

**Regulations for Implementing the Banjul Protocol on Marks
Within the Framework of the
African Regional Industrial Property Organization
(ARIPO)***

**(adopted by the Administrative Council of ARIPO at Kariba (Zimbabwe)
on November 24, 1995, and amended on November 28, 1997,
May 26, 1998 and November 26, 1999)**

TABLE OF CONTENTS

	<i>Rule</i>
Definitions	1
Conditions of Registration; Independence of Protection.....	2
Classification	3
Requirements of Application	4
Application Procedure	5
Formalities Examination by the Office.....	6
Time Limits	<i>6bis</i>
Representation of the Mark	7
Right of Priority.....	8
Later Designations	9
Fees	10
Examination by a Designated State.....	11
Duration and Renewal of Registration	12
Changes in Registered Particulars.....	13
Restoration of a Mark.....	<i>13bis</i>
Registration of Licenses, Assignments and Other Similar Rights.....	14
Registration and Publication	15
Amendment.....	16
General Provisions	17
Schedule I: Schedule of Fees ¹	
Schedule II: Schedule of Forms ²	
Schedule III: International Classification of Goods and Services ³	

**Rule 1
Definitions**

For the purposes of these Regulations, unless the context otherwise requires:

“Administrative Instructions” means the Administrative Instructions established by the Director General of the Office in accordance with Rule 15.4;

“application” means an application for registration of a mark;

“assignment” means transfer by act of parties concerned;

“Board of Appeal” means the Board of Appeal established under Section *4bis* of the Protocol on Patents and Industrial Designs Within the Framework of the African Regional

Industrial Property Organization (ARIPO) adopted at Harare, Zimbabwe, on December 10, 1982⁴;

“the Protocol” means the Protocol on Marks Within the Framework of the African Regional Industrial Property Organization adopted at Banjul, The Gambia on November 19, 1993⁵;

“Contracting State” means the State that adheres to the Banjul Protocol;

“designated State” means any State designated in the application in accordance with Rule 4;

“Office” means the Office of the African Regional Industrial Property Organization (ARIPO);

“Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1983, as revised and amended⁶;

“International Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957 as revised and amended⁷;

“pending mark” means a mark which is the subject of an application for registration;

“Register” means the Register of Marks kept under the provisions of the Protocol and these Regulations;

“registered mark” means a mark which is actually on the Register;

“registered user” means a person who is registered as such under Rule 15.1;

“transmission” means transfer by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being an assignment.

Rule 2

Conditions of Registration; Independence of Protection

An application for the registration of a mark may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal has not been effected in the country of origin as defined in Article 6*quinquies*.A(2) of the Paris Convention.

Rule 3

Classification

3.1 Where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such an application shall result in one and the same registration.

3.2 However, any designated State may declare that, notwithstanding sub-rule 3.1 where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such application shall result in two or more registrations provided that each and every such registration shall bear a reference to all other such registrations resulting from the said application.

Rule 4 Requirements of Application

4.1 An application for registration of a mark on Form M1 shall contain:

- (a) a request for the registration;
- (b) the name and address of the applicant;
- (c) the designation of the Contracting States for which the registration is requested to have effect;
- (d) four copies of a representation of the mark; and
- (e) a list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification.

4.2 Where applicable, a transliteration of the mark or of certain parts of the mark, or a translation of the mark or of certain parts of the mark shall accompany the application.

Rule 5 Application Procedure

5.1 The application for registration of a mark shall be made on Form M1; where an applicant is represented, the power of attorney on Form M2 shall be filed together with the application or within two months from the date of filing.

Rule 6 Formalities Examination by the Office

6.1 The Office shall examine whether the formal requirements of an application have been complied with. If the Office finds that the application does not comply with the said requirements, it shall notify the applicant, inviting him to comply with the requirements within two months. Such notification shall be made on Form M3. If the applicant does not comply with the requirements within the specified period, the Office shall refuse the application.

