

ADDIS ABABA UNIVERSITY
COLLEGE OF LAW AND GOVERNANCE STUDIES
SCHOOL OF LAW



The Use and Regulation of Trademark in Ethiopia's Sports Industry

By: Tesfaye Dechassa Tolla

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A Thesis submitted to Addis Ababa University, the School of Law: in Partial fulfillment of the Requirements for the Degree of Master of Laws (LL.M) in Business Law

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

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Acronyms

WIPO World Intellectual Property Organization

TRIPS The General Agreement on Tariffs and Trade

WTO World Trade Organization

UK United Kingdom

US United States

EIPA Ethiopian Intellectual Property Authority

FDRE Federal Democratic Republic of Ethiopia

The Use and Regulation of Trademark in Ethiopia's Sports Industry

Chapter One

Research Proposal

1.1 Background of the Study

Nowadays, sport, particularly at the professional elite level, is considered as not only as mere leisure, but also a huge business industry.¹ Recent statistics shows that more than 3% of the world trade is covered by the sports industry.² Since intellectual property rights vests almost in every components of the sports industry, the significance of intellectual property rights in the commercialization of sports industry is huge.³ Trademark is the commonly used intellectual property rights and therefore, it is at the heart of the successful commercialization of sporting industry around the globe.⁴ In its recent statistics, the World Intellectual Property Office also reveals that about 14.3 million trademark applications were filed in 2018 across the world.⁵ Given the increasing trend of sports trademark utilization by sports persons around the world, it is therefore, easy to deduce from the above statistics that sports trademark share not little amount of trademark applications.

Trademark is a symbol used by a person in commerce or business to indicate the origin of his/her goods or services and thereby identify them from those sold or made by others.⁶ It includes not only names, words, symbols, but also as it includes shapes, sounds, smells and combinations of them, which help consumers, distinguish some products from others.⁷ Trademarks grant the owners an exclusive right to use them in the goods and/ or services; excluding the use of the same or confusingly similar trademark by others.⁸ This is to mean that trademark holder can use it

¹ Sharada Kalamadi, 'Intellectual Property and the Business of Sports Management' (2012) 17 Journal of Intellectual Property Rights 438

² Simon Gardner, *Sports law (2nd edn Cavendish Publishing Limited, 2001)* 1

³ Aswathy Sujith, 'Sports and Intellectual Property Rights- An Overview on the Indian Standards' 2 Journal of Legal Studies and Research < www.jlsr.thelawbrigade.com > accessed on 30 January 2020. **83

⁴ *ibid* 438

⁵ World Intellectual Property Organization, *IP Facts and Figures*, (2019), 7

⁶ Stephen M. McJohn, *Intellectual Property* (6th edn, Wolters Kluwer, 2019) 352

⁷ Szwajdler Pawel, 'The Protection of Sports Trademarks, in the Recent Case Law of the Court of Justice of the European Union' (2016) 6 Journal of Education, Health and Sport 259

⁸ Hilina Ashenafi, 'Trademark and Geographical Indications in Protecting Ethiopia's Agricultural Products and its Synergy with Ethiopia's Developmental Concerns' (LLM Theses, Addis Ababa University 2015) 1

himself/herself or it can license/assign it to someone else for consideration and no one can make use of this mark without the authorization of its holder. The use of a similar mark by another person in a way that it would likely to create confusion as to the source of the goods and/or services amounts to trademark infringement.⁹ This may happen when a person uses as a trademark a sign that is substantially identical with, or deceptively similar to the trademark in relation to goods and services for which the trademark is registered. International experience reveals that both civil and criminal remedies are provided for trademark infringement claims.¹⁰ It follows then that, in the absence of such a legal remedy for the infringement of trademarks, it would be very difficult to imagine the proper use and exploitation of trademark in the sports industry.

Brand building and exploitation has become the trend among sporting industries in the developed countries.¹¹ Sports association, sports event organizers and/or sports professional use their own unique slogans, taglines, logos and etc to build their brand all over the world and thereby generate lucrative amount of profits.¹² Through brand building professional sports teams in the developed countries have now become economically more very much powerful. Football clubs such as Manchester United, Real Madrid, and Barcelona are perfect examples among the most popular sports teams to make use of their brand names through trademark protection.¹³ Professional Sports men and women around the world have also become more commercially important than before.¹⁴ England football legend David Beckham for instance, has successfully filed and registered his name i.e., "David Beckham" as a trademark and earned millions of dollars through various sponsorship deals.¹⁵ Many other professional sports personalities around the world have also managed to own their sports related trademarks and generate profits out of it under the trademark law protection.

⁹ Barret R. Arthur, 'Always Protect Your Brand: Trademark Infringement Protection for Athletes Using Social Media Sites' (2014), DePaul Journal of Sports law 86

¹⁰ Merchant and Gould, 'Criminal Liability for Trademark Infringement - A collaborative International Study', (2021) 2

¹¹ Ugochukwu Johnson Amadi, 'Intellectual Property Rights in Sports; A Trick or Two Nigeria Can Learn From The Global Game' (2017) African Sports Law and Business Bulletin 1

¹² ibid

¹³ Sujith (n 3) 59

¹⁴ ibid

¹⁵ Paras Sharma, 'International Property Rights in Sports' (2020) International Journal of Creative Research Thoughts 2582

In Ethiopia, the use and exploitation of sports trademark is not known as such.¹⁶ No single Ethiopian professional sports man or women dare to have registered his/her sports related trademark this far.¹⁷ The world renowned Ethiopian athlete, Haile Gebresilessie for instance, has no registered sports related trademark with the Ethiopian Intellectual Property Authority (hereinafter the EIPA).¹⁸ Given the country's well placed position and recognition in the world athletics sport, specifically in the middle and long distance running, the non use and proper exploitation of sports trademark in the Ethiopia's athletics sports industry is very much worrisome.¹⁹ Its only very recently that some sport teams begun to file their own trademark with the EIPA for registration and yet with poor usage and exploitation.²⁰

Given the paramount importance attached to trademarks in general and sports trademark in particular, it is not surprising to learn that trademark is regulated under many international instruments and domestic national legislations as well. Madrid System which is administered by the World Intellectual Property Organization (WIPO) is the major international instrument to be mentioned in relation to the regulation of sports trademarks for it extends protection in many countries with a single sports trademark application. The TRIPPS agreement, that provides a uniform minimum definition for the term trademark is also another international instrument worth mentioning in relation to trademarks.²¹ The Nairobi Treaty, that protects the International Olympic Symbols and the Nice Agreement that provides for the International Classification of goods and services are also the major international instruments to be mentioned in relation to the regulation of sports related trademarks.

As far as the international experience is concerned, there is no distinction made between the regulation of sports related trademark and other trademarks and the provisions of trademark law in general law equally apply to sports trademark as well.²² By the same taken, Ethiopia's trademark

¹⁶ Interview with Feleke Bereda, Director of Trademark and Industrial Design Protection Development, Ethiopian Intellectual Property Office (Addis Ababa, 10 February 2021)

¹⁷ *ibid*

¹⁸ Interview with Abiyu Tesfaye, Assistant Managing Director, Haile and Alem International PLC, (Addis Ababa, 18 February 2021)

¹⁹ Interview with Ayalew Tilahun (Phd), Ethiopian Athletics Federation President Advisor at Ethiopian Athletics Federation (Addis Ababa, 10 February 20121)

²⁰ Interview (n 16)

²¹ Thomas Cottier, 'The Agreement on Trade Related Aspects of Intellectual Property Rights' [2005] 77

²² S. Pawel, (n 7) 261

legal regime that regulates trademarks in general also applies to sports trademark. In other words, there is no such a law called sports trademark law and it's the trademark law that governs the sports related trademarks as well. No distinction is also made between the different sports fields as regards to the governance of sports trademarks in Ethiopia.

1.2 Statement of the Problem

As far as the Ethiopian law of Intellectual property rights with respect to sports trademarks is concerned, there are different applicable laws that includes Ethiopian Intellectual Property Office Establishment Proclamation number 320/2003, Trademark Registration and Protection Proclamation number 501/2006, Trademark Registration and Protection Regulation number 273/2012, and Directive issued by the EIPA in January 2005 (Ethiopian calendar) to re-register trademarks. There are different problems associated with these laws as regards to the regulation of sports trademark is concerned.

To start with, trademark laws of Ethiopia that is also applicable to sports trademark lack consistency in defining what constitutes trademark. Whereas, any sign or combination of signs capable of distinguishing goods or services from similar goods or services constitutes trademark as per the EIPA establishment proclamation, a completely different definition is provided for the term trademark under the trademark proclamation as the later requires such a sign or combination of signs to be visible. This legal loophole gives the Ethiopian Intellectual Property Authority a wider and undue discretion in the interpretation of what constitutes trademark and not during the registration of sports trademarks.

A related legal problem is with respect to the phrase 'Public Morality' as used in the trademark law. The trademark proclamation doesn't define what constitutes "public morality". What is moral in some parts of the country may not be moral in another parts of the country and vice versa, in a diversified society like Ethiopia. Therefore, absence of qualifying terms attached to this phrase may cause practical problems during the registration of sports related trademarks.

Ethiopia's trademark law also lack clarity for it doesn't address whether the sports trademark should be used in commerce or not. This is very important in that if the registered sports trademark is not going to be used in commerce, it will not serve the very purpose of trademark law i.e., protection of marks to be used in commercial activities so that consumers will not be deceived with in

identifying the goods and services provided under such marks. Besides, the directive issued by the EIPA that provides for the re-registration of trademarks has turned in to ultra-virus law by setting additional procedural requirements not envisaged under the trademark legislations. In order to have registered its sports trademarks, the directive requires the applicant to furnish legal trading license to the EIPA together with the application form. Neither the trademark proclamation nor the trademark regulation provides for such a requirement to be complied with. A related legal gap is, the directive, apart from prescribing for the requirement of legal trading license as additional procedural requirement, fails to specify whether such license should relate to the provision of goods and services for which the sports trademark is going to be used. The specificity of the trademark law in this regard is very important in that it limits the discretionary power of the EIPA in the registration of sports trademark and thereby avoid if not minimize the confusion relating to the requirement of legal trading license during the registration of sports trademark by sports person who do not have a legal trading license that relates to the provision of the goods/services for which the trademark is applied.

The EIPA is duty bound to render advisory services on sports trademark matters to public, state, private organization and professionals' association as well as individuals and facilitating conditions that will help to create linkages between sports trademark owners and entrepreneurs who wish to exploit their trademark. Failure on the part of the EIPA to discharge these basic legal duties contributed its share to the very limited use and exploitation of sports trademark by sports persons in Ethiopia. Lack of awareness among the sports community in Ethiopia about the very nature of trademarks may also be cited as another major issue associated with the proper use and exploitation of sports trademark in Ethiopia. Therefore, the study will try to address all these issues.

1.3 Research Questions

Based on the above research problems, the study tries to addresses the following research questions:-

- What are the problems associated with the inconsistency between Ethiopian trademark registration and protection proclamation and Ethiopia's intellectual property Authority establishment proclamation in defining the term trademark?
- Does Ethiopia's trademark registration and protection proclamation apply to sports persons who are not traders?

- What is the problem associated with the phrase "public morality" as used but not defined in the Ethiopia's trademark proclamation during the registration of sports trademarks with the EIPA?
- Does Ethiopia's Trademark law require the legally registered sports related mark to be used on the goods/services to be provided for commercial activity?
- Is the implementing directive to re-register trademark issued by the EIPA compatible with trademark registration and protection proclamation number 501/2006 in requiring an applicant to hold a legal trading license the registration of sports trademark?
- What are the major practical problems on the part of the Ethiopian sports persons in the use and exploitation of sports trademarks?
- What are the major failures on the part of the EIPA in assisting the sports persons to use and properly exploit their brand names in the Ethiopia's sports industry?

1.4 Objectives of the Study

Major objective of the study:-

- To evaluate the recurring legal and practical problems manifested in the registration of sports Trademark in Ethiopia.

Specific objectives of the study are the followings:-

- To identify the deficiencies in Ethiopia's trademark laws in relation to regulation of sports trademark
- to examine whether the implementing directive to re-register trademark issued by Intellectual property rights office with regard to sports trademark is in congruent with the trademark registration and protection proclamation.
- To examine the practical challenges related to the use and proper exploitation of trademark in Ethiopia's sports industry.

1.5 Methodology of the Study

The study will employ doctrinal approach. It involves mainly examination of pertinent Ethiopia's trademark legal regime. Trademark Registration and Protection Proclamation no 501/2006, EIPA Establishment Proclamation no 320/2003,

Trademark Registration and Protection Council of Ministers Regulation no 273/2012, and Implementing Directive to Re-Register Trademark 2005 are the main pertinent Ethiopia's trademark legal regimes to be analyzed and scrutinized. In doing so qualitative method of interpretation will be employed. The study will also use non doctrinal (empirical) method in assessing the use and exploitation of sports trademark in Ethiopia and in analyzing the practical problems with regard to the use of sports trademark in Ethiopia. Data will be collected, analyzed and interpreted qualitatively.

