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“Inventa IP Review” is an annual compilation with the main Intellectual Property (IP) topics that occurred in the previous year.

In this first edition, we cover 2020, an unusual year in which the COVID-19 pandemic created an unprecedented disruption in global development. But in some way, this year also allows us to be more resilient.

The path of Intellectual Property was no different.

In less than a year, the world was able to create a vaccine to control the Covid-19 pandemic, and with this discovery, new IP-related issues emerged, in particular IP rights.

At the beginning of 2020, the green economy appears to be the best alternative to the current dominant economic model, indispensable to achieving sustainable development, especially in developing economies. And even if the planet has not reached its goal, it was not a forgotten subject by many.

Regarding the African continent, we continue to see many misconceptions. It can be confusing to some businesses, especially for companies and IP owners that are mainly used to protecting and enforcing their intellectual assets in other regions of the world. But lack of information and knowledge can easily lead to false understandings.

Inventa International presents a sum of all 2020 articles and relevant announcements, mainly in Africa, Europe and Asia.

Inventa International



Inventa International is an Intellectual Property firm, specializing in the protection and internationalization of trademarks, patents, industrial designs, copyright and domains, with a vast network of offices and local representatives.





TRADEMARK

- 4 Trademark registration in Somalia and Somaliland – what you need to know
- 6 Global data analysis reveals Angola's varying trademark landscape
- 7 Presidential election in Tanzania could shake the trademark landscape
- 9 How to submit a trademark customs recordal in Egypt
- 11 The elimination of the “graphical representation” requirement and its effect on non-traditional EU trademarks
- 13 What do I want to drink today? Data search reveals African filing trends
- 15 Ranking (trademark) innovation in Africa
- 16 Essential steps for Chinese companies filing trademark applications in Africa
- 18 Proof of use in Algeria
- 19 Is Western Sahara a no-go for trademark protection?
- 22 EUIPO launch of AfrIPI aims to shake up trademark registration in Africa
- 24 Understanding the nuances of trademark use in various ARIPO jurisdictions
- 26 How to best manage trademark applications in Africa
- 28 Protection and use of Certification Trademarks in Africa
- 30 Confusion remains over the not-so-young Trademarks Act of Sierra Leone
- 31 Ethiopia's online trademark system brought to a halt by internet shutdown
- 32 Registering defensive trademarks in Mozambique
- 33 The absence of service marks protection: a roadbump in the history of Zambian IP law
- 35 Pending trademark regulations in Nigeria
- 36 Why the green economy is important to Ghana – and how certification marks contribute to it
- 38 Mozambique joins the Banjul Protocol on trademarks
- 39 A new era for trademarks in Angola?
- 41 WIPO data reveals rise in international trademark applications originating from Africa
- 42 Amendments to the trademark registration procedure in Angola
- 43 The growth of trademarks in Angola
- 44 ICLG Chapters: Portugal and Angola
- 45 Somalia Trademarks Office resumes operations after almost 30 years
- 46 How religion influences trademark applications in Libya
- 48 Life of a trademark at the African Regional Intellectual Property Organisation
- 49 Registration challenges for pharmaceutical trademarks in Angola
- 50 How to stay on top of trademark oppositions in Lesotho

PATENT

- 52 Patent Applications in the European Continent having Origin in China
- 54 How can Utility Models provide protection to subjects with smaller levels of "inventiveness"?
- 56 Patent Applications in the African Continent having Origin in China
- 57 Looking at EU priority in ARIPO patent applications
- 59 European Patent Applications filed by Applicants from Africa
- 60 Green Patents and Remote work? What are the odds?
- 62 China takes over world leadership in international patent applications
- 64 Which countries do not belong to the International Patent System?
- 65 Patent Applications as an Indicator of Research and Development Against Coronaviruses
- 68 Patents related to Artificial Intelligence in the European Patents Office

COPYRIGHT

- 70 The protection of copyrights through Algorithms
- 72 The implementation of the Beijing Audiovisual Performances Treaty in Nigeria

IP RELATED

- 75 Let's Talk about Brexit
- 76 A fond farewell to Fernando dos Santos – Bemanya Twebaze elected new director general of ARIPO
- 77 Amendments to OAPI system will shake up the entire registration process
- 78 A guide to OAPI: what you need to know
- 79 Counterfeiting of Drugs in Africa: current situation, causes and countermeasures
- 81 Covid-19 prompts applicant-friendly requirements in Cape Verde
- 83 Is covid-19 a force majeure for trademark use in Angola?
- 84 African database searches uncover small rise in corona or covid-related marks
- 85 Pause for thought - Misconceptions of IP in Africa
- 89 The importance of brand protection in Kenya
- 91 Sao Tome and Principe – tips to manage trademark portfolios during covid-19
- 92 The impact of covid-19 on IP rights prosecution in Cape Verde
- 93 Intellectual Property, Covid-19 and African Countries: better forge your own path?
- 95 Mauritius: an African success story
- 97 Amendments to Zanzibar's IP practices
- 98 Cape Verde makes its first steps to protect Appellations of Origin and Geographical Indications
- 99 Increase in IP fees could shake up filing in Ghana and Tunisia
- 100 Counterfeit goods: a critical situation in Mozambique
- 101 The law on distinctive signs in Mozambique explained
- 103 Announcements: 5 minutes reading about



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Trademark registration in Somalia and Somaliland

What you need to know

Inês Sequeira

Africa

Somalia & Somaliland



The Somalia Trademarks Office resumed operations at the end of 2019, when the Ministry of Commerce and Industry issued Ministerial Decree 1/2019, stipulating that trademark registrations are once again permitted. The decree is based on Somali Trademark Law 3 (1955), as amended by Law 33 (1975) and Law 3 (1987).

Only single-class applications are being accepted by the office. Further, a trademark is valid for 10 years from the filing date of the application and may be renewed indefinitely every 10 years.

In order to register a trademark, the Office will carry out a search to ascertain whether the mark already exists. Once the application fees have been paid, the application is then filed. The application should contain the proposed mark, the class of goods or services, and the applicant's name, address and signature. If the applicant is a foreign company, a power of attorney is required. The application is then examined to determine its inherent registrability and any conflict with prior existing registrations or applications. If accepted, the application will be advertised in the local gazette or on the IP website for 35 days. If there is no opposition after 45 days, the registrar, on payment of the prescribed fee, will enter the trademark in the register and issue a certificate of registration.

The requirements for registration include providing:

- a representation of the mark
- a specification of the goods;

- the name and address of the owner;
- a copy of a signed power of attorney form ;
- a copy of the applicant's business registration certificate;
- a copy of the trademark registration certificate in the applicant's country of origin; and
- a company profile (ie, summary of the company's business activities and countries in which it operates).

Cautionary notices in Somalia

Trademark owners can rely on the cautionary system to protect their marks. In order to ensure that a cautionary notice reaches a wide audience, it will be published in the local language (Somali) in the print newspaper Mogadishu Times – published daily – and in English in the online newspaper hadhwanaag.ca – available on the website within two working days.

Republication of the cautionary notice is recommended every two to three years.

Cautionary notices in Somaliland

Although Article 16(2) of the Somaliland Constitution states that “the law shall determine the rights to authoring, creating and inventing”, no trademark registration laws, systems or offices have been implemented yet. As such, is advisable to publish cautionary notices as a means of enforcing trademark rights. The recommended procedure for publishing is as follows:

- Publish a cautionary notice in a print newspaper – this will be released in the

weekly English newspaper the Horn Tribune.

- Publish a cautionary notice, in English, in the online newspaper the Somalilandsun – this will be available on the Somalia Trademark Office website within two working days.

- Publish a cautionary notice in Somali – this will appear in the Horn Tribune, which is published every Monday, Wednesday, Thursday and Saturday. Once published, the online version will also be published online in the Somalilandsun.

Requirements for publishing include providing:

- a clear copy of the mark;
- a list of the relevant goods and/or services to which the mark is applied as per the Nice Classification; and
- the name and address of the trademark owner.

The cautionary notice should be republished every two to three years. |



Global data analysis reveals Angola's varying trademark landscape

Diogo Antunes

Africa

Angola



Angola is a lusophone country on the west coast of Africa. Over the past two decades, it has piqued the interest of big brands and multinationals as a lucrative destination for investment. Many companies have preventively filed their trademarks there in order to market their products or services safely in the future. Further, it is common to find several applications for well-known trademarks on behalf of national companies or people in the national trademark bulletin – these tend to generate many oppositions. This article provides a global analysis of trademark applications in Angola to uncover the trends.

A record number of trademark applications were filed in Angola in 2014 (around 5,500). While numbers have since fallen, in the last three years it seems that the upward trend has resumed its course.

Class 35 is the preferred one for trademark applications in Angola, with 7% of trademark applications designating this, followed by Classes 9 and 41. The top five nationalities of trademark applicants in Angola are Angolans, followed by Portuguese, North Americans, South Africans and French.

The companies with the most trademarks in Angola are as follows:

- Sonae;
- Mundialsanzi – Comércio Geral Importação e Exportação, Limitada;
- Naspers;
- Nestlé;
- Noble Group, Limitada;
- BP PLC;
- Johnson & Johnson;

- Refriango – Indústria e Comércio Geral Limitada;
- Glaxosmithkline PLC; and
- WSB World Soft Drinks, Ltd.

The Angolan national companies with the most trademarks are as follows:

- Sanzi – Comércio Geral Importação E Exportação, Limitada;
- Noble Group, Limitada;
- Refriango – Indústria e Comércio Geral Limitada;
- Cabire Alimentos Limitada;
- Overseas International Trading Company, Limitada;
- Tropigália, Ltda;
- Neofagecomidis Produtos Farmacêuticos Limitada;
- Semba Comunicação, Limitada;
- Prince Farma, Ltda; and
- Grupo Chicoil, Sa.

In Angola, the brands of several multinational entities are protected. In many cases, these registrations were preventative, since the vast majority of these businesses do not operate directly in the country. Generally in Angola, it is common for prestigious trademark applications to be the subject of litigation between multinationals and companies or local applicants.

Looking at Angola's *Trademark Bulletin*, it is easy to identify trademark applications by national applicants that operate under another name in other countries. In some cases, the registration of these marks has been prevented. However, when dealing with marks that have a presence in a few countries but that are not well known in Angola, it is very difficult to invalidate these registrations. Most multinationals are aware of this situation and are rushing to file applications for their marks. The richness of the natural resources and its immensity along the African continent has made Angola an attractive country for foreign investment. |

Presidential election in Tanzania could shake the trademark landscape

Vera Albino

Africa

Tanzania



Despite the United Republic of Tanzania – which comprises Tanzania Mainland and Zanzibar – frequently stating that innovation is a key driver of economic development and exceeding expectations for its innovation development this year, trademark owners have expressed uncertainty as to the future of IP protection in the light of the presidential elections that took place on 28 October 2020.

In 2019 the then-deputy permanent representative of Tanzania, Robert KV Kahendaguza, gave a statement before the Assemblies of the Member States of WIPO, in which he reassured them that: “We fully understand the importance and the contribution of IP in fostering industrial development and productivity.” This coincided with an increase in the number of trademark registrations in the United Republic of Tanzania, reflecting the constant increase in contributions from rights holders to the gross domestic product (GDP) of the country since 2009.

Tanzania’s progress

The adoption of the free-market economy in the 1980s, which assigned a mere regulatory function to the government, was highly beneficial to both the private sector and the economy as a whole. Now, more than 90% of businesses in Tanzania are small companies that are responsible for 40% of total employment and 35% of GDP. Most of these companies have registered trademarks. Further, the government is making efforts to modernise the IP system, with the Business Registrations and Licensing

Agency (BRELA) of Tanzania Mainland and the Zanzibar’s Business and Property Registration Agency (BPRA) adopting an online trademark registration system, which is rare in Africa.

The [Global Innovation Index \(GII\) 2020 Report](#) revealed that the United Republic of Tanzania ranked 88th among the 131 economies featured in the index. It was placed first in the 16 low-income group economies and fourth among the 26 economies in sub-Saharan Africa. Tanzania is recognised as having a reasonable innovation system and good international connectivity. The country benefits from strong university-industry research collaboration and cluster development, high productivity growth among its workforce and strong gross capital formation. Finally, the country ranks among the top 25 for creative goods exports.

Post-election climate

The presidential elections of 28 October, following which the incumbent President John Magufuli was re-elected, unveiled a highly polarised society. This is not necessarily negative, as a society whose members are divergent can be creative thinking, innovative and often prosperous. However, there has been some disquiet following the election, as the spectre of violence and conflict often hovers over young nations. With regard to trademark protection, if Tanzania were to become unstable, it would jeopardise all laudable improvements achieved by the BRELA and the BPRA and endanger the effectiveness of trademark rights, which

depend on enforcement by government institutions. These institutions must be capable of action and require stability to do so. Further, internal turmoil would hold back the creation and development of SMEs, thereby substantially reducing the protection of trademark rights. Finally, economic insecurity could cause a brain drain, which would put a stop to innovation in the country and may lead to a flight of investors from the country.

Tanzania's progress and stability have set an example for many developing countries in Africa. Many developed states also respect the country's continuous efforts to enhance its economic and legislative weaknesses. It is hoped that the past 10 years of development will be sufficient to secure peace and governance of the law, including trademark law.

“ The adoption of the free-market economy in the 1980s, which assigned a mere regulatory function to the government, was highly beneficial to both the private sector and the economy as a whole. ”

How to submit a trademark customs recordal in Egypt

Inês Monteiro Alves

Africa

Egypt



Trademark infringement in Africa is one of the reasons why various stakeholders avoid seeking protection there, as it is believed that the trademark registration systems of certain countries are not as effective as those of more developed countries. This is one of many misconceptions about intellectual property in Africa. Some countries on the continent – whose legislation does not provide for a formal recordal of trademarks before a customs authority – offer the possibility of requesting an informal registration.

Egypt

In Egypt, filing an informal registration before Customs can be effective in protecting against counterfeits. A formal registration before the customs authority is not available in Egypt, despite the Executive Regulations of the Import and Export Law 118 (1975), which restricts the import of products that infringe IP rights and the procedures available to rights holders to stop and prevent infringing shipments from entering the country. However, it is possible to seek IP protection and fight counterfeits by means of an informal registration.

The process starts by addressing a letter to the customs authority requesting to enter a mark in a watch list for monitoring possible counterfeit consignments. The letter should contain information about possible local distributors, the country of export and the usual ports of arrival in Egypt.

It is then the rights holder's responsibility to have detailed knowledge of the incoming products (eg, the port of origin,

shipment number, name of the vessel, name of consignee and date of arrival of shipment at the port), which will make the customs authority alert to possible infringement and able to identify and seize the shipment, if necessary. Without this information, infringing products can and do enter the country unchecked.

This letter should be accompanied by a certified copy of the registration certificate of the trademark in Egypt and a power of attorney legalised before an Egyptian consulate. The request will be then forwarded by Customs to all customs units in Egypt.

In the case that Customs detects any goods being imported or exported under a trademark included in the watch list, an alert will be sent to the IP owner, which then has the option to file a lawsuit. This is mandatory to continue with the seizure of the shipment and to call for an expert to examine the shipment and confirm the infringement. In addition, a civil case should be filed within 15 days from the date of the seizure order in order to obtain a decision on merits.

Following the publication of Decrees 992/2015 and 43/2106, which entered into force on 16 March 2016, the Ministry of Trade and Industry has introduced important changes to the customs clearance procedure, as well as to the list of regulated products subject to conformity assessment. As of this date, manufacturers or trademark owners of regulated products must be registered at the General Organisation for Export and Import Control (GOEIC) to be able to import products into Egypt.

In order to register a company or factory in the GOEIC, the rights holder must submit the following, along with a power of attorney legalised before an Egyptian consulate:

- a consulate copy of the licence issued to the factory or a certificate of the contents of the licence legalised at an Egyptian consulate and the Chamber of Commerce;
- a copy of the commercial register of the company legalised at an Egyptian consulate and the Chamber of Commerce;
- a certificate of registration of the trademark or priority documents that have been issued by the Egyptian trademark office within six months from the filing date; and
- a certificate that the factory applies the quality control system (ISO certificate) legalised by an Egyptian consulate and the Chamber of Commerce.

All of these documents must be translated into Arabic. |

“ In Egypt, filing an informal registration before Customs can be effective in protecting against counterfeits. ”



The elimination of the “graphical representation” requirement and its effect on non-traditional EU trademarks

João Pereira Cabral

Europe



The current European Union (EU) Regulation (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark) on EU trademarks entered into force on the 1st of October, 2017.

One of the major modifications introduced by that Regulation was the elimination of the graphical representation requirement of trademarks. This requirement was held responsible for being an obstacle to the registration of non-traditional trademarks.

The aim of this article is to analyze the effect of this change on non-traditional trademarks registrations in EU.

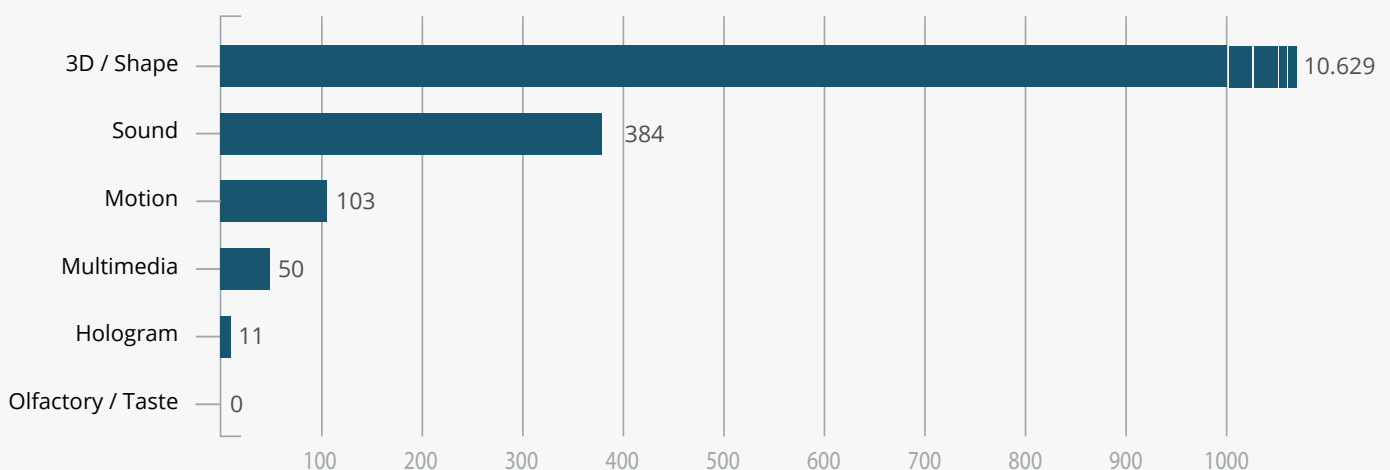
Non-traditional trademarks

Article 4 of the EU trademark Regulation provides that “An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds (...)”. This means that non-traditional trademarks can be registered in the EU.

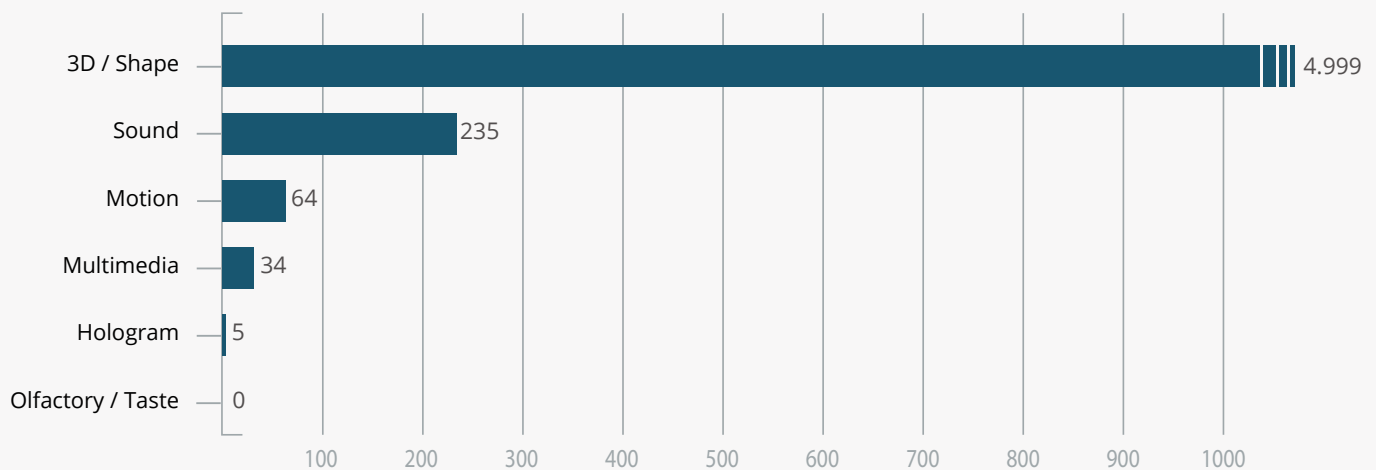
A non-traditional trademark may be defined as any trademark that cannot be considered a traditional trademark. Traditional trademarks are word marks, figurative marks and word marks with figurative elements.

Non-traditional EUTM, All status:

Total
11.177



Registered non-traditional EUTM:



Non-traditional trademarks are any other trademarks. Examples of non-traditional are 3D or shape, hologram, motion, multimedia, olfactory / taste and sound trademarks.

According to the European Union Intellectual Property Office (EUIPO)'s database there are currently (October 6, 2020) 11.177 non-traditional trademarks if searched by all status and 5.613 non-traditional EU trademark registrations currently valid, being 4.999 of them 3D or shape trademarks.

The “graphical representation” requirement

Prior to the 1st of October, 2017, Article 4 of the EUTM Regulations then applicable provided as follows: “A Community trade mark may consist of any signs capable of being represented graphically (...)”. This meant that any sign had to be necessarily represented in one specific way: graphically. Any other way of representing the sign was not allowed. For example, sound marks could not be represented through a MP3 file nor a multimedia mark be represented through a MP4 file.

Whatever the type of sign, the representation had to be graphic. This was not problematic for signs that are apprehended by vision and are static, like 3D or shape signs and holographic signs. These signs, despite being non-traditional, can easily be graphically represented. However, for signs that are apprehended by other senses than vision, like olfactory, taste and sound signs the graphic representation was difficult or impossible.

Applicants managed to fulfill this requirement in what sound signs are concerned, by filing, for example, musical scores. However, for sounds that were not music, graphical representation was very difficult, if not impossible, as, for example, sound spectrograms were not admitted. This was because not only the representation had to be graphic, it also had to be clear, precise, self-contained, easily accessible, intelligible, durable and objective” (ECJ decision in Sieckmann V. Deutsches Patent und Markenamt, C-273/00). Mere descriptions were not sufficient as well.

(...)



What do I want to drink today?

Data search reveals African filing trends

Diogo Antunes

Africa



Trademark application numbers can reveal a great deal about a country. This article takes a closer look at the trademark databases of the African Intellectual Property Organisation (OAPI), Angola, Cape Verde, Mozambique and South Africa to reveal how the alcoholic and non-alcoholic beverages sector varies among African jurisdictions. But before presenting the data, it is important to note that most databases are not public and because of this, the following information may contain some inaccurate statistics.

It is also worth noting that there are two classes for beverages:

- Class 32, which includes non-alcoholic beverages and beer; and
- Class 33, which includes alcoholic beverages other than beer.

OAPI

Over the past seven years, OAPI has received an average of 450 beverage-related trademark applications per year. Drinks in Class 32 represent about 70% of these.

The main applicants are:

- Brassivoire;

- Diageo Ireland;
- Beverage Trade Mark Company Limited;
- Fan Milk International AS;
- Societe Anil Sarl;
- Patisen SA;
- Groupe Abbassi;
- Monster Energy Company CA;
- E & J Gallo Winery CA;
- Noble Spirits (Pty) Ltd;
- Khazaal Industries;
- Cowbell International Inc;
- Fortune Industries Ltd;
- Castel Freres;
- Compagnie Gervais Danone;
- Laurent-Perrier;
- Toto Limited;
- The Coca-Cola Company GA;
- Pepsico Inc NY;
- and
- Société Lakhi Industries Benin Sarl.



Angola

Inventa International found a database with almost 8,500 trademark applications in Angola. Class 32 is the ninth most-requested class of all applications.

In particular, 2009, 2014 and 2015 proved to be highly profitable years for the beverage sector, with more than 740 trademark applications each year. The main applicants were:

- Modelo Continente Hipermercados SA;
- Refriango – Indústria E Comércio Geral,

Limitada;

- Companhia Brasileira De Distribuição;
- WSB World Soft Drinks Limited;
- Sanzi – Comércio Geral Importação E Exportação, Limitada;
- Cabire Alimentos Lda;
- Overseas International Trading Angola Company Limitada;
- The Coca-Cola Company GA;
- Yamaha Corporation; and
- Newaco Grupo Lda.

Cape Verde

Cape Verde has a much lower number of applications than the other countries analysed in this article. Even so, it was possible to access a little more than 600 trademarks applications in Classes 32 and 33. The difference in numbers per class is small, with 55% of filings designating Class 32.

The main applicants are:

- Diageo Brands BV;
- The Coca-Cola Company;
- Sogrape Vinhos SA;
- Diageo Scotland Limited;
- Rauch Fruchtsäfte GmbH;
- Tecnicil Industria SA;
- Unilever NV;
- Pernod Ricard;
- Chivas Holdings IP Limited; and
- Sumol + Compal Marcas SA.

Mozambique

Almost 1,600 applications designating Classes 32 and 33 were found on the Mozambique register. What is more, the difference between classes is significant, with 61% of applications designating Class 32. In recent years, the average number of applications has been fairly constant, reaching almost 100 per year. The main applicants are:

- Tropigalia Lda;

- Navya Distilleries Lda;
- Sabmiller International BV;
- Yaafico Industrial Lda;
- Wal-Mart Stores, Inc AR;
- Chivas Holdings IP Limited;
- Bakhresa Grain Milling Mozambique Lda;
- KVV Intellectual Properties Pty Ltd;
- Cervejas De Mocambique SA;
- Mozamvini Distribuicao, Limitada; and
- Sumol + Compal Marcas SA.

South Africa

South Africa has more than 32,000 trademark applications for Classes 32 and 33, with 56% of applications in Class 33. In the past 10 years, the average number of applications has grown, reaching more than 1,000 applications per year.

