

Ambassador
Albert Muchanga
Commissioner of Trade and Industry
African Union
Addis Ababa
Ethiopia

RE: Comments IP Protocol Africa Continental Free Trade Agreement

Dear Ambassador,

Founded in 1878, [the International Trademark Association \(INTA\)](http://www.inta.org) is the world's oldest and largest brand owners association. With a membership of over 7,200 companies, the Association represents over 31,000 trademark professionals in diverse capacities: multinational corporations, businesses of all sizes, law firms and other professionals, academic institutions, and not-for-profit organizations from 190 countries.

Our mission is to encourage and support best practices and excellence in the field of trademarks and related intellectual property rights, and protection of rights for brand owners and consumers, as well as foster economic growth and innovation through awareness of the importance and development of brands. The Association is dedicated to the support and advancement of trademarks and related intellectual property rights as elements of fair and effective national and international commerce. To achieve this goal, [INTA's four year Strategic Plan of 2018-2021](#) is to: 1) Promote the value of Trademarks and Brands, 2) Reinforce Consumer Trust, and 3) Embrace Innovation and Change.

We appreciate the African Union laudable efforts to harmonize the Intellectual Property landscape on the continent. In this connection, INTA is pleased to share with you recommendations and guidance aiming at striking the right balance between employment creation, protection of brand owners and sustainable and economic development in line with Africa's blueprint and master plan for transforming Africa into the global powerhouse of the future.

Companies in virtually every sector of the economy protect their brands with trademarks. Trademarks are more widely used than any other form of intellectual property (IP), particularly by small and medium sized enterprises. Branding is also one of the most important mechanisms for a company to secure return on investments in research and development. Strong trademark laws also help to protect consumer from counterfeits. Increasing globalization means that brands transcend national borders more than ever before.

General Recommendations and Transparency

A well-functioning market economy must embrace basic principles in order to instil confidence in private sector investors. Procedural transparency is an indispensable condition, furthering good governance and the rule of law. Free Trade Agreement commitments can promote targeted training and capacity building, information exchanges, and enhance awareness of the importance of IP among the civil service and the

public. Strong trademark obligations advocated by the Africa Union will set the benchmark for fair and equitable treatment for the fastest growing segment of IP-intensive industries.¹

The Free Trade Agreement should incorporate provisions to improve the parties' general IP systems, to ensure a level playing field for all IP owners, such as small and medium sized enterprises, including:

- Clear definition of AfCFTA.
- Consistency between the use of "AfCFTA" and "Agreement" with.
- Raising awareness of the importance of IP at the AU and national level.
- Define role and mission of National Intellectual Property offices and Regional Intellectual Property bodies in the context of the Free Trade Agreement.
- Online publication of laws, regulations, procedures, and administrative rulings of general application concerning the protection and enforcement of IP rights.
- Online publication of information concerning trademark applications and registered trademarks.
- Training judges and prosecutors with specific IP and trademark expertise to promote confidence in civil and criminal avenues for IP enforcement.
- Exchanging information between IP offices or other relevant agencies or institutions.

Recommendations:

Part 1 Definition, Objectives and Principles

Article 1: Definition

- Make a reference to the TRIPS Agreement to serve as a framework, defining IP under PART II, STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS
- Explain what "AfCFTA" refers to
- Explain what "AfCFTA Market" refers to
- Explain what "the Agreement" refers to

Article 2: Objectives

- Reformulate b) as follow: Achieving the objectives defined in Agenda 2063 for a continental market in...
- Include a definition of Agenda 2063

Article 3: Principles

¹ Trademark-intensive industries are the largest in number and contribute the most employment with 23.7 million jobs in 2014 (up from 22.6 million in 2010). *Intellectual Property and the U.S. Economy*, at 10, <https://www.uspto.gov/sites/default/files/documents/IPandtheUSEconomySept2016.pdf>.

- Reformulate b) as follow: “to promote norm-setting activities related to IP that support a robust public domain” to facilitate the diffusion of knowledge

Part 2 Regional Trade and Norm Settings

Article 7: Exhaustion of Rights:

- National exhaustion of trademark rights in relation to the parallel importation of goods should be applied.
- In those countries that currently follow international exhaustion, and in which political or other conditions make it highly improbable that national exhaustion would be implemented, a “material differences” standard should be adopted in order to exclude parallel imports that are materially different from those products authorized for sale by the trademark owner in the domestic market.

