AfCFTA AND THE CALIBRATION OF TRADE MARK POST-REGISTRATION USE REQUIREMENTS

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ABSTRACT

Trade marks, while facilitating brand recognition and consumer trust, may also become trade barriers when unused registrations clutter national registries. Africa's cluttered registries, dominated by dormant marks (often from non-African individuals or entities), impose disproportionate costs on local traders by raising barriers to market entry and hindering competitiveness. This article examines the proliferation of unused registered trade marks in Africa and their detrimental impact on intra-continental trade under the African Continental Free Trade Area (AfCFTA). Through an analysis of post-registration use requirements across selected states and registry data, the article proposes a harmonised AfCFTA framework that reduces the post-registration use period and automatic expungement for specific high-clutter classes. This calibration aims to purge unused marks, reduce artificial trade barriers, and foster authentic brand competition, thereby advancing the AfCFTA's goals of economic integration and Agenda 2063.

KEYWORDS: AfCFTA, trade marks, post-registration use, post-registration, clutter, economic integration, evergreening, non-tariff barrier

1. Introduction

The modern economy increasingly relies on trade marks, the most widely registered, used and maintained type of intellectual property right in the world,[1] for value creation. The most valuable trade marks and their related goodwill easily dwarf that of comparable copyright-protected works and of patented inventions.[2] Where works and inventions could be seen as tradable commodities, trade marks may be a closer representation of the market itself. Further, the normative framework and the registry infrastructure of trade marks

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1 L Bently, B Sherman, D Gangjee & P Johnson et al *Intellectual Property Law* 6 ed (2022). The authors consistently identify trade marks as the most numerously registered and commercially pervasive form of registered IP right. See also: WIPO 'World Intellectual Property Indicators 2024', available at: https://www.wipo.int/edocs/pubdocs/en/wipo-pub-941-2024-en-world-intellectual-property-indicators-2024.pdf (accessed on 20 July 2025). WIPO's annual World Intellectual Property Indicators reports consistently show trade marks, estimated 11.6 million trade mark applications were filed worldwide in 2023, dwarfing all other registered IP rights. Furthermore, an estimated 88.2 million trade mark registrations were active in 2023. Trade marks clearly outpace both patents (by a factor of ~4.5× vs patents) and industrial designs (almost 5× more than patents, and 14× more than designs), and their continual renewal over time makes them especially enduring.

2 C Castaldi 'All the great things you can do with trademark data: Taking stock and looking ahead' (2019) *Strategic Organization* 18(3) 472.

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may serve as both a private and public good,[3] contribute to both micro and macro-economic ends, and how each state's trade mark system is calibrated in relation to others may affect trade and competitiveness of private enterprises operating within its territory.

As a moderately harmonised species of intellectual property with very little in terms of divergence in procedural frameworks,[4] trade mark harmonisation within Africa offers a relatively low-hanging fruit for states seeking development-driven regional economic integration, while simultaneously supporting private sector growth. In the context of regional trade, such as between member states of the African Continental Free Trade Agreement ('AfCFTA'),[5] trade marks can be instrumental in stimulating economic growth by reducing consumers 'search costs',[6] safeguarding consumers from counterfeit goods and reducing trade barriers by promoting the free flow of goods and services. They provide a common language for businesses across borders, facilitating communication and understanding. This shared understanding could cultivate trust and reduce transaction costs, leading to increased trade and economic cooperation.

However, these promised benefits to inter-state trade are premised on credible trade mark registries where registered marks are legitimately used in trade. While proof of use is not required in many countries for either registration or renewal, it is critical for maintaining trade mark rights and preventing registries from being cluttered with unused marks. Across the African continent, the statutory post-registration period following which a registrant must use their trade mark or risk it being cancelled due to non-use varies between countries from three to five years. On the other hand, while art 10(2) of the AfCFTA Protocol on Intellectual Property (IP protocol)[7] allows states to make registrability dependent on use, this is a resource-heavy administrative task that no African state has or is likely to implement.

