



AFRICA **UPDATE** 2020

COUNTRY UPDATES | AFRICAN INNOVATION | ADAMS.AFRICA ADVISORY

AFRICA OVERVIEW

Adams & Adams



ARIPO Director General

**FERNANDO
DOS SANTOS**

WELCOME

One of the key findings of the WIPO Innovation Index 2019 is that

“Innovation inputs and outputs are still concentrated in very few economies; a global innovation divide persists”.

Unfortunately, Africa is still depicted as the poor relation in the whole spectrum of innovation and Intellectual Property uptake.

There is therefore an urgent need for all stakeholders to work together to reverse such situation. It is high time that Africa shifts from being main Intellectual Property consumer to Intellectual Property producer.

As Adams & Adams is publishing this 8th issue of the Africa Update Magazine which covers the IP highlights on the Continent, it is befitting to commend the Firm as one of the largest users of the ARIPO system, and a key stakeholder in the development of Intellectual Property, for their role in creating awareness on Intellectual Property in Africa.

In collaboration with its partners, ARIPO is more than ever before engaged in setting the Continent on global competition in terms of innovation. In this context, the year 2019 was marked by the implementation of the Tripartite MoU WIPO-ARIPO-OAPI signed in 2018 (also known as the WAO Agreement) which is aiming at mainstreaming IP technical assistance to Africa. Several initiatives were undertaken including the Conference *“Intellectual Property, Innovation, and Value Addition for Business Competitiveness and Sustainable Development in Africa”* and the Development of the Nairobi Action Plan on Copyright. In operations, ARIPO also registered the highest number of applications both in patents (867) and marks (408). Further, the ARIPO Academy was transformed into

a Regional IP Training Center of Excellence, a 3rd Master's Degree Programme on IP was launched at the University of Dar es Salaam in Tanzania. ARIPO also endeavoured to improve efficiencies in its operations namely through the use of ICTs as evidenced by the fact that 94% of patent applications received were filed online which strongly suggests that by the end of 2020, ARIPO could be a paperless office.

However, a lot is yet to be done on the African Continent. Indeed, according to the WIPO IP Facts and figures for 2019, Africa share on global patents applications is still at 0.5 percent, in trademarks at 1.7 percent, 1.5 percent in industrial designs and 0.1 percent in utility models. This is against the global trend that has witnessed an exponential growth of IP rights in all other regions. The reasons behind the low uptake of IP in the Continent may be profound and include lack of adequate policies, legislation and institutional frameworks. However, issues related to efficiencies and responsiveness of IP offices with regard to their operations may be crucial and may need to be looked at closely and improved.

As we are moving toward the implementation of an African Continental Free Trade Area (AfCFTA), it is important that the Continent set the conditions to facilitate trade and movement of goods and services by improving IP as one of the most important enablers.

This publication will go a long way in providing information about the IP systems in Africa, sensitize the global IP fraternity on the important developments that are happening in the continent and promote more trust in it for better utilization.

Therefore, it is with great pleasure that I welcome you to this edition of the Adams & Adams Africa Updates Magazine and I hope you will find it relevant and useful.



AS COINED BY OLIVER WENDELL HOLMES, JR:

“A mind that is stretched by a new experience can never go back to its old dimensions.”

Chairperson, Africa Strategy Committee
Co-chair, Trade Marks Department

SIMON BROWN

INTRODUCTION



Established in 1908 with our head office in South Africa, we have expanded over the years with various Associate Offices and partners across Africa. Needless to say, it has been an exciting journey, with many highlights to look back on and challenges to learn from.

At Adams & Adams we look to explore, engage, understand and grow, while fostering meaningful relationships with Africa's IP fraternity and clients alike.

Adams & Adams continues to foster relationships with IP organisations operating within the continent.

Living in today's technology-driven world, where society lives and relies on devices makes meaningful personal connections more important than ever. As such, Adams & Adams partners continue to travel widely across the continent to engage with its associates and IP administrators in number of African countries. This interaction with the African IP fraternity is what sets Adams & Adams apart from its competitors.

Last year, partners travelled extensively, visiting Angola, Botswana, eSwatini, Ghana, Kenya, Lesotho, Liberia, Mauritius, Namibia, Nigeria, São Tomé and Príncipe, Tanzania, and Uganda. Travel – much like knowledge – the more you see, the more you know.

By visiting its Associate Offices and the Registries in each country, Adams & Adams receives on-the-ground information on the challenges they face and how they plan on addressing them.

The 2019 Adams & Adams Africa IP Network Meeting, held in Pretoria, South Africa, saw agents, practitioners, and registrars from across the continent gather to share experiences, challenges, developments, and learnings on IP prosecution and litigation in their respective jurisdictions.

Adams & Adams also held several IP enforcement training workshops with local police officers and customs officials in the various African countries.

Notably, the World Customs Organisation invited Adams & Adams to participate in the National Intellectual Property Rights (IPR) Workshop in Accra, Ghana, where the team provided anti-counterfeiting training. The event was well attended, with Ghanaian customs officials expressing a great deal of interest, calling for further co-operation and training.

Africa is a diverse continent, made up of 54 countries, and each with its own culture, social dynamics, opportunities, and challenges. The only way to really understand the intricacies of the continent is with first-hand experience.



Adams.Africa
ADVISORY

ADAMS.AFRICA ADVISORY UNIT

Economic growth is closely associated with progressive intellectual property (IP) protection systems that are geared towards fostering technological and industrial development and innovation.

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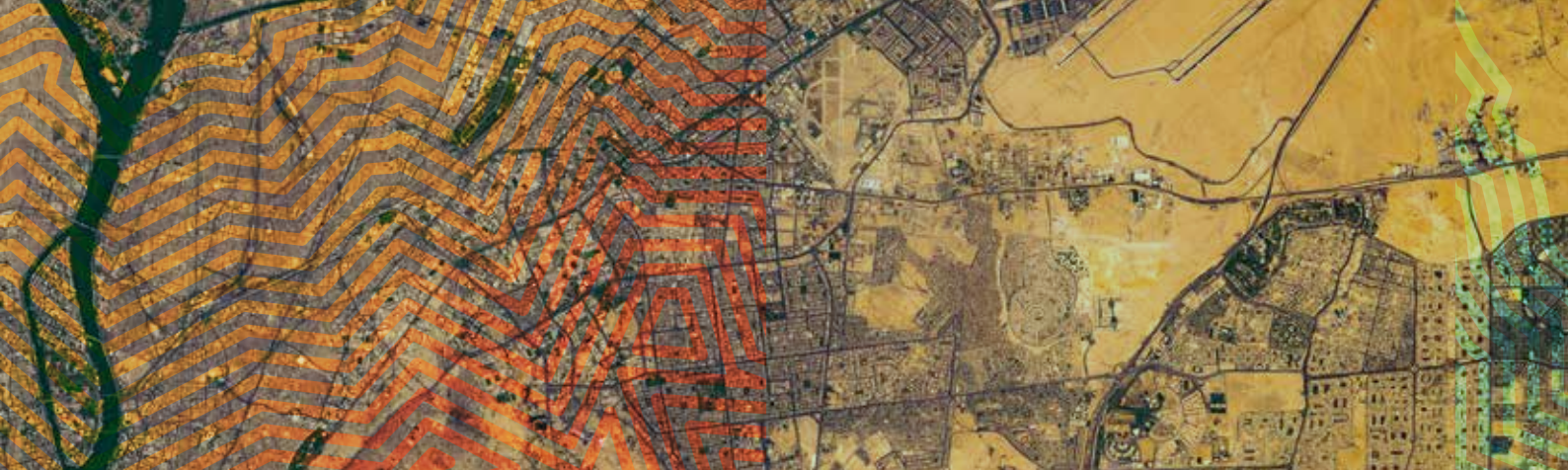
However, lack of access to critical economic data and market intelligence, coupled with policy uncertainty, continues to affect strategic decisions, and as a result, deters investors.

To assist investors in entering the African marketplace, the **Adams.Africa Advisory unit** has an expert team on hand ready to help clients mitigate risks and take advantage of investment opportunities across the continent.

The team has decades of on-the-ground experience, comprising market specialists, industry experts, and thought leaders, providing clients with the latest business, economic, political, and legal updates, events, and trends from across the continent.

Africa is ripe with opportunities. However, before clients dive in, they need to consider the challenges that the continent presents, too, as they are multifaceted and unique to each jurisdiction.

For those looking to invest, Adams.Africa Advisory unit has pegged investment opportunities in five sectors that are set for take-off and identified seven key challenges facing businesses entering the marketplace in its two latest reports.



Weighing up Africa's investment potential

Once seen as the 'risky' continent, despite being a viable investment destination for natural resources, Africa's respectable growth rate and improvements within business environments have made it an attractive destination for foreign direct investment for several key industries.

Boasting a growing fast-consumer goods sector that has attracted attention from various international brands, Africa is also quickly becoming an important import hub for a variety of other industries.

Multinational organisations have managed to gain strong footholds and as a result, increased the number of partnerships with local players to assist them in securing in-depth market knowledge, allowing them to leverage this information for the expansion of operations.

Despite the progress being made across the continent, Africa still poses a number of challenges for current and future investors, especially those trying to enter the marketplace.

One must always keep in mind that a 'one-size-fits-all' blanket approach is not the way to go when approaching the African marketplace. By acknowledging that Africa is made up of a collection of diverse countries, each with its own business challenges, rooted in unique cultural, geographical, and sociological thought-processes and differences that should be used to guide and inform business engagements.

Opportunities

Africa is emerging as an investment destination of choice, with burgeoning industries ready for further development.

A recent study by Adams.Africa Advisory details the key sectors that are poised for expansion, helping clients navigate challenges to secure opportunities across the continent.

Africa's economies have traditionally been rooted in the primary sectors due to its favourable climate conditions and abundance of natural resources. However, the success of Africa's economic development is not restricted to the extractive industries. Other sectors that are showing immense potential include construction, financial services, food, agri-processing, healthcare, manufacturing and retail – all of which are emerging as important industries, helping to drive development on the continent.

Key sectors that present attractive investment opportunities for investors include agriculture, energy resources, healthcare, telecommunications, and transport infrastructure.

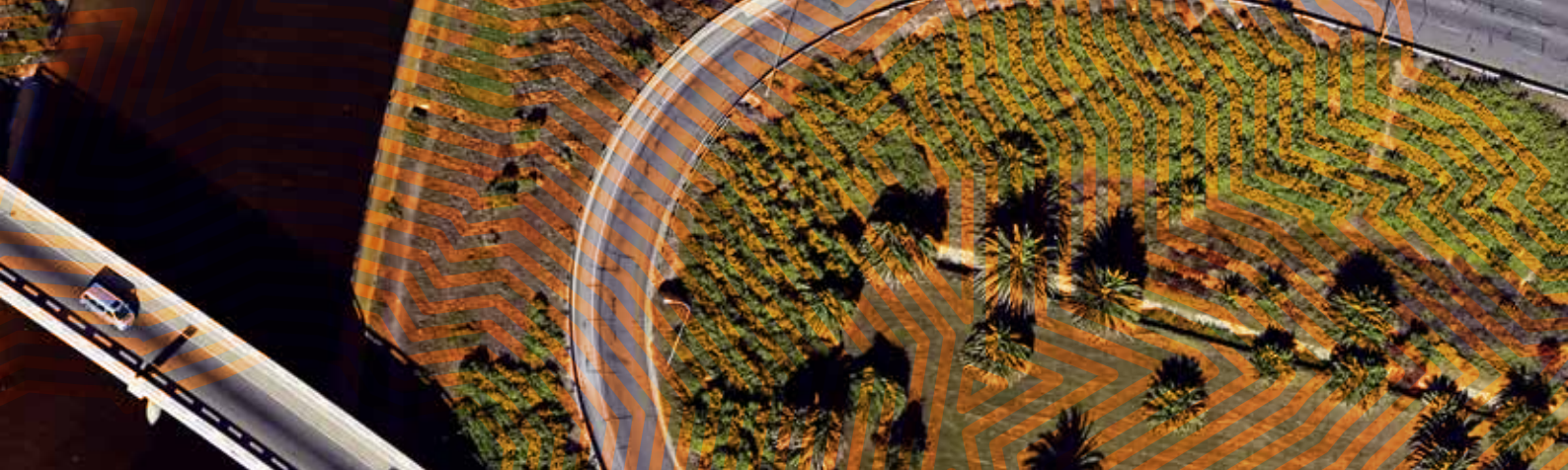
Development priorities vary in scale and by industry across regions and countries. Investors require targeted research, market entry strategies, and feasibility studies in identifying regional and country-specific gaps and opportunities in being better informed on potential investment costs and risks before making in-roads on the continent.

Challenges

The Adams.Africa Advisory unit identified and unpacked the challenges facing clients doing business in Africa, with the most prominent being the ease of doing business and the rigid regulatory environments that are prone to corruption.

Other challenges include establishing trustworthy local partnerships, ineffective IP rights, limited market size, inadequate infrastructure, and lack of access to capital and funding.