Article 8: Traditional Knowledge, Traditional Cultural Expressions and Genetic Resources:

- INTA's has for several years has been engaged in the intersection between trademark rights and Indigenous Rights and in 2015 established its Indigenous Rights Committee. INTA has participated in consultations with countries such as New Zealand which has sought a balance between protecting both trademarks and indigenous rights. The Association also participates in the efforts of the World Intellectual Property Organization which has devoted considerable resources to the issue pursuant to the UN Declaration on Rights of Indigenous Peoples (UNDRIP) which recognized that these rights included the right to intellectual property.
- With respect to traditional knowledge and traditional cultural expressions, it is proposed that the Protocol should explicitly define these terms, and state as to what constitutes TK and TCE, respectively. Further, it is proposed that the Protocol may provide that the State Parties are not bound by these definitions and may adopt them based on local customs, traditions and practices.
- The language used does not seem to be consistent. Whereas in paragraph 1, the term holders is used and the access is subject to prior informed consent, in paragraph 3, the reference is to the community and it states that the registration by a third-party is subject to express consent. The AU should follow consistent terminology.
- The protocol does not seem to deal with scenarios relating to traditional knowledge and traditional cultural expressions which do not belong to any holder / community per se and may be considered to be in public domain or owned by the Government. While it could be the case that the term holder in paragraph 1 is used in a wider sense in paragraph 1 and could be deemed to include the Government, however, the flow of the article does not seem to suggest so. It is, therefore, proposed that a mechanism in such a scenario shall also be developed and an exception to this effect shall also be proposed to be introduced.
- It is possible to offer protection against inappropriate use of words, symbols, sounds and smells through the trademark law by including a prohibition against registration of a mark if it would be contrary to public policy or accepted principles of morality.

- We appreciate the difficulties in arriving at a suitable formula to protect words, symbols, sounds, and smells against culturally inappropriate usage. Prohibitions on registration of marks the use of which may be offensive or inappropriate may be unworkable because they are imprecise.

Article 9: Geographical Indications:

- Consider a balanced approach through the principle of “first in time, first in right” based on the well-established principles of territoriality, exclusivity, priority, and good faith when resolving conflicts between geographical indications and trademarks, including collective and certification marks.
- Consider that any regulation of geographical indications must have effective and transparent mechanisms for addressing: (i) applications for geographical indications, applications for amendments, and applications for cancellation; and (ii) effective opposition, cancellation, and notification procedures that recognize pre-existing trademark rights with which geographical indications might conflict or cause confusion.
- Consider that trademark rights holders and other relevant parties such as governmental bodies, trade associations, or individual traders with legitimate interests in the use of a geographical indication and/or prior rights, must have standing to oppose, seek amendment, or seek cancellation of geographical indications; and
- Consider that names with a geographical connotation or significance that are or have become generic terms in a jurisdiction should not be impaired by geographical indication protection in that jurisdiction.

Part III Cooperation

Article 11: Scope of cooperation:

- Reformulate 2) b. as follows: Preserving TRIPS flexibilities to facilitate measures for the protection of public health.

Part IV Institutional Provisions

Article 12: Implementation, Monitoring and Evaluation:

- Reformulate 1) as follows: The Council of Ministers, in accordance with Article 11 of the Agreement Africa Continental Free Trade Area, shall establish a Committee on Intellectual Property which shall monitor implementation of this Protocol and, in particular, the compliance of State Parties with their obligations under the Protocol. State Parties shall be allowed to consult this Committee on matters relating to intellectual property.
- Reformulate 2) as follows: The Committee shall carry out such other responsibilities as may be assigned by the Council of Ministers, in particular assistance in the context of dispute settlement procedures and imposition of sanctions.

Annex II Guidelines for Enforcement on Intellectual Property

- The Annex should adopt and maintain the minimum requirements of TRIPS (Part III). The Guidelines cover only the specific relief of injunction. Also, the guidelines refer to remedies provided in equity as in common law, which may not apply to certain jurisdictions within the African Union.
- We would suggest to either complete this Annex II to address enforcement of IP rights more in general (preliminary measures, injunctions, TRO, Damages, Criminal enforcement, Custom actions, etc.), refer to a larger convention addressing enforcement more in general, or renaming this Annex II it to "Guidelines on Injunctive relief".

CONCLUSION

INTA is pleased to have the opportunity to provide input to this process. INTA welcomes any questions that the Commission of Trade and Industry may have and is available to discuss our recommendations in more detail. In this respect, please contact Tat Louembe, Representative Africa, Middle East and Intergovernmental Organizations, at tlouembe@inta.org

Sincerely,



Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association (INTA)