

AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)

BANJUL PROTOCOL

ON MARKS 2018

amended by the Administrative Council of ARIPO

November 22, 2017

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PREAMBLE

We, the Contracting States of this Protocol:

Having regard to the Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO), concluded in LUSAKA, Zambia, on December 9, 1976;

In accordance with the objectives of ARIPO generally and in particular Article III(c), which provides for the establishment of such common services or organs as may be necessary or desirable for the co-ordination, harmonisation and development of the intellectual property activities affecting the members of ARIPO; and

Considering the advantages of pooling resources in respect of industrial property administration:

Hereby establish this Protocol to be known as the Banjul Protocol on Marks within the framework of the African Regional Intellectual Property Organization (ARIPO) and agree as follows:

SECTION 1 GENERAL

1:1 The African Regional Intellectual Property Organization (ARIPO) is hereby entrusted with the registration of marks and the administration of such registered marks on behalf of the Contracting States in accordance with the provisions of this Protocol.

1:2 In the exercise of its functions under this Protocol, ARIPO shall act through its Secretariat, hereinafter referred to as "the Office".

SECTION 2 FILING AND TRANSMITTAL OF APPLICATIONS

2:1 All applications for the registration of a mark shall be filed either directly with the Office or with the Industrial Property Office of a Contracting State by the applicant or his duly authorized representative.

2:2 Where-

(a) an application is filed directly with ARIPO but the applicant's principal place of business or ordinary residence is not in the host country of ARIPO; or

(b) an application is filed with the Industrial Property Office of a Contracting State by an applicant whose principal place of business or ordinary residence is not in a Contracting State; the applicant shall be represented.

2:3 Representation shall be by a patent or trade mark agent or by a legal practitioner who has a right to represent applicants before the Industrial Property Office of any of the Contracting States.

2:4 Where an application is filed with the Industrial Property Office

of a Contracting State, such office shall, within one month of receiving the application, transmit the application to the Office.

SECTION 3 CONTENTS OF APPLICATION

3:1 An application for the registration of a mark shall:

- (i) identify the applicant;
- (ii) contain, as prescribed, a representation of the mark;
- (iii) designate the Contracting States in which registration is being requested; and
- (iv) be subject to the payment of the prescribed fees.

3:2 The application shall indicate the goods and/or services in respect of which protection of a mark is claimed, including the corresponding class or classes provided for under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised. For this purpose the ARIPO Office will check that the applicant has made such indication of class or classes and that indication is correct and where the applicant does not give such indication or the indication is not correct, the ARIPO Office shall classify the goods or services under the appropriate class or classes of the latest edition of the Nice Classification on payment of a classification fee.

3:3 Where colour is claimed to be a distinctive feature of the mark, the applicant shall make a statement to that effect as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour.

3:4 Where the mark is a three-dimensional mark, the applicant shall make a statement to that effect and attach to the application a reproduction of the mark consisting of a two-dimensional graphic or photographic reproduction either of a single view of the mark or several different views of the mark.

3:5 The application shall contain a declaration of actual use of the mark or intention to use the mark, or be accompanied by an application for the registration of a person as a registered user of the mark; Provided that where there is an application for a registered user the Director General of the Office is satisfied that-

- (i) the applicant intends it to be used by that person in relation to those goods or services; and
- (ii) that person shall be registered as a registered user thereof immediately after registration of the mark.

SECTION 3bis FILING DATE

3bis:1 The Office shall accord as the filing date of an application the date on which the following indications or elements were received by the Contracting State in which the application was filed or received by the Office:

- (i) an express or implied indication that registration of a mark is sought;
- (ii) an indication allowing the identity of the applicant to be established;
- (iii) indications sufficient to contact the applicant or the applicant's representative, if any, by mail or any other safe/secure electronic means of communication;
- (iv) a clear reproduction of the mark;
- (v) a list of goods and/or services for which the registration is sought;

provided that the Office may accord as the filing date of the application the date on which it received the indications or elements referred to.

3bis:2 If the Office finds that the application does not comply with the requirements under 3bis:1, it shall notify the applicant accordingly, inviting the applicant to comply with the requirements within the prescribed period. If the applicant does not comply with the requirements within the said period, the Office shall refuse the application.

SECTION 4 RIGHT OF PRIORITY

4:1 An applicant or a successor in title shall have the right to claim priority rights provided under Article 4 of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised.