6.2 Where an application is filed with the industrial property office of a Contracting State, such State shall without delay transmit the application to the Office. Transmittal of the application to the Office shall be made on Form M5. The applicant shall be notified of the transmittal on Form M6.

6.3 If the Office refuses an application, the applicant may, within three months from the date of refusal, request that the application be treated in any designated State as an application according to the national law of that State. The request for conversion of the application to a national application shall be made on Form M7.

Rule 6bis Time Limits

6bis.1 The prescribed period referred to in Section *5bis.1* of the Protocol within which the applicant may request the Office to reconsider the matter shall be two months after the date of notification of the decision of the ARIPO Office that the application has been refused.

6bis.2 The applicant may lodge an appeal against decisions of the Office to the Board of Appeal within three months after the date of notification of the decision of the Office.

Rule 7 Representation of the Mark

7.1 The representation of the mark shall be affixed on Form M1.

7.2 Where the mark consists of letters, words, numerals or punctuation signs and no special graphic features are claimed, the said elements may be reproduced by typewriter in the appropriate space on the form. One copy of the representation of any other two-dimensional mark shall be affixed to the appropriate space in the form.

7.3 Where the mark is three-dimensional, the application shall contain an indication to that effect according to Section 3 of the Protocol.

7.4 The representation of the mark shall be clear and of a durable nature. It shall be capable of direct reproduction by photography, electrostatic processes, photo effect, microfilming and other electronic means of reproduction.

Rule 8 Right of Priority

8.1 An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in or for a Convention country shall, within three months of the date of filing, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in or for which he or his predecessor in title filed such application and furnish a copy of the earlier application certified as correct by the appropriate authority with which such earlier application was filed.

Rule 9 Later Designations

9.1 The application for a later designation as provided in Section 9 of the Protocol shall be made on Form M3 and shall be subject to payment of the prescribed fee.

9.2 The Contracting State subject to a later designation shall examine the application for registration, which shall be contained in Form M3, under its national law.

Rule 10 Fees

10.1 An application for registration shall be subject to payment of the prescribed fee. The fees payable for application, registration, renewal and other matters incidental thereto are contained in Schedule I to these Regulations.

10.2 The distribution of fees between the Office and the designated States shall be fifty percent to the Office and fifty percent to designated States.

Rule 11 Examination by a Designated State

11.1 An application that complies with the formal requirements shall without delay be transmitted by the Office to all the designated States for examination in accordance with the national laws of a designated State. The transmittal of applications shall be made on Form M8 and the applicant shall be notified of such a transmittal to designated States on the same form.

11.2 The communication referred to under Section 6 of the Protocol shall be made on Form M9.

Rule 12 Duration and Renewal of Registration

12.1 The registration of a mark shall be for a period of ten years from the filing date. The registration may be renewed for further periods of ten years each on payment of the renewal fee.

12.2 The renewal fee shall be paid within twelve months preceding the date of expiration of the original registration or of the last renewal of the registration provided that a grace period of six months shall be allowed, in either case, on payment of a surcharge.

Rule 13 Changes in Registered Particulars

13.1 Request for the recording of change, such as territorial extension to one or more countries in respect of all or some of the goods and services, transfer, partial assignment for some of the goods and services or for some of the countries, cancellation of the registration, voluntary cancellation in respect of some of the countries concerned, limitation of the list of goods and services, or change in the name and address of the owner, shall be presented in a single copy, dated and signed by the applicant or his representative on Form M11.

13.2. The request for recording of change shall in all cases indicate:

- (i) the number of the mark concerned; and
- (ii) the name and address of the owner of the registration or his representative.

13.3 When a change in ownership results from a contract, the Office may require that the request indicate that fact and be accompanied by one of the following:

- (i) a copy of the contract, which shall be certified by a notary public or any other competent public authority, as being in conformity with the original contract;
- (ii) an extract of the contract showing the change in ownership, which extract shall be certified by a notary public or any other competent public authority, as being a true extract of the contract;
- (iii) an uncertified certificate of transfer signed by both the holder and the new owner;
- (iv) an uncertified transfer document signed by both the holder and the new owner.

