

Madrid Trademarks – Africa and Surrounding Islands – Changing Perspectives^[1]

The Madrid system, governed by the Madrid Agreement^[2] and Madrid Protocol^[3] is designed for trademark owners to secure protection in several countries by a single registration in their national Trademarks Office, followed by a deposit with the International Office at WIPO in Geneva, designating the other member states where protection is sought. In territories where it is effective, the International (Madrid) trademark registration (“ITMR”) provides a simple and inexpensive form of protection.

Because of these advantages 85 trademark jurisdictions are currently members of the Madrid Union, including 14 on the African continent plus the island states of Madagascar and Sao Tome & Principe^[4].

At the time of writing the members in Africa and surrounding islands are Algeria, Botswana, Egypt, Ghana, Kenya, Lesotho, Liberia, Madagascar, Morocco, Mozambique, Namibia, Sao Tome & Principe, Sierra Leone, Sudan, Swaziland and Zambia.

It must be stressed, however that ITMRs are not necessarily valid and enforceable in all African countries which have signed up to the Madrid arrangements. Complex issues are arising in several of them.

1. Algeria and Morocco

Under long-established laws and practices, ITMRs designating these countries are duly processed, recognised and effective.

2. Common-law Jurisdictions

Botswana, Ghana, Lesotho, Sierra Leone, Swaziland and Zambia:

2.1 “The Orthodox Doctrine”

In considering these territories, practitioners have been guided by the rule stated thus:-

An international agreement can only become part of the domestic law of a subscribing country, when it has expressly been enacted into that national law by an Act of Parliament.

There is no such reference to the Madrid arrangements in the national laws of any of the above. Accordingly our often-expressed view has been that an ITMR designating such a territory cannot lawfully be processed by the Registrar of Trademarks, nor can it be recognised or enforced in that jurisdiction. The only reliable protection is by means of a national trademark registration.

2.2 New Perspectives

2.2.1 In recent years, watchers of Africa and international bodies including ARIPO and WIPO have noted a tendency away from the orthodox doctrine. A typical section in WIPO’s model code says:

The provisions of any international treaties to which [country] is a party shall apply to matters dealt with by this [Act] and, in case of conflict with any provisions of this [Act], shall prevail over the latter.

2.2.2 Constitutionalists may debate whether a specialised statute can change a constitutional principle but evidently the section is there with a view to being obeyed. Versions of the model code have been enacted or proposed in numerous territories.

- 2.2.3** Even without new statutes, the official views in several jurisdictions seem to be diverging from the orthodox doctrine. The African Regional Intellectual Property Organisation (ARIPO) treaties raise similar questions to those discussed here. At the November 2009 ARIPO meetings in Botswana, representatives from Lesotho and Swaziland (as well as Namibia [see below] and Malawi) opined that the Banjul trademarks protocol is effective in their jurisdictions. Apparently, Madrid was not discussed and the opinions were not debated, but the delegates' statements are significant.

In the countries of this category, trademark owners can face ambiguities. ITMRs appear, from the Madrid Union viewpoint, to be available there; and may be alleged to conflict with national trademark applications or registrations. Nevertheless, in the absence of express changes to the domestic laws, the caution expressed in paragraph 2.1 above surely remains valid.

3. Egypt

The Madrid Agreement having been applicable to Egypt since 1952, the Protocol became effective on 3 September 2009. The relationship between Egypt's national laws and treaties such as Madrid and PCT has been debatable. It is thought by some that British dominance in the 19th and early 20th centuries created a common-law heritage with the result mentioned under paragraph 2.1 "The Orthodox Doctrine", above. On the other hand, a written constitution was adopted in 1980; and the Madrid treaties, like PCT, are recognised in practice without specific provisions in domestic law. Quite recently, the fact of official PCT recognition was illustrated by a notification dated 6 June 2009 clarifying the base dates from which annuities are calculated.

4. Kenya

Kenya, a common-law country, joined the Agreement and Protocol in 1998 but national law was not changed until 22 August 2003, when the Trade Marks (International Registration) Rules came into effect. It was thought for a time that ITMRs designating Kenya did not become effective until that date, and earlier designations could not be relied on. However, it is now established that pre-2003 ITMRs are enforceable but many are invisible to a searcher. A detailed review of the Kenya/Madrid situation is available on our web-site www.spoor.com.

