The Interface between Trademark and Trade Name in Ethiopia

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Abstract

The main purpose of trademark is to guarantee a product's genuineness, which is used by a manufacturer or seller to distinguish its product from those of others. On the other hand, a trade name is a means of identifying a business or its products or services to establish goodwill. Trade name symbolizes the business's reputation. However, in many cases, it is difficult to distinguish a trade name from a trademark, especially when the mark or the name is printed on a certain product. Using a similar sign or word as trade name and trademark by different parties has the capacity to create likelihood of confusion misleading the consumer. The trademark proclamation has also failed to address the issue in an explicit manner. Thus, this commentary is aimed at addressing the legal gaps with respect to administering the issue. To this end, the following questions are posed in order to distinguish between the two concepts: what is the interface between trademark and trade name in Ethiopia? Whether trademark bars subsequent registration of the same mark as a trade name, if so what is the notion for the restriction?

Keywords: Trade name, Trademark, Intellectual Property, Competition

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1. Introduction

This commentary is devoted to discussions related with the interface between trademark and trade name. Companies own trademarks to distinguish their goods and services from those of their competitors or similar products. In the same manner, they also distinguish the business itself from other companies or enterprises. Trade name plays this role of distinguishing the business itself. There is always a problem concerning registration of trademark and trade name as both are fixed on packages of products. It is also difficult to distinguish the name from the mark when there is similarity.

However, there is no ground of refusal of registration of trademarks based on preexisting trade names in Ethiopian context. Ethiopian trademark law failed to enumerate a preexisting trade name as a ground for refusal of registration for subsequent trademarks. Similarly preexisting trademark is not mentioned as a ground for refusal for registration of trade name under the commercial registration and licensing proclamation. Moreover, the institutions are different for the registration of trade name and trademark. Ministry of trade and industry is administering trade name,[1] but trademark is under the Ethiopian Intellectual Property Office. Therefore, it can be inferred that the gap created by the law and the lack of administration cooperation are the main problems of the existing scenario in the area. There is no mechanism between the Ministry of Trade and Industry and Ethiopian Intellectual Property Office to share information concerning the registration of trade name and trademark at respective offices.

In order to understand the issue from different perspectives, this review addresses the following major question: what is the interface between trademark and trade name in Ethiopia? On the basis of this major research question, the specific research questions are: what is the blurred area under Ethiopian Intellectual

[1] Ethiopian Commercial Registration and Licensing Proclamation (Amendment), 2019, Art. 3, Proclamation No. 1150/2019, Fed. Neg. Gaz., Year 25, No. 77.

Property law concerning the interface between trademark and trade name? What is the basis for this restriction whether a word or a sign being used or registered as a trade name bars subsequent registration of a trademark with the same content?

2. Trademark and Trade Name Laws

2.1. General overview

There are diverging views about the protection of Intellectual property rights under main aspects of modern trade and economic cooperation agreements. While many argue in favor of the protection, it is a determinant factor and an indispensable precondition for innovation and growth, and hence for development. On the contrary, many others believe that it is an obstacle to growth and development for developing countries.[2]

The legal instruments in the area prefer to define intellectual property in terms of enumeration of protected works under the regime. For instance, Trade Related Intellectual Properties (TRIPS) agreement referred intellectual property with respect to the categories of intellectual property that are the subject of Sections 1 through 7 of Part II.[3] This part of the agreement provides the type of rights protected under the instrument as intellectual property rights. For the purpose of this writing, the definition provided by the publication of WIPO (World Intellectual

[2]Hannes Schloemann, TRIPS Plus and TRIPS Minus in EPAs *An Article-by-Article Analysis of the 2007 Draft SADC EPA, (2008*), p.7
Presenting the detailed account of the debate on IPRs is not the concern of this writing. However, esteemed readers may find various literatures devoted for arguments presented for and against protection of the rights. Among these, the work of Errol D'Souza and Peter de Souza is the prominent one. They have provided that: "There are various levels and arguments involved in the debate on Intellectual Property Rights (IPRs). Four aspects have merited attention, the consequentialist, where the dispute is shown to be primarily empirical, the intrinsic, where the disagreement concerns the norms of a free society, the incentive, where IPRs are seen as incentives that are socially beneficial, and the desert, where the inventor's desert is the basis of dispute." See Errol D'Souza and Peter de Souza Source (1990), "Restating Arguments on Intellectual Property Rights", Economic and Political Weekly, Vol. 25, No. 21, pp. 1163-1168.
[3]TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement], Art. 1(2).