As an instrument to collect data, the study employ both primary and secondary sources of data. Accordingly, it employs interviews of concerned personnel in the field as a primary sources of data more specifically on issues related with the practical use and application of sports trademarks in Ethiopia. A total of eleven persons will be interviewed and they will be selected based on their knowledge about the subject matter of the study because of their position and exposure to it. The secondary sources that will be used includes; trademark laws (including international instruments that deals with trademarks), books, journals, articles, working papers, news papers, archives internet sources and other literatures. To shed a light on the subject matter of the study, international experience of some selected countries and also experience of some selected professional sports personnel in relation to sports trademark will be discussed.

1.6 Significance of the study

The study:

- Will create awareness to the stakeholders on the legal regime and institutional framework governing trademarks in general and sports trademark in particular.
- will also tries to identify the main legal and practical problems associated with sports trademarks and hence, help the law making bodies to have consistent and workable sports trademark legal regime on the one hand and also help the Intellectual Property Rights Office of Ethiopia to be abided by the trademark legislations while issuing implementing directives and thereby aid the Authority to have a uniform practice of sports trademark registration system on the other hand.
- will also acquaint the stakeholders with the necessary knowledge as to the massive importance of sports trademark so that Ethiopia's sports industry will make the proper exploitation of trademark.

- Moreover, the study will serve as a basis for further research in the subject matter.

1.7 Limitations of the Study

The study is mainly based on the law and the practice at the EIPA in the registration of sports trademark. In addition to this, the practice of sports trademark in relation to some sports personnel and sports institutions are also made part of the study. Absence of previously conducted study on the subject matter made the study difficult to get materials that are directly related to the topic of the study. Besides, the study is constrained by inaccessibility of information from the relevant sports persons and sports institutions on the subject matter.

Chapter Two: The Use and Regulation of Sports Trademarks in General

2.1 Trademarks and Sports Industry

Sport, being part of popular culture since time immemorial, is going through a significant change and are ingrained in our lives and become an important part of our daily lives.²³ As a social activity many people participate in sport, either as amateurs or professionals, and many people observe it as spectators.²⁴ Our consumption of it is increasingly mediated through television, radio, newspapers, and other new technologies including different social media outlets.²⁵ Until very recently, sport has been viewed as a pure entertainment or leisure. In the modern era, however, where intellectual property rights have become a major source of revenue for the sports industry, the concept of sport has transcended from a mere leisure to a very lucrative business.²⁶ According to the study conducted recently, the sports industry accounts for over 3% of the world trade.²⁷ In this regard intellectual property rights are used as marketing tools towards the branding of sporting games, sponsorship, teams, celebrity status, and broadcasting and media deals.²⁸

The developed western world, in particular the US, UK and the European Union have already enjoying the utilization of intellectual property rights arising from sports industry.²⁹ Sports teams of these countries have now become economically significant and viable and hence, attracted multinational companies through marketing, merchandizing, promotion and brand building of professional sports teams.³⁰ Sportsmen and women have also become commercially more attractive than ever and the organizers of sporting events on international level have been able to accumulate huge finance by exploiting the marketable potentials that exist in sports.³¹

For a successful commercialization of various creative aspects of sports industry, therefore, intellectual property rights protection is of no choice. In the modern era of intellectual property

²³ Gardner, (n 2) 1

²⁴ *ibid*

²⁵ *ibid*

²⁶ J. Gordon Hylton, 'The Over-Protection of Intellectual Property Rights in Sport in The United States and Elsewhere' (2011) 43 *Journal of Legal Aspects of Sports* 43

²⁷ *ibid*

²⁸ Sujith, (n 3)

²⁹ Amadi (n 12) 1

³⁰ *ibid*

³¹ *ibid*

rights, at least three form of intellectual property protections may be extended to safeguard rights in Sporting industry.³² These are copyrights, Patent and Trademark Protections.

With regard to copy rights protection, the law of copyright originated out of a desire to protect the work of the author in their creative efforts so that they would be an incentive to produce such works. The promotion and marketing of sporting events and/or competitions, the artistic designs of the logos of both sports teams and sports competitions represent copyright.³³ The US, for instance has extended copyrights protection to broadcasts of live sporting events in 1976 statute.³⁴ It is argued that the special techniques of sports broadcasting that includes: instant replays, split screen shots and commentary by announcers, constitute creativity for authorship purposes.³⁵ Broadcasting rights, that follow from the contemporary conception of rights of copyrights, has therefore, proven to be the most lucrative source of income for the sports industry.³⁶ Reports suggest that FIFA, the governing body of world football, for instance has received an amount estimated to 1.2 billion Euro in television and new media broadcast rights in 2006.³⁷

Patents are intellectual property rights that are used to protect inventions and inventive processes which bestows the owner exclusive right to produce, commercially exploit, importing the invention, and prevent others from doing so.³⁸ In sports, the famous English Premier League, for instance has recently introduced, hawk-eye- goal-line technology and many others that assist the referees in making crucial judgment calls.³⁹ The technology used in a swim wear is inventive in nature and thus can be registered as a patent.⁴⁰ Likewise methods of placing golf ball, methods for training pitchers in baseball are some of sporting activities that have got patent protection in the US.⁴¹

³² F. Scott Kieff, Robert G. Kramer and Robert M. kunstadt, 'Intellectual Property Protection For Sports Move' [2009] 2 Santa Clara High Technology Law Journal 767

³³ Amadi (n 11) 5

³⁴ Hylton, (n 26) 51

³⁵ *ibid*

³⁶ *ibid*

³⁷ *ibid* 44

³⁸ M. McJohn, (n 6) 23

³⁹ Sujith, (n 3) 59

⁴⁰ *ibid*

⁴¹ Amadi (n 11) 6

2.2 The Role of Trademarks in Sports Industry

Trademark, as discussed in the preceding parts, by and large, refers to a sign that distinguishes a products (goods/services) of one undertaking from those of other undertakings. Trademark indicates the source of origin of a particular goods and/or services. As far as the relationship with sports is concerned, trademarks have an enormous role to play in sports industry.⁴².

With the increasing commercialization of sports around the globe, the sports industry has grown at very fast. Intellectual property rights such as trademark is very crucial in the growing commercialization of modern sports industry in the absence of which sports industry cannot become a commercially productive asset.⁴³ Trademarks in sports in general is very crucial in generating additional revenue channels particularly for sports persons whose careers will likely be short relative to their overall lifespan.⁴⁴ Trademark protects the goodwill and reputation of a sporting brand. The ability to protect and distinguish one sport team or club from the other is significant with respect to brand building and development.⁴⁵ Since branding plays an important role in creating value, interest and vitality in sport, sports trademark drives consumer loyalty and confidence in the quality and features of sporting goods and or services.⁴⁶ That's why professional men and women, sports teams, and sports events organizers as well, tend to register their names, taglines, logos, slogans, and etc as sports trademark.⁴⁷

The most popular example of sports event mark in the world, the interconnected rings of the Olympic Games for instance, is protected not because of the popularity of the Olympic Games, but also because of the legal protection that can be available for sports event marks.⁴⁸ Olympic Games, being an international event, is protected by the Nairobi Agreement at the international level.⁴⁹ At the national level, however, the international Olympic Committee makes it a prerequisite for any country that wishes to host Olympic Games, to protect the rings of the Olympic Games, by their respective special trademark laws.⁵⁰ Again in the US, the famous sports

⁴² Kalamadi (n 1) 438

⁴³ *ibid*

⁴⁴ Arthur (n 9) 91

⁴⁵ Amadi (n 11) 3

⁴⁶ *ibid*

⁴⁷ *ibid* 2

⁴⁸ *ibid* 4

⁴⁹ Nairobi Treaty on the Protection of the Olympic Symbol (adopted 26 September 1981)

⁵⁰ Amadi (n 11) 4

association, the National Basketball Association (NBA), has successfully registered a logo of a basketball player dribbling a basketball with the word NBA written adjacent to the logo.⁵¹ The Federation International de Football Association commonly known as, FIFA, has also registered different types of marks as trademarks, in 124 countries under 37 classes, which took it about 4,500 applications out of which 500 applications are lodged in South Africa alone.⁵²

Since recently, many individual athletes and other sports celebrities including coaches, have also been starting to generate millions of dollars, even after retirement from their profession, through trademark by successfully protecting their own brand names, nicknames, catchphrases, the name of their business endeavor and licensing of their names to third-party companies.⁵³ As a matter of fact, Professional sports men or women's physic won't allow them to continue dominating in their field of sport for a long period of time. Statistics reveal that, although professional sports men or women can make millions of dollars throughout their carrier, yet many of them eventually run out of money once their playing days are over.⁵⁴ Once they are separated from the sporting activities for whatever reason including retirement, they need to adjust and rebuild themselves to life outside sports. To this end, therefore, exploitation of their own names, which is a brand for creating business value, by itself, is of paramount importance.

It follows then that sports legends such as Michael Jordan Tiger Woods, David Beckam, Cristiano Ronaldo, Usain Bolt, Rodger Federer, Mohammed Ali, Kenennisa Bekele, Halie Gebressilassie, Derartu Tullu and many more are not mere professional sports persons but are brands themselves. The names of these and other sports celebrities can therefore, be trademarked. Businesses that put the names of these celebrities to a product can result in a massive increase in sales of its products.⁵⁵ Michael Jordan, who has retired from basketball some 17 years ago, for instance, has collected millions of dollars above and beyond his income from competing in sports by successfully exploiting his own name as a trademark.⁵⁶ Football legend Cristiano Ronaldo has a life time

⁵¹ Kieff, G. Kramer and M. kunstadt (n 32) 782

⁵² Roshana Klebrick, 'Ambush Marketing and the Protection of the Trademarks of International Sports Organizations - A Comparative View' [2020] Institute of Foreign and Comparative Law 29

⁵³ Brett Harris Pavony and Jaia Thomas, 'For the Love of The Name: Professional Athletes Seek Trademark Protection' (2012) 2 Pace Intellectual Property Sports and Entertainment Law Forum 157

⁵⁴ *ibid*

⁵⁵ Janine Hollesen, 'Trademarks: Sports and the Creation of Superstars' (2018) Legal Brief 1

⁵⁶ Hylton, (n 26) 44

contract with the Nike Company, worth around \$1 billion.⁵⁷ Nike Company which has produced products containing CR7, the famous registered sports trademark of Cristiano Ronaldo, that includes clothing, bags, footballs, boots and etc., in return has generated massive revenues from the significance and goodwill attached to this brand name.⁵⁸ He is also collecting lucrative amount of profits from Hotels opened under this brand mark, i.e., CR7. ⁵⁹ In 2010, Usain Bolt, "world's fastest man", has successfully registered versions of Bolt pose in the USPTO.⁶⁰ All these show that the use and exploitation of trademark in the sports industry around the world has become very popular.

Contrary to this, however, it is very sad, and even embarrassing to learn that the world renowned Ethiopian athletes or any Ethiopian sports personality does not make use of their golden brand names under trademark legal protection so as to make huge business out of it.⁶¹

2.3 Regulation of Sports Trademark

2.3.1 International Legal framework for the Regulation of Sports Trademark

A) The Madrid System

International trademark protection is regulated under the Madrid Agreement concerning International registration of Trademarks signed in 1881 (which comes in to effect in 1892) and Protocol Related to the Madrid Agreement 1989 (Madrid Protocol, effective January 1st 1996).⁶² The Madrid System, which is administered by the World Intellectual Property Office, hereinafter, WIPO, is a cost effective and convenient avenue for registration of trademark across the world.⁶³

Since the system allows holders of trademark to file a single application and pay one set of fees to apply for registration in member countries (currently around 122) and maintain and renew those marks through a single procedure, it helps sports trademark owners a cost effective and user

⁵⁷ Hollesen, (n 55) 1

⁵⁸ *ibid*

⁵⁹ *ibid*

⁶⁰ Montgomery McCracken, 'The Olympics, Usain Bolt, and Intellectual Property Law' (2016) Private Business Counsel

⁶¹ Interview (n 19)

⁶² Demson Tiopan and Shelly Kurniawan, 'The Politics of Law in the Madrid Protocol Ratification in the Form of President Regulation Related to Trademark Registration' (2020) 10 Technium Soc Sci J 248

⁶³ *ibid* 108

friendly way to protect their sports trademark in international markets.⁶⁴ It will guarantee the owners of sports trademark to properly use and exploit their sports trademark by protecting their mark from illegal use by others within the member countries. By doing so, the system therefore, encourages professional sports persons to properly use and exploit their sports trademark in many countries without facing significant hurdles. In the absence of such international legal protection framework, it will be difficult for professional sports persons who have already got worldwide recognition and built fame in the field of sporting activities to engage themselves in the use and exploitation of their commercial value containing brand names through trademarks. It is practically unfeasible for owners of sports persons to apply and have registered his/her sports trademark in each countries around the world. Madrid system is therefore, the pertinent avenue for those owners of sports persons seeking protection of their sports trademark in many countries with single registration. Had it not been for the existence of such an international legal framework, the very success of owners of many professional sports persons around the world in leveraging huge profits would have been questionable. International application of trademark under this system, however, presupposes that the applicant must have already registered or applied for registration of a mark in his/her domestic country.⁶⁵

Apart from the Madrid system, the Nairobi Treaty and Nice Agreement are the two international instruments that specifically deals with the regulation of sports related trademark worth discussion here.

