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Adams & Adams

AFRICA UPDATE

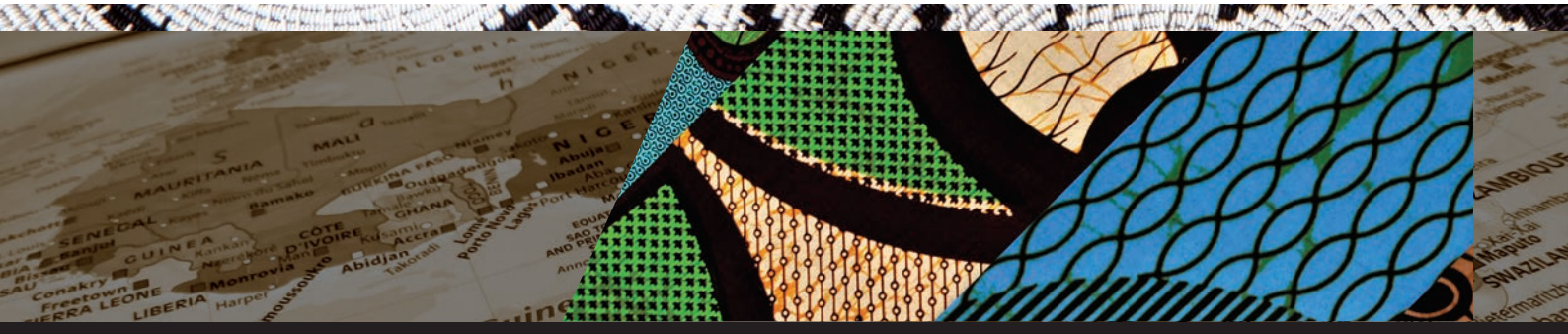
2017

+ COUNTRY UPDATES

+ IP CASE LAW REVIEW

AFRICA NETWORK
MEETING 2016





FOREWORD |
SIMON BROWN



Notwithstanding the spectre of a tumultuous 2016 worldwide, there is still much to be optimistic about insofar as Africa's rise on the world stage is concerned. While development obstacles abound, the World Bank's **Africa Pulse Report** projects that annual economic growth for Sub – Saharan Africa will remain at an expected average of 4.5%, whilst the **EY Global Attractiveness Study** for 2016 highlights some economic “bright spots” on the continent including the East, Francophone and North African regions.



The traditional giants of the African economy all generally experienced a slowdown in growth for various reasons in 2016. There is consensus among analysts that territories that rely too much on extractive industries will find 2017/8 difficult, whereas those focussing on renewable energies and expanded industrialisation and manufacturing will reap rewards. Territories in West and North Africa such as Cote D'Ivoire, Senegal, Togo, Benin and Morocco are poised for a second wave of investment opportunities that will benefit them. The economic climate demands that African economies increase productivity while creating and driving employment, as they ensure that they are both producers and consumers.

The continent's governments appear to be well aware of the need to build infrastructure for intra-African integration as well as address domestic concerns, such as growing consumer spending whilst encouraging household savings. In addition to the growth potential in Western and North Africa, other countries that still boast some of the world's fastest growing economies include Ethiopia, the DRC, Tanzania, Rwanda and Kenya.

While governance on the continent is improving and economic growth has been steady, much work remains ahead in stemming the scourge of poverty and inequality in many African countries. Corrupt and exploitative deals, authoritarian regimes that suppress democratic expression and poor working conditions for many workers continue to arrest economic development and change. The development of local laws, respect for human rights, robust constitutions together with innovation and entrepreneurship are key drivers to Africa's commercial growth.

In the field of intellectual property law, there continues to be encouraging improvements in many territories, with laws and regulations constantly in the process of evolution and development. Allied to this, the development of Intellectual Property Offices across the continent, including the automation and digitisation of these Agencies and capacity building initiatives, remains imperative.

Central to Adams & Adams' (A&A) continued growth strategy, is the close relationship we continue to foster with our local partners and Associate Offices throughout the African continent, in combination with vital engagement with local Registries. This year we have managed to travel widely, focusing our efforts on jurisdictions where protecting our clients' interests has been problematic. We hope that you enjoy this update of our activities on the continent over the past year.

SIMON BROWN

CHAIR OF THE AFRICA STRATEGY
COMMITTEE AND CO-CHAIR OF
THE TRADE MARKS DEPARTMENT



The Adams & Adams Africa Team in New York

BIPF Conference in London

+ IP Africa Roadshow, New York

+ AFRICA Network

THE ADAMS & ADAMS AND MANAGING IP AFRICA ROADSHOW | NEW YORK

In April 2016, Adams & Adams, in association with **Managing IP** (MIP), hosted the inaugural **Africa IP Roadshow** in New York. The purpose of the full day seminar was to brief attendees on the most recent economic and intellectual property developments in Africa.

The programme served to guide delegates through the vastly different approaches that had to be adopted in different territories in order to effectively protect their IP rights in Africa. Representatives of A&A Africa were accompanied by a renowned economist from a large commercial bank in South Africa. The initiative was well received by the delegates and plans for future events in different US states are in the pipeline.

BRICS IP FORUM ANNUAL CONFERENCE | LONDON

Adams & Adams proudly presented the **BIPF** Annual Conference in London in November 2016. The two-day meeting featured a number of leading industry professionals who shared their views on- and experiences in intellectual property protection and enforcement in the BRICS nations. Expert IP views from all five countries were also featured – addressed by leading IP practitioners from the firms that make up the BRICS IP Forum. The focus of the conference was on new trends in IP policy, prosecution, transactions and enforcement.

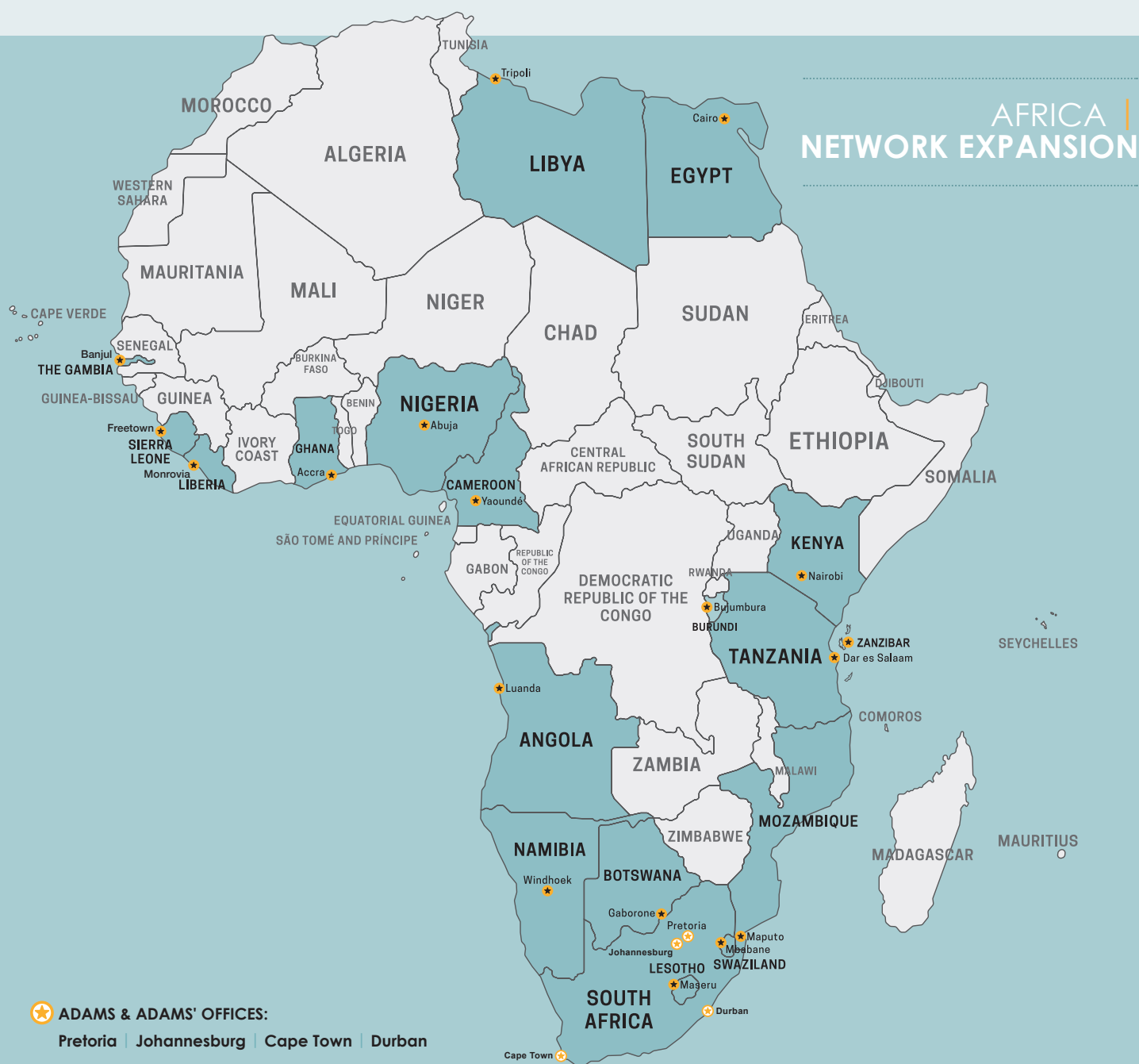
ADAMS & ADAMS AFRICA NETWORK EXPANSION

Adams & Adams continues to expand its Africa Network, recently establishing an Associate Office in The Gambia. The office will also service Liberia and Sierra Leone. Plans are underway to open an office in Ethiopia, as well as Zimbabwe in 2017. This will bring to 20, the number of Associate Offices in different African countries – forming part of the unique **Adams & Adams Africa Network** (AAAN).

“Our focus has always been to add value to our clients’ IP portfolios. We target strategic associations with local Partners whose ethics and commitment to clients mirror those of our own,” says Simon Brown, Partner and Chair of the Africa Strategy Committee.

"The heart of this approach is the enhancement of the level of experience and assurance for our clients. High standards are expected of our offices and we ensure continued adherence through a rigorous due diligence process. Our strategy remains to empower our Associate Offices by exposing them to our extensive legal and institutional knowledge – accumulated over the 109 years that Adams & Adams has been in operation."

