



Study Visit of Focal Persons of  
African Economic Communities and  
Exe Bodies of the African Union



# Trademarks

## Their role and significance

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2016**

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# Trademarks

What, When, Where and How?



# What?

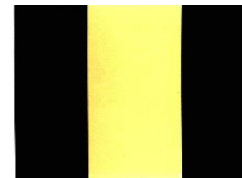
- Subject-matter of protection
- A trademark is: ...“any sign or any combination of signs, capable of **distinguishing** the **goods** or **services** of one undertaking from those of other undertakings...”

TRIPS 15(1)

# What?

“... signs, in particular **words** including personal names, **letters, numerals, figurative elements** and combinations of **colors**, as well as any combination of such signs...”

LOUIS VUITTON



# What: Exceptions & Limitations

**descriptive**

A TM **cannot** be granted if

**customary in  
trade**

**contrary to  
public policy or  
morality**

**deceptive**

**Article 6quinquies B. 2 and 3 Paris Convention**

# What: Exceptions & Limitations

TOURMALINE SOAP  
トルマリンソープ

(JP)

**GOLDEN PAGES** (DE)

**“EXTASY IF YOU TASTE IT,  
YOU ' LL BE ADDICT”**

(FR)



(RU)

Article 6quinquies B. 2 and 3 Paris Convention

# What: Exceptions & Limitations

- A TM cannot be granted
- If the sign is of such a nature as to **infringe rights** acquired by **third parties** in the country where the protection is claimed

**Article 6quinquies B. 1 Paris Convention**

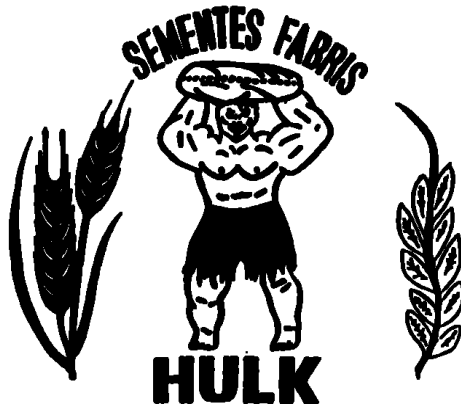
# What: Exceptions & Limitations



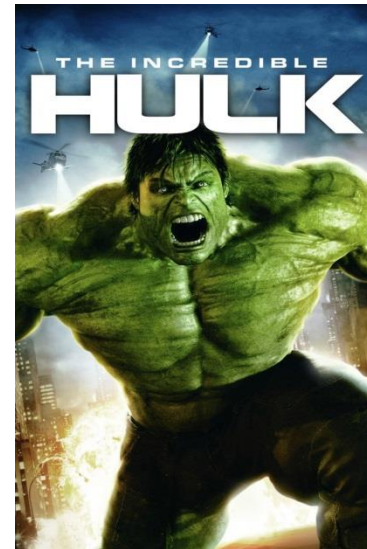
versus



(MK)



versus



(BR)

**Article 6quinquies B. 1 Paris Convention**



# How?

## Distinguishing **goods** and/or services

- Company A

- Product: Carbonated drinks

- Mark: Coca-Cola

- Company B

- Product: Carbonated drinks

- Mark: Pepsi



# How?

## Distinguishing goods and/or **services**

- **Company A**
- Service: Private Banking
- Mark: Lloyds TSB



- **Company B**
- Service: Private Banking
- Mark: HSBC



# When?



- Trademark rights may **result** from registration
- a **mark** for which registration is sought must be presented to the relevant registration authority
- The **date** of registration fixes the starting date of protection
- Trademark rights may also be recognized from **use**
- The holder of a mark who **claims** his right from first use in trade needs to **prove** that first use

# Where?

## Paris Convention: Article 6

“The conditions for the **filing** and **registration** of trademarks shall be determined in each country ... by its **domestic** legislation.”

