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**Competition Law and Protection of Trade names and Trademarks in
Ethiopia: A case Study**

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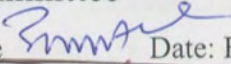
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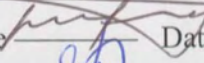
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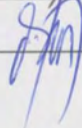
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I, the undersigned, declare that this thesis is my original work, and has not been presented for a degree in this and any other University, and that all source of materials used for the thesis have been fully acknowledged.

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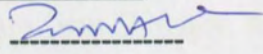
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List of Acronyms and abbreviations

ADLI	Agriculture-Development-Led Industrialization
Appellate Committee	Ethiopian Intellectual Property Office Appellate Committee
Appellate Tribunal Tribunal	Federal Trade Competition and Consumers Protection Authority Appellate Tribunal
Art/s.	Article/s
ASYCUDA	Automated System for Customs Data
Authority	Federal Trade Competition and Consumers Protection Authority
Cassation Division	Ethiopian Federal Supreme Court Cassation Division
Commission	Trade Practice Investigation Commission
CRLP	Commercial Registration and Licensing Proclamation No.980/2016
Cum.	Cumulative
ed.	edition/editor
EFY	Ethiopian Fiscal Year
EIPO	Ethiopian Intellectual Property Office
ERCA	Ethiopian Revenues and Customs Authority
EU	European Union
FDI	Foreign Direct Investment
FDRE	Federal Democratic Republic of Ethiopia
FTC	Federal Trade Commission (of the US)
FTCCPAT	Federal Trade Competition and Consumers' Protection Authority's Tribunal
GDP	Gross Domestic Product
GTP	Growth and Transformation Plan
ICC	International Chamber of Commerce
ICT	Information and Communication Technology
IDZs	Industrial Development Zones
INPI	Industrial Property Institute
IP	Intellectual Property
J. Eth.L	Journal of Ethiopian law
MoICT	Ministry of Information and Communication Technology
MOT	Ministry of Trade
MoTI	Ministry of Trade and Industry
Neg. Gaz	Negarit Gazette
OECD	Organization for Economic Cooperation and Development
P/pp.	Page/ pages
Para.	Paragraph
PASDEP	A plan for Accelerated and Sustained Development to End Poverty
PLC	Private Limited Company
S.C	Share Company
SIGTAS	Standard Integrated Government Tax Administration System

TCCPP	Trade Competition and Consumers Protection Proclamation No. 813/2013
TPRP	Trademark Protection and Registration Proclamation No.501/2006
TPRR	Trademark Protection and Registration Regulation No.273/2012
TRIPS Agreement	Agreement on Trade-Related Aspects of Intellectual Property
UNCTAD	United Nations Commission for Trade and Development
USAID	United Sate's Agency for International
Development	
Vs.	Versus
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

Abstract

This thesis examines the adequacy and compatibility of the legal frameworks governing trademarks, trade names and trade competition in Ethiopia. To this end, it employs tools of legal review and case analysis buttressed by qualitative data obtained from interviews, country experiences and case study. The thesis principally, scrutinizes the Trademark Registration and Protection Proclamation No.501/2006 that lacks a clear legislative stipulation for the recognition of earlier tradenames upon trademark registration. Although the law requires distinctiveness for the registrability of trademarks, the writer contends that this cannot adequately resolve priority conflicts between trade names and trademarks. There is no well-developed judicial jurisprudence rectifying the legislative loophole either. Furthermore, the registration of trademarks and trade names in different organs poses practical problems. A deadlock arises since the Ministry of Trade and the Ethiopian Intellectual Property Office have no mutually supportive search data bases during registration. In particular, the registration of a trademark in respect of class of services or goods which conflicts with a trade name of a business entity registered with similar activities to the goods or services, and vice versa provokes avalanche of tradename-trademark infringements and unfair competition suits.

The thesis also finds out significant lacunae on the competition, trade name, and trademark regimes which become stumbling blocks for successful enforcement actions out there.

So much so that, the present thesis proposes the articulation of priority and prevalence rules during the registration of tradenames and trademarks supplemented by institutional synchronization across trademarks, trade names and competition regimes. The legislature should adopt an eclectic line of jurisprudence from the benchmarked country experiences discussed in the paper. This exercise requires legislative amendment and institutional revitalization.

Table of Content

List of acronyms and abbreviations.....	i
Abstract	iii
CHAPTER ONE: INTRODUCTION.....	1
1.1 Background.....	1
1.2 Statement of the problem.....	2
1.3 Research Objectives.....	4
1.3.1 General Objective	4
1.3.2 Specific Objectives	4
1.4 Research Questions.....	5
1.5 Significance of the Research.....	5
1.6. Research Methodology and Methods.....	5
1.7 Limitation of the Study	6
1.8 Organization of the Paper.....	6
CHAPTER TWO: OVERVIEW OF THE COMPETITION REGIME IN ETHIOPIA	8
2.1 The Intersection among Trademark, Trade name and Competition Regimes	8
2.2 A brief account of International Treaties on Trademark and Trade name protection*	12
2.3 Background of Ethiopia's Economy	14
2.4 Locating Competition notions in various National Policies	15
2.5 Overview of Competition, Competition Law and Policy in Free Market Economy	17
2.6 Competition Law and Consumers' Protection.....	19
2.7 Overview of the Ethiopian Competition Regime.....	20
CHAPTER THREE: OVERVIEW OF THE ETHIOPIAN TRADE NAME AND TRADEMARK REGIMES IN LIGHT OF THE COMPETITION REGIME	24
3.1 Understanding Trade name, Trademark and Business name.....	24
3.1.1 Trade name.....	24
3.1.2 Trademark	25
3.1.3 Business Name.....	27
3.2 Methods of Protection, Protected Rights and Corresponding Limitations of Trade Names and TradeMarks	28

3.2.1 Methods of Protection.....	28
3.2.2 Overview of the Protected Rights and Corresponding Limitations	33
a. Rights	33
b. Limitations	36
3.3 Administration and Enforcement of Trade Competition, Trade name and Trademark Regimes	36
3.3.1 Administration and Enforcement of Trade Competition and tradename.....	36
a. Administration.....	36
3.3.2 Administration and Enforcement of Trademarks	39
a. Administration.....	39
b. Enforcement.....	43
3.4 The Protection of Well-known Trademarks and Competition law	48
3.5 Trade names, Trademarks protection and Distributorship Agreements vis-a-vis Competition Regime.....	50
3.6 Domain names, Trademarks and Competition Regimes.....	54
3.7 The Compatibility of the Trademark, Trade name, and Competition Regimes.....	56
CHAPTER FOUR: ANALYSIS OF CASES PERTAINING TO TRADE NAMES, TRADEMARKS AND COMPETITION IN ETHIOPIA	59
4.1 The Experience of Selected Countries' Trademarks and Tradenames Registration Systems	59
a. Mongolia	59
b. People's Republic of China	60
c. Austria	61
d. Brazil	62
4.2 Analysis of Cases on the Registration of Trade names and Trademarks in Ethiopia.....	62
CONCLUSION AND RECOMMENDATIONS.....	75
A. Conclusion	75
B. Recommendations	78
Bibliography	

CHAPTER ONE: INTRODUCTION*

1.1 Background

There is a greater global consensus on the desirability of competition and free markets today than at any time in the history of human economic behavior.¹ A number of countries across the world have adopted market economy systems, which allow free competition between industrial and commercial enterprises within certain limits defined by law.² From the beginning of the 1990s onward, the government of Ethiopia has embarked upon series of policy reforms that have substantial implications for market competition. Apart from the introduction of a mixed economic policy around 1990, the economic policy in Ethiopia was not based on the ideals of free market.³

As two different concepts in law, trademark distinguishes the origin of the goods or services whereas the trade name describes business entities. A trademark is part of the commercial equipment of a business and it is singularly effective weapon in the competitive struggle.⁴ The trade name of the defendant may create the impression that it is an entity affiliated with the origin of the goods and/or services of the plaintiff where the latter claims to be the owner of the competitive trademark.⁵ Conversely, a prior trade name owner may take the initiative to show that a conflict exists with the defendant's trademark.

As a caveat, synchronizing trademarks and trade names under the rubric of competition may overcome any eventual conflict of one against the other. The trademarks, trade names, and competition regimes should be demarcated clearly so as to grapple with burgeoning discords during administration and enforcement. In Ethiopia, numerous disputes have come up for the consideration of courts and administrative organs. This is evident from the plenty of administrative, judicial and Cassation decisions some of which have been analyzed in this paper. Without losing sight of the wide-ranging dimensions, the main thrust of this research is to investigate the normative and institutional frameworks connected to the registration,

*The writer has employed the Addis Ababa University, Faculty of law, 1965 Rules of citation by making limited references to other systems of citation for those rules which are not clearly provided for in the Booklet.

¹ Richard Whish, *Competition Law*, (6th ed., 2009), Oxford University Press, p.1

² WIPO, Intellectual property handbook, Policy, law and Use, publication no.489 (E), 2004, p 132 [Herein after, WIPO Intellectual property handbook]

³ Hailegabriel G. Feyissa, "EUROPEAN INFLUENCE ON ETHIOPIAN ANTITRUST REGIME: A Comparative and Functional Analysis of Some Problems", Mizan Law Review, Vol.3, No.2, (2009), p.1

⁴ RUDOLF CALLMANN, "Trademark infringement and Unfair competition: Law and Contemporary Problem," Cal. L. Rev., Vol. 42 No.77, (1954), p.188 [Here in after, RUDOLF CALMANN, Trademark infringement and Unfair competition]

⁵ *Id.* at p.191

administration and enforcement of trade names and trademarks that involve competition at the federal level.

1.2 Statement of the problem

Quite a good number of persons normally misconceive that by registering their trade name at the commercial registry, they are holders of a trademark right.⁶ Registration under the relevant trademark law, entitles business entities to prevent others from marketing identical or similar products under the same or a confusingly similar mark.⁷ Trade names distinguish one enterprise from others, quite independently of the goods or services that the enterprise markets or renders.⁸ Enterprises can register trade names as trademarks not only to distinguish themselves but also to distinguish the goods or services that they offer.⁹ As a result, a conflict arises when a trademark registered in respect of class of services or goods conflicts with a trade name registered for a business entity registered with similar activities to the services.¹⁰ In practice, two conflicting registrations are liable to occur due to the fact that trade names and trademarks are not linked, and the search data bases are not crosschecked on the side of registering authorities.¹¹ Since trade names and trademarks are members of the broader family of unfair competition law, the clash may further affect competition.

In Ethiopia, the culture of registering trademarks is not inculcated in the minds of the trademark and trade name owners.¹² The latter tend to be myopic by equating the legal and practical effects of trademarks, firm names, and trade names. A problem arises when a person who is already registered for a trade name purports to exclude a subsequent trademark registrant bearing similar or identical name, and the other way round.

Unlike other jurisdictions which have a priority rule of resolving trade name and trademark conflicts, the Ethiopian Trademark Protection and Registration Proclamation (Here after, the

⁶ WIPO, [Making a Mark: An Introduction to Trademarks for Small and Medium Sized Enterprises, WIPO publication Number 900 \(Available at \[www.wipo.int/e-Books\]\(http://www.wipo.int/e-Books\) shop\) \(Last accessed on March 24,2016\)](#) [Herein after, WIPO publication Number 900]. "Holder of a right" means the natural person who, or the legal entity which, according to the applicable law, is to be regarded as the beneficiary of the protection. See [Treaty on Intellectual Property in Respect of Integrated Circuits](#), Adopted at Washington, on May 26, 1989, Art.2(iii)

⁷ WIPO publication Number 900, cited above, note 6, at p.3

⁸ WIPO Intellectual property handbook, cited above, note 2, at p.96

⁹ Id. at p.97

¹⁰ HodaTaysir, ([Available at \[www.international-law-office.com/newsletter/intellectual-property/United Arab Emirates/intellectual property-Tamimi-company/Trademark vs. Trade names: An unresolved conflict\]\(http://www.international-law-office.com/newsletter/intellectual-property/United-Arab-Emirates/intellectual-property-Tamimi-company/Trademark-vs.-Trade-names:-An-unresolved-conflict\) \(Last accessed on November 23,2016\)](http://www.international-law-office.com/newsletter/intellectual-property/United-Arab-Emirates/intellectual-property-Tamimi-company/Trademark-vs.-Trade-names:-An-unresolved-conflict)) [Here after, HodaTaysir, Trademark vs. Trade names: An unresolved conflict]

¹¹ Ibid.

¹² Interview with Ato Abirdu Birhanu, Ethiopian Intellectual Property Office, Copy right and Community Knowledge Research and Registration Team Leader, Senior expert and member of Appellate Committee, March 27,2016

TPRP No. 501/2006) is silent on the matter. Art . 7(1), (4) of the TPRP recognizes the characteristic title of another person's protected literary, artistic rights or right to a photograph or design without stating anything as to the fate of earlier trade name owners.

In Ethiopia, the FDRE Ministry of Trade (here in after, the MOT) and the Ethiopian Intellectual Property Office (henceforth, the EIPO) are vested with the responsibility of administering and registering trade names and trademarks, respectively. Since such organs are autonomous and disparately coordinated, there have been inconsistent registrations. The EIPO grants with a trademark certificate to applicants by simply looking at the eligibility requirements provided for in the TPRP without considering priority rights over identical or similar trade names. The experts contend that in the course of registering trademarks, they own no extraneous responsibility to consider the Trade Competition and Consumers Protection, and Commercial Registration and Licensing laws.¹³ Good many of administrative and practical challenges surface under the circumstances where the EIPO grants a trademark certificate to an applicant while such trade name is already registered as a trade name of another by the Commercial Registration and Licensing Department. It is further submitted that the institutional and governance capacities on trademarks are outgrown by the reality.¹⁴

Competition law becomes at issue where the owners of trade name and trademark risk diametrically opposed and non-complacent protection mechanisms. Under such circumstances, it becomes hard pressing for trade name and trademark owners to go for the enforcement of their rights. Cognizant of this, the Federal Supreme Court Cassation Division(henceforth, the Cassation Division) has passed a decision which obliges the EIPO to grant trademark registration certificate by considering the purpose and spirit of the TPRP, trade names and fair trade practices as well as consumers protection laws of the country so that the decisions could be attuned to free market and consumers.¹⁵

There are also entities with exclusive or sole importation and distribution license invoking that they have got the benefit of a trademark protection and thereby seeking to ban the importation and distribution of products barely registered by them. The Ethiopian Revenues and Customs

¹³ Interview with Ato DerejeTsgu, Ethiopian Intellectual property Office, Trademarks and Industrial design registration Business Process, Senior Researcher, March 24, 2016. Interview with Ato Emsshaw Bekele, Ethiopian Intellectual Property Office, Trademark and Industrial Design Search and Examination, Senior expert, April 01,2016

¹⁴ See generally, Research Team, ICT-IPR Legal Framework Report: Incorporating Recommended IPR policies, Strategies, IPR laws and Regulations, Organization, Institutions and Implemetation,2015 [Here in after, ICT-IPR Legal Framework Report]

¹⁵ See for example, Ethio-Ceramic P.L.C Vs. EIPO and Ashoriga Technology Limited, (Federal Supreme Court Cassation Division, 2011, civil cassation Case No. 57179), in የ ፌዴራል ጠቅላይ ፍርድ ቤት ሰበር ሰማ. ችሎት ወላኔዎች ንቅጽ 12 የ አ.ፌ.ዲ.ሪ ጠቅላይ ፍርድ ቤት፣አዲስ አበባ፣ 2003፣ገጽ 544-548

Authority (henceforth, the ERCA) has been taking administrative and legal measures on the basis of such allegations and counterfeit imports.¹⁶ Even more, there is a confusion arising from the possibility of using the firm name as a trade name among the business communities.¹⁷

If traders compete on a level playing field, they will thrive, and consumers are more likely to pay the lowest possible prices, and get better quality and greater choices of quality and adequate supplies.¹⁸ Despite that, unwary consumers in Ethiopia have been victims of unfair competition, unethical service provision, unsafe food supply, dumping of non-standard and inferior quality; under or over weighing goods which are hazardous to life and property of the consumer.¹⁹ Unless some legal options are put in place, the registration of conflicting trademarks and trade names would end up in overlapped protection affecting fair competition.

1.3 Research Objectives

1.3.1 General Objective

The main objective of the research is to examine the adequacy and compatibility of the legal and institutional frameworks regulating trademarks, trade names and competition regimes in Ethiopia.

1.3.2 Specific Objectives

The study sets out the following specific objectives:

- i. To explain the legal demarcations and possible overlaps between trademarks and trade names within the framework of the competition law;
- ii. To examine the Ethiopian system of registration, administration and enforcement of trademarks and trade names;
- iii. To evaluate the compatibility of the trade name, trademark and competition regimes;
- iv. To examine the adequacy of the enforcement mechanisms pertaining to trademarks, trade names and competition laws, and

¹⁶ Interview with (confidential), Ethiopian Intellectual property Office, Trademark and Industrial designs registration and protection, March 24, 2016

¹⁷ ፈ.ቃ.ፍ. ጸ.ፕሮስ ገ/መስቀል፡ የኢትዮጵያ የኩባንያ ህግ፣ 2ኛ ዕትም (ተሻሻሎ የቀረበ) ፣ 2008 ዓ.ም, Far East Trading PLC, pp.22 (translation mine)

¹⁸ Herka Haroye, "Competition policies and laws: Major Concepts and an Overview of Ethiopian Trade Practice Law." Mizan Law Review, Vol.2 No.1, (2008), p. 5. See also Research Team: Review of the Legal and Institutional frame work for Market Competition in Ethiopia, (2009) ,p.8 and 24, Private Sector Development Hub/Addis Ababa Chamber of Commerce and Sectorial Associations,[Here in after, Team report ,Review of the legal and institutional framework for market competition in Ethiopia]; Alemayehu Fentaw, Ethiopian Unfair Competition law, Working Paper CCLP (L) 21, the University of Oxford, Centre for Competition Law and Policy,p.2[Here in after, Alemayehu Fentaw, Ethiopian Unfair Competition law]

¹⁹ Alemu Jote, Consumer protection Association and Industrial Development, work shop programs on the problems and prospects of consumer rights in Ethiopia, (2002) (unpublished), Addis Ababa, p.7

- v. To suggest the best possible alternatives for effective administration and enforcement of tradenames, trademarks and competition regimes.

1.4 Research Questions

The paper seeks to address the following research questions:

- i. What are the boundaries and interfaces among the trademark, trade name and competition regimes of Ethiopia?
- ii. What are the legal and institutional frameworks regulating the registration, administration and enforcement of trade names and trademarks?
- iii. How far are the trademark and trade name regimes of Ethiopia tuned to the prescriptions of the competition regime in force?
- iv. Are the enforcement mechanisms pertaining to trademarks, trade names and competition laws adequate?
- v. Are the competent bodies administering and enforcing trademarks and trade names in line with the tenets of the competition law? If not, what are the factors behind the pitfalls?

1.5 Significance of the Research

Since there is a dearth of literature on the theme, this research would create adumbrations towards the legal scholarship. It would provide with data for further empirical inquiries by putting alternative platforms and perspectives. It may contribute to a conceptual clarity by guiding the consumer's associations as well as enforcement personnel who tend to conflate trademarks and trade names. The findings would also advise law makers and the relevant authorities to develop better system of administration and enforcement on the areas under consideration.

1.6. Research Methodology and Methods

The study is essentially doctrinal wherein qualitative secondary and primary sources of information and data are employed to address the broad-based issues. Interviews have been conducted purposively with key persons in authority, private legal practitioners and senior experts from the EIPO, ERCA, MoT, Federal Trade Competition and Consumers' Protection Authority Tribunal (hence forth, FTCCPAT). The interviews are of un structured forms so as to freely elicit the relevant data therefrom.

With a view to demonstrating the interface among trademarks, trade names and competition laws, available and pertinent literature, laws, treatises, books, journals, excerpts, unpublished materials, databases, and reports of empirical data have been collected and reviewed.

The methods of the study involve tools of legal and case reviews as well as analyses. As for the legal analysis, the pertinent provisions of the TPRP No.501/2006 and its Regulation No.273/2012, Trade Competition and Consumers' Protection Authority Proclamation (here in after, TCCPP), No.813/2013, the Commercial Registration and Licensing Proclamation (herein after, the CRLP No.980/2016) and the Commercial Code along with some national policy documents have been consulted. Also, the provisions of the TRIPS Agreement, the Convention Establishing the World Intellectual Property Organization, the Trademark Law Treaty, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, Madrid Agreement Concerning the International Registration of Marks and the Protocol there to, the Paris Convention for the Protection of Industrial Property, Nairobi Treaty on the Protection of the Olympic Symbol, Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks and the Singapore Treaty on the Law of Trademarks have been referred to, where necessary.

In order to draw the interfaces of trademarks and trade names precisely, the researcher consulted four countries' line of jurisprudence having clear and inter operable system of trademark and trade name registration. Concerning the case analysis, cases decided by the EIPO and the Appellate Committee thereto, FTCCPAT, Federal High Court and Federal Supreme Court, Cassation Division and the prosecution Office have been considered. The cases are selected based on their authoritative relevance to the study.

1.7 Limitation of the Study

In the course of conducting this study, some of the key persons in authority, as promised in the methodology, could not be interviewed as they were not capable of being reached for various reasons. The researcher interviewed the senior experts on their behalf. The research could have benefited much from the authorities as they are closer to the policy directions. Despite the researcher's wish to consider the macroeconomic portion of tradenames and trademarks, there were no specific data addressing such components.

1.8 Organization of the Paper

The research covers a broad array of topics. The contents are organized into four chapters including the introductory part. The immediate chapter presents the interfaces among trademarks, trade names, and competition regimes along with a brief account of the international treaties

protecting trade names and trademarks. It then sets the stage for the Ethiopian policy rooms which anchor competition notions. It also sheds light on the basics of competition, competition law, and policy. Besides, the correlation of competition and consumers' protection regimes are discussed succinctly.

The third chapter is devoted to the understanding of the Ethiopian trademark and trade name regimes in light of the competition regime. At this cleavage, it introduces the methods of protection of trademarks and tradenames and the protected rights with the corresponding limitations. It also overviews the administration, and enforcement of trade competition, trade names and trademarks laws. It then highlights the nexus of well-known trademarks; trademarks, trade names and distributorship agreements and domain names along the lines of competition law followed by an appraisal of the compatibility of the Ethiopian trade name and trademark laws against the existing competition regime.

The fourth chapter assesses the system of trade name and trademark registration and protection in four selected countries followed by case studies in Ethiopia. The paper draws to a close by presenting its key findings in a piecemeal fashion. It eventually puts some remarks by way of recommendations.

CHAPTER TWO: OVER VIEW OF COMPETITION REGIME IN ETHIOPIA

2.1 The Intersection among Trademark, Trade name and Competition Regimes

By way of background, there was a perceived age-old conflict between encouraging free competition and expansive protection of monopolistic property rights.²⁰ There were tempestuous historical changes and developments towards characterizing the coexistence between competition law and the monopoly power created by trade mark regimes. This in turn, created irreconcilable tensions playing out in various levels of legal and jurisprudential analysis.²¹

The tensions are considerably captured by the competing theories of legal formalism and legal realism. The former views trademark protection as objectively anti-competitive. Its exponents argue that strong trademarks regimes coupled with persuasive brand advertising could lead to product differentiation by manipulating consumers' demand and creating high barriers to market entry by competition lacking market power.²² They advocate for using antitrust law to directly attack the use of trademarks. However, the latter theory propounds a more fact oriented consideration of policy issues for analyzing the competitive effects of trade mark protection.²³ Its supporters from Chicago School of economics proposed that antitrust law and policy should completely ignore claims of unlawful exclusion by trademark owners.²⁴

Under current thinking, especially since the early 1980s, the pro-competitive effect of trademarks is being triumphant. The pendulum is swinging back in favor of the protection and use of trademarks.²⁵ Trademarks safeguard the public against mistake, confusion, and deception by identifying the source or origin of particular products.²⁶

²⁰ Daniel M. Mc Culure, "Trademarks and Unfair Competition: A critical History of Legal Thought," Tm REP, vol. 69, No. 305, (1979,) p.1 [Here in after, Daniel M. Mc Culure, Trademarks and Unfair Competition: A critical History of Legal Thought]. In US, the tension between trademark protection and competition reached a breaking point in the 1970s with the filing of the **ReaLemon** case when the FTC granted compulsory royalty free licensing of the trademark ReaLemon.

²¹ Ibid. The extremities pertain to: access vs. protection; likelihood of confusion vs. generic/descriptive/suggestive/arbitrary trademarks; and utilitarianism vs. natural rights

²² Ibid.

²³ Ibid. Economic approach to the analysis of anticompetitive practices is particularly important not to categorically prohibit alleged anticompetitive practices whose competitive advantage, upon economic analysis, would be greater than the disadvantages. See Hailegabriel G. Feyissa, "EUROPEAN INFLUENCE ON ETHIOPIAN ANTITRUST REGIME, cited above, note 3, at p.12

²⁴ William E. Kovacic' (Commissioner US Federal Trade Commission) " At the intersection of antitrust and intellectual property law: looking both ways to avoid a collusion: The importance of history to the design of competition policy strategy: the Federal Trade Commission and Intellectual Property," Seattle University Law Review, v.3.0 No. 319. (2005), P.329 [Here in after, William E. Kovacic, the Intersection of antitrust and Intellectual property law]

²⁵ Daniel M. Mc Culure, Trademarks and Unfair Competition: A critical History of Legal Thought, cited above, note 20, at p.1

²⁶ Abebe Getachew, Trademarks the law and practice in Ethiopia, LL. B Thesis, (1997, unpublished, Library, Faculty of Law, Addis Ababa University), at p.44. Trademarks are part of consumer protection laws for they reduce

Such a paradigm shift invigorates perfect compatibility between the goals of trademarks and competition law. Both legal formalism and realism are converging towards a greater protection of trademarks.

Despite this, the growing role of competition tribunals has myriads of effects on intellectual property (here in after, IP) litigations. Competition agencies may afford an ostensible protection to IP owners. There are vital areas comprising the sensibility of existing substantive rules and remedies, adjustments in the activities of other government bodies that share authority with the competition agency, and developments that stem from the exercise of private rights of action.²⁷ Competition authorities may practically devote distant attention and resources to IP-related matters.²⁸

The degree to which the competition tribunals employ the full array of their distinctive mix of policy tools and human capital improves the quality of the litigations in the competition field.²⁹ Accordingly, a litigation limited exclusively to the prosecution and adjudication of antitrust cases hardly touches the broader group of regulatory bodies such as the trademark offices. A critical factor in avoiding commitment mismatches is a careful assessment of the agency's human capital.³⁰ The latter's contributions are needed to ensure that the IP system takes proper account of the value of competition as a stimulus for innovation.³¹ The competition tribunals' recourse to broad collection of litigation and non-litigation policy instruments reflects the recognition to large collection of institutions and adjudicators for passing sound judgments.³² In particular, competition oriented trademark litigations should consider the technicalities of IP. If the competition tribunals have limited capacity in the regime of IP, they may be competition-minded in a way that overlooks trademark protection.

