



ARIPO

*African Regional Intellectual
Property Organization*



Overview of the ARIPO Trademark System

ARIPO HARARE
3-5 September 2024



"Fostering creativity and innovation for social-economic growth of our Member States through an effective Intellectual Property System"

Outline

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Banjul Protocol: Brief Background

- **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 Protocol
 - 1995 - Adoption of the Implementing Regulations (Kariba, Zimbabwe)
- **Administrative Instructions:**
 - 1997 - entered into force
- **All Amended (10):**
 - November 1997
 - May 1998
 - November 1999
 - August 2004
 - November 2013, 2014, 2015, 2018,
 - August 2021 and December 2021, November 2022



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Current Contracting States

Botswana.....October 29, 2003

Cape Verde.....October 14, 2022

Eswatini..... March 6, 1997

The Gambia August 3, 2021

Lesotho February 12, 1999

Liberia..... March 24, 2010

Malawi March 6, 1997

Mozambique August 5, 2020

Namibia January 14, 2004

Sào Tomé and Príncipe..... February 27, 2016

Uganda..... November 21, 2000

United Republic of Tanzania.....September 1, 1999

Zimbabwe..... March 6, 1997



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Legal Instruments

Applications are processed in accordance with:

Banjul Protocol
on Marks

Regulations for
Implementing
The Protocol

Administrative
Instructions

National
Trademark Act



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FILING AN APPLICATION



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Filing an Application

Applications can be filed either:

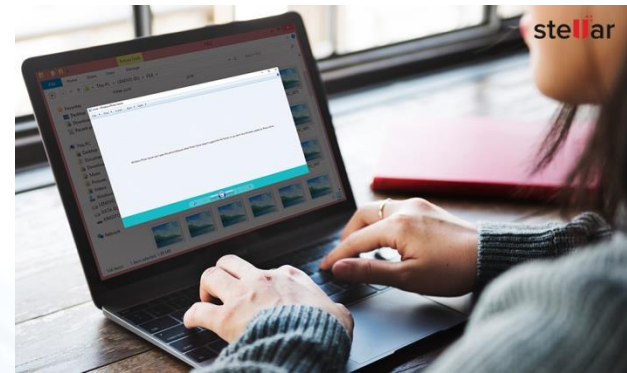
- directly at the Secretariat
- or at the Office of a Contracting State (Receiving Office)



Filing an Application Continued!

Means of filing an application:

- **On-line**
- Walk-in
- Postal*
- Courier
- Email
- Fax*



* Less frequently used



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Who can File? (Section 2:2)

- a natural person or
- a representative of the applicant
 - Representation is required where applicant is not a national of any of the contracting states or does not have a place of business within any of the contracting states.
 - Representatives should be from any of the contracting states



Filing requirements

An application for registration of a mark shall be filed through a request form (Form No. M1) and shall contain in accordance with (Rule 4.1) :

- the name and address of the applicant;
- a designation of one or more Contracting States
- a representation of the mark;
- a list of the goods or services and corresponding class or classes in the international classification.
- Declaration of actual use or intention to use the mark
- Fee payment or undertaking to pay fees.
- Power of Attorney if applicant appoints a representative



Applications filed through the
National Office of a Contracting
State or Receiving Office (RO)
(Rule 5:3)



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Contracting State as RO

- Applications can be filed through a contracting state for onward transmission to ARIPO.
- 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**
- Payment can be made in local currency where applicant is a national of that state, at the National office using the official exchange rate.(Rule 10.3)



Filing and Verification at ARIPO



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Filing at ARIPO

- Requirements specified under Rule 4 apply where an application is filed directly at ARIPO
- On receipt, ARIPO verifies documents for fulfillment of filing requirements
- Applicant shall be notified of non-compliance and requested to rectify



ACKNOWLEDGEMENT OF RECEIPT OF APPLICATION

- Acknowledgement of receipt of mark application (Form M5B) generated,
 - contains filing date and application number
 - Is sent to applicant
 - shall be copied to all designated states
- A payment receipt shall be issued to the applicant for fees paid.



Formality Examination



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Formality Examination Procedures

- Examining to ensure that prescribed formal requirements are complied with.
- Office shall issue a notice of compliance with formality requirements to designated states and applicant.
- This notification is the request for Substantive Examination by each of Designated state
- ARIPO office shall refuse the application if applicant fails to comply with formal requirements within the prescribed period.