This contribution, particularly in Part 4, proposes a harmonised automatic expungement approach on the African continent, which must be understood in the context of binding international intellectual property obligations. Two sets of norms are particularly important. First, the Paris Convention

3 P Bhatia 'Role of public interest in Trademark Law' (2021) 25(1) *The Journal of World Intellectual Property* 236–246.

4 *Paris Convention for the Protection of Industrial Property,* 20 March 1883, as revised at Stockholm, 14 July 1967, 828 UNTS 305 (entered into force 26 April 1970) ('Paris Convention'). More than 190 countries are party to the Paris Convention, ensuring a common framework in both substance and form. *Madrid Agreement Concerning the International Registration of Marks*, 14 April 1891, as revised at Stockholm, 14 July 1967, and amended in 1979, 828 UNTS 389 (entered into force 6 July 1989) ('Madrid Agreement'). *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, 27 June 1989, 1989 UNTS 408 (entered into force 1 December 1995) ('Madrid Protocol'). The Madrid Agreement and especially the Madrid Protocol (which has over 115 contracting parties, including most major economies) enable centralized international registration of trade marks through the World Intellectual Property Organization (WIPO).

5 *Agreement Establishing the African Continental Free Trade Area*, 21 March 2018, AU Doc. No. AfCFTA/Agreement/28/01/2018 (entered into force 30 May 2019) ('AfCFTA').

6 WM Landes & RA Posner 'Trademark law: An economic perspective' (1987) 30 *J.L. & ECON* 265.

7 *Protocol on Intellectual Property Rights to the Agreement Establishing the African Continental Free Trade Area*, adopted 5 February 2023, AU Doc. No. AfCFTA/Protocol/IPR/2023 (not yet in force) ('IP Protocol').

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(including art 6*bis* on well-known marks) requires member states to provide protection against unfair competition and to recognise certain protections for well-known marks irrespective of registration. This requires any automatic expungement procedure to preserve the rights of well-known brands and to provide an adequate mechanism to recognise well-known status. Secondly, the TRIPS Agreement[8] shapes permissible regulatory space, allowing member states to legislate for legitimate public policy objectives (arts 7–8) while requiring national treatment and prohibiting unjustifiable barriers to trade. Any harmonised AfCFTA measure (or a regional instrument) must therefore be calibrated to respect TRIPS obligations, including non-discrimination and the protection of well-known marks. The AfCFTA Protocol on Intellectual Property also provides scope for coordination but does not displace these pre-existing obligations. As such, the proposed harmonised three-year post-registration use declaration requirement coupled with a default expungement regime proposed in this contribution should include explicit safeguards for well-known marks, procedural fairness, and non-discriminatory treatment of resident and non-resident applicants.

In this paper, therefore, the author explores the danger of unused registered trade marks in Africa, which he postulates may impose disproportionately higher costs on future local traders when compared to other regions. Part 2 of this article discusses the economic and trade characteristics of trade marks, followed, in Part 3, by an analysis of how these characteristics may be leveraged for the benefit of intra-African trade. In Part 4 of this paper, as intimated above, drawing on an analysis of use requirements in various states, regional bodies and registry data, the author proposes a shorter unified post-registration use period (three years) for AfCFTA member states and automatic expungement for specific high-clutter classes (Class 3, 9, 25 and 35). The rationale here is that even marginal cost increases disproportionately affecting SMEs accumulate across borders and may deter first-time exporters. From a policy perspective, low-cost regulatory fixes that remove such friction arer justified even without perfect econometric proof. This harmonised approach aims to promote genuine trade mark use, reduce trade barriers, and foster competitiveness within the AfCFTA, contributing to the realisation of the African Union's Agenda 2063 goals for economic growth and regional integration.

2. Trade Marks, Economic Development and Trade in Africa

Trade marks are distinctive names or symbols that the producer or supplier of products and services registers and uses in relation to those products to inform the public that they are the producer or supplier of those products.[9]

8 *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS),* Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization, 15 April 1994, 1869 UNTS 299 (entered into force 1 January 1995) ('TRIPS Agreement').

9 O Dean & A Dyer (eds) *Dean and Dyer: Introduction to Intellectual Property Law* (2012) 93.

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The modern economy increasingly relies on intangible assets, such as trade marks, for value creation. Implied in this is that trade marks can be viewed from a broad macroeconomic and trade perspective as a policy instrument capable of influencing national and international economic outcomes.[10] This view can extend to key macroeconomic objectives such as fostering economic growth, shaping international trade patterns, attracting foreign direct investment, and promoting overall economic development, particularly in an increasingly interconnected African continent. To avoid confusion, this hypothesis should be grounded in the understanding that, inasmuch as the state does not 'own' the marks it permits to be registered, it is duty-bound to regulate them in a manner that is beneficial to the public good.

