

Patent and trademark filing and enforcement strategies in Africa

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About Von Seidels

- Intellectual property law firm based in Cape Town with a satellite office in Johannesburg
- 4 regional offices: South Africa, Namibia serving ARIPO, Cameroon serving OAPI and Nigeria - covering the majority of the African continent. In the rest of Africa we work with trusted agents
- We assist clients both locally and internationally in obtaining all forms of IP protection and deal with all IP related commercial activities, including agreements, valuations and litigation
- Established in 2007
- IP work split: 60% patents and 40% trade marks



Our Offices



Nigeria
(largest economy in Africa)

Cameroon
(OAPI)

Namibia
(ARIPO)

Cape Town, South Africa
(Von Seidels head office)



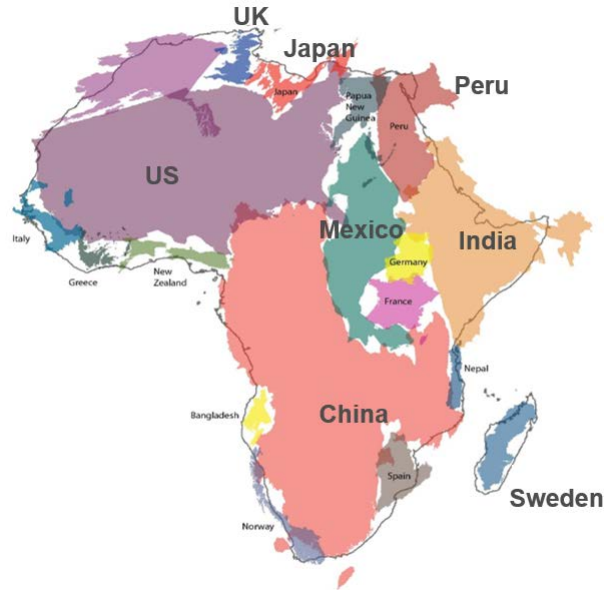
Africa Overview

- 54 countries
- 1.3 billion people (estimated 2.5 billion by 2050)
- Fastest growing population in the world, growing 2.5% p.a.
- Vast natural resources and enormous growth potential



The True Size of Africa

- 54 countries
- 1.3 billion people
- Population growth 2.5% p.a.
- Vast natural resources and enormous growth potential



Africa:	30.2 million km ²
US:	9.8 million km ²
China:	9.6 million km ²
India:	3.3 million km ²

Political Systems in Africa

Colonialism in Africa

- Starting in the 1600s... European nations, France, Portugal, United Kingdom, Spain, Belgium, Italy and Germany focus on taking over African lands in a race for control of the largest possible territory.
- First resistance in 1896 in Ethiopia followed by South Africa gaining independence in 1911.
- 1980 marks the end of European presence in Africa yet the continent will still have to face various forms of neo-colonialism.



Algeria



Angola



Egypt



Rwanda



Ethiopia



Kenya



Nigeria



South Africa



Challenges and Developments

- 1 Many IP Offices operate with physical files only.
- 2 Many IP Offices require original documents.
- 3 Countries may take several years to grant a right.
- 4 IP laws may be old.
- 5 Regional systems provide protection in several countries with one application – reducing costs significantly.
- 6 Regional systems allow pooling of resources thus providing greater efficiency.
- 7 Offices are starting to move away from original documents.
- 8 Majority of countries operate in English – both regional offices operate in English.



Patent Protection in Africa



South Africa - Patents



Requirements for filing

- Patent registration system – acceptance typically within 6 months of filing and LP issues about 3-6 months thereafter
- Possible to delay acceptance – typically 12 months to provide time to consider amendments and filing divisional applications
- Expedited processing of patent applications at no additional cost
- Important to amend a patent since cannot enforce a patent if even one claim is invalid
- South Africa is generally the entry point into Africa for most technologies

ARIPO – Patents

Covering 21 sub-Saharan African countries



21 member countries:

- Botswana
- Cape Verde
- Gambia
- Ghana
- Kenya
- Lesotho
- Malawi
- Mozambique
- Namibia
- Rwanda
- São Tomé and Príncipe
- Seychelles
- Sierra Leone
- Somalia (*cannot be designated*)
- Sudan
- Swaziland
- Tanzania
- Uganda
- Zambia
- Zimbabwe

