

**AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)  
REGULATIONS FOR IMPLEMENTING THE BANJUL PROTOCOL 2019**

amended by the Administrative Council of ARIPO

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## **Rule 1 Definitions**

For the purposes of these Regulations, unless the context otherwise requires:

A **"Mark"** includes a sign, name, word, device, brand, heading, level signature, letter, numeral or a combination thereof.

**"Administrative Instructions"** means the Administrative Instructions established by the Director General of the Office in accordance with Rule 17:4;

**"Application"** means an application for registration of a mark;

**"Assignment"** means transfer by act of parties concerned;

**"Board of Appeal"** means the Board of Appeal established under Section 4bis of the Protocol on Patents and Industrial Designs within the Framework of the African Regional Intellectual Property Organization (ARIPO) adopted at Harare, Zimbabwe, on December 10, 1982;

**"The Protocol"** means the Protocol on Marks within the Framework of the African Regional Intellectual Property Organization adopted at Banjul, The Gambia, on November 19, 1993;

**"Contracting State"** means the State that adheres to the Banjul Protocol;

**"Designated State"** means any State designated in an application in accordance with Rule 4;

**"Office"** means the Office of the African Regional Intellectual Property Organization (ARIPO);

**"Paris Convention"** means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1983, as revised and amended;

**"International Classification"** means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended;

**"Pending mark"** means a mark which is the subject of an application for registration;

**"Register"** means the Register of Marks kept under the provisions of the Protocol and these regulations;

**"Registered mark"** means a mark which is actually on the Register;

**"Registered user"** means a person who is registered as such under Rule 15:1;

**"Transmission"** means transfer by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being an assignment.

## **Rule 2 Conditions of Registration; Independence of Protection**

An application for the registration of a mark may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal has not been effected in the country of origin as defined in Article 6 quinquies A (2) of the Paris Convention.

## **Rule 3 Classification**

**3:1** Where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such an application shall result in one and the same registration.

**3:2** However, any designated State may declare that, notwithstanding Sub-rule 3:1 where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such application shall result in two or more registrations provided that each and every such registration shall bear a reference to all other such registrations resulting from the said application.

**3:3** A maximum of 50 words will be allowed for the goods listing of each class on an application. A prescribed surcharge per word will be levied for any additional word(s) after the 50th word.

## **Rule 4 Requirements of Application**

**4:1** An application for registration of a mark on Form No. M 1 shall contain:

- (a) a request for the registration;
- (b) the name and address of the applicant;
- (c) a designation of one or more Contracting States for which the registration is requested to have effect;
- (d) four copies of a representation of the mark; and
- (e) a list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification.

**4.2** Where applicable, a transliteration of the mark or of certain parts of the mark, or a translation of the mark or of certain parts of the mark shall accompany the application.

## **Rule 5 Application and Transmittal Procedures**

**5.1** The application for registration of a mark shall be made on Form No. M 1; where an applicant is represented, a power of attorney on Form No. M 2 shall be filed together with the application or within 2 months from the date of filing.

**5:2** If the Office finds that the application does not comply with the said requirements under Rule 4, it shall notify the applicant, inviting the applicant to comply with the said requirements within 2 weeks. Such notification shall be made on Form No. M 4C. If the applicant does not comply with the requirements within the specified period, the Office shall refuse the application.

**5:3** Where an application is filed with the office of a Contracting State, such State shall without delay transmit the application to the Office. Transmittal of the application to the Office shall be made on Form No. M 5. The applicant shall be notified of the transmittal on Form No. M 6.

#### **Rule 5bis Electronic Filing of Marks**

**5bis:1** A mark may be filed and processed in electronic form or by electronic means in accordance with the Administrative Instructions provided that the ARIPO Office or any Member States' Office shall permit the filing of applications on paper.

**5bis:2** These regulations shall apply mutatis mutandis to all applications filed in electronic form or by electronic means subject to any special provisions of the Administrative Instructions.

**5bis:3** The Administrative Instructions shall set up the provisions and requirements in the filing and processing of applications filed, in whole or in part in electronic form or by electronic means including, but not limited to, provisions and requirements in relation to acknowledgement of receipt, procedures relating to the according of a filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with offices and applicants.

