

# **Commission on Intellectual Property Rights**

## **Country Case Study for Study 9: Institutional Issues for Developing Countries in IP Policy-Making, Administration and Enforcement**

### **Sub-Saharan Africa**

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# AN OVERVIEW OF INTELLECTUAL PROPERTY POLICY, ADMINISTRATION AND ENFORCEMENT IN SELECTED AFRICAN COUNTRIES

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## INTRODUCTION

The aim of this paper is to explore and examine issues of Intellectual Property Policy, Administration and Enforcement in Africa in general and in particular Eritrea, Liberia and Zambia. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which is an integral part of the Marrakesh Agreement Establishing the World Trade Organisation has created obligations to which WTO Members must comply with its provisions. The provisions set minimum standards which Members must comply with irrespective of whether or not a country has the necessary manpower and resources. No doubt the TRIPS Agreement does not seem to have taken into account the lack of resources by Least Developing Countries (LCD's). For the Least Developing Countries, protection of Intellectual Property Rights (IPR) is not a priority as most of its citizens struggle to survive. Indeed the available UN and World Bank statistics indicate that in Africa two thirds of its population, particularly in Sub-Saharan Africa live on less than one US dollar per day. This means that this population lives in abject poverty, that is to say they live on the margins of existence, without adequate food, clean water, sanitation or health care and indeed without education.

The TRIPS Agreement can be said to be most comprehensive agreement adopted by WTO Members on Intellectual Property Rights. The negotiations of this Agreement was spearheaded by the United States of America, who wanted to protect Intellectual Property Rights of its citizens. In 1992 the US Trade Representative (USTR) affirmed that **“The importance of a strong, unyielding stance on intellectual property protection as part of our global trade strategy cannot be overestimated”**<sup>1</sup>

No doubt the TRIPS Agreement has created the forces of globalisation, and the emerging information Age has placed a premium on the protection of intellectual property. This fact is more evident in the international trade policy of the United States. The position taken by United States on IPR and globalisation should be considered and reconciled with the UN Secretary General's report to the Millennium Assembly, **“The central challenge we face is to ensure that globalisation becomes a positive force for all the world's people, instead of leaving billions of them behind in squalor. Inclusive globalisation must be built on the great enabling force of the market, but market forces alone will not achieve it. It requires a broader effort to create a shared future, based upon our common humanity in all its diversity”**<sup>2</sup>

The protection of intellectual property through the TRIPS Agreement has become an integral party of the multilateral trading system as reflected in the World Trade Organisation. WTO Members are under an obligation to ensure that they comply with the provisions of the Agreement. No consideration or exceptions are given or provided in the Agreement for the poor of the poorest members who may not be able to comply with provisions for lack of manpower and resources in all its forms. Is such an Agreement fair?

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1 Report of the Industry Sector Advisory Committee on services on the North American Free Trade Agreement, 14<sup>th</sup> September, 1992.

2 UN Secretary General, April 2000, Report to the Millennium Assembly.

How can one expect the LCD's to provide resources for compliance of the TRIPS Agreement, when its population is barely surviving by the grace of God? Is it morally right for the Developed countries such as UK, US, Germany indeed all G 8 to expect a government of a Least Developing Country to put its resources on IPR compliance instead of providing education to its children; providing health care to its citizens who 70% of the population in the Sub-Saharan Africa are infected with HIV/AIDS.

The majority of the applications of IPR being sought for protection in Developing countries come from Developed Countries. Is it asking for too much if a mechanism is worked out to ensure that IPR owners, should make a contribution towards the eradication of poverty? Does globalisation not mean a shared future, based upon common humanity in all its diversity as stated in the report of the UN Secretary General?

These are some of vexing question which must be properly addressed by the Developed Countries and the IPR owners.

## **2. IP POLICY IN GENERAL**

The Developed countries have dealt with IP policy matters as far back as 1883 when they held a diplomatic conference which was convened in Paris at which the Paris Convention for the Protection of Industrial Property Treaty was adopted.

The majority of African States did not have any IP policy, as issues pertaining to IP were a privilege of the colonial master, such as UK. Prior to 1980s most English –Speaking African countries did not have independent Intellectual Property Laws and IP offices, and therefore did not grant any IPR. Most of these countries were tied to UK Patent office, for example in order to have an IP right protected in Kenya, Uganda, Tanzania etc, one had to file an application in UK and once granted then the IPR owner upon production of the Certificate of Registration or grant issued by the controller of UK-Patent Office, the official in the given country was obliged to protect the IP rights.

In 1972, the World Intellectual Property Organisation (WIPO) held a conference in Addis Ababa at which for the first time the African Governments sent delegation to the meeting. At that meeting, it was decided that there was a need of updating and enacting of new IP Laws and therefore WIPO and United Nations Economic Commission for Africa (UNECA) was tasked to organise future meetings.

In late 1970s, the English-speaking African countries formed two committees namely Committee on Patent Matters and Committee on Trademark Matters. The two Committees with the support of WIPO and UNECA published two model laws, commonly known as ESARIPO Model Laws on Patents and Trademarks.

The ESARIPO Model Laws have been the basis upon which a number of African Regional Industrial Property Organisation (ARIPO) Member State legislation on Industrial Property is based.

The participation by African States in IP policy only dates back to 1970s whereas the Developed Countries goes back to 1883 when the Paris Convention for the Protection of Industrial Property was adopted in Paris. This was followed by the Berne Convention for the Protection of Copyright and Neighbouring Rights in 1886.

It seems that the African experience in IP policy is not well grounded, particularly in negotiating such as TRIPS Agreement. No doubt, it would appear that the Africans did not understand the implications of the TRIPS Agreement. This is evidenced by the fact that the TRIPS Agreement does not make any exceptions or allow any country to make reservations on certain provisions regarding the compliance of the Agreement.

### 3. IP ADMINISTRATION IN SELECTED COUNTRIES

The Administration of IP in most African countries is vested in Ministries of Justice, or Ministry of Commerce and Trade or Ministry of Information and Broadcasting. Prior to Zambia's Independence, the IP matters were under the portfolio of the Government of the Federation of Rhodesia and Nyasaland and the IP Administration was based and administered from Harare in Zimbabwe. The IP Office was established in Zambia in 1968 at the end of the Federation of Rhodesia and Nyasaland in the Ministry of Commerce, Trade and Industry.

In Zambia, issues of IPR are vested in two Ministries namely the Ministry of Commerce, Trade and Industry and the Ministry of Information and Broadcasting. The Patents, and Companies Registration Office (PCRO) administers the Industrial Property aspect of Intellectual Property rights, while the Ministry of Information and Broadcasting deals with Copyrights and Neighbouring Rights.

The PCRO was a department within the Ministry, until 1998, when it was transformed into an Executive Agency on similar lines like the UK Patent Office. When it was a department its finances were budgeted and approved by Parliament.

Although, the Office generated a lot of revenue nevertheless the funding of the Office was not adequate. Due to financial constraints, the Office could not develop to its full capacity in terms of human resources, equipment and Office space. This resulted in having operational difficulties in the running of the Office. It was almost impossible for the Office to finance the attendance of the Governing Bodies Meeting of WIPO and ARIPO. This had a negative impact on the development of IP Administration in Zambia. Zambia could not effectively attend most of important Meeting pertaining to the IP matters due to lack of financial Resources.

The Industrial Property Administration in Eritrea is non existence. There is no Industrial Property Office. There is only one officer who attends to Industrial Property Matters. The Officer has received no training in Industrial Property Matters. The findings of the Report commissioned by the World Intellectual Property Organisation (WIPO) in April, 2000 is still valid. The detailed Report is submitted as **ANNEX ONE**.

The position of IP Administration in Liberia is slightly improved compared to Eritrean situation. The IP legislation in Liberia dates back to 1864 and is somewhat similar to the IP Legislation which existed in United States of America in the early 1880s. The reason being that Liberia had ties with the United States of America being a state founded for freed black slaves. However, although US has developed its IP laws, Liberia has lacked behind.