Requirements for filing:

- Countries **must** be designated at filing
- No post-grant validation
- Works well for patents, designs and utility models
- Substantive examination of patents typically follows other examining countries (US, Europe or China)
- Once an ARIPO patent, design or utility model is granted, it has the same effect as a national right
- Significantly cheaper to file via ARIPO than to file nationally
- Prosecution is significantly smoother than national and typically much quicker to grant - 6-12 months if accelerated.
- National laws apply to litigation
- Applications are prosecuted in English – translations can be filed after filing

OAPI – Patents

Covering 17 Northern and Western African countries



17 member countries:

- Benin
- Burkina Faso
- Cameroon
- Central African Republic
- Chad
- Comoros
- Congo
- Cote d'Ivoire
- Equatorial Guinea
- Gabon
- Guinea
- Guinea Bissau
- Mali
- Mauritania
- Niger
- Senegal
- Togo

Requirements for filing

- Single patent, design or utility model enforceable in all countries
- Not possible to file in individual countries
- Applications are prosecuted in English or French
- High excess page and claim fees for patents
- Patent registration system – acceptance typically within 6-12 months of filing and LP issues about 6 months thereafter
- Litigation takes place in individual countries but in terms of OAPI Protocol (no longer any national IP laws)



Nigeria - Patents



Requirements for filing

- Patent registration system – acceptance typically within 6 months of filing and LP issues about 3-6 months thereafter
- Possible to delay acceptance – typically 12 months to provide time to consider amendments and filing divisional applications
- Courts tend to be in favour of patentee
- Population of +- 200 million

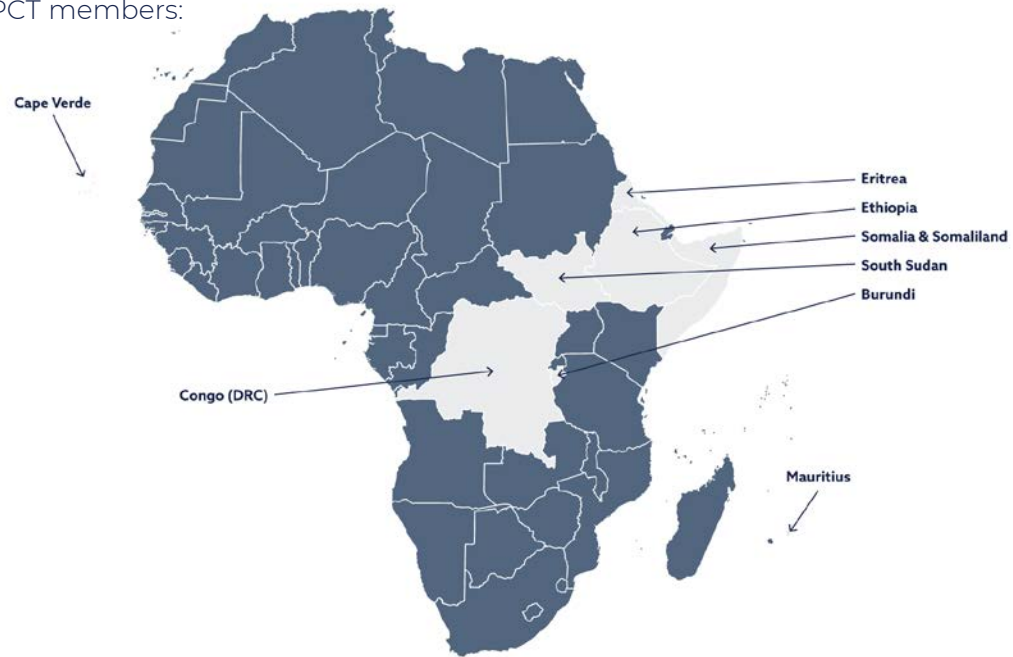




Africa and the PCT

Most African countries are PCT members

There are only 8 non-PCT members:





Filing and Prosecution Tips

ARIPO

- Possibly not designating smaller countries to reduce filing and renewal fees
- Amending claims to conform with those allowed in examining jurisdictions – avoid issuing of unfavorable official actions
- Filing amendments at the time of requesting examination to reduce excess claim and page fees

OAPI

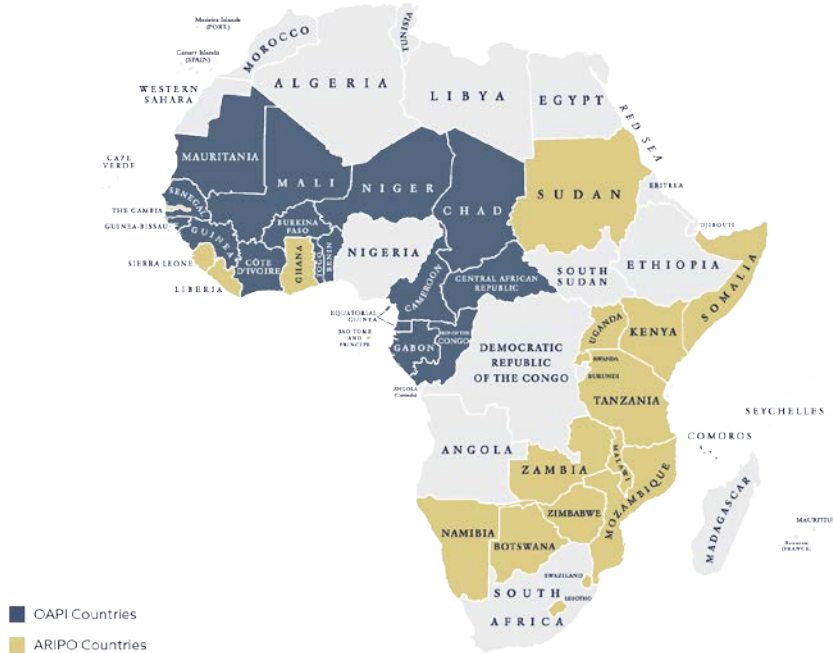
- Amend claims at filing to reduce excess fees
- If considering divisional then inform us ASAP to request deferment of grant
- Patent typically proceeds to grant within 6-12 months – any amendments must be made before grant
- Amending claims to conform with those allowed in examining jurisdictions – to ensure validity

Nigeria

- Delaying acceptance to provide sufficient time to consider amendments in view of prosecution of foreign patents and to consider filing divisionals
- Amending claims to conform with those allowed in examining jurisdictions – to ensure validity



Countries not covered by Regional Filings



- Nigeria
- South Africa
- Egypt
- Algeria
- Morocco (EPO)
- Angola
- Tunisia
- DRC
- Libya
- Ethiopia

- Egypt – 3rd largest economy in Africa and population of +- 100 million
- Angola is an important oil producer
- DRC is rich in natural resources – but not a member of PCT
- Libya – patent applications can be filed but are currently not examined
- Ethiopia – one of the fastest growing economies in the World – but not a member of PCT





Patent Enforcement in Africa



- **Great challenge in many countries**
- Different legal systems: civil, common law, mixed.
- Communal approach to life and property in many countries.
- Lack of enforcement capacity and infrastructure not really developed.
- Inexperienced judicial officers.



