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Reconciling Trademark Infringement and the Tort of Passing Off in Cameroon: A Legal Appraisal

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Abstract

This paper unveils the concept of trademark infringement and the tort of passing off under intellectual property rights by reviewing the Cameroonian perspective on the same. It evaluates the scope of protection accorded to holders of registered and unregistered marks and signs in Cameroon. The paper adopts a qualitative research methodology based on the doctrinal and content analysis of primary and secondary data. The study documents that owners of registered trade or service marks have been extensively sheltered under the law in force, while users or owners of unregistered marks or signs remain vulnerable in cases of illicit use by unauthorized third parties, since the range of protection is limited with no statutory shield. The researcher recommends that policies and statutory shields be established to protect the ingenuity of unregistered mark holders and the reputation of goods sold under the name and style of such marks.

Keywords: Infringement, passing off, reconciling, trademark

INTRODUCTION

Every great idea begins with the mind. These great ideas are usually a springboard for innovation, businesses, and divergence. The quagmire of every creative mind can be summed up in one question: How do I protect my inventions and innovations? This leads the researcher to the concept of intellectual property rights. Intellectual property (IP) refers to a category of intangible rights protecting commercially valuable products of the human intellect [1]. These IP products consist primarily of trademarks, copyrights, and patent rights, but equally include trade secrets, cultural heritage, utility models, protection against unfair competition, plant varieties, and geographical indications [2]. The principal legal instrument regulating the protection of intellectual property in Cameroon is the Bangui Accord of 2nd March 1977 as amended [Endnote (i)]. This regional system of intellectual property is managed by the African Intellectual Property Organization commonly known by its French acronym, OAPI [3, 4].

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Trademarks and service marks [endnote (ii)] in Cameroon are regulated principally by Annex III of the Bangui Accord, read together with the penal code of the Republic of Cameroon [5]. The purpose of a trade or service mark is to distinguish the goods of any natural or artificial person from those of another. Where a mark or sign is registered, use of the same by an unauthorized user shall amount to infringement of the trademark which is actionable [6]. This intention raises the question of what happens to unregistered trade or service marks. The assumption, which has been documented in many common law jurisdictions, is that natural and artificial persons who have a proprietary interest in an unregistered trade or service mark in cases of infringement by third parties can institute an action for the tort of passing off [7]. This paper seeks to examine the scope of protection granted to holders of registered and unregistered marks in Cameroon. To achieve this objective, the paper is divided into two parts. Part one evaluates the eligibility of signs to qualify as trade or service marks in Cameroon, likewise the circumstances that may amount to trademark or service mark infringement in Cameroon. Part two unveils the status quo that exists in Cameroon for the unauthorized use of registered and unregistered marks or signs. It also contains policy recommendations.

MODALITIES FOR SIGNS TO QUALIFY AS TRADEMARKS OR SERVICE MARKS IN CAMEROON

Not every sign or mark is eligible for trademark protection in Cameroon. The presupposition which has been adopted in many treaties regulating IPR around the world is that for a sign or a mark to qualify as a trademark, it must be distinctive and used in commerce. The position of the law in Cameroon is that visible or audible signs can be used as trade and service marks which have the purpose of distinguishing the goods and services of a natural or artificial person [8].

More specifically, the regulatory text states that the sign may constitute denominations in all forms, such as words, combinations of words, surnames in/and of themselves in a distinctive form, arbitrary or fanciful designations, letters, abbreviations, and numerals. Article 2 annex III of the Bangui Accord of 1977 as amended further documents that figurative signs such as drawings, seals, reliefs, labels, holograms, logos, and synthesized images and shapes particularly those of product or its packaging and combination of shades of colors. Further to the aforementioned, audible signs such as signs and musical phrase, series of signs and audiovisual signs constitute valid trademarks/service marks in Cameroon [9]. The aforementioned may equally serve as collective marks [10].

In line with the legal framework for the protection of trademarks in Cameroon, a mark shall not be registered as a trademark if it is not distinctive particularly in cases where such a mark is of generic designation. Trademark/service mark registration shall not equally apply to a mark which is identical to an existing mark belonging to another owner which has already been registered or filled before same. Mark/signs equally contrary to the law, public policy, and morality are further excluded from being considered as trademarks in Cameroon. In addition to the marks which are liable to mislead the public or business circle as the nature and characteristics of a good likewise its geographical origin are also excluded. Finally, the law also excludes marks which imitates, reproduces, or imitates armorial bearings likewise flags or other state emblems [11].

OVERVIEW OF TRADE OR SERVICE MARK OWNERSHIP IN CAMEROON

Registration remains a sine qua non [Endnote (iii)] for trademark ownership in Cameroon. The Bangui accord firmly prohibits exclusive ownership of a mark/sign unless it has been registered or has been already filled for registration in accordance with Article 9 of the same [12]. Upon registration, certain rights are jealously conferred on the owner by law; a violation of the same by unauthorized third parties amounts to infringement. These rights include:

- Right of ownership of the mark for the goods and services designated.
- The owner of the mark or sign has the autonomy to authorize the reproduction, affixation, and usage of the mark. This applies even in circumstances where there is going to be an addition of words, formula, method type, and system to same or identical to that which has been designated upon by registration.
- The owner further has the powers to authorize the suppression or modification of a registered mark.
- Unless authorized by the owner, the reproduction, use or affection of a mark like a registered mark is prohibited particularly in instances where they are liable to create confusion in public perception [13].

Trade/Service mark Infringement in Cameroon and Penalties for Illicit Exploitation

The word trademark infringement has been defined as the unauthorized use of a mark or use of a mark in a confusing similar name, symbol, or word or a combination of the aforesaid in relation to goods and services in a manner likely to cause confusion, deception, and mistake about the source of the goods or service [14]. The Bangui accord summarily defines trade/services mark violation as any infringement of the rights of an owner of a mark within the context of Article 6 of the Bangui Accord which consists of counterfeiting the same [15]. The penal laws of the Republic of Cameroon fail to expressly address/define what constitutes trademark infringement, but they do highlight acts likely to constitute trademark infringement [16].

With regards to the illicit exploitation of a mark, attention is directed to individuals who fraudulently reproduce marks for goods and services identical to those that have been designated. This applies even in circumstances where words, formulas, types, or methods are added to the said registered mark or sign. Persons who also knowingly involve themselves in the sale of one or more goods bearing counterfeited marks or fraudulently delete a properly affixed mark are all liable for illicit exploitation of trade/service marks. In addition to the illicit exploration of a trade/service mark equally includes the fraudulent modification of a properly affixed mark or deleting of same with the intention of creating confusion in public perception. It encompasses the fraudulent exploit of a mark for goods which are marketed by the owner of the mark whose state has subsequently been altered, likewise the intentional sale or offer of sale of more than one good bearing a fraudulently imitated mark, or one bearing indications which are likely to mislead the buyer as to the nature of the good. Persons involved in the here-mentioned acts are sanctioned with an imprisonment term of three months to two years and or with a fine of five hundred thousand to thirty million francs (500.000XFA–30.000.000XFA) [17].

To equally protect trade/service mark owners in Cameroon, the law goes forward to state that when an accused has been convicted for counterfeiting/trade mark violation, at the request of the injured party, the court may order that the said goods found to have been counterfeited, likewise materials and instruments which were used for their creation or manufacturing of same be withdrawn from commercial channels and destroyed or confiscated. The court *suo moto* may equally order any appropriate measure to offer widest publicity of the said verdict at the cost of the counterfeiter [18]. Judicial precedence turns to suggest that registration of a trademark provides a statutory shield for trademark holder in Cameroon. This is particularly justified by virtue of the position of some Cameroonian state courts in the adjudication of trademark infringement related issues.

The High Court of Wouri Division (Douala-Cameroon) sitting at first instance in the case of *Colgate Palmolive Company v Mbouhou Yap Ibrahim & 2 others* [19] applied the law in force to find the defendants liable for trademark violation of the registered mark “Double action”. The claimant was awarded damages to the tune of twenty-three million, one hundred and thirty-nine thousand eight hundred francs (23.139.800XAF). The court further ordered the seizure and destruction of counterfeited products too with fifty boxes of toothbrushes, each containing 100 dozen [20].

The plaintiff, Colgate Palmolive Company, a company incorporated under the laws of the United States of America, with registered head office at 300, Park Avenue, New York, NY10022-7499 operating in Cameroon with head office at Boulevard Ahamadou Ahijo, Akwa, BP2799, Douala ignited legal actions against the defendant’s Mbouhou Yap Ibrahim, Dagha Samuel, Dame Pean Esther (All commercial traders resident in Douala), for infringement of the trademark “Double Action’, a registered trademark of the plaintiff illicitly exploited by the defendant in the ordinary course of business on her products (toothbrush).

The trial court, after full hearing, ruled in favor of the plaintiff, by concluding that from a sample visual comparison between the counterfeited sample and the original sample, the defendants had infringed on the registered trademark of the plaintiff (Double Action).

Contemporary View of the Tort of Passing off in Cameroon

Unlike in some jurisdictions where trademark rights are granted to owners of registered and unregistered marks, the Bangui accord and Penal laws of Cameroon adopt a restrictive approach [21, 22]. Unless a mark is registered, it cannot be protected as a trade/service mark. This raises the question of the degree of protection accorded to persons who use unregistered trade/service marks in Cameroon during business, in cases of counterfeiting. Under common law, judicial precedence [23] documents that persons who use unregistered trade/service marks in case of infringement have the legal remedy of passing off against the tortfeasor. The contemporary view is that passing off is a judge-made law which attempts to ensure a degree of fairness and honesty in the way trade is conducted. This was the position of the law established by Mr. Justice Laddus [24].