**5bis:4** No Member State shall be obliged to receive or process ARIPO trademark applications filed in electronic form or by electronic means unless if the Member State has notified the ARIPO Office that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions.

**5bis:5** No Member State which has given the ARIPO Office a notification under Rule 5bis:4 may refuse to process an application filed in electronic form or by electronic means which complies with applicable requirements under the Administrative Instructions.

**5bis:6** Rule 5bis shall apply mutatis mutandis to other corresponding documents relating to all ARIPO applications.

## **Rule 6 Formalities Examination by the Office**

**6:1** The Office shall examine whether the formal requirements of an application have been complied with. If the Office finds that the application does not comply with the said requirements, it shall notify the applicant, inviting him to comply with the requirements within 2 months. Such notification shall be made on Form No. M 4. If the applicant does not comply with the requirements within the specified period, the Office shall refuse the application.

**6:2** If the Office refuses an application, the applicant may, within 3 months from the date of refusal, request that the application be treated in any designated State as an application according to the national law of that State. The request for conversion of the application to a national application shall be made on Form No. M 7.

**6:3** An application that complies with the formal requirements shall be transmitted by the Office to all the designated States for examination in accordance with the national laws of a designated State. The transmittal of applications shall be made on Form No. M 8. The applicant shall be notified of such a transmittal to designated States on the same form.

## **Rule 6bis Time Limits**

**6bis.1** The prescribed period referred to in Section 5bis:1 of the Protocol within which the applicant may request the Office to reconsider the matter shall be 2 months after the date of notification of the decision of the ARIPO Office that the application has been refused.

**6bis:2** The applicant may lodge an appeal against decisions of the Office to the Board of Appeal within 3 months after the date of notification of the decision of the Office.

## **Rule 7 Representation of the Mark**

**7:1** The representation of the mark shall be affixed on Form No. M 1.

**7:2** Where the mark consists of letters, words, numerals or punctuation signs and no special graphic features are claimed, the said elements may be reproduced by typewriter in the appropriate space in the form. One copy of the representation of any other two-dimensional mark shall be affixed to the appropriate space in the form.

**7:3** Where the mark is three-dimensional, the application shall contain an indication to that effect according to Section 3:4 of the Protocol.

**7:4** The representation of the mark shall be clear and of a durable nature. It shall be capable of direct reproduction by photography,

electrostatic processes, photo effect, microfilming and other electronic means of reproduction.

#### **Rule 8 Right of Priority**

**8:1** An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in or for a Convention country shall include in his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in or for which he or his predecessor in title filed such application and shall within 3 months furnish a copy of the earlier application certified as correct by the appropriate authority with which such earlier application was filed.

#### **Rule 9 Subsequent Designations**

**9:1** The application for a subsequent designation as provided in Section 9 of the Protocol shall be made on Form No. M 3 and shall be subject to payment of the prescribed fee.

#### **Rule 10 Fees**

**10:1** An application for registration shall be subject to payment of the prescribed fee. The fees payable for application, registration, renewal and other matters incidental thereto are contained in Schedule I to these Regulations.

**10:2** The distribution of fees between the Office and the States designated in the application shall be fifty percent to the Office and fifty percent to those designated States. The sharing of fees between designated States and the Office will apply only to those designated States which choose to do so.

**10.3** Any Contracting State may declare that, in connection with each application filed under the Banjul Protocol, and in connection with the renewal of any such registration, it wants to receive, instead of a share in the fee charged by the ARIPO Office, a fee (hereinafter referred to as "the individual fee") whose amount shall be indicated in a declaration, and can be changed in further declarations.

**10.4** A contracting State that makes or has made a declaration under Rule 10.3 of the Protocol shall notify the Director General of the individual fee to be charged.

**10.5** The individual fee received by the Contracting State may not be higher than the equivalent of the amount which the said Contracting State's office would be entitled to in a national application.

### **Rule 11 Examination by a Designated State**

**11:1** For the purposes of examination under Section 6, a written communication shall be made by the designated State on Form No. M 9 or Form No. M 9B whichever is applicable.

**11:2** The applicant may respond to the communication referred to in paragraph 11:1 on Form No. M 9C within 2 months from the date of notification.

**11:3** The designated State shall respond to the communication referred to in paragraph 11:2 within 2 months from the date of notification failure to which ARIPO shall proceed with the registration of the mark.