The link between trademarks and competition laws is manifested in terms of the varied principles underlying trademark protection. At this juncture, the term trademark is defined as any sign or any combination of signs, capable of distinguishing the goods or services of one undertaking from

consumers' confusion and search costs by further preventing against passing off inferior quality products. Dr. Biruk Haile (Assistant Professor), Lecture on Advanced Issues in Intellectual Property Law, Addis Ababa University, School of Law, October, 2015

²⁷ William E. Kovacic "at the intersection of antitrust and intellectual property law, cited above, note 24, p. 337

²⁸ Id. at p. 329

²⁹ Ibid.

³⁰ Id. at p. 334

³¹ Id. at p. 343

³² Ibid.

those of other undertakings.³³ It is also defined as: A name, symbol, or device attached to goods for sale in the market so as to distinguish them from similar goods, and to identify them with particular traders as the owner of a particular business as being made worked or imported, selected, certified or sold by him or others.³⁴

The foregoing definitions recognize principles that mirror the core objectives of competition law. These may include: protecting business goodwill, promoting commercial morality, preventing consumer deception, and promoting free competition.³⁵ Trademarks indicate that all goods bearing the marks are of an equal level of quality and serve as prime instruments in advertising and selling of the goods.³⁶ Thus, the ultimate purpose of trade mark protection is to foster competition by preventing misleading uses of marks that may confuse consumers about the source, sponsorship, or affiliation of the products or services they buy.³⁷ This in turn, reduces consumers search costs, promotes market pace efficiency, and enables producers to reap the benefits of their investment in product quality and business goodwill, facilitating entry by new competitors and, hence providing an incentive to strive for quality.³⁸

There are various instances of unfair competition including trademark infringement; dilution of good will and trademarks; use of similar trade or firm names; false advertising; passing off goods for those of another.³⁹ These instances involve a common thread i.e., utilizing someone else's good will.⁴⁰ The law of unfair competition has its roots in the common law countries which treat technical trademark infringement as cause of action to unfair competition.⁴¹ More importantly, trademark law applies the doctrine of exhaustion to ensure that marks are available for use in sales and resale of second hand marked products.⁴² Competition between the legitimate parallel import of trademarked goods and goods placed on the domestic market by the trademark proprietor is

³³ The Agreement on Trade-Related Intellectual Property Rights, 1994 Art. 15.1, (Here in after, the TRIPS Agreement, 1994)

³⁴ Pattishal, Michigan Law Review, Vol.115, No.7, (2017), University of Michigan, p.335 (Available at <http://repository.law.umich.edu/mlr/> Last accessed on February 02, 2017)

³⁵ Daniel M. McClure, Trademarks and Unfair Competition: A critical History of Legal Thought, cited above, note 20, p.14

³⁶ Arthur R. Miller and R. Michael, Davis, *Intellectual property Patents, Trademarks and, Copy rights*, (1990), West blushing Company, p.237

³⁷ Margaret Barrett, "Finding Trademark Use: The historical foundations for limiting infringement liability to uses in the manner of a mark," Wake Forest Law Review, vol.43, (2009), University of California, p.895 [Herein after, Margaret Barrett, Finding Trademark Use]

³⁸ *Ibid.*

³⁹ Alemayehu Fentaw, Ethiopian Unfair Competition law, cited above, note 18, at p.6

⁴⁰ *Ibid.*

⁴¹ Margaret Barrett, Finding Trademark Use, cited above, note 37, at p. 895

⁴² *Ibid.*

realized through a doctrine of international trademark exhaustion.⁴³ Protection of trademarks extends only to nonfunctional marks which meet the requirement of distinctiveness to ensure that trademarks laws are not used to monopolize useful product and packaging features that patent and copy right laws relegate to the public domain.⁴⁴

Calibrating the interfaces among trade names, trademarks and competition laws becomes more essential in countries which adopt a legislative system of registration of trademarks and trade names. A conflict arises between trade names and trademarks partly because one who registers for a trade name to a business the name of which is identical with or confusingly similar to the merchandize mark of another may mislead the buyer that he is purchasing goods associated with the trademark.⁴⁵ It is widely recognized that a prior trademark is infringed if the use of the trade name is likely to create confusion as to the origin of the goods or services that the enterprise offers under its name.⁴⁶ The use of a trademark can in the same way infringe a prior trade name. As long as the trade names and trademarks are not linked, and the search data bases are not crosschecked, conflicting registrations are likely to occur in practice.⁴⁷

If the plaintiff's trademark is used as the defendant's trade name, there is actionable likelihood of confusion for trademark infringement despite the fact that the mark may be used as a merchandize mark by the plaintiff and as a trade name by the defendant.⁴⁸ As a result, the defendant may encroach upon the plaintiff's trademark and the later invokes a cause of action in the name of unfair competition. As will be better explained in chapter three, the Ethiopian trademark and trade name legislation offer no legal solution on the subject.

For the time being, suffices to say that both trade names and trademark regimes promote goodwill. Goodwill may not exist as a right in gross, or a mere abstract right having no reference to a particular business.⁴⁹ It is a property the elements of which it is made up is distinctly considered property.⁵⁰

⁴³ Frank Schechter, "The historical foundations of the law relating to trade-marks", Columbia Legal Studies, (2011), New York, p.186, (Available at <https://www.amazon.com/Historical-Foundations-Relating-Trade-mark>) (Last accessed September 02, 2016)

⁴⁴ Margaret Barrett, Finding Trademark Use, cited above, note 37

⁴⁵ *id.* p.97

⁴⁶ *ibid.*

⁴⁷ Hoda Taysir, Trademark vs. Trade names: An unresolved conflict, cited above, note 10

⁴⁸ RUDOLF CALLMANN, Trademark infringement and Unfair competition, cited above, note 4, p.192

⁴⁹ Grover C. Crimsore, "The assignment of Trademarks and Trade names," Michigan Law Review, vol.30, (1932), p. 492

⁵⁰ F. A Wright, "Tort Responsibility for destruction of Good will", Corner Law Quarterly, Vol.14, (1929), p.298 (Available at: <http://scholarship.law.cornell.edu/clr/vol14/iss3/4>. CORNELL LAW QUARTERLY) (Last accessed on June 20, 2016)

The Ethiopian Commercial Code approaches the term goodwill as a result of the creation and operation of a business and is of value which may vary according to the probable or possible relations between a trader and third parties who may acquire from him goods or services.⁵¹ Trademarks are treated as incorporeal elements of a business.⁵² Thus, they protect business goodwill.⁵³ Competition law protects the owners of trademarks and trade names against misappropriation of their goodwill.⁵⁴ Both unfair competition suit and statutory trademark infringement suits seek to protect good will.⁵⁵ If the plaintiff's competitors including those having similar trade names were permitted to refer to a trademark, the owner will be powerless to prevent it from being generic which may even involve dilution.⁵⁶

The law of unfair competition effectively supplements trademark and trade name proprietors where the later are not protected by the trademark and tradename regimes.⁵⁷ This can be related to the confusion-based liability theory. However, it is only that segment of the law of trademarks and tradenames, which refers to the discords between competitors in the context of the law of unfair competition.⁵⁸ In other words, competition is not relevant in all matters relating to trademarks and trade names. It confines it self to controlling confusing businesses and the presentation of indistinguishable rival products for consumers in the market.

2. 2 A Brief Account of International Treaties on Trademark and Trade name protection*

Although trademarks and trade names rights are regulated nationally, there are a number of international arrangements that recognize them. Amongst them, the Paris Industrial Property Convention concretizes trade names, trademarks and competition in a wider sense whilst

* It should be noted that Ethiopia is not a member to any of these international trademark and trade name treaties, hitherto. This being so, the discussions are meant to simply elucidate the international system of tradename and trademark protection.

⁵¹ Commercial Code of the Empire of Ethiopia, 1960, Art. 130, Proclamation No.166, Neg. Gaz year 19, no. 3. Both trade names and trademarks are 'elements of a business' which may be subject to franchising agreements, assignment, and contractual transfer. They become inextricably linked when they are jointly owned by the same person. See Commercial Code, Arts.127 (2), (a), (b), 139(1), 148(1), 152, and 171.

⁵² Id. Art. 127(2)(b)

⁵³ Yet, the definition of good will provided for in the Commercial Code (if it can be said to be a definition, at all), is flawed. It does not tell the nature or meaning of good will.

⁵⁴ See Admit Singh, Tulip Sunman and Thripura V, "Interfaces and synergies between Intellectual property rights and competition law in India: An Analysis," Journal of Intellectual property rights, Vol.20,(2015),(Available at [http://nopr.niscair.res.in/bitstream/123456789/31953/1/JIPR%2020\(4\)%20201-209](http://nopr.niscair.res.in/bitstream/123456789/31953/1/JIPR%2020(4)%20201-209) (Last accessed on December14,2016) .[Here after, Admit Singh, Tulip Suman and Thripura V, Interfaces and synergies between Intellectual rights and competition law]

⁵⁵ R. Reaves Elledge Jr., "Trade name Infringement as Unfair Competition" ,California Law Review, Vol. 40, Issue 4, (1953), p.106 (Available at <http://scholarship.law.berkeley.edu/california-law-review/vol40/issue4/5/Last-accessed-on-September-21,2016>)

⁵⁶ RUDOLF CALLMANN, Trademark infringement and Unfair competition cited above, note 4, at p.193

⁵⁷ WIPO Intellectual property handbook, cited above, note 2, at p.131

⁵⁸ See RUDOLF CALLMANN, Trademark infringement and Unfair competition cited above, note 4, at p.188

the rest treaties concern themselves with trademarks. The Paris Convention protects patents, trademarks, trade names, appellations of origin, and the repression of unfair competition.⁵⁹ It provides that a trade name shall be protected in all member countries without the obligation of filing or registration, whether or not it forms part of a trademark.⁶⁰ It allows members to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority as being already the mark of a person entitled to the benefits of the Convention and used for identical or similar goods.⁶¹ It prescribes that trademarks be neither denied registration nor invalidated except when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed.⁶² The Convention also obliges member countries to assure to nationals of such countries effective protection against unfair competition.⁶³ It prescribes that all goods unlawfully bearing a trademark or trade name be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.⁶⁴

Similarly, the Madrid Agreement states that in the absence of any special sanctions ensuring the repression of false or deceptive indications of source, the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable.⁶⁵ Again, The TRIPS Agreement states that member states may require, as a condition of registration, that signs be visually perceptible⁶⁶ and make registrability of trademarks depend on distinctiveness acquired through use and that signs be visually perceptible.⁶⁷ However, actual use of a trademark shall not be a condition for filing an application for registration.⁶⁸ Also, the Trademark Law Treaty

⁵⁹ **Paris Convention for the Protection of Industrial Property of March 20, 1883**, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979, Art.1 (2). In contrast, Art. 2(viii) of the **Convention Establishing the World Intellectual Property Organization, (1967), Stockholm, (Available at [www.wipo.int/treaties/en/convention/Vertaal deze pagina](http://www.wipo.int/treaties/en/convention/Vertaal%20deze%20pagina))**. The Convention treats trade names and trademarks in terms of "intellectual property" as the latter is widely crafted as to include the rights relating to trademarks, service marks, and commercial names and designations and protection against unfair competition, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

⁶⁰ Paris Convention for the Protection of Industrial Property, cited above, note 59, Art. 8. In a way, the Convention grants discretion upon member states to protect trade names and trademarks without the obligation of registration.

⁶¹ Id. Art. 6^{bis}. 1

⁶² Id. Article 6^{quinquies} 2.B. 1

⁶³ Id. Art.9(3)

⁶⁴ Id. Art.9(1)

⁶⁵ **Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods** of April 14, 1891 Act revised at Washington on June 2, 1911), at The Hague on November 6, 1925), at London on June 2, 1934, and at Lisbon on October 31, 1958, Art. 1(5)

⁶⁶ TRIPS Agreement, 1994, Art.16(1), cited above, note 36

⁶⁷ Id. Art.16(3)

⁶⁸ Id. Art.16(3)

recognizes marks consisting of visible signs.⁶⁹ The Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks.⁷⁰ Nor shall it apply to collective marks, certification marks and guarantee marks.⁷¹ Furthermore, the Singapore Treaty on the Law of Trademarks protects trademarks and service marks upon registration. This Treaty does not apply to collective marks, certification marks and guarantee marks.⁷² Again, the Madrid Agreement Concerning the International Registration of Marks⁷³ and the Protocol thereto state that trademark Protection is secured through International Registration.⁷⁴ According to the Protocol, the applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement.⁷⁵ The Nice Agreement requires the countries to which the Agreement applies adopt a common classification of goods and services for the purposes of the registration of marks.⁷⁶ The classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.⁷⁷ The fact that a term is included in the alphabetical list in no way affects any rights that might subsist in such a term.⁷⁸

2.3 Background of Ethiopia's Economy

The GDP at constant basic price for 2007 Ethiopian Fiscal Year is estimated to be 10.2%.⁷⁹ As per the estimates, annual growth rates of the major sectors, i.e. agriculture, industry and service were 6.4%, 21.7% and 10.2%; respectively. The shares of the major sectors, agriculture, industry and services out of the total GDP were about 39%, 15% and 46 %, respectively. The major

⁶⁹ Trademark Law Treaty of October 27, 1994, Art.2(1)(a), Geneva

⁷⁰ Id.Art.2(1)(b)

⁷¹ Id.Art.2(2)(b)

⁷² Singapore Treaty on the Law of Trademarks, Regulations under the Singapore Treaty on the Law of Trademarks and Resolution by the Diplomatic Conference Supplementary to the Singapore treaty on the law of Trademarks and the Regulations there under, Art.2(2), (b)

⁷³ Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967, and as amended on September 28, 1979, Art.5

⁷⁴ 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, Art.2

⁷⁵ Id. Art.3 (2). This provision also states that if the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification.

⁷⁶ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979, Art.1 Particularly, Art.1(2) of the Nice Agreement states that the Classification consists of a list of classes, together with, as the case may be, explanatory notes and an alphabetical list of goods and services with an indication of the class into which each of the goods or services falls.

⁷⁷ Id.Art.2(1)

⁷⁸ Id.Art.2(4)

⁷⁹ The Ethiopian Fiscal Year National Accounts Statistics GDP Estimates, Brief Note, (2007)

industrial classification shows that agriculture; industry and service industries have contributed 2.5 %, 3.0% and 4.7%, respectively. Over the last twelve consecutive years (i.e. during 1996-2007(EFY), the annual average growth rate of GDP was 10.8 %. In the Growth and Transformation Plan (GTP I) implementation period, the GDP annual average growth rate was 10.1%. Agriculture, industry and service sectors contribute 6.6%, 20.2%, and 10.8% annual average growth rates, respectively.

In the face of globalized competition and Ethiopia's future openness to the world trading arrangements, protecting the trade names and trademarks of major players is a critical interest to Ethiopia's investment and growth. Marketing people are generally fond of brand names that generate a positive association with the product in the mind of the consumer.⁸⁰ The Ethiopian economic performance reports do not foreshadow the percentage of trademark and trade names supporting trade. Nor are competition law and Policy considered during economic planning.⁸¹ In what follows, some of these economic policies that connote competition will be reviewed.

2.4 Locating Competition notions in various National Policies

To provide context for the discussion, Ethiopia recorded some success stories in aiding the transition to a free market system, trade liberalization, privatization of public enterprises and streamlining the bureaucracy.⁸² The incumbent government has formulated an economic development policy. It aspires to attain a higher growth trajectory by envisioning four fundamental goals: rapid and sustainable economic growth; equitable and broad-based mass beneficence, cutting-off the country's reliance on foreign aid; and creating an effective free market system.⁸³ The last goal is meant to enhance competition. At the heart of the economic policy of Ethiopia, agriculture is designed to be the engine of overall economic growth. This is envisaged in the Agriculture-Development-Led Industrialization (here in after, the ADLI).⁸⁴ The Strategy aims at intensifying marketable and exportable farm products by creating adequate markets so as to ensure the promotion of internationally competitive industry in the country.⁸⁵

⁸⁰ WIPO Intellectual property handbook, cited above, note 2, at p.72

⁸¹ Synchronizing competition law along the lines of fiscal, monetary and trade policies is important. Solomon Abay (Dr.), Theories and Principles of Economic Law, competition policy and law, lecture delivered at the School of Law, Addis Ababa University, 16 April, 2015

⁸² Gebremedhin Birega, Preliminary Country Paper on Ethiopia on competition regime: Building on competition policy in selected countries of Eastern and Southern Africa (7 up 3 projects), (2013), (Available at www.cuts-international.org/7up3/Ethiopia-final.doc, university of Warwick), (Last accessed on February 01,2017) p.2 [Here after, Gebremedhin Birega, Preliminary Country Paper on Ethiopia on competition regime]

⁸³ The Council of Ministers, FDRE Rural Agricultural Development Policies and Strategies, Official Amharic Text, 2002, p.10, (translation mine)

⁸⁴ Ibid.

⁸⁵ Gebremedhin Birega, Preliminary Country Paper on Ethiopia on competition regime, cited above, note 82, p.6

Currently, the EIPO is using collective trademarks as means of enhancing productions and commercialization of agricultural products.⁸⁶

Ethiopia has no independent investment and trade policies, so far. Rather, the investment law reflects the inbuilt policy. The law is fairly concerned with the promotion and enhancement of equitable distribution of investments among regions and benefit the society by ensuring competitiveness among investments made by investors.⁸⁷ The law also considers the establishment of the Industrial Development Zones (IDZs) as the latter creates enabling and competitive conditions to interrelate manufacturing sectors based on value creation and attract and expand investment.⁸⁸ This again encourages the level of competitiveness. Today, the private sector⁸⁹ in general and private investors in particular, are encouraged to invest in almost all areas of the economy.⁹⁰ Nevertheless, the private sector claims for not being allowed to engage in the efficient and profitable economic investment sectors.⁹¹ There is no a formal land market system in Ethiopia since land is constitutionally designed to be extra-commercium.⁹²

Ethiopia has also an Industrial policy that is derived from the Industrial Development Strategy. The later contains key principles.⁹³ The Policy recognizes market competition as a nuance towards effective resource allocation in the country and the value of competitiveness to the integration of

⁸⁶ Interview with Ato Emshaw Bekele, Ethiopian Intellectual Property Office, Search and Examination, Senior expert, April 01, 2016, cited above, note 13

⁸⁷ Investment proclamation, 2012, Preamble Para 3 and 6, Proclamation No.769/as amended by Proclamation No.894/2014/, Federal. Neg. Gaz. year 22, No.52, 20th February, 2012, Addis Ababa

⁸⁸ Id. preamble, para.6

⁸⁹ The term *private sector* is defined as: "The part of a nation's economy which is not directly controlled by the government and that functions through market processes; the forms in an economy owned by individuals or shareholders; All organizations in a jurisdiction or economy that are not controlled by the government including privately owned businesses and not-for-profit organizations. See Ramesh Kollis, Final report of The Study on the Determination of the Share of the private sector in Ethiopian GDP, www.ethiopianchamber.com/(2010), p.13

⁹⁰ Investment proclamation No.769/2012, cited above, note 89, Art.5(1)

⁹¹ There are some market structure issues affecting the competitiveness of the private sector. Besides, the state monopolizes the trade and service sectors by off-limiting foreign and private sector's participation. The participation of the private sector in the international trade would effectuate their competitiveness in the global competition in the long run.

⁹² Constitution of the Federal Democratic Republic of Ethiopia, 1995, Art. 40(3), proclamation No.1, Federal Neg. Gaz. Year1 No.1 [Here in after, the FDRE constitution, Proclamation No1/1995]. The overwhelming numbers of Ethiopians have no better capital than land, a liberalized land market would allow competitiveness through judicious state interventions there to.

⁹³ These principles include, recognizing the role that can be played by the private sector as an engine of industrial development; Following the direction of ADLI; Export-Led Industrialization, additional benefits of quality improvement; Focusing on labor-intensive industries; Using coordinated foreign and domestic investment; and Coordination between government and the private sector. See Research Team, Review of the Legal and Institutional Frame Work for Market Competition in Ethiopia, cited above, note 18

the economy into the international economic order.⁹⁴ To that effect, the policy is hinged upon diversified, highly productive market economy dominated by manufacturing and services beforehand. It foresees the formulation and implementation of strong sectoral policy to make the private sector accept and realize the principles of competition.

The GTPs are synchronized with the overall policy objectives of maintaining the previous growth momentum envisaged by the Sustainable Development and Poverty Reduction Program (PASDEP). During the GTPI period, research works have been undertaken to identify and ensure effective use of existing market opportunities.⁹⁵ Ethiopia is on the verge of acceding to the World Trade Organization (hence forth, WTO). Various activities have been undertaken to enable the country join the WTO.⁹⁶ The accession would create more liberal and competitive forum in the country. The GTP foresees trade partnerships and negotiation with selected market destinations to make the country create new market opportunities and increase FDI flow.⁹⁷ It does not specify the nature and design of the particular competition and trademark régimes, though.

2.5 Overview of Competition, Competition Law and Policy in Free Market Economy

At the heart of economic liberalism is an exceedingly broad doctrine which roughly refers to “the view that the best economic order is a free market”⁹⁸ thereby making competition a matter of necessity. Competition is an over-loaded concept which serves socio-economic and political goals.⁹⁹ It implies equal opportunities and complete freedom to benefit from its results, provided that the trader accrues the benefit in lawful competitive manner.¹⁰⁰ Economic competition is a relationship which takes place where the competitors sell similar products, in the same area, and

⁹⁴ FDRE Council of Ministers, Industrial Development Policy Official Amharic Document, (2002), Addis Ababa, Ministry of Information, at pp.189-194

⁹⁵ FDRE, GTP I, (2010/11-2014/15), Main text, p.1. See also generally, Ethiopia Building on Progress: A plan for Accelerated and Sustained Development to End Poverty, (2005/06-2009/10), Vol.1, Addis Ababa

⁹⁶ National Planning Commission, Addis Ababa, 2016, FDRE Growth and Transformation Plan II (2015/16-2019/20), Main text, at p.32

⁹⁷ FDRE, GTPII, Report, Ministry of Finance and Economic Development, Vol I, 2010, p. 32 Needless to say, a strict trademark regime which protects domestic brands would promote competition while a liberal trademark regime opens up more room for brand piracy and unfair competition.

⁹⁸ Maryanne Cline HOROWITZ (ed.), *New Dictionary of the History of Ideas*, Vol.3, (2005), p. 1267 [‘As quoted by, Alemayehu Fentaw, Ethiopian Unfair Competition law, cited above note 18, p.1

⁹⁹ Andrew Terry, “Unfair competition and the Misappropriation of the competitors’ trade values, *Mod.L. Rev.* Vol, 51, (1990), p.206 See also, Wudu Gashaw, the available legal remedies to unfair competition with special emphasis of Good will in Ethiopia, LL. B Thesis, (1999, unpublished, Library, Faculty of Law, Addis Ababa University), p23. For Wudu, a free market economy implies competition.

¹⁰⁰ Wex. S Malone, “Torts in Nut shell,” *Journal of Tort Law*, Vol. 52 No.13, U. TORONTO, (2002), pp. 349-350 (Available at https://www.law.yale.edu/system/files/documents/pdf/Faculty/Witt_Contingency), (Last accessed on February 04, 2017)

at the same time.¹⁰¹ Competition serves allocative, productive and dynamic efficiencies.¹⁰² Nonetheless, competition is not perfect owing to information asymmetry. Nor are competitors always rational decision makers. Moreover, every country, whatever its political alignment, has a general inclination against free play of competition.¹⁰³

In the broadest possible connotation, competition policy refers to governmental measures that directly affect the behavior of enterprises and the structure of industry and covers a whole raft of executive policies and even approaches.¹⁰⁴ In this sense, it includes economic policies that enhance competition in local and national markets and laws designed to regulate anti-competitive business practices by firms and unwarranted government intervention in the market.¹⁰⁵

On a specific plane, competition law is an instrument for enforcing competition policy.¹⁰⁶ It can be simply conceived as a set of rules governing the interaction of businesses with each other in the market place.¹⁰⁷ It is a tool designed to control anticompetitive practices and tendencies that might affect competition.¹⁰⁸ Competition law maintains and enhances market competition by addressing “restrictive business practices and regulate market structures that significantly lessen competition.”¹⁰⁹ There is also a more specific species of competition law, the law of unfair competition.¹¹⁰ The latter places limits on uncontrolled freedom of trade competition that

¹⁰¹ Alemayehu Fentaw, “Ethiopian Unfair Competition law,” cited above, note 18, p.7

¹⁰² Richard Whish, *Competition law*, cited above, note 1, p.18. For Richard, competition enhances consumer welfare and assists economic development. It also decentralizes decision-making; It facilitates economic restructuring; It increases innovation, technology change and economic efficiency.

¹⁰³ Mario Rotondi, “Competition in Europe”, *American Journal of comparative law A quarterly*, Vol.7, (1958,) p.328 (Available at

<https://www.google.com.et/#q=MarioRotondi%2C+Unfair+Competition+in+Europe%2C+American+Journal+of+comparative+law> (Last Accessed August 26,2016)

¹⁰⁴ *Challenges in Implementing a Competition Policy and Law: An Agenda for Action*, CUTS Centre for International Trade, Economics & Environment (Available at www.cuts-international.org/ccier_publications.htmVertaal deze pagina), (2002)

¹⁰⁵ *Competition Policy & Law Made Easy*, p.28 (Available at www.cuts.org/pdf/Competition_Policy_and_Law_Made_Easy.pdf (Last accessed on August 26,2016)

¹⁰⁶ Team report, Review of the legal and institutional framework for market competition in Ethiopia, cited above, note 14, p.18

¹⁰⁷ The world Bank and OECD, *a frame work for Design and Implementation of Competition law and Policy*, (1998), p.23 (‘As quoted by’, Muhammad Kebie, A critical Appraisal of the Institution Controlling Competition in Ethiopia: Analysis of the law and the practice, LL.M thesis, Addis Ababa University, Law faculty,2014). [un published, available at Addis Ababa University library], p.25

¹⁰⁸ This can be achieved by shaping business culture, correcting market failure and imperfection, and controlling market abuses. See Team Report, *Review of the legal and institutional framework for market competition in Ethiopia*, cited above, note 18, p. 14

¹⁰⁹ See generally Gebremedhin Birega, *Pulling Up Our Socks -A Study of competition regimes of Seven Developing Countries of Africa and Asia under the 7-Up Project*, CUTS Centre for Competition, Investment & Economic Regulation and DFID, (2003)

¹¹⁰ Team Report, Review of the legal and institutional framework for market competition in Ethiopia, cited above, note 18, p.21

cause an economic injury to another firm, through a deceptive or wrongful business practice.¹¹¹ The term unfair competition refers only to those actions that confuse consumers as to the source of the product, while “unfair trade practices”, comprises all other forms of unfair competition.¹¹² Speaking of scope wise, competition laws find themselves in all continents and in all types of economies.¹¹³ All commercial activities such as: actions, transactions, agreements and arrangements involving goods and services¹¹⁴ as well as both the public and private sector firms fall under the ambit of Competition law.¹¹⁵ Nonetheless, the activities of the state, local governments, and institutions acting with delegated government authority fall beyond the purview of competition law.¹¹⁶ The critical areas of interest in competition law and policy across jurisdictions can be categorized into four:¹¹⁷ (a) Anti-competitive agreements whether horizontal or, vertical; (b) Anti-competitive mergers, (c) Abuse of market dominance and (d) Anti-competitive unilateral actions. These will be highlighted on the Ethiopian context.