'Use' in trade mark law is doctrinally and functionally distinct from mere ownership of a registration. Given that fundamental purpose of a trade mark is to distinguish the goods or services of one trader from those of another, use in the marketplace is what makes a mark function as a true identifier of source or origin. The use requirement, therefore, ensures that a trade mark owner's exclusive rights are limited to the way the public actually perceives the mark. The 'bargain' between the owner and the public is then that, for a limited monopoly granted to the trader over certain marks, the trader must use the mark for the informational role of distinguishing their goods and services from those of others.

The right to use the name or symbol is conferred exclusively on the registrant in a particular territory, in principle indefinitely, provided that they continue to use it in relation to related products and renew it with the relevant authorities. The key requirement of the trade mark is that, through its use, it must empower the consumer to easily differentiate the products of one proprietor from those of another. In doing so, these signs are intended to ensure that consumers make informed choices and reduce the transaction costs in their search and comparison of the variety of products on the market. Accordingly, in the market, some signs may serve to identify the origin, others to certify quality and others to protect the reputation of the originating firm.[11] Trade mark law, then, viewed through the lens of microeconomic policy, primarily serves as a mechanism to reduce consumer search costs in the marketplace.[12]

In market competition, characterised by a rivalry between firms in a market for goods or services ('products'),[13] trade marks, while helping consumers identify the source of the products, may generate more revenue and offer additional choices to consumers when used to identify new and innovative products.[14] They may also signal the investment in goodwill in those products

10 EE Johnson 'The macroeconomics of intellectual property' (2023) 100 *Washington University Law Review*.

11 PS Morris 'Intellectual property for breakfast: Market power and informative symbols in the marketplace' (2019) 68 *Clev. St. L. Rev.* 51.

12 Landes & Posner (n6).

13 Morris (n11).

14 LA Heymann 'Trademark law and consumer constraints' (2022) 64 *Arizona Law Review* 342.

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when they represent an existing product.[15] When a trade mark becomes associated with a certain level of quality in the minds of consumers over time, to maintain the value of their trade mark and the related goodwill, businesses are motivated to ensure that their products meet consumer expectations.[16] In a self-enforcing loop, businesses with valuable trade marks would be hesitant to lower the quality of their products for fear of damaging their reputation and losing consumer trust.

In a dynamic market, therefore, competition should be promoted by trade marks in that they serve as incentives for the efficient production and supply of products by a single proprietor by protecting the reputation of the firm. This, in turn, also signals competitors to enter the market. In considering the relationship between trade marks and competition, it can be understood that trade marks not only enhance consumer recognition but also enable trade mark holders to secure a loyal customer base, thereby increasing their market share. This creates a dynamic where trade mark holders can leverage their brand reputation to maintain a competitive edge, even in the face of market entry by new rivals.

Researchers in this field emphasise that trade marks contribute to product differentiation, which is a critical aspect of maintaining dynamic market competition, but can simultaneously lead to market dominance by established players.[17] The implications of this are evident in early foundational rulings of the European Court of Justice, currently the Court of Justice of the European Union ('CJEU'),[18] grappling with the tension between trade marks and the free movement of goods within the European community.[19] This court[20] and those in South Africa[21] have noted that the protection of trade marks must not unduly restrict competition. This balance between protecting brand value and avoiding market distortion is crucial in understanding how trade marks

15 Ibid.
16 Heymann (n14) at 358.
17 Morris (n11) at 50.
18 In *Centrafarm BV & another v. Sterling Drug Inc.* (Case 15/74), the European Court of Justice (ECJ) held that a trade mark owner may not use its mark to block parallel imports of goods legitimately placed on the EU market, even if the goods carry the proprietor's mark, with such use constituting a barrier to free trade incompatible with EU law. In *Consten & Grundig v Commission* (Joined Cases 56–58/64), Grundig had granted exclusive distribution rights and the exclusive use of its trade mark in France. The ECJ found that such arrangements unlawfully restricted intra-EU trade under then-art 85 (today's art 101). In *Van Zuylen frères v Hag AG* (Case 192-73), the Court, while recognising the legitimacy of trade mark rights, held that these rights cannot be used to artificially partition the single market.
19 RS Smith 'The unresolved tension between trademark protection and free movement of goods in the European community' (1992) 3 *Duke Jornal of Comparative & International Law* 89.
20 The CJEU has repeatedly stressed that trade mark rights are not absolute but rather that protection should be confined to cases where one of more function (especially the origin function, reputation function, or advertising function) are adversely affected. See: *Interflora Inc v Marks & Spencer* (Case C-323/09) - CJEU (22 Sept. 2011) paras 66 and 91, *Google France SARL & Google Inc v Louis Vuitton Malletier SA* (Joined Cases C-236/08–C-238/08) - CJEU (23 Mar. 2010) paras 71–90, and *L'Oréal SA & others v eBay International* (Case C-324/09) - CJEU (12 July 2011) para 131.
21 *Cochrane Steel Products (Pty) Ltd v M-Systems Group (Pty) Ltd & another* [2016] ZASCA 74 paras 19–23.

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influence market structures and may be regulated manner that encourages rather than obstructing trade.

In the context of the AfCFTA, it is essential that lawmakers and regulators note that even though trade mark laws operate within a broader ecosystem of consumer information law, aiming to ensure that the information available to consumers in the marketplace is truthful and not misleading, the ability of trade mark laws to serve their informational purpose effectively is not uniform across all consumers.[22] Factors such as a consumer's literacy level and socioeconomic status can influence their capacity to understand and utilise the information conveyed by trade marks, with some studies suggesting that disadvantaged consumers might be affected by trade mark law in ways that differ from the experiences of the legal professionals who adjudicate trade mark disputes.[23] Authorities should also take into account that the microeconomic analysis of trade mark law relies heavily on information economics, particularly the concepts of information asymmetry between producers and consumers and the role of trade marks in reducing search costs.[24]

From a macroeconomic perspective, studies indicate that trade mark law plays a significant role in shaping national competitiveness and market globalisation by creating a unique market position for firms and allowing them to compete domestically and internationally.[25] Furthermore, research indicates a positive correlation between investment in brands and a country's GDP per capita (at least in the Global North),[26] suggesting that nations whose firms invest in branding and registering trade marks tend to experience higher levels of economic development. This connection arises because brand investment drives competition, encourages innovation, and enhances market efficiency, all contributing to overall economic growth.[27] Trade marks also facilitate market globalisation by enabling companies to establish and protect their brands across international borders.

3. The Impact of Clutter on Inter- and Extra-Africa Trade

In spite of the discussions above, a significant concern arises for African countries in their local registries being dominated by trade marks from the

22 Heymann (n14).
23 Ibid.
24 SL Dogan & MA Lamley 'A search-cost theory of limiting doctrines in trademark law" (2007) 97(6) *The Trademark Reporter* 1225.
25 E Baroncelli, C Fink & BS Javorcik 'The global distribution of trademarks: Some stylised facts' (2005) 28(6) *The World Economy* 765.
26 F Erixon & M Salfi 'Building value: The role of trademarks for economic development - European Centre for International Political Economy' (2015), available at: https://ecipe.org/wp-content/uploads/2015/11/Policy-Brief-Building-Value.pdf (accessed on 21 July 2025).
27 CA Corrado, CR Hulten, & DE Sichel 'Intangible capital and economic growth' National Bureau of Economic Research Working Paper No. 11948 (2006), available at: https://www.nber.org/papers/w11948 (accessed on 10 October 2025).

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Global North,[28] as strong and well-established marks may also present barriers to entry for new competitors,[29] potentially adding further to trade imbalances and obstructing the AfCFTA goal of increased trade between African states. Multilateral and bilateral agreements between African states and external parties may play a role in this situation.[30]

The TRIPS agreement,[31] administered by the World Trade Organization (WTO), represents a landmark in this integration, establishing minimum standards for the protection and enforcement of a broad spectrum of IP rights across its member nations, thereby linking IP to the multilateral trading system. The increasing intertwining of IP law and trade policy underscores the global recognition of the economic significance of knowledge and innovation. However, this also introduces considerable complexities, particularly for countries at different stages of development and with varying levels of technological capabilities.

Trade imbalances, characterised by African countries often experiencing trade deficits with their developed counterparts, can impact their leverage and strategic choices in trade negotiations that involve IP.[32] Developed countries may employ various trade policy instruments to exert pressure on African nations to enhance their IP protection regimes in ways that align with the former's commercial interests.[33] This pressure can manifest in various forms, including the linkage of trade benefits to the level of IP enforcement (such as with AGOA) and the advocacy for the adoption of specific legal standards that align with the interests of the developed nations' trade mark holders.[34] This trade pressure, where African countries administer permissive registries, can also be exerted within the registries through the dominance of foreign-owned marks.