B) Nairobi Treaty

Another international instrument worth mentioning here in relation to the regulation of sports trademark is the Nairobi Treaty. Nairobi Treaty is a WIPO administered treaty that obliges its member states to protect the Olympic symbol against any use for commercial purposes without the authorization of the International Olympic Committee (IOC).⁶⁶ According to the Treaty, the contracting parties shall have the obligation to refuse to register, or to invalidate the registration of a trademark that consists of the Olympic symbol. Apart from this, parties to the Nairobi Treaty

⁶⁴ Gerd Kunze, 'Introduction to Trademark Law and Practice', (1993), A WIPO Training Manual 108

⁶⁵ Tilahun Esmael, 'Protection of Well-Known Trademarks in Ethiopia: A Comparative Treatise Under The Trademark Proclamation' (2013) 1 Haramaya Law Review 99

⁶⁶ Phillip Johnson, 'Intellectual Property and Sports: Ambush Marketing' (2009) 14

shall also have the obligation to take the necessary measures that hinder the use of the Olympic symbol for commercial purposes.⁶⁷

The IOC may license the Olympic properties such as Olympic symbol, Olympic flag, Olympic emblem for profit making, commercial, and advertising purposes.⁶⁸ The Treaty is therefore, instrumental as regards to the regulation of sports trademark in that, once the IOC grants authorization to use the Olympic symbol in a state party to the Treaty, the National Olympic Committee of that State is entitled to a part in any revenue the International Olympic Committee obtains for granting the said authorization.⁶⁹

C) Nice Agreement

The Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks was established by an agreement concluded at the Nice Diplomatic Conference, on June 15 1957, and was revised twice in then after.⁷⁰ The Agreement has the purpose of creating a classification system for goods and services that would be used by countries to promote consistency in trademark classification within national trademark offices.⁷¹ The system would also make it easier for countries adhering to the Agreement to organize and administer the trademark applications and registrations that were filed in the national offices.⁷² A lists of 34 classes of goods and 11 classes of services are identified in the Agreement and member countries should use this classification system for the national registration of marks.⁷³ Moreover, it obliges the contracting states to indicate in official documents and in any publication they issue in respect of the registration of marks the number of the classes of the classification to which the goods or services for which the mark is registered belong.⁷⁴ International registration of sports trademark under the Madrid system also presupposes the use of the Nice classification.

⁶⁷ *ibid*

⁶⁸ *ibid*

⁶⁹ *ibid*

⁷⁰ Nice Agreement Concerning the International Classification of Goods and Services for the Purpose 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 as amended at Geneva on September 28, 1979 (hereinafter Nice Agreement) .

⁷¹ Jessie N. Roberts, '*International Trademark Classification: A Guide to the Nice Agreement*' (4th edn, 2012) 1

⁷² *ibid*

⁷³ *ibid*

⁷⁴ Nice Agreement, art 2(3)

Goods and services that has a lot to do with sports trademarks are identified and classified in different classes in the Agreement. Accordingly, class 25 of the Agreement for instance, that consists of goods like clothing, footwear, and headgears is the appropriate class for sports trademark owners who wants to use their trademarks on clothes, footwear, and/or headgears. The registration of the word "ARSENAL" as a trademark with the EIPO to provide sporting kits, jackets, hats, t-shirts and etc. badges, is a good example of the application of this class to sports related trademarks.

Class 28 of the Agreement that deals with the registration of trademark for games and playthings, gymnastics and sporting articles is also another appropriate class to be used in the registration of sports related trademarks.

With regard to service, entertainment, sporting and cultural activities are categories of services classified under class 41 of the Agreement.⁷⁵ The appropriate and suitable class for those sports persons who wish to register their sports trademark to be used in entertainment and other sporting and cultural activities is therefore, class 41.

To sum up, as far as the regulation of sports trademark in the international arena is concerned there is no specific sports related trademark agreement or instrument domestic that is applicable to the sports trademark alone. Unlike the Nairobi Treaty, which is applicable to sports related trademark alone, i.e., the protection of Olympic symbol, the Madrid System and the Nice Agreement, that deals with trademark in general are equally applicable to the sports trademarks as well.

2.3.2 Experience of Some Countries

The following section of the study highlights the experience of some selected countries as regards to the regulation and use of sports trademark. The following countries are selected merely because they have already established a robust trademark legal regime and the actual use or exploitation of sports trademarks in those countries is found to be exemplary to follow for our country Ethiopia. In the discussion therefore, emphasis is given to the major characteristics and departing dimensions of the trademark laws of the countries concerned.

⁷⁵ ibid art 41

A) USA

In the United States of America, trademark is governed by the Federal Trademark Act of 1946 which is known as the Lanham Act.⁷⁶ The regulation of sports trademark is no exception to this. In other words, the Act is equally applicable to trademarks involving sporting activities. The Lanham Act defines a trademark as:

"any word, name, symbol or device or combination thereof, used by a person or company, in order to differentiate his/her or its products, including a unique product, from the goods or merchandise of another, and to identify the source of those goods, even if that source is unknown"⁷⁷

In order to get sports trademark protection under the Lanham Act, it is mandatory for an applicant to register his/her mark with the United States Patent and Trademark Office, (USPTO), alleging to use or intend to use the mark in commerce.⁷⁸ The actual use of the mark by affixing the trademark to the goods or to point-of-purchase displays for them or an intent to use a mark in the ordinary course of trade, are means of establishing protectable exclusive trademark rights as per the Act.⁷⁹ Nonuse or absence of intention to use the mark in commercial activities shall therefore, be a bar to secure sports trademark registration under the US trademark Act. In other words, registration for sports trademark could only be secured for those persons who use the mark or intends to use it in trading activities. Hence, traders are the one envisaged under the Lanham Act. Professional sports persons or sports teams, or any other person, who want to have registered their trademark for purposes other than commerce are excluded from the ambit of the Act and therefore the Act doesn't protect sports trademark of such persons.

The requirement of providing using or intending to use the mark in the course of trading activities in the Act is very interesting in that, as its name implies the Act is nothing but Trademark Act which should worry about protection of marks used in trading activities no more and no less. Therefore, there is no reason for non-business persons to approach the USPTO for the registration of the mark they will not use in trading activities.

⁷⁶ Glenn M Wong, 'Recent Trademark Law Cases Involving Professional and Intercollegiate Sports' (1986) 1986 Det CL Rev 88

⁷⁷ Lanham Act (1946), 15 USC 1051-1127

⁷⁸ Pavony and Thomas, (n 53) 154

⁷⁹ *ibid*

Once registered, sports trademark rights continue to last indefinitely as long as the mark is in use directly or through a licensee; provided, however, that registrations must be renewed every ten years and a declaration of use must be filed during the sixth year after registration.⁸⁰ An owner of a sports trademark may use by himself his registered sports mark on various goods and services or he can also license to other person (in return for profits) so that they can make use of the mark on the products for which the mark is registered.

The use of sports trademark in the US is tremendous. The marketing of goods bearing professional sports person's name, sports team logos and etc. has increased over time.⁸¹ In 1989, an iconic US basketball coach Pat Riley, for instance, has secured registration of sports trademark for the term "three-peat", which indicates that his basketball team, Los Angeles Lakers has won a remarkable three consecutive championships.⁸² Riley's 'three peat' trademark is then used, among other things on T-shirts, hats, and jackets that is made available for sale. Following the registration of sports trademark by Pat Riley, many other professional athletes and sports figures have also managed to secure registration of sports trademarks.

Furthermore, the use of sports trademark among sports teams is also widely practicable in the US. Major professional sports team such as; the National Basketball Association (NBA), the National Football League, the National, and the Major league Soccer Hockey League, have successfully registered logos and symbols with the USPTO as trademark and leverage huge amount of profits out of it mainly through licensing of their registered trademark⁸³ They are now became a huge business empire by simply exploiting the commercial value attached to their respective sports trademark.

As discussed above, the use of sports trademark by different sports persons has become a common phenomenon in the US. It is therefore, not surprising to see numerous trademark infringement cases arising from the sports trademark in the US. When the use of a sports trademark by another would cause confusion as to the source of goods and services, it amounts to trademark

⁸⁰ *ibid*

⁸¹ Steven N Geise, 'A Whole New Ball Game: The Application of Trademark Law To Sports Mark Litigation' (1995) 5 *Seton Hall J Sport L* 555

⁸² *ibid* 156

⁸³ Avi Friedman, 'Protection of Sports Trademarks' (1995) 15, *Loyola of Los Angeles Entertainment Law Review*, 689

infringement.⁸⁴ The likelihood of creating confusion as to the source of the goods and services is a key factor in the determination of infringement claims involving sports trademark.

B) UK

In the United Kingdom, trademark is governed by the 1994 Trademark Act, and Section 1 of the Act defines trademark as "any sign capable of being represented graphically which is capable of distinguishing the goods and services of one undertaking from other undertakings".⁸⁵ From the above statutory definitions, the ability to create a visible distinction via graphical representation between two or more like products produced or supplied by different undertakings can be taken as the major characteristics of trademark. England's Manchester United football club greatest ever manager, Sir Alex Fergusson, for instance, has failed to register his name under the UK trademark act on the ground that it doesn't fulfill the requirement of distinctiveness.⁸⁶

The UK trademark legal regime is different from that of the US in that, unlike in the US, UK's trademark law requires graphical representation of the sign apart from its distinctiveness. It excludes invisible signs such as smell, that cannot be represented graphically from the ambit of registrable signs. The consequence is that a sports person who seek to have registered invisible signs like smell sign shall not be entitled to protection under the UK Trademark Act.

Furthermore, the use or intention to use the mark for commerce has not been made a requirement to have a trademark registration under the UK trademark Act. Unlike the US, the UK Trademark Act allows any person including non traders the right to apply for the registration of its trademark. Any sports personality may apply and get registration for its sports related trademark under the UK trademark legal system regardless of the use of such mark in trading activities. As per the Act, an owner of sports related trademark may use its trademark on products (goods and/or services) to be delivered to consumers for free without any gain from it. For instance, a sports association, may use its registered mark to be displayed on billboards while providing sporting entertainment services to the people for free without any commercial gain out of it. Therefore, so long as the sign is capable enough to identifies the source of a given product, it is immaterial whether the owner

⁸⁴ **Lanham Act, 15 U.S.C. § 1114**

⁸⁵ Amadi (n 11) 2

⁸⁶ *ibid*

of the sports mark has used it in commerce as per the UK trademark Act. As discussed with the case in the US, the need to use the mark in trading activities should be the issue the law of trademark should worry about.

This being the case however, the commercial use of sports trademark in the UK is very significant. In the UK, it has become increasingly popular for sports people to start to trademark their names to exploit their valuable image rights attached to their fame and to enforce the protection afforded by the trademark against unauthorized use.⁸⁷ World renowned football legends like; Alan Shearer and Michael Owen of England, for instance have managed to register their respective names under the UK trademark act.⁸⁸ They are generating handsome amount of profits out of it by using them in different ways.

The evolution of England football clubs such as Chelsea, Manchester United and Liverpool, among others, in to a profitable sports clubs has also a lot to do with the use and proper exploitation of their marketable values attached to their names.⁸⁹ In the absence of protection of trademark, it is difficult for these and other sports team to drive benefits out of their commercial value containing names.

C) INDIA

In India, trademarks in sports is protected under the provisions of the 1999 Trademark Act.⁹⁰ According to this Act, Trademark is defined as a mark capable of being represented graphically and which is capable of distinguishing the goods and services of one person from those of others and may include shape of goods, their packaging and combination of colours.⁹¹ From this statutory definition of trademark one may conclude that, India's trademark law is similar to that of the UK in that, in both of them, graphical representation of the sign is the basic element underlining the trademark apart from the distinctiveness of the sign. On the other hand, India's Trademark law is

⁸⁷ Amadi (n 11) 2

⁸⁸ ibid

⁸⁹ Sujith (n 3) 59

⁹⁰ ibid 61 .

