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THE MADRID PROTOCOL

An analysis of the rationale regarding South Africa's possible accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

A Dissertation by
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SUMMARY

THE MADRID PROTOCOL

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DEPARTMENT : INTELLECTUAL PROPERTY/ BUSINESS LAW

DEGREE : LLM

DECLARATION

I, Mishayla Kercival declare that ...

- (i) The research reported in this dissertation, except where otherwise indicated, is my original work.
- (ii) This dissertation has not been submitted for any degree or examination at any other university.
- (iii) This dissertation does not contain other persons' data, pictures, graphs or other information, unless specifically acknowledged as being sourced from other persons
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 - a. Their words have been re-written but the general information attributed to them has been referenced;
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ABSTRACT

Where South Africa's accession to the Madrid Protocol has not been confirmed by any state entity or government, there are numerous legal practitioners and academics who have alluded to the possibility of South Africa acceding to the Madrid Protocol. The objective of this study is to analyse whether various perceived advantages and practical disadvantages of acceding to the Madrid Protocol, will amount to actual consequences in South Africa. This study will expand on the arguments made in support of South Africa's accession to the Madrid Protocol and will also give consideration to opposing perspectives. The purpose of this study is two-fold. Firstly, to establish whether filing a trade mark application, in terms of the Madrid Protocol, would result in effective protection of an international trade mark in South Africa. Secondly, to establish whether South African trade mark owners, who file trade mark applications in terms of the Madrid Protocol, would receive effective protection for their trade mark in foreign countries that are party to the Madrid Protocol.

The academic aim is to provide a synthesis of the advantages and disadvantages of acceding to the Madrid Protocol, in respect of a South African context. The strategic aim is to make recommendations to policy-makers on whether accession to the Madrid Protocol will provide effective protection for South African International trade mark owners in foreign countries that are party to the Madrid Protocol, as well as whether accession to the Madrid Protocol will result in effective protection of an international trade mark in South Africa. The legal problem area relates to the fact that should South Africa accede to the Madrid Protocol, enabling legislation will need to be enacted in order to ensure the legality of international trade marks in South Africa. The policy problem area relates to whether or not South Africa should actually accede to the Madrid Protocol or not, in light of potential practical consequences of accession. Overall, the study provides direction as to whether South Africa should accede to the Madrid Protocol – where the question of South Africa's accession to the Madrid Protocol assesses the positives and negatives, in a South African context, for both South Africans and foreign trade mark owners.

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CHAPTER 1: INTRODUCTION

1.1. BACKGROUND OF TRADE MARK PROTECTION

Before reaching an understanding of what this dissertation centres around, in terms of South Africa's relationship with international law and the meaning of an international trade mark, it is necessary to first set out a brief background of the foundational concepts that give structural integrity to the research at hand. Where intellectual property law is the area of law under which this research exists, the following definition of intellectual property explains what its laws govern. "Intellectual property is any creation of the mind that is capable of being protected by law from use by any other person, whether in terms of South African law or foreign law, and includes any rights in such creation".¹ It includes all outputs of creative endeavour in literary, artistic, scientific and engineering fields that can be legally protected against use by any other natural person or legal entity. The types of intellectual property can be divided into four main types, namely, copyrights, patents, trade marks and registered designs.² The research in this regard, will center around trade marks.

1.1.1. The Nature of Trade marks

"A trade mark is the badge or symbol that a producer of goods or a supplier of services uses in relation to his goods or services in order to inform the public that he is the source or provider of those goods or services".³ According to the World Intellectual Property Organisation (WIPO), "Trade marks strongly influence purchasing behaviour, as consumers make more careful decisions, often reverting to 'tried and trusted' brands". Therefore a trade mark, is a form of intellectual property which is an invaluable asset to any business.⁴ This assertion is further substantiated by the

¹ 'Intellectual Property' as defined in terms of the Intellectual Property Rights Act No. 51 of 2008 s1(c)

² D Bellangere *Intellectual Property* (unpublished lecture notes, University of KwaZulu-Natal, 2017)

³ O H Dean & A Dyer *Introduction to Intellectual Property Law* (2014) 79

⁴ C Jewell 'Trademarks: Valuable assets in a changing world' (2009) available at http://www.wipo.int/wipo_magazine/en/2009/04/article_0002.html, accessed on 8 May 2018

European Union Intellectual Property Office (EUIPO) which has stated that recent trends in intellectual property rights filings reveal a steady increase in the use of worldwide intellectual property rights.⁵

A trade mark owner strives to establish a trade mark that encapsulates “public goodwill, brand reputation, and consumer recognition”, to ensure that the product or service is distinguished from products or services of a similar nature in the market.⁶ This also prevents third parties from using a confusingly similar mark or sign, to gain any potential business that would have been attributable to the established mark.⁷ Where a “well-managed intellectual property portfolio is a source of competitive advantage for a business”, the circumvention of infringements in intellectual property rights and the general protection of trade marks, is vital to a country’s economy.⁸ Where the action of registering an international trade mark secures the global protection of a trade mark, it incentivizes other local entrepreneurs and companies to invest in their brand equity.⁹ This uplifts the national economy of a country through the increase in revenue from local businesses, which is a marker for countries that are evolving from the status of a developing countries.¹⁰ Moreover, economies of the world are becoming more interconnected with the growth of the online shopping market and the increase in international travel.¹¹ Therefore, trade is not limited to a specific country or regional jurisdictional area.¹² Companies, along with their associated trade mark, are constantly expanding into international territories and therefore the protection of trade marks on an international level are critical.¹³ Trade mark rights are jurisdictional by nature and are only granted territorial protection, on a country-by-country basis.

⁵ ‘Strategic Plan 2020’ (2018) available at https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/strategic_plan/strategic_plan_2020_en.pdf, accessed on 13 December 2018

⁶ K Won ‘Should I protect my Trade mark internationally?’ available at <https://www.cooleygo.com/should-i-protect-my-trade-mark-internationally/>, accessed on 8 May 2018

⁷ G de Rassenfosse ‘On the price elasticity of demand for trade marks’ 2018 SSRN. 2

⁸ P Ramsden *A Guide to Intellectual Property Law* (2011) 8

⁹ G de Rassenfosse ‘On the price elasticity of demand for trade marks’ 2018 SSRN. 2

¹⁰ R O’Leary ‘How Treaties and Technology Have Changed Intellectual Property Law’ (2016) 16 *J. Int’l Bus. & L.* 94

¹¹ S M O’Coin ‘Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries’ Economies’ (2011) 15 *Holy Cross J.L. & Pub. Pol’y* 269

¹² EE Izogo & C Jayawardhena ‘Online shopping experience in an emerging e-retailing market’ (2018) 12(2) *Journal of Research in Interactive Marketing* 194

¹³ D Bellangere *Intellectual Property* (unpublished lecture notes, University of KwaZulu-Natal, 2017).

Therefore “protection over a trade mark in one country usually does not provide protection in other countries”.¹⁴

However, international trade marks allow trade mark owners to seek trade mark protection on an international scale.¹⁵ As can be seen from the aforementioned assertions, it is necessary that trade mark owners be able to register or manage their trade mark portfolios in a secure, time-effective and economical way in foreign countries - where failure to do so could result in potential profit losses for a business.¹⁶ It follows that WIPO’s international trade mark system - known as the Madrid system – appears to be an affordable, user-friendly and attractive option for companies seeking trade mark protection in various jurisdictions such as North America, South America, northern African countries, the European community, the Middle East, Asia and Australia.¹⁷

1.1.2. The Madrid System: The Madrid Agreement & the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

The Madrid system is governed by two treaties, namely the Madrid Agreement and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol”) – both of which are administered by the International Bureau of WIPO.¹⁸ The Madrid Agreement provides for the international registration of trade marks, and was followed by the Madrid Protocol. The Madrid Agreement and the Madrid Protocol “are independent, parallel treaties, with separate,

¹⁴ D Devine ‘Intellectual Property Law, International Trade mark, Daily Archive’ (2015) available at <https://500law.com/2015/06/11/>, accessed on 8 May 2018.

¹⁵ ‘Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)’ available at http://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html, accessed on 8 May 2018

¹⁶ C Jewell ‘Trademarks: Valuable assets in a changing world’ (2009) available at http://www.wipo.int/wipo_magazine/en/2009/04/article_0002.html, accessed on 8 May 2018

¹⁷ C Jewell ‘Trademarks: Valuable assets in a changing world’ (2009) available at http://www.wipo.int/wipo_magazine/en/2009/04/article_0002.html, accessed on 8 May 2018

¹⁸ C Jewell ‘Trademarks: Valuable assets in a changing world’ (2009) available at http://www.wipo.int/wipo_magazine/en/2009/04/article_0002.html, accessed on 8 May 2018

but overlapping regulations and memberships”.¹⁹ Various provisions of the Madrid Agreement were unfavourable for major countries due to the fear of “incompatibility with common law jurisdictions, loss of national sovereignty, and the inability to register based on an application”.²⁰ The Madrid Agreement was considered untenable from these challenging provisions, to which some countries therefore abstained from signing it.²¹ This resulted in the creation of the Madrid Protocol which addressed the initial concerns stemming from the Madrid Agreement. This enabled countries who did not elect to sign the Agreement to exclusively sign the Madrid Protocol.²² Although the two treaties are similar, there are significant differences.²³

1.2. RATIONALE FOR THE STUDY

This study is solely positioned around a further contextual analysis of the Madrid Protocol and not the Madrid Agreement since South Africa will only be ratifying the Madrid Protocol. South Africa is likely to only accede to the Madrid Protocol instead, in light of the differences between the Agreement and the Madrid Protocol.²⁴ According to the assertions of various legal minds, it has been determined that where countries are considering accession to the Madrid Protocol, it is unlikely that it would entertain

¹⁹ ‘Madrid System in Vietnam: Difference between Madrid Agreement and Madrid Protocol’ available at <https://duytho.com/madrid-system-in-vietnam/13005-difference-between-madrid-agreement-and-madrid-protocol.html>, accessed on 8 May 2018

²⁰ S M O’Coin ‘Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries’ Economies’ (2011) 15 *Holy Cross J.L. & Pub. Pol’y* 271

²¹ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

²² H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

²³ ‘Madrid System in Vietnam: Difference between Madrid Agreement and Madrid Protocol’ available at <https://duytho.com/madrid-system-in-vietnam/13005-difference-between-madrid-agreement-and-madrid-protocol.html>, accessed on 8 May 2018

“Some of the differences between the Madrid Protocol and the Madrid Agreement include: 1) The Madrid Agreement requires that an international application be based on a home country registration, where it takes a certain period of time to obtain a registration in the home country. Under the Protocol, the applicant may base its application for international registration on an application filed with the home country’s trade mark office or a registration granted by that office. 2) Under the Agreement, the working language is French and all applications filed must be in French. However, under the protocol, the Office of Origin may require applications made under the Protocol to be filed in English, French or Spanish or it may permit the applicant to choose one of the three. 3) The time limit for a designated country to refuse an extension of protection under the Agreement is 12 months. However, under the Protocol, each Contracting Party may elect a period of 18 months to grant or refuse protection to the mark or notify the holder of the possibility of refusal. 4) In terms of validity, a registration under the Agreement lasts for 20 years before it must be renewed, while under the Protocol a registration lasts for 10 years before it must be renewed.”

²⁴ ‘Madrid Agreement and Madrid Protocol’ (2015) available at <https://www.sztnh.gov.hu/en/madrid-agreement-and-madrid-protocol>, accessed 13 December 2018

the idea of becoming a signatory to the Madrid Agreement as well. Furthermore, the legal bodies and specialists of South Africa have made no mention of acceding to the Madrid Agreement, where countries are no longer using that treaty as an option for international trade mark protection.²⁵ Thus, the research in this dissertation will be limited to the Madrid Protocol. South Africa's accession to the Madrid Protocol has not been confirmed by any state entity or government.²⁶ However, there are numerous legal practitioners²⁷ and academics²⁸ who have alluded to the possibility of South Africa acceding to the Madrid Protocol, describing South Africa to have "signaled their intentions to accede" to the Madrid Protocol since 2006.²⁹ The remarks of Blignaut on this matter insist that amendments to the Trade Marks Act³⁰ of South Africa have been proposed in order to enable accession to the Madrid Protocol, following the necessary legislative processes.³¹ With regards to South Africa's general development in the landscape of intellectual property law, legal practitioners have noted that the progression of intellectual property rights in South Africa is "unpredictable".³² This leads to the idea that in spite of the commentary from the South African legal community confirming South Africa's accession to the Madrid Protocol, there is still uncertainty surrounding this notion. The sentiment that South Africa's advancements in intellectual property are unpredictable, has been attributed to the contemporary nature of the Constitution of the Republic of South Africa³³ as a document, especially where the rights promulgated by this legislation are frequently raised in intellectual property cases.³⁴ An example of this would be the *Laugh it off case*.³⁵

²⁵ H Blignaut 'Marked improvements on the IP Landscape' (2018) *Intellectual Property Magazine* 57

²⁶ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

²⁷ H Blignaut 'Marked improvements on the IP Landscape' (2018) *Intellectual Property Magazine* 57 – "South Africa is, and has been for some time, in line to join and implement the Madrid System. Proposed amendments to the South African Trade Marks Act have been made, which will provide for the enactment of South Africa's obligations in terms of the Madrid System in its national law."

²⁸ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 6

²⁹ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

³⁰ Trade Marks Act No. 194 of 1993

³¹ H Blignaut 'Marked improvements on the IP Landscape' (2018) *Intellectual Property Magazine* 57

³² W Meiring 'Good News, Challenges and Mixed Messages' (2014) 238 *Managing Intell. Prop.* 65

³³ The Constitution of the Republic of South Africa, 1996

³⁴ W Meiring 'Good News, Challenges and Mixed Messages' (2014) 238 *Managing Intell. Prop.* 65

³⁵ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) (27 May 2005)

1.2.1. Overview of the Madrid Protocol

The Madrid Protocol is an international treaty that facilitates the international registration and maintenance of trade marks, providing a central means of seeking trade mark protection in nations that are members of the treaty.³⁶ As of 4 December 2018, there are 103 (one hundred and three) members of the Madrid Protocol, and thus 119 (one hundred and nineteen) countries covered.³⁷ These numbers differ because members of the Madrid Protocol are not restricted to countries, but also regional bodies and systems such as the Organisation Africaine de la Propriété Intellectuelle³⁸ (OAPI) or the European Union³⁹ (EU), that are comprised of a group of many individual countries in a particular region.⁴⁰ Hence, there are fewer members of the Madrid Protocol, but a greater number of countries or territories covered. The international registration is completed through the filing of a single streamlined international application⁴¹, with the national or regional intellectual property office of a Madrid Protocol member.

The application is done in the language of English, Spanish or French and payment of a single fee to protect a trade mark in numerous countries.⁴² According to the Madrid Protocol, Article 2 (1) (i) and (ii) provides for securing the protection of a mark through

³⁶ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

³⁷ 'Samoa Joins the Madrid System' (2018) available at https://www.wipo.int/madrid/en/news/2018/news_0015.html, accessed on 5 December 2018

³⁸ "The following countries belong to OAPI: Benin, Burkina-Faso, Cameroon, Central African Republic, Chad, Republic of Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal, Togo and the Union of the Comoros" - 'Intellectual Property in Africa: An Overview' (2016) available at

<https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520->

https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjc-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

³⁹ "The following countries belong to the EU: Austria, Belgium, Bulgaria, Croatia, Republic of Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK" - 'Countries in the EU and EEA' available at <https://www.gov.uk/eu-eea>, accessed on 16 December 2018

⁴⁰ A Adewopo 'Trademark Systems in Africa - A Proposal for the Harmonisation of the ARIPO and the OAPI Agreements on Marks' (2003) 6 *Journal of World Intellectual Property* 473

⁴¹ J F Sistik 'Options for Foreign Trademark Protection - Comparison of the Madrid Protocol and the Community Trademark System' (2003) 21(3) *Ent. & Sports Law*. 17

⁴² E Barraclough ... et al. 'The Madrid Protocol Comes of Age' (2013) 230 *Managing Intell. Prop.* 35.

international registration, where the person in whose name that application or registration stands⁴³ (for either a legal entity or a natural person) is a national of, or is domiciled⁴⁴ in a Madrid member country, or has a “real and effective industrial or commercial establishment”, in the territory of a Madrid member state or region.⁴⁵ Therefore, under the Madrid Protocol, the applicant may choose its Office of Origin based on establishment, domicile or origin.⁴⁶

The purpose of this study is two-fold. Firstly, to establish whether filing a trade mark application, in terms of the Madrid Protocol, would result in effective protection of an international trade mark in South Africa. The issue here, lies in the fact as to whether South Africa may be able to effectively afford an international trade mark protection within South Africa’s jurisdiction. Secondly, to establish whether South African trade mark owners, who file trade mark applications in terms of the Madrid Protocol, would receive effective protection for their trade mark in foreign countries that are party to the Madrid Protocol.⁴⁷ The concern in this regard, is that when applying for an international trade mark in a third world country (which may not have all its Intellectual Property systems in line), South African trade mark owners may not be receiving equivalent trade mark protection as compared to when a South African trade mark owner applied for trade mark protection in first world countries. Where this two-fold purpose is fulfilled, it would amount to the Madrid Protocol functioning effectively at its optimum.

An analysis of the outcomes of the aforementioned questions of the study, would provide direction as to whether South Africa should accede to the Madrid Protocol. Ultimately, the questions at hand are whether South Africa can give protection to

⁴³ ‘Overview - The Madrid System for the International Registration of Marks: Objectives, Main Features, Advantages’ (2016) available at

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf, accessed on 14 December 2018

⁴⁴ H Kruger ... et al. *The Law of Persons in South Africa* (2010) 68 - “Domicile has been referred to as a person’s home for legal purposes, and as a person’s ‘center of gravity’, where rights, duties and capacities can be imputed on him or her”.

⁴⁵ Article 2 (1) (i) and (ii) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

⁴⁶ ‘Cabinet approves ratification of Madrid Protocol’ (2003) available at <https://www.mylexisnexis-co-za.ukzn.idm.oclc.org/Index.aspx>, accessed on 19 December 2018

⁴⁷ S Hollis ... et al. ‘Memorandum on the effectiveness of International (MADRID) Registrations in Africa’ (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

international applicant's marks and whether South African applicants can receive such protection of their international marks. The motivation for this study is to provide a critical analysis of the rationale supporting the decision of South Africa acceding to the Madrid Protocol. Hence this research will assist in the decision-making process of whether South Africa should accede to the Madrid Protocol or not, and may even lead to the consequence of a general revision under South African trade mark law. This notion is to be emphasized further in the research, in that it is of particular relevance if South Africa were to accede to the Madrid Protocol, where amendment to the existing trade mark laws in South Africa would be part of the process of implementation.

Various authors have explained that international agreements are not all generally equally favourable to every country that has acceded to it, where the benefits are purely based on how the country's economy will receive it.⁴⁸ It is therefore necessary to analyse a country's subjective accession to the Madrid Protocol in its reality.⁴⁹ Thus, it requires reviewing the existing trade mark registration process within that country, evaluating its proficiency for users, and how to best prepare for the necessary adjustments in the case of possible accession.⁵⁰ This is what the content of this dissertation will evolve around within the context of South Africa. In order to achieve the goal of this study, it is proposed that research be done on South Africa's potential accession to the Madrid Protocol, by drawing comparisons between countries - of a similar status to South Africa - that have acceded or are in the process of acceding to the Madrid Protocol⁵¹. The research will focus in countries like Brazil⁵², Mexico⁵³ and India⁵⁴ - as these countries share with South Africa, a similar socio-economic climate and developing third-world country status. A supplementary focus of this study, is to

⁴⁸ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

⁴⁹ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

⁵⁰ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

⁵¹ B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

⁵² J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

⁵³ A Pyrah 'Problems as Mexico Joins Madrid Protocol' (2013) 228 *Managing Intell. Prop.* 8

⁵⁴ A Ramanujan 'Reflections on the Indian Accession to the Madrid Protocol' (2008) 13 *Journal of Intellectual Property Rights* 111

shed light on the “importance of a protected and effective international trade mark – where the Madrid Protocol makes filing a trade mark” an easier task for people who work in global situations.⁵⁵ Preliminary research has revealed that this topic has been explored before⁵⁶, however not within a South African context. Therefore, we can extrapolate the findings of foreign jurisdictions for an indication as to how beneficial the Madrid Protocol has or has not been in the effective protection of international trade marks.⁵⁷

There is a justifiable need for the world to unite its Intellectual Property’s trade mark laws through a streamlined international trade mark registration process, which is necessary for the effective marketing of a global brand, and subsequently the enhancement of the global knowledge-based economy.⁵⁸ Accession to the Madrid Protocol will potentially improve international relations which will enable the unification of a global community. Where International trade marks are a systemic part of globalization, the Madrid Protocol illustrates great capacity for progress as a developing country.⁵⁹ Creating this synergy between international law and South African law, is a starting point into how South Africa is evolving to meet global standards, where the filing of international trade marks is crucial to South Africa’s advances made in Intellectual Property laws.⁶⁰

The international investors that South Africa host, ultimately grow our economic footprint on the international market.⁶¹ By acceding to the Madrid Protocol, it allows investors who venture into foreign jurisdictions seeking to make investments with their Intellectual Property and grow their international brand, thus expanding the use of their trade marks, while simultaneously filing through one trade mark application for

⁵⁵ I Davies ‘Legal update’ (2003) 10(3) *Journal of Brand Management* 252

⁵⁶ Readings relating to this topic not only make assessments of the advantages and disadvantages of the Madrid Protocol, but rather discusses the effectiveness of the Madrid trade mark registration system and the benefits it has for certain groups, such as large corporations over small entrepreneurs. Therefore, this dissertation will seek to contextualise the information drawn from preliminary research, in a South African context.

⁵⁷ S Brown & M Du Plessis ‘Easing International Registrations in Africa’ (2014) 238 *Managing Intell. Prop.* 60

⁵⁸ T Bosling ‘Securing the Trademark Protection in a Global Economy - The United States’ Accession to the Madrid Protocol’ (2004) 12 *U. Balt. Intell. Prop. L.J.* 137

⁵⁹ S M O’Coin ‘Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries’ Economies’ (2011) 15 *Holy Cross J.L. & Pub. Pol’y* 268

⁶⁰ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 14

⁶¹ GI Zekos ‘Trademarks and Cyberspace’ (2006) 9(5) *The Journal of World Intellectual Property* 505

protection covering all the designated countries that are members. If South Africa does not accede to the Madrid Protocol, it means that our international investors would have to file a separate trade mark application for protection in South Africa creating a unfavourable market place with more bureaucracy.

Where South Africa has not simplified its international trade mark protection system with the Madrid Protocol, the motivation for this study stems from a need to provide an objective analysis and synthesis of perceived advantages and actual advantages of accession by South Africa to the Madrid Protocol.⁶² The research aims to also provide a contribution to the current knowledge around this issue to people in the strategic environment as well as to provide a public service to Trade mark owners about the rights that could be available to them.⁶³ In the current stagnant phase of uncertainty that South Africa is in, with regards to acceding to the Madrid Protocol, this dissertation will endeavour to contextualise the general discussions and act as a catalyst for further conversation.

