

PROTECTION OF TRADEMARKS IN ETHIOPIA

by *Everett F. Goldberg**

What are trademarks, and how does Ethiopian law protect them? The object of this note is to consider these questions, giving thought to the relevant provisions and suggestions as to their meaning. Remedies, enforcement of the claim and other related matters are touched on only briefly.

The principles of trademark protection through-out the world make up a complex body of law, one which differs in many respects among different countries. The relevant Ethiopian rules are few, and do not by any means cover all the problems in the area or solve clearly all the problems they do cover. This article's purpose is more to provide a starting point for discussion than to provide comprehensive answers.

NATURE AND FUNCTION OF TRADEMARKS

Neither the Commercial Code nor any other Ethiopian law defines trademarks. But the word is generally used to mean a mark or sign which a person attaches to a product or its packaging or uses with relation to a product, in order to identify it and distinguish it from the products of others (for example, the label on a beer bottle).¹ In olden times in Europe, a trademark served one or both of two functions. First, it identified the owner of an item. Second, it identified the particular source of a product (for example, the manufacturer or seller); this was especially important to the merchant guilds which dominated European commerce, so they could enforce rules regarding the origin and quality of goods.^{1a}

Although it still may perform these functions, its major object in a modern competitive system is to distinguish a product from other products, so that a customer may purchase an item which he believes, by experience or reputation, he will like; and, in turn, so a producer or seller may attract and retain customers. In this sense, it still may be said that the trademark identifies the source of a product, but not a particular source. The trademark states, in effect, that the goods to which it is attached come from the same source as other goods bearing the same trademark, whoever that source may be. Similarly, the trademark is a

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1. The precise definitions of "trademark" and some related terms differ from country to country. These distinctions will not all be examined here. A useful point of departure is provided by the Model Law on Trademarks, Trade Names and Unfair Competition (International Chamber of Commerce, 1959), which in Art. 1 defines a trademark as:

... any mark used or proposed to be used upon, in connection with, or in relation to goods for the purpose of distinguishing the goods of a person from those of others.

As such may serve any distinctive sign, including a word, name, device, or any combination thereof.

1a. See F. Schechter, *The Historical Foundations of the Law Relating to Trademarks* (New York, Columbia Univ. Press, 1925).

symbol of quality — not evaluated according to an objective standard, but the quality which, by experience or reputation, the purchaser attributes to the product.²

The variety of signs which may serve as a trademark is illustrated by the African and Malagasy Conventions:

Surnames taken alone or in a distinctive form, special, arbitrary or fancy names, the characteristic form of a product or its get-up, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedge, edging, combinations or arrangements of colours, drawings, reliefs, letters, figures, devices, pseudonyms and in general, all material signs serving to distinguish the products or objects of any business shall be considered to be trademarks.³

The essential requirement of a trademark is distinctiveness. Other countries have developed several rules to help separate the signs which have it from those which do not. For example, terms of fantasy and the arbitrary use of terms unrelated to the product usually will be distinctive. But words which are merely descriptive of the product or which are necessarily used in describing it, generic names for the kind of product, and identifications of geographical origin usually will not. Thus, "good" or "beer" would not be valid trademarks for beer. But "Lion" would.⁴

If a person uses a non-distinctive sign to the extent that it becomes associated with his goods in the minds of the public, it may thus acquire the necessary distinctiveness.⁵ On the other hand, a mark may lose its distinctiveness; for example, if it becomes so popular that it is used by people as a generic term for the kind of product involved rather than as an identification of the particular product (thus, when "A" is used as a synonym for beer, and not just the brand made by one

2. F. Schechter, "The Rational Basis of Trademark protection," *Harvard L. Rev.*, vol. 40 (1926-27), pp. 814-819. See also P. Roubier, *Le droit de la propriété industrielle* (Paris, Sirey, 1952-54) vol. 2, secs. 242-246; C.J. de Haan, "The Protection of Trademarks," in *Restrictive Practices, Patents, Trademarks and Unfair Competition in the Common Market* (International and Comparative Law Quarterly, Supp. Publication No. 4, 1962), p. 60.

3. Art. 2, Annex II, Accord Relating to the Creation of an African and Malagasy Office of Industrial Property (1962), as printed in E. Offner, *International Trademark Protection* (New York, Fieldston Press, 1965), p. 259.

4. The use of a person's own name as a trademark poses a problem of the conflict between the possibility of confusion and the right of every person to use his own name. See Civ. C., Art. 45. See also Civ. C., Art. 46, regarding the use of the name of another person, and Comm. C., Art. 137, regarding the use of one's own name as a trade name.

5. Compare Art. 2 of the Model Law, cited above at note 1:

The following shall not be deemed trademarks . . . :

- (a) those which consist exclusively of a sign or indication which may serve in commerce to designate the kind, quality, quantity, destination, value or geographical origin of a product;
- (b) those which consist exclusively of a sign or indication which has become common in the current language or in the lawful and constant customs of the trade in the country where protection is sought;
- (c) those that are otherwise not distinctive in the meaning of Article 1.

In all such cases, the claimant of the mark shall be entitled to prove that the trademark in question is in fact distinctive. . . .

company).⁶ The boundary between what is protectibly distinctive and what is not is obviously vague, and has been the source of much litigation in other countries.

Under many laws, some signs may be prohibited for use as trademarks whether or not they are distinctive; for example, coats of arms, flags, insignias or other decorations of government, or of international inter-governmental organizations, or marks which are injurious to public order or morality.⁷

Before examining the legal protection of trademarks, some related signs must be identified. Perhaps the most important are trade names and distinguishing marks. Like trademarks, trade names and distinguishing marks are distinctive signs in that they serve to distinguish some aspect of a person's business from the business of another. Unlike trademarks, they are defined and treated by the Commercial Code. A trade name "is the name under which a person operates his business and which clearly designates the business."⁸ It is used on the business papers of the trader and may be his own name or a term of fantasy.⁹ A distinguishing mark is "the name, designation, sign or emblem affixed on the premises where the trade is carried on and which clearly designates the business."¹⁰ The trademark, trade name and distinguishing mark may be the same. But they also may differ. The trade name is merely a name, the distinguishing mark is a sign attached to the premises and the trademark is attached to, part of or used with relation to a product.

