

WIPO Collection of Leading Judgments on Intellectual Property Rights

Members of the African
Intellectual Property
Organization (1997-2018)

Collection OMPI des jugements les plus déterminants en matière de propriété intellectuelle

Membres de l'Organisation
africaine de la propriété
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Edited by
Max Lambert Ndéma Elongué and Joseph Fometeu

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Sous la direction de
Max Lambert Ndéma Elongué et Joseph Fometeu



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Foreword

It is with great pleasure that the World Intellectual Property Organization (WIPO) presents this second volume of the *WIPO Collection of Leading Judgments in Intellectual Property*, dedicated to the intellectual property (IP) jurisprudence of the member states of the African Intellectual Property Organization (OAPI). The Collection was launched in 2019, as part of WIPO's commitment to providing free public access to data and knowledge on IP adjudication approaches and trends to the global IP community. Each volume in the Collection opens global access to the landmark IP judgments of a selected jurisdiction or region. The first volume contained 30 representative judgments curated by the Supreme People's Court of the People's Republic of China, between 2011 and 2018. This second volume showcases 53 of the most significant decisions rendered by OAPI member state courts between 1997 and 2018, through commentaries authored by distinguished judges and academics.

The members of the OAPI have a common IP legislative framework, governed by the Bangui Agreement. In this framework, the OAPI provides for a regional system for IP protection with a single filing mechanism by which OAPI registrations automatically extend to all OAPI member states. Additionally, IP disputes are adjudicated by the national courts of the relevant member state and the court decisions related to the provisions of the Bangui Agreement are binding on all other OAPI member states. In this context, judges in the region can benefit immensely from having access to the judgments rendered by courts across the region to inform their own analysis and decision-making. So far, there has been limited available information regarding IP jurisprudence in the region, and this volume intends to fill this gap. By providing free access to landmark judgments, as well as judicial analysis authored by judges and academics in the field, it is our hope that this publication will serve as a useful judicial education resource, and will contribute to the consistency and predictability of decisions rendered by courts in the OAPI member states. In addition, by providing the commentaries in French and in English, judges beyond the OAPI and francophone region will be able to benefit from this jurisprudence.

The Collection is one part of WIPO's broader efforts to increase free access to information on the judicial administration of IP. In this context, the Collection is complemented by WIPO Lex, an online database that provides free of charge access to legal information on IP from around the world, including laws, treaties and judgments. All of the decisions commented in

this volume are included in full text in WIPO Lex, and can be accessed at <https://wipolex.wipo.int/en/main/judgments>.

This volume is the result of the collaborative efforts of WIPO, the OAPI, the National Institute of Intellectual Property in France (INPI) and a number of distinguished judges and academics from Benin, Cameroon, France and Senegal. We are grateful to the individual authors of this volume, Judge Max Lambert Ndéma Elongué, Judge Malick Lamotte, Judge Aristide Fade, Dr. Joseph Fometeu, Dr. Grégoire Jiogue and Dr. André Lucas. The commentaries in this volume reflect the views of the authors in their personal capacity, and do not represent the views of any court, member state, OAPI or WIPO.

The Collection seeks to encourage conversation and exchange with a view to enhancing judicial analysis, reasoning and decision-making. We trust that the insightful judicial analysis provided in these pages will assist judges in their role of achieving an effective and balanced IP ecosystem, in the OAPI region and elsewhere.

Marco M. Alemán

Assistant Director General
IP and Innovation Ecosystems Sector
WIPO

Preface

Efforts to enforce intellectual property (IP) rights are gaining traction in the area covered by the African Intellectual Property Organization (OAPI). Slowly but surely, the judicial authorities are making their mark as they interpret the notions enshrined in the Bangui Agreement and its annexes. They have already shed light on a number of issues, in particular with regard to IP law jurisdiction and how that fits in with the legal framework of the Organization for the Harmonization of African Business Law (OHADA in its French acronym), definitions of such concepts as the likelihood of confusion, intellectual work, originality and novelty, and matters relating to trade names, counterfeiting and seizure, and unfair competition.

It is important that the public be made aware of these developments. To that end, OAPI, the National Industrial Property Institute (INPI) of France and the World Intellectual Property Organization (WIPO), working through that Organization's Division for Africa and the WIPO Judicial Institute, decided to publish a compendium of annotated case law. There are at least two key reasons for compiling such a selection of landmark court rulings. Firstly, it resolves the formality of publication itself, given that, with few exceptions, judgments handed down in the various OAPI countries are not usually published. More importantly, by this approach we bring to the attention of the public only what are deemed to be key judgments. To compile such a compendium has meant entrusting a team of experts with the task of making a rigorous selection of judgments and annotating them.

A team of senior judges under the direction of Max Lambert Ndéma Elongué and a team of academics led by Professor Joseph Fometeu undertook that work. The two teams worked seamlessly together to achieve the result that I am pleased to present to you, the reader.

It is a unique piece of work, the first compendium of landmark judgments ever published in the OAPI region.

Its target audiences are clear: the compendium is primarily directed at actors operating in the market place. The message that I hope is transmitted to them by this initiative is that IP rights are well protected in the OAPI region, thereby making it attractive economically from a rights standpoint. The judgments contained in the compendium are indicative of the rigorous, objective and impartial analysis of the law made, as a rule, by the judges. The compendium is also directed at those responsible for implementing IP rights, in particular judges in OAPI countries and those serving

on the OAPI High Commission of Appeal, and at OAPI staff too. Finally, it will be of use to lawyers and anyone, academics or otherwise, conducting any kind of IP-related research in the OAPI area.

To the co-authors, I express the hope that, as the Act of 2015 continues to be applied, it will be possible to publish a second edition of this compendium as soon as the number of judgments handed down allows.

Denis L. Bohoussou
Director General
OAPI

Acknowledgments

Commentators

Max Lambert Ndéma Elongué, Magistrate, Deputy Director for Audit and Administrative and Financial Disputes (Direction des Affaires non répressives et du Sceau), Ministry of Justice (Cameroon)

Malick Lamotte, Magistrate, President of the Commercial Court of Dakar (Senegal)

Aristide Fade, Magistrate, Public Prosecutor, Court of First Instance (Second Class) of Aplahoué (Tribunal de première instance de 2ème classe d'Aplahoué) (Benin)

Joseph Fometeu, Professor, University of Ngaoundéré (Cameroon)

Grégoire Jioque, Professor, University of Yaoundé II (Cameroon)

André Lucas, Professor emeritus, University of Nantes (France)

Science Committee

Joseph Fometeu, Professor, University of Ngaoundéré (Cameroon)

Grégoire Jioque, Professor, University of Yaoundé II (Cameroon)

André Lucas, Professor emeritus, University of Nantes (France)

Technical Secretariat

Brillant Aimé Yobo, Attorney at law, Cameroon

Joël Fabrice Dongmo Donfack, Doctor of private law

Awal Mohamadou, Doctoral student of private law

WIPO Coordinators

Inés Fernández Ulate, Legal Officer, WIPO Judicial Institute, IP and Innovation Ecosystems Sector

Eun-Joo Min, Director, WIPO Judicial Institute, IP and Innovation Ecosystems Sector

Marc Sery-Kore, Director, Division for Africa, Regional and National Development Sector

WIPO Technical Experts

Ignacio de Castro Llamas, Director, IP Disputes and External Relations Division, WIPO Arbitration and Mediation Center, IP and Innovation Ecosystems Sector

Marina Foschi, Senior Legal Officer, Policy and Legislative Advice Section, Department for Trademarks, Industrial Designs and Geographical Indications, Brands and Designs Sector

Marcus Höpperger, Senior Director, Department for Trademarks, Industrial Designs and Geographical Indications, Brands and Designs Sector

Tomoko Miyamoto, Head, Patents and Treaties Law Section, Patent and Technology Law Division, Patents and Technology Sector

Xavier Vermandele, Senior Legal Counsellor, Building Respect for IP Division, Global Challenges and Partnerships Sector

Michele Woods, Director, Copyright Law Division, Copyright and Creative Industries Sector

Abbreviations

AB-1977	Agreement Relating to the Creation of an African Intellectual Property Organization, constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (Bangui Agreement of March 2, 1977)	Cass. soc.	Chambre sociale de la cour de cassation [Social Chamber of the Court of Cassation] (France)
ABR-1999	Bangui Agreement, as revised on February 24, 1999	CCJA	Common Court of Justice and Arbitration (OHADA)
ABR-2015	Bangui Agreement, as revised on December 14, 2015	CFAF	Communauté financière africaine franc
ADR	Alternative dispute resolution	CJEU	Court of Justice of the European Union
AERIA	Board of the Abidjan International Airport	CMO	collective management organization
Ann. propr. ind. art./arts.	<i>Annales de propriété industrielle</i> article/articles	COCC	Code des obligations civiles et commerciales [Code of Civil and Commercial Obligations] (Senegal)
BBDA	Bureau burkinabè du droit d'auteur [Copyright Bureau of Burkina Faso]	Comm.	Communication
BNDA	Bureau national de droit d'auteur [National Copyright Bureau] (Niger)	CPI	Code de la propriété intellectuelle [Intellectual Property Code] (France)
BOPI	<i>Bulletins officiels de la propriété industrielle</i>	D.	Dalloz
BRDA	<i>Bulletin rapide droit des affaires</i>	EU	European Union
BSDA	Bureau sénégalais du droit d'auteur [Senegalese Copyright Bureau]	EU IPO	European Union Intellectual Property Office
BUBEDRA	Bureau béninois du droit d'auteur [Copyright Bureau of Benin]	Fasc.	Fascicule
Bull. civ.	<i>Bulletin civil de la cour de cassation</i>	Gaz. Pal.	<i>Gazette du palais</i>
BURIDA	Bureau ivoirien du droit d'auteur [Copyright Bureau of Côte d'Ivoire]	ICANN	Internet Corporation for Assigned Names and Numbers
CA	Cour d'appel [Court of Appeal] (France)	IIC	The International Review of Intellectual Property and Competition Law
Cah. dr. auteur	<i>Cahiers de droit d'auteurs</i>	INPI	Institut national de la propriété industrielle [National Institute of Intellectual Property] (France)
Cass. 1^{ère} civ.	Première chambre civile de la cour de cassation [First Civil Chamber of the Court of Cassation] (France)	JCP E	<i>Juris-Classeur périodique</i> , édition entreprise
Cass. 2^{ème} civ.	Deuxième chambre civile de la cour de cassation [Second Civil Chamber of the Court of Cassation] (France)	JCP G	<i>Juris-Classeur périodique</i> , édition générale
Cass. 3^{ème} civ.	Troisième chambre civile de la cour de cassation [Third Civil Chamber of the Court of Cassation] (France)	JORF	<i>Journal officiel de la République française</i>
Cass. ass. plén.	Assemblée plénière de la cour de cassation [Plenary Assembly of the Court of Cassation] (France)	Juriscl.	<i>Jurisclasseur</i>
Cass. com.	Chambre commerciale de la cour de cassation [Commercial Chamber of the Court of Cassation] (France)	LGDJ	Librairie générale de droit et de jurisprudence
Cass. req.	Chambre des requêtes de la cour de cassation [Requests Chamber of the Court of Cassation] (France)	LPA	<i>Les petites affiches</i>
		OAMPI	Office africain et malgache de propriété industrielle [African and Malagasy Office of Industrial Property]
		OAPI	Organisation africaine de la propriété intellectuelle [African Intellectual Property Organization]
		obs.	Observation
		OHADA	Organisation pour l'harmonisation en Afrique du droit des affaires [Organization for the Harmonization of Business Law in Africa]

OHIM	Office for Harmonization in the Internal Market (Trade Marks and Designs) (EU)	TPI	Tribunal de première instance [Court of First Instance]
PIBD	<i>Propriété industrielle – Bulletin Documentaire</i>	TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
Propr. intell.	Propriété intellectuelle [Intellectual Property]		
PTPI	Président du tribunal de première instance [President of the Court of First Instance]		
PUF	Presses universitaires de France		
RAPAC	Rassemblement des artistes professionnels et amateurs [Society of Professional and Amateur Artists] (Cameroon)		
RAPI	<i>Revue africaine de la propriété intellectuelle</i>		
Rev. dr. unif.	<i>Revue de droit uniforme</i>		
RFPI	<i>Revue francophone de la propriété intellectuelle</i>		
RIDA	<i>Revue internationale de droit d'auteur</i>		
RID comp.	<i>Revue internationale de droit comparé</i>		
RIPIA	<i>Revue internationale de la propriété industrielle et artistique</i>		
RLDA	<i>Revue Lamy droit des affaires</i>		
RTD civ.	<i>Revue trimestrielle de droit civile</i>		
RTD com.	<i>Revue trimestrielle de droit commercial</i>		
SACEM	Société des auteurs, compositeurs et éditeurs de musique [Society of Authors, Composers and Publishers of Music] (France)		
SDRM	Société pour l'administration du droit de reproduction mécanique des auteurs, compositeurs, éditeurs, réalisateurs et doubleurs sous-titres [Society for the Administration of Mechanical Reproduction Rights] (France)		
SOCINADA	Société civile nationale des droits d'auteur [National Civil Society for Copyright] (Cameroon)		
SONITEL	Société nigérienne de télécommunication [Telecommunications Company of Niger]		
T. civ.	Tribunal civile [Civil Court]		
T. com.	Tribunal commercial [Commercial Court]		
TGI	Tribunal de grande instance [High Court]		

Introduction to the OAPI

The African Intellectual Property Organization (OAPI) is an intergovernmental international organization in the field of intellectual property (IP). OAPI was established on September 13, 1962, under the terms of the Libreville Agreement, subsequently revised as the Bangui Agreement. Its headquarters are in Yaoundé, Cameroon, and its 17 member states are: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

As part of its mission, the Organization:

- issues industrial property titles relating to patents, utility models, trademarks for products and services, industrial designs, trade names, geographical indications and plant varieties;
- ensures the publication of industrial property titles;
- promotes creativity and technology transfer;
- encourages the exploitation of inventions and innovations;
- provides IP training;
- conducts activities to promote the protection of literary and artistic works, and traditional cultural expressions and knowledge.

The Bangui Agreement is the uniform law applicable in all OAPI member states. It is the national IP law of each member state. The Bangui Agreement established a common IP office for the member states: the OAPI office. Its procedures are centralized: an application submitted to the OAPI is filed, either directly at its headquarters, or through the ministry responsible for industrial property matters in each member state. Such applications are deemed to have been filed nationally in all member states and a single title is issued for each application.

The titles issued by OAPI are valid in all member states. There are no national mechanisms to issue IP titles that coexist with the regional system of the OAPI. The OAPI system is consistent with the provisions of the main international IP conventions. The collective management of copyright in the member states is managed by the collective management organizations. IP disputes are dealt by the courts of each of the member states.

Maurice Batanga
Director of Legal Affairs
OAPI

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Chapter 1

General theory of intellectual property

A. Relationship between the African Intellectual Property Organization (OAPI) and the domestic courts of its member states – No obligation to refer cases to the OAPI High Commission of Appeal before accessing domestic courts – Jurisdiction of administrative and judicial bodies – Precedence of judicial decisions

The jurisdiction of the African Intellectual Property Organization (OAPI) administrative dispute resolution bodies has no effect on that of domestic courts in the member states, which have concurrent jurisdiction. Consequently, recourse to such courts is not subject to the exhaustion of OAPI internal remedies nor can decisions by the OAPI bodies be referred to domestic courts, the decisions of which have primacy under the 1977 Agreement Relating to the Creation of an African Intellectual Property Organization, constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (Bangui Agreement, or AB-1977), as revised in 1999 (ABR-1999) and 2015 (ABR-2015).

ARLA FOODS AMBA V. DANA HOLDINGS LTD, Com judgment No. 7 of January 5, 2012, High Court of Wouri (Douala)

Observations:

A hot potato? That is what comes to mind in exploring the many interesting legal controversies raised in this litigation between Arla Foods AMBA and Dana Holdings Ltd, and mostly sidestepped by the judge.

Facts: The facts are unremarkable for a trademark dispute. The company Arla Foods had owned the word mark “Dano,” registered in OAPI countries under No. 36147, since March 24, 1996, for goods in classes 5, 29 and 30. On November 30, 2004, the company Dana Holdings registered two related signs: the word mark “Dana,” No. 50961, for goods in classes 5, 16, 29 and 30; and the figurative mark “Dana & Device,” No. 50962, for goods in classes 5, 16, 29 and 30. Arla Foods then filed its opposition to registration of the two marks in proceedings before OAPI, which issued two decisions. The first, No. 00090/DG/SCAJ of June 30, 2007, ordered cancellation of the “Dana” mark, while the second, No. 00091/DG/SCAJ of the same day, dismissed Arla’s opposition to the “Dana & Device” mark. The simplicity of these facts conceals, however, what later emerged before the High Court of Wouri in Douala (Cameroon), where Arla Foods, dissatisfied with the second mark being upheld, brought action to invalidate it.

Reasoning: Proceedings before that court sparked some important debate on theoretical matters that the judge rather glosses over, sticking only to the essentials in a case comprising no fewer than 24 dockets and using language likely to mislead readers unfamiliar with OAPI law.¹

Among the specific grounds for the decision, the only question the judge expressly raised – without explanation – was of which body is competent to invalidate an OAPI registration. From that perspective, in affirming its own competence and by extension that of national courts generally, the High Court rules on one of the possible causes for judicial invalidation – namely, in this case, the infringement of a prior right and consequent likelihood of confusion. The question would be of little interest were it not part of a case that is otherwise highly instructive, focused largely on the respective roles of national courts and OAPI dispute resolution bodies, the latter being administrative in character.

That question gives rise to several secondary, yet equally noteworthy, questions, including:

- I. the body competent for opposition, cancellation and invalidity;
- II. the point in time when the Director General’s decisions take effect; and
- III. the procedures for appealing the decisions of OAPI dispute resolution bodies.

I. Jurisdiction over opposition, cancellation and invalidity

A key point of debate in this case concerns jurisdiction to hear disputes on invalidity and cancellation: does it fall to courts in the member states, or does it lie solely with bodies within the OAPI? The question stems from the two OAPI decisions – one ordering cancellation of one mark; the other dismissing opposition to another – and one party’s effort to circumvent the dismissal by seeking judicial cancellation of a mark implicitly validated when

¹ For example, the judge spoke of the Director General of the OAPI as “the President” of that institution and the Director General’s decisions as the “OAPI judgment.”

the OAPI dismissed opposition to it.² Although the facts are familiar and the solutions fairly predictable, the legal situation in this case is rather particular, in several ways.

First, neither party had appealed the OAPI Director General's decisions to the Organization's High Commission, seemingly indicating their acquiescence. The defendant (Dana Holdings) argued before the High Court that the plaintiff (Arla Foods) should have appealed to the OAPI High Commission before resorting to a domestic court. The plaintiff, in its arguments before the court, invoked the OAPI Director General's own findings.

It is important to affirm here that appeal to the OAPI High Commission cannot be considered a precondition to domestic court proceedings, given the autonomy of administrative and judicial frameworks for industrial property disputes. Indeed, in a case brought after this one, the same court had the opportunity to affirm (albeit implicitly there too) concurrent jurisdiction for OAPI bodies and domestic courts.³ In that other case, one of the parties to that dispute, raising an objection of inadmissibility, argued that opposition to registration of a mark was time-barred. The court clearly affirmed that since different legal regimes applied to the two actions concerned, the time limit for opposition under one regime could not apply to recourse under the other. The reasoning in that case clearly affirms that an OAPI internal procedure cannot have effect on proceedings in any court.

A second characteristic of the present case, reflecting a natural inclination, is that court litigation usually follows administrative proceedings. In cases of infringement or unfair competition, a decision by the director general or high commission of an administrative institution – based, for instance, on infringement of a prior right and likelihood of confusion – may easily be invoked in a litigant's favor. Such a scenario did in fact play out for a claim adjudicated by the Lomé Court of Appeal.⁴ The respondent in that interesting case counterclaimed ownership of a mark registered after its own by the appellant, who had claimed in its application an earlier registration of the mark by an overseas co-contractor. The appellant successfully invoked a decision in which the OAPI Director General had canceled the respondent's registration, to seek dismissal of the respondent's ownership claim and to defend against the infringement case.

In another trademark case before the High Court of Wouri in Douala, in 2007, the judge's decision left it

much clearer what effect OAPI decisions have on judicial litigation.⁵ On a parallel track before the OAPI Director General, the plaintiff in that case, alleging infringement and unfair competition, had opposed registration of the disputed mark. After the Director General dismissed that opposition, the judge likewise dismissed the plaintiff's suit, reasoning that the Director General had recognized none of the rights claimed. The obvious question is thus whether a failure of opposition proceedings before the OAPI should justify the courts' automatic rejection of a parallel action for infringement and unfair competition brought against the author of the disputed registration.⁶

While courts may look kindly on OAPI decisions, these two avenues of recourse must clearly retain their independence, with recourse to the OAPI complying with article 18 of annex III to ABR-1999, and litigation in the courts complying with article 24 of the same annex. While the law gives primacy to judicial decisions pursuant to article 18 of that agreement's General Provisions,⁷ however, the courts can draw inspiration from OAPI administrative decisions without considering them sufficiently probative of the facts disputed before them.

II. Effective date of the OAPI Director General's cancellation decisions

The question raised on this point in the present case is of particular interest. Dana Holdings argued that "no decision declaring the registration of the mark 'Dana' invalid has ever been notified to the African Intellectual Property Organization." This reasoning begs the question of precisely *when* the Director General's cancellation decisions take effect: immediately, or only after submission to and validation by a domestic court? The question is all the more interesting in that Dana Holdings premised its argument on a court declaring the mark's registration invalid. The question could also arise if the OAPI were to cancel other kinds of protection under ABR-2015 before case law in this area can be consolidated. One judge has already affirmed that "[a]rticle 18 of ABR-1999, which gives primacy to the authority and independence of judicial decisions [...] subjects the OAPI governing bodies to censure by the civil courts relating to their acts and decisions on the implementation of instruments for the protection of industrial property."⁸ Interpreted strictly, that the decisions of the OAPI Director General and High Commission of Appeal are subject to "censure" by the courts means they can be challenged before them.

2 The question does not arise in such terms in the latest revision of the Bangui Agreement (ABR-2015). Indeed, any such opposition must be filed after the application has been published to prevent registration and possibly issuance of the title. An administrative cancellation following an OAPI internal procedure is therefore unnecessary. The OAPI takes action only after a member state's domestic court has issued a decision. Only a plant variety denomination may be subject to forfeiture after registration. See art. 30 of annex X to ABR-2015.

3 See *Société Marine Magistrale SA v. Mr. Kamga Nenkam, Jean Paul*, Civil judgment No. 382 of December 23, 2013, High Court of Wouri (Douala) (obs. A. Fade, this collection, Chapter 3, section N).

4 See *Nazaire Gnanhoue v. Sola Co.*, Judgment No. 70/15 of March 4, 2015, Court of Appeal of Lomé (obs. M. Lamotte, this collection, Chapter 3, section I).

5 See *Société R.M. & Co. Ltd v. Société C.D.M. (SCDM)*, Judgment No. 218 of September 19, 2007, High Court of Wouri (Douala) (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section E).

6 Likewise, an appellate court considered that, in trademark matters, the OAPI is "the institutional body for trademark supervision and registration" and that its assessment of the likelihood of confusion could serve as a basis on which to reject the claims of an appellant who considered such a likelihood to exist: *Independent Tobacco FZCO v. Rothmans of Pall Mall Ltd*, Judgment No. 536/Civ of November 6, 2013, Court of Appeal of the Center Region (Yaoundé) (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section Q).

7 Cf. ABR-2015, art. 20.

8 See *SIVOP SA v. Angel Cosmetics SA*, Civil judgment No. 187 of March 21, 2013, Court of First Instance of Yopougon (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section L).

To address these points, the concepts of cancellation and invalidity must first be distinguished; they could otherwise result in the erasure of an industrial property right that the registration applicant has sought to establish.

- The aim of *cancellation* is to erase the protection registration provides for a mark, neutralizing its legal effects.
- *Invalidity* is conventionally defined as a sanction against irregularly established legal acts, making them void.

Another concept frequently applied to industrial property matters is *forfeiture*, signifying “the loss of a right, either as a penalty or due to a failure to comply with the conditions for exercising that right.”⁹

It would certainly appear that, in OAPI member states, domestic courts have sole competence to declare invalidity. After all, it is generally up to judges to find substantive or formal flaws that may have tainted a procedure conferring an industrial property title. This could include cases where:

- the title does not apply to the object concerned (a patent can protect only an invention, a plant variety certificate can protect only a plant variety, etc.);
- the description submitted does not match the object covered;
- there is no connection between the object protected and subsequent certificates;¹⁰ and
- the object has been excluded from intellectual property protection.¹¹

These are all circumstances, as mentioned in the Agreement, under which a court could declare invalidity.¹² Marks may be invalidated under article 24(2) if they do not comply with the requirements of articles 2 and 3 of annex III to ABR-1999 (and the same articles of ABR-2015) – that is, if they are not distinctive, infringe a prior right, are deceptive, or imitate or exploit official signs. It was precisely because the marks “Dano” and “Dana & Device” might infringe a prior right that this dispute arose. A complicating factor, however, is overlap in ABR-1999 between the grounds for invalidity and the grounds for cancellation.¹³ The same grounds under article 24 for

judicial review of invalidity (i.e., in a domestic court) can also be grounds for administrative cancellation, starting with a decision by the OAPI Director General and may be followed by appeal to the High Commission.

The dispute is complicated further by the apparent existence of two types of cancellation, one administrative and the other judicial. As illustrated by this case, however, the two are easily differentiated.

- *Administrative cancellation* is declared by the OAPI Director General and may be confirmed by the High Commission of Appeal. This occurs after an opposition has been filed against the registration of a title – a trademark, in this case. The procedure for opposition – established in article 18 of annex III to ABR-1999 – is an adversarial administrative procedure. Once the decision has been handed down, the interested party has three months from receipt of notice to appeal it before the High Commission.
- *Judicial cancellation* is regulated under ABR-1999 by article 14 of annex VI in matters of geographical indications and by article 23 of annex III in trademark matters. The latter article provides for cancellation of a mark only if has not been used for an uninterrupted period of five years prior to the request.

It follows that the two forms of cancellation, administrative and judicial, are regulated differently.

Nevertheless, debate in the present case seems to have been colored by the possibility of using the same grounds to obtain either cancellation or invalidity. Dana Holdings argued that, “No decision declaring the registration of the mark ‘Dana’ invalid has ever been notified to the Organization, as required by article 24.” That argument is surprising, since it was the Organization’s Director General who declared it invalid. Was this an attempt to persuade the judge that the Director General’s decision – which was not appealed – should take effect only after issuance of a judicial decision on an action to invalidate the mark? The answer would seem to be in the affirmative. By that logic, cancellations ordered by the OAPI Director General would require validation by a domestic court and notification thereof back to OAPI.

The problem needs to be viewed differently. The OAPI is an autonomous legal entity under international law. Its decisions are not subject to review by courts in its member states, and they are thus immediately applicable and final. A title’s validity may still be challenged, but separately, through the courts.

III. Appeals against OAPI cancellation decisions

Another question raised by the judge’s reasoning concerns jurisdiction to hear appeals against OAPI cancellation decisions. Considerable debate centered in this case on recourse against decisions by the OAPI Director General, although the judge – much to this observer’s disappointment – did not address the issue.

9 See S. Guinchard and T. Debard (eds.) (2017) *Lexique des termes juridiques*, 25th edn. Paris: Dalloz.

10 This particular cause of invalidity is established in ABR-1999, art. 39(2) of annex I and art. 34(2) of annex II. It means that if a certificate has been issued to take account of changes, improvements or additions to a patent or utility model, such amendments must actually relate to that invention or utility model. In the absence of such a relationship, the subsequent title may be declared invalid.

11 For example, in ABR-1999, art. 6 of annex I, art. 2(4) of annex IV and art. 1(2) of annex IV. In ABR-2015, art. 2, the list of express exclusions in respect of patents was shortened, thanks to the revision of art. 1, defining the concept of an invention.

12 More specifically, failure to comply with a prescribed requirement on pain of invalidity and the finding of an invalid provision. See, e.g., ABR-2015, art. 11(4), art. 36(2) of annex I and art. 6(4) of annex IV.

13 This overlap was corrected in ABR-2015. Cancellation by court order no longer exists as a separate penalty as it did under ABR-1999, art. 23. Deregistration should now be a simple operation after the declaration of forfeiture, e.g. on account of the mark not being used for five years.

As already noted, decisions on cancellation and forfeiture are declared by the Director General. Parties can appeal those decisions, subject to provisions in the various annexes of the Bangui Agreement, to the High Commission of Appeal. That much is clear. The situation is less clear, however, if a party requesting cancellation of a title but denied it by the Director General attempts to circumvent that rejection by obtaining invalidation of the title from a domestic court. It is also unclear whether recourse to a domestic court is subject to prior recourse before the Commission.

These questions, as put to the court in this case, represent an astute reading of OAPI law. The Director General ordered cancellation of the mark "Dana" and rejected Arla Foods' opposition to the mark "Dana & Device," effectively validating that mark. Both decisions could have been brought before the High Commission, but neither party appealed them. Before the court, one party claimed that the absence of such an appeal amounted to acquiescence and considered it a bar to the proceedings.

Neither the Agreement nor its annexes make recourse before the High Commission of Appeal a precondition to recourse to the domestic courts. That silence is understandable: the Organization's decisions are autonomous and binding. The court did not address the matter in this case, but it did affirm its jurisdiction, the absence of such appeal notwithstanding. This implies confirmation that no such prior appeal is necessary.

In taking its case to a domestic court in an effort to bypass rejection of its opposition, Arla Foods was clearly seeking a second chance to invalidate a now implicitly validated trademark. Furthermore, in its arguments before the court, the company availed itself of findings set out in the Director General's decision. Indeed, according to one of its arguments, "it has been firmly established by unappealable decision that there is a phonetic resemblance between the plaintiff's 'Dano' and the defendant's 'Dana,'" and the mark "Dana & Device" was therefore to be declared invalid. The argument is opportunistic but also legally compelling, since no text prohibits the opposing party from seeking invalidation by a court of a trademark implicitly consolidated when opposition to its registration has been rejected – or such rejection has been upheld – by the High Commission of Appeal. Is it possible, in such cases, to plead *res judicata*?

The question of *res judicata* is apt in relation to this case and may be equally apt in relation to other areas of industrial property, for two reasons. First, the procedure brought before OAPI internal bodies is cancellation; the procedure brought before a court is invalidation. The two procedures have different purposes technically, but the same cause. Moreover, it is only natural that the Douala judge granted the invalidation, giving no thought to OAPI internal procedures, even though these were hotly debated by the parties. As mentioned, the OAPI dispute resolution bodies are purely administrative. That includes the High Commission of Appeal, the role

of which has sometimes been debated.¹⁴ It follows that decisions rendered by such bodies cannot have the force of *res judicata* in a court of law.

Decisions of the OAPI, moreover, can be easily circumvented. Not only may parties dispense with appeals to the High Commission, but also, even if they do appeal, parties dissatisfied with the High Commission's decision can recommence proceedings before a domestic court. Furthermore, even in the midst of proceedings before OAPI bodies, nothing prevents a party with an interest in doing so from taking the other party straight to court, circumstances permitting. As soon as a prior right and likelihood of confusion emerge, particularly in trademark matters, judicial channels are fully open. All things considered, it seems that cases may be referred to the domestic judge before, during or after a case is brought before the OAPI administrative bodies. Conversely, once a dispute is brought before a court, recourse to the OAPI administrative bodies no longer makes sense, since, under article 18 of ABR-1999, judicial decisions are binding on the OAPI.¹⁵

The lack of available legal means to prevent such easy circumvention of OAPI decisions is regrettable. The decisions of the OAPI's dispute resolution bodies – particularly its High Commission of Appeal – help to standardize OAPI law in certain areas only independently of the courts.

Joseph Fometeu

B. Arbitration in intellectual property matters – No application of OHADA law – Appointment of the arbitration board – Film broadcasting – Payment of remuneration

The parties to a contract may opt to resolve copyright disputes through arbitration. In such cases, the court judge asked to appoint the arbitral board is bound by the terms of the arbitration clause. Thereafter, it is the arbitral board's responsibility to rule on all aspects of the dispute submitted to it and to refrain from referring the dispute back to the judge. Accordingly, an arbitral board that adjudicates royalty issues but refers other matters back to the judge rules *infra petita*.

LINDA-COMMUNICATIONS V. MIC-VIDÉO, Decision No. 7/GCS.02 of May 17, 2002, Supreme Court of the Congo

Observations:

In Africa, recourse to alternative dispute resolution (ADR) is uncommon in intellectual property matters. The decision handed down by the Supreme Court of the Congo on May 17, 2002, is therefore of interest.

14 Considering it a judicial body: R.G. Biyo'o (2004) La protection des marques de produits dans l'espace de l'Organisation africaine de la Propriété intellectuelle. Doctoral thesis, University of Douala, www.memoireonline.com.

15 This rule was taken up as art. 20 in ABR-2015.

Facts: The company Linda-Communications entered into an exclusive contract with MIC-Vidéo Establishments under which MIC-Vidéo provided film cassettes to television channel Canal Ocean, owned by Linda-Communications, for broadcast to subscribers. In exchange, Linda-Communications undertook to pay remuneration equal to 50 percent of the gross revenues received from Canal Ocean subscribers. In addition, a clause in the contract provides for the submission of any dispute to an arbitral board jointly selected by the parties.

Unfortunately, execution of the agreement did not go as planned. After the cassette supplier, MIC-Vidéo, submitted a complaint, the parties failed to agree on a method for calculating the royalties. MIC-Vidéo took its case to the commercial court of Pointe-Noire, where a three-member arbitral board was constituted and issued a ruling. Linda-Communications contested the validity and content of the board's ruling, disputing its competence as originating not from the parties' agreement but from a court unilaterally seized by MIC-Vidéo. Linda-Communications also alleged various substantive flaws in the board's decision, including error of law, distortion of the meaning of a contract and breach of procedural rules.

Reasoning: The dispute is interesting in several ways, raising broader questions about arbitration itself in terms of the appointment of arbitrators to rule on a dispute and the role played by arbitral boards.

In this particular case, these questions were addressed in an effort to resolve the factual issue behind the dispute and are specifically related to intellectual property. The dispute arose, after all, over remuneration claimed for Canal Ocean's use of the films; it was settled (which rarely happens) through an arbitral decision – albeit one that was contested. The mere inclusion of an arbitration clause in a contract licensing intellectual property rights is noteworthy in itself as an opportunity to confirm that an intellectual property dispute *can* be arbitrated under OAPI law (see section I). In addition, the Congolese Supreme Court ruling in this case provides some useful clarification of the basis on which royalties for the use of protected rights can be calculated (see section II).

I. The arbitrability of intellectual property disputes within OAPI

It may seem superfluous to discuss the arbitrability of intellectual property disputes insofar as the question of the relationship between arbitration and intellectual property is a longstanding one. From the standpoint of comparative law, the matter seems settled. As Vivant puts it, with reference to intellectual property, only “a few islets of non-arbitrability remain in an ocean of arbitrability.”¹⁶ However, these “islets” are not very numerous, if one refers to the arbitration in matters of industrial property (A) and literary and artistic property (B), or if one looks at the applicable law to arbitration of intellectual property disputes within OAPI (C).

A. Arbitration in matters of industrial property

For example, some observers argue that an arbitrator may rule on the rights conveyed by an industrial property title but not on the title itself. Since the title is issued by a public authority, the reasoning goes, its validity is a matter of public policy.¹⁷ According to other observers, an arbitrator may rule on both the rights and the title itself – but in terms of enforceability between the parties, not their validity toward others. The arbitral award is then “classed as a non-opposition agreement,”¹⁸ with effect between the contractual parties only.¹⁹ Along the same lines, the Paris Court of Appeal, by its decision of February 28, 2008, admitted that an arbitrator may rule on the validity of a patent as an incidental question, but stated that the arbitral award has effect between the parties only and lacks the force of *res judicata*.²⁰ There are two legally distinct questions here: *validity* refers to the status of an act upon origination; *enforceability*, to a title's effectiveness between parties.²¹ Making everything subject to arbitration might seem a satisfactory solution, even if some things then become unenforceable, but it carries significant risks in practice, including of contradictions between judicial and arbitral decisions. In other words, “patents effective *inter partes* today could be erased tomorrow by a court decision.”²² It would therefore be preferable if disputes over a title's validity within the OAPI were not to be brought before the courts.²³

Another controversial topic is whether disputes over criminal matters and interim measures specific to intellectual property are subject to arbitration. With regard to criminal matters, article 4(1) of ABR-2015 seems to prohibit their submission to arbitration. By providing that domestic courts have exclusive jurisdiction over criminal matters relating to the recognition, scope or exploitation of the rights provided for in the Agreement and its annexes, article 4(1) – intended, in reality, to lay the foundations for a supranational jurisdiction for intellectual property, leaving related criminal matters to the domestic courts – could be interpreted as giving exclusive jurisdiction to those courts. For disputes over interim measures, and specifically infringement seizure, most observers consider it “less obvious, but not impossible”²⁴ that an arbitral board might order such a seizure, which might then be preferably referred to a court before or in parallel with the arbitral procedure.²⁵

- 17 G. Bonet and C. Jarrosson (1994) L'arbitrabilité des litiges de propriété industrielle, droit française. In *Arbitrage et propriété intellectuelle* (Publications de l'IRPI). Paris: Litec, 66.
- 18 J. Tankeu (2018) *Le recours aux modes alternatifs de règlement des litiges en matière de propriété intellectuelle*. Paris: L'Harmattan, 228 et seq.
- 19 However, concerning the acceptance of the validity of *erga omnes* in France, in application of art. L.716-6 CPI, see N. Binctin (2020) *Droit de la propriété intellectuelle*, 6th edn. Paris: LGDJ, No. 1633.
- 20 CA Paris, February 28, 2008, *RTD Comm*, 516 (obs. E. Loquin).
- 21 A.-C. Chiariny-Daudet (2006) *Le règlement judiciaire et arbitral des contentieux internationaux sur brevets d'invention* (Bibliothèque de droit de l'entreprise). Paris: Litec, Nos. 531 and 699.
- 22 A.J. Johnson-Ansah (2015) Le concours de l'arbitrage à la protection de la propriété industrielle en Afrique francophone subsaharienne. *RFPI*, 1, 4–18.
- 23 Along these lines, see *ibid.*
- 24 Tankeu, n. 18.
- 25 For a similar, and unequivocal, argument, see A. Lucas (2008) *Arbitrage et propriété intellectuelle, allocution lors de la conférence annuelle de la Faculté de Droit de l'Université des Émirats Arabes Unis*. Presented at Emirates Centre for Strategic Studies and Research.

16 M. Vivant (2004) Cherche litige non arbitral laborieusement. *RLDA*, 72, 5.

Such doctrinal differences aside, arbitrators in some countries are allowed by law to rule on a title's validity and even on the infringement claim itself. In the United States, for example, section 294 of the federal Patent Act in principle allows arbitration for both validity and infringement claims, even if the arbitral award has legal effect between the parties only. Belgian law goes further, allowing arbitration for patent disputes and expressly recognizing the possible legal effect on others.²⁶ In France as well, arbitration is allowed by provisions in the Intellectual Property Code, including articles L.331-1, L.521-3-1 and L.615-17, devoted to copyright, designs and models, respectively, as well as patents. It is done in essentially the same way: after affirming the jurisdiction of civil courts for civil actions and intellectual property claims, including those alleging unfair competition, the Code says that nothing "precludes recourse to arbitration."

B. Arbitration in matters of literary and artistic property
With regard to literary and artistic property in particular, the possibility of arbitrating economic rights has never truly been challenged.²⁷ In the present case, neither the judge nor either of the parties contested that possibility in principle. The debate tends instead to center on criminal matters relating to an infringement, which should not be arbitrable.²⁸

Moral rights are inarbitrable within the OAPI in principle,²⁹ but not strictly so in practice. It is beyond dispute that the effects of infringing a moral right can indeed be arbitrated; they are likely to be economic and thus pertain to rights that are freely alienable. A moral right may itself be alienable (and thus available) in some circumstances. French case law allows some moral rights, including inviolability of the work and right of the author to be identified,³⁰ to be waived under certain conditions and with the author's consent. The latter waiver is admittedly provisional because authors can reclaim their identification as such at any time. Even so, given the acceptance of such waivers – which represent a monetization, in effect, of the rights concerned³¹ – the general inalienability of moral rights can no longer be assumed. This means that an arbitrator "could legitimately rule, if pursuant to an arbitration clause, on the validity or invalidity of such waivers."³² Finally, there are proposals to permit the arbitration of moral rights in line with progress toward formalizing such rights.³³

26 T. Cook (2014) *Alternative Dispute Resolution (ADR) as a Tool for Intellectual Property (IP) Enforcement: Main Document and Executive Summary*, www.wipo.int/meetings/fr/doc_details.jsp?doc_id=263216.

27 L.Y. Ngombe (2004) *Le droit d'auteur en Afrique*. Paris: L'Harmattan, No. 265.

28 For an opposing view, see M. Vivant and J.M. Bruguiere (2009) *Droit d'auteur*. Paris: Dalloz, No. 1146. The authors conclude "without reservation" that infringement disputes are arbitrable. For an overview of the debate, see M. Rivoire (2018) *L'arbitrabilité du droit d'auteur: le cas du droit français*. *McGill Journal of Dispute Resolution*, 4, 43–64, <https://ssrn.com/abstract=3073874>.

29 Although, in some countries, moral rights can be arbitrated when waivable (and thus alienable) by law. See, e.g., Copyright Act of Canada, s. 14(2).

30 A. Lucas and H.-J. Lucas (2017) *Traité de la propriété littéraire et artistique*, 5th edn. Paris: Litec, Nos. 545 and 614.

31 F. Siirainen (2012) *Arbitrage, transaction et droit moral de l'auteur* (Actes de Colloque). Paris: Dalloz, 99–116.

32 Tankeu, n. 18.

33 Rivoire, n. 28.

In the current case, however, the arbitrability of rights under the contract was not addressed. At issue instead were the arbitral board's appointment and its violation thereafter of various substantive and procedural rules. The board had allegedly ruled *infra petita*, for instance, having failed to address some of the questions said to have been presented. What those questions might be, however, is unfortunately not clear from reading the decision, leaving it uncertain whether the board considered them inarbitrable.

There have been few arbitral decisions on such points in any case, so debate about them here might have been useful.

C. Applicable law to arbitration of intellectual property disputes within OAPI

On that subject, it must first be considered that an arbitration clause was included in a copyright exploitation contract and that the only matter in dispute was the royalty owed for exploitation of a public performance right – a matter perfectly arbitrable within the OAPI legal framework. The text applicable to intellectual property within the OAPI at the time the contract was signed was the original 1977 version of the Bangui Agreement then in force. The law applicable to arbitration consisted of the Uniform Act on Arbitration Law of the Organization for the Harmonization of Business Law in Africa (Organisation pour l'harmonisation en Afrique du droit des affaires, or OHADA) and certain provisions of the country's Code of Civil, Commercial, Administrative and Financial Procedure.

The 1977 Bangui Agreement provided no recourse to arbitration, but that does not imply opposition to the idea. It follows that article 9 of the contract between Linda-Communications and MIC-Vidéo was entirely legal. Accordingly, the validity of the arbitration clause contained in that article could not be challenged in principle nor could application of the clause be challenged under the OHADA Uniform Act on grounds that the right at issue was inarbitrable. For contractual rights to be arbitrable, according to article 2 of the Act, they must be freely alienable. And the right concerned here – the author's economic right, to be exploited under the contract – was clearly alienable.

Arbitration clauses are even less exposed to invalidation under article 4(2) of ABR-2015, which provides that: "Any dispute concerning the application of this Agreement and its annexes may be settled by arbitration or mediation." In addition, following the example of the World Intellectual Property Organization (WIPO), the OAPI has set up an arbitration and mediation center to settle intellectual property disputes by non-judicial means. Article 2 of its arbitration rules indicates the following requirements for submitting disputes:

"(a) the dispute must relate to intellectual property, pursuant to an arbitration clause or arbitration agreement;

- “(b) at least one of the parties must have its domicile or habitual residence in one of the member states of the Organization, or failing that, the contract must be executed in whole or in part in at least one such member state;
- “(c) the intellectual property rights in dispute must be arbitrable.”

What is particular about this last requirement is that it calls for adherence to article 2 of the OHADA Uniform Act, as well as due regard for the nuances of intellectual property law outlined above.

Applying all of these provisions can be a delicate exercise. In the present case, it meant applying Congolese domestic law, referred to by the court as “*droit commun*,” as well as the OAPI and OHADA provisions. The combined application of the OAPI and OHADA provisions was simplified by the fact that the former did not regulate arbitration at the time.³⁴ Neither had any conflict arisen between the OAPI provisions and domestic law. By contrast, the court *did* have to choose whether to apply domestic law or the OHADA provisions. It chose the former, reasoning that the dispute was subject not to the OHADA Uniform Act but to domestic law, and so to domestic procedural rules. This reasoning suggests that applying the provisions of one legal regime to the substance of a dispute necessarily means applying that same regime’s formal or procedural rules as well. If that approach is to be countenanced, it must be qualified, since the OHADA Uniform Act cannot simply be ignored in an OAPI country. Indeed, as stated in article 1 of the Act, “This Uniform Act shall apply to any arbitration when the seat of the arbitral tribunal is in one of the state’s parties.” That provision, establishing the basic conditions for any type of arbitration and for all areas of business law, means that the Act’s provisions are applicable without exception, and particularly in respect of arbitrability. The Act’s universal character is such that, even for matters not governed thereby, some of its provisions will occasionally apply.

II. Calculating royalties for the exploitation of protected intellectual property

Royalties for the use of protected intellectual property are calculated differently for copyright than for industrial property. Provisions applicable to the latter have left the remuneration of right holders entirely unregulated, granting total freedom in the matter. None of the annexes to the Bangui Agreement establish any basis for calculating such remuneration.³⁵

For copyright, on the other hand, domestic laws have led the way in providing for proportional remuneration generally, with provision for lump sums in special cases.

In the Congo, article 45 of Law No. 24/82 of July 7, 1982, on copyright and related rights, requires that licenses assure authors of a proportional share in any revenue, of any type, generated through sale or exploitation. The same principle has now been adopted in annex VII to ABR-2015. The principle of proportional remuneration is relatively simple: contracts must assure the author a specific percentage of gross revenue from exploitation. For both physical and electronic media (i.e., downloaded copies), the percentage is applied to the unit sale price. The bottom line is that copyright royalties are calculated based on revenue accruing to the operator.³⁶

However, the rule is mandatory only for licensing contracts entered into directly by the author; it is not so for other types of copyright exploitation or sub-licensing contract. Rates may be freely negotiated but, if minimal, this might imply an intention to evade the law.

The amount serving as the basis for the remuneration is determined according to the law. It is “the price paid by the public,” usually consisting of revenue from exploitation.³⁷

The circumstances surrounding the demand for payment from Linda-Communications raise doubts as to the applicability of this rule to the contract invoked. It was clearly not the authors of the exploited films who contracted to “supply” the cassettes; it was the distributor, no doubt under contract with the film producers. So proportional remuneration was not required nor did the contract convey the right at issue, that of public performance. Lastly, the contract calculated remuneration based on the gross subscription revenue earned by the Canal Ocean network and it is precisely that basis that led to the dispute. While the proportionality rule was not applicable to the case, for the reasons noted, the Supreme Court’s decision offers an opportunity to distill some useful clarifications. It is important first that the basis for calculation would have preferably, from the perspective of MIC-Vidéo, included revenue generated by all of the channels managed by Linda-Communications. According to Linda-Communications, the basis specified in article 9 of the contract consists of revenue generated only by the channel broadcasting the films. The question, in short, is whether the contracting party’s entire business activity or only that relating to exploitation of the work concerned should serve as the basis for proportional remuneration. The question may seem trivial at first glance, but sometimes copyright exploitation contracts do base calculations of proportional remuneration on a licensee’s total sales – an approach justified only when the licensee’s activity consists essentially or exclusively of exploiting protected works.³⁸ Problems specific to this particular sector, moreover, have been the focus of

34 Even today, there should be no difficulty, since the two types of regulation do not give rise to any instances of conflict.

35 It appears well established, however, that licensing agreements generally combine a lump sum, independent of production volume, with remuneration proportional to the sales generated or number of goods manufactured under license, with the contract enabling a titleholder to check the accuracy of calculation.

36 J. Fometeu (2018) *Droit d’auteur et droits voisins, Questions/réponses*. Paris: L’Harmattan, 22 et seq.

37 J.P. Clavier and C. Bernault (2015) *Dictionnaire de la propriété intellectuelle*, 2nd edn. Paris: Ellipses, 440 and 441.

38 Fometeu, n. 36, at 106–107.

abundant legal commentary.³⁹ None of this, however, justifies including all of a debtor's business activities as the basis for calculation.

Two points require clarification here. First, remuneration can be proportional only to the revenue generated by exploiting one or more specific works covered by the contract. Expanding the basis to include the debtor's other activities inevitably means broadening the contractual scope beyond that intended by the parties. Worse still, such expansion in this case would encroach on other contracts and hence on the remuneration calculated for other right holders for works exploited on the debtor company's other channels.

Second, remuneration should be determined only after certain deductions have been made – specifically, taxes. In that vein, French case law bases proportional remuneration on the retail price, net of tax,⁴⁰ which operators must pay. On the one hand, the Supreme Court applies the law in that regard faultlessly. On the other hand, however, in a preambular paragraph the Court questionably prescribes that the arbitral board should have deducted “corporate accounting costs.” Had article 9 of the contract included such a deduction, then it logically should have been binding, the contract not being between an author and a licensee. Had it been such a contract, however, a clause of that kind would have been invalid. The above-mentioned Law No. 24/82 on copyright and related rights refers to “revenue of any nature from sale or exploitation,” meaning here the company's gross revenue from exploitation. Deducting corporate accounting costs would indeed lower the basis for remuneration, so if the contract is silent on that point, it means that the parties envisaged compulsory deductions only, including taxes, and that the Congolese judge exceeded the parties' intent.

Joseph Fometeu

C. Legislation establishing the seizure of infringing works – Questions of OHADA law – Application of OAPI law (annex VII) – Application of domestic law

The choice of legislation on which to base the seizure of infringing goods is a function of the intellectual property protected. Consequently, a seizure relating to works of the mind can be based on neither annex III to ABR, concerning trademarks, nor on OHADA law, but rather on annex VII, concerning literary and artistic property, as well as relevant domestic law.

39 See, e.g., C. Monnerie (2009) Point de vue sur la rémunération des auteurs de cinéma. *Comm. com. electr.*, alert. 1; C. Bernault (2014) Contrat de distribution des œuvres audiovisuelles, contrat de distribution video. *Juris-Classeur Contrats-Distribution*, Fasc. 3510.

40 Cass. 1^{ère} civ., July 16, 1998.

SOCIÉTÉ EUROPRESS – EDITORES E DISTRIBUIDORES DE PUBLICAÇÕES LDA V. COMPAGNIE BEAUCHEMIN INTERNATIONAL INC., Interim order No. 124 of July 20, 2004, Regional Court of Niamey

Observations:

The case brought before the judge for urgent applications in Niamey is a mine of intellectual property law, studded with questions regarding both practice and general theory.

Facts: The facts of the case foreshadow the legal difficulties to be encountered. Following an international call for tenders, the company Europress was successfully selected to supply primary and secondary school textbooks, including some from the GRIA-Côte d'Ivoire collection for the 8th and 9th grades. The books were delivered to good effect for distribution by Daouda Establishments, but some texts in the collection proved to be substitutes from another, similarly named collection, GRIA-Niger. Subsequently, a Canadian company, Beauchemin International Inc., claiming to be the right holder and a victim of infringement, executed a sequestration of tangible personal property (the substitute books) and of credits in the hands of Education Project 1, sponsored by the African Development Fund (I.FAD), the Ministry of Basic Education, and the Ministry of Economic Affairs and Finance, amounting to CFAF 27,939,871 in principal and CFAF 1 million for damages. Europress resorted to the judge for urgent applications, seeking cancellation of the sequestrations. During the proceedings, the Niger Copyright Office filed a voluntary intervention.

Reasoning: Europress invoked various arguments in support of its petition, including the contention that Beauchemin had not provided proof of ownership of rights to the attached works, in an effort to seek denial of the company's standing and right to attach. It requested in addition that the voluntary intervention by the Niger Copyright Office be declared inadmissible on the grounds that it had not produced documents establishing any agreement with the collective management organization (CMO) to which Beauchemin supposedly belonged.

To counter that argument, Beauchemin raised objection to the jurisdiction of the judge for urgent applications on the grounds that the matter had already been referred to the trial judge and, most importantly, that the applicable annex to ABR-1999 (then in force) was not annex III but annex VII. That last argument, in particular, along with a few others, are what makes this decision so interesting, giving the judge the opportunity to:

- I. explore the ramifications of a local CMO's standing to defend the repertoire of a foreign CMO;
- II. determine the applicability in intellectual property matters of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures; and
- III. assess how annex VII of ABR-1999 fits in with domestic laws on copyright and related rights.

I. The standing of a national CMO to defend a foreign repertoire

The Regional Court of Niamey responded clearly to this first question: where no agreement exists between them, a national CMO cannot defend a foreign CMO's repertoire. The answer harks back to a long-standing debate over whether CMOs can bring proceedings on behalf of rights holders who are not their members. French case law says they cannot.⁴¹ And, apparently, even if they *are* members, their infringed works must also be included in the plaintiff CMO's repertoire.⁴²

In that sense, while the court's position is perfectly justified and legally robust, the solution may prove inconvenient.⁴³ The question is whether the situations of national and foreign right holders need to be differentiated. If, on the one hand, a national right holder were to fail or deliberately choose not to join a national CMO, or to include some of its works in the CMO's repertoire, it would be inappropriate for a third party – whether a CMO or not – to intervene in the management of those rights. Foreign right holders, on the other hand, cannot be faulted for being unable to join national CMOs in the countries where they need protection – or, if they are able to join, for their CMOs not being party to a reciprocal representation agreement. In addition, in pursuit of wide applicability, positive law “disregards the simple fact that many authors cannot join a CMO because none exists in their countries of residence.”

⁴⁴ Since it would not be fair to leave such authors vulnerable to infringement of their works, the question then becomes whether national agencies might be given authority to address the problem from a business management standpoint.⁴⁵

II. The applicability in intellectual property matters of the OHADA Uniform Act

Is sequestration permitted under the referenced OHADA Uniform Act in the specific case of intellectual property? That was the second point of law submitted to the court in its capacity as judge for urgent applications. In principle, the answer should vary depending on the situation.

Suppose, first, that an object of intellectual property can be distrained to cover a debt owed by the object's right holder. Attachment for that purpose is unquestionably possible, even if the regime for such attachments remains imprecise.⁴⁶ Consider, second, whether intellectual property can be sequestered under the Act. It clearly can, if done for the purpose of a forced sale, such

as if the creditor sequesters intellectual property rights with a view to later conversion. Such sequestrations are above reproach. But in cases of infringement, sequestration as defined in the Act is more complicated. In this case, Beauchemin did sequester intellectual property, but not for the purposes of debt recovery; rather, its purpose was to preconstitute evidence of the infringement for proceedings already initiated. The court's reasoning on this point is unfortunate and difficult to follow. While the sequestration was carried out under the Act, the court invokes domestic law and annex VII to ABR-1999 to dismiss the petition for its cancellation. There are admittedly seizure mechanisms other than the seizure of physical media that can be used to preconstitute evidence of infringement, but sequestering tangible personal property hardly falls in that category. The court should have cancelled the sequestration of physical media and sent Beauchemin back to carry out the appropriate form of seizure.

That still leaves the sequestration of credits in the hands of the I.FAD project. The question is interesting because the sums placed under judicial control could be used for debt payment if the seizure carried out could be converted to one of attachment and award. Unfortunately, the facts cited as legal grounds in the court's decision are erroneous.

It appears from the decision that the presumption in attaching those sums was that they consisted of “revenues,” as regulated by copyright legislation. Given the nature of the project that was holding them when seized and the institutions behind it, that could never be the case. They were not, in fact, revenues, but credits on the I.FAD project's books in favor of Europress. Nor did the seizure meet the conditions required of attachment for debt recovery. Broadly speaking, protective measures for any debt can be authorized only if the underlying claim appears to be founded and the creditor can show proof of circumstances likely to jeopardize recovery.⁴⁷ In the particular case of counterfeiting, if sequestration is sought before a trial can begin, the seizure applicant will not be in a position to show that its claim as creditor is founded. That requires a trial court conviction recognizing the criminal nature of the distrainee's acts. So, unlike other creditors – required to establish only the likelihood of their claim and threat to its recovery, with adjudication of the claim's merit coming later – a person seeking to sequester intellectual property before going to court must establish both the likelihood that it owns the right in question *and* that the right has been infringed – with the merits of both claims also being adjudicated later. The difference between what is required in each case calls for the application of different statutory provisions: a creditor must ordinarily proceed based on the provisions governing enforcement measures generally, but holders of intellectual property rights must follow the provisions governing intellectual property. That nuance escapes the Niamey judge for urgent applications when approving the sequestration by Beauchemin.

41 See, e.g., Cass. 1ère civ., February 19, 2013, D. 2013, 67 (note P. Allayes).

42 See Vivant and Bruguière, n. 28, No. 1141; CA Paris, July 10, 1990, *RIDA* 1990/91, 31.

43 A. Lucas, A. Lucas-Schloetter and C. Bernault (2017) *Traité de la propriété littéraire et artistique*, 5th edn. Paris: LexisNexis, No. 1197.

44 U. Uchtenhagen (2005) *La gestion collective dans la vie musicale*. Geneva: WIPO, No. 275.

45 Along similar lines, see *ibid.*, No. 276 *et seq.*

46 For an example of trademark seizure, see *Rothmans of Pall Mall Ltd SA v. Société Adil Co. and El Hadj SS*, Judgment No. 118 of May 20, 2008, High Court of Niamey (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section 5).

47 See OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures, art. 54.

III. Annex VII to ABR-1999 vs. national copyright laws

The current case provides a perfect illustration of the difficulties in interpreting how annex VII to the Bangui Agreement correlates with domestic laws. The debate surrounding the versions of the Agreement prior to 2015 centered on the nature of the rights created by that annex, the advancement of which compares so unfavorably with that of rights established under the other annexes to the Agreement. While the others have been easy to apply in member states, meeting no legal barriers in the provisions of domestic law, an unlikely path has had to be forged for annex VII to survive and justify its existence as part of OAPI law.

The situation at the time was rather puzzling. While there were no theoretical distinctions between the different annexes, the reality was that domestic laws on copyright and related rights were in place in almost all OAPI countries. How, then, does annex VII connect with domestic laws? That is a question the court implicitly answered without the parties actually asking it. Some background on how the Agreement evolved over time may cast helpful light on the issue: annex VII was placed at something of a disadvantage in early versions of the Bangui Agreement (A) compared with ABR-2015 (B).

A. The status of annex VII prior to ABR-2015

The status of annex VII in previous versions of the Bangui Agreement was ambiguous in theory and difficult to apply in practice.

It was ambiguous in theory in that article 3(1) of ABR-1999 stipulated the following: "Rights relating to the fields of intellectual property, as provided for in the annexes to this Agreement, shall be independent national rights subject to the legislation of each of the member states in which they have effect."⁴⁸ How was that provision to be understood in an international convention? Several interpretations were possible.

According to the first, it meant that the regional text constituted national law in all member states but could be supplemented in each country. By systematically adopting their own copyright laws, however, member states clearly demonstrated the desire for the annex to coexist alongside their own domestic legislation. Annex VII was thus serving as a general framework only.⁴⁹ This first interpretation does not take us far, since the term "general framework" is imprecise.

According to a second interpretation, the rights provided for in the Agreement and its annexes were to be subject to national law only for the purpose of implementation, which amounted to *incorporating* the rights under annex VII and the other annexes into domestic law. That reading was self-defeating: if adopted, it would apply to all of the annexes, so neither the Agreement nor its

annexes would be directly applicable in the member states, which was far from the legal reality.

Accordingly, a third interpretation of the provision was that the rights enshrined in the Bangui Agreement and its annexes *constituted* national law, exactly as if enacted by a domestic legislative body. This last interpretation appears to capture the reality of how national laws in OAPI member states relate to annex VII of the Bangui Agreement. Indeed, all indications are that OAPI provisions are seen as being integrated into national law and subject to domestic provisions, suggesting that OAPI law is in no way supranational.

The application of annex VII was complicated by its status. All of the interpretations draw distinctions between the various annexes,⁵⁰ largely as attempts to justify, *a posteriori*, a legally awkward situation for a regionally integrated group of countries. Every time a country legislated on copyright and related rights, it was more or less emancipating itself from the corresponding part of the Bangui Agreement. In countries that had already legislated in this area, provisions in the annex could at best be used to fill gaps in domestic law.

The confused status of annex VII has led to confused case law. Under the pre-2015 versions of the Agreement, three distinct scenarios have tended to play out in domestic courts within the OAPI. One is for the judge to apply domestic law only, without reference to annex VII or invocation thereof by the parties.⁵¹ That has happened in most cases. Another is application of annex VII only, essentially papering over domestic law. In a case in Cameroon, for instance, the only legislation applied to copyright issues (lack of formalities, originality of the work, title of the work, etc.) was annex VII, although annex III was also applicable.⁵² A last is where the judge applies both domestic law *and* annex VII, which can be done in two ways.

- The judge may cite the regional text, but then apply the national law. A judge in Cameroon did just that after citing both the Bangui Agreement (AB-1977 at the time) and Cameroon's Law No. 2000/11 of December 19, 2000, affirming that "only natural or legal persons exploiting protected literary or artistic works without the authorization of their authors are required to pay royalties."⁵³
- The judge may apply annex VII and domestic law as if they are simultaneously applicable. That is the approach taken by the judge for urgent applications in the present case.

50 Such distinctions ran contrary to ABR-1999, art. 4(2) and (3).

51 See, e.g., *Groupement Edition Pierron International v. Etablissement Niger – Bureau*, Judgment No. 80 of March 3, 2004, Regional Court of Niamey. In P. Edou Edou (ed.) (2009) *Le contentieux de la propriété intellectuelle dans les États membres de l'OAPI: Guide du magistrat et des auxiliaires*. Geneva: WIPO, 103; *Christine ROSSANO v. Société SOVING AB*, Judgment (undated), Tribunal of Libreville. In *ibid.*, 116.

52 *Moulinex SA v. Vapsan Trading Cie and ors*, Civil judgment No. 192 of December 15, 2000, High Court of Wouri (Douala). In *ibid.*, 169.

53 *Société SEMEN distributeurs SARL v. Société civile du droit d'auteur et des droits voisins des arts audiovisuels et photographiques (SCAAP)*, Interim order No. 186 of March 7, 2007, Court of First Instance of Bonanjo (Douala). In *ibid.*, 116.

48 See also AB-1977, art. 2(1).

49 Y.-L. Ngombe (2005) *Le droit d'auteur dans les États membres de l'organisation africaine de la propriété intellectuelle (OAPI): une harmonisation inachevée?* e.*Bulletin du droit d'auteur*, January–March.

It must be said, however, that the judge is dealt a relatively easy hand, because both texts provide for the same solution. What would a judge decide if the solutions offered were different? Unfortunately, no one can say. The 2015 revision of the Agreement, however, does shed some light on the issue.

B. The status of annex VII under ABR-2015

ABR-2015 clarifies the status of annex VII but leaves open issues likely to affect its application. Article 5(1) and (2) in the revised version contain most of the new details to be heeded.

Article 5(1) sets the stage by reproducing article 3 of ABR-1999. Article 5(2) then introduces the changes that aim to scrap the various interpretations of previous versions of the Agreement, as follows: “This Agreement and its annexes shall serve as laws governing their intended subject matter in the Member States, where they shall rescind or prevent the entry into force of all contrary provisions. Annex VII relating to literary and artistic property is a minimum statutory framework.”

Two sets of solutions are thus provided. The first relates to what could be termed the general status of the Agreement and its annexes relative to domestic law. The new version clarifies that OAPI law *is* domestic law, forming part of each state’s domestic legal system and serving to govern the subject matter covered. It also borrows from OHADA in rescinding or preventing the entry into force of contrary provisions should domestic legislative bodies attempt to adopt them. It could not be clearer. Inspired by article 10 of the OHADA Treaty on the Harmonization of Business Law in Africa, the new wording ends all speculation about the relative status of regional vs. domestic legal provisions. The supranational effect of OAPI law is no longer in doubt.

The second set of solutions relates to the special status of annex VII. According to the text, it represents “a minimum statutory framework.” The effect of that solution, while sophisticated, is simply to make annex VII a minimum standard, or benchmark, for states that prefer to have their own domestic legislation in the area concerned, literary and artistic property, rather than to apply the annex directly. This approach would rank the annex alongside other binding international conventions in this area. The annex naturally draws from such plentiful sources, incorporating the latest international legal standards and allowing for new ones to be integrated over time, thus raising the minimum standards observed in OAPI countries. In other words, as the annex is updated to meet international minimum standards, and to raise them where necessary, domestic laws are likewise updated to meet the new OAPI minimum standards, with ABR-2015 representing the new floor for OAPI member states.

Some difficulties remain, however. The first, both political and material, is that several OAPI member states have quite recently amended their domestic laws (e.g., Côte d’Ivoire in 2016, Mali in 2017 and Guinea in 2019) and will doubtless be reluctant to implement

change. That may not be enough to revive nationalistic undercurrents, but it could delay implementation of the annex.

The second lies in defining the “minimum statutory framework,” the substance of which could be open to discussion.

Those difficulties notwithstanding, the situation is by far preferable to that under earlier versions of the Agreement. The new article 5(2) *in fine* is clearly aimed at national legislators in the member states, who must heed it when drafting or updating domestic law. If they do nothing, application of the new text falls directly to judges. Consequently, where a state is slow to update its legislation, litigants can rely on the Agreement to guide judges where domestic law might remain silent on matters regulated by the OAPI or below its minimum standards. On the basis of article 5(2), the judge can then set domestic law aside and apply annex VII.

And that offers hope that judges will respond favorably and decisively to informed litigants seeking to avail themselves of the broadened Agreement and the fresh impetus being given to OAPI law.

Joseph Fometeu

D. Nationality – Payment of *cautio judicatum solvi* by nationals of OAPI member states in other member states

While the Bangui Agreement establishes regional protection for intellectual property titles issued by the OAPI on a community basis within a territory spanning 17 states, nationals of those states are still required to pay a *cautio judicatum solvi* when bringing actions before the courts of other member states.

MAMADOU S. DIALLO ESTABLISHMENTS V. IBRAHIMA KEITA AND WALY FAYE, Decision No. 73 of September 19, 2018, Supreme Court of Senegal

Observations:

The enforcement of a court ruling against a foreign plaintiff is often problematic. A foreign plaintiff with no ties to the host country can bring vexatious claims against nationals without fearing conviction as a consequence. A *cautio judicatum solvi*⁵⁴ deposit is a palliative measure aimed at protecting nationals against reckless claims made by foreign plaintiffs. Introduced by article 16 of the Napoleonic Civil Code, this protective mechanism was later incorporated into the codes of civil procedure of the Bangui Agreement signatory countries.⁵⁵ However, requiring a *cautio judicatum solvi* deposit in matters of industrial property raises a number of issues

54 A sum that any foreign plaintiff in a lawsuit is required to pay and which is intended to guarantee the recovery of damages and interest, as well as any costs that may be ordered against them.

55 See, e.g., arts. 110, 73, 4 and 123 of the Civil Procedure Codes of Senegal, Cameroon, Côte d’Ivoire and Burkina Faso, respectively.

related to the unique character of the OAPI space, conceived of as a single territory.

Facts: The facts behind this case are simple. Mamadou Samba Diallo Establishments (Diallo), in execution of Order No. 26, of July 19, 2016, by the High Court of Kaolack, carried out an infringement seizure of 134 bales of motorcycle tires, valued at CFAF 15 million, against Mr. Ibrahima Keita, while also bringing action against him before the same High Court to establish his acts of counterfeiting, obtain approval of the seizure and seek compensation amounting to CFAF 50 million. In an interlocutory decision of March 16, 2017, the High Court ordered the plaintiff to make a *cautio judicatum solvi* deposit in the amount of CFAF 15 million – a decision upheld by the Court of Appeal of Dakar. Diallo then appealed to the Supreme Court to quash the prior ruling, alleging violation of annex III to AB-1977 and arguing that the *cautio judicatum solvi* deposit provided for in article 110 of the Senegalese Code of Civil Procedure was not required for the national of a state party, since the OAPI's 17 member states constituted a single protective regional territory.

Reasoning: The legal question put to the Senegalese Supreme Court was whether a plaintiff who is a national of an OAPI member state is exempt, by virtue of belonging to that region, from a *cautio judicatum solvi* deposit requirement under the national code of civil procedure of the country where the plaintiff's action is being brought. The Supreme Court rejected the appeal, concurring with the appeal court on the main ground cited: that the Bangui Agreement "does not codify the conditions of access to the domestic courts of each state party."

The decision is noteworthy because it:

- I. clarifies the content and scope of the single-territory concept within a uniform system for the protection of intellectual property; and
- II. highlights the decisive effect of national legislation on the procedure for enforcing intellectual property rights.

I. The content and scope of the single-territory concept within the OAPI

The first part of Diallo's single plea in appealing to the Supreme Court relates precisely to the unity of OAPI territory as grounds for exemption from the *cautio judicatum solvi* deposit requirement. This is clearly no trivial argument. It weaponizes as litigation, in effect, the original intent of the plenipotentiaries of OAPI member states. It was they, in pursuit of greater cooperation, who established region-wide protection for industrial property, thus forming a single territory for both the recognition and exercise of rights.⁵⁶ It is precisely for that

reason that plaintiffs need not file patent applications, for instance, in every OAPI member state. As provided for in article 7(1) of ABR-1999, "any filing effected with the administration of one of the member states in accordance with the provisions of this Agreement, or with the Organization, shall be equivalent to a national filing in each member state." Furthermore, the titles issued by the OAPI, as the common industrial property office for all 17 member states, are effective in all those states. In terms of the exercise of rights, the right to exploit industrial property in one member state is recognized as a right to do so in all the others, although the principle is expressed differently depending on the specific right in question.⁵⁷ Regulations relating to the recognition and exercise of rights are approached in the same way, whether one adopts a restrictive (A) or expansive (B) approach to the single-territory concept.

A. Restrictive interpretation of the single-territory concept

The appellants to the Supreme Court invoked the unity of the OAPI territory in seeking to avoid the *cautio judicatum solvi* deposit required under the Senegalese Code of Civil Procedure. In their view, they should have been treated as nationals by virtue of the integration achieved through OAPI law, since the dispute related to intellectual property. Following that interpretation, the term "foreigner," as used in both the national codes of civil procedure and the annexes to the Bangui Agreement, takes on a very singular meaning. Strictly speaking, since the founding fathers of the OAPI saw no need to define "foreigner," the term can be assumed to retain its commonplace meaning when applied to the OAPI community. It follows from that reasoning that any plaintiff not a national of the OAPI member state where the case is being brought must be considered a foreigner within the meaning of the Bangui Agreement and must therefore make the deposit. That argument finds support in article 3 of ABR-1999, which characterizes the rights covered in the annexes as national rights, signifying that domestic judges in OAPI countries are to apply them as if emanating from a domestic legislative body.⁵⁸ That suggests that the lines between state jurisdictions have not been erased by integration, such that the national of one member state who takes legal action in another cannot be exempted from the *cautio judicatum solvi* requirement. The argument is also supported by the lack of any textual evidence that the OAPI intended to create its own common citizenship.

B. Expansive interpretation of the single-territory concept

The narrow interpretation builds its reasoning on an incomplete foundation and has not been corroborated by the evolution of OAPI law. Article 5(3) of ABR-2015 provides, "Non-nationals shall enjoy the provisions of this Agreement and its annexes under the same conditions as nationals." That terse wording, which

56 S. Ngo Mbem (2007) Les enjeux de la protection des dessins et modèles industriels dans le développement en Afrique: le cas des pays membres de l'Organisation Africaine de la Propriété intellectuelle (OAPI). Doctoral thesis, University of Strasbourg III – Robert Schuman, 38 *et seq.*

57 In the case of trademarks, for example, art. 23(1) of annex III provides for the cancellation of any registered mark that, for an uninterrupted period of five years, has not been used within the national territory of one of the member states; in the case of patents, art. 46 of annex I provides for the grant of a non-voluntary license if the patented invention "is not being worked on the territory of a member state."

58 See L.Y. Ngombe (2004) *Le droit d'auteur en Afrique*. Paris: L'Harmattan, 128.

might have come from a national legislator, is unambiguous: the Agreement and its annexes are intended to automatically benefit the nationals of all member states, so the term “foreigner” can refer only to the national of a non-member state. But that explanation merely lays the groundwork for further argument. The reasoning must be based not only on the nature of the rights enshrined in the Agreement⁵⁹ or the Agreement’s effect on nationality, but also on the concept of national treatment underpinning the Agreement.

The national treatment rule is relevant here because of the confusion created in case law whenever nationality is invoked in intellectual property cases. It seems to be automatically assumed that national treatment means perfectly equating a non-national with a national. The High Court of Wouri in Douala⁶⁰ fell into that trap with a questionable decision in a case similar to this one. To escape payment of the security deposit in that case, a company incorporated under American law sought the application in its favor of article 2, on national treatment, of the Paris Convention for the Protection of Industrial Property of March 20, 1883. By validating the American company’s argument under article 2 of the Convention, the Cameroonian High Court violated the letter of that provision, paragraph 3 of which allows a notable exception that was clearly overlooked: “The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure, to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.” It is clear that, under the Paris Convention, the principle of national treatment simply allows a “foreigner” to enjoy, in every state that has signed the same Convention as their own country, the individual rights conferred by such states on their own nationals. The Paris Convention relates only to intellectual property rights, as opposed to other rights, granted to nationals by national law. It therefore leaves intact specific judicial and administrative procedures under domestic legislation in member states, including the *cautio judicatum solvi* deposit requirement. Any other reasoning would exceed the legal protection provided by the international conventions establishing this principle.

On balance, it can safely be said that the uniform system for the protection of intellectual property under the Bangui Agreement is in no way intended to replace national legislation on judicial procedure. So, from that standpoint, the judgment reported here is laudable. The only way in which Diallo might have salvaged its case was to invoke (which it did not) either (a) a judicial cooperation agreement between Senegal and Guinea exempting their respective citizens from the *cautio judicatum*

solvi requirement,⁶¹ or (b) its possession in Senegal of immovable property sufficiently valuable to ensure such payment (see article 16 of the Civil Code of 1804).

II. Difference between a *cautio judicatum solvi* deposit and the security deposits required under the Bangui Agreement

The requirement of a *cautio judicatum solvi* deposit in intellectual property proceedings may cause confusion over provisions in the Bangui Agreement that (a) *allow* a court to require security deposits from seizure applicants, but (b) effectively *oblige* it to do so when the applicant is foreign.⁶²

Confusion over this distinction is even more likely since the purpose of both types of deposit is nearly identical: to ensure the payment of damages and costs that might be ordered. A fine line remains between them, however, in certain respects.

- With regard to their scope of application, the *cautio judicatum solvi* requirement never applies to nationals, while the security concerns over seizures relate to nationals and foreigners alike.
- Further, requiring security for seizures is sometimes optional, sometimes mandatory, while requiring the *cautio judicatum solvi* is always mandatory for foreign plaintiffs who (a) do not own sufficient immovable property to ensure payment and (b) are not nationals of states bound by judicial cooperation agreements with the host country exempting them from the deposit requirement.
- Finally, with regard to procedural provisions, security deposits are generally ordered in cases of seizure unilaterally and *ex officio*, while the *cautio judicatum solvi* deposit is a procedural exception that must be raised by the opposing party in adversarial proceedings.⁶³

In short, the security requirements in the two cases remain distinct – but can they be combined in the same proceedings?

Consider the following scenario. A foreign plaintiff applies to a judge for an infringement seizure. The judge orders a security deposit in accordance with the applicable annex. The foreign plaintiff then institutes court proceedings on the merits, as required by law. Before the trial court, the defendant, a national of the host country, raises an exception to the *cautio judicatum solvi* requirement. Should the court consider the security deposit ordered when the seizure was authorized to

59 Bearing in mind that this was reinforced by the 2015 revision, in that art. 5 (reproducing and reorganizing the former art. 3) clearly reinforces the superiority of OAPI law over national law, making it indisputably supranational.

60 Civil judgment No. 164 of December 6, 2004, High Court of Wouri (Douala) (obs. H. Ndedi Penda, *La Gazette* 2008, 2, 19).

61 On the subject of such an agreement, see *Air Afrique, Revue camerounaise du droit des affaires* (No. 2), July 16, 1999, Court of Appeal of Littoral (Douala), at 81.

62 For example, art. 64(4) of annex I, relating to patents, provides that “[s]ecurity shall always be required of foreigners seeking seizure.” That provision is taken up by almost all the provisions of the annexes relating to industrial property subject matter that provide for infringement seizure. See ABR-1999, art. 64(3) and (4) of annex I, art. 48(3) of annex III and art. 31(3) of annex IV.

63 Moreover, a litigant who has not raised such an exception in good time is irrevocably presumed to have waived it: *Ohadata J-07-27*, Decision No. 13 of June 29, 2006, CCJA, First Chamber.

be equivalent to a *cautio judicatum solvi* deposit? The question is open to debate.

Before attempting an answer, consider another scenario – one that would raise no difficulties. The trial judge, unbound by the interim measures, decides to cancel the deposit requirement imposed upon seizure and to order the appropriate *cautio judicatum solvi* deposit. To return to the question, it could be argued that since the two types of deposit share the same purpose, the deposit ordered at the time of seizure suffices, with no need to “pile deposit upon deposit.” In addition, combining the deposit orders would dissuade foreigners from bringing actions, contrary to the Agreement as last revised (ABR-2015). Article 65(3) of that text requires the judge considering the seizure application, whatever the distrainee’s nationality, to determine that the deposit is “adequate without deterring applicants from availing themselves of the procedure.”

And yet it would not be entirely pointless to combine the two deposit orders. While both are intended to cover damages incurred by the defendant, it remains uncertain whether the compensation sought relates to the same prejudice. Prejudice arising from the seizure must be distinguished from that caused by the lawsuit on the merits. The dividing line is very fine, especially since the foreign plaintiff may be viewed as bringing the same action sequentially. The distinction *can* be made, however, in isolated situations. Since the *cautio judicatum solvi* is intended to cover compensation as well as any costs charged to the foreign plaintiff, the trial court can determine its amount by supplementing what was deposited prior to seizure. Furthermore, if the plaintiff or distrainer were to exceed the seizure order (by carrying out an actual seizure when only an inventory has been ordered, for instance) and their claim found in court to have partial merit (such as where not all of the goods seized prove to be infringing), the deposit prior to seizure could serve to compensate the distrainee for the wrongful seizure, while the *cautio judicatum solvi* could remedy any fault committed by the plaintiff – not in carrying out the seizure, but in bringing action on the merits – and defray court costs.

Joseph Fometeu
Max Lambert Ndéma Elongué

E. OHADA Common Court of Justice and Arbitration – Intellectual property – Jurisdiction – National Supreme Court

The Common Court of Justice and Arbitration (CCJA) of the Organization for the Harmonization of Business Law in Africa (Organisation pour l'harmonisation en Afrique du droit des affaires, or OHADA) is not competent in principle to hear cases involving application of the Bangui Agreement and its annexes.

Infringement seizure under OAPI legislation is authorized by the president of a civil court, ruling as a motions judge, rather than by a judge for urgent applications.

PLAST-KIM V. OCI-PLAST, Decision No. 5/2007 of February 1, 2007, OHADA CCJA

Observations:

In this decision, the OHADA CCJA unequivocally declined jurisdiction for cases that raise intellectual property questions. And yet the issue has led to controversy among practitioners of intellectual property law – and sometimes contradictory decisions by courts of the same state. By way of illustration, the president of the Court of First Instance of the Centre Region (Yaoundé), ruling as an enforcement judge, affirmed its jurisdiction for a case concerning the withdrawal of an order for infringement seizure of a literary and artistic work, issued under articles 336 and 337 of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures.⁶⁴ By contrast, the president of the Court of First Instance of Ekounou in Yaoundé, faced with a similar case but in trademark matters, declined jurisdiction on the grounds that infringement seizure was regulated under ordinary law, not the OHADA Uniform Act.⁶⁵ In the present case, relating to the application of AB-1999, the Supreme Court of Côte d'Ivoire declined jurisdiction in favor of the CCJA.

Facts: The company PLAST-KIM, owner of a plastic container model registered with the African and Malagasy Office of Industrial Property (Office africain et malgache de propriété industrielle, or OAMPI),⁶⁶ learned that its sister company, Océan Ivoirien plastic (OCI-PLAST), was manufacturing and marketing plastic containers identical to its own. It sought and obtained an infringement seizure order from the president of the Abidjan Court of First Instance, ruling as judge for urgent applications.

Upon appeal by OCI-PLAST, the appeal court quashed the seizure order on the grounds that the judge for urgent applications was not competent to rule on articles 36 *et seq.* of annex IV to AB-1977, the provisions of which conferred that prerogative on the motions judge.

PLAST-KIM then appealed to the Supreme Court of Côte d'Ivoire, which declined competence in favor of the CCJA, noting questions raised about the OHADA Uniform Act relating to General Commercial Law. The CCJA also declined jurisdiction and sent the case back to the Supreme Court.

Reasoning: The CCJA's decision illustrates the prerogatives conferred on the president of a civil court in intellectual property matters (section I) and draws a line separating intellectual property law from matters under CCJA jurisdiction (section II).

64 See, e.g., *NGANDINGA Eric v. SCAAP*, Order No. 150/C of December 1, 2006, President of the Court of First Instance of the Center Region (Yaoundé).

65 See *Société P2MP SARL v. Société D. SARL*, Order No. 62 of March 18, 2008, President of the Court of First Instance of Ekounou (Yaoundé). Along the same lines, see *Bic SA v. TBC SA*, Decision No. 28 of January 28, 2008, Court of Appeal of Littoral (Douala) (obs. M.L. Ndéma Elongué, this collection, Chapter 1, section F).

66 The OAMPI was established on September 13, 1962, in Libreville. This agreement was revised in Bangui on March 2, 1977, after the withdrawal of Madagascar for the establishment of OAPI.

I. Competence of the civil court president in intellectual property matters

The 1999 revision of the Bangui Agreement (ABR-1999) recognizes the traditional prerogatives of a civil court's president in matters concerning the exercise of intellectual property rights. That text expressly recognizes the president's competence for orders on request – that is, acting as motions judge (A) – but does not mention the president's *ex officio* competence as judge for urgent applications, which has led to varying interpretations in practice (B).

A. Orders issued on request

The president of a civil court issues infringement seizure orders at the request of alleged victims and subject to documentation that varies depending on the intellectual property concerned.⁶⁷ Infringement seizure is an *ex-gratia* measure granted to the holder of the infringed right, or the holder's legal successors, for enforcement against an alleged infringer. It is subject, however, to the latter's right to seek review or withdrawal of the measure. In the case reported here, PLAST-KIM, whose model of container was allegedly infringed, obtained a seizure order from the Abidjan Court of First Instance, ruling as judge for urgent applications, in proceedings brought against OCI-PLAST.

Is a judge for urgent applications authorized to issue seizure orders for infringement? It would appear not, at least judging from a review of laws on judicial organization in almost all signatory countries under the Bangui Agreement, that prerogative generally being conferred on the president as motions judge. That was the crux of the argument made by OCI-PLAST in its successful appeal, adjudicated by appeal court Decision No. 696 of October 17, 2000. The argument seems reasonable since, according to the texts regulating infringement seizure in industrial property matters, the measure is subject to an order issued on request by the president of a civil court ruling as motions judge.

B. Orders issued by a judge for urgent applications

While not specified as such in the Bangui Agreement, case law allows the distrainee in an industrial property case to apply to a judge for urgent applications under ordinary law for either the withdrawal of the seizure order or its restriction to a few copies of the infringing items.⁶⁸ Not even the Agreement's latest version, ABR-2015, expressly allows distrainees to do so for infringement seizures⁶⁹ – unlike almost all domestic laws on copyright, which do allow for such restriction through

a judge for urgent applications.⁷⁰ That latitude, consistent with common law, can legitimately be extended to industrial property. That means reserving recourse to the judge for urgent applications for parties contesting a seizure as irregular – not those seeking the issuance of a seizure order. It is therefore surprising that PLAST-KIM proceeded as it did, particularly since recourse to a judge for urgent applications, unlike recourse to a motions judge, is a procedure *inter partes*, thus eliminating the element of surprise needed to be effective.

II. Exclusion of intellectual property matters from CCJA jurisdiction

According to the CCJA, contrary to the Supreme Court's pronouncements in quashing the seizure order, the issue was *not* application of the OHADA Uniform Act. The parties mainly based their arguments on AB-1977 and the Ivorian Code of Civil and Administrative Procedure. In other words, the CCJA, a supranational court, declined jurisdiction based on the nature of the case (A). The principle of excluding intellectual property matters from its jurisdiction, however, is not absolute (B).

A. Exclusion from CCJA jurisdiction based on the nature of the case

First of all, at no stage in litigating this dispute over plastic containers had the parties mentioned the OHADA Uniform Act as the Supreme Court did. In reality, the essential question submitted to the Supreme Court was whether a judge for urgent applications was empowered to order an infringement seizure under AB-1977. Or more specifically, did interim order No. 3119/2000, issued on April 21, 2000, by the president of the High Court of Abidjan, conform with the relevant provisions of articles 36 *et seq.* of annex IV to AB-1977, on industrial designs? Such a matter indisputably falls within the purview of intellectual property law. The CCJA was therefore right to decline jurisdiction and refer the case back to the Supreme Court. The exclusion of intellectual property matters from CCJA jurisdiction, however, is not absolute.

B. The relative exclusion of intellectual property matters from CCJA jurisdiction

To exclude the CCJA from the field of intellectual property litigation is a questionable proposition, particularly when a dispute over business law, although covered by the Treaty on the Harmonization of Business Law in Africa and its subsequent Acts, raises related intellectual property issues. That situation, already noted by one author,⁷¹ poses significant conflict-of-jurisdiction issues between the CCJA, as a supranational court for business matters, and the domestic courts that judge intellectual property cases under ordinary law within the OAPI community. The conflict is all the greater for the lack of

67 In ABR-1999, see art. 64(2) of annex I (on patents), art. 47(2) of annex II (on utility models) art. 48(2) of annex III (on trademarks), art. 31(2) of annex IV (on industrial designs), etc. ABR-2015 now gives jurisdiction to the president of the competent domestic court.

68 See *Bic SA v. TBC SA*, Decision No. 28 of January 28, 2008, Court of Appeal of Littoral (Douala) (obs. M.L. Ndéma Elongué, this collection, Chapter 1, section F); *SPN SA v. Société LM Co. Ltd.*, Order No. 189 of August 22, 2007, President of the Court of First Instance of Ndokoti (Douala); *Société P2MP SARL v. Société D. SARL*, Order No. 62 of March 18, 2008, President of the Court of First Instance of Ekounou (Yaoundé).

69 Revised to read "seizure for counterfeiting" in ABR-2015.

70 See, e.g., art. 86 of Cameroon's Law No. 2000/11 of December 19, 2000, relating to copyright and related rights; art. 133 of Senegal's Law No. 2008-09 of January 25, 2008, bearing on copyright and related rights; art. 101 of Burkina Faso's Law No. 32/99/AN of December 22, 1999, governing copyright and related rights.

71 See P. Menie M'essono (2013) *La protection juridictionnelle dans l'espace OAPI*. Chişinău: Editions Universitaires européennes, 103 *et seq.*

an OAPI court system, which makes the OHADA judge competent by default for OAPI legislation on certain issues.⁷² The statutory text of the CCJA, however, clearly indicates its jurisdiction for laws enacted by OHADA, an organization subject to its oversight.

The CCJA's jurisdiction for OHADA law has also been affirmed by the Court of Justice of the West African Economic and Monetary Union (WAEMU). According to that court's Opinion No. 1/2000 of February 2, 2000, on the draft community investment code, it would infringe on the exclusive jurisdiction of the CCJA if the court were to venture to interpret the OHADA Uniform Acts.⁷³ Might it be possible, in such a context, to do as recommended by P. Menie M'essono: to divide cases up so that each court hears only those matters falling within its jurisdiction?⁷⁴ But such a solution, says J. Yado Toe, could get legal systems into a "tangle difficult to unravel."⁷⁵ A court would then have to adjudicate only those aspects of a case within its purview, declining jurisdiction for others. Such complications illustrate the difficulty of seamlessly dividing jurisdiction between the CCJA and domestic courts in intellectual property matters.

The CCJA could also have occasion to review awards issued in intellectual property disputes arbitrated under its auspices, since the arbitrability of such disputes is expressly permitted by article 4(2) of ABR-2015: "Any dispute concerning the application of this Agreement and its annexes may be settled by arbitration or mediation." That position is also supported by African literature and case law on the subject.⁷⁶ As the arbitration and mediation center being established under ABR-2015 is not yet operational, disputes falling within the center's competence could quite feasibly be administered provisionally under CCJA auspices. Such difficulties, of course, are best ironed out through an inter-community judicial cooperation agreement.

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72 See L.Y. Ngombe (2013) OHADA versus OAPI, lecture transversale et partielle. *RAPI*, December, 31.

73 See Cour de Justice de l'UEMOA (2008) *Recueil des textes fondamentaux et de jurisprudence de la Cour*. Ouagadougou, 229, cited in D.C. Sossa (2011) Les conflits des juridictions communautaires et les mécanismes de coopération inter-juridictionnels. In OHADA Higher Regional School of Magistracy (ERSUMA), *Actes du Colloque sur le droit communautaire en Afrique sur le thème "De la concurrence à la cohabitation des droits communautaires."* Cotonou-Benin, January 24–26, 126 et seq.

74 See M'essono, n. 71.

75 See J. Yado Toe (2008) La problématique actuelle de l'harmonisation de droit des affaires par l'OHADA: Actes du Colloque sur l'harmonisation du droit OHADA des contrats- Ouagadougou 2007. *Rev. dr. unijf.*, 32, www.unidroit.org.

76 See F. Ekani (2012) L'arbitrage et la médiation dans le contentieux de la propriété intellectuelle: quel intérêt pour les États membres de l'OAPI ? La propriété intellectuelle au service du développement de l'Afrique. In *Mélanges offerts à Denis Ekani* (OAPI Collection No. 4), Paris: L'Harmattan, 173 et seq. See also *Linda-Communications v. MIC-Vidéo*, Decision No. 7/GCS.02 of May 17, 2002, Supreme Court of the Congo (obs. J. Fometeu, this collection, Chapter 1, section B).

F. Infringement seizure – Execution difficulties – Jurisdiction – Judge for disputes over enforcement – No application of article 49 of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures – National ordinary law – Judge for urgent applications – Trial judge

Jurisdiction for difficulties relating to the execution of an infringement seizure falls not to the judge indicated in article 49 of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures, but to the judge indicated under ordinary law.

BIC SA V. TBC SA, Decision No. 28 of January 28, 2008, Court of Appeal of Littoral (Douala)

Observations:

The execution of an infringement seizure may lead to multifaceted litigation raising both legal and practical questions. How to determine the judge competent to hear such cases is a problem frequently encountered. Is it the judge referenced in article 49 of the OHADA Uniform Act? Is it the trial court? Or perhaps the judge for urgent applications? It does not help that the Bangui Agreement provides no guidance on the matter, leaving room for different interpretations within the community. The decision of the appeal court reported here is unequivocal: difficulties in executing an infringement seizure are matters for the ordinary judge for urgent applications – not the judge described in the Act.

Facts: The facts of this case are relatively simple. The company Bic SA, owner of the eponymous trademark, registered with the OAPI under No. 10922 and affixed to the ballpoint pens it manufactures and markets, became aware that the company TBC SA was marketing pens identical to its own. Bic obtained a seizure of the pens by Order No. 1327 of July 5, 2006, issued by the president of the Court of First Instance of Bonanjo in Douala. TBC then petitioned the court's judge for urgent applications to cancel the seizure and order release of the seized pens. That judge granted TBC's request, disregarding a plea of incompetency *ratione materiae* made by Bic, arguing that the judge indicated for such enforcement matters in the OHADA Uniform Act was alone competent to rule on the matter.

On appeal, as reported here, the Littoral Court of Appeal quashed the seizure order and referred the case back to the judge for urgent applications.

Reasoning: The Court of Appeal of Littoral (Douala) was unambiguous on the question of the judge competent to hear enforcement difficulties relating to an infringement seizure (section I), yet barely mentioned the equally important matter of the role to be played by that judge (section II).

I. Jurisdiction for difficulties resulting from the execution of an infringement seizure

Several difficulties may arise in enforcing an infringement seizure. The bailiff may face resistance from the distrainee (who may lock up premises or refuse to produce requested documents) or encounter a technical difficulty requiring skilled assistance. The distrainee may also request withdrawal of the seizure order, annulment of the attachment report and even restriction of the objects seized. Which court is competent to address such difficulties and disputes? In a general sense, the annexes relating to industrial property under ABR-1999, in force when the appeal court rendered its decision, empower the president of the civil court to authorize infringement seizures. But the annexes are silent as to jurisdiction for difficulties arising in execution of the measure. Theoretically, one of three courts could be involved depending on the measure: the motions judge (A), the judge for urgent applications (B) or the trial judge (C).

A. The motions judge

Some of the difficulties arising from the execution of an infringement seizure can be ironed out by the same motions judge who ordered it. Nothing prohibits a bailiff from suspending seizure operations⁷⁷ and requesting authority for additional measures not included in the order but proving necessary during the operation (a locksmith, if premises are locked; a chartered accountant, if a distrainee's books must be examined to determine the extent of infringement; an IT engineer, etc.). French case law also allows a bailiff to search for accounting information, even *ex officio*, with no opposition possible from the court president.⁷⁸ Be that as it may, recourse to the motions judge is bound to be exceptional: a clause included in seizure orders generally indicates the judge for urgent applications.

B. The judge for urgent applications

Bic disputed the competence of the judge for urgent applications, arguing that the courts competent under ABR-1999 were those called upon to judge the merits of an infringement case. Use of the plural form "courts," as appears in the Agreement, refers to civil and criminal jurisdictions. Bic argued further that, the Bangui Agreement being silent on the point, the competent authority to rule on difficulties relating to execution of an infringement seizure, as a protective measure, was the judge indicated in article 49 of the OHADA Uniform Act in question: the president of the court sitting in the course of urgent proceedings. The first part of Bic's argument, however, reflects an imperfect reading of articles 47(1) and 49 of annex III to ABR-1999.

Article 47(1) requires that civil actions relating to marks be brought before the civil courts and judged

77 P. Veron (2005) *Saisie-contrefaçon*, 2nd edn. Paris: Dalloz, 61, No. 13.251. The author insightfully points out that expiration of a seizure order is not an obstacle to the suspension of seizure operations where necessary to fully execute the order.

78 See CA Paris, July 8, 1993, *PIBD* 1993, No. 555, III, 673; TGI Paris, 3ème mech., June 30, 1994, *PIBD* 1994, No. 576, III, 527.

as summary proceedings.⁷⁹ Article 49 provides that "should the complainant fail to take action under either civil or criminal law within a period of 10 working days, the inventory or seizure shall become void as of right, without prejudice to any damages that may be claimed." Now, reference to the terms, "courts," "civil law" and "criminal law" does not signify the OAPI legislator's intent to bar the ordinary judge for urgent applications from involvement in intellectual property enforcement.⁸⁰ That is the court designated as competent for such enforcement by virtually all national laws on copyright and related rights.

It should be remembered, however, that an infringement seizure results from an order on request and remains subject to the general regime for such orders. That regime, in the silence of intellectual property law, must therefore apply *mutatis mutandis* to infringement seizures.⁸¹ That solution is all the more justified in that, as a virtually systematic practice, judges insert reserve clauses in infringement seizure orders indicating the urgent applications process. The appeal court in this case rightly observed that "the OHADA Treaty does not regulate infringement seizures, which therefore remain subject to the provisions of ordinary law," and accordingly that "only the judge for urgent applications under ordinary law, per article 182 of the Code of Civil and Commercial Procedure, remains competent for summary proceedings on difficulties arising from the execution of such seizures." The competence of the judge for urgent applications thus appears clear, as also accepted in case law – even after infringement proceedings are referred to the appropriate trial court.

It could be objected that after the seizure has been executed and the merits referred to the trial court, the latter could deal with it all, including any dispute arising from execution. But the objection does not hold up: the judge presiding in the urgent proceedings may be validly requested to amend or withdraw the measure, having been ordered *ex gratia*. Along the same lines, a judge's power to amend or withdraw their order even if a trial court has been seized on the merits is acknowledged in article 497 of the French Code of Civil Procedure. The French Court of Cassation has censured an appeal court based on that provision. The appeal court concerned had denied a request for such withdrawal – because the ground cited for the request, nullity, was subject to the trial court's competence – without investigating whether the legal requirements for carrying out an infringement seizure had been satisfied.⁸²

79 Article 46(1) of the version revised subsequently (ABR-2015) clarified the matter by requiring other civil action concerning marks to be brought before "the competent domestic courts and heard as for summary matters." That new guideline is also included for patents, utility models, industrial designs and so on.

80 See art. 86 of Cameroon's Law No. 2000/11 of December 19, 2000, relating to copyright and related rights; art. 133 of Senegal's Law No. 2008-09 of January 25, 2008, governing copyright and related rights.

81 See *PMUC v. Alfred Meno*, Interim order No. 301/C of February 19, 2007, President of the Court of First Instance of the Center Region (Yaoundé) (obs. M.L. Ndéma Elongué, this collection, Chapter 4, section E).

82 See Cass. 2ème civ., July 9, 1997, No. 95-12.580, *Bull. civ.* 1997, II, No. 231, cited by P. Veron (2013/14) *Saisie-contrefaçon*, 3rd edn. Paris: Dalloz, 148, No. 151.62.

C. The trial judge

Trial judges also have occasion to deal with incidents arising from infringement seizure. In Cameroon, the Judicial Organization Act⁸³ gives jurisdiction for such incidents to courts of first instance or high courts, depending on the amount claimed.⁸⁴ Those matters are clearly side issues, however, and it is hard to imagine instigating trial proceedings for that purpose *per se*. Alleged infringers often raise such disputes as part of their defense in an ongoing infringement trial – contesting the validity of the attachment report for instance, or, to a lesser extent, making counterclaims of unreasonable seizure, particularly when the procedure exceeds its exclusively probative purpose.⁸⁵ In short, both the judge for urgent applications and the trial court, each within its respective purview, may deal with incidents arising from the execution of infringement seizures. Their respective fields of intervention must be marked out carefully, however, bearing in mind the natural limits placed on a judge for urgent applications where substantive matters are concerned.

II. Role of the judge competent for difficulties arising from the execution of infringement seizures

As is clear from the foregoing, more than one judge may be competent for execution-related difficulties arising from infringement seizure. Setting apart the motions judge, whose involvement is more theoretical than real, execution-related difficulties concern, chiefly, the judge for urgent applications (A) and, secondarily, the trial judge (B).

A. The judge for urgent applications: withdrawal or amendment of the seizure order

While not being expressly provided for in annex III to ABR-1999, the distrainee in an infringement seizure is given the option of seeking withdrawal or amendment of the seizure order in urgent proceedings. Withdrawal is possible only if the distrainee can demonstrate that the conditions for authorizing the infringement seizure had not been met. In this case, TBC could have petitioned the judge to withdraw the seizure order by invoking, for example, the complainant's failure to provide a registration certificate, or a certificate of non-cancellation and non-forfeiture, proving the complainant's ownership of the mark. In a decision on January 6, 1932, the Paris Court of Appeal withdrew an infringement seizure order issued to a distrainer not certified as owner of the property concerned.⁸⁶ In addition, an alleged infringer is perfectly entitled to request amendment of the order. This could include the placement of restrictions on a seizure liable to immobilize an entire stock or large quantity of allegedly infringing goods.⁸⁷

Overall, an infringement seizure order can be withdrawn only if originating under irregular conditions or authorizing excessive measures. Consequently, the role of the judge for urgent applications is limited to reviewing the conditions and extent specified for an infringement seizure order when granted.⁸⁸ Fortunately, case law has clarified that a judge for urgent applications petitioned to withdraw an order is invested with powers limited to those of the order's author.⁸⁹ Accordingly, the judge for urgent applications can rule neither on the validity of seizure operations nor on the corresponding report. It therefore appears inappropriate in this case for such a judge to have issued the interim order concerned, No. 509 of September 20, 2006, cancelling the infringement seizure. It is well established in this case that the judge for urgent applications lacked competence for that purpose. Case law has more generally ruled out that judge's competence for complaints over the execution of an infringement seizure.⁹⁰ The judge for urgent applications in this case, the Court of First Instance of Bonanjo in Douala, should have declined jurisdiction for voiding the infringement seizure, as falling naturally to the trial judge.

B. The role of the trial judge in voiding the attachment report

A civil or criminal trial judge can void an infringement seizure order for at least two reasons: irregularities committed by a bailiff during execution of the seizure, as discussed earlier; or failure by the distrainer to take civil or criminal action within 10 working days, as stipulated in article 49 of annex III to ABR-1999. The corresponding attachment report may be voided based on an invalid trademark registration certificate (a requisite for the seizure order), withdrawal of the order, misuse of the seizure procedure or, as in the present case, irregularities tainting the report itself.⁹¹ This solution seems logical: if the order authorizing the infringement seizure is voided, the seizure carried out pursuant to that order becomes void as of right also. In an interesting copyright case, the court ruled that, in the absence of any material evidence of infringement, a distrainer cannot have statements taken from the distrainee.⁹² The same solution can be transposed *mutatis mutandis* to industrial property matters.

In the present case, the first judge voided the infringement seizure on the grounds that the corresponding report did not include the identity of the bailiff – an omission he said tainted the report and the entire procedure. Setting aside whether the judge for urgent applications was competent to hear the matter (that was the trial judge's job, in our view), the grievance against the attachment report failing to identify the bailiff raises a number of questions. According to Bic, the first page of the report was stamped with the bailiff's name, Victor Tekeu, and the last page bore the

83 Law No. 2006/15 of December 29, 2006, as amended.

84 See art. 13 *et seq.* or Law No. 2006/15 of December 29, 2006.

85 Veron, n. 82, at 157, No. 152.30.

86 See CA Paris, January 6, 1932, *Ann. propr. ind.* 1932, 291 (note Fernand-Jacq).

87 See *Ameropa SA v. Mustapha Tall SA*, Judgment No. 501 of December 28, 2012, Court of Appeal of Dakar (obs. M. Lamotte, this collection, Chapter 3, section K).

88 Veron, n. 82, at 148, No. 151.71.

89 Com., June 9, 2009, Nos. 8–12. 139, NP, cited in Veron, n. 82.

90 Douai, First Chamber, February 4, 2002, *PIBD* 2002, No. 741, III, 206.

91 See, e.g., TGI Paris, Third Chamber, February 18, 2011, *PIBD* 2011, No. 941, III, 406.

92 See CA Paris, Fourth Chamber, October 7, 1998, *PIBD* 1999, No. 667, III, 16.

state seal and showed the ministerial officer's surname, first name, position, post office box, telephone number and signature. It is therefore surprising that the judge for urgent applications upheld the grievance – despite the relevance of Bic's argument and the fact that no law prescribes how a bailiff's identity must appear on a ministry's documents. The texts guiding a bailiff for the purposes of executing an infringement seizure are the statute of judicial officers and the Code of Civil Procedure of the state concerned.

French lower courts have occasionally been flexible on the matter, recognizing an attachment report's validity if the bailiff's name can be determined from the signature.⁹³ But the Court of Cassation has been stricter, refusing, for instance, to overturn an appeal court's annulment of an attachment report bearing the name of the bailiff's office only.⁹⁴ Ultimately, the attachment report represents an act of bailiff subject to general rules established in the codes of civil procedure of OAPI member states.

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93 See, e.g., TGI Paris, Third Chamber, March 12, 1997, *PIBD* 1997, No. 636, III, 391; TGI Paris, 14th Chamber, January 16, 1998, *PIBD* 1998, No. 653, III, 240.

94 See Cass. com., October 20, 1998, No. 673, *PIBD* 1999, III, 131.





Chapter 2

Patents

A. Patents – Conditions for validity – Novelty – Prior personal possession – Good faith

It is a misapplication of the law for an appeal court to confirm the novelty of a process patent on the grounds of there being no similar process already without first conducting a search for prior art.

The owner of a process patent may not prohibit a competitor from using the same process if found to be doing so in good faith prior to the grant of the patent asserted.

AL ITIHAD COOPERATIVE V. A.A., Decision No. 170 of August 7, 2006, Court of Appeal of Niamey

Observations:

The decision handed down by the Niamey Court of Appeal, in an area where few judicial precedents have been established in OAPI member states, illustrates how intellectual property litigation is diversifying in that region.

Facts: The facts of the case are simple, but they pose some complex legal issues. The dispute concerned two competing cooperatives producing *pain de sucre* (sugarloaf). On February 16, 2001, the Al Itihad cooperative obtained a license to operate in Niger. Three years later, the Tchékassane cooperative, claiming identity as the originator of the sugarloaf production process, requested and obtained authorization for an infringement seizure against Al Itihad. Al Itihad had the seizure order withdrawn and sued Tchékassane for vexatious proceedings and related damages. For unknown reasons, those proceedings were discontinued, bringing the first episode of this judicial saga to a close.

On April 12, 2002, Mr. A.A., a member of the Tchékassane cooperative, applied to the OAPI to patent the sugarloaf production process. He was granted the patent on October 7, 2003. Informed of that fact, Al Itihad brought proceedings against A.A. in a Niamey civil court to uphold its right to use the process, invalidate the patent and remove all related entries from the organization's registers. Instead, the civil court validated the patent and prohibited further use of the process by Al Itihad. The latter appealed to the Niamey Court of Appeal for the decision reported here.

The questions of law put to the appeal court were two: was the sugarloaf production process – to which both cooperatives laid claim – patentable? If so, were

Al Itihad and its members entitled to invoke prior personal possession?

Reasoning: In answering, the appeal court partially reversed the decision of the civil court, so that A.A., although undisputed owner of the patent, could not prevent Al Itihad and its members from using the invention. The decision is correct, but its legal grounding seems incomplete, with regard to:

- I. the patentability of the claimed invention; and
- II. the recognition of prior personal possession.

I. Patentability of the claimed invention

Addressing the central question of the patentability of the sugarloaf production process, the appeal court confirmed the novelty and, consequently, the validity of this invention (A), as the applicant for invalidation did not provide proof of lack of novelty (B).

A. The notion of novelty

The answer to the legal question posed depends on mastering the contours of the concept of novelty in patent law. In this regard, it is important to refer to the provisions of article 2(1) of ABR-1999, which define the criteria for the patentability of an invention. According to this article, an invention is patentable when it is new, when it involves an inventive step, and when it may be industrially applicable. The invention can consist of or relate to a product, a process or a use thereof. These three criteria substantially condition the access of a patent to legal protection and must all be met.¹ In the case commented on here, the only criterion submitted to the appreciation of the appeal court was the novelty. Indeed, the applicant, Al Itihad, contested the novelty of the sugarloaf production process, which was the subject of the patent granted by OAPI to the benefit of A.A.

An invention is considered new if it has not been anticipated by prior art.² Thus perceived, the novelty giving rise to legal protection is absolute. With regard to the process of producing sugarloaf, this supposes that the main aspects of this invention did not exist in the prior art from which it stems. Theoretically, to conclude

1 See to this effect A. Chavanne and J.-J. Burst (1990) *Droit de la propriété industrielle*, 3rd edition, Paris: Dalloz, 28 *et seq.* See also J. Schmidt-Szalewski and J.-L. Pierre (2007) *Droit de la propriété industrielle*, 4th edition, Paris: Litec, 37 *et seq.*

2 Article 3 of annex 1 of ABR-1999 states that an invention is new if it has not been anticipated by prior art consisting of everything made available to the public before the filing date either of the patent application or of a patent application filed abroad, the priority of which has been validly claimed. This article is maintained *in extenso* in ABR-2015.

that an invention is new, the competent authorities of the industrial property office investigate to determine whether any prior art genuinely exists.³ Of course, the contested issue in this case benefited from presumption of novelty because it was the subject of a patent granted by OAPI on October 7, 2003. However, this presumption can be put into question, as it can be challenged before the competent jurisdictional bodies. This is especially the case because – under the system established by ABR-1999 under which the present decision was handed down – OAPI did not carry out substantive examination of the conditions of patentability, but only examination of the formal regularity of the application.⁴ However, the entry into force of ABR-2015 has substantially changed the legal order concerning examination of patent applications within OAPI.⁵ Indeed, confirmation of novelty now requires in-depth examination in order to ascertain whether the process in question cannot be found in prior art in its entirety.⁶ In any event, it should be emphasized that, once the patent has been granted, the invention to which it corresponds enjoys – whatever the situation – presumption of novelty that could be called into question during invalidation litigations.

B. Proving lack of novelty

The question of proving lack of novelty has two aspects that have fueled proceedings before appeal courts.

The first relates to who has the burden of proving lack of novelty: The owner? The applicant for invalidation of the patent? Al Itihad criticized the initial judge for having placed the burden of proof on it rather than on the inventor, by referring to the provisions of article 43 of the TRIPS Agreement. However, these seem clearly irrelevant, as providing proof in this matter is governed by common law. Indeed, doctrine and jurisprudence agree that, when a patent is granted by the industrial property office, its validity may be affected only if the applicant for invalidation provides proof that the right does not satisfy a particular condition of validity, the patent being presumed to be valid.⁷ Moreover, this approach seems logical because, when the dispute is based on the question of novelty, as in the present

case, the invalidation applicant seeks to disprove the novelty by demonstrating that the contested invention is included in prior art, i.e., that it was available to the public before the filing date of the application or the priority date. It was therefore not up to the right holder, as Al Itihad wrongly claimed, to prove that the patent was valid, even though it is true that the latter could have brought up the unsuitability of the means invoked to challenge the presumed novelty of its invention.

The second aspect is inherent to the way in which proof is provided: How can lack of novelty of an invention be proved? In reality, proof of lack of novelty comes down to demonstration by the invalidation applicant of prior art likely to affect the novelty of the claimed invention. In other words, the party invoking lack of novelty is required to submit, to the exclusive jurisdiction of the judge, the relevant elements of the prior art that constitute “the basis of comparison reference by which the compliance of the invention with the legal requirement shall be verified.”⁸ It is precisely this major obstacle that was encountered by Al Itihad, which, before the judges who had successively dealt with this dispute, limited itself to making assertions without being able to establish the reality of the prior art it claimed, namely its sugarloaf production process. In the absence of this decisive proof, the application for invalidation of the patent granted to A.A. was naturally doomed to failure. In this respect alone, the decision commented on here is in accordance with positive law. It is also in line with Paris Court of Appeal jurisprudence, which has consistently held i) that an applicant cannot simply allege that a patent is invalid without providing any proof⁹ and ii) that prior art can disprove the novelty of an invention only if there is no doubt as to both its content and its date.¹⁰

Moreover, in another case, the court was able to rule that the existence of doubt as to the validity of the patent, in particular because of a lack of certainty as to the date, content or scope of a prior art claimed by the invalidation applicant, precludes invalidation of the patent and thus benefits the right holder.¹¹ The Niamey Court of Appeal was therefore right to point out that “Whereas the Al Itihad cooperative does not present to the proceedings its technique of sugarloaf production ... in the absence of this element of comparison, the court cannot deny that A.A. made a new invention.” The solution thus reached should naturally have an impact on the issue of the legality of granting the benefit or prior personal possession exception to the above-mentioned enterprise.

II. Prior personal possession exception

The prior personal possession exception, still referred to by the generic term “exception regarding prior

3 Art. 3(3) of annex I of ABR-1999 stipulates the conditions under which the novelty cannot be denied, in particular if, within a period of 12 months preceding the day referred to in para. 2, the invention has been disclosed as a result of an obvious abuse of the applicant or its author. ABR-2015 omits the ambiguous expression “predecessor in title” and replaces it with “its author.”

4 The scope of the examination of the patent application varies from one office to another. Traditionally, two approaches are possible. The first is based on a thorough examination of the application, which consists, after an examination of the formal regularity, in a search for prior art that would deny the novelty or that may affect the inventive step. The second, enshrined in ABR-1999, gives priority to examination of the formal regularity of the request and leads to the quasi-automatic grant of patents, subject to possible rejection in the event that the invention is contrary to public order.

5 Art. 23 of ABR-2015 now establishes a substantive examination of the conditions of patentability, with the subsequent search report having to establish the substantive criteria of patentability in addition to the formal requirements. This is a major innovation that bolsters the credibility of OAPI-granted patents.

6 On this issue, see I. Cissoko, “Les dangers de la divulgation de l’invention, la perte de la nouveauté,” *Revue africaine de la propriété intellectuelle*, Collection OAPI, October 2008, 25 *et seq.*

7 J. Passa, *Droit de la propriété industrielle*, Vol. 2, LGDJ 2013, 453. See, to the same effect, J. Raynard *et al.*, *Droit de la propriété industrielle*, Lexis Nexis, Paris, 66 *et seq.*

8 J. Raynard *et al.*, n. 7.

9 CA Paris, Oct. 12, 2001, PIBD 2002, No. 733, I.

10 CA Paris, Feb. 9, 2001, PIBD 2001, No. 725, III, 389.

11 CA Paris, Nov. 29, 1995, PIBD 1996 No. 605, III, 89; CA Paris, May 28, 1999, PIBD 1999, No. 687, III, 501. See, to the same effect: Cass. com, May 18, 1999, Pourvoi No. 97 – 17461, PIBD 1999, No. 686, III, 473.



use,”¹² is provided in annex I, article 8(1) (d) of ABR-1999.¹³ Historically, prior personal possession is perceived as a corrective to the first-to-file rule in that it favors the first non-applicant inventor by conferring on them, under certain conditions, a right of exploitation over the invention that is the subject of a subsequent patent issued to a third party. Under patent law, a person is entitled to invoke objection of prior personal possession of an invention when, without having patented it, they have secretly held it since a date prior to the filing, by a third party, of an application relating to the same invention.¹⁴ The purpose of this exception is to strike a fair balance between the interests of the patent owner and those of the prior user who may have invested economic, physical and intellectual resources in the use of the patented invention. Al Itihad’s accessory claim, which received a favorable response from the appeal court, is part of this dynamic. However, the approach of these judges is questionable in terms of both the conditions for granting this preferential measure (A) and the effects attached to it (B).

A. The conditions for the prior personal possession exception

To invoke the prior personal possession exception, the applicant must prove their possession of the claimed invention (1) and their good faith (2).

1. Possession of the claimed invention

The benefit of the prior personal possession exception is subject to the applicant providing proof of actual possession of the claimed invention prior to the filing date of the application or the priority date. Such a condition is required because possession of a technology resulting from an inventive step cannot be reasonably claimed if one is unaware of its contents. Jurisprudence calls for the applicant to invoke the identity of the possession, the technique covered by the patent, and their full knowledge of all the elements constituting the invention subject of the patent before its filing date.¹⁵

The question of who has the burden of proof is governed by common law, and possession is a legal fact, the proof of which must be provided by the person who has invoked it. In the present case, such proof does not seem to have been formally provided, as Al Itihad limited itself to alleging prior possession without presenting its sugarloaf production process or any other relevant element. Consequently, it was not possible for the court

to verify whether the alleged possession corresponded to the invention covered by the patented issued to A.A. Furthermore, Al Itihad did not offer to prove that it had full knowledge of the sugarloaf production technique officially attributed to A.A. This fundamental requirement is reaffirmed by specialized doctrine. In their previously mentioned book, A. Chavanne and J.-J. Burst emphasize that the possessor can validly oppose the right of the patent owner to exploit the patent only if the possession relates to the very technique covered by the patent, if it has remained secret and if it was invented prior to the date of filing or priority of the patent. Under these circumstances, there is legitimate doubt as to the relevance of the reasons that led the judges to give full effect to an unestablished possession.

2. The possessor’s good faith

Good faith plays a central role in granting the benefit of the prior personal possession exception, in that its absence allows for the exclusion from the circle of beneficiaries of any person who can justify possession fulfilling the characteristics of certainty and identity but whose knowledge of the patented invention was acquired illegitimately, i.e., by fraud, theft of information or violation of an obligation of confidentiality. The question of the good faith of the prior possessor could be approached from two angles, as the possessor could have made the invention themselves or simply received it from the initial inventor.

In the first approach, the prior personal possession exception fully fulfills its historical purpose, which is to protect the interests of the initial inventor who had not filed a patent on their invention but who exploited it before the date of filing of the same invention by a third party. It was probably under these circumstances that Al Itihad claimed to produce the sugarloaf “since its creation in 2001, according to techniques proven since the dawn of time,” thus claiming its prior possession in relation to the date of filing of the patent by A.A., which was April 12, 2001. It should be pointed out that Al Itihad received approval on February 16, 2001, a date which would correspond to that of the start of exploitation of the disputed process, especially if we keep in mind the previous conflict having opposed the two competing cooperatives with regard to the same invention. The question that could be asked at this stage is whether this alleged prior possession was made in good faith. The appeal court answered in the affirmative, in accordance with article 8 of ABR-1999, but without the proof of good faith having been formally provided by Al Itihad. Such an approach is open to criticism in that it could suggest a broad interpretation of this legal provision, which would then enshrine a presumption of good faith in favor of the prior possessor who claims to have made the invention.

In the second approach, the exception benefits those who, without having performed the inventive step, have legitimately benefited from the information communicated by their author. Here the crucial question is linked to the legitimate character of the possession of information by this category of persons,

12 This exception is enshrined in several legal systems under various names. The generic term “exception regarding prior use” is the one used within WIPO. For more information on this issue, see the results of the 32nd session of the Standing Committee on the Law of Patents available at: https://www.wipo.int/edocs/mdocs/scp/en/scp_32/scp_32_3.pdf.

13 According to this provision, “The rights deriving from the patent shall not extend: to acts performed by any person who in good faith on the filing date, or where priority is claimed, on the priority date of the application on the basis of which the patent is granted on the territory of a member state, was using the invention or making effective and genuine preparations for such use, insofar as those acts are not different in nature or purpose from the actual or planned earlier use.”

14 A. Chavanne and J.-J. Burst, n.1, 282 *et seq.*

15 CA Paris, January 11, 2006, PIBD 2006, 825, III B-155; TGI Paris, September 4, 2001, PIBD 2002, 739, III, 156.

who could be the heirs of the initial inventor or their successors in title. It is this orientation that A.A. wanted to give to the proceedings, by evoking the hardly orthodox conditions in which Al Itihad would have had knowledge of the contested sugarloaf production process, in particular by the intermediary of his ex-employees hired away by it. This phenomenon, which is moreover similar to a classic case of unfair competition,¹⁶ is very common in the business world when it comes to companies in the same sector of activity, in this case the production of sugarloaf. Logically, the benefit of personal prior possession exception should be excluded in this case because of the employment relationship that would have existed between A.A. and his former employees. In a similar case, the Paris Court of Appeal rejected exception due to lack of good faith on the grounds that the possessors' knowledge of the aspects of the know-how resulted from a licensing agreement with the subsequent patentee, thereby imposing an obligation of confidentiality.

B. Effects of the prior personal possession exception

Prior personal possession exception gives the beneficiary the right to exploit the invention (1). However, this right of exploitation is limited in scope (2).

1. The right to exploit the invention

Prior personal possession has the effect of giving the owner the right to exploit the invention despite the existence of a patent registered by a third party. It thus allows its beneficiary to enter into the sphere of protection of the patent owner without the latter being able to oppose their exclusive right. The decision commented on here illustrates the implementation of this exception to the exclusive right of the patentee enshrined in article 8 of ABR-1999. The appeal court held that A.A. cannot prohibit the Al Itihad cooperative and its members from operating its sugarloaf production process despite the patent he claimed.

On analysis, recognition of Al Itihad's right to exploitation seems debatable, at least if we consider the objections previously formulated on the reality of the possession it alleged, which should logically lead to the exclusion of this favorable measure. Extension of this right to the members of the cooperative seems equally problematic for two basic reasons. The first is related to the status of the individuals benefiting from the exception. Indeed, the members of the cooperative, taken individually, are physical persons distinct from the cooperative to which they belong, which has its own legal personality. The second relates to the personal nature of the right of exploitation, which is in principle non-transferable, the beneficiary not being entitled to assign it or to grant licenses to third parties.¹⁷ ABR-1999 moreover provides a framework for the transfer of these exceptional prerogatives in annex 1 article 8(2), which states: "The right of the user referred to in paragraph (1)(d) may not

be transferred or handed on otherwise than with the business or company or the part thereof in which the use or the preparations for use were made."

2. A limited right of exploitation

The right to exploit the invention that is the subject of a subsequent patent and granted exceptionally to the prior possessor has a limited scope, as the acts of exploitation relating to it are strictly circumscribed by law, which excludes certain acts from the scope of the exception. Article 8(1) (d) of the aforementioned annex I to ABR-1999, under which the decision commented on here was handed down, states that prior personal possession is applicable only insofar as the acts do not differ in nature or purpose from the actual or planned earlier use. Under this legal provision, the beneficiary of the prior personal possession exception can exploit the patented invention only i) insofar as the beneficiary had been using it and ii) as the invention was used, prior to the date at which the patent holder filed their application, with no possibility of new uses.

Although the question was not formally raised in this case, it is important to mention it in order to highlight the developments following the recent revision of ABR-1999. Indeed, annex 1 of article 7(e) of ABR-2015 stipulates the following: "The rights conferred by the patent shall not extend to the following: (e) acts performed by any person who in good faith on the filing date or, where priority is claimed, on the priority date of the application on the basis of which the patent is granted on the territory of a Member State, was in possession of the invention." This new orientation appears to be more liberal in that it offers the prior possessor a wide margin of maneuver in the exploitation of the patented invention, subject to the prohibition on transferring their rights to third parties without their company.

Max Lambert Ndéma Elongué

¹⁶ See art. 7 of annex VIII of AB-2015, which deals with unfair competition through the disorganization of a competing enterprise.

¹⁷ See on the character of personal possession, J. Schmidt-Szalewski and J.-L. Pierre, n. 1, 37 *et seq.*



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Chapter 3

Trademarks

A. Trademarks – Opposition to registration of a later trademark – Pharmaceutical products – High degree of consumer attention – No high likelihood of confusion

Consumers pay close attention to pharmaceutical products, thereby precluding any likelihood of confusion between the trademarks “BRONCHOKOD” and “BRONCHOBOS,” in which the prefix “BRONCHO” is merely an indicator of the therapeutic target of the products used in treating respiratory and bronchial diseases.

BOSNALIJEK PHARMACEUTICAL AND CHEMICAL INDUSTRY CO. V. SANOFI-AVENTIS SA, Decision No. 157 of April 26, 2012, OAPI High Commission of Appeal

Observations:

Likelihood of confusion plays a key role in trademark law. It is this likelihood that shapes the framework for protection in cases other than those in which identical signs refer to identical goods or services.¹ Under the heading “Rights conferred by the registration,” article 6(3) of annex III to ABR-2015 prohibits “(a) the reproduction, use or affixing of a mark and the use of a reproduced mark for goods or services that are similar to those designated in the registration” and “(b) the imitation of a mark and the use of an imitated mark for goods or services that are identical or similar to those designated in the registration.” However, the article starts by setting out the condition “if they are liable to create confusion in public perception.” That condition is found in article 3(b), under which the registration of a mark that “resembles such [an earlier] mark that it is liable to mislead or confuse” is prohibited. It follows that “the conditions upon which precedence is based, and consequently the conditions for opposition or seeking invalidation of the second mark, are identical to those for the infringement action.”²

Facts: The dispute in this case, arising from an opposition, helps to better delineate the concept of “average consumer” that lies at the heart of “likelihood of confusion.” The company Sanofi-Aventis France, owner of the “BRONCHOKOD” mark, registered under class 5 in 1989, filed an opposition to registration of a mark called “BRONCHOBOS” for products of the same class,

filed in 2008 by Bosnalijek Pharmaceutical and Chemical Industry. The OAPI Director General dismissed the opposition on the ground that the marks of both owners could coexist without any likelihood of confusion. Sanofi-Aventis France took the matter to the High Commission of Appeal, claiming a conceptual, visual and aural similarity between the two name and word marks.

Reasoning: The High Commission, in the decision reported here, also dismissed the opposition, reasoning that likelihood of confusion should be assessed with reference to the “average” consumer, which it defined as “a literate person able to notice true differences with a level of discernment so qualified within the OAPI space.” Such a consumer is all the more capable of distinguishing between the marks at issue, the Commission reasoned, because they designated “pharmaceutical products known to the medical community and dispensed on the advice of a doctor or pharmacist.” The prefix “BRONCHO,” it said, “merely indicates the therapeutic target of the products used to treat respiratory and bronchial pathologies,” and is “descriptive and falls within the common domain.” It is indeed generally accepted that “if a mark is made from a radical listed in the dictionary or from a term that is hardly distinctive given the many marks incorporating it, the protection provided by the mark is more limited.” There could be no valid basis for the plaintiff’s claim in the present case since the radicals “KOD” and “BOS” that had been added to the prefix “BRONCHO” sound very different and could not be confused. The Commission thus found “no similarity between the two marks or likelihood of confusion for the consumer of an average attention level.”

There are some minor flaws in this reasoning. For example, it is surprising to see an “average consumer” or “consumer of an average attention level” characterized as “a literate person,” possibly suggesting a consumer of “literature,” which hardly need be the case. What, for that matter, did the Commission mean by a consumer with “a level of discernment so qualified within the OAPI space”? Nor is it clear why it was worth mentioning a “proliferation of class 5 marks in the market”: the entire pharmaceutical market was not at issue in the case; only the market for respiratory illness products. And a finding of “no similarity” between the marks in conflict is perhaps excessive. “Average similarity” – an expression often found in European case law³ – or “slight similarity” would have been more precise.

1 J. Raynard, E. Py and P. Trefigny (2016) *Droit de la propriété industrielle*. Paris: LexisNexis, Nos. 457–461.

2 S. Durrande (2010) *JurisClasseur Marques – Dessins et modèles*, Fasc. 7110, No. 15. See, in this regard before the CJEU, C-291/00 *LJ Diffusion SA v. Sadas Vertbaudet SA*, Judgment of March 20, 2003, ECLI:EU:C:2003:169, at 41.

3 For instance, in a case to be discussed later, T266/17 *Kwizda Holding v. EUIPO – Dermapharm (UROAKUT)*, Judgment of the General Court (First Chamber) of September 20 2018, ECLI:EU:T:2018:569, at [56].

In other regards, the High Commission's reasoning in the case was persuasive. It was right to assess likelihood of confusion with reference to an average consumer. It was right too to link the earlier mark's scope of protection to its more-or-less distinctive character and to find such protection more limited in the present case, the "BRONCHO" prefix in question being commonly used for medicinal products.⁴ Finally, and most importantly, the Commission was right to consider the level of consumer attention as varying according to the nature of a trademarked product and higher for pharmaceutical products. While it also helpfully observed that such products are "known to the medical community and dispensed on the advice of a doctor or pharmacist," it might have been useful to more clearly identify the consumer targeted. The General Court of the European Union, for example, has observed that "when the goods in question are medicines or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as the end consumers, on the other."⁵ That court's case law has characterized medical professionals as necessarily displaying "a high level of attentiveness" and consumers or patients themselves as "reasonably well informed and reasonably observant and prudent given the effect of these products on their health," whether they are prescribed or not.⁶

The High Commission's conclusion of "no similarity" may seem extreme considering that the word marks were each composed of ten letters and three syllables, and that eight of the letters in use were the same, and appeared in the same order, in each. Be that as it may, the Commission drew its conclusion from the principles applicable.

Its decision bears comparison with two General Court judgments concerning pharmaceutical product trademarks, each dismissing an opposition despite similarities between the signs at issue. In the *Kwizda* case already alluded to, the disputed mark was the word sign "UROAKUT." It had been filed under class 5 products, described as "dietary supplements and dietetic preparations; medical and veterinary preparations and articles." Its registration was opposed by the owner of the figurative mark "UroCys," designating "dietetic substances and food supplements adapted for medical use other than for treating or preventing gout." After carefully analyzing the similarity between the two marks, the General Court concluded that "the visual, aural and conceptual differences relating to the additional components 'akut' and 'cys' of the signs at issue were not insignificant in the overall impression of the signs for the relevant public" and "offset the visual, aural and conceptual similarities, which arise purely from the presence of the common component 'uro' and the idea to which it refers, especially given that the relevant

public will display an increased level of attention."⁷ The signs were thus considered "entirely different in their overall impression for the relevant public."⁸ Most of the observations made regarding the prefix "uro," referring to the field of urology, could apply to the prefix "broncho," from the field of pneumology.

In the second General Court case,⁹ the disputed mark was the word sign "XENASA," designating "pharmaceutical preparations, namely for the diagnosis, prevention and/or treatment of gastrointestinal disorders and conditions; pharmaceutical preparations for the treatment of inflammation of the gastrointestinal tract; dietetic substances adapted for medical use, namely for the diagnosis, prevention and/or treatment of gastrointestinal disorders and conditions." The opposition was based on the existence of an earlier European Union (EU) word mark, "PENTASA," designating "pharmaceutical products and substances." The General Court recalled here too the high degree of consumer attention likely where prescription pharmaceutical products were concerned.¹⁰ But it then dismissed likelihood of confusion as a consideration in the case, irrespective of the consumer's attention level or recognition of "the word elements 'PENTA' and 'XEN' as references to the Greek prefix 'penta' and Greek word 'xenos.'"¹¹ It may shed some light on the General Court's reasoning to know that 5-aminosalicylic acid or 5-ASA (pentasa), also known as mesalazine, is an anti-inflammatory drug used to treat certain inflammatory ailments of the colon.

André Lucas

B. Slavish reproduction of a service mark on a website – Counterfeiting – Identity of signs and services – No need for evidence of likelihood of confusion

The slavish reproduction of a trademark on a website, performed by the website's owner, constitutes counterfeiting from the moment the injured party proves that it has a valid and exclusive right to the mark and that an exact reproduction of its distinctive sign has been used to designate identical services. The likelihood of confusion in public perception is presumed in such cases, relieving the injured party of any burden to prove it.

FOREST STEWARDSHIP COUNCIL V. BORIS BOIS SARL,
Civil judgment No. 886/Civ of December 5, 2016, High Court of Wouri (Douala)

Observations:

The 21st century has been marked by growth in trade via cyberspace, which allows suppliers to rationalize

4 See the section on "l'usage de racines descriptives ... dans domaine pharmaceutique" in A. Folliard-Monguiral (2019) *JurisClasseur Marques – Dessins et modèles*, Fasc. 7610-1, No. 277.

5 *Kwizda*, n. 3, at [25].

6 *Ibid.*, at [26].

7 *Ibid.*, at [81].

8 *Ibid.*, at [82].

9 T-362/16 *Tillotts Pharma v. EUIPO – Ferring (XENASA)*, Judgment of the General Court (Fifth Chamber) of June 19, 2018, ECLI:EU:T:2018:354.

10 *Ibid.*, at [23].

11 *Ibid.*, at [68]–[70].

production costs and reach distant markets at the click of a button. But the trend has also been devastating for owners of industrial trademarks. In the OAPI member states, these new economic actors – the newly minted titans of e-commerce – clash in legal battles, pitting the monopoly granted by trademark law on one side against the profitability offered by a fluid World Wide Web on the other.¹² The judgment reported here provides some insight into this new reality.

Facts: The case concerns the international non-governmental organization (NGO) Forest Stewardship Council (FSC), owner of a portfolio of four brands of goods and services that included the marks “FSC + Logo” No. 68286 and “FSC + Logo” No. 68289. These marks were properly registered with the OAPI and their registration was kept up to date. The Council nonetheless became aware that its FSC marks No. 68286 and No. 68289 were being used for commercial purposes by company Boris Bois SARL (headquartered in Douala), which had included them on the homepage of its website. To preserve its rights to take action for counterfeiting, the Council sought and obtained authorization from the motions judge for the Court of First Instance of Bonanjo in Douala to complete a detailed inventory of the company’s website. The inventory was completed on April 8, 2016, and a record drawn up shortly after. On that basis, the Council brought action against Boris Bois in civil proceedings before the High Court of Wouri in Douala, asking the court to order removal of the Council’s registered marks from the defendant’s website and thereby put an end to its fraudulent use of them.

Reasoning: Despite the failure of Boris Bois to appear and assert its claims, the High Court considered the case on the merits and granted the Council’s request. In essence, although the alleged activity was carried out entirely in cyberspace, the High Court ruled the reproduction of FSC marks No. 68286 and No. 68289 to be slavish and thus counterfeiting (section I). Accordingly, Boris Bois was ordered to remove them from its website under threat of penalty (section II).

I. Conditions governing convictions for the slavish reproduction of signs as counterfeiting

The High Court briefly recalled the prerequisites for ruling slavish reproduction of a mark to be counterfeiting (A), regardless of the environment in which that activity takes place (B).

A. Prerequisites for a finding of counterfeiting

Plaintiffs bringing action for counterfeiting are required to furnish proof of title on the first day of proceedings, as well as of prior ownership of the counterfeited sign and of its continuing validity.

It is the prerogative of the holder of rights to the title – that is, the first to file for its registration – to bring

such action for counterfeiting, with their certificate of registration providing proof of ownership. It is logically up to the plaintiff to demonstrate that it has indeed acquired the rights allegedly infringed. The judge in this case raised the issue and noted compliance with this requirement, the plaintiff having produced certificates confirming its registration of the marks concerned.

But the plaintiff must also prove that the protection afforded by such registration has not lapsed owing to non-renewal or been canceled following prolonged failure to use the mark – that is, for an uninterrupted period of five years prior to bringing the action. As noted in the judgment, the plaintiff produced certification that the registration had neither lapsed nor been canceled.

It is only after fulfillment of these prerequisites that the substantive conditions for a finding of counterfeiting *stricto sensu* should be assessed under civil law.

B. Substantive conditions specified by the judge for a finding of counterfeiting in the case of slavish reproduction

Just as community lawmakers have done, the judge in this case laid down basic conditions for a finding of counterfeiting based on slavish reproduction of a sign.¹³ In essence, the judge required both identical signs and the designation of identical goods or services (1), and also a likelihood of confusion in public perception (2).

1. Identical goods and services

Trademark counterfeiting is defined in various ways: as unlawful or fraudulent imitation, as slavish or nearly slavish reproduction of another person’s mark, as violation of a license contract or as unlicensed use of another person’s mark.

Slavish reproduction of a sign amounts to the most obvious form of counterfeiting and the two have long been assimilated.¹⁴ Gastombide was aware even in the 19th century of the danger of such activity “diverting customers through imitation.”¹⁵ Such slavish counterfeiting assumes identical reproduction of a protected sign, with no discernible difference between the counterfeit and genuine signs. Imitations leaving insignificant or imperceptible differences are called *nearly slavish*. The difference in the present case was so slight, however, that the imitation and original appeared completely identical – a key consideration in ascertaining counterfeiting based on slavish reproduction.¹⁶

Two signs were reproduced: “FSC + Logo” No. 68286 and “FSC + Logo” No. 68289, both duly registered with the

12 M.-E. Ancel (2012) Un an de droit international privé du commerce électronique. *Comm. com.* 1, chron. 1.

13 See AB-1977, art. 37(1)(a) of annex III; see also ABR-1999, art. 57(1)(a) of annex III.

14 E. Montcho Agbassa (2017) *Revue congolaise de droit et des affaires*, 27, 13; *LTJ Diffusion SA v. Sadas Vertbaudet SA*, R 112003 of June 19, 2002, OHIM Board of Appeals, *PIDB* 2003, III, 341. It has even been asserted that confusion is a “condition for infringement by imitation of a mark”: Y. Monelli (2003) *Contrefaçon: de l’appréciation de la contrefaçon*. In M. Vivant (ed.) *Les grands arrêts de la propriété intellectuelle*, Paris: Dalloz, 401.

15 A.-J. Gastombide (1837) *Traité théorique et pratique des contrefaçons en tous genres*. Paris: Le Grand & Descaurrier Éditeurs, 410.

16 P. Mathely (1984) *Le droit français des signes distinctifs*, JNA, 29.

OAPI under the plaintiff's name. The defendant, Boris Bois, was thus accused of reproducing them *in extenso*, without differences or additions, and publishing them on its website.

The Bangui Agreement reserves exclusive rights for the beneficiary of a registered mark that may be activated positively or negatively.

- If activated positively, the beneficiary is alone authorized to use a protected sign, unless it authorizes use by third parties.
- If activated negatively, the beneficiary has exclusive standing to prohibit use of the protected sign.

The point of dispute in this case was the defendant's use of the sign without authorization. The High Court reasoned that the defendant, having placed the marks concerned on its website to market its forest management services, usurped the plaintiff's reputation as a forest management NGO, making the defendant liable for identically reproducing the plaintiff's distinctive signs.

In addition to identical signs, the goods or services designated by them must also be identical if the reproduction is to constitute counterfeiting.¹⁷ According to the specialty principle followed under trademark law, protection granted to the right holder for a sign used as a trademark is enforceable only insofar as the sign is used for goods or services that are identical or similar to those indicated on the registration certificate. The relevant goods are those mentioned in the registration application, which must be compared with those designated by the infringing sign.

In the present case, the judge implicitly characterized the goods and services as identical based on the nature of the defendant's activity, professional forest management, which was very like that of the plaintiff, the Forest Stewardship Council. The goods and services specified in the registration application were those included in classes 16, 19, 20, 31 35, 40 and 42 under the Nice Agreement. The judge consequently inferred that the goods and services of the two parties were identical, and thus the defendant's use of the plaintiff's mark was liable to create confusion in public perception.

2. The likelihood of confusion in public perception
Such likelihood is obviously inseparable from the concepts of counterfeiting and slavish reproduction. Reproduction is counterfeiting, in other words, only if that reproduction is liable to deceive the public about the provenance of the goods or services. Such confusion need not have actually occurred; it is the likelihood that is punishable, whether realized or not.

It is a judge who must assess the likelihood of such confusion. Under OAPI law, confusion is presumed likely where an identical sign designates identical goods and

services.¹⁸ In counterfeiting cases, this relieves the victim of having to prove a likelihood of confusion.¹⁹ In all cases, the judge must factor in the relevant audience's level of awareness when assessing this likelihood of confusion.

Ruling under civil law based on the evidence presented, the High Court correctly found confusion likely for the plaintiff's targeted public: "[T]he defendant illegally used the plaintiff's acronym on its products in such a way as to create confusion in public perception." This was a proper application of article 7(2) of annex III to ARB-1999, giving the injured party the benefit of presumed confusion.

II. The penalty for counterfeiting through slavish reproduction

In response to the initial request, the judge penalized the defendant's slavish reproduction of the mark by ordering its removal from the defendant's website (A). The decision invites comment and criticism, however, as to the High Court's jurisdiction *ratione materiae* for the case, in its capacity as judge for civil matters (B).

A. Removal of the counterfeit signs from the defendant's website: a relatively mild penalty

The civil penalties available for trademark counterfeiting are quite extensive, comprising a range of sanctions appropriate to different counterfeiting offenses. Among the most frequently pronounced are those awarding damages to the victim, various forms of injunction to cease illegal activity, publication of court rulings and destruction of goods marketed under infringing marks.

As civil judge in the present case, the High Court merely issued an injunction against Boris Bois and ordered it to remove the counterfeit signs from its website, imposing additional penalties should there be any delay in compliance, aiming to discourage any spontaneous resistance.

The penalty ordered is regrettably light, aimed apparently at nothing more than stopping the counterfeiting and discouraging the defendant from repeating the offense. It is unfortunate, in terms of business ethics, that the judge could not take action beyond the plaintiff's claims and written submissions, which narrowed the decision's parameters from the start. Under the doctrine of *non ultra petita*, the court could rule only on those requests contained in the original act of referral.

B. Issues raised by the ruling

The decision nonetheless raises two issues: whether the High Court was competent to hear the case, and its failure to establish the identical nature of the plaintiff's and the defendant's goods and services.

17 Cf. Decision No. 69/OAPI/DG/SCAJ of the OAPI Director General, canceling registration of the mark "TUDOR" No. 40059.

18 See ABR-1999, art. 7(2) of annex III.

19 Decision No. 100/OAPI/DG/DGA/DAJ/SAJ of the OAPI Director General canceling registration of the mark "ITEL Logo" No. 73235.

With regard to the first issue, competence is the acknowledged authority of a judge to decide disputes on particular matters within a clearly defined geographical area. Where a court has competence *ratione materiae*, it may be invoked by the judge, even *ex officio*, as a matter of public policy (*ordre public*) pertaining to judicial organization.

The problem here is that the Bangui Agreement did not designate the civil court competent to hear actions relating to trademarks.²⁰ Article 47(1) of annex III to ABR-1999 merely provides that: "Civil actions relating to marks shall be brought before the civil courts and judged as summary proceedings." In Cameroon, under Law No. 2006/15 of December 29, 2006, organizing the judiciary, *ratione quantitatem* competence is conferred on courts of first instance and high courts for disputes concerning industrial property assets. Articles 15 and 18 of the Act assign competence to courts of first instance for disputes involving up to CFAF 10 million and to high courts for those involving larger amounts. However, since 2006, competence has been assigned specifically to the *commercial chambers* of such courts, as opposed to the commercial courts existing in some OAPI countries. The High Court's Civil Chamber was thus wrong to retain competence in the present case. The best course, even if taken *ex officio*, would have been to decline competence *ratione materiae* as a matter of public policy.

The second problem with the High Court's decision lies in some regrettable flaws in its stated reasoning. For there to be counterfeiting through reproduction, both the signs and the products of the two parties must be identical. Such identity must be real and proven, failing which the plaintiff may be obliged to demonstrate a likelihood of confusion between its products and those of the alleged counterfeiter.

The main question put to the judge was whether the goods and services listed on the various registration certificates, falling within classes 16, 19, 20, 31 35, 40 and 42 under the Nice Agreement, were identical to those marketed by Boris Bois. These classifications are, however, of administrative, not legal, value. Goods or services of the same class are not necessarily identical, or even similar, while two similar products may belong to different classes.

In its written grounds for the ruling, the High Court mentions the classes of goods and services counterfeited without venturing to enumerate them specifically and, unconvincingly, declares the goods and services to be identical. No such thing was established. The judge seems not to have verified the identical nature of both signs and products but only to have presumed it, based on the inventory of the defendant's website and the plaintiff's activity.

Aristide Fade

20 Cf. P. Edou Edou (ed.) (2009) *Le contentieux de la propriété intellectuelle dans les États membres de l'OAPI: Guide du magistrat et des auxiliaires*. Geneva: WIPO, 73.

C. Trademarks – Forfeiture proceedings for a non-working mark – Concept of genuine use – Territorial scope

To successfully oppose forfeiture proceedings, the owner of a mark must prove genuine and uninterrupted use of the sign invoked as a trademark in at least one of the OAPI member states. Use relating to a trademark other than the one registered should not count in that determination.

ANIL SARL V. COMPAGNIE AFRICAINE DE PRODUITS ALIMENTAIRES EN CÔTE D'IVOIRE (CAPRACI), Judgment No. 3242/201 of October 27, 2015, Commercial Court of Abidjan

Observations:

The judgment reported here addresses an issue with considerable practical ramifications: how to define a mark's "genuine use," which, if proved, can prevent forfeiture of the title as non-working? Such forfeiture is now provided for in article 27 of annex III to ABR-2015: "At the request of any person, the competent domestic court may ascertain the forfeiture and order the deregistration of any registered mark that: (a) for an uninterrupted period of five years prior to the request, has not been used on the territory of one of the member states if its rightful owner fails to provide valid grounds ..."

Facts: Forfeiture has not always been a feature of trademark law. The 1857 law in France did not provide for it, since rights were acquired at that time as a result of use. The Paris Convention of March 20, 1883, provided for the possibility of cancellation, but as a voluntary option for the signatory states.²¹

Forfeiture can be justified in two ways. First, it can be based on the fundamental principle of free trade and industry. According to this notion, the number of signs is necessarily limited, making it increasingly difficult for operators entering the market to choose a new mark. It can be considered healthy, by this reasoning, to remove "parasitic" signs, which are often called "defensive" or "blocking" marks. Second, forfeiture may be justified by the need to restrict the mark to its function as a guarantee of origin, as affirmed by the Court of Justice of the European Union (CJEU) in its *Ansul* decision.²²

In the present case, the mark concerned was "*Mama pour la cuisine de Maman*." The mark's forfeiture, as reported by the OAPI, had been pronounced by a default judgment of the Commercial Court of Abidjan. The owner

21 Article 5C(1): "If, in any country, use of the registered trade mark is compulsory, the registration may be canceled only after a reasonable period, and then only if the person concerned does not justify his inaction." See, in this regard, art. 19.1 TRIPS.

22 C-40/01 *Ansul BV v. Ajax Brandbeveiliging BV*, Judgment of the Court of March 11, 2003, ECLI:EU:C:2003:145, at [37]: "The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings."

of the mark, opposing its forfeiture, sought withdrawal of the default judgment for failing to consider the mark's use in Benin, an OAPI member country. In response, the company seeking forfeiture objected that uninterrupted and genuine use in Benin had not been proven and that, in any event, "obligation of use" imposed by the Bangui Agreement extends "to all OAPI member countries" and thus to Côte d'Ivoire, where the action was brought.

Reasoning: The Abidjan Commercial Court was thus presented with two distinct problems:

- I. the nature of the use required; and
- II. the territory where such use had occurred.

I. Nature of the use required

In assessing whether the use claimed in Benin might preclude forfeiture, the court first recalled the terms of article 23 of annex III to ABR-1999, the applicable version of the Bangui Agreement (the wording of which is retained verbatim as article 27 of ABR-2015). The court read the burden of proof indicated in that provision as requiring the mark's owner to "prove, by any means, genuine and uninterrupted use of the sign invoked as a trademark and allowing it to be distinguished from those of its competitors." The court specified that "symbolic use, the sole purpose of which is to maintain the rights created by the mark," could not be taken into account. While not found in the Bangui Agreement, the adjective "genuine" used in the court's ruling does appear in EU legislation.²³ Other language in the court's ruling (use of the sign "as a mark," the exclusion of "symbolic use") is similar to wording in the well-known *Ansul* decision,²⁴ in which the CJEU stated as a matter of law that:

"[T]here is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark."

In highly didactic fashion, the court then entered into detail on what must be proved. "Acceptable proof," it affirmed, "must give indications as to the place, duration, significance and nature of the mark's use for the goods and services designated in registering it." The CJEU has taken that same view even further. Genuine use must be assessed, it has affirmed, "taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity."²⁵

23 Regulation (EU) 2017/1001 of the European Parliament and of the Council of June 14, 2017 on the European Union trade mark, OJ L 154/1, art. 18.1.

24 *Ansul*, n. 22.

25 C-149/11 *Leno Merken BV v. Hagelkruis Beheer BV*, Judgment of the Court (Second Chamber) of December 19, 2012, ECLI:EU:C:2012:816.

Had the plaintiff in the present case met this burden of proof? The court's response appears to have been "no," based mainly on the place of use not being clearly established. While elliptical, the answer does shed light on specific actions that can be considered to establish genuine use.

The court started on a positive note, accepting that some of the exhibits produced (e.g., purchase orders, bills of lading, product packaging stamped with the mark) "unquestionably prove the tangible and physical existence and use of the mark." That formulation is, however, perplexing. It would have been preferable to know which pieces of evidence were convincing (the packaging, no doubt) and why others were not (perhaps the purchase orders or bills of lading). Similarly, did the use claimed extend over the full five years of "uninterrupted use," as required by article 27 of annex III to ABR-2015?²⁶

Taking a more skeptical tone, the court then made an important point: the purchase orders and bills of lading refer to "a mark called 'Mama' not '*Mama pour la cuisine de Maman*,' as in dispute here." Because these were "two quite different marks," the court reasoned, use of the former could not in any event prove use of the latter.

That assertion may be based on article 27, which refers simply to a "registered mark." It is tempting to view that provision in the light of article 5(C)(2) of the Paris Convention of 1883, which provides: "Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the [Paris] Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark."²⁷ According to article 19 of ABR-2015, moreover, where provisions of the Bangui Agreement diverge from those of international agreements signed by OAPI member states (which include the Paris Convention), the international agreements shall prevail.²⁸ But such an easy path to proving use, to avoid forfeiture, might be considered less appropriate where the mark concerned has itself been registered separately, as seems to have been the case for "*Mama*." In France, the Court of Cassation ruled to that effect²⁹ before the opposite solution became established under EU law.³⁰

In any event, even leaving aside the difficulty associated with multiple marks, the contradiction between the Bangui Agreement (article 27) and the Paris Convention (article 5(C)(2)) can be overcome if deletion of the words "*pour la cuisine de Maman*" is considered sufficient to alter the mark's "distinctive character," within the

26 ABR-2015, art. 27 of annex III, identical to ABR-1999, art. 23, the version applicable to this case.

27 See also Regulation 2017/1001, n. 23, at art. 18(1)(a), reserving the possibility of invoking such use against forfeiture proceedings.

28 "Where the provisions of this Agreement or its annexes diverge from those of the international agreements to which the Member States or the Organization are party, the international agreements shall prevail."

29 Cass. com., June 20, 2006, No. 4-18.768.

30 See Regulation 2017/1001, n. 23, at art. 18(1)(a).

meaning of the latter provision. A judgment of the Court of First Instance of the European Union appears to have made that argument. It interpreted article 18(1)(a) of European Regulation 2017/1001 as relating “to a situation where a national or Community registered trade mark is used in trade in a form slightly different from the form in which registration was effected,” that being the case “where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent.”³¹

The particular case of elements being deleted from a registered mark has been the subject of extensive case law in France that is rather difficult to summarize. Taking a somewhat extreme position, the Paris Court of Appeal refused to consider the sign “Seven” as genuine use of the mark “Seven7,” reasoning that the latter’s distinctiveness depended in particular on repetition of the number 7.³² According to a more accommodating judgment from the same court, use of the words “Top Model” did not alter the distinctive character of a mark registered as “Top Model de Jean-Jacques Vivier.”³³ The premise of this latter ruling is not entirely dissimilar to that of the present case. However, while permission to appeal against the ruling was denied,³⁴ the precedent it sets is limited. The solution has, in fact, been criticized as shirking the principles laid down by the EU Court of First Instance in the case mentioned above.³⁵

The position of the Commercial Court of Abidjan can thus clearly be commended for its solid reasoning. It is simply unfortunate that the debate did not address this point.

II. Territory of use

To serve as a defense against forfeiture proceedings under article 27 of annex III to ABR-2015, the use of a mark must have occurred “on the territory of one of the member states.” That was the crux of the court’s reasoning in the present case. After conceding that “some” of the exhibits produced in the proceedings established use of the mark “*Mama pour la cuisine de Maman*,” the court said that “these exhibits, taken together or individually, do not establish that the disputed mark was actually used in Benin.” It laid particular emphasis on the absence of an affidavit from “a sworn official whose acts are considered authoritative until proven otherwise,” attesting that the products were “available for sale in Benin.”

This reasoning is also solid. To prevent forfeiture, it is sufficient, under article 27, to establish use on the territory of one of the member states. The applicant insisted that use in all OAPI member states must be proven, such that failure to do so in a single country “exposes the trademark concerned to deregistration.” That position obviously cannot be right. But it does have to be established where the use occurred and, in practice, that can be done only through sworn official statements.

The only reservation we might have in relation to this finding concerns its focus on territorial localization, warranting another comparison with EU law. The previously mentioned article 18(1) of Regulation 2017/1001, referring to EU marks, mentions only use “in the Union,” without specifying (as does ABR-2015, in article 27 of annex III) that it must occur “on the territory of one of the member states.” Yet the provision that this replaced, Regulation 207/2009 of February 26, 2009, containing the same provision on forfeiture,³⁶ had been preceded by a joint statement by the Council asserting that use in a single country represented genuine use within the Union.

This solution was applied initially by the European Union Intellectual Property Office (EUIPO),³⁷ but later transformed by the CJEU in the *Leno Merken* decision, which rejected its automatic character.³⁸ The CJEU reasoned that while there was:

“... admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State.”³⁹

This is contrary to what the EU Court of First Instance had seemed to rule previously,⁴⁰ in laying down the principle (admittedly, about a national mark, not an EU mark) that genuine use implies that the mark is present in a substantial section of the territory in which it is protected. The court concluded from this that it was “impossible to determine *a priori*, and in the abstract, what extent of territory should be considered sufficient to determine whether the use of a mark is genuine or not.”⁴¹ It then called on domestic courts, in very general wording, to consider “all the relevant facts and circumstances.”

31 T-194/03 *Il Ponte Finanziaria SpA v. EUIPO*, Judgment of the General Court (Fourth Chamber) of February 23, 2006, ECLI:EU:T:2006:65, at [50].

32 CA Paris, June 6, 2005: *PIBD* 2005, III, 551.

33 CA Paris, June 9, 2006: *PIBD* 2006, III, 612.

34 Cass. com., December 4, 2007, No. 6-18.901.

35 See, in this regard, P. Trefigny-Goy (2008). *Propr. ind.*, comm. 10, No. 6: “This interpretation seems to be very tolerant for the trademark owner. It is not clear whether this is a minor modification ...” See also E. Le Bihan (2018) *JurisClasseur Marques – Dessins et modèles*. Fasc. 7405-2, No. 83: “Clearly, the mark as used differed significantly from that registered, and we can thus question the relevance of such a decision where the mark is in the end used in a form shortened by more than 50%, whereas the deleted elements cannot be considered as lacking in distinctiveness.”

36 Council Regulation (EC) No. 207/2009 of February 26, 2009 on the Community trade mark, OJ L 78/1, art. 51.

37 E. Le Bihan, n. 35, No. 20, and the references quoted there.

38 *Leno Merken*, n. 25.

39 *Leno Merken*, n. 25, at [50].

40 T-39/01 *Kabushiki Kaisha Fernandes v. EUIPO*, Judgment of the General Court (Fourth Chamber) of December 12, 2002, ECLI:EU:T:2002:316.

41 *Ibid.*, at [55].

Perhaps the Commercial Court of Abidjan should have followed that advice to put the issue of territorial location in perspective.

André Lucas

D. Trademark – Registration – No change in subject of registration – Infringement action – Acquittal of accused – Counterclaim for compensation – Assessment of damage – Flat-rate compensation

Under article 7 of annex III to ABR-1999,⁴² the only act that the owner of a trademark is entitled to prevent, or to proceed against in court, is the unlawful use of an identical or similar sign for goods or services that are themselves similar to those for which the trademark or service mark has been registered.

The Court of Appeal has therefore correctly applied the terms of ABR-1999 by quashing a lower-court decision, dismissing alleged infringement and recalling that exclusive right of use cannot, without a new registration, be claimed for modifications made to the registered trademark in violation of article 21(3) of annex III.

If the plaintiff should fail to substantiate facts constituting infringement, they may be ordered to pay compensation for the damage caused to the alleged infringer if the action is deemed abusive or vexatious.

MP AND AMANDATOU ADECHOKAN V. FATI YOUNOUSSA AND SALAMATOU YOUNOUSSA, Judgment of July 18, 2006, Court of Appeal of Brazzaville

Observations:

The owner of a protected mark has the right to prevent competitors from using marks identical or so similar to its own as to confuse the consumer with regard to goods or services identical or similar to those designated by the owner's mark. The right possessed by the owner of a mark is thus recognized as exclusive – a principle enshrined in article 7(3) of annex III to ABR-1999,⁴³ which provides that “[r]egistration of the mark likewise confers on the owner the exclusive right to prevent all third parties from making use in business without his consent, of identical or similar signs for goods or services that are themselves similar to those for which the trademark or service mark has been registered where such use is liable to cause confusion.”

The same principle has also been adopted internationally via article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which provides that “[t]he owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which

the trademark is registered where such use would result in a likelihood of confusion.” The principle means that, under trademark law, the right holder must be able, at the very least, to put a stop to the use of similar signs for similar products in the same market where such use would cause confusion among consumers about the origin or authorization of those products.

From this perspective, the judgment of the Court of Appeal of Brazzaville in this case is of major legal interest.

Facts: Mrs. Fati Younoussa and Mrs. Salamatou Younoussa registered the fabric trademark “SULTANA ALWAYS THE BEST” with the OAPI on April 17, 2001. The mark was a logo composed of three colors (red, white and gold) and a royal crown.⁴⁴ In 2004, the two plaintiffs became aware of the presence on the market of traditional dresses (in French, *pagnes*) bearing the distinctive sign “SYLVANA ELEGANCE BEST QUALITY,” which they considered an infringement of their own mark. They requested and obtained from the president of the Brazzaville High Court an order for a detailed inventory of the products marked, imported, delivered and sold to their detriment, to be performed by the economic and financial investigations department of the Directorate of Judicial Police. The two plaintiffs also obtained an order for the seizure of two copies of the infringing goods from all warehouses and displays.

Under that order, on March 15, 2004, the Directorate's department confiscated a batch of 250 dresses bearing the sign “SYLVANA ELEGANCE” from the ADE (Marna Bonheur) and ICE establishments. It was against this backdrop that Mrs. F. Younoussa and Mrs. S. Younoussa brought legal proceedings against ADE and ICE, as well as Mrs. A. Adechokan, before the correctional chamber of the Brazzaville Court of First Instance. That trial court found the latter guilty of unlawfully exploiting a registered mark and ordered her to pay the plaintiffs CFAF 25 million in damages.

Mrs. Adechokan appealed.

Reasoning: Finding no infringement offense, the Brazzaville Court of Appeal quashed the trial court's ruling. It based its decision first on the plaintiffs having violated both the specialty principle and the prohibition against modifying registered marks, and second, on the absence of a notable likelihood of confusion. The court also received a counterclaim for compensation from Mrs. Adechokan for excessive seizure and the distrainers' abuse of civil action procedures.

The court's ruling represents a clear statement on whether the use of a mark in a modified form remains protected by article 7 of annex III to ABR-1999,⁴⁵ so as to warrant an infringement action. In its statement, the court affirms:

44 Such a mark may be classified in the category of semi-figurative marks characterized by a combination of a name and a design. See Dépôt de marque.com, Les différentes formes de marques déposables, <https://depot-de-marque.com/guide-marques/marques-verbales-figuratives-et-semi-figuratives-les-differentes-formes-de-marques/>.

45 Now ABR-2015, art. 6 of annex III.

42 Cf. ABR-2015, art. 6 of annex III.

43 *Ibid.*

- I. the obligation to use a mark in accordance with the corresponding registration certificate; and
- II. the trial judge's discretionary power in infringement cases.

I. Obligation to use the mark in accordance with the registration certificate

Under article 7 of annex III to ABR-1999, the only act that the owner of a trademark or service mark is entitled to prevent or proceed against is the unlawful use of an identical or similar sign for goods or services that are themselves identical or similar to those for which the mark has been registered (A). Such protection does not extend to modifications made to the registered mark in violation of article 21(3) of annex III unless a new registration is filed (B).

A. Protection of the mark through prior registration

In their application for registration, the owner of a mark must define exactly what they intend to protect; ABR-1999, in its provisions for infringement actions under articles 7 and 46 of annex III, protects only what is included in the registration application. In other words, the registration applicant must specify all elements of a mark that they might seek to protect through infringement action.⁴⁶

In this case, the appeal court invoked that principle against the plaintiffs. They had registered their mark with the OAPI on April 17, 2001, as comprising three colors, red, white and gold, and a logo formed by a royal crown printed in a gold color within a central ring. The judges noted that although such signs can be protected legally under article 7, such protection cannot be extended to other signs not appearing on the registration certificate:

“[T]here is no indication in the judgment or on the sheet reproducing the mark that ‘SULTANA ALWAYS THE BEST’ can be translated into French as ‘TOUJOURS LE MEILLEUR’ according to the destination of the goods [...] paradoxically, a sample dress bearing the registered mark ‘SULTANA ALWAYS THE BEST’ appears nowhere in the dossier [...] instead of the logo registered under No. 45120 on February 19, 2002, in Yaoundé, the dossier contains a different logo: ‘SULTANA Les Griffes de Fati!’”

The Court's position was that the logo “SULTANA Les Griffes de Fati” affixed to the allegedly counterfeited dresses could not fall within the scope of protection of the mark “SULTANA ALWAYS THE BEST” – a position that appears to accord strictly with article 7 of annex III: only that which is declared is protected.⁴⁷

That principle, frequently invoked in case law, applied fully in the present case. Having indicated “SULTANA ALWAYS THE BEST” as the mark registered, the plaintiffs could not extend protection to word signs not included in the registration application. Moreover, it was surprising that the owner of a mark, in offering physical evidence of having registered the mark to prove infringement of its rights, should have provided goods bearing signs not matching those registered.

Specifically, as the court observed, the plaintiffs had entered into evidence dresses bearing a logo, “SULTANA Les Griffes de Fati,” which did not appear in the official registration, rather than “SULTANA ALWAYS THE BEST.” The court therefore risked violating article 7 of annex III if it were to accept the former as a component of the protected mark. Indeed, except for well-known trademarks,⁴⁸ the reference document used to establish the scope of trademark protection is the registration certificate,⁴⁹ which is based on the information on the application form filed. For that reason and in accordance with article 8 of the same annex, it is important that applications for trademark registration provide a description and/or reproduction of the mark and a list of the products for which registration of the sign is sought, as well as their corresponding classes under the international classification of goods and services. Use of the mark must subsequently accord with the registration certificate.

The court buttressed its reasoning by invoking the principle of specialty, which the plaintiffs were said to have violated. According to the principle of specialty, a mark must be used – and is protected – only in respect of the goods or services designated upon registration, so that their origin can be determined. That is a mark's essential purpose.

That principle, however, ought not to have been raised in this case, because the product declared in the act of registration (a fabric) was provided as a sample and turned out to be the same as that impugned by the plaintiffs. The problem lay elsewhere: in the discrepancy, as the court pointed out, between the word signs registered under the mark and those appearing on the dresses produced as evidence of trademark infringement. The court, apparently understanding this, simply evoked the specialty principle without elaborating further; the court emphasized instead that a change of logo cannot be considered a change of registration, which is not legally permissible for trademarks.

B. Protection of the mark through the exclusion of modifications

In correcting the trial judge, the Court of Appeal was careful to recall that a registered mark cannot be modified, article 21(3) of annex III to ABR-2015 clearly stating: “No changes may be made either to the mark

46 See ABR-1999, art. 8 of annex III, now ABR-2015, art. 9 of annex III.
47 See J. Passa (2009) *Droit de la propriété intellectuelle, vol. 1: marques et autres signes distinctifs*, 2nd edn. Paris: LGCF, 147–149. See also CA Paris, November 10, 2000, *PIBD* 2001, No. 716, III, 143.

48 See ABR-1999, art. 6; ABR-2015, art. 5 of annex III; art. 6bis of the Paris Convention for the Protection of Industrial Property; art. 16(2) and (3) TRIPS.
49 See ABR-1999, art. 16 of annex III (now ABR-2015, art. 20 of annex III).

or to the list of goods or services for which the mark was registered.” That position results from presentation during the proceedings of sample dresses bearing the logo “SULTANA Les Griffes de Fati” rather than the registered mark “SULTANA ALWAYS THE BEST.” The court interpreted the different word sign as a modification to the registered mark and reversed the trial court’s decision to accept that modification. The trial court had based its acceptance on annex II, which deals with utility models, instead of annex III, on trademarks (article 21(3)), despite the fact that the Younoussas had registered as marks a set of word signs (“SULTANA ALWAYS THE BEST”) and figurative signs composed of “red, white and gold colors, with a logo in the central ring formed by a royal crown printed in a gold color.”

The Court of Appeal therefore properly applied the law – in particular, article 21(3) of annex III to ABR-1999, which prohibits any modification to the mark or to the goods or services for which the mark was registered. It is clearly not permissible to modify any of a mark’s essential elements, including the name, logo or associated wording.⁵⁰ This underscores the importance for trademark applicants to carefully consider the mark intended to be registered and adequately draft the application for registration, to achieve long-term protection.

According to article 19 of annex III, once a mark has been registered for 10 years, it can be renewed indefinitely. It is true that this might tempt the owner to try modifying its mark if business developments should so require. But as the appellate judges correctly pointed out, in that event, a new registration is required under conditions laid down in articles 8 and 9 of the same annex;⁵¹ under articles 13 and 14 of that annex, the OAPI will then examine whether those conditions have been met.

Indeed, the question of trademark modification is covered by a large body of case law in other countries, particularly France. Despite the formal prohibition against changing any element of a mark, certain modifications not liable to alter a mark’s distinctiveness have been recognized. In France, for instance, the Court of Appeal of Aix-en-Provence has accepted separate use of only part of a mark where the rest is substantively redundant.⁵²

In the same vein, the Commercial Chamber of the French Court of Cassation confirmed a judgment in which the Paris Court of Appeal upheld as valid the modified use of a trademark because the modification did not alter its distinctive character.⁵³

Unlike annex III to ABR-1999, applicable to the facts in the present case, however, article L714-5(1) of the French Intellectual Property Code (Code de la Propriété Intellectuelle, or CPI) explicitly authorizes use of a mark “in a modified form that does not alter its distinctiveness.” The prohibition of trademark modification is similarly eased by article 5(C)(2) of the Paris Convention,⁵⁴ which is referenced in ABR-1999. Positively aligning with this more flexible approach, article 27(2) of annex III to the most recent revision of the Bangui Agreement (ABR-2015) authorizes use of a mark in a modified form that does not alter its distinctive character.

In this case, however, combining the word “SULTANA” with the words “Les Griffes de Fati” instead of “ALWAYS THE BEST” modified the mark so substantially that not even ABR-2015 would allow it. The court was thus correct in declining to recognize the word sign “SULTANA Les Griffes de Fati” as protected under the registered mark “SULTANA ALWAYS THE BEST.”

Its assessment regarding infringement, meanwhile, is problematic.

II. Exclusive jurisdiction of the trial judge for the main infringement action and acceptance of the counterclaim for damages

The salient points in this decision are that:

- A. it is up to a plaintiff to prove to the court that its trademark right has been infringed and the trial judge has exclusive jurisdiction to rule on that allegation; and
- B. a plaintiff failing to demonstrate that infringement has been committed may be ordered to pay compensation for the damage caused to the alleged infringer if the plaintiff’s action is deemed to be abusive or vexatious.

A. Assessment of the infringement conditions

The Court of Appeal ruled first on the validity of the seizure ordered on March 10, 2004, by the president of the Brazzaville High Court, and executed by the economic and financial investigation department of the Directorate of the Judicial Police. It then assessed the likelihood of consumers confusing the two marks in question.

50 Cass. ass. plén., July 16, 1992, *PIBD* 1992, No. 534, III, 659; *JCP E-44* 1992, 239 (note J.-J. Burst); *Sté Nicolas Napoléon v. Sté Dulong Frères et Cie*, Judgment of the CA Paris, Fourth Chamber, of March 21, 1983, *Ann. propr. ind.* 1983, 73; A. Thrierr and O. Thrierr (2004) *JurisClasseur Marques*, Fasc. 7720, 23.

51 ABR-2015, arts. 9 and 10.

52 Cf. Judgment No. RG 16/7491 of March 21, 2019, of CA Aix-en-Provence. Regarding the mark, “les pierres du v la pierre du v,” the court held “it cannot be contested that the distinctive element of the registered word mark is the term ‘pierre du Vallat’; the sign ‘les pierres du vallat’ preceding the group ‘la pierre du vallat’ appears to be a redundant element, and it is noted that the full sign as registered cannot be used in economic usage because of its unusual length.”

53 Cass. com., December 12, 2018, No. 10633F: “The French trademark ‘monkiosque.fr monkiosque.net’, registered in 2006, will be read ‘monkiosque’ a single time and does not derive its distinctiveness from the doubling of the same word. The extensions .fr and .net are linked only to internet needs and are no more distinctive, and the addition of a figurative element and colors do not alter the distinctive character of the trademark.”

54 Article 5C(2) of the Paris Convention provides that: “Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [...] shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.”

Recalling the substantive conditions for a valid infringement seizure, the court said that “the first judge ordered seizures on the basis of the registered trademark without verifying, as required by article 48(2), whether the right holder had proven its registration of the trademark by producing an official act to that effect, as now included in the dossier, but above all, proof that the mark had neither lapsed nor been canceled.” Under article 48 of annex III, when a court is petitioned for infringement seizure and before it grants such a petition, its president must first verify whether the applicant is indeed the owner of a valid and available mark. For that purpose, the judge so petitioned, as well as the court hearing any challenge to the seizure order should one be issued, must confirm both the registration of the mark and that it has neither lapsed nor been canceled. The necessary certificates will allow the judge to ascertain that the mark was protected on the day of the petition.⁵⁵

In the present case, the Court of Appeal found the first judge to be at fault for failing to seek such verification, especially given the “troubling” circumstance “that the owner of a well-defined registered mark, while availing herself of that registered mark, was content to present to the court samples of another logo, as if the registered mark had lapsed or been canceled.” The court’s comments suggest that had the plaintiff produced certification that the mark “SULTANA ALWAYS THE BEST” had neither lapsed nor been canceled, the point could then have been verified.

While the observation is correct from the standpoint of article 48, the court draws no conclusions from it. Also questionable is the relevance of raising issues at this point in the court’s reasoning not about execution of the seizure but about the order authorizing it. The recitals preceding article 7 of annex III make it clear that protection under that article did not extend to the modified mark. The Younoussas had substantiated neither the registration of their mark nor its effective use – indispensable conditions for establishing and enforcing trademark protection. There is consequently reason to question why the court ruled on the likelihood of confusion after it had demonstrated the absence of any protected right.

Under article 37 of annex III,⁵⁶ certain infringements of the mark are punishable only if “liable to create confusion in public perception.” These include fraudulent imitation of a mark and the sale or offer for sale of goods bearing a fraudulently imitated mark or indications liable to deceive the buyer about the nature of the product, as well as the offer and supply of goods or services under such a mark. This shows the real-life significance of assessing the likelihood of confusion among consumers.⁵⁷

55 ABR-1999, art. 48(2) of annex III: “The order shall be made on request, subject to proof that the mark is registered and that it has neither lapsed nor been canceled.”

56 Now ABR-2015, art. 57 of annex III.

57 A. Bouvel (2012) *JurisClasseur – marques et noms de domaines*, Fasc. 7519, para. 34 et seq. Cf. also *Bosnalijek Pharmaceutical and Chemical Industry Co. v. Sanofi-Aventis SA*, Decision No. 157 of April 26, 2012, OAPI High Commission of Appeal (obs. A. Lucas, this collection, Chapter 3, section A).

In case law, judicial precedents have established that the judge must assess the likelihood of confusion in public perception comprehensively, “taking into account all relevant factors in the case,”⁵⁸ and that such relevant factors include in particular “the visual, auditory or conceptual similarity of the marks at issue.”⁵⁹

In sum, the likelihood of confusion is assessed not on the basis of differences, as the Court of Appeal incorrectly bases its assessment in this case, but of similarities.⁶⁰ By reasoning that “the two logos have too many differences to be similar,” and that “the first obvious difference is between the crown next to SULTANA and the sun of SYLVANA,” the court misapplies that important criterion, setting an example not to be followed by lower courts, their discretion in the matter notwithstanding.⁶¹

Even more fundamentally, it is the relevance of assessing the likelihood of confusion that is problematic in this case. As the court itself says, “the mark claimed by F. and S. Younoussa cannot be assigned ownership.” Having thus denied the plaintiffs’ ownership of a protected mark, the court should not have even broached the issue of confusion – as it did with so little basis – since no intellectual property right can possibly have been infringed. The absence of a right to a protected trademark precludes any notion of infringement in the sense of article 37 of annex III.⁶² Infringement being an offense against an intellectual property right, a person cannot be prosecuted for it if the protected right has not been established.

In any event, the court found no material evidence of trademark infringement and acquitted Mrs. Adechokan of that charge.⁶³ Most importantly, the court found the plaintiffs’ actions to be abusive and ordered them to pay damages to the defendant.

B. Admission of the counterclaim of damages for abusive and vexatious proceedings

In the present case, the court admitted and partially granted the request made by the defendant, who, claiming to be the victim of a vexatious and abusive procedure, sought compensation from the plaintiffs in the amount of CFAF 50 million, with all causes of injury combined.

58 See C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport*, Judgment of the Court of November 11, 1997, ECLI:EU:C:1997:528.

59 Cass. com., April 10, 2019, No. 18-10.075.

60 See Cass. com., May 30, 2012, No. 11-14910, unpublished, in which a recent illustration of this principle of the assessment of infringement was set out based on similarities rather than differences. The case law of the French Court of Cassation is logically consistent on this point and emphasizes that infringement is to be assessed on similarities. See Cass. 1ère civ., May 25, 1992, D. 1993, case law 184 (note X. Daverat), D. 1993, sum. 84 (obs. C. Colombet), *LPA* March 10, 1993, 10 (C. Gavalda) and D. 1993, sum. 243 (obs. T. Hassler).

61 Moreover, the French Court of Cassation has recalled that confusion must be assessed to the extent likely of the average consumer, “normally informed and reasonably attentive and sensible” in the product category at issue: see Cass. com., September 6, 2016, No. 14-25.692.

62 Now ABR-2015, art. 57.

63 See art. 405 of the Code of Criminal Procedure of the Republic of Congo: “If the court considers that the act being prosecuted does not constitute an offense under criminal law or that the act is not established or is not attributable to the accused, the accused shall be acquitted.” See also art. 457 of the Senegal’s Code of Criminal Procedure of Senegal.

In an initial recital, the court admitted the existence of misconduct and injury, recognizing “that the damage suffered from the excessive seizure of 250 dresses, instead of a few samples, has been clearly established; that the lawsuit has caused her inconvenience, discrediting her throughout this procedure; and that the loss of trust among her customers warrants compensation.” In a second recital, the court itself assessed the damages incurred: “This court has the discretionary power to determine the extent of damage done to her, and seeing that abuse of the judicial process has been demonstrated under article 407 of the Code of Criminal Procedure, assesses the resulting damages at CFAF 5 million ...”

In so doing, the court raises two issues:

- the acceptance of a counterclaim based on abuse of procedure in a case of trademark infringement, particularly in criminal proceedings; and
- the assessment of damage suffered by a person accused but acquitted of infringement.

At the outset, it should be emphasized that a counterclaim is a device in civil law defined as “the claim by which the original defendant seeks advantage other than mere dismissal of its adversary’s claim.”

⁶⁴ The Code of Civil Procedure of Senegal, for example, treats counterclaims as incidental requests,⁶⁵ admissible only if sufficiently linked to the original claims.⁶⁶ In trademark litigation, the defendant’s recognized standing to exercise that procedural right usually leads to counterclaims for a title’s invalidation,⁶⁷ or for forfeiture of the rights conveyed by registration of the mark.⁶⁸ Increasingly, however, defendants prosecuted for infringement are filing such counterclaims systematically, claiming injury from abusive proceedings to seek compensation.

This case is of particular interest because the seizure was requested before a criminal court. Public proceedings in criminal matters are initiated in principle by the public prosecutor’s office, although generally based on a victim’s complaint.⁶⁹ In this case, the complaint concerned counterfeiting, but its originators had filed a civil claim. It would thus be incorrect to penalize them for abusive proceedings at the exonerated defendant’s request, because it was not they who initiated the prosecution for counterfeiting.⁷⁰ The situation would be different only if they themselves had initiated public proceedings, as the law allowed,⁷¹ by lodging a complaint

with the examining magistrate and suing for civil injury, or initiating private prosecution directly before the court. In these latter two instances, a court would have reason to rule on the counterclaim after absolving its author of the civil charges in the same decision.⁷²

In this case, there is every indication that the second instance applied. Following article 407 of the Code of Criminal Procedure of the Republic of Congo, the Court ruled against the plaintiffs on the question of their abuse of civil law proceedings.⁷³ But at what point does exercise of the right to proceed against trademark infringement become abusive and vexatious, so as to backfire against the plaintiff? Looking at the case law, it is not commonplace for courts to accept counterclaims for abusive and vexatious proceedings after dismissing an infringement action; rather, they tend to consider a failed infringement action as resulting from the original plaintiff’s poor decision-making or misconception about the scope of its rights.⁷⁴ The situation is different, however, when such a plaintiff acts with full knowledge that its claim is ill-founded.⁷⁵

Nonetheless, the Court of Appeal found abuse in this case – although not, strictly speaking, in the initiation of legal proceedings. The abuse lay instead in that the plaintiffs had obtained actual seizure of all or part of the infringing products instead of the court-ordered inventory granted by the judge, and they then saw their infringement action dismissed on the merits.⁷⁶ The situation is similar to that in which infringement seizure is granted but later invalidated for failure to initiate proceedings on the merits within the 10 days allowed by law.⁷⁷

What the court found in this case was a mishandling of the judge’s order when judicial police seized 250 dresses instead of a few samples. That position is founded in law. As the facts and proceedings clearly show, the plaintiffs were granted a court-ordered *inventory*, but the procedure conducted in fact was the actual, physical seizure of a substantial portion of the goods in stock. That makes the seizure abusive and a misdeed, warranting compensation.

64 See, e.g., art. 64 of the Code de procédure civile français, Paris: Dalloz, 2020, 111 edition, 168.

65 See art. 193 of Senegal’s Code of Civil Procedure.

66 See G. Couchez and X. Lagarde (2004) *Procédure civile*, 17th edn. Paris: Sirey, 179.

67 Cass. com., April 10, 2019, No. 17-26612

68 Cass. com., July 5, 2017, No. 13-11.513.

69 Article 1 of the Code of Criminal Procedure of the Republic of Congo: public proceedings for enforcement of sentences are initiated and exercised by the judges and officials to whom they are entrusted by law.

70 See J. Pradel (2013) *Procédure pénale*, 17th edn. Paris: Cujas, 602–603.

71 Article 1(2) of the Code of Criminal Procedure of the Republic of Congo: “These proceedings may also be brought by the injured party under the conditions laid down in this Code.”

72 See art. 407 of the Code Criminal Procedure of the Republic of Congo; art. 459 of Senegal’s Code of Criminal Procedure.

73 Article 407 of the Code of Criminal Procedure of the Republic of Congo: “In the case provided for in art. 405, where the civil party has itself brought the public proceedings, the court shall decide by the same judgment on the claim for damages brought by the person acquitted against the civil party for abuse of suing for civil injury.”

74 See CA Paris, January 16, 1998, *RD Propr. intell.* 1998, No. 87, 20; CA Paris, May 23, 2001, *PIBD* 2001, No. 729, III, 526; TGI Marseille, March 14, 1979, *PIBD* 1979, No. 244, III, 337; Cass. com., May 22, 1973, No. 71-13.912, *JurisData* No. 1973-097181; CA Lyon, May 28, 1991, *Dossiers brevets* 1991, II, 1; CA Paris, January 16, 1992, *Ann. propr. ind.* 1995, 57, *PIBD* 1992, No. 524, III, 326.

75 See Cass. com., May 22, 1973, No. 71-13.912, *JurisData* No. 1973-097181; CA Lyon, May 28, 1991, *Dossiers brevets* 1991, II, 1; CA Paris, January 16, 1992, *Propr. ind.* 1995, 57, *PIBD* 1992, No. 524, III, 326.

76 See *PIBD* No. 894, III, 951; 13 *PIBD* No. 897, III, 1110.

77 *Nazaire Gnanhoue v. Sola Co.*, Judgment No. 70/15 of March 4, 2015, Court of Appeal of Lomé (obs. M. Lamotte, this collection, Chapter 3, section I): “Detention beyond the legal time limit of an allegedly infringing shipment of goods through exercise of an excessive prerogative of ordinary law intended to constitute evidence for a future procedure undoubtedly creates damage to the owner of those goods.”

It then remained for the counterclaiming defendant, upon dismissal of the charge against her, to establish the damage she had suffered. That is what a judge can remedy following the principle of full compensation: nothing but the damage, but all the damage suffered.⁷⁸ An interesting innovation can be found in this regard in article 54 of annex III to ABR-2015, which establishes precise criteria for determining damages: “The court seized of the matter shall determine the amount of the damages, having regard to the adverse financial effects, including loss of earnings, suffered by the prejudiced party, the profit made by the counterfeiter and the moral damage caused to the owner of the rights as a result of the infringement.” In the present case, the Court of Appeal exercised its discretion to set the amount at CFAF 5 million for nuisance caused to Mrs. Adechokan, who, in addition to being discredited, had suffered a loss of trust among her customers. In addition to moral prejudice, the court referred to material damages, but without quantifying them separately.

Malick Lamotte

E. Infringement action and unfair competition – Dismissal of opposition to registration of an allegedly infringing mark – OAPI – Judicial review

A judge at first instance who dismisses an action for infringement and unfair competition initiated by the owner of a registered mark on the grounds that the owner’s opposition to registration of the infringing mark before competent OAPI bodies has failed does so without legal basis.

SOCIÉTÉ R.M. & CO. LTD V. SOCIÉTÉ C.D.M. (SCDM),
Judgment No. 218 of September 19, 2007, High Court of Wouri (Douala)

Observations:

Does the failure of proceedings to oppose registration of a trademark brought within the OAPI by the owner of a prior mark lead *ipso facto* to the dismissal of that owner’s parallel judicial action for infringement and unfair competition against the applicant for the registration so opposed?⁷⁹ This was the core question put to the judges of the Wouri High Court in this case.

Facts: R.M. & Co. Ltd was the owner of the “CROCODILE” mark registered with the OAPI on July 30, 1991, under No. 30659, covering products in class 8 (machetes and other cutting tools). Informed about use of its mark by Société C.D.M. (SCDM), established in Douala,

R.M. & Co. brought action against SCDM, before the same court, for infringement and unfair competition. According to SCDM, however, the “CROCODILE” mark and accompanying design was in fact the property of T., beneficiary of registration No. 35636 published in the Official Industrial Property Bulletin (Bulletins officiels de la propriété industrielle, or BOPI) under No. 8/1996. SCDM asked the court on that basis to dismiss the action of R.M. & Co., especially since the latter’s parallel opposition proceedings before the OAPI had themselves been dismissed on January 15, 1998, by Decision No. 5/ OAPI/DG/ADG/SCAJ/.

The Wouri High Court did so.

Reasoning: The court based its ruling on a finding in the decision by the Director General of the OAPI that the company enjoyed no exclusivity over the word “crocodile” and the accompanying image, which had been the subject of several earlier filings and registrations in the same classes. Setting aside the preliminary objection raised by SCDM and its counterclaim, which have no relevance to the legal point examined here, the court’s decision calls for a few observations. They concern how opposition to the registration of a mark relates to the action for infringement, on the one hand, and to that for unfair competition, on the other.

In the first regard, the purpose of opposition must be contrasted with that of an infringement action. The main purpose of opposition before the OAPI is to allow prior right holders to prevent the registration of marks likely to harm them.⁸⁰ Conversely, the purpose of an infringement action, under article 18 of annex III to ABR-1999, is to win damages from the alleged infringer and seek additional remedies, including termination of the infringing activity, destruction of the infringing objects and related material, and publication of the decision. In simpler terms, the purpose of opposition to the registration of a mark is different from that of an infringement action. In a judgment instructive in this regard, the Paris Court of Appeal reasoned that “because opposition proceedings ... and infringement action do not have the same purpose, the decision handed down on opposition cannot have the force of *res judicata* with regard to the infringement action.”⁸¹

From that point of view, the decision of the Wouri High Court appears questionable – a view shared in the literature. According to Jérôme Passa, for example, “following his own analysis, the judge can perfectly well decide, despite dismissal of the opposition, that confusion is likely and that the second mark must be canceled or judged to be infringing.”⁸² Admittedly, an OAPI body specializing in hearing opposition to the registration of a mark, on the one hand, and a judge dealing with an action for infringement, on the other, both examine the likelihood of confusion. A decision

⁷⁸ See F. Terre, P. Simler and Y. Lequette (2018) *Droit civile: les obligations*, 10th edn. Paris: Dalloz, 752 *et seq.*

⁷⁹ Opposition is an administrative procedure initiated before the Director General of the OAPI. Among its purposes is enabling the holder of an earlier right to have a third party’s later-obtained registration canceled, in violation of that later party’s right. It is governed by ABR-1999, art. 18 of annex III. The Director General has two options: to cancel the disputed registration, or to maintain it. The Director General’s decision may be appealed to the High Commission of Appeal.

