

Business-smart Intellectual Property enforcement strategies

The case of the OAPI area

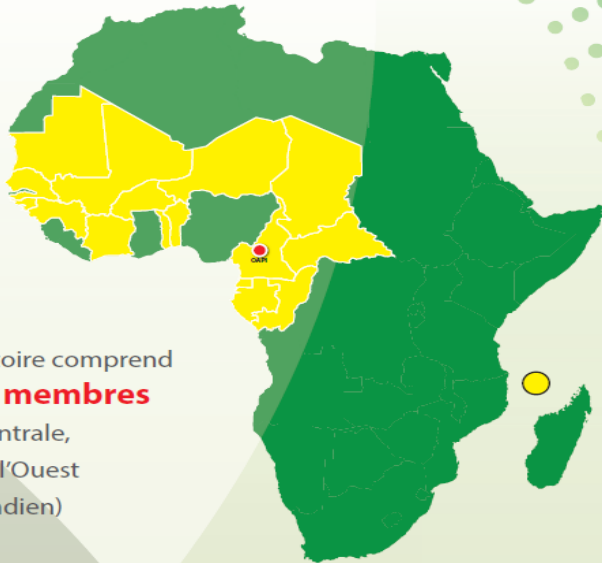
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Brief overview of the African Intellectual Property Organization (OAPI)

- Created in 1962
- Headquartered in Yaoundé, Cameroon
- 17 Member States
- Language for filing IP applications: French and English



The OAPI IP System



Notre territoire comprend
17 Etats membres
(Afrique centrale,
Afrique de l'Ouest
et Océan Indien)

Bénin, Burkina Faso, Cameroun, Centrafrique, Comores, Congo, Côte d'Ivoire, Gabon, Guinée, Guinée-Bissau, Guinée Equatoriale, Mali, Mauritanie, Niger, Sénégal, Tchad et Togo.

Characteristics of the OAPI IP System

- Uniform Legislation (Bangui Agreement) + Annexes
- Common IP Office for 17
- Centralised procedures
- Competence of national courts in the settlement of disputes
- Collective databases

IP Rights protected at the OAPI

- Patents and certificates of addition
- Utility models
- Trademarks
- Industrial designs
- Trade names
- Plant varieties
- Geographical Indications

How to file an application at the OAPI

- Directly at the Organization's headquarters
- Through an agent approved by OAPI
- Information is readily available on the OAPI website (www.oapi.int)

OVERVIEW OF THE IP ENFORCEMENT STRUCTURE IN OAPI SYSTEM

The Bangui Agreement enables owners of intellectual property rights to take action against infringement, either through:

- **OAPI: administrative litigation**
- **National courts: judicial litigation**

Litigation procedures

Administrative litigation within OAPI:

- Oppositions
- Claim of ownership
- Appeals

Judicial litigation in the Member States:

- Validity of IP titles
- Infringement proceedings
- Action in unfair competition



Oppositions: the case of trade marks

The procedures for opposition and claiming ownership

- Based on the adversarial principle, these proceedings are conducted before the Director General of OAPI.
- The decision rendered by the Director General concerning an opposition or a property claim may be appealed before the OAPI High Commission of Appeal

The procedures for objecting to the registration of a trade mark at the OAPI

As of January 2022: Opposition requests concern trade mark and industrial design applications rather than titles already registered.

- Publication of trademark applications in the OAPI Gazette
- Opposition phase/Claim of ownership by any third party
- Internal Commission set up to decide cases

Appeal to the Superior Appeals Commission (CSR)

Any rejection of an:

- Application for registration of an IP title;
- Request for opposition to registration;
- Application for restoration of IPR

Can be appealed to the Superior Appeals Commission (CSR), a body composed of judges from OAPI Member States. The decisions taken by this body are final.

Judicial litigation

These are legal proceedings relating to intellectual property rights.

1) On the validity of industrial property titles:

- The invalidity action
- Action for revocation
- Action for cancellation

2) Intellectual property litigation is generally based on two main actions:

- Infringement proceedings
- Action in unfair competition

The fight against counterfeiting in OAPI Member States

- All OAPI Member States are adherents to the Agreement on trade-related aspects of Intellectual property rights (TRIPS)
- The Bangui Agreement was revised in-depth to align with it in 1997
- National legislation is brought in line with the TRIPS Agreement, including institutions and administrative and judicial practices
- Criminal code with sanctions for IPR infringements
- Investment Code ensuring equal IP protection for domestic and foreign companies
- National and regional (CEMAC, WAEMU) customs codes

Judicial sanctions for counterfeiting in the Member States

- The majority of IPR infringements known to customs and national courts are related to counterfeiting
- These institutions crack down on infringement cases found

EXAMPLES OF CASES

**Example 1: Judgment No. 0292/2021 of MAY 5, 2021 - Commercial Court of Lomé
between AB PLAST and RACH MUNDO, all based in Lomé, TOGO.**

COMPLAINT

AB Plast is the owner of designs and models of plastic shoes of the brand "CONFIDENCE" filed with the OAPI on February 26, 2020. That same year, it noted the introduction on the Togolese market of designs and models of plastic shoes of the "CONFIANCE" brand that do not comply with those it distributes.

FIRST MEASURE

AB Plast requested and obtained a provisional order from the President of the Commercial Court of Lomé, for the purposes of seizure of counterfeit products
Police seized several boxes of shoes in shops. Then AB Plast seized the commercial court of Lomé.

COURT DECISION

After adversarial debate between the parties, the court, in its judgment n° 0292/2021 of MAY 5, 2021, Sentenced the authors of the infringement to pay to the right holder, a sum of 229 000 Euros for damages and ordered the confiscation of the counterfeit products.

EXAMPLES OF CASES

Example 2: Order No. 275-9/2022 of the President of the Lomé Commercial Court in the PUMA SE case against Pasto A. Umes, Stanley and others

COMPLAINT

Last year, PUMA SE specialized in the production, marketing and distribution of clothing goods and owner of the PUMA trademark regularly registered in the OAPI space, identified in its Togo market, a huge sale of counterfeit products of its brand by local merchants.

FIRST MEASURE

PUMA called in the police to protect its interests and draw attention to the infringements. It then referred the matter to the president of the Commercial Court of Lomé to request provisional measures including the seizure of the suspected products pending the designation of a trial judge.

COURT DECISION

By order no. 275-9/2022 of October 26, 2022, the President of the Commercial Court of Lomé granted the request for seizure of the suspected products put on the market by a company named Pasto A. Umes, Stanley and any person, merchant or retailer

Customs services in the fight against counterfeiting: the case of Togo

Recurrent cases of counterfeiting that are often referred to customs concern trademarks, medicinal products and industrial designs.

- It is the right holders who refer the case to customs, however, the public service can also initiate the procedure.

The NESTLE company has entered into a formal partnership with customs. To this end, it has made available to Customs the means of detecting counterfeiting of its products and trained personnel. When a case of counterfeiting is detected by the customs services, they take a photo of the suspected products and then call on the trained agents made available to them for verification. If the suspicion is confirmed, the customs officers initiate the procedure for the customs detention of the counterfeit products while asking the complainant to refer to the judicial authorities for further action.

As regards counterfeit medicines, customs services automatically seize them upon suspicion and call on the national pharmacy directorate for verification. The products are destroyed if this directorate confirms the suspicions.

How is AfrIPI building the capacity of anti-counterfeiting actors in the OAPI area?

- Seminar on the fight against substandard and counterfeit medicines
- Training seminars for judges in the OAPI area
- Creation of a network of magistrates in the OAPI area
- Creation of a platform for collecting court decisions



Thank You!