



ARIPO

*African Regional Intellectual
Property Organization*

WORKSHOP ON THE PROMOTION OF ARIPO PROTOCOLS

Processing of Applications Under the Banjul Protocol

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Port Louis, Mauritius



Fostering Creativity and Innovation for Economic Growth and Development in Africa

Outline

- **Overview of protocol**
- **Filing an application**
- **Formality Examination**
- **Substantive examination**
- **Opposition procedure**
- **Registration and publication**
- **Advantages and challenges**



Overview:

Banjul Protocol on Marks

- 1993 - Adoption of the Protocol (Banjul, The Gambia)

Regulations for Implementing the Banjul Protocol

- Established in accordance with Rule 17.5 of the Regulations
- 1995 - Adoption of the Implementing Regulations (Kariba, Zimbabwe)

Amendments (11):

- November 1997
- May 1998
- November 1999
- August 2004
- November 2013, 2014, 2015, 2018,
- August 2021 and December 2021
- November 2022

Administrative Instructions

- 1997 - entered into force

- 2023 Committee set =up to review the Protocol, Regulations and Instructions



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Status of Member States

State	Lusaka Agreement	Banjul Protocol
Botswana	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Gambia	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Cape Verde	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Ghana	<input checked="" type="checkbox"/>	
Kenya	<input checked="" type="checkbox"/>	
Lesotho	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Liberia	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Malawi	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Mauritius	<input checked="" type="checkbox"/>	
Mozambique	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Namibia	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Rwanda	<input checked="" type="checkbox"/>	
Sao Tome and Principe	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Seychelles	<input checked="" type="checkbox"/>	
Sierra Leone	<input checked="" type="checkbox"/>	
Somalia	<input checked="" type="checkbox"/>	
Sudan	<input checked="" type="checkbox"/>	
Swaziland	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Uganda	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Tanzania	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>
Zambia	<input checked="" type="checkbox"/>	
Zimbabwe	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>

Out of the 22 Member States of the Lusaka Agreement, **13** are contracting states to the Banjul Protocol.



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Effect of Country of origin

- An application for the registration of a mark may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal has not been effected in the country of origin (Rule 2)

- **Effects of Registration**

Rights conferred by the mark registered by ARIPO office shall have the same effect in every designated states as if filed under its national laws



Where and How to File?

Where?

- directly at the Secretariat
- or at the Office of a Contracting State
 - ***transmittal within one month from receipt***

How?

E-service, Walk-in, Courier, Email, Postal, Fax**

Who can File?

- a natural person or
- a representative of the applicant
 - Representatives can only be from any of the contracting states



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The Cycle



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Verification and transmittal by RO (Rule 4.1)

- RO verifies application for compliance with filing requirements
- Applicant shall be notified of non-compliance and requested to rectify
- Payment can be made in local currency, at the National office using the official exchange rate.(Rule 10.3)

