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ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN AFRICA

Enforcement of Intellectual Property Rights in Africa

This brochure presents a brief overview of intellectual property rights (IPR) enforcement in Africa and draws general guidelines and directions to follow for rights holders regarding their IPRs on the African continent.

Though enforcement of IPRs remains governed by national laws, there have been remarkable efforts to harmonise and strengthen intellectual property (IP) enforcement across the 54 African States.

Efficient IPR enforcement is essential for rights holders: IP enforcement is a key parameter in determining whether they should invest and be active or not in any given country. Similarly, the quality of IPR enforcement plays an essential role in developing a culture of creativity, incentivising local businesses and attracting foreign investments.

1. What are the laws for IPR enforcement?

Most African countries have a complete legal and institutional framework for IP enforcement, with national laws and policies to protect and enforce IP. In many countries, protection covers:

- copyright;
- trade names;
- registered trade marks;
- registered industrial designs;
- registered patents;
- registered utility models;
- registered plant breeders' rights;
- registered geographical indications.

National laws are based on most African countries being members of:

- the Berne Convention for the Protection of Literary and Artistic Works (https://www.wipo.int/treaties/en/ip/berne/);
- the Paris Convention for the Protection of Industrial Property (https://www.wipo.int/treaties/en/ip/paris/);
- other World Intellectual Property Organization (WIPO) Treaties (https://www.wipo.int/treaties/en/);
- the World Trade Organization (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) (https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

These treaties set minimum standards for IP protection and enforcement that participating

African countries are committed to meet in their legislation.

In addition, most African countries have received support to enhance effective IP enforcement, from numerous international organisations, including WIPO, the WTO, the World Customs Organization (WCO), the International Criminal Police Organization (INTERPOL) and the European Union (EU), as well as from many EU Member States and other third countries.

The African continent is second only to Europe in terms of IPR granting unification or harmonisation. Similar to European countries, to better meet and facilitate IP protection objectives, many African countries (39 out of 54) have agreed to extended IPR harmonisation or integration mechanisms between themselves.

However, though protection of IPRs is centralised between numerous African countries, enforcement remains national. Nevertheless, whenever IPR protection is granted under common rules, the effective enforcement of IPRs is influenced by common rules.

There are three country categories in Africa.

- Member States of the Organisation Africaine de la Propriété Intellectuelle (OAPI) with 17 countries: Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, the Comoros, the Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, the Niger, Senegal and Togo).
- Member States of the African Regional Intellectual Property Organization (ARIPO) with 22 countries: Botswana, Cape Verde, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mauritius, Mozambique, Namibia, Rwanda, São Tomé and Príncipe, Seychelles, Sierra Leone, Somalia, Sudan, Tanzania, Uganda, Zambia and Zimbabwe).
- Countries that not members of either of these two organisations.

A. Member States of OAPI, headquartered in Yaoundé, Cameroon

The 17 members of this intergovernmental organisation established to harmonise and streamline the protection of IP across French-speaking African countries apply a completely unified sub-regional registration system. This means that once an IPR is granted by OAPI, it applies to all 17 countries.

This makes really simple for businesses to protect their IPRs in multiple jurisdictions with a single application. Whenever these rights need to be enforced, they are so at national level, but the legal basis for the IPR litigated is a single one (the OAPI Bangui Agreement) and identical for the 17 countries, making simpler and less costly any enforcement procedures in the OAPI area. It is also likely that enforcers in one country who are aware of litigation on the same IPR in another OAPI country would consult any similar case in the other OAPI country.

B. Member States of ARIPO, headquartered in Harare, Zimbabwe

22 countries are members of this intergovernmental organisation aiming at partly harmonising

IPR granting and protection across English-speaking African countries, meaning that IPR applicants can, depending on the right applied for, apply centrally for patents, trade marks and industrial designs for a certain number of ARIPO Member States.

The ARIPO system is less integrated than the OAPI one. Still, common mechanisms influence them. ARIPO makes it easier for businesses to request IPR protection in multiple ARIPO jurisdictions with a single application in participating countries. Whenever IPRs should be enforced, this are done at national level and based on national law. However, the common standards and formalities in applying for IPRs makes likely that enforcers in one ARIPO country who are aware of cases in the same IPR in another country would consult them.

Therefore, both ARIPO and OAPI facilitate IP protection across multiple countries with minimal bureaucratic hurdles, with positive induced effects on their enforcement.

C. Countries not members of any of these two organisations

They follow national granting and enforcement rules. Yet, many of them are members of: the Berne Convention for the Protection of Literary and Artistic Works, the Paris Convention for the Protection of Industrial Property, numerous WIPO-administered Treaties and the WTO TRIPS Agreement. This creates virtuous elements of harmonisation between granting IPRs, enforcement legislations and international standards.