⁸⁰ A. Bertrand (2000) *Le droit des marques et des signes distinctifs*. Kampala: Cedat, 244.

⁸¹ See CA Paris, October 10, 2005, *PIBD* 2005, No. 820, III, 730.

⁸² See J. Passa (2006) *Droit de la propriété industrielle, vol. 1*. Paris: LGDJ, 161.

by the former, however, is an administrative act not binding on the latter, given the pre-eminence of judicial rulings over those of administrative bodies, including the OAPI.⁸³ French case law, going further, has not treated opposition proceedings as a mandatory prerequisite for infringement action, such that failure to initiate them cannot be invoked as a defense.⁸⁴

In the present case, the judges should have assessed likely confusion between the marks on their own initiative,⁸⁵ instead of deciding on the basis of the OAPI Director General's decision to dismiss the plaintiff's opposition.⁸⁶ In short, the failure of proceedings to oppose registration of a mark does not preclude judicial infringement proceedings or even cancellation of the mark concerned.

The second relationship at issue is that between opposition and unfair competition proceedings, as lodged with the Wouri High Court in this case by R.M. & Co. against SCDM.⁸⁷ That court dismissed the action on the grounds that the former's right to the word "crocodile" was not exclusive and that the accompanying image had been the subject of several earlier applications and registrations for goods in the same classes. With certain reservations, those grounds are acceptable for dismissal of infringement based on prior registration of the infringed mark, but not for the dismissal of unfair competition proceedings, even where the mark used has not been registered. Admittedly, the facts as reported do not provide us with objective elements for assessment, since the plaintiff company did not specify an actionable fault committed through unfair competition distinct from infringement itself.⁸⁸

To seek conviction for unfair competition as well as trademark infringement, a victim of the latter must prove that the confusion likely to result from reproduction or imitation pertains to an element not included in the mark's registration.⁸⁹ According to R.M. & Co., SCDM, in using its mark without obtaining consent or a transfer of rights to do so, had not only infringed the mark but also competed unfairly. But the act concerned – use of the "CROCODILE" mark – is the same and cannot constitute two offenses at once. According to the literature and case law, a separate actionable fault must be demonstrated if action for unfair competition is to be admitted in addition to that for infringement. If such a separate fault can be proved, the action for unfair competition could outlive the infringement proceedings and generate damages

in its own right. It therefore follows that the Director General's dismissal of opposition to registration of the "CROCODILE" mark with the OAPI should not have led *ipso facto* to the court's dismissal of the supplementary action for unfair competition, because the source of likely confusion and the criteria for assessing it are different in each case. In the case of trademark infringement, the likelihood of confusion is assessed with reference to the mark as registered, an abstract process. In the case of unfair competition, that assessment is based on concrete market results, factoring in both the protective and competitive aspects.⁹⁰

The acts constituting unfair competition, moreover, are extremely varied – another argument for treating an action alleging that offense separately from an opposition to a mark's registration. Unfair competition can indeed take many forms, beyond the acts enumerated in articles 2–7 of annex VIII, which are merely indicative. In fairness to the Wouri High Court, the petition by R.M. & Co was poorly worded and unclear, but even so, the court needed to assess the two counts separately to avoid possible censure from a higher court.

Max Lambert Ndéma Elongué

F. Fraudulent filing of a trademark – Proof of prior use – Bad faith – Invalidity – Damages

According to the general legal principle *fraus omnia corrumpit* ("fraud corrupts all"), registration of a mark with the OAPI is null and void if the beneficiary was fully aware that a third party had a prior right to use the mark in trade in the same specialist area within the same territory. The infringer may also be liable for damages under ordinary law.

COOPER SA V. LABORATOIRE BRIDE SA, Judgment No. 672 of September 17, 2003, High Court of Mfoundi (Douala)

Observations:

Article 5(1) of annex III to ABR-1999 provides that "ownership of a mark shall vest in the person who files it first." That rule ceases to apply, however, where the filing is fraudulent – in particular, where it is evident that the filer was aware of prior use of the same sign by a third party. This is the transposition into intellectual property law of the fundamental legal principle *fraus omnia corrumpit*, "fraud corrupts all," as recalled on various occasions in French case law⁹¹ and specialized doctrine.⁹² The judgment reported here is typical of such cases.

83 See, to this effect, *SIVOP SA v. Angel Cosmetics SA*, Civil judgment No. 187 of March 21, 2013, Court of First Instance of Yopougon (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section L); see also *Arla Foods AMBA v. Dana Holdings Ltd*, Com judgment No. 7 of January 5, 2012, High Court of Wouri (Douala) (obs. J. Fometeu, this collection, Chapter 1, section A).

84 See CA Paris, Fourth Chamber, April 8, 1998, *Gaz. Pal.* 1998, 2, 545.

85 The two "CROCODILES" marks, Nos. 30659 and 35636, with accompanying design, published in BOPI under No. 8/1996.

86 No. 5/OAPI/DG/ADG/SCAJ of January 15, 1998.

87 Regarding the possibility of cumulation of the two actions, see ABR-1999, art. 2-2 of annex VII; ABR-2015, art. 1(3) of annex VIII.

88 Cf. *Moulinex SA v. Vapsan Trading Cie and ors*, Civil judgment No. 192 of December 15, 2000, High Court of Wouri (Douala) (obs. M.L. Ndéma Elongué, *La Gazette* 2007, 1, 17).

89 Passa, n. 82, at 453.

90 See, in this respect, Passa, n. 82, at 454.

91 See TGI Paris, Third Chamber, April 15, 1983, *PIBD* 1983, III, 260; CA Bordeaux, First Chamber, February 28, 1994, *PIBD* 1994, III, 301; *Distrimed Pharma SARL v. Fábrica Española de productos químicos y farmacéuticos (FAES) SA*, Judgment No. 257/Civ of May 18, 2011, Court of Appeal of the Center Region (Yaoundé); Cass. com., April 25, 2006, No. 83.3, *PIBD* 2006, III, 471.

92 Bertrand, n. 80, at 390 *et seq*; Passa, n. 82, at 178 *et seq*.

Facts: The facts of the case are straightforward. Pursuant to a contract letter dated February 25, 1938, Société de Coopération Pharmaceutique Française (“Cooper”) entrusted Laboratoire Bride SA with the manufacture of medicines based on its own formulas. Those products were distributed by the latter in Africa under the mark “SEDASPIR,” first registered in France in 1934. Decades later, Cooper discovered parallel registration filed with the OAPI for the same mark under No. 36716, dated August 13, 1995, in the name of its trading partner Laboratoire Bride. Cooper therefore brought action against Laboratoire Bride before the Mfoundi High Court for cancellation of the latter’s mark and payment of damages, having registered the same mark with the OAPI, in its own name, on April 1, 1997, under No. 37638. Laboratoire Bride then brought a counterclaim against Cooper, before the same court, for cancellation of the latter registration, No. 37638.

What the Mfoundi High Court had to decide in this case was whether, in the silence of community law, a mark can be canceled on the basis of fraud.

Reasoning: Consolidating the two actions, the court responded in the affirmative, declaring registration of the mark “SEDASPIR,” No. 36716, in the name of Laboratoire Bride, to be null and void and ordering the latter to pay CFAF 30 million to its trading partner. The Bangui Agreement does not expressly say so, but once evidence of fraudulent registration has been reported, the perpetrator of the fraud may be twice penalized.

As a general rule, the party claiming fraudulent registration must prove its own prior use of the disputed sign in trade and for the same areas of specialty, as well as the registrant’s intent to do harm. For some authors,⁹³ supported by case law,⁹⁴ such prior use must meet certain criteria: it must be public, continuous and neither ambiguous nor precarious. Those criteria appear to be satisfied in this case, since Cooper had initially registered the “SEDASPIR” mark in France and used it for several decades in Africa, where it distributed products under the same name and sign in accordance with its partnership contract with Laboratoire Bride. It is therefore clear that Cooper had the prior right to use the mark in OAPI countries.

A fraudster’s intent to do harm can derive from knowledge, at the time of registration, that a third party is using the same mark without having filed for protection. From that standpoint, Laboratoire Bride clearly intended harm to its partner: it was perfectly aware that Cooper was using the “SEDASPIR” sign for tablets distributed in both France and Africa, and – more importantly – its contract with Cooper contained a clause prohibiting registration of the mark without the latter’s consent. This suggests that “SEDASPIR,” registered under No. 36716 on August 13, 1995, was a “blocking” mark, aimed at making the sign unavailable within the OAPI to the detriment of Cooper, which had a legitimate interest

in using it. Laboratoire Bride’s intent to do harm in this way violates the essential purpose of trademark rights: permitting the origin of goods or services to be known. Consumers of the pharmaceutical products concerned could indeed have been misled about their true origin.

Such fraud is penalized by canceling the offending mark and awarding damages, where appropriate under ordinary law. It is accepted in the literature and case law, under the overriding principle of *fraus omnia corrumpit*, that the nullity of a sign registered fraudulently is absolute. A finding of fraudulent trademark registration retroactively renders null and void the rights otherwise conveyed by the mark concerned. The parties then revert to their status prior to cancellation, or a similar status. If the decision is confirmed upon final adjudication, the contested mark is deemed never to have existed. According to article 28 of annex III to ABR-1999, any final judicial decision declaring a mark’s registration void on the national territory of a member state, upon notification from the court, is entered in the special registry of marks and a notice to that effect is published by the OAPI. The court was therefore right to cancel the “SEDASPIR” mark registered with the OAPI under No. 36716 on August 13, 1995, with the clear intent to harm Cooper, the sign’s first user. The direct consequence was deregistration of the offending sign within the OAPI and removal of any subsequent acts registered in relation thereto.

Apart from cancellation, the wrongful behavior of Laboratoire Bride in fraudulently registering the “SEDASPIR” mark, without regard to the prior right of its trading partner, warranted damages under ordinary law. The court awarded Cooper CFAF 30 million for the costs incurred in defending its rights. Cooper had, in fact, requested the reimbursement of such legal costs only, but assessed them at CFAF 50 million. The court did not explain how it arrived at CFAF 30 million, since no supporting documents were produced during the proceedings. That omission exposed this ruling to reversal on appeal.

Max Lambert Ndéma Elongué

G. Mark – Invalidation of the certificate of registration – Assessment of prior right – Assignment of a mark – Enforceability – Regional authority of final judicial decisions

The assignee of a valid registered trademark does not have grounds for seeking cancellation of an identical or similar mark registered prior to registration of the assignment in the OAPI special register of trademarks (first case).

A court of first instance in an OAPI member country that cancels a trademark, the validity of which has been previously confirmed by a final ruling of the highest court in another member country, violates article 18 in the general provisions of ABR-1999 (second case).

93 Bertrand, n. 80, at 391; Chavanne and Burst, n. 1, at 631.

94 See CA Paris, January 18, 2006, *PIBD* 2006, No. 826, III, 223.

NOSOCO-TOGO SARL V. PASTACORP SA, Judgment No. 47/11 of July 21, 2011, Supreme Court of Togo; **SOCIÉTÉ PASTACORP V. TANKOUNANG, JEAN DELORS AND SOCIÉTÉ NOSOCO TOGO SARL**, Judgment No. 96/ Com of May 4, 2016, High Court of Mfoundi (Yaoundé)

Observations:

According to article 5(1) of annex III to ABR-1999, “ownership of a mark shall vest in the person who files it first.” It is indeed registration that gives rise to trademark rights, which are vested in the registrant, subject to provisions in the Agreement for denying registration.⁹⁵ The courts of states party to the Agreement have qualified that language to allow for particular circumstances. It is against this backdrop that the two decisions reported here represent diametrically opposed approaches to the issue.

Facts: The facts behind these decisions are relatively complex. Rivoire and Carret Lustacru (RCL), a now-defunct company formerly governed under French law, owned the semi-figurative mark “COUSCOUS SIPA,” which it registered with the OAPI on February 9, 1981, with successive renewals in 1991, 2001 and 2011. It distributed its products in Africa through a local partner, Nosoco-Togo SARL. After RCL ceased to exist, Nosoco-Togo registered the same mark with the OAPI under its own name. One year later, Nosoco-Togo became aware that the company La Mascotte, operating in Togo, was importing a brand of couscous identical to its own. It brought action for infringement of its trademark “COUSCOUS SIPA,” No. 47511, before the Lomé Criminal Court. La Mascotte claimed to import the couscous bearing the disputed trademark from the company Mardi, a representative of Pastacorp SA, both registered in France. La Mascotte was found guilty of infringement. But, just as Nosoco-Togo was preparing to execute the decision, Pastacorp lodged a complaint against it before the Lomé Court of First Instance, to invalidate the registration filed by Nosoco-Togo.

By judgment No. 622 of April 13, 2007, that court confirmed the right of Nosoco-Togo to use the mark and ordered deregistration of the same mark in the name of Pastacorp.

The Lomé Court of Appeal reversed that decision by judgment No. 27/2009 of February 26, 2009, declaring Pastacorp the mark’s owner, having been assigned the mark that RCL had registered back in 1981, under No. 21047, and ordering Nosoco-Togo to pay Pastacorp CFAF 100 million in damages.

On final appeal, the Togo Supreme Court reversed the appeal court’s ruling by its judgment No. 47/11 of July 21, 2011, thereby re-establishing registration No. 47511 in the name of Nosoco-Togo.

Three years later, in the second case reported, Pastacorp returned to the attack, bringing action for the invalidation of

registration No. 47511 against its competitor Nosoco-Togo and Mr. Jean Delors Takounang, exclusive distributor of “COUSCOUS SIPA” products in Yaoundé, Cameroon. That case went before the High Court of Mfoundi (Yaoundé), which ruled for Pastacorp. The Mfoundi High Court found Pastacorp to have been defrauded in its capacity as assignee of the mark registered as No. 21047 back in 1981 and renewed successively in 1991, 2001 and 2011.

Reasoning: In both of the cases reported, the core question put to the Togo Supreme Court and Mfoundi High Court in Cameroon was whether the assignee of a registered trademark can claim a prior right over that mark if the assignment invoked has not been entered into the appropriate OAPI registry. Their successive rulings take diametrically opposed positions with respect to who holds the prior right (section I), making it questionable how effective regional authority has actually been when the validity of OAPI-issued titles is finally adjudicated in the courts (section II).

I. Who holds the prior right?

A question from the start was whether Nosoco-Togo or Pastacorp could claim the prior right to the “COUSCOUS SIPA” trademark. The different solutions found are best analyzed from the standpoints first of the unregistered assignee (A) and then of the fraudulent registrant (B).

A. The unregistered assignee

It is clear that the trademark “COUSCOUS SIPA” was originally filed with the OAPI by French company RCL on February 9, 1981. That registration remained in force up to 2021 through successive renewals.⁹⁶ While this right was unquestionably transferred to Pastacorp (1), its enforceability against third parties was subject to doubt (2).

1. A theoretically transferred prior right

According to article 5(1) of annex III to ABR-1999,⁹⁷ ownership of the mark “COUSCOUS SIPA,” as maintained up to 2021, clearly fell to RCL. If RCL had initiated the legal proceedings, the case would have been over quickly. As the facts show, however, when RCL ceased to exist, it had assigned its rights and actions in respect of the “COUSCOUS SIPA” trademark to its sister company Pastacorp, as subrogate, on April 20, 2004. This gave Pastacorp undisputed claim to the trademark – especially having benefited from the original registration, No. 21047, as filed by RCL, since February 9, 1981.⁹⁸

96 Under art. 19 of the agreement, “registration of a mark shall be valid for only 10 years from the filing date of the application for registration; however, the ownership of a mark may be preserved indefinitely through successive renewals of the registration, which may be effected every 10 years.” Renewal is therefore a formality that allows rights to a trademark to be maintained indefinitely. This is governed by art. 21 of the same agreement. Case law indicates that renewal resulting from a mere declaration without formality of examination and not from a new filing does not give rise to a new right, but merely allows it to be retained. See CA Paris, Fourth Chamber, April 8 1998, *Gaz. Pal.* 2, 545

97 This provision was fully included in ABR-2015, art. 4: “Subject to the following provisions, ownership of a mark belongs to the person who first deposited it.”

98 Through this subrogation mechanism, the assignee becomes the owner of the rights resulting from the registration of the transferred mark and is therefore entitled to exercise the actions needed to protect and defend its interests as the original owner would have done.

95 Under ABR-1999, art. 14(2), “any filing that does not conform to the provisions of Article 3(c) and (e) shall be rejected.”

In the second reported case, as a crucial part of their stated reasoning, the panel of judges of the High Court of Mfoundi (Yaoundé) recognized that Pastacorp “acquired the COUSCOUS SIPA trademark by way of assignment, in 2004, from Rivoire et Carret Lustacru (RCL), the trademark having been registered with the OAPI on February 9, 1981, under number 21047.” Yet while the prior right was theoretically assigned to Pastacorp, its enforceability against third parties was not.

2. A prior right not enforceable against third parties

In the first reported case, the Court of Appeal of Lomé, in its contested decision, unequivocally recognized “the assignment of the COUSCOUS SIPA mark to Pastacorp as enforceable against Nosoco-Togo, making Pastacorp owner of the prior right, with entitlement to seek cancellation of registration No. 47511, of July 3, 2003, in the name of Nosoco-Togo SARL.” The Supreme Court, basing its argument on the enforceability of the assignment against Nosoco-Togo, censured the Court of Appeal for conferring the prior right on Pastacorp:

“Whereas the contract of assignment between RCL and Pastacorp SA was not registered or brought to the notice of third parties, including Nosoco-Togo SARL, until it was entered into the OAPI Special Register of Marks on January 17, 2005, which had been after the mark was registered with OAPI in the name of Nosoco-Togo SARL, under No. 47511, dated July 16, 2002.”

The Supreme Court invoked article 27 of annex III to ABR-1999 in concluding that Nosoco-Togo had the prior right and that Pastacorp was not entitled – as the original owner RCL would have been – to seek its invalidation:

“Whereas Pastacorp SA was therefore not yet the owner of the mark when Nosoco-Togo SARL registered it in its own name, only the companies Semoulerie de Normandie and RCL, whose registration of the mark ‘COUSCOUS SIPA’ predated that of Nosoco-Togo SARL, could take action to invalidate the registration filed by Nosoco-Togo SARL;

“Considering, however, that neither of those companies has brought action against the registration filed by Nosoco-Togo SARL; that Pastacorp SA, whose ownership right precedes that of Nosoco-Togo SARL, is therefore not entitled to seek invalidation of the latter’s registration; and that the plea is therefore well founded in requesting that the impugned judgment be quashed.”

Article 27 makes the enforceability of a third-party assignment subject to the formal requirement of registration in a special register of marks.⁹⁹ Indeed, for every object of industrial property and for all member states, the OAPI maintains a special registry containing entries as stipulated in the Agreement. However, assignment of the “COUSCOUS SIPA” mark by RCL to Pastacorp was not registered until January 17, 2005, and therefore after the registration filed by Nosoco-Togo. The Supreme Court endorsed the first judge’s decision, confirming the right of Nosoco-Togo to use mark No. 47511 as registered on July 3, 2003, which was prior to registration of the assignment. But it gave no explanation for invalidation of the identically named mark, No. 21047 of February 9, 1981, which was not, from all appearances, tainted by any fatal flaw.

The first judge invalidated the registration filed by Pastacorp on January 17, 2005, but, significantly, Pastacorp never actually re-registered it, its validity having been extended up to 2021; what Pastacorp was actually registering on January 17, 2005, was the assignment. Such registration is necessary, moreover, not for an assignment to be valid but for the purposes of third-party enforceability. On that point, the French Court of Cassation has consistently held that failure to publish through a special registry of marks does not affect the validity of an assignment or pledge; it only makes it unenforceable against third parties.¹⁰⁰ In that respect, the Supreme Court erred in this case by invalidating registration No. 21047, the one performed on February 9, 1981. The mark’s priority should have been assessed based not on when its assignment was registered but on when it was initially filed – reasoning that might have resulted in the coexistence of conflicting marks being admitted. The point is moot, however, if fraud enters into the case.

B. The fraudulent applicant

The question of fraud was not expressly raised before the Supreme Court, which no doubt was merely examining the relevance of arguments made by Nosoco-Togo, invoking articles 24(2) and 27 of annex III to ABR-1999 in support of its appeal. However, the Supreme Court can rightfully raise a matter *ex officio* where public policy is concerned. The public policy concerned in this case was the general principle of *fraud omnia corrumpit* (“fraud corrupts all”). In a related case, the OAPI High Commission of Appeal had occasion to invoke that principle – in dismissing opposition to registration No. 43441, for the mark “Princesse Vignette”¹⁰¹ – to invalidate the mark cited in opposing it. From that standpoint, some reservations are in order about the decision in the present case.

99 ABR-2015, art. 31 provides for a double formality for the purposes of enforcement – namely, registration in the Special Register of Marks and publication in the official gazette.

100 See Cass. com., May 24, 1994, D. 1994, IR 55.

101 See HCA, Decision No. 32/CSR/OAPI of March 25, 2004, *Recueil des décisions de la Commission Supérieure de Recours* 2003–05, 18; see also *Cooper SA v. Laboratoire Bride SA*, Judgment No. 672 of September 17, 2003, High Court of Mfoundi (Douala) (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section F).

It becomes clear why Pastacorp took its later case to the Mfoundi High Court in Cameroon to invalidate the mark filed by Nosoco-Togo – this time alleging fraud as its basis. It goes without saying that, at the time of the disputed registration, Nosoco-Togo knew of the mark's prior registration by its long-time partner RCL. The fraud seems clear and the Mfoundi High Court's panel of judges was correct to affirm the following: "Considering that at the time Mr. Nabil Tarraf Koudjock registered the disputed mark, he was fully aware of the existence of an identical prior mark; that in so doing he committed fraud; that Pastacorp is thus entitled to request invalidation of that registration ... [and] its request needs to be granted." But while their reasoning is entirely sound, the Mfoundi judges seem to have solved one problem by creating another, more formidable one: the problem of respect in final court rulings for regional authority in matters concerning a title's validity.

II. Alteration of the rule of regional authority in final judicial decisions

Article 18 of ABR-1999 stipulates: "Final legal decisions relating to the validity of titles and rendered in one Member State under Annexes I to X of this Agreement shall be binding on all other Member States, with the exception of decisions based on public policy and morality."¹⁰² The decisions reported here severely test that principle (A) and could be perplexing for OAPI bodies implementing them (B).

A. Violation of article 18 of ABR-1999

Article 18 of ABR-1999 is a central pillar of the community edifice. The OAPI's founding plenipotentiaries intended from the outset to give regional effect to final judicial rulings issued in member states on the validity of titles, with a view to completing the framework erected through ordinary legislation over the years. In other words, despite its defects, the earlier Supreme Court judgment in the first case, invalidating the mark's initial 1981 registration under No. 21047, had acquired the status of *res judicata* under article 18 and should thus have been binding for the Mfoundi High Court judges in the second case. Pastacorp undoubtedly took advantage of the fault committed by Mr. Takounang and Nosoco-Togo to distract the Mfoundi judges from the Supreme Court's previous invalidation of its mark – for war, after all, is war! Be that as it may, the Mfoundi court ruling directly violated article 18 and, if not overturned, could create an impossible dilemma for relevant OAPI bodies.

¹⁰² This provision was amended by ABR-2015, art. 20, which provides further clarification of the principle of regional jurisdiction in final judicial decisions on the validity of titles. Article 20(1) states that: "Subject to the provisions of Article 4 above, final judicial decisions rendered in respect of the validity of titles in a Member State pursuant to the provisions of Annex I to Annex X of this Agreement shall be binding on all other Member States, save for decisions based on public policy and morality." Article 20(2) goes further: "Final judicial decisions rendered in a Member State in areas other than the validity of titles shall be enforceable in all other Member States pursuant to an *exequatur* decision rendered in accordance with the legislation of the State concerned, save for decisions based on public policy and morality."

B. The dilemma within OAPI

The dilemma that OAPI bodies could face is of a legal (1) and a practical nature (2).

1. The legal dilemma

According to article 28 of annex III to ABR-1999, "any final decision declaring the effects of the filing of a mark invalid on the national territory of one of the Member States shall be entered in the Special Register of Marks on notification by the judicial body concerned, and a mention thereof shall be published by the Organization." Applying that provision, the OAPI could face two final, but contrary, court rulings relating to the same trademark, held in two different member states, as in the present cases. The Supreme Court judgment in Togo, on July 21, 2011 (No. 47/11), invalidates the 1981 mark, No. 21047; the Mfoundi High Court judgment in Cameroon, on May 4, 2016 (No. 96/Com), restores the same mark. Choosing between those two decisions could prove a real conundrum for the OAPI. Purists would plainly accord pre-eminence to the Supreme Court judgment, coming from a country's highest court. But that might be hasty, and even artificial, there being no formal hierarchy among decisions made in different states. Nor can the OAPI, without risk to itself, favor one state over another. The situation therefore raises the prospect of empowering a regional intellectual property court to settle such issues.

2. The practical dimension of the dilemma

The implementation of the above-mentioned final judicial decisions by the competent technical services of OAPI, in application of article 24(3) of ABR-1999, has led to many administrative disputes. The High Commission of Appeal recently resolved this situation through a very interesting decision, which stipulates that, when a decision declaring registration null and void has become final, it shall be communicated to OAPI for entry in the special register of trademarks. Initially seized by Nosoco-Togo Sarl for the purpose of registering Adversarial Judgment (*Arrêt contradictoire*) No. 47 of the Supreme Court of Togo, OAPI refused to accept the request because the registration decision had not been communicated as the Bangui Agreement and its annexes stipulate.

On the other hand, OAPI responded favorably to the subsequent request of Pastacorp SA seeking to register judgments No. 095 and No. 096 handed down on May 4, 1996, by the High Court of Mfoundi. These two decisions invalidated, respectively, the "COUSCOUS SIPA + logo" No. 47511 and "COUSCOUS SIPA" No. 64509 trademarks belonging to Nosoco-Togo Sarl.¹⁰³ This dispute was brought before the college of judges of the High Commission of Appeal and settled in favor of Nosoco-Togo Sarl.¹⁰⁴ Notwithstanding this stance taken by the highest body for dispute settlement within OAPI, its competent services have still not executed the decision,

¹⁰³ The recording of these judgments was noted by the decisions of the Director General of OAPI No. 18/0513/OAPI/DG/DMSD/SSPD and No. 18/0512/OAPI/DG/DMSD/SSPD of April 27, 2018, unpublished.

¹⁰⁴ See Decision No. 0183/OAPI/CSR of October 30, 2014, unpublished.

obliging Nosoco-Togo Sarl to once again apply to the judges of the High Commission of Appeal, this time to invalidate the OAPI Director General's decisions to record in the special register of marks the judgments handed down by the Mfoundi Court of First Instance.

By Decision No. 0018/20/OAPI/CSR of November 17, 2020, the High Commission of Appeal put an end to this dispute at the administrative level through two actions: i) invalidation of the contested decisions of the Director General of OAPI and ii) an order to record, in the special register of marks, both Decision No. 47/11 of July 21, 2011 (handed down by the Supreme Court of Togo) and Decision No. 0183/OAPI/CSR of October 30, 2014 (handed down by the High Commission of Appeal). This significant decision reflects the regulatory role that this body must play within OAPI, which is required to comply with final court decisions handed down by the courts of its member states, in application of the Bangui Agreement and its annexes.

Max Lambert Ndéma Elongué

H. Trademark – Infringement – Fraudulent imitation – Infringing use – Provision – Loss of earnings – Commercial damage – Profit made – Damage suffered – Duty of care – License contract

If the materiality of a trademark infringement is left to the discretion of trial judges, it is on the condition that they not distort the facts presented. Judges cannot change a law by requiring circumstances not provided for therein.

The court must calculate compensation for damage suffered by the trademark owner on the basis of accounting data, including the infringer's profits.

“M...” SA V. “BA... IMPORT-EXPORT” SA, Judgment No. 425/Com of June 19, 1998, Court of Appeal of Dakar

Observations:

It is within a trial judge's discretion to establish whether an act of trademark infringement has taken place, on condition that they not distort the facts presented to them. Judges cannot change a law by requiring circumstances that the law does not mention. The court must base its calculation of compensation for damage suffered by the trademark owner on accounting data, including profits made by the infringer. These principles flow directly from annex III to ABR-1999 (and the 2015 revision), and from case law that is both plentiful and interesting. However, some of the judicial precedents concerned – including the judgment reported here – have been highly questionable.

Facts: The companies M... and Veuve M. C. et Fils, by acts dated September 2, 1980, and January 1, 1990, registered a brand of head gasket under the trademark “Meillor” with both the OAPI and the French National Institute of

Intellectual Property (Institut national de la propriété industrielle, or INPI). In exploiting the mark, the companies signed a license contract with an expiration date of May 3, 1993, with the company A.J., registered under Tunisian law.

Learning that the companies BA... Import-Export and Four... were importing their “Meillor” head gaskets from A.J. and selling them in Senegal without consent, M... and Veuve M. C. et Fils lodged a complaint with the Regional Court of Dakar¹⁰⁵ and, on August 6, 1996, obtained a court-ordered inventory of those products.

On August 22, 1996, M... and Veuve M. C. et Fils brought action for validation of the seizure, as performed on August 14, 1996, and the payment of CFAF 100 million in damages. The trial court ruled against the plaintiffs on all claims, reasoning that the defendants had not violated articles 37 and 38 of annex III to AB-1977.

M... and Veuve M. C. et Fils appealed that decision.

Reasoning: The Dakar Court of Appeal partially reversed the trial court's decision by validating the court-ordered inventory, as justified on the basis of infringing use, and ordering destruction of the samples. It also found the defendants, BA... Import-Export and Four..., liable under civil law but awarded only a symbolic single franc in damages to M... and Veuve M. C. et Fils.

In reaching this decision, the court had to consider two crucial questions, as follows.

- a. Does the import and sale of products constitute infringement if the trademark license of the originating company has expired?
- b. Can a trial judge remedy the damage resulting from such infringement if they are unable to quantify it fully?

The court did indeed find infringement – not in the sense of fraudulent imitation but rather “infringing use” – owing to the importer's negligence. It also found the defendants, BA... Import-Export and Four..., liable for contributing to the damage suffered by M... and Veuve M. C. et Fils, which amounted to an affirmative response to the second question above.

Provisions relevant to the case were set out in annex III to AB-1977, in force when the decision was rendered, and are now found especially in ABR-2015, which has clarified the categories of trademark infringement and better addressed the nagging question of compensation.¹⁰⁶

¹⁰⁵ The Dakar Regional Court “hors classe” became the High Court “hors classe” via Law No.2014-26 of November 3, 2014, repealing and replacing Law No. 84-19 of February 2, 1984, determining the judicial organization in Senegal.

¹⁰⁶ Cf. ABR-2015, art. 54 of annex III: “The court seized of the matter shall determine the amount of the damages, having regard to the adverse financial effects, including loss of earnings, suffered by the prejudiced party, the profit made by the counterfeiter and the moral damage caused to the owner of the rights as a result of the infringement.”

Important questions raised in this case relate to the trial court's ruling – namely, about:

- I. the penalty it imposed for importing and selling infringing products; and
- II. the assessment it made of the perpetrator's liability.

I. The trial court's finding of infringing import or sale of infringing products

In the initial ruling, the trial court found no changes made by BA... Import-Export or Four... to characteristics of the mark of a nature to deceive the buyer, and it therefore ruled out fraudulent imitation (A). What it found instead was "infringing use" (B).

A. Absence of any substantial change liable to deceive the buyer

In dismissing the claims of M... and Veuve M. C. et Fils, the Court of Appeal based its reasoning on whether any substantial modification was made to the "Meillor" mark to which the appellants held an exclusive right. Indeed, while AB-1977 was in force, the notion of fraudulent imitation was used as an alternative means to punish offending manufacturers not indictable for trademark counterfeiting. In this case, it is clear that fraudulent imitation, under article 38(a) of annex III to AB-1977, the basis on which the Court of Appeal assessed it, fell outside the scope of trademark counterfeiting.¹⁰⁷

The drafters of AB-1977 borrowed the same punishment as indicated for counterfeiting for persons who, "while not counterfeiting a mark," made a fraudulent imitation of one liable to deceive the buyer. However, the distinction thus drawn in that original version of the Agreement seems spurious if counterfeiting can consist of any reproduction or other use of a registered mark, in a manner liable to affect its image, without the owner's consent.¹⁰⁸

Fraudulent imitation falls well within that definition of counterfeiting. That point is now clarified in ABR-2015: "Any infringement of the rights of the owner of the mark as defined in Article 6 shall constitute counterfeiting."¹⁰⁹

Both ABR-1999 and ABR-2015 group all such offenses under the expression "unlawful exploitation of a registered mark."¹¹⁰ In French case law as well, fraudulent imitation of a mark liable to create confusion in public

perception constitutes counterfeiting.¹¹¹ The clarification is welcome, permitting any unlawful exploitation of a trademark to be treated as counterfeiting.¹¹²

In the present case, the Court of Appeal correctly ruled that imitation of the "Meillor" mark, as alleged by the appellants, had not been sufficiently established. Such imitation must consist of goods or services identical or similar to those designated in the application for registration. Case law on the subject indicates three conditions that must be met to establish such an unlawful imitation:

- a. imitation of a registered trademark through the use of aural, visual or conceptual elements;
- b. designation of identical or similar goods; and
- c. the likelihood of confusion among consumers.¹¹³

Unlawful imitation cannot be confirmed without evidence of very likely confusion and the burden of providing it rests with the party alleging the offense. At this level, the difference need not be characteristic or remarkable, but it does have to cause confusion for the buyer.¹¹⁴ A finding of fraudulent imitation of a mark must also consider the consumer. It is in terms of a consumer's ability to distinguish between the goods that the imitation is assessed in considering appropriate punishment.

In the present case, a bailiff report dated September 4, 1996, had established that the characteristics of the head gaskets stored by defendant companies BA... Import-Export and Four... were identical to those of the series 411-129 and 411-652, which bore a mark belonging to companies M... and Veuve M. C. et Fils. That report notwithstanding, the Court of Appeal determined that fraudulent imitation could not be confirmed, since "the companies M... and Veuve M. C. et Fils have not demonstrated the means by which the companies Four... and BA... Import-Export might have altered the characteristics of the 'Meillor' mark to taint the imitation as fraudulent." What the court found instead was "infringing use," consisting of the introduction and distribution of counterfeit goods.

B. Recognition of infringing use

Analyzing the facts of this case with reference to article 37(a) of annex III to AB-1977, the Court of Appeal found that, by importing counterfeit products, BA... Import-Export and Four... committed infringing use.

107 Article 38: "The following persons shall be punished by a fine of from 50,000 to 150,000 CFA francs and by imprisonment of one month to one year, or to either of these penalties: (a) persons who, while not counterfeiting a mark, have made a fraudulent imitation of one liable to mislead the buyer or who have made use of a fraudulently imitated mark ..."

108 By way of comparison, see AB-1977, art. 58 of annex I and art. 41 of annex II. According to those articles, any injury to patent or utility model rights by use of means forming the subject of the patent or utility model, by possession of stolen goods, by sale or display for sale, or by bringing into the territory of one of the member states constitutes the offense of counterfeiting.

109 Cf. ABR-2015, art. 49 of annex III.

110 Violations of AB-1977, arts. 37 and 38, are combined within ABR-1999, art. 37, which establishes penalties for offenses of omission and non-compliance with restrictions, including for using signs where that use is prohibited. See also ABR-2015, art. 57 of annex III.

111 *SA Iliad v. Cédric A*, Judgment of January 7, 2003, of TGI Paris, Third Chamber.

112 With regard to the requirement for identical or nearly identical reproduction, the Court of Justice of the European Union has ruled that "a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer": *C-291/00 LTJ Diffusion SA v. Sadas Vertbaudet SA*, Judgment of March 20, 2003, ECLI:EU:C:2003:169, at [54].

113 See ABR-2015, art. 6.

114 See *Iliad*, n. 110, in which the court held that, under art. L.713-3 of the Intellectual Property Code, "if it can result in confusion in the public perception ... the imitation of a mark and the use of an imitated mark for products that are identical or similar to those designated in the registration ... shall be prohibited." In this case, a modification substituting a hyphen for a letter within the mark "3617 An-u, l'annuaire inversé" is clearly an imitation.

Under article 37(a), such infringing use would have to consist of use by “those persons who have counterfeited a mark or who have made use of a counterfeited mark,” which requires a prior determination that the mark has been counterfeited.¹¹⁵

In settling on the notion of infringing use in this case, the appeal judge found the “Meillor” mark to have been counterfeited by the Tunisian company A.J. That offense is similar to “infringing reproduction,” which has been defined in case law as the reproduction of a mark in an identical form, with no deletions or additions, without the owner’s consent.¹¹⁶

M... granted A.J. the right to use its mark via a trademark license contract dated May 19, 1992, supplemented by a rider signed the same day, in Nantiat, France. But that license agreement was terminated on May 3, 1993. Therefore, at the time in 1996 when A.J. delivered to Four... the “Meillor” mark head gaskets, with the characteristics of the 411-129 and 411-652 series, A.J. no longer possessed the right to use that mark. As a result, M... and Veuve M. C. et Fils had every reason to protest the offer for sale of products bearing their “Meillor” mark, as registered with the OAPI and the INPI, the mark having been wrongfully affixed to the packages and head gaskets of the series 411-129 and 411-652, respectively, under headings No. 20698 and No. 45202.

This protection is referred to again in article 7 of annex III to ABR-1999 and article 6 of ABR-2015. It is indeed the owner of the mark who has an exclusive right to use it, or a sign resembling it, for the goods and services for which it was registered or for similar goods and services.¹¹⁷ However, the choice of the appellate judge to analyze the facts of the case from the perspective of infringing use seems questionable. For the purposes of article 37(a) of annex III to AB-1977, when a third-party manufacturer uses a mark without its owner’s authorization, it is said to “have made use of a counterfeited mark.”¹¹⁸ In the present case, it would have been more appropriate to apply article 37(c) and to assess the facts in terms of the sale or offer for sale of the goods concerned.

Indeed, it was established that BA... Import-Export and Four... had introduced and offered for sale counterfeit goods manufactured by the Tunisian company M..., which no longer had the right to use the “Meillor” mark.

115 See ABR-2015, art. 57 of annex III.

116 See *Forest Stewardship Council v. Boris Bois SARL*, Judgment No. 886/Civ of December 5, 2016, High Court of Wouri (Douala) (obs. A. Fade, this collection, Chapter 3, section B).

117 In AB-1977, this point is covered in art. 20. In ABR-1999, art. 7(2) of annex III confers another right on the owner of the mark – namely, “the exclusive right to prevent all third parties from making use in business without his consent, of identical or similar signs for goods or services that are themselves similar to those for which the trademark or service mark has been registered where such use is liable to cause confusion.”

118 A comparison of the provisions of AB-1977, arts. 37(a) and 38(b) of annex III, ABR-1999, arts. 37(1)(a) and 37(2)(b) of annex III, and ABR-2015, art. 57, suggests that infringing use requires not only the materiality of the use of an infringing mark but also the existence of indications likely to deceive the buyer about the nature of the product. In the latter two cases, use of the mark appears to be directed at the manufacturer and not at the seller.

Infringing use could thus have been established more easily against the manufacturer A.J., allowing the court to use the bundle of indicators established in case law to establish such infringement.¹¹⁹ Under revisions in ABR-1999, a finding of infringing use would require that the mark bear indications liable to mislead the buyer about the nature of the product.¹²⁰

Following its train of logic, having found infringing use, the court naturally held BA... Import-Export and Four... liable for it.

II. The trial court’s assessment of liability

Such liability resulted in this case from the importers’ contribution to the damage suffered by M... and Veuve M. C. et Fils (A), and the need to compensate them for that damage (B).

A. Liability for contributing to the damage

As grounds for its conclusion, the court observed that the importers introduced into Senegal counterfeit products bearing the “Meillor” mark, which mark belonged exclusively to M... and Veuve M. C. et Fils. Even if the defendants did not commit counterfeiting, the court reasoned, they would be punishable for infringing use. It is on that basis that the court linked them with the damage suffered.

The court considered the importers’ good faith in their dealings with A.J., finding the latter to have concealed the mutually agreed termination of its license by furnishing documents attesting to the contrary. But the court drew no conclusions from that good faith. No moral element of any kind entered into the reasoning with which it found the companies to have contributed to the damage suffered – and that is surprising. To consider this moral element and to find “honest use” would be to dismiss the counterfeiting charge – a principle affirmed by the French Court of Cassation.¹²¹ “Honest use” is a concept invoked to avoid systematic punishment when trademarks are used without consent.

Having drawn no such conclusions from the importing companies’ apparent good faith, the court then found them to have failed in their duty of care when they

119 See ABR-1999, arts. 37(1)(a) and 37(2)(b) of annex III. With regard to penalties, AB-1977 appears to sanction both manufacturers, on the one hand, and sellers or distributors, on the other. ABR-1999 is clearer in the case of patents and utility models, because art. 58 of annex I and art. 41 of annex II provide for receiving or selling an infringed patent. ABR-2015 did not change this: it provides for the same receiving in art. 55 of annex I and art. 61 of annex II. It would be positive if the 2015 version were to bring into widespread use as an act of infringement for all intellectual property works the receiving of stolen goods. However, it is debatable whether receiving a counterfeit mark could be penalized under art. 430 of the Criminal Code of Senegal, which states that “[t]hose who knowingly receive, in whole or in part, objects or goods that are stolen, diverted or obtained by means of a crime or an offense shall be punished with the penalties provided for in article 370.” Our reading of this provision leads us to answer in the affirmative. Possessing or holding an infringing object is an act of handling stolen goods that requires the judicial officials to establish that there was bad faith. See, e.g., C-65/12 *Leidseplein Beheer BV and Hendrikus de Vries v. Red Bull GmbH and Red Bull Nederland BV*, Judgment of the Court (First Chamber) of February 6, 2014, ECLI:EU:C:2014:49; CA Paris, January 23, 2012, Pôle 5, ch. 12.

120 See ABR-1999, art. 37(2)(b) of annex III.

121 Cass. com., July 7, 2017, No. 15-28114.

introduced counterfeit goods into the country. That approach seems problematic. Duty of care is defined not by legislation but in case law – albeit that a draft codification was once proposed in France, as part of legislation aiming to reform the country’s law of obligations, article 1242 of which draft treated failure to exercise duty of care as an offense and an “act which is objectively abnormal in relation to the conduct expected of a reasonable person.”¹²²

The court did not find such a failure in the present case, recalling instead the good faith shown by BA... Import-Export and Four..., having based their actions, as established in the case, on a license contract provided by A.J. and on all other information available to them. In these circumstances, a finding that they failed in their duty of care is questionable.¹²³ Moreover, the court did not sufficiently characterize the fault on which it based the liability of BA... Import-Export and Four... – a characterization all the more necessary because case law allows for judicial oversight in the matter.

In that vein, the French Court of Cassation has recently recalled a trial court’s obligation to characterize all aspects of any such fault, based on its discretionary assessment of the factual circumstances, and not merely to deduce from injury suffered in the case that a fault has been committed.¹²⁴

However, in the present case, the introduction of counterfeit products into Senegalese territory was itself sufficient for the Court of Appeal to hold BA... Import-Export and Four... liable and to consider what compensation might be in order.

B. Compensation for damage suffered by the owner of the counterfeited mark

In calculating compensation, the Court of Appeal first examined the damage suffered (1) and then determined the compensation mechanisms appropriate (2).

1. Damage resulting from trademark infringement

The court began by affirming that the damage suffered by the owner of an infringed trademark is estimated based on the profit made by the infringer from unlawfully selling the counterfeit objects, which can be correlated with profits lost to the victim.

Such a compensation mechanism, based on profitability to the perpetrator, would be specific to actions for counterfeiting. The principle generally followed in matters of civil liability is compensation in full of damage actually incurred, determined from the victim’s perspective.¹²⁵ In focusing on the perpetrator’s profit to determine the compensation amount, the Court of Appeal seems to have watered down the full compensation principle – to the victim’s detriment.

The decision’s significance, however, lies in its innovative approach. Punishing an infringer based on their own profit is a better way of discouraging unlawful practices and thus protecting intellectual property rights. Its virtually automatic character ensures that the compensation will, at a minimum, erase any profit the perpetrator may have made.

But the approach does have limitations: the damage done may be greater than the profit made. For compensation to be truly effective, the impact of counterfeiting on a trademark’s image must also be considered in assessing damage. That cannot be done if only profit to the perpetrator is considered. Two elements must also consistently be factored in when calculating compensation for counterfeiting victims: unlawful enrichment of the infringer, and damage to the mark’s reputation or prestige.¹²⁶

To address these concerns and encourage better compensation for the damage caused, ABR-2015 – the latest revision of the Agreement – has broadened the criteria for assessing damage from counterfeiting. They now include “the adverse financial effects, including loss of earnings suffered by the prejudiced party, the profit made by the counterfeiter and the moral damage caused to the owner of the rights as a result of the infringement.”¹²⁷ There is no disputing that profitability to the counterfeiter is a relevant and innovative criterion for assessing damage to the victim, but a court then hits a wall if information sufficient to quantify such profit cannot be found.

It may have been this difficulty that led M... and Veuve M. C. et Fils to formulate their claims for compensation based on article 134 of the Senegalese Code of Civil and Commercial Obligations (Code des Obligations Civiles et Commerciales, or COCC).¹²⁸ That provision establishes the principle of full compensation as follows: “Where the amount of damages depends directly or indirectly on the amount of the victim’s income, the compensation awarded is assessed by taking into account its tax

122 In the end, this definition was not eventually adopted under Order No. 2016-131 of February 10, 2016, on the reform of contract law, the general regime and proof of obligations: see *JORF*, February 11, 2016, 35, text No. 26.

123 See F. Desportes (2003) *La responsabilité pénale en matière d’infractions non-intentionnelles*. In *Cour de Cassation, Rapport 2002 de la cour de cassation*. Paris: La documentation française.

124 This principle has been laid down since a decision of 1873 (Cass. civ., April 15, 1873); it was recently recalled by the Second Civil Chamber (Cass. 2ème civ., No. 826 of June 14, 2018.17-14.781).

125 Cf. art. 134 COCC: “The damages must be determined in a way that they provide full compensation for the victim in relation to the damage suffered.”

126 Cass. civ., June 8, 2017, No. 15-21.357.

127 This method of determining damages has been widely adopted and similar wording has been included in various other annexes, in particular with regard to patents (art. 69), utility models (art. 61), trademarks (art. 54), industrial designs (art. 18-4), and geographical indications (art. 22-4) and others.

128 Article 134: “The damages must be determined in such a way that they provide full compensation for the victim in relation to the damage suffered. Where the amount of damages depends directly or indirectly on the amount of the victim’s income, the compensation awarded is assessed by taking into account its tax declarations covering the three years preceding the damages.”

declarations covering the three years preceding the damage.” Where the damage to be compensated results from counterfeiting, the liability envisaged represents an alternative way of awarding more than a symbolic single franc to the victim.¹²⁹

The damage invoked and the amounts claimed should, in any case, be demonstrated. ABR-1999, in its article 43 of annex III, refers to the trademark owner’s right to damages but does not define criteria for assessing them. Accordingly, considering such damage established in the case, the court proceeded to consider the appropriate remedies.

2. Remedies for prejudice sustained by the trademark owner

The Court of Appeal invoked basic rules of fairness to justify its decision to award a symbolic single franc. It did not purport to compensate the prejudice fully because it lacked the means needed to quantify it; the court encountered this obstacle because it limited itself to a single criterion – the infringer’s profit – for assessing damage.

Yet once damage has been established, determining its extent – which depends on the facts presented – should be less difficult.¹³⁰ In any case, difficulty in determining the extent of damage is not sufficient justification for awarding only a symbolic franc, which is clearly not enough – in terms of fairness or any other perspective – to remedy the damage actually suffered.¹³¹

The court itself acknowledged the inadequacy of the amount and, after validating the court-ordered inventory, it ordered additional measures, to include destruction of the samples and publication of excerpts from its decision in two daily newspapers, at the expense of BA... Import-Export and Four...

Destruction of the counterfeit goods was ordered under article 44 of annex III to AB-1977, which became

article 43 of annex III to ABR-1999.¹³² This is an effective remedy because it stops their circulation.¹³³ Even if imposed as a supplementary penalty, elimination of the counterfeit goods can be considered a form of compensation for the trademark owner.¹³⁴ However, in this case, in destroying only the two sealed samples handed over to the chief clerk of the Special Regional Court of Dakar, as recorded by the court bailiff in Dakar during the proceedings on August 14 and 27, 1996, the measure appears incomplete: *what about the rest of the stock?*

In this regard, the court said that it could not “order the destruction of goods it cannot at present identify, let alone enumerate” – a position that offers little protection for the exclusive holder of a trademark. It would mean a judge not ordering such destruction of goods, even where no doubt remains about their origin as counterfeits, unless the judge were able to identify and enumerate them. The court in this case observed that “the stock of products are still in the warehouses of the liable companies,” and hence ordering their seizure and eventual destruction seems a better way of remedying the prejudice suffered, for it was otherwise far from assured that circulation of the counterfeit goods would be stopped.

In addition to destruction, the publication of an excerpt from the judgment in the dailies *Walfadjiri* and *Le Soleil* was ordered on the basis of article 43(2) of annex III to AB-1977.¹³⁵ Publicity is also an effective deterrent, making consumers aware of the counterfeiter’s fraudulent behavior and hence less likely to buy from them. Care must be taken, however, to ensure that any such publicity does not mislead consumers about the grounds or scope of the judgment.¹³⁶

For the sake of expediency, the Court of Appeal in the present case made the costs of destruction and publication chargeable to the companies BA... Import-

129 Under the OAPI framework, ABR-1999, art. 63(1)(2) of annex VII provides for the following in the case of literary and artistic property: “The amount of damages shall be determined in accordance with the relevant provisions of the national civil code, taking into account the gravity of the material and moral prejudice suffered by the right holder and of the size of the profit that the infringer has derived from the infringement.” This provision is not of general scope and we consider it to be applicable only in this way. However, ABR-2015 contains corrections that provide for such a trademark provision – in particular, in art. 54 of annex III.

130 Of course, there may be cases in which the damage is not physically assessable for technical reasons – in particular, when assessment of the facts of the cause or of the measures to be ordered requires knowledge not available to the judge. However, even in such circumstances, the elements of the proceedings in particular, the alleged facts and the evidence in support of the claims must make it possible to assess the extent of the damage. In these circumstances, an expert’s opinion may be sought. See art. 156 *et seq.* of Senegal’s Code of Civil Procedure.

131 *Lindt et Sprungli SA v. Etablissement Public du Musée et du Domaine de Versailles*, CA Paris, March 9, 2005, *PIBD* 2005, 809, III, 45. In this case, it was considered that, since the damage suffered was purely symbolic, it would be compensated by the awarding of EUR 1. Moreover, the TGI Paris noted, in a judgment of July 4, 2003, that the plaintiff company had not produced “any document of any kind to justify its damage; that it did not have any infringement seizure made at the premises ... which would have made it possible to seize some accounting documents.” Nevertheless, it had awarded the sum of €7,000 in damages to the company holding the patent right and €10,000 to the exclusive licensee.

132 See *Colgate Palmolive Co. v. Banaboy Symphore Jacques*, Judgment No. 9/ Civ, of January 19, 2011, of the Court of First Instance of Bonanjo (Douala), Ohadata J-12-244. In this case, the judge held that: “[A] person who infringes a trademark when it has not been forfeited or deregistered is liable to infringement seizure of the counterfeit goods. As the seizure has been carried out according to regulations, the owner of the infringed mark, who possesses a certificate of non-forfeiture and a certificate that the mark has not been deregistered, may obtain from the competent court a ruling on the validity of the seizure carried out, all the while ordering the destruction of the counterfeit goods and the sentencing of the infringer to pay compensation for the damage suffered.”

133 In accordance with art. 133 COCC, the judge may even automatically order any measure designed to compensate the damage or to limit its extent.

134 ABR-2015, art. 55 of annex III, provides: “In the event of a conviction for counterfeiting, the competent domestic court may order, at the request of the injured party, that the goods found to be counterfeit and the materials and instruments that mainly served in their creation or manufacture be withdrawn from commercial channels, definitively removed from such channels, destroyed or confiscated.” Given that a civil party cannot request the application of a penalty, even a supplementary one, the prerogatives thus granted to the injured party can be considered only as measures of compensation in kind. Indeed, this is the meaning of art. 133(2) COCC.

135 Now ABR-2015, art. 55(2).

136 Along these lines, the French Court of Cassation has recalled that “publication on the website of a company of a court decision favorable to that company may constitute an act of unfair competition if the victim has abused its right to communicate by omitting certain elements that could alter the assessment of third parties on the decision”: Cass. com., October 18, 2017, No. 15-27.136.

Export and Four..., with the victim to execute the measures directly and seek reimbursement of the costs upon presentation of proper invoices and a copy of the conviction ruling.

Malick Lamotte

I. Infringement seizure – Seizure for counterfeiting – Automatic invalidation – Non-alteration of court proceedings – Prejudice stemming from a seizure – Judge’s discretionary power – No search for bad faith – Compensation – Counterclaim concerning the ownership of the mark – Admissibility

According to article 52 of annex III to ABR-2015, in respect of a trademark, when an application to obtain a seizure for counterfeiting is granted, the applicant must submit the matter to the competent court via either civil or criminal law proceedings within 10 working days. If this obligation is not met, the court-ordered inventory or seizure practiced shall become void, without prejudice to any damages that may be claimed.

Consequently, based on article 52, a judge asked to rule on a request to find the seizure void as of right should not enter into questions about ownership of the mark, or whether the seizure was made in good or bad faith.

NAZAIRE GNANHOUE V. SOLA CO., Judgment No. 70/15 of March 4, 2015, Court of Appeal of Lomé

Observations:

According to article 6 of annex III to ABR-2015, registration of a mark confers on its owner a right of ownership of the mark when used in relation to the goods and services the owner designated. The owner thus enjoys an exclusive right to use the mark and to prevent others from using it. When the owner considers that another has used its mark without its consent, or another has registered an infringing mark at a later date, it can bring court proceedings alleging infringement or seeking cancellation of the subsequently registered mark. In preparation for a trial on the merits, the president of the competent court may authorize the owner of the mark to seize the allegedly counterfeit products, under article 51 of annex III to ABR-2015 (former ABR-1999, art. 48) on seizure for counterfeiting. According to article 52 (former ABR-1999, art. 49), the owner then has 10 days in which to submit the matter to a civil or criminal court, failing which the seizure becomes void as of right, without prejudice to any counterclaim for damages by the distrainee. The Lomé Court of Appeal applied these principles in the present case.

Facts: On January 2, 2009, Établissements Sola (Sola) obtained execution of an “infringement seizure” (the term in ABR-1999, later replaced by “seizure for counterfeiting” in ABR-2015) targeting goods bearing the mark “Cookzen,” marketed by Mr. Nazaire Gnanhoue.

Sola then voluntarily released the goods with a view to later confiscation.

Seeing the distrainers fail thereafter to initiate substantive proceedings within the 10 days allowed for under article 49 of annex III to ABR-1999, then in force,¹³⁷ Mr. Gnanhoue took the matter before the Lomé Court of First Instance, on January 27, 2009, requesting that Sola’s seizure be found void as of right, under articles 48 and 49 of ABR-1999, and claiming related damages.

By its judgment No. 3503/9, of November 13, 2009, the Lomé Court of First Instance dismissed Mr. Gnanhoue’s requests and canceled the “Cookzen” mark he was claiming as his own. The court had found no prior decision rendering the seizure void and considered the disputed mark to belong to Sola, the first to register it with the OAPI. The court also ordered Mr. Gnanhoue to pay compensation, granting a counterclaim for damages by Sola as owner of the contested mark.

On February 15, 2010, Mr. Gnanhoue appealed, arguing that the Court of First Instance was at fault for ruling on ownership of the “Cookzen” mark rather than focusing on his request to find the seizure void as of right.

Reasoning: The Lomé Court of Appeal, in its judgment of March 4, 2015, reversed the contested judgment, invalidated the seizure, awarded damages to Mr. Gnanhoue and dismissed Sola’s request to cancel the appellant’s mark, as well as the company’s claim for damages.

The Court of Appeal reasoned that the Court of First Instance had an obligation to declare the infringement seizure void as of right and to remedy the damage caused. This answered the central question put to it: what is the scope of a judge’s discretionary power, in cases based on article 49 of annex III to ABR-1999,¹³⁸ where a distrainer fails in the obligation to take legal action within 10 working days of an infringement seizure?

It is therefore important, based on the court’s highly relevant reasoning, to examine the scope of that obligation (section I), as well as a judge’s duty to remedy damage resulting from a seizure declared void as of right (section II).

I. The obligation to bring trial court proceedings within the prescribed time limit following an infringement seizure

The Lomé Court of Appeal, differing from the trial court, found that Sola had failed in its obligation to take action within 10 days of the seizure report of January 2, 2009. This accords with article 49 of annex III to ABR-1999,¹³⁹ which sanctions such failure by making the inventory or seizure void as of right.

¹³⁷ Now ABR-2015, art. 52 of annex III.

¹³⁸ *Ibid.*

¹³⁹ *Ibid.*

The purpose of article 49¹⁴⁰ is to protect the distrainee in such cases against potential abuses of the seizure order. It requires a distrainer to take action on the merits within a very short period – just 10 days. ABR-1999 and ABR-2015 are both strict on that point, treating seizure as justified only when preliminary to court action – as a means of securing of the alleged offense – and thus void as of right if no such action is taken.¹⁴¹ The Agreement confers extensive investigative powers on the distrainer that must be used solely as required for such proceedings and not for intimidation. That is why the distrainee must not be left in doubt and why article 49¹⁴² allows so limited a time for subsequent action. It is therefore important for a judge dealing with such cases to verify compliance with the deadline – which raises the issue of how the deadline is reckoned.

The Court of Appeal had no difficulty in finding Sola non-compliant. For one thing, Sola acknowledged as much when it released the seized goods in a bid to avoid expiration of the seizure's validity and to escape liability for related damages. For another, Sola brought no action on the merits in time to preserve the seizure's validity. Clarification is required, however, about how the time limit is reckoned, which bears on the outcome of the seizure itself. The points of reference for assessing a distrainer's timeliness in taking action are, in principle, the date of the seizure and the date of the summons for court proceedings.¹⁴³ Case law and legal scholars largely concur that what counts for the summons is the date of delivery; registration with the court can take place later.¹⁴⁴

Moreover, where an applicant chooses to proceed in the criminal courts, the date to consider is that on which the competent court is seized, including through the mechanism of private prosecution. A simple complaint does not suffice to meet the obligation to take action¹⁴⁵ – but what of the private prosecution? It is admittedly filed with the examining magistrate, rather than the competent trial court, but has the virtue, unlike a simple complaint, of triggering public prosecution. It must therefore be accepted as consistent with the spirit of article 48 of annex III to ABR-1999.¹⁴⁶

The court in the present case accepted the job of reckoning the time limit, but it did so from the date on which “the respondent carried out the seizure, on January 2, 2009, which gave it 10 working days from that

date” to take action on the merits. The respondent had still not done so, the court observed, “by January 27, 2009, the date when the appellant seized the first judge.” Accordingly, the court found the seizure void as of right under article 49.

Article 49 provides effective punishment by making a seizure or inventory void as of right should the distrainer, in alleging trademark infringement, fail to take action on the merits within 10 days. The expression “void as of right” (“void *ipso jure*” in ABR-1999) allows the judge no discretion in pronouncing it. Judges must confine themselves to verifying compliance with the legal time limit and, in the absence of such compliance, declaring the seizure void. The Court of First Instance, the Court of Appeal argued, should thus have declared the seizure void, more than 10 days having passed between January 2, 2009 (the date of the seizure) and January 27, 2009 (when action was brought for its annulment).

The Court of Appeal also clarified – concurring on this point with the Court of First Instance – that the respondent's voluntary release of the items seized did not alter the judge's obligation, if the conditions under article 49 had been met, to find the seizure void as of right. A judge of first instance cannot, as the court correctly said, make such a finding subject to a prior decision by another judge. To do so would be to legislate on top of article 49.

The court also found the Court of First Instance at fault for entering into debate about the mark's ownership. According to the Court of Appeal, a judge asked to rule on an infringement seizure should do no more than verify the mark's ownership and the alleged offense against it.¹⁴⁷

It is here, however, that the question of the judge's discretion arises. On the one hand, in the case of a simple court-ordered inventory, where no goods are actually taken, the judge has no discretion once it is proven that the mark has been registered and has neither lapsed nor been canceled.¹⁴⁸ This is to safeguard the rights of the mark's owner. In the case of actual seizure, on the other hand, the judge needs to retain full and exclusive discretion:¹⁴⁹ if the offense is not subsequently established, an action for compensation may not be sufficient to preserve the interests of the alleged offender.

It is also important to consider the position taken by the Court of First Instance, as confirmed by the Court of Appeal, that release of the items seized has no impact on the action to void the seizure. What, then, is the point of voiding a seizure already withdrawn?

140 *Ibid.*

141 Infringement seizure is an extreme measure under ordinary law and is intended to provide evidence of alleged infringement. Its purpose is to collect material that would establish the existence of the alleged infringement. In short, it assembles evidence in anticipation of a future trial. See P. Véron (2013/14) *Saisie-contrefaçon*, 3rd edn. Paris: Dalloz; U.N. Mezatio (2017) *La saisie-contrefaçon en matière de marque et de brevet dans l'espace OAPI*, <https://cabinetjogo.com/la-saisie-contrefacon-en-matiere-de-marque-et-de-brevet-dans-lespace-oapi>

142 ABR-2015, art. 52 of annex III.

143 Cass. com., July 7, 2015, No. 14-12.733; CA Paris, Fourth Chamber, December 15, 2006, *PIBD* 2007, No. 847, III, 183.

144 TGI Paris, May 27, 1994, *PIBD* 1994, No. 573, III, 459; TGI Rouen, February 27, 1997, *PIBD* 1997, 631, III, 246; CA Paris, May 26, 1994, *PIBD* 1994, No. 574, III, 487.

145 See P. Véron and I. Romet (2015/16) *Droit et pratique des voies d'exécution*. Paris: Dalloz, ch. 1214.

146 ABR-2015, art. 51 of annex III.

147 ABR-1999, art. 48(2) of annex III; ABR-2015, art. 51: “The order shall be made on request, subject to proof that the mark is registered and that it has neither lapsed nor been canceled.”

148 CA Aix-en-Provence, December 1, 1976, *PIBD* 1977, No. 186, 63; TGI Paris, Third Chamber, February 8, 2013, RG No. 10/14491.

149 See, in this regard, F. Greffe (2005) *Contrefaçon-constatation-saisie-contrefaçon*. *JurisClasseur Marques-Dessins et modèles*, Fasc. 3470, No. 11; J.-P. Stenger (2003) *Saisie-contrefaçon – Introduction*. *Ordonnance autorisant la saisie-contrefaçon*. *JurisClasseur Brevets*, Fasc. 4631, No. 61 (the judge would have no choice but to authorize a real infringement seizure of the goods).

The seizure of allegedly counterfeit goods, performed pursuant to article 48 of annex III to ABR-1999, renders the goods unavailable for sale, depriving the distrainee of the right to market them. Consequently, voluntary release of the goods by the distrainer makes those goods available again, as does the seizure being found void by a judge. The distrainee regains the right to dispose of its goods, while the distrainer loses the samples to be used as evidence in court and any means of regaining them through confiscation. It is consequently hard to see the point of voiding a seizure already withdrawn. As in the cases of protective seizure or attachment and sale,¹⁵⁰ the request in this case to void the infringement seizure could have been dismissed. In other cases, however, if the goods are released after being immobilized for a certain number of days, voiding the seizure might be worthwhile if there is a prospect of claiming damages.

Ruling the seizure void for failure to comply with article 49, the Court of Appeal turned to the issue of damages.

II. Obligation to compensate damage resulting from a seizure voided as of right

According to article 49 of annex III to ABR-1999, an alleged counterfeiter subjected to an infringement seizure can claim damages if the distrainer does not take action under either civil or criminal law within the 10-day time limit. Apart from that basic principle, the Agreement's drafters do not specify a legal framework for liability in the context of such seizures. Based on the wording of article 49, liability is not automatic, since voiding the seizure does not automatically result in damages. The framework for liability under ordinary civil law is based on fault, damage and a causal link – formulated in article 1382 of the French Civil Code thus: "Any act of man causing damage to another must be remedied by the person whose fault it was."¹⁵¹

But article 49 does not preclude liability for abuses of process. The wording "without prejudice to any damages that may be claimed" provides no basis for assessing such damages. As the Court of Appeal admitted, an action for damages resulting from a seizure later voided could be based on abuse of the procedure¹⁵² – especially where, as in the present case, not a few samples but an entire stock of goods was seized. The court acknowledged as much: "The immobilization of an allegedly infringing shipment of goods beyond the legal time limit, exercising an exorbitant prerogative under ordinary law to constitute evidence for future proceedings, unquestionably does harm to the owner

of those goods." In that regard, the respondents could hardly argue their own good faith or the alleged bad faith of the appellant as reasons to dismiss the latter's claim for compensation. It was undisputedly their own failure to bring timely action on the merits of the case that led to the seizure becoming void.

Ultimately, it is quite logical that the court did not pursue intent to harm, since what is punished under article 49 is failing to follow the seizure with timely judicial action.

The question of a distrainee's bad faith, as the court rightly noted, cannot be addressed while the infringement seizure is in dispute. Proceedings on that point are not intended to address the merits of a case but to build evidence. The court was also right to limit debate on the claim for compensation: it was based only on the seizure becoming void through the appellant's own fault. It was thus on that basis that, while dismissing the grounds based on good and bad faith, the court accepted the appellant's claim for damages and awarded the reasonable sum of CFAF 20 million.¹⁵³

After reversing the trial court's judgment and admitting the action for compensation, the court also dismissed Sola's counterclaim for ownership of the "Cookzen" trademark, on grounds of a lack of supporting evidence.

In terms of the effects of the court's decision, its solution has merits. It is in line with the general tendency in trademark law to reserve for a mark's holders the right to prevent its use by another. It is the exclusive character of trademark rights, after all, that is protected.¹⁵⁴ As the court also observed, based on the evidence presented, the "Cookzen" trademark filed by Sola was deregistered "at the request of Hangzou Richland Foods Co. Ltd., a Chinese company which had in fact filed it first." The court thus declined to acknowledge Sola's right to the mark and rightly dismissed its counterclaim.

Malick Lamotte

J. Infringement seizure – Seizure as part of a criminal investigation – No prior order by the president – Validity of the seizure – No invalidity of the investigation report

According to article 48 of annex III to ABR-1999 (reformulated as "seizure for counterfeiting" in article 51 of annex III to ABR-2015), infringement seizures fall under the jurisdiction of the president of the competent civil court. However, that provision does not preclude the exercise of powers conferred by domestic criminal law on judicial police officers and investigating judges in the context of criminal proceedings.

150 These seizures are provided for under arts. 54 *et seq.* and 90 *et seq.* of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures: see *Société Europress – Editores e Distribuidores de Publicações LDA v. Compagnie Beauchemin International Inc.*, Interim order No. 124 of July 20, 2004, Regional Court of Niamey (obs. J. Fometeu, this collection, Chapter 1, section C).

151 See art. 119 COCC: "Any person who causes damage to others by their fault is liable."

152 Cf. art. 122 COCC: "Any person who uses their right with the sole intention of harming another, or who makes use of it for an intention contrary to its purpose, commits an abuse of law."

153 On the procedures for compensation, see *MP and Amandatou Adechokan v. Fati Younoussa and Salamatou Younoussa*, Judgment of July 18, 2006, Court of Appeal of Brazzaville (obs. M. Lamotte, this collection, Chapter 3, section D).

154 Cf. ABR-1999, art. 7 of annex III, now ABR-2015, art. 6 of annex III.

Consequently, where a public prosecutor has ordered a seizure procedure against a defendant accused of importing counterfeit goods and offering them for sale, a criminal court that decides to void the procedure on the ground that the order authorizing it was not made by the civil party in the dispute – despite the seizure being conducted by judicial police officers within the framework of a preliminary investigation – misapplies articles 47 and 48 of annex III to ABR-1999 (articles 49 and 51 of annex III to ABR-2015).

MP AND NESTLÉ SA V. AMINATOU LASSISSI, Judgment of April 16, 2008, Court of First Instance of Lomé, First Criminal Chamber

Observations:

Infringement seizure is simply a supplementary and often very effective means of proving infringement. As observed in an analogous case: “There is no statutory or regulatory requirement to use this particular means of proof before bringing the case to a judge.”¹⁵⁵ In this case, however, the Lomé Court of First Instance seems to have forgotten that principle.

Facts: Nestlé, owner of the “Maggi Poulet” cubes trademark, lodged a complaint with the public prosecutor of the Lomé Court of First Instance against Mrs. Aminatou Lassissi for the sale or offer for sale of counterfeit “Maggi Poulet” cubes. On the basis of this complaint, 1,800 cartons of such goods belonging to Mrs. Lassissi were seized. Mrs. Lassissi was subsequently summoned before the criminal court and charged with the sale or offer for sale, on Togolese territory, of goods bearing a fraudulently imitated trademark or indications likely to deceive the buyer as to the nature of the goods.

Counsel for Mrs. Lassissi, in an effort to stymie the substantive proceedings at the very outset, objected, arguing that the seizure was void for violation of article 48 of annex III to ABR-1999 (article 51 of annex III to ABR-2015), on the basis that it had been conducted without prior authorization being applied for or obtained from the president of the Court of First Instance.

Reasoning: Ruling in favor of Mrs. Lassissi, the Lomé court:

- declared the seizure null and void;
- invalidated preliminary investigation report No. 77/2007, issued on October 22, 2007, by the Central Office Against Unlawful Drug-trafficking and Money Laundering; and
- ordered the return of the seized objects to Mrs. Lassissi and dismissed the charges against her.

The Lomé Court of First Instance thus responded affirmatively to an important question: whether actual physical seizures in criminal matters, in the context of trademark infringement proceedings, are subject to prior authorization by the president of the competent court. In this decision, the court appears to assert that

all potential seizures in connection with trademarks are formally subject to the prior authorization required under article 48.

Yet that position suggests some confusion over the provisions governing seizures in cases of counterfeiting (section I), subjecting the validity of a criminal procedure to that for “infringement seizures,” as specified in the Agreement and subject to conditions outlined therein (section II).

I. Confusion over the provisions governing trademark infringement seizures

In dismissing the counterfeiting charges against Mrs. Lassissi, the Lomé Court of First Instance observed the plaintiffs’ failure to provide evidence of an order from the president of the competent civil court authorizing the seizure, as required by article 48. Article 48 stipulates:

“The owner of a mark or holder of an exclusive right of exploitation may, acting in pursuance of an order from the president of the civil court within whose jurisdiction the action is to be taken, including at the border, engage bailiffs or public or ministerial officials, including customs officials, if necessary with the aid of an expert, to make a detailed inventory, with or without seizure, of the goods or services that he claims have been marked, provided or furnished to his prejudice in breach of the provisions of this Annex.”

Article 48 thus treats seizures in such cases as a probative measure, permitting the holder of an intellectual property right to engage a public officer for that purpose. The result is generally a description of the infringement alleged, its extent and surrounding circumstances, and, in certain cases, an inventory of the allegedly infringing articles with or without the physical seizure of samples or even all such articles. The Dakar Court of Appeal noted in a similar case that “this seizure is only to allow a purported victim to provide evidence that its rights have been infringed.”¹⁵⁶

Article 48 thus allows a detailed court-ordered inventory to be accompanied by actual seizure of the allegedly infringing product or samples thereof. Such a seizure can be ordered upon request by the president of the civil court having territorial jurisdiction. That is the basis on which Mrs. Lassissi impugned the civil party, Nestlé SA, for conducting an infringement seizure without prior authorization from the president of the court concerned. The Lomé Court of First Instance concurred, ruling that the seizure of cubes marked “Maggi” by judicial police officers, executed at the direction of the public prosecutor, constituted a violation of article 48, such authority being reserved under that provision for the president of the civil court.

¹⁵⁶ See *Ameropa SA v. Mustapha Tall SA*, Judgment No. 501 of December 28, 2012, Court of Appeal of Dakar (obs. M. Lamotte, this collection, Chapter 3, section K).

¹⁵⁵ TGI de Strasbourg, February 5, 1991, *PIBD* 1991, III, 339 *et seq.*

The question, then, is this: *did the public prosecutor have such authority?*

In answer to that question, consider the following. When an infringement action is brought in criminal proceedings, the public prosecutor receives a complaint from the victim, or a denunciation¹⁵⁷ – but the public prosecutor does not thereby forgo the traditional prosecutorial prerogatives of their office.¹⁵⁸ Under ordinary law, in the case of a *flagrante delicto* investigation or even a preliminary one, the public prosecutor can perform or order “all acts necessary for the investigation and prosecution” of the offense.¹⁵⁹ For probative as well as confiscatory purposes, the public prosecutor can direct judicial police officers to seize allegedly offending (e.g. counterfeit) objects, instruments used or intended for use in committing the offense and anything that appears to result directly or indirectly from it.¹⁶⁰ The investigating judge, upon receiving a bill of indictment from the public prosecutor, or a complaint filed as private prosecution by a trademark owner or licensee, has the same powers to conduct investigations and seizures.¹⁶¹ Under article 47 of annex III to ABR-1999 (now article 55 of annex III to ABR-2015), a criminal court can subsequently order confiscation as a supplementary penalty.

All such seizures are criminal procedures,¹⁶² specific to criminal proceedings. Their validity does not require the court order indicated in article 48 of annex III to ABR-1999.¹⁶³

The court therefore erred in granting the annulment sought by counsel to Mrs. Lassissi on the ground that Nestlé did not produce evidence of such an order, the seizure having been executed by judicial police officers on the instructions of the public prosecutor as part of a preliminary criminal investigation.

The court should have noticed the confusion between infringement seizure, which requires an order from the president of the competent civil court under article 48 of annex III to ABR-1999,¹⁶⁴ and seizures performed in criminal matters under the Togolese Code of Criminal Procedure, which gives seizure power to judicial police officers, the public prosecutor and the investigating judge engaged in an investigation or preliminary inquiry into trademark counterfeiting.

The Lomé court should have dismissed the defendant’s request to void the seizure.

In finding for the defendant instead, it voided the entire procedure, including preliminary investigation report No. 77/2007 of October 22, 2007, by the Central Office for Unlawful Drug-trafficking and Money Laundering. It then went on to order the return to Mrs. Lassissi of the 1,800 cartons of the “Maggi” cubes seized from her.

For the reasons explained, that decision is a clear misapplication of article 48 of annex III to ABR-1999.¹⁶⁵

II. Violation of the conditions for admissibility of criminal proceedings for counterfeiting

Having embraced the grounds for the defendant’s request – the violation of article 48 of annex III to ABR-1999 – the court’s decision to dismiss the criminal charges against her went a step further: “As no order by the president of the court concerned was produced by counsel for the civil party, the proceedings should be dismissed entirely, for violation of article 48 of the Bangui Agreement, with the consequences stipulated in article 265 of the Code of Criminal Procedure.”

The court thus conditioned the validity of a criminal investigation report, and of the criminal proceedings themselves, on the validity of the seizure as such, dismissing the public prosecutor’s case without a trial on the merits. The court seems to have been unaware that infringement seizure, as defined in article 48, is merely a means of proof and that voiding such a procedure cannot legitimately invalidate a criminal case against counterfeiting. The public prosecutor forfeits some of their evidence but can still present other means of proof. This is a point often recalled by the French Court of Cassation: “The nullity of a counterfeit seizure, which is a probative act preliminary to, and initiated only through, prosecution for counterfeiting, does not constitute grounds for a procedural objection.”¹⁶⁶

Failure to produce the president’s order authorizing, or even voiding, the seizure cannot in principle – contrary to the court’s position – affect the validity of the proceedings. How, then, can we interpret the court’s decision? On what basis does it declare the procedure invalid? Why does the invalidity extend to the entire proceedings? The judgment offers no answers to those questions. The court provided no grounds for the invalidation. The difficulty is understandable: articles 37 and 47 of annex III to ABR-1999 (articles 57 and 49, respectively, of annex III to ABR-2015) – the touchstones for litigants alleging infringement – mention no penalties for flaws of procedure. Their wording on the conditions for bringing criminal proceedings for infringement is terse,¹⁶⁷ leaving it to domestic courts to apply the procedures applicable under ordinary law.

157 See, in this regard, art. 32 of each of Togo’s and Senegal’s Codes of Criminal Procedure.

158 Articles 31–36 of Togo’s Code of Criminal Procedure; arts. 31–38 of Senegal’s Code of Criminal Procedure. See, in this regard, J. Pradel and J.-P. Laborde (1997) *Du Ministère public en matière pénale*. *D.* 1997, chron. 141.

159 Articles 34 and 61 of Togo’s Code of Criminal Procedure; arts. 33, 60 and 67 of Senegal’s Code of Criminal Procedure.

160 Article 44 of Togo’s Code of Criminal Procedure; Article 46 of Senegal’s Code of Criminal Procedure.

161 Articles 41 and 64 of Togo’s Code of Criminal Procedure; Articles 72 and 87 bis of Togo’s Code of Criminal Procedure; Articles 72 and 87 bis of Senegal’s Code of Criminal Procedure.

162 Pradel, J., *Procédure pénale*, 17th ed., n. 70, at 390.

163 Article 51 of annex III to ABR-2015

164 Ibid.

165 Ibid.

166 Cass. civ., January 19, 2010, *JurisData*, No. 2008-370800.

167 See art. 47 (2) of annex III to ABR-1999 and art. 6 (2) of annex III to ABR-2015.

In other words, the court's invalidation of the proceedings could not be based on annex III to ABR-1999. The latest revision, ABR-2015, deals with various intellectual property rights and their protection by administrative and judicial means. It affirms that the Agreement is not intended to regulate the principles of criminal procedure, which remain subject to state sovereignty. In the sphere of criminal law, its provisions regulate offenses of and penalties for only the infringement of intellectual property rights. Nor does the court invoke Togolese criminal procedures that could justify invalidating the proceedings, for there is no textual basis for doing so.

In criminal law, the invalidity of a procedural act and the scope of its invalidity must, in principle, be prescribed by law.¹⁶⁸ The only exception is where important provisions of criminal procedure have been violated.¹⁶⁹ The court made no mention of any substantive provisions of Togolese criminal procedure supposedly violated by the public prosecutor. It therefore had no basis for voiding the investigation report and dismissing the proceedings before the merits of the counterfeiting allegations could be considered. Indeed, the court had an obligation to declare Mrs. Lassissi either guilty or not guilty, but it failed to do so. Errors committed by the civil party in respect of the seizure, even if demonstrated, should have had no bearing on the public prosecutor's charges against her, which related to the substance of the law, the guilt of the accused and the claim for compensation. The public prosecution of counterfeiting cannot legitimately be hindered by such procedural issues; it is the public prosecutor's role to act independently. The initiation of criminal prosecution for infringement of trademarks, as opposed to patents, utility models or industrial designs,¹⁷⁰ cannot be made subject to a preliminary complaint by the victim.¹⁷¹

In the end, to ensure legitimate protection for intellectual property rights under ABR-2015, judges in OAPI countries will do well *not* to follow the path taken here by the Lomé Court of First Instance.

Malick Lamotte

K. Trademarks – Likelihood of confusion – No actual seizure of allegedly infringing goods – Limiting seizure to a few samples

Infringement seizures are merely a specific means of proving infringement. Their purpose is not to punish the alleged infringer. Accordingly, they must not be so general in scope that a distrainer can seek and seize any time, any place, any goods based only on an assumption that they are infringing.

¹⁶⁸ See arts. 164 and 168 of Senegal's Code of Criminal Procedure.

¹⁶⁹ Art. 166 of Senegal's Code of Criminal Procedure.

¹⁷⁰ Art. 61 of annex I, art. 44 of annex II and art. 30 of annex IV to ABR-1999: "Criminal action seeking the imposition of the above penalties may only be brought by the Office of the Public Prosecutor on a complaint by the injured party."

¹⁷¹ Art. 46 of annex III to ABR-2015.

A judge receiving a request for retraction cannot enter into the merits of infringement allegations.

AMEROPA SA V. MUSTAPHA TALL SA, Judgment No. 501 of December 28, 2012, Court of Appeal of Dakar

Observations:

Infringement seizure is a means of proving infringement, including counterfeiting, of an intellectual property right. It is a procedure requiring the president of the competent civil court to authorize the owner of an intellectual property right to engage a court bailiff or public officer to verify that infringement has occurred. If the application or appeal is granted, any party concerned can refer the matter back to the court president who issued the order, subject to the conditions laid down in domestic law.¹⁷² A judge receiving such a complaint can modify or retract their order, even if the case has already gone to trial. The purpose of such proceedings is not to ascertain whether the alleged infringement has actually occurred – that is to be proved through the seizure – but to reassess the merits of the application, this time in light of the alleged infringer's defense. The Dakar Court of Appeal recalled those principles in the case reported here.

Facts: Moustapha Tall SA, claiming ownership of the trademark "le bon cheval légendaire + logo" (filed with the OAPI on December 30, 2008, and registered on August 17, 2009, under No. 60828), applied to the president of the Dakar Special Regional Court for authorization of an infringement seizure of rice contained in green bags bearing a "horse logo" resembling its own. The bags of rice had been received by Ameropa SA and stored at a Sonafor customs warehouse.

By orders No. 929/2012 and No. 1000/2012 of June 22, 2012, issued by the president of the Court,¹⁷³ Moustapha Tall was authorized to obtain a detailed court-ordered inventory of the allegedly infringing products. The authorization included actual seizure, on the premises of Sonafor and of all merchants operating within the court's jurisdiction, or any other location, of all goods bearing elements characteristic of the mark and intended for sale by Ameropa.

Pursuant to article 49 of annex III to ABR-1999,¹⁷⁴ Moustapha Tall summoned Ameropa to appear before the regional court on July 19, 2012, asking the court to establish the infringing character of the product, obtain its destruction (or otherwise prevent it from being marketed) and have it withdrawn from sale if marketing had begun.

By writ dated July 10, 2012, Ameropa summoned Moustapha Tall in return to appear without delay before the regional court president to request retraction of order No. 1000/2012 of June 22, 2012, and to limit actual

¹⁷² See arts. 820-8 and 820-9 of Senegal's Code of Civil Procedure.

¹⁷³ The Dakar Tribunal de Grande Instance Hors Classe since 2015.

¹⁷⁴ Now ABR-2015, art. 52 of annex III.

seizure to a few samples. The regional court dismissed the request for retraction, and confirmed its order for the inventory and the seizure of all products presumed to be infringing.

It was this last order that Ameropa submitted for review to the Dakar Court of Appeal. Among other grounds, it argued that the motions judge erred in ordering the seizure of its entire stock of products, and that there was no likelihood of confusion between the products it marketed and those belonging to the plaintiff.

The Court of Appeal in this case had two questions to answer, as follows.

- a. Can a motions judge invoke article 48 of annex III to ABR-1999 to order actual seizure of an entire stock of allegedly infringing goods?¹⁷⁵
- b. Can they also assess the ownership of the trademark and the veracity of the infringement allegation within the context of proceedings for retraction of their own order to seize the goods?

Reasoning: The Dakar Court of Appeal answered first that infringement seizure is for probative purposes and thus cannot apply to an entire stock of supposedly infringing goods, and second, that the proceedings for retraction of an infringement seizure are not substantive and thus not the forum for discussing the merits of an infringement case. It is clear, therefore, that:

- I. infringement seizure is only a specific means of proving infringement; and
- II. a judge ordering a detailed inventory combined with actual seizure must specify the scope of the latter.

I. Court-ordered inventory as a specific means to prove infringement

In the statement of grounds for its decision, the Court of Appeal emphasized the exclusively probative purpose of the court-ordered inventory obtained by Moustapha Tall. Accordingly, the scope of proceedings initiated by Ameropa for retraction of that court order could not include the merits of the infringement case itself.

In validating the order, the Court of Appeal explained that the court-ordered inventory arranged by Moustapha Tall “merely allows the victim of an alleged infringement to provide evidence of infringement.” According to article 48 of annex III of ABR-1999,¹⁷⁶ as the court notes:

“The owner of a mark or holder of an exclusive right of exploitation may, acting in pursuance of an order from the president of the civil court within whose jurisdiction the action is to be taken, including at the border, engage bailiffs or public or ministerial officials, including customs officials, if necessary with the aid of an expert, to make a detailed inventory, with or without seizure, of

the goods or services that he claims have been marked, provided or furnished to his prejudice in breach of the provisions of this Annex.”

A trademark registrant suspecting unlawful infringement of its intellectual property rights can, by right, request a court-ordered inventory or seizure,¹⁷⁷ and if the legal conditions are met, the judge cannot refuse.¹⁷⁸ Infringement seizure is a means of proving infringement. It has been defined as “the measure enabling the owner of an intellectual property right to engage a public officer to conduct investigations, generally including a court-ordered inventory, of the alleged infringement, its circumstances and its extent.”¹⁷⁹ Moreover, the term “seizure,” as Pierre Véron has observed, is used improperly here; rather, it is the inventory that is described.¹⁸⁰ An inventory must make as faithful a representation as possible, from the distrainer’s viewpoint, of the infringed product. The product remains, in principle, in the hands of the distrainee, who may freely dispose of it unless the court seized with the matter considers it necessary, at the request of the holder of the trademark, to order the seizure of samples claimed to be marked, delivered or supplied to its detriment.

An inventory or seizure helps at a later stage, during consideration of the merits, to prove the existence and extent of an alleged infringement. It is the court-ordered inventory, in other words, that is the main purpose of the procedure, as recalled on numerous occasions in doctrine and case law.¹⁸¹ The application to the judge for order of that inventory must be as detailed as possible, since the authorization is based strictly on what is requested.

In the present case, in an order of June 22, 2012, the president of the regional court authorized Moustapha Tall to “engage Mademba Gueye, bailiff for Dakar, to conduct a detailed court-ordered inventory of the allegedly infringing goods” – an order that is too broad, in light of the above, lacking the precision needed to avoid possible abuse in the bailiff’s execution of it.

A cautious, precise approach is crucial, given the probative importance assigned to the bailiff’s report by article 48.¹⁸² The Court of Appeal affirmed this point by observing that the grounds Ameropa invoked in its defense “do not call into question the validity and intrinsic elements of the court-ordered inventory report of June 15, 2012, whose description, as observed and stated by the bailiff, holds true until proven otherwise.”

If the order is granted, an allegedly infringing third party can always request that the same judge retract it if it can

175 Now ABR-2015, art. 51 of annex III.

176 Article 51 of ABR-2015.

177 In this regard, see also Stenger, n. 147.

178 See P. Roubier (1952) *Le droit de la propriété industrielle*, vol. 1. Paris: Sirey, 426.

179 P. Véron (2005) *Saisie-contrefaçon*, 2nd edn. Paris: Dalloz, No. 11.

180 P. Véron (ed.) (2013/14) *Saisie-contrefaçon*, 3rd edn. Paris: Dalloz, 487 *et seq.*

181 See J.-C. Galloux (2000) *Droit de la propriété industrielle*. Paris: Dalloz, No. 489.

182 The report, like any act of bailiff, is a public document that, according to art. 18 of Senegal’s Code of Obligations, is authentic until proven otherwise.

be considered prejudicial to the third party's own rights.¹⁸³ According to the court, however, its proceedings were neither the place nor the time to discuss the merits of the infringement allegation.

Significantly, the procedure initiated by Ameropa for retraction of order No. 1000/2012 of June 22, 2012, was based not on ABR-1999 and its annexes, which do not expressly provide for it, but on the general system of motions or orders upon request, as regulated by the civil procedures of each member state.¹⁸⁴ The essential purpose of that procedure is to open adversarial proceedings to any affected party. In the context of infringement seizure, it is hard to imagine anyone but the distrainee requesting such a procedure.¹⁸⁵

A judge who orders such a procedure unilaterally in such circumstances, based solely on the version of the presumed right holder, must then reassess the seizure application and how it was granted, this time in light of the alleged infringer's defense.

As the court appropriately recalled, however, proceedings for the retraction or modification of an infringement seizure order are not the forum for discussion of the merits of a case or to assess whether alleged infringement has actually occurred. The purpose of an infringement seizure is not to look for infringement but to prove it.¹⁸⁶

That was the court's response to Ameropa, whose grounds for appeal related solely to the merits of the case, disputing the infringement allegation with arguments based on differences between characteristics of the Moustapha Tall mark and those described in the inventory, the protection obtained for its own mark through registration with the OAPI and the absence of any exclusive right for Moustapha Tall to use the mark.

The Court of Appeal was right to avert discussion on the merits of the infringement allegations in the context of proceedings against the initial judge's seizure order. A judge who is asked to order an infringement seizure, or to retract or modify such an order, must exercise no more than superficial, *prima facie* control, making sure that the distrainer's right to the mark is both valid and obvious, and that signs of third-party infringement (i.e. by the distrainee) are present.

Since it is the purpose of infringement seizure to obtain evidence of infringement, the initial signs of it need not be overly broad. To demand proof at this stage would be

self-defeating.¹⁸⁷ The distrainee will have the opportunity for such discussion during proceedings on the merits, which the distrainer must initiate within 10 working days or else risk invalidation of the seizure as of right.

Another interesting aspect of this case is that, in accepting the validity of the court-ordered inventory, the Court of Appeal did no more than verify the registration of Moustapha Tall's "horse + logo" trademark – as No. 3201102761, by order No. 12/1252/OAPI/DG/DGA/DPI/SSD of May 31, 2012 – without proof that the mark had neither lapsed nor been canceled, as required by article 48 of annex III to ABR-1999.¹⁸⁸

The court also ruled on the validity of the actual seizure so ordered.

II. The extent of the actual seizure for infringement

In the recitals for its decision, the court duly distinguished the court-ordered inventory from the actual seizure or physical removal of goods.

In its first recital, it upheld the court-ordered inventory. In its second, with regard to the actual seizure of the distrainee's entire stock of goods, the court finds the first judge to be at fault for issuing "a general order allowing the applicant to sue any infringer, at any time and any place, without being restricted to the stock stored on Sonafor premises."

On the scope of actual seizure in infringement cases,¹⁸⁹ the court sided with Ameropa in disputing the authority of the judge for urgent applications to order seizure of the defendant's entire stock. At this stage of the proceedings, the court reasoned, the infringement was merely alleged. Its purported victim did not need to seize the defendant's entire stock to prove infringement; a few samples would have sufficed. Seizure of it all, while not indispensable for the plaintiff, could have been seriously detrimental to the defendant.

The court stated its reason for invalidating the seizure, based on its extent, as follows: "Actual seizure, which retains a probative purpose, cannot take on a protective form to cover the entire stock of infringing products." Here, the court exercises prudence, given the material and moral damage that can result from actual seizure.¹⁹⁰ That is why article 48 of annex III to ABR-1999,¹⁹¹ in regulating infringement seizure, enables the judge for urgent applications to require security from seizure applicants, thereby discouraging rash or vexatious requests aimed at harming competitors. Such security must, in principle, be of sufficient amount to compensate damage to the distrainee if the seizure

183 See *Société S v. Société RCFG*. – *Recueil de décisions de justice*, Interim order No. 867 of June 20, 1995, of the High Court of Douala, OAPI collection No. 3, 393.

184 Article 820-8 of Senegal's Code of Civil Procedure: "[I]f the application or petition for appeal is granted, any party concerned may at any time refer the matter to the presiding judge who issued the order."

185 See J.-P. Stenger (2004) *Saisie-contrefaçon – Recours après saisie-contrefaçon*. *JurisClasseur Brevets*, Fasc. 4634, No. 125 *et seq.*

186 A. Mendoza-Caminade (2007) *La saisie-contrefaçon: une mesure aux allures de sanction*. In *A propos de la sanction: études réunies et présentées par Corinne Mascala* (Les Traavaux de l'IFR). Toulouse: Presse de l'Université Toulouse Capitole, 117–134.

187 J. Azéma *et al.* (2006) *Lamy Droit commercial*. Paris: Wolters Kluwer, No. 2040: "The applicant is not obliged to justify likelihood of infringement, which is the purpose of the seizure procedure to establish."

188 Now ABR-2015, art. 51 of annex III.

189 Stenger, n. 185.

190 Cass. com., January 4, 1985, *Bull. civ.* 1985, IV, No. 9, API 1985, 237 (note P. Mathély), *PIBD* 1985, 373.

191 Now ABR-2015, art 51 of annex III.

proves unwarranted, because the abuse of rights can be significant. Penalties can, of course, be assessed later, but the preliminary security requirement remains essential as a more expeditious means of remedy and a more effective curb on excess.¹⁹²

The court's decision to invalidate the actual seizure in this case therefore reflects a commendably balanced and prudent approach to the issue, although perhaps one not entirely consistent with article 48 of annex III to ABR-1999.¹⁹³ The court affirmed that actual seizure, being for probative purposes only, cannot take an entire stock of supposedly infringing goods without becoming a protective seizure. That affirmation does not flow from article 48 of annex III to ABR-1999, which refers to a "detailed inventory, with or without seizure, of the goods or services that he claims have been marked." The text thus covers the general modalities of such seizures rather well, but its lack of precision as to extent is regrettable.

In any case, article 48 provides no basis for a court to infer any legal restrictions as to actual seizure in infringement cases. Seizure of an entire stock of goods may in some cases be justified, as Moustapha Tall sought to establish in the present case, arguing that "the sale of these bags of rice on the Senegalese market would inevitably lead to both product confusion and unfair competition," potentially causing "commercial harm or even loss of income."

Actual seizure of an entire stock can be justified where any delay in taking action could cause *irreparable harm* to a mark's holder. An example of such action drawn from the TRIPS Agreement is "to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance."¹⁹⁴ Prevention of irreparable harm is a concept now enshrined in article 50 of annex III to ABR-2015: "The competent domestic court may also order all urgent measures on application where the circumstances require that such measures should not be taken *inter partes*, in particular where any delay is likely to cause irreparable harm to the applicant." Seizure for counterfeiting, while not envisaged in the article so entitled, article 51 of annex III, is now recognized as a procedure that the judge for urgent applications is authorized to order, even though the legal basis for doing so tends to vary.

In short, where irreparable harm may be imminent, actual seizure can be ordered on request.

By way of comparison, the seizure of stocks of goods is allowed under article L.716-7 of the French Intellectual Property Code (Code de la Propriété Intellectuelle, or CPI). Actual seizure can thus cover all goods or services alleged to be infringing and in violation of the distrainer's

rights. That is quite broad, as already recognized by various decisions in OAPI countries.¹⁹⁵

Be that as it may, it seems that Fernand de Vischer and Françoise Jacques de Dixmude rightly surmise that, as the use of infringement seizure develops and as the risks generated become clearer, a more balanced approach to the procedure will be required.¹⁹⁶ To achieve the right balance where stocks of goods are concerned, security must be required systematically, as provided for in article 51 of annex III to ABR-2015 in relation to trademarks: "Where grounds for seizure exist, the above-mentioned order may require the applicant to make a security deposit which he must provide before the seizure is effected. The deposit shall be adequate without deterring applicants from availing themselves of the procedure."

Proper enforcement of that provision by judges should encourage seizure applicants to moderate their demands.

Malick Lamotte

L. Trademark – Claim of right of priority – Restoration of priority – Violation of prior right

A claim of priority for a mark made to the OAPI two years after its initial filing in a third country is time-barred and therefore inoperative, notwithstanding a decision by the Director General of the OAPI to restore the priority claimed, the judge having found failure to meet the conditions required by OAPI regulations to restore such rights.

The initial registration of a mark based on a flawed right of priority cannot have priority over the subsequent registration of an identical or similar sign.

SIVOP SA V. ANGEL COSMETICS SA, Civil judgment No. 187 of March 21, 2013, Court of First Instance of Yopougon

Observations:

Within the union established by article 4 of the Paris Convention for the Protection of Industrial Property,¹⁹⁷ right of priority in trademark matters is a means to relieve applicants of the need to file applications simultaneously in every country where protection might be needed and to allow applicants a certain period of time from their initial filing in one member country to

192 Cass. com., March 11, 2003, *JCP G* 2003, IV, 1842: "Infringement seizure must be used in accordance with its purpose, because otherwise it is likely to generate abuses and its legitimacy and scope will be diminished."

193 Now ABR-2015, art 51 of annex III.

194 See art. 50 TRIPS.

195 See *Société B.SA v. Société S Sénégal*, Judgments No. 1847 of November 27, 2002, of the Regional Court of Dakar, in Edou Edou, n. 20, at 247–256; *Sté Air L and ors v. Sté A.S Cameroun*, Judgment No. 250 of January 24, 1996, High Court of Mfoundi (Yaoundé), in Edou Edou, n. 20, at 266–269.

196 F. de Visscher and F.J. de Dixmude (2001) *La saisie-description en Belgique: une mesure probatoire et parfois conservatoire. Les cahiers de propriété intellectuelle*, 13, 2, 465–486.

197 The Convention was signed on March 20, 1883, revised in Stockholm on July 14, 1967, and amended on September 28, 1979. It is one of the core agreements administered by the WIPO and all the WIPO member states have acceded to it.

make parallel filings in others without risk of losing priority to other possible applicants. Such applicants might otherwise seek to profit from publication of the first filing to file the same sign first in other states.¹⁹⁸ The decision reported here sheds valuable light on the conditions behind the implementation of this right of priority, as regulated by article 11 of annex III to ABR-1999, pursuant to article 4 of the Paris Convention.

Facts: Ivorian company SIVOP SA, asserting its prior right over the “CAROLIGHT” trademark and logo, as registered with the OAPI on November 30, 2006, under No. 54659, for goods in classes 3, 20 and 25, lodged a complaint against Angel Cosmetics SA, located in Kinshasa, before the Yopougon Court of First Instance, for cancellation of the same mark registered under No. 57,406 on October 17, 2005, in the name of Angel Cosmetics. In return, Angel Cosmetics claimed the prior right to the “CAROLIGHT” trademark under its Congolese right of priority, as restored by the Director General of the OAPI by Decision No. 217/OAPIDG/DPI/DAJ/SSD/SAJ of October 11, 2007. Angel Cosmetics had, in fact, filed the “CAROLIGHT” trademark in the Congo on the date stated, that country being a non-member country of OAPI but a party to the Paris Convention.

Angel Cosmetics was aware that its claim to priority was late: it should have reached the OAPI no more than three months after the original application. The company had therefore requested and obtained restoration of its Congolese right of priority from the OAPI Director General. The company argued that this gave it retroactive ownership of the mark as from October 12, 2005, when it filed its mark in the Congo. Angel Cosmetics also said it had simultaneously filed its opposition with the OAPI to registration of the same mark being sought by SIVOP, arguing that the civil proceedings under way before the Yopougon court could not conclude until that prejudicial issue had been settled by the competent authority.

The Yopougon court faced two questions. First, in considering a request for cancellation of a trademark, should it defer its decision until the OAPI had finished considering simultaneous opposition to registration of the same mark? Second, can the foreign filer of a trademark claim priority that has been wrongly restored by the Director General to gain priority over the same mark filed first with the OAPI?

Reasoning: The Yopougon court answered the first question in the negative, denying the stay of proceedings requested and thus giving precedence to judicial decisions in member states over those issued by OAPI statutory bodies (section I). In answer to the second question, the court denied the priority claimed, based on its preliminary review of the conditions for exercising such priority (section II).

I. Precedence of decisions by the courts over those by OAPI statutory bodies

The precedence of court decisions over those made by OAPI bodies is established in ABR-1999 and is a recurring theme in the enforcement of intellectual property rights. According to article 18 of the Agreement’s general provisions: “Final legal decisions relating to the validity of titles and rendered in one member state under the provisions of Annexes I to X of this Agreement shall be binding on all other member states, with the exception of decisions based on public policy and morality.” It is on the basis of that community provision that the judge drafting the court’s decision rightly denied the stay of proceedings requested by Angel Cosmetics: “[T]his provision is consistent with article 18 of ABR-1999, which establishes the primacy of authoritative, independent judicial decisions over those taken by OAPI statutory bodies and subjects the latter to civil court censure for their acts and decisions relating to industrial property protection.”

It is thus clear that court decisions on the validity of industrial property ownership are binding on right holders and industrial property offices alike. The authority of decisions by OAPI bodies in attributing title to industrial property rights is not absolute. Such decisions confer the presumption of such rights but no certainty as to their existence or validity. By way of illustration with regard to patents, article 22(1) of annex I to ABR-1999 provides that “the grant of patents shall be at the applicant’s own risk and without any guarantee either as to the reality, novelty or merits of the invention or as to the truth or accuracy of the description.” It is ultimately up to the courts to determine whether a right is legally protected or not. That principle applies to both the creation and continuing validity of industrial property rights.

As to the inception of such rights, it is a judge who ultimately decides, after examining the legal conditions for such protection, whether an industrial property title has been legitimately issued.

As to a title’s continuing validity, a judge can declare it void, canceled or lapsed in response to either a principal or incidental claim.¹⁹⁹ It can also declare the cancellation or forfeiture of a trademark restored by the competent OAPI organ. From that point of view, Decision No. 217/OAPIDG/DPI/DAJ/SSD/SAJ by the OAPI Director General, of October 11, 2007, restoring priority in the Congo of mark No. 57406, “CAROLIGHT,” as from October 17, 2005, was not binding on the court, which had the power to revoke it if finding the necessary legal conditions deficient. It was, in fact, after examining those conditions that the court denied Angel Cosmetics the benefits of priority and thus overrode the Director General.

¹⁹⁹ For more information on this issue, see M.L. Ndéma Elongué (2012) *La propriété intellectuelle à l’épreuve de la justice des pays membres de l’OAPI. In Mélanges offerts à Denis Ekani* (OAPI Collection No. 4), Paris: L’Harmattan, 189 *et seq.*

¹⁹⁸ See Passa, n. 82, at 560.

Once final, such a decision is naturally binding on the OAPI under the combined provisions of article 18 of ABR-1999 and article 24(3) of its annex III. According to the latter provision, when the decision declaring the registration invalid becomes final, it must be notified to the OAPI.²⁰⁰ According to rule 6(1) of the Organization's regulations under ABR-1999, the decision is to be conveyed to the OAPI by the first party undertaking to do so.

II. Conditions required for exercising right of priority

The exercise of a prior right is subject to certain conditions in the above-mentioned laws. The court's decision to cancel the "CAROLIGHT" trademark, No. 57,406 of September 4, 2007, registered by Angel Cosmetics, was grounded in the latter's infringement of the earlier right acquired by SIVOP in registering the same trademark on November 30, 2006, under No. 54,659. The court made that decision after denying the priority claimed in the Congo by Angel Cosmetics for trademark No. 57,406, because the latter had failed to comply with formal and material requirements laid down in OAPI legislation.

It is important to note that while ABR-1999 (article 11(1) of annex III) does not expressly provide for the restoration of priority, ABR-2015 now does so. In the latter version, article 12(5) of annex III reads as follows: "However, the right of priority referred to in paragraph 4 above may be restored in accordance with Article 21 below." It is only since the adoption of the Regulations on Restoring Rights, in Cotonou on December 4, 2004,²⁰¹ that such restoration can be granted under ABR-1999.

Examining those regulations in conjunction with articles 11(1) and 25 of annex III to ABR-1999, it is clear that restoration of the priority of an earlier registration must be applied for within three months after its original filing date. The application must include:

- a full statement of the grounds for restoration, with supporting documents;
- a written declaration stating the date and number of the original application for registration; and
- a certified true copy of, and receipt of deposit for, said original application, or alternatively, a document establishing or assigning priority or the translation of such document.

The sphere of trademark restoration was initially limited to the hypothesis in article 25, of failure to renew protection for a trademark. The cited regulations on restoration of rights broadened the scope of restoration to include applicants having failed to submit the priority document in a timely fashion.

According to SIVOP, the OAPI Director General should not have accepted the application for restoring the priority

claimed by Angel Cosmetics, insofar as the latter's supporting document was certified as a true copy not by the appropriate office (the Zairian Office of Industrial Property) but by the civil registrar of a third country. However, the relevant provision in ABR-1999 (article 11(1) (b) of annex III), does not specify which authority must certify the copy. Logically speaking, the prerogative should rest with the industrial property office, as well as any other competent local authority. That suggests that this formal requirement had been met in this case (although the authority of the Malian civil registrar, which physically certified the copy, seems open to question). In any event, this involvement of an authority from a country other than that of the office responsible gives a taste of the exceptional circumstances invoked by Angel Cosmetics.

With regard to the conditions, article 25(1) of annex III to ABR-1999 provides for restoration if non-renewal of the mark has resulted from circumstances beyond the registrant's control.²⁰² In support of its request for restoration, Angel Cosmetics indicated two circumstances beyond its control: the fault of an agent, and the political and military crisis in the Congo. The High Commission of Appeal had long considered an agent's fault to be a circumstance beyond the registrant's control.²⁰³ But its interpretation eventually grew stricter, requiring applicants to prove diligence and follow-up in recovering their rights.²⁰⁴

Angel Cosmetics, however, could neither prove the circumstances depicted nor specify the nature of the fault alleged. SIVOP, meanwhile, produced letters from the Congolese government and postal service disproving the existence of such circumstances during the time in question. SIVOP argued that this stripped away the legal basis for Angel Cosmetics' bid to restore the priority of its mark and rendered the Director General's decision invalid. In short, the trademark filed by Angel Cosmetics as No. 57,406 on September 4, 2007, being invalid, could not have priority over the same mark filed by SIVOP, No. 54,659, on November 30, 2006.

In addition to that argument, SIVOP sought invalidation of the Director General's decision to restore the priority of Angel Cosmetics in the Congo as a misuse of procedure. The restoration of priority, it reasoned, pertained to registrations received by the OAPI or in one of its member states. The beneficiaries of registration in third countries could benefit from OAPI protection only by applying for extension of the original protection to the OAPI space under article 45 of ABR-1999.²⁰⁵ Curiously, the

202 Article 4 of the Regulations on the Restoration of Rights states that circumstances beyond the registration holder's control must be understood to mean accidental and unavoidable events, for example interruption of postal services and loss or delayed delivery of mail.

203 See Decisions No. 29/SCR/OAPI of October 31, 2003, No. 41/CSR/OAPI of October 29, 2004, and No. 50/CSR/OAPI of April 1, 2005, *Recueil des décisions de la commission supérieure de recours*, Sessions 2003–05.

204 See Decisions No. 102/CSR/OAPI of April 27, 2007, and No. 103/CSR/OAPI of April 27, 2007. Also see in this regard CSR Decision No. 103/CSR/OAPI of April 27, 2007 (obs. F. Ekani, *La Gazette* 2008, 4, 10).

205 ABR-1999, art. 45(1), stipulates that: "Titles in force in a State prior to its accession to this Agreement shall continue to have effect in that State in accordance with the legislation in force when they were applied for."

200 See ABR-2015, art. 28(3).

201 The subject of Resolution No. 44/13, adopted by the 44th session of the OAPI Board of Directors.

Court of First Instance accepted this argument, which suggests confusion between a claim of priority and a request for the extension of protection. A *claim of priority* is where applicants for extension from third countries that are members of the Paris Union, as in the present case, claim the date of the first filing for all subsequent filings of the same trademark in the other states. A *request for extension* settles the fate of registrations granted in a state prior to its accession to the OAPI.

That reservation aside, however, the decision warrants approbation.

Max Lambert Ndéma Elongué

M. Use of a trademark as an internet domain name – Unfair competition – Bad faith – Determining the author of a competitive act

A company that knowingly and for commercial ends uses as a domain name the registered trademark of an online payment service in disregard of the trademark owner's rights has committed the fault of unfair competition under articles 1 *et seq.* of annex VIII to ABR-1999, together with the national civil code.

Liability for the impugned acts rests with both the registrant of the domain name and any user in bad faith of that domain name.

SONATEL MOBILES SA V. AGENCE TOUBA SÉNÉGAL AND GPS GROUP, Judgment No. 57 of May 17, 2017, Supreme Court of Senegal

Observations:

Conflicts between trademarks and domain names are becoming frequent in the OAPI space owing to the increasing popularity of the internet in member states. This is evidenced by the surge in the registration of domain names, which have become a source of both revenue and multifaceted disputes. Domain names are addresses that denote the location of servers, websites or users. The characters they contain help to identify or locate the domain owners or areas of activity. Domain names are currently managed at the global level by the Internet Corporation for Assigned Names and Numbers (ICANN). However, the responsibility for registering domain names lies with US-based company Network Solutions Inc. A number of IT service providers accredited as registrars by Network Solutions act as technical intermediaries between ICANN and network users.

Conflicts arise essentially from the lack of coordination between trademark registration systems and domain name registration systems. This has led to the practice of cybersquatting – that is, registering domain names containing the trademarks of third parties with a view to selling the names to those parties. André R. Bertrand notes that, unlike trademarks registered by public authorities OAPI in the Central and West Africa

subregion), which are enforceable only on specific territories, domain name registration systems are not geographically bound or dependent on any government.²⁰⁶

In the case under review, the dispute between the trademark holder and the domain name registrant falls broadly within the realm of unfair competition, as covered in articles 1 *et seq.* of annex VIII to ABR-1999.²⁰⁷

Facts: The facts are relatively straightforward. Agence Touba Sénégal (Touba) – holder of the “sen-factures” service trademark for a remote invoice payment system, which had been filed with the OAPI on January 30, 2006, with effect from April 12, 2005 – initiated legal proceedings against Sonatel Mobiles for unfair competition and payment of damages for having used the trademark for commercial ends without its consent. The defendant company claimed that it had used the trademark not as the owner and provider of the disputed payment service but as a client of the GPS Group – itself belonging to Gie Gainde 2000, owner of the domain name “senfactures.sn,” having registered it as such in Senegal in January 2005, prior to Touba’s use and filing of its similar trademark. The trial court ruled in favor of Touba, but its ruling was quashed by the Dakar Court of Appeal.

The Supreme Court then overturned the appeal court’s reversal and referred the case to the Kaolack Court of Appeal, which ruled for Touba.

Reasoning: Consistent in its reasoning, the Supreme Court ultimately rejected a subsequent appeal by Sonatel Mobiles, bringing this judicial saga to a close. The Supreme Court was asked in this case to resolve two key questions: had unfair competition occurred? And if so, who should be held responsible?

The Supreme Court reasoned, first, that the prohibition on the use of a registered trademark without the permission of its holder, under article 7 of annex III to ABR-1999, is general and applies to third parties irrespective of the category of activity concerned. In the course of industrial and commercial activities, the court went on to say, unfair competition can consist of any act, including use of a trademark that creates or is likely to create confusion.

The court’s reasoning seems to blur the line between trademark infringement and unfair competition, requiring us to re-examine the true intent of this litigation. Since unfair competition presupposes a wrongful act, the first step is to assess the competitive act concerned (section I). The party or parties responsible for that act must then be identified (section II).

206 A.R. Bertrand (2005) *Droit des marques, signes distinctifs-noms de domaine*, 2nd edn. Paris: Dalloz, 373.

207 See also articles 1–9 of ABR-2015.

I. Assessing the competitive act

The unfair competition alleged in this case by Touba, based on article 1(1)(a) of annex VIII to ABR-1999, presupposed the exercise of a competing activity (A) and bad faith (B).

A. The competing activity

The non-exhaustive instances of unfair competition enumerated in annex VIII include confusion with another's enterprise or activities, damage to another's image or reputation, disparagement of another's enterprise or activities and violations of confidentiality. In the case reported here, the act impugned by the plaintiff related to confusion with a registered trademark, based on article 2(2) of annex VIII. Touba alleged Sonatel Mobiles was at fault for using the domain name "senfactures.sn," an imitation of its own eponymous trademark for a remote invoice payment system, as filed with the OAPI on January 30, 2006, with effect from April 12, 2005. The existence of unfair competition in this case depended on how likely the domain name was to cause confusion with the trademark in the minds of the public.

The imitation in this case was beyond doubt. The domain name "senfactures.sn" is phonetically identical to the "sen-factures" trademark filed by Touba, so the similarity was clear and the difference in spelling inconsequential. As a matter of comparative law, the Court of Justice of the European Union has found similarity to be sufficiently clear where a sign "reproduces, without any modification or addition, all the elements constituting the trademark, or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."²⁰⁸ Even the non-identical reproduction of a trademark, or the products or services associated with it, may be considered a source of confusion within the meaning of article 2(1) and (2)(a) of annex VIII to ABR-1999.²⁰⁹

It is accepted in the case law that domain name extensions need not be considered when estimating the likelihood of confusion. By way of background, a domain name consists of a root and an extension. Over the years, ICANN has created new extensions for generic top-level domains to meet high demand for new web addresses. In one pertinent case, the company Gandi cited its trademarks "Gandi" and "Gandi-net" as grounds for action against registrants of domain names containing "gandi-info." The Paris High Court held that since the disputed domain names consisted of a root and an extension, and the extension denoted the generic domain, only the root "Gandi" should be considered in assessing imitation.²¹⁰ While this decision concerned trademark infringement, the reasoning behind it applies perfectly to unfair competition, particularly in establishing the likelihood of confusion. In the case

under review, that likelihood stems from the root of the disputed domain name ("senfactures") being identical to the registered trademark ("sen-factures"), the domain name extension (".sn") being of little import.

The imitation causing the confusion in this case also concerned the service provided under the "sen-factures" trademark – namely, remote invoice payment. In a similar case, albeit one relating to copyright infringement, the Nanterre High Court reasoned that the content of an impugned website must be compared with the goods and services for which protection is claimed.²¹¹ In the same vein, the Versailles Court of Appeal denied protection under a class 38 trademark (telecommunications) against the mark's use in a domain name, regardless of other considerations. According to that court, class 38 services should be understood as having their stated purpose (communication, messaging, etc.), not liable to be confused with the many services for which computer communications, electronic messaging, the internet or other media are simply means.²¹²

In the present case, the registrant of the disputed domain name was providing, via its website www.senfactures.sn, a service identical to that designated by the Touba trademark (remote payment of invoices), with a website layout highly likely to mislead internet users as to the company providing the service.

B. Bad faith

The meaning of bad faith is best conveyed by the expression "contrary to honest practice" used in article 1(1)(a) of annex VIII to ABR-1999. Under that article, reproducing a trademark as a domain name is not in itself punishable as an act of unfair competition; there must also be bad faith or dishonest behavior in the exercise of industrial and commercial activities. Broadly speaking, bad faith must be assessed relative to the date of registration of the disputed domain name. In the case of "senfactures.sn," that was in January 2005, before the "sen-factures" trademark was filed with the OAPI (on 30 January 2006 with effect from 12 April 2005). This raises serious doubts as to the bad faith of the registrant of the domain name "senfactures.sn."

The question of acknowledging prior claims by domain name users has been debated in the literature, as well as in the courts. Some decisions have denied ownership status within the meaning of intellectual property law;²¹³ others have been more liberal in recognizing such status. In a decision evocative of the case under review, the Paris Court of Appeal reasoned that a domain name, based particularly on its commercial value to the owning company, may warrant protection against

208 C-291/00 *LTJ Diffusion SA v. Sadas Vertbaudet SA*, Judgment of March 20, 2003, ECLI:EU:C:2003:169.

209 See also article 3 of annex III to ABR-2015.

210 *Gandi v. Inexpensive Domains and ors*, June 27, 2003, Paris High Court.

211 *Sté Publications Bonnier v. Sté Saveurs and Senteurs Créations*, January 21, 2002, Nanterre High Court, *JCP E* 2002, No. 36, No. 8 (obs. M. Vivant).

212 *Zebank (SA) v. Multimedia Canada Ltd (Ste, Canada)*, 123 *Multimedia (SA)*, November 22, 2001, CA Versailles, *JCP E* 2003, No. 106, No. 7 (obs. B. Humblot).

213 See *Amélie M. v. Société Internic, Jacob N*, March 13, 2000, Nanterre High Court, *JCP E* 2000, 1856, No. 7 (obs. M. Vivant).

infringements.²¹⁴ According to French jurist and author Jérôme Passa, in commenting favorably on decisions in this vein, the name of a domain, once operating, can constitute prior art and thus grounds for cancellation of a trademark.²¹⁵ Some authors consider domain names only a nascent form of property not yet warranting such protection.²¹⁶

It is difficult to see how initial registration of the domain name “senfactures.sn” could be considered fraudulent if Touba’s prior claim to use of the eponymous trademark could not be established. That is precisely what Sonatel Mobiles argued, affirming its good faith in using the name, unaware that a “sen-factures” trademark existed. The company also affirmed that it was not the intended recipient of a commercial offer from Touba for use of the trademark – sent to “Sonatel” by letter dated March 9, 2004 – having its own separate legal personality as “Sonatel Mobiles.” Arguments based on that offer, while relevant, were declared inadmissible for failure to produce the letter. The letter might otherwise have corroborated prior use of the trademark by Touba and supported its posture as a victim of unfair competition. But it might also have corroborated the assertion of good faith by Sonatel Mobiles: if it was not the intended recipient, it could not logically have been aware of the offer.

In any event, the court’s rationale for penalizing Sonatel Mobiles was clearly based on prior use of the “sen-factures” trademark by Touba, as illustrated by the following preambular paragraph:

“[Considering that] the appeal court also notes that Sonatel and the GPS Group, after learning of the registration and use of the ‘senfactures’ trademark by Touba, continued to use that protected mark; this fraudulent use, contrary to honest practice, was liable to create confusion with the service trademark legitimately and legally owned by Touba, and to disrupt its market.”

It seems questionable, however, to recognize prior use of the “sen-factures” trademark by Touba, since the letter of March 9, 2004, offering that trademark for commercial use was not included in the dossier. In these circumstances, only the date on which the trademark was filed with the OAPI or, at the very least, entered into force (namely, April 12, 2005) should be considered in determining prior use – unless it is assumed that the Supreme Court relied on earlier testimony from Sadaga Sarr, general director of Touba, on August 14, 2002, the content of which remains unknown.

214 *Virgin Interactive Entertainment Ltd and Virgin Interactive Entertainment SARL v. France Télécom and BDDP-TBWA* (voluntary participant), October 18, 2000, CA Paris, *JCP E* 2000, No. 36, 8 (obs. M. Vivant).

215 See Cass. com., November 26, 2003, *PIBD* 2004, No. 780, III, 98; CA Paris, September 15, 2004, *PIBD* 2005, No. 800, III, 54.

216 See M. Vivant *et al.* (2004) *Lamy droit de l’informatique et des réseaux*. Paris: Éditions Lamy, No. 2061.

II. The author of the competitive act

Identifying the author of an act in question might seem straightforward, but it is not. Websites are operated by multiple individuals whose precise responsibilities need to be determined. Primary responsibility clearly lies with the natural or legal person who reserved the domain name – that is, who applied for its registration with the accredited registrar (A). The responsibility of users of the services offered under the offending domain name is a more delicate question (B). The responsibility of technical intermediaries, including the access provider and website hosting company, was not expressly raised and will not be examined here.²¹⁷

A. The registrant of the offending domain name

Responsibility for the acts of unfair competition concerned in this case lay primarily with the legal person benefiting from the domain name, which was Gie Gainde 2000, to which the GPS Group belonged. The facts show that this entity registered the domain name “senfactures.sn” in Senegal in January 2005. The Supreme Court endorsed the appeal court’s argument that the appellant’s registration with a national body – instead of the OAPI, which was “the only subregional institution competent in the matter” – did not entitle it to use the trademark against the will of the respondent. This reasoning suggests a lack of familiarity with domain name registration, which, unlike that for traditional industrial property titles, is done at the national and international levels by accredited registrars. It is the responsibility of the applicant to check that use of the requested name does not infringe any prior rights.²¹⁸ In the present case, Gie Gainde 2000 should have performed a prior art search before registering the name, to confirm its availability. Such a search would have been all the easier for the fact that the litigants were in the same line of business – namely, online invoice payment. In any event, it was the appeal court’s sovereign judgment that the GPS Group was aware before registering its domain name that Touba had already used the “sen-factures” trademark, such that the group’s use of that name on the internet was wrongful. However, the proceedings seem mainly to have targeted Sonatel Mobiles, which tried at all costs to avert conviction.

B. Users of the offending domain name

Sonatel Mobiles claimed that it used the “senfactures.sn” domain name not as the owner and provider of the associated payment service but as a client of the GPS Group – itself belonging to Gie Gainde 2000, owner of the domain name. Accordingly, it claimed to bear no responsibility for the actions of its trading partner. The Supreme Court, however, reasoned that Sonatel Mobiles used the offending name fully aware of the prior trademark and thus upheld the complaint of unfair competition against it. It is a common approach to rule competition unfair, as the Supreme Court did here,

217 See J. Fometeu (2013) *La responsabilité des intermédiaires techniques dans l’utilisation en ligne des objets protégés*. *RAPI*, 4, 25.

218 See Vivant *et al.*, n. 216, No. 2044.

where civil liability has been incurred for misconduct, in accordance with the civil legislation in OAPI member states. Proving the bad faith of one participant in a chain is sufficient to hold them personally or jointly liable for the offending acts. For counterfeiting, where good faith is not a factor, the approach is fundamentally different.

The question is how to interpret the court's reasoning (as noted earlier, the court reasoned that the prohibition on the use of a registered trademark without the permission of its holder, under ABR-1999, art. 7 of annex III, is general and applies to third parties irrespective of the category of activity concerned), which is a source of concern, invoking as it does provisions on the rights conferred by trademark registration to characterize unfair competition. The court's desire to protect a trademark owner's rights, whoever might seek to violate them, is understandable. But it is also true that the holder of an exclusive trademark right has a choice: bring action for infringement directly or seek to punish the infringement on grounds of unfair competition, provided that, in the latter case, the likelihood of confusion can be demonstrated without calling the trademark rights into question. In France, the Court of Cassation continually reminds lower French courts that:

- a. actions for unfair competition can be brought only in the event of wrongdoing, whereas actions for infringement concern the violation of exclusive rights;
- b. these two types of action have different causes and aims; and
- c. actions for infringement are not incidental, consequential or complementary to actions for unfair competition.²¹⁹

The court was therefore wrong to cite article 7 of annex III to ABR-1999. It could be argued further that since the two companies operated in the same sector, Sonatel Mobiles must have been aware of the "sen-factures" trademark and, in using the online invoice payment service provided by Gie Gainde 2000, intended to "ride the coattails" of the trademark holder and benefit from its marketing efforts.

Max Lambert Ndéma Elongué

N. Claiming ownership of a trademark – Exclusive competence of the OAPI – Competence of the civil court – Validity of a trademark registration – Violation of a prior right – Penalty: invalidation

Claims to ownership of a trademark do not fall under the exclusive competence of OAPI judicial organs. Actions in respect of such claims may legitimately be brought before the domestic courts of member states. The success of such actions is in no way restricted by the six-month time limit for submitting administrative claims to the OAPI Director General.

SOCIÉTÉ MARINE MAGISTRALE SA V. MR. KAMGA NENKAM, JEAN PAUL, Civil judgment No. 382/Com of December 23, 2013, High Court of Wouri (Douala)

Observations:

The right over a trademark exists from the date of its filing. Under the Bangui Agreement, the use of a sign in relation to a particular product is reserved for the person who files it first with the OAPI – a rule known as "first to file" (see article 5(1) of annex III to ABR-1999). This rule is flexible, however, and does not apply to fraudulent filings: under the general principle of *fraus omnia corrumpit*, "fraud corrupts everything," fraudulent acts may be challenged in court. Indeed, cognizant of the dishonest practices common in commercial circles, regional legislators have equipped trademark users with the legal instruments necessary to protect themselves from fraudulent applications aimed at misappropriating their assets. Actions asserting ownership claims have thus been sanctioned as the best way of punishing those appropriating a sign even though aware of a claimant's prior use. With the exception of administrative appeals lodged with the OAPI organs, there is nothing to prevent national courts from being seized of such matters, as in the case reported here.

Facts: According to the facts in the case, Mr. Kamga Nenkam was appointed general director of company Marine Magistrale (2M), plaintiff in the case, by a resolution of its board of directors. To protect its highly modern port handling service, "Harbour Handling with Big Bags," the plaintiff mandated Mr. Nenkam to file with the OAPI on its behalf the service mark "H2B2 System." Taking advantage of his privileged position, Mr. Nenkam used his employer's resources to file the mark in his own name, registering it under trademark No. 66841 by order of July 29, 2011, of the OAPI Director General. After discovering this, Marine Magistrale terminated its contract with the defendant and, claiming prior use of the trademark, initiated legal proceedings to invalidate Mr. Nenkam's filing and register the mark under the company's name.

Reasoning: In addition to examining the issue of validity in this case, the High Court took the opportunity to consider the fundamental question of whether, under OAPI positive law, the national courts of member states can admit trademark claims. In doing so, the court deployed the country's legislative framework for trademark ownership claims. The crux of the dispute concerned how courts have interpreted the combined provisions of articles 5(3) and 47(1) of ABR-1999. The court's solution clearly distinguished between judicial claims and administrative claims made against fraudulently registered trademarks.

In principle, the Bangui Agreement applicable at the time of the facts (ABR-1999) provides for administrative claims to be lodged for trademark ownership. Under article 5(3) of annex III to ABR-1999, "where a mark has been filed by a person who at the time of filing knew, or should have known, that another person had a prior right to use the said mark, the latter may file a claim of ownership of the

219 See Cass. com., February 24, 1987, *PIBD* 1987, III, 316; *Moulinex SA v. Vapsan Trading Cie and ors*, n. 89.

mark with the Organization, provided that he does so within six months following the publication of the record of the first filing.” This provision clearly and helpfully sets out the conditions, both substantive and formal, to be met by trademark claimants.

On that basis, it is clear that the success of such administrative claims depends on:

- a. the defendant having both filed a sign and acted in bad faith; and
- b. the claimant having previously used the mark.

The defendant must also have filed the sign fraudulently.

Filings are considered fraudulent where they breach a legal or treaty obligation to the detriment of the sign’s prior user. On this basis, the court seized of the well-known *Dynamogen* case²²⁰ reasoned that, since Distrimed Pharma had registered the “Dynamogen” trademark in bad faith and in violation of a contractual obligation, having been mandated to register the disputed trademark on behalf of FAES S.A. instead, the registration was fraudulent and should be invalidated under the *fraus omnia corrumpit* principle.

What constitutes an applicant’s bad faith is clear from the text of article 5. On that basis, case law has commonly affirmed that applicants are considered to have acted in bad faith where they were aware, or could not have failed to notice, that a third party was already using the sign in question or a similar sign for similar or identical goods and services (the principle of specialty). In the absence of bad faith, claims are simply dismissed. In one case submitted to the OAPI Director General, an appeal lodged by a claimant with the High Commission was dismissed owing to the latter’s inability to prove the bad faith of the defendant, who had performed a prior art search before filing the sign at issue.²²¹

Bad faith is assessed relative to the date on which the sign was filed and can be proven by any means; prior use of the mark is required by law. In other words, under article 5, a party need only prove its prior use of a trademark to lay claim to it. Whether the plaintiff has an exclusive right to the sign is irrelevant, because the victim’s prior use of the sign must be established in any event.²²² It was on this basis that the High Commission of Appeal dismissed the *Dynamogen* case.

In addition to substantive requirements, the Bangui Agreement lays down a number of formal requirements for administrative claims. Ownership claims must meet strict formal requirements as to when and before which body they may be brought. Under article 5(3), they must

be brought within six months following publication in the official gazette of an allegedly fraudulent filing. Within that period, the claimant must file with the OAPI for registration of the sign in its own name or permanently lose the right to claim ownership. This was established in a case brought before the OAPI High Commission of Appeal.²²³ When a case is brought, adversarial proceedings are conducted before the OAPI Director General. In this particular dispute, more than six months had passed after publication of the first filing before the appellant company made the second in its own name. For this sole breach of the governing legislation, the case was dismissed.

In terms of the administrative organs competent to hear trademark disputes, the process starts with the OAPI Director General. If the Director General rules in favor of the claimant, the fraudulent filing is struck from the record so that the claimant’s filing can be considered. If the Director General dismisses the claim, the claimant may lodge a final appeal with the High Commission of Appeal within 60 days of the notification of dismissal (see also article 31(2)(d) of ABR-2015).

While ABR-1999 contains no such provision, ABR-2015 also allows trademark claims to be brought before courts in the member states, as an alternative to administrative appeals. In the present case, two of the plaintiff’s substantive complaints were the subject of technical debate before the court: the first concerned the court’s jurisdictional competence; and the second, the time limit applicable.

With regard to the competence of domestic courts to hear trademark proceedings, the Bangui Agreement in force at the time was silent, but that should in no way be interpreted as legislative intent to exclude such recourse. Indeed, the devolution to domestic courts of disputes arising from the exploitation of industrial property titles is a specific characteristic of the OAPI system. In other words, the OAPI system gives domestic courts common law jurisdiction for disputes over industrial property rights. In principle, penalties for infringement are also for domestic courts to decide, making them competent *de facto* to hear ownership claims. Article 47(1) of annex III to ABR-2015 provides that:

“Where a mark is registered by a person who, at the time of deposit, knew or should have known that another person had priority to exploit the mark, the other person may claim ownership of the mark before the competent domestic court.

“Where a mark is acquired in infringement of a legal or contractual provision, the prejudiced party may also claim ownership of the mark before the competent domestic court.”

220 *Distrimed Pharma SARL v. Fábrica Española de productos químicos y farmacéuticos (FAES) SA*, Judgment No. 257/Civ of May 18, 2011, Court of Appeal of the Center Region (Yaoundé).

221 Judgment No. 172/OAPI/CSR of November 13, 2013, of the OAPI High Commission of Appeal.

222 *Ibid.* In rejecting the appeal, the High Commission noted that Mrs. Adibadij had not been able to prove that she had used the trademark at issue prior to its filing by Mr. Agbere Issaka Sanounou.

223 *Distrimed Pharma SARL v. Fábrica Española de productos químicos y farmacéuticos (FAES) SA*, Judgment No. 11/19/OAPI/CSR of October 18, 2019, of the OAPI High Commission of Appeal.

The Agreement distinguishes between judicial proceedings for claims brought before domestic courts and administrative proceedings brought before the OAPI.²²⁴ Thus, in assuming jurisdiction, the judge hearing the case adhered to those rules, which would have obliged him, if declining jurisdiction, to fully examine observations made about transposing the six-month time limit to court proceedings.

The judge went on to say, nonetheless, that the time limit for administrative trademark proceedings does not apply to judicial ones. This ruling thus helped to clarify the judicial role in respect of trademark claims, no legal basis for which had been previously set down. According to the judge's decision, trademark claims can be pursued in two ways: the first, *in principle*, before the courts; and the second, *as an exception*, before the OAPI. While strict time limits apply for the administrative route (six months under ABR-1999 and three months under ABR-2015), they do not for judicial proceedings, which may be brought at any time.

Aristide Fade

O. Trademarks – Opposition to the registration of a later mark – Reiteration of opposition – Similarity of goods concerned – Likelihood of confusion caused by a later mark

The owner of a registered trademark may oppose the subsequent registration of a mark for goods similar to those covered by their own mark where the signs for each mark bear phonetic and visual similarities that could confuse an average consumer.

MR. ABDOULAYE SACKO V. SOCIÉTÉ AMAR TALEB MALI SARL, Judgment No. 175/OAPI/CSR of November 13, 2013, OAPI High Commission of Appeal

Observations:

The judgment under review comes from the OAPI High Commission of Appeal, which is responsible under article 31(2)(a) of ABR-2015 for ruling on appeals following the rejection of applications for titles of protection for industrial property. The case provides insight into an age-old issue in trademark law: the availability of a sign to be registered. *Availability* means the absence of any prior third-party right over the sign. The applicable rule, which is fully consistent with the trademark's essential guarantee function, is set out in article 3(b) of ABR-1999. It provides that a mark may not be validly registered if it is identical to a mark that belongs to another owner and is already registered, or to a mark whose filing or priority date is earlier and which relates to the same or similar goods or services, or it so resembles such a mark that it is liable to mislead or confuse. It should be noted in passing that while the Agreement refers only to prior trademark rights, some national laws include other prior rights as reasons for

unavailability. For example, article 8.4 of the European Union Trade Mark Regulation (Regulation 2017/1001/EU of June 14, 2017) allows for registration to be opposed by the owner of an unregistered trademark or of another sign used in the course of trade on more than a local scale, while article L.711-4 of the French Intellectual Property Code provides that a sign which infringes prior rights may not be adopted as a trademark.

Facts: The question raised in the present case related solely to the field of trademark law. Having registered the trademark "Gazelle thé vert de Chine + Logo"²²⁵ with the OAPI in 2007, under class 30, the plaintiff opposed the subsequent registration of a mark "La Gazelle et ses petites," filed in 2009 under classes 29 and 30, on the basis of article 18 of annex III to ABR-1999 (article 15 of annex III to ABR-2015). The OAPI Director General, ruling in the plaintiff's favor, decided to cancel the latter mark, citing the likelihood of its confusion with the former. His decision was then referred to the High Commission of Appeal.

Reasoning: Three separate issues were concerned in this case. The first was formal, relating to the initial opposition being declared inadmissible (section I); the other two, both substantive, concerned the identity or similarity between the goods concerned by the two marks (section II), and the likelihood of confusion between them (section III).

I. Admissibility of the opposition

The case was peculiar insofar as an initial opposition had been declared inadmissible by the OAPI Director General on June 29, 2012, for non-compliance with article 18 of annex III to ABR-1999, on which basis the defendant argued that a second opposition could not succeed either and that the owner of the prior trademark should have referred the inadmissibility decision to the High Commission of Appeal. The plaintiff responded that, its initial opposition having been submitted on overzealous counsel before registration of the contested mark had even been published, it was now entitled to resubmit its opposition within the time limit of six months of publication allowed under the Bangui Agreement.

The Commission agreed. It declared the new opposition admissible, having been submitted within the time frame and in the form prescribed by law to regularize the grounds for dismissal following publication.

The solution is entirely commendable. According to the letter of article 18(1) of annex III to ABR-1999,²²⁶ dismissal of the plaintiff's opposition was not an option. While the judicial nature of the High Commission of Appeal is debatable,²²⁷ it is logical to transpose the general rules

²²⁵ This is how the High Commission of Appeal describes the mark, although in reality the contested decision (No. 40/OAPI/DG/DGA/DAJ/SAJ, July 11, 2012) shows the mark as "China Green Tea Gazelle." For the remainder of this commentary, however, "Gazelle thé vert de Chine" will be used, as this is the mark of concern to the Commission.

²²⁶ Now ABR-2015, art. 15 of annex III.

²²⁷ See J. Fometeu, annotated OAPI Code, sub-art. 31.

²²⁴ See article 19(1) of annex III to ABR-2015.

accepted in civil proceedings, including the principle that grounds for dismissal may be regularized at any time. What matters, as the Commission pointed out, is submission within the time limit. Dismissal, moreover, would have been excessively harsh given the Commission's role, under article 15 of annex III to ABR-1999, as the "the judge and arbiter of final instance."

II. Identity or similarity between the goods concerned by the two marks

As stipulated in article 3(b) of annex III to ABR-1999, the priority of the first sign can prevent registration of the second only if both are for similar goods or services. In a similar vein, article 8(1)(b) the European Union Trade Mark Regulation refers to the identity or similarity between goods or services covered by the trademarks. This is simply the application of the fundamental "specialty" principle, which has been rightly described as "consubstantial with the concept of the distinctive sign."²²⁸ The likelihood of confusion justifying the refusal of a registration exists only where the opponents operate in the same market.²²⁹

That is the argument the plaintiff put forward in affirming that its mark "Gazelle thé vert de Chine" and the disputed mark "La Gazelle et ses petites" were used for identical or similar goods. The defendant objected, in return, that its mark covered goods in classes 29 and 30, whereas the prior mark covered goods in class 30 only.

In response to that objection, the Commission merely noted the similarity between classes 29 and 30. This reasoning seems too brief to be convincing. It is based on the assumption that the specialty principle applies only to the international classification of products and services under the 1957 Nice Agreement, which has been revised several times. While article 9(2)(c) of that Agreement (article 8(d) of the version applicable at the time) requires applicants to specify classes of goods and services with reference to the Nice Classification, it begins by stating that the file must contain a clear and complete enumeration of the goods or services to which the mark applies. The OAPI trademark registration form takes this into account: it requires the applicant to indicate the goods covered in a box opposite each class claimed.

The Nice Classification is clearly without legal effect in this regard. As eminent experts have noted,²³⁰ the scope of protection of a trademark is determined by the goods and services enumerated rather than their administrative class. Similarly, case law establishes that trademark protection covers only those goods that are identical or similar to the goods for which the mark was filed and does not necessarily extend to all goods in

the class under which it was filed.²³¹ It was only with the benefit of this clarification that the Commission could conclude that the goods in question were similar, and it was therefore wrong, in our view, for the Commission to find that the two classes of goods were similar only in that they both concerned food products.

It is also worth mentioning that a variety of products are included in classes 29 (meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats) and 30 (coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flours and preparations made from cereals, bread, pastry and confectionery, edible ices, honey, molasses syrup, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice cream). It should have been indicated which of these two long lists was covered by the trademarks "*La Gazelle et ses petites*" and "*Gazelle thé vert de Chine*." Moreover, it is hard to imagine the latter mark designating products in class 30 other than tea without being considered deceptive or liable to mislead the public under article 3(d) of annex III to ABR-1999 as to the nature of the good in question.

III. Likelihood of confusion between the signs

Article 3(b) of annex III to ABR-1999 provides that a mark may not be validly registered if "it is identical to a mark that belongs to another owner and is already registered, or the filing or priority date of which is earlier, and which relates to the same or similar goods or services, or where it so resembles such a mark that it is liable to mislead or confuse." In the case under review, the two marks in question were not identical; it was their resemblance that was at issue. Article 8(1)(b) of the European Union Trade Mark Regulation provides that an opposition must be upheld if "there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected." The difference in the wording of the two texts is only slight, with the term "confusion" serving to convey the idea of fraud implied by the term "mislead" in the ABR-1999 provision.

The plaintiff in the present case asserted that the likelihood of confusion arose from the fact that both marks were visually representative and intellectually evocative of gazelles. The defendant argued that any confusion was allayed by the fact that its own mark specifically depicted three gazelles, consisting of a mother and her two offspring, and included the words "*Gazelle et ses petites*" in clear print, while the prior mark was purely figurative, consisting of a single gazelle. This was in fact only partially true: the image shown in the contested decision contained both a gazelle and the words "China Green Tea" and "Gazelle."

Without broaching that issue, the High Commission of Appeal ruled in favor of the plaintiff, considering the signs to be both phonetically and visually similar. "Indeed," the Commission reasoned:

228 S. Durrande (2010) Disponibilité des signes. *JurisClasseur Marques – Dessins et modèles*. Fasc. 7110, No. 5.

229 See J. Raynard, E. Py and P. Trefigny (2016) *Droit de la propriété industrielle*. Paris: LexisNexis, No. 374: "[T]he prior art making the sign unavailable must exist in the business segment for which the mark is registered."

230 J. Azema and J.-C. Galloux (2012) *Droit de la propriété industrielle*, 7th edn. Paris: Dalloz, No. 1505.

231 See Cass. com., June 17, 1980, No. 78-16.098, *Bull. civ.* 1980, IV, No. 260.

"[T]he classes of goods are similar, both relating to foodstuffs, and both of the signs were visually representative of gazelles as two-horned animals, regardless of how many; the average consumer will see the word 'gazelle' and then the image of a gazelle; confusion between the two marks was therefore likely for consumers not seeing (or hearing) them at the same time."

A formal reservation is warranted here. The commission's use of the word "indeed" suggests that the similarity between the signs resulted from similarity between the goods concerned. Yet clearly this cannot be the case. It must first be established that the goods covered are similar and then, separately, that the signs are similar enough to create the likelihood of confusion.

The commission's reasoning is otherwise classic and taken more or less verbatim from the contested decision, reflecting the generally recommended method for determining whether a likelihood of confusion exists. It would have been useful to supplement the applied criteria with those referred to in the 11th recital to the European Union Trade Mark Regulation, which states that assessing the likelihood of confusion "depends on numerous elements and, in particular, on the recognition of the trademark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trademark and the sign and between the goods or services identified." By the same token, the CJEU, in *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, reasoned that assessing the likelihood of confusion "implies some interdependence between the relevant factors, and in particular a similarity between the trademarks and between the goods or services covered," and that "a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa."²³² This demonstrates the link between the issues of similarity between goods and services, on the one hand, and likelihood of confusion, on the other.

André Lucas

P. Trademarks – Compliance with the mandatory registration procedure for plant protection products – Justification – Infringement

A person's compliance with the mandatory approval procedure for plant protection products established by the competent administration does not justify infringement by that person of a registered trademark for those products. Consequently, a court misapplies the law if, despite the proven similarity between two conflicting signs, it dismisses a trademark owner's infringement action on the grounds that the alleged infringer complied with this administrative procedure.

SOCIÉTÉ SINOCAM SARL V. SOCIÉTÉ AFCOTT CAMEROUN SARL, Judgment No. 4/Com of December 6, 2018, Supreme Court of Cameroon

Observations:

In civil proceedings for trademark infringement, alleged infringers may plead a variety of defences to avoid conviction, including lack of standing, invalidity of the allegedly infringing mark on various grounds and forfeiture by acquiescence. Leaving aside the challenged validity of the trademark, this judgment of the Supreme Court of Cameroon is an opportunity to examine an atypical defense for an infringement defendant based on compliance with the approval procedure for marketing the infringing goods. The court clearly stated that compliance with that administrative formality does not justify infringement, rebuking the appeal court for relying on such justification to reject the infringement proceedings.

Facts: Sinocam SARL, owner of the "Lamida Gold 90 EC + logo" trademark, No. 71469, for goods falling within class 1, fortuitously discovered that Afcott Cam SARL was marketing the same goods bearing the infringing sign "Lamida Cot 90 EC" from a number of warehouses in Douala. Sinocam summoned Afcott Cam to appear before the Wouri High Court to answer charges of infringing its trademark, asking the court to order:

- cessation of all manufacture and distribution of the Lamida Cot 90 EC product, subject to a fine of CFAF 500,000 for each infringement observed;
 - seizure and destruction of the entire stock of infringing products; and
 - payment by the infringer of CFAF 100 million in damages.
- Alcott Cam pleaded two defenses of unequal weight:
- that the mark "Lamida Gold 90 EC + logo" was invalid, for lack of distinctiveness; and
 - that the marketing of goods bearing the mark "Lamida Cot 90 EC" was lawful.

In its Decision No. 167/Com of April 6, 2016, the Wouri High Court ruled in favor of Sinocam. That decision was overturned on appeal, in Decision No. 40/Com of November 7, 2016.

Sinocam appealed to the Supreme Court.

Reasoning: The key questions before the Supreme Court concerned, first, whether fulfilment of the conditions for marketing goods bearing an infringing mark can justify setting aside an infringement grievance and, secondly, to what extent the mark in question was effectively distinctive. In its ruling, the Supreme Court answered the second question by ruling that compliance with the registration procedure does not justify an infringement (section II), but it did not fully address the first, equally important, issue of the mark's distinctiveness (section I).

232 C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Judgment of the Court of June 22, 1999, ECLI:EU:C:1999:323, at [19].

I. Distinctiveness as a condition for the validity of a mark

Before the appeal court, Afcott Cam challenged the validity of the mark “Lamida Gold 90 EC + logo” primarily on the grounds that it was generic and therefore not distinctive, in terms of both the sign filed for registration (A) and the goods designated (B).

A. The sign

It is worth reiterating that, under article 3(a) of annex III to ABR-1999, a trademark cannot be validly registered if it is devoid of distinctiveness. That requirement is also frequently referred to in the literature.²³³ It means rejecting marks that consist only of necessary or generic designations. According to Bertrand, a sign or term is considered generic if it designates not a specific product or service but merely the category, type or genre to which the product or service belongs, or a type of product or service to which consumers attribute no specific origin.²³⁴ Chavanne and Burst define as generic those marks that consist solely of the name commonly used to designate the product or service provided.²³⁵ The aim of excluding such marks, and thus allowing competitors to use generic terms freely, is to remove unnecessary barriers to the freedom of trade and industry. The main argument made by Afcott Cam was that the term “lamida” was both a type of insect and the generic name of a chemical used to repel it. The appeal court agreed. It reasoned that, in researching and marketing pharmaceutical or plant protection products, promoters can use expressions relating to the germs to be combated without infringing the rights of the patent holder, provided that the “intonation” of the name is different for each of the products in question.

The appeal judges appear not to have grasped the complexity of the “Lamida Gold 90 EC + logo” mark, which contained both verbal and figurative elements. The distinctiveness of such a mark must be assessed based on the entirety of the sign rather than a single word within it – in this case, “lamida” – however generic. The courts, moreover, have consistently allowed a generic term to be registered as a trademark if one or more arbitrary elements are added to give the mark, considered as an indivisible whole, its own individual appeal. For instance, according to case law in France, the French term “agenda” cannot be validly registered as a mark for designating appointment books, but signs such as “Agenda XY,” “AgenDDa” or the word “agenda” written in a particular and unusual script to designate such products can receive trademark protection.²³⁶ By that logic, while a trademark owner cannot prohibit or oppose the use by its competitors of non-distinctive elements of its trademark – in this case, the term

“lamida”²³⁷ – it may nonetheless contest slavish or quasi-slavish reproductions of its trademark that include the arbitrary elements making it distinctive. The method of assessment the Court of Appeal used here – that is, singling out the word element “lamida” as grounds for considering the mark generic – is thus far from orthodox. The Supreme Court paid little attention to this important aspect of the dispute, appearing to focus solely on the appellant’s arguments. In any event, the generic nature of a sign, whether complex or simple, must be assessed in relation to the goods or services designated.

B. The goods or services indicated in the act of registration

The goods or services designated by a trademark are decisive in determining its distinctiveness. As indicated above, a sign is considered to be devoid of distinctiveness where it constitutes only the necessary or generic designation or composition of the product or service with which it is associated. It was consequently significant that Afcott Cam associated the term “lamida” with an insect that was named and described by Allata Walker in 1859 and later adopted by scientists to designate a chemical repellent for that insect.

It is necessary at this stage to identify the precise goods covered by the act of registration for the “Lamida Gold 90 EC + logo” trademark, to assess the respondent’s assertion that the sign is generic. In seeking dismissal of the grievance, Sinocam argued that:

- its mark was registered for class 1 goods – that is, chemicals intended specifically for agriculture, horticulture and forestry – rather than for insects;
- among the wide variety of trademarks and denominations for plant protection products, no insect, named “lamida” or otherwise, is sold as a product or product component, let alone used as a common name for a fungicide, pesticide or insecticide;
- the term “lamida” is not a necessary or generic designation of the goods indicated in the certificate of registration for the mark; and
- its characterization as such by Afcott Cam was therefore fanciful.

We might, at best, speculate about the connotations the “Lamida Gold 90 EC + logo” mark might have for its target audience – primarily, farmers. It is perfectly conceivable that customers might directly or indirectly equate the term “lamida” with goods bearing the mark “Lamida Gold 90 EC + logo.” Doing so, however, would be a highly subjective process, as Jérôme Passa rightly observes.²³⁸ It is generally accepted, in any event, that assessing the generic nature of a sign is for the sovereign judgment of the trial court, often based on surveys or polls. That is the only real means of determining how most consumers or users view the sign: as designating either a type or category of goods or a product of specific origin.²³⁹ The

233 See Bertrand, n. 204, at 53; Passa, n. 82, at 83.

234 Bertrand, n. 80, at 112.

235 Chavanne and Burst, n. 1, at 583.

236 See CA Paris, March 10, 1994, *PIBD* 1994, No. 568, III, 325; Cass. com., January 24, 1995, *Bull. civ.* 1995, IV, No. 25; CA Paris, November 9, 2001, *PIBD* 2002, No. 737, III, 106.

237 In other words, a person cannot reserve a descriptive or generic term designating a product or service to the detriment of its competitors operating in the same business sector. Such terms are effectively in the public domain and are therefore available to all.

238 Passa, n. 82, at 93.

239 Bertrand, n. 80, at 114.

“Lamida Gold 90 EC + logo” mark associated with class 1 goods was, in our opinion, distinctive. Notwithstanding its possible connotations, the term “lamida” could not in itself perform the functions required of a mark: enabling the consumer or ultimate recipient of a product or service to recognize it and know what enterprise, among other competitors, owns the mark for it.²⁴⁰

II. Defenses pleaded by the alleged infringer

Afcott Cam argued that its “Lamida Cot 90 EC” sign did not cause a likelihood of confusion with the mark in question (A) and that it committed no fault, the products bearing that sign having been approved for marketing by the competent authority (B).

A. Likelihood of confusion

The appeal court also saw little likelihood of confusion between the signs based on the absence of imitation, the differences in product name intonation and packaging, and the absence of intent to mislead consumers.

That position appears suspect for two reasons. First, the imitation is obvious from simply examining the signs, in terms of both spelling and phonetics. As for the spelling, it is clear that Afcott Cam had slavishly reproduced the key characteristics that made the “Lamida Gold 90 EC + logo” mark distinctive.²⁴¹ Indeed, the substitution of the letter “C” for “G” in “COT 90 EC” amounts visually to so small a difference as to go unnoticed by the average consumer. The imitation might have been less clear if Afcott Cam had been content to use the trademark’s non-distinctive elements, such as the term “lamida” – although the generic nature of that element relative to the goods in question had yet to be established.

Second, in assessing the likelihood of confusion, the appeal court curiously took the perspective of a consumer looking at both products together to conclude that customers purchasing either would be reassured, not confused, as to their choice. It is accepted in both literature and case law, however, that a judge must take the perspective of an *average* consumer – that is, one not seeing or hearing the signs together. As a matter of comparative law, the French Court of Cassation systematically checks whether lower courts have met that requirement.²⁴²

B. Commission of fault

Afcott Cam argued that it had committed no fault. It had marketed goods under the “Lamida Cot 90 EC” trademark having duly followed the procedure established under Decree No. 2005/772/PM of April 6, 2005, on the terms and conditions for the registration and control of plant protection products. The appeal court agreed that

the company had committed no fault, reasoning that the rights of possible competitors were ensured by the commission responsible for approving use of the products concerned.

That position disregards the conditions laid out in the Bangui Agreement for protecting and exploiting the trademarks of products to be marketed. A commission for approving the use of plant protection products cannot act in the place of the OAPI, the body responsible for registering trademarks, nor especially in the place of courts competent to enforce trademarks. Through registration, as Sinocam rightly pointed out, the competent authority approves plant protection products as suitable for their intended use when used as recommended, and safe for human and animal health and the environment, based on a review of complete scientific data to that effect. Therefore, after following the registration procedure, Afcott Cam should have consulted with Sinocam, the undisputed owner of the “Lamida Gold 90 EC + logo” trademark, to negotiate the conditions for use of that mark under a contractual license. Indeed, under article 7(2) of annex III to ABR-1999, Sinocam could have prevented all third parties from making use in business without its consent of signs identical or similar to those for which the “Lamida Gold 90 EC + logo” mark was registered. Because Afcott Cam did not obtain permission to exploit the “Lamida Cot 90 EC” sign, which was similar to the cited trademark, the grievance lodged against it for infringement was more than supported.

The Supreme Court was therefore right to affirm, in disagreeing with the appeal court, that compliance with the mandatory registration procedure for plant protection products does not justify infringement of an intellectual property right. Its ruling restored the legal order upset by the contested judgment.

Max Lambert Ndéma Elongué

Q. Assessing likelihood of confusion – Complex trademark – Principle of the indivisible whole – OAPI administrative bodies – Member state courts

The method used to assess the likelihood of confusion regarding a complex trademark is both abstract and global. It is abstract in referring to the content of the registration and to a fictitious character known as the average consumer, who cannot see or hear two competing products at the same time. It is global in assessing the overall impression created by the conflicting marks, considering their distinctive and dominant elements in particular. Consequently, a court errs if it declines to find infringement without first ascertaining the likelihood of alleged confusion, basing its decision on the fact that the OAPI, although empowered to deny it, had approved registration of the offending mark.

240 See Y. Rebou (2012) *La Marque: outil stratégique pour l'entreprise*. In *Mélanges offerts à Denis Ekani* (OAPI Collection No. 4). Paris: L'Harmattan, 108 *et seq.*

241 See *Independent Tobacco FZCO v. Rothmans of Pall Mall Ltd*, Judgment No. 536/ Civ of November 6, 2013, Court of Appeal of the Center Region (Yaoundé) (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section Q).

242 See Cass. com., November 26, 2003, *PIBD* 2004, No. 780, III, 100; Cass. com., February 18, 2004, *PIBD* 2004, No. 788, III, 360.

INDEPENDENT TOBACCO FZCO V. ROTHMANS OF PALL MALL LTD, Judgment No. 536/Civ of November 6, 2013, Court of Appeal of the Centre Region (Yaoundé)

Observations:

Likelihood of confusion is a central concept in trademark law and the basis for finding infringement. It is assessed using the so-called global method, established in the case *Sabel BV v. Puma AG, Rudolf Dassler Sport*, in which the Court of Justice of the European Union reasoned that likelihood of confusion must be “appreciated globally,” taking into account all factors relevant to the circumstances.²⁴³ Such likelihood is a key measure of the resemblance between two competing signs and, according to Passa, can take many forms. It can be direct, where the public confuses or is likely to confuse trademarks and signs, or indirect, where the public distinguishes between, say, two signs, but upon comparison believes them to be exploited by the same owner. Likelihood of confusion also exists where the public, while able to distinguish both signs and their users, may imagine, for instance, that arrangements exist between two companies, warranting possible quality concerns about both.²⁴⁴ In the case considered here, the Yaoundé Court of Appeal applied the global method to a dispute between Independent Tobacco FZCO and Rothmans of Pall Mall Ltd.

Facts: The facts are relatively straightforward. Independent Tobacco registered the trademark “Business Royal,” as sanctioned by order No. 6/1318/OAPI/DG/SSD of the Director General of the OAPI, on September 15, 2006. Rothmans of Pall Mall Ltd, claiming an exclusive and prior right over the sign “Royal,” having filed and registered the trademarks “Rothmans Royals Label” and “Royals” on March 17, 1997, and November 6, 2001, respectively, brought proceedings before the Mfoundi High Court requesting cancellation of the “Business Royal” trademark and payment of damages.

The High Court granted the request in its judgment of January 26, 2011, which Independent Tobacco appealed.

Reasoning: The Court of Appeal of the Centre Region (Yaoundé) was thus being asked to decide whether the OAPI, an institutional body responsible for registering trademarks, was qualified to assess the likelihood of confusion on the same footing as a court of law. It answered in the negative and dismissed the appeal, reasoning that the OAPI had registered without protest several other marks bearing the word “Royals,” but also that other elements, such as color and logo, were sufficient to distinguish the marks, each of which should be considered as an indivisible whole.

The decision is helpful in recalling how the likelihood of confusion should be assessed in the case of complex marks. But it could also give the mistaken impression

that responsibility for such assessments is shared between the OAPI and the courts. In truth, the OAPI reviews applications for trademark registration as a purely administrative procedure (section I), while likelihood of confusion is a matter for courts to assess (section II).

I. Review of applications for registration: a purely administrative procedure

The appeal court’s reasoning invites us to consider both the content (A) and scope (B) of this review.

A. Content of the review

When the OAPI receives an application to register a mark, it examines whether the formal requirements under articles 8 and 9 of annex III to ABR-1999 have been met and the relevant fees paid.²⁴⁵ The formal requirements relate to the number of copies of the application, proof of payment of the filing fee, power of attorney, reproduction of the mark with a list of the products or services covered and the corresponding class(es) thereof. The OAPI also checks whether the mark to be filed is contrary to public policy, morality or the law,²⁴⁶ and whether it imitates, reproduces or includes among its elements coats of arms, flags or any other such emblems.

The review is of limited substantive scope. The OAPI does not automatically conduct research to ascertain whether the sign is available – a task that would be delicate, unpredictable and, in any case, dependent on claims to prior art.²⁴⁷ Nor is it viable for the industrial property office to assess likelihood of confusion, which varies over time, while reviewing applications for registration; rather, its responsibility is to register trademarks meeting the minimum requirements on a “first come, first served” basis. Third parties may challenge its decisions by filing their opposition or trademark ownership claims to the OAPI Director General or through judicial proceedings for cancellation of the registration concerned. The validity of the certificate issued following the review, moreover, is subject to third-party challenge at any time, on grounds of likely confusion with another’s signs, goods or services. In short, the review carried out by the OAPI is purely administrative and highly limited in scope.

B. Scope of the review

The review that the OAPI conducts of registration applications is by no means exhaustive. In particular, it does not verify whether signs to be registered are available or likely to be confused with previously registered ones; such verification is performed *a posteriori* in court if challenges are brought. The decision approving the mark’s registration in that event is not binding on the court, which may order its cancellation where confusion is found to be likely.

243 C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport*, Judgment of the Court of the Court of Justice of the European Union November 11, 1997, ECLI:EU:C:1997:528.

244 Passa, n. 82, at 303.

245 See ABR-1999, art. 14(1) of annex III. ABR-2015, art. 18 reproduces this provision in full.

246 See ABR-1999, art. 3(c) of annex III; ABR-2015, art. 18(2).

247 Passa, n. 82, at 159.

From that perspective, the court's reasoning in the present case was unorthodox. It considered the term "Royals" to be clearly distinctive, as Rothmans argued, and sufficiently so that if the confusion so deplored had actually been likely, the OAPI, as the body responsible for managing and registering trademarks, would not have registered several other marks containing that term – neither for this nor for other, non-competing companies, no protests having been filed until then. The court thus attributed to the OAPI the sovereign power to assess likelihood of confusion when examining applications for registration, which would make its assessments binding on national courts. Beyond the exorbitant power this would mean for the OAPI, the court would recognize the pre-eminence of decisions taken by that administrative body over judgments by courts of law. Article 18 of ABR-1999, however, affirms the contrary: that the decisions of member state courts are binding on OAPI statutory bodies.²⁴⁸ The OAPI is indeed required to enforce the final judicial decisions communicated to it.²⁴⁹ In any event, the decisions issued by OAPI statutory bodies after reviewing such applications have only administrative value and are revocable by courts of law.

II. Methods of assessing likelihood of confusion

For a complex trademark, the process of assessing the likelihood of confusion is both abstract (A) and global (B).

A. Abstract elements of assessment

The assessment of likelihood of confusion is abstract in that it is based on the content of trademark registration and on a fictitious "average consumer." The first point of comparison, the content of the registration, consists of the trademarks as filed and described on their respective registration certificates, without regard to the conditions under which the signs are used in the market.²⁵⁰ In a judgment handed down on February 18, 2004, the French Court of Cassation curiously dismissed an appeal in which it had been argued that where a trademark right pertained to a sign, as filed to designate certain goods or services, the conditions under which the sign was used could not be taken into account in assessing the likelihood of confusion.²⁵¹ In the present case, the comparison could be based only on the word elements "Business Royals" and "Royals," which were the competing trademarks and denoted their respective specialties. It does not appear from the facts, however, that either was given a particular graphic form or accompanied by a figurative element not referenced in the registration.

In assessing the likelihood of confusion, courts have required consideration of the greater or lesser distinctiveness of the mark concerned – in this case, the sign "Royals," which was registered on March 17, 1997, and November 6, 2001, and has since taken a significant place in the market for such products. This was doubtless why the trial court invalidated the "Business Royals" trademark registered on April 24, 2004, for the same class 24 products, as clearly liable to create confusion in the minds of the target audience, which might easily have imagined that the "Business Royals" sign was a variation of the initial "Royals" trademark, or that the two competing marks belonged to the same owner.²⁵²

The other abstract part of assessing likelihood of confusion relates to a theoretical "average consumer," which French case law consistently defines as the typical, reasonably well-informed, observant and prudent consumer of a given category of product. The French Court of Cassation systematically confirms whether appeal courts have considered the average consumer's perspective in relevant cases.²⁵³ The definition of the average consumer developed by the OAPI High Commission of Appeal, however, differs from that used in France. The Commission indicates in a number of its judgments that case law in economies with higher levels of development and education should not be determinative in defining an economy's average consumer; rather, weight should be given relative to the differences in consumer awareness.²⁵⁴ The Commission refers in later decisions to the "average consumer of the OAPI zone."²⁵⁵ It is to be hoped that courts in OAPI member states will embrace this concept in assessing likelihood of confusion. In the present case, the Court of Appeal merely compared the word elements of competing marks without considering the perspective of the average consumer of the goods concerned, undermining the validity of its comparison.

Likelihood of confusion can, alternatively, be assessed globally.

B. Global assessment of likelihood of confusion

In the *Sabel* case, the European Court affirmed that a global assessment of the visual similarity between marks must be based on the overall impression they convey, bearing in mind in particular their distinctive and predominant components. In other words, a global assessment considers, among other things, the overall impression the signs make on the consumer, as defined above, and the distinctiveness of the mark concerned. Considering the overall impression made by a disputed mark means not restricting the examination to a single, isolated element of that mark. That is the substance of the apparent rebuke the appeal court forcefully addressed to the trial court in pointing out that:

248 This article states that "final legal decisions relating to the validity of titles and rendered in one member state under the provisions of annexes I to X of this Agreement shall be binding on all other member states, with the exception of decisions based on public policy and morality," thus establishing the pre-eminence of judicial court decisions over the decisions of OAPI statutory bodies. The provision was amended in ABR-2015.

249 See M.L. Ndéma Elongué (2017) *De la portée des décisions rendues par les tribunaux en matière de propriété intellectuelle*. In *Mélanges en l'honneur de l'action du Dr Paulin Edou Edou pour l'OAPI*. Poitiers: Juriscope, 299.

250 See CA Paris, March 30, 2005, *PIBD* 2005, No. 812, III, 423.

251 See Cass. com., February 18, 2004, *PIBD* 2004, No. 787, III, 333, cited by Passa, n. 82, at 305.

252 See CA Paris, June 27, 2003, *PIBD* 2003, No. 775, III, 581; CA Bordeaux, March 1, 2004, *PIBD* 2004, No. 786, III, 296.

253 Cass. com., November 26, 2003, *PIBD* 2004, No. 780, III, 100; Cass. com., February 18, 2004, *PIBD* 2004, No. 788, III, 360, cited by Passa, n. 82, at 309.

254 See Judgments Nos. 34–39/CSR/OAPI of March 26, 2004.

255 See Judgment No. 47/CSR/OAPI of April 1, 2005.

- a. the complexity of the marks “Rothmans Royals” and “Business Royal,” each consisting of multiple elements, was undisputed;
- b. according to case law on the matter, similarity assessments to ascertain the likelihood of confusion between marks of this kind should not be confined to a single conceptual element of a mark, but each of its designations taken as a whole; and
- c. the likelihood of confusion alleged should therefore be assessed based on all elements of each of the marks concerned.

This reasoning appears consistent in principle, but it falls short on one point: it failed to consider that one particular element of a mark might be so highly distinctive that reproducing it alone could cause confusion.

As a case in point, the term “Royals” appears to be the sole identifying element of the mark for these goods in the minds of the target audience, such that adding the qualifier “Business” does not diminish the individuality and distinctiveness of the “Royals” mark. The court alluded to elements other than the “Royals” name as forming an indivisible whole, distinguishing each mark from the other. But other than color and logo, the court did not specify what those elements were, making it difficult to assess their relevance. Its reasoning was, in any case, deficient and subject to censure upon further appeal.

Max Lambert Ndéma Elongué

R. Distraint and diversion of a mark – Assignee – Proof of ownership of a mark – Validity of an assignment

The success of an action for the diversion of a distrained mark brought by an assignee is conditional on proving the validity of the assignment – notwithstanding the assignee’s renewal of the registration with the OAPI in its own name – since the ownership of a trademark can be validly transferred only under a clearly valid assignment agreement.

ROTHMANS OF PALL MALL LTD SWITZERLAND V. SOCIÉTÉ ADIL CO. SA AND EL HADJ SANI SOULEY NA SALEY, Interim order No. 176 of August 5, 2008, High Court of Niamey

Observations:

This judgment of the High Court of Niamey illustrates the difficulties encountered by OAPI judicial officers in applying the rules and principles of intellectual property law.

Facts: At first glance, the facts of the case appear to center on the application of seizure law established under the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures. But the case also concerns key aspects of intellectual property law.

The cigarette trademark “Rothmans King Size Filter,” owned by Rothmans of Pall Mall Ltd, of Städtle 36, Vaduz 9490, Liechtenstein (“Rothmans-Liechtenstein”), was the target of an attachment order (distrain) dated November 20, 2017, as security for the payment of CFAF 100 million and CFAF 50 million, respectively, to Adil Co. SA and Mr. El Hadj Sani Souley Na Saley (the distrainers).

Rothmans of Pall Mall Ltd Switzerland (“Rothmans-Switzerland”), believing itself the true owner of the disputed mark, having acquired it from Rothmans-Liechtenstein under an assignment agreement dated May 9, 2002, summoned the distrainers to appear before the judge for urgent applications at the Niamey High Court, seeking an order of diversion of the attached trademark under article 141 of the OHADA Act.

Opposing the application for diversion, the distrainers argued that:

- a. the agreement assigning the trademark was irregular because it lacked certified signatures and did not indicate the extent of the assignment; and
- b. the assignment could not be enforced against them because it had not been recorded in the Special Register of Marks, in violation of article 27 of annex III to ABR-1999.

Reasoning: The court was called upon to examine two legal issues:

- I. the validity of the agreement assigning the trademark; and
- II. its enforceability against third parties.

I. Was the agreement assigning the trademark valid?

The defendants against diversion (the distrainers) disputed the validity of the assignment on which the property rights claimed by the plaintiff (Rothmans-Switzerland) were based, under both common law (A) and intellectual property law (B).

A. Validity of the assignment under common law

Adil Co. SA and Mr. El Hadj Sani Na Sale argued that the assignment was flawed: the signatures of the contracting parties were not certified, so the agreement could not be reliably dated. This is an issue clearly subject to common law in general – and, specifically, the rules governing contractual conditions. Because the disputed assignment agreement was concluded in London, the Niger court in this case considered the agreement’s formal requirements to be beyond its control. But this was erroneous. In private international law, the judge of the forum seized is competent to settle disputes over interactions involving foreign elements on the basis of the law applicable. As the court rightly pointed out, formalities pertaining to the validity of an agreement are subject under private international law to the laws of the place where the agreement was concluded. The court unfortunately failed to verify, however, whether, under English law, the validity of an agreement depends on the

signatures being certified, which would *ipso facto* have affected the outcome of the application for diversion.

B. Assessing the validity of the assignment under trademark law

Article 26(2) of annex III to ABR-1999 provides that “acts involving transfer of ownership, the licensing of the right of exploitation or the assignment of that right, or a pledge or cancellation of a pledge, in respect of a mark shall, on pain of invalidity, be evidenced in writing.” Thus, apart from the common law conditions for contractual validity, such a written act is the only requirement arising from trademark law that, if not met, would invalidate a trademark assignment agreement.²⁵⁶ This represents a departure from common law, where the “consensualist” principle means that agreements need be written only as an exception, *ad validitatem* – that is, where stipulated as a condition for validity. That particular issue, however, did not formally enter into the present case, the disputed agreement having clearly been made in writing and in compliance with trademark law.²⁵⁷

The defendants against diversion argued further that the agreement did not specify the terms of the disputed assignment, whether partial or total.²⁵⁸ The question was whether this failure invalidated the agreement. The judge sidestepped the issue as a matter for English contract law: “In private international law, the formalities for the validity of an agreement are governed by the laws of the place where the agreement was concluded; accordingly, the formal requirements of an agreement concluded in London are beyond the control of a judge in Niger.” While the judge was correct that certification of an agreement’s signatures is a matter of private international law, failure to indicate the material scope of a trademark assignment comes under domestic law, which, in the case of the Republic of the Niger, consists of annex III to ABR-1999, forming the country’s law on trademarks and service marks in accordance with article 3 of its general provisions.²⁵⁹ In any event, a failure to indicate an assignment’s scope in the assignment agreement does not invalidate the agreement. Nor does ABR-1999, under which article 26(1) to annex III provides for the transferability in whole or in part of rights subsisting in a mark, expressly penalize such failure by invalidating the assignment.

II. Enforceability of the agreement assigning the trademark

Adil Co. SA and Mr. El Hadj Sani Na Sale went on to deny the enforceability of the trademark assignment agreement on the grounds that it had not been published in the OAPI Special Register of Marks. This argument calls for some explanations about the assignment registration procedure (A) and its scope (B).

A. Procedure for registering assignments in the Special Register of Marks

Our explanations on this point relate to the registration procedure itself, on the one hand, and the registrant, on the other. On the registration procedure, the OAPI maintains special registers for all member states where information is recorded on individual objects of intellectual property from the time of their registration. The content of those registers varies. For trademarks and service marks, articles 16 and 17 of annex III to ABR-1999 provide for entry into the Special Register of Marks of:

- the serial number of the mark;
- the filing date of the application for registration;
- the date of registration;
- the date of priority, if claimed;
- the trade name, or surname and forename, and address of the owner of the mark;
- a reproduction of the mark; and
- the classes of goods and services covered by the registration.

These data are the same as those included in the registration certificate initially issued to the applicant upon satisfactory review of the application by the competent OAPI authorities.

Events during the lifetime of a mark, including renewals, cancellations and final court decisions, are registrable in the Special Register of Marks. Other examples of such events include the acts referred to in article 26(2) of annex III to ABR-1999 – namely, the licensing of exploitation rights, the assignment of such rights, pledges and cancellations of pledges. That is what can be deduced, at least, from article 27(1) of annex III to ABR-1999, which stipulates that the acts referred to in article 26 are not enforceable against third parties unless recorded in the Special Register of Marks. Under ABR-2015, acts are not enforceable against third parties unless they are both recorded in the Special Register of Marks and published in the official gazette.²⁶⁰ This concerns acts involving:

- the transfer of trademark ownership, such as trademark assignment agreements;
- the assignment of exploitation rights, such as sub-licenses; and
- pledges of trademarks or cancellations thereof.

In view of this, the agreement of May 9, 2002, assigning the trademark “Rothmans King Size Filter,” concluded between Rothmans-Liechtenstein and Rothmans-Switzerland, was registrable in the Special Register of Marks. However, it appears from the facts in the case that no such entry was made. The question is who was responsible for recording the agreement in the register.

According to the judge, based on article 21(5) of annex III to ABR-1999, that responsibility lay with the OAPI, not with the assignee Rothmans-Switzerland. Article 21(5), however, is clearly not the appropriate provision: it

256 See ABR-1999, art. 29(3) of annex III; ABR-2015, art. 32(3) of annex III.

257 See ABR-1999, art. 29(3) of annex III; ABR-2015, art. 30(2) of annex III.

258 See ABR-1999, art. 26(3) of annex III; ABR-2015, art. 32(1) of annex III.

259 Cf. ABR-2015, art. 5(1), which indicates that rights relating to the fields of intellectual property, as provided for in the annexes to the Agreement, are independent national rights subject to the legislation of each member state in which they have effect.

260 ABR-2015, art. 31(1) of annex III.

refers to the entry of trademark registration renewals, not assignments. Those are two separate requirements, entailing separate fees. The applicant's publication of the "Rothmans King Size Filter" trademark in the official industrial property gazette does not necessarily mean that it successfully recorded the alleged assignment in the Special Register of Marks, as required under article 27(1) of annex III to ABR-1999, for it to be enforceable against third parties. The OAPI records assignments in the appropriate register only upon prior request by the interested party – in this case, the assignee – with whom responsibility ultimately lies. The role of the OAPI is merely a supporting one.

B. The registration of assignments in the Special Register of Marks

Such registration is ostensibly optional (2), but it does have legal effects (1).

1. Effects of registering an assignment in the Special Register of Marks

According to article 27(1) of annex III to ABR-1999, trademark assignment agreements not recorded in the Special Register of Marks cannot be enforced against third parties denying their existence.²⁶¹ This provision, which transposes into intellectual property law the principle of the relative effect of agreements set out in article 1165 of the Napoleonic Code, is covered by the Bangui Agreement annexes on patents,²⁶² utility models,²⁶³ industrial designs,²⁶⁴ trade names²⁶⁵ and layout designs of integrated circuits.²⁶⁶ In the case under review, it was clear that the agreement of May 9, 2012, pertaining to the "Rothmans King Size Filter" trademark, was not recorded in the Special Register of Marks. Accordingly, it could not be validly enforced against distraining creditors denying the agreement ever existed. The judge's decision to order diversion of the distrained mark was therefore unfounded.

2. Recording the assignment in the Special Register of Marks: merely an option?

No particular provision of annex III to ABR-1999 expressly obliges the parties to a trademark assignment agreement to request its entry in the Special Register of Marks. Such registration is legally required, however, to assign rights for the exploitation of a trademark. Under ABR-1999, art. 29(4) of annex III, "the license contract shall be entered in the Special Register of Marks of the Organization." OAPI administrative instruction No. 414 appears to bridge this gap by providing for the entry of trademark assignments in the appropriate register, but its scope of application is limited, for at least two reasons: first, administrative instructions issued by the management of the OAPI apply only within the OAPI legal system and thus cannot validly correct a statutory oversight; and second, the instructions concern only partial assignments and are in any case not mandatory.

261 ABR-2015, art. 31(2) of annex III.

262 See ABR-1999, art. 34(1) of annex I.

263 See ABR-1999, art. 29(1) of annex II.

264 See ABR-1999, art. 21(1) of annex IV.

265 See ABR-1999, art. 15(3) of annex V.

266 See ABR-1999, art. 19(1) of annex IX.

It can therefore be argued that Rothmans-Switzerland was not required to request the entry of the assignment agreement of May 9, 2002, in the Special Register of Marks and that therefore its failure to do so did not otherwise affect the agreement's validity.

Max Lambert Ndéma Elongué

S. Sequestration of a mark – Liability of a mark to attachment – Legal basis – Procedure – Place of attachment

A trademark is an asset within the meaning of civil law that is liable to sequestration on the basis of articles 54 *et seq.* of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures. Such sequestration is to be executed, where community law is silent on the matter, in accordance with the established procedure for attaching securities and partnership rights.

However, it is a misapplication of the law for a trial judge to validate the attachment of a mark carried out on an OAPI national liaison structure rather than on OAPI headquarters, which is the only structure empowered to hold and manage industrial property titles.

ROTHMANS OF PALL MALL LTD SA V. SOCIÉTÉ ADIL CO. AND EL HADJ SS, Judgment No. 118 of May 20, 2008, High Court of Niamey

Observations:

Product or service trademarks, as governed by the provisions of annex III to ABR-1999, are assets liable to compulsory execution and protective measures in accordance with articles 28 *et seq.* of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures. That is the principle set out in the decision reported here. Indeed, since OAPI law does not regulate the attachment of intellectual property and since trademarks, like other industrial property, are assets within the meaning of civil law, the common law on attachment applies. As a matter of comparative law, article R.714-4 of the French Intellectual Property Code refers to the attachment of trademarks but without prescribing a procedure for it. Article L.616-21 of the Code provides that: (i) patents may be attached by extrajudicial act served on the patent owner, on the National Institute of Industrial Property and on the holders of rights to the patent; and (ii) such attachment renders unenforceable against the distraining creditors any subsequent modification of patent rights.

This apparent disregard for creditors is aggravated by the paucity of enforcement measures for intangible assets in the new French Code of Civil Enforcement Procedures.²⁶⁷ Both in France and much more so in Africa, enforcement law seems to overlook intellectual property assets, which can be highly valuable and provide the

267 See C. Hugon (2018) La réalisation forcée des propriétés intellectuelles en droit française. *Les cahiers de droit*, 59(Z), 425–440.

creditors of their owners unprecedented guarantees. Determining the legal framework and procedure for attaching trademarks is thus inherently difficult. This is particularly so in the case of OHADA member states, where the Uniform Act deals with the attachment not of intellectual property but of securities and partnership rights. Part VII of the OHADA Uniform Act Organizing Simplified Recovery Procedures and Enforcement Measures is entitled “Special provisions relating to partnership rights and assignable securities.” There is no specific provisions for patents, trademarks, service marks, copyright and related rights, and so on. Such issues can be daunting for the creditors of intangible property owners, as appears to be the case here.

Facts: According to the facts, by judgments No. 124 of June 5, 2006, and No. 235 of October 16, 2006, the Court of Appeal of Niamey ordered Rothmans of Pall Mall Ltd SA (“Rothmans”) to pay the sums of CFAF 100 million and CFAF 50 million, respectively, to Adil Co. and Mr. El Hadj Sani, for improperly conducting an infringement seizure. In executing those judgments, on November 20, 2007, the latter parties obtained sequestration of their common debtor’s cigarette trademark, No. 37610, “Rothmans King Size Filter,” in the custody of the OAPI national liaison structure.

Now, under article 2 of the regulations for collaboration between the OAPI and national liaison structures, adopted at the 47th ordinary session of the OAPI Administrative Council, national liaison structures are national public administrations or other structures placed under the authority of the head of the department in charge of industrial property and serving as a point of contact for users of OAPI services. The sequestration was subsequently annulled by the Court of Appeal of Niamey as per judgment No. 26 of March 5, 2008, for the violation of articles 54, 88 and 238 of the OHADA Uniform Act.

Two additional sequestrations executed by Adil Co. and Mr. El Hadj Sani, on March 25 and 26, 2008, were then referred to the High Court of Niamey for annulment. Rothmans claimed, first, that the OHADA Uniform Act concerned does not provide for the sequestration of trademarks, which are not subject to seizure and are governed by ABR-1999, and, second, that the sequestration was unlawfully executed by the national liaison structure in Niamey – namely, the Ministry of Commerce. The distrainers argued in response that trademarks are intangible assets subject to sequestration under the OHADA Uniform Act. The court was called upon to examine two questions of unequal weight – namely, whether trademarks can be sequestered, and if so, on what basis and according to what procedure.

Reasoning: In its decision, the Court of Appeal of Niamey clearly established the principle that trademarks can be sequestered (section I), but without indicating the procedure for doing so (section II).

I. The principle: trademarks can be sequestered

Whereas the legal nature of trademarks or service marks as industrial property assets does not appear *a priori* to preclude their sequestration (A), the legal basis for performing it must be stipulated, because such matters are generally more complex than they appear (B).

A. The legal nature of trademarks

Whether a mark can be sequestered, which Rothmans disputed, depends on whether it constitutes a good, as defined by the Civil Code.²⁶⁸ As movable assets, trademarks fall into two distinct legal subcategories: tangible and intangible. While a tangible movable can be physically seized, an intangible movable consists of a right over a movable object. This distinction is of particular legal import when interpreting rules on the sequestration of such assets, which their intangible nature would appear to preclude. Among such intangible movables, a distinction is generally drawn between personal intangible rights and those determined by law, which include intellectual property.

From this perspective, a trademark acquired by its owner upon registration with the competent industrial property office cannot escape the reach of the owner’s creditors, who can obtain sequestration of the mark from judicial authorities. In the case under review, Rothmans was unquestionably the owner of the “Rothmans King Size Filter” cigarette trademark, filed with the OAPI on March 27, 1997, and registered under No. 37610. The company’s creditors, Adil Co. and Mr. El Hadj Sani, were owed CFAF 116,716,800 and CFAF 58,867,946, respectively, in principal and expenses, secured by enforceable titles. They were thus entitled to sequester and sell the trademark to settle those debts.

B. Legal basis for sequestering a trademark in OAPI countries

The legal basis for sequestering intellectual property assets is ordinarily found in a country’s intellectual property code, which in this case was surprisingly silent on the matter (1), or its civil enforcement procedure (2).

1. The country’s intellectual property code: the Bangui Agreement

None of the various iterations of the Bangui Agreement, which serves as the intellectual property code of OAPI member states, includes provisions on the seizure of intellectual property assets, leaving the matter to each country’s discretion. This remains true in ABR-2015. The silence of community legislators on this point is attributable to the original intent that the OAPI would govern intellectual property matters for all signatory countries, while referring civil and criminal procedural questions, with certain exceptions, to their national legislators. In that sense, a number of specific procedural rules intended for application in all member states are set out in the Agreement, as a start in harmonizing their

²⁶⁸ According to art. 516 of the Napoleonic Code, all goods are movable or immovable.

fundamental principles of court proceedings. Those principles include:

- the referral of civil actions relating to certain industrial property titles to civil courts for summary judgment;
- the exceptional jurisdiction of correctional courts to hear questions relating to nullity, forfeiture and ownership of titles;
- the time limit after seizure for bringing proceedings before the trial judge;
- the requirement of a prior complaint by the victim for public proceedings to be brought; and
- the communication of certain cases to the public prosecutor's office.

In addition, the OAPI may be reluctant to interfere in an area currently covered by its sister organization, OHADA, given that almost all OAPI member states have acceded to the OHADA Treaty.²⁶⁹ The Bangui Agreement does refer in passing, however, to the transfer and pledge of certain industrial property titles, including patents,²⁷⁰ utility models,²⁷¹ trademarks and service marks,²⁷² and industrial designs. With respect to the pledging of trademarks, the Bangui Agreement stipulates only that pledges should be evidenced in writing. No mention is made of the applicable legal regime, implicitly leaving matters of securities law to national legislators. In any event, in the absence of any provision for sequestration in the Bangui Agreement, the common law in each member state applies, as the High Court of Niamey rightly observed in its summary judgment No. 118 of May 20, 2008.

2. Applicability of the OHADA Uniform Act

Regarding the applicability of the OHADA Uniform Act, the High Court of Niamey made the following points.

- a. The Uniform Act is applicable under its article 337 to protective measures, recovery by distraint and recovery proceedings initiated after its entry into force.
- b. The case submitted for examination by the court concerned a dispute over a seizure – specifically, a recovery by distraint.
- c. The applicant argued that enforcement measures are governed solely by the Uniform Act, regardless of the object or the property concerned by the seizure or protective measure.

That reasoning – in particular, the citation of article 337 – appears sound, since, upon ratification by Niger, the OHADA Treaty automatically superseded the country's prior legislation on enforcement. In addition, article 56 of the OHADA Uniform Act provides a legal basis for seizure of the trademark, stipulating that sequestration

may be carried out on all tangible or intangible personal property of the debtor, and it renders such property inalienable. The claim made by Rothmans that the Uniform Act was not applicable to trademarks, which were governed by ABR-1999, was therefore specious.

But certain aspects particular to trademarks do not fit well under a legal regime designed to deal with tangible assets. The immateriality of trademarks calls for the adoption of special provisions. It is surprising, then, that the OHADA Uniform Act, in Part VII on special provisions relating to partnership rights and assignable securities, makes no mention of intellectual property. That may have been a simple omission or a deliberate decision by the legislator. Either way, this discriminatory treatment of intangible property was always likely to hamper the execution of trademark sequestration.

II. Executing trademark sequestration

Neither do these legal provisions indicate the procedure that needs to be followed to sequester trademarks – an omission that makes their execution all the more difficult. As a result, it is not immediately obvious what model to follow in conducting the sequestration, while also doing justice to the specificity of the trademark concerned. In the present case, determining where the trademark should be attached (A) and the requirements to be met for enforceability (B) was a complex task indeed.

A. Place of attachment

The judge of the High Court of Niamey ruled in favor of the creditors, who carried out the attachment on the Ministry of Commerce of the Republic of the Niger. In response to the debtor, which challenged the validity of that act, contending that it should have been performed at OAPI headquarters in Yaoundé, the judge observed that the trademark was attached as intangible property from the OAPI national liaison structure in its capacity as the only authorized agent of the OAPI in Niger.

This reasoning is conspicuous on two accounts. First, the national liaison structure – in this case, the Ministry of Commerce of Niger, the role of which is outlined above – is not an authorized agent of the OAPI but a national public administration, reporting to a ministerial department and serving as a channel of communication between the OAPI and its users. The profession of agent is governed by a special rule established by Resolution No. 48/13 adopted at the 48th ordinary session of the Administrative Council, held in Brazzaville on December 16, 2008. Within the meaning of articles 2 *et seq.* of that resolution, agents are broadly understood to be natural or legal persons empowered to act in accordance with a mandate, whether in a professional capacity or not, on behalf of another natural or legal person to carry out intellectual property operations for the OAPI. Within that meaning, a public administration cannot act as an agent.