Passing off as a tort intends to protect the reputation/goodwill of a trader from misrepresentation, by preventing another trader from deliberately or unintentionally offering his goods or services in a manner which turns to suggest/deceive the customers to believe that they are buying the goods or service of another party [25]. *Simplicita*, passing off arises when a defendant wrongly represents his goods or services as being that of the claimant or has some connection and association with that of the claimant which is untrue, with the intention misleading customers. This act of misrepresentation often damages the reputation of the claimant's business and leads to financial damage. The basic test required for the fulfillment of this tort is if the defendant's conduct is one which turns to mislead the public to believe that the defendant's business is that of the plaintiff or likely to cause confusion between the businesses of both the plaintiff and the defendant [26].

Traditionally, under common law, to sustain liability for the tort of passing off, the claimant had the burden of proving to establish three criteria commonly referred to as the "classic trinity". These three elements were established by the House of Lord in the Jif Lemon case [27], amongst which include:

(a) That the claimant's goods or services have acquired reputation or good will in the marketplace/ordinary course of business, which turns to distinguish same from the goods and services from other competitors.
(b) That the defendant misstates, misrepresents, and gives a false account of his goods and services such that the public turns to believe that the goods/services offered is that of the claimant. This issue of misrepresentation can be done intentionally or unintentionally.
(c) That the claimant may subsequently suffer damages because of the misrepresentation of the defendant.

It is important to state that the elements to secure liability for the tort of passing off have evolved over time and have been modified by judicial precedence. Lord Diplock in landmark case of *Erven Warnick v Townend & Sons (Hull) ltd* [28] enumerated on some key components of the tort of passing off which nowadays is referred to as the modern elements of the tort of passing off. They include:

i. Misrepresentation of goods and services by the defendant.
ii. Such a misrepresentation must be made by the defendant in the ordinary course of business.
iii. The said misrepresentation must be made to prospective customers of the defendant or end users of the goods/services in question.
iv. The misrepresentation of the defendant is calculated to injure the goodwill/reputation of the claimant.
v. The said misrepresentation causes damage to the reputation/goodwill of the claimant.

CONCLUSION

Existing Cameroonian legal and institutional framework turns to suggest that Cameroon, like many other OAPI countries has no legislation, specifically on counterfeiting of unregistered mark. The owner/users of such marks irrespective of the absence of a statutory shield can institute civil actions for the tort of passing off, particularly where such a mark meets the criteria. Unfortunately, this remedy remains less than a perfect protection mechanism since the burden of proves lies on the claimant who may not sufficiently discharge same. This is particularly justified by the virtue of the fact that the tort can be committed in many forms, amongst which includes extended passing off [Endnote (iv)], reverse passing off [Endnote (v)] . On the contrary, trademark holders in Cameroon have a statutory shield to secure and sustain monopoly of right owners.

Recommendation

Based on this, it is evident that there is a need to reconcile trademark infringement and the tort of passing off in Cameroon, since the tort of passing off in Cameroon is manifestly reliant on probability. The researcher recommends that the complexity involved in successfully sustaining a claim for passing off can only be addressed if a statutory shield is accorded to owners of unregistered marks. The researcher opines the same by virtue of the decision of the Court of Appeal Southwest Region in the case of *Simo Pierrre & Anor v The People and Anor* [29]. The decision of the trial court was heavily criticized on appeal as one which was unsound and unreasonable for relying on trademark violation of the mark MATTABBL with no exhibits in evidence to show that it was a duly registered mark, likewise the production of physical goods carrying the genuine mark. Passing off thus remains sue generis to each case in Cameroon, to which a statutory shield is accorded.

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ENDNOTE

(i) This law is essentially an agreement between sixteen West and Central African Countries to create a regional IP system. Amongst these Countries include Benin, Burkina Faso, Cameroon, Congo. Central African Republic, Equatorial Guinea, Gabon, Guinea Conakry, Guinea Bissau, Mauritania, Mali, Senegal, Niger, Tchad and Togo.

(ii) Article 2 annex iii of the Bangui Accord 1977 as amended defines a trademark/service mark as any visible sign, which has been used or it’s intended to be used and its capable of distinguishing goods or services of any Natural or Artificial Person.

(iii) An essential condition

(iv) Passing off which applies to the misrepresentation of a particular quality of a product.

(v) Passing off which occurs when a Party kills or eliminates the Original Trademark on a Product and sells the said product without permission or his/her brand.

