

THE PROTECTION OF WELL-KNOWN MARKS IN GHANA



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Newsletter

Editor's Note

Integrated Legal Consultants (ILC) was founded in April 2007, in Accra, Ghana, to offer dedicated and innovative corporate legal services while ensuring that the Ghanaian and West African business community and our network of international clients benefit from the highest quality of corporate and commercial legal services that the Practice provides.

As part of this vision, the firm has introduced the publication of newsletters on legal and economic issues that would be of interest to clients and equally affect their transactions. This is our 13th edition.

The outbreak of the COVID-19 pandemic forced the world to go digital and in effect rely more on the intellectual property (IP) created by others for running their businesses. Thus, the protection of these IP rights across the globe (which is mainly territorial) has become very important.

In this issue, we have taken a look at well-known marks and the provisions of the Trade Marks Act, 2004 (Act 664) that pertain to their protection in Ghana.

We hope you find it informative and educative. Your feedback is welcome.

Esohe Olajide

Editor

Olusola Ogundimu

Editor-In-Chief



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In Ghana, the protection of intellectual property (IP) rights particularly trademarks, is regulated by statutes which recognize and protect both registered and unregistered marks. The principal legislation with respect to trademarks is the Trade Marks Act, 2004 (Act 664) as amended by the Trademarks (Amendment) Act, 2014 (Act 876).

In addition, the Protection Against Unfair Competition Act, 2000 (Act 589) also provides for protection of trademarks (whether registered or not) against unauthorised and misleading use in trade circles.

In the past eighteen (18) to twenty-four (24) months, many businesses have had to rely more on digital solutions and in turn, IP created by third parties, particularly to aid remote work, due to the outbreak of the COVID-19 pandemic. This trend has also brought to the fore front the importance of recognition and protection of IP rights particularly trademarks across the world as well, as in Ghana.

A trademark is defined by Section 1 of Act 664 as amended to be:

“ (1) A sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods and services of another undertaking.

(2) A trademark may consist of

(a) words, personal names, designs, letters, colours, numerals, shapes, holograms, sounds or a combination of any of these elements, or

(b) slogans, where they are not long enough to be protected by copyright.”



In effect, trademark rights basically guarantee protection for the brand names, logos, or slogans used to promote various goods and services in Ghana and across the world.

The protection of trademarks is territorial thus, the general principle regarding trademarks is that protection is limited to the jurisdictions/countries in which registration is effected in respect of each trademark. Consequently, proprietors of marks should ensure they take steps to effect registration of trademarks in countries where they are actively using or intend to use their trademarks for promotion of their goods and services.

Aside from the rights conferred on the proprietor of a trademark upon registration of same in Ghana, per Section 9 of Act 664, protection is also granted in Ghana to proprietors of trademarks which are registered in other jurisdictions in line with the Paris Convention on the Protection of Industrial Property

1883 (Paris Convention).



The Paris Convention provides in Article 6bis (1) as follows:

“(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith”

This provision is codified in our local laws by virtue of Section 52 of Act 664 as amended by Act 876 which reads as follows:

“Well-known trademark means the trademarks of a person who is:

- (a) A national of a country that is a party to the Paris Convention; or*

- (b) Domiciled in or has a real of effective commercial establishment in a country that is a party to the Paris Convention and the trademark is recognized or known in the relevant public sector as belonging to the person”*

Thus, trademarks that are well known as defined in Article 6bis of the Paris Convention are entitled to protection in Ghana by virtue of Section 52 of Act 664 as amended.

The effect of this provision is that it allows proprietors of well-known marks to take steps to protect their well-known marks in Ghana. This could include opposing the registration of offending marks, or where they are registered, seeking reliefs from the High Court for the enforcement of rights in their trademarks against unlawful use of confusingly similar or identical marks by third parties in Ghana.

It is important to note that the registration of the mark being sought to be protected in Ghana is not a prerequisite for the grant of a legal right against infringing third parties in respect of well-known marks. Section 52 of Act 664 makes no mention of registration in Ghana being a requirement for protection of such marks.

The essence of the Paris Convention is to repress unfair competition by third parties who have not sought the consent of the proprietor of a mark but are rather carrying on business using same in the bid to ride on the coattails of the owner of the mark.

Since Ghana is a party to the Paris Convention, it has taken steps to recognize well-known marks as

contained in the reference Section 52 of Act 664.



Similarly, Section 1 of Act 589 provides thus:

“Any act or practice in the course of industrial or commercial activities, that causes, or is likely to cause, confusion with respect to another person's enterprise or its activities, in particular, the products or services offered by that enterprise, constitutes an act of unfair competition.”

Section 2 further provides that:

“Confusion may in particular, be caused with respect to—

- (a) a trademark, whether registered or not;*
- (b) a trade name;*
- (c) a business identifier other than a trademark or trade name;*
- (d) the presentation of a product or service; or*
- (e) a celebrity or well-known fictional character.”*

Thus, a proprietor of a trademark whether registered or not may approach the courts for injunctive remedies under Act 589 and in the case of well-known marks seek reliefs both in terms of Act 664 and 589 respectively.

It is important for proprietors of well-known marks across the world to keep watch to ensure that their marks are not being infringed upon in Ghana. Where such instances occur or a threat of same exists, they

should take immediate steps to bring such infringing acts to an end as these marks are protected under our trademark laws.

Proprietors should note however, that where they intend to actively use or trade with their trademarks in Ghana, they should in addition, take steps to effect registration of such marks at the Ghana Industrial Property Office.

***By Esohe Olajide
(Senior Legal Consultant)***

If you require any assistance with respect to well-known marks or other related trademark matters in Ghana, kindly send an email to ilc@integratedlegalconsultants.com