28 Baroncelli et al (n25). In an analysis of disaggregated trade mark registration data spanning over 100 countries from 1994 to 1998, the authors concluded that while a vast majority of the mark registered in high income countries were owned by residents, the opposite was true in low income countries. Over 80% of registrations were in the name of foreigners. See also: TT Azomahou & M Diene 'Structural change and economic dynamics' (2012) 22(4) *Structural Change and Economic Dynamics* 431 where the distribution of resident v non-resident registrations of trade marks and patents (particularly in Sub-Saharan Africa) are aligned with innovation. B Beebe & JC Fromer 'Are we running out of trademarks? An empirical study of trademark depletion and congestion' (2018) 131(4) *Harvard Law Review* 962.

29 Johnson (n10).

30 For instance, the *Economic Partnership Agreement between the European Union and its Member States, of the one part*, and the SADC EPA states, of the other part, signed 10 June 2016, OJ L250/3, 16.9.2016 (entered into force 10 October 2016) ('EU–SADC EPA'), while framed as instruments of market access and development, has been instrumental in entrenching asymmetrical trade patterns between African states and the EU by maintaining rules of origin and intellectual property clauses that reflect EU standards.

31 TRIPS Agreement (n8). Similarly, the United States of America via the American African Growth and Opportunity Act (AGOA), Public Law 106–200, 18 May 2000, 114 Stat. 251 (United States) ('AGOA'), retains discretion over eligibility criteria including IP enforcement, often pressing for stronger trade mark protection in African states to benefit American brands.

32 E Jones 'When do "weak" states win? A history of African, Caribbean and Pacific countries manoeuvring in trade negotiations with Europe' (2014) *Global Economic Governance Working Paper, Oxford* No. 2014/95.

33 African Growth and Opportunity Act (AGOA), Public Law 106–200, 18 May 2000, 114 Stat. 251 (United States) ('AGOA').

34 M Nkomo 'IP dimension of bilateral and regional trade agreements in Africa: Implications for trade and development policy' in *WIPO-WTO Colloquium Papers, 2018 Africa Edition* (2018) 65.

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3.1 Dominance of foreign (non-African) registrants

As intimated earlier, the dominance of foreign trade marks on local registries may also reinforce brand dominance and market preferences established by multinational corporations in African markets. The global reach of well-known brands often overshadows local producers in Africa, making it difficult for them to establish their own trade marks or penetrate international markets.[35] This can result in reduced market share for domestic producers in African countries, as consumers may prefer established foreign brands. Trade marks, while contributing to consumer choice, also serve to maintain market power for established brands, potentially stifling competition from new entrants in developing markets. This dynamic perpetuates trade flows that favour the export of branded products from the North to Africa, rather than encouraging balanced trade relationships.[36]

A review of the available annual reports of the African Regional Intellectual Property Organisation ('ARIPO')[37] the South African Companies' and Intellectual Property Commission ('CIPC'),[38] the Kenya Industrial Property Institute ('KIPI'),[39] revealed that the trend of foreign dominance of registries described above by Baroncelli et al persists in African registries, with 45% or more non-resident applicants and registrants. This contrasts even mid-income countries such as China, the Islamic Republic of Iran, the Russian Federation and Türkiye, where they represent between 2.5% and 8% of the total filings.[40] The effect of the dominance of the marks of foreign applicants may be particularly acute in key industries and popular classes such as those for scientific equipment and software, technological service and pharmaceuticals.[41] As there is no continent-wide standard on exhaustion or parallel imports, trade marks (particularly those that are registered but unused) could still serve as a

35 N Lambek 'Imposing IP compliance: Trends in the USTR Special 301 Reports for India and China from 2000–2008' (2009) 2 *Indian J. Intell. Prop. L.* 129. See also: Politico 'How the US and EU pressured South Africa to delay copyright reform', available at: https://www.kipi.go.ke/sites/default/files/2025-03/Kenya_IP_statistics_2000-2022.pdf/ (accessed on 21 July 2025).

36 B Fayissa & B Tadesse 'The impact of African Growth and Opportunity Act (AGOA) on U.S. imports from Sub-Saharan Africa' (2008) 20(7) *Journal of International Development* 928.

37 ARIPO Annual Reports from 2014, 2016 and 2017 (the only complete records reported) of the proportion of non-African trade mark residents revealed a total 40%, 30% and 25%, respective, for each year. Given the nature of the ARIPO registry, however, the figures may not necessarily reflect an increase in resident applicants but rather a waning interest by non-African residents in the ARIPO applications while shifting to national applications. A more accurate reflection would involve a systematic survey of ARIPO member, which is beyond the scope of this contribution.