1.3. AIMS AND OBJECTIVES OF THE RESEARCH

The aims of this research can be categorized into an academic aim and a strategic aim. The academic aim of this research is to provide a synthesis of the advantages and disadvantages of acceding to the Madrid Protocol, in respect of a South African context. The strategic aim is to make recommendations to policy-makers on whether accession to the Madrid Protocol will provide effective protection for South African International trade mark owners in foreign countries that are party to the Madrid Protocol, as well as whether accession to the Madrid Protocol will result in effective protection of an international trade mark in South Africa.⁶⁴ Hence, whether the various

⁶² 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

⁶³ A Tramosch 'What to Tell a Client about the New Madrid Protocol International Trademark Registration' (2003) 85 *J. Pat. & Trade mark Off. Soc'y* 616

⁶⁴ Ghafele R 'Trade mark owners' perspectives on the Madrid System: practical experiences and theoretical underpinnings' (2007) 2 *Journal of Intellectual Property Law & Practice* 161

perceived consequences of acceding to the Madrid Protocol, will amount to actual consequences in South Africa and for South Africans.⁶⁵

The research that follows will also shed light on the relevant legal considerations in this regard. The legal area refers to the Trade Marks Act⁶⁶ currently not being equipped to facilitate accession to the Madrid Protocol, and the subsequent use of international trade marks through the Act. In this regard, the dissertation will concentrate on motivating for the Madrid Protocol's potential implementation in South Africa while simultaneously analysing the intended or unintended consequences that may flow from South Africa's accession. The objective of this study is to analyse whether various perceived consequences of acceding to the Madrid Protocol, will amount to actual consequences in South Africa. This thesis will seek to provide responses to these questions and suggestions for prospective solutions.

1.4. THE RESEARCH PROBLEM & KEY RESEARCH QUESTIONS

This study will primarily focus and expand on the arguments made in support of South Africa's accession to the Madrid Protocol, and give consideration to opposing perspectives. There are various authors who are proponents of South Africa's accession to the Madrid Protocol - such as Muhlberg - who explain how the current international trade mark registration system in South Africa is set to change, and he addresses some of the main advantages that would materialize if South Africa were to accede.⁶⁷ However, contrasting perspectives are brought to the fore by authors like Meiring who outlines the issue of "validity and enforceability" of international registrations in "common law countries that have failed to incorporate the Madrid Protocol into their domestic law", and the pending drawbacks of the Madrid Protocol.⁶⁸

In order to achieve the aims and objectives of the research paper the following key research questions will be answered, followed by various sub-questions that will be

⁶⁵ R Ghafele 'Trade mark owners' perspectives on the Madrid System: practical experiences and theoretical underpinnings' (2007) 2 *Journal of Intellectual Property Law & Practice*

⁶⁶ No. 194 of 1993

⁶⁷ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 6

⁶⁸ W Meiring 'Beware When Using the Madrid Protocol in Africa' (2015) 248 *Managing Intell. Prop.*16

considered in order to establish clear answers. The main research question at hand is two-fold, with several factors to be considered in answering them. The first fold of the question deals with **whether filing a trade mark application in terms of the Madrid Protocol, would result in effective protection of an international trade mark in South Africa?** This first question generates further sub-issues, which can be identified in terms of the legal and socio-economic consequences that accession to the Madrid Protocol entails. A detailed assessment of South Africa's infrastructure, through legal and socio-economic factors, will establish whether South Africa should accede to the Madrid Protocol or not. In terms of the legal consequences that would arise in lieu of accession to the Madrid Protocol, the following question becomes apparent is **whether there a need for South African Intellectual Property law to be amended to facilitate the Madrid Protocol?** This dissertation will provide research into South Africa having to change its Intellectual Property laws prior to accession and **how will the implementation of the Madrid Protocol affect the practical registration of trade marks on a national level as well as an international level?**

With the numerous socio-economic outcomes that would ensue, the core issues that would arise, lie in administrative difficulties, enforcement and economic growth. An important research question to ask is **how successful would the practical use of the Madrid protocol be in South Africa in terms of the administration of international trade marks?** It follows that practical implementation of the Madrid Protocol would also fall into question⁶⁹ - bearing in mind that South Africa still experiences difficulty enforcing trade mark protection at a national level, **to what extent will South Africa be able to enforce the Madrid Protocol at an international level/ in accordance with international standards if accession has to take place?** Another sub-question that is relevant to this research is **in terms of infrastructure and development, will South Africa's CIPC be able to manage and adjust to the Madrid Protocol's new software?** And finally, from a commercial perspective, one could also pose the following question of **whether accession to the Madrid Protocol would encourage economic growth for both big and small entrepreneurs?** The

⁶⁹ A Salhotra & S Khan 'Accession to the Madrid Protocol' (2010) 202 *Managing Intell. Prop.* 40

answer to this question lies in assessing the accession of countries with a similar social or economic standing as South Africa, to the Madrid Protocol or the lack thereof.⁷⁰

The second fold of the main research question deals with **whether South African trade mark owners, who file trade mark application in terms of the Madrid Protocol, would receive effective protection for their trade mark in foreign countries that are party to the Madrid Protocol?** Overall, these varying questions are essential for the research at hand, to ultimately establish whether or not South Africa should accede to the Madrid Protocol. Part of developing the answer to this question, also delves into whether the Madrid Protocol is necessary for the South African Trade mark industry, in terms of international trade mark protection.

1.5. RESEARCH METHODOLOGY

In terms of achieving the aforementioned research aims, the research method to be pursued in this dissertation will be that of desktop research, where existing publications – such as Journals, Cases, Statutes, Unpublished theses, Internet sources will be reviewed and analysed – as well as primary resources being the relevant legislation.

1.6. PLANNED STRUCTURE OF DISSERTATION

Chapter two will focus on international trade marks, discussing the workings of the Madrid Protocol. In addition, a comparison will be drawn regarding the process of registering an international trade mark in South Africa, as juxtaposed with the registration of an international trade mark through the Madrid Protocol. This comparison will therefore simulate the international trade mark registration process if South Africa were to accede to the Madrid Protocol. Chapter three will consider the international backdrop against which the Madrid Protocol sits, by drawing a contrast

⁷⁰ S M O'Coin 'Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries' Economies' (2011) 15 *Holy Cross J.L. & Pub. Pol'y* 276

with countries both similar and dissimilar to South Africa that have already acceded or are in the process of doing so, in order to create a holistic perception of what accession to the Madrid Protocol entails. The countries included in the research are Zimbabwe, Botswana, Gambia, Brazil, India, Mexico, Canada and New Zealand.

This chapter will also provide a more detailed account of the practical experiences and difficulties involved in acceding to the Madrid Protocol. Chapter four will critically analyse the assertions made or problems presented and make various recommendations, based on the advantages and disadvantages that member states of the treaty have recognized in implementing the Madrid Protocol. This will be achieved by exploring the consequences of acceding to the Madrid Protocol - delving into a practical understanding of the potential implementation in South Africa. Chapter five will conclude with a comprehensive summary of the dissertation and the purpose it serves, by formulating critical responses to the key research questions at hand.

CHAPTER 2: INTERNATIONAL TRADE MARKS

2.1. INTRODUCTION

Chapter two will provide comprehensive insight into international trade marks, as well as a short note on South Africa's involvement and practices with international treaties in relation to intellectual property. This will be followed by a discussion of the workings of the Madrid Protocol, analysing the process of registering an international trade mark in South Africa, in comparison with the registration of an international trade mark through the Madrid Protocol.⁷¹ In light of the varying opinions both for and against South Africa's accession to the Madrid Protocol, it is necessary to formulate a perception of what South Africa's accession to the Madrid Protocol could be perceived as. Therefore, an amalgamation of South Africa's national trade mark procedures and the Madrid Protocol's processes will thereby simulate the international trade mark registration process if South Africa were to accede to the Madrid Protocol.

2.1.1. What is an International Trade mark?

As mentioned in the previous chapter, an international trade mark allows for protection of the mark in a global arena.⁷² In understanding the nature of an international trade mark, it is worth noting that this does not mean that the trade mark is protected in all the countries of the world.⁷³ "The mark is only recognized in member countries" of the Madrid Protocol.⁷⁴ Other regional trade mark filing mechanisms observe the same practice.⁷⁵ However WIPO's Madrid Protocol is widely recognised as the best option

⁷¹ I Davies 'Legal update' (2003) 10(3) *Journal of Brand Management* 252

⁷² 'Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)' available at http://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html, accessed on 8 May 2018

⁷³ R Annand and L Kemp 'Global Registration – Where are We Now?' (2011) 101 *Trade mark Rep.* 94

⁷⁴ F Al Sakkaf 'One Trade mark, One Application' (2018) 5(11) *Ct. Uncourt* 11

⁷⁵ "International Trade mark filing mechanisms that are close alternatives to the Madrid Protocol, include the 'Community Trade Mark' which affords protection in all the member states of the European Union and the African equivalents being OAPI", which will be discussed further in the Chapter 4 - GI Zekos 'Trademarks and Cyberspace' (2006) 9(5) *The Journal of World Intellectual Property* 505

for trade mark filing that provides protection on a global basis.⁷⁶ The observable benefits of registering an international trade mark are similar to those of registering a national trade mark, except that these benefits reach across continents.⁷⁷ However, it does remain optional for the trade mark proprietor to register their national trade mark as an international trade mark.⁷⁸

2.1.2. The Effect of an International Trade mark

In terms of how an international trade mark takes effect, it is also important to consider that “there is no such thing as an ‘internationally effective’ trade mark”.⁷⁹ This means that while the Madrid Protocol offers efficient protection of a trade mark in several territories, there is no mechanism that can offer a trade mark owner, a “truly international trade mark” that is immediately enforceable worldwide, through countries that are not members of the Madrid Protocol.⁸⁰ It can be said that the effect of an international trade mark, is mainly based on the respective member state’s internal processes when registering a trade mark. Over and above WIPO’s formal examination of the trade mark application, each member country in which the trade mark owner has applied to register their trade mark in, will be given a requisite amount of time to assess the application under the territory’s respective internal intellectual property laws.⁸¹ For example, according to a recent Madrid Information Notice issued by WIPO, the trade mark office of Mexico has communicated to WIPO that holders of international registrations who designate Mexico as a territory in which they seek protection, “must file declarations of actual and effective use of the mark”.⁸² Where

⁷⁶ G de Rassenfosse ‘On the price elasticity of demand for trade marks’ 2018 SSRN. 2

⁷⁷ CM Aide ‘Madrid by way of Ottawa: Tips and Traps for the International Registration System’ (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

⁷⁸ J Murray ‘How Do I Register a Trade mark or Service Mark Internationally?’ (2018) available at <https://www.thebalancesmb.com/register-trade-mark-or-service-mark-internationally-399015>, accessed on 14 September 2018

⁷⁹ N Webster ‘7 Things To Know About International Trade mark Applications’ (2017) available at <https://www.trade-marknow.com/blog/7-things-to-know-about-international-trade-mark-applications>, accessed on 14 September 2018

⁸⁰ N Webster ‘7 Things To Know About International Trade mark Applications’ (2017) available at <https://www.trade-marknow.com/blog/7-things-to-know-about-international-trade-mark-applications>, accessed on 14 September 2018

⁸¹ A Tramosch ‘What to Tell a Client about the New Madrid Protocol International Trademark Registration’ (2003) 85 *J. Pat. & Trade mark Off. Soc’y* 619

⁸² ‘Madrid Protocol Concerning the International Registration of Marks’ (2018) available at https://www.wipo.int/edocs/madrdocs/en/2018/madrid_2018_13.pdf, accessed on 14 December 2018

non-compliance with this requirement is identified, the trade mark office of Mexico will declare the cancellation of the mark in Mexico, *ex officio*.⁸³

2.1.3. South Africa's Accession to International Treaties and Conventions in relation to Intellectual Property

By considering a brief history of South Africa's involvement in international treaties, this provides contextual analysis to the country's possible accession to the Madrid Protocol. South Africa is a member of the United Nations since 1945, and the World Trade Organization as of 1995.⁸⁴ A few of the treaties administered by WIPO, to which South Africa is also a member, include the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention), the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Convention Establishing the World Intellectual Property Organization (WIPO Convention).⁸⁵ The Paris Convention was also the first main international treaty that provided for international protection of intellectual property rights such as trade marks in terms of Articles 6 to 9.⁸⁶ Since the introduction of these major international agreements, there have been a growing number of "international treaties regulating intellectual property rights" around the world, such as the The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Singapore Treaty on the Law of Trademarks and the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Agreement).⁸⁷ South Africa is also a signatory to WIPO's Trade mark Law Treaty, but not a member.⁸⁸ The difference between being a signatory and being a member lie where the effects of either one differ. Being a

⁸³ A Tramosch 'What to Tell a Client about the New Madrid Protocol International Trademark Registration' (2003) 85 *J. Pat. & Trade mark Off. Soc'y* 617

⁸⁴ 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

⁸⁵ T Bosling 'Securing the Trademark Protection in a Global Economy - The United States' Accession to the Madrid Protocol' (2004) 12 *U. Balt. Intell. Prop. L.J.* 140

⁸⁶ P Ramsden *A Guide to Intellectual Property Law* (2011) 10

⁸⁷ AB Deorsola ... et al 'Intellectual Property and trade mark legal framework in BRICS countries: A comparative study' (2017) 49 *World Patent Information* 2

⁸⁸ P Ramsden *A Guide to Intellectual Property Law* (2011) 13

signatory merely entails declaring an intention to make the provisions of the treaty legally binding through signature. Yet being a member, involves both signing and ratifying the terms of the treaty in terms of the country's own internal procedures. The content or provisions of the respective treaty, become enforceable with ratification in this instance.⁸⁹

2.2. REGISTERING AN INTERNATIONAL TRADE MARK IN SOUTH AFRICA

A practical scenario facing many trade mark owners in South Africa is as follows:⁹⁰

Sipho is a businessman who operates a logistics company, and currently owns the registered trade mark, 'Enigma Logistics', in South Africa. Sipho seeks to register his trade mark as an international trade mark. He will therefore approach South African Intellectual Property lawyers and tell them that he wants to register his trade mark in South Africa, as well as India, Spain and Australia. The South African Intellectual Property lawyers will handle the South African application themselves and they will instruct law firms in the respective countries, to handle the foreign applications. The foreign law firms report to the South African lawyers, who in turn will report to Sipho.

In order to shed light on the change in process that would ensue with the accession to the Madrid Protocol, it is vital to outline the evolution of how a general international trade mark registration is typically carried out and recognised in South Africa. The current avenue that a South African trade mark owner would pursue for international trade mark registration, involves a South African company approaching Intellectual Property attorneys in South Africa, and giving them a mandate to register its trade mark in South Africa as well as the foreign country in which it seeks the trade mark to be protected.⁹¹ These attorneys will manage the South African application, and will instruct the foreign law firm to handle the foreign application.⁹² However, before initiating the registration process, it is good practice to conduct a general availability

⁸⁹ N Botha 'Public International Law' (2009) *Annual Survey of South African Law* 1152

⁹⁰ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 6

⁹¹ T Grant 'South Africa streamlines prosecution procedure' (2006) 160 *Managing Intell. Prop.* 47

⁹² H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 6

search in order to establish “whether there are any existing marks that may conflict with the proposed trade mark” being applied for.⁹³ This involves filing separate applications in the trade mark offices of each country in which protection is sought.⁹⁴

The examination of applications are “conducted on both absolute and relative terms” where the registration and examination process in its entirety varies from twenty-four to thirty-six months, depending on how easily the application can be processed.⁹⁵ The latest developments in the practices of South Africa’s trade mark registry have included electronic improvements with the e-filing of new trade mark applications, renewals and the online publication of applications which have been accepted for registration.⁹⁶ This application is usually in different languages, being the preferred language or official language of the country that has been specifically designated by the South African trade mark proprietor.⁹⁷ A separate application fee will also need to be paid in each trade mark office.⁹⁸ Amongst the array of fees to be paid, the South African Intellectual Property attorneys will also solicit the legal services of a foreign law liaison in the designated country. The foreign attorney will report to the South African Intellectual Property attorneys, who will in turn report to the client thereafter.⁹⁹

Recent figures detailing the trade mark prosecution activity in South Africa, have totalled 38 283 (thirty-eight thousand two-hundred and eighty-three) applications filed through the South African Registry in the year of 2017.¹⁰⁰ Of this number, 15 543

⁹³ ‘Intellectual Property in Africa: An Overview’ (2016) available at <https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520->

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf &ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa’, accessed on 16 March 2018

⁹⁴ ‘Overview - The Madrid System for the International Registration of Marks: Objectives, Main Features, Advantages’ (2016) available at

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf, accessed on 14 December 2018

⁹⁵ H Blignaut ‘Marked improvements on the IP Landscape’ (2018) *Intellectual Property Magazine* 57

⁹⁶ H Blignaut ‘Marked improvements on the IP Landscape’ (2018) *Intellectual Property Magazine* 57

⁹⁷ ‘Overview - The Madrid System for the International Registration of Marks: Objectives, Main Features, Advantages’ (2016) available at

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf, accessed on 14 December 2018

⁹⁸ ‘Overview - The Madrid System for the International Registration of Marks: Objectives, Main Features, Advantages’ (2016) available at

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_418_2016.pdf, accessed on 14 December 2018

⁹⁹ H Muhlberg ‘The Wrong Crowd’ (2015) *Without Prejudice* 6

¹⁰⁰ H Blignaut ‘Marked improvements on the IP Landscape’ (2018) *Intellectual Property Magazine* 57

(fifteen thousand five hundred and forty-three applications) were filed by international trade mark owners.¹⁰¹ From these statistics, one can deduce that members of the South African business community are conscious of their intellectual property rights and that there are foreign investors eager to expand into South Africa. In terms of South Africa's current trade mark policy, if accession to the Madrid Protocol does not materialise, the status quo, as explained above will remain where trade mark owners will have to file separate international trade mark applications with the trade mark office of each country in which protection is sought.

With regards to the matter of what extent would South Africa be able to secure the protection of, and enforce the intellectual property rights of international trade mark registrations of a foreign trade mark holder in South Africa, it is worth analysing the current enforcement mechanisms in place that safeguard trade marks at a national level. From this information one could then develop an idea of what safeguarding international trade marks in South Africa would possibly look like.¹⁰² There are several methods which a trade mark owner can utilise to enforce his intellectual property rights in South Africa. The most appropriate option to will depend on the specific set of facts in each individual matter.¹⁰³

In terms of conventional trade mark enforcement, such as a claim for trade mark infringement of a registered trade mark in South Africa, the trade mark proprietor may opt for litigation by instituting infringement proceedings.¹⁰⁴ In any infringement matter, the proprietor will approach the High Court of South Africa for relief.¹⁰⁵ Even though South Africa does not have any specialised intellectual property courts, there has been increased activity in trade mark litigation with an increase in the number of trade mark cases being argued before the Court. This amounts to the High Courts and Supreme Court of Appeal regularly issuing new judgments and often setting new precedents.¹⁰⁶

¹⁰¹ H Blignaut 'Marked improvements on the IP Landscape' (2018) *Intellectual Property Magazine* 57

¹⁰² 'Q&A: Trade marks in South Africa' (2012) 222 *Managing Intell. Prop.* 89

¹⁰³ H Blignaut 'Marked improvements on the IP Landscape' (2018) *Intellectual Property Magazine* 58

¹⁰⁴ 'Q&A: Trade marks in South Africa' (2012) 222 *Managing Intell. Prop.* 89

¹⁰⁵ T Grant 'South Africa streamlines prosecution procedure' (2006) 160 *Managing Intell. Prop.* 47

¹⁰⁶ 'Q&A: Trade marks in South Africa' (2012) 222 *Managing Intell. Prop.* 89

In South Africa, the other active measures that trade mark proprietors can take include the possibility of lodging company name objections with the Companies Tribunal of

It is also worth noting an auxiliary point as to how effective enforcement of intellectual property rights are for international trade mark owners in South Africa.¹⁰⁷ In this regard, South Africa's trade mark law provides for unregistered foreign trade marks, as they are acknowledged within the parameters of qualifying as well-known marks under the Trade Marks Act¹⁰⁸ and are also protected under the common law.¹⁰⁹ Therefore, in South Africa, whether or not a trade mark proprietor elects to register an international trade mark, they are not left without any protection, as South African national trade mark law also provides protection for unregistered trade marks, and will therefore accommodate for the protection of unregistered international marks.

2.3. REGISTERING AN INTERNATIONAL TRADE MARK THROUGH THE MADRID PROTOCOL

According to the Madrid Protocol, Article 2 (1) (i) and (ii) provide for the securing of protection of a trade mark through international registration. The gatekeeping requirements are that the person in whose name that application or registration stands (either a legal entity or a natural person) is a national of, or is domiciled in a Madrid member country, or has a "real and effective industrial or commercial establishment", in the territory of a Madrid member state or region¹¹⁰. Therefore, under the Madrid Protocol, the party applying for international trade mark protection may choose its Office of Origin based on establishment, domicile or origin.¹¹¹ Where a trade mark owner is a national of, or has a business in a particular country, the trade mark owner's connection will be with this country, which must be member of the Madrid Protocol.¹¹²

¹⁰⁷ T Rengecas ... et al 'Important IP Information for SA Exporters' (2006) available at <https://www.spoor.com/en/News/important-ip-information-for-sa-exporters/>, accessed on 14 December 2018

¹⁰⁸ No. 194 of 1993

¹⁰⁹ T Grant 'South Africa streamlines prosecution procedure' (2006) 160 *Managing Intell. Prop.* 47

¹¹⁰ Article 2 (1) (i) and (ii) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

¹¹¹ I Davies 'Legal update' (2003) 10(3) *Journal of Brand Management* 252

¹¹² 'How to file your international application: Basic requirements' available at https://www.wipo.int/madrid/en/how_to/file/requirements.html, accessed on 16 December 2018

This trade mark owner would therefore have to file the application for an international trade mark through that country's Intellectual Property Office.¹¹³ According to WIPO, the procedure of registering an international trade mark is for protection of the trade mark outside its Office of Origin as part of an international business growth strategy.¹¹⁴ The processes of the Madrid protocol, can be divided into three main stages which are as follows:¹¹⁵

The first stage involves "application through the trade-mark owners National or Regional intellectual property Office", also known as the Office of Origin.¹¹⁶ Prior to filing an international application, the "individual or business domiciled in a country that is a Madrid Protocol member must have registered a trade mark in the home country in order to secure protection for a mark in some or all countries that are members of the Protocol.¹¹⁷ This national application or home registration, is known as the "basic mark", and is therefore the basis for a Madrid Protocol application.¹¹⁸ Thereafter, an international application is to be submitted through this Office of Origin, which will certify and forward it to WIPO in Geneva, Switzerland. This application is to be completed in the language of either English, Spanish or French and payment of one set of fees in Swiss Francs is levied. This application will indicate territories where protection of a mark is being sought.¹¹⁹ The WIPO office also provides that applicants from a "least developed country", will benefit from a ninety percent reduction in the basic fee.¹²⁰ One must also take note of the computerised programme initiated by WIPO known as the Intellectual Property Automated System¹²¹ or the Industrial

¹¹³ 'How to file your international application: Basic requirements' available at

https://www.wipo.int/madrid/en/how_to/file/requirements.html, accessed on 16 December 2018

¹¹⁴ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹¹⁵ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹¹⁶ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹¹⁷ 'The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice' (2002) 92 *Trade mark Rep.* 1441

¹¹⁸ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹¹⁹ E Barraclough ... et al. 'The Madrid Protocol Comes of Age' (2013) 230 *Managing Intell. Prop.* 35.

