

Towards Harmonizing Ethiopia's Trademark Protection Regime with TRIPS Standards: Bridging the Rift

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Abstract

The protection of trademarks is necessitated to safeguard the interests of businesspersons and consumers thereby contributing to the country's overall economic growth and development. This, in turn, calls for a strong trademarks system capable of adjusting itself with the dynamic interests of all stakeholders. Ethiopia has adopted relatively comprehensive trademark protection legislations in 2006. The country is also negotiating for the accession to the World Trade Organization (WTO) since 2003 and this requires compliance with the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, among others. Accordingly, this article assesses the compatibility of the Ethiopian system of trademark protection with the TRIPS standard of protection and finds that there exists certain degree of inconsistency between the two legal regimes. It acknowledges Ethiopia's move to harmonize its trademark protection standards with the TRIPS requirements but concludes that a lot remains to be done to strike the balance between the country's regulatory interests and the WTO regime.

Keywords: Ethiopia, Trademark Protection, Trademark Proclamation, Trade Related Aspects of Intellectual Property Rights, World Trade Organization

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I. INTRODUCTION

A trademark is one of the forms of intellectual property rights represented by a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Apart from indicating the origin of goods and services, it serves as a marketing tool because it gives rise to a desire for product or service as consumers attach a particular quality to a trademark. The protection of trademarks traces back to the old days of 1880s when the Paris Convention on the Protection of Industrial Property (PC) was adopted.¹ The adoption of the TRIPS Agreement at the end of the Uruguay round of trade negotiations marked a new era for the protection of trademarks.² In Ethiopia, trademark issue has been under technical regulations starting from the 1960s though it was not until 2006 that Ethiopia enacted independent legislations which regulate the trademark regime.³ The trademark legislations deal with the subject matters of protection, excluded subject matters, requirements for protection, the limitations and others.

The need to make a comparative study between TRIPS Agreement and the Ethiopian trademark regime primarily arises from the need to supplement the ongoing Ethiopia's accession to the WTO⁴. TRIPS require member states to the WTO to comply with its own provisions and that of the PC. A reference to the PC is also justified because its material provisions are incorporated in the TRIPS.⁵ In addition, the comparison also helps to understand the Ethiopian trademark system in light of internationally accepted rules of trademark protection.

Against this backdrop, this paper aims at analyzing the Ethiopian trademarks regime in light of TRIPS and other international intellectual property instruments. It examines the extent of compatibility between the two legal regimes and recommends important adjustments in case of non-compliance. The paper is organized into seven sections. Section two briefly presents the historical development of the international and domestic trademark legal regime. Section three discusses subject matters protected the requirements for protection under the Ethiopian trademark system in light of the TRIPS Agreement. Section four focuses on the rights conferred and limitations imposed by the trademark regime while section five addresses special cases of protection for collective and well-known trademarks. The last two sections are devoted to remedies for infringement of trademark rights and conclusion, respectively.

¹ Paris Convention for the Protection of Industrial Property, signed on 20th March 1883 and entered into force as from 7th July 1884, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979.

² Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments-Results of the Uruguay Round, vol. 31, 1994, International Legal Materials.

³ The Federal Negarit Gazette, Proclamation No. 501/2006. Trademark Registration and Protection Proclamation. 12th Year No. 37, Addis Ababa, 7th July 2006; The Federal Negarit Gazette, Trademark Registration and Protection Council of Ministers Regulation No. 273/2012. 19th Year No. 10, Addis Ababa, 24th December 2012.

⁴ It has to be noted that Ethiopia has applied to accede to the WTO in 2003 and the negotiation process is underway.

⁵ TRIPS Agreement, *supra* note 2, Art 2.1.

II. HISTORICAL DEVELOPMENT OF TRADEMARK LAW

Human beings use symbols to speed up thinking and communications. As a result, the law attaches symbols and words exclusively to commodities or services of producers. In fact, attaching symbols and words to commodities is not a recent phenomenon. In ancient and medieval period, people were using symbols to identify their products from the products of others.¹ In the early Minoan, Egyptian, Mesopotamian, Etruscan and Chinese civilizations people were using trademark to mark slaves, animals and goods.² The practice of modern trademark comes into existence particularly since the industrial revolution as an indication of origin of the products. Through time, the protection of trademark as intellectual property has been recognized in different jurisdictions. Furthermore, trademark has become the subject of international negotiations and treaties. It has been negotiated under the PC in 1967 and finally under TRIPS agreement in 1995. The TRIPS Agreement has put cornerstone in the global development of protection of intellectual property law in general and trademark in particular.

The 1957 Penal Code³, the 1960 Commercial Code⁴ and the 1965 Civil Procedure Code⁵ have regulated the protection of trademark technically. The Commercial Code and the Penal Code have regulated trademark issues under the guise of unfair competition. Under these codes, one cannot enjoy trademark protection as of rights, but one can claim compensation extra contractually if the use of a certain mark leads in to creating unfair competition. However, the owner of a certain mark had not exercise exclusive rights over certain trademark by having registered the mark.

The Constitutional recognition of intellectual property rights may be taken as further development of trademark in the country's history.⁶ Currently, under the Trademark Proclamation, the owner of a certain mark or sign which has capacity to distinguish her products from products of others can apply to the Ethiopian Intellectual Property Office (EIPO) for protection of the mark/sign. Accordingly, under the new law, trademark is treated and protected not as tort issue but as constituting independent rights. With this trademark legal regime, Ethiopia is on the way to accede to the WTO multilateral trade negotiations. Commenced in 2003, the accession to WTO requires Ethiopia to bring her laws into TRIPS consistence. Hence, the ongoing WTO accession negotiation may require the country to make changes to the existing trademark rules either for the interest of other WTO members or to enable the country exploit the existing flexibilities.

III. THE SUBJECT MATTERS PROTECTED AND THE REQUIREMENTS FOR PROTECTION

A. Subject Matters Protected

There is no consensus among legal instruments concerning subject matters protected under the trademarks regime. The subject matters that are eligible for protection in some jurisdictions may not be eligible for protection in other jurisdictions. In this subsection, the author discusses the protected subject matters briefly.

i. *The notion of 'Any Sign'*

Reference to various international and national legal instruments as well as the jurisprudence of states on protected subject matters indicates that opinions are divided in to two. For the proponents of the first line of argument, a mark is to be protected as a trademark provided that two requirements are satisfied cumulatively.⁷ First, there has to be a 'sign' that the applicant wants to register as a trademark. Other than stipulating a sign as a pre-requisite for registration, no jurisprudence is clear enough in defining what is meant by the term. Be the definition as it may, signs can have two forms. These are visible and non-visible signs. The former category constitutes those having the capability of graphic representation, to which references are explicitly made under various intellectual property laws. On the other hand, there are signs which are invisible like sounds and smells. A point to be noted is that, in both cases, the issue of having distinctive feature would not be at issue. In other words, distinctiveness exists irrespective of visibility. Accordingly, invisible signs are equally distinctive. Second, that sign has to be capable of distinguishing the products or services of one undertaking from that of another undertaking with respect to similar goods or services.

The second group, on the other hand, gives a due emphasis to the visibility aspect of a sign. For a sign to qualify for the purpose of trademark in the proper sense, they argue, it being visible is a matter of no alternative.

¹ Graham Dutfield and Uma Suthersanen, 2008, *Global Intellectual Property Law*, Edward Elgar Publishing, Inc, Massachusetts 01060, USA pp.135, see also Joanna Schmidt-Szalewski, *The International Protection of Trademarks After The TRIPS Agreement*, *Duke Journal of Comparative & International Law* Vol.9; 189-190.

