

# PROTECTION OF WELL-KNOWN TRADEMARKS IN ETHIOPIA: A COMPARATIVE TREATISE UNDER THE TRADEMARK PROCLAMATION

Tilahun Esmael Kassahun\*

## ***Abstract***

*The purpose of this Article is to undertake a comparative survey of key issues that need to be addressed under the Trademark Proclamation with regard to protection of well-known trade marks in Ethiopia. In doing so, the Article attempts to evaluate the current system against relevant international instruments and best practices in an effort to bring the current standards of protection in the country close to that of the international community. In so doing this article finds that the Proclamation goes further to protect well-known marks than what would be required of it under relevant international instruments, a situation which should be reviewed in light of the need to balance Ethiopia's domestic interests with its international commitments.*

**Keywords:** *Ethiopia, trademark, TRIPS Agreement, well-known trademark*

## **I. Introduction**

The theories and practices underlying modern trademark systems are as old as commerce itself.<sup>1</sup> Today, although trademark protection regimes

---

\* Assistant Lecturer at Haramaya University College of Law and is currently on study leave; LL.M. (Business Law candidate) Addis Ababa University, LL.M. (International Economic Law and Policy, IELPO, University of Barcelona candidate) he can be reached at tekassahun@ielpo.org. The author also would like to give his sincere gratitude to the editors of the *Haramaya Law Review* and the two anonymous reviewers for their valuable remarks, comments and suggestions.

are present virtually in every country of the world, “national regimes often differ markedly regarding the scope of protection, the requirements for names and symbols that can be protected, and guidelines for avoiding confusing marks, registration costs, the legal means available for fighting infringement, and other important details.”<sup>2</sup> One of the thorny issues in this area is the case of global protection of well-known trademarks where in the course of the globalization of economic activities and diversification of business lines in recent years, there is an increasing risk that the property interests of trademarks, particularly “famous trademarks,” could be damaged.

At the moment, a comprehensive level of global consensus seems to have been reached in terms of protecting this line of trademarks. The *famous marks doctrine*, which should more accurately be called the *famous foreign marks doctrine*, proposes that trademarks that have achieved a certain degree of fame or recognition in a foreign country ought to be accorded domestic protection without a showing of domestic registration or use in commerce.<sup>3</sup> In the more developed jurisdictions of the United States and major European countries, if a registered trademark is widely known or if its reputation is damaged, that trademark is protected, while the particular set of infringements are deemed to constitute a trademark infringement, beyond the scope of the registered goods or services.<sup>4</sup> It has been said that

---

1. David Johnson, “*Trademarks : A history of a billion-dollar business*”, <http://www.infoplease.com/spot/trademarks1.html> (last accessed Dec. 2012), at 1. Read more: *Trademarks: A History*, <http://www.infoplease.com/spot/trademarks1.html#ixzz2EZxlWYsF>

2. Carsten Fink & Beata K. Smarzynska, *Trademarks, Geographical Indications, and* lity principle has also been eroded both by domestic case law and international developments that have made the well *Developing Countries*, in Bernard Hoekman et al., (eds.), *DEVELOPMENT, TRADE, AND THE WTO: A HANDBOOK* 403, at 403(2002).

3. Accordingly, with respect to the scope of trademark rights, “the strength of the territorial -known mark doctrine more readily available as an alternative means for a foreign user to obtain rights in the United States.” See Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 *HOUS. L. REV.* 886, 918 (2004).

4. See generally Momoko Nishimura, *Expanding the Protection of Famous Trademarks*, *INST. INTELL. PROP. BULL.* 58 (2008).

“the notion of a well-known trademark is one of the most polemic concepts within intellectual property, but also the most noble.”<sup>5</sup>

Following the line of developments emerging on the global plane, Ethiopia’s 2006 Trademark Registration and Protection Proclamation has made a wise effort to keep the country in line with the most sophisticated intellectual property systems.<sup>6</sup> Yet, regulation of the issue both under international intellectual property instruments and the Trademark Proclamation is not free of challenges. For instance, the definition and protection granted to well-known trademarks are still grey areas, both internationally and under the Trademark Proclamation. Thus, despite general recognition that protection should be given to well-known marks, the Trademark Proclamation is still short of fully addressing vital questions that could arise in this context.

The purpose of this Article is to undertake a comparative survey of key issues that need to be addressed under the Trademark Proclamation with regard to protection of well-known marks in Ethiopia. In doing so, the Article attempts to evaluate the current system against relevant international instruments and best practices in an effort to bring the current standards of protection in the country close to that of the international community. In so doing, this article finds that the Proclamation goes further to protect well-known marks than what would be required of it under relevant international instruments, a situation which should be reviewed in light of the need to balance Ethiopia’s domestic interests with international commitments.

Accordingly this work is structured in to seven sections. In the subsequent section, an attempt will be made to highlight some basic economic foundations of trademark law. Section 3 tries to sketch a brief account of contemporary trademark law systems of the world. Sections 4, 5 and 6 will briefly highlight the Ethiopian trademark law system and

---

5. See Orlando Viera-Blanco, *The Extension and Nobility of a Well-Known Trademark*, available at [www.ilflaw.com/publications](http://www.ilflaw.com/publications).

6. *Trademark Registration and Protection Proclamation* No. 501/2006, FED. NEGARIT GAZETA, 12th Year No. 37 (hereinafter *Trademark Proc.*). For further understanding of the Ethiopian trademark law regime, see also the recently introduced *Trademark Registration and Protection Council of Ministers Regulation No.273/2012*, Federal Negarit Gazette, 19th Year No 10, Addis Ababa, 24 Dec 2012 (hereinafter *Trademark Regulation*).

introduce the issue of well-known trademarks. Under section 7, a modest attempt is made to analyze the current state of protection of well-known trademarks in Ethiopia followed by a brief conclusion.

## II. Economics of Modern Trademark Protection and Law

Historically,

[t]rademarks originated as craftsmen's marks that artisans and others put on their goods to distinguish them from those of other artisans. Such marks have been found in antiquity, in many societies and civilizations, including Persia, Egypt and China, as well as Greece and Rome.<sup>7</sup>

Dating back to those barbarian times where majority of people could not read or write is when symbols became a logical method of letting people know, what belonged to whom? The earliest marks were that of marking of animals, so a farmer, rancher or lord could distinguish what animals belonged to whom.<sup>8</sup>

Today, the economic analysis of trademarks shows that what a trademark indicates is not that the article in question comes from a definite or particular source,<sup>9</sup> the characteristics of which are specifically known to the consumer, but merely that the goods emanate from the same—possibly anonymous—source or have reached the consumer through the same channels as certain other goods that have already given the consumer satisfaction, and that bore the same trademark.<sup>10</sup>

In standard law and economics literature, trademark law is presented as an instrumental tool of incentive creation for business enterprises to

---

7. See *International Trademark Law Harmonization*, Ladas & Parry LLP, available at <http://www.ladas.com/Trademarks/IntTMProtection/IntITM03.html> (last accessed on Dec. 04, 2012).

8. Manisha Shirolkar, *History and Evolution of Trademark System*, available at <http://www.sinapseblog.com/2011/01/history-and-evolution-of-trademark.html>

9. See generally NICHOLAS ECONOMIDES, *TRADEMARKS IN THE NEW PALGRAVE DICTIONARY OF ECONOMICS AND THE LAW*, (Peter Newman ed., 1997).

10. Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 814 (1927).

invest in the quality of the goods and services with which the marks are used and as a remedy to specific market failures.<sup>11</sup> As the argument goes, if it were impossible for consumers and for the public-at-large to identify the source of goods, then every business would have an incentive to supply goods at a quality lower than the average prevailing in the market, because the profits generated by the individual transaction would, in fact, be garnered by the individual business entering into it, while the reputational costs derived from the public's disappointment with the quality of goods would be externalized to the entire industry.<sup>12</sup> Thus, “the adoption of a sign or symbol that consistently links the goods to a source over time is seen as a device to overcome this difficulty.”<sup>13</sup> The case is often made that while “other intellectual property rights—for example, patents and copyrights—provide a mix of welfare costs and long-term economic benefits, in principle, very few costs and no welfare losses whatsoever are associated with trademark protection.”<sup>14</sup>

Trademarks are also renowned for the economic efficiency that they generate in favor of consumers.<sup>15</sup> In particular, trademarks are welcomed because of their value in saving search and experiment costs of consumers.<sup>16</sup> “The value of a trademark is the saving in search costs made

---

11. See William M. Landes & Richard Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987). Also for a normative account of Trademarks, see Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839 (2007).

12. Giovanni B. Ramello, *What's in a Sign? – Trademark Law and Economic Theory*, (Dep't of Pub. Pol'y and Pub. Choice – POLIS, Working Paper No. 73, 2006); see also Andrea Mangani, Paper Presented at the 4th Oxford University Conference on Business and Economics: Trademarking Global Brands in the European Union (June 26-28, 2005) <http://dse.ec.unipi.it/~mangani/Trademarking%20Global%20Brands1.pdf>.

13. Nicola Bottero, Andrea Mangani & Marco Ricolfi, *The Extended Protection of "Strong" Trademarks*, 11 MARQ. INTEL. PROP. L. REV. 225, 267 (2007).

14. See David W. Barnes, *A New Economics of Trademarks*, 5 NW. J. TECH. & INTEL. PROP. 22 (2006).

15. See Deborah R. Gerhardt, *Consumer Investment in Trademarks*, 88 N. C. L. REV. 427 (2010).

16. For exemplary US Jurisprudence see The Senate Committee on Patents, S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946), U.S.C.C.A.N. 1274; stating that “[t]he purpose underlying any trademark statute is twofold. One is to protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner

possible by the information or reputation that the trademark conveys or embodies about the brand (or the firm that produces the brand).”<sup>17</sup>

It should be apparent, however, that the benefits of trademarks presuppose legal protection.<sup>18</sup> For instance, for a business to create a reputation in the relevant market, it requires business expenditures on product quality, service, advertising, and so on. Once the reputation is created, the business will obtain greater profits because consequential and stable purchases will generate higher sales in addition to “fame” profits generated because consumers will be willing to pay higher prices for lower search costs and greater assurance of consistent quality.<sup>19</sup> However, if the market is disturbed by “copycats” because “the cost of duplicating someone else's trademark” is insignificant, the incentive to incur this cost will disappear.<sup>20</sup>

[I]n the absence of legal regulation . . . [t]he free riding competitor will, at little cost, capture some of the profits associated with a strong trademark since the large portion of the consumers will assume (at least in the short run) that the free rider's and the original trademark holder's brands are identical.<sup>21</sup>

---

of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trademark owner.”

17. Landes & Posner, *supra* note 11, at 270.

18. *Id.*

19. Such people are often called “snobs” because of the economic “irrationally” of paying more for the same physical product they could have purchased for less. *See generally* Shahar J. Dilbary, *Famous Trademarks and the Rational Basis for Protecting “Irrational Beliefs,”* 14 GEO. MASON. L. REV. 605 (2007).