The main applicants are:

- DGB (Proprietary) Limited;
- Stellenbosch Farmers' Winery Limited;
- Tiger Food Brands Intellectual Property Holding Company (Proprietary) Limited;
- The Coca-Cola Company GA;
- The South African Breweries (Pty) Ltd;
- Trans-Scripto (Pty) Ltd;
- KVV Intellectual Properties (Pty) Ltd;
- Pioneer Foods Groceries (Pty) Ltd;
- Société Des Produits Nestlé SA; and
- Rogge Cloof (Pty) Ltd. |

Ranking (trademark) innovation in Africa

João Francisco Sá

Africa



The 2020 Global Innovation Index (GII) was released in September. The study was authored by WIPO, Cornell University and INSEAD and focused on innovation financing, against the backdrop of the economic impact of the covid-19 pandemic. This article focuses on how African countries performed, using trademark-related information as an indicator.

Africa at a glance

The most innovative economies on the continent are Mauritius (52nd place), South Africa (60th), Tunisia (65th) and Morocco (75th). The study concluded that while most countries ranked fairly low in several indicators, such as R&D, high government reliance and challenging business environments, the report highlighted several countries' strengths, including high expenditure in education (ie, Botswana and Tunisia), R&D (ie, South Africa, Kenya and Egypt) and strong use of the IP system (ie, Kenya, Tunisia, South Africa, Namibia, Madagascar and Morocco).

In sub-Saharan Africa, besides Mauritius and South Africa, the top innovators are Kenya (86th), Tanzania (88th), Botswana (89th), Rwanda (91st) and Cape Verde (100th), while the remaining 10 ranked countries scored lower than 100th place.

The study shows that sub-Saharan countries tend to perform above expectations compared to their level of development. However, while these countries' strengths are in their institutions, markets and business sophistication, their weakness is in creative output.

Trademarks as an indicator of innovation in Africa

The number of trademark applications by origin (class count) – measured by gross domestic product based on purchasing power parity – was one of the creative outputs that the GI evaluated. In this sphere, the top African countries are Mauritius (21st), Namibia (26th), Madagascar (40th), Morocco (55th), Togo (60th), Cabo Verde (73rd), Kenya (74th) Mozambique (77th) and South Africa (79th).

The report demonstrates that for Mauritius and Namibia, the volume of trademark applications should be seen as an innovation strength, meaning that it is one of the 10 innovation indicators for that country. With regard to Madagascar and Togo, this indicator is deemed an income group strength, meaning that the countries rank above average for their income. On the other hand, this indicator is seen as a weakness in Zimbabwe (123rd) and Ethiopia (126th).

Comment

While this analysis shows that African countries still have some catching up to do in terms of innovation, the report confirms that they have many strengths, which could foster sustained growth in neighbouring countries if progress and cooperation is encouraged and practical innovation policies are enacted.

The number of trademark applications by origin demonstrates that although some African countries are global leaders, others still rank fairly low. Trademark applications are a good measure of innovation in intellectual property as they show the creative outputs of local companies trying to sell their goods and services. However, grassroots IP policies are still required to push for development in the African IP landscape. |

Essential steps for Chinese companies filing trademark applications in Africa

Crystal Zhang

Asia / Africa



Chinese companies began investing in Africa in the last century, mainly via direct investment. In 2013 President Xi Jinping proposed China's Belt and Road Initiative (BRI) in order to connect Asia with Africa and Europe via the continental belt and maritime road across 65 countries. Its aim is to improve regional integration, increase trade and stimulate economic growth.

The initiative offers unlimited opportunities for various African countries to attract investment from Chinese companies through infrastructure projects, mining, real estate and agriculture.

This rise in investment has led to a year-on-year increase in the number of Chinese companies looking to register and protect their IP rights in Africa. Such companies can register trademarks in Africa by filing:

- via the Madrid System for international registration;
- a regional trademark registration; or
- a single-country trademark registration.

Madrid System

The Madrid System is the main international convention that African countries have joined. At present, 123 countries and regions have joined the Madrid Agreement, the Madrid Protocol and the African Intellectual Property Organisation (OAPI). However, it is difficult to confirm the effectiveness of Madrid international registrations in some African countries (eg, Ghana, Lesotho, Liberia, Sierra Leone, Swaziland and Zambia).

For Chinese companies seeking trademark protection in Africa, Madrid System processes are simpler and more cost-effective than alternative routes. However, for Chinese companies to adopt this system, the application process is relatively long and requires examination by the China National IP Administration, WIPO and the local state trademark office.

Regional trademark registration in Africa

There are two regional IP organisations in Africa: OAPI and the African Regional Intellectual Property Organisation (ARIPO). Through these, applicants can obtain trademark protection in multiple countries in the corresponding region through one application.

OAPI represents 17 African member states: Benin, Burkina-Faso, Cameroon, Central African Republic, Chad, Comoro Islands, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea-Bissau, Guinea, Mali, Mauritania, Niger, Republic of Congo, Senegal and Togo. OAPI registers trademarks in both French and English.

Registration through OAPI helps to ensure that a Chinese company's trademark is protected in all member states, as it can register through the organisation without individually filing a trademark in the countries in which protection is sought. After the trademark is granted, it will be effective in all member states. However, it is not possible to include both the category of goods and the category of services in one application through OAPI. Instead, separate trademark applications

must be filed. In terms of examination, OAPI only conducts formal and substantive examinations based on absolute grounds and does not conduct a prior examination of identical or similar marks. Overall, the registration process takes about 18 months.

ARIPO comprises countries in Central and Eastern Africa whose official language is English. The 10 countries that have enacted the Banjul Protocol for Trademarks are Botswana, Eswatini, Lesotho, Liberia, Malawi, Namibia, Sao Tome and Principe, Tanzania, Uganda and Zimbabwe. The ARIPO trademark system is similar to the Madrid System and applicants can designate one or more member states.

Single-country trademark registration

In comparison to the Madrid System, the advantage of a single-country trademark registration is that it is not restricted by a Chinese trademark registration. It can be registered based on the actual and specific needs of the company in the target country. Chinese companies cannot file trademark applications themselves in China and must entrust local agencies to process the application directly with the local trademark office.

The region's three largest economies – Nigeria, South Africa and Angola – are among the top 10 wealthiest African countries according to gross domestic product and are China's three major trading partners in Africa. These three countries are not members of the Madrid International Registration System, ARIPO or OAPI. Therefore, registering a mark in South Africa, Nigeria or Angola must be done through a single-country registration method (ie, domestic trademark registration procedures) and both a formal and substantive examination must be carried out. It takes roughly two years from filing to registration in South Africa, and three years in Nigeria and Angola. |



Proof of use in Algeria

Inês Tavares

Africa

Algeria



The Algerian Trademark Law 03-06 (2003) states that a trademark registration is valid for 10 years from the application's filing date and may be renewed for 10-year periods after this.

In 2015 the Algerian Patent and Trademark Office (PTO) implemented new rules on renewing trademark registrations, which stated that renewals should be accompanied by proof of use and delivered in the year preceding the renewal deadline. This requirement applies to trademarks but excludes other distinctive trade signs.

A registered trademark owner has an exclusive right over the trade name. The monopoly over the relevant products and/or services is perceived as a privilege, and the owner must either use the trademark or make it available for future rights holders in the marketplace. Demonstrating the effective use of a trademark in a specific jurisdiction ensures that the applicant holds a real interest in maintaining the asset protected.

This practice differs widely across various African jurisdictions.

There are territories in which proof of use is not required, although there is an obligation for the owner to use the trademark under penalty of having the registration challenged in the form of cancellation based on non-use.

In other countries, such as Mozambique, it is mandatory to file a declaration of intention of use every five years (excluding the year in which the renewal is due). Finally, countries such as Kenya

and Ghana allow trademarks that have not been renewed and should have lapsed to block the registration of new trademark applications, which gives unlawful rights to the owner of a lapsed mark, rather than preventing uninterested parties from holding the right to a trademark for eternity.

Algeria's system can be perceived as a middle ground between several practices on the continent. The PTO can confirm whether the renewal is based on a real interest on the owner's part to use the trade name in the Algerian market.

Further, if the applicant is unable to prove that it has used the trademark in the past 10 years, this is a good indication of a lack of interest and that the distinctive trade sign could be held and used by a different market player.

Proof of use is due upon renewal of a mark and a signed declaration of use of the trademark should be delivered along with a signed power of attorney.

Nevertheless, trademarks registered in Algeria can also be challenged by way of a cancellation action on the grounds that the trademark has not been subject to serious use for three years. |

Is Western Sahara a no-go for trademark protection?

Vera Albino

Africa

Western Sahara



Western Sahara is an Atlantic-coastal desert area of 266,000km², bordered by the Atlantic Ocean, Morocco, Algeria and Mauritania. A former Spanish colony, it has been on the the United Nations (UN) list of non-self-governing territories since 1965 along with 17 other territories.

'Non-self-governing territories' are defined as "territories whose people have not yet attained a full measure of self-government" according to Chapter XI of the UN Charter.

The reasons for a region to be declared a non-self-governing vary and are specific to each territory.

In the case of Western Sahara, this is mainly due to the fact that it is a disputed territory between the Saharawi people, led by the Polisario Front, which self-proclaimed it the Sahrawi Arab Democratic Republic (SADR) in 1976, and Morocco, which annexed two-thirds of the country in 1975 after the withdrawal of Spain.

Many governments recognise the SADR and it is a full member of the African Union. However, Morocco sees Western Sahara as part of its historic territory and continues to claim control of the region. This contradiction of positions resulted in an armed conflict, which ceased after UN intervention in the 2000s. At that moment, Morocco agreed to hold a referendum on Western Saharan independence, but this is yet to take place.

As a result, the legal status of the territory and the question of its sovereignty remain unresolved.

Registering a trademark in Western Sahara

In terms of trademarks in an international framework, the SADR is not a member of the Word Trade Organisation and, consequently, is not a signatory member of the Agreement on Trade-Related Aspects of Intellectual Property Rights. In fact, it is not a member of any IP-related international agreement. However, because it is a non-self-governing territory, it has an international code (ES), which is accepted for use in indicating states, other entities and intergovernmental organisations when applying for international applications at WIPO. Thus, even if it is unlikely that this code is used, in the eventuality that it is, what are its legal effects?

At a local level, the SADR has no IP legislation, IP office or publications of cautionary notices. There is therefore no trademark protection in the SADR. Nevertheless, since the territory is largely occupied by Morocco, which considers itself to have legitimate control of the region, any trademark rights protected in Morocco are arguably also protected in all regions over which the country claims jurisdiction.

However, since the Western Sahara is a non-self-governing territory, the legitimacy of these rights is a legal conundrum when it comes to international commercial agreements (eg, when licensing a Moroccan trademark to an international company).

Indeed, can this licence be considered effective in Western Sahara by courts other than Moroccan courts?

Naturally, the Polisario Front would defend that Western Sahara can be designated when applying for international rights at WIPO, while Morocco would contest this.

On the other hand, Morocco would affirm that a Moroccan IP right must be considered effective in Western Sahara by any national court in the world.

However, no legal response to this dilemma exists. As the jurisdiction of Morocco in the region is at stake as far as IP rights are concerned, we can expect that cases related to the 2000 and 2010 EU-Morocco Trade Agreements would help to highlight a response or at least some guidance. These agreements are related to agricultural and fish products.

In practice, Morocco began to export agricultural products grown in Sahrawi land and fish caught in Sahrawi waters to the European Union. However, these commercial acts were denounced by a non-governmental organisation – Western Sahara Campaign UK – which challenged the applicability of the 2000 agreement in Western Sahara before the UK courts, and by the Front Polisario, which defended the non-applicability of the 2010 agreement to Western Sahara before the European courts.

Both legal actions were based on the principles of international law, including the rights of the Sahrawi people to self-determination and permanent sovereignty over their natural resources.

The UK and European courts decided equally for the non-applicability of the referred trade agreements based on international customs and treaties – namely, on the principles of interpretation under Article 31 of the Vienna Convention on the Law of Treaties and the customary principle of self-determination. The courts considered that, in light of those principles, the “territory of the Kingdom of Morocco”

“ At a local level, the SADR has no IP legislation, IP office or publications of cautionary notices. ”

cannot be interpreted as including Western Sahara.

These decisions do not provide a response regarding the legality of Western Sahara, as this would be beyond the courts' power.

However, they do teach us that it would be foolhardy to consider that trademarks protected in Morocco would be automatically protected in Western Sahara without any other consideration of, for example, the impact of such rights on the local population.

Overall, Western Sahara is effectively a no man's land for trademark protection. It is hoped that this will change in the future. |

EUIPO Ideas Powered for Business SME Fund 2021

With a global value of 20 million euros, the ***Ideas Powered for Business SME Fund*** is a grant scheme created to help small and medium-sized companies in developing their IP strategies and protection of their rights at national, regional or EU level.

Supported by the European Union Intellectual Property Office (EUIPO) and the European Commission, this fund is to be applied in IP pre-diagnostic execution and/or trademark and design application by an SME established in one of the 27 EU Member States, during the year 2021. Both services imply partial restitution of the associated costs and each SME can be reimbursed up to a maximum value of EUR 1500.



EUIPO launch of AfrIPI aims to shake up trademark registration in Africa

Júlia Alves Coutinho

Europe / Africa

EUIPO



AfrIPI is the EUIPO's first IP-focused project that collaborates with African jurisdictions.

Expected to last four years, it was launched in February 2020 and the Project Steering Committee's inaugural meeting was on 7 September 2020. In addition to the European Commission and the EUIPO, the other project partners are the African Regional Intellectual Property Organisation (ARIPO), the African Intellectual Property Organisation (OAPI) and the African Union Commission.

At the inaugural meeting, AfrIPI's general plan and future activities for the coming years were discussed and approved, the main objective of the project being to increase the protection and promotion of IP rights in Africa, thus contributing to national economies, trade and business across the continent.

AfrIPI also aims to reinforce EU and African cooperation to further implement all IP-related aspects of the African Continental Free Trade Area (AfCFTA) – the world's largest free trade area since the formation of the World Trade Organisation. The AfCFTA covers 54 African countries, with the exception of Eritrea, which has not yet signed the agreement. However, due to covid-19, the implementation of the AfCFTA – previously scheduled for 1 July 2020 – has been postponed until 1 January 2021.

The EUIPO intends to extend the reach of existing tools and databases (eg, TMview and DesignView) to third countries and provide support to the European Observatory

on Infringements of Intellectual Property Rights outside the European Union. Thus, greater collaboration is expected with regard to:

- sharing tools and practices;
- increasing public awareness of IP rights and their violations; and
- improving the sharing of knowledge, skills and methodologies.

The European Union Intellectual Property Network has developed a number of tools to facilitate trademark and design registration workflows, which range from trademark/design and classification searches to entire front and back-office systems used by national and regional IP offices. TMclass allows users to search and translate products and services to and from any of the 44 languages available, while DesignClass allows users to search and translate product indications in 28 languages.

“ Once implemented, platforms such as TMclass and DesignClass will be able to assist European companies that wish to enter the market in one or more African jurisdictions. ”

Once implemented, platforms such as TMclass and DesignClass will be able to assist European companies that wish to enter the market in one or more African jurisdictions by submitting applications for



afrIPI

Intellectual Property Rights & Innovation

the registration of trademarks and designs. These tools will also support African companies that intend to enter the European market, as the list of products and services provided in their country of origin will be harmonised with the European list.

Following the introduction of the AfrIPI project, on 3 August 2020 the Uganda Registration Services Bureau (URSB) joined the TMclass and DesignClass systems. Uganda is the first African country to take this initiative, based on the partnership between the URSB and the EUIPO. This type of direct partnership between African IP offices and the EUIPO is hopefully the first of many that will occur in the coming years.

Finally, AfrIPI will also support:

- the registration of geographical indications in Africa and the European Union;
- the development of IP guidelines for OAPI and ARIPO member states; and
- training for IP examiners on international frameworks (eg, the Hague Agreement).

There will be a great deal of news on the development of AfrIPI across the continent over the next four years. In the meantime, the protection and recognition of IP rights in Africa will only continue to grow. |

Understanding the nuances of trademark use in various ARIPO jurisdictions

Inês Monteiro Alves

Africa

ARIPO



Trademark owners have a monopoly over the use of their registered mark insofar as they can prevent third parties from using equal or similar signs on the market for the same or related products and services. However, in order to benefit from trademark rights, the owner must meet certain requirements, one of which is to use the mark with regard to the products or services for which it was registered.

Requirement of use

The main purpose of the requirement of use is to prevent abusive registrations. The market can be extremely competitive and there are many situations wherein an entity files a trademark solely to prevent a competitor from obtaining the registration, even if it is not within the applicant's business plan to use the trademark for the products for which it was initially registered.

Further, the requirement of use avoids the so-called 'trademark graveyard'. It also permits other players in the market to freely claim exclusive rights so that a mark may be properly used.

What is considered non-use?

Trademark laws across the world are largely harmonised thanks to efforts by international and regional organisations, particularly, WIPO, the EUIPO, the African Regional Intellectual Property Organisation (ARIPO) and the African Intellectual Property Organisation.

In light of this, trademark rights:

- confer the registered owner the use of the trademark exactly as it was registered in association to the goods or services for which the trademark is registered;
- entitle the registered owner to obtain relief for infringement, provided that the registered mark has reputation in the relevant jurisdiction;
- prohibit others from using or obtaining the registration of an identical mark; and
- determine that there will be no registration for the same or confusingly similar mark, not only for the same goods or services.

However, there are rules surrounding trademark rights to which a rights holder must adhere, such as use of a mark. It will be considered non-use if:

- the mark is used for products or services that differ from the ones for which the trademark was registered;
- the mark is used with a sign that differs substantially from the one registered (the use of different colours could be considered non-use in some jurisdictions);
- the mark is used in other jurisdictions; or
- the mark is not used in the market.

The Banjul Protocol governs trademark registration in 10 ARIPO member states (at the time of writing): Botswana, eSwatini, Lesotho, Liberia, Malawi, Namibia, Sao Tome and Principe, Tanzania, Uganda and Zimbabwe. From 15 August 2020, Mozambique will be included in ARIPO applications.

Section 8 of the Banjul Protocol determines the effects of trademark registration and states that: “The registration of a mark by the Office shall have the same effect in each designated State, with respect to rights conferred by the mark, as if it was filed and registered under the national laws of each such State.”



The Banjul Protocol clearly stipulates that the rights conferred are determined by the national laws of each designated state and for this reason, ARIPO acts solely as a receiving office and all substantive matters with regard to trademarks (eg, the requirement of use) are each state’s responsibility. This means that cancellation based on non-use will follow individual state rules.

Consequences of non-use

Jurisdictions can adopt mechanisms to prevent the non-use of a mark.

For example, legislation under the Banjul Protocol provides the possibility of requesting the cancellation of a trademark based on non-use.

In Botswana, a mark can be subject to cancellation after three years of consecutive non-use, which an interested party may request to the trademark office. Within the same period and before the relevant office, the same legal framework applies in Eswatini, Lesotho, Liberia, Tanzania and Uganda. Meanwhile, Malawi, Namibia, Sao Tome and Principe and Zimbabwe require five years’ consecutive non-use in order to request a cancellation.

As for Mozambique, applicants must submit a declaration of intention of use (DIU) every five years, except on the year of renewal. Only in the situation where a DIU is not filed can a third party challenge the use of a trademark in this jurisdiction.

Despite being a source of revenue for the trademark office, the legal framework of the DIU is extremely challenging for third parties that intend to act against abusive registrations, particularly in situations where the trademark is not being used by the owner. Cape Verde is the only other country in Africa that applies the same legal framework. |

“ The market can be extremely competitive and there are many situations wherein an entity files a trademark solely to prevent a competitor from obtaining the registration. ”

How to best manage trademark applications in Africa

João Francisco Sá

Africa



Africa is the second largest continent in terms of size and population. Prior to the covid-19 outbreak, its young communities, developing economies and access to commodities meant that Africa was increasingly becoming a recipient of foreign direct investment.

Foreign companies wishing to protect their brands in any of the 54 countries on the continent should be aware of a few key IP management tips to ensure the protection of their trademarks without harming their legal protection.

First to file versus first to use

Legal systems in Africa draw their inspiration from a variety of legal traditions, including civil and common law. One of the main differences with regard to intellectual property is that countries with a civil law tradition provide legal protection to the entity that files a trademark application in the first place (first to file), regardless of actual use. On the other hand, common law countries provide a greater standard of protection to the entity that uses the trademark in the market in the first place (first to use).

Broadly speaking, English-speaking countries (eg, South Africa and Kenya) apply a first-to-use system, while others draw their legal traditions from continental European countries, using a first-to-file system (eg, Angola and Morocco).

Brand owners should always file their marks as early as possible in the countries where they wish to do business. If a mark is used in commerce but has not been registered, countries with a first-to-use

system provide increased protection for this, but mark owners may risk increased litigation costs.

Claiming priority

Most African countries apply provisions related to the Paris Convention, namely the possibility of claiming priority from an earlier application with six months from the first filing.

If brand owners file an African trademark close to the six-month priority deadline, they should make sure to claim convention priority. This helps to prevent bad-faith applications, which are common in Africa. In many cases, as trademark publications can take a while to be released, mark owners may not be aware of recently filed bad-faith applications.

If claiming priority is not possible and the trademark is made available elsewhere, a clearance search can help to determine whether a broader protection strategy is needed and if there are prior conflicting trademarks that could prevent registration. It is highly recommended that this is carried out in countries with larger backlogs (eg, Angola, Ghana and Nigeria).

Languages

When filing in several countries, providing a translation of the trademark (if it has any particular meaning) can help to prevent office actions.

In addition, preparing the list of goods/services according to the Nice Classification and providing a translated list in Arabic, English, French and Portuguese

can facilitate the application process and reduce the chances of receiving an office action.

Regional trademarks

Africa has two regional agreements that allow trademark applicants to file regional trademarks that cover several countries with a single application.

The African Intellectual Property Organisation (OAPI) has 17 member states and provides an automatic and unitary system, offering protection in the mostly French-speaking countries of West Africa, such as Burkina-Faso, Mali, Cameroon and the Côte d'Ivoire. OAPI members do not have national trademarks and it is therefore not possible to seek national protection.

The African Regional Intellectual Property Organisation (ARIPO) has 10 member states that have ratified the Banjul Protocol on Trademarks (11 members from 15 August, as Mozambique has ratified the protocol, which is effective from this date) and provides a single application proceeding, although this is neither automatic nor unitary. Members are mostly English-speaking countries in East Africa.

These agreements are cost-effective ways of filing multi-jurisdictional trademark applications. However, applicants should be aware that not all ARIPO members have fully implemented the regional system at a local level and enforceability can only be guaranteed in Botswana, Malawi, Namibia, Zimbabwe and Sao Tome and Principe.

International trademark - Madrid Protocol

The Madrid Protocol on the International Registration of Trademarks can provide a cost-effective way of protecting trademarks in Africa, with 21 member states, plus the OAPI. Applicants rely on a basic application from their local IP office to file

an international trademark and can directly designate several African countries with a centralised application procedure. This agreement includes Kenya, Mozambique, Zimbabwe, Cameroon and Morocco.

However, applicants may face several challenges using the Madrid Protocol, which may harm the ability to enforce trademarks in Africa. First, applications are examined according to local regulations, but several countries have significant backlogs and are not able to grant or refuse protection within the 18-month time limit. This results in problematic situations wherein applicants are not notified that their trademark has been refused, which can cause serious harm when enforcement becomes a prime concern.

Second, this risk and uncertainty is reinforced by not knowing if a trademark has been granted as a statement of grant of protection is not usually issued. Third, applicants should be aware that some countries have post-grant requirements, which have to be met to keep the trademark in force, such as filing proof of use or declarations of intent to use (eg, Mozambique).

Brand owners should therefore measure the importance of the trademark in the relevant market and the need to enforce it and consider filing a national trademark.

Comment

While protecting trademarks in Africa presents some unique challenges, any doubts that arise with regard to enforceability can be answered with a prudent filing strategy. Further, a mindful prosecution strategy can prevent unnecessary costs later on and provide a cost-effective means of securing legal protection across the continent. |

Protection and use of Certification Trademarks in Africa

Inês Tavares

Africa



Certification trademarks have a specific purpose aside from protecting the mark. Certification trademarks are trademarks that have the capability of distinguishing goods or services certified by the proprietor of the mark in what concerns the mode or the material of the manufacture of said goods or execution of said services, the quality, and reliability of those goods and/or services.

In most countries, certification trademarks are not a guarantee of geographical origin, unlike geographical indications and, sometimes, collective trademarks; nevertheless, there are jurisdictions in which Certification Trademarks are capable of designating geographical origin. In essence, a certification trademark gives a guarantee for specific characteristic of certain goods or/and services.

It is rather easy to confuse Certification Trademarks with Collective ones. The big difference between Certification and Collective Trademarks is that the latter are limited to use by a certain group of enterprises. The owner of a collective trademark is often an association, public institution, or a cooperative that allows its members to use the trademark to identify and distinguish origin, material, and mode of manufacturer or other common characteristics. The owner of the collective trademark is also responsible for ensuring that certain standards and regulations are met by their members and users of the trademark.

Given that Collective Trademarks promote the strict cooperation of a certain group of people, they have become very relevant to local development of businesses. In Ghana for instance, Collective Trademarks

are especially essential for they can be used to protect cultural expressions. In Kenya, Collective and Certification Trademarks are used to protect and indicate geographical indications. In 2006, a trademark application for "ECHUCHUKA" was filed in the Kenyan Industrial Property Institute as a collective trademark for an aloe-vera based product that grows and is manufactured in and by the community of Lake Turkana.

On the consumer's point a view, the existence of a certification trademark or a collective trademark on a specific product or service assures that said product or service complies with a previously existing and accepted standard or regulation, ensuring, to the consumer, a guarantee of quality or other relevant characteristic of the product or service.

The main benefit of certification and collective trademarks is to encourage objectivity in the use of a trademark and to ensure to consumers, as previously mentioned, certain requirements: quality of the materials, methods and manner of production, or performance of services, quality of accuracy, were properly met. Of course, there are downsides as well. An applicant that intends to use a Certification Trademark must comply with these standard and fixed specifications rigorously.

An applicant who wishes to protect a Certification, or a Collective Trademark must have a method for determining if whether the requirements are being met by trademark users and that method has to satisfy competent authorities in order for the applicant to become an approved certifier.

Furthermore, overall the administrative and regulatory burden on certification marks is significant as compared to standard trademarks.

