



ARIPO

*African Regional Intellectual
Property Organization*

Discussion on the Legal Framework of the Banjul Protocol

And

Implementing Regulations

Charles Pundo
Head of Formality Examination ARIPO

Online Workshop on the Banjul Protocol

April 28, 2021



Fostering Creativity and Innovation for Economic Growth and Development in Africa

Outline

- Brief ARIPO Historical Background
- Membership; Objectives and Mandates
- Legal Instruments
- Banjul Protocol: purpose, mandates, Current Contracting States; Geographical representation
- Procedures under the Banjul Protocol
 - Filing and Formality Examination
 - Effects of Registration
 - Administration
- Ratification/Accession, denunciation or amendments
- Advantages and outlook



Brief ARIPO Historical Background

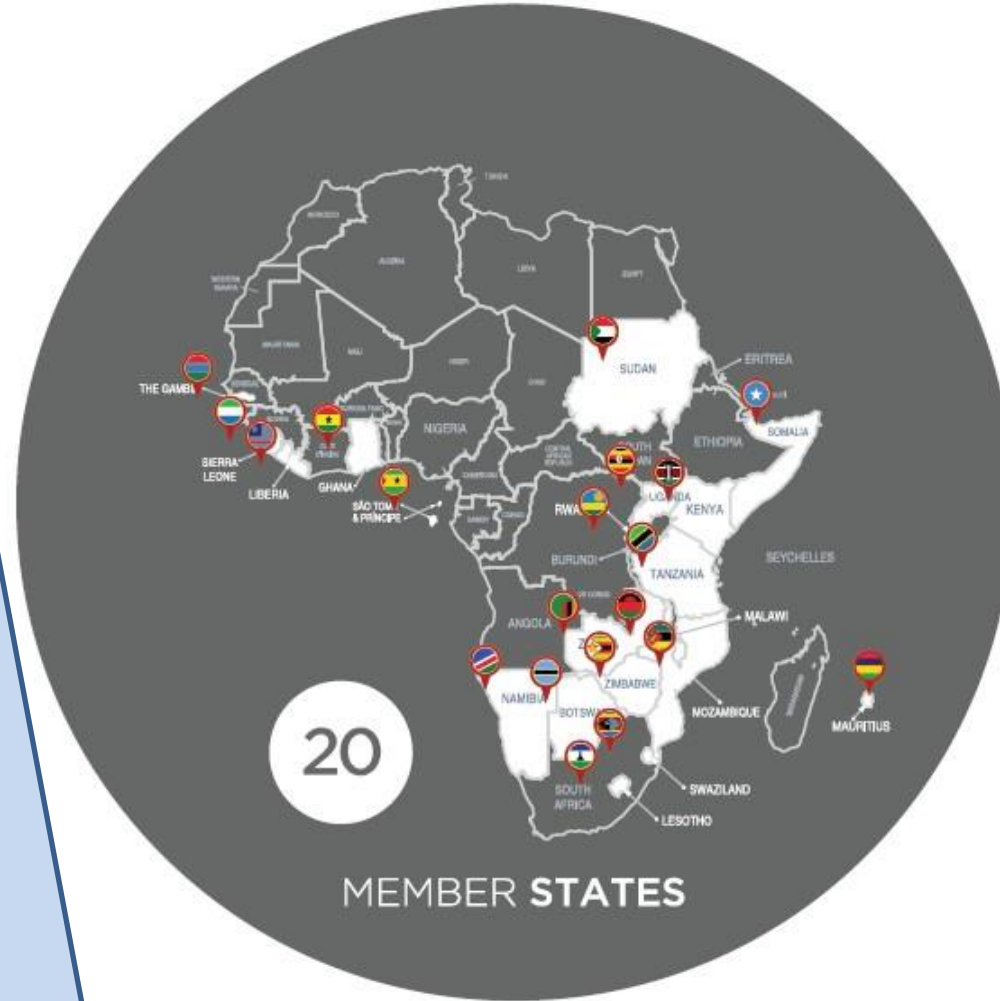
- The African Regional Intellectual Property Organization (ARIPO) was created by the Lusaka Agreement, signed on December 9, 1976
- The Organization was on creation, known as the “English Speaking African Regional Industrial Property Organization (ESARIPO)”
- On June 1, 1981, the Organization established its own Secretariat in Harare, Zimbabwe
- Organization’s name was changed from ESARIPO to the African Regional Industrial Property Organization (ARIPO)
- On acquiring mandate on Copyright and Related Rights the name was again changed to the current name, the African Regional Intellectual Property Organization (ARIPO)



