is made for the filing of an opposition to a patent prior to grant. However, it is possible to appeal the decision to register a patent within two months of the date of grant. An appeal must be filed with the High Court.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant the patent. Granted patents are published in the Lesotho Patent Journal.

### **Duration and maintenance**

The term of a patent obtained in terms of Lesotho's national legislation is 15 years. This period is extendible for a further five year period subject to the filing of a suitable application and proof of working of the patent in Lesotho, or circumstances which justify the failure to work the patent. However, the Harare Protocol states that the term of an ARIPO patent designating Lesotho is 20 years.

### **Restoration**

There are no provisions for restoration of a patent after expiry of the six months grace period for payment of the renewal fee.

However, the Registrar does have a general discretion to excuse the failure to comply with any deadlines in the Order or Regulations if he is satisfied that circumstances justify the failure to do so. Accordingly, it may be possible to argue that renewal fees can be tendered after the expiry of the six month grace period for payment of the annual maintenance fees.

### **Revocation**

Any interested person may request the High Court to invalidate a patent on the following grounds:

- non-patentable subject matter
- lack of novelty, inventiveness or industrial applicability
- lack of sufficiency and/or clarity of disclosure and/or claims
- failure to file drawings if they were necessary to understand the invention.

### **Assignments and licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

The Registrar must publish any assignments or the appointment of any licensees in the Journal. Although a copy of the licence agreement must be furnished, the contents shall remain confidential.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

The law also provides for the exploitation of a patented invention by a government agency or a third person, without the agreement of the patent owner but on the basis of a decision by the Minister, in cases of public interest, in particular national security, nutrition, health or the developments of vital sectors of the economy.

### **Amendments**

Amendments can be made prior to grant, but any amendment shall not go beyond the disclosure of the invention in the application as filed. Although it is not possible to amend a patent in any material manner, the Registrar does have the power to correct any clerical error in any documents filed in support of an application or an error appearing in the register.

### **Effect of a patent**

The registration of a patent confers on the owner the right to authorise others to exploit the invention, and the right to institute court proceedings in the case of infringement.

### **Infringement**

The exploitation of the patented invention in Lesotho by any person other than the patentee, without the authority of the patentee, shall be considered an infringement of the patent. This is subject to certain exceptions, ie unless the person has been granted a compulsory licence; or unless the use occurs on board an aircraft or vehicle which has only temporarily entered the airspace or territory of Lesotho.

The exclusive right of the patentee also does not extend to articles which have been put on the market in Lesotho by the patent owner or with his consent, or to acts done for research.

**Marking**

No provision.

**Working**

Working of a patented invention is required within a period of four years from the date of filing, or three years from the grant of the patent, whichever occurs later. Failure to work the patent may lead to the granting of a non-exclusive, compulsory licence to interested third parties if they are able to prove their ability to work the patent.

**Utility model certificates**

The Industrial Property Order provides that an invention will also qualify for registration as a utility model if it is new and industrially applicable. The requirements for registrability are very similar to those for patents, and the rights conferred by a utility model certificate are likewise similar to those conferred by a patent.

A utility model certificate expires, without any possibility of renewal, at the end of the seventh year after the filing date. An applicant for a patent may, before the grant/rejection of the application, convert the application into an application for a utility model, and *vice versa*.

**DESIGNS****Law**

- Industrial Property Order no 5 of 1989, last amended by Act no 4 of 1997
- Industrial Property Regulations, 1989

Lesotho is a member of the Paris Convention, ARIPO (Harare Protocol) and the WTO/TRIPS.

**Design protection**

Design protection is available by way of a national filing or via an ARIPO application designating Lesotho. Lesotho has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving valid design protection to applicants seeking to obtain a design registration via ARIPO.

**Registrable subject matter**

An industrial design means any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, which composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, provided that it does not consist of anything which serves to obtain a technical result.



### **Classification of designs**

The Locarno International Classification of Designs is not applied. However, the law does require the application to state the kind of products for which the design will be used.

### **Types of applications**

Application for a design registration may be made by way of –

- a non-convention application, where the effective date is the filing date
- a convention application, claiming convention priority, where the effective date is the priority date
- an ARIPO application designating Lesotho.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Lesotho Designs Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**. Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- statement justifying applicant's right to registration/assignment document
- suitable graphic representations of the design
- certified copy of the priority document (if applicable).

### **Applicant**

The author or creator or his assignee may apply for registration.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Lesotho is filed within six months from the earlier application.

A certified copy of the priority application can be filed belatedly. However, if not submitted to the satisfaction of the Registrar, then the claim to priority will be disregarded.

### **Novelty**

A design is new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form; or in Lesotho, by description or by use or in any other way, prior to the filing, or where appropriate, the priority date, of the application. A grace period of six months preceding the filing date or priority date is provided, for disclosures which were by reason of, or in consequence of, acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements and also to determine whether the design falls within the definition of a design. If satisfied that the conditions for registration have been met, the Registrar shall register the design, publish the fact of registration, and issue the registration certificate.

### **Opposition**

No provision is made for the filing of an opposition to a design prior to registration. It is however, possible to appeal the decision to register an industrial design within two months of the date of registration. An appeal must be filed with the High Court.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. ARIPO designs, however, are only valid for 10 years and are subject to payment of annual maintenance fees. ARIPO also has a six month grace period for payment of renewal fees.

### **Restoration**

No provision.

### **Revocation**

Any interested person may apply to the court for the invalidation and revocation of a design registration, on any of the following grounds:

- that the design is not a design as defined
- that the design is not new
- that the design is contrary to public order or morality
- that the registered owner is not the creator of the design or his successor in title.

### **Assignments and licences**

The right to a design may be transferred. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

No provision is made for compulsory licences for designs in Lesotho.

### **Effect of a design registration**

The registration of a design confers on the owner the right to authorise others to exploit the design in Lesotho, and the right to institute court proceedings against any person who exploits the design without the owner's consent, or who performs any acts that make it likely that infringement will occur.

**Infringement**

The exploitation of a registered industrial design by anyone other than the registered owner requires the consent of the owner. The owner of a registered industrial design has the right to institute court proceedings against any infringer as well as any person who performs any act which makes it likely that an infringement will occur.

The rights of the owner do not extend to acts in respect of articles which have been put on the market in Lesotho by the owner or with his consent.

**Marking**

Optional.

**Working**

No provision.

**COPYRIGHT****Law**

- Copyright Order no 13 of 1989

Lesotho is a member of the Berne Convention, the Rome Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law confers copyright protection on authors of original literary, artistic and scientific works. Such works include:

- books, pamphlets, theses, dissertations and other writings
- lectures, addresses, sermons and other oral works
- dramatic and dramatico-musical works
- musical works, vocal or instrumental
- choreographic works, pantomimes
- cinematographic and audiovisual works
- works of drawing, painting, architecture, sculpture, engravings, tapestry
- photographic works
- works of applied art
- illustrations, maps, plans, three-dimensional works relative to geography, topography, architecture, technology or science.

Protection is also given to derivative works, including:

- translations, adaptations, arrangements, transformations of literary, artistic or scientific works
- collections of literary, artistic or scientific works
- works inspired by expressions of folklore.

### **Registration of copyright**

Not provided for.

### **Exclusions from copyright**

Copyright protection shall not extend to:

- rules or decisions of courts or administrative bodies
- news of the day
- mere communications of facts or data.

### **Authorship and ownership**

The author is entitled to ownership of the copyright, which comprises economic and moral rights. The economic rights can be transferred; the moral rights cannot be transferred.

### **Duration of copyright**

Copyright generally endures for the lifetime of the author plus 50 years. In the case of cinematographic or audiovisual works, the period of protection is 50 years from the making of the work. In the case of photographic works or works of applied art, the duration of protection is 25 years from the making of the work.

### **Protection afforded by copyright**

The economic rights enjoyed by the author or his successor in title comprise the exclusive right to do or to authorise the following acts:

- reproducing the work
- communicating the work to the public by performance, broadcasting, distribution
- making an adaptation, translation or transformation of the work.

### **Exceptions to copyright protection**

Certain uses of a protected work shall be permissible without the author's or owner's consent, including:

- reproduction, translation, etc of the work exclusively for the user's personal and private use
- use for quotations, provided such quotations are compatible with fair practice
- use by way of illustration for teaching purposes
- use for reporting on current events.

### **Moral rights**

The moral rights enjoyed by the author include the right –

- to claim authorship and to be recognised as the author
- to object to any distortion, mutilation or modification of the work which would be prejudicial to his honour or reputation.

### **Assignment and licensing of copyright**

The author or his successor in title has the right to transfer or license the economic rights.

### **Copyright infringement and proceeding**

In the case of copyright infringement, the copyright owner may institute civil proceedings in a court of competent jurisdiction; the remedies include an interdict, damages for losses suffered, taking into account the profits enjoyed by the infringing person. If the infringement caused reputational prejudice, exemplary damages may be awarded.

### **Criminal offences**

Violation of the rights under copyright also constitutes an offence; the penalties may be a fine or imprisonment or both.

### **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Lesotho.

# LIBERIA

## GENERAL INFORMATION

Liberia is located on the west coast of Africa, bordered to the north by Sierra Leone and Guinea, to the east by the Ivory Coast and to the west and south by the Atlantic Ocean.



<b>Area:</b>	111 370 km <sup>2</sup>
<b>Population:</b>	3.7 million
<b>Capital:</b>	Monrovia
<b>Currency:</b>	Liberian Dollar
<b>GDP:</b>	\$ 1.76 billion (2010)
<b>Internet domain:</b>	.lr
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Iron ore; diamonds; natural rubber; coffee; timber
<b>Imports:</b>	Fuel; chemicals; machinery; transportation equipment; manufactured goods; rice and other foodstuffs

## International/regional conventions

Liberia is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 2010)
- Berne Convention (since 1989)
- Harare Protocol (of ARIPO) (since 2010)
- Lusaka Agreement (ARIPO) (since 2009)
- Madrid Agreement on Marks (since 1995)
- Madrid Protocol on Marks (since 2009)
- Paris Convention (since 1994)
- Patent Cooperation Treaty (since 1994)
- Phonograms Convention (since 2005)
- Rome Convention (since 2005)
- Universal Copyright Convention (since 1956)
- WIPO Convention (since 1989)

## IP legislation

**Note:** Although the Industrial Property Act of Liberia was published in 2003, it has not yet actually been passed by Parliament. However, in practice, with effect from January 2009, its provisions have been complied with by the Liberian Industrial Property Office under an executive decision.

### Trade marks

- Industrial Property Act of Liberia, 2003

### Patents

- Industrial Property Act of Liberia, 2003

### Designs

- Industrial Property Act of Liberia, 2003

### Copyright

- Copyright Act of Liberia, 1997

## TRADE MARKS

### Law

- Industrial Property Act of Liberia, 2003

**Note:** Although the Act was published in 2003 it has not yet been passed by Parliament. However, in practice, with effect from 1 January 2009, its provisions have been complied with by the Trade Marks Office under an executive decision.

Liberia is a member of the Paris Convention, the Madrid Agreement and Protocol, and the ARIPO (Banjul Protocol).

### Trade mark protection

Provision is made for the registration of trade marks for goods and services, for collective marks, and for the protection of trade names.

### Protection of well-known marks

A mark cannot validly be registered if it is identical or confusingly similar to, or a translation of, a mark of another enterprise that is well known in Liberia for identical or similar goods or services; or if the other mark is well known and registered in Liberia for goods or services which are not identical or similar, when registration of the first mark would indicate a connection with the goods, services, or owner of the well-known mark and the interests of such owner are likely to be damaged.

### Advantages of trade mark registration

The registration of a trade mark confers on the owner the right to authorise other persons to use the registered mark in respect of the relevant goods and services. Registration also confers on the owner the right to institute court proceedings against any person who infringes the trade mark.

### Types of trade marks

The Act provides for the registration of the following marks:

- trade marks for goods
- trade marks for services
- collective trade marks.

### Definition of a trade mark

A trade mark is defined as any visible sign capable of distinguishing the goods or services of an enterprise.

### Definition of a collective trade mark

A collective mark is defined as any visible sign capable of distinguishing the origin or other common characteristic, including the quality, of goods or services of different enterprises which use the sign subject to the control of the registered owner thereof.

### **Limitation of colour**

No express reference is made to the colours of a mark. However, the use of colours is permitted in practice.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

Liberia is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the first filed application, provided the Liberian application is filed within six months of such earlier filing date.

### **Banjul Protocol**

A mark in respect of which Liberia is a designated state, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect in Liberia as a mark registered under the Liberian Act, unless the Registrar has communicated to ARIPO a decision, in accordance with the provisions of the Protocol, that a registration made by ARIPO shall have no effect in Liberia.

### **Application**

An application may be filed as a national filing at the Liberian Trade Marks Office, administered by the Director for Industrial Property.

The following information and documents are required:

- full particulars of the applicant
- combined authorisation of agent, oath and declaration (legalised or authenticated by an Apostille under the Hague Convention)
- electronic prints of the trade mark
- list of the goods or services to be covered
- priority document (certified copy), if priority is claimed.

Since Liberia became a member of ARIPO and the Banjul Protocol in 2010 it is possible that applications for trade mark registration may also be filed by way of ARIPO filings. The Act expressly provides that a mark registered by ARIPO where Liberia is a designated state, shall have effect in Liberia (see the section on **Banjul Protocol** above).

Although there is no express reference to the Madrid Agreement or Protocol, the Act has a general provision to the effect that any international treaty of which Liberia is a member shall apply to matters dealt with by the Act. However, the effect of trade mark registrations under Madrid and designating Liberia is not clear.

### **Examination/procedure**

The Registrar examines the application to determine whether it complies with the formal, relative and substantive requirements.



The Registrar, if he is satisfied that the application complies with the requirements, will accept the application and advertise the application for opposition purposes in the local newspaper. Thereafter the registration certificate will be issued.

### **Opposition**

Opposition may be lodged within 30 days following advertisement of the trade mark application. As mentioned below, the Registrar appears to be empowered to grant extensions of time.

### **Opposition proceedings**

In terms of the Act, the Registrar shall send a copy of the opponent's notice of opposition to the applicant who must, within the prescribed period and in the prescribed manner, submit a counter-statement to the Registrar setting out the grounds on which he relies for his application. If the applicant does not submit a counter-statement, his application shall be deemed to have been abandoned.

If the applicant does submit a counter-statement, the Registrar shall send a copy thereof to the opponent and, after hearing the parties, if either or both parties wish to be heard, the Registrar must consider the merits of the opposition and decide whether or not the mark in question should be registered.

Regulations governing the prescribed manner in which oppositions may be lodged are referred to in the Act but, at the time of writing, regulations have not yet been published. It is worth noting that the Act does empower the Registrar to grant extensions of time.

### **Grounds of opposition**

A mark cannot be validly registered:

- if it does not fulfil the definition of a trade mark
- if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises
- if it is contrary to the public order or morality
- if it is likely to mislead the public or trade circles, in particular with regard to geographical origin of the goods or services concerned or their nature or characteristics
- if it is identical with, or is an imitation of, or contains as an element, an armorial bearing, flag and other emblem, or official sign or hallmark of any state, intergovernmental organisation or international organisation, unless authorised by the competent authority of that state or organisation
- if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Liberia for identical or similar goods or services of another enterprise; or which is well known and registered in Liberia for goods or services which are not identical or similar, but where use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and the interests of the owner of the well-known mark are likely to be damaged by such use

- if it is identical with a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

### **Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of filing, and may be renewed for consecutive periods of 10 years upon payment of the renewal fees. A period of six months is allowed for the late renewal of a trade mark, subject to the payment of a penalty fee.

### **Cancellation/removal of a trade mark**

Any interested person may request the Registrar to invalidate the registration of a trade mark.

### **Grounds for cancellation/removal of a trade mark**

A registered trade mark may be invalidated on any one of the grounds listed in the section on **Grounds of opposition** above.

A registered trade mark may also be cancelled if it has not been used for a continuous period of three years up to one month preceding the date of the request for cancellation, unless special circumstances prevented the use (see the section on **Use requirement** below).

### **Use requirement**

If a registered trade mark is not used by the registered owner or a licensee for a continuous period of three years or longer, the registration shall be vulnerable to cancellation, unless there are special circumstances which prevented the use (see the section on **Grounds for cancellation/removal of a trade mark** above).

### **Assignment**

The rights in a mark may be transferred or assigned, and the transfer must be in writing and recorded at the Trade Marks office. The change will have no effect until it has been recorded.

Any change in ownership must be made with the goodwill of the business.

Requirements for recordal:

- power of attorney from the assignee (legalised/ authenticated by Apostille)
- deed of assignment (legalised).

### **Licensing/registered users**

Licensing of a registered trade mark is recognised. Recordal of the licence agreement is required in order to be effective against third parties.

Any licence agreement must provide for the effective control by the licensor, of the quality of the goods and services of the licensee in

connection with which the mark is used. If the licence agreement does not provide for such quality control, or if such control is not effectively carried out, the licence agreement shall not be valid.

Requirements for recordal:

- power of attorney by the licensee (legalised/ authenticated by Apostille)
- power of attorney by the licensor (legalised/ authenticated by Apostille)
- licence agreement (legalised).

### **Amendment**

No provision.

### **Rights conferred by registration**

The registration of a trade mark confers on the owner the exclusive right to authorise the use of the mark by others in relation to the relevant goods or services. The owner is also given the right to institute court proceedings against any person who infringes the right.

### **Trade mark infringement**

The Act states that the use of a registered mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner, shall require the agreement of the latter.

The Act furthermore states that the registered owner of a mark, in addition to any other rights, remedies or actions available to him, has the right to institute court proceedings against any person who infringes the mark by using the mark without his agreement, or who performs acts which make it likely that infringement will occur. The right extends to the use of a sign similar to the registered mark, and to use in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public.

### **Defences to trade mark infringement**

The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Liberia by the registered owner or with his consent. No other specific defences are provided for in the Act.

### **Relief for trade mark infringement**

Relief in the form of an injunction (to prevent continued infringement or imminent infringement) and damages may be obtained. Criminal proceedings are also possible where the person knowingly performs an act of infringement.

### **Common law rights**

No express provisions.

### **Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg Regd. Tm.) or symbol ® is optional.

## PATENTS

### Law

- Industrial Property Act of Liberia, 2003

**Note:** Although the Act was published in 2003 it has not yet been passed by Parliament. However, in practice, with effect from 1 January 2009, its provisions have been complied with by the patent office under an executive decision.

Liberia is a member of the Paris Convention, ARIPO (Harare Protocol) and PCT.

### Patent protection

Patent protection is available via a national filing or an ARIPO application designating Liberia. The 2003 Act (which, as indicated above, is being applied), incorporates the Harare Protocol (which regulates patent and design filings in ARIPO) into Liberia's national law. However, the validity of an ARIPO application designating Liberia is uncertain as it is not clear whether the 2003 Act is legally in effect. The 2003 Act also provides for PCT filings. Accordingly, patent protection may be obtained via the PCT, but again there is some uncertainty in regard to validity.

### Types of patents

Patents may be obtained for inventions which are new, inventive and industrially applicable. The Act also provides for divisional patents where the initial application contained more than one invention. A divisional application is entitled to the filing or priority date of the initial application.

### Patentable subject matter

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following are not patentable:

- discoveries, scientific theories and mathematical methods
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body
- inventions the commercial exploitation of which would be contrary to public order or morality.

Although methods for the treatment of the human or animal body and diagnostic methods are not patentable subject matter, the prohibition does not extend to products for use in those methods.

### Types of applications

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application

- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Liberia is designated
- an ARIPO application designating Liberia
- a divisional application, where the original application covers more than one invention.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Liberian Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- assignment from the inventor(s) or a statement by the applicant justifying its right to the invention (legalised)
- copy of the specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable; not required for PCT national phase applications).

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

An invention is new if it is not anticipated by prior art. Prior art consists of everything that has been disclosed to the public, anywhere in the world, by publication in tangible form; or in Liberia, by oral disclosure, by use or in any other way, prior to the filing or the priority date.

### **Certain prior knowledge or publication excused**

A grace period of 12 months preceding the filing date or the priority date is provided if the disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Inventiveness**

An invention is considered to be inventive if, having regard to the prior art, it would not have been obvious to a person with ordinary skill in the art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Liberia is filed within 12 months from the earlier application.

The Registrar may call for the filing of a certified copy of the priority application. If the priority document is not submitted as required by the Registrar, then the claim to priority will be disregarded.

### **Examination/procedure**

The Act requires that applications should be subjected to both formal and substantive examination. It provides that the Registrar may take into account the result of an examination report by any competent authorities for any corresponding applications, such as the International Search Report or International Preliminary Report on Patentability, or he may cause the application to be examined by an external search and examination authority. However, in practice only formal examination is carried out and patents proceed to grant very quickly in Liberia.

The Act requires that the Director General must make a decision on grant within two years of the commencement of examination.

### **Opposition**

No provision is made for the filing of an opposition to a patent prior to grant. However, it is possible to appeal the decision to register a patent within two months of the date of grant. An appeal must be filed with the Circuit Court.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant the patent. Granted patents are published in the Liberian Patent Journal.

### **Duration and maintenance**

The term of a patent is 20 years. Maintenance fees are payable in advance on pending Liberian applications, and are payable annually calculated from the filing date. A grace period of six months is provided. If the payment is not made within this period, the patent lapses.

However, the Registrar does have a general discretion to excuse the failure to comply with any deadlines in the Act or Regulations if he is satisfied that circumstances justify the failure to do so. Accordingly, it may be possible to argue that renewal fees can be tendered after the expiry of the six month grace period for payment of the annual maintenance fees.

### **Restoration**

There is no provision for restoration of a patent after expiry of the six months grace period for payment of the renewal fee.

### **Revocation**

Any interested person may request the Circuit Court to invalidate a patent on the following grounds:

- non-patentable subject matter
- lack of novelty

- lack of sufficiency and/or clarity of disclosure or claims
- failure to file drawings if they were necessary to understand the invention
- applicant not entitled to protection.

### **Assignments and licences**

Assignments and voluntary licences are permitted and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (legalised)
- deed of assignment or licence contract (legalised).

The Registrar must publish any assignments or the granting of any licences in the Journal. Although a copy of the licence agreement must be furnished, the contents shall remain confidential.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

The Act also makes provision for the granting of compulsory licences in the interests of national security, nutrition, health or the development of the economy, and also in the case of anti-competitive behaviour. In such cases, the request should be accompanied by proof to the effect that the applicant for the licence has been unable to obtain such licence on reasonable terms and within a reasonable time. Proof to this effect is not required in the case of a national emergency or if the patentee has been found to be guilty of anti-competitive practices.

The Act further provides for compulsory licences in the case of dependent patents, where a later patent cannot be exploited without infringing on an earlier patent, provided the invention in the later patent involves an important technical advance of considerable economic importance.

The Act states that the exploitation of a patent under a compulsory licence shall be predominantly for the supply of the market in Liberia, but does not specifically rule out exportation.

### **Amendments**

Amendments can be made prior to grant, but any amendment shall not go beyond the disclosure of the invention in the application as filed. Although it is not possible to amend a patent in any material manner, the Registrar does have the power to correct any clerical error in any documents filed in support of an application, or an error appearing in the register.

### **Effect of a patent**

The grant of a patent affords the owner the exclusive right to authorise the exploitation of the patented invention by other persons. The exploitation of a patent means any of the following acts:

- making, importing, offering for sale, selling and using the patented product
- stocking such product for purposes of sale or use
- using a patented process, and doing any of the acts referred to above in respect of a product of the process.

Furthermore, the patent owner has the right to institute court proceedings against any person who infringes the right. This right does not extend to acts in respect of articles which have been put on the market in Liberia by the patent owner or with his consent; or to the use of articles on aircraft, vehicles or vessels temporarily within the territory of Liberia; or to acts done solely for experimental purposes; or to acts done in good faith prior to the filing date or priority date.

### **Infringement**

The Circuit Court has jurisdiction to hear matters related to patent infringement. Any person who commits any act which is reserved for the owner of the patent without the permission of the patent owner commits an infringement.

### **Marking**

No express provision.

### **Working**

Working is required within a period of four years from the date of filing, or three years from the grant of the patent, whichever occurs later. Failure to work the patent may lead to the granting of a non-exclusive, compulsory licence to interested third parties on terms and conditions fixed by the Director General, and subject to payment of the prescribed fee (see the section on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Industrial Property Act of Liberia, 2003

**Note:** Although the Act was published in 2003 it has not yet been passed by Parliament. However, in practice, with effect from 1 January 2009, its provisions have been complied with by the Designs Office under an executive decision.

Liberia is a member of the Paris Convention and ARIPO (Harare Protocol).

### **Design protection**

Design protection is available by a national filing or via an ARIPO application designating Liberia. Liberia has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving design protection to applicants seeking to obtain a design registration via ARIPO.



**Registrable subject matter**

An industrial design is defined to mean any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, which composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

The Act excludes from protection anything in a design which serves solely to obtain a technical result.

**Classification of designs**

The Locarno International Classification of Designs is applied.

**Types of applications**

A design application may be filed as a national filing in Liberia, in appropriate circumstances claiming priority, or as an ARIPO application designating Liberia.

**Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Liberian Designs Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

A single application can cover multiple designs provided they relate to the same class of the international classification, or to the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- statement by the applicant justifying his right to the design (legalised)
- certified copy of the priority document (if applicable).

**Applicant**

The author/creator or his assignee can apply for registration.

**Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Liberia is filed within six months from the earlier application.

The Registrar may call for the filing of a certified copy of the priority application. If the priority document is not submitted as required by the Registrar, then the claim to priority will be disregarded.

**Novelty**

A design is new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form, or in Liberia, by description, or by use, or in any other way prior to the filing or, where appropriate, the priority date, of the application. A grace period of 12 months preceding the filing date or priority date is provided, for disclosures which were by reason of, or in consequence of, acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

**Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements and also to determine whether the design falls within the definition of a design. If satisfied that the conditions for registration have been met, the Registrar shall register the design, publish the fact of registration and issue the registration certificate.

**Opposition**

No provision is made for opposition to a design prior to registration. It is, however, possible to appeal the decision to register an industrial design within two months of the date of registration. An appeal must be filed with the Circuit Court.

**Duration and maintenance**

The initial term of a design registration in Liberia is five years, which period is extendible upon payment of renewal fees for two further five year terms. There is a six month grace period for payment of the renewal fees.

ARIPO designs are, however, only valid for 10 years and are subject to payment of annual maintenance fees. ARIPO also has a six month grace period for payment of renewal fees.

**Restoration**

No provision.

**Revocation**

Provision is made for the invalidation of a design registration on the request of a person who can prove that any of the requirements for registration (eg as regards registrable subject matter and novelty) have not been met; or if the registered owner is not the creator of the design or his successor in title.

**Assignments and licences**

The right to a design may be transferred, and voluntary licences may be granted. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (legalised)
- deed of assignment or licence agreement (legalised).

**Compulsory licences**

No provision is made for compulsory licences for designs in Liberia.

**Effect of a design registration**

A design registration affords the registered owner the right to exploit, and to authorise other persons to exploit, the design. Exploitation means making, selling or importing articles incorporating the design.

The right of the owner does not extend to articles which have been put on the market in Liberia by the owner or with his consent.

**Infringement**

The exploitation of a registered industrial design by anyone other than the registered owner requires the consent of the owner. The owner of a registered industrial design has the right to institute court proceedings against any infringer, as well as against any person who performs any act which makes it likely that an infringement will occur.

**Marking**

Optional.

**Working**

No requirements.

**COPYRIGHT****Law**

- Copyright Act of Liberia, 1997

Liberia is a member of the Berne Convention, the Rome Convention, the Phonograms Convention, and the Universal Copyright Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law provides for copyright in respect of original works of authorship in the form of literary, dramatic-musical and artistic works, including:

- books, pamphlets, computer programs and other writings
- lectures, addresses, sermons
- dramatic and dramatic-musical works
- musical works
- choreographic works, pantomimes
- audiovisual works
- works of art, painting, drawing, architecture, sculpture, etc
- photographic works
- works of applied art or handicraft

- illustrations, maps, plans, sketches, three-dimensional works relative to geography, topography, architecture, science
- works of folklore
- translations, adaptations, arrangements of works
- compilations of literary or artistic works
- derivative works.

### **Exclusions from copyright**

Excluded from protection are:

- ideas, procedures, processes, concepts, principles
- laws and decisions by courts or administrative bodies, reports by commissions
- mere data regardless of the form in which it is described, explained, illustrated.

### **Registration of copyright**

No requirement for registration.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author must be a Liberian national or resident, or the work must have been first published in Liberia. Since Liberia is a member of the Berne Convention, copyright protection is extended to works eligible under such treaty, eg where the author is a national or resident of a member country of the treaty.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author.

### **Duration of copyright**

Copyright generally endures for the lifetime of the author plus 50 years. The copyright in a photographic work endures for 25 years from the publication of the work; for cinematograph or audiovisual works the period is 50 years.

### **Protection afforded by copyright**

Copyright confers on the copyright owner certain economic rights, including the exclusive right himself to do, or to authorise, any of the following acts:

- reproduce the copyright work or make sound recordings
- prepare derivative works
- distribute copies of sound recordings to the public, including by way of importation (regardless of whether copies were made and distributed lawfully in any other country)
- communicate the copyright work to the public.

The author also has the exclusive moral rights to –

- claim authorship and to be acknowledged as the author
- to object to mutilation or modification of the work which would be prejudicial to his honour or reputation.

### **Exclusions from copyright**

The Act provides for certain acts to be excluded from copyright, namely acts constituting fair use of a copyright work, for purposes of criticism, news reporting, teaching (including the making of copies for classroom use), scholarship or research.

### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed.

### **Compulsory licences**

The Act provides for compulsory licences to be granted in specific circumstances, eg to make and distribute sound recordings of a non-dramatic musical work.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Liberia.

# LIBYA

## GENERAL INFORMATION

Libya is situated in North Africa on the Mediterranean Sea and is bordered by Tunisia and Algeria on the west, Niger and Chad on the south, Sudan on the south-east and Egypt on the east.



**Area:** 1 759 540 km<sup>2</sup>

**Population:** 6.5 million

**Capital:** Tripoli

**Currency:** Libyan Dinar

**GDP:** \$ 89 billion (2010)

**Internet domain:** .ly

**Languages:** Arabic (official language)

**Working week:** Sunday - Thursday

**Exports:** Crude oil; refined petroleum products; natural gas; chemicals

**Imports:** Machinery; transport equipment; manufactured goods

## International/regional conventions

Libya is a member of the following international agreements:

- Berne Convention (since 1976)
- Paris Convention (since 1976)
- Patent Cooperation Treaty (since 2005)
- WIPO Convention (since 1976)

## IP legislation

Trade marks

- Trade Mark Law no 40 of 1956
- Commercial Law no 23 of 2010

Patents

- Patents, Industrial Designs and Models Law no 8 of 1959

- Patents, Industrial Designs and Models Law no 8 of 1959

Copyright

- Copyright Protection Law no 9 of 1968

## TRADE MARKS

### Law

- Trade Mark Law no 40 of 1956
- Commercial Law no 23 of 2010

**Note:** A new Commercial Law no 23 of 2010 has been enacted, which includes provisions on trade marks. This Law became effective on 21 August 2010; however, the regulations to implement the Law have not yet been issued. Accordingly, the Trade Mark Law of 1956 is still being applied.

Libya is a member of the Paris Convention.

**Trade mark protection**

The 1956 Law provides for the protection of trade marks for goods and services, and also for certification and collective marks.

**Protection of well-known marks**

No express provision is made in the 1956 Law for the protection of well-known marks. The new 2010 Law defines a well-known mark and provides for protection of well-known marks.

**Advantages of trade mark registration**

The registered owner of a trade mark is deemed to be the sole proprietor of the mark, and is entitled to the exclusive use thereof.

**Types of trade marks**

Trade marks are, in practice, registrable in respect of goods and services. However, the Law only refers to the registration of trade marks in respect of goods, referred to as so-called commercial trade marks. The new 2010 Law provides for the registration also of certification and collective marks.

**Definition of a trade mark**

A commercial trade mark is defined to include names of any distinctive form, signatures, words, letters, figures, drawings, tokens, stamps, seals, devices, embossed engravings or any other mark, employed or intended to be employed to distinguish the products of any undertaking.

**Limitation to colour**

There is no express reference to colours, but the use of colours is permitted in practice.

**Classification**

The International Classification of Goods and Services (Nice Classification) is followed. Application may not be made for alcoholic products in classes 32 and 33. A separate application has to be filed for each class of goods or services.

**Convention priority**

Although Libya is a member of the Paris Convention, the Law contains no express provision for the claiming of convention priority. However, in practice the filing date of an earlier filed foreign application can be claimed as the effective date, provided the application in Libya is filed within a six month period of such earlier filed foreign application.

**Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (legalised), in Arabic
- certificate of incorporation (if the applicant is a company; legalised), with an Arabic translation
- copy of a corresponding home registration (legalised; may be required)

- specimen of the trade mark
- list of goods and services to be covered.

**Examination/procedure**

Applications are examined for formal requirements, inherent registrability and for conflict with prior registrations and/or pending applications. Upon acceptance, the trade mark is published.

**Opposition**

The Law makes provision for the lodging of an opposition within the prescribed time limit, although the current regulations do not make provision for opposition proceedings. In practice, an interested party may oppose the registration of a mark within three months of its publication.

**Opposition proceedings**

Any person concerned may submit to the office a written notification of his objection to the registration of the trade mark together with the grounds of opposition. The office must serve on the applicant for registration a copy of the notification of objection. The applicant must submit to the office his written response to the objection within the term prescribed.

The opposition is heard by the Registrar of Trade Marks and, if the matter is not settled or a party is unhappy with the Registrar's decision, the matter may be referred to the Tribunal. The Law also makes provision for appeals to the Federal Supreme Court.

**Grounds of opposition**

The registration of a trade mark may be opposed on the ground that the mark is not registrable as a trade mark. The following marks shall not be registrable as trade marks:

- marks that contain no distinctive signs of authenticity, or which consist of signs or titles which are, by custom, assigned to the products themselves or to any ordinary drawing or picture thereof
- marks which are contrary to good morals or public order
- public emblems, official signs and stamps and imitations thereof, flags and other symbols of the State or of any other state dealing with Libya on a basis of reciprocity
- marks which are identical with or similar to symbols of a purely religious character
- symbols of the Red Crescent or the Red Cross or other similar symbols
- pictures or mottos of any other person, unless the use thereof is approved by him
- descriptions of honorary titles to which the applicant cannot prove his legal title
- marks which may mislead the public or which contain any misstatements about the origin or description of the products
- marks which contain a fictitious, imitative or forged commercial name.



**Duration and renewal**

A trade mark registration is valid for 10 years and, thereafter, renewable for like periods.

**Cancellation/removal of a trade mark**

A trade mark registration may be removed from the register by an order of court.

**Grounds for cancellation/removal of a trade mark**

The court of first instance may, upon the application of any person concerned, order the cancellation of a trade mark registration where it is satisfied that the trade mark in question has not been seriously used for five consecutive years, unless the proprietor of the marks shows a reasonable cause for non-use.

In addition, the trade marks office and any person concerned shall be entitled to apply for a judgment cancelling any marks which might have been unjustly registered (see the section on **Grounds of opposition** above).

The ownership of a trade mark cannot be placed in dispute where it has been used by the person who has registered it for a continuous period of at least five years from the date of registration, in the course of which period no claim against the registration has been judged to be valid.

**Use requirement**

To avoid a risk of cancellation on the ground of non-use, the owner must ensure that a period of five consecutive years does not elapse without the mark being seriously used, unless he can show reasonable cause for non-use (see the section on **Grounds for cancellation/removal of a trade mark** above).

**Assignment**

Assignment is permitted with the goodwill of the business. Recording is required in order to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (legalised), in Arabic
- deed of assignment (legalised), in Arabic or with verified Arabic translation
- certified copy of the certificate of incorporation of the assignee (legalised), with an Arabic translation.

**Licensing/registered users**

Licensing is recognised. Recording is required in order to be effective against third parties. The licence agreement must provide for quality control by the licensor.

Requirements for recordal:

- power of attorney from the proprietor (legalised), in Arabic
- power of attorney from the licensee (legalised), in Arabic
- licence agreement (legalised), in Arabic or with verified Arabic translation.

### **Amendment**

Provision is made for the amendment of a registered trade mark, provided that any modification or addition shall not amount to a substantial change of the mark.

### **Rights conferred by registration**

The registration of a trade mark confers on the owner the sole proprietorship of the mark. The owner is entitled to the exclusive use of the mark in regard to the goods for which it was registered, or to authorise use by other parties.

### **Trade mark infringement**

As indicated above, any person registering a trade mark shall be deemed to be the sole proprietor of such mark. The proprietor of the mark shall be entitled to exclusive use of the mark in relation to the products or goods for which it was registered. Any person who uses the mark without the consent of the owner commits an infringement.

### **Relief for trade mark infringement**

Both civil and criminal proceedings are possible. Seizure, confiscation and destruction of infringing goods, as well as damages, may be ordered.

The remedies available to the owner of a registered trade mark are also available to trade marks registered abroad which are entitled to protection in terms of international agreements to which Libya is a party.

The Law also provides for certain offences which include:

- counterfeiting a trade mark which has been registered, or imitating it in order to mislead the public, or using a counterfeited or forged trade mark
- using any trade mark owned by another person
- selling or offering for sale or circulation, or holding for sale, or importing into the country for commercial purposes a counterfeited or forged trade mark or any products carrying a counterfeited, forged or unlawful trade mark, or in any other way causing the circulation of the aforesaid trade mark or products.

The penalties upon conviction include a fine and imprisonment.

### **Defences to trade mark infringement**

No specific defences are provided for.

### **Common law rights**

No provision.

**Marking of goods**

No provision.

**PATENTS****Law**

- Patents, Industrial Designs and Models Law no 8 of 1959

Libya is a member of the Paris Convention and of the PCT.

**Patent protection**

Patent protection is obtainable by way of a national application, which may be a non-convention or a convention application or a national phase application under the PCT. Patents of addition may be obtained for improvements or amendments to the principal patent.

Although the Law in Libya has not yet been amended to recognise the PCT, PCT applications are being accepted and processed by the patent office.

**Types of patents**

Provision is made for patents in respect of inventions that are new and industrially exploitable. Provision is also made for patents of addition in respect of amendments or improvements to the invention of the original patent.

**Patentable subject matter**

Any innovation that is industrially exploitable, whether it is related to new industrial products, new methods or industrial means or application of new methods for known industrial approaches or means, shall be patentable.

Patents shall not be granted for the following:

- inventions, exploitation of which may result in breach of morals or public order
- inventions related to foodstuffs, medicines or pharmaceutical preparations unless these products are made through special methods or chemical processes, in which case the patent shall be granted for the method of production rather than in respect of the products themselves.

**Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application, based on an international application under the PCT in which Libya is designated
- an application for a patent of addition in respect of improvements or amendments to the invention of an initial patent.

**Application**

Patent applications are filed at the Libyan Patent Office.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised), in Arabic
- deed of assignment (if applicable; legalised), in Arabic or with Arabic translation
- specification (including claims, drawings and abstract), in Arabic
- certified copy of the priority document (if applicable), with Arabic translation
- certificate of incorporation or extract from the commercial register for the applicant (legalised).

The Libyan Patent Office requires that all the above documents (with the exception of the priority document) must be submitted on the filing date. Some local agents are able to file without all the documents, but this is a practice concession and, as such, it can change at any stage and should not be relied on.

If the certified copy of the priority document is not submitted before the three months deadline, the claim to priority will be abandoned and the application will proceed as a non-convention patent application.

**Applicant**

The inventor or his successor in title may apply for a patent. An assignment document is required if the applicant is not the inventor.

**Novelty**

Libya has local novelty requirements. The invention must not have been used in public or published in Libya during the preceding 50 years; or a patent must not have been granted in Libya for the same invention during the preceding 50 years.

Provision is made for provisional protection for patents disclosed at national or international exhibitions in Libya or in any country with which Libya has reciprocal rights.

**Inventiveness**

No express provision.

**Convention priority**

The Law is silent regarding the claiming of priority in terms of the Paris Convention as such. However, it does state that if an application for a patent is filed in a state which treats Libya on a reciprocal basis, the applicant may, within one year of the filing date of the first application, apply in Libya for a patent for the same invention. In such cases, the date of the first application shall be the priority date.

A certified copy of the priority document must be filed within three months of the filing date. If the priority document is not filed within the deadline, the priority claim will be lost.

### **Examination/procedure**

Applications for patents are subjected to both formal and substantive examination. The examination includes examination for novelty, sufficiency and clarity.

The patent office may require amendment of the application to comply with the requirements for patentability. If the applicant does not amend the application to overcome the objections raised by the patent office within six months, the application will be considered to be abandoned.

### **Publication**

Applications which meet the conditions for patentability and which comply with the formal requirements are published in the Patent Journal for purposes of opposition. If no opposition is filed, the patent will proceed to grant and the grant shall again be published in the Journal.

### **Opposition**

Any interested party may oppose the issuing of a patent by filing a notice of opposition within two months from the publication in the Journal.

No specific grounds of opposition are stipulated.

### **Duration and maintenance**

Subject to the exception regarding the duration of patents relating to foodstuffs, medicines and pharmaceutical preparations, the initial term of a patent is 15 years.

It is possible to obtain an extension of five years if the patentee can show that the invention is of 'unique importance' and that he did not make sufficient profits during the initial 15 year term.

The duration of patents relating to foodstuffs, medicines and pharmaceutical compositions is limited to 10 years and no extension of this term is available.

Maintenance fees are not payable on pending applications, but are payable annually after grant of the patent, on the anniversary of the filing date. A six month grace period is provided.

### **Restoration**

No provision is made for restoration.

### **Revocation**

Applications for revocation of a patent may be instituted by any interested party by filing an application for cancellation with the Supreme Federal Court. Grounds for revocation include lack of novelty and non-patentable subject matter, amongst others.

A patent may also be cancelled if the patented invention has not been used in Libya or in the country of origin within three years from the date of grant (see the section on **Working** below).

### **Assignments**

Patents can be assigned or mortgaged. The Law does not stipulate that assignments need to be in writing to be effective against third parties; however, this is advisable.

Requirements for recordal:

- power of attorney (legalised), in Arabic
- extract of the entry of the assignee company in the commercial register, or a copy of the certificate of incorporation (legalised), with Arabic translation
- deed of assignment (legalised), with verified Arabic translation.

### **Licences**

No express provision is made for voluntary licences.

### **Compulsory licences**

Provision is made for the granting of compulsory licences in the interests of national defence, or in the interests of the public, ie *pro bono publico*. The owner is entitled to fair compensation, and any grievances regarding decisions to grant compulsory licences shall be made to the Supreme Federal Court.

### **Amendments**

It is possible to amend a Libyan patent application at any stage prior to grant. Amendments must not go beyond the disclosure in the application as initially filed. After grant, amendments must be effected by way of a patent of addition.

### **Effect of a patent**

The registration of a patent grants the owner the right of exploiting the invention by any means. The owner also has the right to institute civil proceedings or initiate a criminal lawsuit against persons who infringe his rights.

The owner's right does not extend to the acts by any other party who commenced exploitation of the invention in good faith before the filing of the patent application.

### **Infringement**

The Law provides for civil and/or criminal sanctions for infringement of patents in Libya. Civil sanctions include fines, confiscation and destruction of infringing goods, and criminal sanctions include fines and/or imprisonment.

Specific provisions are made for precautionary measures to be taken prior to the filing of any proceedings (either civil or criminal). Such precautionary measures may include withholding infringing goods or any equipment which may be used to produce such goods. It is also possible to obtain an order preventing the importation of any such goods in anticipation of litigation.

The court may order that the judgment must be advertised in a newspaper at the expense of the convicted party.

**Marking**

No provision.

**Working**

Working of the patent either in Libya or the 'country of origin' (ie the home country of the patentee) is compulsory. Failure to work the patent within three years from the date of grant leads to automatic cancellation of the patent.

It is possible to apply for an extension not exceeding two years to work the patent, if the patentee can show that the non-working occurred because of compelling circumstances.

**DESIGNS****Law**

- Patents, Industrial Designs and Models Law no 8 of 1959

Libya is a member of the Paris Convention.

**Design protection**

Design protection can be obtained via a national filing in Libya. Libya is a member of the Paris Convention, so that priority may be claimed.

**Registrable subject matter**

Any arrangement of lines and any shape, in colours or without colours, used for industrial production, whether manually or by a chemical means, shall be considered an industrial design or model.

**Classification of designs**

The Locarno Classification is not applied.

**Types of applications**

A design registration may be obtained by way of a national filing, in appropriate circumstances with a claim to priority.

**Application**

It is not possible to file a single application for multiple designs in Libya.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised), in Arabic
- extract of the entry of the applicant company in the commercial register, or copy of the certificate of incorporation (if the applicant is a company or a body corporate; legalised)
- deed of assignment from the author/creator (if applicable; legalised)
- certified copy of the priority document (if applicable; legalised)
- representations of the design.

### **Applicant**

The author/creator or his assignee can apply for registration of an industrial design.

### **Convention priority**

The filing date of an earlier foreign application can be claimed as the effective date, provided the application in Libya is filed within the six month period of such earlier filed foreign application.

### **Novelty**

A design is new if it has not been published or used in Libya during the preceding 50 years. A six month grace period preceding the filing date or priority date is provided for disclosure of the design at an officially recognised exhibition in Libya, or by publication or use of the design in Libya for which application was filed by a foreigner in a country with which Libya has reciprocal arrangement, or in an International Union country.

### **Examination/procedure**

The designs office may reject the application on the grounds that the application contravenes the requirements of the Law and Regulations, or that the design is contrary to public order or morality. Rejections by the designs office may be appealed within one month of notification thereof to a special committee, with a further appeal possible to the Union High Court within sixty days of the committee's decision.

### **Opposition**

Provision is made for filing opposition after registration, on the basis that the applicant was not the true owner of the design.

### **Duration and maintenance**

The initial term of the design registration is five years. This is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration. Renewal fees can only be paid in the final year of each five year period.

### **Restoration**

The Law does not make any provision for restoration if the renewal fees are not paid.



**Revocation**

A general reference is made in the Law to the possibility of challenging a design registration on the basis of its true ownership.

**Assignments and licences**

Assignments and licences must be recorded in the register and published in accordance with the Regulations in order to be enforceable against third parties.

Requirements for recordal:

- power of attorney (legalised), in Arabic
- copy of the certificate of incorporation or extract of the entry of the assignee company in the commercial register (legalised)
- deed of assignment or licence agreement (legalised).

**Compulsory licences**

No provisions.

**Infringement**

The Law provides for civil and/or criminal sanctions for infringement of industrial designs in Libya. Civil sanctions include fines, confiscation and destruction of infringing goods, and criminal sanctions include fines and/or imprisonment.

Specific provisions are made for precautionary measures to be taken prior to the filing of any proceedings (either civil or criminal). Such precautionary measures may include withholding infringing goods or any equipment which may be used to produce such goods. It is also possible to obtain an order preventing the importation of any such goods in anticipation of litigation.

The court may order that the judgment must be advertised in a newspaper at the expense of the convicted party.

**Marking**

No provision.

Falsely indicating that the design of an article is protected by registration is punishable by a fine and imprisonment, to seizure of the offending goods, and to an order of disposal of the goods by the court and their possible destruction.

**Working**

No provision.

## **COPYRIGHT**

### **Law**

- Copyright Protection Law no 9 of 1968

Libya is a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Law provides for copyright in respect of literary, artistic and scientific works, regardless of their type or method of expression, including:

- written works, such as books and other publications
- works of art, architecture, painting, drawing, sculpture, architecture, etc
- works conveyed verbally, such as lectures, addresses, sermons
- dramatic works and musical plays
- musical works
- photographic and cinematic works
- geographical maps and drawings
- three-dimensional works related to geography, topography or science
- eurhythmic and choreographic works
- works of applied art or craft
- works for broadcast by radio or television.

### **Exclusions from copyright**

Excluded from protection are:

- collections of verse, prose, music, etc
- collections of official documents, such as laws and regulations, decisions by courts, official documents.

### **Registration of copyright**

Registration of copyright is required. The person who registers a work in his name is considered to be the author, unless there is evidence to the contrary.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author must be a Libyan citizen or resident, or the work must have been first published in Libya. Since Libya is a member of the Berne Convention, copyright protection is extended to works eligible for protection under this Convention, or protected in another country which provides similar protection to Libyan authors.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author.

**Duration of copyright**

Copyright generally endures for the lifetime of the author plus 25 years as regards the economic rights entailed therein, provided that the total period of protection shall not be less than 50 years. The copyright in photographic and cinematic works endures for five years after the date of publication.

**Protection afforded by copyright**

Copyright confers on the copyright owner the exclusive right to publish the copyright work, to utilise the work financially, and to authorise the exploitation by others.

The financial utilisation rights include:

- conveying the work directly to the public by way of public recital or performance
- conveying the work indirectly to the public by making copies of the work available.

The author shall also have the exclusive right to be recognised as the author of the work, and to prevent changes to the work.

**Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed.

**PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Libya.

# MADAGASCAR

## GENERAL INFORMATION

The Republic of Madagascar is an independent state situated in the Indian Ocean off the south-east coast of Africa, separated from the mainland by the Mozambique Channel.



<b>Area:</b>	587 041 km <sup>2</sup> (fourth largest Island in the world)
<b>Population:</b>	21.3 million
<b>Capital:</b>	Antananarivo
<b>Currency:</b>	Malagasy Franc
<b>GDP:</b>	\$ 20.7 billion (2010)
<b>Internet domain:</b>	.mg
<b>Languages:</b>	French, Malagasy (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; vanilla; cloves and clove oils; sugar; petroleum products; shellfish
<b>Imports:</b>	Intermediate manufactures; capital goods; petroleum; consumer goods; food

## International/regional conventions

Madagascar is a member of the following international agreements:

- Berne Convention (since 1966)
- Madrid Protocol on Marks (since 2008)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1989)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

Patents

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

Designs

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

## Copyright

- Law no 94-036 of 1995, on Literary and Artistic Property
- Decree no 98-435 of 1998, on General Rules for the collection of Copyright and Neighbouring Rights
- Decree no 90-260 of 1990, modifying the provisions of Decree no 84-389 of 1984, establishing the Malagasy Copyright Office (OMDA)
- Decree no 84-390 of 1984, on Regulation of Copyright royalties

## TRADE MARKS

### Law

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

Madagascar is a member of the Paris Convention, the Madrid Protocol and the WTO/TRIPS.

### Trade mark protection

Trade mark applications may be filed as national applications, in appropriate circumstances claiming convention priority in terms of the Paris Convention, or the country may be designated in international applications filed in terms of the Madrid Protocol.

Provision is made for the registration of trade marks for goods and for services, and for collective marks.

### Protection of well-known marks

No express provision is made for the protection of well-known marks.

### Advantages of trade mark registration

The registration of a trade mark confers on the owner the right to prohibit others from making commercial use of the mark (see the section on **Rights conferred by registration** below).

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- collective marks.

### Definition of a trade mark

A mark is defined to mean any visible sign intended and capable of distinguishing the goods or services of one enterprise from those of other enterprises. This definition is open ended and is in turn defined to include surnames, special, arbitrary or fancy denominations, the characteristic form of a product or of its wrapped presentation, labels, envelopes, emblems, prints, stamps, seals, colours, designs, reliefs, letters, devices, slogans,

pseudonyms and any materialised signs that are sufficiently distinctive for the use for which they are intended.

### **Definition of a collective trade mark**

A collective trade mark means any visible sign designated as a collective mark and capable of identifying the origin, quality, or any other common characteristic of goods or services of various enterprises which use the collective mark under the control of the owner.

### **Limitation to colour**

Colours may constitute a trade mark.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

Madagascar is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to claim a priority right to be accorded the same date as the first-filed application, provided that the application is filed in Madagascar within six months.

### **Application**

An application is filed at the Malagasy Office of Industrial Property in French or Malagasy with a French translation.

The following information and documents are required:

- full particulars of the applicant
- power of attorney by the applicant (notarised), in French
- list of goods or services to be covered
- electronic print of the mark
- certified copy of the priority document (if applicable), in French.

### **Examination/procedure**

Prior to registration, the application will be subjected to an administrative and substantive examination. If the application meets the formal and substantive requirements for registration, it shall proceed to registration. Notification of grant will be published in the Official Gazette of Industrial Property.

### **Opposition**

It is not possible to oppose a trade mark application in Madagascar. It is, however, possible to apply to court to have a trade mark registration declared null and void (see the section on **Cancellation/removal of a trade mark** below).

### **Cancellation/removal of a trade mark**

In general, Madagascar follows a first-to-file system in respect of trade marks. This means that the first person to file for its registration, is the owner of a mark.

However, the competent court may, in certain situations and at the request of a competent authority or of any person proving a legitimate interest, and after having given the owner an opportunity to be heard, declare null and void the registration of a mark with effect from the date of registration.

If, however, a registered mark has been used publicly and continuously by the owner of the registration in Madagascar for at least three years without having given rise to legal action that has been upheld, the mark shall belong to the owner of the registration without possible opposition on the grounds of prior use by another person, unless it is proved that at the time of filing the applicant could not have been unaware of such other person's mark.

### **Grounds for cancellation**

The grounds for cancellation include:

- that the mark does not fulfil the definition of a trade mark, ie does not consist of a visible sign intended and capable of distinguishing the goods or services of one enterprise from those of other enterprises
- that use of the sign is contrary to public policy or morality and, in particular, is liable to deceive trade circles or the public as to the nature, the source, the manufacturing process, the characteristics or the suitability for their purpose, of the goods or services concerned
- that the sign reproduces or imitates the armorial bearings, flags and other emblems, official signs or hallmarks adopted by a state, or initials, names or abbreviations of names of any state or of any intergovernmental international organisation, without the authorisation of such a state or organisation
- that the sign is incapable of distinguishing, particularly where:
  - the sign consists of the shape of the goods concerned or of their packaging and such form is imposed by the inherent nature or function of the goods or of their packaging
  - the sign consists exclusively of an indication which may serve, in the course of trade, to designate the kind, quantity, quality, intended purpose, value, time of production or of supply or other characteristics of the goods or services
  - the sign consists exclusively of an indication which has become, in the current language or in the *bona fide* and established practices of local trade, a customary designation of the goods or services concerned
- that the sign consists of a geographical indication liable to mislead as to the geographical origin of the goods and services concerned or which, if it were registered as a mark, would unduly interfere with use of the geographical indication by other persons that are entitled to use such indication
- that the sign conflicts with a prior right:

- where a mark belonging to a party or a collective mark is the subject of a registration or of a pending application and another party files an application for registration as a mark, for identical or similar goods or services, of a sign that is identical to the earlier mark, or similar to the extent of probable confusion, the latter sign is deemed to conflict with a prior right
- where the earlier mark has ceased to be registered one year at the most before the date on which the application is filed by the later party, or where the collective mark has ceased to be registered five years at most before such date.

Where the grounds of nullity apply to only one class of goods or services, or to certain goods within a certain class, nullity of the registration shall be declared for that part of the goods or services only.

In addition, the property right in a mark shall lapse for failure to use the mark within a period of three years as from the date of registration, unless the owner of the mark is able to produce legitimate reasons for his failure to use the mark (see the section on **Use requirement** below).

Furthermore, any person who has allowed his mark to fall into the public domain or become everyday language without having taken measures to prevent abuse, shall forego his rights in that mark.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the date of filing, and is thereafter renewable for like periods subject to payment of the prescribed fee. Late renewal is possible within a grace period of six months, subject to payment of a penalty fee.

### **Use requirement**

A trade mark registration shall lapse if the registered mark is not used within a period of three years from the date of registration, unless the owner of the mark is able to produce legitimate reasons for his failure to use the mark.

### **Assignment**

Assignments of trade marks are possible and may be made with or without the goodwill of the business, and in respect of some or all of the goods or services covered by the registration. An assignment must be in writing and recorded in the register in order to be enforceable against third parties.

Requirements for recordal:

- the assignment must be in accordance with the prescribed form
- power of attorney (notarised) copy of the authentic instrument of assignment or transfer bearing the signatures of the parties to the contract (notarised), accompanied by a translation into either in Malagasy or French
- approval by the government.



**Licensing/registered users**

Voluntary licensing of a trade mark is recognised. A licence agreement must be in written form and must be signed by the parties, failing which it shall be null and void.

A licence agreement may be recorded on payment of the prescribed fee. No person may rely on the fact that he or she did not have knowledge of a recorded licence agreement.

Requirements for recordal:

- the agreement must be in accordance with the prescribed form
- power of attorney (notarised)
- copy of the licensing contract duly signed by the parties (notarised), accompanied by a translation into either Malagasy or French
- approval by the government.

**Amendment**

No express provision.

**Rights conferred by registration**

In terms of the Ordinance, the registration of a trade mark shall afford its owner the right to prohibit others from carrying out the following acts:

- any commercial use of the mark or sign or of a trade name resembling it in such a way as to mislead the public, for goods or services for which the mark is registered or for other goods or services for which use of the mark or sign could mislead the public
- any other use of the mark or of a sign or a trade name resembling it, without just cause and under conditions likely to be prejudicial to the owner of the mark.

**Trade mark infringement**

Any person who, without the authority of the trade mark owner, makes any commercial use of the registered mark, or a mark so closely resembling it as to mislead the public, on identical or similar goods, commits an infringement. Any infringement of the rights under a mark constitutes an offence.

**Defences to trade mark infringement**

Registration of a mark shall not afford to its owner:

- the right to prohibit others from using in good faith their names, addresses, pseudonyms, geographical names, or accurate statements about the type, quality, quantity, purpose, value, standards, place, origin or period of production of their goods or the provision of their services on condition that the use is limited to the purpose of simple identification or information and does not mislead the public as to the source of the goods or services
- the right to prohibit others from using the mark in relation to goods lawfully sold by the trade mark owner or a licensee in the country under that mark, provided that such goods have not undergone any change
- the right to prohibit the publication of specific studies or of comparative tests of goods or services of various brands for the use of consumers.

**Relief for trade mark infringement**

Both civil and criminal proceedings are possible. Any infringement of the rights under a mark shall constitute an offence punishable by imprisonment and a fine. Seizure and confiscation of infringing articles can be ordered by the court, as well as damages.

**Common law rights**

Common law rights do not appear to be recognised. The Ordinance provides that no person may claim an exclusive right in a mark unless a valid application has been filed.

**Marking of goods**

Products carrying the trademark can be marked and products destined for Madagascar should contain indications of the country of origin.

**PATENTS****Law**

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

Madagascar is a member of the Paris Convention, the PCT and the WTO/TRIPS.

**Patent protection**

Patent protection is available via a national filing. Patent protection may also be obtained by way of a national phase application based on an international application under the PCT designating Madagascar.

**Types of patents**

Provision is made for:

- conventional patents in respect of inventions that are new, inventive, and capable of industrial application
- inventors' certificates, where the right to exploit an invention belongs to the State
- certificates of addition, in respect of improvements to an existing patent or inventor's certificate
- divisional patents, where the original application comprises more than one invention.

**Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- inventions contrary to public policy or morality
- plant or animal varieties or essentially biological processes for the production of plants or animals

- software
- methods, systems, schemes, discoveries and scientific theories and abstractions of pure form that do not solve a material problem or do not provide a tangible technical solution
- pharmaceutical, veterinary, cosmetic and food products
- inventions excluded by decree, where required by vital national interests of education, public health, national defence, or national economy.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Madagascar is designated
- an application for a certificate of addition, to cover improvements or amendments to the invention of the original patent
- a divisional application, where the original application covers more than one invention.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised)
- assignment from the inventors, or a statement by the applicant justifying its right to the invention (if applicable)
- declaration of priority rights
- specification (including claims, drawings and abstract), in French
- certified copy of the priority document (if applicable), with a verified French.

Failure to file the priority document within the stipulated time period will lead to the lapsing of the priority claim.

### **Applicant**

The inventor or his successor in title may file an application. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it does not form part of the state of the art. The state of the art comprises everything made available to the public, at any place or at any time, by means of written or oral description, by use or in any way, prior to the filing or priority date.

### **Certain prior knowledge or publication excused**

A grace period of six months immediately preceding the Madagascar filing date or priority date (if convention priority is claimed) is provided, where disclosure of the invention was made by the inventor or his successor at an officially recognised exhibition on national territory or in the member countries of the Paris Convention.

### **Inventiveness**

An invention involves an inventive step if it is not obviously derived from the state of the art or from the normal skill of a person of the art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Madagascar is filed within 12 months from the earlier application.

A certified copy of the priority application has to be filed within six months of the filing date or the claim to priority will be lost.

### **Examination/procedure**

Formal examination of an application takes place to determine whether or not all the formal (ie documentary) requirements have been satisfied. Once all the documentary requirements have been satisfied, the application is subjected to a patentability examination.

### **Opposition**

The Ordinance does not provide for opposition to the grant of a patent by third parties.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant the patent. According to the Ordinance, granted patents are published in the Official Gazette.

### **Duration and maintenance**

The duration of a patent is 15 years, extendible for a further five years if the national interest so demands and the invention is worked in a serious and satisfactory manner. Maintenance fees are payable annually from the filing date for pending applications and granted patents. A six months grace period is provided, subject to payment of a penalty.

### **Restoration**

Any person who, for reason of *force majeure*, has been unable to comply with the time limits stipulated in the Ordinance, may request restoration of the rights lost, provided he furnishes proof to justify his failure to comply.

**Revocation**

Revocation is possible by a competent judicial authority on application by an interested person or the public prosecutor, although no grounds for revocation are set out in the Ordinance.

**Assignments and licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment or licence contract (original or certified copy), with translation in Malagasy or French.

**Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

The State may also obtain a licence to work an invention for reasons of public interest.

**Amendments**

Amendments can be made at any time prior to grant, but may not go beyond the disclosure of the invention in the application as filed.

**Effect of a patent**

A patent affords the holder the right to prohibit others from carrying out the following acts:

- manufacturing, importing, offering for sale, selling or using the patented product
- holding the product for purposes of sale
- using a patented process, or carrying out any of the above acts in respect of a product of the patented process .

The rights granted to the patentee extend only to acts carried out for industrial or commercial purposes. Anyone who, in good faith, commenced manufacturing the product or using the process before the filing date or priority date of the patent shall have the right to continue carrying out such acts.

**Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Civil remedies could include damages, seizure and confiscation of the infringing products. Criminal sanctions include a fine, and a term of imprisonment.

**Marking**

No requirement.

**Working**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, the competent court may grant a compulsory licence on the ground that the patented invention has not been worked or has been insufficiently worked, or the patentee refuses to grant licences under reasonable conditions, or working of the patented invention within the country does not satisfy the reasonable demand for the product. A compulsory licence will not be granted if the patentee can give legitimate reasons for the lack of working.

**DESIGNS****Law**

- Ordinance no 89-019 of 1989, Establishing Arrangements for the Protection of Industrial Property in Madagascar
- Decree no 92-993 of 1992, Implementing Ordinance no 89-019 of 1989, as amended by Decree no 95-057 of 1995

Madagascar is a member of the Paris Convention and the WTO/TRIPS.

**Design protection**

Design protection is available by way of a national filing.

**Registrable subject matter**

An industrial design means any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours. Such lines or colours are required to give a special appearance to a product of industry or handicraft and be able to serve as a pattern for a product of industry or handicraft. Those elements which serve to obtain a technical result and leave no freedom as regards arbitrary features of appearance, shall not enjoy protection.

**Classification of designs**

It is not clear whether the Locarno International Classification is applied.

**Types of applications**

An application can be filed as a non-convention application, or it can claim priority from an earlier application in a convention country.

**Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Foreign applicants must have a local address for service. An application filed in Madagascar may contain only one industrial design.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised)
- assignment document (if applicable)

- drawings, photographs or other graphic reproductions of the article embodying the design
- description of the design
- certified copy of priority document (if applicable), with verified French translation.

**Applicant**

The author or creator or his assignee may apply for registration.

**Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Madagascar is filed within six months from the earlier application.

A certified copy of the priority application has to be filed within three months of the filing date or the claim to priority will be lost.

**Novelty**

A regular application for registration of an industrial design shall raise a presumption that the design was original and new at the time of application. A design shall not be deemed to be new solely because it has unimportant differences in relation to earlier designs, or it applies to goods of a different type.

A grace period of six months preceding the filing date is provided, during which publicity of the design in the national territory will be excused.

**Examination/procedure**

Formal examination of an application takes place. The application is also subjected to substantive examination.

**Opposition**

The Ordinance does not provide for opposition to the registration of a design by third parties.

**Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration. A six months grace period is provided for late payment of the renewal fees.

**Restoration**

The Ordinance provides that any person who, for reasons of *force majeure*, has been unable to comply with time limits and so loses any right, may request restoration of such right if he furnishes proof to justify his failure to comply.

### **Revocation**

Any competent authority or any person with a legitimate interest may appeal to a competent court against any final decision in regard to a design; this would include a decision to grant a design registration.

### **Assignments and licences**

The right to a design may be transferred or licensed. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment or licence contract (original or certified copies), with translation in Malagasy or French.

### **Compulsory licences**

No provision is made for compulsory licences for designs in Madagascar.

### **Effect of a design registration**

The registration of a design affords the owner (or his successor in title) the right to prohibit others from carrying out the following acts:

- the slavish reproduction or fraudulent imitation of the design in the manufacture of a product
- the importation, offering for sale or selling a product reproducing the protected design
- the holding of such product for purposes of sale.

Reproductions intended for personal or domestic use do not constitute infringement.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Civil remedies could include damages, seizure and confiscation of the infringing products. Criminal sanctions include a fine, and a term of imprisonment.

### **Marking**

No requirement.

### **Working**

No requirements.



## COPYRIGHT

### Law

- Law no 94-036 of 1995, on Literary and Artistic Property
- Decree no 98-435 of 1998, on General Rules for the collection of Copyright and Neighbouring Rights
- Decree no 90-260 of 1990, modifying the provisions of Decree no 84-389 of 1984, establishing the Malagasy Copyright Office (OMDA)
- Decree no 84-390 of 1984, on Regulation of Copyright royalties

Madagascar is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

The law provides for copyright in respect of all intellectual works, whatever their genre, form of expression or merit, including:

- books, brochures and other literary, artistic and scientific writings
- lectures, speeches, addresses, sermons
- dramatic and dramatico-musical works
- choreographic works, pantomimes
- musical works
- cinematographic and audiovisual works
- works of art, architecture, painting, drawing, sculpture, etc
- graphic and typographic works
- photographic works
- works of applied art or craft
- illustrations and geographical maps
- plans, sketches and plastic works relating to geography, topography, architecture
- software programs
- works of folklore
- translations, adaptations, arrangements of works
- databases or compilations of data.

### Registration of copyright

No requirement for registration.

### Requirements for subsistence of copyright

There is no express requirement that the author must be a citizen or resident of Madagascar or the work must have been first published in Madagascar. Since Madagascar is a member of the Berne Convention, copyright protection is extended to works eligible under such treaty.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. The copyright includes the moral rights (namely the right to claim authorship and to be recognised as the author), and proprietary rights (namely the right to exploit the copyright work in tangible and intangible form).

### **Duration of copyright**

Copyright generally endures for the lifetime of the author plus 70 years as regards the economic rights entailed therein. The copyright in a computer program endures for 20 years.

### **Protection afforded by copyright**

The proprietary rights inherent in copyright confer on the copyright owner the exclusive right to use and exploit the copyright work, and to authorise the use and exploitation by others. These rights include:

- performance of the work, eg by public performance or broadcast
- communication of the work to the public
- reproduction of the work
- distribution of copies of the work.

Reproduction of a work exclusively for the private use of the user is excluded in certain circumstances; likewise the use for teaching, parody, by way of quotation, reporting as news, etc.

### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Madagascar.

# MALAWI

## GENERAL INFORMATION

Malawi is a landlocked country in the south-western region of Central Africa, with Zambia to the west, Tanzania to the north and east, and Mozambique to the south and east. Lake Malawi forms most of Malawi's eastern boundary.



<b>Area:</b>	118 484 km <sup>2</sup>
<b>Population:</b>	15.4 million
<b>Capital:</b>	Lilongwe
<b>Currency:</b>	Malawian Kwacha
<b>GDP:</b>	\$13.5 billion (2010)
<b>Internet domain:</b>	.mw
<b>Languages:</b>	English, Chichewa (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Tobacco; tea; sugar; coffee; peanuts; wood products; cotton; clothing apparel
<b>Imports:</b>	Food; petroleum products; semi-manufactures; consumer goods; transportation equipment

## International/regional conventions

Malawi is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1997)
- Berne Convention (since 1991)
- Harare Protocol (of ARIPO) (since 1984)
- Locarno Agreement on Classification of Designs (since 1995)
- Lusaka Agreement (ARIPO) (since 1978)
- Nice Agreement on Classification of Marks (since 1995)
- Paris Convention (since 1964)
- Patent Cooperation Treaty (since 1978)
- Strasbourg Agreement on Patent Classification (since 1996)
- WIPO Convention (since 1970)
- WTO/TRIPS (since 1995)

## IP legislation

### Trade marks

- Trade Marks Act of 1967, Chapter 49:01
- Trade Mark Regulations, 1981
- Merchandise Marks Act of 1966, Chapter 49:04

### Patents

- Patents Act of 1986, Chapter 49:02
- Patents Regulations, 1992

### Designs

- Registered Designs Act of 1985, Chapter 49:05
- Registered Designs Regulations, 1997

### Copyright

- Copyright Act of 1989, Chapter 49:03
- Copyright (Production, Importation and Distribution of Sound and Audio Visual Recordings) Licensing Regulations, 2007

## TRADE MARKS

### Law

- Trade Marks Act of 1967, Chapter 49:01
- Trade Mark Regulations, 1981
- Merchandise Marks Act of 1966, Chapter 49:04

Malawi is a member of the Paris Convention, the Nice Agreement, and the Banjul Protocol of ARIPO, and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods (Part A or B of the register), for certification marks (Part C), and for defensive trade marks (Part D).

### Protection of well-known marks

The protection extended by the Act to well-known trade marks forms the basis of the registration of defensive marks. Where a trade mark has become so well known in relation to certain goods, that the use of the same mark in relation to other goods would be likely to be taken as indicating a connection in the course of trade with the owner of the well-known mark, the owner of the well-known mark can register the mark in respect of such other goods in Part D of the register as a defensive mark, even though he does not intend using the mark in regard to such other goods.

### Advantages of trade mark registration

The Act provides that no person shall be entitled to institute proceedings to prevent, or to recover damages for, the infringement of an unregistered mark. However, actions for passing off shall not be affected.

### Types of trade marks

The following types of trade marks are registrable:

- trade marks for goods
- certification trade marks
- defensive trade marks.

### Definition of a mark

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

### Definition of a trade mark

A trade mark is defined to mean a mark used or proposed to be used in relation to goods for the purpose of indicating a connection in the course of trade with a person having the right to use the mark, with or without an indication of the identity of that person.

**Definition of a certification trade mark**

A certification mark is a mark to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, etc from goods not so certified. A certification mark is registrable in Part C of the register.

**Limitation to colour**

There is no express provision in regard to colours. The use of colours is permitted in practice.

**Classification**

The Nice International Classification of Goods is applied (there is no provision for services). A separate application is required for each class of goods.

**Convention priority**

Provision is made for priority claims, as Malawi is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the first filed application, provided the application is filed within six months of such earlier filing date.

**Application**

An application is made to the Malawian Trade Marks Office.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic print of the mark
- list of the goods
- certified copy of the priority document (where applicable), with a certified English translation.

**Examination/procedure**

Applications are examined as to formal requirements as well as on relative and substantive grounds. Once accepted, the application is advertised in the Official Patents and Trade Marks Journal and in the absence of opposition, the registration certificate is issued.

**Opposition**

Any interested person may, within two months of advertisement, enter opposition against the trade mark application. Extensions of this period of two months at a time can be obtained.

**Opposition proceedings**

A notice of opposition must include a statement of the grounds upon which the opponent objects to the registration. The Registrar of Trade Marks serves the notice of opposition on the applicant who then has two months to file a counter-statement.

Within two months of receipt of the applicant's counter-statement, the opponent must file evidence in support of the opposition. If the opponent does not file the evidence within the prescribed time period, the opposition is deemed to have been abandoned.

Within two months after the opponent's evidence, the applicant must file his answering evidence. If he fails to do so, the application is deemed to have been abandoned. Within two months of the filing of the applicant's answering evidence, the opponent may file evidence in reply.

The Registrar of Trade Marks will then hear the parties, if appropriate, or otherwise consider the opposition.

### **Grounds for opposition**

A mark may be opposed on both relative and absolute grounds, including:

- that it does not fulfil the definition of a trade mark
- that it is not capable of distinguishing
- that the use of the trade mark would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice
- that the mark is contrary to law or morality or incorporates any scandalous design
- that it is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same description of goods, or which so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

### **Duration and renewal**

The registration is valid for an initial period of seven years and thereafter renewable for further periods of 14 years. Late renewal is possible within a six month grace period, subject to payment of a penalty fee.

### **Cancellation/removal of a trade mark**

A registered trade mark may be removed from the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Tribunal (which is the Patents Tribunal established under the Patents Act) or the Registrar of Trade Marks.

### **Grounds for cancellation/removal of a trade mark**

A registered trade mark may be cancelled on the following grounds:

- that the trade mark was registered without any *bona fide* intention on the part of the applicant that it should be used in relation to those goods and that there has in fact been no *bona fide* use thereof up to a month before the application
- that up to a date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods by the proprietor of the trade mark

- that it is an entry wrongly made or wrongly remaining on the register (see the section on **Grounds of opposition** above)
- that it is an entry wrongly remaining on the register by virtue of the fact that the trade mark consists solely of a word or words which has become the name or description of an article or substance used by persons in the trade.

### **Use requirement**

A registered trade mark may be taken off the register if it was registered without any *bona fide* intention of using it in respect of the specified goods and there has in fact been no *bona fide* use of the mark up to one month before the date of the application for cancellation.

A registered trade mark may also be removed if there was no *bona fide* use of the mark by the proprietor for a continuous period of five years, unless the proprietor can show that the non-use was due to special circumstances in the trade and not to any intention on his part not to use the mark.

### **Assignment**

A registered trade mark can be assigned with or without the goodwill of the business, and in relation to all of the goods for which it is registered, or some of the goods.

Requirements for recordal:

- power of attorney from assignee (simply signed)
- deed of assignment or a notarially certified copy.

### **Licensing/registered users**

A person other than the proprietor of a trade mark registered in either Part A or Part B of the register may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered. The use of a trade mark by a registered user thereof in relation to goods in respect of which the trade mark remains registered, is referred to as 'permitted use'.

Requirements for recordal:

- powers of attorney from proprietor and user (simply signed)
- registered user agreement
- statutory declaration and statement of case.

### **Amendment**

A trade mark registration may be amended either by:

- correcting any error in the name, address or description of the proprietor
- entering a disclaimer
- entering any change in the name, address or description of the proprietor
- striking out any goods or classes or goods from those in respect of which a trade mark is registered
- cancelling the entry of the trade mark.

Requirements for amendment:

- power of attorney (simply signed)
- supporting documents.

### **Rights conferred by registration**

The valid registration of a trade mark gives to the proprietor the exclusive right to the use of the trade mark in relation to the goods covered by the registration.

### **Trade mark infringement**

The rights conferred by registration shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, uses a mark that is identical with the registered trade mark, or which so nearly resembles it as to be likely to deceive or cause confusion, in the course of trade in relation to goods in respect of which it is registered and in such a manner as to render the use of the mark likely to be taken either:

- as being used as a trade mark, or
- in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as referring to some person having the right either as proprietor or as registered user of the trade mark; or to goods to which the person as aforesaid is connected in the course of trade.

### **Defences to trade mark infringement**

Several defences are provided for in the legislation; these include:

- use of the registered trade mark in relation to goods connected in the course of trade with the proprietor or registered user of the trade mark or where the proprietor or registered user has expressly or impliedly consented to the use
- use of the registered trade mark in relation to goods adapted to form part of, or be accessory to, the proprietor's goods, provided the use is necessary to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the trade mark is to indicate a connection in the course of trade
- use of a trade mark which, although identical or confusingly similar to the registered trade mark, is separately registered
- continuous use of the mark from a date anterior to the use of the registered trade mark or its registration, whichever is the earlier
- *bona fide* use by a person of his or his predecessors' own name or the name of his place of business
- use of a *bona fide* description of the character or quality of a person's goods.

### **Relief for trade mark infringement**

An interdict (injunction) and damages may be obtained from the High Court.



### **Common law rights**

Common law rights are recognised, ie that a person who has acquired a reputation in a mark may prevent others from misrepresenting that they are associated with the proprietor in a manner that is likely to cause confusion and deception and damage to the person with a reputation (passing-off). This right is expressly recognised by the Act which states that no person shall be entitled to institute any proceedings to prevent or recover damages for the infringement of a trade mark that is not registered but the Act shall not affect the right of action for passing-off.

The Act also provides that the owner of a registered trade mark shall not be entitled to interfere with the use by any person of a mark identical or resembling the registered mark, where such person (or his predecessor in title) has continuously used that mark from a date prior to the registration of the mark or the use by the owner of the registered mark. Vested rights are thus protected.

### **Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation or the symbol ® is optional.

Imported goods that contain reference to any town, place, district or country must be marked with the country of origin. There are also regulations dealing with marks of origin on goods bearing the name of a firm or town in Malawi, and there are prohibitions on goods bearing unauthorised emblems.

## **PATENTS**

### **Law**

- Patents Act of 1986, Chapter 49:02
- Patents Regulations, 1992

Malawi is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS. Malawi is also a member of the Strasbourg Agreement on the International Patent Classification.

### **Patent protection**

Patent protection is available by way of a national filing or via an ARIPO application designating Malawi. The Act expressly recognises the Harare Protocol of ARIPO and provides that a patent granted under the Protocol (and designating Malawi) shall have effect in Malawi as if it were granted under the Act. It would appear, therefore, that valid patent protection could be obtained via an ARIPO application designating Malawi.

However, Malawi has not yet promulgated regulations to implement the Harare Protocol. Accordingly, there is uncertainty regarding the enforceability of rights obtained through the filing of an ARIPO application designating Malawi.

Malawi has not yet amended its laws to provide for the PCT. Accordingly, it is not certain whether valid patent protection can be obtained via a PCT national phase application in Malawi.

### **Types of patents**

The Act provides for patents for inventions that are new, inventive and industrially applicable, and for patents of addition in respect of modifications or improvements of the original invention.

### **Patentable subject matter**

An invention means any new and useful art (whether producing a physical effect or not), process, machine manufacture or composition of matter which is not obvious and which is industrially applicable, or any new and useful improvement thereof.

The following are not patentable:

- applications for inventions that are frivolous
- applications for inventions that are contrary to law or morality
- applications which claim as an invention a substance capable of being used as food or medicine which is a mixture of known ingredients, or applications which claim as an invention a process producing such a substance by mere admixture.

### **Types of applications**

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Malawi is designated
- an ARIPO application designating Malawi
- an application for a patent of addition, to cover improvements or amendments to the invention of the original patent.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Malawi Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventors, or a statement by the applicant justifying its right to the invention (where applicable)
- copy of the specification (including claims, drawings and abstract) in English
- certified copy of the priority document (if applicable).

Foreign applicants must be represented by an agent.

### **Applicant**

The inventor or his successor in title may apply for a patent. An assignment document is required if the applicant is not the inventor.

### **Novelty**

An invention is new if, before the filing date or the priority date, the invention was not –

- known or used anywhere in Malawi by anyone other than the applicant or the person from whom such applicant has derived his right or title (secret knowledge or secret user otherwise than on a commercial scale being excluded)
- worked anywhere in Malawi otherwise than by way of reasonable technical trial or experiment by the applicant or any person from whom such applicant has derived his right or title.
- described in a patent specification available to public inspection and bearing a date less than 50 years prior to the effective date of the application
- described in writing in any publication of which there was a copy anywhere in Malawi at the effective date of the application, or in a publication printed and published outside Malawi less than 50 years prior to such date;
- claimed in any complete specification for a patent which, though not available to public inspection at the effective date of the application, was deposited pursuant to an application which will be of prior date to the date of the application.

Novelty of an invention is not destroyed by disclosure prior to the filing date of the application or convention priority date without the patentee's knowledge or consent, provided that the matter disclosed was derived or obtained from the patentee; or if the invention had been used by the patentee or his predecessor in title in Malawi, prior to the filing date or priority date, purely for the purpose of reasonable technical trial thereof, provided that the application was filed with reasonable diligence after learning of the disclosure or after the trial or experiment.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application is filed within 12 months from the earlier application.

### **Examination/procedure**

Applications are subjected to formal examination. The Act also makes provision for applications to be examined to ensure that the subject matter is substantially similar to the subject matter of the priority application (if priority is claimed).

## **Opposition**

The Act makes provision for the filing of opposition within three months of publication of the acceptance of the application. It is possible to file an opposition after this period has expired as long as the patent has not yet been granted, but the consent of the applicant must be obtained in such a case.

Grounds for opposition include (amongst others) that:

- the applicant was not entitled to make the application
- the application is in fraud of another person's rights
- the invention is not an invention as defined
- the invention lacks novelty or inventiveness
- the invention is not useful
- the claims do not clearly define the subject matter claimed
- the specification does not fully describe the invention
- the application contains a material misrepresentation.

## **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met he shall publish the patent for opposition purposes. Assuming no opposition is entered, the patent shall proceed to grant within a maximum period of 22 months from the date of filing in Malawi.

## **Duration and maintenance**

The term of a patent obtained in terms of Malawi's national legislation is 16 years. Annual renewal fees are payable but are due as from the third anniversary of the filing date and are only payable after sealing. A six month grace period is available.

