

Brazzaville, June 29, 2017

Additional comments and observations in relation to areas of convergence in document SCT35/4, taking into account paragraph 14 of the Summary by the Chair of the SCT.

Introduction

The Republic of Congo made two choices with regard to its legislation on intellectual property.

In relation to the protection of copyright and related rights, it chose to bring its laws into line with the Bangui Agreement once the latter had been ratified.

The provisions of the Agreement became part and parcel of the country's national legal system by enactment of Law No. 24/ 82 of July 7, 1982, on the protection of copyright, folklore and related rights.

As far as intellectual property is concerned, the legislator respected the ratification order allowing the respective jurisdictions to refer to the Bangui accord when settling IP disputes that had been submitted to them.

The Paris Convention of March 20, 1883, which created the Paris Union for the Protection of Industrial Property, and the Berne Convention of September 9, 1886, which created the Berne Union for the Protection of Literary and Artistic Works, reinforced the legal arsenal available to litigants, legal practitioners and all persons eligible for protection under intellectual property law.

The comments and observations made herein take into account not only the Bangui Agreement but also other international instruments recognized as being applicable for the protection of intellectual property in Congo.

Area of Convergence No. 1 : Notion of Country Name

Article 6*ter* of the Paris Convention (1967) refers to the protection of state emblems, official hallmarks and emblems of intergovernmental organizations against registration or use as trademarks.

This is applicable, within the framework of the WTO, under Article 2.1. of the TRIPS Agreement, which explicitly refers to the notification procedures that members (and intergovernmental organizations) must follow in order to inform other members of the emblems that they do not wish to see registered or used as trademarks. These procedures also refer to the manner in which oppositions can be filed in order to protect an emblem.

According to the Bangui Agreement, which is applicable in Congo, names of States are represented by armorial bearings, flags or other emblems, the abbreviated name or acronym or an official sign or hallmark indicating control or warranty of a State.

Area of Convergence No.2 : Non-registrable if considered descriptive

According to the Bangui Agreement, which is applicable in Congo, a mark may not be validly registered if, *inter alia*, it reproduces, imitates or “*incorporates armorial bearings, flags or other emblems, the abbreviated name or acronym or an official sign or hallmark indicating control and warranty of a State*” or an intergovernmental organization established by an international convention, “except where the competent authority of that State or of that Organization has given its permission¹”.

According to point (e) of Article 3 of Annex III of the Bangui Agreement of 1977, as revised in 1999, the presence of the name of a State as an element of the mark is enough for said mark to be excluded from registration.

Under this provision, the refusal to register the mark does not take into account distinctiveness or contradiction to public policy or morality, imitation or reproduction. All that matters is the presence of that name in the component elements of the mark.

By failing to mention the grounds for such a refusal, said exclusion is considered absolute under the Bangui Agreement, unless there is authorization by the competent authority of the State or organization.

From a legal perspective, a measure of this kind must be accompanied by clear grounds for refusal, which are included in the applicable national law relating, on an exceptional basis, to the names of States, particularly with regard to the origin of the products or services in question.

Area of Convergence No. 5 : Invalidation and Opposition Procedure

The procedure preventing the registration of a mark is set out in Articles 18, 23 and 24 of Annex III of the Bangui Agreement. This procedure respectively consists of opposition, cancellation and invalidity.

“Any interested party may oppose the registration of a mark by sending to the Organization, within a period of six months from the publication mentioned in article 17², a written statement setting out the reasons for this opposition, which reasons must be based on an infringement either of the provisions of Articles 2 or 3 of this Annex, or of a prior right belonging to the opposing party³”.

According to the above, opposition is permitted under the Bangui Agreement after registration and publication of the mark. Names of States that are recognized as a mark or as elements of a mark are, in reality, subject to the same principles as those used to register the mark. The idea that interested parties may raise a specific issue, a characteristic of opposition procedures, *irrespective of whether a national system provides for oppositions prior to or after registration*, seems to be in contradiction to the Bangui Agreement, which

¹ Article 3, paragraph (e) of Annex III of the Bangui Agreement.

² Article 17 of Annex III of the Bangui Agreement “The Organization shall publish the particulars referred to in Article 16 above for every certification of registration used. Those particulars shall be entered in the Special Register of Marks”.

³ Article 18, paragraph 1 of Annex III of the Bangui Agreement.

sets forth the opposition procedure and the grounds therefor early on in the process under Articles 2 and 3 of Annex III.

Logically, the Bangui Agreement, as it applies to marks, contains legal provisions for filing oppositions to said marks including the names of States if they are recognized as marks or are elements of a mark. Article 2 refers to signs that are recognized as marks, and Article 3 indicates the grounds for ineligibility of registration, particularly when the mark is devoid of distinctness, contrary to public policy, morality or the law, or liable to mislead the public, notably as to the geographical origin of the goods or services in question, if it reproduces or imitates the marks of others or if it contains an element of a State without the authorization of a competent authority.

Furthermore, “At the request of any interested party, the court may order the cancellation of any registered mark which, for an uninterrupted period of five years prior to the request, has not been used on the national territory of one of the member States, except where the registered owner has legitimate reasons for having failed to use it; the cancellation may be extended to all or part of the goods or services for which the said mark was registered⁴”.

The rationale behind this provision is the time limit, which forms the main reason for cancellation of the mark. In the case of a name of a State, cancellation implies that the name of the State had been authorized, registered and published but had not been used.

Lastly, “the invalidation of the effects on the national territory of the registration of a mark shall then be deemed never to have had any effect⁵”. The same should apply to the name of a State used as a mark.

At the request of the above-mentioned interested parties or organization, the court declares that the registration of a mark is null and void if the registration fails to comply with Articles 2 and 3 of said Annex. In the case of the latter, invalidation is pronounced solely upon the request of the prior right holder. Invalidity may apply either to all or some of the goods or services for which the mark was registered. The organization is then informed accordingly.

When the name of a State is used as a mark, the applicable law relating to the invalidation procedure for marks must be applied. This means that when the court receives a request from a ministry, interested party or professional union, it will declare that the registration of a name of a State as a mark is null and void.

Area of Convergence No. 6 : Use of Names of States as a Mark

As for all marks, the use of a name of a State in such a capacity is subject to substantive and formal criteria related to the registration thereof.

In addition to absolute measures such as exclusion from registration, Article 3 paragraph (e) of Annex III of the Bangui Agreement provides for the use of names of States as marks by stipulating “... except where the competent authority of that State or of that organization has given its permission”.

The appropriate procedure for examining the conditions for the registration of marks is indicated in the same Article 3 of the Annex III.

Article 3 of the Bangui Agreement stipulates that “a mark may not be validly registered if :

⁴ Article 2, paragraph 1 of Annex III of the Bangui Agreement.

⁵ Article 24, paragraph 1 of Annex III of the Bangui Agreement.

(a) it is devoid of distinctiveness, notably owing to the fact that it consists of signs or matter constituting the necessary or generic designation of the product or the composition thereof;

(b) it is identical to a mark that belongs to another owner and is already registered, or the filing or priority date of which is earlier, and which relates to the same or similar goods or services, or where it so resembles such a mark that it is liable to mislead or confuse;

(c) it is contrary to public policy, morality or the law;

(d) it is liable to mislead the public or business circles, notably as to the geographical origin, nature or characteristics of the goods or services in question;

(e) it reproduces, imitates or incorporates armorial bearings, flags or other emblems, the abbreviated name or acronym or an official sign or hallmark, indicating control and warranty of a State or intergovernmental organization established by an international convention, except where the competent authority of that State or of that organization has given its permission”.

The three conditions to be met are :

(a) geographical representation. A sign that is part of the name of a State must fulfil the requirement that graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective ;

(b) the requirement of distinctiveness. In order to fulfil this requirement as a mark, the name of a State must enable distinction of the products and services of a natural person or a legal entity;

(c) the legality of a sign. In other words, the names of States must not be :

- excluded by Article 6^{ter} of the Paris Convention of 20 March 1883 or by paragraph 2 of Article 23 of Annex 1 C to the Agreement establishing the World Trade Organization (WTO);

- contrary to public policy, morality or the law;

- misleading.

These comments and observations are non-exhaustive. Should your require any further information, please contact :

FOCAL POINT : Jean Bruno Obambi, Director of Cultural Industries and Cultural Centers, Representative of the Ministry of Culture and Arts in the National Committee for the Coordination and Development of Intellectual Property.

Tel. : (+242) 06 656 42 80

Email : obambijeanbruno@gmail.com