20. Landes & Posner, *supra* note 11, at 270.

21. *Id.*

### III. Contemporary Trademark Law Systems

#### A. Trademarks under Common Law and Civil Law

In conventional trademark systems, trademarks are “acquired either through use or through” registration or some combination of these.<sup>22</sup> 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,<sup>23</sup> “[w]hile the ‘registration’ model grants trademark rights according to registration and the first applicant will obtain the trademark right.”<sup>24</sup> “In modern society, the United States is the representative state that still insists on the ‘use’ principle.”<sup>25</sup> The legislative basis that the U.S. Congress used to enact the Trademark Law is the trade provision in the U.S. Constitution: “To regulate commerce with foreign nations, and among the several states, and with the Indian tribes”. Thus, U.S. trademark law adopted a system where the use of a trademark in the course of trade between states is a prerequisite for the trademark right.<sup>26</sup> The common law doctrine of use has been deeply rooted in the U.S. trademark law. So far, the trademark grant systems in the world have been divided into the French-represented civil law registration model and the U.S.-represented common law use model.<sup>27</sup>

The protection of trademarks originated as an effort to prevent harm against the greater population by “the sale of defective goods, and to safeguard the collective goodwill.”<sup>28</sup> “The repression of trademark infringement came into the common law through an action of deceit and, although it is the public rather than the owner of the trademark who is

---

22 Trademark law, [http://www.markenverband.de/english\\_/trade%20mark%20law](http://www.markenverband.de/english_/trade%20mark%20law). (last accessed on Dec. 2012).

23. Landes & Posner, *supra* note 11.

24. The Acquisition of Trademark Right, [www.ipr2.org/storage/Acquisition\\_of\\_TM\\_rights-EN928.doc](http://www.ipr2.org/storage/Acquisition_of_TM_rights-EN928.doc) (last accessed on Dec. 2011).

25. *Id.*

26. For a detailed treatise on U.S. trademark law and policy, *see generally* HUGH HANSEN, U.S. INTELLECTUAL PROPERTY LAW AND POLICY (2006).

27. The Acquisition of Trademark Right, *supra* note 24.

28. Schechter, *supra* note 10, at 819.

actually deceived, the common law trademark action still” protects the interest of the trademark owner.<sup>29</sup> Thus, in countries which have a legal system based on pure common law, prior use is generally sufficient for claiming rights over a given trademark in case of dispute.<sup>30</sup> That is why, for instance, in countries like the U.S., trademark rights are recognized primarily based on the “first-to-use” principle.<sup>31</sup> In civil law countries, however, this is usually not the case. Only trademark registration will provide legal certainty on exclusive rights to the use of the trademark, regardless of how many years an enterprise has been using the name.<sup>32</sup> Today, the vast majority of the world aligns itself as a civil law legal tradition, wherein legal norms are basically either compiled or codified.<sup>33</sup>

A typical feature of civil law trademark regime is that jurisdictions grant trademark rights upon registration.<sup>34</sup> This way “registration allows the registrant to enforce trademark rights against others.”<sup>35</sup> In practice however, “many civil law countries allow the assertion of some trademark rights arising as a result of notoriety or distinctiveness acquired through use.”<sup>36</sup>

---

29. *Id.*

30. See World Intellectual Property Organization (WIPO), Trademarks in General, <http://www.wipo.int/madrid/en/faq/trademarks.html> (last accessed Dec 2011).

31. Thomas F. Zuber, Registering and Enforcing a Foreign Trademark in the U.S., IP International, 3-4/2009 China IP, 2009, at 101-104.

32. WIPO, *supra* note 30.

33. “*The Common Law and Civil Law Traditions*”, The Robbins Collection, 2010, at 5 <http://www.law.berkeley.edu/library/robbins/pdf/CommonLawCivilLawTraditions.pdf>. See also James G. Apple and Robert P. Deyling, *A Primer on the Civil-Law System, Federal Judicial Center publication*; see also Joseph Dainow, “*The Civil Law and the Common Law: Some Points of Comparison*”, 15 AM. J. COMP. LAW 419, (1966-1967).

34. See Gregory H. Guillot, “*All about Trademarks*”, <http://www.ggmark.com/protect.html> (last accessed Dec 2012).

35. Samantha D. Slotkin, Note, *Trademark Piracy in Latin America: A Case Study on Reebok International Ltd.*, 18 LOY. L.A. INT’L & COMP. L.J., 672-73(1996).

36. Ladas & Parry, *supra* note 6.

## ***B. International Law***

Traditionally, trademark law grew all over the world with the internal market in mind, with little or no thought given to foreign owners of trademarks or their rights.<sup>37</sup> However, the driving by accelerating globalization and international trade has given a powerful boost to the argument in favor of protection of trademarks and business reputation, central to which trademark law must be consistency in operation and application.<sup>38</sup>

Thus, globalization has led to a degree of harmonization of trademark laws.<sup>39</sup> Harmonizing national legal systems to be similar, employing basic minimum standards, or at least enacting more consistent laws, all have the obvious effect of simplifying trademark protection. Major example includes the 1983 Paris Convention for the Protection of Industrial Property (Paris Convention).<sup>40</sup> Another key force in the harmonization of international trademark laws has been the 1994 World Trade Organization's (WTO) TRIPs Agreement,<sup>41</sup> which generally requires both statutory harmonization and enforcement harmonization.<sup>42</sup> The Paris

---

37. See generally Brad Sherman and Lionel Bently, *The Making of Modern Intellectual Property Law - The British Experience, 1760-1911*, Cambridge Studies in Intellectual Property Rights, Chapter Seven, Explanations for the shape of intellectual property law, (1999).

38. LANNING G. BRYER, SCOTT J. LEBSON AND MATTHEW D. ASBELL, *INTELLECTUAL PROPERTY OPERATIONS AND IMPLEMENTATION IN THE 21ST CENTURY CORPORATION*, by John Wiley & Sons, Inc., at 226 (2010).

39. See generally J. Weberndörfer, *The Integration of the Office for Harmonization in the Internal Market into the Madrid System: A First Field Report*, in E.I.P.R. (2008).

40. *Paris Convention for the Protection of Industrial Property* of March 20, 1883, as revised at Brussels on Dec.14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on Oct. 31, 1958, and at Stockholm on July 14, 1967, and as amended on Sept. 28, 1979.

41. *Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, Marrakesh Agreement Establishing the World Trade Organization*, signed at Marrakesh (Morocco), April 15, 1994; Annex IC, *Agreement on Trade-Related Aspects of Intellectual Property Rights* [hereinafter TRIPS Agreement or TRIPS], reprinted in *The Results of the Uruguay Round of Multilateral Trade Negotiations—The Legal Texts*, 1–19, 365–403, GATT Secretariat, Geneva (1994).

42. See generally DUNCAN MATTHEWS, *GLOBALIZING INTELLECTUAL PROPERTY RIGHTS*, (ROUTLEDGE/WARWICK STUDIES IN GLOBALIZATION ) (2002).

Convention has also been an instrument of harmonization of the trademark laws.<sup>43</sup>

Accordingly, since the national trademark systems are a design of national legislators, they can act, both in theory and practice, as a barrier for international movement of trade and investment.<sup>44</sup> The laws in fact were originally intended to protect local merchants. This stands in contrast to today's theory and growing practice of the global market. Therefore, "the use of a national trademark as a way to seal off various markets from one another as a form of trade protectionism has come under increasing international criticism."<sup>45</sup> In the mean time, the inherent limitations of the territorial application of trademark laws have been mitigated by various intellectual property treaties, foremost amongst which are the Paris Convention, the Madrid System, the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) and the Trademark Law Treaty. Below is a brief reflection on the basic framework of these.

- *Paris Convention*: Paris Convention for the protection of Industrial Property is the oldest and multilateral industrial property treaty. It was signed in Paris on March 20, 1883, entered into force as from July 7, 1884, and has been revised six times, the latest revision being made in Stockholm in 1967. It has the widest membership consisting of more than 140 member countries. The Paris Convention includes provisions relating to the all-industrial property rights, and establishes a set of uniform rules that must be observed by the member country of Union to provide minimum protection in the domestic legislation of the industrial property rights.<sup>46</sup> In addition, the cornerstone of the Convention is the National Treatment

---

43. Karol A. Kepchar, *Protecting Trademarks: Common Law, Statutes and Treaties*, ALI-ABA Course of Study, Fundamentals of Trademarks, Copyrights, and Unfair Competition: Protection and Enforcement in the Digital Age, Chicago, Illinois October 11-12, 2007, at 103.

44. Zenobia Ismail, Tashil Fakir, *Trademarks or trade barriers?: Indigenous knowledge and the flaws in the global IPR system*, 31 INT'L J. SOC. ECON. 1/2 (2004), at 173.

45. See, Substantive Trademark Law Harmonization, [http://www.gaileevans.com/Ch7\\_Evans\\_Final.doc](http://www.gaileevans.com/Ch7_Evans_Final.doc) (last accessed Dec. 2011).

46. XIA Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards and Trademark Law Systems Between Japan and China*, Trademark Office State Administration for Industry and Commerce, at [www.jpo.go.jp/torikumi\\_e/kokusai\\_e/asia\\_ip.../2002\\_china.pdf](http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip.../2002_china.pdf) (last accessed Dec 2011).

principle, expressed in Article 11(1), which provides that “[n]ationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant to nationals.”

- *Madrid System*: The Madrid System primarily constituting the Madrid Agreement Concerning the International Registration of Marks<sup>47</sup> (Madrid Agreement) is the oldest multilateral regime to simplify and harmonize the standards and procedures for trademark registration and protection.<sup>48</sup> Two treaties make up the *Madrid System*: the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement.<sup>49</sup> The system establishes a core application and registration framework in its member countries by immediately extending the protection obtained through the World Intellectual Property Organization.<sup>50</sup> This international registration is in turn based upon an application or registration obtained by a trademark applicant in its home jurisdiction.<sup>51</sup> The main input of the *Madrid system* is its innovative approach which allowed an owner of a trademark to secure a simultaneous trademark protection in more than one jurisdiction by filing only one application in a single jurisdiction.<sup>52</sup>

---

47. *Madrid Agreement Concerning the International Registration of Marks* of April 14, 1891, as revised at Brussels on Dec. 14, 1900, at Washington on June 2, 1911, at The Hague on Nov. 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967, and as amended on Sept. 28, 1979 (here in after *Madrid Agreement*).

48. Robert H. Hu, *International Legal Protection of Trademarks in China*, 13 INTELL. PROP. L. REV. 69, 86 (2009).

49. *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007 (here in after *Madrid Protocol*).

50. The World Intellectual Property Organization is a specialized agency of the United Nations dedicated to the promotion and protection of Intellectual Property in all its forms.

51. *See Madrid Protocol*, Article 4: Effects of International Registration; Article 4bis: Replacement of a National or Regional Registration by an International Registration.

52. *Id.*, Article 6: Period of Validity of International Registration; Dependence and Independence of International Registration; Article 7: Renewal of International Registration For a comprehensive discussion of the Madrid Agreement and the Madrid Protocol; *see also* PETER J. GROVES, SOURCE BOOK ON INTELLECTUAL PROPERTY LAW, Chapter 6, Trademarks, at 627-632 (1997).