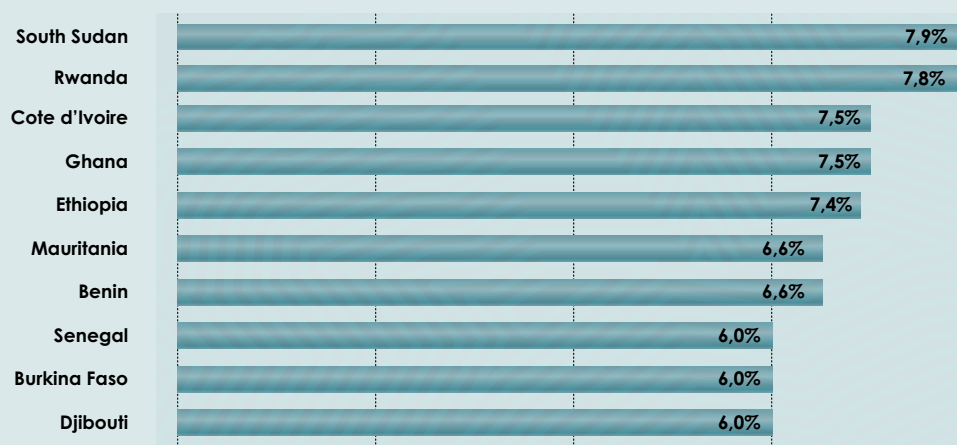
To assist investors entering the African marketplace, Adams & Adams through its Adams.Africa Advisory unit offers a comprehensive range of business, economic, political, and legal research services, coupled with up-to-date information and a precise framework for investment and IP protection across Africa's jurisdictions. If you would like to receive more information, contact us on advisory@adams.africa



AFRICA ECONOMIC OVERVIEW 2019

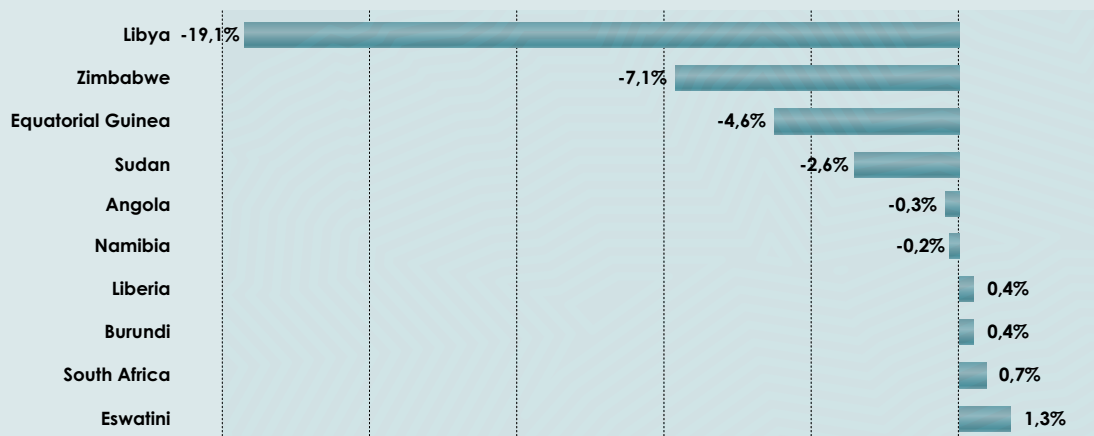
Top 10 fastest growing economies in Africa 2019

REAL GDP GROWTH AT MARKET PRICES



Top 10 slowest and declining economies in Africa 2019

REAL GDP GROWTH AT MARKET PRICES





AFRICAN INNOVATION

Helping Africa's entrepreneurs succeed through IP



Africa Innovation Challenge – Tapping into the benefits of Intellectual Property (IP)



Africa holds an abundance of potential however young, innovative entrepreneurs still face several barriers, ultimately hindering their inevitable success.

Many of these African entrepreneurs hold some of the most innovative ideas that could alleviate some of Africa's current burdens, from healthcare to lack of access to electricity and water.

With a surge of activity among entrepreneurs and health systems leaders looking to develop solutions that overcome health and societal challenges, Johnson & Johnson launched the Africa Innovation Challenge to identify worthy innovations aimed at tackling African healthcare related problems.

Launched in 2017 as part of the company's comprehensive approach to support and collaborate with Africa's innovation, education, and health systems and institutions, the Africa Innovation Challenge is a platform that looks to develop and grow sustainable businesses.

Ugandan architect, Grace Nakibaala's innovation, passion and dedication towards coming up with a solution to solve some of Africa's challenges recently earned her an accolade as one of the three winners of the inaugural Africa Innovation Challenge.

Seeking to prevent disease transmission and reduce water use, Grace came up with the idea to create a hands-free solution for water taps in Uganda.

Her innovation, PedalTap™ is an affordable, portable hands-free foot-operated water dispensing solution. Using technology that involves modifying the existing water tap system, PedalTap creates a cost-effective solution for developing countries, reducing the growth and frequency of infectious diseases such as flu, cholera, Ebola and Coronavirus on existing taps.

Grace's invention is much needed, as effective hand hygiene could contribute to a 60% reduction in hospital care-associated infections spread in public facilities.

As a budding entrepreneur, Grace realised her innovation needed further credibility and protection if investors were to buy into her invention.

Adams & Adams, as an official partner of the Africa Innovation Challenge offered to extend their services to Grace.

Adams & Adams successfully secured trade mark and utility model protection for Grace's PedalTap innovation. This is a small victory for Grace on her important journey in improving the well-being of all Africans.



AFRICA IP NETWORK MEETING, PRETORIA

The 2019 Adams & Adams Africa IP Network Meeting, held in Pretoria, South Africa, saw agents, practitioners, and registrars from across the continent gather to share experiences, challenges, developments, and learnings on IP prosecution and litigation in their respective jurisdictions.

Touching on the latest and most pressing issues taking place across the continent, Gérard du Plessis, Adams & Adams Chairman addressed the incidences of xenophobic violence in South Africa, which overshadowed last year's events.

Du Plessis called the incidences "senseless acts" that "go against the constitutional values of our nation and our firm."

His sentiments were echoed by Keynote Speaker, Redi Tlhabi, a broadcasting journalist, producer, author and a former radio presenter on 702 for over a decade – recalling her own challenges that citizens continue to face today, especially women across Africa.

Voted as one of the top 50 **'Most Influential People'** in IP by Managing Intellectual Property, Fernando dos Santos, ARIPO Director General, and Guest Speaker explored key strategies that are needed to restore Africa's profile and international IP reputation.

Presenting the session titled, 'Can IP Help Africa to Reclaim its Former Glory in Innovation?', dos Santos referenced the words of Francis Gurry, WIPO Director General, saying:



Gérard Du Plessis (Partner & Chairman, Adams & Adams) and Redi Tihabi

“Ultimately, the source of all innovation and creativity is human, and Africa is the cradle of humanity, so it is in this sense the origin of all innovation and creativity that characterises our species as human beings.”

The low uptake of IP across the continent, while not utilising the full potential of the system, was emphasised, as Africa only accounts for 0.5% of all patents and 1.9% of all trade marks filed globally.

If Africa is to move forward, delegates need to assume their role as stakeholders of the IP system by raising awareness and contributing to IP education. Dos Santos encouraged delegates to assist local creators and innovators while finding ways to improve Africa's IP systems image and policies, as well as its legal and institutional frameworks.

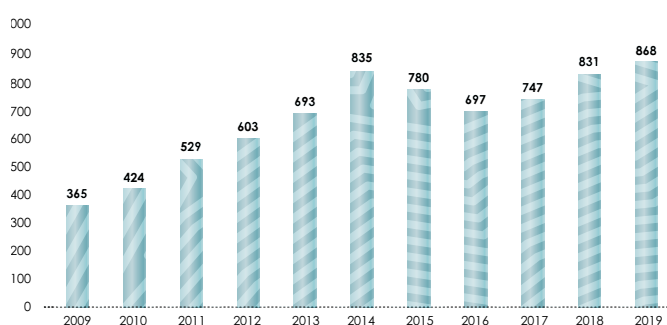
Various topics were discussed with in-depth talks and break-out sessions held on copyright, non-traditional trade marks and trade marks in the digital, domain name complaints, regional organisations, such as ARIPO and OAPI, and the interaction between designs, copyright and trade dress.

Adams & Adams Partner and the meeting's MC, Simon Brown, was upbeat about the event's turnout, hailing it a major success. He mentioned that every year, delegates are becoming more and more positive about the role IP will play in Africa's economic growth going forward.

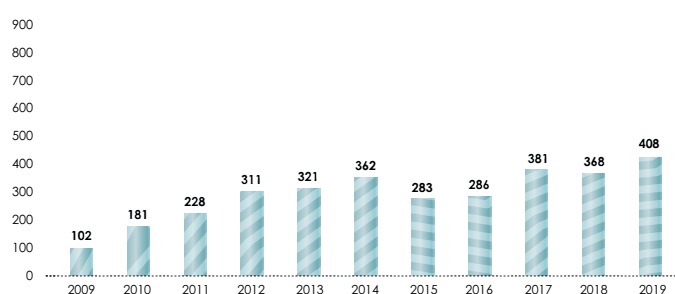
COUNTRY UPDATES

ARIPO UPDATES & NEWS

Increase in Patent and Trade Mark Filings



TOTAL PATENTS FILED 2009 - 2019



TOTAL TRADE MARKS FILED 2009 - 2019

The increase in patent filing numbers since 2016 was maintained in 2019, as it recorded the highest number of filings since 2009. The performance of the ARIPO system continues to improve with increases in both patent and trade mark filings.

ARIPO Administrative Council Meeting 2019, Monrovia

The 43rd Session of the Administrative Council of ARIPO took place in Monrovia, Liberia, between 18 and 20 November 2019. Adams & Adams partner, Stephen Hollis and, Africa Practice Manager, Menzi Maboyi, attended the session as the only law firm representatives in attendance.

Out of the 19 member states, 17 were represented, with two observer states also in attendance, namely Mauritius and Seychelles.

The Guest of Honour, Lucia Ipumbu, Deputy Minister of Industrialisation, Trade and SME Development of the Republic of Namibia, addressed the Council and officially opened the 43rd Session of the Administrative Council.

Based in South Africa, Adams & Adams works with ARIPO via our Mozambique office. We have been operating in this way since 2009 and are currently one of the largest users of the ARIPO patent system.



Members of the 43rd Administrative Council Meeting



**Stephen Hollis (Partner, Adams & Adams),
Mr Fernando dos Santos, ARIPO DG and
Konstantinos Georgaras (Director General,
Canadian Intellectual Property Office),**

Recent amendments to the Banjul and Harare Protocols

At the recent ARIPO Administrative Council meeting, held in November 2019, a number of amendments to the Banjul and Harare Protocols were adopted and came into force on 1 January 2020.

The amendment has introduced new requirements regarding the filing of applications, specifically regarding the filing date and payment of official fees.

The most significant amendments made to the Banjul Protocol relate to oppositions. Previously the Protocol merely indicated that any person can oppose an application. Now, the opposing party has to show that it is an interested person.

A further amendment deals with the filing of oppositions. The term within which to oppose a mark is three months from the date of publication stating the acceptance of

an application in the ARIPO Journal. The amendment has clarified that the Notice of Opposition (prepared in accordance with the national laws of each member state) should be filed at the ARIPO Office. A copy of the Notice of Opposition should also be sent to the Registry of each member country.

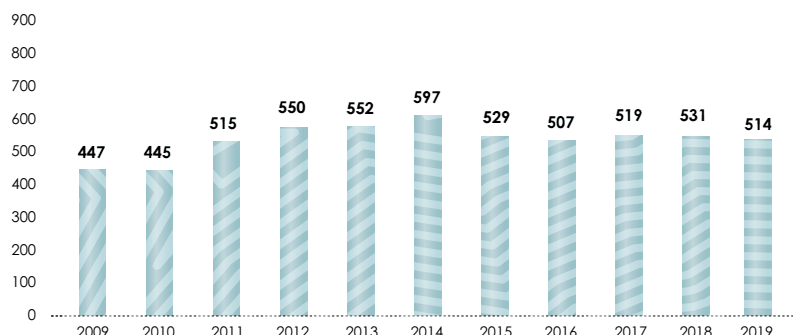
The Council also considered a draft legal framework on the establishment of a regional voluntary copyright registration and notification system. The framework will now be reformulated into a draft protocol and will be considered for adoption at the next meeting.

Under the Harare Protocol on Patents and Industrial Designs, including its Implementing Regulations, the most significant amendments relevant to the filing of patent and design applications include provisions relating to addition of member states, early publication of an application, a change in the timing of surcharge payments and the introduction of substantive examination of utility models.



OAPI UPDATES & NEWS

OAPI Patents Filed 2009 – 2019



Cases granting within six months

Currently, OAPI patent applications are subject only to formal examination. Consequently, patent applications can proceed to grant quickly, in some cases as early as six months from filing and without any forewarning. As such, there is limited opportunity to amend an application or file a divisional application. Therefore, a proactive approach to prosecution is required.