### **Rule 11bis Publication of Applications in the ARIPO Journal**

**11bis.1** Where an application for registration of a mark 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, the Office shall, as soon as possible, cause the application, to be published in the ARIPO Journal for 3 months.

**11bis.2** The published application shall contain the following information:

- (a) the number of the application;
- (b) the filing date of the application;
- (c) the class or classes, or the goods or services, to which the mark relates;
- (d) the name of the applicant;
- (e) if the applicant has an agent, the agent's name;
- (f) designated state(s); and a
- (g) reproduction of the mark.

### **Rule 12 Duration and Renewal of Registration**

**12:1** The registration of a mark shall be for a period of 10 years from the filing date. The registration may be renewed for further periods of 10 years each on payment of the renewal fee.

**12:2** The renewal fee shall be paid within 12 months preceding 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.

### **Rule 13 Changes in Registered Particulars**

**13:1** Request for the recording of change, such as, transfer, partial assignment for some of the goods and services or for some of the countries, cancellation of the registration, voluntary cancellation

in respect of some of the countries concerned, limitation of the list of goods and services, or change in the name and address of the owner, shall be presented in a single copy, dated and signed by the applicant or his representative on Form M 11.

**13:2.** The request for recording of change shall in all cases indicate-  
(a) the number of the mark concerned; and  
(b) the name and address of the owner of the registration or his representative.

**13:3** When the change in ownership results from a contract, the Office may require that the request indicate that fact and be accompanied by one of the following:

(a) a copy of the contract, which shall be certified by a notary public or any other competent public authority as being in conformity with the original contract;

(b) an extract of the contract showing the change in ownership, which extract shall be certified by a notary public or any other competent public authority as being a true extract of the contract;

(c) an uncertified certificate of transfer signed by both the holder and the new owner; or

(d) an uncertified transfer document signed by both the holder and the new owner.

**13:4** The request shall be accompanied by the prescribed fees or an undertaking to pay such fees.

#### **Rule 13bis Restoration of a Mark**

**13bis.1** The registration of a mark which has not been renewed for non-payment of renewal fees and which has lapsed and has been removed from the Register may be restored at the request of the owner

**13bis.2** A request for restoration of a mark removed from the Register for non-payment of renewal fees shall be made on Form No. M 15 and shall be accompanied by a restoration fee. The request shall be made within 6 months of the removal of the mark from the Register.

#### **Rule 14 Registration of Licences, Assignments and Other Similar Rights**

**14:1** The Office shall register assignments, licences and other similar rights pertaining to marks registered or whose registration has been applied for under the Protocol.

**14:2** However, where such assignments, licences, registered user or other similar rights affect only one Contracting State, an application to register such right may be made to the office of the Contracting State concerned or to the Office. Where the application to register



such right has been made to the office of the Contracting State, the office shall, within 2 months of registration of such right, provide the Office with the particulars of such registration using Form No. M 13.

**14:3** The registration of assignments, transmission or other form of transfer shall be made on Form No. M 15. The application to register a licence or other similar rights shall be made on Form No. M 16, while an application for registration of a registered user shall be made on Form No. M 17.

#### **Rule 15 Registration and Publication**

**15:1** Registration of a mark shall entail recordal in the Register and publication of the mark in the ARIPO Journal. The following particulars shall be recorded in the Register of Marks in respect of each registered mark:

- (a) the number of the application;
- (b) the name and address of the owner of the registration;
- (c) the name and address of any authorized agent;
- (d) the date and number of registration;
- (e) designated States;
- (f) any change with respect to the above; and
- (g) representation of the mark.

**15:2** Every alteration, renewal of a registration, registration of licences, assignments and other similar rights pertaining to a mark shall be recorded in the Register and published in the Journal.

**15:3** The applicant shall be issued with a Certificate of Registration, on Form No. M 12 and a copy of the certificate shall be transmitted to each designated State.

#### **Rule 16 Amendment**

**16:1** These Regulations may be amended, at the instance of the Director General or of any ARIPO Member State which is a Contracting State, during the Administrative Council sessions.