Other related terms include service mark, association or collective mark, and indication of geographical origin. Like trademarks, these terms are not defined in Ethiopian laws. A service mark is a sign "used by a person for the purpose of distinguishing services performed by him from those performed by others."¹¹ For example, the sign emblazoned on the vehicles of a trucking company or attached to a package of laundered clothes by the launderer is a service mark. Service marks are a relatively recent development in the history of distinctive commercial signs.¹² Since they perform for services the same function described above which a trademark performs for products, the laws of some countries treat them as trademarks, although not all give them the same degree of protection.¹³ An association mark or collective mark, is "adopted by an association to indicate one or more properties of goods or services originating from or performed by members of such association,

6. See S. Ladas, "Transformation of a Trademark into a Generic Term in Foreign Countries" *The Trademark Reporter*, vol. 54 (1964), p. 941, discussing the approaches taken to this problem in a variety of nations. See also E. Offner, "Draft Model Law for Developing Countries on Marks, Trade Names, Indications of Source, and Unfair Competition - An Appraisal," *The Trademark Reporter*, vol. 56 (1966), p. 836.

7. Model Law, cited above at note 1, Art. 3.

8. Comm. C., Art. 135(1). The Code uses the words "firm-name" and "company name" for the names of business organizations, but these serve the same function as the trade name. See Arts. 281, 297, 305 and 514.

9. Comm. C., Art. 136.

10. Comm. C., Art. 140(1). It also is called the "special designation under which the trade is carried on," Arts. 105(j), 127(2) (b).

11. Model Law, cited above at note 1, Art. 12.

12. W. Derenberg, *Trademark Protection and Unfair Trading* (Albany, New York; Matthew Bender, 1936), p. 322; *Dalloz Encyclopedie juridique, Repertoire de droit commercial et des societes* (Paris, Dalloz, vol. 2, Marques de fabrique et de service, no. 3.

13. See E. Offner, work cited above at note 3, pp. 138-141. The Model Law treats service marks as trademarks; Model Law, cited above at note 1, Art. 12, and p. 21.

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as a geographical origin of goods."¹⁴ An example is the sign which is attached to products to show they are made by members of a labor union or the sign attached by a quality-control organization to show that a product measures up to certain standards. They also receive protection in many countries. An indication of geographical origin identifies the geographical origin of a product. It is particularly important for products of which the quality or characteristics vary with the place of origin -- for example, wine. Legislation in many countries, including Ethiopia, prohibits the use of false indications of origin.¹⁵

Who cares if one businessman imitates the trademark of another? The general public does, because it has an interest in promoting fair and honest conduct among its citizens. So do buyers of commercial goods, because they do not want to be deceived as to the products they buy. But most interested is the businessman. The success of any business depends upon its customers. If the trademark on one product is similar to the trademark on another, a purchaser may think the source of both products is the same. If the products are identical, purchases of them will be divided between the different producers. Even if the products are somewhat different, the reputation of one will suffer if the other is of poorer quality.¹⁶

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Article 148 of the Commercial Code provides that rights of industrial property, which include the right to use a particular trademark, shall be governed by "special laws."¹⁷ There is no special trademark law presently in force in Ethiopia. However, existing laws, particularly Article 133 of the Commercial Code and Article 674 of the Penal Code, provide civil and penal remedies for the victim of trademark imitation.¹⁸ In addition, the Ministry of Commerce and Industry is required to maintain a register of trademarks. No statute requires trademarks to be registered in order to be protected, but a recent court decision has indicated that registration may be necessary for that purpose.

14. Model Law, cited above at note 1, Art. 13. In some countries, this is called a "certification trade mark" -- for example, in the English Trade Mark Act of 1938, Art. 37, *Halsbury's Statutes of England* (2d ed.), vol. 25, p. 1213.

15. As in the Model Law, cited above at note 1, Art. 15. The use of a false indication of origin is expressly penalized in Ethiopia by Pen. C., Art. 674.

16. In addition to preventing confusion of customers, a businessman may have an interest in preventing "dilution" of his mark. As to dilution, see note 33 below and accompanying text.

17. The English version of Art. 148 states:

Art. 148.- Patents

(1) A business may consist of patents relating to registered inventions, trade-marks, designs and models.

(2) Patents shall be subject to the provisions of special laws.

A more accurate translation from the original French and the official Amharic of the word "patents" is "industrial property." This also applies to "patents" in Art. 127(2) (d). Note too that the word "registered" in Art. 148(1) modifies only the word "inventions" and not "trade-marks, designs and models;" this appears more clearly in the French and Amharic versions. References in this paper to the French version of the Commercial Code are to the *Code de commerce de L'Empire d'ethiopie de 1960* (Paris, Librairie generale de droit et de jurisprudence, 1965).

18. Some of the other relevant provisions are mentioned at appropriate places below. Discussion of all provisions which may apply in particular circumstances is beyond the scope of this article.

1. Commercial Code, Article 133

Articles 132-134 of the Commercial Code deal with the fault of unfair competition. That the rules governing unfair competition provide a remedy for trademark imitation is clear.¹⁹ To the extent that a trader has or is likely to have customers, he has a value defined by Article 130 of the Commercial Code as "goodwill." A trader's goodwill may decrease because of honest competition. For example, his competitors may take away his customers by offering a product or service of better quality. This is permitted, even though the trader's loss of goodwill is a natural result of the intentional acts of his competitors.²⁰ However, certain conduct which cuts down a competitor's good will is deemed to be improper and is therefore prohibited by law. In this sense, commercial activity is like a game. The competitors must play honestly, in accordance with the rules. The rules of the game of commerce are contained chiefly in the provisions forbidding unfair competition.²¹

According to Article 133(1), unfair competition generally consists of "any act of competition contrary to honest commercial practice." In particular,²² according to Art. 133(2):

The following shall be deemed to be acts of unfair competition:

- (a) any acts likely to mislead customers regarding the undertaking, products or commercial activities of a competitor.²³

19. Even if there were a special trademark law, the rules of unfair competition might provide a supplementary remedy. For example, in France, at least before the revision of the trademark statute in 1964, the victim of trademark imitation could follow two basic routes - an action under the special statute or an unfair competition action. Both might be brought, unfair competition being relied upon if the special law were held not to apply. See P. Roubier, work cited above at note 2, vol. 1, sec. 107. Compare the English actions of infringement and passing off, discussed in T. Blanco White, *Kerly's Law of Trade Marks and Trade Names* (9th ed., London, Sweet & Maxwell, 1966), nos. 592, 718. Of course, whether unfair competition remains as a general trademark remedy in Ethiopia if a special law is adopted would depend on the wording of the special law.

Note that the trade name and the distinguishing mark are expressly protected from imitation by the rules of unfair competition. Comm. C., Arts. 137(2), 138(2), 141(2).

See also the excellent discussion of trademarks and unfair competition by Judge Buhagiar in his dissenting opinion in *Azanaw Aleme v. Singer Sewing Machine Co. Ltd.*, (Sup. Imp. Ct., 1964), *J. Eth. L.*, vol. 2, p. 220.