In this case, under article 6(2) of ABR-1999, the national administration was authorized to receive applications

²⁶⁹ Article 1 of the Cooperation Agreement of May 9, 2016, concluded between OAPI and OHADA, specifies that the objectives and missions of the two regional organizations are similar and complementary with regard to the improvement of the legal and judicial environment, aiming to secure economic investment in their member states.

²⁷⁰ See ABR-1999, art. 33 of annex I; ABR-2015, art. 36(2) of annex I.

²⁷¹ See ABR-2015, art. 31(2) of annex II.

²⁷² See ABR-1999, art. 26(2) of annex III; ABR-2015, art. 30(2) of annex III.

for industrial property titles from users domiciled in its territory and had to transmit those applications to the OAPI within five working days of submission. The national liaison structure did not keep or manage industrial property titles on a day-to-day basis. It would seem rather unusual to perform the attachment of an object, on a precautionary basis or otherwise, that was not in the possession of the entity targeted for that procedure – in this case, the country's Ministry of Commerce.

The attachment could, however, have been validly performed at the OAPI headquarters in Yaoundé, in its capacity as the sole organization empowered not only to issue trademark registration certificates but also to hold and manage them day to day. This solution has the disadvantage of being expensive for creditors domiciled outside the OAPI host country, Cameroon. They also run the risk of having the exequatur for local execution of a foreign decision rejected by the competent court in Cameroon, potentially producing an impasse.

The option of attaching the trademark at OAPI headquarters appears more consistent with article 236 of the OHADA Uniform Act. That article, applicable *mutatis mutandis*, stipulates that the attachment of partnership rights and assignable securities “should be carried out on the issuing company or corporate person or on the authorized agent charged with the preservation or management of the securities.” That was the provision the High Court of Niamey cited in validating the attachment carried out on the Ministry of Commerce, which, as established above, neither keeps nor manages industrial property titles. The situation is no less confusing when one considers the high degree of formality required to make such attachments enforceable.

B. Formal requirements for enforceability

In the case under review, the attachment was carried out on the national liaison structure, the country's Ministry of Commerce, in breach of article 236 of the OHADA Uniform Act, as established above and argued by Adil Co. Traditionally and in line with articles 236 *et seq.* of the Uniform Act, two notices must be served to attach intangible property: one to the manager of the title in question – in this case, the OAPI – and the other to the debtor/distrainee – in this case, Rothmans of Pall Mall Ltd. The latter must be informed within eight days under pain of forfeiture.²⁷³ In the case under review, whereas attachment of the cigarette trademark “Rothmans King Size Filter” was notified to the debtor company, it is clear that no writ of attachment was served on the third party concerned, the OAPI, thus rendering the attachment unenforceable. The OAPI, in its dual capacity as curator and manager of the trademark, enters into the appropriate registers all acts occurring during the trademark's lifetime and thus should have been the first recipient of the writ of attachment.

If only for that reason, the decision of the High Court of Niamey validating the attachment of the trademark in question, notwithstanding the failure to notify the third party concerned, was fatally flawed.

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273 See art. 238 of the Uniform Act.



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Chapter 4

Industrial designs

A. Industrial designs – Novelty – Manifest use – Destruction of novelty – Prior personal possession

An industrial design registered with the OAPI is considered new and thus eligible for legal protection if elements for comparing it with others do not exist. Moreover, its exploitation by a third party beginning less than six months before the filing date does not meet the criterion of prior manifest use required to defeat novelty. In rejecting a design's prior personal possession, as claimed by a third party unable to demonstrate prior exploitation of the design in its own name or on the basis of a licensing agreement, a court applies the law correctly.

SOCIÉTÉ DES RAFFINERIES DU LITTORAL V. ETABLISSEMENTS NGO OND & FILS, Judgment No. 58-cc of March 18, 1999, Supreme Court of Cameroon

Observations:

Article 3(1) of annex IV to the Bangui Agreement of March 2, 1977 (AB-1977) excluded legal protection for industrial designs that, on the date of filing of the application for registration or on the date of the validly claimed priority, had manifestly been utilized in the territory of one of the member states of the OAPI. The element of novelty was therefore relative: it could not be denied based on disclosures outside the OAPI space. That provision was substantially modified to become article 2(2) of annex IV to the Bangui Agreement as revised on February 24, 1999 (ABR-1999). It now provides that a design is novel where "it has not been disclosed anywhere in the world by publication in tangible form, by use or by any other means before the filing date or, where applicable, before the priority date of the application for registration." That wording, which remains intact in the Bangui Agreement as revised on December 14, 2015 (ABR-2015), requires absolute novelty for an industrial design to be eligible for legal protection.¹ The decision reported here is interesting in several ways. It provides an overview of how the concept of novelty has evolved since AB-1977 and sheds light on article 8 of its annex IV to that original text, on the exception of prior personal possession, reproduced *expressis verbis* as article 7 in annex IV to ABR-1999.

Facts: Etablissements NGO OND & Fils held the rights to a design for bags used to package palm oil, filed with

the OAPI on July 30, 1991, and registered on May 17, 1993, under No. 1062. Based on a bailiff's report dated November 19, 1991, NGO OND & Fils became aware of illegal use of its design by Société des Raffineries du Littoral. The latter, claiming prior personal possession under article 8 of annex IV to AB-1977, contested the novelty of the design filed by NGO OND & Fils on the grounds of having itself manifestly utilized it since March 1991 – that is, prior to the filing date. The key questions for the Supreme Court – beyond concerns relating to jurisdiction and compensation for damages, not discussed here – were:

- a. whether the design filed by NGO OND & Fils was novel within the meaning of article 3(1); and
- b. whether Raffineries du Littoral was entitled to claim prior personal possession.

Reasoning: In its ruling, the Supreme Court concurred with the lower courts that:

- I. the disputed design was new; and
- II. the conditions for prior personal possession had not been met.

I. Determining novelty with respect to designs

According to the Supreme Court, the design for the bags registered under No. 1062 was new (A) and its novelty had not been defeated (B).

A. The meaning of novelty

According to article 2(1) of annex IV to AB-1977, "the present Annex shall apply to any new design, any new three-dimensional form or to any industrial object which differs from like objects either by a distinct and recognizable form giving it an aspect of novelty, or by one or several external effects giving a new and distinct appearance." The provision characterizes the features of a design eligible for legal protection but does not define novelty. It is argued in the literature² that the novelty required to register an industrial design under AB-1977 was both objective and relative:

- objective in that it could be defeated by disclosure prior to the design's filing for registration – making it ineligible for protection; and

¹ Unlike AB-1977, the subsequent revisions in ABR-1999 and ABR-2015 allow for denial of novelty if the design in question has been made available to the public anywhere in the world.

² S. Ngo Mbem (2007) Les enjeux de la protection des dessins et modèles industriels dans le développement en Afrique: le cas des pays membres de l'Organisation Africaine de la propriété intellectuelle (OAPI). Doctoral thesis, University of Strasbourg III-Robert Schuman, 88 *et seq.*

- relative in that the prior disclosure required was limited to a description of the design in printed publications, or its manifest utilization in the territory of an OAPI country.

In challenging the design's novelty, Raffineries du Littoral claimed to have used the design itself since March 1991, but without specifying its characteristic features. The lack of any elements for comparison allows no further comment here on that important point.³ According to the Supreme Court, the bailiff's report merely established that Raffineries du Littoral had marketed the OAPI-protected design without permission and that NGO OND & Fils had filed it with OAPI on July 30, 1991. Such a report, the court reasoned, was clearly no basis for establishing similarities between the protected design and the one used by Raffineries du Littoral. And yet, as one author has argued,⁴ the novelty of a design also has to be assessed in terms of the essential criterion of disclosure, while avoiding confusion between the concepts of specialty and novelty – specialty being premised on the absence of similar prior works; novelty, on the absence of prior disclosure. The debate ultimately came down to the prior use claimed by Raffineries du Littoral, with the Supreme Court finding failure to demonstrate the manifest prior use required to destroy the design's novelty.

B. Destruction of novelty

The situations in which the novelty of a design can be destroyed were indicated in article 3(1) of annex IV to AB-1977. One of those situations is where, on the date of either the application or the claimed priority, the design is being "manifestly utilized" in the territory of an OAPI country.⁵ However, the Supreme Court's interpretation of the term "manifestly," in the silence of the law on that point, elicits reservations. The court considered that use of the bags by Raffineries du Littoral began only in March 1991 – too short a time before the filing to be considered "manifest." A longer period and elements relating to publicity and consumer habituation were required. The court was right to consider publicity – and, to a lesser degree, consumer habituation – but deeming use to be "manifest" based on the duration of that use, without first establishing what duration would suffice, appears risky. Such an approach creates judicial insecurity, especially given the lack of a central OAPI court to maintain uniform application of community law, leaving each country's highest court to interpret such terms differently.

Manifest use, as conventionally understood, implies that the public, or a large number of people in a given sector, know about the object used. The Court of Appeal of Lomé, in the area of trademarks and service marks,

3 See *Mr. Bertin Dabe Zohora v. Société Orange Côte d'Ivoire and Société NTDD*, Judgment No. 1929/2015 of July 23, 2015, Commercial Court of Abidjan (obs. A. Lucas, this collection, Chapter 4, section D).

4 C. Seuna (2009) La notion de dessins et modèles industriels susceptibles d'enregistrement: essai de théorie juridique. *RAPI*, 2, 26.

5 ABR-2015, art. 2(2) of annex IV, states that "an industrial design is new if it has not been disclosed anywhere in the world by publication in tangible form, by use or by any other means before the filing date or, where applicable, before the priority date of the application for registration."

has held that a trademark's longevity, the extent of its marketing and the geographic scope of its distribution must all be considered to determine how manifest the mark's use might have been.⁶ From that perspective, the prior use in this case could legitimately be considered manifest, especially since the bags designated were openly sold and used in Douala as packaging for a widely consumed product – namely, palm oil.

According to the facts, moreover, NGO OND & Fils presented its bag design at a 1990 trade fair, from a stand set up for the event by Raffineries du Littoral and at the latter's request. The question thus becomes whether the disclosure then made, occurring prior to the filing date of July 30, 1991, was sufficient under article 3(1) to destroy the design's novelty. The answer is far from obvious. Article 3(2)(b) of annex IV to AB-1977, the basis for this decision, provides that the novelty of a design cannot be denied if, during the six months preceding the date of filing or claimed priority, the applicant (or predecessor in title) has disclosed it by display at an official or officially recognized international exhibition, as NGO OND & Fils clearly did. But the precise date of that disclosure (in 1990) is unknown, so the period of time between the disclosure and the filing date (July 30, 1991) cannot be calculated.

II. Prior personal possession

In the interest of fairness, the original drafters of AB-1977 limited the exclusive character of rights to an industrial design, as conferred by registration, based on a third party's prior personal possession, as described in article 8 of annex IV. Application of that provision, however, is premised on prior use of the design (A) and the prior user's good faith (B).

A. Prior use of an identical design

Article 8 of annex IV to AB-1977 reads:

"The registered industrial design shall not produce effects in respect of third parties who, at the time of filing of the application for registration, already exploited the said design on the territory of one of the member states or who had taken the necessary steps with a view to exploiting it. The said third party shall be authorized to use the industrial design in his business, his own workshops or those of other persons. This right may only be transferred with the business."

Prior personal possession is also provided for in ABR-1999 and ABR-2015, although the provisions have changed over time. In article 7(a) of annex IV to ABR-2015, where the conditions are set out, the word "exploited" is replaced with "owned," and the exception based on the third party having "taken the necessary steps with a view to exploiting it" is eliminated. The provision now reads:

6 See *Etablissements W.C.v. Etablissements MLT*, Judgment No. 80 of September 18, 2007, Court of Appeal of Lomé, concerning the trademark "PANTHERE NOIRE."

“The rights deriving from the industrial design shall not encompass ... acts performed by any person who, on the filing date of the application for registration, already owned the design. Such a person is authorized to use the industrial design for the purposes of his business, in his own workshops or in another person’s workshops. This right may only be transferred with the business.”

In any event, the version in force when this decision was handed down was AB-1977, which limited the eligibility of third parties to claim prior personal possession to those having already privately exploited the same object, as creator or assignee, on the territory of an OAPI member state before the design’s date of filing or claimed priority. Raffineries du Littoral, needless to say, did not meet that criterion. It owed its use of the design to the true creator, NGO OND & Fils, which also delivered the bags to users, as evidenced by the various invoices submitted into evidence. The Supreme Court rightly noted that Raffineries du Littoral did not provide proof that it was exploiting the contested invention before July 30, 1991, the date on which the disputed design was filed with the OAPI.

Neither was the supposed exploitation of the bag design substantiated by any reference to a license. Raffineries du Littoral exploited the bag design without a license, even though one is required by the Agreement – which nicely sets up the last important question: did the user act in good faith?

B. The user’s good faith

The condition of good faith is not expressly stated in the provision applicable to the design in this case, article 8 of annex IV to AB-1977, let alone the succeeding provisions of ABR-1999 and ABR-2015. The need to prove a prior user’s bad faith, however, has been emphasized in the literature under the maxim *fraus omnia corrumpit* (“fraud corrupts all”),⁷ assimilating the system for industrial designs with that for patents. In the latter area, article 8(1)(d) of annex I to ABR-1999 and article 7(1)(e) of annex I to ABR-2015 expressly require good faith on the part of prior patent owners. The same requirement makes sense for industrial designs and models, given the possibilities for fraudulent appropriation of such creations.

In the case under review, Raffineries du Littoral clearly acted in bad faith in claiming a right of prior use over the bag design, providing no evidence of having created it, having instead simply bought the bags on the open market like any other customer (such customers also being its competitors). Such a willful attempt to unlawfully appropriate the fruit of another’s creative efforts constitutes an offense, incurring the offender’s liability for damages under common law, and hence the Supreme Court’s ruling to uphold the lower court’s award of compensation to NGO OND & Fils.

Max Lambert Ndéma Elongué

⁷ See Ngo Mbem, n. 2, at 123 *et seq.*

B. Industrial designs – Novelty – Elements constituting infringement

A model of bowl must be considered new if differently formed than ordinary bowls on the market, such that the marketing of a design resembling it constitutes infringement.

SOGET – IVOIRE V. SIFAM – CI, Judgment No. 32 of February 4, 2010, Supreme Court of Côte d’Ivoire, Judicial Chamber

Observations: The ruling reported here has produced a muddled combination of conditions under two different intellectual property regimes: the one for copyrights, protecting works of the mind; and the other for industrial designs or models and rights thereto. The case warrants attention all the same, because it provides a good illustration of those two separate regimes and a chance to better delineate the distinction between them, based on the more rigorous wording of the current Bangui Agreement.

Facts: In registering a model of bowl for protection, a company selling aluminum household utensils also initiated proceedings for infringement and unfair competition against a company marketing an alleged copy of the model. The trial court and, subsequently, the Court of Appeal of Abidjan dismissed the claim, finding the plaintiff’s model to be unoriginal and, in any case, different from that of the defendant.

The company took its case to the Supreme Court of Côte d’Ivoire.

Reasoning: The Supreme Court quashed the appeal court’s ruling, both for violation of article 2(1) of annex IV to AB-1977 and for “insufficient grounds.” Invoking its power under Ivorian law to rule on the merits, the Supreme Court affirmed that “[t]he benefit of protection established by annex IV to the Bangui Agreement is subject not only to the novel character of the registered model, but also to its originality,” and that (referring to the same text) “a design is new if no identical design or model has been disclosed as of the filing date of the application for registration.” The court then found on the facts that the plaintiff’s model was differently formed than ordinary bowls on the market and did, in fact, resemble the plaintiff’s; on that basis, it found against the defendant’s argument that the model at issue was “unoriginal.”

Since we do not have the facts of the case, we will not examine the merits of this solution. The court’s two-part reasoning, however, warrants serious reservations.

To start with, the text applicable in this case was the original AB-1977. Article 2(1) of annex IV to that version provides that “the present Annex shall apply to any new design, any new three-dimensional form or any industrial object which differs from like objects either by a distinct and recognizable form giving it an aspect of novelty, or by one or several external effects giving a new and

distinct appearance.” The judgment being appealed had misread that article in denying protection on grounds of lack of originality. But the Supreme Court reviewing it was equally mistaken. It began by attributing a “distinct appearance” – more easily asserted than demonstrated – to the allegedly infringing model, equally premised in article 2(1). The court then went on to assert that a model must be both new and original to qualify for protection under the Bangui Agreement. That assumption is clearly contrary to annex IV (of AB-1977 and ABR-2015), which in no way requires originality.

The most recent revision of the Agreement, ABR-2015, draws a clear distinction between the object to be protected and the conditions for its protection, unlike AB-1977, which covered both in a single provision. Article 1(1) of annex IV to ABR-2015 defines a design as “any arrangement of lines or colors” and a model as “any three-dimensional shape, whether or not associated with lines or colors ... provided that the said arrangement or shape gives a special appearance to an industrial or craft product and may serve as a pattern for the manufacture of such a product.” According to article 2(1) of the same annex, “an industrial design may be registered if it is new.”

The court’s approach can be likened to that of the European Union in its Regulation 6/2002 of December 12, 2001, on community designs. In article 3(a) of the Regulation, a design is defined as “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation.” Article 4, on conditions for protection, provides that “a design shall be protected to the extent that it is new and has individual character.” The novelty requirement is therefore common to both the EU Regulation and the Bangui Agreement. The difference is that the European Union adds the condition of “individual character.” However, on closer inspection, that requirement might also be deduced from the definition in article 1(1) of annex IV to ABR-2015, which refers to the “special appearance” given to a product. Thus the distinction between the object to be protected and the conditions for its protection is no longer that clear.

It has, in any case, been established that the protection of a design under the Bangui Agreement is conditional on novelty rather than originality. The two concepts do not overlap and could even be considered opposites. In the field of intellectual property, the term “originality” is traditionally understood subjectively – that is, with reference to the personality of the creator, which must be clearly reflected in the object created; “novelty” is understood objectively as the absence of prior art, as stipulated in article 2(2) of annex IV to ABR-2015.⁸

This distinction is admittedly not always clear in judicial practice. Assessments of originality in the case of a

8 “An industrial design is new if it has not been disclosed anywhere in the world by publication in tangible form, by use or by any other means before the filing date or, where applicable, before the priority date of the application for registration.” See also art. 5 of Council Regulation (EC) No. 6/2002 of December 12, 2001, on Community designs, OJ L 3/1.

copyright may take into account objective elements, such as the existence or absence of prior art. Some national laws treat the concept less subjectively than the traditional search for the imprint of an author’s personality implies. One such law is Côte d’Ivoire’s Law No. 96-564 of July 25, 1996, on the protection of intellectual works and the rights of authors, performers and phonogram and videogram producers. In its article 1, an original work is defined as an author’s own intellectual creation – a criterion initially used in EU law to assess the originality of computer programs⁹ and later extended to all works by the Court of Justice of the European Union, in the case *Infopaq International A/S v. Danske Dagblades Forening*.¹⁰ That criterion is considered sufficiently broad to accommodate the approach traditionally taken to copyright: calling original what is not a copy.¹¹

However, it was wrong, in our view, for the court to impose both requirements, originality and novelty. Novelty alone should suffice.¹² The court was also wrong to make the protection of a design under the Bangui Agreement conditional on its “innovative character” – an awkward turn of phrase, reminiscent of the “inventive step” required of patentable inventions.¹³ The absence of prior art should be the only consideration, in line with the court’s subsequent characterization of novelty as “where no identical design has been disclosed on the filing date of the application” and its assertion that the plaintiff’s model differed from “ordinary bowls on the market,” even if then specifying, as per article 5(2) of EU Regulation 6/2002 of December 12, 2001, that designs are deemed to be identical where their features differ only in immaterial details.

The novelty of the allegedly infringing design having been established, all that was needed was the finding on infringement. The court’s reasoning on that point was slim indeed. Having invoked its power to settle the matter, it said very little; merely that the second model of bowl “resembled” the first. The practice in industrial property matters, it is true, is to judge infringement based on similarities rather than differences. Better practice would have been to compare the two models and precisely characterize the points of resemblance between them – even if only to demonstrate their immateriality (i.e., as not relating to essential characteristics of the protected model and not required by functional considerations) – and to dismiss the infringement action accordingly.

André Lucas

- 9 Council Directive 91/250/EEC of May 14, 1991, on the legal protection of computer programs, OJ L 122/42, as consolidated by Directive 2009/24/EC of the European Parliament and of the Council of April 23, 2009, on the legal protection of computer programs, OJ L 111/16, art. 1(3).
- 10 *C-5/08 Infopaq International A/S v. Danske Dagblades Forening*, Judgment of the Court (Fourth Chamber) of July 16, 2009, ECLI:EU:C:2009:465.
- 11 A. Lucas, A. Lucas-Schloetter and C. Bernault (2017) *Traité de la propriété littéraire et artistique*, 5th edn. Paris: LexisNexis, No. 141.
- 12 For a similar view, see P. Fieni, (2011) *Actualités juridiques*, No. 71, 124, noting that the same decision “adds to the confusion regarding the criteria for the protection of industrial models.”
- 13 ABR-2015, arts. 2 and 4 of annex I.

C. Industrial designs and models – Novelty (lack of) – Models claimed to be identical to those previously worked by the defendants

An action for infringement brought by a plaintiff who has filed models of tableware for registration with the OAPI that are identical in all respects to articles being worked for multiple years by the defendant – and which thereby fail the test of novelty – cannot be admitted.

MR. ALI MROUE V. SOCIÉTÉ NESTLÉ CÔTE D'IVOIRE AND ORS, Judgment No. 1915/2013 of March 4, 2014, Commercial Court of Abidjan

Observations:

The court's solution in this judgment, dismissing an action for infringement of industrial models, is not inherently problematic, but there are flaws in its reasoning that merit discussion.

Facts: In filing models and designs with the OAPI for plastic plates, glasses, spoons, knives and forks – and before starting to manufacture them – the plaintiff accused various companies headquartered in Abidjan of marketing infringing tableware imported from other countries, including China and Turkey.

The Commercial Court of Abidjan ruled otherwise.

Reasoning: A registration is not enforceable unless the novelty of the models and designs at issue can be established. In the present case, the court additionally acknowledged that “various bills of lading and delivery notes” produced by the defendants showed their prior use, “for a number of years, of household goods identical in all respects to the models and designs at issue.” The court concluded that the condition specified in article 2(2) of annex IV to ABR-1999 had not been met and dismissed the complaint.

While it is difficult to form an opinion on the court's assessment of novelty, based on the information provided in the judgment, several reservations are nonetheless in order.

First of all, the court's decision was regrettably ambiguous as to the nature and number of the protected creations. The dispute appeared to concern models (for tableware), while the court referred repeatedly to “models and designs.” The same legal regime applies to both, but strictly speaking the distinction should be respected. It is conventionally accepted that *designs* are two-dimensional figures, while *models* have three dimensions.¹⁴ Article 1 of annex IV to ABR-1999 defines a design as “any arrangement of lines and colors,” and a model as “any three-dimensional shape, whether or not associated with lines or colors.” Moreover, the creations concerned were covered by a single registration, while the action for infringement related to a series of models

(the judgment expressly referred to “the offending household items”). In that respect, the court's summary of the facts, referring to a request to ban “model and design No. 3191,” is an unfortunate source of confusion.

On the merits, the court's summation may have gone too far in finding that the goods marketed “for several years” by the defendants were “identical in all respects to the claimed models and designs.” It would have been more correct to explain in detail, model by model, how the goods were identical and precisely when they were marketed. The court sought justification for denying novelty in the plaintiff's admitted postponement of production “for fear of unfair competition by the defendants,” as though such admission somehow attested to prior use, the basis for defeating novelty. Such reasoning seems flimsy. It would be more natural that an exclusive right holder to industrial models would await judicial confirmation of its exclusive right before investing in production.

The court also erred on two accounts in analyzing the consequences of defeating novelty. To start with, it denied a request by one of the defendant companies to cancel the plaintiff's registration with the OAPI, reasoning first that, for models or designs,¹⁵ annex IV does not indicate failure to meet the criteria of novelty or originality¹⁶ as grounds for canceling registration, and second that while article 23 of annex III does provide for cancellation of a registered trademark if not worked for five years, failure to work the designs was not the basis, in this case, for seeking cancellation.

The argument is completely off-target. The legislation imposes no obligation to work industrial models or designs. Cancellation could not be granted because it was not the applicable punishment. The consequence of destroying novelty, under article 30(1)(a) of annex IV to ABR-2015, is invalidity, not cancellation, of the registration concerned.¹⁷ Article 20 of ABR-2015 stipulates that “final judicial decisions rendered in respect of the validity of titles in a Member State pursuant to the provisions of Annex I to Annex X of this Agreement shall be binding on all other Member States, save for decisions based on public policy and morality.”

Which brings us to the court's second error. Rather than rule it invalid for lack of novelty, the court reasoned in terms of the registration's unenforceability. To justify its reasoning, the court invoked article 7 of annex IV to ABR-1999, the version applicable to the case, which reads:

“The registered industrial design shall not be binding on third parties who, at the time of filing of the application for registration, were already exploiting the said design in the territory of one of the member states or had taken the necessary steps with a view to exploiting it. The said third

15 This is presumably a typographical error: the judgment actually refers to the cancellation of a trademark.

16 This error is beyond typographical: there is no originality requirement for industrial models and designs.

17 See also Regulation 6/2002, n. 8, art. 25(1)(b).

14 J. Azema, and J.-C. Galloux (2012) *Droit de la propriété industrielle*, 7th edn. Paris: Dalloz, No. 1184.

party shall be authorized to use the industrial design in his business or his own workshops or in those of other persons.”

The court interpreted this provision as prohibiting the registrant from “calling into question the acquired rights of third parties who were already using the said design or model but who neglected or did not think it necessary to register it with the appropriate intellectual property institution.”

That reasoning results from confusion worth sorting out. *Unenforceability* is the situation in which a third party can set aside the effects of a legal act, the validity of which is not in question. The very different situation here calls for *invalidity*, which renders the act void with retroactive effect. Where a model does not meet the novelty requirement, there is simply no protection. In that event, it makes little sense to seek dismissal of an infringement action by invoking prior personal possession of an industrial model, design or patent,¹⁸ since the party using those creations can continue doing so. In any event, article 7 of annex IV permits the “possessor” to use the model or design in question only “in [their] business,” which excludes the licensing of distributors, as does article 22(3) of EU Regulation 6/2002.¹⁹

Having ruled on the question of novelty, the court need not have responded to the other two defenses, neither material, pleaded by three of the defendant companies. Their argument for exoneration was that they had engaged only in distribution and had never claimed intellectual property rights over the models and designs. Article 3 of annex IV clearly recognizes a right holder’s “exclusive right to exploit the said design and to *sell* or cause to be sold for industrial or commercial purposes the goods in which the design is incorporated” (emphasis added).

Failing too is the argument that the models and designs concerned were filed and registered with the National Institute of Industrial Property in France under the Paris Convention, administered by the World Intellectual Property Organization, to which Côte d’Ivoire is a party. Even if correct, that argument could defeat the action for infringement only if the subject of the filing in France had been specified and, more importantly, only if it were proven that the filing was made prior to the plaintiff’s application for registration with the OAPI, in which case the plaintiff’s model, assuming it was identical, would have lacked novelty.

André Lucas

¹⁸ ABR-2015, art. 7(1)(e) of annex I.

¹⁹ “The right of prior use shall not extend to granting a license to another person to exploit the design.”

D. Industrial designs – Novelty – Overall visual impression – Assessing infringement – Burden of proof on the plaintiff

For a model or design to meet the novelty requirement in article 2(1) of annex IV to ABR-2015, its overall visual impression must differ from that produced by all other previously disclosed models. In addition, an action for infringement must be dismissed where the plaintiff does not provide the specific information required to assess the individual and distinct elements of the model as compared with that of the defendant.

MR. BERTIN DABE ZOHORA V. SOCIÉTÉ ORANGE CÔTE D’IVOIRE AND SOCIÉTÉ NTDD, Judgment No. 1929/2015 of July 23, 2015, Commercial Court of Abidjan

Observations:

The judgment handed down by the Commercial Court of Abidjan on July 23, 2015, provides valuable insight into the novelty required for protection under annex IV to ABR-2015. Novelty – that is, the quality of being “new” – is the only substantive requirement set out in article 2(1). Its definition follows in the next paragraph (art. 2(2)): “An industrial design is new if it has not been disclosed anywhere in the world by publication in tangible form, by use or by any other means before the filing date or, where applicable, before the priority date of the application for registration.”

Facts: The case concerned a model of removable panel for displaying advertisements and newspaper headlines on street furniture, filed with the OAPI by the plaintiff in 2011. The following year, Orange Côte d’Ivoire turned down a commercial proposal from the plaintiff for use of the panels, which included all the technical details. The plaintiff, on later learning that Orange Côte d’Ivoire was distributing allegedly infringing panels through an advertising and communications agency to newsagents throughout the Abidjan district, brought an action for infringement. Orange Côte d’Ivoire argued that the “method” employed by the model had long been in common use in Abidjan and other major cities around the world, and that the designs for the panel attached to the plaintiff’s application for registration were “deplorably banal and unimaginative.” It deduced that the registration could not possibly confer any exclusive rights and, accordingly, that the applicant had no grounds to bring an action for infringement. The advertising and communications agency likewise argued that the novelty requirement laid down in article 2(1) of annex IV to ABR-2015 had not been met and, moreover, that the applicant had yet to manufacture the model that it claimed had been reproduced and imitated.

The court found in favor of the defendants.

Reasoning: The Commercial Court interpreted the novelty requirement under annex IV to mean that, to be eligible for protection, a model must produce an overall visual impression different from that of all

previously disclosed models. The court found the images and photographs submitted by the plaintiff so unclear as to preclude a comparison with those provided by the defendants, and the description of the plaintiff's model so brief as to preclude assessment of the panel's individual and distinct elements in comparison with those of the defendant's model for possible infringement. The court also found that the plaintiff failed to demonstrate the novelty of its model, and hence that it could not benefit from other legal provisions for the protection of literary and artistic property. The court concluded that the plaintiff did not provide evidence of any infringing activity on the part of the defendant companies.

The court's reasoning raises concerns about both form and substance. The substantive concern relates to the court's opaque reasoning that the "novelty" of the model must be proved if a plaintiff is to benefit from "other legal provisions for the protection of literary and artistic property." The "other provisions" can be only those contained in annex VII of ABR-2015, which deals with literary and artistic property, and the application of which is expressly provided for in article 1(3) of annex IV.²⁰ And yet those provisions, should they apply, would be subject to the requirement of originality rather than novelty. Originality is understood subjectively – that is, with reference to the personality of the author of the intellectual creation; novelty is understood objectively, as the absence of prior art. It should be clarified, however, that protection can be afforded under both legislative regimes – for industrial designs, as well as copyright – only if the requirements specific to each have been met.²¹

The concern about form relates to the court's unfortunate linking of novelty, a condition for protection, with infringement, the violation of an exclusive right. The court observed first that the evidence provided by the plaintiff did not substantiate the allegations of reproduction or imitation. Only then did the court consider novelty. That is the wrong way around: novelty must be established first; if found lacking, the infringement action goes nowhere, so the issues of reproduction or imitation no longer matter.

Ultimately, though, the court's solution was reasonable. Contrary to the plaintiff's assertion, production of a certificate of registration for a model that is "innovative" is not sufficient to enforce an exclusive right against third parties; the model must meet the novelty requirement. To prove novelty, a plaintiff must provide all the information needed to assess the possible existence of prior art. The plaintiff in this case did not do so. Information is said to have been provided on the model (although denied by the advertising and communications agency mentioned earlier), but it was not accurate enough, according to the court, for the purposes of such an assessment.

20 It should be noted here that the plaintiff made no reference whatsoever to the application of these provisions.

21 See Cass. com., No. 15-10885, March 29, 2017, in which it was noted that total cumulative protection under art. L.112-1 of the Intellectual Property Code and art. 96.2 of Regulation 6/2002 is not automatically afforded, but rather is permitted only where the respective conditions for protection are met.

The court was also correct to refer to the overall visual impression of the model, which needed to differ from impressions given by previously disclosed models, but it lumped that requirement together with novelty, traditionally understood in industrial property matters as the objective absence of prior art. There, it may have interpreted the Agreement too loosely. In the European Union, the situation is slightly different: Regulation 6/2002 requires the design to be new but also to have "individual character" (art. 4), such that "the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public" before a specific date (art. 6.1), and that the assessment of individual character should take into consideration "the degree of freedom of the designer in developing the design" (art. 6.2).

In any case, the Commercial Court's approach, while unorthodox, should not be viewed unfavorably. It is not illogical in the context of industrial designs to attribute a special character to the otherwise purely relative concept of novelty, as long argued in the literature.²² In the same vein, article 1(1) of annex IV, in defining a model as "any three-dimensional shape," requires it to give a "special appearance" (emphasis added) to the industrial or craft product concerned. That text can serve as proxy within OAPI member states for the concept of "overall visual impression," even if regrettably eliding the definition of a model with the conditions for protecting it.

André Lucas

E. Industrial designs – Infringement seizure – Order – Retraction – Competent judge – Extent of authority of the judge for urgent applications

The judge for urgent applications, given that the ABR-1999 is silent on the matter, has jurisdiction to rule on any request to retract an order authorizing infringement seizure of an industrial design or model. That authority, however, is limited to assessing the legitimacy and appropriateness of the contested measure.

PMUC V. ALFRED MENO, Interim order No. 301/C of February 19, 2007, President of the Court of First Instance of the Centre Region (Yaoundé)

Observations:

The question at the heart of the case was whether an order authorizing an infringement seizure in respect of an industrial model or design can be the subject of an appeal for retraction before the judge for urgent applications. The matter may appear trivial in most legal areas, retractions being a normal remedy against motion orders, but it is a valuable precedent in the context of intellectual property law, where the nature and legal

22 J. Raynard, E. Py and P. Trefigny (2016) *Droit de la propriété industrielle*. Paris: LexisNexis, No. 543. The authors note that, unlike patent law, the regime applicable to models and designs requires only relative novelty.

framework of infringement seizure set it apart from conventional enforcement measures.

Infringement seizure, a probative measure specific to intellectual property matters, permits a right holder to obtain an inquiry by a public officer, generally consisting of a court-ordered inventory, to substantiate an allegation of infringement, the extent thereof and related circumstances – or to obtain the physical seizure of objects relating to the infringement. All of this is paraphrased in the various annexes to ABR-1999 as “detailed descriptions, with or without seizure,” which is logical, since the procedure differs from common law seizures. One eminent author describes the wording as less connotative and more correct.²³

Facts: Mr. Alfred Meno, holder of the rights on the industrial model called “business kiosk” registered with OAPI on August 6, 2004, had a detailed inventory carried out, along with the seizure of the kiosks owned by the company *Pari Mutuel Urbain Camerounais* (PMUC) and operated by the latter on sidewalks and public squares. This action was carried out in execution of Order No. 1608 made on September 7, 2006, by the presiding judge of the Court of First Instance of Yaoundé-Centre Administratif. After this measure was executed, PMUC summoned Alfred Meno before the judge for urgent applications of this court, to apply for retraction of the order and the lifting of the infringement seizure on grounds of lack of novelty of the model in dispute and failure to produce the certificate of non-cancellation and non-forfeiture. Alfred Meno raised the objection regarding lack of jurisdiction of the judge for urgent applications, stating that, in his opinion, the infringement-seizure order did not fall within the category of retractable orders.

Reasoning: Infringement seizures have an essentially probative purpose. Under ABR-1999, they are ordered by the president of the civil court within whose jurisdiction the action is to be taken. In ABR-2015, the wording “president of the civil court” has been replaced with “presiding judge of the competent national court,” which eliminates uncertainty over differences in the judicial organization of OAPI member states.²⁴ There is no provision in the Agreement for appeal against such orders. Where substantive legislation on the matter is silent, appellants must invoke the ordinary domestic law provisions for motion orders in OAPI countries where so allowed.

The judge in this case ruled explicitly on his own competence as judge for urgent applications to hear appeals for the retraction of motion orders authorizing infringement seizures (section I), but he gave only cursory treatment to a crucial underlying issue: the extent of a judge’s authority in that capacity to assess the legitimacy and appropriateness of such measures (section II).

I. Legal basis for the competence of the judge for urgent applications in relation to the retraction of infringement seizure orders

The legal basis for the competence of a judge for urgent applications to rule on retraction of an infringement seizure order was an issue much discussed in this case. Mr. Meno argued that infringement seizure orders of industrial designs or models could not be retracted. His argument finds support in the absence of any contrary provision in ABR-1999 (A), but it did not convince the judge, who invoked the ordinary domestic provision on motion orders (B).

A. The silence of ABR-1999

ABR-1999 does not expressly provide for appeal against civil court orders for infringement seizure of industrial property. The omission is regrettable. It allows for different judicial opinions on the matter in different OAPI countries, as evidenced by Mr. Meno’s argument. The latter’s advisors maintained that article 29(1) of annex IV to ABR-1999 restricted jurisdiction for actions relating to industrial designs to civil courts only, precluding such authority for an interim judge. The court president in this case disposed skillfully of this specious argument by invoking the ordinary provisions of domestic law on motion orders, which applied here in any event.

B. Application of ordinary law on motion orders

Given the lack of any provision in annex IV to ABR-1999, covering industrial designs, the judge rightly invoked the ordinary domestic legal provision for motion orders. He reasoned that, in traditional law, the judge for urgent applications undisputedly has jurisdiction to rule on any request for the retraction of orders issued in *ex parte* proceedings, including those for infringement seizure. Infringement seizure orders issued in such non-adversarial proceedings are necessarily subject to the general regime for such proceedings in each member state. In his capacity as judge for urgent applications, the court president was thus right to affirm jurisdiction for the matter. According to the Court of Appeal of Brazzaville, in a comparable case, in which the victim of an infringement seizure contested as a principle of positive law the competence of a judge for urgent applications, an order issued by an interim judge can be opposed before the same judge, in interim proceedings, by any interested party.

This omission appears to have been fixed by ABR-2015. In that revised version, under article 33(1) of annex IV, seizures for counterfeiting (the revised term for “infringement seizures”) are executed by order of the “presiding judge of the competent domestic court,” making such seizure orders subject to ordinary domestic law in OAPI countries.

II. Scope of authority of the judge for urgent applications in relation to the retraction of infringement seizure orders

The judge for urgent applications can assess the conditions for granting an infringement seizure order

23 P. Veron (2013/14) *Saisie-contrefaçon*, 3rd edn. Paris: Dalloz, 3.

24 See ABR-2015, art. 65(2) of annex I, art. 58(1) of annex II, art. 51(1) of annex III and art. 33(1) of annex IV.

(A) but not the validity of rights claimed to the title concerned by the purported right holder (B).

A. Assessing the conditions for granting an order for infringement seizure

The responsibility of the judge for urgent applications in considering the retraction of an infringement seizure order is purely procedural: a check on whether the documents required by law have been provided in support of the seizure application. For an industrial design, the documents comprise proof that its registration has been published by the OAPI and has neither lapsed nor been canceled, and that any necessary security deposit, if required for the procedure, has been paid.²⁵ In this case, Mr. Meno submitted into evidence order No. 4/52/OAP I.PG/DPG/HJT, signed by the OAPI Director General on August 6, 2004, for the registration of an industrial design and model of “business kiosk,” applied for on June 16, 2003, along with a copy of the models filed and proof that the registration had not lapsed.

It is useful to speculate in this context about the grounds for the judge’s ruling to retract the order (No. 1608 of December 7, 2006) and subsequently release the items seized, on December 15, 2006. Two unstated reasons – the inappropriateness of the mass seizure performed and the absence of any risk that the objects seized would deteriorate – seem to underlie the grounds as written, which include the following preambular paragraphs of the judge’s ruling:

“Considering that literal application of the contested order allowed Mr. Meno the freedom to execute it without limitation as to spatial extent or number of kiosks seized, which was liable to disrupt the business conducted by PMUC since 1994, as evidenced by the documents entered into evidence ... Considering also that no risk of deterioration or concealment of the kiosks has been invoked by the seizure applicant ...”

The extent of infringement seizures is a recurring issue in cases before the courts of OAPI countries. Where the law is silent, judges tend to confine such seizures to a few examples of the offending objects. Advocating the same prudent approach in their commentary, some authors affirm the power of the presiding judge to deny any measure that they deem unnecessary for evidentiary purposes if potentially causing unwarranted harm to the distrainee, such as physical seizures of *excessive* extent.²⁶ The judge’s decision in the present case was in line with that approach. ABR-1999 does not specify how extensive an infringement seizure should be, leaving that to the court president, acting as motions judge or judge for urgent applications. That power must be exercised delicately in the case of infringement seizures, avoiding intrusion into areas within the trial court’s domain.

25 See ABR-1999, art. 31(1), (2) and (3) of annex IV. The conditions for granting the measure are simplified in ABR-2015, arts. 33(2), by removal of the need to produce proof that the registration has neither lapsed nor been canceled.

26 See *Ameropa SA v. Mustapha Tall SA*, Judgment No. 501 of December 28, 2012, Court of Appeal of Dakar (obs. M. Lamotte, this collection, Chapter 3, section K); Veron, n. 23, at 90, No. 123.12.

B. Assessing the validity of a right holding

As a general rule, the intervention of a judge for urgent applications in intellectual property disputes in no way alters existing jurisdictional rules in OAPI countries, as enshrined in their codes of civil procedure. The provision applicable in this case was article 185 of the Code of Civil and Commercial Procedure of Cameroon, which prohibits a judge for urgent applications from prejudicing adjudication on the merits of a case. Accordingly, a judge for urgent applications asked to retract an infringement seizure order may not examine the validity of the title allegedly infringed or the material facts of the alleged infringement, both of which are matters for the trial court. Two regrettable decisions had been rendered previously on this point – one, by the presiding judge of the Court of First Instance of Abidjan-Plateau, the other, by his counterpart at Ndokoti in Douala – both intruding into matters for the trial court to decide.²⁷

The judge for urgent applications in the present case quite wisely worded his reasoning thus: “The matter to be decided here is not the validity of ownership rights to a model of kiosk, but the legitimacy as well as appropriateness of an infringement seizure ordered in non-adversarial proceedings.” He thereby circumscribed the prerogative of the judge for urgent applications in dealing with infringement seizures – a procedure increasingly in demand since the adoption of ABR-2015. Article 32 of annex IV to this latest revision, with respect to industrial designs, now allows any person empowered to bring action for counterfeiting to make an urgent application to the competent domestic court seeking, if necessary under financial compulsion, an order against the alleged counterfeiter or the intermediaries whose services they use, instituting any measure intended to prevent an imminent infringement of the rights vested in the certificate of registration or to prevent the continuation of the alleged counterfeiting. That represents a major innovation certain to revolutionize the judicial enforcement of industrial property rights and gladden the hearts of their holders in title.

Max Lambert Ndéma Elongué

27 See *Société Sivorpra v. Issa Mohamad Ali*, Interim order No. 2240 of May 5, 2002, of the president of the Court of First Instance of Abidjan-Plateau, in *Recueil des décisions de justice* (OAPI Collection), 439, in which the judge for urgent applications prohibited the fraudulent use of the infringing mark and ordered withdrawal of the infringing goods throughout the national territory; Interim order No. 189 of August 22, 2007, of the president of the Court of First Instance of Ndokoti (Douala), in *ibid.*, at 191, in which the judge for urgent applications rejected a request for retraction of an infringement seizure order on the grounds that the infringement was proven, thus settling the dispute on the merits; *Société STCH v. Société Sotiba Simpafric SA*, Interim order No. 4167 of April 14, 2008, Special Regional Court of Dakar, in which the presiding judge ordered retraction of an infringement seizure order carried out by the holder of a right over a model on the grounds that the victim of the seizure had a prior right over the disputed model, thus ignoring the objection on grounds of lack of material jurisdiction raised by the distrainee, who had already brought the dispute before the trial judge.

A.
Use of a trade name registered with OAPI
by a competitor in the national territory of a
member state – Use liable to create confusion
between the enterprises in question – Use
declared illegal and prohibited 101

Chapter 5

Trade names

A. Use of a trade name registered with OAPI by a competitor in the national territory of a member state – Use liable to create confusion between the enterprises in question – Use declared illegal and prohibited

A request to prohibit the use of a trade name registered with OAPI by the owner of the registration can succeed only where that use is (a) on the national territory of an OAPI member state, (b) by a competitor and (c) liable to create confusion between the enterprises in question.

SOCIÉTÉ BATIPRO V. SOCIÉTÉ EMBCI-PROBETON,
Judgment No. 4653/2015 of April 14, 2016, Commercial Court of Abidjan

Observations:

Under article 1 of annex V to the Bangui Agreement of February 24, 1999 (ABR-1999), a trade name is defined as “the name under which a trade, industrial, craft or agricultural establishment is known and exploited.”¹ Trade names are among the distinctive signs used by companies to attract customers. Within the OAPI, a party can obtain an exclusive right over a trade name in one of two ways – namely, by working it or by registering it.² Registering a trade name, however, does not necessarily protect it from unlawful use, as is clear from the judgment rendered here by the Commercial Court of Abidjan on April 14, 2016.

Facts: The company BATIPRO was owner of the trade name “PROBETON” by virtue of trademark and trade name registration certificates issued by the OAPI on May 29 and August 31, 2015. The company EMBCI-PROBETON was reported to be using the same name and thereby infringing BATIPRO’s exclusive right, as a bailiff’s report of March 11, 2015 documented. BATIPRO took action accordingly before the Commercial Court of Abidjan to prohibit such use; EMBCI-PROBETON filed a counterclaim, seeking to invalidate the trade name registered by BATIPRO.

Reasoning: The Commercial Court, in ruling on this claim and counterclaim, had to consider two legal issues:

- I. the conditions under which the use of a registered trade name can be prohibited; and
- II. whether a registered trade name can be invalidated.

1 The definition in ABR-2015, art. 1 of annex V, also includes “or other business.”

2 ABR-1999, art. 3(1) of annex V.

The court’s decision was to uphold BATIPRO’s claim, to prohibit EMBCI-PROBETON’s use of the name and to reject the latter’s request that the former’s trade name be held invalid.

I. Conditions for the success of an action to prohibit the use of a registered trade name

Under article 16 of annex V to ABR-1999, if the rights attaching to a trade name are infringed, the registered owner of such rights may take legal action to prohibit the continuation of such infringement and to claim payment of damages, as well as any other sanction provided for in the Civil Code. However, an action for prohibition also comes under article 5(1) of annex V, which specifies three conditions that must be met if the use of a trade name is to be held illegal:

- the use must occur in the national territory of an OAPI member state;
- the use must be for the same trade, industrial, craft or agricultural activity as that of the owner of the registered trade name; and
- the use must be liable to create confusion between the enterprises in question.

It should have been verified, first of all, whether those conditions were met in this case.

The court did not explicitly address the first condition, requiring that the use occur in an OAPI country. It may have assumed, but not confirmed, that the condition was met since both enterprises were headquartered in Port-Bouët, Abidjan, and the defendant clearly used the trade name in Côte d’Ivoire.

The court did address, if indirectly, the second condition, requiring that use of the name be for the same trade, industry, craft or agricultural activity as that of the registered trade name’s owner. Reference to the “same” activity means that the plaintiff and defendant must be competitors, offering goods or services to the same clientele. According to the court, the bailiff’s report did indicate similarity in the companies’ fields of activity and hence it could be said that the second condition is satisfied.

The court devoted more attention to the third condition, requiring there to be potential for confusion between the enterprises. It affirmed first that anyone encountering an EMBCI-PROBETON billboard or sign would be bound to confuse it with the plaintiff’s trade name and mark. It found the brand palette – the same shade of red – and



the activities being pursued by the two companies to be so similar that consumers dealing with one company could believe it to be the other. The natural consequence of such confusion is a cost to the registered owner of a trade name – in this case, the company BATIPRO – which will have built its reputation on that name.

Seeing the three conditions met, the court rightly ruled for BATIPRO, prohibiting the defendant's use of the "PROBETON" name under threat of financial penalty.

While not an issue in this case, article 5 of annex V to ABR-1999 does, however, indicate two scenarios in which the owner of a registered trade name may not prohibit third-party use.³ Article 5(2) sets out the first:

"The registered owner of a trade name may not preclude third parties from the use in good faith of their names, their addresses, a pseudonym, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production of their goods or of the supply of their services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services."

The second scenario, in article 5(3), runs as follows:

"An interested party whose name and first name are similar to those of a registered trade name, where his rights to the trade name of his establishment are subsequent to those of the registered trade name, shall take all necessary measures, by an addition to his trade name or in any other manner, to distinguish his trade name from that of the registered trade name."

Both scenarios place limits on the exclusive rights of the owner of a registered trade name. There is also a third such limit: the effects of the trade name's registration can be invalidated.

II. Invalidity of a registered trade name

The counterclaim filed by EMBCI-PROBETON, entirely without grounds, sought invalidation of the trade name "PROBETON," as registered to BATIPRO. The court dismissed the claim on the simple basis of BATIPRO's ownership and, in doing so, it risked suggesting that registered trade names cannot be invalidated.

Under article 14(1) and (2) of annex V to ABR-1999, such invalidation is pronounced by the civil courts at the request of the OAPI, the Office of the Public Prosecutor, or any interested natural or legal person.

The grounds for invalidity, as specified in article 14(2), are as follows.

- a. The first is non-conformity with the definition of "trade name" provided in article 1 of annex V ("the name under which a trade, industrial, craft or agricultural establishment is known and exploited").
- b. Based on article 2 of annex V, the second applies where "a name or designation is not admissible as a trade name if, by reason of its nature or the use to which it may be put, it is contrary to morality or public policy and if, in particular, it is liable to mislead trade circles or the public as to the nature of the trade, industrial, craft or agricultural establishment of that name."
- c. Based on article 5(1) of annex V, the third would apply in cases where the name has been previously registered for the same trade, industrial, craft or agricultural activity.
- d. The final ground is conflict between the registration and a prior right. This ground is broader than the third, applying not only to the registered name but also to all prior intellectual property rights.

This final ground was applied in a similar case, in a judgment dated May 14, 2008, by the Court of First Instance of Libreville.⁴ The plaintiff in that case, Compagnie Générale des Etablissements Michelin-Michelin, had registered trademarks with the OAPI containing the name "Michelin," numbered and dated thus:

- Michelin No. 36897, registered on October 7, 1996
- Michelin No. 44309, registered on June 22, 2001
- Michelin No. 44310, registered on June 22, 2001

On April 23, 2002 – that is, after the plaintiff had registered the marks – Rabiou Abdou Wassi, the defendant, filed and registered with the OAPI the sign and trade name "Michelin Dieu Merci." Informed of this, the plaintiff took action to invalidate the defendant's registration, on the ground that it conflicted with its own prior right. The court recognized the plaintiff's right to the trade name "Michelin Dieu Merci," registered on April 23, 2002, as No. 34058, as prior to the defendant's registration of the same name, which the court invalidated.

Returning to the present case, EMBCI-PROBETON's counterclaim, aiming to invalidate BATIPRO's registration, invoked none of these four grounds and was doomed from the start. The court was right to dismiss it, but its reasoning calls for comment. It was based solely on BATIPRO's ownership of the registered trade name, which, as demonstrated, could be invalidated on any of the four grounds spelled out in article 14 of annex V to ABR-1999. The court's reasoning should have confirmed that none of these grounds applied.

Grégoire Jiogue

³ These two situations are reproduced *in extenso* in ABR-2015, art. 5 of annex V, which had not yet entered into force at the time of the present case.

⁴ *La Compagnie Générale des Etablissements Michelin-Michelin et Compagnie v. Michelin Dieu Merci*, unpublished.

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Chapter 6

Copyright

A. Works of the mind – Concept – Need for a concrete form perceptible to the senses – Slavish reproduction of a contest under the same name as that used by the contest’s creator – Parasitic competition (“passing off”) found

A work of the mind can be copyrighted only if expressed in a concrete, original form perceptible to the senses. Such is not the case for the rules of a contest, which cannot in themselves constitute a work of the mind.

A contest that is not copyrighted can, however, be protected under the rules against unfair competition. When a person “piggybacks” on an author’s creation to earn profit from it at no expense to themselves, they may be found to be liable for conduct comprising a type of parasitic competition known as passing off.

AMISSAH MARIELLE LINDA V. 1. SOUMAHORO MAURY FERÉ; 2. MGROUP; 3. MTN CÔTE D’IVOIRE; 4. BUREAU IVOIRIEN DU DROIT D’AUTEUR, Judgment No. 3556/17 of December 19, 2017, Commercial Court of Abidjan

In this case, the Commercial Court of Abidjan was asked to decide on two legal questions: the conditions under which a contest can be protected by copyright; and whether the defendants’ replication of a contest under the same name and without the consent of the plaintiff (the contest’s creator) constitutes “passing off.”

I. Protecting a work of the mind through copyright

Under all national copyright laws, as well as article 3(1) of annex VII of the Bangui Agreement, only an original work may be protected by copyright. The inception of a copyright can – arguably, must – be subject to a twofold condition: that the work’s character be substantiated both as a work of the mind and as an original one. The judgment reported here illustrates the first part of the condition.

The judgment reported here illustrates the first condition. The Commercial Court of Abidjan denies that copyright protection exists for the concept of a contest, the *Coupé-Décalé Awards*, promoting a musical genre very popular in Côte d’Ivoire in the 2000s. The plaintiff, a noted singer in the “stylmoulance” musical movement, claimed that the contest, which she created in 2010, was an original creation, and that the defendants had “re-presented” it in an infringing manner.

The defendants argued that the plaintiff had not provided “objective evidence that her name had usually appeared in conjunction with the *Coupé-Décalé Awards* or that she had developed a stage format bearing her imprint.” They added that “copyright protection does not cover ideas, methods, procedures, concepts or information as such, and that having provided no proof of the work being registered with BURIDA [Bureau Ivoirien du Droit d’Auteur/Copyright Bureau of Côte d’Ivoire],” the plaintiff could invoke no right to the work against third parties.

These three objections do not carry equal weight. The failure to make reference to the author of a work when using that work obviously does not suffice to rule out infringement. Nor is registration of a work with a collective rights management organization a prerequisite for copyright; rather, as the court quite rightly noted in its judgment, it follows from article 4 of annex VII to the Bangui Agreement and article 5 of Côte d’Ivoire’s Copyright Act that “copyrights arise without the need for formalities, by the mere fact of a work’s creation.”

That left open the issue of whether the work concerned constituted a work of the mind, as defined in the copyright legislation. The court’s ruling on why it did not is instructive.

The court began by citing the principle that a “work of the mind” can be copyrighted only if “expressed in an original form or representation.” The wording “form or representation” is unfortunate, in that the word “representation” refers merely to one possible means of communicating the work. It would have been preferable to refer only to “form.” But the argument is still compelling: “The requirement as to the form in which the work must be cast relates to the ability to communicate it and make it perceptible to an audience. Accordingly, irrespective of their original form or presentation, the rules of a contest cannot in themselves constitute a work of the mind protected by copyright.”

It could not be clearer that the only purpose of copyright is to protect a creation perceptible through the senses. This flows from a fundamental principle of intellectual property law: that ideas in themselves are freely available.¹ This means that, once obtained, copyright protection does not extend to the ideas contained in a work. The principle is recalled in article 2, entitled “Scope

¹ For an illustration that dates back some time, see T. civ. Seine, December 19, 1928, *Ann. propr. ind.* 1929, 181: “In the realm of thought, ideas remain eternally free and can never be exclusively protected.”

of copyright protection,” of the WIPO Copyright Treaty of 1996: “Copyright protection extends to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.” It also means that a work is eligible for copyright protection only if it takes some concrete form.

From that point of view, the court was right not to rely on the plaintiff’s affirmations that her contest was the fruit of an intellectual effort consisting of various arbitrary choices to showcase the contest’s originality – in particular, the ranking of artists by category, the process for choosing winners and the unfolding of the event, with a procession, a video presentation, a tribute to Douk Saga (celebrated pioneer of the musical genre) and a concluding concert performed by *coupé-décalé* artists. Indeed, neither the exertion of “intellectual effort” (the plaintiff also highlighted her “effort of reflection”) nor the making of “arbitrary choices” suffice to make a work eligible for protection. According to the court in this case, to obtain copyright protection, the plaintiff should have demonstrated “the original form or presentation of the above ideas. The form could consist of a text setting out the contest.” The example of a “text setting out the contest” may not be the most relevant, since a court would have to examine such words to assess whether they met the originality condition. It would have been more effective to hypothesize, as the defendants themselves did, a staging “format” for the contest. But the argument remains ineluctable: the plaintiff failed to “demonstrate that her intellectual activity produced anything of concrete form.”

The judgment appears well grounded in law and is comparable to a ruling of the French Court of Cassation in a case concerning awards for the year’s best beauty products.² The French court found that “the rules of a contest, even if resulting from arbitrary choices, cannot in themselves, regardless of their form or general presentation, constitute a protected work of the mind.”

That ruling has broad implications, considering that, in the case law of many European Union countries, copyright protection is often claimed for televised game “concepts” negotiated at astronomical prices.³ It is generally accepted that such protection can be granted only if the concept concerned takes the form of what is known in media jargon as a “format” for a segmented, structured program.

The distinction is clarified in a judgment of the Paris Court of Appeal.⁴ That case concerned a television project about celebrities’ collections. The project’s creator, who had registered it with the Société des Gens de Lettres (a body for the defense of authors, established

in the 19th century), later recognized his idea in a program broadcast by the TF1 television network. The Paris Court of Appeal recognized the project as a work of the mind. While the synopsis for that project was brief, it included precise elements, as follows.

- It combined televised visits to the homes and collections of stars, with a technical report on each celebrity’s collection, commentary by a psychologist on each celebrity and collection, a game segment awarding prizes for answers to questions of general culture about an object, painting or artist, and recent news about the celebrity.
- The synopsis then proposed how the program would actually be segmented.
- Further, it characterized the program’s “tone” (“young, rebellious, fast-paced”).

That plaintiff’s appeal was nonetheless denied, on the grounds that none of the TF1 programs “replicated the above combination.” For viewers who might have missed them, the programs showed Michèle Torr’s collection of earthenware cicadas, Uri Geller’s collection of twisted spoons, Daniel Hechter’s modern art collection, Jean-Claude Dreyfus’s pig collection, and the car collections of Alain-Dominique Perrin and the King of Morocco – but never under the conditions enumerated in the plaintiff’s synopsis.

In both French judgments, the same principles are applied. While copyright protection is denied in the first and admitted in the second, both are based on the same distinction: between a simple canvas without real content (an entertainment program on the why of things or the happenings of daily life) and a segmented structured “format,” as described above.

The distinction between a work that can be protected and an idea that cannot often arises in advertising. The French Court of Cassation has established in principle “that a simple advertising idea, however original, is not in itself subject to ownership.”⁵ According to abundant case law, however, an advertising idea can be owned if it takes the form of a slogan or design.

II. Protecting a work of the mind against passing off

Passing off is today generally considered an act of unfair competition,⁶ the latter concept having evolved significantly. The concept of unfair competition was traditionally confined to cases in which the plaintiff and defendant actually competed – that is, where they shared the same clientele or customer base.⁷ It has since been found increasingly that competition can be unfair in the absence of such a shared clientele,⁸ including in the case of passing off. Passing off was eventually found to be unfair even in the absence of any

2 Cass. 1^{ère} civ., November 29, 2005, No. 4-12.721, *RIDA* 2006, 2, 273, *Comm. com. électr.* 2006, comm. 18, 1^{ère} esp. (note C. Caron), *D.* 2006, 517 (note A. Tricoire), *RTD com.* 2006, 78 (obs. F. Pollaud-Dulian).

3 For an overview of the problem, see E. Derieux (1994) *La protection des projets et genres d’émissions. Légipresse*, II, 97-106; G.W.G. Karnell (2000) *Copyright to sequels – with special regard to television show formats. IIC*, 31, 886-913.

4 Fourth Chamber, December 6, 2002, *Propr. intell.* 2003, 158, 2^{ème} esp. (obs. A. Lucas).

5 Cass. com., June 16, 1964, *JCP G* 1965, II, 14059, *Ann. propr. ind.* 1965, 279.

6 V.G. Ripert, R. Roblot and L. Vogel (2001) *Traité de droit commercial, vol. 1*, 18th edn. Paris: LGDJ, Nos. 752-753, 613 *et seq.*

7 A. Pirovano (1974) *La concurrence déloyale en droit française. RID comp.*, 467.

8 See Ripert, Roblot and Vogel, n. 6, Nos. 730, 595 and 596, and the case law cited in that regard.

competitive situation.⁹

The Commercial Court of Abidjan defined passing off as a set of behaviors through which an economic actor, at no cost to itself, exploits and profits from the efforts and knowledge of another. That definition is in line with the legal doctrine that gave rise to the passing-off concept.¹⁰ According to Saint-Gal, actors who operate as “parasites, profiting from the efforts, reputation and fame of another” behave illegally. The definition by the Commercial Court of Abidjan just cited was first applied in the same terms by the Commercial Chamber of the French Court of Cassation.¹¹

The definition having now been validated, the question remains whether the Commercial Court of Abidjan was correct in applying it to a work of the mind in the case of a game show, the *Coupé-Décalé Awards*, created by the plaintiff, Ms. Amissah Marielle Linda, also known as Lindsay, and debuting in July 2010. When the first program was aired, several artists and producers received prizes, including Mr. Soumahoro Maury Féré, also known as Molare. However, owing to the 2011 post-electoral crisis in Côte d’Ivoire, the plaintiff could not directly follow up that first program with a second. When, in 2016, she was preparing to do so, she was surprised to learn that Mr. Soumahoro and the firm MGroup were organizing the first program of what they called the *Coupé-Décalé Awards*, sponsored by the company MTN. Despite repeated efforts by the plaintiff to dissuade them, the defendants went ahead with the event. She then brought action before the Commercial Court of Abidjan seeking legal redress for the prejudice caused by their passing off.

The theory of passing off was first advanced in respect of trademark infringement¹² and subsequently applied in case law to economic activity, and hence the references to “economic passing off” and “economic actor” in most judicial decisions on the matter.¹³ The Commercial Court of Abidjan referred to “economic actor” in its own definition of passing off.

With that in mind, the concept of passing off as an act of unfair competition arises primarily in respect of economic activity. It is, however, exceedingly difficult to characterize as an economic activity a game show organized by a natural person on an apparently pro bono and occasional basis. Nor does such a game show fit within the concept of unfair competition defined in the Bangui Agreement, as revised on February 24, 1999 (ABR-1999), which addresses only industrial and commercial activities. The game show at issue is neither an industrial nor a commercial activity. Nor is it an activity of the liberal professions, which the Bangui

Agreement as revised on December 14, 2015 (ABR-2015) puts on a similar footing with industrial and commercial activities. Even the case law in this area, in which the concept of unfair competition is quite broadly based on article 1382 of the Civil Code, excludes “traditional” services (those performed by political, labor, cultural, professional and philanthropic bodies), given their pro bono character. What is true for such “traditional” services also applies to the game show at issue, since nothing in the decision permits a determination that it was profit-driven.

That said, it must also be observed that the conditions associated with passing off (which can occur in the absence of a shared clientele) differ from those that have traditionally characterized unfair competition (which can exist only where clientele is shared). Viewed from that perspective, the position taken by the Commercial Court of Abidjan is understandable. What cannot be treated as unfair competition in the classic sense can be considered passing off. While it arose in the context of economic activity, passing off can also be applied to other fields, such as artistic endeavors. The court therefore rightly referred not to economic but artistic passing off. Given the general character of the passing-off theory, nothing prevents it from being applied, when its defining features have been identified, to the arts.

In this case, the judge found artistic passing off to have occurred based on two facts:

- the slavish manner in which the defendants replicated the *Coupé-Décalé Awards*, using the same name, after having participated in 2010 in the first program; and
- the similarity of their program to that created by the plaintiff, which inevitably evoked the latter in the minds of the viewing public.

In view of those facts, the Commercial Court of Abidjan rightly concluded that the defendants, at no cost to themselves, had exploited and profited from the plaintiff’s creation. Thus, although a work of the mind may be denied copyright protection, it can still be protected by applying the passing-off concept.

The significance of the concept in that regard should not, however, be overstated. Indeed, if any replication of an unprotected creation is to be treated as passing off, the coherence of intellectual property will be affected. It is in that light that the ruling of October 18, 2000, by the Paris Court of Appeal should be viewed: copying the works of others as a way to economize does not constitute an offense, since works not covered by intellectual property rights can in principle be freely reproduced.¹⁴

Having so characterized artistic passing off, the Commercial Court of Abidjan could grant the plaintiff’s claim for compensation only by first finding injury to have occurred – which it did, considering the plaintiff to have sustained real injury in the loss of her intellectual investment. It would indeed be difficult for her “to again

9 Cass. com., January 30, 1996, *Bull. civ.* 1996, IV, No. 32.

10 Y. Saint-Gal (1956) *Concurrence parasitaire ou agissements parasitaires. RIPIA*, 37.

11 Cass. com., January 26, 1999, No. 96-22.457, *BRDA* 1999, No. 6, 10, D. 2000, 87 (note Y. Serra).

12 Saint-Gal, n. 10.

13 Cass. com., January 26, 1999, n. 11; CA Toulouse, October 19, 1988, D. 1989, 290 (note Barbéri); Cass. com., May 9, 1991, *PIBD* 1991, III, 699; CA Versailles, January 16, 1997, *D. Aff.* 1997, 565.

14 D. 2000, 850 (note J. Passa).

organize the program at issue, associated as it now is with Mr. Soumahoro, whose renown in the world of *coupé-décalé* is solidly established.”

Questions nonetheless arise about the legal basis of compensation for the plaintiff’s injury. The Commercial Court of Abidjan cited article 1382 of the Civil Code but not annex VIII to ABR-1999. Given that the theory of unfair competition was enshrined in subsequent revisions of the Bangui Agreement, article 1382 should no longer, strictly speaking, apply in unfair competition cases.¹⁵

The main lesson to be drawn from the judgment is the need to distinguish passing off from other forms of unfair competition, particularly in the case of artistic (as in this case) as opposed to economic passing off. Under annex VIII of the Bangui Agreement, the application of unfair competition provisions is limited to industrial and commercial activities. The game show at issue was neither an industrial nor a commercial activity but a pure work of the mind. Thus, from the OAPI standpoint, there are two coexisting legal frameworks for unfair competition: article 1382 of the Civil Code, and annex VIII of the Bangui Agreement. The latter should be considered the principal framework and the former, its subsidiary.

André Lucas

B. Originality – Condition for the protection of works – Content of the concept – Blend of objective and subjective criteria – Reproduction of original expressions and elements characteristic of the work – Infringement

As a general rule, a work eligible for copyright protection is the “original” one, which, under article 1 of the Côte d’Ivoire Law of July 26, 2016, on copyright and related rights, is that which constitutes the author’s own work of the mind.

An infringing reproduction of a literary work consists of the full or partial replication of original expressions and elements characteristic of the pre-existing work. In the absence of prior authorization from the author, such reproduction is illegal and subject to heavy penalties under civil law.

KIPRE BROYO CARLO V. NOUVELLE PARFUMERIE GANDOUR, Judgment of December 28, 2017, Commercial Court of Abidjan

Observations:

Can a fragment of a literary work be subject to copyright protection? This is a core question for copyright

15 See *Adamou Idrissa v. Mahaman Mindaou*, Judgment No. 13 – 086/c of April 4, 2013, State Court of Niger, Judicial Chamber (obs. G. Jiogue, this collection, Chapter 7, section A).

protection in a time of political and legislative caution when dealing with allegations of plagiarism. Without distinguishing between different categories of art, copyright protects all aspects of creativity from the moment the originating factual idea for a creation becomes concrete – or, better still, is “externalized as forms and/or colors.”¹⁶ “Plagiarism” is a non-legal concept with purely moral connotations; the legal term is “infringing reproduction.”¹⁷ Infringing reproduction is the illegal reproduction, representation or dissemination, by whatever means, of elements of the original expression of a work of the mind. For a plagiarist to incur civil liability, case law requires that the elements resemble those taken from the original, regardless of their quantitative extent. That is the essence of this judgment of the Commercial Court of Abidjan.

Facts: During the course of 2010, Mr. Kipre Broyo conceived of and produced the first volume of a handbook entitled *Technique pour devenir un professionnel de la haute coiffure* [Techniques for Becoming a Professional Hairdresser], which was followed in January 2015 by a second volume, entitled *Guide du coiffeur, Devenir professionnel* [Hairdresser’s Guide: Become a Professional]. The work was registered twice with the Copyright Bureau of Côte d’Ivoire (Bureau Ivoirien du droit d’auteur, or BURIDA), on June 17, 2016, and June 16, 2017. Having signed a contract in March 2015 to train student hairdressers for the Nouvelle Parfumerie Gandour, Mr. Broyo used his work as a training textbook for the students until the contractual relationship was terminated. Mr. Broyo was later surprised, in January 2017, to learn that Nouvelle Parfumerie Gandour had published its own hairdressing handbook, plagiarizing several pages of his second volume. Considering the reproduction an infringement of his copyright, Mr. Broyo brought civil liability proceedings, grounded in article 1382 of the Civil Code, before the Commercial Court of Abidjan. The court was called upon to identify in general terms what elements of the work were protected by copyright.

Reasoning: It is a truism that copyrights generally protect not ideas, which can be exchanged freely, but their expression. The intent of this fundamental copyright principle is to guarantee freedom of expression and creation. According to this principle, ideas cannot be owned unless they have been expressed in some clear form. Deceptive in its simplicity, application of this principle can be tricky. Judges have to identify, from the standpoint of creativity, what creative works, or elements thereof, are eligible for protection. At this stage, originality is unquestionably the essential criterion for that determination (section I). Judges must then have the expertise to examine whether the reproduction at issue constitutes an infringement (section II).

16 P. Sirinelli (1992) *Propriété littéraire et artistique et droits voisins*. Paris: Dalloz, 25.

17 See A.-C. Renouard (1838/39) *Traité des droits d’auteurs dans la littérature, les sciences et les beaux-arts*, vol. 2. Paris: J. Renouard, 22; see also C. Colombet (1999) *Propriété littéraire et artistique et droits voisins*, 9th edn. Paris: Dalloz, No. 389; R. Plaisant (1970) *Le droit des auteurs et des artistes exécutants*. Delmas, No. 403.

I. Originality – the key criterion for determining a work’s eligibility for protection

Originality, a bedrock concept in copyright law that has withstood the test of time and legislative reform, can be defined in several ways, depending on one’s theoretical starting point. As part of a traditional, eminently subjective concept of originality, there has been a reluctance in case law to break with numerous precedents where objective criteria have been applied. Faced with those two approaches to the concept, subjective and objective, the judge in the present case took certain liberties in applying both.

A. Alternative criteria for defining an original work

Viewed holistically, the concept of an original work is multidimensional in copyright law, those dimensions having evolved according to various schools of thought. From among myriad defining criteria, two main approaches have emerged: one subjective; the other objective.¹⁸

B. The judge’s regrettable combination of criteria

The Commercial Court’s combination of both subjective and objective criteria in this case may be regrettable. Seeking to define the concept of original work first subjectively, the judge emphasized that “it is a principle of intellectual property law that a work is deemed original if it is new and bears the imprint of the author’s personality.”

Expressed in negative terms, that conception amounts to saying that a new work is not original if it does not bear an author’s personal imprint and vice versa.

Most case law broadly deconstructs the concept of originality subjectively in this way, in line with the personality-based approach largely taken in the literature.¹⁹ In a case before the Supreme Court of Côte d’Ivoire, the judge largely echoed the narrowly subjective approach to defining originality.²⁰ In that case, the appellant had created a clownish character who appeared on children’s programs under the pseudonym “Bouba.” The appellant had brought legal action for infringement of his copyright – to both the character and pseudonym – against the respondent’s use of those two creations. The Supreme Court rejected the appeal on the grounds that neither of these creations bore the appellant’s personal imprint. Judges in France have repeatedly avoided any mention of the objective criterion, requiring originality alone, regardless of prior art at the time of application for literary and artistic property rights.²¹ In other words, they perceive originality exclusively in terms of the author’s own imprint on the creation.

A small number of case rulings, however, reflect a diametrically opposed perception of originality as an entirely objective matter. Often moved by both pragmatism and the subjective criterion’s shortcomings in certain areas of creativity, such as databases and computer programs, judges have often departed from the mainstream approach and relied exclusively on the objective criterion for originality instead. While judges in the OAPI countries have not been receptive to this judicial thinking, French judges have frequently spoken of originality as being the opposite of banality,²² denying protection for a drawing, for instance, on the grounds of its banal and commonplace composition.²³

In judgments based on either approach, a clear boundary is usually drawn to avoid any possible confusion between, or combination of, the criteria applied. While it may not have significantly affected the thrust of the decision, it is therefore regrettable that the judge in this case referenced both sets of criteria for defining originality.

II. Delineating the contours of illegal reproduction

In practice, the original character of a first work is not sufficient to characterize a subsequent work as plagiaristic, informally understood here as “infringing” on the former. In examining the facts in a case, a judge must find the replication of elements characteristic of the work’s form to be of a certain nature (A), regardless of how extensive the borrowed elements may have been (B).

A. Nature of the replication

For replication of a literary work to be found infringing, it must include expressions found in the original and that reproduction must be unauthorized.

As a general rule, according to Professor Lucas, there can be no copyright to a work until it leaves the realm of speculation to take concrete, perceptible form.²⁴ In other words, an expression is protected by copyright only so long as it is original. Aware that such originality of expression was required, the defendant strove in vain to demonstrate how the second volume of the hairdresser’s handbook was “in no way original.” The defendant argued that the material inspiring its own book, extracted from the plaintiff’s work, was too banal for claims of infringement to be founded – that the points of resemblance between the two works pertained to elements not eligible for copyright protection and the differences sufficed to rule out infringement. Sweeping this line of argument aside, the judge concluded that the pages reproduced represented an arbitrary choice by their author, setting them apart from the “prior public domain.” The various chapters, titles and paragraphs, and especially the approach taken to customer relations in the second volume of his handbook, reflected free

18 See *Toure, A. v. SICOA*, Judgment No. 598 of December 8, 2005, Supreme Court of Côte d’Ivoire (obs. A. Fade, this collection, Chapter 6, section E).

19 C. Le Henaff (2005/06) *Les critères juridiques de l’œuvre à l’épreuve de l’art* conceptual. Masters thesis, University of Poitiers, 68.

20 See *n. 18* (obs. A. Fade, this collection, Chapter 6, section E).

21 Cass. 1ère civ., February 11, 1997, *JCP G* 1997, II, 22973, 1ère esp. (note X. Daverat), D. 1998, 290; 2ème esp. (note crit. F. Greffe), summary, 189 (obs. C. Colombet), *RTD com.* 1999, 391 (obs. A. François).

22 M. Vivant and J.M. Bruguiere (2009) *Droit d’auteur*. Paris: Dalloz, 161.

23 Cass. civ., May 27, 1942, S. 1942.1.124.

24 A. Lucas and H.-J. Lucas (2001) *Traité de la propriété littéraire et artistique*, 2nd edn. Paris: Litec, 33.

choices by the author and, by extension, sufficiently distanced his work from that entitled *African-Caribbean Hairdressing*, second edition.

Having deemed the form reproduced to be original, the judge went on – as if recalling the need to do so – to observe the absence of prior consent from the author to publish the infringing work: “Inasmuch as [the defendant] brings no proof that it obtained the plaintiff’s authorization in this regard, it can be reliably said and ruled that the reproduction is unlawful and thus opens up a right to redress for the plaintiff.”

B. Irrelevance of the quantitative extent of the reproduced elements

In comparative law, article L.335(3) of the French Intellectual Property Code defines infringement as the “reproduction, representation or dissemination by any means of a work of the mind in violation of copyright.” It is thus intended for cases where all or part of a literary work is reproduced without authorization from its author.

In the case examined here, the judge was at pains to emphasize the partial character of the illicit reproductions, starting with a minute examination of resemblances between the two works: chapters, headings, titles and approach to customer relations. Numerous paragraphs from Mr. Broyo’s work were found to have been transposed verbatim and *in extenso* in the unauthorized copy.

Not stopping there, the judge went on to weigh the differences between the two works, while carefully avoiding those found in their respective summaries, omitting mention too of the unauthorized handbook’s successful registration with BURIDA. To guard against impunity for pillaging the work – something a potential infringer might achieve by rewriting the copy in minor ways – the judge focused on the intrigue of spatiotemporal transposition to declare the subsequent work an infringement, victimizing the prior work’s author.²⁵

After comparing the two works, the judge concluded that the defendant’s work was indeed a partial reproduction of the plaintiff’s second volume.

Aristide Fade

C. Copyright – Original work – Proof of originality – Need for trial judges to state the grounds for their decisions

Trial judges must ground their decisions in arguments of fact and law, facilitating judicial review by appeal courts as much as possible. They may not simply infer infringement from the unauthorized commercial exploitation of a photograph without ascertaining its originality, as in the first case reviewed.

The court in the second case too can be criticized for finding, without stating the grounds for its decision, that a service provider that has designed an internet site can claim to hold copyright to the site’s hidden components, including the source code, object code, algorithms, programs or other technical descriptions, data structures and database content.

First case

SONITEL V. THE KYBIA AGENCY, Judgment No. 15-040/ Civ of April 21, 2005, Supreme Court of Niger

Second case

SOCIETE DE GALVANISATION DE TOLES EN COTE-D’IVOIRE SA (TÔLES IVOIRE) C/ SOCIETE FOCUS BUILDING & CONSULTING SARL, Judgment No. 1561/2013 of November 7, 2013, Commercial Court of Abidjan

Observations:

The Supreme Court of Niger did not furnish a factual basis for appraising the merits of arguments made against it – a failing that incurred censure from the Court of Appeal of Niamey. The firm Société Nigérienne de Télécommunication (SONITEL), a pioneering national telecommunications operator, hired the agency Iman, presumably for an advertising campaign, and Iman used a photograph, the rights to which belonged to another agency, Kybia. The Court of Appeal found infringement and ordered SONITEL to pay Kybia CFAF 5 million in damages. The Supreme Court quashed that judgment for insufficient grounds.

Without dwelling on the ways in which the defendant company justified its exploitation of the work, arguing that it had legitimately acquired the rights to do so, suffice it to say here that the court dismissed its plea, such rights conferring no dispensation for the assignee from respecting the author’s right to be identified as such (see the second comment on this decision below).

By way of grounds for its decision, the Court of Appeal stated: “[It] is well established and not in dispute that SONITEL and Iman commercially exploited the photograph at issue without prior authorization from Kybia, profiting monetarily by doing so – and also violating both article 28 of Ordinance Nos. 93–27 of March 30, 1993, in respect of copyright in Niger, and annex VII of the revised Bangui Agreement (ABR), establishing the OAPI.” Seeking to have the decision quashed, the appellant found fault with the summary character of these grounds. Attempting to salvage them, the respondent described the Court of Appeal’s solution as based on “careful analysis of the arguments advanced by the parties on substance, including summons and statements of facts served by a court bailiff which shall be considered authoritative until proven otherwise” – but to no avail: the Supreme Court, citing article 2(2) of Law No. 2004-50 of July 22, 2004, on organization of the judiciary in the Republic of the Niger, recalled that “the obligation to explain the reasons for judicial rulings requires judges to found their decisions on arguments of fact and law, ascertainable upon first reading, so as to facilitate subsequent judicial review as much as possible.” That condition had not been met, according to the Supreme Court, in this case on appeal.

25 TGI Paris, December 6, 1989, *Cah. dr. auteur* 1990, May–July, 21.

The clarification is welcome. The obligation to explain the reasons for judgments and rulings, as the court noted, stems from the need for effective judicial review. In civil law matters, however, that is not the obligation's only purpose. The French Court of Cassation has characterized it as: (i) a requirement that "judges perform legal reasoning, examining the law and the facts each in light of the other"; (ii) "a guarantee for litigants that their pleas and arguments have been seriously and fairly considered"; and (iii) "a rampart against arbitrary and partial judges."²⁶ All of this makes it "an essential rule permitting verification as to whether a judge has applied the law correctly, consistent with the principles guiding the trial." Among the conclusions drawn from this reasoning, French courts have found, as one example, that recognition of a foreign decision for which the grounds have not been stated nor documentary evidence furnished is contrary to international public policy on legal procedure.²⁷ In the present case, it was incumbent on the trial judges not only to characterize the originality of the photograph at issue but also to verify eligibility for the protection claimed and indicate precisely how that right was infringed.

The court's clarification remains extremely general and hence is unclear for commentary purposes. It likely concerns whether copyright protection exists – which is affirmed rather than demonstrated – not whether wrongful exploitation occurred. From this point of view, the decision to quash the judgment should be understood as obliging the trial court to clearly assess the originality of the work allegedly infringed. The reminder is apt: courts frequently assume the originality of a work when the *maxim actori incumbit probatio* prescribes that it is incumbent on the plaintiff alleging infringement to demonstrate the work's eligibility for copyright protection. The originality of a photograph, moreover, is often debatable and is often denied in the courts. In France, for instance, photographs are eligible for protection only if they faithfully represent an object,²⁸ a place,²⁹ an animal,³⁰ a model³¹ or an event.³² The French Court of Cassation has been particularly strict in such cases in requiring trial judges to explain their reasoning as to originality.³³

26 Cour de Cassation, *Rapport 2010 de la cour de cassation*. Paris: La documentation française, §1.2.2.1.1.

27 Cass. 1ère civ., November 28, 2006, No. 4-19.031.

28 CA Aix, Second Chamber, January 20, 2004, *Comm. com. électr.* 2004, comm. 37, 1ère esp. (note C. Caron).

29 TGI Nanterre, First Chamber, May 18, 1994, *Gaz. Pal.* 1997, 2, summary 506, 1ère esp.

30 CA Paris, 25th Chamber, November 5, 1991, JurisData No. 1991-024063.

31 CA Paris, Fourth Chamber, October 15, 2004, JurisData No. 2004-251871.

32 Cass. 1ère civ., February 3, 2004, No. 2-11.400, *Prop. intell.* 2004, 630, 2ème esp. (obs. A. Lucas), and 633, 1ère esp. (obs. P. Sirinelli).

33 Cass. 1ère civ., December 10, 2014, No. 10-10.923, *RIDA* 2015, 2, 367: "Considering that to find the company Jeca liable for artistic infringement and prohibit it from using the photograph at issue, the impugned judgment held that the photograph, representing a round and a trapezoid-shaped paté, labeled mousserelle and elaborately composed against a carefully arranged background, was clearly original in character; and that in so concluding, based on reasoning inadequate to characterize how the photograph bore the imprint of the author's personality, the Court of Appeal did not provide a legal basis for its decision."

The need to explain reasoning as to originality does not hold true for photographs alone, as shown in this second reported case under this heading, a judgment of the Commercial Court of Abidjan concerning an internet site.

The facts in this case are paradigmatic. A company retained a consulting firm in connection with a "strategic program" that included the development of an internet site. Considering that the firm had "entirely consumed" its approved budget for the year, the company terminated the contract and requested a meeting to settle related practical matters, which included the firm turning over the site's access code. When the firm refused, the company refused in turn to pay the firm's final invoice, producing a stalemate. The company considered the firm's refusal unfounded, since the company now "owned" the site, having financed it.

The consulting firm responded that, as author of the site, it was sole owner of the accompanying copyright, giving it the authority to freely decide whether or not to make related disclosures, including of the access codes. As a client, it said, the company was entitled only "to use the site, there being no clause assigning intellectual property rights."

The court ruled in favor of the consulting firm. The reasoning of the Commercial Court was sound but completely disregarded the issue of originality – the focus of attention here. The court began by recalling the principle that "when a company assigns to an external provider the design of its internet site or the creation of site content, the provider owns the associated IP rights unless otherwise agreed in a written contract." The court went on to say, however, that the site's access code, which was merely a "password," was not covered by the protection afforded, leaving it normally up to the provider to furnish it to the client upon completion of the work. The client, meanwhile, was obliged to honor its own commitments and it had not done so, having failed to pay an amount owed. The consulting firm was thus justified in exercising its right to hold as security its debtor's movable assets, including incorporeal ones such as the site's access code.

We shall not dwell on the interesting civil law question raised: whether the right of lien provided for in article 67 of the Uniform Act Organizing Securities of the Organization for the Harmonization of Business Law in Africa (OHADA) can be exercised in respect of incorporeal movable assets, possibly including an access code. We shall speak only of the copyright-related aspects.

We cannot but endorse the premise that copyright to "works made for hire" does not convey automatically to the hiring party. The plaintiff erred from that standpoint in characterizing the issue as one of "service delivery as opposed to a work of the mind," which removed copyright from the discussion. Also escaping discussion was the affirmation that an access code, which is not a work of the mind, cannot give rise to copyright. The court surprisingly seemed to take as given that an internet site as such is a work eligible for protection; it is not, unless

it fulfills the originality requirement – a conclusion that is not evident here. The trial judges should have verified this point.

The omission is all the more regrettable given the judgment's wide protective effect, attributing to the provider "copyright to hidden components of the site, including the source code, object code, algorithms, programs or other technical descriptions, data structures and database content." But this conclusion is flawed. It is widely accepted in particular that algorithms are not eligible for copyright protection³⁴ and that only the structure of databases, exclusive of their "content," can give rise to copyright.³⁵

André Lucas

D. Copyright – Ownership of rights – Multiple works – Outside contributions to the work – No exclusive authorship

The role played in editing the manuscript by a person entrusted with the publication of a work on ritual crimes cannot be used as an argument to claim exclusive authorship of the final work.

EBANG ONDO ELVIS V. MINKO MVE BERNADIN,
Judgment No. 192/10-11 of March 9, 2011, Court of First Instance of Libreville

Observations:

This judgment of the Libreville Court of First Instance, while not without its flaws, offers an overview of such essential concepts as author, collaborative work, collective work and derivative work.

Facts: After the death of his son, victim to a ritual crime, the plaintiff created an association to raise public and government awareness of such atrocities in Gabon. The association organized numerous conferences and roundtables, collecting data in the process for use in a "manifesto." The defendant was entrusted with editing this work, for which he received payment of CFAF 800,000. However, he then published under his own name, with L'Harmattan, a work entitled *Manifesto against Ritual Crimes in Gabon*.

Sued for infringement by the association's founder, the defendant claimed authorship of this work, underscoring his role in preparing the manuscript, correcting it extensively, and traveling multiple times between Libreville and Paris. He claimed that the plaintiff had

"contributed nothing to the drafting and finalization" of the work.

He did not convince the Libreville trial court, which ruled against him, reasoning as follows.

Reasoning: Article 4 of annex VII to AB-1977 provides that copyright protection is acquired as of "the creation of the work even if the work is not fixed on a material medium." It was not in dispute that the "idea for the manifesto" came from the plaintiff or that the plaintiff communicated extensive documentation to the defendant, consisting of statements made at numerous conferences and roundtables organized by the association and many of the plaintiff's own writings. Thus, the court said:

"[E]ven if considered a collective work, as argued by the defendant, that does not allow the defendant to claim authorship of the *Manifesto against Ritual Crimes in Gabon*, of which he was not the 'initiator'. This is particularly true since, while he contributed 'much of his own flavor' to the final work – considering that in purely formal terms he altered (the plaintiff's) somewhat naïve, mystical-religious style – there are substantive similarities between the plaintiff's personal writings and the *Manifesto* in terms of content and questions addressed."

The work was therefore to be considered that of the association's president, who was to be granted his "requests to stop dissemination of the work in its current form under the (defendant's) name and withdraw it from sale."

The judgment is praiseworthy in refusing to make the defendant the exclusive author of the work at issue. No such claim was reasonable once it was established that the work had arisen from documentation furnished by the plaintiff, including his own personal writings. The claim also clashed with the defendant's own characterization of the work as collective, since initial ownership of the rights would then be attributed to the person (natural or legal) having initiated – rather than those having contributed to – the collective work.

It is difficult to follow the court, however, on the other points it addressed and it is regrettable that the opportunity was missed to comment instructively on the ownership of rights to collective works.

The work in this case was indeed collective; contrary to the court's ruling, the defendant's contribution to the final work could not be dismissed. It would clearly be contradictory to attribute exclusive authorship to the plaintiff while at the same time admitting that the defendant contributed "much of his own flavor." Such an observation should have ruled out the idea of the work having a single author.

But the status of this collective work must still be determined.

34 See C-406/10, *SAS Institute Inc. v. World Programming Ltd*, Judgment of the Court (Grand Chamber), of May 2, 2012, ECLI:EU:C:2012:259, RIDA 2012, 3, 341 and 181 (obs. P. Sirinelli), *Comm. com. électr.* 2012, comm. 105 (note C. Caron), D. 2012, 2836 (obs. P. Sirinelli), *Propri. intell.* 2012, 423 (obs. V.-L. Benabou), *RTD com.* 2012, 536 (obs. F. Pollaud-Dulian, who says, at [32], that, "consistent with the principle that only the expression of a computer program is protected by copyright; the ideas and principles underlying the logic, algorithms and programming languages are not protected by virtue of this Directive").

35 See art. 3(2) of Directive 96/9/EC of the European Parliament and of the Council of March 11, 1996, on the legal protection of databases, OJ L 77/20, which specifies that such protection "does not cover their content."

Before finally recognizing the plaintiff's authorship as exclusive, the court did not reject the characterization of the work as collective, drawing explicitly on the definition in article 25 of annex VII to AB-1977 in dismissing the defendant's claim of authorship. That provision, now incorporated in ABR-2015 as article 1 of annex VII, defines the term "collective work" as a:

"... work created at the initiative of a natural or legal person who discloses it under his direction and name and in which the individual contributions of the various authors participating in its creation merge in the whole for which it was created so that it is impossible to attribute to each of them a separate right in the whole work once completed."

The court deduced from this provision that "a work, even a collective one, must be issued under the direction and name of its initiator," from which it inferred that the defendant, who in no way claimed that the idea for the "manifesto" was his and who even recognized explicitly that it was the plaintiff's, could not claim to be recognized as its author.

This reasoning calls for two observations. First, it is built on the premise that the initiator of the collective work was necessarily the plaintiff, because he had the idea first; it would have been perfectly possible, however, to consider the association that the plaintiff represented the initial right holder, spoiling the court's conclusion.

The second, more important, observation is that the characterization of the work as a collective one warranted more extensive debate. The definition cited above is very closely based on that in article L.113(2)(3) of the French Intellectual Property Code, which defines a collective work as "a work created on the initiative of a natural or legal person, published and disseminated under that person's name and direction, and in which the individual contributions of several authors blend together as a whole, as envisioned when first conceived, without it being possible to attribute to each a distinct right to the entire work." This definition assumes multiple contributions, a condition met in this case, but also "direction" by the initiator of the creative process. It is often said that collective works entail a hierarchical relationship between initiator and contributors. It is not apparent from the facts set out in the judgment, however, that the defendant received any direction at all about the work's content.

This absence of hierarchy suggests a collaborative effort, which would mean indivisible ownership by the plaintiff and defendant. Such a work of joint authorship is defined in article 1 of annex VII to ABR-2015 as "a work in whose creation two or more authors have collaborated" – a verbatim transposition of article L.113(2)(1) of the French Intellectual Property Code. Examining how that provision has traditionally been interpreted in French case law – a logical step given the textual provenance – it appears that the definition implies genuine collaboration among

the co-authors.³⁶ It would thus be entirely appropriate to conclude that the second co-author in this case did not in any way collaborate with the first.

Upon reflection, the situation here brings to mind the concept of a "composite" work, which is defined in article 1 of annex VII as "a new work in which a preexisting work is incorporated without the collaboration of the author of the latter" – a definition taken word for word from article L.113(2)(2) of the French Intellectual Property Code. It would be fine, in our view, to characterize the work as "derivative," an easier term to grasp. Reference is sometimes made to multiple successive authors,³⁷ where the contribution of the second author, if there are two, adapts, completes or corrects that of the first. In the case of the work at issue, the defendant not only made corrections but also, as indicated above, contributed "much of his own flavor," which means that he contributed significantly to the form taken by the final work. It would therefore have been logical to recognize his authorship of what can be considered a derivative work.

That does not mean, however, that the plaintiff's claim was completely unfounded. Indeed, the consequences of characterizing the work as composite (or derivative) are indicated in article 5 of annex VII, which provides that protection for composite works "shall not affect the protection of existing works used in the making of such works." In concrete terms, the author of the second work acquires copyright but can exploit it only with authorization from the author of the first. In this case, such authorization would have had to come from the plaintiff, either as author of the first work or, if the work were considered collective, as representative of the association as copyright holder. In the absence of such authorization, the exploitation was indeed an infringement.

The result, one can see, is the same, but the route whereby we reach it is quite different, taking better account of the legal categories of literary and artistic property.

André Lucas

E. Copyright – Protection of a pseudonym – Protection of a logo – Condition for protection: originality

To be eligible for copyright protection, any literary or artistic work must be of prior creation and meet the condition of originality. Pseudonyms and logos are not exceptions to this rule. Borrowing from the subjective conception of originality, the judge requires that these creations reflect the imprint of the personality of their author.

36 A. Lucas, A. Lucas-Schloetter and C. Bernault (2017) *Traité de la propriété littéraire et artistique*, 5th edn. Paris: LexisNexis, No. 189 and the references cited.

37 *Ibid.*, No. 229.

TOURE, A. V. SICOA, Judgment No. 598 of December 8, 2005, Supreme Court of Côte d'Ivoire

Observations:

In essence, copyright boils down to a set of subjective prerogatives enjoyed by the authors of protected works, irrespective of their means of expression, value or intended audience. A work must meet the condition of originality, the “cornerstone of copyright,” or else be excluded from protection.³⁸ Borrowing from the French Court of Cassation, which has often been prompt in recalling this established principle,³⁹ this unusual judgment issued by the Supreme Court of Côte d'Ivoire gives further shape to this conceptual approach.

Facts: The case concerned a dispute between Mr. Toure, the appellant, and the company SICOA. Mr. Toure seems to have created a clownish character with special attributes and a specific image, as which he appeared under the pseudonym “T.B” in the context of animated children’s programs, such as *Wozo Vacances* and *Ahouaney*. After a decade of performing as that character, Mr. Toure claimed credit for the clownish image and pseudonym “Bouba,” which SICOA was then using, without the creator’s consent, as a logo to market its baby pacifiers. Considering that he had suffered injury from commercial use of his creations, Mr. Toure brought a suit for damages before the Abidjan trial court for the logo’s infringement of his copyright.

Dismissed by the trial judge, Mr. Toure took his claims – again without success – to the Court of Appeal of Abidjan. The appeal court, appropriately, took the opportunity to recall that a work’s originality is the keystone of copyright protection. In other words, to be protected by copyright, a creation must above all be an *original work*, defined here in the sense of article 10 of Côte d'Ivoire’s Law No. 96-564 of July 26, 1996, on the protection of intellectual works and on copyright for authors, performers and producers of phonograms and videograms – that is, as a work whose author can be individually identified.

Dissatisfied with this decision and as a last resort, Mr. Toure appealed to the Supreme Court of Côte d'Ivoire.

Reasoning: Ruling to settle the dispute, the court affirmed the appeal court’s reasoning, taking a keenly subjective approach to defining the concept of originality. It is thus essential to revisit the fluid contours of that concept, as the nerve center of copyright protection (section I), before looking more closely at the decision (section II).

I. The ambiguous contours of the originality concept

Originality is a fundamental criterion distinguishing literary and artistic, as well as industrial, property. It cannot be simply defined and hence originality has become a variable concept. We can note – without stirring controversy, given its scattered interpretations – that the lawmakers of Côte d'Ivoire, faithful to their personalist convictions, provided the following definition in article 10 of the law invoked by the appellant: “An original work is a work whose characteristic features and form, or form alone, allow its author to be individually identified.”

The crux of the present case lay in defining the concept of originality – the key to copyright protection. The Supreme Court was called upon to go beyond the combative rhetoric of doctrinal controversy and make a decisive choice between the predominant conceptual approaches being taken in contemporary case law (A). While at first glance it seems to have taken a subjective approach, the court’s reasoning ultimately betrays its – possibly unconscious – objectivity (B).

A. The doctrinal dispute over originality

The earliest, revolutionary, legislative texts made no references, even veiled, to originality.⁴⁰ The concept was to be constructed discreetly over the years through judicial precedent.

Throughout the 19th and part of the 20th centuries, a work was deemed original, on its face, if not the reproduction of a prior work.⁴¹ As P.-Y. Gautier put it, the concept of originality could “better be delineated in contrast with its antonym, banality,” so that in practice it became synonymous with “novelty.”⁴² On this basis, copyright was quickly denied for a drawing on the grounds that its composition was banal and commonplace.⁴³ Yet this is to ignore the more subjective theories of those following Desbois, who offered an example: two painters depict on their canvases, one after the other, the same place, from the same perspective and under the same light conditions. Both, he says, have created original paintings, but the second is objectively not new if we imagine artistic creation to be nothing more than a work imitating nature and the second painting thus to be nothing more than reproduction of an earlier creation.⁴⁴

Yet that second painting is indeed entirely novel according to article 10 of the law cited in the present case, which approaches originality from a subjective, or personalist, perspective. Desbois puts it simply: “To be eligible for copyright it suffices for a work to be original; it need not be objectively new.”⁴⁵ For disciples of the personalist school, a work is protected because the author is present within it: originality is subjective.

38 Vivant and Bruguere, n. 22, at 160.

39 See *Babolat v. Pachot*, March 7, 1986, Cass. ass. plén.; M. Vivant (ed.) (2003) *Les grands arrêts de la propriété intellectuelle*. Paris: Dalloz, No. 9; Comm. Maffre-Baugé, D. 1986, 405; Concl. Cabannes (note B. Edelman), *JCP E* 1986, II.

40 Vivant and Bruguere, n. 22.

41 See T. civ. Mayenne, May 31, 1935.

42 P.-Y. Gautier (2007) *Propriété littéraire et artistique* (Droit fondamental). Paris: PUF, No. 35.

43 See Cass. civ., May 27, 1942, S. 1942, I, 124.

44 H. Desbois (1978) *Le droit d’auteur en France*, 3rd edn. Paris: Dalloz.

45 *Ibid.*

The work is a “projection of its author”; the work *is* the author.⁴⁶ In this vein, originality is commonly said to be the very stamp of an author’s soul. For M. Tafforeau, then, originality consists of the author’s personal style.⁴⁷ Ownership thus stems from an indivisibility between subject and object.

Poorly adapted to applied art, the dogma of subjective theory rapidly gave way to new, more legally pragmatic, paradigms. Admittedly, most courts continue to echo a subjective conception of originality. But alongside that formula, reference is now being made to the imprint, reflection or stamp of the artist’s personality. Going further, some judges have cited artistic merit as though it were a criterion indicative of originality.⁴⁸ The case law has also begun to evidence substitution of the more objective concept of intellectual contribution for that of originality, particularly in cases of copyright protection for utilitarian works (maps, diagrams, databases, etc.), protection of which the personalist doctrine alone cannot justify. The stance taken on the originality concept by the country’s highest court thus needs to be viewed in context among these often-entrenched different schools of thought.

B. The judge’s application of the originality concept

Against this doctrinal and case law backdrop, the Abidjan trial court and, later, the Supreme Court were called upon to take positions on the substance of the originality concept. Basing their decisions on articles 6(3) and 10 of Law No. 96-564, both courts leaned, albeit tacitly, toward the personalist approach – or at least, rarely strayed far from it, the Supreme Court reasoning that “none of the characteristic features of the work at issue serve to individualize the appellant.” Rather than reciting dogma about the original work bearing the imprint of its author’s personality, the Supreme Court settled on a blunt formula that is open to criticism. Its reasoning could have been clearer had it used accepted terminology. Instead, for example, the Supreme Court said that “Mr. Toure could not be considered ... the *inventor* of the clownish character.”

In any case, extending its personalist approach to the question of protection for the pseudonym and logo, the court denied the appellant’s request.

II. Denial of protection

Having opted for the subjective approach, the Supreme Court upheld the judgment of the Court of Appeal, thereby denying Mr. Toure protection for the creations he claimed. In denying compensation (A), the judge barely conceals their confusion of protection with ownership of rights (B).

46 Vivant, n. 22, at 162.

47 P. Tafforeau (1995) *Le style musical dans le droit de la propriété littéraire et artistique*. In University of Paris-Sorbonne (ed.) *Musique et style. Méthodes et concepts* (Conférences et séminaires). Paris: Observatoire musical française, No. 3, 50–55.

48 Gautier, n. 42, No. 50: “Sous l’originalité, le mérite.”

A. Denial of compensation

The recognition of protection centres on two conditions: that a creation be deemed a “work,” and that the work be deemed original.

Did the creations claimed by Mr. Toure meet the definition of a “work of the mind”? The judge answered this question indirectly. In denying the appellant’s claim for compensation on the grounds that his creations lacked originality, the court implicitly recognized the pseudonym and the clown image as works.

The next step was thus to appraise the works’ originality. Both the appeal court and the Supreme Court addressed this question. The Supreme Court decided that the creations lacked originality, understood in its subjective sense. In other words, it held that creation of the predominant characteristic features of the works at issue could not be attributed to the appellant.

The court can be commended for first identifying those features characteristic of both the pseudonym and the image. In its analysis, however, the court went on to conclude that the prior and widespread use in Côte d’Ivoire of the nickname “Bouba,” the name used for the animated character in the case, precludes its being original. In so reasoning, the Court fundamentally confused two different conceptions of the term “original.” According to one, an original work must be pre-existing – that is, such that another work can be “derived” from it. But, according to another, a derived work is as eligible for protection as an original if the intellectual contribution made by the derived work’s author is itself “original,” defined subjectively. According to this second meaning, a work may be original, despite its apparent banality, if it is so difficult to disassociate from its author that it has become bound up with the author’s personality. This is illustrated by the second painting in the example given by Desbois. From that standpoint, the court found that the “Bouba” character and image could not bear Mr. Toure’s unique personal imprint.

It is noteworthy that the Supreme Court’s decision to deny the appellant protection reached beyond simple statement, the court explaining it with objective paradigms. But in doing so the court defined originality contrary to instructions from the country’s legislators. For the court, a work bearing the imprint of its author’s personality, in the sense of article 10 of the law cited on appeal, is a new work that is not banal. This was not the legislators’ intention.

It must be acknowledged that the conflation at play in this definition is similarly found often in the literature. For many years, authors have likened novelty to originality. Already resigned to this tendency in his own time, P.-Y. Gautier said, “Too bad! Let’s just say it: in practice these two concepts (originality and novelty) are virtually the same.”⁴⁹ But the judge’s choice here is one of convenience; as mouthpiece for the law, the judge should have simply applied the legislators’ choice. Since

49 Ibid, No. 35.

the “novelty” concept sits within the objectivist school of thought, the judge’s reasoning is thus contrary to the law in Côte d’Ivoire.

B. Confusion between protection and ownership

On this point, the court was misguided in denying compensation on the supposed grounds that Mr. Toure did not create the works at issue. In a key preambular paragraph, the court said that “the result of combining these two articles is to make works of the mind eligible for intellectual property protection only if they are original” and that, “in this case, Mr. Toure did not originate the pseudonym, which does not refer to anyone in particular, being commonplace and widely used.”

This reasoning suggests the judge’s confusion of a claim for protection and a claim for ownership of rights – a distinction that calls for brief exploration of the moment at which a work is deemed to have been created.

That moment is when an author follows up their idea for a work with its expression, even if that expression is incomplete. Article 7(3) of Cameroon’s Law No. 2000/11 of December 19, 2000, regarding copyright and related rights, provides: “The work shall be deemed to be created independently of any disclosure, solely from the personal though incomplete realization of the design, even where such design is incomplete.” More plainly, a work is considered to have been created the instant it takes material form, regardless of the medium, its artistic value or the intended audience. The creator or author is the original owner of rights to that work.

Identifying the creator of the pseudonym “Bouba” in Côte d’Ivoire is thus unrelated to the granting of protection – a truth the court seemed to ignore in the present case. It affirmed first that Mr. Toure did not create the pseudonym or, worse still, “invent” the clown image the respondent used as its logo. This justification for dismissing Mr. Toure’s claim for compensation has rather serious consequences, based as it is on concepts alien to literary and artistic property law. The concept of “inventor” is inextricable from patent law; it refers to the owner of rights to an invention protected by patent. The equivalent term in copyright law is “author”; that is, the owner of copyright protection.

The least that can be said about this is that authorship, as highlighted in the court’s reasoning, is relevant only to the dispute on ownership of the rights and not to protection, which was the issue before the court. Indeed, any works at issue may well be eligible for protection regardless of whether or not a plaintiff is their creator. And yet, on the question of whether the creations in the present case were eligible for protection, the court responded in the negative on the grounds that the animator, Mr. Toure, created neither the character nor the pseudonym. The consequences of this combination of errors are regrettable: the Supreme Court closed the case and denied a claim that, if considered differently, might have been deemed well founded.

Aristide Fade

F. Copyright – Broadcast of a commercial incorporating a musical work – Equitable remuneration for a collective rights management organization – Inadmissibility of action brought individually by the author

The author of a musical work that has been used to produce a radio commercial does not have standing to bring action against the advertiser, inasmuch as the remuneration owed for that use is equitable under article 68 of the Copyright Act of Benin and can be recovered only by the legally designated collective rights management organization.

ISAAC TOHODE V. PHIBAUT AMOUZOUN, Judgment No. 17/18/CJ/SII/TCC of May 3, 2018, Commercial Court of Cotonou

Observations:

This judgment leaves an observer of these cases less than satisfied. The Commercial Court of Cotonou seized on an objection to admissibility to bar action brought by the author of a musical composition, missing the chance to examine other, possibly problematic, legal questions in the case.

Facts: The plaintiff presented himself as an “artist, composer, singer and arranger.” One of his works (one of ten on a phonogram album) was used – under conditions not fully clear from the decision – to produce a commercial aired for several months by a number of radio stations. The author then sued the advertiser for damages in the amount of CFAF 75 million. The action was declared inadmissible on the grounds that it was for the Benin copyright office, the Copyright Office of Benin (Bureau béninois du droit d’auteur, or BUBEDRA), to recover remuneration owed for use of the phonogram.

Reasoning: The court’s questionable solution is based on a provision not applicable to the case: article 68 of the Copyright Act of Benin. The court’s position is regrettable in that, while this objection was not relevant (section I), other objections did warrant, but did not receive, attention (section II).

I. The objection upheld, based on article 68 of the Copyright Act

According to the defendant, “any amount receivable by the author of a work for its use in advertising is collected from the collective management commission, which receives a single equitable remuneration from the phonogram user.” This assertion derives implicitly from the legal licensing system set out in article 60 of annex VII to the Bangui Agreement and article 68 of Law No. 2005-30 of April 5, 2006, concerning protection of copyright and related rights in the Republic of Benin. Under the latter provision, the performer and producer of a commercially published phonogram assign their exclusive rights to a collective rights management organization in exchange for “fair remuneration.”

The Commercial Court examined the argument solely from the standpoint of the Beninese law. After establishing the principle that “when a phonogram is published for commercial purposes, remuneration is paid by the user to the public establishment for collective management and defense of copyright and related rights,” the court concluded that, in this case, BUBEDRA was exclusively “eligible to seek the recovery of royalties for holders of copyright and related rights,” such that artists and musicians could not “recover such remuneration directly from users.”

The argument is not convincing.

To begin with, the court’s reading of article 68 of the national law applied is erroneous. Contrary to its preambular grounds (as restated in its dispositive conclusions), it is not “publication” of the phonogram that infringes the exclusive rights of the phonogram’s artist or performer and producer, opening the way for fair remuneration, but its being broadcast or communicated to the public.

Nonetheless, to generate royalties, publication would still need to have been “for commercial purposes,” which was not as certain in this case as the court seemed to think. As best one can judge from reading the decision, what radio stations broadcast was not the phonogram as a whole, which was an album of the artist’s works (a phonogram indeed published for commercial purposes), but only one of the works included on it (a piece entitled “Evolution”), which, before being fixed on that phonogram and at the time it was used in the commercial, had already been performed publicly several times. It might be tempting to argue that the work at issue was in fact first “fixed” by the commercial itself. There is no doubt that the phonogram had not yet been published, which traditionally means producing multiple “copies.”⁵⁰ But what must be understood is that the legal license for which equitable remuneration is exchanged is intended to free broadcasters from the constraints of exclusive rights when they air previously commercialized phonograms.

Lastly, and above all, the only exclusive rights that could have been infringed in this case would be the related rights of performers and producers of the phonogram. The plaintiff claimed authorship, having stated in his written submissions “that as author of the song ‘Evolution’, he is eligible to assert his claim of ownership to it in court and has an interest in doing so,” rendering article 68 irrelevant to his authorship claim.⁵¹

II. Other possible objections

Other objections could have been – and, in some cases, were – raised against the plaintiff author.

The defendant indicated that another well-known composer had participated in creating the work and, to establish his co-authorship, had opposed the plaintiff’s deposit of the work with BUBEDRA, triggering conciliation proceedings that made the plaintiff’s action for infringement inadmissible pending their conclusion. In doing so, the defendant implicitly refers to articles 86 and 87 of the national law. Article 86 provides that “[a]ny dispute arising from the enforcement of contracts for reproduction, publication or public performance of literary and artistic works and creations protected by neighboring rights shall be referred to the collective management organization for attempted conciliation.” Article 87 provides that “[i]n the event of failure of such conciliation, the parties shall have the right to refer the case to the competent court, either directly or through the collective management organization.” This case, however, does not line up with the hypothesis set out under Law No. 2005-30. The particular point here concerned a dispute between two authors as to authorship of a work deposited with a collective rights management organization – not execution of an exploitation contract. The plaintiff rightly refuted the objection, arguing that BUBEDRA was “not a court and cannot perform any judicial act” and that submission to that body of “a dispute regarding authorship of the segment ‘Evolution’ did not constitute a preliminary point of law.”

The defendant also pleaded inadmissibility on grounds that the plaintiff had not demonstrated “exclusive authorship” of the musical composition at issue – an argument suggesting that a joint author of a collaborative work may not individually bring legal action for infringement. That argument finds support in article 33(4) of annex VII to the Bangui Agreement, which lays down the principle that “the joint authors shall exercise their rights by mutual agreement.” It is true that this provision does not expressly refer to matters of judicial action. In France, early case law admitted the possibility of a co-author taking action alone.⁵² But in 1988 the Court of Cassation did not hesitate to prescribe that “the co-author of a collaborative work who takes the initiative in legal action to defend her ownership rights must involve the work’s other authors, subject otherwise to inadmissibility.”⁵³ This line of case law has been criticized, however, in the literature,⁵⁴ for it painfully complicates effective legal action against infringement. It is therefore less than desirable for article 33(4) of annex VII to be so interpreted.

One last objection comes to mind, concerning the implications of the plaintiff author’s affiliation with collective rights management organization BUBEDRA. That point would be decisive in France, where the Court of Cassation caused a stir by first admitting an action

50 See art. 3(d) of the Rome Convention of October 26, 1961, for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations; art. 2(e) of the WIPO Performances and Phonograms Treaty of 1996.

51 See L.Y. Ngombé, *Chronique d’Afrique: août 2016–décembre 2018*. RIDA 2019, 1, 61–138, esp. 107.

52 Cass. civ., July 21, 1908, S. 1909, 1, 121 (note CH-L. Lyon-Caen); CA Paris, November 3, 1956, *Gaz. Pal.* 1956, 2, 324.

53 Cass. 1ère civ., October 4, 1988, No. 86-19.272, RIDA 1989, 3, 251, D. 1989, 482 (note P.-Y. Gautier). See also Cass. 1ère civ., February 8, 2017, No. 15-26.133.

54 Lucas, Lucas-Schloetter and Bernault, n.36, No. 199; P.-Y. Gautier (2019) *Propriété littéraire et artistique* (Droit fondamental), 11th edn. Paris: PUF, Nos. 703 and 765.

brought by an author who had entrusted his rights to a collective management company,⁵⁵ then spectacularly reversing itself by declaring inadmissible action taken individually by an author having entrusted defense of the rights concerned to the French Society of Authors, Composers and Publishers of Music (Société des auteurs, compositeurs et éditeurs de musique, or SACEM), barring only that organization's failure to defend them itself.

⁵⁶ No such failure having been alleged, the action for infringement in this case would be declared inadmissible in France, absent demonstration that the commercial use at issue is not covered by the copyrights entrusted to the collective rights management organization.

The situation is quite different, however, in OAPI member states. Indeed, article 69 of annex VII, after attributing to collective rights management organizations the mission of ensuring the "protection, exploitation and management of the rights of authors of works and the rights of holders of related rights," adds that those "provisions shall in no event prejudice the faculty enjoyed by the authors of works and their successors in title and by the holders of related rights to assert the rights afforded them by this annex" – a stipulation made in the same terms in article 12(4) of the Beninese law.

André Lucas

G. Prior work – Ownership of rights – Creator of the work – Transformation of the prior work – Author's authorization required – Remedy for use without authorization

The author of a literary work is the natural person who has created it. Accordingly, any public exhibition, transformation or adaptation of the author's creation requires the author's explicit prior consent, and the request to that end must indicate the duration, mode and purpose of the intended use.

The moral rights of the author of a work, which include the rights to be identified and to integrity of the work, are guaranteed by law, under threat of heavy financial penalties in instances of infringement.

MR. KLI V. MR. SJSJL, Judgment of February 18, 2015, RG 326 of April 10, 2014, High Court of Ouagadougou

Observations:

The ownership of copyright to works of the mind can sometimes be nebulous, particularly where the work has multiple authors. The arrival of financial returns – sometimes unexpected at the time of creation – can sound the death knell for any superficial harmony among contributors and signal the start of legal jousting,

with each downplaying the creative genius of the next to claim sole authorship and exclusive rights to exploit the work. The moral, as well as financial, reason for this is simple: the fewer involved, the easier it is to share money and success.⁵⁷ That is the essence of the judgment handed down by the High Court of Ouagadougou in this case.

Facts: Mr. SJSJL, a widely known motion picture director, commissioned Mr. KLI to create a dramatic work entitled *Salomon le sage*, to be staged and broadcast as part of festivities to launch the 2011–12 television season. The elaborate creation proved a huge success and SJSJL then took the liberty, without the consent of KLI, the original owner of exploitation rights, of making changes in the original version of the work and extending its duration beyond the period specified in the representation contract signed on November 6, 2011. Surprised to learn, first, that the amended version of his work had been deposited with the Copyright Bureau of Burkina Faso (Bureau Burkinabè du droit d'auteur, or BBDA) and, second, that representation of the work had been extended, KLI sought judicial remedy for the illicit exploitation of his work.

The outcome of that judicial contest raises a question: who can legitimately claim ownership of the rights to a successful theatrical work?

Reasoning: After recalling a number of fundamental principles, the judge responded to this question with reference to the Bangui Agreement, which defines "author" as "the natural person who has created a work."⁵⁸ More helpful than the definition set out by Burkina Faso's legislators,⁵⁹ this rule applies to every individual work created by a single person.

Accordingly, absent the litigants' creative contributions, the judge applied the rule to:

- I. determine the single author of the work; and
- II. remedy any infringement of the rights attached to that work.

I. Determination of authorship

According to the facts set out in the case, two creations, both entitled *Salomon le sage*, were at the heart the dispute. The High Court was called upon to determine respective authorship of the original and amended versions. The court began by identifying authorship of the original work (A) and went on to determine which parts of the derived work were liable to be exploited (B).

A. Authorship of the original work

The central question in assessing exploitation of the work was who owned the rights to the original version. In answering that question, the court first had to consider

55 Cass. 1ère civ., February 24, 1998, No. 95-22.282, *Bull. civ.* 1998, I, No. 75, *RIDA* 1998, 3, 213 (note A. Kéréver), *D.* 1998, 471 (note A. Françon).

56 Cass. 1ère civ., November 13, 2014, No. 13-22.401, *Bull. civ.* 2014, I, No. 187, *Comm. com. électr.* 2015, comm. 2 (note C. Caron), *D.* 2015, 410 (note A. Étienney-de Sainte Marie), *Propri. intell.* 2015, 64 (obs. J.-M. Bruguière), *RTD com.* 2015, 291 (obs. F. Pollaud-Dulian).

57 J. Fometeu (2018) *Le contentieux du droit d'auteur et des droits voisins dans la zone OAPI, Mélanges en hommage au Doyen Stanislas Meloné*. University Press of Cameroon, at 631.

58 See ABR-1999, art. 1(viii) of annex VII.

59 See art. 26(2) of Burkina Faso's Law No. 32-99/AN.

the prevailing legal context for copyright in Burkina Faso. That context consisted largely of article 2(viii) of ABR-1999, which the plaintiff cited. Under the general rule set out in article 1(viii) of annex VII, a work's author is the natural person who has created it and they are free to authorize or withhold its use.⁶⁰

This begs another question: at what moment does that creation occur? There as well, Burkina law is less than helpful. Under article 4(3) of Burkina Faso's Law No. 32-99/AN on the protection of literary and artistic property, a work has been created when its conception has been followed by realization of that conception, even if incomplete.⁶¹ In simpler terms, there is conception from the moment the work will have received a formal consecration, sizeable by the law, as opposed to ideas and concepts that are not materialized and that are not susceptible to being legally appropriated. It does not matter that this expression of ideas is unfinished.

KLI claimed conception of the entire work at issue. In response, the defendant SJSJ proved incapable of demonstrating any active participation in conceiving the general idea or in developing parts of the work or arrangements thereof. KLI was thus able to convince the judge that he had fashioned the work entirely. In a similar case, *Maedza v. Mogotsi*, the defendant had commissioned their student, the plaintiff, to compose a poem and then included it in an anthology entitled *Mmopa Khukhu* as though it were their own work.⁶² The Botswana court seized of the merits of that case found that the plaintiff was indeed the author, having duly created the poem themselves.⁶³

In this case, SJSJ sought to obfuscate the facts, claiming a significant contribution of his own to the original work – to no avail. The judge deduced from the circumstances – particularly from the minutes of the BBDA's conciliation process of October 16, 2012 – that the contributions claimed were subsequent to registration of the original work and were not determinative of the original work's authorship.

That left only the task of determining what parts of the derived work should be deemed liable to be exploited.

B. Determination of authorship of the derived work

The arguments the defendant, SJSJ, presented were intended to plant in the judge's mind the idea of jointly owned rights, to be shared with KLI, to the dramatic work entitled *Salomon le sage* – or at least to its revised (derived) version. Before ruling on ownership of the modified work, however, the judge first had to assign it to an existing legal category.

60 P. Edou Edou (ed.) (2009) *Le contentieux de la propriété intellectuelle dans les États membres de l'OAPI: Guide du magistrat et des auxiliaires*. Geneva: WIPO, 23.

61 Cf. art. 7(3) of Cameroon's Law of December 19, 2000, concerning copyright and related rights.

62 *Maedza v. Mogotsi*, Judgment of April 24, 2006, High Court of Lobatse, *Botswana Law Reports* 2007, 1, 182, online at www.elaws.gov.bw/displaylrpage.

63 See *Toure, A. v. SICOA*, Judgment No. 598 of December 8, 2005, Supreme Court of Côte d'Ivoire (obs. A. Fade, this collection, Chapter 6, section E).

First, did the modified work meet the definition of a *composite or derivative* work? The mere existence of a pre-existing work makes it initially tempting to answer "yes." A composite or derivative work is one in which a pre-existing work is incorporated without its author's collaboration, "but with that author's consent."⁶⁴ It was thus clear that it is not the collaboration of the first work's author that would be required to so define the work in the present case but his consent – and that clearly answered the first question in the negative.

Next, what about a *collaborative* work? This question was central to the case. It is worth noting, in this regard, the contempt that litigants sometimes display in distorting French legal terminology. In his reply to the plaintiff, SJSJ contrived to represent the modified work he himself had deposited with the BBDA as a collaborative one. While collaborative works are not clearly defined in the country's copyright law, however, article 27 of Burkina Faso's Law No. 32-99/AN does provide: "The co-authors of a collaborative work are the original owners of the moral and economic rights to that work. They exercise their rights by common consent; in the event of a dispute, it is up to the competent court seized to decide." Put more plainly, a collaborative work is one in the creation of which two or more authors have participated.⁶⁵

There are two possible situations in which a collaborative work may be created. One is where two persons work together to create the work, such that it cannot be easily or precisely said which parts of the work are attributable to which persons. This hypothetical scenario could not be further from the facts in this case. Another is where individual attribution may or may not be possible but the authors have acted in a concerted way toward a common aim. Considering the facts in the case, this second hypothesis also had to be dismissed. The reason is simple, KLI astutely observing that the defendant's contribution to the modified work lacked originality. And, in the absence of an original creative contribution, the derived work could not be found creative and hence eligible for copyright protection.

Clearly not falling within either of the categories of work by multiple authors, the defendant's argument found no favor with the court. KLI's copyright to the successful work, in its entirety, was rightly upheld and the defendant was rightly found to be liable for infringing exploitation.

II. Infringement of rights to the work

Recognizing the plaintiff as author and the exploitation of his work as infringement, the judge had to appropriately penalize the infringement (B), and the decision therefore carefully and minutely delineates its material extent (A).

64 Edou Edou, n. 60, at 23.

65 Edou Edou, n. 60, at 22.

A. Material delineation of the rights infringed

In response to the initial claim, the judge outlined the extent of the rights infringed, espousing as faithfully as possible the standard terminology established in copyright legislation. In broad strokes, the judge deplored the multiple infringements of the author's economic rights (1), curiously ignoring the non-economic infringements (2), although they had been brought to his attention.

1. Infringement of economic rights

Economic rights are the rights of the author to exploit their work and profit from it. They refer to the author's right to reward for their creative effort work and their financial prerogatives in administering it.⁶⁶ Article 16 of Burkina Faso's Law No. 32-99/AN enumerates such economic rights as the rights to:

- reproduce, translate, adapt, arrange or otherwise transform the work;
- publicly disseminate copies of the work through sale, transfer of ownership, lease or lending;
- publicly represent or perform the work; and
- import copies of, broadcast or publicly communicate the work.

In this case, the economic rights allegedly infringed by the defendant were the rights to publicly represent and to transform the work.

According to P.-Y. Gautier, representing a work traditionally means "exhibiting it to the public or bringing it to public awareness by performing it: playing a song or symphony, reciting a poem."⁶⁷ Representation of a work gives rise to monopoly under this traditional conception only if it is communicated to the public.⁶⁸ Today, with the rise of new information and communication technologies, representation of a work extends well beyond material exhibition to include public access when and where an individual might choose.⁶⁹

In this case, the infringement of representation rights by SJSJL consisted of prolonging theatrical performance of the protected work, without the author's consent, beyond the agreed duration.

It is regrettable that the trial judge utterly disregarded the infringement of the author's right to transform his own work, *Salomon le sage*. The transformation of a work means its translation, adaptation, arrangement or any other alteration.⁷⁰ An author therefore enjoys the right to authorize or prohibit transformation of their work in any way.

66 Organisation Internationale de la Francophonie (2011) *Droit d'auteur et droits voisins, Guide pratique sur copyright et les droits voisins à l'intention des magistrats et auxiliaires de justice*. Ouagadougou: BBDA, 20.

67 P.-Y. Gautier (2010) *Propriété littéraire et artistique (Droit fondamental)*, 7th rev'd edn. Paris: PUF, 326.

68 Vivant and Bruguier, n. 22, at 343.

69 See *SONITEL v. BNSA*, Judgment No. 11-250-civ of December 1, 2011, State Court of Niger (obs. A. Fade, this collection, Chapter 6, section O).

70 See art. 18(1) of Cameroon's Law No. 2000/11 of December 19, 2000, on copyright and related rights.

The defendant did, in fact, transform the plaintiff's theatrical work without requesting express authorization to do so, depositing that revised version with the competent collective management organization. The judge might therefore have been expected to sanction that infringement as well.

2. The judge's disregard of moral rights

The BBDA identifies moral rights as non-economic rights falling within a wider category known as "personality rights."⁷¹ Four such rights are identified in article 9 of Burkina Faso's Law No. 32-99/AN: the right of disclosure, the right to be identified, the right to respect, and the right to reconsideration and withdrawal.

Debate in this case centered on the right to respect – that is, the right of the author of a work to authorize or prohibit its distortion, mutilation or other modification.⁷²

The plaintiff complained that SJSJL had mutilated his creation, without requesting prior consent, by adding new female characters in a manner the plaintiff considered highly "prejudicial to his honor or reputation." The judge condemned SJSJL for the violation of the right to respect KLI's work.

It is regrettable that the judge did not also consider the defendant's infringement of the plaintiff's right to be identified as the author of the work, although it was debated during the proceedings. That right is one of those enumerated in article 11 of Law No. 32-99/AN, which was in force when the facts of the case occurred. It refers to an author's exclusive right to require mention of their name each time their work is made available to the public.

B. Application of relevant sanctions

Any sanction applied in cases such as this is intended to stop the infringements committed and also to remedy the prejudice caused. In the present case, no clear explanation was given of the calculation of damages, the main sanction (1), and additional sanctions (2) were applied likewise, the judge having decided to go beyond the request for calendar-based penalties.

1. The main sanctions against SJSJL

To protect the plaintiff's monopoly for exploitation of his work, the judge penalized the defendant's theatrical presentation as infringement of copyright by proportionately combining injunction with the award of damages.

The original grounds on which such an injunction is granted can be found in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which was explicitly included in AB-1977 (annex VII, art. 63(1)) but not clearly mentioned in subsequent revisions.

71 Organisation Internationale de la Francophonie, n. 66, at 18.

72 See art. 12 of Law No. 32-99/AN; art. 14(1)(c) of Cameroon's Law No. 2000/11 of December 19, 2000, on copyright and related rights refers to the right to defend a work's integrity.

Article 44(1) of TRIPS provides: “The judicial authorities shall have the authority to order a party to desist from an infringement, *inter alia*, to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods.” That measure facilitates immediate cessation of the infringement.⁷³ The judge in this case likewise ordered “cessation of the infringement of the plaintiff’s rights to the work at issue.”

The award of damages often centers on the civil law measures available to combat infringements of intellectual property rights, both in general and for copyright in particular. Such awards are the civil sanction applied most commonly in infringement cases. They entail the payment of monetary damages to remedy any injury caused by infringement.⁷⁴

As KLI argued in his conclusions, action for damages is legally founded in copyright reforms at the community⁷⁵ and national⁷⁶ levels. Their purpose is to remedy the material and moral prejudice caused by infringement of the victim’s rights.

In this case, the order for SJSJL to pay CFAF 10 million was intended to be compensation for all the injuries combined. It would have been useful, however, for the judge to specify the amount allocated to each injury and hence better explain the amount awarded.

2. The ineffective additional sanctions
The judge could have done more than order provisional execution of his judgment, pending any appeal.

A brief review of KLI’s main allegations reveals that the trial judge was also being asked to “order SJSJL to desist from infringing the plaintiff’s rights under penalty of CFAF 500,000 per day of delay in doing so; and ... to pay him CFAF 500,000 for costs incurred but not included in the legal fees.” In ignoring KLI’s claims for penalties as well as reimbursement of legal fees, although generously formulated, the judge’s decision feels like a job unfinished.

The claim for penalties was entirely appropriate. The relevant provisions of AB-1977 prescribed such a measure, intended to discourage a perpetrator otherwise inclined to continue their illegal practices. According to article 63(4) of annex VII to AB-1977: “Where the danger exists that the infringing acts will continue, the court shall expressly order the cessation of such acts. It shall also determine an amount to be paid as a daily fine.” This provision is identical to article 63(4) of ABR-1999. The fine in this context would be a necessary complement to the judge’s injunction in the event of such risk. The same can be said of the request for reimbursement of legal fees, which is rooted in article 63(1) of annex VII to ABR-1999.

73 Edou Edou, n. 60, at 80.

74 Edou Edou, n. 60, at 77.

75 See AB-1977, art. 76; ABR-1999, art. 63 of annex III.

76 See art. 104 of Burkina Faso’s Law No. 32-99/AN.

The judge in this case thus missed an opportunity to better calibrate the victim’s compensation.

Aristide Fade

H. Copyright – Assignment of rights – Transfer of economic rights – Inalienability of moral rights – Respect by the assignee

While assignment of the rights to a literary or artistic work entails transfer to the assignee of the related economic rights, that assignee must nonetheless respect the moral rights attached to the assigned work, which are personal, inalienable, perpetual, unassailable and transmissible *mortis causa* to the author’s heirs.

An assignee who brings a work to the public without identifying the author on all related media is thereby committing an infringement.

SONITEL V. THE KYBIA AGENCY, Judgment No. 15-040/ Civ of April 21, 2015, Supreme Court of Niger

Observations:

Rare in the courtrooms of OAPI countries are cases examining the moral rights of literary or artistic authors. The present case was an eagerly anticipated opportunity for the Supreme Court of Niger to polish the distinctions between different moral rights conferred by copyright.

Facts: An agency, Kybia, owned the copyright to a photograph. It contractually assigned the economic rights to the photograph to SONITEL. For its operational purposes, SONITEL then hired another agency, Iman, to reproduce the photographic work on several media before communicating it to the public and it did so without identifying Kybia as its creator. While it had assigned away its economic rights to the photograph, Kybia considered that that work’s anonymous publication by SONITEL, without Kybia’s consent, had infringed its moral rights – the right to be identified in particular. Kybia therefore brought judicial action for infringement of its moral rights.

After considering the case, the trial judge declared the action inadmissible, ordering the plaintiff to pay SONITEL CFAF 20 million. Dissatisfied with that ruling, Kybia appealed to the Court of Appeal of Niamey, which re-examined the merits of the case and overturned the trial judge’s decision, ruling against SONITEL. In determining the admissibility of the appellant’s claim and then ordering payment to Kybia of CFAF 5 million in damages, the Court of Appeal simply declared infringement of the appellant’s copyright without explaining the nature of the rights infringed.

The Court of Appeal having thus fallen short of its obligation to state the grounds for its decision, SONITEL unsurprisingly called upon the country’s Supreme Court to exercise its role as forum of last resort. Under an obligation to state the grounds for its decisions,

the appeal should have distinguished, from among an author's exclusive prerogatives, those considered to be non-transferable. The Supreme Court thus had to adjudicate questions pertaining to moral rights, including inalienability, on which hinged the success of the action for infringement. It had to determine whether, in addition to economic attributes, the assignee of rights to a literary or artistic work also acquired moral rights.

Reasoning: Exercising a power to raise issues denied to it under national law, the Supreme Court quashed the appeal judgment, remanding the case back a differently composed court for readjudication. Like a vessel's compass, the Supreme Court thus directed the debate in which that reconfigured lower court should engage. Upon analysis, it quickly becomes clear that two legal provisions cited in its grounds heighten the quality of technical debate. In giving meaning to those provisions, the Supreme Court's decision calls for observations and reflection at two levels.

At the first level, there are two types of copyright, economic and moral. The *economic* rights consist of prerogatives enabling copyright owners to receive financial compensation for the economic exploitation of their works by third parties. Article 8 of the Ordinance governing copyright in Niger (No. 93-27 of March 30, 1993) exhaustively enumerates six such economic prerogatives: reproduction, translation, transformation, importation, representation or performance and communication. According to article 31 of the Ordinance:

"[W]hen a work is created on behalf of a natural or legal person, public or private, under a work contract signed by the author, or when the work is commissioned from the author by such a person, the author is the original owner of economic and moral rights to the work, but the economic rights are deemed to have been transferred."

This text, appearing as part of the second ground, gives substance to the rule that economic rights are transferable. It is unanimously admitted in case law that assignment of copyright entails transfer of economic rights to the assignee.⁷⁷

In that sense, as assignee of economic rights to the photographic work in the present case, SONITEL could – against payment – reproduce, communicate or distribute the creation to the public without requiring prior authorization from Kybia. Whether the assignee exploited the work on its own or through an intermediary – Iman, in this case – was immaterial. In that respect, the Court of Appeal's decision was entirely appropriate. Its only fault was that it did not specify in its grounds the nature of the infringed rights giving rise to the award of damages.

From that perspective, the Supreme Court was able to challenge the factual information considered by the

appeal court, which, while recognizing the status of SONITEL as copyright assignee, proceeded even so to hold it liable for copyright infringement. In a rather explicit preambular paragraph about their reasoning, the appeal judges affirmed that "it is established and not in dispute that SONITEL and the Iman Agency engaged in commercial exploitation of the photograph at issue without prior consent from the Kybia Agency and derived monetary profit from doing so." The Court of Appeal reasoned, in other words, that – absent the assignor's consent – copyright assignment did not entail the transfer of exclusive prerogatives enabling their beneficiary to exploit the work concerned. The question thus arises: was the Court of Appeal actually characterizing the exercise of assigned economic rights as unauthorized and thus illicit exploitation? One cannot help wondering whether the assignment contract, never once challenged during the proceedings, is not a form of authorization to exploit the work, which would be at odds with the Ordinance cited above.

And yet, at the second level, the Court of Appeal's decision would have been sound if its statement of grounds had made the necessary distinctions between the author's various rights. Instead of limiting itself to ambiguous condemnations, the court should have based its argument on article 8 of the Ordinance, as cited in the second ground, and confirmed the rule that *moral* rights are not transferable. As pointed out by the judge in a similar case in Gabon,⁷⁸ copyright prerogatives of a moral nature are reserved exclusively for the author, even after assigning away all or part of their economic rights. The judge in that case decided that "even if, as in the case before us, Ms. Ross assigned the right to use her work to Jeep, against payment, she still retains moral rights to that work."

The foundations for the rule that moral rights are not transferable, unexamined in this case, are several. One concerns the very nature of moral rights, which fall into the larger category of personality rights. Their main purpose is to protect and preserve the link between author and creation, thus avoiding excessive alienation of the author's freedom of creation in the future.⁷⁹

The law of Niger applicable to the diverse facts in the case draws clear distinctions between the right to be identified, the right of integrity and the right to remain anonymous or use a pseudonym. Modern legislation in other countries is much more generous in conferring a wider range of moral rights. For example, article 14(1) of Cameroon's Law No. 2000/11 of December 19, 2000, on copyright and related rights, identifies the moral rights to be identified, of integrity, of disclosure and of reconsideration or withdrawal. The right to be identified, the main focus of debate in this case, means the right of an author to be named as such in all iterations of the work. That right means at least two things.

77 *Christine ROSSANO v. Société SOVING AB*, Judgment (undated), Tribunal of Libreville, reported in Edou Edou, n. 60, No. 3, 373.

78 *Ibid.*

79 WIPO (2016) *Understanding Copyright and Related Rights*, 2nd edn. Geneva: WIPO, 9.

- In positive terms, it means that the author has a prerogative to ensure that the work is published under their own name.
- In negative terms, although a separate prerogative under the law of Niger, it is also the right of an author to remain anonymous or to publish under a pseudonym, so as not to reveal their identity.

A certain number of characteristics are generally attributed to moral rights. Consistent with their personal character, moral rights are defined in article 8 of the Ordinance cited in this case as perpetual, inalienable, imprescriptible and not seizable, and as transmissible at death to the author's heirs. As used here, the term "inalienable" is understood to mean that the author's right cannot be transferred to a third party. Case law has consistently favored this language, systematically annulling all contrary clauses in assignment contracts. In the case between Christine Ross and Soving Co., for example, the Libreville court convicted the latter of infringing the former's right to be identified, which was not transferable by means of a copyright assignment contract.

The present case can serve as a reminder: in the case of an artist, the assignment of copyright conveys economic rights only; the assignor retains in perpetuity the exclusive ownership of moral rights.

Aristide Fade

I. Literary and artistic work – Unauthorized reproduction of the work – Commercial exploitation – No exception for private copies – Infringement

Mass reproduction of a literary and artistic work without the author's consent (in this case, of a painting as a greeting card) and distribution of the reproductions to associates of the copier far exceeds the concept of a private copy, and it constitutes an infringement of copyright under article 27 of Côte d'Ivoire's Law No. 96-564 of July 25, 1996, on protection for intellectual works.

SENI BAMOGO V. AERIA, Adversary judgment RG No. 1001/14 of June 12, 2014, Commercial Court of Abidjan

Observations:

Certain kinds of activities are not restricted by the legal monopoly conferred on authors, and the reproduction of works for private use is a good example. Faced with the complex new means of reproduction facilitated by the internet and digital technology, many modern legislatures, including those in OAPI countries, have adopted the palliative solution of legalizing copies of works shared only privately.⁸⁰ Indeed, while existing technology does not allow authors or their successors

to easily maintain their exclusive right of reproduction, compensation for such persons, through the imposition of a levy, has been suggested as a solution.⁸¹ Under such a regime, copying would no longer be illegal and the copier would be relieved of the duty to obtain prior authorization from a work's author or their successors. Copies made only for private distribution is therefore a formidable exception available to copiers of protected works if they are sued for infringement, into which this case opens a window.

Facts: Seni Bamogo, a renowned, widely exhibited artist, was the author of a painting, *The Future of a Child* (2009, acrylic on canvas). Following its exhibition in a gallery in the Abidjan district, the painting was sold in 2009 to the Houkami Guyzgn art gallery, which then exhibited the work on its own premises. A few months after the sale, Simplice De Messe Zinsou, chair of the board of Abidjan International Airport (AERIA), took advantage of the painting's exhibition to reproduce it as a greetings card and send it en masse to airport customers, without obtaining prior authorization from the creator.

Displeased by the reproduction and public representation of his work, Mr. Bamogo brought action before the Commercial Court of Abidjan for infringement of his rights to reproduce and represent his creation. During the proceedings, to avoid liability, AERIA claimed that the reproduction had been for private use only. The question the judge then examined was whether a person's use of a painting, given freely to only an airport's customers, could be called "private use," thereby exonerating such person of infringement. In doing so, the court was able to stake out a judicial framework for the treatment of works copied privately in an age of digital reproduction.

Reasoning: The judge responded to the question in the negative, first recalling the conditions for allowing private-copy exceptions, which include lawfulness of the source, the personal and private character of the use, and an ability to pass a "three-step test."

In broad terms, the private-copy exception establishes a special waiver of the author's exclusive right to authorize copies of their work by third parties. If the exception is allowed, only reproductions escape the author's monopoly. Creators have no legal recourse for infringement in the few cases where reproductions are authorized. In terms of content, the reproduction of works occurs across a wide range of activities, so the concept is extensive. It covers such activities as the recording of a musical work, the publication of a book, the photograph of a work, the audio, audiovisual or digital copy of a work, and the photocopy of a work. However, the exception is conditioned on the *lawfulness of the source* reproduced – a limitation that the judge in this case overlooked or ignored.

80 S. Rompre (2007) Le régime de la copie privée face à Internet. *Lex Electronica* 12(1), 2.

81 WIPO (1971) *Guide to the Berne Convention for the Protection of Literary and Artistic Works*. Paris: WIPO, 56.

A source of numerous disagreements, in both case law and the literature, the question of lawfulness of source has been central to the debate on conditions for the private-copy exception. Virtually all the legislation in OAPI member states conditions the exception on lawful disclosure of the work later reproduced.⁸² In other words, a copy made from an unlawful source is itself unlawful, by “contamination,” and does not qualify for the private-copy exception.⁸³ Article 31 of the Côte d’Ivoire law applicable when the facts occurred is a perfect example. Inclusion in that article of the condition of lawfulness of the source of reproductions indicates the intent of the Ivorian legislator to make it decisive for the private-copy exception. The article provides that “when the work has been lawfully made available to the public,” the author cannot prohibit reproductions reserved for strictly personal and private use. For the exception to apply in this case, the lawful character of the painting’s exhibition by the Houkami Guyzgn art gallery, including non-infringement of the painter’s prerogatives, had to be established.

The disagreements hinge on whether it is acceptable to make lawfulness of source a condition for waiving the author’s monopoly.⁸⁴ The main advantage of this is to spare parties invoking the exception the evidentiary difficulties entailed. Indeed, for any derogation, the burden of proof rests with the party invoking the exception; in this instance, it is the copier – although it is the author who is best positioned to know if their work was lawfully disclosed. Keeping the burden of proof on the copier, whose interests will always lie in invoking the exception, could ultimately neutralize the effect sought. In the present case, the court followed this judicial line of thinking and thus strayed from the legislators’ intent.

In many provisions on copyright, the benefit of the private-copy exception is conditioned on strictly private use of the copies. While distinguishing *personal and private use* might appear simple, it is an elastic concept in judicial practice.

In literal terms, personal use is the opposite of collective use and it is not for profit. Private use encompasses the copier’s personal needs and those they might have in carrying out their work. The classic example is a student who copies a document or has it copied for the purposes of their studies or personal research.

82 See ABR-1999, art. 10(2) of annex VII, which provides: “Notwithstanding the provisions of article 8, and subject to those of para. 2 of this article and those of article 58, it shall be permitted, without the consent of the author and without payment of remuneration, to reproduce a lawfully published work exclusively for the private use of the user.” See also art. 29(1)(c) of Cameroon’s Law No. 2000/11 of December 19, 2000, on copyright and related rights: “When the work has been published with the author’s consent, the author cannot prohibit ...”

83 A. Singh and T. Debiessé (2007) *Droit d’auteur, copie privée et responsabilité pénale. Les cahiers de la propriété intellectuelle*, 19(1), 355.

84 See *MP and SCPP v. Mr. D.T.*, Judgment of November 15, 2005, TGI de Bayonne. In stating its grounds, the trial court reasoned that “conversely, in storing musical extracts on his computer’s hard disk or recording them on CD-ROM, the defendant merely exercised his right to make a copy for personal use and must therefore be acquitted.”

Taking the situation into business, the idea of private use for internal purposes has been evoked to exonerate reproduction and circulation of copies within a company for purposes only of information and documentation. “Company” in this context is meant in the broadest sense. It could include public and private enterprises, persons performing an independent activity for profit irrespective of legal form (such as public establishments, limited liability companies, associations or independent merchants) and other groups of persons, even if not legally established and structured (such as advocacy and interest groups). The waiver in this case is restricted to the purposes of internal information and documentation, which is clearly not the same as reproduction and distribution to customers.

In the present case, the chair of the board of AERIA reproduced the plaintiff’s painting without authorization, using greeting cards as a medium, and then distributed the reproductions to airport customers free of charge. Sweeping aside the private-copy exception argued, the Commercial Court construed the “strictly private” use of copies in a narrow sense, holding that “such reproduction goes well beyond private copying because it constitutes collective use, in that copies of the work were sent via greeting cards to persons other than Mr. Simplicé De Messe Zinsou.”

Lastly, the conditions for the exception are not limited to lawfulness of the source and personal and private use: a *three-step test* is also required. Although the judge did not explicitly say so in the present case, the use of copies within a company is not always collective. Private use must also be understood as any use not infringing normal exploitation of the work or unjustifiably prejudicing copyright holders. According to the key provision framing exceptions under the Berne Convention, copies used within a company are deemed to be for private use if they pass a three-step test. Under article 9(2) of the Convention: “It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.”

To pass the first step in this test, the exception must represent a special case and be clearly defined. Article 31 of Côte d’Ivoire’s Law No. 96-564 of July 25, 1996, on the protection of intellectual works and the rights of authors, performers and producers of phonograms and videograms, provides: “When the work has been lawfully made available to the public, the author may not prohibit ... reproductions, translations and adaptations intended for strictly personal and private use, and not for collective use, with the exception of works of art.” At this first level, that the copies made by AERIA of the painting work fail the triple test.

The second step in the test is that, to be excepted, the reproduction activity must not conflict with normal

exploitation of the work.⁸⁵ According to Senftleben, “conflicts with normal exploitation occur when authors are deprived of an actual or potential source of income of considerable importance in the markets for works of this category.” For paintings, the normal means of exploitation are exhibition and sale to the public. Viewed in terms of compatibility with the general regime of copyright exceptions, digital reproduction of a painting – even if solely for private purposes and worse still if done on a large scale – does indeed conflict with these means of exploitation. The copies made by AERIA failed this step.

To meet the final step in the test, the reproduction activity must not unreasonably prejudice the right holders. This step consists of gauging the proportional benefit of allowing the exception in the context of preserving the author’s interests.⁸⁶ Ultimately, the exception will be considered illegitimate under the test only if the prejudice is unjustified and disproportionate.

Enshrined in article 10(2)(vi) of annex VII to ABR-2015, application of the three-step test is a practical necessity for judges considering copyright cases. This mechanism for framing copyright waivers would clearly not have allowed the private-copy exception that AERIA argued to justify its digital reproduction of Mr. Bamogo’s work. The judge’s denial of the waiver for reproduction therefore made good sense.

Aristide Fade

J. Copyright – Permission to exploit issued by the national collective rights management organization – Online exploitation of works from the repertoire of a sister company – Individual action by the author – Admissibility – No unlawful exploitation

The legal action filed by a Malian author and member of SACEM against a user authorized by the national copyright office, the Copyright Office of Burkina Faso (Bureau Burkinabè du droit d’auteur, or BBDA), to exploit the author’s works online was admissible; the exploitation impugned, however, was not unlawful, since it was covered by the authorization.

SALIF KEITA V. AIRTEL BURKINA FASO, SA AND ORS,
Judgment No. 607 of December 5, 2012, High Court
of Ouagadougou

Observations:

The carefully drafted judgment discussed in this case is an opportunity to examine how individual and collective copyright management are interrelated.

85 M. Senftleben (2004) *Copyright, Limitations and the Three-Step Test: An Analysis of the Three-Step Test in International and EC Copyright Law* (Information Law Series). The Hague: Kluwer Law International, 43 et seq.

86 E. De Cock (2015/16) *Les exceptions au droit d’auteur: problématiques liées à l’exception de copie privée*. Masters thesis, Université Catholique de Louvain, 33.

Facts: World-famous Malian singer and musician Salif Keita, during a visit to Burkina Faso, learned that some of his works were being used in the country by company Airtel Burkina Faso (Airtel), through a paid upload service called *Mam’zik*. An amicable negotiation seemed in store until Airtel, shifting its stance, disputed the artist’s claims, arguing that the company’s use of the musical works was founded in its partnership agreement with the company Mobile Services Burkina Faso (Mobile Services), which had acquired rights to the works from the national copyright office, the BBDA. Sued before the High Court of Ouagadougou for CFAF 200 million in compensation, Airtel in turn sought compulsory intervention in the case by Mobile Services and the BBDA.

Reasoning: The court denied a motion to dismiss the case for lack of standing (section I), but ruled against the plaintiff on the merits, reasoning that the authorization issued by the BBDA was sufficient to justify the defendant company’s conduct (section II).

I. The plaintiff’s standing

The defendants contested Salif Keita’s standing to bring the suit, arguing as follows. The plaintiff artist was a member of SACEM, a French collective rights management organization. In 1987, the BBDA had signed a reciprocal representation agreement with SACEM (and with the Société pour l’administration du droit de reproduction mécanique des auteurs, compositeurs, éditeurs, réalisateurs et doubleurs sous-titres, or SDRM, for the mechanical reproduction rights), the terms of which entrusted the BBDA with managing SACEM’s repertoire in Burkina Faso. Therefore, they argued, only the BBDA and SACEM (or the SDRM) had standing to act on behalf of the artist.

The argument is not exactly unambiguous. If the BBDA has been entrusted with managing Salif Keita’s rights in Burkina Faso, then the BBDA alone – and not SACEM – should have standing to assert his rights in court. The argument no doubt stems from a clause in the 1987 contract, invoked in the BBDA’s written submissions and cited in the judgment, that only SACEM “has standing to bring legal action as necessary to protect Salif Keita’s rights.”

Be that as it may, the court dismissed the argument, on the basis of article 96 of Burkina Faso’s Law No. 32-99/AN. That article provides that arrangements entrusting a professional body with collective management of copyright and related rights “are without prejudice to the standing of authors, holders of related rights and their successors to directly exercise the rights conferred on them by this law.” Based on that provision, the court concluded that, “as artist and right holder, Salif Keita had standing, concurrently with the organizations cited above (BBDA, SACEM and SDRM), to bring legal action in defense of his interests.”

Nothing need be reiterated about the rejection of the motion to dismiss, which was required under the letter of local copyright law. It can be added, however,

that article 69 of annex VII to the Bangui Agreement supports this view: having attributed to collective rights management organizations the mission of “protection, exploitation and management of the rights of authors of works and holders of related rights,” article 69 stipulates that such arrangements “shall in no event prejudice the faculty enjoyed by the authors of works and their successors in title, and by the holders of related rights, to assert the rights afforded them by this annex.”

The only reservation – albeit a considerable one – relates to the idea of concurrent standing arranged between author and collective rights management organization(s) (more than one such organization in this case, since the court, without explanation, proceeded as though both the BBDA and SACEM had standing). In this case, however, there was no true concurrence, since the advertiser’s conduct was justified by the BBDA’s authorization alone. It would thus have been useful to better delineate the interface between individual and collective rights management – a job, of course, for the legislator. The approach taken in the French courts, for instance,⁸⁷ in deciding that the infringement of rights entrusted to a collective rights management organization is not a legitimate basis for individual action by the author or holder of a related right unless the organization demonstrably fails to act itself or, alternatively, unless (as the BBDA advanced in this case) allowance is made in assigning preferred standing to the collective rights management organization for individual action only against “a defendant exploiting works clandestinely, without any prior authorization and without the knowledge of the organization entrusted with protecting the works.”

II. Exonerating effect of the authorization issued by the BBDA

On the merits, the court ruled in favor of the defendants, finding Airtel not at fault, having acted in agreement with a partner authorized by the BBDA to exploit the works at issue.

The court reasoned that, under articles 95 and 96 of Law No. 32-99/AN, “it is part of [the] BBDA’s mission to ensure the protection of literary and artistic works by authors who are nationals of the country, as well as foreign nationals, and receive requests for authorization to exploit the works it protects.” The court then analyzed the agreements concluded among the three defendants.

It referred first to a “general contract for the exploitation of protected works” under which the BBDA gave Airtel “prior authorization under articles 95 and 96 ... to make public use, or to arrange for or allow such use, of the protected works in its repertoire and the repertoires of organizations having designated it as agent under the Berne Convention.” The court clarified that this

authorization “covers the communication of protected works to the public, via landline and mobile telephone networks, by internet and for advertising campaigns by the user,” for which the user commits to paying royalties.

Airtel, for its part, entered into a partnership agreement with Mobile Services under which the latter committed to providing musical works to Airtel and to “obtaining” the intellectual property rights attached to such works from the BBDA, stipulating that no literary or artistic property rights were thereby “assigned.”

The BBDA, finally, had its own “general contract for the exploitation of protected works” with Mobile Services, which was authorized to exploit the repertoire of the collective rights management organization itself and the repertoires of other organizations it represented “in accordance with the Berne Convention and reciprocal representation agreements.”

The court concluded from the facts in the case that “[the] BBDA assigned its rights in respect of Salif Keita,” and that the BBDA had authorized both Airtel and Mobile Services to exploit the works of the plaintiff, whose claim was therefore denied.

We can ignore the court’s slip of the pen in concluding that, “in any event, Airtel’s exploitation of Salif Keita’s works could not be unlawful” (emphasis added). It would have been more appropriate to write “therefore” instead of “in any event,” for it is only on the very solid grounds cited in the judgment that the claim was denied and the reasoning itself is quite compelling. It is correct that the BBDA was empowered by its reciprocal representation agreement with SACEM⁸⁸ to authorize the exploitation of works by the plaintiff, provided that the scope of such authorization did not exceed what SACEM itself could authorize (a premise not in dispute), on the principle that a company could not confer greater powers on a sister company than it had itself.

To counter that line of argument, Salif Keita contended that the authorization given to Airtel covered public performance only – a form of exploitation distinct from communication to the public and thus beyond “the scope of the contract as defined by its object.” This objection, unanswered by the judgment, does not withstand scrutiny. For certain works (especially musical), public performance has been the traditional means of communication to the public and so should not be seen as a distinct form of exploitation.

Another, more troublesome, objection, likewise disregarded by the court, concerns an express provision in the contract between the BBDA and Mobile Services that the rights conferred were “not transferable without written agreement from [the] BBDA.” The plaintiff argued that authorization consequently could not

87 Cass. 1ère civ., November 13, 2014, No. 13-22.401, *Bull. civ.* 2014, I, No. 187, *Comm. com. électr.* 2015, comm. 2 (note C. Caron), D. 2015, 410 (note A. Étienney-de Sainte Marie), *Propri. intell.* 2015, 64 (obs. J.-M. Bruguière), *RTD com.* 2015, 291 (obs. F. Pollaud-Dulian).

88 Not “by the Berne Convention,” which is silent on the subject of collective management and is relevant here only in that it obliges the Union states to guarantee national treatment, i.e. the same for foreign as for domestic, in accordance with art. 5(1), expressly cited in this regard by the Malian author.

have been transmitted to Airtel. The two defendant companies tried to challenge this reasoning by recalling that clause 9 of their partnership agreement disallowed any “assignment of intellectual property rights.” But that reasoning did not alter the fact that the BBDA conferred the authorization only on Mobile Services, which did not have the right to transmit it to Airtel. It does not appear, however, that Airtel engaged in unlawful exploitation: according to the facts, it had received authorization itself from the BBDA to draw from its own repertoire and the repertoires of the BBDA’s sister companies. What is truly surprising is that it was considered necessary under these conditions to assign to Mobile Services the obligation to obtain from the BBDA the “intellectual property rights for the musical works it furnishes to Airtel.”

It is understandable that a successful author might be frustrated to find themselves earning much less in royalties from collective management of their rights than they could through individual negotiation. But that is the inevitable consequence of joining such an organization, which also has its advantages.

André Lucas

K. Digital reproduction of a literary and artistic work – Authorization from the author – Lack of authorization – Infringement

Digital reproduction of a literary and artistic work – a book, in this case – followed by internet posting with free uploads, without the author’s authorization, constitutes infringement under article 142 of Senegal’s Law No. 2008-09 of January 25, 2008, on copyright and related rights.

MP AND ABDOULAYE AZIZ V. MAMADOU AND SERIGNE, Judgment No. 1061/2015 of November 26, 2015, Special Regional Court of Dakar

Observations:

On August 14, 1996, the Paris High Court rendered an interim judgment in a case between successors to the artist Jacques Brel and university students who had digitized his works without the successors’ authorization.⁸⁹ According to the judge reviewing the request for interim measures: “In respect of musical works protected by copyright, any digital reproduction of such works suitable for transmission to individuals connected to the internet must be expressly authorized by the copyright holders or assignees.” The applicability of copyright to networks and the internet is now beyond doubt, even where difficulties result. French legislators enshrined this rule in the country’s Intellectual Property Code. European Union authorities clearly included it in Directive No. 2001/29/CE of May 22, 2001, regarding certain aspects of copyright in an information society.

That provision was directly in line with the agreed statement of the diplomatic conference that adopted the WIPO Copyright Treaty, on December 20, 1996. Article 1(4) of that statement provides that “the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of article 9 of the Berne Convention.” Nearly all the laws on copyright and related rights in signatory countries of the Bangui Agreement apply to the internet, including Senegal’s Law No. 2008-09 of January 25, 2008, on copyright and related rights, article 33 of which is referred to in the judgment discussed here. This shows that classic legal copyright provisions remain pertinent as new communication technologies emerge, even if certain adaptations might be considered necessary.

Facts: According to the facts of the case, after publication in two volumes of his work entitled *Pour l’honneur de la gendarmerie sénégalaise*, Colonel Abdoulaye Aziz Ndaw learned that the internet sites Actunet.sn and Assirou.net were offering free uploads of his work for internet users, thereby depriving him of substantial potential income: owing to the fraud alleged, the work’s publisher had been able to sell only a few copies. This senior officer of the Senegalese Gendarmerie obtained a bailiff’s official report attesting to these facts, and brought action against Mamadou Mouth Bane and Serigne Fadel Mbacke, managers of the two sites, respectively, under *in flagrante delicto* proceedings, before the Dakar Special Regional Court for offenses and infringement of exploitation rights punishable under article 142 of Law No. 2008-09.

Reasoning: The court found the defendants culpable under both civil and penal law (section II) for having infringed the author’s copyright to the work on the internet (section I).

I. Infringement of copyright via internet

According to the facts in the case, the following message appeared on two sites serving as vehicles for counterfeited works on the web: “[Assirou.net and Actu.net] offer you two works by Colonel Ndaw. Thank you for downloading.” We will examine the acts committed in the case relative to copyright law in Senegal (A) and criminal intent, which can easily be inferred from the absence of authorization from the copyright holder (B).

A. The infringements

The defendants were charged with infringing exploitation rights. Under article 33(1) of Law No. 2008-09, “the author shall enjoy the exclusive right to exploit his work in any form and to derive monetary profit therefrom.” Article 33(2) goes further: “The author’s right of exploitation shall include the right of communication to the public, the right of reproduction, the right of distribution and the right of rental.” Since the right of rental does not enter into this case, only the first three of these rights will be discussed here.

1. Infringement of the right of reproduction
Article 35(1) of Law No. 2008-09 defines reproduction as

⁸⁹ See TGI Paris, August 14, 1996, *JCP G*. 1996, II, No. 22727 (note E. Oliver and F. Barbey).

“fixation of the work, by any means, in a physical form that allows it to be communicated to the public.” This definition is holistic, encompassing all reproduction means and techniques developed through technological innovation, including digitization. This holistic, as opposed to enumerated, approach allows an unlimited number of acts to come under the legislative provisions. It is the approach taken in the French Intellectual Property Code, from which the Senegalese law is derived. Article L.122(3) of the French Code provides a non-exhaustive list: “Reproduction shall consist in the physical fixation of a work by any process permitting it to be communicated to the public in an indirect way. It may be carried out in particular by printing, drawing, engraving, photography, casting and all processes of the graphical and plastic arts, mechanical, cinematographic or magnetic recording.” This means that fixation of the work *Pour l’honneur de la gendarmerie sénégalaise* in digital form on a digital medium constitutes a reproduction for purposes of the referenced copyright law. The reasoning for the Parisian decision mentioned earlier puts it very well: “Any digital reproduction of musical works protected by copyright, reproduced in a form suitable for transmission to persons connected to the internet, must be expressly authorized by the holders or assignees of the copyright.” Extensive case law, particularly in France, has followed in this direction, now irreversible.⁹⁰ It is no longer disputed that digital storage of a work falls within the legal meaning of reproduction. It still must be clarified – although the decision discussed here does not explicitly raise the issue – what kind of fixation to consider, inasmuch as digitization, compression or transmission of a work entail several types of fixation and therefore of reproduction. One example is a work copied by a routing computer,⁹¹ or on the random access memory (RAM) of a user’s computer.⁹² It is also the case in what are called cached, or buffering, copies.⁹³ It is beyond doubt that Law No. 2008-09, referred to in the decision reported here, is intended in theory to govern these different forms of reproduction. In practice, however, the protection is artificial, since the only purpose of such essentially technical copies, with no economic value of their own, is to permit circulation of the works on digital networks.

It is suggested in the literature that we take account of the human dimension of transmission in identifying acts of reproduction that bear on copyright.⁹⁴ A muffled echo of that concern can be detected in the laws of

90 See CA Paris, Référence, May 5, 1997, *JCP G* 1997, II, No. 22906 (note E.T. Olivier); T. com. Nanterre, Ninth Chamber, January 27, 1998, *JCP E* 1998, 850 (obs. M. Vivant and C. Le Stanc); TGI Strasbourg, February 3, 1998, *JCP G* 1998, II, No. 10044 (note E. Derieux).

91 Or router, an intermediating device that routes packets between separate networks.

92 A user’s personal computer can temporarily copy information received online instead of reconnecting to the network for each consultation. Doctrine concurs with case law in excluding such acts from the scope of legal protection.

93 Computer servers act as an interface between the supplier and the internet. They often copy frequently visited sites to obviate connection each time to the original site. From a practical standpoint, cached copies enhance the flow of traffic, generating real bandwidth economies.

94 See M. Vivant (ed.) (2004) *Droit de l’informatique et des réseaux*. Paris: Edition Lamy, 1331, No. 2278. The authors argue that the focus should be on physical fixations for communication to human beings, not merely technical fixations.

some African countries – on copyright, in particular – that raise technical copies to the rank of exceptions to copyright for an author’s work produced on the internet.⁹⁵ As currently worded, the Senegalese law does not specify any exception for technical reproductions, which is problematic for determination of the liability of technical intermediaries.

2. Infringement of the right of communication to the public According to article 34(1) of Law No. 2008-09:

“[T]he author shall have the exclusive right to authorize the communication to the public of their work by any means, including broadcasting, distribution by cable or satellite or provision on demand, in such a way that members of the public may access the work from a place and at a time individually chosen by them, and, in the case of graphic or three-dimensional works, by means of exhibiting the physical object.”

It is clear from this provision that the site operators for Assirou.net and Actu.net made both volumes of Colonel Ndaw’s work available to internet users, allowing each visitor free access to it from anywhere on the planet. The concept of “the public” poses no particular difficulty here: it consists of all potential visitors to the sites offering the infringed work.

One of the recurring questions about internet communication not expressly addressed in the reported case concerns the possibility of holding criminally liable the author of a hyperlink that allows a user to access a website through a path different from that intended by its designer. Hyperlinks embedded in a web page are mechanisms permitting instant access to another web page, wherever situated in the network. Hyperlinks, which play a key role in the functioning of internet architecture, are often used by their creators to direct users to unlawful content. Is the creator of such a link – one that communicates a digitized work to the public – liable under article 34 of Law No. 2008-09? *A priori*, the creation of a hyperlink is not in itself an infringement of the right of communication to the public. Nothing, however, prevents recourse to common law rules on complicity if it is established that the hyperlink has been wrongfully used, particularly as a means to infringe.⁹⁶

3. Infringement of the right of distribution

Article 36 of Law No. 2008-09 provides: “The author shall have the exclusive right to authorize the distribution, through sale or other means, of physical copies of the author’s work.” The wording of the provision suggests that it does not apply to digital copies, which would also exclude online sales of or free access to protected works. This appears more a drafting problem than an expression of clear legislative intent to exclude online

95 Cf. art. 29 of Cameroon’s Law No. 2000/11 of December 19, 2000, on copyright and related rights; see also, in European law, art. 5(1) of Directive 2001/29/EC, of the European Parliament and of the Council of May 22, 2001, on the harmonization of certain aspects of copyright and related rights in the information society, OJ L 167/10.

96 See Vivant, n. 94, at 1333, No. 2281.

distribution from copyright protection, particularly given the rise in e-commerce and related infringement activity in African countries.

It is immaterial, moreover, whether the distribution is done for profit or free of charge. The work in this case was offered by the infringing sites as a free download, but the activity was nonetheless criminal. Examining the profit-making character of an offense, relating to the right of representation, the French Court of Cassation has affirmed that “actions for copyright infringement are not confined by any provision of law to cases where an author’s work has been represented for profit.”⁹⁷

The right of exploitation claimed by Colonel Ndaw for his work *Pour l’honneur de la gendarmerie sénégalaise* was affected in this case in three ways. The reasoning of the reported decision is regrettably inadequate, confined to enumerating the material elements of the infraction without really characterizing them. At any rate, to constitute the offense covered by article 144 of Law No. 2008-09 requires a moral element: the absence of authorization from the owner of the rights.

B. Absence of authorization from the right holder

The decision reported did not indicate whether the operators of the sites Assirou.net and Actunet.sn requested, let alone obtained, authorization from Colonel Ndaw before posting online and distributing the two volumes of his work. Yet, under articles 33 *et seq.* of Law No. 2008-09, reproduction, communication to the public, and distribution of a literary and artistic work, even by electronic means, must be authorized by the author of the work or their successors. The defendants’ failure to appear for the hearing, moreover, was symptomatic of the absence of an agreement formalizing such authorization, whether from the author himself or from the Senegalese Copyright Bureau (Bureau Sénégalais du droit d’auteur, or BSDA), if the author was affiliated with it.

II. Punishment for copyright infringement via the internet

Several actors enter into the process of digitizing and disseminating a literary and artistic work created on the web. It is therefore useful to define the circle of individuals who could be held criminally liable (A) and examine the matrix of sanctions applicable (B).

A. The perpetrators

The perpetrators include the operators of websites incorporating illegal content (1) and other implicated links in the chain for circulation of a work in the digital environment (2).

1. Website operators

According to the arguments put forward in this case, responsibility for the offense lay primarily with the website operators, who, in posting the content at issue online, could have anticipated that it came from another

source. Thus, third parties can incur criminal liability for illegally disseminating an infringed work online. According to the facts, Mamadou Mouth Bane and Serigne Fadel Mbacke were the operators of the websites Actunet.sn and Assirou.net, which served as vehicles for the content at issue. It was therefore entirely right from a legal point of view that they be found criminally liable for infringing the civil plaintiff’s right to exploit his work.

2. Other actors in the network

The possibility of holding liable the creators of hyperlinks permitting or facilitating access to a website containing such information was mentioned earlier. Such a scenario obviously entails complicity, as defined in the national Criminal Code. It is just as possible to envisage criminal liability for the access provider, whose main function is to connect subscribers with the sites or with other users. An access provider does not control content. As well expressed in the Broglie Report, “it opens a door but does not accommodate.”⁹⁸ In short, the access provider’s criminal liability may be incurred if proven that they personally committed the offense or took part in any way in doing so.

B. The sanctions matrix

The sanctions incurred by the offenders were both criminal (1) and civil (2).

Imprisonment and a fine are the criminal sanctions that can be imposed on the perpetrator of an infringement on the rights of authors of literary and artistic works. Under article 142 of Law No. 2008/09 of January 25, 2008, “infringement of the right of communication to the public, the right of reproduction, the right of distribution or the right of rental shall be punishable by a prison term of 6 months to 2 years and a fine of 1 million to 5 million CFA francs.” It is important to note that the law stipulates that the prison sentence should be combined with a fine. Yet, the judge sentenced the defendants to a suspended three-month prison term, thus shielding them from the fine, in violation of the aforementioned legal provision. In any event, this leniency by the judge seems to contradict the guidelines of OAPI legislation, which, in article 64(1) of annex VII of ABR-1999 according to which this decision was handed down, encourages a sufficiently dissuasive penalty against the perpetrators of acts infringing a protected right.

At any rate, in accordance with article 149, the judge also ordered the publication, at the expense of the convicted perpetrators, of the judgment in certain newspapers and on the websites under dispute.

2. Civil remedies

In the case commented on here, the court faced the question of how to assess the damages which the injured party can claim in the event of copyright infringement, as Colonel Ndaw requested CFAF 300 million in compensation. In Senegalese copyright law,

97 See Cass., April 1, 1882, S. 1882, I, 334.

98 See *Rapport du groupe de travail de l’Académie des sciences, sous la direction de Gabriel de Broglie*, July 2000, 46, <http://bbf.enssib.fr/consulter/bbf-2001-05-0155-00>.

assessment of prejudice is covered by article 52 of Law 2008-09, which states that “the plaintiff may claim compensation for all damage caused by an infringement of their rights, calculated on the basis of loss of earnings and moral damage and the profits unjustly obtained by the defendant. They may also claim payment of costs occasioned by the infringement, including legal costs.” In general, the burden of proof of the prejudice in all its forms lies with the plaintiff, who must present the relevant information to enable the judge to assess its reality and to quantify it.

After having considered that it had sufficient evidence, the court awarded CFAF 20 million in compensation for the material and moral damages that Colonel Ndaw suffered from the infringement of his right of exploitation on the websites Actunet.sn and Assirou.net. It is important, however, to question the relevance of the judge’s approach to the various types of damage remedied. The decision commented on here does not provide information making it possible to determine the separate amounts awarded for material and non-material damage respectively. Because these damages are different in nature, the decision is subject to censure by a higher court.

Max Lambert Ndéma Elongué

L. Copyright – Action for infringement – Plaintiff’s identity as author contested – Appeal to quash the decision – Distinction of law from fact

The plaintiff appealing an infringement case before the Supreme Court may not call back into question established facts based on which the trial court denied the plaintiff’s claim to authorship of the work allegedly infringed.

PAPE MALICK FALL V. SOCIÉTÉ DES CONSERVÉRIES ALIMENTAIRES DU SENEGAL (SOCAS), Judgment No. 60 of July 4, 2012, Supreme Court of Senegal

Observations:

The judgment of the Supreme Court of Senegal in this case illustrates the difficulty of distinguishing between law and fact – an essential, but slippery, distinction – to determine where a court called upon to quash a ruling may exercise its control.⁹⁹ The difficulty arises particularly in matters of literary and artistic property, in controlling, as in this case, such concepts as author and originality, where trial courts have wide discretion. Unfortunately, on some questions the language used in the case does not allow us to draw broader lessons.

Facts: Insofar as the facts can be reconstituted from the fragmentary information provided in the Supreme Court’s ruling, it appears that action for copyright infringement brought by one Pape Malick Fall, claiming authorship of a design depicting three tomatoes with

a red-and-gold striped background and the bust of a woman, against the company SOCAS, inventor of the industrial tomato in Senegal, which, according to the appellant, reproduced his design without his authorization on the packaging of one of its products.

After the Court of Appeal of Dakar denied his claim, the appellant addressed four pleas to the Supreme Court –:

- I. “false representation of the facts”;
- II. “inaccuracy of the grounds”;
- III. “contradiction in the grounds”; and
- IV. “violation of the law.”

The Supreme Court declared all four inadmissible.

I. “False representation of the facts”

The appellant first impugned the Dakar appeal court’s judgment for stating that he did:

“... not claim paternity of the character appearing on the packaging of the SOCAS product illustrated by three tomatoes with a red and gold background and the bust of a woman with the title *Signara*, this character having been added to – and inspired by the title of – his work, which had depicted the three tomatoes with the name *Signara* against a red and black striped background.”

That court’s wording here is unfortunate in two ways. First, it does not clearly explain the fault being alleged of the trial court but merely that the design on the packaging is not a slavish copy of the design claimed by the appellant (a circumstance that in no way precludes infringement).

Second, and more importantly, by using the expression “false representation of the facts,” that court disregarded the abiding principle that judicial control and the quashing of a decision must center on questions of law not of fact.

The Supreme Court’s response to this was praiseworthy, dismissing the ground by recalling – as is inarguably true – that “a grievance regarding false representation of facts is grounds for quashing a decision only if it pertains to a written document.” A good precedent here is a judgment by the French Court of Cassation, in a case where the appellant claimed “distortion of the parties’ intent.” The French court denied the argument as unfounded (not as inadmissible) on the grounds that “a grievance in respect of distortion may not relate to the interpretation of a material fact.”¹⁰⁰

II. “Inaccuracy of the grounds”

The second plea concerned the appeal court’s “decisive ground,” consisting of a letter written by the appellant saying that he had entitled his design “La tomate” and that the title “La signara” had been the defendant’s

99 D. Louis-Caporal (2014) La distinction du droit et du fait en droit judiciaire privé. Unpublished thesis, Montpellier University, No. 9.

100 Cass. soc., November 28, 2000, No. 98-41.377.

“idea,” whereas the plaintiff had demonstrated by means of two BSDA attestations that he himself had deposited a work entitled “La signara.” It is hard to understand, here again, how the title might dictate the solution.

At any rate, the Supreme Court dismissed the appellant’s second ground, which it said was “limited to criticizing the grounds of the impugned judgment.” That response is surprising, since criticizing a judgment’s grounds can be enough in itself to get the judgment quashed – if it is ultimately found, for instance, “insufficient” or “contradictory” (as argued in the appellant’s third plea). It would have sufficed, as it did for the first plea, to say that the appeal may not call back into question established facts relied on by the trial judge, whatever one might think of their probative value.

III. “Contradiction in the grounds”

The appellant’s third ground argued a contradiction in the appeal court’s grounds: “[A]fter referring to Pape Malick Fall as the creator of a work entitled *Signara*, depicting bunched tomatoes, and after saying the infringed work’s originality stemmed from the symbolism of the title,” the appeal court “denied” his identity as the work’s creator, “even though the SOCAS packaging indeed showed bunched tomatoes.”

The Supreme Court swept this objection aside: “The alleged contradiction bears not on the facts but on the legal consequences the appeal court drew from them.”

This logic is perplexing. In view of all the foregoing, it is difficult to understand how the Supreme Court could refuse to take up a criticism bearing on the “legal consequences” drawn by a lower court from a factual situation. Is it not traditionally said that a court called upon to quash a lower court’s ruling (the role being played here by the Supreme Court of Senegal) “judges the law”?¹⁰¹

In any case, in the absence of access to the contested judgment, the wording of the appeal on this point appears flagrant. To characterize a plaintiff as the “creator” of a work and to recognize the “originality” of that work is to acknowledge the plaintiff as its owner, particularly if the work is referred to as an “infringed” work. If the Court of Appeal of Dakar then denied such authorship, it must be regarded as having contradicted itself – and a decision’s contradictory grounds are recognized as grounds for quashing it.

IV. “Violation of the law”

In his last plea, the appellant alleged that the trial court had violated the law – specifically, article 118 of the Senegalese Code of Civil and Commercial Obligations (Code des Obligations Civiles et Commerciales, or COCC) – which it had wrongly declined to apply, “even though the fraudulent and profitable use by SOCAS of

the appellant’s work for commercial purposes represents unjust enrichment at Mr. Fall’s expense and constitutes an offense.” In addition, denial of the plaintiff’s plea for compensation after the latter had “substantiated the infringement of his rights and the damages caused to him by the quasi-criminal acts committed by SOCAS” violated article 9 of the Code. All the Supreme Court had to say on this point was that the appellant’s ground “based on this grievance calls back into question facts and evidence sovereignly considered by the lower court” and was thus inadmissible.

In our view, the appellant’s plea and the court’s response both raise doubts. Article 9 COCC provides that “a party demanding execution of an obligation must prove that it exists” and that “a party claiming to be free of an obligation must prove that it does not exist or is inoperative.” The article is thus concerned only with the burden of proof and would be relevant to this case only if the plaintiff had already established the existence of the defendant’s obligation, which was precisely the point at issue. As for article 118, it is unrelated to unjust enrichment, which is covered in articles 160 and 161.

However, contrary to what the Supreme Court affirmed, the plea concerning the violation of this article did not call sovereignly appraised facts back into question; rather, the argument was of an eminently legal nature. It would have been appropriate and also easy to answer it. The response could – perhaps should – have been as follows. Inasmuch as infringement has not been established, which is always the assumption we make at the outset, an action to establish civil liability can play a subsidiary role only if the plaintiff can substantiate a distinct offense. It is accepted that such actions, which often pertain to unfair competition, cannot serve to reconstitute an exclusive right to a creation that is not (or is no longer) protected.¹⁰² Such a distinct offense was not even alleged in this case; the appeal argued merely that criminal acts had “violated” the plaintiff’s rights, which implies infringement.

That leaves only the theory of unjust enrichment. Even admitting that the defendant enriched itself through commercial use of the work, the plaintiff can demonstrate corresponding impoverishment only by proving his authorship – a claim precisely rejected by the impugned judgment. Moreover, article 161 COCC provides that actions based on this theory (*quantum meruit*) “can be brought only in the absence of other legal recourse.” It is doubtful that this condition was met, since the main substance of the action was judged unfounded.

Overall, as it was worded, the appellant’s request to quash the impugned judgment was not destined to succeed; the court’s denial, however, could have been better argued.

André Lucas

101 J.F. Weber (2011) *Cour de cassation*, 2nd edn. Paris: La documentation française, 9.

102 See, in the case of French law, Cass. req., November 29, 1943, *Ann. propr. ind.* 1940/48, 339; Cass. com., January 24, 1972, No. 70-11.878, *Bull. civ.* 1972, IV, No. 27.

M. Copyright – Counterfeit seizure – Provincial committee to combat piracy – Irregular composition of the committee – No identification of the seizure applicant and no objects seized – Recourse to OHADA law on seizures – No application of the law on cinematographic works – Competent jurisdiction – Judge for urgent applications

The seizure of counterfeit goods in no way constitutes an administrative sanction; it can be carried out only if authorized by the competent judge. In addition, the record of any such authorization must include all of the information necessary to identify the applicant for seizure and the assets to be seized. Where an applicant has failed to meet those requirements, a seizure is grounds for action before the judge for urgent applications.

SADJO MABI V. COMITÉ PROVINCIAL DE LUTTE CONTRE LA PIRATERIE (PROVINCIAL COMMITTEE TO COMBAT PIRACY), Interim order No. 17/R of September 21, 2005, High Court of Garoua

Observations:

Interim order No. 17/R, issued on September 21, 2005, by the president of the High Court of Garoua, perfectly illustrates the difficulties actors concerned with copyright must overcome in Cameroon, specifically, and in OAPI countries generally.

Facts: The facts in the case are relatively banal. On July 13, 2005, Mr. Sadjo Mabi, a vendor of phonographic and videographic media, was subjected to a seizure carried out on the initiative of the Provincial Committee to Combat Piracy of the North Region in Cameroon. Considering the seizure unwarranted, Mr. Mabi took action before the judge for urgent applications to obtain release of the object seized. He based his claim on three grounds:

- that the committee was not legally formed as prescribed by the decision creating the National Committee to Combat Piracy (Decision No. 2/48/MINCULT/CAB of November 11, 2002), signed by the Minister of Culture of Cameroon, which prescribes the procedures for creating and operating the provincial committees;
- that the seizure was procedurally null for lack of prior authorization from the High Court's president; and
- two arguments concerning the seizure operations themselves – namely, that the seizure report did not list in detail the objects placed in judicial custody and that references in the writ to those persons who were to carry out the seizure were uncertain.

Reasoning: In its defense, the Provincial Committee began by arguing against the competence in this matter of the judge for urgent applications, based on the substantive damage its interim order would cause and on the administrative character of the order designating

the committee's members, Order No. 1174/AP/D/SG/ASD of November 29, 2004, issued by the governor of the North Region of Cameroon. The Provincial Committee next invoked the fact that Mr. Sadjo did not have an authorization to exploit the works of their minds, citing in support of that argument legislation on the exploitation of cinematographic works. It argued that a seizure therefore constitutes an administrative sanction against an alleged infringer.

The plaintiff for the urgent application naturally disputed these arguments, countering that, under article 87 of Cameroon's Law No. 2000-11 of December 19, 2000, on copyright and related rights, the seizure applicants should have gone to the competent trial court, under penalty of release of the objects seized.

What is clear in this situation, which may be a consequence of error or confusion, is that in no case could this seizure constitute an administrative sanction, which the Provincial Committee had no power to impose in the stead of state authorities; rather, what it constituted was counterfeit seizure. The involvement in the seizure of an institution created by the Minister of Culture to combat infringement, the Provincial Committee to Combat Piracy, and the placement in judicial custody of cassettes and CDs belonging to Mr. Mabi, on July 13, 2005, thus raise two legal questions that the judge for urgent applications should have settled:

- I. the legality of the counterfeit seizure (section I); and
- II. jurisdictional competence for counterfeit seizure procedures (section II).

I. Legality of the counterfeit seizure

Beyond the legislation pertaining specifically to copyright, the legality of a seizure may be subject to common law procedures for counterfeit seizure as such. This is particularly the case in areas where the legislation on such procedures is incomplete or silent, including the content of a seizure report. The legislation that appears to apply here is the OHADA Uniform Act Organizing Simplified Recovery Procedures and Measures of Execution, the only legislation applicable in OAPI countries to civil execution procedures. The Uniform Act requires any persons conducting a seizure to clearly identify themselves and to specify in detail the objects being seized (A).

Settling the question about the legality of counterfeit seizure means first identifying the national law under which it was carried out (B).

A. Identification of the seizure applicant and the objects seized

No express provision in the Bangui Agreement or in national law on copyright and related rights requires, as a general condition, identification of the applicant for counterfeit seizure. But such identification, as the Garoua judge for urgent applications recalled, is a general principle that certainly applied in this case. That

principle is basic for any jurist: it is important for the distrainee (i.e., the party targeted for seizure), or affected third parties, to be able to identify who has initiated the procedure, so that they may organize their defense.

This observer naturally turned to the common law, as derived from the Uniform Act, as an increasingly accepted means to fill the many legislative gaps in respect of seizures in intellectual property matters.¹⁰³ Yet case law is lucid in its rejection of recourse to the Uniform Act when the solution can be found instead in special legislation on counterfeit seizure in national copyright laws or in the annexes to the Bangui Agreement for industrial property. That much is made clear in *Société Bic SA v. Société TBC S.*, in which case the court rejected the competence of the enforcement judge indicated in article 49 of the Uniform Act.¹⁰⁴ That case is also an opportunity to see how the common law applicable to counterfeit seizures can have national origin when the Special Law on Intellectual Property and the Uniform Act are silent on the subject of execution measures. Indeed, in *Bic SA*, the judge affirmed that:

“[I]nsofar as the OHADA Treaty does not regulate counterfeit seizures, those procedures remain subject to the provisions of common law; ... only the judge for urgent applications, in the classic sense of article 182 of the Code of Civil and Commercial Procedure, is competent to take urgent cognizance of difficulties with the seizures in question; ... the judge for urgent applications should therefore be declared competent.”

The solution is laudable, even though it adds complexity to a deceptively simple matter.¹⁰⁵

In this case, the Uniform Act reinforces the obligation for the seizure applicant to identify themselves. According to article 64(2) of the regional text, to be valid, a precautionary seizure report must include “the first and last names and address of the distrainee and of the seizure applicant.” Articles 77(1) and 100(1) refer to the same obligation and the same sanction in the case of debt garnishment, and the seizure and sale of movable property, respectively.

Was it worthwhile under these conditions for the defendant to invoke the specific provisions of the Criminal Code then in force in Cameroon? It is this observer’s opinion that it was not, for at least two reasons. On the one hand, article 37 of the Code, which refers expressly to seizures in conjunction with a criminal offense, concerns those conducted in “the defendant’s domicile.” Counterfeit seizure, dealing with counterfeit items and counterfeiting equipment, generally happens in the place where the counterfeiter conducts the criminal activity, which is not necessarily their domicile.

103 See, concerning seizure of a mark, *Rothmans of Pall Mall Ltd SA v. Société Adil Co. and El Hadj SS*, Judgment No. 118 of May 20, 2008, High Court of Niamey (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section S).

104 *Bic SA v. TBC SA*, Decision No. 28 of January 28, 2008, Court of Appeal of Littoral (Douala) (obs. M.L. Ndéma Elongué, this collection, Chapter 1, section F).

105 See also *ibid.*

Whether counterfeit seizure is a civil measure or not, it is clear that the competent jurisdiction for recourse against the seizure is the judge for urgent applications.¹⁰⁶ Following that logic, there is no need to invoke the Code in cases where the seizure applicant meets the other conditions for a counterfeit seizure.

In any case, the seizure applicant was well known, having clearly identified itself as the Provincial Committee to Combat Piracy. The only problem was its standing, the defendant having claimed that the individuals concerned were not the persons specified as comprising the committee. But that single ground could have invalidated the seizure only if the validity of the administrative act designating them had been challenged. As the judge for urgent applications recalled, that was far from the subject at issue.

On the other hand, in failing to identify in detail the objects seized, the committee made certain that the seizure would be invalidated. The question nonetheless arises as to which legislation is applicable to ground that invalidation. Every applicable provision of the Uniform Act cited above amplifies that, to be valid, a seizure report must include a detailed list of the objects seized (see especially article 64(4)).

In any case, the same result could be achieved by invoking general principles of law. It is clear that any report not including such essential elements would not be serving its intended purpose; the quasi-nullification theory could then be applied. It must therefore be affirmed that the ministerial or judicial police officer had an obligation to indicate the precise number of phonograms and videograms seized and to list them in detail, by artist, by title or by collection, so as to provide a legible, detailed and exhaustive inventory precluding all doubt.

In any event, the lack of detail concerning the objects seized was not the only ground for invalidating the procedure; the committee also undermined its validity by invoking false legal premises.

B. Identification of applicable law

It may seem incongruous to open a debate on identification of the legislation applicable to counterfeit seizure. A person seizing works of the mind would not normally be expected to justify doing so by invoking legislation other than that governing copyright. But that is what happened in this case. The attorney for the Provincial Committee to Combat Piracy argued that “the distribution through sale, rental, exploitation or importation of a work of the mind is subject to prior authorization as required by Decree No. 90/1463 of November 9, 1990, and by Law No. 88/17 of December 16, 1990,” and that, failing such authorization, the infringing party was subject to administrative

106 See *infra*. Overall, apart from interventions by the public prosecutor and the judicial police, these are the civil authorities who carry out counterfeit seizure. That is the case in particular of the High Court president, acting as a motion judge in virtually all seizures prior to civil trials.

sanctions. This was a clumsy and confusing attempt to generalize rules specifically applicable to the exploitation of audiovisual works so that they would encompass all works of the mind. Fortunately, the Garoua judge for urgent applications astutely distinguished one law from the other. The only thing to add would be that cinematographic works are subject both to copyright legislation, where the exploitation of rights is concerned, and to the legislation on government use of such works.