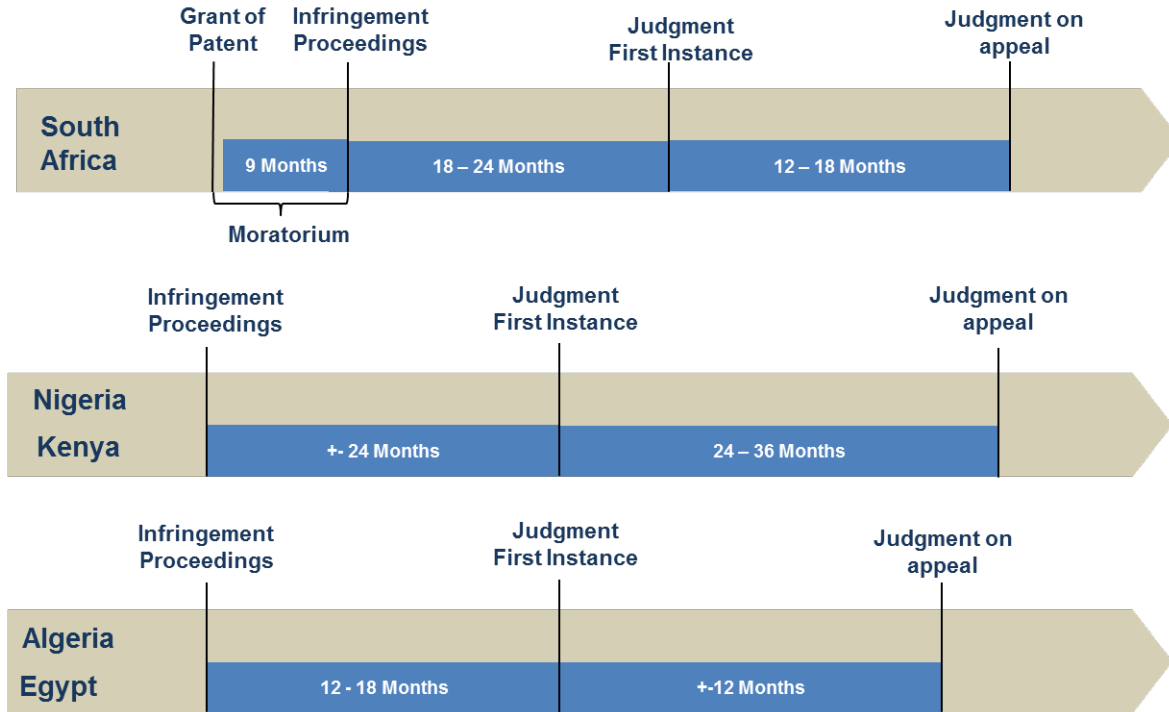
- **But enforcement is improving in many key economies**
- Effect of TRIPS.
- Growing importance of foreign direct investment.
- Push against counter-fit products – large foreign manufacturers starting to enforce IP in Africa (mainly TM rights)



- **Courts tend to favour the patentee – example South Africa**
- 11 cases taken on appeal in the last 5 years.
- In 9 of the 11 cases the decision of court *a quo* was overturned.
- In none of the 11 cases was the patent revoked.
- In 10 out of the 11 cases the judgment was in favour of the patentee.



Patent Enforcement in Africa – Process Timeline



Patent Opposition in Africa

1

Very few countries provide for opposition proceedings for patents

2

In Egypt an opposition must be filed within 60 days of publication – decision usually within 60 days thereafter

3

ARIPO's law to be amended this year to provide for both post-grant opposition and third party observations



Country Selection Guide For Filing Patents

Industry Sector	Where Companies File
Pharmaceutical & Biotech	South Africa, Egypt, Nigeria, OAPI, ARIPO, Ethiopia, Algeria, Morocco
Manufacturing & Industrial	South Africa, Egypt, Algeria, Tunisia, Kenya
Mining & Drilling	South Africa, Egypt, Libya, Algeria, Nigeria, ARIPO (Botswana, Namibia, Zambia, Ghana, Tanzania, Sudan), DRC, Angola
Telecommunications & IT	South Africa, Egypt, Nigeria, ARIPO (Kenya, Ghana), OAPI, Algeria
Banking & Financial	South Africa, ARIPO (Rwanda, Kenya, Ghana) and Nigeria
Agriculture	South Africa, ARIPO (Rwanda, Kenya, Ghana, Tanzania), Egypt, Ethiopia
Chemical	South Africa, Egypt, Nigeria



Trade Mark Protection in Africa





Practical Considerations For a Trade Mark Filing Strategy in Africa



- The cost of filing vs trying to enforce use rights.
- Might not be possible to enforce use rights or well-known trade marks.
- In many African countries the courts and registries work well.
- Important industries in Africa.





Strategic Approach When Considering a Filing Strategy



File in your active countries immediately.

File in South Africa and the other Southern African Customs Union (SACU) countries.