⁹¹ sharma (n 15)

different from that of the US in that the US trademark law does not require a mark to be graphically represented.⁹²

Since India's trademark law does not provide the use or intention to use the mark in commerce as a pre-requisite for grant of registration, the owner of a given sports trademark may validly use its mark for activities other than commerce. This may help sports persons who wish to have registered their marks to be used on goods and services that may be made available to the people freely.⁹³

Given the massive commercial, benefits attached to sports trademark, however, sports industry in India has made significant use of sports trademark in commerce. After the coming in to force of the Act, which guarantees trademark holders, exclusive rights to exploit the commercial value inherent in their marks, sports in India has become one of the biggest industries in the country.⁹⁴ In India, commercialization of sports industry through brand building, has transformed the most popular sports, such as tennis, cricket, car racing and etc in to mega international events.⁹⁵

At this point it is very important to note that, as regards to the comparative experience of countries is concerned, all the substantive and procedural requirements set out in their domestic trademark legislations that provides for trademarks regulation in general are equally applicable to sports trademark. Simply put, as far as the comparative experience is concerned, division between sports trademark and other trademarks is not regulated in any legal act.⁹⁶ Since there is no unique feature inherent in sports trademark, particularly when the registered sports trademark is used on goods and services that are made available for commercial activities, the regulation of sports trademark under the general trademark law may be justifiable. The two basic elements of trademarks namely; existence of signs and distinctiveness of such signs for instance, are equally applicable to sports trademarks and other trademarks. If there is a difference at all, it is only in relation to the identity of the owners of the marks. In the case of sports trademarks, owners of the mark will be a sports persons who have already built their names as because of their on-field achievements in the sporting industries. In the case of other trademarks, owners may have no any sporting activities that is related to its trademark. Apart from this sports trademark and other trademarks are

⁹² Amadi (n 11) 2

⁹³ sharma (n 15)

⁹⁴ ibid

⁹⁵ Sharma, (n 15)

⁹⁶ pawel, (n 7) 261

essentially the same and there is no such as special thing with the sports trademarks that warrant its regulation separately from other trademarks.

Moreover, trademark rules apply irrespective of the category of sports field to which a given sports trademark belongs. No distinction is made between the different sports fields as regards to the regulation of sports trademark is concerned However, this does not mean that each field of sports are equally participating in the exploitation of the commercial elements of sports trademark. The more popular a given sports field in the world the better it exploits its trademark.

Chapter Three: The Use and Regulation of Sports Trademark in Ethiopia

3.1 Sports Industry in Ethiopia

Since ancient times, peoples of Ethiopia have had various traditional means by which they entertained themselves among which horse racing, wrestling, hokey, Stick fighting, and chess are a few to mention.⁹⁷ Emperor Libna Dingel (1508-1540) was an avid player of chess (*sentreji*) and that the game was popular among the Ethiopian nobility and the upper class.⁹⁸ Traditionally, raiding ability and prowess have been rated as the highest of manly virtues, and some of the most daring and highly honored acts of sportsmanship in horse racing, and that's why important personalities and rulers have being frequently referred to by the names of their horses.⁹⁹

However, at the turn of the twentieth century, modern sports games have been introduced and many of the traditional sports games begun to give way for the newly invented sports games.¹⁰⁰ Even though the above mentioned and other traditional sports are still practicable specially in the rural parts of Ethiopia, today, modern sports games began to attract the attentions of the peoples of Ethiopians.

Athletics and football are the most popular sports in the modern day Ethiopia.¹⁰¹ The country has recorded extraordinary success and achieved well deserved recognition in the middle and long distance running in the world athletics field.¹⁰² Ethiopia started to take part in Olympics in 1956 and since then the country have been continuously participating in various sports including Winter Olympic games.¹⁰³ Abebe Bikila, the first African to won the Olympic Gold medal in marathon at Tokyo, Japan, Olympiad was the first athlete to acquaint Ethiopia with the world in the field of athletics. One of the all time long distance running legend, Haile Gebrselassie of Ethiopia, has smashed world records 27 times during his splendid running carrier.¹⁰⁴ Ethiopian women Super

⁹⁷ Solomon Addis, 'A History of Sport in Ethiopia' Proceedings of the 16th International Conference of Ethiopian Studies (2009) , 410 <<https://www.scribd.com/document/63478304/Solomon-Addis-Getahun-A-History-of-Sport-in-Ethiopia>> accessed 17 January 2021

⁹⁸ ibid

⁹⁹ ibid 410-411

¹⁰⁰ ibid

¹⁰¹ Gemechu Beker Tufa, 'Assessment of Challenges and Opportunity of Basketball Developments in Some Selected Regions in Ethiopia' Journal of Education and Practice, (2015) 47

¹⁰² Interview (n 19)

¹⁰³ ibid

¹⁰⁴ ibid

star runners including, but not limited to, Derartu Tullu and Tirunesh Dibaba have also rocked the world in so many world athletics avenues and established their names as one of world legends.¹⁰⁵ Ethiopia has also registered one of its major success in the field of running by taking fifth rank during the 2008 Beijing Olympics.¹⁰⁶

As regards to the football industry in Ethiopia is concerned, Ethiopian national football team called, the "Walia Antelopes" have won the 1962 African Cup of nations and have qualified for the 2012 African Cup of nations. This being their major achievements to be mentioned, however, Ethiopia's football has not contributed a lot to the country's football industry as much as its popularity in the country.¹⁰⁷ In other words, despite its domestic popularity, the country's overall success in the world football and its contribution in terms of producing world class footballers is very insignificant.

Apart from running and football Ethiopians are also interested in basketball and its one of the countries in Sub-Saharan Africa that has first established basketball team.¹⁰⁸

In summary, despite the popularity of different sports games (both traditional and modern), sports teams, sports event organizers and/or sports professionals have not yet properly exploited the existing sports trademark in Ethiopia. More importantly, Ethiopian world super star athletes have not yet make use of their valuable brand names under trademark legal protection.

3.2 The Use of Sports Trademark in Ethiopia

As has been discussed in the preceding chapters, the concept of sport has transcended the context of a mere leisure and entertainment to become a significant revenue stream and a major contributor to economies all over the world. Nowadays, professional sports teams, sports event organizers, sportsmen and sports women, have become commercially important. In this regard trademark is one of the most commonly used intellectual property rights that is associated with sports. The logos, names, titles, slogans, tagline and etc of professional sports teams or professional sports man can be registered as trademark.

¹⁰⁵ *ibid*

¹⁰⁶ *ibid*

¹⁰⁷ Interview with Abrar Indris, Legal Service Department Head, Ethiopian Football Federation (Addis Ababa, 18 February 2021)

¹⁰⁸ Tufa, (n 98) 47

Despite the overall low status of Ethiopia's sports industry, however, there still exists very few sports that are so popular in the country. Football and Athletics more importantly running, are the two popular sports fields in Ethiopia. The more the sports industry become developed the better it is used in the trademark.

Overall, the use of sports trademark in Ethiopia is not known. This is mainly due to a very poor file management and recording system at the EIPA in making available data relating to sports trademark that will help to identify the sports persons who have managed to register their sports trademarks. Some of the sports clubs which have managed to register their sports trademark are also inaccessible to know the way they are using their marks. The case in point is the US based National Basketball Association (NBA). However, based on a limited empirical data obtained from different sources, the use of sports trademark in Ethiopia in some popular sports fields will be discussed below to provide an insight on the use of sports trademark in Ethiopia to some extent.

3.2.1 The Use of Sports Trademark in Athletics Sports

Undeniably athletics, more importantly running, is the only sports field that Ethiopia is best known for in the world. The country has produced many super star runners to the world who have waived Ethiopia's flag and made Ethiopia's national anthem sung louder on different major world sporting events although this does not mean that athletics sports industry is pretty much a developed sports field in Ethiopia. The very success of Ethiopian super star runners in the world athletics is however, not attributable to the country's well established athletics institution needed for the success of athletics sports but massive individual efforts from the athletes themselves and also their managers to some extent.¹⁰⁹

Nowadays, Ethiopia is known in the world for it contributed the all time long distant race legends such as; Abebe Bikila, Haile Gebrselassie, Derartu Tullu, Kenenisa Bekelle, and Tirunesh Dibaba among others. Given the massive and splendid achievements these athletes have registered during their decorated carriers on many world athletics events, they have already become brands themselves. Their names by itself is a valuable commodity.¹¹⁰ This being the general truth,

¹⁰⁹ Interview with Samuel Birhanu, Ethiopian Athletics Federation Training, Study and Research Work Team Leader, Ethiopian Athletics Federation (Addis Ababa, 17 February 2021)

¹¹⁰ Interview (n 19)

however, the commercial exploitation of sports trademark is very limited and Ethiopia's sports industry lags behind in the exploitation of sports trademarks.¹¹¹

One of the all time world's long distant Ethiopian runner Haile Gebreslassie for instance, has registered no single sports trademark with the EIPA.¹¹² Although Haile Gebreslassie is the world legend and his name is a valuable brand that can be exploited and be converted in to money, yet no effort is made by the athlete to use his brand name under sports trademark legal framework.¹¹³ Haile has long established his private business before he became know in athletics and currently he is one of Ethiopia's investors that own huge investment.¹¹⁴ Haile has received tantalizing amount of awards in cash so many times during his carrier as a long distant runner that helped him in further expanding his previously established business.¹¹⁵ Currently Haile is using Haile and Alem International Plc. as trade name, under which all of his businesses including Haile Resorts and Hotels are being run.¹¹⁶ So far he has registered about five trademarks with the EIPA including the most notable one that consist the word "Haile" that is used to run the business of Haile Hotels and Resorts.¹¹⁷ Unfortunately all his trademarks and businesses has nothing to do with sports trademark.¹¹⁸

Haile, is however, looking forward to make use of his precious valuable name under sports trademark legal framework both at domestic and international level although no practical efforts to that end is underway thus far¹¹⁹

In general, the exploitation of sports trademark by the by the Ethiopian super star athletes, who have established their brand names in the world, is nonexistent. They primarily focus on doing their on-field jobs tirelessly and become successful in their respective fields of sports contest.¹²⁰ Even those who have some knowledge of the importance attached to the sports trademarks in making business, they are reluctant in making use of their brand names under sports trademark

¹¹¹ ibid

¹¹² Interview (n 18)

¹¹³ ibid

¹¹⁴ ibid

¹¹⁵ ibid

¹¹⁶ ibid

¹¹⁷ ibid

¹¹⁸ ibid

¹¹⁹ ibid

¹²⁰ Interview (n 17)

legal framework.¹²¹ They are not curious in the exploitation of their brand names rather they are very much interested in making some sort of businesses with the money they received as an award from their job.¹²² They simply mention the country's overall development status in the management of sports trademark as a concern.¹²³

3.2.2 The Use of Sports Trademark in Football

As far as the football industry in Ethiopia is concerned, football have a big fans in and its pretty much a popular sport in the country. Although football in Ethiopia has a big fans and very popular, Ethiopia's Football National team (in both sex) is not known as such in the world football industry. During the May 2021 for instance, Ethiopia ranks 140 and 40 in the World and Africa respectively in the men's FIFA ranking chart.¹²⁴ Ethiopia's football clubs ranking in the world and in Africa's football ranking is also very poor.¹²⁵

The governing body of football in Ethiopia, the Ethiopian Football Federation, has its own distinctive logo. But it has not registered this logo or any other sports related trademark with the EIPA.¹²⁶ Since the Federation is established as the governing body whose task is confined to administrative activities as opposed to provision of goods and/or services, it has not approached the EIPA for the registration of its logo as trademark.¹²⁷ This coincides with the earlier established argument that trademark law is there just to protect marks used or to be used in commercial activities. The application for the registration of the Federation's logo as trademark for non commercial activities under the collective trademark provision may not also be successful for this provision is devised to allow only workers associations or associations to apply for the registration of trademark to protect the interests of their members as opposed to the association itself. Neither will the application for the registration of this mark under the well-known trademark may also be materialized for the provision is yet to come in to effect.

¹²¹ *ibid*

¹²² *ibid*

¹²³ *ibid*

¹²⁴ Interview (n 107)

¹²⁵ *ibid*

¹²⁶ *ibid*

¹²⁷ *ibid*

(Issues relating to collective trademark and a well known trademark provisions in relation to sports trademark will be discussed in detail later on under this chapter.)

It is only recently that football clubs found in Ethiopia began to make exploitation of the commercial aspects of trademark. In 2017, the Ethiopian Coffee Sport Club have applied to the EIPA to register trademark that consists a three dimensional sign and the name of the club both in Amharic and English. In the application form the club has made clear that they intended to use the trademark they requested for registration for the purpose of selling kits, shoes, scarps, hand badges, hats, wallets, flags, watches and etc. Up on securing the registration of its mark under class 35 according to the international classification of goods and services, the Club have embarked on to providing different kinds of goods most notably 'T-shirts' and badges to its fans.¹²⁸ The club make available the provision of these goods to its fans through the fans association.¹²⁹ The fans association is an independent association with its own legal personality established with the very objective of providing support to Ethiopian Coffee Sport club.¹³⁰ In 2013 (E.C.) only, the association has sold to its fans around 40,000 (fourthy thousand) trademarked T-shirts each for Ethiopian Birr 500.00 (five hundred birr).¹³¹ It can be said that the club is generating a handsome amount of money by using its registered trademark.

Although the club have already registered its sports trademark for the purpose of selling kits, shoes, scarps, hand badges, hats, wallets, flags, watches and etc., the use of the trademark is confined to selling of T-shirts and sometimes hand badges and scarps. Given the popularity of the club and the massive fans the club have in Ethiopia, it is safe to conclude that not using the registered sports trademark for all the purposes it was registered is a big blow to the club in missing over a massive profit that would have been made out of it.