38 CIPC 'Companies and Intellectual Property Commission Annual Report 2023/2024' (2024), available at: https://www.thedtic.gov.za/wp-content/uploads/CIPC-AR-2024.pdf (accessed on 21 July 2025). Over the preceding five years there was relatively stable distribution of trade mark application between the resident and non-resident with a ratio between two categories of 58% to 42% for 2023/24.

39 KIPI 'Kenya Industrial Property Institute 2000–2022 Statistics' (2022), available at: https://www.thedtic.gov.za/wp-content/uploads/CIPC-AR-2024.pdf (accessed on 21 July 2025).

40 World Intellectual Property Indicators 2024 (n1) at 71. The author is awake to the fact that filing data may not necessarily correlate with the subsequent registry data. Nevertheless, valuable, albeit imperfect, inferences can be drawn from this data.

41 World Intellectual Property Indicators 2024 (n1) at 75.

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legal boundary to exports between African states — thereby further cementing the dominance of firms from the Global North.

When calibrating trade mark laws for increased trade, trade mark registries in African countries will therefore have to account for the fact that their firms may encounter substantial challenges in building and effectively protecting their own brands within the global marketplace, often due to the overwhelming presence and recognition of established brands originating from the Global North.[42] Foreign trade mark owners often hold a considerable proportion of the trade marks that are in force within developing countries,[43] frequently possess greater financial resources for marketing, advertising, and are able to secure robust legal protection, making it difficult for emerging brands from the Africa to gain visibility, compete effectively on an international scale; this potentially impedes the growth and development of local industries by limiting their ability to establish distinct brand identities. This 'cultural and commercial dependence on foreign trade marked goods'[44] is a major obstruction for African states and their corporations in their goal for increased trade liberalisation and development of sources from African solutions. The dominance of marks from the Global North is in and of itself a trade barrier that must be progressively and systematically dismantled.

3.2 Registry clutter

Registry clutter refers to a situation when a large number of unused trade marks, overly broad trade marks and unused classes remain on a register and subsequently block others' use of the same or similar marks.[45] For African traders competing in their market with well-heeled foreign registrants who occupy the registry speculatively, this significantly increases the cost and complexity involved in obtaining trade marks. In light of the aforementioned imbalances in resources, trade, market notoriety and national multilateral power, this further disadvantages African firms looking to expand to their neighbouring states. Clutter, in a sense, is non-state sponsored non-trade barrier emanating from beyond the continent but sustained by registry practices. Admittedly, unlike quotas or licensing rules, it does not formally regulate trade flows. Clutter's barrier effect arises through private enforcement backed by state recognition, rather than direct state actions.

On a more substantive level, the registration of a trade mark with no intention of using it offends the very tenets of trade mark law, that is – use of a mark in trade. Whether protected through statute or common law, 'use' for trade marks serves a similar function to originality for copyright law and utility requirements for patents, in the sense that each operates with the public function

42 D Shanahan 'The trademark right: Consumer protection or monopoly?' (1982) 72 *Trademark Rep.* 233.

43 EV Goldman 'International trademark licensing agreements: A key to future technological development' (1986) 16(1) *California Western International Law Journal* 179.

44 Ibid.

45 G v Graeventiz 'Trade mark cluttering – evidence from EU enlargement' (2013) Intellectual Property Office Research Paper. See also: G v Graeventiz, C Greenhalgh, C Helmers & P Schauteschick *Trade Mark: Cluttering: An Exploratory Report* (2012).

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to encourage the authoring of 'original' works, the production of 'useful' inventions, and the application of marks to goods that fulfil the information function. This then justifies the public good of the monopoly granted in each instance. Instead of reducing consumer search costs through the use on goods and in relation to services, unused marks deplete[46] the presumably finite corpus of existing marks and weakens the utility of having a registry of rights. African states can ill-afford a network of cluttered registries operating an enclave which to raid and cleave African markets in favour of foreign traders acting in bad faith.

A further key consideration regarding clutter has to do with 'well-known' marks. These are famous marks that have special status in trade mark law, where their presence in the system can interact with the problem of registry clutter in interesting and sometimes counterintuitive ways. Under art 6*bis* of the Paris Convention and art 16(3) of the TRIPS Agreement, well-known marks enjoy protection even in the absence of registration and across dissimilar goods. This expansive protection effectively enlarges the 'exclusion zone' around famous (usually foreign) marks, reducing the available mark-space for new entrants and intensifying perceptions of clutter. In light of the fact that well-known marks may be enforced even when unregistered in a jurisdiction, the register itself may underestimate the exclusionary influence. This may result in a form of invisible clutter that would also have to be taken into account in the harmonisation of decluttering laws and policies.