2.6 Competition Law and Consumers’ Protection

Both market competition and consumer protection exhibit comparable associations with the respective policies and laws.¹¹⁸ There is substantial overlap in the contents of competition and consumer protection regimes.¹¹⁹ The former seeks to rectify the behavioral and structural problems in order to ensure effective competition in the market. This in turn engenders higher economic efficiency, greater innovation, and consumers’ welfare.¹²⁰ Competition regimes regulate the supply side and the consumer protection regimes optimize the demand forces. By way of supplement, consumer protection policies such as information policies and prohibition of

¹¹¹ Ibid.

¹¹² Ibid.

¹¹³ Richard Whish, *Competition law*, cited above, note 1, p.16

¹¹⁴ Cassey Lee, Model Competition Laws: The World Bank-OECD and UNCTAD Approaches Compared, *Faculty of Economics & Administration*, (2004), University of Malaya, p. 5, p.17

¹¹⁵ Olivia Jensen, Contours of A National Competition Policy: A Development Perspective, *CUTS Centre for International Trade, Economics & Environment, Briefing Paper No. 2*, (2001), p. 3, cited above at Team Report, Review of the Legal and Institutional Framework for Market Competition in Ethiopia, note 18, (2009), p.17

¹¹⁶ Ibid.

¹¹⁷ Solomon Abay, Theories and Principles of Economic Law, competition policy and law, lecture, cited above, note 81. Yet, a review of existing competition laws across countries reduces the core operational concerns of competition law in to three namely: collusive agreements, control of monopoly power or a dominant position, and mergers and acquisitions. Compare with the Team Report cited above, note 83, at p.19

¹¹⁸ Team Report, Review of the legal and institutional framework for market competition in Ethiopia, cited above, note 18, p.24

¹¹⁹ Ibid.

¹²⁰ Jaju Kanjo, Recent Development of Consumer Laws in Korea, *APEC Information Paper* No.6, Korea, (2005), (‘As quoted by’, Tesema Elias, A Critical Analysis of the Enforcement Framework of Consumer Protection in Ethiopia: Challenges and Prospects, LL.M Thesis, (2011, Library, School of Law, Addis Ababa University) p.2

misleading or fraudulent advertising can enhance competitive processes.¹²¹ Consumers protection law is concerned with improving market conditions for effective exercise of consumer choice during making transactions.¹²²

However, the effectiveness of both laws is highly determined by the quality of enforcement frameworks.¹²³ The efficacy of antitrust regulations in meeting consumer welfare depends upon the scope of application, the relative specificity of the rules, and the room left to economic analysis of alleged violations.¹²⁴ Ethiopia had no a codified consumer protection law until the enactment of the Trade Practice and Consumers' Protection Proclamation No. 685/2010.¹²⁵

2.7 Overview of the Ethiopian Competition Regime

The history of Ethiopian competition law can be traced back to the 1960s when the Imperial government attempted to control competition, trademarks, trade names and other elements of business.¹²⁶ A separate legal regime governing trade competition was not full-born until the Trade Practice Proclamation No.329/2003 was enacted which was repealed by the Trade Practice and Consumers' Protection Proclamation No. 685/2010 as abrogated by the existing TCCPP No 813/2013. The skeleton of the TCCPP demonstrates that the legal framework virtually fits into the widely accepted principles of competition regime-abuse of market dominance, anti-competitive agreements, regulation of merger and unilateral anti-competitive actions.¹²⁷

¹²¹ Spencer Weber Waller, In Search of Economic Justice: "Considering Competition and Consumer Protection Law," *Chicago Law Journal*, Vol. 36, (2005), Loyola University p. 636. Indeed, consumer protection law helps consumers exercise that choice free of fraud, coercion, deception, or demonstrably false information.

¹²² Id. at p5

¹²³ Yasmine Afifi, "Independence of the Egyptian Competition Authority: Assessment and Recommendations", *Global Antitrust Review*, Vol.6, (2008) No. 34, 339-468

¹²⁴ Hailegabriel G. Feyissa, 'EUROPEAN INFLUENCE ON ETHIOPIAN ANTITRUST REGIME, cited above, note 3, at p.17

¹²⁵ Till then, the country had been using the conglomerates of various legal rules and institutions to protect consumers from deceptive, unfair and harmful business practices. For instance, the Commercial Code, cited above, note 51, deals with the Commercial registration, civil and penal sanctions for the failure to register, and the protection of third parties under Book I, Title-IV, and chapters two to four. There are also some protective schemes envisaged under the Civil Code like the legal requirements for the formation and invalidation of contracts in general and the special contracts-sales warranty and dispossession, tort.

¹²⁶ The scope of the unfair competition is dealt with Articles 132-134 of the commercial Code. The Code was followed by the issuance of the Unfair Trade Practice Decree which was in turn subsequently enacted as Unfair Trade Practice Proclamation. Meanwhile, the existing provisions were far from being adequate nor was an institutional mechanism put in place to enforce claims arising therefrom. There was no competition law and policy during the Dergue regime owing to the prevailing ideology and economic policy. Nor was an officially promulgated competition law in the Transitional Government than a tacit application of the Anti-unfair competition Provisions envisaged in the commercial Code. Recently, Ethiopia has taken steps toward opening several sectors of the economy to competition and to encourage and facilitate new entrants into those sectors.

¹²⁷ Trade Competition and consumer protection, 2013, Arts 5,7,9-13, proclamation No. 813, *Federal Neg.Gaz.*, Year 21, No.28 [Herein after, TCCPP No.2013/2013]

To begin with, the TCCPP forestalls abuse of market dominance and anti-competitive trade agreements.¹²⁸ The provision addressing abuse of market dominance states that: no business person, either by himself or acting together with others, may carry on commercial activity by openly or dubiously abusing the dominant position in the market.¹²⁹ The same provision provides some exemplary anti-competitive practices which may create a room for unduly restraining competition, having or being likely to have adverse effects on market competition.¹³⁰ The law also forbids an agreement between business persons in a vertical and horizontal relationship having the effect of preventing or significantly lessening competition unless a party to the agreement can prove any outweighing technological, efficiency or other pro-competitive gains and of the setting of minimum resale price.¹³¹ It further prohibits preventing, hoarding and diversion of goods from being sold in the regular channels of trade, or unauthorized distribution route.¹³²

Of the three Common institutional designs for consumers and competition Authority, i.e., partially Integrated/Single Authority Model, Integrated/hybrid Authority Model, and Separate Authority Model¹³³, the TCCPP seems to have adopted the integrated model. Accordingly, the Trade Competition and Consumers Protection Authority (here in after, the Authority) is vested with the implementation of consumers and traders' rights. Such a choice saves resources in poor countries such as Ethiopia.¹³⁴

The TCCPP also prescribes a variety of statutory enforcement options and remedies to prevent conducts that are harmful to competition.¹³⁵ These options uphold the ex-ante measures of fighting anti-competitive practices in smaller economies.¹³⁶ The law defines unfair competition in terms of any act that causes or, is likely to cause confusion, or in a manner contrary to honest commercial practice, or misleading the business interest of the competitor in particular as to the goods and services offered by the counterpart business person.¹³⁷ This is a catch-all provision. It provides

¹²⁸ Id. Arts. 5 and 7

¹²⁹ Id. Art. 5(1)

¹³⁰ Id. Art. 5(2)

¹³¹ Id. Art. 7(1), (2), (3), (c)

¹³² Id. Art. 5(2)(a)

¹³³ The three types of classifications are inferable from Kati Ceres, Institutional Design for the Enforcement of Competition Law and Consumer Protection Law, Amsterdam Centre for Law and Economics, University of Amsterdam, (Available at

[¹³⁴ Nevertheless, it should be seen to it that since the Authority is in charge of regulating two policies and laws, it would perpetuate the implementation gaps for the two laws.](http://www.institutional design for the enforcement of competition law and consumer law.mht and FTC International Activities: Competition and Consumer Protection Authorities Worldwide. (Available at http://www.ftc.gov) . (Last accessed on September 16, 2016)</u></p></div><div data-bbox=)

¹³⁵ Id. Art. 30(2), (6), (10), (11), (14) Cases in point are education, training, persuasion, advocacy and self-regulation.

¹³⁶ See Adhikari R. & Knight John M., "What Type of Competition Policy and Law Should a Developing Country Have?" *South Asia Economic Journal*, vol. 5, (2004), at pp. 14-15

¹³⁷ TCCPP No. 2013/2013, cited above, note 127, Art. 8

general standards and remedies to owners of trademarks and trade names where the trade name and trademark regimes are of no avail to the owners. The TCCPP obliges the Authority to establish cooperation and relationship with domestic and foreign institutions having similar objectives.¹³⁸ In that direction, the relevant domestic institutions may include the MoT and EIPO. Additionally, the law establishes and entrusts the Adjudicative Tribunal of the Authority with robust judicial powers as will be overviewed in chapter three.

The TCCPP dedicates provisions having the flavor of trademarks and trade names. It particularly, requires goods to be labeled with country of origin, material content, weight and other details affecting the consumers.¹³⁹ The disclosure of such accurate information enhances competition by further helping consumers shop and compares goods.¹⁴⁰ It generally regulates commercial advertisements where in quality marks, trademarks and emblem are required to be indicated therein.¹⁴¹ It also requires any business person to display his trade name at an overt place.¹⁴²

The TCCPP devotes about 13 exclusive provisions for the protection of consumers coupled with basic frameworks encapsulated in the general, administrative and enforcement parts. One may argue that the normative contents of the TCCPP gravitates to consumers' protection. Nonetheless, a closer look at the objectives, substantive provisions and structural arrangement of the proclamation signifies the balanced treatment afforded to both consumers and of the business communities.¹⁴³ The TCCPP espouses many disparate goals, though.¹⁴⁴

¹³⁸ Id. Art.30 (14)

¹³⁹ Id. Art. 16

¹⁴⁰ Research team, Ethiopia, A commercial law & Institutional reform and trade diagnostic, (2007), USAID, p.62 [Here in after, A commercial law & Institutional reform and trade diagnostic]

¹⁴¹ TCCPP No.813/2013, cited above, note 127, Article, 18 cum.19

¹⁴² Id. Art. 18(1). The TCCPP applies to trade names in a broader sense owing to the absence of self-executive provisions in respect of trade name rights.

¹⁴³ Interview with Ato Henok Tafesse, Trade competition and Consumers Protection Authority, Adjudicative Tribunal, presiding Judge, July 12, 2016. Henok goes without saying that a closer look at the entirety of the preambular paragraphs of the TCCPP No.813/2013 and Articles 5, 7, 8 in conjunction with 13-26, 42-43 of same, corroborate this line of argument. In fact, it should be noted that competition law is not invariably tailored towards consumers' welfare for there might be situations of market imperfections and failures tripled with inconsistent policy considerations favoring lesser competition to protect consumers. See Research Team: Review of the Legal and Institutional Framework for Market Competition in Ethiopia, cited above, note 18, p.14

¹⁴⁴ Research team, a commercial law & Institutional reform and trade diagnostic, cited above, note 140, p. 58 In Ethiopia, the TCCPP seems to exclude certain firms and economic sectors from its scope of application. As a rule, the proclamation applies to all persons involved in any commercial activity. Exceptionally, the inapplicability of the law may, on a case by case basis, be considered for enterprises having significant impact on development and designed by the state to speed up economic development; and (3) basic goods and services that are susceptible to price regulation. It further regulates unfair and deceptive conducts between individual competitors; See Arts.4(2) cum. 25(1) of the TCCPPP

It also grants the state broad powers to exempt many consumer goods from competition.¹⁴⁵ This obviates enforcement from the overwhelming anti-competitive conduct and wastes resources. Recent empirical findings show that the intervention of MoT in the market in the form of price regulation of basic goods and services lacked proper pre-intervention study in terms of prioritization, determination, and application.¹⁴⁶ A conflict of interest would crop up where the MoT urges market stability whilst the Authority attempts to protect the individual rights. The law also allows vague terminologies like efficiency, technological or pro-competitive gains for invoking the exceptions pertaining to vertical and horizontal agreements which are as good as overruling the principle.¹⁴⁷ If the exceptions were meant to guarantee low prices for certain basic and essential consumer goods, this could be achieved by funding directly the consumers or introducing, when necessary, price controls.¹⁴⁸ Economists argue that trade should be driven by the forces of market demand and supply than price controls.¹⁴⁹

Apart from this, the doctrine of unfair dealing as applied for non-competitors, is not adequately recognized under the competition law.¹⁵⁰ Besides, the law does not incorporate a mandatory provision allowing the private-public mix of the Authority. This may in turn pose problems in the course of enforcing the proclamation and further affect the interest of the business communities and consumers.¹⁵¹ Although the TCCPP recognizes the Regional Trade Bureaus to establish Consumers Protection Judicial organs and Appellate Tribunals,¹⁵² it does not recognize the power to issue regulations thereof. The power of the Prime Minister to appoint a Director General and Judges of the Authority would adversely erode the Authority's independence.¹⁵³

¹⁴⁵ TCCPP No.813/2013, cited above, note 127, Article 4(2), 2(8)

¹⁴⁶ Tessema Elias, A Critical Analysis of the Enforcement Framework of Consumer Protection in Ethiopia, abstract, cited above, note 120, p.63

¹⁴⁷ TCCPP No.813/2013, Article 7(2), cited above, note 127

¹⁴⁸ Gebremedhin Birega, Preliminary Country Paper on Ethiopia on competition regime, cited above, note 82, p.12

¹⁴⁹ See Seid Hassan, "The Futility and Damaging Effects of Ethiopian Price Caps", Economic Journal, Vol 5, (2004), Murray State University, at pp.14- 15, (Available at <http://www.ethiopia.org> (Last visited on september16, 2016))

¹⁵⁰ This is discernible from the scope of the provision devoted for unfair competition which opens up with: "No business person may in the course of trade, carry out any act which is dishonest, misleading or deceptive, harms or is likely to harm the business interest of a competitor". See TCCPP No.813/2013, Art 8. On top of that, the provision dealing with criminal liabilities devotes only two sub- articles to hold 'any person' responsible for the anti-competitive act whilst the remaining sub -articles are phrased as to refer any business person which out rightly excludes the actual and potential liabilities of non-business persons that would jeopardize the business interest of a non-competitor. See Id. Art.43

¹⁵¹ Tessema Elias, A Critical Analysis of the Enforcement Framework of Consumer Protection in Ethiopia, abstract, cited above, note 120, cited above, at p.60

¹⁵² TCCPP No.813/2013, cited above, note 127, Art. 34

¹⁵³ Id Art. 35(1)

CHAPTER THREE: OVERVIEW OF THE ETHIOPIAN TRADE NAME AND TRADEMARK REGIMES IN LIGHT OF THE COMPETITION REGIME

3.1 Understanding Trade name, Trademark and Business name

3.1.1 Trade name

A trade name distinguishes one enterprise from others, quite independently of the goods or services that the enterprise markets or renders.¹⁵⁴ It is the name a person uses for advertising and sales purposes within a specific business category.¹⁵⁵ In Ethiopia, trade names are regulated by the CRLP¹⁵⁶ and the Commercial Code. The latter defines 'trade name' as a name under which a person operates his business and which clearly designates the business.¹⁵⁷ Hence, trade name signifies the various activities carried out by the business person. All the same, the CRLP defines it as a name that a given business person uses for his business or known by the society as such.¹⁵⁸

Should a business person adopt a trade name that is identical or very similar to that of a competitor, there may be a potentiality for consumers to be confused. A similarly-named competitor may confuse customers and cause the plaintiff to lose control of its own reputation. In consequence, the CRLP requires the registration of a trade name of a sole proprietor in his first name followed by his family name by further prescribing the use of a different identification in respect of already registered trade names.¹⁵⁹ The trade name appears on a separate certificate of the business license specifying the commercial sector of engagement.¹⁶⁰ It is issued after the commercial registration and business license.¹⁶¹

A trade name can take either personal or family name or assumed names. An assumed name can take after a particular place, the name of a thing, arbitrary and fanciful words.¹⁶² On the other hand, a personal or family name signifies his personality according to his individual ideals and

¹⁵⁴ WIPO Intellectual property handbook, cited above, note 2, at p.96

¹⁵⁵ Stephen Yoon, Understanding trademarks, key differences between legal name, trade name and trademarks available at www.invention-protection.com/intellectualpropertypublication_documents/legal_name_trade_name_trademark_2010 (last Accessed on November 22, 2016) [Here in after, Stephen Yoon, key differences between legal name, trade name and trademarks]

¹⁵⁶ Commercial Registration and Licensing Proclamation, 2016, proclamation No.980, Federal Neg. Gaz. Year 22, No.101 [Here in after, Commercial Registration and Licensing Proclamation CRLP No.980/2016]

¹⁵⁷ Commercial Code, Article 135(1), cited above, note 51. See also CRLP No.980/2016, cited above, and note 156, Arts. 4(10),15,16

¹⁵⁸ CRLP No. 980/2016, cited above, note 156, Art. 2(10)

¹⁵⁹ Id. Art.14(1)

¹⁶⁰ Id. Arts.15(5) cum 14(2) -(3)

¹⁶¹ Id. Arts.15(5),18(1), (c)

¹⁶² Milton Handler and Charles Pickett, "Trademarks and Trade names-An analysis and synthesis ", Columbia Law Review, Vol.30, (1930), p.199

philosophy of life and the attainment of materialistic success.¹⁶³ In this regard, the First Clause of the US constitution allows the right of a man to use his fortunate name to capitalize upon his own business. It is deemed to be part of the natural and inalienable rights without which the right to acquire, possess and protect property would be of little worth.¹⁶⁴ It has been considered as the exercise of a sacred and legal right albeit the naked fact that another similarly named is already so engaged under his name. Even though such a use would prove detrimental to a previously established business, it is allowed to cater free competition. This is tolerable so far as there is no palpable fraud characterizing the defendant's use of his own name in a particular business. Besides, there are competing theories which surmise the propriety of devoting personal or family names for the purpose of trade names, though.¹⁶⁵

Conversely, the use of one's own name in business cannot justify to be used by a corporate or partnership name of which an individual's name is a part.¹⁶⁶ Such a prohibition might prevent unfair competition as there is no commercial necessity to justify the adoption of the name of an individual.

In Ethiopia, the Commercial Code recognizes the use of the personal and assumed names as trade names.¹⁶⁷ It explicitly states that the trade name may be the trader's family name, with or without his surname provided the use of such name is honest and fair one.¹⁶⁸ The last proviso - 'honest and fair one,' takes account of fair competition in choosing trade names.

3.1.2 Trademark

In the current Ethiopian legal system, trademarks are regulated by the TPRP No.501/2006¹⁶⁹ and the Regulation No.273/2012.¹⁷⁰ The EIPO Proclamation defines trademark in terms of any sign or combination of signs capable of distinguishing goods or services from similar goods or services.¹⁷¹ However, the TPRP defines it as any visible sign capable of distinguishing goods or services of one person from those of other persons including words, goods or their packaging, or the

¹⁶³ William Forrester, "Trade Regulation: Right to use one's own name", Tulane Law Review, Vol.41, (1967), P.173

¹⁶⁴ RUDOLF CALLMANN, Trademark infringement and Unfair Competition, cited above, note 4, p. 197

¹⁶⁵ Tesfaye Degefa, Protection of Trade names under Ethiopian Law, Addis Ababa University, School of law, LL. B Thesis, (1998, unpublished, Library, Faculty of Law, Addis Ababa University) p.35

¹⁶⁶ RUDOLF CALL MANN, Trademark infringement and Unfair competition, cited above, note 4

¹⁶⁷ Commercial Code, cited above, note 51, Art. 136

¹⁶⁸ Id. Art. 137(1)

¹⁶⁹ Trademark Registration and Protection Proclamation, 2006, Proclamation No.501 Fed.Neg. Gaz., 12th year, No 37, 7th July, 2006 [Herein after, TPRP NO.501/2006]

¹⁷⁰ Trademark Registration and Protection Regulation, 2012, Council of Ministers Regulation No. 273, Art. 2(6), Fed.Neg.Gaz. 19th year, No. 10 [Here in after, the TRPR no.273/2012]

¹⁷¹ Ethiopian Intellectual property Office Establishment Proclamation, 2003, Article 2(3) Proc. No .320, Fed.Neg. Gaz., 9th year, No 40, 8th April, 2003

combinations thereof.¹⁷² Apparently, the former defines trademark liberally to encompass any signs whereas the latter sets aside other signs such as sounds and scene. In fact, the discrepancy does not pose substantial problems as long as one can make use of the rules of interpretation. For constituting a trademark, the subject-matter of any application must satisfy three conditions:¹⁷³ Firstly, it should be a sign. Secondly, the sign needs to be capable of being represented graphically. Thirdly, the sign must be able to distinguish the goods or services of one undertaking from those of other undertakings. Here, the nature of the goods or services to which a trademark applies

shall in no case form an obstacle to registration of the trademark.¹⁷⁴ Although the ownership of trademarks may yield exclusive rights, they are valueless and meaningless in a vacuum. In other words, trademarks must specify the individuality of the goods in connection with which they are found.

There are also related terms such as service marks, collective trademarks, certification marks and appellation of origin. A collective trade mark is any visible sign which serves to distinguish any other common characteristic of goods and services of different enterprises which use the mark under the control of the registered owner.¹⁷⁵ Hence, collective trademarks distinguish the origin of the common characteristics of goods and services of different enterprises.¹⁷⁶ An appellation of origin has been conceived as the geographical name of a country, region or locality which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.¹⁷⁷ A certification mark guarantees a characteristic of the product.

Unlike trade names under which a particular business entity operates the business and presents the products to the consumers, trademarks are employed for product differentiation.¹⁷⁸

¹⁷² TPRP No.501/2006, cited above, note 169, Art.2(12)

¹⁷³ LTC Harms, *The enforcement of Intellectual property rights, A case book*, (3rd ed., 2013), at p.62 (Available at www.wipo.int/edocs/pub_docs/en/intproperty/791/wipo_pub_791.p). (Last accessed August 27, 2016)

¹⁷⁴ TRIPS Agreement, cited above, note 33, Art.15.4

¹⁷⁵ WIPO, African Introductory Course on Industrial property, *The protection of distinctive Signs used in trade: Marks and Geographical indications* (1995) p.4 (Available at www.wipo.int/meetings/en/details.jsp?meeting_id=3183)(Last retrieved on August 17, 2016)

¹⁷⁶ Tsehay Weda, *Implication of Trade marks in Transfer of Technology*, senior paper, (un published). Again, collective marks can be split into one of collective trade mark and collective membership marks.

¹⁷⁷ The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958, as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979, Art. 2(1). By the same token, Art. 22(1) of the TRIPS Agreement defines Geographical indications as indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

¹⁷⁸ In marketing, product differentiation is the process of distinguishing a product offering from others, to make it more attractive to a particular market. Product differentiation refers to such variations within a product class that (some) consumers view as imperfect substitutes. Alemayehu Fentaw, Ethiopian unfair competition law, cited above,

They reflect the source- distinguishing , or protection of the distinctiveness of the product, not of a monopoly on the product. For the trader, differentiation is a source of competitive advantage.¹⁷⁹ Trade names have in common with trademarks that they exercise a distinguishing function. They also share some standards during the registration such as identical or confusingly similar nature of the trade names concerned. Enterprises can register trade names as trademarks, and vice versa. The definition of a trademark is broader than a trade name. However, at times, the trade name may embrace so many trademarks thereunder.¹⁸⁰

3.1.3 Business Name

The name of business is also known as a legal name, firm name, fictitious or Doing Business As (DBA).¹⁸¹ It is incorporated in the commercial register or other organizational documents of the business person.¹⁸² The name of business is used in the course of communicating with the government or businesses such as filing tax returns, drawing checks and buying property.¹⁸³ In Ethiopia, it is defined as the name used by a business organization for commercial registration and by which such business organization is recognized as a legal person by the registering office or third party.¹⁸⁴ Name of business is governed by the CRLP and of the Commercial Code.¹⁸⁵ It is the name accorded during the acquisition of legal personality. It appears on the certificate of commercial registration.¹⁸⁶ It determines the rights and duties attributable to business persons. The character of the business must be mentioned along. For example, the Ethiopian Commercial Code states that a share company's name shall be as "agreed", but shall not offend public policy, or rights of third parties and shall include the words 'Share Company.'¹⁸⁷ Similarly, a Private Limited Company may have a firm-name indicating the nature of its business followed by the words "Private Limited Company."¹⁸⁸

note 18, p.3 Product differentiation in quality, packaging, design, color, and style has an important impact on consumer choice. See Simon P. ANDERSON, Andre de PALMA, and Jacques-Francois THISSE, *Discrete Choice Theory of Product Differentiation*, (1992), The MIT Press, at p. 36

¹⁷⁹Id. at p.3

¹⁸⁰ For example, if a given trader has secured a business license for soft drinks whose trade name is issued as **Moha Soft Drinks Trading**, the trader may make use of as many trademarks as he wishes for various soft drinks. The rules regulating trademarks apply mutatis mutandis to service marks.

¹⁸¹ Stephen Yoon, key differences between legal name, trade name and trademarks cited above, note 155

¹⁸² Ibid.

¹⁸³ Ibid.

¹⁸⁴ CRLP No. 980/ 2016, cited above, note 156, Art. 2(11)

¹⁸⁵ CRLP No. 980/ 2016, cited above, note 156, Art. 15(3) and (5). See Commercial Code, cited above, note 51, Arts. 135 (2), 207 (3), 280 (3), 305, 514

¹⁸⁶ CRLP No.980/ 2016, cited above, note 156, Art.15(3)

¹⁸⁷ Commercial Code, cited above, note 51, Art. 305

¹⁸⁸ Id. Art. 514

The name of business need not undergo the procedures of opposition by third parties. Unlike trade names which are issued after the acquisition of legal personality, the name of business is a pre-incorporation requirement for business organizations. A person can have only a single commercial register and name of business, but he may get registered for multiple trade names¹⁸⁹ and trademarks.

