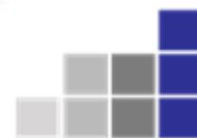


# TRADEMARK INFRINGEMENT IN GHANA



**TRADEMARK**  
**INFRINGEMENT**

**Edition 22**



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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 22<sup>nd</sup> edition. Trademarks are adopted by several businesses as a unique way to identify and distinguish their goods or services from those of others in the circle of trade.

There is however the need to ensure that the unauthorized use of trademarks (i.e. infringement) is checked and addressed by the owners. Infringing use of trademarks where unaddressed could lead to loss of revenue and hard-earned business reputation for its owners. Our trademark laws provide certain remedies for registered owners of trademarks where such marks have been infringed upon.

In this issue, we take a look at trademark infringement in Ghana, how to establish that there is infringement, and what options and remedies are open to the owners of trademarks where such infringement occurs.

We trust that you had a great and restful festive season and wish you a happy new year, 2025!

We hope you find it informative and educative.

Your feedback is welcome.

*Esohe Olajide*

**Editor**

*Olusola Ogundimu*

**Editor-In-Chief**



## TRADEMARK INFRINGEMENT IN GHANA

### Introduction

Trademarks have been adopted by businesses for centuries as unique identifiers for their goods and services. Trademarks are intangible assets which their owners strive to protect and exploit for their commercial gain. A major way to protect your trademark is by registration under the applicable laws in the jurisdictions where you live, carry on business or have a strong commercial presence.

In Ghana, trademarks registration is regulated by the Trade Marks Act, 2004 (Act 664) as amended by the Trademarks (Amendment) Act, 2014 (Act 876) and the Trade Marks Regulations 1970 (LI 667). In addition, The Protection Against Unfair Competition Act, 2000 (Act 589) also regulates the unauthorized or misleading use of trademarks whether registered or unregistered.

### Definition of Trademarks

Section 1 of Act 664 as amended defines a trademark as a *“sign or a combination of signs capable of distinguishing the goods or services of one undertaking from the goods and services of another undertaking”*. A trademark may be a name, letters, words, shapes, colours, numerals, holograms, sounds or a combination of these. The Act also allows for the registration of slogans which are not long enough to be protected as copyrights.

Thus, business owners may register their brands/ trademarks in Ghana once they meet the definition as provided in section 1 of Act 664.

Once a trademark is registered by virtue of sections 3 and 9 of Act 664, the registered proprietor of the mark has

certain rights conferred on him/her which include the right to prevent unauthorised use of the mark, or to prevent acts which may likely infringe on his/her registered rights in that mark. The proprietor is empowered to institute an action in court where there is infringement of the mark, and this extends to the use of similar marks which are used in relation to goods or services similar to those for which the mark was registered.



**Trademark  
Infringement**

### What is Trademark Infringement

Infringement of a trademark occurs when there is unauthorised use of an identical or similar trademark by a third party in respect of goods or services which are identical or similar to the goods or services for which the said trademark was registered. For instance, when Company A registers its trademark in respect of pens and Company B starts using the trademark for pencils without the consent or prior approval of Company A, then Company B has infringed on the trademark rights of Company A.

Infringement is said to have occurred where there is a slight modification in the mark such that the modification

cannot be easily noticed or identified by the average consumer in the market.

### How to Detect Trademark Infringement

In order for the owner of a trademark to address infringement, it must first be detected. We will look at a few ways in which owners can identify actual or possible infringement.

1. A key means of detecting infringement is by regularly monitoring the market for products or services that may infringe on your trademark. Making periodic visits to the markets or major stores that sell products in the class in which your mark is registered will help to easily identify potential or actual infringement from the onset.

Trademark owners should keep a watchful eye on the goods and services offered by their competitors as well as being informed about new entrants in the market offering similar goods or services.

2. Another way to detect infringement is by carrying out a watch brief service on trademark journals and publications in Ghana and any other jurisdictions where you have a registration and are using your mark. This allows trademark owners to identify attempts to register infringing trademarks and obtain the details of ongoing or potential infringers.

3. Owners of trademarks may also detect infringement by conducting periodic searches online on websites of major e-stores and online stores where products are offered for sale to customers all across the world. Some of the online stores accessible in Ghana include e-bay.com, Jiji.com.gh, kongka.com, ubuy.com.gh and amazon.com.

4. Infringement can also be detected where owners of trademarks conduct periodic use investigations to identify new products that may be confusingly similar to their brands/ trademarks which are being offered for sale to the public.



### How to Establish a Case of Infringement

To establish trademark infringement the proprietor of the mark must show the following:

1. That the Complainant/Plaintiff is the owner of the infringed trademark and has made use of it in commerce.
2. That the Complainant/Plaintiff has a registered right in the trademark in the jurisdiction where he/it seeks to protect the trademark. This could be a registration or a pending application to register the mark. as Act 664 accords protection to pending applications.
3. That the Plaintiff has prior rights in the mark(s). This means that his rights predate the defendant's/ infringer's rights.

4. That the infringer/defendant's mark is likely to cause confusion in the minds of consumers about the source or sponsorship of the goods or services it is applied to.

### Defences to Trademark Infringement

Where a party is accused of trademark infringement, the most common defenses that may be raised in trademark infringement actions include:

1. *Laches*- This is a defence in equity that has developed in trademark common law which is aimed at preventing parties from sleeping on their rights or not taking any steps to protect their rights once they are aware of infringement. A defendant in an infringement action may claim that the plaintiff has delayed bringing an action for such a long period of time that the defendant/infringer has been prejudiced.

2. *Doctrine of fair use*- This defence may be raised where the use of another party's trademark without their consent is done for purposes which may include comparative advertising, news reports, criticisms or parodies.