In the past four years, Adams & Adams has also established Associate Offices in Kenya, Nigeria, Ghana and Egypt – which acts as a hub for the other North African jurisdictions of Algeria, Libya, Morocco, Sudan and Tunisia. We anticipate further Associate Offices being established in Eastern and Southern Africa during 2017.





AFRICA IP NETWORK MEETING | PRETORIA

What are we as professionals doing to preserve the legacies and intellectual capital of Africa? This was the question that renowned actor, director, writer and playwright, John Kani, asked the delegates who had gathered for the **4th Africa IP Network Meeting** at the offices of Adams & Adams in Pretoria. Kani, who delivered the keynote address, captivated the audience with stories of his upbringing in apartheid South Africa and time in Hollywood – including his latest role as an African monarch in the **Marvel Captain America** film franchise.

“I was cast as an African monarch in a fictional North African kingdom, and I asked them very nicely whether I could speak Xhosa instead of the ‘Tarzan’ dialect that Hollywood loves so much,” he jokes. “We need to think carefully about how we protect and advance our continent’s rich history, legacy and inherent intellectual property.” It was a sobering thought for the delegates. Adams & Adams has been particularly active in the area of Legacy Intellectual Property rights, with recent work being undertaken for the **Steve Biko Foundation** by Partner, Darren Olivier, and his team.

In welcoming the attendees, both Chairman, Gérard du Plessis and Partner, Simon Brown, stressed the importance of attendees to promptly communicate updates on IP developments and legislative changes in their jurisdictions, in order for the firm to continue to develop best practice IP strategies for its clients.

Attendees discussed and debated topical industry matters such as IP commercialisation, the handling of opposition IP proceedings in multiple jurisdictions, Registry practices and search capabilities.

High on the agenda was the implementation of the **Madrid Protocol** – a system of international registrations, administered by the **World Intellectual Property Organisation** (WIPO) that allows for the centralised registration and management of trade marks.



G rard du Plessis, John Kani, Nicky Garnett and Simon Brown

Darren Olivier receiving the MIP Award

Of the 37 African territories that are currently members of the **Madrid Agreement / Protocol**, only nine have actually "domesticated" (and in a handful of these there still remain practical concerns) the Protocol through appropriate amendments to their national trade mark legislation, together with the implementation of enabling regulations. Speaking at a recent Madrid system think-tank at Adams & Adams, Partner, Stephen Hollis noted that "one of the core issues with the national applicability of IP treaties such as the Madrid Protocol is that additional direction, procedures and mechanisms need to be put in place, on a national level, to ensure that the national IP Office is equipped to deal with and process International Registrations, including, how to deal with objections, oppositions and the like. Even national trade mark legislation is not considered to be enacted properly until the so-called 'enabling regulations' have been promulgated. Enabling regulations supplement and complete trade mark legislation by formally determining the processes and procedures through which the provisions of the legislation can be practically implemented and fulfilled by the national trade marks office concerned."

Strategies to deal with Madrid, as well the current implementation of the Industrial Property Automation System (IPAS) system in registries across the continent, were also discussed; followed by regional updates from Associate offices in Egypt (North), Ghana (West), Tanzania (East) and Zimbabwe (South).

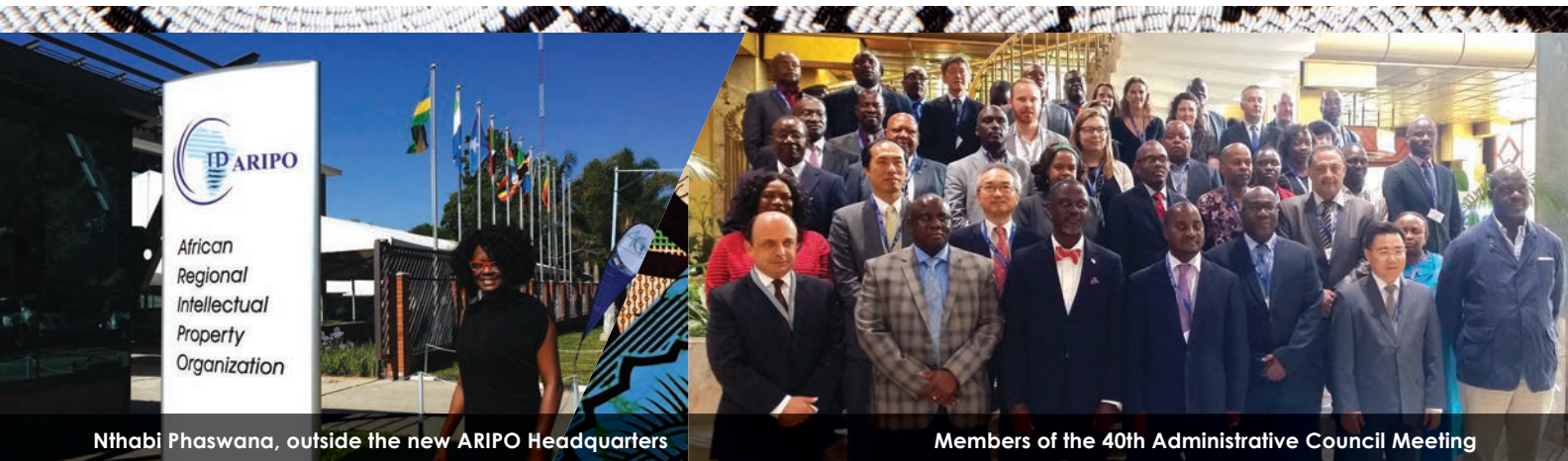
+ Africa IP Law Firm, 2017

AFRICA IP NETWORK
MEETING | PRETORIA

ADAMS & ADAMS CROWNED AFRICA IP LAW FIRM OF 2017

At the **Managing IP (MIP) Global Awards** banquet, held at **The Savoy** in London, Adams & Adams was confirmed as the leading law firm in Africa for 2017 – the third year in a row for the firm. Partner at the firm, Darren Olivier was on hand to accept the award and to celebrate the firm's phenomenal achievements in uniting and advancing the business of good intellectual property in territories across the African continent.

"This is a fantastic accomplishment for us and we are immensely grateful to the members of MIP, who have recognised our efforts and our firm's ascendancy in Africa," said firm Chairman, G rard du Plessis, of the award. "We are also indebted to our local and global clients who continue to trust our professionals with their commercial interests and intellectual property rights on the continent."



Nthabi Phaswana, outside the new ARIPO Headquarters

Members of the 40th Administrative Council Meeting

ARIPO



Representatives of Adams & Adams were delighted to attend the historic 40th session of the annual ARIPO Administrative Council meeting held in Harare, Zimbabwe from 5 – 7 December 2016. The meeting coincided with the inauguration of the **African Regional Intellectual Property Organisation's** new state-of-the-art headquarters building.

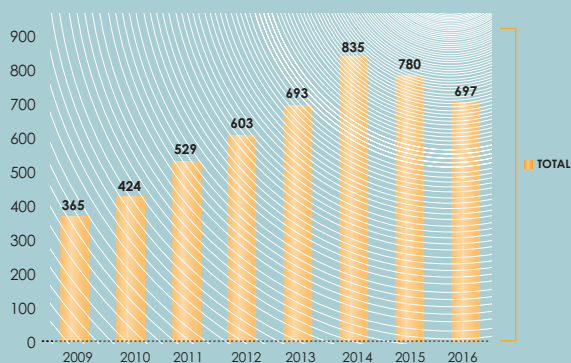
The Vice President of the Republic of Zimbabwe, the Honourable Emmerson Mnangagwa was the Guest of Honour at the ceremony. Other dignitaries and guests who attended the event were members of the Council of Ministers of ARIPO, Members of the Diplomatic Corps accredited to Zimbabwe, heads of international and regional cooperating partners, senior government officials from Zimbabwe and the Member States, members of the Administrative Council of ARIPO and intellectual property practitioners. The new headquarters building offers adequate office space, meeting rooms and modern conference facilities for the burgeoning staff complement.

The 40th anniversary celebrations and inauguration of the new headquarters was graced by several of ARIPO's co-operating partners who delivered their congratulatory messages. These included; the **World Intellectual Property Organization** (WIPO), **International Federation of Reproduction Rights Organisations** (IFRRO), **Japan Patent Office** (JPO), **State Intellectual Property Office** (SIPO) of the Republic of China, **Groupement National Interprofessionnel des Semences et Plants** (GNIS), **European Patent Office** (EPO), **European Union Intellectual Property Office** (EUIPO), **Africa University**, **African Intellectual Property Organization** (OAPI) and **Mexican Institute of Industrial Property** (IMPI-Mexico).

At the Administrative Council Session, amendments to the Harare Protocol, which regulates the filing and prosecution of patents, utility models and industrial designs, were approved. The amendments were adopted by the ARIPO Administrative Council, and came into operational effect on 1 January 2017. The amendments include new provisions regarding the following:

- Inventions excluded from patentability
- Substantive examination
- Restoration of rights in respect of patents, utility models and industrial designs
- Post grant amendments

Having last increased its fees in 2006, the Administrative Council adopted the proposal to increase its Patent filing fees by between 5 and 15% with effect from 1 January 2017. In addition several new fee categories have been introduced.



+ Filings Decrease

+ Protocol Improvements

ARIPO

ARIPO PATENTS FILED 2009 – 2016

FILINGS DECREASE

For the second consecutive year, an ARIPO report noted that the number of applications received – both patents and trade marks – continued to decrease when compared to a filings peak in 2014. During his address at the Administrative Council Meeting, Director General, Mr. Fernando dos Santos expressed concern at this trend, particularly against the fact that there is a global increase in filings, led by China. Dos Santos pointed out that of the roughly three million patent applications filed worldwide, Africa accounted for a mere 0.3%.