¹²⁰ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹²¹ W Meiring 'Good News, Challenges and Mixed Messages' (2014) 238 *Managing Intell. Prop.* 65

Property Administered System¹²² (IPAS), which is a means by which Madrid Protocol applications are documented. It allows for electronic copies of applications as well as registration records to be uploaded through the IPAS system and efficiently transferred to WIPO's database.¹²³ The IPAS system at present, handles international trademark applications in a similar way as the national e-filing systems established by various member states of the Madrid Protocol. WIPO therefore requires all member states to submit the international trademark application processed at their intellectual property office and other required details through this programme.¹²⁴

The second stage details the formal examination of the international application, conducted by WIPO.¹²⁵ WIPO processes the application through its database and determines whether the applicable Madrid formal filing requirements have been met and the required fees are paid.¹²⁶ The fees will depend on whether the trade mark is in colour or black and white, the number of classes in which the trade mark is being registered, as well as a number of selected countries in which the trade mark is to be registered.¹²⁷ WIPO further evaluates the list of goods or services, making the essential translations into the Protocol's working languages.¹²⁸ The list of goods or services "must be identical or narrower than the list in the trade mark, as applied in the office of origin".¹²⁹ WIPO will contact either the trade mark owner or its national office if the application does not conform with the established requirements, depending on the nature of the error.¹³⁰ With WIPO's confirmation of the necessary Madrid

¹²² B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹²³ S Brown ... et al 'Zimbabwe: Ratification of the Madrid Protocol' (2017) available at <https://www.adamsadams.com/news-insights/zimbabwe-ratification-madrid-protocol/>, accessed on 11 November 2018

¹²⁴ B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹²⁵ 'How the Madrid System Works: The International Trade mark Registration Process' available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹²⁶ 'The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice' (2002) 92 *Trade mark Rep.* 1441

¹²⁷ A Tramosch 'What to Tell a Client about the New Madrid Protocol International Trademark Registration' (2003) 85 *J. Pat. & Trade mark Off. Soc'y* 620

¹²⁸ 'The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice' (2002) 92 *Trade mark Rep.* 1441

¹²⁹ F Al Sakkaf 'One Trade mark, One Application' (2018) 5(11) *Ct. Uncourt* 12

¹³⁰ 'The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice' (2002) 92 *Trade mark Rep.* 1441

requirements being met, “the mark is recorded in the International Register and is published in the WIPO Gazette of International Marks”.¹³¹ Hereafter, a certificate of international registration of the mark is issued to the trade mark owner, however protection of the trade mark has not been afforded as yet.¹³² WIPO will then notify the intellectual property offices in all the territories designated in the international registration.¹³³

The third stage entails a substantive examination completed by the “National or Regional Intellectual Property Offices of the designated Contracting Party”.¹³⁴ The members of the Madrid System who are involved in the process of application and securing protection of its trade marks, are also known as Contracting Parties to the Madrid Protocol. Once accession and ratification to the treaty have taken place, these contracting parties are considered member states. The intellectual property offices of the designated territories where a trade mark owner seeks protection for the mark, will make a decision to either accept or reject registration of the mark, in accordance with their legislation, by analysing the application and formal examination facilitated by WIPO.¹³⁵ The analysis of the application is done within the applicable time limit of eighteen months. In the instance that the national intellectual property office fails to communicate any rejection within the aforementioned stipulated timeframe, the office cannot refuse trade mark protection of the trade mark.¹³⁶ If a particular intellectual property office “either totally or partially” rejects protection of the mark within this timeframe, this decision will not impact the decisions of other intellectual property offices which were stipulated as designated countries in respect of the international trade mark application.¹³⁷ WIPO will accordingly record the decisions of the individual

¹³¹ ‘The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice’ (2002) 92 *Trade mark Rep.* 1442

¹³² ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹³³ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹³⁴ B Bennett ‘Study on the Accession to the Madrid System for the International Registration of Marks’ (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹³⁵ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹³⁶ Article 5(2)(b) and (c) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

¹³⁷ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

intellectual property offices in the International Register and proceed to notify the trade mark owner.¹³⁸

A trade mark owner whose trade mark has been rejected by a designated country can contest any rejection of the international trade mark application before the relevant intellectual property office or a competent authority in the territory concerned.¹³⁹ The application will then be reviewed in accordance with its domestic legislation. Thereafter, if the trade mark is approved by the member state, the trade mark proprietor will be successful in their trade mark registration in that designated country.¹⁴⁰

If an intellectual property office accepts to protect your mark, it will “issue a statement of grant of protection”, confirming the effects of the trade mark in that region.¹⁴¹ The international registration becomes a Bundle of National registrations, which is held under one international registration number. The international registration is issued for ten years and can be renewed indefinitely, directly with WIPO. Once a mark has been renewed with WIPO, it simultaneously takes effect in the designated member countries concerned.¹⁴² When an office accepts protection of an international registration, such protection is the same as if the mark was registered with that national office directly.¹⁴³ It is important to note that the scope of protection of an international registration is only established after a “substantive examination and decision by the intellectual property offices” in the regions in which protection is sought.¹⁴⁴

¹³⁸ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹³⁹ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹⁴⁰ DL Barch ‘Navigating the Madrid Protocol: A New Global Regime for the International Registration of Trade marks’ (2003) 8 (2) *Intell. Prop. L. Bull.* 17

¹⁴¹ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹⁴² ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹⁴³ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

¹⁴⁴ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

It is also worth mentioning that international trademark registration can be extended geographically through subsequent designations.¹⁴⁵ Where it is not a requirement for all the designated countries that the trade mark owner seeks protection in, to be stipulated in the original international trade mark application, countries that were not initially designated can be added at a later stage. This is done through a "subsequent designation". Any subsequent designations to the initial registration in this regard are to be recorded with WIPO and retain the effect of a single procedure.¹⁴⁶ The intellectual property office of the subsequently designated member state is required to extend the registration on the same basis as that of the basic home registration, where it will be examined in accordance with the domestic intellectual property law of that nation and cannot be in contravention with the provisions of the Madrid Protocol.¹⁴⁷ As previously mentioned, Article 3 ter (2) of the Madrid Protocol states that in the case of a subsequent designation, the trade mark is only valid as of the date that it was recorded at WIPO, in terms of the statement of grant. Therefore, trade mark protection that is based on a subsequent designation, will be effective from the date that the subsequent designation is made, and not the date from the initial international trade mark registration.¹⁴⁸ Furthermore, the registration of the subsequent designation will become invalid upon expiry of the initial international registration of which it pertains to, also known as the basic mark. Essentially, the renewal date remains the same for all the designated countries within the application.¹⁴⁹ Therefore, it can be concluded that members of the community that have a vested interest in intellectual property find this territorial extension to be of significance where it minimizes costs of repeating a trade mark application, and removes the obstacles of filing numerous separate applications, in the path of establishing central protection of trade marks throughout the globe.¹⁵⁰

¹⁴⁵ B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹⁴⁶ U Pathak 'Madrid Protocol and Indian Trade Mark Law: a critical analysis' (2016) 5(2) *The Clarion* 51

¹⁴⁷ 'The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice' (2002) 92 *Trade mark Rep.* 1442

¹⁴⁸ A Tramosch 'What to Tell a Client about the New Madrid Protocol International Trademark Registration' (2003) 85 *J. Pat. & Trade mark Off. Soc'y* 625

¹⁴⁹ Article 3 ter (2) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

¹⁵⁰ U Pathak 'Madrid Protocol and Indian Trade Mark Law: a critical analysis' (2016) 5(2) *The Clarion* 49

Overall, in comparison to the process of registering an international trade mark under South Africa's national internal processes, registering a trade mark through the Madrid Protocol is a more streamlined and cost-effective process. The involvement of legal representation is low, and therefore fewer opportunities for flaws in the administration of the international trade mark registration. However, it is imperative to remain cognizant of the fact that this process outlined above is how an international trade mark application and registration would unfold in an ideal situation, without the realities of practical implementation.

2.4. A SIMULATED OUTLOOK OF REGISTERING AN INTERNATIONAL TRADE MARK IN SOUTH AFRICA THROUGH THE MADRID PROTOCOL

The workings of the Madrid Protocol vary in how it operates within each member country. Hence, this study requires insight as to how the Madrid Protocol would function in a South African setting. Joining the international registration system would mean that a South African trade-mark owner pursuing an international trade mark application in numerous countries, will no longer need to file separate national applications in each country.¹⁵¹ The trade mark owner can rather "file a single application for an international registration with WIPO in Geneva, designating the countries in which protection is being sought".¹⁵² In the application, the South African trade-mark owner can select any number of countries in which they desire protection, as long as they are all members states of the treaty. The procedure is managed by an attorney in South Africa.¹⁵³ The only prerequisite is that the South African trade mark owner must already have filed a national application to register the trade mark in South Africa.¹⁵⁴

¹⁵¹ RH Thompson 'International Trademark Protection Strategy' (2010) 19 *J. Contemp. Legal Issues* 480

¹⁵² H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

¹⁵³ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

¹⁵⁴ RW Emerson & CR Willis 'International Franchise Trademark Registration: Legal Regimes, Costs, and Consequences' (2017) 52 *Wake Forest L. Rev.* 12

Once again, a South African intellectual property attorney will handle the trade mark application for South Africa. After this national trade mark application is processed, the intellectual property attorney will prepare “an application for an international registration” covering the foreign countries the trade mark owner requires protection in.¹⁵⁵ One of the annexures to the application will be a confirmation by the South African Companies and Intellectual Property Commission (CIPC), which is South Africa’s local trade marks office, confirming that there is a corresponding South African national application. The CIPC will then proceed to forward the application for an international registration to Geneva.¹⁵⁶ WIPO will, in turn, forward copies of the application to the national registries of the foreign countries.¹⁵⁷

On condition that the application for an international registration reaches WIPO within two months of the date on which it was lodged at the CIPC, “the South African lodging date is the registration date of the international registration”,¹⁵⁸ failing which, the registration date will be considered the date on which the application was received by WIPO. WIPO further ensures that the application complies with all the necessary formalities. With such compliance, WIPO issues a certificate of registration to the trade mark owner, indicating that the trade mark is registered in the designated countries and the registration is advertised in a journal.¹⁵⁹ WIPO also sends the application to the national registries of the designated countries. These registries of these territories have a maximum of eighteen months thereafter, to raise objections to the trade mark being registered in their countries.¹⁶⁰ In each country the application is examined in accordance with domestic trade-mark legislation. If there is no contestation from these registries within the prescribed period, such as “non-distinctiveness or conflicting rights”, the international registration is valid in all the designated regions.¹⁶¹

¹⁵⁵ B Bennett ‘Study on the Accession to the Madrid System for the International Registration of Marks’ (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹⁵⁶ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

¹⁵⁷ H Muhlberg ‘The Wrong Crowd’ (2015) *Without Prejudice* 6

¹⁵⁸ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

¹⁵⁹ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

¹⁶⁰ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

¹⁶¹ H Muhlberg ‘The Wrong Crowd’ (2015) *Without Prejudice* 6

Within this simulated outlook of registering an international trade mark in South Africa through the Madrid Protocol, reference can be made to the earlier practical scenario involving Sipho, the businessman, as a trade mark owner in South Africa seeking to register his trade mark on an international basis. In the hypothetical instance that South Africa accedes to the Madrid Protocol, Sipho would no longer need to file separate applications to India, Spain and Australia, as he could rather designate these three member states of the Madrid Protocol in a single application to be forwarded to WIPO, and WIPO will then disseminate to each respective country's intellectual property office. However, if one of the countries in which Sipho sought to register his trade mark in is not a member state of the Madrid Protocol, it would require him to file another individual application to that country.¹⁶² This is a salient point to be addressed in the subsequent chapters, where global participation in accession to the Madrid Protocol has an impact on the efficiency and convenience associated with registering an international trade mark in terms of the Madrid Protocol. It is especially important in terms of cost and the engaging the services of more legal practitioners. Finally, if any objections surface in one of these countries, there is a route to challenge the case, however a local attorney is to be appointed.¹⁶³ For example in Sipho's situation, if the objection arises in Spain and the objections are maintained, the international registration will only remain valid in the other two countries.¹⁶⁴

2.5. CONCLUSION

It can be deduced from the existing system of international trade mark registration in South Africa that not only are there a great number of attorneys involved in this process, but it also involves the added administrative step of filing separate applications in each country, where there are "different documentation for each country".¹⁶⁵ In addition, trade mark owners will bear additional fees for registration and translation for each country they wish to apply for.¹⁶⁶ Muhlberg¹⁶⁷ is of the opinion that

¹⁶² H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 6

¹⁶³ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

¹⁶⁴ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

¹⁶⁵ F Al Sakkaf 'One Trade mark, One Application' (2018) 5(11) *Ct. Uncourt* 12

¹⁶⁶ F Al Sakkaf 'One Trade mark, One Application' (2018) 5(11) *Ct. Uncourt* 12

¹⁶⁷ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

the present trade mark system fails to acknowledge the vast differences in fees when registering a trade mark in countries of differing world development status. Countries that are ranked as first world countries are said to charge an “immodest fee” for an international trade mark registration, whereas third world to developing countries charge an inexpensive cost.¹⁶⁸

We can further infer that the procedure to register an international trade mark is more streamlined and cost-effective under the Madrid Protocol in comparison to the current practice for a South African trade mark owner to register an international trade mark.¹⁶⁹ Registration through the Madrid Protocol involves less bureaucracy and legal representation because “the owner does not have to appoint a local agent in every country to file for the application he would require only one agent to file for the trade mark”.¹⁷⁰ (further reducing costs) Therefore, it can be said that the simulated outlook of the international trade mark registration process that would exist under the Madrid Protocol, would be a progressive and more efficient step in registering international trade marks for South African trade mark owners.¹⁷¹

¹⁶⁸ H Muhlberg ‘It’s a Brave New World for Trade-mark Owners’ (2003) 426 *De Rebus* 21

¹⁶⁹ RH Thompson ‘International Trademark Protection Strategy’ (2010) 19 *J. Contemp. Legal Issues* 495

¹⁷⁰ F Al Sakkaf ‘One Trade mark, One Application’ (2018) 5(11) *Ct. Uncourt* 12

¹⁷¹ JM Samuels & LB Samuels ‘International Trademark Prosecution Streamlined: The Madrid Protocol Comes into Force in the United States’ (2004) 12 *J. Intell. Prop. L.* 160

CHAPTER 3: INTERNATIONAL PERSPECTIVE – A COMPARATIVE ANALYSIS

3.1. INTRODUCTION

Chapter three will consider the international landscape against which the Madrid Protocol operates, by drawing a comparison with countries to South Africa. The comparative countries selected have already acceded or are in the process of acceding to the Madrid Protocol.¹⁷² For the purpose of this dissertation, the countries of Zimbabwe, Botswana, Gambia, Brazil and India have been used for comparative analysis. By extrapolating material data from these countries, it may enable an articulation of the perceived consequences of South Africa's possible accession to the Madrid Protocol. This chapter will provide an analysis as to the nature of the experiences that each country has encountered when acceding to the Madrid Protocol, thus ultimately allowing for more informed preparation and efficient transition into the Madrid Protocol.¹⁷³

Initially, the comparative analysis will concentrate on countries that share a similar socio-economic and developing third-world status with South Africa. The basis on which comparisons can be made between South Africa and these developing countries, relate to various social indicators of development like wage gap, poverty, mortality, education, Gross Domestic Product, business development strategies as well as the basic resources of the countries.¹⁷⁴ Thereafter, the comparative analysis will proceed to democratic countries that share the status of a BRICS nation.¹⁷⁵ Another international country of a comparable standing to South Africa is Mexico,

¹⁷² B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

¹⁷³ P Kilmer 'The Madrid Protocol - Sea Change or Tempest in a Teapot?' (2003) 21(4) *IPL News*. 20

¹⁷⁴ V Møller 'Whatever Happened to Social Indicators in Africa? Whatever Happened Indeed! A Developing World Perspective on the Kenneth C. Land and Alex C. Michalos Report on "Fifty Years After the Social Indicators Movement"' 135 (3) *Social Indicators Research: An International and Interdisciplinary Journal for Quality-of-Life Measurement* 1011

¹⁷⁵ "BRICS is an acronym for the grouping of the world's leading emerging economies, namely Brazil, Russia, India, China and South Africa" – 'What is BRICS?' available at <http://www.brics2018.org.za/what-brics>, accessed on 7 September 2018

which share the status of a developing country.¹⁷⁶ Lastly, it is important to analyse the efficacy of the Madrid Protocol when operating within first world countries like Canada and New Zealand.

3.2. COMPARISON WITH AFRICAN COUNTRIES

Research suggests that surrounding African countries are making sound policy decision as well as maintaining a relatively stable political climate.¹⁷⁷ Therefore, the evolving legal jurisprudence and economic strategy that has emanated from other African countries will be of noteworthy importance to understanding the consequences that will ensue from the accession to the Madrid Protocol.¹⁷⁸ In addition, foreign investment has escalated due to a significant growth with regards to infrastructure, and these capitalists thereby seek security for the “protection and commercialisation of their intellectual property in Africa”.¹⁷⁹ Out of the 54 (fifty four) countries that exist in Africa, 21 (twenty one) countries have acceded to the Madrid Protocol, as well as the previously mentioned OAPI, which is a union of the seventeen African countries.¹⁸⁰ OAPI is a major African regional system that enables the securing of trade mark protection in its member countries by filing a single trade mark application.¹⁸¹ The significance of OAPI in its relationship with the Madrid Protocol, and the bearing that it has on South Africa’s accession to the Madrid Protocol is to be discussed in the next chapter. Ultimately, there are more than three quarters of Africa’s countries are member states of the Madrid Protocol at present, which bears testament to the evolution of WIPO’s Madrid Protocol in Africa.¹⁸² Therefore, consideration must be given to the evolving protection of intellectual property rights in Africa, as it can be said that a range of treaties exist which offer the national, regional and international

¹⁷⁶ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

¹⁷⁷ W Meiring ‘Africa: Africa and International Registrations’ (2015) *Managing Intell. Prop.* 1

¹⁷⁸ P Kilmer ‘The Madrid Protocol - Sea Change or Tempest in a Teapot?’ (2003) 21(4) *IPL Newsl.* 20

¹⁷⁹ S Brown & M Du Plessis ‘Easing International Registrations in Africa’ (2014) 238 *Managing Intell. Prop.* 60

¹⁸⁰ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 14

¹⁸¹ S Brown & M Du Plessis ‘Easing International Registrations in Africa’ (2014) 238 *Managing Intell. Prop.* 63

¹⁸² W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 14

registration of trade marks – such as OAPI and African Regional Intellectual Property Organization (ARIPO).¹⁸³

In the comparative analysis, each country observed will be used to highlight a particular experience when implementing the Madrid Protocol. These experiences not necessarily endemic to that specific country, but are rather the shared experiences within most African countries. Amongst the various issues to be discussed in detail with regards to international trade mark registrations in Africa, there are also general matters which permeate throughout Africa that need to be addressed before the detailed findings of each countries experiences with implementing the Madrid Protocol.¹⁸⁴

The use and enforcement of the Madrid Protocol when registering and protecting an international trade mark, requires considering whether the designated country in the application is a civil or common law country. A distinction must be drawn between countries termed as “civil law countries” and “common law countries”.¹⁸⁵ There is no legislative contention between Civil law countries and international agreements, where the obligations that arise from such treaties and conventions, are considered binding on the nation without implementation into domestic legislation as a requirement.¹⁸⁶ Common law countries in contrast have constitutions which establish a hierarchy of national laws, constitutional legislation and international law.¹⁸⁷ These countries employ a dualist approach in terms of domestic law and international law, meaning that provisions of an international treaty or agreement will be brought into effect when it is “expressly enacted and incorporated into domestic law”, as per the legislature’s

¹⁸³ ‘Intellectual Property in Africa: An Overview’ (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpFDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

¹⁸⁴ W Meiring ‘Africa: Africa and International Registrations’ (2015) *Managing Intell. Prop.* 1

¹⁸⁵ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 16

¹⁸⁶ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 16

¹⁸⁷ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 16

mechanisms established in that constitutional dispensation.¹⁸⁸ There are three means of transitioning international law into domestic law, which are as follows:

“The provisions of the treaty can be contained in an Act, the treaty can be included as a schedule to a statute, or lastly an enabling Act of Parliament can give the executive the power to make a treaty effective by means of a proclamation.”¹⁸⁹

In essence, an international treaty signed by a common law country can only become valid upon being formally incorporated into the country's domestic law through legislation.¹⁹⁰ Many of these common law countries have however, signed up to the Madrid Protocol and failed to merge the treaty into legislation.¹⁹¹ International registrations that have already been filed without the necessary amendments to national legislation, are considered invalid. Furthermore, where conflict arises between international and domestic law in this predicament, the domestic law prevails.¹⁹² There are consequently real doubts regarding the enforceability of international registrations in the common law countries, that have “failed to integrate the Madrid Protocol into domestic law”.¹⁹³

International registrations via the Madrid Protocol are being poorly administered by African countries that have been designated in the international trade mark application.¹⁹⁴ Poor administration amounts to a delayed turnaround time where the period between documents being received, until such time that the application is accepted or rejected, is overdue. The impediments created by the flawed administration has had a two-fold consequence. The first consequence is that the international trade mark applicant will only receive full trade mark protection once the

¹⁸⁸ ‘Intellectual Property in Africa: An Overview’ (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

¹⁸⁹ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.*17

¹⁹⁰ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.*1

¹⁹¹ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.*1

¹⁹² W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.*17

¹⁹³ J de Beer ... et al ‘The Intellectual Property Treaty Landscape in Africa, 1885 to 2015’ (2017) *Open Air Africa Innovation Research* 4

¹⁹⁴ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 14

trade mark has been registered and therefore any delays in registration, will result in delayed protection of the mark. The second consequence stems from the fact that in order for a local applicant to apply for an international registration, they require the base registration to be processed in the office of origin. It follows that any untimely administration in the base application would be detrimental to the business strategy of that local entrepreneur.¹⁹⁵

An additional cause for concern is that international trade mark registrations are not being utilized by African intellectual property owners to a great extent.¹⁹⁶ Statistics reveal, a marginal number of international registrations originate in African countries.¹⁹⁷ The Madrid Protocol consequently does not enable a significant advantages to the African population at this point in time.¹⁹⁸ Thus the concept of “one-way traffic” is prevalent in some African nations, where “foreign businesses are using the Madrid Protocol” as a way of attaining easy economical trade mark protection in Africa while the African local businesses are not using the Madrid Protocol to grow their business.¹⁹⁹ This is an unintended consequence of exercising the Madrid Protocol. Overall, the reality is that although WIPO may be eager to sign up more member states and promote the accession of less-developed countries to the Madrid Protocol, these countries are not yet prepared or equipped to manage implementation of the treaty as yet.²⁰⁰

3.2.1. Zimbabwe²⁰¹

Zimbabwe is an appropriate example of how the course of accession to the Madrid Protocol practically unfolds in a common law country. This deals with making provision for the Madrid Protocol in their national legislation, in order to secure the legitimacy of

¹⁹⁵ J de Beer ... et al ‘The Intellectual Property Treaty Landscape in Africa, 1885 to 2015’ (2017) *Open Air Africa Innovation Research* 4

¹⁹⁶ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 14

¹⁹⁷ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.* 1

¹⁹⁸ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 14

¹⁹⁹ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 14

²⁰⁰ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.* 1

²⁰¹ “Zimbabwe joined the Madrid Protocol in 2015” - W Meiring ‘Africa: Recent developments in African IP’ (2017) *Managing Intell. Prop.* 21

the international registrations that would designate Zimbabwe in their trade mark application.²⁰²

The process began by facilitating a series of meetings to deliberate its proposed accession to the Madrid Protocol, to which the decision was made by the Cabinet and approved by the House of Assembly and the Senate.²⁰³ In the interim, the relevant Zimbabwean legislation ceased to make reference to the Madrid Protocol. Meaning that this instrument of accession to the Madrid Protocol had not modified its domestic law to give effect to international registrations. Pending this action, the lawfulness of the international registrations that were processed came into question.²⁰⁴ Concerns regarding the legitimacy of international registrations designating Zimbabwe in an international trade mark application, have been allayed nearly two years after accession with the passing of the Trade Marks Regulation 2017.²⁰⁵ This regulation which gives recognition to the Madrid Protocol became operational later that year.²⁰⁶ This means that the Madrid Protocol is now enforceable in Zimbabwe having been incorporated into the domestic laws through an Act of Parliament.²⁰⁷ Despite Zimbabwe's ratification of the Madrid Protocol there is still circumspection surrounding trade marks filled through the Madrid Protocol in Zimbabwe. The reason for this uncertainty is due to the current paper-based process of filing trade mark registrations that Zimbabwe employs. The required digital IPAS programme is still being put into effect as a requirement of the Madrid Protocol.

