



Business IP-Smart Enforcement Strategies

The Geographical Indications Case

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PROGRAMME

15'
Presentation

- **Business IP-Smart enforcement strategies for non-registered GIs**
- **Business IP-Smart enforcement strategies for registered GIs**

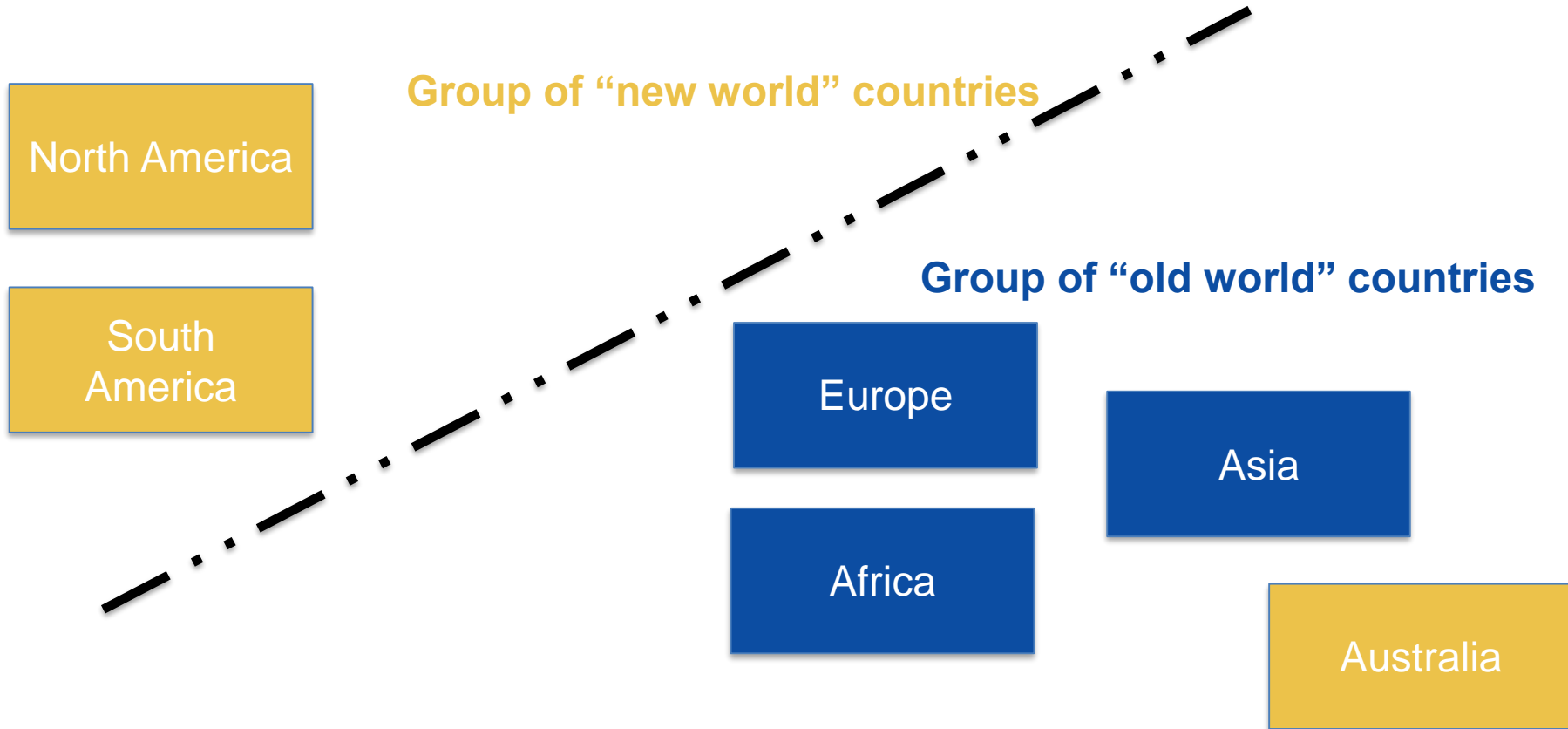
5'
Questions and answers

Why would you reserve a “special treatment to GIs”?