Applicants are encouraged to consider any claim amendments or instruct the filing of divisional applications by no later than six months from the date the application is filed at the OAPI Patent Office



ANGOLA

Encouraging Developments at the Registry

In October 2019, Adams & Adams partners, Nicky Garnett, Stephen Hollis and Elio Teixeira travelled to Luanda for a meeting with Anna Paula Bolivar, the Director General of the Instituto Angolana Propriedade Industrial (IAPI) as well as other senior registry officials. The purpose of the meeting was to discuss with IAPI concerns regarding the delays in processing patent applications in Angola and to obtain clarification on IAPI's plans for legislative amendments and capacity building.



Stephen Hollis and Nicky Garnett (Adams & Adams partners) at the Registry Offices



From left to right: Jacinto Ucuahamba, Adams & Adams Angola, Nicky Garnett, Ms Ana Paula Boliva (Registrar) and Stephen Hollis (extreme right) with senior Registry staff

The visit was extremely useful and has already proved beneficial as we have seen a number of patents proceeding to grant. This is a significant step forward as not a single patent was granted by IAPI in the period 2010-2018. In addition, there have been definite improvements in the frequency of publication of patent applications in the months following our visit and some patents (which has been previously been overlooked) have now been published paving the way for these applications to proceed to grant in the near future.

Ms Bolivar has been the Director General of IAPI since 2014 and has embarked on a program of recruiting and training additional registry staff to improve the ability of the office to deal with incoming matters as well as the backlog of cases

which she inherited. The publication and issuance of trade mark certificates and processing of trade mark oppositions have improved dramatically. That said, there are still delays in the processing of trade mark records in Angola and patent searches are problematic. Whilst the World Bank is assisting IAPI with the digitisation of their records, this is an ongoing project which is subject to severe capacity constraints.

We are encouraged by the willingness of Ms Bolivar and her team at IAPI to meet with stakeholders and look forward to seeing continuous improvements with the handling of our cases in Angola.

KEY OPPORTUNITIES & CONCERNS

- + Angola remains Africa's second largest oil producer
- + Government is serious about diversifying the economy away from the energy sector, and is opening investment opportunities
- + Angola is well-positioned to produce entertainment and media content for Portuguese-speaking Africa
- + By 2050, Africa will be home to the world's largest Portuguese-speaking population, surpassing Brazil
- President João Lourenço's dismembering of the old dos Santos corruption machine is underway but is encountering resistance from the country's corrupt elite
- Urban social services are poor and poverty is widespread in rural areas
- Agriculture employs over eight out of ten workers but contributes little to GDP due to antiquated practices and a small value added food industry



BOTSWANA

KEY OPPORTUNITIES & CONCERNS

- + An extensive transportation infrastructure ensures economic sectors are well served and entices new investment
- + Confidence in government remains high, and corruption is limited to local scandals and errant individuals rather than existing as entrenched culture
- + Industrial parks and agricultural initiatives are government's incentives to diversify the economy away from the mining sector
- Energy and water security are perennial issues in the desert country
- Business confidence is on the decline. While the 2018 score of 58 was up from 46 in 2016, as recorded biannually, a long-term decline from a high of 82 in 2008 is likely to accelerate with substandard 2019 economic data
- A progressive wildlife protection policy was viewed as compromised with a lifting of an elephant hunting ban in May 2019, bringing criticism from conservationists and worries about effect on Botswana's US\$ 2 billion annual tourism revenues

Registry Visit

In July 2019, Adams & Adams partner, Eugene Honey and Trade Mark Administrator, Shakes Mashaba travelled to Gaborone to visit our Associate Office, as well as the Companies and Intellectual Property Authority (CIPA) at its premises in the new central business district.

They met with the Registrar, Mr. Tim Moalusi, to discuss Registry operations and outstanding matters. Mr. Moalusi provided an update on the digitisation implementation, which has experienced delays. He further advised that they were in the process of reviewing their legislation and the possible setting up of a tribunal to deal with IP issues.

Anti-counterfeiting: Customs Training

During February 2019, our anti-counterfeit team travelled to Gaborone for strategic discussions and meetings with officials from Botswana Companies and Intellectual Property Authority (CIPA). Discussions included a change in mandate with regards to anti-counterfeiting enforcement in Botswana and assisting in compiling regulations and processes for the combatting of counterfeit goods in Botswana. The buy-in from the CIPA members was encouraging and provided a hopeful platform from which to work for the future.

At the same time, CIPA arranged a meeting with the registered clearing agents with the intention to educate them with regards to the actual harm caused by counterfeit goods, during which we gave a presentation and answered various questions from the attendees.



BURUNDI



New Approach to Trade Mark Renewals

Historically, trade marks filed in Burundi were valid indefinitely; therefore, there was no need to pay renewal fees in this jurisdiction. In 2009, the law regarding trade mark renewals in Burundi changed. As mentioned in previous editions of this Update, trade mark proprietors should be aware of the impact on their trade mark registrations in this jurisdiction.

Burundi Law No. 1/13, relating to industrial property, came into effect on 28 July 2009 (hereinafter referred to as "the New Legislation"). As indicated above, prior to the new legislation, once registered, a trade mark registration remained valid indefinitely. The New Legislation altered this position and every trade mark that was registered on, or after, 28 July 2009, will remain valid only for a period of 10 years. Thereafter, it may be renewed by the trade mark proprietor on each 10th year anniversary, in perpetuity.

Trade marks that were registered before 28 July 2009 should have been renewed upon expiry of 10 years since the New Legislation came to force (i.e., on 28 July 2019), and every 10 years thereafter.

KEY OPPORTUNITIES & CONCERNS

- + Coffee and tea are established exports
- + Decision by President Nkurunziza not to seek another term will ease political tension and may reduce tribal discrimination and earn international good-will
- + Social services, particularly education and healthcare, require large-scale refurbishments
- The country's landlocked position limits export industries
- A lawless, dictatorial government is kept from committing genocide by a UN presence
- A massive refugee crisis will distort society until resolved politically



CAPE VERDE

KEY OPPORTUNITIES & CONCERNS

- + While the islands are currently popular with European tourists, the tourism industry has not reached its full potential
- + Fishery resources are plentiful, particularly lobster and tuna indigenous to the islands' coastal waters
- + New food-growing technologies if deployed can eliminate costly food imports
- Water shortages have always been part of island life, and must be overcome for economic growth
- A shortage of skilled workers resulting from emigration, has complicated the establishment of local businesses that can in turn draw back immigrants
- Climate change's effects of indigenous flora and fauna can harm tourism, while rising sea levels threaten to flood coastal areas where most people live



DEMOCRATIC REPUBLIC OF THE CONGO (DRC)

Treaties Joined

On 4 April 2019 Cape Verde took a monumental step in ensuring copyright protection for its authors by acceding to WIPO's three main copyright treaties:

- The WIPO Copyright Treaty ("WCT")
- The Performances and Phonograms Treaty (the "WPPT")
- The Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled (the "Marrakesh Treaty")

Cape Verde's instruments of accession were formally deposited with WIPO on 22 February 2019 and entered into force on 22 May 2019. The WCT and WPPT (together referred to as the "Internet Treaties"), as well as the Marrakesh Treaty, form the foundation of the current international copyright system.

This is an exciting development for Cape Verde, which has now formally entered the international creative digital marketplace as the 100th contracting party to the WIPO "Internet Treaties". These treaties were implemented to supplement the existing WIPO copyright treaties. They will enable Cape Verde to respond competitively to developments in the digital sphere by supporting the expansion and protection of its online creative industries and authors alike, as well as to benefit disadvantaged persons and authors and the organisations that support these individuals.

We look forward to seeing how local copyright law will be modified to ensure that Cape Verde complies with the requirements of these treaties, not only to ensure that the rights of its authors are vindicated and protected but also to guarantee the growth and protection of local participants in the international digital economy.

Positive Signs of Stability at the Registry

The turnover in appointments of Ministers of Trade, who oversee the Registry functions, has always had a negative impact on the processing of applications filed at the Registry of the Democratic Republic of the Congo (DRC). This is as a result of the requirement that the registration certificates must be signed off by the Minister.

Recently, the Ministry's office has seen increasing levels of stability, resulting in improved periods of application processing and the signing off and issuing of certificates.

This is encouraging for users bearing in mind that DRC is one of the African jurisdictions without complicated processing procedures, and it still provides for patent of importation, which enables foreign granted patents to be simply registered in the DRC.

KEY OPPORTUNITIES & CONCERNS

- + The end of the Kabila regime with the election of opposition candidate Felix Tshisekedi gives hope for a less corrupt administration dedicated to national unity and growth
- + The country is rich in mineral resources that may soon be more legitimately excavated in a less corrupt environment
- + The country's large population ensure a growing consumer demographic, and with mobile phone technology also growing retail transactions by phone are expected to reach US\$ 1 billion in 2025
- Significant parts of the country are destroyed or undeveloped due to decades of warfare and political strife
- Militant groups have been fighting in the country and looting its resources for so long their complete eradication will be a task
- A population impoverished by decades of corrupt government and armed warfare requires significant social interventions



EGYPT



INTA anti-counterfeiting workshop

KEY OPPORTUNITIES & CONCERNS

- + Egypt is strategically positioned between Europe, the Middle East and the rest of Africa, with the Suez Canal a gateway between West and East
- + Tourism continues to be an economic mainstay, with a large majority of international tourists to Africa choosing Egypt to visit
- + An improving economy is being led by communication and electronics technologies
- The Sisi administration's authoritarian actions are setting back democracy
- Islamic militants continue warfare in the Sinai
- Terrorists mount fatal attacks on the country's military and Christian churches

Egyptian Trade Mark Office Fee Increase on Hold

Official fee increases which were tabled in the ministerial decree No.179 dated 4 September 2019, were supposed to come into effect on 5 September 2019. However, this increase has not yet been effected and remains on hold.



Associate Office hosts INTA Anti-Counterfeiting Workshop

In June 2019, our Associate Office in Egypt, hosted an INTA anti-counterfeiting enforcement workshop. Organised by INTA, the theme of the workshop was '*Anti-counterfeiting: Enforcement & Coordination*', and formed part of a series of dialogues and meetings with key stakeholders in various African countries.

The workshop attracted government officials, private sector representatives, and local attorneys. Participants included representatives, from the Egyptian Customs Office, the Japan External Trade Organisation (JETRO) and the U.S. Patent and Trademark Office (USPTO). Areas of co-operation in efforts to stop counterfeits and illicit trade in Egypt were highlighted and discussed at the meeting.



Brand identification workshop



ESWATINI (SWAZILAND)

KEY OPPORTUNITIES & CONCERNS

- + Close ties with neighbouring South Africa provide a boost for the economy
- + While land reform is unlikely, much land is agriculturally-productive land and can be used for food exports
- + Tourism based on Swazi culture is established and has room to grow
- A corrupt, dictatorial government has a poor human rights record
- The worst-performing economy in Southern Africa with a small domestic market that discourages industrial growth
- Government survives through nepotism and patronage, but civil servants are only one missed pay check away from an uprising

Anti-counterfeiting training

During March 2019, at the request of the Royal Swaziland Police, our Anti-Counterfeiting Team met with senior members of the Police to assist in developing and strategizing anti-counterfeit operations throughout Eswatini during April 2019.

This meeting resulted in a Brand Identification Workshop being held with the Police during the first week of April 2019. The country wide operations during the last week of April 2019, focused on food related products, during which in excess of 10000 units of counterfeit goods were seized. These operations were well supported by both the local enforcement authorities and INTERPOL.



ETHIOPIA

Online Trade Mark Filing System Introduced in Ethiopia

The Ethiopian Intellectual Property Office (EIPO), in collaboration with the World Intellectual Property Office (WIPO) has adopted an online trade mark filing system. The development was borne of an agreement between EIPO and WIPO to modernise the IP system in Ethiopia.

The new system is expected to change the culture of doing business and obtaining trade mark registrations in Ethiopia.

There will be less reliance on hard copy records; therefore, the efficiency of EIPO is likely to improve overall.

The online system facilitates the filing of applications for the registration of trade marks. However, the prescribed fees and original supporting documents, such as legalised Powers of Attorney, which are still required, will need to be presented at the Registry by an agent once the online application has been reviewed and approved by an examining officer.



KEY OPPORTUNITIES & CONCERNS

- + Wise investment policy has given Ethiopia the title of East Africa's largest economy
- + Dynamic foreign policy that brought peace with Eritrea in 2019 and a Nobel Peace Prize to Prime Minister Ahmed has expedited investment
- + Spending on infrastructure has made Ethiopia East Africa's air transport hub, introducing modern urban light rail to Africa and boosting industry with industrial parks
- Agriculture land is limited and requires investment in new technology for better yields
- Ethiopia's landlocked placement geographically adds to shipping costs
- Education levels are low and skills tutoring is required for a modern workforce



The online filing system will, hopefully, contribute to the issuance of more accurate trade mark registration certificates.

The very first online trade mark application was filed by Adams & Adams, through our Associate Office, on the 8th of April 2019.

Partnership between Ethiopian Intellectual Property Office (EIPO) and European Patent Office (EPO)

The EPO has been expanding its footprint into the continent, signing a Memorandum of Understanding (MoU) with various African IP Offices. Recently, the EPO and EIPO signed a Biennial Work Plan, which is aimed at assisting the development of an Ethiopian national patent system, streamlining patent procedures, and building local capacity to ensure efficient and high-quality patent examination. In practice, the impact of this plan has been seen in the way applications filed at the EIPO have been processed and examined.