ARIPO MEMBERSHIP

Member States

- Botswana
 - Eswatini
 - The Gambia
 - Ghana
 - Kenya
 - Liberia
 - Lesotho
 - Malawi
 - Mauritius
 - Mozambique
 - Namibia
 - Rwanda
 - Sao Tome & Principe
 - Sierra Leone
 - Somalia
 - Sudan
 - Tanzania
 - Uganda
 - Zambia
 - Zimbabwe
- =20



Observer States:

- Angola
- Burundi
- Cape Verde
- Ethiopia
- Eritrea
- Nigeria
- Seychelles
- South Africa
- South Sudan



Fostering Creativity and Innovation for Economic Growth and Development in Africa

ARIPO Main Objectives

- Promotion, harmonization and development of IP
- Establish common services and organs for IP coordination, development and harmonization
- Establish IP Capacity Building Schemes
- Organize conferences, seminars and meetings on IP
- Promote exchange of ideas and research on IP
- Promote a common view and approach in dealing with IP matters
- Support members in acquisition of IP based technologies
- Development of IP systems for the economic benefits of its member states.

Lusaka Agreement: Article III



Fostering Creativity and Innovation for Economic Growth and Development in Africa

ARIPO Protocols

- To implement the mandates, four protocols are currently in place and are:
 - The Harare Protocol on Patents and Industrial Designs (includes Utility Models).
 - The Harare Protocol is linked to the Patent Cooperation Treaty (PCT)
 - The Banjul Protocol on Marks.
 - The Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore
 - Arusha Protocol for the Protection of New Varieties of Plants (not operational)
- Draft protocol of the Voluntary Registration of Copyright and Related Rights is set for adoption



Banjul Protocol on Marks



Fostering Creativity and Innovation for Economic Growth and Development in Africa

Banjul Protocol: brief background

- **Banjul Protocol on Marks:**
 - 1993 - Adoption of the Protocol (Banjul, The Gambia)
- **Regulations for Implementing the Banjul Protocol**
- 1995 - Adoption of the Implementing Regulations (Kariba, Zimbabwe)
- **Entry into Force:**
 - 1997 - entered into force after ratification/accession by 3 states (Section 11:3)
- **Amended:**
 - November 1997; May 1998; November 1999; August 2004
 - November 2013, 2014, 2015, 2018 and 2019
- **Administrative Instructions:**
 - Established in accordance with Rule 17.5 of the Regulations



Banjul Protocol: purpose

- To achieve interaction between ARIPO and member states in field of Marks
- To establish common service for marks
- To pool together the resources of its member countries



Banjul Protocol: mandate

- Receive Mark Applications
- Register Marks
- Administer the Marks

section 1



Fostering Creativity and Innovation for Economic Growth and Development in Africa

Current Contracting States

- Out of the 20 Member States of the Lusaka Agreement, 11 are contracting states to the Banjul Protocol and these are:
 - Botswana - October 29, 2003
 - Liberia - March 24, 2010
 - Lesotho - February 12, 1999
 - Malawi - March 6, 1997
 - **Mozambique** - **August 15, 2020**
 - Namibia - January 14, 2004
 - São Tomé and Príncipe - February 27, 2016
 - Kingdom of Eswatini - March 6, 1997
 - Uganda - November 21, 2000
 - United Republic of Tanzania - September 1, 1999
 - Zimbabwe - March 6, 1997