- **Triple nature of GIs and associated enforcement mechanisms**



An affiliation of Africa to the group of “old world countries” in “GI diplomacy”

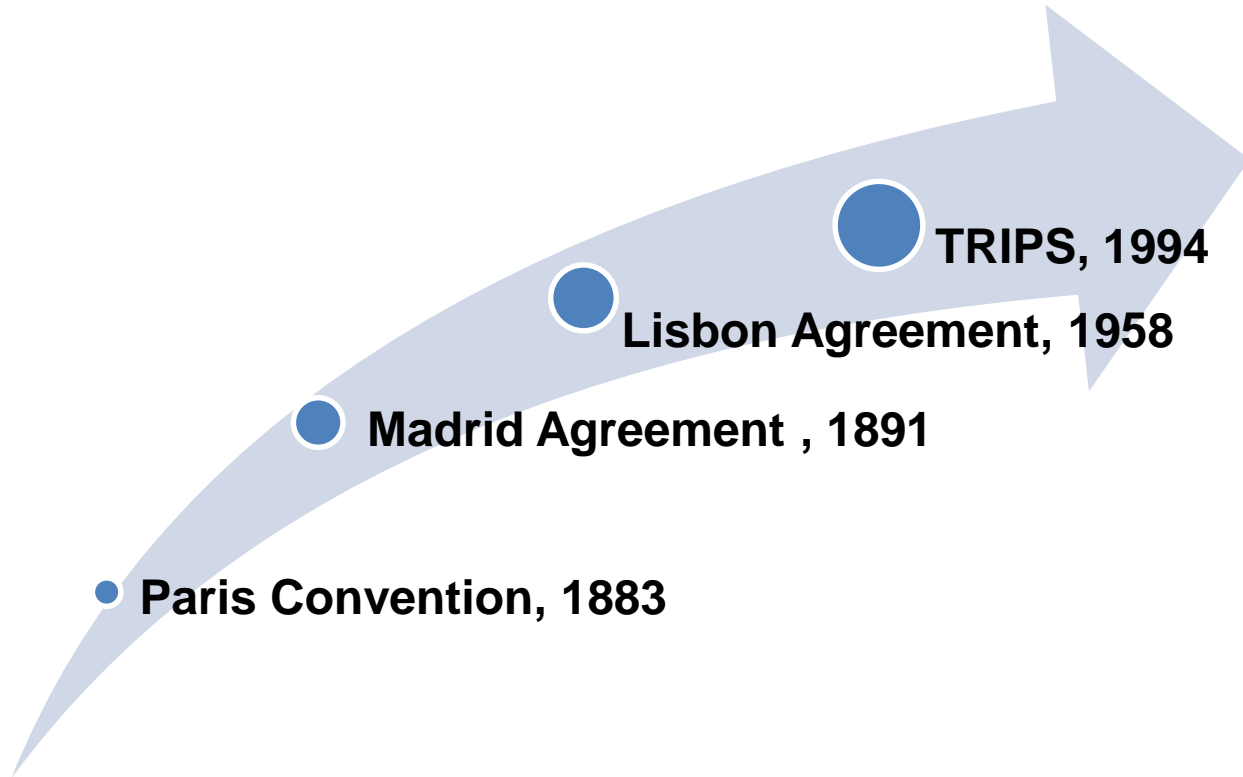




PRELIMINARY REMARKS ABOUT GEOGRAPHICAL INDICATIONS

Geographical indications are the “*Sleeping beauty*” of Intellectual Property Rights