² *Id.*

³ Penal Code of The Empire of Ethiopia, Proclamation No.158/1957, Art 674.

⁴ Commercial Code of the Empire of Ethiopia, Proc .No 166 of 1960, Art 132-134, Art 147, Art 148.

⁵ Civil Procedure Code of The Empire of Ethiopia of 1965, *Negarit Gazeta*-Extraordinary Issue No.3 of 1965 Addis Ababa, Decree No.52/1965, Art 15(2) d. It gives the jurisdiction to deal with trademark issue for the then High Court.

⁶The Constitution of Federal Democratic republic of Ethiopia, Proclamation No.1/1995, *Federal Negarit Gazeta*, 1st year no.1, Addis Ababa 21st August 1995, Art 40(2), (hereinafter FDRE Constitution).

⁷ TRIPS Agreement, *supra* note 2. TRIPS seems to support this line of argument when it prescribes protectable subject matter as 'any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings' under its Art 15(1).

In this regard, only visible sign is believed to serve the primary purpose of trademark- to distinguish a good or service of a competitor from that of another in similar circumstances. The Ethiopian trademark system follows this second routine. Concerning the subject matters protected by the Trademarks legal regime, the Ethiopian trademark proclamation tries to draw a line between matters protected and matters not protected. In its attempt to define ‘trademark,’¹ it lists objects that can be used as trademarks and, hence, protectable with a particular focus on the visibility of the sign in question. The sign can be words, designs, letters, numerals, colors or the shape of goods or their packaging the combinations irrespective of the types and nature of goods and services.² This shows that the sign must be capable of being represented by graphical representations.

TRIPS, on its part, provide lists of subject matters which it urges states to protect. It, in particular, mentions words including personal names, letters, numerals, figurative elements and combination of colors and of signs.³ However, graphical representations are not mandatory requirement under TRIPS agreement.⁴ The TRIPS Agreement trademark protection includes any mere sensory marks that are perceptible for human senses. Personal name is example of signs eligible for protection of trademark under TRIPS agreement while not under Ethiopian law. In relation to this the Ethiopian law has specifically excluded surname of the applicant and name of an alive person for trademark protection while TRIPS did not. Another point to be noted here is that the use of such terms as ‘in particular’ and ‘including’⁵ indicate the illustrative nature of the provision. This, in turn, gives Member States a wide room for flexibility to frame their trademark laws in a manner that accommodates the contextual realities of their economy. By the same token, the Ethiopian Trademark law also provides for protectable subject matters in a non-exhaustive manner.

ii. Sounds and Smells: protected?

As illustrated above, visibility is not a prerequisite under TRIPS whereas it is the case for the Ethiopian trademark system. Such a dichotomy on its face may seem unimportant. Its importance, however, outshines with the advent of the need on the part of business persons to register invisible signs as a trademark. At the heart of this claim are such signs as sounds and smells. The recognition or otherwise of such signs continues to call for hot debates among different states.

Some scholars argue that trademark protection under TRIPS is not only limited to visual signs but also extend to sensory marks which are perceptible to human senses such as olfactory and aural signs.⁶ In their opinion, therefore, sounds and smells deserve protection under trademark laws. Their position is justifiable for two reasons. First, the list of protectable subject matters under TRIPS regime is only indicative, paving ways for member States to determine the forms of signs to protect at their discretion. Second, there is no such requirement as ‘visibility’ to grant protection under TRIPS.

When it comes to Ethiopia, sounds and smells are not protected under the trademark regime. This is true for two reasons-one, explicit and the other, implicit. They are explicitly excluded from the ambit of protectable subject matters under the Trademark Proclamation.⁷ Tacit exclusion of sounds and smells can also be inferred from Art 2(12) of the Trademark Proclamation which lays down the requirement of ‘visibility’ for signs to be registered as trademark. Needless to mention, sounds and smells are invisible and, hence, could have been understood as if they are excluded from the outset. This takes us to the conclusion that the explicit exclusion under Art 6(1) (b) is the result of a poor draftsmanship and adds no value than redundancy.

Be that as it may, some scholars⁸ ask whether the need to exclude invisible signs like sounds and smells is justifiable by practical considerations like the need for a workable register and the need for the publication of the marks. The question appears to stem from the suspicion that such invisible signs could not be validly registered and publicized. In this regard, it is argued that the graphic representation of sound marks must be made either by musical notation (with stave, clef, notes and rests), or by a sonogram with a time scale and a frequency scale.⁹ In fact, literatures indicate that registration has been made for the smell of fresh cut grass for tennis balls as well as for a melody.¹⁰ Even assuming, but not admitting, that invisible signs cannot be registered and publicized, the question that still remains unanswered is whether these grounds, of themselves, are sufficient to deny protection

¹ Pursuant to Art 2(12) of the Trademark Proclamation no. 501/2006, a ‘trademark’ is defined as any visible sign capable of distinguishing goods or services of one person from those of other persons including words, designs, letters, numerals, colors or the shapes of goods or their packaging or the combinations thereof.

² *Id.*

³ TRIPS Agreement, *supra* note 2. Art 15, second sentence.

⁴ *Id.* Art 15 par 1.

⁵ Fikremarkos M., *The Ethiopian Law of Intellectual Property Rights: Copyright, Trademarks, Patents, Utility Models and Industrial Designs*, School of Law, Addis Ababa University, September 2012, p. 161.

⁶ Dutfield and Suthersanen, *supra* note 6, at 141.

⁷ Art 6(1) (b) of the Trademark Proclamation no 501/2006 stresses that a trademark which consists of a sound or smell is inadmissible for registration. And it should be noted that a trademark is protectable in Ethiopia only upon registration.

⁸ Fikremarkos, *supra* note 17, at 162

⁹ Dutfield and Suthersanen, *supra* note 6, at 141.

¹⁰ Fikremarkos, *supra* note 17, at 162; Dutfield and Suthersanen also illustrate that the sound of the roar of the lion for MGM in United States, the advertising jingles, and the smell of a fabric conditioner or washing powder are protected trademarks.

to the marks. If not narrowly interpreted, such denial would interfere with the legitimate claim of businesspersons to acquire marks of their choice as the capability of the mark to distinguish the goods or services of one undertaking from that of another would suffice to grant protection.

The question that comes to one's mind at this juncture is whether Ethiopia's approach to the understanding on 'protectable subject matter' is in violation of TRIPS standards. TRIPS have no mandatory provisions on what type of forms signs have to acquire to be protected in Member States. Instead, it is up to the states to set conditions that must be satisfied in this regard.¹ States are at their discretion to or not to require the visibility of the signs to make registration. Accordingly, Ethiopia's situation does not constitute the violation of TRIPS. This, however, doesn't mean that the denial has no negative impacts. Rather, it would have a tremendous effect in hampering the cross-border business dealing of the country as it discourages businesspersons from jurisdictions where invisible signs are protected.

iii. Shape of goods and their packaging

Sometimes it may be such that a product or packaging attributes serve as a trade dress, i.e. they function to identify the origin of goods or services. The definitional provision of the Trademark Proclamation² provides that the shape of goods or their packaging could be registered as trademarks. This, however, is not without qualifications.