- *The TRIPs Agreement*: The conclusion of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) in 1994 opened the advent of effective global protection of trademark rights.<sup>53</sup> In addition, the Agreement also provides detailed rules regulating the protection of trademarks, and rules, which would impose legal obligations on WTO Members towards building effective enforcement procedures within their jurisdiction.<sup>54</sup> Among others, the Agreement requires WTO Members to ensure that enforcement procedures and remedies are available to permit effective action against any act of infringement of the intellectual property rights referred to above, including civil and administrative procedures and remedies, provisional measures and criminal procedures.<sup>55</sup> Pursuant to Articles 3 and 4 of the TRIPS Agreement, each WTO Member must accord other WTO Members national treatment and most-favoured-nation treatment, subject to a number of exceptions.<sup>56</sup>

- *Trademark Law Treaty*: The Trademark Law Treaty is a system that aims to establish international rules on areas whereby countries commit to standardize their procedural rules with respect to their domestic trademark registration procedure.<sup>57</sup> Apparently, what has become today's Trademark Law Treaty is only a reminder of broad aspirations originally envisioned by the contracting parties. The original aim of the negotiations for this treaty, was to harmonize the trademarks laws of the eventual signatory states in numerous areas, both administrative and substantive, including harmonization of the definition of registrable marks, provision for registration of sound marks, provision of opposition procedures,

---

53. See generally Gail. E. Evans, *Substantive Trade Mark Law Harmonization by Means of the WTO Appellate Body and the European Court of Justice: The Case of Trade Name Protection*, 41 J. WORLD TRADE L. 6, 1127–1162 (2007).

54. See generally PETER VAN DEN BOSSCHE, *THE LAW AND POLICY OF THE WORLD TRADE ORGANIZATION TEXT, CASES AND MATERIALS*, Cambridge University Press 2005.

55. TRIPs Agreement, Articles 41–61.

56. Other than Trademarks, the TRIPS Agreement in general covers six types of intellectual property: copyright and related rights (Articles 9-14), geographical indications (Articles 22-24); industrial designs (Articles 25-26); patents (Articles 27-34); layout-designs (topographies) of integrated circuits (Articles 35-38); and undisclosed information, including trade secrets (Article 39).

57. WIPO, *TRADEMARK LAW TREATY*, Done at Geneva on Oct. 27, 1994, WIPO Publication No 225(E).

harmonization of the definition of objectionable marks, etc.<sup>58</sup> However, due to serious line of stalemates in the negotiations, almost all the substantive goals of the Treaty were eliminated, thereby leaving the treaty with the purely administrative harmonization treaty as we have it today.<sup>59</sup> In the mean time, the principal features of trademark practice, which the Treaty seeks to harmonize include, *inter alia*, the initial registration term and renewal terms of trademark registrations will be ten years,<sup>60</sup> service marks are given the same protection as trademarks under the Paris Convention,<sup>61</sup> one power of attorney may be submitted for each applicant and member states may not require that signatures on powers be authenticated or legalized,<sup>62</sup> cumbersome documentation procedures, such as the submission of multiple powers of attorney, certificates of incorporation or corporate status, etc will be alleviated, and importantly single application may be filed to cover multiple international classes.

#### IV. Ethiopia's Trademark Law

As discussed above, the key function of trademarks is distinguishing products and services from others in commerce. In fact, only marks that perform such a function are protected by the Law. Accordingly Ethiopia's newly introduced and working Trademark Registration and Protection

---

58. Ian J. Kaufman, Trademark Law Treaty, 2001, available at <http://www.ladas.com/Trademarks/MadridAgreement/Madrid05.html> (last accessed Dec. 2011).

59. See WIPO, Summary of the Trademark Law Treaty (TLT) (1994), [http://www.wipo.int/treaties/en/ip/tlt/summary\\_tlt.html](http://www.wipo.int/treaties/en/ip/tlt/summary_tlt.html) (last accessed Dec. 2011).

60. TRADE LAW TREATY, Article 13 of the Treaty provides for duration and renewal of registration. (7) [Duration] The duration of the initial period of the registration, and the duration of each renewal period shall be 10 years.

61. *Id.*, Article 16, Service Marks: Any Contracting Party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.

62. *Id.*, Article 22, (2) [Single Power of Attorney for More Than One Application and/or Registration ] Any State or intergovernmental organization may declare that, notwithstanding Article 4(3)(b), a power of attorney may only relate to one application or one registration. (3) [Prohibition of Requirement of Certification of Signature of Power of Attorney and of Signature of Application] Any State or intergovernmental organization may declare that, notwithstanding Article 8(4), the signature of a power of attorney or the signature by the applicant of an application may be required to be the subject of an attestation, notarization, authentication, legalization or other certification.

Proclamation,<sup>63</sup> (Trademark Proclamation), protects trademarks that have distinguishing ability within a market.<sup>64</sup> The Proclamation was promulgated in 2006 to replace the existing, non-statutory trade mark system administered by the Ethiopian Intellectual Property Office (EIPO).<sup>65</sup> The existing system has been developed since 1987 from a simple cautionary notice procedure, so as to comprise registration for the stated term of 6 years.<sup>66</sup> Similar to economic assertions mentioned in the previous heads of this work, the Proclamation under its preamble provides that "... trade mark ... play an important role in guiding customers' choice and protecting their interests."<sup>67</sup> In here, the Proclamation does not explicitly mention the function of trademark registration as an incentive for the production of quality products. However, by emphasizing on the source identifying role of trademark registration, it can be contended that our Trademark Proclamation as well encourages the production of quality products.

---

63. *See, Trademark Proc.*

64. *Id.*, Article 2 (12) states that a "trademark" means any visible sign capable of distinguishing goods or services of one person from those of other persons; it includes words, designs, letters, numerals, colors or the shape of goods or their packaging or the combinations thereof.

65. *See Ethiopia, Trademark Law & Practice Developments*, (2010), <http://www.spoor.com/home/index.php?ipkArticleID=317> (last accessed Dec. 2011).

66. *Id.*

67. *Trademark Proc.*; in general, the preamble of the of the Proclamation state the objective of the Proclamation by stating that;

WHEREAS, it is necessary to protect the reputation and goodwill of business persons engaged in

manufacturing and distribution of goods as well as rendering services by protecting trademarks to avoid confusion between similar goods and services;

WHEREAS, trademarks, in the course of free trade. play an important role in guiding customers' choice and protecting their interests;

WHEREAS, it is believed that protection of could have positive impact on the national economic advancement and especially on the trade and industrial development of the country.

### ***A. Eligibility for Protection***

Although the role of trademark is ever expanding beyond our imagination, it primarily serves to indicate the origin of goods and/or services. Thus, the standard for the eligibility of trademarks for registration is basically determined whether the mark is distinctive.<sup>68</sup> Accordingly, under the Trademark Proclamation, a trademark shall be eligible for registration if it fulfills the following conditions: be a sign as defined under Article 2 (12) which includes words, designs, letters, numbers, colors or the shape of goods or their packaging or the combination thereof, be capable of being represented graphically as envisaged under Article 8(3)(a), be capable of distinguishing goods or services of one person from those of others, be used or proposed to be used in relation to goods and services, the use must be for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be.

### ***B. Application and Registration: Formality and Procedure***

As discussed earlier, many countries require registration of trademarks as a validity requirement. Some authorities resist the registration system as complicated, expensive and unnecessary. However, it is thought that the advantages of the registration system outweigh its potential disadvantage. In particular, it is argued that the registration of trademark would enable third parties to discover whether other traders had claimed the right to use a particular sign and, where necessary, to locate the proprietor of the sign.

Ethiopia seems to have been influenced by this Civil Law tradition in this regard. Under the Proclamation and the newly introduced Trademark Regulation, trademarks and their subsequent rights are conferred upon the trader upon the registration of the trademark and its certification which is initiated when a trader approaches the office for such registration and

---

68. See Search Results *Why a trade mark needs to be distinctive - Trade Mark Articles*, available at <http://www.trademarkroom.com/.../why-a-trade-mark-needs-to-be-distinctive> (last accessed Dec 2011).

certification.<sup>69</sup> The approval and certification of a trademark, in general, involves four steps: application for registration to be put in by the trader,<sup>70</sup> examination of application,<sup>71</sup> publication of notice of invitation for opposition,<sup>72</sup> registration of trademarks and issuance of certification, and notification of registration.<sup>73</sup>

In particular, a written application for the registration of a trademark is made by the trader and is filed in the intellectual property office. The office will, upon receipt of the application examine it for form and content. If the application is found insufficient, it will give the applicant notice and provide with sufficient time to remedy the defect. But if the defect is fundamental or if, in the period of time granted to him, the applicant does not take the appropriate steps, the office will reject his application and inform the applicant the decision in writing. Where the application proves sufficient under examination, the office will publish and broadcast, through the press and media, a notice inviting opposition to the grant of the trademark at the cost of the applicant. An opposing party will have to, within the prescribed time limit and in writing, present his issues to the office which shall relay such to the applicant. A counter report shall be expected of the applicant, the absence of which means that he has abandoned his application. The office shall furnish copies of the counter opposition to the party making the opposition and arrive at a decision within a prescribed period of time. Where the request for the registration of a trademark is found to have fulfilled its conditions as to substance and form and where it has not been opposed to or an opposition filed has been rejected, the office will register the trademark and, upon the requisite payment, issue the applicant a certificate of registration conferring him rights over such trademark.

From the time an application is made known to the public until the grant of a trademark, the applicant enjoys the legal protection that he would

---

69. As per Art.4, a right in trademark is acquired and is binding on third parties upon the grant of a trademark registration.

70. *Trademark Proc.*, Article 8. *See also Trademark Regulation*, Arts.9, 10 & 12

71. *Id.*, Art. 11 ;*see also Trademark Regulation*, Arts.14-16.

72. *Id.*, Art. 12; *Trademark Regulation*, Art. 25(2) & 26.

73. *Id.*, Art. 15; *Trademark Regulation*, Art. 31-33.

get, if he had been granted a trademark. The only exception to this rule is legal infringement. A trader may not initiate proceedings for legal infringement unless his trademark has been registered and certified. After a trademark has been appropriated appeal to such may be filed to the relevant court within 60 days from the issue.<sup>74</sup>

### *C. Duration and Renewal of registration of trade marks*

It should be noted that there is a key difference between protection of trademarks and protection of IPRs that seek to stimulate creative and inventive activity - patents, copyright, designs, and so on. In particular, unlike copyrights and patents, trademark rights can last indefinitely as long as the owner continues to use the mark to identify its goods or services. Thus, while term of protection in a trademark law can range between 5 to 10 years, this only means that protection is to be given indefinitely with 5 to 10 year renewal terms.<sup>75</sup> This fundamental difference is reflected in the fact that patents and copyright receive protection for only a limited time period, whereas trademarks can endure forever, provided they remain in use.<sup>76</sup>

Accordingly, in accordance with Article 24 of the Proclamation, the registration of a trade mark remains valid in Ethiopia for a period of seven years from the date of submission of the application for registration. However, this does not mean that the trademark would be a public domain right after the seven years period. Unlike the patent system, the jurisprudence of the trademark law always allows for indefinite renewal of trademark registration. In this regard, Article 25 provides that “registration of trademark may, upon request of the owner, be renewed for consecutive periods of seven years.” No provision under the Proclamation envisages a

---

74. *Id.*, Art. 15(1); *Trademark Regulation*, Art. 30.