It is therefore incumbent upon African registries to employ effective, practical and forward-looking strategies that not only declutter their registries but also have to account for the obligations to adhere demands of other international instruments.

3.3 Trade mark evergreening

Trade mark 'evergreening', a word borrowed from a similar practice in patent law,[47] refers to the legal or procedural strategy whereby a trade mark owner periodically re-files an identical or nearly identical trade mark, typically just before the grace period lapses.[48] This is done to avoid cancellation for non-use under laws that allow a mark to be removed from the register if it has not been used in trade for a continuous period, commonly three or five years from registration in most African state. The strategy can take three basic forms: (a) Re-filing the same mark in the same class, effectively resetting the three or five-year period, (b) filing slightly altered versions of the same mark to claim renewed protection, or (c) filing the mark in additional or related classes to widen the scope of legal exclusivity.[49] In each instance, the intention is

46 B Beebe & JC Fromer 'Are we running out of trademarks? An empirical study of trademark depletion and congestion' (2018) 131(4) *Harvard Law Review* 962.

47 MZ Abbas 'Evergreening of pharmaceutical patents: A blithe disregard for the rationale of the patent system' (2023) 15(2) *Journal of Generic Medicines* 53.

48 S Southall 'Evergreening' (2023), available at: https://www.kangssolicitors.co.uk/news-insights/intellectual-property-evergreening-trade-mark-protection (accessed on 21 July 2025).

49 Ibid.

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seemingly to prospectively defend against a non-use cancellation application, where the proprietor would otherwise have to demonstrate *bona fide* use or justify non-use.

This practice of evergreening contributes directly to registry clutter in that it results in the congestion of the registry through registration of versions of the same mark by the same owner, which are mostly not used in trade and because the trade marks are merely filed strategically (but not used) to preclude others from entering the market. As noted earlier, this is another practice that a proprietor with vast resources, at least in the context of the African market, would be able to employ. Any AfCFTA strategy aimed at establishing a credible network of registries or a unified continental registry would have to confront the dominance of foreign firms, the congestion caused by unused marks, and the tactics employed to maintain those unused marks. Prior to the proposal that necessitated this contribution, an outline of the common strategies employed in other territories may be instructive.

4. Decluttering Strategies

As the author discussed earlier, trade mark registry clutter refers to the excessive number of trade marks registered but not used in trade, which hampers market entry, increases search costs, and weakens the informational objective of marks. Evergreening, on the other hand, denotes procedural tactics employed to perpetually renew trade marks, often without a genuine intention to use, creating artificial barriers to entry. In Africa, foreign applicants, often non-resident multinationals, dominate trade mark filings without corresponding economic activity or brand use. These phenomena contribute to economic inefficiencies, obstruct trade between AfCFTA members, and call for substantive and procedural reforms.

A good place to start when dealing with a common market with multiple semi-distinct territories would be the United States and the European Union, locales that have both had to deal with the issue of clutter. Under the US Lenham Act,[50] an application must be based on actual use or intent to use, with post-registration proof of use required.[51] While no intent to use is required at registration with the European Intellectual Property Office ('EUIPO'), a mark becomes vulnerable to cancellation if not used within five years. The EU also provide for the revocation of a trade mark.[52] On the African continent, OAPI member states require use in one of the member states for an uninterrupted period of five years prior to the request for revocation by a third party due to non-use.[53] What is common between all these measures, as in most countries, is that the procedure for the removal of an unused mark requires an interested

50 Lanham (Trademark) Act of 1946, 15 USC §§ 1051–1141n (USA).
51 Lanham (Trademark) Act (n50) §1(a) and §1(b).
52 EUTMR, art 58.
53 Agreement Relating to the Creation of an African Intellectual Property Organization (Bangui Agreement), signed 2 March 1977, revised 24 February 1999 and 14 December 2015 (entry into force 14 November 2020), OAPI.

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third party to initiate a revocation action. It is submitted that pervasive issues identified above may require a more active approach on the part of the registries on the continent.

4.1 Automatic and semi-automatic expungement

Among the more impactful post-registration strategies, the US requires a declaration with accompanying specimens evidencing use between the fifth and sixth years post-registration to maintain the registration. In the context of African states, this might be far too cumbersome and, as discussed in the introduction of this contribution, likely too costly a strategy. On the other hand, among OAPI member states, a mandatory Declaration of Use must be filed in the third year of registration to avoid cancellation of the trade mark.[54] If it is not filed, the trade mark becomes vulnerable to cancellation for non-use. While the trade mark isn't automatically cancelled, it can be cancelled upon a request from an interested third party.