4:2 The right to priority shall subsist only when the application is made within 6 months from the date of the earlier application.

SECTION 5 FORMALITIES EXAMINATION; NOTIFICATION AND CONVERSION

5:1 The Office shall examine whether the formal requirements provided under Section 3 have been complied with.

5:2 If the Office is of the opinion that the application does not comply with the formal requirements, it shall notify the applicant accordingly, inviting him to comply with the requirements within a prescribed period. If the applicant does not comply with the requirements within the said period, the Office shall refuse the application.

5:3 If the application complies with all the formal requirements, the Office shall within the prescribed period notify each designated State.

5:4 Where the Office refuses an application or a reconsideration in terms of Section 5bis:1 is refused or an appeal in terms of Section 5bis:2 is unsuccessful, the applicant may within a period of 3 months from the date on which he receives notification of such refusal or result of appeal request that his application be treated, in any designated State, as an application according to the national laws of that State.

SECTION 5bis APPEALS

5bis.1 Where under Section 5:4 of the Protocol the Office refuses any application, the applicant may, within the prescribed period, request the Office to reconsider the matter.

5bis.2 If after the Office has reconsidered the application, the Office still refuses the application, the applicant may lodge an appeal against the decision of the Office to the Board of Appeal established in terms of Section 4bis of the Protocol on Patents and Industrial Designs Within the Framework of the African Regional Intellectual Property Organization (ARIPO) (the Harare Protocol).

SECTION 6 SUBSTANTIVE EXAMINATION BY A DESIGNATED STATE

6:1 Every application for the registration of a mark shall be examined in accordance with the national laws of a designated State.

6:2 Before the expiration of 9 months from the date of the notification referred to in Section 5:3, each designated State may make a written communication to the Office that, if a mark is registered by the Office, that registration shall have no effect on its territory on the basis of any grounds, both absolute and relative, including the existence of third party rights.

6:3 Where the designated State refuses the application under Section 6:2, it shall give reasons under its national laws for refusing the application. These reasons shall within 1 month of the decision being made be communicated to the Office which shall without delay communicate the same to the applicant.

6:4 The applicant shall be given an opportunity to respond through the Office, to the designated State concerned, to the decision to refuse the application. The decision shall be subject to appeal or review under the national laws of the designated State concerned. The appeal or review shall be filed through the Office. The decision upon appeal or review shall be communicated to the Office by the designated State

within 1 month from date of issuance.

6:5 A communication to the Office under Section 6:2 or a refusal by a designated State shall not prejudice the issuance by the Office of a certificate of registration having effect in those designated States in respect of which the application has not been subject to a communication under Section 6:2 or has not been refused.

6:6 Where a designated State which makes a communication under Section 6:2 subsequently withdraws it or where the designated State initially refused the application but subsequently accepts the same, the designated State shall within 1 month communicate this fact to the Office. In this case, the Office shall extend the registration to such designated State.

SECTION 6bis PUBLICATION; REGISTRATION AND NOTICE OF OPPOSITION

6bis.1 An application for registration of a Mark which has been accepted by any designated State or in respect of which any designated State has not made the communication referred to in Section 6:2 shall be published in the Marks Journal as having been accepted by the designated State or designated States concerned.

6bis:2 Subject to the provisions of Section 6bis.4, 3 months after the publication of the Journal referred to in Section 6bis.1, the Office shall register the mark on payment of registration fees. Such registration shall be recorded in the Marks Register and the Office shall issue to the applicant a certificate of registration.

6bis.3 The fact of registration of a mark shall be published in the Journal.

6bis:4 At any time after the publication in the Marks Journal of an application as accepted by the designated State or designated States in terms of Section 6bis:1 but before the registration of the mark in terms of Section 6bis:2, any person shall lodge a notice of opposition to the application for registration; which notice shall be filed with the Office. Thereafter, the application shall be treated according to the opposition procedures laid down under the national laws of the designated State or designated States concerned.

SECTION 7 DURATION AND RENEWAL OF REGISTRATION

7:1 The registration of a mark shall be for a period of 10 years from the filing date.

7:2 The registration of a mark may be renewed for further periods of 10 years on payment of the prescribed renewal fee.

7:3 The renewal of the registration shall be effected on or before the

date of expiration of the original registration or of the last renewal of the registration provided that a grace period of 6 months shall be allowed, in either case, on payment of a surcharge.