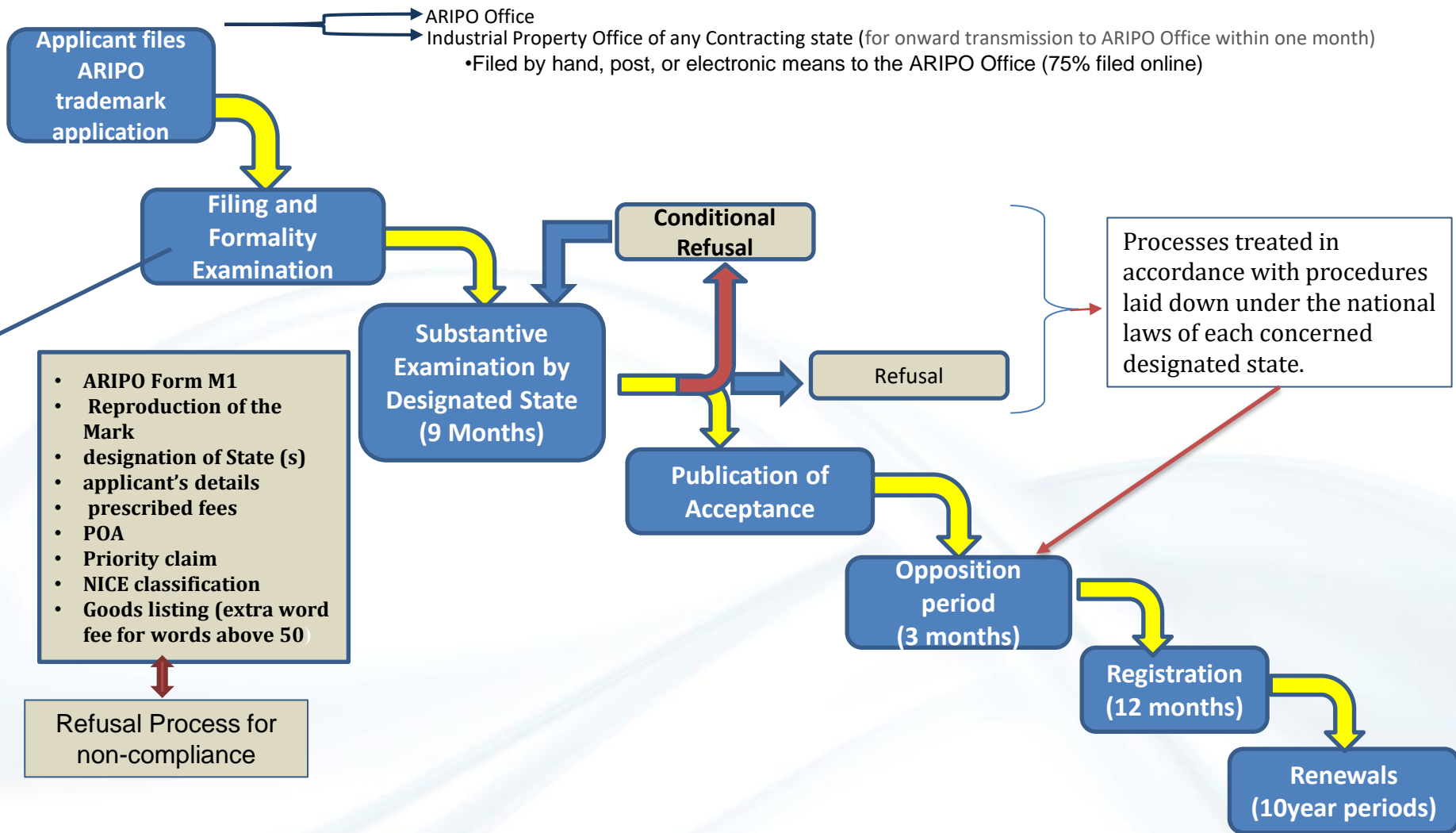
- Domestication:
 - ARIPO is also working to ensure that all contracting states domesticate the Banjul Protocol.



Geographical Representation of Banjul Protocol



ARIPO Trademark Procedures under the Banjul Protocol



BANJUL PROTOCOL: filing applications and transmittal

- Directly with the office (ARIPO)
 - Post, email, courier, electronic
 - (75% of applications filed electronically)
- Through contracting state (receiving office)
 - ✓ application to be transmitted to ARIPO from receiving office within one (1) month

section 2; rule 5bis



BANJUL PROTOCOL: who can file?

- Natural person
- Duly authorized representative

Note:

where applicant is not from or does not have place of business in any contracting state; representation is compulsory

section 2



BANJUL PROTOCOL: application contents?