However, the Harare Protocol states that term of an ARIPO patent designating Malawi is 20 years. This issue has not been tested in the courts. Accordingly, the duration of an ARIPO patent designating Malawi is uncertain.

The Act further provides for the term of the patent to be extended for a maximum period of 10 years on the basis of inadequate remuneration. The application for the extension of the term of the patent must be made before expiry of the main patent and must be advertised for opposition purposes.

## **Restoration**

Provision is made for the restoration of a patent if the annual renewal fees are not paid timeously. Applications for restoration are advertised in the Journal for purposes of opposition. An order for restoration shall contain provisions to protect the rights of persons who availed themselves of the patented invention after the lapse of the patent.

## **Revocation**

Any interested person may request the Patents Tribunal to invalidate a patent on any of the grounds on which the grant of the patent may have been opposed (see the section on **Opposition** above).

### **Assignments and licences**

Assignments and voluntary licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney from assignee or licensor (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Amendments**

Amendments are allowed but should be made prior to acceptance. If the application has already been accepted, then the specification can only be amended by way of a disclaimer, correction or explanation but any amendment shall not go beyond the disclosure of the invention in the application as filed. A request for amendment of an accepted complete specification shall be published for purposes of opposition, and no amendment of a patent which is the subject of any infringement or revocation proceedings is allowed.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below). In order to obtain a compulsory licence, an applicant must show that the reasonable requirements of the public have not been satisfied. The Act sets out different circumstances in which the reasonable requirements will be deemed not to have been met.

### **Effect of a patent**

The effect of a patent shall be to grant to the patentee full power, sole privilege and authority, by himself or through his agents or licensees, to make, use, exercise and sell the patented invention within Malawi, so that he shall have and enjoy the profit and advantage accruing by reason of the invention.

### **Infringement**

The exploitation of the patented invention in Malawi by any person other than the patentee or a licensee shall be considered an infringement of the patent. Proceedings for infringement are initiated in the High Court and remedies include an interdict and damages, although no damages can be claimed for infringing acts prior to the date of publication of the acceptance of the application in the Journal.

### **Working**

Working is required within a period of four years from the date of filing, or three years from the grant of the patent, whichever occurs later. Failure to work the patent may lead to the granting of a non-exclusive, compulsory licence to interested third parties.

## DESIGNS

### Law

- Registered Designs Act of 1985, Chapter 49:05
- Registered Designs Regulations, 1997

Malawi is a member of the Paris Convention, ARIPO (Harare Protocol), the Locarno Agreement on Classification of Designs and the WTO/TRIPS.

### Design protection

Design protection is available by way of a national filing or via an ARIPO application designating Malawi. The Harare Protocol is recognised in the Act, and there is a provision that a design registered under the Protocol shall have effect in Malawi as if it were a design registered under the Act. However, Malawi has not fully implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws. Accordingly, it is unclear whether any valid rights would be obtained by way of an ARIPO design registration designating Malawi.

### Registrable subject matter

An industrial design is defined to mean features of shape, configuration, pattern or ornamentation applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction, or features of shape or configuration which are dictated solely by the function which the article, to be made in that shape or configuration, has to perform.

### Classification

The Locarno International Classification of designs is not applied, although Malawi has acceded to Locarno. The Act does require the applicant to specify the articles to which the design will be applied.

### Application

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO Applications) can either be filed via the Malawi Designs Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must provide a local address for service and may be represented by an agent.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- statement justifying applicant's right to registration/assignment document
- suitable graphic representations of the design or specimens thereof
- certified copy of the priority document (if applicable)
- statement of novelty (not required for textile designs).

Applications must be completed within 15 months or they shall be considered to be abandoned, unless the delay in completing the application was not due to the default or negligence on the part of the applicant.

**Applicant**

The author or creator or his assignee may apply for registration.

**Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Malawi is filed within six months from the earlier application. A certified copy of the priority application must be filed within three months.

**Novelty**

In order to be registrable, a design must be new and original. The design will not be registrable if it has been published in Malawi, or is the same as a design already registered. Accordingly, an application must be filed before the design has been published in Malawi.

Novelty is not destroyed by confidential disclosure by the proprietor; or by disclosure in bad faith by anyone except the proprietor; or by the acceptance of a first and confidential order for goods bearing a new or original textile design; or by disclosure to an authorised government department or official. Novelty is also not destroyed if an application is filed by the proprietor of an artistic work already protected under copyright law to register a corresponding design, provided no industrial use was made of the artistic work by the proprietor or with his consent, and provided the artistic work is not excluded from registration by the Designs Act.

**Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements and also to determine whether the design falls within the definition of a design. If satisfied that the conditions for registration have been met, the Registrar shall register the design and issue the registration certificate. If not, he shall advise the applicant of his objections and the applicant will have an opportunity to respond before a final decision is made.

**Opposition**

No provision is made for opposition to a design prior to registration.

**Revocation/invalidation**

At any time after registration any interested party can apply to the Registrar for cancellation of the registration of the design. The decision of the Registrar can be appealed to the Tribunal.

**Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. A grace period of three months is available.

ARIPO designs are, however, only valid for 10 years and are subject to payment of annual maintenance fees. ARIPO also has a six month grace period for payment of renewal fees.

### **Effect of a design registration**

The registration of a design gives the proprietor the exclusive right in Malawi to make or import for sale or for purposes of trade, or to sell or hire or offer for sale or hire, an article to which the design (or a design not substantially different) has been applied.

### **Assignments and licences**

The right to a design may be transferred and voluntary licences may be granted. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney from assignee or licensor (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

Provision is made for the granting of a compulsory licence at any time after a design has been registered on the ground that the design is not being used in Malawi to a reasonable extent. Applications are decided by the Registrar.

### **Infringement**

The exploitation of a registered industrial design by anyone other than the registered owner requires the consent of the owner. The owner of a registered industrial design has the right to institute court proceedings against any infringer as well as any person who performs any act which makes it likely that an infringement will occur.

### **Marking**

Marking is advisable. The Act specifically states that no damages shall be awarded to a proprietor if the infringer can show that they were unaware that the design was registered.

### **Working**

See the section on **Compulsory licences** above.

## **COPYRIGHT**

### **Law**

- Copyright Act of 1989, Chapter 49:03
- Copyright (Production, Importation and Distribution of Sound and Audio Visual Recordings) Licensing Regulations, 2007

Malawi is a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always



generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary, dramatic, musical and artistic works
- expressions of folklore
- performances
- audiovisual works and sound recordings
- broadcasts
- typographical arrangements of works published in Malawi.

Literary works are further defined to include:

- novels, stories, poetic works, letters, reports, memoranda
- plays, stage directions, film scenarios, broadcasting scripts
- textbooks, treaties, essays, articles, encyclopaedias, dictionaries
- lectures, addresses and sermons
- charts, tables and compilations of data
- computer programs.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, engravings, prints
- maps, plans, diagrams
- works of sculpture, works of architecture
- photographs, works of artistic craftsmanship.

Folklore is defined to mean literary, dramatic, musical and artistic works belonging to the cultural heritage of Malawi created, preserved and developed by ethnic communities of Malawi.

### **Requirements for subsistence of copyright**

No requirement for registration. For a work to qualify for protection, the author must be a national of Malawi, or domiciled or ordinarily resident in Malawi. Alternatively, the work must have been made or first published in Malawi.

### **Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author. If the work was done in terms of a commission or in the course of the author's employment, for the Government or a private body or person, the copyright vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, and the right to object to distortion or mutilation of the work which would be prejudicial to his honour or

reputation. The moral rights may not be transferred during the life of the author.

### **Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years.

In the case of all other works, the duration is 50 years from the date on which the work was made or was made available to the public, except for photographic works for which the term is 25 years, and computer programs for which the term is 10 years.

### **Protection afforded by copyright**

Copyright confers on the owner the economic rights, namely exclusive right to control the doing in Malawi of any of the following acts:

- the reproduction of the work
- the distribution to the public of the work
- the communication to the public of the work.

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor. Provision is also made for the granting of compulsory licences.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, account of profits, delivery up of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Malawi.

# MALI

## GENERAL INFORMATION

Mali is a landlocked, surrounded on the west by Senegal and Mauritania, on the north-east by Algeria and Niger, on the south-east by Burkina Faso, and on the south by Ivory Coast and Guinea.



<b>Area:</b>	1 240 192 km <sup>2</sup>
<b>Population:</b>	13.8 million
<b>Capital:</b>	Bamako
<b>Currency:</b>	CPA Franc
<b>GDP:</b>	\$ 16.7 billion (2010)
<b>Internet domain:</b>	.ml
<b>Languages:</b>	French (official language), Arabic, Bambara
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cotton; livestock; gold
<b>Imports:</b>	Machinery and equipment; construction materials; petroleum; foodstuffs; textiles

## International conventions

Mali is a member of the following international agreements:

- Bangui Agreement (OAPI) (since 1984)
- Berne Convention (since 1962)
- Hague Agreement on Designs (2006)
- Paris Convention (since 1983)
- Patent Cooperation Treaty (since 1984)
- WIPO Convention (since 1982)
- WIPO Copyright Treaty (since 2002)
- WIPO Performances and Phonograms Treaty (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

Mali is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the

right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Mali had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, refer to the chapter on **OAPI**.

In Mali legislation to provide for copyright was recently enacted:

- Law no 08-024 of 2008 on the Regime of Literary and Artistic Property in the Republic of Mali.

## **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# MAURITANIA

## GENERAL INFORMATION

Mauritania lies on the north-west coast of Africa, bordered by the Atlantic Ocean to the west, by Senegal on the south-west, Mali on the south-east and east, Algeria on the north-east, and the Western Sahara province of Morocco on the north-west.



<b>Area:</b>	1 030 700 km <sup>2</sup>
<b>Population:</b>	3.2 million
<b>Capital:</b>	Nouakchott
<b>Currency:</b>	Ouguiya
<b>GDP:</b>	\$ 6.8 billion (2010)
<b>Internet domain:</b>	.mr
<b>Languages:</b>	Arabic (official language), French
<b>Working week:</b>	Sunday - Thursday
<b>Exports:</b>	Fish and fish products; iron ore; gold; cooper; petroleum
<b>Imports:</b>	Consumer goods; foodstuffs; petroleum products; capital goods

## International/regional conventions

Mauritania is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1973)
- Paris Convention (since 1965)
- Patent Cooperation Treaty (since 1983)
- WIPO Convention (since 1976)
- WTO/TRIPS (since 1995)

## IP legislation

Mauritania is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Mauritania had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, refer to the chapter on **OAPI**.

## **PLANT BREEDERS’ RIGHTS**

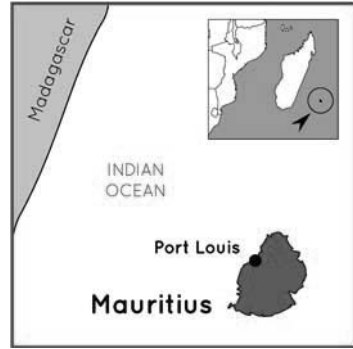
Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# MAURITIUS

## GENERAL INFORMATION

The island of Mauritius lies in the Indian Ocean, off the east coast of Southern Africa and east of Madagascar.

<b>Area:</b>	1860 km <sup>2</sup>
<b>Population:</b>	1.3 million
<b>Capital:</b>	Port Louis
<b>Currency:</b>	Mauritian Rupee
<b>GDP:</b>	\$ 17.5 billion (2010)
<b>Internet domain:</b>	.mu
<b>Languages:</b>	French, English (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Clothing; textiles; sugar; cut flowers; molasses; fish
<b>Imports:</b>	Manufactured goods; capital equipment; foodstuffs; petroleum products; chemicals



## International/regional conventions

Mauritius is a member of the following international agreements:

- Berne Convention (since 1989)
- Paris Convention (since 1976)
- Universal Copyright Convention (since 1968)
- WIPO Convention (since 1976)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004
- Geographical Indications Act no 23 of 2002

Patents

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004

Designs

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004
- Layout Designs (Topographies) of Integrated Circuits Act no 24 of 2002

Copyright

- Copyright Act no 12 of 1997

## TRADE MARKS

Law

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004
- Geographical Indications Act no 23 of 2002

Mauritius is a member of the Paris Convention and the WTO/TRIPS.

### **Trade mark protection**

The Act allows for the registration of trade marks for goods and services, collective marks and trade names.

### **Protection of well-known marks**

The Act provides that a trade mark will not be registrable if it is identical with, or confusingly similar to, or constitutes a translation of, a mark of another person that is well known in Mauritius for identical or similar goods or services, or where the well-known mark is registered in Mauritius for goods or services which are not identical or similar, but the use of the mark being applied for would indicate a connection with the owner of the well-known mark and the interests of the owner are likely to be damaged by such use.

### **Advantages of trade mark registration**

The registration of a mark gives the owner the right to authorise others to use the mark in relation to the relevant goods or services, and gives the owner the right to institute proceedings against any person who uses the mark without the authority of the owner.

### **Types of trade marks**

The following types of trade marks are registrable:

- trade marks for goods and services
- collective marks
- trade names.

### **Definition of a trade mark**

A mark means any visible sign capable of distinguishing the goods or services of an enterprise from those of another enterprise.

### **Definition of a trade name**

A trade name means the name or designation identifying and distinguishing an enterprise.

### **Definition of a collective trade mark**

A collective mark means any visible sign capable of distinguishing the origin or any other common characteristic, including the quality of goods or services, of different enterprises which use the sign under the control of the registered owner of the collective mark.

### **Limitation to colour**

There is no express reference to colour. However, the use of colour is permitted in practice.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied, and multiple class applications are permitted.



**Convention priority**

The application may contain a declaration claiming priority of an earlier application filed by the applicant. A certified copy of the priority application (with English translation if necessary) is required to be filed within three months of the lodgment date.

**Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (notarised and authenticated by an Apostille in terms of the Hague Convention, or legalised)
- electronic reproduction of the mark
- certified copy of the priority document (if applicable).

**Examination/procedure**

Applications are examined on both absolute and relative grounds, and an office action may issue requiring the filing of a response within two months. Once the Controller is satisfied that the requirements for registration are complied with, he must accept the application and cause it to be published in the Government Gazette.

**Opposition**

Any person may, within two months of the publication of acceptance of the application in the Government Gazette, lodge an opposition. This period is extendible on application to the Registrar.

**Opposition proceedings**

Opposition is by way of notice and must state the grounds of opposition and must be accompanied by supporting evidence.

The applicant is afforded an opportunity to file a counter-statement with the grounds on which he relies for his application, with supporting evidence. If the applicant does not file a counter-statement, he shall be deemed to have abandoned the application.

Where the applicant files a counter-statement, the Controller shall, after hearing the parties, if so required, decide whether the mark should be registered.

**Grounds of opposition**

The grounds upon which a trade mark application may be opposed include:

- that the mark is incapable of distinguishing the goods or services of one enterprise from those of other enterprises
- that the mark is contrary to public order or morality
- that the mark is likely to mislead any person, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics
- that the mark is identical with, or an imitation of, or contains an armorial bearing, flag or other emblem, a name or abbreviation of, or an official sign or hallmark adopted by, any state, intergovernmental organisation

or organisation, unless authorised by the competent authority of that state or organisation

- that the mark is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Mauritius for identical or similar goods or services of another enterprise
- that the mark is identical with a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or where it so nearly resembles such a mark as to be likely to deceive or cause confusion
- that the mark is similar to a well-known mark which is registered in Mauritius for goods or services that are not identical or similar to those for which registration is applied, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark, and the interests of the owner of the well-known mark are likely to be damaged by such use
- that the mark contains certain prohibited words such as 'registered', 'patent', 'copyright', as well as 'Mauritius', the Mauritian flag etc.

### **Duration and renewal**

The registration of a mark shall be for a period of 10 years from the date of filing, renewable for like periods by payment of a renewal fee. Subject to the payment of a penalty, renewal is still possible up to three months after the due date.

### **Cancellation/removal of a trade mark**

Any interested person may apply to the Controller for cancellation of a mark in the case of non-use (see the section on **Use requirement and cancellation** below); or to the Tribunal where the requirements for registration have not been fulfilled (see the section on **Grounds of opposition** above) for an order invalidating the registration of a mark or removing it from the register.

### **Grounds for cancellation/removal of a trade mark**

The grounds for cancellation are:

- that the mark does not fulfil the definition of a trade mark or does not fulfil one of the other requirements for registration (see the section on **Grounds of opposition** above)
- that up to one month prior to the filing of the request, the mark had, after its registration, not been in use by the registered owner or a licensee for a continuous period of three years, unless reasonable circumstances prevented the use (see the section on **Use requirement and cancellation** below).

### **Use requirement and cancellation**

The Act provides that, where no use of a registered trade mark by the owner or a licensee has taken place for a continuous period of three years, the registration may be cancelled, unless there were reasonable circumstances that prevented the use and there was no intention not to use the mark.

**Assignment**

Assignment is permitted, but is not effective against third parties unless recorded.

Requirements for recordal:

- power of attorney from assignee, (notarised and authenticated by Apostille, or legalised)
- deed of assignment (authenticated by way of Apostille, or legalised).

**Licensing/registered users**

Licensing is permitted subject to effective quality control measures contained in the licence agreement, which must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney from licensor (notarised and authenticated by Apostille, or legalised)
- licence agreement (notarised and authenticated by Apostille, or legalised).

**Amendment**

Amendments are permitted, provided applications are submitted in writing. The Controller may correct any error in any application.

**Rights conferred by registration**

Registration of a trade mark confers on the owner the right to authorise other persons to use the mark in relation to the relevant goods or services, and the right to institute proceedings against persons who use the mark without authority.

**Trade mark infringement**

Any interested person, other than the registered owner, who intends to use a registered mark, in relation to any goods or services for which it has been registered, shall require the authorisation of the owner. The registered owner has, in addition to any other rights, remedies or actions available to him, the right to institute court proceedings against any person who infringes the mark by using it without his agreement or who performs any act likely to cause an infringement.

Any registered owner may, where the use of any sign similar to the registered mark and in relation to goods and services similar to those for which the mark has been registered, is likely to cause confusion in the public, institute court proceedings.

The infringement provisions apply, *mutatis mutandis*, to any action instituted by the owner of a well-known mark against any person in respect of the unlawful use of the well-known mark.

### **Defences to trade mark infringement**

The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Mauritius by the registered owner or with his consent. No other specific defences are provided for in the Act.

### **Relief for trade mark infringement**

Both civil and criminal proceedings are available. It is a criminal offence to knowingly infringe a trade mark. An injunction, damages and forfeiture of infringing goods can be ordered.

The Unfair Practices Act makes provision for a host of additional, specific forms of infringement, including in relation to unregistered trade marks, the appearance of products, trade names and other business identifiers. The provisions protect against confusion, damage to another's goodwill and misleading the public.

### **Common law rights**

No express provision.

### **Marking of goods**

No express provision.

## **PATENTS**

### **Law**

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004

Mauritius is a member of the Paris Convention and the WTO/TRIPS.

### **Patent protection**

Patent protection is available by way of a national filing.

**Note:** Although Mauritius has not yet acceded to the PCT, the Act has specific provisions referring to the PCT and providing for international applications under PCT to designate Mauritius. However, until Mauritius accedes to the PCT it will not be possible to designate Mauritius in an international application under PCT.

### **Types of patents**

Provision is made for conventional patents in respect of inventions, and for divisional patents where the initial application covered more than one invention.

### **Patentable subject matter**

An invention is defined as an idea of an inventor which provides the solution to a specific problem in the field of technology. Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- discoveries, scientific theories and mathematical methods
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body
- plants
- animals
- essentially biological processes for the production of plants and animals
- plant varieties, and
- literary, dramatic, musical or artistic works or any other aesthetic creation whatsoever.

Although methods for the treatment of the human or animal body and diagnostic methods are not patentable subject matter, the prohibition does not extend to products for use in those methods.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a divisional application, where the original application covers more than one invention.

### **Application**

Non-convention and convention applications are filed with the office of the Controller.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- assignment from the inventors, or a statement by the applicant justifying its right to the invention (if applicable)
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

Failure to file the priority document within the stipulated time period will lead to the lapsing of the priority claim.

### **Applicant**

The inventor or his successor in title may apply for registration. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it is not anticipated by prior art. Prior art consists of anything disclosed to the public, anywhere in the world, by publication in tangible form, or by oral disclosure, by use or in any other way, prior to the filing date or the priority date.

### **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Mauritius filing date or priority date (if convention priority is claimed) is provided, where disclosure of the invention was by reason or in consequence of acts committed by the applicant or his predecessor in title, or disclosure was by reason of abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Inventiveness**

An invention is considered inventive where, having regard to the prior art, it would not have been obvious to a person skilled in the art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Mauritius is filed within 12 months from the earlier application.

### **Examination/procedure**

The application is subjected to formal examination at the Mauritius Patent Office. The Controller may direct that results of examination conducted in other countries, where corresponding applications have been filed, be furnished.

### **Opposition**

The Act does not provide for opposition to the grant of a patent by third parties.

### **Publication**

After examination, if the Controller is satisfied that the necessary requirements have been met, he shall grant and publish the patent.

### **Duration and maintenance**

The duration of a patent is 20 years. Maintenance fees are payable annually from the filing date for pending applications and granted patents. If the maintenance fee is not paid, the patent lapses. There is no grace period provided.

### **Restoration**

No provision.

## **Revocation**

Any interested person may request the Tribunal to invalidate a patent on the grounds that:

- the invention is not an invention within the meaning of the term as defined in the Act
- the patentee is not a person entitled to apply for a patent
- the invention is not patentable, ie not new, inventive, capable of industrial application
- the subject matter of the invention is excluded from patent protection
- the application did not comply with the formal requirements laid down in the Act.

## **Assignments and licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (legalised)
- deed of assignment or licence contract (legalised).

## **Compulsory licences**

A compulsory licence may be granted in cases of non-working or insufficient working (see the section on **Working** below). The competent authority may also authorise compulsory licences if required in the public interest, including national security, nutrition or health, or for the development of vital sectors of the economy, or where the manner of exploitation by the patent owner is anti-competitive.

## **Amendments**

Amendments can be made prior to grant, but any amendment shall not go beyond the disclosure of the invention in the application as filed.

## **Effect of a patent**

Any exploitation of the patented invention in Mauritius shall require the agreement or authorisation of the owner of the patent. Exploitation is defined to mean the following:

- where the patent is for a product, making, importing, offering for sale, selling and using the patented product, or stocking the product for purposes of sale
- where the patent is for a process, using the process and performing any of the above acts in respect of a product of the process.

The rights under a patent do not extend to:

- acts in respect of articles put on the market in Mauritius or any other country by the owner of the patent or with his consent:
- acts done for research and experimental purposes
- acts done in good faith before the filing or priority date.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis and claim damages against the person who infringes the patented invention.

### **Marking**

No express provision.

### **Working**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, the Controller may grant a compulsory licence on the ground that the patented invention is not exploited or is insufficiently exploited. A compulsory licence will not be granted if the patent owner can show that circumstances existed which justified the insufficient exploitation.

## **DESIGNS**

### **Law**

- Patents, Industrial Design and Trade Marks Act no 25 of 2002
- Patents, Industrial Designs and Trade Mark Regulations, 2004
- Layout Designs (Topographies) of Integrated Circuits Act no 24 of 2002

Mauritius is a member of the Paris Convention and the WTO/TRIPS.

### **Design protection**

Design protection is available by way of a national filing.

### **Registrable subject matter**

An industrial design means any composition of lines or colours or any three-dimensional form, or any material, whether or not associated with lines or colours, which composition or form gives a special appearance to a product of industry or handicraft, can serve as a pattern for a product of industry or handicraft, and appeals to and is judged by the eye.

To be registrable, a design must be new. A design which is contrary to public order or morality is not registrable.

### **Classification of designs**

The articles to which designs may be applied are classified into different classes. The Locarno International Classification of Designs is applied.

### **Types of applications**

Application for registration may be filed as a national filing, in appropriate circumstances claiming a priority right.

### **Application**

Non-convention and convention applications are filed with the office of the Controller. Foreign applicants must have a local address for service.



A single application filed in Mauritius may be in respect of two or more designs provided that the designs relate to the same class of the international classification or the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (legalised)
- assignment document (if applicable; legalised)
- drawings, photographs or other graphic reproductions of the article embodying the design
- specimen of the article embodying the industrial design (where the design is two-dimensional)
- certified copy of priority document (if applicable).

### **Applicant**

The author or creator or his assignee may apply for registration.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Mauritius is filed within six months from the earlier application.

A certified copy of the priority application has to be filed within three months of the filing date or the claim to priority will be lost.

### **Novelty**

A design shall be considered to be new if it has not been disclosed to the public anywhere in the world by publication in tangible form, or by use or in any other way prior to the filing date or priority date (if priority is claimed). However, a 12 month grace period from the filing date or priority date is provided, where disclosure of the design was by reason or in consequence of acts committed by the applicant or his predecessor in title, or disclosure was by reason of abuse committed by a third party with regard to the applicant or his predecessor in title.

### **Examination/procedure**

Formalities examination is conducted.

### **Opposition**

The Act does not provide for opposition by third parties to the registration of a design.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration.

### **Restoration**

No provision.

### **Revocation**

Any person may apply to the Tribunal for the invalidation of a design registration, on the ground that the design is not a design as defined, or that it was not registrable, eg lacked novelty.

### **Assignments and licences**

The right to a design may be transferred and voluntary licences may be granted. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney from assignee or licensor (legalised)
- deed of assignment or licence contract (original or certified copy; legalised).

### **Compulsory licences**

No provision is made for compulsory licences for designs in Mauritius.

### **Rights conferred by registration**

The registered owner of the design has the right to authorise the exploitation of the design in Mauritius. Exploitation means the making, selling or importing of articles embodying the design or a substantial copy thereof.

The registered owner also has the right to institute court proceedings against any person who infringes the design by performing any of the above acts without authority.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis and claim damages against the person who infringes the registered design.

### **Marking**

No requirement.

### **Working**

No requirements.

## **COPYRIGHT**

### **Law**

- Copyright Act no 12 of 1997

Mauritius is a member of the Berne Convention, the Universal Copyright Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law provides for copyright in respect of artistic, literary and scientific works, including:

- books, pamphlets, or other writings
- illustrations, maps, plans or sketches
- lectures, addresses, sermons
- dramatic and dramatico-musical works
- musical works
- choreographic works, pantomimes
- audiovisual works
- sound recordings
- works of art, architecture, painting, drawing, sculpture, engravings, lithography
- photographic works
- works of applied art or craft
- computer programs
- works of folklore
- derivative works.

Derivative works include

- translations, adaptations, arrangements of works
- collections and compilations of works.

**Exclusions from copyright**

Excluded from protection are:

- ideas, procedures, systems, methods of operation, concepts, principles
- official texts of laws, decisions by courts, or of administrative bodies.

**Registration of copyright**

No requirement for registration.

**Requirements for subsistence of copyright**

To qualify for copyright, the work must be original and must have been written down, recorded, fixed or otherwise reduced to material form. Furthermore, the author must be a citizen or resident of Mauritius, or the work must have been first published in Mauritius.

Since Mauritius is a member of the Berne Convention and the Universal Copyright Convention, copyright protection is extended to works eligible under such treaties.

**Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. Copyright entails economic and moral rights.

The economic rights confer on the copyright owner the exclusive right to carry out or authorise the following acts:

- reproduction of the work
- distribution to the public of copies of the work

- public performance of the work
- communication of the work to the public
- broadcasting of the work
- importation of copies of the work
- translation of the work.

The economic rights are subject to certain exclusions, eg reproduction of a work for private and personal use; quotations from the work; reproduction of the work for teaching, or for libraries and archives.

The moral rights confer on the author (whether or not the economic rights have been transferred) the following rights:

- to claim authorship of the work
- to object to any distortion, mutilation or alteration of the work which would be prejudicial to his honour or reputation.

### **Duration of copyright**

The economic rights inherent in copyright generally endure for the lifetime of the author plus 50 years. The copyright in an audiovisual work endures for 50 years, and in a photographic work endures for 25 years.

### **Protection afforded by copyright**

As indicated above, copyright confers on the copyright owner economic rights, ie the exclusive right to use and exploit the copyright work, and to authorise the use and exploitation by others (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed. The moral rights cannot be assigned.

Special provision is made for the establishment and operation of the Mauritius Society of Authors.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Mauritius.

# MOROCCO

## GENERAL INFORMATION

Morocco is an independent monarchy in the northwest corner of Africa, comprising Tangier, Western Sahara (formerly the Spanish Sahara), Ifni and Tarfaya. The Kingdom of Morocco was previously, until 1956, divided into three zones, namely a French zone, a Spanish zone and an International zone of Tangier. These zones have now been united into one kingdom.

The fishing ports of Ceuta and Melilla are still Spanish municipalities.



<b>Area:</b>	446 550 km <sup>2</sup>
<b>Population:</b>	31.6 million
<b>Capital:</b>	Rabat
<b>Currency:</b>	Moroccan Dirham
<b>GDP:</b>	\$ 153.8 billion (2010)
<b>Internet domain:</b>	.ma
<b>Languages:</b>	Arabic (official language), French, Spanish, Berber
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Food and beverages; semi-processed goods; consumer goods; phosphates; crude minerals
<b>Imports:</b>	Gas and electricity; crude petroleum; textile fabric; telecommunication equipment; wheat; transistors; plastic

## International/regional conventions

Morocco is a member of the following international agreements:

- Berne Convention (since 1917)
- Brussels Convention on Programme-carrying Signals (since 1983)
- Budapest Treaty (since 2011)
- Hague Agreement on Designs (since 1930)
- Madrid Agreement on Source of Goods (since 1917)
- Madrid Agreement on Marks (since 1917)
- Madrid Protocol on Marks (since 1999)
- Nairobi Treaty on Olympic Symbol (since 1993)
- Nice Agreement on Classification of Marks (since 1966)
- Paris Convention (since 1917)
- Patent Cooperation Treaty (since 1999)
- Trade Mark Law Treaty (since 2009)
- UPOV Convention on New Varieties of Plants (since 2006)
- WIPO Convention (since 1971)
- WIPO Copyright Treaty (since 2011)
- WIPO Performances and Phonograms Treaty (since 2011)
- WTO/TRIPS (since 1995)

**IP legislation****Trade marks**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

**Patents**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

**Designs**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

**Copyright**

- Law no 2-00 of 2000 on Copyright and Related Rights

**Related areas**

- Law no 9-94 of 1997 on Protection of New Plant Varieties of Plants
- Decree no 2-01-2324 of 2002 implementing Law no 9-94 on the Protection of New Varieties of Plants
- Law on the Protection of New Plant Varieties of 2006
- Decree no 2-02-2325 of 2002 on the remuneration for services provided by the Ministry of Agriculture in relation to the Protection of New Varieties of Plants
- Orders no 1576-02 to 1581-02 of 2002 on different administrative matters relating to the protection of new plant varieties

**TRADE MARKS****Law**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

Morocco is a member of the Paris Convention, the Madrid Agreement and the Madrid Protocol, and the WTO/TRIPS. Morocco is also a member of the Nice Agreement.

**Trade mark protection**

Provision is made for the registration of trade marks for goods and for services, as well as for collective and certification marks.

Trade mark applications may be filed as national applications, claiming convention priority in terms of the Paris Convention when appropriate; or Morocco may be designated in international applications filed in terms of the Madrid Agreement or Protocol.

**Protection of well-known marks**

The owner of a well-known trade mark within the meaning of Art 6 *bis* of the Paris Convention may claim the cancellation of the registration of a mark liable to lead to confusion with his own mark. Such nullity proceedings shall be prescribed five years after the registration of the mark, unless the registration was applied for in bad faith.

**Advantages of trade mark registration**

According to the Law, the registration of a trade mark confers on the owner a right of property in the mark for the goods and services that have been designated.

**Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- collective marks
- collective certification marks.

**Definition of a trade mark**

A trade mark or a service mark is defined as a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person, and specifically includes the following:

- denominations in all forms, such as words, combinations of words, surnames and geographical names, pseudonyms, letters, numerals, abbreviations
- figurative signs, such as devices, labels, seals, selvedges, reliefs, holograms, logos, synthesised images, shapes (particularly those of a product or its packaging or those that identify a service), arrangements, combinations or shades of colour
- sound signs, such as sounds, musical pieces
- olfactory marks.

**Definition of a collective trade mark**

A mark shall be known as a collective mark if it may be used by any person who complies with regulations issued by the owner of the registration.

**Definition of a collective certification trade mark**

A collective certification mark is to be affixed to goods or services that display the characteristics detailed in the collective regulations in regard to nature, properties or qualities.

**Limitation to colour**

Combinations or shades of colour can constitute a mark.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

**Convention priority**

Morocco is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the first filed application, provided the Moroccan application is filed within six months of such earlier filing date.

Morocco is also a member of the Madrid Agreement and Protocol, so that registration of a trade mark may be obtained by way of an international application designating Morocco.

**Application**

A national application is filed with the Moroccan Industrial and Commercial Property Office, headed by the Director-General and operated under the supervision of the Ministry of Industry and Trade.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed), in French
- list of the goods or services
- electronic print of the mark
- for sound marks: the musical notation (sheet music)
- for olfactory marks: a legend explaining the essence of the smell
- priority declaration (where applicable)
- certified copy of the priority document (if applicable), in French.

**Examination/procedure**

An application is examined as to formal requirements only. If formal compliance is established, the application is published in the Gazette issued by the Industrial and Commercial Property Office. If no opposition is filed, the mark can be considered registered and a registration certificate will be issued.

**Opposition**

The Law makes provision for opposition within two months from publication. There is no provision for the extension of this period.

**Opposition proceedings**

An opposition is initiated by filing a statement with the body in charge of industrial property. The statement must also be sent to the trade mark applicant or its representative by registered mail. The opposition is recorded in the register.

The trade mark applicant may file a response to the opposition. After considering the opponent's grounds of opposition and the trade mark applicant's reply, the body in charge of industrial property prepares a draft decision and sends it to both parties who have 15 days to object to the findings, failing which the decision becomes effective.



An opposition must be settled within six months of it being entered, or such further time as may be allowed upon application by either or both of the parties.

### **Grounds for opposition**

The grounds of opposition include:

- that the mark is a sign or name which in everyday or technical language constitutes the necessary, generic or usual designation of the goods or services
- that the mark is a sign or name which may serve to designate a feature of the product or service, particularly the type, quality, quantity, purpose, value, geographical origin or time of production of the goods or furnishing of the service
- that the mark is a sign or name exclusively constituted by the shape imposed by the nature or function of the product, or which gives the product its substantial value
- that the mark incorporates an effigy of any member of the royal family, or official State insignia or emblems, or those of intergovernmental organisations
- that the mark is confusingly similar to an earlier registered trade mark or application in respect of the same or similar goods or services
- that the mark is misleading, or that its use would be contrary to law or morality
- that the use of the mark will be contrary to the rights of a well-known mark within the meaning of the Paris Convention.

The above grounds of opposition are not exhaustive. Any impediment recognised in law to the registration of a mark may be raised as a ground of opposition.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the filing date of the application, and is thereafter renewable for like periods of 10 years. Renewal should take place within the six months preceding expiry of the 10 year period, but a grace period of six months from expiry is allowed for renewal.

### **Cancellation/removal of a trade mark**

Any concerned person or the public prosecutor may apply to the court for the rights of an owner of a registered mark to be nullified or revoked. Partial revocation (only in respect of some of the goods or services concerned) is possible.

### **Grounds for cancellation/removal of a trade mark**

The grounds for cancellation include:

- that, up to a date three months before the cancellation proceedings are launched, the owner has not put his mark to genuine use in connection with the goods or services covered by the registration during an

uninterrupted period of five years, without good reason (see the section on **Use requirements and cancellation** below)

- that the mark does not meet any of the absolute or relative grounds for registration of a mark; however, a mark may not be contested after it has been registered for five years or more
- that the mark is liable to lead to confusion with a well-known trade mark entitled to protection in terms of the Paris Convention; nullity proceedings on this ground shall prescribe five years after the registration date of the mark, unless registration was applied for in bad faith
- that the mark has become the common name in trade for a product or service
- that the mark has become liable to mislead the public, particularly as regards the nature, quality or geographical origin of the product or service.

### **Use requirement and cancellation**

The Law provides that an owner who has not put his mark to genuine use in connection with the relevant goods or services during an uninterrupted period of five years, without good reason, shall be liable to revocation of his rights.

### **Assignment**

Assignment of any or all of the rights acquired by registration is possible, but shall have no effect against third parties unless it is in writing and entered in the National Register of Marks.

Requirements for recordal:

- power of attorney (legalised), in French
- a request by any of the parties involved
- deed of assignment (legalised), with French translation.

### **Licensing/registered users**

The rights under a registered mark may be subject, in whole or in part, to a voluntary licence, whether exclusive or non-exclusive. Agreements involving licensing shall be recorded in writing, on pain of nullity. Recording of licenses or registered users is not required, but recommended in practice.

Requirements for recordal:

- power of attorney (legalised), in French
- a request by any of the parties involved
- licence agreement (legalised), with French translation.

### **Amendment**

An applicant may, within three months from filing, request rectification of linguistic errors or mistakes in transcription and substantive errors in the elements or documents filed. The mark itself and the classes applied for may not be amended.

An application or registration may also be renounced by means of a written declaration by the owner(s) thereof.

Requirements for amendment:

- request for amendment must be in writing
- it must contain the subject matter of the proposed rectifications.

### **Rights conferred by registration**

The registration of a trade mark confers on the owner a right of property in the mark for the goods and services designated. The reproduction or use of a mark is prohibited unless authorised by the owner.

### **Trade mark infringement**

The following acts amount to trade mark infringement and are prohibited, unless authorised by the owner of the registered trade mark:

- the reproduction, use or affixing of a mark (even with the addition of words such as formula, manner, system, imitation, type, method), or the use of a reproduced mark or a sign identical to this mark, for goods or services that are identical to those covered by the registration
- the suppression or modification of a duly affixed mark
- the reproduction, use or affixing of a mark or use of a reproduced mark or an identical or similar sign for goods or services that are similar or relating to those covered by the registration, if such use is likely to confuse the public
- the imitation of a mark and the use of an imitated mark for goods or services that are identical or similar to those covered by the registration, if such use is likely to confuse the public.

The Act also makes provision for certain specific criminal offences, eg counterfeiting of a trade mark.

### **Defences to trade mark infringement**

The offering for sale, putting on the market, reproduction, use, holding with a view to use, or putting on the market of an infringing product, where such acts are committed by a person other than the manufacturer of the infringing product, shall cause the liability of the person committing them only if such acts have been committed in full knowledge of the facts.

No other specific defences are provided for in the Act.

### **Relief for trade mark infringement**

Both civil and criminal proceedings are available. On a civil basis, injunctions and damages may be granted. Preliminary relief in the form of a temporary injunction can be obtained. Both civil and criminal causes of action prescribe three years after the dates of the acts upon which they are founded. Seizure of infringing goods (including by customs) and destruction are available.

### **Common law rights**

No express provision.

### **Marking of goods**

The marking of goods is optional.

## **PATENTS**

### **Law**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

Morocco is a member of the Paris Convention, the Budapest Treaty, the PCT and the WTO/TRIPS.

### **Patent protection**

Patent protection is obtainable by way of a national application and convention priority may be claimed in appropriate circumstances, or by way of a national phase application under the PCT. Patents of addition may be obtained for improvements or amendments to the principal patent.

The Law in Morocco has not yet been amended to incorporate rules regarding the PCT system. However, PCT applications are being accepted and processed by the patent office.

### **Types of patents**

The Law provides for conventional patents for inventions that are new, involve an inventive step, and is susceptible to industrial applications. The Law also provides for patents of addition in respect of developments or improvements of the original inventions.

### **Patentable subject matter**

An invention may concern products, processes, or any new application or combination of known means to achieve a result unknown in the prior art.

Any invention that is new, involves an inventive step and is susceptible of industrial application may be patented.

The following are not regarded as inventions:

- discoveries, scientific theories and mathematical methods
- aesthetic creations
- schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers
- presentations of information.

Patents shall not be granted for the following:

- inventions the publication or implementation of which would be contrary to public policy or morality

- new plant varieties subject to the provisions of Law no 9-94 on the Protection of New Plant Varieties
- methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body. (This provision does not apply to products, in particular substances or compounds, for use in any of these methods.)

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Morocco is designated
- an application for a patent of addition, to cover improvements or amendments to the invention of the original patent.

### **Application**

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- deed of assignment (simply signed; not required if the international application and PCT national phase application are filed in the same name)
- copy of the specification (including claims, drawings and abstract), in French
- certified copy of the priority document (if applicable)
- international preliminary report on patentability (for PCT national phase applications only).

If the certified copy of the priority document is not submitted within the three month deadline, then the claim to priority will be disregarded. In practice, the certified copy of the priority document does not need to be submitted for PCT national phase applications.

### **Applicant**

The inventor or his successor in title may apply for a patent. An assignment document is required if the applicant is not the inventor.

### **Novelty**

An invention shall be considered to be new if it does not form part of the state of the art. The state of the art comprises everything made available to the public by means of a written or oral description, by use or in any other way, before the date of filing of the patent application in Morocco, or of a patent application filed abroad and for which valid priority has been claimed.

### **Certain prior knowledge or publication excused**

Notwithstanding these provisions, disclosure of an invention shall not be taken into consideration if:

- it occurred within the six months preceding the filing date of the patent application
- it resulted from the publication, after the date of such filing, of a prior patent application and if
- in either case, it was due directly or indirectly to –
  - an evident abuse in relation to the applicant or his legal predecessor
  - the fact that the applicant or his legal predecessor had displayed the invention at an officially recognised, international exhibition held within the territory of one of the countries of the Paris Convention.

However, in the latter case, the display of the invention at the exhibition must have been declared at the time the application was filed.

### **Inventiveness**

An invention is considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

### **Convention priority**

Applications claiming priority will be recognised provided they are filed within 12 months of the priority application, and provided that the certified copy of the priority document is filed within three months of the filing date. If the priority document is not filed within the deadline, the priority claim will be lost.

### **Examination/procedure**

Applications for patents are subjected to formal examination and a certain level of substantive examination. The Law makes provision for refusal on certain specific grounds including non patentable subject matter, invention not industrially applicable, lack of unity of invention etc. However, in practice applications do not undergo substantive examination and routinely proceed to grant without objection. On compliance with the formal requirements, a patent will be granted without any guarantee regarding the nature of the invention or the merits of the invention.

### **Opposition**

The Law does not make any provision for the filing of opposition to a patent application.

### **Publication**

Applications which meet the conditions for patentability and which comply with the formal requirements are granted and will then be published in the Patent Journal.

### **Duration and maintenance**

Patents have a term of 20 years from date of filing of the application. Annuities are payable in periods of five years, ie the 2<sup>nd</sup> – 5<sup>th</sup> annuities must be paid at the time of filing the application. The rest of the annuities are payable for periods of five years as follows: 6<sup>th</sup> – 10<sup>th</sup>, 11<sup>th</sup> – 15<sup>th</sup>, and 16<sup>th</sup> – 20<sup>th</sup>. A six-month grace period is allowed. If the annuities are not paid within this period, the patent lapses.

The Law provides for extension of the term of a patent which relates to pharmaceutical products. An application for extension of term must be lodged within three months of the actual date of launch of the product on the market. The term of the patent may be extended for a further period of up to two and a half years, taking into account the time between the application for official marketing approval and the date when such approval is given.

The extension of the patent term cannot exceed a maximum period of two and a half years after expiration of the duration of the patent.

The duration of a certificate of addition is the same as the patent upon which it is based and no annuities are payable in respect of the certificate of addition.

### **Restoration**

An application for restoration can be filed within three months of the date of receipt of a notification from the patent office that the renewal fees have not been paid. The application must provide a legitimate reason why the fees were not paid in time.

### **Revocation**

Applications for revocation of a patent may be instituted by any interested party by filing an application for cancellation with the court. An application for revocation which relates to only a part of the patent will result in the corresponding limitation of the claims, as opposed to complete revocation.

Grounds for revocation include:

- the invention is not patentable
- the description of the invention does not disclose the invention in a manner sufficient to enable a person skilled in the art to carry it out
- the subject matter of the invention extends beyond the application as filed
- the claims do not define the scope of protection sought.

### **Assignments**

Patents can be assigned in whole or in part. Any assignment must be in writing and recorded in the special register to be enforceable against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment (notarised), with French translation.

### **Licences**

Exclusive and non-exclusive voluntary licences are permitted, and must be recorded in writing to avoid nullity.

Requirements for recordal:

- power of attorney (simply signed)
- licence agreement (notarised), with French translation.

### **Compulsory licences**

On expiry of a period of three years from the grant of a patent, or four years from the filing date of an application, any public or private legal person may be granted a compulsory licence under the patent provided that, at the time of the request and failing legitimate reasons, the owner of the patent or his successor in title:

- has not begun to work or has made no real and effective preparations for working the invention that is the subject matter of the patent in the territory of Morocco
- has not marketed the product that is the subject matter of the patent in a quantity sufficient to satisfy the needs of the Moroccan market
- has abandoned working or marketing of the patent in Morocco for more than three years.

The application for a compulsory licence is made to the court and must be accompanied by evidence establishing that the applicant has been unable to obtain a licence from the owner of the patent amicably under reasonable conditions and commercial terms, and that he is in a position to work the invention in order to satisfy the needs of the Moroccan market.

A compulsory licence may only be non-exclusive. Any compulsory licence shall be granted mainly for the supply of the Moroccan market. It shall be granted on conditions laid down by the court and these conditions may be amended by the court on a request by the owner or by the licensee.

The Law also provides for patents granted for medicines or processes for obtaining medicines, to be worked *ex officio* in cases where interests of public health so demand. Such *ex officio* working shall be ordered by administrative order. An *ex officio* licence shall be granted under fixed conditions.

### **Amendments**

It is possible to request correction of linguistic or transcription errors as well as material errors at any stage prior to grant. After grant it is necessary to file a certificate of addition to effect any improvements or modifications to the main patent.

### **Effect of a patent**

The effect of a patent is to give to the owner the right to authorise or prohibit the following acts by other persons:

- making, offering, putting on the market, or using a product which is the subject matter of the patent, or importing or stocking such product
- using a process which is the subject of a patent, or knowingly offering the process for use in Morocco
- offering, putting on the market or using the product obtained directly from the patented process.



### **Infringement**

The Law provides for civil and/or criminal sanctions. Civil sanctions include search and seizure operations, confiscation and payment of damages, all of which may be subject to a security deposit by the patent owner.

The Law also provides specific criminal penalties (including payment of a fine and a period of imprisonment) for patent infringement where the infringer was aware of the rights of the owner of the patent. Provision is made for the doubling of the specified amounts and periods in the case of repeat offences, and for more severe penalties if the infringer was a former employee of the owner of the patent.

### **Marking**

No express requirement.

### **Working**

In order to avoid the granting of compulsory licences, the Law requires a patent owner, either himself or through a licensee, to commence working the patent and marketing the patented product in Morocco on a scale sufficient to satisfy the needs of the market in Morocco within a period of three years from the grant of the patent, or four years from the filing date. (See the section on **Compulsory licences** above.)

## **DESIGNS**

### **Law**

- Law no 17-97 of 2000 on Protection of Industrial Property (as modified and supplemented by Law no 31-05 on Protection of Industrial Property)
- Decree no 2-00-368 of 2004, implementing Law no 17-97 on the Protection of Industrial Property (as amended by Decree no 2-05-1485 of 2006)

Morocco is a member of the Paris Convention, the Hague Agreement and WTO/TRIPS.

### **Design protection**

Design protection can be obtained via national filing in Morocco. Design protection can also be obtained by way of an international registration in terms of the Hague Agreement, designating Morocco.

### **Registrable subject matter**

Any three-dimensional shape, associated with lines or with colours, shall be considered an industrial design or model, on condition that the assembly lends a special appearance to an industrial or craft product and can serve as a type for the manufacture of an industrial or craft product.

The protection provided by the Law shall not extend to industrial designs that are contrary to morality or public policy, or to designs that reproduce efficacies of his Majesty the King of Morocco or a member of the royal family, or armorial bearings, flags or insignia of the Kingdom or other states.

### **Classification of designs**

Locarno Classification is not applied.

### **Types of applications**

A design registration may be obtained by way of a national filing, in appropriate circumstances with a claim to priority.

Although Morocco has acceded to the Hague Agreement, no express provision is made for registration of designs to be obtained in terms of that Agreement.

### **Application**

The Law states that it is possible for a single application to include up to 50 designs on condition that they are in the same category. In practice this means that a single application may include up to 50 embodiments of the same design.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- suitable graphic reproductions of the design
- assignment document (if applicable)
- statement of novelty, with French translation
- brief description, with French translation
- certified copy of priority document (if applicable).

### **Applicant**

The author or creator or his assignee can apply for registration of an industrial design. The law contains a presumption to the effect that the first person to file an application for an industrial design is the creator.

### **Convention priority**

It is possible to claim priority of an earlier application provided that the application in Morocco is filed within six months of the filing date of priority application. If a certified copy of the priority document is not filed within three months of the filing date, the claim to priority will be disregarded and the design will be registered without priority.

### **Novelty**

An industrial design or model shall be deemed new if it has not been made available to the public by advertising or any other means, prior to the date of its filing or, if appropriate, prior to a validly claimed priority date.

An industrial design or model shall not be deemed made available to the public by the simple fact that, within the six months preceding its filing date, it has been shown for the first time at an official or officially recognised international exhibition held in the territory of one of the countries of the Paris Convention.

**Examination/procedure**

Formal examination is conducted.

The Designs Office may reject the application on the grounds that:

- the design does not fall within the definition of a design
- the design is contrary to morality or public policy, or that it includes an effigy, sign, emblem or currency without authorisation from the competent authorities
- the documentary requirements to support the application have not been submitted within the permitted time period.

**Opposition**

No provision is made for opposition to an industrial design prior to registration.

**Duration and maintenance**

The initial term of the design registration is five years. This term is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration. Renewal fees can only be paid six months before expiry of the design, and a six month grace period is available.

**Restoration**

The Law does not make any provision for restoration if the renewal fees are not paid.

**Revocation**

Any concerned person, including the public prosecutor, may invoke the nullity of the registration of a design made in violation of the requirements of the Law.

**Assignments and licences**

Assignments and licences must be recorded in the special register if they are to be enforceable against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (notarised), with French translation.

**Compulsory licences**

No provisions.

**Effect of a design registration**

The registration of a design confers on the holder the right to prohibit others from performing any of the following acts when undertaken for commercial purposes:

- reproduction of the design with a view to its exploitation
- importing, offering for sale or selling a product reproducing the design
- holding such product for the purposes of sale.

**Infringement**

The Law provides for civil and/or criminal sanctions. Civil sanctions include search and seizure operations, confiscation and payment of damages, all of which may be subject to a security deposit.

The Law also provides for specific criminal penalties (including payment of a fine and/or a period of imprisonment) for infringement where the infringer was aware of the rights of the owner of the registered design. Provision is made for more severe penalties if the infringer was a former employee of the owner of the design.

**Marking**

No provision.

**Working**

No provision.

**COPYRIGHT****Law**

- Law no 2-00 of 2000 on Copyright and Related Rights

Morocco is a member of the Berne Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The Law provides that all authors shall enjoy copyright in relation to their literary or artistic works, including the following:

- works expressed in writing
- computer programs
- lectures, addresses, sermons and other works consisting of words or expressed orally
- musical works, irrespective of whether they contain accompanying texts
- dramatic and dramatico-musical works
- choreographic works and mimed works
- audiovisual works including cinematographic works and videograms
- works of fine art, including drawings, paintings, engravings, lithographs, printing on leather and all other works of fine art
- works of architecture
- photographic works
- works of applied art
- illustrations, maps, plans, sketches and three-dimensional works relating to geography, topography, architecture or science
- expressions of folklore and works inspired by folklore
- drawings of garment industry designs.

Protection shall be independent of the mode or form of expression, quality and aim of the work.

The following shall also be protected as works:

- derivative works and collections
- ancient manuscripts.

### **Authorship and ownership**

The author is generally the first owner of the copyright in the work, including the moral rights and the economic rights. The economic rights may be assigned; the moral rights shall not be transferable.

### **Exclusions from copyright**

Certain subject matter is excluded from protection:

- official texts of a legislative, administrative or legal nature
- current events
- ideas, procedures and systems, methods of operation, concepts, formulas, numerical tables, discoveries, mere data.

### **Duration of copyright**

The term of copyright is as follows:

- the economic rights in a work will generally endure for the life of the author plus 70 years
- the economic rights in a collective or audiovisual work are protected for 70 years from the year of publication
- the economic rights in works of applied art endure for 70 years from the year of production
- the duration of protection for phonograms, performances and broadcasts is 70 years from the year of creation.

### **Exceptions to copyright infringement**

The Law provides for certain limited exceptions, when the copying of a work will not constitute infringement.

These include:

- copying of a work for personal use (subject to specified limitations)
- copying of a work for the purpose of education
- copyright for use in libraries, archives and similar institutions
- making of temporary reproductions
- citing or quoting from a work
- using for judicial, administrative, or information purposes
- making of a back-up copy of a computer program
- making of a temporary copy for broadcasting purposes.

### **Assignment or licensing of copyright**

The economic rights under copyright may be assigned or licensed. Such assignment or licence must be in writing. The moral rights are not transferable.

### **Protection afforded by copyright**

The protection afforded by copyright entails economic rights as well as moral rights.

#### **Economic rights**

The copyright owner has the exclusive right to carry out, prohibit or authorise the following acts:

- republish and reproduce the work in any way or form
- translate the work
- make adaptations, arrangements and other transformations of the work
- carry out the hiring or public loan of copies of audiovisual works, or phonograms, or computer programs
- carry out the public distribution of the work, by sale, hiring
- perform the work in public
- import copies of the work
- broadcast the work
- communicate the work to the public.

#### **Moral rights**

The author of a work has the following moral rights even after transfer of the economic rights:

- the right to claim authorship or paternity, or to remain anonymous
- the right to object against any distortion, mutilation or alteration of the work which would be prejudicial to his honour or reputation.

#### **Copyright infringement**

In the case of infringement, ie the unauthorised use of the copyright work by others, the copyright owner may institute a civil action or a criminal action, depending on the nature of the infringing act.

Civil remedies include an injunction (for the cessation of the violation), confiscation of infringing copies, impounding of packaging and implements used for infringement, and damages. Provision is also made for border measures.

Criminal sanctions may include imprisonment and a fine.

## **PLANT BREEDERS' RIGHTS**

### **Law**

- Law no 9-94 of 1997 on Protection of New Plant Varieties of Plants
- Decree no 2-01-2324 of 2002 implementing Law no 9-94 on the Protection of New Varieties of Plants
- Law on the Protection of New Plant Varieties of 2006
- Decree no 2-02-2325 of 2002 on the remuneration for services provided by the Ministry of Agriculture in relation to the Protection of New Varieties of Plants
- Orders no 1576-02 to 1581-02 of 2002 on different administrative matters relating to the protection of new plant varieties

Plant breeders' rights can be obtained under the above Moroccan laws. Morocco is a member of the UPOV Convention for the Protection of New Varieties of Plants.

**Protectable subject matter**

Protection can currently only be obtained for 76 listed kinds of plants. Although further varieties can, in principle, be added to the list, it seems that this is a difficult process.

**Requirements for registrability**

To be registrable, a plant variety must be new. Thus, at the date of filing the application, reproductive material, harvested material or a processed product of the variety must not yet have been sold or given to others in another way, by the breeder or with his consent, for purposes of exploitation of the variety, for more than one year in Morocco, or for more than four years (general plants) and six years (trees and vines) outside Morocco.

**Application**

Requirements for filing a plant breeder's right application include

- an application form
- a form B (similar to a technical questionnaire)
- a power of attorney
- a deed of assignment
- plant specimens
- results of DUS (distinct, uniform, stable) examinations conducted elsewhere
- priority document (if applicable).

**Convention priority**

Convention priority can be claimed.

**Duration**

A plant breeder's right endures for 20 – 25 years or for 30 years, depending on the type of plant.

# MOZAMBIQUE

## GENERAL INFORMATION

The Republic of Mozambique is located on the south-east coast of Africa, bordered in the north by Tanzania; on the west by Malawi, Zambia and Zimbabwe; on the south-west and south by South Africa and Swaziland; and on the east by the Indian Ocean.



<b>Area:</b>	799 380km <sup>2</sup>
<b>Population:</b>	22.0 million
<b>Capital:</b>	Maputo
<b>Currency:</b>	Meticais
<b>GDP:</b>	\$ 22.19 billion (2010)
<b>Internet domain:</b>	.mz
<b>Languages:</b>	Portuguese (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Aluminium; prawns; cashew nuts; cotton; sugar; citrus; timber; bulk electricity
<b>Imports:</b>	Machinery and equipment; vehicles, fuel, chemicals, metal products; foodstuffs; textiles

## International/regional conventions

Mozambique is a member of the following international/regional agreements:

- Harare Protocol (of ARIPO) (since 2000)
- Lusaka Agreement (ARIPO) (since 2000)
- Madrid Agreement on Marks (since 1998)
- Madrid Protocol on Marks (since 1998)
- Nice Agreement on Classification of Marks (since 2002)
- Paris Convention (since 1998)
- Patent Cooperation Treaty (since 2000)
- WIPO Convention (since 1996)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Decree no 4 of 2006 on Industrial Property Code
- Patents
- Decree no 4 of 2006 on Industrial Property Code
- Designs
- Decree no 4 of 2006 on Industrial Property Code
- Copyright
- Law no 4 of 2001 on Copyright



## TRADE MARKS

### Law

- Decree no 4 of 2006 on Industrial Property Code

Mozambique is a member of the Paris Convention, the Madrid Agreement and the Madrid Protocol, the Nice Agreement on Classification of Marks and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of product and service marks, as well as for collective and certification marks. Trade mark applications may be filed as national applications, claiming convention priority in terms of the Paris Convention when appropriate; or Mozambique may be designated in international applications filed in terms of the Madrid Agreement.

### Protection of well-known marks

A trade mark will not be registrable if it is identical or similar to a mark of high renown or well known in Mozambique. It is specifically provided that the registration of a mark will be refused or annulled if the mark wholly or essentially constitutes a reproduction, imitation or translation of another mark that is well known in Mozambique, if it is to be used on identical or similar products or services that are liable to create confusion.

It is further provided that the registration of such a mark will also be refused or annulled, even though used on products or services that are not identical or similar, if the other mark enjoys high renown in Mozambique or in the world and the later mark will take undue advantage of, or be detrimental to, the distinguishing character of the renowned mark.

### Advantages of trade mark registration

The registration of a mark confers on the owner the right to the exclusive use of the mark, and the right to prohibit third parties to use the mark (subject to certain limitations).

### Types of trade marks

The following types of trade marks are registrable:

- product and service marks
- certification marks
- collective marks.

### Definition of a trade mark

A product and service mark is defined as a distinctive, clearly visible or audible sign, which is capable of being represented graphically and of distinguishing the products or services of one enterprise from those of another, and which consists of words, including personal names, designs, letters, numerals, or the shape of the product or its packaging.

### **Definition of a certification trade mark**

A certification mark is defined as a mark that identifies services which are used by persons other than the proprietor but under the supervision of the proprietor, and which guarantee the particular characteristics or qualities of the services.

### **Definition of a collective trade mark**

A collective mark is defined as a mark that is capable of distinguishing the origin or any other common characteristic, including the quality, of products or services of enterprises that are members of an association or group.

### **Limitation to colour**

Express reference is made to the mark consisting of a colour or colours, namely as a ground for opposition (see the section on **Grounds for opposition** below).

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover only one class.

### **Convention priority**

Mozambique is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right to be accorded the same date as the first-filed application, provided the Mozambique application is filed within six months of the earliest filing date.

Since Mozambique is also a member of the Madrid Agreement and Protocol, trade mark protection may be obtained via an international application under the Protocol, designating Mozambique. Although Mozambique is also a member of the Lusaka Agreement on ARIPO, it has not acceded to the Banjul Protocol on Trade Marks.

### **Application**

An application is filed with the Industrial Property Institute (IPI) headed by the Director-General and operated under the supervision of the Ministry of Industry and Commerce.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (notarised) in Portuguese
- list of goods or services for which registration is sought
- electronic print of the mark
- transliteration and translation of words in little-known characters, where relevant
- priority declaration (where applicable)
- certified copy of the priority document (where applicable), in Portuguese.

**Examination/procedure**

An application is initially examined as to formal requirements only. If formal compliance is established, the application is published in the Industrial Property Bulletin issued by the IPI. If no opposition is filed, the mark will undergo a substantive examination. A registration certificate will be issued if there are no grounds to refuse registration, or if any grounds that the Director General has raised have been cleared.

**Opposition**

The Code makes provision for opposition within 60 days from publication, which period may be extended only once for a maximum of 60 days upon application.

**Opposition proceedings**

An opposition, setting out the facts and law that support it, is lodged with the IPI. The IPI must then send a copy of the opposition to the applicant, who must respond thereto within 30 days (which period may be extended only once upon application). If the applicant does not respond within the 30 days, he will be deemed to have abandoned his application.

After all interested parties have been heard, the Director General shall make a decision and inform the interested parties thereof. Any of the parties may appeal to the court against this decision.

**Grounds for opposition**

The grounds for opposition include:

- that the mark is not capable of distinguishing the products or services of one enterprise from those of another
- that the mark is contrary to law or offends against public order and morality or *bonos mores*
- that the mark is capable of misleading consumers or the public in regard to the specific characteristic features of the product or service to which the mark relates, namely the geographical origin, the nature or the characteristics of the products or services in question
- that the mark reproduces, imitates or contains features of coats of arms, flags, emblems, coins, escutcheons, shields, abbreviations or other official symbols belonging to a state, municipalities, other national or foreign public entities or intergovernmental organisations, save as authorised by such state or organisation
- that the mark reproduces official badges, stamps and seals relating to any inspection and warranty, or private emblems or the name of the Red Cross or other similar organisations
- that the mark is identical or similar to a mark of high renown or a mark that is well known in Mozambique
- that the mark reproduces or imitates the characteristic elements of other distinctive signs of trade registered in Mozambique
- that the mark constitutes a generic, common, ordinary or simply descriptive feature of the products or services for which protection is sought

- that the mark is identical to or imitates a mark that has already been registered in Mozambique or has an earlier date of filing, belonging to a different proprietor for the same products or services
- that the mark wholly or essentially constitutes a reproduction, imitation or translation of another mark that is well known in Mozambique, if it is used for identical or similar products or services and is liable to create confusion therewith (a mark is considered a well-known mark when it is well known among the interested public as a result of promotion of the mark in Mozambique)
- that the mark, although used on products or services that are not identical or similar, wholly or essentially constitutes a reproduction, imitation or translation of another mark that enjoys high renown in Mozambique or in the world, and use of the mark intends to take undue advantage of, or may be detrimental to, the distinguishing character or renown of the mark
- that the mark consists exclusively of a shape which results from the nature of the product or which is necessary to obtain a technical result or which gives the product its substantial value
- that the mark consists exclusively of an indication which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, means of production or rendering of a service, or other characteristics of the goods or services
- that the mark consists exclusively of signs or indications which have become customary in the current language or in *bona fide* and established trade practices
- that the mark consists of a colour or colours, unless combined with other graphic elements or wording which are distinctive
- that the mark is such that the applicant intends to practise unfair competition or that this is possible, irrespective of the applicant's intention.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the filing date of the application, and is thereafter renewable for like periods of 10 years. Payment of renewal fees should take place within the six months preceding expiry of the 10 year period, but a grace period of six months from expiry is allowed for effecting renewal, upon payment of a surcharge.

The Code also has a general provision to the effect that the proprietor of an industrial property right who, through no fault of his own and despite all diligence, has been unable to meet a deadline which could affect the validity of the right, to have his right restored on application. The application must be submitted within two months of the cessation of the hindrance, and not more than one year after the missed deadline, and must set out fully the relevant reasons.

### **Cancellation/removal of a trade mark**

An interested person can apply to court for the annulment of a trade mark registration within one year of the date of grant, and for the reversal of the right in his/her favour, provided circumstances permit this.

In addition, any interested party may apply to court to invoke the nullity of a trade mark registration at any time.

### **Grounds for cancellation/removal of a trade mark**

The grounds to invoke the nullity of a trade mark registration include:

- that the subject matter is not protectable
- that the requirements and formalities of the legislation were not followed
- that the rules of public order and morality have been violated
- that the mark wholly or essentially constitutes a reproduction, imitation or translation of another mark that is well known in Mozambique, if it is used for identical or similar products or services and is liable to create confusion
- that the mark, although used on products or services that are not identical or similar, wholly or essentially constitutes a reproduction, imitation or translation of another mark that enjoys high renown in Mozambique or in the world, and use of the latter mark intends to take undue advantage of, or may be detrimental to, the distinguishing character or renown of the mark.

### **Use requirement and cancellation**

The Code is silent on the issue of non-use of a trade mark after registration, and this is not currently a ground for cancellation *per se*. The Code does, however, require the proprietor of a registered mark to file a declaration of intention to use the mark every five years, starting from the date of registration. This declaration must be filed between six months before and after expiry of the relevant five year period. If no such declaration is filed, the mark will not be enforceable against third parties, and the Director General shall declare the lapse of the registration at the request of any interested party. If there is no such request, the mark will once again become effective when the declaration is filed and proof of use is supplied.

### **Assignment**

Assignment of any or all of the rights acquired by registration is possible, with or without transfer of the goodwill of the business. All transfers of rights must be noted on the certificate of grant.

Requirements for recordal:

- power of attorney (notarised), in Portuguese
- deed of assignment (notarised), translated into Portuguese.

**Licensing/registered users**

Voluntary licences and registered users are recognised. Recording of licences or registered users at the IPI is required in order to have effect against third parties.

Requirements for recordal:

- power of attorney (notarised), in Portuguese
- copy of the licensing contract (notarised), translated into Portuguese.

**Amendment**

An application may be amended in respect of the applicant and/or the goods and/or services for which registration is sought. An applicant may also withdraw his application at any time while it is pending by addressing a letter of request to the IPI. An amendment must be published in the Industrial Property Bulletin.

**Rights conferred by registration**

Registration of a mark confers upon its proprietor the right to the exclusive use of the mark, and the right to prohibit third parties from using in the course of their business, without the proprietor's consent, identical or similar signs for products or services identical or similar to those in respect of which the mark was registered, where such use would be capable of leading to confusion.

**Trade mark infringement**

Any person who uses a registered trade mark in the course of business without the proprietor's consent, commits an infringement.

Further specific offences are listed in the Code including:

- totally or partially counterfeiting or reproducing a registered mark without authorisation from the proprietor
- changing the registered mark of another already placed on products on sale in the market
- using counterfeit or imitated marks
- using, reproducing or imitating well-known marks or marks of high renown
- using a mark to identify products or services different from those of the proprietor of the registered mark, in such a way as to deceive consumers as to the origin of the products or services
- exporting or importing, selling or putting on sale or into circulation products or articles with a mark that is counterfeit, imitated or used under the circumstances mentioned in the preceding sub-paragraphs.

**Defences to trade mark infringement**

The defences to trade mark infringement include:

- *bona fide* use from a date prior to the date of filing or priority of the registration (unless the user failed to lodge an opposition to the registration of the mark)
- that the items were put on the market in Mozambique by the proprietor or with the proprietor's consent.

**Relief for trade mark infringement**

Both civil and criminal proceedings are available. Criminal proceedings envisage the payment of fines. Seizure of infringing goods is also possible.

**Common law rights**

The Decree recognises *bona fide* prior user rights, by providing that such users will have a preferential right to register the mark in certain circumstances.

**Marking of goods**

The marking of goods, by using the words '*marca registrada*' or the symbol ® thereon, is optional.

**PATENTS****Law**

- Decree no 4 of 2006 on Industrial Property Code

Mozambique is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

**Patent protection**

Patent protection is available via a national filing or an ARIPO or a PCT application designating Mozambique. Mozambique has implemented both the PCT and the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving enforceable rights to patents obtained via ARIPO and the PCT.

Foreign applicants must be represented by an accredited local agent.

**Types of patents**

Provision is made for:

- conventional patents in respect of an invention which is new, inventive and industrially applicable
- divisional patents, where the initial application contains more than one invention
- utility models in respect of an invention that is new, significantly inventive, and capable of industrial application.

A utility model application may, before examination, be converted into an application for a patent, and *vice versa*.

**Patentable subject matter**

An invention means any idea that provides a practical solution to a particular technical problem; it may be a product or a process or both. An invention is patentable if it is new, involves an inventive activity, and is capable of industrial application.

The following are not patentable:

- scientific theories and mathematical methods
- discoveries aimed at making known or revealing something which already exists naturally, notwithstanding that it was previously unknown to man
- systems, plans, rules and methods for the performance of purely intellectual activities, playing games or economic activities
- computer program
- aesthetic creations and artistic or literary works
- presentation of information
- methods of surgical, therapeutic or diagnostic treatment applicable to the human body or animals (the products, substances or compositions used in any of such methods shall be patentable)
- substances, materials, mixtures, elements or products of any type resulting from atomic nuclear transformation, as well as the modification of their physical and chemical properties and the processes for obtaining or modifying them.

### **Types of applications**

Application for a patent may be made by way of:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date is the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Mozambique is designated
- an ARIPO application designating Mozambique
- a divisional application, where the original application covers more than one invention
- a utility model application, which may be converted into a patent application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the Industrial Property Institute (IPI) headed by the Director General. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Mozambique Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised), in Portuguese
- assignment from the inventor(s), or a declaration by the applicant justifying its right to the invention (notarised)
- copy of the specification (including claims, drawings and abstract), in Portuguese (see the **Note** below)
- certified copy of the priority document (if applicable; not required for PCT national phase applications), with Portuguese translation



**Note:** The Portuguese translation of the title and abstract are required on the day of filing, but the full Portuguese translation can be filed belatedly.

Failure to file the priority document within 60 days of the date of filing will lead to abandonment of the right to claim priority. The Code requires applicants to inform the patent office of any corresponding foreign application and to provide certain information in connection therewith. In practice, this provision is not enforced and information on corresponding foreign applications is not required by the registry.

### **Applicant**

The inventor or his successor in title may apply for a patent. An assignment document is required if the applicant is not the inventor. The Code specifically states that it shall be presumed that the applicant is entitled to grant of the patent until the contrary is proved.

### **Novelty**

An invention is new if it has no precedent in the state of the art. The state of the art comprises everything that has been published in Mozambique or in any other part of the world, orally, by use or by any other means, prior to the filing or the priority date.

### **Certain prior knowledge or publication excused**

There are two exceptions: Where inventions are published during the 12 months preceding the date of filing or the priority date (if any), novelty is deemed not to be destroyed provided –

- the disclosure of the invention was promoted by the inventor or his successors in title, to scientific or professional institutions or publications, or in competitions, exhibitions and trade fairs which are officially recognised by the government under the terms of the Paris Convention
- the disclosure was a result of obvious abuse by third parties against the inventor or his successors in title.

### **Inventiveness**

An invention is considered to involve inventive activity if, for a person skilled in the art, the result is not obvious.

### **Convention priority**

An applicant who has filed a patent application in a convention country or in any country which is a member of the World Trade Organisation is entitled to claim priority from such earlier application, provided the application is filed within 12 months from the earlier application and a certified copy of the priority document (and a Portuguese translation thereof) is filed within 60 days of the filing date in Mozambique.

In practice, it appears that there is no need to file a certified copy of the priority document or a Portuguese translation thereof for PCT national phase applications in Mozambique.

**Examination/procedure**

Applications are subjected to formal examination. The Code also makes provision for the registry to request specialised persons or regional or international institutions to conduct special examination or provide technical assistance. However, in practice, applications are subjected to formal examination only, after which they are published in the Journal for purposes of opposition.

**Opposition**

Applications are advertised after 18 months of the date of filing or the date of priority. Publication can be expedited at the request of the applicant and provisional protection is granted to the applicant from the date of publication in the Journal.

Opposition must be filed within 60 days of the date of publication with the registry. Oppositions are decided by the Director General and are subject to appeal to the courts.

**Publication**

After examination, if the Director General is satisfied that the necessary requirements have been met, he shall publish the patent for opposition purposes. Assuming no opposition is filed within the 60 days period, the patent shall proceed to grant and the applicant shall enjoy provisional protection even though the certificate of grant is not yet issued.

**Duration and maintenance**

The term of a patent is 20 years. Annual renewal fees are payable and the first and second annuities must be paid on filing. The Code states that annuities can only be paid within six months of the expiry of the last payment.

There has been some uncertainty over the base date for calculation of annuities for PCT cases in Mozambique. Until such time as an official notification is issued by the registry, it is recommended that the base date for PCT national phase applications in Mozambique is considered to be the priority date and not the international filing date. A six month grace period is available for the payment of renewal fees.

**Restoration**

Provision is made for the restoration of a patent if the annual renewal fees are not paid timeously. Applications for restoration must be filed within 12 months of the date of publication of the lapse of the patent in the Journal.

**Revocation**

Any interested person may request the courts to annul a patent within one year of the date on which it was granted, on the basis that the right to the invention belongs to him or that his rights are infringed as a result of the grant of the patent.

It is also possible for interested parties to seek revocation (nullity) of a patent in the courts on the basis that the subject matter cannot be protected, that the correct procedures were not followed, that rules of public order, safety and health have been violated, or that the rights are *contra bonos mores*. Revocation can be sought at any stage during the life of the patent and can be total or partial.

### **Assignments/licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment or licence contract (original or notarised copy), with Portuguese translation.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

The Code also provides for compulsory licences in the following cases:

- where working of the patent is necessary for reasons of public interest; this is where it is of fundamental importance to public health, national defence, and economic and technological development
- where the working of a dependent patent necessarily relies on using the subject matter of a previous patent.

### **Amendments**

Amendments prior to grant do not appear to be contemplated in the legislation. The Code does however make provision for modification of a granted patent at any stage, as long as the modification results in the limitation of the scope of protection granted to the patentee.

### **Effect of a patent**

The proprietor of a patent enjoys the following exclusive rights:

- to work the patented invention
- to dispose of the patent
- to license the patented invention
- to oppose the improper use of the patented invention.

The working of a patent includes the following acts:

- manufacture, importation, offer for sale, sale or use of the product
- storing the product for purposes of sale
- using the patented process
- carrying out the above acts in respect of a product directly derived from the process.

The rights of the proprietor do not extend to:

- use of the patented invention for scientific research
- acts related to products put on the market in Mozambique by the proprietor or with his consent.

### **Infringement**

The exploitation of the patented invention in Mozambique by any person other than the patentee or his licensee shall be considered an infringement of the patent. Proceedings for infringement are initiated in the Common Court. The Code provides for a specific amount of damages to be paid in the case of an infringement, and also provides for the granting of provisional remedies to safeguard the rights of the patentee.

### **Marking**

Marking is optional. During the validity of the patent the proprietor may use the words '*Patente numero*' or '*Pat Nr*' on the products.

### **Working**

Working of a patented invention is required within a period of four years from the date of filing, or three years from the grant of the patent, whichever occurs later. Failure to work the patent may lead to the granting of a non-exclusive, compulsory licence to interested third parties

### **Utility models**

The Decree provides for the registration of utility models in respect of inventions that are new, involve a significant inventive activity, and are industrially applicable. A utility model has a duration of 15 years from the date of filing, subject to payment of annuities.

At any time before the examination of a utility model, the application may be converted to a patent application. A patent application may likewise be converted to an application or a utility model.

## **DESIGNS**

### **Law**

- Decree no 4 of 2006 on Industrial Property Code

Mozambique is a member of the Paris Convention, ARIPO (Harare Protocol) and the WTO/TRIPS.

### **Design protection**

Design protection is available by a national filing or via an ARIPO application designating Mozambique. Mozambique has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving effective protection to ARIPO designs in Mozambique.

**Registrable subject matter**

An industrial design means any combination of lines or colours or three-dimensional form, which gives a new and original appearance to a product or part of a product and which may serve as a model for the industrial manufacture thereof or the manufacture by artisans.

**Classification of designs**

The Locarno International Classification of Designs is not applied.

**Types of applications**

Application for registration may be filed as:

- a non-convention application
- a convention application, with a claim to convention priority
- an ARIPO application designating Mozambique.

**Application**

Non-convention and convention applications are filed with the office of the Industrial Property Institute (IPI), headed by the Director General. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Mozambique designs office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must be represented by a local agent.

It is possible for a single application to include two or more designs, provided they are in the same class or they make up one whole or a single composition of industrial objects.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised)
- assignment from the creators or a declaration by the applicant justifying his right to the design (if applicable; notarised), in Portuguese
- suitable graphic representations of the design
- certified copy of the priority document (if applicable), with Portuguese translation thereof.

Failure to file the priority document within 60 days of the date of filing will lead to abandonment of the right to claim priority.

Applications must be completed within 15 months or they will be considered to be abandoned, unless the delay in completing the application was not due to the default or negligence on the part of the applicant.

**Applicant**

The design belongs to the author or creator thereof, and he or his assignee may file an application.

### **Convention priority**

Any person who has filed an application for an industrial design in any country which is a member of the Paris Convention, or in any member of the World Trade Organisation or ARIPO, shall enjoy the right to claim priority for the purpose of filing an application for registration of an industrial design in Mozambique. The application must be filed within six months from the earlier application, and a certified copy of the priority document must be submitted as proof of the claim to priority.

### **Novelty**

A design is new if it has not been disclosed by means of publication in a tangible form, nor used in any other way, prior to the date of filing or the priority date, if any, of the application for registration.

A design is not new if:

- it has been registered before (even if the registration is invalid or has lapsed)
- if the design has been described in a publication in such a way as to make it capable of being known and worked by experts in the field
- if the design has been used in a well-known manner, or has become part of the public domain.

### **Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements. If satisfied that the conditions for registration have been met, the Registrar shall publish the applications. It is possible to request that publication be delayed.

The publication of the application shall provisionally confer on the applicant all the rights which he would enjoy on registration of the design.

### **Opposition**

Opposition must be filed with the registry within 60 days of the date of publication. Oppositions are decided by the Director General and are subject to appeal to the courts.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible for further terms, upon payment of renewal fees, for a maximum period of 25 years.

Annual renewal fees are payable and the first and second renewal fees must be paid on filing. The Code states that renewal fees can only be paid within six months of the expiry of the last payment. A six month grace period is available.

ARIPO designs are, however, only valid for 10 years and are subject to payment of annual maintenance fees. ARIPO also has a six month grace period for payment of renewal fees.

### **Restoration**

The Code has a general provision to the effect that the proprietor of an industrial property right who, through no fault of his own and despite all diligence, has been unable to meet a deadline which could affect the validity of the right, to have his right restored on application. The application must be submitted within two months of the cessation of the hindrance, and not more than one year after the missed deadline, and must set out fully the relevant reasons.

### **Revocation**

The Code has a general provision that interested persons may apply for the annulment of an industrial property right. The annulment may be sought on the basis that the registration was obtained in contravention of the person's rights.

Provision is also made for an interested party to apply for annulment on the ground that the subject matter did not meet the requirements for protection, or violated public rights.

### **Assignments and licences**

The right to a design may be transferred or licensed. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment or licence contract (original or notarised copy), with Portuguese translation.

### **Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

### **Rights conferred by registration**

A registered design gives the proprietor the right to prevent any third party from working the design, namely producing, manufacturing, selling or working the subject matter of the design. The proprietor also has the right to take judicial action against any person who infringes the exclusive rights of the proprietor.

### **Infringement**

The exploitation of a registered design in Mozambique by any person other than the owner or his licensee shall be considered an infringement of the registered design. Proceedings for infringement are initiated in the Common Court. The Code provides for a specific amount of damages to be paid in the case of an infringement, and also provides for the granting of provisional remedies to safeguard the rights of the owner of the design.

**Marking**

Marking is optional but advisable. The proprietor may use the words '*Desenho numero*' or the abbreviation '*D.Nr*'.

**Working**

Inasmuch as certain provisions relating to patents have also been made applicable to designs, it seems that working of a design is required within a period of four years from the date of filing, or three years from the registration of the design, whichever occurs later. Failure to work the design may lead to the granting of a non-exclusive, compulsory licence to interested third parties.

**COPYRIGHT****Law**

- Copyright Law no 4 of 2001
- Ministerial Decree no 8 of 2003

Mozambique is not a member of the Berne Convention; it is a member of WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law provides for copyright in respect of literary, artistic and scientific works, that are original intellectual creations in the literary, artistic and scientific fields, including:

- written works, including computer programs
- lectures, addresses, sermons and other works consisting of words expressed orally
- musical works
- dramatic and dramatico-musical works
- choreographic works, mimed works
- audiovisual works
- works of fine art, including painting, drawing, sculpture, engravings, lithographs
- works of architecture
- photographic works
- works of applied art or craft
- illustrations, maps, plans, sketches, three-dimensional works relating to geography, topography, architecture
- expressions of folklore.



The Decree also applies to derived works which constitute intellectual creations, namely

- compilations of works
- translations, adaptations, arrangements of works.

### **Exclusions from copyright**

Excluded from protection are:

- daily news and accounts of events purely for information
- official texts of a legislative, administrative or judicial nature
- simple facts and data
- ideas, processes, operational methods, mathematical concepts.

### **Registration of copyright**

No requirement for registration. Copyright commences on the creation of the work.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author must be a Mozambican citizen or resident, or the work must have been first published in Mozambique. Since Mozambique is not a member of the Berne Convention, copyright protection is not extended to works eligible under such treaty.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author.

### **Duration of copyright**

Copyright generally endures for the lifetime of the author plus 70 years as regards the economic rights entailed therein. The copyright in an audiovisual work is protected for 70 years after the publication of the work, and a work of applied art is likewise protected for 70 years after completion.