It appears that the two organisations are also looking into the possibility of entering into a validation agreement wherein patents granted at the EPO can be validated in Ethiopia. This will not be the first validation agreement that the EPO has signed with African Registry. North African countries such as Morocco and Tunisia have signed a validation agreement with the EPO.

The Tiff over Teff – Traditional Knowledge

Recently, the Ethiopian Ambassador to the United States of

America, Mr. Fitsum Arega, tweeted that the Court of The Hague had just handed down judgment in a matter in which two Dutch patents, concerning the processing of Teff, were held invalid for lack of inventive step. His tweet continued: "I hope we can learn from this that our national assets must be protected by Ethiopians & friends of #Ethiopia."

Teff is a nutrient-rich gluten-free grain that has long been an integral part of Ethiopia's heritage. It is used to make Injera, a pancake-like flatbread, which forms a staple part of the Ethiopian diet.

The Dutch patents were in the name of a company that is owned by Dutch businessmen who reportedly received traditional knowledge (TK) regarding Teff from Ethiopia. According to various media reports, the agreement would see the TK exploited in order to benefit both parties.

However, the businessmen were not party to the agreement in their personal capacities, but through a company that subsequently went insolvent. As a result, their contractual obligations to Ethiopia with respect to the TK were terminated. As such, the businessmen then assigned the patents into another entity's name and were able to exploit them free of any contractual obligations towards Ethiopia.

In South Africa, the Protection, Promotion, Development and Management of Indigenous Knowledge Systems Bill is currently before the National Assembly, awaiting final approval before being enacted into law. The Bill aims to protect South African TK and avoid situations, like the one previously mentioned, where TK is exploited by third parties, for no benefit to South Africa, and without legal recourse.



GHANA

KEY OPPORTUNITIES & CONCERNS

- + Ghana's entry into oil production has helped diversify the economy
- + The population enjoys good social services like health and education
- + Agriculture is a key sector whose production is marketed through good international trade links
- Government is involved in an offshore territorial dispute with Gabon centred on valuable oil reserves
- Poor city planning is the root of town woes, with some township slums scarcely inhabitable
- Youth unemployment, a result of widespread poverty, is leading to crime and a host of social problem

Registry Visit

In November 2019, Adams & Adams partner, Stephen Hollis, and Africa Practice Manager, Menzi Maboyi, travelled to Accra to visit our Associate Office, as well as the Ghana Registry. They met with the Assistant Registrar, Mr. Know Sessa Acquaye, to discuss Registry operations and outstanding matters. Mr. Acquaye provided an update on a number of challenges facing the Registry, and how they are planning to address them. For example, the engagement of more Legal Officers to help deal with the backlog of cases.



Left to right: Kofi Nyarko (Chief Executive Officer), Samuel Ohene Kankam (Programmer), Godsentina Gogo Tawiah (Assistant State Attorney), AnnMarie Ayanru (Assistant State Attorney), Olusola Ogundimu (Adams & Adams Ghana), Kow Sessa Acquaye (State Attorney), Stephen Hollis (Partner, Adams & Adams), Mark Adjabeng (Senior Company Inspector) and Menzi Maboyi (Africa Practice Manager, Adams & Adams)



Anti-counterfeit training, Accra, Ghana



Anti-counterfeiting training

In January 2019, Adams & Adams was invited to participate in and provide anti-counterfeit training by the World Customs Organisation as its National IPR Workshop hosted in Accra, Ghana.

The National IPR Workshop was well attended by a number of Ghanaian Customs officials and a great deal of interest was expressed by these officials for further training and co-operation with Brand Holders.



KENYA

KEY OPPORTUNITIES & CONCERNS

- + With a large ICT-advanced market, the country has a diverse economy geared for 21st century growth
- + A skilled workforce of nearly 20 million is also financially responsible, with 82% of Kenyans having bank accounts testament to a thriving financial sector
- + The energy sector is advancing with alternative energy initiatives
- Corruption and cronyism have compromised governance
- GDP growth has slowed in recent years and unemployment remains high
- The 2020 locust plague, the worst in 50 years, shows lack of preparedness for such emergencies as climate change brings erratic weather and drought



New Managing Director of Kipi to be Appointed

On Friday 29 November 2019, Mr Slyvance Sange's tenure as the Managing Director of the Kenya Industrial Property Institute (KIPI) came to an end. Mr Sange was appointed on 31 May 2014, initially in an acting capacity, but later permanently. Adams & Adams appreciated Mr Sange's support in attending the Adams & Adams Africa Network Meeting in 2013 and during our visit to KIPI in 2016.

The Deputy Managing Director of KIPI, Mr John Onyango, has been appointed as Acting Registrar by the Cabinet Secretary for Trade and Industrialisation.

Details about a permanent appointment will be communicated as and when developments occur.



If the shoe fits, wear it

In *Bata Brands SA and Bata Shoe Company (Kenya) Limited vs. Umoja Products Limited*, the Plaintiffs, Bata Brands SA and Bata Shoe Company (Kenya) Limited, claimed trade in a school shoe with a distinctive design for 15 years in Kenya under the trade mark TOUGHEES. The Plaintiffs sought *inter alia*, an injunction against the Defendant, *Umoja Products Limited*, on the grounds it was trading in a shoe bearing an identical or substantially similar design that would likely cause confusion or deception.

The Defendant argued that the Plaintiffs had not acquired any registered design rights under the Industrial Property Act, which legislation is the only law in Kenya that protects industrial designs. Therefore protection was not available for a shoe design under the common law.

The Defendant further argued that even if protection under the Industrial Property Act was available, it was not available in this case as shoes embodying the design had been on the market for 15 years, being the maximum term of protection of a design. The industrial design fell into the public domain.

In addition, the Defendant argued that passing-off was limited to unregistered trade marks and did not extend to designs. It further denied that any confusion would result from the sale of its shoe on the basis that they were sold under the trade mark SHUPAVU.

The Court, however, concluded that an unregistered design could indeed be the subject of passing-off. It accepted that a design, owing to considerable use, could be associated in the minds of the public with the goods to which the design is applied and therefore be distinctive of those goods. Additionally, it accepted that the use by a Defendant of the same design or a substantially similar design in relation to its goods may lead to confusion by misleading members of the public to believe that the Defendant's goods are those of the Plaintiff. The Court determined that the Defendant had not gone to any lengths to indicate those features of its design, which were distinguishable from the Plaintiffs' design and

had replicated the Plaintiffs' distinctive design. According to the Court, this amounted to a misrepresentation.

Despite these findings, the Court ultimately gave the Plaintiffs' the boot in relation to the injunction on the grounds that they were unable to prove a likelihood of irreparable harm that would not adequately be compensated by damages. The Court considered that the Defendant had been making use of the same design since 2014, and the Plaintiffs shoe sales had increased between that date and the institution of the suit.

Cross-examination possible in cancellation proceedings in Kenya

In *Biostadt India Limited vs. Osho Chemical Industries Limited*, Biostadt applied for the expungement of the WOKOZIM trade mark registered in the name of Osho concerning organic foliar fertiliser. However, it is not the cancellation proceedings per se that have broken ground in Kenya, but rather an unusual order for cross-examination of one of the witnesses who had deposed to a statutory declaration in the matter.

As there was a dispute of fact, Osho made an application for the cross-examination of the deponent to Biostadt's many declarations, who was its General Legal Counsel, based in India. The application was opposed on the grounds that it would delay proceedings, amount to a fishing expedition, and cause Biostadt to incur unnecessary additional costs. However, the Registrar of Trade Marks noted that, in terms of Section 54(1) of the Kenyan Trade Marks Act, evidence by way of oral testimony may be given in lieu of, or in addition to, evidence by means of a statutory declaration. Exercising its discretion in favour of Osho, the Registrar decided clarity was required on an issue relevant to the determination of the case and that, given that the issue had been appropriately identified, the cross-examination would not amount to a fishing expedition. The Registrar also felt that the advantages of continuing with the cross-examination outweighed the concerns that Biostadt had regarding the associated costs. Accordingly, the General Legal Counsel



of Biostadt has been ordered to attend the hearing of the expungement proceedings in person.

While cross-examination or oral testimony is unlikely to be the norm in proceedings before the Registrar in Kenya, it is worth bearing in mind that, in certain circumstances, it is justifiable and within the discretion of the Registrar to direct that a deponent travels to Kenya to provide oral evidence.

Expungement Application – CAT vs. AOT

In January 2016, Caterpillar Inc. filed an application for the expungement of Kenyan trade mark registration no. 82764 AOT (word & device) in class 25, in the name of Al Imran Investments Limited. The expungement application was based on the AOT & Device mark's confusing similarity to Caterpillar Inc.'s prior, registered and well-known CAT & Design trade mark, and the fact that the mark was being used on lookalike CAT shoes to create confusion.

The parties' respective marks:



The parties' respective shoes:



The matter was not defended, but Caterpillar Inc. was required to file evidence with the Registrar of Trade Marks and argue the issue at a hearing. On the 17th of September 2019, the Registry handed down a favourable decision, ordering the cancellation of the AOT & Device trade mark registration. In its ruling, the Registrar analysed the respective marks and held that they were visually and conceptually similar as both marks contained the letters "A" and "T", as well as a triangle device, which was a dominant component in both marks. Based on the similarity of the marks, as well as the respective goods in relation to which the marks had been registered, the Registrar found that Al Imran Investments Limited did not have a valid legal claim to the AOT & Device mark.

Although the outcome of the case was positive, the Registrar found that insufficient evidence had been furnished to prove that the CAT & Design mark was well-known in Kenya and, therefore, deserving of protection under Section 15A of the Trade Marks Act. In making this finding, the Registrar considered the WIPO Joint Recommendations Concerning Provisions of the Protection of Well-Known Marks, as well as the relevant provisions of the Trade Marks Act, and found that the requirements needed to prove a mark is well-known had not been met. However, this did not preclude a finding that the AOT & Device mark ought to be removed from the Register.

The Registrar also commented on the requirements for the authentication of evidence filed and stated explicitly that every annexure of a statutory declaration must be "properly sealed under the seal of the Commissioner as required by law", and that failing to do so the evidence may be declared inadmissible.



Brand protection training in Nairobi and Mombasa



Workshop delegates

Anti-counterfeiting training

In addition to having travelled to Kenya for a number of matters specific instances, during August 2019, we travelled to Nairobi and Mombasa to conduct Brand Identification Training with members of the ACA in Nairobi and Mombasa.

A number of ACA members from other towns travelled to Nairobi and Mombasa respectively to attend these sessions. Both sessions were very interactive, with the members raising various points and requesting assistance with specific instances. The Brand Identification Training was very well received by the attendees and numerous additional requests have been made by the ACA to conduct further trainings of this nature.



LESOTHO

Key opportunities & concerns

- + River water resources are plentiful and water exports to South Africa are major revenue earners
- + The country's rivers can also be harnessed for hydro-electricity production
- + Impressive mountainous topography offers potential for tourism growth
- The population is poor, unskilled and impacted by HIV/AIDS
- The country's internal market is too small and natural resources too scarce to support a thriving economy
- Governance is marred by perpetual scandals, military involvement through coup d'etats and election interference, and political violence



Search and seizure operations



Anti-counterfeiting search and seizure operations

In February 2019, we travelled to and met with the Deputy Commissioner of Police – CID and his members with a view to obtaining their assistance in conducted various search and seizure operations in the Kingdom of Lesotho on behalf of various of our clients.

As a result of this meeting, three (3) targeted search and seizure operations were conducted in March, September and October in the Kingdom of Lesotho seizing in excess of 18000 units of various counterfeit goods.



LIPO Offices



Menzi Maboyi, Africa Practice Manager, Adams & Adams (second from left), Ajie Amie Ceesay, Adams & Adams Liberia (centre) and Stephen Hollis, Partner, Adams & Adams (extreme right) with LIPO representatives



LIBERIA



KEY OPPORTUNITIES & CONCERNS

- + The country is again safe for foreign investment and the Weah administration is actively seeking investors
- + Fertile farmland can be exploited for agricultural exports, including timber forests
- + Liberian companies have been side-lined in the economy, though government is assisting their growth
- Education levels remain low, effecting worker productivity
- Reflecting the destruction of civil war and the Ebola outbreak, Liberia ranks a low 176 out of 189 countries on the 2019 Human Development Index
- Infrastructure is in dire need of rehabilitation after decades of neglect due to lack of financing

Registry Visit

In November 2019, Stephen Hollis (partner, Adams & Adams) and Menzi Maboyi (Africa Practice Manager) travelled to Monrovia to attend the ARIPO Admin Council Meeting. They also visited our Associate Office as well as the offices of the Liberia Intellectual Property Office (LIPO). As LIPO was hosting the 43rd ARIPO Administrative Council Meeting in Margibi County, which was some distance from Monrovia, the Director General of Liberia Intellectual Property Office (LIPO), Honourable Atty. Adelyn Cooper, was unable to meet with us at the LIPO offices, but in her opening address to the Administrative Council she was able to outline the plans of LIPO as Liberia assumed the position of Chair of the ARIPO Administrative Council for a two year term. The LIPO representatives that we met at the LIPO offices were able to discuss various aspects of the Registry's operations and highlighted operational and administrative issues being faced by LIPO. We were also able to highlight the issues being experienced by IP practitioners which LIPO was working to resolve.



