

WIPO's Madrid System

How well does it perform in Africa?

The World Intellectual Property Organization's (WIPO) Madrid System offers a convenient and cost-effective solution for registering and managing trade marks worldwide. Through the filing of a single international trade mark application, and payment of one set of fees, it is possible for brand owners to apply for statutory protection in up to 131 countries. Trade mark portfolio management through a centralized system, through which marks can be renewed, updated and protection expanded to cover additional countries over time, is a stand-out feature that appeals to most international brand owners and trade mark portfolio managers.

The Madrid System functions at its very best in member countries with modernized IP laws, fully digitized systems, and Registry examination practices that are aligned with international best practice.

This memorandum briefly sets out some of the important factors that brand owners who intend to rely solely on the Madrid System to secure enforceable, statutory trade mark rights in African member countries should bear in mind.

Key criteria

For the Madrid System to function effectively, the following key requirements need to be met:

1. National trade mark laws should expressly recognize the validity and enforceability of international registrations secured via the Madrid System. It should also establish clarity on how the national Trade Marks Registry must process and examine designations made under the Madrid Protocol, and how objections and oppositions must be managed and notified to WIPO.
2. The national Trade Marks Registry must be able to consistently process, examine, and publish designations made under the Madrid Protocol within the prescribed 12 to 18-month period allowed for the notification of any objections or oppositions to WIPO. Failure to do so could result in designations being examined and refused outside of WIPO's timelines, and ultimately lead to inconsistencies in that WIPO's database may reflect a designation as finalized or "registered", while the national Registry's database reflects a mark as "refused" or "under opposition".
3. The national IP Office should maintain a centralized and digital trade marks register in which all national marks and international registrations are processed and

recorded, and that is linked with WIPO's IPAS or "IP Office Administration System" in Geneva to enable notification exchange in real-time. It should also have appropriate infrastructure, technical support, and data protection systems in place to ensure that the Registry's online systems are not subjected to extended downtimes due to technical issues that may arise from time to time.

Africa Madrid Members

At present, the following 24 African jurisdictions are members to the Madrid Protocol and can be designated under international registrations:

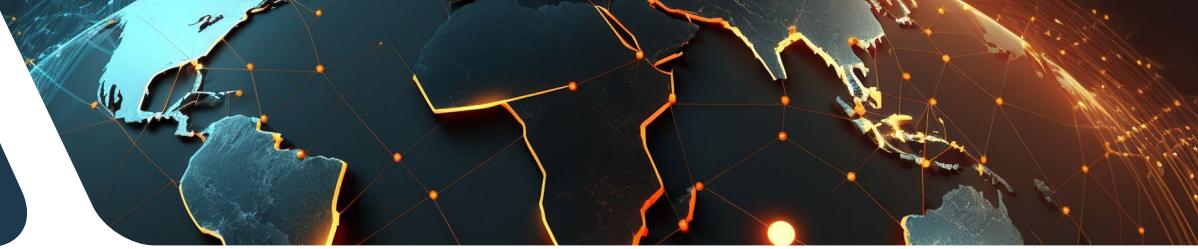
Algeria, Botswana, Cape Verde, Egypt, Gambia, Ghana, Kenya, Lesotho, Liberia, Madagascar, Malawi, Mauritius, Morocco, Mozambique, Namibia, OAPI, Rwanda, São Tomé and Príncipe, Sierra Leone, Sudan, Swaziland, Tunisia, Zambia, and Zimbabwe.



Enforceability

Of these member states, the following jurisdictions meet the key criteria that are mentioned above for the Madrid System to function properly: **Algeria, Egypt, Kenya, Morocco, OAPI, and Tunisia.**¹

¹ This is at the time of writing this memo in July 2024. Adams & Adams is actively monitoring the performance of the Registries of all African Madrid Protocol member countries and will provide updated recommendations from time to time. The Egypt IP Office has processed international registrations (IRs) for many years, but their national laws have not been properly amended yet to fully recognize the validity and enforceability of IRs. Their Courts have confirmed the enforceability of IRs since at least 2009. The Namibia IP Office started processing IRs recently, and early signs are positive, although a decision was taken by the Registrar to issue registration certificates for all IRs, and around 12 months later, no certificates have been issued for IRs, casting unnecessary doubts over enforceability until such time as certificates have been issued nationally. The Botswana Registry seems to be processing IRs efficiently, but their online systems have been subjected to extended downtimes in recent years, at times also resulting in data losses requiring the reconstitution of the Registry's records, and casting doubts over the proper processing of IRs within WIPO's prescribed timelines. If the Registry can prevent similar occurrences in the years ahead, the Madrid system could be relied on with a good deal of certainty in Botswana. The Mozambique Registry is examining IRs efficiently, but there are reported issues with the timing and clarity of notifications made by the Registry of objections and oppositions to WIPO, resulting in situations where discrepancies exist between WIPO's international database and the national register regarding the recognized validity status of affected IRs. The Mauritius IP Office commenced with the processing of IRs in 2023, and while early signs are positive, we will review the Registry's performance over the course of the next 12 months before making any recommendations.



Even in these countries, a level of risk remains for owners of international registrations as most African Registries find it challenging to consistently examine and publish trade mark applications within the prescribed 12 to 18-month timeline.

As a firm, we are aware of an increasing number 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 through international registrations, to only learn at a later stage when enforcement becomes a priority, that no enforceable rights were secured on a national level in those countries at all.

This would mainly be due to the failure of the national Trade Marks Office to consistently examine international designations within WIPO's timelines, and even though WIPO does not recognize refusal decisions or oppositions notified outside of the Madrid Protocol timelines, the national Trade Marks Office would often hold a different view, that they should be able to refuse marks or allow oppositions if their internal backlogs or technical difficulties with online systems prevented them from timely examination and publication.

This could result in an unfortunate contradiction arising, that WIPO's database of international registrations would reflect a mark as "registered", while the national trade marks register may reflect the mark as "refused" or "under opposition". A third party may subsequently have registered the same or similar mark nationally, and when the owner of the international mark seeks to enforce their rights (e.g., against a local distributor who acted in bad faith) they discover that they have no statutory rights to rely on and enforce under national law.

Additional considerations

Several countries in Africa are so-called, "First-to-File-jurisdictions", where common law rights arising from the use of a trade mark in commerce are not formally recognized under national trade mark laws. 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. This introduces an additional layer of risk for brand owners who seek to rely solely on the Madrid System in African member countries where the System does not yet function properly.

International 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.

Trade mark owners who wish to receive registration certificates, issued by the national IP Offices of African countries where they successfully registered their trade marks, should not rely on the Madrid System as certificates are only issued by national Registries for marks filed nationally (with the exception of Namibia, where the Registrar recently issued a directive that certificates will be issued for international registrations as well).

Conclusion

While the Madrid System offers a convenient and cost-effective solution for registering and managing trade marks worldwide, the System does not yet function as intended in most of Africa's member countries. Trade mark owners and portfolio managers should carefully consider enforcement prospects before making decisions to solely rely on the Madrid Protocol to secure statutory trade mark rights in Africa's member countries.

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