(principle of **territoriality** and independence)



**Apple Computer, USA**



Apple

**Apple Corps., UK**

# Where?

## ■ Protection is granted within a territory

- a country;



- an area;



## ■ Protection may be “internationalized”

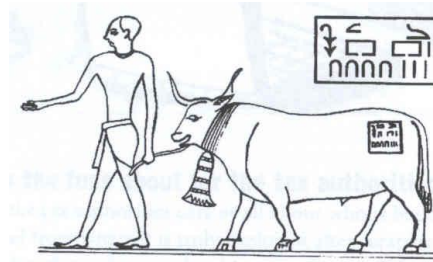
- **Madrid System** for the International Registration of Marks

- in up to 97 countries



# Why is this important for us?

- Since ancient times, trademarks have helped traders to **distinguish** their products



- Trademarks, which are the legal expression of **brands** help establish the connection between producer and the consumer



# Why is this important for us?



# Why is this important for Africa?



ECOWAS



UEMOA



IGAD



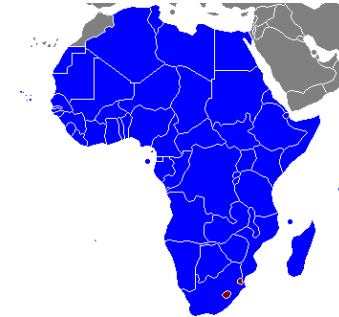
ECCAS



COMESA



SADC



AU

NEPAD



# Protection of IGO emblems

- Article *6ter* of the Paris Convention for the Protection of Industrial Property
- **What:** armorial bearings [logos], flags, abbreviations and names of international intergovernmental organizations
- **How:** prohibit the registration and use of trademarks which are identical or present a certain similarity with the signs communicated under Article *6ter*
- **But:** Defensive protection and not the establishment of any intellectual property right

# Article 6ter

## Article 6ter Express Database

- Contains all signs communicated by States Party to the Paris Convention and International Intergovernmental Organizations
- **Not** an international registry
- Information is used as evidence to prevent registrations of identical or similar signs

*<http://www.wipo.int/article6ter/en/>*

# African IGOs in Article 6ter Express

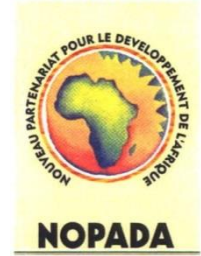


AFRICAN UNION



A Programme of the African Union

UNION AFRICAINE



Un programme de l'Union Africaine

Two institutions of UEMOA



BCEAO



# African IGOs in Article 6ter Express

## ■ Two Regional Intellectual Property Organizations:



# Good news for Africa



- Bangui Agreement establishing **OAPI**  
(*Organisation Africaine de la Propriété Intellectuelle*)
- This treaty is at the same time the national intellectual property law of OAPI Member States (17)
- It was **amended** on December 14, 2015
- New Bangui Agreement will enter into force once it is ratified by 2/3 of OAPI Members (11 out of 17)

# Good news for Africa

- Recently, **OAPI** joined two WIPO treaties:
  - The Madrid Protocol Concerning the International Registration of Marks
  - The Singapore Treaty on the Law of Trademarks
- This means great opportunities for trade to and from Africa



- This also presents the challenge to update national laws and practices
- WIPO lends its technical-legal support in the form of **legislative advice**

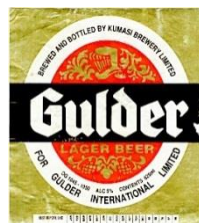
# Good news for Africa



# Good news for Africa



- Safaricom/M-Pesa, Tusker and Pilsner
- Dangote, Zenith Bank, Golden Penny Foods
- Orijin, Star Beer, Gulder Beer and Maltina
- are valued the strongest supported African brands



**WIPO**  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION



*Thanks for your attention!*  
*Merci beaucoup de votre attention!*

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