2. When can IPR enforcement take place?

IPRs can be protected if national legislation ensures a protection for the establishment of IPRs, IPR registration in the country in question and IPR enforcement. Most African countries have legislation that match establishment, registration and enforcement at borders and in the country's marketplace.

IPR enforcement can take place anytime but IPRs can be enforced mostly:

- during administrative procedures with IP offices;
- during customs operations at the country's borders; or
- directly in the territory of any country.

Enforcement normally takes place through:

- court action in civil or criminal enforcement procedures; or
- alternative dispute resolution (ADR).

3. How can IPR enforcement take place?

3.1. Administrative procedural challenges

As an administrative measure, in many African countries, an IPR registration by a third party

or competitor may be opposed after publication of the intended IPR registration by the third party. This process helps to prevent undue registration of business' registered IPRs by the IP office for a third party or competitor. It is important for IPR holders to monitor IP office publications for possible infringing IPRs, to initiate immediate action via an opposition procedure, within the opposition period that may be as short as 3 months after publication. Yet, in many African countries, there are no provisions for opposition in patent prosecution, since they only publish the granting of patents and rights holders have to proceed directly to courts to invalidate such grants.

3.2. Border enforcement

Apart from administrative procedures, the main litigation in IPR infringement often starts at borders or within the country's territory.

As with the initial steps, to request IPR enforcement in any country, individuals and companies must demonstrate that they own an IPR, for example, a patent, design, trade mark or geographical indication valid in the country (including through registration, if applicable).

Border enforcement often represents the best time slot for enforcement, since goods are stopped for inspection at customs. This may be the easiest moment for IPR holders to act to protect their rights: Customs authorities play a vital role in IPR border enforcement. They are in the first line of defence against the movement of counterfeit goods into and out of a country. Many African customs authorities are entrusted with the responsibility of monitoring, seizing and destroying counterfeit goods, as well as working with rights holders to enforce their IPRs.

Key activities involved in border enforcement include:

- **goods inspections** – customs officers inspect goods entering or leaving the country to ensure they comply with national IP laws and international treaties;
- **seizures** – when customs authorities identify counterfeit or pirated goods, they may have the authority to seize them at the border;
- **collaboration with rights holders** – customs authorities often work in partnership with IP owners who may provide information about counterfeit goods and even assist in identifying infringing items.

Africa's sub-regional trade agreements and customs unions have further facilitated cooperation in border enforcement. Some of the most prominent sub-regional bodies working on IP enforcement are: the East African Community (EAC) (with customs management rules, which include provisions for IP enforcement at borders); the Economic Community of West African States (ECOWAS), and the Southern African Development Community (SADC).

3.2.1. Border control operations: registration of IPRs with customs authorities

Some countries offer, or impose, a specific IPR registration already valid in the country with customs that facilitate border inspection (e.g. Egypt, Kenya, Morocco). In countries applying additional IPR registrations with customs, IPR holders (i.e. legitimate business operators) who

wish to protect their rights must use a specific, manageable application for IPR registration with customs. If accepted, the registration will then permit customs officers to better and easily identify infringements during border control operations, alert IPR holders and allow them to launch actions in court to stop the infringements and gain remedies against IPR violators.

Thanks to the request recorded in IPR registration systems at customs, customs officers are in charge of keeping watch for any counterfeits or suspected infringing goods moving through customs points under the customs jurisdiction.

Customs authorities retain the right for the *ex officio* controlling of any goods-infringing IPRs at borders, but the rights registration largely facilitates their work.

The main principles for IPR registrations with customs are the following.

The IPR holder should provide detailed information on their rights and all contacts. Information and evidence (and intelligence whenever available) should be presented with the application and are summarised as follows:

- a sample article bearing the right registered with OAPI / ARIPO / the national IP office as appropriate, or a copy of a photographic or other likeness of the right or trade mark, as it is used on genuine goods;
- the place of manufacture of genuine goods and the identity of the manufacturer(s);
- the name and principal business address of each foreign person or business entity authorised or licensed to use the IPR and a statement as to the authorised or licensed uses;
- the name and business address of the importer(s) or consignee(s) of the allegedly infringing goods, whenever available;
- a sufficiently detailed description of the suspect goods to make them readily recognisable by customs, including a sample of the infringing article(s), a photograph or other likeness whenever available;
- the country or countries of origin of the suspect goods or the country or countries of manufacture of the allegedly infringing goods, whenever available;
- the name and principal business address of each foreign person or business entity involved in the manufacture or distribution of suspect goods, whenever available;
- the mode of transportation and the identity of the transporter(s) of the allegedly infringing goods, whenever available;
- the customs office where it is anticipated that the suspected articles will be presented to customs, if it is known.