File through the regional systems available - OAPI and ARIPO

File in countries with the largest economies of relevance to your technologies.



Nigeria – Trade Mark



- First to file country
- No provision for multi-class applications
- Despite being a member of the Paris Convention, it is **not** possible to claim priority
- Filing to acceptance takes approx. 6 months
- Long delays to proceed to registration: 2 to 3 years
- It is common for the older marks, which were filed manually, to remain pending for years as many of the files have been lost.
- No recognition of well known trade marks.
- Nigeria has a huge problem with counterfeit products – certain products up to 80% counterfeit

Requirements for filing

- Simply, signed POA



ARIPO – Trade Mark

Covering 13 member countries for trade marks



13 member countries:

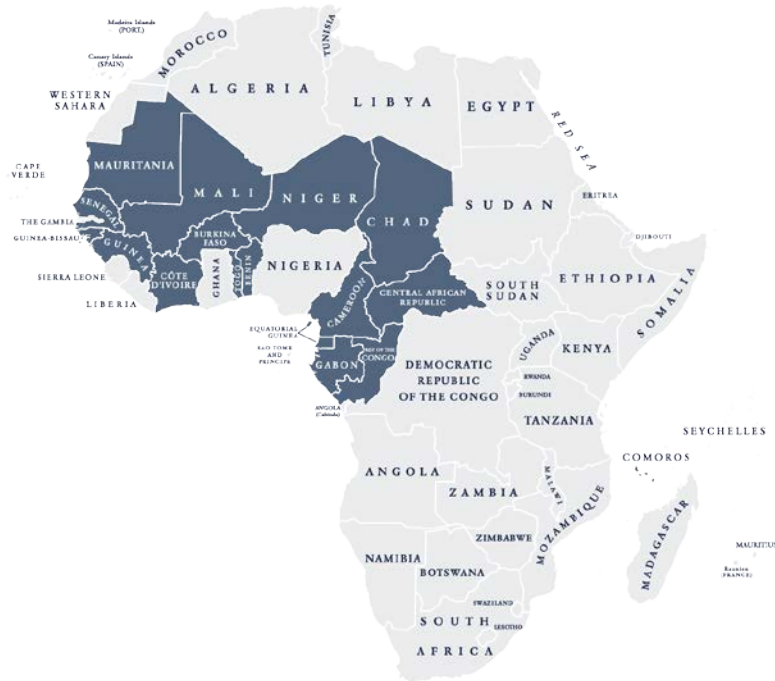
- **Botswana**
- Cape Verde
- Lesotho
- **Liberia**
- **Malawi**
- **Mozambique**
- **Namibia**
- eSwatini
- **Sao Tome & Principe**
- Tanzania
- Uganda
- **Zimbabwe**
- The Gambia

***Bolded** countries are enforceable.

Requirements for filing

- A simply, signed Power of Attorney and a Declaration of intent to use / actual use
- Countries to be designated at filing
- This is a cheaper option than filing nationally in the member countries but it is important to note that there is an additional charge per word after the 50th word in each specification and this could greatly influence the filing fee.
- Filing to registration in a straightforward case is 12 – 18 months

OAPI – Trade Mark



- 17 member countries:
- Benin
 - Burkina Faso
 - Cameroon
 - Central African Republic
 - Chad
 - Comoros
 - Congo
 - Cote d'Ivoire
 - Equatorial Guinea
 - Gabon
 - Guinea
 - Guinea Bissau
 - Mali
 - Mauritania
 - Niger
 - Senegal
 - Togo

Requirements for filing

- Simply signed POA is required for filing
- If priority is claimed, a certified copy of the priority document is required.
- Filing to registration in a straightforward case: 12 months



Madrid Protocol and Africa



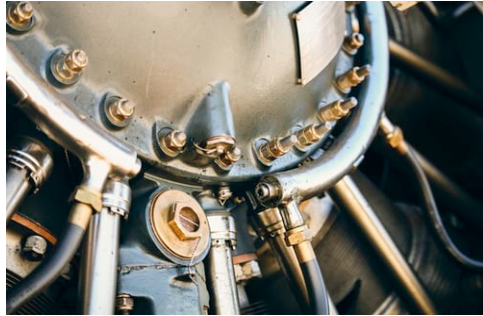
What you need to know:

- 22 out of the 54 African countries are members of the Madrid Protocol.
- International registrations should be recognized in civil law African countries, such as **Algeria, Egypt, Madagascar, Morocco, Rwanda, Sudan, Tunisia.**
- International registrations are not enforceable in common law countries, such as **eSwatini, Lesotho, Sierra Leone and Zambia.**
- Is an OAPI designation enforceable?