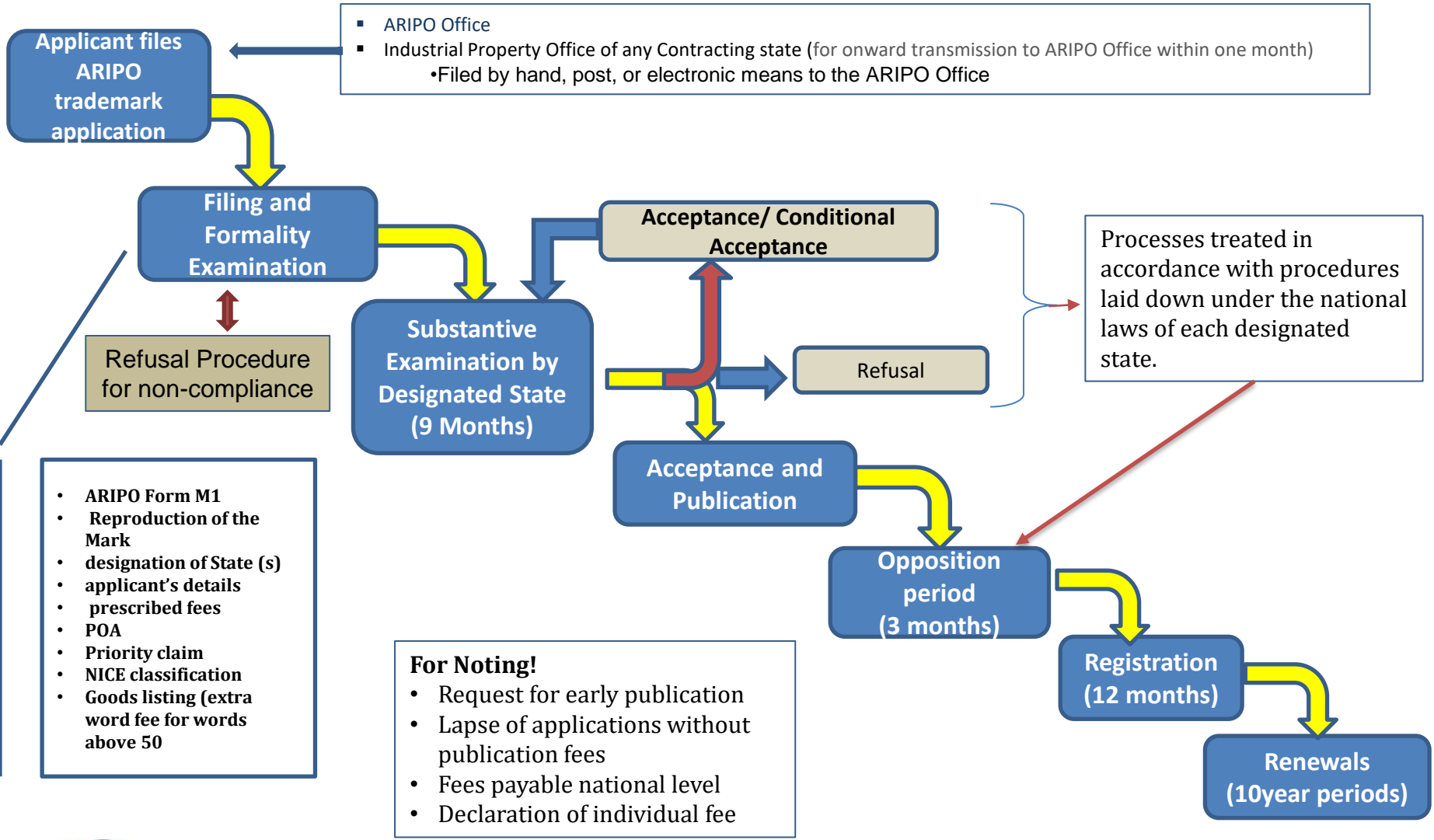
Transmittal of Application to ARIPO

- Application may be transmitted to ARIPO without being rectified on applicant's insistence
- Receiving office shall within one month of receipt, transmit the application to ARIPO.
- Documents are transmitted using a fully completed Form M5
- RO notifies applicant of transmittal through Form M6



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Trademark Processing under the Banjul Protocol



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Documents comprising an Application

An application for registration of a mark shall be filed through Form No. M 1 in accordance with (Rule 4.1) and which shall contain :

- a. Full applicant(s) contact details
- b. Representation (if applicable)
- c. Reproduction
- d. Designations
- e. Goods/Services Specification
- f. Declaration of Use
- g. Translation or transliteration



Documents comprising an Application cont'

➤ Fees

- receipt of fees or written undertaking to pay the prescribed fees within 21 days from the date of lodgment of the application
- Application fee: US\$100 (Paper Filing)
 US\$80.00 (Online Filing)
- Designation fee US\$50.00 per country for 1st class
 US\$10.00 per additional class
- Fees In US\$ or equivalent in local currency
- Check correctness of fees paid

According Filing Date and Number (Rule 5ter)

- ARIPO shall accord:
 - a filing date
 - an application numberto each application which complies with Rule 4.1.
- Notification shall be copied to all designated states
- A payment receipt shall be issued to the applicant for the application and designation fees paid.



Subsequent/Follow up documents and fees

- Subsequent documents should be filed within the given time limits or application will be refused
- These are:
 - Power of Attorney and Priority document (within 2 months)
 - Application, designation and extra word fees (within 21 days)



Notification of Compliance with Formality Requirements (Rule 6)

- Where application complies, notification of compliance (Form M8) is issued.
- Notification send to Applicant and copied to Designated States.
- Notifications requests for Substantive Examination by each Designated state



Notification of Non-Compliance with Formality Requirements (Rule 6)

- Applicant shall be notified of non-compliance on Form M4
- Applicant shall be invited to comply within 2 months from date of such notice (M4B)
- On failure to comply, application shall be refused (M4A)



Conversion (Rule 6.2)

- If the Office refuses an application, the applicant may, within 3 months from the date of refusal, request that the application be treated in any designated State as an application according to the national law of that State.
- The request for conversion of the application to a national application shall be made on Form No. M 7.