75. How long does trademark protection last? <http://www.registeringatrademark.com/length-trademark.shtml>

76 CARSTEN FINK AND BEATA K. SMARZYNSKA, TRADEMARKS, GEOGRAPHICAL INDICATIONS, AND DEVELOPING COUNTRIES (IN) BERNARD HOEKMAN, AADITYA MATTOO, AND PHILIP ENGLISH, DEVELOPMENT, TRADE, AND THE WTO; A HANDBOOK, THE INTERNATIONAL BANK FOR RECONSTRUCTION AND DEVELOPMENT / THE WORLD BANK, (2002), at 404.

time limit for renewal of trademark registration. Thus, the trademark owner can in no way be discouraged by the initial shorter duration of his trademark right.

## V. The Doctrine of “Famous” and “Well-known” Trademarks

As discussed above, although there are systems which facilitate the filing, registration or enforcement of trademark rights on global basis, such as the Madrid System, it should be noted that, currently it is not possible to file and obtain a single trademark registration which will automatically apply around the world. Thus, like any other legal regime under national law, trademark laws apply only in their applicable country or jurisdiction, a character which is often known as ‘territoriality’.

Accordingly, trademark rights are territorial and ownership of a mark in one country in principle provides no advantage when enforcing the mark in another country.<sup>77</sup> Hence, trademark rights under national legislation are in principle, established through state legislature and national court decisions<sup>78</sup> supplemented by the practices of the IP offices.<sup>79</sup> According to World Intellectual Property Office (WIPO), these rights, “such as patents, trademarks and industrial designs are ‘territorial rights’ that are protected through a registration or grant procedure.<sup>80</sup> This means that they can only be enforced in countries or regions (e.g. Member States of the EU or African Intellectual Property Organization-OAPI) where protection has been established and is in force.”<sup>81</sup>

---

77. See generally Christopher Dolan, *IP: Territoriality and Well-Known Trademarks*, Inside-Counsel, A Summit Business Media Publication, 2011.

78. Mavreen A. O’Rourke, *Evaluating Mistakes in Intellectual Property Law: Configuring the system to account for imperfection*, 4 THE J. SMALL & EMERGING BUS. L., at 168 (2000).

79. It is thus expected that these institutions pay attention to the sorts of trademarks are being protected and why; thus, fulfilling their democratic mandate directly or indirectly.

80. *Convention Establishing the World Intellectual Property Organization*, signed at Stockholm on July 14, 1967 and as amended on Sept. 28, 1979.

81. See WIPO, [http://www.wipo.int/sme/en/documents/ip\\_pharma.html](http://www.wipo.int/sme/en/documents/ip_pharma.html) (last accessed Dec. 2011).

But it is understandable that a considerable number of companies have successfully established, via their trademarks, including service-marks, worldwide fame and reputation. 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. These trademarks are called *well-known trademarks*.<sup>82</sup> Following this, the geographical expansion in the operations of many businesses has given rise to a form of opportunism, against which international action, through the instrumentality of international agreements such as the Paris Convention and the WTO Agreement on Trade Related Intellectual Property Rights (TRIPs) Agreement, has taken place. More specifically, the Paris Convention has been revised to prevent the preemptive adoption of such marks by copyists in countries where the proprietor has not yet commenced marketing.

#### ***A. Well-known trademarks under Paris Convention***

According to the Paris Convention, a mark that creates confusion with a well-known trademark may not be registered in the territories of the contracting states.<sup>83</sup> Consequently, members states of the Convention are expected to acknowledge the protection of well-known trademarks within their domestic trademark law regime. In the mean time, to apply this provision, the infringing mark which creates confusion must belong to the same class of goods or be used for identical or similar goods in addition to the fact that the protection accorded for well-known marks under the Paris Convention is only limited to trademarks over goods and not services.<sup>84</sup>

---

82. See generally Lile Deinard and Amy Stasik, *The Famous Marks Doctrine Under the Paris Convention*, N. Y. L. J. (2006).

83. Paris Convention for the Protection of Industrial Property, 21 UST 1583, 828 UNTS 305, Article 6bis: Marks: Well-Known Marks.

84. *Id.*, The relevant part of the Convention reads:

Article 6 bis.

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitute a reproduction, an imitation, or a translation, liable to create confusion, of a mark

Article 6bis first incorporated the concept of a well-known trademark in 1925, and has been applying universally. It specifies the principles of protection of well-known trademarks in the countries of the Convention. The unauthorized registration and use of trademarks that constitute the reproduction, an imitation or a translation of well-known trademarks, which are the clear standards, the competent authority of the country where the protection of well-known trademark is sought has to refuse, cancel or prohibit such trademarks, while well-known trademarks should be well-known and used in the country where the protection is sought.<sup>85</sup> As such, Article 6bis of the Paris Convention imposes an obligation to recognize and protect well-known marks even where they have not been registered. Consequently, well-known trade mark status is commonly granted to famous international trade marks both in better developed and less-developed jurisdictions.

In the mean time, the Paris Convention has not defined what “well-known trademark” is. It also neither provided a criterion of which trademarks can be recognized as well known. While, the existence of actual confusion or a risk of confusion is necessary for the protection of well-known trademarks as a result of infringement, the limitation of the boundaries of a well-known mark is left under the respective jurisdiction of each Member State. In the mean time, while the provision of Article 6bis played a very important role for protection of well-known trademark in the past decades, it was unable adapt to the needs of protection in line with modern developments of global commerce. It is within this context that the limitation of the Convention has become apparent where the infringing or

---

considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

85. XIA Qing, *supra* note 46.

counterfeiting acts to well-known trademarks has become very severe were it deeply damages the benefits of proper proprietor. Therefore it became necessary to reframe the Convention towards a stronger provision to protect well-known trademarks in the global scale.<sup>86</sup> This was later achieved by the work of the TRIPs Agreement.

### ***B. Well-known trademarks under TRIPs***

Speaking of the TRIPs Agreement, one can safely say that its outstanding achievement in realm of international intellectual property protection is its ability to build from earlier foundations of intellectual property regimes established under historical instruments such as the Paris Convention.<sup>87</sup> Particularly it has been provided under the TRIPs Agreement that every Member country of the WTO is obliged to implement at the domestic level Articles 1-12 and 19 of the Paris Convention, whether or not that member is signatory of the Paris Convention in the first place.<sup>88</sup> Based on the above understanding, the TRIPs agreement provides under Article 16 that the owner of a registered trademark [will] 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."<sup>89</sup> Article 16(2) of the Agreement incorporates

---

86. *Id.*

87. Generally, the TRIPs Agreement frequently refers to other intellectual property agreements, such as the *Paris Convention for the Protection of Industrial Property (1967)*, the *Bern Convention for the Protection of Literary and Artistic Works (1971)*, the *Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1961)* and the *Washington Treaty on Intellectual Property in Respect of Integrated Circuits (1989)*, making provisions of these agreements applicable to all WTO Members.

88. Tshimanga Kongolo, *The International Intellectual Property System and Developing Countries before and after the TRIPs Agreement: A Critical Approach*, 3 INT'L PUB. POL'Y STUD. 1, at 99-116 (1998).

89. TRIPs, Art.16: Rights Conferred.

Article 6 bis of the Paris Convention and further extends the scope of its protection to ‘services’ as well.<sup>90</sup>

Thus, in conformity with the prescription of Article 16(1), an unauthorized label on goods using signs already registered as a trademark shall be considered as infringement and the labeled goods as counterfeit goods. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.<sup>91</sup> From this perspective then we can say that TRIPs has strengthened the protection of well-known marks in the sense that it applies expressly to services and is extended to “dissimilar goods or services when use of a registered mark would likely indicate a harmful connection between those dissimilar goods or services and the owner of the registered mark.”<sup>92</sup>

## VI. The Case of Well-known Trademarks in Ethiopia

While the Territoriality Rule is rooted in the commonsense idea that if a mark is not registered in Ethiopia commerce, then Ethiopian/foreign consumers will not encounter it, globalization has rendered the rule anachronistic. Indeed, economic integration, increased travel and the Internet have changed the playing field. It is now very possible that Ethiopian consumers will recognize well-known brands used exclusively overseas and erroneously assume that a copycat in Ethiopia, is associated with the overseas brand owner. Simply speaking, the primary question remains determination of whether it is actually possible for a foreign well-

---

90. In addition Art 16(2) provides that in determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark. Article 16(3) further provides; Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

91. *Id.*

92. TRIPs, Art. 16 (3); *see also* J.H. Reichman, *Universal Minimum Standards of Intellectual Property Protection under the TRIPs Component of the WTO Agreement*, 29 INT’L LAW. 2 (1995), at 363.

known mark, that is not used in Ethiopia as a trademark, to reach the required level of recognition by consumers? The answer at first seems to be in the negative. However, after considering the great number of Ethiopian diaspora abroad, internet, the growth of international satellite TV, the ease of global communications, and the convenience of international travel, a different answer emerges. Thus one can safely say that, foreign marks can and do easily become well-known to Ethiopian consumers even without actual use in the country.

Thus it is within this understanding that the Trademark Proclamation provided for rules which protects property interests of owners of foreign well-known trademarks.<sup>93</sup>

However, at the outset it should be noted that the Proclamation in effect does not commence to protect well-known marks at the date of its adoption. Rather the applications of the above rules are subject to any international agreement that Ethiopia will enter in the future. Considering the fact that the most important international agreements in this regard are the Paris Convention and the TRIPs Agreement, one can safely assume that the pertinent provision of the Proclamation protecting well-known trademarks will be put in to effect only when Ethiopia joins these instruments. And there is a high likelihood that this would happen as there are informal talks which tip that Ethiopia will sign the Paris Convention soon, while importantly Ethiopia is already in the process of acceding to the WTO and thus signing the TRIPs agreement will be certain up on accession in due time.<sup>94</sup> When this is done, an owner of a well-known

---

93. *Trademark Proc.* The following are the pertinent provisions: Article 23: 3, Well-known Trademarks 1. A trademark which is entitled to protection under an international convention to which Ethiopia is a party, as a well-known trademark shall be protected under this Proclamation if it is well-known in Ethiopia and is a trademark of a person who is: a) the national of a state party to the convention; or b) domiciled in or has a real and effective industrial or commercial establishment in a state party to the convention, Whether or not such person carries on business or has any good will in Ethiopia. Article 26 (2); Registration of a trade mark shall confer upon its owner the right to preclude others from the following: a) Any use of a trademark or a sign resembling it in such a way as to be likely to mislead the public for 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 sign is likely to mislead the public, b) Any use of a trademark, or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests and; c) Other similar acts.