**16:2** The decision to amend these Regulations shall be by a simple majority of Contracting States.

**16:3** Every amendment to these Regulations shall be notified to the Contracting States by the Director General.

#### **Rule 17 General Provisions**

**17:1** Communications between the Office and the industrial property offices of Contracting States on matters relating to the Protocol and

these Regulations shall be effected direct and by registered mail or any other safe/secure electronic means of communication.

**17:2** Communications between the Office and the Courts or other authorities of Contracting States on matters relating to the Protocol and these Regulations shall be effected through the intermediary of the industrial property office of the said States.

**17.3** At any stage of any proceedings before the Office, the Director General may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.

**17.4** The times or periods prescribed by the Protocol and these Regulations for doing any act or taking any proceeding thereunder may be extended by the Director General if he thinks fit, upon such terms as he may direct, and such extension may be granted although the time or period for doing such act or taking such proceeding has already expired.

**17:5** The Director General of the Office may establish Administrative Instructions which shall deal with details in respect of the application of these Regulations. Administrative Instructions so established shall not be in conflict with the provisions of the Banjul Protocol and these Regulations.

**Schedule I Fees**

**Part A: Fee Structure Declarations by Contracting States**

**Part B: Regional Fees Structure**

The Regional Fees will remain the same as indicated in the Table below.

	<b>Matter or Proceeding</b>	<b>Amount of fee (US \$)</b>	<b>Corresponding Form</b>
1.	Authorization of Agent (Power of Attorney)		No. M 2
2.	Application for Registration of a Mark		No. M 1
	(a) Paper filing	100.00	
	(b) Electronic filing (including 20% reduction)	80.00	
	(c) For one mark		
	(i) In one class per D/S	50.00	
	(ii) In every additional class per D/S	10.00	
	(d) For every additional mark		
	(i) In one class per D/S	50.00	
	(ii) In every additional class per D/S	10.00	
3.	Later Designation per D/S	100.00	No. M 3
4.	Registration fee:		
	(i) In one class per D/S	100.00	
	(ii) In every additional class per D/S	50.00	
5.	Certificate of Registration		No. M 12
6.	Request for Renewal of Registration of a Mark:		No. M 10
	(i) In one class per D/S	100.00	
	(ii) In every additional class per D/S	50.00	
7.	Additional Fee for Late Renewal:		
	(i) In one class	20% surcharge	
	(ii) In every additional class	20% surcharge	
8.	Application to Remove Mark from Register for Non-use or to Rectify a Register Entry	20.00	
9.	Application for Change of Representative	50.00	No. M 11

10.	Application by Registered Proprietor to Strike out Goods or Services from those for which Mark is Registered per D/S	50.00	
11.	Request for correction of error(s), change(s), or alteration(s) of Application or Registered Mark: (a) For one class per D/S (b) For every additional class per D/S	50.00 50.00	No. M 11
12.	Restoration of a mark per D/S	100.00	No. M 14
13.	Application for Registration of Registered User: (i) For one class per D/S (ii) For every additional class per D/S	50.00 50.00	No. M 17
14.	Application by Registered Proprietor and Registered User of Mark to Vary Entry of Registered User: (i) For one class per D/S (ii) For every additional class per D/S	50.00 50.00	No. M11
15.	Application by Registered Proprietor and Registered User of Mark to Cancel Entry of Registered User: (i) For one class per D/S (ii) For every additional class per D/S	50.00 50.00	No. M17
16.	Request for Registrar's Certificate of Certified Copies of Entries in the Register of Documents or of Extracts	30.00	No. M18
17.	Inspection of the Register	20.00	
18.	Registration of assignments, transmission or other form of transfer (i) For one class per D/S (ii) For every additional class per D/S	50.00 50.00	No. M15
19.	Application to ARIPO to register a licence or other similar rights (i) For one class per D/S (ii) For every additional class per	50.00 50.00	No. M16

	D/S		
20.	Request for conversion of application into national application	50.00	No. M7
21.	Request for classification of a trademark in accordance with the latest edition of the NICE Classification	50.00	
22.	Search Fee	50.00	
23.	Request for extension (extension is calculated from date the action is due)	50.00	No. M19
24.	A surcharge per word for the goods listing of each class on any application after the 50th word	5.00 per word after 50	

**Schedule II Schedule of Forms (Omitted)**

**Schedule III International Classification of Goods and Services (Omitted)**