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RESPONSE TO THE IPR SURVEY 2010 OF THE EUROPEAN COMMISSION

MARQUES, the European Association of Trade Mark Owners, was founded in 1987 and is incorporated in the United Kingdom as a not for profit company limited by guarantee. It has no shareholders, issues no dividends and its directors are expressly prohibited from being paid for their services.

MARQUES represents the interests of trade mark owners worldwide in the protection and utilization of trademarks as essential elements of commerce. Its current membership of trade mark owners and trade mark and design law practitioners representing trade mark owners is in excess of 750 members in 84 countries. Membership crosses all industry lines. The trade mark owners represented in the Association together own more than two million trademarks which are relied upon by consumers as signposts of genuine goods and services.

An important objective of **MARQUES** is to safeguard the interests of the public by ensuring the proper protection of trademarks and to safeguard the interests of trade mark proprietors with regard to the regime of trade mark protection. **MARQUES** attempts to achieve this objective by advancing the cause of trade mark laws which protect the public from deception and confusion. In this sense, **MARQUES** is dedicated to providing a platform for the representation of the interests of brand owners within a global economy, including the selection, management, protection and exploitation of their trade marks. Intellectual property ("IP") rights are a crucial aspect of the global economy and trademarks play a significant role in free trade and competition.

MARQUES is an accredited association before OHIM and an official non-governmental observer to the World Intellectual Property Organization (WIPO).

Therefore, **MARQUES** falls within the Commission's definition of stakeholder for this consultation, being a business association of IP right holders, i.e. an interest representative.

By way of background, the African continent comprises of 51 independent countries. Most have intellectual property legislation in place, some are more up to date than others. There are however two regional systems for trademarks and patents and, some African countries have acceded to the Madrid Protocol. Over the years, many African countries have been affected by civil unrest, which also had an impact on the protection and enforcement of intellectual property law in African countries over the years.

We deal with the different systems below:

1. **MADRID PROTOCOL**

At present there are 16 African states that have joined the Madrid system. These are, in no particular order:

Egypt, Morocco, Sudan, Algeria, Kenya, Lesotho, Liberia, Mozambique, Sierra Leone, Swaziland, Zambia, Namibia, Botswana, Madagascar, Ghana and Sao Tome.

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

Namibia deposited its instrument of accession at WIPO on 31 March 2004. A new IP bill has been drafted, but the regulations still have to be drafted. Until Namibia has promulgated its new IP Act, an international right will not be enforceable there.

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

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

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

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

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

The situation with regard to Madagascar and Sao Tome remains unclear. We understand that legislative amendments have been put in place, but have not yet had sight of the relevant provisions and there also appears to be no regulations to deal with international registrations at the registries.

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

2. ARIPO

The African Regional and Industrial Property Organization (ARIPO) was founded in 1976, and the Administrative Council adopted the Banjul Protocol on Trade Marks in 1993. There are 17 member states, being Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania (Tanganyika), Uganda, Zambia, Zimbabwe and most recently Liberia. 9 Countries have acceded to the Banjul Protocol.

With the exception of Botswana and Zimbabwe (with effect from 10 September 2010), none of the territories have amended their national legislation in order to recognize ARIPO trade mark registrations. Uganda has recently passed a new Trade Marks Act, but it does not refer to the Madrid Protocol or ARIPO trade mark applications. It is our strong recommendation that proprietors should continue to protect their trade marks on a national basis until such time as the national laws of member states for which protection is required, have been amended.

In the circumstances, the ARIPO trade mark system does not yet function effectively and any rights in respect of trademarks obtained would be difficult to enforce. On the other hand the patent system has functioned well for many years.

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3. **OAPI**

OAPI is a union of 16 predominantly former French Protectorates, which established common Intellectual Property Laws and a single Intellectual Property Office situated in Yaounde, Cameroon. The present member states are Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

OAPI follows the International Classification of goods and services and a single application may cover more than one class. However, goods and services may not be included in a single application.

Infringement of a trade mark has to be brought before the courts in the country where the cause of action arises and the national laws will apply.

The OAPI system has functioned effectively for many years.

Respectfully submitted

31st December 2010

Guido Baumgartner, Chair of **MARQUES** Council

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Enclosures: Responses to the Questionnaire for South Africa, Nigeria, Kenya, Cameroon, Namibia (Total 5 attachments)

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