20. See P. Roubier, work cited above at note 2, vol. 1, secs. 116, 118, distinguishing the doctrines of unfair competition and abuse of rights in French law.

21. Comm. C., Art. 131.

22. The words "in particular" are part of the Amharic and French versions of the introductory clause of Art. 133(2); they are not in the English version, although the sense of the English version would seem to require an interpretation giving a similar result. This means that an act may constitute unfair competition even though it is not listed in sub-Art. (2), thus giving the definition of unfair competition a flexibility which enables it to be adapted to changing commercial usage.

23. The definition of unfair competition in Art. 133 is substantially the same as Art. 10 bis, paras. (2) and (3), lines 1 and 2, of the Convention of Paris for the Protection of Industrial Property of 1883, as revised. The original French and official English translation of this convention, with revisions through 1958, are reproduced in *United States Treaties and Other International Agreements*, vol. 13(1962), p.1 (Art. 10 bis at pp. 14 and 37). Ethiopia is not a party to this convention, to the knowledge of the author.

The following discussion will focus on paragraph (2) (a), but the generality which paragraph (1) instills into unfair competition must be kept in mind. The scope of activities prohibited by the rules of unfair competition is broader than the specific acts mentioned in paragraph (2), and is impossible to define with precision. The essence of unfair competition is its relationship to the customs of the business community, evaluated as to what acts are honest and what are not.²⁴ Inherent in it is a flexibility which permits the judge to consider each case on its facts, in the context of the time and community involved.

Paragraph (2) (a) is particularly relevant here because trademark imitation may create confusion as to the "undertaking, products or commercial activities of a competitor." Of course, an act of imitation need not be in the form of another trademark to create this confusion. It may result when a person uses as any distinctive sign the trademark of another -- for example, as a trade name, distinguishing mark, or service mark.

Confusion among customers is the primary danger in cases of trademark imitation. An act is sufficient to create liability if it is "likely to mislead customers;" actual confusion is not required, although proof of actual confusion may help show that confusion is likely. It is interesting that the French version of this provision is more literally translated: "of such a nature as to create confusion by any means whatever."²⁵ The actual English version probably represents the intended meaning of the phrase; in any case, however, it is a preferable interpretation. In emphasizing the sufficiency of a likelihood of confusion, rather than actual confusion, it reduces for the plaintiff what might otherwise be an intolerable burden of proof. It also emphasizes that confusion of *customers* is feared. This suggests that the standard for evaluating similar marks should be the average purchaser of the product involved.²⁶

The degree of similarity there must be for a likelihood of confusion to exist varies with the case. Of course, full duplication would always result in a likelihood of confusion. But it seems clear that the signs need not be exactly the same. Although the characteristics of the average purchaser may vary with the product, he usually does not spend his day working with different marks and comparing them; he easily forgets the details. When he does go out to buy the product, he may pick it or take what is handed to him by a clerk without taking great care to examine the fine points of the trademark. The courts in other countries generally agree that trademarks should be compared in their entirety and not part by part. The marks should not be placed side by side and differences sought; rather, the judge should put himself in the place of the forgetful, inattentive average purchaser and decide whether a likelihood of confusion exists.²⁷

24. P. Roubier, work cited above at note 2, vol. 1, secs. 114, 118. He notes in sec. 114 that this principle is embodied in Art. 10 bis of the Paris Convention, the source of Art. 133. (See note 23 above.)

25. Art. 10 bis, para. (3) (1), of the Convention of Paris, cited above at note 23.

26. See E. Offner, work cited above at note 3, pp. 72-73.

27. Ibid. Offner's comments on this point refer to the determination of confusing similarity in proceedings to cancel or prevent the registration of trademarks under special trademark legislation, but they would seem to be applicable to confusion in unfair competition cases as well.

The Ethiopian judges have used differing approaches on this point. In *AZANAW ALEME v. SINGER SEWING MACHINE CO. LTD.*,²⁸ the signs were built around the letter "S", with a woman sewing within and the words "Singer Sewing Machines" along the contour, Ato Azanaw's with a sewing machine within, a crown on top, and the words "Sheba Sewing Center" following the letter. According to the Supreme Imperial Court, "there is not even a remote similarity, either in appearance or arrangement, between the trademarks . . . ; the possibility of confusing customers does not arise, because the two trademarks are distinctly different." The court felt so strongly about the dissimilarity of the marks that it described the suit as "nothing more than an attempt to harass a competing businessman under the guise of the law," and ordered the plaintiff, to pay the defendant "the damages it caused him by instituting a suit without good cause."²⁹ Judge Buhagiar, who dissented from the Supreme Imperial Court's decision, noted that the letters "S" used by both parties were "of exactly the same design;" notwithstanding the different details, he added, "the main characteristic and the principal feature in the design which attracts the eye is the "S", and this with the sewing machine (in one form or another) is . . . likely to create confusion. . . ."³⁰ According to the High Court, in which the suit was originally brought, Ato Azanaw's mark was "an accurate copy of plaintiff company's trademark, both in the letter and color."³¹ It seems clear that the major question which divides these opinions is the degree of detail with which the court should examine the trademarks.

There should exist some similarity in, or relationship between, the products in order for confusion as to a trader's "undertaking, products or commercial activities" to result. The closer the products, the more likely will the customer think their sources the same (for example, beer and wine as opposed to beer and automobiles).³² This factor is also required, in perhaps a greater degree, for the traders to be in competition — another requirement under Article 133, discussed below.

Note that, even if the products are completely dissimilar and there is little likelihood of confusion, a businessman may wish to prevent his trademark from being used by another in order to prevent its "dilution." The dilution concept rests on the idea that a trademark is a symbol of the product and, therefore, calls the product to mind whenever the trademark appears. A trader is benefitted if the trademark only calls his product to mind, instead of a variety of products. The more products it is associated with, the less the mark represents his product. Also, if the same mark is used on an inferior product, even if dissimilar, the public may associate the inferior quality with the trademark and therefore with all products which bear it. Finally, dilution of a mark's distinctiveness may eventually make it more difficult or impossible to protect as a trademark, since distinctiveness is the essence of the trademark. Since dilution occurs whenever a mark is used on another product, whether or not confusion is likely, a trader's interest in preventing dilution is satisfied whenever another trader is prevented from using the same mark.

28. Sup. Imp. Ct., 1964, *J.Eth. L.*, vol. 2, p. 220, reversing a decision by the High Court, Addis Ababa, 1964, *J.Eth. L.*, vol. 2, P. 277.

29. *J. Eth. L.*, vol. 2, p. 224.

30. *J. Eth. L.*, vol. 2, P. 227.

31. *J. Eth. L.*, vol. 2, p. 296.

32. See the discussion of evaluation of product similarity in B. Offner, work cited above at note 3, pp. 72-73.

But the confusion requirement cuts off part of the area in which dilution might occur (for example, when the same mark is used on beer and automobiles). Although the courts in some countries have protected against dilution even where there is no confusion, the concept generally has not been widely accepted.³³ The confusion requirement in Article 133(2) (a) of the Commercial Code, and the necessity for product similarity contained in the competition requirement, prevent protection of marks from dilution under Article 133 insofar as dissimilar goods are concerned.

In addition to the nature of the trademarks and products, a variety of factors may affect the likelihood of confusion of customers. For example, in *AZANAW ALEME v. SINGER SEWING MACHINE CO. LTD.*, the alleged unfair competitor had been employed by the plaintiff before starting his own business and ran his business with his marks displayed in the same building which plaintiff had occupied before moving to a new location. The High Court took this into account in finding a likelihood of confusion to exist.³⁴

Article 133 applies only to improper acts by competitors. Competitors are those businessmen who are attempting to attract the same customers, or, in other words, to sell in the same market. In the present context, this entails three major elements: they must be selling similar products, in the same area, at the same time.³⁵

(1) The person who produces teff is not in competition with the person who manufactures automobiles. But the products need not be exactly the same before competition results. The maker of wine may very well be competing with the maker of beer or even non-alcoholic drinks.

(2) The person who sells beer only in Ethiopia is not in competition with a person who sells beer only in France. But the size of an area of competition is relative, particularly with regard to the size of the business, the type of product and the prospective customer. The increase in mobility of persons and products makes it particularly difficult to say where the competitive area begins and where it ends. For example, if one beer manufacturer sells his product only in Asmara and another beer manufacturer only in Addis Ababa, they are not generally in competition with each other. But it would be a mistake not to treat them as being in competition for purposes of protecting against trademark imitation. With the increasing movement of people between Asmara and Addis Ababa, customers who do travel might very well be confused as to the source of the product. More important, it is wise to recognize that certain products may easily expand into new markets. Taking into account an area of potential competition may help promote the expansion of trade and commerce. It even may be argued that this area with regard to trademarks should extend to the nation's boundaries.³⁶ If this is done, however, a difficult

33. E. Offner, work cited above at note 3, p. 75. For a commentary on the dilution concept in the context of United States law, see Note, "Dilution: Trademark Infringement or Will-O'-the-Wisp?," *Harvard L. Rev.*, vol. 77 (1964), p. 520. See also Schechter, work cited above at note 2.

34. Case cited above at note 28, p. 298. The Supreme Imperial Court did not discuss these facts when it reversed the High Court's decision; it relied on its own finding that the marks themselves were too different for confusion to result.

35. See G. Lagarde, "Unfair Competition-France," in H.L. Pinner (ed.), *World Unfair Competition Law* (Leyden, Sijthoff, 1965), vol. 2, p. 972.

36. As to the effect of national boundaries on the question of trademark rights, see pp. 15 and 17 below.

problem may arise if traders using similar marks in different areas each build up a clientele before they begin to sell in the same area. It may be unfair to require one to give up or modify his mark. One solution to this dilemma may lie in the degree of culpability required for a particular remedy to apply. This is discussed below.

(3) A person who no longer sells or does not yet sell a product is no longer in competition with a person who does. Here, too, difficult interpretative questions may arise. A person may stop making or selling a product temporarily, yet it would seem his mark should be protected for a reasonable time, or until he abandons it. Likewise, a person who has not yet brought his product onto the market arguably should be protected for a reasonable time if he has taken preliminary steps to do so - for example, by advertising his product and trademark.³⁷ Whether the idea of competition covers the situations is unclear.

May a person be guilty of unfair competition if he acts in good faith, not knowing that his mark resembles to the point of confusion the trademark of someone else? Or must it be proved that he actually acted in bad faith, knowing of the existence of the other trademark and intending that, by imitating it, customers will be misled to buy his products instead of his competitor's? Or is there some middle ground? Article 133 does not fully answer these questions. Article 133(1) requires that an act be "contrary to honest commercial practice" in order to constitute unfair competition; "honest" is a vague term, permitting great flexibility in interpretation. Article 133(2) mentions no mental element; but, since it contains particular examples of acts falling within Article 133(1), the minimum standard of "contrary to honest commercial practice" would seem to apply to it.

If a person acts in bad faith, intending that his trademark mislead customers into thinking his products are those of someone else, or knowing that such will likely be the result of his acts, and his acts have this result, he clearly commits unfair competition. He should also be liable if he acts negligently; that is, if he did not know his trademark would be likely to mislead customers, but if he should have known it. This may occur when he did not actually know of the existence of the other trademark, but should have; when he did not believe his trademark was confusing, but should have; or when he did not think the other sign was a valid trademark, but should have. Although not clearly stated by the code, liability for negligent creation of a likelihood of confusion results from a consideration of the underlying purposes of the rules preventing unfair competition and their place in the legal scheme.³⁸

The most important purpose of the rules against unfair competition is to assure that competition is fairly and properly carried on.³⁹ This purpose can best be served if negligent conduct is prohibited as well as intentional conduct. Traders should be encouraged to be careful in their choice of trademarks and other distinguishing signs. Since the number of different signs from which a person may choose a trademark is quite broad, the burden is not a serious one.

37. Regarding publication of customary notices, see Section 4 below.

38. In France, for example, the courts originally required proof of bad faith. But now a showing of imprudence or negligence is sufficient. Even good faith may not be a sufficient defense for purposes of an injunction (as opposed to damages). *Dalloz Encyclopedie juridique*, cited above at note 12, vol. 1, *Concurrence deloyale ou illicite*, nos. 13-17.