Property Organization) as a working definition is taken. In this publication it is provided that: *"Intellectual property (IP) refers to creations of the mind – everything from works of art to inventions, computer programs to trademarks and other commercial signs*".[4]

Intellectual property is divided into two categories: industrial property and copyright. Patents for inventions, trademarks, industrial designs and geographical indications fall under the first category. Literary and artistic works (e.g., drawings, paintings, photographs and sculptures) and architectural design remain under the domain of the second category. In addition to the list enumerated, copyright includes the right of performers, producers and broadcasters, as they are neighboring right holders.[5] Ethiopian law defines intellectual property as "*a legal right over a creative works of the human intellect and includes patent, trademark, registration certificate and copyright."*[6] This definition indicates that the right emanates from the legal protection accorded under the state laws and the protection extended to *creative works of the human intellect*, in addition to the generic expression, the law also provides for a list of protected items.

It is worth mentioning the justification for protection of intellectual property rights. One is to give expression to the moral sentiment that a creator should enjoy the fruits of their creativity; the second is to encourage the investment of skills, time, finance, and other resources into innovation in a way that is beneficial to the society.[7] This is an indication of the role of Intellectual Property Rights systems in

[4]WIPO, What is intellectual property?, available at: https://www.wipo.int/edocs/pubdocs/en/wipo_pub_450_2020.pdf accessed on 22 July 2021.
[5]World Intellectual Property Organization, What is Intellectual Property?, WIPO Publication No. 450, available at http://www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf accessed on 30 Oct. 2018
[6]Ethiopian Intellectual Property Office Establishment Proclamation, 2003, Art. 2(1), Proclamation No. 320/2003, Fed. Neg. Gaz., Year 9 No. 40.
[7]WIPO Intellectual Property Handbook, Policy, Law and Use, WIPO Publication No. 489, *available at*: http://www.wipo.org/about-ip/en/ iprm/pdf/ch1.pdf accessed on 30 Oct. 2018

the promotion of technological progress.[8] The justifications provided may be categorized under either right-based justification or public interest based justification.[9]

2.2. Trademark and Trade Name under Ethiopian Law

The Ethiopian trademark registration and protection proclamation defined trademark as any visible sign capable of distinguishing goods or services of one person from those of other persons. In doing so, the law made enumeration of trademarks to be protected.[10] In the same fashion, Black's Law dictionary defines it as *"a word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others".* In addition to the definition, the purpose of trademark as a means to assure *"product's genuineness,"*[11] is also stated. Hence, we can say that the purpose of trademark is to enhance the awareness of the consumer on where the source of production of the item is.[12] The dictionary also defined and stated the purpose of trade name in the following manner:

"…trade name is a name, style or symbol used to distinguish a company, partnership or business, under which a business operates. A trade name is a means of identifying a business or its products or services to establish goodwill. It symbolizes the business's reputation."[13]

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[8]Carlos A. Braga & Carsten Fink, (1996), "The Economic Justification for the Grant of Intellectual Property Rights: Patterns of Convergence and Conflict, The Implications of the New Regime for Global Competition Policy", Chicago Kent Law Review, Vol. 72, Issue 2, p. 439 Available at: https://scholarship.kentlaw.iit.edu/cklawreview/vol72/iss2/8: accessed on 27 Oct. 2018

[9] For further understanding on this issue please see Justin Hughes, (1988), "The Philosophy Of Intellectual Property", Geo. L.J. Vol. 77 No. 287, p. 291

[10]Trademark Registration and Protection Proclamation, 2006, Art. 2(12), Proc. No..501/2006, Fed. Neg. Gaz. year 12No. 37.