Two requirements must be satisfied for the shape of goods or their packaging to be considered as protectable subject matters.³ First, any such mark should satisfy all the requirements of trademark protection. Under this requirement may fall the capability of the mark to distinguish the goods or services. In addition, it should not fall under those marks that are inadmissible to serve as trademarks. Second, any likelihood of the mark to distort competition has to be ruled out. This outlaws, in particular, the functional features of goods or services from the ambit of trademarks. This, in turn, benefits consumers since the possibility of imitation of the functional attributes paves way to acquire products at lesser price.

iv. Is a single color protected?

It is true that trademark laws generally recognize colors as valid trademarks. The problem is when it comes to whether a single color could constitute a trademark. This issue is explicitly addressed nowhere under intellectual property instruments including TRIPS. The laws are no clearer than saying colors as trademarks are protectable. TRIPS provide that '*combination of colors*' can be recognized as signs capable of serving as trademarks.⁴ At a first glance, one may argue that a single color is not protectable under TRIPS because the phrase 'combination of colors' presupposes the existence of at least two colors. On the other hand, one could also say that two or more colors can be mixed together in a way that it is difficult to differentiate each constituent colors thereby forming a single color.

In Ethiopian context, Art 2(12) of the Trademark Proclamation states that '*colors*' or '*combinations of colors*' can serve as trademark. Art 5(2) of the same Proclamation in its attempt to address the manner in which color marks are to be registered is also of no help.⁵ Thus, both provisions are not clear enough in answering the aforementioned question. Single colors *per se* without any unusual or fanciful features would be devoid of any distinctive character, since they are considered to be in the public domain and form part of the store of signs available to all traders. Even if there are reasons⁶ why a single color should not be independently sufficient to be a trademark, there are some jurisdictions⁷ standing at the other end of this extreme position.

B. Requirements for the Protection of Trademarks

Needless to mention, not all marks are protected by trademark laws. For a mark to be protected as a trademark, certain requirements need to be met. These are substantive preconditions related to whether the mark in question satisfies validity requirement in itself. The mere fact that a mark is capable of being recognized as a trademark, of itself, does not entitle the owner to invoke protection.⁸ In this subsection, a brief discussion of these requirements is in order.

i. Graphic Representation

Some jurisdictions provide protection only to visible signs. As briefly mentioned earlier, the Ethiopian trademark

¹ The last sentence of Art 15(1) provides that 'Members may require, as a condition of registration, that signs be visually perceptible.'

² Trademark Proclamation, *supra* note 3, Art 2(12).

³ Fikremarkos, *supra* note 17, at 163.

⁴ TRIPS Agreement, *supra* note 2, Art 15, second sentence.

⁵ This provision states that a trademark may be registered in black-and-white or color. It goes on saying that a trademark registered in black-and-white is to be protected in all color combinations whereas one registered in color is to be protected in the color combination in which it is registered.

⁶ Fikremarkos provides three justifications for this. First, a single color may be descriptive instead of being distinctive. Second, colors by their nature tend not to be distinguishable. Third, colors should not be monopolized since they are limited in number.

⁷ The U.S has become a typical example. See the decision of the Supreme court in *Qualitex Co. Vs Jacobson Products Co., Inc.* 514 U.S. 159 (1995)

⁸ Fikremarkos, *supra* note 17, at 176.

system recognizes that only visible signs are protected as trademarks.¹ This requires a sign to be capable of being represented graphically. Furthermore, the law requires an applicant for trademark registration to submit a reproduction of the applied trademark in three copies.² There is no consensus among legal systems as to at what point in time a sign is said to have been represented graphically. Particularly, the situation exacerbates when it comes to the representation of invisible signs like sounds and smells. With respect to countries like Ethiopia, this issue seems to have been addressed at least to some extent as sounds and smells are explicitly excluded from the ambit of trademarks. In other systems, however, an explanation of the sound or the smell in words suffices to meet this requirement.³

There is no such thing as graphic representation under TRIPS. Article 15.1 defines which signs or combinations of signs are capable of constituting a trademark. A close reading of its Art 15(1), sentence four indicates that Member States are at liberty to or not to set it as a precondition for protection. Hence, a point to be made is that Ethiopia is not in violation TRIPS for demanding graphic representation to grant protection.

ii. Distinctiveness

Under the Trademark Proclamation, a mark is eligible for registration, and hence for protection, when it is established to be distinctive.⁴ By this, it is to mean that the sign must be capable of distinguishing the goods/services of one undertaking from that of another. In other words, eligibility of a trademark for registration is tied to its distinguishing function. Art 5(3) of the Proclamation tempts to show the firm stands of the Ethiopian trademark system not to tolerate any element or character of a sign which blurs the distinctiveness of a trademark. On its face, it permits the inclusion of elements which, in themselves, are not protectable. However, it explicitly provides that such inclusion of unprotected elements in a trademark is as long as their incorporation does not affect the distinctive character of the mark.

The Proclamation goes on saying that a mark which is incapable of distinguishing the goods or services of a person from that of another is inadmissible for registration.⁵ By doing so, it reiterates what is already mentioned under its Art 5(1). This requirement is expressly provided in the first sentence of Art 15 of TRIPS. In a more abstract manner, TRIPS makes it possible that distinctiveness be acquired through use.⁶ If such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, then they become *eligible for registration as trademarks*.⁷ In the *European Communities vs. United States*, the WTO Appellate Body stated that the title of Article 15.1 – "Protectable Subject Matter" – indicates that Article 15.1 embodies a *definition* of what can constitute a trademark.⁸ It added that WTO Members are obliged under Article 15.1 to ensure that those signs or combinations of signs that meet the distinctiveness criteria set forth in Article 15.1 – and are, thus, *capable of constituting a trademark* – are *eligible for registration as trademarks* within their domestic legislation.⁹ Accordingly, the title of Article 15 expresses the notion that the subject matter covered by the provision is subject matter that *qualifies* for, but is not necessarily *entitled to*, protection.

The Trademark Proclamation recognizes distinctiveness by use provided that such use has become well known in Ethiopia.¹⁰ This provision is workable only with respect to three categories of marks which are declared ineligible otherwise. These are matters falling under Art 6(1) (e), (f) and (j) of the Proclamation. Other than these three scenarios, distinctiveness by use is not permitted in Ethiopia. First, descriptive marks referred to under Art 6(1) (e) indicating the kind, quality, quantity, intended purpose etc or other characteristics of goods or services have the potential to become distinctive with the lapse upon usage. Second, marks which have become

¹ Trademark Proclamation, *supra* note 3, Art 2(12).

² *Id.* Art 8(3) (a). It is only where graphic representation of the mark is possible that it becomes possible to reproduce it. For instance, the applicant for an invisible sign, say smell, cannot reproduce and submit it.

³ Dutfield and Suthersanen, *supra* note 6, at 141. The EU is a typical example in this regard.

⁴ Trademark Proclamation, *supra* note 3, Art 5(1).

⁵ *Id.* Art 6 (1) (c)

⁶ TRIPS Agreement, *supra* note 2, Art 15, third sentence. The provisions read "Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application." Accordingly, even if it is impossible for the owner of the trademark to establish distinctiveness in accordance with the first two sentences of Art 15 TRIPS, the association by consumers of the mark with certain type of goods may enable the applicant to support her claim.

⁷ According to Article 15.1, in respect of signs not inherently capable of distinguishing goods or services, registrability may be made dependent on distinctiveness acquired through use. In addition, Members may require, as a condition for registration, that signs be visually perceptible.