The status of IP Administration is described in the Report Commissioned by the World Intellectual Property Organisation (WIPO). Up to June 2001, the situation regarding IP laws and IP Office remained the same, as no changes have taken place. The detailed Report is submitted as **ANNEX TWO**.

It will be observed that IP Administration in the three countries namely Zambia, Eritrea and Liberia is far from satisfactory compared with small Industrialised Countries of the developed world.

Zambia, has a relatively advanced IP Administration compared with most African countries, whereas Liberia has nothing to talk about and Eritrea has nothing completely. This is the situation in most African Countries, yet the TRIPS Agreement expects these states to at least comply with the minimum standards in terms of protection of IP Rights.

Is it realistic to expect these countries to comply with the provisions of TRIPS Agreement? Could one say that the playing field is level? Is it morally right for the Developed Countries to apply sanctions if the Developing Countries fail to provide the protection to IP Rights belonging to owners of Developed Countries?

The Developed Countries and owners of IP Rights must address these issues and find lasting solutions which will not burden the poverty stricken Developing Countries. The rich must learn to share with the poor, since the world has become one global village.

#### **4. TRIPS AGREEMENT AND IP ENFORCEMENT IN SELECTED COUNTRIES**

The TRIPS Agreement consolidated several international agreements and standards into a single undertaking which is backed up with enforceable dispute settlement measures. Its provisions requires the World Trade Organisation (WTO) Members to provide a high level of minimum protection to a wide range subject-matter such as inventions, industrial designs, trade secrets, test data, trade marks, geographical indications on goods, plant varieties, integrated circuit topographies, computer programmes, data bases, encrypted programme-carrying satellite signals, phonograms, and creative works such as films, books and musical works.

The level of protection under the TRIPS Agreement goes beyond what is provided in the Paris Convention especially in the areas of industrial property, where it also establishes obligations on the features of intellectual property such as subject matter to be protected, minimum term of protection and rights conferred upon right –holders.

The Agreement also spell out in detail the procedures and remedies available to the right-holders and imposes an obligation on WTO Members to ensure that the IPRs are protected by ensuring that the necessary infrastructures, civil and judicial processes are put in place for speedy enforcement of the rights.

It is urged that the protection of IP is of little use if the rights cannot be effectively be enforced. The TRIPS Agreement negotiators paid much attention to the issue of enforcement, and as a result it contains provisions which takes care of the domestic procedures and remedies that WTO Members have to comply with in order to enable right holders to enforce their IPRs effectively.

The provisions require that WTO Members must provide in their legal frame work the following:-

- (a) **The procedures for effective action against infringement of IPRs under the Agreement;**
- (b) **The procedure should provide expeditions remedies and prevent infringement, so as to deter others from further infringements;**
- (c) **The recourse to judicial remedies should be fair and equitable;**
- (d) **The procedure should not be a barrier to legitimate trade and must provide safeguards against abuse; and**
- (e) **The procedure must not be unnecessarily be complicated or costly or entail unreasonable time limits or unwarranted delays.**

Whereas, the special obligations under the TRIPS Agreement require that WTO Members must have the following provisions in their domestic law so as to enable IPRs owners to invoke:-

- (a) **enforcement provision regarding submission of proof of evidence to a claim which is in the hands of opposing party by judicial authority;**
- (b) **The Judicial procedure to grant an injunction to restrain the infringer of IPRs;**
- (c) **The Civil and Judicial procedures to award damages, and order the infringers to inform IPRs owner of the identity of third party persons involved in the infringement;**
- (d) **The Judicial procedure to obtain an order to destroy infringing goods outside the commercial channel in order to avoid harm caused to the IPR owner and minimize further infringement.**

WTO Members are obliged under the TRIPS Agreement that their national laws provide for remedies for IPR infringement which should include the following:-

- (a) **imprisonment or monetary fines;**
- (b) **Seizure and forfeiture, and destruction of infringing goods and materials; and**
- (c) **Injunctions, damages and account for profit.**

The enforcement of IPRs by national authorities requires adequate infrastructure, financial and human resources, such as :-

- (a) **IP Laws which are TRIPS Compliance;**
- (b) **IP Office- which examines and grants these rights;**
- (c) **Strong Judicial System regime, which will deal with disputes of these rights both in civil and criminal offences;**
- (d) **Strong Customs Authorities – Knowledgeable in IP issues, especially where Copyright and Neighbouring Rights are concerned.**

The IP regime in Zambia is contained in the following statutes:-

- (i) **The Patents Act, Chapter 400 of the Laws of Zambia.**
- (ii) **The Trade Marks Act, Chapter 40 of the Laws of Zambia.**
- (iii) **The Registered Designs Act, Chapter 402 of the Laws of Zambia.**
- (iv) **The Copyright and Performance Act, Chapter 406 of the Laws of Zambia, and**
- (v) **The Competition and Fair Trading Act, Chapter 417 of the Laws of Zambia.**

The Patents and Companies Registration Office (PCRO) is charged with the administration of industrial property aspect of IP and the Copyright and Neighbouring Rights is administered by the Registrar of Copyright in the Ministry of Information and Broadcasting. The IPRs are derived by complying with the requirements of the concerned Act. The IPRs are enforced in a court of law (i.e. the High Court of the Republic of Zambia), which has unlimited jurisdiction.

The Litigant in IPR action is entitled to all such relief by way of injunction, damages, inspection, account of profit and the Court may make any order it deems fit.

The Zambian situation is such that it has a reasonable established legal system and the IP office. Nevertheless, the resources for implementation and compliance of the TRIPS Agreement, would not be available for the simple reason that Zambia's foreign debt and the level of poverty is very high. Zambia is also affected by the HIV/AIDS problem, it is very unlikely that extra resources would be made available for the purpose of ensuring that it complies with TRIPS Agreement at the expense of the said problems.

The position regarding enforcement in Eritrea and Liberia is as at now non existence since the two countries have no infrastructures, no IP regime to speak about, no manpower and indeed no financial resources. Both countries have just come out of wars and the levels of poverty are alarming.

No reasonable, compassionate person would expect the Governments of the State of Eritrea and Liberia to spend their meager resources on IPRs at the expense of health, education, shelter etc.

**5. REGIONAL INSTITUTIONAL CAPACITY BUILDING OF AFRICAN COUNTRIES IN IP- AFRICAN REGIONAL INDUSTRIAL PROPERTY ORGANISATION (ARIPO) AND AFRICAN INTELLECTUAL PROPERTY ORGANISATION (OAPI)**

In Africa, there are two Regional Organisations which deal in IPRs, these are the African Regional Industrial Property Organisation (ARIPO) and the African Intellectual Property Organisation (OAPI) in Harare and Yaoundi respectively.

**THE LUSAKA AGREEMENT**

African Regional Industrial Property Organisation (ARIPO) is an inter-governmental industrial property organisation created in 1976 at a Diplomatic Conference in Lusaka, Zambia. The Treaty creating ARIPO (known as the Lusaka Agreement) entered into force in 1978. The headquarters of ARIPO are in Harare, Zimbabwe.

At present, 15 States are members of ARIPO:

Botswana, Gambia, The Ghana, Kenya, Lesotho, Malawi, Mozambique, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, United Republic of Tanzania, Zambia and Zimbabwe.