[11]Bryan A. Garner (ed), Black's Law Dictionary, West Group, (7th ed. 1999), p. 1500.

[12] Oscar A. Geier, Patents, Trademark and Copyrights law and Practice, (17th ed. 1934), p. 70.

[13] A. Garner (ed), cited above at note 11, p. 1501

The Ethiopian Commercial Registration and Licensing Proclamation defined a trade name as "a name that a given business person uses for his business or known by the society as such".[14]

Concerning administration of the rights under Ethiopian laws, trade name is protected mainly under Commercial Registration and Licensing Proclamation Number 980/2016. On the other hand, trademark falls under the scope of intellectual property laws stipulated under Proclamation Number 501/2006 and Regulation Number 273/2012. The protection is accorded as economic incentive. In other words, the justification for the protection is not originated from the intent of incentivizing innovation or creativity. Protection on the base of incentivizing innovation or creativity might be raised as justification for other intellectual property rights, such as copyright and patent protection.[15]

2.3. Registration of trademark: the requirements and its implication

"International Registrations" is a system of Registrations obtained under the Madrid Agreement or Madrid Protocol.[16] A Madrid System registration can reduce filing expenses and facilitate renewals, among other things. However, the rights obtained through Madrid System registrations are not greater than the rights obtained through a national registration, because of the application of the concept of territoriality of trademark registrationrights.[17] Hence, the owner of an International Registration must go before national courts to enforce its rights.[18]

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[14] Ethiopian Commercial Registration and Licensing Proclamation, 2016, Art. 2(10), Proc. No. 980/2016, Fed. Neg. Gaz. Year 22 No.101.

[15]Stanley M. Besen and Leo J. Raskind, "An Introduction to the Law and Economics of Intellectual Property", (1991), The Journal of Economic Perspectives, Vol. 5, No. 1 p. 21

[16]Madrid Agreement Concerning The International Registration of Marksof April 14, 1891, as amended on September 28, 1979, hereinafter Madrid Agreement, Art. 1(2) cum 3 and Protocol Relating To The Madrid Agreement Concerning The International Registration Of Marks Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007, hereinafter Madrid Protocol, Art. 2

[17] Madrid agreement Art. 3bis and Madrid Protocol Art. 3bis

[18]Lanning G. Bryer, International Trademark Protection, International Trademark Association, (2015), pp. 3-4

Registration of trademark at the concerned authority is a requirement to get protection but this requirement is not mandatory in all legal systems of countries. For example, in the United States, parties are not required to register their marks to obtain protectable rights. The interested party may establish "common law" rights in a mark; without registration, the rights are based solely on use of the mark incommerce. However, registration provides a number of advantages over common law rights, including a legal presumption of ownership of the mark and exclusive right to use the mark; public notice claim of ownership of the mark; the ability to record the U.S. registration with U.S. Customs and Border Protection to prevent importation of infringing foreign goods; and the ability to bring an action concerning the mark in federal court.[19]

However, the Ethiopian trademark registration and protection proclamation requires the registration of the trademark to get the protection of the law as stated under article 4 of the proclamation. Ownership of the mark and its effect on third parties emanates from the very fact of registration,[20] save protection of trademark that can be established to be used in Ethiopia as an exception.[21]

Ethiopian Trademark Registration and Protection Proclamation provide various requirements to get the registration of the mark. Among others, the trade mark shall be capable to distinguish goods or services of a person from those of other persons, distinctive rather than merely descriptive;[22] it may not be contrary to public order; and it may not infringe the right of others. Other grounds are listed under article 5, 6 and 7 of the proclamation. Article 7(1) of the Proclamation provides that the authority shall refuse the registration of a trademark when it is identical with an earlier trademark of another person in respect of the same goods or services or

[19]United States Patent and Trademark Office, Protecting Your Trademark Enhancing Your Rights Through Federal Registration, Pp. 10 & 11 available at http://www.uspto.gov/trademarks, accessed on 25 Oct. 2018.
[20] Trademark Registration and Protection Proclamation, 2006, cited above at note 10, Art. 4.
[21] Id. Art. 7(2.)
[22] Id. Art. 5(1) cum 6(1) (c).