Country Selection Guide for Filing a Trade Mark



Automotive and parts Industry:

- Angola, Djibouti, Ghana, Malawi, Mozambique, Nigeria, OAPI, Rwanda, Seychelles, Sierra Leone, South Africa, Tanzania (Tanganyika and Zanzibar), Uganda



Electronics:

- Angola, Ethiopia, South Africa, Kenya, Mozambique, OAPI, Tunisia, Zambia



Telecoms/Mobile Money/Fintech:

- ARIPO (Mozambique, Malawi), Angola, Ghana, Ethiopia, Nigeria, OAPI, Kenya, DRC, Rwanda, Seychelles, Zambia

Pharmaceutical Industry in Africa: Overview



- Rapidly growing sector presenting significant opportunities for investment and growth
- Sector is driven by factors such as increasing urbanisation, population growth, economic development and an increasing demand for healthcare services.
- The African continent's population is projected to reach 2.5 billion by 2050, with a growing middle class that has increased access to healthcare.
- The Value of Africa's pharmaceutical industry jumped to USD 28.56 billion in 2017 from just USD 5.5 billion 10 years earlier.
- The market is predicted to be worth USD 56 billion to USD 70 billion by 2030
- Opportunities for multinationals and pharmaceutical companies seeking new sources of growth as developed markets stagnate while patients will also gain access to medicines previously unavailable on the continent.
- Between 2017 and 2030, prescription drugs are forecast to grow at a compound annual growth rate of 6.5%, generics at 10%, over-the-counter medicines at 7.1%, and medical devices at 12.1%.



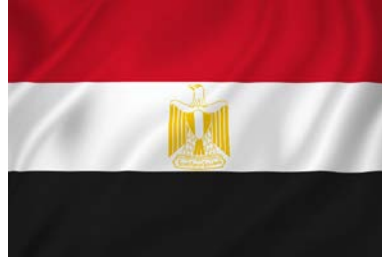


African countries with the largest Pharmaceutical sectors:



South Africa

- Population: 58 million (2023 est.)
- Largest market in Africa.
- Market size estimated at USD 3.9 billion.
- South Africa's pharma and medical device sectors are the most advanced in sub-Saharan Africa.
- The Pharmaceuticals market in Africa is projected to grow by 5.98% (2024-2028) resulting in a market volume of US\$16.02bn in 2028



Egypt

- Population: 109 million (2023 est)
- Market size estimated at USD 2.6 billion
- Africa's second largest economy
- Industry growth driven by government increasing investment in R&D= incentives for local production
- Country has a large aging population & a prevalence of chronic disease which contributes to the growth of pharmaceuticals
- Country has a strategic location



Algeria

- Population 44 million (2023 est.)
- Market size estimated at USD 1.9 billion
- One of Africa's fastest growing economies
- Growing demand for generic drugs
- Increasing adoption of digital technologies such as telemedicine and e-prescriptions = improved access to remote areas

(Statista.com 2023)



Fastest growing African countries with large Pharmaceutical sectors:

Ethiopia

- Population: 116 million (2023 est.)
- Residents becoming more aware of the importance of healthcare
- Opportunity to invest in R&D

Kenya

- Population: 57 million (2023 est.)
- Third largest Sub-Saharan economy
- Major pharmaceutical industry player in East Africa.
- Surge in manufacturing activities with a focus on producing quality generic drugs

Nigeria

- Population: 230 million (2023 est.)
- Increased focus on local manufacturing
- Increasing use of tech in the pharmaceutical industry (electronic health records and telemedicine)



Our Africa Coverage

+ - 70% of Africa's economic activity



Thank you.

Questions and discussion.