The TRIPS Agreement is credited with “breathing new life” into GIs



TRIPS : a multilateral agreement



WORLD TRADE
ORGANIZATION

- **164 States**
- **1 definition**
- **1 minimum regime of protection**

Articles 22 to 24

Agreement on the Trade-related Aspects of Intellectual Property Rights

TRIPS : means of implementation left to the discretion of states

Imposed

At the discretion of
states

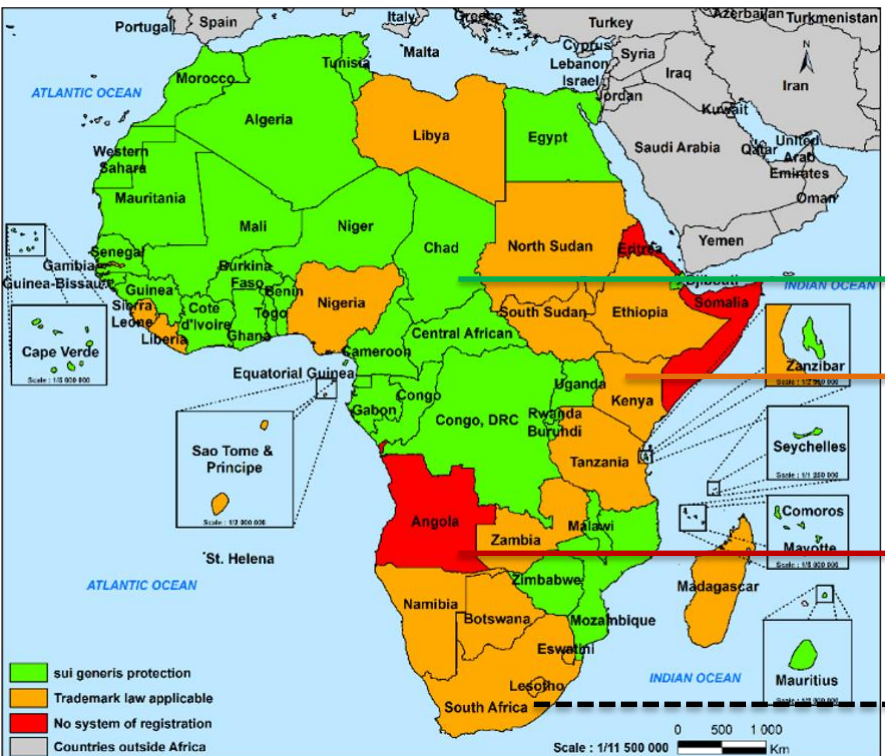
Definition
and minimum
regime

Options to
protect

Options to
implement

Options of protection and its impact on the scope of the protection of a GIs

DIFFERENT SCOPE OF PROTECTION



Sui generis system

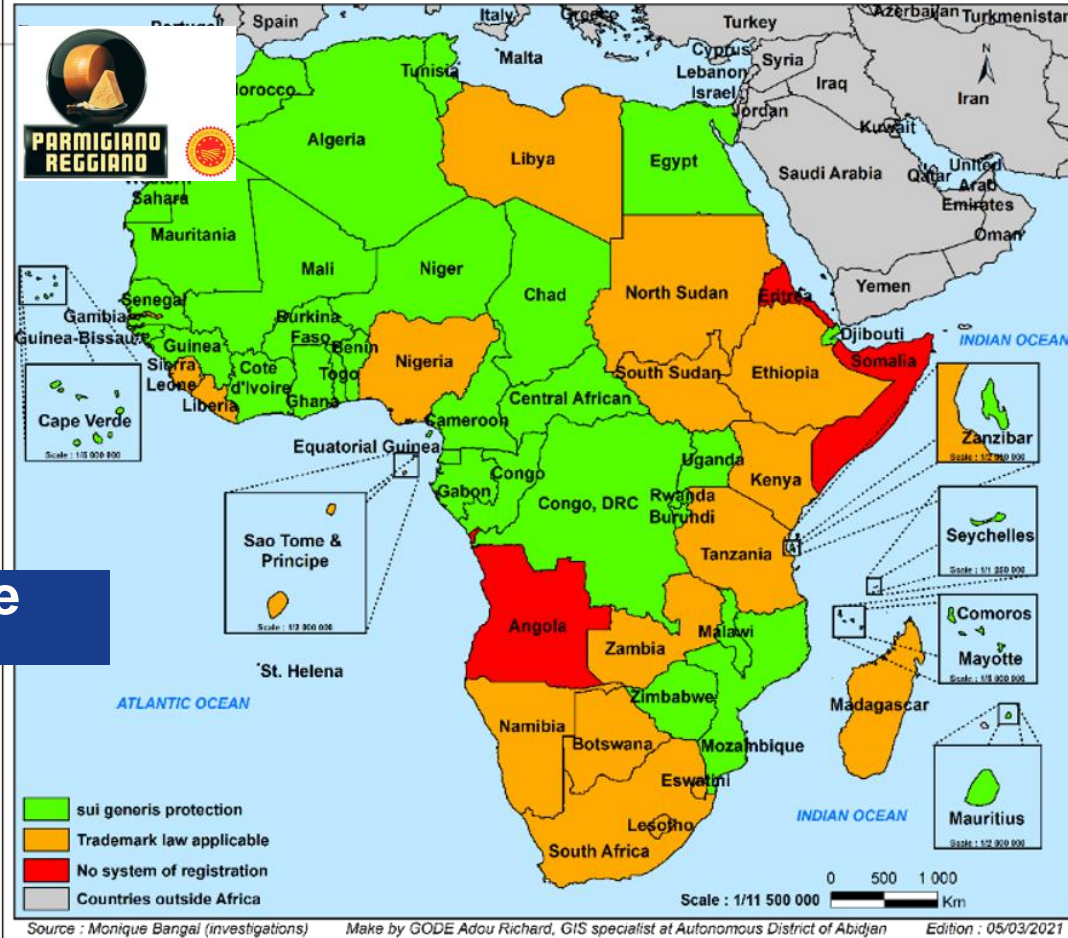
