

Africa: the trade mark basics

When first entering any overseas market, whether to sell goods or services or as a place of manufacture, one of the most important things to remember is that trade mark rights are geographical in nature. Hence, rights which you might have in one territory (such as the UK) do not necessarily provide corresponding protection in an overseas market. In view of this, we have put together some advice and top tips for those entering the African market for the first time.

The 'heads up'

1. The most common pitfall for companies first entering the African continent, is **failing to recognise that the region is far from homogenous**. The African continent is incredibly diverse, consisting of 54 countries and a multitude of different cultures, languages and social groups. A particular brand or trade mark which is perfectly acceptable in one or more languages may have a negative connotation to a particular group of people.
2. Many businesses entering the market for the first time assume incorrectly that only low quality and cheap goods will have a market. There is **a significant market for luxury goods**, and brand consciousness is as prevalent in Africa as in other regions of the world. Brand loyalty is also very high in most of Africa.
3. There are significant differences in infrastructure and this can impact upon the methods of doing business. For example, landlines are not common in much of Africa whereas mobile phone ownership is widespread; as a result, **email is less commonplace than texting** and faxes are hardly used at all.
4. The sheer size of Africa together with the multiple countries within the continent increases both the cost and the logistical difficulty associated with transportation. There are also significant differences in tariff rates applied between countries and the importation process and administration can be quite complex and burdensome. It is highly recommended to **establish strong operations and distribution networks** before embarking on significant trade.
5. Failure to take action against infringing marks and counterfeits. **Some businesses assume that there is little that can be done to prevent trade mark infringement** or even the production of counterfeit goods and as a result they take no action against this brand abuse. In fact, there is much that can be done in relation to trade mark infringement, whereas a failure to act might undermine the rights of the legitimate owner.

Some important branding considerations for overseas companies planning expansion into Africa

1. Register your trade mark. This is a particular problem in countries which operate a 'first to file' system, i.e. regardless of your reputation elsewhere, or if you have used your mark there previously, the first one to apply to protect it will own the rights. If a trade mark has already been registered it can be extremely difficult for the 'true owner' to redress the situation and secure rights to the mark.

2. There is no single trade mark registration for the whole African continent, instead brand owners have the option to register on a country by country basis or via the African Intellectual Property Organization (OAPI – Organisation Africaine de la Propriété Intellectuelle). Despite its name, the OAPI organisation does not cover the whole of the African Continent, only Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo Brazzaville, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

Operating alongside the OAPI is the African Regional Intellectual Property Organization – ARIPO, trade mark members who have signed up to the Banjul protocol are Botswana, Cape Verde, Eswatini, Gambia, Ghana, Kenya, Namibia, Uganda, Lesotho, Liberia, Mauritius, Mozambique, Rwanda, Zimbabwe, Malawi, Tanzania, Sao Tome and Principe, Seychelles, Sierra Leone, Somalia, Sudan, and Zambia.

3. Search for competing registered marks before commencing trade in the region.

The OAPI countries, for example, have a 'first to file' system rather than a first to use. This means it is even more important for availability searches to be conducted before starting to sell goods or services, or having branded goods manufactured. Even if they are destined for export to other markets, you need registered trade mark rights to protect you if you are having branded goods made in the country.

4. Because new trade mark applications are not examined on relative grounds, **it is up to the brand owner to look out for registrations which might conflict with their own registered rights.** It is important to check the Bulletin since failure to watch for advertised marks in the Bulletin might mean that the opportunity to oppose potentially infringing marks is missed.

5. Match the trade mark registration to the commercial reality and business plan. The sheer size and complexity of the African continent is such that even the most widely known consumer brands would not see the need to register in every single country since the cost to do so might outweigh the potential commercial return. Brands entering the market should **think carefully about where they really need protection** and where they have the resources and commitment to defend their rights.