IPR holders are encouraged to provide as much evidence as possible in their application to assist customs' targeting. Because of their IPR registration, rights holders accept to be liable for the custody by customs of suspected goods that would then result in not infringing their rights, and often deposit with customs authorities a monetary guarantee to this effect.

Customs officers have authority to receive, accept or refuse a registration request from an IPR holder. Applicants, if deemed necessary, can challenge refusals of registration. When the registration is accepted, it produces its effects with customs for a certain time (renewable if the IPR remains valid in the country). As mentioned, this means that upon the request recorded in

the Intellectual Property Right Registration system, customs officers keep watch for any counterfeits or suspected infringing goods moving through the customs points under the customs jurisdiction.

3.2.2. How border control measures take place effectively

At borders, customs authorities will perform the following duties.

- **Inspection and supervision for the imports or exports of goods registered by IPR holders with customs** and are suspected of infringing registered IPRs: where customs is satisfied, after consulting with the applicant if necessary, that the imported or exported goods are suspected to infringe an IPR covered by the customs registered IPR, they will suspend the clearance of the goods referred to.

- **Alternatively, in countries without specific IPR registration systems with customs**, when a business has prior information about a possible entry into the country of IPR-infringing goods, it must take immediate steps through an IP attorney to obtain an order for detention of the infringing materials at the borders.

- **Customs will detain the infringing goods** normally for a certain period: this time lapse may vary depending on the country, but it is normally 10 working days (reduced to 3 working days for perishable goods, including food). This period can generally be extended upon request by a further 10 working days (3 days for perishable goods) to allow the IPR holder to initiate proceedings in the appropriate court or to reach an agreement with the owner for their disposal. It may be required to post a security deposit in these situations.

- **Where there is no IPR registration in force, customs at their own initiative (through *ex-officio* action) may detain a suspected shipment** to allow the IPR holder, following a notification from customs, to lodge an application for suspension of the shipment.

- **In any case, suspension at customs cannot generally exceed 20 days, and IPR holders must initiate court actions to sanction the infringer and possibly request damages within this period.**

Customs action borders thus permits IPR holders whose rights are infringed to initiate proceedings in court. They should launch proceedings within the prescribed lapse of time of customs withholding the proceedings in the appropriate court, or alternatively reach an agreement with the rights holder.

N.B. In most countries, foreign IPR holders must appoint a local IP attorney to represent a foreign client at customs.

3.3 Action before courts

Whether infringement is initially identified at borders as per above, or directly in the country's

internal market, court procedures shall have to be engaged.

Several African countries are engaged in the creation of specialised IP courts that are more knowledgeable on IP than non-specialised courts, thus facilitating IP enforcement.

3.3.1. Criminal enforcement procedures

IPR holders can file a criminal complaint with local law enforcement agencies if IPR infringement constitutes a criminal offense under national laws. This will attract criminal penalties such as fines, imprisonment and seizure of counterfeit goods. This measure has proven to act as a strong deterrent against infringement in many cases. If IPR infringement is not detected at the border, IPR holders may also solicit police assistance to enforce their IPRs on the market. The police may also engage in raids in matters of counterfeit and piracy and proceed to prosecute the accused persons.

3.3.2. Civil actions and remedies

An aggrieved IPR holder may seek relief from the courts (often commercial divisions). The remedies available to the aggrieved rights holder may include:

- interim orders;
- injunctions, including 'Anton Piller' and 'Mareva' injunctions, to avoid that proofs of infringement disappear, and to prevent further infringement;
- special damages pleaded and proved before a judge may award such damages, which can be a deterrent;
- general damages, which may not be punitive enough to be a deterrent;
- additional damages, which may be awarded if the infringement is flagrant and blatant, and may be a deterrent;
- the detention and disposal of infringing materials at the cost of the infringer, which is a deterrent;
- the disclosure of other persons known to the defendant to be involved in the production; and
- the distribution of the infringing goods or services.

N.B. In most countries, foreign IPR holders must appoint a local IP attorney to represent a foreign client in court.