It is this latter legislation, regarding government use, to which the committee's attorney refers. Authorizations under that legislation are issued after considering the conditions under which the works will be used, but without regard to copyright protection (the concern being about public safety – cf. article 13 *et seq.* of the 1988 Law). Copyright legislation has a different purpose: its scope does not include the administrative conditions for exploitation; it pertains only – as the judge for urgent applications noted – to relationships between copyright holders and licensees. Thus it can provide no basis for administrative sanctions, just as laws on administrative matters provide no basis for seizures in copyright infringement cases. In those cases, the use of a work is punishable because the copyright owner – as opposed to the government – has not authorized it. Moreover, given the mode of exploitation, it follows that the seizure applicants should have exercised greater caution. The exploitation of works through representation is governed exclusively by the Special Law on the Exploitation of Cinematographic Works. The objects seized in this case were illegal copies, constituting exploitative reproduction.

All of this illustrates the need for actors concerned with copyright to raise awareness about intellectual property in Cameroon and, by extension, in OAPI countries generally. For it is clearly lack of awareness on that subject that explains, at least in part, the confusion and errors in this case. Limited awareness might also underpin the debate over the competence of judges for urgent applications.

II. Jurisdictional competence for counterfeit seizure

The question of jurisdictional competence for counterfeit seizure was another central issue in these proceedings. It is therefore worth examining the general rules applicable to jurisdictional competence (A). In this case, the application of those rules was disrupted by the involvement of the National Committee to Combat Piracy and its branches, the provincial committees (B).

A. General rules applicable to jurisdictional competence for counterfeit seizure

The question of jurisdiction for counterfeit seizure generally arises at two stages: upstream (before seizure), and downstream (after seizure).

Upstream, a court is asked to issue an authorization for the seizure. In that context, article 85(1) of the law of 2000 in Cameroon provides that, when their rights are infringed or threatened, copyright holders and their

successors in title may have recourse to a “competent judge” for authorization to seize forged copies, illegally imported copies and objects, and the equipment used or to be used for performance or reproduction.¹⁰⁷ The next paragraph, article 85(2), provides that “[t]he president of the civil court with jurisdiction” can also order or request particular measures, including seizures during non-business hours or the seizure of receipts. Overall, the law in Cameroon is needlessly convoluted on this point. It is indeed clear that a victim, or potential victim, of infringement, informed of the offense, or threatened offense, has every interest in acting as quickly as possible. The appropriate judge for such rapid recourse is the judge designated for urgent matters, who, in the case of Cameroon, is the president of the trial court, acting as motions judge. Accordingly, the judicial authorization referred to in article 85(1) could take no form other than an interim injunction – and practice confirms this interpretation.

Downstream, the judge competent for recourse against counterfeit seizure is the judge for urgent applications. On that point, the 2000 Law is relatively clear. After building suspense in article 86(1), referring simply to the “president of the court,” it lifts the veil in article 86(2), citing more specifically “[t]he president of the court ruling in chambers.” This judge can act only on petition by a distrainee or an interested third party, who must contest the seizure within 15 days of the date of the seizure report. According to article 85, the purpose of such proceedings is to limit the effects of the seizure or to authorize resumption of manufacture or performance either under the authority of an assignee or upon deposit of funds as security against any damages the copyright holder might eventually claim.

However, this part of the proceedings for counterfeit seizure, intended to minimize prejudice to the alleged infringer, requires first that the seizure be procedurally valid. In cases where the seizure is not judicially authorized, occurs during non-business hours or involves taking possession of receipts without special authorization from the trial court president – and this case falls into that category – such seizure is procedurally flawed and thus invalid. The jurisdiction competent in such a case is consistently recognized. The Garoua judge for urgent applications was therefore correct in asserting his competence for recourse against counterfeit seizure.

Yet here, again, that assertion was made on the wrong legal basis. It was argued that the seizure applicant must (and did not) submit the matter, within 15 days of the date of the seizure report, to the trial court president ruling in chambers.

This confusion may well arise from the same time limit being stipulated for both the distrainee and the seizure applicant in articles 86(1) and 87, respectively, and hence the two actions must be more clearly distinguished. The action referred to in article 86 is available to the

107 The law in Cameroon confers the power to authorize seizure on that “competent judge” and on the public prosecutor.

distrainee, or an affected third party, allowing them to contest the seizure before the judge ruling in chambers within 15 days of the date of the seizure report. Article 87 requires the seizure applicant to act within the same time limit to evidence the offense.¹⁰⁸ If the seizure applicant does not act within that time limit, the assets seized are released. Those two actions are different in every way: one is taken by the distrainee, or by an affected third party, before the judge for urgent applications; the other is taken by the seizure applicant before the competent trial judge.

B. Involvement of a state actor

With Decision No. 2/48/MINCULT/CAB of December 11, 2002 (as amended and supplemented by No. 4/56/CAB of July 27, 2004), the Minister of Culture of Cameroon established the National Committee to Combat Piracy of Works of the Mind in Cameroon. Article 5 of the Decision provides that a similarly named provincial committee should be established by order of each regional governor. Without doubt, the committee and its provincial branches were established as secular arms of the state to combat piracy. The objective is therefore laudable.

Yet the entry of this institution into the fight against piracy raises questions. The first concerns the Provincial Committee for the North Region. The governor of the North Region legally impaired that institution by giving it an irregular composition. Rather than appointing his jurisdiction's provincial delegate of culture as committee chair, as required by article 5 of the Decision, he took that power upon himself. Mr. Mabi, whose assets were seized in the case, logically deduced that the governor had created a committee other than that prescribed by ministerial decision. He therefore invoked its irregular composition to demand release of the seized objects.

In its defense, the committee contested several points, including the competence of the judge for urgent applications. It argued that the governor's order creating the Provincial Committee was an administrative act beyond that judge's competence. It is fortunate that the judge pierced through to the question of law to be addressed: not the regularity of the committee's composition, but simply the validity of the seizure obtained by that body. The first point would require the judge to focus on the administrative act creating the committee; the second, to determine only whether its acts were in accordance with the law of December 11, 2000. Framing the case in this way, the Garoua judge for urgent applications quite correctly asserted his competence.

It is also true, however, that the judge's task was easy once the seizure was found to be flawed. What would he have decided if the seizure had been valid? This question invites two more: first, can an irregularly composed committee conduct a valid seizure; and second, even if

regularly composed, did the Provincial Committee – and, by extension, the National Committee itself – have the standing to seize pirated works? Those questions are significant because several African countries have created similar bodies. Examples include Benin¹⁰⁹ and Côte d'Ivoire.¹¹⁰

Where the legislation is silent on this point, as in Cameroon and other countries, the two questions echo a debate in France on which of a collective work's authors can seek legal remedy in respect of such works. Just as the committee's irregular composition was an original flaw tainting all of its subsequent acts, so too is the ownership of copyright to a collective work claimed by one of its authors tainted by the impossibility of proving that other contributors have transferred their rights to that one author. The defendant might seek to take refuge behind the absence of such transfers to escape all liability. In one well-known case, for example, proof of the transfer of rights to a legal person exploiting a work, who then sued for infringement, was successfully raised as a defense before a French appeal court, which found that the plaintiff had not demonstrated such a transfer. Reviewing the appellate decision, the French Court of Cassation affirmed that, "in the absence of claims by one or more authors, exploitation of the work by a legal person, in that person's own name, creates the presumption, as far as third parties sued for infringement are concerned, that said person owned the rights to the author's incorporeal property."¹¹¹

This precedent, which established presumption of ownership linked to exploitation of a work, is regrettable for various reasons.¹¹² Indeed, on pure principle, to have standing for the infringement action, the original plaintiff (the defendant on appeal) needed to deliver proof of receiving the transfer of such rights. But, as the Court of Cassation held, such requirements encumber the proceedings to the infringer's advantage. This line of precedent in French case law can be justified only as an additional weapon against piracy. But the same narrow reasoning could be applied in a debate over whether the composition of a country's committee to combat piracy was valid. Its composition would then be beside the point: an offense was committed and must be punished. Though intellectually dissatisfying, the argument is perfectly defensible – for while it is normal for an infringer to dispute that infringement has occurred, attacking the composition of the body taking enforcement action seems little more than procedural artifice.

108 For the application of this rule in matters of trademark, see *Nazaire Gnanhoue v. Sola Co.*, Judgment No. 70/15 of March 4, 2015, Court of Appeal of Lomé (obs. M. Lamotte, this collection, Chapter 3, section I).

109 Decree No. 2005/187 of April 14, 2005, on the creation, powers and operation of the national committee to combat piracy of literary and artistic works.

110 Decree No. 2014-420 of July 9, 2014, on the powers, organization and operation of the national committee to combat piracy. There is little to dispute, however, where the laws expressly empower those committees to act (which is the case of the committee in Benin. Cf. art. 5 of Decree No. 2005/187, n. 115).

111 Cass. 1^{ère} civ., February 22, 2000, cited by P. Sirinelli, *Les bénéficiaires initiaux du droit d'auteur: règles générales. Lamy droit des médias et de la communication*, étude 118, No. 118-97.

112 See, on the question as a whole, Lucas, Lucas-Schloetter and Bernault, n. 39, Nos. 1193 *et seq.*

The same reasoning, it would seem, should apply to the standing of a national committee and its provincial branches. Infringers subjected to seizure could then argue that those committees lacked standing. From a strictly legal standpoint, such an argument might prosper. Copyright law in Cameroon indeed limits who has standing to act in defense of copyrights. The authors themselves are naturally included, as are the holders of related rights, their successors and assignees, as well as collective rights management organizations.¹¹³ Moreover, article 2 of the ministerial decision creating Cameroon's National Committee defines its mission as "taking every action to facilitate the fight against infringements of copyright and related rights, including awareness, information and training activities." That wording does not appear to authorize seizure.

Even if the reasoning shifts because a criminal offense is nonetheless concerned, the committee's actions must be considered illegal. The initiative to act in this case, after all, rested solely with the public prosecutor, with the victim and with certain government bodies. In that context, all seizures by such committees should be subject to invalidation. Their role should be confined, at the very most, to alerting the right holders, or obtaining the mandate to bring action themselves on behalf of the right holders or their collective rights management organizations. The representation of those organizations on the committees is immaterial in that context. While it legitimizes their activity, it does not legally empower them to seize assets unless mandated to do so by those who do have such power.

Piracy is an elusive offense, yet the outflow of illegally reproduced products is ubiquitous. Thus there is no time to lose while localizing such activity and hence it appears natural to permit a special committee created by the state to help to deter the offense, including through seizures if necessary. Success in combating this scourge will require acceptance of solutions that are less than intellectually tidy.

What matters for the infringer, after all – whether or not the person performing the seizure lacks the authority to do so, as alleged – is that the infringement be proven and that the seizure be conducted so as to preserve the infringer's rights ... "What does it matter if the cat is gray or black if it catches the mouse?" (Deng Xiao Ping).

Joseph Fometeu

N. Copyright – Action for infringement – Obligation of the trial judges to explicitly state the grounds for the sentence – Failure to reply to allegations of infringement of the right of authorship

The assignment of copyright does not deprive the author of a work of the right to be identified – that is, to mention

of their name on any of the media used by the assignee to communicate the work to the public. It is incumbent on the trial court to specify in its statement of grounds whether the assignee has respected this principle.

SONITEL V. THE KYBIA AGENCY, Judgment No. 15-040/ Civ of April 21, 2015, Supreme Court of Niger, Civil and Commercial Chamber

Observations:

This judgment issued by the Supreme Court of Niger on April 21, 2015, discussed already in this chapter from the standpoint of originality, calls for additional observations, this time raising concerns about the transfer of rights.

Facts: Recall that the Court of Appeal of Niamey had found the firm Société Nigérienne de Télécommunication (SONITEL) liable for its use in an advertising campaign of a photograph provided by the agency Iman but the rights to which belonged to the agency Kybia.

In its second plea on appeal to the Supreme Court, SONITEL criticized the appeal court's finding of liability "for violating the economic rights of others [sic – likely meaning 'of the author']," even though Kybia had assigned copyright to the photograph to SONITEL, which had paid for it, in accordance with article 31 of Ordinance No. 93-27 of March 30, 1993, in respect of copyright, related rights and folklore. SONITEL had thus, it argued, reasonably used the photograph "according to its usual marketing methods."

In response, Kybia invoked the moral right protected by article 8 of the Ordinance, arguing that no one could "deny it the right to claim authorship of the photograph that Iman had communicated to the public at the request of SONITEL without reference to the author on the reproductions."

Reasoning: The Supreme Court adopted the same reasoning as the Court of Appeal. It first affirmed that "while the principle of copyright assignment is admitted, it must not deprive the author of the right to systematic mention of the author's name on all media used by the assignee to communicate it to the public." It then went on to note that the trial judges, in their statement of grounds, had not specified "whether SONITEL, as intermediary for Iman, had respected this principle or not." The Supreme Court saw this as a violation of article 31 of the 1993 Ordinance.

The logic is perplexing. In addition to not considering whether such a moral right can be held only by the natural person who has authored the work (who had not entered into this litigation), the court seems to have overlooked key aspects of the case warranting examination. If Kybia had effectively invoked an infringement of its right of authorship and the Court of Appeal of Niamey had not ruled on the point that would represent a failure to respond to the plea in breach of the court's obligation to state the grounds for its decision, such that censure of its decision would be justified. As

113 Cf. art. 85(1).

described in the judgment, however, Kybia's appeal did not raise that issue; the appeal to the Supreme Court, as that court seems to forget, concerned only the infringement of economic rights, as found by the Court of Appeal and contested by SONITEL. The Supreme Court failed to respond to that point except to state baldly that "the principle of assigning copyright is admitted." It would have been helpful had the court, in either granting or rejecting the plea, taken a clear position on the matter.

To do so, it needed to decide on the applicable text. The court censured a violation of article 31 of the 1993 Ordinance N. 93-27 – but this is a mistake. The text of article 31 does not correspond at all with the language cited in court, which was reported as follows:

"Where a work is created on behalf of a natural or private or public legal person under a work contract of the author, or where the work is commissioned from the author by such person, the first owner of the economic and moral rights shall be the author. However, the economic rights in the work shall be deemed to have been transferred."

As indicated by its heading, article 31 of the Ordinance deals only with "Ownership of rights in works created under a work contract." It provides:

"[W]here a work is created on behalf of a natural or private or public legal person (hereinafter 'employer') under a work contract of the author, absent contrary provisions in the contract, or where the work is commissioned from the author by such person, the first owner of the economic and moral rights shall be the author. However, the economic rights in the work shall be deemed to have been transferred to the employer to the extent justified by the habitual activities of the employer at the time of the creation of the work."

The court's language, as transcribed, corresponds word for word to the start of article 31 of annex VII to ABR-1999 (appearing as article 35(2) in ABR-2015) – but only the start. The Bangui text goes on to say that the rights "are deemed to have been transferred to the employer [the wording in article 35(2) of ABR-2015 is more symmetrical, adding 'or of such natural or legal person'] to the extent justified by the habitual activities of the employer at the time of the creation of the work." It was therefore up to the Supreme Court to review the grounds stated by the first-instance court to determine whether the conditions for transferring the economic rights indicated by this text had been fulfilled.

We might even complicate the analysis further by examining whether the legislation of Niger – in referring to salaried employees only, thereby leaving to common law cases in which works are made on commission – would have offered better protection to the authors concerned. If so, the courts could have justified passing over the Bangui provision to apply national law and hence deny the plea.

As shown, there was meaningful matter for discussion here – an opportunity regrettably missed.

André Lucas

O. Payment of copyright royalties – Actual use of works – Condition for requiring payment – Capacity to disseminate the works

The public representation or performance of certain works of the mind, claimed to be part of the repertoire of a collective copyright management organization, is subject to the payment of royalties by users under conditions determined by regulation.

According to the regulatory body concerned, a mobile telephone company is subject to the payment of such royalties without the need to first determine that it has actually used the works concerned, with failure to pay constituting infringement.

SONITEL V. BNDA, Judgment No. 11-250-civ of December 1, 2011, State Court of Niger

Observations:

The modern means available for exploiting works of the mind are diverse, including cable, satellite and the internet. Public representation means "public exhibition" of a work – that is, the act of bringing it to public awareness through performance: by playing a song, performing a symphony, reciting a poem and so on.¹¹⁴ Whatever form they take, these diverse means of exhibiting an author's output permit authors to control exploitation of, and earn a living from, their creations. This makes it imperative to subject all such forms of representation to a monopoly, requiring the author's prior authorization for use of their creation. This, in broad strokes, is the substance of the judgment rendered by the State Court of Niger on December 1, 2011, in a case between Société Nigérienne de Télécommunication (SONITEL) and the national copyright bureau, the Bureau National de Droit d'Auteur (BNDA).

Facts: The dispute began when the BNDA, the public organization responsible for collective copyright management in Niger, required SONITEL, by extrajudicial Act served on August 22, 2001, to pay the BNDA CFAF 540 million in copyright royalties owed for having represented or publicly performed certain works of the mind claimed as part of the BNDA's repertoire.

Following SONITEL's refusal, the BNDA sought payment before the Niamey Regional Court, where its claim was denied in Judgment No. 181 of March 28, 2003, on the grounds that it had failed to prove that SONITEL had used works from its repertoire.

The BNDA then appealed to the Niamey Court of Appeal. In its Judgment No. 140/4, of June 21, 2004, the appeal

114 Gautier, n. 67, at 32.

court overruled the first-instance court, finding in favor of the BNDA and ordering SONITEL to pay the royalties. According to the Court of Appeal, when read together, Ordinance 93-027 of March 30, 1993, on copyright, related rights and expressions of folklore and Order No. 157/MCI/MCC of October 14, 1997, regulating royalties for copyright, related rights and expressions of folklore do not make the actual use of works a decisive condition for requiring telephone networks to pay copyright royalties.

Attacking that line of argument, SONITEL appealed to the State Court of Niger (which was acting as Supreme Court during the military transition in the country¹¹⁵) to quash the appeal court's ruling.

Reasoning: The State Court was asked to rule on whether the actual use of protected works is a condition *sine qua non* for the charging of royalties. The judge's response seems to cast doubt on the entire copyright system.

In reaching a decision to subject SONITEL to the payment of copyright royalties (section II), the court provides clarification concerning the constituent elements of representation (section I).

I. Elements constituting the public performance of a work

Under article 1 of Ordinance 93-027, particularly article 1(v): "Communication of a work ... to the public means the act of making the work publicly available."

Based on that wording, public representation consists of two elements. Although the Ordinance strongly implies actual use of the work, the State Court held it to be optional (A), deeming two other elements mandatory for an activity to be considered a public exhibition: the work being made available, and the existence of a public that will see it (B).

A. The optional element: use of the work

While the term "use" does not appear explicitly in the Ordinance of March 30, 1993, it is nonetheless an intrinsic part of a work's representation or public performance. The Ordinance is undeniably clear in providing that communication "is the act of making the work publicly available."

A better illustration is provided by Order No. 157/MCI/MCC. Article 1 of that regulation sets out the royalty amounts to be paid by users of literary and artistic works. Its wording clearly makes use of the works a decisive factor in requiring such payments.

That reading of the 1993 Ordinance is consistent with the legal framework and mechanisms for copyright. To earn a living from their art, authors should be able to derive income from their works of the mind, which requires that they be able to control the exploitation of those works – that is, their actual use by third-party consumers.

Unfortunately, the State Court of Niger delivered a blow to that proposition by making actual use of a work an optional criterion. According to that court, any debate on actual use had been rendered redundant by the royalties schedule established and applicable to the appellant, to which the B8 tariff category was applicable as a consequence of its classification as a "telephone network." Ordinance No. 93-027 made it moot, the Court reasoned, whether SONITEL disseminated the artistic works or not.

This position is regrettable, and it breaks with classic precepts for literary and artistic property rights. But what elements, then, *are* considered essential to characterize an activity as execution of a work?

B. Essential elements: a capacity to make a work available to the public

A simple reading of the 1993 Ordinance offers material elements with which to characterize the public representation of a work: the work being made available, and the existence of a public for it.

The requirement of a work being made available necessarily means its exhibition, in the sense of its communication to the public. This element does not pose particular difficulties in practice. The court seems to leave space for ambiguity, however, about what such exhibition must consist of, finding that the appellant's capacity to disseminate the work amply sufficed to consider communication to have occurred and thus to make the appellant ultimately liable for the payment of royalties.

The 1993 Ordinance requires too the existence of a potential public to whom the work is to be communicated. Representation is subject to the monopoly benefiting an author only if the work is communicated to a public.¹¹⁶ Traditionally, "public" has been understood as opposed to the concept of a "family circle." In simple terms, it means a group of people (who are not clients of the person making the work available) gathered in the same place, at the same time, to experience contact with the work.¹¹⁷ But that traditional definition is clearly out of step with new technological realities in the communication of works. Case law has thus dispensed with the same-time, same-place requirement to adapt to, for example, the televising of works in multiple hotel rooms (not the same place) for digital transmission on demand (not at the same time).

Whether or not it actually reaches the public, the work must be available for public access, without which there can be no communication. On the question of the public actually receiving such communication, article 1(2) of the 1993 Ordinance provides: "Any process necessary to make the work publicly available and that permits access is a communication, and a work is considered to have been 'communicated' even if the public for which it is intended does not actually receive it, see it or hear it."

115 See Ordinance No. 2010-16 of April 15, 2010, on the organization, powers and functioning of the State Court.

116 Vivant and Bruguiere, n. 22, at 34.

117 Ibid, at 343.

The court interpreted this as making it an optional criterion that the public actually receive the work; the most important thing is that the communication can reach the public concerned, because the author has a monopoly right to make a work available to the public. Illustrating its position, the court affirmed that “effective use of a work occurs by virtue solely of the capacity of the structure concerned to make it publicly available through the possession and deployment of an appropriate technical mechanism; the circumstance that no one actually receives it, sees it or hears it is immaterial.”

II. Liability for the payment of royalties

As a sanction for its unauthorized communication of the works, the appellant was held liable for the payment of royalties. In concrete terms, the State Court of Niger reiterated the financial penalties for SONITEL (A), with no concern for the incongruities its decision created (B).

A. The financial penalties for SONITEL

Essentially a confirmation of the appeal court’s sanction, the State Court ordered the appellant to pay the copyright royalties due and awarded damages to BNDA, the defendant on appeal.

In reality, royalties consist simply of regular payments made by users exploiting a work of the mind. In principle, this remuneration corresponds to a proportion of the receipts generated by economic exploitation of the work; in practice, however, it is often difficult – if not impossible – to assess receipts as a basis for calculating what users owe. Flat-rate remuneration is therefore often fixed by regulation.

In this case, the BNDA was responsible for collecting the royalties due to authors contributing to its repertoire. The Order cited in the case fixed the annual amount of such royalties for telephone networks at CFAF 30,000 per network. As indicated during the proceedings, SONITEL had two telephone networks covering all of Niger. Accordingly, the company was ordered to pay CFAF 180,000 in royalties for the years 1999, 2000 and 2001.

As if to be logically consistent, the State Court of Niger replicated too the appeal court’s decision to award damages. Thus, for the prejudice it caused to the defendant on appeal by abusively resisting the payment of the royalties it owed, SONITEL was ordered to pay in damages an additional amount of CFAF 500,000.

B. Critique of the State Court’s sentence

The State Court’s judgment is incoherent in at least two ways. Above all, it strayed from the remuneration logic behind royalties, which are still perceived as the counterpart to exploitation of a right. The court confined itself to creating a presumption that protected works had been used and then making that presumption a substitute for their “actual use.” As if that were not enough, the court forces a misconception of the remuneration accorded to the right holder as a form of tax rather than simply royalties.

It is hard to remain sanguine about the approach taken by the court. Seeking grounds on which to convict SONITEL, it centered the company’s mere capacity to disseminate the works at issue as the main justification for charging it royalties, whether or not the protected objects have been actually exploited. And yet, according to the spirit and letter of the provisions cited by the court, *actual* use or exploitation of the works is what gives rise to royalties. The payment of royalties is simply the counterpart for consumption of the fruits of the author’s intellectual efforts. The use of a work is a judicial fact, not a matter of opinion.

The appellant attempted to demonstrate this to the court by demanding proof from the BNDA that it (SONITEL) was communicating protected works to the public. Unfortunately for the appellant, the court batted this argument away, citing Order No. 157/MCI/MCC of October 14, 1997, requiring the payment of royalties by communication networks. In short, from the moment the user’s activity is covered by that regulation, the user is liable for the payment of royalties, whether the protected works are actually consumed or not.

By making the use of works an optional criterion, the court created a presumption of use at the expense of all persons with the technical means to make works of the mind publicly available. That interpretation of the texts cited in the plea is legally consequential and could lead to royalties being collected unduly.

Indeed, the court ended up misrepresenting copyright royalties as a kind of mandatory levy. In private law, a royalty is a sum regularly paid to its beneficiary by the user of an intellectual property right (such as copyright, patent or trademark) as payment for – a counterpart to – that use. The payment of royalties is conditioned on use of the right concerned; under a reciprocal contract, it is exploitation of the work that is cause for payment. A royalty is thus not a tax, which is a compulsory levy without counterpart.

SONITEL tried to hammer that point home in its arguments – but to no avail.

Aristide Fade

P. Procedure – Copyright – Counterfeit seizure – Proceedings on the merits – Unsuccessful plaintiff – Compensation for prejudice resulting from seizure

An unsuccessful plaintiff for infringement, having been judicially authorized to seize assets, must compensate the distrainee if damages result.

Société Zenith-Plastics Côte d’Ivoire (ZPCI) v. Société Industrielle de Fabrication de Plastique en Côte d’Ivoire (SIFPLAST-CI), Judgment No. 1412/15 of July 2, 2015, Commercial Court of Abidjan

Observations:

In this case, the Commercial Court of Abidjan responded convincingly to the question of what should be done when a plaintiff's action for infringement is dismissed after they have been judicially authorized to perform a seizure. The present case concerns designs and models, but the lessons that can be drawn from this judgment are valid more generally, for all intellectual property rights.

Facts: The facts of the case are straightforward. The company Zenith-Plastics Côte d'Ivoire (ZPCI), which specialized in manufacturing and marketing plastic materials, developed a model shoe known as "Model 838," which it registered with the OAPI in 2000. The company manufactured and marketed the product until 2009. In December of that year, the company SIFPAST-CI, also engaged in the manufacture of plastic shoes and believing Model 838 to be a copy of its "Super 13" and "Super 14" models, which it had registered with the OAPI in 1996 (with renewals in 2003 and 2008), seized all stocks of Model 838 shoes for sale in client stores. (The judgment does not say under what conditions.) It then obtained authorization from the president of the High Court of Yopougon to conduct a seizure on ZPCI premises, on January 5, 2010, of all manufacturing equipment, materials and stocks of Model 838 shoes, and it went on to bring action for infringement and unfair competition, seeking payment of CFAF 738 million in damages.

SIFPAST-CI won its case before the Yopougon trial court, the decision of which was then confirmed by the Court of Appeal of Abidjan.

That judgment however, was then quashed on June 7, 2012, by the Judiciary Chamber of the Supreme Court, which ordered SIFPLAST-CI to release all objects seized from ZPCI and to ensure restitution of all material assets and goods under penalty of CFAF 5 million per day of delay in doing so, reckoned from the date of notification of the decision.

Considering that the counterfeit seizure in 2010 had paralyzed it throughout the judicial proceedings, ZPCI sought damages. It obtained the designation of an expert from the president of the Commercial Court of Abidjan (by an order confirmed by the Court of Appeal of Abidjan) to determine its material, commercial and financial damages, which were assessed at CFAF 870,536,049. ZPCI then sued SIFPLAST-CI for that amount, in 2015, in compensation for the "irregular seizure," as well as CFAF 335 million in punitive damages. The defendant contested the claim, saying that, in performing the seizure at issue, it was merely executing a court decision.

Reasoning: The problem is well known, but the solution in this case was not obvious. The difficulty here lay not in the consequences of any liability, for the compensation of damages is covered by common law and calls for no further comment; rather, it lay

in the court's validation of an expert report despite faults found in it by the defendant.¹¹⁸

That left two questions:

- I. on the principle itself; and
- II. on the conditions for such liability.

I. The principle of liability for the seizure applicant unsuccessfully bringing action for infringement

The defendant company disputed the very principle of its liability. It said that it had committed no "assault" and that to consider legal execution of a judicial decision as incurring liability would amount to "holding the state liable for employing judges who issue judicial decisions."

The Commercial Court of Abidjan did not agree. It recognized that the defendant "had the right to conduct a counterfeit seizure," but said that it was nonetheless obliged to remedy any damages caused to the company targeted for seizure. According to the court, a provision in ABR-1999 that "the judge may order the requester to deposit a certain amount as guarantee for the damages which the author may claim" shows that "the principle of compensating third parties injured by a counterfeit seizure is clearly admitted in intellectual property law." The conclusion is thus inevitable: "It is therefore to no avail that the defendant brandishes judicial rulings to evade all liability."

The court's reasoning is laudable on all points. The notion that execution of a judicial decision cannot be a source of liability is unacceptable. From that point of view, the court is correct in invoking the Bangui Agreement, particularly with respect to industrial designs and models under article 33(3) of annex IV. It is interesting from a historical standpoint that, in 1791, the first French law on patents for inventions, which instituted counterfeit seizures, provided expressly for compensation of the distrainee.¹¹⁹

The situation is comparable to that of a plaintiff provisionally executing a judgment under appeal. No one denies that damages caused by such execution should be remedied if the judgment is overturned. In France, the Court of Cassation sitting in full court clearly enunciated the solution, all the wider in scope in that the impugned decision in that case had been spontaneously executed by the losing party.¹²⁰

118 The judge also applies common law to calculate the penalty. Calling the exercise more than the simple arithmetic of multiplying the number of days of non-compliance by the daily penalty, the court reduces the amount, considering the circumstances in the case, to CFAF 200 million.

119 J.-P. Stenger (2004) *Saisie-contrefaçon – Recours après saisie-contrefaçon. JurisClasseur Brevets*, Fasc. 4634, 206, No. 130.

120 Cass. ass. plén., February 24, 2006, No. 5-12.679, JurisData No. 2006-032415, D. 2006, 1085 (note R. Perrot).

II. The conditions under which liability can be incurred by a seizure applicant unsuccessfully bringing action for infringement

The difficulties lay in the nature of the liability incurred and thus the conditions under which the seizure was performed.

It must be admitted on this point that the judgment, as reported, is not entirely unambiguous. It begins by affirming that the obligation to remedy damages derives from “the general principle of civil and criminal liability set forth in article 1382 of the Civil Code.” That provision says that “any human act causing damage to others obliges the person at fault for the act to remedy such damage.” But in intellectual property matters, the judgment immediately adds, “counterfeit seizures are always performed at the risk of the seizure applicant, who must compensate injured parties if it is ultimately found that the applicant’s intellectual property rights have not been infringed as claimed.” The two obligations are fundamentally different: the first refers to liability for fault; the second, to liability without fault.

The idea that the seizure applicant’s liability is incurred only if its fault is proven is not illogical. It amounts to saying that a plaintiff who sues for infringement but is ultimately unsuccessful is liable for the consequences of seizure performed prior to the judgment *only* if the seizure occurs under conditions making it wrongful. This would be the case, for example, where accompanying publicity is intended to harm the distrainee, or where the seizure applicant could not have been unaware of the fragility of the intellectual property right being claimed.

Conversely, the seizure applicant would be exonerated if it had performed the seizure under normal conditions or had misunderstood, in good faith, the existence or scope of its rights. In France, part of the case law in this area, especially in patent matters, adopts such reasoning. In 1964, for instance, the French Court of Cassation ruled that “a judgment is rightly founded in denying damages claimed for wrongful seizure of patent-infringing goods, rejecting the appellant’s argument that as a precautionary measure, counterfeit seizure incurs the seizure applicant’s objective liability if the seizure proves to be unjustified and prejudicial, and for that fact alone, irrespective of any fault.”¹²¹

If applied in this case, this reasoning would have denied the claim for compensation. Nothing in the judgment supports the idea of a wrongful seizure. From that point of view, the court’s reference to “irregular seizures”¹²² is unfortunate, because a seizure authorized by a judge is not in itself “irregular.” Nor is there any evidence that SIFPLAST-CI acted in bad faith, knowing its case to be weak.

This lamentable outcome alone indicates defects in the court’s analysis. It must not be forgotten that counterfeit seizure is a provisional measure only and that the broader such measures are, as in this case,¹²³ the greater the risk incurred. Who assumes this risk when the legal action fails? To that question, the judgment is correct in answering that counterfeit seizure “is always conducted at the risk of the seizure applicant,” citing the absence of intellectual property infringement alone as grounds for requiring compensation.

The case law in France predominantly follows that reasoning. The French Court of Cassation has imposed the principle that “any person conducting counterfeit seizure does so at their own risk and is thus liable for any damages that may result.”¹²⁴ It applies the same reasoning to the related hypothesis concerning provisional execution.¹²⁵

The Commercial Court of Abidjan, despite some ambiguities, follows in the same line of reasoning and can therefore be applauded.

André Lucas

Q. Copyright – Conflict of laws – Condition of foreign nationals – Legislative reciprocity invoked against foreign authors – Berne Convention – National treatment

It has been held that authors of foreign nationality can enjoy their copyrights in Cameroon only by demonstrating that their national law accords to nationals of Cameroon the same level of protection provided under the law in Cameroon.

MP ET RAPAC V. MOHAMADOU AMINOU, Judgment No. 367/Com of April 17, 2003, High Court of Ngaoundéré

Observations:

This case is an opportunity to examine the situation of foreign nationals in respect of literary and artistic

121 Cass. com., June 8, 1964, *Ann. propr. ind.* 1964, 254. See also CA Paris, pôle 5-1, January 30, 2013, No. 11/5261, *PIBD* 2013, No. 982, III, 1132.

122 It is unclear whether the plural form includes the seizure performed in stores, in December 2009, or only that conducted on the company’s premises, on January 5, 2010.

123 Where ring-fencing, which unfortunately was not requested, would have been fully justified.

124 Cass. com., October 19, 1999, No. 97-12.845. See Stenger, n. 126, No. 130: “A party that takes this exorbitant measure, prejudicial by definition to the party targeted for seizure, necessarily does so at its own risk should it ultimately prove unjustified ... Therefore, in the case of counterfeit seizure, if proof of counterfeiting is found and the risk is then incurred by the party targeted for seizure, the same result in a case where no illegality is found would be illogical.” See also Stenger, n. 126, No. 137: “No one is forced to resort to counterfeit seizure. But a party that does so must assume the attendant responsibility. A proper balance between the rights of a seizure applicant, in taking that exorbitant measure, and the rights of a party unjustifiably targeted for seizure, cannot be disregarded without compromising institutional integrity.” See also P. Greffe (2000) *Dessins et modèles. JCP E* 2000, 1280, No. 92: “This case law is all the more meritorious in that seizure has consistently been treated as an optional formality for essentially evidentiary purposes and that proof of counterfeiting can be provided by any means.”

125 Cass. ass. plén, February 24, 2006, n. 127: “Whereas provisional execution of an enforceable judicial decision can occur only at the risk of the executing party ...” For an earlier case, see Cass. 1ère civ., June 6, 1990, *Bull. civ.* 1990, I, No. 140: “Even if provisionally authorized, execution of a judicial decision later appealed occurs only at the risk of the executing party.”

property. In a time of globalization, this is a crucial question too often confused with that of the law applicable. Regrettably, however, the High Court of Ngaoundéré glossed over the question, based on a biased reading of the law in Cameroon, to reject the allegation of infringement.

Facts: “Artists/musicians,” claiming to act on behalf of an artists’ association, the Rassemblement des artistes professionnels et amateurs du Cameroun (RAPAC), arranged for the seizure from a discotheque operated by the plaintiff of 2,133 videocassettes and CDs not bearing the label SOCINADA (Société civile nationale des droits d’auteur, a collective rights management organization operating in the country at the time). The attorney contesting that action argued that the works fixed on the media seized were by authors of “foreign nationality” and that no evidence had been provided, as required by the law in Cameroon, that the national laws of the authors concerned provided the same level of protection as local law to “Cameroonian singers and musicians.”

Reasoning: In endorsing that line of argument, the High Court of Ngaoundéré disregarded the fundamental principle of national treatment (section I) without considering the conditions set out in international treaty law circumscribing that highly hypothetical reciprocity (section II).

I. The principle of national treatment

To justify its acquittal, the court invoked the reciprocity provided for under article 93(1) of the Law of December 19, 2000, on copyright in Cameroon, which stipulates that “foreign nationals enjoy in Cameroon the copyrights or related rights they hold on the condition that the law of the State of which they are nationals, or on whose territory they have their domicile, headquarters or establishment, protects the rights of Cameroonians.” It concluded that, absent demonstration by the public prosecutor and the victims that this condition has been met by legislation in the countries concerned, infringement could not be found.

This logic is not convincing. It bypasses, in effect, article 94 of the same law, which stipulates that “the provisions of this law concerning the protection of literary and artistic works, interpretations, phonograms, videograms and programs, apply to works protected under an international treaty to which Cameroon is a party.” With respect to copyright, the text refers to the Berne Convention – specifically, its article 5(1), which provides: “Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the [copyright protection] Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.” That provision is echoed by article 5(3) of ABR-2015: “Non-nationals shall enjoy the provisions of this Agreement and its annexes under the same conditions as nationals.”

The principle behind those three texts is known as “national treatment” and it is the exact opposite of reciprocity. National treatment would mean that a Union country (a signatory to the Berne Convention) must guarantee the nationals of another Union country (as well as residents thereof) enjoyment of the same rights enjoyed by its own nationals, even if the latter do not enjoy the same rights in that other country.

This rule pertains to the condition of foreign nationals – and foreign nationals alone. From that point of view, the wording of article 94 of the 2000 law is questionable: in referring expressly to application of the “provisions in this law,” it could give the impression of a rule governing conflict of laws (an impression possibly reinforced by the words “national treatment”). But the two questions are different. It is one thing whether foreign nationals may be deprived of enjoying a right because of their foreign nationality, but quite another whether one law or another should apply to the infringement of their rights (which need not, theoretically, be the law of the forum seized). A good way of avoiding confusion would be to speak not of “national treatment” but of “assimilation of foreign authors to national authors.”¹²⁶

Considered together, articles 93 and 94 of the 2000 law should have cautioned the High Court of Ngaoundéré against invoking the “sacrosanct principle of reciprocity in international relations.” But with the Berne Convention on the table, the issue clearly became one of national treatment. The Berne Convention stipulates reciprocity for authors from Union countries in exceptional cases only, concerning resale rights, for instance.¹²⁷ In the present case, based on passages in the judgment, the Berne Convention was indeed on the table. The judgment refers to some of the authors claiming infringement as being nationals of the United Kingdom (the court incorrectly refers to “English” nationality), of Niger and of Nigeria – as well as of India (if one accepts that meaning for a reference to “Hindu” nationality). They are all Union countries under the Berne Convention (a founding country, in the case of the United Kingdom). Since Cameroon is also a Union country (since 1960) and contrary to the court’s judgment, no form of reciprocity could be invoked against those authors.

II. Conditions for reciprocity

Suppose that some of the authors had been nationals and residents of non-Union countries unable to prove residence in a Union country. The hypothesis is unlikely, given the Berne Convention’s global scale, but cannot be ruled out, since the “foreign nationalities” listed (with the surprising inclusion of “Hindu” and “Hausa”), ending with an ellipsis indicating that the list is not exhaustive, are cited by the court as illustrations only.

On first reading, article 93(1) of the 2000 law, subjecting the enjoyment of copyright to legislative reciprocity, would seem to apply. That impression is strengthened

126 See Lucas, Lucas-Schloetter and Bernault, n. 37, Nos. 1759 *et seq.*

127 Berne Convention, art. 14 *ter* (2).

by article 5(4) of ABR-2015: the provisions concerning national treatment “shall apply to non-nationals of a state party to an international agreement to which the Organization or its member states are parties, or non-nationals who do not have their principal establishment or residence in such a state under conditions of reciprocity.” The wording leaves two things to be desired. First, the phrase “or non-nationals” appears to be a drafting error; to be correct, it should read “or to non-nationals.” Second, it is clumsy to say in the same sentence that national treatment is subject to reciprocity, since national treatment, as discussed, is understood as automatic assimilation of non-nationals to nationals.

It should be noted, however, that the wording of article 5(4) of ABR-2015 is less than ideal. A literal reading of the text (starting with the conjunction “or” and glossing over the drafting error) would be that foreign nationals of a Union country who reside in a non-Union country would be subject to the reciprocity requirement, which would be contrary to both the Berne Convention and article 93(1) of the Cameroonian law. In addition – and this objection applies to both texts – the Berne Convention makes it impossible to reason exclusively in terms of nationality (or of residence). Article 5(1) guarantees national treatment for authors in respect of “works for which they are protected under this Convention.” Determination of the country of origin is essential to that end.¹²⁸ Specifically, a national of a non-Union country who publishes a work for the first time in a Union country is entitled to national treatment. What needed to be done in this case was thus to ascertain the country of origin (in the sense of article 5(4) of the Berne Convention) of each of the works in question.

Admittedly, under article 6 of the Convention, even a Union country of origin may require reciprocity if the author’s country of nationality (hypothetically a non-Union country) “fails to protect in an adequate manner” the works of authors who are nationals of the Union country. But this assumes that the Union country “avails itself of this right” by giving notice to the Director General of WIPO “by a written declaration specifying the countries in regard to which protection is restricted, and the restrictions to which rights of authors who are nationals of those countries are subjected” (article 6(1) and (3), respectively). This mechanism, which did not exist in the initial version of the Convention, was introduced when it was revised in 1928 at Canada’s request, that country seeking to reserve a retaliatory possibility vis-à-vis its powerful neighbor, the United States, which had not yet acceded to the Convention. Canada has not availed itself of the mechanism, however, having given no notice and made no declaration to that effect.¹²⁹ Nor does it appear that other countries have done so. In other words, application of the text to the circumstances in this case amounts to pure hypothesis.

The question was obviously complex and warranted more than the peremptory response delivered in this judgment.

André Lucas

¹²⁸ C. Masouye (1978) *Guide de la Convention de Berne*. Paris: WIPO, 34.

¹²⁹ W. Nordemann, K. Vinck and P.W. Hertin (1983) *Droit d’auteur international et droits voisins dans les pays de langue allemande et les États membres de la Communauté européenne* (trans. J. Fournier). Brussels: Bruylant, 86.

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Chapter 7

Unfair competition

A. Unfair competition – Conditions: existence of a competitive situation – Elements of unfair competition

Legal action against unfair competition can prevail only if the following two preconditions have been met:

- a competitive situation exists between the plaintiff and defendant; and
- the three elements of unfair competition – a wrongful act, damage suffered and a causal link between the two – are present.

ADAMOU IDRISSE V. MAHAMAN MINDAOU, Judgment No. 13 – 086/c of April 4, 2013, State Court of Niger, Judicial Chamber

Observations:

This judgment, issued by the Judicial Chamber of the State Court of Niger on April 4, 2013, highlights the conditions for successful legal action against unfair competition. The case pitted Adamou Idrissa, promoter of school CSP Dessa, against Mahaman Mindaou and other promoters of school CSP Gobir.

Facts: The facts of the case are quite simple. Although they did not effectively open their establishment for the 2008–09 academic year before completing the administrative requirements, Mr. Mindaou and the other promoters of CSP Gobir had already undertaken to recruit teachers, register students, display posters and air radio spots on the conditions and procedures for student registration.

Mr. Idrissa, the promoter of CSP Dessa, where three of the promoters of CSP Gobir had formerly been part-time teachers, considered that their promotional campaign, recruitment of teachers and registration of students, all before completing the required administrative formalities, constituted unfair competition. Mr. Idrissa successfully instituted proceedings for that offense against Mr. Mindaou and the other CSP Gobir promoters before the High Court of Maradi. That court's judgment was then quashed by the Court of Appeal of Zinder on the grounds that the acts alleged against the CSP Gobir promoters did not constitute unfair competition. CSP Gobir had indeed rolled out publicity, with posters and radio spots on student registration, before receiving administrative authorization to operate, but the establishment did not open until it had received those permissions.

Dissatisfied with the appeal court's ruling, Mr. Idrissa

petitioned the State Court of Niger to quash it. He argued that the promotional posters, radio spots and student recruitment proved the school had in effect opened prior to authorization, causing damage to others and constituting unfair competition subject to articles 1382 and 1383 of the Civil Code. According to Mr. Idrissa, the defendants' wrongful conduct had been deliberate and vengeful, damaging his own school in two ways:

- the defendants' school's extremely low tuition costs forced him to lower his own school's fees; and
- there was reduced availability of teachers.

The legal question put to the State Court was whether the conditions required for competition to be ruled unfair were met in the case.

Reasoning: To answer that question, the court began by recalling the legal basis for the treatment of unfair competition, consisting of articles 1382 and 1383 of the Civil Code and articles 4 and 7¹ of the Bangui Agreement establishing the African Intellectual Property Organization (OAPI) – of which Niger is a member – as revised on March 2, 1999 (ABR-1999). The court then recalled the purpose of, and conditions for, unfair competition proceedings:

- the purpose is the regulation of the right to compete, primarily to ensure sufficient and effective competition in the interests of free trade and enterprise, thereby safeguarding the interests of individual competitors and consumers, as well as the general public interest; and
- the conditions, that an act incurring liability must have been committed, damage must have been suffered, a causal link must exist between the act and the damage, and the parties must supply similar products or services to a common clientele.

The court dismissed Mr. Idrissa's excuses for his failure to meet the conditions required for a finding of unfair competition. The court considered the trial court to be at fault in ruling the competition unfair having ascertained neither the existence of a competitive situation before CSP Gobir was legally established nor the latter's commission of unfair competitive acts thereafter.

1 The judge failed to specify that those articles are contained in annex VIII to the Agreement.

The court concurred with the appeal court that the acts impugned by Mr. Idrissa, the promoter of CSP Dessa, did not qualify as unfair competition, even if they did reduce his own establishment's tuition income.

The court's reasoning invites us to review the two distinct conditions that must be met for competition to be ruled unfair – namely, that:

- I. there must be a competitive situation; and
- II. the elements of unfair competition must be present.

The case also implicitly raises a third legal question that the court should have addressed:

- III. the legal basis for actions against unfair competition in OAPI countries.

I. The existence of a competitive situation

Establishing the existence of a competitive situation between two professionals is itself subject to two conditions: their engagement in competitive activities (A), and their appeal to a common clientele (B).

A. Engagement in competitive activities

Article 1(a) of annex VIII to ABR-1999 defines unfair competition as pertaining to industrial or commercial activities. The subsequent revision, ABR-2015, added a third category: activities relating to the liberal professions. Education, the activity concerned in this case, is neither an industrial nor a liberal professional activity: can it be considered a commercial activity?

Both the trial court and the State Court behaved as though the answer – that education *can* be considered a commercial activity – goes without saying, but that is far from so. A better answer comes from article 3 of the OHADA Uniform Act Relating to General Commercial Law. That article defines a “commercial act by nature” as “an act by which a person engages in the movement of goods that he produces or purchases or an act by which he provides services with the intent to make a monetary profit.” While education is not a good, it is a service. Is its intent to make a monetary profit? Since it does not appear among the acts enumerated in article 3, one might hesitate to consider education a commercial act by nature. The enumeration in article 3, however, is not restrictive. The commercial nature of the educational activity provided by both CSP Dessa and CSP Gobir, to the extent that it was conducted in exchange for tuition fees, could thus be based on their intent to profit from it. As a profit-making rather than philanthropic activity, it qualified as a commercial and thus competitive activity under article 3.

This characterization of education as a commercial activity, however, is to some extent flawed, particularly since it is not identified as such – nor as a civil activity – in Ordinance No. 96/035 of June 19, 1996, regulating private education in Niger. By way of comparison, in Cameroon, article 2(1) of Law No. 4/22 of July 22, 2004, regulating the organization and functioning of private education,

characterizes private education as a social service of public utility performed by private partners. Although the Ordinance in Niger is silent on the nature of private education, it is certainly a social service of public utility in that country, as it is in Cameroon.

As a social service of public utility, private education can be considered not a commercial but a civil activity. Moreover, annex VIII to ABR-1999 restricts the concept of unfair competition to industrial and commercial activities. That restrictive approach, however, is also flawed. The same annex to ABR-2015 expanded the conception to include activities relating to the liberal professions. It should now be expanded further, to include all civil activities performed with the aim of capturing clientele. On that basis, the educational activities conducted by CSP Dessa and CSP Gobir, though civil in character, could also be considered competitive.

B. The existence of a clientele

The State Court found fault in the trial judge's recognition of unfair competition on the basis of CSP Gobir's activities before it legally existed – in displaying posters, airing radio spots, recruiting teachers and registering students – without explaining how CSP Gobir could have seriously competed with CSP Dessa or drawn from the same clientele.

Recalling that “[u]nfair competition always pertains to a real and common clientele, with both parties offering similar products or services to the same clients,” the court highlighted the two factors traditionally considered in determining the existence of a clientele – namely, that the clientele must be real (1), and it must be common to the two parties (2).

1. The existence of a real clientele

At what point does a business concern have a real clientele? Two main answers have been advanced in the literature: one based on the concern being open for business;² the other on it actually operating.³ The French Court of Cassation, preferring the latter, rejected the notion that a potential clientele can constitute a real one.⁴

In this case, it appears from the unchallenged facts established in the dossier and court hearings, as summarized by both the trial and appeal court judges, that CSP Gobir published its promotional posters and aired radio spots before receiving the administrative authorizations it needed to operate – but also that it opened for business only after receiving them. The trial judge found against CSP Gobir for unfair competition, based on its activities prior to existing legally – apparently considering those preparatory activities sufficient for clientele and thus for competition to materialize whether or not the school was later authorized to open. The trial judge, in other

2 Weill and Chabasse. *Création et disparition du fonds du commerce. Juriscl. Fonds de commerce*, Fasc. VI.

3 Cohen (1955) *La propriété des fonds de commerce exploités dans les immeubles spécialisés. JCP* 1955, I, 1222.

4 Cass. com., February 27, 1973, *JCP* 1973, II, 17403 (obs. A.S.); Cass. 3ème civ., May 18, 1978, *Bull. civ.* 1978, III, No. 205, 159.

words, rejected both theses: the one based on the concern being open for business and the other, on it actually operating.

The State Court quite rightly rejected that solution, finding fault in the trial judge's failure to explain how CSP Gobir could have seriously competed with CSP Dessa based on its preparatory activities alone. According to the court, no educational establishment can legally exist, or have a clientele, without first being authorized to open. For a school, posters, radio spots, teacher recruitment and student registration are not enough in themselves to make clients appear; that can happen only once the school has been authorized to open for business and does so.

2. The existence of a common clientele

The court also found fault in the trial judge's failure to explain how CSP Gobir could have shared a common clientele with CSP Dessa before receiving authorization to open. It thus embraced the traditional concept of unfair competition,⁵ in line with most case law in OAPI countries.⁶

But that concept is now being challenged in French law, where judicial action against unfair competition is no longer subject to the existence of competition between the parties.⁷ There, the offense of unfair competition can thus be committed in the absence of a common clientele.⁸

To determine whether a common clientele existed in this case, two distinct phases must be considered: the phase *before* the opening of GSP Gobir, and the phase *after* it was authorized to open.

- In the preparatory phase, there was no common clientele because CSP Gobir did not yet have clients. Only CSP Dessa, which was already operating, had clients. The court rightly found the trial judge to be at fault – in basing its decision on the posters, radio spots, teacher recruitment and student registration prior to legal existence – for failing to explain how a legally non-existent establishment could have shared a common clientele with the plaintiff.
- In the phase subsequent to authorization for CSP Gobir to open, it is undeniable that both conditions were met: the existence of its own clientele and of a clientele common to both establishments. The two establishments were indeed performing a similar – in fact, identical – activity.

5 See L. Mermillod (1954) *Essai sur la notion de concurrence déloyale en France et aux Etats-Unis*. Paris: LGDJ, 60; P. Roubier (1952) *Le droit de la propriété industrielle*, vol. 1. Paris: Sirey, 108.

6 *SECAREC v. S.G.B.C., MERCEDES SEAC*, Judgment No. 112 of May 5, 1978, High Court of Douala; *Société Philip Morris Inc. v. Société VISTAMIL SL*, Judgment No. 175 of December 11, 1985, High Court of Yaoundé; *Cie des Transactions Commerciales (C.T.C.) v. Cie des Transports et de Commerce (C.T.C.)*, Judgment No. 10/C of November 21, 1969, Court of Appeal of Douala.

7 Cass. com., November 8, 1994, *Bull. civ.* 1994, IV, No. 325, *Contrats conc. consom.* 1995, No. 6 (obs. D. Vogel), summary 209 (obs. Y. Serra); L. Vogel (1995) *Droit français de la concurrence*. *JCP E* 1995, 1, 492.

8 See, in this vein, V.G. Ripert, R. Roblot and L. Vogel (2001) *Traité de droit commercial*, vol. 1, 18th edn. Paris: LGDJ, Nos. 730, 595 and 596, and all of the jurisprudence cited there.

For that reason, the court did not consider it necessary to explicitly address the common clientele condition in considering the subsequent phase. It preferred to focus instead on the existence of elements constituting unfair competition imputed by the plaintiff (CSP Dessa) to the defendants (CSP Gobir).

II. The elements of unfair competition

Successful legal action against unfair competition, as the State Court helpfully recalled, requires the following elements: an act of unfair competition incurring liability or fault, damage suffered and a causal link between the two. The court does not dwell at any length on the condition concerning damage (B) or on the causal link (C), but only on the act of unfair competition (A).

A. The act of unfair competition

According to the court, to incur liability for unfair competition under articles 1382 and 1383 of the Civil Code, an act must consist of a wrongful intervention in the market, breaching the duty to exercise the freedom of competition in good faith, honestly and in the social interest.

By this definition, in line with that embraced in case law and enshrined in successive versions of the Bangui Agreement,⁹ acts of unfair competition are those deemed contrary to what is considered honest practice in professional milieux.

With respect to good faith, or the lack of it, numerous acts and practices have been considered signs of bad faith in case law and in successive iterations of the Bangui Agreement, including:

- the disparagement of competing individuals, establishments and products;
- disorganization of the production, staff, activity or commercial methods of a competing enterprise; and
- confusion created about a competing establishment, its products and personnel, and so on.

In the court's opinion, the fault or misconduct that constitutes unfair competition must be explicitly identified by the trial judge, whose characterization of the facts is then subject to review.

In performing its function of judicial review oversight, the court found the trial judge in this case to be at fault for not explaining how "the activities of the defendants, after obtaining all the official documents required, had the effect of deceiving the public to the detriment of CSP Dessa, of disparaging CSP Dessa or of disorganizing that establishment or the region's private education sector in general." There was no need to dwell on those allegations of bad faith because the appellant was unable to prove them.

No acts of unfair competition having been established, the court sided with the appeal court in denying Mr. Idrissa's claim.

9 AB-1977, ABR-1999 and ABR-2015.

It was difficult, moreover, to impute unfair competition to the CSP Gobir promoters, in either the preparatory or post-authorization phases.

- In the preparatory phase, CSP Gobir had neither real nor common clientele and thus could not have engaged in unfair competition – a point the appellant challenged. But even assuming that CSP Gobir *had* begun operating without authorization to open, the situation then would have been one of prohibited,¹⁰ rather than unfair, competition.
- In the post-authorization phase, CSP Gobir did have a real and common clientele, so the traditional condition of competition was satisfied. But were acts or practices committed that were contrary to accepted honest practice in professional milieux? The promoter of CSP Dessa did not demonstrate that they were.

Be that as it may, the fact that CSP Gobir exercised its activity after obtaining authorization to open could not constitute unfair competition; in fact, it was the epitome of free competition. The court quite rightly said as much in distinguishing between “competition” and “unfair competition,” “... the former being the framework of legal rules governing the realities between economic actors in seeking and keeping clientele, and the latter being wrongful practices liable to injure others.”

Recognition of free competition has two consequences.

- The first is the freedom of every professional to price products or services as necessary, including below those offered by other professionals having entered the market earlier. Price regulation, it should be recalled, falls not under the laws on unfair competition as such but under those on anti-competitive practices. The fact that CSP Gobir priced its tuition at CFAF 43,000, and not CFAF 60,000, as CSP Dessa was then charging, did not constitute unfair competition as the latter’s promoter contended.
- The second relates to the legality of competitive damage. Competition for clientele being free, every professional can attract clients away from others. In other words, freedom of competition means freedom to poach the customers of other competitors. As one author put it, “the freedom of the competitor doing the damage trumps the security of his unfortunate rival.”¹¹ The promoter of CSP Dessa therefore had no grounds to impugn the fall in its staffing caused by the opening of CSP Gobir. That was a normal consequence of free competition.

The promoter of CSP Dessa could, however, have explored a different way of bringing action for unfair competition, based on a non-compete obligation, provided that a clause to that effect had been included in the employment contracts of its former teachers, now its competitors. While opening a school to compete with

a former employer does not in itself constitute unfair competition, it could constitute competition in breach of contract, if the former employee were subject to a valid non-compete obligation.

B. Damage in matters of unfair competition

Despite the importance of civil liability in unfair competition proceedings, the need for damage to be suffered as a condition for success remains controversial in the literature. There are two main schools of thought on the matter, both claiming to represent positive law.

- According to the first and older school of thought, the plaintiff must demonstrate damage suffered even if requesting only cessation of the unfair competition.¹² The authors supporting this thesis base it on the fact that unfair competition is governed by article 1382 of the Civil Code of Niger, which in all cases and in principle requires proof of damage suffered. Their conception of damage is rather broad, however, including potential damage as well as that actually suffered.
- Authors of the second school of thought reject this thesis.¹³ Dean Roubier, for example, argues against assimilating proceedings brought for unfair competition with those brought for civil liability, asserting that two hypotheses need to be distinguished: a plaintiff seeking compensation must demonstrate the damage suffered; a plaintiff seeking not compensation but an injunction against unfair competitive practices can obtain it “on no other condition than the innate and current interest of any competitor to escape the impact of such practices.”¹⁴ To summarize Roubier’s thinking, “damage is suffered as a normal occurrence and need not be demonstrated for proceedings against unfair competition to succeed, unless the plaintiff claims compensation for it.”¹⁵

The Bangui Agreement, as revised in 1999 and again in 2015, appears to align with the thesis requiring damage to be suffered. Article 1(1)(b) of annex VIII to ABR-1999 reads: “Any natural or legal person who has suffered damage or is liable to suffer damage due to an act of unfair competition may institute proceedings ...”¹⁶ This means that proceedings for unfair competition may be instituted both where damage has been suffered and where it might be suffered. Where it has been suffered, the person injured can institute proceedings for compensation, among other things. But where damage is only potential, the person liable to incur it cannot seek compensation – only cessation of the unfair situation.¹⁷

10 Prohibited competition occurs when a person engages in an activity for which they ought to, but have not, sought prior authorization.

11 R. Prieur (1960) Contribution à l'étude de la concurrence sur le marché. *RTD com.* 1960, 521.

12 Cass. req., May 29, 1894, *D.P.* 1894, 1, 521 (note F. Despagne); H. Allart (1892) *Traité pratique et théorique de la concurrence déloyale*, Paris: A. Rousseau, No. 7; H. Godinot (1932) *La concurrence déloyale ou illicite*. Thesis, University of Nancy, 32.

13 Roubier, n. 5, Nos. 111, 507 *et seq.*; C. Giverdon, *Les délits et quasi-délits commis par le commerçant dans l'exercice de son commerce*. *RTD com.* 1953, Nos. 23, 862.

14 Roubier, n. 5, at 509.

15 *Ibid.*

16 This article has been reproduced *in extenso* as ABR-2015, art. 1(2)(b).

17 See ABR-1999, art. 1(1)(b) of annex VIII (now ABR-2015, art. 1(2)(b)), which includes injunctions among the remedies for unfair competition

Case law in the OAPI countries is divided. Some judges align with Roubier;¹⁸ others require proof of damage suffered, even while sharply curtailing that condition to punish certain particularly wrongful acts. Some courts have thus required only minimal damage,¹⁹ or simply moral prejudice.²⁰ Such case law was enshrined in ABR-2015, in which moral prejudice is listed among the remediable forms of damage under article 8 of annex VIII.²¹

Rejecting the thesis of unfair competition, the State Court recalled the need for damage if proceedings against such competition are to succeed. As in matters of civil liability, the burden of proving damage from unfair competition rests with the plaintiff but entails more than demonstrating a diversion of clientele or a decline in sales.²² It is, however, sufficient for the plaintiff to demonstrate that a competitor has poached numerous customers from it by unfair methods.²³ In such a case, awarding compensation for the damage suffered can be a delicate matter, so courts usually award a symbolic single franc. Such symbolic penalties have not deterred unfair competitors. The best penalty for that purpose may be to require that the unfair activity be stopped and to publish court verdicts against an unfair competitor.

C. The causal link between the act incurring liability and the damage suffered

The third element of unfair competition the State Court recalled is the causal link between an act of unfair competition and damage suffered. Unlike the elements of fault and damage, however, that of a causal link has received little attention from the courts or in the literature on this topic.

In principle, requiring a causal link means that the damage suffered by a competitor must be the direct consequence of another's unfair act. In the few cases where they have had to opine on this point, courts have been quite flexible in their appraisal of causality. In one case, the French Court of Cassation upheld the award of compensation for a business even though it had not demonstrated that its declining sales resulted directly from wrongful practices by its competitor.²⁴

Such judicial flexibility is in no way surprising. First, the variable nature of any clientele makes it very difficult to identify and assess the (hypothetical) causes of particular variations. In addition, to the extent that courts do not systematically demand certain proof of damage and require only potential damage as grounds for conviction, the causal link requirement fades in importance or vanishes entirely.

III. The legal basis for proceedings against unfair competition

Virtually all countries with free-market economies have admitted the theory of unfair competition as a means of applying morality to competitive activity.²⁵ Different countries have, however, constructed it in different ways. For example, in French law, in the absence of a special text criminalizing practices deemed unfair, the theory emerged in the 19th century from case law and the literature as simply a particular form of civil or criminal liability, incurred through a personal act, based on articles 1382 and 1383 of the Civil Code.

Having so evolved, the theory was introduced through French colonization to some of sub-Saharan Africa, where it long remained a construction of case law. It was not until AB-1977 that the theory of unfair competition was given legislative sanction in French-speaking signatory countries.

ABR-1999 assigned greater importance to unfair competition, by including an entire annex (annex VIII) and far more articles (increased from one to eight) on the subject. ABR-2015 includes a nearly identical annex VIII to that introduced into the 1999 version.

Since the original AB-1977 entered into force, however, numerous judges in OAPI countries have continued to refer in their decisions on unfair competition either to article 1382 of the Civil Code²⁶ or to the relevant provisions of the Bangui Agreement,²⁷ or to the two in combination (as the court did in this case).

The concept of unfairness developed in case law based on article 1382 is admittedly identical to that enshrined in successive revisions of the Agreement. Even so, it would be better in our view – except in cases of non-economic parasitic competition (“passing off”)²⁸ – to discontinue references in unfair competition to article 1382, whether independently or coupled with the Agreement, which alone suffices. Where plaintiffs continue to cite

18 Judgment No. 10/C, n. 6: “In addition, the measure to suppress an illegal situation is preventive in character and can be ordered even in the absence of damage.”

19 *Ibid.*

20 *Menuiserie Camerounaise Industrielle (MCI) v. MECAF et SOPECAM*, Civil judgment No. 382 of June 22, 1983, High Court of Yaoundé: “Whereas the plaintiff has not brought or offered to bring proof of the material damage claimed ... [but whereas] it is certain that the acts committed by MECAF have caused moral prejudice to MCI ...” The Court of Appeal concurred on this point in *Le Directeur de l'entreprise MECAF v. Menuiserie Camerounaise Industrielle*, Decision No. 58/ Civ of December 4, 1985, High Court of Yaoundé.

21 “The competent domestic court shall take into consideration the negative economic consequences, including loss of profits, suffered by the injured party, the profits made by the author of the wrongful act and the moral prejudice caused to the victim.”

22 CA Paris, April 3, 1995, D. 1996, summary 254; Cass. com., January 25, 2000, *PIBD* 2001, III, 154, P.A. 2000, July 18 (note M. Malaurie-Vignal), P.A. 2000, July 3 (note N. Mathey).

23 CA Orléans, March 29, 1889, *D.P.* 1890, II, 134; CA Rouen, November 8, 1899, *D.P.* 1900, II, 338.

24 Cass. com., October 16, 1957, *Bull. civ.* 1957, III, No. 265.

25 Roubier, n. 5, at 1.

26 See, e.g., *Société SOGEC-Ivoire v. Société Ivoirail*, Judgment No. 816 of June 6, 2003, Supreme Court of Côte d'Ivoire (obs. A. Fade, this collection, Chapter 7, section D); *Société SOGEC-Ivoire v. Etablissements Mroui & Freres*, Judgment of June 1, 2006, Supreme Court (Judicial Chamber) of Côte d'Ivoire.

27 See, e.g., *Moulinex SA v. Vapsan Trading Cie and ors*, Civil judgment No. 192 of December 15, 2000, High Court of Wouri (Douala) (obs. M.L. Ndéma Elongué, *Revue scientifique de la propriété industrielle ma Gazelle* 2017, 1, 17 et seq.); *Sonatel Mobiles SA v. Agence Touba Sénégal and GPS Group*, Judgment No. 57 of May 17, 2017, Supreme Court of Senegal (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section M).

28 See *Amisshah Marielle Linda v. Soumahoro Maury Fere and ors*, Judgment No. 3556/17 of December 19, 2017, Commercial Court of Abidjan (obs. A. Lucas and G. Jiogue, this collection, Chapter 6, section A).

article 1382, judges granting their claims should ground their decisions in the Bangui provisions instead. Similarly, where trial courts continue to apply article 1382, appeal and supreme courts in OAPI member states should make the same substitution when exercising their judicial oversight.

Grégoire Jioque

B. Long-term storage of a competitor's gas cylinders – Sabotage of others – Disorganization of the sales network of an established competitor – Inappropriate application of the intentional element

The long-term storage by an industrial and medical gas company of a large quantity of a competing company's gas cylinders and the sabotage of other gas cylinders have been found to constitute an act of unfair competition through disorganization of a competitor's sales network.

SOCIÉTÉ AIR LIQUIDE CÔTE D'IVOIRE SA V. SOCIÉTÉ D'OXYGÈNE ET D'ACÉTYLÈNE DE CÔTE D'IVOIRE (SOA-CI), Judgment No. 2234/2015 of July 31, 2015, Commercial Court of Abidjan

Observations:

Annex VIII to ABR-1999 contains a non-exhaustive list of unfair competitive practices. This includes the disorganization of a competing company and its market,²⁹ which is considered the most brutal form. A competing company can be disorganized by several means; the means used in this case, adjudicated by the Commercial Court of Abidjan on July 31, 2015, was disorganization of the company's sales network.

Facts: This judgment concerns two competing companies – Air Liquide, the plaintiff, and SOA-CI, the defendant – both engaged in the sale of industrial and medical gas. In the course of their business, both companies were selling cylinders stamped with their names.

Informed with supporting pictures that cylinders belonging to the plaintiff had found their way into the defendant's maintenance warehouse, the plaintiff sought and obtained a court order authorizing it to inspect the defendant's premises. That inspection, conducted by a bailiff, revealed that:

- there were 43 cylinders on the defendant's premises;
- of the 43 cylinders, 12 were equipped with valves and 31 were not; and
- cylinders belonging to SOA-CI had been stamped with its trade name.

The bailiff also found several rusted cylinders on the defendant's premises that had deteriorated too far to determine their ownership. According to the plaintiff, all signs pointed to those cylinders being its property, since the defendant had no interest in allowing its own cylinders to fall into such a state.

The plaintiff argued, on this basis, that:

- a. the defendant was collecting the plaintiff's cylinders, filling them for sale with its own gas and stamping them with its own trade name; and
- b. the defendant's storage on its premises of the plaintiff's cylinders was disorganizing the plaintiff's distribution network.

The plaintiff sought redress from the defendant for the damage caused by this act of unfair competition.

The question asked of the Commercial Court was whether the plaintiff's distribution network had indeed been disorganized. The court answered in the affirmative.

Reasoning: As the Commercial Court saw it, the defendant intentionally stored the plaintiff's cylinders on its premises for several days to use them itself, which it deemed an unfair act. That act, the court concluded, disorganized the plaintiff's distribution network, depriving it of the cylinders it needed to meet its clients' needs, while the defendant had many available to meet its own clients' needs.

It appears from the court's reasoning that it based its conclusion on two criteria: a material act and intent. For such disorganization to constitute unfair competition, there must indeed be a material act (section I). Requiring the element of intent, however, has long since proven inappropriate (section II).

I. The material act constituting disorganization of a competitor's distribution network

Article 7 of annex VIII to ABR-1999, in line with the case law and article 1382 of the Civil Code of Côte d'Ivoire when drafted, affirmed the unlawfulness of disorganizing a competing enterprise and its market, providing that: "Any act or practice which, in the course of industrial or commercial activities, is liable to disorganize a competing enterprise, its market or the market of the profession concerned, shall constitute an act of unlawful competition."³⁰

The words "liable to" mean that the act or practice need not have already produced its effects to be considered unlawful; it is sufficient that it *could* disorganize the competing enterprise, its market or the market of the profession concerned.

Article 7 also contains a non-exhaustive list of ways in which such disorganization might occur. They fall into

29 Cf. ABR-1999, art. 7 of annex VIII. This article is reproduced *in extenso* in ABR-2015.

30 This text is reproduced *in extenso* in ABR-2015, art. 7(1) of annex VIII.

two categories: those disorganizing a particular operator, and those disorganizing an entire market. The first category includes suppression of advertising, diversion of orders and disorganization of the sales network. The second includes abnormally low prices and failure to comply with regulations on the activity concerned.

In this case, the plaintiff sought that the defendant be found liable for unfair competition on the grounds that the defendant had disorganized the plaintiff's distribution network by storing some of the latter's cylinders on its own premises and sabotaging others. The defendant argued in response that the presence of the cylinders on its premises did not constitute an act of unfair competition; rather, it reflected a practice among gas distribution companies whereby customers often arrived for refills with cylinders belonging to a competitor. Since a deposit would have been paid on such cylinders, they were set aside to be returned to the customer later. That was why, according to the defendant, the 43 cylinders in question were on its premises, just as cylinders of its own were often on the plaintiff's own premises. The defendant claimed to have neither filled with gas nor utilized for commercial purposes the 43 cylinders at issue, but to have stored them still empty, as indicated in the testimony.

On the strength of those arguments, the defendant denied that any act of disorganization liable to incur its liability had occurred. The defendant's other arguments, concerning procedure, do not call for comment here.

To adjudicate this dispute, the court began by defining disorganization as "damage consisting of certain, significant and potentially debilitating harm to an economic organization." This definition cannot be assessed relative to article 7 of annex VIII to ABR-1999, which does not define disorganization. It merely affirms the unlawful character of the offense and non-exhaustively indicates some examples. By the court's definition, the act or practice of disorganization must be such that it does disable or could disable the victim. In addition, what is important in this case is how that disorganization transpired in relation to the plaintiff's distribution network.

To conclude that an act of disorganization had been committed, the court began by considering the issue of the plaintiff's many cylinders on the defendant's premises and dismissing the latter's point about current practice in the gas distribution sector: "If such a practice actually exists in this business, the defendant does not provide evidence that a competitor can keep so many cylinders on its premises." The court then considered the matter of the defendant sabotaging the plaintiff's cylinders, concluding that, here again, the defendant had not proven that a company could remove the valves and caps from the cylinders of a competitor, as occurred in this case. Finally, the court considered the fact that the defendant had "placed its label on some of the cylinders at issue in order to use them commercially, to the detriment of the company Air Liquide." In light of all these considerations, the court quite correctly concluded

that an act of unfair competition had been committed by means of disorganizing the plaintiff's distribution network, "insofar as the storage of several of its cylinders prevented the plaintiff from meeting the needs of its clientele, unlike SOA-CI, which had numerous cylinders on hand to meet its own clients' needs."

Having established the existence of a material act to disorganize the plaintiff's distribution network, the court went on to characterize this disorganization in terms of intent – a questionable line of reasoning in a case of unfair competition.

II. The relevance of intent in the disorganization of a competitor's distribution network

Among other factors, the court based its finding that the defendant disorganized the plaintiff's distribution network on the fact that the latter "intentionally stored the cylinders on its premises for several days, in order to use them." The court thus makes intent an element of unfair competition in general and of disorganization of the victim's distribution network in particular. Yet intent is not included as an element of unfair competition in article 7 of annex VIII to ABR-1999, the relevant provision on disorganization of a competing enterprise and of the market, or in other articles of that annex on different forms of unfair competition (in both the 1999 and 2015 revisions).

The Bangui Agreement is thus in line with the case law based on article 1382 of the Civil Code, which, starting with the French Court of Cassation in 1958,³¹ has dispensed with the element of intent as a necessary criterion in finding unfair competition.

To digress briefly, there have been three major stages to the evolution of case law over the years with respect to intent in relation to unfair competition, each a function of the same main question: must a competitive act be intentional to qualify as "unfair"? For quite some time, French case law betrayed little doubt about the answer: unfair competition required fraudulent intent – or, in other words, bad faith. Both the country's trial courts³² and the Court of Cassation held that position, the latter having affirmed in several of its judgments that "unfair competition presupposes bad faith."³³ According to that early judicial thinking, unfair competition could not exist in the absence of bad faith.

31 D. 1959, 87 (note F. Derrida).

32 See esp. Grenoble, May 3, 1954, D. 1954, 426: it has been a constant in the literature and in case law that an action for unfair competition is admissible only if the plaintiff proves "that the competitor concerned engages in harmful maneuvers in attempting to divert clientele, bad faith being an element essential to unfair competition." See also Lyon, June 9, 1955, and Cass. com., April 18, 1958: "Whereas unfair competition, which consists of any maneuver to poach the clientele of others, presupposes bad faith ..."

33 Cass. req., March 9, 1870, D.P. 1871, I, 211; Cass. req., November 18, 1903, D.P. 1904, I, 10, S. 1904, I, 84; Cass. req., February 26, 1907, D.P. 1908, I, 27.

While endorsed by some authors in the literature,³⁴ this early case law has been criticized by most.³⁵ A majority of the authors regarded unfair competition as a simple matter of civil liability, which a competitor's negligence or imprudence should be sufficient to incur. To require bad faith as well, according to this view, was excessive. Over time, such critiques led courts to temper their approach, recognizing liability in the absence of bad faith, where a competitor has simply been negligent. Two series of decisions have followed that line: the first have conceded the absence of bad faith, or declined to look for it, before convicting the competitor concerned of carelessness or negligence;³⁶ in the second, after seeking but not finding fault for a competitive act, courts have refrained entirely from convicting the allegedly unfair competitor, despite the damage caused.³⁷ Other court rulings and a number of authors have termed such competition "prohibited," as a tort of negligence, using the term "illicit competition" to distinguish it from "unfair competition," the latter being characterized by intentional fault. This distinction is more than mere terminology, bearing two consequences highlighted by many authors and judicial rulings:

- one consequence is procedural, obliging courts to dismiss claims of unfair competition in the absence of bad faith and preventing them from invoking "illicit competition";³⁸ and
- the other concerns the assessment of damages, whereby bad faith should aggravate a defendant's liability and good faith should mitigate it.³⁹

Most authors have criticized this distinction in terms of both terminology and effect.⁴⁰

The third stage in the evolution of case law began with a judgment of April 18, 1958, handed down by the French Court of Cassation. The court's statement of grounds reads: "... a merchant's use of his namesake under conditions creating confusion between two establishments constitutes the tort of negligence without an element of intent being required." In embracing that principle, the court adopted an objective conception of unfair competition, repudiating the purely linguistic and unnecessary distinction between unfair competition and illicit competition.⁴¹

34 See *JCP* 1948, II, 4035 (note R. Plaisant); *JCP* 1958, II, 10535 (note P. Esmein).
 35 See A. Chavanne. *Jurisl. responsabilité civile*, Fasc. 17 bis A, No. 41; S. 1937, II, 1 (note S. Geny); R. Savatier (1951) *Traité de la responsabilité civile*, vol. 1. Paris: LGDJ, No. 50; P. Roubier and A. Chavanne (1955) *Chroniques. RTD com.*, 837, No. 11; P. Roubier and A. Chavanne (1958) *Chroniques. RTD com.*, 102, No. 18; Crouanson (1925) *De l'élément de faute dans la concurrence déloyale*. Thesis, Aix-Marseille University, 24.
 36 CA Toulouse, January 4, 1954, D. 1954, 116; CA Chambéry, February 2, 1954, D. 1954, 297; CA Paris, February 14, 1958, *JCP* 1958, II, 10535 (note P. Esmein).
 37 CA Rennes, November 28, 1922. See also Cass. req., July 16, 1925, *Ann. prop. ind.* 1928, 24; T. com. Seine, 29 June 1927, *Gaz. Pal.* 1927, II, 416; CA Paris, July 5, 1954, S. 1955, II, 1 (concl. Dupin).
 38 Cass. req., March 9, 1870, n. 32; Cass. req., November 18, 1903, n. 32; CA Grenoble, 26 June 1906, *Ann. prop. ind.* 1907; CA Poitiers, November 5, 1935, S. 1937, II, 1 (note Gény).
 39 Cass. req., June 1, 1874, S. 1875, I, 111.
 40 See esp. Maunoury (1894 [2018]) *Du nom commercial*. Paris: Hachette, 275.
 41 P. Roubier and A. Chavanne (1959) *Chroniques. RTD com.*, 425; Cass. com., April 18, 1958 (note F. Derrida). According to this author, "there should no longer be any difference between unfair competition and unlawful competition: both incur the liability of their author on the same basis and according to the same principles."

Despite resistance from a few,⁴² judges in OAPI countries have largely aligned with this third stage in the case law. Indeed, most of their decisions no longer subject the admission of unfair competition cases to proof of a defendant's bad faith.⁴³ In short, while proof of fault is both necessary and sufficient, a tort of carelessness or negligence is just as sufficient as intentional fault if a party is to incur liability for unfair competition.⁴⁴

It is clear, then, that the decision of the Commercial Court of Abidjan in the present case is out of step with the evolving case law, and with the 1999 and 2015 revisions to the Bangui Agreement, and cannot be endorsed. Admittedly, a company does not store a large number of a competitor's gas cylinders and sabotage others without any intent to disorganize that competitor's distribution network – but such intent must not be considered a requisite element of unfair competition.

Grégoire Jiogue

C. Civil proceedings for trademark infringement and unfair competition – Voluntary participation – Non-exclusive licensee – Admissibility

A trial judge declaring inadmissible the voluntary participation of a non-exclusive trademark licensee in proceedings initiated by the trademark owner for infringement and unfair competition on the grounds that the latter was defending the same interests – although, according to the facts, the voluntary participant was seeking to secure compensation for prejudice specific to themselves – has improperly applied article 46 of annex III to ABR-1999.

Moreover, the conditions referred to in article 46(1) of the same text – failure to act by the trademark owner after being called upon to do so – do not apply in proceedings for unfair competition.

U. NV V. T.A., Judgment No. 139/2005 of March 23, 2005, High Court of Ouagadougou

42 See Judgment No. 382, n. 19: "In passing off as its own work, in the presentation it deliberately made to SOPECAM journalists, the two buildings on pilings concerned, knowing they had been built by MCI, MECAF unquestionably committed an act of unfair competition characterized by the confusion it created, in bad faith, between the two enterprises."
 43 See, e.g., *Société SOGEC-Ivoire v. Société Ivoiral*, Judgment No. 816 of June 6, 2003, Supreme Court of Côte d'Ivoire (obs. A. Fade, this collection, Chapter 7, section D); *Société SOGEC-Ivoire v. Etablissements Mroui & Freres*, Judgment of June 1, 2006, Supreme Court (Judicial Chamber) of Côte d'Ivoire; *Moulinex SA v. Vapsan Trading Cie and ors*, Civil judgment No. 192 of December 15, 2000, High Court of Wouri (Douala) (obs. M.L. Ndéma Elongué, see n. 26); *Sonatel Mobiles SA v. Agence Touba Sénégal and GPS Group*, Judgment No. 57 of May 17, 2017, Supreme Court of Senegal (obs. M.L. Ndéma Elongué, this collection, Chapter 3, section M).
 44 See *Cie des Transactions Commerciales (CTC) v. Cie des Transports et de Commerce (CTC)*, Decision No. 10/C of November 21, 1969, Court of Appeal of Douala, concerning the fault of negligence or carelessness incurring the defendant's liability.

Observations:

The right to bring civil action for the infringement of a mark belongs mainly to the mark's owner, in the way of an exclusive right. That principle, drawn from article 46(1) of annex III to ABR-1999, calls for a few qualifications, however. On the one hand, the beneficiary of an exclusive right of use – in other words, an exclusive licensee – may also initiate such action, subject to two cumulative conditions: the absence of a contrary contractual clause and prior notification of the owner. The beneficiary of a non-exclusive license, on the other hand, under article 46(2) of the same annex, can only intervene in infringement proceedings brought by another. Questions therefore arise about this judgment of the High Court of Ouagadougou declaring inadmissible the voluntary participation of a licensee – in this case, the company U. Côte d'Ivoire – in infringement proceedings initiated by the owner of the infringed mark

Facts: U. NV, owner of the OAPI-registered trademark for the detergent "OMO," claiming to be a victim in the case, brought action for infringement and unfair competition against the alleged perpetrator, T.A., based on articles 47 and 49 of annex III to ABR-1999, having initiated an infringement seizure of 2,616 cartons of "MIMO" detergent belonging to T.A., based on similarities between the labels and colors featured in its packaging and those used under the "OMO" trademark. U. Côte d'Ivoire then intervened voluntarily in those proceedings to seek compensation for damage it claimed as beneficiary of a license to sell "OMO" detergent, granted to it by the company U. PLC, the beneficiary in turn of an exclusive right to use the mark.

In response, T.A. sought the dismissal of both actions on the grounds of failure to certify that registration of the mark had neither lapsed nor been canceled, failure to make the security deposit required under the procedure for infringement seizure and incompetence of the judge issuing the infringement seizure order. With respect to the voluntary participation, T.A. argued that the owner of the mark had acted to protect the same interests as those claimed by U. Côte d'Ivoire, so that the latter lacked standing to bring action. On the substance of the case, T.A. claimed that it had bought the "MIMO" detergent contained in the cartons at the port of Tema, in Ghana, and noticed the product's resemblance to products marked "OMO" only once in Ouagadougou.

Reasoning: Apart from the admissibility of these actions (section I), the court had to rule on their merits, in respect of both infringement and unfair competition (section II).

I. Admissibility

From the outset of these proceedings, T.A. challenged the admissibility of both actions: the principal claim (A) and the voluntary participation (B).

A. The principal claim

In addition to the traditional conditions for admissibility set out in the national codes of civil procedure of

Bangui Agreement signatory countries, the owner of a trademark bringing action for infringement must demonstrate ownership and the scope of its rights by producing a registration certificate for its mark, or else risk dismissal of the action. In this case, T.A. based its motion for dismissal on failure to demonstrate that registration of the mark had neither lapsed nor been canceled, failure to make the required security deposit and incompetence of the judge issuing the infringement seizure order.

It is clear that – apart from the competence of the judge, which is not a question specific to intellectual property law – the other two grounds could legitimately make an action for infringement inadmissible. Demonstrating that registration of the mark had neither lapsed nor been canceled and that the required security deposit had been made were legal requirements for the seizure order, not conditions for admitting the action for infringement.⁴⁵ The requirement to prove that the registration had neither lapsed nor been cancelled would be rendered moot, moreover, by article 51(2) of ABR-2015: "The order shall be made on application and on submission of proof of registration of the mark." The entry into force of this text will facilitate recourse to this protective measure by trademark owners (particularly those residing in countries other than that in which the headquarters of OAPI is located) who, because of their remoteness, had difficulties in obtaining urgent certificates of non-removal and non-forfeiture, even by electronic means. In any case, flaws in the seizure cannot reasonably paralyze proceedings on the substance of the alleged infringement, where the trademark owner can legitimately avail itself of the mosaic of evidentiary procedures afforded under ordinary law. And while the grounds stated were less than convincing, one can easily understand the judge denying T.A.'s motion for dismissal of the principal claim of U. NV, consisting of two components: infringement and unfair competition. Declaring the infringement component inadmissible would still leave unfair competition, the less formally burdensome part of the claim. Under the ordinary laws on liability for personal acts, as contained in national civil codes, the production of certification that registration has neither lapsed nor been canceled, or that a required security deposit has been made, are not required for a judge to admit actions for unfair competition.

As a matter of civil liability under ordinary law, a claim for unfair competition is subject to the traditional conditions for admitting any litigation.

B. The voluntary participation

According to the facts of the case, the company U. Côte d'Ivoire had obtained a non-exclusive sublicense from its sister company U. PLC, itself the beneficiary of an exclusive license obtained from the company U. NV, owner of the "OMO" trademark. Based on article 46(2) of annex III to ABR-1999, U. Côte d'Ivoire sought to participate voluntarily in the proceedings. Citing

⁴⁵ Cf. ABR-1999, art. 48 of annex III.

article 46(1) of the same annex – not the relevant provision, since it concerns exclusive licensees – the court denied the participation.

Now, as mentioned earlier, U. Côte d’Ivoire was party to a simple license contract and thus, under article 46(2) of the same text, entitled to intervene in infringement proceedings brought by the trademark owner. The judge therefore erred in denying U. Côte d’Ivoire the opportunity to obtain compensation for the damage it attributed to T.A. The judge’s ruling on this point is all the more regrettable in that the aim sought by U. Côte d’Ivoire through voluntary participation was compensation for damage resulting from unfair competition, which is governed by a protective regime not subject to article 46.

It should be emphasized that, contrary to the position taken by the judge in this case, the beneficiary of any kind of license to exploit a mark also incurs damage when the mark is infringed or affected by unfair competition and has the right to seek compensation. Those entitled to seek it through voluntary participation under ABR-2015 do not appear to include simple licensees. Is this a simple omission or the deliberate intent of community legislators? The omission hypothesis seems plausible, since the matter is plainly covered elsewhere in the same text, with respect to patents for inventions,⁴⁶ utility models⁴⁷ and industrial designs or models.⁴⁸

II. The merits

Assessed next are the merits of the actions for infringement and unfair competition: how they were merged to form a single action (A) and what sanctions were applied as a result (B).

A. How the actions were merged

The main action initiated by U. NV, the original owner of the “OMO” trademark, was grounded in two annexes of ABR-1999: annex III, in article 37 (on infringement); and annex VIII, in articles 2, 3 and 4 (on unfair competition). But there is no clear line distinguishing how these two protective regimes should have applied to the facts in this case, as reflected in the judge’s reasoning:

“Considering that information included in the case file shows that the labels and colors used in packaging the ‘MIMO’ products were similar to those used for the ‘OMO’ products, [and] that ‘OMO’ is a legally registered and protected trademark, while ‘MIMO’ is not, these acts of imitation constitute infringement; and by confusing and deceiving the public, these acts also constitute unfair competition ... the claim by U. NV is well-founded and thus granted.”

This recital does not clearly distinguish acts constituting infringement from those actionable as unfair

competition. Yet it is widely accepted in the literature, as well as case law, that an action for unfair competition is admissible only if based on an actionable fault distinct from the act constituting infringement and not otherwise sanctioned.⁴⁹ In this case, U. NV argued that the infringement consisted of the use of similar labeling and colors to package the “MIMO” and “OMO” products, and that the unfair competition stemmed from the confusion caused by the imitation of “OMO” packaging by “MIMO” distributors. In other words, the same act could have been characterized by the judge as both infringement and unfair competition, unfavorably impacting the compensation the victim could expect to receive.

B. The resulting sanctions

U. NV sought reimbursement of its legal costs for the proceedings and CFAF 250 million for loss of earnings resulting from a slump in sales caused in turn by the infringement allegations. The court denied those requests as unfounded. The slump in sales and the legal costs must obviously be proved by producing accounting records, without which a judge has no objective basis for assessing them. The judgment called for no particular comment on that point – only that the conviction for infringement and unfair competition should result in damages being awarded separately, since two faults had been alleged. That question is not specifically addressed by the judge, who rightly confined himself to considering U. NV’s request as presented, with no breakdown of the costs. Courts in the signatory countries of the Bangui Agreement tend to ignore the difference in legal regimes applicable to those two offenses, particularly if they are combined in a single act, as in this case. In an interesting case between two companies in Douala concerning the trademarks “Moulinex” and “Mammonlex,” that city’s high court sentenced the convicted company to pay a lump sum of CFAF 20 million in damages for both infringement and unfair competition.⁵⁰

Max Lambert Ndéma Elongué

D. Industrial design or model – Unfair competition – Similarity liable to create confusion in the consumer’s mind – Fault – Damage – Diversion of clientele – Compensation

A company that introduces into a market a model of bowl similar to one already made available in that same market by a competitor, thereby creating confusion in the consumer’s mind that may have diverted clientele, has acted in breach of article 1382 of the Civil Code of Côte d’Ivoire.

SOCIÉTÉ SOGEC-IVOIRE SOCIÉTÉ IVOIRAL, Judgment No. 816 of June 6, 2003, Supreme Court of Côte d’Ivoire

46 Cf. ABR-2015, art. 63(2) of annex I.

47 Cf. ABR-2015, art. 55(3) of annex II.

48 Cf. ABR-2015, art. 33(1) of annex IV.

49 J. Passa, (2006) *Droit de la propriété industrielle*, vol. 1. Paris: LGDJ, 453.

50 See, e.g., *Moulinex SA v. Vapsan Trading Cie and ors*, Civil judgment No. 192 of December 15, 2000, High Court of Wouri (Douala) (obs. M.L. Ndéma Elongué, see n. 26).

Observations:

Freedom of competition does not permit companies to behave in ways contrary to fair trade practices, aiming to harm and divert clientele from their competitors. The protective regime for unfair competition therefore penalizes competitive excesses in a free economy.⁵¹ Unfair competition is, by nature, a polymorphous offense.⁵² Beyond the classic definition of unfair competitive acts set out in article 10*bis*(2) of the Paris Convention for the Protection of Industrial Property, OAPI law treats four kinds of act – those seeking to confuse, disparage, disorganize or disclose – as unfair competition.⁵³ When a distinctive sign evokes in the consumer’s mind the image of a given enterprise, any act by a competitor that creates, or could create, confusion about the origin of products bearing that sign is an act of unfair competition.⁵⁴ That is the point recalled in this decision by the Supreme Court of Côte d’Ivoire in a case pitting two companies, SOGEC-Ivoire and Ivoiral, against one another.

Facts: The facts in the case are easily summarized. SOGEC-Ivoire, specializing in the household utensils business, manufactured a model of bowl called the “Affoue 16 A/C.” To optimize sales of that product, SOGEC entered into a subcontract with Ivoiral. The dispute arose when the subcontract expired. Challenging Ivoiral for marketing a bowl called the “Tassa 16/B,” which replicated its own “Affoue 16 A/C” model, SOGEC-Ivoire sought redress from the Abidjan Court of First Instance. The court granted its request, by Judgment No. 79 on February 4, 1998.

Ivoiral took issue with the ruling before the Court of Appeal of Abidjan. The latter’s Judgment No. 816, of July 9, 1999, quashed the lower court’s ruling, whereupon SOGEC-Ivoire appealed to the Supreme Court.

Reasoning: The question of law presented to the Supreme Court was whether Ivoiral’s marketing by of its Tassa 16/B bowl constituted a form of unfair competition. The Supreme Court answered in the affirmative – but on two conditions: a competitive relationship between the two litigants, and the presence of elements inherent in unfair competition.

Unlike article 10*bis*(2) of the Paris Convention, the Bangui Agreement does not expressly require the unfair act to be an act (“any act”) of competition. Yet the expression “unfair competition” has meaning only if the perpetrator and victim are in fact competing – that is, if, through their activities, they vie for the same clientele.⁵⁵

Moreover, a viable action for unfair competition, as a variant of civil liability action under articles 1382 *et seq.* of the Civil Code, presupposes that three elements have been established: a generating fact (the unfair act or behavior), damage, and a causal link between act and damage.

With respect to the generating fact, the Bangui Agreement refers to “act” or “practice” to cover not only an “act” in the strict sense but also any pattern of omission. An omission may consist of a failure to publish rectification or additional information about the results of a product test published in a consumer review.⁵⁶ Although highly varied in form, actions for unfair competition are often based on four main acts – namely, of those seeking to confuse, disparage, disorganize or disclose.⁵⁷

Unfair competition has quite commonly been based on acts causing confusion, which are punishable whether or not the confusion is intentional. It is not even necessary, moreover, that the confusion intended has been actually created; although less commonly, the simple “risk of confusion” is also punishable as unfair competition. According to article 2(1) of annex VIII to ABR-2015: “Any act or practice which, in the course of industrial or commercial activities, generates or is likely to generate confusion with the enterprise or activities of another person, in particular with the products or services proposed by such enterprise, shall constitute an act of unfair competition.” The courts require proof that such an act has been committed and dismiss actions not providing such proof. In one case, the Court of Appeal of Quémé rejected an action for unfair competition because the appellant had not demonstrated that the acts attributed to its adversary were liable to create confusion in the minds of the public⁵⁸:

“Considering that article 17(b) of the Bangui Agreement makes unlawful ‘all acts of such a nature as to create confusion or fraud by any means whatsoever with the trade name, the establishment, the goods, the services or the industrial or commercial activities of a competitor ...’ [and] that a vendor’s introduction of a product in Benin knowing that a similar, better known product is already being marketed here, is not sufficient to establish the infringing character of the vendor’s product; while there is certainly competition, whether it is unfair must be established by the production of evidence of unfair acts liable to create confusion or constitute fraud.”⁵⁹

Confusion can be seeded in several ways. Some examples of when use of a trademark, trade name or other distinctive sign of an enterprise generates, or is likely to generate, confusion as to the origin of the goods

51 P. Edou Edou (ed.) (2009) *Le contentieux de la propriété intellectuelle dans les États membres de l’OAPI: Guide du magistrat et des auxiliaires*. Geneva: WIPO, 86.

52 The expression used by Oumoul Khaïry Ndao (2015) *Le droit comparé de la contrefaçon et de la concurrence déloyale: l’exemple de la France et du Sénégal*. Doctoral thesis, University of Toulouse, 27.

53 Edou Edou, n. 51, at 85-86; Roubier, n. 5, at 536 *et seq.* See also ABR-1999, art. 2(6) of annex VIII.

54 WIPO (1996) *Model Provisions on Protection against Unfair Competition*. Geneva: WIPO, 16.

55 See *Adamou Idrissa v. Mahaman Mindaou*, Judgment No. 13 – 086/c of April 4, 2013, State Court of Niger, Judicial Chamber (obs. G. Jiogue, this collection, Chapter 7, section A).

56 Cf. WIPO, n. 54, at 8.

57 Edou Edou, n. 51, at 85–86.

58 See *Reckitt et Colman v. Société d’Import-Export (SIMEXPRO)* Decision No. 14 of November 9, 1989, Court of Appeal of Quémé.

59 *Ibid.*

or services concerned are contained in article 2(2) of annex VIII to ABR-2015. The confusion quite often arises when – because of its similarity to a pre-existing mark, whether registered or not – a mark used by an unfair competitor creates, or is likely to create, confusion in the minds of the public. A case before the High Court of Ouagadougou found that confusion had been generated by the use of similar trademarks “OMO” and “MIMO.”

⁶⁰ It conditioned an unfair competition claim – which the plaintiff had combined with infringement in a two-part action – on there being an actionable fault distinct from that characterized as infringement,⁶¹ but confusion can also arise from the use of a distinctive sign not protected by the Bangui Agreement, such as those used to give a company and its products or services a certain identity.

In the present case, the confusion was created by the outward appearance of the competing products – specifically, their shape. Exercising its evocation power to rule afresh on the matter, the Supreme Court referenced a pre-trial expert opinion (ordered before the Court of First Instance of Abidjan, Judgment No. 299 of April 17, 1996) documenting “nearly identical similarity between the models of bowl concerned ... liable to create confusion in the minds of consumers and possibly divert clientele away from SOGEC-Ivoire, the latter having unquestionably suffered material damage from the loss of earnings and part of its clientele.” Such confusion can also result from a product’s packaging,⁶² color⁶³ or other non-functional characteristics.

Under article 1382 of the Civil Code, to generate compensation, an act of unfair competition must cause damage to its victim. Such damage most commonly results from diversion of a competitor’s clientele and it is for that loss of clientele, even if limited, that the competitor is compensated. It matters little, moreover, whether the clients lost are in fact diverted to the unfair competitor; they may, in theory, go to other competitors. In practice, as in this case, it is the unfair one who often benefits.

Like any action for civil liability, actions for unfair competition seek compensation for damage already incurred. Where it has not yet occurred, or is only potential, such actions cannot succeed. During the Supreme Court’s deliberations, it was demonstrated that SOGEC-Ivoire had lost customers for its bowl to its rival. The damage was therefore clearly established, even if the court’s reasoning – that the similarity and confusion “could have led to a diversion of clientele” – left doubt in the air.

In addition to damage, successful action for unfair competition requires a causal link between the act

contrary to honest practice and the victim’s loss of clientele – in other words, between the unfair competitor’s actions and the damage incurred by the plaintiff. Case law has been highly pragmatic in appraising this causal link. For the court in the present case, it meant finding “definite material damage caused by a loss of earnings, caused in turn by a partial loss of clientele.”

All of the necessary ingredients for successful action against unfair competition were thus combined in this case brought by SOGEC-Ivoire.

Aristide Fade

60 *La Sté U. NV v. T.A.*, Judgment No. 139/2005, High Court of Ouagadougou; see also *Société Paco Rabanne Parfums v. M.A. EL G*, Civil judgment of April 10, 1989, Court of First Instance of Abidjan.

61 *Passa*, n. 49, at 453.

62 *Société Paco Rabanne Parfums v. M.A. EL G*, Civil judgment of April 10, 1989, Court of First Instance of Abidjan.

63 *Société Moulin SA v. Société VAPS*, Judgment No. 192 of December 15, 2000, High Court of Wouri (Douala).



Collection OMPI des jugements les plus déterminants en matière de propriété intellectuelle

Membres de l'Organisation
africaine de la propriété
intellectuelle (1997-2018)

Sous la direction de
Max Lambert Ndéma Elongué et Joseph Fometeu



Avant-propos

L'Organisation Mondiale de la Propriété Intellectuelle (OMPI) a le plaisir de présenter le deuxième volume de la *Collection OMPI des jugements les plus déterminants en matière de propriété intellectuelle*, consacré à la jurisprudence en matière de propriété intellectuelle des États membres de l'Organisation africaine de la propriété intellectuelle (OAPI). Cette collection, lancée en 2019, s'inscrit dans le cadre de l'engagement de l'OMPI à fournir à la communauté mondiale de la propriété intellectuelle un accès public gratuit aux données et aux connaissances sur les approches et les tendances en matière de détermination des droits de propriété intellectuelle. Chaque volume de la collection ouvre un accès mondial aux jugements déterminants en matière de propriété intellectuelle d'un ressort juridique donné. Le premier volume contenait 30 jugements déterminants sélectionnés par la Cour populaire suprême de la République populaire de Chine entre 2011 et 2018. Ce deuxième volume présente 53 des décisions les plus significatives rendues par les tribunaux des États membres de l'OAPI entre 1997 et 2018, assorties de commentaires rédigés par d'éminents juges et professeurs.

Les membres de l'OAPI disposent d'un cadre législatif commun en matière de propriété intellectuelle, régi par l'Accord de Bangui. Dans ce cadre, l'OAPI prévoit un système régional de protection de la propriété intellectuelle avec un mécanisme de dépôt unique par lequel les enregistrements de l'OAPI s'étendent automatiquement à tous les États membres de l'OAPI. En outre, les litiges en matière de propriété intellectuelle sont tranchés par les tribunaux nationaux de l'État membre concerné dans chaque cas et les décisions des tribunaux relatives aux dispositions de l'Accord de Bangui sont contraignantes pour tous les autres États membres. À cet égard, les juges de la région peuvent largement tirer parti de l'accès aux jugements rendus par les autres tribunaux de la région pour éclairer leurs propres analyse et prise de décision. Jusqu'ici, peu d'informations étaient disponibles concernant la jurisprudence en matière de propriété intellectuelle dans la région et le présent volume vise à combler cette lacune. En offrant un accès libre à des jugements déterminants, ainsi qu'à des analyses judiciaires rédigées par des juges et des professeurs spécialisés dans ce domaine, cette publication devrait constituer une ressource utile pour la formation des juges et contribuer à la cohérence et à la prévisibilité des décisions rendues par les tribunaux des États membres de l'OAPI. De plus, les commentaires figurant à la fois dans la version originale française et dans la traduction anglaise

permettent à des juges issus de pays non membres de l'OAPI ou n'appartenant pas à la région francophone de bénéficier de cette jurisprudence.

La collection s'inscrit dans le cadre des efforts déployés plus largement par l'OMPI pour renforcer le libre accès à l'information sur l'administration judiciaire de la propriété intellectuelle. Dans ce contexte, la collection est complétée par WIPO Lex, une base de données en ligne permettant d'accéder gratuitement à des informations juridiques en matière de propriété intellectuelle provenant du monde entier, notamment des lois, des traités et des jugements. Toutes les décisions commentées dans le présent volume figurent en texte intégral dans WIPO Lex, et peuvent être consultées à l'adresse suivante : <https://wipolex.wipo.int/fr/main/judgments>.

Le présent volume est le fruit des efforts de collaboration entre l'OMPI, l'OAPI, l'Institut national de la propriété industrielle (INPI) de la France et un certain nombre d'éminents juges et universitaires du Bénin, du Cameroun, de la France et du Sénégal. Nous sommes reconnaissants aux différents auteurs de ce volume, le magistrat Max Lambert Ndéma Elongué, le magistrat Malick Lamotte, le magistrat Aristide Fade, le professeur Joseph Fometeu, le professeur Grégoire Jioque et le professeur André Lucas. Les commentaires contenus dans ce volume reflètent les opinions des auteurs à titre personnel et ne représentent pas les opinions d'un tribunal, d'un État membre, de l'OAPI ou de l'OMPI.

La collection vise à encourager le dialogue et l'échange de vues afin d'améliorer l'analyse, le raisonnement et la prise de décisions judiciaires. Nous sommes convaincus que l'analyse judiciaire approfondie fournie dans ces pages aidera les juges dans la mise en place d'un écosystème de propriété intellectuelle efficace et équilibré, dans la région de l'OAPI et ailleurs.

Marco M. Alemán

Sous-directeur général
Secteur des écosystèmes de propriété intellectuelle
et d'innovation

Préface

La dynamique de l'application des droits de propriété intellectuelle est bel et bien en marche dans l'espace couvert par l'Organisation Africaine de la Propriété intellectuelle. En effet, de manière progressive mais certaine, les juridictions de cet espace ont commencé à marquer du sceau de leur science l'interprétation des concepts contenus dans l'Accord de Bangui et ses annexes. Ainsi ont-elles déjà apporté des précisions utiles à la compréhension de plusieurs questions, notamment celles liées à la compétence juridictionnelle, aussi bien dans le droit de propriété intellectuelle lui-même que dans les rapports de celui-ci avec le droit OHADA, celles relatives aux contours du risque de confusion ou aux notions telles celles d'œuvre de l'esprit, d'originalité, de nouveauté et celles ayant trait aux noms commerciaux et aux régimes de la saisie-contrefaçon et de la concurrence déloyale.

Cette dynamique se devait d'être portée à la connaissance du public. Pour ce faire, le moyen choisi par l'OAPI, l'INPI France et l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) à travers la Division pour l'Afrique et l'Institut judiciaire de l'OMPI est celui de la publication d'un recueil de jurisprudences annotées. Ce moyen bien connu des juristes sous la dénomination "Grands arrêts" était parfaitement indiqué pour la circonstance, pour au moins deux raisons. D'une part, il permet de résoudre le problème purement matériel de la publication des décisions, dans la mesure où, à quelques exceptions près, les jugements et arrêts rendus dans les différents pays de l'espace OAPI ne sont pas publiés. D'autre part et surtout, il permet de ne porter à la connaissance du public que les décisions qui paraissent les plus significatives. En d'autres termes, le choix de la formule "recueil de jurisprudences annotées" permet de confier à une équipe d'experts la tâche de procéder à une rigoureuse sélection des décisions puis à leur annotation.

Ce travail a été confié à une équipe de magistrats chevronnés conduite par Monsieur Max Lambert Ndéma Elongué et à une équipe d'universitaires menée par le Professeur Joseph Fometeu. Les deux équipes ont travaillé dans une belle synergie pour aboutir au résultat que j'ai le plaisir de vous présenter.

Il s'agit, à l'évidence, d'une œuvre inédite, dès lors qu'il s'agit du tout premier recueil de grandes décisions annotées publié dans l'espace OAPI.

Ses destinataires sont bien connus. En premier lieu, les personnes visées sont les acteurs du marché. Le message que j'espère qu'ils percevront à partir de cette

initiative est que les droits de propriété intellectuelle sont bien protégés dans l'espace OAPI et que cet espace est économiquement attractif du point de vue de ces droits, dès lors qu'à partir des décisions recensées, on peut noter que les juges procèdent généralement à des analyses rigoureuses, objectives et impartiales de la loi. En deuxième lieu, les destinataires sont les acteurs de la mise en œuvre des droits de propriété intellectuelle, c'est-à-dire, en particulier, les magistrats en service dans les juridictions de l'espace ainsi que ceux qui officient à la Commission supérieure de recours de l'OAPI, voire les personnels de l'OAPI. En troisième lieu, il faut compter les avocats et, tous ceux qui, universitaires ou non, effectuent des recherches de quelque nature que ce soit, dans le domaine de la propriété intellectuelle dans l'espace OAPI.

À l'endroit des coauteurs de ce recueil, j'émets le vœu qu'à la faveur de l'application de l'Acte de 2015, une deuxième édition soit envisagée aussitôt que le nombre de décisions rendues le permettra.

Denis L. Bohoussou
Directeur général
OAPI

Remerciements

Commentateurs

Max Lambert Ndéma Elongué, magistrat hors hiérarchie, sous-directeur du contentieux administratif, financier et des comptes (direction des affaires non répressives et du sceau), Ministère de la justice (Cameroun)

Lamotte Malick, magistrat hors hiérarchie, président du tribunal de commerce hors classe de Dakar (Sénégal)

Aristide Fade, magistrat, procureur de la République, tribunal de première instance de deuxième classe d'Aplahoué (Bénin)

Joseph Fometeu, professeur, Université de Ngaoundéré (Cameroun)

Grégoire Jioque, professeur, Université de Yaoundé II (Cameroun)

André Lucas, professeur émérite, Université de Nantes (France)

Comité scientifique

Joseph Fometeu, professeur, Université de Ngaoundéré (Cameroun)

Grégoire Jioque, professeur, Université de Yaoundé II (Cameroun)

André Lucas, professeur émérite, Université de Nantes (France)

Secrétariat technique

Brillant Aimé Yobo, avocat au Barreau du Cameroun

Joël Fabrice Dongmo Donfack, docteur en droit privé

Awal Mohamadou, doctorant en droit privé

Coordonnateurs de l'OMPI

Inés Fernández Ulate, juriste, Institut judiciaire de l'OMPI, Secteur des écosystèmes de propriété intellectuelle et d'innovation

Eun-Joo Min, directrice, Institut judiciaire de l'OMPI, Secteur des écosystèmes de propriété intellectuelle et d'innovation

Marc Sery-Kore, directeur, Division pour l'Afrique, Secteur du développement régional et national

Experts techniques de l'OMPI

Ignacio de Castro Llamas, directeur, Division des litiges relatifs à la propriété intellectuelle et des relations extérieures, Centre d'arbitrage et de médiation de l'OMPI, Secteur des écosystèmes de propriété intellectuelle et d'innovation

Marina Foschi, juriste principale, Section des politiques et des services consultatifs en matière de législation, Département des marques, des dessins et modèles industriels et des indications géographiques, Secteur des marques et des dessins et modèles

Marcus Höpperger, directeur principal, Département des marques, des dessins et modèles industriels et des indications géographiques, Secteur des marques et des dessins et modèles

Tomoko Miyamoto, chef, Section du droit des brevets et des traités, Division du droit des brevets et de la technologie, Secteur des brevets et de la technologie

Xavier Vermandele, conseiller juridique principal, Division de la promotion du respect de la propriété intellectuelle, Secteur des enjeux et des partenariats mondiaux

Michele Woods, directrice, Division du droit d'auteur, Secteur du droit d'auteur et des industries de la création

Liste des abréviations

AB-1977	Accord relatif à la création d'une Organisation africaine de la propriété intellectuelle conclu à Bangui le 2 mars 1977	CPP	Code de procédure pénale
ABR-1999	Accord de Bangui, tel que révisé le 24 février 1999	CSR	Commission supérieure de recours
ABR-2015	Accord de Bangui, tel que révisé le 14 décembre 2015	D.	Dalloz
ADPIC	Accord sur les aspects des droits de propriété intellectuelle qui touchent au commerce	dir.	Sous la direction
aff.	Affaire	éd.	Édition
al.	Alinéa	ex.	Exemple
Ann. prop. ind.	Annales de la propriété industrielle, artistique et littéraire	fasc.	Fascicule
art.	Article	Gaz. Pal.	Gazette du Palais
AUDCG	Acte uniforme OHADA portant sur le droit commercial général	Ibid.	Ibidem
AUPSRVE	Acte uniforme portant sur l'organisation des procédures simplifiées de recouvrement et des voies d'exécution	ICC	The International Review of Intellectual Property and Competition Law
BOPI	Bulletins officiels de la propriété industrielle	INPI	Institut national de la propriété industrielle (France)
BRDA	Bulletin rapide de droit des affaires	IRPI	Institut de recherche en propriété intellectuelle
Bull.	Bulletin	JCP E	JurisClasseur entreprise
Bull. civ.	Bulletin civil	JCP G	JurisClasseur périodique, édition générale
CA	Cour d'appel	JO	Journal officiel
c.	Contre	JORF	Journal officiel de la République française
Cah. dr. auteur	Cahiers du droit d'auteur	Juriscl.	JurisClasseur
Cass. ass. plén.	Cour de cassation – Assemblée plénière	LGDJ	Librairie générale de droit et de jurisprudence
Cass. civ.	Chambre civile de la Cour de cassation française	LPA	Les Petites Affiches
Cass. com.	Chambre commerciale de la Cour de cassation française	OAMPI	Office africain et malgache de la propriété industrielle
Cass. req.	Chambre des requêtes de la Cour de cassation française	OAPI	Organisation africaine de la propriété intellectuelle
Cass. soc.	Chambre sociale de la Cour de cassation française	obs.	Observation
CCJA	Cour commune de justice et d'arbitrage	OHADA	Organisation pour l'harmonisation en Afrique du droit des affaires
CE	Commission européenne	OHMI	Office de l'harmonisation dans le marché intérieur
Cf	Confer	op. cit.	opus citatum
civ.	Civil	p.	Page
CJCE	Cour de justice des Communautés européennes	par.	Paragraphe
COCC	Code des obligations civiles et commerciales (COCC)	PIBD	Propriété industrielle – Bulletin Documentaire
Comm.	Communication	pp.	Pages
CPI	Code de la propriété intellectuelle (France)	Préc.	Précité
		Prof.	Professeur
		Prop. Ind.	Propriété industrielle
		PTPI	Président du tribunal de première instance
		PUF	Presses universitaires de France
		RAPI	Revue africaine de la propriété intellectuelle
		Req.	Requête
		RD propr. intell.	Revue de droit de la propriété intellectuelle

RFPI	Revue francophone de la propriété intellectuelle
RIPIA	Revue internationale de la propriété industrielle et artistique
RIDA	Revue internationale de droit d'auteur
RID comp	Revue internationale de droit comparé
RLDA	Revue Lamy droit des affaires
RTD com	Revue trimestrielle de droit commercial
s.	Suivant
Somm.	Sommaire
Ss	Suivants
TGI	Tribunal de grande instance
TPI	Tribunal de première instance
UEMOA	Union économique et monétaire ouest-africaine
Vol.	Volume
WCT	Traité de l'Organisation Mondiale de la Propriété Intellectuelle sur le droit d'auteur
WIPO/OMPI	Organisation Mondiale de la Propriété Intellectuelle
WPPT	Traité de l'Organisation Mondiale de la Propriété Intellectuelle sur les interprétations et exécutions et les phonogrammes

Présentation de l'OAPI

L'Organisation africaine de la propriété intellectuelle (OAPI) est une institution internationale intergouvernementale, œuvrant dans le domaine de la propriété intellectuelle. Institution créée le 13 septembre 1962 par la Convention de Libreville révisée et dénommée aujourd'hui l'Accord de Bangui, l'OAPI a son siège à Yaoundé, République du Cameroun, et compte à nos jours 17 États membres, à savoir : Bénin, Burkina Faso, Cameroun, République centrafricaine, Congo, Côte d'Ivoire, Gabon, Guinée, Guinée Bissau, Guinée équatoriale, Mali, Mauritanie, Niger, Sénégal, Tchad, Togo et Union des Comores.

Dans le cadre de la mise en œuvre de ses missions, l'Organisation :

- délivre les titres de propriété industrielle relatifs aux brevets, modèles d'utilités, marques de produits et de services, dessins et modèles industriels, noms commerciaux, indications géographiques et obtentions végétales;
- assure la publication des titres de propriété industrielle;
- promeut la créativité et le transfert de technologie;
- encourage l'exploitation des inventions et innovations;
- assure la formation en propriété intellectuelle;
- mène des activités dans le cadre de la promotion de la protection de la propriété littéraire et artistique, des expressions culturelles traditionnelles et des savoirs traditionnels.

L'Accord de Bangui est la législation uniforme de tous les États membres de l'OAPI. Elle est la loi nationale de chacun des États membres en matière de propriété intellectuelle. Cet accord crée un office commun : l'OAPI. Les procédures sont centralisées : une demande adressée à l'Organisation est déposée soit directement à son siège, soit par l'entremise du ministère chargé de la propriété industrielle dans chaque État membre. Ce dépôt a valeur de dépôt national dans chacun des États membres. Un seul titre est délivré sur la base d'une seule demande.

Les titres délivrés par l'Organisation sont valables sur le territoire de tous les États membres. Il n'y a pas de systèmes nationaux de délivrance des titres qui coexistent avec le système régional. Ce système est en accord avec les principales conventions internationales régissant la propriété intellectuelle. La gestion collective des droits d'auteurs est confiée à des organismes de gestion collective dans les États membres. Les litiges portant sur les titres de propriété intellectuelle et les atteintes aux droits conférés sont portés devant les juridictions des États membres.

Maurice Batanga

Directeur des affaires juridiques
OAPI

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Chapitre 1

Théorie générale de la propriété intellectuelle

A. Rapports entre l'Organisation africaine de la propriété intellectuelle (OAPI) et les juridictions nationales des États membres – Absence d'obligation de saisir la Commission supérieure de recours de l'OAPI avant d'accéder aux juridictions nationales – Compétence des instances administratives et judiciaires – Préséance des décisions judiciaires

La compétence des instances administratives de règlement des litiges de l'Organisation africaine de la propriété intellectuelle (OAPI) n'affecte nullement celle des juridictions nationales des États membres qui ont une compétence concurrente. Dès lors, la saisine de ces juridictions n'est pas subordonnée à l'épuisement des recours internes à l'OAPI et les décisions rendues par ces instances ne peuvent être déférées devant les juridictions nationales dont les décisions priment en vertu des dispositions de l'Accord de Bangui de 1977 relatif à la création d'une Organisation africaine de la propriété intellectuelle portant révision de l'accord portant création d'un Office africain et malgache de la propriété industrielle (Accord de Bangui ou AB-1977), tel que révisé en 1999 (ABR-1999) et en 2015 (ABR-2015).

Tribunal de grande instance du Wouri (Douala), Jugement COM n° 7 du 5 janvier 2012, ARLA FOODS AMBA c. DANA HOLDINGS LIMITED

Observations :

Patates chaudes? Telle est la question qu'on pourrait se poser au sujet des nombreux et intéressants débats juridiques soulevés par les parties à l'occasion du litige opposant la société Arla Foods Amba à une autre, Dana Holdings Limited, et qui ont été quasiment tous éludés par le juge.

Faits : Les faits de l'espèce ne présentaient aucune originalité par rapport aux conflits habituels qui naissent en droit des marques. En effet, la société Arla Foods est titulaire de la marque verbale "Dano", enregistrée sous le numéro 36147 sur le territoire de l'OAPI depuis le 24 mars 1996 pour les produits des classes 5, 29 et 30. Le 30 novembre 2004, la société Dana Holdings Ltd dépose deux signes voisins, la marque verbale "Dana" enregistrée sous le numéro 50961 pour les produits des classes 5, 16, 29 et 30 et la marque figurative "Dana & Device" enregistrée sous le numéro 50962 pour les produits des classes 5, 16, 29 et 30. La société Arla Foods formule alors une opposition après l'enregistrement de ces deux marques devant l'OAPI qui rend deux décisions.

Dans une première rendue sous le n° 00090/DG/SCAJ du 30 juin 2007, elle prononce la radiation de la marque Dana. Dans une seconde sous le n° 00091/DG/SCAJ du même jour, elle rejette l'opposition à l'enregistrement de la marque "Dana & Device". La simplicité de ces faits est déconcertante lorsqu'on découvre les débats qui sont nés postérieurement devant le juge saisi du litige. En effet, non satisfaite de la décision rendue par l'OAPI en ce qui concerne la marque maintenue, Arla Foods demande au tribunal de grande instance du Wouri à Douala (Cameroun) d'en prononcer la nullité.

Raisonnement : La procédure devant cette juridiction a donné lieu à d'importants débats théoriques, plus ou moins occultés par le juge qui a préféré s'en tenir à l'essentiel dans un jugement comportant pas moins de 24 rôles, et dans lequel se sont glissées des expressions susceptibles d'induire en erreur le lecteur non familier au droit de l'OAPI¹.

À la lecture des motifs spécifiques de la décision, la seule question de cette nature qui a été expressément évoquée et, sans motivation aucune du juge, est celle de l'instance compétente pour prononcer la nullité d'un enregistrement effectué par l'OAPI. Dans cette perspective, en affirmant sa compétence et donc celle des juridictions nationales, le tribunal s'est prononcé sur l'un des cas d'ouverture à ladite nullité, à savoir pour le cas d'espèce, l'atteinte à un droit antérieur et l'existence subséquente d'un risque de confusion. Cette question n'aurait, à vrai dire, présenté aucun intérêt en elle-même si elle ne s'inscrivait pas dans le cadre d'une affaire contenant des débats d'une grande finalité didactique. De fait, elle se situe dans la principale problématique qui était en jeu dans le cas d'espèce et qui peut se construire autour des rapports entre les instances administratives internes de règlement des litiges à l'OAPI et les juridictions nationales.

Cette problématique globale comporte plusieurs questions secondaires, toutes dignes d'intérêt, dont :

- I. la compétence en matière d'opposition, de radiation et de nullité;
- II. la prise d'effet des décisions rendues par le directeur général; et
- III. les voies de recours contre les décisions prises par les instances en charge du contentieux au sein de l'OAPI.

¹ Par exemple, d'une part, le jugement évoque "le président de l'OAPI" alors qu'il fait allusion au directeur général de cette institution; d'autre part, il vise le "jugement de l'OAPI" alors qu'il s'agit simplement de décisions rendues par ce directeur général.

I. La compétence en matière d'opposition, de radiation et de nullité

La question de la compétence pour connaître des litiges relatifs à la nullité et de la radiation a été au cœur d'un grand débat dans l'affaire examinée par le tribunal de grande instance du Wouri. Concrètement, il était question de savoir si la compétence pour connaître des oppositions, de la nullité et de la radiation relevait du domaine des juridictions des États membres ou si elle appartenait uniquement à l'OAPI. Le débat était né de ce que grâce aux deux décisions précitées, l'OAPI avait prononcé la radiation d'une marque et rejeté une opposition et de ce que par la suite, l'un des protagonistes avait saisi une juridiction pour contourner la décision de rejet, en sollicitant l'annulation de la marque que le rejet de l'opposition validait implicitement². La situation était donc assez particulière, même si les faits étaient familiers et les solutions plus ou moins attendues. En effet, la situation évoque plusieurs aspects juridiques.

D'une part, aucune partie n'a formé de recours contre les décisions rendues par le directeur général de l'OAPI devant la Commission supérieure de recours, ce qui pouvait laisser croire, a priori, qu'elles avaient toutes acquiescé à ces décisions. D'ailleurs, c'est cette absence de recours que soulève le défendeur à l'instance devant le tribunal, estimant que le recours devant la Commission supérieure de recours aurait dû être formé avant toute saisine éventuelle d'un tribunal national. D'autre part, devant ce tribunal, le demandeur va plus loin et se prévaut des constatations contenues dans la décision du directeur général de l'OAPI, devant le tribunal.

Sur le premier aspect, il importe de réaffirmer que l'exercice du recours interne à l'OAPI par le biais de la saisine de la commission sus-évoquée ne saurait constituer un préalable à l'introduction d'une procédure judiciaire. Cette affirmation peut être aisément justifiée par l'autonomie des contentieux administratifs et judiciaires concernant les titres de propriété industrielle. D'ailleurs, dans une affaire postérieure à celle commentée, la même juridiction a eu l'occasion d'affirmer, là aussi implicitement, la compétence concurrente entre les organes de l'OAPI et les juridictions nationales³. En effet, l'une des parties à ce litige avait soulevé l'irrecevabilité de la demande en justice, au motif que les délais pour faire opposition à l'enregistrement d'une marque étaient expirés. Le tribunal a clairement relevé que les fondements juridiques des deux actions étant différents, les délais prévus pour cette opposition ne sauraient s'appliquer à l'action judiciaire. À partir

de ce raisonnement, il est clair pour le juge que la procédure interne à l'OAPI ne saurait interférer avec celle susceptible d'être introduite devant une juridiction.

Sur le second aspect, il s'agit d'un argument d'opportunité bien choisi, dans la mesure où, bien souvent, le contentieux judiciaire est postérieur à la procédure administrative. En effet, il est aisé par exemple, dans un litige en contrefaçon ou en concurrence déloyale, d'invoquer à son profit une décision rendue par le directeur général ou par la Commission supérieure de recours, qui serait basée sur la violation d'un droit antérieur ou sur l'existence d'un risque de confusion qui en serait ou non la conséquence. Cette dernière hypothèse s'est d'ailleurs présentée devant la cour d'appel de Lomé⁴. Dans une espèce intéressante, l'intimé revendique reconventionnellement la propriété d'une marque enregistrée par l'appelant après lui, alors que le dépôt de ce dernier était fondé sur un enregistrement antérieurement effectué à l'étranger par son cocontractant. Cet appelant a alors invoqué avec succès la décision du directeur général de l'OAPI portant radiation de l'enregistrement de l'intimé, pour faire écarter la revendication de propriété par l'intimé et pour soutenir son action en contrefaçon.

Dans une autre affaire ouverte devant le tribunal de grande instance de Douala en 2007, le juge a beaucoup plus clairement laissé apparaître l'influence des décisions des instances de l'OAPI sur le contentieux judiciaire⁵. En effet, parallèlement à la procédure judiciaire ouverte devant lui pour contrefaçon et concurrence déloyale, le demandeur avait fait opposition à l'enregistrement de la marque litigieuse devant le directeur général de l'OAPI. Ce dernier avait alors rejeté cette opposition et, par la suite, le juge, s'appuyant sur la décision de rejet, a estimé que le directeur général n'ayant reconnu aucun droit au demandeur, celui-ci ne pouvait poursuivre l'adversaire en contrefaçon ou en concurrence déloyale. La question, à l'évidence, était alors de savoir si l'échec de la procédure d'opposition devant l'OAPI devait fonder le rejet automatique de l'action en contrefaçon et concurrence déloyale intentée parallèlement devant les tribunaux contre l'auteur de l'enregistrement contesté⁶.

À l'évidence, en dépit du regard bienveillant que les juridictions peuvent accorder aux décisions émanant de l'OAPI, il est clair que les deux catégories de contentieux doivent pouvoir conserver leur autonomie. Celui devant l'OAPI conformément à l'article 18 de l'annexe III de l'ABR-1999 et celui devant le tribunal conformément à l'article 24 de ladite annexe. Bien plus, dès lors que la

2 Sous ABR-2015, la question ne se pose pas dans les mêmes termes. En effet, l'opposition doit être formulée après la publication de la demande, ce qui permet d'empêcher l'enregistrement et éventuellement la délivrance du titre. Une annulation administrative suivant une procédure interne à l'OAPI est donc initiale. L'OAPI n'interviendra qu'après qu'une juridiction interne d'un État membre aura rendu une décision. Il n'en va différemment que pour la dénomination d'une variété végétale dont la radiation demeure possible après l'enregistrement. Cf. art. 30 de l'annexe X de l'ABR-2015.

3 Voir TGI du Wouri (Douala), Jugement civil n° 382/Com du 23 décembre 2013, *Société Marine Magistrale SA c. Sieur Kamga Nenkam Jean Paul* (obs. FADE (A.), ce recueil, chapitre 3, section N).

4 Cour d'appel de Lomé, Arrêt n° 70/15 du 4 mars 2015, *Gnanhoue Nazaire c. Établissement Solo* (obs. LAMOTTE (M.), ce recueil, chapitre 3, section I).

5 TGI du Wouri (Douala), Jugement n° 218 du 19 septembre 2007, *Société R.M. & Co Limited c. Société C.D.M. (SCDM)* (obs. NDEMA ELONGUE (M-L), ce recueil, chapitre 3, section E).

6 De même, une cour d'appel a estimé qu'en matière de marques, l'OAPI était "l'organe institutionnel de contrôle et d'enregistrement des marques", et que son appréciation du risque de confusion pouvait servir d'argument pour rejeter les prétentions de l'appelant qui estimait que ce risque existait : Cour d'appel du Centre (Yaoundé), Arrêt n° 536/Civ du 6 novembre 2013, *The Independent Tobacco FZCO c. Rothmans of Pall Mall Ltd* (obs. NDEMA ELONGUE (M-L), ce recueil, chapitre 3, section Q).

loi accorde la primauté aux décisions juridictionnelles suivant les dispositions de l'article 18 de l'accord⁷, les juridictions pourraient s'inspirer des décisions des instances administratives de l'OAPI, sans considérer que les éléments qu'elles contiennent prouvent à suffisance les faits contestés devant elles.

II. La prise d'effet des décisions rendues par le directeur général de l'OAPI en matière de radiation

La question du moment de la prise d'effet des décisions rendues par le directeur général de l'OAPI en matière de radiation, et soulevée dans l'affaire Arla Foods, est digne d'intérêt. En effet, dans ses écritures, Dana Holdings a relevé "qu'aucune décision déclarant l'enregistrement de la marque 'Dana' nul et non avenu n'a jamais été communiquée à l'Organisation africaine de la propriété intellectuelle". Ce raisonnement conduit à s'interroger sur le moment de la prise d'effet des décisions du directeur général de l'OAPI en matière de radiation. Autrement dit, celles-ci prennent-elles effet immédiatement ou doivent-elles être soumises en vue de leur validation éventuelle à un juge national? La question est d'autant plus intéressante que la partie qui soulève cet argument le confronte avec un jugement éventuel qui prononcerait la nullité. Par ailleurs, elle est intéressante parce qu'elle pourrait se poser à l'égard d'autres titres de protection dont la radiation pourrait être prononcée par le directeur général de l'OAPI et que la jurisprudence de cet espace est encore balbutiante. En effet, un juge a d'ailleurs pu déclarer que : "l'article 18 de l'ABR qui fait prévaloir la primauté de l'autorité et l'indépendance des décisions judiciaires (...) soumet les organes dirigeants de l'OAPI à la censure des Tribunaux civils dans leurs actes et décisions relatives à la mise en œuvre des instruments de protection de la propriété industrielle"⁸. Interprétée à la lettre, la pensée de ce juge pourrait conduire à croire que les décisions rendues par le directeur général et la Commission supérieure de recours sont susceptibles d'être "censurées" par les juridictions et donc attaquées devant elles.

Pour répondre à ces différents aspects, il convient, à titre préalable, d'établir une distinction théorique entre ces notions dont le résultat est l'anéantissement d'un droit de propriété industrielle dont la naissance était souhaitée par le déposant.

- En ce qui concerne la radiation, celle-ci tend à obtenir la suppression de la protection du registre qui la constate afin d'en neutraliser les effets de droit.
- Quant à la nullité, elle est définie de manière classique, comme la sanction qui frappe un acte juridique irrégulièrement formé.

D'ailleurs, on peut ajouter à ces deux concepts un autre qui est assez fréquemment employé en matière de propriété industrielle : il s'agit de la déchéance, laquelle

doit s'entendre comme "la perte d'un droit, soit à titre de sanction, soit en raison du non-respect des conditions d'exercice de ce droit"⁹.

L'annulation, on s'en doute, ne relève que de la compétence des juridictions nationales des États membres de l'OAPI. Pour le confirmer, il faut d'abord affirmer que, de manière générale, ce sera au juge de procéder à la constatation des irrégularités de fond ou de forme qui auraient émaillé la procédure ayant abouti à la création du droit constaté par le titre de propriété industrielle. Tel serait le cas, lorsque :

- l'objet dont le titre a été délivré n'est pas conforme audit titre (par exemple un brevet ne peut protéger qu'une invention; un certificat d'obtention végétale, une obtention végétale, etc.);
- une description n'est pas conforme;
- il n'y a pas de lien de rattachement entre un objet protégé et les certificats subséquents¹⁰;
- la protection a été octroyée alors que l'objet est exclu du domaine de la propriété intellectuelle¹¹.

Tel serait aussi l'ensemble des hypothèses où l'accord invite le juge à constater la nullité¹². Tout particulièrement, en matière de marques, celle-ci peut être annulée, selon l'article 24, alinéa 2, lorsqu'elle n'est pas conforme aux exigences des articles 2 et 3 de l'annexe III (Actes de 1999 et de 2015), c'est-à-dire particulièrement lorsqu'elle n'est pas distinctive, elle porte atteinte à un droit antérieur, elle est déceptive, elle imite ou utilise des signes officiels, etc. Précisément, c'est parce que les marques "Dano" et "Dana & Device" étaient potentiellement en conflit avec un droit antérieur que le litige est né. Mais ce qui l'a complexifié, c'est d'abord le chevauchement créé par l'acte de 1999 de l'Accord de Bangui, entre les causes de nullité et les causes de radiation¹³. En effet, si les causes ci-dessus citées émanant de l'article 24 constituent bien des cas d'ouverture à la nullité dont l'examen relève de la compétence des juridictions nationales des États membres, ces mêmes causes ouvrent droit à la radiation administrative dont la procédure va de la décision du directeur général jusqu'à la Commission supérieure de recours éventuellement saisie d'un recours contre ladite décision.

⁷ Cf. art. 20 de l'ABR-2015.

⁸ Voir TPI de Yopougon (Côte d'Ivoire), Jugement civil n° 187 du 21 mars 2013, *Sivop SA c. Société Angel cosmetics SA* (obs. NDEMA ELONGUE (M-L), ce recueil, chapitre 3, section L).

⁹ Cf. GUINCHARD (S.) et DEBARD (Th.) (éds.), *Lexique des termes juridiques*, 25^e éd., Paris (Dalloz), 2017.

¹⁰ Cette cause particulière de nullité résulte de l'art. 39 al. 2 de l'annexe I et l'art. 34 al. 2 de l'annexe II de l'ABR-1999. Elle signifie que si un certificat a été délivré pour tenir compte des modifications, améliorations ou additions apportées à un brevet d'invention ou à un modèle d'utilité, il faut que la modification, l'amélioration ou l'addition se rattache effectivement à cette invention ou à ce modèle d'utilité. À défaut d'un tel rattachement, le titre ultérieur peut être déclaré nul.

¹¹ Par ex., dans l'ABR-1999 : art. 6 de l'annexe I, art. 2 al. 4 de l'annexe IV et art. 1 al. 2 de l'annexe IV. Dans l'art. 2 de l'ABR-2015, la liste des exclusions expresses en matière de brevets a été raccourcie, grâce à la révision de l'art. 1, qui définit le concept d'invention.

¹² On pense particulièrement à l'inobservation d'une exigence prescrite sous peine de nullité et à la constatation d'une disposition invalide. Voir, par exemple, ABR-2015, art. 11 al. 4 et art. 36 al. 2 de l'annexe I et art. 6 al. 4 de l'annexe IV.

¹³ Ce chevauchement a été corrigé dans l'ABR-2015. La radiation judiciaire n'existe plus en tant que sanction autonome telle qu'elle ressortait de l'art. 23 de l'ABR-1999. Désormais, la radiation devrait être une simple opération consécutive à la déchéance prononcée, par exemple du fait de l'inutilisation de la marque pendant cinq ans.

Ce qui a, ensuite, complexifié le litige c'est l'existence, semble-t-il, de deux types de radiations, dont l'une est administrative et l'autre judiciaire. Cependant, la distinction entre les deux types de radiations est aisée à établir; d'ailleurs, ce n'est pas cette distinction qui posait problème dans le cas d'espèce.

- La *radiation administrative* est prononcée par le directeur général de l'OAPI et éventuellement confirmée par la Commission supérieure de recours. Elle intervient après une opposition formulée contre l'enregistrement du titre, en l'occurrence la marque. La procédure de cette opposition est organisée par l'article 18 de l'annexe III. Selon ce texte, il s'agit d'une instance administrative contradictoire. Une fois la décision prononcée, la partie intéressée dispose d'un délai de trois mois à compter de la réception de la notification de cette décision, pour l'attaquer devant la Commission supérieure de recours.
- Quant à la *radiation judiciaire*, elle est régie par l'article 14 de l'annexe VI et en matière de marques par l'article 23 de l'annexe III de l'Acte de 1999 de l'Accord de Bangui. Cette disposition de l'annexe III précise que cette radiation ne peut intervenir qu'en cas de non-utilisation pendant une durée ininterrompue de 5 années précédant l'action.

Il en découle que les deux formes de radiation sont assez distinctement organisées.

Il reste que le débat, dans le cas d'espèce, semble avoir été obscurci par la possibilité d'utiliser les mêmes causes pour obtenir soit la radiation, soit la nullité. Cet obscurcissement se manifeste dans le fait que dans ses conclusions, la société "Dana Holdings" déclare "qu'aucune décision déclarant l'enregistrement de la marque Dana nul et non avenu n'a jamais été communiquée à l'Organisation, relativement à l'article 24...". Cet argument est surprenant dès lors que, dans cette espèce, une décision du directeur général a déclaré cet enregistrement nul. Essayait-il d'amener le juge saisi à décider que la décision du directeur général, non frappée en l'espèce de recours, ne devait prendre effet qu'à compter du prononcé d'une décision judiciaire rendue dans une instance en annulation de ladite marque? La réponse est affirmative selon toute vraisemblance. En effet, dans la logique de cet argumentaire, lorsque le directeur général de l'OAPI prononce la radiation, celle-ci doit encore faire l'objet d'une validation par une juridiction nationale dont la décision doit, ensuite, être notifiée à l'OAPI.

Pourtant, une orientation contraire s'impose. L'Organisation africaine de la propriété intellectuelle est une personne morale de droit international dont les décisions ne peuvent être justiciables devant les juridictions nationales de ses États membres. Celles-ci sont autonomes. Dans cette logique, elles sont d'application immédiate. Par conséquent, lorsqu'elle s'est prononcée dans un contentieux lié à la validité d'un titre, sa décision est définitive sous réserve de l'ouverture d'un autre contentieux devant les juridictions de l'ordre judiciaire.

III. Les recours contre les décisions rendues par le directeur général de l'OAPI en matière de radiation

On le voit, l'argumentaire développé devant le juge amène également à s'interroger sur la compétence pour connaître des recours formés contre les décisions rendues par l'OAPI en matière de radiation. La question des recours contre les décisions rendues par le directeur général de l'OAPI a été fort débattue, même si, à la déception du commentateur, le juge ne s'en est pas saisi.

Ainsi qu'il a déjà été relevé, les décisions relatives à la radiation et à la déchéance sont prononcées par le directeur général de l'Organisation. D'après les dispositions des différentes annexes, les parties peuvent alors former un recours contre ces décisions devant la Commission supérieure de recours. Là est une évidence. Ce qui l'est moins, c'est la situation dans laquelle une des parties cherche à contourner le rejet prononcé par le directeur général, en sollicitant une annulation devant une juridiction nationale et d'autre part, d'imaginer que la saisine d'une juridiction nationale est subordonnée à celle préalable de la Commission sus-évoquée.

Ces deux orientations proposées au tribunal tirent leur source d'un maniement intelligent du droit OAPI. En effet, dans le cas d'espèce, le directeur général avait prononcé la radiation de la marque "Dana" et avait rejeté l'opposition de l'entreprise Arla Foods en ce qui concernait la marque "Dana & Device", ce qui revenait à valider l'existence de ladite marque. Les deux décisions auraient pu être attaquées devant la Commission, mais aucune partie n'a fait recours. Et, devant le tribunal, la défenderesse se prévalait de ce que l'absence de recours devant ladite Commission valait acquiescement et estimait que cette absence était de nature à constituer une fin de non-recevoir devant le tribunal.

En ce qui concerne la subordination de la saisine d'une juridiction nationale à l'exercice préalable du recours devant la Commission supérieure de recours, aucune disposition de l'accord ou de l'une des annexes ne la prévoit. Ce silence est compréhensible, dans la mesure où, comme il a été relevé, les décisions de cette Organisation sont autonomes et exécutoires. Le juge, bien qu'il ne se soit pas prononcé sur cette question, a retenu sa compétence alors qu'il n'y avait pas eu un tel recours; il reconnaissait ainsi implicitement que ce recours n'était pas nécessaire à l'ouverture de sa saisine.

En ce qui concerne le contournement du rejet de l'opposition par la saisine d'une juridiction nationale, il faut reconnaître qu'il s'agit d'une seconde chance que tentait de s'octroyer l'entreprise Arla Foods en vue d'obtenir l'annulation de la marque implicitement validée. De surcroît, devant la juridiction saisie, cette entreprise s'est prévaluée des constatations de la décision du directeur général. En effet, dans son argumentaire, elle estime "qu'il est définitivement acquis par décisions inattaquables qu'il existe une ressemblance phonétique entre "Dano" du demandeur et "Dana" de la défenderesse" et que sur la base de cette ressemblance, l'annulation de la marque "Dana & Device" doit être

prononcée. La démarche est assez opportuniste et juridiquement imparable, car aucun texte n'interdit qu'après le rejet d'une opposition formulée à la suite d'un enregistrement, voire qu'après une décision dans le même sens rendue par la Commission supérieure de recours sur ledit rejet, la partie adverse tente d'obtenir l'annulation de la marque implicitement consolidée devant une juridiction nationale. Peut-on alors lui opposer l'autorité de chose jugée?

La question de l'autorité de la chose jugée est pertinente en l'espèce et peut l'être également dans d'autres domaines de la propriété industrielle, pour deux raisons. D'une part, la procédure ouverte devant les instances internes de l'OAPI est une instance en radiation tandis que celle ouverte devant la juridiction est une instance en annulation. Techniquement, les deux litiges n'ont pas le même objet, même s'ils sont fondés sur la même cause. D'ailleurs, c'est tout naturellement que le juge de Douala a examiné la demande d'annulation et s'est prononcé en faveur de la nullité sollicitée. Autrement dit, il ne s'est nullement interrogé sur la procédure interne à l'OAPI, bien que celle-ci ait fait l'objet de vifs débats dans les conclusions des parties. D'autre part, comme il a déjà été relevé, les instances de règlement des litiges de l'OAPI sont des instances purement administratives, y compris la Commission sus-évoquée dont la nature a été quelquefois discutée¹⁴. Il en découle que les décisions rendues par ces instances ne sauraient avoir autorité de chose jugée pour la juridiction saisie du litige.

Finalement, les décisions de l'OAPI peuvent être aisément contournées. En effet, dans l'exercice normal de leur droit, les parties peuvent non seulement s'abstenir de saisir la Commission supérieure de recours après une décision du directeur général, mais aussi, même après la saisine ladite Commission, la partie insatisfaite peut recommencer la procédure devant une juridiction nationale. De surcroît, rien, non plus, ne s'oppose à ce que pendant la procédure devant les instances administratives de l'OAPI, la partie qui estime y avoir intérêt puisse attirer l'autre devant un tribunal lorsque les circonstances le permettent. Particulièrement, en matière de marques, dès lors que le conflit avec un droit antérieur matérialisé par l'existence éventuelle d'un risque de confusion est en cause, la voie judiciaire est royalement ouverte. Au total, il en découle que le juge national peut être saisi, aussi bien avant, pendant ou postérieurement à la saisine des instances administratives de l'OAPI. Cependant, en sens inverse, il apparaît clairement que la saisine des instances administratives de l'OAPI ne présente plus aucune utilité lorsqu'une juridiction est saisie du litige, dès lors que les décisions juridictionnelles s'imposent à l'OAPI en application de l'article 18 de l'Accord de Bangui, Acte de 1999¹⁵.

En fin de compte, on peut tout de même regretter que l'on ne puisse disposer de moyens juridiques susceptibles d'éviter un contournement aussi aisé des décisions rendues par les instances internes de l'OAPI. Celles-ci, en particulier celles de la Commission supérieure de recours, contribuent à leur manière et ce, indépendamment des tribunaux, à uniformiser certains aspects du Droit OAPI.

Joseph Fometeu

B. Arbitrage en matière de propriété intellectuelle – Application du droit OHADA – Désignation du collège arbitral – Diffusion de films – Paiement de la rémunération

Les parties à un contrat peuvent opter pour le recours à l'arbitrage en vue de la résolution d'un litige relevant du droit d'auteur. Dans ce cadre, le juge judiciaire saisi de la mise en place du collège arbitral est tenu de respecter les termes de la clause compromissoire. Par la suite, ce collège est tenu de statuer sur tous les aspects du litige qui lui est soumis et de s'abstenir d'en renvoyer au juge judiciaire. Dès lors statue *infra petita* le collège arbitral qui tranche la question de la redevance due et renvoie au juge judiciaire les autres questions.

Cour suprême du Congo, Arrêt n° 07/GCS.02 du 17 mai 2002, LINDA COMMUNICATIONS c. MIC VIDEO

Observations :

Le recours aux modes alternatifs de règlement des litiges n'est pas courant en matière de propriété intellectuelle en Afrique. C'est la raison pour laquelle l'arrêt rendu par la Cour suprême du Congo le 17 mai 2002 présente un intérêt certain.

Faits : La société LINDA COMMUNICATIONS a conclu un contrat d'exclusivité avec les établissements MIC-VIDEO. Grâce à ce contrat, MIC-VIDEO met à la disposition de la chaîne de télévision CANAL Océan appartenant à LINDA COMMUNICATIONS des cassettes de films en vue de la diffusion pour les abonnés. En contrepartie, cette dernière s'engage à verser une rémunération égale à 50% des recettes brutes provenant des abonnements payés par la clientèle de la chaîne CANAL Océan. Par ailleurs, une clause du contrat prévoit que tous les litiges qui pourraient survenir seraient soumis à un tribunal arbitral choisi d'un commun accord par les parties.

Malheureusement, l'exécution de la convention ne se déroule pas comme attendu. Entre autres, à la suite de la réclamation de l'entreprise fournisseur des cassettes, les parties ne parviennent pas à s'accorder sur les modalités de calcul de la rémunération due. C'est ce qui fonde la saisine du tribunal de commerce de Pointe-Noire par cette entreprise. Devant cette juridiction, un "collège arbitral" de trois membres est constitué. Celui-ci statue sur la cause et se prononce par une sentence dont l'existence et le contenu sont contestés par LINDA COMMUNICATIONS. En effet, cette entreprise estime,

14 Considérant qu'il s'agit d'un organe judiciaire : BIYO'O (R.G.), La protection des marques de produits dans l'espace de l'Organisation africaine de la propriété intellectuelle, mémoire de Diplôme d'études supérieures spécialisées (DESS), Université de Douala - Cameroun, 2004. Disponible en ligne à l'adresse <http://www.memoireonline.com>.

15 Cette règle a été reprise par l'art. 20 de l'ABR-2015.

d'une part, que le collège arbitral est incompétent pour statuer sur le litige dans la mesure où il n'est pas l'émanation de l'accord des parties, mais plutôt de celle du tribunal saisi d'une requête unilatérale du demandeur. D'autre part, elle estime que dans le fond, plusieurs griefs peuvent être reprochés à la sentence rendue par le collège. Il s'agit, entre autres, de la violation de la loi, de la dénaturation du contrat, de la violation des règles de procédure, etc.

Raisonnement : Le litige est donc intéressant à plus d'un titre. En effet, il soulève au moins deux problèmes dont l'un est lié à la désignation des arbitres devant statuer sur un litige et l'autre, plus global, à certains aspects de l'office du juge arbitral. Cependant, il s'agit de problématiques très générales qui ne devraient être abordées que dans le cadre d'une analyse relative à l'arbitrage considéré en lui-même.

Dans le cas de l'affaire LINDA-COMMUNICATIONS, ces problèmes sont abordés en vue de résoudre le point de fait qui a généré le litige et qui intéresse particulièrement la propriété intellectuelle. Faut-il le rappeler, le litige est né à la suite de la réclamation de la rémunération due en contrepartie de l'exploitation des films par la chaîne de télévision CANAL Océan et, fait rare, il a été tranché par un arbitre, fût-il contesté. Autrement dit, le fait que les parties aient inséré une clause compromissoire dans leur contrat dont l'objet était l'exploitation d'un droit de propriété intellectuelle est suffisamment important pour mériter une certaine attention. Il donne l'occasion de confirmer qu'il est possible, dans le contexte du droit OAPI, de soumettre un litige de propriété intellectuelle à l'arbitrage (voir section I). Dans le cas d'espèce, le juge suprême congolais offre également l'occasion d'apporter des précisions utiles en ce qui concerne l'appréciation de la base de calcul des redevances dues au titre de l'exploitation d'un objet protégé (voir section II).

I. L'arbitrabilité des litiges de propriété intellectuelle dans l'espace OAPI

Il peut sembler superflu d'évoquer l'arbitrabilité des litiges de propriété intellectuelle dans la mesure où la question des rapports entre l'arbitrage et la propriété intellectuelle est bien ancienne. En effet, il s'agit d'une question que l'on peut considérer comme résolue, si l'on raisonne sur le champ du droit comparé. Comme l'a écrit Vivant, il ne subsiste en matière de propriété intellectuelle que "quelques îlots d'inarbitrabilité au milieu d'un océan d'arbitrabilité"¹⁶. Cependant, ces "îlots" ne sont pas bien nombreux, si l'on se réfère à l'étendue des pouvoirs de l'arbitre en matière de propriété industrielle (A) et en matière de propriété littéraire et artistique (B), ou si l'on s'intéresse au droit applicable en matière d'arbitrage des droits de propriété intellectuelle dans l'espace OAPI (C).

A. L'étendue des pouvoirs de l'arbitre en matière de propriété industrielle

Pour certains, l'arbitre peut statuer sur les droits résultant d'un titre de propriété industrielle, mais non pas sur le titre lui-même car, ce titre étant délivré par une autorité publique, la question liée à sa validité toucherait à l'ordre public¹⁷. Pour d'autres, l'arbitre peut statuer à la fois sur les droits et sur le titre lui-même. Toutefois, ils précisent que lorsque la validité du titre est en cause, l'arbitre n'est pas, à vrai dire, invité à se prononcer sur sa validité *erga omnes* mais plutôt sur l'opposabilité du titre entre parties. La sentence arbitrale est alors "assimilée à une convention de non-opposition"¹⁸ en ce qu'elle ne déploie ses effets que *inter partes*¹⁹. Dans le même sens, un arrêt de la Cour d'appel de Paris du 28 février 2008 a admis que l'arbitre puisse se prononcer sur la nullité d'un brevet soulevée de façon incidente, mais sa sentence, sur ce point, est dépourvue de l'autorité de chose jugée et n'a d'effet qu'entre les parties²⁰. Les deux questions sont juridiquement distinctes : la validité est un état de l'acte apprécié au moment de sa formation tandis que celle de l'opposabilité renvoie à l'efficacité du titre entre les parties²¹. La solution de l'arbitrabilité intégrale, même nuancée par le recours à la technique de l'inopposabilité, peut paraître satisfaisante pour l'esprit. En pratique, elle comporte de grands risques, notamment celui d'une contrariété de décisions entre un jugement et une sentence. En d'autres termes, si on admet une telle option, "on peut avoir des brevets efficaces *inter partes* aujourd'hui qui seraient susceptibles d'être anéantis demain par des décisions judiciaires"²². Pour ces raisons, il est préférable de refuser la soumission des litiges liés à la validité des titres aux juridictions, dans l'espace OAPI²³.

La possibilité pour la justice arbitrale de connaître du contentieux répressif et du contentieux des mesures provisoires propres à la propriété intellectuelle est également débattue. En ce qui concerne le premier, l'article 4, alinéa 1, *in fine* de l'Accord de Bangui, Acte de 2015, paraît avoir prohibé sa soumission précise à l'arbitrage. En effet, en décidant que les juridictions nationales sont "seules compétentes pour le contentieux pénal" afférent à la reconnaissance, à l'étendue ou à l'exploitation des droits prévus par l'accord et ses annexes, ce texte qui en réalité avait pour but d'ouvrir la voie à une possible création d'une juridiction supranationale de propriété intellectuelle et de réserver le contentieux répressif de la propriété intellectuelle aux juges nationaux pourrait s'interpréter comme ayant

16 VIVANT (M.), *Cherche litige non arbitral laborieusement* : Revue Lamy du droit des affaires, n° 72, 2004, p. 5.

17 BONET (G.) et JARROSSON (Ch.), *L'arbitrabilité des litiges de propriété industrielle en droit français : Arbitrage et propriété intellectuelle*, Publications de l'IRPI, Paris (Litec), 1994, p. 66.

18 TANKEU (J.), *Le recours aux modes alternatifs de règlement des litiges en matière de propriété intellectuelle*, Paris (L'Harmattan), 2018, pp. 228 et s.

19 Voir cependant, pour une admission de la validité *erga omnes* en France, en application de l'article L. 716-6 CPI : BINCTIN (N.), *Droit de la propriété intellectuelle*, 6^e éd., Paris (LGDJ), 2020, n° 1633.

20 Cour d'appel de Paris, 28.02.2008 : RTD com 2008, p. 516 (obs. LOQUIN (E.)).

21 CHIARINY-DAUDET (A.-C.), *Le règlement judiciaire et arbitral des contentieux internationaux sur brevets d'invention*, Bibliothèque de droit de l'entreprise, Paris (Litec), 2006, n° 531 et n° 699.

22 JOHNSON-ANSAH (A. J.), *Le concours de l'arbitrage à la protection de la propriété industrielle en Afrique francophone subsaharienne* : RFPI, n° 1, 2015, pp. 4-18.

23 En ce sens, voir *ibid.*

finalement créé une compétence exclusive au profit de ces juridictions. En ce qui concerne le contentieux des mesures provisoires, il faut relever, pour le cas spécifique de la saisie-contrefaçon, que la doctrine majoritaire estime que le prononcé de cette saisie par le tribunal arbitral "est moins évident, mais pas impossible"²⁴ et qu'il pourrait alors être préférable de saisir le juge judiciaire avant ou en parallèle avec la mise en œuvre de la procédure arbitrale²⁵.

Au-delà de ces divergences doctrinales, certains droits étrangers admettent que l'arbitre puisse se prononcer sur la nullité du titre et même sur l'action en contrefaçon. Aux États-Unis par exemple, la loi admet, de façon générale (*article 294 de la loi fédérale sur les brevets*), un principe d'arbitrabilité, y compris pour la validité du titre et pour la contrefaçon, même si l'effet de la sentence ne se produit qu'*inter partes*. Le droit belge va plus loin car il prévoit l'arbitrage pour les litiges relatifs aux brevets, en reconnaissant expressément que ce mode de règlement peut avoir un effet *erga omnes*²⁶. En France, plusieurs dispositions du Code de propriété intellectuelle évoquent expressément la possibilité d'un recours à l'arbitrage. Tel est le cas des articles L.331-1, L521-3-1 et L.615-17, respectivement consacrés au droit d'auteur et aux dessins et modèles et aux brevets. Dans l'ensemble, la formule utilisée est la même : après avoir affirmé la compétence des juridictions civiles pour les actions civiles et les demandes relatives à tel ou tel droit de propriété intellectuelle, y compris lorsque ces demandes portent sur une question connexe de concurrence déloyale, le Code précise qu'il ne s'agit nullement de "faire obstacle au recours à l'arbitrage".

B. L'étendue des pouvoirs du juge en matière de propriété littéraire et artistique

En matière de propriété littéraire et artistique particulièrement, la soumission des droits patrimoniaux à l'arbitrage n'a jamais été véritablement contestée²⁷, comme le démontre l'arrêt commenté dans lequel aucune remise en cause du principe n'a été relevée ni par une partie, ni par le juge. Le débat peut, plutôt, concerner les aspects répressifs de la violation de ces droits, qui ne devraient pas être arbitrables²⁸.

Quant au droit moral, il est inarbitrable dans l'espace OAPI²⁹. Cependant, la rigueur de l'inarbitrabilité des litiges relatifs au droit moral doit être nuancée. En effet, d'une part, l'arbitrabilité des conséquences des atteintes au droit moral n'est pas discutée, dès lors que les violations de ce droit sont susceptibles de se traduire en conséquences patrimoniales, lesquelles relèvent à l'évidence de la catégorie des droits dont on a la libre disposition. D'autre part, l'impossibilité de renoncer au droit moral, et donc son indisponibilité, ne sont pas absolues. En effet, la jurisprudence française admet sous certaines conditions, notamment le consentement de l'auteur, certaines renonciations. Il en est ainsi pour le droit au respect de l'œuvre et pour le droit de paternité³⁰. Certes, il s'agit alors d'une renonciation provisoire dans la mesure où l'auteur peut, à tout moment, révéler sa paternité; il n'en demeure pas moins qu'à partir de l'admission de ces renonciations qui constituent "une forme de patrimonialisation (du droit moral)"³¹, on ne peut plus poser un postulat général relatif à l'indisponibilité du droit moral. En conséquence, "l'arbitre pourrait valablement se prononcer dans le cadre d'une clause compromissoire, sur la validité ou l'invalidité de telles renonciations"³². Enfin, certains proposent que l'arbitrabilité du droit moral soit admise, en la mettant "en parallèle avec le mouvement de contractualisation" de ce droit³³.

Dans l'affaire LINDA COMMUNICATIONS, aucun débat ne s'est ouvert sur l'arbitrabilité des droits découlant du contrat. Seules étaient en cause la désignation du collège arbitral, et la violation par ce collège, d'un certain nombre de règles substantielles et de procédure. Parmi ces violations, il était reproché au collège arbitral d'avoir statué *infra petita*. Autrement dit, le collège arbitral s'était abstenu de se prononcer sur certains aspects qui auraient été présentés. Malheureusement, il est impossible, à la seule lecture de la décision, d'identifier ces aspects et, par conséquent, de savoir si c'est l'inarbitrabilité qui a fondé l'attitude de ce collège.

Toutefois, la rareté des sentences en ce domaine justifie que l'on s'interroge sur l'éventualité d'un débat qui aurait pu naître.

C. Le droit applicable en matière d'arbitrage des litiges de propriété intellectuelle

À ce sujet, il faut d'abord relever qu'une clause compromissoire était contenue dans un contrat d'exploitation des droits d'auteur et que le litige qui est né concernait uniquement le paiement de la redevance due au titre de l'exploitation du droit de représentation. Par conséquent, le droit en cause était parfaitement arbitral au regard du droit positif de l'espace OAPI. En effet, dans cet espace, au moment de la conclusion

24 TANKEU (J.), n.18.

25 Dans le même sens et sans aucune nuance, voir LUCAS (A.), Arbitrage et propriété intellectuelle, allocution lors de la conférence annuelle de la Faculté de droit de l'Université des Émirats arabes unis présentée au Emirates Centre for Strategic Studies and Research, 28-30 avril 2008.

26 COOK (T.), Les modes extrajudiciaires de règlement des litiges comme instrument d'application des droits de propriété intellectuelle, 27 janvier 2014. Disponible en ligne à l'adresse www.wipo.int/mdocs/wipo_ace_9/wipo_ace_9_3.

27 NGOMBE (L.Y.), Le droit d'auteur en Afrique, Paris (L'Harmattan), 1^{re} éd., 2004, n° 265.

28 Pour une opinion contraire, voir VIVANT (M.) et BRUGUIÈRE (J.M.), Droit d'auteur, Paris (Daloz), 2009, n° 1146. Ces auteurs concluent "sans réserve à l'arbitrabilité du contentieux de la contrefaçon". Voir sur l'ensemble du débat : RIVOIRE (M.), L'arbitrabilité du droit d'auteur : le cas du droit français, in : Revue de règlement des différends de McGill, Vol. 4 (2017-2018), 2017, pp. 43-64. Disponible en ligne à l'adresse <https://ssrn.com/abstract=3073874>.

29 Bien que, dans certains pays, les droits moraux puissent être arbitrés lorsqu'ils sont renonçables (et donc aliénables) par la loi. Voir par exemple art. 14 al.2 de la Loi canadienne sur le droit d'auteur (LRC (1985) ch. C-42).

30 LUCAS (A.) et LUCAS (H.-J.), Traité de la propriété littéraire et artistique, Paris (LexisNexis), 5^e éd., 2017, n° 545 et 614.

31 SIIRIAINEN (F.), Arbitrage, transaction et droit moral de l'auteur (Actes de Colloque), Paris (Daloz), 2012, pp. 99-116.

32 TANKEU (J.), n.18.

33 RIVOIRE (M.), n.28.

du contrat, le texte en vigueur en matière de propriété intellectuelle était l'AB, Acte de 1977 et, en matière d'arbitrage, le droit en vigueur résultait de l'Acte uniforme de l'Organisation pour l'harmonisation en Afrique du droit des affaires (OHADA) relatif au droit de l'arbitrage ainsi que de certaines dispositions du Code de procédure civile, commerciale, administrative et financière du Congo.

En ce qui concerne l'Accord de Bangui de 1977, il ne faisait aucune allusion expresse à la possibilité d'un recours à l'arbitrage. Néanmoins, cela ne doit pas être interprété comme signifiant qu'il s'y opposait. Il en découle que l'article 9 du contrat entre LINDA COMMUNICATIONS et MIC-VIDEO était parfaitement conforme à la loi. Dans son principe, la clause compromissoire qu'il contenait ne pouvait, en conséquence, être attaqué sur le terrain de sa validité. Il en va d'ailleurs de même pour sa portée qui ne pouvait être remise en cause sur le terrain de l'arbitrabilité. En effet, dès lors que l'objet du contrat était l'exploitation d'un droit patrimonial d'auteur, la clause ne pouvait être attaquée sur le terrain de la conformité à l'Acte uniforme OHADA relatif à l'arbitrage, dans la mesure où l'article 2 de ce texte exige que les droits soumis à ce mode alternatif par la convention soient librement disponibles, ce qui est le cas des droits patrimoniaux d'auteur.

Cette clause serait encore moins exposée à l'annulation dans le nouveau contexte juridique de l'OAPI. En effet, d'une part, l'article 4, alinéa 2, de l'AB, Acte de Bamako de 2015 dispose expressément que "tous les litiges portant sur l'application du présent accord et de ses annexes peuvent être réglés par voie d'arbitrage ou de médiation". D'autre part, l'OAPI a créé, à l'instar de l'OMPI, un centre d'arbitrage et de médiation en vue de régler par ces moyens non juridictionnels, les contentieux de propriété intellectuelle. D'ailleurs, l'article 2 du Règlement d'arbitrage de l'OAPI énumère les critères de soumission des litiges à l'arbitrage et à la médiation OAPI. Pour ce texte :

- a) le différend doit survenir en matière de propriété intellectuelle, en application d'une clause compromissoire ou d'un compromis d'arbitrage;
- b) une des parties au moins doit avoir son domicile ou sa résidence habituelle dans un des États membres de l'Organisation, ou, à défaut, le contrat doit être exécuté en tout ou partie sur le territoire d'au moins un des États membres de l'Organisation;
- c) les droits de propriété intellectuelle en litige doivent pouvoir faire l'objet d'un arbitrage.

Cette dernière exigence a une portée assez particulière : en même temps qu'elle incite à avoir en regard l'article 2 *in fine* de l'Acte uniforme OHADA sur l'Arbitrage, elle postule la prise en compte des nuances du droit de la propriété intellectuelle telles que rappelées ci-dessus.

Toutefois, le maniement de l'ensemble de ces normes est délicat. En effet, le litige opposant les deux entreprises implique à la fois, comme on l'a relevé, le droit national du Congo, qualifié de "droit commun" dans les motifs de

l'arrêt, le droit OAPI et le droit OHADA. En ce qui concerne ces deux derniers, la coexistence n'était pas de nature à soulever une quelconque difficulté, dès lors que le premier ne réglementait pas l'arbitrage à l'époque³⁴. Pas plus ne s'est posée une question de coexistence entre le droit national et le droit OAPI. En revanche, le juge a dû se prononcer sur l'applicabilité du droit national face au droit OHADA. Pour lui, dès lors que le litige ne concernait pas ce droit, mais plutôt le droit national, seules les règles de procédures nationales devaient être appliquées. Autrement dit, pour lui, l'applicabilité d'un droit de fond emporte applicabilité du droit de forme ou de procédure. Si cette option doit être soutenue, elle doit néanmoins être nuancée : il ne peut être fait abstraction de l'existence de l'Acte uniforme sur l'arbitrage, dans un pays de l'espace OAPI. En effet, dès lors que ce texte a "vocation à s'appliquer à tout arbitrage lorsque le siège du tribunal arbitral se trouve dans l'un des États parties" (*art. 1^{er}, AUA*) et qu'au demeurant, il établit des conditions de fond pour toute sorte d'arbitrage et pour tous les domaines du droit des affaires, il ne saurait être fait quelque distinction que ce soit, en ce qui concerne son applicabilité. Par exemple, il faut bien se référer à ce texte pour vérifier si le litige est arbitrable ou non. Il en résulte que le droit OHADA demeure omniprésent et que, parfois, même lorsque le litige concernera une matière non régie par ce droit, certaines de ses règles trouveront à s'appliquer.

II. La base de calcul des redevances dues en contrepartie de l'exploitation d'un objet protégé par la propriété intellectuelle

Les redevances payées en contrepartie de l'exploitation des objets protégés par la propriété intellectuelle peuvent être diversement approchées selon que l'on est dans le domaine du droit d'auteur ou dans celui de la propriété industrielle. Dans ce dernier domaine, il existe une telle liberté que le législateur se refuse à encadrer la question de la rémunération des titulaires de droit, laissant ainsi libre cours à l'autonomie de la volonté. En effet, aucune annexe de l'AB ne pose une quelconque base en vue du calcul de ladite rémunération³⁵.

En revanche, en droit d'auteur, ce sont d'abord les lois nationales qui ont retenu le principe de la rémunération proportionnelle, accompagné de cas particuliers où un forfait peut être prévu. Pour le cas du Congo, il s'agit de l'article 45 de la loi n° 24/82 du 7 juillet 1982 sur le droit d'auteur et les droits voisins, selon lequel la cession à titre onéreux doit comporter, au profit de l'auteur, une participation proportionnelle aux recettes de toutes natures provenant de la vente ou de l'exploitation. Puis, récemment l'annexe VII de l'AB l'Acte de 2015 l'a adopté en l'insérant de manière expresse. Dans son contenu, la compréhension du principe de la rémunération proportionnelle est relativement simple : le contrat doit

34 Aujourd'hui encore, il ne devrait pas y avoir de difficulté, les deux catégories de normes ne présentant pas de situations conflictogènes.

35 Il semble toutefois bien établi que les contrats de licence combinent généralement une somme forfaitaire, indépendante du volume de production, avec une rémunération proportionnelle aux ventes générées ou au nombre de produits fabriqués sous licence, le contrat permettant au titulaire de vérifier l'exactitude du calcul.

prévoir un certain pourcentage qui reviendra à l'auteur sur les recettes brutes d'exploitation. De manière globale, si, par exemple, des supports physiques sont vendus, il s'agit d'un pourcentage calculé sur le prix de vente de chacun de ces supports. Tant pour les supports physiques que pour les supports électroniques (c'est-à-dire les copies téléchargées), le pourcentage devrait être calculé sur le prix de chaque copie téléchargée. En somme, pour le rappeler, les redevances de droit d'auteur sont calculées sur la base des recettes perçues par l'exploitant³⁶.

Cependant, cette règle n'est impérative que pour les contrats de cession conclus par l'auteur lui-même. En d'autres termes, elle n'est pas exigée pour d'autres types de contrats d'exploitation des droits d'auteur, pas plus qu'elle ne l'est pour les contrats de sous-cession. En ce qui concerne son taux, il est librement négocié, même si l'existence d'un taux dérisoire pourrait laisser croire qu'il a été prévu en vue d'éluider la loi.

Enfin, quant à l'assiette de la rémunération, elle résulte de la loi : celle-ci est habituellement constituée des recettes d'exploitation. En fait, "c'est le prix payé par le public qui doit servir de référence"³⁷.

En scrutant les circonstances qui entourent la demande de paiement émanant de MIC VIDEO, on peut s'interroger sur l'applicabilité de cette règle au contrat sur la base duquel cette entreprise réclamait son dû. Tout d'abord, il est évident que le contrat devant permettre la "fourniture" des cassettes contenant des films à diffuser sur la chaîne de télévision "CANAL Océan" n'a pas été conclu par les auteurs des œuvres exploitées, mais par un distributeur, sans doute lié aux producteurs par contrats. Par conséquent, de ce point de vue, la rémunération proportionnelle prévue n'était pas obligatoire. Ensuite, le contrat ne porte pas cession du droit de représentation dont l'exploitation était en cause. Enfin, le contrat a considéré comme base de calcul de la rémunération les recettes brutes réalisées par les abonnements de la clientèle au réseau CANAL Océan. Précisément, c'est cette assiette qui est à l'origine du litige objet de l'arrêt commenté. Même si l'applicabilité de la règle de la proportionnalité dans le litige ne s'imposait pas pour les raisons déjà évoquées, l'arrêt rendu par la Cour suprême du Congo offre l'occasion d'apporter des précisions utiles. Dans cette optique, il importe de relever que, dans la logique de MIC VIDEO, l'assiette devant être prise en considération pour ce calcul devait englober les recettes réalisées par toutes les chaînes gérées par la société débitrice alors que, selon le demandeur au pourvoi, le contrat spécifiait en son article 9 que cette base serait plutôt celles de l'unique chaîne qui diffusait les films. La question peut être posée de manière générale : l'assiette devant servir de calcul à une rémunération proportionnelle doit-elle être définie par rapport à l'ensemble de l'activité du cocontractant ou

uniquement par rapport l'activité relative à l'exploitation de l'œuvre concernée? Cette question peut paraître triviale à première vue. En réalité, elle rappelle, d'une part, que les contrats d'exploitation des droits d'auteur prévoient parfois une rémunération proportionnelle au chiffre d'affaires. Il convient de rappeler que cette option ne peut être justifiée que lorsque l'activité de l'utilisateur est essentiellement ou exclusivement assise sur l'exploitation des œuvres protégées³⁸. Elle rappelle également que le secteur en cause a suscité des difficultés spécifiques ayant justifié une abondante doctrine³⁹. Pour autant, il ne justifie pas que le calcul s'étende à l'ensemble de l'activité du débiteur.

Sur ce point, deux précisions doivent être faites : d'une part, la rémunération n'est proportionnelle qu'aux recettes réalisées dans le cadre de l'exploitation d'une ou de plusieurs œuvres spécifiques faisant l'objet du contrat qui lie les parties. Autrement dit, étendre l'assiette à d'autres activités du débiteur signifie inéluctablement que le champ contractuel a été étendu au-delà de la volonté commune des parties. Plus grave, en l'espèce, cette extension conduisait à empiéter sur d'autres contrats et donc sur l'assiette de calcul de la rémunération des autres titulaires des droits dont les œuvres étaient exploitées sur d'autres chaînes du groupe LINDA COMMUNICATIONS.

D'autre part, le calcul de la rémunération ne doit s'effectuer qu'après certaines déductions, en particulier les impôts. C'est la raison pour laquelle la jurisprudence française décide que la rémunération proportionnelle est assise sur le prix public hors taxes⁴⁰, l'exploitant devant verser les taxes perçues au trésor public. Il en résulte que de ce point de vue, la Cour suprême du Congo a parfaitement appliqué la loi.

Cependant, dans son attendu y relatif, elle estime que le collège arbitral aurait dû également déduire "les charges comptables inhérentes aux sociétés". Cet aspect mérite d'être interrogé. En effet, si l'article 9 du contrat incluait une telle déduction, elle devait nécessairement s'imposer, dès lors que l'on n'est pas dans un contrat liant un auteur et un cessionnaire de ses droits. En revanche, dans un tel contrat, une telle clause aurait été frappée de nullité dès lors que la loi de 1982 précitée parle des "recettes de toutes natures provenant de la vente ou de l'exploitation", ce qui renvoie aux recettes brutes d'exploitation. Car en effet, si l'on déduit les charges comptables, on diminue l'assiette sur laquelle le taux prévu doit s'appliquer. Par conséquent, si le contrat était silencieux en ce qui concerne cette déduction, cela aurait dû signifier que les parties n'ont envisagé que les prélèvements obligatoires et notamment les impôts, et que le juge congolais est allé au-delà de leur volonté.

Joseph Fometeu

36 FOMETEU (J.), *Le droit d'auteur et les droits voisins*, Questions/Réponses, Cameroun (L'Harmattan), 2018, pp. 22 et s.

37 CLAVIER (J.P.) et BERNAULT (C.), *Dictionnaire de droit de la propriété intellectuelle*, 2^e éd., Paris (Ellipses), 2015, pp. 440 et 441.

38 FOMETEU (J.), n.36, pp. 106 et 107.

39 Voir par ex. : MONNERIE (C.), Point de vue sur la rémunération des auteurs de cinéma, in : *Communication commerce électronique*, n° 1, 2009, p. 9; BERNAULT (C.), *Contrat de distribution des œuvres audiovisuelles : Contrat de distribution en salles*, in : *Juriscl. Contrats-Distribution*, Fasc. 3510, 2014.

40 Cass. civ., 1^{re} chambre, 16 juillet 1998 : D. 1999, p. 306 (note DREYER (E))

C. Législation fondant la saisie des œuvres contrefaites – Questions de droit OHADA – Application du droit OAPI (annexe VII) – Application du droit interne

Le choix de la législation devant fonder la saisie de produits contrefaisants est fonction de l'objet protégé par la propriété intellectuelle. Dès lors, l'annexe III de l'Accord de Bangui concernant les marques ne saurait s'appliquer à une saisie relative aux œuvres de l'esprit. Cette saisie ne devrait pas non plus s'appuyer sur le droit OHADA, mais plutôt sur l'annexe VII de l'accord ci-dessus, relative à la propriété littéraire et artistique, ainsi que sur la loi nationale.

Tribunal régional de NIAMEY, Ordonnance de référé n° 124 du 20 juillet 2004, SOCIÉTÉ EUROPRESS-EDITORES E DISTRIBUIDORES DE PUBLICACOES LDA c. COMPAGNIE BEAUCHEMIN INTERNATIONAL Inc.

Observations :

L'affaire portée devant le juge des référés de Niamey est une véritable mine juridique pour la propriété intellectuelle. En effet, elle soulève des questions qui relèvent de la pratique de la propriété intellectuelle mais aussi des problèmes liés à la théorie générale.

Faits : Les faits de l'espèce sont assez révélateurs de difficultés juridiques subséquentes. À la suite d'un appel d'offre international, la société Europress a été désignée comme attributaire d'un marché ayant pour objet la fourniture de manuels scolaires des cycles primaire et secondaire dont ceux de la collection GRIA-Côte d'Ivoire des classes de 4^e et 3^e. Certains livres de cette collection sont d'ailleurs remplacés par ceux d'une autre du même nom, la collection GRIA-Niger. Les manuels sont effectivement livrés pour être distribués par les Établissements Daouda. C'est alors que l'entreprise canadienne Beauchemin International Inc., se présentant comme titulaire des droits, victime d'une contrefaçon, fait pratiquer une saisie conservatoire de meubles corporels sur les livres de remplacement et une saisie conservatoire de créances sur une somme de 27 939 871 F en principal et 1 000 000 F de dommages et intérêts entre les mains du projet I/FAD, du Ministère de l'éducation de base et du Ministère de l'économie et des finances. La société Europress saisit alors le juge des référés aux fins d'obtenir l'annulation de ces saisies conservatoires. Pendant l'instance, le BNDA fait une intervention volontaire.

Raisonnement : À l'appui de sa demande, Europress invoque plusieurs arguments. Par exemple, elle estime que la société canadienne n'apporte pas la preuve de la titularité de ses droits sur les œuvres qui ont été saisies. À partir de là, elle demande que lui soit déniée la qualité à agir et donc, qu'il soit reconnu qu'elle n'avait pas le droit de saisir. Sur le même terrain, elle demande que soit déclarée irrecevable l'intervention volontaire du BNDA, au motif que celui-ci n'a pas produit des documents propres à établir qu'il a une convention avec l'OGC auquel serait liée la société Beauchemin.

Pour contrer cet argumentaire, la société canadienne soulève l'incompétence du juge des référés au motif que le juge du fond est déjà saisi et surtout, elle relève que c'est l'annexe VII de l'ABR-1999, et non l'annexe III qui est applicable en l'espèce. Ce dernier argument s'ajoute à d'autres qui font tout l'intérêt de cette décision. En effet, la décision rendue laisse constater que le juge a été confronté à trois questions importantes :

- I. la qualité à agir d'un organisme local de gestion collective pour la défense du répertoire d'un OGC étranger;
- II. l'applicabilité à la propriété intellectuelle, de l'Acte uniforme OHADA relatif aux voies d'exécution; et
- III. la place de l'annexe VII de l'Accord de Bangui par rapport aux lois nationales relatives au droit d'auteur et aux droits voisins.

I. La qualité à agir d'une organisation nationale de gestion collective pour la défense d'un répertoire étranger

La question de la qualité à agir des organisations de gestion collective pour la défense du répertoire d'une organisation de gestion collective étrangère a reçu une réponse claire du juge de Niamey : en l'absence de convention entre l'organisation étrangère et l'organisation nationale, il ne saurait être possible pour cette dernière de défendre les intérêts des œuvres de son répertoire. Cette réponse du juge ramène à un débat bien ancien : les organisations de gestion collective sont-elles habilitées à défendre les intérêts des titulaires de droits qui ne sont pas leurs membres? Pour la jurisprudence française, la réponse est négative⁴¹. D'ailleurs, selon toute vraisemblance, même lorsque le titulaire de droit a adhéré à l'organisation de gestion collective, il faut encore que l'œuvre objet de la contrefaçon figure sur le répertoire de l'organisation demanderesse⁴².

Dans cette logique, la position retenue par le juge de Niamey est parfaitement justifiée. Pourtant, bien qu'elle soit juridiquement imparable, "la solution est peut-être regrettable en termes d'opportunité"⁴³. En effet, on peut se demander si l'on ne devrait pas distinguer la situation des titulaires nationaux de celle des étrangers. En ce qui concerne les nationaux, ils choisissent délibérément de ne pas adhérer ou de ne pas inscrire certaines de leurs œuvres dans les répertoires des organisations nationales de gestion collective ou alors, ils négligent de le faire. Dans ces conditions, il serait inopportun d'autoriser un tiers, fût-il un de ces organismes, à se mêler de la gestion de leurs droits. En revanche, les titulaires étrangers ne sont pas forcément fautifs s'ils n'ont pas pu adhérer à l'organisme national du pays où le besoin de protection s'est fait ressentir ou surtout si leur structure de gestion collective n'a pas conclu une convention de représentation réciproque. D'ailleurs, la

41 Voir par ex. Cass. civ., 1^{re} chambre, 19 février 2013 : D. 2013, p. 67 (note ALLAYES (P.)).

42 Voir VIVANT (M.) et BRUGUIÈRE (J.-M.), n. 29, n° 1141; CA Paris, 10 juillet 1990 : RIDA 1991, Vol. 1, p. 315.

43 LUCAS (A.), LUCAS-SCHLOETTER (A.), BERNAULT (C.), *Traité de la propriété littéraire et artistique*, Paris (LexisNexis), 5^e éd., 2017, n° 1197.

rigueur du droit positif "ne tient pas compte du fait que de nombreux auteurs ne peuvent pas s'affilier à une organisation de gestion collective tout simplement parce que, dans leur pays de résidence, il n'en existe pas"⁴⁴. Il serait donc sévère de laisser leurs œuvres à la merci des contrefacteurs. C'est pour cette raison qu'on peut se demander si, sur le terrain de la gestion d'affaires, les organisations nationales ne pourraient pas être autorisées à agir⁴⁵.

II. L'applicabilité à la propriété intellectuelle des saisies relevant de l'Acte uniforme OHADA sur les voies d'exécution

Peut-on pratiquer une saisie relevant de l'AUPSRVE en matière de propriété intellectuelle? Telle était la deuxième question de droit clairement soulevée devant le juge des référés de Niamey. En principe, la réponse devrait varier en fonction des situations.

Dans une première hypothèse, il s'agit d'envisager qu'un objet de propriété intellectuelle puisse être saisi en vue d'une exécution forcée pour une dette du titulaire du droit sur cet objet. Il ne fait alors aucun doute que la saisie est possible, même si le régime de ces saisies demeure imprécis⁴⁶. Dans une seconde hypothèse, il s'agit de se demander si l'une des saisies conservatoires prévues par l'Acte uniforme précité peut être pratiquée sur des objets de propriété intellectuelle. À l'évidence, si la saisie conservatoire est pratiquée dans le cadre d'une procédure susceptible de déboucher sur une exécution forcée, elle est parfaitement concevable. Par exemple, si le créancier d'une personne titulaire d'un droit de propriété intellectuelle pratique une saisie conservatoire sur ce droit dans la perspective de procéder à une conversion ultérieure, cette saisie n'encourt aucun reproche. La situation est, en revanche, plus complexe en ce qui concerne la saisie conservatoire pratiquée sur des objets contrefaisants, dans le cadre du droit OHADA. En effet, dans le cas de l'affaire Europress, la compagnie Beauchemin avait pratiqué ce type de saisie alors même que l'objectif recherché n'était pas d'affecter ultérieurement les objets saisis au paiement du créancier, mais de se préconstituer la preuve de l'infraction de contrefaçon dont les poursuites étaient par ailleurs déjà engagées. À vrai dire, le raisonnement du juge est assez difficile à suivre : la saisie a été pratiquée sur le fondement de l'AUPSRVE et, pour rejeter la demande de nullité, il s'est fondé sur la loi nationale et l'annexe VII de l'ABR-1999. Un tel raisonnement doit être déconseillé. En effet, même si la saisie-contrefaçon portant sur des supports matériels d'une œuvre supposée contrefaite n'est pas le seul mécanisme de saisie par lequel la preuve de la contrefaçon peut être préconstituée, elle ne peut être assimilée à une saisie conservatoire

de biens meubles corporels. Par conséquent, le juge aurait dû annuler les saisies conservatoires portant sur les supports contrefaisants et renvoyer la société Beauchemin à pratiquer la saisie idoine.

La question demeure alors entière pour la saisie conservatoire de créance portant sur la somme de 27 939 871 F en principal et 1 000 000 F de dommages et intérêts, pratiquée entre les mains du projet I/FAD, du Ministère de l'éducation de base et du Ministère de l'économie et des finances. Le débat est intéressant en ce que les sommes placées sous mains de justice pourraient bien être affectées au paiement d'une créance après conversion de la saisie pratiquée en saisie-attribution. Malheureusement, les bases juridiques étaient erronées en l'espèce.

Tout d'abord, à la lecture de la décision, il apparaît que la saisie était pratiquée en considérant que les sommes bloquées étaient des "recettes" telles que visées par la législation sur le droit d'auteur, ce qui est inconcevable si l'on se réfère au statut des institutions entre les mains desquelles les sommes ont été saisies. Il s'agissait, en réalité, d'une créance d'Europress entre les mains de ces institutions et non de ses "recettes". Ensuite, si l'on revient aux conditions de fond justifiant une saisie conservatoire de créances, on réalise qu'une telle saisie est injustifiée. En effet, de manière générale, une saisie conservatoire, quelle qu'elle soit, ne peut être autorisée que si la créance est apparemment fondée dans son principe et si le créancier justifie des circonstances susceptibles d'en menacer le recouvrement⁴⁷. En matière de contrefaçon, lorsqu'une saisie est pratiquée avant un procès au fond, il ne peut être possible pour le saisissant de justifier sa qualité de créancier. Celle-ci ne peut résulter que d'une condamnation par le juge du fond, après reconnaissance du caractère délictueux des actes accomplis par le saisi. Il en découle que, contrairement au créancier qui doit établir la vraisemblance de sa créance et la menace qui en hypothèque le recouvrement, puis ultérieurement la simple réalité de cette créance, celui qui, avant la saisine du juge du fond, pratique une saisie en matière de propriété intellectuelle doit établir tant la vraisemblance de la titularité de son droit que celle de l'atteinte à ce droit, puis ultérieurement la réalité de cette atteinte. Cette différence dans les exigences justifie que les législations à mettre en œuvre soient différentes : le créancier doit saisir le juge sur le fondement de la législation applicable aux voies d'exécution tandis que le titulaire du droit de propriété intellectuelle doit fonder sa demande sur la législation relative à cette matière. C'est cette nuance qui n'a pas été comprise par le juge des référés de Niamey qui a validé la saisie conservatoire des créances pratiquée par Beauchemin.

III. La place de l'annexe VII de l'Accord de Bangui par rapport aux lois nationales relatives au droit d'auteur

L'affaire Europress est une illustration parfaite de la difficulté que l'interprète peut éprouver lorsqu'il tente

44 UCHTENHAGEN (U.), La gestion collective du droit d'auteur dans la vie musicale, Genève (OMPI), 2005, n° 275. Disponible en ligne à l'adresse <https://www.wipo.int/publications/fr/details.jsp?id=362&plang=EN>.

45 Dans ce sens : UCHTENHAGEN (U.), *ibid.*, n° 276 et s.

46 Pour une application à la saisie d'une marque, voir : TGI hors classe de Niamey, Ordonnance de référé n° 118 du 20 mai 2008, *Rothmans of Pall Mall limited SA. c. Société Adil company et El Hadj S.S* (obs. NDEMA ELONGUE (M.-L.), ce recueil, chapitre 3, section 5).

47 Cf. art. 54 de l'AUPSRVE.

de définir la place de l'annexe VII de l'Accord de Bangui par rapport aux lois nationales. En effet, le débat sous les versions antérieures à celle de 2015 de cet accord était celui de la nature des droits créés par cette annexe, lorsqu'on comparait sa malheureuse situation à celle des autres annexes. Tandis que les autres s'appliquaient allègrement dans les États membres où elles ne trouvaient aucun obstacle juridique constitué par un autre texte de droit interne, l'annexe VII devait se frayer un chemin improbable afin de survivre et de pouvoir justifier son existence dans l'ensemble du droit OAPI.

La situation d'alors est bien curieuse : alors même qu'aucune discrimination n'est établie au plan théorique entre les différentes annexes, la réalité confine à constater que les États membres de l'OAPI disposent, dans leur quasi-totalité, d'une législation interne sur le droit d'auteur et les droits voisins. Dans ces conditions, quelle place, finalement, donner à l'annexe VII au regard de ces législations internes? En vue d'apporter des éléments théoriques de clarification à cette interrogation à laquelle le juge de Niamey a répondu de manière implicite sans y avoir été expressément convié par les parties, il convient de prendre acte de l'évolution de la législation. En effet, sous le régime des versions antérieures de l'Accord de Bangui, l'annexe VII a un statut moins favorable (A) que celui que lui confère l'Acte de Bamako de 2015 (B).