### **Protection afforded by copyright**

Copyright comprises rights of an economic character and rights of a personal nature. Copyright confers on the copyright owner the following economic rights, namely the exclusive right to authorise the following acts:

- to reproduce the work
- to translate the work
- to prepare adaptations, or arrangements, or transformations of the work
- to make copies available for sale to the public
- to present or perform the work in public
- to import or export copies of the work
- to communicate the work to the public, for broadcasting.

The Law also confers the following personal rights on the author, including:

- the right to certain authorship of the work
- the right to remain anonymous

- the right to object to any distortion, mutilation or modification of the work that might be prejudicial to his honour or reputation.

#### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed. The non-economic or personal rights are not transferable.

#### **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Mozambique.

# NAMIBIA

## GENERAL INFORMATION

The independent Republic of Namibia, which gained independence from South Africa in 1990, is situated on the south west coast of Africa, bordered by the Atlantic Ocean to the west; South Africa to the south and south east; Botswana to the east and Angola to the north. The Caprivi Strip extends Namibia to the Zambezi River, forming a border with Zambia.



<b>Area:</b>	824 268 km <sup>2</sup>
<b>Population:</b>	22 million
<b>Capital:</b>	Windhoek
<b>Currency:</b>	Namibian Dollar
<b>GDP:</b>	\$ 14.64 billion (2010)
<b>Internet domain:</b>	.na
<b>Languages:</b>	English (official language), Afrikaans, German, Khoekhoe (Nama), Herero, Ovambo.
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Diamonds; copper; gold; zinc; lead; uranium; cattle; processed fish; karakul skins
<b>Imports:</b>	Foodstuffs; petroleum products and fuel; machinery and equipment; chemicals

## International/regional conventions

Namibia is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 2004)
- Berne Convention (since 1990)
- Hague Agreement on Designs (since 2004)
- Harare Protocol (of ARIPO) (since 2004)
- Lusaka Agreement (ARIPO) (since 2003)
- Madrid Agreement on Marks (since 2004)
- Madrid Protocol on Marks (since 2004)
- Paris Convention (since 2004)
- Patent Cooperation Treaty (since 2004)
- WIPO Convention (since 1991)
- WTO/TRIPS (since 1995)

## IP legislation

**Note:** An Industrial Property Bill on Patents, Utility Models, Industrial Designs and Trade Marks was introduced in the National Assembly on 6 April 2010 by the Ministry of Trade and Industry. Once enacted into law and implemented, it will repeal the Patents, Designs, Trade Marks and Copyright Act no 9 of 1916; the Patents, Designs and Trade Marks Proclamation no 17 of 1923; the Patents, Trade Marks and Copyright Proclamation no 33 of 1940; and the Trade Marks in South West Africa Act no 48 of 1973.

### Trade marks

- Trade Marks in South West Africa Act no 48 of 1973
- Trade Marks in South West Africa Regulations, 1973

### Patents

- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Patents, Designs and Trade Marks Proclamation no 17 of 1923
- Patent Rules, 1917

### Designs

- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Patents, Designs and Trade Marks Proclamation no 17 of 1923
- Designs Rules, 1917

### Copyright

- Copyright and Neighbouring Rights Protection Act no 6 of 1994
- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Copyright Rules, 1917

## TRADE MARKS

### Law

- Trade Marks in South West Africa Act no 48 of 1973
- Trade Marks in South West Africa Regulations, 1973

Namibia is a member of the Paris Convention, the Madrid Agreement and Protocol, the ARIPO (Banjul Protocol), and the WTO/TRIPS.

As indicated above (see the **Note** under **IP legislation** above), Namibia is soon to have a new Industrial Property Act, which will provide for the Paris Convention, ARIPO (Banjul Protocol) and the Madrid Agreement and Protocol. However, this Act has not yet been enacted or implemented. Trade mark applications are still processed under the existing legislation.

### Trade mark protection

Provision is made for the registration of trade marks for goods and for services, for certification marks, and for defensive trade marks. The Act provides for a Part A and a Part B of the register. In order to be registrable in Part A of the register, the mark must be or contain a distinctive mark, while for registration in Part B the mark must be capable of becoming distinctive through use.

### Protection of well-known marks

No express provision is made for well-known marks, except the provision for the registration of a defensive mark (see the section on **Registration of a defensive mark** below).

### Advantages of trade mark registration

The registration of a trade mark gives the owner the right to authorise other persons to use the trade mark, in the course of trade, in respect of the relevant goods and/or services.

Unless a trade mark is registered, the owner will not have the right to institute court proceedings against persons who use the mark without his authority.

### **Types of trade marks**

The Act provides for the registration of the following marks:

- trade marks for goods
- trade marks for services
- certification marks
- defensive marks.

### **Definition of a mark**

A mark is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof, or a container for goods.

### **Definition of a trade mark**

A trade mark is defined as a mark intended to be used, in the course of trade, in respect of goods or services, so as to:

- indicate a connection between the goods or services and a person who has the right, either as owner or as register user, to use the mark
- distinguish the goods or services in respect of which the mark is used from the same or similar goods or services connected with another person.

### **Definition of a certification trade mark**

A certification mark is a mark suitable to be used in the course of trade in respect of goods or services certified in regard to origin, material, method of manufacture, quality, accuracy or any other characteristic, from goods or services not so certified. Certification marks are registrable in Part A of the register.

### **Registration of a defensive trade mark**

A defensive trade mark may be registered where a trade mark is already registered in Part A of the register in respect of specified goods or services, and it has been used so extensively that there is a likelihood that the use of the mark by another person in respect of different goods or services would indicate a connection with the owner of the registered mark and/or goods or services originating from such owner. The owner may then register the mark (defensively) also in respect of such other goods or services, without the intention of using the mark in regard to such other goods or services.

### **Limitation to colour**

The Act provides that a trade mark may, in its entirety or in part, be limited to a specific colour or colours. This feature will be taken into account in determining its distinctiveness.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A separate application has to be filed for each class.

**Convention priority**

Although the Act makes no express reference to the claiming of priority rights, Namibia has recently acceded to the Paris Convention. The Namibian Constitution contains a provision to the effect that international treaties to which Namibia has acceded will have legal effect, whether supported by local legislation or not. Therefore, it is expected that priority rights should be recognised.

Furthermore, no provision is made in the Act for the recognition of trade mark applications filed and registered in terms of the Banjul Protocol of ARIPO and designating Namibia. Since Namibia has acceded to the Banjul Protocol, the validity of such registrations is uncertain.

**Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic prints of the mark
- list of goods and services to be covered
- priority document (if applicable, in case priority rights are recognised).

**Examination/procedure**

Applications are examined as to formalities as well as on relative and substantive grounds. If the mark is found to be in compliance with the requirements, it is accepted and the applicant must have it published in the Official Journal.

**Opposition**

Any interested person may, within two months from the date of publication, lodge a notice of opposition to the registration of a trade mark. Extension of the opposition period is requested from the Registrar, and is granted at his discretion.

**Opposition proceedings**

Opposition proceedings are prescribed by Regulation. A notice of opposition is lodged, which contains a statement of the grounds on which the opponent objects to the registration. The applicant for registration has one month after the notice of opposition is served to file his counter-statement, stating the grounds upon which he defends the application.

Informal opposition proceedings may then follow. After the lodgement of the notice of opposition and the counter-statement, the Registrar shall, if both parties have consented by lodging a prescribed form within one month, simply consider those documents and all the relevant facts and make a decision.

Alternatively, formal opposition proceedings may follow the filing of the counter-statement. If either party fails to lodge the prescribed form within one month, consenting to informal proceedings, the Registrar shall advise all interested parties and formal proceedings will commence.

Within two months after the Registrar has advised the parties of the commencement of formal proceedings, the opponent must file and serve his evidence. Within two months thereafter, the applicant must file and serve evidence. Within one month thereafter, the opponent must file and serve evidence in reply.

The Registrar shall, upon completion of the delivery of evidence, give notice to the parties of a date for the hearing of the opposition proceedings.

### **Grounds for opposition**

Both absolute and relative grounds of opposition are available.

These include that –

- a mark which is reasonably required for use in the trade shall not be registered
- in order to be registered, a mark must be distinctive, ie it must be adapted, in relation to the goods or services in respect of which it is registered or proposed to be registered, to distinguish goods or services with which the proprietor of the trade mark is connected in the course of trade, from the goods or services in the case of which no such connection subsists
- a trade mark may not contain any of the following:
  - the arms or seal of the territory
  - any word, letter or device indicating Government patronage
  - any mark specified as being a prohibited mark
- a trade mark may not contain any matter, the use of which would be likely to deceive or cause confusion, or would be contrary to law or morality, or would be likely to give offence or cause annoyance to any person or class of persons, or would otherwise be disentitled to protection in a court of law
- a trade mark shall not be registered if it so resembles a trade mark belonging to a different proprietor and already on the register, that use of both such trade marks in relation to goods or services in respect of which they are sought to be registered, would be likely to deceive or cause confusion.

The Act further provides that, where separate applications are made by different persons to be registered as proprietors of trade marks, which so resemble each other that the use of such trade marks in relation to goods or services in respect of which they are respectively sought to be registered, would be likely to deceive or cause confusion, the Registrar may refuse to register any of the trade marks until the rights of those persons have been determined by him, or have been settled by agreement in a manner approved by the Registrar.

### **Duration and renewal**

A trade mark registration under the 1973 Act endures for a period of 10 years, which period may be extended for further 10 year periods upon payment of renewal fees. In the case of trade marks registered under the previous (repealed) legislation, the validity period is 14 years, extendable by similar periods.

If the renewal fee is not paid within the prescribed period, the Registrar may cancel the registration. Provision is made for the restoration of such a cancelled registration.

### **Cancellation/removal of a trade mark**

A registered trade mark may, on application to the court or the Registrar by any person aggrieved, be removed from the register in respect of any goods or services in respect of which it is registered.

Any person aggrieved by the non-insertion in, or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply to the court or the Registrar for an order making, expunging or varying the entry.

### **Grounds for cancellation/removal of a trade mark**

A trade mark registration may be invalidated and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds for opposition** above), in addition to the following:

- that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used by him in relation to those goods or services, and that there has in fact been no *bona fide* use thereof in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application
- that up to the date one month before the date of the application, a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods or services by any proprietor thereof for the time being
- in the case of a trade mark registered in the name of a body corporate, or in the name of a natural person, and such body corporate has been dissolved or such natural person has died, the trade mark can be removed from the register, provided that such demise or dissolution took place not less than two years prior to the date of the application and that no application for registration of an assignment of such trade mark has been made.

### **Use requirement and cancellation**

A trade mark registration can be cancelled if the mark was registered without any *bona fide* intention on the part of the applicant to use it as a trade mark (see the section on **Grounds for cancellation/removal of a mark** above).

Secondly, non-use of a registered trade mark for a continuous period of five years or longer could result in the cancellation of the mark. Permitted use of the mark can be relied on as use by the proprietor, provided the third party has been recorded as a registered user.



**Assignment**

Assignment of a registered trade mark is permitted with or without the goodwill of the business. Assignment must be recorded in order to be binding on third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment.

**Licensing/registered users**

Voluntary licensing and registered users are recognised. Recording is required in order to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- licence agreement.

**Amendment**

There is provision for the amendment of a trade mark application and/or registration.

The following amendments are allowed:

- changing the name and/or address of the proprietor
- altering the goods and/or services
- cancelling the registration
- altering the trade mark (provided that the amendment does not materially affect its identity).

Requirements for amendment:

- supporting document, eg affidavit, certificate of change of name and/or statement of case setting out the nature of the applicant's interest
- copies of the mark as it will appear when altered.

**Rights conferred by registration**

The registration of a trade mark confers on the owner the right to authorise the use of the mark, and the right to institute proceedings against any person who infringes the trade mark by using it, in the course of trade, without the necessary authorisation.

**Trade mark infringement**

The Act provides for two types of infringement:

- unauthorised use as a trade mark, in relation to goods or services in respect of which the trade mark is registered, of a mark so closely resembling the registered mark as to be likely to deceive or cause confusion
- unauthorised use in the course of trade, otherwise than as a trade mark, of a mark so closely resembling the registered mark as to be likely to deceive or cause confusion, if such use is in relation to, or in connection with, goods or services for which the trade mark is registered and is likely to cause injury or prejudice to the proprietor of the trade mark.

It is provided, however, that in the case of a trade mark registered in Part B of the register, no interdict or other relief shall be granted if the defendant establishes to the satisfaction of the Court that the use of which the proprietor of the registered trade mark complains is not likely to be taken as indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as registered user to use the trade mark.

### **Defences to trade mark infringement**

The following defences can be relied upon in infringement proceedings:

- the proprietor or a registered user cannot interfere with or restrain the use by any person of a trade mark identical with or closely resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior to the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title
- no registration of a trade mark shall interfere with any *bona fide* use by a person of his own name or of the name of his place of business, or the name of any of his predecessors in business, or of the name of any predecessor's place of business
- no registration of a trade mark shall interfere with the use by any person of any *bona fide* description of the character or quality of his goods or services.

### **Relief for trade mark infringement**

A successful applicant is usually entitled to the following relief:

- an interdict (injunction) ordering the respondent to refrain from further infringement
- delivery-up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part
- damages.

### **Common law rights**

The Act recognises rights acquired by the use of a trade mark, without registration of the mark; such use constitutes a defence in an infringement action (see the section on **Defences to trade mark infringement** above).

### **Marking of goods**

Marking of goods to indicate that the trade mark is registered is optional, but is advisable.

## PATENTS

### Law

- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Patents, Designs and Trade Marks Proclamation no 17 of 1923
- Patent Rules, 1917

Namibia is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### Patent protection

At the time of writing, patent protection is obtainable via a national filing in Namibia in terms of the 1923 Proclamation. This Proclamation does not provide for priority rights in terms of the Paris Convention, nor for ARIPO applications designating Namibia, nor for PCT national phase applications. In the meanwhile, Namibia has acceded to the Paris Convention, to ARIPO and the Harare Protocol, and to PCT. Namibia is expected soon to have a new Act, which is currently before the Namibian parliament and which will provide for the Paris Convention, ARIPO and PCT. However, this legislation has not yet been implemented. Accordingly, patent applications are still being processed under the old legislation.

Despite this, the Namibian Patent Office is accepting the filing of convention and PCT national phase applications. However, the validity of any patents granted on this basis is uncertain in the light of the absence of local enabling legislation. Nevertheless, the Namibian Constitution does contain a provision which indicates that any international treaties which are signed by Namibia will have legal effect, whether supported by local legislation or not.

### Types of patents

The 1923 Proclamation only refers to patents for inventions which are new, useful and capable of being used in trade or industry. However, since the 1916 Act provided for patents of addition, such patent could arguably also be available in Namibia.

### Patentable subject matter

An invention means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement thereof, capable of being used or applied in trade or industry. However, if the invention is contrary to law, public order or good morals, it is not patentable.

### Types of applications

Application for a patent may be made in the following manner:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date is the priority date of the first-filed application under the Paris Convention (see the section on **Patent protection** above)

- a national phase application based on an international application under the PCT in which Namibia is designated (see the section on **Patent protection** above)
- an ARIPO application designating Namibia (see the section on **Patent protection** above)
- an application for a patent of addition to cover improvements or amendments to the invention of the original patent (see the section on **Types of patents** above).

### **Application**

Non-convention, convention and PCT national phase applications are filed at the office of the Registrar of Patents. Foreign applicants must provide a local address for service and may be represented by a local agent. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Namibian Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of invention from the inventors (if applicable)
- copy of the specification (including claims, drawings and abstract) in English.

### **Applicant**

The inventor or his successor in title may apply for registration. An assignment document is required if the applicant is not the inventor.

### **Novelty**

An invention is new if, at the filing date, the following three criteria are satisfied:

- the invention is not known by others in Namibia
- the invention has not been used by others in Namibia
- the invention has not been on sale for more than two years in any country outside Namibia.

If a patent application is filed for an invention in Namibia within 12 months of filing a patent application for the same invention in another country, any disclosure of the invention after the filing date of the foreign application, but before the filing date of the Namibian application, will not be taken into account when assessing the Namibian application's novelty.

### **Certain prior knowledge or publication excused**

The novelty of an invention is not destroyed by the exhibition of the invention at an international or industrial exhibition, certified as such by the Minister; the publication of a description of the invention during the time of any such exhibition; the use of the invention for the purposes of the exhibition at the

place where it is held; or the use of the invention during the time of the exhibition at another place, by someone not authorised by the inventor, provided that:

- the exhibitor, prior to exhibiting his invention, informs the Registrar in the prescribed manner of his intention to do so, and
- an application for a patent is made within six months from the opening of the exhibition.

The novelty of an invention is also not destroyed by the publication thereof, prior to the filing date of the application, without the patentee's knowledge or consent, provided that the matter published was derived or obtained from the patentee, and that the application was filed with reasonable diligence after learning of the disclosure.

### **Convention priority**

The 1923 Proclamation does not make any provision for priority to be claimed. However, in practice applications claiming priority are accepted by the Namibian Patent Office (see the section on **Patent protection** above). See also the section on **Novelty** above regarding the 12 month period from filing a patent application in another country during which publication will be excused.

### **Examination/procedure**

Applications are subjected to formal examination. If the formal requirements are satisfied, a patent will be granted in due course.

### **Opposition**

The Proclamation makes provision for the filing of an opposition within two months after the publication of the acceptance of the complete patent specification. It is possible to file an opposition after the two month period has expired, subject to the Registrar's discretion.

Grounds for opposition include (amongst others):

- that the invention lacks novelty
- that the invention has been fraudulently obtained to the prejudice of another's rights
- that the invention does not fall within the definition of 'invention' (see the section on **Patentable subject matter** above)
- that the complete specification does not sufficiently disclose or explain the invention or the manner in which it is to be performed
- that the invention or the application is contrary to law, public order or good morals.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall instruct the applicant to publish the acceptance of the complete patent specification. If no opposition is received, or if any opposition is successfully overcome, the patent shall be granted upon the payment of the prescribed fee.

**Duration and maintenance**

The term of a patent obtained in terms of Namibia's national legislation is 14 years. This term is, however, extendable upon application at least six months before the expiration of the patent, if it can be proved that the patentee has been inadequately remunerated. Renewal fees are payable at the end of the third, seventh and tenth years from the filing date. A three month grace period is available.

**Restoration**

Provision is made for the restoration of a patent if the renewal fees are not paid timeously. Applications for restoration are advertised for purposes of opposition.

**Revocation**

An application for revocation of a patent may be made by a petition to the court on any of the grounds on which the grant of the patent might have been refused (see the section on **Opposition** above). The petition may be presented by:

- any person who alleges that the patent has been obtained in fraud of his rights or the rights of any person under or through whom he claims
- any person who alleges that he, or any person under or through whom he claims, was the inventor of the claimed invention
- any person who alleges that he, or any person under or through whom he claims, has an interest in any trade, business, or manufacture and has publicly manufactured, used or sold within Namibia, before the filing date of the patent, the claimed invention
- the Minister of Justice or any person authorised by him.

**Assignments and licences**

Assignments and voluntary licences are recognised. Assignments must be recorded to be effective against third parties. Licences must also be entered in the register.

Requirement for recordal:

- power of attorney (simply signed)
- original and certified copy of the deed of record.

**Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

**Amendments**

Amendments are allowed; however, the claims of an amended specification must fall wholly within the scope of the claims before the amendment. A request for amendment of a complete specification shall be published for purposes of opposition, and no amendment of a patent, which is the subject of any infringement or revocation proceedings, is allowed.

**Effect of a patent**

Registration of a patent affords the owner the right to authorise the exploitation of the patented invention, and the right to institute proceedings against a party who infringes the patent.

**Infringement**

The exploitation of a patented invention in Namibia by any person other than the patentee or his licensee shall be considered an infringement of the patent. Remedies include an interdict and damages. However, no damages can be claimed until after the date of publication of the acceptance of the complete specification. Furthermore, damages shall also not be recoverable if, at the date of infringement, the defendant was not aware, or had no reasonable means of making himself aware, of the existence of the patent.

**Working**

Working of the patented invention is required within a period of two years from the grant of a patent. Failure to work the patent may lead to the granting of a compulsory licence to interested third parties or, in the alternative, to the revocation of the patent. A revocation order will not be granted, however, until three years after grant.

**DESIGNS****Law**

- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Patents, Designs and Trade Marks Proclamation no 17 of 1923
- Designs Rules, 1917

Namibia is a member of the Paris Convention, ARIPO (Harare Protocol), the Hague Agreement, and the WTO/TRIPS.

**Design protection**

In terms of the 1923 Proclamation, design protection is obtainable via a national filing in Namibia. As indicated above, in the section on **PATENTS**, Namibia is expected soon to have a new Act, which will provide for the Paris Convention, the Hague Agreement and ARIPO. However, this Act has not yet been promulgated, and applications are therefore still being processed under the old legislation (see the section on **Types of applications** below).

**Registrable subject matter**

A design means features of shape, configuration, pattern and/or ornament applied to an article by whatever means, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whether manual, mechanical, or chemical, separate or combined, not being a design for a sculpture.

**Classification of designs**

The Act requires the applicant to specify the class in which the application must be registered. Goods are classified in the manner appearing in a schedule which is attached to the 1923 Proclamation.

### **Types of applications**

The 1923 Proclamation makes provision only for a national application. Although Namibia has in the meanwhile become a member of the Paris Convention, the Hague Agreement and ARIPO (Harare Protocol), the Proclamation does not provide for priority rights in terms of the Paris Convention, nor for ARIPO applications designating Namibia, nor for international applications via the Hague agreement. As indicated above, Namibia is expected soon to have a new Act, which will provide for Paris Convention, ARIPO and the Hague Agreement. However, it has not yet been implemented.

Accordingly, design applications are still being processed under the old legislation. Despite this, the Namibian Designs Office is accepting the filing of convention applications. However, the validity of any designs granted on this basis is uncertain in the light of the absence of any local enabling legislation. The Namibian Constitution does contain a provision which indicates that any international treaties which are signed by Namibia will have legal effect, whether supported by local legislation or not.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Namibian Designs Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

Foreign applicants must provide a local address for service and may be represented by a local agent.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- representations of the design
- statement of novelty.

Separate design applications must be filed for each class in which protection is required. An application for registration of a design already registered abroad must be filed within four months of the first foreign registration and must include the date and number of that registration. (Although this provision was repealed in 1947 in respect of applications in South Africa, it is not clear whether the provision still applies in Namibia.)

If applications are not completed within 12 months, the Registrar shall give written notice thereof to the applicant and his agent. If the application is not completed within 14 days from the date on which the notice was sent, the application shall be deemed to be abandoned. The Registrar may extend the 14 day period under certain circumstances.



**Applicant**

The author or creator, or his assignee, may apply for registration.

**Convention priority**

Convention priority cannot be claimed under current legislation. However, see the section on **Application** above regarding the four month period from filing a first design application in another country.

**Novelty**

The design must be new or original and must not have been previously used or described in any printed publication in Namibia.

The exhibition at an international or industrial exhibition, certified as such by the Minister, or the exhibition elsewhere during the period of the holding of the exhibition, without the knowledge or consent of the proprietor, of a design or of any article to which the design is applied, or the publication, during any such exhibition, of a description of a design, shall not prevent the design from being registered or invalidate the registration thereof, provided that:

- the exhibitor, prior to exhibiting the design or article or publishing a description of the design, gives the Registrar the prescribed notice on his intention to do so
- the application for registration is made within six months from the opening of the exhibition.

**Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements. If satisfied that the conditions for registration have been met, the Registrar shall register the application and issue the registration certificate. If not, he shall advise the applicant of his objections and the applicant will have an opportunity to respond before a final decision is made.

**Opposition**

No provision is made for the filing of an opposition to a design prior to registration.

**Duration and maintenance**

The initial term of the design registration is five years, which term is extendible upon payment of renewal fees for two further five year terms. The term of the registration starts from the date of application for registration.

**Restoration**

No provision.

**Revocation**

A general provision allows any interested party to make an application to court, *inter alia* for an entry made without sufficient cause or wrongly remaining on the register to be expunged.

### **Assignments and licences**

Assignment and voluntary licences are recognised. Assignments and licences should be entered in the register.

Requirements for recordal:

- power of attorney (simply signed)
- proof of title (eg deed of assignment or licence contract).

### **Compulsory licences**

There is no provision for compulsory licences.

### **Rights conferred by registration**

The registered proprietor is given the right to authorise the use of the design by others, namely to apply the design or any imitation thereof to any article in the class in which the design is registered, and the right to take legal action against persons who do so without the necessary authorisation.

### **Infringement**

The application of a registered design, or a fraudulent or obvious imitation thereof, to any article for the purposes of sale by any person other than the registered proprietor, without the authority of the proprietor, is considered unlawful. Remedies include an interdict and damages.

### **Marking**

Marking is compulsory. Before being delivered on sale, articles bearing the registered design must be marked 'Registered', 'Regd', or 'Rd' and (except for articles in certain classes) with the registration number. Failure to do so precludes recovery of penalties or damages for infringement, unless the proprietor can show that he took all necessary steps for marking the articles.

### **Working**

No provision.

## **COPYRIGHT**

### **Law**

- Copyright and Neighbouring Rights Protection Act no 6 of 1994
- Patents, Designs, Trade Marks and Copyright Act no 9 of 1916
- Copyright Rules, 1917

Namibia is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- cinematograph films
- sound recordings
- broadcasts
- programme-carrying signals
- published editions
- computer programs.

Literary works are further defined to include:

- novels, stories, poetic works
- dramatic works, stage directions, film scenarios, broadcasting scripts
- textbooks, treatises, essays, articles
- encyclopaedias, dictionaries
- letters, reports, memoranda
- lectures, addresses and sermons
- tables and compilations of data.

Artistic works are further defined to include:

- paintings, sculpture, drawings, engravings, photographs
- works of architecture
- works of artistic craftsmanship.

**Requirements for subsistence of copyright**

No requirement for registration. For a work to qualify for protection, the work must, in general, be written down, recorded or otherwise reduced to material form. Further, the author must be a citizen of Namibia, or domiciled or ordinarily resident in Namibia. Alternatively, the work must have been made or first published in Namibia.

Copyright protection may also be extended, by Ministerial notice, to persons who are citizens of, or domiciled or resident in, a country which is a party of a treaty of which Namibia is also a party, and which provides for copyright protection.

**Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission (in the case of certain works) or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights are not transferable.

**Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years. In the case of all other works, the duration is 50 years from the date on which the work was made or was made available to the public.

**Protection afforded by copyright**

Copyright confers on the owner the exclusive right to control the doing in Namibia of any of the following acts:

- reproducing of the work in any material form, including the translation or adaptation thereof
- publishing the work if previously unpublished
- performing the work in public
- broadcasting the work
- causing the work to be transmitted in a diffusion service.

**Exceptions to copyright protection**

The following acts are amongst acts excluded from the rights of the owner:

- the doing of any of the listed acts by way of fair dealing for purposes of research, private study or private use
- the use of the work for purposes of criticism and review
- the use of the work for purposes of reporting on current events.

**Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

**Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

**Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

**Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, delivery-up of infringing articles, etc.

**Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith.

**PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Namibia.

# NIGER

## GENERAL INFORMATION

The Republic of Niger is completely landlocked and is bordered by Algeria and Libya to the north, Chad to the east, Nigeria and Benin to the south, and Burkina Faso and Mali to the west.



<b>Area:</b>	1 267 000 km <sup>2</sup>
<b>Population:</b>	15.3 million
<b>Capital:</b>	Niamey
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 10.5 billion (2010)
<b>Internet domain:</b>	.ne
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Uranium ore; livestock products; cowpeas; onions
<b>Imports:</b>	Materials; machinery; vehicles and parts; petroleum; cereals; foodstuffs

## International/regional conventions

Niger is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1962)
- Hague Agreement on Designs (since 2004)
- Paris Convention (since 1964)
- Patent Cooperation Treaty (since 1993)
- Rome Convention (since 1964)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1996)

## IP legislation

Niger is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country,

obtained via an OAPI application and registration procedure. In order to join OAPI, Niger had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, refer to the chapter on **OAPI**.

However, further provision was made for copyright protection by way of an executive decree:

- Decree no 93-027 on Copyright, Neighbouring Rights and Folklore.

## **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# NIGERIA

## GENERAL INFORMATION

Nigeria is an independent republic on the west coast of Africa, on the Gulf of Guinea. It is bordered by Benin to the west, Niger to the north, Cameroon to the east, and the Atlantic Ocean to the south.



<b>Area:</b>	923 768 km <sup>2</sup>
<b>Population:</b>	152.2 million
<b>Capital:</b>	Abuja
<b>Currency:</b>	Naira
<b>GDP:</b>	\$ 369.8 billion (2010)
<b>Internet domain:</b>	.ng
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Petroleum and petroleum products; cocoa; rubber
<b>Imports:</b>	Machinery; chemicals; transport equipment; manufactured goods; food and live animals

## International/regional conventions

Nigeria is a member of the following international agreements:

- Berne Convention (since 1993)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 2005)
- Patent Law Treaty (since 2005)
- Rome Convention (since 1993)
- WIPO Convention (since 1995)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Trade Marks Act no 29 of 1967 (Chapter 436, Laws of the Federation of Nigeria, 1990)
- Trade Marks Regulations, 1967

Patents

- Patents and Designs Act no 60 of 1970 (Chapter 344, Laws of the Federation of Nigeria, 1990)
- Patent Rules, 1971

Designs

- Patents and Designs Act no 60 of 1970 (Chapter 344, Laws of the Federation of Nigeria, 1990)
- Design Rules, 1971

Copyright

- Copyright Act no 43 of 1988 (Chapter 68, Laws of the Federation of Nigeria, 1990) as amended by Copyright Amendment Decrees no 98 of 1992 and no 42 of 1999
- Copyright (Security Devices) Regulations, 1999
- Copyright (Video Rental) Regulations, 1999
- Copyright (Collecting Societies) Regulations, 1993

## TRADE MARKS

### Law

- Trade Marks Act no 29 of 1967 (Chapter 436, Laws of the Federation of Nigeria, 1990)
- Trade Marks Regulations, 1967

**Note:** There have been other consolidated Acts drafted since the 1967 Act, in 1990 and in 2004, but no subsequent draft Act has been published and the 1967 Act, therefore, remains in force.

Nigeria is a member of the Paris Convention and the WTO/TRIPS.

### Trade mark protection

The Act provides for the protection of trade marks in respect of goods, as well as for certification marks. The registration of a trade mark gives to the proprietor the exclusive right to the use of the mark in respect of the relevant goods. Although not initially protected, the protection was extended (in 2007) to cover all services in addition to goods (see the section on **Classification** below).

Provision is made for registration in Part A of the register if the mark contains or consists of a distinctive feature and is inherently adapted to distinguish or has become adapted to distinguish through use. To be registrable in Part B of the register, the mark must be capable of becoming distinctive.

### Protection of well-known marks

No express provision.

### Advantages of trade mark registration

Registration of a trade mark gives the proprietor the exclusive right to the use of the mark, and the right to institute proceedings against other persons in the event of infringement of the mark.

### Types of trade marks

The Act provides for:

- trade marks for goods (later extended to services)
- certification trade marks.

### Definition of a mark

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

### Definition of a trade mark

A trade mark means a mark used or proposed to be used in relation to goods for the purposes of indicating a connection in the course of trade between the goods and some person having the right, either as proprietor



or as registered user, to use the mark, whether with or without any indication of the identity of that person.

#### **Definition of a certification trade mark**

A certification mark is a mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in regard to origin, material, method of manufacture, quality, accuracy or other characteristic, from goods not so certified. A certification mark shall be registrable in Part A of the register.

#### **Limitation to colour**

Where a proprietor has more than one mark differing, *inter alia*, as regards colour, these marks may be registered as a series by way of one registration.

#### **Classification**

The International Classification of Goods and Services (Nice Agreement) is applicable. The 1967 Act provides only for the registration of marks in respect of goods. The Act itself was not amended, but a directive was issued in 2007 which incorporated service marks into the classification contained in the Schedule of the Trade Marks Regulations. Thus, applications for registration of service marks commenced in 2007; this would seem to be an indication that these registrations will be recognised.

Nigeria follows a single-class filing system, which means a separate application is required for each class in which protection is sought.

#### **Convention priority**

The 1967 Act does provide for the filing of convention priority claims. However, this provision has been made subject to certain qualifications, one of which is that convention countries must first be recognised by way of a declaration published in the Federal Gazette. Priority claims may thus not be recognised in Nigeria until such time as a declaration has been published. However, it would appear that the Nigerian Registry does accept priority applications.

#### **Application**

An application for registration of a trade mark is filed with the Registrar of Trade Marks, operating under the Ministry of Commerce.

The following documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic print of the mark.

#### **Examination/procedure**

An application is examined as to formalities as well as on relative and substantive grounds.

**Opposition**

Once accepted, an application is published for opposition purposes. Opposition may be lodged within two months from the date of publication of the application in the Journal. It is not possible to extend this two month period.

**Opposition proceedings**

Opposition proceedings are set out in the Act. A notice of opposition must include a statement of the grounds upon which the opponent objects to the registration. The Registrar of Trade Marks serves the notice of opposition on the applicant, who then has one month to file a counter-statement.

Within one month of receipt of the applicant's counter-statement, the opponent must file evidence in support of its opposition in the form of a statutory declaration. If the opponent does not file the evidence within the prescribed time period, the opposition is deemed to have been abandoned.

Following the delivery of the opponent's evidence, the applicant has one month to file its answering evidence. If it fails to do so, it is deemed to have abandoned its application. Within one month of the filing of the applicant's answering evidence, the opponent may file evidence in reply. Extensions of these periods are allowed.

Once all the papers have been filed, the opposition will be heard by the Registrar.

**Grounds of opposition**

The grounds for opposition include:

- in the case of an application in Part A of the Register, that the mark is not distinctive, ie adapted to distinguish either inherently or by reason of prior use, or does not contain or consist of certain essential particulars
- in the case of an application in Part B of the Register, that the mark is incapable of becoming distinctive so as to distinguish the goods or services, either inherently or by reason of use
- that matter forms part of the mark which would, by reason of it being likely to deceive or cause confusion, be disentitled to protection in a court of law
- that the mark is contrary to law or morality
- that the mark consists of a scandalous design
- that the mark is identical to the registered trade mark of another party and registration is sought for the same goods or description of goods covered by the registered trade mark, or the mark so nearly resembles the registered trade mark as to be likely to cause deception or confusion.

**Duration and renewal**

A trade mark registration is effective for a period of seven years from the date of filing of the application for registration and, thereafter, is renewable

for further periods of 14 years, on the payment of the prescribed fee. The registrant has a one month grace period, from date of advertisement of non-payment in the Journal, within which to pay the renewal fee and an additional penalty fee, in order to renew the registration and prevent removal by the Registrar.

### **Cancellation/removal of a trade mark**

Any person concerned may apply in the prescribed manner to the Registrar or to the court for an order making, expunging or varying an entry in the case of –

- the non-insertion in or omission from the register of any entry
- an entry wrongly made in the register without sufficient cause
- an entry wrongly remaining on the register
- any error or defect in any entry in the register.

The procedure for the cancellation is very similar to the procedure for opposition. However, the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement. In any case of doubt, any party may apply to the Registrar for directions.

A trade mark registration may also be cancelled and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds of opposition** above). Finally, a trade mark registration can be cancelled on the grounds discussed under the use requirement below, namely non-use for a specified period, or lack of *bona fide* intention to use.

### **Use requirement and cancellation**

Any person concerned may apply to the Registrar or the court for the removal/cancellation of a registered trade mark on the grounds that:

- it was registered by the proprietor without any *bona fide* intention to use the mark in connection with the relevant goods, and that there has in fact been no *bona fide* use thereof in connection with such goods
- that up to a date one month before the date of application for cancellation, there has been no *bona fide* use of the trade mark in connection with such goods for a continuous period of five years or longer

unless in either case such non-use is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to such goods.

### **Assignment**

Assignments are possible and may be made with or without the goodwill of the business. In order to be effective against third parties, the assignment must be recorded in the register.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment.

**Licensing/registered users**

Voluntary licensing and registered user agreements are recognised. Recording of the licence agreement/registered user agreement is required to be legally binding.

Requirements for recordal:

- power of attorney from the proprietor (simply signed)
- power of attorney from the user (simply signed)
- registered user agreement
- statutory declaration and statement of case.

**Amendments**

The Act provides for the rectification and correction of the register, for the amendment of documents, as well as for the amendment of trade marks but only in a manner that does not substantially affect the identity of the mark.

Requirements for amendment:

- power of attorney (simply signed)
- supporting documents, such as a certificate of change of name (if applicable).

**Rights conferred by registration**

The registration of a trade mark in Part A of the register shall give to the proprietor the exclusive right to the use of that trade mark in relation to the relevant goods. This right is infringed by any person who uses the mark without authority.

The registration of a trade mark in Part B of the register shall give to the proprietor a similar right as the Part A proprietor, except that no injunction or other relief will be granted to the proprietor if the other person can show that his unauthorised use of the mark is not likely to deceive or cause confusion.

**Trade mark infringement**

The exclusive right to the use of a trade mark given by registration shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, in the course of trade uses a mark identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which the mark is registered; or who uses the mark in such manner as to render the use of the mark likely to be taken either –

- as being used as a trade mark, or
- in a case in which the use is upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right (either as proprietor or as registered user) to use the trade mark or to the goods of such legitimate user.

**Defences to trade mark infringement**

A registered trade mark is not infringed by the following acts:

- any *bona fide* use by a person of his own name or the name of his place of business, or of the name, or the name of the place of business, of any of his predecessors in business
- the use by any person of any *bona fide* description of the character or quality of his goods
- the use of a mark that has taken place continuously from a date prior to the use or the registration of the registered trade mark by the proprietor
- in the case of a trade mark registered in Part B of the register, the use of a mark that is not likely to deceive or cause confusion.

**Relief for trade mark infringement**

A trade mark proprietor may ask for the following relief in an action for trade mark infringement:

- injunction
- damages
- delivery-up and/or destruction of the infringing goods
- removal of the infringing trade mark (this is not a separate relief, but will flow from the injunction).

The claim for damages is a claim for pecuniary damages which consists of a loss of profits. It can include a claim for lost royalties. Also, it is possible to bring an application to court to direct the infringer to supply an account of profits, if this is not tendered in the evidence as filed.

**Common law rights**

The Act recognises prior user rights, by providing that the proprietor of a registered trade mark shall not be entitled to interfere with the use by any person of an identical or similar mark, if that person (or his predecessor) has continuously used that mark from a date prior to the use or registration of the mark by the registered proprietor.

The Act also recognises honest concurrent user rights, which may result in the registration of identical or similar marks in respect of the same goods in the names of more than one proprietor.

**Marking of goods**

No requirement for marking.

## PATENTS

### Law

- Patents and Designs Act no 60 of 1970 (Chapter 344, Laws of the Federation of Nigeria, 1990)
- Patent Rules, 1971

Nigeria is a member of the Paris Convention, the PCT, the Patent Law Treaty, and the WTO/TRIPS.

### Patent protection

Patent protection is available via a national filing. Although it is a member of PCT, Nigeria has not amended its laws to implement the PCT. Accordingly, it is not certain whether valid patent protection can be obtained via a PCT national phase application in Nigeria. However, in practice PCT national phase applications are being accepted and processed through to grant by the Nigerian Patent Office.

Foreign applicants must be represented by a local agent.

### Types of patents

Provision is made for conventional patents in respect of inventions, and for divisional patents where the initial application covered more than one invention.

### Patentable subject matter

An invention is patentable if it is new or results from inventive activity and is capable of industrial application.

The following are not patentable:

- plant or animal varieties, or essentially biological processes for the production of plants or animals (other than microbiological processes and their products)
- inventions the publication or exploitation of which would be contrary to public order or morality
- principles and discoveries of a scientific nature.

### Types of applications

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Nigeria is designated (see the section on **Patent protection** above)
- subsidiary/divisional applications, where the original application covers more than one invention.

**Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventors or a statement by the applicant justifying its right to the invention (if applicable)
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

**Applicant**

The inventor or his successor in title may apply for registration. An assignment document is required if the applicant is not the inventor.

**Novelty**

An invention is new if it does not form part of the state of the art. The state of the art means everything that has been made available to the public anywhere by use, publication, or in any other way prior to the filing date or the priority date.

**Certain prior knowledge or publication excused**

A grace period of six months before the filing date or priority date is provided for display of the invention by the inventor or his legal successor at an officially recognised international exhibition.

**Inventiveness**

An invention results from inventive activity if it does not obviously follow from the state of the art.

**Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application is filed within 12 months from the earlier application.

**Examination/procedure**

Applications are subjected to formal examination only, which takes place automatically. There is no examination as to novelty, and if the formal requirements are satisfied, a patent will be granted in due course.

**Opposition**

The Act makes no provision for the filing of opposition to a pending patent application.

**Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met he shall grant the patent. The Act requires that details of all granted patents should be published in the Journal after grant. However, in practice this is not always done.

**Duration and maintenance**

The term of a patent obtained in Nigeria is 20 years. Annual renewal fees are payable, and a six month grace period is available.

**Restoration**

No provision is made for the restoration of a patent if the annual renewal fees are not paid before the due date or within six months thereof. In practice, renewal fees can be paid at any stage even after expiry of the six month grace period. However, the validity of late payments is uncertain.

**Revocation**

Any interested person may request the Federal Court to invalidate a patent on any of the grounds listed in the Act. These are as follows:

- that the subject matter is not patentable
- that the description of the invention does not sufficiently describe the invention, and/or the claims do not define the scope of protection or alternatively they exceed the limits of the description
- that in respect of the same invention a patent has been granted in Nigeria, on the basis of a prior application or an application benefiting from an earlier foreign priority.

**Assignments and licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

**Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

Any person may apply to the court for the grant of a compulsory licence on any of the following grounds:

- that the patented invention is not being worked in Nigeria
- that the existing degree of working does not meet the demand for the patented invention on reasonable terms
- that the working in Nigeria is being hindered by importation
- that the establishment of industrial or commercial activities in Nigeria is being hindered by the lack of working.

A compulsory licence can also be granted where a later patent cannot be worked without infringing an earlier patent, provided the later patent constitutes substantial technical progress or serves different industrial purposes.



### **Amendments**

The Act does not specifically deal with the issue of amendments. However, the Regulations do allow the Registrar discretion to allow any document or drawing relating to an invention to be rectified on such terms as he may see fit. This could mean that it is possible to amend both a pending application and a granted patent, but the issue is not clear.

### **Effect of a patent**

A patent confers on the patentee the right to preclude other persons from doing any of the following acts:

- making, importing, selling or using the patented product
- stocking the product for sale or use
- applying the patented process
- doing any of the above acts in respect of a product obtained directly from the patented process.

The rights do not extend to:

- acts not done for industrial or commercial purposes
- acts done in respect of products lawfully sold in Nigeria.

The rights also do not extend to acts done in good faith from a date prior to the filing of the priority date of the patent; such acts may be continued.

### **Infringement**

The exploitation of the patented invention in Nigeria by any person other than the patentee or his licensee shall be considered an infringement of the patent. Proceedings for infringement are initiated in the Federal High Court and remedies include an interdict, damages, and an account of profits.

### **Marking**

Not required.

### **Working**

Working of the patented invention is required within a period of four years from the date of filing, or three years from the grant of the patent, whichever occurs later. Failure to work the patent may lead to the granting of a compulsory licence (see the section on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Patents and Designs Act no 60 of 1970 (Chapter 344, Laws of the Federation of Nigeria, 1990)
- Design Rules, 1971

Nigeria is a member of the Paris Convention and the WTO/TRIPS.

### **Design protection**

The registration of a novel design gives to the owner the right to preclude all others from using the design in order to derive a commercial benefit. Design protection is available by way of a national filing.

### **Registrable subject matter**

An industrial design means any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, if it is intended by the creator to be used as a model or pattern to be multiplied by an industrial process and is not intended solely to obtain a technical result.

### **Classification of designs**

The Locarno International Classification of Designs is not applied, but the Act does require the applicant, when making the application, to specify the articles to which the design will be applied.

### **Types of applications**

Application for the registration of a design may be by way of –

- a non-convention national application
- a convention national application claiming priority from an earlier application in a convention country.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs.

Foreign applicants must provide a local address for service and must be represented by a local agent.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- statement justifying the applicant's right to registration, or an assignment document
- suitable graphic representations of the design or specimens thereof
- certified copy of the priority document (if applicable).

A single application can include up to 50 designs if the products to which the design relates are of the same kind, or are of the same class (where a classification has been prescribed).

The Act also makes provisions for the filing of applications under 'sealed cover'. In such a case the application may be kept secret for a maximum period of 12 months. A provisional certificate is issued and a provisional publication is made advising of the provisional registration of the design. After 12 months the Registrar will examine the application and, if the application complies with the requirements, issue a registration certificate.

**Applicant**

The author or creator or his assignee may apply for registration.

**Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application is filed in Nigeria within six months from the earlier application.

**Novelty**

An application must be filed before the design has been made available to the public anywhere by description, use, or in any other way, unless it can be shown that the creator of the design could not have known that it had been made available. Display of the design at an officially recognised exhibition does not destroy novelty, if the application for registration is filed within six months of the exhibition.

**Examination/procedure**

Examination is conducted by the Registrar to ensure compliance with the formal requirements and also to determine whether the design is contrary to public order/morality. If satisfied that the conditions for registration have been met, but without examining the application to determine if it is novel, the Registrar will register the design and issue the registration certificate.

**Opposition**

No provision is made for the filing of an opposition to a design prior to registration. At any time after registration an interested party can apply to the Federal High Court for cancellation of the registration of the design. The only grounds for cancellation are that the design was not new or it was contrary to public order or morality.

**Duration and maintenance**

The initial term of the design registration is five years, which period is extendible upon payment of renewal fees for two further five year terms. A grace period of six months is available for payment of renewal fees. In practice renewal payments are accepted and processed even after the six month grace period. However, the validity of late payments is uncertain.

**Restoration**

No provision is made for restoration of a lapsed design.

**Revocation**

Any person (including a public officer) may apply to the court for a design registration to be declared null and void, on the following grounds:

- that the design is not new
- that the applicant was not the creator of the design
- that the design is contrary to public order or morality.

### **Assignments and licences**

The right to a design may be transferred or licensed. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

No provisions.

### **Rights conferred by registration**

The registration of a design confers on the registered owner the right to preclude any other person from doing any of the following acts for commercial or industrial purposes:

- reproducing the design in the manufacture of a product
- importing, selling or utilising for commercial purpose a product reproducing the design
- holding such a product for the purpose of selling it.

The rights of the owner does not extend to –

- acts not done for commercial purposes
- acts done in respect of products lawfully sold in Nigeria.

### **Infringement**

The exploitation of a registered industrial design by anyone other than the registered owner requires the consent of the owner. Exploitation without such consent constitutes infringement. Proceedings for infringement are initiated in the Federal High Court, and remedies include an interdict, damages, and an account of profits.

### **Marking**

No provisions but marking is advisable.

### **Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Copyright Act no 43 of 1988 (Chapter 68, Laws of the Federation of Nigeria, 1990) as amended by Copyright Amendment Decrees no 98 of 1992 and no 42 of 1999
- Copyright (Security Devices) Regulations, 1999
- Copyright (Video Rental) Regulations, 1999
- Copyright (Collecting Societies) Regulations, 1993

Nigeria is a member of the Berne Convention, the Rome Convention, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- cinematograph films
- sound recordings
- broadcasts.

Literary works are further defined to include:

- novels, stories, poetic works
- plays, stage directions, film scenarios, broadcasting scripts
- choreographic works
- computer programs
- textbooks, treatises, essays, articles
- encyclopaedias, dictionaries, directories
- letters, reports, memoranda
- lectures, addresses and sermons
- law reports, excluding decisions of courts
- written tables and compilations of data.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, engravings, prints
- maps, plans, diagrams
- works of sculpture
- photographs
- works of architecture
- works of artistic craftsmanship.

### **Requirements for subsistence of copyright**

A literary, musical or artistic work shall not be eligible unless sufficient effort has been expended to make the work original, and the work has been fixed in a definite medium of expression. There is no requirement for registration. For a work to qualify for protection, the author must be a citizen of Nigeria, or domiciled or ordinarily resident in Nigeria. Alternatively, the work must have been made or first published in Nigeria.

Copyright protection is also extended to persons who are citizens of, or domiciled or resident in, a country which is a party of a treaty of which Nigeria is also a party, and which provides for copyright protection; or to works first published in such a country, or by the United Nations or the Organisation of African Unity.

**Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the so-called moral rights pertaining to the work; these include the right to claim authorship and to be recognised as the author, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights are not alienable and may not be transferred during the life of the author.

**Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 70 years.

In the case of all other works, ie cinematograph films and photographs, sound recordings and broadcasts, the duration is 50 years from the end of the year in which the work was made or was made available to the public.

**Protection afforded by copyright**

Copyright confers on the owner the exclusive right to control the doing in Nigeria of any of the following acts:

- to reproduce of the work in any material form
- to publish the work
- to perform the work in public
- to produce, reproduce, perform or publish a translation of the work
- to make a cinematograph film or record of the work
- to distribute to the public copies of the work, by way of sale, rental, lease, hire
- to broadcast or communicate the work to the public
- to make an adaptation or translation of the work
- to do any of the above acts in respect of an adaptation or translation.

**Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner:

- the doing of any of the listed acts by way of fair dealing for purposes of scientific research, private use, criticism and review
- the inclusion in a film or broadcast of an artistic work situated in a public place
- the reproduction and distribution of copies of an artistic work situated in a public place
- certain usages for teaching in schools or universities.

**Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

**Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

**Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

**Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, account of profits, delivery up of infringing articles, etc.

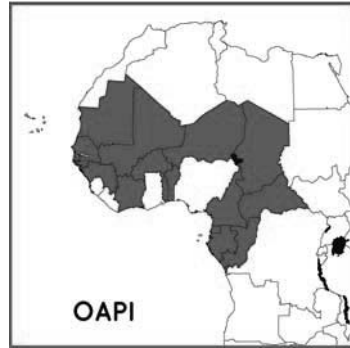
**Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith.

**PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Nigeria.

# ORGANISATION AFRICAINE de la PROPRIÉTÉ INTELLECTUELLE (OAPI)



## GENERAL INFORMATION

OAPI, the Organisation Africaine de la Propriété Intellectuelle, is a union of 16 predominantly French-speaking countries which was formed when the former Libreville Accord (concluded in 1962 by 12 countries) was revised in Bangui in 1977 and the Bangui Agreement was concluded. The Accords of Libreville and Bangui established common intellectual property laws and a single Intellectual Property Office, situated at Yaoundé, Cameroon, to have effect in all member countries.

## OAPI member countries

The current membership of the Bangui Agreement is 16 countries:

Benin (since 1983)	Guinea (since 1990)
Burkina Faso (since 1983)	Guinea Bissau (since 1998)
Cameroon (since 1982)	Ivory Coast (since 1982)
Central African Republic (since 1982)	Mali (since 1984)
Chad (since 1988)	Mauritania (since 1982)
Congo (since 1982)	Niger (since 1982)
Equatorial Guinea (since 2000)	Senegal (since 1982)
Gabon (since 1982)	Togo (since 1982)

Three principles governed the Libreville Accord, which principles were confirmed in the Bangui Agreement:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. Hence designation of specific countries is not required in an OAPI application, ie all OAPI applications are in respect of all member countries.

In concluding the Bangui Agreement, the signatory countries undertook to accede to the international treaties and conventions as listed in the Agreement. OAPI thus recognises the membership of its members of



international conventions and agreements, so that convention priority can, for example, be claimed. (See the section on **International/regional conventions** below.)

### **International/regional conventions**

Member states of the Bangui agreement are also members of the following international conventions:

- Berne Convention (all countries are members)
- Brussels Convention on Programme-carrying Signals (only Togo a member)
- Budapest Treaty (OAPI is the member)
- Cooperation Agreement between OAPI and EAPO
- Hague Agreement on Designs (OAPI is a member) (9 countries are members; Burkina Faso, Cameroon, Equatorial Guinea, Guinea, Guinea-Bissau, Mauritania and Togo are not yet members)
- Lisbon Agreement on Appellations of Origin (only Burkina Faso, Congo, Gabon and Togo are members)
- Locarno Agreement on Classification of Designs (only Guinea is a member)
- Nairobi Treaty on Olympic Symbol (only Congo, Equatorial Guinea, Senegal and Togo are members)
- Nice Agreement on Classification of Marks (only Benin and Guinea are members)
- Paris Convention (all countries are members)
- Patent Cooperation Treaty (all countries are members)
- Phonograms Convention (only Burkina Faso and Togo are members)
- Rome Convention (only Burkina Faso, Congo, Niger and Togo are members)
- Singapore Treaty (only Mali is a member)
- Strasbourg Agreement on Patent Classification (only Guinea is a member)
- Trade Mark Law Treaty (only Burkina Faso and Guinea are members)
- Vienna Agreement on Figurative Elements of Marks (only Guinea is a member)
- WIPO Convention (all countries are members)
- WIPO Copyright Treaty (only Benin, Burkina, Faso, Gabon, Guinea, Mali, Senegal and Togo are members)
- WIPO Performances and Phonograms Treaty (only Benin, Burkina Faso, Gabon, Guinea, Mali, Senegal and Togo are members)
- WTO/TRIPS (all countries are members except Equatorial Guinea)

### **IP legislation**

The Bangui Agreement of 2 March 1977, as subsequently revised on 24 February 1999, contains the legislative provisions providing protection for intellectual property, including patents, utility models, trade marks (including service marks), industrial designs, trade names, geographical indications, layout designs for integrated circuits, new plant varieties, literary and artistic works, audiovisual works, performing rights, phonograms and broadcasts, as well as recognition of and protection for items of cultural heritage.

In order to become members of OAPI, the 16 member states had to renounce their national IP laws. A centralised IP office was set up for OAPI, based in Yaoundé, Cameroon, which deals with all administrative matters pertaining to the registration and maintenance of OAPI intellectual property rights. Although OAPI is an organisation of predominantly French-speaking countries, both English and French are the working languages of OAPI.

Contentious matters, such as proceedings in the case of infringement, are dealt with by the courts in the member countries where the conflict arises.

## TRADE MARKS

### Law

- Bangui Agreement of 1977 (revising the Libreville Accord of 1962, which became effective from 1964), and further revised in 1999. Annex III of the 1999 revision deals with trade marks and service marks
- Regulations issued under the 1999 revision, effective from 2002, as amended from time to time

OAPI member countries are members, *inter alia*, of the Paris Convention, the Lisbon Agreement, the Nairobi Treaty and the WTO/TRIPS.

OAPI trade mark registrations afford protection in all 16 member states (see list under **OAPI member countries** above).

### Trade mark protection

The Bangui Agreement, in Annex III, provides for the protection of trade marks, including service marks, and for well-known marks. Specific provision is made for the registration of collective marks. In Annex V provision is made for the protection of trade names; and in Annex VI for geographical indications.

### Protection of well-known marks

Well-known marks within the meaning of Art 6 *bis* of the Paris Convention are protected, inasmuch as provision is made for the owner of such a well-known mark to apply for the invalidation of a registered trade mark that is liable to be confused with the well-known mark (see the section on **Invalidation/removal of a trade mark** below).

### Types of marks

The Bangui Agreement recognises the following types of marks:

- trade marks for goods
- trade marks for services
- collective marks
- geographical indications.

### Definition of a trade mark

In terms of the Bangui Agreement, any visible sign used or intended to be used on goods or services, and capable of distinguishing the goods or

services of any enterprise, shall be considered a trade mark or service mark. These include in particular surnames by themselves or in a distinctive form, special arbitrary or fanciful designations, the characteristic form of a product or its packaging, labels, wrappers, emblems, prints, stamps, seals, combinations or arrangements of colours, letters, numbers, devices, etc.

#### **Definition of a collective trade mark**

Collective marks are also defined, ie marks where the conditions for their use are laid down in rules approved by a ministerial decision as the competent authority, and where they may only be used by public enterprises, unions or groups of unions, associations, groups of producers, craftsmen or tradesmen which are officially recognised and have legal personality.

#### **Definition of a geographical indication**

A geographical indication is defined as an indication that serves to identify a product as originating from a territory, a region, or a locality within that territory, where the quality, reputation or other specific characteristic of the product may be essentially attributed to such geographical origin.

#### **Classification**

The International Classification of Goods and Services (Nice Agreement) is applied. A single application may cover more than one class. However, goods and services may not be included in a single application

#### **Convention priority**

Convention priority may be claimed under the Paris Convention on the basis of an earlier application filed in a convention country not more than six months prior to the OAPI application.

#### **Application**

A single application covering all member countries of OAPI (without designating individual countries) is filed with the OAPI office. An application can be filed directly at the OAPI office in Yaoundé, or it can be filed via post (registered mail).

Requirements for application:

- full particulars of the applicant
- power of attorney, in French or English\* (simply signed; not in black ink)
- reproduction of the mark; an electronic reproduction of the mark may be used
- list of the goods or services to which the mark is to apply
- certified copy of the priority document (if applicable).

\* **Note:** French and English are the working languages of OAPI.

The filing of a collective mark must include the ministerial decision determining the conditions of use.

**Examination/procedure**

The application is filed at the OAPI office; since an application covers all member states there is no need for countries to be designated. The OAPI office examines the application to determine whether it complies with the formal and substantive requirements. If it finds that the conditions for registration have been met, it registers the mark and publishes the registration.

On registration, a certificate is issued to the owner of the registration setting out the particulars of the trade mark.

**Opposition**

Any interested party may oppose the registration of a trade mark within six months from the publication date referred to above (see the section on **Examination/procedure** above). The deadline is not extendible.

**Opposition proceedings**

In order to oppose the registration of a trade mark, an opponent must lodge at the OAPI office a written statement of opposition. Once the opponent's written statement has been filed at the OAPI office, the office will send a copy of the statement of opposition to the trade mark applicant or to his agent, who may reply within a period of three months (once extendible). The reply is forwarded to the opponent or to his representative.

If the trade mark applicant's reply does not reach the OAPI office by the prescribed time limit, the trade mark applicant shall be deemed to have withdrawn his application for registration and the registration shall be cancelled.

The OAPI office may, before taking a decision on the opposition, hear each of the parties or their agents.

**Grounds of opposition**

The grounds of opposition include the following:

- that the mark is not a mark as defined, or is not capable of distinguishing the goods or services of any enterprise
- that the mark is devoid of distinctiveness, eg where the mark consists of signs or matter or emblems that are descriptive of the goods or services to which the mark is to be applied
- that the mark is identical to a registered mark that belongs to another owner, or to a mark which has an earlier filing or priority date and which relates to the same or similar goods or services, or where it so resembles such a mark that it is liable to mislead or confuse
- that the mark is contrary to public policy, morality or the law
- that the mark is liable to mislead the public as to the geographical origin, nature or characteristics of the goods or services to which the mark is to be applied
- that the mark reproduces, imitates or incorporates armorial bearings, flags or other emblems, or the acronym or an official sign or hallmark of a State or intergovernmental organisation, except where the competent authority of that State or of that organisation has given its permission.

### **Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of application for registration and may be renewed for consecutive periods of 10 years upon payment of the renewal fees and if the trade mark owner can prove that he is using the trade mark within the national territory of one of the member States, or is causing it to be used by means of a licence. A six months grace period is allowed for the late payment of the renewal fees.

### **Invalidation/removal of a trade mark**

A trade mark registration may be declared invalid by a court on any ground on which the application for the registration could have been opposed (see the section on **Grounds of opposition** above), or if it conflicts with a prior right.

Any interested person, the office of the Public Prosecutor or a professional group may apply to the civil courts of the member states of OAPI for the invalidation of the mark in the respective member states. The application for invalidation may be filed only in the OAPI member country in which the trade mark is invalid; the trade mark will then be declared invalid in that country only. If grounds for invalidity of the mark exist in more than one OAPI member state, a separate application for the invalidation of the mark must be filed in each member state should the interested person wish to have the mark declared invalid in more than one or in all of the OAPI member states.

The court will declare the registration of the mark invalid if it does not conform to the requirements of the law or if it conflicts with a prior right. The grounds for invalidity are the same as those on which registration could have been opposed (see the section on **Grounds of opposition** above).

If the ground for invalidation is that the trade mark registration conflicts with a prior right, only the holder of the prior right may apply for invalidation. The registered trade mark may be declared invalid in relation to all or to only some of the goods or services for which the mark was registered. When the decision declaring the registration invalid becomes final, the OAPI office must be notified and the decision must be published. Invalidity is effective from date of publication.

Furthermore, the owner of a well-known mark within the meaning of Article 6 *bis* of the Paris Convention and Article 16 of the TRIPS Agreement, may apply to the court for the invalidation, within the national territory of one or more or all of the member states of OAPI, of a registered trade mark that is liable to be confused with the well-known mark.

The application for the invalidation of the mark must be filed within five years of the date on which the application for registration of the mark was filed, if such application was filed in good faith.

The trade mark registration shall be deemed invalid in each or all of the member states from the date on which the mark was registered.

**Use requirement and cancellation**

A registered trade mark may be cancelled if it has not been used within the national territory of any one of the member states for a continuous period of five years from the date of registration, except where the registered owner has legitimate reasons for such non-use.

At the request of an interested party, the court may order the cancellation of the registered mark; the cancellation may be extended to all or part of the goods or services for which the mark was registered. The burden of proof regarding use of the mark rests with the owner of the mark being cancelled. The authorised use of a mark by another person is recognised as use of the mark by the owner of the mark.

When the decision ordering cancellation becomes final, it must be notified to the OAPI office, which shall record it in the Special Register of Marks and publish it. The cancellation is effective for all the member states in OAPI. Registration of the mark shall then be deemed never to have had any effect.

**Assignment**

The rights in a mark may be transferred; the assignment/transferral must be in writing and recorded at the OAPI office. The change in ownership will have no effect until it has been recorded.

Collective marks shall not be transferred or assigned. However, in the event of a legal merger, the Minister responsible for industrial property may authorise the transfer of a collective mark to the new group created by the merger.

Any change in ownership may be made with or without the goodwill of the business.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment, signed by each of the parties (notarised), in English or French or accompanied by a verified translation.

**Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is required in order to be effective against third parties. The duration of the licence may not be longer than the duration of the registration of the mark.

Any licence agreement shall provide for the effective control, by the licensor, of the quality of the goods and services of the licensee in connection with which the mark is used. If the licence contract does not provide for such quality control, or if such control is not effectively carried out, the licence contract shall not be valid.

Requirements for recordal:

- power of attorney by the licensee (simply signed)
- power of attorney by the licensor (simply signed)
- licence agreement, signed by both parties (notarised), with verified French or English translation.

### **Amendment**

No changes may be made to the mark nor to the list of goods or services for which the trade mark was registered, subject to the right of the registered owner to limit the list.

### **Rights conferred by registration**

The registration of a mark confers on the owner the exclusive right to use or to authorise the use of the mark, or a sign resembling it, in connection with the goods or services for which it has been registered and similar goods or services.

The registration of a trade mark does not confer on its owner the right to prohibit a third party from using, in good faith:

- his name or address
- a pseudonym
- a geographical name
- accurate information concerning the nature, quality, quantity, purpose, value, place of origin or time of production of his goods or rendering of his services;

Provided that the use listed above is of a descriptive nature and cannot mislead the public as to the source of the goods or services.

The registration of a trade mark also does not confer on its owner the right to prohibit a third party from using a mark, in relation to goods that have been lawfully sold under the mark, by the owner or his licensee, in an OAPI member state, on condition that the goods have not undergone any alteration.

### **Trade mark infringement**

The registration of the mark entitles the proprietor of the trade mark to prevent the unauthorised use, in trade, of an identical or similar sign for goods or services that are similar to those for which the mark or service mark has been registered, where this use is liable to cause confusion. Where an identical sign is used for identical goods and services, a risk of confusion shall be presumed to exist.

The rights conferred by the registration of a trade mark can be enforced by civil as well as criminal action.

### **Right to institute civil infringement action**

A civil action based on trade mark infringement may be brought by the owner of the mark. The authorised licensee that is entitled to use the mark may institute infringement proceedings, unless otherwise provided in the licence contract, if the owner of the mark, after being called upon to do so, fails to institute infringement proceedings.

A licensee entitled to use the mark is also entitled to intervene in infringement proceedings that have been instituted by another party, in order to secure compensation for prejudice that he has suffered.

It shall not be permissible to institute infringement proceedings against the user of a registered trade mark if the use of the mark has been tolerated for three years or more. This rule does not apply where the mark has been used in bad faith. Furthermore, the inadmissibility of the action shall be confined to those goods and services for which the use was tolerated.

Civil actions relating to marks must be brought before the civil courts and judged as summary proceedings.

### **Right to institute criminal action**

Certain acts of infringement constitute crimes and criminal action before a criminal court may be instituted by the owner against any person for:

- fraudulently affixing to goods a mark belonging to another
- knowingly selling or offering for sale goods bearing a counterfeit or fraudulently affixed mark, or knowingly selling, offering for sale, or providing or offering to provide goods or services under this mark
- making a fraudulent imitation of a mark in such a way as to mislead the buyer, or making use of a fraudulently imitated mark
- knowingly selling or offering for sale goods bearing a fraudulently imitated mark or information liable to mislead the buyer as to the nature of the goods, or providing or offering to provide goods or services under such a mark
- knowingly providing a product or rendering a service other than that requested of him under a registered mark
- making use of a mark bearing information liable to mislead the buyer as to the nature of the goods.

If the accused, in an action brought before a criminal court, raises questions in his defence concerning the ownership of a mark, the competent court shall rule on the accuser's rights in the mark.

Persons found guilty of the above crimes may be punished by a fine or imprisonment.

### **Seizure of infringements**

The owner of a mark or the holder of an exclusive right of exploitation, acting in pursuance of an order from the president of the civil court within whose jurisdiction the action is to be taken, may engage bailiffs or public or ministerial officials, including officials at the border, to make a detailed inventory, with or without seizure, of the goods or services that he claims have been marked, provided or furnished to his prejudice in breach of the provisions dealing with the unauthorised use of a mark.

The order shall be made on request, subject to proof that the mark is registered and that it has neither lapsed nor been cancelled. The judge may require the complainant to furnish security before seizure is effected. Security shall always be required of foreigners seeking seizure. The persons in possession of the objects described or seized shall be given a copy of the order and, where appropriate, of the document attesting to the deposit of security.



The complainant must take action against the infringer within 10 days of the seizure, failing which the inventory or seizure shall become void.

### **Common law rights**

The general principle is that the ownership of a trade mark shall vest in the person who first files an application for the registration of the mark. However, where an application is filed by a person who knew or should have known that another person had a prior right to use the mark, this other person may lodge a claim of ownership of the mark with the OAPI office, provided he does so within six months of the publication of the first filing.

The prior use of the mark may only be proved by written or printed matter or documents related to the facts that are sought to be established. The OAPI office must rule on the matter. In this manner recognition may be given to prior common law rights.

### **Marking of goods**

No specific provisions in the Bangui Agreement.

## **PATENTS**

### **Law**

- Bangui Agreement of 1977 (revising the Libreville Accord of 1962, which became effective from 1964), and further revised in 1999. Annex I of the 1999 revision deals with patents
- Regulations issued under the 1999 revision, effective from 2002, as amended from time to time

OAPI member countries are also members of the Paris Convention, the Budapest treaty, the PCT and the WTO/TRIPS.

OAPI patent registrations afford protection in all 16 member states (see list under **OAPI member countries** above).

### **Patent protection**

OAPI member countries have renounced their national IP laws since an OAPI registration will provide the patentee with a single title of protection valid in each OAPI member country. Designation of countries is not required as all 16 member countries are automatically included when an OAPI patent application is filed.

Patent matters are dealt with in Annex I of the Bangui Agreement. Patent applications must be filed at the OAPI office. Alternatively, member states may require that applicants domiciled in the territory of a member state must first file the application with the national administration of the member state. In that case, the application must be transmitted to OAPI by the national administration within a period of five days.

Since OAPI is a member of the PCT, patent protection may also be obtained by way of a PCT application.

### **Types of patents**

The Bangui Agreement provides for:

- conventional patents, where a patent is granted for an invention
- divisional patents, where an initial application which covers more than one invention is divided into two or more separate applications
- patents/certificates of addition, where changes, improvements or additions are made to the invention of the principal patent
- utility model certificates, where an implement of work entails a new configuration or component.

### **Patentable subject matter**

Inventions that are new, involve an inventive step, and are industrially applicable are patentable. An invention may relate to a product or a process or to a use thereof. An invention shall be considered industrially applicable if it can be made or used in any industry including handicraft, agriculture, fishery and services.

Patents shall not be granted for the following:

- inventions the exploitation of which is contrary to public policy or morality (provided that the exploitation of the invention shall not be considered contrary to public policy or morality merely because it is prohibited by law)
- discoveries, scientific theories and mathematical methods
- inventions having as their subject matter plant varieties, animal species and essentially biological processes for the breeding of plants or animals other than microbiological processes and the products of such processes
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for the treatment of the human or animal body by surgery or therapy, including diagnostic methods
- mere presentations of information
- computer programs
- works of an exclusively ornamental nature
- literary, architectural and artistic works or any other aesthetic creation.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date is the priority date of the first-filed application under the Paris Convention
- a regional phase application based on an international application under the PCT designating OAPI
- a divisional application, where the original application covers more than one invention
- an application for a certificate of addition to cover improvements or amendments to the invention of the original patent
- an application for a utility model certificate.

## **Application**

An application for a patent must be filed at the OAPI office by the applicant itself or an authorised representative of the applicant. Applicants domiciled outside of the territory of the member states must be represented by an agent. Only agents accredited by OAPI are permitted to represent clients before OAPI.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- specification (including claims, drawings and abstract), in English or French\*
- sequence listings (where applicable)
- priority document (if applicable)
- assignment of invention (if applicable; simply signed)
- assignment of priority (if applicable; simply signed).

\* **Note:** English and French are the working languages of OAPI.

## **Divisional applications**

An application which does not have one principal subject, ie which does not have unity of invention, can be divided into a number of applications, ie divisional applications, all of which will have the filing date of the parent application. An application to divide the application must be made within six months of the date of the relevant notification issued by OAPI.

## **Certificates/patents of addition**

A patentee has the right, for the entire duration of the patent, to make changes, improvements or additions to the invention and to file applications for certificates of addition. A certificate of addition terminates with the principal patent. An application for a certificate of addition may, prior to the grant of the certificate, be converted to an independent patent application.

## **Applicant**

The inventor has the right to a patent, and thus has the right to file a patent application. The right to the patent may be assigned. The applicant is deemed to be the owner of the right to the patent. If the applicant of the OAPI application is different from the applicant of the priority application, then a priority assignment document has to be filed.

## **Novelty**

Inventions that are not novel are not patentable. An invention is new if it is not anticipated by prior art. Everything made available to the public anywhere in the world by means of written disclosure (including drawings and illustrations) or by use or exhibition is considered prior art, if it was so made available before the filing date of the OAPI application or the priority date.

## **Certain prior disclosures excused**

A grace period of 12 months is provided prior to the filing date or priority date, during which disclosure of the invention will not jeopardise novelty,

provided the disclosure took place at an official or officially recognised exhibition; or if the disclosure resulted from an obvious violation committed against the applicant or the predecessor in title.

### **Convention priority**

Since the OAPI member states are also members of the Paris Convention, convention priority can be claimed from an earlier application in another convention country, provided the application is filed within 12 months of the priority application.

### **Examination/procedure**

Formal examination of patent applications takes place, the examination being restricted to determining –

- whether or not the invention contains excluded subject matter
- whether the claims are fairly based on the disclosure in the specification
- whether there is unity of invention, and
- whether the formality requirements have been met.

### **Opposition**

The Bangui Agreement does not make any provision for opposition by a third party to the grant of a patent.

### **Publication**

Granted patents are published in the OAPI Journal.

### **Duration and maintenance**

The duration of an OAPI patent is 20 years from the filing date.

Maintenance fees are payable annually on pending applications and granted patents. Maintenance fees are calculated from the OAPI filing date for convention and non-convention applications, and from the international filing date for PCT regional phase applications. There is a six month grace period for payment of maintenance fees.

A patentee who does not pay the maintenance fee on the anniversary date of the filing (or within the grace period) shall forfeit all his rights, ie the patent shall lapse (see the section on **Restoration** below).

### **Restoration**

Failure to pay the annual maintenance fees before the deadline, or within the six month grace period, results in the lapsing of the application/patent. Restoration is possible within a period of six months from the date on which the applicant/patentee becomes aware that the fee was not paid, or within a period of two years from the date on which the fee was due, whichever ends earlier. Applications for restoration are heard by the OAPI Restoration Commission and an appeal lies to the High Commission of Appeal.

Third parties who started to work the invention after the lapsing of the patent shall have the right to continue such working even after the patent is restored.

### **Assignments and licences**

Patent rights are transferable in whole or in part. Voluntary licences under a patent may also be granted by the owner of the patent. Assignments and licences must be recorded in the special register kept by OAPI in order to be effective against third parties.

Requirements for recordal of assignments:

- power of attorney from assignee (simply signed)
- deed of assignment (notarised), in English or French or accompanied by a verified translation.

Requirements for recordal of licences:

- power of attorney by licensor (simply signed)
- power of attorney by licensee (simply signed)
- licence agreement (notarised), in French or English or with verified translation.

A voluntary licence is not allowed to contain clauses imposing on the licensee restrictions not derived from the rights conferred by the patent. Such clauses shall be invalid.

### **Compulsory licences**

Provision is made for compulsory licences to be granted in two circumstances.

Compulsory licence for non-working:

In the absence of legitimate reasons for the non-working of a patented invention, a compulsory licence can be obtained within four years from the date of filing or within three years from the date of grant of the patent (whichever term is the later), if –

- the patented invention is not being worked in one of the member states, or
- the working of the patented invention in such territory does not meet the demand for the protected product on reasonable terms
- the owner of the patent refuses to grant licences on reasonable commercial terms and conditions, and as a result thereof the establishment or development of industrial or commercial activities in such territory is unfairly and substantially prejudiced.

Compulsory licence for a dependent patent:

Where a patented invention (the dependent patent) cannot be worked without infringing an earlier patent and the owner of the earlier patent refuses to grant a licence to the owner of the dependent patent, a compulsory licence under the earlier patent may be granted in certain circumstances, eg where the invention of the dependent patent represents substantial technical progress.

An application for a compulsory licence is made to the civil court.

### **Amendments or changes**

Amendments to the patent specification can be made at any time before grant but shall not go beyond the disclosure of the invention in the application as filed.

Changes of name or address may be recorded, and corrections to the application may be made.

Requirements for recordal:

- power of attorney (simply signed)
- copy of change of name certificate (notarised).

### **Revocation/invalidation**

The Bangui Agreement provides for the invalidation or revocation of a patent, and for the forfeiture of a patent. Forfeiture takes place when the maintenance fees are not paid on time (see the section on **Duration and maintenance**).

Invalidation can take place in the following circumstances:

- if the invention is not new, is not inventive, or is not industrially applicable
- if the invention comprises non-patentable subject matter (see the section on **Patentable subject matter** above)
- if the specification does not conform to the prescribed requirements.

An action seeking the invalidity of a patent can be brought by any interested party within a member state. Such actions must be heard by the civil courts. In the event that a court finds that a patent is invalid, the court must inform OAPI of the decision and the revocation in respect of that member state shall be recorded in the special register for patents, and shall be published in the OAPI Journal.

### **Effect of a patent**

A patent confers on the owner the exclusive right to work the patented invention.

Working includes the following acts:

- where the patent has been granted for a product, manufacturing, importing, offering for sale, selling and using the product, or holding the product for purposes of offering it for sale, selling or using it
- where the patent has been granted for a process, using the process, or engaging in the acts mentioned above, in relation to a product resulting directly from the use of such process.

### **Infringement**

Infringement of a patent takes place when any person performs, without the consent of the patent owner, any of the acts reserved to the owner under the working of the patent. The owner has the right to institute legal proceedings in a court of the member state where the infringement occurred.

Any violation of the rights of a patentee by the unauthorised receiving or sale or display for sale, or by the introduction into the national territory of one of the member states, of an object covered by the patent, shall constitute an offence which is punishable by a fine or term of imprisonment. These sanctions do not preclude the right of the owner of the patent to claim compensation.

Provision is also made for the seizure of infringing articles. Any further action (civil or criminal) must be instituted within 10 working days of the seizure. If no action is instituted by the complainant, the seizure becomes void. Provision is also made for the confiscation and destruction of infringing articles, or for the handing over of such articles to the patent owner.

### **Utility model certificates**

The Bangui Agreement, in Annex II, also provides for the registration of utility models and the issuance of utility model certificates in respect of so-called implements of work which entail a new configuration, or a new arrangement, or a new component device, and which are industrially applicable. A utility model will be deemed to be industrially applicable if it can be made or used in any kind of industry, including handicraft, agriculture, fishery and services.

An application for a patent may, before grant or rejection, be converted to a utility model application. Similarly, an application for a utility model certificate may, before grant or rejection, be converted to a patent application.

## **DESIGNS**

### **Law**

- Bangui Agreement of 1977 (revising the Libreville Accord of 1962, which became effective from 1964), and further revised in 1999. Annex IV of the 1999 revision deals with industrial designs
- Regulations issued under the 1999 revision, effective from 2002, as amended from time to time

OAPI member countries are also members of the Paris Convention, the Hague Agreement and the WTO/TRIPS.

OAPI design registrations afford protection in all 16 member states (see the list under **OAPI member countries** above).

### **Design protection**

As indicated above, OAPI member countries were required to renounce their national IP laws. As such, an OAPI registration will provide a single design title of protection valid in each OAPI member country.

Design matters are dealt with in Annex IV of the Bangui Agreement. Design applications must be filed at the OAPI office or with the Ministry in a member state responsible for industrial property. In the latter case, the Ministry must transmit the application to the OAPI office within five days.

OAPI is a member of the Hague Agreement Concerning the International Deposit of Industrial Designs. As such, design protection in OAPI can be obtained either via an OAPI application or via an international application under the Hague, designating OAPI.

### **Registrable subject matter**

Any arrangement of lines or colours shall be considered a design, provided that the said arrangement gives a special appearance to an industrial product and may serve as a pattern for the manufacture of such product.

Industrial designs, the exploitation of which are contrary to public policy or morality, may not be registered. If the article to which the design is to be applied also constitutes an invention, protection must be obtained by way of a patent application or an application for a utility model.

### **Classification**

The Locarno International Classification of Industrial Designs is applied.

### **Types of applications**

Application for a design registration may be made by way of –

- a regular OAPI application
- an application claiming convention priority
- an international application under the Hague Agreement designating OAPI.

### **Application**

A single application may include up to 100 designs provided that they belong to the same class (according to the Locarno Agreement) or to the same set or range of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- suitable representations of the design
- statement of the type of product for which the design is to be used
- assignment document (if applicable; simply signed)
- certified copy of the priority document (if applicable).

### **Applicant**

Ownership of a design vests in the person who created the design or his successor in title. In the absence of proof to the contrary, the first applicant shall be presumed to be the creator of the design.



### **Convention priority**

Convention priority can be claimed provided the application is filed within six months of the priority application. The claim to priority must be made at the time of filing or within a period of three months from the filing date.

### **Novelty**

Absolute novelty is required for a design to be registrable in OAPI. According to the Bangui Agreement a design is new if it has not been disclosed anywhere in the world by publication in tangible form, or by use or by any other means. A grace period of 12 months is provided prior to the filing date or priority date, for disclosure of the design at an officially recognised international exhibition, or where the disclosure resulted from an obvious violation of the rights of the applicant or his predecessor.

### **Examination/procedure**

The OAPI office examines the application to ensure that the formal requirements have been met. A notification will be issued if it is found that there are any irregularities. The applicant has a period of three months to respond and/or rectify any irregularities. If no response is filed and the irregularity is not rectified within the three month period, the application will be rejected.

If the OAPI office finds that the formality requirements have been met, it will register the design and publish the registration.

### **Opposition**

The Bangui Agreement does not make any provision for opposition by a third party to the registration of a design.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two consecutive further five year terms. If the renewal fee is not paid, the registration lapses. The term of the registration starts from the date of application for registration.

### **Restoration**

Restoration is possible within a period of six months from the date on which the applicant/owner becomes aware that the fee was not paid, or within a period of one year from the date on which the renewal fee was due. Applications for restoration are heard by the OAPI Restoration Commission and an appeal lies to the High Commission of Appeal.

Third parties who started to exploit the design after the registration expired shall have the right to continue such working even after the design is restored. Restored designs must be published in a prescribed form in the OAPI Journal.

### **Revocation**

No express provision is made for the revocation of a design registration.

**Assignments and licences**

Design rights are transferable in whole or in part. Voluntary licences may also be granted for the exploitation of design rights. Assignments and licences must be recorded in the special register kept by OAPI to be effective against third parties.

Requirements for recordal:

- power of attorney from assignee/licensee (simply signed)
- power of attorney from licensor (simply signed)
- deed of assignment, or licence agreement (notarised), in English or French or accompanied by a verified translation.

**Compulsory licences**

No provision for compulsory licences.

**Effect of a design registration**

A design registration confers on the owner the exclusive right to exploit the design, and to sell or cause to be sold for commercial purposes goods in which the design is incorporated.

**Infringement**

In the case of infringement, a civil action may be brought before the civil courts in the member state where the infringement occurs, and adjudicated as summary proceedings. Any act of infringement knowingly committed in violation of the rights of the owner of the design constitutes a criminal offence and attracts a fine and/or imprisonment. Any criminal action seeking imposition of the prescribed penalties must be instituted by the Public Prosecutor on a complaint by the injured party.

Provision is made for seizure of infringing articles. Any further action (civil or criminal) must be instituted within 10 working days of the seizure. If no action is instituted by the complainant, the seizure becomes void as of right. The Agreement provides for confiscation of infringing articles as well as any implements that assisted in the making of the infringing articles. This additional confiscation is only available in the case of a conviction.