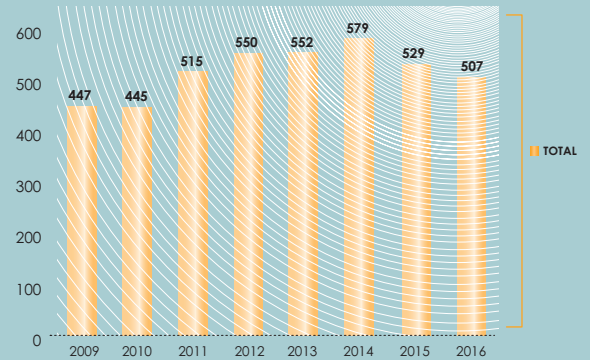
IMPROVEMENT OF THE BANJUL, HARARE AND SWAKOPMUND PROTOCOLS

Adams & Adams attended the **5th Session of the Working Group on the Improvement of the Banjul, Harare and Swakopmund Protocols**, held in Harare in May 2016. The **Working Group** was attended by delegates from ARIPO member states as well as users of the Banjul, Harare and Swakopmund Protocols (the "Protocols"). The ARIPO Secretariat highlighted its mandate to maintain and adapt the Protocols to changing market environments and requirements by member states. Discussions held related to, among other matters; renewals of ARIPO patents, designs and trademarks; the domestication and application of the Protocols by the member states; a proposal for an increase in fees for prosecuting ARIPO patent applications; and improvements to ICT infrastructure to augment the effectiveness of the office and interaction between ARIPO and its users.

Most pertinent of the amendments to the **Harare Protocol on Patents and Industrial Designs**, effective 1 January 2017, is that it is now compulsory to request substantive examination for ARIPO patent applications. A provision for restoration or re-establishment of rights has also been included. The introduction of new fees and the hiking of application and renewal fees, which, while perhaps necessary to ensure that ARIPO continues to develop systems and improve efficiencies, will not be popular with applicants. However, the amendments do clarify provisions on patentable inventions, restrictions on biotech inventions and multiple dependencies of claims, which are largely welcome.



Simon Brown with Mercy Asima and Carlton Akkum, OAPI



OAPI PATENTS FILED 2009 – 2016

OAPI

- + OAPI Headquarters Visit
- + Patent Filings



ARIPO AND OAPI SIGN COOPERATION AGREEMENT

On 9 February 2017, ARIPO and OAPI, signed a four-year **Cooperation Agreement** at the ARIPO offices in Harare, Zimbabwe. The new agreement supercedes two earlier concords between the organisations.

The Agreement establishes a comprehensive and collaborative framework in intellectual property matters that encompasses the harmonisation of the organisations' respective systems; an exchange of documentation and technical information; and mutual cooperation in the development of training and capacity building programs. The organisations also agree to take common positions on major IP issues affecting their respective member states at a continental and international level.

Directors General, Dr. Paulin Edou Edou and Mr. Fernando dos Santos signed the Agreement on behalf of OAPI and ARIPO respectively.

VISIT TO OAPI HEADQUARTERS

Simon Brown (Partner) and Menzi Maboyi (Africa Practice Manager) travelled to Yaoundé, Cameroon in November 2016 to meet with officials from OAPI and to discuss developments within the regional filing body. Time was also spent at the Adams & Adams Associate Office to review files in accordance with our principles of due diligence and to congratulate the team for being named **Cameroon Intellectual Property Law Firm of the Year by Corporate International Global Awards**.

On the occasion of its 54th anniversary in September 2016, OAPI hosted a seminar on geographical indications, within the framework of the **Program for the Support and Implementation of Geographical Indications (PAMPIG)**.

PATENT FILINGS

In line with trends being experienced by ARIPO, OAPI also saw a 12% drop in patent filing numbers from a peak of 579 in 2014.



2016 OAPI IP Firm of the Year

Yaoundé, Cameroon

PROPOSED ESTABLISHMENT OF ARBITRATION & MEDIATION CENTRE

Consideration is being given by OAPI to the adoption of a plan for the establishment of an **Arbitration and Mediation Centre**, and the endorsement of a **Draft Regulation on Arbitration and Mediation**. This is a clear extension of OAPI's mission to advance arbitration and mediation as an alternative means of resolving intellectual property disputes. Also being explored is the possibility of setting up an **OAPI Court of Justice** in the field of intellectual property to ensure the proper interpretation and application, by member states, of intellectual property principles and rules.

- + Arbitration & Mediation Centre
- + OAPI New Director General
- + OAPI Appeals Board Judges

OAPI

NEW DIRECTOR GENERAL FOR OAPI IN 2017

At the OAPI Administrative Council meeting in December 2016, Mr. Denis Loukou Bohoussou of Côte d'Ivoire, was elected to the post of Director General for a period of five years, effective 1 August 2017.

Loukou Bohoussou's predecessor, Dr. Paulin Edou Edou's term of office ends on 31 July 2017. Under the leadership of Dr. Edou Edou, OAPI has acceded to a number of international treaties aimed at creating a modern and dynamic framework and to harmonise administrative procedures in the registration of titles.

APPOINTMENT OF JUDGES TO OAPI APPEALS BOARD

Recently, three judges were newly appointed to the **OAPI Appeals Board**. Judges to the Board are appointed for a period of two years – extended for a further two years if necessary. The three judges hail from OAPI member states, Senegal, Niger and Burkina Faso.

The **Appeals Board, or High Commission of Appeal**, is composed of three members selected from a list of representatives of each member country. Three alternate members are also selected to replace a permanent member who may be unavoidably absent during a session. This is the fifth round of judges to assume office since the establishment of the **OAPI Appeals Board** in 2002.



Customs training, Luanda



Eugene Honey, the Registrar of CIPA, Tim Moalusi and Menzi Maboyi

ALGERIA



WIPO TO OPEN AFRICAN REGIONAL OFFICE IN ALGERIA

Following a vote held in Geneva in August 2016, Algeria was selected by WIPO to host one of its African regional offices. Algeria will host the WIPO external office for North Africa, while Nigeria will host the external office for Sub-Saharan Africa. The process for the establishment of the offices should be completed within two years, with the Algiers and Abuja bureaux anticipated to preserve and promote Africa's interests in WIPO activities and resolutions.

ANGOLA



PATENT APPLICATION CHALLENGES

In the face of assurances by the Director General (DG) that steps were being taken to expedite the processing of patent applications, no apparent progress has been made. Though patent applications are now published regularly in the **Journal**, no patents have proceeded to grant in Angola for many years.

Our professionals are persistently engaging with the **Angolan Intellectual Property Institute** (IAPI) officials in a bid to resolve the delays, a process made all the more difficult in the absence of a permanent IAPI Director General. During the course of 2016 the DG of IAPI, Ms. Ana Paula Miguel, took an extended leave of absence. In the interim Mr. Dário Camati has been appointed DG, pending Ms. Miguel's return.

ANTI-COUNTERFEITING TRAINING WORKSHOP

Adams & Adams Partner, Charl Potgieter, travelled to Luanda to conduct anti-counterfeiting training with members of Angola's **Customs Agency** in April 2016.

BOTSWANA



CIPA REGISTRY VISIT HIGHLIGHTS YOUTH INNOVATION IN BOTSWANA

Adams & Adams Partner, Eugene Honey, travelled to Botswana in June 2016 to meet with the Registrar of the **Company and Intellectual Property Authority** (CIPA), Mr. Tim Moalusi and other Registry officials. The visit included discussions pertaining to outstanding matters and to developments at the Registry, and an assessment of the operations at Adams & Adam's Associate Office.

While in Botswana, Eugene Honey was invited to present a paper and to participate on a panel discussion relating to the **Valuation of IP assets, Commercialisation and Monetisation at the Sub Regional Intellectual Property Workshop for Young Innovators** organised by WIPO, the **Africa Innovation Forum** (AIF) and the **Japan Patent Office** (JPO). The workshop programme also included the annual **Africa Innovation Awards**.

CIPA STAKEHOLDER MEETING

In November 2016, Adams & Adams Partner, Dieter Welthagen, attended a stakeholder meeting held by CIPA to discuss the planned review by the Authority of the Industrial Property (IP) Act 2010. Comments were provided to CIPA on certain Patent and Trade Mark provisions in the Act, followed by written submissions in March 2017.



Anti-counterfeiting training workshop



Anti-counterfeiting search and seizure operation, Gaborone

CUSTOMS TRAINING AND SEARCH & SEIZURE OPERATIONS

The alarming increase in counterfeiting activities on the continent has resulted in the Adams & Adams anti-counterfeiting team becoming more involved with local law enforcement agencies in combating counterfeiting in a number of African countries. This is done through customs training and joint operations. In February 2016, Adams & Adams Partner, Charl Potgieter, conducted customs training in Gaborone with members of the **Botswana Police Service**, including the detective branch of the force. The training was well-received and serves to keep law enforcement abreast of changes in trends relating to counterfeit goods. After the training, joint search and seizure operations were conducted around the city.

BURUNDI



DIRECTIVE FOR RENEWAL OF TRADE MARKS AND INDUSTRIAL DESIGNS

The Burundian IP Office has confirmed a directive stating that **all** trade marks and industrial designs registered under the old law must now be renewed before 28 July 2019. Before this, trade marks and industrial designs in Burundi, were registered for an unlimited period of time.

Trade marks shall be valid for a period of 10 years from the filing date, with the possibility of indefinite renewals for the same period of time; and industrial designs shall be valid for five years from the filing date, with the possibility of two renewals of five years each. For further information regarding the current changes to Burundi's practice for renewal of trade marks and designs, please contact us.

CAPE VERDE



REGISTRY VISIT

Adams & Adams' Mozambique representative, Elio Teixeira, travelled to Praia in Cape Verde to meet with the President of the **Institute of Intellectual Property of Cabo Verde**, Mr. Monteiro Rogerio. We are pleased to report that operations are gradually improving, with a concerted effort by the institute's staff to reduce the backlog of matters. In 2016 three IP journals were published – a significant improvement compared to previous years. There is, however, no indication as to when the island republic intends joining the main international IP treaties, namely the **Paris Convention** and **PCT**.

DEMOCRATIC REPUBLIC OF THE CONGO (DRC)



UPDATE REGARDING FILING CHALLENGES

Administrative and bureaucratic hurdles continue to plague the filing and prosecution of IP matters in the DRC. Certificates of grant must be signed personally by the Minister of Trade (who has recently been replaced) and this may lead to unwelcome delays of several years. Our professionals continue to engage with the Ministry and Registry in an attempt to overcome these difficulties.



