



OAPI - Trade mark registration

Background

Company A registered DRINK-O-POP (word mark) on 2 February 1990 for flavoured milks in the OAPI. Its products are marketed throughout the OAPI region. Company A became aware of the subsequent registration of the mark POP DRINK for flavoured milks at the OAPI in the name of an individual (Mr X.) and Company Y. Company A successfully opposed the registration of POP DRINK on the basis of its earlier trade mark.

Some years later, Company A became aware that once again the mark POP DRINK had been registered for flavoured milks at the OAPI. This time it had been registered by Mr X and another individual. Moreover, flavoured milks were being marketed in two OAPI countries under the POP DRINK trade mark.

Company A once again opposed the POP DRINK registration.

While the opposition procedure was ongoing, Company A unilaterally requested a search and seizure order (saisie contrefaçon) against the distributors of POP DRINK in Niger (an OAPI country). The company requested the seizure of the goods on the basis that they were counterfeit. The seizure was carried out and Company A filed a lawsuit on the merits to secure the seizure. Upon third party opposition by the distributor, the judge lifted the search and seizure order and requested the prompt release of the goods on the basis that the seized goods were in fact covered by a valid trade mark (albeit one under opposition).

Company A also started legal actions for trade mark infringement against a distributor of POP DRINK in Togo (another OAPI country). The judge ruled that there was no trade mark infringement, on the basis that the opposition decision was not definitive, Mr X having appealed the first instance decision of the Opposition Commission of OAPI. The POP DRINK trade mark remained valid in the meantime.


Action undertaken

The above situation was caused by the OAPI's former registration practice. That practice was to follow the steps in this order:

- register a trade mark
- issue a registration certificate
- publish the trade mark and open a 6-month opposition period.

This allowed infringers to rely on a trade mark registration certificate to argue that their activities were legitimate. Bad faith applicants could also systematically re-file trade marks without the knowledge of the rightful owner and thus force the rightful trade mark owner to file post-registration oppositions that – in the worst case scenario - could last for several years. In the meantime, the infringer could continue to market goods using the infringing trade mark.





The new procedure will allow trade mark owners to oppose a trade mark application before it is registered and will prevent the abusive use of a trade mark obtained in bad faith. Under the new procedure, counterfeiters will not be allowed to hide behind their registration to market infringing goods over lengthy periods and thus unduly benefit from the goodwill of legitimate trade mark owners.

Lessons learned

- Each country/system has its own specificities, which must be kept in mind. What may seem obvious under one system may not be acceptable in another.
- Infringers are very resourceful, and a trade mark strategy must at times go beyond trade mark oppositions and the seizure of counterfeit goods to be truly successful. It is important to see the whole picture and look at what might be most effective.
- In countries following a post-registration publication procedure, rights holders should keep an eye on the ground. The availability of counterfeit goods on the local market may provide an indication as to possible infringing trade mark registrations.

Contacts us:

africaiphelpdesk.eu

E-mail: africa.iphelpdesk@euipo.europa.eu

Phone Number: Europe (Spain): +34 96 513 9810

Opening hours: Monday to Friday
8:30 to 18:30 (CET/CEST)

Follow us:

facebook.com/AfricaIPR

linkedin.com/company/africaipr

@AfricaIPR