⁸ *European Communities Vs. United States*, Report of the Appellate Body, WT/DS176/AB/R, 2 January 2002, para. 154. The European Communities and the United States appeal from issues of law and legal interpretations in the Panel Report, *United States – Section 211 Omnibus Appropriations Act of 1998*. The European Communities alleged that Section 211 is inconsistent with the obligations of the United States under Arts. 3.1, 4, 15.1, 16.1 and 42 of the *TRIPS Agreement*, as well as Art. 2.1 of the TRIPS Agreement in conjunction with Articles 2(1), 6bis (1), 6quinquies A(1) and 8 of the *Paris Convention for the Protection of Industrial Property*, as amended by the Stockholm Act of 1967.

⁹ *Id.*

¹⁰ Trademark Proclamation, *supra* note 3, Art 6(2).

customary in current language or in day-to-day economic and business activities may turn to be distinctive when they become well known in the country. Third, the exclusive usage of the applicant's surname is also permitted upon usage. The problem with both the Trademark Proclamation and TRIPS is that they have not addressed the issue of for how long a mark should be used to be distinctive upon use (or to be well known in the language of the Trademark Proclamation. In this regard, the U.S trademark law requires an exclusive and continuous use for a minimum of five years.¹ In *European Communities Vs. United States*, the United States asserted before the Panel that trademark ownership is generally established through use and thus the owner of a trademark is generally the party who controls the nature and quality of the goods sold or services rendered under the trademark.²

It is obvious that trademark seeks to enable consumers identify one product or service and so that they could spend on what pleases them. This is why distinctiveness is said to be at the heart of a trademark. A point to be made here is that a mark should not allude to describing the qualitative characteristics of a good/service. A mark is either inherently distinctive or become distinctive over time even if was not distinctive at the beginning.³ He identifies three types of marks which are inherently distinctive. The first type constitutes words having no prior existence. This category has no or very minimum potential to harm competitors since they are creations of the owner. He called such marks 'fanciful marks'. The second type, named arbitrary marks, is constructed of ordinary words having no close connection with the product or service they represent. Third, there are suggestive marks having no direct connection with what they represent. It should be noted, here, that suggestive marks are different from descriptive marks, which are not protectable under trademarks regime.

iii. Application, Examination and Registration

Application for protection of trademark has to be made in accordance with the requirements provided by the law.⁴ Hence, application for trademark has special form provided by the law. One application has to be made for the protection of one trademark. The applicant has to effect the payment of application fee for each application as provided by trademark regulation. The content of application should include the lists of goods and services for which application is made, the power of attorney where application is made through representation, and documents that show the payment of application fees *per se*. The application for registration and protection of collective trademark has to clearly show that the application is for protection of collective trademark.⁵ It should be accompanied by a copy of statutes governing the use of the trademark.

The examination of application is conducted by Ethiopian Intellectual property Law Office. The office has duty to make examination as to whether the application has satisfied the requirements under trademark proclamation and regulation. The proclamation requires fulfillment of two types requirements; the form and substantive requirements.⁶ The former requires checking whether the application has satisfied the formality requirements provided by the proclamation and regulation or not. On the other hand, the later requires checking whether the application satisfies the substantive requirements provided by the law. This includes checking as to whether the marks are eligible for protection or not under the proclamation and regulation.⁷ After conducting examination, if the application is found acceptable, the office shall publish notice for invitation for opposition.⁸ However, if application is found unacceptable, the office shall reject and inform applicant the reason for rejection in writing.⁹ Finally, after proving the satisfaction of all substantive and procedural requirements and checking the inexistence of opposition to application or the rejection of opposition to application, the office shall register trademark and issue certification upon payment of the prescribed fee.

TRIPS Agreement has permitted member States to freely arrange the application, registration and cancellation proceedings taking in to account the stated general principles.¹⁰ Looking at the trademark proclamation in light of TRIPS shows that the proclamation is TRIPS consistent in providing the application, examination and registration requirements.

iv. Publication Requirements

The publication of trademark is the jurisprudential requirement for the protection of trademark protection in most jurisdictions in very similar ways. It can be said that the life of trademark is highly related with the requirement of publication. It is required from application for trademark registration to its invalidation or renunciation.¹¹ The EIPO has to make a number of publications through Intellectual Property Office *Gazette* or in the newspapers

¹ Section 15 of the U.S. Trademark Act (Lanham Act) (1946).

² *European Communities Vs. United States*, Report of the Panel, **WT/DS176/R**, 6 August 2001, para. 8.63.

³ *Fikremarkos*, *supra* note 17, at 179.

⁴ Trademark Proclamation, *supra* note 3, Art 8.

⁵ *Id.* Art 18(1).

⁶ *Id.* Art 5,6, & Arts 8-24.

⁷ *Id.* Art 8.

⁸ *Id.* Art 12.

⁹ *Id.* Art 13(3,4)

¹⁰ TRIPS Agreement, *supra* note 2, Art 16(1) & 41.

¹¹ Trademark Proclamation, *supra* note 3, Art 12.

which have national circulation, with discretion to support by Television or Radio broadcasting. The proclamation requires the publication of the notice of objections. At the application stage, the publication is required to allow interested persons to bring their objection to the registration of trademark. The next is that the registration of trademark has to be published to notify the public the registration and protection of the trademark.¹ Similarly, the office is required to make publication on the transfer, licensing, invalidation and renunciation of trademark rights and amendments or renewals to the trademarks.² Further, the office may require the publication of amendment of statutes in case of collective trademarks.³

Regarding publications, the TRIPS agreement obliges members to publish each trademark either before it is registered or promptly after it is registered and to afford a reasonable opportunity for petitions to cancel the registration.⁴ TRIPS have no mandatory provision on the stage of publications. It requires member states to give chances to petitioners to oppose registration by causing publications either before registration or after registration. The trademark proclamation has provided publication both before and after the registration. Moreover, it has provided publication in relation to transfer, licensing, invalidation, renunciation etc. In this regard, the trademark proclamation is appears to be TRIPS plus.

v. Use Requirement

The use or non-use issue is another point that should be raised in relation to the subject matters protected under trademark law. The use model is based on the objective facts of trademark use, and decides the ownership of a trademark according to the time that the trademark was first used.⁵ In Ethiopia, trademark must be used or proposed to be used in relation to goods and services so as to get legal protection.⁶ In this regard, the approach followed by the Ethiopian trademark proclamation is similar to that of the TRIPS Agreement. The TRIPS allows member states to subject protection of trademark to use requirement. The member states may require the use of a trademark within specified period along with the maintenance of registration and the enforcement of the rights against third party.⁷ TRIPS Agreement requires the member states to grant the period of at least three years in providing an obligation to use. This duty is expected to be effective either before, during or after registration up to three years. If the owner didn't use the mark for three years after registration without legitimate reason, the trademark would be cancelled upon application of any interested person. However, it prohibits member states from requiring the actual use as a pre condition for registration of trademark. That means application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application. In both the TRIPS agreement and trademark proclamation use requirement cannot be ground for rejecting application for trademark protection.

The other point that begs consideration in relation to use requirement is when do we say the owner has used the trademark? The mark can be used either by the trademark owner or the licensee. It is not mandatory for the trademark owner to use the mark personally. What matters is that the mark has to be used in the economy. The use of trademark by another person authorized by, and under the control of, the trademark owner is considered as a valid use. Further, the use of a trademark in the form differing in elements which do not alter its distinctive character in which it was registered shall not be a ground for cancellation of trademark.⁸

vi. Automatic Ineligibility

The Trademark Proclamation also provides those marks which are automatically excluded from the ambit of the trademark regime.⁹ In this regard, the proclamation seems comprehensive by attempting to draw a line between eligible and ineligible marks. One of the exclusions made under this provision is the protection of trademarks consisting of sound or smell. As pointed out earlier, the alleged justification behind the ineligibility, here, is that both sounds and smells do not satisfy the requirement of graphic representation.