There are several famous Certification Trademarks originating from different countries, such as *WOOLMARK*, which assures products are made from 100% wool; *LABEL ROUGE*, a French certification mark to ensure the quality of food and non-food items as well as unprocessed agricultural products, which certifies that those products are on a superior level when compared to similar ones on the market that do not have the Label Rouge (Red Label); *ENERGY STAR*, that sets the benchmark for energy efficient products; *NTA*, which stands for National Testing Agency, an Indian Certification Trademark which enables entities to carry out qualified college submission examinations; *Fairtrade*, that certifies a product or service as being obtained or provided through better prices, fair working conditions and in a sustainable matter on an ecological and ethical point of view; *UTZ*, a certification to ensure sustainability on the production of coffee, tea and cocoa and *Rainforest Alliance*, which ensures that users of the alliance respect a list of sustainable agricultural principals that includes conservation of wildlife, water resources and minimizing soil erosion, among other regulations. Recently, the *UTZ* and *Rainforest Alliance* have emerged and will be one certification seal only.

In principle, Certification Trademarks can be used by any person or entity as long as they comply with the standards and regulations that were previously defined by the owner of the certification trademark.

It is possible to obtain a certification trademark in the African continent; however, not every country in Africa has the legal provisions for certification and collective trademarks in their Intellectual Property laws. The Certification trademark registration is possible in jurisdictions

such as Djibouti, Kenya, Libya, Morocco, Mozambique, Namibia, Nigeria, Rwanda, Seychelles, South Africa, Uganda, Zambia, and Zimbabwe. Not long ago, in August 2019, Mauritius published a new Industrial Property Bill and the same is expected to enter into force in the upcoming months as soon as the effective date is proclaimed. This new Bill recognizes certification trademarks.

Collective trademarks, on another hand, are a possibility in a wider range of jurisdictions across Africa, namely OAPI, ARIPO, Algeria, Botswana, Burundi, Cape Verde, D.R. Congo, Djibouti, Egypt, Ethiopia, Gambia, Ghana, Kenya, Lesotho, Liberia, Libya, Madagascar, Malawi, Mauritius, Morocco, Mozambique, Rwanda, S. Tome and Principe, Seychelles, Sierra Leone, South Africa, Tanzania, Tunisia, and Zimbabwe.

Regulations on Certification Trademarks are somewhat harmonized worldwide and across the African countries.

The application for the registration of a Certification trademark must designate the mark as such and shall always be accompanied by the terms and conditions governing its use.

In jurisdictions such as Uganda, Zimbabwe and Kenya, the Registrar will examine the regulations as to substance and can decide to refuse to accept the same, or to accept these, subject to conditions, limitations, amendments, or modifications. In general, when examining the Certification Trademark same standards as for standard trademarks will apply, namely disclaimers, descriptiveness, likelihood of confusion, generic nature, amongst others.

(...)



Confusion remains over the not-so-young Trademarks Act of Sierra Leone

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Africa

Sierra Leone



Until mid-2020 there were no regulations drafted on the implementation of the Sierra Leone Trademarks Act 2014, nor was the date of its entry into force defined in the act that was published in the *Sierra Leone Gazette* (vol CXLV 53 (9 October 2014)). Although the Office of the Administrator and Registrar General (ie, the Sierra Leone Registry) informally announced in September 2018 that the new act is in effect and being enforced by the registry, no official notification has been issued thus far. Article 60(1) of the act repeals the earlier Trademarks Act (17 Cap 244 1960). Further, Article 60(2) determines that any regulation made under the repealed act and in force immediately before the commencement of the 2014 act will continue to be in force until amended or revoked.

Therefore, it is uncertain as to whether formal legal processes have been followed to replace the 1960 act, amended by Act 29/1972, which was based on the UK Trademarks Act 1960. The previous act was drafted when the country was still a British colony (it became independent in 1961). Thus, the UK classification system (ie, pre-1938 system with 50 classes of goods and no recognition of services) applied. In addition, the former act did not protect collective or well-known marks or refer to the claim of priority rights under the Paris Convention.

The main changes in terms of the 2014 Trademarks Act include:

- adoption of the Nice Classification of Goods and Services and the registration of service marks;

- acknowledgment of INTA agreements signed by Sierra Leone, which means recognition of international registrations since this jurisdiction is a member of the Madrid Union (the system came into force in Sierra Leone in 1999);

- the possibility to claim priority rights under the Paris Convention;

- protection of collective marks;

- recognition of well-known marks;

- renewal terms every 10 years from the application date;

- publication of the recordal of an assignment;

- full examination, publication and opposition procedures;

- cancellation of a trademark following five years of non-use;

- provisions with regard to:
 - licensing;
 - additional grounds for opposition;
 - infringements (which will be extended to similar goods; damages may be awarded for infringement and intentional infringement will be a criminal offence);
 - unfair competition;
 - trade names; and
 - false trade descriptions;

- establishment of an IP Agency, which includes a trademarks registry; and

- Establishment of an IP tribunal, under an IP Agency Act, with powers to hear appeals and rule on invalidations, infringements and criminal offences.

The changes update the legislation in line with common aspects of other countries' trademark systems. Given the insecurity surrounding the application of this new legislation, regulation of – or at least the issuance of an official statement by the registry on – this act is urgent. This is mainly for essential issues such as the protection of service marks, collective and well-known marks, and trademark renewals. |

Ethiopia's online trademark system brought to a halt by internet shutdown

João Pereira Cabral

Africa

Ethiopia



Following national protests relating to the fatal shooting of singer Hachalu Hundessa on 29 June, Internet access was cut across Ethiopia the next day. Hachalu was an activist and important figure in the Oromo community. Up until the cut, content showing protesters in the capital and across the Oromia region could be seen on social media.

The Ethiopian government is led by Prime Minister Abiy Ahmed – a computer engineer who was awarded the 2019 Nobel Peace Prize for actions such as providing amnesty for political prisoners and legalising banned opposition groups. However, he has been accused of cutting internet and telecommunications services during elections and uprisings. This is causing setbacks to the country's trademark registration system, which has been taking great strides towards modernisation.

Online trademark filing system

The Ethiopian Intellectual Property Office (EIPO) launched an online trademark filing system on 21 December 2018 in collaboration with WIPO, joining the limited group of African countries and regions with an online filing system (others include Morocco, Nigeria, South Africa, Tanzania and Zanzibar).

This system, which allows the online filing of applications and some documents, was implemented to modernise the method of obtaining trademark registration in Ethiopia and increase the EIPO's efficiency.

Reducing reliance on hard documents is beneficial for both applicants and the

EIPO, as hard copy documents can be withheld and digital methods are faster. However, not every aspect of the process has moved online, as official fees and some original documents must still be filed by an agent before the EIPO following the examiner's approval of the online application.

Online power of attorney service

The next step that shook up the trademark protection procedure in Ethiopia was to digitalise the legalisation process of filing Ethiopian power of attorney (E-POA) documents.

Users can file an E-POA application, make the corresponding payment and send the E-POA to the Ethiopian Embassy. The legalisation process is then completed in less than 48 hours.

This service may be accessed at www.ee-poa.org or through a software application downloadable for Apple and Android devices and aims to save time and costs and reduce fraud.

At present the E-POA service is available for power of attorney issued in the United States only, but the system will soon expand to countries in the Middle East, Asia, Europe and Africa.

Still no Internet

However, in the past two weeks – and for periods throughout 2019 – moves towards modernisation have been halted by internet shutdowns, rendering the benefits of digitalisation meaningless. Unfortunately, this highlights the fact that the lack of Internet for trademark registration is a small part of a much bigger problem. |

Registering defensive trademarks in Mozambique

Miguel Bibe

Africa

Mozambique



The Industrial Property Law of Mozambique (31 December 2015) established the requirement to **submit a declaration of intention to use (DIU) for trademarks**. Unlike other Lusophone jurisdictions (eg, Portugal or Angola), where use of a mark is mandatory for the goods and/or services identified, the DIU system maintains the exclusive rights to a mark regardless of whether it is being used in the territory. This means that once the mark is granted, the owner may unilaterally exclude any other entity from using a similar one, even if they do not use the mark themselves.

Generally, the requirement to use a mark in order to maintain its registration allows any interested party to act against an exclusive right if it is not being used. This can prevent entities from benefiting from an exclusive right in perpetuity without actually using the trademark.

However, the DIU system allows mark owners to keep a registration active regardless of whether the mark is being used and without third parties being able to act against the registration.

Further, the DIU system maintains a tacit acceptance as to the registration of trademarks with a purely defensive purpose in Mozambique. Through this type of designation, a mark owner (notorious or not) can file a trademark for goods and services that it does not intend to use, but which is at risk of being used by third parties. Through simple administrative acts, (eg, filing of a requirement or payment of fees), it is possible to maintain rights in force instead of having to prove concrete, repeated and public use.

Therefore, under this defensive method of protection, a mark owner may never use its designation without being exposed to possible cancellations due to lack of use, as it is a trademark that is registered not to be used, but to increase the scope of protection and with the purpose of preventing possible infringement actions.

DIUs must be filed every five years in Mozambique counting from the filing date for national trademark applications or from the designation or renewal date for international registrations, except for the renewal period (every 10 years) and may be presented within one year (for six months before and after the deadline). What is more, while it is a formal requirement to present a DIU, failure to do so has no automatic consequence on the trademark registration.

However, a mark without a valid DIU may be subject to cancellation if a request is filed with the Mozambique Patent and Trademark Office by an interested party. According to Article 138 of the Industrial Property Law, it is not necessary to present proof of use of a mark when the DIU is submitted within the formal deadline. Article 138(4) states that a DIU filed after the deadline must be accompanied by proof of use of the trademark in Mozambique. However, in practice the office does not request this.

Comment

Contrary to other jurisdictions' systems, where mark owners are obligated to use their marks, thereby enabling active and fair competition in the market by all players, Mozambique has a system in which the maintenance of the trademark registration through the simple presentation of DIUs allows an owner to register a trademark with the purpose of preventing third parties from filing and using similar trademarks for different goods or services. |

The absence of service marks protection: a roadbump in the history of Zambian IP law

Vera Albino

Africa

Zambia



Although the use of trademarks, as a means to distinguish the goods of merchants and manufacturers, dates back to antiquity, the emergence of service marks is significantly more recent.

For instance, while the expression 'trademark', understood as a 'goods mark' is present in the original text of the Paris Convention 1883, the first occurrence of the expression 'service mark' in the Paris Convention dates to 1958 (the Lisbon Act). And even if the contemporary use of the word 'mark' is understood to include both goods and service marks, often the use of 'mark' in the Paris Convention concerns only goods marks.

Thus, the absence of provisions related to service marks in the Trademarks Act (Chapter 401 of the Laws of Zambia), which was drafted in 1958, when the country was not independent yet, is not surprising. However, the fact that these marks were not included in the 1980 and 1994 amendments is disturbing, essentially because the consecration of service marks was a globally necessary step to respond to modern trade challenges that originated in the French and Industrial Revolutions.

Service marks provide protection to the entities that use them as distinctive service signs in the market. These marks distinguish the services of one entity from those of its competitors and protect the goodwill and reputation earned by the business. They also encourage competition by requiring entities to associate their marks with the quality of services that they offer.

Further, service marks give valuable references to the consumer, who faces an exponential increase in the services offered and is confronted with a complex and uncertain reality, hindering their decision-making process. Indeed, contrary to what happens when purchasing goods, the intangibility of competing services results in the disability of the consumer to distinguish and compare the characteristics of the services offered and to judge their quality, often even after the purchase.

Given these circumstances, service mark owners seeking **to protect their marks in Zambia must register them in the goods classes that are most closely associated to the relevant services.** However, this means of remedying the absence of service mark protection under Zambian legislation is far from satisfactory. Not only does it put into question important issues such as the genuine and effective use of the mark, it also fails to safely and efficiently protect legitimate owners against imitators and consumers against improvident expenditures for services of dubious or unknown origin.

Zambia is aware that this situation generates a deep feeling of insecurity among national and international investors and consumers, and results in a significant loss of income to the country. As such, efforts have been undertaken to modernise Zambian IP legislation. Bills have been drafted to strengthen the current framework, which includes the protection of service marks along with other major amendments. But these bills are yet to be approved by Parliament.



There is no information as to when the new legislation will come into effect. In the meantime, service mark owners and consumers must rely on protection under other national laws (eg, the Competition, Fair Trading and Consumer Protection Act), which, for instance, prohibit anti-competitive trade practices, regulate monopolies and concentrations of economic power, protect consumer welfare, strengthen the efficiency of production and distribution of goods and services, secure the best possible conditions for freedom of trade and expand the base of entrepreneurship.

They can also rely on penal and civil legislation, which can be quite effective where criminal and civil liabilities are in question.

Because the law tends to respond to the needs of society and not the other way around, the more service mark owners seek effective protection of their rights in Zambia, the more the government is likely to approve the long-awaited new IP legislation. |



Pending trademark regulations in Nigeria

Inês Monteiro Alves

Africa

Nigeria



Nigeria is the seventh most populated country in the world and Africa's largest economy, with a gross domestic product estimated at \$508 billion. The country produces oil and gas and is continuing to grow in other sectors (eg, agriculture, telecommunications and services). However, Nigeria still follows the 1965 Trademarks Act and the 1967 Trademarks Regulations, which are outdated and lack the rules to meet the existing needs of local and foreign trademark owners in the jurisdiction. Fortunately, this looks set to change. In 2018 there was a public reading before the National Assembly of the Federal Republic of Nigeria of a bill to repeal the current Trademarks Act and provide a comprehensive law on trademarks. The bill now appears to be on its way to coming into force – this article focuses on the most important changes it would introduce.

Elimination of the division between Parts A and B

Under the current act, the register is divided into Parts A and B, in which the former is for trademarks that are inherently distinctive and the latter is for ones that acquire distinctiveness through use. This division is impractical as no split takes place in practice at the register. The new act would eliminate this separation.

Wider definition of trademarks

Under the current act, a 'trademark' is defined as a sign that may include colour and aspects of packaging. This is extremely narrow and does not allow for colour and packaging protection. The new act would therefore expand this definition.

Domestication of international treaties

The updated Trademarks Act formally

defines Nigeria as a signatory member of the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights and the Nice Classification. In addition, it would empower the minister of trade and investments, under Section 57, to make regulations to enter into other agreements and international treaties, which includes the Madrid system. Being a signatory member of the Paris Convention means that priority applications would be formally accepted and that well-known marks would be recognised.

Term trademark validity

Currently in Nigeria, trademarks are valid for seven years and may be renewed for 14-year periods thereafter. The new Trademarks Act determines that trademarks would be valid for 10 years and could then be consecutively renewed for periods of 10 years. There would be a grace period of six months – a change from the current three months – to renew a trademark following its expiration.

Trademark infringement

The bill expands the range of acts that constitute trademark infringement under Section 28.

Other improvements and amendments

Under the new regime, trademark applications would now have to be accompanied by a statement of requirement of use. In addition, the bill sets out provisions with regard to border enforcement measures and use of a mark online. Moreover, there are provisions to protect collective marks and amendments with regard to certification marks. Finally, associated and defensive marks would be eliminated.

Overall, the provisions would regulate the expansion of the rights of local and foreign investors and create more effective mechanisms for the protection of marks, which would nearly certainly lead to an increase of foreign investments in Nigeria. |

Why the green economy is important to Ghana – and how certification marks contribute to it

Vera Albino

Africa

Ghana



The United Nations Environment Programme (UNEP) defines the ‘green economy’ as “the low carbon, resource efficient and socially inclusive economy”. The Organisation for Economic Co-operation and Development states that: “Green growth means fostering economic growth and development while ensuring that natural assets continue to provide the resources and environmental services on which our well-being relies.” The Green Economy Coalition, in turn, considers that the green economy is “an economy that provides better quality of life for all within the ecological limits of the planet”. Albeit variable, these definitions share the same vision regarding the key issue: the green economy conciliates environmental sustainability, economic objectives and social wellbeing.

In view of the global climate emergency, the green economy appears to be the best alternative to the current dominant economic model and is indispensable to achieving sustainable development, especially in developing economies such as Ghana.

Ghana’s fundamental environmental legislation includes the National Climate Change Policy, the National Environmental Policy, the Environmental Fiscal Reform Policy and the National Climate Change Adaptation Strategy, among many others. Nevertheless, the country experiences various environmental problems that prevent the achievement of economic development goals, and there is evidence that it is being affected by natural disasters due to global climate change. For instance, despite having abundant natural resources permitting the attainment of sustainable development, Ghana has suffered from dramatic forest degradation and deforestation, and has one of the highest costs of environmental degradation in the world. In order to combat these terrible consequences and to encourage the green economy transition, the country is being supported by various international programmes and projects, including the UNEP green economy programme, Switch Africa Green, the Green Climate Fund and the Sustaining Competitive and Responsible Enterprises programme.

However, to be effective and durable, such efforts must be made by all economic operators, both public and private, national and international. As such, trademark rights are essential legal and communication tools for the country, both to attract foreign investors and to sell their products on international markets.

Under Ghanaian trademark law, there are three methods that economic operators can employ to distinguish their goods or services as being eco-conscious.

- The first is to register traditional marks. This method is widely used; however, there is a risk that the terms 'eco', 'green' and 'sustainable' will be considered as descriptive by the registrar, which will challenge the registration.

- The second is to register collective marks used to promote sustainable development goals. Nevertheless, the number of these marks in Ghana remains insufficient to have a considerable impact on the economy of the country.

- The third way to promote and support the mark system's transaction into the green economy is through certification marks. Certification marks are registered through the Ghanaian Patent and Trademark Office. The rules for governing the use of such marks are established by the owners, approved by the minister and open to public inspection. These exigencies may seem excessive; however, it aims to prevent the registration and use of unregulated green marks that falsely claim to be eco-friendly.

The economic success of products displaying certification marks relies on consumer awareness and on their willingness to pay more if they know that a product is more environmentally friendly. Even if we can anticipate mitigating effects on local consumer behaviour, certification marks offer great opportunities for stakeholders in Ghana

that produce a large number of products – in particular, natural or agricultural products – to be sold in international markets. The Fairtrade certification provides one such example. Through the Fairtrade mark certification, Ghana, which is the world's second largest producer of cocoa, has been able to respond to the demands of the global chocolate industry's biggest players, including Ferrero and Hershey, which have expressed their commitment to achieve a sustainable cocoa sector by the year 2020.

The global wood industry is also economically important to Ghana. Thus, the Forest Stewardship Council™-accredited Forest Management certification plays an important role in attracting international investors and buyers to the country. The Roundtable on Sustainable Palm Oil certification is another certification mark that enables Ghanaian products to be competitively sold in the international market.

The green economy transition is a real challenge for developing countries that are facing significant economic pressures to develop their country and a real temptation to follow the dominant economic model. However, economic growth is also possible through the green economy model and certification marks are a valuable tool to develop countries under this alternative model. |

Mozambique joins the Banjul Protocol on trademarks

Inês Tavares

Africa

Mozambique



The African Regional Intellectual Property Organisation (ARIPO) was established in 1976 under the Lusaka Agreement. It is an intergovernmental association, which brings together jurisdictions to cooperate in IP matters and bolsters IP protection for its members by facilitating proceedings, simplifying formality requirements, and providing an online register and an online gazette. The member states are Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Somalia, Sudan, Tanzania, Uganda, Zambia and Zimbabwe. Further, the Lusaka Agreement states that membership is open to countries in the African Union and members of the United National Economic Commission for Africa.

ARIPO proceedings are ruled by four major protocols:

- the Harare Protocol on Patents and Industrial Designs;
- the Banjul Protocol on trademarks;
- the Swakopmund Protocol on the Protection of Traditional Knowledge; and
- the Arusha Protocol for the protection of New Variety Plants.

Not all ARIPO member states have joined these protocols – each country can decide to ratify all or a particular protocol and incorporate it into its legislation. For entry into force of a protocol, a country must sign and then deposit its instrument of ratification or instrument of accession with the director-general of ARIPO with an indication of its acceptance to be bound to its described rules and regulations.

The following countries have enacted the Banjul Protocol for Trademarks (1993): Botswana, Eswatini, Lesotho, Liberia, Malawi, Namibia, Tanzania, Uganda, Zimbabwe, and Sao Tome and Principe.

Mozambique, a Portuguese-speaking country and the first member state to have never had a constitutional connection with the United Kingdom or a Commonwealth member state, joined ARIPO in February 2000. Until very recently, it was a member of the Harare Protocol only.

In 2016 revisions to Mozambique's Industrial Property Code (Decree No 47/2015 (31 December 2015)) came into force. In particular, Chapter IV(II) entitled "Regional Registration" included provisions to allow the immediate implementation of the Banjul Protocol when the country joined ARIPO. The government finally deposited its instrument of accession to this protocol at ARIPO on 15 May 2020.

In compliance with Section 11 (11:4) of this protocol, it takes three months from the state depositing either the instrument of accession or signature followed by ratification for the protocol to enter into force. Thus, Mozambique will be eligible for designation at ARIPO from 15 August 2020.

(...)



A new era for trademarks in Angola?

Vítor Palmela Fidalgo

Africa

Angola

The
Trademark
Lawyer

Vítor Palmela Fidalgo gives us an overview of “genuine use” in Angola’s latest industrial property Bill.

We have come a long way since the first draft on the new Angolan Industrial Property Act was presented. One cannot deny the anxiety that it has been causing to stakeholders. Considering the seniority and outdatedness of the current law – not even complying with the Trips Agreement – concerns are plenty understandable. However, it seems the time has come. The Bill has just been sent to Council of Ministers for analysis. Considering the deep discussion between all the stakeholders (officials, academia, trademark and patent attorneys and right holders), I do not foresee major changes to the latest version of the Bill.

With this article, I intend to provide an overview of one of the key changes relating to trademarks: the “genuine use” (“uso sério”), whose concept is also absent in the current legislation. The current law prefers not to qualify the use, employing the solely the term “use”, which may lead to the understanding that the requirement is fulfilled only when there is total lack of trademark use. As it is commonly known, almost all legislations worldwide on trademarks stipulate an obligation for the owner of a registered trademark to use that mark in a genuine manner. This requirement is preceded by a “grace period”, where the obligation of use is not applicable immediately after registration of the earlier mark. In contrast with other legislations, the current Angolan Industrial Property Law provides for a short “grace period”. According to Article 39(c), the trademark owner has only two years to initiate the use of the

trademark. This aspect, apart from being a burden for stakeholders, contravenes the Trips Agreement. Under this International Agreement (Article 19(1)) the registered trademark may be canceled for non-use only after an uninterrupted period of at least three years. However, the present proposal switched to a mainstream approach. According to Article 208(1), of the Bill, the “grace period” is established in five years, during which it is not needed to demonstrate use of the trademark. In addition, the lack of genuine use is no longer only a ground for trademark revocation.

Pursuant to the last draft of the Bill, the lack of genuine use may be used as a defense in two different situations: (i) counterclaim in the Opposition; and (ii) Counterclaim in Invalidation Case.

The first situation is provided in Article 183(1) of the draft. Under the terms of this provision, the applicant, facing an opposition from a third party proprietor of an earlier trademark, may request from the opponent to furnish proof that the object trademark has been put to genuine use in connection with the goods or service classes in respect of which it is registered, for a period of five years. According to Article 182(2) the proprietor of the earlier trademark should reply against this request in 30 days, which can extendable for an equal period. It is important to mention that this provision does not imply any assessment of the possible revocation of the registered trademark on which the complaint is based. If the opponent cannot prove that it has used its trademark (or there are valid reasons for the non-use), according to Article 183(4), the only legal effect is the rejection of the opposition. No revocation decision can be issued by the Angolan PTO. Furthermore, under Article 202(4), of the Draft, a trademark cannot be canceled if, on the date on which the respective filed trademark

was made or on the date of the respective claimed priority, the earlier mark claimed does not satisfy the condition of genuine use. Once again, as the solution provided in Article 183(4), under Article 205(5), this measure does not imply any assessment of the possible revocation of the registered trademark on which the complaint is based. Both trademarks will remain co-existing in the market. The only legal issue is that, procedurally, the cancellation action will be dismissed. I would add that - despite not existing any specific Article attesting to this solution - I believe it should be accepted that, during a cancellation action, when it is filed a revocation action before the Angolan PTO, the court may stay the proceedings until the final decision of the institute.

Despite these changes, which are most welcome, there is no legal provision for claiming the genuine use as counterclaim in infringements actions. For these cases, the defendant shall file a revocation action before the institute. It is my understanding, once again, that this will be reason to stay the proceedings before the court until the administrative decision is issued. As for the genuine use itself, there are more novelties in the Bill. According to Article 207(1)(a) use of a trademark in a form which differs in terms of elements that do not significantly change the distinctive character of the trademark in the form in which it is registered. In this sense, there is a room for the trademark owner to make variations in the its sign that, without altering its distinctive character, enable it to be better adjusted to the marketing exigencies of the goods or services concerned.

In accordance with the Bill, the trademark shall be also considered to have been used by its owner where it is used by a third party with the owner's consent. However, the Bill is not completely clear in this matter. According to Article 207(1)(a), the trademark shall be considered to have been used by a licensee, with a duly registered license. In the same arti-

cle and paragraph, but now subparagraph c) the draft returns to the matter, but yet stating that the it is considered "genuine use" the use of the trademark by a third party, provided it is with the consent of the proprietor and for the purpose of maintaining the registration. So, in this second provision, no mention is done to the licensee or the recordal of the same. This raises a doubt whether the recordal shall be a requirement for third-party use of the trademark be legally considered. One of the ways to interpret this rule is to understand that this requirement is only applicable to licensees, waiving the same for other third parties, such as companies as being part of the same business group of the owner of the trademark.

Finally, it should be mentioned that under Article 207(1)(c), the trademark shall be considered used in Angola, even it is only for export purposes. Looking at the changes in this matter, one may answer that **this could be a new era for trademarks in Angola**. The genuine use and its proper application are essential for restrict the number of trademarks registered and avoid, consequently, the number of conflicts between them. In this last vein, genuine use is also important for prevent trademarks being used as an anti-competitive tool. With these new rules Angola will stand alongside with the most advanced legislations in this matter. In its specific case, the genuine use legal regime is important for two reasons. Firstly, the number of defensive trademarks is still remarkably high. Regardless of the reasons behind these applications, a high number of defensive trademarks are ineffective on the market, blocking the entrance of new players. Secondly, the volatility of the Angolan market, where constantly new players come in and others come out of the market, leads to a high number of trademarks not being used, but still formally registered at the institute. So, a new era will definitely come for trademarks in Angola and we look forward to seeing how is going to be applied. |

WIPO data reveals rise in international trademark applications originating from Africa

João Francisco Sá

Europe / Africa

WIPO



WIPO recently released its annual 2019 statistics, which revealed a record year in terms of international IP rights. This article focuses on international trademark applications coming from Africa.