Trademark system

No registration system

NB: RSA applies a *sui generis* system

Source : Monique Bangal (investigations) Make by GODE Adou Richard, GIS specialist at Autonomous District of Abidjan Edition : 05/03/2021

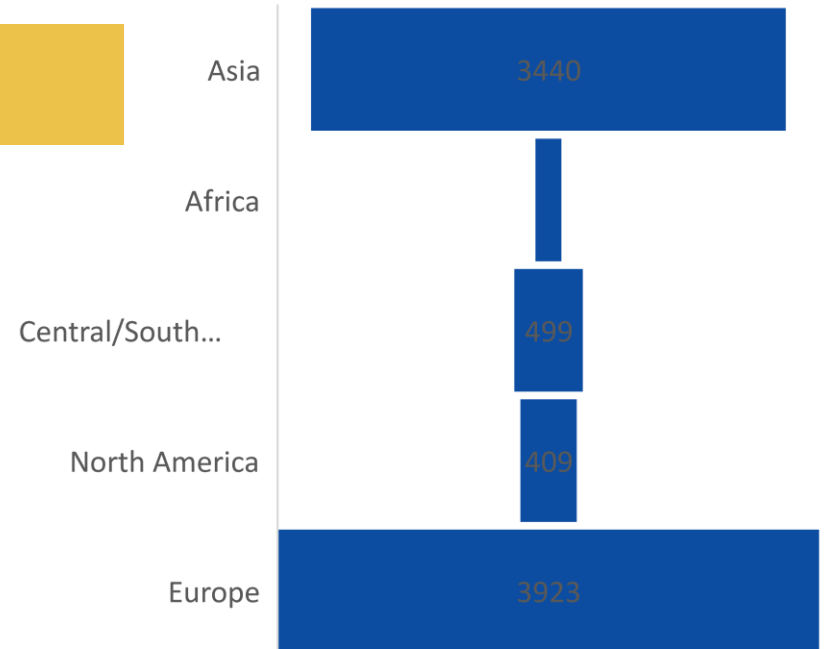
DIFFERENT SCOPE OF PROTECTION



In practice

In Africa, 191 as of January 2021

Number of registered GIs worldwide in 2021



But real cases of misuses....



Translation of
«Parmigiano
Reggiano»

Deceptive use of
Feta



But real cases of misuses....

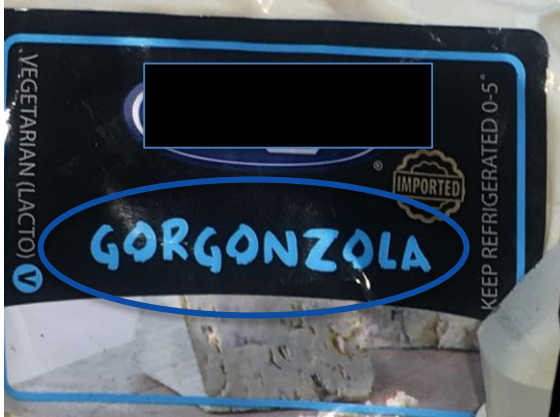


Deceptive use of
Parmigiano Reggiano



Fake use of
Feta

Counterfeiting or not counterfeiting?