39. P. Roubier, work cited above at note 2, vol. 1, sec. 109.

Unfair competition is a particular type of extra-contractual liability.⁴⁰ The general rules of extra-contractual liability are contained in Title XIII of the Civil Code. According to Article 2027, the sources of extra-contractual liability are conduct which constitutes a fault and conduct which, although not a fault, is made the basis of extra-contractual liability by law.⁴¹ Unfair competition is a type of liability based upon fault.⁴² According to Article 2029(1) of the Civil Code, fault "may consist in an intentional act or in mere negligence." Although certain wrongs may be limited to one (for example, physical assault, in which intent is part of the definition),⁴³ there is no express limitation in the definition of commercial unfair competition. The definition of civil unfair competition in Article 2057 of the Civil Code does require that the act of the offender be "contrary to good faith."⁴⁴ This does not necessarily govern Article 133 of the Commercial Code, however, since the latter contains its own definition; a violation of Article 133 is expressly treated as a violation of Article 2057 when its own requirements are fulfilled. Unless the requirement of civil unfair competition is held to carry over to the commercial area, there does not appear to be any reason why negligent conduct should not be considered wrongful in this area, just as it is generally in cases of extra-contractual liability.⁴⁵

The fundamental purpose of assuring fair competition raises particularly difficult problems when a trader has acted in good faith and without negligence, but his mark is still likely to confuse customers. If he continues using his mark, the purpose of the rules will be thwarted; yet it seems unfair to punish him. Here, a court might take advantage of the great flexibility of the remedies available to it to arrive at a just compromise. For example, a court might order the trader to stop using the confusing mark in the future, but not award damages based on prior use. This is consistent with the essentially preventive nature of the rules against unfair competition.⁴⁶ Or, if it would be particularly unfair to prevent him from using the mark -- for example, if he had been using it some time and built up a clientele connected with it -- a court might merely order modifications to avoid confusion as well as can be done in the circumstances. In this latter case, the court might even refuse to apply any remedy because of the delay of the plaintiff in bringing his action.⁴⁷

40. Comm. C., Art. 132. The English version of Art. 132 states: "A trader may claim damages under Art. 2057 of the Civil Code from any person who commits an act of competition which amounts to a fault." A more accurate translation from the French would read: "A trader may bring an action for extra-contractual liability under Art. 2057 of the Civil Code against any person who commits an act of competition which amounts to a fault."

41. The English version of the Civil Code uses the term "offence" as a translation of the French "faute." Articles 132 and 133 of the Commercial Code use "fault" as a translation of the same French word. "Fault" is used in this paper as the preferable translation.

42. Comm. C., Art. 132.

43. Civ. C., Art. 2038(1).

44. Civ. C., Art. 2057: "A person commits an offence where, through false publications, or by other means contrary to good faith, he compromises the reputation of a product or the credit of a commercial establishment."

45. See P. Roubier, work cited above at note 2, vol. 1, sec. 109.

46. See *id.*, secs. 109, 111.

47. Compare Civ. C., Arts. 2097, 2121.

Since unfair competition is a species of extra-contractual liability, all the Civil Code provisions on extra-contractual liability dealing with matters not expressly covered in Articles 132-134 are applicable; for example, period of limitation, burden of proof, extent of damages, responsibility of persons or bodies corporate for the acts of others, etc.⁴⁸ Certain remedies are expressly provided in Article 134. The injured person may claim damages from the unfair competitor. The court may also make such orders as are necessary to put an end to the unfair competition; these may include, in particular, an order under Civ. C., Art. 2120, to publish at the expense of the unfair competitor notices designed to remove the effect of the misleading imitation, and an injunction under Civ. C., Art. 2122, prohibiting the unfair competitor from continuing his misleading acts. A temporary injunction may be granted as early as the institution of the suit.⁴⁹ As indicated above, a court enjoys broad flexibility in tailoring the remedy to the facts of the particular case.

It should be noted that, in theory, the rules of unfair competition do not give a trader the right to use a trademark; they are aimed more at preventing another person from imitating a trademark already in use. The emphasis is not on the first user's property rights, but rather on the second user's mis-conduct.⁵⁰ Thus, it is unimportant for purposes of trademark protection through unfair competition to consider whether a person has a property right in a trademark. That question has puzzled the jurists of many countries,⁵¹ and is not easily answered in Ethiopian law. Trademarks are listed as rights of "industrial property" in the Commercial Code and are considered "elements" of a business, which itself is deemed property by the Code.⁵² On the other hand, trademarks are nowhere expressly defined as property rights — as are literary and artistic property in the Civil Code, for example.⁵³ If any legislative enactment is to do this, it is likely that the special laws contemplated by Article 148 are what the drafter of the Commercial Code had in mind.⁵⁴

If we do wish to think in terms of rights and to consider how a person acquires the right to use a trademark in Ethiopia, we must really consider what he must do to be able to protect it -- in the present context, under Article 133.⁵⁵

48. See generally, Civ. C., Arts. 2090-2161. As to the possibility of the plaintiff recovering profits wrongfully made by the defendant, compare Civ. C., Arts. 2162 and 2163 dealing with unjust enrichment. As to the relationship between remedies in unfair competition and extra-contractual liability in French law, see P. Roubier, work cited above at note 2, vol. 1, sec. 111. He notes that although some prejudice normally must be shown for extra-contractual liability to exist, the emphasis in unfair competition on a likelihood of confusion reduces the need to show actual prejudice. This is consistent with the rationale based on prevention of wrongful conduct. If damages are sought by the plaintiff, the rationale for granting them is reparation of harm done to him, and some damage (although perhaps difficult to evaluate) should be shown.

49. Civ. Pro. C., Art. 155.

50. P. Roubier, work cited above at note 2, vol. 1, secs. 4, 114, 115. He distinguishes between protection of trademark rights created by special statute and wrongful conduct prohibited by the rules of unfair competition.

51. See, for example, F. Schechter, work cited above at note 1a.

52. Comm. C., Arts. 127, 148. See note 17 above regarding the translation of these provisions.

53. Civ. C., Art. 1647.

54. As in French law. See note 50 above.

55. Protection under other articles will, of course, depend on the elements of those articles. See, for example, Pen. C., Art. 674, discussed below.

It would seem sufficient if he satisfies the requirements of Article 133 that he be a competitor of the alleged wrongdoer and that, at least under paragraph (2) (a), the mark has been used on or with relation to goods to the extent that an imitation by the alleged wrongdoer is likely to confuse customers. This returns us to the definitions previously discussed. The plaintiff may also have to show in a court action that his mark is sufficiently distinctive to be protectible as a trademark. This may be particularly difficult in the case of signs which are originally descriptive but which are claimed to have acquired a link with the plaintiff's product in the minds of customers.⁵⁶ The effect of registration is discussed below.

2. Penal Code, Article 674

Article 673 of the Penal Code provides for criminal unfair competition. It may be applicable in a case of trademark imitation, but Article 674 provides more direct coverage and will be the main subject of discussion here.

Article 674 provides:

(1) Whosoever intentionally,

- (a) infringes, imitates or passes off, in such manner as to deceive the public, another's mark or distinctive signs or declarations of origin on any produce or goods or their packing, whether commercial, industrial or agricultural; ... is punishable, upon complaint, with simple imprisonment or fine.

The same penalty is imposed on those persons who sell, offer for sale, import, export, distribute or place on the market goods which they know have trademarks which are imitations, and those persons, who refuse to declare the origin of goods in their possession with such marks.⁵⁷ This article is essentially a form of unfair competition, in that it emphasizes the misconduct of the wrongdoer in misleading the purchasing public. But its scope is both broader and narrower than Article 133 of the Commercial Code. The differences are important even to the person who does not seek a penal remedy, since a violation of Article 674 also may result in civil liability pursuant to Article 2035 of the Civil Code.

Insofar as the act of imitation, the likelihood of misleading customers and the involvement of products are concerned, there is little difference between Article 674 and Article 133. Article 674 speaks of infringement and passing off as well as imitation, but for purposes of this discussion these words essentially mean the same thing.⁵⁸ Article 674 says, "in such manner as to deceive the public," instead of

56. See E. Offner, work cited above at note 3, p. 82.

57. Pen. C., Art. 674(1) (b) and (c).

58. The words "infringes" and "passes off" may have somewhat different meanings. For example, in English law, "infringement" refers to the imitation of a trademark registered pursuant to the trademark registration statute. *Halsbury's Laws of England* (3d ed. London, Butterworth, 1962), vol. 38, Trade Marks, Trade Names and Designs, p. 648. The French version of the Ethiopian Penal Code uses "contrefait," which is used in France in this context to denote the same thing "infringement" does in England. Perhaps the drafters of the Code thought of Art. 674 as providing a remedy for imitation of a registered mark when a special registration statute comes to be adopted, as well as providing a more general remedy for imitation of non-registered marks. "Passing off" in English law refers generally to the false representation that a person's business or goods are the same as or connected with the business or goods of another person. *Halsbury's Laws*, vol. 38, pp. 593-596. It is thus akin to unfair competition in Ethiopian law.

"likely to mislead customers," but the two phrases should be interpreted the same way. One might argue that the phrase in the Penal Code requires actual confusion, but such a strict construction is unsound in light of the difficulty of proving actual confusion and the relation of Article 674 to unfair competition generally.⁵⁹ A strict reading is not justified by the fact that penal sanctions are more severe than civil sanctions, since the requirement of intent (discussed below) adequately protects the offender's interests in this regard. Use of the word "public" instead of "customers" is a reflection, if anything, of the fact that competition itself is not a pre-requisite to the application of Article 674.

The major differences between Article 674 and Article 133 are that Article 674 may apply even if the offender and victim are not competitors and that it will not apply unless the offender actually intended to imitate the victim's mark in such manner as to deceive the public.

Article 674 does not mention competition or competitors. Thus, it is not necessary that the offender and the injured person actually be trying to reach the same customers; that is, that they be selling similar products in the same area at the same time. These requirements are not completely eliminated, however. As discussed above with regard to unfair competition, without some similarity or relationship between the products there will probably be no likelihood of confusion. If the products are not sold at the same time in the same area, there also is little likelihood of confusion. One major exception to this must be noted, however. A trademark may be well-known in a country or area even though the product is not sold there. This may occur, for example, through advertising, or importation of the goods without resale, or travel by people from that area into an area where the product is sold. In such a case, there may be a likelihood of confusion arising from imitation of the well-known mark.⁶⁰ This problem has been particularly important in international trade. Trademark rights are generally deemed to be territorial. Acquisition of such rights in one country does not, in the absence of treaty, give the holder rights in another country. The dangers of this theory for well-known trademarks were recognized in the Convention of Paris for the Protection of Industrial Property, which expressly obligates the parties to provide protection for well-known marks.⁶¹ Well-known marks arguably could receive protection under Article 674 of the Penal Code; they could not under Article 133 of the Commercial Code, since that article requires that the parties be in competition.

The degree of culpability which a person must have before he violates Article 674 is clearly stated. He must have intended to imitate the trademark of another in such manner as to deceive the public. Pursuant to Article 58 of the Penal Code,

59. The French version of this phrase in *Comm. C.*, Art. 133 is closer to the phrase in Art. 674. See note 25 above and accompanying text.

60. It may seem odd that the penal provision is less strict than the civil provision in regard to the requirement of competition, since a penal sanction is more severe than a civil sanction. As indicated, however, the difference is not as great as might appear on the surface, since there at least must be a likelihood of confusion. The requirement that the offender have intent more than balances the remaining difference.

61. Convention of Paris for the Protection of Industrial Property, cited above at note 23, Art. 6 bis. See also Law of December 31, 1964 (Fra.), Art. 4, in *Code de commerce* (Petits codes Dalloz, 63d ed., 1967), p. 708; A Chavanne, "La notion de premier usage de marque et le commerce international," in *Mélanges en l'honneur de Paul Roubier* (Paris, Lib. Dalloz and Sirey, 1961), vol. 2, p. 377.

this element is satisfied either if he committed the act with full knowledge of the other mark and intent to deceive, or if he was aware that his mark would or might deceive the public and committed the act regardless that this would occur.

Penal proceedings against a person who violates Article 674 may be brought only upon a complaint made by the person injured. The offender is punishable with simple imprisonment or fine, or both. Aside from this, the court must order the seizure of the infringing objects and any proceeds of the sale of such objects, and the judgment must be given publicity by the court, at the cost of the offender.⁶²

A person who violates Article 674 incurs civil liability as well as penal liability. A civil action may be brought under Article 2035 (1) of the Civil Code, which provides that a person commits a fault "where he infringes any specific and explicit provision of a law."⁶³ The remedies under Article 2035 are essentially the same as those under Article 133 of the Commercial Code: damages, injunction, publicity at the offender's expense, and, "subject to the liberty of persons and to the rights of third parties, ... any appropriate measures to make good or limit the damage."⁶⁴

3. Registration of Trademarks

Protection of trademarks through the device of unfair competition (or a related remedy, such as Article 674 of the Penal Code), creates difficult problems for trademark users. In order to meet these problems, most nations have adopted trademark registration statutes. Although these statutes vary in their effects, they at least enable a merchant to discover some or all of the marks claimed by others and to give notice to others of the marks they adopt. A registration statute may enable a merchant to test in advance the validity of his mark by permitting the registrar to reject those that are not valid. Registration of the mark may be considered to establish its validity, or at least to raise a presumption of validity. Registration might be treated as extending the use of the mark throughout the entire country, thus assuring protection in markets in which the merchant does not yet sell his goods. Some statutes permit merchants to protect their marks against dilution, by permitting them to claim the mark for goods other than those on which the mark will immediately be used. Some permit a merchant to register marks similar to the one he actually intends to use, to expand the area of protection around his mark by preserving its distinctiveness. Some permit the merchant to reserve marks for use in the future. Registration may enable a merchant to take advantage of treaties and foreign laws which permit protection of a mark in foreign countries only if the mark is already registered in the merchant's own country. Finally, registration provisions are often part of comprehensive trademark laws,

62. Pen. C., Arts. 89, 159, 217, 674, 677, 679. As to secondary punishments and preventive and protective measures which might also be applied in exceptional circumstances, see Pen. C., Arts. 120-127, 138-160.