In sum, trade names and business names can be conceived as relating to businesses whilst trademarks distinguish the goods or services of competing business entities. Accordingly, trademarks have associative function. Whereas the trade names are descriptions of the business of the natural or legal person. They are not required to be distinctive for subsequent use.¹⁹⁰ There are practical connotations between business name and trade names.¹⁹¹

Third parties are being deceived by the business men who tempt to enter into contracts by using their trade name instead of their business names.¹⁹² The distinctions between trade name and business name has been made crystal clear in *Commercial Bank of Ethiopia vs. Michael Tadesse*.¹⁹³

3.2 Methods of Protection, Protected Rights and Corresponding Limitations of Trade Names and TradeMarks

3.2.1 Methods of Protection

There are two contrasting theories, or principles of trade name and trademark protection.¹⁹⁴ These are the first- to- use and the registration principles.¹⁹⁵ Countries employ these theories to extend

¹⁸⁹ CRLP No.980/ 2016, cited above, note 127 Art. 5(3), 6 (1), 24

¹⁹⁰ WIPO, Intellectual property hand book, cited above, note 2, at p.96 But, there is still a possibility where a firm name and a trade name can be afforded protection as a trademark, and the vice versa long as the legal requirements are fulfilled.

¹⁹¹ ፌዴራል ኮርት: የኢትዮጵያ የ ከብንያ ህግ, cited above note 17, at pp.22

¹⁹² Interview with Ato Getu Shiferaw Mehreteab Leul and Associates law Office, Senior expert, Tax and Employment, July 05,2016

¹⁹³ The Commercial Bank of Ethiopia vs. Michael Tadesse (Federal High Court, 2008, Civil file No.162408) (unpublished) At this juncture, the plaintiff claimed the repayment of the money it paid to the defendant based on their indemnity agreement. The payment was made through the bank's procedure to buy outstanding letter of credit in favor of the exporter. Unfortunately, the correpondent bank in Yemen could not repay the plaintiff due to the outbreak of a civil war out there. The plaintiff sued the defendant to collect the money. The defendant raised a preliminary objection alleging that the contract was made between Commercial Bank of Ethiopia and Mitran Exporter and importer hence, contending that the plaintiff cannot bring an action against Michael Tadesse. The court framed the issue whether the plaintiff had to sue in the name Mitran Exporter and importer, or Mical Tadesse. It overruled the preliminary objection stating that Mitran Exporter and importer is a trade name which has no separate legal personality from the owner per Article 212(1) in conjunction with 135(1) of the Commercial Code. The Court held that plaintiff has the right to bring the action against Micael Tadesse. The decision imparts the message that the capacity to be sued is directed against thebusiness name , not against the trade name of the business person. Hence, the business name accords one with the right to sue.

¹⁹⁴ Pattishal, Michigan Law Review, cited above note 34

¹⁹⁵ Ibid.

the exclusive ownership rights. The common law countries adopt the first- to-use theory.¹⁹⁶ They grant exclusive rights upon the use and public identification of a given trade name and/or trademark. In that way, the protection of the trade names and trademarks is contingent upon the prior use. The First to- use doctrine limits the scope of the protection to First in time, First in Right. Competition law protects prior users as long as they can prove priority use rights over a particular trademark in a particular region. This, however, renders practically difficult to prove the coverage of the trade name or trademark concerned. Similar or identical trademarks and trade names could be used in a particular region in a way that creates unfair competition.

Alternatively, the civil law countries adopt the registration principle as a linchpin.¹⁹⁷ Accordingly, the first registrant gets a legal protection over a given trademark, or trade name if he is found to have been registered before the particular organ of registration beforehand. Thus, trademark and trade name infringement exist only with respect to registered trade-marks and trade names. Registration establishes a statutory protection which minimizes litigations regarding the deceptive use of trade names and trademarks. By narrowly permitting strictly registered right, the plaintiff could make later comers to take reasonable precautions as are commercially practicable to prevent the diversion of their lawful trade name and trademark advertisements deceitfully.¹⁹⁸

However, the researcher argues that the effectiveness of the legal remedies upon infringement depends not only on the registration, but also on the enforcement designs and relative specificity of the statutory rules. It should also be kept in mind that the owner of an unregistered mark may sue for passing off in British countries and for unfair competition in a number of civil law countries.¹⁹⁹

In Ethiopia, the registration principle is provided in a mandatory fashion so as to claim protectable trade name rights.²⁰⁰ The CRLP lays down some important regulatory frameworks for competitive processes by putting threshold requirements, registration procedures, and administrative processes like alteration, substitution, and cancellation along with the effects of registration.²⁰¹

¹⁹⁶ Ibid.

¹⁹⁷ WIPO, The role of industrial property in the protection of consumers, (1983), Geneva, p.50. See also, CRLP No.980/2016, Article 17(1), cited above, note 156

¹⁹⁸ Ibid. Registration also affords certain evidentiary presumptions of validity and title, confers constructive use of the mark and trade name as of the application's filing date.

¹⁹⁹ STEPHEN P. LADAS, "The Lanham Act an International Trade, Law and Contemporary problems", Harvard Law Review, vol. 14, No.2, (1939), Harvard University Press, p.269 (Available at: <http://scholarship.law.duke.edu/lcp/vol14/iss2/7>). (Last accessed on December 21,2016) [Here in after, STEPHENP. LADAS, The Lanham Act an International Trade, Law and Contemporary problems]

²⁰⁰ See CRLP No.980/2016, cited above, note 127, Arts. 6(1), 15, 16

²⁰¹ CRLP No.980/2016, cited above, note 156, Arts.17,18,19,20

The law states that any business person is bound to cause registration of his trade name at the place where his commercial registration is conducted and where his business license is obtained.²⁰²

Before the registration of a trade name in the commercial register and in the trade name register, the registering office is required to ascertain that the trade name is not identical or misleadingly similar to a previously registered trade name.²⁰³ In determining the identical or confusingly similar nature of the trade names, the registering experts assess the previous trade name on a -case-by-case basis. They are bound to consider certain factors like the resemblance of the trade names, pronunciation, the closeness of the meaning of the words, and connection of the kind of the business represented by the trade names under consideration.²⁰⁴ The mere prior registration of a trade name does not prevent the registration of the same trade name for a business with an entirely different nature.²⁰⁵ This allows the registration of subsequent similar trade names for a different business. Such kind of legislative stipulation promotes free competition.

On the other hand, the trademark law is unclear as to the requirement of registration. It states that ownership rights of a trademark shall be acquired and be binding on third parties upon the grant of a trademark registration certificate and that the owner of a registered trademark shall have the right to use or authorize any other person to use the trade mark, in relation to any goods or services for which it has been registered.²⁰⁶ The logical organization of this provision confers ownership rights upon the registrant following the acquisition of a certificate of trademark registration. Nonetheless, the phraseology does not directly put registration as the only validity requirement to obtain trademark ownership rights. The fact that well-known trademarks are not necessarily registrable buttresses the fact that registration is not a mandatorily required. Some trademark practitioners had to say that prior users of a mark can enjoy ownership rights without registration.²⁰⁷ For them, it does not require registration as a precondition to prove ownership.

²⁰² Id.Art.15(2)

²⁰³ Id. see generally, CRLP No.980/2016, Art.16(1),(a-f) The provision further states that the trade name may not be identical or misleadingly similar to name of a business organization; name of government institution; religious institution, a nation, peoples, charities, name of a celebrity where a written consent of such celebrity is not submitted along; renowned in Ethiopia or around the world even though it is not registered in Ethiopia without written permission to use it name of a business organization; name of government institution; religious institution, a nation, peoples, charities, name of a celebrity where a written consent of such celebrity is not submitted along; renowned in Ethiopia or around the world even though it is not registered in Ethiopia without written permission to use it.

²⁰⁴ FDRE Ministry of Trade, Explanatory notes on the Commercial registration and Licensing Directive ,2015, Directive No.003/2015, pp.10-11 (translation mine)

²⁰⁵ Id. Art. 17(2)

²⁰⁶ TPRP No. 501/2006, cited above, note 169, Arts.4,26(1)

²⁰⁷ Interview with Benyam Tafesse, Mehreteab Leul and Associates law Office, Head of Intellectual property and Employment practice, July 05, 2016 and Interview with w/rt Lidet Abebe, Attorney at law and legal consultant, former expert of the EIPO, June 29, 2016

The TPRP also recognizes marks 'well-known by use in Ethiopia.'²⁰⁸ The law has gone half-way by considering unregistered trademark marks for the exclusion of subsequently applied trademarks. However, the TPRP should not be understood to have protected priority use rights beyond registration. Therefore, Art. 4 of the TRPP should be seen in the light of Part Six and Seven of the Proclamation which are captioned as '*Rights conferred by registration and Cancellation, invalidation, renunciation of a right on a registered Trademark*', respectively. Art. 26 of the TPRP reiterates same thing. Accordingly, the relative grounds of refusal against the registration of trademarks to protect third party priority rights presuppose registered trademarks. Dr. Biruk Haile argues that the trademark law goes an extra-length in preventing the registration of a subsequent trademark which is identical to, or similar with, an unregistered trademark which is widely known by use in Ethiopia. For him, an earlier trademark registered by the MoT and that is established by use in Ethiopia should be considered for stronger reason. This in turn prevents the subsequent registration of

anti-competitive trademarks

²⁰⁹ Be that as it may, the TPRP fails to define the "use" of a trademark which obscures the applicability of priority use. In fact, the TRPR provides a definition.²¹⁰ Yet, the Regulation focuses on the affixation standard without indicating as to the percentage of the society required for invoking prior user rights.

Having clarified that registration is required for trademark protection, not all marks are eligible for registration either. The Ethiopian trademark regime sets out relative, i.e., those meant for the protection of third parties, and absolute or objective grounds for refusal of registration which absolutely debar a mark from being protected ab initio.

Regarding the relative grounds, the registration of a particular mark is inadmissible owing to the conflicting interest of third parties having valid rights in a mark which are identical or confusingly similar to the mark whose registration is sought.²¹¹ Apart from this, a mark may not be registered because of third party rights in the case of well-known trademarks.²¹² An imitation or a translation, likely to mislead the public, of a mark which is well-known and belongs to a third party is not registrable. Protecting well-known marks does not require registration. As the protection is mainly targeted at saving consumers from being misled and maintaining the distinctive character of the marks, the inadmissibility test is not only confined to identical or similar goods and services but

²⁰⁸ TPRP, No. 501/2006, cited above, note 169, Art. 7 (2)

²⁰⁹ Interview with Dr. Biruk Haile, Addis Ababa University, School of Law, Instructor, Feb. 12, 2017

²¹⁰ TRPR No. 273/2012, cited above, note 170, Art. 2(6). It states that "Use of a trademark" means attaching the trademark to the goods or packaging or labeling of the goods, displaying the trademark closely associated with the goods, placing the trademark in advertising or promotional material for the goods or services, or in any other way establishing a relationship between the trademark and the goods or the services.

²¹¹ TPRP No. 501/2006, cited above, note 169, Art 7(1), (2)

²¹² WIPO African Introductory Course on Industrial Property, International Treaties in the field of Industrial Property, cited above, note 175

also to the whole range of goods and services.²¹³ Accordingly, the owner benefits from stronger protection. A separate discussion on well-known trademarks is in order in this chapter.

The Ethiopian law does not have priority rules resolving trade name and trademark conflicts. Courts may find themselves unable to cancel either of the two registrations despite they undoubtedly conflict. The TPRP only protects the characteristic title of another person's protected literary, artistic rights or right to a photograph or design.²¹⁴ In fact, a broader interpretation of the requirement of distinctiveness, as we will be canvassed afterwards, would protect registration of prior trade names registered in favor of others. However, the test of distinctiveness can not adequately protect the prior trade name rights of third parties. Nor do the EIPO and the MoT have a mutually supportive database and ICT system in the course of exercising their respective statutory registration powers.²¹⁵

As for the objective grounds of refusal for trademark registration, the overriding litmus test for protecting trademarks is, distinctiveness in a sense that a mark which for any other reason like for example, visible signs which are incapable of distinguishing the goods of one enterprise from those of another enterprise do not qualify for registration.²¹⁶ Such an examination is highly desirable both for consumer protection and competitors as well as for the trade in general.²¹⁷ Nobody should be able to have an exclusive right in a descriptive or even a generic term by a simple administrative act.²¹⁸ A mark is not registrable if it contains exclusively a sign which may serve, in the course of trade, to designate the kind, purpose, or value, etc. of the goods and services concerned.²¹⁹ In other words, a mark is not valid if it is merely descriptive of the goods or services which it is supposed to distinguish. This is because there are only limited numbers of words or pictures which may be monopolized hence, being anticompetitive otherwise. If a sign is merely descriptive, it is inherently incapable of distinguishing goods or services from one another. The terms descriptive, common and generic names apply with regard to the registration of trademarks, but they are irrelevant for the registration of trade names.²²⁰

²¹³ TPRP No.501/2006, cited above, note 169, Art.7(3)

²¹⁴ Id. See the full text of Art.7(1), (4)

²¹⁵ Interview with Ato Dereje Tsigu, Ethiopian Intellectual Property Office, Senior Legal Researcher March 24, 2016; Interview with Ato Chernet Mekonen, FDRE Ministry of Trade, Commercial Registration and Licensing Supervisor, August 12, 2016.

²¹⁶ TPRP No.501/2006, cited above, note 169, Arts. 2(12), 5(1), 6(1)(e),27(2)

²¹⁷ WIPO, Intellectual property hand book, cited above, note 2, at p.80

²¹⁸ Ibid.

²¹⁹ TPRP No.501/ 2006, cited Arts. 6(1), (e), see also T.A Blanco white and Robin Jacob, *Kerley's law of Trademarks and trade names*, (10th ed.1972), pp.111,113-115

²²⁰ Explanatory notes on the Commercial registration and Licensing Directive, 2015, Art.5.9, Directive No.003/2015 (translation mine). These terms have nothing to do with the kind of a business nor do they distinguish business organizations.

Besides, a mark is not eligible for valid registration if it has become in the current language or in bona fide and established the practice of the trade in the country a customary designation of the goods or services concerned.²²¹ More importantly, marks which are contrary to morality or public order or which are liable to deceive trade circles or consumers as to nature, source, characteristics or suitability, for the purpose of the goods or services are inadmissible for valid registration.²²² Stated otherwise, the protection of marks which mislead trade circles would be anti-competitive. Last but not least, a mark reproducing or imitating the armorial bearings, flags, emblems, initials, names or abbreviations of a state or an intergovernmental organization may not be eligible for valid registration.²²³

3.2.2 Overview of the Protected Rights and Corresponding Limitations

a. Rights

As a prelude, registered trademarks give an exclusive right to the owners. Anomalous it might seem, the CRLP is devoid of the list of substantive rights obtained by trade name registration. It simply states that the ownership of a business license to which the trade name is attached may not be transferred, sold and pledged.²²⁴ In other jurisdictions, the legal entity has statutory tradename rights. It may own and exploit trade names for advertisement of its goods in packaging, introduction, official documents, and exhibition.²²⁵

Since trademark issues arise in the course of commercial transactions involving the sale, assignment or licensing of trademark rights, it becomes indispensable to make some passing familiarity with the notion of international trade²²⁶ which is inconceivable today without trademarks and their adequate protection.²²⁷ Merchandise is sold by brands in foreign markets even more than in the domestic market.²²⁸ Trademarks are intangible property having a commercial

²²¹ TPRP No. 501/2006, cited above, note 169, Arts. 6(1), (f), 27(2),

²²² *Id.* Art. 6(1), (d)

²²³ *Id.* Art. 6(1)(i) See also **Nairobi Treaty on the Protection of the Olympic Symbol** adopted at Nairobi on September 26, 1981, Article 1. The Treaty obliges the state parties to refuse or to invalidate the registration as a mark and to prohibit by appropriate measures the use, as a mark or other sign, for commercial purposes, of any sign consisting of or containing the Olympic symbol, as defined in the Charter of the International Olympic Committee, except with the authorization of the latter. The Olympic symbol consists of five interlaced rings: blue, yellow, black, green and red, arranged in that order from left to right. It consists of the Olympic rings alone, whether delineated in a single color or in different colors.

²²⁴ CRLP No. 980/2016, cited above, note 127, Art. 26(5) in conjunction with Art. 49(4)

²²⁵ See for example, Article 15 (1) of the 1997 Mongolian law of trademarks and trade names

²²⁶ International trade can, for the purpose of this paper, be understood as an international business transaction which involves the export and import of goods, services, transfer of technology and production abroad.

²²⁷ STEPHEN P. LADAS, "The Lanham Act an International Trade, Law and Contemporary problems, cited above, note 199, p. 185

²²⁸ *Ibid*

value. Consequently, they are the only means of creating and maintaining good will with a foreign public.²²⁹

Trademark rights extend to cases of use of the mark outside trade context whilst trade names are invariably used in relation to trade. Trademarks may be used in the course of writing official letters, in a speech, scientific, or literary work or in any other publication. They also serve social objectives by safeguarding the public against mistake, confusion, and deception by identifying the source or origin of particular products.

Commerce is like a game in which competitors are expected to play by the rules of anti-unfair competition.²³⁰ In view of the preceding discussions, the requirement of confusion or, likely hood of confusion has huge impact on competition. The Paris Convention prohibits any act of competition contrary to honest practices in industrial or commercial matters which constitutes an act of unfair competition.²³¹ In particular, it prohibits all acts of such a nature which create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor.²³² It further prohibits indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.²³³

As to the essence and scope of identical or confusingly similar trademarks, the TRIPS Agreement provides an absolute protection such that in a case of the use of an identical sign for identical goods or services, a likelihood of confusion is to be presumed.²³⁴ Since confusion is assumed, it is not mentioned as a separate requirement and need not be established by means of evidence. Likewise, the TPRP prohibits 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.²³⁵ Therefore, a claim of unfair competition based upon trademark

²²⁹ Ibid. It is maintained that trademarks have had a prominent place in history, emerging with the development of international trade and evolving into one of the principal arms of Intellectual property. This is partly because in the domestic market, the purchasing public has additional ways of identifying products such as knowledge of the manufacturer or merchant by reputation, by advertising, etc. See WIPO, Introduction to Trademark Law and practice: The basic concepts, (1993), Geneva, p.5 (Available at <https://www.amazon.com/Introduction-Trademark-Law-Practice-s.A Wipo Training Manual>) (Last accessed on October 28, 2016)

²³⁰ Everett F. GOLDBERG, "The Protection of Trademarks in Ethiopia", J.Eth. L., Vol.8, No. 1, (1972), at p.134

²³¹ The Paris Convention for the Protection of Industrial Property of 1833 Art.10^{bis} 3(1), cited above, note 59

²³² Ibid.

²³³ Id. Art. 10^{bis} 3(3)

²³⁴ TRIPS Agreement, 1994, cited above, note 33, Art16(1)

²³⁵ TPRP No.501/2006, cited above, note 169, Article 26, (2), (a), (3)

infringement, does not necessarily require the proof of actual confusion of specific customers. Proof of the likelihood of confusion in the market circumstances satisfies the requirement so that similarity between two marks can make the case for unfair competition.²³⁶ The term deception implies the creation of an incorrect belief or mental impression and causing confusion may go no further than perplexing or mixing up the minds of the purchasing public.²³⁷ Nevertheless, the Trademark Law Treaty states that goods or services may not be considered as being similar or dissimilar to each other on the ground that they appear in the same and different class of the Nice Classification, respectively.²³⁸

The Ethiopian law recognizes the economic functions of trademarks. Accordingly, the owner of a trademark can forbid any use of and do confusing acts against the protected trademark, or a sign resembling it without just cause and in conditions likely to be prejudicial to his interests.²³⁹ This protection is designed to protect the trademark owner from unfair competition. The competition law prohibits any act which is dishonest, misleading or deceptive, and harms or is likely to harm the business interest of the competitor.²⁴⁰

The owner of a registered trademark shall have the right to use or authorize any other person to use the trademark in relation to any goods or services for which it has been registered.²⁴¹ A right on a registered trademark or an application for registration of a trademark may be assigned or licensed in whole or in part.²⁴² Consumers are accustomed to the product sold under the trademark so that an assignment without transfer of the enterprise, or part of the enterprise using the mark would deceive consumers. Nevertheless, as long as the new trademark owner ensures the consistent quality of the products sold under the assigned trademarks continues, consumers will then not be deceived. Failing this, partial transfer or assignment of the trademark right would considerably affect the rules of anti-unfair competition. In the case where there is a transfer of the business, the right to the trademark that is attached to the business passes over to the otherwise agreed.²⁴³ This prevents actual and potential confusion of the goods or services offered by another business person.

²³⁶ Alemayehu Fenatw, Ethiopian Unfair Competition law, cited above, note 18, p.9 For Alemayehu, a likelihood of confusion exists when there is confusion as to the enterprise/undertaking/business, products and services, or commercial activities.

²³⁷ WIPO, Intellectual property hand book, cited above, note 2, p.187

²³⁸ Trademark Law Treaty, 1994, cited above, note 69, Art. 9(2)

²³⁹ TPRP No.501/2006, cited above, note 169, Art.26(2), (b), (c),

²⁴⁰ TCCPP No.813/2013), cited above, note 127, Art. 8(1)

²⁴¹ Id. Art. 26(1) He can use, authorize, transfer and license to third parties based on certain conditions.

²⁴² TPRP No.501/2006, cited above, note 69, Art.26(2), (b), (c) Art.28(1)

²⁴³ Id. Art. 28(4)

b. Limitations

The owner of a registered trademark may not preclude third parties to use the trademark in relation to goods lawfully sold in any country under that trademark, provided that these goods have not undergone any change.²⁴⁴ Thus, the trademark proprietor's rights are exhausted once goods and services bearing the trade mark are put on to the market in any country by him or without his consent. The TPRP therefore, espouses an international trademark exhaustion doctrine. This approach allows free access by competitors to the trademark which is already put on the market. On top of this, the owner cannot preclude others from bona fide use of their names, addresses, pseudonyms, a geographical name concerning the kind, quality, quantity, destination, value, place origin, time of production or supply of their goods or services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.²⁴⁵ This exception considers the legitimate interest of non-competitor third parties to refer the mark registered by trademark owner.

3.3 Administration and Enforcement of Trade Competition, Trade name and Trademark Regimes

For the purpose of this paper, the term administration includes the institutional practices of registration, invalidation, cancellation, suspension, rulings on opposition and renewal of tradenames and/or trademarks whilst enforcement presupposes the infringement of the rights protected and the corresponding procedures right from instituting an action towards obtaining the ultimate remedies.

3.3.1 Administration and Enforcement of Trade Competition and Tradename

a. Administration

The TCCPP establishes an autonomous Federal Trade Competition and Consumers Protection Authority having an Adjudicative Tribunal along with its Appellate Tribunal as well as Regional Consumers Protection Judicial organs and Appellate Tribunals.²⁴⁶ To realize its missions, the Authority is composed of a Director General, Deputy Director General, judges, investigative officers and the necessary staff.²⁴⁷ It is given with extensive statutory powers and duties pertaining to the administrative, investigative, prosecutorial and judicial functions.²⁴⁸ The Authority is

²⁴⁴ Id.Art.27(1)

²⁴⁵ Id.Art.27(2)

²⁴⁶ TCCPP No.813/2013, cited above, note 127, Part Four, Arts. 27,34

²⁴⁷ Id.Art.28

²⁴⁸ Id. Arts.36-38

required to establish cooperation and relationship with domestic and foreign institutions having similar objectives.²⁴⁹ This would create an institutional interface among the MoT, EIPO and the Authority.

Concerning the administration of tradenames, the CRLP obliges the MoT or the regional organs administering commercial activities, or the Ethiopian Investment Commission based on the delegation given to it by the MoT, to conduct trade name registration and transfer the data they registered through delegation.²⁵⁰ It further imposed a duty on the MoT to establish and administer a central commercial and trade name registration which has nationwide application and make open and accessible information to the public at large.²⁵¹ This enables to prevent instances of granting confusingly similar trade names across the regions. The availability to the public of registered trade names potentially affects competition. Competitors need to be informed of already registered trade names so that they would be forewarned against registration of others' trade name.

In Ethiopia, there is no a legal mechanism on the basis of which an unused trade name can be cancelled.²⁵² Hence, competitors have no a legal ground to contest its non-use. The data base of the MoT shows that about 27,000 trade names are occupied by former trade name registrants whose proper use of the tradename is not known, though. The database displays no results when the experts search for a previous trade name which in turn could give rise to the registration of confusingly similar and /or identical subsequent trade names thereupon.²⁵³ Unlike trademarks, the cancellation decision for trade names is exclusively made on the motion of the administrative organs without leaving a room for interested parties.²⁵⁴

b. Enforcement

Understandably, the Adjudicative Tribunals of the TCCPA have judicial functions over trade competition.²⁵⁵ They take several measures ranging from passing an order regarding the payment of equivalent compensation to victimized business persons and consumers to administrative measures like causing the discontinuation of the act pronounced unfair and ordering the offending party to take affirmative action to reinstate the injured party's competitive

²⁴⁹ TCCPP No.813/2013, cited above, note 127. Art.30(2), (6), (10), (11), (14)

²⁵⁰ CRLP No.980/2016, cited above, note 156, Art.2(44) in conjunction with 4 (1), (3), (4), (11), (12), (16)

²⁵¹ *Id.* Preamble, Para.2, Art.4(4), (2), (9)

²⁵² But, a trade name can be cancelled following the cancellation of the commercial registration and business license certificates. See the CRLP No.980/2016, cited above, note 156, Arts. 22(1), 27(1),30(1)(f)

²⁵³ Interview with Ato Chernet Mekonen, FDRE MoT, Commercial Registration and Licensing Supervisor, August 12, 2016. In fact, the system of registrations is of recent history as there was no a national commercial registration system before 2010.