**Objectives of ARIPO**

The objectives of the Organisation include:-

- (a) **the modernization, harmonization and development of the industrial property laws of its members;**
- (b) **fostering the establishment of a close relationship between the member in matters relating to industrial property;**
- (c) **establishment common services or organs for the co-ordination, harmonization and development of industrial property activities affecting its members;**
- (d) **promoting and evolving a common view and approach to industrial property matters among the Member States;**
- (e) **assisting its members in the acquisition and development of technology relating to industrial property.**

**Harmonization of industrial property laws among English-speaking African countries has been facilitated by the Committee for Patent matters and the Committee for Trademark matters established by the Conference on Industrial Property laws for English-speaking African in early 1970s. The Committee was assisted by the International Bureau of WIPO who were responsible for the preparation of the draft model laws for English-speaking African based on recommendations made by experts composed of Heads of Patent Offices from the industrial property offices of English-speaking countries.**

The primary objective of the African Regional Industrial Property Organisation is to promote the harmonization and development of the industrial property laws of the countries of the Regional (Article III (a) of the Agreement creating the Organisation, adopted in Lusaka on December, 9, 1976). The Lusaka Agreement entered into force on February 15, 1978. In carrying out this objective, the Organisation took into account the fact that majority of the countries concerned had “dependant patent system”: in other words, their patent laws did not provide for the original grant of a patent in the country but extended to their territories the effects of a patent granted in a foreign country (in most cases, the United Kingdom). Such grants were normally governed not by the law of the African country but by that of the foreign country. Accordingly, the Committee for Patent Matters and the Committee for Trademark and Industrial Design Matters, meeting in joint session adopted a Resolution which recommended that the Governments of English-speaking African States should introduce national independent patent system based upon the approved Model Law for English-speaking African Countries on Patents.

The Trademark Model Law was prepared subsequent to the Model Law for English-speaking African Countries on Patents, which was published in 1978. The proposals were made for the first time at the first session of the Committee for Trade Marks and Industrial Designed Matters Conference on Industrial Property Laws of English-speaking African, which was held in Nairobi (Kenya), in October, 1975. The Committee reached a consensus as to the direction which the harmonization and development of trademark legislation in English-speaking Africa should take.

Subsequently, at its second session, held in Lusaka (Zambia) in December 1976, the Committee of Trade Mark and Industrial Designs Matters examined the result of a questionnaire and an outline of model provisions on trade marks and gave guidance to the Interim Committee on model provisions on trademarks and the Interim Secretariat (WIPO and the United Nations Economic Commission for Africa (ECA) on the preparation of the Model Law. The Council of ARIPO, at its second session, in Nairobi (Kenya), in December 1978, endorsed as the basis for harmonization of trademark legislation’s in the English speaking African countries and requested the Interim Secretariat to proceed with the publication.

On the basis of the Model Law for English-speaking Africa on patent and trademarks, a great number of English-speaking African countries have adopted independent legislations on patents or modified their legislation to correspond to model law. At its seventh session held in Banjul, the Gambia in November 1993, the Administrative Council consider amendment of the Harare Protocol with the view to incorporate the Patent Cooperation Treaty (PCT). Sudan and Malawi were the only members of ARIPO and PCT at that time.

## **HARARE PROTOCOL**

In December 1982, in Harare, Zimbabwe, Council of ARIPO adopted the Protocol on Patents and Industrial Designs (Known as the Harare Protocol).

The Protocol empowers the Office of ARIPO to grant patents and register industrial designs and to administer the granted patents and registered industrial designs, on behalf of the Contracting State (i.e. State which are party to the Protocol).

A Patent granted under the Harare Protocol has the same effect in the designated Contracting State as a national patent. The Protocol entered into force in 1984. Since that date the following countries are a party to the Protocol:-

Botswana, The Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe. Some Contracting States have already incorporated the Protocol into their national laws; for the other Contracting States, incorporation is under way.

## **THE BANJUL PROTOCOL**

The Banjul Protocol on marks, was adopted by the administrative Council in 1993. It establishes a trademark filing system similar to the Harare Protocol. Under the Protocol an applicant may file a single application either at a Contracting State or directly with ARIPO Office and designates in the application the member states in which he wishes his mark to be protected.

The Protocol came into force on 6<sup>th</sup> March, 1997 when three countries ratified, namely Malawi, Swaziland and Zimbabwe, since then Lesotho and Tanzania have joined the Protocol.

## **THE BANGUI AGREEMENT**

Harmonization of intellectual property laws among the French-speaking African countries have been less tedious since individual countries had no intellectual property laws as they were fully dependent on the colonizing foreign country. The countries are bound by the Bangui Agreement signed at Bangui on March, 1977 which came into force on 8 February, 1982. The Agreement contains nine Annexes which include statutory provisions regarding patents, utility model, protection against unfair competition, and a central body for patent documentation and information with the overall purpose of protecting intellectual property rights of the signatory states in their territories in an effective and uniform manner as possible. The member nations also adhere to the Paris Convention for the Protection of Industrial Property, the Convention establishing the World Intellectual Property Organisation and the Patent Cooperation Treaty (PCT).

The Agreement established an African Intellectual Property Organisation (OAPI) with headquarters at Yaoundi in the United Republic of Cameroon. For the member states, the Organisation serves both as the national industrial property office within the meaning of the Paris Convention, and as the central patent documentation and information centre.

The Organisation administers the examination, grant, and publication of the patent and utility model applications. Any filing effected with one of the Member States is considered to be equivalent to the national filing in each Member State.

## **COOPERATION AMONG ARIPO, OAPI AND MEMBER STATES**

In view of the fact that most developing countries are in financial difficulties, as the foreign debt is high and this is compounded by HIV/AIDS and the alarming levels of poverty – Regional Organisations such as ARIPO and OAPI can play a very vital role in the promotion of IP issues. It is important that Member States should ensure that the regional organisations are supported, so as to attract some support from the International Community. At the present moment ARIPO, OAPI and WIPO have an agreement which enables them at least once every year to meet and plan a strategy in matters relating to IP.

It is this cooperation which must be supported by the International Community if the IP issues are to be of direct benefit to poor people. The two regional organisations need to be supported by the International Community in terms of infrastructure, training of human resources etc. With limited resources provide by Member States and fees collected on IP applications, the two organisations have managed to create awareness of IP Matters in Africa, but more need to be done.

## 6. LEGAL OBLIGATION OF AFRICAN STATES IN INTERNATIONAL COOPERATION IN IP

Article 1 of the TRIPS Agreement provides the scope and nature of obligation for all members. It provides that; **“Members shall give effect to the provisions of this Agreement”**

Furthermore, Article 1 (3) provides that members shall accord the treatment provided for in the Agreement to the nationals of other members. These obligations to implement the provisions of the TRIPS Agreement do not discriminate between Developed and Developing Countries and equally bind African States. TRIPS Agreement is not the only IP convention that places obligations on African States.

In this regard, its Article 2 (2) provides that nothing in parts I to IV of the Agreement shall derogate from existing obligations that members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

Therefore, the main obligation of Member States under TRIPS and other IP Conventions is the protection and enforcement of IPRs. The other obligation of African States in International Co-operation in IP is to participate in the formation of IP Convention if their interest and concerns are to be addressed. However, as noted earlier, protection and enforcement of IPRs requires certain structures to be in place. These include IP legislation, IP administration office, enforcement agencies and the Courts of Law. To be established and sustained, these require resources in terms of finances and skilled man power.

Not all African States have these structures in place. Thus, if these countries are to protect and enforce IPRs or their legal obligation under TRIPS Agreement, they must direct their resources to establishing this infrastructure. However, resource are scarce and they are other competing obligations on African governments. These states are struggling to provide the basic needs for existence to their nationals in terms of food, clean water, shelter, clothing, medical care and education to mention a few. Therefore to expect them to effectively protect and enforce IPRs without assistance from the developed countries would be expecting too much. The TRIPS Agreement provides that; **“The protection and enforcement of IPRs should contribute to the promotion of technological innovation and to the transfer and dissemination of technology”**. To the **mutual advantage** of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations (Article 7).

Although African States are under a legal obligation to enforce IPRs **under** international co-operation, it is questionable whether there is mutual advantage of producers and users of technology and a balance of rights and obligation.

One of the justifications of a Patent system is that it encourages technology transfer from developed to the developing countries. The agents for this transfer are multi-national corporations (MNCs). However MNCs objective is to maximise profits through the monopoly created by the patent whereas the host African nations object it to acquire advanced technology to enhance development. Once a MNC acquires a patent it can prevent other companies from making identical products or processes in that country. If the product or process is insufficiently exploited, which is usually the case, the country is prohibited by its own IP system for enjoying the benefit of that technology. MNCs usually obtain patents to protect their markets in African States and these countries are bound by the TRIPS Agreement to enforce them. This reflects a conflict between social and economic welfare of African States and the balance of right and obligations under TRIPS Agreement.