**Marking**

Marking is required in order to prove knowledge on the part of the infringer. Without knowledge on the part of the infringer, the penalties prescribed by the Bangui Agreement may not be imposed.

**Working**

Not required.

**Layout designs for integrated circuits**

Annex IX of the Bangui Agreement specifically deals with the registration of layout designs (topographies) of integrated circuits. A layout design may be protected by way of registration if it is original and if it has not been commercially exploited for more than two years anywhere in the world. A

layout design shall be deemed to be original if it is the result of the creator's own intellectual effort and is not commonplace among creators of layout designs or manufacturers of integrated circuits.

The protection afforded by a registration shall take effect on the date of first commercial exploitation or the filing date of the application (whichever is earlier), and shall endure for a period of 10 years.

## **COPYRIGHT**

### **Law**

- Bangui Agreement of 1977 (revising the Libreville Accord of 1962, which became effective from 1964), and further revised in 1999. Annex VII of the Bangui Agreement deals with copyright and related rights.
- Regulations issued under the 1999 revision, effective from 2002, as amended from time to time.

OAPI member countries are also members of the Berne Convention, the Rome Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty, and the WTO/TRIPS.

Copyright protection afforded under the Bangui Agreement extends to all 16 member states (see the list under **OAPI member countries** above). The provisions of Annex VII cover copyright; the rights of artists, performers, producers of phonograms and broadcasts; and expressions of cultural heritage.

However, the position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this dual legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The following subject matter is eligible for protection:

- literary and artistic works, constituting original creations of the mind and defined to include –
  - works expressed in writing, including computer programs
  - lectures, addresses, sermons
  - musical works
  - dramatic and dramatico-musical works
  - choreographic works
  - audiovisual works
  - works of fine art (drawings, paintings, sculptures etc)
  - works of architecture
  - photographic works

- works of applied art (artistic creations having a utilitarian function)
- illustrations, maps, plans etc
- expressions of folklore
- derivative works and collections, including –
  - translations, adaptations, etc
  - collections of works, of expressions of folklore, of data, etc.

### **Registration of copyright**

No registration is required; copyright comes into existence automatically upon creation of the work.

### **Requirements for subsistence of copyright**

Copyright will subsist if the author is a national of a member state of OAPI, or has his habitual residence or headquarters in a member state; or if the work is first published in a member state.

### **Exclusions of copyright**

Certain subject matter is excluded from protection, such as official texts of a legislative nature, news of the day, etc.

### **Authorship and ownership**

The author is the first owner of the copyright, including both the economic rights and the moral rights provided for in the Bangui Agreement. Where a work is created under a work contract or is commissioned, the economic rights, which initially vest in the author, shall be deemed to have been transferred to the employer or to the person who commissioned the work. The moral rights continue to vest in the author.

### **Duration of copyright**

The economic rights in respect of a work are protected for the lifetime of the author plus 70 years after his death. The moral rights endure indefinitely.

The economic rights in respect of works of applied art are protected for 25 years after the making of the work.

### **Protection afforded by copyright**

The copyright owner has the exclusive right to exploit the work in any form whatsoever and to obtain monetary advantage therefrom. In particular, the copyright owner has the exclusive right to authorise the following acts:

- reproducing the work
- translating, adapting or transforming the work
- distributing copies of the work to the public
- performing the work in public
- broadcasting the work, or transmitting it by television.

### **Exclusions from copyright protection**

Provision is made for several exclusions or limitations, including:

- reproduction for private purposes

- use for teaching
- reproduction by libraries and archives
- reproduction for judicial purposes
- use for information purposes.

### **Assignment of copyright**

The economic rights are assignable by transfer *intra vivos*, or by testament or operation of law. Moral rights are not assignable *intra vivos* but may be transferred by testament. An assignment must be in writing.

### **Moral rights**

The moral rights vest in the author the right to claim authorship and to oppose any distortion or mutilation of his work that may prejudice his honour or reputation. As indicated above, the moral rights cannot be transferred.

### **Licensing of copyright**

Voluntary licences may be granted in respect of the economic rights; licences may be exclusive or non-exclusive. A licence agreement must be in writing.

## **PLANT BREEDERS' RIGHTS**

### **Law**

- Bangui Agreement of 1977 (revising the Libreville Accord of 1962, which became effective from 1964), and further revised in 1999. Annex X of the 1999 revision provides for plant variety protection
- Regulations issued under the 1999 revision, effective from 2002, as amended from time to time

Although OAPI is not a member of the UPOV Convention for the Protection of New Varieties of Plants, the UPOV Convention is listed in the Bangui Agreement as a convention to which member countries are to accede. Annex X of the Bangui Agreement also incorporates UPOV provisions and requirements.

OAPI plant variety registrations and issuance of plant variety certificates afford protection in all 16 member states (see list of **OAPI member countries** above).

### **Protectable subject matter**

Protection can be obtained for new varieties of any kind of plant.

### **Requirements for registrability**

To qualify for protection, a plant variety must be new, distinct, uniform and stable.

A variety is deemed to be new if, at the date of filing/priority date, propagating or harvested material thereof has not been sold or otherwise disposed of by or with the consent of the breeder, for purposes of exploitation of the variety, for more than one year in territories of the member states of OAPI, or for more than six years (trees and vines) or four years (all other species) in non-member states.

### **Application**

The requirements for filing a plant variety certificate application include:

- an application form
- a power of attorney (simply signed)
- a deed of assignment (if applicable; simply signed)
- a technical questionnaire
- results of a DUS (distinct, uniform, stable) examination conducted in another UPOV member country.

### **Denomination of variety**

A proposed denomination is required, as well as identification of the botanical taxon (Latin name and common name).

### **Applicant**

The breeder or a person/concern having the breeder's consent/assignment may apply.

### **Convention priority**

Convention priority can be claimed from an earlier application in a UPOV member country.

### **Examination**

OAPI examines an application as to form and substance, and also carries out a technical examination to establish that the variety belongs to the stated taxon, and that the variety is distinct, uniform and stable. Thereafter, an official description of the variety is established.

### **Duration**

A plant variety certificate endures for 25 years from date of grant, subject to payment of annual fees.

# RWANDA

## GENERAL INFORMATION

The Republic of Rwanda is a landlocked independent state in Central Africa. It is bordered by Uganda to the north, Burundi to the south, Democratic Republic of the Congo to the west, and Tanzania to the east.



<b>Area:</b>	26 338 km <sup>2</sup>
<b>Population:</b>	11 million
<b>Capital:</b>	Kigali
<b>Currency:</b>	Rwandan Franc
<b>GDP:</b>	\$ 11.8 billion (2010)
<b>Internet domain:</b>	.rw
<b>Languages:</b>	French, Kinyarwanda (official languages), English, Swahili
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; tea; tin ore; hides
<b>Imports:</b>	Foodstuffs; machinery and equipment; steel; petroleum products; construction material

## International/regional conventions

Rwanda is a member of the following international/regional agreements:-

- Berne Convention (since 1984)
- Brussels Convention on Programme-carrying Signals (since 2001)
- Hague Agreement on Designs (since 2011)
- Harare Protocol (of ARIPO) (since 2011)
- Lusaka Agreement (ARIPO) (since 2011)
- Paris Convention (since 1984)
- Patent Cooperation Treaty (since 2011)
- Universal Copyright Convention (since 1989)
- WIPO Convention (since 1984)
- WTO/TRIPS (since 1996)

## IP legislation

- Law no 31 of 2009 on the Protection of Intellectual Property
- Ministerial Orders nos 05/10 – 07/10 on Timeframes, Fees and Council of Appeal relating to Intellectual Property

### Trade marks

- Law no 31 of 2009 on the Protection of Intellectual Property Patents
- Law no 31 of 2009 on the Protection of Intellectual Property Designs
- Law no 31 of 2009 on the Protection of Intellectual Property Copyright
- Law no 31 of 2009 on the Protection of Intellectual Property

## TRADE MARKS

### Law

- Law no 31 of 2009 on the Protection of Intellectual Property

Rwanda is a member of the Paris Convention and the WTO/TRIPS. Rwanda has not acceded to the Banjul Protocol of ARIPO.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services, for collective marks and for certification marks. Provision is also made for the protection of geographical indications and trade names.

### Protection of well-known marks

Trade marks which are well known in Rwanda enjoy protection. The Law provides for a well-known mark, even though not registered, to provide the basis for the refusal of the registration of an identical or similar mark for identical or similar goods. Where the mark is well known and registered in Rwanda, it can form the basis to prevent registration of a similar mark also in respect of goods or services not similar to those of the well-known mark.

### Advantages of trade mark registration

The registration of a trade mark affords the owner the sole right to use the mark on the relevant goods and services, and to authorise others to use the mark. The owner also acquires the right to institute proceedings against persons who infringe his rights.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- certification marks
- collective marks
- geographical indications.

### Definition of a trade mark

A trade mark is defined as any visible sign enabling the products (product marks) or services (service marks) of one company to be distinguished from those of other companies.

A sign may be

- any form of denomination including words, names, letters, figures and acronyms
- figurative elements such as designs, relief, product forms or packaging
- colours or combinations of colours
- combinations of the above.

### Definition of a certification trade mark

Certification marks are defined as signs or combination of signs capable of designating any common characteristic, including quality, origin or methods



of production, of goods and services and which are used under the control of the owner of the signs.

**Definition of a collective trade mark**

A collective mark is defined as any visible sign (designated as such in the registration application) allowing the origin and any other common feature to be distinguished, including the quality of products or services of different companies that use this sign under the supervision of the owner of the collective mark registration.

**Definition of a geographical indication**

A geographical indication is defined as an indication used to identify the origin of a product as from a province, region or area of a country, in case where its quality, reputation or any other particular feature may be attributed essentially to its origin.

**Limitation to colour**

A mark may comprise a colour or a combination of colours.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. Rwanda follows a multi-class application system and a single application may cover more than one class.

**Convention priority**

Rwanda is a member of the Paris Convention. An applicant may claim priority in accordance with the Paris Convention or a bilateral, regional or multilateral convention to which Rwanda is a party. Priority may be based on one or more previous national, regional or international applications.

**Application**

An application is filed at the Rwanda Trade Marks Office, administered by the Ministry in charge of Industry.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (notarised), in French
- reproduction of the trade mark
- list of the goods or services to be covered
- priority document (certified copy), in French, if priority is claimed.

The same filing requirements apply to the registration of collective and certification marks. However, the collective mark shall be accompanied by a copy of the regulations determining the conditions of use of the collective mark, and the certification mark application shall be accompanied by the rules governing its use. Furthermore, the owner of a certification mark may not use the sign to identify or certify his own goods or services.

**Examination/procedure**

The Registrar shall examine the application to determine whether it complies with the formal and substantive requirements. The Registrar shall, if he is satisfied that the application complies with the requirements, accept the application and advertise the application for opposition purposes in the Trade Marks Journal. Thereafter the registration certificate will be issued.

**Opposition**

The Law makes provision for opposition to be lodged following advertisement of the trade mark application. The Law does not indicate the period in which to file the opposition; this is to be prescribed by regulation. In terms of a Ministerial Decree issued in 2010, it seems that this time period may be 30 days. The position is somewhat uncertain; at the time of writing, no publication of trade mark applications had taken place.

**Opposition proceedings**

Any interested person gives the empowered authority notice of his opposition to the registration of the mark. The empowered authority must send a copy of the notice to the applicant who shall, within the prescribed time limit, send to the empowered authority a response explaining the grounds on which he bases his application. In the absence of this response, the applicant will be considered to have abandoned his application.

**Grounds of opposition**

Both absolute and relative grounds of opposition are available.

A mark cannot be registered if it is –

- a mark that is identical with, or confusingly similar, to a trade mark or trade name which is well known in Rwanda for identical or similar products of another company, or constitutes a translation of this mark or trade name; or if the existing mark is well known and is registered in Rwanda for products or services which are not identical or similar to those for which registration of the mark is requested, if the use of the new mark in relation to those products or services will indicate a link with the owner of the registered well-known mark, and if this is likely to damage the interests of the owner of the registered mark
- a mark that is identical with or similar to a mark belonging to another owner and which is already registered, and which advertises the same or similar products or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion (In the case of an identical sign for identical products or services, a likelihood of confusion shall be presumed.)
- a mark which is likely to mislead the public or traders, particular as regards to the geographical origin, quality, nature or characteristics of products or services
- a descriptive mark, if it contains, among its components, reference of essential characteristics of the product or service (Words or expressions in common use by consumers and technical words or expressions that

pertain to the field of the products and services shall not having distinctive characteristics.)

- a mark in an application that is made in bad faith or where the mark, if registered, would serve unfair competition purposes
- a mark that is contrary to public order or to morality
- a mark that reproduces, imitates or contains, among its features, a coat of arms or armorial bearing, flags or other emblems, the name or official sign or hallmark of a state or intergovernmental organisation, unless authorisation is given by such a state or organisation.

### **Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of filing and, thereafter, is renewable for like periods. It is possible to effect the late renewal of a registration, but not exceeding the 10 months grace period granted by the Registrar, upon payment of the late penalty fee.

According to the transitional provisions, a trade mark registered under the old 1963 Act shall remain valid and must be considered to have been granted or registered under the new 2009 Law. A trade mark that has been registered under the old 1963 Act must be renewed within 10 years of the date on which the new Law came into force.

### **Cancellation/removal of a trade mark**

Any interested person may request the competent court to invalidate or cancel the registration of a mark.

### **Grounds for cancellation/removal of a trade mark**

A trade mark registration may be invalidated and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds of opposition** above), in addition to the following:

- that there has been no use of the trade mark for a continuous period of three years or more after it was registered
- that a collective trade mark is only being used by its owner, or that the owner allows it to be used in contravention of its regulations or in a manner which is likely to deceive the public as to the origin or other characteristic common to the goods or services. Similar provisions relating to the invalidation of certification marks and geographical names also apply.

### **Use requirement and cancellation**

The Law provides that any interested person may request the removal of a mark from the register on the ground of non-use (see the section on **Grounds for cancellation/removal of a trade mark** above). The mark shall not be removed if the owner can show that particular circumstances existed which prevented use of the mark, and that there was no intention not to use the mark or to abandon it.

**Assignment**

The rights in a mark may be transferred by assignment. A mark must be assigned with the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (notarised)
- deed of assignment.

The same requirements apply for the assignment of a collective mark; however, the assignment must be approved by the empowered authority.

**Licensing/registered users**

Licensing of a trade mark is recognised. Recordal of the licence agreement is required in order to be effective against third parties. Any licence agreement shall provide for the effective control over the quality of the goods or services of the licensee by the licensor.

Requirements for recordal:

- power of attorney by the licensee (notarised)
- power of attorney by the licensor (notarised)
- licence agreement.

A collective mark which is registered, or for which registration is required, may not be subject to a licence agreement.

**Amendment**

No provision.

**Rights conferred by registration**

A trade mark registration confers on the owner the exclusive right to use the registered trade mark for all goods or services for which it is registered. Use by any person other than the owner, requires the owner's consent. The owner shall also have the right to institute proceedings against persons who infringe his rights by using the registered trade mark without his authority.

**Trade mark infringement**

The owner of the registration of a mark shall be entitled, in addition to all other available rights, to undertake judicial proceedings against any person who infringes the mark by using it, without the owner's consent, or who performs acts which make it likely that infringement will occur. That right shall extend to the use of a sign similar to the registered mark, and to use in relation to products and services similar to those for which the mark is registered, when this may lead to confusion in the minds of the public.

The rights acquired by registration do not extend to acts relating to goods or services lawfully put on the market, either by the proprietor or with the proprietor's consent.

**Defences to trade mark infringement**

Although no defences are expressly listed in the Act, provision is made for limitations of rights. Thus there is provision that, in the case of compulsory licences for patents, the importation of products provided with a trade mark will be authorised by the Minister. Further, the Minister of Health may implement measures to authorise or limit the use of marks to facilitate the prescription of, and access to, generic pharmaceutical products and medical services.

**Relief for trade mark infringement**

The Law has extensive provisions to provide for the relief available to the owners of *inter alia* trade marks, in the event of infringement. This includes provisional measures (to conserve evidence); corrective measures (for the cessation of infringement, including seizure and forfeiture); corrective measures to compensate the owner for loss suffered (damages); and criminal penalties.

**Common law rights**

No information available.

**Unfair competition**

The Law also incorporates relief against acts in the course of industrial or commercial activities that are unlawful or contrary to honest practices. Those acts are regarded as acts of unfair competition and include activities that have consequences for trade mark owners and users.

**Marking of goods**

Notice of registration by use of the legend 'Marque Déposéé' is optional.

**PATENTS****Law**

- Law no 31 of 2009 on the Protection of Intellectual Property

Rwanda is a member of the Paris Convention, the PCT, ARIPO (Harare Protocol), and the WTO/TRIPS.

**Patent protection**

Patent protection is available via a national filing or via an ARIPO application designating Rwanda. Rwanda has not yet implemented the Harare Protocol (which regulates patent and design filings in ARIPO) and the provisions of PCT in its national laws. However, it appears that valid patent protection could be obtainable by filing via ARIPO or PCT, based on a specific provision of the Intellectual Property Law, which states that the provisions of any international intellectual property treaty of which Rwanda is a party, shall apply. Furthermore, in case of conflict with the provisions of this Law, the provisions of the international treaty shall prevail.

### **Types of patents**

The Law provides for the following:

- a patent in respect of an invention that is new, inventive, and industrially applicable
- a divisional patent, divided out of an initial application that contained more than one invention
- a utility model certificate for an invention that is new and industrially applicable but with a lower level of inventiveness.

A divisional patent is entitled to the filing date or priority date of the initial patent. An application for a utility model certificate may, prior to grant, be converted to a patent application, and *vice versa*.

### **Patentable subject matter**

An invention is defined as an idea of a creator which, in practice, provides the solution to a particular technical problem. An invention may consist of, or relate to, a product or a process.

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- discoveries, scientific theories and mathematical methods
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body (this provision shall not apply to products for use in any of those methods)
- substances, even if purified, synthesised or otherwise isolated from nature (this provision shall not apply to the processes of isolating those substances from their original environment)
- known substances for which a new use has been discovered (this provision shall not apply to the use itself, where it constitutes an invention)
- plants and animals, including their parts, other than micro-organisms and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes and products obtained from such processes
- animal and plant varieties
- pharmaceutical products (for the purposes of international conventions to which Rwanda is party)
- inventions the commercial use of which is contrary to public order and to morality.

Certain exclusions are provided in respect of computer-generated or computer-implemented inventions.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application

- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Rwanda is designated
- an ARIPO application designating Rwanda
- a divisional application, where the original application covers more than one invention
- an application for a utility model, for an invention with a lower level of inventiveness and which may be converted, prior to grant, to a patent application.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Patents. Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (notarised)
- assignment from the inventor(s), or a statement by the applicant justifying its right to the invention
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

Failure to file the priority document within the stipulated time period will lead to the lapsing of the priority claim.

### **Applicant**

The inventor or his successor in title may apply for registration. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it is not anticipated by prior art. The prior art consists of everything that has been disclosed, anywhere in the world, by publication in tangible form, by oral disclosure, by use or in any other way, prior to the filing or priority date.

### **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Rwandan filing date or priority date (if convention priority is claimed) is provided, during which a disclosure of the invention resulting directly or indirectly from acts committed by the applicant or his predecessor, or from abuse committed by a third party with regard to the applicant or his predecessor in title, will not be taken into account.

### **Inventiveness**

An invention is considered inventive if, for a person skilled in the art in that area, it is obvious that there is progress from the prior art compared to the invention as claimed.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Rwanda is filed within 12 months from the earlier application.

### **Examination/procedure**

Applications are subjected to formal examination which takes place automatically.

### **Opposition**

The Law does not provide for opposition to the grant of a patent by third parties.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant and publish the patent.

### **Duration and maintenance**

The duration of a patent is 20 years from the filing date. Maintenance fees are payable annually, starting from the first anniversary of the filing date. A six months grace period is provided subject to payment of surcharges.

### **Restoration**

No provision.

### **Revocation**

Revocation is possible by a competent judicial authority on application by an interested person and on specific grounds, namely that:

- the invention is not an invention as defined in the Law
- the patentee is not the inventor or a rightful claimant
- the invention is not patentable
- the invention is not new
- the invention is not industrially applicable
- invention does not involve an inventive step
- the invention is excluded from patent protection
- the application did not comply with the requirements laid down in the Law, ie the invention was not fully disclosed, claims not fully supported etc.

### **Assignments and licences**

Assignments and voluntary licences are recognised and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

Non-voluntary or compulsory licences may be granted in different circumstances.



A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

A compulsory licence may be granted in cases of abusive exercise of exclusive rights. The Minister is given the authority to grant such a licence, after consultation with different interested parties (eg other licensees) and after a decision by Cabinet. There is no definition of the concept 'abusive exercise'.

A compulsory licence may be granted in cases where a subsequent patent cannot be used in Rwanda without infringing a previous patent. Again consultation and a Cabinet decision will be required. Furthermore, the invention of the subsequent patent must represent significant technical progress and considerable economic interest.

Provision is also made for *ex officio* compulsory licences in cases of public interest, particularly national security, public health, environmental protection.

Furthermore, provision is made for a limitation to be placed on patent rights by way of exhaustion of rights. The Minister is given the authority of declaring patent rights exhausted and thus authorising the importation of the patented product. The Law outlines the considerations to be taken into account.

### **Amendments**

Amendments can be made at any time prior to grant, but the amendments shall not go beyond the disclosure of the invention in the application as filed.

After grant the patentee can make a formal request to amend the patent text or drawings, intended to limit the scope of the protection conferred.

### **Effect of a patent**

The registration of a patent confers on the owner the exclusive right to use the invention in Rwanda; use by any other person shall require the authorisation of the owner. Use in this context means the following acts:

- making, importing, offering for sale, selling and using a patented product
- stocking such product for purposes of sale or use
- using a patented process, and carrying out the above acts in respect of a product of the process.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis. The remedies available to the patentee include injunction, damages and any other compensation provided by the Rwandan civil and commercial legislation.

### **Marking**

No requirement.

### **Working**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, the Minister may grant a compulsory licence on the grounds that the invention is not being worked in Rwanda, or that the patentee is abusively exercising his exclusive rights to the patent; or on the ground that the invention claimed in a subsequent patent cannot be used in Rwanda without infringing a previous patent (see the section on **Compulsory licences** above).

### **Utility model certificates**

The Law provides for the registration of utility model certificates in respect of inventions that are new and industrially applicable, although not necessarily inventive. Certain subject matter is excluded from utility model protection (on a similar basis as exclusion from patentability).

A utility model certificate expires, without a possibility of renewal, 10 years after the date of filing.

A utility model certificate may be invalidated on certain prescribed grounds, *inter alia* that the owner is not the inventor or his successor in title, lack of novelty, etc.

At any time before the grant or refusal of a utility model certificate, the application may be converted to a patent application. A patent application may likewise be converted to an application for a utility model certificate.

## **DESIGNS**

### **Law**

- Law no 31 of 2009 on the Protection of Intellectual Property

Rwanda is a member of the Paris Convention, ARIPO (Harare Protocol), the Hague Agreement on Designs, and the WTO/TRIPS.

### **Design protection**

Design protection is available by a national filing. Since Rwanda is a member of ARIPO (Harare Protocol) and the Hague Agreement it is expected that design protection could also be obtained by designation in ARIPO applications and international applications under the Hague. However, Rwanda has not yet implemented these treaties in its national laws, so that the position is uncertain. It appears that valid protection could possibly be obtained on the basis of a specific provision in the 2009 Law to the effect that the provisions of any international treaty of which Rwanda is a party, shall apply in Rwanda and shall prevail over the law in Rwanda.

Since Rwanda is a member of the Paris Convention, priority may be claimed on the basis of an earlier application.

### **Registrable subject matter**

An industrial design shall be any assembly of lines or colours, and any plastic shape, associated with lines or colours or otherwise, provided that this

assembly or shape gives a special appearance to an industrial or craft product and may serve as a model for the manufacture of an industrial or craft product.

### **Classification of designs**

The Locarno International Classification of Designs is applied. Separate applications are required for each class.

### **Types of applications**

Application for a design registration may be made by way of –

- a non-convention application, where the effective date is the date of filing
- a convention application, where the effective date is the date of the first filing in a convention country
- an international application under the Hague in which Rwanda is designated
- an ARIPO application designating Rwanda.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Rwanda Design Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

A single application filed in Rwanda may be in respect of two or more designs, provided that the designs relate to the same class of the International Classification or the same set or composition of articles.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment document (if the applicant is not the creator)
- drawings, photographs or other graphic reproductions of the article embodying the design
- certified copy of priority document (if applicable).

### **Applicant**

The author or creator or his assignee may apply for registration.

### **Convention priority**

An applicant who has filed a design application in a convention country is entitled to claim priority from such earlier application, provided the application in Rwanda is filed within six months from the earlier application.

### **Novelty**

Absolute novelty is required. However, a grace period is provided of six months immediately preceding the Rwandan filing date or priority date (if convention priority is claimed), in cases where disclosure of the industrial design resulted directly or indirectly from acts committed by the applicant, or from violation

committed by third party with regard to the applicant. Such disclosure will not destroy novelty.

### **Examination/procedure**

Formalities examination is conducted. The Law also provides that examination should be conducted to ensure that the design falls within the definition of a registrable design. The Law also prohibits registration of designs which are contrary to public order or morality.

### **Opposition**

The Law does not provide for opposition to the registration of a design by third parties.

### **Duration and maintenance**

The initial term of the design registration is five years from the Rwandan filing date, which term is extendible upon payment of renewal fees for two further five year terms. A six months grace period is provided for late payment of renewal fees subject to payment of surcharges. If the renewal is not effected in time, the registration of the design shall lapse.

### **Restoration**

The Law provides that a lapsed design registration cannot be restored.

### **Revocation**

No provision.

### **Assignments and licences**

The right to a design may be transferred, and voluntary licences may be granted. However, changes in ownership or licence agreements must be recorded in the register to have any effect against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

Compulsory licences for industrial designs shall be granted only in cases of failure or insufficiency of use, and in order to eliminate abusive and anti-competitive practices. The Law also gives the Minister the authority to place a limitation on the owner's exclusive right on the basis of the exhaustion of rights. Thus, the Minister may declare the owner's right exhausted, to permit importation of articles embodying the design into Rwanda. The Law sets out the considerations to be taken into account by the Minister.

### **Rights conferred by registration**

The registration of a design confers on the owner the exclusive right to use the design in Rwanda, and to authorise other persons to use the design. Use in this context means the manufacture, sale or importation, for commercial purposes, of items incorporating the design.

**Infringement**

Infringement proceedings may be brought in at a competent court on a civil and/or criminal basis. The remedies available to the owner of the design includes injunction, damages, seizure, confiscation and destruction of the infringing articles, fine or imprisonment, and any other compensation provided by the Rwandan civil and commercial legislation.

**Marking**

No provision.

**Working**

If a registered design is not used or is insufficiently used, then a compulsory licence will be granted.

**COPYRIGHT****Law**

- Law no 31 of 2009 on the Protection of Intellectual Property

Rwanda is a member of the Berne Convention, the Rome Convention, the Universal Copyright Convention, and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law provides for copyright in respect of literary and artistic works that are original intellectual creations, including:

- works expressed by writing, eg books, pamphlets and computer programs
- conferences, speeches, lectures, addresses, sermons and other oral works
- musical works
- dramatic and dramatico-musical works
- choreographic works, pantomimes
- audiovisual works
- works of fine art, eg painting, drawing, sculpture, engraving, lithography, tapestry
- works of architecture
- photographic works
- works of applied art or craft, eg handicraft, industrial designs
- illustrations, maps, plans, sketches, three-dimensional works relating to geography, topography, architecture
- works derived from Rwanda folklore.

The following shall also be protected:

- translations, adaptations, arrangements of works
- collections of works, expressions of folklore, or of facts or data.

### **Exclusions from copyright**

Excluded from protection are:

- official texts of a legislative, administrative or judicial nature
- daily news
- ideas, procedures, systems, methods of operation, concepts, principles.

### **Registration of copyright**

No requirement for registration.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author must be a national or resident of Rwanda, or the work must have been first published in Rwanda. Since Rwanda is a member of the Berne Convention, copyright protection is extended to works eligible under such treaty.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. Copyright entails moral rights which shall belong to the author, including the right to claim authorship and to be recognised as the author; and the right to object to distortion, mutilation or modification of the work which would be prejudicial to his honour or reputation. The moral rights cannot be assigned.

Copyright also entails economic rights, including the right to carry out or authorise any of the following acts:

- reproduction of the work
- translation of the work
- adaptation, arrangement or transformation of the work
- rental of certain works
- communication of the work to the public
- public performance of the work
- broadcasting the work.

### **Duration of copyright**

Copyright generally endures for the lifetime of the author plus 50 years as regards the economic rights entailed therein. The copyright in works of applied art is 50 years.

### **Protection afforded by copyright**

Copyright confers on the copyright owner the exclusive right to use and exploit the copyright work, and to authorise the use and exploitation by others. The use entails the acts set out above (see the section on **Authorship and ownership** above).

### **Assignment and licensing of copyright**

The economic rights inherent in copyright can be assigned or licensed.

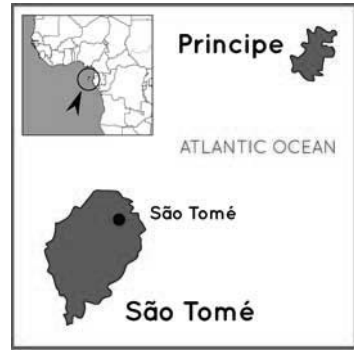
## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Rwanda.

# SÃO TOMÉ AND PRINCIPE (ST THOMAS AND PRINCE'S ISLANDS)

## GENERAL INFORMATION

São Tomé and Príncipe islands lie off the coast of Western Africa, in the Atlantic Ocean. The islands are located in the Gulf of Guinea, about 300 kilometers off the coast of Gabon, just north of the equator.



<b>Area:</b>	964 km <sup>2</sup>
<b>Population:</b>	0.2 million
<b>Capital:</b>	São Tomé
<b>Currency:</b>	Dobra
<b>GDP:</b>	\$ 316.9 million (2010)
<b>Internet domain:</b>	.st
<b>Languages:</b>	Portuguese (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Cocoa; copra; coffee; palm oil
<b>Imports:</b>	Machinery and electrical equipment; food products; petroleum products

## International/regional conventions

São Tomé and Príncipe is a member of the following international agreements:

- Hague Agreement on Designs (since 2008)
- Madrid Protocol on Marks (since 2008)
- Paris Convention (since 1998)
- Patent Cooperation Treaty (since 2008)
- WIPO Convention (since 1998)

## IP legislation

Trade marks

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

Patents

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

Designs

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

Copyright

- Decree-Law no 46 980 of 1966 on Copyright Code

Related areas

- Decree no 36 of 1997 on the Agreement between the Portuguese Republic and the Democratic Republic of São Tomé and Príncipe on the Mutual Promotion and Protection of Investments

## **TRADE MARKS**

### **Law**

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

São Tomé and Príncipe is a member of the Paris Convention and the Madrid Protocol.

The Industrial Property Law of São Tomé and Príncipe is silent on whether recognition is given to trade mark applications which are filed in terms of the Madrid Protocol which designate this country. It would appear, however, from the context of the provision in the Industrial Property Law which recognises and gives effect to São Tomé and Príncipe's treaty obligations, that there was an intention to implement these treaties.

Applications may be filed as national applications and, in appropriate circumstances, claiming convention priority in terms of the Paris Convention. International applications filed in terms of the Madrid Protocol may also designate São Tomé and Príncipe.

### **Trade mark protection**

Provision is made for the registration of trade marks for goods and for services, and for collective marks.

No express provision is made for defensive marks.

### **Protection of well-known marks**

A mark cannot validly be registered if it is identical or similar to a trade mark that is well known in São Tomé and Príncipe for similar goods, and the use of the later mark is likely to cause confusion.

### **Advantages of trade mark registration**

The exclusive right to a trade mark is acquired by way of registration. Any use by third parties in respect of the relevant goods and services shall be subject to the owner's consent.

### **Types of trade marks**

The following types of trade marks are registrable:

- product and service marks
- collective marks.

### **Definition of a trade mark**

A mark is defined to mean any visible sign capable of graphic representation distinguishing the products or the service of a company from those of other companies.



### **Definition of a collective trade mark**

A collective mark means any visible sign capable of graphic representation distinguishing the origin or any other common characteristic, notably the quality of products or services of companies that use the sign under the control of the association owning it.

### **Limitation to colour**

There is no express reference to colour.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A single application may cover more than one class.

### **Convention priority**

São Tomé and Príncipe is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right, to be accorded the same date as the first filed application.

### **Application**

An application is filed at the National Office of Industrial Property in Portuguese. The following information and documents are required:

- full particulars of the applicant
- authorisation of agent (simply signed), in Portuguese
- list of goods or services to be covered, separated in accordance with the relevant classes
- electronic reproduction of the mark in the size prescribed by the relevant laws
- certified copy of the priority document (if applicable), with Portuguese translation.

### **Examination/procedure**

Prior to registration, the application will be subject to formal and substantive examination. If the application meets the formal and substantive requirements for registration, it will be published in the Official Journal for opposition purposes. The applicant will, if no opposition is filed, or if an opposition is unsuccessful, be notified that the application has proceeded to grant.

### **Opposition**

Third parties may oppose an application within 90 days of advertisement in the Official Journal. The Director of Industry may, under conditions determined by him, extend the opposition term.

### **Opposition proceedings**

Opposition proceedings are commenced by an opponent filing with the National Office a notice of opposition within 90 days from the publication of a trade mark application.

The trade mark applicant may respond to the notice of opposition within 90 days of receipt of the notice of opposition.

The Registrar of Trade Marks will then consider the opposition and notify the parties of his decision.

### **Grounds for opposition**

A mark shall not be validly registered if:

- it does not distinguish the goods or services of a company from those of other companies
- it is contrary to good morals
- it is likely to mislead the public as to the geographical origin or the nature or the characteristics of the goods or services that are covered by the mark
- it reproduces, imitates or incorporates the weapons, flags or other signs, a name or an acronym or a sign or official function of a state or of an intergovernmental organisation, except if the competent authority of that state or of that organisation authorises the mark
- it is identical or similar to a mark or trade name that is well known in São Tomé and Príncipe in relation to identical or similar products, and if used is likely to cause confusion, or if the mark is a translation of the well-known mark or of that trade name
- it is identical to a mark that is owned by another proprietor that has already been registered or that is the subject of an earlier priority application for similar goods or services, or if it is so similar to the registered trade mark so as to be likely to mislead or cause confusion.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the date of filing, and is renewable thereafter for similar periods subject to payment of the prescribed fee. A grace period of six months is allowed for such payment, provided that a penalty is paid.

### **Cancellation/removal of a trade mark**

Any interested person may request the Director of Industry to cancel a registered trade mark in relation to the goods or services for which the mark is registered, due to the fact that, up to a month before the application for cancellation, the mark has not been used by the proprietor of the mark or the licensed user for an uninterrupted period of five years.

However, the mark will not be cancelled if it is proved that special circumstances exist that made it impossible for the proprietor of the trade mark to use the mark, and that there was never an intention on the part of the proprietor not to use the mark or to abandon it.

The Law also provides that any person can submit an application to the National Service for Intellectual Property for the cancellation or annulment of a trade mark registration on further grounds, namely:

- if the applicant for the cancellation provides evidence that the trade mark was registered contrary to his common law rights, or that he is the owner of a prior trade mark and that the mark that he seeks to cancel is an infringement of the prior registered trade mark
- if the applicant shows that the mark that was registered is not capable of distinguishing the goods or services of the proprietor from those of others.

The cancellation of the registered trade mark is considered to be effective from the date on which the trade mark was registered and shall be published as soon as possible.

#### **Use requirement and cancellation**

A trade mark registration is vulnerable to cancellation if the registered mark has not been used within a period of five years from the date of registration, unless the owner of the mark proves that special circumstances made it impossible to use the mark and that there was no intention to abandon it (see the section on **Cancellation/removal of a trade mark** above).

#### **Assignment**

Assignments are possible. The Industrial Property Law is silent on the issue whether assignment may be made with or without the goodwill of the business. This law is also silent on the issue whether it is possible to assign the mark in respect of some or all of the goods or services covered by the registration.

Any assignment of a registered mark must be in writing and recorded at the National Office of Industrial Property.

Requirements for recordal:

- power of attorney (simply signed), in Portuguese
- deed of assignment, with sworn Portuguese translation.

#### **Licensing/registered users**

Licensing of a trade mark is recognised. A licence agreement must be in written form and must be recorded at the National Office of Industrial Property in order to be enforceable against third parties. A licence agreement must provide for effective control by the licensor over the quality of the goods or services of interest. A licence agreement shall not be valid unless the quality control is effective.

A collective mark cannot be licensed.

Requirements for recordal:

- power of attorney from both proprietor and licensee (simply signed), in Portuguese
- licence agreement, with sworn Portuguese translation.

**Amendment**

The National Office of Industrial Property may invite an applicant to correct any material error, error of translation, transcription, inscription, and/or any error contained in an application or document deposited at the National Office of Industrial Property which arose as a result of negligence.

**Rights conferred by registration**

The registration of a trade mark gives the owner the right to authorise the use of the mark. Any use of the mark by third persons requires the consent of the owner. In addition, the owner has the right to institute judicial proceedings against anyone who violates his rights, *inter alia* by the use of an identical or similar mark on goods or services identical or similar to those in respect of which the mark was registered, if the result will be confusion of the public.

**Trade mark infringement**

Once a trade mark has been registered, the use of the mark in relation to the goods or services to which the registration extends, is subject to the proprietor's approval.

The owner of a registered trade mark has the right to initiate judicial action against anyone who uses his registered trade mark without his authority. Another party may not use a mark that is identical or similar to the registered trade mark in relation to the identical or similar goods or services if the use of the mark will cause the public to be confused.

The rights granted by the registration of a mark do not prevent the use of the mark in relation to goods that have been placed on the market in São Tomé and Príncipe by the owner of the trade mark or with his consent.

**Defences to trade mark infringement**

The rights granted by the registration of a trade mark do not include the act of selling, in the trade, goods to which the trade mark proprietor's trade mark has been applied with his consent.

**Relief for trade mark infringement**

The owner of a registered trade mark has the right to initiate judicial action against anyone who violates his trade mark rights.

**Common law rights**

The Law gives some recognition to common law rights inasmuch as protection is given to trade names against any unlawful action by a third party, even without registration of such trade name. However, the exclusive right to a trade mark is acquired by registration under this Law.

The Act also recognises unfair competition. Acts of unfair competition include:

- any act that is contrary to the honest customs in the industry or in the commerce

- any act that is likely to lead to confusion in the trade regarding the business, products or activities of a competitor
- any false statement, in the course of trade, that is likely to harm the reputation of the business, goods or activities of a competitor
- any statement that may mislead the public as to the characteristics, manufacturing process, purpose or quantity of goods.

### **Marking of goods**

The use of a false or misleading denomination of origin is illegal. It is advisable to follow the importer's instructions or specific contract specifications.

## **PATENTS**

### **Law**

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

São Tomé and Príncipe is a member of the Paris Convention and the PCT.

### **Patent protection**

Patent protection is available via a national filing.

Although São Tomé and Príncipe is a member of the PCT, the national laws have not yet been amended to cater for the PCT. Accordingly, it is not clear whether enforceable rights will be obtained via PCT national phase filings in São Tomé. The Law does contain a general provision to the effect that the provisions of any international treaty concerning IP to which São Tomé and Príncipe is a party, are applicable and supersede national law. This provision provides a basis for PCT applications.

### **Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable. An invention is defined as the idea of an inventor which provides a solution to a specific technical problem.

The following inventions are not patentable

- discoveries, scientific and mathematical theories
- schemes, plans, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (this provision shall not apply to products for use in any of these methods).

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application

- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- an international application under the PCT in which São Tomé is designated.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in Portuguese
- assignment of invention (if the applicant is not the inventor)
- specification (including claims, abstract and drawings), in Portuguese
- certified copy of the priority document (if priority is to be claimed), together with a Portuguese translation
- International Preliminary Report on Patentability (for PCT applications).

### **Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

### **Novelty**

An invention is considered new if it is not anticipated by prior art.

Absolute novelty is required. An invention is new if there is no anticipation by the state of the art. The state of the art encompasses everything that has been disclosed anywhere in the world by publication, or in São Tomé and Príncipe by oral disclosure, by use or in any other way before the filing or priority date.

### **Certain knowledge or publication excused**

A grace period of 12 months immediately preceding the São Tomé filing date or priority date (if convention priority is claimed) is provided, where disclosure of the invention was made by the inventor or by his predecessor in title or the disclosure was as a result of abuse committed by third party.

### **Inventiveness**

An invention is considered to involve an inventive activity if, to a person with average knowledge in the field, the invention does not result in an evident manner from the state of the art.

### **Convention priority**

Whilst São Tomé is a member of the Paris Convention, the Law does not contain any express provision regarding claiming priority. Likewise the Law does not contain provisions in regard to PCT applications, apart from a general provision which recognises and gives effect to the treaty obligations of São Tomé and Príncipe.

**Examination/procedure**

Applications are subjected to formal examination.

**Opposition**

No provision

**Publication**

The Law provides that where the Registrar grants a patent, the Registrar shall publish reference of the grant of the patent in the prescribed manner.

**Duration and maintenance**

The term of a patent is 20 years from the filing date. An annual fee is payable as from the first anniversary of filing. A grace period of six months is allowed for the late payment of the annual fee subject to payment of surcharges.

**Restoration**

No provision.

**Revocation**

Any interested party may request the court to invalidate a patent on the basis of non-compliance with formal and substantive requirements. Invalidation of a patent can also be requested on the basis that the owner of the patent is not the inventor or the inventor's successor in title.

**Assignments and licences**

Change in ownership and licence contracts are recognised but will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed), in Portuguese
- original or certified copy of the assignment document, with a Portuguese translation; or
- original or certified copy of the licence agreement, with a Portuguese translation.

**Amendments**

The applicant may at any time request an application to be amended, provided the amendments shall not go beyond the disclosure in the initial application.

**Compulsory licences**

Any interested party may request a compulsory licence to be issued where the invention is not sufficiently explored in an industrial manner in São Tomé. The Law is however, silent regarding the period within which an invention must be worked.

The Law also provides that, when public interest so requires, and specifically national security, nutrition, health, or the development of crucial sectors of the economy, the Ministry may decide, even without agreement of the patent owner, to authorise a third person in the service of the State to exploit the invention. The patent owner will be compensated.

### **Effect of a patent**

The registration of a patent gives the owner the right to authorise or prohibit any other person to exploit the patented invention. Exploitation of an invention is defined to include the following acts:

- manufacturing, importing, offering for sale, selling or using the patented product
- retaining stocks of the product for purposes of sale or use
- using a patented process
- doing any of the above acts in relation to a product of the patented process.

The patent owner has the right to institute judicial action against anyone who violates his rights.

### **Infringement**

Infringement proceedings may be brought in a competent court for appropriate remedy.

The Law provides for certain exceptions when there will be no infringement, including:

- acts relating to products put on the market in São Tomé by the owner of the patent
- acts relating to scientific research
- acts performed by a person in good faith prior to the filing or priority date; such person will be allowed to continue with such acts.

### **Working**

Working of a granted patent is provided for in the Law. However, the Act is silent regarding the deadline within which to work the invention.

The Law does provide that working means sufficiently exploiting the invention in an industrial manner; this is to be determined on a case-by-case basis.

## **DESIGNS**

### **Law**

- Law no 4 of 2001 on Industrial Property
- Decree no 6 of 2004 on Regulation on Industrial Property

São Tomé and Príncipe is a member of the Paris Convention and the Hague Agreement.

Although São Tomé and Príncipe has acceded to the Hague Agreement, the national law has not yet been amended to provide for international



applications designating São Tomé. Accordingly, it is not clear whether enforceable rights can be obtained in that manner. The Law does contain a general provision to the effect that the provisions of any international treaty concerning IP to which São Tomé and Príncipe is a party, are applicable and supersede national law.

### **Design protection**

Design protection is available by way of a national filing.

### **Registrable subject matter**

An industrial design is defined as any assembly of lines, colours or any forms of three dimensions, associated or not with lines and colours, provided that assembly or that form provides for a special aspect to an industrial or craft product, and can be used as a model for manufacturing an industrial or craft product.

Designs which serve solely to obtain a technical result are excluded from protection.

### **Classification**

No provision.

### **Application**

Non-convention and convention applications are filed with the Registrar's office.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in Portuguese
- deed of assignment (if applicable), with Portuguese translation
- representations of the design
- certified copy of the priority application (together with Portuguese translation).

### **Applicant**

The creator of the design may apply, or his successor in title.

### **Convention priority**

São Tomé is a member of the Paris Convention. Accordingly, priority can be claimed from an earlier application in a convention country, provided the application in São Tomé is filed within six months.

### **Novelty**

Absolute novelty is required. An industrial design will be new if it has not been disclosed anywhere in the world by a publication, or in São Tomé and Príncipe by oral disclosure, by use or in any other way prior to the filing or priority date.

A grace period of 12 months immediately preceding the São Tomé filing date or priority date (if convention priority is claimed) is provided, where disclosure of the design was made by the author or by his predecessor in title, or if the disclosure was as a result of abuse committed by a third party.

### **Examination/procedure**

Applications are subjected to formal examination.

### **Opposition**

No provisions.

### **Revocation/invalidation**

Any interested person may apply to the court to declare a design registration invalid or void. Such an application can be based on the grounds that the design did not comply with the requirements of the law, or that the owner is not the creator or his successor in title.

### **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. A grace period of six months is allowed for the late payment of the renewal fee, subject to payment of surcharges.

### **Assignments and licences**

Change in ownership and licence contracts must be recorded at the Registrar's office.

Requirements for recordal:

- power of attorney by the applicant (simply signed), in Portuguese
- original or certified copy of the assignment document, with Portuguese translation; or
- original or certified copy of the licence agreement, with Portuguese translation.

### **Compulsory licences**

No provisions.

### **Effect of a design registration**

A design registration confers on the owner the right to authorise or prohibit the exploitation of the design by others. Exploitation of a design means the manufacture, sale, or importation of articles incorporating the registered design.

The owner also has the right to institute judicial proceedings against anyone who exploits the design without his consent.

### **Infringement**

Infringement proceedings may be brought in a competent court for appropriate remedy.

**Marking**

Not required.

**Working**

No provisions.

**COPYRIGHT**

**Law**

- Decree-Law no 46 980 of 1966 on Copyright Code

São Tomé and Príncipe is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent and surrounding islands is not always generally available. In the case of São Tomé and Príncipe, a law was passed in 1966 establishing the Code on Copyright. However, an English version of this law could not be obtained, and it is not clear whether the law has in fact been implemented. As indicated above, São Tomé and Príncipe has not yet acceded to the Berne Convention. Accordingly, no commentary on copyright could be given at the time of writing.

**PLANT BREEDERS' RIGHTS**

It has not been possible to determine whether or not São Tomé and Príncipe has legislation or a protection regime for the protection of plant varieties.

# SENEGAL

## GENERAL INFORMATION

Senegal is an independent republic in West Africa, bounded on the north by the Islamic Republic of Mauritania, on the east by Mali, on the south by the Republic of Guinea and Guinea-Bissau, and on the west by the Atlantic Ocean. Senegal surrounds The Gambia on the land side.



<b>Area:</b>	196 722 km <sup>2</sup>
<b>Population:</b>	12.3 million
<b>Capital:</b>	Dakar
<b>Currency:</b>	CFA Franc
<b>GDP:</b>	\$ 23.8 billion (2010)
<b>Internet domain:</b>	.sn
<b>Languages:</b>	French (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Fresh and processed fish; fuels; groundnuts and related products; phosphates; cotton
<b>Imports:</b>	Food and beverages; capital goods; fuels

## International/regional conventions

Senegal is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1962)
- Hague Agreement on Designs (since 1984)
- Nairobi Treaty on Olympic Symbol (since 1984)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1978)
- WIPO Convention (since 1970)
- WIPO Copyright Treaty (since 2002)
- WIPO Performances and Phonograms Treaty (since 2002)
- WTO/TRIPS (since 1995)

## IP legislation

Senegal is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states
- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to ‘renounce’ their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Senegal had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, refer to the chapter on **OAPI**.

In Senegal new legislation on copyright was enacted:

- Law no 2008-09 of 2008 on Copyright and Related Rights.

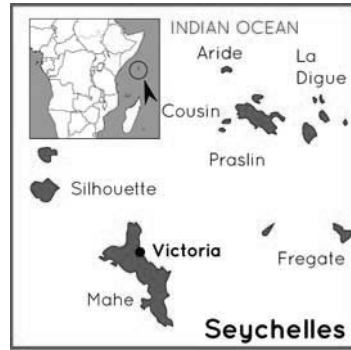
## **PLANT BREEDERS’ RIGHTS**

Provision is made for plant breeders’ rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders’ rights within OAPI, refer to the chapter on **OAPI**.

# SEYCHELLES

## GENERAL INFORMATION

Seychelles is an archipelago comprising some 112 islands in the Indian Ocean, about 1500 kilometers east of the African coast and to the north of Madagascar. The principal island is Mahé. Seychelles is an independent republic within the British Commonwealth,



<b>Area:</b>	455 km <sup>2</sup>
<b>Population:</b>	0.1 million
<b>Capital:</b>	Victoria on the Island of Mahé
<b>Currency:</b>	Seychelles Rupee
<b>GDP:</b>	\$ 1.9 billion (2010)
<b>Internet domain:</b>	.sc
<b>Languages:</b>	French, Creole, English (official languages)
<b>Working week:</b>	Monday – Friday
<b>Exports:</b>	Copra; fish; cinnamon bark; petroleum products (re-exports)
<b>Imports:</b>	Manufactured goods; food; petroleum products; tobacco; beverages; machinery and equipment

## International/regional conventions

Seychelles is a member of the following international agreements:

- Paris Convention (since 2002)
- Patent Cooperation Treaty (since 2002)
- WIPO Convention (since 2000)

## IP legislation

Trade marks

- Decree no 18 of 1977 on Trade Marks, Chapter 239 (amended by Act no 15 of 1991)
- Trade Marks Regulations of 1991

Patents

- Patents Act no 5 of 1901, Chapter 156 (amended several times, most recently by Act no 23 of 1976)

Designs

- None

Copyright

- Copyright Act of 1984, Chapter 51 (revised in 1991)
- Copyright (Registration) Regulations of 1984 (revised in 1991)

## TRADE MARKS

### Law

- Decree no 18 of 1977 on Trade Marks, Chapter 239 (amended by Act no 15 of 1991)
- Trade Marks Regulations of 1991

Seychelles is a member of the Paris Convention.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services; for certification marks and for series marks, as well as for defensive registrations of well-known marks.

### Protection of well-known marks

The Decree permits the registration of well-known marks as defensive trade marks (see the section on **Defensive marks** below).

### Advantages of trade mark registration

The registration of a trade mark gives to the proprietor the exclusive right to use the mark in respect of the relevant goods or services, or to authorise other persons to do so.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- certification marks
- series marks
- defensive registrations.

### Definition of a mark

A trade mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

### Definition of a trade mark

A trade mark is a mark which is used, or proposed to be used, in relation to goods or services for the purpose of indicating a connection in the course of trade with the proprietor or registered user of the trade mark.

### Definition of a certification trade mark

A mark adapted in relation to any goods or services to distinguish such goods or services in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristics from goods or services not so certified, is registrable as a certification mark. The proprietor of the registration shall be entitled to authorise other persons to use the mark.

**Series and parts of marks**

The Decree provides for the registration of series of marks. Where a person claims to be the proprietor of several trade marks in respect of the same goods or services, which, while resembling each other yet differ, eg as regards statement of goods or services, statements of price or quality, or colour, such person may register all these marks as a series in one registration.

Further, where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may register the whole as well as any such part as separate trade marks.

**Defensive marks**

Finally, the Decree provides for the registration of defensive marks where a trade mark consisting of an invented word or words has become so well known in respect of the goods or services for which it is registered, that the use of the mark in regard to other goods or services would be likely to be taken as an indication of a connection with such proprietor, then the proprietor will be entitled to register the mark also in regard to such other goods, as a defensive trade mark, although he has no intention of using the mark in respect of those other goods or services.

**Limitation to colour**

A trade mark may be limited in whole or in part to one or more specified colours. If a trade mark is registered without limitation of colour, it is deemed to be registered for all colours.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A separate application is required for each class.

**Convention priority**

Seychelles is a member of the Paris Convention and it is possible to claim convention priority.

**Application**

An application is filed with the Registrar General.

The following documents are required:

- full particulars of the applicant
- power of attorney (notarised)
- electronic prints of the mark in the case of device marks
- certified copy of the priority document (if applicable).

**Examination/procedure**

Applications are examined as to inherent registrability, as well as for conflict with prior applications or registrations. Upon acceptance, the application is to be advertised.



**Opposition**

Interested parties may oppose an application within two months of advertisement of the acceptance of the mark.

**Opposition proceedings**

Any person may, within two months from the date of advertisement, give notice to the Registrar of his intention to oppose the registration of the trade mark. The notice must be given in writing in a prescribed manner and must include a statement of the opponent's grounds of opposition.

The Registrar shall send a copy of the notice of opposition to the applicant and, within two months after the receipt, the applicant must send to the Registrar a counter-statement. If the applicant does not file a counter-statement, he will be deemed to have abandoned his application.

Opportunity is then provided to both parties to file supporting evidence. Failure to file supporting evidence will result in that party's proceeding being deemed abandoned.

The Registrar shall, after hearing the parties and considering the evidence, decide whether or not the trade mark application is to be registered.

**Grounds of opposition**

The registration of a trade mark may be opposed on the ground of non-compliance with any requirement for valid registration, including the following:

- that the mark does not consist of or contain a distinctive element or feature
- that the mark contains any matter, the use of which would be likely to cause deception or confusion, or which would otherwise be disentitled to protection in the courts, or be contrary to law or morality or constitute a scandalous design
- that the mark is identical to a trade mark belonging to a different proprietor, that is already on the register in respect of the same goods or description of goods, or if it so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

However, it is provided that –

- in the case of honest concurrent use, or in the case of other special circumstances, the court or the Registrar may permit the registration of trade marks that are owned by different proprietors and that are identical or nearly resemble each other, in respect of the same goods
- where separate trade mark applications are filed by different applicants and the respective marks are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of the marks until the rights of the respective applicants have been determined by the courts, or have been settled by agreement in a manner approved by the court.

**Duration and renewal**

A trade mark is valid for seven years, and thereafter renewable for periods of 14 years from the date of expiration of the original registration or of the last renewal.

Renewal requirements:

- power of attorney (notarised).

**Cancellation/removal of a trade mark**

The Decree provides for different circumstances which could be relied on in order to obtain the cancellation or removal of a trade mark from the register.

**Grounds for cancellation/removal of a trade mark**

The Court or the Registrar may remove a registered trade mark from the register in respect of any of the goods or services that are covered by the mark, if the trade mark was registered without any *bona fide* intention to use the trade mark in relation to the goods or services and there has, in fact, been no *bona fide* use up to one month before the date of the application for cancellation; or that a continuous period of five years or longer has elapsed during which there has been no *bona fide* use of the trade mark in relation to the goods or services.

The Court or the Registrar may refuse cancellation if it is shown that there has in fact been *bona fide* use of the trade mark. A trade mark registration shall also not be cancelled if any non-use has occurred due to special circumstances in the trade and if the non-use of the mark is not due to any intention on the part of the proprietor not to use or to abandon the mark.

**Cancellation on the grounds of non-use**

Use of a registered trade mark is a requirement and non-use of a registered trade mark for a period of five years or more shall render the registration vulnerable to cancellation, except where the proprietor can show that the non-use was due to special circumstances.

As indicated above, a trade mark registration shall not be cancelled if any non-use of the trade mark has occurred due to special circumstances in the trade and if the non-use of the mark is not due to any intention on the part of the proprietor not to use or to abandon the trade mark.

**Cancellation on the ground that the trade mark has become generic**

A registered trade mark may be invalidated if descriptive words are incorporated in the trade mark, except in the following cases:

- if the words that are contained in the mark are commonly used in trade
- if the goods to which the mark is applied were manufactured under a patent and a period of two years has passed from the date on which the patent lapsed and the word is necessary to describe the goods
- if the trade mark contains the descriptive word in conjunction with additional elements of the mark, the Registrar may decide that the trade

mark does not need to be declared invalid (he may order the proprietor of the trade mark to disclaim any exclusive rights in the descriptive part of the trade mark).

### **Assignment**

The registered proprietor of a trade mark may assign the trade mark. In order to be valid, the assignment must be registered.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment (notarised), with sworn English translation.

### **Registered users**

Registered users are recognised in respect of some or all of the goods or services in respect of which a trade mark is registered (except for a defensive trade mark). Use of a trade mark by a registered user is considered permitted use. Registered user agreements must be recorded.

Requirements for recordal:

- powers of attorney from proprietor and registered user (notarised)
- declaration and statement of case, with sworn English translation
- licence agreement (notarised), with sworn English translation.

### **Amendments**

The registered proprietor of a trade mark may apply to the Registrar for leave to add to or alter the trade mark in a manner not substantially affecting the identity thereof. Such amendment is at the Registrar's discretion.

### **Rights conferred by registration**

The registration of a trade mark gives to the owner the exclusive right to use the trade mark in relation to the relevant goods or services, and to authorise the use thereof by other persons. The right shall be deemed to be infringed by any person who uses a mark identical or similar to the registered mark in the course of business in relation to the relevant goods or services.

### **Trade mark infringement**

The registration of a mark in respect of any goods or services shall, if valid, grant the proprietor of the mark the exclusive right to use the trade mark in relation to those goods or services. These rights shall be deemed to be infringed by any person who, not being the proprietor of the mark or a registered user, uses a mark that is identical to the registered trade mark or so nearly resembles it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods or services in respect of which the trade mark is registered, where such use is likely to mislead the public.

**Defences to trade mark infringement**

The rights in a registered trade mark shall not be infringed by the use of a mark –

- if the proprietor of the registered trade mark, or its permitted user, has applied the trade mark to those goods and has not subsequently removed or amended the trade mark or has, at any time, consented to the use of the mark by another party
- in relation to goods that are adapted to form part of, or be an accessory to, other goods in relation to which the trade mark is used, if the use of the mark is reasonably necessary to indicate that the goods are adapted to be used in relation to the goods for which the mark is registered.

The use of a registered trade mark, which is one of two or more registered trade marks that are identical or that nearly resemble each other, shall not be deemed to be an infringement of the rights of the proprietor of the other registered trade mark.

The proprietor of the registered trade mark shall not be entitled to interfere with or restrain the use by any person of a mark that is identical with or nearly resembling the registered trade mark, in relation to goods to which that person has continuously used the trade mark from the date before –

- the use of the first mentioned trade mark
- the registration of the first mentioned trade mark.

The registration of a trade mark shall not interfere with:

- the *bona fide* use by a person of his own name or of the name of his place of business or of the name of his predecessor in business, or
- the use by any person of any *bona fide* description of the character or quality of the goods.

**Relief for trade mark infringement**

The Decrees does not specify the relief available to the proprietor of a registered trade mark in the case of infringement, except to provide that no injunction or other relief will, in certain circumstances, be available in the case of registrations effected in Part B of the register prior to the effective date of the 1991 Amendment Act.

**Common law rights**

The Decree recognises the rights of honest concurrent users and provides that the Registrar may, in that case, permit the registration of trade marks that are identical or similar in respect of the same goods or services in the name of more than one proprietor. Furthermore, the owner of a registered trade mark may not interfere with or restrain the use by any other person of an identical or similar mark, if such use pre-dates the use or registration of the registered mark.

**Marking of goods**

Marking of goods to reflect registration is optional.

## PATENTS

### Law

- Patents Act no 5 of 1901, Chapter 156 (amended several times, most recently by Act no 23 of 1976)

Seychelles is a member of the Paris Convention and the PCT.

### Patent protection

Patent protection is available via a national filing or via registration of a UK granted patent in Seychelles.

Although it is possible in a PCT international application to designate Seychelles, the laws in Seychelles have not been amended to cater for the PCT. Accordingly, it is not clear whether enforceable rights will be obtained via PCT national phase filings in Seychelles.

### Types of patents

Although there is some uncertainty, it seems that patent rights may be obtained by way of –

- patents granted on the basis of a national application
- patents granted on the basis of a national phase application under PCT
- registration of UK patents.

### Patentable subject matter

No provision.

### Types of applications

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Seychelles is designated
- an application for registration of a UK granted patent.

### Application

Non-convention and convention applications, applications for registration of a UK patent, and PCT national phase applications are filed with the office of the Registrar of Patents.

Filing requirements:

For national and PCT applications:

- full particulars of the applicant
- power of attorney (notarised)
- assignment of invention by the inventors (if applicable)
- specification (including claims, drawings and abstract), in English
- copy of the priority document (if applicable)
- copy of the International Preliminary Report on Patentability.

All documents above must be legalised by the UK consul if signed outside the United Kingdom; otherwise only notarisation is required.

For confirmation of a UK patent:

- full particulars of the applicant
- power of attorney (notarised)
- certified copy of the UK patent
- certificate of the UK Comptroller of Patents, giving full particulars of the issue of the UK patent, together with such evidence as the Registrar may require to prove that the applicant is the *bona fide* holder of the patent, and that the patent is in force.

All documents must be legalised by the UK consul if signed outside the United Kingdom; otherwise only notarisation is required.

### **Applicant**

The inventor or his successor in title may apply, whether or not they are citizens of Seychelles. An assignment document is required if the applicant is not the inventor.

### **Novelty**

The Act does not expressly deal with the requirement of novelty apart from providing that disclosure of the invention at an industrial or international exhibition, or the publication of a description of the invention at such an exhibition, will not prejudice the right of the inventor to apply for a patent, provided that the Registrar has to be notified in advance of the exhibition, and the application must be filed within six months from the date of the exhibition.

UK patents must be registered within three years of their date of issue.

### **Convention priority**

Since Seychelles is a member of the Paris Convention, priority may be claimed from an earlier application filed in a convention country, provided the application is filed in Seychelles within 12 months from the first filing date.

### **Examination/procedure**

Applications are subjected to formal examination which takes place automatically. An application with a complete specification must be accepted within 12 months from the date of the application, or within an extended time not exceeding 15 months.

On acceptance of the complete specification, the Registrar shall advertise the acceptance in the Gazette.

### **Opposition**

Application for opposition must be filed within two month from the date of advertisement of the acceptance of a complete specification. Grounds of opposition include that –

- the applicant is not entitled to the invention
- the invention has already been patented in Seychelles.

If no opposition is entered, or if the opposition is decided in favour of the grant of a patent, the patent shall be granted and sealed.

#### **Duration and maintenance**

Independent patents are granted for a term of 14 years counting from the date of the application, extendible for seven years and exceptionally for 14 years upon payment of the prescribed fees.

Provision is made for the extension of the term of a patent, by an order of court, in cases where the patentee has been inadequately remunerated by the exploitation of the patent.

Registration of UK patents in Seychelles expire with the basic UK patent and remain in force as long as the UK patent is maintained in force.

#### **Restoration**

Failure to pay the annual maintenance fees timeously will result in the lapsing of the patent. Application for restoration must be filed within three years from the date on which the patent lapsed.

#### **Revocation**

Revocation is possible by a competent judicial authority on application by an interested person, on any ground on which the patent could have been refused.

#### **Assignments and licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (notarised or legalised)
- deed of assignment or licence contract (notarised or legalised).

#### **Compulsory licences**

A compulsory licence may be granted in cases of non-working of the invention, or if the reasonable requirements of the public cannot be met. The Act also provides for the Government, during any period of emergency, to authorise third parties to exercise the patented invention, by making, using, exercising and vending the patented invention.

#### **Amendments**

Amendments can be made prior to or even after grant, but any amendment shall not go beyond the disclosure of the invention in the application as filed.

### **Effect of a patent**

The effect of a patent is to grant to the owner the exclusive right to exploit the patented invention in Seychelles, and the right to recover damages in respect of infringements of his rights.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis. Remedies could include an injunction, inspection and damages.

### **Marking**

No provision.

### **Working**

No requirement for working, but compulsory licence provisions exist.

## **DESIGNS**

A United Kingdom design extends automatically to the Seychelles.

## **COPYRIGHT**

### **Law**

- Copyright Act of 1984, Chapter 51 (revised in 1991)
- Copyright (Registration) Regulations of 1984 (revised in 1991)

Seychelles is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent and surrounding islands is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- performances of literary or musical works
- films
- sound recordings
- broadcasts.

Copyright is also provided for works of Seychelles folklore. Special provisions apply to the copyright in Seychelles folklore.

Literary works are further defined to include:

- books, novels, stories, poetic works
- plays, mime, stage directions, film scenarios, broadcasting scripts



- textbooks, treatises, histories, biographies, essays, articles
- scientific works, tables and compilations of data
- encyclopaedias, dictionaries
- letters, reports, memoranda
- lectures, addresses and sermons
- computer programs.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, collage, prints, engravings
- maps, plans, diagrams, sketches or illustrations
- works of sculpture
- three-dimensional works relating to geography, topography, or science
- photographs
- works of architecture
- works of artistic craftsmanship or applied art.

For literary, musical or artistic works to be eligible for copyright, sufficient effort has to be expended to make the work original, and the work must have been written down, recorded or otherwise reduced to material form.

#### **Requirements for subsistence of copyright**

For a work to qualify for protection, the author must be a citizen of Seychelles, or domiciled or ordinarily resident in Seychelles. Alternatively, the work must have been made or first published in Seychelles.

Copyright protection is also extended to persons who are citizens of, or domiciled or resident in, a country party to a treaty of which Seychelles is also a party, and which treaty provides for copyright protection.

There is no requirement for registration in order for copyright to subsist. However, provision is made for the registration of ownership of a copyright work, and for the registration of contracts, licences, assignments, etc relating to a work.

#### **Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The copyright in Seychelles folklore vests in the State, and the copyright in works made under the direction and control of the Government vests in the Government.

### **Duration of copyright**

In the case of literary, musical and artistic works (except photographs and performances) the copyright endures for the lifetime of the author plus 25 years.

In the case of all other works, the duration is 25 years from the date on which the work was made or was made available to the public.

### **Protection afforded by copyright**

Copyright confers on the owner the exclusive right to control the doing in Seychelles of any of the following acts:

- the reproduction of the work, including the translation or adaptation thereof
- the communication to the public of the work
- broadcasting the work.

### **Exceptions to copyright protection**

The following acts are amongst a list of acts excluded from the rights of the owner:

- the doing of any of the listed acts by way of fair dealing for purposes of scientific research, private use, criticism and review
- the use for purposes of judicial proceedings
- certain usages for teaching in educational institutions.

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. Provision is made for the registration of assignments, licences and other contracts pertaining to copyright.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, account of profits, delivery up of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith and without knowledge.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Seychelles.

# SIERRA LEONE

## GENERAL INFORMATION

The Republic of Sierra Leone is located on the Atlantic Ocean, on the west coast of Africa. It is situated between Guinea to the north and east, and Liberia to the south.



<b>Area:</b>	71 740 km <sup>2</sup>
<b>Population:</b>	5.2 million
<b>Capital:</b>	Freetown
<b>Currency:</b>	Leone
<b>GDP:</b>	\$ 4.8 billion (2010)
<b>Internet domain:</b>	.sl
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; cocoa beans; diamonds; rutile; fish
<b>Imports:</b>	Machinery; transport equipment; foodstuffs; fuel and lubricants

## International/regional conventions

Sierra Leone is a member of the following international/regional agreements:

- Harare Protocol (of ARIPO) (since 1999)
- Lusaka Agreement on ARIPO (since 1980)
- Madrid Agreement on Marks (since 1997)
- Madrid Protocol on Marks (since 1999)
- Paris Convention (since 1997)
- Patent Cooperation Treaty (since 1997)
- WIPO Convention (since 1986)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Trade Marks Act, Chapter 244 of the Laws of Sierra Leone, 1960
- Trade Marks Act no 17 of 1913 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Patents

- Patents Act, Chapter 247 of the Laws of Sierra Leone, 1960
- Patents Act no 21 of 1924 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Designs

- United Kingdom Designs (Protection) Act no 17 of 1936 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Copyright

- Copyright Act no 20 of 1965

## TRADE MARKS

### Law

- Trade Marks Act, Chapter 244 of the Laws of Sierra Leone, 1960
- Trade Marks Act no 17 of 1913 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Sierra Leone is a member of the Paris Convention, the Madrid Agreement and Protocol, and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods, for series marks and for parts of marks.

Although Sierra Leone is a member of the Paris Convention and the Madrid Agreement, it has not passed national legislation giving effect to these treaties; it is therefore not clear whether it will be possible to claim priority in terms of the Paris Convention or enforce international registrations in terms of the Madrid Agreement.

There is no specific provision for defensive marks.

### Protection of well-known marks

No express provision.

### Advantages of trade mark registration

The registration of a trade mark gives the proprietor the exclusive right to use the mark in relation to the relevant goods; to assign the mark; and to institute court proceedings in the case of the infringement of his rights.

### Types of trade marks

The following types of trade marks are registrable:

- goods marks (no provision for service marks)
- parts of marks
- series marks.

### Definition of a mark

A mark is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

### Definition of a trade mark

A trade mark is defined as a mark used, or proposed to be used, upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of the trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.

### Registration of parts of marks

If the owner of a trade mark claims to be entitled to the exclusive use of any portion or part of the mark separately, he may apply to register these parts as separate trade marks. Each separate part must comply with all

requirements for registration and shall be independent trade marks, although deemed to be associated marks.

### **Registration of series of marks**

If a person claims to be the proprietor of several trade marks for the same description of goods, which resemble each other yet differ in respect of statements of the goods to be used; statements of price or quality of the goods; other non-distinctive elements; or colour, these marks may be registered as a series of marks in one registration. All such marks shall be deemed to be associated marks.

### **Limitation of colour**

The Act provides that a trade mark may be limited, in whole in part, to one or more specified colours. In so far as a trade mark is registered without limitation as to colour, it is deemed to be registered for all colours.

### **Classification**

The pre-1938 United Kingdom classification of 50 goods classes is followed. A separate application must be filed for each class.

### **Convention priority**

Sierra Leone is a member of the Paris Convention but has not enacted national legislation to provide for priority rights. As a result it is not clear whether it is possible to claim convention priority. However, the Registry does appear to be accepting priority applications.

### **Application**

Applications are filed with the Registrar of Trade Marks.

The following information and documents are required

- full particulars of the applicant
- power of attorney (simply signed)
- list of goods to be covered
- electronic prints of the mark, for each class
- certified copy of a UK Registration (if the application is filed for cotton goods).

Although Sierra Leone is a member of ARIPO, it has not yet acceded to the Banjul Protocol. Therefore, a trade mark registration cannot be obtained via an ARIPO registration.

### **Examination/procedure**

Applications are examined as to formal requirements and whether they are in conflict with prior applications and registrations.

### **Opposition**

Interested third parties may oppose the application within three months from date of publication. The extension of the opposition period is possible at the discretion of the Registrar, for a maximum of six months.

**Opposition proceedings**

The opposition procedure is dealt with in the Sierra Leone Trade Marks Act, which provides that a notice of opposition must include a statement of the grounds of opposition. The Registrar must send a copy of such notice to the applicant and, within one month after receipt, or such further time (not exceeding three months) as the Registrar may allow, the applicant must send to the Registrar a counter-statement of the grounds on which he relies for his application. If the applicant fails to file a counter-statement, he shall be deemed to have abandoned his application.

The Registrar must furnish a copy of the counter-statement to the opponent, and shall require him to give security for costs; if such security is not given within 14 days, or such further time as the Registrar may allow, the opposition shall be deemed to be withdrawn. If the opponent gives such security, the Registrar must inform the applicant. The case is then be ready for determination by the court.

**Grounds of opposition**

The Act states that a registrable trade mark must contain or consist of at least one of the following essential particulars:

- the name of a company, individual, or firm represented in a particular manner
- the signature of the applicant for registration or some predecessor in his business
- an invented word or invented words
- a word or words having no direct reference to the character or quality of the goods, and not being a geographical name or a surname
- any other distinctive mark.

The term 'distinctive' in this context means adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. In determining whether a trade mark is so adapted, the Court may take into consideration the extent to which use has rendered such trade mark in fact distinctive; provided always that any mark which has been registered as a distinctive mark in England under the Trade Marks Act, 1905 or the Trade Marks Act, 1938, or any Act amending or substituted for the last mentioned Act, shall be deemed to be a distinctive mark.

The Act further provides that:

- it shall not be lawful to register as a trade mark any matter, the use of which would, by reason of it being calculated to deceive, be disentitled to protection in a court, or would be contrary to law or morality, or any scandalous design
- a trade mark shall not be registered for any goods set forth in certain specified classes unless such trade mark is registered in the UK in respect of such goods
- a trade mark shall not be registered (except by order of a court) in respect of any goods, if it is identical with another mark already registered for the same goods, or so nearly resembles the registered mark as to be calculated to deceive.

**Duration and renewal**

A trade mark registration is valid for an initial period of 14 years from the date of filing, and is renewable for like periods of 14 years each, upon payment of the applicable renewal fees.

**Cancellation/removal of a trade mark**

A registered trade mark is vulnerable to cancellation/removal on different grounds.

**Grounds for cancellation/removal of a trade mark**

A registered trade mark may be expunged or cancelled if it is an entry wrongly made in, or wrongly remaining on, the register.

The Act provides that:

- the court may, on the application of any person aggrieved by the omission of the name of any person or of any other particulars from the register kept under the Act, or by any entry made without sufficient cause in the register, or by any entry wrongfully remaining on the register, make such order for making, expunging, or varying the entry, as the court thinks fit
- the Court may, in any proceedings under this provision, decide any question that it may be necessary or expedient to decide for the rectification of the register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved
- notice of any intended application to the court under this provision shall be given to the Registrar by the applicant, and the Registrar shall be entitled to be heard on the application
- in the case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the court under the provisions of this section
- if any order of the court rectifying the register is made, the Registrar shall, on proof thereof, and on payment of the prescribed fee, cause the register to be altered in conformity with such order.

A registered trade mark may also be cancelled and removed from the register for lack of use, or if the trade mark was registered without any *bona fide* intention to use the mark.

The Act thus provides that a registered trade mark may, on an application to court by any person aggrieved, be taken off the register in respect of any of the goods for which it is registered –

- on the ground that it was registered by the proprietor without any *bona fide* intention to use the mark in connection with such goods and there has, in fact, been no *bona fide* use of the mark
- on the ground that there has been no *bona fide* use of the trade mark in connection with the goods during the five years immediately preceding the application.

The mark will not be removed if, in either case, such non-use is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon the trade mark.

### **The seven year incontestability rule**

The so-called seven-year rule applies in regard to the validity of a trade mark registration. The Act provides that, in all legal proceedings relating to a registered trade mark, the original registration of a trade mark shall, after the expiration of seven years from the date of original registration, be taken to be valid in all respects, unless the original registration was obtained by fraud, or unless the trade mark offends against the provisions of the Act.

### **Use requirement and cancellation**

The use of a registered trade mark is required inasmuch as the Act provides for the cancellation of the registration in the case of non-use (see the section on **Grounds for cancellation/removal of a trade mark** above.)

### **Assignment**

Assignments of registered marks are possible and must be made with the goodwill of the business. The assignment must be recorded at the Registry.

Requirements for recordal:

- a power of attorney by the assignee (simply signed)
- deed of assignment, signed by both parties.

### **Licensing/registered users**

There are no specific licensing provisions. However, if registrations are based on existing UK rights which have registered user appointments, such a recording can also be extended to Sierra Leone.

Requirements for recordal:

- a power of attorney by proprietor and licensee (simply signed)
- proof of recordal of registered user against the basic UK registration.

### **Amendment**

The owner of a registered mark may request the Registrar to add or alter a trade mark in any manner which does not substantially affect its identity. The amendment will be advertised for opposition purposes.

Requirements for amendment:

- power of attorney (simply signed)
- supporting document (if any, eg certified certificate of the change of name and/or address).

### **Rights conferred by registration**

The registration of a trade mark gives to the registered proprietor the exclusive right to the use of the trade mark in relation to the relevant goods. The proprietor shall also have the power to assign the trade mark.



Further, the proprietor has the right to institute judicial proceedings against persons who infringe his rights.

The so-called seven-year rule is also relevant in the context of the enforcement of a proprietor's trade mark rights.

### **Trade mark infringement**

The Act provides that the registration of a person as the proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of the trade mark upon, or in connection with, the goods in respect of which it is registered. The proprietor also has the right to institute court proceedings against other persons who infringe his rights by using the registered mark without his authority.

The Act further states that no person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade mark, unless that trade mark has been in use for not less than three years prior to the commencement of the proceedings, and has been refused registration under the Act.

### **Defences to trade mark infringement**

The Act provides that no registration of a trade mark shall interfere with any *bona fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods.

The Act further provides that nothing in the Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the use by any person of a similar trade mark upon or in connection with goods where such person has, by himself or his predecessors in business, continuously used the trade mark from a date prior to the use of the registered trade mark by the proprietor thereof.

### **Relief for trade mark infringement**

A successful litigant in trade mark infringement proceedings would be entitled to an interdict (an injunction) ordering the infringer to refrain from further unauthorised use, and to damages.

### **Common law rights**

Rights in a mark acquired through use, and without registration of the mark, are protected. As indicated above (see the section on **Defences to trade mark infringement** above), the owner of a registered trade mark is not entitled to interfere with the use by another person of a similar trade mark on similar goods, where such other person commenced such use prior to the use of the registered mark, or to object to such person being put upon the register for such similar trade mark in respect of such goods (honest concurrent user application).

**Marking of goods**

It is not compulsory to use the ® symbol to indicate that the mark has been registered. However, it is a criminal offence to indicate that an unregistered mark has been registered.

**PATENTS****Law**

- Patents Act, Chapter 247 of the Laws of Sierra Leone, 1960
- Patents Act no 21 of 1924 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Sierra Leone is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

**Patent protection**

Patent protection is available by way of the confirmation of a granted UK or EP/UK patent, or via an ARIPO application designating Sierra Leone.

Sierra Leone has not implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law. Accordingly, it is not clear whether patents granted by the ARIPO Patent Office will be enforceable in Sierra Leone.

Although the Registrar is currently accepting PCT national phase applications, the national laws of Sierra Leone have not been amended to provide for the PCT. Accordingly, the Registrar is not processing the applications to grant, as the draft Bill which incorporates the filing of PCT applications has not yet passed into law.

**Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable:

- discoveries
- scientific theories or mathematical methods
- literary, dramatic, musical or artistic works or other aesthetic creations
- schemes, rules or methods for doing business, performing a mental act or playing a game
- programs for computers
- methods for the treatment of the human or animal body by surgery
- diagnostic methods practised on the human or animal body.

Although methods for the treatment of the human or animal body and diagnostic methods are not patentable subject matter, the exclusion does not extend to products for use in those methods.

## Types of applications

Application for a patent may be made by way of –

- a national phase application based on an international application under the PCT in which Sierra Leone is designated
- an ARIPO application designating Sierra Leone
- confirmation of a granted UK or EP/UK patent.

## Application

Confirmation and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Sierra Leone Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**. Foreign applicants must have a local address for service.

Filing requirements for confirmation of a UK patent:

- power of attorney (simply signed)
- certified copy of the UK Letters Patent, including specification and drawings
- certificate from the UK Patent Office giving full particulars of the UK patent.

Filing requirements for a PCT national phase:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of invention (if applicable)
- copy of the specification (including claims, drawings and abstract), in English
- copies of the PCT request, International Search Report, specification, claims and drawings filed in the international application, and the International Preliminary Examination Report, where relevant.

## Applicant

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

## Novelty

No provision. However, an application for confirmation of a UK patent must be made within three years from the date of issue of the UK patent.

## Convention priority

No provision.

## Examination/procedure

Applications are subjected to formal examination, which takes place automatically.

## Opposition

No provision.

## Publication

No provision.

### **Duration and maintenance**

A patent obtained as confirmation of a UK patent remains in force for the period for which the UK patent remains in force, subject to the payment of renewal fees in the United Kingdom.

### **Restoration**

No provision.

### **Revocation**

A patent may be revoked on the same grounds as under UK law.

### **Assignments**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

No provision.

### **Amendments**

Whenever the specification or drawings of a United Kingdom patent, registered in Sierra Leone, have been amended according to UK law, a request accompanied by a copy of the specification as amended, duly certified by the Comptroller General of the UK Patent Office, may be made to the Registrar General to substitute a copy of the amended specification for the specification originally filed.

### **Effect of a patent**

The owner of a patent registered in Sierra Leone has the exclusive right to exploit, or to authorise the exploitation of, the patented subject matter in Sierra Leone, and to institute court action against persons who infringe his rights.

### **Infringement**

Infringement proceedings may be brought before the Supreme Court.

### **Working**

No provision.

## DESIGNS

### Law

- United Kingdom Designs (Protection) Act no 17 of 1936 (as amended by the Laws (Adaptation) Act no 29 of 1972)

Sierra Leone is a member of the Paris Convention, the ARIPO (Harare Protocol), and the WTO/TRIPS.

### Design protection

A United Kingdom design extends automatically to Sierra Leone.

Registered design protection in Sierra Leone is also obtainable via ARIPO. Since Sierra Leone has not implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, it is not clear whether ARIPO design registrations would be enforceable in Sierra Leone.

There is no national route for obtaining registered design protection in Sierra Leone.

## COPYRIGHT

### Law

- Copyright Act no 20 of 1965

Sierra Leone is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. In the case of Sierra Leone, although a Copyright Act was enacted in 1965, it was not possible, at the time of writing, to obtain a copy of the Sierra Leone Copyright Act. As indicated above, Sierra Leone has not yet acceded to the Berne Convention. Accordingly, no commentary on copyright could be given at the time of writing.