63. See also Pen. C., Art. 100, regarding damages in penal actions. Regarding joinder, see P. Graven, "Joinder of Criminal and Civil Proceedings," *J. Eth. L.*, vol. 1 (1964), p. 135.

64. Civ. C., Arts. 2090, 2120-2122 (quoting from Art. 2090(2)).

regulating such matters as assignment and licensing and providing special remedies for infringement.⁶⁵

In Ethiopia, the Ministry of Commerce and Industry is required by Article 24(d) of the Ministers (Definitions of Power) Order to maintain a trademark registry.⁶⁶ But no statute obligates a trader to register his trademark or states what the effect of registration is. Trade names must be included on registration statements filed under the Business Enterprises Registration Proclamation, but this appears to be for informational purposes only; no special legal effects are stated.⁶⁷ The proclamation does not speak of trademarks. Articles 105(i), 105(j), and 106(d) of the Commercial Code require inclusion of trade names and distinguishing marks on business registration statements, but trademarks are not mentioned; in any case these provisions are not yet in effect.⁶⁸

Since no law attributes legal effects to trademark registration, the conclusion perhaps to be drawn is that there are no special legal effects. Even assuming this to be true, registration still serves a purpose. The prudent businessman will examine the register before using a trademark to ascertain the claims of others. He will register the trademark he chooses, to give notice to others.

Registration could easily be interpreted to be relevant to non-penal unfair competition, particularly with regard to the mental status of the infringer. Thus, it might be argued that a trader should know of trademarks in the registry. If bad faith is deemed to be an element of unfair competition, the trader could be presumed to know of registered marks, such a presumption being either conclusive or shifting the burden of proof to the alleged unfair competitor to prove his lack of knowledge. The Commercial Code does establish a conclusive presumption of this nature for registered trade names and distinguishing marks.⁶⁹ Failure to examine the registry might at least be evidence of negligence on the part of the trader.

65. See E. Offner, work cited above at note 3; A. Chavanne, work cited above at note 61; Model Law (including commentary), cited above at note 1. Note in particular the Draft Model Law for Developing Countries on Marks, Trade Names, Indications of Source and Unfair Competition, prepared by the United International Bureau for the Protection of Intellectual Property in 1966 (commented upon by E. Offner, work cited above at note 6) and the trademark law adopted by the adherents to the African and Malagasy Convention, cited above at note 3. A survey of world trademark laws is contained in a special volume on patents and trademarks of National Association of Credit Management, *Digest of Commercial Laws of the World* (Dobbs Ferry, New York; Oceana Publications; loose-leaf). Some national registration laws are cited in other notes in this paper - for example, France, note 61; England, note 14; Canada note 77. See also Webster, *Patents, Trade Marks and Designs in Africa* (Pretoria, Patlaw, 1961).

66. 1966 Order No. 46, *Neg. Gaz.*, year 25, no. 23. Art. 24(d) continues the obligation to maintain a registry of trademarks established by Art. 32(h) of the Ministers (Definition of Powers) Order, 1943, Order No. 1, *Neg. Gaz.*, year 2, no. 5. Art. 32(h) was repealed by Order No. 46.

67. Arts. II(1) (b) (1), III(1) (c) (1), IV(1) (a) (2), 1961, Proc. No. 185, *Neg. Gaz.*, year 21, no. 3.

68. See Comm. C., Art. 1174(1).

69. Art. 120(2) provides that "third parties shall not be permitted to prove that they did not know of a fact entered in the commercial register." Note, however, that trade names and distinguishing marks are *not* listed among the facts which "shall not affect the rights of third parties in good faith where they have not been entered in the commercial register." Art. 121. Note also that these articles are part of the registration provisions which are not yet in effect, under Art. 1174(1).

The problem of determining the effects of registration has received judicial consideration. The Supreme Imperial Court recently dealt with the relationship of two signs, one of which was used before the other, but only the second registered. In that case, Singer Sewing Machine Company sued Ato Azanaw Alemu under Article 133 of the Commercial Code to stop him from using a distinctive sign claimed to be similar to the trademark used by Singer.⁷⁰ Both parties used the design in connection with sewing machines. Singer's product and trademark were in use in Ethiopia for many years before those of Ato Azanaw, and Singer had published cautionary notices more than thirty years before Ato Azanaw, but Ato Azanaw had registered his trademark at the registry of the Ministry of Commerce and Industry and Singer had not. The High Court found for Singer and prohibited the use of the design by Ato Azanaw.⁷¹ The Supreme Imperial Court, one judge dissenting, reversed. It said:

It does not help to approach the dispute in light of the law on registration of trademarks and sole ownership because there is no such law in Ethiopia. And since we must resort to equity to arrive at a solution, we are compelled to determine who registered this letter "S" as a trademark first by consulting the register kept by the proper authorities. Under the law, or more appropriately, in equity, a businessman may monopolize a trademark and have other businessmen barred from using it only if he was the first person to have that trademark registered with the authorities empowered to register such trademarks. The mere fact that a person has used a trademark for a long time does not entitle him to claim that he is the sole owner and that others are prohibited from using it, unless he was the first person to have the trademark registered and reserved for his exclusive use. In the absence of any legislation on trademarks, both equity and the spirit of foreign legislation on the subject, and the practice abroad, dictate that we study the registers to determine the rights of both parties.⁷²

Registration, the court added, is "in accordance with the usage of the country."⁷³ The court treated unfair competition as an independent doctrine and rejected its application in this case because it did not believe the marks involved were so similar that confusion would result.⁷⁴ Article 674 of the Penal Code was not mentioned by either the High Court or Supreme Imperial Court and apparently was not made the basis of any claim.

The demand for certainty and stability in trademark usage may very well justify a general rule that trademarks be registered in order to receive protection. By searching the register, a trader knows whether or not the mark which he wishes to adopt is available for use. Once his mark is registered, he knows it is protectible from imitation and generally safe from attack, particularly if the registration process involves a determination as to the validity of the mark.⁷⁵ But in some situations, the interest in certainty may be outweighed by other interests - for example, discou-

70. The nature of the marks involved is described in the text accompanying notes 28-31 above. Note that the defendant's sign was a distinguishing mark, not a trade mark. For purposes of liability for imitation of another's trademark, the distinction is unimportant. See p. 135 above.