²⁵⁴ CRLP No.980/2016, cited above, note 156, Art.18

²⁵⁵ TCCPP No.813/2013, cited above, note 127, Art. 37(1)

position.²⁵⁶ The Tribunals may also revoke or suspend the offending party's business license and impose substantial fines up to 10% of the value of total assets and rigorous imprisonment ranging from 3 to 7 years.²⁵⁷ In relation to jurisdiction, *any person aggrieved by the decision of the Authority to prohibit merger or to revoke merger approval or to ban a commercial advertisement or by any decision of an Adjudicative Bench of the Authority may appeal to the Appellate Tribunal within 30 days from the date of the decision.*²⁵⁸ *Such a decision shall be final; provided however, that a party that claims the existence of mistake on question of law may lodge an appeal to the Federal Supreme Court within 30 days from the date of the decision.*²⁵⁹ A party who has exhausted these remedies and who invokes the existence of fundamental error of law may bring the case to the Cassation Division.²⁶⁰

An owner of a trade name may get through the aforementioned routes as long as he substantiates a risk of confusion and undue association between the trade names. A tradename infringement may involve the use and imitation of a trade name by another on the competitors' business such that the customers of such business are deceived, or likely to be deceived, or indeed to believe that the enterprise was run by the owner of trade name.²⁶¹ Since Ethiopia has no a sui-generis system of rectifying situations of trade name infringements, the rules of unfair competition can govern the violation of trade name rights. Accordingly, the owner of a given trade name can bring an unfair competition claim before the competition tribunals and seek the remedies envisaged under the TCCPP. However, the scope of protection accorded to trade names by the competition law is not sufficient. Traders, whose claims are grounded on different sectors of commerce, cannot avail themselves of the unfair competition provisions of the law. Besides, the requirement of "common field of activity" denies of remedies against trade name dilutions and particularly undermines the well-known trade names. Even another baffling issue is: What is the extent of the right that a prior trade name registration certificate in relation to goods vis a-vis trademarks?²⁶²

While we are on the subject, it is important to note that the CRLP deals with grievance against the state decision by specifying the route of appeal to the High court. In fact, the High Court has been exercising an appellate power over the decisions passed by the MoT long before the enactment of this law. For instance, in *Habtewold Zergaw Jethro Leadership and Management Institute vs. Samuel*

²⁵⁶ Id. Arts.32(1), (b), (c), (2), (a), (b)33(2), (a) cum. 42(1-4),43, (2), (4)

²⁵⁷ Id.Art.,43(2), (3), (4)

²⁵⁸ Id.Art.39(1) in conjunction with Art.33(2), (a), (b)

²⁵⁹ Id. Art. 39(2)

²⁶⁰ The FDRE Constitution, Proclamation No.1995, cited above, note 92, Art.80(3), (a)

²⁶¹ Thomson Reuters, American Jurisprudence, (2nd ed. 2017) ([Available at Thomson Reuter legal solutions Thomson Reuters .com/law /American-Jurisprudence. /1000275](https://www.thomsonreuters.com/law/American-Jurisprudence./1000275)) (Last accessed on January 29, 2017)

²⁶² The online advertisement of trade names regarding services would be tolerable. Because, services are intangible assets whose presence requires official advertisement. However, advertising trade names pertaining to goods may displace the persuasive effects of trademarks.

Assefa Jethro Management Consultancy Service,²⁶³ the Cassation Division held that a party aggrieved by the decisions of the MoT may lodge an appeal before the Federal High Court. Likewise, in *FDRE MoT vs. Tiger Logistics and Property Protection PLC*,²⁶⁴ the applicant granted a trade name registration certificate to a third party called *Tiger Security* whose trade name and field of activity is allegedly similar with that of the respondent. The latter requested for the cancellation of the subsequent trade name by alleging that it causes unfair competition. The MoT rejected the opposition stating that the trade names are not similar. It reasoned that the respondent is owned by foreign shareholders constituting 70% of its share that cannot undertake similar security activities with the later registrant. As a result, the respondent filed a suit before the First Instance Court and the Court in File No.1411884/2009, decided in favor of the former applicant. The MoT filed an appeal before the Federal High Court. Nevertheless, the latter reiterated and confirmed the decision of the lower court. The respondent petitioned to the Cassation Division. The Cassation Division confirmed the decisions on the merit upon adding that the mere prior registration of a trade name does not prevent the registration of the same trade name for a business with an entirely different nature. Accordingly, it decided that this is not an issue of unfair competition which warrants the cancellation of the trade name by the MoT. It, however, criticized the First Instance Court in assuming jurisdiction. A rather lurid genre of case has arisen in *Beilema Entertainment PLC vs. Beilema Tour and Transport Agent PLC and FDRE MoT*.²⁶⁵

3.3.2 Administration and Enforcement of Trademarks

a. Administration

As already noted earlier, the EIPO is entrusted with the task of administration and registration of trademarks. There are many benefits of federally registering a trademark. It, for instance, enables

²⁶³ *Habtewold Zergaw Jethro Leadership and Management Institute vs. Samuel Assefa Jethro Management Consultancy Service*, (Federal Supreme Court Cassation Division, 2004, Civil file no. 69603,) in የፌዴራል ጠቅላይ ፍርድ ቤት ሰበር ሰሚ ችሎት ውሳኔዎች ፤ ቅጽ 13 ፤ የኢ.ፌ.ዲ.ሪ ጠቅላይ ፍርድ ቤት ፤ አዲስ አበባ ፤ ገጽ 374-377

²⁶⁴ *FDRE MoT Vs. Tiger Logistics and Property Protection PLC*, (Federal Supreme Court Cassation Division, 2003, Civil file Number 58931.), (unpublished)

²⁶⁵ *Beilema Entertainment PLC vs. Beilema Tour and Transport Agent PLC and FDRE MoT*, (Federal Supreme Court Cassation Division, 2008, Civil file No.113161), (unpublished) In this case, the applicant argued that its trade name and trademark is registered as Beilema Entertainment PLC. It argues that it had been engaged in tour transport agency and that the first respondent has been granted with confusingly similar trade name-**Bielema Tour and Transport Agent PLC** for similar commercial activities. The first respondent denied the assertions of the applicant. The Federal First Instance Court decided the case in favor of the applicant. The respondents appealed before the Federal High Court and the latter ruled that the First Instance Court had no material jurisdiction. Accordingly, the High Court declined to assume appellate jurisdiction for want of material jurisdiction. Aggrieved by such a decision, the applicant lodged an appeal before the Federal Supreme Court and the latter confirmed the decisions of the High Court. The case was finally, brought to the Cassation Division and the latter upheld the decisions of the High court and the Supreme Court. It underscored that the applicant ought to have initially instituted the suit before the MoT so that the High Court would have assumed appellate jurisdiction had an error of law been committed thereupon.

the EIPO to control the mark by rejecting subsequent applications to register marks that conflict with the registered mark and thereby controlling anti-competitive trademarks. Registration creates nationwide constructive notice thereby preventing subsequent “innocent” adoption of the registered mark.

In the course of registration, the EIPO complies with the following basic procedures:²⁶⁶ It undertakes a formality and then substantive examinations of the application followed by a notice inviting the possible opposition to the registration of the mark by publicizing in a gazette having nationwide circulation. The opposition procedure opens up a door for any interested party particularly former trademark owners to attack the registration of confusingly similar trademark. If the application is accepted and no opposition is lodged, the EIPO will register the mark and issue a certificate of registration in favor of the registrant.²⁶⁷ It then discharges the tasks of periodic renewal.²⁶⁸ In case the certificate of trademarks is invalidated, or cancelled, the EIPO shall make necessary amendments in the state record of trademarks and shall publish in the trademark bulletin having nationwide circulation.²⁶⁹ This ensures free competition by availing the post registration and cancellation record in the trademark registry.

A registered trademark is not protected perpetually.²⁷⁰ The requirement of renewal appears to be a welcome opportunity for competitors. It would be both unjust and counter-productive to prohibit those having similar or identical products from using the communicative content of the mark whilst the marks are of no longer interest to the previously registered owner. Renewal may not include any change in relation to the previous registration in its latest form, though.²⁷¹ The decision for the cancellation of trademarks can be made on the motion of the EIPO and the interested parties if the trademark has not been used for a consecutive period of three years after its registration

²⁶⁶ Keith A. Barritt, *Prior User vs. Federal Registrant: Whose Mark Is It, Anyway?* (2009), p.11 (Available at <http://www.fr.com/news/prior-user-vs-federal-registrant-whose-mark-is-it-anyway>)(Last accessed on June 15, 2016) See generally, TPRP No.501/2006, cited above, note 169, Arts.11,12,13

²⁶⁷ Id. Art.15

²⁶⁸ Id. Art.25

²⁶⁹ Id. Art .37 (1) cum. 43 in conjunction with TRPR No., 273/2012, Art.40 (3), cited above, note 170. Likewise, the TRIPS Agreement, cited above, note 33, Art. 15.5 obliges members to publish each trademark either before it is registered or promptly after it is registered and to afford a reasonable opportunity for petitions to cancel the registration.

²⁷⁰ See, Art. 18 of the TRIPS Agreement, cited above, note 33. It limits the initial registration for a term of not less than seven years; Article 13(7) of the 1994 Trade mark Law Treaty, cited above, note 59, it fixes the duration of the initial registration and each renewal at 10years. On the other hand, Art. 7(2) of the MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS of April 14, 1891, cite above, note73. It states that any registration may be renewed for a period of twenty years from the expiration of the preceding period, by payment only of the basic fee and, where necessary, of the supplementary and complementary fees.

²⁷¹ MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, cited above, note 73, Art.7(2)

unless the registrant can prove force majeure for his nonuse.²⁷² While trademarks are expected to go through a statutorily fixed period of renewal for their continuity, trade names are not supposed to be renewed.

Now, let us turn our attention to the power of the EIPO Appellate Committee. The Appellate Committee is inter alia, empowered to review final decisions rendered by the relevant EIPO experts in respect of petitions relating to the invalidation and cancellations of trademarks and industrial designs.²⁷³ The decision of the committee is not binding unless the Director-General approves it.²⁷⁴ The powers bestowed upon the Appellate Committee raise three broad questions:²⁷⁵

Firstly, is it assuming a judicial power which is conferred upon regular courts by virtue of the Constitution?²⁷⁶ Normally, courts of law are established by a proclamation²⁷⁷ whilst the Appellate Committee's existence and of functioning is the outcome of an internal administrative Directive which does not follow legally prescribed procedure. This provokes constitutionality

issues. Secondly, is the Appellate Committee exercising an adjudicatory power, or passing an administrative decision? The Directive leaves a room for lodging an appeal before the competent court against the decisions passed by the Director General.²⁷⁸ If so, is the Appellate Committee exercising purely an administrative matter or a quasi-judicial jurisdiction? In fact, the Appellate Committee's power over the the decision passed by body of experts can be considered as an internal review system which is inherently exercised by administrative agencies. However, the Appellate Committee's powers and composition indicate that it is neither an appellate nor a judicial body as the Director-General is required to unilaterally approve the Appellate Committee's decisions. This seems to be an awkward arrangement.

Thirdly, how would one go about the subsequent proceedings when the decisions rendered by the Appellate Committee are contested by the parties to the suit? Is it the Appellate Committee or the Director General who is to be joined in the subsequent proceedings? In this connection, much discourse

²⁷² TRPR No 501/2006, Art.35 in conjunction with TRPR No. 273/2012, cited above, note 170, Art.43 (3)

²⁷³ Ethiopian Intellectual property Office Appellate Committee Establishment Directive, 2012, Art.7(1), (2)

²⁷⁴ Id. Art.13cum. 17

²⁷⁵ Interview with Dr. Mehari Redae (Associate professor), Addis Ababa University, School of Law, instructor, Legal Consultant and Attorney, April 19, 2016

²⁷⁶ The FDRE Constitution Proclamation No. 1/1995, cited above, note 92, Art. 79(1), 37(1), 78(4)

²⁷⁷ Federal Courts Establishment proclamation, 1996, Proclamation No.25, Federal. Neg.Gaz. Year 2, No.13, /as amended/ Federal Courts Proclamation Re-Amendment Proclamation No.454/2005, 11th year, No.42, Addis Ababa, 14th June, 2005 /as amended/ Federal Courts Amendment Proclamation No.321/2003, 9th year No.41, Addis Ababa, 8th April, 2003

²⁷⁸ Appellate Committee Establishment Directive, cited above, Article 18, note 246

arose in *Mahlet Habtewold and Welwalo Traditional Beverage vs. Kangaroo Plast*.²⁷⁹ The case has been presented as follows:

The trademark at issue, **Ibex** was initially registered both in words and in figure for distinguishing breweries and general trading activities of the respondent. The applicants contested that the trademark was not in use for the last three consecutive years following its registration in Ethiopia. The applicants petitioned to the EIPO to cancel the respondent's trademark based on Art. 35 (1), (2) of the TPRP. The respondent contended that it faced force majeure resulting from a fire accident which turned its foam factory into ashes.

The Appellate Committee framed the issue whether or not the respondent failed to use the trademark for reasons of force majeure. It discovered that it was the respondent's foam factory which risked fire accident, not the brewery factory and that the latter factory has a separate legal personality, rights, property and duties. It cancelled its trademark stating that the trademark was disused for a consecutive period of three years nor did the respondent prove force majeure thereto. Aggrieved by such a ruling, the respondent appealed to the Federal High Court making the applicants parties to the appeal and omitting the EIPO from the file. The merit of the case was suddenly drifted to issue of joinder of parties. The attorney for the first respondent, Dr. Mehari Redae, argued that it is the EIPO which should be made a party to the litigation, and not the former applicants. He also argued that the first applicant is not using the trademark in question whose joinder is therefore; wrong both procedurally and even unhelpful during enforcement of the rights of the judgment creditor. He further argued that the decisions of the EIPO administrative as the EIPO is even allowed to cancel unused trademarks on its motion per Article 43(3) of the TRPR. He further argued that the parties did not litigate on the merit of the matter nor was the right being exercised by the applicant that hence, makes the litigation complicated and undesirable. Despite the preliminary objections, the Federal High Court proceeded to hear and decide the matter by joining the parties. It reversed the decision of the Appellate Committee holding that the foam factory was proven to be an input for the brewery factory in which case the burning of the factory could constitute force majeure to the respondent. The first applicant filed an appeal before the Federal Supreme Court. The Supreme Court held that the parties and the EIPO may be joined in the appellate proceeding as the former are in some way or another beneficiary from the cancellation decision of the Office. It further held that if the cancellation is made on the EIPO's

²⁷⁹ *Mahlet Habtewold and Welwalo Traditional Beverage vs. Kangaroo Plast*, (Federal Supreme Court, 2008, Civil file No.118946) (unpublished)

motion pursuant to the powers given to it by the TRPR, it is a matter of administrative decision for which only the EIPO should be the party in the subsequent litigations. It remanded the case to the Federal High Court. The High Court re-entertained the case in File No. 1511647/2009.

The researcher concurs with the position of the Supreme Court which orders for the inclusion of the EIPO in the appellate proceeding by virtue of Article 40(2) of the Ethiopian Civil procedure Code.²⁸⁰ The Supreme Court's contemplation that the parties are also practically interested in the merits of the litigation upon justifying their joinder seems to be acceptable. Undeniably, the parties are practically and more likely to apply for the use and registration of the trademarks in the event of cancellation by the EIPO. From the vantage point of competition law, unused trademarks are artificial barriers to the registration of new marks by competitors. The Appellate Committee's decision ensures the competitive outcome of trademarks. The cancellation of the trademark encourages interested parties to make use of it. It makes no economic sense to protect trademarks without imposing the obligation to use them. But, the High Court erred in interpreting the meaning of force majeure liberally which in effect maintains the monopoly of unused trademarks in the name of force majeure.²⁸¹ This ultimately affects free competition.

b. Enforcement

Trade mark enforcement arises during the validity of the trademark. Although a pending trade mark application is an expectant right, the applicant cannot institute an infringement claim thereof. Under the TPRP, there is no a definition adopted for trademark infringement. This would affect effective enforcement. As Rudolf beautifully articulates, precedent in the law can be stultifying if applied blindly, and thus, the virtue turns to vice.²⁸² Basically, the defendant infringes upon the plaintiff's trademark when he attaches to his trademarks the same or a confusingly similar mark, or sells without authorization, the plaintiff's product with its trademark after rebottling, repacking, or refilling.²⁸³

The question that forces itself in to the forefront is: as to how and before what organ can a trade mark be enforced against an infringer? The TPRP states that any party aggrieved by the decisions of the EIPO with regard to the registration of trademarks has the right to appeal to the court having

²⁸⁰ The Civil Procedure Code of the Empire of Ethiopia, 1965, Articles 40(2 Decree No.165, *Neg. Gaz.*, year, No.3, Addis Ababa

²⁸¹ The TRIPS Agreement, cited above, note 33, Art. 19(1), recognizes valid reasons for non-use in terms of circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark.

²⁸² RUDOLF CALMANN, *Trademark infringement and Unfair competition*, cited above, note 4, at p.199

²⁸³ *Id.* at p.194

jurisdiction within 60 days from the date of notification of the decision to the person concerned.²⁸⁴

The law generally provides that the Federal Courts shall have jurisdiction over disputes and related matters that are governed by the TPRP and TRPR.⁸⁵ Thus, an infringement lawsuit in an ordinary trade mark infringement cases may be filed before federal courts²⁸⁶ However, the level of the federal court having jurisdiction over the final decisions of the EIPO is not specified. Thankfully, the Cassation Bench has elucidated the jurisdiction in the following cases.

In *Tibebe Ayele vs. EIPO*,²⁸⁷ the applicant applied for the registration of a trademark called *PANARISING* for electronic goods and the respondent rejected its claim stating that the trademark is similar to the previously registered trademark known as *RISING*. As a result, the applicant filed a suit before the First Instance Court. The respondent objected the jurisdiction of the Court, however; the latter established a jurisdiction and proceeded to decide on the merit of the case in favor of the applicant. The Court framed the issue whether or not it has the jurisdiction to hear the case and as to whether the EIPO is justified in declining the registration or not. The court ruled that the EIPO has registered similar trademarks before like SONY SONA and SHISANYO as a result of which the registration of *PANARISING* has no similarity with *RISING*. The Court further held that the trademark, *RISING* has lapsed for reasons of non-renewal which cannot prevent the subsequent registration. It ordered the registration of *PANARISING*.

The litigation continued up to the Cassation Division. The latter held that the cumulative reading of Arts. 6,17,36,49 of the TPRP in tandem with Proclamation No.25/1996; and looking at the meaning of appeal, the purpose of the EIPO proclamation as well as the system of filing appeal under the Ethiopian Civil procedure code; do not imply the possibility of filing a direct suit before the Federal First Instance Court. It ruled that it is the Federal High Court which should assume appellate jurisdiction in respect of final decisions containing an error of law passed by the EIPO. Such a line of interpretation was also adopted in *DAT International Trading PLC. vs EIPO Sada Santi Animale SA*²⁸⁸ and in *EIPO and Abdul hamid Abamecha vs. K.C.G and company*.²⁸⁹

²⁸⁴ TPRP No.501/2006, cited above, note 169, Art.17 (1), (2)

²⁸⁵ Id. Art.17 (2), 49

²⁸⁶ But, the state courts can entertain trademark matters by virtue of delegation. See FDRE Constitution, Proclamation No.1/1995, cited above, note 92, Arts.78 (2),80 (5), (6)

²⁸⁷ *Tibebe Ayele vs. the Ethiopian Intellectual property Office*, (Federal Supreme Court Cassation Division, 2003, Civil file No.5905), in የፌዴራል ጠቅላይ ፍርድ ቤት ሰበር ስሟ ችሎት ውሳኔዎች፣ ቅጽ 12 ፣ የኢ.ፌ.ዲ.ሪ ጠቅላይ ፍርድ ቤት፣ ኦገስት 11 ቀን 2003 ፣ ገጽ 549-552

²⁸⁸ *DAT International Trading PLC.Vs Ethiopian Intellectual Property Office and Sava Santi Animale SA* (Federal Supreme Court Cassation Division, 2004, Civil file No. 63454) (Unpublished)

²⁸⁹ *EIPO and Abdul Hamid Abamecha vs. K.C.G and company* (Federal Supreme Court Cassation Division, 2007E.C, Civil file no.99090, (un published). The Cassation Division held that the Federal Supreme Court shall assume

With respect to which level of federal courts should assume first instance jurisdiction in cases involving trade mark infringement, there are two lines of arguments. On the one hand, it can be said that the Federal High Court must assume exclusive first instance jurisdiction in both civil and criminal cases involving trademark infringements. This is correspondingly provided under the Copy Right and Neighboring Rights as well as the Proclamation Concerning Inventions, Minor Inventions and Industrial Designs.²⁹⁰ Further, since trademark is defined as one element of IP rights under the EIPO Establishment Proclamation No.320/2003,²⁹¹ the Federal High court may be analogically competent to entertain trade mark infringement cases in its first instance jurisdiction.

On the contrary, though EIPO Establishment Proclamation defines IP to include trademarks, it does not necessarily allude to the exclusive jurisdiction of the Federal High Court. As said earlier, the TPRP No.501/2006 has not clearly determined the level of the court which has first instance jurisdiction in the event of trade mark infringement.²⁹² Accordingly, it becomes of necessity to look at proclamation No.25/1996 which generally, states that federal courts shall have jurisdiction over civil cases relating to patent, literary and artistic- ownership rights.²⁹³ Art.11(1) of same also states that without prejudice to the powers vested on the Federal Supreme court, the Federal High Court shall have first instance jurisdiction over civil cases submitted to it involving an amount in excess of Birr five hundred thousand (500,000) and other civil cases arising in Addis Ababa and Dire Dawa. Again, Art. 11(2) of the Proclamation has listed the exclusive civil first instance jurisdiction of the Federal high court without listing IP rights. Art.14 of same further provides that the Federal First Instance Court has jurisdiction over civil cases involving an amount not in excess of Birr five hundred thousand (500,000) or, over civil cases the value of which cannot be expressed in money so long as the jurisdiction vested on the Federal Supreme Court and the Federal High Court provided for in the proclamation are not affected. Had the legislature intended

appellate jurisdiction over final decisions of the Federal High court which are given in confirmation of the Decisions of the EIPO.

²⁹⁰ The Copyright and Neighboring Rights Proclamation clearly authorizes the Federal High Court to entertain cases involving Copyright and Neighboring rights. See, Copyright and Neighboring Rights Protection Proclamation, 2004, Article 2(9), 34, Proc. No .410, **Federal Neg. Gaz.**, 10th year, no 55, as amended, Copyright and Neighboring Rights Protection (Amendment) Proclamation, 2014, Proc. No. 872, **Id.**, 21st year, No.20. The then Central High Court (the present Federal High Court) is empowered under the Proclamation Concerning Inventions, minor Inventions and Industrial Designs, to entertain the infringement of the exclusive rights protected under the Proclamation, too. See Proclamation Concerning Inventions, Minor Inventions and Industrial Designs Proclamation,1995, Article 2(1) cum. 54(1), Proclamation No.123, **Neg.Gaz.**, No.123/1995, No.25, Year 10

²⁹¹ EIPO Establishment Proclamation No. 320/2003, cited above, note 171, Art. 2(1) defines the term 'Intellectual property' as a legal right over a creative work of the human intellect and includes patent, trademark, registration certificate and copyright

²⁹² It simply provides that the Federal Courts shall have jurisdiction over disputes and related matters that are governed by this Proclamation and the Regulations. see TPRP No.501/2006, cited above, note 169, Art .2(2) cum. Art. 49

²⁹³ Federal Courts Establishment proclamation ,1996/Amended/, Art.5(8), cited above, note 277

to bestow exclusive first instance jurisdiction upon the Federal High Court in cases related to trade mark infringement, it would have clearly provided like it did in the Copy Right and Patent proclamations. It follows that a trademark civil suit whose pecuniary value exceeds 500, 000 Birr falls under the jurisdiction of the Federal High court and those bellow 500,000 Birr as well as those trademarks claims whose value cannot be assessed in terms of money as well those matters which are not expressly given to the Federal High Court are to be entertained by the Federal First Instance Court.

Regarding criminal matters, the Federal High Court has a jurisdiction to entertain criminal cases specified under sub-Arts .(1), (2), (3), (8) of Art. 4 of the proclamation. Yet again, trademark matters do not fall in this list. So, by virtue of exclusionary principle, the Federal First Instance Court shall entertain criminal cases relating to trademark infringement per Art.15 of the Proclamation.

The defendant to a claim of trademark infringement may argue various non-infringement defenses.²⁹⁴ There are wide varieties of remedies available for trademark infringement. A successful infringement action leads to prohibition of the use of the confusingly similar mark.²⁹⁵ To that extent, it protects competitive processes. The TPRP contains provisional, administrative, criminal and civil measures which have preventive and remedial purposes.²⁹⁶ The provisional measures prevent the entry into the channels of commerce of import and export goods.²⁹⁷ They envisage a mechanism for seizing or preventing the importation of infringing goods or services. The court may order an ex parte-preliminary injunction to halt infringement before the suit is disposed of on the merit.²⁹⁸ It also grants the temporary injunction upon investigating the imminence of the threat, prima facie strength of the action, and the gravity of the prejudice of the decision for or against to either of the parties.²⁹⁹ Final injunctions may be granted when the Court confirms the decision on the merits.³⁰⁰

There are also customs port and stations measures. The ERCA may, on the basis of written application accompanied by a certificate of trademark registration and other relevant evidence

²⁹⁴ These may include that the sign does not meet the trade mark function; there are pre-existing similar or identical marks being used in the same market segment; the mark lacks intrinsic distinctiveness and therefore should tolerate coexistence; continued use or prior use of the mark in good faith and without opposition from the title holder; etc. The defendant may also raise other grounds of defense in addition to non-infringement arguments such as procedural flaws as well as the arguable nullity of the mark.

²⁹⁵ WIPO Intellectual property hand book, cited above, note 2, at p.89

²⁹⁶ TPRP No.501/2006, cited above, note 169, Art.39-42

²⁹⁷ Id.Art.39(1), (a)

²⁹⁸ Id.Art.39(3)

²⁹⁹ Id.Art.39(4), (a)

³⁰⁰ Id. Art.39(6)

made by the right holder, and upon sufficient guarantee provided by the applicant, seize and detain goods which are the alleged infringement of the applicant's right.³⁰¹ Therefore, counterfeited products or infringing services may be halted ex officio by the ERCA. It is, however, required to release the seized and detained goods after crediting the guarantee unless the applicant brings court injunction within ten working days.³⁰²

In the civil sphere, the most common remedies are material recovery of damages and injunctive orders.³⁰³ As infringement is a volatile concept, damage is practically difficult to prove in trademark infringement cases. If it is proved successfully, the corresponding compensation would return the victim to the status quo ante. The criminal sanctions impose measures such as seizure, forfeiture and destruction of the infringing goods and of any materials and implements used in the commission of the criminal offense.³⁰⁴ They effectuate the civil remedies by deterring intrusive actions of brand pirates.

Be that as it may, the TPRP has no mechanism for the enforcement of unregistered marks.³⁰⁵ Also, a problem arises during the border enforcement of the trademark and trade name rights as the owners have no access to information as to the day-to-day import and export activities and products.³⁰⁶ The trademark law presupposes proactive and informed owners on the port while there is no an up-to-date database system that lets interested parties alert the relevant authorities of their trade mark rights and provide information regarding the identification of knock-offs. Many counterfeited products may be circulated in the channel of commerce. Besides, the ten working days' time limit envisaged for releasing detained and seized goods at the customs port, appears to be too short disallowing flexibility nor can all counterfeits be satisfactorily blocked.³⁰⁷

³⁰¹ Id. Art 42(1)

³⁰² Id. Art. 42 (3) It should be born in mind that the ERCA is not empowered to render final decisions on the merit of the case. It automatically releases the goods upon the lapse of the ten working days.