## PLANT BREEDERS' RIGHTS

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Sierra Leone.

# SOMALIA

## GENERAL INFORMATION

The Somali Democratic Republic (also known as Somalia) lies on the east coast of Africa, in the Horn of Africa. It is bordered by Ethiopia to the west, Djibouti to the north-west, and Kenya to the south. Somalia has a long coast line on the Indian Ocean, extending to the Gulf of Aden to the north.



<b>Area:</b>	637 657 km <sup>2</sup>
<b>Population:</b>	10.1 million
<b>Capital:</b>	Mogadishu
<b>Currency:</b>	Somali Shilling
<b>GDP:</b>	\$ 5.9 billion (2010)
<b>Internet domain:</b>	.so
<b>Languages:</b>	Somali, Arabic (official languages)
<b>Working week:</b>	Tuesday - Saturday
<b>Exports:</b>	Livestock; bananas; hides; fish; charcoal; scrap material
<b>Imports:</b>	Foodstuffs; manufactures; petroleum products; construction materials

## International/regional conventions

Somalia is a member of the following international/regional agreements:

- Lusaka Agreement (ARIPO) (since 1981)
- WIPO Convention (since 1982)

## IP legislation

- Trade Marks and Patents Law no 33 of 1975 (introduced Italian Laws on Patents, Industrial Designs and Trade Marks)

Trade marks

- Ordinance no 3 of 1955 on Trade Marks (amended by Presidential Decree of 1975)

Patents

- Ordinance no 1 of 1955 on Patents (amended by Presidential Decree of 1975)

Designs

- Ordinance no 2 of 1955 on Industrial Designs (amended by Presidential Decree of 1975)

Copyright

- UK Copyright Act, 1911
- Copyright Law no 66 of 1977

## TRADE MARKS

### Law

- Ordinance no 3 of 1955 on Trade Marks (amended by Presidential Decree of 1975)

Somalia is not a member of the Paris Convention. Even though Somalia is a member of the Lusaka Agreement (on ARIPO) and has apparently acceded to but not ratified the Banjul Protocol of ARIPO, no implementing legislation has been passed.

**Note:** Prior to 1991, the 1955 Ordinance applied in Somalia. Following the overthrow of the government in 1991, Somalia has been without a stable central government and it has become virtually impossible to file new trade mark or patent applications in Somalia, or to maintain existing applications/registrations in Somalia.

Even at the time of writing, it has been difficult to obtain reliable and up-to-date information. The commentary given below is based on the information available at the time of writing.

### Classification

Somalia follows the old Italian classification of 49 classes. A single application may cover more than one class.

### Convention priority

Priority cannot be claimed; Somalia is not a member of the Paris Convention.

### Application

In theory, a national trade mark application can be filed.

The following information and documents are required:

- power of attorney, simply signed
- prints of the trade mark for device marks.

### Examination/procedure

Examination as to formal requirements only.

### Opposition

No provision is made for opposition. There are, however, specific grounds on which a registration may be cancelled (see the section on **Cancellation/removal of a trade mark** below)

### Duration and renewal

A registration is effective for a period of 20 years and, thereafter, renewable for like periods.

### **Cancellation/removal of a trade mark**

Trade mark registrations may be cancelled on the grounds set out below.

#### **Grounds for cancellation/removal of a trade mark**

In addition to cancellation on the ground of non-use (see below), a registration may be cancelled if it is confusingly similar to an earlier registration or to a prior well-known (notorious) mark of another person. After five years, a registration is incontestable to objections based on prior notorious marks.

#### **Use requirement**

If a trade mark has not been used for a period of three years, it will be vulnerable to forfeiture and cancellation.

#### **Assignment**

Trade marks can be assigned and have to be assigned together with the goodwill of the business. Recording of an assignment can be effected.

Requirements for recordal:

- power of attorney from assignee (simply signed)
- deed of assignment.

#### **Licensing/registered users**

Licensing is recognised and the licence agreement is to be recorded to be legally effective against third parties.

Requirements for recordal:

- power of attorney for licensor (simply signed)
- power of attorney from licensee (simply signed)
- licence agreement.

#### **Amendment**

No provision.

#### **Trade mark infringement**

No provision.

#### **Relief for trade mark infringement**

No remedies specified.

#### **Marking of goods**

Notice of registration by use of the legend 'Marca Depositata' is optional. Marking of goods must be clear and in a language understood by the people. English is acceptable. Fines are imposed for falsifying the origin of goods.



## PATENTS

### Law

- Ordinance no 1 of 1955 on Patents (amended by Presidential Decree of 1975)

Somalia is not a member of the Paris Convention.

Somalia is a member of ARIPO, as it is a party to the Lusaka Agreement on the creation of the African Regional Intellectual Property Organisation (ARIPO). However, Somalia has not yet acceded to the Harare Protocol which regulates the filing of patents and designs in ARIPO. Accordingly, Somalia cannot be designated in an ARIPO patent or design application.

**Note:** Somalia is in a state of civil disruption at present. The current information is that the Intellectual Property Office is not functioning at the present time, due to the prevailing political situation, so that national patent filings are not possible. Accordingly, no current information is available regarding the protection of patents and designs in Somalia.

## DESIGNS

### Law

- Ordinance no 2 of 1955 on Industrial Designs (amended by Presidential Decree of 1975)

**Note:** Please see the remarks above in regard to the current position on patent and designs.

## COPYRIGHT

### Law

- UK Copyright Act, 1911
- Copyright Law no 66 of 1977

Somalia is not a member of the Berne Convention.

**Note:** It has not been possible to obtain information on the current position in regard to the protection of copyright.

## PLANT BREEDERS' RIGHTS

### Law

- No legislation in force.

**Note:** It has not been possible to obtain information in regard to the protection of plants, such as plant breeders' rights.

# SOUTH AFRICA

## GENERAL INFORMATION

The Republic of South Africa ceased to be a member of the British Commonwealth of Nations and became an independent republic in 1961. After 1994 it rejoined the Commonwealth. South Africa lies at the extreme southern tip of the African continent, bordered to the north by Namibia, Botswana and Zimbabwe, and on the northeast by Mozambique. Swaziland and Lesotho are also neighboring countries.



<b>Area:</b>	1 219 090 km <sup>2</sup>
<b>Population:</b>	50 million
<b>Capital:</b>	Pretoria (administrative) Cape Town (legislative)
<b>Currency:</b>	Rand = 100 cents
<b>GDP:</b>	\$ 527.5 billion (2010)
<b>Internet domain:</b>	.za
<b>Languages:</b>	11 official languages: English, Afrikaans, Ndebele, North Sotho, Sesotho, Swazi, Tswana, Tsonga, Venda, Xhosa, Zulu
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Gold; other minerals and metals; foods; chemicals; manufactured goods
<b>Imports:</b>	Machinery; transport equipment; chemicals; textiles; scientific instruments; petroleum products

## International/regional conventions

South Africa is a member of the following international agreements:

- Berne Convention (since 1928)
- Budapest Treaty (since 1997)
- Paris Convention (since 1947)
- Patent Cooperation Treaty (since 1999)
- UPOV Convention for New Varieties of Plants (since 1977)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1995)

Signatory (but no accession yet) to: Trade Mark Law Treaty, WCT, WPPT

## IP legislation

Trade marks

- Trade Marks Act no 194 of 1993
- Trade Mark Regulations, 1995
- Merchandise Marks Act no 17 of 1941

Patents

- Patents Act no 57 of 1978
- Patent Regulations, 1978

## Designs

- Designs Act no 195 of 1993
- Design Regulations, 1999

## Copyright

- Copyright Act no 98 of 1978
- Copyright Regulations, 1978
- Registration of Copyright in Cinematograph Films Act no 62 of 1977
- Registration of Copyright in Cinematograph Films Regulations, 1980

## Related areas

- Counterfeit Goods Act no 37 of 1997
- Performers' Protection Act no 11 of 1967
- Plant Breeders' Rights Act no 15 of 1976
- Plant Breeders' Rights Regulations, 1977

## TRADE MARKS

### Law

- Trade Marks Act no 194 of 1993
- Trade Mark Regulations, 1995
- Merchandise Marks Act no 17 of 1941

South Africa is a member of the Paris Convention and the WTO/TRIPS. South Africa is expected to accede to the Madrid Protocol within the near future.

### Trade mark protection

The Act provides for the registration of trade marks in respect of goods and services. It is important to note that registration of a trade mark does not necessarily confer an absolute right to use the mark. Prior rights, recognised by law, to a mark may have been secured in ways other than by registration, eg by use (see the section on **Common law rights** below).

The protection afforded by a trade mark registration extends to the use of an identical mark or a mark so nearly resembling it as to be likely to deceive or cause confusion, in relation to identical goods or services, or goods or services which are so similar that a likelihood of deception or confusion exists (see the section on **Trade mark infringement** below).

### Protection of well-known marks

Well-known marks, in terms of Art 6 *bis* of the Paris Convention, are protected.

Where the well-known mark is a registered trade mark in South Africa, the Act provides protection that extends to **any** goods or services, if the use of an identical or similar mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the well-known mark, notwithstanding the absence of confusion or deception.

The Act also provides protection to the owner of a foreign well-known mark, even if such mark has not been registered in South Africa. The owner

of the well-known mark must be a national of or domiciled in a convention country, or must have a commercial presence in a convention country. Such owner has the right to restrain the use in South Africa of a mark which constitutes a reproduction, imitation or translation of the well-known mark in relation to identical or similar goods or services where the use is likely to cause deception or confusion.

### **Advantages of trade mark registration**

While common law rights may be acquired through use of a trade mark (see the section on **Common law rights** below), the advantages of registration are substantial, eg –

- enforcement of rights in terms of the Act
- an easy and clear remedy for infringement
- a deterrent to potential infringers
- the possibility of licensing
- the right to use the legend 'Registered Trade Mark'
- a *prima facie* right to use the trade mark.

### **Types of trade marks**

The Act provides for the registration of the following marks:

- trade marks for goods
- trade marks for services
- certification trade marks
- collective trade marks.

### **Definition of a mark**

A mark is defined to mean any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods, or any combination of the aforementioned.

### **Definition of a trade mark**

A trade mark (other than a certification or a collective trade mark) means a mark used or proposed to be used by a person in relation to goods and services for the purpose of distinguishing the goods or services from the same kind of goods or services connected in the course of trade with any other person.

### **Definition of a certification trade mark**

A certification mark is a mark capable of distinguishing, in the course of trade, goods or services certified by any person in respect of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services, from goods or services not so certified.

A mark may not be registered as a certification trade mark in the name of a person who carries on a trade in the goods or services for which registration is sought.

**Definition of a collective trade mark**

A collective mark is a mark capable of distinguishing, in the course of trade, goods or services of persons who are members of any association from goods or services of persons who are not members thereof. The mark must be registered in the name of such association as the proprietor thereof.

**Limitation to colour**

A trade mark may be limited, in whole or in part, to a particular colour or colours. If a trade mark is registered without limitation to colour, it is deemed to be registered for all colours.

**Classification**

The International Classification of Goods and Services under the Nice Agreement (9<sup>th</sup> edition) currently applies, although South Africa has not acceded to the Nice Agreement. A separate application is required for each class.

**Convention priority**

Any person who has applied for registration of a trade mark in a convention country (at present Paris Convention countries) is entitled, in priority to later applicants, to registration of that trade mark, and the South African registration shall have the same date as the date of first application in a convention country. The application in South Africa must be filed within six months after the date of first application in a convention country.

**Application**

Requirements for application:

- full particulars of the applicant
- power of attorney by the applicant (simply signed)
- prints of the mark (black and white, unless the mark has colour limitations, then in the relevant colours)
- list of goods and/or services on which the mark will be used
- classes in which the application is to be filed
- certified copy of the priority document (if priority is to be claimed).

**Examination/procedure**

An application is first examined as to formal requirements. Thereafter the application is examined to determine inherent registrability and/or conflict with prior applications and/or registrations. The grounds for refusal of registration correspond broadly with the grounds of opposition (see the section on **Grounds of opposition** below).

If the application is found to be acceptable, the acceptance must be advertised in the Patent Journal.

**Opposition**

Any interested person may, within three months following the advertisement of the trade mark application in the Patent Journal, lodge an opposition to the registration of the trade mark.

Extension of the opposition period is available for an initial period of three months by way of a request to the Registrar. Further extensions can only be obtained with the consent of the applicant, or on the basis of good cause shown on application to the Registrar.

### **Opposition proceedings**

Opposition proceedings are prescribed by Regulation. A notice of opposition is lodged, accompanied by a founding affidavit containing the evidence on which the opposition is based. The applicant for registration has one month to notify the opponent whether or not he intends to defend the opposition. Within two months of such notification, the applicant must deliver an answering affidavit with supporting evidence. The opponent has one month to deliver a replying affidavit.

Extensions of deadlines for both parties may be requested and agreed to between the parties or, on the basis of good cause shown, on application to the Registrar be granted by the Registrar.

The matter is thereafter set down for hearing by the Registrar, who has powers equivalent to those of a judge of the High Court.

### **Grounds of opposition**

Both absolute and relative grounds of opposition are available; some of the many grounds listed in the Act are set out below:

- that the mark does not constitute a trade mark, or is not capable of distinguishing the goods or services
- that the mark consists exclusively of a sign which may serve in trade to designate kind, quality, intended purpose, value, geographical origin, etc
- that the mark is inherently deceptive, or the use of the mark is likely to deceive or cause confusion, or will be *contra bonos mores*
- that the mark is identical to the registered trade mark of another party, or identical to the mark which is the subject of an earlier application by another party, or so similar that use thereof on the intended goods or services would be likely to deceive or cause confusion
- that the mark is identical or similar to a trade mark already registered and which is well known in South Africa, if the use of the mark is likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the well-known registered mark
- that the mark is one to which the applicant has no *bona fide* claim to proprietorship, or no *bona fide* intention of using as a trade mark
- that the mark consists of a sign or an indication which has become customary in the current language or the established practices of the trade
- that the mark consists of the national flag or armorial bearings of the Republic or another state or an international organisation
- that the mark was filed in bad faith.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years and, thereafter, is renewable for similar periods in perpetuity. Provision is made in the Regulations for late payment of the renewal fee (upon payment of a fine) and for the restoration of a lapsed trade mark in cases where the Registrar is satisfied that it is just to do so.

### **Cancellation/removal of a trade mark**

Any interested person may apply in the prescribed manner to the Registrar or to the court for the desired relief for –

- the non-insertion in or omission from the register of any entry
- an entry wrongly made in or wrongly remaining on the register
- any error or defect in any entry in the register.

Proceedings for the cancellation/removal of a trade mark are brought on notice of rectification supported by an affidavit setting out the facts on which the applicant relies. It is possible to institute rectification proceedings either before the Registrar or in the High Court. Proceedings before the Registrar are essentially the same as application proceedings in the High Court.

### **Grounds for cancellation/removal of a trade mark**

A trade mark registration may be cancelled and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds of opposition** above), in addition to the following –

- that the trade mark was registered without any *bona fide* intention of the applicant that it would be used, and that there in fact has been no *bona fide* use up to the date three months prior to the application
- that up to three months before the application for cancellation, there has been no use of the trade mark for a continuous period of five years or more from the date of issue of the registration certificate.

### **Use requirement and cancellation**

Use of the trade mark **prior to** the application is not required; only the *bona fide* intention to use the trade mark. Registration may be cancelled if the trade mark was registered without any *bona fide* intention to use the mark and there has, in fact, been no use of the mark (see the section on **Cancellation/ removal of a trade mark** above).

Failure to use the trade mark for a continuous period of five years **after** date of issuance of the registration certificate will render the registration vulnerable to removal from the register (see the section on **Cancellation/removal of a trade mark** above).

### **Assignment**

Assignment of a registered trade mark may take place with or without the goodwill of the business, and must be recorded in the register by the assignee.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment or other instrument of transfer of title, signed by the assignor.

### **Licensing/registered users**

Licensing and registered users of trade marks are recognised and may be recorded in the register.

Requirements for recordal:

- power of attorney from proprietor (simply signed)
- power of attorney from licensee (simply signed)
- certified copy of the licence agreement.

### **Amendments**

The Trade Marks Act has several provisions providing for the amendment and/or correction of a trade mark application or registration, and for the amendment and/or correction of the trade marks register.

A pending trade mark application may be amended, by application to the Registrar or the High Court, to correct any error in the application, including changes to the representation of the mark and changes to the specification of goods and services.

A registered trade mark may be amended by application to the Registrar to add to or alter the trade mark in any manner not substantially affecting the identity of such trade mark. The application for amendment is advertised in the Patent Journal, and third parties may oppose the amendment. The degree of change or alteration which will be allowed is for the court to decide.

Amendment of the register may be made on application to the Registrar for correcting an error in, or altering, the name or address of the registered proprietor; cancelling the registration; deleting any goods or services; or entering a disclaimer relating to the trade mark.

In the case of amendments or alterations likely to invoke adversarial reaction, application may be made to the High Court.

### **Rights conferred by registration**

Although the registration of a trade mark does not confer an absolute right to use the mark, registration is necessary to give the owner the right to institute infringement proceedings under the Act.

Furthermore, although registration of a trade mark does not ensure that no one else will be entitled to use an identical or confusingly similar mark, registration of the mark gives the owner the right to authorise or license the use of the mark, and will place the onus on the alleged infringing party to justify the use of an identical or confusingly similar mark.



### Trade mark infringement

Proceedings for infringement can be brought by way of application, on notice of motion, when there is no dispute of fact (motion proceedings); or by way of action, by the issuing of a summons, when there is an anticipated dispute of fact (trial proceedings).

The Act provides for infringement in four circumstances:

- the unauthorised use in the course of trade in relation to the **same goods or services** in respect of which the mark is registered, of an identical mark or a mark so nearly resembling the registered mark as to be likely to deceive or cause confusion
- the unauthorised use in the course of trade of a mark which is identical or similar to the registered trade mark, in relation to **goods or services which are so similar** to the goods or services in respect of which the mark is registered, that such use has a likelihood of deception or confusion
- the unauthorised use in the course of trade in relation to **any goods or services** of a mark which is identical or similar to the registered trade mark, if the registered trade mark is well known in South Africa and the use of such mark is likely to take unfair advantage of, or be detrimental to, the distinctive character or repute of the well-known registered trade mark, notwithstanding the absence of confusion or deception  
[This type of infringement recognises the concept of ‘dilution’, which is the gradual erosion or diminution of the distinctiveness, commercial magnetism or selling power of a trade mark.]
- the unauthorised use of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of a trade mark which is entitled to protection under the Paris Convention as a well-known mark (even though not registered in South Africa), if such use is in relation to goods or services which are identical or similar or the goods or services in respect of which the mark is well known, and the use is likely to cause deception or confusion.

### Defences to trade mark infringement

A registered trade mark is not infringed by the following acts:

- the *bona fide* use by a person of his own or his predecessor’s name or place of business, provided that such use is consistent with fair practice; this defence does not apply in respect of the name of a juristic person which was registered after the date of registration of the trade mark
- the use by any person of any *bona fide* description or indication of the kind, quality, quantity, purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or rendering of the services, provided such use is consistent with fair practice
- the *bona fide* use of a trade mark in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts and accessories or the rendering of services, provided that the use is consistent with fair practice

- the importation into or distribution, sale or offering for sale in South Africa of goods to which the trade mark has been applied by or with the consent of the proprietor thereof
- the *bona fide* use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern which is the subject of a trade mark registration
- the use of a trade mark where such use is within the scope of a limitation entered in the register against the registered trade mark
- the use of any identical or confusingly similar trade mark which is registered.

### **Relief for trade mark infringement**

A successful plaintiff is usually entitled to the following relief:

- an interdict (injunction) ordering the defendant to refrain from infringement
- an order for the removal of the infringing trade mark from all material and, where the infringing mark is inseparable or incapable of being removed, an order that all such material be delivered up to the proprietor for destruction
- damages, only to be claimed in proceedings brought by way of action
- in lieu of damages, a reasonable royalty, which similarly may only be claimed in proceedings brought by way of action.

A reasonable royalty is a royalty which would have been payable by a licensee for the use of the trade mark, including any use which took place after advertisement or acceptance of an application for registration. In terms of the Act, an enquiry into the amount of any damages or reasonable royalty to be awarded may be ordered, and the court may prescribe the procedures for conducting such enquiry.

### **Common law rights**

It is also possible to acquire common law rights in respect of a trade mark, eg through extended use of a mark. A proprietary right may in this way be acquired in respect of the goodwill associated with the mark or get-up, inasmuch as the mark or get-up will be associated in the minds of the public with the goods or services of that person. Enforcement of such common law rights takes place by way of common law proceedings for passing-off and/or unlawful competition.

The Act gives recognition to the rights acquired through continuous *bona fide* use of a trade mark, by providing that the proprietor of a registered trade mark will not be entitled to interfere with or restrain such use, if such use commenced from a date anterior to the date of the registered trade mark.

### **Marking of goods**

Notice of registration to third parties by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg 'Regd. TM.')

Falsely representing that a mark is registered is a criminal offence.

## PATENTS

### Law

- Patents Act no 57 of 1978
- Patent Regulations, 1978

South Africa is a member of the Paris Convention, the Budapest Treaty, the PCT and the WTO/TRIPS.

### Patent protection

Patent protection is obtainable by way of a national filing, or via a PCT filing. A national filing can be in the form of a provisional application or a complete application, and the complete application can be a non-convention or a convention application (see the section on **Types of applications** below).

A patent confers on the patentee for the duration of the patent (ie as long as it is maintained in force by the payment of renewal fees), the right to exclude all other persons in South Africa from making, using, exercising, disposing of or offering to dispose of, or importing the patented invention, so that the patentee shall have and enjoy the whole profit and advantage accruing by reason of the invention.

The sale in South Africa of a patented article by or on behalf of the patentee gives the purchaser the right to use and dispose of that article.

### Types of patents

The Act provides for conventional patents, ie where a patent is granted for any new invention which involves an inventive step and is capable of being applied in trade or industry or agriculture.

The Act also provides for patents of addition, ie where the holder of a main patent applies for a further patent in respect of any addition to, or improvement in, or modification of the main invention. The period of a patent of addition expires with that of the main patent.

The Act further provides for divisional patents, ie where the applicant for a patent lodges a fresh application in respect of part of the matter disclosed in the first application; the fresh application is ante-dated to the date of the first application. A patent granted on the fresh application may not be invalidated on the grounds of lack of novelty having regard to matter disclosed in the first application.

### Patentable subject matter

Any new invention, which involves an inventive step and which is capable of being used or applied in trade or industry or agriculture, is patentable.

The following are not patentable:

- inventions contrary to law or morality
- discoveries, scientific theories, mathematical methods
- literary, dramatic, musical or artistic work or any other aesthetic creation
- a scheme, rule, or method for performing a mental act, playing a game or doing business
- a program for a computer
- the presentation of information
- varieties of plants or animals or essentially biological processes for producing them, which are not microbiological in nature
- therapeutic or surgical methods of treating humans or animals, or diagnostic methods practised on either
- anything obviously contrary to well-established natural laws
- any invention the use of which would encourage illegal or immoral behaviour.

### **Types of applications**

Application for a patent may be made by way of –

- a provisional application (with a provisional specification), where the effective date is the date of filing
- a complete application pursuant to a provisional application (with a complete specification), claiming priority of the provisional filing date
- a non-convention complete application in the first instance (with a complete specification), where the effective date is the date of filing
- a convention application (with a complete specification), claiming priority of the first-filed application in a Paris Convention country
- a national phase application based on an international application in terms of PCT (with a complete specification), where the effective date will be the effective date of the PCT international application
- an application for a patent of addition, where the patent will expire with the main patent
- an application for a divisional patent, where the effective date will be the effective date of the original application.

### **Application**

Requirements for filing a national application:

- prescribed declaration and power of attorney by the applicant (simply signed)
- assignment of invention by the inventor (simply signed), where the applicant is not the inventor
- specification, with drawings (if required) and with claims (in the case of a complete specification), in English or an official language of South Africa
- abstract, for publication purposes, providing a concise technical description of the invention
- certified copy of the basic application in the convention country (if convention priority is to be claimed)
- verified English translation of the basic application (if not in English)

- assignment of priority rights (if the applicant is not the same as in the basic application; simply signed)
- prescribed disclosure and statement (simply signed).

**Note:** The purpose of the prescribed disclosure and statement is to determine whether the invention is based on, or derived from, an indigenous biological resource, or traditional knowledge or use of such resource. Proof may be required of the applicant's title to use the indigenous biological resource or the traditional knowledge or use.

In the case of urgency, a filing date can be obtained by filing a so-called informal application. This requires in the case of an application claiming priority –

- the name and address of the applicant
- the title of the basic application(s) in the convention country
- the country, number(s) and date(s) of the basic application(s).

Requirements for a national phase application under PCT (in addition to the requirements for a national filing):

- translation of the international application in English (if the international application is not in English; to be filed within six months)
- assignment (simply signed) (if the applicant in the national phase is not the same as in the international application or the priority application; not required in certain circumstances).

### **Applicant**

An application for a patent may be made by the inventor or by any other person acquiring from the inventor the right to apply. Two or more co-applicants may apply, or a company or other entity with legal personality.

### **Novelty**

Absolute novelty is required. An invention is deemed to be new if it does not form part of the state of the art immediately before the priority date of that invention.

The state of the art comprises:

- all matter which has been made available to the public anywhere in the world, by written or oral description, by use or in any other way
- matter contained in a patent application in South Africa which is, or will become, open to public inspection and where such matter has an earlier priority date
- an invention used secretly but on a commercial scale in South Africa prior to the priority date.

### **Certain prior knowledge or publication excused**

Unauthorised disclosure of an invention by another party prior to the filing date of a patent application can be excused, provided the applicant files the application with reasonable diligence after learning of the disclosure.

Disclosure or knowledge of the invention prior to the filing date, as a result of the invention being worked in South Africa by way of reasonable technical trial or experiment by the applicant, can also be excused.

### **Inventiveness**

An invention is deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art immediately before the priority date (but excluding subject matter contained in a pending application in South Africa, and an invention used secretly but on a commercial scale in South Africa).

### **Convention priority**

Any person who has filed a patent application in a convention country (at present Paris Convention countries) is entitled to claim priority from such earlier application, provided such earlier application was the first application for the invention as claimed in any convention country, and the application in South Africa is filed within 12 months from the filing date of such earlier application.

A certified copy of the earlier application has to be lodged, and an assignment of priority rights if the applicant is not the same as in the earlier application.

Priority rights may also be claimed in the following cases:

- where the application was preceded by a provisional application in South Africa and the subsequent complete application is filed within 12 months of the provisional application (a three-month extension is available upon payment of a fee)
- where the application was preceded by an earlier complete application in South Africa (without a claim to priority) and a subsequent complete application is filed within 12 months of the earlier application (a three-month extension is available upon payment of a fee).

### **Examination/procedure**

An application is subjected to formal examination only.

Once the Registrar is satisfied that all formal requirements have been complied with, a notice of acceptance is issued. It is possible, on request to the Registrar, to delay acceptance for up to 18 months for national applications, or 12 months for PCT applications (and for a period of three months thereafter upon payment of a fee). Any delay beyond 21 months for national applications, or 15 months for PCT applications, is at the discretion of the Registrar and on good cause shown.

If the documentary requirements have not been lodged within the abovementioned 18 months or 12 months period (or the three months extended period), the application lapses, unless an appeal has been lodged or the delay in accepting the application was not due to any act or omission on the part of the applicant.

**Opposition**

The Act makes no provision for opposition to an application prior to grant.

**Publication**

Upon issuance of the notice of acceptance, the applicant must publish the acceptance in the Patent Journal within three months (or within such further period as the Registrar may allow on good cause shown and on payment of a fee).

The patent is deemed to have been sealed and granted as from the date of such publication of acceptance.

**Duration and maintenance**

The term of a patent is 20 years from the date of filing. Maintenance fees are payable annually as from the third anniversary of the filing date. A six month grace period may be obtained on payment of the prescribed fee.

For PCT-based national phase applications, if grant takes place 33 months or later after the international filing date, the due date for payment of maintenance fees is extended to a date six months after the date of grant. A further six month grace period is also available.

If the renewal fee is not paid by the end of the prescribed period, the patent lapses.

**Restoration**

Where a patent has lapsed due to the non-payment of a renewal fee within the prescribed (or extended) period, the patentee may apply to the Registrar for the restoration of the patent. The Registrar must be satisfied that the omission was unintentional and that no undue delay has occurred in making the application.

The application for restoration is advertised in the Patent Journal and interested parties may oppose the restoration.

**Revocation**

A granted patent is subject to revocation. Any person may apply to the Court of the Commissioner for the revocation of the patent, or may counterclaim for revocation in an infringement action, on any of the grounds prescribed by the Act, including the following:

- that the invention was not new at the filing or priority date of the application
- that the invention is obvious
- that the patentee was not entitled to apply for the patent
- that the grant of the patent is in fraud of the rights of the person applying for revocation
- that the complete specification does not sufficiently describe, ascertain and, where necessary, exemplify or illustrate the invention
- that the claims are not clear or not fairly based on the matter disclosed

- that the prescribed declaration or the prescribed disclosure statement on the use of biological resources contains a false statement or representation which is material, which the patentee knew or ought reasonably to have known to be false.

### **Assignments**

An applicant for a patent or a patentee may assign the patent application or the patent. An assignment must be in writing and must be recorded in the register. If an assignment is not recorded it will not be valid as against third parties.

A patent for a main invention and its patent of addition cannot be assigned apart from one another.

Requirements of recordal:

- power of attorney by the applicant (simply signed)
- assignment document (simply signed), or abbreviated recordal document.

**Note:** The recordal is to take place within six months of the date of the assignment (which period may be extended on payment of a fee).

### **Licences**

A patentee may grant voluntary licences under the patent. A licence terminates when the patent expires or is revoked or lapses. Licences may not contain certain prescribed conditions which will unduly restrict the licensee in exercising the licensed rights.

Although a licence may be recorded in the register, this is not a requirement for its validity or enforceability.

Requirements for recordal

- power of attorney by the licensor (simply signed)
- copy of the licence agreement (simply signed), or abbreviated recordal document.

### **Compulsory licences**

The Act provides for compulsory licences to be granted by the Court of the Commissioner of Patents in two circumstances:

- in the case of so-called abuse of patent rights, ie when the rights under the patent are being abused by the patentee, eg if the patented invention is not adequately worked in South Africa within four years of the application date or three years of the date of grant (whichever period last expires), or if the demand for the patented article in South Africa is not being met to an adequate extent and on reasonable terms, or if the patent owner refuses to grant a voluntary licence on reasonable terms and trade or industry or agriculture in South Africa is being prejudiced



- in the case of a so-called dependent patent, ie where the working of a dependent patent cannot take place without infringement of a prior patent and agreement cannot be reached with the patent owner of the prior patent on the granting of a voluntary licence.

In both cases application has to be made to the Court of the Commissioner and the prescribed evidence is to be submitted. Such a compulsory licence is subject to certain prescribed conditions.

### **Amendments**

The Patents Act provides for the amendment of the documents forming part of a patent application or a patent, and for the correction of clerical errors.

The Registrar or the Commissioner of Patents may authorise the correction of any clerical error or error in translation in a patent application or patent. This may take place on the basis of a request by the applicant or patentee, or may be initiated by the Registrar. The procedure to be followed is prescribed in the Act and Regulations.

An applicant for a patent or a patentee may also apply to the Registrar for the amendment of the patent specification. The procedure and applicable principles are prescribed. Generally speaking, an amendment will not be allowed if it seeks to introduce new matter or matter not in substance disclosed prior to amendment, or if it seeks to introduce a claim not fairly based on matter disclosed in the specification prior to amendment and not wholly within the scope of a claim before amendment.

If new matter is to be introduced, this may be done by way of a so-called supplementary disclosure, which will receive the date on which such amendment is made.

An amendment made in conflict with the provisions of the Act and Regulations may be set aside by the court.

### **Effect of a patent**

The effect of a patent is to grant to the patent owner the right to exclude other persons from making, using, exercising, disposing of or offering to dispose of, or importing the patented invention, so as to enjoy the whole profit and advantage accruing by reason of the patent.

If a patented article has been disposed of by, or on behalf of (eg by a licensee), the patent owner, the purchaser has the right to use or dispose of that article.

### **Infringement**

Infringement takes place when any person without the authority of the patentee makes, uses, exercises, disposes of, offers to dispose of, or imports the patented invention.

An important exception was created when a so-called Bolar provision was introduced into the Patents Act. In terms of this provision, it shall not constitute an infringement of a patent to make, use, exercise, dispose or offer to dispose of, or import a patented invention on a non-commercial scale and solely for the purposes reasonably related to the development or submission of information required under any law that regulates the manufacture, distribution, use or sale of any product. Stock-piling of any patented product is not permitted.

An infringement action may be instituted in the Court of the Commissioner by the patentee (or in certain limited circumstances by a licensee). Infringement proceedings may normally not be instituted within nine months of the grant of the patent. The defendant may, by way of a counterclaim, apply for the revocation of the patent.

The successful plaintiff is usually entitled to the following relief:

- an interdict (injunction) ordering the defendant to refrain from further infringement
- an order for the delivery-up or destruction of infringing articles
- damages; an enquiry into damages may be ordered
- in lieu of damages, an amount may be awarded calculated on the basis of a reasonable royalty.

### **Marking**

It is not a legal requirement for patented products to be marked with the patent number. However, if the patented product is not so marked and an infringer can show that he was not aware, and had no reasonable means to be made aware, of the existence of the patent, the patentee will not be entitled to recover damages.

### **Working**

If the patented invention is not worked in South Africa on a commercial scale or to an adequate extent within four years after filing of the application or three years after grant, and there is no satisfactory reason for such non-working, this provides a ground for a compulsory licence to be granted (see the section on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Design Act no 195 of 1993
- Design Regulations, 1999

South Africa is a member of the Paris Convention and the WTO/TRIPS. It is expected to accede to the Hague Agreement in the near future.

### **Design protection**

Design protection is obtained by the filing of an application for the registration of a design.

The effect of a design registration is to grant to the registered proprietor the right, for the duration of the registration, to exclude other persons from making, importing, using or disposing of any article included in the class in which the design is registered and embodying the registered design, or a design not substantially different therefrom, so that the registered proprietor shall have and enjoy the whole profit and advantage accruing by reason of the registration.

The disposing (in South Africa) of an article embodying a registered design by or on behalf of the registered proprietor gives the purchaser the right to use and dispose of that article.

### **Registrable subject matter**

The Act provides for two types of designs:

- an aesthetic design, which is defined to mean a design applied to an article, whether for the pattern or the shape or the configuration or the ornamentation thereof, and by whatever means it is applied, having features which appeal to and are judged solely by the eye
- a functional design, which is defined to mean a design applied to an article, whether for the pattern or the shape or the configuration thereof, and by whatever means it is applied, having features which are necessitated by the function which the article is to perform, and includes an integrated circuit topography, a mask work and a series of mask works.

It is a requirement that the article, to which a design is to be applied, must be intended to be multiplied by an industrial process.

An aesthetic design is registered in Part A of the register; a functional design in Part F of the register.

### **Classification of designs**

The articles to which designs may be applied are classified into different classes. The International Classification of Industrial Designs adopted by the Locarno Union (as subsequently amended) is applicable, although South Africa is not a member of the Union. A separate application is required for each class.

### **Types of applications**

Application for a design registration may be made by way of –

- a non-convention national application
- a convention application claiming priority of the first-filed application in a Paris Convention country.

Designation of South Africa in an international application under the Hague Agreement is not yet possible.

**Application**

The requirements for filing a non-convention design application are:

- declaration and power of attorney by the applicant (simply signed)
- assignment, simply signed, where the applicant has acquired the right to apply from the author/creator or a predecessor
- indication that the registration is to be in Part A or Part F
- indication of the class in which the registration is to be effected
- release date, if applicable (see the section on **Novelty** below)
- representations of each view of the design (may be drawings or photographs)
- definitive statement of the features for which protection is claimed
- explanatory statement in the case of designs for an integrated circuit topography (explanatory statement is optional for other functional designs)
- brief statement of the features of the design, for publication.

The requirements for a convention application are the same as for a non-convention application (see above) and in addition –

- certified copy of the basic application in the convention country (with verified English translation, if applicable)
- assignment of priority rights if the applicant is not the same as in the convention country.

**Applicant**

The applicant must be the proprietor of the design.

The proprietor means:

- the author of the design
- where the author (or his employee) executed the work for another person, such other person
- where the ownership has passed to another person (eg by assignment), such other person.

**Convention priority**

Any person who has filed a first design application in a convention country (at present Paris Convention countries), is entitled to claim priority from such earlier application, provided the South African application is filed within six months from such earlier application.

**Novelty**

To be registrable, an aesthetic design must be new and original; a functional design must be new and not commonplace in the art.

A design is deemed to be new if it is different from, or not part of, the state of the art at the effective date of the application. The effective date is the date of filing the application in South Africa, or the priority date, or the release date, whichever date is earlier.

The release date means the date on which the design was first made available to the public (whether in South Africa or elsewhere) with the consent of the proprietor of the design. It should be noted that if a design is released prior to the filing of an application for registration, it will only be deemed new if an application is filed in South Africa within six months of the release date; or, in the case of an integrated circuit topography or a mask work, within two years of the release date.

The state of the art comprises the following:

- all matter made available to the public, in South Africa or elsewhere, by written description, by use or in any other way
- all matter contained in an earlier pending South African design application, or in an earlier application in a convention country subsequently registered in South Africa, if such earlier date is earlier than the effective date of the relevant South African design application.

### **Examination/procedure**

An application is subjected to formal examination only. If the Registrar is satisfied that all formal requirements are complied with, a notice of registration is issued. The registration is then published in the Patent Journal.

### **Opposition**

No provision is made for opposition.

### **Duration and maintenance**

The duration of the registration of –

- an aesthetic design is 15 years
- a functional design is 10 years.

The continued maintenance of the registration is subject to the payment of the prescribed annual renewal fees as from the third year after registration. A six month grace period may be obtained (on payment of a fee) for the payment of a renewal fee. If the renewal fee is not paid by the end of the relevant period, the registration lapses.

### **Restoration**

Where a design registration has lapsed due to the non-payment of a renewal fee, the registered proprietor may apply to the Registrar for the restoration of the registration. The Registrar must be satisfied that the omission was unintentional and that no undue delay occurred in making the application.

The application for restoration is advertised in the Patent Journal and interested parties may oppose the application.

### **Revocation**

A registered design is subject to revocation. Any person may apply to the High Court for the revocation of a design registration on the following grounds:

- that the applicant for the design registration was not entitled thereto
- that the design registration is in fraud of the rights of the person applying for revocation
- that the design is not registrable
- that the design application contained a false statement or representation which is material
- that the registration of the design should have been refused.

### **Assignments and licences**

Specific provision is made in the Act for designs to be assigned or to devolve by operation of law. Assignments must be in writing and must be recorded in the register to be valid against third parties.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- assignment document (simply signed), in English or with English translation.

General references are also made in the Act to the licensing of design rights. Although not required for validity, a licence may be recorded in the register. In order to rely on a licence as evidence in any proceedings, recording is necessary.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- licence contract (simply signed), in English or with English translation.

### **Compulsory licences**

The Act provides for the granting of a compulsory licence by the court in cases where it can be shown that the rights in a registered design are being abused by the proprietor. Abuse will be deemed to occur, for example, if the design is not being exploited in South Africa to an adequate degree, or if articles embodying the design are not available in South Africa on a commercial scale or to an adequate extent; or if the refusal by the registered proprietor to grant voluntary licences on reasonable terms causes prejudice to the trade or industry or agriculture in South Africa. Application has to be made to the High Court for a compulsory licence, and such licence will be subject to certain prescribed conditions.

### **Amendment**

The Act provides for the amendment of an application for a design registration or of the registration itself. An amendment may be allowed if it is by way of correction, including the correction of a mistake.

No amendment of an application or a registration shall be allowed if –

- the effect of the amendment will be to introduce new matter or matter not in substance disclosed prior to amendment
- the effect of the amendment would be to introduce matter not fairly based on matter disclosed before amendment.

An amendment of a registration after grant will also not be allowed if the scope of the registration after amendment would be wider than before amendment; or if the amendment is to move the registration from Part A to Part F of the register or *vice versa*.

An application for amendment is made to the Registrar, who shall advertise the application in the Official Journal. If the application for registration is open to public inspection, the application for amendment may be opposed by any person.

### **Effect of a design registration**

A design registration grants to the proprietor of the registration the right to exclude all other persons from making, importing, using or disposing of any article included in the class in which the design is registered and embodying the registered design or a design not substantially different therefrom, so that the proprietor shall have and enjoy the whole profit and advantage accruing by reason of the registration.

### **Infringement**

Infringement takes place when any person, without the authority of the proprietor of the design registration, makes, imports, uses or disposes of any articles included within the class or classes in which the design is registered and embodying the registered design or a design not substantially different.

There are certain specific exceptions in respect of designs for integrated circuit topographies.

Proceedings for infringement may be instituted in the High Court by the registered proprietor. The defendant may counterclaim for the revocation of the design registration.

The successful plaintiff is usually entitled to the following relief:

- an interdict (injunction) ordering the defendant to refrain from further infringement
- surrender of any infringing products or articles
- damages; an enquiry into damages may be ordered
- in lieu of damages, an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee.

Compensation is payable to an infringer who incurred expenditure prior to the infringement proceedings, in certain circumstances.

### **Marking**

It is not a legal requirement for an article bearing a registered design to be marked with the registration number. However, if the article is not marked with the registration number, the registered proprietor will be prevented from claiming damages from, or obtaining an interdict against, an infringer during a specified period when such infringer requests the relevant information.

Falsely representing that a design is registered is a criminal offence.

### **Working**

In certain circumstances, non-working can be a ground for an application to the High Court, by a third party, for a compulsory licence.

## **COPYRIGHT**

### **Law**

- Copyright Act no 98 of 1978
- Copyright Regulations, 1978
- Registration of Copyright in Cinematograph Films Act no 62 of 1977
- Registration of Copyright in Cinematograph Films Regulations, 1980
- Performers' Protection Act no 11 of 1967

South Africa is a member of the Berne Convention and the WTO/TRIPS.

### **Subject matter eligible for protection**

The following works, if they are original, are eligible for copyright:

- literary works
- musical works
- artistic works
- cinematograph films
- sound recordings
- broadcasts
- programme-carrying signals
- published editions
- computer programs.

A work (except a broadcast or programme-carrying signal) is not eligible for copyright unless it has been written down, recorded, represented in digital data or signals, or otherwise reduced to material form.

The requirement of originality has been interpreted by the courts to mean that the author must have expended creative effort, labour and skill in creating the work.

### **Registration of copyright**

There is no provision in the Act for the registration of copyright. Separate legislation provides for the registration of copyright in films (see the section on **Registration of copyright in films** below).



### **Requirements for subsistence of copyright**

Copyright in terms of the Act exists *de facto*; there is no provision for registration of copyright. In respect of cinematograph films, optional registration is provided for in a separate Act (see the section on **Registration of copyright in films** below). Such registration is not required for copyright to be created; registration merely serves to provide proof of the existence of the copyright, the ownership of the copyright, the existence of licences, etc.

Copyright is automatically conferred on a work eligible for copyright at the time when it is created or published for the first time, provided certain requirements are complied with:

- the work must be original and reduced to material form (see above)
- the author (or in the case of joint authorship, one of the authors) must, at the time the work is made, be a qualified person; this means –
  - in the case of an individual, a person who is a citizen of South Africa or a Berne Convention country, or who is domiciled or resident in South Africa or a convention country; or
  - in the case of a juristic person, a body incorporated under the laws of South Africa or a convention country
- a work of architecture erected in South Africa, or any other artistic work incorporated in a building or any other permanent structure in South Africa, is eligible for copyright whether or not the author was a qualified person
- a work which is first published in South Africa or a Berne Convention country, or in the case of a broadcast, a cinematograph film or a computer program, is made in South Africa or a Berne Convention country, is eligible for copyright even though the author is not a qualified person
- in the case of a work which is eligible for copyright and which is made by or under the direction or control of the State or an international organisation, the copyright vests in the State or in the relevant international organisation.

### **Copyright extended to Berne Convention countries**

The Act provides that copyright enjoyable in terms of the Act may be extended to the nationals of member countries of the Berne Convention. Such extension takes place by way of a notice in the Government Gazette by the Minister.

### **Exclusions from copyright**

The Act provides that no copyright will subsist in official texts of a legislative, administrative or legal nature, or in official translations thereof, or in news of the day that are mere items of press information.

### **Authorship**

The author of a copyright work is generally the person who makes or creates the work, but this is not the case in respect of all works.

The author is defined in the Act in respect of the different works as follows:

- a literary, musical or artistic work, the person who first makes or creates the work
- a photograph, the person who is responsible for the composition of the photograph
- a sound recording, the person by whom the arrangements for the making of the sound recording were made
- a cinematograph film, the person by whom the arrangements for the making of the film were made
- a broadcast, the first broadcaster
- a programme-carrying signal, the first person emitting the signal to a satellite
- a published edition, the publisher of the edition
- a literary, dramatic, musical or artistic work or computer program which is computer-generated, the person by whom the arrangements necessary for the creation of the work were undertaken
- a computer program, the person who exercised control over the making of the computer program.

### **Ownership of copyright**

The author is, generally speaking, the first owner of the copyright which subsists in the work. The Act provides that as a general rule, the ownership of the copyright vests in the author, except in the following cases:

- where a literary or artistic work is made by an author in the course of his employment by the proprietor of a newspaper, magazine or the like, the copyright belongs to the proprietor of the newspaper, magazine, etc for the purposes of being so published, but in all other respects the copyright vests in the author
- where a person who commissions a photograph, painting or drawing of a portrait, making of a gravure, making of a cinematograph film or making a sound recording and pays for it, that person will be the owner of the copyright
- in the case of all works not falling within the above categories and which are made in the course of an author's employment by another person under a contract of service or apprenticeship, the copyright will be owned by the employer
- in the case of works made under the direction or control of the State, ownership of the copyright vests in the State.

In the first-mentioned three cases, the statutory provisions in regard to ownership may be excluded or changed by way of agreement between the parties.

### **Duration of copyright**

The term of copyright is different for different categories of works but is never less than 50 years:

- in respect of literary, musical or artistic works other than photographs, the term is the life of the author plus 50 years from the end of the year in which the author dies (there are special provisions for unpublished works)

- in respect of cinematograph films, photographs and computer programs, the term is 50 years from the end of the year in which the work is made available to the public with the consent of the copyright owner, or the end of the year in which the work is first published, whichever term is longer, or failing this, 50 years from the end of the year in which the work is made
- in the case of sound recordings, the term is 50 years from the end of the year in which the recording is first published
- in the case of broadcasts, the term is 50 years from the end of the year in which the broadcast first takes place
- in the case of programme-carrying signals, the term is 50 years from the end of the year in which the signals are emitted to a satellite
- in the case of published editions, the term is 50 years from the end of the year in which the edition is first published.

Special provisions provide for anonymous or pseudonymous works and works of joint authorship.

### **Protection afforded by copyright**

The subsistence of copyright in a work in terms of the Act does not confer absolute protection for the work in the sense of prohibiting the making of or use of a similar work by another in all circumstances; it confers generally a right to prohibit certain acts, particularly the unauthorised copying of the work by another.

Copyright confers on the copyright owner an exclusive right to do or to authorise the doing of certain acts specified in respect of each of the different categories of works. These prohibited acts vary according to the type of work. The most important acts which are so prohibited are:

- the unauthorised making of a reproduction (or copy) of the work
- the unauthorised publishing of the work if it was previously unpublished
- the unauthorised broadcasting of the work
- in the case of programme-carrying signals, the unauthorised diffusion of the work is the most important prohibited act
- in the case of computer programs, sound recordings and cinematograph films, the unauthorised letting or offering for hire by way of trade of copies of the work is also specifically prohibited.

### **Exceptions to copyright protection**

The Act provides for certain cases where the use of a copyright work will not constitute an infringement of copyright. Generally speaking these cases cover the so-called 'fair dealing' with a copyright work. Although the concept of fair dealing is not defined in the Act, it is generally understood to mean that such dealing should not be to the economic detriment of the copyright owner. The excepted acts are specifically defined in respect of each category of copyright works.

The Act also provides for the making of certain reproductions of copyright works to be permitted by way of regulation, in a manner not in conflict with the normal exploitation of the work and not unreasonably prejudicial to the legitimate interests of the copyright owner. The reproductions relate primarily to archival or library conservation or storage, or the making of copies for class room use for teaching and/or educational purposes.

### **Moral rights**

The Act provides that, notwithstanding the transfer of the copyright in a literary, musical or artistic work or in a cinematograph film or a computer program, the author shall have the right to claim authorship in the work and to object to any distortion, mutilation or other modification of the work where such action is or would be prejudicial to the honour or reputation of the author.

### **Assignment of copyright**

Copyright is transferable as movable property by assignment, testamentary disposition or operation of law. To be effective, an assignment of copyright must be in writing and signed by the assignor.

### **Licensing of copyright**

Copyright may be licensed by the copyright owner. To be effective, an exclusive licence must be in writing and signed by the licensor. However, a non-exclusive licence may be written or oral or inferred from conduct.

A special Copyright Tribunal has been established to deal with disputes relating to licensing bodies and licence schemes.

### **Copyright infringement**

The Act provides for acts of direct as well as indirect infringement.

#### **Direct infringement**

Copyright in a work is infringed by any person who, without the authorisation of the owner, does any of the acts reserved for the owner in terms of the Act (see the section on **Protection afforded by copyright** above).

#### **Indirect infringement**

Copyright is infringed indirectly by the following acts:

- by any person who, without the authority of the copyright owner, imports, sells, lets, by way of trade offers or exposes for sale or hire, or distributes for purposes of trade, an article in South Africa if he knew that the making of the article constituted an infringement of copyright or would have constituted an infringement if made in South Africa
- by any person who permits a place of entertainment to be used for a public performance of a literary or musical work, where the performance constitutes an infringement of copyright, unless the person was not aware and had no reasonable grounds to suspect that the performance was an infringement.

### **Infringement proceedings**

Civil proceedings may be instituted in the High Court or a Magistrate's Court by the copyright owner to obtain relief in the case of infringement of copyright. Such proceedings can be instituted either by way of application or by action. In an application evidence is by affidavit, while in an action evidence is given orally. In view of the limited jurisdiction of the Magistrate's Court, High Court proceedings are generally preferred.

If infringement is found to have taken place, the plaintiff is entitled to –

- damages
- an interdict
- delivery-up of infringing copies or plates used for making infringing copies
- in lieu of damages, at the option of the plaintiff, an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee.

For determining the amount of the damages or the reasonable royalty, the court may direct that an enquiry into damages be held. The court may also, taking into account the flagrancy of the infringement and the benefit shown to have accrued to the defendant, award such additional damages as the court may deem fit.

### **Criminal offences**

Criminal proceedings are also available in certain cases. Certain acts and dealings which infringe copyright are stipulated to be criminal offences, and fines and periods of imprisonment are prescribed. These acts include the following if done without the authority of the copyright owner:

- making for sale or hire
- selling or letting for hire by way of trade
- exhibiting in public or distributing by way of trade
- importing into South Africa otherwise than for private or domestic use articles which the person knows to be infringing copies of the work.

### **Registration of copyright in films**

The purpose of registration is not to create the copyright; it is to facilitate proof that copyright subsists in a particular cinematograph film in South Africa, and that a given person is the owner of the copyright in such film. This makes it easier for a copyright holder to bring infringement proceedings against an infringer. In the absence of registration, it is necessary for a copyright owner in a litigation matter not only to prove ownership, but also to establish the subsistence of copyright.

Any person claiming to be the owner of the copyright in a cinematograph film by virtue of the provisions of the Copyright Act may apply to the Registrar in the prescribed manner for registration.

**Requirements for filing an application for registration**

- the full name, nationality, trading style, legal status, and description of the applicant (if the applicant is a body corporate other than a South African company, the nature of the body and country of incorporation)
- the street address of the applicant or the principal place of business of a corporation
- documentary proof of entitlement to apply (if the applicant is not the author)
- whether the film is in colour, or in black and white
- whether any marks, including trade marks, or any features are used to distinguish the cinematograph film
- the category of the film (the categories are specified in the Regulations)
- the language of the film
- the duration of the film
- the particulars to be set out in the statement of case
- the full names (and designation) of the signatory of the sworn translation certifying the statement of case
- a power of attorney.

The Registrar may, in his discretion, call for a deposit of a specimen of the cinematograph film.

**Statement of case**

The application for registration must be accompanied by a statement of case, which must contain the following particulars:

- the name or names of the film
- the name, citizenship, and country of domicile and residence of the author of the film
- if it is claimed that the author is a body corporate, the circumstances by virtue of which it is so claimed
- dates on which and places at which the film was made
- whether the film has lawfully been made available to the public, and if so the date on which this took place
- whether the film has been published and if so the place and date of first publication
- a brief description of the story or subject matter of the film
- the full name of the director and producer of the film
- the full names of the principal players or of the narrator in the film.

**Procedure after filing**

The application is examined by the Registrar, who may either accept it absolutely, or preliminarily refuse it, or indicate subject to what conditions it may be accepted. If there is a preliminary refusal, or a conditional acceptance, the applicant may make representations to the Registrar to overcome objections, or to deal with the application as the circumstances may dictate.

Once an application has been accepted, it must be advertised in the Patent Journal. A month after the advertisement date, if no opposition is entered, a certificate of registration is issued.

### **Performers' protection**

The TRIPS Agreement requires its member states to provide protection to performers in respect of their fixed and unfixed performances. The Performers' Protection Act provides such protection, but makes it clear that the rights created under the Act will in no way restrict or affect the rights provided by other laws in regard to copyright in literary, musical or artistic works.

The Act imposes restrictions on the use of unfixed performances without the consent of the performer, including –

- broadcasting or communicating the performance to the public
- making a fixation of the performance
- making a reproduction of a fixation of the performance.

Where there is a commercial fixation of a performance, the Act restricts the use of such fixation, without payment of a royalty to the performer, by –

- broadcasting the performance
- causing the performance to be transmitted in a diffusion service
- causing any communication of the performance to the public.

The royalty payable is to be determined by agreement between the performer and the broadcaster, or between their collecting societies.

The protection extends from the date on which a performance takes place, for a period of 50 years (calculated from the end of the calendar year).

Enforcement can take place by civil proceedings. Certain contraventions constitute offences; the penalty is a fine or imprisonment.

## **PLANT BREEDERS' RIGHTS**

### **Law**

- Plant Breeders' Rights Act no 15 of 1976
- Plant Breeders' Rights Regulations, 1977

South Africa is a member of the UPOV Convention for the Protection of new Varieties of Plants, and the WTO/TRIPS.

### **Protection**

Protection by way of a plant breeder's right may be obtained in respect of new varieties of certain 'kinds of plants' by filing an application for registration (see the section on **Application** below) under the Plant Breeders' Rights Act.

The effect of the protection is that prior authority must be obtained from the holder of the right by way of a licence, by any person intending to undertake any of the acts set out below, in respect of propagating material of the protected variety, or harvested material (including plants) obtained through the unauthorised use of propagating material of the protected variety, namely:

- production or reproduction (multiplication)
- conditioning for the purpose of propagation
- sale or any form of marketing
- exporting
- importing
- stocking for any of the above purposes.

In addition to the protected variety, the protection is extended to –

- essentially derived varieties of the protected variety
- varieties which are not distinguishable from a protected variety
- varieties the production of which requires the repeated use of the protected variety.

The protection may also be extended by notice in the Government Gazette to products made directly from harvested material of a protected variety.

### **Protectable subject matter**

In order to be registrable, a plant must be prescribed, ie named in the list of 'kinds of plants' which is set out in the Regulations under the Act. This list is varied from time to time; for example, the list currently includes *inter alia* the following kinds of plants that are registrable:

#### **Agricultural crops**

Kidney bean, castor bean, potato, groundnuts, oats, soya bean, cotton, sunflower, barley, rye grass, hops, lucerne, rice, pearl millet (babala), grain sorghum, wheat and grain maize.

#### **Vegetable crops**

Onion, garden beet, cauliflower, cabbage, turnip, sweet pepper, cucumber, pumpkin, squash, carrot, lettuce, tomato, garden bean, pea, sweet corn, popcorn, watermelon, spanspek (sweet melon), eggfruit and olive.

#### **Fruit crops**

Citrus, quince, strawberry, litchi, apple, mango, banana, grenadilla, avocado, apricot, sweet and sour cherry, plum, peach, nectarine, guava, pear, grape, almond, pecan nut, coffee, tea and macadamia nut.

#### **Ornamental crops**

Protea, chrysanthemum, carnation, poinsettia, freesia, gladiolus, geranium, rose, african violet, lachenalia, chinkerinchees, brunia, wax flower, heath, sword fern, giant panicum, protea, agapanthus, michaelmas daisy, fuchsia, begonia, ivy, hibiscus and oleander.



**Requirements for registrability**

In order to qualify for registration, and thus for protection under a plant breeder's right, a plant must constitute a variety and must be new, distinct, uniform and stable.

**Variety**

A variety is defined to mean a plant grouping within a single botanical taxon of the lowest known classification and which can be –

- defined by the expression of the characteristics resulting from a given genotype or combination of genotypes
- distinguished from any other plant grouping by the expression of at least one such characteristic, and
- considered as a unit with regard to propagation without change.

**New**

A plant variety is deemed to be new if propagating material or harvested material of the plant has not been sold or otherwise disposed of by the breeder (or with his consent) for purposes of exploitation for longer than certain prescribed periods (eg one year for sale or disposal in South Africa with longer periods available outside South Africa).

**Distinct**

A plant variety is deemed to be distinct if, at the date of filing the application, it is clearly distinguishable from other varieties of the same kind of plant whose existence is a matter of common knowledge. The common knowledge is deemed to include a pending plant breeder's right application.

**Uniform**

A plant variety is deemed to be uniform if it is sufficiently uniform as regards its features or characteristics.

**Stable**

A plant variety is deemed to be stable if the characteristics thereof remain unchanged after repeated propagation.

**Application**

The requirements for filing an application or registration are the following:

- an application form containing –
  - full particulars of the applicant and breeder, including names, addresses and nationalities
  - if the breeder is not the applicant, the manner in which the applicant obtained rights to file the application (eg a deed of assignment)
  - the proposed denomination, which must comply with the Act
  - the country in which the variety was bred or discovered
  - particulars of preceding applications in other countries for plant breeders' rights or for inclusion in official variety lists in respect of the same plant
  - if propagating material and/or harvested material of the variety has already been offered for sale or has been marketed, full details of such sales or marketing
- a completed technical questionnaire

- a power of attorney, executed by or on behalf of the applicant
- propagating material as prescribed, typically in the form of seeds, bulbs or specimen plants, for examination purposes.

All documentary requirements must be submitted on filing of the application. The propagating material must be supplied to the Registrar within 12 months of the filing of the application.

### **Denomination of variety**

For purposes of an application for a plant breeder's right, the variety must have a denomination, which is the generic name for the variety. No other denomination may be used in respect of that variety; however, a trade mark may be used in conjunction with the denomination.

### **Applicant**

An application for registration of a plant breeder's right may be made by –

- the breeder, ie the person who bred or discovered or developed the variety, or
- the employer of the breeder if that person was an employee and the variety was bred in the performance of his duties, or
- the successor in title of the breeder or employer.

The applicant must be a citizen of or domiciled in South Africa or in a convention country or an agreement country. Where the applicant is a juristic person, the applicant must have a registered office in such country.

### **Convention priority**

South Africa, as a member of the UPOV Convention, recognises an application filed in another member country for purposes of the granting of priority rights. South Africa has also, by proclamation in the Government Gazette, declared certain countries to be so-called agreement countries for purposes of the fulfilment of a bilateral agreement concerning plant breeders' rights.

Priority rights can be claimed from a previous application in a country which has subscribed to the UPOV Convention or which is designated as an agreement country, provided the South African application is filed within 12 months of the date of deposition in the convention country or agreement country. A certified copy of the previous application must be filed within three months of the date of filing the South African application.

Conversely, an application in another country can claim convention priority from a basic South African application if the country is a convention country or an agreement country, and provided the foreign application is filed within one year of the basic South African application.

### **Examination**

After filing an application, a formal examination of the application is conducted by the Registrar. If the application is formally in order, the application is published in the Government Gazette by the Registrar. Any

person may within a period of six months from such publication, object to the grant of the plant breeder's right.

The Registrar may also reject the application on one of a number of formal grounds, including that –

- the application does not comply with the provisions of the Act
- the variety is not in respect of a prescribed kind of plant
- the applicant is not entitled to make the application
- the application contains a material misrepresentation
- the applicant has failed to propose an acceptable denomination.

The Registrar thereafter subjects the propagating material to a variety of tests and trials for purposes of evaluation. The application will remain pending for a period of one to three years until the conclusion of the examination by the Registrar. If the results of the evaluation are satisfactory, a plant breeder's right will be granted and a registration certificate issued.

### **Provisional protection**

If the application is found to be formally in order and is to be published in the Government Gazette, the applicant may request that a protective direction be issued. A protective direction will be issued if certain requirements are met, eg that the applicant gives a written undertaking that no reproductive material will be sold for the duration of the direction.

The protection afforded by the protective direction is as if the plant breeder's right has already been granted; the direction ceases to have effect when the plant breeder's right is finally granted or refused.

### **Infringement**

Infringement of a plant breeder's right take place if any person –

- without the authority of a voluntary licence obtained from the owner of the right (see the section on **Licences**), or without the authority of a compulsory licence (see the section on **Compulsory licences**), carries out any of the acts reserved exclusively for the right holder, including extended rights (see the section on **Protection**)
- has obtained a voluntary or compulsory licence but fails to comply with any term or condition thereof
- uses the denomination of a protected variety in conjunction with plants or propagating material of another variety
- sells plants or propagating material of a protected variety under a denomination other than the approved denomination.

The Act also provides for certain exceptions to infringement, such as reselling of propagating material, use of propagating material for *bona fide* research, or for private or non-commercial purposes.

Infringement proceedings may be instituted in any competent court. On proof of infringement and without proof of damages, the right holder can recover a monetary compensation not exceeding a specified amount. The right holder or a licensee may also institute proceedings for actual damages

in addition to further relief, such as the surrender of books and documents, and of propagating material or related products.

### **Duration**

In 1996 the Plant Breeders' Right Act was amended to provide that plant breeders' rights are granted for 25 years for vines and trees, and 20 years for all other plants. Prior to 1996, the duration of plant breeders' rights varied between 15 and 20 years.

In order to keep a plant breeder's right in force, annual renewal fees have to be paid.

### **Assignment**

A plant breeder's right may be assigned. The Registrar must be notified within a period of 30 days from the date of the transfer, with information of the name and address of the assignee and proof that all licensees have been notified.

Any transfer or assignment must be published in the Government Gazette.

### **Voluntary licences**

The right holder may grant a voluntary licence to a licensee. The licensor must notify the Registrar of the licence within 30 days and must submit a copy of the licence agreement.

The South African Exchange Control provisions must be borne in mind in regard to the payment of royalties to a foreign right holder.

### **Compulsory licences**

If a person can show that a right holder unreasonably refuses to grant a voluntary licence, or imposes unreasonable conditions on such a licence, such person may apply to the Registrar for a compulsory licence.

If the Registrar is satisfied that the right holder is unreasonably refusing a licence or is imposing unreasonable conditions, a compulsory licence may be granted. In settling the terms of such a licence, the Registrar must ensure that propagating material of the protected variety will be available to the public on reasonable terms consistent with the right holder deriving a reasonable commercial advantage.

### **Marking**

After registration, propagating material sold for purposes of propagation must indicate the denomination of the variety on a label attached thereto, or if it is packed, on its container.

# ST HELENA

## GENERAL INFORMATION

St Helena is an island in the South Atlantic Ocean, which lies about 1920 kilometers west of Angola and is administered by the United Kingdom.

<b>Area:</b>	308 km <sup>2</sup>
<b>Population:</b>	7670
<b>Capital:</b>	Jamestown
<b>Currency:</b>	St Helena Pound
<b>GDP:</b>	\$18 million (2010)
<b>Internet domain:</b>	.sh
<b>Languages:</b>	English (official language)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Fish (frozen and salt-dried skipjack, tuna); handicrafts; coffee
<b>Imports:</b>	Food; beverages; tobacco; fuel oils; animal feed; building materials; motor vehicles and parts; machinery and parts



## International conventions

St Helena is not a member of any international agreements.

## IP legislation

Trade marks

- United Kingdom Trade Marks (Registration) Ordinance no 1 of 1949, Chapter 127 (as amended)
- United Kingdom Trade Marks (Registration) Rules Notice no 3 of 1949 (as amended)

Patents

- Patents (Registration) Ordinance no 2 of 1927, Chapter 129 (as amended)
- Patents (Fees) Regulations Notice no 12 of 1989 (as amended)

Designs

- United Kingdom Designs (Protection) Ordinance no 7 of 1930, Chapter 128 (as amended)

Copyright

- Copyright Order no 1038 of 1963

## TRADE MARKS

### Law

- United Kingdom Trade Marks (Registration) Ordinance no 1 of 1949, Chapter 127 (as amended)
- United Kingdom Trade Marks (Registration) Rules Notice no 3 of 1949 (as amended)

St Helena is not a member of any international treaty on trade marks.

### Trade mark protection

Provision is made for the registration of product marks only. Only the owner of a UK registered trade mark may apply for registration in St Helena, based on a UK trade mark registration.

### Definition of a trade mark

There is no definition of a mark in either the Ordinance or the Rules. This is so since applications have to be based on trade marks already registered in the UK.

### Classification

The International Classification of Goods is applied, but there is currently no provision for services. A single application may cover more than one class.

### Convention priority

Priority cannot be claimed.

### Application

Applications can be filed at any time during the life of the UK trade mark. An application is filed with the Registrar of the Supreme Court of St Helena.

The following information and documents are required:

- power of attorney (simply signed)
- electronic print of the mark
- certified copy of the corresponding UK registration certificate.

### Examination/procedure

There is no examination procedure. When applications are lodged, the details of the UK registration are entered into the St Helena register, and a certificate of registration is issued.

### Opposition

There is no provision for opposition.

### Duration and renewal

A trade mark registration is effective from the date of registration in the United Kingdom, and continues for the duration of the UK registration (ie 10 years). The registration in St Helena must be renewed within six months after the renewal of the UK registration, by giving notice to the Registrar in the prescribed form and paying the prescribed fee.

**Cancellation/removal of a trade mark**

The court has the power, on application by any person whose interests have been prejudiced by the registration of a trade mark in St Helena, to cancel the registration in St Helena on any grounds, *mutatis mutandis*, on which the basic UK registration could have been cancelled. Should the basic UK registration be removed for non-use, the dependent St Helena registration will automatically be cancelled.

**Assignment**

Assignment of a registration is possible.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- certified copy of the UK registration certificate showing assignment or other proof of title
- original St Helena certificate of registration for endorsement.

**Licensing/registered users**

Licensing is recognised. Recordal of licensees or registered users is required in order to be legally binding.

Requirements for recordal:

- power of attorney from the proprietor (simply signed)
- power of attorney from the licensee (simply signed)
- proof of recordal in the UK.

**Amendment**

A registration may be amended with regard to any change in the name, description or address of the registered proprietor. It is also possible to correct clerical errors in any application or other matter entered on the Register, as well as to cancel the registration or the entry of a registered user, either wholly or in part.

**Rights conferred by registration**

The registered proprietor of a trade mark in St Helena has the same privileges and rights, *mutatis mutandis*, in relation to the use of the trade mark in respect of the relevant goods as would be conferred by the law in force in the UK.

**Trade mark infringement and defences**

The Ordinance provides that the rights conferred by a registration in St Helena continue to be effective for as long as the UK registration remains in force. It is then expressly stated that no action for infringement of the trade mark will be entertained in respect of use made of the trade mark prior to the date of issue of the certificate of registration in St Helena.

**Relief for trade mark infringement**

No provision.

### **Common law rights**

It is expressly stated that nothing in the Ordinance will affect any right of action based on passing-off.

### **Marking of goods**

The marking of goods by using the legend 'Registered Trade Mark' or suitable abbreviation (eg Regd. Tm.) or the symbol ® thereon is optional.

## **PATENTS**

### **Law**

- Patents (Registration) Ordinance no 2 of 1927, Chapter 129 (as amended)
- Patents (Fees) Regulations Notice no 12 of 1989 (as amended)

St Helena is not a member of any international treaty on patents.

### **Patent protection**

Patent protection in St Helena is obtainable only by confirmation of a United Kingdom patent. Although this is not expressly referred to in the Ordinance, a granted European patent in which the UK was designated and which was validated in the UK would theoretically also qualify as a UK patent.

### **Types of patents**

The Ordinance only provides for the registration in St Helena of a patent granted in the UK.

### **Patentable subject matter**

No provision.

### **Types of applications**

The Ordinance only provides for an application for the registration in St Helena of a granted UK patent.

### **Application**

Applications are filed with the St Helena Registrar of Patents.

Filing requirements:

- power of attorney (simply signed)
- two certified copies of the British Letters Patent document.

### **Applicant**

The application may be filed by the grantee of the UK patent, or by a person who has acquired the UK patent.

### **Novelty**

Granted UK patents must be confirmed in St Helena within three years of the date of grant thereof.



### **Convention priority**

No provision.

### **Examination/procedure**

There is no examination procedure in St Helena.

### **Opposition**

No provision.

### **Duration and maintenance**

The patent has the same duration as the granted UK patent and will remain in force while the UK patent is maintained. No maintenance fees payable directly in St Helena.

### **Restoration**

No provision is made for restoration.

### **Revocation**

The Supreme Court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration, to declare that the exclusive privileges and rights conferred by such certificate of registration have not been acquired on any grounds upon which the UK patent might be revoked under the law for the time being in force in the United Kingdom.

### **Assignments and licences**

Change in ownership and licence contracts will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

There is no working requirement, and no provision for compulsory licences.

### **Amendments**

Amendments can only be effected after the UK patent has been amended. The request for amendments must be accompanied by a copy of the specification as amended at the UK Patent Office, duly certified by the Comptroller-General of the UK Patent Office.

### **Effect of a patent**

A certificate of registration confers on the holder the privileges and rights, subject to all conditions under the law of St Helena, as though the patent had been issued with an extension to St Helena.

### **Infringement**

Specific provision is made that no action for infringement will be entertained in respect of manufacture, use or sale of the patented invention prior to the date of issue of the registration certificate in St Helena.

### **Working**

There is no working requirement and accordingly no provision for the grant of compulsory licences.

## **DESIGNS**

### **Law**

- United Kingdom Designs (Protection) Ordinance no 7 of 1930, Chapter 128 (as amended)

St Helena is not a member of any international treaty on designs.

### **Design protection**

A United Kingdom design registration extends automatically to St Helena. There is no provision for registration in St Helena.

### **Application**

There is no requirement for an application to register the UK design registration in St Helena.

### **Applicant**

The registered proprietor of the design in the UK enjoys the same rights in St Helena.

### **Duration and maintenance**

The protection in St Helena endures as long as the UK design registration remains in force.

### **Revocation**

The court in St Helena has the power, upon application of a person whose interests have been prejudiced, to declare the rights and privileges in St Helena to be cancelled on any ground on which the UK registration may be cancelled. Such grounds include the publication of the design in St Helena prior to the date of registration in the UK.

### **Rights conferred**

The registered proprietor of the UK design shall enjoy, in St Helena, the same rights and privileges as he enjoys in the UK.

### **Infringement**

The Ordinance provides that the proprietor of the design registration shall not be entitled to recover damages in respect of any infringement if the person can prove that, at the date of the infringement, he was not aware

and had no reasonable means of making himself aware of the existence of the design registration.

## **COPYRIGHT**

### **Law**

- Copyright Order no 1038 of 1963

St Helena is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent and surrounding islands is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Copyright protection**

The Copyright Order of 1963 provides that certain provisions of the UK Copyright Act, 1956 shall extend to St Helena. The provisions so extended include most substantive protection provisions.

The Order further provides that the UK Orders on international conventions shall extend to St Helena, subject to certain modifications.

The effect of these provisions appears to be that the protection of copyright works as provided in the UK, is extended to copyright works in St Helena, and furthermore, that the reciprocal recognition of copyright in terms of the Berne Convention also applies in St Helena.

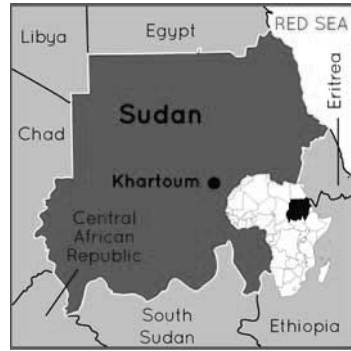
## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in St Helena.

# SUDAN

## GENERAL INFORMATION

Sudan was the largest country in Africa before the secession of South Sudan. Sudan is located in the northeast of Africa, with a short coastline on the Red Sea. On the land side the country is bordered by Egypt, Libya, Chad, Central African Republic, South Sudan and Ethiopia. The Nile river divides the country between east and west sides. The southern region of Sudan was granted autonomy in terms of a Peace Agreement; South Sudan seceded from the rest of the country in 2011.



Following the secession of South Sudan, the information set out below only applies to the northern part of the country, which retained the name Sudan.

<b>Area:</b>	1 886.068 km <sup>2</sup>
<b>Population:</b>	30.9
<b>Capital:</b>	Khartoum
<b>Currency:</b>	Sudanese Dinar
<b>GDP:</b>	\$ 123.6 billion (2011)
<b>Internet domain:</b>	.sd
<b>Languages:</b>	Arabic (official language), English
<b>Working week:</b>	Sunday - Thursday
<b>Exports:</b>	Cotton; sesame seed; meat; livestock; gum Arabic; sugar; oil and petroleum products
<b>Imports:</b>	Machinery and equipment; foodstuffs; manufactured goods; chemicals; textiles

## International/regional conventions

Sudan is a member of the following international/regional agreements:

- Berne Convention (since 2000)
- Harare Protocol (of ARIPO) (since 1984)
- Lusaka Agreement (ARIPO) (since 1978)
- Madrid Agreement on Marks (since 1984)
- Madrid Protocol on Marks (since 2010)
- Paris Convention (since 1984)
- Patent Cooperation Treaty (since 1984)
- WIPO Convention (since 1975)

## IP legislation

Trade marks

- Trade Marks Act no 8 of 1969
- Trade Mark Rules, 1969

Patents

- Patents Act no 58 of 1971
- Patent Regulations, 1981

## Designs

- Industrial Designs Act no 18 of 1974
- Industrial Design Regulations, 1999

## Copyright

- Copyright and Neighbouring Rights Protection Act no 54 of 1996

## TRADE MARKS

### Law

- Trade Marks Act no 8 of 1969
- Trade Mark Rules, 1969

Sudan is a member of the Paris Convention, and the Madrid Agreement and Protocol. Although Sudan is a member of ARIPO, it has not acceded to the Banjul Protocol.

Applications may be filed as national applications and, in appropriate circumstances, claiming convention priority in terms of the Paris Convention. Inasmuch as Sudan has not acceded to the Banjul Protocol, the Sudanese Trade Marks Act of 1969 does not provide for recognition of trade mark applications filed via ARIPO.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services. No express provision is made for defensive marks.

### Protection of well-known marks

The Act provides that a mark which constitutes a reproduction, an imitation, a translation or a transcription, likely to mislead the public, of a mark which is well known in the country and belongs to a third party, will not be registrable without the consent of the third party.

### Advantages of trade mark registration

The registration of a trade mark gives the owner the right to preclude third parties from certain acts relating to the use of the registered mark, and the right to institute court proceedings against third parties who infringe this right.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks.

### Definition of a trade mark

A trade mark is defined to mean any visible sign used or proposed to be used upon, in connection with or in relation to goods for the purpose of distinguishing the goods of a person from those of others. A trade mark may consist of any distinctive sign, including a word, name, pseudonym, device, brand, arbitrary or fanciful designation, heading, label, ticket, signature, letter, numeral, slogan, package, emblem, container or any combination thereof.

A service mark is defined to mean any visible sign used or proposed to be used to distinguish the services of a person from those of others.

### **Limitation to colour**

There is no provision regarding the use of colour.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A separate application is required for each class. No application may be made for marks for alcoholic products.

### **Convention priority**

Sudan is a member of the Paris Convention. An applicant who has applied for a trade mark in another convention country is entitled to a priority right, to be accorded the same date as the earlier application, provided that the application in Sudan is made within six months from the first-filed application.

### **Application**

An application is filed at the Industrial Property and Copyright Office in Arabic or English or, if not in either of these languages, then with a certified translation in Arabic or English.

The following information and documents are required:

- full particulars of the applicant
- power of attorney signed by the applicant (legalised), in Arabic
- certificate of incorporation, certificate of partnership registration, extract from an official commercial register, or such other document as shall satisfy the Registrar as to the nationality of the applicant (legalised)
- list of goods or services to be covered
- reproduction of the mark in the size prescribed
- certified copy of the priority document (if applicable), in English or Arabic.

### **Examination/procedure**

Prior to registration, the application will be subjected to formal and substantive examination. If the application meets the formal and substantive requirements for registration, it will be published for opposition purposes. The applicant will, if no oppositions are filed, or if an opposition is unsuccessful, be notified that the application has proceeded to grant.

Before the issue of a registration certificate, the applicant must furnish the Registrar with a declaration on oath that his nationality has not changed since the application for registration was lodged.

### **Opposition**

When an application is advertised as accepted, any interested person who is resident in Sudan may, within six months from the date of such advertisement, oppose the registration of the trade mark. Any person resident outside of Sudan may, within eight months from the date of

advertisement of an application, file with the Registrar an opposition. Extension of the opposition period is not possible.

### **Opposition proceedings**

The procedure for opposition involves the filing of a notice of opposition by the opponent, a copy of which must be sent by the Registrar to the applicant. The applicant must send to the Registrar a counter-statement of the grounds on which he relies for his registration. If the applicant does not file a counter-statement, he shall be deemed to have abandoned his application.

If the applicant files a counter-statement, the Registrar must furnish a copy thereof to the opponent.

The Registrar shall, after hearing the parties and considering the evidence, decide whether or not, and subject to what conditions, amendments, modifications or limitations, the registration is to be permitted. In any hearing before the Registrar, the evidence must be given by affidavit, but if the Registrar thinks it right to do so, he may take *viva voce* evidence.

The decision of the Registrar shall be subject to appeal to the court.

### **Grounds of opposition**

Both absolute and relative grounds of opposition are available. These include that:

- the trade mark is not entitled to registration under the provisions of the Act
- the mark has been obtained by fraud
- at the date of application, there was no *bona fide* intention to use the mark
- the applicant has effectively abandoned his mark.

The Act provides that the following cannot be validly registered as trade marks, namely marks which:

- consist of shapes or forms imposed by the inherent nature of the goods or by their industrial function
- consist exclusively of a sign or an indication which may serve, in the course of trade, to designate any particularity such as quality, quantity, purpose, value and place of origin
- have become, in the current language or in the *bona fide* and established practices of the trade of the country, a customary designation of the goods
- are contrary to morality or public order, or are calculated to deceive or confuse trade circles or the public as to the nature, the source, the manufacturing process, the characteristics or the suitability for their purpose, of the goods concerned
- reproduce or imitate armorial bearings, flags and other emblems, initials, names, official signs or hallmarks of any state or intergovernmental international organisation (unless authorised by the competent authority of the state or international organisation)
- are identical with or similar to emblems of exclusively religious, sectarian or tribal organisations

- resemble or depict the portrait of a religious or tribal leader or a person of any sectarian significance
- resemble, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a person claiming priority, in respect of the same goods or other goods in connection with which use might be likely to mislead the public
- constitute a reproduction, in whole or in part, an imitation, a translation, or a transcription, likely to mislead the public, of a mark which is well known in the country and belongs to a third party
- infringe other third party rights or are contrary to the rules for the prevention of unfair competition.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years from the date of filing, and is thereafter renewable for similar periods subject to payment of the prescribed fee. A grace period of six months is allowed for such payment, provided that a penalty is paid.

### **Cancellation/removal of a trade mark**

Any interested person may apply in the prescribed manner to the Registrar to remove a mark from the register.

### **Grounds for cancellation/removal of a trade mark**

The cancellation of the registration of a trade mark may be ordered by the court on the request of any interested person or the Registrar if:

- the mark was not entitled to registration under the provisions of the Act (same as grounds of opposition), provided that grounds which no longer exist at the time of the decision shall not be taken into account
- the trade mark has been obtained by fraud
- the mark has, without legitimate reason, not been used in the Republic of Sudan after registration during five consecutive years preceding the allegation of non-use. The burden of proof regarding the allegation of non-use of the mark shall be decided by the court according to the circumstances of the case.

### **Use requirement**

A trade mark registration is vulnerable to cancellation if the registered mark has not been used within a period of five years from the date of registration, unless the owner of the mark proves that legitimate reasons for non-use exist.

### **Assignment**

Assignments are possible. Assignment may be made with or without the goodwill of the business and in respect of some or all of the goods or services covered by the registration. The assignment must be recorded within a period of six months from the date of the assignment instrument and upon payment of the prescribed fee. Failure to record the assignment will result in the assignment being null and void.



Requirements for recordal:

- power of attorney from the assignee (legalised)
- deed of assignment
- if the applicant is a company, an extract from the commercial register or a copy of the certificate of incorporation (legalised)
- original registration certificate required for endorsement purposes.

#### **Licensing/registered users**

Where a trade mark is used with the consent of the registered proprietor, such use is deemed to be use by the registered proprietor, provided that:

- control is exercised by the proprietor over the nature and quality of the goods
- the trade mark is not used in such a manner as to deceive the public.