- Fully completed request form ([Form M1](#))
 - Full name and address of the applicant
 - Designation of states
 - Indication of goods and classes
 - Copies of a representation of the mark
 - Declarations
 - Application for registration of a registered user
- Fees or undertaking
- Priority claims

section 3bis; rule 4, 7



BANJUL PROTOCOL: fees?

- Application subject to payment of fees
 - Fees paid in USD or equivalent
 - Fees may be paid in local currency
- Fees shall be distributed 50% office 50% designated states
- Declaration of **individual fees** by contracting state
- Contracting state can request **for share of fees** at any time

rule 10



BANJUL PROTOCOL: filing and formality examination

- Instituted by the office
- Involves checking for:
 - duly completed application Form M1
 - application and designation fees
 - power of Attorney (Form M2)
 - priority document
 - required copies of the mark
 - Excess words fee

section 3; rule 3,6,7



BANJUL PROTOCOL: refusal, appeal, conversion

- Refused if filing or formal requirements are not met
- Invitation to comply within specified period is issued
- Applicant can request office to reconsider refusal
- If refusal is upheld:
 - applicant can lodge an appeal against the decision with the ARIPO Board of Appeal.
 - or submit request to convert application to national application within specified periods

section 5:2-4



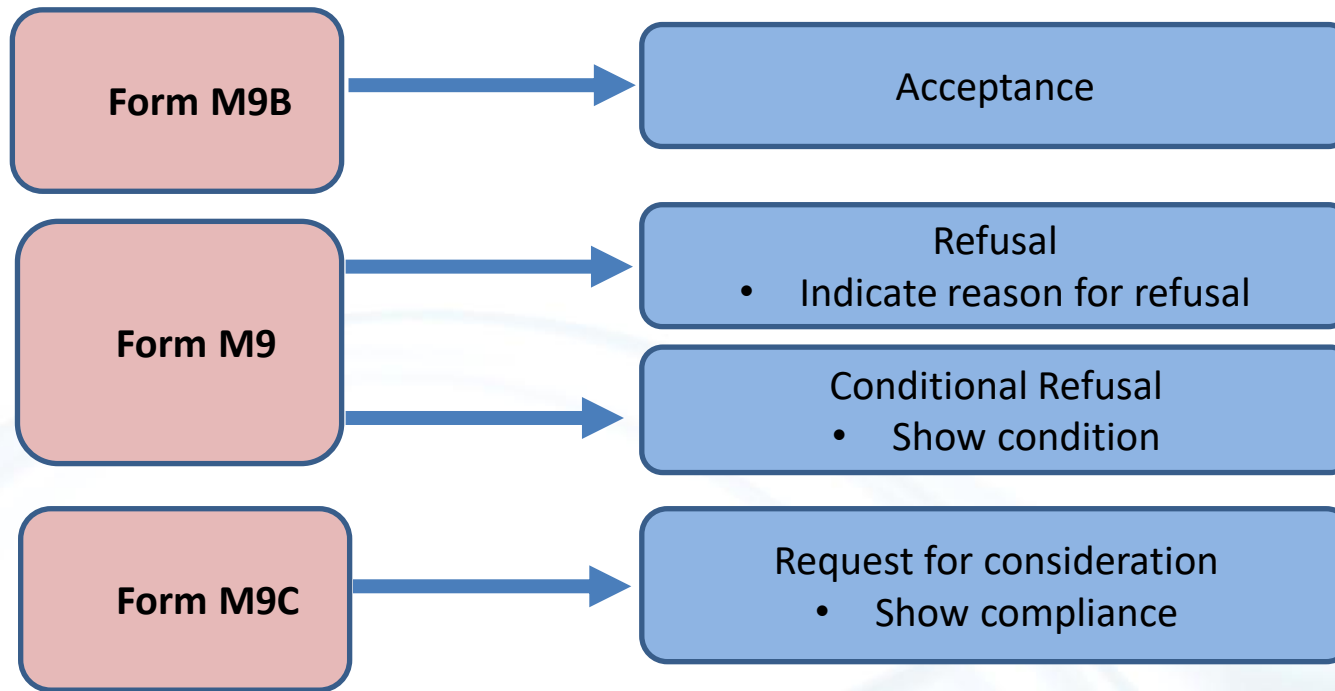
BANJUL PROTOCOL: substantive examination