Practical difficulties have persisted in Zimbabwe after ratifying the Madrid Protocol where there is still a lack of clarity at this stage as to whether the Zimbabwean registry

²⁰² Nyakoty S 'The Protection of Geographical Indications in Zimbabwe: An Overview of the Relevant Legislation, Institutional Framework and Mechanisms' (2013) 16 *The Journal of World Intellectual Property*. 190

²⁰³ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 63

²⁰⁴ W Meiring 'Beware When Using the Madrid Protocol in Africa' (2015) 248 *Managing Intell. Prop.* 16

²⁰⁵ Trade Marks (Madrid Protocol) Regulation of 2017

²⁰⁶ W Meiring 'Africa: Zimbabwe provides clarification on Madrid Protocol' (2017) *Managing Intell. Prop.* 9

²⁰⁷ S Brown ... et al 'Zimbabwe: Ratification of the Madrid Protocol' (2017) available at <https://www.adamsadams.com/news-insights/zimbabwe-ratification-madrid-protocol/>, accessed on 11 November 2018

will be able to successfully conduct examinations within the eighteen-month time period set by WIPO's Madrid Protocol.²⁰⁸ However, once the integration of the IPAS is complete and in use, not only is it possible that the Zimbabwean Intellectual Property Office (ZIPO) would then be able to examine applications within WIPO's timelines, but trust in the use of the Madrid Protocol as a tool for trade mark protection will be confirmed.²⁰⁹ Although the Zimbabwean Registry is relatively prompt in the administration of its intellectual property office, the implementation of the IPAS will probably be a time-consuming process due to registry backlogs, delays due to critical shortages in staff, and a lack of proper investment of funds by the Zimbabwean Government into the upgrading of ZIPO's operations.²¹⁰ These are also issues that persist in many African countries belonging to this international trade mark system.²¹¹

In light of South Africa also being a common law country, many of the issues of implementation faced by Zimbabwe are potentially significant to South Africa's implementation. In the instance that accession is pursued, South Africa would need to amend its domestic legislation to specifically mention and give effect to the Madrid Protocol. The incorporation of the Madrid Protocol into domestic legislation would be effected through inclusion in a schedule or a passing of enabling regulation or an amendment of the relevant legislation. If not, there would be uncertainty regarding the legality and enforceability of international registrations which designate South Africa as a country of choice for protection.²¹² As observed in Zimbabwe, the transition into this Madrid Protocol could be a potentially lengthy process for South Africa. This is especially relevant where Muhlberg confirms that the CIPC is already highly inundated with trade mark applications and cannot commit to the eighteen-month examination

²⁰⁸ W Meiring 'Africa: Zimbabwe provides clarification on Madrid Protocol' (2017) *Managing Intell. Prop.* 9

²⁰⁹ S Brown ... et al 'Zimbabwe: Ratification of the Madrid Protocol' (2017) available at <https://www.adamsadams.com/news-insights/zimbabwe-ratification-madrid-protocol/>, accessed on 11 November 2018

²¹⁰ S Brown ... et al 'Zimbabwe: Ratification of the Madrid Protocol' (2017) available at <https://www.adamsadams.com/news-insights/zimbabwe-ratification-madrid-protocol/>, accessed on 11 November 2018

²¹¹ W Meiring 'Africa: Zimbabwe provides clarification on Madrid Protocol' (2017) *Managing Intell. Prop.* 9

²¹² W Meiring 'Beware When Using the Madrid Protocol in Africa' (2015) 248 *Managing Intell. Prop.* 16

period required by the Madrid Protocol.²¹³ Thus, the initial implementation of the IPAS could potentially cause additional delays in South Africa's local trade mark registry.

3.2.2. Botswana²¹⁴

Botswana has successfully made alterations to their domestic legislation in order to give effect to their "obligations in terms of the Madrid Protocol".²¹⁵ This was specifically achieved with Botswana's Industrial Property Act 8 of 2010²¹⁶ and regulation²¹⁷ which both came into operation six years after accession to the Madrid Protocol.²¹⁸ The regulation offers specific provision for international registrations under the Madrid Protocol when a trade mark proprietor lists Botswana as a designated country in their application.²¹⁹ This recognition of the Madrid Protocol in the national legislation, ensures that the trade mark proprietor's rights are recognised, valid and enforceable.²²⁰

After passing the relevant enabling legislation in 2012, early 2016 saw Botswana's Registrar of Trade Marks declaring a failure to examine the eight thousand international trade mark applications received in terms of the Madrid Protocol since

²¹³ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

²¹⁴ "Botswana became a party to the Madrid Protocol in 2006" - 'Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)' available at http://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html, accessed on 8 May 2018

²¹⁵ 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

²¹⁶ Industrial Property Act, 2010 (Act No. 8 of 2010)

²¹⁷ Industrial Property Regulations, 2012 (S.I. 70 of 2012)

²¹⁸ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 60

²¹⁹ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 60

²²⁰ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 60

becoming a member country in 2006.²²¹ Trade marks were simply registered by default where examiners were unsure of how to proceed in processing the applications, conducting examinations and capturing the registrations.²²² The Registry officials overlooked the IPAS and reverted to recording new registrations in their register.²²³ Even though the Botswana Registry eventually phased into using the IPAS by the end of 2016, WIPO was informed in early 2017 that all of the data processed by the Botswana Registry on the IPAS database, had been lost.²²⁴ Hence one of the current issues being faced by the registry in respect of international registrations of trade marks, is proper record-keeping.²²⁵

Further enquiry suggests that the majority of the African member countries, including Botswana, often neglect to publish international registration designations. Moreover, on the occasion that they do, some fail to do so within the prescribed eighteen-month period for examination. A national registry's inability to maintain full and proper records of all registered trade mark rights is a pressing matter, as it inhibits the registry's ability to make major decisions.²²⁶ If a local search fails to furnish a business with a comprehensive and complete representation of the trade marks protected in a country, it makes it problematic for the business to ensure that there will be no objection to its trade mark application in that country. In addition, Botswana Registry's failure to advertise international registrations designating the country is detrimental to the business strategy of local and international companies.²²⁷ Without proper notice of new trade mark applications, the trade mark proprietor is prejudiced in challenging or

²²¹ ²²¹ S Hollis ... et al. 'Memorandum on the effectiveness of International (MADRID) Registrations in Africa' (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²²² ²²² S Hollis ... et al. 'Memorandum on the effectiveness of International (MADRID) Registrations in Africa' (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²²³ ²²³ S Hollis ... et al. 'Memorandum on the effectiveness of International (MADRID) Registrations in Africa' (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²²⁴ ²²⁴ S Hollis ... et al. 'Memorandum on the effectiveness of International (MADRID) Registrations in Africa' (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²²⁵ W Meiring 'Fresh concerns over the Madrid Protocol in Africa' (2017) *Managing Intell. Prop.* 1

²²⁶ W Meiring 'Fresh concerns over the Madrid Protocol in Africa' (2017) *Managing Intell. Prop.* 1

²²⁷ W Meiring 'Fresh concerns over the Madrid Protocol in Africa' (2017) *Managing Intell. Prop.* 1

opposing potentially similar marks.²²⁸ Trade mark owners are therefore urged to mitigate potential risk by conducting a national general trade mark search in any of the African member countries in which they seek protection, particularly those failing to maintain records of international registration designations.²²⁹

3.2.3. Gambia²³⁰

Like in Botswana, alterations were successfully made to domestic legislation which allowed for the ratification of the Madrid Protocol. However, following their accession, trade mark proprietors were cautioned to be mindful of a possibly superficial examination process conducted by the Gambian Registry.²³¹ This will mean that international registrations, that have not undergone suitable inspection could simply be considered valid by default. While it may be a fortunate exercise for the enterprise applying for the international registration to evade proper examination, this remains problematic. For example, a flawed examination or a lack thereof, opens the door to contesting a registration on the grounds that it was incorrectly accepted or where an aggrieved third party with earlier registered rights may apply for cancellation of the mark, on the grounds of it being “wrongly registered”.²³²

With an unusually low refusal rate of international trade mark applications, research confirms that there is a lack of thorough examination, or potentially any examination of the application.²³³ An alarming number of African registries fail to examine international registrations that designate their countries.²³⁴ This trend of “non-

²²⁸ S Hollis ... et al. ‘Memorandum on the effectiveness of International (MADRID) Registrations in Africa’ (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²²⁹ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.* 1

²³⁰ W Meiring ‘Africa: Gambia and Algeria join Madrid Protocol’ (2015) *Managing Intell. Prop.* 22 – “Gambia is the 21st African country or regional organisation to join the Madrid Protocol”

²³¹ W Meiring ‘Africa: Gambia and Algeria join Madrid Protocol’ (2015) *Managing Intell. Prop.* 22

²³² W Meiring ‘Africa: Gambia and Algeria join Madrid Protocol’ (2015) *Managing Intell. Prop.* 22

²³³ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.* 1

²³⁴ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 15 – “Legitimate examination of international registrations takes place in a few of African countries. It certainly happens in Algeria, Egypt, Madagascar, Morocco and Sudan. There is also examination in Kenya, Mozambique and Tunisia. However, the refusal percentage in these countries is very low indeed, and this does raise concerns.”

examination” can be attributed to a lack of infrastructure or perhaps the registry’s inability to comply with the eighteen-month time restriction placed by WIPO.²³⁵ Similar to Botswana, this jurisdiction has also failed to advertise international trade mark registrations in the wake of the Madrid Protocol.²³⁶ As previously discussed, the potential repercussions of non-examination and a lack of advertisement results a trade mark registration that could be questioned by an aggrieved third party.

There are still backlogs of pending trade mark applications at the Gambian Registry, making the current examination timeline in Gambia twenty-six months. An international trade mark application is likely to be examined outside of WIPO’s eighteen-month timeline. According to WIPO, the international trade mark application cannot be rejected after the eighteen-month time period has lapsed and the trade mark application and registration will have to be accepted by default. However, the registration can still be successfully opposed at this stage. Thus, this controversial action could potentially give the trade mark owner the false impression that they have secured protection for the international registration of their trade mark through statutory and enforceable trade mark rights in Gambia, when they in fact have not.²³⁷ Had the registration of an international trade mark included a more timeous examination process, the mark would have accepted or rejected accordingly. The delay experienced in the examination of the trade mark could be due to the slow implementation of the IPAS, especially where the majority of records are not yet computerised.²³⁸

It can be inferred from the facts above, that the validity and enforceability of the international trade mark registration affected in Gambia, may be problematic.²³⁹ This is not due to the legislative alterations made, but rather the poor examination process

²³⁵ W Meiring ‘Fresh concerns over the Madrid Protocol in Africa’ (2017) *Managing Intell. Prop.* 1

²³⁶ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 16

²³⁷ S Hollis ... et al. ‘Memorandum on the effectiveness of International (MADRID) Registrations in Africa’ (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²³⁸ S Hollis ... et al. ‘Memorandum on the effectiveness of International (MADRID) Registrations in Africa’ (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

²³⁹ W Meiring ‘Examining the Madrid Protocol in Africa’ (2016) 263 *Managing Intell. Prop.* 16

associated with Gambia's intellectual property office. The experiences of the Gambian Registry can be considered evidence of a flawed implementation of the Madrid Protocol, as a result of inadequate infrastructure and improper administration.

3.2.4. Conclusion

It can be inferred from the challenges faced in the aforementioned countries, that there are potential problems at various stages in the process of accession. However, now that these issues have been identified and therefore brought to South Africa's attention, it is possible to be proactive and counteract these challenges, thus allowing for a more seamless transition of the Madrid Protocol. From the findings above, it is evident that improper administration of the Madrid Protocol is one of the difficulties in the implementation of the treaty that is shared between some of these African member states. Examples of this can be found in not adhering to time limits imposed by the system, as well as the purely cursory examination process of the trade mark application.²⁴⁰ In the instance that the international trade mark registration is not effectively examined, it can be deduced that the trade mark proprietor's rights would be vulnerable to litigation by a third party, which is an unfavourable outcome.²⁴¹

While it is a testament to the efficiency of the Madrid Protocol that international enterprises are predominantly able to effectively use the Madrid Protocol for trade mark protection in Africa, the validity of these international registrations that designate numerous African countries comes into question.²⁴² This issue presents itself in the instance that a common law country that has joined the international trade mark registration system or signed the international treaty in question, however fails to

²⁴⁰ 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

²⁴¹ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 63

²⁴² J de Beer ... et al 'The Intellectual Property Treaty Landscape in Africa, 1885 to 2015' (2017) *Open Air Africa Innovation Research* 21

formally and specifically integrate it into national law.²⁴³ Thus, it can be deduced that South Africa would have to follow a similar route of making legislative adjustments to avoid any issues of validity and enforceability that may arise.²⁴⁴ From the above information, one can deduce that a trade mark proprietors with trading activity in Africa or who is aiming to develop into the continent of Africa should form a “strategic intellectual property policy” which incorporates the Madrid Protocol in order to have an effective intellectual policy.²⁴⁵

The policy should consider nations that are members of the Madrid Protocol and are operating efficiently for the successful enforcement of international registrations. In this regard, complete trade mark protection in South Africa will not be instantaneous, however with strategic preparation and sound financial arrangements to enable infrastructure on South Africa’s behalf, international trade mark proprietors can benefit from expanding their business enterprises in Africa.²⁴⁶

3.3. COMPARISON WITH OTHER INTERNATIONAL COUNTRIES

It is essential to consider countries of different statuses as developing countries have different concerns to developed countries. Countries that are considered to hold the status of developing countries and share a common economic ethos (BRICS)²⁴⁷ are Brazil and India, In order to provide an international contextual analysis in relation to the implications of the Madrid Protocol on entrepreneurs and established businesses,

²⁴³ ‘Intellectual Property in Africa: An Overview’ (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

²⁴⁴ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 16

²⁴⁵ S Brown & M Du Plessis ‘Easing International Registrations in Africa’ (2014) 238 *Managing Intell. Prop.* 63

²⁴⁶ S Brown & M Du Plessis ‘Easing International Registrations in Africa’ (2014) 238 *Managing Intell. Prop.* 63

²⁴⁷ AB Deorsola ... et al ‘Intellectual Property and trade mark legal framework in BRICS countries: A comparative study’ (2017) 49 *World Patent Information* 8 - Brazil, India, China and South Africa are on similar level of socio-economic development. The BRICS countries have undertaken significant amendments in their intellectual property systems, changed their laws and become signatories to various conventions, treaties and agreements.

an analysis of Mexico will be conducted.²⁴⁸ Aside from the African countries and developing countries analysed in this dissertation, Canada and New Zealand are countries that will also be considered in this chapter in order to analyse the effectiveness of the Madrid Protocol when functioning within a developed country.

3.3.1. DEVELOPING INTERNATIONAL COUNTRIES

3.3.1.1. Brazil²⁴⁹

Amidst conditions of “political democratization and economic liberalization”, the Council of Ministers of the Brazilian Chamber of Foreign Trade of the Federal Government (CAMEX) recommended and approved Brazil's accession to the Madrid Protocol, indicating that the nation is finally set to join WIPO's international trade mark system.²⁵⁰ The text of the Protocol has already been signed and is awaiting ratification in Congress.²⁵¹ The path leading up to Brazil joining the Madrid Protocol is an apt portrayal of the different obstacles that are presented at the fore of accession. This country's accession is especially worthy of analysis as it is currently in the penultimate stage of bringing the Madrid Protocol into effect. Legal practitioners have however been divided in their opinions concerning the effects of Brazil's accession to the Madrid Protocol.²⁵²

Supporters of this step acknowledge that the Madrid Protocol is not the definitive solution to the Brazilian Patent and Trade mark Office's (BPTO) issues, but have remarked that a positive outcome would be dependent on the success of IPAS. It has been indicated that the implementation of the IPAS programme is a significant step toward acceding. Recent developments were initially well-received by the legal fraternity, expressing how economically beneficial it will be for the export of products, as stakeholders would have already established a secure business identity through

²⁴⁸ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

²⁴⁹ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

²⁵⁰ AB Deorsola ... et al 'Intellectual Property and trade mark legal framework in BRICS countries: A comparative study' (2017) 49 *World Patent Information* 3

²⁵¹ J Nurton 'Brazil commits to joining Madrid System' (2016) *Managing Intell. Prop.* 42

²⁵² J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

their intellectual property rights.²⁵³ However, Brazil's late accession can be attributed to various reasons, such as the country's change in political will which interfered with attempts to pass the required legislation and the potential disruption that accession would have on negotiations between the Brazilian government in the scope of multilateral treaties.²⁵⁴ Furthermore, prior to signing the treaty, Brazil will have to deliberate on matters like delays from the backlog of applications at the BPTO as well as applicable and additional fees.²⁵⁵

One of the crucial challenges that the BPTO does currently face, is dealing with its backlog of trade mark applications by reducing the examination time from thirty months to eighteen months, as required by Madrid Protocol.²⁵⁶ In an attempt to reduce this backlog, the BPTO has identified that this will be achieved by employing additional examiners and fast-tracking unopposed applications.²⁵⁷ In addition joining the Madrid Protocol is generally criticised due to the BPTO's lack of resources required to effectively manage accession. Thus, in order to adhere to the terms provided for in the Madrid Protocol, the national offices that are member states of the treaty would have to "undertake efforts to advance its infrastructure and procedures".²⁵⁸ Specific consideration should be given to the language impediments, where Brazilian law requires all official communication to be in Portuguese, however the Madrid Protocol only accepts applications in English, French and Spanish.²⁵⁹ One can deduce that where elements like political instability and economic fluctuations bear influence on the Brazil's efforts in acceding to the Madrid Protocol, such elements will similarly have an impact on how South Africa proceeds to implement the treaty. This issue of language will be expanded on later in this chapter with the comparative analysis of Mexico.

²⁵³ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

²⁵⁴ A Pyrah 'Problems as Mexico Joins Madrid Protocol' (2013) 228 *Managing Intell. Prop.* 9

²⁵⁵ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

²⁵⁶ I Cardozo, H Fernandes & R Rocha 'Responding adeptly to Brazil's trade mark system' (2018) *Managing Intell. Prop.* 1

²⁵⁷ J Nurton 'Brazil commits to joining Madrid System' (2016) *Managing Intell. Prop.* 42

²⁵⁸ AB Deorsola ... et al 'Intellectual Property and trade mark legal framework in BRICS countries: A comparative study' (2017) 49 *World Patent Information* 8

²⁵⁹ A Pyrah 'Problems as Mexico Joins Madrid Protocol' (2013) 228 *Managing Intell. Prop.* 8

A widespread issue delaying the implementation of the Madrid Protocol, is the lack of awareness amongst the public and local businessmen about the benefits of protecting intellectual property rights. Academics declare that Brazil is yet to evolve into an enlightened community with a belief in the advantages of intellectual property.²⁶⁰ It has been recognized that there is a need for entrepreneurs to be more conscious of intellectual property, in terms of safeguarding intangible rights that are potentially a source of economic growth.²⁶¹ By dedicating greater economic resources to educating the community, it not only improves the knowledge of individuals who may benefit from the Madrid Protocol, but also dispels any preconceived notions about the intricacies of this international trade mark registration system.²⁶² The education of potential trade mark owners should be actioned by the CIPC so that the value in protecting intellectual property could be better understood and incorporated into a business's growth strategy.

3.3.1.2. India²⁶³

India has successfully enacted legislation to enable accession to the Madrid Protocol.²⁶⁴ In the years preceding accession to the Madrid Protocol, the Indian government has laid extensive groundwork in preparation for the Madrid Protocol. With Indian products entering the global marketplace, it demanded an international approach be taken in securing brand protection for local businesses. India was previously reluctant to adopting this approach, especially with regards to the registration of its trade marks.²⁶⁵ However, their outlook has changed for the better.

²⁶⁰ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

²⁶¹ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

²⁶² M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

²⁶³ "India acceded to the Madrid Protocol for the International Registration of Trade marks on 8 April 2013 and came into force on 8 July 2013" - 'Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)' available at http://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html, accessed on 8 May 2018

²⁶⁴ U Pathak 'Madrid Protocol and Indian Trade Mark Law: a critical analysis' (2016) 5(2) *The Clarion* 52

²⁶⁵ R Prassas 'On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks' (2004) 32 *Int'l Bus. Law.* 213

During the transition into the Madrid Protocol, there were also ongoing administrative reforms taking place in India. However, it was established that India need not wait until such reforms were fully completed to sign and implement the Protocol.²⁶⁶ Thus, it is a potential option for South Africa to accede to the Madrid Protocol on a partly exempted basis through partial reforms, once the legislative changes have covered satisfactory ground to meet the obligations of the Madrid Protocol on a “partially exempted basis”.²⁶⁷

An operational issue that India’s intellectual property office faces, is how unaccustomed people are to the electronic filing of trade mark applications.²⁶⁸ There is only a small percentage of electronic applications being filed whereas the majority of applicants file a paper-based application.²⁶⁹ Updating trade mark owners and attorneys on the new e-filing practices, has impacted remedying the technological knowledge drought in India.²⁷⁰ The preparation carried out for India’s accession to the Madrid Protocol, involved recruiting more trade mark examiners and information technology trained personnel for the intellectual property office, which was especially necessary in light of the resistance to a digitized filing system. Furthermore, lengthy opposition proceedings also accumulated into a considerable backlog. Another measure taken in preparation for the Madrid Protocol, was to make the general search for trade mark registrations, open to the public. This task would usually require a trade mark proprietor visiting the intellectual property office, and having to pay for an electronic search - whereas in other countries it is of no charge. This is something that South Africa could put into practice before acceding to the Madrid Protocol, by reorganising the trade mark registry and bringing order to the trade mark registration system, rather than in the midst of accession and in time for the Madrid protocol to become operational.²⁷¹

²⁶⁶ R Prassas ‘On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks’ (2004) 32 *Int’l Bus. Law.* 215

²⁶⁷ R Prassas ‘On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks’ (2004) 32 *Int’l Bus. Law.* 215

²⁶⁸ P Ollier ‘India Prepares for Madrid Protocol’ (2010) *Managing Intell. Prop.* 35

²⁶⁹ P Leung ‘India accedes to the Madrid Protocol’ (2013) 230 *Managing Intell. Prop.* 69

²⁷⁰ J Nurton ‘India accession boosts Madrid System’ (2013) 2 *Managing Intell. Prop.* 53

²⁷¹ I Du Plessis ‘Madrid Protocol: Issues in Africa’ (2015) available at <https://www.ensafrica.com/news/Madrid-Protocol-issues-in-Africa?Id=1801&STitle=IP%20ENSight>, accessed on 23 February 2018

Another problem amongst the Indian business community, is an indifference to the Madrid Protocol, which can be attributed to a lack of awareness about the treaty.²⁷² Companies had no clear information on the procedural simplicity of the Madrid Protocol as afforded by its “centralized processing systems”.²⁷³ This misconception became prevalent where domestic industries were under the impression that the Madrid Protocol was complex in procedures and involved high transaction costs.²⁷⁴ In order to remedy this situation various campaigns and workshops were facilitated by the Indian government, in different regions of the country.