A trademark in contravention with public order or morality is also inadmissible for registration.¹⁰ Due to the subjectivity element in the determination of whether a trademark contravenes a public order or morality, this provision leaves a wide room open for the discretion of the registry officers. As such, unless the blessing of the officers is secured, the arbitrary denial of registration may occur. Art 6(1) (e) of the Proclamation excludes the so called descriptive or indicative trademarks.¹¹ For instance, a trademark which asserts the quality or purpose of

¹ *Id.* Art 16.

² *Id.* Arts 29(2), 34(3), 37(1), 25(4).

³ *Id.* Art 22(2).

⁴ TRIPS Agreement, *supra* note 2, Art 15(5).

⁵ Tilahun Esmael Kassahun, Protection of Well-Known Trademarks in Ethiopia: A Comparative Treatise under the Trademark Proclamation, Haramaya Law Review, Vol. 1, No. 2, Winter 2013, 89-136, 95.

⁶ Trademark Proclamation, *supra* note 3, Arts 5,6, 7 and 35.

⁷ TRIPS Agreement, *supra* note 2, Art 19(1).

⁸ Trademark Proclamation, *supra* note 3, Art 35(5).

⁹ *Id.* Art 6(1). A close reading of the two versions of the provision indicates that they deliver different message. The English version of the text is only permissive when it says 'the following trademarks *may* not be admissible for registration'. The Amharic version, however, tends to make it obligatory by saying an equivalent of '...*shall* not be registered'.

¹⁰ *Id.* Art 6 (1) (d).

¹¹ The full provision states "a trademark consisting exclusively of signs or indications which designate the kind, quality, quantity, intended

the concerned goods or services will automatically be discarded. By the same token, one cannot rely on the geographical origin of the goods or services she wants to protect. At this point, one may question why the law denies protection to this kind of trademarks. The answer is simple. If businesspersons are permitted to use such indicative marks, the monopolistic nature of the right will exclude others from competition thereby impairing consumers' choices. This, in turn, would defeat the very purpose of trademarks protection.

Sometimes, it may be such that certain signs or indications had once constituted a trademark, or even had never served as such for that matter, but at the time of application for protection, have become customary in a 'current language' or in 'day to day economic and business activities'. Such signs or indications are clearly outlawed under the proclamation.¹ This provision calls for interpretation as 'current language' and 'day to day economic and business activities' are not clear in themselves. Accordingly, no one can exercise a monopoly right over them. Furthermore, a trademark consisting exclusively of a shape which results from the nature of the good itself or that is necessary to obtain a technical result of the good or that gives substantial value to the good is ineligible for registration.

A trademark should not cause an act of misleading a public in whatever aspect. In particular, any form of confusion related to the geographical origin, the nature or characteristics of the goods or services they intend to represent would render the mark ineligible. Obviously, this aims at the protection of consumers from deceptive practices. What is more, the use of a trademark which is identical to or imitative of one used by States or intergovernmental organizations offices or, which is substantially concerned with signs or indications inherent to them is prohibited. This is to avoid acts which offend governments or intergovernmental organizations by allowing use of flags or other indications peculiar for an inappropriate use that could ridicule the country or the organization. PC obliges members to protect the notified signs of other Member States and international intergovernmental organizations.² A point to be made here, however, is that the use of the aforementioned signs and indications is permissible with the authorization of competent authorities. The issue of who a competent authority in each scenario is to be determined on a case by case analysis.

The use of the names of individuals as a trademark is denied in two circumstances.³ First, the exclusive use of the applicant's surname results in eligibility. Second, the exclusive use of the full name of other live individuals without securing their consent is not permitted. We can derive the following conclusions from this provision. It is not prohibited to use the name of individual in combination with other signs or indications. What is prohibited is the exclusive or sole use of another's name. The use of the first name or the patronymic name or family name of another individual is not prohibited. The law clearly refers to the full name which constitutes the combination of the three. The use of a dead person's name has not been outlawed. The prohibition is subject to the consent of the individual concerned. In other words, the use of such names is permitted upon the consent of the other party.

IV. RIGHTS CONFERRED AND LIMITATIONS IMPOSED BY THE TRADEMARK REGIME

A. Rights Conferred

The owner of a trademark is conferred with two broad categories of rights under the Trademark Proclamation. These are (1) the right to use or to authorize to use and; (2) the right to exclude others from its use.

i. The Right to Use and Authorize Others to Use

The rights conferred on the owner of a trademark under TRIPS and the Ethiopian trademark regimes are crafted in different ways. The former recognizes the exclusive right of the owner to prohibit others from using the protected mark under certain circumstances.⁴

Article 16 of the TRIPS has generally been construed to require an internationally agreed upon minimum level of exclusive rights that the owner of a registered trademark enjoys and which all the WTO Members must guarantee in their domestic legislation.⁵

The EU argued before the Panel that Sections 211(a)(2) and (b) deprived trademark owners of the exclusive rights conferred on them by Article 16.1 of the TRIPS Agreement, because they were denied access to the U.S. courts if they were a certain class of trademark owners, i.e., those who owned trademarks which had been

purpose, value, geographical origin of goods of services, the time of production of the goods or rendering of the services, or other characteristics of the goods or services may not be admissible for registration".

¹ See generally Art 6(1) (f-i), Trademark Proclamation, *supra* note 3.

² Paris Convention, *supra* note 1, Art 6ter.

³ Trademark Proclamation, *supra* note 3, Art 6(1) (j & k).

⁴ The relevant provision of Art 16(1) TRIPS provides as follows: The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using "in the course of trade" identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. What is prohibited is the use of a similar mark only "in the course of trade". The use of a protected trademark of others other than in the course of trade does not fall under the exclusive right of the trademark owner under TRIPS. However, we do not have such qualification under the Trademark Proclamation.

⁵ European Communities v. United States (Appeal), *supra* note 38, para. 186.

confiscated without the permission of the owner.¹ The Panel concluded that the EU had not provided any evidence for concluding that Section 211(a)(2) would deprive a person who was deemed to be an owner of a registered trademark by a U.S. court of that person's exclusive rights. Therefore, the Panel ruled that there was no evidence that Sections 211(a) (2) or (b) was inconsistent with Article 16.1.