This conflict is further reflected in the incident in South Africa where pharmaceutical companies that own patents for AIDS treatment drugs sought protection and enforcement of their IPRs against the use of generic. Their drugs were too expensive for the ordinary South African in numbers but were now being saved through the affordable generic drugs. The country was faced with a legal and social obligation of enforcing IPRs at the expense of sacrificing its population to the scourge of the AIDS pandemic.

Therefore, in considering the legal obligation of African States in international cooperation in IP, the question to be asked is, where there is a conflict between a legal obligation and a moral obligation should these countries direct their scarce resources to the protection and enforcement of IPRs at the expense of the social and economic welfare of its citizens?

However, under TRIPS Agreement a developing country is entitled to delay for 4 years the application of the provisions of the Agreement and the Least Developed Country to delay for a period of 10 years. These period are inadequate considering the extent of their economic, financial and administrative constraints. It is for these reasons that the level of participation in international cooperation has not reached satisfactory levels.

Recognising the importance of International Cooperation the TRIPS Agreement provides that; **“In order to facilitate implementation of this Agreement, developed country members shall provide, on request and on mutually agreed term and condition technical and financial cooperation in favour of developing and least developed country members”.** (Article 67)

But what is seen on the ground is more demand for protection and enforcement of IPRs from the developing and least developed countries and less of the technical and financial cooperation. African Countries are required to comply with TRIPS Agreement but there is a conflict with their other obligations. It is not enough to put a burden on third world countries without adequate provisions to take into account their special circumstances.

## CONCLUSION

In order for African countries to attract the much need technology for development, it is vital that the IP regimes in their respective countries should provide for a high level of protection required by the TRIPS Agreement. The majority of African countries are working towards that goal. Most of the IP Legislation in Africa is under consideration by the authorities, so as to ensure that by the year 1<sup>st</sup> January, 2006 it is TRIPS compliance.

However, the African countries are faced with adverse effects of high foreign debt repayment obligations, the HIV/AIDS pandemic, high levels of poverty, lack of clean water, decent shelter, the majority of school going age children are out of school systems, the health facilities in general are not available to the poor people, these and many pressing issues.

The African governments find themselves in a very difficult situation, whether they should put their meager resources into improving their IP regimes in order to provide high levels of protection of IPRs or channel these resources to social obligations as responsible governments. The need to find ways and means of ensuring that IP benefits, the poor cannot be achieved without the cooperation of the Developed World and International Community in general.

It is not fair to expect Developing and Least Developing countries to meet their part of the obligation and yet the Developed Countries` whose IPRs is being protected continue to pay lip service.

At the recent meeting of the World Bank and International Monetary Fund, the British Minister of Finance Mr. Gordon Brown is reported in the Economist of 24<sup>th</sup> –30<sup>th</sup> November, 2001 to the effect that: **“Too little is done for more than one billion people who scrape by less than a dollar a day”**.

Therefore, the onus is on the Developed Countries and IPRs owners to make a contribution to poor people. As the saying goes Developed Countries and their industries must put real money where their mouths are.

## *ANNEX ONE*

### **THE REPORT OF THE MISSION TO ASMARA, ERITREA FROM 17<sup>TH</sup> APRIL TO 17<sup>TH</sup> MAY, 2000 BY ANDERSON R. ZIKONDA, WIPO EXPERT.**

#### **MANDATE**

The mandate of the Mission is to assess how best the World Intellectual Property Organisation (WIPO) would assist the State of Eritrea in establishing an Industrial Property Office. The Mission was tasked to:-

- “ (i) Assess the current situation;
- (ii) discuss the draft industrial property law sent to government by WIPO and provide explanations, where necessary;
- (iii) discuss possible work procedures and develop a training programme;
- (iv) assess possible equipment, documentation and human resources needs;
- (v) provide information on treaties in the intellectual property field; and
- (vi) advise the government authorities on administrative and organisational policies to be adopted in the implementation of the legislation and obligation arising from membership of international conventions.”

#### **INTRODUCTION**

##### **Background**

The State of Eritrea attained its Liberation and Independence on 24<sup>th</sup> May, 1991 and 24<sup>th</sup> May, 1993 respectively. Prior to independence the State of Eritrea was under the Italian and British rule from 1809 to 1950. From 1950 to 1960 it was a federation of Ethiopia and Eritrea. The state of Eritrea was engaged in an armed struggle for its independence against the rule of the regimes of Haile Selassie and Mengistu Haile Mariam from 1961 to 1991.

There is no evidence to indicate that an industrial property office ever existed during the period referred to above. It would appear that the State of Eritrea was treated as a province of Ethiopia. With this background, the state of Eritrea deserve a special treatment and assistance from WIPO to enable this young nation to establish an industrial property office.

#### **1. CURRENT SITUATION**

##### *INTELLECTUALL PROPERTY*

The State of Eritrea has some intellectual property legislation contained in the Commercial Code, Civil Code and Penal Code. These Codes were proclaimed by Ethiopia in 1957 and 1960 and the State of Eritrea adopted these Codes on transitional basis and certain provision of these Codes were not adopted.

The State of Eritrea does not have an industrial property office, however, there is one officer who attends to industrial property matters. The officer is designated as Director of Domestic Trade.

During the meeting with the Honourable Minister of Trade and Industry, the Mission emphasised the importance and the urgent need for the State of Eritrea to enact industrial property legislation

and the establishment of an industrial property office. The Mission informed the Honourable Minister the important role an IP office can play in the transfer of technology for development.

*Page 2*

## **2. THE WIPO DRAFT INDUSTRIAL PROPERT LAW OF 1995**

In 1995, at the request of the State of Eritrea, WIPO prepared a draft Industrial Property Law for the consideration by the government of the State of Eritrea.

The Mission discussed the draft law with the following:-

- (a) The Honourable Minister of Trade and Industry;
- (b) The Director General of the Department of Trade, Ministry of Trade and Industry;
- (c) The Director of Domestic Trade, Ministry of Trade and Industry;
- (d) The Director General of the Department of Legal Services, Ministry of Justice;
- (e) The President of the High Court (Chief Justice);
- (f) The Attorney General;
- (g) The Director of the Law Programme (Dean School of Law);
- (h) Dr. Yohannes Berhane, Former Vice President of High Court, Now Practising Advocate and legal consultant;
- (i) Mr. Berhane Gila- Michael, Intellectual Property Lawyer;
- (j) The Legal Advisor, Ministry of Trade and Industry; and
- (k) Mr. Kebreab Habte Michel, Legal Practitioner;

The Honourable Minister expressed his gratitude and appreciation to the Director General of WIPO, Dr. Kamil Idris for sending the mission. He assured the Mission that the Government of the State of Eritrea was committed to ensure that the question of putting in place of the intellectual property regime would receive his government's attention, even though the State of Eritrea is at war. He assured the Mission to feel free to call on him. He informed the Mission that the details of the draft should be discussed with the Legal Advisor in his Ministry and the Director General of the Department of Legal Services, in the Ministry of Justice.

The draft Industrial Property Law was discussed with the Director General of Department of Legal Services with the Mission in company of the Legal Advisor of the Ministry of Trade and Industry. The Director General of the Department of Legal Services was of the opinion that since the draft was prepared in 1995, a new draft should be prepared taking into account the new developments in this field since 1995. The Mission assured him that the draft as it stands was in order, however that his wishes would be looked into, and if necessary WIPO would update the draft. The Director General of Department of Legal Services informed the Mission that a decision has already been

made by Government that an IP Legislation would not be part of the Civil Codes as was previously, but that a separate proclamation would be made to accommodate IP matters.