The Madrid Protocol on the International Registration of Marks (1989) currently has 106 members, covering 122 countries. In Africa, the Madrid Protocol has 22 members over 38 countries, due to the participation of the African Intellectual Property Organisation. While there is a growing majority of African countries that belong to the Madrid System, Nigeria, South Africa and Angola are notable exceptions as the first,

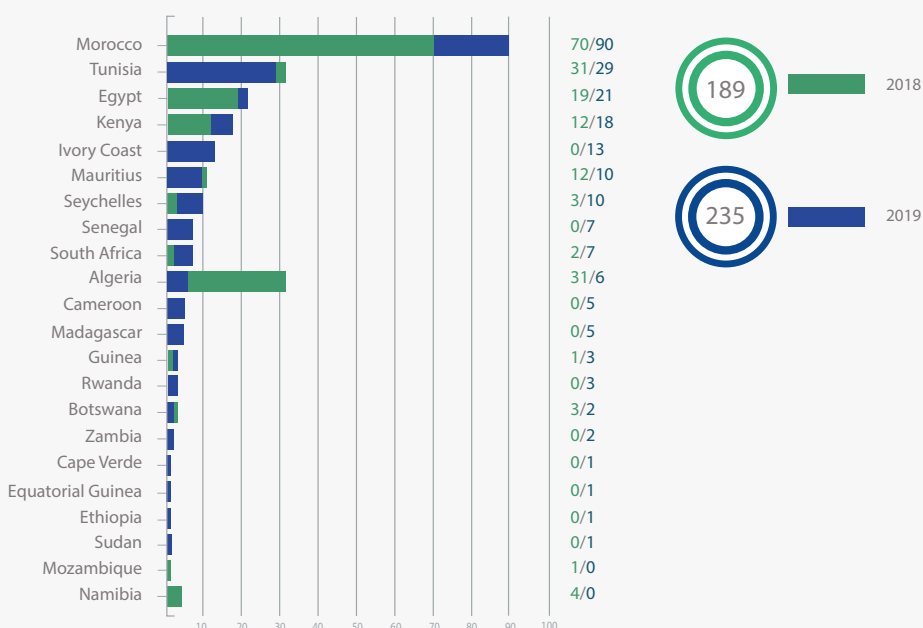
second and seventh largest economies in terms of nominal gross domestic product.

The number of international registrations designating African countries (Table 1) shows that Mauritius, Seychelles, South Africa and Cape Verde are ranked as countries of origin on international trademarks even though they are not members of the Madrid Protocol. This is the result of a provision in the Madrid Protocol that provides entitlement to file an international application to applicants that – even if not domiciled in the territory of a member state – have real and effective industrial or commercial establishment in the

territory of a member state. Globally, 2019 saw an increase of about 6% of the total number of international trademarks filed via the Madrid Protocol to 64,400. In Africa, there was an increase of 24%, from 189 to 235 applications. The top African countries of origin for international trademark applications were Morocco (90 applications), Tunisia (29) and Egypt (21), showing dominance in Northern Africa.

This increase in the number of international trademark applications originating from Africa appears to suggest that more companies are protecting their businesses abroad. However, the number of applications is still far too low, even with positive discrimination provisions applied by WIPO, which provide a 90% discount on the basic fee for international applications for least developed countries.

While the growth is positive, putting the matter into perspective, Cyprus – a country with a population of 1 million – had roughly the same number of international trademark applications (231) as the combined countries of the African continent (235), which has a population closer to that of China. |



Source: Extract of African countries - International trademarks applications by origin (Madrid System), WIPO (April 2020)

Amendments to the trademark registration procedure in Angola

Miguel Bibe

Africa

Angola



There have been many changes in 2020 to procedures for registering industrial property rights in Angola, particularly with regard to trademark registration. The most significant revision is the **change to the payment period for granting fees**, which alters the entire procedure for registering trademarks in the country, along with the possibility of requesting a 60-day extension.

Previously, granting fees were payable after the opposition period only. The Angolan Institute of Industrial Property (IAPI) proceeded with the substantive examination after these fees had been paid, meaning that there were two periods of payment.

The payment of granting fees after the opposition period caused considerable constraint on the registration system as there was no formal deadline to proceed with this payment. In many cases, applicants took years to pay fees, did not pay them until the marks were granted or refused to pay them altogether.

In addition, IAPI was prevented from spending resources on examining compliance with this formality and did not issue formal notifications to trademark applicants requesting payment.

Before the amendment, the trademark registration procedure consisted of the following steps:

- filing the application at IAPI;
- issuance of the official filing receipt with the official trademark number;
- publication of the application in the

Industrial Property Bulletin;

- opposition period;
- payment of granting fees;
- substantive examination; and
- publication of grant and issuance of the registration certificate.

Now, granting fees must be paid at the same time as the filing fees. This occurs when the trademark application is filed.

With the amendment, the procedure for trademark registration is as follows:

- filing the trademark application at IAPI;
- issuance of the official filing receipt with the official trademark number;
- publication of the application in the Industrial Property Bulletin;
- opposition period;
- substantive examination; and
- publication of grant and issuance of the registration certificate.

Although this measure entered into force a few weeks before activity at IAPI was suspended due to the covid-19 pandemic, it will undoubtedly be a positive measure for trademark registrations in Angola.

The trademark registration process can still be time consuming and rather bureaucratic. While the mark may still take a few years to be granted, this measure will ease the bureaucracy in trademark registration procedures, since it eliminates a previously essential step and leads to trademark owners having their rights protected in a more prompt and effective way. |

The growth of trademarks in Angola

Cátia Góis

Africa

Angola



Angola is one of many countries that recognises IP rights as an important contribution to a country's social and economic development. It is a member of WIPO and adopted the Paris Convention for the Protection of Industrial Property. Further, Law 3/92 (published in the Official Gazette (9) on 28 February 1992) was the first piece of specific IP legislation in the country.

The following registration process for a trademark in Angola is simple and similar to procedures in many other jurisdictions:

- a request is filed before the Angolan Institute of Industrial Property;
- the application is published in the Industrial Property Bulletin;
- third parties have 60 days to file an opposition;
- the granting is published; and
- the registration certificate is issued.

What the data reveals

The authors examined data from WIPO to see the impact and the development of intellectual property in Angola. Figures show that – with the exception of the period from 2015 to 2017 – the number of trademark registrations has grown continuously since 1991.

In 2016 and 2017, there were 18,543 and 21,435 trademarks in force in Angola, respectively. In 2018 this rose to 23,369. Data demonstrates that in 2018, more than 4,100 trademarks applications were filed, with more than 2,300 coming from national applicants. This is a 19% increase from 2017 figures, in which around 3,300 trademarks applications were filed.

Next, the countries that are filing the most marks in Angola are as follows:

- United States (13.6%);
- China (9.7%);
- Portugal (7.5%);
- France (7.5%); and
- South Korea (7%).

On the other hand, the countries in which Angolan applicants are registering trademarks are as follows:

- China (19%);
- Brazil (11.7%);
- Pakistan (10.4%); and
- South Africa (9.8%).

The most popular classes of product of the trademarks filed in Angola are as follows:

- Class 5 (9%), which is related to pharmaceutical products and other medical and veterinary preparations;
- Class 35 (8.4%), which includes advertising, business management and administration and office functions;
- Class 30 (6.6%), which considers food products of vegetable origin prepared for consumption or conservation; and
- Class 41 (5.9%), which concerns education, entertainment and sporting and cultural activities.

(...)



Europe / Africa

Inventa International collaborates with 9th edition “Trade Marks 2020” of ICLG

Inventa International contributed with Portugal and Angola chapters in the ninth edition “Trade Marks 2020” of International Comparative Legal Guide (ICLG), published by Global Legal Group.

These guidelines summarize legislation and regulations regarding trademarks in both countries focusing on the main steps, timings, requirements and other related rights.



Portugal

Vítor Palmela Fidalgo and João Pereira Cabral authored the **Portugal chapter** about trademark laws and regulations.



Angola

Vera Albino and Miguel Bibe authored the **Angola chapter** about trademark laws and regulations.



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info here

Somalia Trademarks Office resumes operations after almost 30 years

João Pereira Cabral

Africa

Somalia



The Somalia Trademarks Office resumed its operations at the end of 2019, when Ministerial Decree 1/2019 was issued by the Ministry of Commerce and Industry, stipulating that trademark registrations are once again possible in this former Italian colony and British Protectorate.

Background

Following the overthrow of President Siad Barre in 1991, Somalia entered into civil war and the northwestern region declared its independence, becoming the Republic of Somaliland. In the following years several attempts to restore a central government in Somalia failed, with powers shifting from local administrations to warlords and business and religious leaders. In 2006 the Transitional Federal Government gained control of zones that had been in the hands of the Islamic Courts Union. Only in 2012 was there sufficient stability to establish democratic institutions. In August 2019 a provisional constitution was passed and the Federal Government of Somalia was constituted. Since then the country has been trying to re-establish several institutions, which culminated, with regard to IP rights, in the decree that resumed operations at the Trademarks Office in late 2019.

The previous trademark situation

Trademark registrations did not exist in Somalia for 28 years. In more recent years a solution for protecting trademarks was adopted in the form of cautionary notices. These were advertisements in a local

newspaper, preferably a leading one, in which a specific entity described an IP asset and claimed ownership of it. The aim was to acquire sufficient public recognition of ownership. This is a standard proceeding in many jurisdictions where IP rights are not provided by law or specific means to acquire such rights are not determined.

The new trademark situation

Thanks to the decree it is now possible to file trademark applications at the Trademarks Office, which was established under the Ministry of Commerce and Industry. However, the decree does not provide much more detail than the fees for trademark registration (\$1,000) – it appears that the Trademarks and Patents Law (1975) still governs this area. While trademarks registered before 1990 appear to no longer be valid, previous registrations may be taken into account by courts in some cases. Because the 1975 law is being followed, the Trademarks Office is classifying applications using the old Italian system of 49 classes. Only single-class applications are being accepted. One of the major concerns is that applications are not being published in a trademark gazette and, consequently, there are no opposition proceedings. It is understood that the office is conducting examinations on absolute and relative grounds before granting applications. It also appears that proceedings are fast, with registration certificates being issued within one month. Registration is then valid for 10 years after the filing date.

While it may be true that Somalia is still to approve much-needed trademark laws, the decree is an important first step in establishing a functioning IP system in a country that has many more important problems to solve. |

How religion influences trademark applications in Libya

Inês Sequeira

Africa

Libya



Libya lies along the southern edge of the Mediterranean in North Africa and is the fourth largest Arab nation in the world. It has a population of almost 7 million people, 97% of whom are Sunni Muslims.

Sharia is the main source of law in all Islamic states. It is derived from the Qur'an and the traditions (Sunnah) of the Prophet Mohammad by religious scholars (the ulema) who have been trained in one or more schools of Islamic jurisprudence. In line with Sharia practice, each Islamic country has its own IP laws.

The principles of morality, modesty and prohibition encompassed in Sharia influence the registration and enforcement of IP rights. Certain goods and services that may seem commonplace to brand owners and consumers are forbidden and therefore trademarks related to them are not registrable in Libya.

Libyan trademark law prohibits the registration of certain categories of trademarks, including those seen as "violating public morals or public order" (Article 5(b)) or those that are "identical or similar to symbols constituting a pure religious nature" (Article 5(e)).

In practice, this means that trademarks referencing banned substances are regularly refused (eg, pork products in Class 29 and alcoholic beverages in Classes 32 and 33).

In addition, trademarks that incorporate non-Islamic religious symbols, such as the Christian cross or Christmas-related goods (eg, Christmas trees in Class 28) are also refused.

If the mark lacks any requirement as provided in the law and its implementing regulations, the application may be rejected by the examiner. The applicant may appeal the rejection of its application to a commission appointed for that purpose within 30 days of the date of receiving the relevant official notification.

The steps and rough timeframe for filing a trademark application are as follows:

- filing to examination – 10 to 12 months;
- examination to publication – 12 months);
- opposition period – three months from the publication date); and
- granting of the trademark.

Libya presents brand owners with significant opportunities and potential challenges. If the fundamentals of Libyan culture – particularly that of Sharia – are adhered to then the trademark can be accepted. However, since legal grounds for refusal are not particularly clear under the Trademarks Law (40/1956), there may be a rise in appeals from applicants who file marks for the abovementioned classes of goods, especially with regards to Articles 5(b) and (e).

A specific rule must be added to confirm these goods as an absolute ground for refusal of trademark registration. |

*“ In line with Sharia practice,
each Islamic country has its own
IP laws. The principles of
morality, modesty and
prohibition encompassed in
Sharia influence the registration
and enforcement of IP rights. ”*

Life of a trademark at the African Regional Intellectual Property Organisation

Diogo Antunes

Africa

ARIPO



The African Regional Intellectual Property Organisation (ARIPO) allows an applicant to register a regional trademark, which designates the following countries:

- Botswana;
- Eswatini;
- Lesotho;
- Liberia;
- Malawi;
- Namibia;
- Sao Tome and Principe;
- Tanzania;
- Uganda; and
- Zimbabwe.

One of the main differences between ARIPO and the African Intellectual Property Organisation is that at the former it is possible to designate several or all member states.

The trademark registration system in ARIPO is fairly simple – there is an online platform, which contains all the forms to be filled out. A trademark registration request can be made in less than 30 minutes if the applicant has the current information to hand.

Upon receiving the application, ARIPO processes the formal examination and communicates it to member states. These must then carry out a substantive examination in accordance with their national laws within nine months of ARIPO's notification.

If the trademark meets the formal requirements it is published in the *Marks*

Journals. Within three months it is possible for an opposition to be filed by an interested party. The opposition must be filed at ARIPO but the procedural and substantive examination of the opposition proceeding is carried out according to the laws of each member state.

If the application overcomes all obstacles and the granting fees have been paid, its concession is published in the journal. The trademark will then be valid for 10 years from the application date and is renewable for equal periods, consecutively.

After the trademark is granted, the applicant must bear in mind that cancellation is possible according to the laws of each member state.

Cancellation (eg, due to lack of serious use), if successful, must be communicated to ARIPO and is published and recorded in the registration process.

Further, ARIPO allows for subsequent designations of member states, permitting the applicant to decide – during the pendency or after the granting – to designate more countries than those initially requested.

Although elements of ARIPO's practice are complex, its system is easily accessible, not only because of the technology available but also the clarity of its legislation when it comes to completing a trademark registration. |

Registration challenges for pharmaceutical trademarks in Angola

Miguel Bibe

Africa

Angola



In Angola, all trademark applications are subject to examination by the Angolan Institute of Industrial Property (IAPI). During this process, if the institute concludes that there are grounds for refusal as specified under Articles 31(1) and 35 of the Angolan Industrial Property Law, it will publish the refusal in the *Industrial Property Bulletin*.

In 2018, several publications in the *Industrial Property Bulletin* stated that applications had not been regulated as per the Industrial Property Law – namely, they violated the World Health Organisation’s (WHO’s) international non-proprietary name (INN) rules. An ‘INN’ is an official generic and non-proprietary name given to a pharmaceutical drug or an active ingredient, which provides a unique standard name for each active ingredient.

The WHO has a mandate to “develop, establish and promote international standards with respect to biological, pharmaceutical and similar products”, collaborating closely with INN experts and national nomenclature committees to select a single name for the global use of every active substance that is to be marketed as a pharmaceutical. Trademarks should neither be derived from INNs nor contain common stems used in INNs as this could be dangerous for patients. Entities cannot obtain the exclusive trademark rights of a protected designation as an INN. Responsibility falls on the IP offices of UN member states and, consequently, the WHO to ensure the compliance to these provisions. According to the *Industrial Property Bulletin*, IAPI refused to register the word mark DEXAMEX in Class 5, which covers medicines, due to the “violation of the INN, adopted by the WHO, for active

substances in medicines prohibited from being registered as trademarks”. It referred to Article 77, which states that the “provisions of the international conventions of which Angola is a member, relating to industrial property, shall apply with the provisions of the present Law” and applied this in connection with the absolute grounds for trademark refusal provided in Article 31(1) (ie, applications that do not distinguish a company’s goods or services from identical or similar ones), Article 35(f) (expressions or logos contrary to good customs or offensive to law and public order) and Article 73 (unfair competition) of the Industrial Property Law. In light of the above, it can be confirmed that there is an additional absolute ground to refuse a registration in Class 5 covering medicines in Angola.

However, the registration process for these marks may take longer than usual, as IAPI must cooperate with the Ministry of Health on this matter, which must confirm that there is no violation of WHO rules at the time of the trademark application examination. In practice, this means that there are two independent authorities carrying out trademark examinations in Angola. While this examination process is more time-consuming and delays the decision to grant marks, it is a positive for protecting pharmaceutical marks and demonstrates that IAPI is committed to complying with international regulations. Further, it ensures that no entity benefits from the exclusive rights of protected designations as INNs. However, since the legal grounds for refusal are not particularly clear under the Industrial Property Law, there may be a rise in appeals from applicants that file trademarks using INNs, especially with regard to Article 35(f) (expressions or figures contrary to the good customs or offensive to law and public order). A specific rule must be added to confirm the protection of these terms as an absolute ground for refusal of trademark registration. |

How to stay on top of trademark oppositions in Lesotho

Inês Monteiro Alves

Africa

Lesotho



Lesotho has been a signatory member of the Paris Convention since 1989. In 1999 it ratified the Madrid Agreement and Protocol and on that same year the Banjul Protocol on Marks within the framework of the African Regional Intellectual Property Organisation (ARIPO).

There are thus **three routes to obtaining registration of a trademark in Lesotho**:

- nationally – directly with the national IP registry;
- regionally – via ARIPO; and
- internationally – via the Madrid Protocol.

Upon filing an application and subsequent to the formal examination conducted by the Lesotho Trademark Registry, Article 28(4) of Industrial Property Order 5/1989 (as amended by Act 4/1997) determines that: “[a]ny interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on grounds that one or more of the requirements of section 2, relating to the definition of a mark, and section 26(2) and the regulations pertaining thereto are not fulfilled.”

Article 51 of the Industrial Property Regulations 1989 establishes that after filing an opposition the defendant then has two months to state, in writing the grounds upon which the applicant relies for his application and accompanied by supporting evidence if any”. It then has the opportunity to request a hearing “at any time after the filing of notice of opposition but not later than one month after the expire of the prescribed period

for filing the counter-statement. The Registrar shall give the parties at least one month's written notice of the date set for the hearing.”

The law establishes that the **Lesotho Trademark Registry is obliged to publish regional and international trademark applications for opposition purposes**.

However, this is not current practice – in actuality, the registry publishes only national trademark applications.

This means that applicants for international and regional trademark registrations that designate Lesotho – as well as interested third parties – must rely on the publications of ARIPO and WIPO and then file their oppositions accordingly before the Lesotho Trademark Registry.

The opposition period of two months starts when the international registration is advertised by WIPO or when the regional registration is published in ARIPO's *Bulletin*. |



PATENT



Patent Applications in the European Continent having Origin in China

Vítor Sérgio Moreira & Diogo Antunes

Europe / Asia



Background

In recent years, the investment from Chinese companies in Europe has increased substantially [1]. The fact that there is a growing investment by Chinese companies in European jurisdictions may result in a greater concern by these investors to protect their intellectual assets in Europe. In this sense, this article will seek to identify the profile of patent applications having origin in China and filed in European countries, in order to identify the main jurisdictions targeted by Chinese applicants and which are the technological fields of the respective patent applications.

We have gathered information referred to patent applications from public patent databases, namely the databases Espacenet and EP Bulletin Search, both provided by the European Patent Office (EPO), the statistics database made available by the World Intellectual Property Organization (WIPO), and the database OECD.Stat provided by the Organization for Economic co-operation and Development.

Investment from China in Europe

The figure 1 shows the cumulative value of Chinese foreign direct investment (FDI) in the European Union (EU) by country from 2000 to 2019 1. The top 10 countries recited in figure 1 have received in said period almost 90% of the overall Chinese FDI.

According to data from the MERICS 1, the

sectoral mix of Chinese investment in Europe was quite concentrated in 2019, far more so than in the previous year. The sectors Automotive, Consumer Products and Services, Financial and Business Services, Health and Biotechnology and ICT received more than 80 percent of total Chinese investment within the EU.

Total number of patent application having origin in China

The trend of filing of patent applications having origin in China Mainland before European countries and before the regional European Patent Office (EPO) is shown in Figure 2. To identify these results, we have used the WIPO statistics database. The results of Figure 2 were obtained through the indicator Total Patent Applications (direct and PCT national phase entries), in which the country of origin is China Mainland, and the filing Patent Offices correspond to the National Patent Offices of each one of the countries expressly cited in figure 1 and EPO from 2000 to 2018.

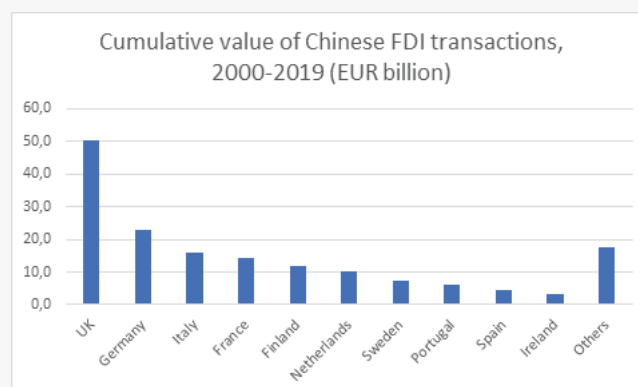


Figure 1

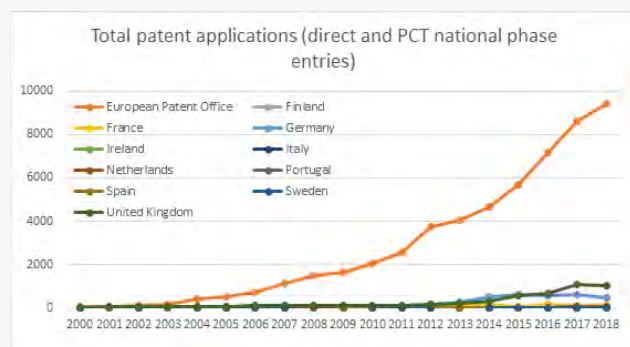


Figure 2

The figure 3 reveals that the Chinese Applicants usually employ the Treaty of Cooperation in Patents (PCT) in order to file the patent applications before the European jurisdictions, wherein the results of figure 3 were obtained by a similar indicator to that one employed for figure 2. The results show a massive predominance of patent applications in EPO, corresponding to Euro-PCT applications, followed by minor filing applications before the National Patent Office from UK and before the National Patent Office from Germany.

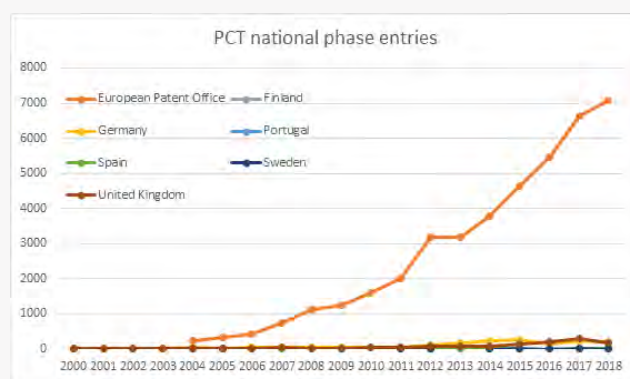


Figure 3

We shall mention that selecting the EPO as the filing Office is advantageous when the Applicant seeks protections for his invention before many countries from Europe, because after having a patent granted, it is possible to easily validate it in several countries, filing requests of validation of the European patent to each one of the countries of interest. In addition, the processing of a European patent enjoys a centralized and rigorous

examination process that is accepted by the member state institutes. Annuities, while the European patent application is being analyzed, are due to the European Institute itself. Figure 3 shows a growth in European patent applications from PCT applications. This growth has been steady over the past few years.

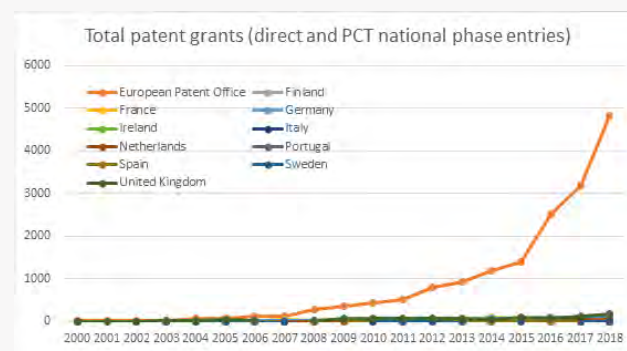


Figure 4

Figure 4 shows the total patent grants (direct and PCT national phase entries), as a result of mapping the indicator Total Patent grants (direct and PCT national phase entries), comprised in the WIPO statistics database, in which the country of origin is China Mainland, and the filing Patent Offices correspond to the National Patent Offices of each one of the countries expressly cited in figure 1 and EPO from 2000 to 2018. It is observed a positive correlation between the patent applications before EPO and their grants, which highlights the quality of inventions having origin in China.

Preferred technological fields

Regarding the main technological fields of applications filed by Chinese applicants in Europe, emphasis on patent applications related to the areas of digital communications, computer technology, telecommunications and heavy machinery and energy is observed in the set of results.

(...)



How can Utility Models provide protection to subjects with smaller levels of “inventiveness”?

Vítor Sérgio Moreira

Europe / Africa / South America

The Patent Lawyer
Magazine

Vítor Sérgio Moreira provides a case study on utility models in Angola, Brazil, Mozambique and Portugal.

Several countries allow protection of subject matters by means of Utility Models, which are generally considered as inventions having a smaller level of inventiveness. Usually, the utility models are examined by the Patent Offices according to simpler and accelerated procedures than that related to a patent application. The utility models play an important role in developing countries, wherein this kind of protection aims to provide a significant level of protection to applicants that develop new products having some level of inventiveness. The provision of utility models also allows an initial easier use of benefits comprised in the patent system. However, some fully developed countries, as Germany, still maintain utility models in their patent system.

This study aims to compare the legal aspects of utility models in some Portuguese speaking countries, namely Angola, Brazil, Mozambique and Portugal. We also present some data related to the filing of utility models in most of the abovementioned jurisdictions. Moreover, some challenges and advances referred to substantive examinations, namely the inventiveness requirement, by the respective Patent Offices are presented.

Angola

Utility models are protected in Angola according to Industrial Property Law No. 3/92 of February 28, 1992. The article 15

of said IP Law defines a utility model as “Any new arrangement or form obtained in or introduced into objects such as tools, work implements or utensils that improve or increase the conditions for their use and their usefulness”. Furthermore, the subject matter shall meet the novelty criteria, considering that “Protection shall be granted exclusively to the particular new form that makes it possible to increase and improve the utility and utilization of the objects for which it is intended”.