94. See generally Melaku Geboye Desta, *Accession for What? An Examination of Ethiopia's Decision to Join the WTO*, 43 J. WORLD TRADE. 2 (339), at 348 (2009).

trademark in Ethiopia will be able to protect and exploit his interests by the work of the above mentioned provisions of the Proclamation. Thus even though the trademark is not registered as per the rules of the proclamation, protection will be granted to an owner of a well-known trademark to the extent that he is a national or resident of a state party to a convention which Ethiopia has signed.<sup>95</sup>

To illustrate, consider a well-known trademark owned by some foreigner. When the above provisions are fully effective up on ratification of either the Paris Convention or the TRIPs agreement, another person who copies that mark cannot legally use it under the Rules of the Proclamation if it is confusingly similar to the well-known mark, because TRIPs presumes that Ethiopian consumers are likely to believe that the goods of the copier are connected with the owner of the well-known trademark. Consumers who ordinarily would not have purchased the copying mark owner's products will do so because they believe the copier's products are associated with the products bearing the well-known mark that they have read about in magazines or travel guidebooks, or seen in advertisements, on their favorite websites, or television programs. Ethiopian consumers might well enjoy the copier's product because they thought they were dealing with a branch of the well-known mark's owner, the case of services.

Other than the above, while this work does not attempt to provide a comprehensive commentary on the application of the Proclamation, it seems vital if one or two words are added to explain some important innovations incorporated under the Proclamation based on international standards. The first is the case of Article 23 sub-article 2 – which provides determination of well-known status based on knowledge of the trademark to be established *with in a relevant sector of the public*. This means, depending on the nature of the goods and services, the channels of distribution may differ considerably. Certain goods may be sold in supermarkets and are easily obtainable for consumers. Other goods are distributed through accredited dealers or through sales agents direct to a consumer's business or home. This would, for example, indicate that a survey among consumers who exclusively shop in supermarkets may not be a good indication for establishing the relevant sector of the public in

---

95. *Trademark Proc.*, Art. (1) a & b.

relation to a mark which is used exclusively on goods sold by mail order.<sup>96</sup> Thus, according to Article 23 Sub-Article 2, in order for a mark to be considered to be a well-known mark, it is sufficient that the mark is well known in at least one relevant sector of the public. It accordingly would not be necessary to apply a more stringent test such as, for example, that the mark be well known by the public at large. The reason for this is that marks are often used in relation to goods or services which are directed to certain sectors of the public such as, for example, customers belonging to a certain group of income, age or sex. An extensive definition of the sector of the public which should have knowledge of the mark would not further the purpose of international protection of well-known marks, i.e., to prohibit use or registration of such marks by unauthorized parties with the intention of either passing off their goods or services as those of the real owner of the mark, or selling the right to the owner of the well-known mark.<sup>97</sup>

It also seems that, in accordance with Article 6bis of the Paris Convention, the Proclamation, under Article 23(1) has provided protection for marks that are only well-known in Ethiopia; in the words of the Convention this is *the country in which protection is sought*. Thus, for a well-known trademark to be granted protection under the Proclamation, it is not sufficient that the mark be well known only in the country of origin or elsewhere, rather it must, in fact, also be well known in Ethiopia. Article 23 sub 2 of the Proclamation also seem to have taken Article 16 of the TRIPs Agreement in to consideration by adding another important element of the TRIPs agreement which protects well-known trademarks created *as a result of the promotion of the trademark and the knowledge gained as a result of promotions*.<sup>98</sup>

---

96. WIPO, *Draft Provisions on the Protection of Well-Known Marks, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications*, Second Session, First Part, Geneva, March 15 to 17, 1999.

97. *Id.*

98. According to Héctor A. Manoff, “This element is very important for those cases where advertising created good reputation, yet the product is not available. This kind of case is also very useful in analyzing trademarks that promote themselves sponsoring shows that are watched worldwide, or that have web pages on the Internet.” See Héctor A. Manoff, *Famous Trademarks in the Argentine Law, The McDonald case in South Africa and the*

In addition to this, it should be recognized that trademark protection traditionally was only possible where goods were of the same description. Where a mark was applied to different category of goods, there was frequently no remedy. New developments of trademark law regimes now contain significant changes. Similarly, in Ethiopia an owner of a well-known trademark can protect his mark against prejudices to come from non identical use of his well-known trademark. Under Article 7(2) the Registrar may consider whether an application for registration will have a detrimental effect on the reputation or distinctive character of a well-known mark, even if the application registration is for dissimilar goods. And obviously, under Article 26(4), a registered proprietor is now able to prevent the unauthorized use of his trade mark in relation to goods or services which are not similar to the proprietor's goods or services, provided the trade mark has a reputation in Ethiopia and that the unauthorized mark would take unfair advantage of or would be detrimental to the distinct character of the repute of the registered trademark. The extension in Article 26(4) would prevent, for instance, an imitation of a mark used for a soft drink being used on weed-killer and could protect trademarks from being extended or expanded into widely different products by deterring other traders from poaching existing goodwill.

Generally, contrary to the Territoriality Rule, which would argue that proof of registration should be unnecessary to underpin an infringement action involving a well-known mark, it is the reputation of a demonstrably well-known mark that is given protection under the Trademark Proclamation and thus reputation should be considered sufficient to create enforceable rights in a well-known foreign mark. Otherwise, foreign companies' successful marks are at risk of infringement in Ethiopia.<sup>99</sup> Accordingly, it is also worth noting that under the terms of Art. 6bis of the Paris Convention, marks that are well-known in a member country may be

---

*necessity to define "well-known trademarks"*, Vitale Manoff & Feilbogen, THE NAT'L L.J. (1996), at 5.

99. That is, under the working Trademark Proclamation, enforceable trademark rights arise from actual registration of the mark in Ethiopia under what is referred to as the Territoriality Rule. Thus, if a foreign company has yet to register its mark in Ethiopia, the Territoriality Rule can have the surprising and inequitable effect of precluding it from enforcing its mark against copycats in the Ethiopia, even when the foreign company's mark is well-known abroad and in Ethiopia. *See Trademark Proc.*

protected there even without use within its borders. Thus, under Ethiopia's obligations upon accession to the WTO or to the Paris Convention, Ethiopia would have to protect a mark that has been well-known in a member state of the Paris Convention, without requiring use in Ethiopia. Rights given to the well-known trademark owners by the Paris Convention, accordingly, will at least pre-empt Ethiopia's Trademark law. Therefore, we can see that the well-known mark doctrine, as indicated under Article 23 of the Trademark Proclamation, will provide protection to owners of well-known foreign marks from infringement in Ethiopia, despite the territoriality Rule. Under this doctrine, marks that are used and well-known abroad may be enforced in Ethiopia, even when they are not used in Ethiopia.

## VII. Analysis of the Current State of the Law

With a historical perspective on the protection of well-known marks in the greater context of the past development of the Trademark Proclamation, this section sketches the contours of what well-known mark protection in Ethiopia could be in the future. As Ethiopia continues its own search for the *rule of law* and as it strives to build a *market economy*, polishing the current Proclamation and the entire trademark protection system is unavoidable.

Under the current Trademark proclamation, certain well-known trademarks will receive protection in Ethiopia where some likelihood of confusion is found, even if the well-known mark and the copying mark are registered in different classes of goods/services. Art 26(2, a) in particular, in line with TRIPS Article 16(3) declares that the protection of well-known marks extends to goods or services that are different from those for which the trademarks are registered, as long as the use of the mark on those goods or services would indicate a connection with the owner of the registered trademark, and as long as the owner of the registered trademark would be damaged by use of the mark on those goods or services.

### A. Defining "Well-Known" Trademarks

As it has become apparent from the above discussions, ascertainment of the meaning of "well-known" trademarks is needed for legal certainty as

to when a trademark owner in Ethiopia can rely up on international agreements such as Article 6bis of the Paris Convention.

Yet ever since the time of the Paris Convention, this issue has been problematic. For starters Art 6bis does not provide a definition. TRIPS 16(2) however has given some basic guidance: “Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.” This has also been adopted by Ethiopia’s working Trademark Proclamation. Under the terms of the Proclamation, a well-known mark is a mark with “knowledge in the mark of the relevant sector of the public.” This definition requires more than simple name recognition. The test is whether Ethiopian consumers would associate the trademark with the goods and services for which the trademark is used outside Ethiopia.

However, the Trademark Proclamation does not provide any criterion or illustrative factors which will be helpful to define whether a mark is “well-known.” There is no clear definition of well-known trademarks under the Proclamation. Perhaps, a precise ascertainment of what protection is available for well-known marks will probably require a great deal of litigation in the coming years. Knowing the meaning of the term “well-known” in the context of trademark law is important to determine whether a foreign well-known mark that has not been used as a trademark in Ethiopia will be protected here.

In this context the most important question that should be raised is whether a trademark that is well known in a Ethiopia in the sense of Article 23(1) of Trademark Proclamation only relates to the *degree* that a trademark is well known in a Ethiopia or an important part thereof, or whether this concept also relates to a trademark that is (only) in-brief well known in a certain region and its surrounding area.<sup>100</sup> That is, the issues is whether the Proclamation to a workable extent has elaborated what the executive or adjudicators need to ascertain in terms of the ‘well known’ status of a certain trademark. So, the question is whether the word well known relates to the degree of deepness in knowledge of the well-known

---

100. For similar line of investigation, see Kennedy Van der Laan, *Where a Well-Known Trademark Should be Known*, A discussion of the “Nieto Nuno” judgment of the European Court of Justice (November 2007).

mark in the relevant sector or does it refer to the spatial (e.g., territorial or population wise) scope of the knowledge of the relevant trademark.

In addition to the above – while, TRIPs determines the grant of protection to well-known marks premises ‘knowledge of the trademark in the relevant sector of the public,’ and the reference to the relevant sector of the public requires States to accord protection even when the trademark is known only to a certain group of consumers, how the relevant sector of the public is to be defined, is a matter of national legislation.

In light of the possibility that the knowledge be obtained through the trademark’s promotion, we have discussed above that it is not necessary that the trademark is well-known to the consumers constituting the specific market for the product, but knowledge of an interested circle of experts could suffice. However, this proposition holds the risk of an uncalculated increase of well-known marks. Thus, implementing a relatively high standard regarding the criterion of knowledge of the trademark among the relevant sector therefore have been recommended for developing states like Ethiopia.<sup>101</sup> That is, as there is a risk that defining ‘well known’ in terms of the relevant sector of the public will lead to a proliferation of well-known marks, this risk should be addressed by imposing a relatively high standard regarding the degree of knowledge of the mark among the relevant sector, which possibly is in line with the scope of the relevant obligation under international law, in particular the TRIPs Agreement.<sup>102</sup>

Thus, generally the primarily challenge is a question of what criterions to consider when ascertaining the well-known status of a certain trademark? Under the international framework, some attempts have been made to further support the extended protection of well-known marks but without defining the concept. While, this work provides below a brief sketch of this development, it should be noted that most of the national laws dealing with the subject, rather opt to provide only some guideline factors which can be used as a test case in establishing the case for a ‘well-

---

101. For more on this, *see* RÜDIGER WOLFRUM AND PETER-TOBIAS STOLL, MAX PLANCK COMMENTARIES ON WORLD TRADE LAW, at 324 (Martinus Nijhoff Publishers, Leiden-Boston 2009).