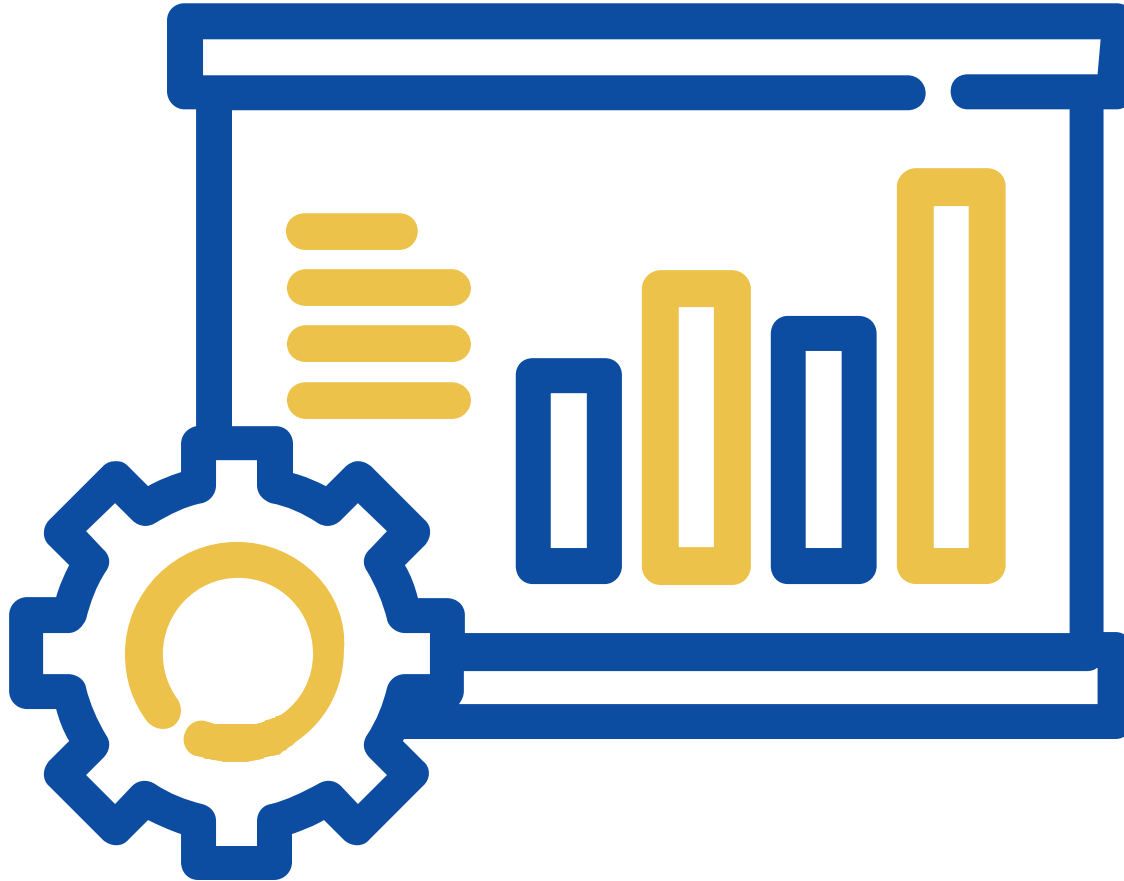
Fake use of Gorgonzola



Deceptive use of Mozzarella di Bufala?

COMMON FEATURES OF THOSE NAMES = THEY ARE **NOT REGISTERED** ON THE CONTINENT





How to enforce non-registered GIs in Africa?

- Unregistered GIs cannot be protected, only the registration protects GIs
- Through mechanisms to fight unlawful trade practices
- Through international IP law
- Through bilateral agreements
- Through quality control mechanisms

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BUSINESS IP-SMART ENFORCEMENT STRATEGIES

2.1 Few tips without registration

2.2 Few tips with registration

2

STRATEGIES FOR NON-REGISTERED GIs

2.1 Without prior registration

- 2.1.1 Mechanisms to fight unlawful trade practices**
- 2.1.2 Mechanism of international IP law**
- 2.1.3 Bilateral mechanisms**
- 2.1.4 Control mechanisms**

2

STRATEGIES FOR NON REGISTERED GIs

2.1 Without prior registration

2.1.1 Mechanisms fight unlawful trade practices

2.1.2 Mechanism of intellectual property law

2.1.3 Bilateral mechanisms

2.1.4 Control mechanisms

OPTION 1: The protection through mechanisms to fight unlawful trade practices

Any mechanism that provides a remedy against illegal and dishonest commercial practices

**Unfair
competition
law**

**The *passing
off* action**

WHERE TO FIND INFORMATION ON NATIONAL LAWS AND JURISDICTIONS?