closely related goods or services, or nearly resembles trademark if it is likely to deceive or causes confusion.[23]

The provision also stipulates the refusal grounded on the fact that the trademark is identical with earlier trademark. However, the proclamation has failed to indicate the similarity between earlier trade name and the trademark submitted for registration.[24] We may argue that the stated likelihood of causing confusion has the tendency to include earlier registered or known trade name of others. However, the framing of the provision does not seem to cover such scenarios. Trademarks liable for likelihood of confusion are not capable of registration and protection under international instruments. For instance, the Paris Convention for the Protection of Industrial Property allows the member states to prohibit the registration of trademarks when the mark is capable to create likelihood of confusion with other trademarks.[25] Article 15 of the Trademark Law Treaty obliges the contracting parties to obey the requirements provided under the Paris Convention for the Protection of Industrial Property.[26] In addition to this, the TRIPS Agreement provides that the right holder has the right to prevent others from using of signs that may have the possibility to create likelihood of confusion.[27] Ethiopia is not a party to this treaty, but the standing of the agreement has a persuasive nature because of its wide acceptance.[28]

[23] Id. Art. 7(1).
[24] Article 16 of commercial registration and licensing proclamation provides list of causes preventing registration of trade name but preexisting trademark is not mentioned as a ground for refusal for registration of trade name.
[25]Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Stockholm on July 14, (1967), Art. 6bis
[26]Trademark Law Treaty Done at Geneva on October 27, 1994, Art. 15.
[27]TRIPS Agreement, Art. 15 cum 16 (1).
[28]The WTO has 164 members and 25 observer governments. See the detailed information on member states at WTO website: https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm#collapseE accessed on 21 July 2021.

3. The Decision of the Federal Supreme Court Cassation Division

The Federal Supreme Court Cassation Division of Ethiopia is empowered to interpret the laws of the country,[29] and the interpretation[30] comes into picture when there is ambiguity or vagueness in the law.

A case has been presented to the Cassation Division by the applicant (applicant at the Cassation).[31] The applicant has stated that the Ethiopian Intellectual Property Office has registered a Trademark of the second respondent (respondent at the Cassation, the Ethiopian Intellectual Property Office is referred as first respondent at the Division) that is similar with the applicants trade name and have a possibility to create a likelihood of confusion because both parties are traders registered to supply cement. The Ethiopian Intellectual Property Office has rejected the opposition presented by the applicant mentioning that the trade name has not been registered as a trademark and the word registered for the second respondent has additional stars surrounding the word, which is claimed as a trade name, by the applicant.

The Cassation Division ruled on the issue at hand and stated that the Ethiopian Intellectual Property Office shall take into account the relevant laws, pursuant to article 6(1) of its establishment proclamation[32] at the time of examination of applications for trademark registration. The court has pinpointed two major grounds to be considered by the office: the first one is the possibility of creating a likelihood of confusion to the public and the second one is the tendency of creating

[29] Constitution of the Federal Democratic Republic of Ethiopia, 1995, Art. 80(3) (a), Proc. No. 1/1995, Fed. Neg. Gaz., Year 1, No. 1. See also Federal Courts Proclamation, 2021, Art, 10(1), Proc. No. 1234/2021, Fed. Neg. Gaz., year 27, no. 26.

[30] *"Lawyers and judges often use 'interpretation' to find out the meaning of the laws' language and to find out its legal content".* William Baude & Stephen E. Sachs, (2017), The Law of Interpretation, Harvard Law Review, vol. 130, no. 4, pp. 1085-1086.

[31] Ethio-Ceramic Vs. Ethiopian Intellectual Property Office and Avorgiga Technology Ltd., Federal Supreme Court Cassation Division, File No. 57179, 22 Yekatit 2003 Eth. C., The Ethiopian Federal Supreme Court Cassation Division decisions' publication book, Vol. 12, p. 544-548.

[32] Ethiopian Intellectual Property Office Establishment Proclamation, cited above at note 6, Art. 6(1).

unfair competition among the business community.[33] This section of the writing is devoted to the grounds mentioned by the court and discussion on the practical importance of the decision.