A licence agreement must be recorded within a period of six months. Failure to do so will result in the licence being null and void.

Requirements for recordal:

- power of attorney from the licensor (legalised)
- licence agreement
- certified copy of the certificate of incorporation of the licensee (legalised).

#### **Amendment**

The Trade Marks Act is silent on the issue of the amendment of a trade mark application and registration by the applicant/proprietor.

#### **Rights conferred by registration**

Registration of a trade mark confers upon the registered owner the right to preclude third parties from the following acts:

- any use of the trade mark, or of a sign resembling it in such a way as to be likely to mislead the public, for goods in respect of which the mark is registered, or for other goods in connection with which the use of the mark or sign is likely to mislead the public
- any other use of the mark, or of a sign or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interest of the registered owner of the mark.

The registered owner also has the right to institute proceedings against parties who infringe his rights, and to recover damages.

#### **Trade mark infringement**

Proceedings for infringement can be brought by the owner of a trade mark before the court. The fact that a person is registered as the owner of a trade mark shall be *prima facie* evidence of the validity of the registration. The court may, however, admit evidence of the usages in the trade in respect of the get-up of goods for which the trade mark is registered.

**Defences to trade mark infringement**

No registration under the Act shall interfere with any genuine use by a person of his own name or place of business, or that of any of his predecessors in business, or the use by any person of any genuine description of the character or the quality of his goods.

**Relief for trade mark infringement**

In addition to relief in civil proceedings, the Act provides that any person who, with intent to deceive, commits or attempts to commit, aids or abets any other person in committing any of the acts listed below, shall be guilty of an offence and shall be liable upon conviction to imprisonment or to a fine or both.

The listed acts include the following:

- to use a trade mark duly registered by another person under the Act, or an imitation of such trade mark, for goods in respect of which the mark is registered
- to sell, store for the purpose of sale, or expose for sale goods bearing a mark the use of which is an offence
- to use a mark duly registered by another person under the Act for the purpose of advertising in the public press or in any other manner, goods in respect of which the mark is registered
- to mark, engrave, print, or sell, any plate, dye, block or other representation of a mark duly registered by another person, or any imitation thereof, for the purpose of enabling another person to make use of such mark which is an offence
- to mark, pack or wrap, sell, store for the purpose of sale, or expose for sale, goods packed, wrapped or otherwise prepared so as to lead intending purchasers to believe that they are goods of another manufacturer
- to make direct or indirect use of a false or deceptive indication of the origin, or to imitate an indication of origin even if the true origin of the product is indicated, or if the indication of origin is accompanied by terms such as 'kind', 'type', 'make', 'imitation' or the like
- to import any goods bearing a mark which would constitute an infringement of a duly registered mark, or to import goods so wrapped, packed or prepared as to enable such goods to be passed off as the goods of another manufacturer.

Nothing in the Act affects the right to bring an action against any person for unfair competition in respect of his trade.

**Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg 'Regd. Tm.') or symbol ® is optional.

## PATENTS

### Law

- Patent Law no 58 of 1971
- Patent Regulations, 1981

Sudan is a member of the Paris Convention, ARIPO (Harare Protocol), and the PCT.

### Patent protection

Patent protection is available via a national filing or via an ARIPO application designating Sudan. Sudan has not yet implemented the Harare Protocol (which regulates patent and design filings in ARIPO). Accordingly, there is uncertainty regarding the enforceability of rights obtained through the filing of an ARIPO application designating Sudan.

Although it is possible to file PCT national phase applications in Sudan, the national law has not yet been amended to cater for the PCT. Accordingly, it is not clear whether enforceable rights will be obtained via PCT national phase filings in Sudan.

### Types of patents

The Act provides for patents for inventions, and also for divisional patents where an initial application covers more than one invention. A divisional patent is entitled to the filing date, or priority date, of the initial application.

### Patentable subject matter

An invention is patentable if it is new, involves an inventive step and is industrially applicable. An invention which constitutes an improvement on an already patented invention shall also be patentable, if it is new, involves an inventive step and is industrially applicable.

Principles and discoveries of a scientific nature are not considered to be inventions. Patents may also not validly be obtained for inventions the publication or working of which would be contrary to public order or morality.

### Types of applications

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Sudan is designated (see the section on **Patent protection** above)
- an ARIPO application designating Sudan
- a divisional application, where the original application covers more than one invention.

**Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Sudan Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- declaration or assignment by the inventor (if applicable)
- specification (including claims, drawings and abstract), in English with Arabic translation
- certified copy of the priority document (if applicable)
- international preliminary report on patentability (for PCT applications)
- certified copy of the certificate of incorporation of the applicant company and its articles of incorporation (legalised; not required for a PCT application).

**Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

**Novelty**

An invention is considered new if it is not anticipated by prior art.

Absolute novelty is required. Prior art is constituted by everything disclosed to the public, anywhere and at any time whatsoever, by means of written or oral disclosure, by use or in any other way before the filing or priority date. However, a grace period of six months is provided where the invention was exhibited by the inventor or his successor at an officially recognised international exhibition.

**Convention priority**

Sudan is a member of the Paris Convention and the Act provides that an application may contain a declaration claiming priority of an earlier application in a convention country.

**Examination/procedure**

Applications are subjected to formal examination only.

**Opposition**

No provision.

**Publication**

The Act provides that, where the Registrar grants a patent, the Registrar shall publish a reference to the grant of the patent in the Gazette.

**Duration and maintenance**

The term of a patent is 20 years from the filing date, subject to payment of annual fees. A grace period of six months is allowed for the late payment of the annual fee, subject to payment of surcharges. Failure to pay the renewal fee causes the patent to lapse.

**Restoration**

No provision.

**Revocation**

Any interested party may request the court to invalidate a patent on the basis of non-compliance with formal and substantive requirements. The grounds for invalidation include the following:

- that the subject matter of the patent is not patentable as required by the Act
- that the description of the invention or claims do not satisfy the requirements
- that a patent has already been granted in Sudan for the same invention on a prior application.

**Assignments and licences**

Changes in ownership (assignments) and licence contracts will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney (notarised)
- deed of assignment (legalised); or
- licence agreement (legalised).

**Amendments**

The applicant may ask the Registrar to correct any written error in the patent application, the description, the patent or in any statement mentioned in the patent register.

**Compulsory licences**

Any interested person may approach the court to grant a compulsory licence on the basis that the invention has not been worked in Sudan, or that the patentee refuses to grant licences on reasonable terms. At any time after the expiration of four years from the date of the application, or three years from the date of grant, whichever period expires last, an interested person may apply for a compulsory licence on the following grounds:

- that the patented invention, capable of being worked in Sudan, has not been worked
- that the working of the patent does not meet the demand for the product on reasonable terms
- that the working of the patent in Sudan is being hindered by importation
- that, by reason of the refusal of the owner to grant licences, industry or commerce in Sudan is unfairly prejudiced.

### **Rights conferred by of a patent**

A patent shall confer on the registered owner the right to preclude other parties from the following acts:

- making, importing, offering for sale, selling or using the patented product
- stocking such product for purposes of sale
- applying the patented process
- doing any of the above acts in respect of the product of the patented process.

The rights of the patent owner only extend to such acts done for commercial purposes.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include an injunction, damages, seizure and destruction of the infringing products.

International infringements may also constitute offences, punishable by a fine or imprisonment.

### **Working**

A granted patent must be worked within four years from the date of filing of the patent application, or three years from the date of the grant of the patent, whichever period expires last. Failure to work makes the patent vulnerable to compulsory licences (see the section on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Industrial Designs Act no 18 of 1974
- Industrial Design Regulations, 1999

Sudan is a member of the Paris Convention and the ARIPO (Harare Protocol).

### **Design protection**

Design protection is available by way of a national filing or via an ARIPO application designating Sudan. As mentioned above, Sudan has not yet implemented the Harare Protocol (which regulates patent and design filings in ARIPO). Accordingly, there is uncertainty regarding the enforceability of rights obtained through the filing of an ARIPO application designating Sudan.

### **Registrable subject matter**

An industrial design is defined to mean any composition of lines or colours formed to give a special appearance to any industrial or hand-made product or any plastic form, whether or not it is restricted to colour, on condition that the form or composition can be used as an industrial design or a handicraft design.

Designs which serve solely to obtain a technical result are excluded from protection, as are designs which are against the public interest or morals.

### **Classification of designs**

No provision.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Sudan Design Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed and stamped, or notarised)
- certificate of incorporation of the applicant (legalised)
- verified translation into Arabic of the contents of the application and its enclosures (legalised)
- photographic picture or sketch drawings of the industrial design, in colour if possible, or an architectural model or any other means of representation
- full description of the design in Arabic, including details of the materials from which the design is made
- the approximate dimensions (length, height and width) of the article in any units, eg inches, mm, etc
- certified copy of the priority application (if applicable).

### **Applicant**

The creator of the design may apply, or his successor in title.

### **Convention priority**

Sudan is a member of the Paris Convention. Accordingly, priority can be claimed, provided the application in Sudan is filed within six months from the first-filed application in a convention country.

### **Novelty**

Only new designs shall enjoy the protection under the Act. Absolute novelty is required. A design shall be considered new if it was not available to the public at any place and by any means, before the date of application.

However, a grace period of six months immediately preceding the Sudan filing date is allowed, where the design was exhibited by the author or his successor at an official or officially recognised international exhibition.

### **Examination/procedure**

Applications are subjected to formal examination only.

## **Opposition**

No provision

## **Duration and maintenance**

The initial term of the design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. A grace period of six months is allowed for the late payment of the renewal fee, subject to payment of surcharges. Failure to pay the renewal fees causes the design registration to lapse.

## **Restoration**

No provision.

## **Revocation**

Any person with a legal interest may approach the court to declare a design registration void if it did not comply with the requirements of the Act, eg if the applicant was not entitled to apply, or if the design was not new, or if it was contrary to public interest or morals.

## **Assignments and licences**

Changes in ownership (assignments) and licence contracts must be recorded at the Registrar's office.

Requirements:

- power of attorney (notarised)
- deed of assignment (legalised)
- licence agreement (legalised).

## **Compulsory licences**

No provision.

## **Effect of a design registration**

The registration of a design gives the owner the right to prevent other persons from doing the following:

- using the design in the manufacture of a commodity
- importing a commodity embodying the design, or exhibiting it for sale, or selling or using it
- stocking the commodity for purposes of sale.

The owner also has the right to institute legal proceedings against persons who infringe his rights.

## **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include an injunction and damages. Intentional infringement also constitutes an offence punishable with a fine or imprisonment or both.

## **Marking**

Not required.



## COPYRIGHT

### Law

- Copyright and Neighbouring Rights Protection Act no 54 of 1996

Sudan is a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

The Act provides protection, without any formality, to any original intellectual work in the field of literature, science or arts, and whatever the manner of expression, including the following:

- written works such as books, magazines, periodicals, articles
- works of fine art such as sculpture, drawing, painting, decoration, works of applied art, works of artistic craftsmanship
- dramatic and dramatic-musical works, musical works with or without lyrics, musical and dancing plays, shows which are performed by movements or steps
- audiovisual works
- photographic works
- works of architecture
- computer programs
- electronic data banks
- all kinds of maps and sketches relative to topography, geography or science.

Copyright also extends to derivative works, such as –

- translations, adaptations, arrangements and transformations of works
- collections of protected works or non-protected materials, provided they constitute the result of intellectual effort.

Protection does not extend to:

- works that have fallen in the public domain
- official documents
- daily news published in newspaper, magazines or periodicals or broadcast
- ideas, methods, state emblems and symbols.

National folklore is deemed to be the property of the State.

### Registration of copyright

Although registration is not a requirement for the subsistence of copyright, the Act provides for the establishment of a general register to be kept by the Registrar; application for registration of works is optional. The register shall serve as *prima facie* proof of the creation and authorship of copyright

works. Registration of contracts for the transfer of the author's economic rights is obligatory.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author of a work must be a national of Sudan, or the work of a foreign author must be first published in Sudan. Works of nationals of Sudan that are first published in another country will also be protected; also unpublished works by nationals of Sudan or foreigners who are resident in Sudan.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. The ownership of copyright in a work thus initially vests in the author, and comprises economic rights and moral rights. Both the economic rights and the moral rights may be transferred.

The economic rights afford the owner the exclusive right to do or to authorise others to do the following:

- to publish, produce or reproduce the work
- to distribute the work, or make it available to the public on a commercial basis
- to perform the work in public
- to broadcast the work, including through broadcasting satellites
- to communicate the work to the public by wire, including cable, optical fibre and other material carriers
- to make a translation of the work
- to make an adaptation, arrangement or transformation of the work
- to commercially exploit the work.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be recognised and acknowledged as the author, the right to publish the work and to withdraw the work from circulation, and the right to object to distortion or mutilation or alteration of the work. The moral rights exist for the life of the author and may be transferred during the life of the author.

### **Duration of copyright**

In the case of most works (except those listed below) the economic rights of copyright endure for the lifetime of the author plus 50 years.

In the case of the works listed below, the duration is 25 years from the date on which the work was made or was made available to the public:

- photographs, cinematograph films, audiovisual works
- works published for the first time after the author's death
- works published under a pseudonym or anonymously.

The moral rights exist only for the life of the author.

**Exceptions to copyright protection**

The following acts are amongst a list of acts excluded from the rights of the owner:

- publication of a quotation, summary or announcement for purposes of analysis, study, culture, information
- reproduction of essays or lectures or speeches on political, economic, scientific or religious discussions
- use for purposes of quotation or illustration, with acknowledgment of the work and the author
- the doing of certain acts for purposes of private use
- reproduction of copies for restoration purposes in public libraries or archives
- certain usages for teaching purposes in educational institutions
- use for purposes of current information, judicial proceedings.

**Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. Assignments and exclusive licences must be recorded in the register.

**Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imitates, sells, distributes or imports an article which he knows to be an infringing article for commercial purposes.

**Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, attachment of infringing articles, etc.

**Criminal offences**

Certain infringing acts constitute criminal offences.

**PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Sudan.

# SOUTH SUDAN

## GENERAL INFORMATION

South Sudan was formed when the southern-most states of Sudan seceded, being Bahr el Ghazal, Equatoria and Upper Nile as well as the Abyei Area. The secession was as an outcome of a peace deal. South Sudan is bordered by Sudan in the north, Central African Republic in the west, the DRC in the southwest, Uganda and Kenya in the south, and Ethiopia in the east. South Sudan gained its independence in 2011.



<b>Area:</b>	619 745 km <sup>2</sup>
<b>Population:</b>	9.7 million
<b>Capital:</b>	Juba
<b>Currency:</b>	South Sudan pound
<b>GDP:</b>	\$ 13 billion (2010)
<b>Internet domain:</b>	.ss
<b>Languages:</b>	English, Arabic (both official), Juba Arabic, Dinka
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Oil, timber, agricultural products
<b>Imports:</b>	Consumer goods

## International/regional conventions

When South Sudan was still part of Sudan, it enjoyed membership of several international conventions. However, until the Government of South Sudan deposits instruments of accession and ratifies the various agreements, they will no longer extend to South Sudan.

## IP legislation

The Transitional Constitution of South Sudan states that all current laws of Sudan shall remain in force, and all current institutions shall continue to perform their functions and duties unless new actions are taken in accordance with the provisions of the constitution. It must be assumed that such new actions probably envisage the promulgation of domestic legislation by the South Sudanese legislature. The current Sudanese intellectual property legislation, which will for the time being continue to apply in South Sudan, is as follows:

### Trade marks

- Trade Marks Act no 8 of 1969
- Trade Mark Rules, 1969

### Patents

- Patents Act no 58 of 1971
- Patent Regulations, 1981

#### Designs

- Industrial Designs Act no 18 of 1974
- Industrial Design Regulations, 1999

#### Copyright

- Copyright and Neighbouring Rights Protection Act no 54 of 1996

According to the Transitional Constitution, it would appear that intellectual property rights in South Sudan are regulated in terms of the abovementioned Sudanese Laws. Please refer to the chapter on **SUDAN** for further information with regard to the various laws and procedures.

In practice, South Sudanese authorities have not yet considered protection in terms of the Sudanese Patent and Designs Act, but to some extent are allowing the filing of trade mark applications. However, in contrast to the requirements of the 1969 Sudan Trade Marks Act, the authorities are following a deposit system: provided a notarised power of attorney together with a certified copy of the applicant company's certificate of incorporation are submitted, the application will be processed. Although official fees are being requested, the amounts appear to differ and are not strictly regulated. It would appear that the Ministry of Justice is considering whether to formally adopt the workings of the 1969 Trade Marks Act until such time as a new law is promulgated.

Sudanese registrations do not extend to South Sudan and cover only the territory of 'North' Sudan.

# SWAZILAND

## GENERAL INFORMATION

The Kingdom of Swaziland is a former British protectorate which became independent in 1968. Swaziland is a landlocked country bordered on the north, west and south by South Africa, and on the east by Mozambique.



<b>Area:</b>	17 364 km <sup>2</sup>
<b>Population:</b>	1.4 million
<b>Capital:</b>	Mbabane
<b>Currency:</b>	Lilangeni
<b>GDP:</b>	\$ 6 billion (2010)
<b>Internet domain:</b>	.sz
<b>Languages:</b>	English, Swazi (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Soft drink concentrates; sugar; wood pulp; cotton yarn; citrus and canned fruit; refrigerators
<b>Imports:</b>	Motor vehicles; machinery; transport equipment; foodstuffs; petroleum products; chemicals

## International/regional conventions

Swaziland is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1997)
- Berne Convention (since 1998)
- Harare Protocol (of ARIPO) (since 1988)
- Lusaka Agreement (ARIPO) (since 1987)
- Madrid Agreement on Marks (since 1998)
- Madrid Protocol on Marks (since 1998)
- Paris Convention (since 1991)
- Patent Cooperation Treaty (since 1994)
- WIPO Convention (since 1988)
- WTO/TRIPS (since 1995)

## IP legislation

Trade marks

- Trade Marks Act no 6 of 1981
- Trade Marks Regulations, 1989
- Merchandise Marks Act, 1937
- Merchandise Marks Regulations, 1937

Patents

- Patents and Designs Proclamation of 1955
- Patents, Utility Models and Industrial Designs Act no 6 of 1997

**Note:** The 1997 Act on Patents, Utility Models and Designs is not yet in force as it is still awaiting parliamentary approval and implementing regulations. This chapter is therefore based on the provision of the 1955 Proclamation.

## Designs

- Patents and Designs Proclamation of 1955
- Patents, Utility Models and Industrial Designs Act no 6 of 1997

**Note:** The 1997 Act is not yet in force as it is still awaiting parliamentary approval and implementing regulations. This chapter is therefore based on the provision of the 1955 Proclamation.

## Copyright

- Copyright Act no 36 of 1912
- Copyright (Rome Convention) Act, 1933
- Copyright (Prohibited Importation) Act, 1918

## Related areas

- Seeds and Plant Varieties Act, 2000

## TRADE MARKS

### Law

- Trade Marks Act no 6 of 1981
- Trade Marks Regulations, 1989
- Merchandise Marks Act, 1937
- Merchandise Marks Regulations, 1937

Swaziland is a member of the Paris Convention, ARIPO (Banjul Protocol), the Madrid Agreement and Protocol, and the WTO/TRIPS.

**Note:** Although Swaziland is a member of ARIPO (Banjul Protocol) and the Madrid Agreement and Protocol, Swaziland does not yet have enabling legislation. The relevant provisions to implement these filing systems are, therefore, not yet in place. However, it is possible that ARIPO applications designating Swaziland will be recognised, as would be applications under the Madrid Agreement and/or Protocol designating Swaziland.

### Trade mark protection

The Act provides for the protection of marks, including a series of marks and parts of marks.

### Protection of well-known marks

No express provision.

### Advantages of trade mark registration

The registration of a trade mark gives to the owner the exclusive right to the use of the trade mark in relation to the relevant goods or services, and the right to institute proceedings in the case of infringement.

### Types of trade marks

Provision is made for the registration of:

- trade marks for goods and services
- series of trade marks
- parts of trade marks.

**Definition of a trade mark**

A trade mark is defined as any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing, in the course of trade or business, the goods or services of a person from those of another.

A visible sign is defined to mean any sign which is capable of graphic reproduction, including a word, name, brand, device, heading, label, ticket, signature, letter, number, relief, stamp, seal or emblem, or any combination thereof.

**Parts of and series of trade marks**

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part of the mark, he may apply to register any such parts as separate trade marks, and each such part will constitute a separate trade mark.

Similarly, where a person claims to be the proprietor of several trade marks to be used for the same or closely related goods or services, he may apply to register those marks as a series of marks in one registration.

**Limitation to colour**

A trade mark may be limited in whole or in part to one or more specified colours. Where there is no limitation as regards colour, the mark is deemed to be registered for all colours.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. Swaziland follows a multi-class filing system, which means a single application may cover more than one class.

**Convention priority**

The Act provides for the claiming of convention priority in Swaziland. The Swaziland application must be filed within six months of the priority filing date, and a certified copy of the priority application must be filed within three months of the date of filing of the Swaziland application.

**Application**

An application for registration of a trade mark is filed with the Registrar of Trade Marks, which operates under the Ministry responsible for Justice.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- reproductions of the mark
- certified copy of priority document (if applicable).

**Examination/procedure**

An application is examined as to formalities, as to its inherent registrability, and possible conflict with prior registrations or pending applications.



**Opposition**

Once accepted, an application is published for opposition purposes. Opposition may be lodged within three months from the date of advertisement of the application in the Official Gazette. The Registrar is empowered to grant extension of this period.

**Opposition proceedings**

The notice of opposition must be given in writing within three months from the date of the advertisement of the application. The Registrar will send a copy of the notice of opposition to the trade mark applicant. The trade mark applicant must submit to the Registrar a counter-statement of the grounds on which he relies for his application, within two months from receipt of the notice of opposition. If the applicant fails to submit a counter-statement, the trade mark application shall be deemed to have been abandoned.

The Registrar must provide the opponent with a copy of the counter-statement. Within two months, the opponent must file with the Registrar evidence by way of statutory declaration in support of his opposition. The Registrar must provide the trade mark applicant with a copy of the statutory declaration. If the opponent does not file evidence within the period specified, he shall, unless the Registrar directs otherwise, be deemed to have abandoned his opposition. The applicant must, within two months of receipt of the evidence, file with the Registrar evidence by way of statutory declaration in support of his application. The registrar must send a copy to the opponent.

Within two months of receipt of the copy of the applicant's evidence, the opponent may file with the Registrar evidence strictly confined to matters in reply. The Registrar must send a copy to the applicant.

Upon completion of the evidence, the Registrar shall give at least two months' notice to the parties of the date when he will hear the case. If the Registrar fails to notify the parties of a date for the hearing within three months of the completion of the evidence, the parties may elect to refer the matter to the court for hearing and determination. The Registrar shall then transmit all relevant documents to the court.

**Grounds for opposition**

Any person may, within the time prescribed from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration on the following grounds, namely that:

- the use of the trade mark would be contrary to law or morality or would be likely to deceive or cause confusion as to the nature, geographical or other origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services concerned
- the trade mark consists solely of the shape, configuration or colour of the goods or the containers thereof
- the trade mark is identical with, or imitates the armorial bearings, flags and other emblems, or official sign or hallmark of any state or of any

intergovernmental international organisation, unless authorised by the competent authority

- the trade mark constitutes a reproduction, in whole or in part, an imitation or transcription, liable to create confusion, of a trade mark or business or company name which is well known in Swaziland and belongs to a third party.

In addition to the grounds referred to above, the following also constitute grounds for the purpose of opposition:

- where the trade mark resembles, in such a way as to be likely to deceive or cause confusion, an unregistered trade mark used earlier in Swaziland by a third party in relation to the same or closely related goods or services, provided that an application for the registration of the earlier unregistered trade mark is filed at the same time as the notice of opposition
- where the trade mark resembles, in such a way as to be likely to deceive or cause confusion, a business or company name used in Swaziland by a third party
- where the trade mark is filed by the agent of the representative of a third party who is the proprietor of the trade mark in another country, without the authorisation of such proprietor.

#### **Duration and renewal**

A trade mark registration is effective for a period of 10 years from the date of filing of the application and, thereafter, is renewable for like periods, provided the registrant submits a statement confirming use of the trade mark in Swaziland during the preceding three years or that special circumstances prevented use of the trade mark.

#### **Cancellation/removal of a trade mark**

A registered trade mark may be removed from the Register in respect of any of the goods or services in respect of which it is registered, on application by any aggrieved person to the Registrar on the ground that up to one month prior to the filing of the application, a continuous period of three years or longer has elapsed during which the registered proprietor has not used the trade mark in relation to those goods or services.

Failure to use the trade mark shall not be taken into account where:

- it is attributable solely to special circumstances preventing use of the trade mark, and not to any intention to abandon or not to use the trade mark
- the non-use is within five years from the date of the registration.

For the purposes of expungement:

- the use of the whole of a registered trade mark shall be deemed to be equivalent to the use of any part thereof registered in the name of the same proprietor
- where a trade mark has been used in relation to some of the goods or services in respect of which it is registered, such use shall be deemed to be in relation to all closely related goods or services

- where a trade mark is applied to goods or services to be exported from the country, such use shall be deemed to be use of the trade mark in Swaziland
- the use of the trade mark with additions or alterations not substantially affecting its identity, may be accepted as use of the trade mark.

Any person aggrieved by the non-insertion in or omission from the Register of an entry, or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may apply to the Registrar to make, expunge or vary the entry.

The Registrar may also make such order as he may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of a condition entered on the Register in relation thereto.

### **Use requirement and cancellation**

A registered trade mark may be removed from the register on the ground that up to one month prior to filing the application for cancellation, the trade mark had not been used for a continuous period of three years or longer (see the section on **Cancellation/removal of a trade mark** above).

### **Assignment**

Assignments are possible and may be made with or without the goodwill of the business. The assignment must be recorded in the register in order for it to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment.

### **Licensing/registered users**

The Act provides for registration of a person as a registered user of a trade mark. Recording of the registered user agreement is required to be effective against third parties. Such agreements must provide for effective quality control by the registered proprietor.

Requirements for recordal:

- power of attorney from the proprietor (simply signed)
- power of attorney from the user (simply signed)
- registered user agreement.

### **Amendment**

The Act provides for rectification and amendment of applications and registrations and the alteration of registered trade marks, provided an alteration does not substantially affect the character of the trade mark.

Requirements for amendment:

- power of attorney (simply signed)
- certificate of change of name, if applicable.

**Rights conferred by registration**

The registration of a trade mark gives to the owner the exclusive right to use the mark in relation to the relevant goods or services, and to authorise other persons to use the mark. The registered owner also has the right to institute proceedings against persons who use the mark without his authority.

**Trade mark infringement**

The Act provides that no person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark. (However, nothing in the Act shall affect rights of action for passing-off.)

Subject to any limitation or condition entered in the Register, the registration of a trade mark gives the registered proprietor thereof the exclusive right to the use of the trade mark in relation to the goods or services in respect of which it is registered, including sale, importation and offer for sale or importation.

The exclusive right referred to above will be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, uses a sign that is:

- identical with or so nearly resembling the registered mark as to be likely to deceive or cause confusion, in the course of trade, in relation to goods or services in respect of which the mark is registered or closely related goods or services, and in such manner as to render the use of the sign likely to be taken –
  - as being used as a trade mark or business or company name, or
  - in a case in which the use is on the goods or in relation to services, or in an advertising circular or other advertisement, as importing a reference to some person having the right either as proprietor or as a registered user to use the trade mark
- identical with or nearly resembling the registered mark in the course of trade in any manner likely to impair the distinctive character or acquired reputation of the trade mark.

The exclusive right referred to above will also be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, does any of the following acts in the course of trade in respect of goods purchased from the proprietor of the trade mark or a registered user:

- applying the trade mark upon the goods after they have undergone alteration as regards their state or condition, get-up or packaging
- where the trade mark is upon the goods, altering or obliterating it
- where the trade mark is upon the goods and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, removing or obliterating the trade mark unless that other matter is wholly removed or obliterated
- where the trade mark is upon the goods, applying any other trade mark to the goods or adding to the goods any other matter in writing that is likely to injure the acquired reputation of the trade mark.

### **Defences to trade mark infringement**

A trade mark registration is not infringed by use of such trade mark by any person:

- in relation to goods connected in the course of trade with the proprietor or a registered user, if the proprietor or the registered user has applied the trade mark and has not subsequently removed or obliterated it or has expressly or impliedly consented to such use of the trade mark
- in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been registered, if the use of the trade mark is reasonably necessary
- in relation to goods which have been sold or offered for sale in Swaziland under the trade mark by the proprietor or with his consent, unless the condition of the goods is modified or impaired after they have been sold or offered for sale.

The proprietor of a registered trade mark is not entitled to interfere with the use by any person of a (unregistered) trade mark identical with or nearly resembling the registered trade mark, in relation to goods or services in relation to which that person has continuously used that (unregistered) trade mark from a date anterior to the registration of the trade mark or the commencement of the use of the mark by the proprietor.

The registered proprietor may also not object to that person being put on the Register for that identical or nearly resembling trade mark in respect of the same or closely related goods or services.

No registration of a trade mark shall interfere with:

- the *bona fide* use by any person of his own name or of the name of the geographical location of his business, or of the name of any of his predecessors in business
- the use by any person of any *bona fide* description of the character of quality of his goods or services, not being a description that would be likely to be taken as importing a reference to some person having the right either as proprietor or as a registered user to use the trade mark, or to goods or services of such person.

### **Relief for trade mark infringement**

The Act does not contain a specific provision that deals with the relief for trade mark infringement. However, since the Act does stipulate that the proprietor of a registered trade mark has the exclusive right to use the trade mark in relation to the relevant goods or services, it is expected that the proprietor would be entitled to an interdict (injunction) ordering the respondent to refrain from further unauthorised use.

### **Common law rights**

It is provided that nothing in the Act shall give the proprietor of a registered trade mark the right to interfere with the use by another person of a similar mark where such other person has continuously used the similar mark from an earlier date even though not registering the mark (see the section on **Defences to trade mark infringement** above).

**Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or a suitable abbreviation or the symbol ® is optional.

**PATENTS****Law**

- Patents and Designs Proclamation of 1955
- Patents, Utility Models and Industrial Designs Act no 6 of 1997

**Note:** As indicated above, the 1997 Act is not yet in force as it is still awaiting parliamentary approval and implementing regulations. This chapter is therefore based on the provision of the 1955 Proclamation.

Swaziland is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

**Patent protection**

Swaziland has not yet implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, and the current national law does not provide for filings under the PCT and for priority claims. Accordingly, although Swaziland is a member of ARIPO, it seems that patents registered via an ARIPO application designating Swaziland may not be recognised. Furthermore, it is not possible to file a PCT national phase application, or a convention or non-convention application directly in Swaziland.

At present, therefore, patent protection is available by way of the extension of a United Kingdom granted patent, and the registration of a South African granted patent, while the validity of an application via ARIPO is uncertain.

**Note:** The 1997 Act, which is not yet in operation, provides for ARIPO applications designating Swaziland. Although the Act refers to the PCT, there are no specific provisions for PCT applications.

**Patentable subject matter**

There is no provision in the current Proclamation of 1955 to define patentable subject matter.

**Types of applications**

Patent protection may be obtained by way of –

- automatic extension of a UK granted patent
- registration of a South African granted patent
- an ARIPO application designating Swaziland (see the section on **Patent protection** above).

**Application**

Applications for registration of granted South African patents are filed with the Registrar's office. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Swaziland Patent Office, in which case they must be transmitted to the ARIPO office for processing.

Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Granted UK patents extend automatically to Swaziland; no registration is required.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- certified copy of the granted South African patent.

### **Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention from the inventor.

### **Novelty**

The 1955 Proclamation is silent regarding novelty requirements.

### **Convention priority**

Swaziland is a member of the Paris Convention. However, the current applicable national law (1955 Proclamation) does not provide for the Convention. Accordingly, it is not possible to file a convention application directly in Swaziland, claiming convention priority.

### **Examination/procedure**

Applications are subjected to formal examination only.

### **Opposition**

No provision.

### **Duration and maintenance**

A patent registered based on a granted South African patent will remain in force for the period for which the South African patent remains in force, subject to the payment of renewal fees, and subject to the South African patent being renewed.

The extension of a UK patent remains in force as long as the UK patent remains in force.

### **Restoration**

No provision.

### **Revocation**

Any interested party may request the court to invalidate a patent, or claim or part of a claim, on the basis that the invention was used or published in Swaziland prior to the priority date of the application.

### **Assignments/licences**

Assignments and voluntary licences are recognised. Change in ownership and licence contracts will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement
- certificate issued by the South African Patent Office confirming the assignment or licence of the corresponding South African patent.

### **Compulsory licences**

No provision.

### **Amendments**

No provision.

### **Effect of a patent**

The registration of a South African patent in Swaziland gives the owner the right to authorise use and exploitation of the patented invention in Swaziland, and the right to institute proceedings in the case of infringement.

The owner of a UK patent (which extends automatically to Swaziland) would have similar rights.

### **Infringement**

Infringement proceedings may be brought in a competent court for an appropriate remedy, including damages and an interdict.

### **Marking**

No provision.

### **Working**

No provision.

## **DESIGNS**

### **Law**

- Patents and Designs Proclamation of 1955
- Patents, Utility Models and Industrial Designs Act no 6 of 1997

**Note:** As indicated above, the 1997 Act is not yet in force as it is still awaiting parliamentary approval and implementing regulations. This chapter is therefore based on the provision of the 1955 Proclamation.

Swaziland is a member of the Paris Convention, ARIPO (Harare Protocol), and the WTO/TRIPS.

### **Design protection**

Design protection is available by the automatic extension of a United Kingdom registered design, or by way of the registration of a South African registered design. Although Swaziland is a member of ARIPO (Harare Protocol), it has not



yet implemented the Harare Protocol in its national law. Therefore, it is not clear whether a design registered via ARIPO and designating Swaziland will be recognised in Swaziland.

As indicated above, the 1997 Act (which is not yet in operation) provides for ARIPO applications.

**Registrable subject matter**

No provision.

**Classification of designs**

No provision.

**Types of applications**

As indicated above, design protection may be obtained by way of –

- automatic extension of a UK design registration
- registration of a South African design registration
- an ARIPO application designating Swaziland (see the section on **Design protection** above).

**Application**

Applications for registration of South African designs are filed with the Registrar's office. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Swaziland Design Office in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

UK design registrations automatically extend to Swaziland.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- certified copy of the registered South African design.

**Applicant**

The owner of the South African design registration may apply, or his successor in title.

**Convention priority**

Swaziland is a member of the Paris Convention. However, the current applicable national law (1955 Proclamation) does not provide for the Convention. Accordingly, it is not possible to file a convention application directly in Swaziland, claiming convention priority.

**Novelty**

No provision.

### **Examination/procedure**

Applications are subjected to formal examination.

### **Opposition**

No provision.

### **Duration and maintenance**

South African registered designs registered in Swaziland are valid for the duration of the South African design, subject to the payment of renewal fees, and subject to the South African design being renewed.

The extension of a UK registration remains in force as long as the UK registration is in force.

### **Restoration**

No provision.

### **Revocation**

No provision.

### **Assignments and licences**

Change in ownership and licence contracts must be recorded at the Registrar's office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement
- certificate issued by the South African Designs Office confirming the assignment or licence of the corresponding South African design.

### **Compulsory licences**

No provision.

### **Rights conferred by registration**

The registration of a design in Swaziland gives the owner the sole right to apply the design to the relevant articles for commercial purposes, and to authorise other persons to do so.

### **Infringement**

Infringement proceedings may be brought in a competent court for appropriate remedy.

### **Marking**

No provisions.

### **Working**

No provisions.

## **COPYRIGHT**

### **Law**

- Copyright Act no 36 of 1912
- Copyright (Rome Convention) Act, 1933
- Copyright (Prohibited Importation) Act, 1918

Swaziland is a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

In the case of Swaziland, the copyright law is antiquated and as such does not contain express provisions in respect of works such as computer programs.

### **Subject matter eligible for protection**

The Act provides for copyright to subsist in every original literary, dramatic, musical and artistic work.

A literary work is defined to include maps, charts, plans, tables and compilations.

Dramatic works are defined to include any piece of recitation, choreographic work, or entertainment in dumb show, and any cinematograph production where the arrangement or acting or the combination of incidents give the work an original character.

An artistic work is defined to include works of painting, drawing, sculpture and artistic craftsmanship, architectural works, engravings, photographs.

### **Exclusions from copyright**

No express provision.

### **Registration of copyright**

No requirement.

### **Requirements for subsistence of copyright**

To qualify for copyright, a published work must have been first published within the British Commonwealth; for an unpublished work, the author must have been a British subject or resident in the British Commonwealth.

### **Authorship and ownership of copyright**

The author of a work shall be the first owner of the copyright in the work, except in the following cases:

- in the case of certain works (engravings, photographs, portraits), a person who ordered and paid for the work shall be the owner, unless otherwise agreed

- where the author is employed under a contract of service or apprenticeship and the work was made in the course of his employment, the employer shall be the owner.

#### **Duration of copyright**

Copyright subsists for the lifetime of the author plus 50 years.

#### **Protection afforded by copyright**

The protection afforded the copyright owner is the sole right to produce or reproduce the work in any material form whatsoever; to perform the work in public; and to publish the work.

The copyright in a work is infringed by any person who, without the permission of the copyright owner, carries out any act reserved as the sole right of the owner.

Certain acts are excluded from infringement, such as any fair dealing with a work for purposes of private study, research, criticism or review.

#### **Assignment and licensing of copyright**

Copyright may be assigned and licensed.

### **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Swaziland.

## TANZANIA (comprised of Tanganyika, Zanzibar and Pemba)

### GENERAL INFORMATION

The United Republic of Tanzania comprises Tanganyika, on the African mainland, and the islands of Zanzibar and Pemba. Tanganyika lies on the east coast of Africa and is bordered by Kenya and Uganda to the north; Rwanda, Burundi and Democratic Republic of the Congo to the west; and Zambia, Malawi and Mozambique to the south. The islands of Zanzibar and Pemba lie off the east coast of Tanganyika.



<b>Area:</b>	947 300 km <sup>2</sup>
<b>Population:</b>	41.9 million
<b>Capital:</b>	Dodoma (largest city Dar es Salaam)
<b>Currency:</b>	Tanzanian shilling
<b>GDP:</b>	\$ 62.2 billion (2010)
<b>Internet domain:</b>	.tz
<b>Languages:</b>	Swahili, English (official languages)
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Raw cotton; cashew nuts; gold; coffee
<b>Imports:</b>	Industrial raw materials; construction materials; consumer goods; transport equipment; crude oil

### International/regional conventions

Tanzania is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1999)
- Berne Convention (since 1994)
- Harare Protocol (of ARIPO) (since 1999)
- Lusaka Agreement (ARIPO) (since 1983)
- Nice Agreement on Classification of Marks (since 1999)
- Paris Convention (since 1963)
- Patent Cooperation Treaty (since 1999)
- WIPO Convention (since 1983)
- WTO/TRIPS (since 1983)

**Note:** Although Tanzania is a United Republic, uniting Tanganyika and Zanzibar (which is part of an archipelago including Pemba), Zanzibar retained its legislative independence in certain areas, *inter alia* in intellectual property (see the section on **ZANZIBAR** below). So, although the United Republic of Tanzania is a union of the two countries, the IP regime in Tanzania entails two separate and independent legal systems: for purposes of IP regulation, Tanganyika and Zanzibar are two separate jurisdictions. Zanzibar has thus enacted its own IP laws which apply in Zanzibar (and apparently also in Pemba).

Therefore, although the IP laws enacted in Tanganyika are formulated as if to apply to the entire United Republic, so that protection obtained under those laws would appear to have effect also in Zanzibar and Pemba, this is in fact not the case.

## **TANZANIA/TANGANYIKA**

### **IP legislation**

#### Trade marks

- Trade and Service Marks Act no 12 of 1986
- Trade and Service Marks Regulations, 2000
- Merchandise Marks Act no 20 of 1963
- Merchandise Marks Regulations, 2008

#### Patents

- Patents (Registration) Act of 1994, Chapter 217, incorporating Patents Act no 1 of 1987 (as amended by Acts no 13 of 1991 and no 18 of 1991)
- Patent Regulations, 1994

#### Designs

- Ordinance no 25 of 1936, Cap 219

#### Copyright

- Copyright and Neighbouring Rights Act no 7 of 1999
- Copyright and Neighbouring Rights (Production and Distribution of Sound and Audiovisual Recordings) Regulations, 2006
- Copyright and Neighbouring Rights (Registration of Members and their Works) Regulations, 2005

#### Related areas

- New Plant Varieties (Plant Breeders' Rights) Act no 22 of 2002
- Plant Breeders' Rights Regulations, 2008.

## **TRADE MARKS**

### **Law**

- Trade and Service Marks Act no 12 of 1986
- Trade and Service Marks Regulations, 2000
- Merchandise Marks Act no 20 of 1963
- Merchandise Marks Regulations, 2008

Tanzania, and thus Tanganyika, is a member of the Paris Convention, the ARIPO (Banjul Protocol), the Nice Agreement, and the WTO/TRIPS.

Trade mark applications may be filed as national applications, in appropriate circumstances claiming convention priority in terms of the Paris Convention. Although Tanganyika is a member state of ARIPO, it has not enacted enabling legislation for the local recognition and protection of ARIPO trade mark registrations.

### **Trade mark protection**

Provision is made for the registration of trade marks for goods and services.

**Protection of well-known marks**

Some protection is given to well-known marks, inasmuch as the Act provides that a trade or service mark cannot validly be registered if it constitutes, in whole or in part, an imitation, translation or transcription liable to create confusion with a trade or service mark (or a business or company name) that is well known in the country and belongs to another party.

**Advantages of trade mark registration**

The registration of a trade or service mark grants to the proprietor the exclusive right to the use of the trade or service mark, and the right to institute proceedings to prevent, or to recover damages for, the infringement of the exclusive right.

**Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- parts of marks
- series of marks.

No provision is made for certification or collective marks.

**Definition of a trade or service mark**

A trade or service mark is defined to mean any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing, in the course of trade or business, the goods or services of a person from those of another.

The concept of a visible sign is defined to mean any sign including a word, name, brand, device, heading, label, ticket, signature, letter, number, relief, stamp, seal, etc or any combination thereof.

**Registration of parts of a mark**

Where the proprietor of a trade or service mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade or service marks.

**Registration of series of marks**

Where a person claims to be the owner of several trade or service marks in respect of the same or closely related goods or services, and the marks, while resembling each other in material particulars, yet differ in regard to statements of goods or service, statements of number, price, quality or names of places, or other matters of non-distinctive character or colour, these marks may be registered as a series by way of one registration.

**Limitation to colour**

The Act provides that a trade or service mark must be limited in whole or in part to one or more specified colours. If a trade or service mark, in any circumstances, is registered without limitation of colour, it shall be deemed to have been registered for all colours.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. One application covers a single class.

### **Convention priority**

Tanganyika is a member of the Paris Convention. An applicant who has applied for a trade or service mark in another convention country is entitled to a priority right, to be accorded the same date as the earlier application, provided the Tanganyika application is filed within six months of the first filing date.

### **Application**

An application is filed at the Trade and Service Marks Office, administered by the Registrar of Trade and Service Marks.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic specimens of the trade mark
- list of the goods or services to be covered
- priority documents (certified copy), if priority is claimed.

### **Examination/procedure**

The Registrar examines the application to determine whether it complies with the formal as well as substantive and relative grounds.

The Registrar will, if he is satisfied that the application complies with the requirements, accept the application and advertise the application for opposition purposes in the Trade and Service Mark Journal. Thereafter the registration certificate will be issued.

### **Opposition**

Opposition may be lodged within 60 days following advertisement of the acceptance of the trade mark application. It is possible to secure extensions of the opposition term if sufficient cause is shown; the Registrar has absolute discretion to grant an extension.

### **Opposition proceedings**

The notice of opposition must set out the grounds on which the opposition is based. Evidence is only filed at a later stage. The Registrar will send a copy of the notice to the applicant for registration. The applicant has 60 days after receipt of the notice within which to send to the Registrar a counter-statement setting out the grounds on which he relies for registration.

If the applicant fails to submit such a counter-statement, he shall be deemed to have abandoned the application. If a counter-statement is filed by the applicant, the Registrar will send a copy thereof to the opponent. The opponent is allowed a prescribed period within which to file evidence in support of the notice of opposition, in the form of a statutory declaration.



The opponent's statutory declaration is again sent to the applicant by the Registrar, and the applicant is afforded an opportunity to file evidence in support of his counter-statement within 60 days. The opponent is then afforded a final opportunity to file evidence in reply, within two months. Once all the papers have been filed, the opposition will be heard by the Registrar.

### **Grounds for opposition**

The grounds of opposition include:

- that the use of the mark would be contrary to law or morality or which would be likely to deceive or cause confusion as to the nature, geographical or other origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services concerned
- that the mark consists solely of the shape, configuration or colour of the goods, or the containers thereof
- that the mark constitutes a reproduction, in whole or in part, or an imitation, translation or transcription liable to create confusion with a trade or service mark or a business or company name which is well known in the country and belongs to a third party
- that the mark is identical to a trade or service mark belonging to a different proprietor and already on the register in respect of the same goods or services or closely related goods or services, or that the mark so nearly resembles such a trade or service mark as to be likely to deceive or cause confusion
- that the mark resembles, in such a way as to deceive or cause confusion, an unregistered trade or service mark used earlier in Tanzania by a third party in relation to the same goods or services or closely related goods or services, provided that an application for the registration of the earlier used unregistered trade or service mark is filed at the same time as the notice of opposition
- that the mark resembles, in a way as to be likely to deceive or cause confusion, a business or company name already used in Tanzania by a third party.

### **Duration and renewal**

The registration of a trade or service mark endures for a period of seven years from the date of registration, and thereafter may be renewed for periods of 10 years. In the event that priority is claimed, registration is calculated from the priority date.

### **Cancellation/removal of a trade mark**

Any aggrieved person may apply in the prescribed manner to the Registrar or to the court for an order making, expunging or varying an entry in the case of –

- the non-insertion in or omission from the register of any entry
- an entry wrongly remaining on the register
- any error or defect in any entry in the register.

The application must be accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks. From there on the application will follow much the same procedure as an opposition. However, the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement; in case of doubt, either party may apply to the Registrar for directions.

A trade mark registration may also be cancelled and the trade mark removed from the register on any of the grounds on which the trade mark application could have been opposed (see the section on **Grounds for opposition** above).

A registered trade or service mark may further be cancelled if it has not been used for a continuous period of three years up to one month preceding the date of the request for cancellation (see the section on **Use requirement and cancellation** below).

#### **Use requirement and cancellation**

A registered trade or service mark has to be used by its owner or by a registered user to avoid the risk of cancellation.

Any aggrieved person may apply to the Registrar or the court for the removal/cancellation of a registered trade or service mark on the ground that up to a date one month before the date of application for cancellation, a continuous period of three years or longer had lapsed during which the registered proprietor did not use the trade or service mark in relation to the relevant goods or services, unless the proprietor can show that -

- such non-use is due to special circumstances in the trade and not to any intention not to use or to abandon such trade mark in relation to such goods
- the non-use is within five years from the date of first advertisement of the trade or service mark.

#### **Assignment**

The rights in a mark may be transferred by assignment. An assignment must be registered in the register.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment.

#### **Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is required in order to be effective against third parties.

Any licence agreement shall provide for the effective control over the quality of the goods or services of the licensee by the licensor.

Requirements for recordal:

- power of attorney by the licensee (simply signed)
- power of attorney by the licensor (simply signed)
- licence agreement.

### **Amendment**

The Registrar shall on request by the registered proprietor effect the following amendments and/or corrections:

- correct any error in the name, address or description of the registered proprietor
- record any change of name and address
- cancel the entry of a trade or service mark
- amend the specification of goods or services
- enter a disclaimer or memorandum
- correct any error or enter any change in the name or address of a registered user
- alter any trade or service mark.

### **Rights conferred by registration**

The Act provides that the registration of a trade or service mark shall give to the registered proprietor the exclusive right to the use of the trade or service mark in relation to the relevant goods.

The Act further provides that no person shall be entitled to institute any proceedings to prevent, or recover damages for, the infringement of an unregistered mark. Such right to institute proceedings flows from the registration of the mark.

### **Trade mark infringement**

The exclusive right to the use of a trade mark given by registration shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, uses a sign –

- identical with or so nearly resembling the mark as to be likely to deceive or cause confusion, in the course of trade or business, in relation to any goods or services or related goods or services in respect of which the registered mark is registered, in such a manner as to render the use of the sign likely to be either:
  - seen as use as a trade mark or business or company name, or
  - in a case in which the use is upon the goods or in physical relation thereto or in an advertisement issued to the public, seen as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark in relation to goods with which such a person is connected in the course of trade
- identical with or nearly resembling it in the course of trade or business in any manner likely to impair the distinctive character or reputation of the mark.

**Defences to trade mark infringement**

A registered trade mark is not infringed by the following acts:

- any *bona fide* use by a person of his own name or the name of his place of business, or that of any of his predecessors in business
- the use by any person of any *bona fide* description of the character or quality of his goods
- the use has taken place continuously from a date anterior to the use of the registered trade mark by the proprietor, or the registration of the registered trade mark, whichever occurred first
- use in relation to goods to which the proprietor of the trade mark (or registered user) has applied the goods
- use in relation to goods which have been sold or offered for sale in Tanzania under the trade mark by the proprietor, unless the condition of the goods is modified or impaired after they have been sold or offered for sale.

**Relief for trade mark infringement**

A trade mark proprietor may ask for relief in an action for trade mark infringement in the form of an injunction, damages, delivery-up and/or destruction of the infringing goods, and removal of the infringing trade mark (this is not a separate relief, but will flow from the injunction).

A claim for pecuniary damages is based on a loss of profits and is generally very difficult to prove. An application can be made for the infringer to furnish an account of profits. Lost royalties may form part of special damages under the general damages claim.

**Common law rights**

Certain common law rights are recognised and protected. It is provided that nothing in the Act shall be deemed to affect rights of action against any person for passing off, or the remedies in respect thereof. It is also provided that nothing in the Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the use by any other person of an identical or similar mark, where such other person (or a predecessor in title) has continuously used that mark from a date anterior to the use of the registered mark by the proprietor or the registration of the registered mark.

**Marking of goods**

Notice of registration by the use of the legend 'Registered Trade Mark' or suitable abbreviation (eg Regd. TM) or symbol ® is optional.

## PATENTS

### Law

- Patents (Registration) Act of 1994, Chapter 217, incorporating Patents Act no 1 of 1987 (as amended by Acts no 13 of 1991 and no 18 of 1991)
- Patent Regulations, 1994

Tanzania, and thus Tanganyika, is a member of the Paris Convention, the PCT, ARIPO (Harare Protocol), and the WTO/TRIPS.

### Patent protection

As indicated earlier, the United Republic of Tanzania comprises two countries or regions, ie Tanganyika and Zanzibar. These two regions have separate IP laws. Patent protection must thus be obtained separately in each territory. This section deals with Tanganyika only; see the separate section below for **ZANZIBAR**.

Patent protection is obtainable in Tanganyika via a national filing or via an ARIPO application designating Tanzania. Tanganyika has recognised the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law. It is likely, therefore, that valid patent protection will be afforded to applicants seeking to obtain a patent via an ARIPO application.

The Act also specifically recognises and provides for PCT applications, so that valid protection can be obtained via a PCT national phase application in Tanganyika.

### Types of patents

Provision is made for:

- patents for inventions that are new, inventive and industrially applicable
- divisional patents, divided out of an initial application covering more than one invention
- utility certificates for inventions that are new and industrially applicable.

### Patentable subject matter

Inventions are patentable if they are new, involve an inventive step and are industrially applicable.

The following, even if they are inventions, are not patentable

- discoveries, scientific theories and mathematical methods
- plant or animal varieties or essentially biological processes for the production of plants or animals, other than microbiological processes and the products thereof
- schemes, rules or methods for doing business, performing a mental act or playing a game
- programs for computers

- methods for the treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (this exclusion does not apply to products for use in any of those methods)
- mere presentation of information.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Tanzania is designated
- an ARIPO application designating Tanzania
- a divisional application, where the original application covers more than one invention
- a utility model application, which may prior to grant be converted into a patent application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Tanganyika Patent Office in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor, or a statement by the applicant justifying his right to the invention (if applicable)
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

Failure to file the priority document within the stipulated time period will lead to the lapsing of the priority claim.

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it is not anticipated by prior art. Prior art includes everything made available to the public anywhere in the world by written disclosure (including drawings and illustrations) or by oral disclosure, use, exhibition or other non-written means, which occurred prior to the filing or the priority date.

**Certain prior knowledge or publication excused**

A grace period of six months immediately preceding the Tanganyika filing date is provided, where disclosure was by reason or in consequence of the applicant or his predecessor in title displaying the invention at an official or officially recognised international exhibition, or by reason of an evident abuse in relation to the applicant or his predecessor in title.

**Inventiveness**

An invention is considered inventive if, having regard to the prior art, it would not have been obvious to a person skilled in the art.

**Convention priority**

Tanganyika is a member of the Paris Convention. An application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in any state party to a Convention to which Tanganyika is a party. A certified copy of the priority application has to be filed within three months of the filing date or the claim to priority will be lost.

**Examination/procedure**

Applications are subjected to formal examination which takes place automatically. The Act provides that applications relating to specified technical fields will be subjected to substantive examination.

**Opposition**

The Act does not provide for opposition by third parties to the grant of a patent.

**Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant and publish the patent.

**Duration and maintenance**

The duration of a patent is 10 years, extendible for further two terms of five years each, provided the owner or licensee can show that the patent was being worked in the United Republic, or that there were legitimate reasons for non-working.

Maintenance fees are payable annually from the filing date for both pending applications and granted patents. A six months grace period is provided, subject to surcharges. Failure to pay the annual maintenance fees before the deadline or within the six month grace period leads to lapsing of the application/patent.

**Restoration**

The Act makes provision for restoration of a lapsed patent. Within 12 months from the expiration of the period of grace for renewal, any interested person may request the Registrar to restore the patent. The Registrar must be satisfied that the non-payment of the renewal fee was unintentional, and that all annual fees have been paid.

### **Revocation**

Revocation of a patent is possible by a competent judicial authority on application by an interested person and on specific grounds, namely –

- that the patentee is not a person entitled to apply for a patent
- that the claimed invention is not patentable in terms of the Act
- that the claimed invention is excluded from protection in terms of the Act
- that the description and claims do not comply with the requirements set out in the Act.

The patentee may also surrender his patent.

### **Assignments/licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

### **Compulsory licences**

The Act provides for the granting of compulsory licences in different circumstances.

At any time after four years from the filing date, or three years from the date of grant, whichever period last expires, any person may request the court for the grant of a compulsory licence on the ground that:

- the patented invention has not been worked in the United Republic
- the degree of working of the patented invention does not meet on reasonable terms the demand in the domestic market for the patented product
- the working of the patented invention is being hindered by importation of the patented product
- by reason of the refusal of the patentee to grant licences on reasonable terms, industry or commerce in the United Republic is unfairly prejudiced.

Where the patented invention in a later patent cannot be worked without infringing an earlier patent, the owner of the later patent may request the court to grant a compulsory licence under the earlier patent.

The Minister may also, by order published in the Gazette, direct that a compulsory licence may be granted in respect of a patented product, or a process for the manufacture of the product, where the product is of vital importance for the defence, the economy or the public health of the country.

### **Amendments**

Amendments can be made prior to grant, provided the amendments do not go beyond the disclosure of the invention in the application as filed.



### **Effect of a patent**

The grant of a patent gives the owner the right to preclude any other person from exploiting the patented invention. The exploitation of the patent takes place by any of the following acts:

- making, importing, offering for sale, selling or using the patented product
- stocking such product for purposes of sale
- using the patented process
- doing any of the above acts in respect of a product of the patented process.

The rights of the patentee extend only to acts done for industrial or commercial purposes, and not to acts done for scientific research. The rights also do not extend to articles that have been put on the market in the United Republic by the owner of the patent or with his consent.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Civil remedies could include an injunction, damages or any other remedy provided for in civil law. Criminal sanctions include a fine and a term of imprisonment.

### **Marking**

No express provision.

### **Working**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, the High Court may grant a compulsory licence on the ground that the patented invention is not worked or sufficiently worked, or the reasons for refusal by the owner to grant a licence under the patent are unreasonable (see the section on **Compulsory licences** above).

### **Utility certificates**

The Act provides for the registration of utility certificates in respect of inventions that are new and industrially applicable, although not necessarily inventive. A utility model certificate expires, without a possibility of renewal, at the end of the seventh year after the date of filing.

A utility certificate may be invalidated on certain prescribed grounds, *inter alia* that the owner has no right to the utility certificate, or that the invention was not eligible for a utility certificate, etc.

At any time before the grant or refusal of a utility certificate, the application may be converted to a patent application. A patent application may likewise be converted to an application for a utility certificate.

## DESIGNS

Currently it is not possible to obtain design protection via a national filing directly in Tanganyika, as the regulations implementing the Act providing for the independent registration of designs are still pending. As Tanganyika is a member of ARIPO, design protection can be obtained via an ARIPO application, designating Tanzania. However, in the absence of any effective national laws, it is not certain that any enforceable rights can be obtained in Tanganyika by way of an ARIPO registration.

## COPYRIGHT

### Law

- Copyright and Neighbouring Rights Act no 7 of 1999
- Copyright and Neighbouring Rights (Production and Distribution of Sound and Audiovisual Recordings) Regulations, 2006
- Copyright and Neighbouring Rights (Registration of Members and their Works) Regulations, 2005

Tanzania, and thus Tanganyika, is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

The law provides for copyright in respect of original literary and artistic works, including:

- books, pamphlets and other writings, including computer programs
- lectures, addresses, sermons
- dramatic and dramatico-musical works
- musical works (vocal and instrumental)
- choreographic works, pantomimes, cinematograph and other audiovisual works
- works of architecture, painting, drawing, sculpture, engraving, lithography and tapestry
- photographic works
- works of applied art, whether handicraft or for industrial production
- illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

Derivative works shall also be protected, including:

- translations, adaptations, arrangements of literary and artistic works
- collections of literary and artistic works, such as encyclopaedia, anthologies, collections of expression of folklore, compilations of data
- works inspired by expressions of folklore.

**Exclusions from copyright**

Excluded from protection are:

- laws and decisions by courts or administrative bodies
- news of the day published, broadcast or publicly communicated
- ideas, procedures, methods of operation, concepts, principles, discoveries or mere data.

**Registration of copyright**

No requirement for registration. Copyright subsists by the sole fact of the creation of the works.

**Requirements for subsistence of copyright**

To qualify for copyright, the author must be a national or resident of the United Republic of Tanzania, or the work must have been first published in Tanzania. Since Tanzania is a member of the Berne Convention, copyright protection is extended to works eligible under such treaty, or to works eligible in a country which grants similar rights to nationals or residents of Tanzania.

**Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. The work must be original and must be reduced to material form in any manner.

The ownership of copyright in a work initially vests in the author, unless the work was done in the course of the author's employment, in which case it vests in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The economic rights afford the owner the exclusive right to do or to authorise others to do the following:

- reproduction of the work
- distribution of the work
- rental of an original or a copy of the work in the case of audiovisual works, sound recordings, computer programs
- public exhibition of the work
- translation of the work
- adaptation of the work
- public performance of the work
- broadcasting of the work
- communication of the work to the public
- importation of copies of the work.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be recognised and acknowledged as the author, and the right to object to distortion or mutilation or alteration of the work. The moral rights may not be transferred during the life of the author.

### **Duration of copyright**

In the case of literary, musical and artistic works the copyright (both economic and moral rights) will endure for the lifetime of the author plus 50 years.

In the case of audiovisuals, the duration is 50 years from the date on which the work was made or was made available to the public; in the case of applied art, the duration is 25 years.

### **Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner (except as regards computer programs and architectural works):

- the production, translation, etc by way of fair dealing for purposes of private use
- use for purposes of quotation, with acknowledgment of the work
- certain usages for teaching purposes in schools or universities or educational institutions
- use for purposes of current information, reporting on current events
- reproduction in the press of articles published in newspapers or periodicals in certain circumstances
- reproduction of certain works by public libraries, non-commercial documentation centres.

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, seizure of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences.

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## PLANT BREEDERS' RIGHTS

### Law

Plant breeders' rights can be obtained under the protection of New Plant Varieties (Plant Breeders' Rights) Act no 22 of 2002.

Tanzania is not a member of the UPOV Convention for the Protection of New Varieties of Plants.

### Protectable subject matter

Plant breeders' rights can only be obtained for those varieties of new plants that have been listed under Rule 6 and the second schedule of the Plant Breeders' Rights Regulations of 2008.

### Requirements for registrability

To qualify for registration, and thus for protection under a plant breeder's right, a plant variety must be new, distinct, uniform and stable.

A variety is deemed new if it has not yet been sold or otherwise disposed of, for the purpose of exploiting the variety, with the consent of the applicant, for more than one year prior to the date of application (in Tanzania) and for more than six years (trees and vines) and four years (other plant varieties) outside Tanzania.

### Application

The requirements for filing an application for a plant breeder's right include the following:

- an application form
- a completed technical questionnaire
- a power of attorney
- seeds/plant material for examination purposes.

### Duration

Protection is obtained for 25 years for trees and vines, and 20 years for other crops, running from the date of grant. Annual fees are payable.

# ZANZIBAR

## GENERAL INFORMATION

Zanzibar is part of an archipelago consisting of two main Islands: Zanzibar (also referred to as Unguja) and Pemba, and about 51 other surrounding small islets. Zanzibar is a partner state, with Tanganyika, in the United Republic of Tanzania. The name Zanzibar is derived from the name Zanj Bar (Black Land) given to the island by Arab mariners; Zanzibar attracted people from as far as the Orient and Iberia, Assyria and India. Pemba is the second largest island of the archipelago, initially named Al-khudra (Green Island) by the Arab mariners.



<b>Area:</b>	1500 km <sup>2</sup>
<b>Population:</b>	984,625
<b>Capital:</b>	Zanzibar Town
<b>Currency:</b>	Tanzanian Shilling
<b>GDP:</b>	\$ 528 million
<b>Internet domain:</b>	not listed
<b>Languages:</b>	Swahili and English
<b>Exports:</b>	spices; seaweed; fine raffia
<b>Imports:</b>	petroleum products; manufactured articles; rice; maize; sugar; cooking oil

## International/regional conventions

As a part of the United Republic of Tanzania, Zanzibar is a member of the international agreements as listed for Tanzania.

**Note:** As indicated above, Zanzibar is part (with Tanganyika) of the United Republic of Tanzania. However, Zanzibar retained its legislative independence in certain areas, *inter alia* in regard to intellectual property, so that it has enacted several IP laws which apply in Zanzibar (and apparently also in Pemba).

## IP legislation

Trade marks

- Zanzibar Industrial Property Act no 4 of 2008, Parts III and IV

Patents

- Zanzibar Industrial Property Act no 4 of 2008, Parts II (Chapters I and II) and IV

Designs

- Zanzibar Industrial Property Act no 4 of 2008, Parts II (Chapters III and IV) and IV

Copyright

- Zanzibar Copyright Act no 14 of 2003

## TRADE MARKS

### Law

- Zanzibar Industrial Property Act no 4 of 2008, Parts III and IV

As part of the United Republic of Tanzania, Zanzibar is a member of the Paris Convention, ARIPO (Banjul Protocol), the Nice Agreement and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services, for collective marks and for certification marks.

### Protection of well-known marks

A mark cannot validity be registered if it is identical with, or confusingly similar to, or constitutes a translation of, a mark which is well known in Zanzibar for identical or similar goods or services of another enterprise; or if the mark is well known and registered in Zanzibar for other goods or services, and use of the later mark would indicate a connection with the owner of the well-known mark and the interests of such owner are likely to be damaged by such use.

Special provision is also made for the infringement of a well-known registered mark, to extend to the use of the mark in relation to goods or services which are not identical or similar to those in respect of which the mark is registered.

### Advantages of trade mark registration

The registration of a trade mark gives the owner the exclusive right to prevent all third parties from using, in the course of trade, identical or similar signs for identical or similar goods or services where there would be a likelihood of confusion. The owner also gets the right to institute court proceedings against, and obtain relief from, third parties who infringe his rights.

### Types of trade marks

The following types of trade marks are registrable:

- goods and service marks
- certification marks
- collective marks.

### Definition of a trade mark

A mark is defined to mean any sign capable of being represented graphically that is capable of distinguishing goods (trade marks) or services (service marks) of one undertaking from those of other undertakings. A mark may consist of words, designs, letter, colours or combinations of colours, numerals or the shape of goods or their packaging, holograms, sounds and scents. Slogans not long enough to be protected by copyright, may also constitute marks.

### **Definition of a certification trade mark**

A certification trade mark is defined to mean any sign or combination of signs capable of designating any common characteristic, including quality, origin or methods of production, of goods and services and which are used under the control of the owner of the signs.

### **Definition of a collective trade mark**

A collective trade mark is defined to mean any mark that belongs to a collectivity such as a cooperative or an association or federation of industrialists, producers or merchants.

### **Limitation to colour**

A trade may consist of a colour or a combination of colours.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is applied. One application covers a single class.

### **Convention priority**

As part of Tanzania, Zanzibar is a member of the Paris Convention. An applicant may thus claim priority in accordance with the Paris Convention of an earlier national or regional application. The Zanzibar application must be filed within six months of the first filing date.

### **Application**

An application is filed at the Industrial Property Office in Zanzibar, administered by the Ministry in charge of Industrial Property.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- electronic specimens of the trade mark
- list of the goods or services to be covered
- certified copy of priority documents (if applicable).

The same filing requirements apply to the registration of collective and certification marks. However, an application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the rules, if any, governing the use of the collective mark. The application for the registration of a certification mark must designate the sign as a certification mark and shall be accompanied by the rules governing its use. Furthermore, the owner of a certification mark may not use the sign to identify or certify his own goods or services.

### **Examination/procedure**

The Registrar examines the application to determine whether it complies with the formal as well as the substantive and relative requirements.



The Registrar will, if he is satisfied that the application complies with the requirements, accept the application and advertise the application for opposition purposes in the Official Journal. Thereafter the registration certificate will be issued.

### **Opposition**

Opposition may be lodged within three months following advertisement of the trade mark application. It is possible to secure extensions of the opposition term, if sufficient cause is shown. The Registrar has absolute discretion to grant an extension of time.

### **Opposition proceedings**

If an opposition is lodged, a notice of opposition is published in the Official Gazette, and the applicant has to submit within the prescribed period a counter-statement with the grounds on which he relies for his application. If he fails to do so, the application is deemed to be abandoned.

The Registrar must furnish a copy of the counter-statement to the opponent. After hearing both parties and considering the merits, the Registrar decides the matter.

### **Grounds for opposition**

The grounds for opposition include the following:

- the mark is not a mark as defined
- the mark is incapable of distinguishing the goods or services of one enterprise from those of another
- the mark is contrary to public order or morality
- the mark is likely to mislead the public or trade circles, in particular as regards the geographic origin of the goods or services, or their nature or characteristics
- the mark is identical with, or an imitation of, or contains as an element an armorial bearing, flag or other emblem, name, sign or hallmark of the State or an intergovernmental organisation
- the mark is identical with, or confusingly similar to, or a translation of, a mark that is well known in Zanzibar for identical or similar goods, or a mark that is well known and registered in Zanzibar also for goods or services which are not identical or similar and there is a likelihood of a connection with the owner of the well-known mark and the likelihood of prejudice
- the mark is identical or similar to a mark of a different proprietor, which is already on the register and has an earlier date
- the application for registration was made in bad faith.

### **Duration and renewal**

The registration of a mark shall be for a period of 10 years from the filing date of the application for registration. The registration of a mark may, upon request, be renewed for consecutive periods of seven years, provided that the registered owner pays the prescribed renewal fee. A six months grace period is allowed for the payment of late renewal fees.

In the event that priority is claimed, the initial 10 year period is calculated from the priority date and thereafter can be renewed for periods of seven years.

### **Cancellation/removal of a trade mark**

Any interested person may request the court to invalidate or cancel the registration of a trade mark. The request for invalidation must be filed within a period of five years from the date of issuance of the registration certificate, unless the registration was obtained in bad faith, in which case the request can be filed without any time limits.

The registration may be invalidated on any ground on which the application could have been opposed (see the section on **Grounds for opposition** above). The registration can also be invalidated in certain specific circumstances if the mark consists of a geographical indication; or if the use of the mark is contrary to honest practices and constitutes unfair competition. Specific provision is made for the court to invalidate the registration of a trade mark which consists of a geographical indication with respect to goods not originating in the country indicated.

Furthermore, a registered trade mark may be cancelled if it has not been used for a continuous period of three years up to one month preceding the date of the request for cancellation. However, the mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there has been no intention not to use or to abandon the mark.

### **Use requirement and cancellation**

Failure to use a trade mark may make the mark vulnerable to cancellation or removal (see the section on **Cancellation/removal of a trade mark** above).

### **Assignment**

The rights in a mark may be transferred by assignment. A mark may be assigned without the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment.

The same requirements apply for the assignment of collective and certification marks. However, certification marks must be assigned with the goodwill of the business.

### **Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is required in order to be effective against third parties. Any licence agreement shall provide for the effective control over the quality of the goods or services of the licensee by the licensor.

Requirements for recordal:

- power of attorney by the licensee (simply signed)
- power of attorney by the licensor (simply signed)
- licence agreement.

A collective mark which is registered, or for which registration is required, may not be subject to a licence agreement.

### **Amendment**

No provision.

### **Rights conferred by registration**

The owner of a registered trade mark shall have the exclusive right to prevent all third parties from using, in the course of trade, identical or similar marks for goods or services identical or similar to those for which the mark is registered, where such use is likely to cause confusion. The owner shall also have the right to institute court proceedings against any person who infringes the mark by using the mark without the owner's consent.

### **Trade mark infringement**

A registered trade mark is infringed by the performance in Zanzibar of any act reserved for the trade mark owner by any person without the consent of the owner.

### **Defences to trade mark infringement**

The rights of the trade mark owner shall not extend to acts in respect of articles which have been put on the market in Zanzibar by the owner or with his consent; the rights of the owner shall be regarded as exhausted. Similarly, the rights of the owner shall not extend to acts in respect of articles which have been put on the market in any other country by the owner or with his consent. The owner's rights shall likewise be exhausted.

Provision is further made for the Minister in certain circumstances to declare the trade mark rights exhausted and thus to authorise importation of products bearing the mark.

### **Relief for trade mark infringement**

Relief granted by a court may be in the form of damages, an injunction to prevent imminent or continued infringement, or other appropriate relief.

### **Marking of goods**

Notice of registration by use of the legend 'Registered Trade Mark' or suitable abbreviation (eg Regd. Tm) or symbol ® is optional.

## PATENTS

### Law

- Zanzibar Industrial Property Act no 4 of 2008, Parts II (Chapters I and II) and IV

As part of the United Republic of Tanzania, Zanzibar is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT, and the WTO/TRIPS.

### Patent protection

As already indicated, Tanzania comprises two countries, ie Tanganyika and Zanzibar. Patent protection must separately be obtained in each territory. In what follows, the securing of patent protection in Zanzibar is dealt with.

Patent protection is obtainable in Zanzibar via a national filing or via an ARIPO application designating Tanzania. Unlike Tanganyika, Zanzibar has not yet recognised the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws. Accordingly, it seems uncertain that enforceable rights will be obtained in Zanzibar via an ARIPO application designating Tanzania.

Unlike Tanganyika, Zanzibar has also not introduced provisions in its law to recognise and provide for PCT applications. Although Zanzibar is a member of PCT, it is not clear whether valid patent protection could be obtained via a PCT application.

### Types of patents

Provision is made for:

- patents for inventions that are new, inventive and industrially applicable
- divisional patents, divided out of an initial application covering more than one invention
- utility model certificates for inventions that are new, sufficiently inventive, and industrially applicable.

### Patentable subject matter

Inventions are patentable if they are new, involve an inventive step and are industrially applicable, and if they have not been excluded from patentability under the law of Zanzibar.

The following, even if they are inventions, are not patentable:

- discoveries, scientific theories and mathematical methods
- schemes, rules or methods for doing business, performing a mental act or playing a game
- methods for the treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body
- natural substances, even if purified, synthesised or otherwise isolated from nature (this provision shall not apply to the processes of isolating those natural substances from their original environment)

- new uses or forms of known products or processes
- plants or animals including their parts, including DNA, cells, seeds, varieties, and species other than micro-organisms, and essentially biological processes for the production of plants or animals, other than microbiological and non-biological processes
- animal and plant varieties
- the human body and all its elements in whole or in part
- inventions, the prevention within the territory of Zanzibar of the commercial exploitation of which is necessary to protect public order and morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment
- pharmaceutical products and processes until 1 January 2016 or the expiry of such later period of extension agreed upon by the WTO Council for TRIPS.

Express provision is made for the patentability of computer-related inventions, such as:

- process inventions which in whole or in part consist of steps performed by a computer and directed by a computer program
- product inventions consisting of elements of a computer-implemented invention, including in particular machine-readable computer programs stored on a tangible medium.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Tanzania is designated
- an ARIPO application designating Tanzania
- a divisional application, where the original application covers more than one invention
- a utility model application, which may prior to grant be converted into a patent application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Zanzibar Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor(s), or a statement by the applicant justifying his right to the invention (if applicable)
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it is not anticipated by prior art or where a highly skilled person in the relevant area could not derive the invention from a combination of publications.

Prior art consists of everything disclosed to the public anywhere in the world, by publication in tangible form including patent specifications, or by oral disclosure, by use or in any other way.

### **Certain prior knowledge or publication excused**

Novelty will not be destroyed where disclosure was by reason or in consequence of abuse committed by a third party in relation to the applicant or his predecessor in title.

### **Inventiveness**

An invention shall be considered as involving an inventive step if, having regard to the differences and similarities between the claimed invention and the prior art, the claimed invention would not have been obvious to a person highly skilled in the art.

### **Convention priority**

As part of Tanzania, Zanzibar is a member of the Paris Convention. An application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by an applicant or his predecessor in title in any state party to the Paris Convention or to a convention to which Zanzibar is a party.

### **Examination/procedure**

Applications are subjected to formal examination, which takes place automatically.

### **Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall publish the patent. The Registrar will also publish granted patents.

**Opposition**

Any interested person may after the application is published, but before grant, lodge a notice of opposition with the Registrar's office. The notice of opposition must set out the grounds on which the opponent relies for opposing the grant of the patent, as well as all relevant evidence. The patent applicant has a prescribed period after the notice of opposition to file a counter-statement. The Registrar will grant a hearing and decide the matter.

**Duration and maintenance**

The term of a patent is 20 years from the filing date subject to payment of the annual maintenance fees. A grace period of six months is provided, subject to payment of surcharges.

**Restoration**

Failure to pay the annual maintenance fees before the deadline or within the six month grace period leads to the lapsing of the patent. However, it is possible to request the Registrar to restore the lapsed patent. An application for restoration must be made within one year from the date on which payment should have been made. The patentee must satisfy the Registrar that the non-payment of the maintenance fee was justifiable and that rights of third parties, that may have arisen in the meantime, are not unreasonably harmed.

**Revocation**

Revocation of a patent is possible by a competent judicial authority on application by an interested person and on specific grounds, namely –

- that the patentee is not a person entitled to apply for a patent
- that the invention is not patentable in terms of the Act.

**Assignments/licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy).

**Compulsory licences**

Provision is made for compulsory licences to be granted by the Minister, either on the basis of a decision by the Minister or on request by a third person, and after consideration by the Minister of the merits of each case, on the following grounds:

- that the public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy, so requires
- that the patent holder or his licensee is exploiting the invention in an abusive, anti-competitive manner (on the basis of a finding by a judicial or administrative body)

- that the invention is not available in sufficient quantities or qualities or at predetermined reasonable prices in Zanzibar, either through manufacture in Zanzibar or through importation
- that the patented invention, which is capable of being worked in Zanzibar, has not been duly worked by the patentee or a licensee after three years from the date of grant or four years from the date of filing
- that the patent holder has refused to grant licences on reasonable conditions and terms in response to endeavours to obtain such a licence.

The Minister may also grant a licence where a second patent, claiming an invention that involves a technical advance of considerable economic importance, cannot be worked without infringing a first patent in respect of which the compulsory licence is required.

The Act contains extensive provisions on the terms and conditions to be included in a compulsory licence, the remuneration to be paid, and the considerations to be taken into account.

### **Amendments**

Amendments can be made prior to grant, provided the amendments shall not go beyond the disclosure of the invention in the application as filed.

### **Effect of a patent**

A patent confers on the owner the right to prevent third parties from exploiting the patented invention in Zanzibar. Exploitation of a patent entails the following acts:

- making, importing, offering for sale, selling or using the patented product
- stocking such product for purposes of sale
- using the patented process
- doing any of the above acts to the product of the patented process.

The patent owner also has the right to institute court proceedings against any person who infringes the patent by performing any of the above acts without the authority of the owner.

The Act provides for certain limitations on the rights of the patent owner, including:

- acts in respect of articles put onto the market in any country by the patent owner or his licensee (thus exhausting his rights)
- acts done for experimental use (whether for scientific or commercial purpose)
- acts done in good faith by any person before the filing or priority date of the patent (subject to certain specific conditions)
- acts done solely and reasonably related to the development and submission of information required in Zanzibar, or any other country, for purposes of manufacturing or marketing authorisation.



## **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis. Civil remedies could include an injunction, damages, destruction of the infringing articles and removal of the infringing articles from the commercial channels.

## **Working**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, any interested party may request the Minister to grant a compulsory licence on the ground that the patented invention, although being capable of being worked in Zanzibar, is not being worked to the fullest extent (see the section on **Compulsory licences** above).

## **Utility model certificates**

The Act has extensive provisions for the registration of utility model certificates in respect of inventions that are new, involve a sufficiently inventive step, and are industrially applicable. A utility model certificate expires 10 years after the date of filing; an annual maintenance fee is payable.

A utility model certificate may be invalidated on certain prescribed grounds, *inter alia* that the owner is not the inventor or his successor in title, or that any other requirement has not been fulfilled.

At any time before the grant or refusal of a utility model certificate, the application may be converted to a patent application. A patent application may likewise be converted to an application for a utility model certificate.

## **DESIGNS**

### **Law**

- Zanzibar Industrial Property Act no 4 of 2008, Parts II (Chapters III and IV) and IV

As part of the United Republic of Tanzania, Zanzibar is a member of the Paris Convention, ARIPO (Harare Protocol), and the WTO/TRIPS.

**Note:** Although Zanzibar has enacted legislation (as part of its Industrial Property Act of 2008) to provide for the registration and protection of industrial designs, it appears that regulations to implement this legislation have not yet been promulgated. Accordingly, it is currently not possible to obtain design protection by way of a national filing.

Since Zanzibar is a member of ARIPO, the registration of a design may be effected via an ARIPO application designating Tanzania. However, in the absence of a duly implemented national system, it is not clear whether enforceable rights will be obtained.

The general legislative provisions relating to industrial designs, as contained in the Industrial Property Act of 2008, are set out below.

### **Design protection**

As indicated above, it does not seem that a national design filing is possible at the time of writing. An ARIPO application designating Tanzania may be a way of obtaining protection, although this is not clear.

### **Registrable subject matter**

An industrial design means any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, and which appeals to and is judged solely by the eye.

The protection afforded by the Act does not extend to anything in the design which serves to obtain a technical result.

Designs which are contrary to public order or morality shall not be registered.

### **Types of applications**

As indicated above, at this time an ARIPO application designating Tanzania may be the only option.

### **Applicant**

The author or creator or his assignee can apply for a design.

### **Novelty**

An industrial design is registrable only if it is new. An industrial design is deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form, or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration. Disclosure of the design will not be taken into consideration if it occurred by reason of, or in consequence of, an evident abuse committed by a third party in relation to the applicant or his predecessor in title.

### **Application**

Although national applications are not possible at the present time, the Act provides for the requirements as set out below.

Filing requirements:

- full particular of the applicant
- power of attorney (simply signed)
- assignment of design (if applicable)
- statement justifying the applicant's right to the industrial design
- specimens of the article embodying the industrial design
- certified copy of the priority application, with verified English translation if not in English.

Two or more designs may be the subject of one application.

**Examination/procedure**

The Registrar will examine the application to ensure that all requirements have been complied with. If the registrar finds that the requirements have been met, he must publish a notice in the Official Gazette. The applicant must then pay the prescribed fee to cover the costs of registration and for the first five-year term of protection.

**Duration and maintenance**

The initial term of a design registration is five years, which is extendible upon payment of renewal fees for two further five year terms. Renewal fees can only be paid within the last year of the initial five year term.

There is a three month grace period for payment of the renewal fees. If the renewal fee is not paid, the registration lapses.

**Restoration**

There is no provision for restoration.

**Revocation**

Any interested person may request the court to invalidate a design registration, on the ground that the requirements of the Act have not been fulfilled.

**Compulsory licences**

Provision is made for compulsory licences in cases of public interest, such as national security, nutrition or health; or in cases of anti-competitive conduct by the owner.

**Rights conferred by registration**

The registration of a design confers on the owner the right to prevent others from exploiting the design in Zanzibar, including the making, selling or importation of articles incorporating the design.

The owner shall also have the right to institute court proceedings against any person who infringes his rights by performing, without the owner's consent, any of the acts reserved for the owner.

**COPYRIGHT****Law**

- Zanzibar Copyright Act no 14 of 2003

As part of the United Republic of Tanzania, Zanzibar is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent and surrounding islands is not always generally available. The commentary given below is based on the information available at the time of writing.