13.4 The request shall be accompanied by the prescribed fees or an undertaking to pay such fee.

Rule 13bis **Restoration of a Mark**

13bis.1 The registration of a mark which has not been renewed for non-payment of renewal fees and which has lapsed and been removed from the Register may be restored at the request of the owner.

13bis.2 A request for restoration of a mark removed from the Register for non-payment of renewal fees shall be made on Form M15 and be accompanied by a restoration fee. The request shall be made within six months of the removal of the mark from the Register.

Rule 14 **Registration of Licenses, Assignments** **and Other Similar Rights**

14.1 The Office shall register assignments, licenses and other similar rights pertaining to marks registered or applied under the Protocol.

14.2 However, where such assignments, licenses, registered user or other similar rights affect only one Contracting State, an application to register such right may be made to the office of the Contracting State concerned or to the Office. Where the application to register such right has been made to the office of the Contracting State, the office shall, within two months of registration of such right, provide the Office with the particulars of such registration using Form M13.

14.3 The registration of assignments, transmission or other form of transfer shall be made on Form M15. The application to register a license or other similar rights shall be made

on Form M16, while an application for registration of a registered user shall be made on Form M17.

Rule 15 Registration and Publication

15.1 Registration of a mark shall entail recordal in the Register and publication of the mark in the *ARIPO Journal*. The following particulars shall be recorded in the Register of Marks in respect of each registered mark:

- (i) the number of the application;
- (ii) the name and address of the owner of the registration;
- (iii) the name and address of any authorized agent;
- (iv) the date and number of registration;
- (v) designated States;
- (vi) any change with respect to the above; and
- (vii) representation of the mark.

15.2 Every alteration, renewal of a registration, registration of licenses, assignments and other similar rights pertaining to a mark shall be recorded in the Register and published in the Journal.

15.3 The applicant shall be issued with a Certificate of Registration, on Form M12 and a copy of the certificate shall be transmitted to each designated State.

15.4 The Director General of the Office may establish Administrative Instructions which shall deal with details in respect of the application of these Regulations. Administrative Instructions so established shall not be in conflict with the provisions of the Banjul Protocol and these Regulations.

Rule 16 Amendment

16.1 These Regulations may be amended at the instance of the Director General or any member of a Contracting State during the Administrative Council sessions.

16.2 The decision to amend these Regulations shall be by a simple majority of Contracting States.

16.3 Every amendment to these Regulations shall be notified to the Contracting States by the Director General.

Rule 17 General Provisions

17.1 Communications between the Office and the industrial property offices of Contracting States on matters relating to the Protocol and these Regulations shall be effected direct and by registered mail.

17.2 Communications between the Office and the Courts or other authorities of Contracting States on matters relating to the Protocol and these Regulations shall be effected through the intermediary of the industrial property offices of the said States.

17.3 At any stage of any proceedings before the Office, the Director General may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.

17.4 The times or periods prescribed by the Protocol and these Regulations for doing any act or taking any proceeding thereunder may be extended by the Director General if he thinks fit, upon such terms as he may direct, and such extension may be granted although the time or period for doing such act or taking such proceeding has already expired.

Schedules I to III

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* *English title.*

Entry into force (of Regulations as last amended): January 1, 2000.

Source: Communication from the Secretariat of ARIPO.

1 Not reproduced here (*Editor's note*).

2 *Idem.*

3 *Idem.*

4 See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 1-008 (*Editor's note*).

5 See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 3-012 (*Editor's note*).

6 See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 1-016 (*Editor's note*).

7 *International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice*

Classification), Part I: *List of Goods and Services in Alphabetical Order*, WIPO Publication Number: 501.1(E) and Part II; *List of Goods and Services in Class Order*, WIPO Publication Number: 501.2(E); for the text of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, see *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 3-001 (*Editor's note*).

⁸ Schedules not reproduced here (*Editor's note*).