



IMPORTANT UPDATES ON
TRADEMARK
PROTECTION
UNDER THE OAPI



The Bangui Agreement, which governs the protection of intellectual property rights of African Intellectual Property Organization (OAPI) member states, has been revised, introducing some changes to the process of registering trademarks at the OAPI. The revisions have now entered into force and were effective from January 2022.

These changes are discussed in detail below.

- **The admission of two new Categories and three additional types of trademarks**

As of January 2022, OAPI now registers two new categories and three new types of trademarks. The two new categories are the Certification Marks and Marks with joint ownership. The three new types of registrable trademarks are Audible signs such as sounds and musical phrases, audio-visual signs, and Series marks. These new categories and types of marks registrable at OAPI present a new opportunity for businesses, as it protects innovative commercial and advertising strategies. Additionally, registration of certification marks gives companies or associations a competitive edge in the market and helps to demonstrate the quality of their products.

- **The opposition of Trademarks before registration**

The previous system, in which trademarks could only be challenged after they were registered, has been overhauled. Trademark applications will now be published for opposition before registration. The opposition term has been reduced from 6 months to 3 months, and the term for filing an appeal against opposition decisions will be 2 months instead of 3 months. Additionally, the amended agreement permits the division of multi-class applications to overcome a provisional refusal. This means that if a mark is refused in some of the classes for registration, the mark can still be registered in the other classes where no objections were raised.

Also, there are now three different actions that can hinder the registration of a trademark:

- **opposition by a third party**
- **an ownership claim;**

N: B (Both are administrative procedures and are brought before the registration certificate is issued).

- **litigation (this can be brought by a person who did not react during the opposition period, and after the registration certificate has been issued).**

This change has a dual effect. This means that proprietors may easily react to the opposition before expending funds on registration and take the initiative to develop an alternative strategy where necessary. It also means that companies can bring opposition against marks that are likely to infringe on their registered marks before the infringing mark is registered.

● **Substantive Examination of Trademarks**

The new amendment also introduces substantive examination of trademarks to be filed at the OAPI. The examination of marks on the basis of substance shall be done to determine the following:

- The distinctiveness of the mark;
- To ensure it is not contrary to public policy, morality, or the law;
- To ensure it is not liable to mislead the public, in particular as to the geographical origin, nature, or characteristics of the goods or services in question;
- To ensure that it does not reproduce, imitate, or incorporate armorial bearings, flags, or other emblems of a state save for where the competent authority of that State or organization has granted its permission.

If all conditions for admissibility are not met, the applicant's agent shall be notified and given three months to regularize the file. If after six months such regularization is not done, the file shall be rejected, and the filing fee forfeited. However, the rejection can be appealed against within 60 days (two months) from the date of notification.

● **Common law rights**

Common Law rights in trademarks are now formally recognized in OAPI, and a third party is entitled to file a so-called 'claim of ownership objection' during the opposition period on the basis of prior use made of a mark. If the opposition succeeds on this basis, the Registry will assign the trademark application to the successful claimant

● **Customs/Border Collaboration**

We can now offer "customs/border services" for clients - Counterfeit products can be detained by customs authorities on the basis of an OAPI trademark registration. Trademark owners can launch criminal or civil proceedings within 10 days from the detention or seizure of suspected counterfeit products

- **Enforceability of Madrid Applications**

The Bangui Agreement now formally recognizes the validity and enforceability of International Registrations designating OAPI obtained through WIPO's Madrid System. However, some uncertainties remain because not all OAPI member states have ratified OAPI's accession to the Madrid Protocol, and this is fundamental to the enforceability of this position in the member states.

- **Fees and Administrative issues**

The OAPI Registry has revised its official fee schedule. The new fee structure takes effect on January 1, 2022. The most significant change concerns trademark filing fees, which have been reduced but no longer includes up to three classes, with one fee. Therefore, when a multi-class application is filed, official filing fees are now calculated per class. The Registry also reported that it is on track to implement an online e-filing system and related procedures by 2022.

These new changes are already being implemented and have affected the current official fees for filing at the OAPI. We are closely monitoring these developments and shall keep you updated.