Even the selling of T-shirts containing the club's brand name is also not properly utilized by the Ethiopia Coffee Football Club. The club makes order of the purchasing of the T-shirts once a year to be sold to the clubs fans who are members of the Ethiopia Coffee Sport Club Fans Association only. The T-shirts are also limited in number which means that all Ethiopian Coffee sports club

¹²⁸Interview with Solomon Tamirat, Vice President, Ethiopia Coffee Sport Club Fans Association (Addis Ababa, 14 March 2021)

¹²⁹ *ibid*

¹³⁰ *ibid*

¹³¹ *ibid*

fans will not manage to get it. The club being very popular in the country the limitation in the number of the branded T-shirts sold means it has not reached all people who wants to buy the brand T-shirt. This practice primarily hurts the club in that it denies the profit to be generated out of the improper exploitation of the registered trademark.

Very recently, Saint George Sports Association, the owner of Saint George Sports Club, is another Ethiopian Sports persons that has applied for the registration of its trademark under file number LTM/9786/2013 that consists a logo of Saint George on horse with spear and shield in his hand placed above the boldly written letter "V" and the name of the club included in a totally yellow colored background of the logo. Unfortunately the EIPA has rejected the association's application on the ground that the word "ጳጳጳ ጳጳጳጳጳ" i.e., "Saint George" in English, is contrary to the public morality the issue to be discussed in detail in the next chapter. The office has then, requested the association to make the necessary amendments in to its application within 90 days upon the receipt of the decision of the Authority. The case is still pending as it awaits for the response of the association. Hence, nothing can be said about its use and exploitation.

Manchester United Football Club Limited has also lodged a letter of application to register its brand name 'MANCHESTER UNITED' through its Ethiopian based agent in 22nd day of October, 2019. The EIPA has conducted substantive examination in to the application and decided that since the mark has fulfilled the substantive requirements set out under article 5, 6, and 7 of trademark registration and protection proclamation, it can be sent to press for cautionary notice.¹³² Although the Authority has decided to refer the application for publication to call for opposition in 17th day of December 2019, the applicant has never approached the office to take its trademark to press for publication upon paying the required fee to the office and hence, the application is still pending.¹³³

The applicant claims that the EIPA has not yet notified them the result of the examination to their application probably due to unexpected occurrence of the Covid-19 pandemic which interrupted their communication with office.¹³⁴ Despite the unforeseeable occurrence of the Covid-19 pandemic around the world, providing such a probable reason exposes the agents lack of real ambition and commitment to have registered the sports trademark they have applied. It is

¹³² Trademark Proclamation, art 5, 6 and 7

¹³³ Interview with Benyam Tafesse, Agent, Manchester United Football Club Limited, (Addis Ababa, May 10 2021)

¹³⁴ bid

ridiculous on the part of the agent of the club to fail to follow the progress of their application for such a long period of time as the office has not yet stopped its regular operation.

Coming to individual Ethiopian footballers, even though there are few famous footballers that are popular in Ethiopia, yet no Ethiopian footballer has registered any of his/her sports related trademark with the EIPA under trademark legal regimes.¹³⁵ Living Ethiopia's popular football star like Adane Girma, (Ethiopia's solo goal scorer against Zambia in the 29th African cup of nations held in South Africa in 2013), for instance, have not yet made acquaintance with the business of sports trademark.¹³⁶ Failure to exploit their valuable brand names by Ethiopian football stars may be partly attributable to the country's overall development status in protecting the trademark industry in general and low status of Ethiopia's football industry in particular.¹³⁷ The fact that many of the Ethiopian football stars do not even know the very concept of trademark and its exploitation in sports trademark also contributed a lot for non exploitation of sports trademark by Ethiopian celebrity footballers.¹³⁸ The use of sports trademark by the Ethiopian individual footballers is therefore, nonexistent.

3.2.3 The Use of Foreign Registered Sports Trademark in Ethiopia

An effort to have a complete data as to the exact figure of the active registered foreign sports trademark has failed due to poor file management system that helps to access the necessary information on the issue. However, according to the search made in to the archives at the EIPA, in relation to foreign sports trademark, so far Arsenal Football Club and National Basketball Association (NBA) are the two foreign sports teams that are found out to have secured registration of their respective sports trademark with the EIPA in Ethiopia.

Arsenal football club is an England based football club and has applied, through its agent, for the registration of its trademark i.e. its name "ARSENAL", to provide goods or different kinds of sports facilities (equipments) including sporting kits. The initial application of the club was rejected by the registration authority on the ground that the mark consists of only indications which designate the geographical origin of goods. But, later on up on finding that the there is no city in

¹³⁵ Interview (n 128)

¹³⁶ *ibid*

¹³⁷ *ibid*

¹³⁸ *ibid*

England called Arsenal that makes reference to geographical origin and the clubs popularity in the world which entitles it the well known trademark status, the registration Authority accepted the application and granted certificate of registration to the club categorizing the trademark under class 25 in international classification of goods and services.

When we come to the use and exploitation of this sports trademark in Ethiopia, so far the owner of the trademark i.e. Arsenal Football Club, has not made any use of it.¹³⁹ The club is reluctant to invest in Ethiopia using the registered trademark mainly because, the market in Ethiopia is not tantalizing as such.¹⁴⁰ No one has also taken the initiative to import and provide goods under the "ARSENAL" trademark by having some sort of agreement for instance, through license agreement, with the Club.¹⁴¹ The Club's agent, who have managed to secure the registration of the mark with the EIPA has given no power other than the registration work.¹⁴² The goods circulating in the Ethiopia's market that bears the "ARSENAL" mark are not the one provided by the Club and are out of the knowledge of the trademark holder. Even though the holder of the trademark have been made aware of the fact that its trademark is being used by someone else, they are not interested to go about the legal process of infringement claim for its too costly and difficult to trace the importer or domestic producer of the goods.

The Club is simply awaiting for a good day i.e., attractive market conditions to come in the country to inter into the provision of goods bearing the registered trademark.¹⁴³ Till then, the only thing they are worried about is just renewal of their trademark on time.¹⁴⁴

Interesting point worth discussion here is that, trademark law stipulates that non use of the registered sports trademark in Ethiopia, without legitimate reason or force majeure , for a continuous period of at least three years, by the registered owner or a licensee, may result in the cancelation of the registration of a sports trademark even before its initial term of protection comes to an end.¹⁴⁵ When we count from the date of the registration of the mark, i.e., June 8th, 2015, it

¹³⁹ Interview with Tamirat Assefa, Arsenal Football Club Public Limited Company Agent, (Addis Ababa, 25 September, 2021)

¹⁴⁰ *ibid*

¹⁴¹ *ibid*

¹⁴² *ibid*

¹⁴³ *ibid*

¹⁴⁴ *ibid*

¹⁴⁵ Trademark Proclamation, art 35

has gone beyond seven years without use. Therefore, the registered "ARSENAL" trademark should have been cancelled by the EIPA for disuse for a continuous period of more than seven years. Lack of attractive market for the non use of the trademark for such a long period of time after registration would neither be a legitimate reason nor force majeure for non cancellation. However, since no one has yet submitted a request to the EIPA for the cancellation of the mark on the above mentioned ground, the "ARSENAL" trademark is still protected under the Ethiopian trademark law.

NBA PROPERTIES, INC is also a foreign national (American) basketball institution that has registered its trademark in Ethiopia to provide entertainment service, namely organizing and conducting basket-ball exhibitions. It has registered the trademark that contains letters i.e. NBA and picture up on providing to the registration Authority a duly authenticated certificate of registration called home certificate, for the same type of service trademark it has registered in America. Under international classification of goods and services Education and Entertainment is categorized under class 41 and that is why the NBA PROPERTIES, INC. has registered its trademark service under class 41.

Since the clubs base in abroad and its agent unable to be accessed, the practical use of the registered trademark by this club is not known.

In general, in Ethiopia, sports teams, sports associations, sports event organizers and sports professionals, specially Ethiopian celebrity athletes, are not pretty much familiar with the concept of sports trademark.¹⁴⁶ Therefore, lack of awareness, about the very nature of sports trademark among Ethiopia's sports industry together with reluctance from some celebrity sports persons to exploit their brand names can be mentioned as one of the major practical challenges in relation to the use of sports trademark in Ethiopia.

¹⁴⁶ Interview (n 139)

3.3 Regulation of Sports Trademark in Ethiopia

In Ethiopia, legal protection of intellectual property rights in general is a recent phenomenon.¹⁴⁷ Since there has been little knowledge about the protection of intellectual property rights in Ethiopia, it was uncommon for the right holders to claim intellectual property rights despite extensive instances of infringements.¹⁴⁸ However, very recently in Ethiopia, rights holders have begun to appreciate the importance of attaching protection to intellectual property rights such as trademarks.¹⁴⁹

The current working trademark laws of Ethiopia includes Trademark Registration and Protection Proclamation¹⁵⁰ (herein after the trademark proclamation), the Ethiopian Intellectual Property Authority establishment Proclamation¹⁵¹, the Implementing Trademark Registration and Protection Regulation number 273/2012 and Implementing Directive to re-register trademark issued in 2005 by the EIPA).¹⁵²

As far as the international instruments are concerned, Ethiopia has signed and ratified very few instruments dealing with trademarks. Ethiopia has been a party to the Convention establishing the World Intellectual Property Organization (WIPO) since 1998 and a party to the Nice Agreement. Yet, the country has not ratified most international conventions governing the protection of trademarks like the TRIPPS Agreement.¹⁵³

As discussed in the preceding chapter the experience of other countries around the world reveal that there is no separate special sports trademark law that governs the sports industry trademark exclusively. The general trademark law applies to sports related trademark regardless of the use of such sports mark in trading activities. In other words, the trademark law that regulates trademark

¹⁴⁷ Sileshi Hirko, 'The legal Framework for The Protection of Geographical Indications in Ethiopia: A Critical Review' (2014) Journal of African Law 210

¹⁴⁸ *ibid*

¹⁴⁹ *ibid*

¹⁵⁰ Trademark Registration and Protection Proclamation, 2006, Art 6(1)(b), Proc No 501, *Fed Neg Gaz*, year 12, no 37 (hereinafter Trademark Proclamation).

¹⁵¹ Ethiopian Intellectual Property Rights Establishment Proclamation, 2003, para 1 of the preamble, Proc No 320, *Fed Neg Gaz*, Year 9, no 40 (EIPREP)

¹⁵² Implementing Directive to Re-Register Trademark 2005, Art 7(1), (unpublished, Intellectual Property Rights Office) (hereinafter the Directive)

¹⁵³ Hirko (n 106) 214

in general applies to the sports trademark with no exception. In Ethiopia too, the legal regime governing trademarks in general is also applicable to sports trademark. Moreover, Ethiopia's trademark law has no separate provisions that deals with and applicable to sports trademark alone.

3.3.1 Registration of Sports Trademarks in Ethiopia

Sports trademarks, like any other trademarks are generally acquired and therefore, be protected based on either use or registration.¹⁵⁴ Many countries prefer to have registration as a requirement simply because of the undisputable potential advantages registration of trademark yields in enabling third parties to discover whether other traders had claimed the right to use a particular sign and, where appropriate, to locate the proprietor of the sign.¹⁵⁵ Today, almost all countries around the world have trademark register, because full trademark protection can only be secured if registration is made.¹⁵⁶

Pursuant to Ethiopia's trademark law, ownership rights of sports trademark shall be acquired and then be binding on third parties, only when registration of sports trademark is made with the EIPA.¹⁵⁷ In other words, sports trademarks and their subsequent rights are conferred up on an owner upon the registration of the sports trademark and its certification which is initiated when an owner approaches the EIPA for such registration and certification. In the case of a well-known trademarks however, as long as such trademark is well known in Ethiopia and it is a trademark of a person who is the national of a state party to the convention; or domiciled in or has a real and effective industrial or commercial establishment in a state party to the convention, to which Ethiopia is a party, protection shall be extended to that well known trademark without having regard to the requirement of registration.¹⁵⁸

3.3.2 Persons Eligible to Apply for the Registration of Sports Trademark

Ethiopia's trademark law makes no distinction between physical and legal persons as persons entitled to apply for the registration of its trademark. Person, as defined under trademark proclamation shall include both physical and juridical person.¹⁵⁹ The same definition is given to

¹⁵⁴ Esmael (n 65) 95

¹⁵⁵ *ibid* 103

¹⁵⁶ Hylton, (n 26) 11

¹⁵⁷ Trademark proclamation, art 4 and 8(1)

¹⁵⁸ Trademark proclamation, art 23(1)

¹⁵⁹ Trademark Proclamation art 2(9)

the term person under the trademark regulation.¹⁶⁰ Furthermore, although we cannot find such an expression in the trademark law that reads "any person" may apply for the registration of its sports trademark, trademark law provisions sometimes refer to legal persons while addressing requirements of registration. For instance, this can be evidently seen under article 9(1) of the trademark regulation that reads "if the applicant is a legal person..." In the a contrario reading of this provision, physical person is implied. The conclusion is therefore, both physical and juridical person are eligible persons to seek application for the registration of their sports trademark. The question remains, however, is can a person (either physical or juridical) who is not a trader eligible to apply for the registration of its sports related marks?