MALAWI

KEY OPPORTUNITIES & CONCERNS

- + The land is agriculturally-productive and lends itself to expanded food production
- + The country faces no internal or external security threats and has achieved a stable government
- + Tourism has made inroads in the country and the industry is set for expansion at Lake Malawi and other key attractions
- The landlocked country has few natural resources to exploit
- Controversial 2019 election that led to a court challenge illustrates continuing tumultuous political landscape
- Rapid population growth hinders social and economic development

The Launch of the National Intellectual Property Policy

Malawi launched the National Intellectual Property Policy in May 2019. The Policy forms part of the government's Growth and Development Strategy III, which has identified industrialisation and the structural transformation of the economy as a key priority area, essential to maintaining long-term growth and economic development. The Policy acknowledges that IP has effectively been sidelined from the national development agenda since Malawi's independence, recognising IP as a catalyst for technological advancement, economic growth, and national development, while provides a framework to foster the generation, protection and exploitation of IP.

The Policy aims to address the deficiencies created by outdated IP laws and the antiquated institutions that administer and manage them while dealing with the lack of deliberate and coordinated policies. The Policy looks to leverage the IP system as a tool for stimulating the generation, protection, and commercialisation of IP assets, in turn, encouraging innovation and creativity for economic growth and development, while enhancing entrepreneurship and business competitiveness).

The Policy identifies five priority areas:

1. An effective institutional framework for modernising the administration of intellectual property rights. The Policy envisages the creation of a modern unified and autonomous agency responsible for the administration and management of IP in Malawi;

2. The generation and protection of IP assets. The Policy acknowledges that the output of locally generated IP rights is meagre and envisages the stimulation of locally generated IP rights through the provision of various types of incentives and funding;

3. The effective exploitation and commercialisation of IP assets. The Policy envisages, amongst other things, the creation of innovation centres or units as well as support structures for micro, small and medium enterprises;

4. An effective and balanced legal regime for IP rights. Here, the Policy envisages a review of Patent, Copyright, and Design legislation, the preparation of legislation and strategies for the protection and exploitation of traditional knowledge, genetic resources, and expressions of folklore originating from Malawi, as well as the implementation of the international agreements (such as TRIPS, etc) to promote the national interest;

5. IP awareness creation and capacity building. The Policy envisages the teaching of IP at school and tertiary level, the establishment of an Institute of IP Attorneys, the development of capacity for IP enforcement and dispute resolution as well as the coordination of IP enforcement activities, etc.

The Policy also identifies various stakeholders responsible for the implementation of each of these priority areas, providing times frames for the implementation thereof, as well as a monitoring and evaluation plan.



MAURITIUS

KEY OPPORTUNITIES & CONCERNS

- + As the economy becomes increasingly advanced, making Mauritius likely to be Africa's first high-income country soon, new technologies like renewable energy, ICT and deep water exploration are growing
- + High-end tourism attracted by tropical island environment, with spectacular golf courses now favoured for international tournaments
- + As part of economic diversification, the textile industry is expanding with trade access to the US market, while the finance sector has grown impressively
- Transportation is a consideration because of distance from the African mainland and trade routes
- Climate change presents a long-term danger with rising sea levels
- All electricity must be locally produced, and 79% is generated from polluting fossil fuels



Mauritius – Good for Investment and IP Protection

In line with its growing relevance as an upper-middle-income economy, Mauritius' IP regime is getting a makeover.

In the pipeline for some time, the new Industrial Property Bill was finally passed by Parliament on the 30th of July 2019 and published in the Government Gazette on the 10th of August 2019. The Bill will come into effect once the effective date is proclaimed – this is expected in the coming months.

Although the new Bill will not bring about significant changes to the landscape of traditional national trade marks, it does provide welcomed statutory clarity on certain aspects.

In this update, we touch on some of the changes with respect to trade marks, trade names, and Geographic Indications (GI's). Some of the headline changes and clarifications include:

- Recognition of certification marks and a procedure for the registration of such marks.
- GI's are recognised as a separate form of IP. Application, examination and opposition processes are prescribed, as well as provisions dealing with invalidation. The duration of the protection of GI's will be 10 years.
- Specific provisions dealing with International Registrations (IR's) and to govern the registration process.
- The distinction between "service marks" and "goods marks" will fall away, and both are simply recognised as trade marks.
- The head of the Industrial Property Office will no longer be known as the Controller but as the Director.
- The creation of an Industrial Property Council which is to advise the Minister on Intellectual Property matters and to ensure cooperation in the formulation of IP policies for industry.
- Cancellation applications will no longer be filed with the Controller, but with the Industrial Property Tribunal.
- Specific reference is made in respect of the refusal to register a mark if it is inherently non-distinctive.
- Express prohibition on the registration of:
 - a) marks which solely designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production or of rendering of services, or other characteristics of goods or services;



- b) shape marks where the shape results from the nature of the goods or provides a technical result;
- c) terms customary in the relevant trade; and
- d) marks the use of which would be contrary to law.

- Recognition of prior use (unregistered rights) as a basis for opposition.
- Introduction of Honest Concurrent Use applications.
- Introduction of division of an application into two or more separate applications, each retaining their initial filing or priority date.
- Explicit provision for the amendment of goods and services in respect of a pending application and amendment of a mark not substantially affecting its identity.
- Introduction of a five-year prescription period on instituting infringement proceedings.
- Provision for a two-month period to correct a formalities defect in an application. The filing date allocated will be the date of correction and not the initial filing date.
- The deadline to respond to office actions and refusals has been extended to six months.
- Express six-month grace period for late renewals and provision for re-registration (restoration of a lapse registration) if done within one year of the expiry of the registration.
- Introduction of partial cancellation.

No changes are proposed to the current provisions dealing with trade names.

Businesses with a commercial interest in Mauritius should stay tuned and consider adapting their Mauritian trade mark strategies once the new Bill comes into force, particularly regarding IR's.

The expungement case in the Industrial Property Tribunal between Shangri-La Tours Ltd v Shangri-La International Hotel Management Limited (2019)

The Industrial Property Tribunal recently, in the expungement case of *Shangri-La Tours Ltd*, made several noteworthy comments and findings which may signal to investors that Mauritius is ready for investments and that they take IP rights seriously. The judgment contains more references to European Union (CJEU) and United Kingdom decisions than it does to judgments of the Mauritian Courts and Tribunals. The Tribunal took considerable guidance from such international decisions.



Brand identification training, Port Louis



Some noteworthy comments of the Tribunal are the following:

- PIDTA [Patents, Industrial Designs and Trademarks Act 2002] was introduced in Mauritius to show the commitment of the Government to create an investment friendly environment in the country, **while at the same time meeting their obligations towards the international community.**
- It is squarely up to an applicant for expungement to prove, on a balance of probabilities, that the registration of the relevant mark is contrary to one or more of the provisions of PIDTA. The onus of proof does not shift to the registrant upon mere bald allegations from the applicant. Furthermore, expungement applications must be assessed at the date of the application for expungement.
- The Tribunal also took cognizance of the fact that the trade mark registrant had registered the same mark in several other countries to support the finding that the relevant mark is not descriptive or non-distinctive.
- The registration of a company name is an entirely separate issue from the trade mark registration procedure – the registration of a company name does not provide a company with an exclusive right to use the name, or with priority right to register it as a trade mark. It also does not mean that the company name would be considered distinctive for trade mark registration purposes. This statement should be seen as a wake-up call to existing businesses to also register their corporate names in Mauritius, if they have not already done so.
- Fictitious places names are not geographically descriptive or unregistrable as trade marks.
- With respect to marks contrary to morality or public order, the position in Mauritius stretches beyond the limits set in decisions of the European Courts, and that morality must be interpreted to include the social and financial considerations (i.e. sharp business practice), in addition to the traditional criminal and religious considerations.

In all, international industrial property rights owners (particularly those who own trade mark rights) should take comfort in the strong comments of the Tribunal and its willingness to be guided by international precedents in arriving at its decision, which decision ultimately protected a foreign brand owner over a local company. It is hoped that this judgment will spur on / guide other judicial officers and law enforcement officials to adopt a similar policy guided mindset when dealing with intellectual property rights matters.

Anti-counterfeiting training

During November 2019, we travelled to Port Louis in Mauritius to conduct Brand Identification Training with officials of the Mauritius Revenue Authority ("MRU") as part of the annual REACT workshop.

The Workshop was well attended by the various officials from the MRU and the attendees expressed that this type of training is vitally important for them to effectively conduct their job. In accordance with this request, we are in discussions with the MRU to conduct further sessions during the course of 2020.



MOROCCO

KEY OPPORTUNITIES & CONCERNS

- + Long-established international trade links provide multiple markets for exports
- + Stability, low inflation and security have proved good for economic growth
- + Low-cost labour assists industrial pursuits and has spurred auto manufacturing
- King Mohammed must be sincere about transference of power to a democratic dispensation or eventually face revolution
- Rabat's claim of Western Sahara is opposed by the UN and much of the international community
- Education levels are low by North African standards, with fewer than two-thirds of Moroccan women able to read and write

OMPIC and WIPO sign Memorandum

On the 4th of October 2019, the Moroccan Office of Industrial and Commercial Property (OMPIC) entered into a Memorandum of Understanding (MoU) with the World Intellectual Property Organisation (WIPO) concerning the promotion of alternative dispute resolution mechanisms in the field of industrial property. The objective of the MoU will see OMPIC and WIPO pool their resources to promote the use of alternative dispute resolution mechanisms to resolve industrial property disputes. Alternative dispute resolution mechanisms have the benefits of being faster and more cost-effective. Such mechanisms would greatly assist small to medium-sized enterprises (SMEs) in resolving industrial property disputes. OMPIC's strategic vision is to promote the use of these alternative dispute resolution mechanisms by 2025.

Trade Mark Squatting in Morocco

In recent years, there has been a significant increase in trade mark squatters filing for the registration of well-known international trade marks in Morocco. In particular, one Harchi Khalid, has, in his name, or in the name of the entity named Plakton, filed several trade mark applications for various world-renowned marks, including cartoon/animated characters. In addition to the unauthorised filing of these trade marks, Harchi Khalid/Plakton has had the audacity to file oppositions to the legitimate applications of the rightful proprietors of well-known trade marks in Morocco. Although we have, in many instances, succeeded in opposing the unauthorised applications by trade mark squatters, trade mark proprietors are encouraged to anticipate the trend of trade mark squatting, by filing their trade mark applications as early as possible.

Trying to misappropriate the beloved Minions characters

The Moroccan Trade Marks Office ("TMO") recognised the notoriety of the well-known MINIONS characters in a recent decision. The matter concerned an opposition filed by Universal City Studios LLC (the "Opponent") against a trade mark application in classes 16, 18, 25 and 28 in the name of PLAKTON (the "Applicant"). The Opponent is a well-known American company that produces and distributes motion pictures and television programmes. The trade mark in dispute concerned the device of the well-known character in the Opponent's Despicable Me series, known as MINIONS (depicted on the next page).



This matter was particularly interesting, as the Opponent did not own any trade mark registrations in Morocco at the time. Accordingly, the Opponent had to rely on its prior use of the trade mark in Morocco, and argue that the trade mark is internationally well-known, including in Morocco, in terms of the Paris Convention. This was done by filing evidence which included copyright registration certificates, internet search results, proof of merchandise sold in Morocco and promotional material bearing the Opponent's MINIONS character mark. Three of the Opponent's franchise films, in which the MINIONS characters were featured, were shown in Morocco. Plakton's applications in classes 16, 18, 25 and 28 covered goods in respect of which the Opponent generally uses and registers its MINIONS marks worldwide.

Plakton failed to defend the opposition and the TMO in Morocco had to decide the matter on the papers before it. In Morocco, unlike many other jurisdictions, the TMO's decision is not made by default when a trade mark applicant fails to defend an opposition. Ultimately, the TMO found that the case made out by the Opponent was sufficiently convincing to reject the trade mark application. Accordingly, the application was rejected, and the Opponent's MINIONS mark was recognised as a well-known mark in Morocco.

MINIONS mark was recognised as a well-known mark in Morocco.

This is a victory for all trade marks proprietors against trade mark squatters in Morocco. The Opponent has also lodged oppositions to other applications filed by Plakton.

Paw Patrol

On 26 November 2019, the Moroccan Appeal Commercial Court dismissed the appeal and upheld a decision of the Trade Marks Office ("TMO"), in the matter between Spin Master Ltd and the trade mark applicant Plakton, in respect of the mark well-known PAW PATROL.

The matter involves an opposition by the "Opponent" to a trade mark application filed by Plakton for the PAW PATROL device in classes 16, 18, 24 and 25. As mentioned above, Plakton is a notorious trade mark squatter in Morocco. The Opponent is a Canadian toy and entertainment company, and also produces a number of animation series, including the well-known PAW PATROL series. The Opponent did not own any registered trade marks in Morocco at the time, and had to rely on the well-known status of the mark, to oppose Plakton's application.