Board of Appeal Procedure

- Where the Office refuses any application, the applicant may, within 2 months, request the Office to reconsider the matter.
- Where the Office still refuses the application, the applicant may within 3 months lodge an appeal against the decision to the the Board of Appeal
- The decision of the Board of Appeal shall be final



Substantive Examination by a Designated State (Rule 11)

- ARIPO transmits all relevant documentation required for substantive examination to designated states on each application due for substantive examination.
- Transmission is done on Form M8 through the Member State Module, CD or FTP depending on the requirements of each state..
- The documents required for examination include:
 - Form M1, M2, Reproduction, priority document
 - Designated state may request any other document regarded as relevant

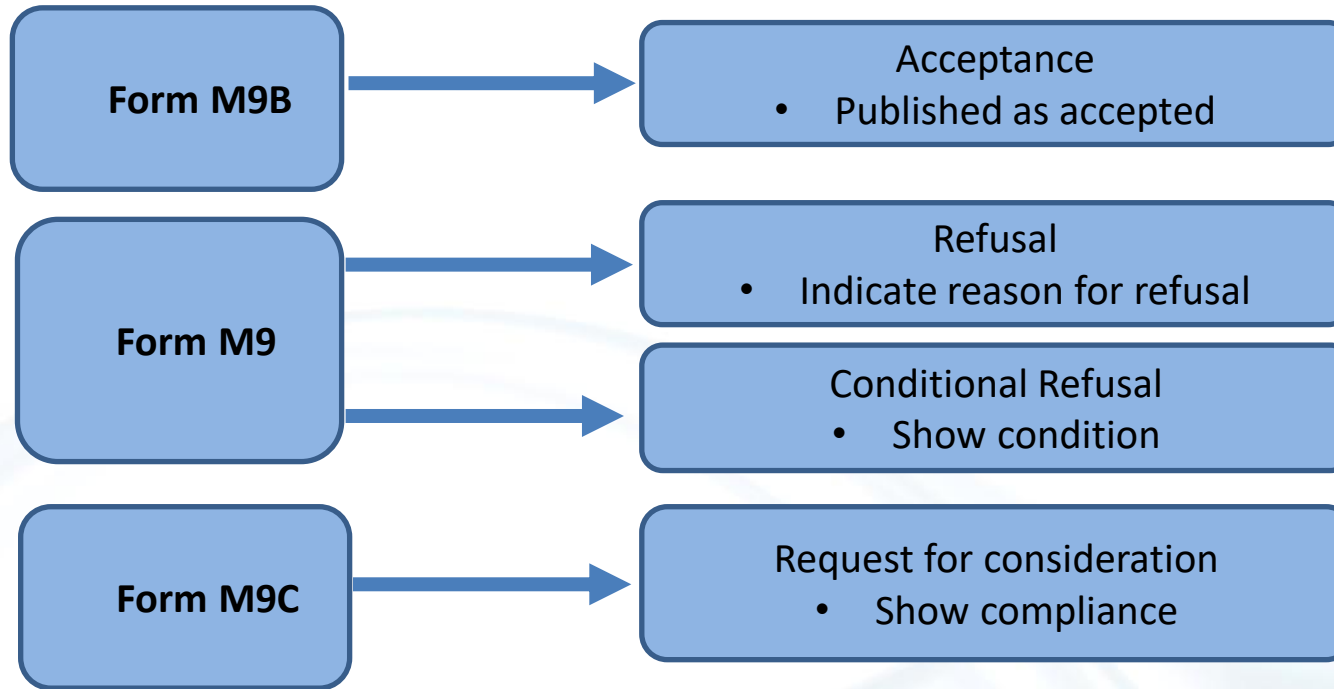


Substantive Examination by a Designated State cont' (Rule 11)

- An ARIPO Mark application is examined in accordance with the National Laws of each designated state.
- Designated States have **nine months** within which to accept or refuse registration of an application and shall give reasons for its refusal
- Such a decision shall be communicated to ARIPO within **one month** and ARIPO shall without delay communicate the same decision to the applicant
- The applicant has the opportunity to respond to the designated state concerning such a refusal.