Brazil

The IP National Law No. 9.279, of May 14, 1996 of Brazil also provides protection of inventions by utility models. According to its Article 9, “an object of practical use, or part thereof, shall be patentable as a utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture.” In comparison with patent protection, the Brazilian Law states in its Article 8, that “an object of practical use, or part thereof, shall be patentable as utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture”. The term of a utility model in Brazil is 15 years as from the filing date.

Mozambique

Utility models are also protected in Mozambique, according to provisions of

the Industrial Property Code (Decree No. 47/2015 of December 31, 2015), wherein a utility model is “an invention that gives an object or part thereof a configuration, structure, mechanism or layout resulting in a functional improvement in its utility or manufacture”.

The national Law of Mozambique allows that a patent application may be converted in a utility model, provided that the applicant request said change before a substantive examination. A regional patent application, filed before African Regional Intellectual Property Organization (ARIPO), may be converted into a utility model in Mozambique, provided that the regional patent application was refused or withdrawn.

Concerning the patentability requirements, the article 97 of the national IP Law of Mozambique defines that “every invention which involves a significant inventive step and has an industrial application is eligible for protection as a utility model, with the exception of pharmaceutical and agro-pharmaceutical”. Moreover, “an invention shall be deemed to have a significant inventive step if it functionally improves the utility of an object or its manufacture”, according to Article 98 of the same Law.

Mozambique provides a faster and simpler prosecution of utility models applications, as is explicit in Article 101 of the national IP Law. The duration of the utility model shall be 15 years from its filing date.

	Sum of patent applications publications	Sum of utility models application published	Utility Models (%)
Angola	88	1	11
Moçambique	44	3	64

Portugal

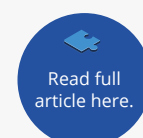
The Portuguese IP Law also allows the protection of inventions by utility models. Regarding the patentability criteria, the invention shall have to be novel and have industrial applicability. Moreover, the invention is required to have an inventive step, wherein the invention must meet one of the following requisites:

- The invention must not be an evident result from the prior art;
- The invention must present a practical or technical advantage for preparation or use of the product or process concerned.

Portugal also included an article in its IP National law stating that the prosecution of a utility model is simpler and accelerated than that related to a patent application. The duration of the utility model shall be until 10 years from its filing date.

A provisional patent application may be converted in a non-provisional patent application within one year from its filing date and, simultaneously, may result in a utility model application. Moreover, the European Patent Convention and the IP Portuguese Law provide the opportunity to convert a withdrawn or refused European patent application into a patent or a utility model application in Portugal.

(...)



Patent Applications in the African Continent having Origin in China

Vítor Sérgio Moreira & Diogo Antunes

Africa / Asia



Background

In recent years, the investment from Chinese companies has increased **substantially**. Chinese companies operating in Africa have contributed to the development of certain industries in different countries on African continent*. The fact that there is a growing investment by Chinese companies in African jurisdictions may result in a greater concern by these investors to protect their intellectual assets in Africa. In this sense, this article will seek to identify the profile of patent applications having origin in China and filed in African countries, in order to identify the main jurisdictions targeted by Chinese applicants and which are the technological fields of the respective patent applications.

Due to the scarcity of complete and updated databases in several African jurisdictions, we have tried to gather as much information as possible from several public patent database, per instance the database Espacenet of the European Patent Office (EPO) and the statistics database of the World Intellectual Property Organization (WIPO). As it will be discussed, the databases show convergent results for some jurisdictions with higher numbers of requests submitted. The WIPO database, despite not having as many results as the Espacenet database, ends up with information that can be filtered by more African countries than Espacenet. However, it will not be possible to obtain a full scanning of the complete scenario,

but only a sample, that we believe to be representative of the purpose of this article, due to information gaps present in the two bases used for a very significant portion of African countries.

Investment from China

Observing the growth trend of the red curve in Figure 1, it may be possible to establish a positive correlation between the evolution of Chinese investments in the African continent and the growth trend of patent applications with Chinese origin in this continent.

According to data from the Johns Hopkins University **SAIS China-Africa Research Initiative**, in the period between 2013 to 2018, Chinese investments were distributed, in approximate percentages, according to the following areas: construction (28%); mining (25%); manufacturing (13%); financial intermediation (13%); scientific research and technological service (5%); leasing and commercial service (6%) and others (10%).

We also refer that Chinese direct investment has supplanted US investment, with an increasing trend. This may imply, in the short range, an increase in patent applications filed in several African countries.

(...)



Looking at EU priority in ARIPO patent applications

Vítor Sérgio Moreira

Europe / Africa

The
Patent Lawyer
Magazine

Vítor Sérgio Moreira examines the growing trend in EU priority claims in ARIPO patent applications and looks at which sectors those applications are most likely to originate from.

In this article, we aim to identify the profile of patent applications filed before the African Regional Intellectual Property Organization (ARIPO) in which priority is claimed via a document originating from a European Patent Office Member State (EU priority). In doing so, we intend to acquire more information about the main technological fields and applicants from Europe that seek patent protection with the member states of ARIPO. ARIPO was created by the Lusaka Agreement (1976). It is an intergovernmental organization for cooperation in matters related to patents, trademarks, and other IP rights.

In respect to patents, ARIPO is empowered to grant patents and administer such rights on behalf of Contracting States of the Harare Protocol (1984). ARIPO applications require the applicant to designate those member states where protection is sought. The ARIPO system does not replace national systems.

The results of our research indicate a growing trend in the number of patent applications filed before ARIPO (AP patents) claiming an EU priority. The main technological fields observed are related to the pharmaceutical industry and the agrochemical industry. The applicants are major European corporations with a global presence in their respective industrial sectors.

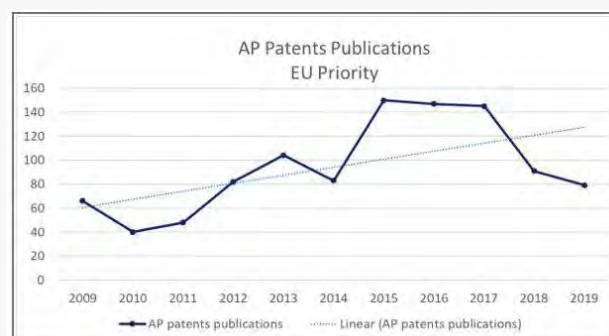
Methodology and results

The top 20 European origins of the EU priorities in AP patents were identified using the Espacenet database and are presented in Table 1. The search statement has comprised AP patent publications having priority from a European Patent Organization (EPO) Member State and published from 2009 to 2019, which resulted in 888 documents.

EPO Member State	Country Code	AP Documents EU Priority	Fraction (%)	Accumulated Fraction (%)
EPO	EP	457	44.0	44.0
United Kingdom	GB	136	13.1	57.1
France	FR	124	11.9	69.1
Germany	DE	76	7.3	76.4
Italy	IT	52	5.0	81.4
Others		193	18.6	100
Sum		1038	100	

Table 1: EU priorities origins in AP patents

The trend of AP patents claiming EU priorities in the last ten years has been identified in the ARIPO patents database and is presented in Figure 1 (image on the right). These results were obtained after searching the ARIPO database for patents



claiming priorities originated from the jurisdictions listed in Table 1 and published from 2009 to 2019. During this time period, the total number of AP patents is 1035. In order to identify the main technologies and applicants referred to by AP patents claiming an EU priority, the set of 888 AP patents published from 2009 to 2019 and obtained by means of the Espacenet database was inputted into the patent analysis free tool PatentInspiration.

The most frequent IPC (International Patent Classification) Main Classes are presented in Table 2. The data indicates that a significant number of patent documents referred to pharmaceutical and agrochemical industries. The IPC main classes C07D and C07K referred to are chemical compounds that may have uses, for example, as active ingredients in pharmaceutical or agrochemical compositions.

IPC Main Class	Counting	IPC (%)	Accumulated Fraction (%)	Description
A61K	278	28.1	28.1	Preparations for medical, dental, or toilet purposes
C07D	199	20.1	48.2	Heterocyclic compounds
A61P	156	15.8	64.0	Specific therapeutic activity of chemical compounds or medicinal preparations
A01N	127	12.8	76.8	Biocides, pest repellents or attractants, plant growth regulators
C07K	26	2.6	79.5	Peptides
A01P	17	1.7	81.2	Biocidal, pest repellent, pest attractant or plant growth regulatory activity of chemical compounds or preparations
Others	186	18.8	100	

Table 2: Main Class IPC identified in AP patents claiming an EU priority published from 2009 to 2019

Applicant	Count (%)	Fraction (%)	Accumulated Fraction (%)	Core Business
SERVIER LAB	38	3.8	3.8	Pharmaceutical
JANSSEN PHARMACEUTICA NV	30	3.0	6.9	Pharmaceutical
SYNGENTA PARTICIPATIONS AG	23	2.3	9.2	Agrochemicals and seeds
BAYER IP GMBH	23	2.3	11.5	Pharmaceutical & life sciences
UNILEVER NV	22	2.2	13.8	Consumer goods
TIBOTEC PHARM LTD	21	2.1	15.9	Pharmaceutical
BASF AG	19	1.9	17.8	Chemicals
BAYER CROPSCIENCE AG	19	1.9	19.7	Agrochemicals and seeds
ENI SPA	17	1.7	21.5	Oil and Gas
BOEHRINGER INGELHEIM INT	17	1.7	23.2	Pharmaceutical

Table 3

The top 10 most frequent applicants of AP patent publications and their respective main core businesses are presented in Table 3. The most frequent countries of origin referred to by the applicants of AP patents claiming an EU priority are presented in Table 4.

Country	Counting	Fraction	Accumulated Fraction (%)
Germany	150	17.2	17.2
France	130	14.9	32.1
United Kingdom	92	10.5	42.6
Switzerland	83	9.5	52.1
Finland	58	6.6	58.8
Netherlands	54	6.2	64.9
Italy	50	5.7	70.7
Belgium	43	4.9	75.6
United States	37	4.2	79.8
Sweden	36	4.1	84.0
Others	140	16.0	100

Table 4

The United States results come about from ARIPO patent applications, wherein the applicants come from this country and a priority document was filed in the European Patent Office or a National Patent Office from a country mentioned in Table 1.

In addition, we have used the ARIPO database to identify, for the set of 1035 AP patents referred in Figure 1, the profile of the designation of member states, presented in Table 5, in order to contribute to the identification of the main jurisdictions of interest to the European applicants of the AP patents.

(...)



European Patent Applications filed by Applicants from Africa

Vítor Sérgio Moreira

Europe / Africa

This study aims to identify the profile of the filing of patent applications before the European Patent Office (EPO), wherein at least an applicant is domiciled in Africa, and to acquire more information about the main technological fields and applicants from Africa that seek patent protection within the member states of EPO.

We have evaluated the European Patent Applications filed from 2009 to 2019 having an applicant domiciled in Africa ("EP Africa patents applications") by means of the

EP Bulletin search database, wherein 1227 documents were retrieved.

Below is listed a Top 10 counting of the number of hits according to the Applicant's country.

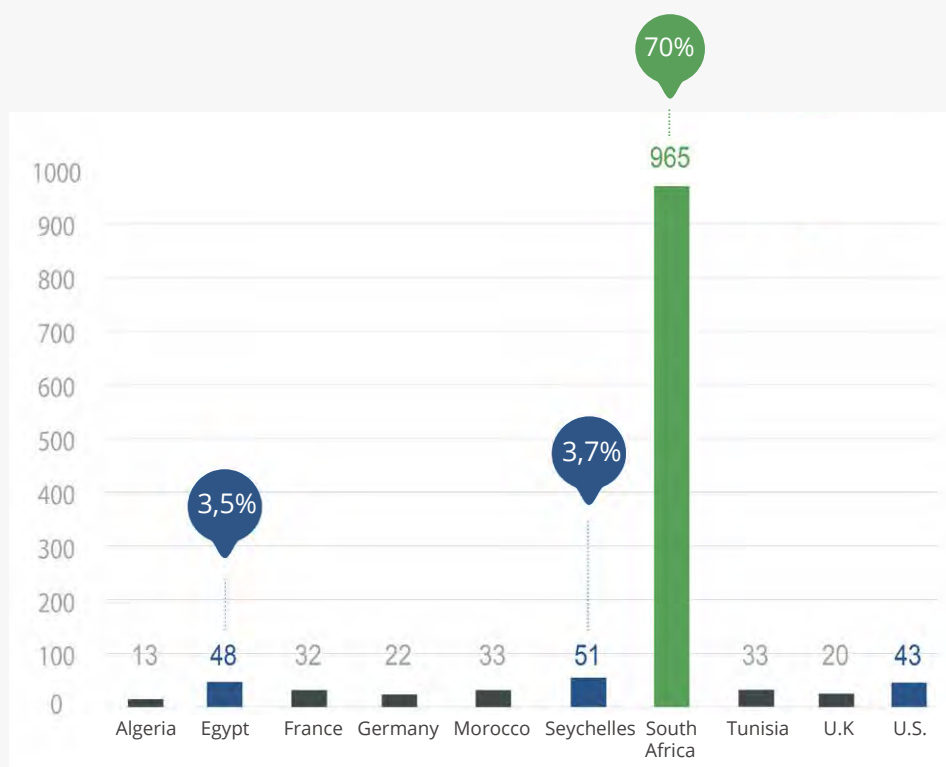
It is remarkable the predominance of applicants from South Africa.

Moreover, a significant amount of patent applications has associations of African applicants and from other countries, for example the U.S., France, Germany and United Kingdom.

Trending of filing of European patent applications per African country of residence

A steady rate of European patent applications per African country of residence of the first applicant is illustrated in the next figure, wherein the applicants from South Africa clearly prevail over the remaining countries. The overall number of EP Africa patent applications in 2018 was 142, which represents less than 0.1% of the number of European patent applications filed in said year, considering the overall filings, extracted from EPO's Statistics referred to 2018. The European patent applications include direct European applications and international (PCT) applications that entered the European phase during the reporting period.

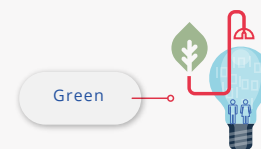
(...)



Top 10 European patent applications wherein at least an Applicant is domiciled in Africa

Green Patents and Remote work?

What are the odds?



Vítor Sérgio Moreira & Diogo Antunes

Worldwide

The world is constantly changing. The changes, however, cause friction with the old habits and represent a threat to the eyes of those who have benefited so much at the expense and detriment of the environment. Climate change, air and water pollution, rising water levels in the oceans, and other circumstances that threaten terrestrial fauna and flora have been in the spotlight in recent years.

If, on one hand, there is an increasing number of individuals and collectivities that are concerned with debating these issues, on the other hand, companies already established with substantial dividends are little interested in this dialogue. In addition, large national economies are sustained in the exploitation of natural resources that pollute the planet earth, such as oil and subsequent derivatives.

Faced with these problems, the development of solutions has been present in the entrepreneurial spirit of many inventors. Naturally, the protection of solutions in this field occurs through the patent system.

Green patents protect inventions related to the protection and preservation of the environment. However, as a rule, its legal framework is not different from other inventions. In the last decades, the concern of Governments and their institutions have increased, precipitating normative impulses so that this type of patents have deposit and granting mechanisms designed to measure. Brazil presented a pilot program in 2012 that was extended until 2016 that aimed to

speed up patent applications involving inventions related to the environment. ⁽¹⁾ The pilot program solidified and, as of December 6, 2016, the Brazilian Institute began to offer the possibility of priority examination of green patents, if it meets certain characteristics. The first characteristic concerns the object of protection that must be included in the list prepared by the [Institute](#) based on the [WIPO Inventory](#).

The remaining requirements concern the number of claims that must not be more than 15 and 3 of them must be independent. Other countries also promote expeditious examinations with a view to the rapid granting of patents in this matter. In this sense, we managed to find similar solutions in countries like Australia, Canada, Israel, Japan, Korea, UK and USA.

Remote Work

We must consider that, within the scope of green patents, there may be different inventions for the same solution but also different inventions that contribute in a different way to the final solution. Contributions can also be direct or indirect. Since the direct solutions to the problems have been scalped over time, this study, imbued by the current state of nations due to the pandemic caused by COVID 19, brings to the debate a statistical analysis of patents that relate remote working to the environment.

For example, the absence of movement on the streets due to the quarantines imposed by the various states at a global

level has contributed to the reduction of pollution in [general](#).

In just one month there was a [reduction in the amount of nitrogen dioxide in China](#). In Europe, the same phenomenon was also consistent in European cities such as Paris, Rome and Madrid, having 50% less air pollution than last year in the [same period](#).

There is no doubt that the closure of much of the industrial sector is largely responsible for reducing these levels of pollution. However, a slice is due to the fact that people are confined at home. In this way, there are certain inventions in the scope of telework, tele-school etc., which can help the decision of companies, schools, and institutions to implement a service provision or distance learning regime that ends up reducing the number of cars on the road, using plastics (related to food for example), and other polluting materials that are used in our normal day-to-day lives. In this sense, it is important that companies take the opportunity to change the mindset of their management and encourage remote work for functions whose physical presence is neither essential nor necessary.

We have selected some patents related to the provision of distance work that can help shape the business sector.

1. US2014136630A1 - System and method of managing meeting invitations
2. WO2019211713A1 - Automated augmented reality rendering platform for providing remote expert assistance
3. JP2017174353A - TELEWORK MANAGEMENT SYSTEM AND PROGRAM FOR TELEWORK MANAGEMENT
4. CN204926175U - Telecommuting system
5. JP2016001385A - Remote management device, remote management method, control program, electrical apparatus, and remote management system

From the previous examples, it is clear that there are several patent applications that introduce technologies that allow the improvement of the daily life of a worker or student at home so that they may perform their duties without leaving home. This type of measures could improve the environment if used on a large scale, since fewer cars circulating on the road means less oil related products in consumption, which in turn contributed to the reduction of its extraction due to lack of demand.

In addition, several inventions related to the reduction of travels can be applied not only to remote work situations but also to visits to the doctor or other types of journeys that can be replaced by efficient and capable technology. As we will see below, there has been a growing number of inventions in this specific area, the pattern of which is interesting to analyze.

Statistical Study

The World Intellectual Property Organization (WIPO) has developed a compendium of Environmentally Sound Technologies (ESTs) related to International Patent Classifications (IPCs), named IPC Green Inventory. This set of technologies comprises several technical fields, for example: biofuels, wind energy, solar energy, waste management and pollution control.

The inventions related to remote work are comprised in the IPC Green Inventory, and besides being relevant in the environmental context, they are also remarkable in the current disruptions caused by COVID-19.

(...)



China takes over world leadership in international patent applications

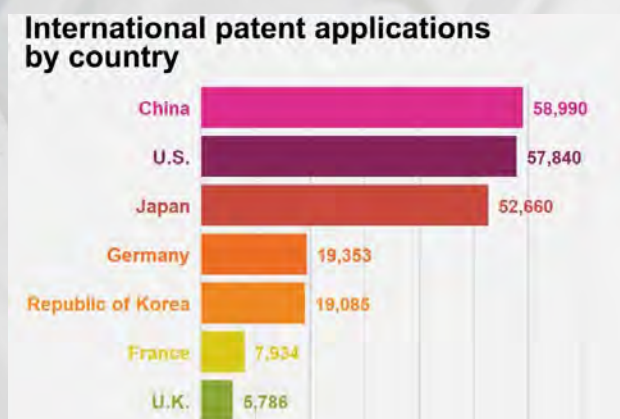
Miguel Bibe

Worldwide



In 2019, China became the world leader in international patent applications, according to the annual report of the World Intellectual Property Organization, presented in Geneva, having overtaken the United States of America and ended a period of leadership that had lasted since the creation of the WIPO Patent Cooperation Treaty (PCT) in 1978.

In a very positive year as regards the number of patent applications at WIPO, there was a general increase of 5.2%, resulting in a total number of 265,800 applications. The 58,990 international patent applications from China contributed to these figures, followed by the 57,840 applications from the United States of America and, closing the Top 5, Japan (52,660), Germany (19,353) and the Republic of Korea (19,085).



(WIPO)

In view of these figures, it can be confirmed that applicants for international patent applications from the Asian continent account for more than half of all applications, namely 52.4%, while Europe represents for 23.2% and North America has a share of 22.8%.

This increase in the number of international patent applications has led WIPO Director General Francis Gurry to consider 2019 as "the best year we have experienced in the history of the Organization", adding that "China's rapid growth to become the top filer of international patent applications via WIPO underlines a long-term shift in the locus of innovation towards the East" and that "in 1999, WIPO received 276 applications from China.

By 2019, that number rose to 58,990 – a 200-fold increase in only twenty years". In this regard, following the trade war between the United States and China, these figures provide arguments for the Chinese government to refute the U.S. government's accusations of violations of intellectual property rights, including patent theft, and, even more so, in light of Francis Gurry's speech that China, in a few decades, has built an intellectual property system, encouraging domestic innovation and increasing global leadership in this sector.

As for applicants, according to the WIPO report, for the third consecutive time the Chinese telecommunications company Huawei Technologies leads the ranking with 4,411 international patent applications in 2019, followed by Mitsubishi Electric Corp. of Japan (2,661 applications), Samsung Electronics of South Korea (2,334 applications), Qualcomm Inc. of the United States (2,127 applications) and finally Guang Dong Oppo Mobile Telecommunications of China (1,927 applications).



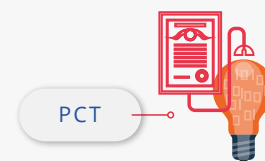
Among the top ten applicants, four are from China, two from the Republic of Korea and one from Germany, Japan, Sweden and the United States. It should be noted that of these ten companies, six of them filed applications related to digital communications, namely the Ericsson, the Guang Dong Oppo Mobile Telecommunications, the Huawei Technologies, the LG Electronics, the Samsung Electronics and the Qualcomm. As far as educational institutions are concerned, the University of California maintains first place with 470 international applications published in 2019, second place for Tsinghua University with 265 applications, followed by Shenzhen University (247 applications), Massachusetts Institute of Technology (230 applications) and South China University of Technology (164 applications). The top 10 universities consist of five American, four Chinese and one South Korean university. In the technology sector, computer technology (8.7% of the total) accounted the largest share of PCT applications published, followed by digital communication (7.7%), electrical machinery (7%), medical technology (6.9%) and measurement (4.7%). Among the ten main technologies, semiconductors (+ 12%) and computer technology (+ 11.9%) were the areas with the highest growth rates in 2019.

However, due to the Covid-19 pandemic, the expectations for the year 2020 are much lower, as it will have significant consequences on the global economy and, according to the WIPO Director General "the impact on creative industries and innovation will be extremely important", stating that it is still too early to quantify the impact, which will depend on the intensity and duration of the crisis, however, preliminary data received by WIPO for the months of January, February and March showed a decline in the growth of patent applications. |

Which countries do not belong to the International Patent System?

João Francisco Sá

Worldwide



While called “international” patent, not all countries are covered.

The *Patent Cooperation Treaty* (PCT), commonly referred to as *International Patent*, provides a common application mechanism for inventors wishing to protect their inventions around the world.

The PCT is useful because it allows inventors to have access to an International Search Report, which provides a non-binding opinion on the patentability requirements, allowing them to know if the patent has a greater chance of being granted, if it should be withdrawn or if amendments are necessary to further differentiate it from the current state of the art.

On a more procedural perspective, the PCT created a process of standardization of proceedings, forms and relevant deadlines, across IP Offices of all contracting parties, culminating in a total of **30-month*** for the applicant to choose the countries where protection for his invention should really be sought, counting from the date of first application (i.e. priority date).

However, like other international treaties, not all countries have ratified the PCT. It currently has 153 contracting parties (2020), while the United Nations has 193 full members. As such, the above mentioned advantages cannot be applied worldwide, namely the 30 month limit to decide the countries where protection is sought.

List of countries or regions that do not belong to the PCT (April 2020):

- | | |
|------------------------------------|---------------------------|
| • Afghanistan | • Macau |
| • Andorra | • Maldives |
| • Argentina | • Mauritius |
| • Bahamas | • Myanmar |
| • Bangladesh | • Nauru |
| • Bermuda | • Nepal |
| • Bhutan | • Pakistan |
| • Bolivia | • Paraguay |
| • Burundi | • Solomon Islands |
| • Democratic Republic of the Congo | • Somalia/Somaliland |
| • Cape Verde | • South Sudan |
| • East Timor | • Suriname |
| • Ethiopia | • Taiwan |
| • Fiji | • Tonga |
| • Guyana | • Uruguay |
| • Haiti | • Vanuatu |
| • Iraq | • Vatican City (Holy See) |
| • Jamaica | • Venezuela |
| • Lebanon | • Yemen |
| | • Western Sahara |

Using the Paris Convention

If a country is not member of the PCT, the Paris Convention for the Protection of Intellectual Property (1883) can be used during the definition of the internationalization strategy. While the Paris Convention does not provide an international examination procedure, it does provide a 12-month limit from priority date to file a patent abroad, which is best described visually.

(...)



Patent Applications as an Indicator of Research and Development Against Coronaviruses

Vítor Sérgio Moreira

Worldwide



Objective

In the context of COVID-19 pandemics, this article aims to use the published patent documents as a source of background information about the studies carried on to finding out a treatment against the severe acute respiratory syndrome coronavirus (SARS-CoV) and the Middle East respiratory syndrome coronavirus (MERS-CoV), which are caused by other types of human coronaviruses.

The patents resulting from experimental studies show trends during research, however it shall not be taken as granted that an approved and effective medication results from a patent application. Several knowledges and technical information have been gathered in the recent years, but considering some technical and scientific challenges, for example the lack of knowledge about the behaviour of the COVID19, an effective and licensed treatment still be far away for this recently discovered virus.

SARS-CoV

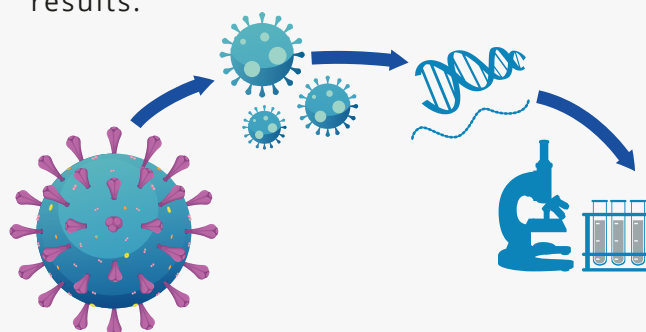
SARS-CoV has a common geographic origin with COVID-19, wherein it **first emerged in 2002 in Guangdong, China**. The virus rapidly spread across 29 countries, infecting more than 8000 people and killing 774. The SARS-CoV was recognized by World Health Organization (WHO) at the end of February 2003. According to data of [WHO](#), the epidemic curve went from November 2002 to July 2003, resulting in almost 6000 cases all over the world. The international effort coordinated by WHO has controlled the SARS outbreaks of 2003-2004.