To start with, protecting the reputation and goodwill of a business person engaged in manufacturing and distribution of goods and rendering of services so that it may not be confused with between similar products is one of the main justifications for the trademark law to come in to being.¹⁶¹ Economic advancement, particularly trade and industrial development of the country are also the rationales behind the legal protection of trademarks.¹⁶² All these justifications in general imply that protecting the marks of businesses so that consumers will not be deceived with products containing similar marks are all about the concern of the law of trademark. On top of this, the EIPA directive requires any domestic sports trademark applicant to submit to the EIPA legal trading license together with the application for registration of sports trademark.¹⁶³ According to Ethiopia's Commercial Registration and Licensing Proclamation, trading license is given to a business person who engage in commercial activities.¹⁶⁴ Commercial activities as defined under Ethiopia's Commercial Registration and Licensing Proclamation constitutes activities specified in the Commercial Code as commercial activities or those commercial activities designated as such by other law that is carried on professionally and for gain by a person.¹⁶⁵

Hence, business person as opposed to non business person is/are implied in Ethiopia's trademark law. Moreover, trademark, as its name implies refers to a mark that is used in the course of trade

¹⁶⁰ Trademark Regulation art 2(8)

¹⁶¹ Trademark Proclamation, para 1 of the preamble

¹⁶² *ibid*, para 3 of the preamble

¹⁶³ Directive 2005 art 7(1)

¹⁶⁴ Commercial Registration and Business Licensing Proclamation, 2003, art 6(1), Proc No 980, Fed Neg Gaz, Year 22, no 101 (hereinafter Commercial Registration and Business Licensing Proclamation)

¹⁶⁵ Commercial Registration and Business Licensing Proclamation art 2(2) (3)

and nothing else. Therefore, trademark law is there to protect marks used in commerce as opposed to marks not used in the commercial activities. It follows then that, persons who do not use or intends to use its mark on goods and/or services to be used in the course of commercial activities are excluded from the ambit of trademark law.

This being the general rule however, Sports person/s by using their sports related mark may engage in the production of goods and supply of services not to be used for profit making purposes but still wants to have their marks protected by law. The implication of consumer interest protection as the other major objective behind trademark law may therefore, necessitate the protection of sports trademark for those persons who do not do commercial activities with the mark. However, Ethiopia's trademark law is very rigid to accommodating those persons who do not do commercial activities with their mark. The trademark law nowhere provides for the extension of trademark protection to those person/s who do not do business with the mark apart from the cases of a well known trademark and collective trademarks as will be discussed in detail later on below.

A) Individual Sports Persons

Ethiopia's sports trademark law simply tries to provide a definition for the term trademark without however, specifying the status of the persons eligible to apply for registration of sports trademark. More specifically, unlike in the case of collective trademark, where non traders like trade unions, trade union federations or associations can apply for registration of collective trademark to protect the interests of their members, Ethiopia's trademark law doesn't specifically and clearly address whether a sports person who is not running a business and wants to use the mark for non commercial activities, may apply for the registration of its mark.

As explained above, from the reading of the preamble of the trademark law that provides for protection of marks of business persons and the directive issued by the EIPA that requires a person to hold a legal trading license as a pre-requisite for the grant of trademark registration certificate, individual business persons to the exclusion of non business persons are the one the law extends trademark protection. The consequence is that, individual sports person who wish to have registered his/her sports trademark should make use of its mark to be used on goods and/or services to be made available for commerce. For instance, if Haile Gebresillasie of Ethiopia wants to register his brand name as a sports trademark with the EIPA, it is mandatory for him to have a

legal trading license and hence, he has to be a business person. No individual sports person is permitted to have a valid sports trademark or even any other trademark other than well-known trademarks according to Ethiopia's trademark law in the absence of a legal trading license.

In the case of a well known trademark however, whether a person carries on a business with a sports related mark is immaterial to have trademark protection under the trademark law. So long as a given sports mark is well known in Ethiopia, protection is extended to that mark regardless of its use in commerce.¹⁶⁶ Therefore, trademark of any sports person that is well known in Ethiopia and also accorded protection under international conventions to which Ethiopia is a party, may be protected by trademark law even if the owner of that trademark is not a business person. The problem here is the application of this provision has not come into effect as Ethiopia is yet to be a party to international conventions that extends trademark protection to well known trademarks. In the example above, world known Ethiopian athlete Haile Gebresillasie does not benefit from the application of a well known trademark provision unless Ethiopia is a party to international conventions that recognizes and extend protection to a well known trademarks. The importance of the provision dealing with a well known trademark should not be underestimated as it incorporates those sports person who wish to have their sports trademark to be protected by law although they are not doing commercial activities with the mark. Most importantly professional sports person who are devoted to provide goods and services under their well known trademark to those in need for no profit may be protected by under this provision.

B) Sports Associations and Sports Federations

In Ethiopia, there are many sports related associations and federations that have their own legal personality. Ethiopian Athletics Federation, Ethiopian Football association, Ethiopia Coffee Sport Club Fans Association are typical examples to be mentioned. Since they have their own legal personality, they are legal persons as per the trademark law and can apply to have registered their own trademark. The problem is however, these persons are not traders and they do not do business. The principle is that, trademark law does not protect marks of non business person who do not engage in commercial activities for the simple reason that they are not traders and they do not make use of their mark in commercial activities.

¹⁶⁶ Trademark Proclamation, art 23(1)

Exceptionally, however, Ethiopia's trademark law has dealt with the marks of members of non business persons such as workers associations or federations separately under the provision of collective trademarks. Accordingly, workers association or federations may, to protect the interests of their members, apply for the registration of collective trademarks.¹⁶⁷ The trademark law spares these persons from the requirement of producing legal trading license to have registered their marks.¹⁶⁸ Instead they are only required to submit a statute governing the use of the collective trademark together with the application for trademark registration.¹⁶⁹ Here two major issues may be raised with regard to the framing of the trademark law provision dealing with collective trademark and its practical application by the EIPO.

The first issue relates to the discrepancy of the trademark law that is manifested between the Amharic and English versions of the provisions dealing with collective trademarks. Whereas, the Amharic version of the trademark law provides for workers associations or federations as persons eligible to apply for the registration of collective trademark, in contrast to this however, the English version of the same law provision provides for trade unions, trade union federations or associations as persons eligible to apply for the registration of collective trademark.¹⁷⁰ Since the Amharic version of the provision is the governing version of the law by as per the FDRE constitution¹⁷¹, there is no room for sports association to be accommodated under persons eligible to apply for the registration of collective trademark. In other words, since the Amharic version of the trademark law provision nowhere mentions associations as a person eligible to apply for the registration of collective trademark sports associations are not eligible enough to have a successful registration of their sports trademark.

The second major issue worth discussion with respect to collective trademark is the actual application of the collective trademark provision by the EIPA in the registration of trademarks. From the very inception collective trademark is trademark registration mechanism devised to protect the interests of members of workers association or federations as opposed to the interest of the workers association or federation itself. The practice at the EIPA however, doesn't accord with

¹⁶⁷ Trademark Proclamation, art 19

¹⁶⁸ *ibid* art 18(1)

¹⁶⁹ *ibid*

¹⁷⁰ *ibid* art 19

¹⁷¹ Proclamation of the Constitution of the Federal Democratic Republic of Ethiopia, 1995, art 106, Proc. No 1, Fed Neg Gaz, Year 1, no 1 (FRDE Constitution)

the wordings of the trademark law as any sports association or sports federation can successfully apply for the registration of its sports trademark. The only thing they are required by the EIPA is just to have a statute governing the use of a registered trademark.¹⁷² The problem is that allowing workers association or federations or any other association/sports club for that matter to apply for the registration of its sports trademark under the guise of collective trademark contradicts the trademark law because the provision is meant not to allow such entities to apply for the registration of their sports trademark by themselves. The trademark law provision that deals with the registration of collective trademark therefore, is not adequate enough to encompass non business persons such as sports associations, sports federations, sports clubs and etc, who wish to register their sports trademark.

3.3.3 Substantive Requirements for Registration of Sports Trademarks.

Trademarks, as defined by the trademark proclamation, is any visible sign that is capable of distinguishing goods or services of one person from other persons; and it includes words, designs, letters, numerals, colours or the shape of goods or their packaging or the combinations thereof.¹⁷³ Visibility of a sign and capability of that sign to discern the goods of one person from the other persons, are the two decisive elements that must be considered in the registration of a given sports mark as a protectable sports trademark.

A) Visibility of a Sign

The first basic requirement to have registration of sports trademark, as per the trademark law is the need to have a visible sign. Any sports persons, who is eligible to apply for the registration of sports trademark, as discussed above must come up with its own sign which should also be visible. In most of the cases professional sports persons tempt to use their names, slogans, catch phrases, poses, and celebration styles and etc, as a mark to be registered as trademarks. These are some examples of marks in the sports arena that constitute the element of visibility of a sign. These marks, as being closely associated with the sporting activities of such a person on the field, have the capacity to catch the attentions of their followers and thereby force to have interest in goods

¹⁷² Interview, (n 16)

¹⁷³ *ibid* art 2(12)

and services that contain the marks. This in turn will boost the economic capacity of sports person by adding revenue to the one they gain from their on-field activities.

In summary, Ethiopia's trademark law doesn't extend protection to sign that is not capable of being seen. A sports person who seek to apply and get registration of its own unique sound mark it has created during sporting activities for instance, will not succeed in the registration of the mark for one thing sound mark is specifically mentioned as marks inadmissible for registration.¹⁷⁴ and for the other, sound mark is unconventional mark that is not seeable though graphical representation of sound mark may be made possible by converting it in to a visible words, letters, or any other visible mark..¹⁷⁵

B) Distinctiveness of a Sign

The second basic substantive element the law requires is distinctiveness of signs. As discussed above, sports trademark primarily serves to indicate the origin of goods and/or services. A sign is said to be distinctive for the goods and/or services to which it is to be applied, only when it is recognized by those to whom it is addressed as identifying goods/services from a particular trade source, or is capable of being so recognized.¹⁷⁶ Distinctiveness of a sign can therefore, be defines as the capacity of a mark to distinguish a product or services which originates from one source from products or services originating from other sources.¹⁷⁷ A non distinctive sign cannot serve the consumer to identify the goods and/or services of his choice and hence, not eligible for registration as protectable sports trademarks under the Ethiopian trademark law.¹⁷⁸

The distinctiveness of a sign may take different degrees depending on the nature of certain typical categories of marks used.¹⁷⁹ Fanciful or coined trademarks are categories of marks devoid of meaning.¹⁸⁰ Consumers are usually at difficulty to associate such marks to the product they represent even if such mark is not deceptive to consumers.¹⁸¹ It does not let consumers to trace back the origin of the product under the mark. Again common words that are used arbitrarily in

¹⁷⁴ Trademark Proclamation, art 6(2)

¹⁷⁵ Ashenafi (n 8)

¹⁷⁶ Kunze (n 64) 17

¹⁷⁷ N Geise,(n 81) 559

¹⁷⁸ Trademark Proclamation, art 5(1)

¹⁷⁹ Kunze, (n 64) 18

¹⁸⁰ ibid

¹⁸¹ Ashenafi (n 8) 25

the ordinary course of life may be distinctive enough to identify the origin of the product only if they communicate a meaning that is arbitrary in relation to the products on which they are used. Otherwise such marks does not let consumers know and thereby identify the connection between the mark and the product on which such mark is used.¹⁸² Exclusively descriptive marks that describe the qualities, ingredients, or characteristics of a product may also lack the element of distinctiveness. The justification is that consumers generally appreciate brand names that have a positive association with the product on which the mark is used which should therefore, be less descriptive one.¹⁸³ Distinctiveness of a sports marks can therefore, be identified depending on the typical category of a sign used in a particular case.

In general, owing to the significant brand recognition of professional sports person, consumers in the market place can easily associate a professional sports person trademark with the person it belongs to¹⁸⁴ Therefore, although a professional sports person can prove to it that his sign is visible he will not get registration of that mark with the EIPA, unless it can also prove to it that such a sign or mark must be capable of discerning the goods and/or services of one person from those of the other.