A. Le statut de l'annexe VII dans les versions de l'Accord de Bangui antérieures à ABR-2015

Le statut de l'annexe VII dans les versions antérieures de l'ABR-2015 est ambigu en théorie et il est d'application difficile.

Sur le plan théorique, il faut d'abord se référer à l'article 3, alinéa 1, de l'Acte de 1999. Selon cette disposition en effet, "les droits afférents aux domaines de la propriété intellectuelle, tels que prévus par les annexes au présent accord sont des droits nationaux indépendants, soumis à la législation de chacun des États membres dans lesquels ils ont effet"⁴⁸. Comment comprendre cette disposition dans une convention internationale? Plusieurs lectures étaient possibles.

Selon une première lecture, cette disposition signifiait que dans chaque État membre, le texte régional constitue la loi nationale, mais aussi que dans chaque État, le texte régional pouvait être complété. Or, en matière de droit d'auteur, l'adoption systématique par les États membres de textes propres témoigne bien de la volonté de ces derniers d'opter pour la coexistence de l'annexe avec les législations internes propres. Dans ces conditions, l'annexe VII ne constituait qu'un cadre général⁴⁹. Cette première interprétation n'aide pas réellement à faire avancer la réflexion en ce que la notion de "cadre général" est imprécise.

Selon une deuxième lecture, les droits prévus par l'accord et ses annexes ne devaient être soumis au droit national que pour leur implémentation. Cette compréhension signifierait que les droits prévus par l'annexe VII et les autres annexes devaient être internalisés pour être appliqués. Une telle lecture était fragile en ce qu'elle portait en elle-même les germes de sa destruction : si on l'adoptait, il aurait fallu considérer que toutes les annexes obéissaient à ce régime et que, par conséquent, l'accord et ces annexes n'étaient pas d'application directe dans les États membres, ce qui était loin de la réalité juridique.

C'est la raison pour laquelle une troisième approche estimait que cette disposition pouvait s'interpréter comme signifiant que les droits accordés par l'Accord de Bangui et ses annexes constituaient le droit national, exactement comme s'ils émanaient d'un organe interne d'édition des normes. Cette dernière interprétation paraît correspondre à la réalité de la relation entre les lois nationales des États membres de l'OAPI et l'annexe VII de l'Accord de Bangui. En effet, tout porte à croire que le droit OAPI s'intégrait au droit national en se soumettant à la législation interne, ce qui signifierait que ce droit n'était nullement doté de supranationalité.

Sur le terrain de l'application du texte, l'imprécision du statut de l'annexe conduisait à une situation assez malaisée. En effet, d'une part, quelle que soit l'option retenue, elle établissait une discrimination entre les différentes annexes⁵⁰. D'autre part, et de manière plus spécifique, la majorité des interprétations proposées tentaient à vrai dire de justifier a posteriori une réalité juridiquement gênante pour un espace juridique intégré : chaque fois qu'un pays légiférait sur le droit d'auteur et les droits voisins, il s'émancipait plus ou moins totalement de l'Accord de Bangui en cette matière. Tout au plus, dans les pays ayant légiféré, les règles prévues par l'annexe auraient pu être convoquées pour combler les lacunes éventuelles de la loi nationale.

Ces atermoiements relatifs au statut de l'annexe VII ont conduit à une jurisprudence confuse. En effet, de façon globale, trois logiques différentes peuvent être systématisées dans les décisions rendues par les juridictions nationales de l'espace OAPI sous les Actes de l'Accord antérieurs à 2015.

Dans la première logique, les juges font une application exclusive de la loi nationale sans aucune allusion à l'annexe VII qui, au demeurant, n'est pas invoquée par les parties⁵¹. En réalité, il s'agit de la tendance majoritaire.

Dans la deuxième logique, les juges appliquent exclusivement l'annexe VII, ce qui conduit à occulter l'existence de la loi nationale. Par exemple, dans

⁵⁰ De telles distinctions étaient contraires à l'art. 4 al. 2 et 3 de l'ABR-1999.

⁵¹ Voir par exemple : Tribunal régional de Niamey, Jugement n° 080 du 3 mars 2004, *Groupement édition Pierron international c. Établissement Niger – Bureau* : EDOU EDOU (P.) (ed.), *Le contentieux de la propriété intellectuelle dans l'espace OAPI : Guide du magistrat et des auxiliaires*, Genève (OMPI), 2009, p. 103; Tribunal de Libreville, Jugement (non daté), *Christine Rossano c. Société Sovingab* : *ibid.*, p. 116.

⁴⁸ Voir également art. 2 al. 1 de l'AB-1977.

⁴⁹ NGOMBE, (Y.L.), *Le droit d'auteur dans les États membres de l'Organisation africaine de la propriété intellectuelle (OAPI) : une harmonisation inachevée?* : e.Bulletin du droit d'auteur, janvier - mars 2005, p.1.

une affaire soumise à un juge camerounais et dans laquelle l'annexe III était également applicable, l'unique législation appliquée pour les questions de droit d'auteur (*absence de formalités, originalité de l'œuvre, titre de l'œuvre, etc.*) était l'annexe VII⁵².

Dans la troisième logique, les juges font une application concomitante de la loi nationale et de l'annexe VII. Mais cette application s'effectue selon *deux approches différentes*.

- Dans la première approche, les juges se bornent à viser le texte régional, puis à appliquer la loi nationale. Tel est le cas de ce juge camerounais qui, après avoir déclaré "qu'au regard de l'Accord de Bangui du 2 mars 1977 et de la loi n° 2000/011 du 19 décembre 2000, seules sont astreintes au paiement des droits d'auteur les personnes physiques ou morales exploitant, sans autorisation de leurs auteurs, des œuvres littéraires ou artistiques protégées", n'utilise que la loi nationale pour régler le contentieux⁵³.
- Dans la deuxième approche, les juges font une véritable application concomitante de l'annexe VII et de la loi nationale, comme s'il s'agissait de deux textes dont l'application doit être simultanée. Telle est l'approche adoptée par le juge des référés dans la présente affaire.

Il faut le dire, la partie était relativement aisée pour lui dans la mesure où les solutions fournies par les deux textes se recoupaient parfaitement. Qu'aurait-il décidé si les deux textes offraient des solutions différentes? Personne, malheureusement, ne peut répondre à cette interrogation. Fort heureusement, la révision de l'ABR-2015 apporte des précisions de nature à clarifier le débat.

B. Le statut de l'annexe VII dans l'ABR-2015

Le statut de l'annexe VII a été clarifié par l'ABR-2015. Il demeure cependant quelques difficultés qui, probablement, émailleront son application. Sur le plan théorique, l'article 5, alinéas 1 et 2, de l'accord contient l'essentiel des données nouvelles à prendre en considération.

En ce qui concerne l'alinéa 1, il s'agit d'une reprise des dispositions antérieures de l'article 3 de l'Acte de 1999. Cette reprise permet de camper le débat et d'en rappeler les termes. Mais ces termes ont changé avec le nouvel accord, en ce sens que l'alinéa 2 tente de mettre fin à toutes les interprétations proposées pour les versions antérieures de l'accord. En effet, il dispose que "dans les États membres, le présent accord et ses annexes tiennent lieu de lois relatives aux matières qu'ils visent. Ils y abrogent ou empêchent l'entrée en vigueur de toutes les dispositions contraires. L'annexe VII est un cadre normatif minimal".

Deux faisceaux de solutions sont ainsi fournis. Le premier concerne ce qui pourrait être qualifié de statut général de l'accord et de ses annexes. À cet égard, l'accord reprecise, de manière globale, son statut par rapport aux lois nationales : le droit OAPI constitue, à n'en plus douter, le droit national. En effet, il prend place au sein de l'ordonnement juridique interne des États, en ce qu'il constitue la loi relative à la matière qu'il organise. Et, pour emprunter à la méthodologie de l'OHADA, le droit OAPI abroge ou empêche l'entrée en vigueur des dispositions contraires adoptées par les organes internes de production des normes. On ne pouvait pas être plus clair. Désormais, cette formule inspirée de celle de l'article 10 du traité OHADA met fin à toutes les spéculations autour des rapports entre les deux catégories de normes. L'affirmation de la supranationalité du droit OAPI ne fait plus de doute.

Le second concerne le statut spécial de l'annexe VII. Selon le texte, l'annexe VII constitue "un cadre normatif minimal". La formule est sophistiquée, mais elle conduit simplement à dire que cette annexe constitue un minimum. Dans la logique du nouvel accord, cela signifie que l'annexe constitue désormais un des référentiels ou une source d'inspiration obligatoire pour ceux des États qui préféreraient avoir une législation nationale propre dans le domaine de la propriété littéraire et artistique, plutôt que d'appliquer l'annexe elle-même de manière directe. De toute évidence, l'annexe viendrait, dans ces conditions, s'aligner aux côtés des autres conventions internationales relatives à la matière et auxquelles doit se soumettre cet État s'il les a ratifiées. Dans ce foisonnement de sources, l'annexe, elle-même ayant logiquement été mise à niveau par rapport aux minimas juridiques internationaux en la matière, devrait intégrer d'autres orientations qui à leur tour seraient considérées comme les minimas pour les pays de l'espace OAPI. Schématiquement présentée, la situation est la suivante : l'annexe est mise à niveau en se conformant aux minimas internationaux et, le cas échéant, en relevant ces minimas ; à leur tour, les lois nationales sont actualisées en se conformant aux minimas de l'OAPI, puisque le texte de Bangui serait le nouveau plancher pour les États membres.

Il subsistera néanmoins quelques difficultés. La première est à la fois politique et matérielle. Elle résulte de ce que plusieurs États membres de l'OAPI ont modifié assez récemment leur législation interne (*Côte d'Ivoire (2016), Mali (2017), Guinée (2019), etc.*). Dans ces conditions, il ne sera sans doute pas aisé de les amener à opérer une nouvelle modification de la loi. Cette difficulté pourrait, sinon provoquer une résurgence de relents souverainistes de la part de ces États, du moins retarder l'implémentation de l'annexe.

La seconde se trouve dans les difficultés inhérentes à la définition du "cadre normatif minimal" dont le contenu pourrait prêter à discussion.

Toutefois, cette situation est de loin préférable à celle qui découlait des versions antérieures de l'accord. Aujourd'hui, il est clair que l'article 5, alinéa 2 *in fine*,

52 TGI Wouri (Douala), Jugement civil n° 192 du 15 décembre 2000, *Moulinex SA c. Vapsan trading Cie et autres* : *ibid.*, p. 169.

53 TPI Douala Bonanjo, Ordonnance de référé n° 186 du 7 mars 2007, *Société Semen Distributors Sàrl c. Société civile du droit d'auteur et des droits voisins des arts audiovisuels et photographiques (SCAAP)* : *ibid.*, p. 116.

s'adresse d'abord aux législateurs nationaux des États membres qui doivent en tenir compte pour élaborer ou actualiser le droit interne. En cas d'inaction, le texte s'adresse alors aux juges nationaux. Par conséquent, si un État retarde ou se montre réticent à mettre à jour sa législation, le justiciable se fondera le cas échéant sur l'accord, pour amener le juge à constater que sa loi nationale se situe éventuellement en deçà du minimum fixé par l'OAPI ou qu'elle est silencieuse sur une question réglée par cette Organisation. Ce juge, sur la base de l'article 5, alinéa 2, pourrait alors écarter sa loi nationale afin d'appliquer l'annexe VII.

Il ne reste donc qu'à souhaiter que les juges fassent preuve de hardiesse en répondant favorablement aux justiciables avisés qui souhaiteraient bénéficier de cette richesse de l'accord et de cette nouvelle dynamique qu'essaie d'impulser l'OAPI à son Droit.

Joseph Fometeu

D. Nationalité – Paiement de la caution *judicatum solvi* par les ressortissants d'États membres de l'OAPI dans d'autres États membres

Bien que l'Accord de Bangui consacre pour la protection des titres de propriété intellectuelle délivrés par l'Organisation africaine de la propriété intellectuelle l'existence d'un territoire unique sur une base communautaire composée de ses 17 États membres, les ressortissants de ces États demeurent soumis au paiement de la caution *judicatum solvi* lorsqu'ils introduisent des actions devant les juridictions d'autres États membres.

Cour suprême du Sénégal, Arrêt n° 73 du 19 septembre 2018, ÉTABLISSEMENTS MAMADOU S DIALLO c. IBRAHIMA KEITA et WALY FAYE

Observations :

L'exécution d'un jugement obtenu contre un étranger demandeur au procès est très souvent difficile. En effet, l'étranger n'ayant pas d'attache avec le sol du pays d'accueil pourrait tenter des actions vexatoires contre les nationaux sans avoir à redouter les affres d'une éventuelle condamnation. La caution *judicatum solvi*⁵⁴ est un palliatif visant à protéger les nationaux contre les instances téméraires des étrangers. Initialement prévu à l'article 16 du Code civil napoléonien, ce mécanisme protecteur a été ensuite intégré dans les Codes de procédure civile des pays signataires de l'Accord de Bangui⁵⁵. L'exigence de la caution *judicatum solvi* en matière de propriété industrielle soulève quelques difficultés liées à la conception singulière de l'espace OAPI, considéré comme un territoire unique.

54 Somme que tout demandeur étranger à un procès est tenu de payer et qui est destinée à garantir le recouvrement des dommages et intérêts, ainsi que des frais qui peuvent être ordonnés à son encontre.

55 Voir par ex. art. 110, 73, 4 et 123 respectivement des Codes de procédure civile sénégalais, camerounais, ivoirien et burkinabé.

Faits : Les faits ayant généré cette affaire sont simples : en exécution de l'ordonnance n° 26 du 19 juillet 2016 du président du tribunal de grande instance de Kaolack, les Établissements MAMADOU SAMBA DIALLO ont fait pratiquer saisie-contrefaçon de 134 rouleaux de pneus de marque GAZELLE destinés aux motos d'une valeur de FCFA 15 000 000 au préjudice de sieur IBRAHIMA KEITA et ont traduit celui-ci devant la susdite juridiction aux fins de constater les actes de contrefaçon commis par lui, de valider la saisie pratiquée sur les produits querellés et de le condamner au paiement de la somme de FCFA 50 000 000 à titre d'indemnisation. Par jugement avant dire droit du 16 mars 2017, le tribunal a ordonné la consignation par les Établissements demandeurs de la somme de FCFA 15 000 000 en guise de caution *judicatum solvi*, décision confirmée par la cour d'appel de Dakar. Les Établissements MAMADOU SAMBA DIALLO se sont pourvus en cassation en articulant un moyen unique pris de la violation de l'annexe III de l'Accord de Bangui du 2 mars 1977 instituant une Organisation africaine de la propriété intellectuelle, en ce que la caution *judicatum solvi* prévue par l'article 110 du Code de procédure civile sénégalais n'est pas exigée à un ressortissant d'un État partie, les 17 pays membres de cette organisation constituant un seul territoire régional de protection.

Raisonnement : La question de droit à laquelle la Cour suprême devait répondre était celle de savoir si un demandeur au procès, ressortissant d'un pays membre de l'OAPI est dispensé, du fait de son appartenance à cette zone géographique, du paiement de la caution *judicatum solvi* exigée par le Code de procédure civile national du pays dans lequel son action est introduite. La haute juridiction sénégalaise, à la suite des juridictions inférieures, a rejeté le pourvoi en faisant sien le principal motif énoncé par la cour d'appel : l'Accord de Bangui "n'organise pas les conditions d'accès aux juridictions internes de chaque État partie".

La décision est intéressante à plus d'un titre, dans la mesure où elle permet de préciser :

- I. le contenu et la portée de la notion de territoire unique découlant du régime uniforme de protection de la propriété intellectuelle; et
- II. le rôle des dispositions législatives nationales relatives à la procédure, dans la mise en œuvre des droits de propriété intellectuelle.

I. Le contenu et la portée de la notion de territoire unique appliquée à l'espace OAPI

La première branche du moyen unique articulé par les Établissements MAMADOU SAMBA DIALLO à l'appui du pourvoi avait précisément trait à l'unicité du territoire OAPI comme cause d'exonération du paiement de la caution *judicatum solvi*. Cet argumentaire n'est évidemment pas anodin : il est la traduction au plan contentieux du choix opéré dès l'origine par les plénipotentiaires des États membres de l'OAPI qui, dans l'optique de renforcer leur coopération, ont donné une portée régionale à la protection de la propriété industrielle, formant ainsi une sorte de territoire unique

dans ce domaine tant en ce qui concerne l'existence que l'exercice des droits⁵⁶. Justement, relativement à l'existence des droits, le demandeur n'a pas à effectuer des dépôts dans tous les États membres. L'article 7, alinéa 1, de l'accord indique à ce propos que : "... Tout dépôt effectué auprès de l'administration de l'un des États membres, conformément aux dispositions du présent accord et ses annexes, ou auprès de l'Organisation, a valeur de dépôt national dans chaque État membre". Par ailleurs, les titres délivrés par l'OAPI, l'office commun de propriété industrielle pour les 17 États membres, produisent effet dans tous ces États. S'agissant de l'exercice des droits, l'exploitation d'un droit de propriété industrielle dans l'un des États membres vaut exploitation dans tous les autres États. Ce principe est exprimé de différentes manières selon le droit de propriété industrielle considéré⁵⁷. Ces règles liées à l'existence et à l'exercice des droits sont approchées de la même manière, que l'on adopte une approche restrictive (A) ou une approche extensive (B) de la notion de territoire unique.

A. L'approche restrictive de la notion de territoire unique

Les demandeurs au pourvoi ont cru devoir tirer conséquence de l'unicité du territoire OAPI pour se soustraire au paiement de la caution *judicatum solvi* exigée en l'espèce, par le Code de procédure civile sénégalais; car pour eux, ils devaient être considérés comme des nationaux au regard de l'intégration créée par le droit OAPI, dès lors qu'on était en présence d'un litige de propriété intellectuelle. Si l'on s'en tient à cette logique, la notion d'"étranger" visée tant dans les codes nationaux de procédure civile que dans les annexes à l'Accord de Bangui aurait une signification toute singulière. En effet, dans une approche restrictive ou stricte, on peut penser que les pères fondateurs de l'OAPI n'ayant pas jugé opportun de proposer une définition spécifique de l'"étranger", cela laisse croire que ce mot conserve tout son sens ordinaire dans la construction communautaire. Dans cette optique, doit être considéré comme étranger au sens des dispositions des différentes annexes à l'Accord de Bangui, et donc astreint au paiement du cautionnement, tout demandeur au procès non ressortissant d'un État membre de l'OAPI dont relève la juridiction saisie. Cette thèse peut se justifier. Elle peut d'ailleurs s'appuyer sur l'article 3 de l'ABR-1999, selon lequel les droits reconnus par les annexes sont des droits nationaux, ce qui revient à dire que chaque juge national l'applique comme s'ils émanent d'un organe interne d'édiction des normes⁵⁸. Il en résulte que le cloisonnement des juridictions des États ne serait pas supprimé par l'existence de la zone d'intégration et,

comme conséquence, le ressortissant d'un État membre qui agit dans un autre État ne peut être dispensé du paiement de la caution *judicatum solvi*. En outre, elle peut s'appuyer sur le fait qu'aucun argument de texte ne permet d'affirmer que l'OAPI ait entendu créer une citoyenneté commune en son sein.

B. L'approche extensive de la notion de territoire unique

L'approche restrictive procède d'une appréciation partielle de la base sur laquelle le raisonnement doit être conduit. D'ailleurs, elle n'a pas été confirmée par l'évolution du droit OAPI. En effet, en affirmant à l'article 5, alinéa 3, de l'ABR-2015, que "les étrangers jouissent des dispositions du présent accord et de ses annexes dans les mêmes conditions que les nationaux", le législateur OAPI apporte une clarification péremptoire. La formule de cette disposition rédigée comme celle qu'utiliserait un législateur national est univoque : dès lors que l'accord et ses annexes ont vocation à bénéficier d'office à tous les ressortissants des États membres, l'"étranger" ne peut qu'être toute personne ressortissant d'un pays tiers à l'Organisation. Néanmoins, cette clarification permet simplement de poser les jalons de l'argumentaire. Celui-ci doit être poursuivi en précisant que, de toutes manières, ce n'est pas uniquement sur le fondement de la nature des droits découlant de l'accord⁵⁹ ou sur celui d'une nationalité découlant de la mise en place de l'OAPI qu'il faut raisonner, mais également sur le fondement de la règle du traitement national qui en est l'appui en cette matière.

La pertinence de l'invocation de la règle du traitement national résulte de la confusion créée en jurisprudence. En effet, lorsqu'on évoque la nationalité en matière de propriété intellectuelle, le réflexe est de croire que le traitement national est susceptible de conduire à une assimilation parfaite de l'étranger au national. Le tribunal de grande instance du Wouri à Douala⁶⁰ est tombé dans ce travers, en rendant une décision critiquable dans une espèce similaire à celle commentée, où une société de droit américain revendiquait l'application à son profit des dispositions de l'article 2 de la convention d'Union de Paris du 20 mars 1883, relatives au traitement national, pour s'affranchir du paiement de ladite caution. En entérinant l'argumentaire de la société américaine au visa de l'article 2 précité, les juges camerounais ont violé la lettre de cette disposition qui prévoit, en son alinéa 2, une exception notable manifestement perdue de vue : "Sont expressément réservées les dispositions de la législation de chacun des pays contractants relatives à la procédure judiciaire et administrative et à la compétence, ainsi qu'à l'élection de domicile ou à la constitution d'un mandataire, qui seraient requises par les lois sur la propriété industrielle". On le voit, le principe du traitement national prévu par l'Union de Paris permet simplement aux étrangers de jouir, dans

56 NGO MBEM (S.), Les enjeux de la protection des dessins et modèles industriels dans le développement en Afrique : le cas des pays membres de l'Organisation africaine de la propriété intellectuelle (OAPI), Thèse de Doctorat en droit, Université de Strasbourg III - Robert Schuman, 2007, p. 38 et s.

57 En matière de marques par exemple, l'art. 23, al. 1 de l'annexe III dispose que ce signe peut être radié dès lors qu'il n'est utilisé sur le territoire d'aucun des États membres pendant une période ininterrompue de cinq ans; en matière de brevet, l'art. 46 de l'annexe I prévoit l'octroi d'une licence non volontaire pour défaut d'exploitation si l'invention brevetée "n'est pas exploitée sur le territoire de l'un des États membres".

58 En ce sens, voir NGOMBE (L.Y.), Le droit d'auteur en Afrique, Paris (L'Harmattan), 2004, p. 128.

59 Sachant que cela a été renforcé par l'ABR-2015, dans la mesure où l'ancien art. 3, réaménagé et repris par l'art. 5, permet de renforcer de manière visible la supériorité du droit OAPI par rapport aux droits nationaux, ce qui lui confère une supranationalité indiscutable.

60 TGI du Wouri (Douala), Jugement civil n° 164 du 6 décembre 2004, Société Mc Can Ericsson c. Bernard AZRIA, obs., NDEDI PENDA (H.) : Revue La Gazelle, n° 0002, 2008, pp. 19 et s.

chaque État qui aurait signé la même Convention que leurs pays, des droits subjectifs élaborés par ces États en faveur de leurs nationaux. Il ne concerne que les droits de propriété intellectuelle qui seraient accordés par la loi nationale à ses ressortissants et non d'autres droits. En conséquence, il laisse subsister les spécificités inhérentes aux législations internes des pays membres quant à la procédure judiciaire et administrative, au rang desquelles la caution *judicatum solvi*. Si l'on raisonnait autrement, on dépasserait le cadre de la protection juridique offerte par les conventions internationales instituant ce principe.

Au total, on peut affirmer que le régime uniforme de protection des droits de propriété industrielle issu de l'Accord de Bangui n'a nullement vocation à se substituer aux législations des pays membres relatives à la procédure judiciaire. De ce point de vue, l'arrêt rapporté doit être approuvé, les seuls moyens de droit, dont l'invocation eût été salvatrice pour les Établissements MAMADOU SAMBA DIALLO, étant l'existence d'un accord de coopération judiciaire entre le Sénégal et la Guinée affranchissant leurs citoyens respectifs du paiement de la caution *judicatum solvi*⁶¹, ou la possession au Sénégal d'immeubles d'une valeur suffisante pour assurer ce paiement (voir article 16 du Code civil de 1804).

II. La distinction entre la caution *judicatum solvi* et les cautions exigées par les annexes de l'Accord de Bangui

L'exigence d'un dépôt de la caution *judicatum solvi* dans les procédures mettant en cause les droits de propriété intellectuelle peut prêter à confusion au regard des dispositions des annexes à l'Accord de Bangui qui prévoient la faculté pour le juge d'imposer un cautionnement lorsqu'il y a lieu à saisie, laquelle se mue en obligation lorsque le demandeur à cette saisie est un étranger⁶².

Au vrai, à l'égard de l'étranger, la confusion entre les deux types de cautions est d'autant plus facile que les buts poursuivis sont relativement identiques, à savoir garantir le paiement des dommages et intérêts, ainsi que les frais auxquels il pourrait être condamné. Cependant, quelques éléments permettent de conserver une fine ligne de démarcation entre les deux types de cautions.

- Tout d'abord, en ce qui concerne leur champ d'application, la caution *judicatum solvi* n'est jamais appliquée aux nationaux tandis que la caution exigée en matière de saisie concerne tantôt les nationaux, tantôt les étrangers.
- Ensuite, en ce qui concerne les caractères de ces cautionnements, celui applicable en cas de saisie est tantôt facultatif, tantôt obligatoire alors que la

caution *judicatum solvi* est toujours obligatoire dès lors que la demande en est faite et que l'étranger ne dispose pas d'immeubles suffisants qui pourraient garantir l'indemnisation éventuelle du national, et que son pays n'est pas engagé dans une convention de coopération judiciaire qui l'en dispenserait, avec le pays du juge saisi du litige.

- Enfin, en ce qui concerne leur régime procédural, le cautionnement en cas de saisie est ordonné d'office dans la mesure où l'ordonnance qui le contient est unilatérale alors que la caution *judicatum solvi* constitue une exception de procédure qui doit être soulevée par la partie adverse dans le cadre d'un contentieux contradictoire⁶³.

Il découle de ce qui précède que les deux cautionnements sont distincts. La question pourrait alors se poser de savoir si l'on peut les cumuler dans la même procédure.

L'hypothèse de travail serait la suivante : le demandeur étranger saisit le juge afin qu'il ordonne une saisie-contrefaçon; dans son ordonnance, ce juge impose une caution pour se conformer aux dispositions de l'annexe applicable. Par la suite, le demandeur étranger introduit l'instance au fond tel qu'exigé par la loi. Devant le juge du fond, le défendeur national soulève l'exception de caution *judicatum solvi*. Le juge doit-il considérer que le cautionnement résultant de l'ordonnance ayant autorisé la saisie vaut caution *judicatum solvi*? Le doute est permis.

Avant d'esquisser une réponse à la question posée, il importe de relever la situation qui ne soulèverait aucune difficulté; il s'agit de celle dans laquelle le juge du fond, non tenu par les mesures prises par le juge du provisoire, pourrait décider d'annuler le cautionnement exigé au moment de la saisie et d'ordonner une caution *judicatum solvi* suffisante. En ce qui concerne la question elle-même, dès lors que les deux cautionnements visent le même objectif, on pourrait estimer que celui ordonné au moment de la saisie est suffisant. On affirmerait alors que "cautionnement sur cautionnement ne vaut". D'ailleurs, si on cumule les cautions, on dissuade l'introduction des actions en justice par les étrangers alors même que l'Acte de 2015 a, par ailleurs, précisé à l'attention du juge saisi d'une requête aux fins de saisie que le cautionnement qu'il ordonne, quel qu'en soit le débiteur, doit être "suffisant sans être de nature à décourager le recours à la procédure" (v. par ex. art. 65, al. 3, annexe I).

Pourtant, envisager un cumul ne serait pas incongru. En effet, même si les deux cautions visent à offrir des dommages et intérêts au défendeur, on peut se demander si la réparation recherchée concerne exactement le même préjudice. Cela revient à envisager de distinguer le préjudice qui naîtrait de la saisie de celui qui résulterait de l'exercice de l'action au fond.

61 Au sujet d'un tel accord, voir CA Littoral (Douala), 16 juillet 1999, *Air Afrique* : Revue camerounaise du droit des affaires, n° 2, p. 81.

62 Par exemple, l'art. 64 de l'annexe I relative au brevet dispose en son al. 4 que : "le cautionnement est toujours imposé à l'étranger qui requiert la saisie". Cette disposition est reprise par la quasi-totalité des dispositions des annexes relatives aux objets de propriété industrielle prévoyant la saisie-contrefaçon. Voir art. 64 al. 3 et 4 annexe I, art. 48 al. 3 annexe III et art. 31 al. 3 annexe IV de l'ABR-1999.

63 En outre, le plaideur qui n'a pas soulevé une telle exception en temps utile est, de manière irréfutable, présumé y avoir renoncé : CCJA, 1^{re} chambre, Arrêt n° 13 du 29 juin 2006, *Ohadata*J-07-27.

La frontière est bien mince, d'autant plus qu'on peut estimer que c'est la même action qui est exercée par l'étranger de manière séquentielle. Pourtant, il pourrait exister quelques situations, certes marginales, dans lesquelles la distinction serait possible. D'une part, il faut rappeler que la caution *judicatum solvi* est destinée à couvrir l'indemnisation, mais aussi les frais auxquels pourrait être condamné l'étranger. Dans cette optique, elle peut être fixée par le juge du fond, en tenant compte du montant préalablement versé au titre de la caution au moment de la saisie; elle viendrait alors compléter ce montant. D'autre part, on peut envisager l'hypothèse dans laquelle le saisissant a outrepassé les limites voulues par l'ordonnance de saisie (par exemple, en lieu et place d'une saisie-description, le saisissant effectue une saisie réelle) puis, a vu son action partiellement fondée (par exemple, la contrefaçon n'a pas été reconnue à l'endroit de tous les produits saisis). Dans cette hypothèse, la caution relative à la saisie permet la réparation pour la saisie abusive et la caution *judicatum solvi* couvrirait une éventuelle autre faute résultant non plus de la saisie, mais de l'exercice abusif de l'action au fond ainsi que les frais.

Joseph Fometeu
Max Lambert Ndéma Elongué

E. Cour commune de justice et d'arbitrage (CCJA) de l'OHADA – Propriété intellectuelle – Compétence – Cour suprême nationale

La cour commune de justice et d'arbitrage (CCJA) de l'OHADA est en principe incompétente à connaître des affaires soulevant des questions relatives à l'application de l'Accord de Bangui et ses annexes.

La saisie-contrefaçon instituée par la législation communautaire est autorisée par le président du tribunal civil statuant comme juge des requêtes et non par le juge des référés.

Cour Commune de Justice et d'Arbitrage, Arrêt n° 005/2007 du 1^{er} février 2007, SOCIÉTÉ PLAST-KIM c. SOCIÉTÉ OCI-PLAST

Observations :

Dans l'arrêt rapporté, la CCJA s'est, sans détours, déclarée incompétente pour connaître des affaires soulevant des questions relatives à la propriété intellectuelle. Pourtant, cette problématique alimente des querelles au sein de la communauté des praticiens du droit de la propriété intellectuelle conduisant parfois au rendu de décisions contraires par les juridictions d'un même État. À titre d'illustration, le président du tribunal de première instance de Yaoundé-Centre Administratif statuant comme juge du contentieux de l'exécution a retenu sa compétence pour connaître de la rétractation d'une ordonnance de saisie-contrefaçon d'une œuvre littéraire et artistique sur le fondement des articles 336 et 337 de l'Acte uniforme OHADA n° 6 portant procédures

simplifiées de recouvrement et des voies d'exécution⁶⁴. En revanche, saisi de la même question mais en matière de marque, le président du tribunal de première instance de Yaoundé-Ekounou a décliné sa compétence motif pris de ce que l'Acte uniforme susvisé n'a pas réglementé la saisie-contrefaçon qui relève par conséquent du droit commun⁶⁵. Dans l'affaire commentée, la Cour suprême de Côte d'Ivoire s'est dessaisie d'une affaire relative à l'application de l'AB-1977 au profit de la CCJA.

Faits : La société PLAST-KIM, propriétaire d'un modèle de récipient en plastique déposé à l'OAMPI⁶⁶, a constaté que sa consœur, la société Océan Ivoirien de plastique dite OCI-PLAST, fabriquait et commercialisait des récipients en plastique identiques en tous points aux siens. Elle a par conséquent obtenu du président du tribunal de première instance d'Abidjan statuant en référé une ordonnance de saisie-contrefaçon, laquelle fut déferée devant la cour d'appel par la société OCI-PLAST.

Cette juridiction infirma l'ordonnance entreprise motif pris de l'incompétence du juge des référés à statuer sur les articles 36 et suivants de l'annexe IV de l'AB-1977, dispositions qui confèrent cette prérogative au juge des requêtes.

La société PLAST-KIM s'est pourvue en cassation. La Cour suprême de Côte d'Ivoire a relevé que l'affaire soulevait des questions relatives à l'application de l'Acte uniforme portant sur le droit commercial général et s'est dessaisie du dossier au profit de la Cour commune de justice et d'arbitrage. Vidant sa saisine dans cette cause, la CCJA a décliné sa compétence et renvoyé l'affaire devant la Cour suprême de Côte d'Ivoire initialement saisie.

Raisonnement : L'analyse de cette décision permet de lever le voile sur les prérogatives du président du tribunal civil en matière de propriété intellectuelle (section I) et de tracer une ligne de démarcation entre les matières relevant de la CCJA et le droit de la propriété intellectuelle (section II).

I. La compétence du président du tribunal civil en matière de propriété intellectuelle

L'Accord de Bangui, Acte du 24 février 1999 (ABR-1999), reconnaît au président du tribunal civil ses prérogatives classiques dans le cadre de la mise en œuvre des droits de propriété intellectuelle. Le texte communautaire indique expressément que ce magistrat est compétent en matière d'ordonnances sur requête (A), mais omet d'évoquer sa compétence *es qualité* de juge des référés, toute chose à l'origine des divergences d'interprétation dans la pratique (B).

64 Voir par ex. PTPI de Yaoundé - Centre Administratif, Ordonnance n° 150/C du 1^{er} décembre 2006, *NGANDINGA Éric c. SCAAP*.

65 Voir PTPI de Yaoundé-Ekounou, Ordonnance n° 62 du 18 mars 2008, *Société PZMP Sàrl c. Société D. Sàrl*. Voir dans le même sens, CA Littoral, Arrêt n° 28 du 28 janvier 2008, *Société BIC SA c. Société TBC SA* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 1, section F).

66 L'OAMPI, acronyme de l'Office africain et malgache de la propriété industrielle, a été créé le 13 septembre 1962 à Libreville. Cet accord a été révisé à Bangui le 2 mars 1977, après le retrait de Madagascar pour donner naissance à l'OAPI.

A. Les ordonnances sur requête

Le président du tribunal civil délivre des ordonnances de saisie-contrefaçon sur requête de la présumée victime et sous réserve de la production des pièces qui varient selon l'objet de propriété industrielle considéré⁶⁷. La saisie-contrefaçon est en effet une mesure gracieuse octroyée au titulaire du droit violé ou à ses ayants droits à l'encontre du présumé contrefacteur, celui-ci disposant en tout état de cause de la faculté de faire réviser ou retirer ladite mesure. Dans l'espèce commentée, la société PLAST-KIM, victime présumée de la contrefaçon de son modèle de récipient, a obtenu l'ordonnance de saisie-contrefaçon querellée plutôt par la voie contentieuse, notamment en assignant la société OCI-PLAST devant le juge des référés du tribunal de première instance d'Abidjan.

Le juge des référés est-il habilité à rendre des ordonnances de saisie-contrefaçon? L'analyse des lois régissant l'organisation judiciaire interne de la quasi-totalité des pays signataires de l'Accord de Bangui postule a priori une réponse négative, cette prérogative étant en général conférée au juge des requêtes. C'est la quintessence de l'argumentaire développé par la société OCI-PLAST devant le juge d'appel qui fit droit à son recours suivant Arrêt n° 696 du 17 octobre 2000 dont pourvoi. Cette approche paraît justifiée puisque les textes organisant la saisie-contrefaçon en matière de propriété industrielle font dépendre cette mesure d'une ordonnance rendue sur requête par le président du tribunal civil, dans le cadre d'une procédure non contradictoire.

B. Les ordonnances de référés

Bien que l'Accord de Bangui ne le dise pas expressément, la jurisprudence admet la possibilité pour la victime de la saisie-contrefaçon en matière de propriété industrielle de saisir le juge des référés de droit commun pour solliciter la rétractation de l'ordonnance y relative ou le cantonnement de la saisie dans l'optique de la limiter à quelques exemplaires des objets contrefaisants⁶⁸. Il importe de souligner que l'Acte de Bamako du 14 décembre 2015 ne prévoit pas non plus expressément le cantonnement de la saisie-contrefaçon⁶⁹, à la différence de la quasi-totalité des lois nationales régissant le droit d'auteur qui offrent la latitude à la victime de la saisie-contrefaçon de solliciter le cantonnement en référé⁷⁰. Cette mesure, du reste conforme au droit commun, peut valablement être

étendue en matière de propriété industrielle. C'est dire que la procédure de référé ne devrait être enclenchée que pour contester les conditions dans lesquelles l'autorisation de faire pratiquer la saisie-contrefaçon a été accordée et non pour prescrire cette mesure. La démarche de la société PLAST-KIM apparaît dès lors surprenante surtout qu'une saisie-contrefaçon ordonnée par la voie du référé et donc contradictoirement est en pratique inefficace, parce que dépouillée de l'effet de surprise qui y est par hypothèse attaché.

II. L'incompétence de la CCJA en matière de propriété intellectuelle

La CCJA a indiqué, contrairement aux énonciations de l'arrêt infirmatif attaqué, que la contestation soulevée n'est pas relative à l'application de l'Acte uniforme portant sur le droit commercial général, les parties ayant essentiellement fondé leurs moyens sur la violation des dispositions du Code ivoirien de procédure civile et administrative et celles de l'Accord de Bangui, Acte du 2 mars 1977. C'est dire que cette juridiction supranationale s'est déclarée incompétente en raison de la nature de l'affaire (A). Toutefois, il importe de souligner que cette incompétence de principe n'a pas une portée absolue (B).

A. L'incompétence de la CCJA fondée sur la nature de l'affaire

La question essentielle qui était soumise à l'appréciation de la Cour suprême de Côte d'Ivoire était celle de savoir si le juge des référés est habilité à ordonner une saisie-contrefaçon en application des articles 36 et suivants de l'annexe III de l'Accord de Bangui du 2 mars 1977. En l'espèce, s'il est incontestable que le litige à l'origine de cette affaire oppose deux sociétés commerciales, à savoir PLAST-KIM et OCI-PLAST au sujet de la fabrication et de la commercialisation des récipients en plastique allégués être contrefaisants, les débats n'ont à aucun moment achoppé sur l'application de l'Acte uniforme OHADA relatif au Droit commercial général tel qu'indiqué par la Cour suprême de Côte d'Ivoire. Cette haute juridiction était en réalité appelée à se prononcer sur la conformité de l'ordonnance de référé n° 3119/2000 rendue le 21 avril 2000 par le président du tribunal de première instance d'Abidjan aux dispositions pertinentes des articles 36 et suivants de l'annexe IV de l'Accord de Bangui du 2 mars 1977 relatives aux actions en justice et à la procédure en matière de dessins et modèles industriels. Nul doute que cette question relève du droit de la propriété intellectuelle. C'est donc à bon droit que la CCJA a décliné sa compétence et renvoyé l'affaire à la Cour suprême de Côte d'Ivoire. Cependant, l'incompétence de la CCJA en matière de propriété intellectuelle n'a pas une portée absolue.

B. La portée relative de l'incompétence de la CCJA en matière de propriété intellectuelle

L'exclusion de la CCJA du champ du contentieux de la propriété intellectuelle suscite des interrogations notamment lorsque l'on est en présence d'un litige relatif au droit des affaires tel que régi par le Traité de Port Louis et ses Actes subséquents, mais qui soulève des questions connexes de propriété intellectuelle.

67 Cf. dans l'ABR-1999, voir art. 64 al. 2 de l'annexe I, art. 47 al. 2 de l'annexe II en matière de modèles d'utilité; art. 48 al. 2 de l'annexe III en matière de marque; art. 31 al. 2 de l'annexe IV en matière de dessins et modèles industriels, etc. Il importe de souligner que l'ABR-2015 donne désormais compétence au président de la juridiction nationale compétente.

68 Voir en ce sens CA du Littoral (Douala), Arrêt du 28 janvier 2008, *Société BIC SA c. Société TBC SA* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 1, section F); PTPI Douala-Ndokoti, Ordonnance n° 189 du 22 août 2007, *SPN SA c. Société LM Co LTD*, inédit; Voir enfin PTPI Yaoundé-Ekounou, Ordonnance n° 62 du 18 mars 2008, *Société P2MP Sàrl c. Société D. Sàr*, inédit.

69 Révisé en tant que "saisie pour contrefaçon" dans l'ABR-2015.

70 Voir par ex. art. 86 de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins au Cameroun; art. 133 de la loi n° 2008-09 du 25 janvier 2008 portant sur le droit d'auteur et les droits voisins au Sénégal; art. 101 de la loi n° 032/99/AN du 22 décembre 1999 régissant le droit d'auteur et les droits voisins au Burkina Faso.

Cette problématique, déjà évoquée par un auteur⁷¹, est d'envergure, étant donné ses implications en termes de conflit de compétence entre cette juridiction supranationale des affaires et les juridictions nationales des États membres de l'OAPI, juges communautaires de droit commun en matière de propriété intellectuelle. Ce conflit est renforcé par l'absence d'un système juridictionnel OAPI dont l'une des conséquences serait de faire du juge OHADA un juge par défaut de la législation OAPI sur certaines questions⁷². Or, il ressort du texte organique de la CCJA que cette instance a compétence pour appliquer le droit produit par l'OHADA, organisation dont elle constitue l'organe de contrôle.

La Cour de justice de l'UEMOA a d'ailleurs indiqué dans l'avis n° 001/2000 du 2 février 2000 relatif au projet de code communautaire des investissements que l'interprétation par elle des actes uniformes OHADA porterait atteinte à l'exclusivité de la CCJA⁷³. Dans un tel contexte, peut-on envisager, comme le préconise *MENIE M'Essono (Ph.)*, une partition du contentieux de manière à ne confier à chacune des juridictions que les aspects relevant de ses attributions⁷⁴? Il va sans dire qu'une telle solution conduirait à "transformer les systèmes de droit (...) en un écheveau juridique difficile à démêler"⁷⁵. En effet, la perspective d'une partition du contentieux postule que la juridiction saisie se borne à régler les aspects du contentieux la concernant tout en se déclarant incompétente pour connaître du volet exclu de son champ d'intervention. Cette orientation met en exergue la difficulté qu'il y a à tracer une ligne de démarcation étanche entre le domaine de compétence de la CCJA et celui relevant des juridictions nationales en matière de propriété intellectuelle.

La CCJA peut par ailleurs être amenée à connaître du contentieux de la propriété intellectuelle dans le cadre de l'examen d'une sentence arbitrale rendue sous l'égide de l'arbitrage administré par cette instance juridictionnelle. L'arbitrabilité des litiges relatifs à la propriété intellectuelle est en effet expressément admise par l'Acte de Bamako du 14 décembre 2015. L'article 4.2) des dispositions générales de ce texte indique que "tous les litiges portant sur l'application du présent accord et de ses annexes peuvent être réglés par voie d'arbitrage ou de médiation". Cette position est d'ailleurs

confortée par la doctrine et la jurisprudence africaine⁷⁶. Or, le Centre d'arbitrage et de médiation institué par l'Acte de BAMAKO n'étant pas, à ce jour, opérationnel, il est parfaitement envisageable que les litiges relevant de son office soient provisoirement administrés sous les auspices de la CCJA. Quoi qu'il en soit, les difficultés susrelevées ne peuvent qu'être aplanies dans le cadre des accords de coopération judiciaire intercommunautaires.

Max Lambert Ndéma Elongué

F. Saisie-contrefaçon – Difficultés d'exécution – Compétence – Juge du contentieux de l'exécution – Non-application de l'article 49 de l'AUPSRVE – Droit commun national – Juge des référés – Juge du fond

Les difficultés d'exécution consécutives à une saisie-contrefaçon ne relèvent pas de la compétence du juge de l'exécution institué par l'article 49 de l'Acte uniforme portant procédures simplifiées de recouvrement et des voies d'exécution mais plutôt du juge du droit commun.

Cour d'appel du Littoral (Douala), Arrêt n° 28 du 28 janvier 2008, SOCIÉTÉ BIC S.A c. SOCIÉTÉ TBC S.A

Observations :

L'exécution de la saisie-contrefaçon peut donner lieu à un contentieux protéiforme soulevant des questions d'ordre juridique et pratique. L'une des problématiques fréquemment rencontrées a trait à la détermination du juge compétent pour connaître dudit contentieux. Est-ce le juge institué par l'article 49 de l'Acte uniforme de l'OHADA? Est-ce le tribunal appelé à trancher l'affaire au fond ou bien plutôt le juge des référés? La question est d'autant plus difficile que l'Accord de Bangui révisé ne fournit aucune indication à ce sujet, prêtant alors le flanc à des divergences d'interprétation au sein de l'espace communautaire. L'arrêt de la cour d'appel du Littoral ci-dessus rapporté souligne avec force que les difficultés d'exécution de la procédure de saisie-contrefaçon ne relèvent pas de la compétence du juge institué par l'Acte uniforme susvisé, mais bien plutôt du juge des référés classiques.

Faits : Les faits sont assez simples : la société BIC SA est propriétaire de la marque éponyme enregistrée à l'OAPI sous le n° 10922 apposée sur les stylos à bille qu'elle fabrique et commercialise. Ayant constaté que la société TBC commercialise les stylos identiques aux siens, elle a fait pratiquer saisie-contrefaçon sur les stylos allégués être contrefaisants en vertu d'une ordonnance n° 1327 du 5 juillet 2006 du président du tribunal de première

71 Voir *MENIE M'ESSONO (P.)*, La protection juridictionnelle dans l'espace OAPI, Chişinău (Éditions Universitaires européennes), 2013, pp. 103 et s.

72 Voir en ce sens *NGOMBE (L.Y.)*, OHADA versus OAPI. Lecture transversale et partielle : Revue africaine de la propriété intellectuelle, Collection OAPI, décembre 2013, pp. 31 et s.

73 Voir Cour de Justice de l'UEMOA, Recueil des textes fondamentaux et de jurisprudence de la Cour, Ouagadougou, 2008, p.229, cité par *SOSSA (D. C.)*, Les conflits des juridictions communautaires et les mécanismes de coopération inter-juridictionnels : Actes du Colloque sur le droit communautaire en Afrique sur le thème "De la concurrence à la cohabitation des droits communautaires", École Régionale Supérieure de la Magistrature (ERSUMA), Cotonou-Benin, du 24 au 26 janvier 2011, 1^{re} éd., 2011, pp. 126 et s. Voir *MENIE M'ESSONO*, n.71.

74 Voir *YADO TOE (J.)*, La problématique actuelle de l'harmonisation de droit des affaires par l'OHADA, Actes du Colloque sur l'harmonisation du droit OHADA des contrats - Ouagadougou 2007 : Revue de droit uniforme, 2008, p. 32. Disponible en ligne à l'adresse www.unidroit.org.

76 Voir en ce sens *EKANI (F.)*, L'arbitrage et la médiation dans le contentieux de la propriété intellectuelle : quel intérêt pour les États membres de l'OAPI? La propriété intellectuelle au service du développement de l'Afrique : Mélanges offerts à Denis EKANI, Collection OAPI n° 4, Paris (L'Harmattan), pp. 173 et s. Voir également Cour suprême du Congo, Arrêt n° 07/GCS.02 du 17 mai 2002, Chambre commerciale, *Société Linda-Communications c. Établissements Mic-Vidéo* (obs. FOMETEU (J.)), ce recueil, chapitre 1, section B).

instance de Douala-Bonanjo. La société TBC a saisi le juge des référés dudit tribunal en nullité et mainlevée de la saisie querellée.

Ce magistrat fit droit à sa demande, passant outre l'exception d'incompétence matérielle excipée par la société BIC SA qui a soutenu que seul le juge du contentieux de l'exécution institué par l'Acte uniforme susvisé était compétent en l'espèce.

Raisonnement : Saisie, la cour d'appel a infirmé l'ordonnance querellée et renvoyé la cause devant le juge des référés classique. Si la cour d'appel est formelle quant à la question du juge compétent pour connaître des difficultés d'exécution de la saisie-contrefaçon (section I), elle ne s'est guère prononcée sur celle non moins importante de l'office de ce juge (section II).

I. La détermination du juge des difficultés d'exécution d'une saisie-contrefaçon

Plusieurs difficultés peuvent naître au cours de l'exécution d'une saisie-contrefaçon. L'huissier instrumentaire peut en effet se heurter à la résistance du saisi qui pourrait fermer les portes de ses locaux, ou refuser de produire les documents sollicités. En outre, cet officier ministériel peut se trouver confronté à une difficulté d'ordre technique nécessitant l'assistance de l'homme de l'art. En revanche, le saisi peut solliciter la rétractation de l'ordonnance ayant autorisé la saisie, la nullité du procès-verbal de saisie, et même le cantonnement de cette mesure. Quelle est la juridiction habilitée à connaître de ces difficultés et contestations? En général, les annexes à l'Accord de Bangui, Acte du 24 février 1999 relatif à la propriété industrielle, sous l'empire duquel la décision rapportée a été rendue, accordent au président du tribunal civil compétence pour autoriser une saisie-contrefaçon. Elles restent cependant silencieuses quant à l'autorité judiciaire habilitée à connaître des difficultés qui pourraient survenir au cours de l'exécution de cette mesure. Trois juridictions ont théoriquement vocation à intervenir en fonction de la nature de la mesure envisagée, à savoir le juge des requêtes (A), le juge des référés (B) et le juge du fond (C).

A. Le juge des requêtes

Certaines difficultés qui naissent à l'occasion de l'exécution d'une saisie-contrefaçon peuvent être aplanies par le juge des requêtes ayant ordonné ladite mesure. Rien n'interdit en effet l'huissier instrumentaire de suspendre les opérations de saisie⁷⁷, et de se référer à ce magistrat pour solliciter des mesures complémentaires qui n'auraient pas été prévues dans l'ordonnance et qui s'avèrent nécessaires lors du déroulement de la saisie, notamment la présence d'un serrurier en cas de fermeture des voies d'accès, un expert-comptable lorsqu'il est indispensable de

77 Voir VÉRON (P.), *Saisie-contrefaçon*, 2^e éd., Paris (Dalloz), 2005, p. 61, n° 13.251. Cet auteur relève pertinemment que l'épuisement des effets de l'ordonnance ne fait pas obstacle à la suspension des opérations de saisie lorsque cela s'avère nécessaire pour mener à bien la mission fixée dans l'ordonnance.

rechercher des informations comptables du saisi pour déterminer la masse contrefaisante, un informaticien, etc. La jurisprudence française admet d'ailleurs la possibilité, pour l'huissier instrumentaire, de rechercher même d'office des informations comptables, sans que le président du tribunal ne puisse s'y opposer⁷⁸. En toute hypothèse, le recours au juge des requêtes doit être exceptionnel, la clause de référé insérée dans l'ordonnance rendue sur requête ouvrant généralement la voie du référé.

B. Le juge des référés

La société BIC a prétendu que le juge des référés est incompétent motifs pris d'une part de ce que les juridictions compétentes prévues par l'Accord de Bangui sont celles appelées à statuer sur le fond du litige en matière de contrefaçon, d'où le terme "tribunaux" contenu dans ce texte et la référence à la voie civile et la voie correctionnelle. Elle relève d'autre part que la saisie-contrefaçon étant une saisie conservatoire, les difficultés d'exécution qu'elle engendre sont, dans le silence de l'Accord de Bangui, du ressort du juge du contentieux institué par l'article 49 de l'Acte uniforme susvisé. Or, la première branche de l'argumentaire développé par la société BIC SA participe d'une imparfaite lecture des articles 47, alinéa 1 et 49, de l'annexe III de l'Accord de Bangui révisé.

L'article 47.1) indique que les actions civiles relatives aux marques sont portées devant les tribunaux civils et jugées comme matières sommaires⁷⁹. L'article 49 de l'Acte de Bangui du 24 février 1999 précise que faute pour le demandeur de s'être pourvu, soit par la voie civile, soit par la voie correctionnelle, dans le délai de 10 jours ouvrables, la description ou saisie est nulle de plein droit sans préjudice des dommages et intérêts qui peuvent être réclamés s'il y a lieu". Or, la référence aux termes "tribunaux", "voie civile", "voie pénale" ne signifie nullement que le législateur communautaire a entendu exclure l'intervention du juge des référés dans le processus de mise en œuvre des droits de propriété intellectuelle. La quasi-totalité des lois nationales relatives au droit d'auteur et aux droits voisins donnent d'ailleurs expressément compétence au juge des référés de droit commun en cette matière⁸⁰.

Il ne faut cependant pas perdre de vue le fait que l'ordonnance prescrivant une saisie-contrefaçon est une ordonnance sur requête soumise au régime général des ordonnances de cette nature qui doit pouvoir s'appliquer *mutatis mutandis* dans le silence de la loi spéciale régissant la propriété intellectuelle⁸¹. Cette

78 Voir en ce sens CA Paris, 8 juillet 1993 : PIBD 1993, n° 555, III, p. 673; TGI Paris, 3^e chambre, 30 juin 1994 : PIBD 1994, n° 576, III, p. 527.

79 L'art. 46 al. 1 de l'ABR-2015 a levé ce voile en précisant que les autres actions civiles relatives aux marques sont portées devant les juridictions nationales compétentes et jugées comme pour les matières sommaires. Cette nouvelle orientation est également reprise en matière de brevets d'invention, de modèles d'utilité, de dessins et modèles industriels, etc.

80 Cf. art. 86 de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins au Cameroun; art. 133 de la loi n° 2008-09 du 25 janvier 2008 régissant le droit d'auteur au Sénégal.

81 Voir en ce sens PTP! Yaoundé – Centre Administratif, Ordonnance de référé n° 301/C du 19 février 2007, *PMUC c. Alfred Meno* (obs. NDEMA ELONGUE (M.-L.), ce recueil, chapitre 4, section E).

solution est d'autant plus justifiée que dans la pratique, les magistrats insèrent presque systématiquement les clauses de réserve de référé dans les ordonnances de saisie-contrefaçon. C'est donc à bon droit que les juges d'appel ont posé "Que dans le cas d'espèce, le traité OHADA n'ayant pas réglementé les saisies-contrefaçons, celles-ci restent régies par les dispositions du droit commun; Que seul le juge des référés classique de l'article 182 du Code de procédure civile et commerciale demeure compétent pour connaître en urgence les difficultés inhérentes auxdites saisies; Qu'il y a donc lieu de déclarer le juge des référés classiques compétent". La compétence du juge des référés paraît dès lors évidente. La jurisprudence admet du reste cette compétence même postérieurement à la saisine du juge chargé de la gestion du contentieux de la contrefaçon au fond.

L'on peut toutefois objecter qu'une fois le juge du fond saisi après exécution de la saisie-contrefaçon, celui-ci pourrait appréhender l'ensemble du contentieux y compris celui né de l'exécution de cette mesure. Mais il n'en est rien, le président du tribunal statuant en référé pouvant être valablement saisi pour modifier ou rétracter la mesure gracieuse précédemment ordonnée. C'est d'ailleurs la solution retenue par l'article 497 du Code de procédure civile français qui reconnaît expressément la faculté au juge de modifier ou rétracter son ordonnance même si le juge du fond est saisi de l'affaire. La Cour de cassation a d'ailleurs censuré, au visa de cette disposition, une cour d'appel qui avait rejeté une demande de rétractation au motif qu'elle était fondée sur des moyens de nullité relevant du juge du fond sans rechercher si les conditions prévues par les textes pour procéder à une saisie-contrefaçon étaient réunies⁸².

C. Le juge du fond

Le juge du fond peut être amené à régler les incidents nés de la saisie-contrefaçon. S'agissant du Cameroun, il y a lieu de se référer à la loi portant organisation judiciaire⁸³, qui donne compétence aux tribunaux de première ou de grande instance en fonction du montant de la demande⁸⁴. Mais il convient de bien clarifier cette éventualité qui en principe n'est que résiduelle en ce sens que l'on conçoit mal une saisine du juge du fond par voie principale à cette fin. Très souvent, lesdites contestations sont soulevées comme moyens de défense par le présumé contrefacteur dans le cadre d'un procès en contrefaçon déjà pendant. Il en est ainsi de la contestation de la validité du procès-verbal de saisie et, dans une moindre mesure, de la demande reconventionnelle en réparation en cas de saisie abusive précisément lorsque cette procédure a été détournée de sa finalité exclusivement probatoire⁸⁵. On le voit, le juge des référés et son homologue du fond peuvent, chacun en ce qui le concerne, connaître des incidents nés de l'exécution de la saisie-contrefaçon. Il est cependant

impératif de bien baliser leur domaine respectif d'intervention tout en gardant à l'esprit la limite naturelle du juge des référés qui ne saurait, en tout état de cause, préjudicier au fond du droit.

II. L'office du juge des difficultés d'exécution d'une saisie-contrefaçon

Les développements qui précèdent nous ont donné l'opportunité de souligner la nature plurielle du juge des difficultés d'exécution de la saisie-contrefaçon. Le juge des requêtes ne sera cependant pas envisagé ici en raison du caractère beaucoup plus théorique que réel de son intervention. Ces difficultés interpellent principalement le juge des référés (A) et, accessoirement le juge du fond (B).

A. Le juge des référés : la rétractation ou la modification de l'ordonnance de saisie-contrefaçon

La victime d'une saisie-contrefaçon a la latitude de solliciter en référé la rétractation ou simplement la modification de l'ordonnance prescrivant cette mesure bien que l'annexe III à l'Accord de Bangui révisé ne le dise pas expressément. S'agissant de la rétractation, elle n'est envisageable que dans l'hypothèse où le saisi démontre que les conditions d'autorisation de la saisie-contrefaçon ne sont pas réunies. Dans le cas d'espèce, la société TBC aurait pu solliciter la rétractation de l'ordonnance n° 1327 du 5 juillet 2006 du président du tribunal de première instance de Douala-Bonango en invoquant par exemple le défaut du certificat d'enregistrement de la marque, le défaut de l'attestation de non-radiation et de non-déchéance, etc. Le certificat d'enregistrement de la marque permet de vérifier si le requérant en est effectivement propriétaire. Dans un arrêt rendu le 6 janvier 1932, la cour d'appel de Paris a rétracté une ordonnance de saisie-contrefaçon délivrée en faveur d'un propriétaire irrégulier⁸⁶. En outre, rien ne paraît s'opposer à ce que le présumé contrefacteur puisse solliciter la modification de l'ordonnance, notamment le cantonnement de la saisie en cas d'immobilisation de tout le stock ou d'une importante quantité des produits prétendus contrefaisants⁸⁷.

Au total, le recours en rétractation n'est possible que lorsque l'ordonnance de saisie-contrefaçon est obtenue dans des conditions irrégulières ou a autorisé des mesures excessives. Dès lors, l'office du juge des référés consiste exclusivement à réexaminer les conditions d'octroi de l'ordonnance de saisie-contrefaçon et la portée de cette dernière⁸⁸. La jurisprudence indique fort opportunément que le juge saisi, dans le cadre du référé rétractation, n'est investi que dans la limite des pouvoirs appartenant à l'auteur de l'ordonnance⁸⁹. Ainsi, le juge des référés n'est pas juge de la validité des opérations de saisie, encore moins du procès-verbal y relatif. L'on est par conséquent en droit de s'interroger sur la justesse de l'ordonnance de référé n° 509 du 20 septembre 2006

82 Voir Cour cass., 2^e chambre civile, 9 juillet 1997, n° 95-12.580, Bull. 1997, II, n° 231, cité par VÉRON (P.), *Saisie-contrefaçon 2013-2014*, 3^e éd., Paris (Dalloz), 2012, p. 148, n° 151.62.

83 Loi n° 2006/015 du 29 décembre 2006 portant organisation judiciaire modifiée et complétée par la loi n° 2011/027 du 14 décembre 2011.

84 Cf. art. 13 et s. de la loi n° 2006/015 du 29 décembre 2006.

85 VÉRON (P.), n.82, p. 157, n° 152.30.

86 Voir CA Paris, 6 janvier 1932 : Ann. propr. ind. 1932, p. 291 (note FERNAND-JACQ).

87 Voir en ce sens CA Dakar, Arrêt n° 501 du 28 décembre 2012, *Société Amarosa SA c. Société Moustapha Tall* (obs. LAMOTTE (M.)), ce recueil, chapitre 3, section K).

88 VÉRON (P.) n.82, p. 148, n° 151.71.

89 Cass. com., 9 juin 2009, n° 08-12.139, cité par VÉRON (P.), n.82.

dont appel, ayant annulé la saisie-contrefaçon querellée. L'incompétence du juge des référés semble acquise en l'espèce. La jurisprudence va d'ailleurs plus loin en indiquant de façon générale que les critiques formulées sur le déroulement de la saisie-contrefaçon ne peuvent pas être dévolues au juge des référés⁹⁰. Sous ce rapport, le juge des référés du tribunal de première instance de Douala-Bonanjo aurait dû soulever d'office son incompétence à prononcer la nullité de la saisie-contrefaçon, prérogative qui échoit naturellement au juge du fond.

B. Le juge du fond : La nullité du procès-verbal de saisie-contrefaçon

Le juge du fond saisi par la voie civile ou correctionnelle dans les conditions prévues à l'article 49 de l'annexe III de l'Accord de Bangui révisé peut être amené à annuler la saisie-contrefaçon pour deux raisons au moins : soit en raison des irrégularités commises par l'huissier instrumentaire à l'occasion de l'exécution de la saisie, soit pour défaut de saisine du tribunal compétent dans le délai de 10 jours prévu par cette disposition. La nullité du procès-verbal de saisie-contrefaçon peut résulter notamment de la nullité du certificat d'enregistrement de la marque invoquée à l'appui de la requête aux fins de saisie-contrefaçon, de la rétractation de l'ordonnance de saisie-contrefaçon, du détournement de la procédure de saisie-contrefaçon et, comme c'est le cas en l'espèce, des irrégularités affectant le procès-verbal de saisie-contrefaçon⁹¹. Cette solution paraît logique car, l'ordonnance autorisant la saisie-contrefaçon ayant été retirée de l'ordonnancement juridique, la saisie-contrefaçon pratiquée sur le fondement de cette décision est nulle de plein droit. Dans une intéressante affaire, la Cour a en effet jugé, en matière de droit d'auteur, qu'en l'absence de toute preuve matérielle de la contrefaçon, le saisissant ne peut faire consigner les déclarations du saisi⁹². Cette solution est transposable *mutatis mutandis* en matière de propriété industrielle.

Dans l'espèce rapportée, le premier juge a annulé la saisie-contrefaçon au motif que le procès-verbal y afférent ne mentionnait pas l'identité de l'huissier instrumentaire, omission qui, selon lui, viciait aussi bien la pièce que toute la procédure. Abstraction faite de l'inaptitude du juge des référés à connaître de cette question qui, à notre sens, relève de l'office du juge du fond, le grief invoqué à l'encontre du procès-verbal de la saisie querellée, à savoir le défaut d'identification de l'huissier instrumentaire, suscite quelques observations. La société BIC a en effet prétendu que la première page de l'exploit litigieux portait bien le cachet nominal de l'huissier instrumentaire en l'espèce Maître "TEKEU Victor" et qu'à la fin étaient apposés non seulement le sceau de l'État, mais aussi les nom, prénom, qualité, boîte postale, numéro de téléphone et signature de cet officier ministériel. Il paraît dès lors surprenant que le juge des référés ait retenu ce grief en dépit de

la pertinence de cet argument, aucune loi n'indiquant d'ailleurs la forme suivant laquelle l'identité des huissiers doit figurer sur les actes de leur ministère. Il importe de souligner que les textes servant de boussole à l'huissier instrumentaire dans le cadre de l'exécution de la saisie-contrefaçon sont le statut des huissiers de justice et le code de procédure civile de l'État dont il relève.

Les juridictions inférieures françaises manifestent parfois une certaine souplesse sur la question en admettant la validité d'un procès-verbal de saisie-contrefaçon au motif que le nom de l'huissier se déduit de la signature⁹³. La Cour de cassation s'est en revanche montrée plus sévère en rejetant le pourvoi formulé contre l'arrêt d'une cour d'appel qui avait annulé un procès-verbal de saisie-contrefaçon mentionnant seulement le nom de l'Étude de l'huissier⁹⁴. En tout état de cause, le procès-verbal de saisie-contrefaçon est un acte d'huissier obéissant aux règles générales des codes de procédure civile des États membres de l'OAPI.

Max Lambert Ndéma Elongué

90 CA Douai, 1^{re} chambre, Ordonnance de référé, 4 février 2002 : PIBD 2002, III, n° 741, p. 206.

91 Voir par ex. TGI Paris, 3^e chambre, 3^e section, 18 février 2011 : PIBD 2011, III, n° 941, p. 406.

92 Voir CA Paris, 4^e chambre, 7 octobre 1998 : PIBD 1999, III, n° 667, p. 16.

93 Voir par ex. TGI de Paris, 3^e chambre, 2^e section, 12 mars 1997 : PIBD 1997, n° 636, III, p. 391 et TGI Paris, 14^e chambre, 16 janvier 1998 : PIBD 1998, III, n° 653, p. 240.

94 Voir Cass. com., 20 octobre 1998 : PIBD 1999, III, n° 673, p. 131.

A.
Brevet d'invention – Conditions de validité
– Nouveauté – Possession personnelle
antérieure – Bonne foi

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Chapitre 2

Brevets d'invention

A. Brevet d'invention – Conditions de validité – Nouveauté – Possession personnelle antérieure – Bonne foi

Fait une inexacte application de la loi la cour d'Appel qui confirme la nouveauté d'un brevet de procédé motif pris de l'absence d'un procédé similaire, sans toutefois procéder à une recherche d'antériorité.

Le titulaire d'un brevet de procédé ne peut interdire à un concurrent l'exploitation de l'invention dès lors qu'il est établi que celui-ci exploitait de bonne foi le même procédé antérieurement à la délivrance du brevet revendiqué.

Cour d'appel de Niamey, Arrêt n° 170 du 7 août 2006, LA COOPÉRATIVE AL ITIHAD c. A.A

Observations :

L'arrêt rapporté rendu par la cour d'appel de Niamey dans un domaine où la jurisprudence des pays membres de l'OAPI demeure moins florissante illustre la diversification du contentieux de la propriété intellectuelle dans ces États.

Faits : Derrière la simplicité des faits se cache la complexité des questions juridiques à résoudre. Le litige oppose deux coopératives concurrentes ayant pour objet la fabrication du pain de sucre. En date du 16 février 2001, la coopérative AL ITIHAD obtient un agrément pour l'exercice de ses activités au Niger. Trois ans plus tard, la coopérative Tchékassane qui revendique la paternité du procédé de fabrication du pain de sucre a sollicité et obtenu l'autorisation de pratiquer une saisie-contrefaçon au préjudice de la coopérative AL ITIHAD. Après avoir obtenu la rétractation de l'ordonnance prescrivant la saisie, cette coopérative a assigné la saisissante en paiement des dommages et intérêts pour procédure abusive. Cette affaire a été classée pour des raisons non élucidées, classement qui consacre la fin du premier épisode de ce feuilleton judiciaire.

Le 12 avril 2002, Monsieur A.A, un des membres de la coopérative Tchékassane, avait déposé auprès de l'OAPI une demande de brevet du procédé de fabrication du pain de sucre ayant abouti à la délivrance d'un brevet à son profit le 7 octobre 2003. Informée de ce brevet, la coopérative AL ITIHAD a assigné cette fois Monsieur A.A devant le tribunal civil de Niamey d'une part aux fins de se voir conforter dans son droit d'utilisation du procédé litigieux et, d'autre part, de voir ordonner l'annulation dudit brevet et la radiation de toutes inscriptions y relatives dans les registres de l'Organisation. Le tribunal civil a validé le brevet litigieux

et interdit toute exploitation du procédé qui en est l'objet par la coopérative AL ITIHAD qui a déféré cette décision en appel.

Deux questions de droit étaient posées aux juges de la cour d'appel de Niamey : le procédé de fabrication du pain de sucre revendiqué était-il nouveau? Le cas échéant, la coopérative AL ITIHAD et ses membres étaient-ils en droit d'invoquer le bénéfice de la possession personnelle antérieure?

Raisonnement : La Cour a infirmé partiellement la décision critiquée en indiquant que sieur A.A, titulaire incontesté du brevet querellé, ne peut cependant interdire à la coopérative AL ITIHAD et à ses membres l'exploitation de l'invention y relative. Si cette décision peut être approuvée, ses motifs laissent toutefois transparaître un goût d'inachevé sur le double plan de :

- I. la brevetabilité de l'invention revendiquée et;
- II. l'octroi du bénéfice de la possession personnelle antérieure.

I. La brevetabilité de l'invention revendiquée

Abordant la question centrale de la brevetabilité du procédé de fabrication du pain de sucre, les juges d'appel ont confirmé la nouveauté et, par conséquent, la validité de cette invention (A), la demanderesse en annulation n'ayant pas rapporté la preuve du défaut de nouveauté (B).

A. La notion de nouveauté

La réponse à la question de droit posée est tributaire de la maîtrise des contours de la notion de nouveauté en droit des brevets. Dans cette perspective, il importe de convoquer les dispositions de l'article 2.1) de l'ABR-1999 qui définissent les critères de brevetabilité d'une invention. En vertu de ce texte, une invention est brevetable lorsqu'elle est nouvelle, implique une activité inventive et est susceptible d'application industrielle, l'invention pouvant consister ou se rapporter à un produit, un procédé ou l'utilisation de celui-ci. Ces trois critères qui conditionnent substantiellement l'accès d'un brevet d'invention à la protection légale doivent être cumulativement réunis¹. Dans l'espèce rapportée, le seul critère soumis à l'appréciation des juges d'appel est la nouveauté, la société AL ITIHAD, demanderesse

¹ Voir en ce sens CHAVANNE (A.) et BURST (J-J.), Droit de la propriété industrielle, 3^e éd., Paris (Daloz), 1990, pp. 28 et s. Voir également SCHMIDT-SZALEWSKI (J) et PIERRE (J-L.), Droit de la propriété industrielle, 4^e éd., Paris (Litec), 2007, pp. 37 et s.

à l'instance, contestant la nouveauté du procédé de fabrication de pain de sucre objet du brevet délivré par l'OAPI au profit de A.A.

Une invention est dite nouvelle si elle n'a pas d'antériorité dans l'état de la technique². Ainsi perçue, la nouveauté donnant prise à la protection légale est absolue, ce qui suppose, s'agissant du procédé de fabrication du pain de sucre, l'inexistence des éléments essentiels de cette invention dans l'état de la technique dont elle relève. Théoriquement, pour conclure à la nouveauté d'une invention, les instances compétentes de l'office de propriété industrielle explorent l'état de la technique, à l'effet de déterminer s'il n'y existe aucune antériorité véritable³. Certes, le procédé litigieux en l'espèce bénéficie d'une présomption de nouveauté pour avoir fait l'objet d'un brevet délivré par l'OAPI le 7 octobre 2003. Mais il convient de préciser que cette présomption est essentiellement réfragable car susceptible d'être contestée devant les instances juridictionnelles compétentes, surtout que, dans le système consacré par l'ABR-1999 sous l'empire duquel la décision rapportée a été rendue, l'OAPI ne procédait pas à l'examen de fond des conditions de brevetabilité mais simplement à l'examen de la régularité formelle de la demande⁴. Toutefois, l'entrée en vigueur de l'ABR-2015 a substantiellement modifié l'ordonnement juridique en ce qui concerne l'examen des demandes de brevet au sein de l'OAPI⁵. On le voit, la confirmation de la nouveauté passe désormais par un examen approfondi en vue de rechercher si le procédé incriminé ne se retrouve pas tout entier dans l'état de la technique⁶. En tout état de cause, il importe de réaffirmer qu'une fois le brevet délivré, l'invention qui en est l'objet jouit d'une présomption de nouveauté susceptible d'être remise en cause dans le cadre du contentieux de l'annulation.

2 L'art. 3 de l'annexe I de l'ABR-1999 indique qu'une invention est nouvelle si elle n'a pas d'antériorité dans l'état de la technique constituée par tout ce qui a été rendu accessible au public avant le jour du dépôt de la demande du brevet ou d'une demande de brevet déposée à l'étranger et dont la priorité a été valablement revendiquée. Cette disposition a été reprise *in extenso* par l'art. 3 de l'ABR-2015.

3 L'art. 3 al. 3 de l'annexe I de l'ABR-1999 précise les conditions dans lesquelles la nouveauté ne peut être détruite notamment si, dans un délai de 12 mois précédant le jour visé à l'al. 2, cette invention a fait l'objet d'une divulgation résultant d'un abus manifeste à l'égard du déposant de la demande ou de son auteur. L'ADR-2015 a supprimé l'expression "prédécesseur en droit" qui pourrait prêter à équivoque pour la remplacer par "son auteur".

4 L'étendue de l'examen de la demande de brevet varie d'un office à un autre. Classiquement, deux approches sont envisageables : la première matérialisée par l'examen approfondi de la demande consistant, après un examen de la régularité formelle, à procéder à une recherche des antériorités destructrices de la nouveauté ou pouvant affecter l'activité inventive. La seconde, consacrée par l'ABR-1999, privilégie l'examen de la régularité formelle de la demande et aboutit à la délivrance quasi-automatique des brevets sous réserve d'un éventuel rejet fondé sur la contrariété de l'invention à l'ordre public.

5 L'art. 23 de l'ABR-2015 institue désormais un examen de fond des conditions de brevetabilité, le rapport de recherche subséquent devant établir, outre les conditions de forme, les critères de fond de la brevetabilité. Il s'agit là d'une innovation majeure qui contribue à la crédibilisation des brevets d'invention délivrés par l'OAPI.

6 Voir, sur la question, CISSOKO (I.), Les dangers de la divulgation de l'invention, la perte de la nouveauté : Revue africaine de la propriété intellectuelle, Collection OAPI, octobre 2008, pp. 25 et s.

B. La preuve du défaut de nouveauté

La question de la preuve du défaut de nouveauté revêt deux aspects qui ont nourri les débats devant les juges d'appel.

Le premier aspect est relatif à la charge de la preuve. Qui, du titulaire ou du demandeur en annulation du brevet d'invention, doit rapporter la preuve de l'absence de nouveauté? La coopérative AL ITIHAD reprochait au premier juge d'avoir fait reposer la charge de la preuve sur elle plutôt que sur l'inventeur en se fondant sur les dispositions de l'article 43 de l'Accord sur les ADPIC, lesquelles semblent manifestement hors de propos, l'administration de la preuve en cette matière étant gouvernée par le droit commun. Doctrine et jurisprudence s'accordent, en effet, pour dire que lorsqu'un brevet est délivré par l'office de propriété industrielle, sa validité ne peut être affectée que si le demandeur en annulation rapporte la preuve que ce titre ne remplit pas telle ou telle condition de validité, la foi étant due au titre⁷. Cette orientation paraît d'ailleurs logique car lorsque le contentieux se lie sur la question de nouveauté, comme en espèce, le demandeur en annulation cherche à mettre la nouveauté en échec en démontrant que l'invention litigieuse est comprise dans l'état de la technique; autrement dit, qu'elle était accessible au public avant la date du dépôt de la demande ou de priorité. Il n'appartenait donc pas au titulaire, comme l'a soutenu à tort la société AL ATIHAD, de prouver que le brevet était valable, bien qu'il soit acquis que ce dernier pouvait être amené à démontrer l'inaptitude des moyens invoqués à mettre en cause la nouveauté dont est présumée jouir son invention.

Le second aspect est inhérent aux modalités de preuve. Comment prouver le défaut de nouveauté d'une invention? À la vérité, la preuve de l'absence de nouveauté se réduit à la démonstration, par le demandeur en annulation, de l'existence dans l'état de la technique d'une antériorité susceptible d'affecter la nouveauté de l'invention revendiquée. C'est dire que celui qui invoque le défaut de nouveauté est tenu de soumettre à l'appréciation souveraine du juge les éléments pertinents de l'état de la technique qui constitue "le socle de référence par comparaison duquel la conformité de l'invention à l'exigence légale sera vérifiée"⁸. C'est précisément l'obstacle majeur auquel s'est heurtée la société AL ITIHAD qui, devant les juges ayant successivement connu ce différend, s'est contentée d'affirmer, sans pouvoir rétablir la réalité de l'antériorité invoquée, à savoir son procédé de fabrication de pain de sucre. En l'absence de cette preuve décisive, la demande en annulation du brevet délivré à A.A était naturellement vouée à l'échec. Ne serait-ce qu'à ce titre, la décision rapportée est conforme au droit positif. Elle s'inscrit d'ailleurs dans le sillage de la jurisprudence de la cour d'appel de Paris qui pose de façon constante que le demandeur ne peut se borner à alléguer la nullité

7 Passa (J), Droit de la propriété industrielle, Tome 2, L.G.D.J 2013, p.453; Voir, dans le même sens, Raynard (J), Py (E), Tréfigny (P), Droit de la propriété industrielle, Lexis Nexis, Paris, pp. 66 et s.

8 Raynard (J), Py (E), Tréfigny (P), n 7.

d'un brevet d'invention sans rien prouver⁹ et qu'une antériorité n'est susceptible de détruire la nouveauté d'une invention que si elle est certaine à la fois quant à son contenu et quant à sa date¹⁰. Cette juridiction a pu en outre décider, dans une autre espèce, que l'existence d'un doute sur la validité du brevet, en raison notamment d'une absence de certitude sur la date, le contenu ou la portée d'une antériorité invoquée par le demandeur en annulation exclut l'annulation du brevet et profite ainsi au titulaire¹¹. C'est donc à bon droit que la cour d'appel de Niamey a pu relever : "Attendu que la coopérative AL ITIHAD ne produit pas aux débats sa technique de fabrication du pain de sucre... qu'en l'absence de cet élément de comparaison, la cour ne peut dénier à A.A d'avoir fait une invention nouvelle". La solution ainsi dégagée devrait naturellement avoir un retentissement sur la problématique de la légalité de l'octroi du bénéfice de l'exception de possession personnelle antérieure à la susdite société.

II. L'exception de possession personnelle antérieure

L'exception de possession personnelle antérieure, encore désignée sous l'expression générique "exception concernant l'utilisation antérieure"¹², est prévue à l'article 8, alinéa 1.d), de l'ABR-1999¹³. Historiquement, la possession personnelle antérieure est perçue comme un correctif à la règle du premier déposant en ce sens qu'elle privilégie le premier inventeur non déposant en lui conférant, sous certaines conditions, un droit d'exploitation sur l'invention objet d'un brevet ultérieur délivré au profit d'un tiers. En droit des brevets, une personne est habilitée à invoquer l'exception de possession personnelle antérieure d'une invention lorsque, sans l'avoir brevetée, elle la détient secrètement depuis une date antérieure au dépôt de la demande par un tiers portant sur la même invention¹⁴. Cette exception a pour finalité la recherche d'un juste équilibre entre les intérêts du titulaire du brevet et ceux de l'utilisateur antérieur qui pourrait avoir investi des ressources économiques, physiques et intellectuelles dans le cadre de l'utilisation de l'invention brevetée. La demande subsidiaire de la coopérative AL ITIHAD qui a reçu un écho favorable auprès des juges d'appel s'inscrit dans cette dynamique. Toutefois, la démarche de ces magistrats

est discutable sur le double plan des conditions d'octroi de cette mesure de faveur (A) et des effets qui y sont attachés (B).

A. Les conditions de l'exception de possession personnelle antérieure

Pour faire jouer l'exception de possession personnelle antérieure, le demandeur doit prouver sa possession de l'invention revendiquée (1) et sa bonne foi (2).

1. La possession de l'invention revendiquée

Le bénéfice de l'exception de possession personnelle antérieure est subordonné à la preuve préalable par le demandeur de la possession réelle de l'invention objet du brevet revendiqué avant la date de dépôt de la demande ou de priorité. Il ne saurait d'ailleurs en être autrement puisque l'on ne peut raisonnablement prétendre détenir une technologie fruit d'une activité inventive dont on ignore la teneur. La jurisprudence exige l'identité de la possession invoquée avec la technique couverte par le brevet et la connaissance complète par le demandeur de tous les éléments constitutifs de l'invention objet du brevet avant sa date de dépôt¹⁵. L'attribution de la charge de la preuve est gouvernée par le droit commun, la possession étant un fait juridique dont la preuve doit être rapportée par celui qui l'invoque. Or, cette preuve ne semble pas avoir été formellement rapportée dans l'espèce commentée, la société AL ITIHAD s'étant bornée à alléguer la possession antérieure sans toutefois produire son procédé de fabrication du pain de sucre, ou tout autre élément pertinent, ce qui a mis les juges dans l'impossibilité de vérifier si l'objet de la possession correspondait à l'invention couverte par le brevet délivré à A.A. La société demanderesse n'a pas non plus offert de prouver qu'elle avait une pleine connaissance de la technique de fabrication du pain de sucre dont la paternité est officiellement attribuée à A.A. Cette exigence fondamentale est réaffirmée par la doctrine spécialisée. Dans leur ouvrage précité, Albert Chavanne et Jean-Jacques Burst soulignent, en effet, que le possesseur ne peut valablement opposer son droit d'exploitation au propriétaire du brevet que si la possession porte sur la technique même couverte par le brevet, si elle est restée secrète et réalisée antérieurement au jour du dépôt ou de priorité du brevet. L'on peut dans ces conditions légitimement douter de la pertinence des raisons qui ont conduit les juges à donner plein effet à une possession non établie.

2. La bonne foi du possesseur

La bonne foi joue un rôle central dans l'attribution du bénéfice de l'exception de possession personnelle antérieure en ce que son absence permet d'exclure du cercle des bénéficiaires toute personne qui, bien que justifiant d'une possession remplissant les caractéristiques de certitude et d'identité, a eu connaissance de l'invention objet du brevet illégitimement c'est-à-dire par fraude, vol d'informations ou violation d'une obligation de confidentialité. La

9 CA Paris, 12 oct. 2001, PIBD 2002, n° 733, I.

10 CA Paris, 9 févr. 2001, PIBD 2001, n° 725, III, 389.

11 CA Paris, 29 nov. 1995, PIBD 1996 n° 605, III, 89; CA Paris, 28 mai 1999, PIBD 1999, n° 687, III, 501; voir, dans le même sens : Cass. Com., 18 mai 1999, Pourvoi n° 97 - 17461, PIBD 1999, n° 686, III, 473.

12 Cette exception est consacrée par plusieurs systèmes juridiques sous des appellations diverses. L'expression générique "exception concernant l'utilisation antérieure" est celle utilisée au sein de l'OMPI. Pour de plus amples informations sur la question, il convient de se référer aux résultats des travaux issus de la trente-deuxième session du Comité permanent du droit des brevets disponibles à l'adresse suivante : https://www.wipo.int/edocs/mdocs/scp/fr/scp_32/scp_32_3.pdf.

13 Aux termes de cette disposition, "Les droits conférés au brevet ne s'étendent pas : aux actes effectués par toute personne qui, de bonne foi à la date du dépôt ou, lorsqu'une priorité est revendiquée, à la date de priorité de la demande sur la base de laquelle le brevet est délivré et sur le territoire d'un État membre, utilisait l'invention ou faisait des préparatifs effectifs et sérieux pour l'utiliser, dans la mesure où ces actes ne diffèrent pas, dans leur nature et leur finalité, de l'utilisation antérieure effective ou envisagée".

14 CHAVANNE (A.) et BURST (J.-J.), n.1, pp. 282 et s.

15 CA Paris, 11 janvier 2006, PIBD 2006, 825, III B-155; TGI Paris, 4 septembre 2001, PIBD 2002, 739, III, 156.

question de la bonne foi du possesseur antérieur pourrait être abordée suivant deux approches. En effet, le possesseur pourrait avoir réalisé lui-même l'invention ou l'avoir simplement reçue du premier inventeur.

Dans la première approche, l'exception de possession personnelle antérieure remplit pleinement son but historique qui est de protéger les intérêts du premier inventeur qui n'avait pas déposé de brevet sur son invention mais qui l'exploitait avant la date de dépôt de la même invention par un tiers. C'est sans doute dans cette posture que s'est placée la société AL ITIHAD qui a prétendu fabriquer le pain de sucre "depuis sa création en 2001 selon les techniques éprouvées depuis la nuit des temps", mettant ainsi en avant l'antériorité de sa possession par rapport à la date de dépôt du brevet par A.A, à savoir le 12 avril 2001. Il importe de préciser que la société AL ITIHAD a reçu l'agrément le 16 février 2001, date qui correspondrait à celle du début de l'exploitation du procédé litigieux, surtout si l'on s'en tient au précédent conflit ayant opposé les deux coopératives concurrentes au sujet de la même invention. La question que l'on pourrait se poser à ce stade est celle de savoir si cette prétendue possession antérieure était faite de bonne foi. Les juges d'appel y ont répondu par l'affirmative au visa de l'article 8 de l'ABR-1999 précité, sans que la preuve de la bonne foi ait été formellement rapportée par la société AL ITIHAD. Une telle démarche est critiquable en ce qu'elle pourrait suggérer une interprétation extensive de cette disposition légale qui consacrerait alors une présomption de bonne foi au profit du possesseur antérieur qui prétend avoir réalisé l'invention.

Dans la seconde approche, l'exception profite à ceux qui, sans avoir réalisé l'opération inventive, ont bénéficié légitimement des informations communiquées par leur auteur. Ici la question centrale est liée au caractère légitime de la possession des informations par cette catégorie de personnes. Il pourrait s'agir notamment des héritiers du premier inventeur ou de ses ayants cause. C'est cette orientation que le sieur A.A a voulu donner aux débats, en évoquant les conditions peu orthodoxes dans lesquelles la société AL ITIHAD aurait eu connaissance du procédé de fabrication du pain de sucre litigieux notamment par l'entremise des ses ex-employés débauchés par elle. Ce phénomène, qui s'apparente du reste à un cas classique de concurrence déloyale¹⁶, est très courant dans le monde des affaires, s'agissant des entreprises relevant du même secteur d'activités, en l'espèce la fabrication du pain de sucre. En toute logique, le bénéfice de l'exception de possession personnelle devrait être exclu dans ce cas en raison des relations de travail qui auraient existé entre A.A et ses ex-employés. Dans une affaire similaire, la cour d'appel de Paris a écarté l'exception pour absence de bonne foi au motif que la connaissance que les possesseurs avaient des éléments du savoir-faire résultait d'un contrat de licence avec le breveté ultérieur, leur imposant une obligation de confidentialité.

B. Les effets de l'exception de possession personnelle antérieure

L'exception de possession personnelle antérieure confère au bénéficiaire le droit d'exploiter l'invention (1). Ce droit d'exploitation a cependant une portée limitée (2).

1. Le droit d'exploiter l'invention

La possession personnelle antérieure a pour effet de conférer à son titulaire le droit d'exploiter l'invention en dépit de l'existence d'un brevet pris par un tiers. Elle permet ainsi à son bénéficiaire d'entrer dans la sphère de protection du titulaire du brevet sans que celui-ci puisse lui opposer son droit exclusif. La décision rapportée est une illustration de la mise en œuvre de cette exception au droit exclusif du breveté consacrée par l'article 8 de l'ABR-1999. Les juges d'appel ont estimé que sieur A.A ne peut interdire à la coopérative AL ITIHAD et à ses membres d'exploiter son procédé de fabrication du pain de sucre malgré le brevet dont il se prévaut. À l'analyse, la reconnaissance d'un droit d'exploitation à AL ITIHAD paraît mitigée, du moins si l'on s'en tient aux objections précédemment formulées sur la réalité de la possession alléguée par ladite coopérative, lesquelles devraient en toute logique conduire à l'exclusion de cette mesure de faveur. L'extension de ce droit aux membres de la coopérative paraît tout aussi problématique pour deux raisons essentielles. La première est liée au statut des personnes bénéficiaires de l'exception. En effet, les membres, pris individuellement, sont des personnes physiques différentes de la coopérative personne morale dont ils relèvent, laquelle a une personnalité juridique propre. La seconde est relative au caractère personnel du droit d'exploitation qui est, en principe intransmissible, le bénéficiaire n'étant pas habilité à le céder ni à concéder des licences aux tiers¹⁷. L'ABR-1999 encadre d'ailleurs la transmission de ces prérogatives exceptionnelles à l'article 8, alinéa 2, *in fine* qui dispose : "Le droit de l'utilisateur visé au sous-alinéa 1)d) ne peut être transféré ou dévolu qu'avec l'entreprise ou la société ou la partie de l'entreprise ou de la société dans laquelle ont eu lieu l'utilisation ou les préparatifs en vue de l'utilisation".

2. Un droit d'exploitation limité

Le droit d'exploiter l'invention objet d'un brevet ultérieur conféré à titre exceptionnel au possesseur antérieur a une portée limitée étant donné que les actes d'exploitation y relatifs sont strictement circonscrits par la loi qui exclut certains actes du champ de l'exception. L'article 8, alinéa 1)d), de l'annexe I de l'ABR-1999 précité sous l'empire duquel la décision rapportée a été rendue précise en ce sens que la possession personnelle antérieure n'opère que dans la mesure où les actes ne diffèrent pas, dans leur nature et leur finalité, de l'utilisation antérieure effective ou envisagée. En vertu de cette disposition légale, le bénéficiaire de l'exception de possession personnelle antérieure ne peut exploiter l'invention brevetée que dans la mesure et telle qu'il l'utilisait avant la date de dépôt de la demande par le titulaire du droit, sans aucune possibilité

16 Voir art. 7 de l'annexe VIII de l'AB-2015 qui vise la concurrence déloyale par désorganisation de l'entreprise rivale.

17 Voir, sur le caractère personnel de la possession, SCHMIDT-SZALEWKI (J) et PIERRE (J-L), n.1, pp.37 et s.

d'utilisations nouvelles. Bien que la question n'ait pas été formellement posée dans cette affaire, il importe de l'évoquer dans l'optique de mettre en relief l'évolution consécutive à la récente révision de l'ABR-1999. L'article 7.e) de l'ABR-2015 dispose en effet : "Les droits conférés par le brevet ne s'étendent pas... aux actes effectués par toute personne qui, de bonne foi, à la date du dépôt ou, lorsqu'une priorité est revendiquée, à la date de la priorité de la demande sur la base de laquelle le brevet est délivré et sur le territoire d'un État membre, était en possession de l'invention". Cette nouvelle orientation paraît plus libérale en ce qu'elle offre au possesseur antérieur une large marge de manœuvre dans l'exploitation de l'invention objet du brevet sous réserve de l'interdiction qui lui est faite de transférer son droit aux tiers sans son entreprise.

Max Lambert Ndéma Elongué

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Chapitre 3

Marques de produits ou de services

A. Marques – Opposition à l'enregistrement d'une marque postérieure – Produits pharmaceutiques – Degré d'attention élevé des consommateurs – Risque de confusion (non)

Le degré d'attention du consommateur de produits pharmaceutiques est élevé, ce qui exclut tout risque de confusion entre les marques "BRONCHOKOD" et "BRONCHOBOS" dès lors que le préfixe "BRONCHO" est simplement indicateur de la destination thérapeutique des produits servant au traitement des pathologies respiratoires et bronchiques.

Commission supérieure de recours auprès de l'OAPI, Décision n° 00157 du 26 avril 2012, **SOCIÉTÉ BOSNALIJEK PHARMACEUTICAL AND CHEMICAL INDUSTRY c. SOCIÉTÉ SANOFI-AVENTIS France**

Observations :

Le risque de confusion joue un rôle essentiel en droit des marques. C'est lui qui donne la mesure de la protection en dehors des hypothèses où des signes identiques désignent des produits ou services identiques¹.

L'article 6, alinéa 3, de l'annexe III de l'Accord de Bangui, Acte de Bamako du 14 décembre 2015, interdit en ce sens, au titre des "droits conférés par l'enregistrement" : "a) la reproduction, l'usage ou l'apposition d'une marque, ainsi que l'usage d'une marque reproduite, pour des produits ou services similaires à ceux désignés dans l'enregistrement", et "b) l'imitation d'une marque et l'usage d'une marque imitée, pour des produits ou services identiques ou similaires à ceux désignés dans l'enregistrement", mais en précisant d'emblée que, dans les deux cas, la protection est subordonnée à l'existence d'un "risque de confusion dans l'esprit du public".

Le critère se retrouve dans l'article 3.a) qui prohibe l'enregistrement d'une marque qui "ressemble" à une marque antérieure "au point de comporter un risque de tromperie ou de confusion". Il en résulte que "les conditions auxquelles est soumise l'antériorité et, par voie de conséquence, les conditions de l'opposition ou de l'action en nullité de la marque seconde sont identiques à celles de l'action en contrefaçon"².

Faits : Dans la décision commentée, le litige, qui naît d'une opposition, permet de mieux cerner le concept de "consommateur d'attention moyenne" qui est au cœur du risque de confusion. La société Sanofi-Aventis France est titulaire de la marque "BRONCHOKOD" déposée en 1989 dans la classe 5. Elle a fait opposition à l'enregistrement de la marque "BRONCHOBOS" déposée en 2008 par la société Bosnalijek Pharmaceutical and Chemical Industry pour les produits de la même classe. Le directeur général de l'OAPI a rejeté l'opposition au motif que les marques des deux titulaires peuvent coexister sans risque de confusion. La société Sanofi-Aventis France a saisi la Commission supérieure de recours, estimant qu'il existe une similitude conceptuelle, visuelle et phonétique entre ces deux marques nominatives et verbales.

Raisonnement : Elle n'est pas davantage entendue par la Commission. Celle-ci part de l'idée que le risque de confusion doit être apprécié par référence au "consommateur moyen", qu'elle définit comme une "personne lettrée pouvant noter les différences existantes et ayant un niveau de discernement tel que qualifié dans l'espace OAPI". Elle estime que ce consommateur est d'autant plus à même d'identifier les différences entre les marques en cause que les produits qu'elles visent sont des "produits pharmaceutiques connus du milieu médical et délivrés sur conseil du médecin ou du pharmacien". De plus, le préfixe "BRONCHO", qui est "simplement indicateur de la destination thérapeutique des produits servant au traitement des pathologies respiratoires et bronchiques", est "descriptif et relève du domaine commun". Or il est de principe que "si une marque est constituée à partir d'un radical faisant partie du dictionnaire ou d'un terme faiblement distinctif en raison de la multiplicité des marques qui l'emploient, sa protection est plus limitée". En l'espèce, celle du demandeur ne peut valablement fonder l'opposition dès lors que les radicaux "KOD" et "BOS" qui sont adjoints au préfixe "BRONCHO" ne peuvent être confondus, "étant donné que leur sonorité est plus éloignée sur le plan phonétique", en sorte qu'il n'existe "aucune similitude entre les deux marques ni de risque de confusion pour le consommateur d'attention moyenne."

Le raisonnement comporte quelques légères failles. Ainsi, il est un peu surprenant de définir le "consommateur moyen" (la Commission supérieure de recours utilise ensuite l'expression plus orthodoxe de "consommateur d'attention moyenne") comme une "personne lettrée", ce qui peut évoquer un rapport à la littérature qui est évidemment hors de propos. On se perd, par ailleurs, en conjectures sur le sens de la

1 RAYNARD (J.), PY (E.) et TREFIGNY (P.), Droit de la propriété industrielle, Paris (LexisNexis), 2016, n° 457 à 461.

2 DURRANDE (S.), Juriscl. Marques – Dessins et Modèles, Fasc. 7110, 2010, n° 15. Voir en ce sens, en droit de l'Union européenne, Cour de justice de l'Union européenne, Arrêt du 20 mars 1993, *LTI Diffusion SA v. Sadas Vertbaudet SA*, C-291/00, ECLI:EU:C:2003:169, point 41.



précision selon laquelle ce consommateur a “un niveau de discernement tel que qualifié dans l'espace OAPI”. On ne voit pas non plus l'intérêt qu'il pouvait y avoir à relever une “prolifération de marques de produits pharmaceutiques de la classe 5 sur le marché”, vu que ce n'est pas le marché des produits pharmaceutiques en général qui est ici pertinent mais celui des produits destinés aux affections des voies respiratoires. Enfin, conclure qu'il n'existe “aucune similitude” entre les signes en conflit peut paraître excessif, et il aurait sans doute été plus rigoureux de parler d'une “similitude moyenne”, expression que l'on retrouve souvent dans la jurisprudence européenne³, ou de “similitude faible”.

Pour le reste, la démonstration emporte la conviction. La Commission supérieure de recours a raison d'évaluer le risque de confusion par rapport au standard du consommateur d'attention moyenne. Elle a raison de lier l'étendue de la protection de la marque antérieure à son caractère plus ou moins distinctif et d'en déduire que cette protection est plus limitée dans un cas comme celui de l'espèce où le radical “BRONCHO” est couramment utilisé pour des médicaments⁴. Elle a, enfin et surtout, raison de considérer que le degré d'attention du consommateur, qui varie selon la nature des produits couverts par les marques, est plus élevé pour des produits pharmaceutiques dont elle prend soin de relever qu'ils sont “connus du milieu médical et délivrés sur conseil du médecin ou du pharmacien”. Peut-être aurait-il été judicieux de mieux cerner le public pertinent, par exemple en se référant à la jurisprudence du Tribunal de l'Union européenne selon laquelle “lorsque les produits en cause sont des médicaments ou des produits pharmaceutiques, le public pertinent est constitué, d'une part, des professionnels de la médecine et, d'autre part, des patients en tant que consommateurs finaux desdits produits”⁵, étant précisé que les premiers font preuve forcément d'un “niveau élevé d'attention” et que les patients-consommateurs eux-mêmes “sont censés être raisonnablement bien informés, attentifs et avisés, dès lors que ces produits affectent leur état de santé”, qu'ils soient ou non prescrits sur ordonnance⁶.

On peut trouver la solution sévère au regard du fait que les deux marques nominales comportaient chacune 10 lettres en 3 syllabes et que 8 de ces lettres étaient communes et distribuées dans le même ordre. Mais ce constat statistique ne pouvait empêcher de tirer les conséquences des principes applicables.

On rapprochera la décision de deux arrêts rendus par le Tribunal de l'Union européenne concernant des marques couvrant des produits pharmaceutiques,

qui concluent également, l'un et l'autre, au rejet de l'opposition malgré les similitudes entre les signes en conflit. Dans l'affaire Kwizda, déjà évoquée, la marque querellée était le signe verbal UROAKUT. Elle avait été déposée pour des produits de la classe 5 ainsi décrits “Compléments alimentaires et préparations diététiques; préparations et articles médicaux et vétérinaires”. L'opposition était formée par le titulaire de marques figuratives UroCys désignant les produits suivants : “Substances diététiques et compléments alimentaires à usage médical, autres que pour le traitement ou la prévention de la goutte”. Après avoir soigneusement analysé la similitude existant entre les deux marques, le Tribunal conclut que “les différences visuelle, phonétique et conceptuelle portant sur les éléments supplémentaires ‘akut’ et ‘cys’ des signes en conflit ne sont pas négligeables dans l'impression globale des signes pour le public pertinent”, et qu'ils “compensent les similitudes visuelle”, phonétique et conceptuelle, lesquelles résultent uniquement de la présence de l'élément commun “uro” et de l'idée à laquelle il renvoie, et ce d'autant plus que le public pertinent fera preuve d'un niveau d'attention accru⁷, d'où il résulte que ces signes “sont globalement différents dans leur impression d'ensemble pour le public pertinent”⁸. La plupart des observations formulées sur le préfixe “uro”, qui renvoie au domaine de l'urologie, pourraient être transposées au préfixe “broncho” qui renvoie au domaine de la pneumologie.

Dans la seconde affaire⁹, la marque querellée était le signe verbal XENASA, couvrant les produits suivants : “Produits pharmaceutiques, à savoir pour le diagnostic, la prévention et/ou le traitement d'affections et troubles gastro-intestinaux; produits pharmaceutiques pour le traitement de l'inflammation du tractus gastro-intestinal; substances diététiques à usage médical, à savoir pour le diagnostic, la prévention et/ou le traitement des affections et troubles gastro-intestinaux”. L'opposition était fondée sur la marque de l'Union européenne verbale antérieure PENTASA, désignant des “produits et substances pharmaceutiques”. Là encore, le Tribunal, après avoir rappelé le principe selon lequel les consommateurs sont susceptibles de faire preuve d'un degré d'attention élevé lors de la prescription de produits pharmaceutiques¹⁰, écarte le risque de confusion, quel que soit le niveau d'attention des consommateurs finaux, qu'ils perçoivent ou non le suffixe commun “asa” des marques en conflit comme une référence au principe actif “5-asa” ou “mésalazine” et qu'ils identifient ou non les éléments verbaux “penta” et “xen” comme des références au mot grec “xenos” ou au préfixe d'origine grecque “penta”¹¹. Pour bien comprendre le raisonnement, il faut savoir que l'acide 5-aminosalicylique ou 5-ASA (*pentasa*), également connu sous les noms de mésalazine, est

3 Voir par ex., dans une espèce qui sera évoquée plus loin, Tribunal de l'Union européenne, Arrêt du 20 septembre 2018, *Kwizda Holding GmbH c. Office de l'Union européenne pour la propriété intellectuelle*, T266/17, ECLI:EU:T:2018:569, point 56.

4 Voir en ce sens, visant spécialement “l'usage de racines descriptives (...) dans domaine pharmaceutique”, FOLLIARD-MONGUIRAL (A.), *Juriscl. Marques-Dessins et Modèles*, Fasc. 7610-1, 2019, n° 277.

5 *Kwizda Holding GmbH c. Office de l'Union européenne pour la propriété intellectuelle*, n.3, point 25.

6 *Ibid.*, point 26.

7 *Ibid.*, point 81.

8 *Ibid.*, point 82.

9 Tribunal de l'Union européenne, Arrêt du 19 juin 2018, *Tillots Pharma AG c. Office de l'Union européenne pour la propriété intellectuelle*, T-362/16, ECLI:EU:T:2018:354.

10 *Ibid.*, point 23.

11 *Ibid.*, points 68 à 70.

un anti-inflammatoire utilisé pour traiter certaines maladies inflammatoires du côlon.

André Lucas

B. Reproduction servile d'une marque de service sur un site Web – Contrefaçon – Identité de signes et services – Besoin de preuve du risque de confusion (non)

La contrefaçon par reproduction servile d'une marque sur une page Web appartenant au contrefacteur est avérée dès l'instant où la victime établit la preuve de la validité de son droit exclusif et la simple reprise à l'identique de son signe distinctif pour accompagner des services identiques. En pareil cas, la victime est dispensée de la charge de la preuve d'un risque de confusion dans l'esprit du public, lequel risque reste toujours présumé.

Tribunal de grande instance du Wouri (Douala), Jugement civil n° 886/civ du 5 décembre 2016, FOREST STEWARDSHIP COUNCIL c. STÉ BORIS BOIS SARL

Observations :

Le XXI^e siècle est dominé par la recrudescence des échanges commerciaux via le cyberspace, offrant l'avantage de rationaliser le coût de production en touchant au gré d'un clic, les marchés lointains. Ceci n'est pas sans conséquences ravageuses pour les titulaires d'actifs de propriété industrielle consistant dans des marques. Dans les pays membres de l'OAPI, des batailles juridiques opposent entre eux ces néo-acteurs économiques, nouveaux "titans" de l'e-commerce, ballottés entre le monopole que confère le droit sur la marque, d'un côté, et l'exploitation économique de la fluidité du *world wide Web*, de l'autre¹². Le jugement dont commentaire est fait nous ouvre une fenêtre sur cette réalité.

Faits : En l'espèce, l'organisation non gouvernementale internationale FOREST STEWARDSHIP COUNCIL (FSC) était propriétaire d'un portefeuille comprenant quatre marques de produits et de services, à l'intérieur duquel se trouvaient les marques FSC + LOGO n° 68286 et FSC + LOGO n° 68289, régulièrement enregistrées à l'OAPI. Bien que ces enregistrements restaient d'actualité, l'ONG sus-identifiée fera le constat de l'utilisation à des fins commerciales, de ses marques FSC numérotées 68286 et 68289 par apposition de ces actifs sur la page Web d'accueil de la société BORIS BOIS dont le siège social est Douala. Pour préserver ses droits dans la perspective d'une éventuelle action en contrefaçon, l'ONG requérante va solliciter et obtenir du juge des requêtes du tribunal de première instance de Douala-Bonanjo une autorisation de procéder à la description détaillée de la page Web de la société requise. Un peu plus tard, le procès-verbal de description du 8 avril 2016 sera dressé,

permettant alors à l'ONG demanderesse d'assigner la société BORIS BOIS, par devant le tribunal de grande instance du Wouri (Douala), statuant en matière civile, à l'effet de mettre fin à cet usage illicite de ses marques, en obtenant du tribunal leur suppression sur le site Web de la société défenderesse.

Raisonnement : En dépit de la défaillance de la société BORIS BOIS à comparaître à l'audience et faire valoir ses prétentions, le tribunal saisi va examiner la cause au fond, en faisant droit à la demande initiale. En substance et quoique l'activité reprochée s'effectue complètement sur le cyberspace, le juge civil retient la contrefaçon par reproduction servile des marques FSC numérotées 68286 et 68289 (section I), et ordonne par conséquent leur suppression sous astreinte sur la page Web de la société défenderesse (section II).

I. Les conditions d'admission de la contrefaçon par reproduction servile des signes

Le juge de la cause rappelle brièvement les conditions d'admission de la contrefaçon par reproduction servile d'une marque (A), ceci indifféremment du milieu où prend forme l'activité incriminée (B).

A. Les conditions préalables à l'atteinte aux droits

Le tribunal de grande instance exige de celui qui agit en contrefaçon la preuve de son titre au jour de l'introduction de l'instance. Aussi, la victime doit faire preuve de son appropriation antérieure du signe contrefait, et que cette appropriation produit toujours ses effets au jour du procès.

L'action en contrefaçon appartient au titulaire de droit, celui qui le premier en a effectué le dépôt. Le certificat d'enregistrement est la preuve de l'appartenance du droit délivré au déposant. En toute logique, c'est à la victime de la contrefaçon de justifier son acquisition des droits sur le signe contrefait. Le juge de l'espèce le relève tout en constatant que l'ONG demanderesse a produit aux débats des certificats constatant l'enregistrement à son profit des deux marques litigieuses.

Concomitamment à cela, la victime doit prouver que depuis la date de l'enregistrement du signe, elle n'a pas perdu la protection à elle conférée par le droit positif en vigueur. En termes simples, elle devra prouver que ses droits sur la marque n'ont pas été frappés de déchéance à la suite d'un défaut de renouvellement, ou que son enregistrement n'a pas été radié du fait d'un défaut d'usage prolongé de la marque durant une période continue de 5 ans avant la saisine du tribunal. Ces préalables ont en effet été examinés par le juge qui a relevé dans sa motivation la production par la victime de certificats de non-déchéance et de non-radiation de ses actifs de propriété industrielle.

Ce n'est qu'après la satisfaction de ces éléments préalables qu'il convient d'apprécier les conditions de fond de l'admission de la contrefaçon *stricto sensu* sur le plan civil.

12 ANCEL (M.-E.), Un an de droit international privé du commerce électronique : Communication Commerce électronique, (n° 1, 2012), pp. 26 à 35.

B. Les conditions substantielles d'admission de la contrefaçon par reproduction au sens du juge

Tout comme le législateur communautaire, le juge saisi de la cause pose les conditions basiques d'admission de la contrefaçon par reproduction servile du signe¹³. Pour l'essentiel, le juge exige, non seulement une identité entre les signes querellés, mais aussi une identité entre les produits ou services (1) commercialisés sous la marque. Par ailleurs, il doit y avoir possibilité d'un risque de confusion dans l'esprit du public (2).

1. L'identité des produits et services

La contrefaçon de marque se définit en général comme une imitation illicite ou frauduleuse, une reproduction servile ou quasi servile de la marque d'autrui ou une violation du contrat de licence ou une exploitation sans licence de la marque d'autrui.

Dans le cas précis de la reproduction servile d'un signe, encore appelée contrefaçon *stricto sensu*, il faut relever que c'est la forme la plus évidente et qui a d'ailleurs longtemps été considérée comme synonyme de la contrefaçon elle-même¹⁴. Gastombide relevait déjà, à son temps, la dangerosité d'une pareille activité tournée vers le "détournement de la clientèle consommé au moyen d'une reproduction"¹⁵. La contrefaçon servile suppose une reproduction à l'identique du signe protégé par le contrefacteur, sans aucune différence perceptible avec le signe contrefaisant. En situation de différences insignifiantes ou imperceptibles entre les signes en conflit, on parlera de reproduction quasi servile. Dans ce dernier cas, la marque reproduite ne présente, par rapport à la marque originale, qu'une différence si légère qu'elle laisse subsister l'apparence d'une identité totale entre les marques¹⁶. L'identité des signes en conflit reste donc au centre de l'appréciation de la contrefaçon servile.

Dans l'espèce commentée, deux signes faisaient l'objet de reproduction servile, en l'occurrence les marques FSC + LOGO n° 68286 et FSC + LOGO n° 68289, régulièrement enregistrées à l'OAPI au profit de l'ONG demanderesse. Il était reproché à la société BORIS BOIS de les avoir repris *in extenso* sans la moindre différence ni le moindre ajout, avant de l'éditer sur sa page Web.

L'ABR-1999 réserve au bénéficiaire de l'enregistrement d'une marque des prérogatives exclusives, pouvant être actionnées positivement ou négativement.

- Positivement, il est le seul habilité à user du signe protégé, sous réserve de son autorisation à des tiers.
- Négativement, il dispose du monopole de l'interdiction

13 Voir art. 37 al. 1 let. a de l'annexe III de l'AB-1977. Voir aussi art. 57 al. 1 let. a de l'annexe III de l'ABR-1999.

14 MONTCHO AGBASSA (E.), Revue Congolaise de droit et des affaires, n° 27, janvier-février-mars 2017, p. 13. Office de l'harmonisation dans le marché intérieur (OHMI), Chambre des recours, 19 juin 2002, R 112003, *L'ij Diffusion ci Sadas SA* : PIDB 2003, III, p. 341. Voir aussi MONELLI (Y.), Contrefaçon : de l'appréciation de la contrefaçon : VIVANT (M.) (éd.), Les grands arrêts de la propriété intellectuelle, Paris (Daloz), 2003, p. 401.

15 GASTOMBIDE (A-J), Traité théorique et pratique des contrefaçons en tous genres, Paris (Le Grand & Descauriers Éditeurs), 1837, p. 410.

16 MATHELY (P.), Le droit français des signes distinctifs, JNA, 1984, p. 291.

de l'usage du signe protégé. Ainsi, c'est l'usage même de son signe par la défenderesse à l'instance qui était contesté, en l'absence d'une quelconque autorisation.

En faisant usage sur sa page Web des marques susvisées pour commercialiser ses services de gestion forestière, le tribunal saisi constate que la défenderesse a usurpé la réputation de l'ONG responsable de la gestion forestière, se rendant par conséquent coupable d'une reproduction à l'identique des signes distinctifs de la demanderesse.

En sus de l'identité des signes, la contrefaçon au sens strict suppose également une identité des produits ou services accompagnant la marque contrefaite¹⁷. C'est la répercussion du principe de spécialité cher au droit des marques qui postule que la protection accordée au titulaire du droit sur un signe utilisé au titre de marque ne produit des effets que dans la mesure où ce signe est utilisé en rapport avec les produits ou services mentionnés dans le certificat d'enregistrement, ou des produits ou services similaires. Les produits pertinents sont ceux mentionnés dans l'acte d'enregistrement. Leur comparaison doit alors être faite avec les produits ou services accompagnant le signe contrefaisant.

En l'état de la cause, le juge caractérise, de manière sous-entendue, l'identité des produits ou services en partant de la nature de l'activité exploitée par la défenderesse, professionnelle à l'instar de l'ONG FOREST STEWARDSHIP COUNCIL, dans la gestion forestière. Aussi le juge constate-t-il que les produits et services portés dans la demande d'enregistrement sont ceux portés aux classes 16, 19, 20, 31, 35, 40 et 42. Du rapprochement des activités des parties, le juge a déduit une identité des produits et services, susceptible d'alimenter un risque de confusion dans l'esprit du public.

2. L'existence d'un risque de confusion dans l'esprit du public

Ce critère est évidemment consubstantiel à l'idée de contrefaçon tout court, et par conséquent de contrefaçon servile. En d'autres termes, la contrefaçon n'est blâmable que dans la mesure où elle est susceptible de tromper le public sur l'identité d'origine des produits ou services. Le risque de confusion doit être apprécié par le juge. Il importe peu que la confusion ait effectivement été créée dans l'esprit du public, le droit réprime la probabilité du risque de confusion, qu'elle soit faible ou forte.

En droit OAPI, l'existence d'un risque de confusion est présumée en cas d'usage d'un signe identique pour des produits et services identiques¹⁸. Cette disposition exonère la victime de la contrefaçon d'avoir à prouver l'existence du risque de confusion en cas de contrefaçon *stricto sensu*¹⁹. Dans tous les cas, ce risque de confusion doit exister dans l'esprit du public pertinent, en prenant en considération son degré d'attention.

17 Cf. Décision n° 0069/OAPI/DG/SCAJ du directeur général de l'OAPI portant radiation de l'enregistrement de la marque "TUDOR", n° 40059.

18 Voir art. 7 al. 2 de l'annexe III de l'ABR-1999.

19 Décision n° 100/OAPI/DG/DGA/DAJ/SAJ du directeur général de l'OAPI portant radiation de l'enregistrement de la marque "ITEL Logo", n° 73235.

À bon droit, le juge civil a conclu, aux termes de l'examen des pièces et des preuves versées au dossier, à l'existence d'un risque de confusion dans l'esprit du public ciblé par les parties litigantes lorsqu'il conclut que "la défenderesse a illégalement utilisé des sigles de la demanderesse sur ses produits de manière à créer une confusion dans l'esprit du public". On voit très bien qu'à la réalité, il a fait bon usage des dispositions de l'article 7, alinéa 2, de l'annexe III de l'Accord de Bangui, en faisant jouer à la faveur de la victime de la contrefaçon servile la présomption de confusion.

II. La sanction de la contrefaçon par reproduction servile des marques querellées

Le juge sanctionne, en réponse à la demande initiale, la reproduction servile de la marque par la partie défenderesse, en enjoignant à cette dernière la suppression sur son site Web du signe contrefait (A). Cette décision n'est pas sans susciter critiques et observations quant à la compétence matérielle du juge civil saisi (B).

A. La suppression des signes contrefaits sur la page Web du défendeur : une sanction assez douce

Le panier des sanctions civiles à la contrefaçon des marques est assez fourni, offrant des mesures idoines à la mesure des récriminations faites aux contrefacteurs. Aux rangs des sanctions les plus prononcées, on distingue l'allocation des dommages et intérêts à la victime, diverses injonctions faites à l'auteur de cesser l'activité illégale, la publication de la décision rendue, la destruction des produits commercialisés sous la marque contrefaisante, les mesures d'astreinte, etc.

Dans le cas présent, le juge civil s'est limité à prononcer une mesure d'injonction contre la société BORIS BOIS. Le jugement a enjoint la suppression des signes contrefaits sur la page Web du défendeur. En complément à l'injonction, le juge a assorti ladite sanction d'une mesure d'astreinte, en vue de briser la récalcitrance de la défenderesse qui serait tentée de résister à l'exécution spontanée de la sentence judiciaire.

Par ailleurs, on ne peut que déplorer la légèreté de la sanction du juge dont la visée première serait d'endiguer la contrefaçon en dissuadant le défendeur de recommencer. Malheureusement pour la morale des affaires, le juge ne pouvait aller au-delà, les prétentions formulées dans l'acte de saisine et les écritures du demandeur initial ayant déjà fixé le lit de sa décision. S'il vidait sa saisine en se prononçant sur les chefs de demandes non contenus dans l'acte de saisine, le juge aurait alors statué *ultra petita*.

B. Les controverses soulevées par la décision rendue

Elles portent d'une part sur la compétence d'attribution du juge civil saisi, et d'autre part, sur le défaut d'appréciation d'une identité entre les produits et services contrefaits.

Concernant le premier point, la compétence est l'aptitude reconnue à un juge de trancher les litiges concernant

certaines matières, sur un espace géographique bien délimité. Lorsqu'elle est d'ordre matériel, elle est d'ordre public et donc susceptible d'être invoquée même d'office par le juge parce que concernant l'organisation du service public de la justice.

Le problème ici posé est celui de l'absence de désignation dans l'Accord de Bangui, du tribunal civil compétent pour connaître des actions relatives aux marques²⁰. À la lecture de l'article 47, alinéa 1, de l'annexe III de l'Accord de Bangui du 24 février 1999, "Les actions civiles relatives aux marques sont portées devant les tribunaux civils et jugées comme matières sommaires". Plus encore, la loi camerounaise n° 2006/015 du 29 décembre 2006 portant organisation judiciaire désigne les tribunaux de première et grande instance compétents *ratione quantitatem*, pour connaître du contentieux relatif aux actifs de propriété industrielle. Aux termes des art. 15 et 18 de la loi suscitée, le tribunal de première instance est compétent lorsque l'objet du litige est inférieur ou égal à dix millions de francs CFA et au-delà de ce montant, la compétence du litige est dévolue au tribunal de grande instance. Depuis 2006, il s'agit précisément des *chambres commerciales* des tribunaux de première et grande instance, en lieu et place des tribunaux de commerce existants dans certains États membres de l'OAPI. C'est donc à tort que la chambre civile avait retenu sa compétence pour connaître du différend. Au mieux, le juge aurait pu invoquer même d'office cette incompétence d'ordre matérielle puisqu'il s'agit d'un moyen d'ordre public.

Le deuxième problème de la décision de la Haute Cour réside dans certaines failles regrettables dans son raisonnement. Pour qu'il y ait contrefaçon par reproduction, il faut que les signes et les produits des deux parties soient identiques. Cette identité doit être réelle et prouvée, faute de quoi le demandeur peut être obligé de démontrer un risque de confusion entre ses produits et ceux du contrefacteur présumé. La question principale posée au juge était de savoir si les produits et services figurant sur les différents certificats d'enregistrement, relevant des classes 16, 19, 20, 31, 35, 40 et 42 de l'Arrangement de Nice, étaient identiques à ceux commercialisés par Boris Bois. Cette identité doit être réelle et prouvée, à défaut de quoi le demandeur peut être tenu de démontrer une vraisemblance. Ces classifications sont cependant de la confusion entre leur valeur administrative et non juridique. Les produits ou services d'une même classe ne sont pas nécessairement identiques, ni même similaires, alors que deux produits similaires et ceux du prétendu contrefacteur (ce n'est pas le cas en l'espèce) peuvent appartenir à des classes différentes.

Dans les motifs écrits de l'arrêt, la Haute Cour mentionne les catégories de produits et services contrefaits sans se risquer à les énumérer précisément et, sans conviction, déclare que les produits et services sont identiques. Or, rien de tel n'a été établi. La classification, en outre,

20 Voir EDOU EDOU (P.) (ed.), *Le contentieux de la propriété intellectuelle dans l'espace OAPI : Guide du magistrat et des auxiliaires*, Genève (OMPI), 2009, p. 73.

a une valeur administrative mais, semble-t-il, non juridique. Cela signifie que les biens ou services d'une même classe ne sont pas nécessairement identiques, ni même similaires. Inversement, deux signes et produits de nature similaire peuvent appartenir à des classes différentes mais seulement l'avoir présumé, sur la base de l'inventaire du site Web du défendeur et de l'activité du demandeur.

Aristide Fade

C. Marques – Action en déchéance pour défaut d'exploitation – Notion d'usage sérieux – Portée territoriale

Le titulaire de la marque doit, pour s'opposer avec succès à l'action en déchéance, prouver un usage sérieux et ininterrompu du signe invoqué à titre de marque sur au moins un des États membres de l'OAPI. Il n'y a pas lieu, à cet égard, de tenir compte des actes d'usage concernant une autre marque que celle enregistrée.

Tribunal de commerce d'Abidjan, Jugement du 27 octobre 2015, n° 3242/201, SOCIÉTÉ ANIL SARL c. COMPAGNIE AFRICAINE DE PRODUITS ALIMENTAIRES EN CÔTE D'IVOIRE (CAPRACI)

Observations :

Le jugement commenté aborde une question dont les enjeux pratiques sont considérables : en quoi doit consister l'usage sérieux de la marque susceptible de faire obstacle à la déchéance du titre pour défaut d'exploitation? Cette déchéance est prévue aujourd'hui par l'article 27 de l'annexe III de l'Accord de Bangui, Acte de Bamako du 14 décembre 2015, ainsi rédigé : "À la requête de tout intéressé, la juridiction nationale compétente peut constater la déchéance et ordonner la radiation de toute marque enregistrée qui : a) pendant une durée ininterrompue de cinq (5) ans précédant l'action, n'a pas été utilisée sur le territoire national de l'un des États membres pour autant que son titulaire ne justifie pas d'excuses légitimes".

Faits : Elle n'a pas toujours existé en droit des marques. En France, elle n'était pas prévue par la loi de 1857, ce qui était en cohérence avec le fait que l'acquisition du droit résultait, à l'époque, de l'usage. La Convention d'Union de Paris du 20 mars 1883 en prévoyait bien la possibilité mais de manière facultative pour les États signataires²¹.

Elle peut être justifiée de deux manières. D'abord, elle peut prendre appui sur le principe fondamental de la liberté du commerce et de l'industrie. L'idée est que le nombre de signes est forcément limité, ce qui rend de plus en plus difficile le choix par les opérateurs arrivant sur le marché d'une nouvelle marque. On peut alors trouver sain de lutter contre des signes "parasites",

souvent dénommés dans la pratique "marques de défense" ou "marques de barrage". Ensuite, la déchéance peut être justifiée par la nécessité de cantonner la marque à sa fonction de garantie d'origine, comme la Cour de justice des Communautés européennes l'a relevé dans l'arrêt *Ansu*²².

En l'espèce, la déchéance de la marque *Mama pour la cuisine de Maman*, délivrée par l'OAPI, avait été prononcée par un jugement du tribunal de commerce d'Abidjan rendu par défaut et le titulaire de cette marque faisait opposition en sollicitant la rétractation de la décision qui, selon lui, ne tenait pas compte du fait que la marque était effectivement exploitée au Bénin, pays membre de l'OAPI. À quoi la société qui sollicitait la déchéance objectait que la preuve n'était pas rapportée d'une utilisation ininterrompue et sérieuse sur le territoire béninois et qu'en toute hypothèse "l'obligation d'usage" imposée par l'Accord de Bangui s'étendait "à tous les pays membres de l'OAPI", donc à la Côte d'Ivoire, pays où était exercée l'action.

Raisonnement : Deux problèmes bien distincts devaient donc être résolus par le tribunal de commerce d'Abidjan, concernant :

- I. la teneur de l'exploitation requise; et
- II. sa localisation territoriale.

I. Teneur de l'obligation d'exploitation

Pour apprécier si l'usage revendiqué au Bénin caractérise une exploitation faisant obstacle à la déchéance, le tribunal, après avoir rappelé les termes de l'article 23 de l'annexe III, dans sa rédaction applicable à l'espèce (reprise littéralement dans l'article 27 issu de l'Acte de Bamako de 2015), le lit comme faisant peser sur le titulaire de la marque la charge de "prouver, par tout moyen, un usage sérieux et ininterrompu du signe invoqué à titre de marque, et permettant de le distinguer de ceux de ses concurrents", en précisant qu'on ne saurait prendre en compte à cet égard un "usage symbolique, ayant pour seul objet le maintien des droits créés par la marque". On note la référence à un usage "sérieux", adjectif qui ne figure pas dans le texte de l'Accord de Bangui mais que l'on retrouve dans la législation de l'Union européenne²³. On note aussi que la terminologie utilisée (usage du signe "à titre de marque", exclusion de l'"usage symbolique") rejoint celle utilisée par le fameux arrêt *Ansu*²⁴, dans lequel la Cour de justice des Communautés européennes a dit pour droit "qu'une marque fait l'objet d'un 'usage sérieux' lorsqu'elle est utilisée, conformément à sa fonction essentielle qui est de garantir l'identité d'origine des produits ou des

21 Art. 5-C al. 1 : "Si, dans un pays, l'utilisation de la marque enregistrée est obligatoire, l'enregistrement ne pourra être annulé qu'après un délai équitable et si l'intéressé ne justifie pas des causes de son inaction". Voir en ce sens l'art. 19 al. 1 de l'Accord ADPIC.

22 Cour de justice de l'Union européenne, Arrêt du 11 mars 2003, *Ansu BV c. Ajax Brandbeveiliging BV*, C-40/01, ECLI:EU:C:2003:145, point 37 : "La protection de la marque et les effets que son enregistrement rend opposables aux tiers ne sauraient perdurer si la marque perdait sa raison d'être commerciale, consistant à créer ou à conserver un débouché pour les produits ou les services portant le signe qui la constitue, par rapport aux produits ou aux services provenant d'autres entreprises."

23 Art. 18 al. 1 du Règlement UE 2017/1001 du 14 juin 2017 sur la marque de l'Union européenne (ci-après : Règlement UE 2017/1001).

24 *Ansu BV c. Ajax Brandbeveiliging BV*, C-40/01, n.22.

services pour lesquels elle a été enregistrée, aux fins de créer ou de conserver un débouché pour ces produits et services, à l'exclusion d'usages de caractère symbolique ayant pour seul objet le maintien des droits conférés par la marque”.

De façon très didactique, le tribunal de commerce d'Abidjan entre ensuite dans les détails de l'objet de la preuve à rapporter. Les “preuves acceptables”, relève-t-il, “doivent donner des indications sur le lieu, la durée, l'importance et la nature de l'usage qui est fait de ladite marque pour les produits et services pour lesquels elle est enregistrée”.

La Cour de justice des Communautés européennes s'inscrit dans la même optique, mais en élargissant encore davantage la perspective, lorsqu'elle pose le principe que l'usage sérieux doit s'apprécier “en tenant compte de l'ensemble des faits et des circonstances pertinents tels que, notamment, les caractéristiques du marché en cause, la nature des produits ou des services protégés par la marque, l'étendue territoriale et quantitative de l'usage ainsi que la fréquence et la régularité de ce dernier”²⁵.

Ce fardeau probatoire était-il assumé en l'espèce par le demandeur? Le jugement est plus elliptique sur ce point car on comprend à sa lecture que le tribunal opine pour la négative en se fondant principalement, comme on le verra ci-dessous, sur le constat que le lieu de l'exploitation n'est pas clairement établi. Malgré tout, il livre quelques enseignements sur les actes susceptibles d'être pris en compte pour caractériser concrètement le caractère sérieux de l'usage de la marque.

Positivement d'abord, il admet que parmi les pièces produites, à savoir des photographies de conditionnement de produits estampillés de la marque en cause, des bordereaux de commande, des connaissements, des emballages de produits marqués du signe, “certaines font, indubitablement, la preuve de l'existence matérielle et physique et de l'exploitation de la marque”. La formulation suscite la perplexité. On aurait aimé savoir quels étaient les éléments probants (*les photographies de conditionnement et les emballages, sans doute*) et pourquoi les autres (*les bons de commande? les connaissements?*) ne l'étaient pas. Savoir aussi si les utilisations pertinentes s'échelonnaient pendant toute la période de cinq ans, comme l'exige l'article 27²⁶ de l'annexe III en visant un usage “ininterrompu”.

Négativement, ensuite, le tribunal apporte une précision essentielle en relevant que les bordereaux de commande et les connaissements font référence, quant à eux, “à une marque *Mama* et non à la marque *Mama pour la cuisine de Mama* qui est présentement querellée”, d'où il infère que, s'agissant de “deux marques bien différentes”, l'usage éventuel de la première ne saurait, en toute

hypothèse, “servir comme preuve” de l'usage de la seconde.

L'affirmation peut prendre appui sur la lettre de l'article 27 précité, qui se réfère sans plus de précision à l'usage de la “marque enregistrée”. On est tenté de lui opposer l'article 5-C.2 de la Convention d'Union de Paris de 1883, qui dispose que “l'emploi d'une marque de fabrique ou de commerce, par le propriétaire, sous une forme qui diffère, par des éléments n'altérant pas le caractère distinctif de la marque dans la forme sous laquelle celle-ci a été enregistrée dans l'un des pays de l'Union, n'entraînera pas l'invalidation de l'enregistrement et ne diminuera pas la protection accordée à la marque”²⁷. Or l'article 19 de l'Accord de Bangui, Acte de Bamako de 2015, fait, en cas de contrariété, prévaloir les conventions internationales²⁸. Il est vrai qu'en sens inverse, on pourrait songer à écarter cette facilité probatoire lorsque le signe dont l'usage est allégué pour résister à l'action en déchéance a lui-même fait l'objet d'un enregistrement distinct, ce qui semblait bien être le cas en l'espèce pour la marque *Mama*. La Cour de cassation française s'était prononcée en ce sens²⁹, avant que la solution inverse s'impose en droit de l'Union européenne³⁰.

De toute façon, même en faisant abstraction de la difficulté liée à la pluralité de marques, la contrariété entre l'article 27 de l'annexe III et l'article 5-C.2 de la Convention d'Union de Paris peut être contestée si l'on estime que la suppression des termes “*pour la cuisine de Mama*” suffit à altérer le “caractère distinctif” de la marque objet de l'action en déchéance, au sens de la seconde disposition. Un arrêt du tribunal de première instance de l'Union européenne paraît fournir un argument en ce sens en lisant la disposition figurant actuellement dans l'article 18.1)a) précité du règlement européen 2017/1001 comme visant “l'hypothèse où une marque enregistrée, nationale ou communautaire, est utilisée dans le commerce sous une forme légèrement différente par rapport à la forme sous laquelle l'enregistrement a été effectué”, et en précisant qu'il en est ainsi “lorsque le signe utilisé dans le commerce diffère de la forme sous laquelle celui-ci a été enregistré uniquement par des éléments négligeables, de sorte que les deux signes peuvent être considérés comme globalement équivalents”³¹.

Le cas particulier de la suppression d'éléments figurant dans la marque enregistrée a donné lieu en France à une jurisprudence abondante assez difficile à synthétiser. Dans le sens de la sévérité, on peut citer un arrêt de la cour d'appel de Paris qui a refusé de considérer

25 Cour de justice de l'Union européenne, Arrêt du 19 décembre 2012, *Leno Merken BV c. Hagelkruis Beheer BV*, C-149/11, ECLI:EU:C:2012:816.

26 Art. 27 de l'annexe III de l'ABR-2015 identique à l'art. 23 de l'ABR-1999, soit la version applicable à ce cas.

27 Voir aussi l'art. 18 al.1 let. a du Règlement européen 2017/1001, n.23, réservant la possibilité d'opposer un tel usage à l'action en déchéance.

28 “En cas de divergence entre les dispositions contenues dans le présent accord ou dans ses annexes et les règles contenues dans les conventions internationales auxquelles les États membres ou l'Organisation sont parties, ces dernières prévalent”.

29 Cass. com., 20 juin 2006, n° 04-18.768.

30 Voir l'art. 18 al. 1 let. a du Règlement européen 2017/1001, n.23.

31 Tribunal de l'Union européenne, Arrêt du 23 février 2006, *Il Ponte Finanziaria SpA c. Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)*, T-194/03, ECLI:EU:T:2006:65, point 50.

que l'exploitation du signe *Seven* valait usage sérieux de la marque *Seven7*, au motif que la distinctivité de cette dernière tenait notamment à la répétition du chiffre 7³². Dans le sens d'une vision plus accommodante, on évoquera l'arrêt de la même cour décidant que l'exploitation des termes *Top Model* n'altère pas le caractère distinctif de la marque déposée *Top Model de Jean-Jacques Vivier*³³, hypothèse qui n'est pas loin de rappeler celle d'espèce. Mais, bien que le pourvoi formé contre cet arrêt ait été rejeté par la Cour de cassation³⁴, ce précédent est de peu de portée car la solution a été critiquée comme faisant trop bon marché des principes posés par l'arrêt du tribunal de première instance de l'Union européenne dans l'affaire précitée³⁵.

La position du tribunal de commerce d'Abidjan peut, on le voit, se recommander de solides arguments. Il est seulement regrettable que la discussion n'ait pas été menée sur ce point.

II. Localisation territoriale de l'exploitation

Aux termes de l'article 27 de l'annexe III de l'Accord de Bangui, Acte de Bamako de 2015, l'exploitation alléguée en défense à une action en déchéance de la marque doit être localisée "sur le territoire national de l'un des États membres". C'est cette condition qui est au cœur de l'argumentation du jugement commenté. Celui-ci, en effet, après avoir concédé que "certaines" des pièces produites aux débats établissent une exploitation de la marque *Mama pour la cuisine de Maman*, poursuit en affirmant que "ces éléments de preuve, pris ensemble ou individuellement, n'établissent pas que la marque querellée est effectivement exploitée au Bénin", et il met l'accent, en particulier, sur l'absence "d'un constat d'une personne assermentée, dont les actes font foi jusqu'à inscription de faux", attestant que les produits en cause "sont mis en vente au Bénin".

Le raisonnement est imparable. Comme l'article 27 précité le dit expressément, il suffit, pour que l'usage fasse obstacle à la déchéance, qu'il soit établi sur le territoire d'un État membre. L'affirmation péremptoire du demandeur à l'action en déchéance selon laquelle "l'obligation d'usage s'étend à tous les pays membres de l'OAPI, en sorte que le défaut d'exploitation dans un seul État membre expose la marque concernée à la radiation", ne résistait évidemment pas à l'examen. Encore faut-il que les faits d'exploitation soient localisés et cette preuve ne peut, en pratique, être rapportée autrement que par les déclarations d'une personne assermentée.

La seule réserve concerne l'accent mis sur le critère de la localisation territoriale. Là encore, la comparaison avec le droit de l'Union européenne peut se révéler fructueuse. L'article 18.1 précité du règlement 2017/1001 se réfère uniquement à l'usage de la marque de l'Union européenne "dans l'Union", sans viser expressément, comme le fait l'article 27 de l'annexe III de l'Accord de Bangui, l'hypothèse d'un usage "sur le territoire national de l'un des États membres". Mais l'adoption du règlement 2017/2009 du 26 février 2009, qu'il remplace et qui comportait la même disposition sur la déchéance³⁶, avait été précédée par une déclaration conjointe du Conseil affirmant que l'usage dans un seul pays constituait un usage sérieux au sein de l'Union.

Et cette solution a été, dans un premier temps, appliquée par l'EUIPO (*European Union Intellectual Property Office*)³⁷. Mais la Cour de justice a changé la donne dans l'arrêt *Leno Merken*³⁸, où elle a récusé cette automaticité. Elle y juge, en effet, que s'il est "justifié de s'attendre à ce qu'une marque communautaire, en raison du fait qu'elle jouit d'une protection territoriale plus étendue qu'une marque nationale, fasse l'objet d'un usage sur un territoire plus vaste que celui d'un seul État membre pour que celui-ci puisse être qualifié d'usage sérieux", il n'est pas exclu pour autant que, "dans certaines circonstances, le marché des produits ou des services pour lesquels une marque communautaire a été enregistrée soit, de fait, cantonné au territoire d'un seul État membre"³⁹.

Contrairement à ce qu'avait semblé décider antérieurement le tribunal de première instance⁴⁰ en érigeant en principe (il est vrai à propos d'une marque nationale et non d'une marque de l'Union européenne) que l'usage sérieux suppose que la marque soit présente dans une partie substantielle du territoire sur lequel elle est protégée. D'où elle déduit qu'il "est impossible de déterminer a priori, de façon abstraite, quelle étendue territoriale devrait être retenue pour déterminer si l'usage de ladite marque a ou non un caractère sérieux"⁴¹, avant de prescrire au juge national, dans une formule très générale, de tenir compte "de l'ensemble des faits et des circonstances pertinents".

Peut-être le tribunal de commerce d'Abidjan aurait-il pu s'inspirer de la méthode pour relativiser le critère de la localisation territoriale.

André Lucas

32 CA Paris, 6 juin 2005 : PIBD 2005, III, p. 551.

33 CA Paris, 9 juin 2006 : PIBD 2006, III, p. 612.

34 Cass. com., 4 décembre 2007, n° 06-18.901.

35 Voir par ex. TRÉFIGNY-GOY (P.) : Propr. ind. 2008, comm. 10, n° 6 : "Cette interprétation paraît bien compréhensive pour le titulaire de marques. Il n'est pas certain qu'il s'agisse d'une modification mineure...". LE BIHAN (É.), Juriscl. Marques-Dessins et modèles, Fasc. 7405-2, 2018, n° 83 : "À l'évidence, la marque telle qu'utilisée différerait sensiblement du dépôt effectué et l'on peut donc s'interroger sur la pertinence d'une telle décision quand la marque est finalement exploitée sous une forme tronquée de plus de 50%, alors que les éléments supprimés ne peuvent être considérés comme dépourvus de distinctivité."

36 Art. 51 du Règlement (CE) n° 2017/2009 du Conseil du 26 février 2009 sur la marque communautaire.

37 LE BIHAN (É.), n.35, n° 20, et les références citées.

38 *Leno Merken BV c. Hagelkruis Beheer BV*, n.25.

39 *Leno Merken BV c. Hagelkruis Beheer BV*, n.25, point 50.

40 Tribunal de l'Union européenne, Arrêt du 12 décembre 2002, *Kabushiki Kaisha Fernandes c. Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)*, T-39/01, ECLI:EU:T:2002:316.

41 *Ibid.*, point 55.

D. Marque – Enregistrement - Modification de l'objet de l'enregistrement – Action en contrefaçon – Relaxe du prévenu – Demande reconventionnelle en réparation – Évaluation du préjudice – Dommages – Intérêts forfaitaires

Au regard de l'article 7 de l'annexe III de l'Accord de Bangui révisé⁴², le titulaire d'une marque ne peut interdire ou poursuivre que l'usage illicite d'un signe similaire ou identique au signe enregistré pour des produits ou services qui sont similaires à ceux pour lesquels la marque de produits ou de service est enregistrée (A).

Dès lors, fait une bonne application de ce texte la cour d'appel qui, pour infirmer les premiers juges et rejeter la contrefaçon alléguée, rappelle que le droit exclusif d'exploitation ne saurait, sans un nouvel enregistrement, valoir pour des modifications apportées à la marque déposée en violation de l'article 21.3) de ladite annexe.

Ainsi, faute pour le demandeur de caractériser les faits constitutifs du délit de contrefaçon, il s'expose à une condamnation en réparation du préjudice causé au supposé contrefacteur si son action est jugée abusive ou vexatoire.

Cour d'appel de Brazzaville, Arrêt du 18 juillet 2006, MP et ADECHOKAN AMANDATOU c. YOUNOUSSA FATI et YOUNOUSSA SALAMATOU

Observations :

Le propriétaire d'une marque protégée a le droit d'empêcher ses concurrents d'utiliser des marques identiques ou des marques semblables au point de créer une confusion en ce qui concerne des biens et services identiques ou semblables à ceux pour lesquels il utilise sa propre marque. Il s'agit là de la consécration d'un droit exclusif du propriétaire de la marque appelé également droit privatif. Ce principe est bien posé par l'article 7, alinéa 3, de l'annexe III de l'Accord de Bangui du 2 mars 1977, révisé le 24 février 1999⁴³, portant création de l'Organisation africaine de la propriété intellectuelle qui dispose que "l'enregistrement de la marque confère également le droit exclusif d'empêcher tous les tiers agissant sans son consentement de faire usage au cours d'opérations commerciales de signes identiques ou similaires pour les produits ou services qui sont similaires à ceux pour lesquels la marque de produits ou services est enregistrée dans le cas où un tel usage entraînerait un risque de confusion". Le même principe est également adopté, sur le plan international, par l'article 16.1) de l'Accord sur les ADPIC selon lequel "le titulaire d'une marque de fabrique ou de commerce enregistrée aura le droit exclusif d'empêcher tous les tiers agissant sans son consentement de faire usage au cours d'opérations commerciales de signes identiques ou similaires pour des produits ou des services identiques

ou similaires à ceux pour lesquels la marque de fabrique ou de commerce est enregistrée dans les cas où un tel usage entraînerait un risque de confusion".

Ce principe signifie qu'en droit des marques, le titulaire du droit doit pouvoir, à tout le moins, faire cesser l'usage de signes similaires pour des produits similaires sur un même marché, lorsque cet usage est susceptible de créer une confusion chez les consommateurs sur l'origine ou l'autorisation de ces produits. Dans cette perspective, l'arrêt de la cour d'appel de Brazzaville dans cette affaire présente un intérêt juridique majeur.

Faits : Pour rappel, les dames YOUNOUSSA Fati et YOUNOUSSA Salamatou avaient fait enregistrer, auprès de l'Organisation africaine de la propriété intellectuelle, dite l'OAPI, le 17 avril 2001, la marque de tissu nommée "SULTANA ALWAYS THE BEST" composée de trois couleurs (rouge, blanche et or) et d'une couronne royale qui en constituait le logo⁴⁴. Constatant, courant 2004, la présence sur le marché de pagnes, portant les signes distinctifs "SYLVANA ELEGANCE BEST QUALITY", qu'elles estiment contrefaisants, les deux plaignantes ont demandé et obtenu du président du tribunal de grande instance de Brazzaville une ordonnance les autorisant à faire procéder, par le service des enquêtes économiques et financières de la direction de la police judiciaire, à la description détaillée des produits marqués, importés, livrés et vendus à leur préjudice, et à la saisie de deux exemplaires des produits contrefaisants dans tous les entrepôts et étalages.

En exécution de cette ordonnance, ledit service a procédé, le 15 mars 2004, à des saisies avec dépossession d'un lot de 250 pagnes provenant des Établissements ADE (Marna Bonheur) et ICE, revêtus de l'insigne "SYLVANA ELEGANCE". C'est dans ces circonstances que les dames YOUNOUSSA Fati et YOUNOUSSA Salamatou ont poursuivi les établissements ADE et ICE et la dame ADECHOKAN Amandatou devant la chambre correctionnelle du tribunal de première instance de Brazzaville qui, dans sa décision, a déclaré celle-ci coupable du délit d'exploitation illicite d'une marque enregistrée, avant de la condamner au paiement de la somme de vingt-cinq millions (25 000 000) de francs CFA à titre de dommages et intérêts à verser aux dames YOUNOUSSA.

Mme Adechokan a fait appel.

Raisonnement : La Cour, infirmant les premiers juges, a estimé que le délit de contrefaçon n'est pas constitué en considération, d'une part, de la violation par les plaignantes de l'interdiction de modification de la marque enregistrée et du principe de spécialité et, d'autre part, de l'absence de risque de confusion caractérisé. Elle a, également, reçu, à titre reconventionnel, la demande de réparation de la dame

44 Une telle marque peut être rangée dans la catégorie des marques semi-figuratives caractérisées par la combinaison d'un nom et d'un dessin. Voir : <https://www.depot-de-marque.com/guide-marques/marques-verbales-figuratives-et-semi-figuratives-les-differentes-formes-de-marques>.

42 Cf. art. 6 de l'annexe III de l'ABR-2015.

43 *Ibid.*

ADECHOKAN Amandatou pour saisie intempestive et abus de constitution de parties civiles des dames YOUNOUSSA Fati et Salamatou.

Elle s'est ainsi prononcée, très clairement, sur la question de savoir si l'usage de la marque sous une forme modifiée pouvait donner lieu à la protection de l'article 7 de l'annexe III de l'ABR-1999⁴⁵ et justifier ainsi le bien-fondé d'une action en contrefaçon. Dans son argumentaire, la Cour a réaffirmé :

- I. l'obligation d'utiliser la marque conformément au certificat d'enregistrement; mais également
- II. le pouvoir d'appréciation de l'action en contrefaçon par le juge du fond.

I. L'obligation d'utiliser la marque conformément au certificat d'enregistrement

Au regard de l'article 7 de l'annexe III de l'ABR-1999, le titulaire d'une marque ou d'une marque de service ne peut interdire ou poursuivre que l'usage illicite d'un signe similaire ou identique au signe enregistré pour des produits ou services qui sont similaires à ceux pour lesquels la marque est enregistrée (A). Cette protection ne saurait, sans un nouvel enregistrement, valoir pour des modifications apportées à la marque déposée en violation de l'article 21.3) de ladite annexe (B).

A. La protection de la marque : l'exigence de l'enregistrement préalable

Dans sa demande d'enregistrement, le titulaire d'une marque doit définir exactement ce qu'il entend protéger; l'ABR-1999, dans ses dispositions relatives aux actions en contrefaçon en vertu des articles 7 et 46 de l'annexe III, ne protège que ce qui est inclus dans la demande d'enregistrement. En d'autres termes, le déposant doit dès lors préciser tous les éléments de la marque qui seront protégés par l'action en contrefaçon⁴⁶.

En l'espèce, les juges d'appel ont opposé ce principe aux dames YOUNOUSSA qui avaient fait enregistrer auprès de l'Organisation africaine de la propriété intellectuelle (OAPI), le 17 avril 2001, la marque "SULTANA ALWAYS THE BEST", composée de trois couleurs rouge, blanche et or, comportant un logo dans le rond central, une couronne royale imprimée dans une couleur or. Ils ont relevé que si les signes ainsi déclarés pouvaient bénéficier d'une protection légale, en vertu de l'article 7 de l'annexe III ABR-1999, celle-ci ne saurait, par contre, s'étendre à d'autres signes ne figurant pas sur le certificat d'enregistrement. Cette conclusion résulte du constat

"Qu'il n'est fait aucune mention tant sur l'arrêté que sur la feuille de reproduction de la marque que SULTANA ALWAYS THE BEST peut toutefois être traduit en français TOUJOURS LE MEILLEUR selon la destination de la marchandise" et plus loin "que paradoxalement l'échantillon du pagne

apposé de la marque enregistrée SULTANA ALWAYS THE BEST n'y figure nulle part au dossier" et "qu'en lieu et place du logo enregistré sous le n° 45120 en date à Yaoundé du 19 février 2002", y figure au dossier un autre logo dénommé "SULTANA Les Griffes de Fati".

En somme, d'après la cour, le logo "SULTANA Les Griffes de Fati", figurant sur les pagnes supposés contrefaits, ne peut entrer dans le champ de protection de la marque "SULTANA ALWAYS THE BEST". De prime abord, la position de la cour est conforme à la lettre de l'article 7 de l'annexe III précité. N'est protégé que ce qui est déclaré⁴⁷.

Ce principe, maintes fois rappelé par la jurisprudence, trouve bien son application en l'espèce. En effet, en indiquant avoir fait enregistrer la marque "SULTANA ALWAYS THE BEST", les dames YOUNOUSSA ne pouvaient étendre la protection à des signes verbaux non visés dans l'acte d'enregistrement. Il est assez surprenant d'ailleurs que le titulaire d'une marque, qui justifie, pièces à l'appui, l'enregistrement de cette marque, produise comme preuve de l'atteinte à son droit des produits portant des signes non conformes à ceux décrits dans l'acte d'enregistrement.

La cour a relevé qu'en lieu et place de pagnes avec le logo "SULTANA ALWAYS THE BEST", les intimées ont versé aux débats des échantillons de pagnes portant le logo "SULTANA Les Griffes de Fati". La cour ne pouvait, dès lors, au risque de violer les dispositions de l'article 7 précité, retenir ce logo, qui ne figure pas dans l'arrêté portant enregistrement comme constitutif de la marque protégée. En effet, sauf pour les marques notoires⁴⁸, le certificat d'enregistrement est le référentiel pour établir l'étendue de la protection de la marque⁴⁹. Et ce certificat est établi sur la base des renseignements figurant sur le formulaire de dépôt. C'est pourquoi il est important pour le déposant de procéder, conformément à l'article 8 de l'annexe III de l'ABR-1999, à une description de la marque et/ou sa reproduction et d'énumérer les produits pour lesquels l'enregistrement du signe est demandé ainsi que les classes correspondantes de la classification internationale des produits et services aux fins de l'enregistrement des marques. Ainsi, la marque doit être utilisée conformément au certificat d'enregistrement.

En outre, pour mieux asseoir son argumentaire, la cour a fait appel au principe de spécialité qui aurait été violé par les dames YOUNOUSSA. Ce principe signifie que la marque doit être exploitée et n'est protégée que pour les produits ou services visés au dépôt. En effet, la marque est déposée pour désigner des produits et/ou des services afin d'en déterminer l'origine, ce qui est la fonction essentielle de la marque. En application de

45 Devenu l'art. 6 de l'annexe III de l'ABR-2015.

46 Voir art. 8 de l'annexe III de l'ABR-1999 devenu l'art. 9 de l'annexe III de l'ABR-2015.

47 Voir PASSA (J.), Droit de la propriété intellectuelle (Marques et autres signes distinctifs), Tome I, 2^e éd., 2009, pp. 147 à 149. Voir aussi CA Paris, 10 novembre 2000 : PIBD 2001, III, n° 716, p. 143.

48 Voir art. 6 de l'ABR-1999, art. 5 de l'annexe III de l'ABR-2015, art. 6 bis de la Convention de Paris du 20 mars 1883 pour la protection de la propriété industrielle et art. 16 al. 2 et 3 ADPIC.

49 Voir art. 16 de l'annexe III de l'ABR-1999 (devenu art. 20 de l'annexe III de l'ABR-2015).

ce principe de spécialité, celle-ci ne fera, dès lors, l'objet d'une appropriation que pour les produits et services qu'elle désigne.

Toutefois, le respect de ce principe ne se pose pas en l'espèce, dès lors que le produit déclaré dans l'acte d'enregistrement, qui est le tissu, a été produit en échantillon et se trouve être le même que celui incriminé par les dames YOUNOUSSA. Le problème se situe plutôt, comme l'a d'ailleurs relevé la cour, dans la discordance entre les signes verbaux enregistrés au titre de la marque et ceux figurant sur les pagnes produits comme preuve de l'action en contrefaçon de marque. La cour, l'ayant apparemment compris, s'est contentée d'évoquer le principe de spécialité sans le développer dans son argumentaire. Elle a plutôt insisté sur le fait que ce changement de logo ne pouvait être considéré comme une modification de l'enregistrement dès lors que la modification de la marque n'est pas admise par la loi.

B. La protection de la marque : la non-prise en compte des modifications

La cour, corrigeant le premier juge, a pris le soin de rappeler que la marque déposée ne peut faire l'objet de modification au regard de l'article 21.3) de l'annexe III de l'ABR-1999 qui dispose clairement qu'"aucun changement ne peut être apporté ni à la marque ni à la liste des produits ou services pour lesquels ladite marque avait été enregistrée". Elle a adopté cette position en considération de la production aux débats d'échantillons de pagnes portant le logo "SULTANA Les Griffes de Fati" en lieu et place de la marque enregistrée "SULTANA ALWAYS THE BEST".

La cour a apprécié cette différence constatée sur le signe verbal, comme une modification apportée à la marque déposée, et a infirmé le premier juge qui avait admis la modification sur le fondement de l'annexe II de l'ABR-1999 relatif aux modèles d'utilité au lieu de faire application de l'article 21, alinéa 3, de l'annexe III. En effet, les dames YOUNOUSSA avaient effectivement fait enregistrer comme marque un ensemble de signes verbaux "SULTANA ALWAYS THE BEST" et de signes figuratifs de "trois couleurs rouge, blanche et or, comportant un logo dans le rond central, une couronne royale imprimée dans une couleur or". Cette position des juges d'appel est conforme à la loi, notamment à l'article 21, alinéa 3, de l'annexe III de l'ABR-1999 qui interdit toute modification apportée à la marque et aux produits ou services pour lesquels ladite marque a été enregistrée. Il n'est donc pas possible de modifier une marque en changeant l'un de ses éléments essentiels notamment le nom, le logo ou l'extension du libellé⁵⁰. Il est dès lors très important, dès le dépôt, de bien s'assurer de la marque que l'on souhaite déposer et de rédiger un libellé adéquat qui la protégera durablement.

Il est vrai, dès lors que la marque est enregistrée pour dix (10) ans, au regard de l'article 19 de l'annexe III de l'ABR-1999, et peut être indéfiniment renouvelée, que le titulaire peut être tenté de modifier sa marque en fonction de l'évolution de sa situation ou de son activité. Mais, comme les juges d'appel l'ont bien rappelé, il devra pour cela faire un autre dépôt dans les conditions prévues par les articles 8 et 9 de l'annexe III de l'ABR-1999⁵¹. Ce dépôt sera alors soumis à un examen préalable de l'OAPI conformément aux dispositions des articles 13 et 14 de ladite annexe.

Toutefois, il faut dire que la question de la modification de la marque donne lieu à une jurisprudence très fournie à l'étranger et notamment en France. Malgré l'interdiction formelle de procéder à un changement des éléments de la marque, cette jurisprudence admet certaines modifications qui ne sont pas de nature à altérer la distinctivité de la marque. Ainsi, la cour d'appel d'Aix-en-Provence en France a admis l'usage indépendant d'une partie d'une marque lorsque l'autre partie de cette marque est en particulier redondante⁵².

Dans la même lancée, la Chambre commerciale de la Cour de cassation a confirmé l'arrêt de la cour d'appel de Paris qui avait retenu comme valable l'usage modifié d'une marque dès lors que cette modification n'altère pas le caractère distinctif de ladite marque⁵³.

Il faut tout de même signaler que, contrairement à l'annexe III de l'ABR-1999 applicable aux faits de l'espèce, le code de la propriété intellectuelle français autorise à son L714-5 §1 l'usage d'une "marque sous une forme modifiée n'en altérant pas le caractère distinctif". Cette atténuation à l'interdiction de modification de la marque est aussi prévue par l'article 5C.2) de la Convention de Paris⁵⁴ à laquelle fait référence l'Accord de Bangui révisé. C'est donc avec satisfaction que l'on relève que l'Acte de 2015 de l'Accord de Bangui s'inscrit dans cette logique de souplesse en autorisant à son article 27, alinéa 2, de l'annexe III l'usage d'une marque, sous une forme modifiée n'en altérant pas le caractère distinctif.

Mais, en l'espèce, l'adjonction du signe verbal "les GRIFFES de Fati" à "SULTANA", en lieu et en place de "ALWAYS THE BEST", modifie substantiellement la

51 Devenus art. 9 et 10 de l'annexe III de l'ABR-2015.

52 Cour d'appel d'Aix-en-Provence, Chambre 3-1, 21 mars 2019, n° 16/07491. Cette juridiction a estimé "qu'il ne peut être contesté que l'élément distinctif de la marque verbale déposée est le terme 'pierre du Vallat', les signes "les pierres du vallat" précédant le groupe "la pierre du vallat" apparaissent comme un élément redondant, observation étant faite que tel que déposé, le signe complet ne peut faire l'objet d'un usage réel dans la vie économique du fait de sa longueur inusuelle".

53 Cass. com., 12 décembre 2018, n° 10633F : "la marque française 'MONKIOSQUE.FR MONKIOSQUE.NET', déposée en 2006, se lira 'monkiosque' en une seule fois et ne tire pas sa distinctivité du doublement du même mot, et que les extensions .fr et .net ne sont liées qu'aux nécessités de l'Internet et ne présentent pas plus de caractère distinctif mais également que l'adjonction d'un élément figuratif et de couleurs n'altère pas le caractère distinctif de ladite marque."

54 L'article 5C al. 2 de la Convention de Paris du 20 mars 1883 pour la protection de la propriété industrielle dispose que "l'emploi d'une marque de fabrique ou de commerce par le propriétaire, sous une forme qui diffère, par des éléments n'altérant pas le caractère distinctif de la marque dans la forme sous laquelle celle-ci a été enregistrée [...] n'entraînera pas l'invalidation de l'enregistrement et ne diminuera pas la protection accordée à la marque."

50 Cass. ass. plén., 16 juillet 1992 : PIBD 1992, III, n° 534, p. 659 : JCP E-44 (1992), p. 239 (note BURST (J.-J.)); CA Paris, 4^e chambre, 21 mars 1983, *Sté Nicolas Napoléon c. Sté Dulong Frères et Cie* : Ann. propr. ind. 1983, p. 73. THRIERR (A.) et THRIERR (O.), *Jurisl. Marques*, Fasc. 7720, novembre 2004, p. 23.

marque "SULTANA ALWAYS THE BEST" à telle enseigne que, même en application de l'article 27, alinéa 2, de l'Acte de 2015, une telle modification de la marque ne pourrait être admise. La Cour a raison de ne pas reconnaître le signe verbal "SULTANA LES GRIFFES DE Fati" comme relevant de la marque protégée "SULTANA ALWAYS THE BEST".

Par contre, son appréciation de la contrefaçon est problématique.

II. L'appréciation souveraine de l'action principale en contrefaçon et l'admission de la demande reconventionnelle en dommages et intérêts par le juge de fond

Les points saillants de cette décision sont les suivants :

- A. il appartient au demandeur de prouver devant le tribunal l'existence d'une atteinte à son droit à la marque, et le juge apprécie souverainement la contrefaçon alléguée; et
- B. faute pour le demandeur de caractériser les faits constitutifs du délit de contrefaçon, il s'expose à une condamnation en réparation du préjudice causé au supposé contrefacteur si son action est jugée abusive ou vexatoire.

A. L'appréciation des conditions de la contrefaçon

Dans sa démarche, la cour s'est d'abord prononcée sur la régularité de la saisie-contrefaçon ordonnée suivant ordonnance du 10 mars 2004 du président du tribunal de grande instance de Brazzaville et pratiquée par le service des enquêtes économiques et financières de la direction de la police judiciaire, avant de procéder à une appréciation du risque de confusion dans l'esprit du public entre les marques en cause.

S'agissant de la saisie-contrefaçon, la juridiction d'appel considère que "les premiers juges ont ordonné des saisies sur la base de cette marque déposée, sans en vérifier conformément à l'article 48, alinéa 2, si le titulaire du droit avait justifié l'enregistrement de la marque par la production, comme cela a été constaté au dossier, d'un arrêté, et surtout de la production de la preuve de non-radiation et de non-déchéance". La Cour revient ainsi sur les conditions de fond de la saisie-contrefaçon. Effectivement, le président du tribunal, saisi d'une requête aux fins de saisie-contrefaçon, conformément aux dispositions de l'article 48 de l'annexe III de l'ABR-1999, doit, avant de faire droit à la requête, vérifier si le requérant est titulaire d'une marque valide et disponible. À cet effet, le juge de la requête, de même que la juridiction saisie de la contestation de l'ordonnance de saisie, doit exiger la production de l'arrêté d'enregistrement de la marque et d'un certificat de non-radiation et de non-déchéance, pièces qui permettent de s'assurer de l'existence d'une marque protégée au jour de la requête⁵⁵.

55 Art. 48 al. 2 de l'annexe III de l'ABR-1999 : L'ordonnance est rendue sur simple requête et sur justification de l'enregistrement de la marque et production de la preuve de non-radiation et de non-déchéance.

La Cour a ainsi reproché aux premiers juges de n'avoir pas procédé à cette vérification alors surtout qu'"il est troublant de constater que le titulaire d'une marque enregistrée bien précise, tout en se prévalant de cette marque enregistrée se complait à présenter à la justice des échantillons d'un autre logo, comme si cette marque enregistrée était radiée ou tombée en désuétude". Au regard des remarques de la cour, la production de ces pièces, surtout du certificat de non-radiation et de non-déchéance, aurait permis de vérifier si la marque "SULTANA ALWAYS THE BEST" faisait l'objet ou non de radiation ou de déchéance.

Certes, cette observation des juges d'appel est juste au regard des dispositions de l'article 48 de l'annexe III de l'ABR-1999, mais on remarquera qu'ils n'ont tiré aucune conséquence de ce constat. Et il est permis de s'interroger sur la pertinence d'évoquer, à ce stade de son argumentaire, le problème, non pas de l'exécution de la mesure de saisie-contrefaçon, mais de l'ordonnance l'ayant autorisée, dès lors qu'ils avaient fini de démontrer, dans les considérants précédents, que l'usage de la marque modifiée ne pouvait donner lieu à la protection de l'article 7 de l'annexe III de l'ABR-1999. Autrement dit, que les dames YOUNOUSSA ne justifiaient pas, au-delà de son enregistrement, l'usage effectif de la marque, condition *sine qua non* de la sanction de l'atteinte au droit à la marque. C'est pourquoi il y a lieu de s'interroger sur la cohérence de la démarche de la Cour qui, malgré sa démonstration sur l'absence d'un droit protégé, s'est quand même prononcée, dans un raisonnement fort contestable, sur l'existence d'un risque de confusion.

Sur ce point, il faut rappeler qu'au regard de l'article 37 de l'annexe III de l'ABR-1999⁵⁶, certaines atteintes à la marque ne sont sanctionnées que si elles créent un "risque de confusion dans l'esprit du public". Il s'agit notamment de l'imitation frauduleuse d'une marque, la vente ou la mise en vente de produits revêtus d'une marque frauduleusement imitée ou portant des indications propres à tromper l'acheteur sur la nature du produit et l'offre et la fourniture de produits ou de services sous une telle marque. C'est dire l'importance pratique de la question de l'appréciation du risque de confusion dans l'esprit du public⁵⁷. À cet effet, la jurisprudence précise, d'une part, que l'existence d'un risque de confusion dans l'esprit du public doit faire l'objet, de la part du juge, d'une appréciation globale "tenant compte de tous les facteurs pertinents du cas de l'espèce"⁵⁸ et, d'autre part, que l'appréciation du risque de confusion doit tenir compte de tous les facteurs pertinents, notamment "la similitude visuelle, auditive ou conceptuelle des marques en cause"⁵⁹.

56 Devenu l'art. 57 de l'annexe III de l'ABR-2015.

57 BOUVEL (A.), Juriscl. Marques et Noms de Domaines, Fasc. 7519, 2012, par. 34 et s. Voir également la CSR, Décision n° 00157 du 26 avril 2002, *Société Bosnalijek Pharmaceutical and Chemical Industry c. Société Sanofi-Aventis France* (obs. LUCAS (A.), ce recueil, chapitre 3, section A).

58 Voir Cour de justice de l'Union européenne, Arrêt du 11 novembre 1997, *SABEL BV c. Puma AG, Rudolf Dassler Sport*, C-251/95, ECLI:EU:C:1997:528.

59 Cass. com., 10 avril 2019, n° 18-10.075.

En somme, l'appréciation du risque de confusion se fait sur la base des ressemblances et non sur des dissemblances comme l'a fait, à tort, la cour d'appel en l'espèce⁶⁰. En effet, en soutenant que "les deux logos ne se ressemblent guère, tant leurs différences sont nombreuses" et par la suite "que la première différence sautant aux yeux est celle de la couronne du côté de SULTANA et le soleil de SYLVANA", la cour d'appel a fait une mauvaise application du critère de risque de confusion dans l'esprit du public et donné un exemple à ne pas suivre par les juges du fond même s'ils ont le pouvoir d'apprécier souverainement le risque de confusion⁶¹.

Mais, fondamentalement, c'est la pertinence de l'appréciation d'un risque de confusion qui est problématique. En effet, la cour a, elle-même, démontré que "la marque revendiquée par les dames YOUNOUSSA Fati et Salamatou n'est pas susceptible d'appropriation". En déniait ainsi à celles-ci la titularité d'une marque protégée, la cour ne devait pas se hasarder à apprécier un risque de confusion, au demeurant, dans un argumentaire infondé, dès lors qu'il ne pouvait y avoir une atteinte à un droit de propriété intellectuelle. L'absence d'un droit à une marque protégée écarte toute idée de contrefaçon au sens de l'article 37 de l'annexe III de l'ABR-1999⁶². La contrefaçon étant une atteinte à un droit de propriété intellectuelle, elle ne peut être retenue à l'encontre de la personne poursuivie pour cette infraction si le droit protégé n'est pas établi.

Malgré tout, la cour, constatant l'absence de l'élément matériel de l'infraction de contrefaçon de marque, a renvoyé ADECHOKAN Amandatou des fins de la poursuite de contrefaçon de marque⁶³, mais a surtout considéré l'action des dames YOUNOUSSA comme abusive et les a condamnées au paiement de dommages et intérêts à la prévenue.

B. L'admission de la demande reconventionnelle en réparation pour procédure abusive et vexatoire.

En l'espèce, la cour a reçu et fait droit partiellement à la demande présentée par la prévenue ADECHOKAN Amandatou qui, estimant avoir été victime d'une procédure vexatoire et abusive, sollicitait la condamnation des plaignantes, dames YOUNOUSSA Fati et Salamatou, à lui payer reconventionnellement la somme de cinquante millions (50 000 000) de francs CFA, toutes causes de préjudice confondues.

60 Voir Cass. com., 30 mai 2012, n° 11-14910, inédit, où est faite une illustration récente de ce principe de l'appréciation de la contrefaçon sur les ressemblances et non les différences. La jurisprudence de la Cour de cassation française est logiquement constante à ce sujet, et insiste sur le fait que la contrefaçon s'apprécie sur les ressemblances. Voir : Cass. civ., 1^{re} chambre, 25 mai 1992 : D. 1993, p. 184 (obs. DAVERAT (X.)), et : D. 1993, somm., p. 84 (obs. COLOMBET (C.)) : LPA 1993, p. 10 (obs. GAVALDA (C.)) : D. 1993, somm., p. 243 (obs. HASSLER (T.)).

61 D'ailleurs la Cour de cassation française a rappelé que le risque de confusion doit s'apprécier au regard d'un consommateur moyen dans la catégorie de produits en cause, "normalement informé et raisonnablement attentif et avisé". Voir Cass. com., 6 septembre 2016, n° 14-25.692.

62 Devenu l'art. 57 de l'annexe III de l'ABR-2015.

63 Art. 405 du Code de procédure pénale de la République démocratique du Congo : "Si le tribunal estime que le fait poursuivi ne constitue aucune infraction à la loi pénale ou que le fait n'est pas établi ou qu'il n'est pas imputable au prévenu, il renvoie celui-ci des fins de la poursuite". Idem art. 457 du Code de procédure pénale sénégalais".

Dans un premier considérant, la cour a admis l'existence d'une faute et d'un dommage en déclarant "que le préjudice subi est manifestement établi par la saisie intempestive des services de la Police qui ont maladroitement saisi 250 pagnes en lieu et place de quelques échantillons de pagnes; Que le recours à justice leur a causé un désagrément, les discréditant tout au long de cette procédure; Que la perte de confiance de ses clients mérite réparation" et dans un second considérant, elle a déterminé, elle-même, le préjudice en indiquant que "la Cour de céans apprécie souverainement le préjudice, et en application de l'article 407 du Code de procédure pénale, l'abus de constitution de partie civile est justifié et donne ainsi droit à des dommages et intérêts que la Cour fixe à cinq millions (5 000 000) de francs CFA...".

Ce faisant, la Cour soulève deux points :

- le problème de l'admission de la demande reconventionnelle fondée sur l'abus de procédure en matière de contentieux de la contrefaçon de marque et particulièrement de l'action engagée suivant la voie pénale; et
- la question de l'évaluation du préjudice subi par la personne poursuivie du chef de contrefaçon et renvoyée des fins de la poursuite.

D'emblée, il faut souligner que la demande reconventionnelle est une notion civiliste qui est définie comme "la demande par laquelle le défendeur originaire prétend obtenir un avantage autre que le simple rejet de la prétention de son adversaire"⁶⁴. Le code de procédure civile sénégalais, par exemple, classe la demande reconventionnelle dans la catégorie des demandes incidentes⁶⁵. Elle n'est recevable que si elle se rattache "aux prétentions originaires par un lien suffisant"⁶⁶. L'exercice de ce droit processuel, reconnu au défendeur, donne lieu, le plus souvent, en matière de contentieux de la marque à l'action reconventionnelle en nullité du titre⁶⁷ ou en déchéance des droits attachés à l'enregistrement de la marque⁶⁸. Mais on constate que, de plus en plus, les défendeurs, poursuivis pour contrefaçon, demandent systématiquement, à titre reconventionnel, l'allocation de dommages et intérêts pour procédure abusive.

En l'espèce, l'intérêt du débat est renforcé par le fait que la demande a été présentée devant le juge pénal. L'on sait qu'en matière pénale, c'est le Ministère public, en principe, qui met en mouvement l'action publique, même s'il le fait généralement sur la base d'une plainte de la victime⁶⁹. Dans ce cas, l'auteur de la plainte en contrefaçon, qui s'est constitué partie civile, ne saurait

64 Voir par ex. l'art. 64 du Code de procédure civile français, 111^e éd., Paris (Dalloz), 2020, p. 168.

65 Voir art. 193 du Code de procédure civile sénégalais.

66 Voir COUCHEZ (G.) et LAGARDE (X.), Procédure civile, Sirey, 17^e éd., Paris (Sirey), 2004, p. 179.

67 Cass. com., 10 avril 2019, n° 17-26612.

68 Cass. com., 5 juillet 2017, n° 13-11.513.

69 Art. 1 du Code de procédure pénale de la République démocratique du Congo : L'action publique pour l'application des peines est mise en mouvement et exercée par les magistrats et fonctionnaires auxquels elle est confiée par la loi.

être condamné, à la demande du prévenu relaxé, pour procédure abusive dès lors qu'il n'est pas l'auteur de la poursuite en contrefaçon⁷⁰. Il n'en est autrement que si c'est lui-même qui met en mouvement l'action publique, comme le lui reconnaît la loi⁷¹, en saisissant le juge d'instruction d'une plainte avec constitution de partie civile ou directement le tribunal par la voie de la citation directe. Dans ces deux dernières hypothèses, le tribunal est fondé à statuer, par le même jugement, sur la demande en dommages et intérêts formée par la personne relaxée contre la partie civile pour abus de constitution de partie civile⁷².

En l'espèce, tout laisse croire qu'on est dans la deuxième hypothèse. En effet, la cour, visant l'article 407 du code de procédure pénale congolais a retenu contre les dames YOUNOUSSA l'abus de constitution de partie civile⁷³. Mais l'on peut se poser la question de savoir quand l'exercice du droit d'agir en contrefaçon de marque peut dégénérer en une action abusive et vexatoire, susceptible de se retourner contre le demandeur. Au regard de la jurisprudence, on peut dire, de manière générale, que la demande reconventionnelle pour procédure abusive et vexatoire, en cas de rejet de l'action principale en contrefaçon, est peu fréquemment accueillie par les tribunaux qui considèrent le plus souvent que le demandeur initial de l'action en contrefaçon a mal estimé les considérations juridiques ou techniques d'un tel contentieux et qu'il a pu se tromper sur l'étendue de ses droits⁷⁴. Mais il en va autrement lorsque le demandeur à l'action en contrefaçon agit en sachant pertinemment que sa prétention est mal fondée⁷⁵.

Dans tous les cas, l'abus est retenu, même s'il ne s'agit pas, à proprement parler, d'un abus d'ester en justice, lorsque le demandeur, qui avait fait pratiquer une saisie réelle de tout ou partie du stock de produits incriminés en lieu et place de la saisie-description ordonnée par le juge, a vu son action en contrefaçon rejetée au fond⁷⁶. C'est également le cas lorsque la saisie-contrefaçon pratiquée a été annulée pour défaut d'introduction d'une action au fond dans le délai légal de dix jours⁷⁷.

70 Voir PRADEL (J.), Procédure pénale, 17^e éd., Paris (Cujas), 2013, pp. 602 à 603.

71 Art. 1 al. 2 du Code de procédure pénale de la République démocratique du Congo : "Cette action peut aussi être mise en mouvement par la partie lésée dans les conditions déterminées par le présent code".

72 Voir art. 407 du Code de procédure pénale de la République démocratique du Congo et art. 459 du Code de procédure pénale du Sénégal.

73 Art. 407 du Code de procédure pénale de la République démocratique du Congo : dans le cas prévu par l'art. 405, lorsque la partie civile a elle-même mis en mouvement l'action publique, le tribunal statue par le même jugement sur la demande en dommages et intérêts formée par la personne acquittée contre la partie civile pour abus de constitution de partie civile.

74 Voir CA Paris, 16 janvier 1998 : RD propr. intell. 1998, n° 87, p. 20; CA Paris, 23 mai 2001 : PIBD 2001, III, n° 729, p. 526; TGI Marseille, 14 mars 1979 : PIBD 1979, III, n° 244, p. 337; Cass. com., 22 mai 1973, n° 71-13.912 : JurisData, n° 1973-097181; CA Lyon, 28 mai 1991 : Dossiers brevets 1991, II, p. 1; CA Paris, 16 janvier 1992 : Ann. propr. ind. 1995, p. 57 et : PIBD 1992, III, n° 524, p. 326.

75 Voir Cass. com., 22 mai 1973, n° 71-13.912 : JurisData n° 1973-097181. CA Lyon, 28 mai 1991 : Dossiers brevets 1991, II, p. 1. CA Paris, 16 janvier 1992 : Ann. propr. ind. 1995, p. 57 et : PIBD 1992, III, n° 524, p. 326.

76 Voir PIBD, III, n° 894, p. 951. et PIBD, III, n° 897, p. 1110.

77 CA Lomé, Arrêt n° 70/15 du 4 mars 2015, *GNANHOUE Nazaire c. Établissements SOLA* (obs. LAMOTTE (M.), ce recueil, chapitre 3, section I) : "L'immobilisation au-delà du délai légal d'une cargaison des marchandises présumées contrefaisantes par l'exercice d'une prérogative exorbitante de droit commun destinée à se constituer une preuve en vue d'une procédure future crée sans nul doute un préjudice certain au propriétaire desdites marchandises".

Les juges d'appel ont, en l'espèce, considéré que les agents de la police judiciaire ont maladroitement exécuté l'ordonnance du président du tribunal de grande instance de Brazzaville en saisissant 250 pagnes en lieu et place de quelques échantillons. Cette position est fondée en droit dès lors qu'à la lecture des faits de l'espèce et des étapes de la procédure, il apparaît clairement que les dames YOUNOUSSA, qui avaient été autorisées à procéder à une saisie-description, ont en réalité fait pratiquer une saisie réelle d'un important stock du produit incriminé. Cette saisie est donc abusive et constitutive d'une faute susceptible d'être réparée.

Toutefois, il appartient au prévenu, relaxé, d'établir son préjudice, et le juge ne peut réparer que le préjudice subi, rien que le préjudice mais tout le préjudice. C'est l'application du principe de la réparation intégrale⁷⁸. Sous ce rapport, il est important de souligner que l'article 54 de l'annexe III de l'Acte de 2015 apporte une belle innovation en donnant désormais au juge des critères précis de fixation des dommages et intérêts ("La juridiction saisie détermine le montant des dommages et intérêts, en tenant compte des conséquences économiques négatives, dont le manque à gagner, subies par la partie lésée, les bénéfices réalisés par le contrefacteur et le préjudice moral causé au titulaire des droits du fait de l'atteinte"). En l'espèce, la cour a décidé "souverainement" de fixer le montant des dommages et intérêts à cinq millions de francs CFA après avoir retenu que la procédure a causé un désagrément à la dame ADECHOKAN Amandatou qui, en plus d'avoir été discréditée, a subi une perte de confiance de ses clients. La cour a fait état respectivement d'un préjudice moral et d'un préjudice matériel dont l'étendue n'a, toutefois, pas été déterminée.

Malick Lamotte

E. Action en contrefaçon et concurrence déloyale – Rejet de l'opposition à l'enregistrement de la marque contrefaisante – OAPI – Appréciation par les tribunaux de l'ordre judiciaire

Ne donne pas de base légale à sa décision le juge d'instance qui rejette l'action en contrefaçon et concurrence déloyale introduite par le titulaire d'une marque enregistrée au motif que la procédure d'opposition à l'enregistrement de la marque contrefaisante parallèlement initiée par celui-ci devant les instances compétentes de l'OAPI s'est soldée par un échec.

Tribunal de grande instance du Wouri (Douala), Jugement n° 218 du 19 septembre 2007, SOCIÉTÉ R.M & CO LIMITED c. SOCIÉTÉ C.D.M. (SCDM)

Observations :

L'échec de la procédure d'opposition introduite à l'OAPI par le titulaire d'une marque antérieure entraîne-t-il *ipso*

78 Voir TERRE (F.), SIMLER (Ph.) et LEQUETTE (Y.), Droit civil : les Obligations, 10^e éd., Paris (Dalloz), pp. 752 et s.

facto le rejet de l'action en contrefaçon et concurrence déloyale intentée parallèlement par celui-ci devant les tribunaux de l'ordre judiciaire contre l'auteur de l'enregistrement querellé⁷⁹? Telle est la question centrale posée aux juges du tribunal de grande instance du Wouri dans l'espèce rapportée.

Faits : La société RM & Co Limited est titulaire de la marque "crocodile" enregistrée à l'OAPI le 30 juillet 1991 sous le n° 30659 pour couvrir les produits de la classe 8, en l'occurrence les machettes et autres outils tranchants. Après avoir constaté l'usage de sa marque par la société S.C.D.M installée à Douala, la RM & Co Limited l'assigna devant le susdit tribunal en contrefaçon et concurrence déloyale. La S.C.D.M a soutenu lors des débats que la marque "crocodile" accompagnée d'un dessin qu'elle exploite était plutôt la propriété de T. bénéficiaire de l'enregistrement n° 35636 publié au BOPI sous le n° 8/1996. Elle a par conséquent conclu au rejet de l'action de la RM & Co Limited, ce d'autant plus que la procédure parallèle d'opposition initiée par celle-ci à l'OAPI a connu le même sort suivant décision n° 005/OAPI/DG/ADG/SCAJ/ du 15 janvier 1998.

La Haute Cour du Wouri l'a fait.

Raisonnement : Vidant sa saisine, le tribunal a débouté la RM & Co Limited de son action en se fondant sur la décision du directeur général de l'OAPI qui indique que cette société ne bénéficie d'aucune exclusivité sur les termes "CROCODILE" et son dessin objets de plusieurs dépôts et enregistrements antérieurs dans les mêmes classes. La décision rapportée appelle quelques observations, abstraction faite de l'exception soulevée à titre liminaire par la société S.C.D.M et de sa demande reconventionnelle qui ne présentent aucun intérêt relativement au point de droit indiqué plus haut. Ces observations sont relatives aux rapports qu'entretient l'opposition à l'enregistrement d'une marque avec l'action en contrefaçon d'une part, avec l'action en concurrence déloyale d'autre part.

S'agissant du premier type de rapport, il importe de spécifier au préalable l'objet de chacune des actions concernées. Alors que la procédure d'opposition auprès de l'OAPI a principalement pour objet de permettre aux titulaires de droits antérieurs de faire obstacle à l'enregistrement de marques susceptibles de leur porter préjudice⁸⁰, en application des dispositions de l'article 18 de l'annexe III de l'Accord de Bangui précité, l'action en contrefaçon a, en revanche, pour finalité la condamnation du présumé contrefacteur au paiement des dommages-intérêts ainsi qu'aux peines complémentaires, notamment la cessation de l'activité contrefaisante, la destruction des objets contrefaisants

et du matériel résultant, la publication de la décision. Il s'ensuit que l'opposition à l'enregistrement d'une marque et l'action en contrefaçon n'ont pas le même objet. Dans un arrêt assez édifiant, la cour d'appel de Paris a indiqué que "la procédure d'opposition (...) et l'action en contrefaçon n'ayant pas le même objet, la décision rendue sur opposition ne saurait avoir l'autorité de chose jugée au regard de la procédure de contrefaçon"⁸¹.

La décision des juges du tribunal de grande instance du Wouri est critiquable de ce point de vue. La doctrine spécialisée va dans le même sens. Jérôme Passa souligne en effet que "le juge peut parfaitement, à l'issue de sa propre analyse, décider, en dépit du rejet de l'opposition, qu'il existe un risque de confusion et que la marque seconde doit être annulée ou jugée contrefaisante"⁸². Cette position paraît soutenable car s'il est exact que les organes spécialisés de l'OAPI saisis d'une opposition à l'enregistrement d'une marque et le juge judiciaire saisi d'une action en contrefaçon procèdent chacun à un examen du risque de confusion, il reste que la décision rendue par les premiers est un acte administratif qui ne saurait lier la juridiction saisie d'une action en contrefaçon, en raison de la prééminence des décisions des juridictions de l'ordre judiciaire sur celles des organes administratifs de l'OAPI⁸³. La jurisprudence française va plus loin en décidant que la procédure d'opposition n'est pas un préalable obligatoire à l'action en contrefaçon et une défenderesse ne saurait donc se prévaloir de ce que le propriétaire de la marque n'aurait pas diligenté une telle procédure⁸⁴.

Dans l'espèce commentée, les juges auraient dû, de leur propre chef, apprécier l'effectivité du risque de confusion entre les deux marques⁸⁵, plutôt que de fonder leur décision sur celle du DG de l'OAPI⁸⁶ rejetant l'opposition formée par la société demanderesse. On le voit, l'échec de la procédure d'opposition à l'enregistrement d'une marque ne prive pas l'opposant malheureux du droit de se pourvoir en contrefaçon voire en annulation de la marque offensante devant les tribunaux de l'ordre judiciaire.

S'agissant du deuxième type de rapport, il importe de souligner d'emblée que la société demanderesse a également saisi le tribunal de grande instance du Wouri pour voir condamner la société S.C.D.M du chef de concurrence déloyale⁸⁷, action rejetée par cette juridiction motif pris de ce que la société RM ne bénéficie d'aucune exclusivité sur les termes "CROCODILE" et son dessin objets de plusieurs dépôts et enregistrements

79 L'opposition est une procédure administrative initiée devant le directeur général de l'OAPI et qui a pour objet de permettre, entre autres, au titulaire d'un droit antérieur de faire annuler l'enregistrement obtenu par des tiers en violation de son droit. Elle est régie par l'art. 18 de l'annexe III de l'ABR-1999. Deux possibilités s'offrent au directeur général : il peut annuler ou maintenir l'enregistrement contesté. Sa décision est susceptible de recours devant la CSR.

80 BERTRAND (A. R.), Le droit des marques et des signes distinctifs, Kampala (Cedat), 2000, p. 244.

81 Voir CA Paris, 10 octobre 2005 : PIBD 2005, III, n° 820, p. 730.

82 Voir PASSA (J.), Droit de la propriété industrielle (Marques et autres signes distinctifs, dessins et modèles), Tome 1, Paris (LGDJ), 2006, p. 161.

83 Voir en ce sens TPI de Yopougon, Jugement civil n° 187 du 21 mars 2013, *SIVOP SA c. Société Angel Cosmetic SA (obs. NDEMA ELONGUE (M.-L.))*, ce recueil, chapitre 3, section I). Voir également TGI du Wouri (Douala), Jugement du 5 janvier 2012, *Société Arla Foods Amba c. Société Dana Holdings Ltd (obs. FOMETEU (J.))*, ce recueil, chapitre 1, section A).

84 Voir CA Paris, 4^e chambre, 8 avril 1998 : Gaz Pal 1998, II, p. 545.

85 Les deux marques "CROCODILE", n° 30659 et n° 35636, accompagnées d'un dessin n° 35636 publié au BOPI sous le n° 8/1996.

86 N° 005/OAPI/DG/ADG/SCAJ/ du 15 janvier 1998.

87 Sur la possibilité du cumul des deux actions, voir art. 2 al. 2 de l'annexe VII de l'ABR-1999 et art. 1 al. 3 de l'annexe VIII de l'ABR-2015.

antérieurs dans les mêmes classes. Si ce motif de rejet peut être, sous quelques réserves, admis relativement à la contrefaçon qui suppose l'enregistrement préalable de la marque contrefaite, il ne saurait justifier le rejet d'une demande en concurrence déloyale qui peut être exercée même par l'exploitant d'une marque non déposée. Certes, les faits rapportés ne nous fournissent pas d'éléments objectifs d'appréciation, la société demanderesse n'ayant pas spécifié la faute dommageable distincte du comportement constitutif de concurrence déloyale non couverte par la qualification de contrefaçon⁸⁸.