*Page 3*

The President of the High Court was supportive of a new IP proclamation which will address the **lacuna** in the present legislation. He expressed concern, in particular to lack of adequate provisions relating to Copyright. He pointed out that there are a number of people who do not have respect for other people's work, e.g. some individuals they sell in their bookshops books that are copies made on photocopies. The Mission visited a number of Bookshops and found evidence supporting the information given by the President of the High Court. Upon questioning the bookshop attendant the Mission was informed that these books were photocopied in India. The Mission discussed the draft in great detail with the Legal Advisor in the Ministry of Trade of Trade and Industry as suggested by the Honourable Minister of Trade and Industry and explanations were given. Infact all provisions of all the draft IP Law were explained.

The Director of the Law Programme welcomed the Mission and informed it that the Law School taught Intellectual Property as an elective course. He said that at the moment it was not being taught since Dr. Yohannes Berhane stop teaching the course. He however expressed gratitude to WIPO for provision of some IP WIPO publications.

The Attorney General was briefed by the Mission regarding the draft industrial property law and he took note of the draft. He however informed the Mission that with regard to the set up, the Attorney General's function were mainly Criminal and Civil, and that the drafting of legislation is done by the Director General of the Department of Legal Services in the Ministry of Justice. He pointed out that he sits on the Codification Commission. This is Commission which discuss all legislation to be proclaimed. He was also supportive of the proclamation of a new IP Law.

A number of Legal Practitioners involved in intellectual property welcomed the move by government to update the IP Laws and the initiative to establish an industrial property office.

They contended that the IP Laws now in place contained in the Commercial Code, Civil Code and Penal Code were inadequate and needed to be replaced with new modern IP Law.

The Majority of the people the Mission came into contact were of the opinion that it was about time that the government should review the present IP and replace it with modern law. The Mission observed that due to lack of adequate IP law, most shops sold goods which were:-

- (i) bearing imitated trademarks such a Adidas, Nike, Calvin Klein, Pierre Cardine, Lacoste, Christian Dior etc;
- (ii) goods having similar marks such as Adibas, (original mark being Adidas);
- (iii) entire books were copied such as:- Lee lacocca, Daniel Steel, Positive imaging, Irving Wallace.

The Mission emphasised the importance of enacting new IP laws to the Honourable Minister of Trade and Industry, the Director General of Trade, Ministry of Trade and Industry and the Director General of Legal Services, Ministry of Justice.

The Director General of Trade suggested to the Mission that a half day seminar be conducted to which business community who are members of the Chamber of Commerce and other interested parties in IP matters be invited. The Mission agreed to the suggestion and a half-day seminar was held at which Mission discussed the following topics:-

- (i) Intellectual Property in general – Definition and Interpretation.
- (ii) Examination of IP in Eritrea – Commercial Code, Civil Code and Penal Code.
- (iii) Paris Convention – Patents, Trade marks and unfair Competition.
- (iv) Berne Convention – Copyright and neighboring rights (related rights).
- (v) Patent Co-operation Treaty (PCT).
- (vi) The World Trade Organisation (WTO) (TRIPS Agreement).
- (vii) Advantages of enacting new IP Law and need for establishment of an IP Office.

### **3. WORK PROCEDURE AND TRAINING PROGRAMME**

#### **(i) WORK PROCEDURE**

It is not possible to develop work procedure at the moment as there is no IP office and the current IP legislation is silent on registration of Patents, Trademarks or Industrial designs. The Provisions contained in the Commercial Code, Civil Code and Penal Code are not sufficient to enable the development of work procedure.

The work procedure would only be devised and developed after the IP law has been enacted and the Regulations to implement the IP law have been promulgated. The Regulations for implementation of the IP law will in great detail lay down procedures to be adopted in the administration of the Industrial Property Law. The Regulations will be supplemented by Forms to be used in the application for various IP rights.

At the moment it is premature to draw working procedures, as these will be guided by the IP law once enacted.

#### **(ii) TRAINING PROGRAMME**

It is imported at the outset to ensure that training of IP staff is embarked upon, even though the IP law and IP office is not in place. Suitable officers with necessary educational background should be identified in order for them to undergo training in IP matters.

The Training should encompass:-

- (a) Attachment to IP office (s) for one to two months;
- (b) Attendance of IP introductory courses conducted by WIPO, IP offices and other international IP organisations;
- (c) Study tours, especially for the Head of the IP office, as this will provide an opportunity to learn how other IP office operate; and
- (d) When the IP office is established, on-job-training will be necessary.

The on-job-training will require that an expert who has worked in an IP office is attached to the office to assist the Head in training staff in the administration of the office. The attachment could be for a period of one to two months in the initial stage and then a follow up after some period.

#### **4. ASSESSMENT OF REQUIRED EQUIPMENT, DOCUMENTATION AND HUMAN RESOURCES.**

##### **(i) EQUIPMENT**

The IP office when established will require some Equipment such as Computer with scanner, photocopier, fax, office furniture (Desk, Chairs, Filing Cabinets etc). In other words there is no equipment at the moment as the IP office is not in existence.

##### **(ii) DOCUMENTATION**

There is no IP documentation, except for a few WIPO Convention such as Paris Convention, Patent Cooperation Treaty, Berne Convention and Copyright Treaty. Therefore when the office is establish there is a need to have the necessary IP literature and documentation for use by the staff and the public at large.

It is important that in order for the office to function efficiently when established, it is necessary to have adequate equipment and documentation. At the moment, it appears that this young Nation can not manage to finance the purchase of equipment and documentation. In this respect it is strongly recommended that WIPO should if possible assist in the purchase of these equipment and IP literature.

##### **(iii) HUMAN RESOURCES**

The officer who deals with IP issues in the Ministry of Trade and Industry is the Director of Domestic Trade. Therefore there is no staff currently trained in IP matters. It is envisaged that when the office is established should have the following skeleton staff, (see the Annex 1):-

- (a) 1 Director – Head of the Office

- (b) 1 Head of IP Unit – this officer will report to the Director (Head of office) and will be in charge of Patents, Trademarks and Designs matters. Under him or her will be:-
  - (1) 1 Patents Trademarks and Designs officer;
  - (2) 1 Examiner – he or she will perform the functions of an Examiner as to formalities;
  - (3) 1 Documentation and Search Clerk; and
  - (4) 1 Computer operator/Data capture.
  
- (c) 1 Head of Administration and Finance Unit – He or She will report to the Director (Head of office) will be in charge of administration and finance matters. Under him or her will be:-
  - (1) 1 Accounts clerk – he or she will deal with accounts and ensure that the money is banked;
  - (2) 1 Cashier – will receive all payments due to the office and hand it to accounts clerk for banking; and
  - (3) Computer operator.

The identification of the staff and training programme should be undertaken as soon as the new IP legislation is put in place. The training should start as soon as government decides to enact the IP law. The kind of training programme recommended is the one outlined in paragraph 3 (iii) above.

## 5. WIPO TREATIES IN INTELLECTUAL PROPERTY FIELD

### (i) THE PARIS CONVENTION

The Mission explained to the Director General of Legal Services in the Ministry of Justice and the Legal Advisor in the Ministry of Trade and Industry, the importance of this Convention, as being the cornerstone of industrial property. The Articles dealing with issues such as “National Treatment, Unfair Competition, Well-known Marks” were explained in greater detail”. The Mission urged the government to consider joining the Paris Convention, as this would bring advantages to its nationals. The Mission pointed out to the officers that since the state of Eritrea is a party to the World Intellectual Property Organisation (WIPO), it may become a party to the Paris Convention without any further financial obligations. The contribution made to WIPO suffices.

(ii) **THE BERNE CONVENTION**

The Mission explained to the Government officials i.e. the Director General of Trade and Industry and Director General of the Department Legal Services, Ministry of Justice that the Berne Convention is the basic Convention which deals with matters related to Copyright and Neighbouring rights. It is the Cornerstone of literary and artistic works, and that it is advantageous for the State of Eritrea to become a party as this would enable the nationals to enjoy and protect their rights in members States party to the Convention.

The Mission also informed the government the advantages the State of Eritrea would benefit being a party to the Patent Cooperation Treaty (PCT) and the Trademark Law (TLT). During the half-day seminar the Mission took advantage and explained in detail the benefits which would be accrued, if the State of Eritrea was a party to the Convention mentioned above.