C) Denial of Trademark Registration on the Ground of Public Morality

Although the two substantive conditions discussed above are fulfilled, there are however, exceptional cases under which registration may be denied as inadmissible for it does not fulfill the requirements set out under article 6 and 7 of the trademark proclamation.¹⁸⁵ If a sports related trademark is of such a kind that it is contrary to public morality it may be inadmissible for registration.¹⁸⁶ However, the trademark law does not define what constitutes public order or morality. Public morality as defined in a famous Black's Law dictionary, is the ideals or actions of an individual to the extent that they affect others.¹⁸⁷

¹⁸² Kunze, (n 64) 17

¹⁸³ *ibid*

¹⁸⁴ Abby R. Glaus, 'The Intersection of Trademark Law, Athletes, and Money: A "Three-Peat" (2022) *Marquette Sports Law Review* 592

¹⁸⁵ Trademark Proclamation, art 6 and 7

¹⁸⁶ Trademark Proclamation, art 6(1)(d)

¹⁸⁷ Bryan A. Gardner, 'Black's law Dictionary' (8 edn.2004) 1030

In connection with this, the EIPA has recently rejected the sports trademark registration application made by Saint George Sports Association', the owner of Saint George Sports Club for it is contrary to public morality. The association has applied for the registration of its sports trademark that consists a logo of Saint George on horse with spear and shield in his hand placed above the boldly written letter "V" and the name of the club included in a totally yellow colored background of the logo under file number LTM/9786/2013. Up on conducting an examination as to the form and substance of the application, the EIPA has found out that the word "ጳጳጳ ጳጳጳጳጳ" i.e., "Saint George" in English, is contrary to the public morality and rejected the application for the registration of the mark. In its decision the EIPA has provided no detailed reasoning and explanation for its rejection of the application. The decision of the EIPA only states that the word "ጳጳጳ ጳጳጳጳጳ" is contrary to the public morality.

In the above sports trademark application case although the Authority has provided no detailed explanation and reasoning, the fact that the word "ጳጳጳ ጳጳጳጳጳ" is being widely used and worshiped by Ethiopian Orthodox Christian society, seems the rationale behind the rejection of the application by the EIPA for it may go against the ideals or actions of the followers of Ethiopian Orthodox Christianity. The decision of the EIPA may not be welcomed for instance, by followers of other religions, who are indifferent about the mark. Given the fact that Ethiopia is a country exhibiting a very diverse religious society, the insertion of such an unqualified phrase in the trademark law may cause practical problems in the registration of sports trademark as it leaves wider and undue discretionary power to the trademark registration organ i.e., the EIPA. The implication of the EIPAs' decision in this regard is that Saint George Sports Club should be forced to change its name relating to Christianity religion for the purpose of registering its sports brand name. Changing the already built brand name to new name will not however, be seen easy as it looks at first glance. It might not be easy for the club to win back the hearts of its fans who are attached to it simply for the clubs name relates to Christianity religion. The fame and reputation of the club with the change of its name may therefore, be ruined and this may have a far reaching repercussions on the very existence of the Club.

3.3.4 Procedural Requirements for Registration of Sports Trademark

When registration for a sports trademark is initiated and claimed by a potential owner or legal representative of a sports trademark, in general, four steps namely; application, examination of

application, publication of notice, and registration are involved in the process of approval and certification of a trademark. The following section discusses the four steps in the registration of sports trademark.

3.3.4.1 Application for sports trademark

The first procedural step in the registration of sports related trademark is application. At this stage the applicant must submit his application to the EIPA in writing.¹⁸⁸ Since medium of communication with the EIPA, is English and Amharic, the application and any accompanying documents shall be filed in the same languages or translations of those documents in to English or Amharic.¹⁸⁹ Like any other trademark an application for registration of sports trademark shall be accompanied by the necessary documents set out in the trademark laws including the directives.

Accordingly, it is mandatory for a national sports trademark applicant to submit legal trading license to the EIPA together with the application for registration of sports trademark in addition to those documents listed under article 8 of the trademark proclamation and article 9 of the trademark regulation¹⁹⁰. If the applicant is a foreigner, an authenticated legal trading license given by a competent authority in a foreign country or a certificate of sports trademark registration in a foreign country should be furnished.¹⁹¹

The requirement of lodging a written application together with the necessary documents as the requirement to go about the registration process is clearly provided in the trademark proclamation and trademark regulation. A further procedural requirement is also provided under the directive issued by the EIPA in 2005 for the implementation of the trademark regulation i.e., implementing directive to re-register trademark. The directive requires any domestic sports trademark applicant to submit to the EIPA legal trading license together with the application for registration of sports trademark.¹⁹² This requirement is completely lacking both in the Ethiopia's trademark proclamation and trademark regulation.

¹⁸⁸ Trademark Proclamation art 8(1) and Trademark Regulation art 3(1)

¹⁸⁹ Trademark Regulation art 4(1) (2)

¹⁹⁰ Directive art 7(1)

¹⁹¹ *ibid* art 7(2)

¹⁹² Directive 2005 art 7(1)

As has been established in the discussions above, since the whole purpose of the trademark law is the protection of marks to be used in commercial activities so that consumers could easily distinguish the goods and/or services through the mark, the need to hold a legal trading license for the registration of sports trademark may not be considered as weird and unwarranted. At least two major problems are however, identified with the addition of this requirement by the directive. The first one is the EIPA, by prescribing such additional requirement as a precondition for the registration of trademark, is not only acting beyond its power but also creating a mess in the registration of sports trademark in practice. The EIPA acts beyond its power in the sense that all what is given to the office is just to issue directive necessary to implement the trademark proclamation and regulation and this should not allow it to go further and provide for substantive or procedural requirements not envisaged by its superior laws. The directive should limit itself in setting the necessary guidelines for the smooth functioning of the trademark proclamation and trademark regulation. The other is trademark law also leaves room for non-business persons to apply and register for sports mark. The result is therefore, the addition of the legal trading license requirement by the EIPA will exclude such sports persons who do not have a legal trading license. Moreover, this has also led the EIPA to miss interpret and apply the trademark proclamation provision dealing with collective trademark for the purpose it has not intended.

The second problem associated with the procedural requirement of legal licensing is, the directive fails to specify whether the legal trading license an applicant need to produce should relate to the one given for the provision of goods and services under which the sports trademark is going to be used. As per the directive, an applicant having any valid trading license in its name may be allowed to have registered its sports trademark. If any applicant is going to be allowed to have sports trademark certification merely up on producing any legal trading license in its name which has of course nothing to do with the provision of goods and services that bears the sports trademark to be registered, it will not serve the very purpose of the trademark law i.e., protecting trademarks used in commerce. However, the above general arguments and conclusions should not be confused with the exceptional cases of a well-known trademark and collective trademark where the law extends protection even to sports trademarks even if its owner is not a business person.

3.3.4.2 Examination of Application

The second step in the registration of sports trademark is examination of application. Upon receiving the written application of the applicant, the EIPA will examine the application as to its substance and form, in particular whether the substantive requirements are complied with. An interesting sports trademark case worth mentioning here is the above discussed Saint George Sports Association's sports trademark application. The office, after examining in to the content of the application has rejected the application for the registration of sports trademark by the association for it is found contrary to the public morality. Utmost care should be done in the examination of the contents of the application to avoid such kinds of unwarranted decisions by the EIPA.

3.3.4.3 Publication of Notice

Where application proves sufficient under examination, then the EIPA proceeds to the next step i.e. publication of notice of invitation for opposition to let third parties whose interest is at stake to lodge its objection to the application.¹⁹³ An opposing party will have to, within a prescribed time limit, present his issues to the EIPA in writing, a copy of which will be served to the applicant.¹⁹⁴ The applicant then, will be expected to present his counter report the failure of which amounts to abandonment of his application.¹⁹⁵

In the application for registration of sports related trademark by Manchester United Football Club Limited for instance, the EIPA after finding out that the mark has fulfilled the substantive requirements set out under article 5, 6, and 7 of trademark registration and protection proclamation, decided the mark to be sent to press for notice. Although the office has decided to refer the application for publication to call for opposition in 17th day of December 2019, the applicant has never approached the office to take its application to press for publication upon paying the required fee to the Authority. The applicant says the office has not yet communicated to them its decision of referring the case to press for publication of notice.¹⁹⁶ On the other hand, there is no evidence in the file kept at the EIPA that proves the office has yet communicated its decision to the applicant.

¹⁹³ Ibid art 13

¹⁹⁴ Ibid art 13(2)

¹⁹⁵ Ibid art 13(3)

¹⁹⁶ Interview (n 133)

Had it been proved that the Authority have had communicated its decision to the applicant, the application for the registration of the trademark would have been considered as abandoned once 60 days have lapsed from the date of receipt of the decision by the applicant.¹⁹⁷ The requirement for publication of notice should not be taken lightly as it will give any interested party particularly those who have already registered or applied to register their sports trademark to object to the application before the occurrence of any damage. Despite this however, during the trademark registration process for the sports related trademarks that have secured registration for their mark with the EIPA, no one has launched any objection to the applications.¹⁹⁸

3.3.4.4 Issuance of Certificate of Registration

Where the request for the registration of a sports trademark is found to have fulfilled the requirements as to the substance and form and where opposition has not been made or the filed opposition has been rejected, the EIPA, will finally register the sports trademark and issue the applicant certificate of registration, upon payment of the required fee.¹⁹⁹ It was after going all these examination and ascertainment of facts that the EIPA has issued certificate of registration for sports persons such as Ethiopia Coffee Sport Club, Arsenal Football Club among others.²⁰⁰ It can be concluded that certificate of registration of a mark is important in that it shall be used as evidence of the validity of the registered mark. It may also be used as evidence to prove owners title of ownership of the mark. Any sports person who alleges that its sports trademark is infringed and therefore, demand all the possible legal remedies available under the trademark law from the competent court would not be successful in its allegation without first proving to it that it has a lawfully registered trademark certificate for the mark.²⁰¹ Provisional measures by the Ethiopian Customs Authority to seize and detain goods which are subject to the alleged infringement of the trademark holder's right may not also be given without first providing evidence of certificate of trademark registration to the Authority.²⁰² The importance of having certificate of trademark

¹⁹⁷ Trademark Regulation art 26(2)

¹⁹⁸ Interview with Frew Hailu, Director Directorate of Legal Service, Ethiopian Intellectual Property Office (Addis Ababa, 1 February 2021)

¹⁹⁹ *ibid* art 15

²⁰⁰ Interview (n 16)

²⁰¹ Trademark Proclamation, art 4

²⁰² *ibid*, art 42(1)

registration is therefore, is very crucial as application for the registration of sports trademark alone doesn't entitle sports trademark holder all the infringement remedies available under the trademark.

3.3.5 Rights Arising Out of Sports Trademark Registration

Trademark law guarantees the owner of a registered sports trademark the exclusive 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.²⁰³ It is a positive right that implies the right of the owner of the sports trademark to use his mark in advertising, to affix (attach) it on goods, containers, packaging, labels, etc or to use it in any other way in relation to the goods or services for which it is registered.²⁰⁴

A) The Right to Use the Sports Trademark by its Owner

As regards to the right to use of the trademark by sports persons is concerned, the owners of sports trademark may by themselves use their registered sports related trademark. Sports trademark owners may directly engage in the business for which they have registered their mark and provide the goods and/or services by themselves. They may for instance, manufacture sporting kits and attach or affix their registered brand mark on the sports kits they have manufactured and make these goods available in the market by themselves. The United States Golfers Association and the United States Tennis Association for instance, are among the typical major sports organizations to use trademarks on items they manufacture for sale.²⁰⁵ There is no doubt that these sports associations have been transformed in to a big business empire because they have made effective use and exploitation of their respective sports trademark out of the sale of goods and services bearing their brand trademarks. India's cricket club Kolkata Knights Riders also engage itself in the sale of merchandize sells in the form of caps, t-shirts and etc.²⁰⁶

In Ethiopia, the Ethiopian Coffee Sport Club, is the notable sport club to have made use of their sports related trademark by itself.²⁰⁷ The Club simply imports the sporting kits, notably T-shirts they are selling to its fans. As has been discussed earlier, the profits it generate out of the sale of

²⁰³ *ibid*, art 26 (1)

²⁰⁴ Trademark Regulation, art 2(6)

²⁰⁵ Avi Friedman, 'Protection of Sports Trademarks' (1995) 15 Loy LA Ent LJ 689

²⁰⁶ Kalamadi (n 1) 438

²⁰⁷ Interview (n 128)

the T-shirts should not be underestimated though more work is required from the club to use and exploit their registered sports trademark.

Apart from the provision of goods, sports trademark owners may also provide services using their registered mark. The case in point is Cristiano Ronaldo, who has used his brand sports trademark name "CR7" in the provision of hotel services in his country Portugal and few others.²⁰⁸

In most of the cases, however, sports trademark holders are seen being using their trademark through licensing and assignment to companies in return for huge profits. Assignments and Licensing of sports trademarks rights are therefore, the most common forms of transfer of trademark rights from its owner to other person namely; the assignee and licensee respectively.