En effet, la victime de la contrefaçon, qui sollicite à titre complémentaire la condamnation du présumé contrefacteur du chef de concurrence déloyale, doit en sus prouver qu'elle est également victime d'un risque de confusion résultant de la reproduction ou de l'imitation d'un élément non compris dans l'enregistrement de la marque invoquée⁸⁹. La société RM a indiqué que la défenderesse, la S.C.D.M, ayant fait usage de sa marque alors qu'elle ne bénéficie ni d'une concession, ni d'une cession de droit sur ladite marque, a commis à la fois la contrefaçon et la concurrence déloyale. Or le même fait, à savoir l'usage de la marque "crocodile" querellée, ne saurait revêtir ces deux qualifications; la doctrine et la jurisprudence exigent systématiquement la démonstration du fait dommageable distinct pour que l'action en concurrence déloyale complémentaire soit favorablement accueillie. Ainsi, dès lors que le fait dommageable distinct est prouvé, le rejet de l'action en contrefaçon est sans incidence sur l'action en concurrence déloyale, laquelle pourrait alors lui survivre et générer des dommages et intérêts distincts. Il s'en infère que le rejet de l'opposition à l'enregistrement de la marque "crocodile" par le directeur général de l'OAPI ne devrait pas entraîner *ipso facto* celui de l'action en concurrence déloyale complémentaire par le tribunal, le risque de confusion dans les deux hypothèses n'ayant ni la même source, ni les mêmes critères d'appréciation. Alors que le risque de confusion, en matière de contrefaçon de marque, s'apprécie de façon abstraite, c'est-à-dire par référence à la marque telle qu'enregistrée, le risque de confusion constitutif d'une faute sur le terrain de la concurrence déloyale s'apprécie concrètement sur le marché et suppose donc que l'élément à protéger et l'élément litigieux y soient l'un et l'autre utilisés⁹⁰.

Bien plus, la nature extrêmement variée des actes constitutifs de concurrence déloyale renforce l'indépendance de l'action en concurrence déloyale à l'égard de la procédure d'opposition. Les occurrences de concurrence déloyale sont en effet nombreuses, les actes visés aux articles 2 à 7 de l'annexe VIII de l'Accord de Bangui révisé ne l'étant qu'à titre purement indicatif. Si l'on peut mettre à l'actif des juges du tribunal de

grande instance du Wouri l'imprécision ou, mieux, la mauvaise articulation de la demande formulée par la société RM, il reste constant que ceux-ci, saisis des deux chefs de demande, avaient l'obligation de les apprécier séparément selon leurs conditions respectives de mise en œuvre, dans l'optique de soustraire leur décision à une éventuelle censure de la juridiction supérieure.

Max Lambert Ndéma Elongué

F. Dépôt frauduleux d'une marque – Preuve de l'usage antérieur – Mauvaise foi – Nullité – Dommages – Intérêts

Est nul, en application du principe général de droit *fraus omnia corrumpit*, l'enregistrement d'une marque effectué à l'OAPI, alors même que le bénéficiaire avait parfaitement connaissance de ce qu'un tiers avait la priorité de l'usage de ladite marque dans le commerce et dans la même spécialité, sur le territoire de l'un des pays membres, le contrevenant pouvant, au demeurant, être condamné au paiement des dommages et intérêts dans les conditions du droit commun.

Tribunal de Grande Instance du MFOUNDI (Yaoundé), Jugement n° 672/civ du 17 septembre 2003, STÉ COOPER c. LABORATOIRE BRIDE S.A

Observations :

Si l'article 5.1) de l'annexe III de l'Accord de Bangui révisé, Acte du 24 février 1999, pose que "... la propriété de la marque appartient à celui qui, le premier, en a effectué le dépôt", cette règle cesse de recevoir application lorsque ce dépôt présente un caractère frauduleux, en particulier dès lors qu'il est manifeste que le déposant avait connaissance de l'utilisation antérieure du même signe par un tiers. Il s'agit là de la transposition en droit de la propriété intellectuelle du principe fondamental de droit *fraus omnia corrumpit* qui signifie "la fraude corrompt tout" rappelé à diverses occasions par la jurisprudence française⁹¹ et la doctrine spécialisée⁹².

Faits : Les faits du jugement rapporté sont simples. En vertu d'une lettre contrat datée du 26 février 1938, la société de coopération pharmaceutique française, en abrégé Cooper, confiait au Laboratoire Bride SA la fabrication des médicaments sur la base de ses propres formules, produits distribués par elle en Afrique sous la marque SEDASPIR originellement enregistrée en France depuis 1934. Ayant constaté l'enregistrement parallèle à l'OAPI de la même marque en date du 13 août 1995 sous le n° 36716 au profit de son partenaire commercial le laboratoire Bride SA, elle assigna cette société devant le tribunal de grande instance du Mfoundi en annulation de ladite marque et en paiement de dommages et intérêts, non sans avoir fait préalablement enregistrer

88 Voir en sens contraire TGI du Wouri (Douala), Jugement civil n° 192 du 15 décembre 2000, *Moulinex SA c. Vapsan Trading Cie* (obs. NDEMA ELONGUE (M.-L.)) : Revue scientifique de la propriété industrielle la GAZELLE, n° 0001, novembre 2007, pp. 17 et s.

89 PASSA, (J.), n.82, p. 453.

90 Voir en ce sens PASSA (J.), n.82, p. 454.

91 Voir TGI de Paris, 3^e chambre, 15 avril 1983 : PIBD 1983, III, p. 260; CA Bordeaux, 1^{re} chambre, 28 février 1994 : PIBD 1994, III, p. 301; CA Centre, Arrêt n° 207/CIV du 18 mai 2011; Cass. com., 25 avril 2006 : PIBD 2006, III, n° 83.3, p. 471.

92 BERTRAND (A. R.), n.80, p. 390 et s.; PASSA (J.), n.82, pp. 178 et s.

la même marque en son nom à l'OAPI en date du 1^{er} avril 1997 sous le n° 37638. En réaction, la société laboratoire Bride SA l'assigna également devant le même tribunal en annulation de l'enregistrement second n° 37638.

Les juges du tribunal de grande instance du Mfoundi devaient se prononcer sur la question de savoir si, dans le silence de la législation communautaire, la nullité d'une marque peut être prononcée sur le fondement de la fraude.

Raisonnement : Après jonction desdites procédures, le tribunal a répondu par l'affirmative en déclarant nul et non avenu l'enregistrement SEDASPIR n° 36.716 opéré au profit de la société Laboratoire Bride SA non sans condamner celle-ci à payer la somme de FCFA 30 000 000 à son partenaire commercial. Bien que l'Accord de Bangui révisé ne le dise pas expressément, une fois la preuve du dépôt frauduleux rapportée, l'auteur de la fraude peut être doublement sanctionné.

En règle générale, il appartient à celui qui invoque la fraude de prouver à la fois l'usage antérieur du signe querellé et l'intention de nuire du déposant. L'usager qui invoque le caractère frauduleux du dépôt doit justifier qu'il a, le premier, utilisé le signe dont il s'agit dans le commerce et dans la même spécialité. Certains auteurs⁹³ relayés par la jurisprudence⁹⁴ estiment que pour être pris en compte, l'usage doit remplir certaines caractéristiques, à savoir être public, non équivoque, non précaire et continu. Ces exigences paraissent remplies dans l'espèce commentée, étant entendu que la société COOPER qui avait initialement enregistré la marque SEDASPIR en France l'exploitait depuis plusieurs décennies en Afrique où elle distribuait les produits du même nom sous ce signe, en exécution du contrat de partenariat la liant au Laboratoire Bride SA. Il ne fait par conséquent l'ombre d'aucun doute que la société COOPER avait la priorité de l'usage de la marque SEDASPIR en territoire OAPI.

L'intention de nuire résulte de la connaissance qu'avait le fraudeur, au moment du dépôt récusé, qu'un tiers utilisait la marque litigieuse sans l'avoir protégée. Manifestement, la société Laboratoire Bride avait l'intention de nuire à son partenaire car non seulement il avait parfaitement connaissance de ce que la société COOPER utilisait le signe SEDASPIR pour la distribution des comprimés tant en France qu'en Afrique, mais en plus et surtout le contrat les liant contient une clause interdisant le dépôt de la marque sans son consentement. La marque SEDASPIR n° 36716 du 13 août 1995 apparaît ainsi comme une marque de "barrage" ayant pour finalité de rendre ce signe indisponible dans l'espace OAPI au préjudice de la société COOPER qui a un intérêt légitime à en faire usage. La poursuite de ce but révèle l'intention de nuire du laboratoire Bride et détourne le droit des marques de sa

finalité essentielle qui est de garantir l'identité d'origine des produits ou services. En effet, les consommateurs des produits pharmaceutiques litigieux pourraient se tromper sur leur origine réelle.

La fraude est sanctionnée par la nullité de la marque offensante et éventuellement par l'allocation des dommages et intérêts dans les conditions du droit commun. Il est admis tant en doctrine qu'en jurisprudence qu'est nul de nullité absolue le signe qui a fait l'objet d'un dépôt frauduleux en vertu du principe supérieur *fraus omnia corrumpit*. En effet, la fraude une fois démontrée invalide le droit résultant de la marque frauduleusement déposée qui est nulle rétroactivement, les parties étant remises au même et semblable état dans lequel elles étaient avant la survenance de la nullité. La marque récusée est réputée n'avoir jamais existé, du moins dès que la décision commentée acquiert un caractère définitif. L'article 28 de l'annexe III de l'Accord de Bangui révisé indique en effet que toute décision judiciaire définitive prononçant l'annulation des effets sur le territoire national de l'un des États membres du dépôt d'une marque doit être inscrite au registre spécial des marques sur notification de la juridiction, et faire l'objet d'une mention publiée par l'Organisation. C'est donc à bon droit que le tribunal a invalidé la marque SEDASPIR n° 36716 déposée à l'OAPI le 13 août 1995 dans l'intention manifeste de nuire à la société COOPER, premier usager dudit signe tel que démontré précédemment. La conséquence directe en est la radiation du signe offensant des registres de l'OAPI, y compris les actes subséquents intervenus jusque-là en rapport avec ledit signe.

Abstraction faite de la nullité, le comportement de la société Laboratoire Bride SA, qui a cru devoir déposer frauduleusement la marque SEDASPIR sans égard à la priorité de l'usage de son partenaire commercial, caractérise par ailleurs une faute au sens du droit commun ouvrant droit aux dommages et intérêts. Le tribunal a alloué à la société COOPER la somme de FCFA 30 000 000 au titre des frais exposés à l'occasion de la défense de ses droits. S'il est exact que cette société a sollicité uniquement le remboursement desdits frais évalués selon elle à la somme de FCFA 50 000 000, le tribunal n'indique cependant pas sur quelle base il a octroyé le montant de FCFA 30 000 000 à la demanderesse, aucune pièce justificative n'ayant été produite aux débats, ce qui expose ladite décision à la censure de la juridiction d'appel.

Max Lambert Ndéma Elongué

93 BERTRAND (A. R.), n.80, p. 391; CHAVANNE (A.) et BURST (J.-J.), Droit de la propriété industrielle, 3^e éd., Paris (Dalloz), 1990, p. 631.

94 Voir Paris, 18 janvier 2006 : PIBD 2006, III, n° 826, p. 223.

G. Marque – Nullité du certificat d'enregistrement – Appréciation du droit antérieur – Cession de marque – Opposabilité – Autorité régionale des décisions judiciaires définitives

Le cessionnaire d'une marque enregistrée en cours de validité n'est pas fondé à requérir l'annulation d'une marque identique ou similaire enregistrée antérieurement à l'inscription de la cession au registre spécial des marques tenues à l'organisation (1^{re} espèce).

Viola l'article 18 des dispositions générales de l'Accord de Bangui, Acte du 22 février 1999, le juge d'instance d'un pays membre de l'OAPI qui invalide une marque dont la validité a antérieurement été confirmée par une décision judiciaire définitive émanant de la Cour suprême d'un autre État partie (2^e espèce).

Cour suprême du TOGO, Arrêt n° 47/11 du 21 juillet 2011, SOCIÉTÉ NOSOCO-TOGO c. SOCIÉTÉ PASTACORP S.A.S; Tribunal de grande instance du MFOUNDI (Yaoundé), Jugement n° 96/Com du 4 mai 2016, SOCIÉTÉ PASTACORP c. TANKOUNANG Jean Delors et SOCIÉTÉ NOSOCO TOGO Sarl.

Observations :

Aux termes de l'article 5.1) de l'annexe III de l'Accord de Bangui, Acte du 24 février 1999 : "... la propriété de la marque appartient à celui qui, le premier, en a effectué le dépôt". À la vérité, c'est l'enregistrement qui fait naître le droit de marque au profit du déposant, étant entendu que le texte régional prévoit l'éventualité du rejet de la demande d'enregistrement⁹⁵. Les juridictions de l'ordre judiciaire des États parties à l'Accord de Bangui ont été amenées à infléchir la rigueur de ce texte en raison de certaines circonstances spécifiques. C'est dans cette mouvance que s'inscrivent les deux décisions rapportées dont les approches sont diamétralement opposées sur la question.

Faits : La société de droit français Rivoire et Carret Lustacru (RCL) est titulaire de la marque semi-figurative "COUSCOUS SIPA" enregistrée à l'OAPI le 9 février 1981 et renouvelée successivement en 1991, 2001 et 2011 et distribue ses produits en Afrique par le biais de son partenaire local, la société NOSOCO-TOGO Sarl. Après la disparition de la RCL, la société NOSOCO-TOGO Sarl qui fit enregistrer la même marque à l'OAPI en son nom constata, un an plus tard, que les Établissements la MASCOTTE installés au TOGO importaient une marque de couscous identique à la sienne. Poursuivis du chef de contrefaçon de la marque "COUSCOUS SIPA" n° 47.511 devant le tribunal correctionnel de LOME, les Établissements la MASCOTTE prétendirent tenir le couscous revêtu de la marque litigieuse de la société MARDI, représentante de la société PASTACORP SA, toutes installées en France. Les Établissements la MASCOTTE furent condamnés pour contrefaçon. Alors qu'elle s'apprêtait à exécuter cette décision, la société

NOSOCO-TOGO Sarl fut atraite devant le tribunal de première instance de Lomé par la société PASTACORP SA en nullité de son enregistrement.

Par jugement n° 622 du 13 avril 2007, cette juridiction confirma NOSOCO-TOGO Sarl dans son droit d'exploitation de la marque "COUSCOUS SIPA" et ordonna la radiation des registres de l'OAPI de l'enregistrement opéré par PASTACORP SA.

La cour d'appel de Lomé infirma cette décision par arrêt n° 027/2009 du 26 février 2009 et déclara plutôt la société PASTACORP SA propriétaire par voie de cession de la marque "COUSCOUS SIPA" n° 21.047 du 9 février 1981, non sans condamner la société NOSOCO-TOGO Sarl à lui payer la somme de FCFA 100 000 000 à titre de dommages et intérêts.

Suivant arrêt n° 47/11 du 21 juillet 2011, la Cour suprême du TOGO cassa sans renvoi l'arrêt infirmatif de la cour d'appel, réhabilitant ainsi l'enregistrement n° 47.511 opéré par la société NOSOCO-TOGO Sarl.

Trois ans plus tard, la société PASTACORP SA revint à la charge en traduisant sa concurrente NOSOCO TOGO Sarl et sieur TAKOUNANG Jean Delors, distributeur exclusif des produits "COUSCOUS SIPA" à Yaoundé (Cameroun), cette fois devant le tribunal de grande instance de cette ville, en annulation de l'enregistrement "COUSCOUS SIPA" n° 47.511. Cette juridiction donna gain de cause à la société PASTACORP SA motif pris de ce que cet enregistrement a été opéré en fraude de ses droits, en sa qualité de cessionnaire de la marque querellée déposée le 9 février 1981 et renouvelée successivement en 1991, 2001 et 2011.

Raisonnement : La question centrale posée tant aux juges de la juridiction suprême qu'à ceux du tribunal de grande instance était celle de savoir si le cessionnaire d'une marque enregistrée peut se prévaloir d'un droit antérieur sur ladite marque nonobstant la non-inscription de la cession dont il se prévaut dans les registres idoines tenus à l'OAPI. Les deux juridictions ayant successivement donné des solutions diamétralement opposées quant à la question de la détermination du titulaire du droit antérieur (section I), il y a lieu de s'interroger sur l'effectivité du principe de l'autorité régionale des décisions judiciaires définitives portant sur la validité des titres délivrés par cette organisation (section II).

I. La détermination du titulaire du droit antérieur

D'entrée de jeu, il s'est posé la question de savoir qui, de la société NOSOCO TOGO SARL ou de la société PASTACORP SA est en droit de se prévaloir d'un droit antérieur sur la marque "COUSCOUS SIPA". L'analyse des solutions dégagées par les décisions ci-dessus rapportées conduit à considérer d'une part la situation du cessionnaire non inscrit (A) et d'autre part celle du déposant frauduleux (B).

95 Aux termes de l'art. 14 al. 2 de l'ABR-1999 : "Tout dépôt qui ne satisfait pas aux prescriptions de l'article 3, alinéas c) et e), est rejeté."

A. Le cessionnaire non inscrit

Il va sans dire que la marque "COUSCOUS SIPA" a été initialement déposée à l'OAPI par la société française RCL en date du 9 février 1981 et maintenue en vigueur jusqu'en 2021 par suite de renouvellements successifs⁹⁶. Si ce droit est incontestablement transféré à la société PASTACORP SA (1), son opposabilité à l'égard des tiers est sujette à caution (2).

1. Un droit antérieur théoriquement transféré

L'application de l'article 5, alinéa 1, de l'annexe III de l'accord précité⁹⁷ conduit à attribuer sans détours la paternité de la marque revendiquée à la société RCL, son droit de propriété sur la marque "COUSCOUS SIPA" étant consolidé jusqu'en 2021. Évidemment, la messe aurait été dite si les poursuites avaient été enclenchées par ladite société. Or, il résulte des faits qu'à sa disparition, la RCL avait cédé son droit sur la marque "COUSCOUS SIPA" à sa consœur la société PASTACORP SA le 20 avril 2004 laquelle est, du fait de cette cession, subrogée dans ses droits et actions relativement à l'objet cédé. En toute logique, la société PASTACORP SA est en droit de revendiquer la paternité de la marque discutée sur le fondement de la cession dont la validité n'est du reste pas contestée, ce d'autant qu'elle jouit, en principe, rétroactivement des effets du dépôt initial n° 21.047 opéré le 9 février 1981 par la société cédante⁹⁸.

C'est d'ailleurs l'un des éléments essentiels de la motivation du collège des juges du tribunal de grande instance du Mfoundi : "Attendu qu'il est constant que cette société a acquis la marque COUSCOUS SIPA par voie de cession en 2004 auprès de la société Rivoire et Carret Lustacru (RCL) laquelle a été enregistrée le 9 février 1981 à l'OAPI sous le numéro n° 21.047". On le voit, le droit antérieur sur la marque querellée est théoriquement transféré au cessionnaire, la société PASTACORP SA qui ne peut toutefois valablement l'opposer aux tiers.

2. Un droit antérieur inopposable aux tiers

L'arrêt infirmatif attaqué pose sans détours que "La cession de la marque Couscous SIPA à la société PASTACORP étant opposable à la société NOSOCO-TOGO, la société PASTACORP est donc titulaire d'un droit antérieur et peut demander l'annulation de l'enregistrement n° 47.511 fait le 3 juillet 2003 par la société NOSOCO-TOGO". Les juges de la Cour suprême du TOGO ont censuré la cour d'appel pour avoir conféré l'antériorité du droit sur la marque "COUSCOUS SIPA" à

la société PASTACORP motif pris de l'opposabilité de la cession à la société NOSOCO TOGO :

"Attendu qu'en effet, le contrat de cession entre les sociétés RCL et PASTACORP n'a été enregistré et porté à la connaissance des tiers, notamment la société NOSOCO-TOGO, que le 17 janvier 2005 par l'enregistrement de la cession au registre spécial des marques tenu à l'Organisation, donc postérieurement à l'enregistrement de la marque Couscous SIPA au profit de la société NOSOCO-TOGO, répertorié à l'OAPI sous le numéro n° 47.511 en date du 16 juillet 2002".

La Haute juridiction en a déduit, au visa de l'article 27 de l'annexe III de l'Accord de Bangui révisé, que la société NOSOCO TOGO Sarl jouit d'un droit antérieur sur la marque litigieuse et que PASTACORP SA n'est pas habilitée à en solliciter l'annulation, comme l'aurait fait la société RCL propriétaire initiale.

"Attendu que par conséquent, la société PASTACORP n'étant encore titulaire de la marque au moment où NOSOCO-TOGO l'avait enregistrée à son profit, seules les sociétés SEMOULERIE DE NORMANDIE et RIVOIRE ET CARRET LUSTACRU (RCL) dont l'enregistrement de la marque 'Couscous SIPA' était antérieur à celui de NOSOCO-TOGO pouvaient agir en annulation de l'enregistrement opéré par NOSOCO-TOGO;

"Attendu que or, lesdites sociétés n'ont exercé aucun recours contre l'enregistrement de NOSOCO-TOGO; qu'il s'ensuit que la société PASTACORP dont le droit de propriété est postérieur à celui de NOSOCO-TOGO n'est pas fondée à agir en annulation de l'enregistrement de cette dernière; que le moyen est donc fondé, d'où il suit que l'arrêt critiqué encourt cassation et annulation".

L'article 27 de l'annexe III de l'Accord de Bangui révisé subordonne en effet l'opposabilité de la cession aux tiers à un formalisme dirimant, à savoir l'inscription au registre spécial des marques⁹⁹. L'OAPI tient, pour chaque objet de propriété industrielle et pour l'ensemble des États membres, un registre spécial dans lequel sont portées les inscriptions prescrites par l'accord. Or, la cession de la marque "COUSCOUS SIPA" intervenue entre la RCL et la société PASTACORP SA a été inscrite seulement le 17 janvier 2005 et donc postérieurement à l'enregistrement dont se prévaut NOSOCO TOGO. Si la haute juridiction Togolaise a approuvé le premier juge en ce qu'il a confirmé la société NOSOCO TOGO Sarl dans son droit d'exploitation de la marque "COUSCOUS SIPA" n° 47.511 du 3 juillet 2003 enregistrée antérieurement à l'inscription de la cession, rien n'explique cependant l'invalidation de la marque "COUSCOUS SIPA" n° 21.047 du 9 février 1981 qui en soi ne comporte, selon toute

96 L'art. 19 du susdit accord indique que l'enregistrement d'une marque n'a d'effet que pour dix ans, à compter de la date de dépôt de la demande d'enregistrement; toutefois, la propriété de la marque peut être conservée sans limitation de durée par des renouvellements successifs pouvant être effectués tous les dix ans. Le renouvellement est donc une formalité qui permet de maintenir indéfiniment les droits sur une marque. Il est régi par l'art. 21 du même accord. La jurisprudence indique que le renouvellement résultant d'une simple déclaration sans formalité d'examen, et non d'un nouveau dépôt, ne fait pas naître un nouveau droit, mais permet simplement de le conserver : CA Paris, 4^e chambre, 8 avril 1998 : Gaz. Pal. 1998, II, p. 545.

97 Cette disposition, intégralement reprise par l'art. 4 l'ABR-2015, précise que : sous réserve des dispositions ci-après, la propriété de la marque appartient à celui qui, le premier, en a effectué le dépôt.

98 Par le mécanisme de la subrogation, le cessionnaire est désormais titulaire des droits résultant de l'enregistrement de la marque cédée et est par conséquent habilité à exercer les actions nécessaires pour la protection et la défense de ses intérêts comme l'aurait fait le titulaire initial.

99 L'ABR-2015 prévoit, en son art. 31, une double formalité aux fins d'opposabilité, à savoir l'inscription au registre spécial des marques et la publication au Bulletin officiel.

vraisemblance, aucun vice pouvant fonder son annulation.

Il importe de souligner que le premier juge a annulé l'enregistrement opéré par la société PASTACORP SA le 17 janvier 2005. Pourtant, cette société n'a en réalité pas procédé à un nouvel enregistrement de la marque litigieuse, celle-ci ayant vu sa validité prorogée jusqu'en 2021, la date du 17 janvier 2005 étant plutôt celle de l'inscription de la cession au registre spécial des marques. Or, l'inscription de la cession n'est pas requise *ad validitatem* mais aux fins d'opposabilité aux tiers. La Cour de cassation française relève de façon constante que le défaut de publicité au registre spécial des marques ne remet pas en cause la validité de l'acte de cession ou du nantissement. Il rend seulement celle-ci inopposable aux tiers¹⁰⁰. Sous ce rapport, c'est à tort que l'annulation de l'enregistrement COUSCOUS SIPA n° 21.047 du 9 février 1981 a été prononcée, l'antériorité de cette marque devant s'apprécier au jour du dépôt initial et non à la date de l'enregistrement de la cession. Cette approche aurait plutôt conduit le juge suprême à admettre à la limite une coexistence des marques en conflit, encore que cette solution perd tout son intérêt lorsqu'on convoque la notion de fraude.

B. Le déposant frauduleux

La question de la fraude n'a pas été expressément posée devant la Haute juridiction togolaise qui s'est sans doute bornée à examiner la pertinence des moyens de droit tels qu'articulés par la société NOSOCO TOGO Sarl qui invoquait, à l'appui de son pourvoi, la violation des articles 24-2 et 27 de l'annexe III de l'Accord de Bangui révisé. Pourtant, la haute juridiction était en droit de soulever d'office le moyen d'ordre public tiré de la violation du principe général de droit *fraus omnia corrumpit*. La Commission supérieure de recours auprès de l'OAPI a eu l'occasion de convoquer ce principe général de droit qui signifie "la fraude corrompt tout", pour rejeter l'opposition à l'enregistrement de la marque "PRINCESSE VIGNETTE" n° 43441¹⁰¹, pour invalider la marque querellée. De ce point de vue, cette décision appelle quelques réserves.

L'on comprend dès lors pourquoi la société PASTACORP SA a plus tard saisi le tribunal de grande instance de Yaoundé aux fins d'annulation de la même marque "COUSCOUS SIPA" en fondant cette fois son action sur la fraude qu'aurait orchestrée la société NOSOCO TOGO. Il va sans dire qu'à la date de l'enregistrement querellé, cette société avait parfaitement connaissance de ce que la marque litigieuse était précédemment enregistrée au profit de son partenaire séculaire, la RCL. La fraude paraît évidente en la cause. Le collège des juges du tribunal de grande instance a justement indiqué : "Qu'il s'en dégage alors qu'au moment où sieur NABIL TARRAF KOU DJOCK a procédé à l'enregistrement de la marque querellée, il avait pleine conscience de l'existence d'une marque antérieure identique; que ce faisant, il

a procédé par la fraude; qu'il s'en dégage alors que la société PASTACORP est fondée à solliciter l'annulation de son enregistrement; qu'il échet de faire droit à cette demande". Par ce raisonnement qui mérite pourtant approbation, les juges du tribunal de grande instance du Mfoundi semblent avoir déshabillé Pierre pour habiller Paul en ce qu'ils ont résolu une difficulté tout en créant une autre, la plus redoutable qui soit, celle du respect de l'autorité régionale des décisions judiciaires définitives portant sur la validité des titres.

II. L'altération de la règle de l'autorité régionale des décisions judiciaires définitives

L'article 18 de l'ABR-1999 dispose : "Les décisions judiciaires définitives rendues sur la validité des titres dans l'un des États membres en application des dispositions du texte des annexes I à X au présent accord font autorité dans tous les États membres, exceptées celles fondées sur l'ordre public et les bonnes mœurs"¹⁰². Les décisions rapportées mettent à rude épreuve le principe dégagé par cette disposition communautaire (A) et sont de nature à embarrasser les instances compétentes de l'Organisation chargées de les mettre en œuvre (B).

A. La violation de l'article 18 de l'ABR-1999

Cette disposition constitue l'une des poutres maîtresses de l'édifice à la base de la construction communautaire. Les plénipotentiaires de l'OAPI ont en effet entendu dès l'origine conférer aux décisions judiciaires définitives rendues dans les États membres sur la validité des titres un rayonnement régional dans l'optique de parachever l'édifice communautaire amorcée par la législation commune. C'est dire que l'arrêt de la Cour suprême du Togo invalidant la marque "COUSCOUS SIPA" n° 21.047 du 9 février 1981 devrait s'imposer aux juges du tribunal de grande instance du Mfoundi en dépit du vice qu'il comporte, en vertu de l'article 18 précité, cette décision ayant acquis autorité de chose jugée. La société PASTACORP SA a sans nul doute mis à profit la défaillance des défenseurs à savoir sieur TAKOUNANG Jean Delors et la société NOSOCO TOGO Sarl pour dissimuler aux juges d'instance l'Arrêt invalidant sa marque. À la guerre comme à la guerre! En tout état de cause, la décision du tribunal de grande instance du Mfoundi viole frontalement l'article 18 des dispositions générales de l'Accord de Bangui révisé et pourrait, une fois définitive, plonger les instances compétentes de l'OAPI dans une impasse.

B. Le dilemme au sein de l'OAPI

Le dilemme en face duquel les instances de l'Organisation pourraient se trouver à une double

¹⁰⁰ Voir en ce sens Cass. com., 24 mai 1994 : D. 1994, IR, p. 55.

¹⁰¹ Voir CSR, Décision n° 032/CSR/OAPI du 25 mars 2004, in : Recueil des décisions de la CSR, Sessions de 2003 à 2005, p. 18. Voir également TGI du Mfoundi, Jugement n° 672/CIV du 17 septembre 2003, *Société Cooper c. Laboratoire Bride SA* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 3, section F).

¹⁰² Cette disposition a été modifiée par l'art. 20 de l'ABR-2015, qui apporte plus de précisions quant à la compréhension du principe de l'autorité régionale des décisions judiciaires définitives portant sur la validité des titres; l'al. 1 de cet article indique en effet que : sous réserve des dispositions de l'art. 4 précèdent, les décisions judiciaires définitives rendues sur la validité des titres dans l'un des États membres en application des dispositions du texte des annexes I à X au présent accord font autorité dans tous les autres États membres, exceptées celles fondées sur l'ordre public et les bonnes mœurs. L'al. 2 renchérit : les décisions judiciaires définitives rendues dans l'un des États membres, dans les domaines autres que la validité des titres, sont exécutoires dans les autres États membres en vertu d'une décision d'exequatur rendue conformément à la législation de l'État concerné, exceptées celles fondées sur l'ordre public et les bonnes mœurs.

dimension : la première d'ordre juridique (1) et la seconde d'ordre pratique (2).

1. La dimension juridique du dilemme

Aux termes de l'article 28 de l'annexe III de l'Accord de Bangui révisé : "Toute décision judiciaire définitive prononçant l'annulation des effets sur le territoire national de l'un des États membres du dépôt d'une marque doit être inscrite au registre spécial des marques sur notification de la juridiction et faire l'objet d'une mention publiée par l'Organisation". En application de cette disposition, l'OAPI pourrait se retrouver en possession de deux décisions judiciaires définitives contraires émanant de deux États membres et portant sur la même marque, en l'occurrence l'arrêt n° 47/11 du 21 juillet 2011 de la Cour suprême du TOGO invalidant la marque, "COUSCOUS SIPA" n° 21.047 du 9 février 1981 et le jugement n° 96/Com du 4 mai 2016 du tribunal de grande instance du Mfoundi réhabilitant la même marque. Laquelle des deux décisions sera prise en considération au sein de l'Organisation? Un véritable choix cornélien! Les puristes accorderont sans ambages prééminence à celle émanant de la Cour suprême qui est la plus haute instance juridictionnelle d'un pays. Cette approche nous paraît hâtive et même artificielle étant observé qu'il n'existe aucune hiérarchie du moins formelle entre les décisions rendues dans différents États, l'OAPI n'ayant de surcroît pas vocation à privilégier un État au détriment d'un autre au risque de se faire du mal. On voit là se profiler à l'horizon la question de la nécessité d'une Cour régionale de justice de propriété intellectuelle seule habilitée à régler de telles questions.

2. La dimension pratique du dilemme

L'implémentation des décisions judiciaires définitives susévoquées par les services techniques compétents de l'OAPI en application de l'article 24, alinéa 3, de l'ABR-1999 a généré un abondant contentieux administratif qui a récemment connu un dénouement à la faveur d'une décision fort intéressante de la Commission supérieure de recours. Cette disposition légale précise en effet que lorsque la décision déclarant l'enregistrement nul et non avenu est devenue définitive, elle est communiquée à l'Organisation aux fins d'inscription dans le registre spécial des marques. Initialement saisie par la Société NOSOCO TOGO Sarl, aux fins d'inscription de l'Arrêt contradictoire n° 47 de la Cour suprême du TOGO, l'Organisation a refusé de s'exécuter motif pris de ce que cette décision n'avait pas été rendue en application des dispositions de l'AB et ses annexes. Elle a, par contre, réservé une suite heureuse à la demande postérieure de la société PASTACORP SA tendant à l'inscription des jugements n° 095 et 096 rendus le 4 mai 1996 par le tribunal de grande instance du MFOUNDI portant respectivement annulation des marques "COUSCOUS SIPA + logo" n° 47511 et "COUSCOUS SIPA" n° 64509 appartenant à la société NOSOCO TOGO Sarl¹⁰³. Ce différend fut porté

devant le collège des Magistrats de la Commission supérieure de recours et réglé en faveur de la société NOSOCO TOGO Sarl¹⁰⁴. Nonobstant cette posture de l'instance faïtière de règlement des différends au sein de l'OAPI, ses services compétents ne se sont pas toujours exécutés, contraignant la susdite société à solliciter à nouveau le magistrat de ladite instance, cette fois en annulation des décisions du directeur général de l'OAPI portant inscription au registre spécial des marques des jugements rendus par le juge d'instance du MFOUNDI. Par décision n° 0018/20/OAPI/CSR du 17 novembre 2020, ladite Commission a mis un terme à ce différend au plan administratif d'une part, en annulant les décisions du directeur général de l'OAPI critiquées et, d'autre part, en ordonnant l'inscription au registre spécial des marques tant de l'Arrêt n° 47/11 du 21 juillet 2011 de la Cour suprême du TOGO que de la décision n° 0183/OAPI/CSR rendue le 30 octobre 2014 par la Commission supérieure de recours. Cette importante décision traduit le rôle de régulateur que doit jouer cette instance au sein de l'Organisation qui est tenue de se conformer aux décisions de justice définitives rendues par les juridictions des États membres en application de l'AB et ses annexes.

Max Lambert Ndéma Elongué

H. Marque – Contrefaçon - Imitation frauduleuse – Contrefaçon par usage – Provision – Manque à gagner - Préjudice commercial – Profit réalisé – Préjudice ressenti – Devoir de prudence – Contrat de licence

Si la matérialité de l'acte de contrefaçon de marque est laissée à l'appréciation souveraine des juges de fond, c'est à la condition qu'ils ne dénaturent pas les faits dont ils sont saisis. Ainsi, les juges ne peuvent ajouter à la loi en exigeant des circonstances non prévues.

Par ailleurs, en procédant à la réparation du préjudice subi par le propriétaire de la marque, le tribunal doit s'appuyer sur des éléments comptables, notamment le profit réalisé par le contrefacteur.

Cour d'appel de DAKAR, Arrêt n° 425/Com du 19 juin 1998, SOCIÉTÉ M.SA c. STÉ BA IMPORT-EXPORT

Observations :

Si la matérialité de l'acte de contrefaçon de marque est laissée à l'appréciation souveraine des juges de fond, c'est à la condition qu'ils ne dénaturent pas les faits dont ils sont saisis. Ainsi, les juges ne peuvent ajouter à la loi en exigeant des circonstances non prévues. Par ailleurs, en procédant à la réparation du préjudice subi par le propriétaire de la marque, le tribunal doit s'appuyer sur des éléments comptables, notamment le profit réalisé par le contrefacteur. L'application de ces principes, qui découlent de l'essence même des dispositions de l'annexe III de l'Accord de Bangui, révisé en 1999, et de

103 L'inscription de ces jugements fut constatée par les décisions du directeur général de l'OAPI n° 18/0513/OAPI/DG/DMSD/SSPD et n° 18/0512/OAPI/DG/DMSD/SSPD du 27 avril 2018, inédites.

104 Voir : Décision n° 0183/OAPI/CSR du 30 octobre 2014, inédite.

l'Acte de 2015 dudit accord, est toujours à l'ordre du jour, tant il est vrai que la jurisprudence dans les États parties à l'accord est abondante et sont intéressants même si certaines décisions sont parfois très discutables. Le présent arrêt s'inscrit dans ce cadre.

Faits : Pour rappel, les sociétés M... et Veuve M. C. et FILS avaient, par acte en date des 2 septembre 1980 et 1^{er} janvier 1990, fait enregistrer auprès de l'Organisation africaine de la propriété intellectuelle (OAPI) et de l'Institut national de la propriété intellectuelle (INPI) la marque de joints de culasse "MEILLOR". Ainsi, dans le cadre de l'exploitation de cette marque, elles avaient signé avec la société A.J. de droit tunisien un contrat de licence qui a expiré le 3 mai 1993.

Toutefois, constatant la commercialisation au Sénégal, sans son consentement, des joints de culasse "MEILLOR" par les sociétés BA...IMPORTEXPORTE et FOUR, qui les importaient auprès de la société A.J., elles ont saisi le président du tribunal régional de Dakar¹⁰⁵ qui, par ordonnance du 6 août 1996, les a autorisées à faire procéder à une saisie-description de ces produits.

Par exploit du 22 août 1996, les bénéficiaires ont assigné en validation de la saisie pratiquée le 14 août 1996, en paiement de la somme de cent millions de francs CFA à titre de dommages et intérêts. Saisi de cette affaire, le juge d'instance a débouté les sociétés M... et Veuve M. C. et FILS de toutes leurs demandes au motif que les défenderesses n'ont pas violé les dispositions des articles 37 et 38 de l'Accord de Bangui.

Raisonnement : Sur appel interjeté par les sociétés demanderesse, la cour d'appel a infirmé partiellement la décision d'instance en validant, d'une part, la saisie-description sur le fondement de l'existence d'une contrefaçon par usage, ordonnant ainsi la destruction des échantillons et, d'autre part, en retenant la responsabilité civile des sociétés BA...IMPORT-EXPORT et FOUR..., en allouant, toutefois, le franc symbolique aux sociétés M... et Veuve M. C. et FILS.

Pour parvenir à cette décision, la Cour a répondu à deux questions qui lui étaient principalement posées :

- a. L'importation et la mise en vente de produits provenant d'une société, dont la licence d'exploitation est expirée, sont-elles constitutives d'actes de contrefaçon?
- b. Le juge du fond peut-il réparer le préjudice résultant de cette contrefaçon, en s'abstenant de réparer intégralement le préjudice en cas d'impossibilité matérielle de le chiffrer?

Pour la Cour, il y a effectivement contrefaçon résultant d'une négligence de l'importateur des produits contrefaisants. Pour aboutir à cette conclusion, elle a écarté

105 Le tribunal régional hors classe de Dakar est devenu le tribunal de grande instance hors classe par l'effet de la loi n° 2014-26 du 3 novembre 2014 abrogeant et remplaçant la loi n° 84-19 du 2 février 1984 fixant l'organisation judiciaire au Sénégal.

la qualification de contrefaçon par imitation frauduleuse pour retenir la contrefaçon par usage, avant d'admettre la responsabilité des sociétés BA...IMPORT-EXPORT et FOUR pour participation à la réalisation du dommage subi sociétés M... et Veuve M. C. et FILS. En ce sens, elle a aussi répondu par l'affirmative à la deuxième interrogation.

Cette position de la Cour mérite analyse au regard des dispositions pertinentes de l'annexe III de l'Accord de Bangui du 2 mars 1977, sous l'empire de laquelle la décision a été rendue, mais surtout de l'Acte de 2015 dudit accord qui donne désormais une vision plus claire des catégories de contrefaçon de marque et traite de manière plus appropriée la lancinante question de la réparation du dommage¹⁰⁶.

Il est dès lors important d'aborder ici :

- I. la question de la sanction de l'importation et de la mise en vente de produit contrefaisant par le juge du fond; et
- II. l'appréciation de la responsabilité de l'auteur de ces actes par le juge du fond.

I. L'appréciation de la contrefaçon par importation ou mise en vente de produits contrefaisants par le juge du fond

Le juge a conclu à l'absence d'une imitation frauduleuse en estimant que les sociétés BA...IMPORT-EXPORT et FOUR... n'ont procédé à aucune modification des caractéristiques de la marque de nature à tromper l'acheteur (A). Pour autant elle a relevé qu'il y avait contrefaçon par usage (B).

A. L'absence de modification substantielle de nature à tromper l'acheteur

En rejetant les prétentions des sociétés M... et Veuve M. C. et FILS, la cour d'appel a bâti son argumentaire autour de la modification substantielle ou non de la marque "MEILLOR" dont les appelants principaux détiennent le droit exclusif. En effet, la notion d'imitation frauduleuse était, sous l'empire de l'Accord de Bangui du 2 mars 1977, une alternative pour sanctionner le comportement illicite d'un fabricant qui ne pouvait être poursuivi sur le fondement de la contrefaçon de marque. De fait, à la lecture de l'article 38.a) de l'Accord de Bangui du 2 mars 1977 sur la base duquel le juge d'appel a apprécié l'existence ou non d'une imitation frauduleuse, on s'aperçoit que ce délit n'entre pas dans le champ de la contrefaçon de marque¹⁰⁷.

D'ailleurs le législateur procédait à un emprunt de pénalité en précisant que celui qui, "sans contrefaire une marque", en aura fait l'imitation frauduleuse de nature

106 Cf. art. 54 de l'annexe III de l'ABR-2015 : "La juridiction saisie détermine le montant des dommages et intérêts, en tenant compte des conséquences économiques négatives, dont le manque à gagner, subies par la partie lésée, les bénéfices réalisés par le contrefacteur et le préjudice moral causé au titulaire des droits du fait de l'atteinte."

107 Art. 38 let. a : "Sont punis d'une amende de 50 000 à 150 000 francs CFA et d'un emprisonnement d'un mois à un an, ou de l'une de ces peines seulement : a) ceux qui, sans contrefaire une marque, en ont fait une imitation frauduleuse de nature à tromper l'acheteur ou ont fait usage d'une marque frauduleusement imitée."

à tromper l'acheteur, sera puni des mêmes peines que celles prévues pour la contrefaçon de marque. Cette distinction opérée dans l'ancienne législation ne nous semblait pas justifiée dès lors que la contrefaçon englobe la reproduction ou, de manière générale, l'utilisation d'une marque enregistrée, sans l'autorisation du titulaire des droits de nature à affecter l'image de celle-ci¹⁰⁸.

Au regard de cette définition, l'imitation frauduleuse entre bien dans la catégorie de la contrefaçon de marque. D'ailleurs l'Acte de 2015 a corrigé ce manquement en précisant que "Toute atteinte portée aux droits du titulaire de la marque, tels qu'ils sont définis à l'article 6, constitue une contrefaçon"¹⁰⁹.

À la faveur de l'Accord de Bangui révisé de 1999 et de l'Acte de 2015 dudit accord, toutes ces infractions sont désormais regroupées dans l'expression "exploitation illicite d'une marque enregistrée"¹¹⁰. L'imitation frauduleuse d'une marque de nature à engendrer un risque de confusion dans l'esprit du public constitue une contrefaçon¹¹¹. Et cette démarche est à saluer dès lors que toute exploitation illicite d'une marque renvoie à la contrefaçon¹¹².

Il faut noter que c'est à juste titre que la cour d'appel a relevé que l'imitation de la marque "MEILLOR", dont se prévalaient les appelants, n'a pas été suffisamment caractérisée. L'imitation, dont il s'agit ici, doit porter sur des produits ou services identiques ou similaires à ceux désignés dans l'enregistrement. La jurisprudence en la matière a dégagé trois conditions nécessaires à la caractérisation de l'imitation illicite :

- a. d'abord, une imitation d'une marque enregistrée par la reprise d'éléments phonétiques, visuels ou conceptuels; ensuite
- b. une identité ou une similarité des produits; et enfin
- c. des conditions de nature à créer un risque de confusion dans l'esprit du public¹¹³.

Elle ne peut, en effet, être retenue si la preuve de l'existence d'une grande éventualité de confusion n'est pas rapportée; cette preuve est à la charge de celui qui s'en prévaut. À ce niveau, il n'est point exigé que la différence soit caractéristique ou remarquable mais

108 À titre de comparaison : voir l'art. 58 de l'annexe I et l'art. 41 de l'annexe II de l'AB-1977. Il ressort de ces dispositions que toute atteinte portée aux droits du breveté ou au modèle d'utilité, soit par l'emploi de moyens faisant l'objet de son brevet ou de son modèle d'utilité, soit par le recel, soit par la vente ou l'exposition en vente ou soit par l'introduction sur le territoire national de l'un des États membres, d'un ou plusieurs objets, constitue le délit de contrefaçon.

109 Art. 49 de l'annexe III de l'ABR-2015.

110 Les infractions des art. 37 et 38 de l'AB-1977 sont maintenant réunies au sein de l'art. 37 de l'ABR qui prévoit maintenant des sanctions pour les infractions d'omission et le non-respect des restrictions, notamment les signes dont l'emploi est prohibé. Voir aussi l'art. 57 de l'annexe III de l'ABR-2015.

111 TGI de Paris, 3^e chambre, 3^e section, 7 janvier 2003, *SA Iliad c. Cédric A.*

112 À propos de l'exigence d'une reproduction à l'identique ou quasi-identique, il ressort de la jurisprudence de la Cour de justice de l'Union européenne qu'"un signe est identique à la marque lorsqu'il reproduit, sans modification ni ajout, tous les éléments constituant la marque ou lorsque, considéré dans son ensemble, il recèle des différences si insignifiantes qu'elles peuvent passer inaperçues aux yeux d'un consommateur moyen" (Cour de justice de l'Union européenne, Arrêt du 20 mars 2003, *LJ Diffusions SA c. Sadas Verbaudet SA*, C-291/00, ECLI:EU:C:2003:169, point 54).

113 Voir art. 6 de l'ABR-2015.

qu'elle puisse entraîner une confusion chez l'acheteur¹¹⁴. C'est pourquoi la caractérisation de l'imitation frauduleuse de marque requiert nécessairement de prendre en considération le consommateur. De fait, c'est au regard de sa capacité à distinguer les produits que sera appréciée la portée de l'imitation pour envisager sa sanction.

En l'espèce, par constat d'huissier en date du 4 septembre 1996, il a été établi que les joints de culasse entreposés par les sociétés BA...IMPORT-EXPORT et FOUR... étaient identiques aux caractéristiques des joints de série 411-129 et 411-652 dont la marque appartient aux sociétés M... et Veuve M. C. et FILS. Malgré ce constat, la cour a considéré que la contrefaçon par imitation frauduleuse ne pouvait être retenue au motif que "les sociétés M... et Veuve M. C. et FILS n'ont pas démontré les moyens par lesquels les sociétés FOUR... et BA... IMPORT-EXPORT auraient modifié les caractéristiques de la marque 'MEILLOR' qui, ainsi, serait galvaudée, par imitation frauduleuse". Elle a, par contre, estimé qu'il y avait une contrefaçon par usage consistant à l'introduction et la mise en circulation des produits contrefaisants.

B. La reconnaissance d'une contrefaçon par usage

Analysant les faits de l'espèce au regard de l'article 37.a) de l'annexe III de l'Accord de Bangui du 2 mars 1977, la cour d'appel a retenu qu'en important des produits contrefaisants les sociétés BA...IMPORT-EXPORT et FOUR... ont commis une contrefaçon par usage.

Il faut rappeler que la contrefaçon par usage, telle que prévue à l'article 37.a) de l'annexe III de l'Accord de Bangui révisé qui dispose que "ceux qui ont contrefait une marque ou fait usage d'une marque contrefaite" sont punis d'une amende et/ou d'un emprisonnement, implique au préalable la caractérisation de la marque contrefaite¹¹⁵.

En l'espèce, en retenant la notion de contrefaçon par usage, le juge a considéré que la marque "MEILLOR" est contrefaite par la société tunisienne A.J. Cette contrefaçon s'apparente à la contrefaçon par reproduction qui se définit comme la reproduction de la marque à l'identique, sans retraits ni ajouts mais sans le consentement du propriétaire¹¹⁶.

La société M. SA, par contrat de licence de marque du 19 mai 1992, complété par un avenant signé à la même date à NANTIAT en France, avait concédé à la société A.J. le droit de l'utiliser. Toutefois, le contrat de licence, qui liait les parties, a été résilié le 3 mai 1993. Dès lors, au

114 Voir *SA Iliad c. Cédric A.*, n.111; jugé qu'"Aux termes de l'article L. 713-3 du code de la propriété intellectuelle : 'sont interdits [...], s'il peut en résulter un risque de confusion dans l'esprit du public [...], l'imitation d'une marque et l'usage d'une marque imitée pour des produits identiques ou similaires à ceux désignés dans l'enregistrement"'. En l'espèce, la modification consistant à remplacer une lettre par un tiret dans le cadre de l'intitulé 3617 An-u, l'annuaire inversé, représente une imitation manifeste.

115 Voir l'art. 57 de l'annexe III de l'ABR-2015.

116 Voir TGI du Wouri (Douala), Jugement n° 886/civ du 5 décembre 2016, *Forest Stewardship council c. Boris Bois Sarl Rapp* (obs. FADE (A.)), ce recueil, chapitre 3, section B).

moment où les joints de culasse de marque "MEILLOR" avec les caractéristiques 411-129 et 411-652 ont été livrés courant 1996 à la société FOUR... par la société A.J., cette dernière n'avait plus le droit d'utiliser la marque susvisée. De ce fait, les sociétés M... et Veuve M. C. et FILS avaient tout intérêt à s'opposer à la mise en circulation de leur marque "MEILLOR", enregistrée auprès de l'OAPI et de l'INPI, et indûment apposée sur les pochettes et joints de culasse des séries 411-129 et 411-652, respectivement, sous les n° 20698 et 045202.

Cette protection a été réitérée par les dispositions des articles 7 de l'annexe III de l'Accord de Bangui révisé 24 février 1999 et 6 de l'Acte 2015 dudit accord. Le propriétaire de la marque a, en effet, le droit exclusif d'utiliser la marque, ou un signe lui ressemblant pour les produits ou services pour lesquels elle a été enregistrée, ainsi que pour des produits ou services similaires¹¹⁷. Toutefois, le choix du juge d'appel d'analyser les faits de l'espèce sous l'angle de la contrefaçon par usage nous paraît discutable. Au regard de l'article 37.a) de l'annexe III de l'Accord de Bangui du 2 mars 1977, la contrefaçon est dite d'usage lorsque la marque est utilisée par un tiers fabricant sans l'autorisation du propriétaire¹¹⁸. En l'espèce, apprécier les faits sous l'angle de la vente ou de la mise en circulation de produits contrefaisants, comme le prévoit l'article 37.c) de l'annexe III de l'Accord de Bangui du 2 mars 1977 nous semble plus approprié.

En effet, il est établi que les sociétés BA...IMPORT-EXPORT et FOUR... ont introduit et mis en circulation des produits contrefaisants qui ont été fabriqués par la société tunisienne M. SA qui n'avait plus le droit d'exploiter la marque "MEILLOR". La contrefaçon par usage aurait pu être retenue de manière plus aisée à l'encontre de la société fabricante notamment A.J. et dans ce cadre, le faisceau d'indices aménagé par la jurisprudence serait mis en œuvre pour apprécier la

caractérisation de la contrefaçon¹¹⁹. D'ailleurs, à la faveur de la révision de l'Accord de Bangui, la caractérisation de la contrefaçon par usage requiert désormais que la marque porte des indications propres à tromper l'acheteur sur la nature du produit¹²⁰.

Poursuivant sa logique, la cour, après avoir retenu la contrefaçon par usage, a naturellement admis la responsabilité des sociétés BA...IMPORT-EXPORT et FOUR...

II. L'appréciation de la responsabilité de l'auteur de la contrefaçon par le juge du fond

Cette responsabilité résulte de leur participation à la réalisation du dommage subi par M... et Veuve M. C. et FILS (A) et nécessite une réparation (B).

A. La responsabilité pour participation à la réalisation du dommage

Pour en arriver à cette conclusion, la cour a relevé que ces sociétés ont introduit au Sénégal des produits contrefaisants de la marque "MEILLOR" qui appartient exclusivement aux sociétés M... et Veuve M. C. et FILS. Dans la démarche de la juridiction, même si les intimées n'ont pas commis de contrefaçon de marque, elles sont passibles de contrefaçon par usage. C'est d'ailleurs sur ce fondement que les juges ont estimé qu'elles n'étaient pas étrangères au préjudice subi par les appelants.

Les juges d'appel ont pris en considération la bonne foi des sociétés importatrices dans leurs rapports avec la société A.J. Ils ont estimé, en effet, que cette dernière leur a caché la résiliation conventionnelle de sa licence en leur fournissant des documents qui attestaient du contraire. Néanmoins, la cour ne semble tirer aucune conséquence de cette bonne foi dès lors que le raisonnement adopté pour conclure à la participation de ces sociétés au préjudice subi par les appelants principaux n'intègre nullement cet élément moral. D'ailleurs cela nous paraît surprenant. En effet, en prenant en compte l'élément moral, la conséquence serait de ne pas retenir une contrefaçon par usage dès

117 Il s'agit de l'ancien art. 20 de l'AB-1977. L'annexe III de l'ABR-1999 en son art. 7 al. 2 a introduit un autre droit au profit du propriétaire de la marque, notamment celui exclusif d'empêcher tous les tiers agissant sans son consentement de faire usage au cours d'opérations commerciales de signes identiques ou similaires pour des produits ou services qui sont similaires à ceux pour lesquels la marque de produits ou de services est enregistrée dans le cas où un tel usage entraînerait un risque de confusion.

118 Une comparaison des dispositions des art. 37 let. a et art. 38 let. b de l'annexe III de l'AB-1977, art. 37 al. 1 let. a et art. 37 al. 2 let. b de l'annexe III de l'ABR-1999 et de l'art. 57 de l'ABR-2015 permet de dire que la contrefaçon par usage requiert non seulement la matérialité de l'usage d'une marque contrefaisante mais aussi l'existence d'indications propres à tromper l'acheteur sur la nature du produit. Dans les deux derniers cas, l'usage de la marque semble s'adresser au fabricant et non au vendeur.

119 Cf. art. 37 al. 1 let. a et art. 37 al. 2 let. b de l'annexe III de l'ABR-1999. Au regard des dispositions relatives aux sanctions concernant la contrefaçon, il nous semble que l'Accord de Bangui a prévu d'une part des sanctions pour les fabricants et d'autre part des sanctions pour les vendeurs ou distributeurs (l'ABR est plus précis lorsqu'il s'agit par exemple du brevet ou des modèles d'utilité car les dispositions de l'art. 58 de l'annexe I et 41 de l'annexe II prévoient le recel de contrefaçon de brevet). L'ABR-2015 n'a pas apporté de changement à ce niveau car il prévoit les mêmes recels en ses art. 55 de l'annexe I et 61 de l'annexe II. Il serait largement recommandé que l'ABR-2015 généralise le recel comme acte de contrefaçon pour toutes les œuvres de propriété intellectuelle. Mais on peut se demander si l'art. 430 du Code pénal du Sénégal qui dispose que "Ceux qui sciemment auront recelé, en tout en partie, des choses ou biens quelconques enlevées, détournées ou obtenues à l'aide d'un crime ou d'un délit, seront punis des peines prévues par l'art. 370", ne permettrait pas de sanctionner le recel de contrefaçon de marque. Notre lecture de cette disposition nous conduit à l'affirmative. La possession ou la détention d'un objet contrefaisant constitue un acte de recel qui nécessite l'établissement de la mauvaise foi de l'agent pénal pour la sanction. Voir par exemple Cour de justice de l'Union européenne, Arrêt du 6 février 2014, *Leidseplein Beheer BV et Hendrikus de Vries c. Red Bull GmbH et Red Bull Nederland BV*, C-65/12, ECLI:EU:C:2014:49; CA Paris, Pôle 5, 12^e chambre, Arrêt du 23 janvier 2012.

120 Cf. art. 37 al. 2 let. b de l'annexe III de l'ABR-1999.

lors qu'il est établi qu'il y avait un usage honnête comme l'a rappelé la cour de cassation française¹²¹.

Cette expression d'"usage honnête" est un critère qui aurait permis de ne pas sanctionner systématiquement l'usage de la marque d'autrui sans le consentement de ce dernier. Même si la cour n'a pas tiré de conséquences relativement à la bonne foi des sociétés BA...IMPORT-EXPORT et FOUR... elle a aussitôt rappelé qu'en introduisant des produits contrefaisants au Sénégal, elles ont manqué à leur propre devoir de prudence. Cette approche semble problématique car le devoir de prudence n'étant pas défini par la loi, il faudra se référer à la jurisprudence dont la codification avait été proposée dans le projet de réforme du droit des obligations en France. En effet, l'article 1242 de ce projet l'apprécie comme une faute et l'appréhende comme un "acte objectivement anormal au regard du comportement attendu d'une personne raisonnable"¹²².

En l'espèce, la cour ne caractérise pas le manquement au devoir de prudence. En réalité, elle a rappelé que les sociétés BA...IMPORT-EXPORT et FOUR... ont prouvé leur bonne foi et qu'il est établi qu'elles se sont basées sur un contrat de licence fournie par la société A.J. Poursuivant, elle précise qu'elles se sont aussi fondées sur les renseignements dont elles disposaient. Or, dans ces conditions, retenir un manquement à une obligation de prudence suscite des interrogations¹²³. De fait, le juge n'a pas suffisamment caractérisé la faute sur le fondement de laquelle elle a retenu la responsabilité des sociétés BA...IMPORT-EXPORT et FOUR... Cette caractérisation est d'autant plus nécessaire que la jurisprudence admet un contrôle sur la qualification de la faute.

En ce sens, la Cour de cassation a rappelé au juge du fond son obligation de caractériser la faute dans tous ses éléments à partir des circonstances de fait souverainement appréciées et qu'il ne doit pas se limiter à déduire de la constatation d'un préjudice l'existence d'une faute (le principe est posé dans la décision depuis 1873)¹²⁴.

Néanmoins, pour la cour d'appel, le fait d'avoir introduit sur le territoire sénégalais des produits contrefaisants suffit à retenir la responsabilité des sociétés BA...IMPORT-EXPORT et FOUR... et à envisager la réparation.

B. La réparation du dommage subi par le titulaire de la marque contrefaite

La cour d'appel a d'abord évalué le préjudice (1) avant de définir les mécanismes de réparation (2).

1. L'évaluation du préjudice résultant de la contrefaçon de marque

La cour considère d'emblée que l'évaluation du préjudice subi par le propriétaire d'une marque contrefaite est faite en considération du montant des bénéfices réalisés par la vente illicite des objets contrefaisants puisqu'ils peuvent être corrélés avec la perte subie par la victime de la contrefaçon.

Ce mécanisme de réparation, consistant à se référer aux éventuels bénéfices de l'auteur de la faute, serait propre à l'action en contrefaçon car, dans la théorie générale de la responsabilité civile, on envisage le principe de la réparation intégrale du préjudice évalué par rapport à celui qui subit le dommage¹²⁵. En privilégiant, pour la détermination du montant de la réparation, le profit réalisé par l'auteur du dommage au détriment du préjudice subi par la victime, la juridiction d'appel semble diluer le principe de la réparation intégrale.

Toutefois, l'intérêt de sa démarche réside dans le caractère avant-gardiste de la décision. De fait, sanctionner le comportement du contrefacteur, en se fondant sur le profit réalisé, permet d'assurer une meilleure protection des droits de propriété intellectuelle et partant, éviter le développement des pratiques contrefaisantes, au regard du caractère quasi-automatique de la réparation qui, de surcroît, sera au minimum égal au profit que le contrefacteur aura réalisé. Ainsi, il ne pourra tirer aucun profit économique de la contrefaçon dont il est l'auteur.

Cette démarche a aussi des limites objectives. Parfois le préjudice subi par le propriétaire de la marque contrefaite peut être plus important que le montant des bénéfices réalisés par le contrefacteur. Pour une meilleure prise en charge de la réparation, l'image de la marque qui peut être affectée par la reproduction ou la vente illicite doit aussi être un élément d'évaluation du préjudice. Pourtant, si l'on se limite aux bénéfices résultant de la vente illicite, cet élément ne saurait être pris en compte. De manière constante, deux éléments doivent entrer en compte dans l'appréciation du montant de la réparation en cas de contrefaçon : l'enrichissement illicite du contrefacteur et la détérioration de la notoriété ou du prestige de la marque¹²⁶.

Pour une meilleure prise en charge de ces préoccupations et pour mieux garantir la réparation du préjudice résultant de la contrefaçon, l'Accord de Bangui, Acte de 2015 en cours de ratification a élargi le champ des critères d'évaluation du préjudice. Il intègre en effet, pertinemment, "les conséquences économiques négatives, dont le manque à gagner, subies par la partie lésée, les bénéfices réalisés par l'auteur de l'acte illicite et

121 Cass. com., 7 juillet 2017, n° 15-28.114.

122 Cette définition n'a pas été finalement retenue lors de l'adoption définitive de la réforme suivant l'Ordonnance n° 2016-131 du 10 février 2016 portant réforme du droit des contrats, du régime général et de la preuve des obligations, in : JORF, n° 0035, 11 février 2016, texte n° 26.

123 Voir DESPORTES (F.), La responsabilité pénale en matière d'infractions non intentionnelles : Rapport annuel de la Cour de cassation française, 2002.

124 Cass. civ., 15 avril 1873, et récemment rappelé par la deuxième chambre civile. Cass. civ., 2^e chambre civile, 14 juin 2018, n° 17-14.781.

125 Cf. art. 134 Code des obligations civiles et commerciales du Sénégal (COCC) : "Les dommages et intérêts doivent être fixés de telle sorte qu'ils soient pour la victime la réparation intégrale du préjudice subi."

126 Cass. civ., 3^e chambre civile, 8 juin 2017, n° 15-21.357.

le préjudice moral causé à la victime¹²⁷. Même s'il n'est pas discuté que la réparation du préjudice au regard des bénéfices réalisés par le contrefacteur est une démarche pertinente dans l'approche avant-gardiste, il faut relever que si le juge peine à disposer d'éléments lui permettant d'apprécier ce bénéfice, il fait face à un obstacle dirimant.

Sans doute, c'est cette difficulté qui a conduit à apprécier les demandes de réparation formulées par les sociétés M... et Veuve M.C. et FILS sous l'angle de la provision prévue à l'article 134 du Code des obligations civiles et commerciales du Sénégal (COCC)¹²⁸. Néanmoins, cette disposition pose effectivement le principe de la réparation intégrale en précisant que "Lorsque le montant des dommages et intérêts dépend directement ou indirectement du montant des revenus de la victime, la réparation allouée est appréciée en tenant compte de ses déclarations fiscales relatives aux trois années qui ont précédé celle du dommage." De fait, la provision envisagée dans le cadre de la réparation du préjudice résultant d'une contrefaçon est une alternative. Ainsi, un montant forfaitaire qui ne peut se résumer en un franc symbolique peut être allouée à la victime¹²⁹.

Dans tous les cas, il y a lieu de faire la démonstration du préjudice invoqué et des sommes réclamées à ce titre. L'article 43 de l'annexe III de l'Accord de Bangui révisé, qui envisage les dommages et intérêts à l'encontre du contrefacteur, ne définit pas les critères de son appréciation. Ainsi, considérant que le préjudice subi par les propriétaires de la marque est établi, la cour a procédé à sa réparation.

2. Les modalités de réparation du préjudice subi par le titulaire de la marque contrefaite

La cour d'appel a alloué le franc symbolique en précisant qu'elle statuait d'après les règles de l'équité sans émettre la prétention de réparer intégralement le préjudice dès lors qu'elle était dans l'impossibilité matérielle de le chiffrer. Cet obstacle résulte du fait que la cour s'est limitée à un seul critère d'appréciation du préjudice, en l'occurrence le profit réalisé par le contrefacteur.

Pourtant, dès lors que l'existence du préjudice n'est plus discutée, l'appréciation de son étendue, qui dépend des éléments factuels de la procédure, devrait être

moins délicate¹³⁰. Toutefois, même si le juge rencontre une difficulté dans la détermination de l'étendue du préjudice, cela ne doit pas le conduire à allouer un franc symbolique qui, en l'espèce, même apprécié sous l'aspect de l'équité, n'est pas adéquat¹³¹. Cette réparation n'est pas suffisante pour compenser le préjudice réellement subi par la victime.

Étant consciente de l'insuffisance de cette réparation, après avoir confirmé la saisie-description, la juridiction d'appel a prescrit d'autres mesures, notamment la destruction des échantillons et la publication par extrait de sa décision dans deux quotidiens aux frais des sociétés BA...IMPORT-EXPORT et FOUR...

Conformément aux dispositions de l'article 44 de l'annexe III de l'Accord de Bangui de 1977 devenu l'article 43 de l'annexe III de l'Accord de Bangui révisé, la destruction des produits contrefaisants a été ordonnée¹³². Cette forme de réparation est efficace car elle met un terme à la mise en circulation du produit contrefaisant¹³³. Même si cette mesure est une peine complémentaire, elle peut s'analyser en une forme de réparation dans la mesure où elle permet au propriétaire de la marque de se débarrasser entièrement du produit contrefaisant¹³⁴. Toutefois, en l'espèce, la mesure paraît incomplète dans son étendue du fait qu'elle ne porte que sur les deux échantillons scellés et remis au greffier en chef du tribunal régional hors classe de Dakar, suivant procès-verbaux en date des 14 et 27 août 1996, dressés

127 Cette modalité de détermination des dommages et intérêts a été généralisée et la même formulation a été reprise dans les différentes autres annexes notamment en matière de brevets d'invention (art. 69), de modèles d'utilité (art. 61), de marque (art. 54), de dessins et modèles industriels (art. 18 al. 4), d'indications géographiques (art. 22 al. 4), etc.

128 Art. 134 COCC : "Les dommages et intérêts doivent être fixés de telle sorte qu'ils soient pour la victime la réparation intégrale du préjudice subi. Lorsque le montant des dommages et intérêts dépend directement ou indirectement du montant des revenus de la victime, la réparation allouée est appréciée en tenant compte de ses déclarations fiscales relatives aux trois années qui ont précédé celle du dommage".

129 Dans le cadre de l'OAPI, l'art. 63 al.1 et al.2 de l'annexe VII de l'ABR-1999 prévoit en matière de propriété littéraire et artistique que "Le montant des dommages et intérêts est fixé conformément aux dispositions pertinentes du Code civil national, compte tenu de l'importance du préjudice matériel et moral subi par le titulaire du droit, ainsi que de l'importance des gains que l'auteur de la violation a retirés de celle-ci." Cette disposition qui n'a pas une portée générale ne nous semble applicable qu'en cette matière. Toutefois, l'ABR-2015 a apporté des correctifs en prévoyant une disposition pareille en matière de marque entre autres, notamment en son art. 54 de l'annexe III.

130 Il peut certes arriver que le préjudice ne soit pas évaluable sur-le-champ pour des raisons d'ordre technique notamment, lorsque l'appréciation des faits de la cause ou des mesures à ordonner exige des connaissances qui sont étrangères au juge. Mais même en pareilles circonstances, les éléments de la procédure notamment, les faits allégués et les pièces versées au soutien des prétentions doivent permettre d'apprécier l'étendue du préjudice. Dans ce cadre, il est admis d'ordonner une expertise à cette fin. Cf. art. 156 et s. Code de procédure civile du Sénégal.

131 CA Paris, 9 mars 2005, *Lindt et Sprüngli SA c./ Établissement Public du Musée et du Domaine de Versailles* : PIBD 2005, III, n° 809, p. 45. Dans cette espèce, il a été jugé que puisque le préjudice subi était purement symbolique, il serait réparé par l'octroi d'une indemnité d'un euro. D'ailleurs, le tribunal de grande instance de Paris relevait dans un jugement du 4 juillet 2003 que la société demanderesse "ne produit (...) aucun document de quelque nature que ce soit pour justifier de son préjudice; qu'elle n'a fait procéder à aucune saisie-contrefaçon dans les locaux (...) ce qui lui aurait permis de faire appréhender certains documents comptables". Néanmoins, il avait accordé la somme de 7000 euros de dommages et intérêts à la société titulaire du droit de brevet et celle de 10 000 euros au licencié exclusif."

132 Voir TPI de Douala-Bonanjou, Jugement n° 009/Civ du 19 janvier 2011, *Ohadate J-12-244, Société Colgate Palmolive Company c. Banaboy Symphore Jacques*. Dans cette affaire, le juge estime que "celui qui contrefait une marque de fabrique alors que celle-ci n'a fait l'objet d'aucune déchéance ou radiation s'expose à la saisie-contrefaçon des produits contrefaits. La saisie ayant été régulièrement pratiquée, le propriétaire de la marque contrefaite, muni d'un certificat de non-déchéance et d'une attestation de non-radiation peut obtenir de la juridiction compétente qu'elle prononce la validité de la saisie-attribution opérée tout en ordonnant la destruction des produits contrefaits et la condamnation du contrefaisant au paiement des dommages et intérêts en réparation du préjudice subi."

133 Conformément à l'art. 133 COCC, le juge peut même d'office prescrire toute mesure destinée à réparer le dommage ou à en limiter l'importance.

134 L'art. 55 de l'ABR-2015 dispose ainsi qu'"en cas de condamnation pour contrefaçon, la juridiction nationale compétente peut ordonner, à la demande de la partie lésée, que les produits reconnus comme produits contrefaisants et les matériaux et instruments ayant principalement servi à leur création ou fabrication soient rappelés des circuits commerciaux, écartés définitivement de ces circuits, détruits ou confisqués". Sachant qu'une partie civile ne peut demander l'application d'une peine, même complémentaire, les prérogatives ainsi reconnues à la partie lésée ne peuvent alors s'analyser que comme des mesures de réparation en nature. Tel est le sens d'ailleurs de l'art. 133 al. 2 COCC.

par M^e J.D.E., Huissier de justice à Dakar. Quid du reste du stock?

La cour a estimé qu'elle "ne pouvait ordonner la destruction des produits contrefaisants faute de pouvoir les identifier actuellement, donc les dénombrer". Une telle approche ne garantit pas le droit exclusif attaché à la marque. Cela signifierait que même si l'existence de produits contrefaisants ne fait l'objet d'aucun doute, le juge n'ordonne pas la destruction s'il ne peut les identifier et les dénombrer. En l'espèce, le juge constate que "le stock de produits demeure dans les entrepôts des sociétés responsables". Dès lors, ordonner leur saisie en vue de leur destruction nous semblait plus adéquat pour réparer le préjudice subi par la victime car il n'est point garanti qu'il sera mis fin à la circulation du produit contrefaisant.

À côté de la destruction, l'insertion de l'extrait de l'arrêt dans les quotidiens "WALFADJIRI" et "le Soleil" a été ordonnée sur le fondement de l'article 43, alinéa 2, de l'annexe III de l'accord du 2 mars 1977¹³⁵. Cette mesure de publicité est assez dissuasive en ce qu'elle permet d'informer les consommateurs sur le comportement frauduleux du contrefacteur. Par contre, même si elle est autorisée, la publicité ne doit pas être réalisée d'une manière telle qu'elle puisse amener les tiers à se tromper sur ses motifs ou sa portée¹³⁶.

Pour une efficacité des mesures ordonnées, le juge a mis les charges de la destruction et de la publication aux frais des sociétés BA...IMPORT-EXPORT et FOUR... Ainsi, la victime peut directement procéder à ces mesures et poursuivre le remboursement des frais sur présentation de factures dûment établies, accompagnées de la décision de condamnation.

Malick Lamotte

I. Saisie-contrefaçon – Nullité de plein droit – Immutabilité du cadre du procès – Préjudice né de la saisie – Appréciation du juge – Recherche de la mauvaise foi – Réparation – Demande reconventionnelle relative à la propriété de la marque – Recevabilité

Aux termes de l'article 52 de l'annexe III de l'Accord de Bangui Révisé, Acte de Bamako du 14 décembre 2015, s'il est fait droit à la requête en saisie-contrefaçon de marque, le demandeur doit obligatoirement saisir la juridiction de fond soit par la voie civile, soit par la voie correctionnelle dans le délai de 10 jours ouvrables, faute de quoi la description ou la saisie pratiquée est nulle de

¹³⁵ Devenu l'art. 55 al. 2 de l'ABR-2015.

¹³⁶ En ce sens, la Cour de cassation française a rappelé que "publier sur son site internet une décision de justice qui vous donne raison peut constituer un acte de concurrence déloyale, lorsque la victime a abusé de son droit de communiquer, dans la mesure où elle a omis certains éléments modifiant ainsi l'appréciation que les tiers pouvaient porter sur la décision." Cass. civ., Chambre commerciale, 18 octobre 2017, n° 15-27136.

plein droit sans préjudice des dommages et intérêts qui peuvent être réclamés.

Dès lors, le juge saisi d'une demande de nullité de plein droit de la saisie-contrefaçon de marque de dommages et intérêts, sur le fondement de l'article 52 précité n'a pas à apprécier la question de la propriété de la marque ni à rechercher la bonne ou mauvaise foi du saisi.

Cour d'appel de Lomé, Arrêt n° 70/15 du 4 mars 2015, GNANHOUE NAZAIRE c. ÉTABLISSEMENTS SOLA

Observations :

Aux termes de l'article 6 de l'annexe III de l'Accord de Bangui, Acte de Bamako du 14 décembre 2015, l'enregistrement de la marque confère au titulaire le droit de propriété sur cette marque pour les produits et services qu'il a désignés. Le propriétaire de la marque dispose donc sur celle-ci du droit exclusif de l'utiliser et d'en interdire l'exploitation. Ainsi, lorsqu'il estime que sa marque a été utilisée sans son autorisation ou enregistrée ultérieurement par une autre personne, il se garde le droit de saisir le juge d'une action en contrefaçon ou en annulation. Pour préparer cette instance au fond, il peut être autorisé par le président de la juridiction compétente, sur le fondement de l'article 51 de l'annexe III de l'Acte de 2015 (ancien article 48 de l'Accord de Bangui révisé du 24 février 1999), à pratiquer une saisie-contrefaçon sur les prétendus produits à charge de saisir au fond la juridiction civile ou correctionnelle dans un délai de dix (10) jours conformément à l'article 52 de l'annexe III de l'Acte de 2015 (ancien article 49 de l'annexe III de l'Accord de Bangui révisé). En cas de manquement à cette obligation, la saisie-contrefaçon est nulle de plein droit et le saisi pourra, à titre reconventionnel, réclamer des dommages et intérêts en guise de réparation. La cour d'appel de Lomé a fait application de ses principes dans le cas de l'espèce.

Faits : Le 2 janvier 2009, les Établissements SOLA ont fait procéder à une saisie-contrefaçon des produits portant la marque "COOKZEN", commercialisés par le sieur GNANHOUE NAZAIRE, avant d'en donner volontairement mainlevée pour en refaire d'autres.

Par exploit du 27 janvier 2009, le sieur GNANHOUE, estimant que les saisissants n'avaient pas respecté le délai de 10 jours prévu par l'article 49 de l'annexe III de l'ABR-1999¹³⁷ pour assigner au fond, a saisi le tribunal de première instance (TPI) de Lomé, sur le fondement des articles 48 et 49 de l'ABR-1999, de demandes d'annulation de plein droit de la saisie-contrefaçon ainsi pratiquée par les Établissements SOLA, et de réparation du préjudice subi.

Suivant jugement n° 3503/09, rendu le 13 novembre 2009, le TPI de Lomé a débouté le sieur GNANHOUE de l'ensemble de ses demandes avant d'annuler la marque "COOKZEN" dont il se prévalait au motif, d'une part, qu'il n'y a aucune décision préalable constatant cette nullité et, d'autre part, que la marque litigieuse appartenait aux Établissements SOLA qui l'avaient fait enregistrer

¹³⁷ Devenu l'art. 52 de l'annexe III de l'ABR-2015.

le premier auprès de l'Organisation africaine de la propriété intellectuelle (OAPI). Il l'a également condamné au paiement de dommages et intérêts, faisant droit ainsi à la demande reconventionnelle des Établissements SOLA qui prétendaient être propriétaires de la marque litigieuse pour l'avoir fait enregistrer le premier.

Par exploit du 15 février 2010, le sieur GNANHOUE a interjeté appel contre cette décision en faisant grief aux premiers d'avoir déplacé le problème juridique en statuant sur la question de propriété de la marque "COOKZEN" alors qu'il était saisi d'une demande de nullité de plein droit de la saisie-contrefaçon.

Raisonnement : La cour d'appel de Lomé, saisie de ces faits, a, par le présent arrêt, rendu le 4 mars 2015, infirmé le jugement querellé et, statuant à nouveau, annulé la saisie-contrefaçon litigieuse, alloué des dommages et intérêts au sieur GNANHOUE et débouté les Établissements SOLA de leurs demandes d'annulation de la marque de l'appelant et de dommages et intérêts.

La Cour a relevé que le juge d'instance avait l'obligation de constater la nullité de plein droit de la saisie-contrefaçon et d'en tirer les conséquences notamment en réparant le préjudice né de cette situation. Elle a ainsi répondu à la problématique qui lui était soumise, à savoir : quelle est l'étendue du pouvoir d'appréciation du juge, saisi sur le fondement de l'article 49 de l'annexe III de l'Accord de Bangui révisé¹³⁸, pour violation de l'obligation de saisir le juge du fond après une saisie-contrefaçon?

Il est dès lors important, au regard de l'argumentaire fort intéressant de la cour, d'examiner l'étendue de l'obligation pour l'auteur d'une saisie-contrefaçon de saisir le juge du fond dans le délai de 10 jours, sous peine de nullité de plein droit de la saisie-contrefaçon pratiquée (section I) mais également l'obligation pour le juge de réparer le préjudice résultant d'une saisie déclarée nulle de plein droit (section II).

I. L'obligation de saisir le juge du fond dans les délais légaux après une saisie-contrefaçon

La cour d'appel de Lomé, contrairement aux premiers juges, considère que les Établissements SOLA n'ont pas respecté l'obligation d'assigner au fond dans le délai de 10 jours après la saisie faite suivant procès-verbal du 2 janvier 2009. Elle a ainsi fait application des dispositions de l'article 49 de l'ABR-1999¹³⁹ selon lesquelles le demandeur, qui a fait pratiquer une saisie-contrefaçon, est tenu de se pourvoir, soit par la voie civile, soit par la voie correctionnelle, dans le délai de 10 jours ouvrables sous peine de nullité de plein droit de la description ou de la saisie.

Les dispositions de l'article 49 de l'annexe III de l'ABR-1999¹⁴⁰ visent donc à assurer la protection du saisi contre

d'éventuels abus dans la mise en œuvre de la saisie-contrefaçon, en exigeant du saisissant qu'il introduise une action au fond dans un très bref délai de 10 jours. Cette sévérité de l'ABR-1999 se comprend aisément dans la mesure où la saisie-contrefaçon ne se justifie que comme un préalable à l'action au fond en contrefaçon et il n'y aurait aucune justification à la recherche de la preuve d'une contrefaçon sans procès corrélatif¹⁴¹. En effet, la saisie-contrefaçon offre au saisissant des pouvoirs d'investigation étendus qui ne doivent être utilisés que pour les besoins d'une procédure et non à des fins d'intimidation. Pour cette raison, le saisi ne doit pas être laissé dans le doute. C'est pourquoi l'article 49 précité¹⁴² impose un très court délai pour agir. Il est dès lors important pour le juge saisi de bien vérifier le respect du délai. Se pose ainsi le problème de sa computation.

Il faut dire qu'en l'espèce, les juges d'appel n'ont eu aucune difficulté à constater le non-respect dudit délai, d'une part parce que les Établissements SOLA l'ont reconnu en donnant mainlevée de la saisie, pour échapper à une action en nullité et en réparation, et, d'autre part, du fait qu'il n'a été fait état d'aucune action au fond engagée par ceux-ci avant la présente procédure en nullité de plein droit de la saisie. Toutefois, la question de la computation du délai mérite d'être éclaircie dans la mesure où elle détermine en partie le sort de la saisie-contrefaçon. Ainsi, il est de principe que les points de référence pour apprécier si le requérant s'est bien pourvu dans le délai imparti sont la date de la saisie et la date de délivrance de l'assignation¹⁴³. Et la majorité de la jurisprudence et de la doctrine s'accordent à dire que seule la date de délivrance de l'assignation doit être prise en considération, la remise de l'assignation au greffe pouvant intervenir ultérieurement¹⁴⁴.

Par ailleurs, lorsque le requérant choisit la voie correctionnelle, seule la saisine de la juridiction de jugement notamment par une citation directe, par elle servie, est prise en considération. Ainsi, une simple plainte n'est pas suffisante pour justifier le respect de l'obligation de saisir la juridiction de fond¹⁴⁵. Quid ainsi de la plainte avec constitution de partie civile? Certes, elle est adressée au juge d'instruction mais elle a la vertu de déclencher l'action publique, contrairement à la plainte simple, même si elle n'entraîne pas la saisine de la juridiction de jugement. Dès lors, elle doit être admise comme conforme à l'esprit de l'article 48 de l'ABR-1999¹⁴⁶.

138 *Ibid.*

139 *Ibid.*

140 *Ibid.*

141 La saisie-contrefaçon, mesure exorbitante de droit commun, est destinée à rapporter la preuve de la contrefaçon présumée. Elle a donc pour objet de recueillir des éléments matériels de nature à établir l'existence des faits de contrefaçon allégués. Il s'agit de se préconstituer une preuve en vue d'un futur procès. Voir VÉRON (P.), *Saisie-contrefaçon*, 2^e éd., Paris (Daloz), 2005, p. 61, n° 13.251; NINO MEZATIO (U.), *La saisie-contrefaçon en matière de marque et de brevet dans l'espace OAPI*, 2017. Disponible en ligne à l'adresse <https://cabinetjogo.com/la-saisie-contrefaçon-en-matière-de-marque-et-de-brevet-dans-l'espace-oapi>.

142 Art. 52 de l'annexe III de l'ABR-2015.

143 Cass. com., 7 juillet 2015, n° 14-12.733; CA Paris, 4^e chambre, section B, 15 décembre 2006 : PIBD 2007, III, n° 847, p. 183.

144 TGI Paris, 27 mai 1994 : PIBD 1994, III, n° 573, p. 459; TGI Rouen, 27 février 1997 : PIBD 1997, III, n° 631, p. 246; CA Paris, 26 mai 1994 : PIBD 1994, III, n° 574, p. 487.

145 Voir VÉRON (P.) et ROMET (I.), *Droit et Pratique des voies d'exécution* 2015/2016, Paris (Daloz), 2015, chapitre 1214.

146 Art. 51 de l'annexe III de l'ABR-2015.

La Cour s'est soumise à ce travail de computation du délai en relevant que "l'intimé a pratiqué la saisie-contrefaçon le 2 janvier 2009; qu'il disposait ainsi d'un délai de dix jours ouvrables à compter de cette date pour intenter l'action en contrefaçon relativement aux produits présumés contrefaisants" avant de constater "qu'il n'a toutefois pas intenté cette action à la date du 27 janvier 2009 où l'appelant a saisi le premier juge". Elle en conclut, en application de l'article 49 de l'annexe III de l'ABR-1999, "que la saisie-contrefaçon par lui pratiquée est donc nulle de plein droit".

Le texte de l'article 49 de l'annexe de l'ABR-1999, visé par la Cour, sanctionne effectivement par la nullité de plein droit la description ou la saisie pratiquée sur le fondement de l'article 48 du même texte si le saisissant, qui se plaint d'être victime de contrefaçon de marque, n'engage pas une procédure au fond dans le délai de dix (10) jours. Cette nullité de plein droit implique que le juge saisi n'a pas à apprécier l'opportunité de la prononcer. Il doit, en effet, se limiter à vérifier le respect du délai légal et, lorsque le manquement est établi, prononcer la nullité. La Cour rappelle ainsi au juge d'instance qu'il devait constater cette nullité dès lors qu'il a relevé que l'appelant était resté plus de dix (10) jours sans saisir une juridiction de fond notamment entre le 2 janvier 2009, date de la saisie-contrefaçon, et le 27 janvier 2009, date de l'introduction de l'instance en nullité de la saisie.

Elle a également précisé, confirmant sur ce point le juge d'instance, que le fait pour l'intimé d'avoir procédé à la mainlevée volontaire de cette saisie-contrefaçon est sans incidence sur l'obligation du juge de constater la nullité de plein droit, lorsque les conditions visées à l'article 49 susvisé sont réunies. La cour affirme d'ailleurs, à bon droit, que le juge d'instance ne peut, sans risque d'ajouter aux dispositions de l'article 49 de l'annexe III de l'ABR-1999, subordonner l'examen de cette demande de nullité à une décision préalable d'un autre juge.

Elle lui reproche également d'être entré dans des discussions relatives à la propriété de la marque. Comme elle le rappelle, le juge saisi d'une requête aux fins de saisie-contrefaçon procède juste à une vérification formelle de la titularité de la marque et de la supposée atteinte portée à celle-ci¹⁴⁷.

À ce niveau, la question du pouvoir d'appréciation du juge mérite d'être relevée. En effet, lorsque la preuve de l'enregistrement de la marque ainsi que celle de la non-radiation et de la non-déchéance sont rapportées, le juge n'a pas de pouvoir d'appréciation lorsqu'il s'agit d'une saisie descriptive¹⁴⁸. Cette position est motivée par le souci de sauvegarder les droits du prétendu titulaire de la marque mais aussi par le fait que la saisie descriptive n'implique pas dépossession des produits supposés contrefaisants. Toutefois, lorsqu'il s'agit d'une saisie

réelle, le juge doit retrouver tout son pouvoir souverain d'appréciation dans la mesure où cette saisie emporte dépossession et emprise sur les biens présumés contrefaisants¹⁴⁹. En ce sens, l'existence d'une action en réparation peut ne pas suffire pour préserver les intérêts du présumé contrefacteur si tant est que la contrefaçon n'est pas ultérieurement établie.

Il est important de s'interroger, en outre, sur la position du tribunal, confirmée en cela par la cour qui considère que la mainlevée de la saisie-contrefaçon, faite par le saisissant, est sans effet sur le maintien de la demande de nullité de celle-ci. Quel est l'intérêt de se prononcer sur une saisie qui n'existe plus de fait?

La saisie des produits supposés contrefaisants, pratiquée en application de l'article 48 de l'ABR-1999, rend indisponible celles-ci et prive par conséquent le saisi du droit de les commercialiser. Dès lors, la mainlevée, faite d'office par le saisissant, met fin à cette indisponibilité comme l'annulation de la saisie prononcée par le juge; le saisi retrouvant le droit de disposer de ses produits et le saisissant perdant ainsi tout moyen de présenter des échantillons au tribunal ou d'obtenir la confiscation à son profit des produits saisis. Dans ces circonstances, on voit difficilement l'intérêt de se prononcer sur une saisie qui n'existe plus. En faisant le parallèle avec la saisie conservatoire ou la saisie vente de biens¹⁵⁰, la demande d'annulation de la saisie réelle pouvait être déclarée sans objet. Néanmoins, si la mainlevée volontaire a été donnée après immobilisation des marchandises durant un certain nombre de jours, l'intérêt de saisir le juge en vue de déclarer cette saisie nulle, malgré la mainlevée volontaire, peut être justifié par la perspective de réclamer des dommages et intérêts.

Après avoir relevé que la saisie-contrefaçon pratiquée par l'appelant était nulle au motif que l'obligation mise à sa charge par l'article 49 de l'annexe III ABR-1999 n'a pas été remplie, la cour d'appel a statué sur la question de la réparation du préjudice né de cette annulation.

II. L'obligation de réparer le préjudice résultant de la nullité de plein droit de la saisie-contrefaçon

En vertu de l'article 49 de l'annexe III ABR-1999, le présumé contrefacteur peut réclamer des dommages et intérêts si, nonobstant la saisie-contrefaçon qui a été pratiquée sur ses biens, le bénéficiaire de celle-ci est resté plus de dix (10) jours sans saisir au fond la juridiction civile ou correctionnelle. Le législateur OAPI s'est limité sur le principe sans pour autant définir

147 Art. 48 al. 2 de l'annexe III de l'ABR-1999, et art. 51 de l'annexe de l'ABR-2015 : "L'ordonnance est rendue sur simple requête et sur justification de l'enregistrement de la marque et production de la preuve de non-radiation et de non-déchéance."

148 CA Aix-en-Provence, 1^{er} décembre 1976 : PIBD 1977, n° 186, p. 63; TGI de Paris, 3^e chambre, 3^e section, 8 février 2013, RG n° 10/14491.

149 Voir en ce sens GREFFE (F.), Contrefaçon-Constataion-Saisie-contrefaçon, in : Juriscl. Marques-Dessins et modèles, Fasc. 3470, 2005, n° 11; STENGER (J.-P.), Saisie-contrefaçon – Introduction. Ordonnance autorisant la saisie-contrefaçon, in : Juriscl. Brevets, Fasc. 4631, 2003, n° 61 (le juge n'aurait pas le choix quant à l'autorisation de la saisie-contrefaçon, fût-elle réelle).

150 Ces saisies sont faites sur le fondement des dispositions des art. 54 et s. et art. 90 et s. de l'Acte uniforme sur les procédures simplifiées de recouvrement et les voies d'exécution adopté le 10 avril 1999 et paru au JO OHADA n° 6 du 1^{er} juillet 1998. Voir Tribunal régional de Niamey, Ordonnance de référé n° 124 du 20 juillet 2004, *Société Europress-Editores e distribuidores de publicacoes Lda c. Compagnie Beauchemin International Inc.* (obs. FOMETEU (J.), ce recueil, chapitre 1, section C).

le régime de cette responsabilité. Toutefois, on peut affirmer, au regard de la rédaction de l'article 49 susvisé, qu'il ne s'agit pas d'une responsabilité automatique car l'annulation de la saisie-contrefaçon n'emporte pas automatiquement l'allocation de dommages et intérêts. De ce fait, il nous semble qu'il faille retourner vers le régime général de la responsabilité civile qui suppose une faute, un dommage et un lien de causalité suivant la formule de l'article 1382 du Code civil français "tout fait quelconque de l'homme qui cause un à autrui un dommage oblige celui par la faute duquel il est arrivé à le réparer"¹⁵¹.

Sous ce rapport l'on peut dire que l'article 49 précité n'exclut pas l'idée d'une responsabilité pour procédure abusive. En adoptant la formulation "(...) sans préjudice des dommages et intérêts qui peuvent être réclamés, s'il y a lieu", cette disposition n'énumère pas les fondements de cette réparation. Dès lors, l'action en réparation résultant de l'annulation de la saisie-contrefaçon peut se fonder sur le caractère abusif de cette procédure¹⁵², notamment en cas de saisie de tout le stock en lieu et place de quelques échantillons comme en l'espèce. D'ailleurs, la Cour l'a bien retenu en affirmant que "l'immobilisation au-delà du délai légal d'une cargaison des marchandises présumées contrefaisantes par l'exercice d'une prérogative exorbitante de droit commun destinée à se constituer une preuve en vue d'une procédure future crée sans nul doute un préjudice certain au propriétaire desdites marchandises". En ce sens, les intimés ne pouvaient se fonder sur leur bonne foi ou bien sur une prétendue mauvaise foi de l'appelant pour soutenir le rejet de sa demande en réparation alors qu'il n'est pas discuté que la saisie-contrefaçon a été annulée de plein droit du fait de leur manquement notamment le défaut de saisine du juge du fond dans le délai légal.

En définitive, c'est fort logiquement que la cour n'a pas recherché une intention de nuire dès lors que c'est le maintien de la saisie sans l'engagement d'une procédure dans le délai requis qui est sanctionné par le texte.

La question de la mauvaise foi du saisi ne peut aussi, comme l'a justement révélée la cour, être discutée au stade de la saisie-contrefaçon dans la mesure où cette procédure ne vise pas à trancher le litige sur la contrefaçon mais à se préconstituer des éléments de preuve de la contrefaçon. En ce sens, la cour a opportunément circonscrit le débat relatif à la demande de réparation qui n'est, en effet, fondée que sur la faute de l'appelant caractérisée par la nullité de plein droit de la saisie-contrefaçon pratiquée par les intimés. C'est forte de cela qu'elle a accueilli la demande de dommages et intérêts de l'appelant pour y faire droit en lui allouant la somme raisonnable de vingt millions (20 000 000) de

francs CFA après avoir écarté les moyens relatifs à la bonne ou mauvaise foi¹⁵³.

Après avoir infirmé le jugement et admis l'action en réparation fondée sur la nullité de la saisie-contrefaçon, la cour d'appel a rejeté la demande reconventionnelle en revendication de la propriété de la marque "COOKZEN", faite par les Établissements SOLA, pour absence de preuve de la qualité de propriétaire de la marque.

Si l'on s'en tient aux effets de la décision de la cour, sa solution peut être partagée. Elle s'inscrit dans la logique du droit des marques qui veut que le droit d'interdire l'utilisation d'une marque ne soit réservé qu'aux seuls titulaires de droits sur celle-ci car c'est le droit privatif qui est protégé en cette matière¹⁵⁴. Ainsi, en relevant, à partir des éléments de preuve produits aux débats, la radiation de l'enregistrement de la marque "COOKZEN", fait par les Établissements SOLA, "à la demande de la société HANGZOU RICHLAND FOODS CO.LTD, société chinoise qui a déposé la marque en premier", la cour ne pouvait reconnaître aux Établissements SOLA un quelconque droit sur ladite marque. Dès lors, c'est à bon droit qu'elle a rejeté leur demande reconventionnelle.

Malick Lamotte

J. Saisie-contrefaçon – Saisie pratiquée à l'enquête – Ordonnance présidentielle préalable – Validité de la saisie – Nullité du procès-verbal d'enquête

Si la saisie-contrefaçon relève de la compétence du président du tribunal civil, aux termes de l'article 48 de l'annexe III de l'ABR-1999 (cf. article 51, ABR-2015), il reste que ce texte n'exclut pas les pouvoirs reconnus par les législations nationales, en matière pénale, aux officiers de police judiciaire et aux juges d'instruction qui peuvent ordonner, dans le cadre d'une procédure correctionnelle, la saisie des produits supposés contrefaisants.

Dès lors, fait une mauvaise application des articles 47 et 48 de l'annexe III de l'Accord de Bangui révisé (v. articles 49 et 51 de l'annexe III de l'ABR-1015) le tribunal correctionnel qui annule la procédure engagée par le Procureur de la République contre un prévenu pour le délit d'importation et mise en vente des produits contrefaisants au motif que la partie civile ne produit pas l'ordonnance autorisant la saisie-contrefaçon des produits incriminés alors qu'il s'agit d'une saisie pratiquée par les officiers de police judiciaire dans le cadre d'une enquête préliminaire.

151 Voir art. 119 COCC : "Est responsable celui qui par sa faute cause un dommage à autrui."

152 Cf. art. 122 COCC : "Commet une faute par abus de droit celui qui use de son droit dans la seule intention de nuire à autrui, ou qui en fait un usage contraire à sa destination."

153 Sur les modalités de réparation du préjudice, voir CA Brazzaville, Arrêt du 18 juillet 2006, *MP et Amandatou Adechokan c. Fati Younoussa and Salamatu Younoussa* (obs. LAMOTTE (M.), ce recueil, chapitre 3, section D).

154 Cf. art. 7 de l'annexe III de l'ABR-1999 devenu art. 6 de l'annexe III de l'ABR-2015.

Tribunal de première instance de Lomé, Jugement du 16 avril 2008, 1^{re} chambre correctionnelle, MP ET SOCIÉTÉ NESTLÉ SA c. LASSISSI Aminatou

Observations :

La saisie-contrefaçon n'est qu'un mode de preuve supplémentaire et souvent très efficace pour établir l'existence d'une contrefaçon. "Aucun texte, ni législatif, ni réglementaire, n'oblige à recourir à ce moyen de preuve particulier avant de saisir le juge du fond"¹⁵⁵. Dans le cas de l'espèce, le tribunal de première instance de Lomé semble avoir oublié ce principe.

Faits : La société Nestlé, propriétaire de la marque de produits Cubes MAGGI POULET, avait saisi le Procureur de la République du TPI de Lomé d'une plainte dirigée contre la dame LASSISSI Aminatou, pour vente ou mise en vente de Cubes MAGGI POULET contrefaisants. Sur la base de cette plainte, une saisie portant sur 1800 cartons des produits incriminés a été pratiquée entre les mains de la dame LASSISSI. C'est suite à cette saisie que celle-ci a été citée directement devant le tribunal correctionnel, siégeant en matière correctionnelle, pour le délit de vente ou mise en vente sur le territoire togolais de produits revêtus d'une marque frauduleusement imitée ou portant des indications propres à tromper l'acheteur sur la nature des produits.

Pour s'opposer à l'examen au fond de cette prévention, le conseil de la dame LASSISSI a soulevé, *in limine litis*, la nullité de la saisie, pour violation de l'article 48 de l'annexe III de l'ABR-1999 (article 51 de l'annexe III de l'ABR-2015), au motif qu'elle a été pratiquée sans autorisation préalable du président du tribunal de première instance qui doit être ordonnée par voie d'ordonnance à pied de requête.

Raisonnement : Le tribunal, faisant droit à cette exception de nullité, a

- annulé le procès-verbal d'enquête préliminaire établi le 22 octobre 2007 par l'Office central de répression du trafic illicite des drogues et du blanchiment n° 077/2007;
- invalidé le rapport d'enquête préliminaire n° 77/2007, émis le 22 octobre 2007, par l'Office central de lutte contre le trafic illicite de stupéfiants et le blanchiment d'argent;
- ordonné la restitution des objets saisis à Mme Lassissi et rejeté les accusations portées contre elle.

Ainsi, sur la question de savoir si la saisie réelle pratiquée en matière pénale, dans le cadre d'une procédure de contrefaçon de marque, était soumise à l'autorisation préalable du président de la juridiction compétente, le TPI de Lomé a répondu par l'affirmative. Il apparaît dès lors de cette décision que le TPI de Lomé considère que toutes les saisies susceptibles d'être pratiquées en matière de marque sont soumises à la formalité préalable de l'autorisation prévue par l'article 48 de l'annexe III de l'ABR-1999 (devenu l'article 51 de l'ABR-2015).

Cette position du TPI de Lomé procède d'une confusion sur le régime des saisies en matière de contrefaçon (section I), ce qui l'a conduit à faire de la validité de la saisie-contrefaçon une condition de régularité de l'action en contrefaçon devant le juge correctionnel (section II).

I. La confusion sur le régime des saisies en matière de contrefaçon de marque

Pour annuler la procédure pénale engagée contre la dame LASSISSI Aminatou, du chef de contrefaçon de marque, le tribunal a estimé que les parties poursuivantes n'ont pas produit au dossier de la procédure une ordonnance du président du tribunal civil compétent autorisant la saisie-contrefaçon conformément aux dispositions de l'article 48 de l'annexe III de l'ABR-1999 (devenu l'article 51 de l'ABR-2015). Il faut dire que l'article 48 susvisé dispose que

"le propriétaire d'une marque ou le titulaire d'un droit exclusif d'usage peut faire procéder, par tout huissier ou officier public ou ministériel y compris les douaniers avec, s'il y a lieu, l'assistance d'un expert, à la description détaillée, avec ou sans saisie, des produits ou services qu'il prétend marqués, livrés ou fournis à son préjudice en violation des dispositions de la présente annexe en vertu d'une ordonnance du président du tribunal civil dans le ressort duquel les opérations doivent être effectuées, y compris à la frontière".

Il ressort de cet article que la saisie-contrefaçon est une mesure probatoire permettant au titulaire d'un droit de propriété intellectuelle de faire procéder, par un officier public, à des investigations comprenant, en général, la description de la contrefaçon alléguée, de ses circonstances et de son étendue ainsi que, dans certains cas, la saisie avec ou sans appréhension matérielle d'échantillons des articles argués de contrefaçon, voire de tous ces articles. La cour d'appel de Dakar l'a bien rappelé dans l'affaire société AM S.A contre société MT S.A en indiquant que "cette saisie permet seulement à la victime d'une contrefaçon présumée d'apporter la preuve d'une atteinte à son droit"¹⁵⁶.

La description détaillée peut ainsi, sur le fondement de l'article 48 précité, être accompagnée d'une saisie réelle d'échantillons ou du produit supposé contrefaisant. Elle est ordonnée par le président du tribunal civil territorialement compétent, statuant par ordonnance sur requête. C'est donc sur le fondement de ce texte que la dame L. Aminatou a reproché à la partie civile, la société Nestlé SA, d'avoir fait procéder à une saisie-contrefaçon sans avoir, au préalable, obtenu une ordonnance du président du tribunal autorisant une telle mesure. Elle a ainsi considéré que la saisie des produits "cubes MAGGI POULET", pratiquée par les officiers de police judiciaire, sur saisine du Procureur de la République, viole les dispositions de l'article 48 de l'annexe III de l'ABR-1999 (devenu l'article 51, annexe III,

155 TGI de Strasbourg, 5 février 1991 : PIBD 1991, III, pp. 339 et s.

156 Voir CA Dakar, Arrêt n° 501 du 28 décembre 2012, *Ameropa SA c. Société Moustapha Tall SA* (obs. LAMOTTE (M.)), ce recueil, chapitre 3, section K).

de l'ABR-2015) qui donne seul pouvoir seulement au président du tribunal civil.

Le Procureur de la République pouvait-il alors ordonner la saisie par les officiers de police judiciaire des produits prétendus contrefaisants?

En réponse, il faut rappeler que lorsque l'action en contrefaçon est exercée suivant la voie pénale, le Procureur de la République, saisi d'une plainte de la victime ou d'une dénonciation¹⁵⁷, conserve les prérogatives classiques que lui confère le droit commun en matière de poursuite des infractions¹⁵⁸. À cet effet, il peut, dans le cadre d'une enquête de flagrance ou même d'une enquête préliminaire, "procéder ou faire procéder à tous les actes nécessaires à la recherche et la poursuite" de l'infraction de contrefaçon¹⁵⁹. Il peut également faire procéder par les officiers de police judiciaire à des saisies, à but probatoire ou de confiscation de l'objet de l'infraction de contrefaçon, c'est-à-dire le produit contrefaisant, des instruments ayant servi ou qui étaient destinés à la commission de la contrefaçon et enfin de tout ce qui paraît être le produit direct ou indirect de l'infraction de contrefaçon¹⁶⁰. Il faut signaler que le juge d'instruction, également, saisi d'un réquisitoire introductif du Procureur de la République ou d'une plainte avec constitution de partie civile du titulaire de la marque ou d'une licence, dispose des mêmes pouvoirs d'investigation et de saisie¹⁶¹. Ainsi, le tribunal correctionnel pourra ultérieurement, en vertu de l'article 47 de l'annexe III de l'ABR-1999 (devenu l'article 55 de l'annexe III de l'ABR-2015) ordonner, à titre de peine complémentaire, leur confiscation.

Toutes ces saisies, connues sous le vocal de saisie pénale¹⁶², parce que spécifiques à la procédure pénale, peuvent être pratiquées sans autorisation du président du tribunal. Leur validité ne saurait aucunement dépendre d'une quelconque ordonnance prise par celui-ci en vertu de l'article 48 de l'annexe III de l'ABR-1999¹⁶³.

Dès lors, c'est à tort que le tribunal a fait droit à l'exception de nullité soulevée par le conseil L. Aminatou au motif que la société Nestlé SA ne produit pas aux débats l'ordonnance présidentielle autorisant la saisie réelle des cartons de "cubes MAGGI POULET", pratiquée par les officiers de police judiciaire, dans le cadre d'une enquête préliminaire ouverte sur instruction du Procureur de la République.

Le tribunal aurait dû relever la confusion faite entre la saisie-contrefaçon, qui requiert une ordonnance du président du tribunal civil compétent en vertu de l'article 48 de l'annexe III de l'ABR-1999¹⁶⁴, et la saisie

pratiquée en matière pénale suivant les dispositions du code de procédure pénale togolais qui donnent ce pouvoir aux officiers de police judiciaires, au Procureur de la République et au juge d'instruction agissant dans le cadre d'une enquête ou d'une information judiciaire ouverte pour le délit de contrefaçon de marque.

Le tribunal devait, par conséquent, rejeter cette exception de nullité.

Malheureusement, il a suivi la prévenue en annulant toute la procédure notamment le procès-verbal d'enquête préliminaire établi le 22 octobre 2007 par l'Office central de répression du trafic illicite des drogues et du blanchiment n° 077/2007, et en ordonnant la restitution des 1800 cartons de "cubes MAGGI POULET" saisis au profit de L. Aminatou.

Il apparaît donc clairement de ce qui précède que cette décision procède d'une application inappropriée des dispositions de l'article 48 de l'annexe III de l'ABR-1999¹⁶⁵.

II. La violation des conditions de recevabilité de l'action pénale en contrefaçon

Le TPI de Lomé a annulé la procédure pénale engagée contre la dame L. Aminatou pour contrefaçon par importation et mise en vente de produits contrefaisants pour défaut de production d'une ordonnance du président du tribunal civil. Il faut dire que la juridiction d'instance, suivant la prévenue qui avait soulevé la nullité de la procédure pour violation des dispositions de l'article 48 de l'annexe III de l'ABR-1999, est allée plus loin que celle-ci en affirmant "qu'aucune ordonnance du président du tribunal de céans n'étant versée aux débats par le conseil de la partie civile, il y aura lieu de constater purement et simplement la nullité de la procédure antérieure pour violation de l'article 48 de l'Accord de Bangui et tirer les conséquences qui s'imposent sur la base de l'article 265 du Code de procédure pénale".

Le tribunal fait ainsi de la validité de la saisie, pratiquée au stade de l'enquête pénale, une condition de régularité du procès-verbal d'enquête et de la procédure antérieure à la saisine du tribunal, ce qui a eu pour conséquence de mettre fin à la procédure sans examen de la prévention de contrefaçon et le renvoi du ministère public, qui avait initié la poursuite, à mieux se pourvoir. Il semble ainsi ignorer que, même sous le régime de l'article 48 de l'annexe III de l'ABR-1999, la saisie-contrefaçon n'est qu'un mode de preuve du délit de contrefaçon. Dès lors, sa nullité ne peut, en aucun cas, entamer l'action publique ni la régularité de la procédure engagée par le Procureur de la République pour le délit de contrefaçon de marque. Celui-ci se trouve juste dépourvu d'un moyen de preuve pertinent de la contrefaçon. Il garde toutefois la possibilité de présenter d'autres preuves pour établir l'existence de la contrefaçon. La Cour de cassation française le rappelle souvent en considérant que "le moyen de nullité d'une saisie-contrefaçon, laquelle est un acte probatoire antérieur à la procédure de contrefaçon

157 Voir à ce sujet l'art. 32 du CPP du Togo. Idem pour le Sénégal.

158 Art. 31 à 36 du CPP du Togo, art. 31 à 38 du CPP du Sénégal. Voir à ce sujet PRADEL (J.) et LABORDE (J.P.), Du Ministère public en matière pénale : D. 1997, p. 141.

159 Art. 34 et 61 du CPP du Togo et art. 33, 60 et 67 du CPP du Sénégal.

160 Art. 44 CPP du Togo et art. 46 du CPP du Sénégal.

161 Art. 41 et 64 du CPP du Togo et art. 72 et 87 bis du CPP du Sénégal.

162 PRADEL (J.), Procédure pénale, n.70, p. 390.

163 Devenu l'art. 51 de l'annexe III de l'ABR-2015.

164 *Ibid.*

165 *Ibid.*

qui n'est introduite que par la demande en contrefaçon, ne constitue pas une exception de procédure¹⁶⁶.

Ainsi comprise, la non-production de l'ordonnance du président autorisant la saisie ou même la nullité de cette saisie, contrairement à la position du tribunal, ne peut affecter la régularité de la procédure. Dès lors, comment comprendre la décision du tribunal? Sur quel fondement a-t-il prononcé la nullité de la procédure? Pourquoi l'avoir étendue à toute la procédure? Autant de questions qui sont restées sans réponse à la lecture de ce jugement. En effet, le tribunal n'indique aucun fondement à la nullité prononcée. Sa difficulté sur ce point est bien compréhensible dans la mesure où les articles 37 et 47 de l'annexe III de l'ABR-1999 (devenus respectivement les articles 57 et 49 de l'ABR-2015), sièges de l'action en contrefaçon, ne comportent aucune sanction relative à la régularité de la procédure. Ils sont d'ailleurs très sommaires sur les conditions d'exercice de l'action pénale en contrefaçon¹⁶⁷, laissant ainsi au juge national le soin de faire application des procédures de droit commun.

La nullité de la procédure prononcée par le tribunal ne pouvait alors avoir pour fondement les dispositions de l'annexe III de l'ABR-1999. Cela se comprend aisément dans la mesure où l'Acte de 2015 de l'Accord de Bangui s'intéresse aux différents droits de propriété intellectuelle et à leur protection administrative et judiciaire. À ce titre, ils n'ont pas vocation à régler les principes de procédure pénale qui demeurent de la souveraineté des États parties à l'accord. Ils ne réglementent, dans le domaine pénal, que les incriminations et les sanctions relatives aux atteintes aux droits de propriété intellectuelle. Du reste, les juges de première instance n'ont invoqué aucune disposition de procédure pénale togolaise pouvant justifier la nullité de la procédure. Dès lors, cette nullité n'a aucun fondement textuel.

Il faut rappeler qu'en matière pénale, la nullité d'un acte de procédure et l'étendue de cette nullité doivent en principe être prévues par la loi¹⁶⁸. Il n'en est autrement qu'en cas de violation de dispositions substantielles relatives à la procédure pénale¹⁶⁹. Le tribunal n'a fait état d'aucune disposition substantielle de procédure pénale togolaise violée par le Procureur de la République qui a exercé la procédure de contrefaçon. Il ne pouvait dès lors prononcer l'annulation du procès-verbal d'enquête et ainsi mettre fin à la procédure sans examiner au fond la prévention de contrefaçon de marque. Le tribunal avait ainsi l'obligation de se prononcer sur la culpabilité de la prévenue L. Aminatou. Il a malheureusement raté l'occasion de le faire. La carence relevée à l'égard de la partie civile, relativement à l'irrégularité de la saisie qu'elle a fait pratiquer, même à la supposer fondée, ne pouvait aucunement remettre en cause la citation directe initiée par le Procureur de la République. Ce problème, comme déjà indiqué, concerne le fond du

droit, c'est-à-dire la culpabilité de la personne poursuivie et le bien-fondé de la demande de réparation du dommage. Pour dire que l'exercice par le Procureur de la République de l'action pénale en contrefaçon ne pouvait être entravée par ce moyen, celui-ci dispose d'un droit d'agir autonome. En effet, contrairement à l'action pénale en contrefaçon de brevet, de modèle d'utilité ou de dessins et modèles industriels¹⁷⁰, le déclenchement de l'action publique en matière de contrefaçon de marque n'est soumis à aucune plainte préalable de la victime¹⁷¹.

En définitive, le jugement du TPI de Lomé n'est pas un bon exemple pour les juges du fond de l'espace OAPI qui ont pour rôle de veiller à la protection légitime des droits de propriété intellectuelle réglementés par l'Acte de Bamako de 2015 et ses différentes annexes.

Malick Lamotte

K. Marques – Risque de confusion – Saisie réelle des marchandises arguées de contrefaçon – Cantonnement à quelques échantillons

La saisie-contrefaçon est juste un moyen de preuve spécifique de la contrefaçon. Elle n'a pas pour finalité de sanctionner le supposé contrefacteur. Dès lors, elle ne peut avoir une portée générale permettant au requérant de poursuivre et de saisir en tout temps et en tout lieu des produits supposés contrefaisants.

Par ailleurs, le juge saisi de la demande de rétractation ne peut discuter du bienfondé de la contrefaçon.

Cour d'appel de Dakar. Arrêt n° 501 du 28 décembre 2012, SOCIÉTÉ AMEROPA SA c. SOCIÉTÉ MOUSTAPHA TALL

Observations :

La saisie-contrefaçon est un moyen de preuve de la contrefaçon et, plus généralement, de toute atteinte à un droit de propriété intellectuelle. C'est une procédure qui permet, sur autorisation du président du tribunal civil, au titulaire du droit de propriété intellectuelle de faire constater par un huissier de justice ou un officier public une contrefaçon. S'il est fait droit à la requête ou à la requête d'appel, tout intéressé peut en référer au président qui a rendu l'ordonnance dans les conditions prévues par le droit national¹⁷². Saisi de cette contestation, le juge a la faculté de modifier ou de rétracter l'ordonnance même si les juges du fond sont saisis de l'affaire. L'instance de contestation de la saisie-contrefaçon a pour finalité de réapprécier le bienfondé de la requête au regard, cette fois-ci, des éléments de défense présentés par le supposé contrefacteur. Cette instance n'a donc pas pour objet d'apprécier l'existence de contrefaçon que la saisie-contrefaçon a pour but de

166 Cass. civ., 19 janvier 2010, n° 2008-370800.

167 Voir art. 47 al. 2 de l'annexe III de l'ABR-1999 et art. 6 al. 2 de l'annexe III de l'ABR-2015.

168 Voir art. 164 et 168 du CPP du Sénégal.

169 Art. 166 du CPP du Sénégal.

170 Art. 61 de l'annexe I, art. 44 de l'annexe II et art. 30 de l'annexe IV de l'ABR-1999 : "L'action correctionnelle pour l'application des peines ci-dessus ne peut être exercée par le ministère public que sur la plainte de la partie lésée."

171 Art. 46 de l'annexe III de l'ABR-2015.

172 Voir art. 820-8 et 820-9 du Code de procédure civile sénégalais.

prouver. La cour d'appel de Dakar a rappelé ces principes dans le cas de l'espèce.

Faits : La société Moustapha TALL SA, s'estimant propriétaire de la marque "le bon cheval légendaire + logo", déposée le 30 décembre 2008 et enregistrée le 17 août 2009 sous le numéro 60828, auprès de l'Organisation africaine de la propriété intellectuelle (OAPI), avait saisi le président d'une requête aux fins de saisie-contrefaçon d'un lot de riz contenu dans des sacs de couleur verte portant la marque "le cheval logo" ressemblant à la sienne, qui était réceptionné par la société AMEROPA et entreposé dans un magasin sous douane de la SONAFOR.

Par ordonnances n° 929 /2012 et n° 1000/2012 du 22 juin 2012 du président du tribunal régional hors classe de Dakar¹⁷³, elle a obtenu l'autorisation de faire procéder, respectivement, à la description détaillée des produits prétendus contrefaisants et à la saisie réelle dans les locaux de la SONAFOR et de tous commerçants sis dans le ressort du tribunal régional ou en tout autre lieu, de tous les produits comportant des éléments caractéristiques de sa marque et destinés à la vente par la société AMEROPA.

En application des dispositions de l'article 49 susvisé¹⁷⁴, elle a assigné la société AMEROPA à comparaître le 19 juillet 2012 devant le tribunal régional hors classe de Dakar pour constater que les sacs de riz réceptionnés sont contrefaits, ordonner leur destruction ou à défaut interdire leur commercialisation ou ordonner leur retrait du commerce si celle-ci a débuté.

Par exploit en date du 10 juillet 2012, la société AMEROPA SA a assigné à bref délai la société MOUSTAPHA TALL SA devant le président du tribunal régional hors classe de Dakar pour entendre ordonner la rétractation de l'ordonnance n° 1000/2012 du 22 juin 2012 et le cantonnement de la saisie à quelques échantillons. Mais celui-ci a, par ordonnance du 22 juin 2012, rejeté la demande de rétractation et confirmé la mesure de description avec saisie de tous produits supposés contrefaisants.

C'est cette ordonnance qui a été soumise à la censure de la cour d'appel de Dakar par la société AMEROPA qui faisait valoir, entre autres moyens, que le juge des requêtes ne pouvait ordonner la saisie de tout le stock de produit lui appartenant. Elle discutait également l'absence de risque de confusion entre les produits qu'elle commercialisait et ceux appartenant à l'intimé.

La Cour devait ainsi répondre à deux questions :

- a. Le juge des requêtes pouvait-il ordonner, sur le fondement de l'article 48 de l'annexe III de l'ABR-1999¹⁷⁵, la saisie réelle de tout le stock des produits supposés contrefaisants?

- b. Pouvait-il également apprécier la question de la propriété de la marque et l'existence de la contrefaçon alléguée dans le cadre de l'instance en rétractation de son ordonnance autorisant la saisie-contrefaçon?

Raisonnement : En réponse, la cour affirme d'une part que la saisie-contrefaçon, qui a une finalité probatoire, ne peut emporter la saisie de tout le stock prétendu contrefaisant, d'autre part, que l'instance en rétractation de l'ordonnance de saisie-contrefaçon n'est pas une instance au fond où on peut discuter du bienfondé de la contrefaçon. Il apparaît que

- I. la saisie-contrefaçon n'est en réalité qu'un moyen spécifique de preuve de la contrefaçon;
- II. dès lors, le juge qui ordonne la description détaillée avec saisie réelle doit déterminer l'étendue de cette saisie.

I. La saisie-description comme moyen spécifique de preuve de la contrefaçon

Dans ses motifs décisifs, la cour affirme que la saisie-description pratiquée par la société MT a uniquement une valeur probatoire. Par conséquent, l'instance en rétractation, engagée par la société AM contre l'ordonnance prescrivant cette saisie, ne peut avoir pour objet de discuter du bienfondé de la contrefaçon.

Ainsi, pour confirmer l'ordonnance querellée, la cour explique que la saisie-description, pratiquée par la société MT, "permet seulement à la victime d'une contrefaçon présumée d'apporter la preuve d'une atteinte à son droit". Cette affirmation de la cour est pertinente; elle découle, comme elle le rappelle, des dispositions pertinentes de l'article 48 de l'annexe III de l'Accord de Bangui révisé¹⁷⁶, selon lesquelles :

"Le propriétaire d'une marque ou le titulaire d'un droit exclusif d'usage peut faire procéder, par tout huissier ou officier public ou ministériel y compris les douaniers avec, s'il y a lieu, l'assistance d'un expert, à la description détaillée, avec ou sans saisie, des produits ou services qu'il prétend marqués, livrés ou fournis à son préjudice en violation des dispositions de la présente annexe en vertu d'une ordonnance du président du tribunal civil dans le ressort duquel les opérations doivent être effectuées, y compris à la frontière."

C'est donc un droit reconnu au titulaire de la marque de demander une mesure de saisie-description, communément appelée saisie-contrefaçon s'il estime qu'il y a une atteinte illégitime à son droit de propriété intellectuelle¹⁷⁷. Et le juge ne peut lui refuser cette mesure si les conditions légales sont réunies¹⁷⁸. La saisie-contrefaçon permet d'établir la matérialité

173 Devenu le TGI hors classe de Dakar depuis 2015.

174 Devenu l'art. 52 de l'annexe III de l'ABR-2015.

175 Devenu l'art. 51 de l'annexe III de l'ABR-2015.

176 Devenu l'art. 51 de l'ABR-2015.

177 En ce sens, voir également STENGER (J.-P.), Saisie-contrefaçon, Fasc. 4631, n° 147.

178 En ce sens, ROUBIER (P.), Le droit de la propriété industrielle, Vol. 1, Paris (Sirey), 1952, p. 426.

de la contrefaçon. Elle peut être définie comme "la mesure permettant au titulaire d'un droit de propriété intellectuelle de faire pratiquer par un officier public des investigations, comprenant, en général, la description de la contrefaçon alléguée, de ses circonstances et de son étendue"¹⁷⁹. Le terme saisi, selon Pierre Véron¹⁸⁰ serait même impropre car il s'agit plutôt d'une description qui consiste pour le requérant à faire une représentation aussi fidèle que possible du produit faisant l'objet de contrefaçon. Le produit reste, en principe, entre les mains du saisi qui peut librement en disposer sauf si, à la demande du prétendu titulaire du droit à la marque, le juge saisi estime nécessaire d'ordonner le prélèvement de quelques échantillons des produits qu'il prétend marqués, livrés ou fournis à son préjudice.

La saisie-description permet ainsi d'établir, ultérieurement, dans le cadre de l'action au fond, l'existence et l'ampleur de l'atteinte que le titulaire du droit à la marque prétend subir. Il en résulte que la description est l'objet principal de la procédure de saisie en matière de contrefaçon. Cette règle a été maintes fois rappelée par la doctrine et la jurisprudence¹⁸¹. Il faut aussi signaler que la requête présentée au magistrat doit être la plus exhaustive possible dans la présentation des exigences du demandeur. Cette nécessité se comprend car l'autorisation qui sera accordée ne le sera qu'en fonction de ce qui est sollicité.

En l'espèce, dans son ordonnance sur requête du 22 juin 2012, le président du tribunal régional avait autorisé la société MT à "faire procéder respectivement par Maître Mademba GUEYE, huissier de justice à Dakar, à la description détaillée des produits prétendus contrefaits". Une telle ordonnance, trop générale dans ses prescriptions, ne nous semble pas répondre aux exigences de précision recherchées pour éviter alors tout abus dans son exécution par l'huissier instrumentaire désigné.

Cette exigence de prudence et de précision est très importante au regard de la force probante qui s'attache au procès-verbal de saisie-contrefaçon dressé par l'huissier de justice commis conformément à l'article 48 de l'annexe III de l'ABR-1999¹⁸². Les juges d'appel l'ont réaffirmé en faisant remarquer à la société AM que ses moyens de défense "ne remettent pas en cause la validité et les éléments intrinsèques du procès-verbal de saisie-description du 15 juin 2012 dont la description énoncée et constatée par l'huissier fait foi jusqu'à inscription de faux".

Dans tous les cas, s'il est fait droit à la requête, le tiers supposé contrefacteur peut solliciter du même juge la rétractation de l'ordonnance de saisie-contrefaçon qui

lui ferait grief¹⁸³. Mais la cour rappelle que cette instance ne peut être ni le lieu, ni le moment de discuter de l'existence ou non de la contrefaçon alléguée.

Il faut souligner que la procédure de rétractation, engagée par la société AM contre l'ordonnance n° 1000/2012 du 22 juin 2012, trouve sa source, non pas dans les dispositions des annexes de l'ABR-1999, qui ne la prévoient pas expressément, mais bien dans le régime général des ordonnances sur requête réglementé dans chaque État partie par les dispositions relatives à la procédure civile¹⁸⁴. C'est par essence une procédure qui vise à rétablir le principe du contradictoire. Ainsi, lorsqu'il est fait droit à la requête, tout intéressé peut en référer au juge qui a rendu l'ordonnance contestée. Dans le cadre de la saisie-contrefaçon, on imagine mal qu'il puisse s'agir d'une personne autre que celle qui a subi la saisie, c'est-à-dire le supposé contrefacteur¹⁸⁵.

Sous ce rapport, le juge, qui a rendu l'ordonnance sur requête de manière unilatérale, sur les seuls éléments présentés par le supposé titulaire du droit à la marque, réapprécie la requête aux fins de saisie-contrefaçon et les conditions d'octroi de l'ordonnance, cette fois-ci, au regard des moyens de défense apportés par le supposé auteur de la contrefaçon.

Toutefois, la cour d'appel de Dakar a rappelé, fort opportunément, que l'instance en rétractation ou en modification de l'ordonnance de saisie-contrefaçon n'est pas le moment de discuter du fond du droit ou d'apprécier l'existence ou non de la contrefaçon alléguée. Le but de la saisie-contrefaçon n'est pas de chercher la contrefaçon, c'est de la prouver¹⁸⁶.

La cour répond ainsi à la société AM qui, dans ses moyens d'appel, discutait le fond du droit en "contestant la contrefaçon, invoquant des arguments relatifs à la différence entre les caractéristiques de la marque de la Société MT et ceux décrits, la protection de sa marque par son enregistrement à l'OAPI et l'absence d'un droit exclusif d'usage au profit de MT".

Le choix de la cour d'éviter le débat sur l'existence de la contrefaçon alléguée est justifié dès lors qu'elle est saisie uniquement de la contestation relative à la saisie-contrefaçon ordonnée par le juge des requêtes. En effet, le juge saisi d'une demande de saisie-contrefaçon ou de la rétractation ou modification de l'ordonnance prescrivant une telle mesure ne procède qu'à un contrôle superficiel dit *prima facie*. Il doit juste s'assurer de la validité apparente du droit à la marque du requérant et des indices de la contrefaçon commise par le tiers, le futur saisi.

179 VÉRON (P.), Saisie-contrefaçon, 2^e éd., Paris (Dalloz), 2005, n° 11.

180 VÉRON (P.), Saisie-contrefaçon 2013-2014, 3^e éd., Paris (Dalloz), 2012, pp. 487 et s.

181 Voir GALLOUX (J.-C.), Droit de la propriété industrielle, Paris (Dalloz), 2000, n° 489.

182 Le procès-verbal de constat, comme tout exploit d'huissier, est un acte authentique, qui au sens de l'art. 18 du code des obligations du Sénégal fait foi jusqu'à inscription de faux.

183 Voir Ordonnance de référé n° 867 du 20 juin 1995, TGI de Douala, *Société S c. Société RCFG* : Recueil de décisions de justice, Collection OAPI, n° 3, p. 393.

184 Art. 820-8 du Code de procédure civile du Sénégal : "S'il est fait droit à la requête ou à la requête d'appel, tout intéressé peut, à tout moment, en référer au président qui a rendu l'ordonnance."

185 Voie STENGER (J.-P.), Saisie-contrefaçon – Recours après saisie-contrefaçon : Juriscl. Brevets, Fasc. 4634, 2004, n° 125 et s.

186 MENDOZA-CAMINADE (A.), La saisie-contrefaçon. Une mesure aux allures de sanction, Presse de l'Université Toulouse Capitole, Les travaux de l'IFR "À propos de la sanction", 2007, pp. 117-134.

Le but de la saisie-contrefaçon étant d'obtenir des preuves de la contrefaçon, cette exigence d'indices de contrefaçon ne doit pas être entendue de façon trop extensive, sinon cela reviendrait à exiger des preuves de la contrefaçon et donc à priver la procédure de saisie-contrefaçon de son essence¹⁸⁷. Dans tous les cas, le saisi pourra valablement entamer ce débat sur l'absence de contrefaçon dans le cadre de la procédure au fond que le saisissant doit initier dans un délai de 10 jours ouvrables, à peine de nullité de plein droit de la saisie.

Par ailleurs, il est intéressant de relever, en l'espèce, que pour admettre la validité de la saisie-description, la cour d'appel s'est contentée de vérifier que la société MT a fait enregistrer la marque "le cheval + logo", suivant arrêté n° 12/1252/OAPI/DG/DGA/DPI/SSD du 31 mai 2012 portant le numéro 3201102761 sans faire état de la production de certificats de non-radiation et de non-déchéance comme l'exige l'article 48 de l'annexe III de l'ABR-1999¹⁸⁸.

Les juges se sont également prononcés sur la validité de la saisie réelle du stock de riz ordonnée par le juge des requêtes.

II. L'étendue de la saisie réelle en matière de saisie-contrefaçon

Il faut relever, en l'espèce, que la cour a, dans deux attendus, bien pris le soin de distinguer la saisie-description de la saisie réelle emportant enlèvement du produit incriminé.

Si, dans le premier attendu, elle a confirmé la mesure de saisie-description, par contre, dans le second, elle a, s'agissant de la mesure de saisie réelle portant sur l'ensemble du stock du produit incriminé, reproché au premier juge d'avoir rendu "une ordonnance générale permettant au requérant de poursuivre la contrefaçon d'une marque chez tout contrefacteur, en tout temps et en tout lieu sans se limiter au stock visé et entreposé dans les locaux de la SONAFOR".

La cour prend position dans le débat relatif à l'étendue de la saisie réelle en matière de contrefaçon¹⁸⁹ et fait droit aux arguments de la société AM qui soutenait que le juge des requêtes ne pouvait ordonner la saisie de tout le stock du présumé contrefacteur. Elle s'appuie d'abord sur le fait qu'à ce stade de la procédure, le saisi n'est qu'un présumé contrefacteur, ensuite que la victime n'a pas besoin de saisir tout le stock du concurrent pour prouver la contrefaçon, quelques échantillons étant suffisants et enfin, que la saisie de tout le stock porterait une grave atteinte au saisi et ne serait pas indispensable au requérant.

Pour infirmer l'ordonnance entreprise sur l'étendue de la saisie, les juges d'appel ont affirmé que "la saisie réelle, qui conserve une finalité probatoire, ne peut revêtir une forme conservatoire pour porter sur tout le stock de produits contrefaisants". Cette position de la cour procède d'une démarche de prudence en raison du préjudice matériel et moral que peut causer une saisie réelle¹⁹⁰. C'est justement la raison pour laquelle l'article 48 de l'annexe III¹⁹¹, siège de la saisie-contrefaçon en matière de marque, prévoit la possibilité pour le juge des requêtes de subordonner la saisie-contrefaçon à une garantie à fournir par le requérant pour décourager les demandes téméraires ou motivées par une volonté de nuire à un concurrent. Cette garantie doit être en principe suffisante pour indemniser le préjudice que pourrait subir le saisi au vu de l'ampleur de la saisie si celle-ci s'avère injustifiée car il y a effectivement un risque d'abus de droit. Certes, de tels agissements seraient sanctionnés a posteriori mais, dans un but d'efficacité ainsi que de rapidité de l'action en contrefaçon subséquente, il est important pour le juge d'ordonner une constitution de garantie préalable à une mesure de saisie réelle, ceci dans le but d'assurer un usage "plus raisonné"¹⁹².

La décision de la cour sur la saisie réelle semble s'inscrire dans cette dynamique d'équilibre et de prudence à encourager, même si elle est discutable du point de vue de sa conformité avec le texte de l'article 48 de l'annexe III de l'ABR-1999¹⁹³. La cour affirme que la saisie réelle, qui ne peut avoir qu'une finalité probatoire, ne saurait porter sur l'ensemble du stock des produits prétendus contrefaisants au risque d'être assimilée à une saisie conservatoire. Une telle position ne résulte pas du texte de l'article 48 de l'annexe III de l'ABR-1999 qui parle de "...description détaillée avec ou sans saisie des produits ou services qu'il prétend marqués...". Même s'il faut déplorer l'absence de précision du texte sur son étendue, il reste qu'il fait bien état de la saisie des produits ou services prétendus contrefaisants.

La cour ne peut ainsi tirer des dispositions de l'article 48 précité une quelconque restriction légale de la saisie réelle en matière de contrefaçon. La saisie réelle de tout le stock du produit incriminé peut effectivement, dans certains cas, se justifier. C'est ce que la société MT a cherché à établir, en l'espèce, en faisant valoir que "la mise en vente sur le marché sénégalais de ces sacs de riz entraînerait inévitablement une confusion de produit et de surcroît une concurrence déloyale envers elle" de nature à lui causer "un préjudice commercial voire un manque à gagner".

La saisie réelle de tout le stock peut ainsi être ordonnée lorsque tout retard dans l'intervention est de nature à causer un préjudice irréparable au titulaire du droit

187 AZÉMA (J.) et al., *Lamy Droit commercial*, Paris (Wolters Kluwer), 2006, n° 2040 : "Le requérant n'a pas à justifier de la vraisemblance de la contrefaçon que la procédure de saisie aura précisément pour but d'établir."
188 Devenu l'art. 51 de l'annexe III de l'ABR-2015.
189 STENGER (P.), *Saisie-contrefaçon – Exécution de la saisie-contrefaçon* : *Jurisl. commercial*, Fasc. 463.

190 Cass. com., 4 janvier 1985 : *Bull. civ.*, IV, n° 9, p. 237 (note MATHÉLY (P.)) et : *PIBD* 1985, III, p. 373.

191 Art. 51 de l'annexe III de l'ABR-2015.

192 Cass. com., 11 mars 2003 : *JCP G* 2003, IV, p. 1842 : "La saisie-contrefaçon doit être utilisée conformément à sa finalité, car à défaut, elle est susceptible de générer des abus et c'est sa légitimité et sa portée qui en seront amoindries."

193 Art. 51 de l'annexe III de l'ABR-2015.

à la marque. C'est le cas par exemple "lorsqu'il s'agit d'empêcher l'introduction, dans les circuits commerciaux de marchandises, y compris des marchandises importées immédiatement après leur dédouanement"¹⁹⁴. Cette notion de prévention d'un préjudice irréparable est désormais consacrée par l'article 50 de l'annexe III de l'Acte de 2015. Il dispose en effet que "la juridiction nationale compétente peut également ordonner toutes mesures urgentes sur requête lorsque les circonstances exigent que ces mesures ne soient pas prises contradictoirement, notamment lorsque tout retard serait de nature à causer un préjudice irréparable au demandeur." Certes, cette possibilité n'est pas traitée à l'article 51 dudit texte qui concerne de la saisie-contrefaçon. Mais il reste constant que c'est un pouvoir reconnu désormais au juge des requêtes même si le fondement diffère.

Dès lors, il demeure évident qu'en cas de risque de préjudice irréparable, la saisie réelle peut bien être ordonnée par voie d'ordonnance à pied de requête.

À titre comparatif, la France a prévu à l'article L 716-7 du code de propriété intellectuelle (CPI) expressément la possibilité de saisir le stock des produits incriminés. La saisie réelle peut ainsi porter sur tous les produits ou services que le saisissant prétend contrefaits en violation de ses droits : l'objet de la mesure est donc très large. Certaines décisions des États de l'espace OAPI l'ont déjà bien admise¹⁹⁵.

Dans tous les cas, il semble que Fernand de Vischer et Françoise Jacques de Dixmude¹⁹⁶ suggèrent à juste titre que le développement de la saisie-contrefaçon et les risques qu'il peut engendrer doivent conduire à un nouvel équilibre bienvenu au sein de cette procédure. Pour atteindre cet équilibre tant recherché, il est important, en cas de saisie réelle du stock, de rendre systématique la constitution de garanties. En ce sens, l'article 51 de l'annexe III de l'Acte de Bamako portant révision de l'Accord de Bangui a pris en compte ce besoin de sécuriser l'usage de la saisie réelle en matière de contrefaçon de marque. Il dispose ainsi que "lorsqu'il y a lieu à saisie, ladite ordonnance peut imposer au requérant un cautionnement qu'il est tenu de consigner avant d'y faire procéder. Ce cautionnement doit être suffisant sans être de nature à décourager le recours à la procédure".

194 Voir l'art. 50 ADPIC qui dispose que "Les autorités judiciaires seront habilitées à ordonner l'adoption de mesures provisoires rapides et efficaces : pour empêcher qu'un acte portant atteinte à un droit de propriété intellectuelle ne soit commis et, en particulier, pour empêcher l'introduction, dans les circuits commerciaux relevant de leur compétence, de marchandises, y compris des marchandises importées immédiatement après leur dédouanement; (...)".

195 Voir Jugement n° 1847 du 27 novembre 2002, tribunal régional de Dakar, *Jugement n° 250 du 25 janvier 1993, Société B.S.A c. Société S Sénégal*, in : Le contentieux de la propriété intellectuelle dans les États membres de l'OAPI, Collection de l'OAPI, n° 3, pp. 247-256; TGI du Mfoundi - Yaoundé, Jugement n° 250 du 24 janvier 1996, *Sté Air L and ors c. Sté A.S Cameroun*, in : EDOU EDOU (P.), n.20, pp. 266-269.

196 DE VISSCHER (F.), La saisie-description en Belgique : une mesure probatoire et parfois conservatoire, in : Les cahiers de propriété intellectuelle, Vol. 13, 2011, n° 2, pp. 465-486.

Il appartient désormais aux juges de faire une bonne application de ce texte pour amener les demandeurs à raisonner leurs demandes.

Malick Lamotte

L. Marque – Revendication du droit de priorité – Restauration de la priorité – Violation du droit antérieur

Est tardive et donc inopérante la revendication de priorité attachée à une marque effectuée à l'OAPI deux ans après le dépôt initial de ladite marque réalisé dans un pays tiers, nonobstant la décision du directeur général de l'Organisation restaurant la priorité revendiquée, dès lors que le juge constate que les conditions fixées par le Règlement relatif à la restauration des droits ne sont pas réunies.

L'enregistrement d'une marque opéré sous le fondement d'un droit de priorité vicié ne peut antérioriser un signe identique ou similaire enregistré postérieurement à la date du dépôt initial.

Tribunal de première instance de Yopougon, Jugement civil n° 187 du 21 mars 2013, SIVOP, S.A. c. SOCIÉTÉ ANGEL COSMETICS S.A.

Observations :

Le droit de priorité unioniste institué par l'article 4 de la Convention de Paris pour la protection de la propriété industrielle¹⁹⁷ a pour but, en matière de marque, d'éviter au déposant d'avoir à effectuer ses dépôts simultanément dans tous les pays du monde où il souhaite être protégé et de lui permettre de bénéficier d'un certain délai à compter du premier dépôt dans un pays membre, pour réaliser des dépôts parallèles dans d'autres pays membres sans risquer d'être antériorisé dans ces pays par des tiers qui auraient profité de la publication du premier dépôt pour déposer entretemps le même signe dans ces autres États¹⁹⁸. La décision rapportée a le mérite d'apporter un éclairage sur les conditions de mise en œuvre de ce droit de priorité réglementé à l'article 11 de l'annexe III de l'Accord de Bangui révisé pris en application de l'article 4 de la Convention d'Union de Paris.

Faits : La société ivoirienne SIVOP SA, se prévalant de son droit antérieur sur la marque "CAROLIGHT" avec logo enregistrée à l'OAPI le 30 novembre 2006 sous le n° 54.659 pour les produits des classes 3, 20 et 25, a attiré la société Angel Cosmetics SA installée à Kinshasa devant le tribunal de première instance de Yopougon en annulation de l'enregistrement n° 57406 de la même marque opérée à son profit le 17 octobre 2005. La société Angel Cosmetics a prétendu détenir un droit antérieur

197 Cf. art. 4 de la Convention d'Union de Paris pour la protection de la propriété industrielle signée le 20 mars 1883 et révisée à Bruxelles le 14 décembre 1900, à Washington le 2 juin 1911, à La Haye le 6 novembre 1925, à Londres le 2 juin 1934, à Lisbonne le 31 octobre 1958 et à Stockholm le 14 juillet 1967. C'est l'une des conventions maîtresses administrées par l'OMPI et à laquelle tous les pays membres de l'OAPI ont adhéré.

198 Voir PASSA (J.), n.82, p. 560.

sur la marque "CAROLIGHT" en vertu de son droit de priorité congolaise restauré par décision n° 217/OAPI/DG/DPI/DAJ/SSD/SAJ du 11 octobre 2007 du directeur général de l'OAPI. En effet, la société Angel Cosmetics avait, en date du 12 octobre 2005, soit deux années plus tôt, déposé la marque "CAROLIGHT" en République démocratique du Congo, pays non-membre de l'OAPI mais ayant adhéré à la Convention d'Union de Paris.

Consciente du caractère tardif de sa revendication de priorité qui devrait parvenir à l'Organisation au plus tard trois mois après le dépôt de la demande d'origine, la société Angel Cosmetics a sollicité et obtenu du directeur général de l'OAPI la restauration de son droit de priorité congolaise, ce qui, à ses yeux, la constitue rétroactivement propriétaire de la marque litigieuse depuis le 12 octobre 2005, date du dépôt de sa marque en République démocratique du Congo. Elle a par ailleurs indiqué avoir parallèlement saisi cette autorité en opposition à l'enregistrement de la marque revendiquée par la SIVOP SA, et que le tribunal civil ne peut vider sa saisine sans que cette question préjudicielle ne soit préalablement réglée par l'autorité compétente.

Deux questions de droit étaient posées au juge du tribunal de Yopougon : la juridiction de l'ordre judiciaire saisie d'une demande aux fins d'annulation d'une marque doit-elle surseoir à statuer en attendant que l'OAPI parallèlement saisie de l'opposition à l'enregistrement de ladite marque vider sa saisine? Le déposant étranger d'une marque est-il en droit de se prévaloir d'un droit de priorité restauré à tort par le directeur général de l'OAPI pour antérioriser une marque première déposée auprès de cette organisation?

Raisonnement : Le tribunal a rejeté la demande de sursis à statuer, consacrant ainsi la prééminence des décisions des tribunaux de l'ordre judiciaire sur celles émanant des organes statutaires de l'OAPI (section I). En outre, pour refuser le bénéfice de la priorité, la juridiction saisie a préalablement examiné les conditions d'exercice de ce droit (section II).

I. La prééminence des décisions des juridictions de l'ordre judiciaire sur celles des organes statutaires de l'OAPI

La prégnance des décisions des tribunaux de l'ordre judiciaire sur celles émanant des instances de l'OAPI est énoncée par des dispositions pertinentes de l'Accord de Bangui révisé et irradie tout le processus de mise en œuvre des droits de propriété intellectuelle. L'article 18 des dispositions générales de l'Accord de Bangui révisé, Acte du 24 février 1999 dispose : "les décisions judiciaires définitives rendues sur la validité des titres dans l'un des États membres en application des dispositions du texte des annexes I à X au présent accord font autorité dans tous les autres États membres, exceptées celles fondées sur l'ordre public et les bonnes mœurs". C'est au visa de cette disposition communautaire que le juge auteur de la décision rapportée a, à bon droit, rejeté l'exception de sursis à statuer soulevée par la société congolaise Angel

Cosmetics : "...Qu'en cela, cette disposition rejoint l'article 18 de l'ABR qui fait prévaloir la primauté de l'autorité et l'indépendance des décisions judiciaires et soumet les organes dirigeants de l'OAPI à la censure des Tribunaux civils dans leurs actes et décisions relatives à la mise en œuvre des instruments de protection de la propriété industrielle".

On le voit : les décisions des tribunaux sur la validité des titres de propriété industrielle s'imposent tant aux titulaires desdits titres qu'à l'Office de propriété industrielle. En effet, les décisions d'attribution de titres de propriété industrielle émanant des instances de l'OAPI n'ont pas une valeur absolue. Les titres délivrés par l'Organisation ne confèrent qu'une présomption de droit à leurs titulaires, aucune certitude ne s'y attachant quant à l'existence et à la validité des droits. À titre d'illustration, en matière de brevet d'invention, l'article 22, alinéa 1, de l'annexe I de l'Accord de Bangui révisé indique que "la délivrance des brevets est effectuée aux risques et périls des demandeurs et sans garantie soit de la réalité de la nouveauté, ou du mérite de l'invention, soit de la fidélité ou de l'exactitude de la description". C'est l'autorité judiciaire qui détermine en dernier ressort si un titre délivré est éligible à la protection légale. Ce principe trouve application relativement à la naissance des droits de propriété industrielle et à leur maintien en vigueur.

S'agissant de la naissance des droits, c'est au juge qu'incombe la responsabilité de dire en définitive si le titre de propriété industrielle délivré méritait de l'être après examen des conditions légales d'admissibilité de l'objet considéré à la protection légale.

En ce qui concerne le maintien en vigueur des titres délivrés, le juge peut prononcer la nullité, la radiation ou la déchéance par voie principale ou incidente¹⁹⁹. Il peut a fortiori prononcer la déchéance ou annuler une marque qui a été restaurée par les instances compétentes de l'Organisation. De ce point de vue, la décision du directeur général de l'OAPI n° 217/OAPIDG/DPI/DAJ/SSD/SAJ du 11 octobre 2007 portant restauration de la priorité congolaise de la marque "CAROLIGHT" n° 57406 du 17 octobre 2005 ne s'impose pas au juge civil qui a le pouvoir de la rapporter dès lors qu'il estime que les conditions légales ne sont pas réunies. C'est d'ailleurs au terme de cet examen que le juge du tribunal de première instance de Yopougon a refusé d'accorder le bénéfice du droit de priorité à la société Angel Cosmetics désavouant ainsi le Directeur Général de l'OAPI.

Bien entendu, cette décision, une fois définitive, s'impose à l'OAPI en vertu des dispositions combinées des articles 18 de l'ABR-1999, 24.3) de l'annexe III dudit accord. Cette dernière disposition prévoit la communication à l'Organisation de la décision définitive déclarant l'enregistrement nul et non avenue²⁰⁰. La

199 Pour plus amples informations sur la question, v. NDEMA ELONGUE (M.-L.), La propriété intellectuelle à l'épreuve de la justice des pays membres de l'OAPI, in : Mélanges offerts à Denis Ekani, Collection de l'OAPI n° 4, Paris (L'Harmattan), 2012, pp. 189 et s.

200 Cf. art. 28 al. 3 de l'ABR-2015.

Règle 6.1) de son Règlement d'application de l'ABR-1999 précise que cette communication est faite par la partie la plus diligente.

II. Les conditions d'exercice du droit de priorité

L'exercice du droit de priorité est subordonné à l'observance de certaines conditions prévues par les textes de loi susvisés. Le tribunal de Yopougon a annulé la marque "CAROLIGHT" n° 57.406 du 4 septembre 2007 motif pris de la violation du droit antérieur de la société ivoirienne SIVOP SA sur la même marque enregistrée le 30 novembre 2006 sous le n° 54.659 après avoir refusé le bénéfice de la priorité congolaise rattachés à la marque n° 57.406 revendiquée par Angel Cosmetics SA pour inobservation des conditions de forme et de fond prévues par la législation communautaire.

Il importe d'indiquer que l'article 11.1) de l'annexe III de l'Accord de Bangui révisé ne prévoit pas expressément la restauration du droit de priorité à la différence de l'Acte de BAMAKO du 14 décembre 2015 qui indique à l'article 12, alinéa 5, que : "Toutefois, le droit de priorité du déposant peut faire l'objet de restauration conformément à l'article 21 ci-dessous". C'est finalement sur le fondement du Règlement sur la restauration des droits adopté à Cotonou le 4 décembre 2004²⁰¹ que cette mesure de faveur peut être accordée sous l'empire de l'ABR-1999.

De l'analyse des dispositions combinées des articles 11.1), 25 de l'Accord de Bangui révisé et du Règlement susvisé, il ressort que le demandeur doit présenter à l'Organisation une demande de restauration au plus tard dans les trois mois après le dépôt de la demande d'origine et comprenant :

- un exposé complet des motifs présentés à l'appui accompagné de documents justificatifs;
- une déclaration écrite indiquant la date et le numéro du dépôt antérieur;
- une copie certifiée conforme de ladite demande antérieure; et
- le justificatif du dépôt de la demande ou bien du document de priorité, de cession de priorité ou la traduction dudit document.

Il importe de souligner qu'à l'origine, le domaine de la restauration en matière de marque était limité à l'hypothèse visée à l'article 25 de l'annexe III de l'Accord de Bangui, Acte du 24 février 1999, à savoir le défaut de renouvellement de la protection conférée par la marque. Le Règlement relatif à la restauration des droits du 4 décembre 2004 a élargi le champ de la restauration des droits en accordant désormais ce privilège au demandeur qui n'a pas fourni dans les délais le document de priorité.

La société SIVOP SA a soutenu que le directeur général de l'OAPI n'aurait pas dû recevoir la demande de restauration de la priorité revendiquée par Angel

Cosmetics SA dans la mesure où le document produit à l'appui n'a pas été certifié conforme par l'office de protection d'origine, en l'espèce l'office zairoise de propriété industrielle, mais plutôt par un officier d'état civil, de surcroît d'un pays tiers. Or, l'article 11, alinéa 1.a), de l'annexe III de l'Accord de Bangui révisé n'indique pas expressément l'autorité habilitée à certifier conforme la demande antérieure. En toute logique, cette prérogative devrait échoir non seulement à l'office de propriété industrielle compétent mais aussi à toutes autres autorités locales compétentes. De ce point de vue, cette condition de forme nous semble avoir été respectée en l'espèce même si l'on peut spéculer sur la compétence de l'officier d'état civil du Mali ayant matériellement procédé à la certification. En tout état de cause, l'intervention de cette autorité relevant d'un pays autre que celui du ressort de l'office compétent préfigure déjà les circonstances exceptionnelles évoquées par la société Angel Cosmetics à l'appui de sa revendication de priorité.

S'agissant des conditions de fond, l'article 25.1) de l'Accord de Bangui révisé, Acte du 24 février 1999 prévoit la restauration dès lors que la marque n'a pas été renouvelée en raison des circonstances indépendantes de la volonté du titulaire de la marque²⁰². À l'appui de sa demande de restauration de priorité, la société Angel Cosmetics SA a convoqué deux circonstances ou raisons indépendantes de la volonté du titulaire, à savoir la faute du mandataire et la crise politico-militaire en République démocratique du Congo. Pendant longtemps, la Commission supérieure de recours assimilait la faute du mandataire à une circonstance indépendante de la volonté du titulaire²⁰³. Elle a par la suite fait preuve de rigueur en invitant désormais le déposant à rapporter la preuve de sa diligence et de son suivi en vue du maintien en vigueur de ses droits²⁰⁴.

La société Angel Cosmetics SA s'est cependant heurtée au défaut de preuve de ses allégations, la prétendue faute du mandataire n'ayant pas été spécifiée. En outre, la société SIVOP SA a produit aux débats les courriers du Gouvernement de la RDC et des services postaux de ce pays établissant que les circonstances évoquées n'existaient pas au cours de la période considérée, toute chose dépouillant la demande de restauration de priorité de son fondement juridique et invalidant la décision du directeur général de l'OAPI susvisée. La demande de restauration de la priorité congolaise attachée à la marque "CAROLIGHT" n° 57.406 du 4 septembre 2007 n'étant pas fondée, celle-ci ne peut valablement antérioriser la marque "CAROLIGHT" n° 54.659 déposée à l'OAPI le 30 novembre 2006 par la société SIVOP SA.

202 L'art. 4 du Règlement relatif à la restauration des droits précise que par circonstances indépendantes de la volonté du titulaire, il faut entendre des événements fortuits et inévitables. À titre indicatif, comme circonstances indépendantes de la volonté du titulaire de titre de propriété industrielle, on peut citer l'interruption des services postaux et la perte ou le retard inévitable du courrier.

203 Voir Décision n° 29/SCR/OAPI du 31 octobre 2003; Décision n° 41/CSR/OAPI du 29 octobre 2004; Décision n° 50/CSR/OAPI du 1^{er} avril 2005 : Recueil des décisions de la CSR, Sessions de 2003 à 2005.

204 Voir Décision n° 0102/CSR/OAPI du 27 avril 2007; Décision n° 0103/CSR/OAPI du 27 avril 2007. Voir en ce sens CSR Décision n° 00103/CSR/OAPI du 27 avril 2007 (obs. EKANI (F.)) : Revue La Gazelle n° 004, septembre 2008, pp. 10 et s.

201 Ce Règlement a fait l'objet de la Résolution n° 44/13 prise à l'issue de la 44^e session du Conseil d'administration de l'OAPI.

À côté de cet argument, la société SIVOP SA a plaidé la nullité de la décision n° 217/OAPIDG/DPI/DAJ/SSD/SAJ du 11 octobre 2007 du directeur général de l'OAPI portant restauration de la priorité congolaise de la marque "CAROLIGHT" n° 57406 du 17 octobre 2005 motif pris du détournement de procédure, en ce que la restauration de la priorité concerne les enregistrements reçus à l'OAPI ou dans l'un de ses États membres, les bénéficiaires d'enregistrements dans les pays tiers ne pouvant profiter de la protection de l'OAPI qu'en demandant l'extension de la protection d'origine à l'espace OAPI en vertu de l'article 45 de l'Accord de Bangui²⁰⁵. Le tribunal a curieusement entériné cet argumentaire qui procède d'une confusion entre la revendication de priorité et la demande d'extension de la protection. Alors que celle-là permet, comme en l'espèce, à un déposant ressortissant d'un pays tiers membre de l'union de Paris de revendiquer la date du premier dépôt pour les dépôts ultérieurs de la même marque dans les autres États, celle-ci règle le sort des titres délivrés dans un État avant son adhésion à l'OAPI.

Sous cette réserve, la décision commentée mérite d'être approuvée.

Max Lambert Ndéma Elongué

M. Usage d'une marque comme nom de domaine de l'Internet – Concurrence déloyale – Mauvaise foi – Détermination de l'auteur de l'acte concurrentiel

Commet une faute constitutive de concurrence déloyale en application des articles 1^{er} et suivants de l'annexe VIII de l'Accord de Bangui, Acte du 22 février 1999, ensemble le Code civil national, une société qui utilise, à des fins commerciales et en connaissance de cause, une marque de service de paiement en ligne enregistrée comme nom de domaine au mépris des droits du titulaire des droits sur ladite marque.

La responsabilité des faits dénoncés incombe d'une part à l'organisme bénéficiaire de l'enregistrement du nom de domaine offensant et, d'autre part, à tous utilisateurs de mauvaise foi.

Cour suprême du Sénégal, Arrêt n° 57 du 17 mai 2017, SONATEL MOBILES S.A c. L'AGENCE TOUBA SÉNÉGAL ET LE GROUPE GPS

Observations :

Les conflits entre marques et noms de domaine deviennent récurrents dans l'espace OAPI à la faveur de l'engouement que connaît l'Internet dans les États membres, manifesté par l'enregistrement massif des noms de domaine désormais source de revenus et de contentieux multiformes. Les noms de domaine sont

des adresses qui permettent de localiser les serveurs, les sites Web ou les utilisateurs. Ils sont présentés avec des caractères permettant de mémoriser ou de localiser leurs titulaires ou leurs secteurs d'activité. Aujourd'hui, les noms de domaine sont gérés au plan mondial par l'ICANN, acronyme de l'Internet Corporation for Assigned Names and Number. Il importe de préciser que la responsabilité pour l'enregistrement de ces noms était confiée à la société américaine Network Solution Inc (NSI). Cet organisme a accrédité un certain nombre d'unités d'enregistrement appelés "registas". Ceux-ci sont des prestataires informatiques qui assurent l'intermédiation technique entre l'ICANN et les usagers du réseau.

Ces conflits surgissent essentiellement du fait de l'absence de coordination entre les systèmes d'enregistrement des marques et les systèmes d'enregistrement des noms de domaine, circonstance ayant favorisé la pratique du "cybersquatting" qui consiste dans l'enregistrement des noms de domaine comportant des marques appartenant aux tiers pour les revendre aux propriétaires desdites marques. ANDRÉ R. BERTRAND relève en effet que les marques sont enregistrées par une autorité publique gouvernementale (c'est le cas de l'OAPI dans la sous-région Afrique centrale et Afrique de l'Ouest) et les droits qui en découlent ne peuvent s'exercer que sur le territoire spécifique, contrairement au système des noms de domaine qui ne connaît pas de limites géographiques et ne dépend pas des gouvernements²⁰⁶.

Faits : Dans l'espèce commentée, le litige qui oppose le titulaire d'une marque et l'auteur de l'enregistrement d'un nom de domaine se cristallise plutôt sur le terrain de la concurrence déloyale, telle que régie par les articles premier et suivants de l'annexe VIII de l'Accord de Bangui, Acte du 22 février 1999²⁰⁷. Les faits sont d'une relative simplicité : l'Agence TOUBA Sénégal, titulaire de la marque de service "sen-factures" enregistrée à l'OAPI le 30 janvier 2006 avec effet le 12 avril 2005 pour désigner un système de paiement de factures à distance, a assigné la SONATEL MOBILES en concurrence déloyale et paiement des dommages et intérêts pour avoir utilisé sa marque à des fins commerciales sans son consentement. La société défenderesse a soutenu avoir utilisé la marque, non pas comme propriétaire et fournisseur du service de paiement litigieux, mais *es qualité* de cliente du Groupement GPS qui est, lui-même, membre du GIE GAINDE 2000, propriétaire du nom de domaine "senfactures.sn", pour l'avoir fait enregistrer au Sénégal, depuis janvier 2005, antérieurement à son utilisation par l'Agence Touba Sénégal, et au dépôt qu'elle a effectué à l'OAPI. La cour d'appel de Dakar a infirmé la décision du premier juge donnant gain de cause à l'Agence TOUBA Sénégal.

La Cour suprême a cassé l'arrêt infirmatif attaqué et renvoyé la cause à la cour d'appel de Kaolack qui fit droit à la demande de l'Agence TOUBA Sénégal.

205 L'art. 45 al.1 de l'ABR-1999 dispose en effet que : "Les titres en vigueur dans un État avant son adhésion au présent accord continuent à produire leurs effets dans ledit État conformément à la législation en vigueur au moment de leur dépôt."

206 Voir en ce sens BERTRAND (A. R.), *Droit des marques, signes distinctifs-noms de domaine*, Paris (Daloz), 2^e éd., 2005, p. 373.

207 Voir également art. 1 à 9 de l'ABR-2015.

Raisonnement : Fidèle dans sa logique, la haute juridiction a rejeté le pourvoi formulé par la SONATEL MOBILES, mettant ainsi fin à ce feuilleton judiciaire. Deux questions centrales étaient posées à la Cour suprême : la concurrence déloyale est-elle caractérisée en l'espèce? Le cas échéant, qui doit en endosser la responsabilité?

La haute juridiction sénégalaise a indiqué que "l'interdiction d'utiliser une marque enregistrée sans l'autorisation de son titulaire prévue à l'article 7 de l'annexe III de l'Accord de Bangui, Acte du 22 février 1999, est générale et s'applique aux tiers sans considération relative à une quelconque catégorie et que la concurrence déloyale est constituée dans les activités industrielles et commerciales par tout acte qui crée ou est de nature à créer la confusion tel que l'usage d'une marque".

À travers cette motivation, la Cour semble ne pas faire le départ entre la contrefaçon de marque et la concurrence déloyale, toute chose qui commande un recadrage de l'objet du litige pour lui restituer sa véritable portée. La concurrence déloyale nécessitant une faute, il faudra au préalable dire en quoi consiste l'acte concurrentiel en l'espèce (section I) et identifier ensuite le ou les auteur(s) dudit acte (section II).

I. La détermination de l'acte concurrentiel

Dans le droit fil de l'article premier 1)a) de l'annexe VIII de l'Accord de Bangui, Acte du 22 février 1999 précité, la concurrence déloyale sur le fondement de laquelle l'Agence TOUBA a saisi la justice suppose l'exercice d'une activité concurrente (A) et la mauvaise foi (B).

A. L'activité concurrente

L'annexe VIII de l'Accord de Bangui, Acte du 22 février 1999 vise de façon non exhaustive plusieurs occurrences de concurrence déloyale qui vont de la confusion avec l'entreprise d'autrui ou ses activités, de l'atteinte à l'image ou à la réputation d'autrui, du dénigrement, à la violation de l'information confidentielle, etc. Dans l'espèce commentée, l'acte concurrentiel décrié est la confusion avec une marque enregistrée, hypothèse prévue à l'article 2, alinéa 2, du susdit accord. L'Agence TOUBA reproche en effet à la SONATEL MOBILES d'avoir utilisé le nom de domaine "senfactures.sn" qui constitue une imitation de sa marque éponyme enregistrée à l'OAPI le 30 janvier 2006 avec effet le 12 avril 2005 pour désigner un système de paiement de factures à distance. L'existence de la faute concurrentielle en l'espèce est tributaire de l'aptitude du nom de domaine litigieux à générer la confusion dans l'esprit du public avec la marque revendiquée.

L'imitation est évidente en l'espèce, le nom de domaine querellé "senfactures.sn" reprenant à l'identique le terme verbal "sen-factures" constitutif de la marque déposée par l'Agence TOUBA. L'identité entre les signes litigieux est parfaite, leur différence orthographique étant sans aucune incidence. À titre de droit comparé, la Cour de justice des Communautés européennes considère que l'exigence d'identité est satisfaite "lorsque

le signe critiqué reproduit, sans modification ni ajout, tous les éléments constituant la marque ou lorsque, considéré dans son ensemble, il recèle des différences si insignifiantes qu'elles peuvent passer inaperçues aux yeux du consommateur d'attention moyenne"²⁰⁸. Il y a lieu de rappeler que la reproduction même non identique de la marque revendiquée ou des produits ou services auxquels elle se rapporte peut également être source de confusion au sens de l'article 2, alinéas 1 et 2.a), de l'annexe VIII de l'Accord de Bangui, Acte du 24 février 1999²⁰⁹.

Il est par ailleurs admis en jurisprudence que l'extension du nom de domaine ne doit pas être prise en compte dans l'appréciation du risque de confusion. Il importe de noter que le nom de domaine est constitué d'un radical et d'une extension. LICANN a créé au fil des ans de nouvelles extensions qui viennent en complément des domaines génériques (gTLDs) déjà existants pour faire face à la forte demande de nouvelles adresses Web. Dans une intéressante affaire où la société Gandi s'appuyait sur les marques "Gandi" et "Gandi-net" pour poursuivre ceux qui avaient enregistré les noms de domaine "gandi-info", le tribunal de grande instance de Paris a posé que : "Les noms de domaine litigieux (...) sont constitués d'un radical et d'une extension; (...) celle-ci désignant le domaine générique, seul le radical Gandi doit être pris en considération pour apprécier la contrefaçon"²¹⁰. Cette décision a été rendue certes en matière de contrefaçon de marque, mais le raisonnement vaut son pesant d'or sur le terrain de la concurrence déloyale, lorsqu'il s'agit d'établir le risque de confusion. Un tel risque étant acquis dès lors que, comme en l'espèce, le radical du nom de domaine litigieux, à savoir "senfactures", est une reprise à l'identique de la marque enregistrée "sen-factures", l'extension dudit nom, à savoir ".sn", étant sans réelle importance.

La reproduction génératrice de confusion porte également sur le service offert par le titulaire de la marque "sen-factures", à savoir le système de paiement des factures à distance. La démarche ici consiste à mettre en parallèle le contenu du site exploité et le service pour lequel la protection est revendiquée. Le tribunal de grande instance de Nanterre a indiqué, certes en matière de contrefaçon, "Qu'il convient de procéder à une comparaison entre le contenu du site exploité (...) et les produits et services pour lesquels la protection est revendiquée"²¹¹. Dans le même sens, la cour d'appel de Versailles a refusé au titulaire d'une marque déposée en classe 38 – télécommunications – la possibilité d'opposer cette marque à un nom de domaine sans autres considérations. La cour a indiqué que les services visés à la classe 38 de communication, messagerie, etc. "S'entendent de ceux (...) ayant un tel objet et qu'ils ne sauraient se confondre avec les multiples services pour la fourniture desquels les communications par ordinateur,

208 Voir Cour de justice de l'Union européenne, Arrêt du 20 mars 2003, *Littis Diffusion SA c. Sadas Vertbaudet SA*, C-291/00, ECLI:EU:C:2003:169.

209 Voir art. 3 de l'annexe III de l'ABR-2015.

210 Voir TGI de Paris, 3^e chambre, 2^e section, 27 juin 2003.

211 Voir TGI de Nanterre, 3^e chambre, 2^e section, 21 janvier 2002 : JCP E 2002, n° 36, n° 8 (obs. VIVANT (M.)).

messagerie électronique ou tout autre support (tel Internet) ne constitue qu'un moyen"²¹².

Il va sans dire que l'auteur de l'enregistrement du nom de domaine litigieux offre un service identique que celui désigné par l'Agence TOUBA, à savoir le paiement des factures à distance à travers l'adresse "www.senfactures.sn" dont la structuration est évocatrice, toute chose susceptible d'induire la communauté des internautes en erreur quant à l'entreprise prestataire du service concerné.

B. La mauvaise foi

Elle est cristallisée dans l'expression "contraire aux usages honnêtes" contenue dans l'article premier, alinéa 1.a), de l'annexe VIII précitée. En vertu de cette disposition, il ne suffit pas de reproduire la marque revendiquée comme nom de domaine pour être sanctionné sur le fondement de la concurrence déloyale; encore faut-il faire preuve de mauvaise foi, d'un comportement déshonnête dans l'exercice des activités industrielles et commerciales. En règle générale, la mauvaise foi doit s'apprécier à la date de l'enregistrement du nom de domaine litigieux. Or, il ressort des faits que le nom de domaine "senfactures.sn" a été enregistré courant janvier 2005, et donc antérieurement à la marque "sen-factures" enregistrée à l'OAPI seulement le 30 janvier 2006 avec prise d'effet le 12 avril 2005. L'on est, dès lors, en droit d'émettre un sérieux doute quant à la mauvaise foi de l'auteur de l'enregistrement du nom de domaine "senfactures.sn".

Certes, la question de l'attribution du bénéfice de l'antériorité à l'usager d'un nom de domaine est discutée tant en doctrine qu'en jurisprudence, certaines décisions déniaient à ce dernier la qualité de titulaire au sens du droit de la propriété intellectuelle²¹³, alors que d'autres, plus libérales, la lui reconnaissent. Dans un arrêt dont la motivation est assez évocatrice, la cour d'appel de Paris a indiqué que "le nom de domaine, compte tenu notamment de sa valeur commerciale pour l'entreprise qui en est propriétaire, peut justifier une protection contre les atteintes dont il fait l'objet"²¹⁴. Jérôme Passa souligne, dans le même sens, approuvant par là certaines décisions, qu'un nom de domaine, dès lors qu'il est effectivement exploité, peut constituer une antériorité justifiant l'annulation d'une marque²¹⁵. Certains auteurs estiment que le nom de domaine n'est qu'une propriété en gestation, rien n'étant encore acquis quant aux conditions qui justifieraient cette protection²¹⁶.

Toujours est-il que l'on voit mal comment taxer de frauduleux l'enregistrement premier en date du nom de domaine "senfactures.sn" sauf à admettre que l'Agence

TOUBA avait la priorité de l'usage de la marque éponyme. C'est précisément l'un des arguments développés par la SONATEL MOBILES pour établir sa bonne foi dans l'utilisation du nom de domaine offensant. Cette société a en effet soutenu qu'elle ignorait l'existence de la marque "sen-factures" et que l'offre commerciale relative à l'usage de ladite marque adressée à la SONATEL MOBILES par l'Agence TOUBA par correspondance en date du 9 mars 2004 ne lui était pas destinée, étant donné qu'elle a une personnalité juridique distincte de la SONATEL. Ce moyen pertinent a été déclaré irrecevable par la Cour régulatrice, faute de production de la lettre susvisée, laquelle lui aurait permis d'asseoir sa conviction sur la priorité de l'usage de la marque querellée par l'Agence TOUBA et de conforter celle-ci dans sa posture de victime de la concurrence déloyale. Inversement, la production de cette lettre aurait pareillement permis à la SONATEL MOBILES d'établir éventuellement sa bonne foi en prouvant que cette correspondance ne lui étant pas destinée, elle ne pouvait logiquement pas avoir connaissance de l'offre commerciale évoquant la marque querellée.

En tout état de cause, la Cour s'est visiblement fondée sur l'antériorité de l'usage de la marque "sen-factures" par l'Agence TOUBA pour sanctionner la SONATEL MOBILES. Le considérant ci-après l'illustre à suffire :

"Que l'arrêt constate également, que postérieurement à leur connaissance de l'utilisation et de l'enregistrement de la marque 'SENFACURES', par l'agence Touba SÉNÉGAL, la SONATEL et le Groupement GPS, dont elle est un des membres, ont continué à faire usage de ladite marque protégée; que cette pratique frauduleuse, contraire aux usages honnêtes, est de nature à créer une confusion avec la marque de service légitimement et légalement détenue par l'agence Touba SÉNÉGAL, et à perturber son marché".

Or, la reconnaissance du bénéfice de l'antériorité de l'usage de la marque "sen-factures" à l'Agence TOUBA paraît contestable, dès lors que la correspondance du 9 mars 2004 relative à l'offre commerciale visant ladite marque n'a pas été versée au dossier. Dans ces conditions, seule la date d'enregistrement à l'OAPI ou, à tout le moins, la date de prise d'effet de la marque, c'est-à-dire le 12 avril 2005, devrait être prise en compte dans la détermination de l'antériorité, sauf à considérer que la haute juridiction s'est appuyée sur l'engagement du 14 août 2002 de SADAGA SARR dont le contenu reste inconnu.

II. L'identification de l'auteur de l'acte concurrentiel

La question paraît évidente, mais il n'en est rien, l'exploitation d'un site Web faisant intervenir plusieurs acteurs dont les responsabilités méritent d'être circonscrites. Le premier responsable est de toute évidence celui qui entend se faire réserver le nom de domaine, c'est-à-dire la personne physique ou morale qui en a sollicité l'enregistrement auprès de l'unité accréditée (A). En revanche, la mise en jeu de la

212 Voir CA Versailles, 12^e chambre, 22 novembre 2001 : JCP E 2003, n° 106, n° 7 (obs. HUMBLLOT (B.)).

213 Voir en ce sens TGI Nanterre, 13 mars 2000 : JCP E 2000, p. 1856, n° 7 (obs. VIVANT (M.)).

214 Voir également CA Paris, 18 octobre 2000 : JCP E 2000, n° 36, n° 8 (obs. VIVANT (M.)).

215 Voir Cass. com., 26 novembre 2003 : PIBD 2004, III, n° 780, p. 98; CA Paris, 15 septembre 2004 : PIBD 2005, III, n° 800, p. 54.

216 Voir VIVANT (M.), *Lamy droit de l'informatique et des réseaux*, Paris (Éditions Lamy), 2004, n° 2061.

responsabilité des utilisateurs des services offerts sous le nom de domaine offensant nous semble plus délicate (B). La responsabilité des intermédiaires techniques, notamment le fournisseur d'accès et l'hébergeur de site, ne sera pas envisagée dans le cadre de cette analyse, la question n'ayant pas été expressément posée²¹⁷.

A. Le bénéficiaire de l'enregistrement du nom de domaine offensant

Le principal responsable des faits de concurrence déloyale est le bénéficiaire du nom de domaine litigieux, en l'espèce le GIE GAINDE 2000 dont le Groupement GPS est membre. Il ressort des faits que cette structure a enregistré le nom de domaine "senfactures.sn" au Sénégal depuis janvier 2005. L'argument de la cour d'appel entériné par la haute juridiction selon lequel : "... Les appelants ne sont pas fondés à utiliser la marque contre la volonté de l'intimée, en invoquant un enregistrement fait auprès d'un organisme national, en lieu et place de l'OAPI, seule institution sous-régionale compétente en la matière", participe d'une imparfaite maîtrise du mécanisme d'enregistrement des noms de domaine de l'Internet qui, à la différence des titres de propriété industrielle traditionnels, s'opère au plan national et international par des unités d'enregistrement accréditées. Il appartient au demandeur du nom de domaine de vérifier que la dénomination sollicitée ne porte pas atteinte à des droits antérieurs²¹⁸. Dans le cas d'espèce, le GIE GAINDE 2000 était tenu d'effectuer une recherche d'antériorité préalablement au dépôt du nom de domaine choisi auprès de l'unité d'enregistrement afin de s'assurer de sa disponibilité. Une telle recherche est d'autant plus facile que les sociétés en conflit opèrent dans le même secteur d'activité, en l'occurrence le paiement des factures en ligne. En tout état de cause, la juridiction de renvoi a souverainement considéré que le Groupement GPS était informé de l'usage de la marque "sen-factures" par l'Agence TOUBA antérieurement à l'enregistrement de son nom de domaine. Dès lors, l'exploitation dudit nom sur la toile par ce Groupement est constitutive d'une faute. Toutefois, l'action semble avoir été dirigée exclusivement vers la SONATEL MOBILES qui a fait feu de tout bois pour se mettre à l'abri de la condamnation.

B. L'utilisateur du nom de domaine offensant

La SONATEL MOBILES a prétendu avoir utilisé le nom de domaine "senfactures.sn", non pas comme propriétaire et fournisseur du service de paiement auquel il se rapporte, mais *es qualité* de cliente du Groupement GPS, lui-même membre du GIE GAINDE 2000 propriétaire dudit nom et qu'elle ne saurait répondre des actes posés par son partenaire commercial. La cour s'est fondée sur l'utilisation du nom offensant et sur la circonstance que la SONATEL MOBILES avait connaissance de l'existence de la marque revendiquée pour retenir le grief de concurrence déloyale contre elle. La démarche est classique, la concurrence déloyale étant adossée sur la

responsabilité civile pour faute telle que régie par les législations civiles des États membres de l'OAPI. Il suffit de rapporter la preuve de la mauvaise foi de l'un des intervenants de la chaîne pour le tenir pour responsable des faits incriminés à titre personnel ou solidairement. Il y a là une différence fondamentale avec la contrefaçon où la bonne foi est inopérante.

Comment comprendre dès lors la motivation de la cour qui a cru devoir convoquer les dispositions relatives aux droits conférés par l'enregistrement d'une marque pour caractériser la concurrence déloyale : "l'interdiction d'utiliser une marque enregistrée sans l'autorisation de son titulaire prévue à l'article 7 de l'annexe III de l'Accord de Bangui, Acte du 22 février 1999, est générale et s'applique aux tiers sans considération relative à une quelconque catégorie"? Si l'on peut comprendre le souci des juges suprêmes à appréhender toute violation des droits conférés au titulaire d'une marque, quel que soit le statut de l'auteur, ce considérant apparaît comme un élément perturbateur dans leur raisonnement. À la vérité, le titulaire d'un droit privatif sur une marque dispose d'une option, il peut agir directement en contrefaçon ou alors obtenir la sanction du comportement contrefaisant sur le terrain de la concurrence déloyale à condition, dans cette seconde hypothèse, de prouver le risque de confusion sans mettre en jeu le droit sur la marque. La Cour de cassation française rappelle d'ailleurs de façon constante aux juridictions inférieures :

- "(...) que l'action en concurrence déloyale exige une faute et que l'action en contrefaçon concerne l'atteinte à un droit privatif,
- que ces deux actions procèdent de causes différentes et ne tendent pas aux mêmes fins, et
- que la seconde n'est pas l'accessoire, la conséquence ou le complément de la première"²¹⁹.

C'est donc à tort que la Cour régulatrice a convoqué l'article 7 de l'annexe III de l'Accord de Bangui aux débats. L'on pourrait, a fortiori, mettre en avant le fait que la SONATEL MOBILES et l'Agence TOUBA opérant dans le même secteur d'activité, celle-là ne pouvait ignorer l'existence de la marque "sen-factures". De la sorte, en utilisant le service de paiement de factures en lignes offert par le titulaire du nom de domaine litigieux, la société SONATEL MOBILES a voulu se placer dans le sillage du titulaire de la marque pour profiter de ses efforts de promotion commerciale.

Max Lambert Ndéma Elongué

217 Voir sur cette importante question, FOMETEU (J.), La responsabilité des intermédiaires techniques dans l'utilisation en ligne des objets protégés : Revue africaine de la propriété intellectuelle n° 4, décembre 2013, pp. 25 et s.
218 Voir n.216, p. 1200, n° 2044.

219 Voir Cass. com., 24 février 1987 : PIBD 1987, III, p. 316. Voir dans le même sens, TGI du Wouri, Jugement civil n° 192 du 15 décembre 2000, *Moulinex SA c. Vapsan Trading Cie* (obs. Ndéma Elongué (M-L.)) : Revue scientifique de la propriété industrielle la GAZELLE n° 0001, novembre 2007, pp. 17 et s.

N. Revendication de la propriété d'une marque – Compétence exclusive de l'OAPI – Compétence du tribunal civil – Validité de l'enregistrement d'une marque – Violation d'un droit antérieur – Sanction : nullité

La revendication de propriété d'une marque n'est pas de la compétence exclusive des organes juridictionnels de l'OAPI. Cette action peut valablement être intentée devant les juridictions nationales des États membres. Dans ce second cas, son succès n'est nullement enfermé dans le délai de prescription de six mois imparti pour le contentieux administratif devant le directeur général de l'OAPI.

Tribunal de grande instance du Wouri (Douala), Jugement civil n° 382/Com du 23 décembre 2013, SOCIÉTÉ MARINE MAGISTRALE S.A c. Sieur KAMGA NENKAM Jean Paul

Observations :

Le droit sur la marque naît du dépôt. Conformément aux prescriptions de l'Accord de Bangui, l'usage du signe en rapport avec les produits qu'il accompagne sera réservé à celui qui, le premier, en a effectué le dépôt à l'OAPI : c'est la traduction de la règle du premier déposant (*v. art. 5 al. 1^{er} de l'annexe III de l'AB*). Cette règle ainsi posée de manière flexible ne s'applique pas dans les cas de dépôt frauduleux (c'est l'application du principe général *fraus omnia corrumpit*, adage latin qui signifie que la fraude corrompt tout. En application de ce principe, tout acte entaché de fraude peut être remis en cause devant le juge). En effet, le législateur régional parfaitement au fait des manœuvres peu orthodoxes qui sévissent dans les circuits commerciaux va doter tout usager de marque d'instruments juridiques pour se prémunir de la fourberie du déposant désireux de s'accaparer malicieusement son actif. L'action en revendication de propriété est donc la réponse consacrée à cet effet pour sanctionner tout imposteur à la condition que ce dernier ait eu connaissance préalable de l'usage du signe par la partie agissante. En marge du recours administratif prévu devant les organes de l'OAPI, rien n'empêche les juridictions nationales de se saisir de telles actions. Le jugement civil ici rapporté nous ouvre une fenêtre sur cette réalité.

Faits : En l'espèce, le sieur KAMGA NENKAM avait été désigné directeur général et salarié de la société MARINE MAGISTRALE (2M), demanderesse à l'instance, par une résolution du conseil d'administration de cette dernière. Pour accompagner ses services de manutention portuaire ultramoderne dénommé "Harbour Handling With Big Bags", mandat avait été confié par la demanderesse au sieur KAMGA NENKAM de procéder à l'enregistrement à l'OAPI au nom de la première, de la marque de service H2B2 SYSTEM. Profitant de sa position privilégiée dans la gestion de la société, sieur KAMGA NENKAM va utiliser les ressources de l'entreprise qui l'emploie pour financer le dépôt à son nom et l'enregistrement subséquent au n° 66841 de la marque querellée suivant arrêté du 29 juillet 2011 du directeur général de l'OAPI. Après découverte du pot aux roses

consistant en l'enregistrement du signe dont elle se prévaut d'une antériorité dans l'usage, la société MARINE MARCHANDE va, dans la foulée, mettre un terme aux liens contractuels existants entre elle et le défendeur, et plus tard introduire une action à prétentions doubles, à savoir nullité de l'enregistrement obtenu par sieur KAMGA NENKAM d'une part, et transfert à son profit de la marque litigieuse d'autre part.

Raisonnement : Outre l'examen de la question de la validité dans cette affaire, la Haute Cour a saisi l'occasion pour examiner la question fondamentale de savoir si, en vertu du droit positif de l'OAPI, les tribunaux nationaux des États membres peuvent admettre les demandes de marques. Ce faisant, la cour a déployé le cadre législatif du pays pour les revendications de propriété de marque. Cette question donne au juge l'occasion de déployer le dispositif législatif d'encadrement de la revendication de la propriété des marques. Le nœud du contentieux résidait ici dans les interprétations faites par les prétoires des dispositions combinées des articles 5, alinéa 3, et 47, alinéa 1^{er}, de l'AB, Acte du 24 février 1999. La solution du juge de la cause ne fait aucun doute quant à la distinction nécessaire qu'elle opère entre les procédures de revendication judiciaire et de revendication administrative des marques frauduleusement déposées. Ces deux actions ponctueront nos subséquentes analyses.

En principe, l'Accord de Bangui applicable au moment des faits (ABR-1999) a consacré dans ses dispositions la possibilité d'une revendication administrative de la propriété de la marque. Aux termes de l'article 5, alinéa 3, de l'annexe III de l'ABR-1999, "Si une marque a été déposée par une personne qui, au moment du dépôt, avait connaissance ou aurait dû avoir connaissance du fait qu'une autre personne avait la priorité de l'usage de cette marque, cette dernière personne peut revendiquer auprès de l'Organisation la propriété de la marque pourvu qu'elle effectue le dépôt de ladite marque dans les six mois qui suivent la publication de l'enregistrement du premier dépôt". Ce texte a le mérite de poser clairement les conditions, de fond comme de forme, à satisfaire par tout revendicateur de marque.

Du texte susvisé, trois conditions cumulatives subordonnent au fond le succès de l'action administrative en revendication de propriété des marques, à savoir :

- l'exigence d'un dépôt par l'usurpateur du signe;
- la mauvaise foi de ce dernier; et
- une priorité d'usage dans le chef du revendiquant.

Le défendeur doit également avoir déposé le signe de manière frauduleuse.

En premier lieu, par dépôt du signe, il faudrait qu'il s'agisse d'un dépôt frauduleux du signe par l'usurpateur. Sera qualifié de dépôt frauduleux tout dépôt effectué en violation d'une obligation légale ou conventionnelle, au préjudice de l'usager antérieur du signe. Ce fut

fondamentalement la position du juge dans la célèbre affaire DYNAMOGEN²²⁰ lorsqu'il motive : "Considérant qu'il motive sa décision en ce que le dépôt de la marque DYNAMOGEN par la Société DISTRIMED PHARMA a été réalisé de mauvaise foi en violation d'une obligation conventionnelle dans la mesure où elle avait plutôt reçu un mandat d'enregistrer la marque litigieuse au nom de la Société FAES; qu'en vertu du principe *fraus omnia corrumpit* il y a lieu d'ôter tout effet du dépôt frauduleux querellé".

En ce qui concerne la mauvaise foi du déposant, la rédaction du texte de l'article 5 précise en quoi elle consiste. La jurisprudence s'est plusieurs fois inspirée de cette rédaction pour affirmer que la mauvaise foi réside dans le fait pour ce dernier d'avoir connaissance ou de ne pouvoir ignorer qu'un tiers utilisait déjà le signe en question ou un signe similaire pour les produits ou services similaires ou identiques (principe de spécialité de la marque). En l'absence de mauvaise foi, l'action en revendication sera purement et simplement rejetée. Dans une espèce portée à l'attention du directeur général de l'OAPI, le recours introduit par le revendicateur avait été rejeté du fait de l'incapacité de ce dernier à prouver la mauvaise foi de la défenderesse qui avait, avant le dépôt du signe contesté, procédé à une recherche d'antériorité²²¹.

Cette mauvaise foi doit être appréciée au jour du dépôt de la demande d'enregistrement du signe et se prouve par tout moyen. Enfin, la loi exige un usage antérieur de la marque. La lettre de l'article 5 réserve ainsi l'action en revendication des marques aux personnes qui justifient simplement d'un simple usage. Il importe peu que le porteur de l'action justifie d'un droit exclusif sur le signe. Dans tous les cas, cette utilisation antérieure du signe par la victime de la fraude doit être établie. Dans une décision²²² inédite, la Commission supérieure de recours a eu à rejeter la demande de revendication pour défaut de preuve de la priorité d'usage par le recourant. Dans cette décision, la commission constate : "Qu'il convient de dire et juger que Madame ADIBADJI n'est pas en mesure d'apporter la preuve qu'elle exploitait antérieurement la marque querellée avant son dépôt par Monsieur AGBERE ISSAKA SANOUNOU".

Cumulativement aux conditions de fond, l'Accord de Bangui prescrit une forme particulière pour la demande de revendication administrative. Sur la forme, l'action en revendication de propriété doit satisfaire à deux exigences formelles strictes. Celui préalable du délai de son exercice et celui de l'organe à saisir par la victime du dépôt frauduleux. En ce qui concerne la prescription, les dispositions de l'article 5, alinéa 3, de l'AB, acte du 24 février 1999, enferment la revendication de propriété dans un délai de six mois suivant la publication au BOPI de la marque frauduleusement enregistrée. Dans la

fourchette de ce délai, l'utilisateur doit déposer le signe à l'OAPI en vue d'enregistrement à son profit. Passé ce délai, l'action est prescrite et le demandeur perd définitivement le droit de réclamer la marque. Cette position fut consacrée dans une espèce soumise à l'attention de la CSR de l'OAPI, opposant la société Distrimed Pharma Sarl à la société Faes SA Fábrica Española de Productos Químicos y Farmacéuticos²²³. Une fois introduite, l'instruction se déroule de manière contradictoire devant le directeur général de l'OAPI. Dans ce litige, la société recourant avait effectué le second dépôt du signe revendiqué plus de six mois après la publication de l'enregistrement fait à son profit au BOPI. Sur ce seul manquement à texte encadrant la revendication de propriété des marques, son action a été rejetée.