5. Liberia

5.1 Background

Liberia acceded to the Agreement in 1995 and the Protocol on 11 December 2009. It was formerly grouped with the common-law jurisdictions in paragraph 2 above as the law, codified in 1972, made no provision for ITMRs.

5.2 New Law?

A new Industrial Property Act, dated 2003 but never passed by Parliament, was adopted by executive decision of the Industrial Property Office with effect from 1 January 2009. In it, the Madrid arrangements are recognised by implication, under the provision that:-

International treaties to which Liberia is a party shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, shall prevail over the latter.

5.3 Consequences

- 5.3.1** So far as it relates to national trademark registrations, we have taken a pragmatic view that the 2003 law should be accepted. Such rights existed under the former law and only details were changed by the new one.

5.3.2 We cannot advise relying on ITMRs whose effect, if any, rests upon their implied recognition in the 2003 measure which has not been enacted by the legislature.

6. Madagascar and Mozambique

These states have civil-law heritages. Madagascar joined the Protocol with effect from 28 April 2008. Mozambique acceded to the Agreement and Protocol in 1998. Although there are no detailed national regulations for dealing with ITMRs at the national offices, they are being processed. The Industrial Property Offices make it clear that they are recognised and will be enforced.

7. Namibia

7.1 Namibia acceded to the Agreement and Protocol in 2004. Customarily, it was regarded as a common-law country and grouped with the common-law countries as in paragraph 2 above, as the current law makes no provision for ITMRs.

7.2 But study of constitutional history reveals that on independence from South Africa it was enacted that *International agreements binding upon Namibia ... shall form part of the law of Namibia*. It appears that ITMRs ought, therefore, to be recognised.

7.3 The Namibian trade mark office apparently recognises ITMRs for some purposes, but not fully. They are recorded alongside, and may be cited against, national applications but are not being examined or advertised for opposition.

7.4 The Industrial Property Bill, tabled in April 2010 will confirm their validity and supply the necessary machinery, when it comes into force as an Act but the effective date cannot be predicted.

7.5 Therefore the effectiveness of ITMRs in Namibian national territory remains doubtful.

8. Sao Tome & Principe

It was announced in advance of the accession date, 8 December 2008, that the National Industrial Property Service would comply with the obligations of the Madrid Protocol. To reinforce the heritage of civil law, the Industrial Property statute specifies that

The terms of any international agreement relating to patents, industrial models or designs, collective trademarks and indications of provenance or names of origin to which Sao Tome & Principe is a contracting party are applicable [to Sao Tome e Principe], and in the event of divergence between them and this law, they shall prevail.

It is seen that trademarks other than collective marks are not mentioned but that omission seems to be accidental.

9. Sudan

9.1 Sudan inherited a British common-law system via Egypt. For years after it joined the Madrid Agreement in 1984, the Registrar stored notifications from the International Bureau and refrained from action on them, on the basis that under the orthodox doctrine and without amendment of national law, they were of no effect.

9.2 In recent times, however, the status of ITMRs has become fully accepted by the Office and the courts, apparently without any formal change to the constitution or Trademarks Act. It remains possible that the decisions upholding ITMRs may be challenged on appeal. Sudan has joined the Protocol with effect from 16 February 2010.

Summary

Numerous brand owners rely on International (Madrid) trademark registrations, designating countries such as some of the above where they are certainly or arguably ineffective. Those proprietors would be prudent in our view to secure their protection by means of national trademark registrations.

For further information, please speak to your usual Spoor & Fisher contact or email us at info@spoor.co.uk.

[1] *This review by Mac Spence, consultant with Spoor & Fisher Jersey, supplements and modifies earlier discussions on our website www.spoor.com.*

[2] *Madrid Agreement Concerning the International Registration of Marks (1891) amended through 1979.*

[3] *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989), amended in 2007.*

[4] *For a complete list, see http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf*



 Madrid Countries:

The countries indicated are members of the Madrid Agreement and/or protocol.
See accompanying article for details of each member's compliance with Treaty obligations.