With regard to assignment, the trademark law permits the transfer of the rights on application for sports trademark registration in whole or part, in addition to the transfer of a sports registered trademark.²⁰⁹ Assignment should not depend on the simultaneous transfer of the business to which the sports trademark belongs for the law clearly provides for the possibility of transfer of trademark rights with or without the business to which the sports trademark is attached.²¹⁰

This being the guiding principle, however, it is argued that consumers are accustomed to the product sold under the trademark, so that an assignment without transfer of the business, or part of the business, using the mark would deceive consumers, in which case the EIPA may deny to give effect to the assignment rights. Therefore, for the transfer of sports trademark rights to have a meaningful purpose, the business to which that sports trademark have attached should at least be transferred in part to the transferee together with the right to use the mark. This will on the one hand benefit the transferee to have sufficient control over the business under which the trademark right is attached so as to exploit the commercial values attached to the mark properly. On the other hand transfer of the right to use sports trademark together with the business to which the mark is attached may also serve consumers not to be deceived in identifying the goods/services provided under the mark.

²⁰⁸ Hollesen, (n 55) 3

²⁰⁹ Trademark Proclamation art 28(2)

²¹⁰ *ibid* art 28(4)

In relation to Licensing, the possibility of granting a sports trademark license seems to conflict with the trademark's primary function of indicating the origin of goods, since the goods offered under the sports trademark originate with the licensee and not with the registered sports trademark owner.²¹¹ To do away with such problems, it seems, the law obliges the owner of the sports trademark (licensor) to exercise effective control of the quality of the goods or the services in connection with which the trademark may be used.²¹² As discussed above, it is widely seen and practicable in the world that professional sports persons who are owners of sports trademark tend to license their trademark to other giant companies in return for lucrative amount profits. Since the sale of goods bearing the trademarks of professional sports person has increased from time to time the licensing of the mark by such sports person has developed in to mega business. They simply make incredible business by marketing their brand names to other persons.

B) The right to Exclude Others

The other right that registration of a sports trademarks confers upon its owner is the right to exclude others from using a sports trademark or a sign resembling it in such a way as to be likely to mislead the public for goods or services in connection with which the use of the mark or sign is likely to mislead the public.²¹³ This right is derived from the mark's primary function of distinguishing goods of its owner from those of others that he must be able to object to the use of confusingly similar marks in order to protect his interest, that of the consumers and the public at large from being misled.²¹⁴

The Ethiopian Coffee Sport Club, that have managed the registration of its sports trademark for instance, have the right to use its registered mark for the purpose they have registered solely either by itself or through licensing/assignment to other persons. This is to mean that the Club has the right to object to the use of its registered sports trademark by third party by affixing the mark on T-shirts and other goods for which the mark is registered or by using the mark in advertising among other things. The owner of the trademark is the sole arbiter to decide who can use its registered trademark.

²¹¹ kunze, (n 64) 75

²¹² Trademark Proclamation, art 30

²¹³ Trademark Proclamation, art 26(2)(a)

²¹⁴ Kunze (n 64) 52

The right of the sports trademark owner to exclude others is, however, not left unlimited. Owner's right to prevent third parties from using his mark can be restricted by the legitimate interests of others. For instance, where goods are lawfully sold in any country under the same trademark with that of the Ethiopian Coffee Sport Club and these goods have not undergone any change, then registration of that sports trademark shall not deprive third parties the right to use that mark.²¹⁵ Similarly registration of a mark shall not confer on its registered owner the right to exclude third parties from using bona fide use of their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of 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.²¹⁶ Moreover, trademark owner cannot unconditionally object to the use of his trademark or a similar mark for the goods for which his trademark is registered or for similar goods. This is because if a mark is not in use for a continuous period of at least three years its registration may be cancelled out up on a request by any interested party for the cancellation of the mark.²¹⁷ Therefore, the owner of a registered sports trademark should take note of this requirement and make a proper use of its registered mark for the purpose it has been registered. As seen above, Arsenal football Club has never made use of its sports trademark in Ethiopia after it has managed the registration of the mark with the EIPA. Any interested party can therefore, successfully request the cancellation of the mark and thereby end the Clubs right to exclude others as regards to the use of the mark.

3.3.6 Remedies for Sports Trademark Infringement

We have seen that the owner of a registered sports trademark has exclusive right to use the mark. It follows then that he/she can object to acts that infringe that right under the same mark. The unauthorized use of a sports trademark may cause harm to its holder because any sales of unauthorized sports merchandize will reduce the sales of a licensed sports merchandize.²¹⁸ Again Professional sports person, sports teams, sports event organizers and etc invest their time, labor,

²¹⁵ Trademark Proclamation, art 27(1)

²¹⁶ *ibid* art 27(2)

²¹⁷ *ibid* art 35

²¹⁸ Steven N Geise, 'A Whole New BallGame: The Application of Trademark Law To Sports Mark Litigation' (1995) 5 Seton Hall J Sport L 565

and finance to build their goodwill and reputation.²¹⁹ It follows then that sports persons deserve legal protection and remedies in case such infringement occurs.

A successful plaintiff in an infringement action may obtain civil remedies that include injunction order and damages.²²⁰ Accordingly, the court may order an injunction to stop the defendant from continuing the act of infringement and also order the defendant to compensate the damage caused by the infringement.²²¹ Pending the investigation of infringement action, the court may also award different types of provisional injunctive orders as the case may be.²²² There may also be criminal sanctions that may go up to ten years of rigorous imprisonment, against a person who infringes the rights of an owner arising from registration of its sports trademark.²²³ Here it is important to note that in a trademark infringement claim, actual confusion of a specific consumers need not be proved as the proof of the likelihood of confusion in the market circumstances is suffice.²²⁴

As far as sports related trademark in Ethiopia is concerned, neither the EIPA²²⁵ nor the competent regular court²²⁶ have encountered a single infringement claim. Obviously, the likelihood of sports trademark infringement cases are very less, if not non-existent, in a situation where sports trademarks are not widely in use. In the absence of the use of sports trademark by sports persons, no one may claim infringement of such mark. In Ethiopia, even though some sports persons, all of which are legal persons, have managed to registered their sports trademark with the EIPA, yet none of them have brought any infringement case to office.²²⁷ This does not however, mean that no infringement have occurred to those registered sports trademarks with the EIPA. A case in point is the widely selling of T-shirts that contain the Ethiopian Coffee Sport Club registered trademark by untraceable persons.²²⁸ Since persons who made available the T-shirts to the markets are very difficult to be traced and made accountable, the clubs fans association has taken the initiative to

²¹⁹ *ibid*

²²⁰ Trademark Proclamation, art 40

²²¹ *ibid*

²²² *ibid* art 39

²²³ *ibid* art 41

²²⁴ Stanley M. Besen Leo J Raskind, 'An introduction to the Law and Economics of Intellectual Property Rights: American Economic Association' (1991) 5 *Journal of Economic Perspectives*, 22

²²⁵ Interview (n 16)

²²⁶ Interview with Ashenafi Lemecha, Trade Related Bench Judge, Federal First Instant Court of Ethiopia. (Addis Ababa, 1 February 2021).

²²⁷ Interview (n 16)

²²⁸ Interview (n 139)

collect the T-shirts it found out on the market and indeed, they have done good job in minimizing the problem.²²⁹ This is however, not a viable solution to do away with such kind of infringement problems, devising a strict mechanism of control system is necessary both on the part of the trademark holder and the EIPA. The absence of a single sports related trademark infringement claim to the competent court has become a major hindrance to provide a more comprehensive analysis as regards to the actual application of the law in this regard.

3.3.7 The Role of The Ethiopian Intellectual Property Rights Authority in The Registration of Sports Trademarks

In Ethiopia, a government body or institution which is responsible to implement or follow up the implementation of national laws governing intellectual property is the EIPO.²³⁰ It is the EIPA that is mandated to entertain matters relating to trademark registration and certifications.²³¹ Accordingly, an application for trademark protection, whether its sports related trademark or trademark not involving sporting activities, should be made with the EIPA and the EIPA shall register a trademark and issue the applicant a certificate of registration upon ascertaining the fulfillment of both substantive and procedural requirements discussed above.²³² Therefore, it is only when registration is effected and certificate of registration is issued by the EIPA that rights arising out of trademark shall be conferred upon the owner of a registered sports trademark.²³³

Apart from conducting the registration of sports trademark, rendition of advisory services on intellectual property matters to public, state, private organization and professionals' association as well as individuals and facilitating conditions that will help to create linkages between intellectual property owners and entrepreneurs who wish to exploit their creative works are also some of the major powers the law bestowed upon the EIPO. These powers and duties, if properly discharged and implemented by the EIPO, are very instrumental in creating awareness among sports community about the massive economic importance attached to sports trademark and thereby attract sports persons to the business of sports trademark in Ethiopia.

²²⁹ *ibid*

²³⁰ Ethiopian Intellectual Property Rights Establishment Proclamation, 2003, para 1 of the preamble, Proc No 320, Fed Neg Gaz, Year 9, no 40 (EIPREP)

²³¹ *ibid* art 6

²³² Trademark Proclamation, art 15

²³³ *ibid* art 4

The problem is however, the Authority did nothing in this regard apart from conducting the registration process once sports trademark applicants approaches the office.²³⁴ The EIPO has never provided its legal duty of rendering advisory services on intellectual property matters like sports trademark to peoples in the sports industry.²³⁵ There has never been such practice in the office and the office's effort to make the necessary information public to the people through its website is also very limited.²³⁶ The governing laws and rules of procedures are not properly made available on the EIPO website let alone the creation of information system on sports trademark by the office on its website. Had the EIPO managed to property undertake its basic duties mentioned above, the use and exploitation of sports trademark in Ethiopia's sports industry especially by world class athletes of Ethiopia, would have been tremendous. Overall the failure on the part of the EIPO to discharge all its legal duties discussed above have contributed their part to the proper use and exploitation of trademarks in Ethiopia's sports industry.

²³⁴ Interview (n 197)

²³⁵ *ibid*

²³⁶ *ibid*)

Chapter Four: Conclusion and Recommendations

Conclusion

In business, people can easily recognize the brands. Behind brands are trademarks. Trademark is a sign that distinguish goods or services of one person from those of the other persons. Trademark right gives the owner an exclusive right to use it on products and services as well as a right to legal protection from everyone impeding the trademark owner by using a similar goods or service mark for marketing the same or similar kind of products or services. Hence, its legal protection is undisputable.

The sports industry has a growing impact on the world economy, creating jobs, investing in public infrastructures and mobilizing resources. With the emergence of sports as a veritable economic sector, its commercial importance has increased rapidly both in terms of on the field events and of the field activities. The world sports industry, in particular, the European and the US sports industry are exemplary in effectively exploiting the commercial benefits attached to sports trademark. Many of the sports teams, sports event organizers, and professional sports men and women of these countries have become a multimillion empire. Portuguese active football legend Cristiano Ronaldo is the typical sports man to be mentioned for effectively exploiting the commercial value attached to his brand name through trademark protection.

Coming to the Ethiopian case, the use of sports trademark by sports persons particularly by Ethiopia's sports personalities, is not accustomed as such. The country's overall low status of sports industry coupled with the unworkable trademark legal system in the area of sports trademark protection is the main reason behind Ethiopia's poor usage of sports trademark. Besides, reluctance of the Ethiopian Intellectual Property Office in properly discharging its legal duty of creating an information system on sports trademark rights, rendering advisory services on sports trademark matters to public, state, private organizations, professionals association as well as individuals, facilitating conditions that will help to create linkages between intellectual property owners and entrepreneurs are also some of the major barriers to be mentioned for the proper exploitation of trademark in Ethiopia's sports industry.

Arbitrariness of the EIPO in the sports trademark registration being a major worry, lack of awareness among the sports industry also contributed its part to Ethiopia's limited sports trademark

use. Above all, Ethiopia should regret for its living world super star runners for not yet utilizing their brand names under the sports trademark legal framework.

Recommendations

- ✓ Ethiopia should make the necessary amendment to its existing trademark law in relation to persons eligible to have registration of their trademarks. Accordingly, the law should unequivocally provides that professional sports persons, (both physical and legal) should be allowed to register their sports trademark only if they are business persons who make use of the mark on goods and services for which the mark is registered.
- ✓ The requirement of furnishing a legal trading license for the purpose of the registration of sports trademark should be included in the trademark proclamation as opposed to the directive issued by the EIPA.
- ✓ The term 'public morality' as used in the trademark proclamation for the purpose of denying trademark registration should be accompanied by qualifying words/phrases that eliminate if not reduce the undue and wider discretionary power of the EIPA in the interpretation of the term.
- ✓ The EIPA should discharge its legal duties such as; rendition of advisory services on sports trademark matters to public, state, private organization and professionals' association as well as individuals and facilitating conditions that will help to create linkages between sports trademark owners and entrepreneurs who wish to exploit their trademark so that the use of sports trademark in Ethiopia would become promising.
- ✓ Professional sports persons should realize that their playing days will last only as long as their physical ability allows and therefore, should think of ways to expand their earning through the use and exploitation of trademark.
- ✓ Ethiopian professional sports men and women, particularly super star athletes who have managed to conquer the world in their on-field sports activity should make the proper exploitation of the fame and reputation they have already built during their on-field activities through the use of trademarks.
- ✓ Ethiopia should give due regard and strive to the development of its sports industry so that effective use and exploitation of sports trademark can be materialized by professional sports person.

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