Quant aux organes administratifs compétents pour connaître le litige de la revendication des marques, il s'agit en premier ressort du directeur général de l'OAPI. En cas de succès de l'action, il est procédé, conformément à la décision rendue par cette autorité, à la radiation de l'inscription faite au profit du déposant malhonnête pour laisser cours à l'examen du dépôt effectué par le demandeur. Par ailleurs, en cas de rejet de la demande de revendication par le directeur général de l'organisation, le revendiquant dispose d'une voie de recours ouverte devant la Commission supérieure de recours, statuant en dernier ressort, dans un délai de 60 jours à compter de la notification de la décision (v. art. 31 al. 2(d) de l'AB, Acte du 24 février 1999).

Alternativement au recours administratif, la revendication d'une marque peut également être introduite devant les tribunaux des États membres. L'ABR-1999 n'a aménagé aucune disposition en ce sens, cette carence ayant été comblée par les dispositions de l'ABR-2015. À ce sujet, deux griefs essentiels contre la procédure engagée par la demanderesse relevaient le débat technique devant le juge de la cause. Celui de la compétence contestée des autorités judiciaires, d'une part, et l'autre relatif au délai de prescription applicable à l'action en revendication de marque.

En premier lieu, sur la compétence des juridictions nationales à connaître de l'action en revendication des marques, il convient de relever d'ores et déjà que la non-consécration d'une revendication judiciaire dans l'AB en vigueur au moment des faits ne doit nullement s'interpréter comme une envie délibérée du législateur d'exclure en la matière le recours aux tribunaux des États membres. Cela est d'autant plus vrai que l'une des spécificités du système OAPI réside dans la dévolution du contentieux né de l'exploitation des titres de propriété industrielle aux juridictions nationales. En d'autres termes, le système OAPI fait des juges nationaux les juges de droit commun du contentieux des titres de propriété industrielle. Mieux, les sanctions des atteintes aux droits de propriété intellectuelle sont par principe du ressort des juridictions de chaque État membre. De ce fait, par application de l'adage "qui peut le plus peut

220 CA Centre, Arrêt n° 257/CIV du 18 mai 2011, *Société Distrimed Pharma Sarl c. Société Faes SA Fábrica Española de Productos Químicos y Farmacéuticos*.

221 Décision n° 00172/CSR/OAPI du 13 novembre 2013 de la CSR de l'OAPI.

222 *Ibid.*

223 Décision n° 0011/19/OAPI/CSR du 18 octobre 2019, *Société Distrimed Pharma Sarl c. Société Faes SA Fábrica Española de Productos Químicos y Farmacéuticos*.

le moins”, le juge national est de facto compétent pour connaître des actions en revendication de propriété. Cette position a d’ailleurs été consacrée par l’art. 47 de l’annexe III de l’ABR-2015 qui dispose :

“Si une marque a été enregistrée par une personne qui, au moment du dépôt, avait connaissance ou aurait dû avoir connaissance du fait qu’une autre personne avait la priorité de l’usage de cette marque, cette personne peut revendiquer la propriété de ladite marque devant la juridiction nationale compétente.”

“Lorsqu’une marque a été acquise en violation d’une disposition légale ou conventionnelle, la partie lésée peut également revendiquer la propriété de ladite marque devant la juridiction nationale compétente.”

Le texte susvisé distingue désormais une procédure de revendication judiciaire devant les juges nationaux et une autre administrative devant l’OAPI²²⁴. En retenant donc sa compétence, le juge de la cause affiche son adhésion à ces principes, ce qui l’obligeait, pour se dessaisir, à faire toute la lumière sur les observations formulées quant à la transposition dans son office, du délai de prescription de six (6) mois.

En effet, à la question de savoir si le délai de prescription posé par la loi dans le cadre du contentieux administratif de la revendication des marques s’étendait au contentieux judiciaire, le juge répond par la négative. En réalité, la décision ici rapportée sert de tremplin pour déblayer les contours de la revendication judiciaire des marques, dont les fondements juridiques n’étaient pas jusqu’ici posés. Dans le corset de la décision du juge, il convient de relever à ce sujet qu’il existe en la matière deux actions en revendication des marques. La première, de *principe*, devant le juge judiciaire et la seconde, d’*exception* devant l’organisation. Pendant que l’action administrative est strictement encadrée dans un délai, de six (6) mois dans l’ABR-1999 et trois (3) mois dans l’ABR-2015, qui court à compter de l’enregistrement de la marque, l’action judiciaire peut être introduite à tout moment, et ne s’encombre pas par conséquent de ce court délai de prescription.

Aristide Fade

O. Marques – Opposition à l’enregistrement d’une marque postérieure – Réitération de l’opposition – Similarité des produits visés – Risque de confusion résultant d’une marque antérieure

Le titulaire d’une marque antérieure enregistrée peut s’opposer à l’enregistrement d’une marque dès lors que les produits couverts par ces marques sont similaires et que la comparaison des signes fait ressortir une

similitude sur le plan phonétique et sur le plan visuel, induisant un risque de confusion pour le consommateur d’attention moyenne.

Commission supérieure de recours auprès de l’OAPI, Décision n° 00175_/OAPI/CSR du 13 novembre 2013, SIEUR ABDOULAYE SACKO c. SOCIÉTÉ AMAR TALEB MALI SARL

Observations :

La décision commentée, rendue par la Commission supérieure de recours auprès de l’OAPI, chargée notamment, selon l’article 31.a) de l’Accord de Bangui, Acte de Bamako de 2015, “de statuer sur les recours consécutifs (...) au rejet des demandes de titre de protection concernant la propriété industrielle”, offre l’occasion de se pencher sur une question classique du droit des marques touchant à la disponibilité du signe susceptible d’être enregistré. Cette disponibilité implique qu’aucun droit antérieur n’ait été constitué sur le signe par un tiers avant la demande d’enregistrement. La règle, qui est en parfaite cohérence avec la fonction essentielle de garantie assurée par la marque, est énoncée par l’article 3 de l’annexe III de l’Accord de Bangui disposant qu’“une marque ne peut être valablement enregistrée si (...) b) elle est identique à une marque appartenant à un autre titulaire et qui est déjà enregistrée, ou dont la date de dépôt ou de priorité est antérieure, pour les mêmes produits ou services ou pour des produits ou services similaires, ou si elle ressemble à une telle marque au point de comporter un risque de tromperie ou de confusion”. On notera au passage que le texte ne vise expressément que l’antériorité constituée par une marque, à la différence d’autres législations qui précisent que l’indisponibilité peut tenir à d’autres droits antérieurs. C’est le cas, par exemple, de l’article 8.4 du règlement 2017/1001 du 14 juin 2017 sur la marque de l’Union européenne, prévoyant la possibilité d’une opposition du “titulaire d’une marque non enregistrée ou d’un autre signe utilisé dans la vie des affaires dont la portée n’est pas seulement locale”, et de l’article L.711-4 du Code français de la propriété intellectuelle, érigeant en principe que “ne peut être adopté comme marque un signe portant atteinte à des droits antérieurs”.

Faits : En l’espèce, c’est bien sur le seul terrain du droit de marque que la question était posée. L’opposant avait déposé à l’OAPI en 2007 dans la classe 30 la marque “Gazelle thé vert de Chine + Logo”. C’est ainsi, en tout cas, que la marque est décrite par la Commission supérieure de recours. En réalité, la consultation de la décision attaquée²²⁵ montre une reproduction présentant la marque sous la forme “China Green Tea Gazelle”. On s’en tiendra cependant dans la suite du commentaire à la forme “Gazelle thé vert de Chine”, seule visée par la Commission. Le demandeur s’opposait, sur la base de l’article 18 de l’annexe III (*article 15 dans la rédaction issue de l’Accord de Bamako de 2015*), à l’enregistrement de la marque “La Gazelle et ses petites”, déposée en 2009 dans les classes 29 et 30. Le directeur général de l’OAPI lui avait donné raison et décidé la radiation en mettant

224 Voir art. 19 al. 1 de l’annexe III de l’ABR-2015.

225 N° 0040/OAPI/DG/DGA/DAJ/SAJ, 11 juillet 2012.

en avant le risque de confusion entre les deux marques. C'était cette décision qui était déférée à la Commission supérieure de recours.

Raisonnement : Trois problèmes distincts étaient soulevés : le premier, de forme, découlait de ce qu'une première opposition avait été déclarée irrecevable (section I); les deux autres, de fond, concernaient l'identité ou la similarité des produits visés par les deux marques en cause (section II) et l'existence entre elles d'un risque de confusion (section III).

I. Recevabilité de l'opposition

La particularité de l'espèce était qu'une première opposition avait été déclarée irrecevable par le directeur général de l'OAPI le 29 juin 2012 "pour inobservation des dispositions de l'article 18" de l'annexe III de l'ABR-1999. Le défendeur en tirait argument pour prétendre qu'un second recours ne pouvait davantage prospérer. Il appartenait, selon lui, au titulaire de la marque antérieure de déférer la décision d'irrecevabilité devant la Commission supérieure de recours. Faute de l'avoir fait, une seconde opposition devait connaître le même sort. À quoi l'opposant répondait que sa première opposition avait été faite, par un conseil trop zélé, avant même la publication de l'enregistrement de la marque querellée, et qu'il était en droit de refaire sa copie dès lors qu'il était encore dans le "délai de six mois à compter de la publication" prévu par le texte.

C'est ce raisonnement que la commission reprend à son compte en constatant que le nouveau recours avait été formé "dans les délais et formes légaux à titre de régularisation après publication", d'où elle déduit sa recevabilité.

La solution mérite une entière approbation. La lettre de l'article 18²²⁶, alinéa 1^{er}, de l'annexe III de l'ABR-1999 ne permettait pas d'opposer à l'opposant une fin de non-recevoir. Même si la nature juridictionnelle de la Commission supérieure de recours prête à discussion²²⁷, il est logique de transposer les règles générales admises en matière de procédure civile, et notamment le principe selon lequel la cause de la fin de non-recevoir peut être régularisée à tout moment. L'essentiel, comme le relève la décision commentée, est que le recours régulier en la forme soit formé avant l'expiration du délai fixé par la loi. On ajoutera que la solution inverse eût été excessivement sévère si l'on tient compte du fait que la commission, en l'état du texte de l'annexe III applicable à l'espèce, en vertu de l'art. 15 de l'annexe III de l'ABR-1999, jugeait "en premier et dernier ressorts".

II. Identité ou similarité des produits visés par les deux marques en cause

Comme le précise l'article 3.b) de l'annexe III de l'ABR-1999, l'antériorité du signe premier ne peut faire obstacle à l'enregistrement du signe second que si l'un

et l'autre visent des "produits ou services similaires". L'article 8.1)b) du règlement européen 2017/1001 se réfère, dans le même sens, à "l'identité ou (à) la similitude des produits ou des services que les deux marques désignent". Il n'y a là que l'application du principe fondamental de "spécialité" dont on a dit à juste titre qu'il était "consubstantiel à la notion du signe distinctif"²²⁸. Le risque de confusion, qui justifie le refus d'enregistrement, n'existe que si les contradicteurs opèrent sur le même marché²²⁹.

Tel était le cas, selon le demandeur en opposition, pour qui sa propre marque "Gazelle thé vert de Chine", et la marque querellée, "La Gazelle et ses petites", étaient utilisées "pour des produits identiques ou similaires". À quoi le défendeur objectait que la sienne couvrait les "produits des classes 29 et 30" alors que la marque opposée à titre d'antériorité ne couvrait "que des produits de la classe 30".

La Commission supérieure de recours se contente, pour répondre à l'objection, de relever la similarité entre la classe 30 et la classe 29. Cette motivation apparaît trop sommaire pour emporter la conviction. Elle repose, en effet, sur le postulat que le principe de spécialité ne déploie ses effets qu'au regard de la classification internationale des produits et services découlant de l'Arrangement de Nice de 1957, plusieurs fois révisé. Or, s'il est vrai que l'article 9, alinéa 2.c) (art. 8.d) dans la rédaction applicable en l'espèce), fait obligation au déposant de mentionner les classes des produits et services en se référant à la classification internationale définie par l'Arrangement de Nice, il commence par énoncer que le dossier doit contenir "l'énumération claire et complète des produits ou des services auxquels s'applique la marque", et le formulaire de l'OAPI "Demande d'enregistrement d'une marque" en tient compte puisqu'il prescrit au déposant d'indiquer dans un cadre spécial, en face de chaque classe revendiquée, les produits visés.

Il est incontestable, en effet, que la classification de Nice n'a pas de portée juridique. Comme l'ont écrit d'éminents spécialistes²³⁰, "le domaine de protection de la marque est déterminé par l'énumération des produits et services et non par référence à la classe administrative"²³¹. C'est donc seulement sous le bénéfice de cette précision que la commission pouvait conclure à la similarité des produits en cause et c'est donc à tort, selon nous, qu'elle s'est bornée à constater que "les deux classes de produits sont similaires car concernant des produits alimentaires".

228 DURRANDE (S), Disponibilité des signes, Juriscl. Marques – Dessins et modèles, Fasc. 7110, 2010, n° 5.

229 Voir en ce sens RAYNARD (J), PY (E) et TRÉFIGNY (P), Droit de la propriété industrielle, Paris (LexisNexis), 2016, n° 374 : "L'antériorité rendant le signe indisponible doit exister dans le segment commercial pour lequel la marque est déposée."

230 AZEMA (J) et GALLOUX (J.-C.), Droit de la propriété industrielle, Paris (Daloz), 7^e éd., 2012, n° 1505.

231 Voir en ce sens en France Cass. com., 17 juin 1980, n° 78-16.098. : Bull. civ. 1980, IV, n° 260 : "La protection de la marque ne s'étend pas nécessairement à tous les produits de la classe dans laquelle elle a été déposée, mais n'est protégée que pour les produits identiques ou de nature voisine de ceux pour laquelle elle a été déposée."

226 Voir art. 15 de l'annexe III de l'ABR-2015.

227 Voir sur ce débat FOMETEU (J), Code OAPI annoté, sous art. 31.

On mentionnera pour mémoire la diversité des produits compris dans la classe 29 (viande, poisson, volaille et gibier; extraits de viande; fruits et légumes conservés, séchés et cuits; gelées, confitures, compotes; œufs, lait et produits laitiers; huiles et graisses comestibles) aussi bien que dans la classe 30 (café, thé, cacao, sucre, riz, tapioca, sagou, succédanés du café, farines et préparations faites de céréales, pain, pâtisserie et confiserie, glaces comestibles, miel, sirop de mélasse, levure, poudre à lever, sel, moutarde, vinaigre, sauces (condiments), épices, glace à rafraîchir). Il aurait fallu indiquer quels étaient, parmi ces deux longues listes, les produits respectivement couverts par la marque “La Gazelle et ses petites” et par la marque “Gazelle thé vert de Chine”. On peine au demeurant, s’agissant de cette dernière, à imaginer qu’elle pût, dans la classe 30, désigner d’autres produits que du thé, sauf à être considérée comme déceptive, c’est-à-dire, selon l’article 3.d) de l’annexe III, “susceptible d’induire en erreur le public” sur la “nature” du produit”.

III. Risque de confusion entre les signes en cause

L’article 3.b) de l’annexe III de l’ABR-1999 dispose que la marque ne peut être valablement enregistrée si, alors qu’elle vise les mêmes produits ou services ou des produits ou services similaires, elle est “identique” à une marque antérieure ou si “elle ressemble à une telle marque au point de comporter un risque de tromperie ou de confusion”. Les deux marques en l’espèce n’étant pas identiques, seule la seconde hypothèse était en cause dans le présent litige. Elle est aussi prévue par l’article 18.1)b) du règlement 2017/101 précité, qui dispose que l’opposition doit être accueillie s’il existe entre la marque antérieure et la marque demandée “un risque de confusion dans l’esprit du public du territoire dans lequel la marque antérieure est protégée”. La différence entre les deux rédactions est mineure, la notion de “confusion” suffisant à conjurer le risque de fraude qu’induit le terme de “tromperie”.

L’opposant faisait valoir que le risque de confusion résultait de ce que, “du point de vue visuel, les deux marques sont constituées de gazelles” et “qu’intellectuellement, les deux signes renvoient à l’idée de l’animal gazelle”. Le défendeur soutenait au contraire que toute confusion était exclue du fait que sa propre marque présentait la particularité de représenter trois gazelles, soit une mère et ses deux petites, et qu’elle incluait en caractères apparents la mention “Gazelle et ses petites”, alors que la marque antérieure était purement figurative, représentant une seule gazelle. Cette dernière affirmation était partiellement inexacte car si la vignette reproduite dans la décision attaquée montrait effectivement une gazelle, elle comportait aussi les mentions “China Green Tea” et “Gazelle”.

Sans répondre sur ce point, la Commission supérieure de recours se prononce en faveur de l’opposant sur la base du raisonnement suivant :

“la comparaison des signes fait ressortir une similitude sur le plan phonétique et sur le plan visuel; en effet, les deux classes de produits sont similaires car concernant des produits alimentaires et visuellement les deux sont représentés par l’animal à deux cornes qui est la gazelle quel que soit le nombre; le consommateur d’attention moyenne verra le terme verbal puis le dessin de la gazelle; il existe dès lors un risque de confusion pour celui-ci lorsqu’il n’a pas les deux marques sous les yeux en même temps ou à l’oreille à des temps rapprochés.”

La démonstration appelle une réserve de forme. La locution “en effet” donne à penser que la similitude entre les signes est la conséquence de la similarité des produits couverts. Or il ne peut évidemment en être ainsi. Il faut d’abord constater la similarité des produits, et, de façon distincte, montrer que les signes sont assez proches pour créer un risque de confusion.

Pour le reste, l’argumentation, reprise quasi textuellement de la décision attaquée, est classique et correspond bien à la méthode généralement préconisée pour apprécier l’existence d’un risque de confusion. Les critères mis en œuvre auraient pu être utilement complétés par ceux visés par le 11^e considérant du règlement européen 2017/1001 précité, qui énonce de façon générale que cette appréciation “dépend de nombreux facteurs et notamment de la connaissance de la marque sur le marché, de l’association qui peut en être faite avec le signe utilisé ou enregistré, du degré de similitude entre la marque et le signe et entre les produits ou services désignés”, d’où la Cour de justice de l’Union européenne a tiré qu’elle “implique une certaine interdépendance entre les facteurs pris en compte, et notamment la similitude des marques et celle des produits ou services couverts”, en ce sens que, par exemple, “un faible degré de similitude entre les produits ou services couverts peut être compensé par un degré élevé de similitude entre les marques, et inversement”²³². Où l’on voit le lien entre la question de la similarité des produits et services et celle du risque de confusion.

André Lucas

P. Marque – Respect de la procédure d’homologation obligatoire des produits phytosanitaires – Fait justificatif – Contrefaçon

Le respect par le présumé contrefacteur de la procédure d’homologation obligatoire des produits phytosanitaires instituée par l’administration compétente ne constitue pas un fait justificatif de l’atteinte aux droits du titulaire d’une marque enregistrée pour couvrir ces produits. Fait par conséquent une mauvaise application de la loi la cour d’appel qui rejette l’action en contrefaçon initiée par le titulaire d’une marque au motif que le

232 Cour de justice de l’Union européenne, Arrêt du 22 juin 1999, *Lloyd Schuhfabrik Meyer & Co. GmbH c. Klijsen Handel BV*, C-342/97, ECLI:EU:C:1999:323, point 19.

présupposé contrefacteur s'est conformé à cette procédure administrative en dépit de la similitude avérée entre les deux signes en conflit.

Cour suprême du Cameroun, Arrêt n° 04/COM du 6 décembre 2018, SOCIÉTÉ SINOCAM SARL c. SOCIÉTÉ AFCOTT CAMEROUN SARL

Observations :

Dans le cadre du procès civil en contrefaçon de marque, le présumé contrefacteur dispose d'une kyrielle de moyens de défense pour se soustraire à une éventuelle condamnation. Il peut notamment invoquer le défaut de qualité à agir, la nullité de la marque prétendue contrefaite pour divers motifs, la forclusion par tolérance, etc. Abstraction faite de la contestation de la validité de la marque invoquée, le jugement de la Cour suprême du Cameroun rapporté nous fournit l'occasion d'examiner un moyen de défense atypique soulevé par une défenderesse en contrefaçon, à savoir le respect de la procédure d'homologation de la commercialisation des produits contrefaisants. La Cour suprême du Cameroun a posé sans détours que le respect de cette formalité administrative ne constitue pas un fait justificatif de la contrefaçon, censurant ainsi une cour d'appel qui s'est fondée sur ce moyen pour rejeter l'action en contrefaçon initiée par le titulaire d'une marque.

Faits : Un bref rappel des faits est nécessaire : la société SINOCAM Sarl, titulaire de la marque "LAMIDA GOLD 90 EC + logo" n° 71469 pour les produits de la classe 1 découvre fortuitement la commercialisation des mêmes produits revêtus du signe contrefaisant "LAMIDA COT 90 EC" par la société AFCOTT CAM Sarl dans divers entrepôts de Douala et assigne celle-ci par devant le tribunal de grande instance de cette ville aux fins de voir constater la contrefaçon de sa marque :

- cesser toute fabrication et toute distribution du produit "LAMIDA COT 90 EC" sous astreinte de FCFA 500 000 par infraction constatée;
- ordonner la saisie et la destruction de tout le stock des produits contrefaisants; et
- condamner ladite société à lui payer la somme de FCFA 100 000 000 à titre de dommages et intérêts.

La société défenderesse a soulevé deux moyens de défense d'inégale importance, à savoir :

- la nullité de la marque "LAMIDA GOLD 90 EC + logo" pour défaut de distinctivité; et
- la licéité de la commercialisation des produits "LAMIDA COT 90 EC".

Le jugement du tribunal de grande instance du Wouri n° 167/Com du 6 avril 2016 donnant gain de cause à la société SINOCAM Sarl a été infirmé par la cour d'appel suivant arrêt n° 040/Com du 7 novembre 2016.

La SINOCAM Sarl s'est pourvue en cassation.

Raisonnement : La question centrale posée aux juges de la haute juridiction était de savoir si un présumé contrefacteur peut se prévaloir du respect des conditions de commercialisation des produits ou services revêtus de la marque contrefaisante pour se soustraire du grief de contrefaçon. Accessoirement, les hauts magistrats étaient appelés à se prononcer sur l'effectivité du caractère distinctif de la marque invoquée. Statuant en la cause, la Cour suprême a indiqué que le respect de la procédure d'homologation n'est pas un fait justificatif de la contrefaçon (section II) sans toutefois se pencher véritablement sur la question non moins importante de la distinctivité de la marque invoquée (section I).

I. La distinctivité, condition de validité de la marque

Devant la cour d'appel, la société AFCOTT CAM Sarl a principalement contesté la validité de la marque LAMIDA GOLD 90 EC + logo motif pris de ce qu'elle est générique et donc dépourvue du caractère distinctif, lequel s'apprécie par rapport au signe invoqué pris isolément (A) et aux produits ou services auxquels il se rapporte (B).

A. Le signe objet du dépôt

Il importe de souligner d'emblée qu'une marque ne peut être valablement enregistrée si elle est dépourvue de caractère distinctif. Cette exigence formulée à l'article 3.a) de l'annexe III de l'Accord de Bangui, Acte du 22 février 1999, est largement partagée par la doctrine spécialisée²³³. La prohibition des marques dénuées de caractère distinctif permet d'exclure de la protection les marques constituant la désignation nécessaire ou générique. Selon ANDRÉ R. BERTRAND, est générique le signe ou le terme qui désigne non pas un produit ou un service précis mais la catégorie, l'espèce ou le genre auxquels ils appartiennent, ou un type de produits ou de services sans que le consommateur leur attribue une origine particulière²³⁴. Albert Chavanne et Jean-Jacques Burst définissent la marque générique comme celle qui est constituée uniquement par l'appellation usuelle du produit désigné ou du service offert²³⁵. Cette exclusion a pour finalité de lever toutes entraves inutiles à la liberté du commerce et de l'industrie en permettant que les termes génériques puissent être librement utilisés par les concurrents. C'est précisément l'argument décisif développé par la société AFCOTT CAM Sarl qui a prétendu que le terme LAMIDA, qui désigne une variété d'insectes, était l'appellation générique du produit chimique mis au point pour le combattre. La cour d'appel a abondé dans le même sens à travers un considérant assez évocateur nonobstant sa maladresse rédactionnelle : "... dans le cadre de la recherche et de la mise sur le marché des produits pharmaceutiques ou phytosanitaires, les promoteurs ont le droit d'utiliser les formules se rattachant aux germes à combattre, sans que cela porte atteinte aux droits de celui qui a obtenu un brevet, dès lors que l'intonation de l'appellation des produits litigieux est différente".

233 BERTRAND (A. R.), n.204, p. 53; également à ce sujet PASSA (J.), n.82, p. 83.

234 Voir BERTRAND (A. R.), n.80, p. 112.

235 Voir CHAVANNE (A.) et BURST (J.-J.), Droit de la propriété industrielle, 3^e éd., Paris (Daloz), 1990, p. 583

Or, les juges d'appel semblent avoir perdu de vue la nature complexe de la marque LAMIDA GOLD 90 EC + logo qui résulte de la combinaison d'éléments verbaux et figuratifs. L'appréciation de la distinctivité d'une telle marque doit porter sur l'ensemble du signe et non sur un seul élément verbal en l'espèce le terme "LAMIDA", fût-il générique. Et même dans cette hypothèse extrême, la jurisprudence autorise de façon constante une personne à déposer comme marque un terme générique en lui adjoignant un ou plusieurs éléments arbitraires, en sorte que l'ensemble, considéré comme un tout indivisible, puisse avoir un pouvoir attractif autonome. La jurisprudence française indique par exemple que si le terme "Agenda" ne peut constituer une marque valable pour désigner des agendas, il est possible de protéger les signes "Agenda XY", "Agenda" ou le mot "agenda" présenté dans une calligraphie particulière et non usuelle pour désigner les mêmes produits²³⁶. Dans une telle perspective, si le titulaire de la marque ne peut interdire ni s'opposer à l'utilisation par ses concurrents des éléments non distinctifs compris dans la marque, en l'espèce le terme "LAMIDA"²³⁷, il peut néanmoins s'attaquer aux reproductions serviles ou quasi serviles intégrant les éléments arbitraires qui lui confèrent sa distinctivité. Il s'ensuit que la méthode d'appréciation mise en œuvre par la cour d'appel, consistant à extraire l'élément verbal "LAMIDA" de la marque "LAMIDA GOLD 90 EC + logo" pour retenir le grief de caractère générique, est loin d'être conforme à l'orthodoxie. La Cour suprême ne s'est guère préoccupée de cet important aspect du litige, s'étant à l'évidence limitée aux moyens soulevés par le demandeur au pourvoi. En tout état de cause, le caractère générique d'un signe, qu'il soit complexe ou simple, s'apprécie aussi et surtout par rapport aux produits désignés ou aux services offerts.

B. Les produits ou services visés dans l'acte d'enregistrement

Les produits désignés ou les services offerts jouent un rôle déterminant dans l'accession d'une marque à la distinctivité. Ainsi qu'il a été indiqué ci-avant, un signe est dépourvu de caractère distinctif dès lors qu'il constitue la désignation nécessaire ou générique du produit ou la composition du produit ou du service auquel il est associé. Rappelons-le : la société AFCOTT CAM Sarl a associé le terme "LAMIDA" à une variété d'insectes décrite et nommée depuis 1859 par ALLATA WALKER, et souligné que cette appellation est depuis lors consacrée par les scientifiques pour désigner le produit chimique destiné à les combattre.

Il est impératif, à ce stade de la réflexion, d'identifier avec précision les produits visés dans l'acte d'enregistrement de la marque "LAMIDA GOLD 90 EC + logo" pour pouvoir en définitive apprécier le caractère générique attribué

à ce signe par la défenderesse au pourvoi. La société SINOCAM a soutenu, pour écarter ce grief, que

- sa marque a été enregistrée pour les produits de la classe 1, c'est-à-dire les produits chimiques destinés particulièrement à l'agriculture, l'horticulture et la sylviculture et non aux insectes;
- qu'un insecte, fût-il appelé LAMIDA, n'est pas un produit ou la composition d'un produit dans le commerce, encore moins le nom commun des fongicides-pesticides-insecticides, le marché des produits phytosanitaires étant rempli de produits de diverses marques et dénominations;
- il s'en infère que le grief de caractère générique articulé par la société AFCOTT CAM Sarl n'est qu'une simple vue de l'esprit, le terme "LAMIDA" n'étant pas la désignation nécessaire ou générique des produits visés dans le certificat d'enregistrement de la marque revendiquée;
- sa caractérisation comme telle par AFCOTT CAM Sarl était donc fantaisiste.

L'on pourrait a fortiori spéculer sur le caractère fortement évocateur ou suggestif de la marque "LAMIDA GOLD 90 EC + logo" si l'on s'en tient du moins à la perception que pourrait en avoir le public de référence composé en majorité d'agriculteurs. En effet, il est parfaitement envisageable que dans la communauté des utilisateurs du signe revendiqué, le terme "LAMIDA" à lui seul puisse suggérer ou évoquer plus ou moins directement les produits revêtus de la marque "LAMIDA GOLD 90 EC + logo". Mais il faut dire avec Jérôme Passa que cette orientation comporte une grande part de subjectivité²³⁸. De toutes les façons, il est admis que l'appréciation du caractère générique d'un signe relève de l'appréciation souveraine du juge du fond qui très souvent s'appuie sur les résultats des enquêtes et sondages seuls susceptibles d'établir que pour la majorité des consommateurs ou des utilisateurs, il désigne un type ou une catégorie de produits plutôt qu'un produit d'origine déterminée²³⁹. Quoiqu'il en soit, la marque "LAMIDA GOLD 90 EC + logo" associée aux produits de la classe 1 revêt à notre sens un caractère distinctif nonobstant le versant plus ou moins suggestif du terme "LAMIDA" qui, pris isolément, est inapte à assurer la fonction de la marque qui est précisément de permettre au consommateur ou au destinataire final du produit ou du service de reconnaître celui-ci par rapport à ceux de ses concurrents et, partant, d'identifier l'entreprise titulaire de la marque²⁴⁰.

II. Les moyens de défense du présumé contrefacteur

La société AFCOFF CAM Sarl a par ailleurs soutenu qu'elle n'a commis aucune faute car non seulement le signe "LAMIDA COT 90 EC" qu'elle exploite ne comporte aucun risque de confusion avec la marque revendiquée

236 Voir en ce sens CA Paris, 10 mars 1994 : PIBD 1994, III, n° 568, p. 325; Cass. com., 24 janvier 1995 : Bull. civ., IV, n° 25; CA Paris, 9 novembre 2001 : PIBD 2002, III, n° 737, p. 106.

237 Une personne ne peut en effet réserver un terme descriptif ou générique désignant un produit ou un service au détriment de ses concurrents opérant dans le même secteur d'activités. Un tel terme est, pourrait-on dire, dans le domaine public et donc à la disposition de tous.

238 Voir PASSA (J.), n.82, p. 93.

239 Voir BERTRAND, (A. R.), n.80, p. 114.

240 Voir en ce sens REBOUL (Y.), La Marque : outil stratégique pour l'entreprise, in : La propriété intellectuelle au service du développement de l'Afrique, Mélanges offerts à Denis Ekani, Collection de l'OAPI n° 4, Paris (L'Harmattan), 2012, pp. 108 et s.

(A), mais en plus la commercialisation des produits qui en sont revêtus a été homologuée par l'autorité compétente (B).

A. L'absence du risque de confusion

Les juges d'appel ont estimé qu'il n'y avait aucun risque de confusion entre les signes "LAMIDA GOLD 90 EC + logo" et "LAMIDA COT 90 EC" en s'appuyant sur l'absence d'imitation, la différence de l'intonation de l'appellation des produits litigieux et de leurs emballages, l'absence de déception pour la clientèle.

Cette position nous semble curieuse pour au moins deux raisons. D'une part, à l'examen des signes querellés, l'imitation saute aux yeux sur le double plan orthographique et phonétique. Singulièrement sous l'angle orthographique, il est patent que la société AFCOTT CAM Sarl a repris de façon servile les éléments caractéristiques dominants de la marque "LAMIDA GOLD 90 EC + logo", lesquels lui confèrent son autonomie distinctive²⁴¹. Il s'agit en l'occurrence des éléments verbaux "COT 90 EC", la différence résultant de la substitution de la lettre G par la C étant si insignifiante qu'elle peut passer inaperçue aux yeux du consommateur d'attention moyenne. L'imitation aurait été problématique en l'espèce si la société AFCOTT CAM Sarl s'était contentée de reprendre les éléments non distinctifs compris dans la marque à savoir le terme "LAMIDA", encore que le caractère générique de cet élément reste à établir au regard des produits dont il est revêtu.

D'autre part, pour apprécier le risque de confusion, les juges d'appel se sont curieusement placés du point de vue du consommateur ayant en même temps les deux produits sous les yeux puisqu'ils ont indiqué : "... Qu'ainsi, au moment de l'achat de l'un quelconque des deux produits, le client ne saurait éprouver un quelconque embarras sur son choix mais ne peut qu'y être conforté et rassuré", alors qu'il est admis tant en doctrine qu'en jurisprudence que le juge doit se placer du point de vue du consommateur d'attention moyenne n'ayant pas en même temps les deux signes sous les yeux ou à l'oreille. À titre de droit comparé, la Cour de cassation française vérifie systématiquement si les juridictions inférieures se sont conformées à cette exigence²⁴².

B. L'absence de faute

La société AFCOTT CAM Sarl soutient qu'elle commercialise les produits "LAMIDA COT 90 EC" après s'être conformée à la procédure instituée par le Décret n° 2005/0772/PM du 6 avril 2005 fixant les conditions d'homologation et de contrôle des produits phytosanitaires et qu'aucune faute ne peut par conséquent lui être imputée. La cour d'appel a indiqué que cette société n'avait commis aucune faute étant donné que la Commission d'homologation des produits concernés veille au respect des droits des éventuels

concurrents, s'affranchissant à tort des dispositions de l'Accord de Bangui qui régissent les conditions de protection et d'exploitation des marques des produits destinés à la commercialisation.

Il y a dans la démarche de la cour d'appel un véritable mélange de genre ! La Commission d'homologation des produits phytosanitaires ne peut en effet se substituer à l'OAPI qui est l'organe institutionnel chargé d'enregistrer les marques, encore moins aux juridictions de l'ordre judiciaire compétentes pour la mise en œuvre des droits résultants. L'homologation, comme l'a fort opportunément souligné la société SINOCAM, est "un processus au terme duquel l'autorité compétente approuve l'utilisation d'un produit phytosanitaire, après examen des données scientifiques complètes montrant que le produit est efficace pour les usages prévus et ne présente pas de risque pour la santé humaine, animale et pour l'environnement, dans telles conditions d'emploi recommandées". C'est dire qu'après s'être conformée à cette procédure, la société AFCOTT CAM Sarl aurait dû se rapprocher de sa consœur la SINOCAM, titulaire incontestée de la marque "LAMIDA GOLD 90 EC + logo", en vue de négocier les conditions d'utilisation de ladite marque dans le cadre d'une licence contractuelle. L'article 7, alinéa 2, de l'annexe III de l'Accord de Bangui révisé confère en effet à la SINOCAM Sarl le droit d'empêcher tous les tiers agissant sans son consentement de faire usage au cours d'opérations commerciales de signes identiques ou similaires à ceux pour lesquels la marque "LAMIDA GOLD 90 EC + logo" a été enregistrée. La société AFCOTT CAM Sarl n'ayant obtenu aucune autorisation l'habilitant à exploiter le signe "LAMIDA COT 90 EC" semblable à la marque revendiquée, le grief de contrefaçon articulé à son encontre est plus qu'à suffire caractérisé.

C'est donc à bon droit que la cour régulatrice a désapprouvé les juges d'appel en indiquant que la procédure d'homologation obligatoire des produits phytosanitaires n'est pas un fait justificatif d'une atteinte à un droit de propriété intellectuelle, rétablissant ainsi l'ordre juridique manifestement mis à mal par l'arrêt infirmatif attaqué.

Max Lambert Ndéma Elongué

Q. **Appréciation du risque de confusion – Marque complexe – Théorie du tout indivisible – Organes administratifs OAPI – Tribunaux des pays membres**

L'appréciation du risque de confusion, s'agissant d'une marque complexe, se fait selon la méthode à la fois abstraite et globale. Abstraite par référence au contenu de l'enregistrement et à un personnage fictif dit consommateur d'attention moyenne qui n'a pas les deux produits en même temps sous les yeux et à l'oreille. L'appréciation est en outre globale en ce sens qu'elle doit être fondée sur l'impression d'ensemble produite par les marques en conflit, en tenant compte en particulier de leurs éléments distinctifs et dominants. Par

241 Voir CA Centre (Yaoundé), Arrêt n° 536/COR du 6 novembre 2013, *Tobacco FZCO c. Rothmans of Pall Mall Ltd* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 3, section Q).

242 Voir Cass. com., 26 novembre 2003 : PIBD 2004, n° 780, III, p. 100; Cass. com., 18 février 2004 : PIBD 2004, III, n° 788, p. 360.

conséquent, un tribunal fait erreur s'il refuse de conclure à la contrefaçon sans vérifier au préalable le risque de confusion allégué, en fondant sa décision sur le fait que l'OAPI, bien qu'elle soit habilitée à le refuser, ait approuvé l'enregistrement de la marque incriminée.

Cour d'appel du Centre (Yaoundé), Arrêt n° 536/Civ du 6 novembre 2013, THE INDEPENDENT TOBACCO FZCO c. ROTHMANS OF PALL MALL LTD

Observations :

Le risque de confusion qui conditionne la qualification de contrefaçon d'une marque s'apprécie selon la méthode dite globale consacrée par la Cour de justice des communautés européennes dans l'affaire SABEL lorsqu'elle affirme que "le risque de confusion doit être apprécié globalement en tenant compte de tous les facteurs pertinents du cas d'espèce"²⁴³. Le risque de confusion est une notion centrale en droit des marques permettant d'établir la ressemblance entre deux signes en conflit. Selon un éminent auteur, le risque de confusion peut prendre plusieurs formes. Il peut être direct : c'est le cas où le public confond ou risque de confondre la marque et le signe. Il peut aussi être indirect lorsque le public distingue les deux signes mais risque, en suite d'un rapprochement entre eux, de penser qu'ils sont exploités par le même titulaire. Le risque de confusion existe encore lorsque le public, tout en distinguant à la fois les signes et leurs exploitants, peut penser que ceux-ci entretiennent des liens qui peuvent, notamment, justifier un même souci de qualité²⁴⁴. Dans l'arrêt ci-dessus rapporté, la cour d'appel du Centre a fait sien la méthode d'appréciation globale à l'occasion d'un conflit ayant opposé les sociétés The Independent Tobacco FZCO et Rothmans of Pall Mall Limited.

Faits : Les faits sont simples : la société The Independent Tobacco est titulaire de la marque "Business Royal" suivant arrêté du directeur général de l'OAPI n° 06/1318/OAPI/DG/SSD daté du 15 septembre 2006 portant enregistrement d'une marque. Prétendant avoir un droit exclusif et antérieur sur le signe "ROYAL" pour l'avoir déposé et fait enregistrer les 17 mars 1997, et le 6 novembre 2001, à travers les marques respectives "Rothmans Royals Label" et "Royals", la société Rothmans of Pall Mall LTD a saisi le tribunal de grande instance du Mfoundi en nullité de l'enregistrement de la marque "Business Royal" et en paiement des dommages et intérêts.

Par jugement du 26 janvier 2011, le tribunal fit droit à sa demande. La société The Independent Tobacco interjeta appel de cette décision.

Raisonnement : Les juges d'appel étaient appelés à se prononcer sur la question de savoir : l'OAPI, organe institutionnel d'enregistrement des marques, est-elle habilitée à apprécier le risque de confusion au même titre que les juridictions de l'ordre judiciaire? La cour a

répondu par la négative en déboutant l'appelante de son action motif pris de ce que non seulement l'OAPI a enregistré plusieurs autres marques portant le label "Royals" sans aucune protestation, mais en plus, il existe d'autres éléments tels la couleur et le logo suffisants pour distinguer lesdites marques à considérer chacune comme un tout indivisible. Si cette décision a le mérite de rappeler la méthode d'appréciation du risque de confusion en ce qui concerne les marques complexes, elle pourrait toutefois laisser faussement croire que cette opération relève à la fois de l'OAPI et de l'autorité judiciaire.

Pourtant, l'examen de la demande auquel procède l'Organisation préalablement à l'enregistrement d'une marque est une opération purement administrative (section I), alors que l'appréciation du risque de confusion relève de l'office du juge (section II).

I. L'examen de la demande d'enregistrement, une opération purement administrative

La motivation de la cour conduit à considérer d'une part le contenu de l'examen (A) et, d'autre part, la portée de l'examen (B).

A. Le contenu de l'examen

Saisi d'une demande d'enregistrement d'une marque, l'OAPI examine si les conditions quant à la forme, visées aux articles 8 et 9 de l'annexe III de l'accord, sont remplies et si les taxes exigibles ont été acquittées²⁴⁵. Les conditions de forme dont il s'agit sont relatives au nombre d'exemplaires de la demande, à la preuve du paiement de la taxe du dépôt, au pouvoir du mandataire, à la reproduction de la marque comportant l'énumération des produits ou services auxquels elle s'applique, le ou les classes de produits ou services. L'Organisation vérifie en outre si la marque objet du dépôt est contraire à l'ordre public, aux bonnes mœurs ou aux lois²⁴⁶ ou si elle imite, reproduit ou contient parmi ses éléments des armoiries, drapeaux ou autres emblèmes, etc.

À la vérité, il s'agit d'un examen de fond de portée limitée puisque l'OAPI ne recherche pas d'office si le signe est disponible, tant cette recherche est délicate, aléatoire et de toute façon tributaire des prétentions de titulaires des antériorités²⁴⁷. Il en est ainsi de l'appréciation du risque de confusion qui est essentiellement variable, en sorte que l'Office de propriété industrielle ne peut valablement se livrer à un tel exercice au moment de l'examen de la demande d'enregistrement. C'est pourquoi il se contente d'enregistrer les marques qui satisfont aux conditions minimales sus-énumérées, priorité étant due au premier déposant sous réserve d'une éventuelle contestation par des tiers. Ceux-ci peuvent en effet contester une marque offensante soit devant le directeur général de l'OAPI par la voie de l'opposition ou par le moyen de la revendication de propriété de marque, soit alors devant

243 Voir Cour de justice de l'Union européenne, Arrêt du 11 novembre 1997, *Sabel BV c. Puma AG, Rudolf Dassler Sport*, C-251/95, ECLI:EU:C:1997:528.

244 Voir PASSA (J.), n.82, p. 303.

245 Cf. art. 14 al. 1 de l'annexe III de l'ABR-1999; l'art. 18 de l'ABR-2015 reprend *in extenso* cette disposition.

246 Cf. art. 3-C de l'annexe III de l'ABR-1999; Cf. art. 18 al. 2 de l'ABR-2015.

247 PASSA (J.), n.82, p. 159.

les instances judiciaires pour en solliciter l'annulation. En somme, le titre délivré au terme de l'examen est essentiellement précaire, sa validité pouvant être remise en cause à chaque instant par des tiers en raison du risque de confusion qu'il comporte avec leurs signes ou leurs produits ou services. Il s'en infère que l'examen effectué par l'OAPI a une connotation purement administrative, mais aussi et surtout une portée limitée.

B. La portée de l'examen

L'examen de la demande d'enregistrement opéré par les services compétents de l'OAPI n'est pas complet en ce sens que l'office ne vérifie pas la disponibilité du signe pour lequel l'enregistrement est envisagé, en particulier si celui-ci est susceptible de créer la confusion dans l'esprit du public avec celles antérieurement enregistrées. Cette vérification s'effectue a posteriori par le juge saisi d'une contestation. Ainsi, l'arrêté consacrant l'enregistrement d'une marque ne s'impose pas au juge qui se réserve le droit de le rapporter dès lors que le risque de confusion entre ladite marque et celles antérieures est avéré.

De ce point de vue, la position de la cour s'écarte de l'orthodoxie. Cette juridiction relève dans ses motifs "qu'il est en effet manifeste que le terme 'Royals' a un caractère distinctif suffisant ainsi que le soutient la société Rothmans of Pall Mall LTD, en sorte que si le risque de confusion déploré était effectif, l'Organisation africaine de la propriété intellectuelle qui est l'organe institutionnel de contrôle et d'enregistrement des marques n'aurait point consenti à enregistrer plusieurs autres marques comportant ce label ni à son profit ni en faveur des autres sociétés non concurrentes qui n'ont pas jusque-là protesté", reconnaissant alors à l'OAPI un pouvoir souverain d'appréciation du risque de confusion lors de l'examen de la demande d'enregistrement, appréciation qui s'imposerait au juge de l'ordre judiciaire. Une telle approche qui confère à l'OAPI des prérogatives exorbitantes consacre par ailleurs la prééminence des décisions administratives émanant de cette Organisation sur celles des juridictions de l'ordre judiciaires. Pourtant, il résulte de l'article 18 des dispositions générales de l'accord que les décisions des juridictions de l'ordre judiciaires des États membres s'imposent aux organes statutaires de l'Organisation²⁴⁸. Dans tous les cas, les décisions judiciaires définitives sont communiquées à l'Organisation qui est tenue de les exécuter²⁴⁹. En tout état de cause, les décisions rendues par les organes statutaires de l'OAPI au terme de l'examen des demandes qui leur sont soumises n'ont qu'une valeur administrative et peuvent être révoquées par le juge judiciaire.

248 L'art. 18 des dispositions générales de l'Accord de Bangui, Acte du 22 février 1999 indique en effet que "Les décisions judiciaires définitives rendues sur la validité des titres dans l'un des États membres en application des dispositions du texte des annexes I à X au présent accord font autorité dans tous les autres États membres, exceptées celles fondées sur l'ordre public et les bonnes mœurs". Cette disposition, qui consacre en effet la prééminence des décisions émanant des juridictions de l'ordre judiciaire sur celles des organes statutaires de l'OAPI, a été modifiée par l'ABR-2015.

249 Voir sur cette question NDEMA ELONGUE (M.-L.), De la portée des décisions rendues par les tribunaux en matière de propriété intellectuelle, in : Mélanges en l'honneur de l'action de Dr Paulin EDOU EDOU, Poitiers (Juriscope), 2017, p. 299.

II. Les méthodes d'appréciation du risque de confusion

L'appréciation du risque de confusion d'une marque complexe est une opération à la fois abstraite (A) et globale (B).

A. L'appréciation abstraite du risque de confusion

L'appréciation est abstraite parce qu'elle s'opère par référence au contenu de l'enregistrement, et à un personnage abstrait. La comparaison s'opère d'abord par référence au contenu de l'enregistrement, c'est-à-dire en tenant compte des marques telles qu'elles ont été déposées et décrites dans leur certificat d'enregistrement respectif sans égard aux conditions dans lesquelles ces signes sont utilisés sur le marché²⁵⁰. Dans un arrêt rendu le 18 février 2004, la Cour de cassation française a curieusement écarté un pourvoi qui faisait valoir que "le droit sur la marque portant sur le signe lui-même tel qu'il a été déposé pour désigner certains produits ou services, les conditions dans lesquelles les signes en cause sont utilisés ne peuvent être prises en compte pour l'appréciation du risque de confusion"²⁵¹. Dans l'espèce commentée, la comparaison doit porter sur les seuls éléments verbaux qui constituent les marques en conflit, à savoir "BUSINESS ROYALS" et "ROYALS" associées à leurs spécialités respectives, encore qu'il ne ressort pas des faits que l'une ou l'autre est exploitée sur un graphisme particulier ou accompagnée d'un élément figuratif non visé dans l'enregistrement.

La jurisprudence exige par ailleurs de tenir compte, pour apprécier le risque de confusion, du plus ou moins grand caractère distinctif de la marque invoquée, en l'espèce le signe "ROYALS" enregistré depuis les 17 mars 1997 et 6 novembre 2001 et qui a depuis lors acquis un certain rayonnement sur le marché des produits dont elle est revêtue. C'est sans aucun doute cette circonstance qui a motivé le premier juge à invalider la marque "BUSINESS ROYALS" enregistrée postérieurement, c'est-à-dire le 24 avril 2004 pour les mêmes produits, à savoir ceux de la classe 24, celle-ci étant manifestement susceptible de créer une confusion dans l'esprit du public de référence, qui aurait facilement pensé que le signe "BUSINESS ROYALS" constitue une déclinaison de la marque première "ROYALS" ou que les deux marques en conflits appartiennent au même titulaire²⁵².

L'appréciation abstraite du risque de confusion s'opère également par référence à un personnage abstrait dit consommateur d'attention moyenne²⁵³. La Commission supérieure de recours auprès de l'OAPI a par contre

250 Voir en ce sens CA Paris, 30 mars 2005 : PIBD 2005, III, n° 812, p. 423.

251 Voir Cass.com., 18 février 2004 : PIBD 2004, III, n° 787, p. 333, cité par PASSA (J.), n.82, p. 305.

252 Voir en ce sens CA Paris, 27 juin 2003 : PIBD 2003, n° 775, III, p. 581 et CA Bordeaux, 1^{er} mars 2004 : PIBD 2004, III, n° 786, p. 296

253 La jurisprudence française définit de façon constante ce personnage comme le consommateur moyen de la catégorie de produits concernés censé être normalement informé et raisonnablement attentif et avisé. La Cour de cassation française vérifie systématiquement si la cour d'appel s'est placée du point de vue du consommateur d'attention moyenne : Cass.com., 26 novembre 2003 : PIBD 2004, III, n° 780, p. 100; Cass.com., 18 février 2004 : PIBD 2004, III, n° 788, p. 360, cités par PASSA (J.), n.82, p. 309.

dégagé une définition du consommateur d'attention moyenne qui semble se démarquer de celle retenue par la Cour de cassation française. La Commission indique, en effet, dans plusieurs décisions, que pour déterminer le consommateur d'attention moyenne, "...les références à des jurisprudences des zones de développement et de scolarisation plus accentués ne sauraient être décisives en raison de leur relativité par rapport à l'impératif ressorti"²⁵⁴, pour enfin évoquer la notion de "consommateur d'attention moyenne de la zone OAPI"²⁵⁵. Vivement que les tribunaux de l'ordre judiciaire des États membres de l'OAPI donnent un contenu à cette notion qui joue un rôle de choix dans l'appréciation du risque de confusion. Dans l'arrêt rapporté, la cour s'est contentée de mettre en parallèle les éléments verbaux des marques belligérantes sans se placer du point de vue du consommateur moyen de la catégorie des produits concernés, toutes choses ayant débouché sur une comparaison imparfaite desdits signes.

L'appréciation du risque de confusion peut en outre se faire selon une méthode globale.

B. L'appréciation globale du risque de confusion

Dans l'affaire SABEL évoquée plus haut, la Cour de justice des Communautés européennes précise que "l'appréciation globale doit, en ce qui concerne la similitude (...) des marques en cause, être fondée sur l'impression d'ensemble produite par celles-ci, en tenant compte en particulier de leurs éléments distinctifs et dominants". C'est dire que la méthode globale suppose la prise en compte, entre autres, de l'impression d'ensemble produite par les signes sur le consommateur défini ci-avant, et du caractère distinctif élevé de la marque invoquée. La prise en compte de l'impression d'ensemble produite par les marques en conflit exclut l'extraction d'un élément isolé de ladite marque pour ne limiter l'examen qu'à cet élément. C'est la substance du reproche que la cour semble faire au premier juge lorsqu'elle souligne avec force que :

- a. "Considérant par ailleurs qu'il n'est pas contesté en l'espèce que les marques respectives 'Rothmans Royals' et 'Business Royal' sont complexes en ce qu'elles sont constituées de plusieurs éléments;
- b. qu'aux termes de la jurisprudence en la matière pour vérifier l'existence d'un risque de confusion entre des marques de ce type, l'appréciation de la similitude devrait se faire non par considération de l'une des composantes du concept retenu comme marque, mais bien au travers de l'examen de chacune des désignations prises dans son ensemble;
- c. qu'en d'autres termes, l'appréciation du risque de confusion allégué devrait se faire sur la base de l'ensemble des éléments constitutifs de chacune des marques concernées".

Si cette motivation paraît conforme sur le principe, elle est toutefois insuffisante en ce qu'elle ne prend pas en considération le caractère distinctif élevé que peut avoir un élément particulier de la marque invoquée dont la reproduction peut être génératrice de confusion.

Tel semble être le cas du terme "ROYALS" qui apparaît comme étant l'unique élément identificateur de la marque dans l'esprit du public de référence pour les produits concernés, en sorte que l'adjonction du qualificatif "BUSINESS" ne fait pas perdre à la marque "ROYALS" son individualité et son pouvoir distinctif propre. Certes, en dehors de la dénomination, la cour a évoqué d'autres éléments tels la couleur et le logo pour distinguer lesdites marques à considérer chacune comme un tout indivisible, sans pour autant les spécifier, mettant ainsi l'analyste dans l'impossibilité d'en apprécier la pertinence. En tout état de cause, la décision rapportée semble avoir été insuffisamment motivée, ce qui l'expose à la censure de la juridiction régulatrice.

Max Lambert Ndéma Elongué

R. Saisie conservatoire – Distraction de la marque – Cessionnaire – Preuve de la propriété de la marque – Validité de la cession

Le succès de l'action en distraction d'une marque initiée par le cessionnaire est subordonné à la preuve de la validité de la cession, nonobstant l'obtention par celui-ci du renouvellement de l'enregistrement en son nom auprès de l'Organisation africaine de la propriété intellectuelle, la propriété de la marque n'étant valablement transférée que sur le fondement d'un contrat de cession dont la validité est consolidée.

Tribunal de grande instance hors classe de Niamey, Ordonnance de référé n° 176 du 5 août 2008, SOCIÉTÉ ROTHMANS OF PALL MALL Limited SWITZERLAND c. SOCIÉTÉ ADIL COMPANY SA et EL HADJ SANI SOULEY NA SALEY

Observations :

La décision ci-dessus rapportée illustre les difficultés rencontrées par les acteurs du système judiciaire de l'OAPI dans l'application des règles et principes du droit de la propriété intellectuelle.

Faits : À première vue centrés sur l'application du droit des saisies issus de l'Acte uniforme OHADA relatif aux procédures simplifiées de recouvrement des créances et des voies d'exécution, les faits de la cause soulèvent en réalité des questions pertinentes de droit de propriété intellectuelle.

La marque de cigarettes "ROTHMANS KING SIZE FILTER", propriété de la société ROTHMANS OF PALL MALL Limited de Staedle 36, Vaduz 94.90, principauté de Liechtenstein, a fait l'objet d'une saisie conservatoire en date du 20 novembre 2017 pour sûreté et avoir paiement de la somme de FCFA 100 000 000 et FCFA 50 000 000

254 Voir Décisions n° 034/CSR/OAPI, n° 035/CSR/OAPI, n° 036/CSR/OAPI, n° 37/CSR/OAPI, n° 038/CSR/OAPI, n° 039/CSR/OAPI datées du 26 mars 2004.
255 Voir Décision n° 47/CSR/OAPI du 1^{er} avril 2005.

respectivement au profit de la société ADIL COMPANY SA et de sieur EL HADJ SANI SOULEY NA SALEY.

S'estimant désormais véritable propriétaire de la marque litigieuse pour l'avoir acquise de sa consœur la société ROTHMANS OF PALL MALL LIMITED de Saedle 31, Vaduz 94.90 en vertu d'un contrat de cession du 9 mai 2002, la société ROTHMANS OF PALL MALL LIMITED Switzerland ayant son siège social en Suisse a assigné les saisissants par devant le juge des référés du tribunal de grande instance de Niamey aux fins de distraction de ladite marque sur le fondement de l'article 141 de l'Acte uniforme OHADA susvisé.

Pour faire échec à la demande, les saisissants ont fait valoir

- a. d'une part que la convention portant cession de la marque est irrégulière pour défaut de légalisation de la signature et défaut d'indication de l'étendue de la cession; et
- b. d'autre part, que ladite cession ne leur est pas opposable pour n'avoir pas été inscrite au registre spécial des marques en violation de l'article 27 de l'annexe III de l'Accord de Bangui révisé, Acte du 22 février 1999.

Raisonnement : Deux problèmes juridiques étaient soumis à l'examen du tribunal saisi : la convention portant cession de la marque est-elle valable? Ladite cession est-elle opposable aux tiers? Le succès de la demande en distraction était dès lors tributaire de :

- I. la validité de la convention portant cession de la marque; et
- II. son opposabilité aux tiers.

I. La validité de la convention portant cession de la marque

Les défendeurs ont contesté la validité de la cession, fondement du droit de propriété de la demanderesse en distraction, sur le double terrain du droit commun (A) et du droit de la propriété intellectuelle (B).

A. L'appréciation de la validité de la cession sur le terrain du droit commun

La société ADIL COMPANY SA et sieur EL HADJ SANI NA SALE ont conclu à l'irrégularité de la cession motif pris du défaut de légalisation des signatures des parties au contrat, toute chose ne permettant pas de lui conférer date certaine. Il va sans dire que cette question relève du droit commun notamment des règles relatives aux conditions de formation du contrat. La cession querellée ayant été conclue à Londres, le juge nigérien a estimé à tort qu'en raison de cet élément d'extranéité, les conditions de forme de ladite convention échappent à son contrôle. En droit international privé le juge du for est compétent pour régler, sur le fondement de la loi applicable, un différend né d'une relation présentant un élément d'extranéité. Après avoir indiqué à bon droit qu'en droit international privé, les formalités de validité des contrats sont celles prévues par la législation du lieu

de formation, le juge s'est malencontreusement dérobé, alors même qu'il se devait de vérifier si le droit anglais prévoit la formalité de légalisation des signatures comme condition dirimante de validité des contrats, ce qui aurait *ipso facto* influencé l'issue de la demande en distraction de la marque.

B. L'appréciation de la validité de la cession sur le terrain du droit des marques

L'article 26.2) de l'annexe III de l'Accord de Bangui révisé dispose : "Les actes comportant soit transmission de propriété, soit concession de droit d'exploitation ou cession de ce droit, soit gage ou mainlevée de gage relativement à une marque doivent, sous peine de nullité, être constatés par écrit". Il résulte de cette disposition que sous réserve des conditions de validité des conventions prévues par le droit commun, la seule exigence issue du droit des marques et dont l'inobservation entraîne la nullité de la convention de cession d'une marque est l'écrit²⁵⁶. Il y a là un particularisme par rapport au droit commun gouverné par le principe du consensualisme, l'écrit n'étant exigé qu'exceptionnellement *ad validitatem*, c'est-à-dire comme condition de validité de la convention. Cette question n'a pas été formellement débattue dans le cas d'espèce, la convention querellée ayant été de toute évidence passée par écrit et dans le respect des dispositions spécifiques au droit des marques²⁵⁷.

Les défendeurs en distraction ont toutefois soutenu que cette convention était muette quant aux modalités de la cession querellée en ce qu'elle n'indique pas si elle est partielle ou totale²⁵⁸. Le défaut d'indication dans un contrat de cession de marque de l'étendue de la cession entache-t-il ladite convention de nullité? Le juge a éludé cette question qui, à ses yeux, relève de la législation anglaise des contrats : "Attendu qu'en droit international privé, les formalités de validité des contrats sont celles prévues par la législation du lieu de formation; que les conditions de forme d'une convention conclue à Londres échappent au contrôle du juge nigérien". Or, si l'on peut s'accorder avec le juge, en ce que l'exigence de la légalisation des signatures relativement au contrat querellé soulève une question de droit international privé, le défaut d'indication de l'étendue matérielle de la cession d'une marque est une question de droit interne relevant de l'annexe III de l'Accord de Bangui révisé qui est la loi nationale du Niger en matière de marques de produits ou de services, en application de l'article 3 des dispositions générales de l'ABR-1999²⁵⁹. En tout état de cause, le défaut d'indication de l'étendue de la cession dans le contrat y relatif n'entache pas pour autant ladite convention d'irrégularité. L'article 26, alinéa 1, de l'annexe III de l'Accord de Bangui révisé qui prévoit la transmissibilité en totalité ou en partie des droits

256 Cf. art. 29 al. 3 de l'annexe III de l'ABR-1999; art. 32 al. 3 de l'annexe III de l'ABR-2015.

257 Cf. art. 29 al. 3 art. 30-2 de l'annexe III de l'ABR-2015.

258 Cf. art. 26 al. 3 de l'annexe III de l'ABR-1999; art. 32 al. 1 de l'ABR-2015.

259 Cf. art. 5 al. 1 de l'ABR-2015 qui indique que les droits afférents aux domaines de la propriété intellectuelle, tels que prévus par les annexes au présent accord, sont des droits nationaux indépendants, soumis à la législation de chacun des États membres dans lesquels ils ont effet.

attachés à une marque ne sanctionne pas du moins expressément l'inobservation de cette formalité par la nullité de la cession.

II. L'opposabilité de la convention portant cession de la marque

La société ADIL COMPANY SA et sieur EL HADJ SANI NA SALE ont en outre fait valoir l'inopposabilité de la convention de cession de la marque querellée motif pris de sa non-publication dans le registre spécial des marques tenu à l'OAPI. Cet argumentaire postule un examen intrinsèque de la formalité d'inscription (A) et de sa portée (B).

A. Les modalités de l'inscription de la cession au registre spécial des marques

Deux points seront successivement examinés, à savoir le contenu de l'inscription et l'auteur de l'inscription. En ce qui concerne le contenu de l'inscription, il importe de souligner que l'OAPI tient, pour l'ensemble des États membres, des registres spéciaux dans lesquels sont inscrits certains renseignements se rapportant aux différents objets de propriété intellectuelle à la date de leur enregistrement et pendant leur vie. Les contenus desdits registres varient selon le titre de propriété industrielle considéré. S'agissant précisément des marques de produits ou de services, les articles 16 et 17 de l'annexe III de l'Accord de Bangui révisé prévoient l'insertion de plusieurs données au registre spécial des marques, notamment :

- le numéro d'ordre de la marque;
- la date de dépôt de la demande d'enregistrement;
- la date de l'enregistrement;
- la date de priorité si celle-ci est revendiquée;
- le nom commercial ou les nom, prénom, adresse du titulaire de la marque;
- une reproduction de la marque; et
- l'indication des classes des produits ou de service sur lesquels porte l'enregistrement.

Ces renseignements sont identiques à ceux contenus dans le certificat d'enregistrement délivré initialement au déposant après examen satisfaisant de sa demande par les instances compétentes de l'OAPI.

Bien plus, les événements qui surviennent pendant la vie de la marque, en l'occurrence le renouvellement, la radiation, les décisions judiciaires définitives, sont inscriptibles au registre spécial de marques. Cette énumération, qui est loin d'être exhaustive, s'étend aux actes visés à l'article 26.2) de l'annexe III de l'ABR-1999, à savoir la concession des droits d'exploitation, la cession de ce droit, le gage ou la mainlevée de gage, c'est du moins ce qui ressort de l'interprétation de l'article 27.1) de cette annexe. L'article 27 de l'annexe III de l'ABR-1999 précise en ce sens que "Les actes mentionnés à l'article 26 précédent ne sont opposables aux tiers que s'ils ont été inscrits au registre spécial des marques tenu à l'Organisation". L'Acte de BAMAKO apporte sur ce point une précision supplémentaire en subordonnant l'opposabilité aux tiers à une double formalité, à savoir

l'inscription au registre spécial des marques et la publication au Bulletin officiel²⁶⁰. Sont concernés :

- les actes comportant transmission de propriété de la marque notamment la convention de cession d'une marque;
- les actes comportant cession d'une concession de droit d'exploitation à l'instar d'une sous licence; et
- les actes comportant gage ou mainlevée de gage tel le nantissement d'une marque.

Au bénéfice de ce qui précède, il va sans dire que la convention du 9 mai 2002 portant cession de la marque "ROTHMANS KING SIZE FILTER" intervenue entre les sociétés ROTHMANS OF PALL MALL LIECHTENSTEIN et ROTHMANS OF PALL MALL Suisse était inscriptible au registre spécial des marques. Pourtant il ressort des faits de la cause que cette formalité de publicité n'a pas été accomplie. Mais qui devait en prendre l'initiative?

Le juge a indiqué, au visa de l'article 21, alinéa 5, de l'annexe III de l'ABR-1999, que l'inscription de la convention de cession de la marque litigieuse au registre spécial idoine incombe aux instances de l'OAPI et non au cessionnaire, la société Suisse ROTHMANS OF PALL MAL. Or, l'inadéquation des dispositions de l'article 21.5 de l'annexe III susvisé à la situation litigieuse est évidente d'autant plus que ce texte vise l'inscription du renouvellement de l'enregistrement d'une marque au registre spécial y afférent, et non l'inscription requise en cas de cession de la marque. Il s'agit de deux formalités indépendantes l'une de l'autre donnant lieu au paiement de taxes distinctes. Par ailleurs, la publication de la marque "ROTHMANS KING SIZE FILTER" au Bulletin officiel de la propriété industrielle (BOPI) par la société requérante n'implique pas nécessairement que celle-ci a requis avec succès l'inscription de la cession dont elle se prévaut au registre spécial des marques tel que prescrite par l'article 27.1) de l'annexe III de l'Accord de Bangui révisé aux fins d'opposabilité aux tiers. L'inscription de la cession au registre idoine par l'OAPI est subordonnée à une demande préalable formulée par celui qui y a intérêt, en l'occurrence le cessionnaire sur qui repose en définitive cette obligation, l'Organisation se bornant à effectuer les opérations matérielles y afférentes.

B. La portée de l'inscription de la cession au registre spécial des marques

L'inscription de la cession d'une marque au registre spécial des marques semble être facultative (2). Mais une fois réalisée, elle produit des effets de droit (1).

1. Les effets de l'inscription de la cession au registre spécial des marques

Le défaut d'inscription de la convention de cession d'une marque au registre spécial des marques est sanctionné par l'inopposabilité de cette convention aux tiers à l'égard desquels elle est censée n'avoir jamais existé en application de l'article 27.1) de l'annexe III de l'ABR-1999²⁶¹. Cette disposition, qui transpose en droit de la propriété

²⁶⁰ Cf. art. 31 al. 1 de l'annexe III de l'ABR-2015.

²⁶¹ Cf. art. 31 al. 2 de l'ABR-2015.

intellectuelle le principe de l'effet relatif des conventions posé à l'article 1165 du Code civil napoléonien, est reprise par les annexes de l'Accord de Bangui relatives au brevet d'invention²⁶², aux modèles d'utilité²⁶³, aux dessins et modèles industriels²⁶⁴, aux noms commerciaux²⁶⁵, aux schémas de configuration des circuits intégrés²⁶⁶. Dans l'espèce commentée, il est évident que la convention du 9 mai 2012 portant cession de la marque "ROTHMANS KING SIZE FILTER" n'a pas été inscrite au registre spécial des marques. Elle ne pouvait par conséquent pas être valablement opposée aux créanciers saisissant à l'égard desquels elle est censée n'avoir jamais existé. C'est donc à tort que le juge s'y est fondé pour ordonner la distraction de la marque querellée.

2. L'inscription de la cession au registre spécial des marques : une simple faculté?

Aucune disposition expresse de l'annexe III de l'Accord de Bangui révisé n'oblige les parties à un contrat de cession d'une marque d'en requérir l'inscription au registre spécial des marques. En revanche, dans l'hypothèse d'une concession du droit d'exploitation d'une marque, la loi en fait une formalité dirimante. L'article 29, alinéa 4, de l'annexe III de l'Accord de Bangui révisé dispose en effet que : "le contrat de licence doit être inscrit, au registre spécial des marques, de l'Organisation...". Certes, l'instruction administrative n° 414 semble combler ce vide juridique puisqu'elle prévoit l'accomplissement de cette formalité en cas de cession de marque. Mais il convient de relativiser la portée juridique de ce texte pour au moins deux raisons : d'une part, ces instructions élaborées par la direction générale de l'OAPI ont une valeur résiduelle dans l'ordonnancement juridique de cette Organisation et ne peuvent de ce fait valablement suppléer la carence du législateur. D'autre part, elle a un champ restreint en ce qu'elle ne vise que l'hypothèse d'une cession partielle, encore que cette disposition ne soit pas impérative. L'on est dès lors en droit de soutenir que la société suisse n'était pas tenue de requérir l'inscription de la cession du 9 mai 2002 au registre spécial des marques, l'inobservation de cette formalité étant du reste sans incidence sur la validité dudit contrat.

Max Lambert Ndéma Elongué

S. Saisie conservatoire de marque – Saisissabilité de la marque – Fondement juridique – Modalités – Lieu de la saisie

La marque est un bien au sens du droit civil susceptible de réalisation forcée, sur le fondement des articles 54 et suivants de l'Acte uniforme portant procédures simplifiées de recouvrement et des voies d'exécution, la procédure devant être conduite, dans le silence de la législation communautaire, suivant les modalités

prévues pour la saisie des valeurs mobilières et des droits d'associés.

Fait toutefois une mauvaise application de la loi le juge d'instance qui valide une saisie conservatoire de marque pratiquée entre les mains de la structure nationale de liaison plutôt qu'au siège de l'OAPI, seule structure habilitée à détenir et gérer les titres de propriété industrielle.

**Tribunal de grande instance hors classe de Niamey,
Ordonnance de référé n° 118 du 20 mai 2008,
ROTHMANS OF PALL MALL LIMITED SA c. SOCIÉTÉ ADIL
COMPANY et EL HADJ S.S**

Observations :

La marque de produits ou de services telle que régie par les dispositions de l'annexe III de l'Accord de Bangui révisé, Acte du 24 février 1999, est un bien susceptible de réalisation forcée conformément aux articles 28 et suivants de l'Acte uniforme portant organisation des procédures simplifiées de recouvrement et des voies d'exécution. Tel est le principe posé par la décision ci-dessus rapportée. En effet, le droit communautaire OAPI n'ayant pas réglementé les saisies des propriétés intellectuelles, seul le droit commun des saisies a vocation à s'appliquer, la marque, au même titre que les autres actifs de propriété industrielle, étant un bien au sens civiliste du terme. À titre de droit comparé, la possibilité de la saisie d'une marque apparaît dans l'article R 714-4 du Code de propriété intellectuelle français, la partie législative n'indiquant aucune procédure de saisie de cet objet de propriété intellectuelle. La saisie des brevets est en revanche expressément autorisée par l'article L 616-21 dudit code qui dispose : "La saisie d'un brevet est effectuée par acte extrajudiciaire signifiée au propriétaire du brevet, à l'Institut national de la propriété industrielle ainsi qu'aux personnes possédant des droits sur le brevet; elle rend inopposable au créancier saisissant toute modification ultérieure des droits attachés au brevet".

Ce relatif ostracisme est aggravé par le silence du nouveau Code des procédures civiles d'exécution français qui n'a pas intégré plusieurs voies d'exécution portant sur les objets immatériels²⁶⁷. L'on remarquera que sous les deux cieux et beaucoup plus en Afrique, le droit des voies d'exécution semble se désintéresser des propriétés intellectuelles qui peuvent pourtant représenter des valeurs pécuniaires importantes et des garanties sans précédent au profit des créanciers de leurs propriétaires. L'on voit dès lors se profiler à l'horizon les difficultés inhérentes à la détermination du régime juridique de la saisie de marque en ce qui concerne spécialement son fondement juridique et sa mise en œuvre, ce d'autant que s'agissant des pays membres de l'OHADA, l'Acte uniforme précité ne traite pas expressément de la saisie des propriétés intellectuelles mais bien plutôt de la saisie des valeurs mobilières et des droits d'associés. En effet,

262 Cf. art. 34 al. 1 de l'annexe de l'ABR-1999.

263 Cf. art. 29 al. 1 de l'annexe II de l'ABR-1999.

264 Cf. art. 21 al. 1 de l'annexe IV de l'ABR-1999.

265 Cf. art. 15 al. 3 de l'annexe V de l'ABR-1999.

266 Cf. art. 19 al. 1 de l'annexe IX de l'ABR-1999.

267 Voir HUGON (C.), La réalisation forcée des propriétés intellectuelles en droit français : Les cahiers de droit, Vol. 59 (Z), 2018, pp. 425 à 440. Disponible en ligne à l'adresse suivante : <https://doi.org/10.7202/1048587ar>.

Le titre VII de l'Acte uniforme portant organisation des procédures simplifiées de recouvrement et des voies d'exécution est intitulé "Dispositions particulières à la saisie des droits d'associés et des valeurs mobilières". Aucune disposition particulière n'a été prise pour les brevets d'invention, les marques de produits ou de services, le droit d'auteur et les droits voisins, etc. Ces difficultés de mise en œuvre qui assombrissent le ciel des créanciers des titulaires des propriétés incorporelles transparaissent à quelques égards de l'affaire ayant généré les décisions dont analyse.

Faits : Il ressort des faits qu'en exécution des grosses des arrêts n° 124 du 5 juin 2006 et n° 235 du 16 octobre 2006 de la cour d'appel de Niamey condamnant la société ROTHMANS OF PALL MALL LTD à payer les sommes de FCFA 100 000 000 et FCFA 50 000 000 respectivement à la société ADIL Cie et à sieur EL HADJ SANI pour saisie-contrefaçon abusive, ces derniers ont fait pratiquer, le 20 novembre 2007, saisies conservatoires sur la marque de cigarettes "Rothmans King Seize Filter" numéro 37 610, appartenant à leur débiteur commun entre les mains de la structure nationale de liaison de l'OAPI.

Aux termes de l'article 2 du Règlement fixant le cadre de collaboration entre l'OAPI et les structures nationales de liaison adopté au cours de la 47^e session ordinaire du Conseil d'administration de l'OAPI, la structure nationale de liaison est une administration publique nationale ou toute autre structure placée sous l'autorité du responsable du département en charge de la propriété industrielle. Elle constitue le relais de l'OAPI auprès des utilisateurs des services de l'Organisation. Cette saisie fut annulée par la cour d'appel de Niamey suivant arrêt n° 26 du 5 mars 2008 motif pris de la violation des dispositions des articles 54, 88 et 238 de l'Acte uniforme susvisé.

Les 25 et 26 mars de la même année, la société ADIL Cie et sieur EL HADJ SANI ont fait pratiquer deux nouvelles saisies déferées une fois de plus en annulation par devant le tribunal de grande instance hors classe de Niamey. La société Rothmans Of Pall Mall limited a prétendu, d'une part, que l'Acte uniforme sur les procédures simplifiées de recouvrement et des voies d'exécution ne saurait régir la saisie d'une marque, bien insaisissable, qui relève de l'Accord de Bangui révisé du 24 février 1999 et que, d'autre part, c'est à tort que ladite saisie a été pratiquée entre les mains de la structure nationale de liaison à Niamey, à savoir le Ministère du commerce. Les saisissants ont en revanche soutenu que la marque était un bien incorporel saisissable sur le fondement de l'Acte uniforme OHADA précité. Deux questions d'inégale valeur étaient posées à la cour : la marque est-elle un bien saisissable? Dans l'affirmative, sur quel fondement et selon quelles modalités?

Raisonnement : Si la cour d'appel de Niamey a posé sans détour le principe de la saisissabilité de la marque (section I), elle n'a cependant pas épuisé la question sous-jacente des modalités d'exécution de ladite saisie (section II).

I. Le principe de la saisissabilité d'une marque

Si la possibilité de réalisation forcée d'une marque de produits ou de services ne soulève pas a priori de difficultés particulières en raison de la nature juridique de cet actif de propriété industrielle (A), le fondement juridique de cette opération doit être précisé, les choses étant moins simples qu'il n'y paraît (B).

A. La nature juridique de la marque

La question de la saisissabilité de la marque soulevée par la société ROTHMANS OF PALL MALL Limited est tributaire de l'admission de cet objet de propriété intellectuelle au rang des biens tels qu'appréhendés par le Code civil²⁶⁸. Il va sans dire que la marque rentre dans la catégorie des meubles elle-même répartie en deux sous-catégories juridiques distinctes, à savoir les meubles corporels et les meubles incorporels. Les biens meubles corporels sont ceux susceptibles d'appréhension matérielle, alors que les biens meubles incorporels sont des droits portant sur une chose mobilière. Cette distinction a un intérêt juridique sans précédent relativement aux règles qui gouvernent leur réalisation forcée, l'immatérialité des seconds apparaissant peu ou prou comme un facteur de complication de cette procédure. S'agissant en particulier des meubles incorporels, l'on distingue généralement les droits mobiliers par leur objet, les droits personnels mobiliers, et les droits mobiliers par détermination de la loi au rang desquels les propriétés intellectuelles.

Vue sous cet angle, la marque dont la propriété est acquise au titulaire après enregistrement à l'office de propriété industrielle compétent est un bien qui ne saurait échapper à l'emprise des créanciers, lesquels ont la latitude de la mettre sous mains de justice. Dans l'espèce commentée, la marque de cigarette "ROTHMAN KING SIZE FILTER" déposée à l'OAPI le 27 mars 1997 et enregistrée sous le n° 37 610 est sans contredit la propriété de la société ROTHMANS OF PALL MALL Limited. C'est donc à bon droit que les créanciers de cette société, en l'occurrence la société ADIL Cie et sieur EL HADJ SANI, bénéficiaires des créances respectives de FCFA 116 716 800 et de FCFA 58 867 946 en principal et frais consolidés par des titres exécutoires, ont cru devoir faire saisir ladite marque pour se faire payer sur le prix de la vente de cet objet de propriété industrielle.

B. Le fondement juridique de la saisie de marque dans l'espace OAPI

Le fondement juridique de la réalisation forcée des propriétés intellectuelles doit être naturellement recherché dans le Code de la propriété intellectuelle dont le mutisme est surprenant (1) et alternativement dans les codes de procédures civiles d'exécution en vigueur au sein des États membres de l'OAPI (2).

268 D'après l'art. 516 du Code civil français de 1804 encore applicable dans certains pays membres de l'OAPI à l'instar du Cameroun, tous les biens sont meubles ou immeubles. Il faut toutefois préciser que les règles issues dudit code ont été conçues à propos des choses corporelles et c'est par analogie que s'opère leur application aux droits intellectuels.

1. Le mutisme de l'Accord de Bangui

Les différentes versions de l'Accord de Bangui qui est le code de la propriété intellectuelle des pays membres de l'OAPI ne règlementent pas la saisie des propriétés intellectuelles, laissant alors cette question à la discrétion des États membres. Ce choix du législateur communautaire réitéré dans l'accord signé à Bamako le 14 décembre 2015 pourrait s'expliquer d'une part par le fait que dès l'origine, l'OAPI a entendu régir le droit matériel de la propriété intellectuelle pour l'ensemble des pays signataires, tout en renvoyant sous quelques réserves les questions de procédure d'ordre civil et pénal aux législateurs nationaux. L'Accord de Bangui a en effet élaboré quelques règles de procédure spécifiques ayant vocation à s'appliquer dans tous les pays membres, jetant ainsi les bases d'un mouvement d'harmonisation des principes directeurs du procès dans l'espace OAPI. Il s'agit notamment de :

- la règle selon laquelle les actions civiles relatives à certains titres de propriété industrielle sont portées devant le tribunal civil et jugées comme matières sommaires;
- la compétence exceptionnelle des tribunaux correctionnels habilités à connaître des questions de nullité, déchéance, ou celles relatives à la propriété des titres;
- les délais de saisine du juge du fond après une saisie-contrefaçon;
- l'exigence de la plainte préalable de la victime pour la mise en mouvement de l'action publique; et
- la communication de certaines causes au ministère public, etc.

La démarche des plénipotentiaires de l'OAPI pourrait d'autre part se justifier par le refus de s'immiscer dans un domaine désormais réservé par sa consœur l'OHADA, étant observé que la quasi-totalité des pays membres de l'OAPI ont adhéré au traité de Port Louis²⁶⁹. Toutefois, l'Accord de Bangui évoque au passage la cession et le gage de certains titres de propriété industrielle, en l'occurrence le brevet d'invention²⁷⁰, le modèle d'utilité²⁷¹, la marque de produits ou de services²⁷², les dessins et modèles industriels, etc. Il est important de souligner que le gage de la marque n'est envisagé par l'Accord de Bangui que sous l'angle de l'exigence d'un écrit. Rien n'est dit au sujet de son régime juridique, le législateur communautaire renvoyant alors implicitement aux législations nationales relatives au droit des sûretés mobilières. En tout état de cause, dans le silence de l'Accord de Bangui, s'agissant de la réalisation forcée des propriétés intellectuelles, c'est le droit commun en vigueur dans les États membres qui a vocation à s'appliquer tel que relevé à juste titre par le juge du tribunal de grande

instance de Niamey dans l'ordonnance de référé n° 118 du 20 mai 2008.

2. L'applicabilité de l'Acte uniforme OHADA relatif aux voies d'exécution

Abordant la question de l'applicabilité de l'Acte uniforme relatif aux voies d'exécution, le juge du tribunal de grande instance hors classe de Niamey relève :

- a. "Attendu qu'il ressort des dispositions de l'article 337 de l'AUPSRVE que le présent Acte uniforme sera applicable aux mesures conservatoires, mesures d'exécution forcée et procédures de recouvrement engagées après son entrée en vigueur;
- b. Attendu qu'en l'espèce, il s'agit d'une contestation de saisie, c'est-à-dire une mesure d'exécution forcée qui est déferée à notre appréciation;
- c. Que comme le soutient le requis, seules les dispositions de l'OHADA régissent les voies d'exécution et ce quel que soit la matière ou le bien-fondé sur lequel porte la saisie ou la mesure conservatoire".

Le raisonnement semble justifié surtout au regard des dispositions de l'article 337 convoqué par le juge, l'État du Niger ayant ratifié le traité de Port Louis qui se substitue d'office à sa législation antérieure en matière de voies d'exécution. Par ailleurs, l'on peut trouver, dans l'article 56 de l'Acte uniforme sur les voies d'exécution, un fondement légal à la saisie de la marque. Ce texte dispose en effet que : "la saisie conservatoire peut porter sur tous les biens mobiliers, corporels ou incorporels appartenant au débiteur. Elle les rend indisponibles". Il s'ensuit que les prétentions de la société ROTHMANS OFF PALL MALL Limited selon lesquelles les dispositions de l'OHADA ne peuvent être appliquées aux marques puisqu'elles sont régies par l'Accord de Bangui révisé le 24 février 1999 sont simplement spécieuses.

Quelques réserves sont cependant permises au regard de la nature particulière de la marque objet de la saisie qui s'accommode mal avec un régime juridique conçu sur le modèle des choses corporelles. L'immatérialité de la marque commande en effet l'adoption des dispositions spéciales tenant compte de cette spécificité. Il est dès lors surprenant que le Titre VII de l'Acte uniforme précité consacré aux dispositions particulières à la saisie des droits d'associés et des valeurs mobilières ait occulté les propriétés intellectuelles. Est-ce une simple omission ou un choix délibéré du législateur? Quoi qu'il en soit, ce traitement discriminatoire des biens incorporels préfigure les difficultés de mise en œuvre de la saisie de marque.

II. La mise en œuvre de la saisie de marque

Les difficultés de mise en œuvre de la saisie de marque proviennent de ce que le dispositif juridique sus-évoqué ne fournit aucune indication sur la procédure à suivre. Par conséquent, des hésitations sont permises quant au modèle sur lequel cette saisie peut se greffer sans trahir la spécificité de la marque qui en est l'objet. Dans

269 L'accord du 9 mai 2016 entre l'OAPI et l'OHADA précise en son art. 1^{er} que les objectifs et les missions de ces deux organisations sous-régionales sont similaires et complémentaires en ce qui concerne l'amélioration de l'environnement juridique et judiciaire en vue de la sécurisation des investissements économiques dans leurs États membres.

270 Cf. art. 33 de l'annexe I de l'ABR-1999; art 36 al. 2 de l'annexe I de l'ABR-2015.

271 Cf. art. 31 al. 2 de l'annexe II de l'ABR-2015.

272 Cf. art. 26 al. 2 de l'annexe III de l'ABR; art. 30 al. 2 de l'annexe III de l'ABR-2015.

l'espèce ci-dessus rapportée, la détermination du lieu de l'exécution de la saisie (A) et des formalités à observer aux fins d'opposabilité (B) est émaillée d'incertitudes.

A. Le lieu d'exécution de la saisie

Le juge du tribunal de grande instance hors classe de Niamey a donné gain de cause aux créanciers poursuivants qui ont fait pratiquer la saisie conservatoire sur la marque querellée entre les mains du Ministère du commerce de l'État du Niger, toute chose réprouvée par le débiteur saisi pour qui la saisie devrait plutôt être opérée au siège de l'OAPI à Yaoundé.

Pour y parvenir, le juge a posé "que la marque a été saisie comme bien incorporel et entre les mains de la représentation de l'OAPI qu'est la structure nationale de liaison qui en effet, est la seule mandataire agréée de l'Organisation africaine de la propriété intellectuelle au Niger". Cette motivation appelle au moins deux observations : premièrement, la structure nationale de liaison en l'espèce le Ministère du commerce du Niger dont le rôle a été circonscrit ci-avant n'est pas un mandataire agréé auprès de l'OAPI, mais bien plutôt une administration publique nationale placée sous l'autorité du chef du département ministériel au sein duquel elle est logée et qui sert de courroie de transmission entre l'OAPI et les usagers. La profession de mandataire est organisée par le Règlement issu de la résolution n° 48/13 dans le cadre de la 48^e session ordinaire du conseil d'administration qui s'est tenue à Brazzaville le 16 décembre 2008. Il résulte des articles 2 et suivants de ce texte que la profession de mandataire est une profession libérale, le mandataire étant défini comme une personne physique ou morale habilitée à agir sur mandat, à titre professionnel ou non, pour le compte d'une personne physique ou morale, en vue d'effectuer auprès de l'Organisation africaine de la propriété intellectuelle des opérations de propriété intellectuelle. Sous ce rapport, une administration publique ne saurait jouer le rôle de mandataire.

Cette administration, en vertu de l'article 6, alinéa 2, des dispositions générales de l'Accord de Bangui révisé, est habilitée à recevoir les demandes des titres de propriété industrielle émanant des usagers domiciliés sur son territoire à charge de transmettre lesdites demandes à l'OAPI dans un délai de cinq (5) jours ouvrables à compter du dépôt. La seconde observation découle de la première : la structure nationale de liaison ne détient pas les titres de propriété industrielle et n'assure pas non plus leur gestion quotidienne. Il semble par conséquent artificiel de pratiquer une saisie, fût-elle conservatoire, entre les mains d'un non-détenteur de l'objet ciblé, en l'occurrence le Ministère du Commerce du Niger.

En revanche, une telle saisie pourrait valablement être opérée entre les mains de l'OAPI précisément dans son siège à Yaoundé, cette organisation étant seule habilitée non seulement à délivrer les certificats d'enregistrement de marques mais en plus à en assurer la détention et la gestion quotidienne. Cette solution présente le désavantage d'être dispendieuse pour les créanciers domiciliés hors du siège de l'OAPI, lesquels courent de

surcroît le risque de se voir refuser l'exequatur par la juridiction compétente du pays hôte, en l'occurrence le Cameroun, s'agissant d'une décision étrangère dont l'exécution est envisagée localement. L'on pourrait au final déboucher sur une impasse!

L'option consistant à faire pratiquer la saisie conservatoire de marque au siège de l'OAPI nous paraît plus conforme aux dispositions de l'article 236 de l'Acte uniforme OHADA relatif aux voies d'exécution applicables *mutatis mutandis*, lesquelles précisent, s'agissant de la saisie des droits d'associés et des valeurs mobilières, que "la saisie est effectuée soit auprès de la société ou de la personne morale émettrice, soit auprès du mandataire chargé de conserver ou de gérer les titres". C'est d'ailleurs au visa de cette disposition que le tribunal de grande instance hors classe de Niamey a validé la saisie pratiquée entre les mains du Ministère du commerce du Niger. Or, il a été abondamment démontré plus haut que ce département ministériel ne conserve ni ne gère les titres de propriété industrielle. L'incertitude annoncée est encore accentuée lorsque l'on envisage le formalisme nécessaire aux fins d'opposabilité de la saisie de marque.

B. Les formalités aux fins d'opposabilité

Dans l'espèce commentée, la saisie a été pratiquée auprès de la structure nationale de liaison, à savoir le Ministère du commerce de l'État du Niger entre les mains de qui l'acte a été délaissé. Or, tel que démontré ci-haut, l'irrégularité de cette démarche viole les dispositions de l'article 236 de l'Acte uniforme sur les voies d'exécution. Ce fut d'ailleurs l'un des reproches formulés par la société ADIL Cie SA contre la saisie querellée. Classiquement et dans le droit fil des dispositions des articles 236 et suivants de l'Acte uniforme relatif aux voies d'exécution, la procédure de saisie des biens incorporels repose sur une double notification : une première notification à l'adresse du gestionnaire du titre en cause en l'espèce l'OAPI, une seconde à l'intention du débiteur saisi, c'est-à-dire le société ROTHMANS OF PALL MALL Limited qui doit en être informée dans un délai de huit jours à peine de caducité²⁷³. Dans le cas d'espèce, si la saisie de la marque de cigarette "Rothman King size Filter" a été portée à la connaissance de la société débitrice, il est patent que l'acte de saisie n'a pas été signifié au tiers saisi, toute chose qui rend ladite saisie inopposable. Pourtant, c'est l'OAPI, en sa double qualité de conservateur et gestionnaire de la marque, qui est le premier destinataire de l'acte de saisie. C'est en effet cette organisation qui inscrit dans les registres idoines tous les actes intervenant pendant la durée de vie de la marque.

Ne serait-ce qu'à ce titre, la décision du tribunal de grande instance hors classe de Niamey validant la saisie de la marque litigieuse nonobstant le défaut de signification au tiers saisi porte en elle-même les germes de sa destruction.

Max Lambert Ndéma Elongué

273 Cf. art. 238 de l'AUPSRVE.

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Chapitre 4

Dessins et modèles industriels

A. Dessins et modèles industriels – Nouveauté – Utilisation notoire – Destruction de la nouveauté – Possession personnelle antérieure

Est considéré comme nouveau et donc éligible à la protection légale un dessin ou modèle industriel enregistré à l'OAPI, dès lors qu'il n'existe pas d'éléments comparatifs, l'utilisation de cet actif de propriété industrielle par un tiers commencée moins de six mois avant la date de dépôt ne remplissant par ailleurs pas le critère de notoriété requis pour mettre la nouveauté en échec.

En rejetant la possession personnelle antérieure d'un dessin ou modèle, telle que revendiquée par un tiers incapable de démontrer l'exploitation antérieure du dessin ou modèle en son nom propre, ou sur la base d'un contrat de licence, un tribunal applique correctement le droit.

Cour suprême du Cameroun, Arrêt n° 58-cc du 18 mars 1999, SOCIÉTÉ DES RAFFINERIES DU LITTORAL c. ETS NGO OND & FILS

Observations :

L'article 3.1) de l'annexe IV de l'Accord de Bangui, Acte du 2 mars 1977, exclut de la protection légale les dessins et modèles industriels qui, à la date du dépôt de la demande d'enregistrement ou à la date de la priorité valablement revendiquée, ont été notoirement utilisés sur le territoire de l'un des États membres de l'OAPI. Cette rédaction de l'Accord de Bangui qui consacrait une nouveauté relative, en ce qu'elle ne peut être mise en échec par une divulgation intervenue en dehors des États membres de l'OAPI, a été substantiellement modifiée par l'Accord de Bangui, Acte du 24 février 1999 qui indique en son article 2, alinéa 2, qu'un dessin ou modèle est nouveau "(...) s'il n'a pas été divulgué en tout lieu du monde, par une publication sous forme tangible, par un usage ou par tout autre moyen avant la date de dépôt ou, le cas échéant, avant la date de priorité de la demande d'enregistrement". Cette disposition, reprise intégralement par l'Acte signé à Bamako le 14 décembre 2015, exige désormais une nouveauté absolue pour qu'un dessin ou modèle industriel soit éligible à la protection légale¹. La décision rapportée est intéressante à plus d'un titre : en même temps qu'elle donne une vue panoramique de l'évolution de la notion de nouveauté

depuis l'Accord du 2 mars 1977, cette décision permet de clarifier l'exception de possession personnelle antérieure prévue à l'article 8 de l'Acte du 2 mars 1977 et reprise *expressis verbis* par l'Acte du 24 février 1999 en son article 7.

Faits : Les établissements NOF sont titulaires des droits sur un modèle de sachets servant au conditionnement de l'huile de palme déposé à l'OAPI le 30 juillet 1991 et enregistré le 17 mai 1993 sous le n° 1062. Suivant procès-verbal d'huissier en date du 19 novembre 1991, cette structure a fait constater l'utilisation illégale de ce modèle par la société SRL qui a contesté la nouveauté dudit modèle au motif qu'elle l'utilise notoirement depuis mars 1991 et donc antérieurement au dépôt réalisé par les Éts NOF, revendiquant ainsi l'application à son profit des dispositions bienveillantes de l'article 8 de l'accord du 2 mars 1977. Au-delà des préoccupations relatives à la compétence et à la réparation du préjudice qui ne feront pas l'objet de développements particuliers dans le cadre de cette contribution, la question centrale à laquelle les magistrats de la Cour suprême étaient appelés à répondre était :

- celle de savoir si le modèle querellé est nouveau au sens de l'article 3.1) précité; et accessoirement
- si la société SRL est en droit de bénéficier de la possession personnelle antérieure.

Raisonnement : Les juges suprêmes ont, à la suite de leurs homologues des juridictions inférieures, indiqué que :

- le modèle litigieux était nouveau; et
- les conditions de mise en œuvre de l'exception de possession personnelle antérieure n'étaient pas réunies.

I. La détermination de la nouveauté en matière de dessins et modèles

La Cour suprême a considéré que le modèle de sachets objet de l'enregistrement n° 1062 revêt un caractère nouveau (A) et que cette nouveauté n'est pas mise en échec (B).

A. La teneur de la nouveauté

Aux termes de l'article 2.1) de l'annexe IV de l'Accord de Bangui, Acte du 2 mars 1977 : "La présente annexe est applicable à tout dessin nouveau, à toute forme plastique nouvelle, à tout objet industriel qui se différencie de ses similaires soit par une configuration distincte et reconnaissable lui conférant un caractère de nouveauté,

¹ Contrairement à l'AB-1977, sous l'empire de l'ABR-1999 et l'ABR-2015, la nouveauté est détruite si le dessin ou modèle litigieux a été rendu accessible au public en tout lieu du monde.

soit par un ou plusieurs effets extérieurs lui donnant une physionomie propre et nouvelle". Si cette disposition fournit quelques indications sur les caractéristiques d'un dessin ou modèle éligible à la protection légale, elle ne définit pas pour autant la notion de nouveauté. D'après un auteur, la nouveauté requise pour l'enregistrement d'un dessin ou modèle industriel sous l'empire de l'Accord de Bangui de 1977 est à la fois objective et relative :

- objective puisque cet objet ne peut être protégé s'il a été divulgué antérieurement au dépôt de la demande d'enregistrement; et
- relative car la divulgation faisant échec à la nouveauté ne peut résulter que de la description du dessin ou modèle dans des publications imprimées ou de son utilisation notoire sur le territoire de l'un des États membres de l'OAPI².

Dans l'espèce commentée, la société SRL a contesté la nouveauté du modèle litigieux motif pris de ce qu'il est antériorisé par celui qu'elle utilise depuis mars 1991 et dont les éléments caractéristiques n'ont du reste pas été spécifiés. Or, l'absence d'éléments de comparaison des modèles en cause ne permet pas à l'analyste d'approfondir la discussion sur cet important point³. La cour a d'ailleurs relevé à ce propos que : "...Le procès-verbal du 19 novembre 1991 qui ne constate au demeurant que la commercialisation sans autorisation par la Société des Raffineries du Littoral du modèle protégé à l'Organisation africaine de la propriété intellectuelle depuis le 30 juillet 1991 par les Établissements NGO OND & Fils (NOF) ne pouvait établir manifestement les similitudes entre le produit protégé et celui utilisé par la Société des Raffineries du Littoral". Pourtant, l'appréciation de la nouveauté du modèle querellé devrait également être faite, ajoute un auteur, à l'aune du critère essentiel de la divulgation, en évitant de confondre spécialité et nouveauté. En effet, la spécialité suppose le défaut d'œuvres antérieures similaires, alors que la nouveauté implique le défaut de divulgation du dessin ou modèle revendiqué⁴. C'est finalement autour de la question de l'utilisation antérieure que les débats ont achoppé, les juges de la Cour suprême ayant, en définitive, retenu que l'utilisation antérieure invoquée par la SRL ne remplissait pas la condition de notoriété requise pour pouvoir mettre la nouveauté du modèle litigieux en échec.

B. La destruction de la nouveauté

La nouveauté d'un dessin ou modèle peut être détruite dans l'une des hypothèses visées à l'article 3.1) de

l'annexe IV de l'Accord de Bangui, Acte du 2 mars 1977 notamment si, à la date de la demande ou de la priorité revendiquée, il a été notoirement utilisé sur le territoire de l'un des États membres⁵. Dans le silence de la loi, la Cour suprême a donné à la notoriété un contenu qui suscite quelques réserves : "Considérant que l'utilisation des sachets NOF par la SRL n'a débuté qu'en mars 1991; qu'on ne peut parler d'utilisation notoire pour un laps de temps si bref, la notoriété exigeant une utilisation plus longue outre d'autres éléments relatifs à la publicité, l'accoutumance des consommateurs". Si l'on peut en effet s'accorder avec les juges de la Haute juridiction quant à la prise en compte des éléments relatifs à la publicité et, dans une moindre mesure, à l'accoutumance des consommateurs dans l'appréciation de la notoriété de l'utilisation d'un dessin ou modèle industriel, il paraît en revanche hasardeux de rattacher la notoriété à la "longueur de l'utilisation" d'un dessin ou modèle sans qu'aucune limite temporelle ne soit préalablement fixée. Une telle approche est source d'insécurité judiciaire. Cette insécurité est d'autant plus accentuée qu'il n'existe pas pour le moment, dans l'espace OAPI, de juridiction faîtière chargée d'assurer une interprétation uniforme de la législation communautaire, chaque Cour suprême pouvant donner à la notion de notoriété un contenu différent.

La notoriété dans son acception classique semble renvoyer à la connaissance d'un fait par un grand nombre de personnes relevant d'un secteur d'activité donné ou du public en général. En matière de marque de produits et de services par exemple, une cour d'appel a indiqué que pour déterminer la notoriété, l'on doit prendre en considération l'ancienneté de la marque, les efforts publicitaires qui la soutiennent, l'importance de la diffusion des produits, ainsi que leur dispersion géographique⁶. Vue sous cet angle, l'utilisation du modèle de sachets querellé pouvait valablement être considérée comme notoire, s'agissant surtout des sachets librement commercialisés dans la ville de Douala par les sociétés plastiques pour le conditionnement d'un produit de grande consommation, en l'espèce l'huile de palme.

Les faits révèlent, en outre, que les Éts NOF avaient présenté leur modèle de sachets lors de la foire promo 1990 dans le stand de la SRL à la demande de cette dernière. Cette divulgation intervenue antérieurement à la date du dépôt, c'est-à-dire le 30 juillet 1991, emporte-t-elle destruction de la nouveauté en application des dispositions de l'article 3.1) précitées? La réponse à cette interrogation n'est pas évidente. L'article 3.2)b) de l'Accord de Bangui, Acte du 2 mars 1977, sous l'empire duquel la décision rapportée a été rendue, précise que la nouveauté n'est pas mise en échec si, dans les six mois précédant la date de dépôt ou de la priorité revendiquée, le dessin ou modèle industriel a fait l'objet

2 Voir NGO MBEM (S.), Les enjeux de la protection des dessins et modèles industriels dans le développement en Afrique : le cas des pays membres de l'Organisation africaine de la propriété intellectuelle (OAPI), Thèse de Doctorat en droit, Université de Strasbourg III-Robert Schuman, septembre 2007, pp. 88 et s.

3 Voir en ce sens Tribunal de commerce d'Abidjan, Jugement du 23 juillet 2015, n° 1929/2015, *Sieur Dabe Zohora Bertin c. Société Orange Côte d'Ivoire SA et Société Nouvelle Typic Design Diffusion dite NTDD SA* (obs. LUCAS (A.), ce recueil, chapitre 4, section D).

4 Voir en ce sens SEUNA (C.), La notion de dessins et modèles industriels susceptibles d'enregistrement : essai de théorie juridique, in : *Revue africaine de la propriété intellectuelle* n° 0002, septembre 2009, pp. 26 et s.

5 L'art. 2 al. 2 de l'annexe IV de l'ABR-2015 indique que la nouveauté est détruite si le dessin ou modèle a été divulgué en tout lieu du monde, par une publication sous forme tangible, par un usage ou par tout autre moyen avant la date de dépôt ou, le cas échéant, avant la date de priorité de la demande d'enregistrement.

6 Voir CA Lomé, 18 septembre 2007, Arrêt n° 80, *Établissements Weilliang LU c. Établissements MLT*, à propos de la marque "PANTHÈRE NOIRE".

d'une divulgation résultant du fait que le déposant de la demande ou son prédécesseur en droit l'a exposé dans une exposition internationale officielle ou officiellement reconnue. Or, s'il est manifeste que la divulgation est le fait des États NOF, il est en revanche difficile d'évaluer avec précision la période de temps séparant cette divulgation intervenue en 1990 sans autres précisions du dépôt réalisé le 30 juillet 1991.

II. La possession personnelle antérieure

Le législateur du 2 mars 1977 a, pour des raisons d'équité, prévu à l'article 8 une limitation aux droits exclusifs conférés par l'enregistrement d'un dessin ou modèle industriel, notamment la possession personnelle antérieure dont la mise en œuvre suppose l'exploitation antérieure dudit dessin ou modèle (A) et la bonne foi de l'exploitant (B).

A. L'exploitation antérieure d'un dessin ou modèle identique
L'article 8 de l'Accord de Bangui, Acte du 2 mars 1977, dispose :

“Le dessin ou modèle industriel enregistré ne produit pas d'effet à l'égard du tiers qui, au moment du dépôt de la demande d'enregistrement, exploitait déjà ledit dessin ou modèle sur le territoire de l'un des États membres ou avait pris des mesures nécessaires pour cette exploitation. Ce tiers est autorisé à utiliser ce dessin ou modèle pour les besoins de son entreprise, dans ses propres ateliers ou dans ceux d'autrui. Ce droit ne peut être transmis qu'avec l'entreprise.”

L'exception de possession personnelle antérieure a été également prévue par les versions ultérieures de l'accord, à savoir celles du 24 février 1999 et du 14 décembre 2015. Cependant, le contenu des différentes dispositions y relatives a varié au fil du temps. En définitive, l'article 7.a) de l'Accord de Bamako du 14 décembre 2015 qui traite de la possession personnelle antérieure a substitué le mot “exploitation” retenu par les précédentes versions de l'accord par “possession” dans un souci de clarté et de précision. Cette nouvelle disposition énonce en effet :

“Les droits découlant du dessin ou modèle industriel ne s'étendent pas aux actes accomplis par celui qui, au moment du dépôt de la demande d'enregistrement, possédait déjà ledit dessin ou modèle. Celui-ci est autorisé à utiliser ce dessin ou modèle industriel pour les besoins de son entreprise, dans ses propres ateliers ou dans ceux d'autrui. Ce droit ne peut qu'être transmis avec l'entreprise.”

Par ailleurs, ce texte exclut désormais le tiers qui avait pris des dispositions nécessaires en vue de l'exploitation du dessin ou modèle industriel litigieux du champ de la possession personnelle antérieure. En tout état de cause, l'accord du 2 mars 1977 sous l'empire duquel la décision commentée a été rendue limitait le bénéfice

de la possession personnelle antérieure aux tiers, c'est-à-dire aux personnes qui, antérieurement à la date du dépôt du dessin ou modèle querellé ou de la priorité revendiquée, exploitaient déjà secrètement le même objet comme créateur ou cessionnaire dans le territoire de l'un des États membres de l'OAPI. Il va sans dire que la SRL ne remplit pas cette condition, étant donné qu'elle utilisait le modèle de sachets litigieux du fait de son véritable créateur les États NOF qui en assuraient d'ailleurs la livraison auprès des divers utilisateurs, en témoignent les diverses factures produites aux débats. La Cour suprême a d'ailleurs relevé à bon droit que la SRL n'a apporté aucune preuve qu'elle exploitait l'invention litigieuse avant le 30 juillet 1991, date du dépôt du modèle querellé à l'OAPI.

L'exploitation du modèle de sachets litigieux par la SRL n'était pas non plus assise sur une licence d'exploitation en application des dispositions pertinentes du susdit accord. L'on est là aux confins de l'exigence de la bonne foi de l'exploitant.

B. La bonne foi de l'exploitant

Cette exigence ne résulte pas expressément des dispositions de l'article 8 de l'Accord de Bangui, Acte du 2 mars 1977, encore moins de ses succédanés (il s'agit notamment de l'Accord de Bangui, Acte du 24 février 1999, et de l'Accord de Bamako du 14 décembre 2015). La doctrine spécialisée souligne la nécessité de la preuve de la mauvaise foi de l'exploitant antérieur en vertu de la maxime *fraus omnia corrumpit*⁷, rapprochant ainsi le régime des dessins et modèles industriels de celui des brevets d'invention. Les articles 8.1)d) de l'annexe I de l'Accord de Bangui, Acte du 24 février 1999 et 7.1)e) de l'annexe I de l'Accord de Bamako du 14 décembre 2015 exigent expressément la bonne foi du possesseur antérieur de l'invention revendiquée. Ce rapprochement paraît d'ailleurs judicieux compte tenu des possibilités d'appropriations frauduleuses des créations protégées au titre du régime spécial des dessins et modèles industriels.

Dans l'espèce commentée, il est évident que l'invocation par la SRL d'un droit d'utilisation antérieure du modèle de sachets enregistrés au profit des États NOF procède d'une mauvaise foi manifeste de sa part étant observé qu'elle ne prouve aucunement avoir antérieurement créé le modèle dont s'agit, ayant simplement acquis les sachets litigieux sur la place du marché au même titre que ses concurrentes. Il y a là une volonté d'appropriation injuste du fruit des efforts créatifs d'autrui constitutive d'une faute ouvrant droit aux dommages et intérêts dans les conditions du droit commun. D'où la confirmation par la haute juridiction de l'indemnité allouée aux États NOF par les premiers juges.

Max Lambert Ndéma Elongué

B. Dessins et modèles industriels – Notion de nouveauté – Appréciation de la contrefaçon

Un modèle de cuvette doit être considéré comme nouveau dès lors qu'il présente une contenance différente de celle des ustensiles ordinaires rencontrés sur les marchés et que la commercialisation d'un modèle qui lui ressemble caractérise une contrefaçon.

Cour suprême de Côte d'Ivoire, Chambre judiciaire, Arrêt n° 032 du 4 février 2010, SOGEC-IVOIRE c. SIFAM-CI

Observations :

Bien qu'il mélange fâcheusement les conditions de protection d'un dessin ou modèle industriel et d'une œuvre de l'esprit au sens du droit d'auteur, l'arrêt commenté mérite attention en ce qu'il offre l'occasion de mieux cerner la distinction entre les deux situations, en prenant appui désormais sur une rédaction plus rigoureuse de l'Accord de Bangui.

Faits : Il s'agit en l'espèce d'un modèle de cuvette enregistré par une société commercialisant des ustensiles ménagers en aluminium. Reprochant à une société d'avoir mis sur le marché une copie de ce modèle, elle l'assigne en contrefaçon et en concurrence déloyale. La cour d'appel d'Abidjan, comme l'avaient fait les premiers juges, la déboute en retenant que le modèle litigieux n'est pas original, et qu'en toute hypothèse il est différent du modèle de la défenderesse.

La société a porté son affaire devant la Cour suprême de Côte d'Ivoire.

Raisonnement : L'arrêt est cassé à la fois pour avoir violé l'article 2, alinéa 1^{er}, de l'annexe IV de l'Accord de Bangui, et pour "insuffisance de motifs". Usant du pouvoir d'évocation que lui reconnaît la législation ivoirienne, la Cour suprême relève que "le bénéfice de la protection instaurée par l'annexe IV de l'Accord de Bangui est subordonné non seulement au caractère novateur du modèle déposé, mais aussi à son originalité", et que la nouveauté, au sens du même texte, "est caractérisée si aucun dessin ou modèle identique n'a été divulgué à la date du dépôt de la demande d'enregistrement". Constatant qu'il est établi, d'une part, que le modèle de la société demanderesse "présente une contenance différente de celle des ustensiles ordinaires rencontrés sur les marchés", d'autre part que celui exploité par la société défenderesse lui "ressemble", elle en déduit que cette dernière est mal fondée à opposer le "manque d'originalité" de la cuvette litigieuse.

On se gardera bien, faute de disposer des éléments factuels, de discuter le mérite de la solution. Mais les deux étapes du raisonnement appellent de sérieuses réserves.

Rappelons d'emblée que le texte de l'Accord de Bangui mis sur le tapis en l'espèce est le texte initial de 1977. Dans cette version, l'article 2, alinéa 1^{er}, de l'annexe IV, prévoyait que "la présente annexe est applicable à tout

dessin nouveau, à toute forme plastique nouvelle, à tout objet industriel qui se différencie de ses similaires soit par une configuration distincte et reconnaissable lui conférant un caractère de nouveauté, soit par un ou plusieurs effets extérieurs lui donnant une physionomie propre et nouvelle". L'arrêt attaqué n'en avait pas fait une lecture correcte puisqu'il avait refusé le bénéfice de la protection en se fondant sur le défaut d'originalité. Mais l'arrêt commenté erre tout autant puisque, s'il commence par fonder la censure sur l'existence, d'ailleurs assénée plus que démontrée, d'une "physionomie propre" du modèle argué de contrefaçon, critère effectivement posé par la disposition précitée, il ne craint pas d'affirmer ensuite que l'Accord de Bangui subordonne la protection du modèle à la double condition de nouveauté et d'originalité. Ce postulat méconnaît ouvertement la lettre de l'annexe IV qui n'évoque aucunement l'exigence d'originalité, aussi bien dans la version initiale, applicable en l'espèce, que dans sa rédaction actuelle, issue de l'Accord de Bamako de 2015.

Dans cette dernière rédaction, à la différence du texte de 1977, qui traitait des deux questions dans une disposition unique, une distinction est clairement opérée entre l'objet et la condition de la protection. L'article 1^{er}, sous l'intitulé "Définition", dispose qu'il faut entendre par "dessin" "tout assemblage de lignes ou de couleurs", et "le modèle" comme "toute forme plastique associée ou non à des lignes ou à des couleurs", en ajoutant "pourvu que cet assemblage ou forme donne une apparence spéciale à un produit industriel ou artisanal et puisse servir de type pour la fabrication d'un produit industriel ou artisanal". L'article 2, sous l'intitulé "Dessins et modèles industriels susceptibles d'enregistrement", énonce, dans son premier alinéa : "Un dessin ou modèle industriel peut faire l'objet d'un enregistrement s'il est nouveau".

La démarche peut être rapprochée de celle adoptée par l'Union européenne dans le Règlement 6/2002 du 12 décembre 2001 sur les dessins ou modèles communautaires, dont l'article 3.a) définit le "dessin ou modèle" comme "l'apparence d'un produit ou d'une partie de produit que lui confèrent, en particulier, les caractéristiques des lignes, des contours, des couleurs, de la forme, de la texture et/ou des matériaux du produit lui-même et/ou de son ornementation", avant que l'article 4 précise les "conditions de protection" en prévoyant que la protection du dessin ou modèle "n'est assurée que dans la mesure où il est nouveau et présente un caractère individuel". Le point commun avec l'Accord de Bangui est l'exigence de "nouveauté". La différence est que le droit de l'Union européenne pose la condition supplémentaire du "caractère individuel". Mais, à y regarder de plus près, cette condition peut aussi se déduire de la définition contenue dans l'article 1^{er}, alinéa 1^{er}, de l'annexe IV dans la version de Bamako, laquelle, comme il a été dit plus haut, se réfère à l'"apparence spéciale" donnée au produit. Où l'on voit que la question de l'objet de la protection n'est pas ici complètement séparée de celle de ses conditions.

En tout cas, il est acquis désormais que la protection du modèle selon l'Accord de Bangui est subordonnée

à la condition de nouveauté et non à celle d'originalité. Or les deux notions ne se recoupent pas. Elles s'opposent même en ce sens que, selon la terminologie traditionnellement admise en matière de propriété intellectuelle, l'originalité s'entend dans un sens subjectif, par référence à la personnalité du créateur (dont l'empreinte doit se manifester dans la forme créée), alors que la nouveauté s'entend dans un sens objectif comme l'absence d'antériorité, ainsi que le précise l'article 2, alinéa 2, de l'annexe IV de l'Accord de Bangui dans la version issue de l'Acte de Bamako⁸.

Il est vrai que, dans la pratique judiciaire, l'opposition n'est pas toujours aussi nette car l'appréciation de l'originalité au sens du droit d'auteur peut aussi prendre en compte des éléments objectifs comme l'existence ou l'absence d'antériorité. Et même certaines lois nationales en retiennent une acception qui n'est pas aussi subjective que celle, traditionnelle, renvoyant à la marque de la personnalité de l'auteur. C'est précisément le cas de la loi ivoirienne n° 96-564 du 25 juillet 1996 relative à la protection des œuvres de l'esprit et aux droits des auteurs, des artistes-interprètes et des producteurs phonogrammes et de vidéogrammes, dont l'art. 1^{er} définit l'œuvre originale comme "une création intellectuelle propre à son auteur", critère qui a d'abord été retenu par le droit de l'Union européenne pour caractériser l'originalité des programmes d'ordinateur⁹, avant d'être généralisé à l'ensemble des œuvres par la Cour de justice dans l'arrêt Infopaq¹⁰, et qui est considéré comme suffisamment compréhensif pour rendre compte de l'approche des systèmes de *copyright* qui ramènent traditionnellement l'originalité à l'absence de copie¹¹.

Il n'empêche. C'est à tort, croyons-nous, que l'arrêt commenté ajoute la condition d'originalité à celle de nouveauté. Il aurait dû s'en tenir à cette dernière¹². C'est également à tort qu'il pose le principe que l'Accord de Bangui subordonne la protection du modèle à son "caractère novateur", terminologie maladroite qui semble renvoyer à une sorte d'équivalent de "l'activité inventive" requise de l'invention brevetable¹³. Il aurait dû s'en tenir à l'absence d'antériorité, comme d'ailleurs il le fait ensuite en ajoutant que la nouveauté "est caractérisée si aucun dessin ou modèle identique n'a été divulgué à la date du dépôt de la demande d'enregistrement", puis en constatant, en fait, que le modèle de cuvette déposé par la société demanderesse

diffère "des ustensiles ordinaires rencontrés sur les marchés", quitte à compléter l'exigence par la précision, contenue dans l'article 5, alinéa 2, du règlement européen, que "des dessins ou modèles sont considérés comme identiques lorsque leurs caractéristiques ne diffèrent que par des détails insignifiants".

La nouveauté du modèle argué de contrefaçon étant établie, il restait à caractériser ladite contrefaçon. De ce point de vue, la motivation de l'arrêt est vraiment très sommaire puisque la Cour suprême use de son pouvoir d'évocation en se bornant à affirmer que le modèle second "ressemble" au premier. Certes, il est de principe que la contrefaçon, en matière de propriété industrielle, s'apprécie d'après les ressemblances et non d'après les différences. Cependant, il aurait été de bonne méthode de comparer les deux modèles de cuvette et d'indiquer avec précision sur quoi portait cette ressemblance, ne serait-ce que pour démontrer que les éventuelles différences ne portaient pas sur les caractéristiques essentielles du modèle protégé (auquel cas elles auraient conduit à écarter la contrefaçon) et que les points communs constatés n'étaient pas imposés par des considérations fonctionnelles.

André Lucas

C. Dessins et modèles industriels – Nouveauté – Modèles revendiqués identiques à des articles exploités antérieurement par les défendeurs

L'action en contrefaçon ne peut être accueillie dès lors que les modèles d'ustensiles de table déposés à l'OAPI par le demandeur sont identiques en tous points aux articles dont les défendeurs font usage depuis plusieurs années, et ne répondent donc pas à la condition de nouveauté.

Tribunal de commerce d'Abidjan, Jugement du 4 mars 2014, RG n° 1915/2013, SIEUR ALI MROUE c. SOCIÉTÉ NESTLÉ CÔTE D'IVOIRE; STÉ CDCI; STÉ SOCOPIRIX; STÉ TOP BUDGET; STÉ SOCOCE; STÉ PROSUMA; COMPTOIR GANAMET ET FILS; FOIRE DE CHINE; STÉ MONDIAL MÉNAGE

Observations :

Le jugement commenté rejette l'action en contrefaçon de modèles industriels. La solution n'appelle pas la critique en elle-même, mais le raisonnement qui la fonde comporte quelques failles méritant d'être relevées.

Faits : Le demandeur a déposé à l'OAPI des dessins et modèles d'assiettes, verres, cuillers, fourchettes et couteaux en matière plastique. Il reproche à diverses entreprises ayant leur siège à Abidjan de commercialiser des ustensiles de table contrefaisants importés de pays étrangers, notamment de Chine et de Turquie, alors que lui-même n'a même pas encore commencé à fabriquer les modèles déposés.

Il n'est pas suivi par le tribunal de commerce d'Abidjan.

8 "Un dessin ou modèle industriel est nouveau s'il n'a pas été divulgué en tout lieu du monde, par une publication sous forme tangible, par un usage ou par tout autre moyen avant la date de dépôt ou, le cas échéant, avant la date de priorité de la demande d'enregistrement". Voir aussi l'art. 5 du Règlement (CE) n° 6/2002 du Conseil du 12 décembre 2001 sur les dessins ou modèles communautaires.

9 Art. 1 al. 3 de la Directive 91/250/CEE du Conseil, du 14 mai 1991, concernant la protection juridique des programmes d'ordinateur, consolidée par la Directive 2009/24/CE du Parlement européen et du Conseil du 23 avril 2009.

10 Cour de justice de l'Union européenne, Arrêt du 16 juillet 2009, *Infopaq International A/S contre Danske Dagblades Forening*, C-5/08, ECLI:EU:C:2009:465.

11 LUCAS (A.), LUCAS-SCHLOETTER (A.) et BERNAULT (C.), *Traité de la propriété littéraire et artistique*, Paris (LexisNexis), 5^e éd., 2017, n° 141.

12 Voir en ce sens FIENI (P.), *Actualités juridiques* n° 71, 2011, p. 124, note sous l'Arrêt commenté relevant que la solution "ajoute à la confusion qui règne dans la définition des critères de protection des modèles industriels".

13 Art. 2 et 4 de l'ABR – 2015.

Raisonnement : Celui-ci constate que les dessins et modèles litigieux ont bel et bien été enregistrés mais que cet enregistrement n'est opposable aux défendeurs que sous réserve d'établir la nouveauté des créations en cause. Or, les "divers connaissements et bons d'expédition et de livraison" produits par ceux-ci montrent qu'ils "font usage, depuis plusieurs années, des articles de ménage identiques, en tous points, aux dessins et modèles revendiqués". La condition posée par l'article 2, alinéa 2, de l'annexe IV de l'Accord de Bangui n'est donc pas remplie, et le demandeur est débouté.

Il est difficile au commentateur, en l'état des indications fournies par le jugement, de se forger une opinion sur le bien-fondé de l'appréciation concernant le défaut de nouveauté, mais plusieurs réserves peuvent être formulées.

D'abord, on peut regretter l'ambiguïté de la décision sur la nature et le nombre des créations protégées. Il semble que le litige portait sur des modèles (ustensiles de table) alors que le tribunal évoque à de nombreuses reprises des "dessins et modèles". Or, même si le régime juridique est identique, il est plus rigoureux de respecter la distinction entre le dessin et le modèle. On admet traditionnellement que "le dessin est une figure à deux dimensions et le modèle une figure à trois dimensions"¹⁴. L'article 1^{er} de l'annexe IV s'inscrit dans le droit-fil de cette approche en définissant le dessin comme "tout assemblage de lignes ou de couleurs", et le modèle comme "toute forme plastique associée ou non à des lignes ou à des couleurs". Par ailleurs, même si les différentes créations avaient fait l'objet d'un enregistrement unique, l'action en contrefaçon visait incontestablement une pluralité de modèles¹⁵, et la référence faite, dans l'exposé du litige, à la demande d'interdiction "du dessin et modèle n° 03191" constitue à cet égard une fâcheuse source de confusion.

Sur le fond, on peut trouver bien sommaire la motivation qui consiste à affirmer sans plus de précision que les articles commercialisés de longue date ("plusieurs années") par les défendeurs sont "identiques, en tous points, aux dessins et modèles revendiqués". Il aurait été plus rigoureux d'expliquer de façon circonstanciée, modèle par modèle, en quoi se révélait une telle identité et à quelle date exacte avait eu lieu la commercialisation. Le tribunal croit pouvoir tirer argument en faveur du défaut de nouveauté de ce que le demandeur lui-même reconnaissait qu'il avait différé la fabrication de ses propres modèles "par crainte d'une concurrence déloyale de la part des défendeurs", comme si cette attitude témoignait d'une sorte de reconnaissance de l'antériorité destructrice de nouveauté. L'indice, en vérité, est bien fragile car on peut, au contraire, trouver naturel que le titulaire d'un droit exclusif sur des modèles attende la confirmation judiciaire de son droit exclusif avant d'investir dans la fabrication.

Les conséquences du défaut de nouveauté sont, au demeurant, analysées de façon erronée par le tribunal, et ce à deux points de vue. D'abord, il rejette la demande de radiation de l'enregistrement à l'OAPI formulée par une des sociétés défenderesses sur la base du raisonnement suivant : l'annexe IV de l'Accord de Bangui ne prévoit pas la possibilité de radiation d'un enregistrement de dessin ou modèle (le jugement mentionne "radiation d'une marque", mais il s'agit, de toute évidence, d'une erreur de plume) en cas de "violation des critères de nouveauté et d'originalité"¹⁶; l'article 23 de l'annexe III sanctionne, lui, par la radiation de l'enregistrement de la marque le non-usage de cette marque sans excuses légitimes, pendant une durée ininterrompue de cinq ans, mais en l'espèce la demande de radiation n'est pas fondée sur la "non-utilisation" des dessins et modèles, en sorte que la demande ne peut prospérer.

L'argumentation manque totalement sa cible. Il est évident que la législation n'impose aucune obligation d'exploitation en matière de dessins et modèles industriels. En réalité, si la demande de radiation ne pouvait aboutir, c'était tout simplement parce qu'elle n'est pas la sanction appropriée du défaut de nouveauté, qui emporte l'annulation de l'enregistrement, comme le prévoit l'article 30.1)a) de l'annexe IV¹⁷, étant précisé qu'aux termes de l'article 20 de l'Accord de Bangui, "les décisions judiciaires définitives rendues sur la validité des titres dans l'un des États membres en application du texte des annexes I à X au présent accord font autorité dans tous les autres États membres, excepté celles fondées sur l'ordre public et les bonnes mœurs".

Ce constat conduit à la seconde critique, tenant à ce que le tribunal, au lieu de sanctionner le défaut de nouveauté par la nullité de l'enregistrement, raisonne, comme on l'a vu, en termes d'inopposabilité dudit enregistrement. Et il croit conforter ce raisonnement en appelant à la rescousse l'article 7 de l'annexe IV qui, dans la rédaction de 1999 applicable en l'espèce, dispose :

"Le dessin ou modèle industriel enregistré ne produit pas d'effet à l'égard du tiers qui, au moment du dépôt de la demande d'enregistrement, exploitait déjà ledit dessin ou modèle sur le territoire de l'un des États membres ou avait pris des mesures nécessaires pour cette exploitation. Ce tiers est autorisé à utiliser ce dessin ou modèle pour les besoins de son entreprise, dans ses propres ateliers ou dans ceux d'autrui".

Pour lui, cette disposition interdit au déposant "de remettre en cause les droits acquis des tiers qui exploitaient déjà ledit dessin ou modèle mais qui ont négligé ou qui n'ont pas cru devoir le faire enregistrer à l'institution de propriété intellectuelle idoine".

14 AZEMA (J.) et GALLOW (J.-C.), *Droit de la propriété industrielle*, Paris (Dalloz), 7^e éd., 2012, n° 1184.

15 Le jugement vise expressément "les articles de ménage incriminés".

16 Là, l'erreur n'est pas seulement de plume, car l'originalité n'est aucunement requise en matière de dessins et modèles industriels.

17 Voir dans le même sens l'art. 25 al. 1 let. b du Règlement (CE) n° 6/2002 du 12 décembre 2001 sur les dessins ou modèles communautaires.

Le raisonnement procède d'une confusion qu'il est utile de dissiper. L'inopposabilité renvoie à une situation dans laquelle les tiers peuvent écarter les effets d'un acte juridique dont la validité n'est pas en cause. Or il ne s'agit pas du tout de cela en l'espèce, mais de nullité, c'est-à-dire de la disparition rétroactive de l'acte. Si les modèles en cause ne répondent pas à la condition de nouveauté, il n'y a pas de protection du tout, et il est donc inutile, pour débouter le demandeur en contrefaçon, de recourir à ce que l'on appelle l'exception de possession personnelle antérieure qui permet, en matière de dessins et modèles industriels comme en matière de brevets d'invention¹⁸, à celui qui exploitait la création en cause à la date du dépôt de la demande du titre de continuer cette exploitation. À quoi on ajoutera qu'en toute hypothèse, le "possesseur" ne peut, selon les termes exprimés de l'article 7 de l'annexe IV, utiliser le dessin ou modèle en cause que "pour les besoins de son entreprise", ce qui exclut la possibilité de consentir des licences à des distributeurs, comme le prévoit l'article 22 du règlement européen 6/2002¹⁹.

Ayant tranché en faveur du défaut de nouveauté, le tribunal n'avait pas à répondre à deux autres moyens de défense, l'un et l'autre sans portée, invoqués par trois des sociétés défenderesses. Celles-ci faisaient d'abord valoir qu'elles n'avaient eu qu'une activité de distribution et qu'elles n'avaient jamais prétendu se prévaloir "d'un quelconque droit de propriété intellectuelle sur les modèles et dessins", ce qui, selon elles, suffisait à justifier leur mise hors de cause. L'argument est évidemment inopérant dès lors que l'article 3 de l'annexe IV reconnaît au titulaire du droit le "droit exclusif d'exploiter ce dessin ou modèle et de *vendre* (italiques ajoutés par nous) ou faire vendre les produits dans lesquels ce dessin ou modèle est incorporé".

Pas davantage il ne pouvait être fait droit à l'autre moyen tiré de ce que "les dessins et modèles concernés sont déposés et enregistrés auprès de l'Institut de la propriété intellectuelle (*il faut lire "industrielle"*) en France, en vertu de la Convention de Paris, érigée par l'Organisation Mondiale de la Propriété Intellectuelle, dite OMPI, à laquelle la Côte d'Ivoire est partie". À la supposer exacte, l'assertion ne pouvait paralyser l'action en contrefaçon qu'à la condition de préciser sur quoi portait exactement le dépôt en France et, surtout, d'établir que ce dépôt était antérieur à la demande d'enregistrement effectuée par le demandeur à l'OAPI, d'où résultait, en cas d'identité, le défaut de nouveauté.

André Lucas

¹⁸ Art. 7 al. 1 let. e de l'annexe I de l'ABR-2015.

¹⁹ Art. 22 al. 3 du Règlement (CE) n° 6/2002 du 12 décembre 2001 sur les dessins et modèles communautaires: "Le droit fondé sur une utilisation antérieure ne donne pas la faculté d'octroyer une licence à autrui aux fins de l'exploitation du dessin ou modèle".

D. Dessins et modèles industriels – Nouveauté – Impression visuelle d'ensemble – Appréciation de la contrefaçon – Preuve pesant sur le demandeur

La nouveauté exigée par l'article 2, alinéa 1^{er}, de l'annexe IV de l'ABR-2015 implique que le dessin ou le modèle suscite une impression visuelle d'ensemble différente de celle produite par tout modèle divulgué antérieurement et l'action en contrefaçon ne peut être accueillie si le demandeur ne fournit pas les éléments précis permettant de procéder à un examen d'ensemble des éléments propres et distincts de son modèle en comparaison avec ceux de la défenderesse.

Tribunal de commerce d'Abidjan, Jugement du 23 juillet 2015, n° 1929/2015, Sieur DABE ZOHORA Bertin c. SOCIÉTÉ ORANGE CÔTE D'IVOIRE et SOCIÉTÉ NTDD

Observations :

Le jugement du tribunal de commerce d'Abidjan du 23 juillet 2015 permet de mieux cerner la nouveauté qui conditionne l'accès à la protection au titre de l'annexe IV de l'ABR-2015. Rappelons que c'est la seule exigence de fond formulée par l'article 2, alinéa 1^{er}, qui en précise la signification en ces termes : "Un dessin ou modèle industriel est nouveau s'il n'a pas été divulgué en tout lieu du monde, par une publication sous forme tangible, par un usage ou par tout autre moyen avant la date de dépôt ou, le cas échéant, avant la date de priorité de la demande d'enregistrement".

Faits : Le modèle en cause, en l'espèce, était un panneau amovible permettant d'afficher des messages publicitaires sur le mobilier urbain et de présenter les titres de la presse écrite. Le demandeur l'avait déposé à l'OAPI en 2011. L'année suivante il avait transmis à la société Orange Côte d'Ivoire une proposition commerciale, incluant tous les détails techniques, visant à mettre à sa disposition l'exploitation de tels panneaux. L'offre n'avait pas été acceptée mais le déposant avait constaté que la société destinataire avait fait distribuer aux vendeurs de journaux dans tout le district d'Abidjan, à travers une agence de publicité et de communication, des panneaux qu'il estimait, quant à lui, être contrefaisants, ce qui l'avait amené à intenter une action en contrefaçon. La société Orange Côte d'Ivoire lui opposait que le "procédé" mis en œuvre par le modèle existait de longue date, qu'il était d'usage courant aussi bien à Abidjan que dans toutes les grandes villes du monde, et que l'examen des dessins du dispositif d'affichage joint à sa demande d'enregistrement était "de toute évidence, d'une banalité aussi plate qu'affligeante". Elle en déduisait que l'enregistrement n'était susceptible de conférer aucun droit privatif au déposant, lequel n'était donc pas fondé à agir en contrefaçon. L'agence de publicité et de communication faisait valoir, elle aussi, que la condition de nouveauté posée par l'article 2, alinéa 1^{er}, de l'annexe IV de l'ABR-2015 n'était pas remplie, et elle affirmait qu'au demeurant, le demandeur ne produisait même pas son modèle qu'il prétendait reproduit ou imité.

Le tribunal donne raison aux défenderesses.

Raisonnement : Pour le tribunal de commerce d'Abidjan, la nouveauté requise par l'annexe IV doit s'entendre en ce sens que "pour qu'un modèle soit protégé, il faut qu'il suscite une impression visuelle d'ensemble différente de celle produite par tout modèle divulgué antérieurement". Or non seulement les images et les photographies versées aux débats par le demandeur "sont floues et ne permettent pas de les comparer à ceux (*sic*) distribués par les défenderesses", mais la description qu'il fait de son modèle "est très sommaire et ne permet pas de procéder à un examen d'ensemble des éléments propres et distincts de son panneau en comparaison avec ceux de la défenderesse pour établir la contrefaçon". Par ailleurs, il "ne démontre pas en quoi son modèle est nouveau pour se prévaloir des autres dispositions légales de protection applicables en matière de propriété littéraire et artistique". La conclusion, dès lors, s'impose : il "n'a pas rapporté la preuve de l'activité contrefaisante" des sociétés défenderesses.

L'argumentation appelle une réserve sur le fond et une réserve sur la forme. La réserve sur le fond concerne la motivation, pour le moins elliptique, sur la preuve de la "nouveauté" du modèle qui aurait pu, si elle avait été établie, justifier le bénéfice des "autres dispositions légales de protection applicables en matière de propriété littéraire et artistique". Ces "autres dispositions" ne peuvent être que celles contenues dans l'annexe VII de l'ABR-2015, relatives à la propriété littéraire et artistique, dont l'article 1^{er}, alinéa 3, de l'annexe IV réserve expressément l'application²⁰. Mais cette application, par hypothèse, serait subordonnée à l'exigence d'originalité, entendue dans un sens subjectif, par référence à l'empreinte de la personnalité de l'auteur de l'œuvre de l'esprit, et non à celle de nouveauté, entendue comme l'absence objective d'antériorité. Il doit être bien clair, en effet, que le cumul entre la protection au titre de la législation sur les dessins et modèles industriels et la protection au titre du droit d'auteur ne joue que si les conditions propres à chacune sont respectées²¹.

La réserve sur la méthode tient à l'articulation maladroite entre la question de la nouveauté, qui conditionne l'accès à la protection, et la question de la contrefaçon, qui intéresse l'éventuelle atteinte au droit exclusif. Le jugement commenté constate en premier lieu que les éléments de preuve fournis par le demandeur ne permettent pas de caractériser la réalité de la reproduction ou de l'imitation alléguée, et c'est seulement dans un second temps qu'il recherche si la nouveauté du modèle revendiqué est elle-même établie. Or c'est l'inverse qu'il aurait fallu faire. En effet, la question de la nouveauté se pose en amont en ce

sens que si le modèle n'est pas nouveau, l'action en contrefaçon est dépourvue de tout fondement juridique, en sorte que la matérialité de la reproduction ou de l'imitation n'a même pas à être examinée.

La solution, malgré tout, emporte la conviction. Contrairement à ce que soutenait le demandeur, il ne suffit pas de produire un certificat d'enregistrement d'un modèle baptisé "innovateur" pour opposer aux tiers son droit privatif, encore faut-il démontrer que le modèle satisfait effectivement à l'exigence de nouveauté. Pour rapporter cette preuve, il faut, bien entendu, apporter tous les éléments permettant d'apprécier l'existence éventuelle d'antériorités, ce qui n'avait pas été fait en l'espèce puisque si des informations avaient bien été fournies sur le modèle déposé (ce que contestait, on l'a vu, l'agence de publicité et de communication), elles n'étaient pas suffisamment précises pour permettre aux juges de procéder à un tel examen.

On retiendra aussi, pour l'approuver, la référence à la nécessité d'une "impression visuelle d'ensemble différente de celle produite par tout modèle divulgué antérieurement". Certes, en rattachant cette exigence à celle de nouveauté, le jugement commenté va au-delà de l'acception traditionnellement reçue de cette notion en matière de propriété industrielle, qui, comme il a été dit plus haut, la ramène à l'absence objective d'antériorité. En ce sens, on pourrait lui reprocher d'ajouter à la lettre de l'Accord de Bangui. Dans l'Union européenne, la question se pose en termes différents puisque le règlement précité 6/2002, outre la condition de nouveauté, exige que le dessin ou modèle "présente un caractère individuel" (art.4), et qu'il déduit un tel caractère de ce que "l'impression globale qu'il produit sur l'utilisateur averti diffère de celle que produit sur un tel utilisateur tout dessin ou modèle qui a été divulgué au public" avant une certaine date (art. 5.1), en précisant que l'appréciation doit tenir compte, à cet égard, "du degré de liberté du créateur dans l'élaboration du dessin ou modèle" (art. 5.2).

Mais cette audace ne peut, selon nous, être critiquée car il n'est pas illogique d'imprimer à la nouveauté en matière de dessins et modèles industriels une spécificité que l'on peut rattacher à sa relativité, depuis longtemps soulignée en doctrine²². Au demeurant, l'article 1^{er}, alinéa 1, de l'annexe IV, en définissant le modèle comme "toute forme plastique", pourvu qu'elle "donne une *apparence spéciale (italiques ajoutés par nous)* à un produit industriel ou artisanal", peut fournir une base textuelle au critère de "l'impression visuelle d'ensemble", même s'il est regrettable que la question de la définition du modèle soit ainsi mélangée avec celle des conditions de la protection.

André Lucas

20 Que le demandeur, on le relèvera en passant, ne mettait aucunement sur le tapis en l'espèce.

21 Voir en ce sens en droit français Cass. com, 29 mars 2017, n° 15-10885 : "Les articles L. 112-1 du code de la propriété intellectuelle et 96.2 du règlement CE n° 6/2002 du 12 décembre 2001 sur les dessins ou modèles communautaires n'imposent pas un cumul total ou de plein droit des protections qu'ils instituent, mais autorisent seulement un tel cumul lorsque les possibilités respectives des différentes protections sont satisfaites".

22 Voir par ex. RAYNARD (J.), PY (E.) et TRÉFIGNY (P.), Droit de la propriété industrielle, Paris (LexisNexis), 2016, n° 543 : "le régime des dessins et modèles pose une exigence de nouveauté seulement relative distincte du droit des brevets".

E. Dessins et modèles industriels – Saisie-contrefaçon – Ordonnance – Rétractation – Juge compétent – Étendue des pouvoirs du juge des référés

Dans le silence de l'Accord de Bangui, Acte du 22 février 1999, le juge des référés est compétent pour statuer sur toute demande de rétractation d'une ordonnance autorisant la saisie-contrefaçon d'un dessin ou modèle industriel, l'office de ce magistrat étant toutefois limité à l'appréciation de la légitimité et de l'opportunité de la mesure querellée.

Président du tribunal de première instance Yaoundé (Centre administratif), Ordonnance de référé n° 301/C du 19 février 2007, PMUC c. MENO Alfred

Observations :

L'ordonnance prescrivant une saisie-contrefaçon en matière de dessins et modèles industriels peut-elle faire l'objet d'un recours en rétractation devant le juge des référés? Telle est la question centrale posée dans l'affaire PMUC c. MENO Alfred à l'origine de la décision rapportée. Si cette problématique paraît triviale en droit commun, la rétractation étant la voie de recours normale contre les ordonnances sur requêtes, elle retrouve toutes ses lettres de noblesse sur le terrain du droit de la propriété intellectuelle, la saisie-contrefaçon, de par sa nature et son régime juridique, étant singulière comparativement aux mesures d'exécution classiques. La saisie-contrefaçon est en effet une mesure probatoire spécifique aux divers domaines de la propriété intellectuelle qui permet au titulaire du droit de faire pratiquer par un officier public des investigations, comprenant, en général, la description de la contrefaçon alléguée, de ses circonstances et de son étendue ou la saisie d'objets qui se rapportent à la contrefaçon. Les différentes annexes de l'Accord de Bangui utilisent plutôt la périphrase "description détaillée avec ou sans saisie" pour désigner la saisie-contrefaçon, ce qui apparaît d'ailleurs logique puisque cette mesure n'est pas une saisie au même titre que les saisies de droit commun. D'après un éminent auteur, cette périphrase est moins évocatrice et plus correcte²³.

Faits : Monsieur MENO Alfred, titulaire des droits sur le modèle industriel dénommé "business kiosque", enregistré à l'OAPI le 6 août 2004, a fait pratiquer une description détaillée avec enlèvement des kiosques appartenant au Pari mutuel urbain camerounais (PMUC) exploités par cette société sur les trottoirs et places publiques, en exécution de l'ordonnance n° 1608 rendue le 7 septembre 2006 par le président du tribunal de première instance de Yaoundé-Centre Administratif. Après exécution de cette mesure, le PMUC a assigné MENO Alfred devant le juge des référés de cette juridiction aux fins de rétractation de l'ordonnance sur requête et mainlevée de la saisie-contrefaçon pratiquée sur son fondement motifs pris du défaut de nouveauté du

modèle en querelle et de la non-production du certificat de non-radiation et de non-déchéance. MENO Alfred a soulevé l'exception d'incompétence du juge des référés, l'ordonnance de saisie-contrefaçon ne rentrant pas, selon lui, dans la catégorie des ordonnances retractables.

Raisonnement : La saisie-contrefaçon a une finalité essentiellement probatoire. Elle est prescrite, précise l'ABR-1999, par ordonnance du président du tribunal civil du lieu où l'exécution est envisagée. L'ABR-2015 précise que l'ordonnance est rendue par le président de la juridiction nationale compétente, évacuant ainsi les incertitudes générées par la périphrase "président du tribunal civil", les organisations judiciaires des États membres de l'OAPI n'étant pas uniformes²⁴. Toutefois, l'Accord de Bangui est muet quant aux recours éventuels contre les ordonnances du président du tribunal civil. Dans le silence de la législation spéciale, il y a lieu de convoquer le droit commun des ordonnances sur requête issu des législations nationales des États membres de l'OAPI qui admettent cette éventualité.

Si le juge, dans la décision commentée, s'est prononcé sans détours sur l'aptitude du juge des référés à connaître des recours en rétractation contre les ordonnances sur requête autorisant la saisie-contrefaçon (section I), il a simplement effleuré la question sous-jacente de l'étendue des pouvoirs de ce magistrat dans l'appréciation de la légitimité et de l'opportunité de ladite mesure (section II).

I. Le fondement juridique de la compétence du juge des référés en matière de rétractation d'une ordonnance de saisie-contrefaçon

La question du fondement juridique de la compétence du juge des référés en matière de rétractation d'une ordonnance de saisie-contrefaçon a été débattue en l'espèce, sieur MENO Alfred ayant soutenu que l'ordonnance de saisie-contrefaçon, s'agissant des dessins et modèles industriels, ne rentre pas dans la catégorie des ordonnances retractables. Cette approche, favorisée par le silence de l'Accord de Bangui révisé (A) n'a pas été retenue par le juge qui a convoqué le droit commun des ordonnances sur requête (B).

A. Le silence de l'Accord de Bangui révisé

L'Accord de Bangui révisé ne prévoit pas expressément de recours contre les ordonnances du président du tribunal civil autorisant la saisie-contrefaçon en matière de propriété industrielle. Il s'agit d'une omission regrettable en ce qu'elle prête le flanc aux interprétations divergentes au sein de la communauté des acteurs du système judiciaire de l'OAPI. L'argumentaire développé par sieur MENO Alfred en est une parfaite illustration. Ses conseils ont en effet soutenu que l'article 29.1) de l'annexe IV de l'Accord de Bangui du 24 février 1999 attribue la connaissance des actions relatives aux dessins et modèles industriels aux seuls tribunaux civils et les exclut du domaine de

23 Voir VÉRON (P.), Saisie-contrefaçon 2013/2014, 3^e éd., Paris (Dalloz), 2012, p. 3.

24 Cf. art. 65 al. 2 de l'annexe I; art. 58 al. 1 de l'annexe II; art. 51 al. 1 de l'annexe III; art. 33 al. 1 de l'annexe IV de l'ABR-2015.

la juridiction du provisoire. Il faut saluer la vigilance du juge qui a subtilement rejeté ce moyen spécieux en convoquant le droit commun des ordonnances sur requête qui s'applique en tout état de cause.

B. L'application du droit commun des ordonnances sur requête

Dans le silence de l'annexe IV de l'Accord de Bangui révisé relative aux dessins et modèles industriels, le juge a, à juste titre, convoqué le droit commun des ordonnances sur requête en indiquant "qu'il est incontestable en droit classique que le juge des référés est compétent pour statuer sur toute demande de rétractation d'une ordonnance rendue en matière gracieuse, sans exclusion du cas de la saisie-contrefaçon". L'ordonnance de saisie-contrefaçon étant une ordonnance gracieuse, elle obéit forcément au régime général en vigueur dans chaque État partie. C'est donc à bon droit que le juge des référés a retenu sa compétence en l'espèce. La cour d'appel de Brazzaville a rendu un arrêt assez édifiant à ce propos dans une affaire où la compétence du juge des référés était contestée par la victime d'une saisie-contrefaçon : "Considérant qu'il est de principe du droit positif que si le juge des ordonnances prononcées sur pied de requête fait droit à une requête, tout intéressé a la faculté de former une opposition en référé à fin de rétractation devant le juge qui a rendu l'ordonnance" (CA Brazzaville, Arrêt civil n° 92 du 3 juillet 2003, Aff. Les Établissements SAMORA c. Les Établissements WAFAA).

Le vide juridique sus-relevé semble avoir été comblé par l'Accord de Bamako du 14 décembre 2015. L'article 33, alinéa 1, de l'annexe IV dudit accord indique que la saisie est exécutée en vertu d'une ordonnance du président de la juridiction nationale compétente, soumettant désormais les ordonnances de saisie-contrefaçon au régime de droit commun des pays membres de l'OAPI.

II. L'étendue des pouvoirs du juge des référés en matière de rétractation d'une ordonnance de saisie-contrefaçon

Le juge des référés apprécie les conditions d'octroi de l'ordonnance de saisie-contrefaçon (A) mais pas le bien-fondé du droit du détenteur du titre revendiqué (B).

A. L'appréciation des conditions d'octroi de l'ordonnance de saisie-contrefaçon

L'office du juge des référés saisi d'une demande de rétractation d'une ordonnance de saisie-contrefaçon est purement formel. Il vérifie en effet si les pièces requises par la loi ont été produites à l'appui de la demande. En matière de dessins et modèles industriels, il s'agit de l'attestation de publicité délivrée par l'OAPI, de la preuve de non-radiation ou de non-déchéance et, éventuellement, du paiement du cautionnement²⁵. Il ressort de la décision rapportée que sieur MENO Alfred a produit aux débats l'arrêté n° 04/0052/OAPI/PG/DPG/HJT signé le 6 août 2004 par le directeur général de l'OAPI

portant enregistrement du dessin et modèle industriel "business kiosque", sa demande d'enregistrement datée du 16 juin 2003 avec copie des modèles déposés, ainsi que l'attestation de non-déchéance.

L'on est dès lors en droit de spéculer sur la pertinence des motifs qui ont déterminé le juge à rétracter l'ordonnance sur requête n° 1608 du 7 décembre 2006 et à ordonner subséquemment la mainlevée de la saisie-contrefaçon pratiquée le 15 décembre 2006 en exécution de cette décision. Deux raisons qui transparaissent de la motivation suivante semblent avoir guidé le juge, à savoir l'inopportunité de la saisie massive des modèles de kiosques litigieux et l'absence de risque de dépérissement desdits objets :

"Que l'exécution littérale de l'ordonnance querellée qui laisse à MENO le loisir de pratiquer cette mesure sans limitation dans l'espace ni quant au nombre de kiosques à saisir est susceptible d'entraîner des perturbations dans les activités exercées depuis 1994 par le PMUC et attestées par les pièces fournies au dossier de procédure; que du reste, il n'est nullement invoqué le risque de dépérissement ou de dissimulation des kiosques utilisés par le demandeur".

La question de l'étendue de la saisie-contrefaçon se pose de manière récurrente devant les tribunaux des États membres de l'OAPI. Les juges ont tendance, dans le silence de la loi, à cantonner la saisie à quelques exemplaires seulement des objets contrefaisants. Cette approche qui participe d'une logique prudentielle est partagée par une partie de la doctrine spécialisée qui soutient que le président a le pouvoir de refuser toute mesure lui paraissant inutile à la collecte des preuves et de nature à porter une atteinte non justifiée au saisi, telle qu'une saisie réelle d'une étendue *excessive*²⁶. La décision rapportée s'inscrit dans cette mouvance. Si l'Accord de Bangui ne fixe pas l'étendue de la saisie-contrefaçon, il revient au président du tribunal intervenant comme juge des requêtes ou juge des référés d'exercer son pouvoir de contrôle des modalités de la saisie avec délicatesse, tout en s'abstenant de s'immiscer dans la sphère du juge du fond.

B. L'appréciation du bien-fondé du droit du détenteur du titre

En règle générale, l'intervention du juge des référés dans le contentieux de la propriété intellectuelle ne modifie en rien les règles classiques de compétence secrétée par les codes de procédure civile des pays membres de l'OAPI. L'article 185 du code de procédure civile et commerciale camerounais sous l'empire duquel la décision rapportée a été rendue fait interdiction au juge des référés de préjudicier au principal. Dès lors, saisi d'une demande aux fins de rétractation d'une ordonnance autorisant une saisie-contrefaçon, le juge des référés ne peut examiner la validité du titre prétendument contrefait ni la matérialité de la contrefaçon alléguée, prérogatives

25 Cf. art. 31 al. 1, 2, 3 de l'annexe IV de l'ABR-1999; l'ABR-2015 a simplifié les conditions d'octroi de la mesure en supprimant la production de la preuve de non-radiation ou de non-déchéance; art. 33 al. 2 de l'ABR-2015.

26 Voir en ce sens CA Dakar, Arrêt n° 501 du 28 décembre 2012, *Société Ameropa SA c. Société Moustapha Tall* (obs. LAMOTTE (M.), ce recueil, chapitre 3, section K); VÉRON (P.), n.23, p. 90, n° 123.12.

qui relèvent de la compétence du juge de la contrefaçon. Le président du tribunal de première instance d'Abidjan-Plateau et son homologue de Douala-Ndokoti ont respectivement rendu deux décisions critiquables à cet égard en s'immiscant dans la sphère de compétence du juge du fond²⁷.

Dans l'espèce commentée, le juge des référés a fait preuve d'une grande sagesse en relevant dans ses motifs que "la présente espèce concerne non la connaissance du droit de propriété sur un modèle de kiosque, mais cumulativement la légitimité et l'opportunité d'une saisie-contrefaçon prescrite en l'absence d'un débat contradictoire". Ce magistrat a ainsi circonscrit les prérogatives du juge de l'urgence en matière de saisie-contrefaçon, lesquelles ont tendance à s'accroître à la faveur de la récente révision de l'Accord de Bangui intervenue à Bamako le 14 décembre 2015. L'article 32 de l'annexe IV dudit accord régissant les dessins et modèles industriels permet désormais à toute personne ayant qualité pour agir en contrefaçon de saisir en référé la juridiction nationale compétente afin de voir ordonner, au besoin sous astreinte, à l'encontre du prétendu contrefacteur ou des intermédiaires dont il utilise les services, toute mesure destinée à prévenir une atteinte imminente aux droits conférés par le certificat d'enregistrement ou à empêcher la poursuite des actes argués de contrefaçon. Il s'agit là d'une innovation majeure qui révolutionnera à coup sûr la mise en œuvre judiciaire des droits de propriété industrielle pour le grand bonheur des titulaires des titres.

Max Lambert Ndéma Elongué

27 Voir en ce sens PTPI Abidjan-Plateau, Ordonnance de référé n° 2240 du 5 mai 2002, *Société SIVORPRA c. ISSA MOHAMAD ALI*, Recueil des décisions de justice, Collection OAPI p. 439. Dans cette affaire, le juge des référés a ordonné l'interdiction de l'utilisation frauduleuse de la marque contrefaite et le retrait des produits contrefaisants sur toute l'étendue du territoire national. Voir également PTPI Douala-Ndokoti, Ordonnance de référé n° 189 du 22 août 2007, SPN. SA c. Société L.M Co Ltd, Recueil préc., p. 191. Dans cette autre affaire, le juge des référés a rejeté la demande en rétractation d'une ordonnance aux fins de saisie-contrefaçon au motif que la contrefaçon était avérée, vidant ainsi le contentieux au fond. Voir enfin Trib. hors classe, Ordonnance de référé n° 4167 du 14 avril 2008, *Société STCH c. Société SOTIBA SIMPAFRIC SA*; dans cette affaire, le président du tribunal hors classe de Dakar a ordonné la rétractation d'une ordonnance de saisie-contrefaçon pratiquée par le titulaire des droits sur un dessin ou modèle motif pris de ce que la société victime de la saisie dispose d'un droit antérieur sur le modèle litigieux, passant outre l'exception d'incompétence matérielle soulevée par le saisi qui avait déjà porté le litige devant le juge du fond.

A.
Utilisation d'un nom commercial enregistré
à l'OAPI par un concurrent sur le territoire
national de l'un des États membres –
Utilisation susceptible de créer une confusion
entre les entreprises en cause – Illégalité
de l'utilisation contestée – Demande
d'interdiction de l'utilisation du nom
commercial fondée

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Chapitre 5

Noms commerciaux

A. Utilisation d'un nom commercial enregistré à l'OAPI par un concurrent sur le territoire national de l'un des États membres – Utilisation susceptible de créer une confusion entre les entreprises en cause – Illégalité de l'utilisation contestée – Demande d'interdiction de l'utilisation du nom commercial fondée

La demande d'interdiction de l'utilisation d'un nom commercial enregistré à l'OAPI par le titulaire de l'enregistrement ne peut prospérer que lorsque trois conditions sont réunies : le nom commercial doit être utilisé sur le territoire national de l'un des États membres de l'OAPI; cette utilisation doit être l'œuvre d'un concurrent; elle doit enfin être susceptible de créer une confusion entre les entreprises en cause.

Tribunal de commerce d'Abidjan, Jugement du 14 avril 2016 RG n° 4653/2015, SOCIÉTÉ BATIPRO c. SOCIÉTÉ EMBCI-PRO BÉTON

Observations :

Aux termes de l'article 1^{er} de l'annexe V de l'Accord de Bangui révisé du 24 février 1999, le nom commercial est la dénomination sous laquelle est connu et exploité un établissement commercial, industriel, artisanal, agricole¹. Il constitue un des signes distinctifs contribuant au ralliement de la clientèle des entreprises. Le droit exclusif sur un nom commercial s'acquiert dans l'espace OAPI suivant deux modalités : l'usage et l'obtention de son enregistrement². Cette dernière formalité ne met cependant pas le nom commercial à l'abri des utilisations illicites, comme il en ressort du jugement du tribunal de commerce d'Abidjan du 14 avril 2016 rapporté.

Faits : Il ressort de ce jugement que la société BATIPRO est titulaire du nom commercial "PROBÉTON" en vertu des certificats d'enregistrement de marque et de nom commercial délivrés par l'OAPI et datés des 29 mai et 31 août 2015. Nonobstant cet enregistrement, la société EMBCI-PROBÉTON a utilisé la dénomination "PROBÉTON" en violation du droit exclusif de la société BATIPRO sur celle-ci. Cette utilisation illicite a fait l'objet d'un procès-verbal de constat d'huissier dressé le 11 mars 2015. C'est donc naturellement que la société BATIPRO a saisi le tribunal de commerce d'Abidjan pour solliciter qu'il soit fait interdiction à la société EMBCI-PROBÉTON d'utiliser

la dénomination "PROBÉTON". En réaction à l'action de la société BATIPRO, la société EMBCI-PROBÉTON a sollicité reconventionnellement l'annulation du nom commercial "PROBÉTON" revendiqué par la société BATIPRO.

Raisonnement : Les deux demandes principale et reconventionnelle invitaient le juge à se prononcer respectivement sur deux problèmes juridiques :

- I. le premier problème était de savoir à quelles conditions l'utilisation d'un nom commercial enregistré est illégale; et
- II. le second problème quant à lui était de savoir si un nom commercial enregistré peut être annulé.

La cour a décidé de donner une suite favorable à la demande de la société BATIPRO qui sollicitait l'interdiction de l'utilisation de la dénomination "PROBÉTON" par la société EMBCI-PROBÉTON et de rejeter la demande d'annulation de cette dénomination formulée par cette dernière société.

I. Les conditions de succès de la demande d'interdiction de l'utilisation d'un nom commercial enregistré

Aux termes de l'article 16 de l'annexe V de l'Accord de Bangui révisé du 24 février 1999, en cas de violation des droits attachés à un nom commercial, le titulaire desdits droits peut en interdire la continuation et demander le paiement de dommages et intérêts ainsi que l'application de toute autre sanction prévue par le droit civil. L'action en interdiction ne peut cependant prospérer que lorsque les conditions fixées par l'article 5, alinéa 1, de l'annexe V sont réunies. Il ressort de ce texte que l'utilisation d'un nom commercial n'est illicite que lorsque les trois conditions ci-après sont réunies :

- l'utilisation du nom commercial sur le territoire national de l'un des États membres;
- l'utilisation d'un nom commercial enregistré pour la même activité commerciale, industrielle, artisanale ou agricole que celle du titulaire du nom commercial enregistré; et
- une utilisation susceptible de créer une confusion entre les entreprises en cause.

Il convient de vérifier si ces trois conditions étaient réunies dans le cas de l'espèce.

Le tribunal ne s'est pas prononcé explicitement sur la première condition relative à l'utilisation du nom commercial sur le territoire national de l'un des États membres. Il a sans doute estimé, sans confirmer, que

1 L'art. 1 de l'annexe V de l'ABR-2015 reprend la même définition et y ajoute l'expression "ou exerçant une autre activité économique".

2 Cf. art. 3 al. 1 de l'annexe V de l'ABR-1999.

l'existence de cette condition allait de soi car les deux entreprises ont leur siège social à Abidjan à Port-Bouët, et l'utilisation du nom commercial "PROBÉTON" par la société EMBCI-PROBÉTON s'est de toute évidence faite sur le territoire ivoirien.

Le tribunal s'est en revanche prononcé sur la deuxième condition relative à l'utilisation du nom commercial enregistré pour la même activité commerciale, industrielle, artisanale ou agricole que celle du titulaire du nom commercial enregistré, même s'il ne l'a pas fait de manière très explicite. L'expression "même activité" signifie qu'il doit exister un rapport de concurrence entre le demandeur et le défendeur, c'est-à-dire une offre de biens et services à une clientèle commune. Selon le tribunal, il résulte du procès-verbal de constat du 11 mars 2015 versé au dossier l'existence d'une similitude du domaine d'activité entre les deux sociétés. Ce qui permet d'affirmer que la deuxième condition requise pour que l'utilisation du nom commercial enregistré soit illégale était donc remplie.

Contrairement aux deux premières conditions, la troisième condition relative à l'utilisation du nom commercial enregistré susceptible de créer une confusion entre les entreprises en cause a mérité plus d'attention de la part du tribunal. Celui-ci relève d'abord que tous ceux qui accèdent aux panneaux publicitaires et pancartes de la société EMBCI-PROBÉTON font la confusion avec le nom commercial et la marque de la demanderesse. Le tribunal relève ensuite que l'usage de la palette de la marque – la même nuance de rouge et la similitude du domaine d'activité – ne manquent pas de créer le trouble dans l'esprit des consommateurs des deux sociétés dont certains contractent avec l'une alors qu'ils croyaient s'adresser à l'autre. Cette confusion entre les deux sociétés s'est faite naturellement au détriment de la société BATIPRO qui est titulaire du nom commercial litigieux dont l'usage antérieur lui a conféré le crédit que lui accordent ses clients.

Les conditions requises pour qu'il y ait utilisation illégale du nom commercial enregistré étant réunies, c'est donc à juste titre que le tribunal a déclaré la société BATIPRO bien fondée en sa demande et a fait interdiction sous astreinte à la société EMBCI-PROBÉTON d'utiliser le nom commercial "PROBÉTON" sous peine de sanction financière.

Même si le problème ne s'est pas posé dans le cas de l'espèce, il convient de souligner que l'article 5 de l'annexe V de l'ABR-1999 prévoit en ses alinéas 2 et 3 deux hypothèses dans lesquelles le titulaire d'un nom commercial enregistré ne peut en interdire l'utilisation aux tiers³.

Selon la première hypothèse inscrite à l'article 5, alinéa 2,

"le titulaire d'un nom commercial ne peut interdire aux tiers l'usage de bonne foi de leur nom, de leur adresse, d'un pseudonyme, d'un nom géographique ou d'indications exactes relatives à l'espèce, la qualité, la quantité, la destination, la valeur, le lieu d'origine ou l'époque de la production de leurs produits ou de la prestation de leurs services, pour autant qu'il s'agisse d'un usage limité à des fins de simple identification ou d'information et qui ne puisse pas induire le public en erreur sur la provenance des produits ou des services".

Selon la seconde hypothèse prévue à l'article 5, alinéa 3,

"l'intéressé qui porte un prénom similaire à un nom commercial enregistré doit, si ses droits sur le nom commercial attaché à son établissement sont postérieurs à ceux qui sont attachés au nom commercial enregistré, prendre toute mesure, par adjonction faite à son nom commercial ou de toute manière, afin de distinguer ce nom commercial du nom commercial enregistré".

Ces deux hypothèses constituent des limites au droit exclusif reconnu au titulaire d'un nom commercial enregistré. Il faut ajouter à ces deux limites la possibilité d'obtenir l'annulation d'un nom commercial enregistré.

II. La possibilité d'annulation d'un nom commercial enregistré

Dans sa demande reconventionnelle, la société EMBCI-PROBÉTON sollicite sans la moindre motivation l'annulation du nom commercial "PROBÉTON" revendiqué par la société BATIPRO. Le tribunal rejette sa demande en lui opposant simplement la titularité de la société BATIPRO sur le nom commercial litigieux. Ce qui peut laisser croire qu'il n'est pas possible d'annuler un nom commercial enregistré.

L'annexe V de l'ABR-1999 consacre cependant son article 14 à la nullité du nom commercial. Les alinéas 1 et 2 indiquent les personnes qui peuvent demander l'annulation de l'enregistrement d'un nom commercial. Il s'agit du ministère public, de toute personne physique ou morale intéressée et de l'OAPI.

Les motifs qui peuvent justifier cette annulation sont également indiqués par l'alinéa 2 comme suit :

- a. Le premier motif d'annulation d'un nom commercial enregistré est la non-conformité de la dénomination enregistrée à la définition du nom commercial donnée par l'article 1 de l'annexe V. Il doit s'agir d'une dénomination sous laquelle est connu et exploité un établissement commercial, industriel, artisanal ou agricole.
- b. Le deuxième motif d'annulation d'un nom commercial enregistré est prévu par l'article 2 de l'annexe V et concerne le cas où le nom ou

3 Ces deux hypothèses sont reprises *in extenso* par l'art. 5 de l'annexe V de l'ABR-2015 non encore entré en vigueur.

la désignation enregistré(e) ne peut constituer un nom commercial. Il s'agit du "nom ou de la désignation qui, par sa nature ou l'usage qui peut en être fait, est contraire aux bonnes mœurs ou à l'ordre public et qui, notamment, pourrait tromper les milieux commerciaux ou le public sur la nature de l'établissement commercial, industriel, artisanal ou agricole désigné par ce nom".

- c. Le troisième motif d'annulation d'un nom commercial enregistré est prévu par l'article 5, alinéa 1, de l'annexe V et concernerait le cas où l'enregistrement porte sur un nom commercial déjà enregistré pour la même activité commerciale, industrielle, artisanale ou agricole que celle du titulaire du nom commercial déjà enregistré.
- d. Le dernier motif d'annulation d'un nom commercial enregistré concerne le cas où l'enregistrement est en conflit avec un droit antérieur. Cette hypothèse est plus large que la troisième car elle vise tous les droits de propriété intellectuelle antérieurs, alors que la troisième hypothèse vise uniquement le droit antérieur sur le nom commercial enregistré.

Ce dernier motif a fait l'objet d'application par le tribunal de première instance de Libreville dans un jugement rendu le 14 mai 2008⁴. Il ressort de ce jugement que la Compagnie Générale des Établissements Michelin-Michelin, la demanderesse, est titulaire de plusieurs marques dénommées "Michelin" enregistrées à l'OAPI aux numéros et dates ci-après :

- Michelin n° 36897 enregistrée le 7 octobre 1996;
- Michelin n° 44309 enregistrée le 22 juin 2001;
- Michelin n° 44310 enregistrée le 22 juin 2001.

Le 23 avril 2002, c'est-à-dire postérieurement aux enregistrements de la demanderesse, le sieur Rabiou ABDU WASSI, le défendeur, procédait à l'OAPI au dépôt et à l'enregistrement au titre de nom commercial, du signe "Michelin Dieu Merci". Informée de cet enregistrement, la demanderesse a saisi le tribunal en vue d'obtenir l'annulation de l'enregistrement du nom commercial "Michelin Dieu Merci" motif pris de ce que ce nom est en conflit avec son droit acquis antérieur. Après avoir constaté que l'enregistrement du nom commercial "Michelin Dieu Merci" du 23 avril 2002 sous le n° 34058 était postérieur à celui de la demanderesse, le tribunal en a déduit que le droit de cette dernière est antérieur au nom commercial "Michelin Dieu Merci" et a par conséquent déclaré nul et non avenu l'enregistrement du nom commercial "Michelin Dieu Merci".

Dans le jugement rapporté, aucun des quatre motifs sus-évoqués n'a été invoqué par la société EMBCI-PROBÉTON pour justifier sa demande d'annulation du nom commercial "PROBÉTON" enregistré par la société BATIPRO. Ne l'ayant pas fait, elle n'avait aucune chance d'avoir gain de cause. Mais si la décision du tribunal rejetant la demande de la société EMBCI-PROBÉTON est

fondée, sa motivation n'est pas à l'abri des critiques. Il justifie en effet sa décision uniquement par la titularité de la société BATIPRO sur le nom commercial enregistré. Or, comme il vient d'être amplement démontré, un nom commercial enregistré peut être annulé si l'un des motifs d'annulation prévus par l'article 14 de l'annexe V de l'Accord de Bangui révisé de 1999 existe. Le tribunal aurait dû motiver sa décision par l'absence de ces motifs.

Grégoire Jiogue

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Chapitre 6

Propriété littéraire et artistique

A. Œuvre de l'esprit – Notion – Nécessité d'une forme perceptible par les sens – Reprise servile d'un jeu – Concours sous la même appellation que celle utilisée par le créateur du jeu-concours – Concurrence parasitaire caractérisée

Une création intellectuelle ne peut être investie du droit d'auteur que si elle est exprimée sous une forme susceptible d'être perçue par les sens. Tel n'est pas le cas pour les règles d'un jeu-concours qui ne peuvent constituer en elles-mêmes une œuvre de l'esprit.

Cependant, un jeu-concours qui n'est pas investi du droit d'auteur peut être protégé par les règles de la concurrence déloyale, lorsqu'une personne s'est immiscée dans le sillage de son créateur, pour en tirer profit, sans bourse délier. En effet, une telle immixtion est constitutive de concurrence parasitaire.

Tribunal de commerce d'Abidjan, jugement du 19 décembre 2017, n° 3556/17, MADAME AMISSAH MARIELLE LINDA c. 1. SOUMAHORO MAURY FERÉ, 2. MGROUPE, 3. MTN CÔTE D'IVOIRE, 4. LE BUREAU IVOIRIEN DU DROIT D'AUTEUR

Observations:

Dans cette affaire, le tribunal de commerce d'Abidjan était invité à se prononcer sur deux questions juridiques : la première question était de savoir à quelle condition un jeu-concours peut être protégé par le droit d'auteur (I). La seconde question quant à elle était de savoir si la reprise par les défendeurs d'un jeu-concours sous la même appellation et sans le consentement de la demanderesse qui en était le créateur est constitutive de concurrence parasitaire et peut être protégée (II).

I. La protection d'une création intellectuelle par le droit d'auteur

Toutes les lois nationales sur le droit d'auteur précisent que celui-ci ne peut protéger qu'une œuvre originale et l'article 3.1 de l'annexe VII de l'Accord de Bangui se prononce dans le même sens. L'exigence, en réalité, peut se dédoubler en ce sens qu'on peut (*et il est même permis de penser qu'on doit, si l'on veut être rigoureux*), subordonner la naissance du droit à la double condition que le demandeur justifie de l'existence d'une œuvre de l'esprit et du caractère original de cette œuvre.

Le jugement rapporté permet d'illustrer la première proposition. Le tribunal de commerce d'Abidjan, en effet,

refuse la protection du droit d'auteur au concept d'un jeu-concours intitulé "Les awards du coupé-décalé", qui fait la promotion d'un genre musical très populaire dans les années 2000-2010 en Côte d'Ivoire. La demanderesse, une chanteuse, qui s'est illustrée dans le courant musical dit de la "stylmoulance", prétend que le jeu qu'elle a créé en 2010 est une œuvre originale et qu'il a fait l'objet de la part des défendeurs d'une "représentation" contrefaisante. Les défendeurs rétorquent que la demanderesse "est dans l'incapacité de fournir des éléments objectifs attestant que son nom est apparu d'une manière usuelle sur l'œuvre scénique 'Les awards du coupé-décalé' et qu'elle a développé un format de représentation scénique qui porterait son empreinte propre". Ils ajoutent que "la protection du droit d'auteur ne s'étend pas aux idées, méthodes, procédures, concepts ou informations en tant que tels et qu'en tout état de cause, la demanderesse ne rapporte pas la preuve d'un enregistrement auprès du BURIDA", ce qui lui interdit d'opposer aux tiers un quelconque droit sur l'œuvre en cause.

Les trois objections, en vérité, sont de valeur très inégale. Que l'emprunt à une œuvre antérieure ne s'accompagne pas de la mention du nom de l'auteur de cette œuvre ne suffit évidemment pas à exclure la contrefaçon alléguée. L'enregistrement de l'œuvre auprès d'une société de gestion collective ne saurait, par ailleurs, conditionner la naissance du droit d'auteur. Comme le jugement rapporté l'observe en termes excellents, il se déduit tant de l'article 4 de l'annexe VII de l'ABR-2015 que de l'article 5 de la loi ivoirienne sur le droit d'auteur de 2016 qu'il "est constant que le droit d'auteur s'acquiert sans formalités, du fait même de la création de l'œuvre".

Reste le débat sur l'existence même d'une œuvre de l'esprit au sens de la législation sur le droit d'auteur, que le tribunal tranche en démontrant d'une manière très didactique, qui mérite de retenir l'attention, pourquoi la condition n'est pas remplie en l'espèce.

Il commence par poser le principe qu'une "création intellectuelle" ne peut être investie du droit d'auteur que si elle est "exprimée sous une forme ou une représentation originale". L'alternative posée ("*forme*" ou "*représentation*") n'est pas très heureuse car la "représentation" n'est qu'un mode de communication de l'œuvre, et il aurait donc été préférable de s'en tenir à l'exigence d'une "forme". Mais l'on ne peut qu'adhérer à l'argumentation développée sur cette base : "L'exigence de la forme dans laquelle la création doit être coulée est liée à la possibilité de communiquer l'œuvre et donc de percevoir par les sens qui sont susceptibles d'assurer la

réception de ladite œuvre par leur destinataire. Ainsi, indépendamment de la forme ou de la présentation originale qui ont pu leur être données, les règles d'un jeu-concours ne peuvent constituer en elles-mêmes une œuvre de l'esprit protégée par le droit d'auteur".

On ne saurait mieux dire que le droit d'auteur n'a vocation à protéger qu'une création se concrétisant dans une forme perceptible par les sens. Il n'y a là qu'une application du principe fondamental du droit de la propriété intellectuelle selon lequel les idées sont en elles-mêmes de libre parcours¹. Elle signifie que la protection du droit d'auteur, une fois acquise, ne peut s'étendre aux idées qui sont contenues dans l'œuvre, ainsi que le rappelle l'article 2 du Traité de l'OMPI sur le droit d'auteur de 1996 (WCT), sous l'intitulé "Étendue de la protection par le droit d'auteur" ("*La protection au titre du droit d'auteur s'étend aux expressions et non aux idées, procédures, méthodes de fonctionnement ou concepts mathématiques en tant que tels*"). Elle implique aussi qu'en amont, l'œuvre ne peut être investie du droit d'auteur qu'à la condition de se concrétiser dans une forme.

De ce point de vue, le tribunal a raison de ne pas apporter de crédit aux affirmations de la demanderesse selon lesquelles son jeu "est le fruit d'un travail intellectuel qui provient d'un certain nombre de choix arbitraires mettant en exergue l'originalité de ce jeu", plus précisément le classement des artistes par catégories, la définition du mode de désignation des vainqueurs, le déroulement de la manifestation qui intègre un défilé, une diffusion vidéo, un hommage à Douk Saga (*pionnier du genre musical célébré*) et au final un concert *live* des artistes du coupé-décalé. En effet, l'existence d'un "travail intellectuel" (*la demanderesse mettait aussi l'accent sur son "effort de réflexion"*) et de "choix arbitraires" ne permet pas, à elle seule, de caractériser une œuvre protégeable. En l'espèce, pour accéder au bénéfice du droit d'auteur, la demanderesse aurait dû, relève le tribunal, établir "la forme ou la présentation originale sous lesquelles les idées sus-indiquées sont exprimées, cette forme pouvant notamment consister en l'élaboration d'un texte matérialisant le jeu-concours". L'exemple du "texte matérialisant le jeu-concours" n'est peut-être pas le plus pertinent car on peut douter que la simple description du jeu par des mots puisse remplir la condition d'originalité, et il aurait été plus parlant d'évoquer, comme le faisaient les défenseurs eux-mêmes, l'hypothèse d'une concrétisation sous la forme d'un "format de représentation scénique" du jeu-concours. Mais la conclusion n'en est pas moins imparable : la demanderesse n'a pas "rapporté la preuve d'une réalisation de forme en plus de l'activité intellectuelle de création".

La décision nous apparaît fondée en droit et en fait. Elle peut être rapprochée d'un arrêt de la Cour de cassation

1 Voir pour une illustration ancienne Tribunal civil de la Seine, 19 décembre 1928 : Ann. propr. ind. 1929, p. 181 : "Dans le domaine de la pensée, l'idée demeure éternellement libre et ne peut jamais devenir l'objet d'une protection privative."

française² qui, à propos d'un concours ayant pour objet de faire décerner des prix aux meilleurs produits de beauté de l'année, a jugé que "les règles d'un concours, même si elles procèdent de choix arbitraires, ne peuvent, indépendamment de la forme ou de la présentation générale qui ont pu leur être données, constituer en elles-mêmes une œuvre de l'esprit protégée".

Elle est d'une grande portée si l'on songe que la protection du droit d'auteur est souvent revendiquée, comme on le vérifie dans la jurisprudence de nombreux pays de l'Union européenne, pour des "concepts" de jeux télévisés qui se négocient à des prix astronomiques³. Il est admis que cette protection ne peut être accordée que si le concept se concrétise dans ce que la pratique, dans le jargon de l'audiovisuel, appelle un "format", concrétisant le concept dans une émission découpée et structurée.

On peut, pour éclairer la distinction, se reporter à un arrêt rendu par la cour d'appel de Paris⁴. Il s'agissait d'un projet d'émission télévisée sur les collections constituées par des "stars". Son auteur, qui avait enregistré ce projet à la Société des Gens de Lettres (*un organisme de défense des auteurs créé au XIX^e siècle*), avait reconnu son idée dans une émission de la chaîne de télévision TF1. La cour d'appel a admis qu'il y avait là une œuvre de l'esprit. Certes, le synopsis était bref, mais il comportait des éléments précis :

- D'abord, il associait à un reportage au domicile d'une star sur la collection constituée par celle-ci un reportage technique sur ladite collection, l'intervention d'un psychologue sur la star et sa collection, un jeu primé portant sur une question de culture générale sur un objet, un tableau ou un artiste, une information sur l'actualité de la star.
- Ensuite, le projet proposait un véritable découpage de l'émission.
- Enfin, il donnait des indications sur son "ton" ("*jeune, mutine, rapide*"...).

Mais la demanderesse n'en a pas moins été déboutée, au motif qu'aucune des émissions de TF1 "ne reproduit la combinaison ci-dessus". Et le téléspectateur qui a raté les émissions d'apprendre qu'on a montré la collection de cigales en faïence de Michèle Torr, la collection de cuillères tordues d'Uri Geller, la collection d'art moderne de Daniel Hechter, la collection de cochons de Jean-Claude Dreyfus, les collections de voitures d'Alain-Dominique Perrin et du Roi du Maroc, mais jamais dans les conditions énumérées par le synopsis de la demanderesse.

2 Cass. civ., 1^{re} chambre, 29 novembre 2005, n° 04-12.721 : RIDA 2006, p. 273; Communication commerce électronique 2006, comm. 18, 1^{re} esp. (note CARON (C.)); D. 2006, p. 517 (note TRICOIRE (A.)); RTD com. 2006, p. 78 (obs. POLLAUD-DULIAN (F.)).

3 Voir sur l'ensemble du problème DERIEUX (E.), La protection des projets et genres d'émissions : Légipresse 1994, II, pp. 97-106; KARNELL (G. W. G.), Copyright to Sequels – With Special Regard to Television Show Formats, 31 IIC, 2000, pp. 886-913

4 CA Paris, 4^e chambre, 6 décembre 2002 : Propr. intell. 2003, p. 158, 2^e esp. (obs. LUCAS (A.)).

Les deux arrêts appliquent les mêmes principes. Si la protection du droit d'auteur est écartée dans le premier et admise dans le second, c'est sur la base de la même distinction entre un simple canevas sans véritable contenu (*une émission ludique sur le pourquoi des choses ou des phénomènes de la vie quotidienne*) et un projet structuré, un "format" dit-on souvent dans le jargon de l'audiovisuel (*une émission découpée et structurée*).

La distinction entre l'idée exclue du champ de la protection et l'œuvre protégeable est souvent mise en œuvre également dans le domaine de la publicité. Ainsi, la Cour de cassation française a érigé en principe "qu'une simple idée publicitaire, fût-elle originale, ne saurait être susceptible d'appropriation en elle-même"⁵ mais une jurisprudence abondante décide que ce refus cesse lorsque l'idée publicitaire s'incarne dans un slogan ou un dessin.

II. La protection d'une création intellectuelle par la concurrence parasitaire

Il est aujourd'hui établi que le parasitisme est un acte de concurrence déloyale⁶. Mais l'admission du parasitisme comme hypothèse de concurrence déloyale marque une évolution notable dans la conception de cette dernière. Traditionnellement en effet, la concurrence déloyale n'est admise que lorsque le demandeur et le défendeur sont en situation de concurrence, autrement dit, lorsque les deux partagent une clientèle commune⁷. Il est cependant progressivement apparu que la déloyauté peut être constituée en dehors de l'existence d'une clientèle commune⁸. Il en est ainsi en cas de parasitisme où il est admis que les agissements parasitaires sont déloyaux même en l'absence de toute situation de concurrence⁹.

Le tribunal de commerce d'Abidjan définit le parasitisme comme l'ensemble des comportements par lesquels un agent économique s'immisce dans le sillage d'un autre, afin de tirer profit, sans rien en dépenser, de ses efforts et de son savoir. Cette définition est conforme à celle donnée par la doctrine qui est à l'origine de la théorie des agissements parasitaires¹⁰. Selon Saint-Gal, celui qui vit en "parasite dans le sillage d'un autre en profitant des efforts qu'il a réalisés et de la réputation de son nom et de sa notoriété" a un comportement illégal. Cette définition doctrinale a été consacrée par la Chambre commerciale de la Cour de cassation française en ces termes : "Le parasitisme économique se définit comme l'ensemble des comportements par lesquels un agent économique s'immisce dans le sillage d'un autre afin de tirer profit, sans rien dépenser de ses efforts et de son savoir-faire"¹¹.

La définition du parasitisme donnée par le tribunal de commerce d'Abidjan étant validée, il reste à savoir s'il a eu raison de l'appliquer en matière de création intellectuelle, en l'occurrence le jeu-concours de récompense des acteurs du monde du "COUPÉ DÉCALÉ", intitulé "LES AWARDS DU COUPÉ DÉCALÉ", créé par Mme AMISSAH Marielle Linda dite Lindsay, la demanderesse, et dont la première édition a eu lieu en juillet 2010. Au cours de cette édition, plusieurs artistes et organisateurs de spectacles ont été récompensés dont Monsieur SOUMAHORO Maury Féré dit le Molare. Mais en raison de la crise post-électorale intervenue en 2011 en Côte d'Ivoire, la demanderesse n'a pas pu organiser immédiatement la deuxième édition. Cependant, au moment où elle s'apprêtait en 2016 à organiser cette deuxième édition, elle a été surprise de constater que Monsieur SOUMAHORO Maury Féré dit le Molare et la société MGROUPE entreprenaient d'organiser la première édition des "AWARDS DU COUPÉ DÉCALÉ", avec le sponsoring de la société MTN. En dépit des multiples interpellations faites par la demanderesse en vue de dissuader les défendeurs, ces derniers ont tout de même organisé la manifestation. C'est alors qu'elle a saisi le tribunal de commerce d'Abidjan pour obtenir réparation du préjudice subi du fait du parasitisme des défendeurs.

La théorie du parasitisme a d'abord été élaborée à propos de l'usurpation de marque¹² et toutes ses applications jurisprudentielles concernent le domaine économique, d'où les expressions "parasitisme économique" et "agent économique" utilisées par la majorité des décisions de justice¹³. Cette dernière expression est d'ailleurs utilisée par le tribunal de commerce d'Abidjan lui-même dans la définition qu'il donne du parasitisme.

Ainsi entendu, le parasitisme en tant qu'acte de concurrence déloyale a pour domaine de prédilection les activités économiques. Or il est très difficile de soutenir qu'un jeu-concours organisé de manière presque bénévole et occasionnellement par une personne physique est une activité économique. Ce jeu-concours n'entre pas non plus dans le domaine de la concurrence déloyale défini par l'Accord de Bangui révisé du 24 février 1999, qui ne vise que les activités industrielles et commerciales. Or le jeu-concours litigieux n'est ni une activité industrielle, ni une activité commerciale, encore moins une activité libérale que l'Acte de Bamako de 2015 assimile aux activités industrielles et commerciales. Même la jurisprudence relative à la concurrence déloyale, construite sur le fondement de l'article 1382 du Code civil, qui a une conception très large du domaine de la concurrence déloyale, exclut de celui-ci les services dits traditionnels (il s'agit des organismes politiques, syndicaux, culturels, professionnels, philanthropiques, etc.) en raison de leur caractère désintéressé. Il en est de ces services dits traditionnels comme du jeu-concours litigieux, car rien dans la décision rapportée ne permet

5 Cass. com., 16 juin 1964 : JCP G 1965, II, n° 14059 et : Ann. Propr. Ind. 1965, p. 279.

6 RIPERT (V. G.) / ROBLLOT (R.), VOGEL (L.), *Traité de droit commercial*, Tome 1, Vol. 1, 18^e éd., Paris (LGDJ), 2001 n° 752 – 753, pp. 613 et s.

7 PIROVANO (A.), *La concurrence déloyale en droit français* : RID comp., 1974, p. 467.

8 RIPERT (V. G.) / ROBLLOT (R.), VOGEL (L.), *Ibid.*, n° 730, pp. 595 et 596 et toute la jurisprudence citée.

9 Cass. com., 30 janvier 1996 : Bull. civ., IV, n° 32.

10 SAINT-GAL (Y.), *concurrence parasitaire ou agissements parasitaires* : RIPIA 1956, p. 37.

11 Cass. com., 26 janvier 1999, n° 96-22.457 : BRDA 1999, n° 6, p. 10 : D. 2000, p. 87 (note SERRA (Y.)).

12 SAINT-GAL (Y.), n.10.

13 Cass. com., 26 janvier 1999, n.11.; CA Toulouse, 19 octobre 1988 : D. 1989, p. 290 (note BARBERI); Cass. com., 9 mai 1991 : PIBD 1991, III, p. 699; CA Versailles, 16 janvier 1997 : D. 1997, p. 565.

de dire si ce jeu-concours était organisé dans un but lucratif.

Il convient cependant de relever que le parasitisme n'obéit pas aux mêmes conditions que la concurrence déloyale traditionnelle. Celle-ci ne peut exister que lorsqu'il existe une clientèle commune. Or il peut y avoir parasitisme sans clientèle commune. Dans cette optique, la position du tribunal de commerce d'Abidjan devient dès lors compréhensible. Ce que la concurrence déloyale classique ne permet pas de faire peut l'être par le parasitisme. Le berceau du parasitisme est certes le domaine économique, mais il peut bien s'appliquer à des domaines non économiques tels que le domaine artistique. C'est donc à juste titre que le tribunal n'a pas parlé de parasitisme économique, mais de parasitisme artistique. En raison de la généralité de la théorie du parasitisme, rien n'interdit de l'appliquer au domaine artistique lorsque les éléments constitutifs en sont caractérisés.

Dans le cas de l'espèce, le juge se fonde sur deux faits pour retenir le parasitisme artistique :

- la reprise de manière servile du jeu-concours "LES AWARDS DU COUPÉ DÉCALÉ" sous la même appellation par les défendeurs, alors qu'ils étaient présents à la première édition qui s'est tenue en 2010;
- la proximité du jeu organisé par ces derniers, qui traduit une proximité de réalisation telle qu'elle évoque nécessairement dans l'esprit du public le jeu-concours créé par la demanderesse.

Au regard de ces faits, on peut conclure à juste titre, comme l'a fait le tribunal de commerce d'Abidjan, que les défendeurs se sont immiscés dans le sillage de la demanderesse, pour tirer profit, sans bourse délier, de la création intellectuelle de celle-ci.