OAPI + Algeria, Djibouti, Madagascar, Morocco, DRC, Rwanda, Tunisia



See the applicable legislations on the website “Droit Afrique”

www.droit-Afrique.com > [country at issue] > online texts > competition and consumption

Maroc



- Documentation
- Liens internet
- Annuaire juridique
- Journaux officiels

Vous trouverez :

- 104 textes en ligne
- 19 liens vers des sites internet
- 339 journaux officiels
- 23 cabinets dans l'annuaire

NB: available in French only

Annex VIII of the Bangui Agreement
revised in Bamako (2015) on unfair competition
applies

**National
jurisdictions**

**OAPI Arbitration
or mediation**



- For common law countries: the action of *passing off* * is enforced in **19 English speaking countries** in Africa namely: Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mauritius, Namibia, Nigeria, Seychelles, Sierra Leone, South Africa, Eswatini, Tanzania, Uganda, Zambia, Zanzibar and Zimbabwe.

- **Consider the memberships to Regional Economic Communities**

AfrIPi

NB: Still exploring the role that RECs may play in the IP arena in Africa including for GI enforcement

UMA
COMESA
CEN-SAD
CAE
CEEAC
SADC
IGAD

2

STRATEGIES FOR NON-REGISTERED GIs

2.1 Without registration

2.1.1 Mechanisms to fight unlawful business trade practices

2.1.2 Mechanisms of international intellectual property law

2.1.3 Bilateral mechanisms

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OPTION 2: The protection through international law on Intellectual Property Rights

- The protection against the confusion and deception of the consumer (article 22.2 et 22.3 of TRIPS)
- A protection that is independent from the registration of the title



Few countries in Africa are not members of TRIPS :
Algeria, Comoros, Equatorial Guinea, Ethiopia (observers)
Libya, Sao Tomé and Príncipe, Somalia, South Sudan,
Sudan

OPTION 2: The protection through international law on Intellectual Property Rights

There could be a problem of legal basis to fight that misuse

- **For those countries, investigating the country of origin of the counterfeited good can be a solution, where applicable**

OPTION 2: The protection through international law on Intellectual Property Rights

- The protection as «**well-known trademarks**» (Paris Convention - article *6 bis*)
 - Usually reserved to trademarks that are otherwise registered
 - Some jurisdictions have agreed to extend to non-registered trademarks



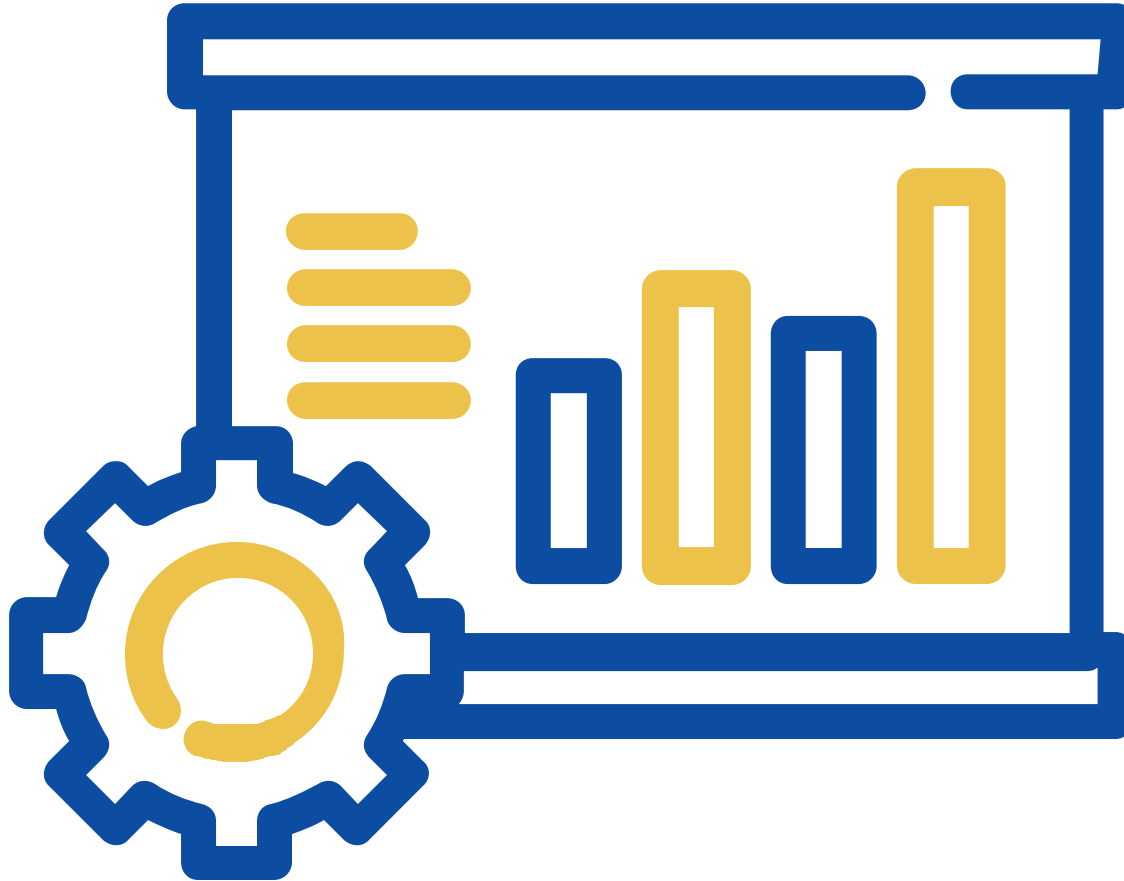
Possible lack of incentives to used that ground by operators: a GI is by nature well-known