It is important to note that it is not possible to rely on copyright in opposition matters in Morocco. Copyright is, however, a basis on which to institute cancellation proceedings. Unfortunately, the Registry did not agree that the Opponent's PAW PATROL characters are well-known, and the opposition was dismissed.

The Opponent proceeded to file a cancellation application in respect of Plakton's marks (which proceeded to registration, after the dismissal of the opposition). The cancellation application was based on the Opponent's copyright in its characters as well as the notoriety of the marks. As Morocco is a member of the Paris Convention, in its Paw Patrol characters and logo was recognised as well-known in terms of Article 6bis of the Paris Convention.

The TMO delivered its decision on 10 June 2019 and ruled in the Opponent's favour. The court also ordered that Plakton ceases all use of the characters and be fined 5000 Moroccan Dirham for each violation. Plakton subsequently filed a belated appeal to the cancellation decision. The appeal failed, and a decision was again made in favour of the Opponent.

It is clear that the rights of trade mark proprietors of well-known marks will be protected in Morocco, but it is recommended that applications be filed for important marks, to avoid becoming involved in lengthy and costly opposition and cancellation proceedings.



MOZAMBIQUE

KEY OPPORTUNITIES & CONCERNS

- + As natural gas reserves go into production they will transform the economy
- + Heavy private and public investment in infrastructure accelerated to mitigate 2019 cyclone destruction
- + Mozambique's impressive natural attractions have yet to be fully exploited by an infant tourism industry
- The first insurgency of Islamic terrorists in Southern Africa has targeted northern Mozambique
- Poverty is pervasive, and economic growth must be channelled to uplift all Mozambicans
- Climate change is worsening seasonal flooding in the south, threatening offshore coral reefs and making storms more deadly

Tommy Flange

The Mozambique Trade Mark Registry has found in favour of Tommy Hilfiger Licensing B.V (the "Opponent"), on 23 January 2020, in an opposition against the registration of the trade mark TOMMY FLANGE, in class 25 filed by Hudsun (the "Applicant"). The Applicant is an entity that operates as a clothing store based in the capital of Mozambique, Maputo, offering a variety of clothing items and footwear. The Opponent is a premium clothing company, manufacturing apparel, footwear, accessories, fragrances and home furnishings and the proprietor of the well-known marks TOMMY HILFIGER, TOMMY and TOMMY HILFIGER & flag logo (depicted below) and of the flag logo (without wording). The Opponent has made extensive use of these marks internationally.



The Applicant filed a trade mark application in class 25, which wholly incorporated the registered TOMMY trade mark and which was argued to be confusingly similar to the TOMMY HILFIGER & flag logo device registered in the

name of the Opponent. The offending Application also incorporated a flag device consisting of the colours red and white (albeit in reverse), which the Opponent contended would be likely to lead to deception and/or confusion amongst members of the public. In addition, the application covered identical goods in relation to which the Opponent had registered its TOMMY HILFIGER flag logo and TOMMY trade mark in class 25 in Mozambique.

In its opposition papers, the Opponent argued that the word FLANGE did not adequately distinguish the application from the Opponent's well-known TOMMY HILFIGER flag logo and TOMMY trade marks. Additionally, the Opponent contended that the word FLANGE in terms of its dictionary meaning is described as a wide edge on a pillow, placemat or other fabric object. The use of the word FLANGE in relation class 25 goods, which include articles of clothing that are made from a variety of fabrics, is therefore, purely descriptive and does not serve to distinguish the mark from the Opponent's well-known TOMMY and TOMMY HILFIGER flag device trade marks .

The Applicant did not file a counter-statement in response to the opposition of the Application, and as a result, the trade mark registry ruled in the Opponent's favour and accordingly, the offending Application is deemed to be withdrawn.



NAMIBIA

KEY OPPORTUNITIES & CONCERNS

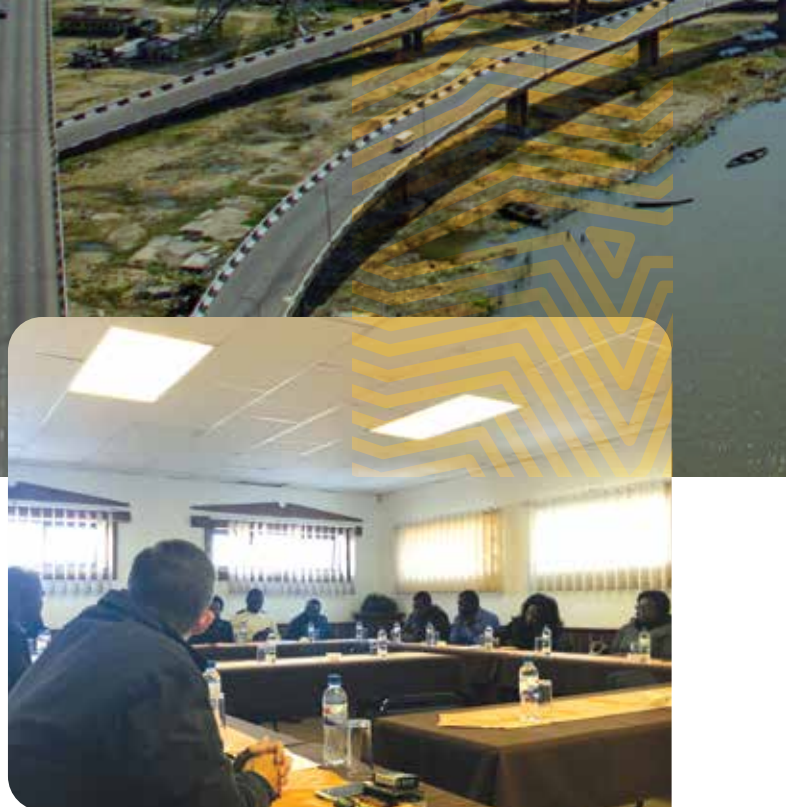
- + Significant mineral deposits exist on land and are being explored offshore
- + Transportation and construction sectors are growing in response to Namibia's increasing role as a regional transportation hub
- + Close trade ties with South Africa provide access to the region's large market, while foreign trade links exist for mineral and fish exports
- The economic recession was three full years in 2019, and while economists forecast an emergence from recession in 2020, economic fundamentals are problematic
- The mining economy's profitability is vulnerable to global commodity price fluctuations
- Poverty and youth unemployment remain high

Anti-counterfeiting training

During May 2019, we travelled to both Windhoek and Walvis Bay to conduct Brand Identification Training with officials of the Namibian Ministry of Finance, Department of Customs and Excise. Two separate sessions were conducted in Windhoek and Walvis Bay, the initial session a theoretical one focusing on identification of counterfeit goods and the processes to be followed and the subsequent session, a practical inspection and seizure of counterfeit goods from the market place.

In Windhoek, a number of businesses were inspected, and counterfeit goods identified, one of which was a known repeat-counterfeit-offender, alleged to be involved in numerous other criminal activities including rhino poaching and tax evasion.

In excess of 15000 units of counterfeit goods were seized during the two practical sessions in Windhoek and Walvis Bay, respectively.



Brand identification training, Windhoek



Search and seizure operation, Windhoek



NIGERIA

KEY OPPORTUNITIES & CONCERNS

- + Oil reserves and advanced oil industry infrastructure will earn significant revenue for years to come
- + Africa's most populated country offers a large domestic market with a large educated and affluent consumer base
- + A motivated local talent and entrepreneur class exists to exploit the country's trade links and diversify the economy from oil dependency
- Boko Haram brutal terrorist activities continue to destabilise parts of the country
- Government corruption is a significant drain on the country's resources and will take years of dedicated effort to alleviate
- The oil-based economy is not sustainable and has led to unpredictable levels of government revenue

INTA Workshop Promotes Further Positive Changes at the Registry

Following last year's release of the first-ever compendium of trade mark opposition rulings by the Registry, a workshop with senior trade mark officials was held in Abuja, in collaboration with INTA.

Simon Brown (partner) and Kelly Thompson (partner), together with local lawyers and a team from our Associate Office, provided training sessions to expand the knowledge of senior officials on trade mark prosecution and opposition issues, particularly focusing on international best practice.

One of the focal points of the workshop, which was held in April 2019, was to work towards changes in respect to the operational challenges faced by the Registry.

The trip also included visits to our Associate Offices in Abuja and Lagos.

WIPO Spec Drafting Workshop

Invited by WIPO, Johnny Fiandeiro, Adams & Adams partner, travelled to Lagos, in May 2019, to provide patent specification drafting training to members of the Nigerian Federal Ministry of Industry, Trade and Investment under which the Registry falls.

The workshop was arranged by WIPO but largely run by the Nigerian Federal Ministry of Industry, Trade and Investment. There were around 20 participants, mainly from universities and private practice from all parts of Nigeria. With little spec drafting experience, the participants were engaged, enthusiastic, and eager to learn.



Left to right: Garba Abdulazeez, Head of Search Unit (Registry), Simon Brown, Partner (Adams & Adams), Adamu Yauri, Registrar of Trade Marks, Representative from our Associate Office in Nigeria, Kelly Thompson, Partner (Adams & Adams), Salihu A. Yunusa, Examiner (Trade Marks), and Ogunbanjo A. Temitope, Head of Acceptance Unit



Workshop delegates



RWANDA

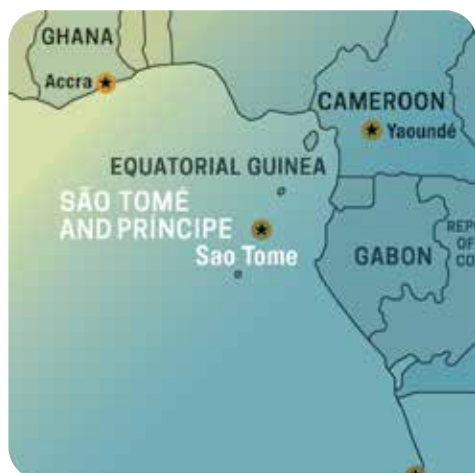
KEY OPPORTUNITIES & CONCERNS

- + A growing ICT sector and continuing foreign investments are facilitated by new industrial parks and industrial sector policy reform
- + Agribusiness has solid foundation in country's dominant agriculture sector
- + The tourism industry is founded on Rwanda's famous gorillas
- Landlocked country has erratic transportation links through some unstable neighbouring countries
- Largely rural peasant population requires training to meet employment demands of a modernising economy
- Success at creating a services economy and other economic policies depends on a vibrant East African Community

Trade Mark Renewal Exercise – Deadline Extended

In accordance with Rwanda Law No. 31/2009 on the Protection of Intellectual Property ("the Law") of 14 December 2009, all trade marks registered in terms of the old 1963 Act, i.e., **trade marks registered before 14 December 2009**, were to be renewed before the 14th of December 2019, to ensure those marks remain both valid and enforceable.

The Rwanda Development Board has since issued a waiver notice dated 31 January 2020 allowing trade mark owners a 10 month grace period to renew trade marks that were not renewed by the deadline of 14 December 2019. Therefore, the deadline for the renewal of trade marks registered before 14 December 2009 expires on **13 October 2020**.



SÃO TOMÉ AND PRINCÍPE

KEY OPPORTUNITIES & CONCERNS

- + Agriculturally-productive land is being well-managed for profitable exports
- + Tourism sector has good growth potential
- + Discoveries of offshore oil and natural gas reserves can start a local energy sector
- Fluctuating commodity prices can destabilise the cocoa and coffee exports as well as future oil and gas exports
- Islands' isolation off West Africa has made the country often invisible to business investors and tourists
- Poor rural infrastructure impedes economic and social growth



Registry Offices

Registry Visit

Adams & Adams' Mozambique partner, Elio Teixeira, travelled to São Tomé in São Tomé and Príncipe in November 2019 to meet with the Registrar of the National Intellectual Property and Quality Service (SENAPIQ), Mr. Domingos da Silva da Trindade. We were encouraged to learn of the Registry's computerisation project, supported by WIPO, which seeks to create an electronic database of the Registry's records. The aim is to complete the project within the first quarter of 2020. Completion of the project is set to improve the speed, accuracy and quality of registration certificates. The Registry now publishes journals quarterly, an improvement from the 3 editions published annually in the past.



SIERRA LEONE

KEY OPPORTUNITIES & CONCERNS

- + Iron ore excavation has resumed and the mining sector leads the economy
- + Better governance is improving the business environment
- + Electricity supplies are improving
- Food security awaits improvements in agriculture
- Widespread poverty characterises the population
- Sexual violence is so disruptive to society it was declared a national emergency in 2019



Trade Mark Prosecution: Update

The Registry is applying the provisions of the 2014 Act, although the date of the Act has not yet been made available.

As per our previous update, it is now possible to file for trade mark applications covering both goods and services. Under the previous Act, it was not possible to file for service marks; therefore, applicants may wish to file additional applications covering their services of interest.

The Act also makes provision for claiming priority rights under the Paris Convention and the filing of collective marks and well-known marks are now also recognised.

Marks are now registered for a period of 10 years from the date of filing.