3.1. Protection against Unfair Competition and Protection of Trademarks

Ensuring the freedom of traders to use their resource at their own choice and at the price they choose is the pillar of competition in product market. Product market competition increases efficiency and productivity by providing incentives for managers to reduce costs, innovate, and improve the institutional arrangements in production.[34] States enact competition regimes so as to maintain free market economic system and protect consumers from anticompetitive acts of traders or firms; however, it is inevitable that the existence of some differences between the regulatory regimes to the content and number of specific objectives to be achieved.[35] Trade Practice and Consumer's Protection Law regulate trade practices by protecting businesses from anti-competitive and unfair trade practices to ensure a competitive business environment.

As stated under the preamble of Trade Competition and Consumers Protection Proclamation, the objective of competition law is, among other things, ensuring free market policy and protection of the business community from anti-competitive practices.[36] The same proclamation prohibits carrying out any dishonest, misleading or deceptive act that harms or is likely to harm the business interest of a competitor.[37] The proclamation also precludes the business community from engaging in any act that causes or is likely to cause confusion regarding products

[33] Ethio-Ceramic vs. Ethiopian Intellectual Property Office and Avorgiga Technology Ltd., cited above at note 31.
[34] The World Bank, Building Institutions for Markets World, Development Report Overview, (Washington, D.C., 2002), p. 133.
[35] Kahsay G. Medhn, "Ethiopian Competition Law: Appraisal of Institutional Autonomy", (2016), International Journal of Innovative Research & Development, Vol. 5 Issue 3. p. 77.
[36]Trade Practice and Consumers' Protection Proclamation, 2013, Proc. No. 813, Fed. Neg. Gaz.,, Year 20, No. 28 Preamble para. 1&2.
[37]Ibid. Art. 8(1)

being supplied.[38] This condition on prohibition of creating confusion can be extended to cases concerning trademark similarity and other elements of business that have a tendency to resemble to trademark, such as trade name. Not only this prohibition, but also the proclamation provided that Commercial advertisements about goods and services announced by any means may not be misleading in any manner particularly on trademark and the source of the product.[39] This means trademark is implicitly protected under the competition law of the state so as to avoid anti-competition practices. In other words, a person who is affected by trademark piracy has the possibility to resort to unfair competition law other than traditional trademark law.[40]

It is worth noting that the function of trademarks is to provide rules of orderly marketing by identifying products and their sources.[41] The quality of a product and the public familiarity with such quality increases value of the trademark; hence, a trademark establishes a reputation for the producer of the product.[42] Furthermore, such reputation is protected under competition laws. For instance, Ethiopian Trade Competition and Consumers Protection Proclamation states that any false or unjustifiable allegation that may have the potential to discredit another business person or its activities is considered as unfair competition.[43] The Ethiopian Criminal Code also provides that infringement of marks in such manner as to deceive the public, shall be punishable with rigorous imprisonment not exceeding ten years.[44]

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[38]Ibid. Art. 8(2)(a)
[39]Ibid. Art. 19(1)&(7)
[40]World Intellectual Property Organization (WIPO), Introduction To Trademark Law &Practice: The Basic Concepts, A WIPO Training Manual, Geneva, (2nd Ed. 1993), p. 12
[41] Fikremarkos Merso, The Ethiopian Law of Intellectual Property Rights: Copyright, Trademarks, Patents, Utility Models and Industrial Design, (2012), P. 161.
[42] M. Besen and J. Raskind, cited above at note 15, p. 21.
[43]Trade Competition and Consumers Protection Proclamation, cited above at note 35, Art. 8(2)(c).
[44] Criminal Code of the Federal Democratic Republic of Ethiopia, 2005, Art. 720(1), Proc. No. 414/2005, Fed. Neg. Gaz, year 10, No. 58.