Stephen Hollis with Dr. Eshete, EIPO DG

DJIBOUTI



ACCESSION TO THE PATENT COOPERATION TREATY

In June 2016, the Minister Delegate to the Ministry of Economy and Finance, Mr. Hassan Houmed Ibrahim, deposited Djibouti's instrument of accession to the **Paris Cooperation Treaty** (PCT) with WIPO. The Treaty came into force in September 2016, however, the law has not yet been amended to provide for PCT filings.

With the accession of Djibouti, the PCT has reached the milestone of 150 member states. Prior to Djibouti's accession to the PCT, patent protection was only available by way of a convention application, or a non-convention application.

EGYPT



INCREASE IN PATENT OFFICIAL FEES

On 13 February 2017, the President of the **Academy of the Scientific Research and Technology** (ASRT) issued Executive Decree, No. 1 of 2017, effective immediately. The ASRT pronouncement affects the official fee that is levied for the examination of patent applications in Egypt - increased from EGP 7,000 to EGP 17,530. The official fees may be reviewed annually to take into account any fluctuations in USD/EGP exchange rate.

RULES GOVERNING THE REGISTRATION OF FACTORIES ELIGIBLE TO EXPORT PRODUCTS INTO EGYPT

Egypt's Ministry of Trade and Industry has amended the rules overseeing the registration of factories qualified to export certain products to Egypt. The new decree requires factories and companies to export listed products and to register their trade marks with the **General Organisation for Export and Import Control** (GOEIC).

TRADE MARK VERIFICATION TOOL INTRODUCED FOR CONSUMERS

The Ministry of Supply and Internal Trade introduced a new system of enforcing the protection of trade marks and of limiting infringements. Through a smartphone application or text message, consumers will be able to verify instantly whether or not a particular product is genuine. The verification message includes the product name and expiration date. Trade mark owners are able to place a sticker on all products that are sold in the Egyptian market and are registered with the **Egyptian Trademarks Office**.

ETHIOPIA



NEW DIRECTOR GENERAL FOR EIPO

Adams & Adams Partner, Stephen Hollis, and Africa Practice Manager, Menzi Maboyi travelled to Addis Ababa in October 2016 to meet and congratulate the newly appointed Director General of the **Ethiopian IP Office** (EIPO), Dr. Mandefro Eshete. The EIPO is, in many ways, grappling with the changes to the trade mark registration process introduced



Associate Office in The Gambia

by the jurisdiction's first-ever Trade Marks Act in December 2012, but efforts are ongoing to improve the system. These efforts include the digitisation of EIPO's records as well as the appointment of a significant number of new staff members, including trade mark examiners. Adams & Adams was invited by Dr. Mandefro to assist with the training of new examiners and to participate in the preparation of written submissions for consideration by EIPO – addressing possible shortcomings in EIPO's current interpretation of their new legislation, when considering how the same principles are applied in other, more advanced IP registration jurisdictions. Adams & Adams is committed to working closely with the EIPO in the coming years and in contributing to the development and training of Registry officials and the development of Ethiopian IP laws, where we are invited to do so.

CHANGES INTRODUCED BY THE COUNCIL OF MINISTERS REGULATION

The Council of Ministers Regulation No. 273/2012 of December 2012 on Trademark Registration and Protection brought into force changes such as the application of cancellation and invalidation procedures and the extension of the renewal period for trade marks from six years to seven years.

Although Ethiopia is not yet a member to the Paris Convention, it is possible to claim the priority date of an earlier filed application in a Paris Convention country in terms of their new legislation. The international (Nice) classification system of goods and services for the purpose of the registration of trade marks will be followed. Currently, the Ethiopian IP Office is applying the 10th edition of the classification system.

ADAMS & ADAMS ASSOCIATE OFFICE IMMINENT

The rising significance of the Ethiopian economy in central and East African markets, coupled with its important strategic

position on the continent, has meant that Adams & Adams has been aiming to set up an Ethiopian Associate Office for a number of years. In the course of 2017, an office will be established in Ethiopia, to be based in Addis Ababa. Further updates will follow.

THE GAMBIA



NEW ADAMS & ADAMS ASSOCIATE OFFICE FOR WEST AFRICA

The Adams & Adams network of Associate Offices continues to expand, in line with the firm's strategy of establish Associate Offices in the territories identified as key economic hubs – and to facilitate the development of IP rights in Africa. Adams & Adams established its 18th Associate Office in The Gambia, which has the capacity to cover Liberia and Sierra Leone.

GHANA



AMENDMENT TO THE TRADE MARKS ACT

With the passing of the Trade Marks (Amendments) Act 2014, Ghana has amended its Trade Marks Act and has expanded the meaning of a "trade mark" to include: "...colours, numerals, shapes, holograms, sounds or a combination of any of these elements, or slogans, where they are not long enough to be protected by copyright". The **Trademarks Registry** has not yet, however, recorded any applications to register sounds or holograms.



Customs training, Accra



Darren Olivier, Mr Slyvance Sange (centre) and Menzi Maboyi

GHANA REGISTRY STRIKE

In 2016/7 officials from the IP and Companies Registries embarked on two strike actions. The first action was from 27 July to 18 August 2016 and involved the Civil and Local Government department. The second action was from 20 August 2016 to 23 January 2017 and involved the State Attorney's department. During both actions skeletal services were available at the Registry but significant delays in the processing of applications were experienced at the time.

GHANA PLANT BREEDERS' BILL STILL TO BE PASSED

Although there have been developments in several jurisdictions with regard to plant breeders' rights, the 2013 Act for the protection of plant breeders' rights in Ghana remains pending. For information on any African country regarding plant breeders' rights, please contact us.

THE SWISS-GHANA INTELLECTUAL PROPERTY PROJECT (SGIP)

In 2010, Ghana implemented the SGIP with the aim of ensuring that the IP laws in Ghana reflect its commitments under the **World Trade Organisation (WTO)** Agreement on the **Trade Related Aspects of Intellectual Property Rights (TRIPS)**. As part of the project there was a review of laws relating to IP and the drafting of accompanying regulations. The five-year programme ended in 2015, and on 21 January 2016 Ghana introduced its **National IP Policy and Strategy (NIPPS)**.

The strategy recognises the need to exploit IP rights for the accelerated growth in technological and industrial development in Ghana. To achieve these objectives, 34 projects have been approved until 2020. In addition, the strategy recognises the need to amend existing laws on patents, designs and geographical indications and to complete automation of the IP registration process.

MADRID PROTOCOL SEMINAR HELD IN GHANA

The Registrar General's Department organised a seminar at which officials from WIPO were invited to provide greater clarity on the operation of trade mark applications under the Madrid Protocol. We contrive to recommend to clients to avoid using Madrid Protocol in certain African countries until their national laws recognise Madrid registrations and until the national IP offices are enabled to deal with new applications in line with the framework of the Madrid Protocol.

ANTI-COUNTERFEITING TRAINING WORKSHOP

In August 2016, Adams & Adams Partner, Charl Potgieter, travelled to Accra to conduct an anti-counterfeiting training session with members of **Interpol**, the **Ghana Police Service** and the **Ghana Customs Division**.

KENYA



INTERNATIONAL CONVENTION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

In May 2016 the International Convention for the Protection of New Varieties of Plants entered into force in Kenya. Kenya was the first country in Africa to join the **International Union for the Protection of New Varieties of Plants (UPOV)** in 1999 and subsequently domesticated the 1961 Act of the UPOV Convention through the Seed and Plant Varieties Act in 2016.



Search and seizure operation conducted at a shop selling counterfeit shoes, Mombasa

Customs training, Nairobi

DRAFT PROPOSALS FOR AMENDMENTS TO THE COPYRIGHT ACT PUBLISHED

The **Kenya Copyright Board** (KECOBO) has published two sets of draft proposals of amendments to the Copyright Act on Collective Management Organisations (CMOs). The draft seeks to modify the procedure for verification of assignment of copyright works from outside Kenya. The proposed procedure requires KECOBO to issue a certificate of verification upon successful application for verification with necessary supporting documents. Thereafter, the verified assignment is entered into the Copyright Register upon payment of a fee. Kenya is one of the only countries in Africa to make provision for the registration of copyright.

KENYA ASSOCIATE OFFICE AND REGISTRY VISIT

Adams & Adams Partner, Darren Olivier, and Africa Practice Manager, Menzi Maboyi travelled to East Africa, including Kenya, in September 2016. The purpose of the trip was to visit the Adams & Adams Associate Office in Nairobi and to assess their ongoing capabilities, review files and perform a due diligence exercise on office operations. The duo also met with the new Managing Director (MD) of the **Kenya Industrial Property Institute** (KIPI), Mr. Slyvance Sange, at the Registry offices; and were able to tour the offices – affording them a rare opportunity to meet and engage with Registry staff. The Registry is poised to meet its goal to digitise all operations within the coming years.

CUSTOMS TRAINING AND GOODS SEARCH & SEIZURE OPERATION

In September 2016, Adams & Adams Partner, Charl Potgieter, conducted anti-counterfeiting and product identification training sessions with members of the **Kenya Customs**

Services Department in Mombasa and Nairobi. Subsequent to that, a number of in-market operations were carried out, leading to the seizure of goods that were identified as counterfeit products.

RECENT MATTERS | TRADE MARK OPPOSITION | GULF V GULFTEX JUDGMENT



In a recent decision by the Assistant Registrar, an opposition to the mark GulfTex in Class 4 by **Gulf International Lubricants Limited** was upheld.

The opposition was based on prior registrations of the **GULF** (word and logo) trade marks in Class 4 in Kenya and the fact that these marks are well-known. The Registrar found that the dominant element of the marks is the word "GULF" and that the addition of the suffix "TEX" by the Applicant was insignificant and did not distinguish the marks from each other. The Registrar found that where prefixes are identical or similar, confusion or deception is more likely to occur, as opposed to cases where the similar or identical elements are suffixes. The Registrar also clarified the requirement for marks to be considered as well-known marks.