This brought the Madrid Protocol to the Indian public, especially those with business interests. These campaigns entailed three key phases. The first phase involved with creating awareness about the strategic economic benefits of the Madrid Protocol and the application filing procedures. Strategic economic benefits include “sustainable competitive advantage”, “integration with Global Supply Chain”, “development of product life cycle” and “optimization of franchising potential”.²⁷⁵ The second phase dealt with preparing the necessary documentation required for registering an international trade mark. The third phase involved ‘Partnership Summits’. The third phase was conducted to partner Indian entrepreneurs and Indian companies that have opted for international trade mark registrations through the Madrid Protocol. This is to ultimately encourage domestic Indian companies and small to medium sized enterprises to use the Madrid Protocol.²⁷⁶

²⁷² P Leung ‘India accedes to the Madrid Protocol’ (2013) 230 *Managing Intell. Prop.* 69

²⁷³ ‘How the Madrid System Works: The International Trade mark Registration Process’ available at http://www.wipo.int/madrid/en/how_madrid_works.html, accessed on 14 August 2018

²⁷⁴ A Damodaran & M Sundaram ‘Madrid System Market Research in India: Marketing Campaign in India for International Registration of Trade Marks’ (2016) 15 – available at http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf, accessed on 14 December 2018

²⁷⁵ A Damodaran & M Sundaram ‘Madrid System Market Research in India: Marketing Campaign in India for International Registration of Trade Marks’ (2016) 17 – available at http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf, accessed on 14 December 2018

²⁷⁶ A Damodaran & M Sundaram ‘Madrid System Market Research in India: Marketing Campaign in India for International Registration of Trade Marks’ (2016) 19 – available at http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf, accessed on 14 December 2018

Where BRICS markets need to be attractive to long-term international investors to “sustain growth and expansion”, it requires having an efficient national intellectual property office. Intellectual property systems are pivotal in upholding intellectual property rights that are integral to business innovation.²⁷⁷ While accession to the Madrid protocol is undoubtedly a pragmatic effort on the part of India, there are certain apprehensions that are yet to be addressed and the advantages will only become more apparent in time, for both local industries and outside investors.²⁷⁸ Accession to the Madrid Protocol becomes mutually beneficial to India and its trading partners across the world, where the economic gains that accrue to Indian trade mark owners from conveniently obtaining registrations abroad, equate to the same benefits that granted to foreign marks in India’s jurisdiction.²⁷⁹

South Africa can steadily follow in the footsteps of India by facilitating workshops and campaigns to educate the general public as well as those in the strategic environment that are business people. It is especially important for an economically developing BRICS country to prioritize its intellectual property directives and hone a culture of being “intellectual property-wise”.²⁸⁰ Where substantial investments of funds in upgrading the infrastructure of India’s trade mark offices may mitigate against the negative consequences in implementation. Developments in infrastructure are a critical venture, as seen in Brazil, and will therefore will be vital for South Africa in order to accommodate the particulars of the Madrid Protocol.²⁸¹ In order to ensure that accession to the Madrid Protocol is conducted with ease in South Africa, it would require the efforts of the CIPC in employing more registrars or trade mark examiners that are proficient in e-filing services for the purposes of implementing the IPAS. It can be further deduced that South Africa could secure the accession to the Madrid Protocol as a seamless process by setting aside a budget in advance to improve general administration at the CIPC.

²⁷⁷ G Bhattacharyya ‘IP protocol puts India on the map’ (2013) 27(30) *Lawyer* 9

²⁷⁸ G Bhattacharyya ‘IP protocol puts India on the map’ (2013) 27(30) *Lawyer* 9

²⁷⁹ Salhotra, A & Khan S ‘Accession to the Madrid Protocol’ (2010) 202 *Managing Intellectual Property* 41

²⁸⁰ R Prassas ‘On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks’ (2004) 32 *Int’l Bus. Law.* 211

²⁸¹ AB Deorsola ... et al ‘Intellectual Property and trade mark legal framework in BRICS countries: A comparative study’ (2017) 49 *World Patent Information* 8

3.3.1.3. Mexico²⁸²

Mexico experienced an array of difficulties in implementing the Madrid Protocol. Reservations stemmed from the fact that this accession to the Madrid Protocol was seemingly more beneficial to foreign enterprises, as international trade mark applications by domestic entrepreneurs were generally uncommon in Mexico.²⁸³ With most local Mexican companies uninterested in protecting their trade mark overseas, it is however worth acknowledging that there is a minority of Mexican companies that are “multinational corporations” that find the capability of filing trade marks in several countries at once, to be economically advantageous.²⁸⁴ Mexican entrepreneurs and businesses who are however, filing national trade mark applications to protect their intellectual property rights have to contend with the likes of numerous international competitors filing applications under the Madrid Protocol.²⁸⁵ The consequence of this is that the national trade mark applications of local Mexican businesses (that require this base registration before even considering an international trade mark application in terms of the Madrid Protocol) are being overstepped by the bigger and even foreign corporations that have well-secured national trade marks. Hence, local entrepreneurs and small to medium-size companies currently lack confidence in the Madrid Protocol as it appears that the effect of the Madrid Protocol is to allow established foreign business to grow at a faster rate than local entrepreneurs.

Moreover, for a brief period after accession, Mexico still lacked a trade mark opposition system which generated further issues for domestic businesses in the use of the Madrid Protocol.²⁸⁶ A trade mark opposition system is “a fair and legitimate way” of permitting interested parties to “raise objections” with the country's trade mark office, which in this instance is the Instituto Mexicano de la Propiedad Industrial or the

²⁸² “The Madrid Protocol came into effect in Mexico on February 2013. Mexico is the 89th member of the international trade mark system, after depositing its instrument of accession with WIPO” - ‘Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)’ available at http://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html, accessed on 8 May 2018

²⁸³ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

²⁸⁴ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

²⁸⁵ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

²⁸⁶ A Pyrah ‘Madrid comes into effect in Mexico’ (2013) 228 *Managing Intell. Prop.* 101

Mexican Institute of Industrial Property (IMPI).²⁸⁷ Mexico previously relied on a lengthy trade mark cancellation procedure, which provided that a trade mark could not be “revoked until after it had been granted”.²⁸⁸ This was a problem because it allowed trade mark protection for marks that should never have passed muster. Hence, domestic establishments were not competing on the same level as those of countries which did have a trade mark opposition system.²⁸⁹ Mexico’s trade mark opposition system only took effect in 2016, nearly three years after accession to the Madrid Protocol.²⁹⁰ It is worth acknowledging this hurdle faced by IMPI, will not have to be dealt with by South Africa, as the CIPC already has a trade mark opposition system in place. This comparative analysis of Mexico illustrates a distinguishing factor from South Africa, that may be South Africa’s benefit in the process of acceding to the Madrid Protocol.

Promoting the Madrid Protocol has been achieved by asking Mexican businesses that have used the system to arrange giving smaller local companies advice on the best practices and why they should pursue the Madrid Protocol. IMPI requires an increase in the participation of Mexican companies in the Madrid Protocol, but the main directive is to develop an intellectual property culture in Mexico.²⁹¹ Mexico also claimed that its intellectual property office had no backlog to contend with, as applications were dealt with within four to five months.²⁹² Even though this is well within international standards, it is likely that the lack of a backlog could be attributed to lack of a trade mark opposition system at the time.²⁹³ Thus, with the introduction of a trade mark opposition system in Mexico under the Madrid Protocol, trade mark applications are coming in more frequently, to which a backlog would arise.²⁹⁴ It has also recently surfaced that when using the Madrid Protocol for the prosecution of trade mark applications in Mexico, a successful registration can take between five to eighteen

²⁸⁷ A Pyrah ‘Why Mexico needs a trade mark opposition system’ (2013) 229 *Managing Intell. Prop.* 68

²⁸⁸ A Pyrah ‘Why Mexico needs a trade mark opposition system’ (2013) 229 *Managing Intell. Prop.* 68

²⁸⁹ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

²⁹⁰ JM Murphy ‘The New Trademark Opposition System in Mexico’ (2017) 107(3) *The Trademark Reporter* 747

²⁹¹ ‘Mexico off to a good start with Madrid’ (2014) 241 *Managing Intell. Prop.* 51

²⁹² ‘Mexico off to a good start with Madrid’ (2014) 241 *Managing Intell. Prop.* 51

²⁹³ L Collada & A Galvez ‘Madrid System and Mexico’s Opposition System’ (2016) 263 *Managing Intellectual Property* 86

²⁹⁴ JM Murphy ‘The New Trademark Opposition System in Mexico’ (2017) 107(3) *The Trademark Reporter* 747

months.²⁹⁵ This backlog will result in subsequent delays and therefore lengthen the set timeframe for an international trade mark registration.²⁹⁶

The most recent topic of concern for Mexico is the translation problems faced when designating Mexico as a country within the application that seeks to obtain international protection for trade marks.²⁹⁷ Where the official language of Mexico is one of WIPO's prescribed languages, there have been translation issues relating to the "descriptions of products or services as described in Spanish by WIPO". Due to permutations as a result of the descriptions being translated in international trade mark applications, IMPI issued many provisional refusals of such applications.²⁹⁸

In light of the earlier findings regarding Mexico's experiences of effecting the Madrid Protocol, it can be said that there has been an improvement since accession. At the outset of Mexico's accession to the Madrid Protocol the trade mark registry experienced numerous problems, as set out in the preceding paragraphs. However, since 2015, Mexico overcame these issues over the years allowing for the seamless integration of the Madrid Protocol in this jurisdiction. Overall, this was a legislative step that was not originally well received amongst the Mexican community but with time a positive path of progression lead to more recent advantages and benefits.

Observing these challenges faced by Mexico during the implementation of the Madrid Protocol within a South African context, reveals some issues that are of relevance to the South African Intellectual community – as well as some issues that are not as critical to South Africa's accession to the Madrid Protocol. Where the domestic businesses of South Africa would similarly have to compete with the larger franchises and companies in applying for a national trade mark registration, it would be necessary for the CIPC to arrange its office so as to allow for a flow of applications and registrations for both national and international trade marks to occur simultaneously.

²⁹⁵ M Garcia 'Mexico: Disadvantages of the Madrid Protocol' (2015) *Managing Intell. Prop.* 18

²⁹⁶ JM Samuels & LB Samuels 'International Trademark Prosecution Streamlined: The Madrid Protocol Comes into Force in the United States' (2004) 12 *J. Intell. Prop. L.* 160

²⁹⁷ CS Olivares & CPL Ogazón 'Mexico: Avoid translation problems when using the Madrid Protocol' (2015) *Managing Intell. Prop.* 26

²⁹⁸ CS Olivares & CPL Ogazón 'Mexico: Avoid translation problems when using the Madrid Protocol' (2015) *Managing Intell. Prop.* 26

In the preliminary stages of accession to the Madrid Protocol, the CIPC would also have to take similar steps as Mexico by appealing to major corporations that have registered trade marks internationally to promote its use amongst smaller local companies. This would spur greater participation from primarily domestic establishments to create this business identity.

Another difficulty experienced by Mexico in its implementation of the treaty, that is unlikely to be experienced by South Africa, is the language barrier. This is unlikely to pose a potential problem in South Africa as there are eleven official languages of which English is included, but not Spanish and French. The general rule for trade mark applications to the CIPC is that all applications to CIPC must be in English, which is efficient as it is a widely-spoken language in South Africa and is also the language in which business is usually conducted. Therefore, the only possibility of translational issues that could be of consequence for South African trade mark owners could be experienced on the ground level, where non-English speakers are filing trade mark applications with the CIPC. In order to properly understand and comprehend the particulars of the national trade mark application being made, the expertise of translators would have to be enlisted in this regard. To close the comparative analysis between Mexico and South Africa, it is to be noted that amongst these developing countries, the true benefits and successes of the treaty only take shape over time.

3.3.1.4. Conclusion

Amongst countries that are third world developing countries, South Africa is much like Brazil and India, in that it will have to improve its own trade mark office before it can adopt the Madrid Protocol.²⁹⁹ However, it is not an impossible task to concurrently make changes and work on accession to the Madrid Protocol. As seen in Brazil, the preliminary stages of joining this international trade mark registration system, were impeded by a culmination of political instability, resistance from intellectual property

²⁹⁹ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

specialists and backlogs at the BPTO.³⁰⁰ It can be said that with the prospective economic, legal and practical concerns that could develop with the implementation of the Madrid Protocol and in the wake of pursuing the demands of a global regime, South Africa may fall victim to such impediments. However, these challenges can be navigated on the journey to accession.³⁰¹ Where the scope of intellectual property rights is critical for international investors, it is imperative that accession to the Madrid Protocol is managed efficiently, especially for BRICS countries to uphold their status as “leading emerging economies”.³⁰² This stems from the economic value inherent to trade marks.³⁰³ What can be construed from this general overview of the encounters experienced by developing countries in their journey to the Madrid Protocol, is that based on a principle of similarity, South Africa’s potential accession to the Madrid Protocol will transpire in a similar fashion to those of the developing countries.³⁰⁴

3.3.2. DEVELOPED INTERNATIONAL COUNTRIES

3.3.2.1. Canada

Canada is presently amongst the few developed countries that have not acceded to the Madrid Protocol as yet. This jurisdiction was falling behind in the intellectual property landscape, where the majority of developed nations are thriving. However, Canada announced this year, that it is on the path to joining the Madrid Protocol.³⁰⁵ Canada is currently refining the regulations to its Trade-marks Act³⁰⁶ and making the

³⁰⁰ J Nurton ‘Brazil commits to joining Madrid System’ (2016) *Managing Intell. Prop.* 42

³⁰¹ S M O’Coin ‘Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries’ (2011) 15 *Holy Cross J.L. & Pub. Pol’y* 276

³⁰² ‘What is BRICS?’ available at <http://www.brics2018.org.za/what-brics>, accessed on 7 September 2018

³⁰³ AB Deorsola ... et al ‘Intellectual Property and trade mark legal framework in BRICS countries: A comparative study’ (2017) 49 *World Patent Information* 8

³⁰⁴ S M O’Coin ‘Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries’ (2011) 15 *Holy Cross J.L. & Pub. Pol’y* 276

³⁰⁵ ‘Canada Announces Plans to Accede to Madrid Protocol’ (2018) available at https://www.wipo.int/madrid/en/news/2018/news_0009.html, accessed on 11 December 2018

³⁰⁶ Trade-marks Act (R.S.C., 1985, c. T-13)

essential changes to its technological systems to file international trade marks electronically.³⁰⁷

Where the Madrid Protocol and its particulars fall within the spectrum of international law, it is necessary to briefly consider the foundational principles of this area of law. One of which, relates that “international rights depend on a basic registration”.³⁰⁸ In accordance with this principle, these rights can be revoked by invalidating a trade mark proprietor’s national registration or basic mark.³⁰⁹ In relation to the Madrid Protocol, there is a five-year timeframe in which the international designations (which equate to international rights) are linked to the base application or basic registration in the country of origin.³¹⁰ In terms of Article 6 of the Madrid Protocol³¹¹, if the base registration fails for any reason through rejection, deletion, cancellation and expiration of trade marks, during the first five years of the international registration, then all international designations listed in the primary international trade mark application, cease to exist as well.³¹² This is described as a “central attack”. The original trademark owner would therefore lose trade mark protection in all the jurisdictions in which it had registered via the Madrid Protocol, even if its trade mark was still acceptable and valid in those countries.³¹³

This is the potential dilemma currently faced by most first world countries and developed nations that have acceded to the Madrid Protocol.³¹⁴ Legal experts point out that this provision of the Madrid Protocol which elicits a “central attack”, and is termed accordingly for attacking the central trade mark registration on which all other

³⁰⁷ ‘Canada Announces Plans to Accede to Madrid Protocol’ (2018) available at https://www.wipo.int/madrid/en/news/2018/news_0009.html, accessed on 11 December 2018

³⁰⁸ I Haleen and AL Scoville ‘United States Ratifies the Madrid Protocol: Pros and Cons for Trademark Owners’ (2003) 15(4) *Intellectual Property & Technology Law Journal*. 2

³⁰⁹ R Prassas ‘On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks’ (2004) 32 *Int’l Bus. Law*. 211

³¹⁰ A Ramanujan ‘Reflections on the Indian Accession to the Madrid Protocol’ (2008) 13 *Journal of Intellectual Property Rights* 112

³¹¹ Article 6 of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

³¹² C Samuels ‘A Big Push toward E-Government: The United States Patent and Trademark Office and the Implementation of the Madrid Protocol’ (2004) 14 *Alb. L.J. Sci. & Tech.* 542

³¹³ C Samuels ‘A Big Push toward E-Government: The United States Patent and Trademark Office and the Implementation of the Madrid Protocol’ (2004) 14 *Alb. L.J. Sci. & Tech.* 542

³¹⁴ L Hudson ‘The Madrid Protocol - seven months on’ (2013) 234 *Managing Intell. Prop.* 34

international registrations are based, is one of the treaty's main disadvantages. The essentialia of "central attack" stem from the strong dependency by the Madrid Protocol member states on the basic mark or basic registration. The trade mark holder is however provided with a solution for the expungement of the home registration in terms of the Madrid Protocol. The solution, found in Article 9quinquies of the Madrid Protocol³¹⁵, prevents the central attack by a "transformation system".³¹⁶ This provision of the treaty gives the trade mark owner three months in which to transform the international trade mark registration into several separate national trade mark applications in those other countries designated in the initial application.³¹⁷ Even though this remedy circumvents central attack, this would unfortunately eliminate any initial savings in cost that were originally made. Furthermore, where the holder of the international trade mark has three months before this original base registration fails, in order to avoid losing its priority filing date, this means that the trade mark application will be treated as if it has been filed on the same day as the original international trademark registration.³¹⁸ The registration will retain its priority, on the condition that it meets the requisite minimum standards.³¹⁹

Even though Canada has not acceded to the Madrid Protocol, it serves to illustrate that even as a developed country, the Canadian Intellectual Property Office (CIPO) still had to handle issues of amending legislation and configuration of e-services for the phasing in of the IPAS, which is similar to the efforts of intellectual property offices in developing nations that are also proceeding to join the Madrid Protocol. In this regard, it is therefore quite possible for the developing nations to progress to this level of advancement. If developing countries like Brazil and India are experiencing the same implementation issues as a developed first world country, it puts these developing countries on a similar footing for comparison. This makes for motivation for underdeveloped and developing nations to accede to the Madrid Protocol, where

³¹⁵ Article 9quinquies of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)

³¹⁶ C Samuels 'A Big Push toward E-Government: The United States Patent and Trademark Office and the Implementation of the Madrid Protocol' (2004) 14 *Alb. L.J. Sci. & Tech.* 542

³¹⁷ C Samuels 'A Big Push toward E-Government: The United States Patent and Trademark Office and the Implementation of the Madrid Protocol' (2004) 14 *Alb. L.J. Sci. & Tech.* 542

³¹⁸ DL Barch 'Navigating the Madrid Protocol: A New Global Regime for the International Registration of Trade marks' (2003) 8 (2) *Intell. Prop. L. Bull.* 17

³¹⁹ 'Rules of Practice for Trademark-Related Filings under the Madrid Protocol Implementation Act' (2005) 20(1) *Berkeley Technology Law Journal* 253

the issues to be experienced are shared or can even avoided through thorough preparation.

Upon Canada's likely accession to the Madrid Protocol, it is critical for Canadian industries that are trade mark owners to conduct thorough searches in the jurisdictions it decides to designate, "seeking to use their Canadian mark of record as a base for a Madrid Protocol international registration".³²⁰ Thorough searches would need to be conducted in both the CIPO and WIPO trade mark databases, along with any other relevant searches such as "company names, domain names, common law marks and names".³²¹ This will assist in identifying risks such as a "central attack".³²²

3.3.2.2. New Zealand³²³

The Trade Marks Amendment Act³²⁴ was passed to enable New Zealand to accede to the Madrid Protocol.³²⁵ While regulations governing the operation of the international trade mark registration system still need to be developed, it is anticipated that New Zealand will take an implementation route adopted in other first world countries like Australia, Singapore, the United Kingdom and the United States of America.³²⁶ Since acceding to the Madrid Protocol, the Intellectual Property Office of New Zealand (IPONZ) has observed strong interest from local businesses in New Zealand seeking to take advantage of the international benefits afforded by the Madrid Protocol system to protect their trade marks in overseas markets.³²⁷ There are numerous applications with many listed designations for international protection filed with IPONZ as the office of origin.³²⁸ The jurisdictions that New Zealand companies and individuals are

³²⁰ CM Aide 'Madrid by way of Ottawa: Tips and Traps for the International Registration System' (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

³²¹ CM Aide 'Madrid by way of Ottawa: Tips and Traps for the International Registration System' (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

³²² CM Aide 'Madrid by way of Ottawa: Tips and Traps for the International Registration System' (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

³²³ P Thoreau & A MacKenzie 'Madrid Protocol takes effect' (2013) 226 *Managing Intell. Prop.* 25 – "New Zealand has adopted the Madrid Protocol in December 2012"

³²⁴ The Trade Marks (International Treaties and Enforcement) Amendment Act 2011 No 71

³²⁵ P Catley & K Giddens 'New Zealand joins Madrid Protocol' (2011) 214 *Managing Intell. Prop.* 43

³²⁶ L Hudson 'The Madrid Protocol - seven months on' (2013) 234 *Managing Intell. Prop.* 34

³²⁷ L Hudson 'The Madrid Protocol - seven months on' (2013) 234 *Managing Intell. Prop.* 34

³²⁸ L Hudson 'The Madrid Protocol - seven months on' (2013) 234 *Managing Intell. Prop.* 34

designating, also reflect their main trading partners who are already members of the Madrid Protocol.³²⁹

One of the commercial advantages to filing a national application in New Zealand is the speed in which applications are examined. The examination will occur within 15 working days to six weeks of filing the application and the registration can be secured within six months. This is a stark contrast to the examination period in developing countries. IPONZ estimates that most of the New Zealand designations will be accepted without objections being raised during the examination phase. This can be attributed to the assertion made by various academics and legal practitioners that there is a reduced number of “classification or specification objections” are expected under the designated jurisdictions in terms of the Madrid Protocol.³³⁰ As a result of this, the currently high acceptance rate of New Zealand designations that the IPONZ deals with is only set to increase with a rise in the post-acceptance of trade marks, including oppositions and revocations of existing trade mark registrations.³³¹ It is vital to ensure that these formalities of the basic New Zealand application are correct and that amendments may need to be made to existing national trade marks in New Zealand, in order to meet the requirements of the intended designated country in the international trademark application.³³² For example, the specification of the goods and services in a Madrid Protocol application “cannot be broader than the goods and services in the home country application or registration”.³³³

Amongst these positive outcomes of the Madrid Protocol in New Zealand, there have also been certain limitations and potential problems that New Zealand faces. Where authors have also identified the issue of central attack as a significant risk for the nation of New Zealand, it can of course be remedied for trade mark owners by the provided solution as previously discussed.³³⁴ Another significant limitation that New Zealand

³²⁹ Y Tian ‘Impacts of Recent Development of the Madrid System on Australian Users & (and) Recommendations for Future Reform’ (2009) 6 *Macquarie J. Bus. L.* 167

³³⁰ P Thoreau & A MacKenzie ‘Madrid Protocol takes effect’ (2013) 226 *Managing Intell. Prop.* 25

³³¹ P Catley & K Giddens ‘New Zealand joins Madrid Protocol’ (2011) 214 *Managing Intell. Prop.* 43

³³² M Gavin ‘The Madrid Protocol’ (2012) *FMCG*. 32

³³³ C Ross ‘The Madrid Protocol for trade marks’ (2012) *The Journal* 43

³³⁴ M Gavin ‘The Madrid Protocol’ (2012) *FMCG*. 33

faced was that the Madrid Protocol, as a system of international trade mark registration, would only apply to those countries who have also signed up to the Madrid Agreement or Madrid Protocol. Even though the Madrid Protocol currently covers roughly half of the world's nations, if a specific country has not acceded to the Madrid Protocol, then that jurisdiction will not be able to take advantage of the system. Furthermore, countries with which it may have strong business relations with, will also not be able to designate an international trade mark through the Madrid Protocol in that jurisdiction. This is issue of having to file for an international trade mark through the Madrid Protocol and to make an additional application to designate a country that has not acceded to the Madrid Protocol, takes away from the objective of convenience in registering an international trade mark. It is the well-established first world countries that are likely to be big exporters and importers in trading, that are majorly affected by the lack of membership to the Madrid Protocol from certain countries. In simpler terms, developed countries are essentially waiting for their trading partners, who are perhaps less developed, to catch up in this regard.³³⁵

3.3.2.3. Conclusion

The analysis of a developed country's dealings and experiences with the implementation of the Madrid Protocol does not only demonstrate the diverse range of problems faced in contrast to the developing nations, it also displays the prospective development that comes with adapting to the Madrid Protocol. The experiences of these developed countries indicate a predominant shared common denominator, being the potential issue of central attack. Yet there is a difference in how the Madrid Protocol has been received by developing third world countries like Brazil as opposed to first world countries like New Zealand. These developed countries have local entrepreneurs that express interest in understanding and using the Madrid Protocol as well as prompt examination processes at their national trade mark offices.