7:4 The registration of a mark which has not been renewed because of non-payment of renewal fees within the period stipulated in Section 7:3 shall be deemed to have lapsed and shall be removed from the Register.

7:5 A mark removed from the Register for non-payment of renewal fees may be restored at the request of the owner on payment of the prescribed restoration fee within the prescribed period.

SECTION 8 EFFECT OF REGISTRATION

8:1 The registration of a mark by the Office shall have the same effect in each designated State, with respect to rights conferred by the mark, as if it was filed and registered under the national laws of each such state.

8:2 The national laws of each Contracting State shall apply to the cancellation of a registration, whether based on non-use or any other grounds. Where registration has been cancelled, the Contracting State concerned shall, within 1 month of cancellation, notify the Office. The Office shall publish this fact in the Marks Journal and record it in the Register.

8.3 The indication of classes of goods or services provided for shall not bind the Contracting States with regard to the determination of the scope of protection of the mark.

SECTION 9 SUBSEQUENT DESIGNATIONS

9:1 Where a mark has been registered by the Office or is pending registration in the Office, the owner or applicant or, where applicable, his successor in title, shall have the right to designate any other State which becomes a party to this Protocol subsequent to the registration or filing of the application for registration of the mark.

9:2 Where, under Section 9:1, the owner of a registered mark or applicant for registration of a mark designates any other State which becomes a party to this Protocol, such subsequent designation shall be deemed to be an application for the registration of a mark with respect to the State so designated and shall accordingly be subject to examination under the national law of such designated State as provided for under Section 6 of the Protocol. In such a case, the filing date of the application in the State so designated shall be the same as the filing date of the earlier application. The date of

subsequent designations, if it complies with the applicable requirements, shall be the date on which it was received by the Office. The date of subsequent designations shall be recorded in the register and published in the ARIPO Journal.

9:3 The period of protection under the subsequent designation expires on the same date as the earlier registration.

SECTION 10 REGULATIONS

10:1 The Administrative Council shall make Regulations for the implementation of this Protocol and may amend them, as necessary.

10:2 Without derogating from the generality of Sub-section 10:1, the Regulations shall-

(i) stipulate any administrative requirements or any details necessary for the implementation of the provisions of this Protocol and any relevant international treaties;

(ii) prescribe fees to be charged by the Office and the details of the distribution of part of those fees among the Contracting States; and

(iii) provide the schedule of forms to be used in registration procedures.

SECTION 11 ENTRY INTO FORCE

11:1 Any State which is a member of ARIPO or any State to which membership of ARIPO is open may become party to this Protocol by-

(i) signature followed by the deposit of an instrument of ratification; or

(ii) deposit of an instrument of accession.

11:2 Instruments of ratification or accession shall be deposited with the Director General of ARIPO.

11:3 This Protocol shall come into force 3 months after 3 States have deposited their instruments of ratification or accession.

11:4 Any State which is not party to this Protocol upon its entry into force shall become bound by this Protocol 3 months after the date on which such State deposits its instrument of ratification or accession.

11:5 Any State which ratifies or accedes to this Protocol shall, by the instrument of ratification or accession, be deemed to have indicated its acceptance to be bound by the provisions of the Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO) and such State shall become a member of ARIPO on the date on which it deposits its instrument of ratification or accession to this Protocol.

SECTION 12 DENUNCIATION OF THE PROTOCOL

12:1 Any Contracting State may denounce this Protocol by notification addressed to the Director General of ARIPO.

12:2 Denunciation shall take effect 6 months after receipt of the said notification by the Director General of ARIPO and shall not affect any application filed prior to the expiration of the said 6 months period or registration of a mark effected upon such an application.

SECTION 13 AMENDMENT TO THE PROTOCOL

13:1 This Protocol may be amended at the instance of any Contracting State or by the Director General during the sessions of the Administrative Council of ARIPO.

13:2 Adoption of the amendments of any provision of this Protocol shall require a majority of two-thirds of the votes of all the Contracting States.

SECTION 14 SIGNATURE OF THE PROTOCOL

14:1 The Protocol shall be signed in a single copy and shall be deposited with the Director General of ARIPO.

14:2 The Director General of ARIPO shall transmit certified copies of this Protocol to the Contracting States, other member States of ARIPO and the States to which membership of ARIPO is open in accordance with Article IV of the Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO).