AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANISATION (ARIPO)
BOARD OF APPLEAL

IN THE MATTER OF
TRADEMARK APPLICATION NO. AP/M/2005/000303 FONES 4 U IN THE NAME OF LANGTON NYATSAMBO

Langton Nyatsambo (hereinafter called the appellant) appeals against the decision of the Director General of the African Intellectual Property Organization (hereinafter called the Respondent) rejecting his application for the registration of trademark "FONES 4 U".

The appellant applied for a trademark registration FONES 4 U under the Banjul Protocol (the Protocol) designating Zimbabwe. The appellant's application was filed and received at the ARIPO office on 4th July 2005. The application was rejected by letter dated 4th July 2006 on the ground that it was not new. ARIPO advised the appellant that Sebego Sharma & Co. Attorneys based in Gaborone, Botswana, had filed an application for the registration of a similar mark FONES 4 U. The application was received by the Registrar of Companies, Patents and Trademarks Gaborone, Botswana on the 8th November 2004.

Though the cover letter transmitting the application to ARIPO is dated 23rd March 2005, the application was received by ARIPO on 27th September 2005, which is six (6) months later than the date of the cover letter, and ten months later than the date of filing the application. In response, the ARIPO office advised the Botswana Registrar that a search had been conducted in the ARIPO trademark register and it shows that the appellant had filed a similar trademark with ARIPO on 4th July 2005 designating one state, which is Zimbabwe.

The appellant appealed against the rejection and requested for a reconsideration of registration of the trademark. The appellant's main argument is;

1. that since he filed his application on 4th July 2005 and the other application was received by the ARIPO Office on 27th September 2005 therefore the later date should be the filing date of the application filed by Sebego Sharma through the Botswana office, thus giving him priority over the one filed by Sebego Sharma & Co. Attorneys.

2. that the application filed through the Botswana office is not in accordance to the Banjul Protocol because the Botswana office failed to comply with Section 2.4 of the Protocol stating that "[w]here an application is filed with the Industrial Property Office of a Contracting State such office *shall, within one month* of receiving the application, transmit the application to the Office". Emphasis added.

3. that since the application filed through Botswana was not filed directly with ARIPO, it was supposed to claim priority in accordance with Section 4 and Rule 8 of the Protocol dealing with the right to claim priority from an earlier application.

4. further, that by the letter of 14TH October 2005 ARIPO had rejected the application filed through Botswana, therefore ARIPO office needed not to revisit the issue and reject its application by letter dated 4th July 2006.

The applicant can file an application of a mark either directly with ARIPO office or through an Industrial Property Office of a contracting state to the Banjul Protocol – See Section 2.1 of the Protocol. Further, the filing date is provided for in Section 3*bis* of the Protocol which provides as follows;

> "The Office shall accord as the filing date of an application the date on which the following indications were *received by the Contracting State* in which the application was filed or were *received by the Office*:
>
> i) an express or implied indication that registration of a mark is sought;
> ii) an indication allowing the identity of the applicant to be established;
> iii) indications sufficient to contact the applicant or his representative; if any by mail;
> iv) a clear reproduction of the mark;
> v) a list of goods and/or services for which the registration is sought;
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> provided that the Office may accord as the filing date of the application the date on which it received only some indications or the elements referred thereto."

It is clear from this that the appellant's filing date is 4th July 2005. And it is also clear from the records transmitted by the Registrar of Botswana that Sebego Sharma application should be 8th November 2004 which is a date that the application was received by the Registrar of Companies, Patents and Trademarks in Botswana, and not the date it arrived into the ARIPO office.

The Protocol requires that where an application is filed through the Industrial Property Office of a Contracting State, the application should be transmitted to the ARIPO office within one month of receiving the application- See section 2.4 of the Protocol. In the present case, the application for the registration of the trademark was filed on 8th November 2004 by Sebego Sharma & Company on behalf Jacques Kardolus. For reasons that are not known to this Board of Appeal and could not be established from the file, the application was received by ARIPO on 27th September 2005, sent under a covering letter dated 23rd March 2005.

We agree with the appellant that indeed the Botswana office failed to comply with Section 2.4 of the Protocol which obliges that office to transmit all ARIPO applications to the ARIPO office within one month from the date of receiving the application. However, we disagree with the appellant on that the Contracting State's non-compliance renders the application of an applicant who finds himself in this unfortunate position non-conforming to the Protocol.

We note that Rule 8 requires that the applicant who wishes to rely and benefit from it must satisfy certain requirements spelt therein. It is clear from the forms of application by Sebego Sharma that the applicant is not claiming priority. It is also clear from Article 4 of the Paris Convention upon which Section 4 and Rule 8 of the Banjul Protocol find their existence, is not a requirement but is to the advantage of an applicant to claim priority from an earlier application where applicable. It is our considered view that the appellant's interpretation of Section 4 and Rule 8 of the Protocol is incorrect, in that Kardolous' application was an ARIPO application filed through a Contracting member state, in this instance Botswana, in accordance with Section 2.1 of the Protocol. Therefore the question of the Sebego Sharma application not complying with Section 4 and Rule 8 of the Protocol does not apply. Even if, there was an earlier application elsewhere, it is not mandatory that an applicant uses an earlier application to claim priority. Consequently, the appellant cannot rely on the issue of priority claim.

We have examined the contents of the letter from ARIPO to the Registrar in Botswana dated 14TH October 2005 and we do not agree that the contents thereof amount to a rejection of the trademark filed by Sebego Sharma through Botswana.