### **Subject matter eligible for protection**

The law provides for copyright in respect of original intellectual creations in the form of literary and artistic works, including:

- books, pamphlets, articles, scientific and artistic writings and other writings, including computer programs
- speeches, lectures, addresses, sermons and other works
- dramatic and dramatic-musical works, choreographic works, pantomimes, and other works created for stage productions
- musical works
- audiovisual works
- works of architecture
- works of painting, drawing, sculpture, engraving, lithography and tapestry and other works of fine art
- photographic works
- works of applied art
- illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

Derivative works shall also be protected, including:

- translations, adaptations, arrangements and other transformations of works
- collections of works, compilations of data (databases), collections of expression of folklore.

### **Exclusions from copyright**

Excluded from protection are:

- ideas, procedures, systems, methods of operation, concepts, principles, discoveries or mere data
- official texts of a legislative, administrative or legal nature.

### **Registration of copyright**

No requirement for registration. Copyright subsists by the sole fact of the creation of the works.

### **Requirements for subsistence of copyright**

To qualify for copyright, the author must be a national of the United Republic of Tanzania or a resident of Zanzibar, or the work must have been first published in Tanzania. Since Zanzibar is a member of the Berne Convention, copyright protection is extended to works eligible under such treaty or to works eligible in a country which grants similar rights to nationals or residents of Tanzania.

### **Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. The work must be original and qualifies for protection by the sole fact of its creation, irrespective of its mode or form of expression.

The ownership of copyright in a work initially vests in the author, unless the work was done in the course of the author's employment or under commission and upon payment of an agreed sum, in which case it vests in the employer or in the person who commissioned. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The economic rights afford the owner the exclusive right to do or to authorise others to do the following:

- reproduction of the work
- translation of the work
- adaptation, arrangement or other transformation of the work
- distribution of the work by sale, rental, public lending, etc
- rental of an original or a copy of the work in the case of audiovisual works, sound records, computer programs
- importation of copies of the work
- public exhibition or display of the work
- public performance of the work
- broadcasting of the work
- communication of the work to the public.

The author also has the moral rights pertaining to the work; these include the right to claim authorship, the right to be recognised and acknowledged as the author, and the right to object to distortion or mutilation or alteration of the work. The moral rights may not be transferred during the life of the author.

### **Duration of copyright**

In the case of literary, musical and artistic works, the economic rights of the copyright will endure for the lifetime of the author plus 50 years. In the case of works of applied art, the duration is 25 years from the making of the work.

### **Exceptions to copyright protection**

The following acts are amongst a list of acts excluded from the rights of the owner:

- the production, translation, etc by way of fair dealing for purposes of private use
- use for purposes of quotation, with acknowledgment of the work
- certain usages for teaching purposes in schools or universities or educational institutions
- use for purposes of current information, reporting on current events
- reproduction in the press of articles published in newspapers or periodicals (in certain circumstances) and items such as political speeches, lectures, addresses
- reproduction of certain works by public libraries, non-commercial documentation centres.

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

The economic rights of copyright are transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, seizure of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences.

## **PLANT BREEDERS' RIGHTS**

As far as could be determined, no separate legislation on plant breeders' rights or other *sui generis* protection for plants is available in Zanzibar. Inasmuch as Zanzibar is part of the United Republic of Tanzania, it is expected that the protection under the New Plant Varieties (Plant Breeders' Rights) Act no 22 of 2002 would also apply in Zanzibar (see the section on **PLANT BREEDERS' RIGHTS** under **TANGANYIKA** above).

# TOGO

## GENERAL INFORMATION

The Republic of Togo lies in West Africa with the Gulf of Guinea on its south side, Ghana to its west, Benin to its east, and Burkina Faso to the north.

**Area:** 56 785 km<sup>2</sup>  
**Population:** 6.6 million  
**Capital:** Lomé  
**Currency:** CFA Franc  
**GDP:** \$ 3 billion (2010)  
**Internet domain:** .tg

**Languages:** French (official language)

**Working week:** Monday - Friday

**Exports:** Phosphates; cotton; coffee; cocoa; re-exports

**Imports:** Machinery and equipment; petroleum products; foodstuffs



## International/regional conventions

Togo is a member of the following international/regional agreements:

- Bangui Agreement (OAPI) (since 1982)
- Berne Convention (since 1975)
- Brussels Convention on Programme-carrying Signals (since 2003)
- Lisbon Agreement on Appellations of Origin (since 1975)
- Nairobi Treaty on Olympic Symbol (since 1983)
- Paris Convention (since 1967)
- Patent Cooperation Treaty (since 1978)
- Phonograms Convention (since 2003)
- Rome Convention (since 2003)
- WIPO Convention (since 1975)
- WIPO Copyright Treaty (since 2003)
- WIPO Performances and Phonograms Treaty (since 2003)
- WTO/TRIPS (since 1995)

## IP legislation

Togo is a member state of the union of 16 predominantly Francophone countries constituting the Organisation Africaine de la Propriété Intellectuelle (OAPI).

Three principles govern OAPI:

- the adoption of uniform legislation to create a uniform system of intellectual property rights protection with a common administrative procedure
- the creation of a common authority to serve as a national intellectual property rights protection office for each of the member states

- the centralisation of procedures so that a single title would issue creating national intellectual property rights in the individual member countries.

OAPI is unique in that its member countries were required to 'renounce' their national sovereignty in the area of intellectual property, to afford the right holder a single regional title of protection valid in each country, obtained via an OAPI application and registration procedure. In order to join OAPI, Togo had to renounce its national IP legislation.

A single OAPI IP office, which is based in Yaoundé, Cameroon, was set up to deal with all administrative matters pertaining to the registration, maintenance and upkeep of OAPI intellectual property rights granted in terms of the Bangui Agreement. Contentious matters, such as proceedings in the case of infringement, are usually handled by the courts in the member state where the conflict arises. For more information regarding OAPI, please refer to the chapter on **OAPI**.

The position in regard to copyright in the OAPI member countries is not entirely clear. Although the Bangui Agreement provides for copyright protection, some member countries have retained their copyright laws or have enacted new copyright laws. It is not clear how this legal dispensation will apply in practice. Reliable and up-to-date information on the copyright laws and their application in individual countries is not always generally available. The commentary given below is based on the information available at the time of writing.

## **TRADE MARKS**

Trade mark protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **PATENTS**

Patent protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **DESIGNS**

Design protection is obtainable only in terms of the Bangui Agreement by way of a filing with the OAPI IP office. For further information regarding procedures refer to the chapter on **OAPI**.

## **COPYRIGHT**

Provision is made for copyright protection in OAPI member countries in terms of the Bangui Agreement. For further information regarding the requirements for copyright protection, refer to the chapter on **OAPI**.



In Togo further legislation on the protection of copyright was enacted:

- Law no 91-12 of 1991 on Protection of Copyright, of Folklore and Neighbouring Rights.

### **PLANT BREEDERS' RIGHTS**

Provision is made for plant breeders' rights to be obtained in terms of the Bangui Agreement by way of a filing with the OAPI office. For more information regarding plant breeders' rights within OAPI, refer to the chapter on **OAPI**.

# TUNISIA

## GENERAL INFORMATION

Tunisia is situated on the north coast of Africa, the northernmost country on the Continent. Tunisia is bounded by the Mediterranean Sea to the north and east, by Algeria to the west and by Libya to the south. The country is divided by the Atlas Mountain range: the northern area is predominantly forest and agricultural land; and the southern part is semi-arid desert.



<b>Area:</b>	163 610 km <sup>2</sup>
<b>Population:</b>	10.6 million
<b>Capital:</b>	Tunis
<b>Currency:</b>	Tunisian Dinar
<b>GDP:</b>	\$ 100.3 billion (2010)
<b>Internet domain:</b>	.tn
<b>Languages:</b>	Arabic (official language), French
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Agricultural products; chemicals and phosphates; electrical equipment; mechanical goods; semi-finished goods, textiles and clothing
<b>Imports:</b>	Hydrocarbons; food; textiles; machinery and equipment; chemicals

## International/regional conventions

Tunisia is a member of the following international agreements:

- Berne Convention (since 1887)
- Budapest Treaty (since 2004)
- Hague Agreement on Designs (since 1930)
- Lisbon Agreement on Appellations of Origin (1973)
- Madrid Agreement on Source of Goods (since 1892)
- Nairobi Treaty on Olympic Symbol (since 1983)
- Nice Agreement on Classification of Marks (since 1967)
- Paris Convention (since 1884)
- Patent Cooperation Treaty (since 2001)
- UPOV Convention for New Varieties of Plants (since 2003)
- Vienna Agreement on Figurative Elements of Marks (since 1985)
- WIPO Convention (since 1975)
- WTO/TRIPS (since 1995)

## IP legislation

### Trade marks

- Law no 2001-36 of 2001 on the Protection of Trade Marks and Trade Services (amended by Law no 2007-50 of 2007)
- Law no 99-57 of 1999 on Appellations of Origin and Indications of Source of Agricultural Products
- Law no 2007-68 of 2007 on Appellations of Origin, Geographical Indications and Indications of Source for Handicrafts

### Patents

- Law no 2000-84 of 2000 on Patents

### Designs

- Law no 2001-21 of 2001 on the Protection of Industrial Designs
- Law no 2001-20 of 2001 on the Protection of the Layout-designs of Integrated Circuits

### Copyright

- Law no 94-36 of 1994 on Literary and Artistic Property (amended by Law no 2009-33 of 2009)

### Related areas

- Law no 99-42 of 1999 on Seeds, Seedlings and New Plant Varieties
- Decree no 2002-3019 of 2002 ratifying the accession of the Republic of Tunisia to the International Convention for the Protection of New Varieties of Plants

**Note:** In addition to the main IP laws listed above, Tunisia also has a long list of Regulatory Decrees and Orders applicable to different aspects of its IP laws and the implementation and administration of these laws.

## TRADE MARKS

### Law

- Law no 2001-36 of 2001 on the Protection of Trade Marks and Trade Services (amended by Law no 2007-50 of 2007)
- Law no 99-57 of 1999 on Appellations of Origin and Indications of Source of Agricultural Products
- Law no 2007-68 of 2007 on Appellations of Origin, Geographical Indications and Indications of Source for Handicrafts

Tunisia is a member of the Paris Convention, the Madrid Agreement on Indications of Source, the Nice Agreement, the Lisbon Agreement, the Vienna Agreement, and the WTO/TRIPS.

### Trade mark protection

Provision is made for the registration of trade marks for goods and services, for collective marks and for well-known marks. Applications may be filed as national applications, in appropriate circumstances claiming priority in terms of the Paris Convention.

### Protection of well-known marks

A trade mark will not be registrable if it constitutes an infringement of a well-known mark. The owner of the well-known mark may oppose such an application for registration.

### **Advantages of trade mark registration**

The Law provides that ownership of a trade mark is obtained through registration. The owner of a trade mark is entitled to institute civil lawsuits against infringers and counterfeiters.

### **Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- collective marks
- well-known marks.

### **Definition of a trade mark**

A trade mark is an apparent sign which makes it possible to distinguish the goods presented or the services provided by a person. A sign may consist of:

- designations such as words, groups of words, surnames, geographical names, pseudonyms, letters, numeral and symbols
- graphic signs such as drawings, holograms and shapes in particular those related to the product, its method of presentation, or those which distinguish the services, the arrangements of colours, the mixings of colours or the separation of the grades of colours and
- phonic signs such as musical tunes and sentences.

### **Definition of a collective trade mark**

A mark is considered to be a collective mark if it can be used by any person who abides by its system of usage, as established by the owner of the registration.

### **Limitation to colour**

Specific reference is made to a mark that may be a graphic sign with an arrangement of colours, or a mixing of colours, or a separation of the shades of colours.

### **Classification**

The International Classification of Goods and Services (Nice Classification) is followed. A single application may cover more than one class.

### **Convention priority**

Tunisia is a member of the Paris Convention, so that applicants who have applied to register a mark in another convention country have the right to claim priority, to be accorded the same date as the earlier application, provided the Tunisian application is filed within six months of the earlier filing date.

### **Application**

Applications are filed with the Ministry of Industry and Technology. Applicants residing outside Tunisia must be represented by a local agent.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed), in French,
- list of goods and/or services to be covered, with a French translation
- prints of the mark, for each class
- certified copy of priority document (if applicable).

### **Examination/procedure**

Applications are examined as to formal requirements only.

As indicated above, a trade mark or a service mark is an apparent sign, which makes it possible to distinguish the goods presented or the services provided by a natural or a juridical person. The distinguishing characteristic of a sign which is to be used as a mark is evaluated with respect to the goods or services to which the mark extends.

The following signs and designations do not contain a distinguishing characteristic:

- signs or designations which are used in the regular or professional language by necessity to denote the goods or services
- signs or designations which can be used to denote any quality or attribute of the goods or services, in particular the type, quality, quantity, purpose, geographical origin, or the time of production or provision
- signs that are necessitated by the nature or function of the product.

Signs and designations may acquire a distinguishing characteristic through use.

### **Opposition**

Specified third parties may oppose the application within two months from date of publication. Extensions of the time period are available at the discretion of the Registrar.

### **Opposition proceedings**

An application for registration may be opposed by:

- the owner of a prior registered mark or a mark that is subject to a priority right
- the owner of an earlier well-known mark
- the holder of an exclusive licence, unless the contract stipulates otherwise.

The opposition shall be submitted to the legal representative of the industrial property authority within two months following the publication date of the trade mark application. The industrial property authority shall first try to reconcile the parties according to procedures to be determined by a ruling.

### **Grounds for opposition**

A mark may be opposed on the grounds that it is:

- a reproduction or an imitation of official slogans, flags, logos, or designations of any country or an international organisation, unless they are used with authorisation from the competent authority
- a reproduction or an imitation of official symbols or stamps sanctioned by a country for quality and assurance, unless their use is authorised by the competent authority
- in violation of public order or good morals or if its use is prohibited by law
- likely to mislead the public, particularly as concerns the nature, quality or geographical origin of the goods or services
- a prior registered mark or a well-known mark
- a designation or a company name which may lead to confusion in trade
- a commercial name or a distinguished signboard which is known in the whole of Tunisia which may lead to confusion of the public
- a protected appellation of source
- a work in which copyright subsists
- a protected industrial drawing or design
- the essence of rights of other persons, including surnames, pseudonyms or pictures
- the name or picture of a local group.

### **Duration and renewal**

A trade mark registration is valid for an initial period of 10 years from the date of filing, and is renewable for periods of 10 years each, upon payment of the applicable renewal fees. Renewal must be effected within the last six months of the period of validity.

### **Cancellation/removal of a trade mark**

A registered trade mark is vulnerable to cancellation if it has not been seriously used for a continuous period of five years.

A registered trade mark may also be removed from the register if the trade mark was registered without any *bona fide* intention to use the mark, and there has in fact been no *bona fide* use of the trade mark up to the date one month before the date of the application for cancellation.

### **Use requirement and cancellation**

The Law provides that a mark will lapse if the owner, without excuse, did not seriously use the mark for the relevant goods or services for at least five years. Serious use of the mark is defined to include:

- placing the mark on the goods or their packaging
- use of the mark with the consent of the owner.

### **Assignment**

Assignments are possible and may be made with or without the goodwill of the business. Recording of an assignment is necessary to be effective against third parties.

Requirements for recordal:

- full particulars of the assignee
- power of attorney by the assignee (simply signed), in French
- date of transfer of ownership
- deed of assignment (simply signed by both parties), with French or Arabic translation.

### **Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is necessary to be effective against third parties.

Requirements for recordal:

- power of attorney (simply signed), in French
- licence agreement (simply signed by both parties), with French or Arabic translation.

### **Amendment**

The owner of a registered mark may request the Registrar to add or alter a trade mark in any manner which does not substantially affect its identity. The amendment will be advertised for opposition purposes.

Requirement for amendment:

- supporting document (if any, eg certified certificate of the change of name and/or address) with French/Arabic translation.

### **Rights conferred by registration**

The right of ownership of a mark is obtained through registration. The registration of the mark shall confer on its holder the right to own the mark in relation to the goods or services to which the mark extends.

Without the consent of the owner, others are prohibited from using the mark.

### **Trade mark infringement**

Without the consent of the owner, others are prohibited from:

- reproducing, using or placing of a mark (even with the addition of such words as 'composition', 'style', 'system', 'imitation', 'type' or 'method')
- using a reproduced mark with respect to products or services that are similar to those covered by the trade mark registration
- deleting or altering a mark which was legally placed.

The following unauthorised actions are prohibited if they are likely to cause confusion in trade:

- reproducing, using or placing a mark or a reproduced mark on goods, or using it in relation to services, that are similar to those covered by the trade mark registration
- counterfeiting a mark and using a counterfeit mark on goods or in relation to services identical or similar to those covered by the trade mark registration

- the use of a well-known mark in relation to goods or services that are not similar to those covered by the registration is a contravention of the law, if the use results in damage to the owner of the well-known mark or if the use is an unjustifiable exploitation of this mark.

### **Defences to trade mark infringement**

The registration of mark does not prohibit the use of a sign (that is the same as or similar to a registered trade mark) in the following manner:

- as the designation of a company, commercial name or shop name, if this use predates the trade mark registration
- the *bona fide* use by a person of his surname
- as a description of the intended purpose of goods or services, specifically relating to a secondary piece or a spare part, provided that there is no confusion as to the source of the goods or services.

However, if the abovementioned use will cause damage to the rights of the trade mark proprietor, he may file a memorandum to the competent court for an order prohibiting or limiting such use.

### **Relief for trade mark infringement**

The infringement of a trade mark proprietor's rights shall be considered as an act of counterfeiting, and the infringer shall be civilly and criminally liable.

A trade mark proprietor, whose rights have been infringed, may apply to the court for the provisional seizure of the infringing goods. The trade mark proprietor must institute legal proceedings against the infringer within 15 days of the seizure of the infringing goods, failing which the goods will be released.

A fine shall be imposed on any person who reproduces, counterfeits, uses, places, removes or alters a trade mark and, by so doing, infringes the right of a proprietor of the registered trade mark.

### **Common law rights**

No express provision.

### **Marking of goods**

It is not compulsory to use the legend 'Marque Déposéé' to indicate that the mark has been registered. It is however a criminal offence to indicate that an unregistered mark has been registered.

## **PATENTS**

### **Law**

- Law no 2000-84 of 2000 on Patents

Tunisia is a member of the Paris Convention, the Budapest Treaty, the PCT and the WTO/TRIPS.



**Patent protection**

Patent protection is available via a national filing, in appropriate circumstances with a claim to priority, or by way of a national phase application based on an international PCT application in which Tunisia is designated.

**Types of patents**

Provision is made for patents for inventions, and for divisional patents where the initial application covered more than one invention.

**Patentable subject matter**

Patents shall be granted to new inventions that involve an inventive step, and that are industrially applicable.

The following shall not be deemed to be inventions and/or shall not be patentable:

- purely ornamental creations
- discoveries, scientific theories and mathematical methods
- schemes, rules and methods intended for use –
  - in the performance of purely mental acts
  - in games
  - in the field of economic activity
  - in connection with software
- methods of therapeutic and surgical treatment of the human body or animals, and diagnostic methods (this exclusion shall not apply to preparations or products and compositions for application in such methods)
- presentation of information
- all types of living substances existing in nature
- varieties of plants or animal breeds or essentially biological processes for the production of plants or animals (except biological processes used in medicine or products obtained from such processes)
- inventions the publication of which would be contrary to morality, public policy, public health or the environment.

**Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Tunisia is designated
- a divisional application, where the original application covers more than one invention.

**Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor(s), or a statement by the applicant justifying its right to the invention (if applicable)
- specification (including claims, drawings and abstract), in English or French or Arabic
- certified copy of the priority document (if applicable).

Failure to file the priority document within three months from the filing date will lead to the lapsing of the priority claim.

**Applicant**

The inventor or his successor in title may apply for a patent. An assignment document is required if the applicant is not the inventor.

**Novelty**

Absolute novelty is required. A patent is novel if it is not included in the state of the art. The state of the art includes everything that has been made accessible to the public, by written or oral description, by use or in any other way prior to the filing or priority date. The state of the art also includes the contents of pending patent applications in Tunisia with an earlier effective date, even though not yet published.

**Certain prior knowledge or publication excused**

There is a grace period of 12 months immediately preceding the Tunisian filing date or the priority date, where disclosure of the invention was as a result of direct or indirect prejudice against the applicant or his legal predecessor.

**Inventiveness**

An invention is deemed to involve an inventive step where it is not obvious to a person skilled in the field of the art.

**Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Tunisia is filed within 12 months from the earlier application.

**Examination/procedure**

Applications are subjected to formal examination only, which takes place automatically. If the application is found to comply with all requirements, a notification of the application will be published.

**Opposition**

The Act makes provision for an opposition to a pending application. A memorandum with a notice of opposition must be filed at court within two months from the date of publication referred to above.

**Publication**

After examination, if the Industrial Property Authority is satisfied that the requirements have been met, and if no opposition was entered or an opposition was decided by the competent court in favour of patentability, the patent shall be granted. Granted patents are published in the Official Bulletin.

**Duration and maintenance**

A patent is valid for 20 years as from the date of filing of the patent application.

Maintenance fees are payable on pending applications, and are payable annually calculated from the filing date. The first maintenance fee falls due on the filing date and annually thereafter. A six months grace period is provided, subject to payment of surcharges. If the renewal fee is not paid, the patent owner forfeits all his rights. The owner is notified of the forfeiture.

**Restoration**

The patentee may request reinstatement or restoration within three months following the official notification of the decision, provided he can provide a legitimate reason for the non-payment of the annual fees.

**Revocation**

Any interested party can approach the court to revoke a patent on the following grounds:

- that the subject matter is not patentable
- that the specification of the invention was not clear and inclusive enough to enable a person skilled in the art to execute it
- that the subject matter extends beyond the scope of the disclosure of the application as filed, or if the patent is based on a divisional application, that the subject matter extends beyond the disclosure of the original application as filed.

**Assignments/licences**

Assignments and voluntary licences are provided for and must be in writing and must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney
- deed of assignment or licence contract (original or certified copy), together with a French or Arabic translation.

The Law contains provisions prescribing certain principles to be adhered to in voluntary (contractual) licences.

**Compulsory licences**

A compulsory licence may be granted in cases of non-working (see the section on **Working** below).

A compulsory licence may also be obtained, after the expiry of the period for working, if –

- the patented product has not been marketed in sufficient quantities to meet the needs of the Tunisian market
- the industrial or commercial exploitation of the patented invention in Tunisia has been abandoned for more than three years.

The Law further provides for *ex officio* licences, where the Minister may notify patent owners to undertake the working of their patents to meet the needs of the national economy. Failure by the patent owners to do so within one year of such notice may lead to the issuance of *ex officio* licences by the Minister.

*Ex officio* licences may also be issued where public health interests require, or for purposes of national defence or security.

### **Amendments**

Amendments can be made prior to publication, but any amendment shall not go beyond the disclosure of the invention in the application as filed.

### **Effect of a patent**

A registered patent shall confer on its owner (or his successors in title) the exclusive right to exploit the patented invention. Third parties are prohibited to carry out the following acts without the consent of the owner:

- manufacturing, marketing, using or importing the patented product, or holding it in stock for these purposes
- using a manufacturing process covered by the patent
- marketing, using or importing the product of such a process, or holding it in stock for these purposes.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Remedies and sanctions include a fine, a term of imprisonment and also possible confiscation and/or destruction of the infringing products.

### **Marking**

No requirement.

### **Working**

A patent owner is obliged to work the patented invention within a period of four years from the filing, or three years from the grant, whichever period is longer, except in cases where the product of the patent is subject to prior marketing approval, in which case the period for working is extended by two years.

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application (or the

extended period), whichever is the later, the Court may grant a compulsory licence on the ground that the invention has not been worked in Tunisia.

## DESIGNS

### Law

- Law no 2001-21 of 2001 on the Protection of Industrial Designs
- Law no 2001-20 of 2001 on the Protection of the Layout-designs of Integrated Circuits

Tunisia is a member of the Paris Convention, the Hague Agreement, and the WTO/TRIPS.

### Design protection

Design protection is available by a national filing or by way of an international filing via the Hague Agreement on the International Registration of Industrial Designs, designating Tunisia.

### Registrable subject matter

The Law provides protection for any new design, any new three-dimensional form, or any new industrial product which differs from those similar to it, either in terms of a distinct and recognisable configuration conferring on it a character of novelty, or through one or more external effects which add to it a special and new appearance.

### Classification of designs

No provision.

### Types of applications

Application may be made by way of a national filing, in appropriate circumstances claiming convention priority; or by way of an international application under the Hague Agreement, designating Tunisia.

### Application

Non-convention and convention applications are filed with the office of the Institute National de la Normalisation et de la Propriete Industrielle (INNORPI). Since Tunisia has acceded to the Hague Agreement, Tunisia can also be designated in international applications filed in terms of the Hague Agreement. However, the filing procedure and other provisions of the Hague system have not yet been incorporated in the national law of Tunisia, so that there is some uncertainty as regards the validity of such applications.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed), in French

- drawings, photographs or other graphic reproductions of the article embodying the design
- certified copy of priority document (if applicable).

### **Applicant**

The author or creator or his assignee may apply for protection.

### **Convention priority**

An applicant who has filed a design application in a convention country or a member country of the World Trade Organisation is entitled to claim priority from such earlier application, provided the application in Tunisia is filed within six months from the earlier application.

### **Novelty**

The Law does not have specific provision dealing with novelty requirements for designs. The Law does, however, state that the publication of the industrial drawing or design through sale or in any other manner before its filing shall not result in loss of the ownership right, or the loss of the protection granted under the law.

### **Examination/procedure**

Applications are subjected to formal examination only, which takes place automatically.

### **Opposition**

No provision.

### **Duration and maintenance**

A design registration is granted for an initial period of five years, extendable to 10 or 15 years starting from the date of filing the application. The duration required must be specified on filing. Renewal fees for the entire period for which protection is sought are due with the filing of the application. No grace period is provided.

### **Restoration**

No provision.

### **Revocation**

An action for annulment may be brought by any interested party. For instance, the registration of an industrial design may be declared void by a court where the depositor is not the author of the design.

### **Assignments and licences**

The Law does not provide that changes in ownership or licence agreements must be recorded in the register to have any effect against third parties. However, it is recommended that changes in ownership are recorded.

Requirements for recordal:

- power of attorney (simply signed)
- deed of assignment or licence contract (original or certified copy), together with a French or Arabic translation.

**Compulsory licences**

No provision.

**Rights conferred by registration**

The owner of an industrial design registration shall have the exclusive right to use or sell the design. Third parties are prohibited, without the consent of the owner, from manufacturing, selling or importing merchandise comprising an industrial design which is either a full or a partial copy of the protected design, where these acts undertaken for commercial purposes.

**Infringement**

Infringement proceedings may be brought in a competent court on a civil or criminal basis, depending on the nature of the infringement. Remedies and sanctions include a fine, a term of imprisonment and also confiscation of goods.

**Marking**

Not required. Falsely indicating that a design or model is protected by registration subjects the offender to a fine.

**Working**

No provision.

**COPYRIGHT****Law**

- Law no 94-36 of 1994 on Literary and Artistic Property, amended by Law no 2009-33 of 2009

Tunisia is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The Law provides for the following works to be eligible for copyright:

- written or printed works such as books, pamphlets and other writings
- works created for the theatre or for broadcasting (sound or visual), whether dramatic, dramatico-musical, choreographic or dumbshow
- musical compositions, with or without words
- photographic works, and works expressed by a process analogous to photography
- cinematographic works, and works expressed by a process producing visual effects analogous to cinematography
- works executed by painting, drawing, lithography, etching or woodcutting and other similar works
- sculpture of all kinds

- works of architecture, comprising also designs, models and the mode of construction
- tapestries and articles of artistic handwork, including also the drawings or models
- maps, and drawings and graphics and three-dimensional reproductions of a scientific or artistic nature
- lectures
- works inspired by folklore
- computer software
- translations and arrangements or adaptations of the above works.

Copyright shall also apply to derivative marks.

### **Requirements for subsistence of copyright**

There is no requirement for registration. For a work to qualify for protection, the author must be a national of Tunisia, or domiciled in Tunisia. Alternatively, the work must have been made or first published in Tunisia. Works of architecture must have been erected in Tunisia.

Copyright protection is also extended to persons who are citizens of, or domiciled in a country which is a party of a treaty of which Tunisia is also a party, and which provides for equivalent copyright protection.

### **Authorship and ownership of copyright**

The ownership of copyright in a work vests in the author. Even if the work was done in terms of the author's employment with a public or private employer, the copyright vests in the employee. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to remain anonymous, and the right to object to distortion or mutilation of the work.

### **Duration of copyright**

In the case of all works except photographs, the copyright endures for the lifetime of the author plus 50 years. In the case of photographs, the duration is 25 years from the year in which the work was made.

### **Protection afforded by copyright**

Copyright confers on the owner the exclusive right to do or authorise the doing in Tunisia of any of the following acts:

- the reproduction of the work in any material form
- the communication to the public of the work by any means, such as performances by means of
  - a diffusion medium
  - broadcasting means
  - modes of transmission by cable or telecommunication



- the communication of a broadcast work to the public by wire, loudspeaker or other transmission device
- the translation or adaptation of the work.

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages.

### **Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith.

## **PLANT BREEDERS' RIGHTS**

### **Law**

- Law no 99-42 of 1999 on Seeds, Seedlings and New Plant Varieties
- Decree no 2002-3019 of 2002 ratifying the accession of the Republic of Tunisia to the International Convention for the Protection of New Varieties of Plants

Tunisia is a member of the UPOV Convention.

Plant breeders' rights can be obtained in Tunisia in terms of legislation of the Tunisian Ministry of Agriculture.

### **Protectable subject matter**

Protection can only be obtained for new varieties of kinds of plants as listed.

### **Application**

The requirements for filing an application for a plant breeder's right include the following:

- full details of the applicant
- power of attorney (simply signed)
- detailed specification of the plant variety
- priority document (if applicable)
- plant specimens for examination purposes.

### **Examination/procedure**

After a plant breeders' right application has been filed, the plant variety will be tested and examined under the supervision of the Ministry of Agriculture in Tunisia, for endorsements within 24 months from the filing date.

### **Convention priority**

Convention priority can be claimed from a corresponding European application.

### **Duration**

A plant breeders' right endures for 15 – 30 years (depending on the variety), running from the date of filing of the plant breeders' right application. Annual fees are payable as from the anniversary date of the filing of the application.

# UGANDA

## GENERAL INFORMATION

Uganda, an independent republic within the British Commonwealth, is situated in East Africa. It is a landlocked country bordered by South Sudan in the north, Democratic Republic of Congo in the west, Rwanda, Tanzania and Lake Victoria in the south, and Kenya in the east.



<b>Area:</b>	241 038 km <sup>2</sup>
<b>Population:</b>	33.4 million
<b>Capital:</b>	Kampala
<b>Currency:</b>	Ugandan Shilling
<b>GDP:</b>	\$ 41.7 billion (2010)
<b>Internet domain:</b>	.ug
<b>Languages:</b>	English (official language), Swahili, Luganda
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Coffee; cotton; tea; gold; fish products; horticultural products
<b>Imports:</b>	Petroleum; cereals; medical supplies; capital equipment; vehicles.

## International/regional conventions

Uganda is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 2000)
- Harare Protocol (of ARIPO) (since 1984)
- Lusaka Agreement (ARIPO) (since 1978)
- Nairobi Treaty on Olympic Symbols (since 1983)
- Paris Convention (since 1965)
- Patent Cooperation Treaty (since 1995)
- WIPO Convention (since 1973)
- WTO/TRIPS (since 1995)

## IP legislation

### Trade marks

- Trade Marks Act no 17 of 2010
- Trade Marks Rules (issued under the repealed Trade Marks Act, Chapter 217 of 1953 and expressly retained in force)
- Trade Marks Act, Chapter 217 of 1953 (repealed by the 2010 Act)

### Patents

- Patents Act, Chapter 216 of 1993
- Patents (Amendment) Act of 2002
- Patent Regulations, 1993

### Designs

- United Kingdom Designs (Protection) Act, Chapter 218 of 1937

### Copyright

- Copyright and Neighbouring Rights Act of 2006
- Copyright Act, Chapter 215 of 1964 (repealed by the 2006 Act)

## TRADE MARKS

### Law

- Trade Marks Act no 17 of 2010
- Trade Marks Rules (issued under the repealed Trade Marks Act, Chapter 217 of 1953 and expressly retained in force)
- Trade Marks Act, Chapter 217 of 1953 (repealed by the 2010 Act)

Uganda is a member of the Paris Convention, the ARIPO (Banjul Protocol), and the WTO/TRIPS.

**Note:** Although Uganda is a member of the Paris Convention, the Act does not make provision for claiming priority. It is therefore not clear whether convention priority can be claimed.

Furthermore, although Uganda is a member of the Banjul Protocol of ARIPO, no provision is made in Uganda's national law for the recognition of ARIPO registrations in which Uganda is designated, nor for the filing of ARIPO applications in Uganda.

### Trade mark protection

Provision is made in the Act for the registration of trade marks for goods and for services. However, as the Rules under the old Act are still in force, they make no provision for the classification or registration of services.

The Act also provides for certification marks as well as for defensive registration of trade marks, and for the registration of series of trade marks.

The Act further provides for the register to be divided into two Parts, Part A for trade marks which are distinctive, and Part B for trade marks which are capable of distinguishing.

### Protection of well-known marks

Although no express provision is made for the protection of well-known marks, the Act does provide for a trade mark registration to be removed on the ground that an identical or similar trade mark was, prior to the registration in Uganda, registered in respect of the same or similar goods or services in another country from which the goods or services originate. The application for the removal of the Uganda trade mark must be made within seven years of its registration.

### Advantages of trade mark registration

The Act provides that a person may not institute proceedings to prevent, or to recover damages for, any acts in regard to an unregistered trade mark, except that an action for passing-off will be available. However, once a trade mark has been registered, the owner shall have the exclusive right to the use of the trade mark in relation to the relevant goods or services, and shall have the right to institute court action against a person who infringes this exclusive right.

**Types of trade marks**

The Act provides for the registration of the following marks:

- trade marks for goods and services
- certification trade marks
- defensive trade marks
- series of trade marks.

**Definition of a mark**

Word and device marks (any sign, mark or combination of signs or marks) are allowed. A sign or mark is defined to include any word, symbol, slogan, logo, sound, smell, colour, brand, label, name, signature, letter, numeral, or any combination of them.

**Definition of a trade mark**

A trade mark is defined to mean a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

**Definition of a certification trade mark**

A mark adapted in relation to any goods to distinguish, in the course of trade, goods certified by a person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods not certified, will be registrable as a certification mark in Part A or Part B of the register. A certification mark in respect of services is registrable in Part A of the register.

**Registration of a defensive trade mark**

Where a trade mark relating to goods or services and consisting of an invented word or words, or a device or devices, or a combination thereof, has become so exceptionally well known in regard to the relevant goods or services that the use of that mark in relation to other goods or services is likely to detract from its distinctive character, then that trade mark may be registered by the owner also in relation to such other goods or services as a defensive trade mark, notwithstanding that the owner does not intend to use the trade mark in relation to such other goods or services.

In determining whether a trade mark is exceptionally well known, regard may be had to all related circumstances, including the length of time that the trade mark has been in use, the extent of its use and of its notoriety.

**Registration of a series of trade marks**

Where a person claims to be the owner of several trade marks in respect of the same goods or services, and the trade marks resemble each other but differ in regard to statements of the goods or services, or statements of number, price, quality or place names or in regard to other non-distinctive matter, or as regards colour, the trade marks may be registered as a series in one registration.

### **Limitation to colour**

A sign or mark is defined to include a colour, while a differentiating feature of a mark in a series may be its colour.

### **Classification**

While neither the Act nor the Rules specifically refer to classification, the International Classification of Goods and Services (Nice Classification) is applied. The goods (which correspond with the class headings of the Nice Classification) are set out in a schedule to the Rules. A single application may cover only one class.

### **Convention priority**

While Uganda is a member of the Paris Convention, the Act does not make provision for the claiming of priority. However, the Registry appears to accept priority applications.

### **Application**

An application is filed with the Uganda Registration Services Bureau (URSB), headed by the Registrar General and operating under the supervision of the Ministry of Justice and Constitutional Affairs.

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed), to be submitted with the application
- list of the goods or services for which registration is sought
- the trade mark, with a print of the mark if it is not a standard word mark.

### **Examination/procedure**

An application is examined as to formal and substantive requirements. If the application is accepted either with or without conditions, the application is published in the Gazette. If no opposition is filed within a period of 60 days, the registration certificate will be issued.

### **Opposition and procedure**

The Act makes provision for opposition within 60 days from publication of the acceptance. The opposition must be made in writing in the prescribed manner, and set out the grounds of opposition.

The copy of the opposition must be sent to the applicant, who must respond by lodging a counter-statement in the prescribed manner, setting out the grounds on which he relies for his application. If he does not send a counter-statement, he will be deemed to have abandoned his application. The Rules make provision for further evidence to be lodged.

After all evidence has been lodged, the Registrar will hear argument from both parties and thereafter make a decision as to whether registration will be permitted. Any party may appeal to the court against this decision.

### **Grounds of opposition**

An application may be opposed either on absolute or relative grounds. The grounds on which a mark may be opposed correspond with the requirements for a mark to be registrable.

With respect to absolute grounds for registration, a mark may be opposed if it does not meet the requirements set out in the Act that the mark must be distinctive, if the mark is proposed to be registered in Part A of the Register. A mark that is proposed to be registered in Part B of the register may be opposed if it does not meet the requirements in terms of the Act, including that the mark must be capable of distinguishing.

A mark may also be opposed on relative grounds, including that it is confusingly similar to an earlier registered trade mark. A trade mark relating to goods or services shall not be registered in respect of a description of goods or services, if the mark is identical with or nearly resembles a trade mark belonging to a different owner and already on the register in respect of:

- the same goods or services
- the same description of goods or services
- goods or services which are associated with those goods or services of the same description.

Other relative grounds on which a mark may be opposed in terms of the Act is if the registration of the mark would be likely to cause confusion or deception (due to the user rights of the opponent) or will be contrary to law or morality.

### **Duration and renewal**

A trade mark registration is effective for an initial period of seven years from the filing date of the application, and is thereafter renewable for consecutive periods of 10 years. Renewal must take place within the three months before, or within one month after, expiry of the preceding term. If the renewal fee is not paid within a month after expiry, the mark will be removed from the register. It may, however, be restored upon application in the prescribed form and upon payment of a renewal and restoration fee.

### **Cancellation/removal of a trade mark for non-use**

A registered trade mark may be removed from the register in respect of goods or services in respect of which it is registered, on application to the court or the Registrar of Trade Marks on the grounds that:

- the trade mark was registered without a *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any owner up to the date one month before the date of the application for cancellation
- at least one month prior to the date of the application, a continuous period of three years or more elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use in relation to those goods or services by any owner.

Cancellation may be refused if it is shown that there has in fact been *bona fide* use in relation to goods or services of the same description, or that the non-use was due to special circumstances in the trade and not to an intention not to use or to abandon the mark. Defensive registrations may not be removed due to non-use.

### **Cancellation/removal of a trade mark on other grounds**

In addition to the cancellation/removal of a mark on the ground of non-use as set out above, a trade mark may also be removed on other grounds:

- an aggrieved person may apply, within seven years of the registration of a mark, for the cancellation of the mark if it is proved that a trade mark identical to or nearly resembling the registered mark was registered in another country in respect of the same or similar goods or services, and the goods originate from such other country
- an aggrieved person may apply for the removal of a defensive trade mark registration on the ground that the requirements for such defensive registration are no longer satisfied
- a person aggrieved by an omission, entry, error, defect or an entry wrongly remaining on the register, may apply in the prescribed manner to the court or to the Registrar, and the court or the Registrar may make an order for making, expunging or varying the entry as the court or the Registrar may think fit.

After registration there is, therefore, provision for an aggrieved person to seek the removal of a registered trade mark from the register on the ground that the mark should not have proceeded to registration due to any of the absolute or relative impediments to registration, or that it has since the date of registration become generic or has become an entry that is, for whatever other reason, wrongly remaining on the register.

### **Use requirement**

A registered trade mark is vulnerable to cancellation if it has not been used for a continuous period of three years (see the section on **Cancellation/removal of a trade mark for non-use** above).

A proprietor cannot rely on the permitted use by a third party, unless the user is recorded as a registered user.

### **Assignment**

A registered trade mark may be assigned with or without the goodwill of a business, and in respect of any or all of the goods or services in respect of which it is registered. Recording of assignment is possible.

Requirements for recordal:

- power of attorney (simply signed)
- signed deed of assignment
- the registration number or a copy of the registration certificate.

### **Licensing/registered users**

Recording of licences or registered users is not required, but is recommended in practice to avoiding uncertainty.



Requirements for recordal:

- power of attorney (simply signed)
- signed licensing agreement
- the registration number or a copy of the registration certificate.

### **Amendments**

The Registrar or court may at any time before or after acceptance correct any error in the application, or may allow the applicant to amend his application. The Act or Rules do not place any limitations on what may be amended. It is also possible to amend a registered trade mark in certain respects, or effect corrections to a registration.

### **Rights conferred by registration**

The registration of a trade mark in Part A of the register gives the owner the exclusive right to the use of the trade mark in relation to the relevant goods or services. The owner also gets the right to institute court proceedings against any person who infringes this exclusive right.

The registration of a trade mark in Part B of the register gives the owner similar exclusive rights, except that the owner will not be entitled to an injunction (interdict) in certain circumstances.

### **Trade mark infringement**

The Act makes separate provision for the enforcement of trade marks that are registered in Parts A and B of the Register.

The proprietor of a trade mark or service mark, registered in the register, has the exclusive right to use the trade mark or service mark in relation to the goods or services covered by the registration. The proprietor of a registered trade mark or service mark is entitled to prevent the unauthorised use, in the course of trade, of marks that are identical to the registered trade mark or so nearly resembling the registered trade mark, in relation to the same goods or services, or goods or services of the same description to those covered by the registered trade mark as to be likely to deceive or cause confusion.

### **Defences to trade mark infringement**

A court will not grant an injunction for trade mark infringement if –

- the use of the mark is reasonably necessary in order to indicate that the services are available for that use
- the infringing use cannot be shown to create a connection in the course of trade with the trade mark proprietor
- the infringing use cannot be shown to be likely to cause deception and confusion, taking into account the scope of the proprietor's registration
- the defendant can show that it is making *bona fide* use of a trade mark that is already registered.

### **Relief for trade mark infringement**

The recognised remedies for trade mark infringement are –

- an injunction to stop trade mark infringement
- delivery-up of all goods, articles and materials bearing an infringing mark and where the mark cannot be separated from those goods, articles and materials
- damages or a reasonable royalty in lieu thereof
- an account of profits.

As indicated above, an injunction will not be granted in the case of Part B registrations if the defendant can satisfy the court that the use complained of by the owner is not likely to deceive or cause confusion, or the use is not likely to be taken as indicating a connection between the goods or services and the owner (or a registered user) of the mark.

### **Common law rights**

From an enforcement perspective, Uganda is a former British Colony and, as such, it recognises that a person who has acquired a reputation in a mark in relation to goods or services may prevent others from misrepresenting that they are associated with the proprietor in a manner that is likely to cause confusion and deception and damage to the person with a reputation.

This right is expressly recognised by the Trade Marks Act which states that nothing in the Act shall be taken to affect a right of action against a person for passing off goods or services as the goods or services of another or the remedies in respect of the right of action.

### **Marking of goods**

The marking of goods is optional.

## **PATENTS**

### **Law**

- Patents Act, Chapter 216 of 1993
- Patents (Amendment) Act of 2002
- Patent Regulations, 1993

Uganda is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### **Patent protection**

Patent protection is available via a national filing or via an ARIPO application designating Uganda. Uganda has implemented the Harare Protocol (which regulates patent filings in ARIPO) in its national law, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application.

Uganda has also implemented in its national law, by way of the Patents (Amendment) Act, 2002 the necessary provisions to recognise international applications under the PCT and designating Uganda, and to deal with national

phase PCT applications in Uganda. Therefore, Uganda can be designated in PCT international applications, and PCT national phase applications can be filed and processed in Uganda.

### **Types of patents**

The Act provides for the following:

- patents for inventions that are new, inventive and industrially applicable
- divisional patents, where an initial application covered more than one invention
- utility certificates, for inventions that are new and industrially applicable.

### **Patentable subject matter**

Inventions are patentable if they are new, involve an inventive step and are industrially applicable. An invention is new if it is not anticipated by prior art (see the section on **Novelty** below).

The following, even if they are inventions, are not patentable:

- discoveries and scientific and mathematical theories
- plant or animal varieties or essentially biological processes for the production of plants or animals, other than biological (*sic*; microbiological intended) processes and the products of such processes
- schemes, rules or methods for doing business, performing purely mental acts or playing games
- methods for treatment of the human or animal body by surgery or therapy as well as diagnostic methods (this restriction shall not apply to products for use in any of these methods)
- mere presentation of information.

### **Types of applications**

Application for a patent may be made by way of –

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Uganda is designated
- an ARIPO application designating Uganda
- a divisional application, where the original application covers more than one invention
- a utility certificate application, which (before refusal or grant) may be converted to a patent application.

### **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Uganda Patent Office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**. Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment from the inventor, or a statement by the applicant justifying his right to the invention (simply signed)
- specification (including claims, drawings and abstract), in English
- certified copy of the priority document (if applicable).

Failure to file the priority document within three months from the filing date will lead to the loss of the priority claim.

### **Applicant**

The inventor or his successor in title may apply. An assignment document is required if the applicant is not the inventor.

### **Novelty**

Absolute novelty is required. An invention is new if it is not anticipated by prior art. Prior art is considered to include everything made available to the public anywhere in the world, by means of written disclosure, including drawings and illustrations, or by oral disclosure, use, exhibition or non-written means.

### **Certain prior knowledge or publication excused**

A grace period of 12 months immediately preceding the Ugandan filing date is provided, where disclosure of the invention was by reason or in consequence of acts committed by the applicant or his predecessor in title, or an abuse committed in relation to the applicant or his predecessor in title.

### **Inventiveness**

An invention is considered as involving an inventive step, if it would not have been obvious to a person skilled in the art, having regard to the prior art.

### **Convention priority**

An applicant who has filed a patent application in a convention country is entitled to claim priority from such earlier application, provided the application in Uganda is filed within 12 months from the earlier application.

### **Examination/procedure**

A Uganda application is subjected to formal examination, which takes place automatically. The Registrar may request the applicant to furnish details of corresponding applications in other countries, and may further request that copies of the search report, granted patent, final rejection, etc be furnished. The Registrar may direct that substantive examination be conducted for particular applications according to the technical field of the invention. In that case, examination is carried out at the ARIPO Patent Office on behalf of the Uganda Registrar.

### **Opposition**

The Act does not provide for opposition to the grant of a patent by third parties.

**Publication**

After examination, if the Registrar is satisfied that the necessary requirements have been met, he shall grant the patent. Granted patents are published in the Gazette.

**Duration and maintenance**

A patent has an initial term of 15 years, but may be extended by a further five year period on payment of renewal fees and proof that the invention is being worked in Uganda.

Maintenance fees are calculated from the first anniversary of the filing date but become payable upon grant of a patent. Thereafter maintenance fees are due upon the anniversary of the filing date. A six months grace period is provided for payment of renewal fees, subject to payment of surcharges. If a renewal fee is not paid within this period, the patent lapses.

**Restoration**

If a renewal fee has not been paid, and within 12 months from expiration of the six months grace period for paying annuities, any interested person may, upon payment of the official fees, request the Registrar to restore an application or patent that has lapsed due to non-payment of maintenance fees.

**Revocation**

Any interested party can approach the court to revoke a patent on the following grounds:

- that the invention claimed is not an invention within the meaning of the Act
- that the invention claimed is excluded from patentability
- that the description and claims accompanying the application for grant of a patent did not comply with the requirements as set out in the Act
- that the person to whom the patent was granted had no right to it and the patent has not been assigned to the person who has the right to it.

**Assignments and licences**

Assignments and licences must be recorded to be effective against third parties.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- deed of assignment or licence contract (original or certified copy).

**Compulsory licences**

At any time after the expiration of three years from the date of grant of a patent or four years from the filing date of the patent application, whichever is the later, a person may, in proceedings between him and the owner of the patent, request the High Court to grant a compulsory licence on the followings grounds –

- that the invention, although capable of being work, has not been worked in Uganda

- that the existing degree of working of the patented invention in Uganda does not meet, on reasonable terms, the demand for the patented product in the domestic market
- that the working of the patented invention in Uganda is being hindered by the importation of the patented product
- that, by reason of the refusal of the patent owner to grant licences on reasonable terms, the industrial or commercial activities in Uganda are unfairly prejudiced.

The Act also provides that, if it is in the vital public interest, the Minister may direct that a patented invention be exploited by a government agent.

### **Amendments**

Amendments can be made prior to or even after grant, but any amendment may not go beyond the disclosure of the invention in the application as filed.

### **Effect of a patent**

The registration of a patent gives the owner the exclusive right to make, use, exercise and vend the invention, and the right to preclude any other person from exploiting the invention by doing any of the following acts without his authorisation:

- making, importing, offering for sale, selling and using the patented product
- stocking the product for purposes of sale
- using the patented process
- doing any of the prohibited acts in respect of the product of the patented process.

Any person who does any of the prohibited acts will be committing an infringement.

### **Infringement**

If the owner of a patent or the licensee is of the opinion that the patent has been infringed or is about to be infringed, he may institute infringement proceedings in the High Court for the following relief:

- damages
- an injunction to prevent infringement or continuing infringement of the patent
- any other civil remedy.

### **Marking**

No requirement.

### **Working**

A compulsory licence may be granted in cases of non-working (see the section on **Compulsory licences** above).

### **Utility certificates**

The Act provides for the granting of utility certificates in respect of inventions which are new and industrially applicable. It is not necessary for the inventions to involve an inventive step. A utility certificate expires, without a possibility of renewal, at the end of the seventh year after the date of filing.

At any time before the grant or refusal of a utility certificate, the application may be converted to a patent application. A patent application may likewise be converted to an application for a utility certificate.

## **DESIGNS**

### **Law**

- United Kingdom Designs (Protection) Act, Chapter 218 of 1937

Uganda is a member of the Paris Convention, ARIPO (Harare Protocol), and the WTO/TRIPS.

### **Design protection**

A United Kingdom design extends automatically to Uganda. Design protection is also available via an ARIPO application designating Uganda. However, Uganda has not implemented the Harare Protocol as far as industrial designs are concerned. Accordingly, it is not clear whether the rights derived from a design registered through ARIPO will be enforceable in Uganda.

### **Registrable subject matter**

Designs as protectable in the UK

### **Types of applications**

Design protection in Uganda can be obtained by:

- a UK design registration which extends automatically to Uganda
- an ARIPO application for the registration of a design, designating Uganda.

### **Application**

United Kingdom registered designs automatically extend to Uganda. As indicated above, application through ARIPO may also be possible inasmuch as Uganda has acceded to the Harare Protocol of ARIPO.

### **Duration and maintenance**

The UK design registration is effective in Uganda for as long as it endures in the UK. The duration of a design registration via ARIPO is 10 years (see the section on **Design protection** above).

### **Revocation**

Any person who alleges that his interests have been prejudicially affected may approach the court to declare, on any grounds on which the UK registration may have been cancelled, that exclusive rights in the design have not been acquired in Uganda. Such grounds include the publication of the design in Uganda prior to the date of registration in the UK.

**Effect of a design registration**

The registered owner of the UK design enjoys like privileges and rights in Uganda.

**Infringement**

The registered proprietor of a design shall not be entitled to recover damages in respect of any infringement of design from any defendant who proves that, at the date of the infringement, he was not aware and had no reasonable means of making himself aware of the existence of the registration of the design.

**COPYRIGHT****Law**

- Copyright and Neighbouring Rights Act of 2006
- Copyright Act, Chapter 215 of 1964 (repealed by the 2006 Act)

Uganda is not a member of the Berne Convention.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The law provides for copyright in respect of literary, scientific and artistic works, including:

- articles, books, pamphlets, magazines, lectures, addresses, sermons and other works of a similar nature
- dramatic and dramatic-musical works and musical works
- audiovisual works and sound recordings, including cinematographic works and other works of a similar nature
- choreographic works, pantomimes
- computer programs and electronic data banks and other accompanying materials
- works of painting, drawing, photography, typography, mosaic, architecture, sculpture, engraving, lithography and tapestry
- works of applied art, whether handicrafts or produced on industrial scale
- illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture and science
- derivative works which constitute original works
- works of folklore and traditional knowledge, science and art
- derivative works such as translations, adaptations, arrangements, and other transformation of pre-existing works; and collections of pre-existing works, like encyclopaedias and anthologies.

**Exclusions from copyright**

Excluded from protection are:

- ideas, concepts, procedures, methods or other similar things



- enactments, statutes, decrees, statutory instruments
- daily news, reports on current events or current information
- decrees, orders and decisions by courts or administrative bodies.

**Registration of copyright**

No requirement for registration.

**Requirements for subsistence of copyright**

To qualify for copyright, the author must be a citizen of Uganda or a resident of Uganda or the work must have been first published in Uganda. Although Uganda is not a member of the Berne Convention, copyright protection is extended to works eligible for protection in a country which is a member of certain international or regional organisations, such as WIPO, ARIPO, UNESCO, WTO/TRIPS.

**Authorship and ownership of copyright**

The copyright belongs to the person who created the work, ie the author. The work must be original and must be reduced to material form in any manner.

The ownership of copyright in a work initially vests in the author, unless the work was done in terms of a commission or in the course of the author's employment, in which case it vests in the person who commissioned the work or in the employer. The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The economic rights afford the owner the exclusive right to do or to authorise others to do the following:

- to publish, produce or reproduce the work
- to distribute the work, or make it available to the public
- to perform the work in public
- to broadcast the work
- to communicate the work to the public by wire or wireless means, including through the internet
- to make a derivative work
- to commercially rent or sell the original or copies of the work.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be recognised and acknowledged as the author, and the right to object to distortion or mutilation or alteration of the work. The moral rights may not be transferred during the life of the author.

**Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years.

In the case of all other works, the duration is 50 years from the date on which the work was made or was made available to the public.

The moral rights exist in perpetuity.

### **Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner:

- the doing of any listed acts by way of fair dealing for purposes of private use
- certain usages for teaching purposes in schools or universities or educational institutions
- use for purposes of quotation, with acknowledgment of the work
- use for purposes of current information, judicial proceedings
- transcription into Braille or sign language.

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article which he knows to be an infringing article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, inspection, removal or delivery-up of infringing articles, etc.

### **Criminal offences**

Certain infringing acts constitute criminal offences.

## **PLANT BREEDERS' RIGHTS**

Currently, no legislative provision for plant breeders' rights or other *sui generis* protection for plants is available in Uganda.

# ZAMBIA

## GENERAL INFORMATION

Zambia, an independent republic, is a landlocked country in southern central Africa, bordered to the north by Democratic Republic of Congo and Tanzania; to the east by Malawi and Mozambique; to the south by Zimbabwe, Botswana and Namibia, and to the west by Angola.



<b>Area:</b>	752 618 km <sup>2</sup>
<b>Population:</b>	13.5 million
<b>Capital:</b>	Lusaka
<b>Currency:</b>	Zambian Kwacha
<b>GDP:</b>	\$ 20 billion (2010)
<b>Internet domain:</b>	.zm
<b>Languages:</b>	English (official language), Bemba, Lozi, Tonga, Nyanja
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Copper; cobalt; tobacco; flowers; cotton
<b>Imports:</b>	Machinery; transportation equipment; foodstuffs; fuel; petroleum products; electricity; fertilizer; clothing.

## International/regional conventions

Zambia is a member of the following international/regional agreements:

- Berne Convention (since 1992)
- Harare Protocol (of ARIPO) (since 1986)
- Lusaka Agreement (ARIPO) (since 1978)
- Madrid Protocol on Marks (since 2001)
- Paris Convention (since 1965)
- Patent Cooperation Treaty (since 2001)
- WIPO Convention (since 1977)
- WTO/TRIPS (since 1995)

## IP legislation

### Trade marks

- Trade Marks Act no 14 of 1957 (Chapter 401) as amended several times, most recently by the Trade Marks Amendment Act no 17 of 1980 and no 13 of 1994
- Trade Mark Regulations, 1994

### Patents

- Patents Act no 13 of 1957 (Chapter 400) as amended several times, most recently by the Patents (Amendment) Act no 18 of 1980 and no 26 of 1987
- Patent Regulations, 1994

### Designs

- Registered Designs Act no 12 of 1958 (Chapter 402) as amended several times, most recently by the Registered Designs (Amendment) Act no 25 of 1987 and no 13 of 1994
- Registered Design Regulations, 1994

### Copyright

- Copyright and Performance Rights Act no 44 of 1994 as amended by the Copyright and Performance Rights (Amendment) Act no 25 of 2010

### Related areas

- Plant Breeders' Rights Act no 18 of 2007
- Plant Variety and Seeds Act no 21 of 1995 (Chapter 236)
- Plant Variety and Seeds Regulations, 1995

## TRADE MARKS

### Law

- Trade Marks Act no 14 of 1957 (Chapter 401) as amended several times, most recently by the Trade Marks Amendment Act no 17 of 1980 and no 13 of 1994
- Trade Mark Regulations, 1994

Zambia is a member of the Paris Convention, the Madrid Protocol, and the WTO/TRIPS.

Although Zambia is also a member of ARIPO, it has not acceded to the Banjul Protocol of ARIPO.

### Trade mark protection

Trade mark applications may be filed as national applications, in appropriate circumstances claiming convention priority in terms of the Paris Convention. Although Zambia is a member state of ARIPO, it has not acceded to the Banjul Protocol and has thus not enacted enabling legislation for the local recognition and protection of ARIPO trade mark registrations.

Provision is made for the registration of trade marks in respect of goods, either in Part A or Part B of the register, and for the registration of certification marks in Part C of the register. Defensive marks may be registered in Part D of the register.

### Protection of well-known marks

A well-known mark may be registered as a defensive mark in respect of goods or services in relation to which the owner has no intention of using the mark (see the section on **Registration of a defensive trade mark** below).

### Advantages of trade mark registration

The Act provides that no person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark. Registration of a trade mark gives the owner the right to institute proceedings for infringement. Moreover, the Act has special provisions to protect a registered trade mark against forgery and falsification.

**Types of trade marks**

Provision is made for the registration of:

- trade marks for goods
- certification trade marks
- defensive trade marks
- parts of marks
- series of marks.

There is no provision for registration of service marks.

**Definition of a mark**

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

**Definition of a trade mark**

A trade mark is defined to mean a mark used or proposed to be used in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right to use the mark.

**Definition of a certification trade mark**

A certification trade mark is defined to mean a mark adapted in relation to any goods, to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or any other characteristic, from goods not so certified. A certification mark is registrable in Part C of the register.

**Registration of a defensive trade mark**

Where a trade mark registered in Part A of the register has become so well known in respect of any goods, that the use thereof by another in relation to other goods would be likely to indicate a connection with the owner of the well-known mark, then, notwithstanding that such owner does not use or propose to use the mark in respect of such other goods, the mark may be registered as a defensive mark in Part D of the register. Non-use of the mark in regard to such other goods or services will not make the registration vulnerable to cancellation.

**Registration of parts of marks**

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part of the mark separately, he may apply to register the whole and any such part thereof as separate trade marks.

**Registration of series of marks**

Where a person claims to be the owner of several trade marks in respect of the same goods or services which, while resembling each other in material particulars, yet differ in regard to statements of the goods or services, or statement of number, price, quality or names of places, or in regard to any other non-distinctive matter or colour, such person may register these marks as a series by way of one registration.

### **Limitation to colour**

A trade mark may be limited in whole or in part to one or more specified colours. If a trade mark is registered without limitation of colour, it is deemed to be registered for all colours.

### **Classification**

The International Classification of Goods is applied. A separate application is required for each class of goods. There is no provision for services.

### **Convention priority**

As Zambia is a member of the Paris Convention, priority can be claimed. Any person who has applied for protection of a trade mark in a convention country is entitled to registration of the trade mark in priority to other applicants, and the registration will have the same date as that of the application in the convention country. Such an application must be filed within six months of the date of the application in the convention country.

### **Application**

An application for registration of a trade mark is made to the Registrar in the prescribed manner for registration either in Part A or B of the register.

In order to be registrable in Part A of the register, the mark must contain or consist of a distinctive feature, which may be the name of a company or individual, the signature of the owner, an invented word or any other distinctive mark. In order to be registrable in Part B of the register, the mark must be capable of distinguishing the relevant goods. The ability to distinguish may be acquired through use.

The following information and documents are required:

- full particulars of the applicant
- list of goods
- representation of the mark
- power of attorney (simply signed)
- certified copy of the basic application (if priority is claimed), together with translation (if applicable).

### **Examination/procedure**

Examination takes place as to inherent registrability and conflict with prior registrations or pending applications. Once examined and accepted, whether absolutely or subject to conditions or limitations, the application is advertised for opposition purposes. Should there be no opposition, the application proceeds to registration.

### **Opposition**

Once a trade mark application has been advertised for opposition purposes in the Trade Mark Journal, any person can oppose the application within two months of the date of advertisement. This deadline is not extendible.

**Opposition proceedings**

Opposition proceedings are commenced by lodging with the Registrar a notice of opposition and a statement of the grounds of opposition.

If the opposition is based on the fact that the mark applied for is similar to a mark already registered, the opponent must include the trade mark number and the date of publication of that trade mark in the Trade Mark Journal.

The Registrar must forward a copy of the opposition to the trade mark applicant. The applicant is obliged to file a counter-statement, setting out the grounds on which the applicant relies to support his application, within two months of receipt of the notice of opposition.

The counter-statement is then forwarded to the opponent. In the event that the applicant fails to file a counter-statement, the trade mark application is deemed to be abandoned. Within two months of receipt of the applicant's counter-statement, the opponent must submit evidence to the Registrar, by way of affidavit or solemn declaration, in support of his opposition. A copy of the evidence is furnished to the applicant. If the opponent does not file evidence, the opposition to the trade mark application is deemed to be abandoned.

On receipt of such evidence, the applicant must also, within two months, file evidence by way of an affidavit or solemn declaration to support his application. The applicant is deemed to have withdrawn his application if he does not file his evidence, or fails to notify the Registrar that he will not adduce evidence in support of his application.

The opponent may file evidence in reply; a copy is provided to the trade mark applicant. Any further evidence can only be submitted with leave from the Registrar.

A hearing then takes place before the Registrar who makes a determination.

It is possible to file an appeal against the Registrar's decision to the High Court. The High Court's decision may be appealed to the Supreme Court.

**Grounds of opposition**

According to the Act, it shall not be lawful to register as a trade mark any matter, the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or would include a scandalous design.

No trade mark may be registered that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

The Act does, however, make provision for honest concurrent use applications, when the proprietor of a trade mark already registered will not be able to oppose the registration of an identical or similar mark if the latter mark had continuously been used from an earlier date (see the section on **Common law rights** below).

**Note:** A recent Supreme Court of Appeal decision has supported a ruling from the Registrar (upheld on appeal by the High Court) that common law user rights do not form the basis for an opposition.

### **Duration and renewal**

The duration of a trade mark registration is seven years, but it may be renewed for further periods of 14 years from the date of the original registration. The proprietor of the trade mark must apply for the renewal within six months of the expiration of the last registration period. If no renewal fee has been paid at the date of expiration, the Registrar will advertise this fact in the Journal. The proprietor then has one month within which to effect the renewal, by payment of the renewal and penalty fees.

If the renewal fee is not paid, the Registrar may remove the mark from the register. The proprietor may apply for restoration in the manner prescribed.

### **Cancellation/removal of a trade mark**

A registered trade mark may be cancelled or removed from the register in any of the following circumstances:

- an aggrieved person may apply to the Registrar or the High Court for such an order as the High Court or the Registrar may think fit, for expunging or varying the registration of a trade mark on the ground of any contravention or failure to observe a condition entered on the register in relation to the trade mark
- any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar for an order for making, expunging or varying the entry as the High Court or the Registrar may think fit.

### **Use requirement and cancellation**

A trade mark may be removed from the register for non-use on application by an aggrieved person to either the High Court or the Registrar on the following grounds:

- that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods for the time being up to the date one month before the date of the application,
- that up to the date of one month before the date of the application, a continuous period of five years or longer has elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to the relevant goods.



The Registrar or High Court may order that certain limitations be entered in respect of a trade mark registration where, in relation to any goods in respect of which a trade mark is registered –

- it has been shown that the trade mark has not been used in a particular place in Zambia, or it has not been used in respect of exports to a particular market outside Zambia, and
- a person has been permitted to register, in terms of the honest concurrent use provision, a trade mark that is identical or nearly resembling the trade mark, for use in relation to goods to be sold in that place in Zambia or to be exported to a particular market outside Zambia.

An applicant for expungement shall not be entitled to rely on any non-use of a trade mark that is shown to have been due to special circumstances in the trade, and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

### **Assignment**

Assignments are possible and a registered trade mark is assignable with or without the goodwill of the business.

Requirements for recordal:

- power of attorney by the assignee (simply signed)
- deed of assignment.

### **Licensing/registered users**

Licence agreements are to be recorded in order to be effective against third parties.

Requirements for recordal:

- power of attorney by the proprietor (simply signed)
- power of attorney by the user (simply signed)
- licence agreement.

### **Amendment**

Amendments of trade mark registrations are possible; these include:

- correcting any error, or entering any change in the name, address or description of the registered proprietor
- cancelling the entry of a trade mark on the register
- striking out any goods or classes of goods in respect of which a trade mark is registered
- entering a disclaimer to the trade mark.

Requirements for amendment:

- power of attorney (simply signed)
- supporting documents.

### **Rights conferred by registration**

The valid registration of a trade mark gives the proprietor the exclusive right to the use of the trade mark in relation to the relevant goods. That right is deemed to be infringed by any person who uses a mark identical with or so

closely resembling the registered mark in relation to the relevant goods as to be likely to deceive or cause confusion in the course of trade.

### **Trade mark infringement**

Any action or legal proceedings relating to the infringement or passing-off of a trade mark shall be brought in the High Court. No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade mark, but the right of action against any person for passing off goods as the goods of another person (or the remedies in respect thereof) is not affected.

As indicated above, the registration of a person as the proprietor of a trade mark in respect of any goods gives that person the exclusive right to use the trade mark in relation to those goods, and that right is deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user, uses a mark identical with or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade.

Furthermore, where a purchaser or owner of goods enters into a contract with the proprietor of a trade mark, to the effect that he will not do, in relation to the goods, certain acts as specified below, he will infringe the trade mark if he does in fact carry out those restricted acts (unless certain specific circumstances apply).

The applicable acts are:

- the application of the trade mark upon the goods after they have undergone alteration in any manner specified in the contract as regards their state or condition, get-up or packaging
- in a case in which the trade mark is already upon the goods, the alteration, partial removal or partial obliteration thereof
- in a case in which the trade mark is used upon the goods and there is also other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration of the trade mark unless that other matter is also removed or obliterated
- in a case in which the trade mark is used upon the goods, the application of any other trade mark to the goods
- in a case in which the trade mark is used upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

### **Defences to trade mark infringement**

The rights in a trade mark shall be deemed not to be infringed in the following cases:

- where the right given to the proprietor by the registration of a trade mark is subject to conditions or limitations entered on the register, it shall not be infringed by the use of the mark in any manner to which, having regard to such limitations, the registration does not extend

- where a registered trade mark is one of two or more registered trade marks that are identical or that nearly resemble each other, the use of the mark shall not be deemed to be an infringement of the right given in respect of any other of those trade marks
- a trade mark will not be infringed by the use of such mark in relation to goods, connected in the course of trade with the proprietor or a registered user of the trade mark, if the proprietor or the registered user has applied the trade mark and has not subsequently removed or obliterated it
- a trade mark registration will not be infringed by the use of the mark by any person in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark is used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted.

Furthermore, a proprietor of a registered trade mark shall not be entitled to interfere with, or restrain the use by, any person of a trade mark identical to or nearly resembling the proprietor's trade mark, in relation to goods on which that person or his predecessor in title has continuously used that trade mark from a date anterior to the use of the trade mark in relation to those goods by the proprietor, or the registration of the trade mark in respect of those goods in the name of the proprietor.

No registration of a trade mark shall interfere with:

- any *bona fide* use by a person of his own name or of the name of his place of business, or those of any of his predecessors in business
- the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that is likely to be taken as importing a connection with the proprietor of the registered trade mark.

### **Relief for trade mark infringement**

The Act does not specify the relief available in the case of infringement. Generally this will include an injunction, damages and, in appropriate circumstances, delivery-up or seizure of infringing goods.

### **Common law rights**

Some common law rights are recognised and protected. Thus the Act provides that the proprietor of a registered trade mark shall not be entitled to interfere with or restrain the use by any person of a trade mark identical with or closely resembling the registered mark in relation to similar goods, if such other person has continuously used the mark from a date anterior to the registration of the registered mark, or the use of the registered mark by the proprietor thereof.

The proprietor may also not object to the other mark being registered on the basis of honest concurrent use.

**Marking of goods**

Notice of registration by use of the symbol ® is optional. Falsely representing that a trade mark is registered if it is in fact not registered, is an offence.

No product may bear the national flag or the armorial signs of Zambia or any part thereof, without official written permission. Imports of merchandise bearing false or deceptive trade descriptions are prohibited.

**PATENTS****Law**

- Patents Act no 13 of 1957 (Chapter 400) as amended several times, most recently by the Patents (Amendment) Act no 18 of 1980 and no 26 of 1987
- Patent Regulations, 1994

Zambia is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

**Patent protection**

Patent protection is obtainable by way of a patent granted on a national filing or a regional filing through ARIPO. A patent is granted in respect of an invention which entails patentable subject matter (see the section on **Patentable subject matter** below).

Although Zambia has also acceded to PCT, specific provisions to implement the filing and prosecution of PCT applications have not yet been introduced into the Act. However, the Act contains a general provision which empowers the Minister to make regulations, by statutory instrument, for securing that a patent application made in accordance with an agreement by the Zambian Government with another country shall not be prejudiced. It is possible that this provision may be used to deal with PCT applications.

**Types of patents**

Provision is made for:

- patents for inventions which are new, inventive and industrially applicable
- patents of addition, in respect of improvements or modifications of a main invention.

**Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable. An invention is defined to mean any new and useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, and capable of being applied in trade or industry.

**Types of applications**

- a non-convention provisional application, where the application is accompanied by a provisional specification and the effective date is the filing date of the application
- a non-convention complete application, where the application is accompanied by a complete specification and the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Zambia is designated
- an ARIPO application designating Zambia
- an application for a patent of addition, to cover improvements or amendments of the invention of the original patent.

**Application**

Patent applications are filed with the Zambian Patent Office.

Filing requirements:

- full particular of the applicant
- power of attorney (simply signed)
- assignment of invention (if the applicant is not the inventor)
- specification (including claims, abstract and drawings), in English
- certified copy of the priority document (if applicable).

**Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention.

**Novelty**

An invention is new if it has not been publicly used, worked, or publicly made known in Zambia, or described in books or other printed publications published anywhere, before the application or priority date. More specifically the Act provides that an invention is new if it was not –

- known or used in Zambia or the territories of the former Federation of Rhodesia and Nyasaland by anyone other than the applicant (secret knowledge or use being excluded)
- worked anywhere in the territories by the applicant otherwise than by way of reasonable technical trial or experiment
- described in a patent specification available to public inspection and with a date less than 50 years prior to the effective date of the application
- described in writing in any publication of which there was a copy anywhere in the territories, or a publication printed and published elsewhere less than 50 years prior to the effective date of the application
- claimed in a complete specification in an application with an earlier effective date.

### **Certain prior knowledge or publication excused**

Novelty of an invention is not destroyed by disclosure prior to the application or convention priority date without the patentee's knowledge or consent –

- if the matter disclosed was derived or obtained from the patentee
- if the invention had been used by the patentee or his predecessor in title in Zambia prior to the application filing date or priority date, for the purpose of reasonable technical trial thereof

and the application was filed with reasonable diligence after learning of the disclosure.

### **Convention priority**

Zambia is a member of the Paris Convention and the Act provides that an application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by an applicant in or for any state party to the Paris Convention.

### **Examination/procedure**

Applications are subjected to formal examination only, for compliance with the formal requirements of the Act. If the application is found to be in compliance, the Registrar will accept the application. Acceptance must take place within 30 months from the filing date.

### **Publication**

Upon compliance with the formal requirements and acceptance of the application, the Registrar will notify the applicant who must advertise the acceptance of the application.

### **Opposition**

Any interested person may within three months from the date of the advertisement of the acceptance of the application, file an opposition application with the Registrar's office. The Act prescribes the grounds on which an opposition may be based; these include:

- that the applicant is not a person entitled to make the application
- that the application is in fraud of the rights of the person opposing the application
- that the invention does not comply with the definition of an invention
- that the invention is obvious
- that the invention is not useful
- that the complete specification does not fully describe the invention
- that the claims do not sufficiently and clearly define the subject matter to be protected
- that the invention is not new.

### **Duration and maintenance**

Granted patents are valid for 16 years calculated from the filing date. Renewal fees are payable and are calculated from the first anniversary of filing. A grace period of six months is allowed for the late payment of the renewal fees, subject to payment of surcharges. Failure to pay a renewal fee causes the patent to lapse.

### **Restoration**

The patentee can file a restoration application with the Registrar's office, where the patent lapsed due to non-payment of renewal fees. The patentee must satisfy the Registrar that the failure to pay the renewal fee was unintentional and that no undue delay has occurred in making the application for restoration.

### **Revocation**

Any interested party may request the court to invalidate a patent or claim on the basis of non-compliance with formal and substantive requirements. Revocation can be requested on any ground on which an opposition could have been based (see the section on **Opposition** above). Invalidation of a patent can also be requested on the basis that the owner of the patent is not the inventor or the inventor's successor in title, or that the application contains a material misrepresentation.

### **Assignments and licences**

Assignments and licence contracts will have no effect against third parties until they are recorded at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

On request made to the Registrar after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the Registrar may issue a compulsory licence on the basis that the reasonable requirements of the public with respect to the invention have not been satisfied, or that the patentee refuses to grant licences on reasonable terms.

The reasonable requirements of the public shall be deemed not to have been satisfied *inter alia* in the following circumstances:

- if the patented invention, which is capable of being worked in Zambia, is not worked in that country on a commercial scale and there is no satisfactory reason for such non-working
- if the working of the patented invention in Zambia is being hindered by importation of the patented product
- if the demand for the patented product in Zambia is not being met to an adequate extent and on reasonable terms
- if the trade or industry in Zambia is being prejudiced by the refusal of the patentee to grant licences on reasonable terms.

The Act also makes specific provision for compulsory licences to be granted where a patent relates to a substance capable of being used as food or medicine, or to a process for producing such a substance, or to an invention capable of being used in surgical or curative devices. In granting a

compulsory licence, the court will endeavour to ensure that food, medicines and surgical or curative devices are available to the public at the lowest prices consistent with the patentee deriving a reasonable remuneration.

### **Amendments**

The applicant may, up to the time when the application is accepted, amend the application, provided the amendments shall not go beyond the disclosure in the initial application. After the application has been accepted, the applicant can only correct obvious mistakes.

### **Effect of a patent**

The effect of a patent shall be to grant to the patentee full power, sole privilege and authority to make, use, exercise and vend the invention in Zambia, so that he shall enjoy the whole profit and advantage accruing by reason of the invention during the term of the patent.

### **Infringement**

Enforcement of patent rights takes place by way of a civil action in the High Court. Remedies available to the patentee include damages, injunction (interdict), and inspection or account of profits.

### **Working**

A granted patent must be worked within four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, failing which makes the patent vulnerable to compulsory licences (see the section on **Compulsory licences** above).

## **DESIGNS**

### **Law**

- Registered Designs Act no 12 of 1958 (Chapter 402) as amended several times, most recently by the Registered Designs (Amendment) Act no 25 of 1987 and no 13 of 1994
- Registered Design Regulations, 1994

Zambia is a member of the Paris Convention, ARIPO (Harare Protocol), and the WTO/TRIPS.

### **Design protection**

Design protection is available by a national filing or via an ARIPO application designating Zambia. Zambia has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, thereby giving valid design protection to applicants seeking to obtain a design registration via ARIPO.

### **Registrable subject matter**

A design is defined to mean features of shape, configuration, pattern or ornamentation applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or



features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.

### **Classification of designs**

No provision.

### **Types of applications**

Application for the registration of a design may be made by way of:

- a non-convention application, where the effective date is the filing date
- a convention application, where the effective date will be the date of the first-filed application under the Paris Convention
- an ARIPO application designating Zambia.

### **Application**

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Zambia Designs office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**.

Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- deed of assignment (if applicable)
- representations of the design
- certified copy of the priority document (if applicable).

### **Applicant**

The creator of the design may apply, or his successor in title.

### **Convention priority**

Zambia is a member of the Paris Convention. Accordingly, priority can be claimed provided the application is filed in Zambia within six months from the priority date.

### **Novelty**

An application must be filed before the design is published in Zambia. Confidential disclosure of the design by the proprietor does not destroy novelty, nor does disclosure in bad faith by a third party, the first confidential order for goods bearing a textile design, or the communication of the design by the proprietor to any authorised government personnel.

### **Examination/procedure**

The Zambian Designs office conducts a formal examination and may subject the design to substantive examination. Substantive examination is in respect of novelty and originality of the design.

### **Opposition**

No provision.

### **Duration and maintenance**

The initial term of the design registration is five years, which term is extendible upon payment of renewal fees for two further five year terms. Renewal must be effected before the expiration of the current term; a grace period of three months may be granted.

### **Restoration**

No provision.

### **Revocation**

The Registrar may, upon the application by an interested person, cancel the registration of a design on the following grounds:

- that the design was not new or original
- that the design corresponded to an artistic work in respect of which copyright subsisted
- that the copyright in that artistic work has expired
- that a ground exists on which the registration could have been refused.

### **Assignments and licences**

Assignments and licence contracts will have no effect against third parties unless recorded at the Registrar's office.

Requirements:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

It is a requirement for a registered design to be worked in Zambia, failing which the design will be open for compulsory licence. Within three years of grant or four years of filing the application, anyone interested may apply for a compulsory licence on the ground that the design is not being applied in Zambia by any industrial process to a reasonable extent.

### **Rights conferred by registration**

The registration of a design gives to the registered owner the copyright in the registered design, namely the exclusive right in Zambia to make or import for sale or for the purpose of trade or business, or to sell, hire, or offer for sale or hire, any article to which the design, or a design not substantially different, has been applied.

### **Infringement**

Infringement proceedings may be brought in a competent court on a civil basis. Remedies include interdict (injunction) and damages.

**Marking**

It is not compulsory to mark a registered design. However, it is a criminal offence to falsely indicate or mark that a design is registered.

**Working**

Registered designs must be worked in Zambia (see the section on **Compulsory licence** above).

**COPYRIGHT****Law**

- Copyright and Performance Rights Act no 44 of 1994 as amended by the Copyright and Performance Rights (Amendment) Act no 25 of 2010

Zambia is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

**Subject matter eligible for protection**

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- computer programs
- compilations
- audiovisual works
- sound recordings
- broadcasts
- cable programs
- typographical arrangements of published editions.

Literary works are further defined to include dramatic works and arrangements of information in tabular form.

Artistic works are further defined to include:

- paintings, drawings, etchings, lithographs, woodcuts, engravings, prints
- maps, plans, charts, diagrams, illustrations and sketches
- works of sculpture
- works of architecture in the form of buildings and models
- photographs.

Copyright shall not subsist in a literary or musical work or in a computer program unless it is recorded in writing or some other form, and in the case of all works unless certain requirements are met (see the section on **Requirements for subsistence of copyright** below).

**Requirements for subsistence of copyright**

There is no requirement for registration. For a work to qualify for protection, the author must be a citizen of Zambia or a convention country, or domiciled or ordinarily resident in Zambia or a convention country. Alternatively, the work must have been made or first published in Zambia or a convention country.

**Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless the work (other than a broadcast or cable program) was made by the author in the course of his employment or on commission from some other person, in which case the employer or the person who commissioned the work will be the first owner of the copyright.

The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be identified and recognised as the author, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights may not be transferred during the life of the author.

**Duration of copyright**

In the case of literary, musical and artistic works or compilations the copyright endures for the lifetime of the author plus 50 years.

In the case of all other works, the duration is 50 years from the date on which the work was made or was made available to the public or published.

**Protection afforded by copyright**

Copyright generally confers on the owner the exclusive right to control the doing in Zambia of any of the following acts:

- publishing the work
- reproducing the work in any material form
- broadcasting the work, or causing it to be included in a cable program
- communicating the work to the public
- importing the work or copies thereof into Zambia
- making an adaptation of the work
- doing any of the above in regard to an adaptation of the work.

**Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner:

- fair dealing with a work for purposes of research, private use or study
- fair dealing with a work for criticism or review or news reports
- reproduction of a work for judicial proceedings
- different usages for teaching in schools or educational purposes
- the making of copies to conserve or replace works in libraries or archives
- the use of quotations from works.

**Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

**Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

**Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner:

Copyright is also infringed by any person who –

- without the consent of the copyright owner, imports into Zambia otherwise than for private use, or who possesses in the course of trade or business, or sells or lets for hire, or exhibits in public or distributes articles which are infringing copies of a work, unless such person can prove that he did not know and had no reasonable grounds for knowing that the articles were infringing copies
- without the consent of the copyright owner, makes or causes to be made, or imports into Zambia, or sells or lets for hire, an article specifically adapted to make copies of a work, unless such person can prove that he did not know and had no reasonable grounds to know that he would be infringing.

**Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, account of profits, delivery-up of infringing articles, etc.

**Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith or without knowing of the infringement.

**PLANT BREEDERS' RIGHTS****Law**

- Plant Breeders' Rights Act no 18 of 2007
- Plant Variety and Seeds Act no 21 of 1995 (Chapter 236)
- Plant Variety and Seeds Regulations, 1995

Zambia is not yet a member of the UPOV Convention for the protection of new varieties of plants.

**Protection**

The effect of protection by way of a plant breeder's right is that the holder (or his licensee) has the exclusive right to act in relation to propagating material of the variety, such as produce/reproduce the material, offer the material for sale, etc.

### **Protectable subject matter**

Protection by way of a plant breeder's right can be obtained only for certain plant species as listed in the Regulations.

### **Requirements for registrability**

In order to qualify for registration, and hence for protection under a plant breeder's right, a plant variety must be new, distinct, stable and uniform.

A plant is deemed new if, at the date of filing of the application, propagating or harvested material of the variety has not been sold or otherwise disposed of by or with the breeder's consent, for more than one year in Zambia, or for more than six years (any tree or vine) and four years (other varieties) outside Zambia.

### **Application**

The requirements for filing a plant breeder's right application include

- an application form for plant variety denomination
- a plant breeder's right application form
- an authorisation of agent
- results of DUS (distinctness, uniformity and stability) examinations conducted elsewhere.

Seed/planting material may be required if the authorities wish to subject the new variety to DUS (distinctness, uniformity and stability) testing.

### **Denomination of variety**

A single and distinct denomination of a variety is required.

### **Applicant**

A breeder of a new plant variety, or the breeder's successor, may apply for a plant breeder's right.

### **Convention priority**

Priority can be claimed from an earlier application in another country which is a party to a bilateral or a multilateral agreement concerning plant variety protection to which Zambia is also a party.

### **Duration**

A plant breeder's right endures for 20 years in the case of an annual crop, and for 25 years in the case of any tree and any other perennial, commencing from the date of grant.

## ZIMBABWE

Zimbabwe is a landlocked independent republic located in the southern part of the African Continent, bordered by Zambia to the northwest, Mozambique to the north and east, South Africa to the south, Botswana to the southwest, and with Namibia sharing a border post on the western tip of Zimbabwe.



<b>Area:</b>	390 757 km <sup>2</sup>
<b>Population:</b>	12.5 million
<b>Capital:</b>	Harare
<b>Currency:</b>	Zimbabwean Dollar
<b>GDP:</b>	\$ 4.4 billion (2010)
<b>Internet domain:</b>	.zw
<b>Languages:</b>	English (official language), Shona, Ndebele
<b>Working week:</b>	Monday - Friday
<b>Exports:</b>	Tobacco; gold; chromium; ferro alloys; cotton; platinum
<b>Imports:</b>	Machinery and transport equipment; chemicals; fuels; food products

### International/regional conventions

Zimbabwe is a member of the following international/regional agreements:

- Banjul Protocol (of ARIPO) (since 1997)
- Berne Convention (since 1980)
- Harare Protocol (of ARIPO) (since 1984)
- Lusaka Agreement (ARIPO) (since 1980)
- Paris Convention (since 1980)
- Patent Cooperation Treaty (since 1997)
- WIPO Convention (since 1981)
- WTO/TRIPS (since 1995)

### IP legislation

#### Trade marks

- Trade Marks Act no 2 of 1974 (Chapter 26:04) as amended several times, most recently by the Amendment Act no 22 of 2001
- Trade Mark Regulations, 2005
- Merchandise Marks Act no 9 of 1974 (Chapter 14:13) as amended by the Amendment Act no 22 of 2001

#### Patents

- Patent Act no 26 of 1971 (Chapter 26:03) as amended several times, most recently by the Patents (Amendment) Act no 9 of 2002

#### Designs

- Industrial Designs Act no 17 of 1971 (Chapter 26:02) as amended several times, most recently by the Designs (Amendment) Act no 25 of 2001

### Copyright

- Copyright and Neighbouring Rights Act 11 of 2000 (Chapter 26:05) as amended, most recently by the Copyright (Amendment) Act no 32 of 2004
- Copyright and Neighbouring Rights Regulations, 2006

### Related areas

- Plant Breeders Rights Act no 53 of 1973 (Chapter 18:16) as amended, most recently by the Plant Breeders Rights (Amendment) Act no 11 of 2001 and the Amendment Act no 22 of 2001

## TRADE MARKS

### Law

- Trade Marks Act no 2 of 1974 (Chapter 26:04) as amended several times, most recently by the Amendment Act no 22 of 2001
- Trade Mark Regulations, 2005
- Merchandise Marks Act no 9 of 1974 (Chapter 14:13) as amended by the Amendment Act no 22 of 2001

Zimbabwe is a member of the Paris Convention, the ARIPO (Banjul Protocol), and the WTO/TRIPS.

### Trade mark protection

The Act provides for the registration of trade marks in respect of goods and services. The protection afforded by registration extends to the use of an identical mark or a mark so nearly resembling the registered mark as to be likely to deceive or cause confusion, in relation to the goods or services in respect of which the mark is registered.

The Act provides for registrations of trade marks in Part A or Part B of the register; certification marks are registered in Part C of the register; defensive marks are registered in Part D of the register.

### Protection of well-known marks

A well-known mark may be registered as a defensive mark in respect of goods or services in relation to which the owner has no intention of using the mark (see the section on **Registration of a defensive trade mark** below).

The Act also provides specific protection to so-called familiar foreign marks where the owner is a national of, or has an effective commercial establishment in, a convention country. Such owner may institute proceedings to prohibit the use in Zimbabwe of a trade mark which constitutes a reproduction or imitation of the familiar foreign mark, where such use will cause deception or confusion, or will prejudice the interests of the owner of the foreign mark.

### Advantages of trade mark registration

The Act provides that no person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an



unregistered trade mark. Registration of a trade mark gives the owner the right to institute proceedings for infringement. Moreover, the Act has special provisions to protect a registered trade mark against forgery and falsification.

### **Types of trade marks**

The following types of trade marks are registrable:

- goods and service marks
- certification marks
- collective mark
- defensive marks for well-known marks
- series of marks
- parts of marks.

### **Definition of a mark**

A mark is defined to mean any sign which can be represented graphically and is capable of distinguishing the goods and/or services of one undertaking from those of other undertakings.

### **Definition of a trade mark**

A trade mark is defined to mean a mark which is used or proposed to be used in relation to goods or services for the purpose of –

- indicating a connection in the course of trade between the goods or services and some person having the right, either as proprietor or registered user, to use the mark, and
- distinguishing the goods or services from the same kind of goods or services connected in the course of trade with any other person.

### **Definition of a certification trade mark**

A certification mark is a mark suitable, in relation to goods or services, to distinguish in the course of trade, goods or services certified by any person in respect of origin, material, mode of manufacture or performance, quality, accuracy or any other characteristic from goods or services not so certified. A certification mark is registered in Part C of the register.

### **Registration of a defensive trade mark**

Where a trade mark registered in Part A of the register has become so well known in respect of any goods or services, that the use thereof by another in relation to other goods or services would be likely to indicate a connection with the owner of the well-known mark, then, notwithstanding that such owner does not use or propose to use the mark in respect of such other goods or services, the mark may be registered as a defensive mark in Part D of the register. Non-use of the mark in regard to such other goods or services will not make the registration vulnerable to cancellation.

### **Registration of parts of marks**

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part of the mark separately, he may apply to register the whole and any such part thereof as separate trade marks.

**Registration of series of marks**

Where a person claims to be the owner of several trade marks in respect of the same goods or services which, while resembling each other in material particulars, yet differ in regard to statements of the goods or services, or statement of number, price, quality or names of places, or in regard to any other non-distinctive matter or colour, such person may register these marks as a series by way of one registration.

**Registration of collective marks**

A collective mark is defined as a mark that is capable of distinguishing, in the course of trade, goods or services of persons who are members of an association from goods or services of persons who are not such members. Collective marks may be registered in such Part of the register as the Controller may determine.

**Limitation to colour**

A trade mark may be limited in whole or in part to one or more specified colours. If a mark is registered without limitation as to colour, it is deemed to be registered for all colours.

**Classification**

The International Classification of Goods and Services (Nice Classification) is applied. A separate application has to be filed for each class of goods or services.

**Convention priority**

Since Zimbabwe is a member of the Paris Convention, the filing date of an earlier foreign application in a convention country can be claimed as the priority date, provided the application in Zimbabwe is filed within a six month period of such earlier filed foreign application.

Specific provision has also been made for the recognition of applications filed in terms of the Banjul Protocol of ARIPO, in which Zimbabwe is designated. A trade mark which has been registered by ARIPO in terms of an application shall have the same effect as a trade mark registered under the Act.

**Application**

The following information and documents are required:

- full particulars of the applicant
- power of attorney (simply signed)
- list of goods and services to be covered
- specimen of the trade mark
- priority document (certified copy; if applicable).

**Examination/procedure**

Applications are examined as to inherent registrability and for conflict with prior registrations and/or pending applications.

If the application for registration is accepted, the applicant must advertise the acceptance.

### **Opposition**

Any person may, within two months of the advertisement of the acceptance, give notice to the Registrar of opposition to the registration. Extensions of time may be granted by the Registrar.

### **Opposition proceedings**

The notice of opposition must be in writing and must include a statement setting out the grounds of opposition. The Registrar must provide the applicant with a copy of the opposition, and the applicant must then, within two months, submit a counter-statement setting out the grounds on which he relies in support of the application. If the applicant fails to submit a counter-statement, the trade mark application shall be deemed to have been abandoned.

The Registrar must provide the opponent with a copy of the counter-statement. Within two months, the opponent must file with the Registrar evidence by way of statutory declaration in support of his opposition. The Registrar must provide the trade mark applicant with a copy of the statutory declaration. If the opponent does not file evidence within the period specified, he shall, unless the Registrar directs otherwise, be deemed to have abandoned his opposition.

The applicant must, within two months of receipt of the evidence, file with the Registrar evidence by way of statutory declaration in support of his application. The registrar must send a copy to the opponent.

Within two months of receipt of the copy of the applicant's evidence, the opponent may file with the Registrar, evidence strictly confined to matters in reply. The Registrar must send a copy to the applicant.

After hearing the parties and considering the evidence, the Registrar must decide the matter. If the registration is to be permitted, it may be subject to amendments or conditions or limitations. The decision is appealable.

### **Grounds for opposition**

An application may be opposed on the ground of non-compliance with any requirement for registration.

The grounds for opposition include the following:

- that the mark is not distinctive (for registration in Part A of the register; a mark may be inherently distinctive, or may become able to distinguish by reason of use or other circumstances)
- that the mark is not capable of becoming distinctive (for registration in Part B of the register)
- that the mark would be likely to deceive or cause confusion
- that the use of the mark would be contrary to law

- that the mark contains scandalous matter
- that the mark would not be entitled to protection in a court of law
- that the mark is identical to a mark belonging to another person which is already registered for the same goods or services, or so nearly resembles the registered mark as to be likely to deceive or confuse
- that the mark is identical with, or is an imitation of, or contains an element of an armorial bearing, flag or other emblem or hallmark of the State or of an intergovernmental organisation.

### **Duration and renewal**

A trade mark registration is effective for an initial period of 10 years and, thereafter, is renewable for like periods upon payment of the prescribed renewal fees.

If a renewal fee is not paid within the prescribed period, the Registrar shall remove the trade mark from the register. The proprietor of the mark may apply within three years of such removal for the trade mark to be restored to the register, declaring that the mark has been used during the period of removal, or furnishing satisfactory reasons as to why there was no such use.

### **Cancellation/removal of a trade mark**

A trade mark registration may be cancelled or removed from the register in different circumstances:

- in the case of no *bona fide* intention to use the trade mark and no actual use, or in the case of no *bona fide* use of the trade mark for a period of five consecutive years (see the section on **Use requirement and cancellation** below)
- in the case of non-payment of the renewal fee (see the section on **Duration and renewal** above)
- in the case where the trade mark, through fault or neglect on the part of the proprietor, has become likely to deceive or cause confusion, or where the mark would not be entitled to protection in a court of law
- in the case of a contravention of, or failure to observe, a condition entered on the register in relation to the mark.

### **Use requirement and cancellation**

A trade mark registration may be cancelled if the mark was registered without any *bona fide* intention on the part of the applicant to use it as a trade mark and there has, in fact, been no *bona fide* use of the trade mark up to the date one month before the date of the application for cancellation.

Registration may also be cancelled if there has been no *bona fide* use of a registered trade mark for a continuous period of five years and one month up to the date of application for cancellation.

Permitted use of the mark by a third party can be relied on as use by the proprietor only where the third party has been recorded as a registered user.

**Assignment**

Assignment of a trade mark is permitted with or without the goodwill of the business. An assignment must be recorded in order to be binding on third parties.

Requirements for recordal:

- power of attorney from the assignee (simply signed)
- deed of assignment.

**Licensing/registered users**

Licensing of a trade mark is recognised. Recording of the licence agreement is required in order to be effective against third parties and for use to inure to the benefit of the owner. The licence agreement must provide for quality control by the licensor.

Requirements for recordal:

- power of attorney from the proprietor (simply signed)
- power of attorney from the user (simply signed)
- licence/registered user agreement
- statutory declaration and statement of case.

**Amendment**

There is provision for the amendment of a trade mark application and/or registration. The following amendments may be allowed:

- amending the name, address or description of the proprietor
- amending the goods and/or services
- cancelling the trade mark
- entering a disclaimer or memorandum which does not expand the scope of the registration
- altering the trade mark (on condition that the amendment does not materially affect its identity).

Requirements for amendment:

- supporting documents (where applicable), eg certificate of change of name, affidavit and/or statement of case setting out the nature of the applicant's interest
- where the trade mark is altered, copies of the mark as it will appear when altered.

**Rights conferred by registration**

The registration of a trade mark gives the proprietor the right to authorise the use of the mark by others, and to institute proceedings to prevent, or to recover damages for, the infringement of the mark, ie the unauthorised use of the mark by other persons. The registered proprietor has the right to authorise the use of the mark by others.

**Trade mark infringement**

The rights acquired by the registration of a trade mark are infringed by any unauthorised use in the course of trade, whether as a trade mark or

otherwise, of a mark identical to or so nearly resembling the registered mark as to be likely to deceive or cause confusion, where that mark is used in relation to the same or similar goods or services as those in respect of which the mark is registered.

Where a mark that is identical to a registered mark is used in respect of the same goods or services, it shall be presumed (unless the contrary is proved), that such use is likely to deceive or cause confusion.

### **Defences to trade mark infringement**

The Act provides for several defences that can be relied on in infringement proceedings, including that –

- the trade mark has been applied to the goods by the proprietor or by a person authorised by him and has not been obliterated or removed by the proprietor or such authorised person
- the use is in relation to other goods adapted to form part of or to be accessory to the registered goods, and the use of the trade mark is reasonably necessary to indicate such adaptation or accessory
- the mark being used is itself a registered trade mark.

The Act also provides that the proprietor of a trade mark is not entitled to interfere with –

- a person who uses an identical or similar mark, if such person has continuously used that mark from a date anterior to the registration of the registered mark or the commencement of its use by the proprietor
- the *bona fide* use by a person of his name or his place of business, or that of his predecessors, or the use of a description of the character or quality of the goods.

### **Relief for trade mark infringement**

The relief in cases of infringement includes an interdict (injunction) and damages, attachment, the rendering of an account, and the delivery-up of improperly marked goods. Damages may, at the option of the proprietor, be calculated on the basis of a reasonable royalty. Additional damages may also be awarded in the case of flagrant infringement.

Such relief may not be granted in certain circumstances in the case of a Part B registration.

The Act also provides for the forgery or falsification of a registered trade mark to constitute an offence, for which a penalty in the form of a fine or imprisonment or both can be imposed.

### **Common law rights**

Certain common law rights are recognised and protected, such as:

- despite the provisions of the Act, any person may institute an action under common law for passing-off or unlawful competition

- nothing in the Act shall entitle the proprietor of a registered trade mark to interfere with a person who uses an identical or similar mark, if such person has continuously used such mark from a date anterior to the date of registration of the registered mark or the use thereof by the proprietor.

### **Marking of goods**

No express requirement.

## **PATENTS**

### **Law**

- Patent Act no 26 of 1971 (Chapter 26:03) as amended several times, most recently by the Patents (Amendment) Act no 9 of 2002

Zimbabwe is a member of the Paris Convention, ARIPO (Harare Protocol), the PCT and the WTO/TRIPS.

### **Patent protection**

Patent protection is available by way of a national filing or via an ARIPO or PCT application designating Zimbabwe. Zimbabwe has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national law, thereby giving valid patent protection to applicants seeking to obtain a patent via an ARIPO application.

Since Zimbabwe is a member of the Paris Convention, a national application may claim priority based on an earlier application in a convention country.

Zimbabwe has also implemented the provisions of the PCT in its national law, thereby recognising and affording valid patent protection in the case of international PCT applications designating Zimbabwe.

### **Types of patents**

The Act provides for the following types of patents:

- patents for inventions which are new, inventive and industrially applicable
- patents of addition to cover modifications or improvements made to the invention of the main patent.

### **Patentable subject matter**

An invention is patentable if it is new, involves an inventive step and is industrially applicable. An invention is defined to mean any new and useful art, whether producing a physical effect or not, process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, capable of being applied in trade or industry.

A patent shall not be granted for

- diagnostic, therapeutic or surgical methods for the treatment of human beings or animals

- plants and animals, other than micro-organisms
- essentially biological processes for the production of plants or animals, other than microbiological processes.

The Act also provides that the Registrar may refuse an application if it appears to him that –

- the application is frivolous in that it claims as an invention anything obviously contrary to well-established natural laws
- the use of the invention would be expected to endanger public order or public safety, or would encourage offensive or immoral behaviour, or endanger human, animal or plant life, or cause prejudice to the environment
- the application claims as an invention a substance capable of being used as food or medicine, which is a mixture of known ingredients possessing only the aggregate of the known properties of the ingredients.

### **Types of applications**

Application for a patent may be made in the following ways:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- a national phase application based on an international application under the PCT in which Zimbabwe is designated
- an ARIPO application designating Zimbabwe
- a provisional application, to be completed by the filing of a complete specification
- an application for a patent of addition to cover improvements or amendments to the invention of the original patent.

A provisional application, which is accompanied by a provisional specification, must be completed within 12 months of its filing date by the lodging of a complete specification. A three-month extension of this period is possible on payment of the prescribed fee. A non-convention national complete application, ie accompanied by a complete specification, may at any time prior to the acceptance thereof be converted to a provisional application.

An application may, at any time prior to acceptance, be post-dated to a date not later than six months after the filing date. In the case of a convention application, it may not be post-dated to a date later than the date on which the application could have been filed.

Finally, at any time before the acceptance of an application, if a fresh application is made in respect of part of the subject matter of the first application, the later application may be ante-dated to the date of the first application.



## **Application**

Non-convention, convention and PCT national phase applications are filed with the office of the Registrar of Patents. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Zimbabwe Patent Office in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, refer to the chapter on **ARIPO**.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- assignment of invention (if the applicant is not the inventor)
- specification (including claims, abstract and drawings), in English
- certified copy of the priority document (if priority is to be claimed).

## **Applicant**

The application may be filed by the inventor, or by a person who has acquired the invention by assignment, either alone or jointly with another person.

## **Novelty**

An invention is new if, before the effective date of the application, the invention was not –

- known or used in Zimbabwe by anyone other than the applicant or the person or persons from whom he derived his title (secret knowledge is excluded)
- worked in Zimbabwe otherwise than by way of reasonable technical trial or experiment by the applicant or the persons from whom he derived his title
- described in a patent specification available to public inspection
- described in writing or in any other way in any publication in or outside Zimbabwe
- claimed in any complete specification in Zimbabwe which, though not open to public inspection, has an earlier effective date.

## **Certain prior knowledge or publication excused**

Novelty of an invention is not destroyed by disclosure prior to the filing date of the application or convention priority date without the patentee's knowledge or consent, provided that the matter disclosed was derived or obtained from the patentee, the invention had not been used by the patentee or his predecessor in title in Zimbabwe prior to the filing date or priority date, other than for the purpose of reasonable technical trial thereof, and the application was filed with reasonable diligence after learning of the disclosure.

## **Convention priority**

An application may contain a declaration claiming priority of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title, in any state party to a convention of which Zimbabwe is a party.

**Examination/procedure**

Applications are subjected to formal examination only, which takes place automatically, although the Act provides for examination in regard to the grounds on which the application may be opposed. If the application is accepted, the applicant is notified, who must then, within a prescribed period, advertise the acceptance in the Patent Journal. Upon advertisement all documents become open to public inspection.

**Opposition**

Any interested person, including the state, may within three months from the date of advertisement of acceptance of the complete specification, lodge a written notice to oppose the grant of the patent.

**Grounds of opposition**

An opposition may be based, *inter alia*, on any one or more of the following grounds:

- that the applicant was not entitled to file the application
- that the application is in fraud of the rights of the opposer
- that the claimed invention does not qualify as an invention
- that the invention is obvious
- that the invention is not useful
- that the specification does not fully describe and ascertain the invention
- that the claims do not clearly define the subject matter for which protection is claimed
- that the invention is not new
- that the complete specification claims subject matter not disclosed in the provisional specification or the first-filed convention application, and that such matter is not new.

**Duration and maintenance**

The term of a patent is 20 years from the filing date or international filing date, subject to payment of the annual renewal fees. A grace period of six months is provided for, subject to payment of surcharges. Failure to pay a renewal fee causes the patent to lapse.

**Restoration**

Where a patent has lapsed due to failure to pay renewal fees, the patentee may within three years from the date on which the patent lapsed, apply for restoration of the patent.

**Revocation**

Any interested party may apply to the court or Intellectual Property Tribunal to revoke or invalidate a patent on the basis of non-compliance with formal and substantive requirements. Invalidation of a patent can also be requested on any of the grounds on which the patent application could have been opposed (see the section on **Grounds of opposition** above).

### **Assignments/licences**

Assignments and licence contracts will have no effect against third parties until they are recorded in writing at the patent office.

Requirements for recordal:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

### **Compulsory licences**

Any interested person who can show that he has been unable to obtain a licence under a patent on reasonable terms may, within a period of six months from the initial request for a licence, apply to the Registrar for a compulsory licence on the ground that the reasonable requirements of the public in respect of the patented invention have not been met.

The reasonable requirements of the public will be considered not to have been satisfied in the following circumstances:

- if the patented invention, capable of being worked in Zimbabwe, is not being worked on a commercial scale and there is no satisfactory reason for such non-working
- if the working in Zimbabwe on a commercial scale is being hindered by the importation of the patented product
- if the demand in Zimbabwe is not being met to an adequate extent and on reasonable terms
- if the trade or industry in Zimbabwe is being prejudiced by unfair conditions imposed by the patentee to the purchase, licence or use of the patented invention.

The Registrar will consider the application and, if he is satisfied that a *prima facie* case has been made out, he must advertise the application in the Journal. The patentee or any other person may oppose the grant of a compulsory licence.

Compulsory licences may also be granted in the following circumstances:

- where a patent has not been worked in Zimbabwe within a period of four years from the date of filing of the patent application, or three years from the date of grant of the patent, whichever period last expires
- where a patent relates to a substance capable of being used as food or medicine or in the production of food or medicine, or a process for producing such a substance, or an invention capable of being used in surgical or curative devices or the protection of the environment, or an invention capable of improving the technological or social or economic development of the country
- where the working of a patent (a dependent patent) cannot take place without infringement of an earlier patent, and the dependent patent involves an important technical advance of economic significance
- where the use or exercise of the invention is required for the State in certain specified circumstances of emergency or war.

**Amendments**

The applicant may, up to acceptance of the application, amend the application, provided the amendments shall not go beyond the disclosure in the initial application. After acceptance, the applicant can only correct obvious mistakes or false statements.

**Effect of a patent**

The effect of a patent is to grant to the patentee full power, sole privilege and authority himself, or through his agents or licensees, to –

- make, use, offer for sale or sell any patented machine, manufacture, or composition of matter in Zimbabwe
- import that machine, manufacture or composition of matter
- use any patented art or process in Zimbabwe
- use, offer for sale or sell within Zimbabwe any product obtained by that art or process
- import any product obtained by such art or process.

These rights are subject to the following limitations:

- any person may make, use or sell the patented invention solely for the purpose reasonably related to the development and submission of information required under any law for the manufacture or marketing of any product
- any person may import (parallel importation) a patented product that has been put on the market in another country by the patentee or his licensee, if the cost of such importation is less than the cost of purchasing the product from the patentee.

**Infringement**

The patentee or an exclusive licensee may institute court proceedings for the infringement of a patent. Infringement proceedings may be brought in a competent court on a civil or criminal basis. Remedies include interdict, fine, damages and imprisonment. Special provision is also made for Anton Piller orders.

**Marking**

It is an offence to mark an article with any word or mark implying that the article is subject to a patent or a patent application, if that is in fact not the case.

**Working**

A granted patent must be worked within four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last. Failure to work can provide a ground for the grant of a compulsory licence.

## DESIGNS

### Law

- Industrial Designs Act no 17 of 1971 (Chapter 26:02) as amended several times, most recently by the Designs (Amendment) Act no 25 of 2001

Zimbabwe is a member of the Paris Convention, ARIPO (Harare Protocol), and the WTO/TRIPS.

### Design protection

Design protection is available by a national filing or via an ARIPO application designating Zimbabwe. Zimbabwe has implemented the Harare Protocol (which regulates patent and design filings in ARIPO) in its national laws, thereby giving valid design protection to applicants seeking to obtain a design registration via an ARIPO application.

### Registrable subject matter

Industrial design means features of shape, configuration, pattern or ornamentation applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.

### Classification of designs

No provision.

### Types of applications

Application for the registration of a design may be made as follows:

- a non-convention application, where the effective date is the filing date of the application
- a convention application, where the effective date would be the priority date of the first-filed application under the Paris Convention
- an ARIPO application designating Zimbabwe.

### Application

Non-convention and convention applications are filed with the office of the Registrar of Designs. Applications in terms of the Harare Protocol (ie ARIPO applications) can either be filed via the Zimbabwe design office, in which case they must be transmitted to the ARIPO office for processing. Alternatively, they can be filed at the ARIPO office in Harare. For more information on ARIPO, please refer to the chapter on **ARIPO**. Foreign applicants must have a local address for service.

Filing requirements:

- full particulars of the applicant
- power of attorney (simply signed)
- deed of assignment (if applicable)
- representations of the design
- certified copy of the priority document (if applicable).

**Applicant**

The creator or author of the design may apply, or his successor in title.

**Convention priority**

Zimbabwe is a member of the Paris Convention. Accordingly, priority can be claimed provided the application is filed in Zimbabwe within six months from the priority date.

**Novelty**

In order to be registrable, a design must be new or original. A design is deemed to be new or original if, before the effective date, the design was not –

- known or used in Zimbabwe by any other person (secret knowledge or use being excluded)
- described or illustrated in a publication inside or outside Zimbabwe
- registered in Zimbabwe
- the subject of a pending application with an earlier effective date and subsequently registered in Zimbabwe.

Novelty is not destroyed by confidential disclosure of the design by the proprietor, by disclosure in bad faith by a third party, by acceptance of a first confidential order for goods bearing the design, or by communication of the design to authorised government personnel. Display of the design at an officially recognised exhibition does not destroy novelty, provided the applicant notifies the Registrar in advance and application is made before or within six months of the opening date of the exhibition.

**Examination/procedure**

The Zimbabwe designs office conducts a formal examination and may subject the design to substantive examination. Substantive examination is in respect of novelty and originality of the design. If the design is found to be registrable, it is accepted, and the applicant must advertise the acceptance in the prescribed manner.

**Opposition**

Any person may oppose the registration of a design, by filing a notice of opposition with the Registrar within two months from the date on which the application was advertised.

**Duration and maintenance**

The initial term of the design registration is 10 years, which is extendible upon payment of renewal fees for one further five year term. In the event of non-payment of the renewal fee, the Registrar may remove the design from the register.

**Restoration**

In the event of removal of the design from the register, the proprietor may, within three years after its removal, apply to the Registrar for the design to be restored to the register. The proprietor must show that there was *bona fide* use of the design within the period of its removal, or provide satisfactory reasons for any non-use.

**Revocation**

No express provision.

**Assignments and licences**

Assignments and licence contracts must be recorded at the Registrar's office.

Requirements:

- power of attorney by the applicant (simply signed)
- original or certified copy of the assignment document; or
- original or certified copy of the licence agreement.

**Compulsory licences**

It is an official requirement for a registered design to be worked in Zimbabwe, failing which the design will be open for compulsory licences. Any person, may at any time after a design has been registered, apply to the Registrar for the grant of a compulsory licence on the ground that the design is not being applied in Zimbabwe by any industrial process or means to the articles in respect of which it is registered.

**Rights conferred by registration**

The registration of a design gives the registered proprietor the exclusive right in Zimbabwe to make, import or export for sale or for use for the purposes of trade, or to sell, hire or offer for sale or hire any article in respect of which the design is registered and to which the design, or a design not substantially different, has been applied.

The proprietor also has the right to institute proceedings against persons who infringe these rights.

**Infringement**

Infringement proceedings may be brought in a competent court or before the Tribunal on a civil basis. Remedies include interdict, damages, attachment, the rendering of account, delivery-up of the infringing articles or of articles used or intended to be used for making infringing copies. The Act also provides for the granting of Anton Piller orders.

**Marking**

It is not compulsory to mark a registered design. However, it is a criminal offence to falsely indicate or mark that a design is registered.

**Working**

Registered designs must be worked (see the section on **Compulsory licence** above).

## COPYRIGHT

### Law

- Copyright and Neighbouring Rights Act 11 of 2000 (Chapter 26:05) as amended, most recently by the Copyright (Amendment) Act no 32 of 2004
- Copyright and Neighbouring Rights Regulations, 2006

Zimbabwe is a member of the Berne Convention and the WTO/TRIPS.

**Note:** Reliable and up-to-date information on the copyright laws and their application in individual countries on the African Continent is not always generally available. The commentary given below is based on the information available at the time of writing.

### Subject matter eligible for protection

The Act provides for the following works to be eligible for copyright protection:

- literary works
- musical works
- artistic works
- audiovisual works
- sound recordings
- broadcasts
- programme-carrying signals
- published editions.

Literary works are further defined to include:

- dramatic works, stage directions, film scenarios, broadcasting scripts
- letters, reports, memoranda
- lectures, addresses and sermons
- computer programs
- tables and compilations of data.

Artistic works are further defined to include:

- graphic works, photographs, sculptures or collages (irrespective of artistic quality)
- works of architecture
- works of artistic craftsmanship.

Graphic works are further defined to include:

- paintings, drawings, diagrams, maps, charts or plans
- engravings, etchings, printed circuits, lithographs, woodcuts.

The following items and documents are not eligible for copyright:

- ideas, procedures, systems, methods of operation, concepts, principles, discoveries, facts or figures
- news of the day, items of press information



- speeches of a political nature, or delivered in the course of legal proceedings
- official texts of enactments or Bills
- official records of judicial proceedings
- notices, advertisements published in the Gazette
- applications, specifications published in the Patent and Trade Marks Journal
- entries in any register kept in terms of an enactment.

### **Requirements for subsistence of copyright**

No requirement for registration. For a work to qualify for protection, the author must be a citizen of Zimbabwe or a designated country, or domiciled or ordinarily resident in Zimbabwe or a designated country. Alternatively, the work must have been made or first published in Zimbabwe or a designated country.

### **Authorship and ownership of copyright**

The ownership of copyright in a work initially vests in the author, unless –

- the work is a literary or artistic work and was made in the course of the author's employment by a newspaper, magazine or similar periodical, in which case the owner of the publication is the owner of the copyright for purposes of such publication
- the work is a photograph, a painting or drawing of a portrait, a gravure, an audio-visual work or a sound recording and was made under a commission, in which case the person who commissioned and paid is the owner
- the work was done in the course of the author's employment, in which case it vests in the employer.

The ownership in this context refers to the economic rights inherent in copyright. The economic rights may be transferred or licensed.

The author shall also have the moral rights pertaining to the work; these include the right to claim authorship, the right to be identified and recognised as the author, and the right to object to distortion or mutilation of the work, or any derogatory action, which would be prejudicial to his honour or reputation. The moral rights may not be transferred during the life of the author.

### **Duration of copyright**

In the case of literary, musical and artistic works (except photographs) the copyright endures for the lifetime of the author plus 50 years.

In the case of photographs and all other works, the duration is 50 years from the date on which the work was made or was made available to the public or published.

### **Protection afforded by copyright**

Copyright generally confers on the owner the exclusive right to control the doing in Zimbabwe of any of the following acts:

- reproducing the work
- publishing the work
- importing or exporting the work into or from Zimbabwe
- performing the work in public
- broadcasting the work, or causing it to be transmitted
- making an adaptation of the work.

### **Exceptions to copyright protection**

The following acts are amongst a long list of acts excluded from the rights of the owner:

- the doing of any of the listed acts by way of fair dealing for purposes of research, private use or study
- different usages for teaching in schools or for educational purposes
- the making of copies to conserve or replace works in libraries or archives
- the use of works in parliamentary or judicial proceedings
- the use of a work for criticism or review or news reports
- the use of quotations from works
- the private recording of musical works and broadcasts.

### **Moral rights**

The author enjoys the moral rights pertaining to the work; these rights may not be alienated (see the section on **Authorship and ownership of copyright** above).

### **Assignment and licensing of copyright**

Copyright is transmissible by way of assignment and may be licensed. No assignment and no exclusive licence shall have effect unless it is in writing and signed by the assignor or the licensor.

### **Copyright infringement**

Copyright is infringed by any person who, without the licence of the owner, does or causes to be done any of the acts reserved for the copyright owner, or who imports an article otherwise than for private use.

### **Infringement proceedings**

Infringement proceedings may be instituted by the owner; the relief may include damages, injunction, attachment, account of profits, delivery-up of infringing articles, etc. Damages may, at the option of the copyright owner, be calculated on the basis of a reasonable royalty. The Act also provides for the granting of Anton Piller orders.

### **Criminal offences**

Certain infringing acts constitute criminal offences, unless the offender can prove that he acted in good faith or without knowing of the infringement.

## PLANT BREEDERS' RIGHTS

### Law

- Plant Breeders Rights Act no 53 of 1973 (Chapter 18:16) as amended, most recently by the Plant Breeders Rights (Amendment) Act no 11 of 2001 and the Act no 22 of 2001

Zimbabwe is, as yet, not a member of the UPOV Convention for the Protection of New Varieties of Plants. Plant breeders' rights can be obtained under the Zimbabwean Plant Breeders' Rights Act.

### Protection

The effect of protection by way of a plant breeder's right is that the holder of the right is entitled to prevent anyone from selling, reproducing or multiplying reproductive material of the protected plant or a plant essentially derived therefrom.

### Protectable subject matter

Protection can currently only be obtained for 32 prescribed kinds of plants.

### Requirements for registrability

In order to qualify for plant breeders' rights protection, a variety must be new, distinct, uniform and stable.

A variety is new if it has not been offered for sale or marketed in Zimbabwe prior to the date of application, or in any other country for more than six years (trees and vines) or four years (other plants) prior to the date of application.

### Application

The requirements for filing a plant breeder's right application include the following:

- an application form
- a power of attorney
- a deed of assignment
- a prescribed technical questionnaire
- results of DUS (distinct, uniform, stable) examinations conducted elsewhere
- samples of reproductive material.

### Denomination of variety

The applicant must propose a denomination, which shall be subject to approval by the Registrar.

### Applicant

The breeder, or his assignee, may apply for a plant breeder's right for a new variety.

**Convention priority**

Priority can be claimed from an earlier application in a UPOV member country.

**Duration**

A plant breeder's right endures for 20 years from the date of grant. A five year extension can be obtained in exceptional circumstances.

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**BERNE CONVENTION (1886): Member States**

(As at January 2012: 165 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	1994, March 6	Czech Republic	1993, January 1
Algeria	1998, April 19	Democratic People's	
Andorra	2004, June 2	Rep of Korea	2003, April 28
Antigua and		Democratic Rep	
Barbuda	2000, March 17	of the Congo	1963, October 8
Argentina	1967, June 10	Denmark	1903, July 1
Armenia	2000, October 19	Djibouti	2002, May 13
Australia	1928, April 14	Dominica	1999, August 7
Austria	1920, October 1	Dominican Rep	1997, December 24
Azerbaijan	1999, June 4	Ecuador	1991, October 9
Bahamas	1973, July 10	Egypt	1977, June 7
Bahrain	1997, March 2	El Salvador	1994, February 19
Bangladesh	1999, May 4	Equatorial Guinea	1997, June 26
Barbados	1983, July 30	Estonia	1994, October 26
Belarus	1997, December 12	Fiji	1971, December 1
Belgium	1887, December 5	Finland	1928, April 1
Belize	2000, June 17	France	1887, December 5
Benin	1961, January 3	Gabon	1962, March 26
Bhutan	2004, November 25	Gambia	1993, March 7
Bolivia	1993, November 4	Georgia	1995, May 16
Bosnia and		Germany	1887, December 5
Herzegovina	1992, March 1	Ghana	1991, October 11
Botswana	1998, April 15	Greece	1920, November 9
Brazil	1922, February 9	Grenada	1998, September 22
Brunei Darussalam	2006, August 30	Guatemala	1997, July 28
Bulgaria	1921, December 5	Guinea	1980, November 20
Burkina Faso	1963, August 19	Guinea-Bissau	1991, July 22
Cameroon	1964, September 21	Guyana	1994, October 25
Canada	1928, April 10	Haiti	1996, January 11
Cape Verde	1997, July 7	Holy See	1935, September 12
Central African Rep	1977, September 3	Honduras	1990, January 25
Chad	1971, November 25	Hungary	1922, February 14
Chile	1970, June 5	Iceland	1947, September 7
China	1992, October 15	India	1928, April 1
Colombia	1988, March 7	Indonesia	1997, September 5
Comoros	2005, April 17	Ireland	1927, October 5
Congo	1962, May 8	Israel	1950, March 24
Costa Rica	1978, June 10	Italy	1887, December 5
Côte d'Ivoire	1962, January 1	Jamaica	1994, January 1
Croatia	1991, October 8	Japan	1899, July 15
Cuba	1997, February 20	Jordan	1999, July 28
Cyprus	1964, February 24	Kazakhstan	1999, April 12

Kenya	1993, June 11	Russian Federation	1995, March 13
Kyrgyzstan	1999, July 8	Rwanda	1984, March 1
Lao People's Dem Republic	2012, March 14	St Kitts and Nevis	1995, April 9
Latvia	1995, August 11	Saint Lucia	1993, August 24
Lebanon	1947, September 30	Samoa	2006, July 21
Lesotho	1989, September 28	Saudi Arabia	2004, March 11
Liberia	1989, March 8	Senegal	1962, August 25
Libyan Arab Jamahiriya	1976, September 28	Serbia	1992, April 27
Liechtenstein	1931, July 30	Singapore	1998, December 21
Lithuania	1994, December 14	Slovakia	1993, January 1
Luxembourg	1888, June 20	Slovenia	1991, June 25
Madagascar	1966, January 1	South Africa	1928, October 3
Malawi	1991, October 12	Spain	1887, December 5
Malaysia	1990, October 1	Sri Lanka	1959, July 20
Mali	1962, March 19	St Vincent and the Grenadines	1995, August 29
Malta	1964, September 21	Sudan	2000, December 28
Mauritania	1973, February 6	Suriname	1977, February 23
Mauritius	1989, May 10	Swaziland	1998, December 14
Mexico	1967, June 11	Sweden	1904, August 1
Micronesia (Federated States of)	2003, October 7	Switzerland	1887, December 5
Monaco	1889, May 30	Syrian Arab Rep	2004, June 11
Mongolia	1998, March 12	Tajikistan	2000, March 9
Montenegro	2006, June 3	Thailand	1931, July 17
Morocco	1917, June 16	Togo	1975, April 30
Namibia	1990, March 21	Tonga	2001, June 14
Nepal	2006, January 11	Trinidad and Tobago	1988, August 16
Netherlands	1912, November 1	Tunisia	1887, December 5
New Zealand	1928, April 24	Turkey	1952, January 1
Nicaragua	2000, August 23	Ukraine	1995, October 25
Niger	1962, May 2	United Arab Emirates	2004, July 14
Nigeria	1993, September 14	United Kingdom	1887, December 5
Norway	1896, April 13	United Republic of Tanzania	1994, July 25
Oman	1999, July 14	United States of America	1989, March 1
Pakistan	1948, July 5	Uruguay	1967, July 10
Panama	1996, June 8	Uzbekistan	2005, April 19
Paraguay	1992, January 2	Venezuela	1982, December 30
Peru	1988, August 20	Viet Nam	2004, October 26
Philippines	1951, August 1	Yemen	2008, July 14
Poland	1920, January 28	Yugoslav Rep of Macedonia	1991, September 8
Portugal	1911, March 29	Zambia	1992, January 2
Qatar	2000, July 5	Zimbabwe	1980, April 18
Republic of Korea	1996, August 21		
Republic of Moldova	1995, November 2		
Romania	1927, January 1		

**BUDAPEST TREATY (1977): Member states**

(As at January 2012: 75 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
African Intellectual Property Organisation (OAPI)	2008, September 16	Latvia	1994, December 29
Albania	2007, March 19	Liechtenstein	1981, August 19
Armenia	2007, July 13	Lithuania	1998, May 9
Azerbaijan	2010, December 8	Luxembourg	2010, July 29
Belgium	1979, April 1	Mexico	2001, March 21
Belize	2003, July 12	Monaco	1999, January 23
Benin	1986, November 2	Montenegro	2006, June 3
Bosnia and Herzegovina	2008, December 24	Morocco	2011, July 20
Botswana	2006, December 5	Netherlands	1987, July 2
Bulgaria	1996, December 11	Nicaragua	2006, August 10
Canada	1996, September 21	Norway	1986, January 1
Chile	2011, August 5	Oman	2007, October 16
China	1995, July 1	Peru	2009, January 20
Costa Rica	2008, September 30	Philippines	1981, October 21
Croatia	2000, February 25	Poland	1993, September 22
Cuba	1994, February 19	Portugal	1997, October 16
Czech Republic	1993, January 1	Republic of Korea	1988, March 28
Democratic People's Rep of Korea	2002, February 21	Republic of Moldova	1991, December 25
Denmark	1985, July 1	Romania	1999, September 25
Dominican Rep	2007, July 3	Russian Federation	1981, April 22
El Salvador	2006, August 17	Senegal	--
Estonia	1996, September 14	Serbia	1994, February 25
Finland	1985, September 1	Singapore	1995, February 23
France	1980, August 19	Slovakia	1993, January 1
Georgia	2005, September 30	Slovenia	1998, March 12
Germany	1981, January 20	South Africa	1997, July 14
Greece	1993, October 30	Spain	1981, March 19
Guatemala	2006, October 14	Sweden	1983, October 1
Honduras	2006, June 20	Switzerland	1981, August 19
Hungary	1980, August 19	Tajikistan	1991, December 25
Iceland	1995, March 23	Trinidad and Tobago	1994, March 10
India	2001, December 17	Tunisia	2004, May 23
Ireland	1991, December 15	Turkey	1998, November 30
Israel	1996, April 26	Ukraine	1997, July 2
Italy	1986, March 23	United Kingdom	1980, December 29
Japan	1980, August 19	United States of America	1980, August 19
Jordan	2008, November 14	Uzbekistan	2002, January 12
Kazakhstan	2002, April 24	Yugoslav Rep of Macedonia	2002, August 30
Kyrgyzstan	2003, May 17		



**HAGUE AGREEMENT (1925): Member states**

(As at January 2012: 60 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	2003, September 19	Monaco	1956, April 29
Armenia	2005, March 6	Mongolia	1997, April 12
Australia	1987, July 7	Montenegro	2006, June 3
Austria	1984, April 26	Morocco	1930, October 20
Azerbaijan	2003, October 14	Namibia	2004, June 30
Belarus	2001, October 19	Netherlands	1979, April 1
Belgium	1983, December 15	Niger	2004, September 20
Bosnia and Herzegovina	2009, January 27	Norway	2010, June 17
Bulgaria	1980, August 19	Oman	2009, March 4
Côte d'Ivoire	1993, May 30	Poland	2009, July 2
Croatia	2004, February 12	Portugal	1997, October 16
Cuba	1994, February 19	Republic of Korea	1988, March 28
Democratic People's Rep of Korea	1992, May 27	Republic of Moldova	1994, March 14
Denmark	2008, December 9	Romania	1992, July 18
Egypt	1952, July 1	Rwanda	2011, August 31
Estonia	2003, December 23	São Tomé and Principe	2008, December 8
European Union	2008, January 1	Senegal	1984, June 30
Finland	2011, May 1	Serbia	1993, December 30
France	1930, October 20	Singapore	2005, April 17
Gabon	2003, August 18	Slovenia	1995, January 13
Georgia	2003, August 1	Spain	1928, June 1
Germany	1928, June 1	Suriname	1975, November 25
Ghana	2008, September 16	Switzerland	1928, June 1
Greece	1997, April 18	Syrian Arab Rep	2008, May 7
Hungary	1984, April 7	Tajikistan	2012, March 21
Iceland	2003, December 23	Trinidad and Tobago	1994, March 10
Italy	1987, June 13	Tunisia	1930, October 20
Kyrgyzstan	2003, March 17	Turkey	2005, January 1
Latvia	2005, July 26	Ukraine	2002, August 28
Lithuania	2008, September 28	Yugoslav Rep of Macedonia	1997, March 18
Luxembourg	1979, April 1		
Mali	2006, September 7		

**LOCARNO AGREEMENT (1968): Member states**  
(As at January 2012: 52 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Argentina	2009, May 9	Malawi	1995, October 24
Armenia	2007, July 13	Mexico	2001, January 26
Austria	1990, September 26	Mongolia	2001, June 16
Azerbaijan	2003, October 14	Montenegro	2006, June 3
Belarus	1998, July 24	Netherlands	1977, March 30
Belgium	2004, June 23	Norway	1971, April 27
Bosnia and Herzegovina	1992, March 1	Republic of Korea	2011, April 17
Bulgaria	2001, February 27	Republic of Moldova	1997, December 1
China	1996, September 19	Romania	1998, June 30
Croatia	1991, October 8	Russian Federation	1972, December 15
Cuba	1998, October 9	Serbia	1992, April 27
Czech Republic	1993, January 1	Slovakia	1993, January 1
Democratic People's Rep of Korea	1997, June 6	Slovenia	1991, June 25
Denmark	1971, April 27	Spain	1973, November 17
Estonia	1996, October 31	Sweden	1971, April 27
Finland	1972, May 16	Switzerland	1971, April 27
France	1975, September 13	Tajikistan	1991, December 25
Germany	1990, October 25	Trinidad and Tobago	1996, March 20
Greece	1999, September 4	Turkey	1998, November 30
Guinea	1996, November 5	Turkmenistan	2006, June 7
Hungary	1974, January 1	Ukraine	2009, July 7
Iceland	1995, April 9	United Kingdom	2003, October 21
Ireland	1971, April 27	Uruguay	2000, January 19
Italy	1975, August 12	Uzbekistan	2006, July 19
Kazakhstan	2002, November 7	Yugoslav Rep of Macedonia	1991, September 8
Kyrgyzstan	1998, December 10		
Latvia	2005, April 14		

**INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGNS**  
under the *Locarno Agreement*  
**Ninth Edition**

- Class 1* Foodstuffs
- Class 2* Articles of clothing and haberdashery
- Class 3* Travel goods, cases, parasols and personal belongings, not elsewhere specified
- Class 4* Brushware
- Class 5* Textile piecegoods, artificial and natural sheet material
- Class 6* Furnishing
- Class 7* Household goods, not elsewhere specified
- Class 8* Tools and hardware
- Class 9* Packages and containers for the transport or handling of goods
- Class 10* Clocks and watches and other measuring instruments, checking and signalling instruments
- Class 11* Articles of adornment
- Class 12* Means of transport or hoisting
- Class 13* Equipment for production, distribution or transformation of electricity
- Class 14* Recording, communication or information retrieval equipment
- Class 15* Machines, not elsewhere specified
- Class 16* Photographic, cinematographic and optical apparatus
- Class 17* Musical instruments
- Class 18* Printing and office machinery
- Class 19* Stationery and office equipment, artists' and teaching materials
- Class 20* Sales and advertising equipment, signs
- Class 21* Games, toys, tents and sports goods
- Class 22* Arms, pyrotechnic articles, articles for hunting, fishing and pest killing
- Class 23* Fluid distribution equipment, sanitary, heating, ventilation and air-conditioning equipment, solid fuel
- Class 24* Medical and laboratory equipment
- Class 25* Building units and construction elements
- Class 26* Lighting apparatus
- Class 27* Tobacco and smokers' supplies
- Class 28* Pharmaceutical and cosmetic products, toilet articles and apparatus
- Class 29* Devices and equipment against fire hazards, for accident prevention and for rescue
- Class 30* Articles for the care and handling of animals
- Class 31* Machines and appliances for preparing food or drink, not elsewhere specified
- Class 32* Graphic symbols and logos, surface patterns, ornamentation.

**MADRID AGREEMENT (Mark) (1891): Member states**

(As at January 2012: 56 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	1995, October 4	Liechtenstein	1933, July 14
Algeria	1972, July 5	Luxembourg	1924, September 1
Armenia	1991, December	Monaco	1956, April 29
Austria	1909, January 1	Mongolia	1985, April 21
Azerbaijan	1995, December 25	Montenegro	2006, June 3
Belarus	1991, December 25	Morocco	1917, July 30
Belgium	1892, July 15	Mozambique	1998, October 7
Bhutan	2000, August 4	Namibia	2004, June 30
Bosnia and Herzegovina	1992, March 1	Netherlands	1893, March 1
Bulgaria	1985, August 1	Poland	1991, March 18
China	1989, October 4	Portugal	1893, October 31
Croatia	1991, October 8	Rep of Moldova	1991, December 25
Cuba	1989, December 6	Romania	1920, October 6
Cyprus	2003, November 4	Russian Federation	1976, July 1
Czech Republic	1993, January 1	San Marino	1960, September 25
Democratic People's Rep of Korea	1980, June 10	Serbia	1992, April 27
Egypt	1952, July 1	Sierra Leone	1997, June 17
France	1892, July 15	Slovakia	1993, January 1
Germany	1922, December 1	Slovenia	1991, June 25
Hungary	1909, January 1	Spain	1892, July 15
Iran (Islamic Rep of)	2003, December 25	Sudan	1984, May 16
Italy	1894, October 15	Swaziland	1998, December 14
Kazakhstan	1991, December 25	Switzerland	1892, July 15
Kenya	1998, June 26	Syrian Arab Rep	2004, August 5
Kyrgyzstan	1991, December 25	Tajikistan	1991, December 25
Latvia	1995, January 1	Ukraine	1991, December 25
Lesotho	1999, February 12	Vietnam	1949, March 8
Liberia	1995, December 25	Yugoslav Rep of Macedonia	1991, September 8

**MADRID PROTOCOL (1989): Member states**

(As at January 2012: 84 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	2003, July 30	Lithuania	1997, November 15
Antigua and Barbuda	2000, March 17	Luxembourg	1998, April 1
Armenia	2000, October 19	Madagascar	2008, April 28
Australia	2001, July 11	Monaco	1996, September 27
Austria	1999, April 13	Mongolia	2001, June 16
Azerbaijan	2007, April 15	Montenegro	2006, June 3
Bahrain	2005, December 15	Morocco	1999, October 8
Belarus	2002, January 18	Mozambique	1998, October 7
Belgium	1998, April 1	Namibia	2004, June 30
Bhutan	2000, August 4	Netherlands	1998, April 1
Bosnia and Herzegovina	2009, January 27	Norway	1996, March 29
Botswana	2006, December 5	Oman	2007, October 16
Bulgaria	2001, October 2	Poland	1997, March 4
China	1995, December 1	Portugal	1997, March 20
Croatia	2004, January 23	Republic of Korea	2003, April 10
Cuba	1995, December 26	Republic of Moldova	1997, December 1
Cyprus	2003, November 4	Romania	1998, July 28
Czech Republic	1996, September 25	Russian Federation	1997, June 10
Democratic People's Rep of Korea	1996, October 3	San Marino	2007, September 12
Denmark	1996, February 13	São Tomé and Príncipe	2008, December 8
Egypt	2009, September 3	Senegal	--
Estonia	1998, November 18	Serbia	1998, February 17
European Union	2004, October 1	Sierra Leone	1999, December 28
Finland	1996, April 1	Singapore	2000, October 31
France	1997, November 7	Slovakia	1997, September 13
Georgia	1998, August 20	Slovenia	1998, March 12
Germany	1996, March 20	Spain	1995, December 1
Ghana	2008, September 16	Sudan	2010, February 16
Greece	2000, August 10	Swaziland	1998, December 14
Hungary	1997, October 3	Sweden	1995, December 1
Iceland	1997, April 15	Switzerland	1997, May 1
Iran (Islamic Rep of)	2003, December 25	Syrian Arab Rep	2004, August 5
Ireland	2001, October 19	Tajikistan	2011, June 30
Israel	2010, September 1	Turkey	1999, January 1
Italy	2000, April 17	Turkmenistan	1999, September 28
Japan	2000, March 14	Ukraine	2000, December 29
Kenya	1998, June 26	United Kingdom	1995, December 1
Kazakhstan	2010, December 8	United States of America	2003, November 2
Kyrgyzstan	2004, June 17	Uzbekistan	2006, December 27
Latvia	2000, January 5	Vietnam	2006, July 11
Lesotho	1999, February 12	Yugoslav Rep of Macedonia	2002, August 30
Liberia	2009, December 11	Zambia	2001, November 15
Liechtenstein	1998, March 17		

**NICE AGREEMENT (1957): Member states**  
(As at January 2012: 83 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	2003, September 19	Lithuania	1997, February 22
Algeria	1972, July 5	Luxembourg	1975, March 24
Argentina	2008, January 24	Malawi	1995, October 25
Armenia	2005, March 6	Malaysia	2007, September 28
Australia	1961, April 8	Mexico	2001, March 21
Austria	1969, November 30	Monaco	1961, April 8
Azerbaijan	2003, October 14	Mongolia	2001, June 16
Bahrain	2005, December 15	Montenegro	2006, June 3
Barbados	1985, March 12	Morocco	1966, October 1
Belarus	1998, June 12	Mozambique	2002, January 18
Belgium	1962, June 6	Netherlands	1962, August 20
Benin	1979, February 6	Norway	1961, July 28
Bosnia and Herzegovina	1992, March 1	Poland	1997, March 4
Bulgaria	2001, February 27	Portugal	1961, April 8
China	1994, August 9	Republic of Korea	1999, January 8
Croatia	1991, October 8	Rep of Moldova	1997, December 1
Cuba	1995, December 26	Romania	1998, June 30
Cyprus	1966, January 17	Russian Federation	1971, July 26
Czech Republic	1993, January 1	Saint Kitts and Nevis	2005, October 27
Democratic People's Rep of Korea	1997, June 6	Saint Lucia	2001, March 18
Denmark	1961, November 30	Serbia	1992, April 27
Dominica	2000, September 8	Singapore	1999, March 18
Egypt	2005, June 18	Slovakia	1993, January 1
Estonia	1996, May 27	Slovenia	1991, June 25
Finland	1973, August 18	Spain	1961, April 8
France	1961, April 8	Suriname	1981, December 16
Georgia	2003, February 28	Sweden	1961, July 28
Germany	1962, January 29	Switzerland	1962, August 20
Greece	1998, November 7	Syrian Arab Rep	2005, March 28
Guinea	1996, November 5	Tajikistan	1991, December 25
Hungary	1967, March 23	The former Yugoslav Rep of Macedonia	1991, September 8
Iceland	1995, April 9	Trinidad and Tobago	1996, March 20
Ireland	1966, December 12	Tunisia	1967, May 29
Israel	1961, April 8	Turkey	1996, January 1
Italy	1961, April 8	Turkmenistan	2006, June 7
Jamaica	2006, February 7	Ukraine	2000, December 29
Japan	1990, February 20	United Kingdom	1963, April 15
Jordan	2008, November 14	United Rep of Tanzania	1999, September 14
Kazakhstan	2002, April 24	United States of America	1972, May 25
Kyrgyzstan	1998, December 10	Uruguay	2000, January 19
Latvia	1995, January 1	Uzbekistan	2002, January 12
Lebanon	1961, April 8		
Liechtenstein	1967, May 29		

## INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

under the *Nice Agreement*

### Tenth Edition

(effective 1 January 2012)

#### **GOODS**

- Class 1* Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- Class 2* Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- Class 3* Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- Class 4* Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- Class 5* Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. *Class 6* Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- Class 7* Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.
- Class 8* Hand tools and implements (hand-operated); cutlery; side arms; razors.
- Class 9* Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.

- Class 10* Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- Class 11* Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- Class 12* Vehicles; apparatus for locomotion by land, air or water.
- Class 13* Firearms; ammunition and projectiles; explosives; fireworks.
- Class 14* Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- Class 15* Musical instruments.
- Class 16* Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- Class 17* Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
- Class 18* Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.
- Class 19* Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
- Class 20* Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- Class 21* Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- Class 22* Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- Class 23* Yarns and threads, for textile use.
- Class 24* Textiles and textile goods, not included in other classes; bed covers; table covers.
- Class 25* Clothing, footwear, headgear.
- Class 26* Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.



- Class 27* Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- Class 28* Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- Class 29* Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.
- Class 30* Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.
- Class 31* Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt.
- Class 32* Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.
- Class 33* Alcoholic beverages (except beers).
- Class 34* Tobacco; smokers' articles; matches.

## **SERVICES**

- Class 35* Advertising; business management; business administration; office functions.
- Class 36* Insurance; financial affairs; monetary affairs; real estate affairs
- Class 37* Building construction; repair; installation services.
- Class 38* Telecommunications.
- Class 39* Transport; packaging and storage of goods; travel arrangement
- Class 40* Treatment of materials.
- Class 41* Education; providing of training; entertainment; sporting and cultural activities.
- Class 42* Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.
- Class 43* Services for providing food and drink; temporary accommodation.
- Class 44* Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- Class 45* Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

**PARIS CONVENTION (1883): Member states**  
(As at January 2012: 174 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	1995, October 4	Cyprus	1966, January 17
Algeria	1966, March 1	Czech Republic	1993, January 1
Andorra	2004, June 2	Republic of Korea	1980, June 10
Angola	2007, December 27	Democratic Rep of the Congo	1975, January 31
Antigua and Barbuda	2000, March 17	Denmark	1894, October 1
Argentina	1967, February 10	Djibouti	2002, May 13
Armenia	1991, December 25	Dominica	1999, August 7
Australia	1925, October 10	Dominican Rep	1890, July 11
Austria	1909, January 1	Ecuador	1999, June 22
Azerbaijan	1995, December 25	Egypt	1951, July 1
Bahamas	1973, July 10	El Salvador	1994, February 19
Bahrain	1997, October 29	Equatorial Guinea	1997, June 26
Bangladesh	1991, March 3	Estonia	1994, August 24
Barbados	1985, March 12	Finland	1921, September 20
Belarus	1991, December 25	France	1884, July 7
Belgium	1884, July 7	Gabon	1964, February 29
Belize	2000, June 17	Gambia	1992, January 21
Benin	1967, January 10	Georgia	1991, December 25
Bhutan	2000, August 4	Germany	1903, May 1
Bolivia (Plurinational State of)	1993, November 4	Ghana	1976, September 28
Bosnia and Herzegovina	1992, March 1	Greece	1924, October 2
Botswana	1998, April 15	Grenada	1998, September 22
Brazil	1884, July 7	Guatemala	1998, August 18
Brunei Darussalam	2012, February 17	Guinea	1982, February 5
Bulgaria	1921, June 13	Guinea-Bissau	1988, June 28
Burkina Faso	1963, November 19	Guyana	1994, October 25
Burundi	1977, September 3	Haiti	1958, July 1
Cambodia	1998, September 22	Holy See	1960, September 29
Cameroon	1964, May 10	Honduras	1994, February 4
Canada	1925, June 12	Hungary	1909, January 1
Central African Rep	1963, November 19	Iceland	1962, May 5
Chad	1963, November 19	India	1998, December 7
Chile	1991, June 14	Indonesia	1950, December 24
China	1985, March 19	Iran (Islamic Rep of)	1959, December 16
Colombia	1996, September 3	Iraq	1976, January 24
Comoros	2005, April 3	Ireland	1925, December 4
Congo	1963, September 2	Israel	1950, March 24
Costa Rica	1995, October 31	Italy	1884, July 7
Côte d'Ivoire	1963, October 23	Jamaica	1999, December 24
Croatia	1991, October 8	Japan	1899, July 15
Cuba	1904, November 17	Jordan	1972, July 17
		Kazakhstan	1991, December 25
		Kenya	1965, June 14

Kyrgyzstan	1991, December 25
Lao People's Democratic Rep	1998, October 8
Latvia	1993, September 7
Lebanon	1924, September 1
Lesotho	1989, September 28
Liberia	1994, August 27
Libyan Arab Jamahiriya	1976, September 28
Liechtenstein	1933, July 14
Lithuania	1994, May 22
Luxembourg	1922, June 30
Madagascar	1963, December 21
Malawi	1964, July 6
Malaysia	1989, January 1
Mali	1983, March 1
Malta	1967, October 20
Mauritania	1965, April 11
Mauritius	1976, September 24
Mexico	1903, September 7
Monaco	1956, April 29
Mongolia	1985, April 21
Montenegro	2006, June 3
Morocco	1917, July 30
Mozambique	1998, July 9
Namibia	2004, January 1
Nepal	2001, June 22
Netherlands	1884, July 7
New Zealand	1931, July 29
Nicaragua	1996, July 3
Niger	1964, July 5
Nigeria	1963, September 2
Norway	1885, July 1
Oman	1999, July 14
Pakistan	2004, July 22
Panama	1996, October 19
Papua New Guinea	1999, June 15
Paraguay	1994, May 28
Peru	1995, April 11
Philippines	1965, September 27
Poland	1919, November 10
Portugal	1884, July 7
Qatar	2000, July 5
Republic of Korea	1980, May 4
Rep of Macedonia	1991, September 8
Rep of Moldova	1991, December 25
Romania	1920, October 6
Russian Federation	1965, July 1
Rwanda	1984, March 1

Saint Kitts and Nevis	1995, April 9
Saint Lucia	1995, June 9
San Marino	1960, March 4
São Tomé and Príncipe	1998, May 12
Saudi Arabia	2004, March 11
Senegal	1963, December 21
Serbia	1992, April 27
Seychelles	2002, November 7
Sierra Leone	1997, June 17
Singapore	1995, February 23
Slovakia	1993, January 1
Slovenia	1991, June 25
South Africa	1947, December 1
Spain	1884, July 7
Sri Lanka	1952, December 29
Sudan	1984, April 16
Suriname	1975, November 25
Swaziland	1991, May 12
Sweden	1885, July 1
Switzerland	1884, July 7
Syrian Arab Rep	1924, September 1
Tajikistan	1991, December 25
Thailand	2008, August 2
The Grenadines	1995, August 29
Togo	1967, September 10
Tonga	2001, June 14
Trinidad and Tobago	1964, August 1
Tunisia	1884, July 7
Turkey	1925, October 10
Turkmenistan	1991, December 25
Uganda	1965, June 14
Ukraine	1991, December 25
United Arab Emirates	1996, September 19
United Kingdom	1884, July 7
United Rep of Tanzania	1963, June 16
United States of America	1887, May 30
Uruguay	1967, March 18
Uzbekistan	1991, December 25
Venezuela (Bolivarian Republic of)	1995, September 12
Viet Nam	1949, March 8
Yemen	2007, February 15
Zambia	1965, April 6

**PATENT COOPERATION TREATY (1970): Member states**

(As at January 2012: 144 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	1995, October 4	Ecuador	2001, May 7
Algeria	2000, March 8	Egypt	2003, September 6
Angola	2007, December 27	El Salvador	2006, August 17
Antigua and Barbuda	2000, March 17	Equatorial Guinea	2001, July 17
Argentina	--	Estonia	1994, August 24
Armenia	1991, December 25	Finland	1980, October 1
Australia	1980, March 31	France	1978, February 25
Austria	1979, April 23	Gabon	1978, January 24
Azerbaijan	1995, December 25	Gambia	1997, December 9
Bahrain	2007, March 18	Georgia	1991, December 25
Barbados	1985, March 12	Germany	1978, January 24
Belarus	1991, December 25	Ghana	1997, February 26
Belgium	1981, December 14	Greece	1990, October 9
Belize	2000, June 17	Grenada	1998, September 22
Benin	1987, February 26	Guatemala	2006, October 14
Bosnia and Herzegovina	1996, September 7	Guinea	1991, May 27
Botswana	2003, October 30	Guinea-Bissau	1997, December 12
Brazil	1978, April 9	Holy See	--
Bulgaria	1984, May 21	Honduras	2006, June 20
Burkina Faso	1989, March 21	Hungary	1980, June 27
Cameroon	1978, January 24	Iceland	1995, March 23
Canada	1990, January 2	India	1998, December 7
Central African Rep	1978, January 24	Indonesia	1997, September 5
Chad	1978, January 24	Iran (Islamic Rep of)	--
Chile	2009, June 2	Ireland	1992, August 1
China	1994, January 1	Israel	1996, June 1
Colombia	2001, February 28	Italy	1985, March 28
Comoros	2005, April 3	Japan	1978, October 1
Congo	1978, January 24	Kazakhstan	1991, December 25
Costa Rica	1999, August 3	Kenya	1994, June 8
Côte d'Ivoire	1991, April 30	Kyrgyzstan	1991, December 25
Croatia	1998, July 1	Lao People's Democratic Rep	2006, June 14
Cuba	1996, July 16	Latvia	1993, September 7
Cyprus	1998, April 1	Lesotho	1995, October 21
Czech Republic	1993, January 1	Liberia	1994, August 27
Democratic People's Rep of Korea	1980, July 8	Libyan Arab Jamahiriya	2005, September 15
Denmark	1978, December 1	Liechtenstein	1980, March 19
Dominica	1999, August 7	Lithuania	1994, July 5
Dominican Republic	2007, May 28	Luxembourg	1978, April 30
		Madagascar	1978, January 24

Malawi	1978, January 24
Malaysia	2006, August 16
Mali	1984, October 19
Malta	2007, March 1
Mauritania	1983, April 13
Mexico	1995, January 1
Monaco	1979, June 22
Mongolia	1991, May 27
Montenegro	2006, June 3
Morocco	1999, October 8
Mozambique	2000, May 18
Namibia	2004, January 1
Netherlands	1979, July 10
New Zealand	1992, December 1
Nicaragua	2003, March 6
Niger	1993, March 21
Nigeria	2005, May 8
Norway	1980, January 1
Oman	2001, October 26
Papua New Guinea	2003, June 14
Peru	2009, June 6
Philippines	2001, August 17
Poland	1990, December 25
Portugal	1992, November 24
Qatar	2011, August 3
Republic of Korea	1984, August 10
Republic of Moldova	1991, December 25
Romania	1979, July 23
Russian Federation	1978, March 29
Rwanda	2011, August 31
Saint Kitts and Nevis	2005, October 27
Saint Lucia	1996, August 30
Saint Vincent and the Grenadines	2002, August 6
San Marino	2004, December 14
São Tomé and Príncipe	2008, July 3
Senegal	1978, January 24

Serbia	1997, February 1
Seychelles	2002, November 7
Sierra Leone	1997, June 17
Singapore	1995, February 23
Slovakia	1993, January 1
Slovenia	1994, March 1
South Africa	1999, March 16
Spain	1989, November 16
Sri Lanka	1982, February 26
Sudan	1984, April 16
Swaziland	1994, September 20
Sweden	1978, May 17
Switzerland	1978, January 24
Syrian Arab Rep	2003, June 26
Tajikistan	1991, December 25
Thailand	2009, December 24
Togo	1978, January 24
Trinidad and Tobago	1994, March 10
Tunisia	2001, December 10
Turkey	1996, January 1
Turkmenistan	1991, December 25
Uganda	1995, February 9
Ukraine	1991, December 25
United Arab Emirates	1999, March 10
United Kingdom	1978, January 24
United Republic of Tanzania	1999, September 14
United States of America	1978, January 24
Uzbekistan	1991, December 25
Vietnam	1993, March 10
Yugoslav Rep of Macedonia	1995, August 10
Zambia	2001, November 15
Zimbabwe	1997, June 11

**UPOV CONVENTION (1961): Member states**  
(As at January 2012: 70 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	1995, October 4	<b>Mexico</b>	<b>1997, August 9</b>
Albania	2005, October 15	Morocco	2006, October 8
Argentina	1994, December 25	Netherlands	1968, August 10
Australia	1989, March 1	New Zealand	1981, November 8
Austria	1994, July 14	Nicaragua	2001, September 6
Azerbaijan	2004, December 9	Norway	1993, September 13
Belarus	2003, January 5	Oman	2009, November 22
Belgium	1976, December 5	Panama	1999, May 23
Bolivia (Plurinational State of)	1999, May 21	Paraguay	1997, February 8
Brazil	1999, May 23	Peru	2011, August 8
Bulgaria	1998, April 24	Poland	1989, November 11
Canada	1991, March 4	Portugal	1995, October 14
Chile	1996, January 5	Republic of Korea	2001, January 7
China	1999, April 23	Republic of Moldova	1998, October 28
Colombia	1996, September 13	Romania	2001, March 16
Costa Rica	2009, January 12	Russian Federation	1998, April 24
Croatia	2001, September 1	Singapore	2004, July 30
Czech Republic	1993, January 1	Slovakia	1993, January 1
Denmark	1968, October 6	Slovenia	1999, July 29
Dominican Republic	2007, June 16	South Africa	1977, November 6
Ecuador	1997, August 8	Spain	1980, May 18
Estonia	2000, September 24	Sweden	1971, December 17
European Union	2005, July 29	Switzerland	1977, July 10
Finland	1993, April 16	Trinidad and Tobago	1998, January 30
France	1971, October 3	Tunisia	2003, August 31
Georgia	2008, November 29	Turkey	2007, November 18
Germany	1968, August 10	Ukraine	1995, November 3
Hungary	1983, April 16	United Kingdom	1968 August 10
Iceland	2006, May 3	United States of America	1981, November 8
Ireland	1981, November 8	Uruguay	1994, November 13
Israel	1979, December 12	Uzbekistan	2004, November 14
Italy	1977, July 1	Vietnam	2006, December 24
Japan	1982, September 3	Yugoslav Rep of Macedonia	2011, May 4
Jordan	2004, October 24		
Kenya	1999, May 13		
Kyrgyzstan	2000, June 26		
Latvia	2002, August 30		
Lithuania	2003, December 10		

**WIPO CONVENTION (1967): Member states**  
(As at March 2012: 185 members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Afghanistan	2005, December 13	Costa Rica	1981, June 10
Albania	1992, June 30	Côte d'Ivoire	1974, May 1
Algeria	1975, April 16	Croatia	1991, October 8
Andorra	1994, October 28	Cuba	1975, March 27
Angola	1985, April 15	Cyprus	1984, October 26
Antigua and Barbuda	2000, March 17	Czech Republic	1993, January 1
Argentina	1980, October 8	Democratic People's Rep of Korea	1974, August 17
Armenia	1993, April 22	Democratic Rep of the Congo	1975, January 28
Australia	1972, August 10	Denmark	1970, April 26
Austria	1973, August 11	Djibouti	2002, May 13
Azerbaijan	1995, December 25	Dominica	1998, September 26
Bahamas	1977, January 4	Dominican Republic	2000, June 27
Bahrain	1995, June 22	Ecuador	1988, May 22
Bangladesh	1985, May 11	Egypt	1975, April 21
Barbados	1979, October 5	El Salvador	1979, September 18
Belarus	1970, April 26	Equatorial Guinea	1997, June 26
Belgium	1975, January 31	Eritrea	1997, February 20
Belize	2000, June 17	Estonia	1994, February 5
Benin	1975, March 9	Ethiopia	1998, February 19
Bhutan	1994, March 16	Fiji	1972, March 11
Bolivia (Plurinational State of)	1993, July 6	Finland	1970, September 8
Bosnia and Herzegovina	1992, March 1	France	1974, October 18
Botswana	1998, April 15	Gabon	1975, June 6
Brazil	1975, March 20	Gambia	1980, December 10
Brunei Darussalam	1994, April 21	Georgia	1991, December 25
Bulgaria	1970, May 19	Germany	1970, September 19
Burkina Faso	1975, August 23	Ghana	1976, June 12
Burundi	1977, March 30	Greece	1976, March 4
Cambodia	1995, July 25	Grenada	1998, September 22
Cameroon	1973, November 3	Guatemala	1983, April 30
Canada	1970, June 26	Guinea	1980, November 13
Cape Verde	1997, July 7	Guinea-Bissau	1988, June 28
Central African Rep	1978, August 23	Guyana	1994, October 25
Chad	1970, September 26	Haiti	1983, November 2
Chile	1975, June 25	Holy See	1975, April 20
China	1980, June 3	Honduras	1983, November 15
Colombia	1980, May 4	Hungary	1970, April 26
Comoros	2005, April 3	Iceland	1986, September 13
Congo	1975, December 2	India	1975, May 1
		Indonesia	1979, December 18

Iran (Islamic Rep of) 2002, March 14  
Iraq 1976, January 21  
Ireland 1970, April 26  
Israel 1970, April 26  
Italy 1977, April 20  
Jamaica 1978, December 25  
Japan 1975, April 20  
Jordan 1972, July 12  
Kazakhstan 1991, December 25  
Kenya 1971, October 5  
Kuwait 1998, July 14  
Kyrgyzstan 1991, December 25  
Lao People's  
Democratic Rep 1995, January 17  
Latvia 1993, January 21  
Lebanon 1986, December 30  
Lesotho 1986, November 18  
Liberia 1989, March 8  
Libyan Arab  
Jamahiriya 1976, September 28  
Liechtenstein 1972, May 21  
Lithuania 1992, April 30  
Luxembourg 1975, March 19  
Madagascar 1989, December 22  
Malawi 1970, June 11  
Malaysia 1989, January 1  
Maldives 2004, May 12  
Mali 1982, August 14  
Malta 1977, December 7  
Mauritania 1976, September 17  
Mauritius 1976, September 21  
Mexico 1975, June 14  
Monaco 1975, March 3  
Mongolia 1979, February 28  
Montenegro 2006, June 3  
Morocco 1971, July 27  
Mozambique 1996, December 23  
Myanmar 2001, May 15  
Namibia 1991, December 23  
Nepal 1997, February 4  
Netherlands 1975, January 9  
New Zealand 1984, June 20  
Nicaragua 1985, May 5  
Niger 1975, May 18  
Nigeria 1995, April 9  
Norway 1974, June 8  
Oman 1997, February 19

Pakistan 1977, January 6  
Panama 1983, September 17  
Papua New Guinea 1997, July 10  
Paraguay 1987, June 20  
Peru 1980, September 4  
Philippines 1980, July 14  
Poland 1975, March 23  
Portugal 1975, April 27  
Qatar 1976, September 3  
Republic of Korea 1979, March 1  
Republic of Moldova 1991, December 25  
Romania 1970, April 26  
Russian Federation 1970, April 26  
Rwanda 1984, February 3  
Saint Kitts and Nevis 1995, November 16  
Saint Lucia 1993, August 21  
Saint Vincent and  
the Grenadines 1995, August 29  
Samoa 1997, October 11  
San Marino 1991, June 26  
São Tomé and  
Principe 1998, May 12  
Saudi Arabia 1982, May 22  
Senegal 1970, April 26  
Serbia 1992, April 27  
Seychelles 2000, March 16  
Sierra Leone 1986, May 18  
Singapore 1990, December 10  
Slovakia 1993, January 1  
Slovenia 1991, June 25  
Somalia 1982, November 18  
South Africa 1975, March 23  
Spain 1970, April 26  
Sri Lanka 1978, September 20  
Sudan 1974, February 15  
Suriname 1975, November 25  
Swaziland 1988, August 18  
Sweden 1970, April 26  
Switzerland 1970, April 26  
Syrian Arab Rep 2004, November 18  
Tajikistan 1991, December 25  
Thailand 1989, December 25  
Yugoslav Rep of  
Macedonia 1991, September 8  
Togo 1975, April 28  
Tonga 2001, June 14  
Trinidad and Tobago 1988, August 16



Tunisia	1975, November 28
Turkey	1976, May 12
Turkmenistan	1991, December 25
Uganda	1973, October 18
Ukraine	1970, April 26
United Arab Emirates	1974, September 24
United Kingdom	1970, April 26
United Republic of Tanzania	1983, December 30
United States of America	1970, August 25

Uruguay	1979, December 21
Uzbekistan	1991, December 25
Vanuatu	2012, March 2
Venezuela (Bolivarian Rep of)	1984, November 23
Viet Nam	1976, July 2
Yemen	1979, March 29
Zambia	1977, May 14
Zimbabwe	1981, December 29

**WTO/TRIPS (1994): Member states**  
(As at January 2012: 153members)

<b>Country</b>	<b>Accession date</b>	<b>Country</b>	<b>Accession date</b>
Albania	2000, September 8	Ecuador	1996, January 21
Anglo	1996, November 23	Egypt	1995, June 30
Antigua and Barbuda	1995, January 1	El Salvador	1995, May 7
Argentina	1995, January 1	Estonia	1999 November 13
Armenia	2003, February 5	European Union	1995, January 1
Australia	1995, January 1	Fiji	1996, January 14
Austria	1995, January 1	Finland	1995, January 1
Bahrain	1995, January 1	France	1995, January 1
Barbados	1995, January 1	Gabon	1995, January 1
Belgium	1995, January 1	The Gambia	1996, October 23
Belize	1995, January 1	Georgia	2000, June 14
Benin	1996, February 22	Germany	1995, January 1
Bolivia	1995, September 12	Ghana	1995, January 1
Botswana	1995, May 31 May	Greece	1 January 1995
Brazil	1995, January 1	Grenada	1996, February 22
Brunei Darussalam	1995, January 1	Guatemala	1995, July 21
Bulgaria	1996, December 1	Guinea	1995, October 25
Burkina Faso	1995, June 3	Guinea Bissau	1995, May 31
Burundi	1995, July 23	Guyana	1995, January 1
Cambodia	2004, October 13	Haiti	1996, January 30
Cameroon	1995, December 13	Honduras	1995, January 1
Canada	1995, January 1	Hong Kong, China	1995, January 1
Cape Verde	2008 July 23	Hungary	1995, January 1
Central African Rep	1995 May 31	Iceland	1995, January 1
Chad	1996, October 19	India	1995, January 1
Chile	1995, January 1	Indonesia	1995, January 1
China	2001, December 11	Ireland	1995, January 1
Colombia	1995, April 30	Israel	1995, April 21
Congo	1997, March 27	Italy	1995, January 1
Costa Rica	1995, January 1	Jamaica	1995, March 9
Côte d'Ivoire	1995, January 1	Japan	1995, January 1
Croatia	2000, November 30	Jordan	2000, April 11
Cuba	1995, April 20	Kenya	1995, January 1
Cyprus	1995, July 30	Korea, Republic of	1995, January 1
Czech Republic	1995, January 1	Kuwait	1995, January 1
Democratic Rep of the Congo	1997, January 1	Kyrgyz Republic	1998, December 20
Denmark	1995, January 1	Latvia	1999, February 10
Djibouti	1995, May 31	Lesotho	1995, May 31
Dominica	1995, January 1	Liechtenstein	1995, September 1
Dominican Republic	1995, March 9	Lithuania	2001, May 31
		Luxembourg	1995, January 1
		Macao, China	1995, January 1

Madagascar	1995, November 17
Malawi	1995, May 31
Malaysia	1995, January 1
Maldives	1995, May 31
Mali	1995, May 31
Malta	1995, January 1
Mauritania	1995, May 31
Mauritius	1995, January 1
Mexico	1995, January 1
Moldova	2001, July 26
Mongolia	1997, January 29
Morocco	1995, January 1
Mozambique	1995, August 26
Myanmar	1995, January 1
Namibia	1995, January 1
Nepal	2004, April 23
Netherlands	1995, January 1
New Zealand	1995, January 1
Nicaragua	1995, September 3
Niger	1996, December 13
Nigeria	1995, January 1
Norway	1995, January 1
Oman	2000, November 9
Pakistan	1995, January 1
Panama	1997, September 6
Papua New Guinea	1996, June 9
Paraguay	1995, January 1
Peru	1995, January 1
Philippines	1995, January 1
Poland	1995, July 1
Portugal	1995, January 1
Qatar	1996, January 13
Romania	1995, January 1
Rwanda	1996, May 22
Saint Kitts and Nevis	1996, February 21
Saint Lucia	1995, January 1

Saint Vincent & the Grenadines	1995, January 1
Saudi Arabia	2005, December 11
Senegal	1995, January 1
Sierra Leone	1995, July 23
Singapore	1995, January 1
Slovak Republic	1995, January 1
Slovenia	1995, July 30
Solomon Islands	1996, July 26
South Africa	1995, January 1
Spain	1995, January 1
Sri Lanka	1995, January 1
Suriname	1995, January 1
Swaziland	1995, January 1
Sweden	1995, January 1
Switzerland	1995, July 1
Chinese Taipei	2002, January 1
Tanzania	1995, January 1
Thailand	1995, January 1
Togo	1995, May 31
Tonga	2007, July 27
Trinidad and Tobago	1995, March 1
Tunisia	1995, March 29
Turkey	1995, March 26
Uganda	1995, January 1
Ukraine	2008, May 16
United Arab Emirates	1996, April 10
United Kingdom	1995, January 1
United States of America	1995, January 1
Uruguay	1995, January 1
Venezuela	1995, January 1
Viet Nam	2007, January 11
Yugoslav Rep of Macedonia	2003, April 4
Zambia	1995, January 1
Zimbabwe	1995, March 5