SOMALIA

KEY OPPORTUNITIES & CONCERNS

- + Mineral and oil deposits await production once the country is fully secure
- + Arable land is capable of sustaining an agricultural export industry
- + Construction and communications are growth sectors
- Somalia-based terror group al-Shabaab continues bombings and attacks
- Armed conflict perpetuates a humanitarian crisis
- International maritime patrols required to keep coastal waters safe from piracy



Registry Operational

In January 2020, notification was received to the effect that the Somalia Registry was now operational and that it was now possible to file trade mark applications in Somalia.

The Ministry of Commerce and Industry had earlier indicated that trade mark registration would only commence after the enactment of new trade mark laws. However, through a Ministerial Decree issued last year, the Ministry has now provided for the registration of trade marks before the enactment of the new laws. The Decree does not outline the procedure for examination or opposition of applications. However, it is expected that the office will conduct relative examination.

We are advised by our agents that the Somali Trade Mark Registry is set up under the Ministry of Commerce and Industry (the Ministry). In this regard, the Decree by the Ministry providing the fees for trade mark registration seems to have enabled the Ministry to resume trade mark registration.

Regarding validity, the Ministry is relying on the laws that were previously in place in Somalia before the suspension of the government i.e., Law No. 33 of 1975 Trade Marks and Patents Law (which introduced the following Italian laws into the territory of Somalia):

- Ordinance number 3 of 1955 on trade marks;
- Ordinance no 1 of 1955 on patents;
- Ordinance number 2 of 1955 on industrial designs.

The Ministry is also relying on Law No. 66 of 1977 (the Copyright Law).

The major concern is that the Ministry officials had earlier indicated that trade mark registration would only commence after the enactment of a trade mark law. This no longer appears not to be the case.

The Ministry is only accepting single class trade mark applications. Further, it appears that the current edition of the Nice classification is now applicable, although previously, the "Old Italian Classification", which consisted of 49 classes, was adopted.

The requirements to file a trade mark are as follows:

- Representation of the trade mark;
- Specification of goods;
- Name and address of the proprietor;
- A copy of a simply signed Power of Attorney form.

Please also note that the timeline from application to registration in Somalia is approximately two to three months. We still await clarity from the Ministry on the procedure for examination and oppositions.

Lastly, note that the publication of cautionary notice is still available as a means of informing the public of a proprietor's IPRs.

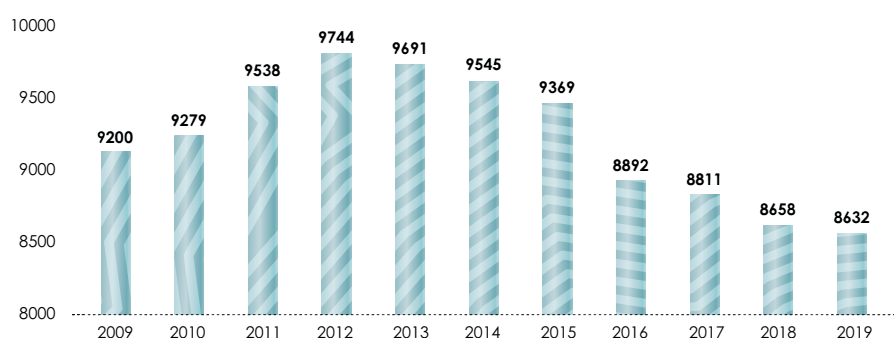


SOUTH AFRICA

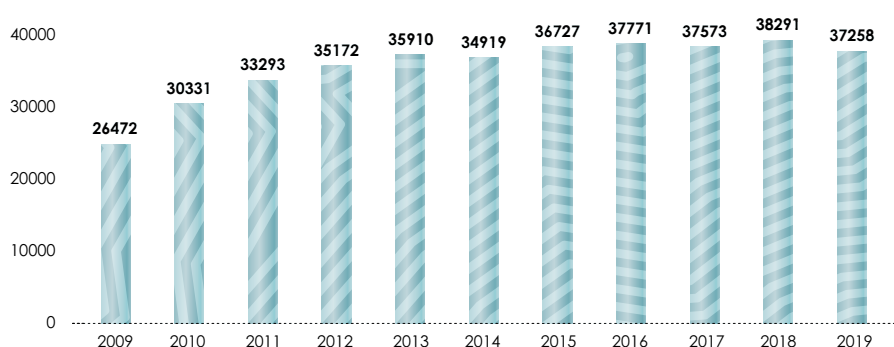
KEY OPPORTUNITIES & CONCERNS

- + As illustrated by the success of President Ramaphosa's 2019 Investors Summit, international investors are drawn to the country's multi-sectored, diverse economy
- + South Africa's businesses and government embrace technological advances and lead Africa in ICT
- + The export-driven economy will benefit from the new African Continental Free Trade Area
- Under the last president the ruling party saw a reign of corruption that undermined national institutions and will take years to correct
- Unemployment, especially youth unemployment, is high and represents the economy's biggest challenge
- Tension over economic and social inequities is high and is manifested in a potential government "land seizure without compensation" policy

Patent Applications Filed 2009 - 2019



Total Trade Mark Filings 2009 - 2019





Trade marks: Classification of goods and services

Version 2020 of the 11th Edition of the NICE Classification of Goods and Services will apply to all trade mark specifications, effective 1 January 2020.

Trade marks: Examination

Version 3 of the Guidelines on the Examination of Trade Mark Applications came into effect as of 20 March 2019, and an updated version (Version 3A) came into force on 6 August 2019.

Madrid Protocol

Cabinet has approved the submission of the Madrid Agreement on the International Registration of Marks (1989) to Parliament for ratification. The enabling legislation now has to be finalised and approved. It is expected to take some months.

Performers Protection Amendment Bill and the Copyright Amendment Bill

President Cyril Ramaphosa is yet to sign the highly controversial Performers Protection Amendment Bill and Copyright Amendment Bill. Various interest groups have raised concerns regarding the two Bills, particularly the provisions relating to fair use.

There has also been added pressure from the US government as a result of these Bills and it is scheduled to hold public hearings to determine South Africa's eligibility to participate in its Generalised System of Preferences (GSP), the largest and oldest American programme that provides nonreciprocal, duty-free tariff treatment to specific products imported from designated beneficiary developing countries (BDCs).

If South Africa's eligibility to participate in the GSP is revoked, it could result in significant economic losses for the country. President Ramaphosa is said to be applying his mind to the Bills and studying the submissions he received from the Ministers of Trade and Industry and Arts and Culture.

Protection, Promotion, Development and Management of Indigenous Knowledge Act 6 of 2019

The Protection, Promotion, Development and Management of Indigenous Knowledge Act 6 of 2019 has been promulgated but is yet to come into operation. The commencement date will be determined by the President in the Government Gazette by proclamation.

The purpose of the Act is to provide for the protection, promotion, development, and management of indigenous knowledge; the establishment and functions of the National Indigenous Knowledge Systems Office; the management of rights of indigenous knowledge communities; the establishment and functions of the Advisory Panel on indigenous knowledge; access and conditions of access to knowledge of indigenous communities; the recognition of prior learning as well as the facilitation and coordination of indigenous knowledge-based innovation.



Indigenous Knowledge Bill

On the 1st of November 2019, the Khoisan community, represented by the National Khoisan Council (NKC) and the South African San Council (SASC) signed a benefit sharing agreement with the Rooibos industry, represented by the South African Rooibos Council (SARC), which will see the Khoi and San community finally benefiting from the commercialisation of the indigenous tea. This has been widely acclaimed as an extraordinary step in the protection of traditional knowledge in South Africa.

The Supreme Court of Appeal Affirms the Test for Inventiveness

This case involved two companies in the mining industry, and more specifically, in relation to the steel conveyor belts used in the sintering process of metals.

Briefly, sintering is partly described as heating a mixture of metal powders having different melting points. In order to heat the metal powder mixture, an endothermic gas can be used.

Outotec registered a patent at the South African Patent Office, which described a steel conveyor with one of the integers being that a portion of the belt is perforated, interspersed with regions that are non-perforated, with the areas of perforation being about 20-60% of the total area of the conveyor belt. It was argued that the perforation allows for the gas to infiltrate the metal powder mixture, and thus the range of perforation can find the 'sweet spot' for sintering.

This case was an appeal from a decision made by the Commissioner of Patents in which the Commissioner dismissed an application for the revocation of the patent held by Outotec on the basis that the patent was both novel and inventive. This appeal was brought primarily on the challenge that the patent did not involve an inventive step.

The Supreme Court of Appeal (SCA) reiterated the South African legal test for determining if a patent includes an inventive step (i.e., is non-obvious), as described in the Ensign-Bickford case, namely,

- What is the inventive step,
- What was the state of the art of the relevant step at the earliest priority date,
- In what respect does the step go beyond, or differ, from the state of the art, and
- Having regard to such development or differences, would the step be obvious to the skilled man?

The Court considered the prior art and noted the primary difference was the range of perforation (20-60%), which was not included in the prior art. The Court then considered evidence of the expert witnesses and agreed with the appellant's expert witness, who concluded that the range is too broad to convey any advantage, preference, or importance related to the percentages, and thus would have been obvious. Accordingly, the Court concluded that the patent lacked an inventive step and upheld the appeal and revoked the patent.

TELLYTRACK v MARSHALLS WORLD OF SPORT (PTY) LTD & OTHERS – Copyright Infringement in Cinematographic Films

On 25 November 2019, the Supreme Court of Appeal delivered an interesting decision dealing with copyright infringement in cinematographic films. This case was an appeal from the KwaZulu-Natal Division of the High Court, Durban. What makes the decision particularly noteworthy is the detail the court went into in analysing what constitutes a cinematographic film and determining the elements that make up a cinematographic film.

In order to understand the intricacies of the case, it will be important to identify what the court of first instance had decided and the reason behind the appeal.



Brief summary on the facts and decision of *Court a quo*:

Tellytrack, a partnership consisting of three different companies which are racetrack operators, was seeking an interdict against the respondents, restraining them from showing national and international horse racing events at their business premises which are shown on Tellytrack Television which is a cable television channel, DSTV channel 239, available in South Africa.

Tellytrack stated that the Respondents were infringing various works by screening events shown on DSTV channel 239 to the public at its premises, without paying the subscription for the services. Tellytrack claimed copyright infringement in literary works, sound recordings, cinematographic films as well as computer programs and claimed for both an interdict and damages calculated on the basis of a reasonable royalty which would have been paid by a licensee in respect of the use of the works.

Tellytrack provided extensive evidence about the way in which its race feeds were created which came down to raw race feeds, slightly enhanced by computer software, essentially being transmitted within seconds of the live events.

The court took note of the definition of 'fixation' – that a work has to be fixed or reduced to some or material form before it can be eligible for copyright and the definition of cinematographic films as stated in *Golden China TV Game Centre & Others v Nintendo Co. Ltd*. The Court came to the conclusion that the Plaintiff's case must fail because there was no copying of work which was 'fixated' or stored (as required by the Copyright Act) when the Defendants showed the Tellytrack channel on their screens. As such, the Defendants were actually showing a broadcast and not a cinematographic film, given that the recording of the events happened concurrently with the transmission of the live event. In respect of the other works, the Court stated that the literary work, sound recording and computer-generated works do not have existence other than as part of the cinematographic film. Given that the Plaintiff claimed for copyright infringement in a cinematographic film and not a broadcast, the application failed.

Supreme Court of Appeal

The Court of Appeal reviewed the decision and came to a different conclusion. The main question in the Court of Appeal was whether Tellytrack was entitled to claim copyright in relation to the cinematographic films. In answering this question, the Court stated:

"There can be no doubt that what the public is allowed to see at the respondents' business locations are a sequence of images seen as a moving picture constituting in the main horse racing events. Those images and others, including those of studio interviews and the overlay of all the items imposed by way of the computer program, have indisputably been reduced to material form by way of the recordings on the aforesaid occasions. First, in relation to domestic races, two recordings were made at the OB van, second at the Tellytrack control room. In respect of international races, the recording is made of the complete product, including enhancements, at the Tellytrack control room. What is seen on channel 239 is what has already been recorded and stored at the OB van and the Tellytrack control room. At the time that a race event is seen on channel 239 it has already been recorded and stored, as described above."



It was on this basis that the Court found that what was seen on DSTV was a cinematographic film and not a broadcast. As such, Tellytrack was entitled to the interdict.

This case is welcomed considering there are not many cases on copyright coming out of our Courts.

Functional Design Registrations – The Definitive Statement is King

A decision concerning a functional design registration highlights the importance of a well-drafted definitive statement and explanatory statement, particularly where the definitive statement does not take the form of the often used omnibus-type format.

The applicant brought an urgent design infringement application against the respondent's floater based on its functional design registration. The dispute concerned whether or not the respondent's floater fell within the scope of the design registration as the respondent identified a number of features depicted in the drawings lodged in support of the design registration that were not taken by the respondent's floater. A feature that was taken by the respondent's floater was, however, described in the definitive and explanatory statements.

The court found that with regards to the definitive and explanatory statements, it was neither contemplated nor intended by the applicant that the general design, shape or form of the floater or the specific graphic rendering thereof was intended to be indivisible from the feature isolated in the definitive statement. Accordingly, the feature described in the definitive statement taken alone was found to be sufficient to infringe the design registration.