3. *Unclean hands*- A defendant may use the defence of unclean hands when he is able to establish that there is a logical nexus, or connection, between the trademark claim the trademark owner is making and the owner's conduct. This means that the trademark owner was involved in misconduct connected to the claim which is being asserted. This can result in the action being dismissed by the court without considering the merits.

4. *Fraud in obtaining the registration* - A defence may be raised by a Defendant in an infringement matter where the trademark owner was intentionally deceitful when

applying to the registration of a trademark. This will be regarded as fraud in obtaining a registration. A finding of fraud will likely impede the trademark owner from obtaining any reliefs in an infringement action.

Under Act 664, where a party is accused of trademark infringement or a threatened infringement, there are certain defences which may be proffered by the defendant as provided in sections 26 and 27.

The defendant can put up the defence that the act was done without intention to defraud.

Also, under Act 664, it is a good defence if that person proves (a) that being in the business of making articles or other instruments to make trademarks, the person applied marks or descriptions to goods and was not interested in the goods for profit or commission dependent on the sale of the goods. Also, it is a good defence where he establishes that reasonable precautions were taken against committing the offence charged.

Likewise, it is a good defence that at the time of the commission of the alleged offence, there was no reason, as an employee, to doubt the genuineness of the trademark, or trade description and that on demand made by or on behalf of the police officer, the offender gave the information that was required with respect to the persons from whom the goods or things were obtained.

Finally, Act 664 also provides for the defence that the alleged infringer acted innocently.



### Remedies under Act 664

Act 664 provides for certain remedies where trademark rights of a registered owner have been infringed upon.

Section 9 (8) of Act 664 states thus:

*“A person who infringes the right of a registered owner of a trade mark by knowingly using a trade mark for goods or services without the consent of the registered owner commits an offence and is liable on summary conviction to a fine not exceeding 250 penalty units or a term of imprisonment not exceeding one year or to both”*

Furthermore, Section 26(3) of Act 664 provides that *“Any person who contravenes subsection (1) and (2) commits an offence and is liable on summary conviction to a fine not exceeding 500 penalty units or to a term of imprisonment not exceeding two years or to both.”*

In addition to the above penalties, Act 664 also provides that the infringing goods may also be forfeited upon conviction.

Act 589 also provides for injunctive remedies in respect of misleading use of trademarks where the defendant is found to have been in breach of the Act.

### How to Address Trademark Infringement

A person or proprietor whose trademark has been infringed or is threatened with infringement may explore any of the following options in seeking to address such infringement in Ghana.

1. *Cease and desist Letter*- A cease and desist letter may be written to the infringer stipulating conditions and timelines to stop the infringing acts and remove the infringing goods from the market. The infringer may also be requested to execute an undertaking affirming his commitment to desist from infringing on the owner’s mark.
2. *Administrative Approach*- The trademark owner may approach the administrative body, for example the Food and Drugs Authority (FDA), where the infringing goods are found to be mis labelled or of substandard quality, the FDA will conduct investigations, a raid and subsequently seize and destroy infringing goods. The FDA may also prosecute the infringer where the act is repeated or where the infringer fails to comply with the FDA’s directives. Where the goods do not fall under the FDA’s purview the Ghana Standards Authority (GSA), or other relevant body may be approached.

3. *Investigation*- The proprietor may conduct a market investigation to determine who is producing and or importing the infringing goods into Ghana to obtain more details to aid the administrative and legal actions that may be taken to tackle infringement. The investigation report is also key evidence where the matter proceeds to court.

4. *Customs Division (CD) of the Ghana Revenue Authority (GRA)* - Where the infringing goods are being imported into Ghana, the proprietor of the infringed trademark may approach the CD with details of possible shipment, proposed arrival date and ways in which the officials of the CD can identify the infringing goods, to enable them to stop/seize the said goods before entering the channels of trade.

5. *The Ghana Police Service*- Where the infringement involves forgery or counterfeit goods, the police may also be approached by a petition with details of the counterfeit goods, location of warehouse or places they are made, or sold for a raid, arrest and prosecution of offenders.

6 *Actions in Court*- Owners of trademarks may approach the court to enforce their right in respect of infringement per sections 9, 24 and 26 of Act 664 particularly in relation to application of a trademark to goods without consent of the owner, and in relation to false application and forgery of a trademark. This is in addition to seeking monetary compensation/ damages for the said infringement.

The court may also be approached for injunctions under Act 589 for misleading use of the trademark or for passing off where the mark is unregistered.

The court action may be civil where commenced by the Trademark Proprietor or criminal, where commenced by the Police or other administrative body.

The proprietors must be willing to expend money and time to protect their trademarks and tackle infringement.

### **Conclusion**

Trademarks are valuable assets adopted by their owners to identify and distinguish their products and services from those of others in the circle of trade. Their owners invest time and efforts to create, maintain and promote these trademarks which gather a lot of goodwill over the years.

Registration of a trademark confers exclusive rights to the use of a mark and empowers its owner to challenge unauthorised or infringing use of a trademark. Thus, trademark owners must be willing to invest the time, energy and resources to tackle trademark infringement in any jurisdiction where their marks are registered and in use. Owners must ensure they monitor their marks to detect infringement early and take steps to tackle infringement once identified in line with the methods identified herein and may seek the remedies as outlines in Act 664 and 589 respectively, in order to protect their businesses and reputation.

***By Esohe Olajide  
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If you require further information or assistance with respect to trademark infringement, kindly send an email to [ilc@integratedlegalconsultants.com](mailto:ilc@integratedlegalconsultants.com)