SECTION 30A OF THE COPYRIGHT ACT DECLARED UNCONSTITUTIONAL

In a judgment delivered by the High Court in the case of **Mercy Muneo Kingoo & Lydia Nyiva Kingai v Safaricom Limited & Attorney General** [2016] eKLR, the court pronounced on the constitutionality of section 30A of the Copyright Act, 2001 (the Act). The Petitioners argued that the section, which provided for the equitable right to remuneration for use of sound recordings and audio-visual works for producers and performers through their respective Collective Management

Organisations (CMOs), was unconstitutional since it infringed on their intellectual property rights as they had already engaged Premium Rate Service Providers and agreed on how their royalties would be paid. The Learned Judge held that section 30A of the Act was unconstitutional to the extent that it limits the rights of artists to choose how their royalties are to be paid since it limits the petitioners' freedom of association and that the section was enacted without public participation.

TRADITIONAL KNOWLEDGE AND CULTURAL EXPRESSIONS ACT

On 31 August 2016, President Uhuru Kenyatta signed the Protection of Traditional Knowledge and Traditional Cultural Expressions Act. The law provides for the collection of information and maintenance of records relating to **Traditional Knowledge** and **Traditional Cultural Expressions** in Kenya. The Act provides for both civil and criminal penalties for unauthorised use of **Traditional Knowledge** or **Traditional Cultural Expressions**. There are no formalities involved in the protection of **Traditional Knowledge** or **Traditional Cultural Expressions**. Registration is simply intended to be declaratory and is not intended to confer any rights. There is also no time limit for protection.

RECENT MATTERS | ADVERTISING STANDARDS COMMITTEE TESTS KENYA'S DRIEST DIAPER CLAIM

In a recent advertising dispute in Kenya, the **Advertising Standards Committee** (ASC) heard a case relating to comparative advertising. The parties to the dispute were **Kimberly-Clark** (KCSSA) East Africa Limited ("the Complainant") and **Procter & Gamble International Operations** ("the Respondent"). Both parties manufacture disposable baby diapers. The Complainant is the owner of the **HUGGIES** trade mark and the Respondent is the owner of the **PAMPERS** trade mark. Both trade marks are used and are well-known in relation to baby care products – both direct competitors in the industry.



* This is not a depiction of the advertisement as it appeared in the market or the filed complaint but an illustration of the claim made.

The complaint filed with the ASC related to the Respondent's **PAMPERS BABY-DRY** in-store marketing and, in particular, the claim that **PAMPERS BABY-DRY** diapers are "**Kenya's DRIEST diaper**".

The Complainant argued that the aforementioned claim, rather than simply referring to the quality and dryness of **PAMPERS** diapers, was a superiority claim which compared the quality and dryness of **PAMPERS** diapers with equivalent diapers in Kenya, and suggested that no other diaper in Kenya was drier than **PAMPERS**. The Complainant further argued that no disclaimer had been added to the claim to qualify its meaning and, as a result, it was misleading.

The Commission found in favour of the Respondent and confirmed that comparative advertising is permitted, provided that it is not disparaging and that the advertising claims are capable of substantiation and are not misleading.

RECENT MATTERS | THE DIFFERENCE IS (NOT) IN THE DETAILS

A recent issue on appeal in **Mount Kenya Sundries v MacMillan Kenya** (Publishers) was whether the Appellant's map, in which it claimed copyright, infringed the copyright subsisting in the Respondent's map. The competing maps, which covered the same geographical area in Kenya, were both made available in 1990. Prior to this, however, the Appellant had been offering an earlier edition of the Respondent's map for sale, but it denied that it had any knowledge of the map prior to receiving demands from the Respondent.

One of the Appellant's contentions was that, since the maps covered the same geographical area, there would naturally be clear similarities between them. However, the Respondent successfully led expert evidence confirming that while maps may provide the same information, the presentation of that information should differ. The Appeal court agreed that the details on the maps were the same and drew the conclusion that the Appellant, having had knowledge of the Respondent's map from an earlier date, had copied a substantial part of its map and therefore infringed its copyright.



Nolwazi Gcaba (centre) with, Ms Kama, Assistant Registrar (left) and senior Registry staff



Lesotho Anti-counterfeiting training workshop

RECENT MATTERS | SHABBY EVIDENCE IN AN OPPOSITION TO THE TRADE MARK SHAGGY CUT

In an opposition to a trade mark application SHAGGY CUT in class 26 in the name of **Solpia Group Inc. by Style Industries Limited**, the Opponent, **Style Industries Limited** sought to rely on evidence of its prior reputation and use of the mark **SHAGGY** in relation to, inter alia, hair extensions, to support its opposition. The grounds of opposition included that the parties' marks so closely resembled each other that their use in relation to goods of the same nature and character would lead to confusion.

The Opponent offered evidence of sales of hair extensions but the labels displayed the word "**SHAGY**" as opposed to "**SHAGGY**" and the authenticity of the invoices came into question. The defects in the evidence were even more apparent when viewed against the evidence presented by the Applicant which constituted proper and genuine use of the mark **SHAGGY CUT**. Aside from the Opponent's evidentiary woes, the Registrar found that the mark **SHAGGY**, on its own, was a reference to the character or description of the goods in respect of which the Opponent had used and applied to register the mark, which disentitled the mark to protection. The opposition was dismissed.

LESOTHO



CONCERNS ADDRESSED AT REGISTRY VISIT

Adams & Adams Partner, Nolwazi Gcaba, and Africa Practice Manager, Menzi Maboyi travelled to Lesotho to meet with members of the Adams & Adams Associate Office and to

visit the Registry. As part of the Registry visit, operational issues and long-outstanding matters were discussed. The team noted that positive progress has been made in the utilisation of the IPAS system initiated by WIPO. Undertakings were made by the Registry to review the operational issues raised.

LIBERIA



CHANGES TO TRADE MARK LAW INTRODUCED BY LIBERIA IP ACT

The new Liberian Industrial Property Act, 2014 was approved by the Liberian House of Representatives on 14 June 2016 and is now in force. The new Act repeals both the Copyright Act of Liberia 1997 and the Industrial Property Act of Liberia, 2003 ("the 2003 Act") and provides for the protection of copyright, trade marks, geographical indications, industrial designs, patent and utility models and lay-out designs of integrated circuits.

Whilst the Regulations are still being drafted, the Registry has been issuing guidelines on how to deal with certain sections of the new Act which are unclear.

NEW ADAMS & ADAMS ASSOCIATE OFFICE

Adams & Adams recently established an Associate Office in Liberia, which will be run from its Gambia Hub, in line with its long term strategy for IP development in Africa and better service and costing to its clients. The World Bank estimates that over the medium term, economic growth in Liberia is expected to increase to 5.0% on average, due to a recovery in mining, improvements in infrastructure, particularly energy and roads, and higher agricultural productivity.

LIBYA



COMMERCIAL REGISTRY UPDATE

The **Libyan Commercial Registry**, situated in Tripoli, is responsible for overseeing the registration and administration of Libyan companies and all related formal processes, as well as housing all formal company documents. The Libyan Government of National Accord, established pursuant to the conclusion of the Libyan Political Agreement in December 2015, has been unanimously endorsed by the United Nations Security Council as the legitimate government of Libya. However, due to the ongoing civil conflict in Libya and the legislative ambiguity, there remains a great deal of uncertainty as to the *de facto* control of the Commercial Registry and various factions have claimed control over the Commercial Registry.

There is much conjecture as to the validity of processes administered by the Commercial Registry and there is also concern over the legality of official documents issued by the Commercial Registry. Conflicting resolutions passed and official communications issued by different factions respectively claiming to be in control of the same company are also a common occurrence, especially in relation to government-owned companies, where the ultimate control of the companies remain in dispute. It, therefore, remains advisable to verify the authenticity of all documents which purport to have been issued by the Libyan Commercial Registry in relation to a Libyan company or by the directors or shareholders of that company.

LIBYAN IP OFFICE | UPDATE

Libya has been a member of the **Paris Convention for the Protection of Industrial Property** since 1976. Trade marks are filed in accordance with the International (Nice) Classification of Goods and Services. The trade mark law in Libya does not make provision for protecting trade marks in classes 32 and 33 for alcoholic beverages as well pork meat in class 29. Christmas trees and related products in class 28 can also not be registered. Service marks can be registered according to the Eighth Edition of the Nice Classification.

The **Libyan Trade Mark Office** experienced difficulties in 2014 while the Libyan government was struggling to maintain order during the well-documented civil unrest. This led to a halt in the filing of trade mark applications. However, currently the IP Office appears to be fully operational and is accepting the filing of new applications.

MADAGASCAR



NEW BEGINNINGS FOR IP IN MADAGASCAR

Throughout 2016, the Malagasy Government expounded upon its revised IP innovation policy and national strategy. The main focus of the strategy includes the modernisation of the Malagasy IP system including legal framework and IP administration; the promotion of innovation through IP for technology development; the strengthening of capacities in patent searches; and a recognition of the need to increase awareness of the role that IP can play in creating industries. To assist in implementing the strategy, a **Technology and Innovation Support Centre** was established at the **Trademark and Patent Office** (OMAPI).

MALAWI



COMMERCIAL LAW | LEGAL DIFFICULTIES IN SECURING LAND OWNERSHIP IN MALAWI

Over the past decade rural Malawians have witnessed a surge in large-scale land acquisitions for commercial purposes, threatening their access, control and ownership of land. This situation has been aggravated by weak legislation governing land resources in Malawi. The existing legal and institutional framework on the governance of land provides loopholes for land transactions without the consent of affected populations, similar to land-based conflicts in other countries. In terms of the Land Act (Cap 57.01), all land in Malawi is classified as either "public", "private" or "customary" land and, although the 2002 Land Policy reasserted the Malawian government's interest in a title registration system, calling for the transfer of registered deeds to the title registry system, a lack of institutional support and funding remain the main stumbling blocks *en route* to forming legal certainty regarding the status of current ownership of the respective portions of land in Malawi.

With 65% to 75% of land in Malawi being customary land (i.e. land vested in the President, in trust for the people of Malawi, and administered in line with various customary traditions), it is hard to foresee that the acquisition of land, especially by foreigners, will become less troublesome and legally sound in the near future. Malawi has, however, in



Lindie Serrurier with Mr Beergaunot at the Registry



Mauritius Anti-counterfeiting training workshop

the past few years, implemented a Community-Based Rural Land Development Project in an effort to relocate peasant farmers from highly populated districts to low-density ones and passed a new land bill which enables commercial farmers who acquired huge farms during the colonial era to continue owning their land under freehold category, the full effects of which will still have to be observed.