In upholding the Panel's ruling, the Appellate Body went further to affirmatively determine that neither Section 211 (a) (2) nor (b) was inconsistent with Article 16.1. The Appellate Body said that Article 16.1 gives exclusive rights to the owner of a trademark but does not tell us who the owner is. The question of who is the owner is to be determined by national law. Under U.S. law, a person who has a trademark, which has been confiscated without the permission of the original owner, is not the owner. If you are not the owner, you have no rights to the trademark. Article 16.1, by its clear language only gives rights to owners. Therefore, the Appellate Body concluded Sections 211 (a) (2) and (b) were not inconsistent with Article 16.1.²

Hence, the owner of a protected trademark would be in a better position to preclude others from the use of a similar or an identical sign or symbol for goods or services similar to the one for which the mark is registered in the course of trade provided that such a use by others would cause a likelihood of confusion. Such exclusion could also be exercised with respect to goods or services which are not similar to those in respect of which the trademark in question is registered.³

Unlike TRIPS, the Trademark Proclamation authorizes the owner of a trademark to use the mark in relation to any goods or services for which it has been registered.⁴ Right of use may include the right of the owner of the mark to affix it on goods, containers, packaging, labels, etc and may also extend to use of the mark in advertisement, on business papers, documents, as well as the right to introduce the goods or services to the market under the trademark.⁵

The owner of a trademark is permitted not only to use the trademark but also to authorize others to make use of it. A word of caution here, however, is that the owner can authorize others to use the marks only in relation to the goods or services for which the owner has been registered. In other words, a person authorized by an owner of a trademark cannot use the mark for goods or services with respect to which the transferor has not been registered.⁶ This coincides with the maxims '*a person cannot transfer a better title than she has*' or '*a person should not be permitted where they have not sown*'. Pursuant to the agreement of the parties, only a portion of such a right may also be transferred. It should also be noted that the owner could transfer not only a right on a registered trademark but also a right on an application for registration of a trademark. The owner of a trademark is permitted to transfer her rights to others in two types of arrangements. These are assignment and license.⁷

Unlike transfer on license, which is regulated under Art 29 through 33 of the Trademark Proclamation (of course Art 28 governs transfer of rights in general), we have no separate provisions regulating assignment of rights on trademarks. Accordingly, the transfer of rights on assignment becomes subject to Art 28 of the Proclamation. Assignment of the right on a trademark can be transferred in two forms-with or without the business in which the mark is used.⁸ However, if the transfer of a trademark independent of the business is made and if the EIPO is of the opinion that the use of the mark by the new business has a potential to mislead the public, the transfer may not take place. Such refusal, in no case, entails the invalidity of the trademark when used by the assignor. Sometimes, it may be such that the transfer of a business is made without agreeing as to the trademark attached to the business. This time, the law takes the presumption that the trademark is transferred with the business. This, by no means, precludes the parties from agreeing to the contrary.

When it comes to TRIPS, it holds that 'the owner of a registered trademark shall have the right to assign the trademark with or without transfer of the business to which the trademark belongs'.⁹ The PC, on its part, permits assignment and transfer of a mark only if at least the portion of the business or goodwill located in that country be transferred to the assignee, or together with the exclusive right to manufacture in the said country, or to sell

¹ *Id.* para. 179.

² *Id.* paras. 198-202.

³ TRIPS Agreement, *supra* note 2, Art 16(3). For the trademark owner to deny the use of a similar mark by others with respect to goods or services not similar to those for which her mark is registered, two cumulative requirements should exist. First, the use of the marks should indicate some degree of connection between the non-similar goods or services and the owner of the trademark. Second, such a use must have endangered the interests of the owner of the trademark. A point to be noted here is that the law is not clear as to what is meant by the 'interests' of the owner of the trademark i.e. whether it refers to a financial, moral or other interests.

⁴ Trademark Proclamation, *supra* note 3, Art 26(1). The relevant part of the provision reads 'the owner of a registered trademark shall have the right to use or authorize any other person to use the trademark in relation to any goods or services for which it has been registered'.

⁵ Fikremarkos, *supra* note 17, at 188.

⁶ Trademark Proclamation, *supra* note 3, Art 33.

⁷ *Id.* Art 28(1) of the Proclamation reads 'a right on a registered trademark or an application for registration of a trademark may be assigned or licensed in whole or in part'.

⁸ *Id.* Art 28(4).

⁹ TRIPS Agreement, *supra* note 2, Art 21.

therein, the goods bearing the mark assigned.¹ This discussion enables us conclude that the Trademark Proclamation, with respect to assignment, coincides with TRIPS but contradicts with the PC.

The right to use a trademark can also be transferred upon license contracts. As pointed out earlier, a subject matter to be transferred is not only a registered trademark but also an application for registration.² The English and Amharic versions of Art 29(1) of the Trademark Proclamation are at variance. Under the English version, two requirements are provided. These are, first, the contract has to be made in writing. And, second, the contract has to indicate whether the license relates to whole or part of the goods or services with respect to which the mark has been registered or an application thereof has been made. In the Amharic version, however, the requirements are missing. Thus, one may question whether a contract which is not in compliance with such requirements is still valid given that they are not provided for under the Amharic version, which turns to prevail in case of contradiction.

In recognition of the voluntary limitations to the right of the trademark owner, trademark proclamation is consistent with the TRIPS agreement. TRIPS agreement has expressly excluded the compulsory license of trademark. However, regarding the voluntary license it has no prohibitive provision. Moreover, TRIPS has recognized the rights of trademark owners to transfer the rights that they have on trademark with or without the business to which it belongs.³ After recognizing this basic right TRIPS has empowered states to set conditions on licensing and assignment of trademark rights. In general the conditions of trademark licensing provided by the trademark proclamation are within the spirit of TRIPS agreement.

Be the debate as it may, the EIPO, after examining the validity requirements, will register and publicize the license contract. What is more, the purpose of registration of the contract is to third parties of the transfer of rights of the licensor to licensee.⁴ It follows that, failing registration; the contract will produce a legal effect as between the parties to the contract.

ii. The right to exclude others

The right to exclude others is another category of right with which the owner of a trademark is conferred.⁵ The rights are crafted in broader terms so as to label numerous acts as infringement. Accordingly, the owner can preclude others from engaging in the following activities. First, the use of a trademark or a symbol resembling it by others in such a way as to be likely to mislead the public for the goods or services in respect of which the trademark is registered, or for other goods or services in connection with which the use of the mark or resembling sign is likely to mislead the public is prohibited. Some elements of this provision are worth mentioning. (i) The claimant is not supposed to establish the exactness of trademark with what others are prohibited to use. Accordingly, a minimum degree of resemblance suffices to exclude others. (ii) A likelihood of misleading the public could give rise to allege infringement. (iii) The mark or the resembling sign is not necessarily to be used with the same goods or services for which the mark is registered. The use of the mark or the resembling sign with respect to other goods calls for the right to exclude others provided that such a use is likely to mislead the public.

Second, the owner can exclude others from any use of a trademark, or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests. Here, it may not be as easy as it may seem to establish a 'just cause' to permit preclusion. In addition, the phrase '*likely to be prejudicial to his interests*' requires a due care as it may result in an arbitrary violation of the rights of other businesspersons. Third, and most importantly, the owner of a trademark can prohibit others from engaging in other similar acts. This provision is no less destructive than permitting the owners of trademarks to take justice in to their hands. One is free to claim any right and argue that he is legally entitled to it under this proviso. This may also be supported by the fact that had the legislature wanted to restrict the rights of the owner to only the grounds mentioned under sub provisions (a) and (b) of sub article (2) of Art 26 of the Proclamation, it would not have inserted sub (c), which is rather very broad.

Moreover, the owner of a trademark who wants to use the right to exclude others is not obliged to prove that the use by others of his marks with respect to identical goods or services has a likelihood of creating confusion to the public.⁶ This is a matter of presumption. The only thing he is required to do is to establish that identical marks are used with respect to identical goods or services for which the mark is registered.

Under TRIPS, the owner of a registered trademark is granted an exclusive right to exclude others from using, in the course of trade, identical or similar signs with respect to goods or services identical or similar to the one in relation to which the trademark is registered in case such use would result in likelihood of confusion to

¹ Paris Convention, *supra* note 1, Art 6(1).

² Trademark Proclamation, *supra* note 3, Art 29(1).

