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Cotonou, March 16, 2017

The Deputy Director General
World Intellectual Property Organization
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GENEVA, SWITZERLAND

REF.: 101/MICA/DC/SGM/ANaPI/SDIT/SP

Dear Madam,

I refer to your letter no. 8607, dated November 3, 2016, enclosing document SCR/35/4 for Benin's comments and observations on the protection of country names against their registration and use as trademarks.

Accordingly, I am pleased to enclose the comments and observations of Benin, as previously submitted by the African Intellectual Property Organization (OAPI) in light of the Bangui Agreement.

Yours faithfully,

[signed]
Lazare Maurice Sehoueto
Minister of Industry, Trade and Crafts

36th SESSION OF THE STANDING COMMITTEE ON THE LAW OF
TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL
INDICATIONS

(Geneva, October 17 to 19, 2016)

**PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND USE
AS TRADEMARKS AND POSSIBLE AREAS OF CONVERGENCE**

Comments of the African Intellectual Property Organization (OAPI)

Possible area of convergence No. 1

Notion of country name

The notion of country name is not specifically defined in the Bangui Agreement, in particular Annex III thereto on trademarks and service marks, the national intellectual property law of its seventeen (17) Member States or the relevant implementing regulations. The proposal in the area of convergence meets with OAPI's approval. That is to say, a country name can be "the official or formal name of the State, the name that is in common use, **translation and transliteration** of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective".

The inclusion of translation and transliteration is, in our view, necessary. At our office, any part of a sign registered as a mark which is in a language other than French or English (OAPI's working languages) must be translated or transliterated by the applicant so that the examiner can ensure its compliance with public policy and morality.

Possible area of convergence No. 2

Non-registrable if considered descriptive

Any mark devoid of distinctive character cannot be validly registered with OAPI. The same is true for any sign which is solely descriptive, in particular of the nature, characteristics or geographical origin of the goods or services in question. Therefore, a country name would not be considered a valid mark if it were used to describe the place of origin of the goods or services or if it were perceived by the public only as an indication of the place of origin of those goods or services.

Possible area of convergence No. 5

Invalidation and opposition procedures

Under the OAPI system, procedures for opposition (before the office) and annulment (before the courts) have the same objective, i.e. to strike from the special register any mark that fails to meet the conditions for validity laid down in Annex III, Articles 2 and 3 of the Bangui Agreement. The grounds for refusal set out in possible areas of convergence Nos. 2, 3 and 4 should constitute grounds for opposition and annulment of registered trademarks.

Possible area of convergence No. 6

Use as a mark

Any use of a country name liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services in question, should be prevented using the appropriate legal instruments, the aim of which should be to stop the use of the mark by means of injunctions and to award damages and any other compensation provided for by civil law, without prejudice to the legal avenues provided by trademark legislation.