MAURITIUS



A REGISTRY VISIT IN PARADISE

In August 2016, as part of Adams & Adam's continued efforts to engage with Registries around the continent, Partner, Lindie Serrurier visited the **Mauritian Industrial Property Office** (MIPO) and met with Mr. Ranjive Beergaunot, the Acting Controller of MIPO – to discuss developments at the Registry and likely plans for the development of IP in Mauritius in the foreseeable future – in light of the proposed Industrial Property Bill.

NEW INDUSTRIAL PROPERTY BILL

The **Mauritius Draft Industrial Property Bill** seeks to consolidate all aspects of IP into a single piece of legislation and has been presented to the public for comment. The draft Bill has proposed changes to the protection of patent, design and trade mark applications and includes provisions for the protection of utility models and plant breeders' rights.

From a patent perspective, the bill includes revised provisions relating to matters excluded from patent protection, provisions for inventor remuneration, opposition provisions and provisions dealing with compulsory licences. Although Mauritius is still not a member of the **Patent Co-Operation Treaty**, the Bill makes provision for PCT applications.

In respect of trade marks, the changes proposed include an extension to the definition of a trade mark, an extension to the grounds for refusal of a trade mark and an amendment to provisions dealing with trade mark infringement.

Operational changes at the Registry have also been proposed, such as the change of title of the head of the IP Office from "Controller" to "Director" and the establishment of the **Intellectual Property Council** to serve as a coordinating body between private and public stakeholders in respect of effective national IP policy and enforcement. The observations period closed in January 2017 and Adams & Adams successfully submitted comments through its local partners in Mauritius.

ANTI-COUNTERFEITING TRAINING WORKSHOP

In June 2016, Adams & Adams Partner, Charl Potgieter, travelled to Port Louis to conduct anti-counterfeiting training with members of the Mauritius **Customs Department** and **Anti-Piracy Unit**.

MOROCCO



INCREASE IN OFFICIAL FEES

In March 2016, the official fees for trade mark applications and trade mark renewals increased by 20%. For further details, please contact us.

MOZAMBIQUE



LEGISLATIVE DEVELOPMENTS | NEW INDUSTRIAL PROPERTY CODE

The new **Mozambique Industrial Property Code** came into effect on 31 March 2016 and replaced Decree no. 4 of 2006. Hailed as the most significant IP legislative development in the past decade for the east coast jurisdiction, the Code establishes specific rules applicable to the protection of Industrial Property Rights, and defines the rights and obligations arising from the granting of those rights.

Most of the sections in the new code have been reworded, with the bulk of the changes relating to procedural and administrative issues. Some changes entail either a shortening, extension or clarification of the time periods within which to oppose the granting of the different forms of intellectual property rights or comply with formalities. For example, the time period within which to oppose a trade mark application has been reduced from 60 days to 30 days, while in respect of all IP rights, the deadline to submit outstanding documents (such as a power of attorney) has been extended from 15 days to 30 days.

Another significant development is that the new Code seemingly gives recognition to ARIPO trade mark registrations – presumably to prepare Mozambique for accession to the Banjul Protocol. Geographical indications and designations of origin (already recognised in the old IP Code) now have a more comprehensive legal framework and the new Code makes provision for industrial property rights to be pledged and given as security.

PATENT COOPERATION TREATY (PCT) SEMINAR SERIES

In April 2016 the **Mozambique Intellectual Property Institute** (IPI) held a Patent Cooperation Treaty (PCT) seminar, in conjunction with WIPO and ARIPO in Maputo. The event was sponsored by Adams & Adams in Mozambique and was attended by 80 delegates, including local Intellectual Property agents, inventors and representatives from several government agencies. The Mozambican Registrar, Mr. José Meque, hosted the event. A similar seminar was held in Beira, the second largest city in Mozambique.

NEW ADVERTISING CODE FOR MOZAMBIQUE

A new Advertising Code, Decree No. 38/2016, came into force in November 2016 and replaced Decree No. 65/2004. The new Code is broader and more extensive than its predecessor, featuring 65 articles compared to the previous 38 articles.

The new Code prohibits advertising that offends values, principles and institutions. Advertising must also have a sense of social responsibility, respect the principles of competition and be compatible with the objectives of national economic development, education and culture. The new Code also states that all those involved in advertising activities must comply with ethical standards of conduct, and advertisements must be accurate and objective. The new rules also entreat the industry to respect copyright. The extensive use of electronic advertising platforms has led to digital and electronic advertising being protected under the new Code as well.

NAMIBIA



NAMIBIA'S PRESIDENT SIGNS BIPA ACT

The **Business and Intellectual Property Authority Act no. 198 of 2016** (BIPA Act) was passed by Namibia's Parliament and signed into law in August 2016. The BIPA Act provides for the establishment of a central body for the registration, regulation and administration of businesses and intellectual property rights, as well as the improved service delivery and the administration of IP rights and company registrations in Namibia.

One of the more significant changes BIPA has introduced is the online registration of companies and close corporations through its website. It also appears that electronic patent applications will be possible soon. Though welcomed by local practitioners, concerns persist regarding the effective implementation of the Act. The Act is expected to come into force in the first quarter of 2017, together with the long awaited Industrial Property Act 1 of 2012.



Anti-counterfeiting training workshop

Anti-counterfeiting search & seizure operation, Rundu

NEW INDUSTRIAL PROPERTY ACT REGULATIONS RELEASED FOR COMMENTARY

The long-awaited Draft Regulations for the Namibian Industrial Property Act, signed by then-President Hifikepunye Pohamba in 2012, were released for public comment with a deadline of 27 February 2017. The Draft Regulations consist of four sections, separately covering preliminary provisions; patents and utility models; designs; and trade marks. At a glance, there are a number of concerns regarding the substance and language of the draft. Adams & Adams has reviewed the Regulations and has submitted comments for consideration. The Act was initially expected to come into force in March this year, together with the new **Business and Intellectual Property Authority Act**, but in light of state of the Regulations, it is unlikely that the Act will be promulgated within the next few months.

CUSTOMS TRAINING AND SEARCH & SEIZURE OPERATION

In September 2016, Adams & Adams Partner, Charl Potgieter, travelled to Namibia to conduct anti-counterfeiting training with members of **Interpol, the Namibia Police Force** and **Customs Service**. In-market operations were subsequently carried out in Kavango and Rundu where large quantities of counterfeit goods were seized.

NIGERIA



INDUSTRIAL PROPERTY COMMISSION BILL PASSES SECOND READING IN PARLIAMENT

On 19 January 2017, the Industrial Property Commission Bill (IPCOM Bill) passed its second reading in the House of Representatives of the National Assembly of Nigeria. The new Bill represents a complete overhaul of the current system and will harmonise all the current IP laws and bodies in Nigeria by establishing a single body for the administration of trade marks, patents and designs. Among other new developments, it also introduces animal breeders' and plants varieties rights in Nigeria.

The next stage in approval brings the Bill to the House Committee on Commerce. As part of its deliberations, the committee may conduct a public hearing, where stakeholders will be invited to consider and debate the various provisions of the Bill. Although the IPCOM Bill has made considerable progress, there is still some work to be done and IP practitioners in Nigeria, who are very keen for the IPCOM Bill to be ratified in the near future, are doing their utmost to keep the 'policy-making' momentum going.

CYBERCRIMES ACT PASSED

In 2016, Nigeria passed the Cybercrimes Act, paving the way to finding solutions to the upsurge of cybersquatting and other internet offences that are on the rise in Nigeria. The Act specifically criminalises the act of cybersquatting and hence makes it an offence to register or use an internet domain name in bad faith - with an intent to profit from the goodwill of a trade mark belonging to someone else or to make a profit by selling the domain name to the rightful owner.



Darren Olivier, Mr Blaise Ruhima and Menzi Maboyi

INTELLECTUAL PROPERTY FILING STATISTICS

The Trademarks, Patents and Design Registry offers two systems of filing applications in Nigeria. They are the Industrial Property Automation System (IPAS) and e-Filing. Adams & Adams has noted that, in 2016, 60% of trade mark and 55% of patent applications were filed using the IPAS system.

IP BILLS BEFORE THE PARLIAMENT

A draft bill to amend the current copyright law is currently before the National Assembly of Nigeria. The **Copyrights Bill** has passed the first reading and is now scheduled for the second reading. The Bill is expected to be passed into law before the end of the current legislative year.

MAINTENANCE OF INTERNATIONAL STANDARDS AT THE NATIONAL AGENCY FOR FOOD AND DRUG ADMINISTRATION AND CONTROL (NAFDAC)

The **National Agency for Food and Drug Administration and Control** (NAFDAC) launched its 2016 regulatory guidelines which have the effect of putting the agency's standards on par with some internationally maintained standards. The guidelines were formulated in collaboration with the **World Health Organisation** (WHO). The aim of the guidelines is to assist in stakeholder compliance, provide specifications on implementation of the regulations and ensure the adoption of safety practices, efficacy and good quality control measures.

WIPO TO OPEN AFRICAN REGIONAL OFFICE IN NIGERIA

In August 2016, Nigeria was selected by WIPO to host one of its African Regional offices. The process for the establishment of the office has commenced and should be completed within two years.

NEW DIRECTOR GENERAL FOR THE STANDARDS ORGANISATION OF NIGERIA (SON)

In October 2016, Mr. Aboloma Osita Anthony was appointed as the new Director General (DG) of the **Standards Organisation of Nigeria** (SON). Under the stewardship of the former DG, Mr. Paul Angya, the agency had doubled its efforts against substandard products on the market and had made substantial progress in the implementation of its programs.

RWANDA



RWANDA AND THE MADRID SYSTEM

Rwanda acceded to the Madrid Protocol in 2013. Although their IP legislation recognises the effect of international IP treaties to which Rwanda accedes, they have not formally domesticated the Madrid Protocol by amending their 2009 IP Act to expressly give full force and effect to Madrid registrations or to introduce regulations to inform the IP Office on how to receive, process, publish or object to the grant of international designations received via the Madrid system. Until such time as this is updated, we recommend that trade mark owners continue to secure statutory rights through national registrations.

