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Measures Against Fraudulent or Bad Faith Trademark Filings: South Africa & Morocco

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INTRODUCTION

Fraudulent or bad-faith trademark filings pose a growing challenge for brand owners, undermining legitimate rights and creating uncertainty in the marketplace. As trademark systems continue to expand across jurisdictions, so too does the need for effective legal mechanisms to prevent, challenge, and remove improperly obtained registrations. This Special Newsletter provides an overview of the principal measures available to address fraudulent or bad-faith trademark filings in South Africa and Morocco, with particular focus on opposition and invalidation procedures, and offers practical guidance to assist rights holders in protecting and enforcing their brands.

SOUTH AFRICA

1. Overview of the Trademark System

1.1. First-to-file or first-to-use

South Africa adopts a first to use system, in that rights flow primarily from prior use rather than filing. Registration is strongly advisable because it provides statutory protection, but it does not override earlier common law rights arising from reputation.¹

1.2. Single or multi-class application system

South Africa does not permit multi-class applications.²

1.3. Available filing routes

Direct National Applications are filed with the Companies and Intellectual Property Commission (CIPC).³

¹ Statutory framework for use of a trademark as foundational to rights flowing therefrom: s2(1) of the Trade Marks Act 194 of 1993 ('the Trade Marks Act') defines a trademark in terms of a mark used or intended to be used in the course of trade; Section 9 and 10 provide for distinctiveness to arise through use; S34(1) allows for the defence and continued use of earlier rights arising from prior use; S27 provides for removal from the register if there has been no bona fide use for a continuous period (five years); and s35 provides for the protection of well-known foreign marks in SA *even without registration*, based on reputation derived through use. South African common-law also recognises rights in unregistered marks derived from use thereof. Most widely-cited authority regarding the principle that common-law rights derive from use, particularly through the remedy of passing-off, is *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd 1997 (1) SA 1 (A)*.

² Section 16(3) requires that an application must contain the '*particulars required by regulation*'. The Trade Marks Act consistently refers to registration in respect of goods or services in a class', using the singular. The statutory structure presumes a *separate application per class* because registrability, examination, refusals, and oppositions are all class-specific. In addition, the Regulations to the Act (https://www.saflii.org/za/legis/consol_reg/tmr212.pdf) incorporate the Nice Classification and require that an application must specify the class applied for. Furthermore, in terms of Regulation 11, only the prescribed Form TM1 may be used for a trademark application. The form permits only one class, making multi-class applications procedurally impossible under the Regulations.

³ https://www.cipc.co.za/?page_id=1423

South Africa is not a member of ARIPO or OAPI.

South Africa is not a member of the Madrid Protocol.

1.4. Duration

In terms of Section 37 of the Trade Marks Act⁴, the initial registration term for a trademark registration is 10 years. Thereafter it is renewable indefinitely for a period of 10 years. Renewal fees must be paid before expiry. Late renewal is possible with surcharge.

1.5. Substantive examination

South Africa conducts substantive examination which covers both absolute grounds (including if a mark is devoid of distinctiveness, descriptive, deceptive, scandalous, or contrary to public policy⁵) and relative grounds (if a mark conflicts with earlier registered marks or well-known marks⁶). Examiners assess distinctiveness, likelihood of confusion, and compliance with statutory requirements.

1.6. Fraudulent or bad faith filings

Fraudulent or bad faith filings are subject to refusal, opposition, and cancellation under statutory provisions. The following provisions of the Trade Marks Act are applicable:

- Section 10(7) provides for refusal if application is made in bad faith.
- Section 21 provides for opposition proceedings, where bad faith can be raised.
- Section 24 provides that registrations wrongly-made or wrongly-remaining on the Register (which would include those obtained by fraud or misrepresentation) can be declared invalid.

1.7. Legislative framework / examination guidelines

Regarding Registry practice, examiners may refuse applications that reproduce well-known marks or show evidence of bad faith.

South African courts have consistently held that fraudulent intent undermines validity, even if formal requirements are met.

⁴ https://iponline.cipc.co.za/Publications/Acts/Trade_Marks.pdf

⁵ S9 of the Trade Marks Act; S10(1) – 10(5) of the Trade Marks Act; S10(7), 10(11) and 10(13) of the Trade Marks Act

⁶ S10(6), 10(12) - 10(17) of the Trade Marks Act. It is noted that some interpretations categorize s10(12) as an absolute ground of refusal due to its reference to marks that are inherently deceptive or where the use thereof would be contrary to law, *contra bonos mores* or likely to give offence to any class of persons

2. Trademark Search methods

Online trademark searches can be conducted on <https://iponline.cipc.co.za/>.

Information accessible includes application number, application date, acceptance date, advertisement date, registration date, trademark, class of goods/services, specification of goods/services, associated trademarks, endorsements, disclaimers, applicant name and address. If an application has been conditionally accepted, it is currently not possible to ascertain the conditions required online.

Online searches are conducted in English, and the Patent Journal⁷, in which trademark applications are published for opposition purposes, is also in English.

Regarding search capability, it is possible to search the online database using an application number and/or a verbal mark. An image/figurative mark can also be searched by uploading the image under the AI Image Search function. The Patent Journal can be searched by publication year, publication month, domain (trademarks, copyright, designs and patents) and application number.

3. Measures Upon Discovering That a Third Party Has Filed or Registered a Mark Identical or Similar to One's Own

3.1. Submission of Information to the Trademark Office Regarding a Fraudulent / Bad-Faith Filing

A letter can be issued to the Registrar of Trade Marks notifying it of an application filed in bad faith and setting out supporting evidence for such a claim; however, the interested party would ultimately have to wait until the application is published in the Patent Journal for opposition purposes to formally oppose the registration of the application.

3.2. Opposition Proceedings

An interested party may within 3 months from the date of advertisement oppose the application.⁸

In practice, opposition is usually commenced by a letter demanding withdrawal of the application (or for removal of specified goods or services covered by the application) and is only filed if the demand is not met.

⁷ <https://iponline.cipc.co.za/Publications/JournalPublications.aspx>

⁸ Section 21 of the Trade Marks Act 194 of 1993

A first 3-month statutory extension of the opposition term can be secured in terms of Regulation 52(1) of the Trade Marks Regulations. Further extensions can be secured with the consent of the trademark applicant.

Settlement negotiations are conducted on an informal basis and must be concluded within the opposition period, or extended opposition period, failing which the envisaged opposition must be filed within that period.

Grounds of opposition

The grounds for opposing the registration of an application are set out under Section 10 of the Trade Marks Act, read with Section 21 of the Trade Marks Act 1993 ("the Trade Marks Act").

Relevant to the issue of a fraudulent application or an application in bad faith, the following are specific possible grounds of opposition:

- a mark in relation to which the applicant has no bona fide claim to proprietorship⁹;
- a mark in relation to which the applicant for registration has no *bona fide* intention of using it as a trademark, either himself or through any person permitted or to be permitted by him to use the mark¹⁰;
- a mark which constitutes, or the essential part constitutes, a reproduction, imitation or translation of a well-known trademark and which is used for goods or services identical or similar to the goods or services in respect of which the trademark is well-known and where such use is likely to cause deception or confusion¹¹;
- a mark the application for registration of which was made *mala fide*¹²;
- a mark which would be likely to deceive or cause confusion, be contrary to law or be *contra bonos mores*¹³, and which provision is broad enough to include bad faith, as well as to rely on Copyright and Copyright infringement or any other conduct which is contrary to law;
- a mark which is identical or similar to a registered trademark that use in relation to the same or similar goods or services would be likely to deceive or cause confusion¹⁴;
- a mark which is identical to a mark which is the subject of an earlier application, or so similar thereto, that use in relation to the goods or services is likely to deceive or cause confusion¹⁵;

⁹ Section 10(3) of the Trade Marks Act

¹⁰ Section 10(4) of the Trade Marks Act

¹¹ Section 10(6) of the Trade Marks Act. This section is protection for an unregistered well-known mark.

¹² Section 10(7) of the Trade Marks Act

¹³ Section 10(12) of the Trade Marks Act

¹⁴ Section 10(14) of the Trade Marks Act

¹⁵ Section 10(15) of the Trade Marks Act

- a mark which is the subject of an earlier application, if registration of the mark is contrary to existing rights of the person making the later application¹⁶; and
- a mark which is identical or similar to a prior registered, well-known mark, if use of the applied for mark would be likely to take unfair advantage of, or be detrimental to, the
- distinctive character or repute of the registered trademark, notwithstanding the absence of deception or confusion¹⁷.

Procedure

The opposition procedure is prescribed in terms of Regulation 19 of the Trade Marks Regulations.

The Trade Marks Regulations can be found at:

https://iponline.cipc.co.za/Publications/Acts/Regulations_v1_trade_mark.pdf and other relevant legislation can be downloaded from <https://iponline.cipc.co.za/Publications/Legislation.aspx>.

- Filing the Opposition
 - Form TM3, which is a formal Notice of Motion to the Registrar of Trade Marks, setting out the relief sought and the sections of the Trade Marks Act relied upon, supported by a founding affidavit setting out the grounds and evidence relied upon. The founding affidavit is usually deposed to by an executive of the Opponent having appropriate knowledge of the matter and facts, or where applicable amplified by accompanying affidavits by deponents who are in a position to provide material on issues necessary for the Opponent to discharge the onus it bears in respect of the particular ground or grounds of opposition it claims. All relevant evidence must be adduced at this stage.
 - Responsible party: The Opponent.
 - Timing: Within 3 months of advertisement of the application in the Patents Journal or within any extended time.

Notably, even if the trademark applicant fails to defend the opposition, the opposition will still be considered on its merits.

- Filing Notice of Intention to Defend
 - Responsible party: Trademark Applicant.
 - Timing: Must be filed within 1 month of receiving the Founding Affidavit.
- Drafting and Filing the Answering Affidavit
 - Responsible party: Trademark Applicant.

¹⁶ Section 10(16) of the Trade Marks Act

¹⁷ Section 10(17) of the Trade Marks Act. This provision is akin to a dilution provision.

- Timing: Must be completed and filed within 2 months of filing the Notice of Intention to Defend. Time period can be extended by agreement between the parties.

- Filing the Replying Affidavit
 - This is an opportunity for the Opponent to deal strictly with matters in reply.
 - Responsible party: Opponent.
 - Timing: Must be filed within 1 month of receiving the Answering Affidavit.

After all the papers have been filed, the matter can be set down for hearing. Whilst the Registrar of Trade Marks is empowered to hear defended oppositions, owing to capacity constraints, in practice such oppositions are referred to the High Court for hearing and decision. The onus is on the Opponent to request the referral of the matter, which is done by way of a formal letter. The Registrar will issue a notice formally granting the referral. Presently, due to challenges and delays with finding the official file at the offsite storage facility, it can take a few months to years for an opposition to be referred.

Appeal

In terms of Section 53 of the Trade Marks Act any person aggrieved by any decision or order of the Registrar may, within a period of 3 months after the date of any such decision or order, apply to the High Court for relief, and the said court shall have the power to consider the merits of any such matter, to receive further evidence, and to make any order as it may deem fit.

3.3. Invalidation Proceedings

Invalidation proceedings, which is application for removal of a trademark registration, is governed by Section 24 of the Trade Marks Act, and may be brought at any time after the trademark is registered. Application for removal includes reliance on Section 10 of the Trade Marks Act, which is the grounds of opposition.

Regarding a fraudulent registration or registration obtained in bad faith, the relevant grounds could include any or all of Sections 10(3), 10(4), 10(6), 10(7), 10(12), 10(14), 10(15), 10(16), 10(17) of the Trade Marks Act.

An application for removal may be brought by any interested person, and at the election of the interested person, filed either with the Registrar of Trade Marks or the Court. Practically, owing to the backlogs and delays at the Registry, and the referral by the Registrar of defended matters,

including cancellations, to the High Court, interested parties file such application directly with the High Court.

Procedure

If the applicant elects to file the cancellation (application for removal) with the Registrar of Trade Marks then the procedure and time frames is also governed by Regulation 19 of the Trade Marks Regulations and is the same as for an opposition.

If the applicant elects to file the cancellation (application for removal) with the High Court then the procedure and time frames are in terms of Rule 6 of the Uniform Rules of Court.

- Filing the Application
 - a formal Notice of Motion setting out the relief sought and the sections of the Trade Marks Act relied upon, supported by a founding affidavit setting out the grounds and evidence relied upon. The founding affidavit is usually deposed to by an executive of the Applicant having appropriate knowledge of the matter and facts, or where applicable amplified by accompanying affidavits by deponents who are in a position to provide material on issues necessary for the Applicant for removal to discharge the onus it bears in respect of the particular ground or grounds of removal it claims. All relevant evidence must be adduced at this stage.
 - Responsible party: The applicant seeking removal of the registration.
 - Timing: As soon as the relevant information and evidence is to hand.

Notably, even if the trademark registrant (Respondent in the removal application) fails to defend the removal application, the application will still be considered on its merits.

- Filing Notice of Intention to Defend
 - Responsible party: Trademark Registrant (Respondent in the application).
 - Timing: 5 days from receipt of the application.
- Drafting and Filing the Answering Affidavit
 - Responsible party: Trademark Registrant (Respondent in the application).
 - Timing: to be filed within 15 days, or any extended period as agreed between the parties.
- Filing the Replying Affidavit
 - This is an opportunity for the Applicant in the removal application to deal strictly with matters in reply.

- Responsible party: The applicant seeking removal of the registration.
- Timing: Must be filed within 10 days of receiving the Answering Affidavit, or within such further time as agreed between the parties.

- Creating an online court file and uploading pleadings
 - Responsible party: Applicant.
 - Timing: Approximately 1 week to prepare the Index, create the court file, and open the matter at the High Court.

- Filing Heads of Argument
 - Responsible party: Applicant.
 - Timing: Must be filed within 15 days of service of the Index on the other party.

- Filing Heads of Argument
 - Responsible party: Respondent.
 - Timing: Must be filed within 10 days of receipt of the Applicant's Heads of Argument.

- Setting the Matter Down for Hearing
 - Responsible party: Applicant.
 - Timing: Hearing dates are allocated by the Court, usually within approximately 3–4 months.

- Hearing
 - Responsible parties: Both Parties.
 - Note: Counsel presents legal argument; no oral evidence is typically required unless a factual dispute arises (which is unlikely).

- Handing Down Judgment
 - Responsible party: Judge (presiding officer).
 - Timing: Dependent on the Judge; judgment may take anywhere from approximately 3 to 6 months.

Appeal

If the application for removal was heard by the Registrar then in terms of Section 53 of the Trade Marks Act any person aggrieved by any decision or order of the Registrar may, within a period of 3 months after the date of any such decision or order, apply to the High Court for relief, and the said court shall have the power to consider the merits of any such matter, to receive further evidence, and to make any order as it may deem fit.

If the application for removal was heard by a single judge of the High Court then leave to appeal must be sought from the Judge for either an appeal before the Full bench of the High Court or to the Supreme Court of Appeal. Rule 49(1)(b) of the Uniform Rules of Court provides that leave to appeal must be sought at the time the judgment or order is given, or within 15 days after the date of the order appealed against.

3.4. Non-Use Cancellation Proceedings

In terms of Section 27 of the Trade Marks Act application for cancellation of a trademark registration can be made where either:

- application for the mark was filed without any bona fide intention to use the mark in relation to the relevant goods or services and there has in fact been no bona fide use of the trademark in relation to such goods or services; or
- up to a date 3 months prior to the application, a continuous period of 5 years elapsed without any bona fide use of the mark in relation to the relevant goods or services.

An application for removal may be brought by any interested person, and at the election of the interested person, filed either with the Registrar of Trade Marks or the Court. Practically, owing to the backlogs and delays at the Registry, and the referral by the Registrar of defended matters, including cancellations, to the High Court, as with applications for removal interested parties often elect to file such application directly with the High Court.

The procedure, including steps and time frames, for a non-use cancellation is the same as opposition proceedings if the application is filed with the Registrar. If the application is filed with the High Court, then the procedure and time frames are as stated in relation to an application for removal.

The appeal process is also as stated in relation to an application for removal.

3.5. Other Procedures for Revoking or Extinguishing Rights

Not applicable.

MOROCCO

1. Overview of the Trademark System

1.1. First-to-file or first-to-use

Morocco adopts the first-to-file system. In terms of Article 153, Law No. 17-97 on the Protection of Industrial Property (2000)¹⁸, registration confers exclusive rights to the owner. Prior use without registration may support an action for unfair competition, but registration is the primary basis for enforceable rights.

1.2. Single or multi-class application system

Morocco permits multi-class applications. Following the amendments under Law No. 23-13, applicants can file a single application covering multiple classes of goods/services. This aligns Morocco with international practice and simplifies filing.

1.3. Available filing routes

Direct national applications are filed with the Moroccan Office of Industrial and Commercial Property (OMPIC)¹⁹.

Morocco is not a member of ARIPO or OAPI. Accordingly, there is no regional trademark route available.

Morocco has been a member of the Madrid Protocol²⁰ since 1999. Applicants can therefore designate Morocco through an international application. OMPIC examines Madrid designations under national law.

1.4. Duration

In terms of Article 152, Law No. 17-97, a trademark registration in Morocco is valid for an initial term of 10 years. It is renewable indefinitely for further periods of 10 years each, subject to payment of renewal fees. Legislation does provide for a late renewal within 6 months of the expiry date, subject to payment of extra fees.

1.5. Substantive examination

Morocco does not conduct substantive examination. Examination is conducted as to the form and on absolute grounds only. Regarding absolute grounds, Articles 134 & 135, Law No. 17-97 provide for

¹⁸ <http://www.ompic.ma/en/content/laws-and-regulations>

¹⁹ <http://www.ompic.ma/en>

²⁰ <https://www.wipo.int/wipolex/en/text/283484>

the refusal of a mark that is devoid of distinctiveness, descriptive, deceptive, contrary to public order or morality. No examination is conducted on relative grounds and the TMO does not reject a trademark application based on a prior existing identical/similar trademark. The onus rests on an interested party to file an opposition against a trademark application once published.

1.6. Fraudulent or bad faith filings

Fraudulent/Bad-Faith Applications can be subject to cancellation under statutory provisions. Article 142 of Law No. 17-97 provides for recovery of rights on a trademark that was filed in bad faith and in violation of a contractual obligation by the distributor, the licensee or the representative in Morocco.

2. Trademark Search methods

Online trademark searches can be conducted on the national database at <http://www.ompic.ma/fr/content/recherche-sur-les-marges-nationales>. International trademarks can be searched through Madrid Monitor at <https://www3.wipo.int/madrid/monitor/en>. The information accessible includes application number, trademark, class of goods/services, specification of goods/services, applicant name and address.

The national database is only accessible in French.

Search capability varies depending on which website is used. Madrid Monitor offers extensive search capabilities.

3. Measures Upon Discovering That a Third Party Has Filed or Registered a Mark Identical or Similar to One's Own

3.1. Submission of Information to the Trademark Office Regarding a Fraudulent / Bad-Faith Filing

There is no provision for informal submission of information to the Moroccan Office of Industrial and Commercial Property (OMPIC) regarding a fraudulent or bad-faith filing. Bad faith also does not constitute grounds for OMPIC to reject an application during examination.

Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23 (collectively the "Industrial Property Law"), in terms of Article 142 provides for a claim to ownership application to be made to Court if registration of a mark has been requested in fraud of the rights of a third party, or in violation of a legal or contractual obligation. The person making application needs to show a right to the trademark in issue.

3.2. Opposition Proceedings

The holder of a prior right may file opposition with OMPIC.

A prior right includes²¹:

- an earlier trademark registration;
- an earlier trademark application, or an application benefiting from an earlier priority date;
- an earlier trademark that is well-known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property; and
- a geographical indication or designation of origin protected or filed prior to the application being opposed.

A licensee of a prior right is also entitled to file opposition, unless otherwise stipulated in the contract.²²

Opposition against an advertised national trademark application may be filed by a holder of a prior right within 2 months from the date of advertisement.²³

Opposition against an international registration (filed in terms of the Madrid System and designating Morocco) must be filed within 2 months from the first day of the month following receipt of the WIPO Gazette with the advertisement by OMPIC.²⁴

Agents (being legal professionals and industrial property consultants) are allowed to file an opposition on behalf of a third party.²⁵ The agent should hold a power of attorney from the third-party Opponent authorizing the filing of the opposition.

Procedure

Opposition is filed with OMPIC using form M7, together with any attachments such as a power of attorney, evidence that the trademark is well-known, proof of payment of the opposition filing fee payable per class.²⁶

²¹ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23 and see <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

²² Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

²³ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

²⁴ See OMPIC's official website at <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

²⁵ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

²⁶ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

The notice of opposition, on form M7, must include a presentation of arguments laid out in the following three parts²⁷:

- Comparison of the goods and services;
- Comparison of the signs; and
- Where relevant, reputation and recognition to show that the trademark is well-known.

Once the opposition has been filed OMPIC notifies the trademark applicant, or the trademark applicant's agent if applicable, of the opposition.²⁸

The trademark applicant has a 2-month period within which to file a counter-statement. If the absence of the filing of a counter-statement, OMPIC will consider and rule on the opposition.²⁹

If the trademark applicant or its agent files a response (counter-statement) in time, the Opponent, or the Opponent's agent, has a 1-month period running from the date of notification of the response by OMPIC, to submit its reply or further observations.³⁰

The trademark applicant or its agent may submit a supplementary response within 1 month of the date of notification of the Opponent's further submissions / reply.³¹

OMPIC is supposed to issue a ruling on the opposition, which ruling is to be a written and reasoned ruling, within a period not exceeding 6 months following expiry of the 2-month opposition term.³² The 6-month period for issuance of a ruling can, however, be suspended.³³

Grounds of opposition:

Article 148 of the Industrial Property Law provides that an application for a trademark should be refused if it does not comply with the provisions of Articles 133, 134 and 135, and/or has been opposed by the holder of a prior right as defined in terms of Article 148.2 of the Industrial Property Law.

²⁷ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

²⁸ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

²⁹ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3(2) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³⁰ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3(3) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³¹ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3(3) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³² See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3(5) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³³ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms> and in terms of Article 148.3(8) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

Relevant to the issue of fraud and/or bad faith, the grounds of opposition include:

- that the application conflicts with a prior trademark registration in Morocco³⁴;
- that the application conflicts with a trademark application of another party that enjoys priority³⁵; and
- that the mark conflicts with a well-known trademark within the meaning of Article 6bis of the Paris Convention³⁶.

An assessment is conducted that covers a comparison of the goods and services, and it is considered if the goods or services are identical, or if there is identity by category of the goods or services, considering the principle of speciality.³⁷

The assessment also involves a comparison of the signs for identity or similarity based on visual, phonetic or conceptual aspects.³⁸

Further, where applicable a review is conducted of the evidence purporting to show that the mark in issue is well-known.³⁹ The threshold for proving that a mark is well-known is fairly high and requires showing recognition and knowledge of the mark in Morocco, which is often demonstrated through sufficient and suitable evidence of sales and advertising.

Appeals

An appeal against OMPIC's decision in an opposition matter must be filed within 15 days of notification of the decision by OMPIC.⁴⁰

An appeal is to be filed with the Casablanca Commercial Court of Appeal.⁴¹

Other notes

In practice, opposition can only be based on one prior right. Therefore, in the instance that a holder (Opponent) has more than one relevant prior right, the most appropriate or strongest right must be presented as the prior right.

³⁴ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³⁵ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³⁶ Article 148.2 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

³⁷ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

³⁸ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

³⁹ See <http://www.ompic.org.ma/en/respect-droit/legal-mechanisms>

⁴⁰ Article 148.3(6) of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴¹ Article 148.5 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

3.3. Invalidation (Nullity) Proceedings

Article 161 of the Industrial Property Law provides that any concerned person, including the public prosecutor, may request nullity (invalidation) of the registration of a mark, if such registration is in violation of the provisions of Articles 133 to 135 of the Industrial Property Law.