**5. ADVICE TO GOVERNMENT ON ADMINISTRATIVE AND ORGANISATIONAL POLICES TO BE ADOPTED IN THE IMPLEMENTATION OF LEGISLATION AND OBLIGATIONS ARISING FROM MEMBERSHIP OF INTERNATIONAL CONVENTIONS.**

The Mission informed the government that IP offices are mainly placed under the portfolios of the Ministry of Trade and Industry or Ministry of Justice or Ministry of Science and Technology or Ministry of Education or Ministry of information. In most countries the decision as which Ministry is charged with the portfolio of IP office is made by the Head of State in consultation with the Cabinet.

In Eritrea the situation is that industrial property matters are under the Ministry of Trade and Industry and whereas the copyright and neighbouring rights fall under the Ministry of Education. The Mission advised the government that it was important to ensure that the new IP Legislation is enacted or proclaimed. Once the new IP Law is put in place, then the necessary regulation for the implementation of the law would be promulgated and this would lead to the establishment of an IP office.

Immediately or just before the new IP law is enacted the State of Eritrea should consider joining the Paris Convention and Berne Convention. These Conventions are the most important in the field of Intellectual Property and are a cornerstone to IP matters. The obligations under these two Conventions were explained to government. The Mission however pointed out that there are no financial obligations, in view of the fact that the State of Eritrea is a member of WIPO.

**6. RECOMMENDATIONS**

- (i) The assessment of the current situation is that a new IP Law is a must in order to replace the present law contained in Commercial Code, Civil Code and Penal Code, which laws were proclaimed in 1957 and 1960 by the Ethiopian Government and does not meet the current trends, as the law is absolute due to the development of IP laws in recent years.

- (ii) The draft Industrial Property Law was discussed with all interested parties. The Director General of Legal Services requested that the draft be up dated and that translation in Tigrigna (local language) and Arabic be provided by WIPO. In view of the current situation in Eritrea, it is necessary that WIPO do consider to provide some financial support for the translation in Tigrigna. Also funds being available it would be necessary to invite the Director General of Legal Services, in the Ministry of Justice and the Legal Advisor in the Ministry of Trade and Industry to Geneva to discuss further the draft.
- (iii) The work procedure can only be addressed when the new IP Legislation has been enacted and the Regulations promulgated. As no work procedure could be worked out in the absence of the law.

The training programme should be embarked upon, this will include:-

- (1) Identification of suitable staff and attachment to other IP offices for a period of one to two months;
  - (2) Attendance of IP introductory course conducted by WIPO and other agencies or IP offices;
  - (3) Study tours, especially for the designated Head of IP office; and
  - (4) On-job-training to be conducted by an expert when the office is finally established. This is important to ensure that a good start is made and work procedures are complied with. This should be done by someone who has work experience in an IP office.
- (iv) Eritrea is in the state war and it is unlikely that it has funds for purchase of equipment and documentation, and therefore it will need the financial and material support from WIPO to purchase the necessary equipment required for an IP office.
  - (v) The information regarding treaties in the intellectual property field were given to various officials during the Mission. However, the Mission is of the considered opinion that a national seminar should be organised to sensitize the public thereby creating awareness of industrial property in the country.
  - (vi) Eritrea should be considered as a special case and it therefore requires special treatment. It is a young nation which has experienced **no peace** for the last 30years. Its development has been hampered by this long drawn war. It has nothing on the ground in terms of IP infrastructure and it needs to catch-up with other developing countries. Therefore financial and material assistance from WIPO would help greatly. The Mission recommends that the Director General, Dr. Kamil Idris gives his favourable consideration to the request of this young nation.

***ANNEX 1***

**MINISTRY OF TRADE AND INDUSTRY  
DEPARTMENT OF TRADE  
DIRECTOR GENERAL**

**DIRECTOR**

**HEAD OF IP UNIT (1)**

**HEAD OF ADMINISTRATION  
AND FINANCE (1)**

**PATENTS, TRADEMARKS  
& DESIGNS OFFICER (1)**

**EXAMINER (1)**

**ACCOUNTS CLERK (1)**

**CASHER**

**DOCUMENTATION AND SEARCH CLERK (1)**

**COMPUTER OPERATOR (1)**

**COMPUTER OPERATOR**

## *ANNEX TWO*

### **THE REPORT OF THE MISSION OF THE BUREAU OF ARCHIVES, PATENTS, TRADEMARKS AND COPYRIGHT OF REPUBLIC OF LIBERIA UNDERTAKEN BY ANDERSON R. ZIKONDA, WIPO EXPERT.**

#### **INTRODUCTION**

This Report is a summary and brief account of the situation of Industrial Property Office of Liberia. The Bureau of Archives, Patents, Trademarks and Copyright is a Division in the Ministry of Foreign Affairs. It also deals with issues such as one's pertaining to incorporation (incorporated Companies) and Land, for example Title Deeds. The Division is headed by a Director with a support staff of 12 Officers. Among them only three deal with matters related to industrial property. They are : One Assistant Director, One Research Assistant and One Trademark Officer.

#### **2. CURRENT LEGISLATION**

- (a) The Industrial Property Law which regulates Patent and Trademarks was enacted in 1972 and is therefore not suitable for the present time. This Legislation is known as **TITLE 24** and deals with Patents, Copyright and Trademarks.  
**S.1.1 of this statute states that "Any person who discovers or Invents any new and useful art, machines, manufacture, process or composition of matter or any new and useful improvement therein or any new and useful application of any known substance, machine, matter, composition of matter, article of manufacture, device or apparatus, or any person who is the legal owner of any such invention or discovery, may apply in writing to the Secretary of State for the issuance of the Patent thereof."**  
  
It can be seen from the quotation above that the law does not comply with the current situation in terms of what constitutes an invention.
- (b) As regards the definition of the trademark, Section 3.1 of the statute state as follows:  
**"S.3.1 A trademark is a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they have been manufactured, selected, certified, dealt with or offered for sale by the proprietor of the trademark. Trademarks used in connection with all classes of goods or products of industry, agriculture or commerce may be registered."**  
It would appear therefore , that this definition of a trademark does not represent the current position or interpretation.
- (c) There is an urgent need for Liberia to enact a new Industrial Property Legislation which will take into account the new development in this field. WIPO had in 1994 prepared a draft Legislation for Liberia, which has not been acted upon.
- (d) In this connection, I recommended to the Minister that he gives his approval for the preparation of the WIPO draft Industrial Property Law into a draft bill for consideration of Cabinet and enactment by the Senate and House of Representatives. The recommendation was approved by the Minister and the WIPO DRAFT is being used as a basis for new Liberian Industrial Property Legislation.

#### **3. CURRENT PROCEDURE FOR GRANT OF PATENTS AND REGISTRATION OF TRADEMARKS**

- (a) There are no prescribed forms for a request for a grant of patent or an application for registration of a mark. The Legal Practitioner merely writes a letter to the Minister of Foreign Affairs. Such as one reproduced hereunder:

“The Honourable , The Minister of Foreign Affairs ”  
Ministry of Foreign Affairs  
Monrovia, Liberia

Application for Registration of Letters Patent in Liberia

**TITLE OF INVENTION: SUBSTITUTED BENZENESUFONAMIDE DERIVATIVES AS PRODRUGS OF COX-2 INHIBITORS**

I, Philip J.L. Brumskine, Counsellor - At Law, hereby make application for and on behalf of G.D. Sarle and Company, a Corporation Organised and existing under the Law of State of Delaware, USA and having its Executive Office at 5200 old Orchard Road, Skoie, Illinois 60077, USA, in connection with the registration of invention for “**SUBSTITUTED BENZENESULFONAMIDE DERIVATIVES AS PRODRUGS OF COX-2 INHIBITOR**”, as set forth in the annexed claims and specifications:

“Said Invention is in the field of antiinflammatory pharmaceutical agent and specifically relates to prodrugs of compounds which selectively inhibit cyclooxygenase-2”

To expedite issuance of the LETTERS PATENT in respect of the above invention, I enclose original copy of oath of Inventors as well as copy of joint assignment and power of Attorney, claims and specification, as well as Bureau of Revenue Receipt for \$75.00.