MERS-CoV

The **MERS-CoV epidemic appeared in Saudi Arabia in 2012**, with people experiencing similar symptoms to SARS-CoV but dying at a much higher rate of 35.9 per cent. Unlike SARS-CoV, which spread quickly and widely, MERS-CoV has been mainly limited to the Middle East. According to data from WHO, from 2012 until the end of November 2018, a total of 2494 laboratory-confirmed cases of MERS-CoV infections were reported from 27 countries with 858 associated deaths. The coronavirus responsible for this disease does not spread so globally and homogeneous as COVID-19 and the SARS-CoV.

Patent documents referred to SARS-CoV and MERS-CoV

In order to identify the patent documents related to medicinal preparations against the SARS-CoV and MERS-CoV, a search was performed in Espacenet database employing the international patent classifications referred to medicinal preparations listed in table 1. Moreover, keywords related to both diseases were used in the title or in the abstract of the patent documents, in order to filter the results.



IPC classification symbol	Description
A61K31	Medicinal preparations containing organic active ingredients
A61K33	Medicinal preparations containing inorganic active ingredients
A61K35	Medicinal preparations containing materials or reaction products thereof with undetermined constitution
A61K36	Medicinal preparations of undetermined constitution containing material from algae, lichens, fungi or plants, or derivatives thereof,
A61K38	Medicinal preparations containing peptides
A61K39	Medicinal preparations containing antigens or antibodies

Table 1: International Patent Classifications referred to medicinal preparations

In the figure 1, the number of published patent documents which represent a patent family referred to medicinal preparations to treat SARS along time is presented. Each patent family consist of an invention and each family may have several different patent applications filed in Patent Offices all over the world. The patent documents referred to organic, antigens or antibodies and peptides as active ingredients are dominant during the research approaches. On the other hand, as the curve of epidemics of SARS decreased in July 2003, about nine months after appearing of the disease, the investments on researching and developing, measured in published patent applications have been decreasing until today.

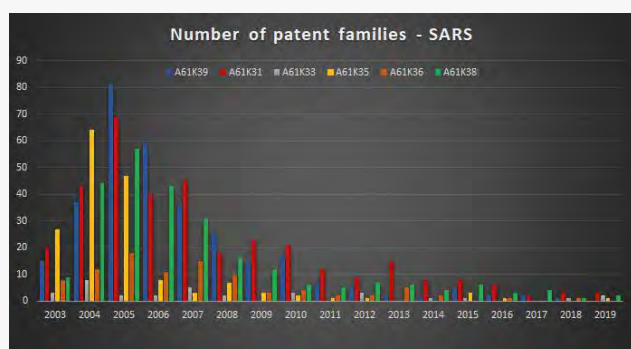


Figure 1

In the figure 2, the published patent documents which represent a patent family referred to medicinal preparations to treat MERS along time is presented. The patent documents referred to antigens or antibodies as active ingredients are dominant during the research and development approaches, that seem to follow a steady rate, considering the number of patent families, although in a significant reduced

amount, when compared to the peak of patent documents referred to SARS.

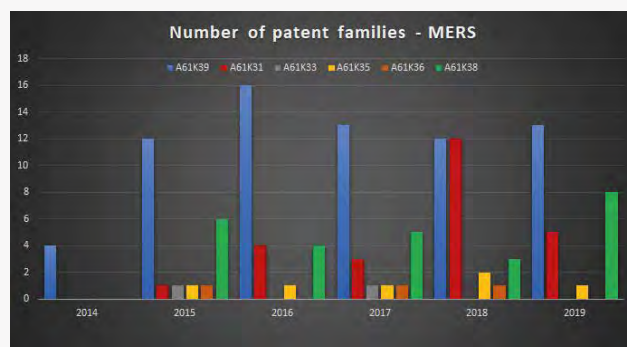


Figure 2

Licensed medications to treat SARS and MERS

Despite all the efforts and researching investments, an effective and approved medication against the two diseases has not been developed. Considering the MERS, in the study of Kayvon Modjarrad, "[Research and Development Activities for Middle East Respiratory Syndrome: The Current Landscape](#)", published in 7 May 2016, it is stated that there are five general vaccine platforms in development for MERS-CoV. At the time of said report, the vaccines were in preclinical stages of development. According to WHO, no vaccine or specific treatment for MERS is currently available.

Conclusions

In the same pattern of a research to discover a new drug to treat a disease, it is going to be necessary to invest a significant amount of funds in research and development in order to develop a medicinal preparation against the COVID-19. For now, the patent application referred to medicinal preparations having the COVID-19 as a target are unpublished. We hope that within some months the first set of patent applications is going to be published by the Patent Offices. The experience and knowledge acquired during the fight against coronaviruses that cause SARS and MERS may be useful to develop a medicinal preparation against COVID-19

(SARS-CoV-2), but considering the background of previous diseases caused by coronaviruses, we might not expect a fully successful and licensed product in the short range. Moreover, even if a patent is related to a well succeeded product, we must consider the regular time frames necessary to approve a commercially available medicament, which is up to the governmental healthy agencies.

The global impact caused by COVID-19 (1,016,534 confirmed cases and 53,164 deaths*) is enormous. In comparison, according to WHO, SARS resulted in 8,098 confirmed cases and 774 deaths and MERS resulted in 2,494 confirmed cases and 858 deaths. Therefore, massive investments in research and development shall be expected in order to beat COVID-19. Accordingly, significant amounts of patent applications related to new medicinal preparations will be filed, besides patents related to second medical uses of known active pharmaceutical ingredients (APIs) and synergistic combinations of APIs. |

*Data from April 3rd 2020 from [tracking](#) performed by The Center for Systems Science and Engineering (CSSE) at Johns Hopkins University



Patents related to Artificial Intelligence in the European Patents Office

Vítor Sérgio Moreira & Diogo Antunes



Europe

EPO

It is manifest the growing interest of mankind in disruptive themes as Artificial Intelligence (AI). As we have been analyzing, this theme has increased its significance as the inventions reach new and inspiring outcomes. This article intends to analyze if there have been a growing tendency on patent applications related to AI in the European Patents Office or if, besides all the euphoria, we are still far away from a technological boom particularly inventive. Throughout the article, we will analyze some graphics and charts so we can draw some conclusions about the technological advance involving AI.

Research Methodology

Before we proceed, we need to pay attention to our research methodology which was based on the following topics:

1. Search in the [Espacenet patent database](#) of European patent applications containing at least one subgroup of the Cooperative Patent Classification (CPC) mentioned in chart 1 and published from 2010 to 2018;
2. Exportation of the results containing the European patent application publication numbers to the EP Bulletin Search and EP Full-Text Search databases;
3. Use of the *EP Bulletin Search* and *EP Full-Text Search* statistical tools to obtain the results shown in Figures 1 and 2 and Tables 2 and 3.

CPC Groups	CPC Subgroups searched	Group Specification
G06N3	G06N3/all	Computational systems based on biological models
G06N5	G06N5/003 or G06N5/006 or G06N5/02 or G06N5/022 or G06N5/027	Computer systems using knowledge-based models
G06N7	G06N7/005 or G06N7/02 or G06N7/023 or G06N7/026 or G06N7/04 or G06N7/043 or G06N7/46 or G06N7/06	Computational systems based on specific mathematical models

Table 1: CPC subgroups that refers to Artificial Intelligence

Number of applications vs Applicants

Data retract allowed to check an **exponential raise on the European patent applications number since the year 2000**, having its peak been observed on 2016.

Although, it is expectable that the number from 2017 and 2018 reaches a superior quantity, due to the fact that there are still applications in secrecy that were not made public through its publication.

(...)



COPYRIGHT



The protection of copyrights through Algorithms

Joana Teixeira

Worldwide



In an era where millions of content creators are uploading their works online, copyright infringement has become very easy, being as simple as uploading a TikTok video or making an Instagram Story.

Due to the evolution of the digital market, the European Parliament and Council approved the Directive 2019/790 on copyright and related rights in the Digital Single Market in April of 2019. When this directive first started to be drawn back in 2016, there was a lot of controversy regarding article 13, which held liable online platforms such as YouTube or Facebook for possible copyright violations from its user, unless “effective and proportionate measures” were taken to prevent the availability of unlicensed copyrighted works.

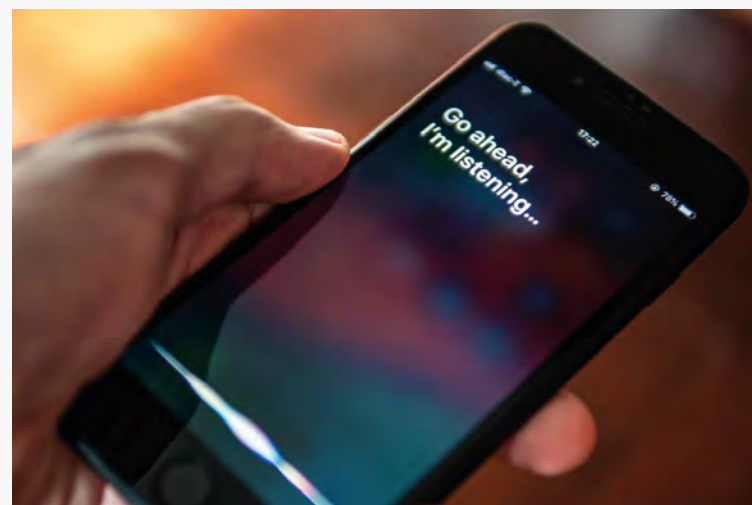
A year ago, the final version of the Directive was approved, giving Member-States a wide deadline to transpose it to their national laws, more specifically until the 7th of June 2021. In this version, the previous article 13 is now article 17 and was reformulated after all the debate that it brought for being too restrictive and reducing online freedoms.

As a result, we were given a broad article that maybe is not so different from its ancestor. According to it, online content-sharing provider services that perform an act of communication to the public or an act of making available to the public when it gives access to copyright-protected works, for which they need to have an authorization from the rightsholders. If this does not occur, the platform can be held liable.

So, naturally, the platforms will try to prevent liability by creating ways to find content that violates copyrights and then proceed to remove them. How they will do this is still uncertain, however, we can foresee an intensive use of algorithms.

Algorithms are amongst the words that we hear the most nowadays, but how can they be related to protecting copyrights? That can be a very simple question at first, but maybe it is not as simple as it may look.

YouTube has been using a mechanism to control copyright called Content ID since 2007, which allows copyright owners to easily identify content that matches their work on YouTube. So, if I post a video with a copyrighted song and do not disclaim that, the Content ID algorithm will analyze my video and report to the owner of that song, and then they can choose what to do, whether blocking my video or ignoring it.



However, this has some flaws. The first is that only a few users can actually benefit from this mechanism, more specifically the users who “own exclusive rights to a substantial body of original material that is frequently uploaded by the YouTube creator community”. So, if I am a new musician uploading my songs to YouTube, it will take me a while to be able to use Content ID.

Another imperfection in this system (and that is likely to be common to other algorithms) is that these systems find it very difficult to recognize humor, such as parody videos. Even though you can ask Siri to tell you a joke, it will struggle to understand a joke you tell it, because humor is a very humane trait. When a user uploads a parody video on YouTube, it can still be target by Content ID, which would go against copyright exemptions and limitations that allow it to be uploaded in the first place.

Another example of the use of algorithms to detect copyrights infringements is in scientific papers. It is very common for teachers (especially in Universities) to submit their student’s papers and articles in computer programs that identify if there was any instance of plagiarism.

On the opposite end, we are also starting to see algorithms being used to avoid copyright infringement. Recently, two colleagues created an algorithm that recorded every possible 8-note, 12-beat melody combo, and claimed to have created every possible melody and then made them available to the public in an attempt to end copyright litigation in music.

In conclusion, can algorithms be used to protect copyrights?

The use of algorithms is becoming more and more of a reality, and, with the implementation of the Directive 2019/790, it can be a solution for platforms to avoid being held accountable for copyrights infringement. However, as stated, there

“ Even though you can ask Siri to tell you a joke, it will struggle to understand a joke you tell it, because humor is a very humane trait. ”

are still some shortcomings with algorithms used nowadays that can be crucial. It seems that there is a movement that attempts to making copyrights something mathematical that can be analyzed through numbers, which may not be an accurate understanding of the complexity of copyright and human creativity.

It is yet too early to know how article 17 will be applied and how it will work in practice, and if these algorithms will be a viable solution for every online platform, but, given the Technological Era that we are living in, it seems a reasonable solution that, nevertheless, still needs improvement, namely human oversight. There is still one year left for EU Member States to bring into force the laws that comply with the Directive, so even the solutions that each Country will adopt can be different. We must wait and see. |

The implementation of the Beijing Audiovisual Performances Treaty in Nigeria

Angela Adebayo

Africa

Nigeria



The Beijing Treaty on Audiovisual Performances is a multilateral treaty which regulates copyright related rights for audiovisual performances and expands the performers' rights. It was adopted on 26 June 2012 by the Diplomatic Conference on the Protection of Audiovisual Performances of the World Intellectual Property Organization, in which 156 WIPO member states, six intergovernmental, and six non-governmental organizations participated. Forty-eight countries signed the treaty on 26 June, followed by 19 other countries in 2012 and 2013. The treaty was signed by 74 states and will enter into force on 28 April 2020 follow the receipt of the 30th ratification.

The treaty has been praised by artists' and performers rights advocates around the world as well as some activist nonprofits such as Knowledge Ecology International, but has also been criticized by some digital rights and free culture activists such as the Electronic Frontier Foundation (EFF) as an infringement on free speech, and aiding censorship schemes.

On October 4th, 2017, Nigeria ratified the WIPO Copyright Treaty (WCT) and WIPO Performances and Phonograms Treaty (WPPT) of 1996. The country also ratified the WIPO Beijing Treaty for Protection of Audiovisual Performances of 2012 (BTAP); and the Marrakesh Treaty for the Blind and Visually Impaired Persons of 2013 (Marrakesh treaty). Nigeria now joins other countries that have ratified these treaties. Thus it has undertaken to respect and implement its obligations under the treaties. However, by s. 12 of the 1999 Constitution (as amended), the treaties are not in force in Nigeria unless and until

domesticated. The Constitution extends the powers of the National Assembly outside the Exclusive Legislative List for the purpose of domestication of treaties. In this case, such a bill shall not be presented to the President for assent and has to be ratified by at least a majority of all the Houses of Assembly in Nigeria before it is enacted. This is one instance where the assent of the President is not required before a bill is enacted into law in Nigeria.

The consequence of failing to get ratification of a treaty by a majority of the various State Houses of Assembly in Nigeria where a matter to be legislated upon falls outside the purview of the Exclusive Legislative List, is that such Law enacted by the National Assembly will be made to govern only the Federal Capital Territory, Abuja. Statutes of Treaties Domesticated in Nigeria have the same force of law as our Nigerian statutes. So, their provisions are interpreted in the same way our statutes enacted in Nigeria are interpreted. Nigeria has given herself actively to participating and signing of international treaties as it applies to the nation, but lesser attention is given to domestication of such treaties signed by the country, even after many years of such international agreements.

It is not enough to domesticate international treaties ordinarily, but there is the need to sensitize legal practitioners to the laws, as well as to provide the people with informed knowledge of what the laws constitute. Every level of government – from a local to state and federal government – is responsible for seeking enforcement of those obligations for the progress of the nation. Civil society

should also join such advocacy, in their circles of influence, to push not only for domestication of international treaties but the sensitization of the masses to know what is in it for them. According to the Nigerian Copyright Commission (NCC), with the ratification of the treaties, "Nigeria is about to witness a new era in its intellectual property (IP) protection policy and legislation. The development again underscores the urgent need to enact a new Copyright legislation that will implement the standards stipulated in the treaties". But as we celebrate the ratification of the treaties, there is a great need to ponder on the effect of their domestication in Nigeria: what impact will the standards in the treaties have on creativity, innovation and access to information for educational purposes in Nigeria?

Put broadly, what effect will they have on the knowledge economy and the overall development in Nigeria? This question is important considering that Nigeria is a developing nation facing challenges of access to information for educational purposes, as shown by the 2014 report of the IOM on needs assessment in the Nigerian education sector. An open and more flexible IP regime would best suit the developmental needs of a developing country like Nigeria. Nigeria has a booming creative industry. But given that strong IP regimes create unnecessary hurdles to market entry in the creative industry, lawmakers would have to be wary in adopting their provisions unquestionably, however their ratification and the planned domestication may be regarded, in principle, as laudable.

It has been rightly stated that performers' rights provide a very similar form of protection to the rights granted to authors by copyright. Nevertheless, there are a few notable differences between the rights enjoyed by authors and those granted to performers. First, the duration of these rights differ, with copyright typically lasting longer than performers' rights. Second, performers' rights only protect the recording of a performance; they do not

protect the actual performance itself in the way that copyright protects against copying the actual work. For example, it is perfectly lawful to copy or imitate another performing artist's style, demeanor or mannerisms: these aspects of their performance are not protected. Lastly, and perhaps most surprisingly, performers do not have right to object to false attribution, which is an important moral right enjoyed by authors.

Finally, it is worth noting that the same artist may enjoy both copyright and performers' rights in his or her contribution to a creative work. For example, consider an actor who directs and/or produces his or her own film, or a singer-songwriter who writes, composes and records her own music. As a songwriter, the musician will enjoy copyright in the songs that he/she writes. And, when he/she records her song, she will enjoy performers' rights in the recorded performance. It is essential to human creativity to give creator's incentives in the form of recognition and fair economic rewards. As a result of this recognition and fair economic reward, the enjoyment of culture, knowledge and entertainment is enhanced. Performers have rights almost equivalent to those of authors and copyright owners conferred on them by the Act.

It is important for lawmakers to be mindful of the gap existing between Nigeria and other developed countries, especially in the area of access to information for educational purposes. This gap may be filled if unnecessary barriers to access to information in the digital environment are removed. In addition, lawmakers should be concerned about not creating unnecessary rent in favor of developed countries' rights holders to the detriment of Nigerians. They should strive to tailor this Beijing Treaty on audiovisual Performances to promote access to educational materials, while ensuring that local creators benefit from their creative efforts, after all the essence of copyright is about creating a fair balance between the interest of rights owners and those of the public in the promotion of social welfare. |

IP RELATED

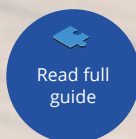


Let's talk about **Brexit**

Intellectual Property Rights and Brexit - Practical Guide to Exit

What happens with your Intellectual Property assets filed and registered through EUIPO in 2021?

Read Júlia Alves Coutinho and Inês Tavares's full guide regarding the impact that Brexit will have on industrial property assets registered or requested at European Institutes.



A fond farewell to Fernando dos Santos – Bemanya Twebaze elected new director general of ARIPO

Vítor Palmela Fidalgo

Africa

ARIPO



The Africa Regional Intellectual Property Office (ARIPO) has announced the appointment of new director general Bemanya Twebaze. The announcement was made during the 44th and last administrative council session, which was held in Zimbabwe between 16 and 20 November.

Twebaze was previously the CEO of the Uganda Registration Services Bureau. He is due to take office on 1 January 2021 for a four-year term and replaces Fernando dos Santos, who served ARIPO for eight consecutive years.

Overall, the impact of dos Santos's term has been extremely positive. Under his leadership, ARIPO has grown, become more professional, launched various education programmes and helped many African countries in their IP development strategies. In particular, he welcomed Sao Tome and Principe and Mauritius as ARIPO member states and promoted the adoption of the Swakopmund and Arusha Protocols, as well as accessions to 11 existing ARIPO protocols.

In terms of education, besides establishing new ARIPO administrative council sub-committees and forming the working group on the improvement of the ARIPO Industrial Property Protocols, dos Santos set up multiple workshops, seminars and master's degrees, including the launch of a philosophy degree in intellectual property at the University of Science and Technology in Kumasi, Ghana and a master's in intellectual property at the University of Dar es Salam, Tanzania.

“ Under his leadership, ARIPO has grown, become more professional, launched various education programmes and helped many African countries in their IP development strategies. ”

These achievements have made him one of the most influential people in the IP world. Further, stakeholders in the IP realm have highlighted his professionalism and generosity.

Dos Santos' work has facilitated and improved daily IP work in Africa. It is therefore no surprise that on 20 November he received a recognition award from ARIPO and its member states for everything that he has done for intellectual property on the continent. Many will wish dos Santos all the best and look forward to ARIPO's continued success – hopeful for what Twebaze will bring. |

Amendments to OAPI system will shake up the entire registration process

Joana Teixeira

Africa

OAPI



The African Organisation for Intellectual Property (OAPI) IP system is ruled by the Bangui Agreement, which was amended in 2019. This has resulted in changes to the IP system for French-speaking countries in Africa. The main alterations are to the prosecution and litigation procedures with regard to trademarks, patents and administration.

The amendments will come into force after it has been ratified by at least 12 OAPI member states. Last year, seven out of 12 countries ratified these changes. At the time of writing, it is believed that this number had risen to 11 – the 12th country to approve would be Cameroon. After the 12th member state ratifies the proposal, the new system will come into effect, although it is likely that trademark-related provisions will come into force in 2021 and patent-related ones in 2022.

Changes include the introduction of substantive examination, which will require the allocation of more resources. Following this, there will be an appeal period of two months against rejections and alternative dispute resolution methods will be available (eg, mediation and arbitration). There will be significant improvement of anti-counterfeiting sanctions, enforcement and border measures. The new amendment will get rid of the current process, in which an IP owner must obtain a non-cancellation certification before proceeding with a seizure of counterfeit goods.

Other new provisions include changes to deferral fees and the continuation of the digitisation of various systems, including online filing. There is now confirmation

that the member states' civil courts have the right to rule on the validity and ownership of all IP rights. The laws surrounding trademarks have seen the most significant changes. There is an extension of the definition of a 'trademark' to include non-traditional marks, such as sound, audiovisual, series and certification marks. There will be a provision for international registration for goods and services to be included in a single application, and publication after filing for third-party opposition. A five-year prescription term will also be implemented, along with substantive examination on absolute grounds, which will include deceptiveness as to origin and genericity.

Further, there will now be claim of ownership. If a party has prior use of a mark, it may claim ownership within three months of the publication date in case the other applicant should have known or should have known about prior rights. Also, it will now be possible for Customs to detain suspected counterfeit goods by request of the trademark owner, who will have 10 days (three, in the case of perishable goods) to file for a civil or criminal procedure. With regard to **patent law**, the main change is the introduction of substantive examination and that patent applications will be published for opposition in a three-month period. There will also be extended protection for geographical indications to include agricultural, natural and artisanal products.

Comment

After a three-year discussion period, OAPI has decided to amend the agreement so as to improve the quality of its operation procedures. Nevertheless, there is still a waiting period, first before it is approved by the member states, and then until the provisions come to force, which should take place in either 2021 or 2022. |

A guide to OAPI: what you need to know

Inês Tavares

Africa

OAPI



The African Intellectual Property Organisation (OAPI) handles trademark registrations for the following – mainly franco-phone – member states: Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, the Comoro Islands, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

Unlike the African Regional Intellectual Property Organisation, OAPI member states do not have national offices. Therefore, registration is only possible through the regional system and applicants cannot designate specific countries.

OAPI was created in March 1977 by the Bangui Agreement with the main goal of encouraging member states to collaborate, build networks and share common resources. It acceded to the Madrid Protocol in March 2015 and is a member of the Paris Convention.

OAPI accepts trademark applications for products, services and collective trademarks, as well as protecting well-known marks in the region. To file an application, applicants must provide:

- their full name and address;
- a sample of the mark (if it is a device mark);
- a list of goods and/or services in accordance with the Nice Classification (11th edition);
- a certified copy of the priority document with a certified French or English translation; and
- a signature of power of attorney.

Further, colour marks can be claimed at OAPI upon payment of the prescribed fee.

OAPI is a multi-class jurisdiction and applications can include up to three classes of products or services. However, it is important to note that it is not possible to file applications for products and services together. For instance, if an applicant intends to file one mark in Classes 1, 4 and 35, it must file two separate applications – one for Classes 1 and 4 and another for Class 35. The official filing receipt and application filing number is issued roughly two weeks to one month later.

Unlike other African jurisdictions, OAPI will perform an examination only with regard to the formal aspects of the application, not its substance. Upon conclusion of the examination process, OAPI will issue a registration certificate containing the registration number. In this regard, OAPI's procedure is unique, as the registration certificate is issued before the trademark is published. This means that the provisional effect, and therefore the trademark, can still be challenged.

When the trademark is published, third parties who considered themselves adversely affected with the registration of the trademark have a period of six months to file oppositions.

Opposition proceedings are launched at OAPI by filing a notice that provides detailed grounds on which the opposition is based.

(...)



Counterfeiting of Drugs in Africa: current situation, causes and countermeasures

Inês Tavares

Africa



Counterfeit is a world spread phenomenon in which the product of someone, company or individual, is imitated to reproduce the original, although often made with materials and components of reduced quality and illegally bearing a trademark or a copyright of another without their permission.

We live in a world of frenetic consumerism, where people are more often judged based on what they own rather than what they are. Having a specific product from a specific brand can provide the sensation of having a certain status or making a statement to other, however brand goods can be expensive and unreachable to many and that is where counterfeit plays a strategic role.

As counterfeit goods cost a fraction of the price of the original goods, people who under normal circumstances would not have access to those products can afford them.

Counterfeit products are everywhere nowadays, filling the markets with twin scourges, often very similar, or even fairly identical to the originals, with certainly lower quality but much cheaper, which makes them very understandably more attractive for consumers that have no means to purchase the real deal – the first generation goods.

Recently, whilst attending one workshop on Anti-Counterfeiting, the panellist told the audience something that caught in my mind: *if you want to know if a specific product, from a specific brand is trending at the*

“ (...) if you want to know if a specific product, from a specific brand is trending at the moment, just take a look at its presence and demand in illegal markets. ”

moment, just take a look at its presence and demand in illegal markets. The more desirable a product is the higher the tendency to replicate it and meet that parcel of consumers that want to join the trend but cannot pay the price.

Very frequently we observe that the percentage of consumers that are unable to buy an item (but would if that product was within their price point) is larger than the percentage of consumers that can afford the first generation good, especially when we talk about high end goods, luxury goods. Profit is one of the many reasons that make counterfeit an attractive business for many.