CHANGES TO IP LAWS

In 2016 a few changes were incorporated into Rwanda's Intellectual Property Law. While Law no. 31/2009 remains in force, a new law, namely, Law no. 005 of 2016, and various Ministerial Orders, have introduced amendments to the existing Law, with effect from April 2016. The main changes entail the recognition and protection of Plant Breeders' Rights and changes to the time periods relating to the opposition of trade mark applications and geographical indications.



Adérito Bonfim, Exec. Director SENAPI and Elio Teixeira

Ministerial Order no. 25 formally amended the opposition period to oppose a trade mark application and geographical indication to 60 days from 30 days. However, the Rwandan Registry had already started implementing a 60-day opposition period from October 2014. No practice directive was issued by the Registry introducing the change to the opposition period at the time but with the recent amendment, the position is now clear. No mention is made of whether the opposition period is extendable, nor of the period of such extension, if applicable. This has been raised with the Registry and clarification requested. The Order also provides that, upon receipt of an opposition, the applicant for registration of a trade mark application or geographic indication has 14 days to submit a written response to the competent authority about the content of the opposition. Prior to the Order, no specified time period had been stipulated.

ASSOCIATE OFFICE AND REGISTRY VISIT

Adams & Adams Partner, Darren Olivier, and Africa Practice Manager, Menzi Maboyi travelled to East Africa, including Rwanda, in September 2016. The purpose of the trip was to visit local partners in Kigali in order to assess their ongoing capabilities, review files (where necessary) and to undertake a due diligence on their operations. The Adams & Adams team also paid a visit to the offices of the **Rwandan Industrial Property Office**, and met with the Manager, Mr. Blaise Ruhima, at the **Rwanda Development Board** (RDB) offices. A tour of the Registry was also arranged.

REGULATIONS TO THE 2009 LAW ON THE PROTECTION OF INTELLECTUAL PROPERTY

The office of the Registrar General is in the process of preparing regulations intended to facilitate the implementation of the 2009 Law on the Protection of Intellectual Property. Upon approval by the Minister, the regulations will be published

in the Rwanda Official Gazette. Adams & Adams is keenly following these developments and will provide an update once the Regulations come into force.

SEMINAR FOR JUDICIARY MEMBERS OF THE EAST AFRICAN COMMUNITY (EAC)

A three-day sub-regional seminar aimed at increasing awareness of IP Rights amongst members of the judiciary was held in Kigali, Rwanda. The Ministry of Trade partnered with WIPO to host the event. Attendees included members of the judiciary from a number of EAC countries, such as Kenya, Uganda, Tanzania, Burundi and Rwanda.

The main focus of the seminar was ensuring that effective, accessible and proportionate measures are put in place, within EAC member states, to recognise and enforce the various types of IP rights in those countries. Rwanda is also in the process of preparing a **National IP Strategy**, with the support of WIPO. The first draft of the National IP Strategy is expected in June 2017.

SÃO TOMÉ & PRÍNCIPE



NEW IP CODE

A new Industrial Property Code approved under Decree – Law 23/2016 is effective immediately in São Tomé & Príncipe. The new Industrial Property Code defines protection for, *inter alia*, patents, inventions, utility models, trade marks, geographic indications and designations of origin.

Following São Tomé & Príncipe's accession to the Banjul Protocol, effective from February 2016, the new Code also recognises and makes provision for regional (ARIPO) applications in terms of the Banjul Protocol and international applications in terms of the Madrid Protocol.

REGISTRY VISIT

Adams & Adams' Mozambique representative, Elio Teixeira, travelled to São Tomé in November 2016, to meet with the representatives of the **IP Office** (SENAPI), the Executive Director, Mr. Adérito Bonfim, and local partners. Plans are afoot to improve efficiencies at the Registry.

SEYCHELLES



PROTECTION OF IMPORTANT INDIGENOUS PLANT

In an effort to protect the *Coco de Mer*, the largest nut in the world, which is only found in Seychelles, the Ministry of Environment introduced a new holographic tag to identify nuts that have been placed on the market with the correct permit. Any tampering with or removal of the tag renders the *Coco de Mer* illegal. The new system is aimed at improving the way that *Coco de Mer* is produced, managed and traded, as illicit trade and poaching threaten the growth and re-population of the rare nut.

SOUTH AFRICA



DISSECTING THE NEW IP CONSULTATIVE FRAMEWORK

On 6 July 2016, the Intellectual Property Consultative Framework was approved by Cabinet, following the Draft National Intellectual Property (IP) Policy that was published for comment in 2013. The framework is the first step in a new process to develop a comprehensive IP policy for South Africa and, following criticism that the previous Draft IP Policy had failed to give recognition to public comments, was finalised by way of a co-ordinated approach between government and civil society.

The framework sets out the objectives that the IP Policy should promote, which included fostering the ethos of the Constitution of South Africa, striking a balance between the creators and users of IP and stimulating innovation. It also recognises that there are a number of key issues that will require immediate attention such as IP issues related to public health (including medicines, vaccines and diagnostics). An inter-Ministerial Committee (IMC) will now be established to serve as a consultative forum for formulating the IP Policy.

PATENT EXAMINERS APPOINTED

In line with the policy of providing for substantive search and examination of patents in South Africa, the first group of 20 patent searchers and examiners have been appointed for a training programme to be completed by December 2017. The goal is to commence substantive search and examination at the Patents Office in January 2018, following the enactment of the IP Policy.

The CIPC aims to repeat this recruitment process every two years, with candidates from technical fields such as chemistry, electrical and mechanical engineering, pharmaceuticals, and information technology. The initial substantive examination of patent applications will be limited to certain technical fields.

PROPOSAL FOR AN OMBUD FOR THE ADVERTISING AND MARKETING INDUSTRY

The **Advertising Standards Authority of South Africa** (ASA) has approached the **National Consumer Commission** (NCC) for accreditation as an ombud scheme for the advertising and marketing industry, in terms of Section 82 of the Consumer Protection Act of 2008 (CPA). It has also proposed an industry code, the Advertising and Marketing Industry Code of Practice (the Industry Code), which was published for public comment in the Government Gazette of 26 July 2016 with a comments deadline of 20 October 2016.

The aim of the Industry Code is to ensure that all advertising and marketing in South Africa is informative, factual, honest, conforms to fair marketing practices, and does not contravene any laws. If the Industry Code is accepted, it will be compulsory for **all** "advertising and marketing industry participants and subscribers" to register with the ASA, and to comply with the Code. They will also be required to contribute towards the funding of the ASA through a levy collection agency.

The Industry Code appears to place more emphasis on consumer rights and, similar to the ASA Code, it provides a basis for dispute resolution between two industry participants (i.e. competitor complaints), and between a consumer and an industry participant (i.e. consumer complaints).

RECENT MATTERS | LEMON TWIST V PEPSI TWIST

In May 2016, a Full Bench of the High Court ruled, on an appeal, to an opposition involving a subsidiary of **The Coca-Cola Company**, **Atlantic Industries (AI)**, and **PepsiCo**. AI is the proprietor in South Africa of a number of **TWIST** trade mark registrations, including **TWIST**, **LEMON TWIST** and **DIET TWIST**, in relation to soft drinks in class 32, and the **TWIST** beverages are iconic in South Africa.

PepsiCo had applied to register the marks, **PEPSI TWIST** and **PEPSI TWIST** label, in relation to soft drinks in class 32 and these were opposed by AI on the basis of its prior rights. **PepsiCo** denied that its trade marks would cause confusion and/or deception with those of AI and, further, sought the removal of AI's registered **TWIST** trade marks from the Trade Marks Register, on the basis that they were allegedly descriptive in relation to soft drinks. **PepsiCo** relied in this regard on a dictionary definition of the word "TWIST", which stated that the word can be used for "curled piece of lemon etc. peel used to flavour a drink" or "a drink consisting of a mixture of two different spirits or other ingredients, such as gin and brandy etc."

The Court a quo had dismissed both AI's opposition to the **PEPSI TWIST** trade mark and **PepsiCo's** counter-application for the cancellation of the **TWIST** marks. However, the Full Bench upheld AI's appeal and dismissed the cross-appeal by **PepsiCo** with costs. The court held that, if viewed globally, the visual and aural similarities between AI's **TWIST** trade mark registrations and **PepsiCo's PEPSI TWIST** and **PEPSI TWIST** label trade mark applications were such that there is a likelihood that deception or confusion will arise, especially as the marks would be encountered in the market place by an ordinary purchaser, with imperfect recollection. This type of customer would, at the very least, wonder if the goods had a common origin which would constitute confusion.

Furthermore, besides the reliance on the dictionary meaning of the word "TWIST", **PepsiCo** had not presented any evidence to show that the word "TWIST" was not inherently distinctive or had not, by reason of its use, become capable of distinguishing or that it consisted of a sign or indication which may serve in trade to designate certain flavours or other characteristics. As such, there was no justification for their removal from the register. **PepsiCo** has been granted leave to appeal the decision to the Supreme Court of Appeal and the matter will be heard later this year.

SOUTH SUDAN



REGISTRY NEWS

The Registry in South Sudan is still not accepting and processing trade mark applications (using a deposit type system). However, there have been some positive developments in that Registry officials appear to be keen to resume operations and there is some engagement with the relevant stakeholders to ensure that the Registry can resume its processes. To date, no formal announcement has been made and Adams & Adams continues to monitor the situation and will provide updates on any positive developments.

ST HELENA



NO IMMEDIATE RELIEF AFTER CONSTRUCTION OF NEW AIRPORT

The island of St Helena, in the middle of the south Atlantic, is considered one of the remotest places on the planet. This tiny British territory of just 120-square kilometres, with 4 000 inhabitants, saw the opening of a new £250m airport being delayed indefinitely after it was discovered that the wind shear was so severe that commercial planes could not land. This dealt a severe blow to the island's plans to boost its local economy through tourism. The island, which is more than 2,000 kilometres from the nearest land mass (Africa) is still only accessible by a Royal Mail ship, which sets sail on a five-day journey from Cape Town once every three weeks. We will continue to rely on this shipping service to deliver applications to the IP Registry until the position in respect of the airport is finalised.