Article 161 of the Industrial Property Law further provides that invalidation or nullity proceedings on the basis of Article 137 of the Industrial Property Law may only be instituted by the holder of the earlier right. In turn, Article 137 of the Industrial Property Law prohibits adoption and registration of marks which infringe earlier rights, particularly:

- an earlier mark that has been registered or that is well-known within the meaning of Article 6bis of the Paris Convention;
- the name or style of a company, where there is a risk of confusion in the minds of the public;
- a trade name or sign board known throughout the national territory, where there is a risk of confusion in the minds of the public;
- a protected geographical indication or appellation of origin;
- rights protected by the Law on the Protection of Literary and Artistic Works;
- rights derived from a protected industrial design or model;
- the personality rights of another person, particularly his surname, pseudonym or likeness;
- the name, image or repute of a local authority.

An application for nullity (invalidation), in terms of Article 161 of the Industrial Property Law, by the holder of an earlier right will not be admissible if the mark was filed in good faith and the holder has tolerated use of the mark for a period of 5 years.

Article 162 of the Industrial Property Law provides that the owner of a well-known trademark within the meaning of Article 6bis of the Paris Convention may claim cancellation of the registration of a mark which is liable to lead to confusion with the owner's own mark. However, the right to such a claim shall prescribe 5 years after the registration date of the mark, unless the registration was applied for in bad faith.

Application for nullity is to be made to the Court.

3.4. Non-Use Cancellation Proceedings

Article 163 of the Industrial Property Law provides that a registration for a mark in respect of which there has not been genuine use in connection with the goods and services covered by the registration for an uninterrupted period of 5 years, without good reason, is liable to be revoked / cancelled.

Revocation or cancellation may be requested by any concerned person.⁴² Application is made to the Court⁴³.

Depending on the facts, revocation may be partial, namely in respect of only part of the goods or services covered by the registration, or full.⁴⁴

Article 163 of the Industrial Property Act includes express provision regarding what use will be considered which is:

- Use made with the consent of the owner of the mark or, in the case of a collective mark, in compliance with the regulations relating to use of the specific collective mark;
- Use of the mark in a modified form which does not alter its distinctive nature;
- Affixing of the mark on good or their packaging, exclusively for export.

There is a window period in that genuine use of the mark in issue which begun or resumed after the 5-year period, but within 3 months prior to the request for revocation and after the holder of the registration gained knowledge of the possibility of a request for revocation, will not be an obstacle to a non-use revocation claim⁴⁵. It will not be a defense.

Whilst the party seeking revocation of a registration should present a prima facie case, with basic information, including searches or investigations, showing there is no evidence of genuine use of the mark in relation to the relevant goods or services within the 5-year period, the burden of proving use (exploitation of the mark) rests with the owner of the mark for which revocation is requested⁴⁶. Proof may be furnished by any means.

3.5. Other Procedures

Claim to Ownership

Article 142 of the Industrial Property Law provides for a party who believes it has a right to a trademark to claim ownership of the registration.

Grounds for a claim to ownership are that the registration was applied for either⁴⁷:

- fraudulently with respect to the rights of another person; or

⁴² Article 163 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴³ See <http://www.ompic.org/ma/en/respect-droit/legal-mechanisms>

⁴⁴ Article 163 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴⁵ Article 163 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴⁶ Article 163 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴⁷ Article 142 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

- in violation of a statutory or contractual obligation.

A claim to ownership application is made to the Court.⁴⁸

Except if the applicant acted in bad faith, a claim to ownership is barred after 3 years from the date of registration of the trademark in the national trademark register.⁴⁹

Although governed by a different provision of the Industrial Property Law, a claim that a registration was made fraudulently, so in bad faith in view of another party's prior rights, is also considered a nullity action for fraud.

⁴⁸ Article 142 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

⁴⁹ Article 142 of Law No. 17-97 on the Protection of Industrial Property, as amended by Law No. 23-23

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