³ TRIPS Agreement, *supra* note 2, Art 16(1).

⁴ *Id.* The last sentence of Art 29(2) provides that 'the license contract shall have no effect against third parties until so registered'.

⁵ Trademark Proclamation, *supra* note 3, Art 26(2) (a-c).

⁶ *Id.* Art 26(3).

customers.¹ Here also, a likelihood of confusion is presumable where identical sign is used for identical goods or services. Thus, the right of a trademark owner is said to be infringed where similar sign is used with similar goods or services without securing the consent of the owner of a trademark and when such use is likely to cause confusion.

B. Limitations

The right conferred on the owner of a trademark is not an absolute one. Accordingly, limitations are imposed on the right to exclude others on use of the trademarks. The PC is not of help in this regard. Under the Convention, exceptions to rights protected by trademarks are not expressly addressed. TRIPS, on the other hand, recognize that members may impose exceptions where the need arises.² It permits member states to make limited exception to the rights of IP right holders in general and trademark holders in particular.³ Particularly in relation to exhaustion doctrine, TRIPS allows national or regional laws to determine the extent to which the trademark right holders exhausted their rights upon the first sell. Hence, adopting international, regional or national exhaustion doctrine lies in the discretion of member states.

Accordingly, the Trademark Proclamation imposes two limitations on the rights of the owner of a trademark. The first limitation relates to the rule of exhaustion.⁴ The owner is not in a position to prohibit others from using the trademark in relation to the goods lawfully sold in any country under that trademark so long as the goods have not undergone any form of alteration. As such, the right of the right holder exhausts only with respect to '*goods lawfully sold*'. The provision applies only to '*goods*'. Hence, it seems that the right of the owner remains intact where the service is lawfully rendered under a registered mark. In addition, only lawful sale of goods under the mark causes exhaustion. In other words, the goods must have been introduced to a market with the consent of that trademark owner. Furthermore, the provision is not clear whether the rights of the owner exhaust on grounds other than sale like, for instance, donation. Second, the exhaustion relates only to the right to use. As a result, non-owners of the mark cannot authorize others to use or preclude others not to use. It has to be noted that the country where a lawful sale of the goods took place is immaterial. This shows that Ethiopia follows *international rule of exhaustion* in this regard. And, finally, the goods should not have been altered. Where a change has been made to the goods sold under the registered trade mark, the exercise of any right out of it goes to the real owner of the mark.

The second type of limitation recognized under the Trademark Proclamation is concerning the '*bona fide*' use by third parties.⁵ Thus, third parties are not precluded from using their names, addresses, pseudonyms, etc concerning the kind, quality, quantity, etc of their goods of services provide that four cumulative requirements are satisfied. First, there should be *good faith* on the part of the third party user. Second, there need to be some connection between the third party (e.g. her name, address etc) and the protected trademark, the existence of which were not known by the user. Third, the use has to be confined to mere *indicative* or *informatory character*. In other words, such use should not serve as representing the *distinctive character* of the goods or services of the user. Fourth, there should be no room for such a use to mislead the public. It can be said that trademark proclamation is TRIPS consistent in imposing the limitations.

V.SPECIAL CASES OF PROTECTION

A.Protection of Collective Trademarks

So far, the author were discussing instances in which private businesspersons, i.e. traders or business organizations claim an entitlement to trademark protection on individual basis. However, sometimes it may be such that a group of persons demand to exercise collectively. Accordingly, the exercise of such group right is recognized under various laws in a special manner. This subsection briefly presents the nature and conditions of such collective protection.

Under the Ethiopian Trademark regime, 'collective trademark' is defined as 'a trademark distinguishing the goods or services of members of an association, which is the owner of the trademark, from those of other undertakings'.⁶ What makes collective mark peculiar from other forms of protection is that only few persons are eligible to apply for it.⁷ As such, entities other than trade unions, trade union federations or associations cannot be granted a protection within the meaning of this provision. However, it is argued that the term association has to be interpreted broadly in such a way that it includes any plurality of natural or legal persons united to pursue a

¹ TRIPS Agreement, *supra* note 2, Art. 16 (1).

² Art 17 of TRIPS reads 'Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties'. This provision is a reflection of the three-step-test accepted for exceptions to copyright.

³ TRIPS Agreement, *supra* note 2, Art 6.

⁴ Trademark Proclamation, *supra* note 3, Art 27(1).

⁵ *Id.* Art 27(2).

⁶ *Id.* Art 2(1).

⁷ Art 19 of the Trademark Proclamation states that trade unions, trade union federations or associations may apply to acquire collective trademark to protect the interests of their members.

common goal.

A collective mark may be owned by an association which itself does not use the collective mark but whose members may use the collective mark.¹ This argument is in line with the definitional provision of ‘collective trademark’ [Art 2(1)] which emphasizes on the ownership of the mark to be of the association. This is not without reason. It is just with the view to hold the association responsible for any acts to be conducted under the collective trademark. Thus, members of the association may make use of the collective mark only as far as their activities coincide with the obligations assumed under the statutes of the association.

An application for registration of a collective trademark is expected to indicate itself as collective and is required to be accompanied with the copy of the statutes governing the use of the trademark.² The statutes have to constitute the basic details of the association and also expected to notify any change thereof at a later time. The Proclamation also governs the circumstances under which the registration of collective trademarks could be cancelled.³ It goes on saying that, once cancellation is effected, the collective trademark cannot be appropriated with same goods or services by a new registration or may not be used in any other way. Such a use may only be permitted after the lapse of seven years from the date of cancellation. The reason for such prohibition seems to be consumer protection by denying a new businessperson not to take the position of the former association in the market.

On the international plane, the PC tries to regulate collective marks.⁴ Under the Convention, Members are duty bound to recognize and protect collective marks of associations provided that such protection is not contrary to the law of origin⁵ and the public interest⁶. Nevertheless, protection has to be granted whether or not the existence of the association contravenes the laws of the host state and irrespective the existence of an industrial or commercial establishment therein. What is more, Art 7bis 3 PC requires members to acknowledge the association’s existence according to the regulations of the country of origin. When it comes to TRIPS, there is no specific provision allotted to the protection of collective marks.

B. Protection of Well-Known Marks

A considerable number of companies have successfully established, via their trademarks, including service-marks, worldwide fame and reputation.⁷ Consequently, consumers can, without effort, recognize and identify their goods or services, their qualities and their features without referring to the location of the company in question.⁸ The protection of such marks, referred to as well-known marks, is justified not only to protect the owner of a well-known mark but also to avoid confusion of consumers.⁹ For a mark to be protected in this scenario in Ethiopia, four requirements need to be satisfied cumulatively.¹⁰ These are, first, there has to be a trademark protected as well-known under international instruments to which Ethiopia is a party. For instance, under the PC, the owners of well-known marks are granted a protection that overrides the rights of a local right holder over the mark even where the latter can show priority of registration or use of the mark in the country.¹¹ Hence, Members are duty bound to reject or delete the registration of trademarks that are identical to a well-known mark or liable to be confused with a well-known mark and to forbid the use of a trademark liable to create confusion.¹² Thus, well-known marks are not only protected against identical marks but also against those with which they could likely be confused.