102. UNCTAD/ICTSD, RESOURCE BOOK ON TRIPS AND DEVELOPMENT, at 240 (Cambridge University Press/The Edinburgh Building, Cambridge CB2 2RU, UK, 2005) (hereinafter RESOURCE BOOK ON TRIP).

known' status or its infringement.<sup>103</sup> At the outset, defining well-known trademarks and issues of protection related with this will be addressed within the international framework via examination of the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Intellectual Property Rights (TRIPS), and the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks of the World Intellectual Property Organization (WIPO).

In particular this work explores workable line of tests and references that should be adopted in the future with the aim of reform and implementation objectives. Primarily this work proposes an assessment of both quantitative and qualitative elements of knowledge of the relevant trademark in determining well-known status. In particular this work argues that assessment in this regard is well situated to internalize the above developmental challenges of setting the right balance between protecting a well-known trademark of foreign interest with that of domestic business.

### *1. Quantitative Vs qualitative determination*

As disused above, while determining whether a trademark is well-known in Ethiopia, regard will be given to the knowledge of the trademark in the relevant sector of the public, this rule does not determine whether reference is to be made to the quantitative geographical reach of this relevant sector or to the qualitative degree of information within the same category of population. Obviously, a mark cannot be considered well-known if it is not known to a certain extent in a specific territory. But the question is what degree of coverage should be established to conclude in positive of well-known status. Well, though jurisdictions and various adjudicative bodies within these (such as the European Court of Justice) have in general been reluctant in establishing any strict limits on percentages for well-known marks (and have strived towards a more qualitative approach), a growing academic and practical opinion in the legal doctrine is that well-known marks as referred to in Article 6bis

---

103. Tshimanga Kongolo, *Are Well-Known Marks Well Known in African Countries?*, 5 THE J. WORLD INTELL. PROP. 2, at 274 (2005).

require an establishment of a minimum 50% of the target group.<sup>104</sup> Advocates in this line have argued that:

“a strict limit on percentages is to be preferred to increase predictability for all market actors. With a strict limit, trademark owners may be assured that they enjoy an extended scope of protection for their mark, which will facilitate their strategic business decisions. According to Grundén, it is of importance that the protection for well-known marks is clearly limited and that the extended scope of protection is not given on an arbitrary basis. By using traditional market surveys, determining the level of establishment of a mark in a specific territory, resource-demanding processes before Court may also be avoided.”<sup>105</sup>

It also appears that this proposition had traditionally gained prominent acceptance in various jurisdictions. For instance, in Sweden, the Swedish Trademark Act requires a finding of 80-90% of the target group and about 20% finding among the general, which resulted in very few marks with the status of being well known.<sup>106</sup> In similar line, while examining whether it is sufficient that a mark is well known only in a part of a Member State, i.e. a city or a region, or if it is required that the mark is well known in the entire member state, in the *Chevy-case*, the European Court of Justice addressed also this question by declaring “...a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”<sup>107</sup> Meanwhile, what constitutes a substantial part of a Member State was not clarified by the ECJ in this case. But, it was underlined that cultural and language

---

104. Peter Ottosson, *Brand-napping:-Goodwill Protection for Well-known Trademarks*, University of Gutenberg, Graduate School Master of Science in Intellectual Capital Management, at 8 (Master Degree Project No.2010:12, 2010).

105. Tatham, *WIPO Resolution on Well-Known Marks: A Small Step or a Giant Leap?* <http://www.faqs.org/abstracts/Law/WIPO-resolution-on-well-known-marks-a-small-step-or-a-giant-leap.html> (last accessed Dec 2011).

106. Peter Ottosson, *supra* note 104, at 11.

107. ECJ, *General Motors Corp v Yplon Sa* [1999], Case C-375/97CMLR, 427, para. 28.

differences in a Member State must be taken into consideration.<sup>108</sup> In a similar matter, the ECJ issued a preliminary ruling in the *Spanish Fincas Tarragona* case, which further clarified the meaning of a mark being considered well known in a substantial part of a Member State. Here, the Court explained that the customary meaning of the expression “in a Member State”, as stated in the Directive, does not include a situation where “...the fact of being well known is limited to a city and to its surrounding area, which together do not constitute a substantial part of the Member State.”<sup>109</sup> In another case, *In Nuño v Franquet* (C-328/06), the ECJ addressed the issue of well-known trademarks in the context of Article 4(2)(d) of the Directive,<sup>110</sup> holding that the requirement is for the mark to be well known in a substantial part of the territory. Mere local reputation is not enough, but the mark does not need to be well known throughout the territory.<sup>111</sup>

On the other side of this proposition, advocates, which favor qualitative assessment over quantitative determination, argue that, “it is the image, goodwill and power of attraction of the used trademark that are in need of protection and it is therefore these qualitative factors that primarily must be considered in the assessment of a mark.”<sup>112</sup> These advocates thus have proclaimed that “the examination should be done from a qualitative rather than a quantitative perspective and it is not the percentage, but the actual damage in the specific case that should determine whether or not a trademark should enjoy an extended scope of protection.”<sup>113</sup>

---

108. Peter Ottosson, *supra* note 104.

109. *Id.*

110. *Nieto Nuno v Monlleo Franquet* (Case C-328/06), available at <http://lexisweb.co.uk/cases/2007/november/nieto-nuno-v-monlleo-franquet-case-c-32806> (last accessed Dec. 2011).

111. Clifford Chance, *Famous and Well-known Trademarks in EU law, Well-known and Famous Trademarks, Country correspondents*, WORLD TRAD. REV., January/February (2008), at 66.

112. Peter Ottosson, *supra* note 104, at 10.

113. *Id.*

## 2. *The case for Ethiopia*

Today, both quantitative and qualitative approaches seem to have earned credit on their own merit while new developments have shown that both methods of evaluation need to be adopted in determining well-known status of a certain trademark. For instance, in later dates it has been established that both quantitative and qualitative elements are to be considered in determining if a trademark qualifies for goodwill protection in the EU.<sup>114</sup> We can also find the interesting jurisprudences from trademark practice in South Africa, where in the highly talked-about case of *McDonalds Corporation v. Joburger*, the South African Supreme Court of Appeal held that the term “*well known*” should be tested by reference to whether “*sufficient persons know it well enough to entitle it protection against deception or confusion.*”<sup>115</sup> Thus, today, the growing understanding is that neither of the two approaches should be exclusively pursued.

It is within this context that the WIPO in its Resolution of 1999, which was adopted as a supplement for the interpretation of the Paris Convention and the TRIPs Agreement, has to some extent clarified the issue of how to define a well-known mark. In doing so, the WIPO Committee of Experts concluded that neither the quantitative approach based on percentages of the relative sector of the public, nor the qualitative approach, based on evaluating the value of the mark, was acceptable as the basis for the definition of a well-known mark.<sup>116</sup>

Thus, experience of the above systems explored in this work show that the complex process of determining whether or not a mark is well-known in Ethiopia under the words of the Proclamation should include assessment of both quantitative and qualitative elements. Primarily, the predominant opinion in the legal doctrine is that less quantitative knowledge about a mark could be compensated by other relevant conditions, such as if a mark is perceived as a highly qualitative mark or represents a high amount of goodwill for consumers in a specific territory.

---

114. *Id.* at 8.

115. *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd. and Another; McDonald's Corporation v Dax Prop CC and Another; McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd. and Another (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA); [1996] 4 All SA 1 (A); (27 August 1996), at 38, para. 1.*

116. Peter Ottosson, *supra* note 104, at 7.

Consequently, as the relevant obligations under the Paris Convention and the TRIPs Agreement are not detailed enough to cover every ground, it is possible that “well-known marks in one jurisdiction will not be found to be well-known in another”;<sup>117</sup> and thereby various jurisdictions have established guidelines in their legislation, which would assist their relevant state departments and adjudicators to reach at consistent determination. In particular, trademark legislations in U.S., under the Lanham Act,<sup>118</sup> Brazil, under the Industrial Property Code of Brazil,<sup>119</sup> and Canada, under the Canadian Trade-marks Act,<sup>120</sup> have established a workable line of guidelines in this regard. In addition, foreign trademark offices, including the Chinese and Japanese trademark offices, have also created criteria for determining well-known status.<sup>121</sup> Trademarks laws of countries such as Vietnam provide indicative definitions of the meaning of well-known trademarks. Apparently, all the above systems seem to have been influenced by the set of guidelines drawn up by the Standing Committee on the Law of Trade Marks of the World Intellectual Property Organization (WIPO).<sup>122</sup>

This work also proposes that further implementation instruments could easily adopt approaches of this instrument. In doing so, the instruments could easily incorporate the set of guidelines included under Article 2 of the WIPO guideline, which provides ‘factors for consideration’ to allow national authorities to draw up their own rules, and a somewhat convoluted ‘factors which shall not be required’. Although ‘any circumstances’ at all can be taken into account in determining whether or not a mark is well

---

117. Vasheharan Kanesarajah, *Protecting and Managing Well-known Trademarks*, Knowledge LINKSM NEWSLETTER from Thomson Scientific scientific.thomson.com/newsletter, 2007, at 3.

118. *See generally* The Lanham Trademark Act, 15 USC 22.

119. Intellectual Property 9.1 Industrial Property 9.1.1, <http://www.brazilian-consulate.org/secom/incs/TrademarksinBrazil.pdf>.

120. *See* Canadian Trademarks Act, R.S.C., ch. T-13, 1995; Amir H. Khoury, *Well-Known and Famous Trademarks in Israel: TRIPS from Manhattan to the Dawn of a New Millennium!*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 4, Article 2, Volume XII Book 4, at 1004 (2002).

121. *Id.*

122. This was adopted in the form of a Joint Recommendation by the Assembly of the Paris Union and the Assembly of WIPO at their meeting in September 1999.

known in any jurisdiction, six headings are listed for special consideration, viz.:

Article 2: Determination of Whether a Mark is a Well-Known Mark in a Member State

(1) [Factors for Consideration] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;

2. the duration, extent and geographical area of any use of the mark;

3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;

4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;

6. the value associated with the mark.

Meanwhile, it should be noted that none of the above are preconditions for the determination, and there is a bewildering array of possible combinations that are given approval. Article 2 Sub-article (c) of the recommendation states that;

The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In

some cases, all of the factors may be relevant. In other cases, some of the factors may be relevant. In still other cases, none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.

Thus this work argues that this WIPO jurisprudence can easily be adopted in Ethiopia forming a set of alternative reference point while determining the well-known status of a certain trademark. Interestingly, this seems to have been done in other jurisdictions of Europe, US and Asia. For instance, even though the WIPO Recommendation for the Protection of Well- Known Marks is a ‘soft-law’, i.e., a non-binding instrument, a number of states in Europe<sup>123</sup>, (such as Estonia, Bulgaria and Romania) – Asia, China<sup>124</sup> and US have provided in their national legislation particular criteria for recognizing a trademark as well-known similar to those established in the WIPO Recommendation.<sup>125</sup>

In way of conclusion, this work emphasizes two points. One, the recommendations will enable proper ascertainment of balance between quantitative and qualitative evaluations. As the Explanatory Notes to the Joint Recommendation state, “The duration, extent and geographical area of any use of the mark are highly relevant indicators as to the determination whether or not a mark is well known by the relevant sector of the public. Attention is drawn to Article 2 (3) (a) (i), providing that actual use of a mark in the State in which it is to be protected as a well-known mark cannot be required. However, use of the mark in neighboring territories, in territories in which the same language or languages are spoken, in territories which are covered by the same media (television or printed

---

123. Danguolė Klimkevičiūtė, *The Legal Protection of Well-Known Trademarks and Trademarks With a Reputation: The Trends of the Legal Regulation in the EU Member States*, Mykolo Romerio Universitetas, SOCIAL SCIENCES STUD. 3 (7) at 229-256 (2010).