3.2. The Interface between Trademark and Trade name and "Likelihood of Confusion"

The Ethiopian commercial code makes both trade name and trademark an incorporeal element of a business.[45] Likewise, some companies tend to use their trade name as a trademark and this scenario has a possibility to create confusion against business owners and consumers. Coca-Cola is among these types of companies.[46] However, the problem arises when the trade name of a company becomes a trademark of another business. We have strong reason to make a distinction between trade names and trademarks. This is required whenever a business starts to employ its trade name to establish the identity of its products and services; in such a case, the trade name is functioning as a trademark.[47] The question is that whether such scenario infringes the right of an existing trademark or not.

As noted in a case entertained by an American court, trademark may not give the exclusive right to prohibit others from using word or words. The right holder could be prohibited only if using the word or words has a potential to deceive the public.This is allowed to protect his good-will from being affected by such use.[48] This means preventing third parties from the use of such word would be allowed only if it represents *"a business good-will that the attributes of property attach to it"*.[49] Therefore, we may say that the prohibition is laid on creation of likelihood of confusion between signs that distinguish the product and the business. To avoid

[45] Commercial Code Federal Democratic Republic of Ethiopia, 2021, Art. 109(2), Proc. No. 1243/2021, year 27.

[46] Russell Huebsch. "Difference Between Trade Name and Trademark"available at http://smallbusiness.chron.com/difference-between-trade-name-trademark-3219.html. Accessed 25 October 2018.

[47]Caron_Beesley, Contributor, The Difference Between a Trade Name and a Trademark – And Why You Can't Overlook Either, U.S. Small Business Admission, available at https://www.sba.gov/blogs/difference-between-trade-name-and-trademark-and-why-you-cant-overlook-either accessed on 01. Nov, 2018.

[48] Prestonettes Inc., Vs .Coty, 264 U.S. 359, 368. Cited in Frank I. Schechter,(1999), the historical foundations of the law relating to trade mark law, p. 155.

[49] Id. p. 157

likelihood of confusion, the marks shall be first examined for their similarities and differences. When marks sound alike when spoken, are visually similar, have the same meaning (even in translation),[50] similarity in sound, appearance, and/or meaning may be sufficient to support a finding of likelihood of confusion, depending on the relatedness of the goods and/or services.[51]

When we come to the issue of the possible likelihood of confusion between trade name and trademark under Ethiopian law, there is no expressly provided provision under the relevant laws. Moreover, Article 7 of the Trademark Registration and Protection Proclamation failed to state prior registered trade name as a ground for refusal of a trademark registration. However, Article 27(1) of the Trademark Regulation states that any interested person can oppose a registration of a trademark.[52] The referred interested person may include the person who got the registration of his trade name. Additionally, sub article 2 (a) of the same regulation does not mention specific grounds of opposition rather it has left it open and be subject to the evidences submitted by the opposing party.[53] In such condition, the prior registered trade name may be submitted as supporting evidence for the opposition. This line of argument may help us to refuse a registration of a trademark for the protection of prior rights emanated from a trade name.

If we look into the experience of other countries like U.S.A, a state's authorization to form a business with a particular name does not also give that person trademark rights and other parties could later try to prevent the use of the business name if

[50] Trademark Registration and Protection Proclamation, 2006, cited above at note 10, Art. 7(2) & (3).
[51]United States Patent and Trademark Office, Protecting Your TrademarkEnhancing Your Rights Through Federal Registration p. 3 available at http://www.uspto.gov/trademarks, accessed on 25 Oct. 2018
[52]Trademark Registration and Protection Council of Ministers Regulation, 2012, Art. 27(1), Reg. No, *273*, Year 19, No. 10.
[53] Id. Art. 27(1), (2)(a)

they believe a likelihood of confusion exists with their trademarks.[54] The basic notion is that "the touchstone of trademark infringement is *'likelihood of confusion'*"[55]

There is also wide understanding of this assertion in the WIPO system, where the use of the trade name is likely to create confusion as to the origin of the goods or services that the entity offers under that name considered as infringement of a prior trademark. In a similar manner, the use of a trademark can infringe a prior trade name. Likelihood of creating confusion is the central point to determine the infringement and its effect.[56]As noted earlier, this standard is provided under Article 6bis of Paris Convention for the Protection of Industrial Property, cross referred under Article 15 of Trademark Law Treaty of Geneva; Article 3bis of Madrid Agreement; Article 3bis Madrid Protocol and Article 16(1) of the TRIPS Agreement. The first four treaties are being administered under the WIPO and the TRIPs agreement is part of the WTO system. Ethiopia is party to neither of the treaties but joined WIPO in 1998.[57]