ARIPO responded to the issues raised by the appellant as follows;

i) the filing date of an application filed in a Contracting State is also subject to compliance with Section 3*bis* of the Protocol, therefore the determinant of the filing date is not when an application reached ARIPO office but when it complied with the said section. ARIPO stated that in some instances, like the appellant's case the date of receipt is the date of filing, same as the application filed through Botswana office;

ii) by the letter of 14th October 2005, it was not rejecting the application filed through Botswana, but merely informing the Registrar's office in Botswana about the existence of the appellant's trademark in the register;

iii) it could not reject the appellant's trademark prior to the lapse of twelve (12) months prescribed in Section 6.2 of the Protocol. ARIPO office says it is at that time that it conducted substantive examination on the appellant's mark and rejected it on grounds that it is not new;

iv) that the appellant did not comply with the of the Protocol 5.4 in that when it first received ARIPO's rejection it lodged an appeal instead of requesting the Office to reconsider its decision in accordance to Section 5*bis* of the Protocol.

We agree with ARIPO that irrespective of where an application was lodged, the date of filing is determined by its compliance with Section 3*bis* of the Protocol. We further agree with ARIPO that the letter to the Registrar of Botswana dated 14th October 2005 was not rejecting that application. However, we wonder why the same information was not relayed to the other designated states in that application.

We agree with ARIPO on the twelve (12) months waiting period. However, we disagree with ARIPO examining the trademark as to substance and rejecting the trademark on grounds that it is not new. Firstly, from all laws best known to us, newness (or novelty), is not a requirement for the registrability of a trademark. Therefore ARIPO was not correct in using the measure of newness to reject the appellant's trademark.

Secondly, Section 6 and Rule 11 of the Protocol reserve powers of substantive examination of a trademark for the Designated states. According to the Protocol, ARIPO is only empowered to conduct examination as to form (see Section 5 of the Protocol). Where ARIPO has satisfied itself that all the formalities have been met, ARIPO should notify all designated states about the application. Thereafter each designated state is to conduct substantive examination in accordance with its national laws. We are particularly guided by Sections 6.3 and 6.4 of the Protocol where the designated states must justify its refusal to register a mark and in that instance the applicant is given a right to deal directly with any such designated state. Therefore it follows that ARIPO can only refuse an application for non-compliance as to formalities.

If we are to assume that Section 6.1 of the Protocol does empower ARIPO to conduct substantive examination, in this case, the ARIPO office did not cite in its letter rejecting the appellant's application, the applicable laws of the Zimbabwe that bar the registration of a mark on grounds that it is not new.

We do not agree with ARIPO when it says the appellant did not comply with the formalities of requirement under Section 5.4 of the Protocol, rather we find that a plea for ARIPO's reconsideration was filed, only it was titled an appeal.

Conclusions

1. We conclude that indeed the Sebego Sharma application complied with the requirements of the Protocol therefore is entitled to the filing date of 4th November 2004.

2. We also conclude that ARIPO has no powers to examine a trademark as to substance, but such powers rest with the Industrial Property offices of the

designated states. Therefore ARIPO erred in rejecting the appellant's application on grounds that it is not new.

3. We would in the circumstances of this case grant the appellant's application with a variation. The variation is that both applications be allowed to co-exist in the ARIPO register as **applications**.

4. ARIPO needs not to take the powers of the designated states in a quest to ensure that its trademark register is clear of conflicting registrations. It is our opinion that where ARIPO foresees such possibilities, its duty is to provide the necessary information to the designated states to enable them to make an informed decision. To address this concern, in this case, we order ARIPO that in compliance with Section 5.3 and Rule 11 of the Protocol must forward Form M8 and provide the following;

   4.1 With regard to the appellant's application AP/M/2005/000303 that ARIPO Office;

      i) writes a cover letter similar to the letter of 14TH October 2005 to the state designated in this application that is, Zimbabwe and ensure that this communication reaches the Zimbabwe industrial property office.

      ii) includes the following details of the trademark application, in respect to the application filed through by Sebego Sharma & Company on behalf of Kardolus through the Botswana office and mainly include the following;

         a) The name, address and nationality/place of business of the applicant;
         b) The filing date of the application;
         c) The trademark applied for and attach copies of the reproduction of the mark;
         d) The class of goods and/or services applied for;
         e) The designated states;
         f) The status of the application in each designated state (e.g. pending, registered, withdrawn, abandoned etc)

   4.2 With regard to the application filed through Botswana by Sebego Sharma & Company (AP/M/2006/000370 (initially BW/M/ARIPO/04/00001) ARIPO Office should;

      a) address its letter of 14TH October 2005 to all states designated in this application that is, Botswana, Malawi, Uganda, Lesotho, Namibia, Tanzania and Zimbabwe. Particularly ARIPO should ensure that this

communication reaches Zimbabwe office because both applications designate this state.

b) include the following;

i) The ARIPO register search results;

ii) Details of the appellant's trademark application, mainly include the following;

a) The name, address and nationality/place of business of the applicant;
b) The filing date of the application;
c) The trademark applied for and attaches copies of the reproduction of the mark;
d) The class of goods and/or services applied for;
e) The designated states;
f) The status of the application in each designated state (e.g. pending, registered, abandoned etc)

Since no prayer for costs was made, none is awarded.

Finally, we would like to urge the ARIPO office to strictly observe the Protocol and in particular adherence to time limits, information delivery, procedure and processing of application, procedure on appeals and rules of natural justice.

Dated at **ARIPO Office, Harare, Zimbabwe** on this **30th** day of **August 2007**.

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Hon. Justice J.H. Ntabgoba
Chairman of the Board of Appeal

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Justice A.S.E Msosa
Member of the Board of Appeal

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K. N. Monyatsi
Member of the Board of Appeal