

the  
**MADRID**  
memorandum



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THE APPLICABILITY OF THE  
**MADRID SYSTEM IN AFRICA**

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Although the Madrid system functions very well in most countries outside of Africa where IP laws are at similar stages of development and IP Offices utilize advanced technologies and maintain digital registers and systems, the reliance on the Madrid-system in most African countries carries with it a degree of commercial risk (the level of which depends on the jurisdiction concerned).

## Key criteria

**For the system to function effectively, the following key requirements need to be met:**

1. National Trade Mark or IP laws should expressly recognize the validity and enforceability of international registrations. Preferably, Regulations should also be implemented to offer guidance and direction to Registry officials on how to process Madrid-designations.
2. The national IP Office should process, examine and publish all Madrid-designations and indicate any objections to WIPO within the strict timelines (12 – 18 months).
3. The IP Office should maintain a singular (digital) trade marks register which contains national and international registrations.

## Africa Madrid Members

**The following 22 African jurisdictions can be designated in terms of the Madrid system:**

Algeria, Botswana, Egypt, Gambia, Ghana, Kenya, Lesotho, Liberia, Madagascar, Malawi, Morocco, Mozambique, Namibia, OAPI, Rwanda, Sao Tome and Principe, Sierra Leone, Sudan, Swaziland, Tunisia, Zambia and Zimbabwe.

## Enforceability

Of these member states, **only four countries** meet the key criteria that are mentioned above, namely **Kenya, Mozambique, Morocco** and **Tunisia**.

Even in these countries, however, some level of risk remains for owners of international registrations as IP Offices struggle with administrative backlogs which prevent the timeous examination of all applications (including international registrations). Recently, the Kenyan IP Office published a list of 125 international registrations which were not examined within WIPO's timelines, inviting third parties to apply for the rectification of the trade marks register if they may have conflicting trade mark rights.

In the other African Madrid member countries, many obstacles remain before the Madrid system can be relied upon to secure enforceable trade mark rights. As a firm, we are aware of an increasing amount of cases where the owners of international registrations were under the mistaken belief that they secured enforceable statutory rights in some African Madrid member countries, to only learn at a later stage, when enforcement becomes a priority, that no enforceable rights were established on a national level in those countries at all.

Further, it bears consideration that a large number of countries in Africa are considered to be **'First-to-File jurisdictions'** where common law rights arising from the use of a trade mark in commerce are not formally recognized. In these jurisdictions, the first party to successfully register a mark may be deemed to be the true proprietor, regardless of whether this reflects commercial reality or not. Consequently, a level of risk is introduced for brand owners who seek to rely solely on the Madrid system to secure enforceable trade mark rights in these jurisdictions, if forming part of the jurisdictions discussed above where the Madrid system does not function well yet.

## General

International (Madrid) registrations are vulnerable to a central attack on the base application/registration during the first 5 years and any invalidation, limitation or cancellation action that succeeds against the base application/registration during this time would also affect all other country designations.

International registrations may also not suit companies with complex licensing or ownership structures as all country designations need to reflect the same ownership details.

## Conclusion

The Madrid system offers a cost-effective trade mark registration system where multiple Madrid member countries are concerned, but careful consideration needs to be given as to whether the rights arising from an international registration would be enforceable in all designated jurisdictions, especially where African countries are concerned, for the reasons set out above.

**For more information on this, please contact us at: [madrid@adams.africa](mailto:madrid@adams.africa)**