Respectfully Submitted,  
G.D. SEARLE & CO.,  
Petitioner, By and through their Counsel;

Signed: Philip J.L. Brumskine  
Counsellor - At - Law.”

- (b) The same format of the letter above is also used when applying for trademarks. When the Act was enacted in 1972, no Regulations for the implementation of the Act were promulgated.
- (c) There are no standard forms used in applying for the grant or registration of a trademark. The letter reproduced above is the only format used for applying for a grant of patent or Registration of a mark. This does not conform with the current practices prevailing in many Industrial Property Offices. There is an urgent need for introduction of forms to be used when applying for industrial property rights.
- (d) There is no filing system currently in use and applications for grant of Patents and registration of trademarks are put on a rack, as there are no filing cabinets.
- (e) There is no coherent numbering system, numbers are given to legal practitioners at random in advance before the submission of applications for grant of patents or registration of marks. The numbers are just given at random and some times the numbers given are misplaced by the Legal Practitioner concerned and the Office does not have a record.
- (f) When a legal practitioner comes to the Office he requests to be given numbers for his use when applying for a grant of patent or registration of the mark. For example one Legal practitioner may be given say 10 numbers i.e. numbers ranging from 985 - 905. This will entail that whenever this legal practitioners submits an application for a grant of patent or registration of the mark he or she can type a Certificate of registration of a mark or letters patent and use say 985, which he or she would number as 98/985. This is irrespective whether the mark or patent has been registered or granted. As a result of this system the numbering in the Register is not coherent.

4. **REGISTER OF PATENT AND TRADEMARKS**

- (a) One Register is used to record patents and trademarks. The trademarks are not examined for similar marks as they are registered as soon as they are received in the Office. The Certificate for Registration of a mark is prepared by the Legal practitioner and submitted to the Office for signature by the Minister of Foreign Affairs or his deputy. The Director of the Archives, Patents, Trademarks and Copyright does not sign the Certificates.
- (b) This kind of practice does not operate well for the Office, the Minister should not be involved in the day to day running of the administration of the Office. The administration of the Office should be in the hands of the Directors of the Archives, Patents, Trademarks and Copyrights.
- (c) The numbering in the Register is not consecutive, it is done at random. For example, on One page the numbering would appear as 98/1998 and the next would be 58/1998. The first number would refer to a grant of patent and the second would refer to a registration of a trademark.
- (e) This kind of numbering is obviously incoherent and confusing. The Office requires to maintain two Registers one to record patents and another to record trademarks. The numbering should be consecutive, based on an application lodged first to the Office. The current practice is that the numbers are given to legal practitioners at random and in advance before the application is submitted to the Office. Some of these numbers given to the Legal Practitioners are not used and this creates a problem of not having consecutive numbers.

5. **INDUSTRIAL PROPERTY STATISTICS FROM 1993 - 1998**

- (a) The Trademarks registered and renewed and the Patent granted during the period from 1993 to 1998 are detailed hereunder:-

**TRADEMARKS**

<b>YEAR</b>	<b>NO. OF REGISTRATION</b>	<b>NO. OF RENEWAL</b>
1993	164	305
1994	186	230
1995	147	253
1996	134	152
1997	235	163
1998	150	248

**PATENTS**

<b>YEAR</b>	<b>NO. OF GRANTS</b>
1993	15
1994	10
1995	12
1996	10
1997	11
1998	10

- (b) The fees for registration and renewal of Trademarks, Service Marks are as follows:-
  - (i) Registration of Trade marks (Liberian Dollars ) LD26.00 (which is at the current rate 0.50 US\$);
  - (ii) Renewal of Trademarks for a period of LD 10;  
The fee for the grant of a patent is LD 75 (1.20 US\$) for the entire life period (i.e. 20 years). This fee is ridiculously on the low side.
- (c) There is certainly a need to revise the fee upward for the services provided by the Bureau. In this regard the Bureau will be able to generate enough revenue for Government and its operations.

#### 6. **CURRENT STAFF MANNING THE OFFICE**

- (a) The Bureau is manned by the Director, Deputy Director, Assistant Director and Three Clerical Staff. The Director and the Assistant Director have had some training in the filed of Industrial Property. The other members of staff do not have any experience in Industrial Property matters.
- (b) The Staff presently on board is adequate to Mann the Office provided they are given an opportunity to train in industrial property matters. This will entail that once the staff has been given necessary training, they should be retained in the Office.
- (c) The Staff has no basic knowledge in procedures regarding Industrial property matters, such as the processing of Patent or trademark application.

#### 7. **CURRENT SITUATION REGARDING OFFICE ACCOMMODATION AND EQUIPMENT**

- (a) The Bureau is accommodated in one large room on the ground floor of the temporary building being used by the Ministry of Foreign Affairs. The Office accommodation is unsuitable and inadequate.
- (b) There are no Office furniture and equipment. There are no files for patent and trademark applications and documents. The documents and applications are piled on the old shelves used for storing the Title Deeds (Land Titles).
- (c) There are no filing cabinets, no index card, no rotary stands etc.
- (d) The Office equipment is essential for the smooth running of an Industrial Property Office. At present, the Office is registering trademark applications not examined. The reason being that there is no system and equipment which could enable the Office to carryout such an examination.
- (e) There is an urgent need therefore to ensure that a system for processing of patents and trademark application is established upon promulgation of the new Industrial Property Legislation.
- (f) The Ministry of Foreign Affairs will be moving to its original building, where the Bureau is expected to have sufficient Office accommodation. This would be the appropriate time to introduce a good system of management of the Industrial Property Office.

#### 8. **TRAINING GIVEN TO STAFF IN INDUSTRIAL PROPERTY**

The staff were trained in the following:-

- (a) Procedure in the processing of the Patents and Trademarks applications in accordance with current Law, Title 24
- (b) General Interpretation of the Industrial Property Act, Title 24.
- (c) General concept of Industrial Property i.e. Patents, Trademarks, Industrial Design, Acts of unfair competition and Copyright.
- (d) The training of I P issues and procedures were given to the following:-

Mr. James W. Mayson, Director, Mr. Jackson K. Purser, Deputy Director, Mr. Briama Dawon, Assistant Director of Patents and Trademarks, Mr. Robert Mezzel, Research Assistant, Mr. Morris Kollie, Trademark Officer and Mrs. Rosetta Carbah, Trademark Officer.

- (e) The training regarding the procedure in the processing of the patents and trademarks applications was based on the current law in force, with regards to applications it entailed the following:-
- (i) **The handling of the applications in the Office, date stamping the applications, the allocations of the application numbers, the examination of the applications with regard to formalities i.e. to ensure that all necessary documents accompanying the applications and to check whether the correct fees have been paid.**
  - (ii) **In the case of trademarks, to ensure that the applications comply with S.3.3 of the Act, Title 24. which requires that the application should contain the following information :-**
    - “(a) a description of the mark;
    - (b) a drawing of the mark
    - (c) a declaration setting forth the goods or services to which it is intended
    - (d) to affix the mark and the mode or manner in which the mark is used or proposed to be used in connection with such goods or services;
    - (e) the date of the applicant’s first use of the mark;
    - the date of the applicant’s first use or proposed use of the mark in industry, agriculture or commerce;
    - (g) an oath ..... ”
  - (iii) **The procedure on substantive examination of a trademark was explained to the Officials, including things an examiner looks for in order to ensure that the mark is registered in accordance with S.3.4, which prohibits the registration of similar marks, deceptive , immoral or scandalous only to name a few.**
  - (iv) **In short, the procedure regarding the processing of a trademark from time of receipt of the application to the time of issuance of the Certificate of Registration was explained in detail.**
  - (v) **As regards to the processing of the Patent applications, the procedure was explained in details with regard to checking of it’s compliance with formal requirements in accordance with S.1.2 of the Act, TITLE 24.**
- (f) Lectures regarding the general interpretation of the Industrial Property Act, TITLE 24 were given to the staff. The Act was discussed in great detail. The requirements of the Act were expanded. All the sections contained in the Act were discussed and explained.