Substantive Examination Procedures



- Where there is no communication/objection from a designated State, **after expiry of 9 months**, the application will be published as **accepted** and **registered** after 3 months opposition period on **payment of relevant fees**.
- Applicant may respond **to a refusal through M9C within 2 months**
- Designated State shall respond **to M9C within 2 months**

Publication of Notice of Acceptance/Refusal of a Mark (Rule 11bis)

- An application for registration of a Mark that has been accepted or that any designated state has not made the communication within the 9 month period shall be **published as accepted by the designated state(s) concerned** in the ARIPO Journal
- An application for registration of a Mark which a designated state has issued a communication of refusal within the 9 month period shall be published in the ARIPO Journal **as refused** by the designated state(s) concerned.



Notice of Opposition (Rule 11ter)

- Any person may give a notice of opposition to the registration of a mark within 3 months from publication of the application as accepted in the Marks Journal.
- An opposition to the registration of a Mark shall be treated according to the opposition procedures laid down under the national laws of the designated state or designated states concerned.



Opposition Process

Step 1	Submit opposition documents to ARIPO (copy DS) within 3 months from acceptance. Documents prepared in accordance with requirements of each DS
Step 2	ARIPO transmits documents to DS (M20)
Step 3	Opposition to be subjected to National procedures of each DS concerned.
Step 4	DS pronounce decision and transmits to ARIPO on M20B. Decision copied to applicant and opponent. Decision can be appealed
Step 5	ARIPO to be notified of any Appeal and subsequently, the final decision
Step 6	ARIPO records decision in Marks Register and Publish in ARIPO Journal

Registration and Publication (Rule 15)

- ARIPO shall register a mark for the applications which have been accepted by designated state(s)
- Such registered mark shall be recorded in the Marks Register
- Registration shall not include states that have refused and where an opposition procedure is yet to be concluded
- The registration of a mark shall be published in the Journal



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Certificate of Registration of a mark

- ARIPO shall issue a certificate of registration (Form M12) to the applicant
- The certificate shall contain all states that have accepted the mark for registration
- Certificate shall be sent to the applicant and copied to each designated state



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Duration and Renewal of a Mark (Rule 12)

- An ARIPO mark shall be renewed after a period of **ten years** from the filing date upon payment of renewal fees
- It may be renewed for further period(s) of ten years
- A grace period of six months shall be allowed, however a late renewal surcharge shall be levied



Lapse and Restoration of Mark (Rule 14)

- A mark not renewed for non-payment of fees shall be deemed to have lapsed.
- Such a lapsed mark shall be removed from the register
- A mark removed for non-payment of fees may be restored six months from the date of removal
- Restoration is on the request of the owner and upon payment of prescribed restoration fee



Subsequent Designation (Rule 9)

- Gives the applicant the right to designate any other Contracting State to an existing registration or application
- Such shall accordingly be subject to examination under the national law of such designated State
- The filing date of the application in the State so designated shall be the same as the filing date of the earlier application
- The date of subsequent designations shall be recorded in the register and published in the ARIPO Journal.



Advantages of the ARIPO system

- Streamlined, simplified, cost effective, faster and user-friendly procedures
- Single application for protection in all or selected designated states
- Supplementary route to the existing national routes
- Single representation on all designated states;
- Centralized renewal fees payment
- Centralized administration
- Share of fees with contracting states



Challenges of the ARIPO system

- **Domestication:**

Of the 22 ARIPO member countries, 13 are currently signatories to the Banjul Protocol, of which 8 (Botswana, Malawi, Namibia, Zimbabwe, Liberia, Uganda, Mozambique and Sao Tome) have given effect to the Banjul Protocol.

- **Time limits**

Non-adherence to time limits by users.

- **Examination**

Non-examination by some designated states



Future of the Protocol

- A system interactive with the national registration system
- Centralized examination system
- Digitalized system (MS Module)
- Country Benefits
 - ✓ Larger portion of fees to benefit Member States
- All member states joining the Banjul Protocol
- More African countries joining the organization.
- Domestication of Protocol by all contracting states



End



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