SANParks Mapungubwe

South African National Parks ("SANParks") opposed trademark applications which all incorporate the mark MAPUNGUBWE, such as MAPUNGUBWE SPIRITUAL SITES & elephant device in classes 41 and 45 in the name of Mapungubwe Game Reserve (Pty) Ltd, a company with a Swedish national as the sole director. SANParks is the proprietor of the mark MAPUNGUBWE NATIONAL PARK, registered in respect of a wide range of goods and services. The Applicant's marks all incorporated the dominant and distinctive element of the Opponent's registered MAPUNGUBWE NATIONAL PARK trade mark and the services covered by its applications overlap directly with the Opponent's registrations or are similar thereto. These applications were filed 3 years after SANParks registered its marks. The Opponent has made extensive use of its mark in relation to services covered by its registrations. It operates the MAPUNGUBWE NATIONAL

PARK which was previously known as Vhembe Dongola and in 2004 it changed the name to the current one. SANParks offers a variety of goods and services, game viewing, walks, night drives, guided walks to the MAPUNGUBWE Cultural Landscape. It offers accommodation at its various rest camps. The Opponent was also of the view that the Applicant cannot claim to be the bona fide proprietor of a mark incorporating MAPUNGUBWE.

The Applicant in turn contended that MAPUNGUBWE is the name of a place and a geographical location and as such no one party could claim exclusive rights in it. It was contended by the Opponent that the mark MAPUNGUBWE NATIONAL PARK retained its exclusivity as a trade mark in respect of the goods and services of interest and is not a geographical designation. No disclaimer was entered against the Opponent's trade mark registrations.



The High Court found that, due to SANParks' extensive use of its trade mark, it has gained distinctiveness and become synonymous with its proprietor. The use by the trade mark Applicant of marks incorporating MAPUNGUBWE in relation to the same or similar services would be prejudicial and/or harmful to SANParks. Consequently, its trade mark applications, all incorporating the mark MAPUNGUBWE, in classes 41 and 45 were dismissed with costs. The Trade Mark Applicant's application for leave to appeal was dismissed.



Brand identification training, Dar es Salaam



TANZANIA

KEY OPPORTUNITIES & CONCERNS

- + Construction industry at work expanding national infrastructure and ICT are economy-leading sectors
- + Busy, region-serving Dar es Salaam port exemplifies Tanzania's historic trade links with rest of world
- + A robust tourism industry is founded on Tanzania's game parks and scenery
- Autocratic actions of President Magufuli's administration have spawned human rights abuses
- A majority of Tanzania's population are poor and excluded from economic growth
- World commodity prices dictate profitability of agriculture sector, and hit sugar and forestry products in 2019

Anti-counterfeiting training

During October 2019, we travelled to Dar Es Salaam in Tanzania to conduct Brand Identification Training at the REACT workshop with the Fair Competition Commission ("FCC") officials to assist them in combating the sale of counterfeit goods in Tanzania.

The workshop was very well attended by the FCC, the Director General of the FCC, Dr John K Mduma was present and provided the opening address stressing the importance of combatting counterfeit goods and providing a further undertaking to continue to assist Brand Holders in protecting their Intellectual Property Rights in Tanzania.



TUNISIA



KEY OPPORTUNITIES & CONCERNS

- + A resilient and resurgent economy based on established trade links
- + The lucrative tourism sector is again performing well
- + The birthplace of the Arab Spring has reaffirmed its commitment to democratic reform
- Tunisia's neighbour Libya is a failed state and security problem
- Tunisia produces more ISIS recruits than any nation and ISIS terrorism remains a threat
- The failure of a coalition government in early 2020 several months after 2019 elections signals a nervous political scene

Increase in official trade mark fees

On 23 January 2020, the Tunisien Patent and Trademark Office (INNORPI) issued Decree no. 29/2020, in which it announced a 100% increase in official trade mark fees, effective as of 27 January 2020.



UGANDA

KEY OPPORTUNITIES & CONCERNS

- + New oil deposits can start energy industry development
- + Uganda has a well-developed, sound and well-regulated banking system which compares favourably with other developing countries in the world. Productive agricultural land is being targeted by government for sustainable commercial farming
- President Museveni's long hold on power is retained at the expense of political and speech freedoms
- Government corruption a problem for investors
- Inadequate electricity supply is hindering national development





Gilbert Agaba, Manager IP Directorate, URSB (second from left), Nishan Singh, Partner, Adams & Adams (5th from left), Maria Nyangoma, Senior IP Registrar, URSB (4th from right), Sarah Rukundo, Senior IP Registrar, URSB (3rd from right) and Abraham Ageet, Patents Examiner, URSB (2nd from right) with representatives from our associated offices

Registry Visit

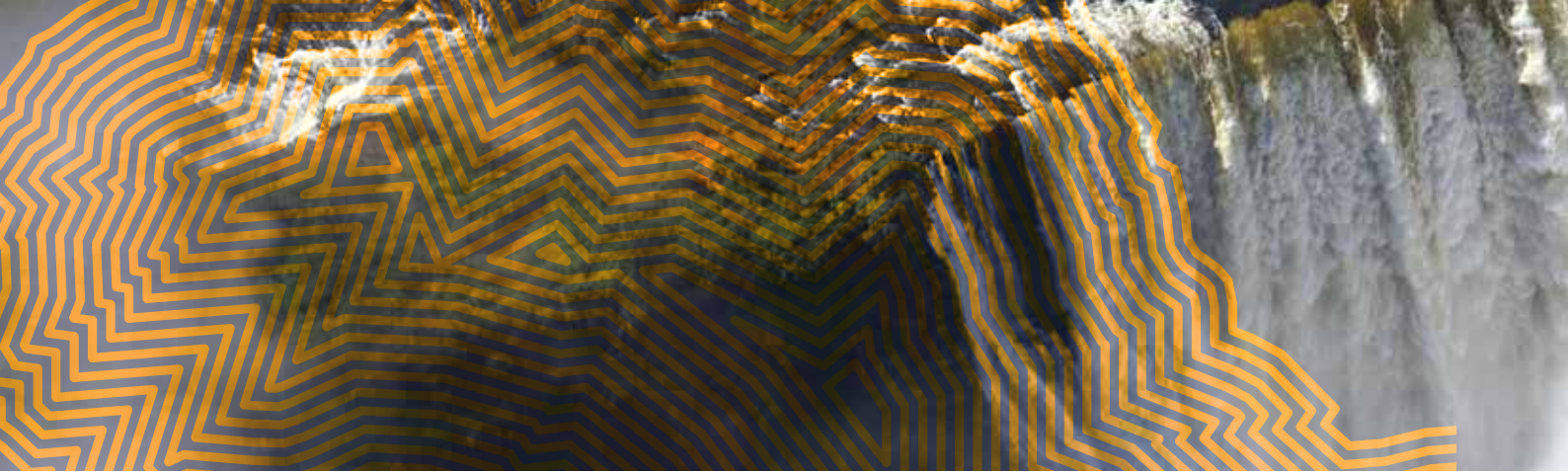
In December 2019, Adams & Adams Partner, Nishan Singh, attended a mediation hearing for a trade mark infringement matter filed at the Commercial Court in Kampala. He was accompanied by representatives from our associated firm. After the hearing, Singh visited the Uganda Registration Services Bureau (URSB), and met with the Manager of IP, Mr. Gilbert Agaba, to discuss Registry operations and outstanding matters.



ZAMBIA

KEY OPPORTUNITIES & CONCERNS

- + Zambia is world's second biggest copper producer and when world metal prices are high, the mining sector thrives, raising with it the national economy
- + The banking sector runs well and financial services are highly rated
- + The agricultural and tourism sectors have potential for growth
- Fluctuation of world commodity prices compromise profits of the economy's key mining industry
- A weak public healthcare system, particularly for the poor, has harmed worker productivity
- An erratic electricity supply is a bane to doing business



The enforceability of International Registrations in Zambia- Trade Marks Rights Not Getting 'Beta'?

In a recent decision of the Registrar of Trade Marks in Zambia in the matter of *Sigma-Tau Industrie Farmaceutiche Riunite* ("the Opponent") and *Amina Limited* ("the Applicant"), the Registrar held that international registrations ("IRs") under the Madrid Protocol designating Zambia are valid on the Zambian trade mark register. Furthermore, the Registrar held that the proprietor of an earlier IR designating Zambia may rely on that IR to oppose any later trade mark application. This decision has come as a surprise to many practitioners, given that the Madrid Protocol has yet to be domesticated into local law in Zambia.

The Applicant applied to register the mark **BETASOL** in class 5 in Zambia. The application was published for opposition purposes back in October 2015. The Opponent filed an opposition against the registration of the **BETASOL** mark on the strength of its earlier IR designating Zambia for the mark **BETNESOL**, also in class 5.

The Opponent argued that the **BETASOL** mark was visually, phonetically, and conceptually similar to its prior IR. Additionally, the Opponent argued that it had used, and continued to use its **BETNESOL** trade mark in Africa and worldwide in relation to a range of consumer pharmaceutical products.

One of the arguments raised by the Applicant in defence of its application was that an IR designating Zambia does not afford a basis on which to oppose an application to register a mark in the country. It argued that the Madrid

Protocol had not been domesticated through enactment or amendment of national legislation and for that reason, IRs were not enforceable locally.

In considering the status of IRs in Zambia, the Registrar held that an IR is "a trade mark that is already on the register" as required in terms of Section 17 of the Zambian Trade Marks Act, and "for all intents and purposes no different to an application filed locally".

The Registrar held that, since similar goods are involved, and there is a high degree of both visual and phonetic similarities between the marks **BETASOL** and **BETNESOL**, the opposition succeeded.

This decision may yet be taken on appeal, particularly since the Supreme Court of Zambia in the case of *Zambia Sugar PLC v Fellow Nanzaluka* held that, without domestication, foreign legal instruments cannot be enforced or applied in the country. Any attempted reliance on the Registrar of Trade Marks' recent ruling may well be attacked by future litigants on this basis.

Therefore, the prospects of proprietors of IRs successfully relying on this decision in the future to try to assert their rights in IRs in Zambia are not clear. Until the Madrid Protocol is domesticated into local law, the position is uncertain, and the best route is to secure national registrations in Zambia to ensure clear and enforceable rights.

Draft Copyright and Trade Mark Regulations under consideration

The Patents and Companies Registration Agency (PACRA) recently circulated long-awaited draft regulations and proposed fees in relation to the Copyright and Performance Rights Act (Laws, Volume 23, Cap. 406) and the Trade Marks Act (Laws, Volume 22, Cap. 401). Industry players were invited to make submissions in respect of these draft regulations. We participated and some of the proposals and submissions that were made, are set out:



- the proposed official fees for trade mark filings in Zambia, in comparison to the region, are very high. The official fees in the majority of the SADC countries are far lower than those now proposed in Zambia. It was submitted to PACRA that bringing the proposed official fees in line with those in Zambia's neighbouring would achieve uniformity in the region;
- there is a disparity between official fees for Zambian entities and nationals, and foreigners. The assumption is that this is to give some incentive to local rights holders to take steps to protect their trade marks locally. The Paris Convention for the Protection of Industrial Property, to which Zambia is a signatory, includes provisions on national treatment (Art 2) which state that members of Union countries must have the same advantages as nationals enjoy. We raised with PACRA that the application of different fees for nationals and foreigners is not in line with the spirit of the Paris Convention;
- the draft copyright regulations provide for the application of holograms to sound recordings and cinematograph works. This is a positive development in the fight against piracy.

As the drafting and consultation process continues, we continue to engage with PACRA.



ZIMBABWE

KEY OPPORTUNITIES & CONCERNS

- + Mineral and natural resources are extensive
- + Fertile agricultural lands can achieve former productivity with good management
- + A well-educated and skilled workforce is available for industrial expansion
- Unrelenting economic depression has created historically high unemployed and a foreign exchange crisis
- International sanctions are still in place against some government officials
- The country's politics is unsettled, security forces resort to violence against political protestors and human rights are problematic



Filing Trade Marks through ARIPO as an Alternative

Zimbabwe acceded to the Banjul Protocol on Marks (ARIPO) in 1997. As Zimbabwe has domesticated the Banjul Protocol, an ARIPO registration designating Zimbabwe is afforded the same rights as a national application.

National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number, is issued.



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National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number, is issued.

In comparison, once an ARIPO application, designating Zimbabwe, is filed, an official filing receipt should be available within a few days.

In terms of the Banjul Protocol, designated states have a period of nine months within which to refuse an application. Once this period expires and the application has not been refused by the designated state, it is deemed to have been accepted and will be published in the ARIPO Journal. Third parties have three months within which to oppose the application. ARIPO applications designating Zimbabwe are also published in the Government Gazette.

Given the current challenges experienced at the Zimbabwe Registry, we recommend that an application be filed at ARIPO designating Zimbabwe.

Enforceability of an ARIPO registration is dealt with in accordance with the national laws of the designated state.

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Adams & Adams developed a first-of-its kind for South Africa and Africa, KIPANGA® pro-active watching service which provides intelligent and screened information to assist brand owners in protecting their trade marks and securing their ability to trade in Africa jurisdictions. It has resulted in a more pro-active enforcement in South Africa and Africa for many of our global and local clients.

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