Courts will need information and evidence (and intelligence whenever available) to be presented, for example:

- a sample article bearing the right registered with OAPI / ARIPO / the national IP office as appropriate, or a copy of a photographic or other likeness of the right, or of trade mark, as it is used on genuine goods;
- the place of manufacture of genuine goods and the identity of the manufacturer(s);

- the name and principal business address of each foreign person or business entity authorised or licensed to use the IP right and a statement as to the authorised or licensed uses;
- the name and business address of the importer(s) or consignee(s) of the allegedly infringing goods, whenever available;
- a sufficiently detailed description of the suspect goods to make them readily recognisable by judges, including a sample of the infringing article(s), a photograph or other likeness whenever available;
- the country of origin of the suspect goods or the country of manufacture of the allegedly infringing goods, whenever available;
- the name and principal business address of each foreign person or business entity involved in the manufacture or distribution of suspect goods, whenever available;
- the mode of transportation and the identity of the transporter(s) of the allegedly infringing goods, whenever available.

IPR holders are encouraged to provide as much evidence to assist courts as much as possible.

3.4. Alternative dispute resolution

Methods such as mediation and arbitration provide a less formal and often quicker way to resolve IPR disputes. Several African states have legislation that provides for mediation and arbitration of disputes if parties agree. A mediation decision is binding and enforceable. An arbitration award is also final and enforceable.

ADR is expected to expedite dispute resolution and keep details of the dispute private between the parties. Such dispute resolution mechanisms may appeal to rights holders who wish to avoid negative publicity and keep certain IPRs secret. Therefore, depending on the IP strategy adopted, it may be useful to opt for settlement of disputes through any of the ADR mechanisms. Yet, although there are ADR professionals in African countries, there are still very few ADR professionals with IP specialisation.

3.4. Leveraging technology for enforcement

Modern technology offers significant potential for improving border and country enforcement. Digital tools such as tracking systems, e-commerce platforms for reporting counterfeit goods, and RFID tags, can help customs and police authorities to track the movement of goods and detect counterfeits. Moreover, advanced data-sharing platforms between countries can provide real-time information about suspected counterfeit shipments, enabling faster and more efficient customs responses.

4. Additional useful hints for readers

What businesses should do to enforce their IPRs

A. How fake products can be identified

There are many tactics that can be adopted to avoid the circulation of IP-infringing goods.

Scrutinise the item and its packaging.

- Check the quality: is it badly made? In particular, ensure that the product, model numbers and equipment details are marked on the packaging. To confuse enforcement agencies and to avoid taxes, IP infringers often put 'high value' infringing goods in boxes marked as containing cheap goods.
- Check that you can read the manufacturer's contact name; phone number or address. This type of information is rarely seen on the packaging of IP infringing products.
- **Carefully examine the logos and labels on products and boxes.** Are there any typographical errors? Are there safety and guarantee tags on the products? Pay close attention to spelling or grammatical errors – these frequently appear on the packaging containing IP infringing products.
- **Check the product transportation crates.** Crates containing genuine products in their boxes normally include bar codes, trade marks and sometimes recycling instructions. Most IP infringers avoid investing time and money reproducing this information.
- **Check case-law to identify recent trends in counterfeits or cases that may be similar to other protected IPRs** (EU resources available online: https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/africa-ip-sme-helpdesk/case-studies_en).

B. Steps to take if your IPRs are infringed

- If you discover that your IPRs have been infringed, **taking prompt and effective action** is crucial to protecting your IP and enforcing your rights.
- **Document the infringement:** Thoroughly document the infringement by capturing screenshots, recording URLs and gathering evidence of unauthorised use of your IPRs. Note the date and time of discovery – this documentation is essential for legal actions and effectively communicating the issue to the infringer or relevant platforms.
- **Verify the infringement:** ensure that the use of your IPRs is indeed unauthorised. Sometimes, what appears to be an infringement might be permissible or could involve IPRs you have previously licensed. Verify that the infringer does not have a licensing agreement.
- **Review the terms of any licenses you may have issued** to ensure that the usage falls outside those terms.
- **Contact the infringer:** reach out to the person or entity that has infringed on your IPRs. Send a formal cease-and-desist letter or email requesting that they stop using your IPRs. Be clear and professional in your communication, outlining the specifics of the infringement and providing evidence. In many cases, a direct approach can resolve the issue without further legal action. If the infringement involves content posted on a third-party platform (such as social media, blogs or online marketplaces), report the infringement to the platform and request for a takedown of the content.

- **Seek legal advice:** if significant infringement occurs or initial resolution attempts fail, consult an IP legal practitioner for guidance on your rights and potential remedies.
- **Update your licensing and policies:** review and update your licensing agreements and policies to better protect your work. Ensure that your terms of use are clear and comprehensive, covering all potential areas where infringement could occur.
- **Do research:** check with contacts or online to see if there are any reports of infringing similar products.

In particular, do all of this when health and safety is a priority.

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