Darren Olivier, Menzi Maboyi with Ms Mhando and Registry staff



Customs training, Kampala



Search and seizure operation

SWAZILAND



ASSOCIATE OFFICE AND REGISTRY VISIT

In November 2016, Adams & Adams Partner, Nelia Hickman, and Africa Practice Manager, Menzi Maboyi travelled to Swaziland to visit the Adams & Adams Associate Office and the Swaziland Registry. The main purpose of the visit was to meet with Registry officials to discuss Registry operations and outstanding matters. Current Registrar, Mr. Stephen Magagula, updated the team on the current status of the Patents Bill 2015 and the Trade Mark Amendment Bill 2015. There are a number of exciting IP initiatives in Swaziland and regular visits will continue to be made to the Registry to offer our support to any initiatives that assist with the development of IP in Swaziland.

TANZANIA



ASSOCIATE OFFICE AND REGISTRY VISIT

Adams & Adams Partner, Darren Olivier, and Africa Practice Manager, Menzi Maboyi travelled to Tanzania in September 2016. The purpose of the trip was to visit the Adams & Adams Associate Office in Dar es Salaam in order to assess their ongoing capabilities, review files and undertake a due diligence on their operations.

A visit to the Tanzanian IP Registry offices, which are located within the **Business Registration & Licensing Agency (BRELA)**, saw the team holding discussions with the Assistant Registrar, Ms. Loy Mhando. A tour of the facility was organised which revealed impressive developments since the previous visit in 2013.

A new Industrial Property Act that will ensure the consolidation of patents and trademarks, and include industrial designs and trade secrets, is being developed in Tanzania.

TUNISIA



RATIFICATION OF BEIJING TREATY ON AUDIOVISUAL PERFORMANCES

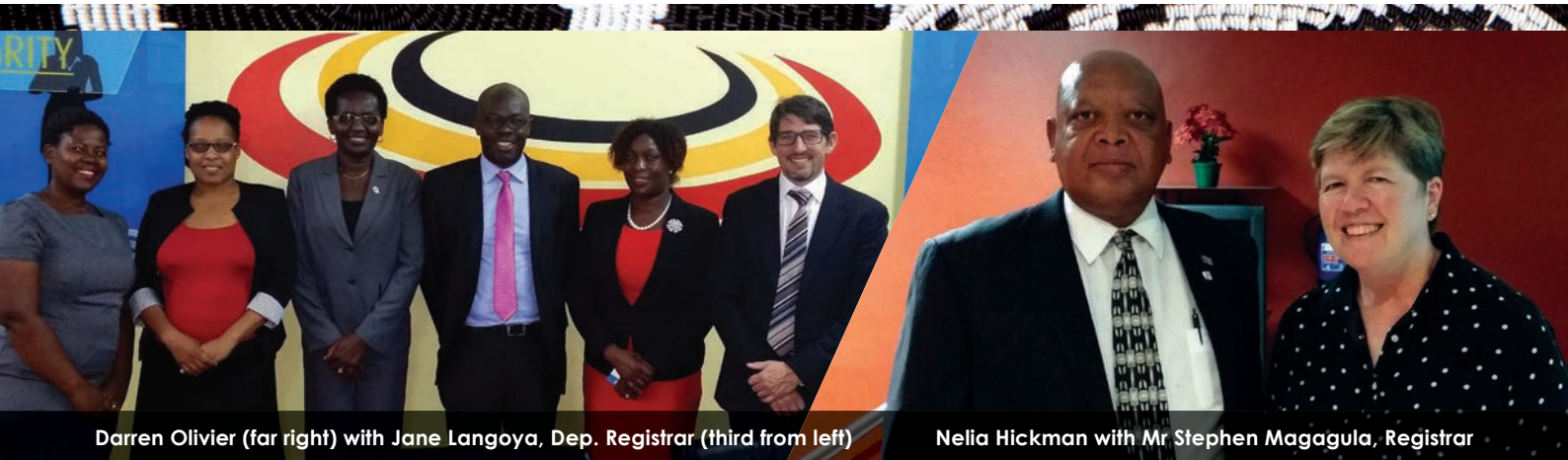
Tunisia became one of the latest African territories to ratify WIPO's Beijing Treaty on Audiovisual Performances. The Beijing Treaty on Audiovisual Performances, adopted in June 2012, deals with the intellectual property rights of performers in audiovisual performances. It grants performers four kinds of economic rights for their performances fixed in audiovisual formats (such as motion pictures), namely the rights of reproduction, distribution, rental and marketing.

UGANDA



INDUSTRIAL PROPERTY REGULATIONS PASSED

On 10 February 2017 the Industrial Property Regulations were gazetted by the Ugandan government bringing the Industrial Property Act, 2014 ("the Act") into full effect. Despite the fact that the Act came into force in February 2014, the implementing regulations were outstanding, hampering the implementation of the 2014 Act.



Darren Olivier (far right) with Jane Langoya, Dep. Registrar (third from left)

Nelie Hickman with Mr Stephen Magagula, Registrar

REGISTRY VISIT

Adams & Adams Partner, Darren Olivier, and Africa Practice Manager, Menzi Maboyi travelled to Uganda in September 2016. The purpose of the trip was to visit local partners in Kampala in order to assess their ongoing capabilities, review files (where necessary) and to undertake a due diligence on their operations. The Adams & Adams team also paid a visit to the offices of the **Uganda Registration Services Bureau (URSB)** and met with the Deputy Registrar, Ms. Jane Langoya, and senior officials within the Registry. A tour of the offices revealed the concerted efforts being made by the Registry to modernise its operations through the use of the IPAS system.

ANTI-COUNTERFEITING TRAINING WORKSHOP

In June 2016, Adams & Adams Partner, Charl Potgieter, travelled to Kampala to conduct anti-counterfeiting training workshops with members of the **Uganda Customs Authority, the National Bureau of Standards (UNBS)** and the **Uganda Police Force**.

ZAMBIA



NEW DESIGN ACT PASSED

Zambia has passed into law the new Industrial Design Act No. 22 of 2016, repealing the Registered Designs Act of 1958. The new Design Act came into force in June 2016. Some of the provisions contained in the new Act address novelty requirements, grace periods and exceptions in respect of compliance with novelty requirements, restoration of rights, amendment of a design application and duration thereof.

OTHER LEGISLATIVE DEVELOPMENTS

The following legislation was also passed in 2016:

1. Lay-out Designs of Integrated Circuits Act (No.6 of 2016)
2. Protection of Traditional Knowledge, Genetic Resources & Expressions of Folklore Act (No.16 of 2016)
3. Patents Act (No.40 of 2016).

At the time of going to the press, none of the aforementioned Acts have come into force, as the Regulations thereunder are still being finalised. We await the issue of the Commencement Orders for each of these Acts.

The Trade Marks Bill is expected to be published during the course of 2017 before submission to Parliament. The Bill is expected to allow for the registration of service marks and to also introduce International Registrations, under the Madrid Protocol.

ZIMBABWE



DOMESTICATION OF THE MADRID PROTOCOL

In December 2014, Zimbabwe deposited its instrument of accession to the Protocol relating to the **Madrid Agreement Concerning the International Registration of Marks** (Madrid Protocol), becoming the 94th member state of the Madrid system. Initially the Protocol was to have come into force on the 11th of March 2015, after the requisite domestication process and amendment of the Trade Marks Act. This did not happen until the successful passing of General Laws Amendment Bill in Parliament, which sought to domesticate this Protocol into the Trade Marks Act.

In terms of this new section, any trade mark which was registered by the Trade Marks Office in accordance with the Madrid Protocol and in respect of which Zimbabwe has been designated would have the same effect as a trade mark registered under the Trade Marks Act and such trade marks would be accorded the same protection as trade marks registered directly in Zimbabwe.

Although the new regulations make it possible for owners of international registrations (obtained via WIPO's Madrid system) to designate Zimbabwe, it is nonetheless to be recommended that brand owners continue to secure registration of their valued trade marks on a national basis in Zimbabwe. Trade marks filed through the Madrid system will remain speculative in Zimbabwe until such time as the Zimbabwean IP Office (ZIPO) has digitized all of their records (and uploaded them to WIPO's IPAS system by which Madrid designations are recorded) and ZIPO is equipped to examine applications within WIPO's strict timelines. This process is likely to take some time owing to Registry backlogs, staffing issues and a lack of proper investment of funds by the Zimbabwean Government into the improvement of ZIPO's operations.

ZIMBABWE ENACTS THE GEOGRAPHICAL INDICATIONS ACT

Geographical indications in Zimbabwe are regulated in terms of the Geographical Indications Act. Despite the Act having been passed in 2002, it only came into force after 2006, albeit without the enabling regulations to bring this Act into full operation. This anomaly has since been rectified by the introduction of the Geographical Indication Regulations, 2016 – gazetted on 8 July 2016.

RECENT MATTERS | VIVON INVESTMENTS (PVT) LTD V WIN-KING INVESTMENT (PVT) LIMITED

The High Court of Zimbabwe delivered a landmark ruling on trade mark infringement in a case involving **Vivon Investments (Private) Limited** and **Win-King Investments (Private) Limited**, both bottled water manufacturers. **Vivon**, the producer of **VIVON** bottled water, alleged that **Win-King** had infringed its trade marks in that it was also producing its water branded **VICTORIA PLUS** which water carried a logo which was confusingly similar or identical to that of **Vivon**. **Vivon** argued that it had trade mark rights in respect of its logo since the logo was registered as a trade mark and **Win-King** did not have the right to use a logo confusingly similar to that of **Vivon** since that would be an infringement of **Vivon's** registered trademarks.

The Judge ruled in favour of **Vivon** and stated that the law was clear as regards the use of registered trade marks by unauthorised persons. The Judge further made it clear that the logo used by **Win-King** on its **VICTORIA PLUS** water was likely to cause confusion to the buying public that the water was the same as that of **Vivon**. **Win-King** was ordered to stop trading in or dealing with goods bearing the logo identical or similar to that of **Vivon**. **Win-King** was further ordered to immediately recall all goods bearing the offending packaging.



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