3.3. Practical value of the decision

The Ethiopian Intellectual property Office frequently encounters problems associated with registration of a trademark, which is registered as a trade name at Ministry of Trade and Industry.[58] The main reasons for this problem are, among others, there is no mechanism of information exchange between the two offices, but the initial understanding has been the offices work together to achieve the objective of the laws. The second reason is that applicants tend to imitate or build

[54]United States Patent and Trademark Office, cited above at note 50, p. 2
[55] Arthur R. Miller and Michael H. Davis, Intellectual Property: Patents, Trademarks And Copyrights In A Nutshell, (3rd ed. 2000), p. 260
[56] WIPO Training Manual, Cited above at note 39, p. 94
[57]See the details on Ethiopia's status at https://www.wipo.int/members/en/details.jsp?country_id=56 accessed on 21 July 2021.
[58]Interview with Wondwosen Herpo, Lawyer, Intellectual Property Related Cases, 13 Nov. 2018.

upon the existing signs, names and marks of others.[59] In addition to these problems, the trademark registration and protection proclamation does not have a clear provision on refusal of registration of a trademark on the base of prior trade name.[60]

Some decisions of the Federal Supreme Court Cassation Division are instructive in this regard. For instance, in the case between Nice Paper Works Factory and Gelan Paper Works Factory, the word 'Nice' was being used by Nice Paper Works Factory as a trade name but later on Gelan Paper Works Factory came up with a trademark which is the trade name of the former.[61]The question here is what the fate of trademarks which have been registered before the decision of the Cassation Division should be.This question is posed because there is no provision under the Federal Courts Proclamation Number 1234/2021 which require the retroactive application of the decisions of the division. However, the interested party may seek the invalidation of the registration pursuant to Article 36 of the trademark registration and protection proclamation. The provision states that "a registration of a trademark may be invalidated by written request of any interested person or by the initiative of the office itself, when it is proved not to have initially fulfilled the conditions" provided under the law.[62] Hence, the interested party may request the invalidation of the registration by invoking the likelihood of confusion and proving his prior registration. Note that the effect of the invalidation is prospective concerning benefits acquired based on the invalidated registration.[63]

[59] Interview with Samson Tesfaye, trademark registration and administration team leader at Ethiopian Intellectual Property Office, 13 Nov. 2018.
[60] Wondwosen, cited above at note 57.
[61] Interview with Endale Deboch, trademark examination team leader at Ethiopian Intellectual Property Office, 13 Nov. 2018.
[62] Trademark Registration and Protection Proclamation, 2006, cited above at note 10, Art. 36.
[63] Id. Art. 37(2)

Conclusion

Under this commentary, we have seen that the gap of the trademark proclamation and the commercial registration and licensing proclamation in providing a clear ground of refusal of registration of trademark and trade name respectively. In addition there is information asymmetry between the offices mandated to register trademark and trade name.

To prevent likelihood of confusion and to protect the reputable trademark and trade name from unfair competition, we have to refuse the registration of trademark based on preexisting/prior-registered trade name, and vice versa. In addition to this, to align our laws on trademark registration with the international standard and the TRIPS agreement, it is better to adopt a law that clearly prohibits the registration or use of a trademark or a trade name for the protection of either of the two which has been registered or in use prior. This means article 16 of the commercial registration and licensing proclamation and Article 7 of the trademark registration and protection proclamation shall be amended in such a way that ensures the protection of the trademark and trade name. The amendment may help to avoid different interpretation by the cassation bench on the same issue in the future because Article 26 (1&4) of the Federal Courts Proclamation Number 1234/2021 allows the bench to vary its interpretation, even a decision rendered by seven judges have a possibility to be reviewed. Additionally, for the sake of information symmetry of the two offices, Ministry of Trade and Ethiopian Intellectual Property Office shall have a mechanism to communicate data of registration.