124. China well-known Trademarks Regulation, [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=198928#LinkTarget\\_44](http://www.wipo.int/wipolex/en/text.jsp?file_id=198928#LinkTarget_44), ... (last accessed Dec. 2011) Also see Edward Eugene Lehman, Camilla Ojansivuy and Stan Abramsz, *Well-Known Trademark Protection in The People’s Republic of China—Evolution of the System*, 26 FORDHAM INT’L L.J. 2 (2002), Article 3.

125. Danguolė Klimkevičiūtė, *supra* note 123.

press) or in territories which have close trade relations may be relevant for establishing the knowledge of that mark in a given state.”

Second, while it is understandable that assessing the qualitative parameters of a mark in practice is a complicated process that includes determining a mark's capability to create associations, this guideline gives the right message to the relevant evaluator that traditional market surveys simply examining the level of quantitative reach cannot be used as indicators of a mark's quality and value. According to Ottosson, “market surveys must be adjusted to better fit the criterion ‘well-known’ before being used as an instrument in this process. By integrating a qualitative dimension into the market surveys they could constitute the basis for a more nuanced assessment. In practice market surveys should for example include questions on the kind of associations that a certain mark creates.”<sup>126</sup>

A wisely harmonized incorporation of the above recommendation in Ethiopia would achieve the above expectations.

### ***B. Scope of Protection***

It is to be noted that protection of well-known marks is a notorious issue for developing countries. The special protection of unregistered well-known marks does not favor local enterprises which carry on business in the same/other sectors. Although TRIPs prescribes that the knowledge of the trademark in the relevant sector of the public shall be taken into consideration, the issue is far from finding an adequate solution.<sup>127</sup>

One of the notoriety brought by trademark laws which guarantee protection for well-known trademarks has to do with protection given for trademark owners against dilution of their trademarks by unjustified interference of other parties.<sup>128</sup> For instance, the TRIPs Agreement provides under Article 16(3) that an owner of a well-known trademark can

---

126. Peter Ottosson, *supra* note 104, at 11.

127. Tshimanga kogolo, *Trademark protection under Congo's Industrial property Act and TRIPs Agreement*, 1998, available at [www.library.osaka-u.ac.jp/metadb/up/LIBOSIPPK/2-7\\_n.pdf](http://www.library.osaka-u.ac.jp/metadb/up/LIBOSIPPK/2-7_n.pdf) (last accessed Dec, 2011).

128. Elson Kasake, *Trade Mark Dilution: A comparative Analysis*, at 1 (Dissertation for Doctor of Laws, University of South Africa, March 2006).

stop any third party from any interference provided that the interests of the owner of the registered trademark are likely to be damaged by such use. Interestingly, this is a recent development of international trademark law influenced by Common law thinking. This is easily noticeable because, Articles 16.2 of TRIPS and 6*bis* of the Paris Convention do not contain such reference to the interests of the right holder, but focus was traditionally given to the likelihood of confusion of the public. In Ethiopia, the Trademark Proclamation, providing protection for well-known trademarks under Article 26(2) (a) & (b), follows similar line of thinking by establishing a regime, which protects the interest of the trademark owner by stating that the trademark owner may forbid any one from any use of a trademark or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests and; other similar acts. In other jurisdictions, this aspect of protecting the ‘interest’ of the trademark owner is called dilution law.<sup>129</sup>

Generally speaking, dilution may appear in two forms: *blurring* and *tarnishment*.<sup>130</sup> Blurring is the whittling away of a trademark’s uniqueness.<sup>131</sup> It occurs when other sellers, not necessarily of identical goods, use or modify the plaintiff’s trademark to identify their own goods.<sup>132</sup> For instance, the use of the famous marks “Toyota” for computers or ‘Marlboro’ for shoes can be simple examples. In these cases, there is no concern that the public will be confused. Primarily, there is no threat that, for instance, in the case of the use of *Toyota*, the mark used by the computer manufacturer would divert trade away from Toyota’s sales. Rather, such a use will lessen the power of the mark to identify a unique seller. The word “Toyota” would trigger an association of a car and a computer, depreciating the unique distinctiveness value of the mark and of its ability to kindle its primarily designated product.<sup>133</sup> The second form of dilution, that is tarnishment, occurs when the trademark is linked to

---

129. See US Trademark Dilution Revision Act of 2006.

130. For an extensive global overview on these see the International Trademark Association, Dilution Debate, *The Global Analysis of Dilution*, WORLDextra: INTA Supplement, (May 2008).

131. Elson Kaseke, *supra* note 128, at 44.

132. *Id.* at 45

133. Shahrar J. Dilbary, *supra* note 19, at 15.

products of inferior quality that is likely to cause disparaging thoughts about the trademark and its product.<sup>134</sup> Thus, the pirated use of the trademark replaces a positive association by a negative one.<sup>135</sup>

Thus, it seems that Ethiopia's Trademark Proclamation, under Article 26 (2b&c) and by the work of Article 26 sub article 4 and 23(2, b), protect the owner of well-known trademark against any activity which would affect or interfere with his trademark in manners "prejudicial to his interest." Accordingly, owners of a well-known trademark in Ethiopia will be granted protection from dilution under the Proclamation in accordance with the relevant international agreement which Ethiopia becomes party to.

Apparently, however, there is no international obligation which mandates states to grant dilution protection to the owners of *unregistered* well-known marks,<sup>136</sup> and understanding of this is very important under the Proclamation since, as it stands now, the Proclamation protects well-known trademarks only to the extent that protection is given under international agreements which Ethiopia has signed. Since Ethiopia has not signed any such agreement yet, for now we can only evaluate potential obligations under existing international agreements which Ethiopia has showed a readiness of becoming a member. Among these the typical case is that of the TRIPs agreement.<sup>137</sup> Accordingly, under Article 16.3, the TRIPs Agreement makes clear that its legal basis available for the protection of well-known marks on non-competing goods.<sup>138</sup> Although this is an

---

134. ILANAH SIMON FHIMA, *TRADE MARK DILUTION IN EUROPE AND THE UNITED STATES*, at 159 (Oxford University Press 2011).

135. Shaha J. Dilbary, *supra* note 19, at 15.

136. Ilanah Simon, "Dilution in the US, Europe, and beyond: international obligations and basic definitions", 1 J. INTEL. PROP. L. & PRAC. 6, at 407(2006). Instead, the obligation is limited to the provision of protection from confusion caused by later use both similar and dissimilar goods.

137. Ethiopia has shown this readiness already back in 1997. See WTO, *Request for Observer Status: Communication from Ethiopia* (WT/L/229, 10 Oct. 1997) and WTO, *Request for Extension of Observer Status: Communication from Ethiopia* (WT/L/445, 11 Jan. 2002).

138. The article states that: -16(3) 3. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the

improvement compared to Article 6bis of the Paris Convention, which only protected ‘identical’ or ‘similar’ goods, an obvious limitation in the former is that TRIPS requires registration of the well-known mark to be given protection against unauthorized use of non-competing goods.<sup>139</sup>

This means, while the Paris Convention and the TRIPs agreement clearly stipulates to the effect that well-known trademarks shall be protected without requiring registration or use in that country, this obligations only relates to protection that should be accorded under the heads of identical or similar goods that are likely to create confusion between consumers on the true identity of the use of a well-known trademark. This means the above obligation does not protect well-known trademarks against dilution to be created by the use of the well-known mark on dissimilar line of products and/or services, the effect of which is not to confuse consumers but only reduces future integrity and thus value of the trademark itself. Protection in the latter context is accorded under the TRIPs agreement if and only if the well-known trademark is registered in the territory of the member state.<sup>140</sup> Thus, it is within this line that has been stated that:

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an important advance, as it provides a legal basis for the protection of well-known marks on non-competing goods. Art 16(3) of TRIPS provides that Article 6bis of the Paris Convention will apply to goods and services that are not similar to those for which a well-known trademark is registered, provided that there is

---

owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.”

139. Héctor A. Manoff, *supra* note 98, at 5.

140. The Executive Committee of Barcelona, Sept 30 – Oct. 5, 1990 for instance has stated that “[t]he owner of such a mark should be able to prevent third parties from taking undue advantage of or causing detriment to the distinctive character or reputation of the mark. The scope of such protection may be dependent upon the nature of the mark and the degree of its reputation. Such protection may be made dependent on registration in the jurisdiction concerned.” <https://www.aippi.org/download/committees/100/RS100English.pdf> (last accessed Dec. 2011), at 2.

a connection between the respective goods and the interests of the well-known mark's owner are likely to be damaged.<sup>141</sup>

Thus, one can safely say that the Proclamation anticipates protecting well-known trademarks more than that is required under any of the international agreements which Ethiopia can potentially accede to. This is because the TRIPS Agreement protects well-known trademarks against dilution only to the extent that have already registered. It does not also set out the criteria to determine what trademark can be recognized as well-known trademark equally, and therefore, the members have to make national legislation about it respectively.<sup>142</sup>

It is also very interesting to notice whether the determination of well-known status under the above provision of the Proclamation is sufficient enough to warrant protection under the latter provision, which establish protection under the concept of dilution. In United States, which protects dilution under a separate set of legislation different from the trademark law, US Congress has declared, under the Federal Trademark Dilution Revision Act, the level of fame required is a much higher burden for a trademark holder to prove.<sup>143</sup> The holder must establish that its trademark is widely recognized by the general consuming public of the United States. "Trademarks with a level of fame recognized by the public only in a specialized segment or geographic place or region in the United States are not protected."<sup>144</sup> Accordingly, the law requires that the consuming public come from all different markets, sectors, and regions of the United States.<sup>145</sup> In European Union, some of the EU trademark law provisions refer to "well-known trademarks" in the sense that the term is used in Article 6*bis*, whereas others refer to "marks with a reputation". The

---

141. Ron Lehrman and Carlos Cucurella, *International Protection of Well-Known Marks*, THE INTERNATIONAL WHO'S WHO OF BUSINESS LAWYERS, at 806.

142. XIA Qing, *supra note 46*. at 9.

143. According to Paul Alan Levy "Because dilution law bars truthful speech, the cause of action *should* be hard to prove." See Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1196 (2006).