Somewhere between the passive post-registration cancellation of the US is the near-passive system within Canadian law, where any third party may request the Registrar to issue a notice requiring proof of use.[55] The Registrar then issues the notice *ex officio* without evaluating merits, following which the registrant must prove use (or valid reasons for non-use) within three months. In this procedure, the failure of the registrant to respond leads to automatic expungement.

4.2 *Sua sponte* actions

There are additional powerful but rarely used post-registration procedural tools in the US, introduced through the Trademark Modernization Act[56] ('TMA') in the form of re-examinations, audits,[57]and *sua sponte* actions.[58] Focusing on the latter, *sua sponte* actions refer to a trade mark registry's proactive authority to cancel or amend registrations without third-party actions. As a cornerstone of the TMA's effectiveness, it is the explicit empowerment of the director of the USPTO to initiate both expungement and re-examination proceedings *sua sponte*. Instead of solely waiting for an aggrieved third party to file a costly and time-consuming cancellation action, the USPTO can now proactively identify and address questionable registrations. This sort of proactive administrative enforcement has the potential to yield significant results should it be coupled with other self-executing measures that neither raise the administrative burden, add to the complexity of the process, nor the cost of decluttering the registry.

54 Article 23 of the Bangui Agreement, Annex III. The treaty itself does not explicitly state this requirement. The Règlement d'application (implementing rules) and the most recent administrative instructions and the OAPI published forms for trademarks infer this requirement.
55 Trademarks Act, RSC 1985, c T-13 (Can). See: s 45.
56 Trademark Modernization Act of 2020, Pub L No 116-260, 134 Stat 1182 (2020) (USA).
57 Ibid.
58 Trademark Modernization Act (n56) 15 U.S.C. § 1066a(c)(1).

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4.3 Proactive and passive expungement

In calibrating a sustainable, scalable, and contextually responsive solution to the registry clutter problem outlined above, the author proposes a two-tiered mechanism that fuses mandatory declarations with automatic expungement to dismantle registry clutter while accommodating administrative constraints.

The proposed model consists of: (a) a mandatory 'Declaration of Use' or 'Declaration of Excusable Non-Use' to be submitted three years post-registration; and (b) a default expungement mechanism targeting non-compliant registrations in specific high-clutter classes such as Classes 3, 9, 25 and 35. This process requires only:

1. A standardised online declaration confirming whether the mark is in use or explaining excusable non-use. The process would be non-evidentiary by default but also allow for optional submission of specimens;
2. A grace period of six to twelve months would be available to cure non-compliance;
3. Critically, failure to file triggers default expungement for marks in designated high-clutter classes (initially Classes 3, 9, 25, 35), identified through empirical criteria determined by the specific registry but ideally mirroring the registry dominance patterns exposed in paras 3.1–3.3.

This hybrid approach, proactive yet administratively lean, eliminates costly third-party litigation burdens (noted in paras 4.1), disrupts evergreening cycles (identified in para 3.3), and aligns with AfCFTA's imperative to purge artificial trade barriers (discussed in para 1). By shifting from reactive cancellation to self-executing removal, it aims to balance rigour with feasibility for resource-constrained registries.

5. Conclusion

Africa's trade mark regimes are at a pivotal moment. As the continent accelerates towards economic integration under the AfCFTA, the infrastructure of intangible assets must evolve from permissive and externally skewed to purposive, endogenous, and enabling. The proliferation of unused trade marks, particularly those held by non-African entities, functions as a non-tariff barrier undermining the AfCFTA's foundational goal of intra-continental economic integration.

Current revocation mechanisms, reliant on adversarial proceedings or discretionary registrar actions, fail to address these structural impediments, perpetuating a system where registry hygiene depends on the resources of challengers rather than the legitimacy of rights holders. Registry clutter, as argued throughout this article, is not merely a bureaucratic inconvenience but a structural barrier to competition, innovation, and the equitable participation of African firms in intra-continental trade.

The proposed framework offers, in the hopes of the author, a legally viable and administratively sustainable corrective. By compressing the use-proving timeline, it deters speculative filings while capturing warehoused marks before

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they metastasise into permanent clutter. The class-based targeting mechanism focuses enforcement where foreign dominance is most acute. In doing so, it guards against overreach while restoring the informational function of trade mark protection for realising the goals of Agenda 2063 and supporting African enterprises in transitioning from consumption-based to production-based value creation.

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