71. *Singer Sewing Machine Co. Ltd. v. Azanaw Alemu* (1964), *J. Eth. L.*, vol. 2, p. 298.

72. *Azanaw Alemu v. Singer Sewing Machine Co. Ltd.* (1964), *J. Eth. L.*, vol. 2, p. 223.

73. *Ibid.*

74. See notes 28-31 above and accompanying text.

75. See E. Offner work cited above at note 6, p. 832.

raging dishonest conduct, preventing deception of customers, and considerations of fairness to the prior user (the person who has used his trademark without registering it, before someone else registers a similar mark). This may occur in particular when the registrant knows of the trademark of the prior user and registers his own in order to appropriate to himself the other's goodwill. If the registrant is permitted to continue using the mark, dishonest conduct is rewarded. Deception of customers will result. If in addition the prior user is ordered to stop using his mark, he will lose the goodwill he has built up and be put to the expense of rebuilding it on the basis of a new trademark. All this may seem a high price to pay for trademark certainty.

The tension between trademark certainty and considerations involving the protection of unregistered prior users has produced different solutions in different countries. Under some trademark laws, a prior user who has not registered will prevail over the registrant.⁷⁶ Under other laws, the prior user who has not registered retains his priority, but only for a statutorily limited period (for example, five years). If he does not take action to have the later user's registration cancelled within that time, he may lose his right to the trademark.⁷⁷ Finally, some laws provide that the right to use a trademark is acquired only by registration and that a registrant generally will prevail over an unregistered prior user.⁷⁸ However, even the laws which make registration conclusive, either from the beginning or after a grace period, do not necessarily cut off all the rights of unregistered prior users. For example, the French statute expressly protects trademarks which are well-known, against infringement by registered marks - for five years if the registration is in good faith, presumably for an unlimited period if it is not.⁷⁹ The Canadian statute permits the cancellation of a registration even after the end of the five-year grace period if "it is established that the person who adopted the registered trademark in Canada did so with knowledge" of a mark previously used or made known.⁸⁰

Aside from giving substantive rights to unregistered trademarks, many statutes provide procedures which, in lending stability to registered marks, help the owner of an unregistered trademark to protect it. These may include an examination by the registration authorities to determine whether a mark proposed for registration

76. For example: E. Vandenberg III, *Trademark Law and Procedure* (New York, Bobbs-Merrill Co., 1959), pp. 42-43, discussing United States Law. This also appears to be the result under Italian law (see *Digest of Commercial Laws of the World*, cited above at note 65) and was the result under the old French law, discussed by P. Roubier, work cited above at note 2, sec. 29.

77. For example: Trad Marks Act (Canada), Art. 17, 1-2 Eliz. II, chap. 49; Model Law, cited above at note 1, Art. 5; compare the British Trade Marks Act of 1938, Arts. 7, 11 and 13, statute cited above at note 14. Under the Canadian act, after the grace period ends the court may under limited circumstances permit the unregistered mark to continue in use along with the registered mark; Arts. 21, 22.

78. For example: Law of December 31, 1964 (France), cited above at note 61 (see the commentary on this law by A. Chavanne, in *Recueil Dalloz Sirey* (1965), *Chronique*, p. 83); Argentine law, discussed in *Digest of Commercial Laws of the World*, cited above at note 65; see also the German law. Compare the Draft Model Law for Developing Countries, as discussed by E. Offner, work cited above at note 6.

79. Law of December 31, 1964, Art. 4, cited above at note 61, and commentary by A. Chavanne cited above at note 78. This reflects Art. 6 bis of the Convention of Paris, cited above at note 23, which requires its adherents to protect well-known marks in the manner specified.

80. Trade Marks Act, Art. 17(2); Model Law, cited above at note 1, Art. 5, comes to a similar result. Compare E. Offner, work cited above at note 6.

is already in use. Or, there might be publication of the proposed mark before or after its registration with opportunity given to prior users to oppose the registration or to obtain its cancellation.⁸¹

Earlier in this section, it was stated that registration might be relevant to unfair competition, particularly with regard to proving the defendant's state of mind. The court's opinion suggests the reverse: that a later user can cut off unfair competition liability by registering his mark first. If the prior user's mark is not registered, this may help show the absence of bad faith or negligence on the part of the later user. But if the registrant actually is in bad faith, or perhaps even negligent, and if the policies suggested above regarding protection of the prior user are accepted, registration should not preclude his liability.⁸²

In the case under discussion, the defendant clearly knew of the plaintiff's trademark before he registered his own.⁸³ However, the essential point in the case was the court's determination that the marks were not confusingly similar. This precludes liability for unfair competition and under Article 674 of the Penal Code. It might even preclude liability if the prior user actually had registered his mark, since he has little ground for complaint if the marks are dissimilar. Thus, even though the court treated registration as an independent matter, it is not completely clear what the court might do if faced with a situation where the marks of the unregistered prior user and the registrant are confusingly similar and the registrant registered his mark in bad faith.

4. Advertising

In Ethiopia and elsewhere, it is customary for persons who wish to use and protect a trademark to publish "cautionary notices" in newspapers warning others not to use the mark, at least with relation to goods such as those on which it is used by the advertiser. It is not expressly required by any Ethiopian law, but it is still strongly advisable. Publication helps make the trademark known to the the public, and gives notice of it to other businessmen. Moreover, since it is customary, a court may give it (or lack of it) weight in evaluating trademark rights.⁸⁴

CONCLUSION

Trademark protection at present is provided chiefly by the rules of unfair competition in the Commercial Code (Articles 132-134) and by Article 674 of the Penal Code. Registration of the trademark at the Ministry of Commerce and Industry has been held to be a pre-requisite of its protection. Publication of cautionary notices is customary. A special trademark law is contemplated by the Commercial Code, and one is apparently in preparation. It is to be hoped that such a law will clarify many of the ambiguities presently existing in the law, and at least make clear the relation between it and the code provisions which currently apply to trademarks.

81. Compare the alternative registration procedures suggested by the Draft Model Law, discussed by E. Offner, work cited above at note 6, pp. 834-836.

82. This would seem to be the result provided in the case of trade names and distinguishing signs. See note 6 above.

83. See the opinion of the High Court, cited above at note 28.

84. Note the reliance by the Supreme Imperial Court on usage in evaluating the effect of registration in *Azanaw Alene v. Singer Sewing Machine Co. Ltd.*, as cited above at note 73.