³⁰³ Id. Art. 40(1), (b)

³⁰⁴ Id. Art. 41(3)

³⁰⁵ Since, trade mark rights are fully enforceable only upon registration; an infringement law suit can hardly be brought by the unregistered user. The Adjudicative Benches of the Trade Competition and Consumers Protection Authority may entertain trademark infringements if a party alleged to have been the victim of unfair competition. By doing so, it may fill the gap that is left uncovered by the trademark law. Thus, whenever applicable, the plaintiff must substantiate that there is a risk of confusion and undue association between the marks. Failing this, the victim may seek damages due to bad faith behavior and/or fault of the pirate under extra-contractual provisions of the Civil Code of the Empire of Ethiopia, 1960, Arts. 2035, 2057 Proclamation No. 165, Neg. Gaz year 19, No. 2

³⁰⁶ Interview with Ato Belete Ahmed, Ethiopian Revenues and Customs Authority, Head Office, Deputy Public Prosecutor of the Prosecution General, Legal Advice and Opinion Directorate, Director, August 19, 2016

³⁰⁷ Ibid. A delayed letter of EIPO's verification as to the applicant's trademark ownership would exacerbate the infringement of the owner's rights.

3.4 The Protection of Well-known Trademarks and Competition law

The TRRP protects the owner of the well-known trademark against any activity which would affect or interfere with his trademark in a manner prejudicial to his interest.³⁰⁸ The determination of well-known status assists the owner in preventing identical and confusingly similar trademarks from being registered for any goods or services by others. In principle, the determination is made on a case-by-case analysis.³⁰⁹ Accordingly, various jurisdictions have clarified their intention under a choice of their trademark legislation.³¹⁰ The Ethiopian law provides neither a standard nor the illustrative factors of determination. It states that 'regard shall be given to the knowledge of the trademark in the relevant sector of the public.'³¹¹ This rule does not, however, determine whether the 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.³¹²

Interestingly, the TPRP goes a step further than the relevant international instruments protecting well-known trademarks.³¹³ It states that certain well-known trademarks are protected 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.³¹⁴ Ethiopia has not ratified the major international IP treaties, so far.³¹⁵ There is also an apparent contradiction between Arts.

23(2) and 7(2) of the TPRP. In this connection, the former provision protects well-known trademarks automatically whether or not the owner carries on business or has any goodwill in Ethiopia whereas the latter provision protects a trademark that is well-known, or established by use in Ethiopia with out being required to be wellknown internationally. Unless the contradiction is resolved, domestic competitors may be motivated to register for the well-known trademarks or enter in to franchising agreements with the rightful owner of the wellknown trademark abroad. This would emasculate the domestic competitors. The following cases would fairly illustrate the problems that have ensued in relation to the protection of well-known trademarks in Ethiopia.

³⁰⁸ TPRP No.501/2006, cited above, note 169, Arts.26 (2), (b), (c) cum. Art. 26(4), 23(2), (b)

³⁰⁹ Tilahun Esmael, "Protection of well-known Trademarks in Ethiopia: a comparative treatise under the trademark proclamation," Haramaya Law Review, Vol. 1, No2, (2013) p.131

³¹⁰ Ibid.

³¹¹ TPRP No.501/2006, cited above, note 169, Art. 23 (2)

³¹² Tilahun Esmael, Protection of well-known Trademarks in Ethiopia, cited above, note 314

³¹³ Id. p.130

³¹⁴ TPRP No.501/2006, cited above, note169, Art. 26 (2), (a). This provision goes in line with TRIPS Agreement, cited above, note 33, Article 16(3) which enunciates 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 so far as the owner of the registered trademark would be damaged by use of the mark on those goods or services mark in the relevant sector the spatial scope of the knowledge of the relevant trademark.

³¹⁵ However, there are Bilateral Trade Agreements (including with the USA which was the basis for claim for protection for MARIOT hotels).

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³⁰⁸ TPRP No.501/2006, cited above, note 169, Arts.26 (2), (b), (c) cum. Art. 26(4), 23(2), (b)

³⁰⁹ Tilahun Esmael, "Protection of well-known Trademarks in Ethiopia: a comparative treatise under the trademark proclamation," *Haramaya Law Review*, Vol. 1, No2, (2013) p.131

³¹⁰ Ibid.

³¹¹ TPRP No.501/2006, cited above, note 169, Art. 23 (2)

³¹² Tilahun Esmael, Protection of well-known Trademarks in Ethiopia, cited above, note 314

³¹³ Id. p.130

³¹⁴ TPRP No.501/2006, cited above, note169, Art. 26 (2), (a). This provision goes in line with TRIPS Agreement, cited above, note 33, Article 16(3) which enunciates 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 so far as the owner of the registered trademark would be damaged by use of the mark on those goods or services mark in the relevant sector the spatial scope of the knowledge of the relevant trademark.

³¹⁵ However, there are Bilateral Trade Agreements (including with the USA which was the basis for claim for protection for MARIOT hotels).

3.4 The Protection of Well-known Trademarks and Competition law

The TRRP protects the owner of the well-known trademark against any activity which would affect or interfere with his trademark in a manner prejudicial to his interest.³⁰⁸ The determination of well-known status assists the owner in preventing identical and confusingly similar trademarks from being registered for any goods or services by others. In principle, the determination is made on a case-by-case analysis.³⁰⁹ Accordingly, various jurisdictions have clarified their intention under a choice of their trademark legislation.³¹⁰ The Ethiopian law provides neither a standard nor the illustrative factors of determination. It states that 'regard shall be given to the knowledge of the trademark in the relevant sector of the public.'³¹¹ This rule does not, however, determine whether the 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.³¹²

Interestingly, the TPRP goes a step further than the relevant international instruments protecting well-known trademarks.³¹³ It states that certain well-known trademarks are protected 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.³¹⁴ Ethiopia has not ratified the major international IP treaties, so far.³¹⁵ There is also an apparent contradiction between Arts.

23(2) and 7(2) of the TPRP. In this connection, the former provision protects well-known trademarks automatically whether or not the owner carries on business or has any goodwill in Ethiopia whereas the latter provision protects a trademark that is well-known, or established by use in Ethiopia without being required to be well-known internationally. Unless the contradiction is resolved, domestic competitors may be motivated to register for the well-known trademarks or enter into franchising agreements with the rightful owner of the well-known trademark abroad. This would emasculate the domestic competitors. The following cases would fairly illustrate the problems that have ensued in relation to the protection of well-known trademarks in Ethiopia.

³⁰⁸ TPRP No.501/2006, cited above, note 169, Arts.26 (2), (b), (c) cum. Art. 26(4), 23(2), (b)

³⁰⁹ Tilahun Esmael, "Protection of well-known Trademarks in Ethiopia: a comparative treatise under the trademark proclamation," *Haramaya Law Review*, Vol. 1, No2, (2013) p.131

³¹⁰ Ibid.

³¹¹ TPRP No.501/2006, cited above, note 169, Art. 23 (2)

³¹² Tilahun Esmael, Protection of well-known Trademarks in Ethiopia, cited above, note 314

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In *SOLO SIRKA Vs. GATE PLC and the FDRE Ministry of Trade and Industry*,³¹⁶ the plaintiff filed a suit before the Federal High Court alleging that it is the owner and user of the trademark for matches and wood works. It argued that the trade mark namely, 'The **SCISSORS**' had been registered and renewed since 1921 in the Czechoslovakian Industrial Property Registry. Despite this, the first defendant registered and manufactured matches under a similar trademark known as *SERIOUS* by adding similar colors and designs in Ethiopia. The plaintiff requested for the cancellation of the registration by the MoTI, the stoppage of use, production, distribution, sale and the collection and destruction of the goods. In response, the defendants raised a preliminary objection by arguing that the plaintiff lacks legal personality to sue for it is not registered pursuant to the Commercial Code³¹⁷ and that did it did not enter its trademark in the Ethiopian trademark registry. They also defended that the products are not imported and distributed in Ethiopia either through an agent or by itself. Hence, the defendants argued that the acts of the first defendant do not cause unfair competition. The High Court framed the issue whether or not the plaintiff has legal personality in Ethiopia. It held that the suit lacks a cause of action as the plaintiff's trademark was not registered and had no legal protection in Ethiopia.

The litigation continued up to the Cassation Division and the latter confirmed the lower courts' decisions.

The decisions imply that unregistered well-known trademark owners are not protected in Ethiopia against any usurpation or imitation in the domestic market as long as there is no treaty creating an obligation against Ethiopia.³¹⁸ A similar decision was also reached in *Zak Ethiopia vs. Trade Link PLC and Per Serowan Firma wings*³¹⁹ and *Everyday Battery Company incorporated and Magma PLC and Muhammed Buser*.³²⁰

³¹⁶ SOLO SIRKA Vs. GATE PLC and the FDRE Ministry of Trade and Industry, Federal Supreme Court Cassation Division, Civil file no.19909,2000) (unpublished)

³¹⁷ Commercial Code, cited above, note 51, Arts. 10,100,223

³¹⁸ **The Vienna Convention on the law of Treaties of 23rd May,1969**, Art. 2(1)(a) defines the term "Treaty" as: an international agreement concluded between States in written form and governed by international law, whether embodied in a single instrument or in two or more related instruments and whatever its particular designation.

³¹⁹ *Zak Ethiopia vs. Trade Link PLC and Per Serowan Firma wings*, (Federal High court, 2000, File no. 2154),(unpublished)

Here, the second respondent was formerly, a plaintiff who invoked a well-known and registered trademark in Indonesia which used to distribute its products through the instrumentality of the first respondent in Ethiopia. The appellant was a defendant against whom the decision was passed in the lower court. The High Court reversed the decisions of the First Instance Court. It added that the second respondent was not registered for the trademark in Ethiopia and even lacks legal personality as it was not registered with the MoT. The High court found out that the second respondent was a commission agent whose rights are dependent upon the existence and protection of the former. /emphasis added/ The Court decided in favor of the appellant by further stating that it can get its trademarks registered in Ethiopia accordingly.

³²⁰ *Every day Battery Incorporated vs. Ali Seman*, (Federal High Court, 2006, Civil file No.15884) (unpublished). The High Court ruled that the respondents are mere importers for foreign manufactured batteries in the name *Ever*

3.5 Trade names, Trademarks protection and Distributorship Agreements vis-a-vis Competition Regime

A distributorship is essentially an agreement made among undertakings of different levels of the production or distribution chain relating to the purchase and sale of certain goods or services.³²¹ As such, when private agreements are made between the trade mark owner and his collaborators such as licensees, suppliers, manufacturers, distributors and the like, competition law intervenes to the extent aspects of the agreements are detrimental to the competitive processes.³²² By definition, the exclusive or sole distributors become vertical agreements may impair competitive market structures. Distribution agreements, as specific type of contracts usually regulated in statutory law.³²³

Nonetheless, there are typical clauses of distribution agreements on trademarks which protect the supplier and the distributor. The ICC Model Distribution Agreement allows the distributor to use trade names, or trademarks only for the purpose of identifying and advertising the products within the scope of the contract and in the supplier's sole interest.³²⁴ The distributor must agree neither to register, nor to have registered any trademarks, trade names or symbols of the supplier which are confusingly similar to the supplier's, in the territory or elsewhere.³²⁵ The distributor's right to use the supplier's trademarks, trade names or symbols, ceases immediately upon the expiration or termination, for any reason, of the contract without precluding the distributor's right to sell the products in stock at the date of expiration of the the supplier's trademark.³²⁶

power which was alleged to be similar with *Everyday battery* and that the respondents are not liable because they are not the producers.

³²¹ Ashtead and Leatherhead, Agency distribution, (Available at [Http://www.twmsolicitors.com/our-services/business-and-commercial-law/commercial-law/agency-and-distribution/distribution-and-distributor-agreements/www.businessmag.co.uk/wp.../webmagTVJulAug11-lo-res.pdf](http://www.twmsolicitors.com/our-services/business-and-commercial-law/commercial-law/agency-and-distribution/distribution-and-distributor-agreements/www.businessmag.co.uk/wp.../webmagTVJulAug11-lo-res.pdf) Last Accessed on January 13, 2017) It is also submitted that the distribution agreements may be of exclusive types giving the distributor with the exclusive right to sell the product held by it in stock in the territory covered by the distribution agreement by preventing the supplier from selling the goods in the relevant area either on his own account or through agents. On the other hand, non-exclusive distributorship agreements deprive the distributor of exclusive rights to the supplier's products. There is yet another category known as a sole distribution agreement, where the distributor will be the only one with whom the supplier deals in a given territory. The supplier will not be prevented from selling its products in the territory on its own account. There are also those which are referred to as selective distribution agreements which limit the number of distributors the supplier will appoint in a given territory.

³²² Admit Singh, Tulip Suman and Thripura V, Interfaces and synergy between Intellectual property rights and competition law, cited above, note, 54 at p.3

³²³ Gustavo BACHER(Dr.) and Szecskay, TRADEMARK LAW ASPECTS OF DISTRIBUTION CONTRACT, Seminar paper, (2011), Budapest, Hungary, p.1

³²⁴ ICC Model Distribution Agreement, Art. 13.1, (Available at www.iccwbo.org/~/media/pdf/model-distributorship-contract-2nd-ed-21-mrt-2016) (Last accessed on January 03, 2017)

³²⁵ Id. Art.13.2

³²⁶ Id. Art.13.3

In return, the supplier whose trademark rights are not exhausted, can enforce contractual claims arising from the breach of contract and he can rely also on the remedies available in the trademark law as exceeding the scope of the license qualifies as an infringement. The EU Trademark Directive states that the proprietor of a trademark may invoke the rights conferred by that trademark against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the trademark may be used, the scope of the goods or services for which the license is granted, the territory in which the trademark may be affixed, or the quality of the goods manufactured or of the services provided by the licensee.³²⁷

The Ethiopian competition law fails to specifically address the wide range of distribution agreements, though. Particularly, sole distributorship agreements lack a clear legal basis under the TCCPP. Fortunately, the existing CRLP bans operating as a sole importer or distributor by exceptionally allowing some sectors based on their type and national significance through a regulation to be issued by the Council of Ministers.³²⁸ This very provision appears to be a competition policy which might fill the lacuna of the competition law.³²⁹

However, the provision is obsessed with the exceptions which tend to create monopolistic tendencies. Given the state monopolizes the trade and service sectors of national importance by off-limiting the private sectors, the prohibition would not practically avoid the monopolistic status.

In Ethiopia, there is no a clear legal base for distributorship agreements and trademark protection. The trademark law generally states that the owner of a registered trademark shall have the right to authorize any other person to use the trademark in relation to any goods or services for which it has been registered.³³⁰ As long as the distributorship agreements are contractual, the authorized sole distributor and the trademark owner can make use of this provision apart from the contractual terms and conditions.

³²⁷ European Parliament and of the Council, EU Trademark Directive, 2008/95/EC, Art.8 (2), 22 October 2008. The Directive "approximates" the laws of the member states relating to trade marks. It further replaces the content of Council Directive 89/104/EEC of 21 December 1988 as amended by a 1992 Council Decision. Besides, Article 6septies of the Paris Convention for the Protection of Industrial Property, cited above, note 59, allows trademark owners to prevent or request cancellation of unauthorized registrations of their marks by their agents or representatives, as well as to prohibit use thereof, where the agent or representative cannot justify his acts.

³²⁸ CRLP, 2016, cited above, note 156, Art. 38

³²⁹ In the previous CRLP, the Competition Authority was forced to respect the sole distributors who have got a license from the MoT. It had the effect of obliterating competition by granting exclusive or sole distributors license. This can be a paradoxical approach, indeed. Because, those who have secured an exclusive distributorship license under the previous law would still keep on maintaining their monopolistic power.

³³⁰ TPRP N.501/2006, cited above, note 169, Art.26(1)

Another cross-cutting issue that requires illustration is the propriety of the sole or exclusive distributors to claim trademark infringement against entities that distribute or import products bearing the trademark upon authorization. Some argue that to the extent the products distributed by the third parties are not counterfeited, they do not constitute trademark infringement.³³¹ The mere importation and/or distribution of the trademarked goods and services from the foreign company by lawful traders do not constitute trademark infringement for the simple reason that infringement is invoked by the owner, not by the distributor/emphasis in original.³³² The exclusive or sole distributor may invoke a contractual remedy for any damage arising from the producer's sale or license of the products to other distributors in the same area. The same holds true for franchising business involving trade names. The following two cases would more or less, demonstrate these scenarios.

In *International Commission Agency PLC and Alem International Commission Agency PLC vs. Garad Enterprise and Shemsu Hassen*,³³³ the first applicant's trademark, **Tiger**, was registered by the Ethiopian MoTI both in words and in figure for identifying 'Cola products'. The second applicant was a sole distributing agent of the first applicant. The applicants contested the use of the first respondent's trademark, **Super Tiger**. The applicants sued the respondents alleging that the respondents are importing and distributing inferior quality products bearing a confusingly similar trademark called **super-tiger** accompanied by a tiger's figure from China. The applicants argued that the products confused the consuming public and created unfair competition in the local markets which caused an economic damage to their detriment. They urged the Trade Practice Commission to order the payment of compensation and seizure of the counterfeited goods.

In response, the respondents contended that they imported goods that bear different words such as **garad trading** and **super tiger** which are not confusingly similar with the trademark of the applicants. They alternatively, argued that it is only the producer in China that might be accountable for the alleged counterfeit. They further argued that they imported upon paying customs duty within the framework of the trade policy irrespective of the registered trademark. They also raised a preliminary objection stating that the second applicant is not an owner of the trademark which has no a vested interest to sue. One of the defendants further raised a preliminary objection stating

³³¹ Interview with Binyam Tafesse, Mehreteab Leul and Associates law Office, Head of Intellectual property and Employment practice, July 05, 2016 and Interview with W/rt Lidet Abebe, Attorney at law and legal consultant, former expert of the EIPO, June 29, 2016

³³² Ibid.

³³³ *International Commission Agency PLC and Alem International Commission Agency vs. Garad Enterprise and Shemsu Hassen*, (Trade Practice Investigation Commission, 1997, Civil file No.3) (Unpublished)

that the Commission does not have competence to hear and decide the case as it had been entertained by the Second Division of the Federal First Instance Court at Arada, which adjourned to pass judgment.

Against this factual background, the Commission framed three issues: whether or not it has jurisdiction over the pending matter before the court; whether the second applicant has a vested interest in the suit or not; and whether the trademarks in question are similar as to create confusion and unfair competition. The Commission overruled the objection justifying that pendency does not oust its administrative jurisdiction provided that the cause of action does not give rise to a criminal or civil liability for damages. It then decided that the second applicant has a right emanating from the sole importation agreement. The Commission stated that the second applicant has a vested interest in the suit for it loses its economic gain owing to the alleged acts of unfair competition. With regard to the third issue, the Commission held that the trademarks have more resemblance as both companies' containers for the coca products are white plastic and that the prefix Super-tiger would create confusion and unfair competition; and that the latter company's additional words like *Garad trading and super tiger* are not sufficient to avoid consumers' confusion. Eventually, it held that the respondents are liable by ordering them to refrain from distributing and importing of the goods in the name of *Super tiger*.

The Commission is correct in holding that the second applicant, being a distributor, has a right emanating from the distributorship agreement. A right can stem from a law or a contract which equally requires legal protection and enforcement. Moreover, the respondents' trademarks are confusingly similar and prompted by bad faith which constitute unfair competition. On top of that, if the Chinese Company, were to be held responsible, it would be impractical as the scope of application of the competition law is territorial so long as there is no a treaty there of.

In *Cane African Industries Limited vs. Keremela Industry PLC*³³⁴, the litigation boiled down to the registrability of a trademark in favor of the respondent known as **KI SAFARI**. The trademark was formerly registered and being used by the appellant in Kenya. The appellant was distributing its products in Ethiopia through the agency of the respondent. The latter took advantage of his power and applied for the registration of the same trade mark in Ethiopia in its own name. The appellant realized the bad faith of the respondent and lodged an opposition before the EIPO. The EIPO ordered the appellant to bring an injunctive order from the court within 15 days. However, the appellant failed to comply with the time frame and the trademark was granted to the _____

³³⁴ *Cane African Industries Limited Vs. Keremela Industry PLC*, (Federal High Court, 1999, Civil file No.48972) (unpublished)

respondent. The appellant lodged an appeal before the High Court and the latter framed the issue whether or not the EIPO hosted the registration of the respondent's trademark properly. It held that the registration contravenes the priority rights of third parties under Art.7 of the TPRP. It remanded the matter to the EIPO by ordering the latter to examine and decide over the registration of the trademark.

The EIPO is correct in literally applying the time frame for the injunction. However, it should have considered the dishonest commercial practice of the applicant that constitutes an apparent case of unfair competition. Though the distributor was an agent with fiduciary duty, it got the trade mark registered in its own name without getting the consent of the rightful owner. This harms the business interest of the competitor. If the owner opposed in the mean time, he should not lose his substantive right. In this connection, Art.6^{bis} (3) of the Paris Convention states that no time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.³³⁵

3.6 Domain names, Trademarks and Competition Regimes

The registration and use of domain names on the internet has been bypassing the province of trademarks by further implicating fair competition. Business entities doing businesses on the web have placed their competitors' marks in hidden html code used by search engines in formulating search results.³³⁶ Domain names are the internet addresses registered by users of the internet to be sent to them or their websites to be accessed.³³⁷ The systematization of the recognition of the proxy names as a popular substitute for all numeric addresses is called the Domain name system.³³⁸ The registration process for a domain name is relatively stringent than that of trademarks.³³⁹ Each name given is unique, so there is less likelihood of having the same name for

³³⁵ Paris Convention, cited above, note 59. By virtue of the Convention, if the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action. See *Id.* Art. 6 septies

³³⁶ Margaret Barrett, *Finding Trademark Use*, cited above, note 37, P.894

³³⁷ Tina Hart, Linda Fazzani and Simon Clark: *Intellectual property Law*, (5th ed.2009), Florence, Italy, pp.134,300

³³⁸ NANDAN KAMATH (ed.), *Law relating to Computers, Internet and E-Commerce: A guide to cyber laws and the Information Technology Act, with rules, regulations and notifications*, (3rded.,2007), Universal Law Publishing PLC, p.167

³³⁹ ROSANNE T. MITCHELL, "Resolving Domain Name-Trademark Disputes: A New System of Alternative Dispute Resolution Is Needed in Cyberspace", *OSJDR*, Vol 14 No.1,1998, p.157 ([Available at kb.osu.edu/dspace/bitstream/handle/.../OSJDR_V14N1_157.pdf](http://kb.osu.edu/dspace/bitstream/handle/.../OSJDR_V14N1_157.pdf)/last accessed on February 02,2017) Visit also Bedoeldeu, http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Main_differences_between

various businesses. There can, for example, be only one EBC.com and it is also possible to have EBC.co.et. A key denominator in determining whether the use of domain name rises to the level of a trademark is whether consumers view the domain name as a symbol of origin or source apart from anything else.³⁴⁰ Albeit this, the interplay of the domain name with trademark law is not straightforward.³⁴¹ Cybersquatters³⁴² register domain names consisting of a famous mark followed by a generic top level domain in hopes of selling the registration to the owner of the mark for an inflated price.³⁴³

The essential distinctions between trademarks and domain names lie in the fact that the former is a sign which can be graphically represented and is capable of distinguishing the goods or services of one undertaking from those of another.³⁴⁴ In contrast, the latter is a website address on the internet which gives one with an online identity. A domain name must be contextual in form like www.noe.gov.et, whilst a trademark may consist of words, designs, letters, numerals colors, the shape of goods or their packaging etc. and any combination of such signs.³⁴⁵ Like trademarks, a domain name is not registrable if it is identical to a previously registered domain name.³⁴⁶ A domain name is valid for a contractual period as agreed between the registrant and the accredited registrar and is subject to renewal.³⁴⁷ A domain name may describe the characteristics of the applied- for goods or services where as trademarks containing signs which exclusively describe the characteristics of the goods or services are not registrable for lack of distinctiveness.³⁴⁸ A domain name does not have to be registered in respect of a particular class of goods or services.³⁴⁹ On the other hand, a trade mark shall be registered in respect of the class of goods or services as classified under the Nice classification.³⁵⁰

trademarks and domain names-amended, Honk Hong (Last accessed July15,2016) [Here in after, Bedoeldeu, Main Differences between trademarks and Domain names]

³⁴⁰ Ibid.

³⁴¹ Research Team, ICT-IPR Legal Framework Report, cited above, note 14, at p.98

³⁴² Id, p.173. In this connection, Cybersquatting is all about the use of a domain name by a person with neither trade mark registration, nor any inherent rights to the name. It is a situation in which a registrant registers a mark or a personal name as a domain name on the internet and then exacts the price to turn the domain name over to the name's owner.

³⁴³ Bedoeldeu, Main Differences between trademarks and Domain names, cited above, note 339

³⁴⁴ Ibid.

³⁴⁵ Ibid.

³⁴⁶ Ibid.

³⁴⁷ Ibid.

³⁴⁸ Ibid.

³⁴⁹ Ibid.

³⁵⁰ **Nice Agreement Concerning the International Classification of Goods and Services for the purposes of the registration of marks**, Nice, cited above, note 76. At this juncture, the classification of figurative elements comprises a list of categories, divisions and sections in which the figurative elements of marks are classified, together with, as the case may be, explanatory notes. See also **Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks**, June 12, 1973, as amended on October 1, 1985, Vienna, Art.2(1)

It is possible for a number of domain names to coexist which comprise essentially the same word or trade name provided that at least one class of goods or services character is different. This could rise to considerable number of disputes between trademark owners and domain name owners which usually involve the domain name owner, the trademark owner, and the registration authority.³⁵¹ Domain name disputes have arisen in two broader contexts:³⁵² Firstly, a person with no other rights to a name may register a website with that name for several objectives including misuse of goodwill in a name or, the alleged preferential right of one entity over the other regarding a particular domain name. The second kind of conflict arises between persons who are equally entitled to a name tag situation owing to the global nature of the internet.

Ethiopia does not have any policy to govern the country's domain name system particularly, domain name registration. Whether trademark owners have an overriding right to claim a domain name that is identical with their trademark is not legally addressed. The registration process for domain names is virtually de-regulated. Because of this gap, cybersquatting would be a common business in Ethiopia. Such a state of deregulation would affect fair competition.