In 2017, a report from Frontier Economics - based on a previous report of 2016 by OECD -prepared for BASCAP and INTA and later disclosed by the International Chamber of Commerce (ICC) estimated that in 2022 the total international trade in counterfeit and pirated goods will be as high as 991 Billion, almost doubling the number reported in 2013 of 461 Billion.

The astonishing numbers affect economic activity, taxes revenue, investment and employment worldwide. The report projected that counterfeiting activity will put at risk between 4.2 and 5.4 million legitimate jobs. Annually, is estimated that the

counterfeit drug market alone is worth around 200 billion US Dollars worldwide, making it the most profitable trade of illegally copied and sold goods.

Africa, unfortunately but not surprisingly, is one of the most affected continents, comprehensible since its markets have become a huge target for second generation goods, with a major focus on pharmaceutical drugs.

The World Health Organization (hereinafter, WHO) stated that 42% of all fake medicine reported to them between the years of 2013 and 2017 was linked to the African continent and we expect that these numbers fall short from accuracy since the report system to the WHO relies on national or regional regulatory authorities which means the data is only as good as the national reporting systems are, which probably means the situation is far worse than the one reported.

Counterfeiting is a crime and, I highlight, not a victimless one, apart from negatively affecting markets and economy, as well as people's jobs, counterfeiting is dangerous and it supports child labour and organized crime. Especially when we look at counterfeit of pharmaceutical goods there is an actual threat to the consumers' health, wellbeing and, in a severe but not uncommon number of cases, to their lives.

Africa is seriously affected by it and one clear example is the anti-malarial medication. Anti-malarial and antibiotics are amongst the most commonly reported as fake or substandard medical products. Worldwide, more than half a million people will die each year as consequence of being infected with malaria, being that children, namely in the Sub-Saharan Africa, are especially affected by the disease with a higher risk of contracting and dying from it. In 2013 an alarming 73% of the analysed medication for malaria

in Nigeria was substandard, according to the United Nations. It is estimated that substandard and fake anti-malarial drugs could be causing over 150 thousand extra deaths from this disease in the Sub-Saharan Africa. Another study, in 2015, has estimated that more than 122 thousand children under the age of five die each year due to substandard anti-malarial drugs in the Sub-Saharan Africa. Around 45 million counterfeit anti-malarial drugs valued at more than 430 Million US Dollars were sold in West Africa in 2008. But even fairly normal medication can be very dangerous.

Drugs found during raids usually include cough syrup, anti-parasitic, anti-malarial, antibiotics and contraceptives. For instance, in February 2009, the Health Minister of Nigeria reported 84 baby's deaths after taking a Teething Mixture called "My Pikin Baby", which was intended to relieve pain for the growing infant teeth. It was later found that the concussion contained diethylene glycol, an industrial solvent and an antifreeze and brake fluid which were added to taint the mixture.

Another case happened in Niger, where it was discovered during vaccination campaigns in 2015 and 2017 that vials contained water, in consequence hundreds of people died. Last year, in 2019, the government sounded the alarm for it was discovered that new fake vaccines were being sold at a local pharmacy following a meningitis outbreak in the country.

(...)



Covid-19 prompts applicant - friendly requirements in Cape Verde

Diana Pereira

Africa

Cape Verde



Even though Cape Verde has only a slight presence in international and regional treaties and conventions – it only became a signatory to the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property in 2008 – its Patent and Trademark Office (PTO) has always shown proof of a particular feature: its rigorousness with the formal requirements for filing industrial property rights, specifically supporting documentation.

The formal requirements for a trademark application in Cape Verde when the applicant is a company are as follows:

- an original and notarised power of attorney (plus Portuguese translation);
- a copy of the certificate of incorporation (plus Portuguese translation), which must prove that the activity carried out is related to trademark goods or services; and
- when claiming priority, an original or certified copy of the priority document (plus Portuguese translation).

When the applicant is an individual, the formal requirements are as follows:

- an original and notarised power of attorney (plus Portuguese translation);
- a copy of an identity card (plus Portuguese translation);
- a copy of the fiscal identification number (plus Portuguese translation); and
- when claiming priority, an original or certified copy of the priority document (plus Portuguese translation).

Besides these referred documents, applicants must complete and submit between three and four different forms, which repeat the same exact data – thus adding to the applicant's burden.

So far, the PTO's practice has been to require the submission of all the supporting documents at the moment of the filing, including the notary public certification. Late submission of documents is not accepted – formal examination is conducted at the time of filing, frequently resulting in a delay to the filing date.

However, there are some discrepancies between the PTO's practice and what is set out in the IP Law. For instance, with regards to the priority document, Article 231 indicates that the PTO in fact has two months after notification to file an authenticated copy of this document; additionally, even though, in practice, the PTO behaves inflexibly with regard to the late submission of documents, Article 323 of the law provides that if some discrepancies are detected after the formal examination, applicants will be notified and given the opportunity to respond within the timeframe settled in the notification (the law does not specify any deadline).

The most significant difference lies in the fact that the PTO allows registrants to file only one original and notarised power of attorney, regardless of the number of trademark applications to be filed. The easing of this requirement is mostly welcome, since it reduces the costs for the certification of documents.

In addition, the covid-19 pandemic is prompting new changes. As a result of the physical obstacles created by lockdown, the PTO introduced some temporary measures to ease the filing process, namely:

- allowing the submission of soft copies of the documents with no need of certification; and
- permitting all original and certified documents to be certified late.

Such measures are still in place at the time of writing and are running smoothly – a good rehearsal for a more modern way of filing.

As per the PTO's feedback, there is an intention to move to a more modern system of filing and to keep pace with other African jurisdictions using such systems (eg, South Africa, Nigeria and the African Regional Intellectual Property Organisation), which could allow applicants to file applications online and technicians to perform a better and faster examination. In fact, the Cape Verdean PTO is developing a section for online services on its website, which may be the first seed for this modernisation.

Given the efforts being made in this area, it seems only a matter of time before digital filing arrives at Cape Verde. |

Is covid-19 a force majeure for trademark use in Angola?

Miguel Bibe

Africa

Angola



In March [2020], the Angolan government declared a state of emergency due to the outbreak of covid-19, enforcing mandatory lockdowns and the closure of all establishments trading non-essential goods and services. This lasted approximately one month, and since then the subject of the mandatory use of trademarks has frequently arisen.

The exception provided in Article 39(d) of the Angolan IP Law – which determines that trademark registration may expire due to non-use for a period exceeding two years, except in the case of a duly justified force majeure – was applicable during the state of emergency. Fortunately, the country's state of emergency was a justified reason for force majeure. However, as the state of emergency has now been lifted and economic activity has largely resumed, the question arises as to whether covid-19 is still a justified reason for non-use. Since the relevant legislation refers to the force majeure generally, rather than defining concrete grounds for applying this exception of Article 39 (d), the application of this rule must be examined on a case-by-case basis.

There are arguments for and against the covid-19 pandemic as valid grounds for non-use. On the one hand, the arguments in favour are related to public health, in that entities should not trade or advertise goods or services under a trademark in order to prevent the spread of the virus. On the other hand, there is no justified reason to not use a trademark since there is no legal impediment to trade goods or services under a trademark and, in this regard, the non-use of the trademark may weaken it.

There are other covid-19-related occurrences that may have an impact on a trademark's non-use in Angola. For example, the cancellation of international flights and the closure of borders could be a valid argument for entities that exclusively provide tourist services to suspend activities and the use of their marks until restrictions on entry into the country are lifted. However, this exception may not be extended to other areas that depend on customers visiting the country for professional or leisure purposes (eg, restaurants and retail stores).

Further, it is uncertain whether the impending global financial crisis constitutes a force majeure exception for the non-use of trademarks. Again, there are valid arguments for both positions; the unsustainability of maintaining the use of a trademark will result in financial losses for its owner (with a plan to use the mark in the future), but there is also the economic initiative of a third party that intends to exploit a trademark that is not being used by its owner, which has no prospect of exploiting it in the territory.

Overall, in the absence of concrete legal provisions, it is crucial to examine the arguments and evidence on a case-by-case basis in order to determine whether there is a valid reason for the non-use of a trademark in Angola. |

African database searches uncover small rise in corona or covid-related marks

Diogo Antunes

Africa



It is common to see a peak in trademark applications that contain terms associated with a recent event and the covid-19 outbreak is no exception. This article reveals the number of trademarks that have been applied for containing the term 'corona' or 'covid' in the following African organisations, countries and regions: the African Intellectual Property Organisation, the African Regional Intellectual Property Organization, Algeria, Angola, Botswana, Cape Verde, Djibouti, Egypt, Eswatini, Ethiopia, Gambia, Ghana, Kenya, Lesotho, Liberia, Libya, Madagascar, Malawi, Mauritius, Morocco, Mozambique, Namibia, Nigeria, Rwanda, Sao Tome and Principe, Seychelles, Sierra Leone, South Africa, Sudan, Tanzania, Tunisia, Uganda, Zambia and Zimbabwe. However, it is worth noting that the databases of some of these countries are incomplete and/or have not been updated.

By searching the term 'corona' in the aforementioned databases, the authors uncovered two trademark applications filed since 1 November 2019: a Moroccan trademark in Class 32 in the name of Cervecería Modelo de México, owner of the famous Corona beer, and another Moroccan mark for products in Class 25 in the name of Mohamed Bouchghoul.

A further two results appear when searching 'covid': the Moroccan trademark COVID-BOUCLIER (translated as COVID-SHIELD) to indicate products in Classes 9 and 10 (namely, masks and filters), applied for on behalf of FILAHYMOD, and the Zambian trademark KICK OUT COVID-19 PROJECT for products

in Class 16 in the name of Sport in Action. Therefore, overall, there has been no rush to obtain corona or covid-related trademark registrations in these countries. This becomes more apparent when compared to EU filing numbers. There were 34 EU trademarks with the term 'corona' applied for in the same period. If country-specific trademarks are included, this number rises to 254 marks. With regard to the term 'covid', there were 33 EU trademark applications, which similarly increases to 258 when including country-specific marks.

In view of the present study, there is a clear difference between the filing numbers in African jurisdictions and those of EU countries. Despite the potential gaps in some African countries' databases, it is safe to say that the rising trend of trademark applications containing the terms 'covid' and 'corona' has not been seen in the African countries considered.

However, given these gaps and the delays caused by office closures, more trademark applications using these terms may appear in future IP bulletins. |

Pause for thought - Misconceptions of IP in Africa

Inês Monteiro Alves & Daniel Reis Nobre

Africa

Intellectual Property Magazine
Business Intelligence | Informa

While businesses are exposed to significant challenges in Africa, Daniel Reis Nobre and Inês Monteiro Alves untangle IP misconceptions surrounding the continent.

There are multiple misconceptions about different topics in Africa and IP is no exception, naturally. The answer is always education, of course. Lack of information and knowledge can easily lead to false understandings and misconceptions of any kind.

IP in Africa can be confusing to some people and businesses, especially for companies and IP owners that are mainly used to protecting and enforcing their intellectual assets in other regions of the world and have limited or no experience at all within the African continent. We highlight the below misconceptions that are common to our clients:

Costly

Most people have the wrong idea that protecting IP in Africa means dozens of filings in multiple countries and jurisdictions and that each filing would be very expensive. In the end it's not that different from other regions in the world and Africa has the advantage of having two regional agreements (the African Regional Intellectual Property Organization (ARIPO) and the Organisation Africaine de la Propriété Intellectuelle (OAPI)) that cover a big part of the continent, making it easier and cost effective when IP owners consider a regional protection.

Too many languages

Many clients think that they would need translations in multiple languages when it comes to filing a patent and even with

supporting documents or lists of goods and services for trademark applications, etc. English, French, Arabic and Portuguese are the four main working languages needed and used for translations to cover all the continent. If you compare it with Europe, for example, imagine the amount of translations you would need to file a regional patent compared to Africa!

Too many documents

Apart from translations, most people also have a common misconception regarding documents that would need to be legalised to support trademark or patent applications in Africa. In most countries we only need a power of attorney (POA), others require it only to be notarised. Just a few countries in Africa such as Ethiopia, Angola or Egypt still require legalisation of POAs or corporate documents in their countries of origin to support applications of foreign filers.

Not worth it

One question we hear all the time – is it worth it to file in Africa? Many companies still don't trust the African IP systems work and rely on some bad experiences they had or heard about in the past. Things have changed a lot in recent years and many IP offices and local authorities have learned and evolved over time. Also, IP law firms have grown and gained expertise in the region as well, providing clients with a better service, compared to what you can find in other regions of the world. The World Intellectual Property Organization (WIPO), European Patent Office, European Union Intellectual Property Office, national IP offices in Europe and other regions have been collaborating with regional and national IP offices in Africa. This is very important, and we must ack-

knowledge that the training and experiences exchanged over the last two decades have been a strong push towards harmonisation and improvement of African IP systems.

Not enforceable

Enforcement in Africa is a main concern for many companies when doing business or exporting goods to the continent. The local laws have changed, and bigger risks arise to the ones infringing third parties' IP. There was a time that we couldn't find who was behind a bad faith action, or an address where we couldn't even send a cease-and-desist letter to an infringer, in many territories. This has changed a lot and it's much easier nowadays to identify and notify infringers.

The customs and economic police departments in the African region have nowadays much better training and experience working with counterfeits too. The internet has also helped a lot in this field, providing more information exchange between authorities, within the countries and crossing borders too. The World Customs Organization and several customs departments from countries in different regions of the world have been collaborating with African authorities and every year this is improving too.

IP landscape

Africa is usually the region of the world with less business investment in general and IP protection, as a main driver for that investment is also limited when compared to other regions. There are many reasons, mainly related to local and regional economic factors, that do not attract as many foreign investors as in other areas of the world.

However, what we see is continuous growing investment every year, in multiple countries and business sectors, at their own pace. There is also a significant change in origin of that investment, with a

big part of that coming now from Asia (and China in particular). Africa used to have much more European and US products and brands in the local markets and in recent years, much of that has been replaced by products from Asia.

Additionally, African IP offices have been receiving more filings from Asian applicants over the last decade than it used to be. We also see more enforcement cases involving Asian companies, something that wasn't common a few years ago.

Areas requiring reforms

There are significant challenges in Africa regarding IP protection and enforcement that governments should focus on. For example:

- Electronic services: many IP offices in Africa still do a lot of paperwork and there is a need for digitisation;
- Staff: IP offices in Africa need more people doing the daily work, that is something governments should definitely invest in;
- Hardware/software: better equipment, tools and databases, along with the necessary training, is missing in some IP departments throughout Africa;
- Specialised IP courts: many countries and jurisdictions still do not have IP courts or judges with experience on IP related matters;
- Laws and regulations: some countries still need to update to a better version of their IP laws in place; and
- Better connection between authorities: local customs and economic police departments should have a better connection with IP offices to better fight counterfeits in Africa.

These are just a few examples of some investments the governments in Africa

should focus on, in general. In the end, the more Africa promotes and invests in its IP systems, the more foreign companies will trust and redirect foreign investment to it.

What the wider world could learn from African IP

Generally speaking, people are more informed about other regions in the world than Africa: either about economy, laws and agreements in place, tourism, what people buy, how many languages they speak, etc. In the end, it's not about IP only, it's information about Africa in general.

For example, people have no idea how big Africa is or know how many countries comprise the continent and its surrounding islands.

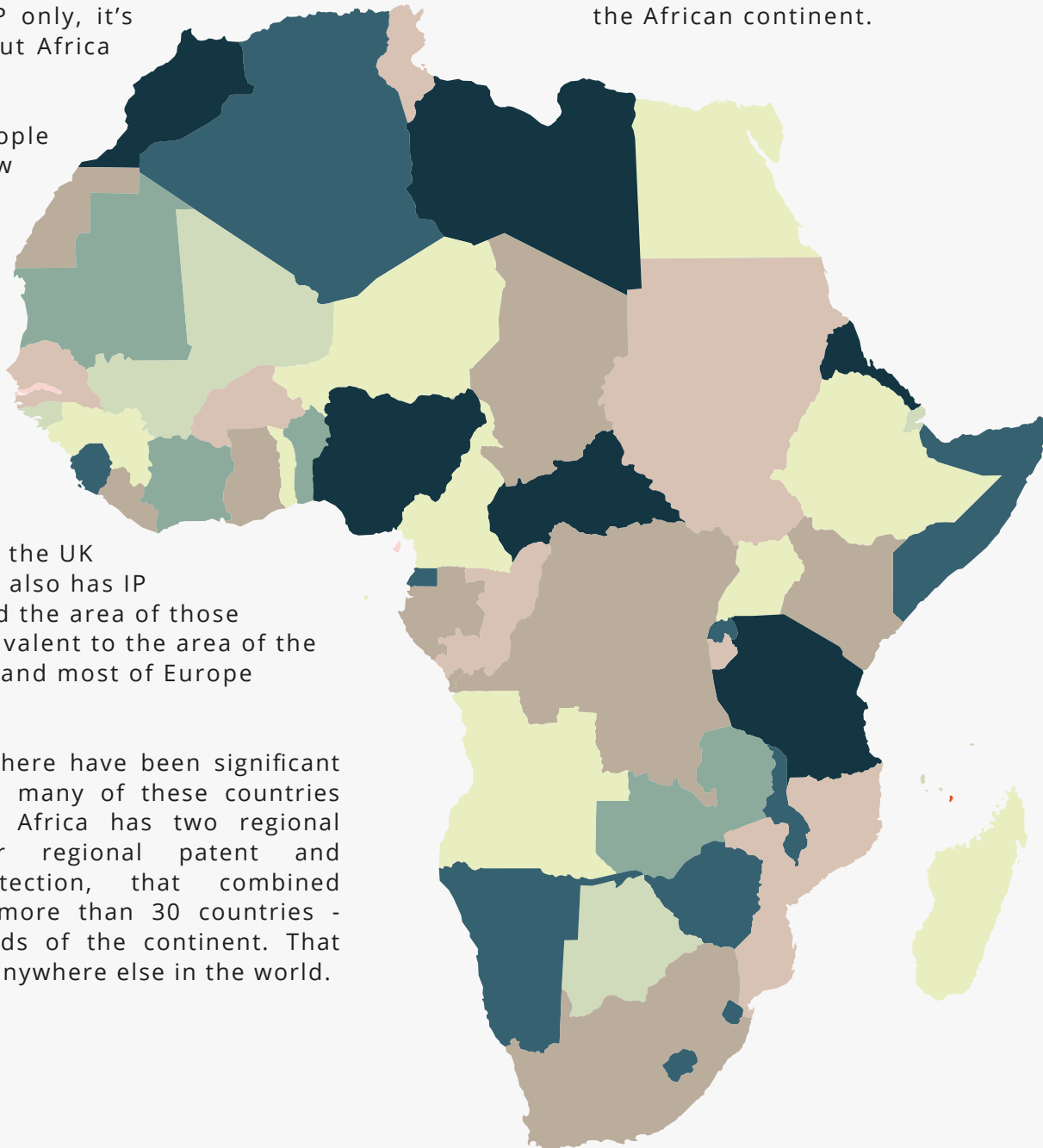
Africa holds 59 countries (although four of them are still dependencies of the UK or France, which also has IP implications) and the area of those countries is equivalent to the area of the US, China, India and most of Europe combined.

In terms of IP, there have been significant developments in many of these countries every year and Africa has two regional agreements for regional patent and trademark protection, that combined together cover more than 30 countries - around two thirds of the continent. That doesn't happen anywhere else in the world.

Traditional knowledge Indigenous

IP is integrated in traditional knowledge (TK), which is, in accordance to WIPO, "a living body of knowledge passed on from generation to generation within a community".

TK may be found in several contexts, including agriculture, science or even medicine and there are several examples of traditional knowledge in Africa. The protection of TK as an autonomous IP right is only now becoming a reality around the globe and particularly in the African continent.



Innovations based on TK benefit from the protection of patent, trademark and geographical indication. It may also be protected as a trade secret or confidential information, however, TK as such is not protected by any system of IP. This is the so-called defensive protection of TK.

The positive protection of TK is, however, currently on the table and negotiations on an international legal instrument for the protection of traditional knowledge are taking place within WIPO, particularly in the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, in order to address the subject.

Despite this, there are some good example, in Africa, where countries are putting an effort to protect TK and where there is obviously the need to protect the countries' inheritance. South Africa and ARIPO can be given as an example of this, as these are at the forefront of TK protection.

On one hand, South Africa has amended the Intellectual Property Law, through Amendment Act No 28 of 2013, in order to provide for the recognition and protection of certain traditional and indigenous terms or expressions and therefore, the protection of the same is since then expressly determined under the law.

The recognition of the traditional knowledge as cultural resource, in accordance to the preamble of the Amendment Act, "will benefit the country and will ensure that fair financial benefits will be received by indigenous communities".

On the other hand, ARIPO also addressed the positive protection of traditional knowledge by way of creating a sui generis indigenous protection.

The Swakopmund Protocol on the Protection of Traditional Knowledge and

" (...) Generally speaking, people are more informed about other regions in the world than Africa (...) In the end, it's not about IP only, it's information about Africa in general."

Expressions of Folklore within the Framework of the ARIPO was adopted by the Diplomatic Conference of ARIPO at Swakopmund (Namibia) on 9 August 2010 and amended on 6 December 2016. At this moment, the protocol counts with the following adherent states: Botswana, Gambia, Liberia, Malawi, Namibia, Rwanda, Zambia and Zimbabwe.

Despite the fact that both legal systems are fairly recent, there is no doubting the importance of TK to the development of a country and therefore, African countries should be praised for the boldness in which they are endeavouring to protect their TK. |

The importance of brand protection in Kenya

Joana Teixeira

Africa

Kenya



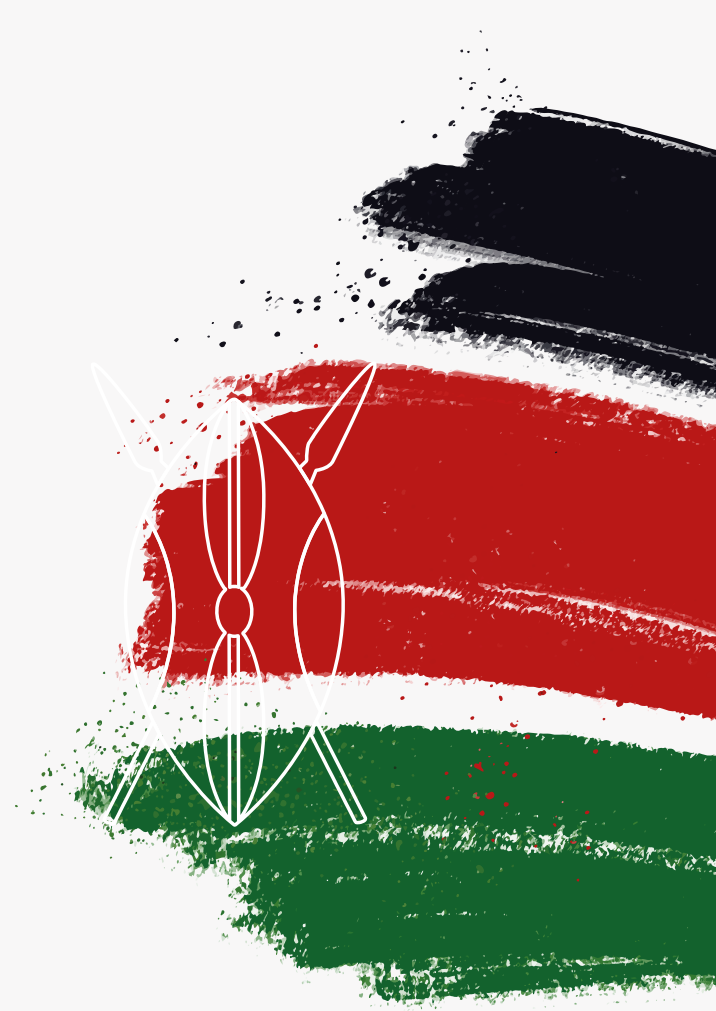
Protecting trademarks should be a priority when starting a new business. However, many entrepreneurs do not consider this, which can lead to unpleasant consequences.

While some companies have great ideas and promising products, these can be reduced to nothing if they are not well protected and monitored. Besides providing legal security and the exclusive use of the brand, securing protection also helps to grow the business and increase its client base. Further, close monitoring makes it easier to find and deal with infringement, (eg, counterfeit products), which is a constant threat in Kenya.

In a survey conducted between October 2019 and February 2020, the Anti-counterfeit Authority (ACA) found that counterfeiting in the building, mining and construction sectors have cost the country more than \$100 million in revenue. After these industries, the energy, electrical and electronics were the other sectors most affected by counterfeiting.

Kenya has passed a new Intellectual Property Bill, with the aim of merging the Kenyan Industrial Property Office (KIPI), the Kenyan Copyright Board (KECOBO) and the ACA in order to establish the Intellectual Property Office of Kenya and consolidate its IP laws with regard to counterfeit products.

In 2016 Kenya had one of the biggest counterfeit product markets in East Africa and, due to its borders with Somalia, Uganda and Tanzania, its proximity to the ocean and to Asia, it was considered a key distribution point for fakes, with many



goods coming from India and China. The Kenya Association of Manufacturers (KAM) estimates that around 40% of the market is lost to counterfeiting. Further, the ACA estimates that one in five goods sold in Kenya are counterfeit – those poses not only a huge risk to the country's economy, but also to the safety and health of the nation. The International Peace Institute report suggests that these markets are run by criminal networks, which may explain why it is so hard to shut them down.

Acting against counterfeiting manufacturers and distributors can be highly challenging.

In Kenya, when these groups know that they are being investigated, they quickly close before it is possible to gather any proof (and they reopen afterwards). Therefore, the best way to shut down these distributors is by gathering sufficient proof without them knowing that they are under investigation.

The amendments to the Intellectual Property Bill promise to make tackling counterfeits easier. However, it is uncertain how long it will take for the bill to bring meaningful change, since these changes are still very recent. Until then, there is the ACA. However, while counterfeit goods represent a danger to the country and to consumers, they affect the owners of the products in a different way. So, instead of waiting for authorities like the ACA to discover these goods, brands should take steps to actively protect themselves.

For example, as soon as a company sees a published trademark that is similar to its own, it should act promptly. While this is not the perfect solution for counterfeit goods, it can be a way to help dismantle these distributors faster and protect companies from losing clients and revenue. Because of this, Kenyan businesses are now more interested in finding ways to protect their consumers by stopping counterfeiting.