144. Xuan-Thao Nguyen, *Fame Law: Requiring Proof of National Fame in Trademark Law*, 33 CARDOZO L. REV. 1 at 99(2011).

145. *Id.* at 104.

legislation does not elaborate on the latter term, which is used in the provisions equivalent to Article 16(3) of the TRIPs Agreement. While it remains unclear whether there is a difference between the two terminologies, in at least one reported case (C-375/97, *General Motors Corporation v Yplon SA*), it was argued that for a mark to have a reputation under Article 5(2) of the directive, it did not need to be well known in the sense of Article 6bis of the Paris Convention,<sup>146</sup> but the European Court of Justice did not comment on this relationship. It did, however, provide guidance on what amounts to a ‘mark with a reputation’. To satisfy the requirement, the trademark must be known by a significant part of the public concerned in a substantial part of the relevant territory.

In the mean time, we can see that Article 26 (2, b&c) generally protect well-known trademarks more than that would be required of Ethiopia under the Paris Convention or the TRIPs Agreement. As this work has tried to show in the above paragraphs, Article 16.3 of the TRIPs Agreement “addresses a situation only in which a third party uses a well-known mark in connection with goods or services for which the mark holder is not well known.”<sup>147</sup> Hence, this work argues that, while Article 26 (2,b&c) of the Trademark Proclamation seems to have rightly adopted the obligation under Article 16(3) of TRIPs, it goes more to protect well-known marks than what would be required of it under the Agreement. Thus, the Proclamation seems to have forfeited great scope of local interest than what would be required of it to comply with upcoming international negotiations under the TRIPs Agreement. In doing so it apparently fails to set the right balance between protecting local interest and that of its obligations under international law by giving more than what is asked for. This work thus calls up on the legislature to either amend the relevant provision of the Proclamation or clarify this issue in an implementing Regulation.

---

<sup>146</sup> ECJ, *General Motors Corp v Yplon Sa* [1999], Case C-375/97CMLR, 427, Judgment of the Court, 14 September 1999. *General Motors Corporation v Yplon SA*, Reference for a preliminary ruling by *Tribunal de commerce de Tournai* – Belgium on Directive 89/104/EEC -Trademarks-Protection-Non-similar products or services-Trademark having a reputation, in the Case, C-375/97, available at [http://www.ippt.eu/files/1999/IPPT19990914\\_ECJ\\_Chevy.pdf](http://www.ippt.eu/files/1999/IPPT19990914_ECJ_Chevy.pdf) - last accessed Dec 2012), at 2.

<sup>147</sup> RESOURCE BOOK ON TRIPS, *supra note* 102, at 240-1241.

### *C. Determination of Well-Known Status: Effect on Latter Disputes*

In principle, a determination is made for each well-known trademark, and the effect thereof is defined on a case-by-case basis. Within this understanding various countries have clarified their intention under various instruments of their trademark legislation. For instance, in Japan, both when the patent office makes determinations of well-known trademarks in the course of the trademark examination procedure, objection procedure and invalidation proceedings, and when courts make determination of well-known trademarks in trademark disputes, the only focus is on the dispute settlement in question. In the majority of EU Member States also, protection of a well-known trademark is based on a case-by-case principle.<sup>148</sup> In this instance it is interesting to point out that the Trademark Regulation of some EU member states explicitly provides that “the recognition of a trade mark as being well-known shall not have any legal effect in later disputes.”<sup>149</sup>

In contrast, however, in France, court decisions where a trademark is recognized as well-known can be important evidence in other cases related to the same trademark.<sup>150</sup> Such decisions are binding on the French courts without any need for the mark owner to provide the evidence presented in the earlier decisions.<sup>151</sup> Of course, such earlier decisions must be recent enough to dispel any doubt as to the current well-known character of the mark.<sup>152</sup>

Between these lines we can also find jurisprudences which took perspectives from both approaches mentioned above. For instance, under China’s Trademark Law - the new regulations allow trademark owners to seek recognition of prior well-known status for each new dispute that arises in the future. However, the new regulations also suggest that recognition of well-known status in an earlier dispute will raise a strong but rebuttable

---

148. Danguolė Klimkevičiūtė, *supra* note 123, at 244.

149. *Id.*, for instance, this is the case in Estonia.

150. *Id.*

151. *Id.*

152. *Id.*

presumption of well-known status in a subsequent dispute.<sup>153</sup> Within this line, a determination of a well-known trademark is not only related to the solution of a particular case but also is significant to the extent to go beyond the case in at least two aspects. Firstly, it is significant in terms of business advertising; once a trademark is determined to be a well-known trademark in the administrative or judicial proceedings, the owner of the trademark can advocate in advertising that his/her trademark is a well-known trademark, thereby acquiring an advantage in the market. On the other hand, owners of trademarks without such determination cannot advertise their trademarks as well-known ones, regardless of how well-known in fact they are.<sup>154</sup>

Understandably, it should come with no surprise to note that Ethiopia's working Trademark proclamation is silent about this issue. Perhaps rules in this regard would only be introduced if need arises. Therefore, while this work does not propose any determination in line with any of the perspectives explored above, it does provide for an argument towards legislative ascertainment against any misconception that would arise in the future. In doing so, the legislature should choose the best alternative, between the various experiences explored above, which would take Ethiopia's pragmatic context into account.

#### ***D. The Procedure for Determining if a Trademark is a Well-Known or with a Reputation***

Similar to the above evaluation, a simple evaluation of the relevant rules of Ethiopia's Trademark Proclamation makes clear that the procedure for determining a trademark's well-known status is not clear. For instance, it is unclear under the Proclamation, whether it is possible to determine a trademark as a well-known *a priori*, or only in connection with disputes and oppositions to come later under the heads of an infringing trademark.

---

153 Regulations on Well-Known Trademarks, *The American Chamber of Commerce People's Republic of China*, <http://www.amcham-china.org.cn/amcham/show/content.php?Id=128&PHPSE> (last accessed Dec. 2012).

154. See generally Mingde Li, *Well-Known Trademark Protection: A Comparative Study between Japan and China*, IIP BULL. (2007).

At the outset, it seems that it possible only in connection with the latter case. That is which involved infringing trademark, determination to be made both by the Intellectual Property Office and the Court.

However, other states have provided well reasoned and detailed provisions in their national trademark laws regarding the procedure for determining if a trademark is well-known. Under the EU, Estonia Bulgaria, and to some extent Lithuania has clarified their intention within their trademark legislation.<sup>155</sup> The Bulgarian legislation addresses both the procedure for determination a mark as a well-known and a mark with a reputation. The law provides that a mark shall be determined as a well-known mark or mark with a reputation by Sofia City Court under the ordinary claim procedure and also by the Patent Office.<sup>156</sup>

Within this context, this work proposes that further implementing instruments to come under the Trademark Proclamation could learn from the above interesting experiences of few European states. In particular this work argues that *a priori* determination of well-known status will have its own efficiency advantages. For instance, if certain owner of a well-known trademark succeeds in getting a declaration of the well-known status of his trademark, this can assist him in preventing identical and confusingly similar trademarks from being registered for any goods or services which would grant him an ability to highlight well-known status and hence acts as a potential deterrent against infringers and counterfeiters. In addition, this determination will also allow him to shift the cumbersome and expensive burden of proving a well-known status of this trademark every time he brings an action against infringers.<sup>157</sup> Practically, this will also have an effect of increasing the value attributed to the trademark from a marketing perspective in addition to the direct effect on the owner which allows him

---

155. Danguolė Klimkevičiūtė, *supra* note 123.

156. *Id.*

157. Experience in other countries show, that under usual practice, an owner of a well-known trademark has to conduct a consumer survey to clearly establishing well-known status. Such surveys are complex and expensive to implement.

to use its trademark with greater legal and commercial certainty as the owner knows it has a valuable asset that can be enhanced and protected.<sup>158</sup>

Of course, the proposal in this heading could and should be accompanied by opposition procedures for third parties acting in good faith to oppose the determination of a mark on as a well-known mark.<sup>159</sup> A declaration of well-known status of a mark which has not been contested by third parties can also be made subject to challenge at any time by any interested party. In addition, the applicable scope of the well-known mark determination provisions could be limited to administrative agency actions so that they cannot be binding on courts. Thus, by giving them only an administrative power/nature, they could only serve as persuasive authority.<sup>160</sup>

Thus the attempt in this work is to show that regardless of their merits, these concrete alternatives bring forth a certain degree of certainty and predictability to potential well-known-mark applicants thus decreasing cost of litigation. As it has been stated at the outset, there is growing number of experiences in this regard proliferating everywhere. If this recommendation is also adopted in Ethiopia, the legislation in this line could take various experiences of other countries and tailor them to fit Ethiopia's practical economic context.

### VIII. Conclusion

Intellectual property protection, in particular the trademark regime, is now recognized for its key contribution towards developing a modern legal framework which facilitates international movement of businesses. For developing and least developed countries like Ethiopia the contribution of

---

158 *Thailand's Well-Known Trademark Registration Process*, available at <http://www.athertonlegal.com/publications/20-intellectual-property/41-thailand-well-known-trademark-registration-process.html> (last accessed Dec. 2011).

159. For perspectives in this regard, see *Model Law Guidelines: A Report on Consensus Points for Trademark Laws*, International Trademark Association, revised November, 2007.

160. Within this line, see generally Jing "Brad" Luo & Shubha Ghosh, "Protection and Enforcement of Well-Known Mark Rights in China: History, Theory and Future", NW. J. TECH. & INTELL. PROP., 2009.

this comes in terms of foreign direct investment. The purpose of this work is thus to investigate whether Ethiopia's newly overhauled trademark protection regime is mature enough up to the needs and expectations of current business developments. Generally, this work in the preceding sections has tried to show that the relevant section of the Trademark Proclamation protecting and governing well-known trademarks need to a certain extent be clarified, consolidated and supplemented by an implementing regulation based on existing international standards of protection for well-known marks under the Paris Convention and the Agreement on Trade-related Aspects of Intellectual Property Rights and soft law developed by WIPO. The evaluation in this work has shown that to attain the goals of uniformity, consistency and certainty, it is essential for the relevant authorities to introduce further implementation instruments which among others endorses urgent recommendations made in this work such as the relevant sectors of the public as proclaimed under Article 23(4) of the Proclamation shall include, but shall not necessarily be limited to: actual and/or potential consumers of the type of goods and/or services to which the mark applies, persons involved in channels of distribution of the type of goods and/or services to which the mark applies, business circles dealing with the type of goods and/or services to which the mark applies.

In addition, this work has exposed the need, under future reform efforts, for a set of guidelines with a list of factors clarifying a criterion for establishing the status of a well-known trademark. In doing so this work has made proposals for adopting the relevant experiences from the WIPO draft provisions which were adopted by the WIPO on September, 1999 as an attempt to provide a worldwide standard on how to implement the requirements under Article 6bis of the Paris Convention and Article 16 of TRIPs. More importantly, this work has tried to put in to question whether the right balance between protecting local interest and that of its obligations under international law has been set under the Trademark Proclamation. Accordingly, this work argues that, while Article 26 (2,b&c) of the Trademark Proclamation seems to have rightly adopted the obligation under Article 16(3) of TRIPs, it goes more to protect well-known marks than what would be required of it under the Agreement thus apparently giving more than what is asked for. Hence the Proclamation seems to have forfeited great scope of local interest than what would be required of it to comply with upcoming international negotiations under the TRIPs

Agreement. Therefore, future review effort on the Proclamation should give its heads up to this concern.

\* \* \*