3.7 The Compatibility of the Trademark, Trade name, and Competition Regimes

This section attempts to evaluate the consonance of the Ethiopian trademark and trade name laws in the light of the TCCPP with particular emphasis on the trademark and trade name provisions having to do with competition. To begin with trademarks, there are great deals of loopholes associated with the determination of well-known trademarks. The trademark regime is devoid of a mechanism for the enforcement of rights of owners related to unregistered marks. The civil remedies embodied under the TPRP are not crafted with the broadest possible scope. All these gaps loom larger in the face of market competition by preventing effective remedies to prevent further trademark infringements. Even worse, filing an opposition and infringement lawsuit before the EIPO and federal courts, respectively when the defendant is a regional body or sole proprietor may end up in unwarranted delays and vexatious proceedings affecting competition. Despite that, the trademark regime is formulated in the wider context of competition law. The legislative attempts to balance trademark rights and competition law can be presented as follows:

³⁵¹ Carl Oppedahl, "Analysis and suggestions Regarding NSI Domain Name, Trade mark policy, ([Available at http://www.patents.com/nsi/iip.sht](http://www.patents.com/nsi/iip.sht)). (Last accessed on October 23, 2016)

³⁵² Nandan, *Law relating to Computers, Internet and E-Commerce: A guide to cyber laws and the Information Technology Act*, cited above, note 338, p.169

Firstly, the TPRP preamble pledges to protect the goodwill and reputation of the business by avoiding confusion between similar goods and services.³⁵³ Undoubtedly, protecting good will is at the heart of competition law. Secondly, the TPRP out rules marks which are likely to deceive mislead or confuse the business community and the public at large from registration.³⁵⁴ It prevents confusingly similar trademarks from registration on account of relative ground of refusal for registration. This squarely replicates the goal of competition law by avoiding confusion.

Thirdly, the grounds of cancellation owing to non-use; the opposition and examination ; the renewal³⁵⁵ as well as the enforcement provisions of the TPRP have an inbuilt element of promoting fair competition. Fourthly, the TPRP allows the owner of the registered trademark to transfer, license, assign and authorize third parties to use the goods or services covered by the protected trademark. This shows the inclination of the law towards free commercial utilization of the trademark as private property rights which enhances competition.

Fifthly, the TPRP has adopted the doctrine of international trademark exhaustion for it unequivocally, states that *the owner of a registered trademark may not preclude third parties to use the trademark in relation to goods lawfully sold in any country under that trademark, provided that these goods have not undergone any change.*³⁵⁶ The last proviso i.e., 'that the goods have not gone any change' implies that the registrant trademark owner can preclude the importation of counterfeited goods that may lead to confusion.³⁵⁷ Also, this provision implicitly strikes the balance between the hardcore restrictions and the owner's exclusionary privilege. Sixthly, the limitations and exceptions attached to the exclusive trademark rights are also tacitly tailored to control the abuse of monopolistic trademark rights which distort competition.

Seventhly, the trademark law only protects distinctive marks so that effective competition requires that competitors have access to common place, descriptive and generic words and symbols. Eighthly, the EIPO shall publicize trademarks in the state record of trademarks and make necessary amendments in the official bulletin. This creates an access to competitors to publicly registered and canceled trademarks. Ninthly, despite the fact that the federal registration might

³⁵³ TPRP No.501/2006, cited above, note 169, preamble para.1,

³⁵⁴ Id.Art.7

³⁵⁵ TPRP, Art.35 cum. TRPR, No.273/2012, Art.43 (3), cited above, note 170. But, the owner can get the trademark protection back upon payment of the penalty and effect application and registration fee anew within the six months' period so long as there is no another applicant before the second application is made. The decision to get the registered mark renewed is important partly because it provides the owner with an opportunity to assess the benefits of the mark in general and the good will of the business generated therefrom in particular.

³⁵⁶ TPRP No.501/2006, cited above, note 169, Art.27(1)

³⁵⁷ Counterfeiting is the imitation of a product. The counterfeit is not only identical in the generic sense of the term. It also gives the impression of being the genuine product. See WIPO Intellectual property hand book, cited above, note 2, p.90

pose registration difficulties, the EIPO would centrally control the subsequent applications to register marks that conflict with the registered mark and prevent anti-competitive trademarks. Regarding the complacency of the Ethiopian tradename and competition regimes, the CRLP does not enumerate the scope and substance of trade name rights which makes hardly possible to invoke the infringement of the rights. Nor does it define trade name infringement. It also lacks a legislative framework which allows the cancellation of unused trade names. This would be damaging to fair competition as trade names which are registered but not used may prevent the subsequent registration by competitors.

However, it fairly devotes certain provisions to supplement competition law. First, during the registration of a trade name of a sole proprietor, the law requires the use of a different identification in respect of already registered or occupied trade names.³⁵⁸ This mechanism is devised to prevent the registration of confusingly similar trade names. Secondly, the law imposes a duty against the registering office not to register a trade name which is identical or has misleading similarity to a trade name or name of a business organization previously registered.³⁵⁹ Thirdly, the law strictly regulates the conditions under which a substitute trade name can be issued in a way that seems to protect former competitors against confusingly similar trade names.

Fourthly, it prescribes that the mere prior registration of a trade name does not prevent the registration of the same trade name for a business with an entirely different nature.³⁶⁰ This provision promotes free competition. Fifthly, there are also grounds of cancellation and suspension of a trade name on account of fraudulent or erroneous registration which perhaps include the registration of confusingly similar trade names to the detriment of former trade name owners.³⁶¹

To close, the MoT is obliged to establish and administer a central commercial and trade name registration which has nationwide application and make information open and accessible to the public at large. This in turn creates uniform system of registration of trade names across the country. It informs the competitors as to the existence or otherwise of confusingly similar or identical tradenames earlier.

³⁵⁸ CRLP No.980/2016, cited above, note 156, Art.14(1)

³⁵⁹ Id.Art.16(1)

³⁶⁰ Id.Art.17(2)

³⁶¹ Id.Art.18(1), (b)-(d)

CHAPTER FOUR: ANALYSIS OF CASES PERTAINING TO TRADE NAMES, TRADEMARKS AND COMPETITION IN ETHIOPIA

4.1 The Experience of Selected Countries' Trademarks and Trade names Registration Systems

By way of reiteration, a conflict is likely to occur when a trade name registered prior to the trademark is registered by various entities. In the following discussions, the paper presents the experiences of four countries which extend trademark and trade name protection up on registration along with the rules devised to resolve the anti-competitive outcomes that could eventuate from conflicting registrations.

a. Mongolia

In Mongolia, there exists a single legislation governing trademarks and trade names.³⁶² The law states that trade names may be exploited in the same way as trademarks and if there is a discrepancy between a trademarks and a trade name, the trademarks shall prevail.³⁶³ It entrusts the IP Office with the responsibility of registering trade names and trademarks. It empowers the Office to receive and solve the applications of trademarks and trade names as well as to issue references for dispute settlement concerning them.³⁶⁴ It defines 'filing date' as the date on which an application of trademarks and trade name is received by the IP Office.³⁶⁵

However, the law does not clearly address where the selected trade mark coincides with a previously registered trade name or, vice versa. It simply dedicates a provision which is captioned as 'Settlement of disputes and grievances ' imposing a duty on the IP Office to settle the dispute and grievances concerning trademarks and trade names pertaining to according of filing and priority date.³⁶⁶ And more, it requires the IP Office to keep a unified state register trademarks and trade names and to establish a unified data base.³⁶⁷ Thus, the fact that the same organ is vested with the power of administration and registration of trade names and trademarks under a single legislation eases the settlement of priority claims pertaining to trade names and trademarks.

³⁶² 1997 Law of Trademarks and Trade names, Art.1 (Available at WIPO Data base of Intellectual property legislative texts). This provision seeks to ensure legal guarantee for trademarks and trade names by protecting the rights, legal interests of their owners, to regulate relations with regard to ownership, exploitation, expenditure of trademarks and trade names

³⁶³ Id. Art. 15(2)

³⁶⁴ Id. Art. 6

³⁶⁵ Id. Arti. 3(10)

³⁶⁶ Id. Art.20 (1)(ii)

³⁶⁷ Id. Art. 6(VI)

b. People's Republic of China

In China, the Trademark Office of the Administrative Authority for Industry and Commerce under the State Council shall be responsible for the registration and administration of trademarks throughout the country. To handle matters of trademark disputes, the Trademark Office establishes the Trademark Review and Adjudication Board there under. The Trademark law provides that any trademark in respect of which an application for registration is filed shall be so distinctive as to be distinguishable, and shall not conflict with any prior right acquired by another person.³⁶⁸ More importantly, the law states that *an application for the registration of a trademark shall not create any prejudice to the prior right of another person, nor unfair means be used to pre-emptively register the trademark of some reputation another person has used.*³⁶⁹ Hence, the trademark to be registered shall be adopted first, and apart from being exempted from the conflict with other first registered trademarks, it shall not clash with any prior legal rights.³⁷⁰

However, the law does not specifically define prior rights. To that end, the Standard for Trademark Review and Adjudication Board states that the prior rights regulated in Art. 31 of the Trademark law shall refer to other prior rights in addition to the trademark right acquired before the application day of the argued trademark including the trade name rights. Another more specific legal ground is envisaged under Article 1 of *Regulations on Several Issues Concerning Hearing on Civil cases between Trademark rights, Trade names and other Prior rights*. It states that *when the law suit is filed for the infringement claim against the plaintiff's copy right, design, patent, trade name right and other priority rights by any third party's literal or images, and such claims are complying with the Regulation in Art.108 of Civil procedure law, the People's Court shall accept it*. Accordingly, the court could conclude that trademark registration could damage the right of trade name which shall also be the first right.

It is however, noticeable that not every first applied trade name right strikes against later registered trademark for such fight against shall conform to certain conditions:³⁷¹ Firstly, the latter registration of trademark must be with malicious purpose of the applicant. This may be

³⁶⁸ The Trademark law of the People's Republic Of China , adopted at the 24th meeting of the Standing Committee of the Fifth National People's Congress on August 23, 1982 ; Amended according to the Decision on Amending the Trademark Law of the People's Republic of China at the 34th Session of the Standing Committee of the 7th National People's Congress on February 22, 1993 for the first time; Amended according to the Decision on Amending the Trademark Law of the People's Republic of China at the 24th Session of the Standing Committee of the 9th National People's Congress on October 27, 2001 for the second time .See Art.9

³⁶⁹ Id. Art.31

³⁷⁰ LuoYanjie, *Bridge Ip law commentary*, (Available at <http://www.chinaip.lawyer.com/decide-infringement-trademark-trade-name-china/>Last accessed December10,2016/), (Shanghai Feide Trading Co., Ltd.,2016)

³⁷¹ Ibid.

demonstrated in terms of two aspects:³⁷² The first is the contact by the applicant to the trade name. The second is when the reputation of the trade name is too high to claiming unknown to the latter applicant. According to the Standard to the Trademark Review, the decision on the public renown of the trade name shall lie with the registration time, using period, territory, business record and propaganda, etc.³⁷³ The second condition for first use trade name rights to compete latter registered trademark is if the registration and using of the latter applied trademark could result in the public confusion. If the latter registered mark is actually manufactured by the company with the name of the trademark, they may mistake the products.³⁷⁴ The administrative and judicial organs are required to judge confusion in light of the originality of the first used trade name, the overlap of the products, the reputation of the first used trade name.³⁷⁵

c. Austria

In Austria, trademarks are protected upon registration by the Patent Office. The Trademark Protection Law³⁷⁶ states that no one may, without the consent of the person authorized, use the name, trade name or special designation of the enterprise of another person for distinguishing goods or services. Furthermore, the law provides the effect of not complying with such a prohibition. It states that *any person may apply for the cancellation of a mark if his name, trade name or the special designation of his enterprise or a designation similar has been registered without his consent as mark or feature of a mark and if the use of the mark is likely to give rise to confusion in trade with one of the signs distinctive of the applicant's signs.*³⁷⁷

From this, a prior trade name owner may request the cancellation of an afterward trademark if there is a likelihood of confusion with the trade name. In order to establish a likelihood of confusion in trademark cancellation proceedings based on an earlier trade name, it is sufficient that the specification of the latter trademark basically coincides with similar or identical branch of business of the earlier trade name and that the trademark owner does not own an earlier trade name.³⁷⁸

³⁷² Ibid.

³⁷³ Ibid.

³⁷⁴ Ibid.

³⁷⁵ Ibid.

³⁷⁶ Austrian Federal Law of 1970, as last amended by the Law of March 7, 1984, amending the Patent Law and Trademark Protection Law, Art.12 (Available at WIPO Data base of Intellectual property legislative texts)

³⁷⁷ Id.Art.32

³⁷⁸ Priority conflicts between trade names and trademarks in Austria: Defense of prior trade name in trademark cancellation actions; (Available at <http://kluwertrademarkblog.com/2016/07/15/priority-conflicts-between-trade-names-and-trademarks-in-austria-defence-of-prior-trade-name-in-trademark-cancellation-action>). (Last accessed on December 27, 2016)

d. Brazil

In Brazil, trademarks rights are primarily derived from registration.³⁷⁹ There are absolute³⁸⁰ and relative³⁸¹ grounds for refusal of registrations which are examined ex-officio by the INPI-the Brazilian Patent and Trademark Office. The latter is an autonomous federal agency under the Ministry of Development, Industry and Commerce. The Institute is vested with implementing rules regarding industrial property as well as for registering and granting patents. Registration is not required for well-known and famous trademarks, though.³⁸²

In addition, a bona fide user of an unregistered trademark may claim priority rights over a competing trademark application provided there is evidence confirming the use of said unregistered trademark in Brazil for at least six months before the date in which the competing application was filled.³⁸³

The INPI does not grant registration to trademarks that contain or imitate any previous rights or trademarks of a third party. In a way, the Brazilian law puts trade names and trademarks on the same level in terms of legal protection.³⁸⁴ It bans trademark registry that refer to a trade name effectively in use before the application for, or registration of the trademark, that reproduces or copies a conspicuous feature of the trade name belonging to a third party, regardless of the date of constitution of the trading company. Any eventual conflict between the trademark registry and trade names is resolved by the principle of specification.³⁸⁵ As a result, if the sectors of the market differ in a way that no confusion is involved, there is no reason why they should not be able to coexist in the universe of commerce. On the other hand, if there is any confusion between them, the earliest registry must prevail.

4.2 Analysis of Cases on the Registration of Trade names and Trademarks in Ethiopia

This section analyzes some of the pertinent judicial and administrative decisions regarding the Ethiopian system of registration of trade names and trademarks which involve an element of competition.

³⁷⁹ The Patent and Trademark Protection Law No.9, 279/96, Art.129

³⁸⁰ Id. Arts. 122-124

³⁸¹ Id. Article 127

³⁸² Id. see generally Arts. 125-26

³⁸³ Id. Art.129(1)

³⁸⁴ Intellectual law in Brazil, p.144

³⁸⁵ Ibid.

i. **Ethio-Ceramic vs. EIPO and Ashoriga Technology Limited** ³⁸⁶

In the case at issue, the applicant claimed to have a registered trade name, 'Ethio-Cement' by the MoT for future cement manufacturing plant. The applicant complained of the confusing similarity of the proposed trademark with its trade name as the only difference of the respondent's trademark is that it is surrounded by ten stars. Despite the applicant's opposition, the first respondent granted a certificate of trademark registration for the second respondent that will produce similar cement products bearing similar words with the applicant's trade name.

Being aggrieved by this decision, the applicant lodged an appeal to the Federal High Court. However, the High Court upheld the recognition and protection of the proposed trademark in favor of the second respondent. The applicant filed a petition to the Cassation Division and the latter reversed the lower decisions altogether. It reasoned out that the applicant has a legal duty to seal its trade name and address on the future production of cement products hence, the trade name would coincide with the trademark of the second respondent. It underscored that the parties will produce similar products as a result of which consumers would get confused. Also, it remarked that the EIPO is duty bound to register trademarks upon ascertaining that the mark subject to registration does not affect fair competition and other relevant laws of the country.

Undeniably, the Cassation Division attempted to give full effect to the unfair competition rules by protecting the trade name which is prior to, and similar with the trademarks upon registration. Evidently, the practice of registering same thing as trademark and trade name by the EIPO and MoT in favor of different producers and enterprises might create anticompetitive effect. However, the Cassation Division's reasoning appears to be far-fetched. It cited the EIPO Establishment proclamation which states that the EIPO has the duty to make appropriate decisions after undertaking or causing to be undertaken the necessary examination in accordance with the relevant law.³⁸⁷ Here, the last proviso, 'the relevant law' is of a singular phraseology which does not impose a direct duty on the EIPO to consult the competition law other than the TPRP and its Regulation upon registration. This provision is transposed to the requirement of distinctiveness in the TPRP.³⁸⁸ A liberal interpretation of the requirement of distinctiveness would resonate that the trademark law has the means to protect prior trade names registered in favor of others.

³⁸⁶ Ethio-Ceramic P.L.C vs. EIPO and Ashoriga Technology Limited, (Federal Supreme Court Cassation Division, 2003, civil cassation Case No. 57179), in የፌዴራል ጠቅላይ ፍርድ ቤት ስበር ሰሚ ችሎት ወላኔዎች ፣ ቅጽ 12 ፣ የኢ.ፌ.ዲ.ሪ ጠቅላይ ፍርድ ቤት ፣ አዲስ አበባ ፣ 2003 ገጽ 544-548

³⁸⁷ EIPO Establishment Proclamation No.320/2003, cited above, note 171, Art.6(1)

³⁸⁸ Distinctiveness is requirement in the TPRP No.501/2006, cited above, note 169, Arts. 2(12), 5(1), and 6 (1), (c). The test of distinctiveness out rules the registration of any mark which is incapable of clearly distinguishing the goods or services of a person from those of other persons.

Nevertheless, distinctiveness does not in and of itself guarantee the prior trade name rights from anti-competitive trademarks. Besides, the TPRP protects the characteristic title of another person's protected literary, artistic rights or right to a photograph or design without referring to the fate of the previous trade name owners.³⁸⁹ Unless the Cassation Division construes the foregoing provision logically, it overstepped its mandate as there is no a clear legal basis to out rule subsequent trademark registrations so as to protect earlier trade name rights. It did not cite this provision, after all. Again, the TPRP lacks clear prevalence clause where there is a discrepancy between a trademark and a trade name. Incidentally, the Cassation Division should have passed a conclusive decision as to the manner of resolving disputes emanating from service marks and trade names concerning services.

ii. **Crown Hotel vs. Six continents Hotels Inc.**³⁹⁰

In this case, the applicant is registered for '*Crown Hotel*' as its trade name and it had been using same as its trademark for hotel business since the last twenty years. The respondent being an agent of the foreign company, Tsemex PLC, recently applied for the registration of a trademark called, *CROWNE PLAZA* before the EIPO. Alarmed by the defendant's move, the applicant filed an opposition claiming that the mark confuses consumers as it is similar to the trade name. The EIPO decided in favor of the respondent by reasoning that trade mark was not registered by the owner of the trade name and that registering in the name of the respondent would foster investment in the country. The applicant lodged an appeal to the Federal High Court. The latter confirmed the lower decision by adding that the trademark and the trade name are different in terms of their pronunciation, reading and sight. The applicant brought the case to the Cassation Division and it got the lower courts' decisions reversed.

The Cassation Division held that the trade name of the applicant is widely known which has acquired reputation and goodwill. It also remarked that there is no an exception to the registrability requirements of the TPRP which denies former trade name owners of their property rights in the name of encouraging investment. Accordingly, it decided that the trademark of the respondent should not be registered and protected.

The decision of the Cassation Division protects the priority rights of trade name owners who have been trademark owners without registration. True, the use of identical or similar trade mark may

³⁸⁹ Id.Art.7(1), (4)

³⁹⁰ Zewditu Mesfin vs. Six continents Hotels Inc., (Federal Supreme Court Cassation Division, 2009, Civil file No.117013) (unpublished)

lead to a diversion of users which would result from such users' mistakenly accessing one trade mark instead of the trade name. However, there is no such kind of protection under the TPRP unless probably the trade name happened to be a well-known mark. As long as the status of the trade name is not transformed in to a well-known trademark, a prior use of a trade name does not amount to the registration of trademarks. The Cassation decision signals that the use of a given trade name over the years can elevate itself up to the level of a trademark. This, on its face, is a sheer disregard of the requirement of trademark registration. It amounts to enacting a new law. Again, the EIPO's registration of the trademark in favor of foreign investors under the guise of promoting investment stifles domestic competition.

*iii. Addis Ababa Foam and Plastic Factory PLC Vs. New Flower General Trading PLC*³⁹¹

In this case, the applicant initially instituted an unfair competition action to the TCCPP Authority Adjudicative Tribunal alleging that the respondent misappropriated its registered trademark known as **ADDIS ABABA FOAM**. The applicant argued that the respondent caused a loss of more than Birr 3.6 million annual turnovers by directly translating its trademark as **NEW FLOWER FOAM** in respect of similar goods i.e. foam products. In response, the respondent contended that its trademark was also registered as a trade name, **NEW FLOWER FOAM** in the MoT long before the registration of the applicant trademark and that the present applicant failed to oppose during the trade name registration. It also defended that the trademark of the applicant is not protected as translated and that the designs, pronunciation, and letters' layout as well as the contents, words, colors of the trademarks in issue are quite dissimilar from each other which do not cause confusion.

In deciding the matter, the Tribunal framed two issues -whether or not the translated trademark which is being used by the respondent could cause confusion in the minds of the consuming public and as to what particular remedies could be awarded to the applicant in case there exists confusion. The Tribunal and of the Appellate Tribunal passed similar judgments in file numbers, 00036/2008 E.c. and 00008/2008 E.c., respectively. They held that the respondent was registered for the trade name **NEW FLOWER FOAM** earlier and the subsequent registration of the same name as its trademark causes no confusion with the applicant's trademark. They further stated that both trademarks are distinct in terms of the colors, letters, signs and words appearing in the foams which do not confuse consumers. They also ruled that the applicant did not prove the resultant

³⁹¹ Addis Ababa Foam and Plastic Factory Vs. New Flower General Trading PLC, (Federal Supreme Court Cassation Division, 2009, Civil file No.128313) (unpublished)

economic loss as a result of the purported acts of the respondent. The, the applicant lodged a petition to the Cassation Division. The latter confirmed the decisions of the lower Tribunals stating that the respondent can continue using its trade name and trademark.

The decisions of the Tribunals and the Cassation Division are cogent to the extent they examined the alleged effects of using a translated trademark on the one hand and the public's perception of the product and its owner on the other. At this juncture, Article 7(3) of the TPRP enunciates that *a trademark shall not be registered on account of third party priority rights which constitutes a translation of a trademark which is registered in Ethiopia ..., provided that the use of the trademark in relation to those goods or services would indicate a connection between those goods and services and that the interest of the owner of the registered trademark is likely to be damaged by such use.*

From this, the registration can be declined as long as the translated mark creates a likelihood of confusion and that the interest of the owner of the registered trademark is at stake. Although 'ADDIS ABABA FOAM' is a trademark whose English translation is *NEW FLOWER FOAM*, the latter differs in terms of colors, letters, signs and words hence, less likely to create confusion. Secondly, the law of unfair competition proscribes the conducts of the business persons, in the course of trade, which harm or are likely to harm the business interest of a competitor.³⁹² Though the claims of the applicant were grounded on having sustained damage as a result of the alleged confusion by the respondent's trademark, the witnesses and the oral litigation did not prove so. Nor did they prove any actual or potential economic loss owing to the alleged bad faith of the respondent in using the translated trademark. Thirdly, the requirement of labeling and packaging envisaged under the TPRP is designed to mitigate the likely hood of confusion.³⁹³ Average consumers can read and understand the degree of similarity and actual association of the distinct signs, words and designs embodied in both companies' foams.

iv. **Bekas Chemical PLC vs. Miski Industry PLC**³⁹⁴

Here, the appellant initially filed an action of unfair competition to the TCCPP Authority's Adjudicative Tribunal. It argued that it has a registered trademark called, '*Bright 'Bekas'*' for producing and selling liquid, detergents and soaps since the last 18 years. It alleged that the

³⁹² TCCPP No.813/2013, cited above, note 127, Art. 8(1),

³⁹³ Id. see Art.18 in general

³⁹⁴ Bekas Chemicals PLC vs. Miski Industry PLC, (Federal Supreme Court, 2008 Civil file No.120677) (unpublished)

respondent committed an unfair competition and that it has sustained an economic damage as a result of it. It further argued that the respondent is registered for '**Best Berekina**' while it used '**Best bright Bekas**' as its trademark to produce and sell similar products without being protected for the word, colors and figures. In response, the respondent contended that the trademark of the plaintiff (the present appellant) is descriptive for soaps and detergents. It also argued that the products of the appellant are trademarked with green and yellow colors whilst the respondent has only used the yellow color. It further argued that the trademark of the appellant is being used by the *East African Tiger Brands* trademarked as **Sun Bright**.

In disposing of the case, the Tribunal framed three cross-cutting issues revolving around whether or not the EIPO has granted protection to the **Bright Bekas**; whether or not **Best Bright Bekas** is similar and confusing with '**Bright Bekas**' in terms of color and shape of the Jerrycan; and as to what kind of remedies could be granted to the plaintiff should it prove unfair competition. The Tribunal in File No.00041/2008 E.c. proceeded into the merits of the case. It held that the design and combination of the colors of the defendant's Jerrycan would confuse the illiterate society. It also held that the respondent is not licensed for, and protected in respect of the words and figures which in turn cause confusion irrespective of the appellant's legal protection as to the particular design in question. It further justified that the requirement of labelling and packaging as envisaged in the TCCPP, presuppose an average and literate consumer. Eventually, the Tribunal could, by majority, hold that the respondent used 'a trade name' which would confuse the public and thereby ordered the stoppage of its use by the respondent.

The appellant appealed to the Appellate Tribunal and got the decision reversed. The Appellate Tribunal, in File No.00007/2008 E.c., held that the trademark used by the appellant is suggestive nor does the protection apply to the yellow color nor do the factual grounds prove the case consistently. Ultimately, the appellant brought the case before the Federal Supreme Court. The Court reversed the Appellate Tribunal's decision by stating that the respondent cannot use the trademark of the appellant as long as it is not cancelled by the EIPO for the allegedly descriptive nature of the trademark. It also criticized the decision of the Appellate Tribunal for holding that the registration at issue would not cause confusion while the written evidences produced by the EIPO proved so.

From a purely legalistic perspective, the interpretation of the Tribunal is erroneous. For one thing, Article 7 (3) of the TPRP protects colors or, combination of colors. Therefore, the Tribunal and the EIPO erred in holding that the yellow color of the respondent's trademark is similar and inadmissible for protection. They should have extended protection as the trademarks

under comparison possess different packages and shapes. Besides, the appellant was protected for the word, the logo and yellow plus green colors, not for the Jerrycan which came to be used by the respondent. Despite the fact that trademarks can have elements not protectable under the law, there is no a legal restriction for using similar colors for different products bearing similar shapes and colors.