Observing how New Zealand received the Madrid Protocol under a South African light, truly demonstrates the extent to which a developed country differs from that of a

³³⁵ M Gavin 'The Madrid Protocol' (2012) *FMCG*. 32

developing country. The positive responses received from domestic traders to the Madrid Protocol, is likely a feature of a stable socio-political climate and solid infrastructure. This is something that a developing country like South Africa may lack. Moreover, where this developed jurisdiction awaits involvement from countries that are yet to accede to the Madrid Protocol, like South Africa, it is a hindrance to the economic benefits it could be accruing. Where this is probably an issue that developed countries will experience in their accession, it is unlikely to be of consequence to South Africa in the near future. However, this is still a valuable observation which illustrates that South Africa and other developing countries need to take active steps to accede to the Madrid Protocol and jointly revitalise the global economy.

3.4. CONCLUSION

Adopting this comparative approach to assess the consequences of South Africa's potential accession to the Madrid Protocol is significant where it creates a relevant context within which to draw conclusions with regards to how successful the process would be. The deductions made indicate that the implementation of the Madrid Protocol has not been a seamless process for most countries, be it developing or developed.

From the discussion above, it can be reasoned that the key difficulties experienced have related to administration of the Madrid Protocol. A noticeable trend amongst a majority of these African and developing countries in their journey to acceding to the Madrid protocol, is the requisite legislative changes that need to be made which South Africa will have to adhere to. The ancillary observation that can be made in researching the development of intellectual property rights is that there has been frequent updating of intellectual property legislation in contemporary Africa, which is a step forward for many of these underdeveloped to developing countries on the continent.³³⁶ This

³³⁶ 'Intellectual Property in Africa: An Overview' (2016) available at <https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf>

knowledge catalyst is progress from which South Africa can derive future insight for intellectual property development. Using countries of a similar socio-political or economic standing as South Africa like Brazil and India, has provided a detailed representation of the Madrid Protocol's route to accession and eventually its implementation. It can be concluded that the obstacles encountered by developing countries are likely to be consistent with those faced with South Africa, based on the common status of BRICS. As mentioned in the preceding conclusion, an assessment of developed international countries conveys the reality of the Madrid Protocol working at its optimum.

In the final analysis that can be made from an international perspective, there is compelling evidence that cannot be ignored from countries akin to South Africa. The Madrid Protocol has consistently been faced with adversity, but has nevertheless endured. Despite the early hesitation, the governing bodies of these nations persevered in their endeavors to facilitate a smooth transition into the Madrid Protocol. This logic can be pursued further to conclude that South Africa's prospective accession to the Madrid Protocol will follow a similar trajectory to the developing countries as discussed above.

From the experiences of the countries within this comparative analysis, it can be inferred that the problems relating to finance and infrastructure that are mainly observed in developing nations, will likely be encountered by South Africa in their potential accession to the Madrid Protocol. Therefore, in preparation for possible accession to the Madrid Protocol, it is necessary to ensure South Africa's financial stability and the sound capability of the country's infrastructure, in the preliminary stages of implementation. This will require the CIPC to be apprised of all the specific mechanisms and policies associated with the Madrid Protocol from research of this nature. Where South Africa has historically had implementation issues relating to infrastructure, it will be imperative that the CIPC manages the internal procedures of the treaty in facilitating this foundational groundwork.

&ved=2ahUKEwjc-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa', accessed on 16 March 2018

Grouping the countries utilized in this comparative analysis according to their status as developing to developed countries, demonstrates that the successes of the Madrid Protocol in a jurisdiction, is based on how the respective country's economy and infrastructure can support the treaty and its workings, as well as how it is incorporated into that country's intellectual property law.³³⁷

³³⁷ C Ross 'The Madrid Protocol for trade marks' (2012) *The Journal* 43

CHAPTER 4: RECOMMENDATIONS

4.1. INTRODUCTION

Chapter four will pursue a critical discussion of the research conducted, by reflecting on the issues pointed out in the implementation of the Madrid Protocol. It will also seek to make suggestions for the factors to be considered in the rationale behind South Africa's decision to accede to the Madrid Protocol.³³⁸ In order to establish whether the Madrid Protocol will be a positive or negative instrument for international trade mark protection in South Africa, it is necessary to analyse the resultant consequences from accession to the Madrid Protocol by countries that have already acceded to the Madrid Protocol. By practically examining the relevant legislation and exploring the idea of potentially implementing the Madrid Protocol in South Africa, one can provide an enlightened opinion regarding the consequences of acceding.³³⁹

4.2. CONSEQUENCES OF ACCEDING TO THE MADRID PROTOCOL

The consequences generated from accession to the Madrid Protocol shed light on whether the Madrid Protocol is a worthy and effective mechanism for international trade mark protection. In this regard, there are consequences that arise before accession, in the preliminary stages of implementation and in the midst of adjusting to this international trade mark system.³⁴⁰ The positive and negative consequences that stem from experiences with the Madrid Protocol, can be further distinguished as theoretical advantages and practical disadvantages. The theoretical advantages are the consequences that would be paper-based and expressly outlined in the treaty

³³⁸ W Meiring 'Examining the Madrid Protocol in Africa' (2016) 263 *Managing Intell. Prop.* 14

³³⁸ 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

³³⁹ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

³⁴⁰ G de Rassenfosse 'A Policy Perspective on the Accession of Peru to the Madrid Protocol' (2016) 2 *SSRN*. 2

itself. However, the practical disadvantages to be discussed are the real manifestations of the treaty's provisions in practice.

4.2.1. THEORETICAL ADVANTAGES VERSUS PRACTICAL DISADVANTAGES

In theory there are various perceived advantages of the Madrid Protocol, however in the practical application of the Madrid Protocol, there are certain practical disadvantages or negative consequences that ensue with the implementation of the Madrid Protocol. After having thoroughly researched the Madrid Protocol and upon its introduction as an instrument for the international protection of trade marks, countless advantages of accession to the Madrid Protocol were set out by WIPO and legal specialists. As per chapter three, the experiences of international countries who were required to grapple with the real requirements of the Madrid Protocol, highlighted the various problems that came arose from accession. Thus from the outset, these advantages were to a greater extent perceived advantages, and in some cases are yet to materialise with time. This chapter will therefore scrutinise these practical disadvantages that have surfaced and whether or not they could be overcome by the theoretical advantages inherent to the Madrid Protocol over time.

A critical analysis of how the Madrid Protocol works reveal many benefits for trade mark proprietors, being the perceived advantages that have become actual advantages. However, there are two established main benefits that are inherent to Madrid Protocol, being the cost-effectiveness and administrative efficiency that emanate from the Madrid Protocol's implementation in its member states.³⁴¹

Theoretically, a central benefit of implementing the Madrid Protocol is the administrative efficiency it puts into practice. Aside from the administrative benefit for small and medium sized enterprises of making trade mark protection in numerous countries a reality, there is also the ease of upholding international protection for a

³⁴¹ 341 M Gavin 'The Madrid Protocol' (2012) *FMCG*. 32

trade mark following a successful international registration.³⁴² According to the treaty's objectives, the administration of the Madrid Protocol makes it simpler to maintain an international registration where registrations of the same mark in all the designated countries, will hold identical renewal dates.³⁴³ Moreover, post-registration matters such as renewals and assignments can be dealt with collectively for the designated overseas jurisdictions.³⁴⁴ This is all achieved through a "single procedural step".³⁴⁵ However, these benefits are not as apparent to some of its member states as these theoretical advantages are being overshadowed by the practical administrative difficulties that certain countries are experiencing in adjusting to the Madrid Protocol. Therefore, for some nations the advantages in theory are yet to materialise.

The number of theoretical advantages and practical disadvantages that exist in African countries to other international developing countries, vary amongst the nations. International registrations by a number of member countries to the Madrid Protocol that have designated various African countries, are being poorly administered.³⁴⁶ This issue is one that encapsulates the extent to which the benefits of acceding to the Madrid Protocol can be purely theoretical, rather than advantageous in actuality. From the backlogs prevalent in Brazil and India to the lack of registrars and staff in Zimbabwe, there is similarity to the current situation that prevails over the CIPC. Where South Africa's local trade mark office does not currently make the turnaround times prescribed by the international system, it is inundated and therefore cannot commit to the eighteen month examination period required by the Madrid Protocol.³⁴⁷ Therefore, backlogs and further delays in the trade mark registry office are to be expected with South Africa's accession to the Madrid Protocol, like in Zimbabwe, Gambia, Brazil and India.

³⁴² P Wilner 'The Madrid Protocol: Balancing Sovereignty and Efficiency' (2002) 84 *J. Pat. & Trademark Off. Soc'y* 875

³⁴³ A Damodaran & M Sundaram 'Madrid System Market Research in India: Marketing Campaign in India for International Registration of Trade Marks' (2016) 9 – available at http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf, accessed on 14 December 2018

³⁴⁴ T Doucas 'International Trade marks: The Madrid Protocol makes it easier and more cost effective for New Zealand companies to register their trade marks overseas' (2012) *Intellectual Property Journal* 45

³⁴⁵ ³⁴⁵ M Gavin 'The Madrid Protocol' (2012) *FMCG*. 32

³⁴⁶ W Meiring 'Examining the Madrid Protocol in Africa' (2016) 263 *Managing Intell. Prop.* 14

³⁴⁷ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

Furthermore, where the non-examination of a trade mark application or lack of a proper examination is a practical disadvantage as to how the country functions. In this instance the Madrid Protocol, applications have been a serious issue in countries like Botswana and Gambia, it can be said that South Africa has a comprehensive examination process which will ensure a thorough and substantive examination of the mark. As previously discussed, the result of this is that International Registrations become valid in these countries by default and it is possible that these registrations could be challenged.³⁴⁸ In this regard, one can infer that South Africa will remain true in its trade mark practices and learn from this downfall endured by other African countries. It is also important to consider that New Zealand's short examination period, in contrast to the developing countries, is able to exist where their infrastructure is well-established and the country has easy access to capital and resources for the Madrid Protocol to flourish in. The prevailing problems experienced in Botswana of improper record-keeping and a failure to publish or advertise the registration of an international trade mark, can be circumvented in South Africa. This could be achieved by ensuring effective administration at the lowest level of national trade mark registrations, which would consequently allow for steady expansion into the international trade mark registrations.

During the transition into the Madrid Protocol, there were also ongoing administrative reforms taking place in India. It was established that India need not wait until such reforms are fully complete to sign and implement the Protocol once these changes have covered some adequate ground to meet the Protocol obligations, "on a partially exempted basis".³⁴⁹ Thus, the recommendation can be made that this is a possible option for South Africa to accede to the Madrid Protocol "on a partly exempted basis"

³⁴⁸ 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

³⁴⁹ R Prassas 'On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks' (2004) 32 *Int'l Bus. Law.* 215

through partial reforms.³⁵⁰ India also recruited more digitally trained trade mark examiners for the Office before the Madrid Protocol became operational. South Africa could put this into practice as soon as possible and not in the midst of accession. By starting to rearrange the registry and bring order to the trade mark registration system in advance, this puts South Africa in better stead for the Madrid Protocol's implementation.³⁵¹ Not only will the recruitment of trained registrars and administrators at the CIPC contribute to job creation in South Africa, but it will allow for the additional personnel and manpower to alleviate the backlog. Prior to accession to the treaty, decreasing the backlog is one of the internal processes that the CIPC should undertake to address with the aim of ushering in a new phase in international trade mark registration afresh.

Chapter 3 also alluded to various general problems such as the validity of these international registrations in some African and underdeveloped countries.³⁵² These broad matters shared amongst African countries, will be addressed in a similar fashion in this chapter. As observed in Zimbabwe, it was necessary to merge the Madrid Protocol into domestic legislation and allow for the passing of relevant regulation. One can infer that the matter of an international trade mark registration's legitimacy, relates greatly to the particulars of implementing the Madrid Protocol.³⁵³ This is because in terms of the effects of aligning South Africa's current intellectual property law legislation with the Madrid Protocol, there are no specific sections of the Trade Marks Act³⁵⁴ that directly correspond with the provisions of the Madrid Protocol. Thus, amendments to South African intellectual property laws would be considered a precursor to accession, where it is of significance in enabling implementation. As mentioned in the previous chapter, this is because an international treaty like the

³⁵⁰ R Prassas 'On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks' (2004) 32 *Int'l Bus. Law.* 215

³⁵¹ AB Deorsola ... et al 'Intellectual Property and trade mark legal framework in BRICS countries: A comparative study' (2017) 49 *World Patent Information* 8

³⁵² 'Intellectual Property in Africa: An Overview' (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpFDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

³⁵³ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

³⁵⁴ No. 194 of 1993

Madrid Protocol in common law countries, is ineffectual and does not automatically become effective upon signature, but only when the country “integrates the agreement into its national law by statute”.³⁵⁵ There are also certain positive indicators that show how accession to the Madrid Protocol will not entail critical changes to the South African legal framework, such as the accession of a regional trade mark registration systems available in Africa known as OAPI, to the Madrid Protocol.

OAPI recently acceded to the Madrid Protocol as a regional member.³⁵⁶ Therefore, by simply designating OAPI in an international trade mark application under the Madrid Protocol, the registration can cover all of the seventeen OAPI member countries in an international trade mark registration.³⁵⁷ The accession of OAPI to the Madrid Protocol can also be considered as an actual benefit to be derived from the Madrid Protocol, having successfully brought into existence the acknowledgment of a regional system.³⁵⁸ OAPI’s accession to the Madrid Protocol is to be seen as highly advantageous in that South Africa has already worked with international laws in respect of regional marks through OAPI. South Africa is not a member of OAPI, but its industries do file regional trade mark registrations through this African trade mark system, that deals with mostly West African countries.³⁵⁹ This synergy between regional marks registrations and national trade mark registrations already exists between OAPI and South Africa. Therefore, in the instance of accession to the Madrid Protocol, the development of South African law will not drastically change trajectory since there is a working relationship between the national intellectual property law and regional intellectual property law. If South Africa can align its intellectual property laws

³⁵⁵ I Du Plessis ‘Madrid Protocol: Issues in Africa’ (2015) available at <https://www.ensafrica.com/news/Madrid-Protocol-issues-in-Africa?Id=1801&STitle=IP%20ENSight>, accessed on 23 February 2018

³⁵⁶ ‘Intellectual Property in Africa: An Overview’ (2016) available at https://www.google.co.za/url?sa=t&source=web&rct=j&url=https://www.spoor.com/docs/4411/IAM%2520-%2520INTELLECTUAL%2520PROPERTY%2520IN%2520AFRICA%2520AN%2520OVERVIEW.pdf&ved=2ahUKEwjC-NeFpfDZAhUDW8AKHWq6CPYQFjAAegQICBAB&usg=AOvVaw0_1YN-TyLUGKJcp5BW0KNa, accessed on 16 March 2018

³⁵⁷ W Meiring ‘Africa: Recent developments in African IP’ (2017) *Managing Intell. Prop.* 21

³⁵⁸ W Meiring ‘Beware When Using the Madrid Protocol in Africa’ (2015) 248 *Managing Intell. Prop.* 15

³⁵⁹ J Nurton ‘OAPI adds 17 countries to Madrid Protocol’ (2015) *Managing Intell. Prop.* 11 - OAPI became the 93rd member of the Madrid System and the Madrid Protocol enters into force for OAPI on March 5 2015.

to register a regional mark, then it will not be such a substantial step to align with other international protocols.

In the likelihood of South Africa's accession to the Madrid Protocol, OAPI's accession to the treaty also enables South African trade mark proprietors to designate OAPI as a region on the application to be afforded trade mark protection in, through the Madrid Protocol. This amounts to a greater streamlined process through the Madrid Protocol and to cover both regional and international jurisdictions. Hence, making a single application for an international trade mark with the Madrid Protocol will be highly efficient and feasible for South African trade mark owners, as it will not have to file a separate application to cover the OAPI states. While this organisation is not yet global, it is an international registration system that is becoming increasingly recognised worldwide.³⁶⁰ Conversely, there have been some doubts regarding OAPI's accession to the Madrid Protocol and whether it had been lawful. This matter lies in the fact that OAPI's accession to the Madrid Protocol was completed by way of a resolution of the its Administrative Council which does not have the authority to create new intellectual property rights, like "an international trade mark registration, on behalf of its member states".³⁶¹ Accession was rather administered by way of an amendment to the Bangui Agreement³⁶², which is the document that founded OAPI. Many legal minds are of the opinion that OAPI's accession to the Madrid Protocol by way of this resolution was invalid, therefore making the OAPI designations of international trade mark registrations unenforceable and of no force and effect in OAPI member states.³⁶³ Pending a decided case on this matter, it can be said that there are some risks attached to covering OAPI as a designation, in terms of an international trade mark registrations.³⁶⁴ In spite of the fact that OAPI's accession is currently a controversial topic, it is however likely that by the time South Africa accedes to the Madrid Protocol, in the instance that it does, a South African trade mark owner will then be afforded enforceable intellectual property protection in the OAPI member states through an

³⁶⁰ CM Aide 'Madrid by way of Ottawa: Tips and Traps for the International Registration System' (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

³⁶¹ W Meiring 'Beware When Using the Madrid Protocol in Africa' (2015) 248 *Managing Intell. Prop.* 15

³⁶² Bangui Agreement

³⁶³ W Meiring 'Africa: Africa and International Registrations' (2015) *Managing Intell. Prop.* 1

³⁶⁴ W Meiring 'Fresh concerns over the Madrid Protocol in Africa' (2017) *Managing Intell. Prop.* 1

international trade mark registration with the Madrid Protocol. For South Africa to exercise this added benefit of an OAPI designation in an international trade mark application under the Madrid Protocol, it would ultimately depend on the outcome of the litigation on this matter.

There are also those in opposition of South Africa's accession to the Madrid Protocol, who perceive that by extension of the fact that South Africa has failed to become a member of a regional trade mark system, that it would not proceed accede to an international trade mark system. However, this insinuation could be reversed where it is possible that South Africa is anticipating accession to a more comprehensive trade mark system that is international and is more inclusive of nations worldwide, rather than that of a regional trade mark system. This touches on the concept of aspirational boundaries and restrictive boundaries that exist promoting and inhibiting the progress of a country, respectively. A further reason for accession, in spite of the adverse consequences that loom over South Africa's decision-making process, is that the Madrid Protocol is a highly aspirational piece of legislation. An analogy that best describes this notion is one which involves the South African Constitution³⁶⁵. This constitution is a piece of legislation that includes a Bill of Rights. Even though access to these rights are limited by socio-economic factors and restricted resources, it remains progressive where the enforcement of human rights is still being realised. With these human rights still materialising, it does not mean that one should not be afforded those rights. As a developing country, they are aspirational goals that are to be worked toward.³⁶⁶ The idea of the constitution being an ambitious piece of legislation can be mirrored by the Madrid Protocol. Where South Africa aspires to achieve the rights encompassed in the Constitution, we South Africa can similarly aspire to achieve the successful implementation of the Madrid Protocol. Access to the benefits and administrative convenience of the Madrid Protocol's procedures, are likewise restricted by certain socio-economic factors, legislative teething problems and limited resources for the necessary implementation of the treaty. In general, one can make the deduction that accession to any piece of legislation will have issues with implementation at the initial phases putting it into practical effect – thus, the Madrid

³⁶⁵ The Constitution of the Republic of South Africa, 1996

³⁶⁶ E Barraclough ... et al. 'The Madrid Protocol Comes of Age' (2013) 230 *Managing Intell. Prop.* 35.

Protocol and the efficiency it secures for the protection of intellectual property rights, should be recognised in the same aspirational light as that of the Constitution.³⁶⁷

By pursuing this argument, there is the notion that boundaries can be aspirational by incentivising development of a country, and there are also boundaries that are restrictive which inhibit the progress of the country. A further analogy to expand on this idea, is that if one wears smaller shoes it constricts the growth of one's feet, which amount to restrictive boundaries. However, if one wears bigger shoes, one's feet will eventually grow into them, similarly to how South Africa would grow to meet the aspirational boundaries being set up by the Madrid Protocol. It can be further reasoned that knowing other countries that are dealing with issues in accession as well, given that we are not the first third world country to accede to the Madrid Protocol, we have the advantage of not repeating those mistakes that they have made. Therefore, South Africa will be able to take more than small steps forward in the process of implementation, having considered the experiences of other countries in their accession.

Another key theoretical advantage of acceding to the Madrid Protocol system are the reasonable costs involved.³⁶⁸ As outlined in chapter 2, with regards to countries that have not acceded to the Madrid Protocol, trade mark owners seeking to secure trade mark protection in another country would have to file separate trade mark applications for each nation.³⁶⁹ Each application would entail expensive individual administrative costs often bringing about a time consuming process, whereas the complete costs of registering an international trade mark under the Madrid Protocol is more economical with only a single initial application fee.³⁷⁰ An additional benefit to be discussed in further detail, is that normally in order to liaise with the local registration office of the designated country, it requires appointing local legal representatives in each designated country. This is an added expense. However, these legal fees can be

³⁶⁷ The Constitution of the Republic of South Africa, 1996

³⁶⁸ H Muhlberg 'It's a Brave New World for Trade-mark Owners' (2003) 426 *De Rebus* 21

³⁶⁹ M Gavin 'The Madrid Protocol' (2012) *FMCG*. 32

³⁷⁰ JM Samuels & LB Samuels 'International Trademark Prosecution Streamlined: The Madrid Protocol Comes into Force in the United States' (2004) 12 *J. Intell. Prop. L.* 160

averted with the use of the Madrid Protocol. There is an exception to this benefit, where a trade mark proprietor would still have to enlist legal services and pay legal fees in the instance that there is an objection to the registration of the trade mark.³⁷¹ These reduced costs are further accompanied by the long-term savings as well. Under the Madrid Protocol the general expenses related to registering an international trade mark, are in fact saved and therefore accumulate in the long term with each phase of the process in registering the international trade mark. This is evident where rather than renewing the number of registrations in each designation every ten years, the trade mark proprietor need only renew one registration with WIPO. This is the type of administrative convenience and proficiency that a developing country like South Africa can benefit from to eliminate avoidable and excessive costs.

Furthermore, as per the simulated outlook of registering an international trade mark in South Africa within chapter 2, the merging of administrative procedures between South Africa and the Madrid Protocol, the efficiency of registering an international trade mark can be observed at each stage of the registration process in terms of the Madrid Protocol. With It is also necessary to once again emphasize that the South African trade mark owner would be filing a single application for the registration of an international trade mark in numerous member states of the Madrid Protocol, which already illustrates the potential streamlined nature of the treaty in South Africa. In addition, where the complete application is being handled by South African attorneys, there will be a substantial saving for the South African trade mark proprietor as the legal fees will not include the services of each foreign intellectual property attorney in each designated country. Thus, the Madrid Protocol is an instrument that involves a comparatively reduced cost to registering a trade mark overseas. In total, this nature of administrative efficiency and minimised cost are intrinsic to the Madrid Protocol, in cultivating a structured environment to expand into international markets. However, the economic savings that arise are not as greatly realized in developing countries as they are in developed countries. This stems from a connection to the individual financial standing of developing nations as opposed to developed nations, where there are jurisdictions that are not as wealthy as the first world countries like Canada and

³⁷¹ M Gavin 'The Madrid Protocol' (2012) *FMCG*. 33

New Zealand and do not necessarily have the funding and established administrative groundwork to enable the easy implementation of the Madrid Protocol. Therefore, as observed in nations like Zimbabwe and Gambia, these countries were initially spending additional amounts to implement processes of the treaty. This included initiating the IPAS programme, yet it can be projected that the long term savings for both the relevant country's intellectual property office and the trade mark owner, would compensate for earlier expenses in the future.

However, where some countries like India made preparation by budgeting the finance to be spent on training personnel and infrastructure, the transition into the Madrid Protocol was more efficient as compared with other developing countries. South Africa is a developing country and houses an economy that is rapidly emerging in the global marketplace. Therefore, specific funds can be allocated to develop infrastructure and the configuration of the IPAS software needed. This would likely make it possible for South Africa to ensure the upgrading of its trade mark registry system which will be more conducive to the current functioning of the CIPC in the registration of national trade marks, as well as taking on more in terms of the international registration of trade marks.