Formality Examination

- The key documents involved in this process include:
 - 1. Application Form:** Properly filled out with all necessary details, including the applicant's information, goods classifications, declaration of use and the designated states.
 - 2. Power of Attorney:** If the application is filed through an agent, a power of attorney document must be provided within 2 months from the date of filing.
 - 3. Priority Documents:** If claiming priority from an earlier application, certified copies of those priority documents must be submitted within 3 months from filing date.



Formality Examination

- 1. Representation of the Trademark:** Clear and accurate representations of the mark, such as logos or word marks, must be provided.
- 2. Proof of Payment of Fees:** Evidence that all required fees have been paid for processing the application.



Substantive Examination



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Substantive Examination by a DS

- ARIPO transmits all relevant documentation required for each application due for substantive examination.
- Transmission is done on Form M8 through Member State Module, CD or SFTP depending on the requirements of each state.
- The documents required for examination include:
 - Form M1, M2, mark reproduction
 - Designated state may request, for any other relevant document(s)



Substantive Examination by a Designated State

- An ARIPO Mark application is examined in accordance with the National Laws of each designated state within nine months and shall issue an acceptance or refusal notice.
- Where a refusal notice is issued, the state shall give reasons for its refusal in accordance with its national laws on Form M9.
- Designated State shall communicate decision to ARIPO within the examination period
- The applicant is accorded an opportunity to respond to the designated state concerning such a refusal.



Notification of Acceptance by Designated State

- An acceptance shall be communicated under **Form M9B**
- ARIPO shall without delay communicate the same decision to the applicant.
- A change in decision or the withdrawal of the decision should be communicated to the ARIPO office within one month by the designated state.



Publication of Notice of Acceptance/Refusal of a Mark

- An application for registration of a Mark that has been accepted or refused shall be published as accepted or refused in the Marks Journal indicating the designated state(s) concerned.
- An application for registration of a Mark which a designated state has not issued a communication of refusal or acceptance **within the 9-month** period shall be **deemed accepted** and published as such in the Marks Journal.



Notice of Opposition

- Any third party may give a notice of opposition to the registration of a mark within the publication period
- ARIPO notifies the designated state on **Form M20**
- An opposition to the registration of a Mark shall be treated in accordance with the opposition procedures laid down under the **national laws** of each designated state affected.



Registration



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Registration of a Mark by the Office

- ARIPO shall register a mark for each application which has been accepted by designated state(s)
- Such registered mark shall be recorded in the Marks Register
- The registration of a mark shall be published in the Journal



Certificate of Registration of a Mark

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



Duration and Renewal of a Mark

- 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



Subsequent Designation

- Where a mark has been registered by the Office or is pending registration in the Office, the owner or applicant or, where applicable, shall have the right to designate any other Contracting State
- Such shall accordingly be subject to examination under the national law of such subsequently 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.



Relationship with National Laws

- Generally, Banjul Protocol provisions are derived from member state laws.

Harmonization and Coexistence:

- **National Autonomy:** Despite the Banjul Protocol, member states retain their national trademark laws and procedures. The protocol allows for a centralized application process, but each member state evaluates the application based on its national laws.
- **National Examination:** Each designated state has the right to examine the application according to its national legislation. This can lead to refusals or oppositions based on national laws, even if the application complies with the Banjul Protocol.



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Relationship with International Treaties and conventions

Paris Convention for the Protection of Industrial Property:

- **Priority Right:** The Banjul Protocol adheres to the principles of the Paris Convention, allowing applicants to claim a priority date based on an earlier application filed in any Paris Convention member country within six months.
- **National Treatment:** ARIPO member states provide the same protection to nationals of other Paris Convention countries as they do to their own nationals.



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Relationship with International Treaties and conventions

TRIPS Agreement (Trade-Related Aspects of Intellectual Property Rights):

- **Compliance:** ARIPO member states, being mostly members of the World Trade Organization (WTO), comply with TRIPS standards, ensuring minimum standards for trademark protection and enforcement.
- **Dispute Settlement:** The TRIPS Agreement provides a mechanism for resolving disputes between member states regarding intellectual property rights, which complements the protections offered by the Banjul Protocol



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Relationship with International Treaties and conventions

Madrid System for the International Registration of Marks:

- **Compatibility:** ARIPO is not a member of the Madrid System, but many of its member states are. Trademarks registered under the Madrid System can be extended to ARIPO member states that are part of both systems
- **Efficiency:** For applicants, using the Madrid System in conjunction with the Banjul Protocol can offer a broader scope of protection while reducing administrative burdens and costs



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**END
THANK YOU**



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