The Act contain the following provisions:-

***“Chapter 1 Patents***

- S.1.1 Application for Patent.
- S.1.2 Contents of application.
- S.1.3 Conditions for issuance of Patent; novelty and loss of right to patent.
- S.1.4 Foreign patent reciprocity; method of obtaining earlier filing date priority right.
- S.1.5 Fee for filing application for patent.
- S.1.6 Contents and terms of letter patent
- S.1.7 Recording of patents and filing of copies thereof with secretary.
- S.1.8 Assignment of patents.
- S.1.9 Abandonment of patent by alien because of non-use.
- S.1.10 Lawsuits relating to patents.
- S.1.11 Use of patents by Government.

## *Chapter 2. Copyrights*

### **S.2.1 Definitions**

**S.2.2 Copyright application filed with Secretary of State.**

**S.2.3 Requirements of Copyright application.**

**S.2.4 Issuance of Certificate of copyright; fee.**

**S.2.5 Copyright notice to be affixed to work.**

**S.2.6 Publication of Copyrights granted.**

**S.2.7 Effect of copyright.**

**S.2.8 Limitations on Copyright.**

**S.2.9 Transfer of copyright.**

**S.2.10 Penalty for publication or plagiarising of Copyright work.**

**S.2.11 Works protected by Universal Copyright convention.**

**S.2.12 Publishers to furnish information service with copies of books printed in Liberia.”**

## *Chapter 3 Trademarks and Service Marks*

### **S.3.1 Trademarks; definition**

**S.3.2 Service Marks registrable; definition.**

**S.3.3 Application for registration of trademark or service mark.**

**S.3.4 Standards for refusing registration of mark.**

**S.3.5 Advertisement of accepted application.**

**S.3.6 Publication of granting of registration.**

**S.3.7 Registration of trademarks and service marks.**

**S.3.8 Permitted amendments of registered trade marks.**

**S.3.9 Duration and effect of registration renewals**

**S.3.10 Assignments of registered marks.**

**S.3.11 Fees.”**

- (c) The Act, Title 24 was enacted in 1972 and no implementing regulations were promulgated. When applying for a grant of patent or registration of a trademark, the applicant only writes a letter to the Minister of Foreign Affairs to which I have already referred to in paragraph 3 above. There are no official application forms. In this regard, the Director of the Office (Mr. J.W. Mayson) requested me to design forms to be used in Patents and trademarks matters, the designed forms are attached to this Report as **ANNEX 1**.
- (d) Lectures were also conducted regarding the general concept of intellectual property. Some of the issues discussed in the lectures included the following:-
- (i) **The general principle of patent law, what constitutes patentable inventions, novelty, inventive step and industrial applicable;**
  - (ii) **Priority and National Treatment under the Paris convention;**
  - (iii) **Definition of trademarks, service marks and collective marks, Priority and National treatment under Paris Convention;**
  - (iv) **Copyright-definition - what is copyrightable, fair use, National treatment under the Berne Convention and TRIPS Agreement.**
  - (v) **Nice Agreement and Patent Co-operation Treaty (PCT) were discussed briefly in relation to marks and patents respectively.**

## **9. LEGAL ADVICE**

- (a) Legal Advice was given to the Government of republic of Liberia in relation to intellectual property, such as the need for Liberia to enact a new I P law which will be in conformity with the conventions recently entered into, namely Convention Establishing WIPO, the Paris Convention, the Berne Convention, the Madrid Agreement and the Patent Co-operation Treaty (PCT).

- (b) The Government accepted my recommendation for introduction of a new Industrial Property Act and the Minister responsible authorised the preparations and presentation of the new IP Act.
- (c) The new draft of the I P Law is based on WIPO 1994 draft for Liberia and the fine copy of the draft is attached as **ANNEX 2**. The Honourable Minister has assured me that he will be seeking Cabinet approval in due course and thereafter submit the draft law for enactment by the Senate and House of Representatives.

10. **PROGRESS MADE AND PROBLEMS ENCOUNTERED**

- (a) A good achievement was made in streamlining the procedures regarding patents and Trademarks. The Staff were trained how to use the forms and the procedure to be followed when processing the patents and trademarks applications.
- (b) A new Trademark Register was designed and a book to be used as a Register was procured as a first step measure. The Legal practitioners were introduced to the new procedure and explanation was given. A new acceptance Form for trademarks was designed and is in use.
- (c) The progress made was limited to matters that could be done within the context of the present Law, namely **TITLE 24**. The procedures designed were those that are allowable within the said Law. The Office procedures have been streamlined, but more needs to be done, when the new Law comes into operation.
- (d) Liberia, has undergone seven years of civil war. All necessary equipment which one would normally find in a Patent Office is not available. There are no Registers, Cabinet files, no desks for officers and no stationery available, except the goodwill of the Officers. Some Officers have not been paid for last three months. This puts a lot of stress on them.
- (e) This situation makes it difficult to train staff as they have to get other jobs in order for them to survive. However I must point out that despite all these constraints, the staff were very keen to learn and to adapt the new skills.
- (f) The Bureau of Archives, Trademarks, Patents, and Copyright does not have a budget of its own. It depends on the grace of the Ministry to supply to it consumable stationery and most of the time, the stationery was not provided due to lack of funds. For instance the Bureau does not have a Secretary and this made my work difficult and targets were not achieved on time.
- (g) There is a dire need for assistance to be given to Liberia in order for it to improve the Office and meet its obligation under the various conventions to which she is a party.
- (h) The assistance needed will be in the form of:-
  - (i) Training of human Resources to man the Office;
  - (ii) Office furniture;
  - (iii) Office equipment such as Computers, Photo Copier, Cabinet files, Registers, Cards for use for keeping trademarks and Patents information.
- (i) The Government of Liberia has no resources to finance the above in view of the fact that, there are more pressing needs such as Education, Health, Housing etc. which the Government must address as matter of urgency.
- (j) In other words in order to upgrade the Liberian Patent Office, there is an urgent need to assist the Office, as the Liberian Government is as of now not in a position due to financial constraints.
- (k) The major achievements of my assignment could be categorised as follows:-
  - (i) Training of Staff in Patents and Trademark procedures;
  - (ii) Streamlining of procedures and designing of Forms to be used in applying for Patents and Trademarks in accordance with **TITLE 24** of Archives, Patents, Trademarks and Copyright Act of 1972; and
  - (iii) The drafting of final copy of the 1994 WIPO draft on Industrial Property for Liberia.

11 **RECOMMENDATIONS**

- (a) I strongly recommend that the Government of Republic of Liberia needs the assistance of the World Intellectual Property Organisation (WIPO) in the following areas:-
- (i) Human Resources: It is important to note that for any office to function well it needs well trained Staff. In this respect the Director of the Office has submitted the names of the Officers to be trained to the Director General of WIPO a copy is attached as **ANNEX 3**.
  - (ii) The Director of the Office should be considered for a study tour to other Offices for him to see, how other offices operate. This study tour should certainly include the ARIPO Office.
  - (iii) Equipment, the Office is in die need for the equipment and Office furniture.
  - (iv) The Office does not have any books or any literature pertaining to intellectual Property. This is a necessity if good results are expected.
  - (v) There is an urgent need for a National Seminar in order to sensitise the Legal Practitioners and the general public.
  - (vi) A follow up Mission is necessary to ensure that the staff is implementing and carrying out the duties properly in accordance with the Law and International Practice.
- (b) The training should be both on job training in Liberia and outside Liberia. In this respect I submit that the list of names of staff communicated to Director General dated 8th March, 1999 be considered favourably for training at any one of the following Patents Offices:- Malawi, Zambia or Zimbabwe.
- (c) The reason being that the three Offices mentioned above have had a long experience in operating as independent Offices. I would recommend that each Officer be attached to one of the above mentioned Offices for a period of one month and this be followed with a supervision of two months in Liberia by a WIPO Expert when the new Act has been enacted.