Another point to consider that can potentially become a disadvantage in the practical functioning of the Madrid Protocol at a ground level relates to the language specifications provided for by the treaty. In the conventional administration of registering an international trade mark, a trade mark proprietor is generally required to apply to each jurisdiction in different languages, by enlisting the skill of a local attorney or translator for every application.³⁷² However, where chapter 2 covers the process of registering an international trade mark in numerous countries through the Madrid Protocol, it is clear that the matter of diverse language issues in applications has been reorganized by WIPO. The matter of language can be both a theoretical and practical advantage to South Africa. As a supplementary issue worth noting in this regard, the problem of translating applications to obtain international protection for trade marks, continues to present itself before countries that may not be able to properly translate

³⁷² U Pathak 'Madrid Protocol and Indian Trade Mark Law: a critical analysis' (2016) 5(2) *The Clarion* 51

key aspects of the international trade mark application into either Spanish, English or French. These translation issues which relate to the description of the goods and services may cause confusion and lead to provisional refusals from various intellectual property offices of countries, as seen in jurisdictions like Brazil and Mexico.³⁷³

This is unlikely to be an issue in South Africa, as previously mentioned, where English is one of the most common languages spoken in the country and is used for business communications. However, issues regarding translation from South African native languages to English can be micro-managed as similarly seen in Mexico. Therefore, it can be said that this will not be a material issue experienced by South Africa, and should be considered an advantage in the practical implementation of the Madrid Protocol, rather than a disadvantage.

Another reason that represents the play between the perceived advantages and practical disadvantages elicited by the Madrid Protocol, is the IPAS. From the research discussed above, with the capability of e-filing, a country has better record-keeping capacity, as there is less manpower involved, and subsequently less room for human error in completing the application form. However, there is still a lack of user confidence and training on WIPO's IPAS. Many jurisdictions in which trade mark protection will be sought are third world countries that are still grappling with an electronic filing system, such as Brazil.³⁷⁴ Countries like Zimbabwe and Botswana also have not yet adjusted to this electronic filing system, even after having made their accession to the Madrid Protocol for some time. This has consequently resulted in these jurisdictions relapsing into their outdated national registration processes.³⁷⁵ This potential lack of record-keeping of international trade marks gives rise to doubts of legitimacy in the registration, until electronic copies have been processed through the IPAS. This has been confirmed by the BPTO, having asserted that a positive outcome to international trade mark registrations made through the Madrid Protocol, would be dependent on the success of the IPAS.³⁷⁶ In pursuing this line of thought studies

³⁷³ A Galvez 'Practical Issues concerning the Madrid Protocol in Mexico' (2015) 252 *Managing Intell. Prop.* 54

³⁷⁴ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

³⁷⁵ S Hollis ... et al. 'Memorandum on the effectiveness of International (MADRID) Registrations in Africa' (2017), available at <https://www.lexology.com/library/detail.aspx?g=03badce6-cf7c-40ce-8daf-addf9a5227f9>, accessed on 14 March 2018

³⁷⁶ J Nurton & S Mahmud 'Brazil on Track for Madrid' (2006) *Managing Intell. Prop.* 11

convey that underdeveloped countries have struggled with implementing the Madrid Protocol, which leads to the deduction that enforcement of trade mark protection can become a relevant issue if the respective intellectual property office is not being administered efficiently in this regard. Furthermore, in terms of this comparative analysis where the nation of Canada is a first world country, this also acts as a relevant example to show that regardless of the countries status as developing or developed – implementing the Madrid Protocol will take time to arrange the IPAS system in the intellectual property office of that country. Hence, South Africa can expect to experience these drawbacks in implementation, but the CIPC can learn from the mistakes of the aforementioned countries by not reverting to the separate applications for an international trade mark registration in each country. The CIPC will rather take advantage of registrars that are professionally skilled in processing documents through the e-filing service and avert the potential aversion to the IPAS system, that countries like Botswana have experienced.

One of the noteworthy consequences of accession that is made clear in the simulated outlook of registering an international trade mark in South Africa, through the Madrid Protocol, especially relates to the reduced number of legal minds required to the register an international trade mark under the Madrid Protocol. As previously dealt with in this chapter, expenses are minimised by not having to seek out local foreign counsel to process each individual trade mark application in the designated country.³⁷⁷ Trade mark owners will however need to engage the services of local foreign counsels should the trade mark application be faced with opposition by third parties or rejected by the national trade mark office.³⁷⁸ These conflicts are anticipated, where it may be rejected by the national trade mark office or opposed by a local third party. Therefore in such predicaments, a local legal representative would need to be engaged for the matter to be handled within the designated domestic jurisdiction in question.³⁷⁹ It has also been argued that the Madrid Protocol paves the way for trade mark proprietors to by-pass local intellectual property attorneys, which further indirectly discourages

³⁷⁷ DL Barch 'Navigating the Madrid Protocol: A New Global Regime for the International Registration of Trade marks' (2003) 8 (2) *Intell. Prop. L. Bull.* 18

³⁷⁸ AB Deorsola ... et al 'Intellectual Property and trade mark legal framework in BRICS countries: A comparative study' (2017) 49 *World Patent Information* 3

³⁷⁹ R Prassas 'On the Road to Madrid - What Will It Take for India to Join the Madrid System for the International Registration of Trade marks' (2004) 32 *Int'l Bus. Law.* 211

promising legal professionals from joining the area of intellectual property law as part of the legal fraternity.³⁸⁰ Due to this progressive step of acceding to the Madrid Protocol by cutting out the middle man, the Madrid Protocol does have the potential to dissuade young legal practitioners from furthering careers in trade mark prosecution, which perhaps leaves trade mark litigation as the next viable professional opportunity.³⁸¹ However, this downfall of the Madrid Protocol's centralised system prioritizes the trade mark proprietor where the process still affords less bureaucracy within the process of registering an international trade mark, and is more accessible in this regard.³⁸² Hence, the South Africa's economy still derive these benefits from the decreased administrative costs associated with the Madrid Protocol, in the same way.

In light of this observation above, it can be said that there are differing opinions that exist in the research conducted in this dissertation, that make conflicting assessments of South Africa's accession to the Madrid Protocol and must be evaluated. It can be said that academics who are learned in the theory of law as opposed to the legal practitioners who practice law and argue it daily, are cognisant of both the advantages and disadvantages to international trade mark registrations in terms of the Madrid Protocol. However, their opinions of the Madrid Protocol take different stances on South Africa's accession to the Madrid Protocol. With the convenience that accompanies the Madrid Protocol in terms of its procedures, one would expect to members of the legal community to recommend the registration of an international trade mark through the Madrid Protocol in most cases. Yet some authors find that there will be certain instances in which proceeding with a separate national trade mark registration still remains appropriate, even though a country has successfully acceded to the Madrid Protocol and has made provision for the treaty in their domestic legislation. Furthermore, certain legal minds may potentially be predisposed to advocating against the Madrid Protocol, being weary of the ramifications it may have for the future of trade mark prosecutors. This is because if the Madrid Protocol, being a centralised trade mark system, is able to work at its optimum in South Africa, the

³⁸⁰ W Meiring 'Examining the Madrid Protocol in Africa' (2016) 263 *Managing Intell. Prop.* 16

³⁸¹ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

³⁸² W Meiring 'Examining the Madrid Protocol in Africa' (2016) 263 *Managing Intell. Prop.* 16

scope for attorneys in trade mark prosecutions that register international trade marks would not be as vast as it currently is. There is still room for trade mark litigation as previously discussed, however this is only in the instance that conflict arises. For example, in the comparative analysis of Zimbabwe's implementation of the Madrid Protocol, regardless of the fact that various regulations had been passed to enable owners of the international trade marks designate Zimbabwe through WIPO's application under the Madrid Protocol, various legal practitioners still endorse securing the registration of international trade marks on a national basis in Zimbabwe.³⁸³

Research has revealed that some of these opinions come from circumstances in which filing an application for an international trade mark directly through the country's national system is more preferable over the Madrid Protocol. These circumstances include the concern over the strong dependency on the basic mark, as it opens the door to "central attack" or instances where the IPAS electronic filing programme is not yet operational in the designated member states.³⁸⁴ Another reason that some trade mark holder's may be advised to revert to filing an international trade mark through the intellectual office of that country, is because the national application can be filed at any time with fewer prerequisites to meet before applying for an international trade mark, as opposed to the Madrid Protocol.³⁸⁵ These reasons ultimately amount to furthering the protection of the trade mark holder's intellectual property rights. However, a critique can be made, where reverting to the previous method for international trade mark strays from the forward-looking nature and innovation of the Madrid Protocol.

Where the progress of local enterprises filing international trade mark applications is yet to reach the rates of trade mark filing within the international marketplace, the Madrid Protocol provides international businesses with a simpler means of securing

³⁸³ S Brown ... et al 'Zimbabwe: Ratification of the Madrid Protocol' (2017) available at <https://www.adamsadams.com/news-insights/zimbabwe-ratification-madrid-protocol/>, accessed on 11 November 2018

³⁸⁴ B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

³⁸⁵ B Bennett 'Study on the Accession to the Madrid System for the International Registration of Marks' (2014) available at <https://www.wipo.int/publications/en/details.jsp?id=3163&plang=EN>, accessed on 13 December 2018

trade mark protection. Thus, in certain member states of the Madrid Protocol, there is a surge of applications coming into a specific country where it is has been designated by many international countries. However, only a few applications for international trade marks are coming out of the designated country in question. This sheds light on the matter of “one-way” traffic. The findings from the comparative analysis provide that the intellectual property offices of member states developing countries, were mainly encouraging external investors to invest in the designated country. This simultaneously resulted in a failure to encourage the development of local entrepreneurs. A failure to put emphasis on the domestic use of the Madrid Protocol amounts to a country economically isolating themselves. This issue of one-way traffic was prevalent in Mexico and India. However, Mexico proceeded to take measures to remedy this situation by linking big industries with small to medium sized businesses for trading advice and to enlighten these local companies about the strategic benefits of registering an international trade mark through the Madrid Protocol. India similarly conducted awareness campaigns to educate the public in this regard. Therefore, these solutions are actions that South Africa can take in advance, before the implementation of the Madrid Protocol, to avoid the lack of participation from local businesses altogether.

The core principles of economics, express that a country does not form part of secular jurisdictional areas, especially where companies which have their economic footprint on other countries tend to expand their business through that continent. For example, in the previous chapter it was highlighted that Brazil as a country is eager to sign the Madrid Protocol as the elected official view the Madrid Protocol as an effective path in building the economy of Brazil. However the level of effectiveness will be dependent on whether its surrounding economic partners also intend to accede.³⁸⁶ Therefore, in order for the Madrid Protocol to be fruitful in its operations, it requires international “buy-in” or global participation. Recently, there have been numerous accessions to the Madrid Protocol that occur daily, therefore this potentially negative outcome is being eradicated in due course. With more countries that are partners in trade with various

³⁸⁶ J Nurton & S Mahmud ‘Brazil on Track for Madrid’ (2006) *Managing Intell. Prop.* 11

member states of Madrid Protocol acceding lately, these member states will be able to perceive the true efficiency of the treaty's processes.

This issue however, does not prevail in countries like New Zealand, where smaller local industries are on the other side of this spectrum, as they are eager to apply for international trade mark registrations through the Madrid Protocol. One can infer that this difference in approach to the Madrid Protocol from local industries, could be ascribed to the differing world statuses of these countries. This issue above, that deals with the general absence of members of the Madrid Protocol that are still not actively utilizing the Madrid Protocol, is a limitation that the country of New Zealand also expresses in a different way. Without the membership of other developing and developed countries, the economic benefits are not as apparent due to the fact that a member state can only register an international trade mark with other member states of the Madrid Protocol. This would mean that, as previously mentioned, a country like New Zealand would have to seek out a national trade mark application in a country that is not a member of the Madrid Protocol in order to obtain protection for the trade mark, thereby incurring costs that could be avoided. In this respect, South Africa's accession to the Madrid Protocol may provoke a slight increase in the number of foreign companies protecting their trade marks here, and subsequently mutual financial benefits would ensue.

One of the prevailing problems amongst the developing countries in terms of implementing the Madrid Protocol, is that the effects of the treaty are considered more favourable for large-scale businesses over smaller local entrepreneurs.³⁸⁷ For instance, local enterprises still have to contend with the trade marks of competitors gaining trade mark protection in Mexico, even though most of these local enterprises are “not yet filing applications under the Madrid Protocol” – this issue relates to a specific lack of participation amongst this group of individuals or businesses. In Mexico however, there are a minority of local companies that are “multinational corporations” which find the ability of filing simultaneous trade marks in several countries, to be economically advantageous.³⁸⁸ Furthermore, research has illustrated that in Brazil,

³⁸⁷ H Muhlberg ‘The Wrong Crowd’ (2015) *Without Prejudice* 6

³⁸⁸ A Pyrah ‘Problems as Mexico Joins Madrid Protocol’ (2013) 228 *Managing Intell. Prop.* 8

similar to South Africa, is a huge dichotomy that exists between large-scale and small-scale businesses.

Considering this conundrum of the effects of the Madrid Protocol being more favourable to bigger industries than smaller local businesses within a South African economic context, also requires having consideration for South Africa's associated economic policies. This becomes relevant when international investors expand into South Africa with the need to grow and work within the economy, and thus South Africa has put economic mechanisms in place to assist the transition from small entrepreneurs into the big entrepreneurs.³⁸⁹ For example, South Africa has implemented an affirmative action policy called Black Economic Empowerment (B.E.E.).³⁹⁰ Legislation relating to B.E.E. allows smaller entrepreneurs who come from previously disadvantaged backgrounds to be afforded fair and equal economic opportunities as those of large-scale industries. This economic policy that is indigenous to South Africa, has an impact on the business culture of the country. Therefore, when making a comparative analysis that involves considering the economic backdrop of a country, such policies are therefore relevant to the comparison. Where Brazil may not have the type of affirmative action policies that South Africa does in terms of economic support for domestic businesses, it can be deduced that the negative impact of the Madrid Protocol in favoring big businesses over local companies, may not be as severe under South Africa's practical implementation of the Madrid Protocol.

This great disparity between what domestic companies can gain from the Madrid Protocol as opposed to those affiliated with their foreign counterparts, is an issue that can be prevented if South Africa were to accede. For example, a measure taken by Mexico to handle this problem was to promote the Madrid Protocol by asking businesses that have used the system to provide small-scale companies with advice for better business practices and why they should pursue the Madrid Protocol. This is a course of action that South Africa's CIPC could take in order to endorse the use of

³⁸⁹ JM Murphy JM 'Demystifying the Madrid Protocol' (2004) 2(2) *Nw. J. Tech. & Intell. Prop.* 242

³⁹⁰ AF Grobler & A Leonard 'Communicating affirmative action in three South African organizations: a comparative case study perspective: research article' (2005) 24(2) *Communicare: Journal for Communication Sciences in Southern Africa* 19

the Madrid Protocol amongst small enterprises, in the likely event that there is resistance, and to avoid the aforementioned difficulties of accession. One can ultimately argue that it will potentially help the small local businessman because this singular application is an incentive for them to aspire to greater global status and expand their business.

Continuing from the previously mentioned issue between domestic businesses and big enterprises, the international perspective detailed in chapter 2, outlines a pattern predominantly found in developing countries.³⁹¹ This being, that small local companies are uninformed and may be unfamiliar with international trade mark practices or are not knowledgeable of procedures like conducting a WIPO search. With particular reference to Brazil and India, there is a lack of awareness that exists amongst the public and local businessmen about the benefits of protecting intellectual property rights.³⁹² By dedicating greater economic resources to educating the community through major businesses guiding small to medium sized industries, not only does it enable more research in this regard, but it also enlightens the individuals who can benefit from the Madrid Protocol.³⁹³ Where the Indian government hosted a range of marketing campaigns to educate the intellectual property rights holders, this active measure dispelled any pre-existing myths that local businesses had about this international trade mark registration system, and as a result brought about interest amongst growing Indian entrepreneurs. This is the type of action that the South African members of the intellectual property law community, would need to take in order to ease potential resistance to accession to the Madrid Protocol. Where the Madrid Protocol is not considered as beneficial to local businesses as per certain developing countries, like Brazil, this could be attributed to a lack of awareness amongst domestic business circles around the importance of guarding intellectual property rights.³⁹⁴

³⁹¹ S M O'Coin 'Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries' Economies' (2011) 15 *Holy Cross J.L. & Pub. Pol'y* 281

³⁹² M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

³⁹³ P Wilner 'The Madrid Protocol: Balancing Sovereignty and Efficiency' (2002) 84 *J. Pat. & Trademark Off. Soc'y* 876

³⁹⁴ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

Therefore the consequence of this is putting the local tradesman on the back foot into the global market place.³⁹⁵

A final point in terms of the practical disadvantages that emerge from the use of the Madrid Protocol, is the concept of central attack. This is when the primary application is rejected or lapsed, cancelled within five years from the date of filing for the registration is dismissed in all the designated countries. In a South African context, where the basic application on which the international registration has been based is refused by CIPC within the first five years of the international registration's life, the entire international registration covering all the designated countries within the application, fails. This demonstrates a serious risk of basing an application for an international registration on a pending application. An international registration which is cancelled through a central attack can, however, be converted into individual national applications in the designated countries within a certain period, or the designated country will grant an extension to permit the trade mark proprietor to re-submit the necessary application.³⁹⁶ Where this issue of central attack persists as a significant risk in countries that have effectively implemented the Madrid Protocol, like New Zealand and Canada, it can be presumed that central attack is the only true theoretical drawback of the Madrid Protocol, that is discernible from the practical disadvantages surfacing from a country's inefficient implementation of the treaty.³⁹⁷

With regards to the possibility of South Africa acceding to the Madrid Protocol, a common area of concern relates to what impact delayed accession will have on South Africa. This thought stems from the common misconception that the Madrid Protocol affects the practical registration of the international trade mark. Accession to the Madrid Protocol rather seeks to achieve effective administration, as opposed to filing numerous separate applications. Therefore, the same application is being disseminated to all the countries and the countries will communicate their responses. Accession to the Madrid Protocol does not mean that simply because a certain international trade mark registration passes muster in various countries but fails in

³⁹⁵ M Loney & M del Pilar Troncoso 'Learning and Lobbying in Latin America' (2016) 263 *Managing Intell. Prop.* 74

³⁹⁶ F Al Sakkaf 'One Trade mark, One Application' (2018) 5(11) *Ct. Uncourt* 13

³⁹⁷ L Hudson 'The Madrid Protocol - seven months on' (2013) 234 *Managing Intell. Prop.* 34

another country due to a prior mark, that the entire registration will be unsuccessful in receiving protection.

It follows that with South Africa's accession, the CIPC will not be forced to accept a mark as all registrations would be subject to South Africa's trade mark law. Hence, acceding to the Madrid Protocol is a purely administrative step, in that the processes of registration will change, and South African intellectual property law will not be fundamentally altered by the Madrid Protocol in the way we decide on the registrability of a trade mark. A positive outcome of acceding to the Madrid Protocol late, that is often mistaken for a negative outcome, is unlikely to be of negative consequence to South Africa in that South Africa would be the last to learning the particulars of an international trade mark registration. Furthermore, there are other countries ahead of South Africa, which however means that South Africa can therefore learn from the mistakes and shortfalls of the countries that have acceded before South Africa. In essence, South Africa's possibly late accession would only be of disadvantage where the economic benefits would be delayed.

Regardless of the criticisms against the Madrid Protocol, there are still great advantages of the Madrid Protocol that cannot go unnoticed. The arguments above, made in support of the Madrid Protocol, can be exemplified by the ideal picture of the treaty's implementation in a country. This can be seen in New Zealand's efforts in intellectual property, with quick and thorough examinations as well as a keen interest from local businesses to apply for international trade mark registrations through the Madrid Protocol. The Madrid Protocol is not necessarily a utopian system, where the problems that unfurl are not necessarily endemic to the Madrid Protocol. Big businesses are constantly entering the South Africa marketplace, which impacts South Africa's economy by it overshadowing of the small to medium-sized enterprises and local businessmen, therefore the Madrid Protocol cannot be impugned for this phenomenon. This composition of the consequences that come from the Madrid Protocol, between both the theoretical and practical aspects, reveal that there is no distinctive black and white advantage to certain trade mark owners, but rather a grey area where this argument rests. From the impressions created by the simulated

outlook of registering an international trade mark in South Africa under the Madrid Protocol, it illustrates that South Africa will be likely to experience certain practical disadvantages of implementing the Madrid Protocol that other developing countries have also experienced. However, it further brings to light that there are certain practical disadvantages and challenges endured by other international countries that South Africa will not have to deal with. This is not only because of the preparation that can take place in the interim by learning from the experiences of other nations, but also due to the basic infrastructure and economic policies that South Africa has in place. In this way, the simulated outlook provides for a succinct view of what matters in implementation South Africa needs to focus on, in the instance that accession to the Madrid Protocol is to take place.

4.3. CONCLUSION

Once again, it can be said that the implementation of any piece of legislation inherently has far-reaching consequences. Therefore, a cautious approach will mean that more unintended consequences can be canvassed and considered. Drawing this information together sets out the advantages and disadvantages of acceding to the Madrid Protocol, in a way that is tangible to the entrepreneur, the consumer and the growth of the economy – creating relevance for this research. It follows that South Africa can engage in decisions regarding the necessary economic scaffolding to implement the Madrid Protocol, and setting the foundations for an improved infrastructure, as other countries that acceded to the Madrid Protocol sought to do. Even though South Africa has not made a firm decision as to whether it will accede – policy-makers may approach the issue as cautiously as possible, by using this time to assess what other countries have done in their experiences whilst grappling with the implementation of the Madrid Protocol. Inquiring into the advantages and disadvantages of acceding to the Madrid Protocol and making suggestions in this research, may provide assistance to policy-makers in arriving at a possible conclusion to the impending decision of whether South Africa will accede to the Madrid Protocol. As previously mentioned, the

issues that are raised in the negative consequences are substantial issues, which in the course of implementation can be rectified.

The structure set out in this chapter highlighted various negative consequences and the positive consequences that counter the difficulties experienced in implementing the Madrid Protocol. This is a testament to how these consequences can balance each other out. It can be said that the negative consequences may be valid, but can be neutralized. Even though the number of adverse consequences is greater than that of the positive consequences, the value of the few positive consequences that exist, outweighs the potentially temporary unfavourable consequences. In summation, it can be deduced that the positives outweigh these negatives in the long term spectrum. Even though the negative consequences that are clear from the practical disadvantages of the Madrid Protocol outweigh the positive consequences provided for in the theoretical advantages of the Madrid Protocol, it can be said that such positive consequences do not dismiss the negative consequences in its entirety. Through the research and contextual analysis that has been conducted, it can be said that from the outset, there are valid arguments in favour of the Madrid Protocol, as long as South Africa is able to learn from the countries that have had difficulties in their accession to the treaty and make the necessary adjustments do not repeat those countries errors. From the recommendations of this chapter and the research completed in this dissertation, the hope is that with South Africa's implementation of the Madrid Protocol as opposed to the experiences of other international countries, that the practical disadvantages would become practical advantages and that the theoretical advantages become practical advantage.