- All applications to be examined in accordance with requirements of the national law of each designated state
- Examination to be conducted within nine months
- Each state to issue a written communication of acceptance or refusal
- Decision to be communicated to ARIPO within one month from date of decision

section 6; rule 11



Substantive Examination Communication



- Where there is no communication/objection from a designated State, [after expiry of 9 months](#), Applicant may respond [to a refusal through M9C within 2 months](#)
- Designated State shall respond [to M9C within 2 months](#)

section 6

BANJUL PROTOCOL: publication and registration procedures

- Accepted or refused applications to be published in the ARIPO Marks Journal
- Accepted applications shall be registered after 3 months opposition period and on payment of relevant fees, unless opposed.
- All registered marks shall be published in the ARIPO Marks Journal

section 6bis; rule 11bis, 15



BANJUL PROTOCOL: effects of registration and cancellations

▪ Registration

- Rights conferred by the registered mark by ARIPO office shall be the same effect in every designated states as if filed under its national laws.

▪ Cancellation

- National laws of designated state shall apply to the cancellation of a registered mark.

section 8



BANJUL PROTOCOL: opposition procedures

- Oppositions accepted within 3 months after publication as accepted
- To be lodged with ARIPO but prepared in accordance with designated state laws
- Opposition to be treated according to national laws of designated state (s)
- Designated State to notify applicant through ARIPO of its decision
- Decision to be communicated to applicant
- Decision to be recorded in ARIPO register and published in ARIPO Journal

section 6bis, rule 11ter



BANJUL PROTOCOL: duration and renewal

- Mark's duration shall be for renewable periods of ten years
- Renewal shall be on or before the date of expiry of the duration
- A grace period of six month is allowed with penalty
- Registration is deemed lapsed due to nonrenewal and removed from the register
- **Restoration**
 - maybe restored within 6 months from date of removal from register and on payment of restoration fee

section 7; rule 12,13bis



BANJUL PROTOCOL: registration of licenses; assignments and other rights

- Office registers all licenses, assignments and other rights
- Office shall notify designated state(s) of such registrations
- Where such registration is done in a designated state, such state shall notify the office within two months

rule 14



BANJUL PROTOCOL: subsequent designations

- Applicant can designate any other state which becomes party to the protocol
- Applies to registered or applications pending registration
- The designation shall be deemed to be a new application in the concerned state
- Shall be examined in accordance with national laws
- Filing date shall be the same date of earlier application
- Period of protection shall expire on same date of earlier application

section 9; rule 9



BANJUL PROTOCOL: ratification/accession

- “Any State which ratifies or accedes to this Protocol shall, by the instrument of ratification or accession, be deemed to have indicated its acceptance to be bound by the provisions of the Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO) and such State shall become a member of ARIPO on the date on which it deposits its instrument of ratification or accession to this Protocol.” Section 11:5
- Protocol shall come into effect 3 months after deposit of ratification or accession

section 11



BANJUL PROTOCOL: amendments /denunciation

- Amendments can be done at the instance of a member state during the administrative council session
- Notification of denunciation to be addressed to Director General
 - denunciation takes effect 6 months after receipt of such notification

section 12; rule 16



Advantages of the ARIPO system

- Streamlined, simplified, cost effective, faster and user-friendly application procedures
- Single application for protection in all or selected designated states
- Supplementary route to the existing national routes
- Single representation on all designated states;
- Centralized renewal fees payment
- Centralized administration
- Share of fees with contracting states



Future of the Protocol

- A system interactive with the national registration system
- Centralized examination system
- Digitalized system (MS Module)
- Country benefits
 - ✓ Larger portion of fees to benefit Member States
- All member states to joining the Banjul Protocol
- More African countries joining the organization.
- Domestication of Protocol by all contracting states

END



The African Regional Intellectual Property Organization (Aerial View)



Fostering Creativity and Innovation for Economic Growth and Development in Africa



African Regional Intellectual Property Organization

- ▶ Address: 11 Natal Road, Belgravia,
Harare, Zimbabwe
- ▶ Tel: **+263 4 794 065 /6/8/54/74**
- ▶ Fax: **+263 4 794 072**
- ▶ **mail@aripo.org**
- ▶ **Website: www.aripo.org**