Comment

While counterfeit goods are still rife in Kenya, the country should be praised for creating the Intellectual Property Bill in order to consolidate its IP laws and assure more security for IP owners. However, brand protection is still crucial when creating a new business in order to have more legal security, while monitoring trademarks can be a way of quickly finding and taking down counterfeit distributors. |



São Tome and Principe – tips to manage trademark portfolios during covid-19

Diana Pereira

Africa

Sao Tome and Principe



Every financial year, applicants settle a budget for their trademark portfolio, which involves examining expenses for new applications and maintaining existing rights, prosecution, litigation, and disbursements, among other things. With the covid-19 pandemic, many rights holders are facing unprecedented financial difficulties, which makes them more conscious of costs.

This in turn is leading to a more considered analysis of assets that are deemed to be crucial and worth keeping.

Below are some tips to minimise trademark portfolio costs in São Tomé and Príncipe.

Redo the budget for the current year and the years to come

Although the trademark grant fee is paid when the application is filed, there can be extra expenses on top of this (eg, recording changes of name or address, assignments and licences of use, among other things).

It is therefore recommended to anticipate these extra costs when rethinking the trademark portfolio budget.

List the trademarks in the portfolio

Ascertaining the assets held is a crucial part of portfolio management. Make a detailed list of the marks in the portfolio in order to develop a strategy for the ones that are worth maintaining.

Analyse the portfolio and decide which rights are worth keeping

It is important to develop a strategy, which means knowing the countries that are important for the business and the marks that require protection based on this. Focus on strong marks (ie, logo, word or older logo) and eliminate redundant or outdated registrations and classes.

Prioritise trademarks with renewals falling in 2020

A trademark renewal extends protection by 10 years and is therefore a financial commitment that will have effects until 2030. However, the grace period for renewals may be used to the mark owner's advantage. In Sao Tome, the grace period to renew a mark is six months, which can be crucial since it gives applicants the opportunity to postpone renewal until 2021.

For instance, a trademark with renewal due in July 2020 can still be paid in January 2021 by means of a surcharge, which is 50% of the fee due. However, since it would be paid the following year, it is an option for reducing application costs in 2020 while keeping the registration in force.

(...)



The impact of covid-19 on IP rights prosecution in Cape Verde

Diana Pereira

Africa

Cape Verde



The majority of IP practitioners have had to adapt their routines to the current pandemic and create new working habits. This has meant remote working, which is running smoothly thanks to the availability of online tools and access to IP asset management platforms. Many IP offices have had to implement different practices, which has been challenging as some cases require immediate response. This article focuses on the obstacles raised by the covid-19 pandemic with regard to the administrative processes of IP rights in Cape Verde.

Cape Verde relies on an old-school model of filing, which demands in-person filing accompanied by original and/or notarised supporting documentation. These formalities quickly became an obstacle to filing, as it is extremely difficult (and sometimes impossible) for applicants to send land or air courier or certify documentation in the notary public.

On 18 March, the Cape Verde Patent and Trademark Office (PTO) closed its doors and issued a circular, which declared that there would be:

- a suspension of deadlines;
- an allowance of e-submission of new applications/other IP acts;
- an allowance of submission of soft copies of the supporting documents with no need of certification; and
- a settlement of a two-month deadline after the contingency period to submit all the original and duly certified documentation.

The PTO took swift action on some of the challenges created by the outbreak. However, its technicians, now working remotely, faced major obstacles. Work-flow slowed, which is possibly due to the fact that there was insufficient time to prepare remote working tools.

The technical teams performed their work without full access to their database and relied on available and existing tools in their households. The main areas affected were the issuance of filing receipts, which officially confirms the submission of IP acts at the PTO (postponed until its reopening), and the publication of the *IP Bulletin* (none have been published so far this year).

In short, tasks were not performed to full capacity due to the understandable limitations provoked by the sudden, but necessary internal alterations.

The PTO reopened its doors on 18 May and is making a great effort to handle ongoing processes and IP matters.

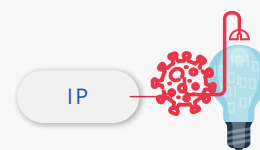
Comment

Even though there were some setbacks, the PTO has risen to the administrative challenges brought on by the coronavirus outbreak and the measures to reduce paperwork and the introduction of digital filing worked out smoothly. In the event the PTO desires to implement e-submission of IP acts, this will benefit IP practitioners and applicants in the future, since it will speed up the registration process and reduce the associated costs with forwarding original documentation. |

Intellectual Property, Covid-19 and African Countries: better forge your own path?

Vítor Palmela Fidalgo

Africa



On May 18 and 19, 2020, the 73rd Assembly of the World Health Organization (WHO) took place, which, considering the circumstances we find ourselves, was held for the first time virtually. This Assembly resulted in the long-awaited Resolution that aims to provide a global response to Covid-19. The Resolution was co-sponsored by more than 130 countries and adopted by consensus.

Amid other statements expressed in the Resolution, the paragraph 4 (page 3) is noteworthy: WHO calls the attention of Member States to the fact that shall be given priority to universal, timely and equitable access to all technology, including its necessary components, whose purpose is to respond to the current Covid-19 pandemic. In the last part of this point of the statement, WHO draws attention that this access to technology must respect “the provisions of relevant international treaties, including the provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and the flexibilities within the Doha Declaration on the TRIPS Agreement and Public Health”.

In interpreting what the Resolution refers to, I would say it highlights that **member states should make joint efforts to give universal access to technology to fight Covid-19 pandemic**. This access concerns both the vaccine itself and other necessary components. In the latter case, it can be given as an example of the lung ventilators or masks. In recent months, there has been a constant demand for

protection for intellectual property rights of various instruments to combat the pandemic.

In addition, we may say that this Resolution is directed mainly to African countries. In fact, the mention of the Doha Declaration in the Resolution leaves no room for doubt. This Declaration, of November 2001, which emerged from the 4th Ministerial Conference of the WTO, was born, to a great extent, due to the pressure from several countries of the so-called “African Group” led by Zimbabwe. The great step in this Declaration was that proclaimed in Paragraph 6, the recognition that countries with a weak or no pharmaceutical industry could benefit from the compulsory licensing system. This possibility led to an amendment to the TRIPS Agreement, which came to provide for partial derogation of Article 31 (f) and to allow compulsory licenses for the exportation of medicines to developing countries.

At this point, after one more Resolution, I wonder whether this will remain a dead-letter. So far, the news are not encouraging. African countries, even with money to invest, but lacking influence on the international stage, have been lagging behind in the race for various materials to combat the pandemic.

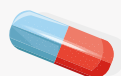
However, this time, the resilience of the African people seems to be coming to the fore. In various parts of the continent, there have been several cases of engineering students, from countries such as Nigeria, Kenya, Senegal or Ethiopia,

developing various instruments to combat the pandemic [1]: home lung ventilators, hand sanitizers or health care robots are some of the examples. Rapid Diagnostic Tests (RDT) have been a difficult problem to overcome, however, there is also good news here. The Pasteur Institute in Dakar, in partnership with a UK diagnostic testing manufacturer, is developing a specific type of RDT that is currently in the final testing phase. If approved, this test will allow you to have results in minutes and will cost less than 1 USD.

In short, despite the various declarations that have existed over the years to make the patent system more flexible, especially with respect to countries in dire need of public health, as with some African countries, the steps taken in this direction have been quite shy. The experience in the Canada-Rwanda [2] process was not exactly fruitful. However, the good news is that, in times of pandemic crisis, the resilience, inventiveness and proactivity of African countries resists this crisis. Although we have legal instruments that make the intellectual property system more flexible and protect public health, the creation of local knowledge will definitely be the best option to be taken. |

[1] See [example](#).

[2] See WTO news about [Canada-Rwanda process](#).



Mauritius: an African success story

Inês Sequeira

Africa

Mauritius



On 30 July 2019, the **Mauritius Parliament approved and passed the Industrial Property Bill 2019**, it was then published in the *Government Gazette* on 10 August 2019. The bill aims to update and strengthen protection for IP rights, as well as to harmonize the current legislation in order to meet the challenges of the globalized industry.

The Mauritian economy is ranked by the World Economic Forum as the most competitive in sub-Saharan Africa. The country has enjoyed average economic growth of 3% per year from 2015 to 2019, mainly driven by financial services, retail and wholesale trade, and information and communications (ICT) technology. The gross domestic product trended upwards, reaching an estimated \$10,200 in 2019 – the third highest in Africa after Equatorial Guinea and Seychelles, according to the African Development Bank Group.

The country has successfully made the transition from being dependent on one agricultural commodity (sugar) into economic diversification, which includes manufacturing (clothing and textiles), financial services, renewable energies, and ICT, supported by consistent growth in the tourism sector.

With relatively high levels of foreign investment, Mauritius has attracted more than 32,000 offshore entities, many aimed at commerce in India, South Africa, and China. Fundamental to its financial performance have been sound governance, political stability, and open regulatory systems.

In line with its growth, the government is committed to modernizing the industrial

property framework to create an attractive investment environment and to continue to transform the economy into a modern and dynamic one. The new bill is key to those aims.

The Minister of Foreign Affairs, regional integration and international trade, Nandcoomar Bodha, recently said of the Industrial Property Bill that: *"it essentially aims at modernizing the IP framework in Mauritius, promoting innovation, facilitating the registration of industrial property rights and creating better conditions to attract high-quality investment. It is also expected to stimulate the generation of more IP assets which, when commercialized, will generate revenue for the IP right holder."*

He also pointed out, that: *"it is a vital complement to the recently adopted Mauritius Research and Innovation Council Act. Both these laws would help shift our focus towards Research, Development and Innovation, and provide a framework for an innovation led economy."*

The main objects of this bill are as follows:

- To expand the scope of protection of industrial property to cover utility models, layout-designs of integrated circuits, breeder's rights and geographical indications, and thereby promote innovation and creativity, the introduction and development of new, improved and innovative plant varieties in Mauritius and the protection of products which have a specific geographical origin and possess qualities, characteristics or a reputation that are a result of that origin.

- To bring together under one single diploma the provisions of the law relating to the protection of industrial property rights namely, patents, utility models, layout-designs of integrated circuits, breeder's rights, industrial designs, marks, trade names and geographical indications, and to provide for related matters.

- To enable Mauritius to accede to the Patent Cooperation Treaty, for the filing of international patent applications, the Hague Agreement Concerning the International Registration of Industrial Designs and the Protocol Relating to the Madrid Protocol Concerning the International Registration of Marks, and to comply with its obligations thereunder following accession.

Some of the highlights relate to the section Marks, Trade Names, Geographical Indications, Madrid Protocol, which sets out the following provisions:

- Registration of a mark by more than one owner may be allowed in the case of genuine concurrent use.

- Recognition of prior use of unregistered rights can be used as a basis for opposition.

- An application may be divided into two or more applications in order to separate the goods or services specified in the initial application. A divisional application will retain the filing date and, where applicable, the right of priority of the initial application.

- The rights conferred by the registration of a mark will not extend to acts with respect to articles that have been put on the market in Mauritius by the registered owner or with their consent (national exhaustion of rights).

- Certification marks may be applied for and should be accompanied by a copy of

the agreement governing the use of the mark.

- Geographical indications may be registered as a separate form of intellectual property.
- Trademarks may be filed under the Madrid Protocol – the process of accession will be initiated by the government of Mauritius in due course.

- The creation of an Industrial Property Council.

- Cancellation applications will be filed with the Industrial Property Court.

- A six-month deadline to respond to office actions and refusals.

To sum up, the Industrial Property Bill encompasses a package of measures that will promote innovation, encourage and facilitate the registration and protection of industrial property rights by creating better conditions to attract investment, where the new Industrial Property Office of Mauritius will administer and implement the bill and assist in the protection, promotion, and development of industrial property governed by the proposed legislation.

The bill will come into operation on a date to be fixed by proclamation, and different dates may be fixed for the enactment of various sections of the act – but it is expected in the coming months. |

Amendments to Zanzibar's IP practices

Joana Teixeira

Africa

Zanzibar



Zanzibar's Business and Property Registration Agency (BPRA) recently introduced several changes to its practice, which are set to have an impact on the country's IP landscape.

The most important amendment is arguably the introduction of an online registration system. It aims to accelerate application proceedings, although this may take a while to be fully effective as it will require automating all existing processes. Implementing a paperless office is a positive, environmentally friendly decision.

The online registration system is available to business entities, parties with secured transactions on movable property and information services only, but e-filing is expected to be introduced for trademarks soon.

The introduction of this system marks a very important change in the country's IP practice. Besides the shift from a traditional to a technologically advanced approach, it will be more appealing to people looking to establish a business in the region, since it will be easier and faster to register rights. The average time to register a trademark is currently eight to 14 months from filing, so reducing this period is a positive for those wishing to extend or open their business in Zanzibar.

Further, the possibility of cross-referencing data with that of other national systems in a much easier manner is a great step forward.

Another change relates to authorised agents. These must now be persons in a law firm who are:

- authorised to practice law in the country;
- hold a certificate to do so before the High Court of Zanzibar and a subordinate court thereof; and
- are registered as an industrial property agent before the Zanzibar IP Office.

Previously, a non-resident of Zanzibar registering a trademark had to be represented by a legal practitioner who was resident or certified to practise in Zanzibar. Now, the power of attorney must be prescribed in the name of this individual.

Further, the Zanzibar IP Office will now take two to three working days to allocate application numbers after the application is filed. However, this period could be extended to two weeks as the office is currently experiencing delays.

Another significant modification covers the publication of IP rights. Previously, trademarks were published in the Official Government Gazette. Now the BPRA publishes its own journal. The first one was released on 1 March and all future issues will be available on the agency's website.

(...)



Cape Verde makes its first steps to protect Appellations of Origin and Geographical Indications

Diana Pereira

Africa

Cape Verde



During its short existence, the Cape Verde Institute of Management and Quality of Intellectual Property (IGQPI) has mainly focused on protecting trademarks and patents. Other IP rights – such as appellations of origin and geographical indications (GIs) – have therefore been ignored.

However, this has started to change, thanks to actions driven by WIPO and the Portuguese National Institute of Industrial Property. IGQPI's president, Dr Ana Paula Spencer, along with a team of technicians, have been participating in conferences and projects, which aim to raise awareness among entities and applicants as to the importance of protecting products with specific geographical origins and qualities that they possess because of their location. People have therefore become more conscious that, under certain conditions, appellations of origin and GIs can contribute to development in rural areas and add value to products and producers.

As per provisions outlined in the IP Law, an appellation of origin corresponds to the name of an island, region or place, which designates or identifies a product from that location – the qualities of which are due to its geographical environment (this includes natural and human factors). Further, the production, transformation and development of the product occur within the delimited geographical area. GIs, on the other hand, have fewer demanding requirements, as the product is only required to possess a reputation, quality or other essential characteristic that is derived from being:

- produced within the delimited area;
- transformed within the delimited area; or
- development within the delimited area.

As Cape Verde comprises an archipelago of 10 volcanic islands in the central Atlantic Ocean, it has specific geographic and climatic characteristics, which enable it to produce goods – mainly foodstuff and drinks (eg, wine, liquors, cheese, tuna and coffee) – with particular qualities.

The year 2018 was a milestone for the protection of appellations of origins, marking the first applications to be filed in Cape Verde. This was a direct result of a pilot project spearheaded by the IGQPI and WIPO.

The application for the appellation of origin of wine from the island of Fogo serves as a useful example. Its vineyards are cultivated on the volcano's slopes, at a variable altitude of 1,500 and 2,000 metres, with no need of irrigation (depending on the scarce precipitation in July and September) or chemical fertilisers. In contrast to regular vineyards, its grapevines are low and do not follow an ordered crop. Further, all stages – from cultivation to bottling – occur on the island.

(...)



Increase in IP fees could shake up filing in Ghana and Tunisia

Inês Tavares

Africa

Ghana & Tunisia



Many African countries have raised their IP fees in the past few years. This is due to economic growth, a rising interest in protecting IP assets and the modernisation of countries' IP systems. For example, in 2017, the Democratic Republic of Congo hiked up its prices by roughly 15% and South Africa's Trademark Office announced an increase in official fees (effective from 1 October 2019).

Egypt has also stated its intention to follow suit for industrial property services payments.

This article focuses on Ghana and Tunisia, which have both raised costs for their IP services this year.

Tunisia

The Tunisian Ministry of Industry, Energy and Small and Medium-sized Entities issued Decree 29/2020, which declared a radical increase – effective from 27 January – in official payments across all types of IP service. Trademark prosecution fees have gone up by an astonishing 100%, patent prosecution services by 30% and industrial designs prosecution services by 20%. However, it is important to remember that these costs had not changed since 2001 – an update is therefore unsurprising and probably overdue.

Although a 100% increase may alarm brand owners and possible investors, in comparison with other countries outside and within Africa, Tunisian fees remain very reasonable and it seems highly unlikely that the volume of IP assets filings will be affected. The cost of registering a

trademark is now \$142, plus a registration fee of \$36 per each trademark. Further, under normal circumstances, a trademark application is approximately \$178 per class. Overall, Tunisia's increase is not that significant when compared to other thriving African countries.

"(...) Tunisian fees remain very reasonable and it seems highly unlikely that the volume of IP assets filings will be affected."

Ghana

Ghana's economy is growing steadily, which may justify the increase in industrial property-related applications and the consequent opportunity to hike up costs. On 19 November 2019, the Ghanaian government reviewed its payment structure for industrial property services and allegedly decided that fees in this field will increase by 20%, which is a significant rise, especially with regard to patents. In accordance with the proposed new schedule effective from 19 May 2020, a trademark application will be \$240, plus the issuance of the registration certificate, which is a further \$240. Further, it will be \$440 per class. |

Counterfeit goods: a critical situation in Mozambique

Júlia Alves Coutinho

Africa

Mozambique



The production of counterfeit goods is common in the trademark field as it is a business opportunity based on the consumer's inability to identify second-generation goods.

Laws surrounding this activity include:

- *Article 177(1)* of the Mozambican Industrial Property Code (Decree 47/2015), which defines the 'production of counterfeit goods' as an infringement committed by an entity that counterfeits a registered trademark without authorisation from the owner, uses a counterfeit mark or exports, imports, sells, puts on sale or circulates products or articles containing a counterfeit mark;
- *Article 73(d)* of the Mozambican Industrial Property Code, which stipulates that it constitutes an industrial property violation; and
- *Article 319* of the Mozambican Penal Code (Law 35/2014), which states that it is considered to be a crime, for which the infringer could receive a fine or even imprisonment as per Article 310 of the same law.

Mozambique has a specific **public institute to control counterfeit activity** – the National Inspectorate of Economic Activities (Inspeção Nacional das Atividades Económicas (INAE)). Under the supervision of the Ministry of Industry and Commerce, it inspects all locations where industrial, commercial or service activity is carried out in the country, with the help of brand specialists. Further, it is particularly active in the capital city, Maputo. The INAE aims to dismantle the circulation of counterfeit goods – namely, clothes,

shoes, bags, perfumes, printers, filters and toners, the majority of which come from Asia. However, while the damage to trademark owners and the strain on the state due to tax evasion is severe, counterfeit food products are even more critical to tackle as they can put public health at risk.

The procedure

The process of terminating counterfeit activity starts with a complaint to the INAE from the trademark owner. Following the seizure of the counterfeit goods, the INAE imposes a fine on the counterfeiter and submits a report of the process to the attorney general's office for the subsequent criminal proceeding. The final outcome, in principle, is the destruction of the goods and a prison sentence for the infringer. In order to prevent counterfeit goods from entering the country, trademark owners can submit an informal application to Customs, requesting that any goods imported with a trademark that does not match the name of the trademark owner or an authorised representative be classified as counterfeits. However, Customs may lack experts who are able to distinguish real products from fake ones, as it is difficult to detect counterfeit products at ports and borders. It is important to emphasise that **Mozambique does not have a Customs Recordal Application system**, unlike other African jurisdictions (eg, Kenya, South Africa, Ethiopia and Morocco).

The responsibility for controlling counterfeiting lies with the INAE, which is committed to remedying this situation and, if possible, preventing it, just as the government of Mozambique is aware of and dedicated to combating this activity. It is hoped that the combined efforts will be fruitful and the situation can be controlled in the near future. |

The law on distinctive signs in Mozambique explained

João Pereira Cabral

Africa

Mozambique



There are **multiple types of industrial property rights** that an entity can use to protect the following distinctive signs in commerce in Mozambique: trademark, logotype, trade name, establishment name, establishment insignia and corporate name.

Distinctive signs and the law

Articles 121 to 162 of Chapter IV of the *Industrial Property Code* deal with trademark rights. They define a 'trademark' as a sign that distinguishes goods and services commercialised and/or provided by an entity from those commercialised and/or provided by other entities.

Articles 187 to 202 of Chapter VI of the *Industrial Property Code* cover trade and establishment names and establishment insignias. A trade name is a name or expression that identifies a legal or natural person in a commercial operation. Article 187(1) states that a trade name must consist of a person's name or a corporate name.

However, this is contradicted by Article 189, which states that trade names may also consist of "fantasy or specific" designations.

An **establishment name** is any kind of name that identifies or individualises a physical space in which economic activity takes place. Under Article 187(2), this may either be a place of manufacture, processing, storage or product marketing, or provide services. Establishment insignia should serve the same purpose as an establishment name (ie, identify an establishment), but be composed of

figurative elements. However, an establishment insignia distinguishes the façade of commercial establishments only.

The registration of a trade name, establishment name or insignia prevents unlawful use by third parties. However, what constitutes unlawful use has not been clarified.

A **logotype** is a sign composition that consists of figures or drawings, individually or combined, which reference a public or private entity. Two articles outline its scope of protection.

The first states that the legal protection of a trade name, establishment name or establishment insignia applies to logotypes. Among trademark professionals there is much confusion as to why logotypes were not included in the abovementioned chapters.

Further, the result is that:

- logotypes and trade names converge in that they identify an entity in commerce, but diverge in that logotypes may consist of figurative elements and correspondence with the corporate name of the owner is only necessary for trade names;
- trade names and corporate names are treated in the same way; and
- the only difference between establishment names and insignias is the type of sign, as the former may only consist of word elements and the latter may be formed of figurative elements with or without word elements.

Possible solutions

This author suggests that trade name rights should be eliminated and is in favour of combining the rights that encompass establishment names and insignias into one, which would cover all types of sign that identify an establishment.

However, this change arguably does not go far enough. Since all of these rights cover signs that identify an entity or an establishment, their coexistence with trademark laws is unclear, because the scope of these rights is not easy to define. For example, if a sign is registered as a logotype with no reference to goods and services, does that mean that a third entity cannot use this sign to identify any good or service? If the answer is affirmative, then why would a company register a trademark instead of a logotype that would confer protection for all goods and services?

Does the registration of an establishment name give the owner the right to prevent its use by others to identify a good or a service? These questions stress the lack of clarity in Mozambican laws on distinctive signs.

Comment

If it is true that any entity in commerce can perform two activities only – commercialise goods or provide services – then trademark rights alone should be sufficient.

For these reasons, according to the author, all the rights for distinctive signs should be eliminated, with the exception of trademark rights and necessary corporate names. |



5 minutes reading about

São Tomé and Príncipe

The Republic of São Tomé and Príncipe deposited its Instrument of Ratification of the Arusha Protocol on the Protection of New Varieties of Plants of July 6, 2015, with the Director General of ARIPO on September 29, 2020. The Arusha Protocol, which main purpose is to grant and protect breeders rights, was adopted by a Diplomatic Conference of ARIPO Member States in Arusha, Tanzania, on July 6, 2015. Under Article 40 (Chapter XVI), the Protocol shall come into force twelve months after four States have deposited their instruments of ratification or accession. Any State, member of ARIPO or to which membership of ARIPO is open, may become party to this Protocol. [\[+\]](#)

Mauritius

The Republic of Mauritius deposited its Instrument of Accession to the Lusaka Agreement of December 9, 1976, establishing the African Regional Intellectual Property Organization (ARIPO) with the Director General of ARIPO on September 25, 2020. The accession of The Republic of Mauritius to the Lusaka Agreement brings the total number of ARIPO's Member States to 20, following Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Somalia (not a member of the Harare Protocol), Sudan, the United Republic of Tanzania, Uganda, Zambia and Zimbabwe. [\[+\]](#)

Portugal

End of deadlines suspension and other alterations by the Portuguese IP Office. On April 16, 2020, the counting of deadlines for the practice of acts by private individuals that had been suspended since the publication of Law no. 1-A/2020, which entered into force on March 12, 2020, as restarted. [\[+\]](#)

Kenya

On June 15, 2020, Kenya Industrial Property Institute publishes a Special Industrial Property Journal regarding new trademark rules. Under Section 23 of the Trademarks Act, all trademarks registration expires after ten (10) years, however, a proprietor of a registered trademark can always apply for its renewal. [\[+\]](#)

Angola

updates its Intellectual Property official fees and procedures. Published in the Official Gazette of the Angola Republic, the new fees came into force on March 20, 2020 and reflect an increase of values in all IP procedures practiced in this jurisdiction, updating rates that have remained unchanged for more than 20 years. The most significant alteration with respect to trademarks, consists of joining in a single fee, paid at the time of the registration application, the filing fees, the first and second publication fees, and the granting and registration certificate fees. [\[+\]](#)

Ethiopia E-POA In late February, 2020, a new app has been launched to revolutionize the legalization process of Power of Attorneys from Ethiopia. The Consular Office, through the website, provides an expedite service that allows applicants and agents to fill in the E-POA form, make the payment and send it to the Embassy of Ethiopia for the online legalization process in less than 24-48 hours. The app was conceived to save time and costs to both the applicants and agents and is set to modernize the system whilst having a zero-fraud rate. The App is currently available for download for Apple and Android devices and on the website the agents can find helpful tutorials to guide themselves through the process without fuss. [\[+\]](#)

Zanzibar Business and Property Registration Agency (BPRA) has introduced the Online Registration System (ORS) that has already been put in place in Tanzania (Tanganyika) with very promising results. The ORS intends to modernize the registration process, making it easier and faster when compared to the manual filing. (...) Another amendment concerns Authorized Agents. Any authorization should be placed to an individual person, within a law firm, that is authorized to practice law in Zanzibar. It is relevant to note that powers of attorney must be prescribed in the name of said individual agent. [\[+\]](#)



Mozambique joins the Banjul Protocol (ARIPO System for Trademark Registration). The government of Mozambique deposited its instrument of Accession to the Banjul Protocol on the 15th of May 2020 and become a member of ARIPO's protocol for trademarks on August 15, 2020. The Banjul Protocol establishes a centralized filing system in all applications for the registration of a trademark. [\[+\]](#)

Myanmar Trademark right holders interested in obtaining a Trademark re-registration in Myanmar can do so starting December 31st [2019], by taking advantage of the soft opening of the registrar which permits a preliminary filling. This soft opening filing is a re-registration system and is available to owners of Trademarks that are registered under the Declaration of Ownership at the Registry of Deeds. [\[+\]](#)

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