CHAPTER 5: CONCLUSION

By establishing the focal points of this dissertation, that respond to the research questions and will lead to the final analysis of the rationale regarding South Africa's possible accession to the Madrid Protocol. The initial chapters explored the process of registering an international trade mark in South Africa, in comparison to the registration of an international trade mark through the Madrid Protocol. The simulated projection of the international trade mark registration process if South Africa were to accede to the Madrid Protocol, reveals how the average South African businessman at a basic level would generally proceed with registering an international trade mark in South Africa and how this how this process would change for the better under the Madrid Protocol. The trade mark prosecution processes involved when registering an international trade mark, have emphasised the cost-effective and efficient nature of the Madrid Protocol as a solution to commercialising and managing intellectual property in Africa.³⁹⁸ Where the current global economy deems the internationalization and harmonisation of trade mark laws to be of great significance, the essence of the Madrid Protocol is the next phase in globalisation. This is because the provisions of the Madrid Protocol afford international companies a simpler means of obtaining protection for their trade marks. Therefore, where many third world developing countries have joined the Madrid Protocol, this accession indicates both a new period of growth for the treaty as well as the advancement of developing nations.³⁹⁹ Overall, the Madrid Protocol has the potential to underpin a strong system of intellectual property governance in any country, depending on its economic status and infrastructure.⁴⁰⁰

The research detailed in this dissertation highlights the Madrid Protocol for the international registration of trade marks as a positive marker of a company's credibility

³⁹⁸ J F Sisteck 'Options for Foreign Trademark Protection - Comparison of the Madrid Protocol and the Community Trademark System' (2003) 21(3) *Ent. & Sports Law*. 17

³⁹⁹ S M O'Coin 'Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries' Economies' (2011) 15 *Holy Cross J.L. & Pub. Pol'y* 278

⁴⁰⁰ G Bhattacharyya 'IP protocol puts India on the map' (2013) 27(30) *Lawyer* 9

and the potential success of the business.⁴⁰¹ Furthermore, the experiences of other countries that have acceded the Madrid Protocol indicate that it will have a significant effect on the management of multi-national trade mark portfolios, and is therefore economically advantageous to both the business and the country's economy.⁴⁰² Within the simulated outlook of registering an international trade mark in South Africa, through the Madrid Protocol, it can be said that the process would be a progressive and more efficient practice for South African trade mark owners to register a trade mark abroad.⁴⁰³ It can be inferred from conducting a comparative analysis from an international standpoint, that there are potential problems at various stages in the process of accession, that are experienced by all countries, as discussed, in different ways. In this regard, there will not be immediate international trade mark protection in South Africa, as it will involve planning and making financial preparations to enable infrastructure on South Africa's behalf, international trade mark proprietors can take benefit from expanding their business enterprises in Africa.⁴⁰⁴ An overview of the encounters in developing and developed countries in implementing the Madrid Protocol, provides that South Africa's potential accession to the Madrid Protocol will transpire in a like manner to those of the developing countries. The comparative analysis of developed country's experiences with the bringing the Madrid Protocol into effect not only depicted an idea of the eventual benefits that would materialise, but also that there are even certain instances in which a country of this status experienced difficulties in implementing the treaty. Accession to the Madrid Protocol gave rise to various consequences that could be identified as advantageous or disadvantageous. To be more specific, the research viewed the Madrid Protocol to be beneficial and positive in most respects on paper, but in reality, putting the Madrid Protocol into practise occasionally proved otherwise.

⁴⁰¹ A Damodaran & M Sundaram 'Madrid System Market Research in India: Marketing Campaign in India for International Registration of Trade Marks' (2016) 20 – available at http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf, accessed on 14 December 2018

⁴⁰² ⁴⁰² M Gavin 'The Madrid Protocol' (2012) *FMCG*. 33

⁴⁰³ JM Samuels & LB Samuels 'International Trademark Prosecution Streamlined: The Madrid Protocol Comes into Force in the United States' (2004) 12 *J. Intell. Prop. L.* 160

⁴⁰⁴ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 63

In order to reach an answer to the first fold of the key research question, which is whether filing a trade mark application in terms of the Madrid Protocol will result in effective protection of an international trade mark in South Africa, it is necessary to first analyse the responses that can be formulated to its sub-questions from the research conducted above. The first sub-question to be answered is whether there is a need for South African intellectual property law to be amended in order to facilitate the Madrid Protocol. From a legal perspective, in accordance with the explicit requirements emphasized in the Madrid Protocol, and the experiences in implementation articulated by international countries, South African trade mark proprietors cannot utilize the treaty without being a member of the Madrid Protocol. This necessitates bringing domestic legislation in line with the provisions of the treaty, not only to maintain its obligations under the Madrid Protocol, but to also uphold the feature of being a common law country.⁴⁰⁵ This is a common theme that runs through various African countries, as seen in Zimbabwe. It is therefore necessary for South Africa to pass enabling legislation and relevant regulations, so as to accommodate the Madrid Protocol, even if it comes into operation sometime after accession.⁴⁰⁶

It should also be mentioned that with such legislative alterations to be made, that the findings of this dissertation is aimed at the researchers, policy-makers, intellectual property organisations, as well as legal practitioners to be involved in South Africa's decision to accede to the Madrid Protocol. This research endeavours to provide the drafters of legislation with various recommendations to guide how the legislation or regulations are written, and to pose critical questions that need to be answered, thus opening the door to further research. Where the issues dealt with in acceding and implementing the Madrid Protocol can be projected from the experiences of other countries, such issues can to be addressed by legislation-makers. Thus, the dissertation here aims to contribute to and accelerate the decision-making process for legislation drafters, ensuring that the Madrid Protocol will work to its highest level. This research has therefore contemplated a path of accession to the Madrid Protocol for South Africa, in which it ultimately seeks to direct policy-makers on the steps that can

⁴⁰⁵ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

⁴⁰⁶ S Brown & M Du Plessis 'Easing International Registrations in Africa' (2014) 238 *Managing Intell. Prop.* 60

be taken in the interim, by assessing the experiences of implementation from foreign jurisdictions.

The second sub-question relates to how accession to the Madrid Protocol will affect the practical registration of trade marks on a national level as well as an international level. In this regard, the general impact of implementing the Madrid Protocol will be purely administrative in nature, where there will be no substantive alterations to be made in the practical registration of both national and international trade marks. It will rather change the procedural elements involved in registering an international trade mark. With the type of procedural amendments to be made to, it can be said that the *essentialia* of South African intellectual property law will not change the substantive elements of the decision-making process when registering a trade mark. In order to formulate a sound socio-economic outlook on the practical registration of trademarks at a national and an international level, it is necessary to adopt both a practical and theoretical approach to understanding the particulars of the Madrid Protocol. This also provides a holistic representation of the treaty's outcomes. As per chapter three, a practical outlook of the Madrid Protocol in action demonstrates a noticeable contrast to the theoretical depiction of perceived advantages of acceding to the Madrid Protocol. This research confirms that some of these perceived advantages are theoretical in nature and are yet to practically materialise due to a lack of infrastructure and resources from the member states, in order to support the Madrid Protocol. In responding to how successful the practical use of the Madrid Protocol would be in South Africa, the problems South Africa currently deals with in terms of trade mark protection, registration and enforcement, are the mostly the same internal administrative and enforcement issues experienced on a global scale prior to accession. This is the current predicament that South Africa's trade mark registry office faces, where it cannot meet the requisite examination period stipulated by the Madrid Protocol due to various delays.⁴⁰⁷ Countries that initially experienced similar issues at the beginning, were able to adapt and regulate their procedures as time passed. This reiterates the fact that there are good prospects for South Africa to manage the Madrid Protocol in due time and to eventually settle into the administration of the treaty. However, the experiences that countries had over time, will also act as a guide to the

⁴⁰⁷ H Muhlberg 'The Wrong Crowd' (2015) *Without Prejudice* 8

South African CIPC. Therefore, South Africa's adjustment to the Madrid Protocol, may not take as long as it did in other countries that have already acceded to the Madrid Protocol. It is also important to note that the natural economic development that South Africa is in line for with the use of the Madrid Protocol, will only materialise over time. Altogether, it can be reasoned that numerous international countries endured the difficulties of adhering to the Madrid Protocol's requirements at the outset of their potential accession to the treaty. However, with time, each country surpassed the implementation hurdles by slowly adjusting to the parameters of the Madrid Protocol. This is the kind of progression that South Africa can strive toward.

A further sub-question that speaks to whether an international trade mark would receive effective protection under the Madrid Protocol in South Africa is how successful the practical use of the Madrid Protocol would be in South Africa, in terms of the administration of international trade marks. In order to answer this question, it requires an understanding of the present-day administration and productivity level of the CIPC at a practical perspective. Thus in this case, postponing and avoiding accession to the Madrid Protocol will not make the prevailing issues in South Africa's trade mark registry disappear. One can infer from the experiences of other countries that the problems that exist in the CIPC, will only worsen any potential backlogs to be experienced at the start of accession. Where the South Africa's Local Trade Marks Office does not currently meet the deadlines or turnaround times prescribed by the Madrid Protocol, it would add to these problems that could be managed in a more constructive manner through the Madrid Protocol. From a socio-economic standpoint, the world's nations share a common desire for both growth and stability in their economies. With the drastic decrease in paperwork and administrative matters that the Madrid Protocol envisages for investors and business savvy people, this is a means by which South Africa can aspire to cultivate its economy and investment portfolio. This in turn means that South Africa could eventually withstand the difficulties in enforcing trade mark protection at a national level by putting the similar measures used by countries in this predicament, into practice and learning from their shortfalls in implementation. This would then lead to trade mark protection is achievable at an international level, especially where the South African trade mark office registry must

harness the ability to respond to new challenges.⁴⁰⁸ Furthermore, administrative bodies like South Africa's CIPC that deals with the registration of the trade mark in South Africa, will therefore utilize the findings of this research to improve the how the treaty is facilitated in terms of national legislation. Overall, it can be said that the practical use of the Madrid Protocol would be successful in allowing for the registration of international trade marks as there are frequently new and upcoming business ventures taking place in South Africa, with entrepreneurs that will be interested in securing protection for their intellectual property rights. Pending the implementation of conditions for accession to the treaty, like a stable infrastructure of the CIPC, the recruitment of more registrars for the trade mark office, as well as an established programme to make society more conscious of the benefits in intellectual property rights – one can deduce that the practical use of the Madrid Protocol would be highly successful in South Africa.

With regards to what extent South Africa would be able to enforce the Madrid Protocol, in the instance of accession at an international level and in accordance with international standards, chapter 2 considered the enforcement mechanisms afforded to protect trade marks in South Africa. In pursuing this thought, it can be reasoned that enforcing the Madrid Protocol by protecting the international trade mark registrations that have designated South Africa will take the same route as the protection the international trade mark at a national level. Once again, this is because the Madrid Protocol makes no substantive changes to a member states national trade mark law, but rather takes effect in the procedural aspects where it is simply a “One-Stop-Shop multi-jurisdictional application system” that is purely administrative in nature.⁴⁰⁹ In keeping with the extent to which South Africa would be able to enforce the Madrid Protocol, it is necessary to consider the substructures that exist within the CIPC and its proficiency in the enforcement of South African trade mark law.

Therefore, in terms of infrastructure and development, a sub-question imperative to analysing whether effective protection of an international trade mark can be afforded in South Africa, is whether South Africa's CIPC be able to manage and adjust to the

⁴⁰⁸ Salhotra, A & Khan S 'Accession to the Madrid Protocol' (2010) 202 *Managing Intell. Prop.* 40.

⁴⁰⁹ CM Aide 'Madrid by way of Ottawa: Tips and Traps for the International Registration System' (2015) available at <https://www.ipic.ca/download.php?id=1074>, accessed on 11 December 2018

Madrid Protocol's IPAS software. In raising various opposing views, a sense of optimism remains where these issues endured by countries similar to South Africa, managed to facilitate the Madrid Protocol efficiently as time passed, and therefore can be overcome. Therefore, with regards to infrastructure and advances in South Africa's trade mark Registry office, the CIPC could make advancements to meet the Madrid Protocol's IPAS and conduct the training of practitioners so that South Africa is in line with the treaty if accession is to take place. This type of action would follow in the direction of other jurisdictions like Zimbabwe so as to secure the legitimacy of its international trade mark registrations by digitizing documents through WIPO's IPAS. There is also a great likelihood of South Africa managing and adapting to the new software by configuring its technological systems accordingly. Over and above the aspect of time being used for the CIPC to familiarize itself with the IPAS software, the assistance of trained professionals in the IPAS software will also enable the process to go smoothly, as similarly projected and met by the intellectual property office of India.

Furthermore, a significant part of South Africa's potential accession to the Madrid Protocol, delves into the whether South Africa will be confronted with all the same obstacles as other international nations during implementation. In terms of the arrangement that exists within South Africa's trade mark industry, it is evident that the findings of this research can already eliminate certain problems that will consequently be of no issue to South Africa's implementation of the Madrid Protocol. Whereas such problems have been encountered by other international jurisdictions, these were a major hindrance to their implementation of the Madrid Protocol in those member states. For instance, South Africa already has a trade mark opposition system, unlike Mexico. The process of accession therefore began with first having to implement a trade mark opposition system and taking an extended period of time before they could proceed to join the Madrid Protocol.⁴¹⁰ This puts South Africa in a good position for implementation and further ahead in its path to accession.

⁴¹⁰ JM Murphy 'The New Trademark Opposition System in Mexico' (2017) 107(3) *The Trademark Reporter* 747

Another sub-question crucial to the outcomes of South Africa's accession to the Madrid Protocol, is whether accession to the treaty would encourage economic growth for large-scale corporations and small-scale businesses. The answer to this sub-question weighs heavily on whether filing a trade mark application in terms of the Madrid Protocol would result in the effective protection of an international trade mark in South Africa. This is because research has discovered, through the global economic statuses of each nation, that once the Madrid Protocol is in force in that country, the treaty and its related procedures can only be maintained through proper administration of the respective intellectual property office, which requires financial resources. Hence, the economic benefits to be derived from supporting domestic businesses will ultimately flow through the South African economy, and eventually bring commercial profit benefit to the CIPC. In answering the aforementioned sub-question, the spectrum of globalisation, has seen the accession to the Madrid Protocol being noted as a worldwide trend. The growing tendency for companies of all sizes to increasingly do business in multiple countries, means that their respective intellectual property systems need to work together.⁴¹¹ Hence, "trade mark protection is a policy instrument situated at the core of firm marketing and innovation strategy" for international commerce – making the Madrid Protocol a step in the right direction.⁴¹² This is further confirmed by the number of countries that have already acceded to the Madrid Protocol, being roughly sixty percent of the world's nations.⁴¹³ The way in which the Madrid Protocol has expanded to new territories, as an international trade mark system is an indicator that the Madrid Protocol would definitely encourage economic growth for both big and small entrepreneurs if South Africa were to accede. In terms of economic growth South Africa needs to have international investors coming into South Africa, in order to be attractive to the international market when joining the global economy.⁴¹⁴ These stakeholders arrive into South Africa's business scene with their intellectual property and need to be able to protect it. As a country we need to be an attractive force for investments and grow our economic footprint internationally. By

⁴¹¹ 'Strategic Plan 2020' (2018) available at https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/strategic_plan/strategic_plan_2020_en.pdf, accessed on 13 December 2018

⁴¹² G de Rassenfosse 'On the price elasticity of demand for trade marks' 2018 SSRN. 1

⁴¹³ 'Samoa Joins the Madrid System' (2018) available at https://www.wipo.int/madrid/en/news/2018/news_0015.html, accessed on 5 December 2018

⁴¹⁴ T Bosling 'Securing the Trademark Protection in a Global Economy - The United States' Accession to the Madrid Protocol' (2004) 12 *U. Balt. Intell. Prop. L.J.* 137

acceding to the Madrid Protocol, it allows investors to file one trade mark application and cover all the countries that are members. If we don't accede to the Madrid Protocol, it means them having to file a separate trade mark application in each country. When creating a market place to do business, the less bureaucracy they have to deal with, the better. As previously established in chapter 1, preserving and safeguarding brand value through trade mark protection is especially critical to developing nations that are budding with fresh entrepreneurial ideas and countries that are still working toward an advanced marketplace.⁴¹⁵ This is especially important where streamlining your international trade mark application allows the trade mark owner to leverage the most value from its intellectual property out of the many countries in which it conducts business in.

In summary, the legal community says that these are advantages and disadvantages of the Madrid Protocol and from looking at the practical implications of International law, we know what the consequences have been in other countries when acceding to the Madrid Protocol. Therefore, this research has observed the positives and negatives in relation to what has actually happened in other countries that are similar to South Africa – seeking to consolidate these two streams of thought in a South African context for a simulated projection of what would happen in the instance that South Africa accedes to the Madrid Protocol. This is the middle ground and void that my research will cover. This is due to the fact that the studies that have been come across in the process of researching were been isolated in nature, and provided no contextual analysis to furnish the South African legislature with an idea of what the Madrid Protocol would be envisioned as at the CIPC. Furthermore, the comments based on the Madrid Protocol from sources of research did not make observations that were as suggestive and relatively conclusive as the research conducted in this regard. Hence, it can be said that this research is relevant to South Africa's investment strategy of becoming an attractive marketplace for foreign businesses. Therefore, understanding the potential of the Madrid Protocol, through the recommendations made and within a South African context will prove useful to policy-makers in perceiving how to implement the Protocol.

⁴¹⁵ E Barraclough ... et al. 'The Madrid Protocol Comes of Age' (2013) 230 *Managing Intell. Prop.* 35.

Taking into account the observations made from the outcome of each research question, the answer to the first-fold of the key research question in terms of whether filing a trade mark application in terms of the Madrid Protocol result in the effective protection of an international trade mark in South Africa, is an arguable resolve. The answer is arguable because in addressing the first research question, it can be determined that filing a trade mark application in terms of the Madrid Protocol, would most likely allow for effective protection of an international trade mark in South Africa. However, this is pending the requisite legislative changes that are to be made, as well as the early preparations that can be made in the South African trade marks registry office that can be facilitated by the CIPC to accommodate the implementation of the Madrid Protocol. This is because in terms of the concluding deductions made in chapter 4, even though the theoretical advantages of the Madrid Protocol are outnumbered by its practical disadvantages, the theoretical positives are far greater than the negative implications that could possibly ensue in South Africa's accession. Thus, it can be said that filing a trade mark by way of the Madrid Protocol in South Africa would likely result in the effective protection of the international trade mark. The success of the Madrid Protocol also depends on the abilities of the CIPC and its registrars to internalise the downfalls of the Madrid Protocol in advance, and recognize the negative experiences of countries that share a likeness to South Africa, as cautionary tales to learn from. In addition, the comparative analysis conducted from an international perspective in chapter 3, ultimately drew the inference that the level of economic benefits to be derived from the workings of the Madrid Protocol, mostly depends on the standard of that country's legal, and socio-economic infrastructure. This essentially means that the legal framework in which the Madrid Protocol exists for the respective country is to be valid and enforceable. In socio-economic terms, this would refer to the way in which the national structures in place are able to support and administer the treaty.⁴¹⁶ In terms of the South African contextual analysis that has developed from these legal and socio-economic factors, these are also indicators that will best project the potential outcomes for analysing the rationale behind South Africa's possible accession to the Madrid Protocol for policy-makers and the South African legislature to consider.

⁴¹⁶ C Ross 'The Madrid Protocol for trade marks' (2012) *The Journal* 43

As this concluding chapter proceeds with the two-fold nature of the key research question of this dissertation, the direction of this research leans toward the first fold of the question, which focused on whether the international trade mark owners will be effectively accommodated within the realms of South African trade mark laws. The second fold of the question contemplated whether South African trade mark owners, who file trade mark applications in terms of the Madrid Protocol will receive effective protection for their trade mark in other member states of the treaty. This second line of inquiry is not the main cause for concern in this regard. However, the comparative analysis has outlined that the standard of protection may differ depending on which countries the trade mark owner designates. One can deduce that international trade mark protection is more advanced in first world countries that are developed and have solid administrative policies in place to facilitate the treaty. In addition, there are third world countries that are underdeveloped and have acceded to the Madrid Protocol, hence the protection of an international trade mark may not be as effective in terms of the type of enforcement mechanisms available. In considering the differing statuses of countries, there are other developing nations that are also long-standing members of the Madrid Protocol, that have adjusted to the processes over time and have become efficient in executing the processes of the Madrid Protocol. Therefore, the level of effectiveness in securing protection for South African trade mark owners in other international countries demands less scrutiny for the purposes of this research.⁴¹⁷

This chapter has aimed to refine the findings of this research and connect outcomes to the research questions. It has been a study of both academic and practical interest where it has addressed the international trade mark registration process in South Africa along with the hands-on implementation of the Madrid Protocol as a forward-looking and progressive treaty. A general interpretation of this dissertation suggests that the Madrid Protocol is a treaty that allows for ownership and centralized management of an international trade mark.⁴¹⁸ Besides analyzing countries similar to South Africa in terms of their accession to the Madrid Protocol, to observe the possible risks and benefits, conducting a contextual analysis of the treaty in South Africa has

⁴¹⁷ S M O'Coin 'Old Treaty, New Outlook: The Madrid Protocol Empowers Developing Countries' *Economies* (2011) 15 *Holy Cross J.L. & Pub. Pol'y* 284

⁴¹⁸ D Bellangere Intellectual Property (unpublished lecture notes, University of KwaZulu-Natal, 2017)

pronounced various recommendations for potential accession. The content of this dissertation endeavors provide a consolidated overview of what the Madrid Protocol c the potential to achieve in South Africa. The other walks of life that this research work will seek to assist are academics and legal practitioners. In terms of educators in academia or members of academia, this research will not only serve to show how an international treaty has the potential to impact South Africa both positively and negatively in its implementation, but to also provide a consolidated source of information regarding the registration of international trade marks in South Africa. This study will also aim to help practitioners of intellectual property law and legal minds to provide holistic opinions to their clients on the general registration of an international trade mark through the national system, and understanding the advice they would possible give to a South African trade mark proprietor when applying for an international trade mark in a foreign jurisdiction through the Madrid Protocol.

From the comparative analysis conducted from an international perspective, it is clear that there are certain conditions under which the provisions of the Madrid Protocol thrive, and to which the benefits it encompass, are able to unfold. Where this study has sought to provide a rounded perspective of South Africa's possible relationship with the Madrid Protocol, one considers South Africa's status as a third world, developing nation. Hence, it can be inferred that South Africa could potentially prepare such suitable conditions for the Madrid Protocol to be successfully exercised. Finally, the intention behind this research is to make a significant social impact on people in the strategic environment, being the trade mark owners and create general awareness around the importance of intellectual property rights in South Africa. In light of the advantages and disadvantages that that have emanated from the implementation and use of Madrid Protocol, research suggests that within this age of modern globalisation, intellectual property is to be utilized as a promoter of economic development and that it is just as important to protect such rights. In this respect, the treaty is not necessarily a flawless solution, however it is the best solution available at present for filing international registration of trade marks.

Overall, the cohesion between the Madrid Protocol and South Africa's national trade mark law demonstrates South Africa's merging into international standards. Once

again a pressing argument to be made in support of accession to the Madrid Protocol comes back to the construct of aspirational boundaries and restrictive boundaries. The idea is that if you wear small shoes it constricts the growth of your feet, but if you wear bigger shoes, your feet will eventually grow into them. Being the young democracy that South Africa is, it is important that the country further challenges itself to effectively facilitate the Madrid Protocol as motivation to work to that higher standard. Thus, where accession to the Madrid Protocol does not infringe or bear any negative impact on the intellectual property sovereignty of South Africa and it should therefore be welcomed.

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14 March 2019

Ms Mishayla Kercival (214512034)
School of Law
Howard College Campus

Dear Ms Kercival,

Protocol reference number: HSS/2203/018M

Project title: An analysis of the rationale regarding South Africa's possible accession to The Protocol Relating to The Madrid Agreement concerning the International Registration of Marks

Full Approval – No Risk / Exempt Application

In response to your application received on 17 October 2018, the Humanities & Social Sciences Research Ethics Committee has considered the abovementioned application and the protocol has been granted **FULL APPROVAL**.

Any alteration/s to the approved research protocol i.e. Title of the Project, Research Approach and Methods must be reviewed and approved through the amendment/modification prior to its implementation. In case you have further queries, please quote the above reference number.

PLEASE NOTE: Research data should be securely stored in the discipline/department for a period of 5 years.

The ethical clearance certificate is only valid for a period of 1 years from the date of issue. Thereafter Recertification must be applied for on an annual basis.

I take this opportunity of wishing you everything of the best with your study.

Yours faithfully

.....
Dr Rosemary Sibanda (Chair)

/ms

Cc Supervisor: Ms Salina Govindsamy
cc Academic leader Research: Dr Freddy Mnyongani
cc School Administrator: Mr Pradeep Ramsewak

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