The Convention extends the protection only when the marks are used with respect to goods. Accordingly, service marks have no such protection. In this regard, Art 6bis PC is supplemented by Art 16 of the TRIPS. Under TRIPS, the protection of well-known marks is inclusive of both goods and services.¹³ Its scope of application is also widened so that well-known marks are protected even where they are used in connection with goods or services other than sold by the owner of the mark.¹⁴ Unfortunately, Ethiopia is not a party to any of the aforementioned international treaties. Accordingly, the application of Art 23 of the Proclamation will remain

¹ Fikremarkos, *supra* note 17, at 195.

² Trademark Proclamation, *supra* note 3, Art 18(1); Trademark Regulation, *supra* note 3, Art 10.

³ *Id.* Art 20.

⁴ Paris Convention, *supra* note 1, Art 7bis.

⁵ *Id.* Art 7bis (1). Under this provision, Members are supposed to cross-check the statutes of the associations and the law of the country of origin, and if it established that the establishment of the associations is not in compliance with the laws of the country of origin, protection to the marks could be denied, without the state transgressing its obligation under the Convention.

⁶ *Id.* Art 7bis (2). Unlike its sub article (1) which explicitly refers to the law of the country of origin, sub (2) is not clear as to whether the benchmark is the country of origin or the host state or both while determining the compliance of the mark with ‘public interest’. Since ‘public interest’ is vague in its nature, it has to be restricted to only that of the country in which protection is sought.

⁷ Tilahun, *supra* note 56.

⁸ *Id.*

⁹ Fikremarkos, *supra* note 17, at 194.

¹⁰ Trademark Proclamation, *supra* note 3, Art 23(1).

¹¹ Paris Convention, *supra* note 1, Art 6bis.

¹² *Id.* 6bis 1.

¹³ TRIPS Agreement, *supra* note 2, Art 16.

¹⁴ *Id.* Art 16(3).

dormant pending Ethiopia's accession to the WTO.

Second, the trademark has to be well-known in Ethiopia. The Proclamation gives a hint as to the matters to be considered in the determination of this second criterion.¹ Thus, a due regard shall be had to the knowledge of the trademark in the relevant sector of the public. This may also include knowledge of the mark which is acquired in the course of the promotion of the trademark even if no goods or services are introduced into a market under that trademark. The more the trademark is advertised in Ethiopia, the higher the chance for it to be protected. TRIPS also prescribe almost similar criteria to determine whether a mark is well-known in Ethiopia.² It requires the mark to be known to a 'relevant sector of the public'. This, however, is not to mean that all members of the sector has to know it. For instance, it may suffice that specialists in a particular field knows the trademark while the general public may not know.³

Third, the ownership of the well-known mark has to go to a national or domiciliary or a person having a real and effective industrial or commercial establishment in a state party to the Convention. It has to be noted that the requirements in this particular paragraph are alternative. Last, but not least, it is immaterial whether or not the owner of the well-known mark in question operates business or has any goodwill in Ethiopia.⁴ Pursuant to Art 6bis PC, it is only necessary that the mark has been used somehow. A registration in a member is not necessary. It, however, needs to have occurred domestically.

VI. REMEDIES FOR INFRINGEMENT OF PROTECTED RIGHTS

Insofar as the enforcement of trade mark rights are concerned, the Proclamation has made, inter alia, trade mark oppositions, trade mark infringement, invalidation and cancellation proceedings and customs recordal vis-à-vis registered trademarks possible in Ethiopia. The Proclamation is also quite revolutionary in that it provides for the protection of unregistered well-known trade mark and marks in which rights have been acquired through local use in Ethiopia. The legislation also prohibits the registration and use of another's marks in relation to dissimilar goods which still suggests a connection to the proprietor of the mark or which is detrimental to the interests of the trade mark owner.

The Trademark Proclamation has included remedies for the infringement of trademark rights.⁵ The same is true for TRIPS agreement.⁶ The two legal regimes have included various types of remedies for the infringement of trademark rights. These are the civil and criminal remedies; boards and internal remedies; as well as provisional and permanent remedies.⁷ In fact, the categories are not exclusive. The provisional and permanent remedies and the boarder and internal remedies can be seen under civil and criminal categories. To start with the civil remedies, the two legal regimes have included these remedies consistently. These remedies include injunction, compensation, custom measures at the port or boarder measure. Regarding injunction, the court may order either temporary or permanent injunction to stop the infringement of trademark. Likewise, the court is empowered to order compensation for the infringement of trademark rights upon the establishment of the infringement. On the other hand, the customs authority may seize and detain the goods which are suspected of infringement of trademark rights subject to requiring the applicant to produce guarantee. However, the authority shall release the goods if the applicant fails to comply with the order of the court within ten days.⁸

The other is that the two instruments have equally included the criminal remedy for the infringement of trademark rights.⁹ These remedies include imprisonment of the infringer, the fine penalties on infringer and the seizure, forfeiture and destruction of infringing goods and any materials used for infringement. Trademark proclamation stipulates that the intentional infringer shall be punished with 5 years to 10 years imprisonment and the negligent infringer shall be punished from 1 year to 5 years unless heavier penalty is provided by criminal law. TRIPS agreement has not provided for specific imprisonment or fine penalties. However, it requires member states to have effective enforcement remedies which have potential to prevent infringement and to deter further infringement.¹⁰ Compared to the TRIPS agreement, the Ethiopian trademark proclamation has managed the remedies for infringement of trademark rights in TRIPS consistent manner.

VII. CONCLUSION

This work has presented a brief analysis of the Ethiopian trademark regime in light of TRIPS with a special emphasis on the subject matter protected, the eligibility for protection and the rights conferred by the trademark

¹ Trademark Proclamation, *supra* note 3, Art 23(2).

² TRIPS Agreement, *supra* note 2, Art 16(2).

³ Fikremarkos, *supra* note 17, at 193.

⁴ Trademark Proclamation, *supra* note 3, Art 23(1), last phrase.

⁵ *Id.* Art 39-42.

⁶ TRIPS Agreement, *supra* note 2, Art 41-61.

⁷ Trademark Proclamation, *supra* note 3, Art 39-42; See also TRIPS Agreement, *supra* note 2, Art 41-61.

⁸ *Id.* Art 42(3).

⁹ *Id.* Art 41.

¹⁰ TRIPS Agreement, *supra* note 2, Art 41(1, 2.&4).

regime. A reference to the PC has also been made on the account that some of its provisions are incorporated under TRIPS. Ethiopia is not yet a signatory to the Paris Convention and the WTO. Notwithstanding this, some of the protections made available under the Ethiopian Trademark Proclamation appear to exceed the minimum protection provided for under TRIPS. The inclusion of some provisions under the Proclamation is something of a misnomer in Ethiopia as they are premised on the articles of the Paris Convention and the TRIPS Agreement. It is also not uncommon to come across where the two legal regimes are in conflict. Be that as it may, this shift in the law has expanded mechanisms for the enforcement of trade mark rights in Ethiopia.

At this crossroad, the Ethiopian trademark regime requires double-check. On the one hand, providing a protection beyond the minimum threshold would distort trade be it a domestic or cross-border. On the other hand, any protection below the TRIPS standard impairs Ethiopia's journey towards accession to the WTO. Therefore, it is advisable that necessary adjustments be made in order to comply with TRIPS standards.

As illustrated in the preceding paragraphs, the endeavors and measures Ethiopia took so far are encouraging. However, much remains to be done. Any reform in the trademark regime should be addressed on a priority basis in view of the determination of the Ethiopian government to strengthen the intellectual property system and use it as a tool for development. The development and integration of intellectual property polices in to national development strategy and plan, the streamlining of intellectual property administration, the revision of existing laws and putting in place new laws must be the way forward.