With due respect to its holding, the Appellate Tribunal's reasoning that the design and combination of the colors of the respondent's Jerrycan would confuse the illiterate society, seems to be an unusual standard. The law indiscriminately takes accounts of every average consumer as a standard of reference. Apart from this, the lower Tribunal seems to have conflated trade names with trademarks for it reasoned that the trade name of the respondent would cause confusion. The Supreme Court held that the respondent used the trademark beyond the scope of its protection. This shows its consciousness of the purpose of registering trademarks.

v. **BMK General Trade PLC vs. Mob Trade and Industry PLC** ³⁹⁵

At this juncture, the applicant argued that it had been registered for a trade name and a trademark, '*Umbrella Steel manufacturing*' accompanied by a woman holding an umbrella. The Trademark and the Industrial designs protection and Development Core Business process registered the same trademark for the respondent irrespective of the applicant's opposition. The applicant contested the registration of the trademark to be confusingly similar. It alleged that the registration causes unfair competition as both companies produce steel products. It urged the EIPO Appellate Committee to reverse the lower decisions and cancel the respondent's trademark from the registry thereof. In response, the respondent asserted that the trademarks at issue are different in terms of their shape, content, and colors and that its trademark contains additional signs like **JSW** and the woman holding the umbrella is missing hence, rendering the applicant's opposition groundless. In deciding the matter, the Appellate Committee framed the issue whether or not the respondent's trademark is similar to the prior trademark in a way that confuses consumers. It relied on the purpose of the TPRP in relation to protecting goodwill. It confirmed the lower decisions. On motion to judgment, it held that the umbrella is customarily used by the public for which neither parties are entitled to an exclusive right nor do the remaining components of the trademarks confuse consumers as the respondent's trademark include additional symbols like **JSW** nor is the woman holding an umbrella attached to the respondent's trademark.

³⁹⁵ BMK General Trade PLC vs. Mob Trade and Industry PLC, (Ethiopian Intellectual property Office Appellate Committee, 2008) (unpublished)

The decision and reasoning of the Appellate Committee appear to be convincing. In establishing the requirement of likelihood of confusion; it managed to look at the factors of relevance such as the respective signs, protected parts, and commonly used signs. Trademark registration system must be holistic in a way that confusingly similar or identical marks have to be examined on a case by case by case analysis. The present decision echoes the essence of free competition. The Appellate Committee delimited the scope of rights accorded to a trademark owner in respect of similar products.

vi. **Trade Competition and Consumers protection Authority's Public Prosecutor vs. Almaz Eshete Mineral Water PLC**³⁹⁶

In this case, the public prosecutor charged the accused company with a crime of commercial dishonesty and unfair competition.³⁹⁷ It argued that the accused used '*Blue Water*' as its trade mark which is misleading and confusing to the public as compared with the trademark of the injured party. According to the prosecutor, the victim has an earlier protection over the two litter's water bottle whose trademark was registered as '*bottle design protection*'. It argued that the accused used the trademark out of its scope of protection by changing the design and content of the trademark in a way that resembles the victim's trademark hence, harming the victim's and the state's interest. On its part, the accused defended that it has acquired a legal protection for using '*Blue Water*' and that the trademarks at issue are completely different which do not mislead and confuse to the public as compared with the trade mark of the injured party, '**Yes Brothers**'. It also argued that the victim company is not registered for the colour nor did the prosecutor show the place, time and magnitude of the damage sustained by the victim.

In deciding the case, the Tribunal framed the issue whether or not the package used in relation to the **Blue water bottle** causes confusion with that of the two litters' bottle manufactured by **Yes brands food and beverage PLC**. It then ruled that there is no a clear indication as to which particular part and shape of the trademark, **yes water bottle** was protected. It acquitted the accused by holding that the latter did not commit an act of unfair competition as the public prosecutor failed to prove the case according to its charge.

The decision of the Tribunal is valid. The victim should have a legally protected interest over the trademark. In the absence of an exclusive interest upon the allegedly infringed trademark, the claim lacks a cause of action let alone entailing criminal responsibility. Further, there is no a

³⁹⁶ Trade Competition and Consumers Protection Authority's Public Prosecutor vs Almaz Eshete Mineral Water PLC, (Federal Trade Competition and Consumers Protection Authority's Tribunal, 2008, Criminal file No.00039) (unpublished)

³⁹⁷ T CCPP No.813/2013, cited above, note 127, Arts. 8(1), (2) (a) cum. 32(1) 42 (3)

specific protection on the shape of the water bottle and the fact that the victim has protection over the 'Yes water' does not mean that the blue colour is already exclusive. If the plaintiff claims color as a distinctive feature of his mark, he should have corroborated specifying the color protected.

ii. **Trade Competition and Consumers protection Authority's Public Prosecutor vs -Vs- Umer Awel and others** ³⁹⁸

In this case, the public prosecutor accused the latter of having committed anti-competition. He charged the accused with unlawful importation and selling of **SOROL** products to the detriment of **GAF PLC** which owns blade products under the trade mark **SOKOL**. The prosecutor also argued that the accused, by selling the misleading products without declaration, caused a loss of governmental revenue. The accused defended not to have been engaged in the process of distributorship and importation of **SOKOL** Products except for selling the already available **SOROL** products in their shops. They contended that even if they were said to have sold the products, they are retailers, not competitors who should be held liable outside the unfair competition provision.

The Tribunal framed the issue whether the accused have committed unfair competition or not. It held that the accused are retailers who run their business by collecting the goods from various entities whose criminality liability for unfair competition depends upon their full knowledge of the confusing manufacture and presentation. It dismissed the case by stating that the prosecution witness did not prove the availability and sell of the **SOROL** products misleading that they are **SOKOL**.

The decision and reasoning of the Tribunal seems to be plausible. Firstly, the provision under which the accused were charged with, does not apply for individual retailers. It is meant for regulating the conduct of producers and importers. Secondly, the mere fact of possessing similarly trademarked goods does not necessarily constitute an act of unfair competition unless the trademark actually or, potentially misleads the consumers or harm the business interest of the competitor. The prosecution evidences should corroborate the confusing or dishonest acts of the competitors who sell similar products, in the same area, and at the same time. In the case under consideration, the accused are not competitors nor was it proven that they collaborated with another principal offender which could differ the merit and outcome of the case.

³⁹⁸ Trade Competition and Consumers Protection Authority's Public Prosecutor vs -Vs- Umer Awel and others (Federal Trade Competition and Consumers Protection Authority's Tribunal, 2008, Criminal file No.00028) (unpublished)

iii. **Royal publishing PLC vs. EIPO and others**³⁹⁹

The appellant lodged an appeal before the High Court following the EIPO's cancellation decision of its trademark, '**Royal**' which was used to identify books. It was formerly used as its trade name as well. The EIPO cancelled the trademark upon the opposition of other former two shareholders who claimed that the appellant cannot make use of the trade name as the company in whose goodwill the trade name was registered is dissolved without determining the ownership of its trade name and that its registration as a trademark by the appellant affects their priority rights. The EIPO ruled that the mark does not fulfill the requirements of registrability. It decided that the trademark be commonly used by the parties to the litigation by justifying that it had been in use by the public. The applicant appealed. The High Court confirmed the cancellation decision of the EIPO, but it reversed the order which states the joint use of the trademark by the parties.

The High court's stand is convincing. In the current case, the EIPO seems to suggest that anyone interested can use the trademark as it is protected in favor of no one. Basically, the TPRP extends exclusive rights upon registration. Although it is possible that a trade mark can be jointly owned, the parties have not been registered as joint owners. Thus, part of the EIPO's decision which orders that they can make use of the trademark jointly defeats the purpose of the registration and protection.

ix. **D.H Geda Steel Manufacturing PLC vs. Akakai Metal works Factory**⁴⁰⁰

In this case, both the appellant and the respondent had been manufacturing steel products without trademark registration. The present respondent had been using the trademark **Gobian metal works S.c** since 1964 which contains five stars, Latin letters spelt as NMP, and made in Ethiopia hard. The respondent sued the appellant alleging that the latter attempted to cause the registration of confusingly similar trademark called **DHG** with four stars at the former MoTI. The respondent objected the application for the registration stating that the appellant's move constitutes an act of unfair competition under Art. 132(1), (a) and 141(2) of the Commercial Code.

The Federal First Instance Court, to which the case was submitted, framed the issues whether the trademark of the appellant is confusingly similar with that of the respondent and as to who has the priority right if the appellant's trademarks causes unfair competition. The Court reasoned that the appellant's move to have registered a similar trademark in respect of steel products would go

³⁹⁹ Royal publishing PLC vs. EIPO, (Federal High Court, 2010, Civil file No. 83002), (unpublished)

⁴⁰⁰ DH Geda Steel Manufacturing PLC vs. Akakai Metal Factory, (Federal High Court, 2003, File No.03546/2003) (unpublished)

against the respondent's long built reputation over the trademark. The Court barely considered the likely hood of confusion for the illiterate society without the need to produce evidence of registration. It also held that the appellant did not deny the priority of the respondents' trademark and that it was a wholesaler of the respondents' products before the application for registration. Finally, it ordered the MoTI not to register the appellant's trademark on the ground of unfair competition.

Aggrieved by such a decision, the appellant lodged an appeal to the High Court alleging that the respondent failed to oppose the registration within the statutory time limit; that unless the trademark is registered, the respondent's use of the trademark for a long period of time does not grant exclusive rights to it and finally it argued that the trademarks are not confusingly similar by adding that even if they are treated as such, the standard used by the lower court to determine confusing similarity is the illiterate society which should be the ordinary buyers.

The appellate court framed the issue which of the parties has better title if the trademarks were confusingly similar; and even if the respondent had better title are the trademarks confusingly similar or not? In view of addressing these issues, the court took for granted that the respondent had been using the trademark since 1964, hence it established the respondent's priority right. It also investigated the trademark of the appellant which contains four stars, the letters DHG for similar steel products except for missing the phrase, 'made in Ethiop, hard'. It confirmed the lower court's decision. Against these comparisons, the Court held that the trademarks seem to be copies of each other and they create confusion on the minds of average consumers. It reasoned out that the appellant is presumed to know or should have known the confusion an unfair competition resulting there from. It then, confirmed the lower court's decisions.

The decisions of the courts are pro-competitive. The law of unfair competition seeks to protect businesses from dishonest and harmful commercial competition. This decision is a typical manifestation of protecting unregistered trademarks in the context of unfair competition. Otherwise, the rightful owner's clients would be taken away by virtue of dishonest and improper competition.

x. **Everyday Battery Incorporated vs. Ali Seman**⁴⁰¹

⁴⁰¹ Every day Battery Incorporated vs. Ali Seman, (Federal High Court, 2006, Civil file No.15884) (unpublished)

In this particular case, the plaintiff is an owner of a registered a trademark called, **Everyday battery** containing additional signs such as a black cat passing via a red colour number nine to identify battery cells. It instituted an action of unfair competition against the defendant by stating that the latter started using, importing, selling and distributing battery cells under a trademark called **Nyala battery** which exhibits a black animal jumping via number six written in red colour. The plaintiff argued that the defendant's trademark is a confusingly similar for it represents similar products with the plaintiff which causes consumers' confusion.

In reply, the defendant argued that the trademarks are completely different starting from their names and the additional symbols, number and colours attached to the defendant's trademark. The Federal High Court framed the issue whether or not the defendant has committed an act of unfair competition. The key criterion for determination was that the defendant changed the black cat in to black animal and the number from nine to six which is written and surrounded by a white ribbon. The Court decided that there need not exist absolute similarity for constituting unfair competition nor did the defendant defend that his trademark could not be confusing. It held that there exists confusing similarity between the trademarks of the plaintiff and that of the defendant. It ordered for the defendant to refrain from using, selling, importing and distributing the products.

The decision of the High Court seems to be tenable. The decision prevents the erosion of the plaintiff's goodwill. It safeguards consumers from confusion.

xi. **Kangaroo Plast PLC vs. Meta Abo Bira S.C**⁴⁰²

In this case, the appellant was aggrieved by the decisions of the EIPO for the latter failed to register its proposed trademark, **Anbesa Beer** bearing a lion's figure beyond neck to distinguish its beer products. The EIPO rejected the application upon the opposition of the registration by the respondent alleging that a similar trademark called **Meta Abo Bira** accompanied by a full picture of a standing lion was registered by the respondent beforehand. The EIPO reasoned that both figures would confuse consumers. The appellant brought its case to the Federal High Court. The Court, in file No. 69926/2008E.c, framed the issue whether or not the trademark applied by the appellant for registration could be confusing to the consumers. It reversed the decision of the EIPO by stating that the layout of the figures for both lions and of trademarks are dissimilar and that they are not likely to confuse consumers. The decision was confirmed by the Federal Supreme Court.

⁴⁰² Kangaroo Plast PLC-Vs Meta Abo Bira S.C, (Federal Supreme Court, 2008, Civil file No.49918) (unpublished)

The decision of the courts is sound and pro-competitive because, the trademarks in question are not confusingly similar in terms of their pronunciation; design and layout. Average consumers can obviously identify and compare the products by only looking at the labeling and figures of both lions.

xii. Wigoye (Techno mobile Assembly Factory -Vs- Jozi (Geotel) Mobile Assembly)⁴⁰³

In this particular case, the plaintiff sued the defendant for unfair competition. It alleged that the latter infringed the trade mark of the plaintiff, **T340 and T341** registered for fixed and smart phones. The plaintiff asserted that the defendant produced and sold **G-340 and G-341** fixed and smart phones bearing similar model numbers, packaging color, layout and body of the cell phone and other specific signs for similar products. The defendant contended that the trademarks are distinct and it operated under the umbrella of a free market and the investment policy after getting a business license.

The Tribunal framed an issue whether or not there appears a similarity that causes unfair competition between the trademarks in question. In determining the matter, it examined the certificates of competence granted to both parties by the MoICT which were found out to be irrelevant to establish the rightful owner, though. It decided that both trademarks are confusingly similar. It ordered the defendant to stop producing and selling the contested products under the trademark in question.

The holding of the Tribunal is commendable. Nevertheless, at a more realistic level, the relief is inadequate. The stoppage order against producing and selling of the said products is ineffectual. An order of stoppage alone does not guarantee that the already produced products would not be distributed in the channel of commerce. The Tribunal ought to have ordered the sale of the produced goods by way of a public auction to recompense the plaintiff and impose deterrent fines thereof.

⁴⁰³ Wigoye (Techno mobile Assembly Factory -Vs- Jeoz (Geotel) Mobile Assembly, (Federal Trade Competition and Consumers Protection Authority's Tribunal, 2006, Civil file No.00017) (unpublished)

CONCLUSION AND RECOMMENDATIONS

A. Conclusion

The thesis has examined the boundaries and tripartite interfaces amongst trade names, trademarks and competition regimes. Initially, the creation and maintenance of strong trademark regime was put at the centerpiece of the competing theories of legal formalism and realism. The tension was resolved upon the paradigm shift towards the perfect compatibility between the goals of trademark protection and competition laws. Competition law supplements trademark and trade name regimes when and if these regimes fail to afford effective protection for trade name and trademark owners. Nonetheless, it is only the confusion based liability theory of the law of trademarks and tradenames that refers to the discords between competitors in the context of the law of unfair competition.

The study has touched upon the growing effects of competition tribunals in IP litigations. Competition authorities may practically devote distant attention and resources to IP-related matters by assigning a high priority to the area of competition policy and law. Competition oriented trademark litigations should consider the technicalities of IP. If the competition tribunals have limited capacity in the regime of IP, they may be competition-minded in a way that pulls trademark protection out of the picture.

That said, the protection of trade names and trademarks may be predicated upon registration or first-user theories each having considerable repercussions in the realm of competitive processes. Ethiopia adopted a system of registration of trade names and trademarks. Accordingly, tradenames are regulated by the CRLP No.980/2016 and trademarks are governed by the TPRP No.501/2006 and TPRR No.273/2012. Accordingly, some marks and trade names are statutorily debarred from registration owing to certain statutory grounds of inadmissibility. Albeit this, Ethiopia has no a rough-hewn and adequate legislative bridge during the registration of trademarks and trade names. This has led to unsettled practical controversies. The statutory requirements for the registration of tradenames and trademarks are far from being complete. In particular, the trade name and the trademark regimes have no cross reference provisions to avoid possible overlaps. This has in turn caused inconsistent registrations and actionable claims based on unfair competition. The fact that trade names and trademarks are being registered independently under the MoT and the EIPO, respectively tripled with the absence of a unified databases poses practical challenges.

True enough, the Cassation Division has passed a pioneer decision towards the harmonious registration of trade names and trademarks by the MoT and EIPO in *Ethio-Ceramic P.L.C vs. EIPO and shoriga Technology Limited* case, but the decision lacks a clear legislative backup for their inter operability.

The GTPs do not specifically foresee the nature and design of the particular competition and trademark regimes nor do the GDP reports show the percentage of trademark and trade names supporting trade. The TCCPP dedicates certain provisions concerning trademarks and trade names. Of particular interest, the unfair competition provision is a catch-all provision that applies to all claims of unfair competition emanating from unregistered trademarks and virtually de-regulated trade names. However, the competition law espouses many disparate goals coupled with vague terminologies and exceptions pertaining to vertical and horizontal agreements.

The study further assessed the compatibility of the Ethiopian trademark and trade name regimes against the competition law in force. Against this back drop, the trademark regime prevents confusingly similar or identical trademarks from registration. Also, the grounds of cancellation owing to non-use; procedures for the opposition and examination; the renewal provisions of the law are designed to incentivize competitiveness. The law further allows the owner of the registered trademark to transfer, license, assign and authorize third parties to use the goods or services covered by the protected trademark. This shows the recognition of private rights in the field of competitive commerce. The TPRP further recognizes the doctrine of international trademark exhaustion. This fosters competitive outcomes by striking the balance between the hardcore restrictions and the owner's exclusionary trademark privilege. The TPRP only protects distinctive marks to allow effective competition by enabling competitors to access to common place, descriptive and generic words and symbols. Moreover, the EIPO is required to publicize trademarks in the official bulletin which creates an access to competitors to publicly registered and canceled trademarks. Finally, the registration of trademarks by the EIPO helps control subsequent applications to register marks that conflict with the registered mark.

On another note, the appraisal shows that there are teething problems during the determination of the competitive effects of well-known trademarks. The TPRP fails to define trademark infringement. This affects bringing successful infringement actions. It has no mechanism for the enforcement of unregistered marks nor are the civil remedies embodied there under comprehensive. Besides, the exclusive federal jurisdiction for administering and registering trademarks practically poses difficulties in terms of accessibility.

As to the compatibility of the tradename and competition regimes, the CRLP devotes certain provisions to supplement competition law. Firstly, during the registration of a trade name of a sole proprietor, the law requires the use of a different identification in respect of already registered trade names. Secondly, it imposes a duty against the registering office not to register a trade name which is identical or has misleading similarity to a previously registered trade name. Thirdly, it strictly regulates the conditions under which a substitute trade name can be issued in a way that seems to protect former competitors against confusingly similar trade names. Fourthly, there are grounds of cancellation and suspension of a trade name on account of fraudulent or erroneous registration which perhaps include the registration of confusingly similar trade names to the detriment of former trade name owners. Finally, the MoT is required to establish and administer a central commercial and trade name registration which has nationwide application and make information accessible to the public at large and competitors.

Nevertheless, the law does not spell out the trade name rights which renders hardly possible to invoke the infringement of tradename rights. There is no legal mechanism for the cancellation of the non-use of a trade name either. This affects free competition. Ethiopia has no a sui-generis system of rectifying situations of trade name violations. Supportively, the rules of unfair competition are referred to govern the violation of trade name rights.

The study further shows that the experts overlook the need to consider the relevant laws during trademark and tradename registration. This poses inconsistent registrations which could end up in litigations based on unfair competition. Nor do the respective authorities have the resilience towards coordination date. More importantly, the power bestowed upon the EIPO's Appellate Committee has provoked much controversy than solution. Also, the trademark and trade name owners encounter enforcement problems due the absence of a modern database relating to export and import activities on the port. Even more, the ten working days' time limit for releasing detained and seized goods by the ERCA falls short of allowing flexibility which may exacerbate the infringement of the trademark and trade name rights. Besides, sole and/or exclusive distributors tend to sue third parties importing or distributing goods or services lawfully bearing the trademark of a producer alleging that such acts constitute trademark infringements. Ethiopia does not have any policy to govern the country's domain name system. To be more specific, whether trademark owners have a superseding right to claim a domain name that is identical with their trademark is not legally addressed. Because of this gap, cybersquatting would become a common business in Ethiopia.

In view of the foregoing findings, the researcher suggests the following recommendations.

B. Recommendations

i. To determine the outcome of the conflicts between confusing trademarks and trade names, Ethiopia is advised to replicate the experiences of other jurisdictions. It should adopt China's jurisprudence concerning the rules of priority. The trademark regime has to recognize prior trade name rights during trademark registration. If the TPRP protects the characteristic title of another person's protected literary, artistic rights or right to a photograph or design as a relative ground of refusal for trademark registration,⁴⁰⁴ then, this provision can similarly apply to pre-existing, similar or identical trade name rights. In fact, until a clear rule of recognition is enacted on the subject, the legal deficiency can be rectified by judicial jurisprudence. In light of this, the role of courts is indispensable.

Alternatively, Ethiopia may espouse the reminiscent experience of Mongolia where trade names and trademarks are regulated under a single legislation and institution by incorporating dispute settlement provisions. To this end, Ethiopia is required to redesign its legal regime in a manner that the administration and registration of trademarks and trade names be run by the same organ—either under the EIPO or, under the auspices of the MoT. In Mongolia, if there is a discrepancy between trademarks and trade names, the trademarks shall prevail. The TPRP should include a prevalence clause of such a kind. The aforesaid measures may require legislative and structural amendment.

Yet another leeway, the MoT and EIPO should develop a unified data base during the registration of tradenames and trademarks. This option is more feasible in the short run. As juxtaposed to this, the registering experts in the MoT and EIPO should think through the relevant laws in the course of registration so as to do away with inconsistent registrations and spirit of unfair competition.

ii. Ethiopia should follow the institutional configuration of China where the Trademark Review and Adjudication Board is established under the Trademark Office to handle matters of trademark disputes. As things stand today, the Appellate Committee faces unconstitutionality issues. Also, the unilateral power of the Director-General to reverse, or approve the final decision rendered by the Appellate Committee appears to be awkward. Thus, the Appellate Committee and the Director-General should have an equal say in terms of collective decision making.

iii. The competition regime should make cross references to trade names, domain names, distributorship agreements, and trademarks. It should sufficiently recognize the doctrine of unfair dealing. The TCCPP has to include clear terminologies that need to be proved for invoking the exceptions pertaining to vertical and horizontal agreements. On top of that, the MoT should

⁴⁰⁴ TPRP No.501/2006, cited above, note 169, Art.7(1), (4)

conduct proper pre-intervention study so as to achieve the goals of the competition law. To better protect trademarks and trade names during IP litigation, the Adjudicative Benches of the TCCPP Authority have to be staffed with the requisite professional mix composed of trademark, tradename and competition experts.

iv. Article 4 of the TPRP is a poor draftsmanship which creates confusion as to the requirement of trademark registration. Thus, it should be captioned as '**Securing Protection through registration**' and be amended its wording as follows:

'Where an application for the registration of a mark has been registered in the register of the EIPO, the person in whose name that registration stands may, subject to the provisions of this Proclamation, secure protection for his mark by obtaining the trademark registration certificate which shall be binding on third parties in relation to any goods or services for which it has been registered.'

Connected to that, Ethiopia should also amend the conflicting provision pertaining to the protection of well-known trademarks i.e. Art.23 (2) and 7(2) in a way that neatly reconciles the contradiction. Up until it signs the normative frameworks of the international treaties, Ethiopia can make use of the bilateral trade agreements or else, customize the WIPO Guidelines to determine the well-known status of a trademark.

v. Ethiopia should enact an adequate trade name regime having enforcement provisions. That law should define trade name infringement upon indicating the normative frameworks of trade name rights for aiding successful enforcement. It should also incorporate a provision for the opposition and cancellation of un-used trade names to obliterate technical barriers to competition.

vi. A trademark infringement should be defined precisely and the lawsuit and registration system should not be exclusively destined to federal jurisdiction. The state institutions and courts have to be given with some powers particularly, when the defendants and registrants are regional bodies or sole proprietors. In fact, since the State Supreme Courts and State High Courts can concurrently exercise the jurisdictions of the Federal High Courts and First Instance Courts, respectively under the conditions of delegation provided for in the federal constitution, the federal jurisdiction provided by the TPRP for the adjudication of trademark infringements can be pragmatically decentralized. Regarding the trademark registration, the EIPO is vehemently advised to establish a decentralized, integrated and national data base system to which regional information and trademark registries can be forwarded like trade name

vi. The TPRP has to incorporate a clear legal mechanism for the enforcement of unregistered marks as well. To make the circle complete, it may take after the Brazilian law which protects

a bona fide user of an unregistered trademark and claim priority rights over a competing trademark application. The law must define the 'use of trademarks' in a more modern context than confining itself to the 'affixation standard'. This may be done by borrowing from China's Standard to the Trademark Review's relative standards.

- vii. The civil remedies embodied under the TPRP need to be phrased with the broadest possible latitude including change of trademarks; replacement of labels and withdrawal of websites.
- viii. The trademark and tradename laws should be accompanied by an up-to-date database system comparable to the **ASYCUDA** and **SIGTAS** on the port. A preemptive protection system for protection of trade names and trademarks could alert the owners of trade mark and trade name rights and provide information regarding the identification of damage. Moreover, the ten working days' time limit for releasing detained and seized goods by the ERCA, should be deleted and be replaced with 'reasonable time' to allow maximum flexibility by putting in place robust controlling mechanisms.
- ix. Third parties importing or distributing goods or services lawfully bearing the trademark of a producer must be protected from unwarranted trademark infringements suits by the sole distributors. On the other hand, those importing and distributing counterfeited products must be disciplined for trademark infringement on the motion of the trademark owner.
- x. Spurred by the modern age of commerce and internet, resolving ubiquitous domain name disputes and cybersquatting requires putting in place legal, administrative and technical frameworks. Accordingly, the legislature is expected to formulate a policy to govern the country's domain name registration system. It should further enact a clear rule demarcating the rights of trademark and domain name owners along with a dispute settlement mechanism thereto.
- xi. The GTPs have to indicate the nature of the particular competition and trademark regimes. The economic planning and of performance reports should show the percentage of trademarks and trade names supporting trade.

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