OPTION 1 & 2



PROOF

Prove that the product has an established reputation, a stable customer base and that the misuse causes material damage to the “industry”



DO YOU KNOW ABOUT:

- Champagne
- Piment d'Espelette

OPTION 1 & 2 some products have a lesser reputation in Africa



2

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OPTION 3: Bilateral agreements

- **Economic Partnership Agreements (EPA)**
 - GI provisions: obtain **the exclusive right** to use their geographical indications in the third country without going through a registration procedure
 - Most African countries are still negotiating under the GI chapter

OPTION 3: Bilateral agreements

- Does the market destination has an EPA with a clause of mutual protection? See [Access2Markets](#)
 - > South Africa



rechercher un pays



rechercher un accord

OPTION 3: Bilateral agreements

In the Protocol, South Africa committed to protect 251 GI names of the EU: 105 agricultural products and foodstuffs (including mainly fruits, vegetables, cereals, cheeses, meat and fisheries products); 5 beers; 120 wines; and 21 spirits.

2

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OPTION 4 Control mechanisms

- **Rationale of enforcement through control mechanisms:**
 - **GI specifications may impose a specific control mechanisms to the user of the name**
 - **Food safety might be at issue: test in laboratories**
 - i.e: adulterated alcohol

OPTION 4 Quality control mechanisms

- **Possibility to test the products in laboratories**

Which laboratory operates according to the norm ISO 17 065 (i.e: KENYA, MOROCCO, TUNISIA)



Panafrican GI HUB



OPTION 4 “social” surveillance control mechanisms

- OriGIn’s market watch: abuses noticed by consumers that may also be connoisseurs may be sent to giabuses@origin-gi.com

3

BUSINESS IP-SMART ENFORCEMENT STRATEGIES

3.1 Few tips without registration

3.2 Few tips with registration

Hope Upcoming
ex officio
opposition

✓ Opposition procedures

Opposition

- **EXAMPLE OF *EX PARTE* OPPOSITION IN ZIMBABWE**

Opposition judgement between *The Scotch Whisky Association* et *Sahana Industries*

(Zimbabwe Industrial Property Journal No. 10 on 31 October 2022)

- ***EX OFFICIO* opposition?**

Hope for
Upcoming
reasoning *in
favorem auctoris*

✓ Cancellation procedures

MEANS REPRESSION OF FRAUD

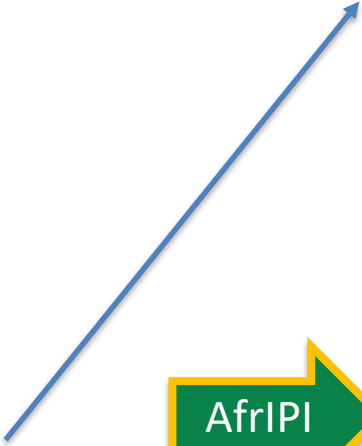
Registration

Publication

IP office

Special commission

Producer's group



«Best allie»



Panafrican

Speaker presentation



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