



4 Nov
2020

Crossing the Zambezi: key issues for brand owners following the completion of the Kazungula bridge

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- **The completion of the Kazungula bridge between Botswana and Zambia creates both new opportunities and new threats in the region**
- **The new bridge may increase the likelihood of counterfeits crossing from one country to another**
- **Neither country makes provision for a customs watch**

The recent completion of the \$260 million Kazungula bridge between Botswana and Zambia is long overdue, replacing as it does a ferry that has to date provided the only means of crossing the Zambezi river. The 930-metre-long bridge - which will feature a single line railway, two traffic lanes, pavements for pedestrians and international border facilities - is expected to significantly improve the trade infrastructure of the Southern African Development Community and the African continent as a whole.

A new bridge creates new opportunities - but with opportunities come threats. This update discusses trademark matters in the two countries joined by the bridge, and raises some issues that brand owners need to be aware of due to the new transport link.

Botswana

The country

On the south bank of the river lies Botswana, a large country with a population of just two million. Botswana is peaceful and stable. The country has a fast-growing economy that is heavily dependent on mining, construction and services.

The law

Botswana is a country with a British law heritage. It is a member of the Madrid Protocol. International registrations are valid and there are specific provisions for them in the legislation, the Industrial Property Act 2010.

The owner of a trademark registration has extensive rights. It can prevent a third party from using a confusingly similar trademark in relation to the same or similar goods or services if there is a likelihood of confusion. It can also stop a third party from using a confusingly similar trademark in relation to any goods or services where that use causes "unfair economic prejudice" through "dilution of the distinctive character or advertising value of the mark". A court can grant an injunction, delivery-up or destruction of goods, damages and an account of profits. Significantly, there is no provision for a customs watch.

Zambia

The country

To the north lies Zambia, another large country, but one that has a population of some 17 million. Mining is important, but other significant economic activities include agriculture, construction and food production.

The law

Zambia also has a British law heritage. However, in the case of Zambia the trademark legislation, the Trademarks Act Cap 401, is decidedly old school - it is one of the few trademark statutes that is still based on the UK Trademarks Act 1938. One consequence of this is that it is not even possible to get protection for services; another is that the register is split into two parts, Parts A and B, with Part B being reserved for marks of limited distinctiveness.

Zambia is a member of the Madrid Protocol, but it has not yet incorporated this treaty into its national law, something that a so-called 'British-law country' needs to do. This is important because there is a Zambian court judgment that strongly suggests that, as a result of Zambia's failure to incorporate the Madrid Protocol into national law, international registrations are in fact not valid in Zambia (see *Johnson and Johnson v Aardash Pharma Limited* (2016/HP/A025)).

A bit of explanation is in order. The judgment in fact dealt with well-known marks rather than international registrations, although they are mentioned in passing. The judge held that well-known marks are not protected in Zambia because the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) has never been incorporated into Zambian law. The view of many is that, if well-known trademarks enjoy no protection in Zambia as a result of the country's failure to incorporate the TRIPS Agreement into national law, international registrations are not protected either. It should be noted that, in 2019, there was a registry judgment where the hearing officer held that international registrations are valid in Zambia, but the consensus is that this is wrong (see [Sigma-Tau Industrie Farmaceutiche Riunite v Amina Limited](#) (27 August 2019)).

As for rights, the owner of a Zambian trademark registration has rather limited rights - it can stop a third party from using an identical mark or a confusingly similar mark, but only if the infringing mark is used on goods actually covered by the registration. Worryingly from an anti-counterfeiting point of view, there is no provision for a customs watch.

The future

New legislation is in the pipeline, but this has been the case since 2011. When the new law does come into force, Zambian trademark law will look quite different, a lot more like a contemporary trademark system. The new law will, for example:

- give effect to the Madrid Protocol;
- make provision for service marks, collective marks, well-known marks and geographical indications;
- allow for registration of three-dimensional marks, slogans and colours;
- allow for multi-class filings;
- provide for five-year prison terms for counterfeiting; and
- provide for border seizures of counterfeit goods.

Potential trademark issues in these countries

Protection in just one of the countries

Some brand owners may only have trademark protection in one of the two countries - will that be adequate? Counterfeiting is rife throughout Africa and it is quite possible that the new bridge will increase the likelihood of counterfeits crossing from one country to another - or indeed parallel imports. Trademark protection in both countries may therefore be prudent.

Madrid Protocol

Some companies now use the Madrid Protocol in order to get trademark protection in certain African countries. Although the Madrid Protocol is available in both Botswana and Zambia, there are serious doubts about the validity of international registrations in Zambia. Brand owners who simply have protection in Zambia through an international registration may wish to consider a national registration.

Customs watch

On the issue of counterfeits, neither country makes provision for a customs watch. Brand owners with commercial interests in either country should therefore make provision for investigation and enforcement activity.

The author's experience in Zambia has been positive, and her perception is that the authorities do take counterfeiting seriously. In a matter involving a leading drinks company, it was established that the Zambian market was flooded with counterfeits of that company's brands, and that these counterfeits were even being sold in duty-free shops at airports. Working with the police, it was possible to find and confiscate over 600 cartons of counterfeit whisky. The counterfeiter entered a guilty plea at court.

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