Comme on peut le constater, la protection d'une création intellectuelle peut être refusée sur le terrain du droit d'auteur et être accordée sur celui du parasitisme. Mais le rôle supplétif du parasitisme ne doit pas être exagéré. En effet, si on en vient à admettre que toute reprise d'une création non protégée est parasitaire, on affecte la cohérence de la propriété intellectuelle. C'est dans ce sens que s'inscrit l'arrêt de la cour d'appel de Paris du 18 octobre 2000¹⁴ qui a décidé que le fait de faire des économies en reproduisant la prestation d'autrui ne constitue pas une faute, la reproduction d'une prestation non couverte par les droits de propriété intellectuelle étant en principe libre.

Le parasitisme artistique étant caractérisé, le tribunal ne pouvait accéder à la demande en réparation de la demanderesse qu'après avoir établi l'existence d'un préjudice. Pour le tribunal, le préjudice causé à la demanderesse est certain et consiste en la perte de son investissement intellectuel. Celle-ci peut en effet "difficilement reprendre l'organisation du jeu-concours litigieux qui est désormais rattachée à la personne de

Monsieur SOUMAHORO Maury Féré dit Le Molare dont la notoriété dans l'univers musical du COUPÉ DÉCALÉ est solidement établie".

On peut cependant s'interroger sur le fondement juridique de la réparation du préjudice subi par la demanderesse. Le tribunal de commerce d'Abidjan vise en effet l'article 1382 du Code civil et non l'annexe VIII de l'Accord de Bangui révisé du 24 février 1999. Or depuis la consécration de la théorie de la concurrence déloyale par les Accords successifs de Bangui, l'article 1382 du Code civil ne devrait normalement plus s'appliquer à l'action en concurrence déloyale¹⁵.

Mais l'enseignement qu'on doit tirer du jugement rapporté est qu'on doit réserver le cas de la concurrence déloyale parasitaire, surtout lorsque le parasitisme n'est pas économique, mais artistique comme dans le cas de l'espèce. En effet, selon l'annexe VIII de l'Accord révisé de Bangui de 1999, seules les activités industrielles et commerciales entrent dans le domaine d'application de la concurrence déloyale. Or, le jeu-concours litigieux n'est ni une activité industrielle, ni une activité commerciale, mais une pure création intellectuelle. Il y a donc coexistence de deux fondements juridiques de la concurrence déloyale dans l'espace OAPI : l'article 1382 du Code civil et l'annexe VIII de l'Accord de Bangui. Celle-ci doit être considérée comme le fondement juridique principal et celui-là considéré comme le fondement juridique subsidiaire.

André Lucas

B. Originalité – Condition de protection des œuvres – Contenu du concept – Mélange des critères objectif et subjectif – Reproduction des expressions et éléments caractéristiques originaux de l'œuvre – Contrefaçon

En règle générale, l'œuvre éligible à la protection par le droit d'auteur est celle dite originale, c'est-à-dire, au sens de l'article 1^{er} de la loi ivoirienne du 26 juillet 2016 relative au droit d'auteur et aux droits voisins, celle qui constitue une création intellectuelle propre à son auteur.

La contrefaçon par reproduction d'une œuvre littéraire suppose la reprise totale ou partielle des expressions ou éléments caractéristiques originaux d'une œuvre préexistante. En l'absence d'autorisation préalable de l'auteur de l'œuvre, cette reproduction illicite est lourdement sanctionnée au plan civil.

¹⁵ Voir Cour d'État du Niger, Chambre judiciaire, *Adamou Idrissa c. Mahaman Mindaou*, Arrêt n° 13 – 086/c du 4 avril 2013 (obs. JIOGUE (G.)), ce recueil, chapitre 7, section A).

Tribunal de commerce d'Abidjan, jugement du
28 décembre 2017, KIPRE BROYO CARLO c. LA
NOUVELLE PARFUMERIE GANDOUR

Observations :

Le fragment d'une œuvre littéraire peut-il donner lieu à la protection par le droit d'auteur? Voilà posée, en termes interrogatifs, la question centrale qui résume la toile de fond de la protection en droit d'auteur contemporain, face aux hésitations des politiques législatives à se saisir de la menace que représente le plagiat d'œuvres de l'esprit. Sans discriminer entre les catégories d'art, le droit d'auteur protège tous les aspects de la créativité, à partir du moment où la création, idée factuelle à l'origine, entre dans le giron des idées concrétisées ou, mieux, "des créations extériorisées par des formes et/ou des couleurs"¹⁶. Ignoré du droit, le concept de plagiat revêt une connotation purement morale. La contrefaçon est son appellation juridique¹⁷. Vu sous cet angle, c'est donc la reproduction illicite, représentation ou diffusion, par quelque moyen que ce soit, des éléments d'expression originaux d'une œuvre de l'esprit. Pour engager la responsabilité civile du plagiaire, la jurisprudence exige une ressemblance des éléments de reprise de l'œuvre première, indépendamment de l'importance quantitative de ces éléments. Tel est en toile de fond le problème posé par le jugement rendu par le tribunal de commerce d'Abidjan.

Faits : Sieur KIPRE BROYO avait, courant 2010, conçu et réalisé le premier tome du guide dénommé "Technique pour devenir un professionnel de la haute coiffure", puis en janvier 2015, le tome 2 dudit ouvrage, lequel avait été doublement enregistré au Bureau ivoirien du droit d'auteur (BURIDA) en dates des 17 juin 2016 et 16 juin 2017. Ayant signé, courant mars 2015, un contrat de prestation en vue de la formation des élèves coiffeurs de la NOUVELLE PARFUMERIE GANDOUR, le sieur KIPRE BROYO va se servir de son guide comme manuel de formation de ses apprenants, jusqu'à la résiliation du lien contractuel. Après la rupture des liens contractuels entre eux, sieur KIPRE BROYO Carlos sera surpris de constater, courant janvier 2017, que la parfumerie GANDOUR avait édité son propre manuel de coiffure qui plagiait plusieurs pages du tome 2 de son guide de coiffure. Estimant que cette reproduction, en l'absence de son autorisation préalable, était constitutive de contrefaçon de son droit de reproduction, KIPRE BROYO Carlos va introduire, devant le tribunal de commerce d'Abidjan, une action en responsabilité civile fondée sur l'article 1382 du Code civil. Au juge d'instance appelé à la cause revenait d'identifier, peu ou prou, les éléments qui, dans une œuvre littéraire, entrent dans le champ de protection du droit d'auteur.

Raisonnement : C'est un truisme que de rappeler que le droit d'auteur ne protège généralement pas les idées, qui sont de libre parcours, mais plutôt leur expression. Ce principe sacramentel du droit d'auteur vise à assurer la liberté d'expression et de création. En effet, le principe postule que les idées ne sont guère appropriables, tant qu'elles n'ont pas été exprimées dans une forme claire. Trompeuse dans sa simplicité, l'application casuelle du principe ne se fait pas sans heurt par les juges, auxquels il incombe de déterminer dans le champ de la créativité les œuvres ou, du moins, les éléments de la création, éligibles à la protection. À ce stade, l'originalité (section I) est sans aucun doute le critère essentiel de la discrimination. Poussant son expertise, le tribunal va rechercher si les reprises critiquées sont constitutives de contrefaçon (section II).

I. L'originalité, critère essentiel de réservation de la protection des œuvres

Concept-tiroir à l'épreuve de l'évolution du temps et des réformes législatives sur le droit d'auteur, l'originalité se définit sous plusieurs facettes, selon la chapelle théorique à laquelle on adhère. Tout en définissant le concept d'originalité aux moyens d'éléments subjectifs, les tribunaux affichent une grande résistance à rompre avec la thèse objective consacrée dans de nombreux cas. C'est à la croisée de ces différents courants théoriques, subjectif et objectif, que le juge de la cause s'est permis des libertés, en retenant une approche mixte du concept d'originalité.

A. Les critères alternatifs de définition de l'œuvre originale

De manière holistique, le concept d'œuvre originale est polysémique en droit d'auteur, son sens évoluant au gré de la chapelle doctrinale dans laquelle on se trouve. En dépit de la floraison des critères de définition, deux grandes tendances se dégagent, l'une subjective et l'autre objective¹⁸.

B. Le cumul regrettable des critères de définition par le juge

On peut regretter que le tribunal de commerce ait combiné dans cette affaire des critères à la fois subjectifs et objectifs. Désireux de cerner le concept d'œuvre originale, d'abord subjectivement, le juge de la cause énonce avec beaucoup d'emphase qu'"Il est de principe en droit de la propriété intellectuelle que l'œuvre est dite originale lorsqu'elle est nouvelle et porte l'empreinte de la personnalité de l'auteur".

Une interprétation négative de ce que serait l'originalité, posée dans les termes du juge, signifie qu'une œuvre nouvelle n'est pas originale si elle ne reflète pas l'empreinte personnelle de son auteur, et vice-versa.

Pourtant, la jurisprudence dans sa majorité déconstruit une perception aussi extensive de la notion d'originalité, en ne prenant en compte que son caractère subjectif, conformément à la thèse personnaliste que retient la

16 SIRINELLI (P), Propriété littéraire et artistique et droits voisins, Paris (Dalloz), 1992, p. 25.

17 Voir RENOARD (A.-C.), Traité des droits d'auteur, dans la littérature, les sciences et les beaux-arts, Paris (J. Renouard), Tome 2, p. 22, n° 1838-1839; Voir aussi COLOMBET (C.), Propriété littéraire et artistique et droits voisins, Paris (Dalloz), 9^e éd., 1999, n° 389; PLAISANT (R.), Le droit des auteurs et des artistes exécutants, Delmas, 1970, n° 403.

18 Voir Cour suprême de Côte d'Ivoire, Arrêt n° 598 du 8 décembre 2005, *TOURE A. c. SICOA* (obs. FADE (A.)), ce recueil, chapitre 6, section E).

doctrine dominante¹⁹. Dans une espèce jugée par la Cour suprême de Côte d'Ivoire, le juge de cassation se faisait largement l'écho de la conception subjective qui suffisait à définir le concept d'originalité²⁰. Dans la cause, le demandeur au pourvoi avait créé un personnage clownesque qui prestait dans le cadre des émissions pour enfants, sous le pseudonyme "BOUBA". Ayant agi en contrefaçon de son droit d'auteur sur le pseudonyme "BOUBA" et le personnage clownesque contre l'usage de ces deux créations par le défendeur au pourvoi, la haute juridiction ivoirienne a rejeté son pourvoi, motifs pris de ce que ces créations ne portaient pas son empreinte personnelle. À plusieurs reprises, le juge français s'est montré rebelle à toute coloration objective, en affirmant que seule l'originalité est requise, indépendamment de la notion d'antériorité inopérante dans le cadre de l'application de la propriété littéraire et artistique²¹. En somme, l'originalité se perçoit limitativement comme l'empreinte laissée par l'auteur dans sa création.

Diamétralement opposée à cette tendance, l'originalité est perçue par une frange minoritaire de la jurisprudence comme une notion exclusivement objective. Très souvent mus par un élan de pragmatisme et bien souvent conscients de l'échec de la théorie subjective devant certains domaines de la créativité à l'instar des créations telles les bases de données ou programmes d'ordinateur, les juges ont souvent eu recours, exclusivement, à des critères objectifs de la notion d'originalité, s'affranchissant ainsi du modèle dominant. Si la position jurisprudentielle des États membres de l'OAPI a manqué jusqu'ici de se montrer réceptive à une telle tendance, le juge français, par contre, a moult fois décidé que l'originalité s'oppose à la banalité²². Certains juges vont donc exclure du champ de la protection un dessin au motif qu'il constituait, purement et simplement, une composition banale et courante²³.

Dans les jugements fondés sur l'une ou l'autre approche, une frontière claire est généralement tracée pour éviter toute confusion possible entre les critères appliqués ou leur combinaison. Bien que cela n'ait peut-être pas affecté de manière significative l'orientation de la décision, il est donc regrettable que le juge dans cette affaire ait fait référence aux deux séries de critères pour définir l'originalité.

II. La délimitation des contours des reprises illicites

En réalité, le caractère original de l'œuvre première ne suffit pas à caractériser le plagiat, casuellement entendu ici comme la contrefaçon d'une œuvre première. Le juge, dans son instruction des faits

de la cause, exige que la reprise des éléments caractéristiques de la forme de l'œuvre revête un certain nombre de caractères (A), indifféremment de l'ampleur des éléments d'emprunt (B).

A. Les caractères des éléments de reprise

Pour que la reproduction illicite d'une œuvre littéraire soit blâmable, il faudrait que cette reprise soit non autorisée et porte sur des expressions originales.

En règle générale, pour reprendre les Professeurs Lucas, l'œuvre ne peut donner prise au droit d'auteur qu'à partir du moment où elle quitte le monde de la spéculation pour entrer dans le monde sensible de la forme²⁴. En d'autres termes, on dit que le droit d'auteur protège l'expression, sous réserve qu'elle soit cependant originale. C'est d'ailleurs bien consciente de cette exigence d'originalité des éléments d'expression que la défenderesse s'évertuait infructueusement à démontrer que le tome 2 du guide du coiffeur "ne présente aucune originalité". Pour illustrer, la parfumerie défenderesse estimait que les éléments dont elle s'est inspirée sont trop banals pour établir la contrefaçon, son manuel s'étant détaché de l'œuvre du demandeur à l'instance. Autrement dit, les ressemblances entre les œuvres portent sur des éléments qui ne sont pas protégeables au titre du droit d'auteur et les différences entre les œuvres en cause sont suffisantes pour écarter la contrefaçon. Pour balayer cet argumentaire d'un revers de sa toge, le juge va conclure que les pages reproduites reflétaient le choix arbitraire de l'auteur de l'œuvre tout en se distinguant du "domaine public antérieur". Les différents chapitres, titres, paragraphes et surtout les rapports de proximité à la clientèle illustrent la liberté de choix de l'auteur du tome 2 du guide du coiffeur et par ricochet, l'éloignement nécessaire entre cette œuvre et celle intitulée *AFRICAN-CARIBBEAN HAIRDRESSING SECOND EDITION*.

À partir du moment où la forme reproduite était originale, le juge a tenu à caractériser, comme pour rappeler la nécessité, l'absence de consentement préalable de l'auteur de l'œuvre contrefaite. En cela, le juge estime que "Dans la mesure où celle-ci ne rapporte pas la preuve qu'elle a obtenu l'autorisation du demandeur à cet effet, il y a lieu de dire et juger que cette reproduction est illicite, fautive, et par voie de conséquence ouvre droit à réparation en faveur du demandeur".

B. La non-pertinence de la dimension quantitative des éléments de reprise

En droit comparé, l'article L. 335-3 du Code de la propriété intellectuelle français définit la contrefaçon comme la "reproduction, représentation ou diffusion, par quelque moyen que ce soit, d'une œuvre de l'esprit en violation des droits de l'auteur". Elle est donc envisagée lorsque l'on reproduit tout ou partie d'une œuvre littéraire sans l'autorisation de son auteur.

Dans l'espèce commentée, le juge a fortement tenu à caractériser le caractère partiel des reproductions

19 LE HENAFF (C.), Les critères juridiques de l'œuvre à l'épreuve de l'art conceptuel, Master 2 recherche en propriété intellectuelle, Université de Poitiers, 2005-2006, p. 68.

20 Voir n.18 (obs. FADE (A.)), ce recueil, chapitre 6, section E).

21 Cass., 1^{re} chambre, 11 février 1997 : JCP G 1997, II, n° 22973, 1^{re} esp. (note DAVERAT (X.)); D. 1998, p. 290; 2^e esp. (note crit. GREFFE (F.)); Somm. p. 189 (obs. COLOMBET (C.)); RTD com 1999, p. 391 (obs. FRANÇON (A.)).

22 VIVANT (M.) et BRUGUIÈRE (J.-M.), Droit d'auteur, 1^{ère} éd., p. 161.

23 Cass. civ., 27 mai 1942 : S. 1942, n° 1, p. 124.

24 LUCAS (A.) & LUCAS (H.-J.), Traité de la propriété littéraire et artistique, Paris (Litec), 2^e éd., 2001, p. 33.

illicites, en appréciant dans un premier temps avec minutie les ressemblances de chapitre, rubrique, les titres et le rapport de proximité avec le client, entre le guide contrefait et le manuel contrefaisant édité par la défenderesse. De nombreux paragraphes, dans leur agencement intact dans l'œuvre du sieur KIPRE BROYO, ont été transposés *in extenso*, dans le manuel incriminé. Néanmoins, le juge ne s'arrête pas là. Il va peser les différences existantes entre les deux œuvres, en prenant soin d'ignorer toutefois les divergences présentées sur le plan sommaire des deux ouvrages ou le succès de l'enregistrement du manuel contrefaisant auprès du BURIDA. En vue de prémunir l'impunité résultant du pillage d'une œuvre en maquillant la contrefaçon par des différences non déterminantes, tenant à la transposition spatio-temporelle de l'intrigue, le juge français a retenu la contrefaçon d'une œuvre postérieure inspirée de l'œuvre première de la victime²⁵.

Au bout de la comparaison, le juge en vient à conclure que "l'œuvre de la défenderesse est une reproduction partielle de l'œuvre dénommée "Guide du coiffeur, Devenir professionnel Tome 2".

Aristide Fade

C. Droit d'auteur – Œuvre originale – Preuve de l'originalité – Nécessaire motivation des juges du fond

Les juges du fond doivent fonder leurs décisions sur des arguments de fait et de droit permettant à la juridiction de cassation d'exercer de manière aussi aisée que possible son contrôle de légalité, et ils ne sauraient donc se borner à déduire la contrefaçon de l'exploitation commerciale non autorisée d'une photographie sans en caractériser l'originalité (1^{re} esp.)

Le jugement rapporté encourt la critique en ce qu'il a admis sans motiver sa décision que le prestataire ayant conçu un site Internet peut se prévaloir du droit d'auteur sur les composantes cachées du site Internet, notamment le code source, le code objet, les algorithmes, les programmes ou autres descriptions techniques, les structures de données et le contenu de la base de données (2^e esp.).

1^{re} espèce

Cour de cassation du Niger, Arrêt du 21 avril 2005, n° 15-040/CIV, **SONITEL c. AGENCE KIBYA**

2^e espèce

Tribunal de Commerce d'Abidjan, jugement du 7 novembre 2013, n° 1561/2013, **SOCIÉTÉ DE GALVANISATION DE TÔLES EN CÔTE-D'IVOIRE SA (Tôles Ivoire) c. SOCIÉTÉ FOCUS BUILDING & CONSULTING SARL**

Observations:

L'arrêt rendu par la Cour de cassation du Niger le

21 avril 2015 ne fournit pas les éléments de fait permettant d'apprécier le bien-fondé des critiques adressées par le pourvoi et ayant motivé la censure de l'arrêt attaqué, rendu par la cour d'appel de Niamey. On comprend seulement que la Société nigérienne de télécommunication (SONITEL), opérateur national historique des télécommunications, a fait appel, probablement pour une campagne publicitaire, aux services d'une agence, l'agence Iman, et que cette dernière a utilisé une photographie dont les droits appartiennent à une autre agence, l'agence Kybia. La cour d'appel de Niamey a jugé qu'il s'agissait d'une contrefaçon et a condamné la SONITEL à payer à l'agence Kybia la somme de FCFA 5 000 000 à titre de dommages et intérêts. L'arrêt est cassé pour insuffisance de motifs.

On ne s'attardera pas sur le deuxième moyen par lequel la société défenderesse faisait valoir qu'elle était fondée à prendre l'initiative d'une telle exploitation dès lors qu'elle avait régulièrement acquis les droits, sauf pour relever qu'il est écarté au motif qu'une telle cession ne dispensait pas le cessionnaire de respecter le droit à la paternité de l'auteur (*v. sur ce point le second commentaire de la décision, infra*).

Pour justifier la condamnation, l'arrêt attaqué avait énoncé "qu'il est établi et non contesté que SONITEL et l'Agence Iman ont procédé à une exploitation commerciale de la photographie litigieuse sans l'accord préalable de l'Agence Kibya et en ont de ce fait tiré profit pécuniaire et le tout en violation de l'article 28 de l'Ordonnance n° 93-27 du 30 mars 1993, portant sur les droits d'auteur au Niger et de l'annexe VII de l'Accord de Bangui révisé, instituant l'OAPI". Le pourvoi lui reprochait cette motivation sommaire que la société défenderesse tentait de sauver en précisant que la solution prenait appui sur une "analyse attentive des différents moyens invoqués par les parties au fond, dont notamment des sommations et des procès-verbaux de constats dressés par un huissier qui font foi jusqu'à inscription de faux". Peine perdue : la Cour de cassation, au visa de l'article 2, alinéa 2, de la loi n° 2004-50 du 22 juillet 2004, portant organisation judiciaire en République du Niger, rappelle que "l'obligation de motivation des arrêts et jugements suppose que le juge ait fondé sa décision sur des arguments de fait et de droit vérifiables à première lecture pour permettre à la juridiction de cassation d'exercer de manière aussi aisée que possible son contrôle de légalité", condition qui, selon elle, n'est pas remplie en l'espèce.

La mise au point est bienvenue. L'obligation de motivation des jugements et arrêts répond effectivement, comme le relève l'arrêt commenté, à la nécessité de permettre à celle-ci d'exercer son contrôle. Mais ce n'est pas sa seule finalité en matière civile. Ainsi que l'a relevé la Cour de cassation française, elle "oblige le juge au raisonnement juridique, c'est-à-dire à la confrontation du droit et des faits" et "constitue ensuite pour le justiciable la garantie que ses prétentions et ses moyens ont été sérieusement et équitablement examinés", en quoi "elle est aussi un rempart contre

l'arbitraire du juge ou sa partialité²⁶. Il s'agit donc bien "d'une règle essentielle qui permet de vérifier que le juge a fait une correcte application de la loi dans le respect des principes directeurs du procès" (*Ibid.*). La jurisprudence en tire, par exemple, la conséquence que la reconnaissance d'une décision étrangère non motivée est contraire à la conception française de l'ordre public international de procédure, lorsque ne sont pas produits des documents de nature à servir d'équivalent à la motivation défaillante²⁷. En l'espèce, si la motivation se bornait réellement à l'attendu rappelé ci-dessus, elle était évidemment insuffisante au triple point de vue qui vient d'être évoqué, et la censure est donc justifiée. Il appartenait aux juges du fond, non seulement de caractériser l'originalité de la photographie en cause, mais aussi de vérifier la titularité revendiquée et d'indiquer en quoi consistait précisément la violation alléguée.

Reste que la mise au point est d'ordre très général, en sorte que le commentateur n'est pas à même de savoir sur quel point exactement la motivation était défaillante. Mais il y a tout lieu de penser que c'était l'existence même d'une protection par le droit d'auteur (et non le fait de l'exploitation critiquée) qui était assénée plutôt que démontrée. Dans cette lecture, la cassation devrait s'entendre comme obligeant le juge du fond à s'expliquer concrètement sur l'originalité de l'œuvre arguée de contrefaçon. Le rappel à l'ordre est opportun car il est fréquent que les tribunaux tiennent pour acquise l'originalité de l'œuvre en cause alors que, par application de l'adage *actor in comit probatio*, c'est au demandeur en contrefaçon d'établir qu'il remplit les conditions pour être investi du droit d'auteur. Or l'originalité des photographies prête souvent à discussion et il n'est pas rare qu'elle soit déniée en jurisprudence, comme on le vérifie en France, où il est jugé que la photographie n'est pas protégeable si elle se borne à reproduire fidèlement un objet²⁸, un site²⁹, un animal³⁰, un modèle³¹ ou un événement³², et où la Cour de cassation se montre particulièrement exigeante, pour ce type d'œuvres, quant à la nécessaire motivation des juges du fond sur l'originalité³³.

Le constat, à vrai dire, n'est pas propre aux photographies, comme le montre, dans la seconde

26 Cour cass., Rapport 2010 de la Cour de cassation, Paris (La documentation française), par. 1.2.2.1.1.

27 Cass. 1^{re} civ., 28 novembre 2006, n° 4-19.031.

28 CA Aix, 2^e chambre, 20 janvier 2004 : *Comm. com. électr.* 2004, comm. 37, 1^{re} esp. (note CARON (C.)).

29 TGI Nanterre, 1^{re} chambre, 18 mai 1994 : *Gaz. Pal.* 1997, II, résumé 506, 1^{re} esp.

30 CA Paris, 25^e chambre A, 5 novembre 1991 : *JurisData* n° 1991-024063; Cass. 1^{re} civ., 22 octobre 2011, No. 10-21.251

31 CA Paris, 4^e chambre, 15 octobre 2004 : *JurisData*, n° 2004-251871

32 Cass. 1^{re} civ., 3 février 2004, n° 2-11.400 : *Prop. intell.* 2004, p. 630, 2^e esp. (obs. LUCAS (A.)), et p. 633, 1^{re} esp. (obs. SIRINELLI (P.)).

33 Cass. 1^{re} civ., 10 décembre 2014, n° 10-10.923 : RIDA 2015, II, p. 367 : "Attendu que pour déclarer la société Jeca responsable de contrefaçon artistique et lui faire interdiction d'utiliser la photographie litigieuse, l'arrêt retient que cette photographie, qui représente un pâté rond et un pâté en forme de trapèze avec la mention "mousserelle" écrite dans un cartouche sur le dessus, dans le cadre d'une composition élaborée, les produits présentés étant disposés dans un décor soigné, a manifestement une originalité; Qu'en se déterminant ainsi, par des motifs impropres à caractériser en quoi la photographie portait l'empreinte de la personnalité de son auteur, la Cour d'appel n'a pas donné de base légale à sa décision."

espèce, le jugement rapporté du tribunal de commerce d'Abidjan, qui concerne un site Internet. Les faits de l'espèce sont classiques. Une société a confié à un cabinet de conseil une mission portant sur un "programme stratégique" incluant notamment la réalisation d'un site Internet. Considérant que le budget validé pour l'année avait été "entièrement consommé" par la société prestataire, elle a mis fin aux relations contractuelles en sollicitant une rencontre afin de régler les aspects pratiques de cette rupture, en particulier la restitution du code d'accès au site. Elle a essuyé un refus de la part de son partenaire, et a refusé, dès lors, de régler le montant de la facture finale, ce qui aboutit à une situation de blocage. Elle estime que le refus n'est pas fondé, affirmant qu'elle est devenue "propriétaire" du site pour l'avoir financé.

Au contraire, l'agence soutient qu'elle "est, en sa qualité d'auteur dudit site, le seul propriétaire du droit d'auteur y afférent, ce qui l'autorise à déterminer souverainement les conditions de sa divulgation et, notamment, de la communication ou non de ses codes d'accès", la société cliente étant seulement titulaire d'un "droit d'utilisation du site, en l'absence d'une clause de cession des droits de propriété intellectuelle" qui n'a pas été stipulée en l'espèce.

Le tribunal va donner raison à l'agence à partir d'un raisonnement bien mené, mais qui fait complètement l'impasse sur la condition d'originalité, ce sur quoi nous entendons focaliser l'attention. Il commence par rappeler le principe que "lorsqu'une société confie à un prestataire extérieur la conception de son site Internet ou la création de son contenu, ce prestataire est titulaire des droits de propriété intellectuelle attachée à l'œuvre à moins qu'il en soit convenu autrement dans un contrat écrit". Mais, poursuit-il, le code d'accès au site, qui n'est en définitive qu'un "mot de passe", n'est pas inclus dans l'orbite de la protection conférée, en sorte qu'il appartient normalement au prestataire de service de le communiquer à son client à l'issue de sa mission. Encore faut-il, cependant, que la société commanditaire ait elle-même, de son côté, honoré ses engagements. Or tel n'est pas le cas puisqu'elle n'a pas payé tout ce qu'elle devait. L'agence est donc fondée à opposer son droit de rétention sur les "biens mobiliers de sa débitrice", y compris le "code d'accès au site internet, bien mobilier incorporel".

On ne s'attardera pas ici sur la question, pourtant fort intéressante, de pur droit civil, consistant à savoir si le droit de rétention prévu par l'article 67 de l'Acte uniforme OHADA portant organisation des sûretés peut être exercé sur un meuble incorporel à quoi un code d'accès peut être ramené, pour cantonner l'analyse aux seuls aspects de droit d'auteur.

On ne peut évidemment que souscrire au postulat que le contrat de commande ne transfère pas automatiquement les droits d'auteur au commanditaire. De ce point de vue, la demanderesse était dans l'erreur en prétendant que la question se rapportait "à une prestation de service et non à une œuvre de l'esprit",

ce qui mettait le droit d'auteur hors du jeu. Échappe pareillement à la discussion l'affirmation selon laquelle un code d'accès, qui n'est pas une création intellectuelle, ne peut donner prise au droit d'auteur. En revanche, il est surprenant que le tribunal ait raisonné comme s'il allait de soi qu'un site Internet constituait en lui-même une œuvre protégeable. La proposition n'est fondée que si le site répond à l'exigence d'originalité, ce qui ne va pas de soi, et que les juges du fond auraient dû vérifier.

Ce raccourci est d'autant plus critiquable que le jugement rapporté assigne ici à la protection un périmètre très large puisqu'il ne craint pas d'énoncer que le prestataire "détient des droits d'auteur sur les composantes cachées du site Internet, notamment le code source, le code objet, les algorithmes, les programmes ou autres descriptions techniques, les structures de données et le contenu de (la) base de données". Cette appréciation ne résiste pas à l'examen. Il est bien acquis, en effet, que les algorithmes ne sont pas protégeables par le droit d'auteur³⁴ et que seule la structure des bases de données peut donner prise au droit d'auteur, à l'exclusion de leur "contenu"³⁵.

André Lucas

D. Droit d'auteur – Titularité des droits – Œuvres plurales – Apport formel d'un contributeur à l'élaboration de l'œuvre – Paternité exclusive

Celui qui a été chargé de la publication d'un ouvrage sur les crimes rituels ne peut prétendre tirer argument du rôle qu'il a joué dans la mise au point formelle du manuscrit pour revendiquer la paternité exclusive de l'œuvre finale.

Tribunal de première instance de Libreville, jugement du 9 mars 2011, n° 192/10-11, SIEUR EBANG ONDO ELVIS c. SIEUR MINKO MVE BERNADIN

Observations :

Le jugement rapporté du tribunal de première instance de Libreville, s'il n'est pas à l'abri de la critique, offre l'avantage de permettre de passer en revue des notions aussi essentielles que celles d'auteur, d'œuvre de collaboration, d'œuvre collective et d'œuvre dérivée.

Faits : Le demandeur, à la suite du décès de son fils, victime d'un crime rituel, a créé une association pour

sensibiliser la population gabonaise et, à travers elle, les pouvoirs publics, sur ce fléau. L'association a organisé de nombreuses conférences et tables rondes. Ont ainsi été recueillies des données qui ont permis de nourrir un "manifeste". Le défendeur a été chargé de faire éditer ce dernier et a reçu pour ce faire une somme de FCFA 800 000. Mais il a ensuite publié aux éditions L'Harmattan sous son propre nom un ouvrage intitulé *Manifeste contre les crimes rituels au Gabon*.

Assigné en contrefaçon par le créateur de l'association, il revendique la qualité d'auteur de cette œuvre en faisant valoir que son rôle a été déterminant puisqu'il a préparé le manuscrit, fait des corrections multiples, effectué des déplacements entre Libreville et Paris et en prétendant que le demandeur n'a, quant à lui, "en rien contribué à la rédaction et à l'élaboration" de l'ouvrage.

Il n'est pas suivi par le tribunal qui va entrer en condamnation en développant le raisonnement suivant.

Raisonnement : L'article 4 de l'Accord de Bangui (en réalité de l'annexe VII de l'accord) du 2 mars 1977 prévoit que la protection du droit d'auteur est acquise "dès la création de l'œuvre, même si celle-ci n'est pas fixée sur un support matériel". En l'espèce, il n'est pas contesté que "l'idée du manifeste" émane du demandeur, ni que ce dernier a communiqué au défendeur toute une documentation, constituée à la fois des interventions faites lors des nombreuses conférences et tables rondes organisées par l'association et de ses propres écrits personnels. Il en résulte "que même dans l'hypothèse d'une œuvre collective, qualification avancée par le défendeur, ce dernier ne pouvait se présenter comme l'auteur du Manifeste contre les crimes rituels au Gabon dont il n'est pas 'l'initiateur', et ce d'autant plus que s'il a apporté à l'œuvre finale 'beaucoup de son cru', dans la mesure où sur un plan de pure forme, il s'est écarté du style quelque peu naïf et mystico-religieux (du demandeur), il peut toutefois être constaté entre les écrits personnels de ce dernier et le manifeste des similitudes de fond, tant dans la démarche que dans les questions abordées".

Cette œuvre doit donc être considérée comme l'œuvre du président de l'association, lequel doit être accueilli dans ses "demandes tendant à l'arrêt de la diffusion sous sa forme actuelle et au nom (du défendeur) ainsi qu'au retrait de cet ouvrage de la vente".

Le jugement mérite assurément l'approbation en ce qu'il refuse de faire du défendeur l'auteur exclusif de l'œuvre litigieuse. Une telle revendication n'était pas raisonnable dès lors qu'il était établi que cette œuvre était issue d'une documentation fournie par le demandeur, accompagnée d'écrits personnels de ce dernier. Elle était d'ailleurs contradictoire avec la qualification d'œuvre collective soutenue en défense, puisqu'une telle qualification conduit (c'est même son intérêt principal) à attribuer la titularité initiale des droits sur l'œuvre collective prise en elle-même à la personne (physique ou morale) qui en a pris l'initiative, à l'exclusion des contributeurs.

34 Voir en ce sens Cour de justice de l'Union européenne, Arrêt du 2 mai 2012, *SAS Institute Inc. c. World Programming Ltd*, C-406/10, ECLI:EU:C:2012:259 ; RIDA 2012, III, p. 341 et p. 181 (obs. SIRINELLI (P.)); Comm. com. électr. 2012, comm. 105 (note CARON (C)); D. 2012, p. 2836 (obs. SIRINELLI (P.)); Propr. intell. 2012, p. 423 (obs. BENABOU (V.-L.)); RTD com. 2012, p. 536 (obs. POLLAUD-DULIAN (F.)), point 32 : "En accord avec le principe selon lequel seule l'expression d'un programme d'ordinateur est protégée par le droit d'auteur, les idées et les principes qui sont à la base de la logique, des algorithmes et des langages de programmation ne sont pas protégés en vertu de cette directive."

35 Voir art. 3 al. 2 de la Directive 96/9/CE du Parlement européen et du Conseil du 11 mars 1996 concernant la protection juridique des bases de données, précisant que la protection des bases par le droit d'auteur "ne couvre pas leur contenu".

En revanche, le tribunal peut difficilement être suivi sur les autres points abordés, et l'on regrette qu'il n'ait pas saisi l'occasion de délivrer un enseignement rigoureux sur la question essentielle de la titularité des droits afférents à une œuvre plurale.

C'est, en effet, d'une œuvre plurale qu'il s'agissait en l'espèce. Contrairement à ce qui est jugé, il est impossible de faire complètement l'impasse, en l'espèce, sur la contribution du défendeur à l'œuvre finale. Il y a une même contradiction manifeste à attribuer l'entière paternité au demandeur tout en concédant dans le même temps que le défendeur y a mis "beaucoup de son cru". Ce constat devait en effet conduire à écarter l'hypothèse d'une œuvre créée par un auteur unique.

Reste à savoir quel statut donner à cette œuvre plurale.

Avant de reconnaître, en définitive, la paternité exclusive du demandeur, le tribunal n'exclut pas la qualification d'œuvre collective puisqu'il prend expressément appui sur la définition de l'article 25 de l'annexe VII de l'Accord de Bangui de 1977 pour écarter la revendication de paternité du défendeur. Le texte, repris aujourd'hui dans l'article 1^{er} de l'annexe VII de l'accord, dans sa version résultant de l'Acte de Bamako du 14 décembre 2015, dispose que l'œuvre collective s'entend de

"l'œuvre créée sur l'initiative d'une personne physique ou morale qui la divulgue sous sa direction et sous son nom et dans laquelle la contribution des divers auteurs participant à son élaboration se fond dans l'ensemble en vue duquel elle est conçue, sans qu'il soit possible d'attribuer à chacun d'eux un droit distinct sur l'ensemble réalisé".

Le tribunal déduit de cette disposition "qu'une œuvre, même collective, doit être divulguée sous le nom et la direction de celui qui en a eu l'initiative", d'où il infère que le défendeur, qui ne prétend aucunement que l'idée du "manifeste" était la sienne et qui reconnaît même explicitement qu'elle émanait du demandeur, ne peut prétendre se voir reconnaître la qualité d'auteur.

Le raisonnement appelle deux observations. La première est qu'il repose sur le postulat que le promoteur de l'œuvre collective serait ici forcément le demandeur, parce qu'il en aurait eu, le premier, l'idée, alors qu'il serait parfaitement possible de soutenir que c'est l'association, dont le demandeur n'est que le représentant, qui doit être le titulaire initial des droits, ce qui ruinerait la conclusion à laquelle aboutit le jugement.

La seconde, plus importante, est que la qualification d'œuvre collective mérite d'être plus amplement débattue en l'espèce. La définition énoncée plus haut, qui est très étroitement inspirée de celle de l'article L.113-2, alinéa 3, du Code français de la propriété intellectuelle ("Est dite collective l'œuvre créée sur l'initiative d'une personne physique ou morale qui l'édite, la publie et la divulgue sous sa direction et son nom et dans laquelle la contribution personnelle des

divers auteurs participant à son élaboration se fond dans l'ensemble en vue duquel elle est conçue, sans qu'il soit possible d'attribuer à chacun d'eux un droit distinct sur l'ensemble réalisé"), suppose non seulement une pluralité de contributions, condition qui est remplie en l'espèce, mais une "direction" du promoteur dans le processus créatif. On dit souvent que l'œuvre collective implique une relation hiérarchique entre le promoteur et les contributeurs. Or il ne résulte pas des éléments de fait contenus dans le jugement rapporté que le défendeur ait reçu la moindre instruction concernant le contenu de l'œuvre.

Cette absence de relation verticale ferait plutôt songer à la qualification d'œuvre de collaboration, ce qui aurait renvoyé à une titularité indivise entre le demandeur et le défendeur. L'œuvre de collaboration est définie par l'article premier de l'annexe VII de l'Accord de Bangui révisé comme "une œuvre à la création de laquelle ont concouru plusieurs auteurs", ce qui est la reprise littérale de l'article L.113-2, alinéa 1^{er}, du Code français de la propriété intellectuelle. Si l'on se réfère à l'interprétation que donne traditionnellement la jurisprudence française de cette disposition, ce qui peut sembler logique eu égard à la filiation textuelle, on est conduit à considérer que la qualification implique une véritable coopération entre les coauteurs³⁶. Or il y a tout lieu de penser que dans la présente espèce, le deuxième coauteur ne s'était aucunement concerté avec le premier.

La situation évoque plutôt, à la réflexion, l'œuvre "composite" définie par l'article 1^{er} de l'annexe VII précitée comme "une œuvre nouvelle qui incorpore une œuvre préexistante et qui est réalisée sans la collaboration de l'auteur de cette dernière", ce qui reprend mot pour mot l'article L.113-2, alinéa 2, du Code français de la propriété intellectuelle. Il n'y a pas d'inconvénient, selon nous, à la dénommer œuvre "dérivée", terminologie dont la signification est plus facile à saisir. On dit parfois qu'elle renvoie à une pluralité successive d'auteurs³⁷, l'apport du second, lorsqu'ils sont deux, venant adapter, compléter ou corriger celui du premier. Dans le cas de l'ouvrage litigieux, le défendeur avait, outre des corrections, mis, comme il a été dit plus haut, "beaucoup de son cru", ce qui signifie qu'il avait contribué de façon significative à la mise en forme de l'œuvre finale. Il aurait donc été logique de lui reconnaître la qualité d'auteur de cette œuvre prise en tant qu'œuvre dérivée.

Pour autant, cela ne veut pas dire que la prétention du demandeur était dépourvue de fondement. En effet, les conséquences à tirer de la qualification d'œuvre composite (*ou dérivée*) sont énoncées par l'article 5 de l'annexe VII précitée qui précise que la protection de telles œuvres "est accordée sans préjudice de la protection des œuvres préexistantes utilisées pour la création de ces œuvres". Concrètement, l'auteur de

36 LUCAS (A.), LUCAS-SCHLOETTER (A.) et BERNAULT (C.), *Traité de la propriété littéraire et artistique*, 5^e éd., Paris (LexisNexis), 2017, n° 189 et les références citées.

37 *Ibid.*, n° 229.

L'œuvre seconde est investi du droit d'auteur mais il ne peut l'exploiter qu'avec l'autorisation de l'auteur de l'œuvre première. Cette autorisation, en l'espèce, aurait dû être donnée par le demandeur soit en tant qu'auteur de l'œuvre première, soit en tant que représentant de l'association titulaire des droits sur une œuvre considérée comme collective. À défaut, l'exploitation était bel et bien contrefaisante.

Le résultat, on le voit, est le même, mais le cheminement est bien différent et prend davantage en compte les catégories juridiques de la propriété littéraire et artistique.

André Lucas

E. Droit d'auteur – Protection d'un pseudonyme – Protection d'un logo - Condition de la protection : l'originalité

Pour prétendre à la protection due au titre du droit d'auteur, toute œuvre littéraire ou artistique doit préalablement être créée, et ensuite satisfaire à la condition d'originalité. Les pseudonymes et les logos n'échappent pas à cette règle. Empruntant à la conception subjective de l'originalité, le juge exige que ces créations reflètent l'empreinte de la personnalité de leur auteur.

Cour suprême de Côte d'Ivoire, Arrêt n° 598 du 8 décembre 2005, TOURE A. c. SICOA

Observations :

De manière basique, le droit d'auteur se décline en un ensemble de prérogatives subjectives dont jouissent les auteurs d'œuvres protégées, indépendamment du mode d'expression, de la valeur ou de la destination de l'expression. L'œuvre devra satisfaire au critère d'originalité, "Pierre angulaire du droit d'auteur", à défaut duquel elle est exclue du champ de la protection³⁸. Empruntant à la Cour de cassation française souvent prompte à rappeler ce principe établi³⁹, cet arrêt inédit de la Cour suprême de Côte d'Ivoire définit le cap, dans l'espèce ayant opposé le sieur TOURE A., demandeur au pourvoi, à la société SICOA.

Faits : Dans la cause, il se dégage que le sieur TOURE A. a créé un nom d'artiste dit "T.B" et un personnage clownesque à son effigie avec des attributs spécifiques dans le cadre de l'animation de ses émissions pour enfants, telles que "WOZO VACANCES" et "AHOUANÉY". Fort de ses états de services construits sur une décennie de prestations, il s'arrogeait d'ores et déjà la paternité du pseudonyme "BOUBA" et l'image clownesque, utilisés par la société SICOA, en vue de la commercialisation de ses produits, en l'occurrence des sucettes pour enfants, ceci sans requérir le consentement de l'auteur.

38 VIVANT (M.) et BRUGUIÈRE (J.-M.), n.22, p. 160.

39 Voir Cass. ass. plén. du 7 mars 1986, *Société Babolat Maillot Witt c. Pachot*, n° 83-10477; VIVANT (M.) (éd.), *Les grands arrêts de la propriété intellectuelle*, Paris (Dalloz), 2003, n° 9; Comm. Maffre- Baugé, : D. 1986, p. 405; Concl. Cabannes (note EDELMAN (B.)) : JCP E 1986, II.

Estimant subir un préjudice du fait de l'usage à des fins commerciales de ses créations, le sieur TOURE A. va introduire une action en dommages et intérêts par devant le tribunal d'Abidjan, en réparation du préjudice par lui subi du fait de la contrefaçon de ses droits d'auteurs sur le pseudonyme "BOUBA" et l'image utilisée au titre de logo. Débouté par le juge d'instance, ce dernier va sans succès renouveler ses prétentions devant la cour d'appel d'Abidjan. L'occasion fut dès lors idoine pour la cour de rappeler que l'originalité de l'œuvre est la clé de voûte de la protection par le droit d'auteur. En d'autres termes, pour la cour, la création protégée au titre du droit d'auteur est avant tout une œuvre, mais aussi et surtout une œuvre originale, c'est-à-dire celle qui, au sens de l'art. 10 de la loi ivoirienne n° 96-564 du 26 juillet 1996, permet d'individualiser son auteur.

Insatisfait par cette décision, le sieur TOURE A. va user de son ultime recours et se pourvoir en cassation.

Raisonnement : Vidant son délibéré pour sonner le glas de la discorde, la haute juridiction va intégralement s'approprier les développements des seconds juges, optant ainsi pour une approche éminemment subjective de la notion d'originalité. Avant de se prêter à une analyse de fond de cette décision inédite (section II), il paraît inévitable de sérier les contours assez flous du concept même d'originalité des œuvres (section I), point névralgique de la protection.

I. Les contours ambigus du concept d'originalité

L'originalité est le critérium fondamental qui sert d'interface entre le champ de la propriété littéraire et artistique et celui de la propriété industrielle. Faute d'être purement et simplement définie, l'originalité finit par être un concept polysémique. Loin du désir de laisser entrer le "loup dans la bergerie" du fait des interprétations diffuses du concept, le législateur ivoirien, du haut de sa chapelle personnaliste va, à l'article 10 de la loi invoquée par le demandeur au pourvoi, disposer : "L'œuvre originale s'entend d'une œuvre qui, dans ses éléments caractéristiques et dans sa forme, ou dans sa forme seulement, permet d'individualiser son auteur".

Le nœud du contentieux réside surtout dans le contenu à assigner à l'originalité, gage de la protection. Au juge de l'illustre cour revenait de faire un choix décisif, au-delà de la simple rhétorique mêlée de controverse doctrinale, entre les thèses conceptuelles qui dominent la jurisprudence contemporaine (A). Le choix du juge, empreint de subjectivité dans son annonce, finit, sans même qu'il ne s'en rende peut-être compte, par trahir un raisonnement dont les bases sont éminemment objectives (B).

A. La controverse doctrinale autour de l'originalité

Il faut souligner qu'à l'orée, les textes révolutionnaires ne parlent pas d'originalité, même pas de manière voilée⁴⁰. C'est donc à la faveur d'un construit mené discrètement

40 VIVANT (M.) et BRUGUIÈRE (J.-M.), n.22.

par les politiques jurisprudentielles que cette notion prendra corps.

Prima facie, tout au long du XIX^e et une partie du XX^e siècle, une œuvre est dite originale parce qu'elle n'est la reproduction d'aucune œuvre antérieure⁴¹. Pour P.-Y. Gautier, il est possible de "mieux cerner l'originalité par son antonyme : la banalité", concluant de ce fait qu'en pratique, les deux notions (d'originalité et de nouveauté) se confondaient⁴². Sur cette base, le droit d'auteur est rapidement refusé à un dessin au motif que sa composition est banale et courante⁴³. C'est pourtant ignorer les théories plus subjectives de ceux qui suivent Desbois, qui propose un exemple : deux peintres représentent sur leurs toiles, l'un après l'autre, le même lieu, selon la même perspective et dans les mêmes conditions de lumière. Tous deux, dit-il, ont créé des tableaux originaux, mais le second n'est objectivement pas nouveau si l'on imagine la création artistique, celle de n'être rien d'autre qu'une œuvre imitant la nature. Une œuvre ne serait pas et le second tableau ne serait donc pas nouveau, dans cette perspective, s'il imitait un objet déjà reproduit, comme si l'exercice ne consistait qu'à reproduire puis rien d'autre que la reproduction d'une création antérieure⁴⁴.

Pourtant, ce deuxième tableau est bien entièrement nouveau selon l'article 10 de la loi citée en l'espèce, qui aborde l'originalité d'un point de vue subjectif ou personaliste. D'une manière péremptoire, Desbois pose comme postulat l'idée qu'"il suffit, pour qu'une œuvre donne prise au droit d'auteur, qu'elle soit originale, au sens subjectif du mot : point n'est besoin qu'elle soit nouvelle, au sens objectif"⁴⁵. Pour cette chapelle à forte coloration personaliste, l'œuvre est protégée parce que l'auteur y est présent et, en ce sens, l'originalité ne peut qu'être subjective. L'œuvre est la "projection même de l'auteur", l'œuvre c'est l'auteur⁴⁶. En termes plus intellectualisés, l'originalité est couramment assimilée à l'empreinte même de la personnalité de l'auteur. Pour M. TAFFOREAU, l'originalité c'est le style personnel de l'auteur⁴⁷. Il y a donc une propriété "par indivisibilité de l'objet et du sujet".

D'application difficile en matière d'art appliqué, la formule canonique (théorie subjective) va vite céder le pas à des paradigmes nouveaux, teintés d'un pragmatisme jurisprudentiel. Il est vrai que les tribunaux se font majoritairement l'écho de la conception subjective dominante. Néanmoins, à côté de la formule canonique, on trouve aussi l'empreinte personnelle, le reflet de la personnalité ou la marque de celle-ci. Allant plus loin, certains juges vont préférer le mérite sous le

couvert de l'originalité⁴⁸. La jurisprudence a également commencé à mettre en évidence la substitution du concept plus objectif d'apport intellectuel à l'originalité, notamment dans l'encadrement de la protection des œuvres utilitaires par le droit d'auteur (carte géographique, croquis, base de données, etc.) que la doctrine personaliste, à elle seule, ne saurait expliquer l'octroi de la protection. C'est forcément au bout des positions parfois tranchées de ces écoles théoriques qu'il convient de situer la position du juge suprême ivoirien, dans son appropriation du concept d'originalité.

B. L'appropriation du concept d'originalité par le juge

Sur cette toile de fond doctrinale et jurisprudentielle, les juges du fond d'Abidjan, et plus tard celui de cassation, se sont positionnés en donnant un contenu au concept d'originalité. En fondant leurs décisions sur les articles 6.3 et 10 de la loi n° 96-564 du 25 juillet 1996 relative à la protection des œuvres de l'esprit et aux droits des auteurs, des artistes-interprètes et des producteurs de phonogrammes et vidéogrammes, les juges d'appel et de cassation se sont, même de manière sous-entendue, inclinés vers la théorie personaliste, ou du moins, ne s'en sont pas éloignés considérablement. C'est bien ce qui s'infère de la motivation de la décision rendue en cassation lorsqu'il y transparaît qu'"aucun des éléments caractéristiques de sa prétendue 'œuvre' ne permettait d'individualiser le demandeur au pourvoi". Au lieu de la formule canonique consacrée selon laquelle l'œuvre originale est celle qui porte l'empreinte de la personnalité de son auteur, la Cour suprême se contente de formules lapidaires pouvant prêter à polémique. On aurait espéré qu'elle fût plus claire dans l'élaboration de sa motivation en usant les termes consacrés, ce d'autant plus que le juge suprême déclare que "T.A ne pouvant être considéré comme (...) l'inventeur du personnage clownesque".

En tout cas, la logique personaliste du juge suprême va déteindre sur la protection du pseudonyme et du logo querellé, ce qui finit par exclure la protection recherchée par le demandeur au pourvoi.

II. L'exclusion de la protection

Ayant penché pour la thèse subjective, la Cour suprême rejette le pourvoi dirigé contre l'arrêt de la Cour d'appel d'Abidjan, refusant de ce fait toute protection aux créations revendiquées. En tout état de cause, cette décision de refus d'indemniser (A) cache mal la confusion entretenue par le juge, entre protection et titularité des droits (B).

A. Le refus d'indemnisation

Deux conditions président donc à l'octroi de la protection, à savoir qu'il faut qu'il y ait une création qualifiée d'"œuvre", et que cette œuvre soit originale.

Les créations revendiquées par T.A répondent-elles à la définition d'une œuvre de l'esprit? La question a

41 Voir Tribunal civ. de Mayenne, 31 mai 1935.

42 GAUTIER (P.-Y.), *Propriété littéraire et artistique (Droit fondamental)*, Paris (PUF), 2007, n° 35.

43 Voir Cass. Civ., 27 mai 1942 : S. 1942, I, p. 124.

44 DESBOIS (H.), *Le droit d'auteur en France*, 3^e éd., Paris (Dalloz), 1978.

45 *ibid.*

46 VIVANT (M.) et BRUGUIÈRE (J.-M.), n.22, p. 162.

47 TAFFOREAU (P.), *Le style musical dans le droit de la propriété littéraire et artistique*, in *Musique et style. Méthodes et concepts*, Université de Paris-Sorbonne/Observatoire musical français (Conférences et séminaires), n° 3, 1995, pp. 50 à 55.

48 GAUTIER (P.-Y.), n.42, n° 50 : "Sous l'originalité, le mérite".

été indirectement tranchée par le juge. En effet, en refusant la demande d'indemnisation du demandeur au pourvoi, motif pris de ce que ses créations manquaient d'originalité, la cour reconnaît implicitement la qualité d'œuvre, autant au pseudonyme qu'à l'image de clown.

Le point décisif du contentieux de la protection devait alors glisser sur l'appréciation du caractère original des créations en cause.

En admettant que les créations revendiquées par T.A correspondent à la définition d'une œuvre, le juge suprême saisi d'une demande en indemnisation devait naturellement se poser une autre question : celle de savoir si ces créations étaient originales. Comme en appel, le juge suprême a répondu à cette question de fond. À cette autre question, le juge suprême décide que les créations revendiquées manquent d'originalité, entendue au sens subjectif du terme. En d'autres termes, les éléments caractéristiques dominants des œuvres en cause n'étaient pas propres au demandeur au pourvoi.

S'il est un mérite qu'on ne saurait refuser à la décision rapportée, c'est celle d'avoir préalablement identifié les éléments caractéristiques dominants des œuvres querellées. Dans la cause, ils étaient constitués du pseudonyme et de l'image.

À l'analyse, la cour s'appuie sur l'antériorité de l'usage du diminutif "Bouba" répandu en Côte d'Ivoire, et utilisé par un personnage d'un dessin animé célèbre, ne pouvant donc plus être original. À l'évidence, cette motivation dénote simplement la grosse confusion entretenue par la cour entre œuvres "originale" et "originelle". L'œuvre originelle est l'œuvre préexistante, entendue comme celle à partir de laquelle dérive une œuvre dite œuvre dérivée. Une œuvre dérivée est protégeable tout comme l'œuvre originelle, la seule condition étant que l'apport intellectuel de l'auteur de la première soit original. Une œuvre peut, en dépit de son apparente banalité, être originale à partir du moment où elle est difficilement dissociable de son auteur, au point de se confondre à sa personnalité. Le second tableau de l'exemple pris par Desbois le montre à suffire. À ce titre, n'est-il pas vrai de constater que T.A avait apporté au personnage de "Bouba" et à l'effigie qui l'accompagne une empreinte singulière?

Enfin, c'est l'occasion de relever qu'au-delà du simple effet d'annonce, la décision de refus de la protection s'appuie plutôt sur des paradigmes objectifs. En effet, on s'est très vite rendu compte que le juge suprême définissait l'originalité sous un angle purement objectif, contrairement aux prescriptions du législateur ivoirien. Pour lui, l'œuvre qui reflète l'empreinte de la personnalité de son auteur, au sens de l'article 10 du texte visé au pourvoi, est une œuvre nouvelle, qui n'est pas banale. Cette position n'est pas conforme au choix législatif.

Il faut dire que l'amalgame qui filtre de la décision rapportée a souvent été volontairement entretenu par la doctrine. Depuis des lustres, nombreux sont les auteurs

qui assimilent la nouveauté à l'originalité. Déjà résigné à son temps, P.-Y. Gautier concluait : "Tant pis! Écrivons-le : en pratique, les deux notions (d'originalité et de nouveauté) se confondent"⁴⁹. Là où le bât blesse, c'est qu'en l'état, les juges ivoiriens ont opéré un choix de convenance. Le juge, qui n'est que la bouche morte de la loi, devait simplement appliquer le choix fait par le législateur. Le concept de "nouveauté" étant propre à l'école objective, il va sans dire que la décision rendue s'inscrit en violation de la loi ivoirienne.

B. La confusion entretenue entre protection et titularité

Sur ce point, la cour s'est visiblement fourvoyée en opposant à la demande d'indemnisation un rejet pour motifs tirés de ce que T.A n'aurait pas créé les œuvres en cause. Dans un attendu capital, la cour déclare : "Qu'il résulte de la combinaison de ces deux articles qu'en matière de propriété intellectuelle, la protection des œuvres de l'esprit ne joue que pour celles des œuvres qui sont originales; Qu'en l'espèce, T.A. n'est pas à l'origine du pseudonyme, qui ne renvoie pas systématiquement à la personne, est usuel et commun".

C'est au bout de cette justification qu'il convient de trouver les bases de la confusion qui règne dans l'esprit du juge, entre une demande de protection et une autre relative à la titularité des droits. L'occasion nous semble donc indiquée d'élaborer brièvement pour dire à partir de quand une œuvre est considérée comme créée.

Une œuvre est dite créée à partir du moment où il y a cumulativement conception suivie de la réalisation, même inachevée de sa conception par son auteur. L'article 7, alinéa 3, de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins au Cameroun dispose que : "L'œuvre est réputée créée indépendamment de toute divulgation, du seul fait de la réalisation personnelle, même inachevée, de la conception". En termes profanes, l'œuvre est créée dès l'instant où elle prend forme à travers des éléments d'expression, indifféremment du mode, de la valeur ou de la destination de l'expression. Le créateur, encore appelé auteur, est titulaire originel de droit sur l'œuvre.

Il s'évince de ces développements que l'identification du créateur du pseudonyme "Bouba" en Côte d'Ivoire est sans incidence sur la question de l'octroi de la protection. La cour a pourtant semblé l'ignorer. Tout d'abord, elle déclare que T.A ne serait pas créateur du pseudonyme. Bien pire, elle ajoute que ce dernier n'est pas l'inventeur de l'image de clown utilisée comme logo par la défenderesse au pourvoi. Cette justification du rejet de la demande en réparation formulée par T.A est assez grave de conséquence, parce que reposant sur des concepts étrangers au droit de la propriété littéraire et artistique. En effet, la notion d'inventeur est consubstantielle au droit des brevets. Il s'agit du titulaire de droit sur une invention protégée par un brevet. À titre d'équivalence en droit d'auteur, c'est l'auteur qui est titulaire de la protection.

49 *Ibid.*, n° 35.

Le moins que l'on puisse dire à cet effet, c'est que la qualité du créateur mise en relief dans la motivation de la décision n'a de pertinence que dans le cadre du contentieux de la titularité des droits, et non celui de la protection qui intéressait la cour. Pour s'en convaincre, il convient de rappeler que les œuvres querellées peuvent bien être éligibles à la protection sans pour autant qu'il ait fallu que le demandeur au pourvoi en soit le créateur. Pourtant, à la question de savoir si ces créations étaient protégeables, la cour a répondu négativement, motifs pris de ce que l'animateur T.A ne serait pas le créateur du personnage et du pseudonyme. L'addition de ces erreurs a abouti à des conséquences regrettables, le juge suprême ayant clôturé son instruction en refusant de faire droit à une demande qui, autrement examinée, pourrait tout aussi être fondée.

Aristide Fade

F. Droit d'auteur – Radiodiffusion d'un spot publicitaire incorporant une œuvre musicale – Rémunération équitable à percevoir par un organisme de gestion collective – Irrecevabilité de l'action exercée à titre individuel par l'auteur

L'auteur d'une œuvre musicale qui a été utilisée pour la réalisation d'un spot publicitaire diffusé sur des radios est irrecevable à agir contre l'annonceur, la rémunération due à raison de cette utilisation constituant la rémunération équitable prévue par l'article 68 de la loi béninoise sur le droit d'auteur, dont le recouvrement ne peut être assuré que par l'organisme de gestion collective désigné par la loi.

Tribunal de commerce de Cotonou, jugement du 3 mai 2018, n° 017/18/CJ/SII/TCC, ISAAC TOHODE c. PHIBAUT AMOUZOUN

Observations :

Le jugement commenté laisse l'arrêstiste sur sa faim. Il se borne, en effet, à se saisir d'une fin de non-recevoir pour déclarer irrecevable l'action exercée par l'auteur d'une composition musicale, ce qui le dispense d'examiner les autres questions juridiques susceptibles d'être agitées en l'espèce.

Faits : Le demandeur se présente ici comme un "artiste compositeur, chanteur et arrangeur". Une de ses œuvres, qui a été ensuite comprise dans un album de 10 titres, a été utilisée à des fins publicitaires, dans des conditions que la lecture de la décision ne permet pas d'élucider avec précision, pour la réalisation d'un "spot" que l'annonceur a fait diffuser pendant des mois sur plusieurs radios. C'est cet annonceur que l'auteur assigne pour lui réclamer 75 millions de francs CFA à titre de dommages et intérêts. L'action est déclarée irrecevable au motif que seul le Bureau béninois du droit d'auteur (BUBEDRA) avait qualité pour recouvrer la rémunération due à raison de l'utilisation du phonogramme en cause.

Raisonnement : La solution est très discutable car elle est fondée sur un texte, l'article 68 de la loi béninoise sur le droit d'auteur, qui n'était pas applicable en l'espèce. Et le parti adopté par le tribunal est regrettable car, en dehors de cette objection, qui n'était pas pertinente (section I), d'autres objections auraient mérité discussion (section II).

I. L'objection retenue, fondée sur l'article 68 de la loi sur le droit d'auteur

Le défendeur affirmait que "la somme à percevoir éventuellement par l'auteur d'une œuvre ayant servi de support de publicité à des fins commerciales est perçue auprès de la commission chargée de la gestion collective, à laquelle est versée une rémunération équitable et unique par l'utilisateur du phonogramme". Le raisonnement se référait implicitement au système de licence légale prévu par l'article 60 de l'annexe VII de l'ABR-2015 et l'article 68 de la loi n° 2005-30 du 10 avril 2006 relative à la protection du droit d'auteur et des droits voisins en République du Bénin, qui font céder le droit exclusif de l'artiste-interprète et du producteur de phonogramme en cas de radiodiffusion ou de communication au public d'un phonogramme publié à des fins de commerce et leur accordent, en contrepartie, une "rémunération équitable" perçue par un organisme de gestion collective.

Le tribunal se saisit de l'argument à partir de la seule loi béninoise. Après avoir posé le principe que "lorsqu'un phonogramme est publié à des fins de commerce, une rémunération est versée à l'établissement public chargé de la gestion collective et de la défense des droits patrimoniaux des auteurs et des titulaires des droits voisins par l'utilisateur", il en déduit qu'en l'espèce seul le BUBEDRA "a qualité pour poursuivre le recouvrement des redevances liées aux droits patrimoniaux des auteurs et titulaires des droits voisins", à l'exclusion d'un artiste musicien qui est sans droit pour "recouvrer directement une telle rémunération auprès de l'utilisateur".

La démonstration ne peut emporter la conviction. D'abord, la lecture que fait le tribunal de l'article 68 de la loi béninoise est erronée. Contrairement à ce qu'il énonce dans ses motifs (et qu'il reprend dans son dispositif), ce n'est pas la "publication" du phonogramme qui paralyse le droit exclusif de l'artiste-interprète et du producteur de phonogramme et leur ouvre droit à rémunération équitable, c'est la radiodiffusion ou la communication au public du phonogramme.

Encore faut-il que le phonogramme ait été "publié à des fins de commerce". Or, en l'espèce, la chose n'est pas aussi certaine que semble le penser le tribunal. En effet, pour autant qu'on puisse en juger à la lecture de la décision, ce qui a été diffusé sur les chaînes de radio n'est pas le phonogramme contenant l'album complet de l'artiste (qui, lui, incontestablement, est un phonogramme publié à des fins de commerce), mais seulement un des titres (intitulé "Évolution") qui, alors même qu'il n'était pas encore fixé sur ce phonogramme, avait déjà été exécuté en public lors de plusieurs

manifestations, et à partir duquel avait été réalisé le spot publicitaire diffusé. On pourrait être tenté de répondre que le spot en lui-même fixait bel et bien l'œuvre en cause. Sans doute, mais ce phonogramme n'avait pas fait l'objet d'une publication, notion qui renvoie traditionnellement à l'idée d'une fabrication en nombre d'"exemplaires"⁵⁰. Il faut bien comprendre, en effet, que la licence légale dont la rémunération équitable constitue la contrepartie n'a été prévue que pour permettre aux radiodiffuseurs d'être libérés des contraintes du droit exclusif lorsqu'ils communiquent des phonogrammes qui ont fait l'objet d'une véritable commercialisation.

Enfin et surtout, cette paralysie du droit exclusif ne vaut que pour les droits voisins dont sont titulaires les artistes-interprètes et les producteurs de phonogrammes. Or, en l'espèce, le demandeur se prévalait de sa qualité d'auteur puisqu'il faisait valoir dans ses écritures "qu'étant auteur du morceau "Évolution", il a qualité et intérêt à revendiquer en justice, la propriété attachée à son œuvre". L'article 68 de la loi béninoise ne pouvait donc lui être opposé⁵¹.

II. Les autres objections susceptibles d'être opposées

D'autres objections pouvaient être (*et, pour certaines d'entre elles, avaient été*) opposées à l'auteur demandeur.

Le défendeur indiquait qu'un autre compositeur bien connu avait participé à la création de l'œuvre et que, pour établir sa co-paternité, il avait fait opposition au dépôt fait par le demandeur au BUBEDRA, déclenchant ainsi une procédure de conciliation qui rendait le demandeur irrecevable à agir en contrefaçon tant qu'elle n'était pas parvenue à son terme. Il se référait ainsi implicitement aux articles 86 et 87 de la loi béninoise. Le premier dispose que "Toute contestation qui naît de l'exécution des contrats de reproduction, d'édition, de représentation et d'exécution en public des œuvres littéraires, artistiques et des créations protégées par les droits voisins sera soumise à l'organisme de gestion collective pour tentative de conciliation", et le second précise que c'est seulement en cas d'échec de cette conciliation que "les parties ont la faculté de saisir le tribunal compétent soit directement, soit par l'entremise de l'organisme de gestion collective". Mais le cas d'espèce ne correspondait pas du tout à l'hypothèse visée par la loi béninoise puisqu'il s'agissait d'un désaccord entre deux auteurs sur la paternité d'une œuvre déposée auprès de l'organisme de gestion collective, et non d'une contestation née de l'exécution d'un contrat d'exploitation des droits d'auteur ou des droits voisins. Le demandeur répondait donc à juste titre, pour réfuter l'objection, que "le BUBEDRA qui n'est pas une juridiction ne peut rendre aucun acte de juridiction" et que "sa saisine d'un contentieux relatif à la

paternité du morceau 'Évolution' ne constitue point une question préjudicielle".

Le défendeur plaidait également l'irrecevabilité de la demande en faisant valoir que le demandeur ne justifiait pas de "sa paternité exclusive" de la composition musicale litigieuse. L'argument sous-entend qu'un coauteur ne peut agir à titre isolé en contrefaçon de l'œuvre de collaboration. Il peut prendre appui sur l'article 33.4 de l'annexe VII de l'ABR-2015 qui pose le principe que "les coauteurs exercent leurs droits d'un commun accord". Il est vrai que cette disposition ne prend pas expressément parti sur le cas des actions en justice. En droit français, la jurisprudence avait, dans un premier temps, admis la possibilité pour le coauteur d'agir seul⁵². Mais la Cour de cassation n'a pas hésité, en 1988, à ériger en principe que "le coauteur d'une œuvre de collaboration qui prend l'initiative d'agir en justice pour la défense de ses droits patrimoniaux est tenu, à peine d'irrecevabilité de sa demande, de mettre en cause les autres auteurs de cette œuvre"⁵³. Toutefois, cette jurisprudence est critiquée en doctrine⁵⁴, car elle complique fâcheusement la mise en œuvre effective de l'action en contrefaçon, et il n'est donc pas souhaitable que l'article 33.4 de l'annexe VII soit interprété en ce sens.

Une dernière objection pouvait venir à l'esprit, tenant aux conséquences de l'adhésion de l'auteur demandeur à un organisme de gestion collective, ici le BUBEDRA. Elle serait décisive en droit français car la Cour de cassation, après avoir admis la recevabilité de l'action d'un auteur ayant apporté ses droits à une société de gestion collective⁵⁵, ce qui avait suscité le trouble, a opéré un spectaculaire revirement en décidant que l'auteur ayant adhéré à la SACEM est irrecevable à agir personnellement pour défendre les droits dont il a fait l'apport, sous la seule réserve d'une carence de la société d'auteurs dans la défense du droit⁵⁶. Une telle carence n'étant pas alléguée en l'espèce, l'action en contrefaçon exercée en l'espèce serait donc déclarée irrecevable en France, sauf à démontrer que l'utilisation publicitaire en cause n'entre pas dans le champ de la cession de droits d'auteur résultant de l'adhésion à l'organisme de gestion collective. Mais la situation est tout autre dans les États membres de l'OAPI. En effet, l'article 69 de l'annexe VII, après avoir attribué aux organismes de gestion collective la mission d'assurer "la protection, l'exploitation et la gestion des droits des auteurs d'œuvres et des titulaires de droits voisins", ajoute que ces dispositions "ne portent, en aucun cas, préjudice à la faculté appartenant

50 Voir en ce sens l'art. 3 let. d de la Convention internationale sur la protection des artistes interprètes ou exécutants, des producteurs de phonogrammes et des organismes de radiodiffusion conclue à Rome le 26 octobre 1961 et l'art. 2 let. e du Traité de l'OMPI sur les interprétations et exécutions et les phonogrammes (WPPT) (1996).

51 Voir en ce sens NGOMBE (L-Y.), *Chronique d'Afrique* : août 2016 – décembre 2018 : RIDA 2019, I, pp. 61 à 138, à la p. 107.

52 Cass. civ., 21 juillet 1908 : S. 1909, I, p. 121 (note LYON-CAEN (CH.-L.)); CA Paris, 3 novembre 1956 : Gaz. Pal. 1956, II, p. 324.

53 Cass. civ., 1^{re} chambre, 4 octobre 1988, n° 86-19.272 : RIDA 1989, III, p. 251; D. 1989, p. 482 (note GAUTIER (P.-Y.)). Voir en ce sens Cass. civ. 1^{re} chambre, 8 février 2017, n° 15-26.133.

54 LUCAS (A.), LUCAS-SCHLOETTER (A.) et BERNAULT (C.), n.36, n° 199; GAUTIER (P.-Y.), *Propriété littéraire et artistique, (Droit fondamental)*, 11^e éd., Paris (PUF), 2019, n° 703, p. 765.

55 Cass. civ., 1^{re} chambre, 24 février 1998, n° 95-22.282 : Bull. civ., I, n° 75; RIDA 1998, III, p. 213 (note KEREVER (A.)); D. 1998, p. 471 (note FRANÇON (A.)).

56 Cass. civ., 1^{re} chambre, 13 novembre 2014, n° 13-22.401 : Bull. civ., I, n° 187; Comm. com. électr. 2015, comm. 2 (note CARON (C.)); D. 2015, p. 410 (note ÉTIENNEY-DE SAINTE MARIE (A.)); Propr. intell. 2015, p. 64 (obs. BRUGIÈRE (J.-M.)); RTD com. 2015, p. 291 (obs. POLLAUD-DULIAN (F.)).

aux auteurs d'œuvres et à leurs successeurs, et aux titulaires de droits voisins, d'exercer les droits qui leur sont reconnus par la présente annexe", précision reprise dans les mêmes termes par l'article 12, alinéa 4, de la loi béninoise.

André Lucas

G. Œuvre première – Titularité des droits – Créateur de l'œuvre - Transformation de l'œuvre première – Nécessaire autorisation de l'auteur – Sanction du défaut d'autorisation

L'auteur d'une œuvre littéraire est la personne physique qui a créé l'œuvre. Par conséquent, toute exhibition publique, transformation ou adaptation de sa création doit requérir son consentement préalable donné de manière expresse et indiquant la durée, le mode et le but de l'exploitation.

Par ailleurs, ses droits moraux, aux rangs desquels les droits à la paternité et à l'intégrité sur son œuvre, sont garantis par la loi, toute contravention exposant l'auteur à des lourdes condamnations pécuniaires.

Tribunal de grande instance de Ouagadougou, jugement du 18 février 2015, RG 326 du 10 avril 2014, K. L. I. c. S. J. S. L.

Observations :

La titularité des droits d'auteur sur les œuvres de l'esprit peut dans certains cas s'avérer être une véritable nébuleuse, notamment dans les cas de créations plurales. La venue des retombées financières, souvent inattendues au moment de la création, sonnent le glas de l'harmonie superficielle entre participants, pour marquer le début des joutes judiciaires. Chaque protagoniste, enclin à banaliser le génie créateur de l'autre et s'arroger à lui tout seul la qualité d'auteur, souhaite demeurer l'unique attributaire des droits d'exploitation. La raison, à la fois morale et financière, en est simple : on partage plus aisément l'argent et le succès lorsqu'on est peu nombreux⁵⁷. C'est ce qui filtre du jugement rendu le 18 février 2015 par le tribunal de grande instance de Ouagadougou.

Faits : Sur interpellation du sieur S.J.S.L., metteur en scène à la notoriété établie, le sieur K.L.I. avait créé une œuvre dramatique, intitulée "Salomon le sage", destinée à être mise en scène et représentée durant les festivités de la rentrée télévisuelle 2011-2012. Suite au succès fulgurant de cette création circonstanciée, S.J.S.L. va se permettre le luxe, sans requérir l'assentiment de K.L.I., titulaire originel des droits d'exploitation, d'apporter des modifications à la version originale de l'œuvre afin d'étendre sa durée au-delà de la période déterminée dans la convention de représentation signée

le 6 novembre 2011. Surpris du dépôt ultérieur, auprès du bureau burkinabé du droit d'auteur (BBDA), de la version modifiée de son œuvre, d'une part, et de la représentation prolongée de ladite création querellée, d'autre part, sieur K.L.I. va ester en justice, afin de voir sanctionner l'exploitation illicite de son œuvre.

L'issue du combat judiciaire était tributaire de la question de savoir qui pouvait véritablement se prévaloir d'être titulaire des droits sur la pièce de théâtre à succès.

Raisonnement : Au bout du rappel des principes fondamentaux, le juge a répondu à la question en faisant référence au législateur communautaire, beaucoup plus fin dans sa plume que son homologue burkinabé⁵⁸, qui dispose que : "l'auteur est la personne physique qui a créé l'œuvre"⁵⁹. Cette règle s'applique toujours dans le cas de l'œuvre individuelle, créée par une seule personne.

C'est donc en conséquence de cause qu'en l'absence de preuve d'une collaboration des litigants dans la création de l'œuvre intitulée "Salomon le sage", le juge appliquera les principes établis, pour :

- I. déterminer l'auteur unique de l'œuvre; et
- II. sanctionner toute atteinte aux droits attachés à cette création.

I. La détermination de l'auteur de l'œuvre

À l'examen des faits de la cause, deux créations, toutes deux intitulées "Salomon le sage", alimentaient bel et bien la discorde devant le prétoire burkinabé. Il fut question d'une œuvre originale et d'une autre, modifiée. Pour chacune d'elles, le juge était appelé à déterminer l'auteur. Pour y parvenir, le juge d'instance va, tout d'abord, déterminer l'auteur de l'œuvre originale (A), et ensuite, délimiter les contours de l'exploitation de l'œuvre modifiée (B).

A. La détermination de l'auteur de l'œuvre originale

La question centrale du contentieux né de l'exploitation de l'œuvre dénommée "Salomon le sage" était de déterminer qui était le titulaire des droits sur la version originale. Pour cela, le juge devait questionner le contexte légal régentant le droit d'auteur au Burkina. Les dispositions de l'art. 2.viii) de l'AB du 24 février 1999, invoquées par le demandeur, ont permis de répondre à cette préoccupation. En règle générale et comme nous l'avons relevé plus haut, l'auteur est la personne physique qui crée l'œuvre et décide librement de son utilisation⁶⁰.

Surgit alors une autre interrogation, celle de savoir à partir de quand une œuvre peut être considérée comme créée. Là non plus, la loi burkinabé n'est pas d'une

58 Voir art. 26 al. 2 de la loi n° 032-99/AN portant protection de la propriété littéraire et artistique (Burkina Faso).

59 Voir art. 1.viii) de l'annexe VII de l'ABR 1999.

60 EDOU EDOU (P.), Le contentieux de la propriété intellectuelle dans les États membres de l'OAPI : Guide du magistrat et des auxiliaires, Genève (OMPI), p. 23.

57 FOMETEU (J.), Le contentieux du droit d'auteur et des droits voisins dans la zone OAPI, Mélanges en hommage au Doyen Stanislas Meloné, Presses Universitaires du Cameroun, 2018, p. 631.

grande utilité. Aussi, de la lecture de l'art. 4, par. 3, de la loi burkinabé n° 032-99/AN portant protection de la propriété littéraire et artistique, il résulte que l'œuvre est créée lorsqu'il y a eu conception, suivie de la réalisation, même inachevée, de cette conception⁶¹. En des termes plus simples, il y a conception à partir de l'instant où l'œuvre aura reçu une consécration formelle, saisissable par le droit, par opposition aux idées et concepts non matérialisés qui sont susceptibles d'être appropriés juridiquement. Il importe peu que cette expression d'idées soit inachevée.

Dans l'affaire rapportée, K.L.I. revendiquait la conception intégrale de l'œuvre querellée. D'ailleurs, le défendeur n'a pas pu prouver qu'il a participé activement à la conception du plan général de la pièce de théâtre, à ses différentes parties et à l'agencement de celles-ci. De la même façon, K.L.I. a pu convaincre le juge que lui seul aura œuvré à la réalisation totale de l'œuvre. Dans l'espèce *Maedza c. Mogotsi*, la demanderesse, qui était une élève du défendeur, avait rédigé à la demande du second un poème qui fut catalogué dans un recueil intitulé *Mmopa Khukhu*, puis présenté comme étant l'œuvre de son enseignant⁶². Saisi au fond sur la détermination de la qualité d'auteur, le juge décidait, aux termes de l'instruction de l'affaire, que la demanderesse était bel et bien l'auteur du poème, pour l'avoir dûment créé⁶³.

Pourtant, dans son exposé, le sieur S.J.S.L. avait vainement tenté de dévoyer les faits, en alléguant avoir apporté une contribution significative à l'œuvre originale. Ceci n'a pas prospéré, le juge ayant déduit des circonstances de la cause, et notamment du procès-verbal de conciliation du 16 octobre 2012 établi par le BBDA, que les apports revendiqués sont postérieurs à l'enregistrement de l'œuvre originale, et ne sauraient déterminer l'attribution de la qualité d'auteur sur celle-ci.

Il ne restait plus pour le juge qu'à fixer les contours de l'exploitation de l'œuvre dérivée.

B. La détermination de l'auteur de l'œuvre dérivée

Les conclusions développées par le S.J.S.L., défendeur à l'instance, étaient destinées à faire asseoir la conviction du juge sur l'idée d'une cotitularité des droits qu'il partagerait avec son contradicteur, sur l'œuvre dramatique intitulée "Salomon le Sage", tout au moins, dans sa version révisée (dérivée). Pour atteindre l'effet escompté par la défense, le juge devait préalablement classer dans une catégorie juridique existante l'œuvre modifiée avant de statuer sur la titularité des droits.

Tout d'abord, l'œuvre transformée satisfaisait-elle aux exigences d'une œuvre composite ou dérivée? Du simple fait qu'elle soit née d'une œuvre préexistante, on serait de prime abord tenté de conclure très vite

par l'affirmative. L'œuvre composite ou dérivée est celle à laquelle est incorporée une œuvre préexistante sans la collaboration de l'auteur de cette dernière, "mais avec l'accord de l'auteur original"⁶⁴. Le texte précise que c'est la collaboration de l'auteur de l'œuvre première qui n'est pas requise, pas son consentement qui, lui, est requis. Cette précision tranche clairement la question ci-dessus posée, en y répondant par la négative.

Quid de l'œuvre de collaboration? Cette question a justement occupé une place de choix durant l'instruction de l'affaire. On ne saurait laisser passer inaperçue la méprise qu'ont les justiciables ordinaires dans leur perception défectueuse des vocables du droit référentiel français. Dans sa réplique à son adversaire, sieur S.J.S.L. s'ingéniait à faire entendre au juge que l'œuvre modifiée qu'il avait à son tour déposée auprès du BBDA était une œuvre de collaboration. La définition de l'œuvre de collaboration n'est pas clairement élaborée dans la loi burkinabé sur le droit d'auteur. Aux termes de l'article 27 de la loi burkinabé n° 032-99/AN du 22 décembre 1999 portant protection de la propriété littéraire et artistique, "Les coauteurs d'une œuvre de collaboration sont les premiers titulaires des droits moraux et patrimoniaux sur cette œuvre. Ils exercent leurs droits d'un commun accord; en cas de litige, il appartient à la juridiction compétente saisie de statuer". Mais d'une manière triviale, il s'agit d'une œuvre à la création de laquelle ont concouru deux ou plusieurs auteurs⁶⁵.

Deux situations sont envisageables dans la création de l'œuvre de collaboration. La première consistant dans une association d'au moins deux personnes travaillant ensemble à l'élaboration de l'œuvre, sans qu'il soit aisé de dire avec précision quelle partie de l'œuvre est attribuable à telle ou telle personne. Cette hypothèse, purement théorique, est aux antipodes des faits de la cause. La seconde hypothèse se conçoit lorsque même en situation de possible individualisation des apports respectifs des auteurs, ces derniers ont agi et en se concertant pour un but commun. En se rapportant aux faits de la cause, la seconde hypothèse doit être écartée. La raison en est simple, et pourtant magistralement relayée par K.L.I. lorsqu'il faisait constater, à raison, que l'effort contributif du défendeur sur l'œuvre transformée était dépourvu d'originalité. C'est-à-dire qu'en l'absence d'un apport créatif original, il n'y a pas d'œuvre au sens des créations protégeables par le droit d'auteur.

Ne répondant donc manifestement à aucune catégorie d'œuvre plurale, l'objectif de cotitularité des droits, pourtant recherché par le défendeur, n'a pas trouvé l'onction du juge, qui a maintenu à bon droit les droits d'auteurs de K.L.I. sur l'entièreté de l'œuvre à succès querellée. C'est donc pour rester cohérent avec lui-même que le juge de la cause va sanctionner l'exploitation de l'œuvre par le défendeur, en violation des droits de K.L.I.

61 Voir art. 7 al. 3 de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins (Cameroun).

62 Haute-Cour du Botswana (Lobatse), *Maedza c. Mogotsi*, 2007 : Botswana Law Reports, I, 2006, p. 182. Disponible en ligne à l'adresse <http://www.elaws.gov.bw/displaylrpage>.

63 Voir Cour suprême de Côte d'Ivoire, *Touré Aboubacar c. Sicoa*, Arrêt n° 598 du 8 décembre 2005 (obs. FADE (A)), ce recueil, chapitre 6, section E).

64 EDOU EDOU (P.), n.60, p. 23.

65 EDOU EDOU (P.), n.60, p. 22.

II. La violation des droits attachés à l'œuvre

Comme exposé plus haut, le juge reconnaît la qualité d'auteur du demandeur initial et incrimine les actes d'exploitation de l'œuvre en cause. Aussi, pour sanctionner convenablement les atteintes incriminées par le prononcé des sanctions idoines (B), la décision commentée prend soin de délimiter minutieusement l'étendue matérielle desdites atteintes (A).

A. La délimitation matérielle des droits violés

Répondant à la demande initiale, le juge va reconstituer l'étendue des droits violés, en épousant d'une manière aussi fidèle que possible la terminologie consacrée par la législation sur le droit d'auteur. En bref, le juge déplore des atteintes redondantes aux droits patrimoniaux (1) de l'auteur, balayant curieusement d'un revers de la toge, celles d'ordre extrapatrimonial (2) pourtant portées à son attention.

1. Les atteintes aux droits patrimoniaux sur l'œuvre

En un mot, il s'agit des droits d'exploitation économique de l'œuvre, permettant à l'auteur de tirer un profit pécuniaire de la gestion de son œuvre. Autrement dit, c'est l'ensemble des prérogatives pécuniaires de l'auteur sur son œuvre⁶⁶. Au rang des droits patrimoniaux, l'art. 16 de la loi burkinabé du 22 décembre 1999 liste les droits de :

- reproduction de son œuvre, de traduction, préparation des adaptations, des arrangements ou autres transformations;
- distribution des exemplaires au public par la vente ou par tout autre transfert de propriété ou par location ou prêt public;
- représentation ou d'exécution en public; et
- importation des exemplaires, de radiodiffusion ou de communication au public, de son œuvre.

Dans le contexte plus précis de l'espèce, les droits patrimoniaux pour lesquels le défendeur était mis en cause étaient le droit de représentation et le droit de transformation de l'œuvre.

Selon P.-Y. Gautier, représenter une œuvre signifie traditionnellement l'exhibition au public d'une œuvre, ou le fait de "la porter à la connaissance du public par son exécution : jouer la pièce, la symphonie, réciter le poème"⁶⁷. La représentation ne donne prise au monopole que si elle communique l'œuvre au public⁶⁸. Avec l'essor des NTIC, la représentation va de nos jours bien au-delà de l'exhibition matérielle des œuvres pour inclure la mise à la communication au public de l'œuvre,

de sorte qu'il puisse y accéder au moment et à l'endroit qu'il choisit individuellement⁶⁹.

Dans l'espèce commentée, la violation du droit de représentation par le sieur S.J.S.L. avait consisté à poursuivre, au-delà du délai convenu, l'exhibition de l'œuvre protégée, sous la forme d'une pièce de théâtre, en l'absence du consentement de l'auteur.

Par ailleurs, on regrette que le juge de la cause ait brillé par son ignorance de la violation du droit de transformation de l'auteur sur l'œuvre "Salomon le sage". En fait, la transformation d'une œuvre s'entend par sa traduction, son adaptation, son arrangement ou toute autre modification de l'œuvre⁷⁰. L'auteur jouit par conséquent du droit d'autoriser ou d'interdire toute sorte de transformation de son œuvre.

Dans les faits, le défendeur avait transformé l'œuvre dramatique créée par son contradicteur, sans requérir son autorisation expresse, toute chose qui avait abouti au dépôt d'une version modifiée de la pièce de théâtre auprès de l'O.G.C compétente. On aurait pu s'attendre à ce que le juge sanctionne également cette atteinte.

2. L'ignorance des droits moraux par le juge

Par droits moraux, la loi désigne les droits extrapatrimoniaux faisant partie d'une catégorie plus vaste de droits dits de la personnalité⁷¹. L'art. 9 de la loi burkinabé n° 032-99/AN du 22 décembre 1999 portant protection de la propriété littéraire et artistique en distingue quatre, à savoir : le droit de divulgation, le droit à la paternité, le droit au respect (souvent dénommé droit à l'intégrité de l'œuvre dans d'autres textes régissant le droit d'auteur) et le droit de repentir et de retrait.

Dans l'espèce commentée, c'est le droit au respect qui était à l'ordre du jour des débats. Par définition, il s'agit du droit pour l'auteur d'autoriser ou d'interdire toute déformation, mutilation ou autre modification de son œuvre⁷².

Dans la cause, la violation de ce droit était au centre des débats. Le demandeur à l'instance se plaignait de ce que le sieur S.J.S.L. avait mutilé sa création, sans requérir son consentement préalable, en y ajoutant des nouveaux personnages, des personnages du genre féminin, de manière disait-il, lourdement "préjudiciables à son honneur ou sa réputation". Le juge va faire droit à sa demande en entrant en voie de condamnation contre le sieur S.J.S.L. pour violation au droit au respect de l'œuvre de K.L.I.

On peut néanmoins regretter que le juge n'ait pas relevé la violation du droit à la paternité de l'œuvre qui avait

66 Droit d'auteur et droits voisins, Guide pratique sur le droit d'auteur et les droits voisins à l'intention des magistrats et auxiliaires de justice, Organisation internationale de la francophonie, réédition novembre 2011, p. 20.

67 GAUTIER (P.-Y.), *Propriété littéraire et artistique (Droit fondamental)*, 7^e éd. refondue, Paris (PUF), 2010, p. 326.

68 VIVANT (M.) et BRUGUIÈRE (J.-M.), n.22, p. 343.

69 Voir Cour d'État du Niger, *Sonitel v. Bnda*, Arrêt n° 11-250-civ du 1^{er} décembre 2011 (obs. FADE (A.)), ce recueil, chapitre 6, section O).

70 Voir art. 18 al. 1 de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins (Cameroun).

71 N.66, p.18.

72 Voir art. 12 de la loi n° 032-99/AN du 22 décembre 1999 portant protection de la propriété littéraire et artistique (Burkina Faso); l'art. 14 al. 1-C de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins (Cameroun) parle de droit à l'intégrité de l'œuvre.

pourtant été débattue. Pourtant, dans son art. 11, la loi burkinabé du 22 décembre 1999 en vigueur au moment des faits énumère ce droit. Il s'agit du droit exclusif pour l'auteur d'exiger que son nom soit mentionné chaque fois que son œuvre est rendue accessible au public.

B. Le prononcé des sanctions idoines

Toute sanction appliquée dans des cas comme celui-ci est destinée à faire cesser les infractions commises et à réparer le préjudice causé. En l'espèce, le calcul des dommages et intérêts, la sanction principale (1) et les sanctions complémentaires (2) n'ont pas été clairement expliqués, le juge ayant décidé d'aller au-delà de la demande de sanctions calendaires.

1. Les sanctions principales prononcées contre S.J.S.L. En vue de garantir au demandeur son monopole d'exploitation, le juge sanctionne les atteintes aux droits d'auteur sur l'œuvre dramatique considérée en combinant, dans un dosage proportionné, injonction et allocation des dommages et intérêts.

C'est dans les dispositions de l'accord sur les ADPIC qu'il convient de trouver le fondement originel de ces mesures d'injonction qui, après mention expresse dans les dispositions de l'article 63, alinéa 1, de l'annexe VII de l'AB de 1977, n'ont plus été expressément mentionnées par les accords subséquents. L'article 44, alinéa 1, de l'Accord sur les ADPIC dispose que "Les autorités judiciaires seront habilitées à ordonner à une partie de cesser de porter atteinte à un droit, entre autres choses afin d'empêcher l'introduction dans les circuits commerciaux relevant de leur compétence des marchandises importées qui impliquent une atteinte au droit de propriété intellectuelle, immédiatement après le dédouanement de ces marchandises". En substance, il s'agit de mesures visant la cessation immédiate de l'atteinte aux droits violés⁷³. Une fois de plus, le juge de la cause a eu recours à cette mesure en ordonnant dans le jugement "la cessation de la violation de ses droits concernant l'œuvre en cause".

Assez souvent, l'allocation des dommages et intérêts polarise le champ des mesures de lutte, au plan civil, contre la contrefaçon des droits de propriété intellectuelle en général, et du droit d'auteur en particulier. C'est à coup sûr la principale sanction civile en matière de contrefaçon. Il s'agit du paiement d'une somme d'argent à la victime de la contrefaçon, en réparation des conséquences dommageables de l'atteinte aux droits⁷⁴.

Comme relevé par K.L.I dans ses conclusions, l'action en dommages et intérêts trouve son fondement dans les réformes communautaire⁷⁵ et nationale sur le droit d'auteur⁷⁶. Elle vise à réparer les préjudices matériel et moral causés par l'atteinte aux droits de la victime.

73 EDOU EDOU (P), n.60, p. 80.

74 *Ibid.*, p. 77.

75 Voir art. 63 de l'annexe III de l'ABR-1999; art. 76 al. 1 de l'ABR-1999.

76 Voir art. 104 de la loi n° 032-99/AN du 22 décembre 1999 portant protection de la propriété littéraire et artistique (Burkina Faso).

Dans l'espèce commentée, la condamnation de S.J.S.L. au paiement de la somme de 10 000 000 francs visait à réparer tout poste de préjudices confondus. Cependant, il aurait été plus intéressant pour le juge de ventiler le montant alloué à titre de dommages et intérêts, ce qui aurait davantage justifié le montant accordé.

2. La faiblesse des sanctions complémentaires
Le juge aurait pu faire mieux qu'ordonner l'exécution provisoire de son jugement nonobstant appel.

Un rapide détour dans les chefs de prétentions du sieur K.L.I nous indique que le juge d'instance était appelé dans l'acte de sa saisine à : "s'entendre ordonner à S.J.S.L. la cessation des violations de ses droits sous astreinte de cinq cent mille (500 000) francs par jour de retard; - s'entendre condamner S.J.S.L. à lui payer la somme de cinq cent mille (500 000) francs au titre des frais exposés non compris dans les dépens". En choisissant d'ignorer certaines demandes, d'astreinte et remboursement des frais exposés par la procédure, pourtant généreusement formulées par K.L.I., la décision du juge laisse un arrière-goût d'inachevé.

Relativement à son opportunité, la demande d'astreinte gardait tout son mérite. À ce propos, l'Accord de Bangui, dans ses dispositions applicables aux faits, prescrivait l'octroi d'une telle mesure d'exécution forcée, censée briser toute velléité future de l'auteur de l'atteinte, désireux de poursuivre son illicéité. Aux termes de l'article 63.4 de l'annexe VII de l'AB acte du 2 mars 1977 : "lorsque le danger existe, que des actes constituant une violation se poursuivent, le tribunal ordonne expressément la cessation de ces actes. Il fixe en outre un montant à verser à titre d'astreinte". Cette disposition est identique à l'article 63.4 de l'AB. du 24 février 1999. L'astreinte est, dans ce contexte, un complément nécessaire de la mesure d'injonction pourtant accordée par le juge dans le cas d'un tel risque. On peut en dire autant de la demande de remboursement des frais exposés par la procédure, dont le fondement est posé à l'alinéa 1 de l'article 63 de l'annexe VII de l'Accord de Bangui du 24 février 1999.

Le juge rate là, assurément, une occasion d'arrimer la réparation au préjudice subi par la victime.

Aristide Fade

H. Droits d'auteur – Cession des droits – Transfert des droits patrimoniaux – Inaliénabilité du droit moral – Respect par le cessionnaire

Si la cession d'une œuvre littéraire et artistique emporte transfert des droits patrimoniaux attachés à ladite œuvre au profit du cessionnaire, celui-ci est en revanche tenu de respecter le droit moral résultant de l'œuvre cédée, lequel est personnel, inaliénable, perpétuel, insaisissable, et transmissible à cause de mort aux héritiers de l'auteur.

Commet par conséquent une contrefaçon le cessionnaire qui communique l'œuvre acquise au grand public en s'abstenant de mentionner le nom de l'auteur sur tout support de communication.

Cour de cassation Niger, Arrêt n° 15-040-Civ du 21 avril 2015, SONITEL c. AGENCE KIBYA

Observations :

Devant les prétoires des États membres de l'OAPI, rarissimes sont les litiges mettant en relief les droits moraux des auteurs d'œuvres littéraires ou artistiques. En cela, le différend ci-dessus rapporté était sans doute l'occasion rêvée pour les juges de peaufiner la distinction entre les différents droits moraux conférés par le droit d'auteur. L'arrêt n° 15-040-Civ du 21 avril 2015 de la Cour de cassation du Niger est sans doute d'une importance capitale.

Faits : L'agence Kybia était titulaire de droits d'auteur sur une photographie. Moyennant un contrat de cession, elle avait transféré ses droits patrimoniaux sur cette création artistique à la SONITEL. Pour les besoins de son activité, SONITEL va commettre l'agence IMAN, qui avait reproduit l'œuvre photographique sur plusieurs supports avant de la communiquer au public, sans faire mention du nom du créateur sur les supports de communication. Estimant que bien qu'elle se soit dépouillée par cession de l'intégralité de ses droits patrimoniaux sur la photographie, cette publication de sa création sous anonymat et sans son consentement, par la SONITEL, constituait une atteinte à ses droits moraux, plus précisément à son droit à la paternité, c'est en conséquence de cause que l'agence Kybia va introduire, devant les tribunaux, une action en contrefaçon de son droit moral.

Aux termes de l'instruction de cette cause, le juge d'instance va déclarer l'action introduite irrecevable et condamner l'agence demanderesse à payer à la SONITEL la somme de FCFA 20 000 000. Insatisfaite de cette décision, l'agence Kybia va contester le jugement rendu devant la cour d'appel de Niamey, qui va procéder à un nouvel examen de l'affaire au fond, avant d'infirmer la décision du premier juge, entrant ainsi en voie de condamnation contre SONITEL. Pour parvenir à la recevabilité de l'action de l'appelant et condamner la SONITEL au paiement de la somme de FCFA 5 000 000 à titre de dommages et intérêts, la cour d'appel fait le constat lapidaire de la violation des droits d'auteur de l'appelant, sans précision, dans la motivation du juge, de la nature des droits violés.

L'auguste cour devait ainsi se prononcer sur les caractères des droits moraux, dont l'inaliénabilité subordonnait le succès de l'action en contrefaçon. La Cour suprême était ainsi appelée à répondre à la question de savoir si, en plus des attributs d'ordre patrimonial, le cessionnaire de droits sur une œuvre littéraire ou artistique recueille également les droits moraux.

Raisonnement : Exerçant un pouvoir d'évocation que les textes nigériens ne lui reconnaissent pas, la Cour

suprême casse et annule l'arrêt infirmatif attaqué, puis renvoie la cause devant ladite cour autrement composée, pour statuer de nouveau. Tel un cap, elle oriente les débats devant la nouvelle composition de la cour d'appel. À l'analyse, on se rend vite à l'évidence que deux textes, convoqués aux moyens, permettent de rehausser la qualité technique des débats. Donnant un sens aux dispositions légales, la décision de l'auguste cour appelle des observations, au moins à un double niveau de réflexion.

Au premier niveau, il convient de partir de la double identité du droit d'auteur, comprenant à la fois des droits d'ordre patrimonial et d'autres d'ordre moral. Les droits patrimoniaux sont les prérogatives qui permettent aux titulaires du droit d'auteur de percevoir une compensation financière pour l'exploitation économique de leurs œuvres par les tiers. L'art. 8 de l'ordonnance portant droit d'auteur au Niger énumérait exhaustivement six prérogatives d'ordre patrimonial, à savoir les droits de reproduction, de traduction, de transformation, d'importation, de représentation ou d'exécution et de communication. Dans la lettre des dispositions de l'art. 31 de l'Ordonnance n° 93-27 du 30 mars 1993, portant sur les droits d'auteur au Niger :

“lorsque l'œuvre est créée pour le compte d'une personne physique ou d'une personne morale, privée ou publique, dans le cadre d'un contrat de travail de l'auteur ou bien lorsque l'œuvre est commandée par une telle personne à l'auteur, le premier titulaire des droits patrimoniaux et moraux est l'auteur, mais les droits patrimoniaux sur cette œuvre sont considérés comme transférés”.

Ce texte articulé au second moyen pose en substance la règle de la transférabilité des droits patrimoniaux. Il est unanimement admis en jurisprudence que la cession du droit d'auteur entraîne transfert des droits patrimoniaux au profit du cessionnaire⁷⁷.

En cela, SONITEL, cessionnaire des droits patrimoniaux sur l'œuvre photographique en cause, disposait désormais de la faculté de reproduire, communiquer ou distribuer à titre onéreux ladite création au public, sans besoin d'autorisation préalable de l'agence Kybia. L'exploitation économique de l'œuvre par la cessionnaire, de son propre chef ou par personne interposée, en l'espèce l'agence IMAN, importe peu. En cela, la décision rendue par la cour d'appel gardait toute sa pertinence. Le seul reproche fait à la cour était celui de n'avoir pas spécifié dans la motivation du juge la nature des droits qui ont été violés, et donc susceptibles de réparation en dommages et intérêts.

Vue sous cet angle, la demande de pourvoi recérait un certain mérite, celle d'interpeler l'auguste cour, eu égard aux données factuelles du débat devant la cour d'appel qui, tout en reconnaissant sa qualité de cessionnaire

77 Tribunal de Libreville, *Madame Christine ROSS c. Société SOVING* (jugement non daté), rapporté dans EDOU EDOU (P.), n.60, n° 3, p. 373.

du droit d'auteur, entrainé tout de même en voie de condamnation contre SONITEL pour violation de ce droit d'auteur. Dans un attendu assez explicite de leur motivation, les juges d'appel déclarent "qu'il est établi et non contesté que SONITEL et l'Agence IMAN ont procédé à une exploitation commerciale de la photographie litigieuse sans l'accord préalable de l'Agence Kybia et en ont de ce fait tiré profit pécuniaire". En d'autres termes, la cour pense que la cession du droit d'auteur n'entraîne pas, sauf consentement du cédant, transfert des prérogatives exclusives permettant au bénéficiaire d'exploiter l'œuvre qui en est l'objet. Est-ce donc à croire que la cour d'appel qualifie d'exploitation non autorisée et donc illicite l'exercice des droits patrimoniaux cédés? C'est à se demander si le contrat de cession, qui n'a fait l'objet d'aucune contestation tout au long des débats, n'est pas en soi une forme d'autorisation à exploiter l'œuvre. Cette position va à l'encontre des prescriptions de l'ordonnance susvisée.

Pourtant, faut-il le relever au second niveau, la décision de la cour aurait été saine si, dans sa motivation, elle opérait le clivage nécessaire entre les différents droits d'auteurs. Plutôt que de se borner à des condamnations ambiguës, la cour d'appel aurait dû partir de l'article 8 de l'Ordonnance du 23 décembre 2010 visé au second moyen, pour rétablir la règle de l'intransférabilité des droits moraux. Comme l'a si bien souligné le juge Gabonais dans une espèce similaire⁷⁸, les prérogatives d'ordre moral du droit d'auteur restent exclusives à l'auteur, même après que ce dernier s'est dépouillé, suite à une cession, de tout ou partie de ses droits patrimoniaux. Dans cette affaire, le juge décide que "même si comme c'est le cas en l'espèce, Mme ROSS... a cédé à titre onéreux l'exploitation de son œuvre à la société JEEP..., il n'en demeure pas moins qu'elle conserve sur celle-ci un droit moral".

Les fondements de la règle de l'intransmissibilité des droits moraux ainsi déclinée sont de divers ordres. On peut relever en premier lieu la nature même des droits moraux, qui s'inscrivent dans cette catégorie plus large des droits de la personnalité. Leur principale finalité est de protéger et de préserver la relation étroite qui existe entre l'auteur et sa création, évitant ainsi que l'auteur n'aliène de façon excessive sa liberté de création pour l'avenir⁷⁹.

Dans leur diversité, la loi nigérienne applicable aux faits de l'espèce distinguait le droit de paternité ou d'attribution, le droit à l'intégrité, le droit de rester anonyme ou d'utiliser un pseudonyme. Les législations modernes sur le droit d'auteur sont beaucoup plus généreuses à accorder davantage aux créateurs d'autres types de droits moraux. À titre d'exemple, l'article 14, alinéa 1, de la loi camerounaise n° 2000/11 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins distingue les droits moraux de paternité, à l'intégrité, de divulgation et enfin le droit de repentir ou de retrait. Le droit de paternité, qui a principalement

nourri les débats au fond, s'entend comme le droit au respect du nom et de la qualité de l'auteur d'une œuvre. Ce droit signifie au moins deux choses.

- Positivement, l'auteur a la prérogative de s'assurer que l'œuvre est publiée sous son nom.
- Négativement, même si la loi nigérienne en fait une prérogative distincte, c'est aussi le droit de l'auteur de rester anonyme pour ne pas voir révéler son identité ou encore de publier sous un pseudonyme.

En général, les droits moraux sont revêtus d'un certain nombre de caractères. Conséquence de leur caractère personnel, le texte de l'article 8 de l'ordonnance susvisée dispose que les droits moraux sont perpétuels, inaliénables, imprescriptibles et insaisissables et transmissibles à cause de mort aux héritiers de l'auteur. Le caractère inaliénable ici mis en exergue sous-entend que le droit moral de l'auteur ne peut être cédé à un tiers. La jurisprudence n'a cessé de donner une onction à ce texte, en annulant systématiquement toute clause contraire mentionnée dans le contrat de cession. Dans l'affaire opposant dame Christine ROSS... à la société SOVING..., le tribunal de Libreville avait condamné la seconde pour violation au droit à la paternité de l'œuvre qui ne saurait être transféré au moyen d'un contrat de cession du droit d'auteur.

L'espèce rapportée était l'occasion d'un rappel. Dans les termes de l'homme de l'art, la Haute Cour rappelle que la cession du droit d'auteur emporte uniquement cession des droits patrimoniaux, le cédant restant toujours titulaire exclusif des droits moraux.

Aristide Fade

I. Œuvre littéraire et artistique – Reproduction non autorisée de l'œuvre – Exploitation à des fins commerciales – Exception de copie privée – Contrefaçon

La reproduction massive d'une œuvre littéraire et artistique, en l'occurrence une œuvre de peinture sous forme de cartes de vœux sans autorisation de l'auteur et sa distribution corrélative aux personnes en relation avec le copiste, va bien au-delà de la copie privée et constitue une atteinte au droit de l'auteur en application de l'article 27 de la loi n° 96-564 du 25 juillet 1996 relative à la protection des œuvres de l'esprit.

Tribunal de commerce d'Abidjan, jugement contradictoire du 12 juin 2014, RG n° 1001/14, SENI BAMOGO c. AERIA

Observations :

S'il est des types d'activités qui s'affranchissent du monopole légal reconnu aux créateurs d'œuvre de l'esprit, la reproduction d'œuvres réservée à un usage privé est le cliché le plus illustratif. Devant la complexité des nouveaux moyens de reproduction offerts par Internet et des avantages qu'offre la technologie numérique, de nombreuses législations modernes, au

⁷⁸ *Ibid.*

⁷⁹ OMPi, Comprendre le droit d'auteur et les droits connexes, 2^e éd., Genève (OMPi), 2016, p. 9.

rang desquelles celles des pays membres de l'OAPI, vont consacrer à titre palliatif un régime de copie privée, afin d'instaurer un régime légalisant la copie d'œuvres dans un cercle privé⁸⁰. En effet, si l'état de la technique ne donne pas aux auteurs ou à leurs ayants droit les moyens d'exercer facilement le droit exclusif de reproduction, il a été estimé que pourrait être prévue une compensation en leur faveur sous forme de redevance⁸¹. Par ce régime, l'activité du copiste sort du giron de l'illicéité en s'exonérant désormais de l'autorisation préalable de l'auteur ou ses ayants droit. Cela fait de la copie privée une exception redoutable entre les mains du copiste poursuivi du chef de contrefaçon par reproduction d'une œuvre protégée. L'espèce soumise à notre analyse est une fenêtre ouverte sur cette réalité.

Faits : Le sieur SENI BAMOGO, artiste de renommée du vernissage des œuvres d'art, était auteur d'une œuvre de peinture intitulée "l'avenir d'un enfant", réalisée en 2009 au moyen de la technique dite de l'acrylique sur toile. Après exposition du tableau dans une galerie située dans le district d'Abidjan, le tableau d'art a été vendu en 2009 à la Galerie d'art Houkami Guyzgn qui l'expose par la suite dans ses locaux de vernissage. Quelques mois après cette vente, le sieur Simplicie De Messe Zinsou, président du conseil d'administration de l'aéroport international d'Abidjan (AERI), va profiter de l'exposition du tableau pour le reproduire de façon massive sur une carte de vœux avant de le communiquer aux clients dudit aéroport, ceci sans l'autorisation préalable du créateur.

Contrarié par cette reproduction suivie d'une représentation publique de son œuvre, le sieur SENI BAMOGO va saisir le tribunal de commerce d'Abidjan, pour les chefs de contrefaçon à ses droits de reproduction et de représentation sur sa création. Au cours des débats judiciaires, l'AERIA va, par voie d'exception, exciper l'usage à titre privé de la reproduction, pour soustraire sa responsabilité. La question alors adressée au juge était de savoir : l'exploitation à titre gratuit d'un tableau dans un cadre restreint à la clientèle d'un aéroport peut-elle s'assimiler à un usage privé de nature à exonérer son auteur des poursuites en contrefaçon? Ce faisant, la cour a pu définir un cadre juridique pour le traitement des œuvres copiées à titre privé à l'ère de la reproduction numérique.

Raisonnement : Le juge y a répondu par la négative, sans manquer l'occasion de rappeler au préalable les conditions d'admission de l'exception de copie privée, au rang desquelles la licéité de la source, le caractère personnel et privé de l'usage qui est fait de l'œuvre et la satisfaction des exigences du triple critère.

De manière générale, l'exception de copie privée consacre une dérogation spéciale au droit exclusif de l'auteur d'autoriser les tiers à réaliser des copies de son

œuvre. Seules les reproductions sont exonérées du monopole de l'auteur par le succès de l'exception. C'est le domaine restreint des reproductions autorisées, pour lesquelles le créateur ne peut poursuivre en contrefaçon. Dans son contenu, la reproduction d'œuvres couvre un spectre assez large d'activités, et s'entend donc d'une manière extensive. On y range les activités telles que l'enregistrement d'une œuvre musicale, l'édition d'un livre, la photographie d'une œuvre, sa copie sonore, audiovisuelle, numérique ou encore sa photocopie... Même si le juge n'a pas cru devoir le rappeler, le bénéfice de l'exception est conditionné par la licéité de la source reproduite.

Source de nombreuses controverses d'opinion en doctrine et en jurisprudence, la question de la licéité de la source domine les débats sur le conditionnement de l'exception de copie privée. La quasi-totalité des législateurs OAPI sur le droit d'auteur conditionnent le succès de l'exception à une divulgation licite de l'œuvre ultérieurement reproduite par le copiste⁸². En clair, la copie réalisée à partir d'une source illicite est ainsi elle-même illicite, par effet de "contamination" et, de ce fait, ne saurait bénéficier de l'exception de copie privée⁸³. L'article 31 de la loi ivoirienne applicable au moment des faits en est une parfaite illustration. Posée dans le texte, l'exigence de licéité de la source des copies reproduites était, au sens du législateur ivoirien, une condition déterminante du bénéfice de l'exception de copie privée. Ce texte dispose : "Lorsque l'œuvre a été rendue licitement accessible au public", l'auteur ne peut en interdire les reproductions réservées à un usage strictement personnel et privé. Cela supposait, pour pouvoir être retenue, que soit établi le caractère licite de l'exhibition dans la Galerie d'art Houkami Guyzgn, laquelle doit nécessairement être exempte de toute atteinte aux prérogatives du créateur du tableau concerné.

Les désaccords portent sur la question de savoir s'il est acceptable de faire de la licéité de la source une condition pour renoncer au monopole de l'auteur⁸⁴. Le principal avantage est celui d'épargner celui qui invoque l'exception des difficultés probatoires qu'elle soulève. En effet, la charge de la preuve d'une dérogation pèse sur la partie qui se prévaut d'une exception. Pour le copiste, cela s'avère difficile dans la mesure où seul l'auteur serait mieux placé pour indiquer si son œuvre a été divulguée licitement ou pas. Le maintien de la charge de la preuve sur le copiste qui aura toujours intérêt à invoquer

80 ROMPRE (S.), Le régime de la copie privée face à Internet : Lex Electronica, Vol. 12, n° 1, 2007, p. 2.

81 OMPI, Guide de la Convention de Berne pour la protection des œuvres littéraires et artistiques, Paris (OMPI), 1971, p. 64.

82 Voir art. 10 al. 2 annexe VII de l'ABR-1999 qui dispose : "Nonobstant les dispositions de l'art. 8, et sous réserve de celles de l'alinéa 2) du présent article et de celles de l'art. 58, il est permis, sans l'autorisation de l'auteur et sans le paiement d'une rémunération, de reproduire une œuvre licitement publiée exclusivement pour l'usage privé de l'utilisateur". Voir aussi l'art. 29 al. 1 let. c de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins (Cameroun) qui dispose : "Lorsque l'œuvre a été publiée avec l'autorisation de l'auteur, ce dernier ne peut interdire."

83 SINGH (A.) et DEBIESSE (T.), Droit d'auteur, copie privée et responsabilité pénale, in : Les cahiers de la propriété intellectuelle, Vol. 19, n° 1, Paris (Éditions Yvon Blais), 2007, p. 355.

84 Voir TGI de Bayonne, cor., 15 novembre 2005, *Ministère Public et SCPP c. Monsieur D. T.* Dans sa motivation, le tribunal déclare que : "Attendu qu'en revanche, en stockant sur le disque dur de son ordinateur des morceaux de musique, ou en les gravant sur les CD ROM, le prévenu n'a fait qu'user de son droit d'établir une copie pour son usage personnel; qu'il doit donc être relaxé du surplus de la poursuite".

l'exception peut finir par neutraliser l'objectif recherché par la dérogation. Le tribunal a préféré prendre fait et cause pour cette position jurisprudentielle, au détriment de celle des législateurs nationaux.

Comme le prescrivent de nombreux textes sur le droit d'auteur, le bénéfice de l'exception de copie privée est subordonné à un usage strictement privé de la copie reproduite. L'appréciation du caractère "personnel et privé" de l'usage peut paraître simple a priori, et pourtant, dans la réalité judiciaire, elle présente une marge d'élasticité.

Dans sa perception littérale, l'usage personnel s'oppose à l'idée d'utilisation collective et suppose en amont l'absence d'un but de lucre. L'usage privé englobe les besoins personnels du copiste et ceux qu'il peut avoir dans l'exercice de son travail. C'est le cas typique de l'étudiant qui, pour mener à bien ses études ou des travaux de recherche personnelle, procède ou fait procéder à la copie d'un texte.

Dans une perception adaptée à la situation de l'entreprise, on met en relief l'idée d'un usage privé à des fins internes pour exonérer la reproduction et la mise en circulation de cette reproduction au sein d'une entreprise à des fins d'information et de documentation. L'entreprise dans ce contexte doit s'entendre dans un sens très large. Il peut s'agir d'entreprises publiques et privées, de personnes exerçant une activité lucrative indépendante, sous quelque forme juridique que ce soit (*établissement de droit public, Sarl, association ou commerçant individuel, par ex.*), ainsi que d'autres regroupements de personnes, même si ceux-ci ne sont pas organisés sous une forme juridique (*par exemple les communautés de défense d'intérêts*). La dérogation est dans ce cas restreinte aux fins d'information et de documentation interne, ce qui du moins est contraire à l'idée de reproduire pour ensuite mettre à la disposition des clients de l'entreprise.

Dans l'espèce commentée, le président de l'organe d'administration de l'AERIA avait reproduit sans autorisation du demandeur l'œuvre de peinture de ce dernier sur un support de cartes de vœux, et avait par la suite distribué, à titre gratuit, des exemplaires de ces cartes de vœux à la clientèle de l'aéroport. Pour balayer d'un revers de la main l'exception de copie privée invoquée par l'AERIA, le tribunal de commerce a fait une appréciation restrictive de l'usage "strictement privé" de l'exploitation des copies, en faisant le constat selon lequel "une telle reproduction va bien au-delà de la copie privée parce qu'il s'agit d'un usage collectif, l'œuvre étant ainsi envoyée, par le biais des cartes de vœux, à d'autres personnes que Monsieur Simplicite De Messe Zinsou".

Enfin, le succès de l'exception ne se borne pas aux seules conditions de licéité de la source ou du caractère personnel et privé de l'usage, puisqu'il faut également respecter le test en trois étapes. Même si le juge ne le dit pas expressément, les copies utilisées au sein d'une entreprise ne sont pas toujours collectives. L'usage privé doit aussi s'entendre comme tout usage qui ne saurait

porter atteinte à l'exploitation normale de l'œuvre, ni causer un préjudice injustifié aux titulaires du droit. Conformément au dispositif central d'encadrement des exceptions posé dans la Convention de Berne, les copies utilisées au sein d'une entreprise sont un usage privé à partir du moment où elles satisfont aux exigences du test en trois étapes. En vertu de l'article 9, alinéa 2, de la Convention, "Est réservée aux législations des pays de l'Union la faculté de permettre la reproduction desdites œuvres dans certains cas spéciaux, pourvu qu'une telle reproduction ne porte pas atteinte à l'exploitation normale de l'œuvre ni ne cause un préjudice injustifié aux intérêts légitimes de l'auteur".

Au premier niveau du test, l'exception doit entrer dans un cas spécial et être clairement définie. Dans l'art. 31 de la loi ivoirienne n° 96-564 du 25 juillet 1996 relative à la protection des œuvres de l'esprit et aux droits des auteurs, des artistes-interprètes et des producteurs de phonogrammes et vidéogrammes : "Lorsque l'œuvre a été rendue licitement accessible au public, l'auteur ne peut en interdire (...) les reproductions, traductions et adaptations destinées à un usage strictement personnel et privé, et non destinées à une utilisation collective, à l'exception des œuvres d'art". On voit qu'à ce premier niveau, les copies faites par l'AERIA de l'œuvre de peinture échouent à l'épreuve du test en trois étapes.

Au second niveau du test, l'activité de reproduction supposée être exonérée par le couvert de l'exception ne doit pas entraver l'exploitation normale de l'œuvre⁸⁵. Selon cet auteur, "Un conflit avec une exploitation normale se produit lorsque les auteurs sont privés d'une source majeure de revenus, actuelle ou potentielle, qui revêt une certaine importance dans l'ensemble des modes de commercialisation des œuvres de cette catégorie". Normalement, les œuvres de peinture sont exploitées par voie d'exposition et vente au public. Sous le prisme de sa compatibilité au régime général des exceptions au droit d'auteur, la reproduction numérique d'un tableau à des seules fins privées, pire encore à grande échelle, est de nature à porter atteinte aux modes d'exploitation susmentionnés. De ce fait, les copies de l'œuvre faites par l'AERIA échouent à cette exigence du test en trois étapes.

Au dernier niveau du test, l'activité de reproduction ne doit pas causer un préjudice injustifié aux titulaires du droit. Dans cette troisième étape du test, il s'agit de mesurer l'avantage proportionnel de l'autorisation de l'exception dans le contexte de la préservation des intérêts de l'auteur⁸⁶. Au final, ce n'est que si le préjudice est injustifié ou disproportionné que l'exception sera considérée comme illégitime au regard du test.

D'ailleurs consacré dans l'ABR-1999 (article 10, alinéa 2)vi), annexe VII, de l'ABR-2015), le critère du

85 SENFTLEBEN (M.), Copyright, limitations and the Three-Step Test – An Analysis of the Three Step Test in International and EC Copyright Law (Information Law Series), La Haye (Kluwer Law International), 2004, p. 43 et s.

86 DE COCK (E.), Les exceptions au droit d'auteur : Problématiques liées à l'exception de copie privée, Mémoire de Master en droit, Université Catholique de Louvain, 2015-2016, p. 33.

test en trois étapes s'impose aux juges qui, dans la pratique, sont chargés de veiller au respect. À l'aune de ce dispositif d'encadrement des dérogations au droit d'auteur, on s'aperçoit bien que le bénéfice de l'exception de copie privée invoqué par AERIA pour justifier la reproduction numérique de l'œuvre du sieur SENI BAMOGO ne pouvait prospérer. Le rejet de la dérogation au droit de reproduction par juge de la cause revêt donc tout son sens.

Aristide Fade

J. Droit d'auteur – Autorisation d'exploitation délivrée par l'organisme national de gestion collective – Exploitation en ligne d'œuvres du répertoire d'une société sœur – Action exercée à titre individuel par l'auteur – Recevabilité – Illicéité de l'exploitation (non)

L'auteur malien adhérent de la SACEM est recevable à agir contre l'exploitant autorisé par le Bureau burkinabé du droit d'auteur (BBDA) à exploiter ses œuvres en ligne mais l'exploitation qu'il critique n'est pas illicite dès lors qu'elle est couverte par ladite autorisation.

Tribunal de grande instance de Ouagadougou, jugement du 5 décembre 2012, n° 607, SALIF KEITA c. SOCIÉTÉ AIRTEL BURKINA FASO SA, BBDA ET SOCIÉTÉ MOBILE SERVICES BURKINA FASO SARL

Observations :

Le jugement commenté, soigneusement rédigé, offre l'occasion de s'interroger sur l'articulation entre gestion individuelle et gestion collective des droits d'auteur.

Faits : Le chanteur et musicien malien Salif Keita, de renommée mondiale, a appris lors de séjours au Burkina Faso que certaines de ses œuvres étaient utilisées dans ce pays par la société Airtel Burkina Faso (ci-après la société Airtel) à travers un service de téléchargement payant dénommé Mam'zik. Après avoir envisagé une négociation amiable, ladite société change de pied et s'oppose aux réclamations de l'artiste en soutenant qu'elle est fondée à exploiter ces œuvres en raison de la convention de partenariat qu'elle a conclue avec la société Mobile Services Burkina Faso (ci-après la société Mobile Services), qui elle-même tient ses droits du Bureau burkinabé du droit d'auteur (ci-après BBDA). Assignée devant le tribunal de grande instance de Ouagadougou en paiement d'une indemnité de 200 millions de francs CFA, elle assigne en intervention forcée ces deux personnes morales.

Raisonnement : Le tribunal écarte la fin de non-recevoir tirée du défaut de qualité à agir du demandeur (section I) mais déboute celui-ci sur le fond en jugeant que l'autorisation délivrée par le BBDA suffit à justifier le comportement de la société défenderesse (section II).

I. La qualité à agir du demandeur

Les défendeurs contestent la qualité à agir de Salif Keita. Le raisonnement est le suivant : l'artiste demandeur a adhéré à la SACEM, société de gestion collective française; or le BBDA a conclu en 1987 avec la SACEM (et la Société pour l'administration du droit de reproduction mécanique des auteurs, compositeurs, éditeurs, réalisateurs et doubleurs sous-titres, ou SDRM, pour le droit de reproduction mécanique) un accord de représentation réciproque qui lui confère mandat de gérer son répertoire au Burkina Faso; dès lors, seuls le BBDA, la SACEM (ou la SDRM) ont qualité pour agir au nom de l'artiste.

La présentation, à vrai dire, n'est pas dépourvue d'ambiguïté. Si le BBDA est investi d'un mandat pour gérer les droits de Salif Keita au Burkina Faso, c'est lui seul, et non la SACEM, qui devrait avoir qualité pour faire valoir ses droits en justice. Sans doute faut-il voir là l'écho de la clause du contrat de 1987, évoquée dans les écritures du BBDA rapportées dans le jugement, selon laquelle seule la SACEM "est habilitée à agir, le cas échéant en justice, dans le cadre de la protection des droits de Salif Keita".

Quoi qu'il en soit, le tribunal récuse cette argumentation. Il prend appui sur l'article 96 de la loi burkinabé n° 032-99/AN du 22 décembre 1999 portant protection de la propriété littéraire et artistique, qui précise que les dispositions confiant à un organisme professionnel la gestion collective des droits d'auteur et des droits voisins "ne portent pas préjudice à la faculté appartenant aux auteurs d'œuvres, aux titulaires des droits voisins et à leurs ayants droit, d'exercer directement les droits qui leur sont reconnus par la présente loi", d'où il tire que "l'artiste et titulaire de droit qu'est Salif Keita a, concurremment avec les organismes suscités (le BBDA, la SACEM et la SDRM) la qualité pour agir en justice pour la défense de ses intérêts".

Il n'y a rien à redire au rejet de la fin de non-recevoir, que la lettre de la loi locale sur le droit d'auteur imposait. On ajoutera que, sur ce point, l'article 69 de l'annexe VII de l'ABR-2015 milite dans le même sens puisque, après avoir attribué aux organismes de gestion collective la mission d'assurer "la protection, l'exploitation et la gestion des droits des auteurs d'œuvres et des titulaires de droits voisins", il ajoute que ces dispositions "ne portent, en aucun cas, préjudice à la faculté appartenant aux auteurs d'œuvres et à leurs successeurs, et aux titulaires de droits voisins, d'exercer les droits qui leur sont reconnus par la présente annexe".

La seule réserve, mais elle est de taille, porte sur le principe de cette concurrence organisée entre l'auteur et l'organisme de gestion collective (et même ici avec les organismes de gestion collective puisque le tribunal, sans apporter sur ce point la moindre justification, reprend à son compte l'idée que le BBDA et la SACEM sont pareillement recevables à agir), concurrence qui n'a pas de réelle portée dès lors que le comportement de l'annonceur est, en l'espèce, justifié par l'autorisation

délivrée par le seul BBDA. Sans doute serait-il judicieux d'articuler de façon plus rigoureuse gestion individuelle et gestion collective (mais c'est bien sûr au législateur de le faire). Par exemple, on pourrait décider, à l'instar de la jurisprudence française⁸⁷, que la violation des droits compris dans l'apport fait à l'organisme de gestion collective n'ouvre droit à l'action individuelle de l'auteur ou du titulaire de droit voisin qu'en cas de carence avérée de l'organisme. On pourrait aussi en donner expressément la préférence à l'organisme de gestion collective, comme le plaidait en l'espèce le BBDA, pour qui l'action individuelle n'était recevable que si elle est exercée contre "un défendeur qui exploitait les œuvres sans aucune autorisation préalable et de façon clandestine, à l'insu de l'organisme chargé de la protection de ces œuvres".

II. Effet justificatif de l'autorisation délivrée par le BBDA

Sur le fond, le tribunal fait droit aux arguments des défendeurs en considérant que Salif Keita ne peut rien reprocher à la société Airtel dès lors que celle-ci a traité avec un partenaire ayant obtenu du BBDA l'autorisation d'exploiter les œuvres en cause.

Rappelant les termes des articles 95 et 96 de la loi précitée de 1999, il en déduit "que c'est dire donc que dans le cadre des missions qui lui sont confiées, le BBDA est amené à assurer la protection des œuvres littéraires et artistiques dont les auteurs sont des nationaux ou encore des étrangers; que pour l'exploitation desdites œuvres, il lui est préalablement fait recours afin qu'elle délivre des autorisations des œuvres qu'il protège". Il s'attache alors à l'analyse des conventions conclues entre les trois défendeurs.

En premier lieu, il se réfère au "contrat général d'exploitation d'œuvres protégées" conclu entre la société Airtel et le BBDA, par lequel ce dernier donne "l'autorisation préalable prévue aux articles 95 et 96 (...) d'exécuter, de faire ou de laisser exécuter publiquement l'ensemble des œuvres protégées qui constitue son répertoire et celui des sociétés dont il est mandataire en vertu de la Convention de Berne", il précise que cette autorisation "porte sur la communication au public d'œuvres protégées, notamment par le réseau téléphonique administratif et mobile, par Internet et par les campagnes publicitaires de l'usager", et prévoit qu'en contrepartie, l'usager s'engage à payer des redevances.

La société Airtel a, par ailleurs, conclu avec la société Mobile Services une convention de partenariat par laquelle cette dernière s'engage à lui fournir des œuvres musicales et à "obtenir" les droits de propriété intellectuelle afférents à ces œuvres auprès du BBDA, la convention précisant qu'elle n'entraîne aucune "cession" de droits de propriété littéraire et artistique.

Enfin, le BBDA a lui-même conclu un "contrat général d'exploitation d'œuvres protégées" avec la société Mobile Services qui est autorisée à exploiter à la fois le répertoire de l'organisme de gestion collective et celui des sociétés dont il est mandataire "en vertu de la Convention de Berne et des conventions de représentation réciproque".

Constatant qu'il résulte du dossier que "le BBDA a versé ses droits à Salif Keita", le tribunal en conclut qu'aussi bien la société Airtel que la société Mobile Services ont été autorisées par le BBDA à exploiter les œuvres du demandeur qui se trouve donc débouté.

On passera sur le *lapsus calami* qui fait écrire au tribunal, à l'issue de son raisonnement, "qu'en tout état de cause, l'exploitation par la société Airtel des œuvres de Salif Keita ne saurait être irrégulière" (soulignement ajouté). Il aurait été plus pertinent de remplacer "en tout état de cause" par "ainsi", car c'est seulement sous le bénéfice des motifs très complets contenus dans le jugement que la demande est rejetée.

La démonstration, en revanche, emporte la conviction. Il est exact que le BBDA était habilité, en vertu de l'accord de représentation réciproque conclu avec la SACEM⁸⁸, à délivrer une autorisation d'exploitation portant notamment sur les œuvres du demandeur, dès lors que la portée de cette autorisation n'excédait pas celle qui aurait pu être donnée par la SACEM elle-même (postulat qui n'était pas ici en débat), la société française ne pouvant conférer à une société sœur plus de pouvoirs qu'elle n'en avait.

Pour combattre cette argumentation, Salif Keita faisait valoir que l'autorisation accordée à la société Airtel ne visait que l'exécution publique, mode d'exploitation distinct de la communication au public qui, selon lui, n'entrait pas "dans le champ contractuel circonscrit par l'objet du contrat". L'objection, à laquelle ne répond pas le jugement commenté, ne résistait pas à l'examen. Le concept d'exécution publique est traditionnellement utilisé pour désigner la communication au public de certaines œuvres (musicales surtout), en sorte qu'il ne faut pas y voir un mode d'exploitation distinct.

Plus gênante pouvait apparaître l'objection, à laquelle le tribunal ne prête pas davantage attention, tirée de ce que le contrat conclu entre le BBDA et la société Mobile Services prévoyait expressément que les droits conférés "sont des droits non cessibles sans accord écrit du BBDA", ce dont s'emparait le demandeur pour plaider que le bénéfice de cette autorisation n'avait pas pu être transmis à la société Airtel. Les deux sociétés défenderesses croyaient pouvoir combattre le raisonnement en rappelant que l'article 9 de leur convention de partenariat excluait toute "cession de droits de propriété intellectuelle". Mais l'argument

87 Cass. civ., 1^{re} chambre, 13 novembre 2014, n° 13-22.401 : Bull. civ., I, n° 187; Comm. com. électr. 2015, comm. 2 (note Caron (C)); D. 2015, p. 410 (note ÉTIENNEY-DE SAINTE MARIE (A.)); Propri. intell. 2015, p. 64 (obs. BRUGUIÈRE (J.-M.)); RTD com. 2015, p. 291 (obs. POLLAUD-DULIAN (F.)).

88 Et non pas "en vertu de la Convention de Berne", laquelle est muette sur le sujet de la gestion collective et dont l'incidence en la matière tient seulement à ce qu'elle oblige les États unionistes à garantir le traitement national, c'est-à-dire l'assimilation de l'étranger au national, ainsi que le prévoit son art. 5 al. 1, expressément visé ici par l'auteur malien.

ne changeait rien au fait que l'autorisation n'avait été conférée par le BBDA qu'à la société Mobile Services, qui n'avait pas le droit d'en faire bénéficier la société Airtel. Cependant, il n'en résultait pas que celle-ci s'était livrée à une exploitation illicite puisque, si l'on s'en tient aux faits rapportés par le jugement, elle avait elle-même reçu du BBDA l'autorisation de puiser dans son répertoire ainsi que dans le répertoire de ses sociétés sœurs. Ce qui, en vérité, est surprenant, est que la convention de partenariat ait cru nécessaire, dans ces conditions, de mettre à la charge de la société Mobile Services l'obligation d'obtenir du BBDA les "droits de propriété intellectuelle relatifs aux œuvres musicales qu'elle fournira à la société Airtel".

On comprend facilement le dépit d'un auteur à succès qui constate que le montant des redevances perçues au titre de la gestion collective est très inférieur à ce qu'il aurait pu obtenir à travers une négociation individuelle. Mais c'est la conséquence inévitable de l'adhésion à un organisme de gestion collective qui, par ailleurs, n'est pas sans avantage.

André Lucas

K. Reproduction par numérisation d'une œuvre littéraire et artistique – Autorisation de l'auteur – Défaut d'autorisation – Contrefaçon – Loi n° 2008-09 du 25 janvier 2008 relative au droit d'auteur et aux droits voisins

La reproduction par numérisation d'une œuvre littéraire et artistique, en l'occurrence un ouvrage, suivie de sa mise à la disposition des internautes en téléchargement libre sans autorisation de l'auteur, est constitutive de la contrefaçon conformément aux dispositions de l'article 142 de la loi n° 2008-09 du 25 janvier 2008 relative au droit d'auteur et aux droits voisins.

Tribunal régional hors classe Dakar, jugement n° 1061/2015 du 26 novembre 2015, MP et ABDOULAYE AZIZ c. MAMADOU et SERIGNE

Observations :

Le 14 août 1996, le tribunal de grande instance de Paris statuant en matière de référé a rendu une décision emblématique dans une affaire opposant les ayants droit de l'artiste Jacques Brel aux élèves d'une grande école qui avaient numérisé ses œuvres sans leur autorisation⁸⁹. Le juge de référés a en effet posé que "Toute reproduction par numérisation d'œuvres musicales protégées par le droit d'auteur susceptible d'être mise à la disposition de personnes connectées au réseau Internet doit être autorisée expressément par les titulaires ou cessionnaires de droit". L'applicabilité du droit d'auteur aux réseaux et à l'Internet est désormais hors de doute même si elle suscite quelques difficultés. Le législateur français a clairement exprimé cette règle à travers le

code de la propriété intellectuelle. Les autorités de la Communauté européenne l'ont intégrée dans la Directive n° 2001/29/CE du 22 mai 2001 relative à certains aspects du droit d'auteur dans la société de l'information, texte qui s'inscrit en droite ligne de la déclaration commune sur le Traité de l'OMPI sur le droit d'auteur adoptée par la conférence diplomatique le 20 décembre 1996. L'article 1.4 de ladite déclaration indique en effet que "Le stockage d'une œuvre protégée sous forme numérique sur un support électronique constitue une reproduction au sens de l'article 9 de la convention de Berne". La quasi-totalité des lois relatives au droit d'auteur et aux droits voisins des États signataires de l'Accord de Bangui s'appliquent à l'Internet. Il en est ainsi de l'article 33 de la loi sénégalaise n° 2008-09 du 25 janvier 2008 relative au droit d'auteur au visa duquel l'arrêt rapporté a été rendu. De fait, l'enseignement qui en résulte est que l'application des dispositions classiques du droit de la propriété littéraire et artistique reste pertinente à mesure que de nouvelles technologies de communication apparaissent, même s'il est permis d'envisager quelques adaptations somme toute nécessaires.

Faits : Il ressort des faits ayant généré l'espèce commentée qu'après publication en deux tomes de son ouvrage intitulé "Pour l'honneur de la gendarmerie sénégalaise", le colonel ABDOULAYE AZIZ NDAW a constaté que les sites internet Actunet.sn et Assirou.net offraient son œuvre en téléchargement libre aux internautes, le privant ainsi des revenus substantiels qu'il pouvait en tirer, l'éditeur n'ayant pu vendre que quelques exemplaires du fait de la fraude décriée. Cet officier supérieur de la gendarmerie sénégalaise a fait constater ces faits par huissier de justice et traduit les nommés MAMADOU MOUTH BANE et SERIGNE Fadel MBACKE respectivement administrateurs desdits sites par voie de flagrant délit devant le tribunal régional hors classe de Dakar pour y répondre des délits de voie de fait et violation du droit d'exploitation, prévus et réprimés par l'article 142 de la loi du 25 janvier 2008 précitée.

Raisonnement : La cour a jugé que la sanction infligée aux contrevenants sur le double plan civil et pénal (section I) est tributaire de l'effectivité de la violation des droits de l'auteur de l'œuvre incriminée sur la toile (section II).

I. La violation des droits de l'auteur via l'Internet

Les faits nous révèlent que les sites ayant servi de vecteurs à la diffusion de l'œuvre contrefaite sur la toile portaient l'inscription suivante : Assirou.net et Actu.net "vous offrent les deux livres du colonel NDAW, merci de le télécharger". Il convient de bien spécifier les actes incriminés en l'espèce au regard de la loi régissant le droit d'auteur au Sénégal (A) et l'intention délictueuse que l'on peut aisément déduire de l'absence d'autorisation du titulaire du droit (B).

A. Les actes incriminés

Les prévenus ont été poursuivis du chef de violation du droit d'exploitation. Aux termes de l'article 33.1) de la loi du 25 janvier 2008 régissant le droit d'auteur et les

⁸⁹ Voir TGI Paris, 14 août 1996 : JCP G 1996, II, n° 22727 (note OLIVIER (É.) et BARBRY (F)).

droits voisins au Sénégal, "l'auteur jouit du droit exclusif d'exploiter son œuvre sous quelque forme que ce soit et d'en tirer un profit pécuniaire". L'alinéa 2 du même article renchérit : "Le droit d'exploitation appartenant à l'auteur comprend le droit de communication au public, le droit de reproduction, le droit de distribution et le droit de location". Seules les trois premières composantes du droit d'exploitation seront examinées dans les développements qui suivent, le droit de location n'ayant pas été touché en l'espèce.

1. La violation du droit de reproduction

L'article 35.1) de la loi n° 2008-09 définit la reproduction comme la "fixation de l'œuvre, par un procédé quelconque, sous une forme matérielle permettant de la communiquer au public". Il va sans dire que la définition retenue par le législateur sénégalais met en avant l'approche synthétique qui est globalisante en ce qu'elle permet la prise en compte de tous les moyens et techniques de reproduction qu'offrent l'évolution de la technique y compris la numérisation d'une œuvre. L'approche synthétique par opposition à l'approche analytique permet d'appréhender toutes catégories d'actes rentrant dans les prévisions du législateur, sans limitation aucune. C'est celle retenue par le code de la propriété intellectuelle français dont s'inspire la loi sénégalaise. L'article L. 122-3 dudit code dispose en effet : "La reproduction consiste dans la fixation matérielle de l'œuvre par tous procédés qui permettent de la communiquer au public d'une manière indirecte. Elle peut s'effectuer notamment par imprimerie, dessin, gravure, photographie, moulage et tout procédé des arts graphiques et plastiques, enregistrement mécanique, cinématographique ou magnétique", la liste des actes cités n'étant pas limitative. C'est dire que la fixation de l'ouvrage "Pour l'honneur de la gendarmerie sénégalaise" sous la forme numérique sur un support numérique est une reproduction donnant prise au droit d'auteur au sens du texte de loi susvisé. La motivation du juge du tribunal de grande instance de Paris dans la décision évoquée ci-avant est suffisamment éloquente à ce propos : "Toute reproduction par numérisation d'œuvres musicales protégées par les droits d'auteur susceptibles d'être mise à la disposition de personnes connectées au réseau Internet doit être autorisée expressément par les titulaires ou cessionnaires de droit". Une abondante jurisprudence notamment française a suivi ce mouvement désormais irréversible⁹⁰. Si l'incorporation du stockage numérique d'une œuvre dans le champ de la reproduction au sens légal du terme n'est plus discutée, il est toutefois impératif de préciser la fixation à prendre en considération, bien que la question n'ait pas été expressément posée dans la décision commentée, tant il est vrai que plusieurs types de fixations et donc de reproductions interviennent au cours du processus de numérisation, de compression ou de transmission de l'œuvre protégée. C'est le cas de la

90 Voir CA Paris, 5 mai 1997 : JCP G 1997, II, n° 22906 (note OLIVIER (É.)), Tribunal commercial de Nanterre, 9^e chambre, 27 janvier 1998 : JCP E 1998, p. 850 (obs. VIVANT (M.) et LE STANC (C.)); TGI de Strasbourg, 3 février 1998 : JCP G 1998, II, n° 10044 (note DERIEUX (E.)).

copie de l'œuvre effectuée par l'ordinateur de routage⁹¹ ou sur la mémoire vive de l'ordinateur de l'utilisateur⁹². C'est également le cas des reproductions dites de proximité réalisées par les serveurs informatiques encore qualifiées de copies en cache ou en mémoire tampon⁹³. S'il est hors de doute que la loi sénégalaise du 25 janvier 2008, au visa de laquelle la décision rapportée a été rendue, a théoriquement vocation à régir ces différentes formes de reproductions, cette extension de la protection s'avère pratiquement artificielle étant donné que ces copies essentiellement techniques ont exclusivement pour finalité de permettre la circulation des œuvres sur les réseaux numériques et n'ont aucune valeur économique propre.

La doctrine spécialisée suggère de tenir compte de la dimension humaine de la transmission pour la détermination des actes de reproduction donnant prise au droit d'auteur⁹⁴. L'on décèle d'ailleurs un écho feutré de cette préoccupation dans certaines législations d'Afrique et d'ailleurs sur le droit d'auteur, lesquelles érigent les copies techniques au rang des exceptions aux droits de l'auteur de l'œuvre diffusée sur la toile⁹⁵. Dans sa rédaction actuelle, la loi sénégalaise susvisée ne prévoit expressément aucune exception pour les reproductions techniques, ce qui est problématique quant à l'encadrement de la responsabilité des intermédiaires techniques.

2. La violation du droit de communication au public

Aux termes de l'article 34.1) de la loi du 25 janvier 2008 :

"L'auteur a le droit exclusif d'autoriser la communication de son œuvre au public par tout procédé, notamment par voie de radiodiffusion, de distribution par câble ou par satellite, de mise à disposition sur demande de manière que chacun puisse avoir accès à l'œuvre de l'endroit où et au moment qu'il choisit individuellement, et, pour les œuvres graphiques et plastiques, par voie d'exposition de l'objet matériel".

Il va sans dire, en application de cette disposition, que les administrateurs des sites Assirou.net et Actu.net ont mis les deux tomes de l'ouvrage du colonel ABDLOULAYE

91 L'ordinateur de routage ou routeur est un élément intermédiaire dans un réseau informatique assurant le routage des paquets entre réseaux indépendants.

92 L'ordinateur personnel de l'utilisateur peut copier temporairement les informations reçues en ligne afin de ne pas avoir à se connecter systématiquement au réseau à chaque consultation. Doctrine et jurisprudence s'accordent à exclure ces actes du champ de la protection légale.

93 Les serveurs informatiques assurent l'interface entre les abonnés du fournisseur d'accès et l'Internet. Ces serveurs réalisent très souvent des copies intégrales des sites les plus visités par les internautes afin d'économiser la liaison avec le site original. Sur le plan pratique, ces reproductions de proximité permettent la fluidité du trafic sur le réseau et une économie réelle de la bande passante.

94 Voir VIVANT (M.) (éd.), Droit de l'informatique et des réseaux, Paris (Édition Lamy), 2004, p. 1331, n° 2278. Les auteurs estiment qu'il faut, en effet, s'attacher à la fixation qui tend à la communication aux personnes humaines et non point à une fixation simplement technique.

95 Cf. art. 29 de la loi n° 2000/011 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins (Cameroun). Voir également en droit européen art. 5 al. 1 de la Directive européenne n° 2001/29/CE du Parlement européen et du Conseil du 22 mai 2001 sur l'harmonisation de certains aspects du droit d'auteur et des droits voisins dans la société de l'information.

AZIZ NDAW à la disposition de la communauté des internautes, chaque visiteur pouvant y avoir librement accès à partir de n'importe quel lieu de la planète. La notion de public ne pose ici aucune difficulté particulière, celui-ci étant constitué de tous les potentiels visiteurs des sites incorporant l'œuvre contrefaite.

L'une des questions récurrentes en matière de communication via le réseau Internet non expressément abordée en l'espèce est celle relative à la mise en jeu éventuelle de la responsabilité pénale de l'auteur d'un lien hypertexte qui assure l'accès à un site Web par un cheminement différent de celui prévu par le constructeur du site. Le lien hypertexte est en effet un mécanisme qui permet de passer instantanément à partir d'un signe contenu dans une page Web à une autre page Web, quelle que soit sa localisation sur le réseau. Ces hyperliens qui jouent un rôle de premier plan dans le fonctionnement de l'architecture de l'Internet sont très souvent utilisés par leurs créateurs pour orienter les internautes vers des contenus illicites. L'auteur d'un tel lien qui réalise une communication de l'œuvre numérisée au public au sens de l'article 34 de la loi n° 2008-09 du 25 janvier 2008 précitée est-il justiciable du chef de contrefaçon? A priori, l'établissement d'un hyperlien ne porte pas en soi atteinte au droit de communication au public. Rien ne paraît cependant interdire le recours aux règles de droit commun sur la complicité s'il est établi que le lien litigieux a été utilisé de façon déloyale notamment comme moyen pour commettre la contrefaçon⁹⁶.

3. La violation du droit de distribution

L'article 36 de la loi n° 2008-09 dispose que "L'auteur a le droit exclusif d'autoriser la distribution, par la vente ou autrement, des exemplaires matériels de son œuvre". La rédaction de cette disposition pourrait laisser croire qu'elle n'intègre pas la distribution d'exemplaires numériques de l'œuvre, ce qui exclurait, le cas échéant, la vente ou l'offre gratuite en ligne des œuvres protégées. Il s'agit plus d'une maladresse rédactionnelle que d'une volonté affichée du législateur sénégalais de soustraire la distribution en ligne des œuvres littéraires et artistiques du champ du droit d'auteur, en particulier compte tenu de l'essor sans précédent du commerce électronique dans les États africains avec tout ce que cette activité implique en termes de violation des droits de propriété intellectuelle.

Il importe de souligner que le caractère lucratif ou gratuit de la distribution est indifférent. Dans le cas d'espèce, les sites contrefaisants offraient l'ouvrage litigieux en téléchargement gratuit, ce qui ne dépouille pas pour autant cette activité de son caractère délictueux. Abordant la question du caractère lucratif de l'acte incriminé, s'agissant certes du droit de représentation, la Cour de cassation française a indiqué qu'"aucun texte de loi ne restreint l'action dérivant du droit de propriété des auteurs au cas où c'est dans un but de lucre qu'a lieu la représentation de leurs œuvres"⁹⁷.

Au total, trois composantes du droit d'exploitation revendiqué par le colonel NDAW sur son ouvrage "Pour l'honneur de la gendarmerie sénégalaise" sont touchées en l'espèce. L'on peut néanmoins déplorer l'insuffisance des motifs de la décision commentée, laquelle se borne à énumérer les éléments matériels de l'infraction sans les caractériser véritablement. En tout état de cause, le délit de l'article 144 de la loi du 25 janvier 2008 exige en outre, pour être constitué, l'élément moral voilé sous le capuchon gris d'absence d'autorisation du titulaire des droits.

B. L'absence de l'autorisation du titulaire des droits

Il ne ressort pas de la décision rapportée que les administrateurs des sites Assirou.net et Actunet.sn ont sollicité, et encore moins obtenu, l'autorisation préalable du colonel NDAW préalablement à la mise en ligne et à la distribution des deux tomes de son ouvrage "Pour l'honneur de la gendarmerie sénégalaise". Or, la reproduction, la communication au public et la distribution même par voie électronique d'une œuvre littéraire et artistique doivent être autorisées par l'auteur de l'œuvre ou ses ayants droit, conformément aux articles 33 et suivants de la loi du 25 janvier 2008. La non-comparution des prévenus à l'audience est du reste symptomatique de l'inexistence en l'espèce d'une convention matérialisant cette autorisation donnée soit par l'auteur lui-même, soit par le bureau sénégalais du droit d'auteur au cas où celui-ci y serait affilié.

II. La sanction de la violation des droits de l'auteur via l'Internet

Plusieurs acteurs ont vocation à intervenir dans le processus de numérisation et de diffusion d'une œuvre littéraire et artistique sur la toile. D'où l'intérêt de la définition du cercle de personnes qui pourraient être tenues pour pénalement responsables des actes sus-spécifiés (A). Ensuite, il y aura lieu de préciser la grille des sanctions encourues (B).

A. Les auteurs des faits incriminés

Les auteurs des faits incriminés sont en premier lieu l'administrateur du site incorporant le contenu illégal (1) et d'autres maillons de la chaîne de circulation de l'œuvre dans l'environnement numérique peuvent être incriminés (2).

1. L'administrateur du site

C'est l'hypothèse évoquée dans l'affaire rapportée. L'administrateur du site en est le principal responsable. C'est lui qui fournit et met le contenu litigieux en ligne, bien qu'il soit envisageable que le contenu provienne d'une autre source. Dans cette hypothèse, le tiers responsable pourra endosser la responsabilité pénale du fait de la diffusion illégale de l'œuvre contrefaite en ligne. Les faits nous révèlent que les nommés MAMADOU MOUTH BANE et SERIGNE Fadel MBACKE sont respectivement administrateurs des sites Actunet.sn et Assirou.net, vecteurs du contenu critiqué. C'est donc en toute légalité qu'ils ont été déclarés pénalement responsables de la violation du droit d'exploitation de la partie civile sur son œuvre.

96 Voir n.94, p. 1333, n° 2281.

97 Voir Cass.civ., 1^{er} avril 1882, in : S. 1882, I, p. 334.

2. Les autres acteurs du réseau

Il a été précédemment évoqué la possibilité de la mise en jeu de la responsabilité du créateur des hyperliens permettant ou facilitant l'accès au site Web cible contenant l'information recherchée. Ce cas de figure renvoie évidemment à la complicité telle que définie par le code pénal national. Il est tout aussi possible d'envisager la responsabilité pénale du fournisseur d'accès dont la fonction principale est de mettre en relation ses abonnés avec les sites ou avec les autres utilisateurs. Il n'a pas la maîtrise des contenus. Plus précisément, selon la lumineuse formule retenue par les auteurs du Rapport Broglie : "il ouvre une porte, mais n'abrite pas"⁹⁸. En somme, la responsabilité pénale du fournisseur d'accès peut néanmoins être mise en jeu s'il est prouvé qu'il a personnellement commis l'infraction ou participé à sa commission à quelque titre que ce soit.

B. La grille des sanctions

Les sanctions encourues par les contrevenants sont à la fois pénales (1) et civiles (2).

1. Les sanctions pénales

Les sanctions pénales susceptibles d'être infligées à titre principal à l'auteur d'une atteinte aux droits des auteurs d'œuvres littéraires et artistiques sont l'emprisonnement et l'amende. Aux termes de l'article 142 de la loi n° 2008/09 du 25 janvier 2008 : "Est punie d'un emprisonnement de six mois à deux ans et d'une amende d'un million à cinq millions de francs CFA la violation du droit de communication au public, du droit de reproduction, du droit de distribution ou du droit de location". Il importe de souligner qu'en vertu de cette disposition légale, la peine d'emprisonnement doit être cumulée de l'amende. Pourtant le juge a cru devoir condamner les prévenus à trois mois d'emprisonnement avec sursis, les mettant ainsi à l'abri de l'amende, en violation de la susdite disposition légale. En tout état de cause, cette mensuétude du juge paraît en contradiction avec les orientations du législateur communautaire qui, à l'article 64, alinéa 1, de l'annexe VII de l'AB-1999 sous l'empire duquel cette décision a été rendue, suggère une peine suffisamment dissuasive contre les auteurs d'actes portant atteinte à un droit protégé.

Quoi qu'il en soit, le juge a en outre, conformément à l'article 149 de la loi susvisée, ordonné la publication du jugement aux frais des condamnés dans certains journaux y compris les sites litigieux.

2. Les sanctions civiles

La question de l'évaluation des dommages et intérêts auxquels peut prétendre la personne lésée en cas de violation du droit d'auteur a préoccupé le juge dans l'affaire rapportée, le colonel NDAW ayant sollicité l'allocation de la somme de 300 000 000 francs à ce titre. En droit d'auteur sénégalais, l'évaluation du préjudice est encadrée par l'article 52 de la loi 2008-09 qui dispose : "Le demandeur peut réclamer l'indemnisation de l'entier

préjudice causé par l'atteinte à son droit, évalué en tenant compte de son manque à gagner et de son préjudice moral, ainsi que des bénéfices injustement réalisés par le défendeur. Il peut également prétendre au paiement des frais occasionnés par l'acte de violation, y compris les frais de justice". En général, la charge de la preuve du préjudice dans toutes ses déclinaisons incombe au demandeur qui doit produire les éléments pertinents devant permettre au juge d'en apprécier la réalité et de le quantifier. Le tribunal a alloué la somme de FCFA 20 000 000 en réparation des préjudices matériel et moral subis par le colonel NDAW du fait de la violation de son droit d'exploitation à travers les sites Internet Actunet.sn et Assirou.net après avoir estimé disposer d'éléments d'appréciation suffisants. Il importe toutefois de s'interroger sur la pertinence de la démarche du juge relativement aux différents postes de préjudice réparés. La décision rapportée ne fournit en effet pas suffisamment d'informations permettant de déterminer les montants alloués respectivement au titre du préjudice matériel et au titre du préjudice moral, s'agissant des préjudices par nature différents, ce qui pourrait l'exposer à la censure de la juridiction supérieure.

Max Lambert Ndéma Elongué

L. Droit d'auteur – Action en contrefaçon – Identité en tant qu'auteur contestée du demandeur – Pourvoi en cassation – Distinction du droit et du fait

Le demandeur en contrefaçon ne peut prétendre remettre en cause devant le juge de la cassation les constatations de fait qui ont conduit les juges du fond à lui dénier la paternité de l'œuvre qu'il prétend contrefaite.

Cour suprême du Sénégal, Arrêt n° 60 du 4 juillet 2012, PAPE MALICK FALL c. SOCIÉTÉ DES CONSERVÉRIES ALIMENTAIRES DU SÉNÉGAL (S.O.C.A.S.)

Observations :

L'arrêt commenté, rendu par la Cour suprême du Sénégal, illustre la difficulté de mettre en œuvre la distinction entre le droit et le fait, distinction essentielle pour délimiter l'étendue du contrôle opéré par le juge de cassation mais qui se révèle "fuyante"⁹⁹, tout particulièrement dans des matières telles que la propriété littéraire et artistique lorsqu'il s'agit, comme en l'espèce, de contrôler des notions comme celle d'auteur ou d'originalité qui font une place très importante au pouvoir d'appréciation des juges du fond. Malheureusement, les enseignements qu'il livre sont limités par sa rédaction parfois imprécise et par la formulation du pourvoi qui n'est pas assez rigoureuse.

Faits : Pour autant qu'on puisse reconstituer le contexte à partir des informations fragmentaires contenues dans l'arrêt de rejet, on comprend qu'il s'agit d'une action en contrefaçon de droit d'auteur intentée par un certain

98 Voir Rapport du groupe de travail de l'Académie des sciences, sous la direction de Gabriel DE BROGLIE, 2000, p. 46. Disponible en ligne à l'adresse [www/http://bbf.enssib.fr/consulter/bbf-2001-05-0155-00](http://bbf.enssib.fr/consulter/bbf-2001-05-0155-00).

99 LOUIS-CAPORAL (D.), La distinction du droit et du fait en droit judiciaire privé, Thèse, Montpellier, 2014, n° 9.

Pape Malick Fall, qui se prétend auteur d'un dessin représentant trois tomates sur fond de rayures rouge et or et un buste de femme, contre la société SOCAS, inventeur de la tomate industrielle au Sénégal, laquelle l'aurait, selon lui, reproduit sans son autorisation sur l'emballage d'un de ses produits.

Débouté par la cour d'appel de Dakar, il forme un pourvoi dans lequel il articule quatre moyens distincts, respectivement fondés sur :

- I. "la dénaturation des faits";
- II. "l'inexactitude des motifs";
- III. "la contradiction de motifs"; et
- IV. "la violation de la loi".

Tous déclarés irrecevables par la Cour suprême, au terme d'une argumentation qui, à vrai dire, n'emporte pas toujours la conviction.

I. Moyen pris de la dénaturation des faits

Le pourvoi reproche en premier lieu à l'arrêt attaqué d'avoir relevé que le demandeur

"ne revendique pas la paternité du personnage figurant sur l'emballage du produit SOCAS illustré par trois tomates sur fond de rayures rouge et or et un buste de femme avec l'intitulé *Signara*, alors que ce personnage, ajouté à son œuvre reproduisant trois tomates reliées et dénommée *SIGNARA* figurant sur un fond de rayures rouge et noir, s'inspire de l'intitulé de son œuvre".

La présentation du moyen est doublement maladroite. D'abord, elle ne permet pas de bien comprendre ce qui est réellement reproché aux juges du fond, sinon que le dessin figurant sur l'emballage n'est pas la copie servile du dessin revendiqué par le demandeur (circonstance qui n'exclut pas, bien sûr, l'existence d'une contrefaçon).

Ensuite et surtout, l'affichage en termes de "dénaturation des faits" méconnaît ouvertement le principe constant selon lequel le contrôle de cassation a pour objet les questions de droit à l'exclusion des questions de fait. La réponse de la Cour suprême mérite à cet égard l'approbation. Elle écarte en effet le moyen en rappelant, ce qui échappe à toute contestation, que "le grief de dénaturation ne donne ouverture à cassation que s'il porte sur un écrit". On citera en ce sens un arrêt de la Cour de cassation française qui, alors que le demandeur au pourvoi plaidait une "dénaturation de la volonté des parties", a déclaré le moyen non fondé (et non pas, on le notera en passant, irrecevable) au motif "qu'un grief de dénaturation ne peut porter sur l'interprétation d'un fait matériel"¹⁰⁰.

II. Moyen pris de l'inexactitude des motifs

Le deuxième moyen était tiré de ce que le "motif déterminant" de l'arrêt attaqué était une lettre adressée

par le demandeur dont il résultait qu'il avait intitulé son dessin "La tomate", et que la dénomination "La signara" avait été une "trouvaille" de la société défenderesse, alors que l'intéressé justifiait par deux attestations du BSDA (Bureau sénégalais du droit d'auteur) qu'il avait lui-même déposé une œuvre intitulée "La signara". Là encore, on peine à comprendre en quoi le titre de l'œuvre pouvait commander la solution.

La Cour suprême se prononce, en tout cas, pour l'irrecevabilité du moyen qui, selon elle, "se borne à critiquer les motifs de l'arrêt attaqué". La réponse est surprenante car, en soi, la critique des motifs peut parfaitement conduire à la cassation, par exemple en cas d'"insuffisance" ou de "contradiction" (*grief articulé dans le troisième moyen*). Il aurait suffi de s'en tenir, comme pour le premier moyen, au constat que le pourvoi ne permet pas de remettre en cause les constatations de fait opérées par les juges du fond, quoi qu'on puisse penser de leur force probante.

III. Moyen pris de la contradiction de motifs

Le pourvoi, dans son troisième moyen, décelait une contradiction de motifs dans le fait que la cour d'appel, "après avoir relevé que Pape Malick Fall est le créateur d'une œuvre dénommée *SIGNARA* figurant des tomates reliées ou mises ensemble et précisé que l'originalité de l'œuvre contrefaite tient au symbolisme de la dénomination", lui a "dénier" la paternité de l'œuvre, surtout qu'il a constaté que les emballages de la SOCAS montrent bien des tomates côte à côte".

L'objection est balayée en ces termes : "attendu que la contradiction alléguée ne porte pas sur les faits mais sur les conséquences juridiques que la cour d'appel en a tirées".

Le raisonnement suscite la perplexité. Au regard des développements précédents, il est difficile de comprendre comment la Cour suprême peut refuser de se pencher sur une critique portant sur les "conséquences juridiques" tirées par les juges du fond d'une situation de fait. Ne dit-on pas traditionnellement de la Cour de cassation (et la Cour suprême du Sénégal est ici dans ce rôle) qu'elle est "juge du droit"¹⁰¹?

Au demeurant, si l'on s'en tient, faute d'avoir accès à l'arrêt attaqué, à la formulation du pourvoi sur ce point, la contradiction dénoncée apparaît flagrante. Qualifier le demandeur de "créateur" d'une œuvre dont on reconnaît l'"originalité", c'est bien en faire le titulaire d'un droit d'auteur, ce que vient conforter la référence à une œuvre "contrefaite". Si la cour d'appel de Dakar lui a cependant dénié cette paternité, il faut bien admettre qu'elle s'est contredite. Or la contrariété de motifs est un cas reconnu d'ouverture à cassation.

100 Cass. soc., 28 novembre 2000, n° 98-41.377.

101 WEBER (J.F.), La Cour de cassation, 2^e éd., Paris (La documentation française), 2011, p. 9.

IV. Moyen fondé sur la violation de la loi

Le dernier moyen est fondé sur la violation de la loi qu'aurait commise la cour. Violation de l'article 118 du Code sénégalais des obligations civiles et commerciales dont ils auraient écarté à tort l'application, "alors que l'utilisation frauduleuse de l'œuvre contrefaite du requérant par la SOCAS à des fins commerciales dont elle a tiré un profit s'analyse en un enrichissement sans cause au préjudice de Papa Malick FALL et constitue une faute". Violation également de l'article 9 du même code en ce qu'ils ont refusé de faire droit à la demande d'indemnisation, "alors que le requérant a établi la réalité de la violation de ses droits qui lui a causé préjudice du fait des agissements quasi délictueux de la SOCAS". La Cour suprême se borne à répondre que "sous couvert de ce grief, le moyen ne tend qu'à remettre en discussion les éléments de fait et de preuve souverainement appréciés par les juges du fond", ce qui le rend irrecevable.

Aussi bien le moyen articulé dans le pourvoi que cette réponse appellent, à notre sens, des réserves. L'article 9 du Code des obligations civiles et commerciales dispose que "celui qui réclame l'exécution d'une obligation doit en prouver l'existence" et que "celui qui se prétend libéré doit prouver que l'obligation est inexistante ou éteinte". Il n'intéresse donc que la charge de la preuve et n'aurait été en cause en l'espèce que si le demandeur avait établi l'existence de l'obligation du défendeur, ce qui était précisément en débat. Quant à l'article 118, il est sans rapport avec l'enrichissement en cause qui est régi par les articles 160 et 161.

Mais contrairement à ce qu'affirme la Cour suprême, le moyen tiré de la violation de cet article ne tendait pas à remettre en cause l'appréciation souveraine des circonstances de fait. L'argument avancé était bel et bien d'ordre juridique. Il aurait été opportun et d'ailleurs facile d'y répondre. Cette réponse aurait pu (*dû*) être la suivante : dès lors que la contrefaçon n'est pas constituée, ce qui est l'hypothèse de départ, l'action fondée sur la responsabilité civile ne pouvait jouer un rôle supplétif qu'à la condition pour le demandeur d'établir la réalité d'une faute distincte. Il est en effet admis qu'une telle action, qui prend souvent la forme d'une action en concurrence déloyale, ne peut permettre de reconstituer un droit privatif sur une création qui n'est pas (ou qui n'est plus) protégée¹⁰². Or cette faute distincte n'était même pas alléguée puisque le pourvoi se bornait à prétendre que les agissements délictueux consistaient dans la "violation" des droits du demandeur, ce qui ramenait sur le terrain de la contrefaçon.

Reste la théorie de l'enrichissement sans cause. On pouvait admettre que l'utilisation commerciale de l'œuvre par la société défenderesse l'avait enrichie mais le demandeur ne pouvait prétendre s'être corrélativement appauvri qu'en prouvant sa paternité, prétention qui avait précisément été écartée par l'arrêt attaqué. Au demeurant, l'article 161 du Code des

obligations civiles et commerciales prévoit que l'action fondée sur cette théorie (l'action *de in rem verso*) "ne peut être intentée qu'à défaut de tout autre moyen de droit". Or il est douteux que cette condition soit remplie lorsque l'action exercée à titre principal est jugée non fondée.

Au total, le pourvoi, tel qu'il était formulé, ne pouvait aboutir à la cassation de l'arrêt attaqué, mais le rejet aurait pu être mieux argumenté.

André Lucas

M. Droit d'auteur – Saisie-contrefaçon – Comité provincial de lutte contre la piraterie – Composition irrégulière du comité – Identification du saisissant et des biens saisis – Recours au droit OHADA des saisies? – Application de la loi sur les œuvres cinématographiques – Jurisdiction compétente – Juge des référés (oui)

La saisie-contrefaçon ne constitue nullement une sanction administrative et elle ne peut être pratiquée que sur autorisation du juge compétent. En outre, le procès-verbal y relatif doit comporter toutes les mentions propres à identifier le saisissant et les biens saisis. Faute pour le saisissant d'avoir observé ces exigences, la saisie peut être attaquée devant le juge des référés.

Tribunal de première instance de Garoua, Ordonnance de référé n° 17/R du 21 septembre 2005, **SADJO MABI c. COMITÉ PROVINCIAL DE LUTTE CONTRE LA PIRATERIE**

Observations :

L'ordonnance de référé n° 17/R rendue le 21 septembre 2005 par le président du tribunal de première instance de Garoua illustre à merveille les difficultés que doivent surmonter les acteurs du droit d'auteur au Cameroun, spécifiquement, et dans l'espace OAPI en général.

Faits : Les faits de la cause étaient relativement banaux. Le 13 juillet 2005, le sieur Sadjo Mabi, vendeur de supports phonographiques et vidéographiques, a fait l'objet d'une saisie pratiquée à l'initiative d'un Comité provincial de lutte contre la piraterie du nord au Cameroun. Le saisi, ayant estimé que la saisie était irrégulière, a saisi le juge des référés aux fins d'en obtenir mainlevée. À l'appui de sa demande, plusieurs moyens sont soulevés :

- tout d'abord, il estime que le Comité est irrégulièrement constitué au regard de la décision n° 02/48/MINCULT/CAB du 11 novembre 2002 signée du ministre camerounais de la culture, portant création du Comité national de lutte contre la contrefaçon, laquelle organise les modalités de création et de fonctionnement des Comités provinciaux;
- ensuite, il relève que, sur le plan procédural, la saisie est nulle, dès lors qu'elle a été pratiquée sans autorisation préalable du président du tribunal de première instance; et

102 Voir en ce sens en droit français Cass. req., 29 novembre 1943 : Ann. propr. ind. 1940-1948, p. 339; Cass. com., 24 janvier 1972, n° 70-11.878 : Bull. civ., IV, n° 27.

- enfin, il invoque deux arguments relatifs au déroulement des opérations de saisie : l'acte de saisie ne contiendrait pas l'énumération détaillée des objets placés sous mains de justice et les mentions concernant les personnes ayant pratiqué la saisie seraient douteuses.

Raisonnement : Pour sa défense, le comité commence par soulever l'incompétence du juge des référés, en se basant tantôt sur le préjudice que porterait l'ordonnance de référé au fond, tantôt sur le caractère administratif de l'arrêté n° 1174/AP/D/SG/ASD du 29 novembre 2004 du Gouverneur de la province du nord Cameroun, portant désignation des membres du comité. Ensuite, il invoque le fait que Monsieur Sadjó ne disposait pas d'une autorisation d'exploitation des œuvres de l'esprit, malheureusement en se fondant sur la législation relative à l'exploitation des œuvres cinématographiques. Sur cette base, il estime que la saisie pratiquée est une sanction administrative contre le prétendu contrefacteur.

Ces arguments sont évidemment contestés par le demandeur au référé, pour qui les saisissants auraient dû, conformément à l'article 87 de la loi camerounaise n° 2000/11 du 19 décembre 2000 relative au droit d'auteur et aux droits voisins, saisir la juridiction compétente au fond, sous peine de mainlevée.

De l'ensemble de cette situation teintée de confusions regrettables, il ressort que la saisie litigieuse ne pouvait, en aucun cas, constituer une sanction administrative que le comité n'avait pas le pouvoir d'agir en lieu et place des autorités étatiques. Il s'agissait plutôt, en réalité, de la saisie-contrefaçon. En s'immisçant dans le cercle des saisissants et en mettant sous mains de justice les cassettes et CD appartenant au sieur SADJO MABI le 13 juillet 2005, le Comité provincial de lutte contre la piraterie, acteur institutionnel créé par le ministre en charge de la culture en vue de renforcer la lutte contre la contrefaçon, a suscité deux débats juridiques que devait trancher le juge des référés de Garoua :

- I. le premier était relatif à la régularité de la saisie-contrefaçon (section I); et
- II. le second se rapportait à la compétence juridictionnelle en matière de saisie-contrefaçon (section II).

I. La régularité de la saisie-contrefaçon

La question soulevée par l'ordonnance commentée à propos de la régularité de la saisie présente deux volets. D'une part, elle donne l'occasion de s'interroger sur le droit commun applicable en matière de saisie-contrefaçon, en ce que cette saisie doit se conformer à la fois à cette législation et à celle spécifique au droit d'auteur. En effet, elle permet de se demander quel serait le droit applicable lorsque la législation spécifique à la saisie-contrefaçon est incomplète ou silencieuse. Tel est le cas de la question de certains éléments que doit contenir le procès-verbal de saisie. Pour y répondre, il convient de relever que la législation qui paraît s'imposer est l'Acte uniforme OHADA portant organisation des procédures

simplifiées de recouvrement et des voies d'exécution. Celui-ci, seule législation applicable aux pays de l'espace OAPI en matière de procédures civiles d'exécution, impose à celui qui pratique une saisie quelconque de s'identifier clairement et de spécifier en détail les biens qu'il saisit (A).

D'autre part, la réponse à la question de la régularité de la saisie-contrefaçon suppose que soit clairement identifiée la législation nationale en vertu de laquelle elle est pratiquée (B).

A. L'identification du saisissant et des biens saisis

Aucune disposition expresse de l'Accord de Bangui ou des lois nationales relatives au droit d'auteur et aux droits voisins ne pose, comme condition générale, l'exigence de l'identification du saisissant dans une procédure de saisie-contrefaçon. Cependant, il ne fait pas de doute qu'il s'agit d'un principe général qui gouverne la matière, ainsi que le rappelle le juge des référés de Garoua. L'explication est triviale pour le juriste : il est important pour le saisi ou le tiers saisi de connaître avec exactitude l'identité de son adversaire dans la procédure que ce dernier a entamée contre lui, afin d'organiser sa défense.

L'interprète est alors spontanément orienté vers le droit commun des saisies tel qu'il ressort de l'Acte uniforme portant organisation des procédures simplifiées de recouvrement et des voies d'exécution. L'applicabilité de cet Acte uniforme en matière de propriété intellectuelle est progressivement admise, afin de combler tous les vides laissés par cette matière dans le domaine des saisies¹⁰³. Cependant, la jurisprudence reste lucide et refuse le recours à ce texte, lorsque la solution se trouve dans le droit spécial de la saisie-contrefaçon tel qu'il résulte des lois nationales sur le droit d'auteur et des annexes de l'Accord de Bangui en ce qui concerne la propriété industrielle. On a pu le vérifier avec l'affaire Société BIC S.A c. Société TBC S., dans laquelle le juge a rejeté la compétence du juge des difficultés d'exécution prévu par l'article 49 de cet Acte uniforme¹⁰⁴. D'ailleurs, cette affaire a donné l'occasion de constater que le droit commun applicable aux saisies-contrefaçons peut également être d'origine nationale lorsque le silence du droit spécial sur la propriété intellectuelle est doublé de celui de l'Acte uniforme sur les voies d'exécution. En effet, dans l'affaire BIC SA ci-dessus citée, le juge déclare que

“le traité OHADA n'ayant pas réglementé les saisies-contrefaçons, celles-ci restent régies par les dispositions du droit commun; Que seul le juge des référés classique de l'article 182 du Code de procédure civile et commerciale demeure compétent pour connaître en urgence les difficultés inhérentes auxdites saisies; Qu'il y a donc lieu de déclarer le juge des référés classiques compétent”.

103 Voir pour application à la saisie d'une marque : TGI Hors classe de Niamey, Ordonnance de référé n° 118 du 20 mai 2008, *Rothmans of Pall Mall Ltd SA c. Société Adil Company et El Hadj S.S* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 3, section 5).

104 CA Littoral-Douala, Arrêt n° 28 du 28 janvier 2008, *Société BIC SA c. Société TBC* (obs. NDEMA ELONGUE (M-L.), ce recueil, chapitre 1, section F).

Cette solution mérite approbation, même si elle contribue à complexifier une matière dont la simplicité apparente est bien trompeuse¹⁰⁵.

En tout état de cause, l'Acte uniforme OHADA conforte, pour le cas d'espèce, l'obligation pour le saisissant de s'identifier. Ainsi, dans l'article 64, alinéa 2, le texte régional dispose que le procès-verbal de saisie conservatoire des meubles corporels doit comporter entre autres, à peine de nullité, "les noms, prénoms et domiciles du saisi et du saisissant...". Aux alinéas 1 des articles 77 et 100, la même obligation est réitérée sous la même sanction, concernant les actes de saisie conservatoire d'une créance et de saisie-vente d'un meuble.

Dans ces conditions, était-il utile pour la partie défenderesse d'invoquer les dispositions spécifiques du Code d'instruction criminelle alors en vigueur au Cameroun? La réponse à cette interrogation est négative pour au moins deux raisons : d'une part, l'article 37 CIC qui vise expressément la saisie effectuée à l'occasion d'une infraction pénale concerne celle qui serait effectuée dans "le domicile du prévenu". Or, en matière de saisie-contrefaçon, les objets contrefaisants et le matériel servant ou devant servir à la commission de l'infraction sont généralement localisés dans le lieu où le contrefacteur exerce son activité délictueuse, lequel n'est pas forcément le domicile. D'autre part, même si la nature civile de la saisie-contrefaçon peut être discutée, on peut voir que la juridiction compétente en cas de recours contre ladite saisie est le juge des référés¹⁰⁶. Dans cette logique, point n'est besoin d'invoquer les dispositions du CIC, dès lors que le saisissant remplit les autres conditions pour pratiquer une saisie-contrefaçon.

Et, de toute manière, le saisissant était bien connu, dès lors qu'il s'était clairement identifié et s'était présenté comme constituant le Comité provincial de lutte contre la piraterie. Seule posait problème sa qualité pour saisir, du moment où le défendeur estimait que ces individus n'étaient pas les personnes devant faire partie dudit comité. Ce seul motif n'aurait sans doute pu conduire à l'annulation de la saisie que si était en cause l'examen de la régularité de l'acte administratif les ayant désignés. Or, le débat, ainsi que le rappelle le juge des référés, était loin de ce sujet.

En revanche, en omettant d'identifier dans le détail les objets saisis, le comité exposait la saisie pratiquée à une nullité certaine. Cependant, la question se pose juste de savoir quelle législation doit être appliquée pour obtenir une telle nullité. Si l'on se réfère à l'Acte uniforme OHADA précité, on constate qu'il rappelle toutes les fois où cela est nécessaire que l'acte de saisie doit comporter la désignation détaillée des biens saisis à peine de nullité (*v. notamment art. 64, al. 4*).

Par ailleurs, même en se fondant sur les principes généraux de droit, on aurait pu obtenir le même résultat. En effet, il est clair qu'un procès-verbal qui ne comporte pas ces éléments substantiels manquerait à sa mission. Il s'agirait alors de faire application de la théorie des nullités virtuelles. Par conséquent, on doit affirmer que, dans le procès-verbal de saisie, l'officier ministériel ou l'officier de police judiciaire doit préciser le nombre de phonogrammes et de vidéogrammes saisis, en les listant minutieusement, notamment par artiste, par titres ou par collection, pourvu qu'il en ressorte un inventaire lisible, détaillé et exhaustif excluant toute incertitude.

Dans tous les cas, l'absence de détails concernant les objets saisis n'était pas la seule cause de nullité de la procédure. Le comité avait utilisé une fausse base légale pour son action, ce qui fragilisait la saisie pratiquée.

B. L'identification de la législation applicable

Il peut sembler incongru d'ouvrir un débat concernant l'identification de la législation applicable en matière de saisie-contrefaçon. A priori, il serait étonnant qu'une personne saisisse des œuvres de l'esprit en se fondant sur une législation autre que celle régissant les droits des auteurs. C'est pourtant ce qu'il est advenu dans le cas d'espèce. Pour la défense du Comité provincial de lutte contre la piraterie, l'avocat relève que "la distribution par vente, location, l'exploitation, l'importation d'une œuvre de l'esprit est soumise à une autorisation préalable exigée selon la réglementation prévue au Décret n° 90/1463 du 9 novembre 1990, autorisation également exigée par la loi n° 88/017 du 16 décembre 1990" et que faute de cette autorisation, le contrefacteur encourrait des sanctions administratives. À la vérité, il créait une grave confusion : maladroitement, il tentait de généraliser les règles spécifiques applicables à l'exploitation des œuvres audiovisuelles à l'ensemble des œuvres de l'esprit. Fort heureusement, le juge des référés de Garoua a admirablement réparti les domaines des deux législations. On peut simplement compléter son propos en soulignant que les œuvres cinématographiques obéissent à la fois à la législation relative aux droits d'auteurs tant que l'exploitation de ces droits est concernée, et à la législation relative à l'exploitation administrative desdites œuvres prises dans leur ensemble.

Cette dernière législation organise donc l'exploitation par rapport aux exigences étatiques. C'est dans ce cadre que se situe l'autorisation d'exploitation à laquelle fait allusion l'avocat du comité. Cette autorisation est délivrée après examen des conditions dans lesquelles seront exploitées les œuvres, sans égard à la protection des droits des auteurs (*il s'agit notamment de la sécurité du public. Cf. art. 13 et suivants de la loi de 1988*). Quant à la législation sur les droits des auteurs, elle a un objet différent. Les conditions administratives de l'exploitation ne tombent pas dans son domaine. Seuls l'intéressent, ainsi que le relève le juge des référés, les rapports entre les titulaires des droits qu'il prévoit et les exploitants. Dans cette logique, elle ne peut servir de base à une quelconque sanction administrative tandis que la première ne peut fonder

105 Dans le même sens, voir NDEMA ELONGUE (M.-L.), *ibid.*

106 Voir *ibid.* De manière globale, en dehors de l'intervention du Procureur de la République et de celle de l'officier de police judiciaire, ce sont les autorités civiles qui assurent la gestion de la saisie-contrefaçon. Il en est ainsi notamment du président du tribunal de première instance agissant en tant que juge des requêtes, lequel intervient dans la quasi-totalité des saisies antérieures à un procès civil.

une saisie tendant à la répression de la contrefaçon. Cette infraction vise précisément à sanctionner une exploitation illicite non pas parce qu'elle n'a pas été autorisée par l'administration, mais plutôt parce qu'elle s'est effectuée sans le consentement du titulaire du droit d'auteur. Au demeurant, le mode d'exploitation aurait dû, logiquement inciter les saisissants à plus de prudence. La loi spéciale sur l'exploitation des œuvres cinématographiques organise exclusivement l'exploitation par la représentation. Or, la saisie pratiquée dans le cas d'espèce mettait en cause des exemplaires illicites, lesquels relèvent de l'exploitation par la reproduction.

En tout cas, cela démontre l'ampleur du travail de vulgarisation de la propriété intellectuelle qui attend les acteurs du droit d'auteur au Cameroun et partant, dans l'espace OAPI. Car, on ne peut le nier, l'ignorance de la matière explique, au moins pour partie, les confusions et les erreurs constatées en l'espèce. La même ignorance justifie, semble-il, le débat ouvert à propos de la compétence du juge des référés.

II. La compétence juridictionnelle en matière de saisie-contrefaçon

La question de la compétence juridictionnelle en matière de saisie-contrefaçon a été également au centre des débats. Ces derniers constituent une belle occasion pour rappeler les règles générales relatives à cette compétence (A). En l'espèce, celles-ci ont été perturbées par l'immixtion du Comité national de lutte contre la piraterie et de ses excroissances, les comités provinciaux (B).

A. Règles générales relatives à la compétence juridictionnelle en matière de saisie-contrefaçon

En matière de saisie-contrefaçon, l'intervention juridictionnelle se situe généralement à un double niveau.

En amont, une juridiction est sollicitée pour délivrer une autorisation devant permettre de pratiquer cette saisie. Dans ce cadre, l'article 85, alinéa 1, de la loi camerounaise de 2000 dispose que, lorsque leurs droits sont violés ou menacés de l'être, les titulaires de droits d'auteur et leurs ayants droit peuvent saisir le "juge compétent" pour obtenir une autorisation permettant de saisir les exemplaires contrefaisants, les exemplaires importés illicitement et le matériel résultant, ayant servi ou devant servir à une représentation ou à une reproduction¹⁰⁷. À l'alinéa 2, le même article 85 dispose que "le président du tribunal civil compétent" peut également, par ordonnance sur requête, décider de mesures particulières, notamment la saisie même en dehors des jours et heures ouvrables et la saisie des recettes. Dans l'ensemble, le législateur camerounais a été inutilement alambiqué sur cette question. En effet, il est évident que lorsque la victime ou la potentielle victime d'une contrefaçon est informée de l'existence ou de la menace de l'infraction, elle a tout intérêt à agir avec la plus

grande célérité. Or, le juge civil idoine pour lui prêter le concours rapide dont il a besoin est le magistrat de l'urgence, c'est-à-dire pour le Cameroun, le président du tribunal de première instance agissant comme juge des requêtes. Par conséquent, on peut dire que l'autorisation juridictionnelle visée par l'article 85, alinéa 1, ne peut être contenue que dans une ordonnance sur requête. D'ailleurs la pratique confirme cette interprétation.

Dans l'affaire du Comité provincial de lutte contre la piraterie du nord, le saisi avait effectivement relevé l'absence d'autorisation de saisir. Mais il s'était appuyé non pas sur l'article 85 précité, mais, plutôt sur "la législation en vigueur en matière de voies d'exécution". Dans sa réponse à ce chef de la demande, le juge des référés relève que le comité se devait d'obtenir "une ordonnance du président du tribunal compétent" dès lors qu'il envisageait de pratiquer une saisie. Il appuie son raisonnement sur l'alinéa 2 de l'article 85, alors que, en toute logique, c'est plutôt l'alinéa 1 qui pose la règle générale qui aurait dû servir de base permettant d'obtenir le même résultat. En tout cas, une constante se dégage de l'ensemble de ces éléments : la victime ou la potentielle victime d'une contrefaçon doit obtenir une ordonnance du président du tribunal de première instance avant de pratiquer la saisie-contrefaçon, sinon celle-ci encourt une nullité certaine, devant le juge des référés (*conformément à l'art. 85, al. 1, la victime ou la potentielle victime de l'infraction peut, si elle le désire, requérir directement un huissier de justice ou un officier de police judiciaire. Cependant, ceux-ci n'ont pas le pouvoir de saisir de leur propre initiative. Ils se borneront à constater l'infraction ou la menace de l'infraction*).

En aval justement, le juge compétent pour connaître des recours contre la saisie-contrefaçon est le juge des référés. Sur ce point, la loi camerounaise de 2000 a été assez claire. Après avoir conservé le mystère en évoquant de nouveau "le président du tribunal" à l'article 86, alinéa 1, elle lève définitivement le voile en évoquant "le président du tribunal statuant en référé" à l'alinéa 2. Ce juge doit être actionné par le saisi ou le tiers saisi qui conteste la mise sous mains de justice des objets, dans les quinze jours du procès-verbal de saisie. L'objet du procès est, selon les termes de l'article 85, le cantonnement des effets de la saisie, la reprise de la fabrication des exemplaires ou encore la reprise des représentations, le cas échéant sous l'autorité d'un administrateur constitué séquestre ou contre consignation d'une somme affectée à la garantie des dommages et intérêts auxquels pourrait prétendre le titulaire du droit d'auteur.

Cependant, cette partie du contentieux de la saisie-contrefaçon, qui tend à minimiser le préjudice subi par le prétendu contrefacteur, présuppose que la saisie soit régulière sur le plan procédural. Lorsque, comme dans le cas d'espèce, elle ne l'est pas, notamment parce qu'elle a été pratiquée sans autorisation juridictionnelle ou parce qu'elle a été pratiquée sur des recettes ou en dehors des jours et heures légales sans autorisation spéciale du président du tribunal de première instance, elle encourt la nullité pour vice de forme. Et la juridiction compétente

¹⁰⁷ Cependant, la loi camerounaise attribue la compétence pour délivrer l'autorisation de pratiquer une saisie-contrefaçon, concurremment à ce juge et au Procureur de la République.

pour en connaître ne varie pas. Le juge des référés de Garoua a donc, à juste titre, retenu sa compétence en tant que juge des recours contre la saisie-contrefaçon.

Mais, une fois de plus, le fondement choisi est erroné. Il estime, en effet, que le saisissant doit (et ne l'a pas fait), dans les quinze jours du procès-verbal de saisie, saisir le président du tribunal de première instance statuant en matière de référé. Il s'agit là d'une confusion née, selon toute vraisemblance, de l'assignation par les articles 86 (*alinéa 1*) et 87, du même délai d'action au saisi et au saisissant.

Il faut le préciser, les deux actions doivent être formellement distinguées. D'une part, l'action de l'article 86 est ouverte au saisi et au tiers saisi pour leur permettre de contester la saisie devant le juge des référés dans les quinze jours du procès-verbal. D'autre part, l'action de l'article 87 est imposée, dans le même délai, au saisissant pour le contraindre à agir au fond afin d'établir la réalité de l'infraction¹⁰⁸. En cas d'inaction du saisissant dans ce délai, la saisie encourt mainlevée. En somme, les deux actions sont en tous points différentes : l'une, relevant du domaine du juge des référés est introduite par le saisi ou le tiers saisi, l'autre, relevant de la compétence juge du fond est engagée par le saisissant.

B. L'immixtion d'un acteur étatique

Par décision n° 02/48/MINCULT/CAB du 11 décembre 2002 telle que modifiée et complétée par celle n° 004/056/CAB du 27 juillet 2004, le ministre en charge de la culture du Cameroun instituait un Comité national de lutte contre la contrefaçon des œuvres de l'esprit au Cameroun. À l'article 5 de ce texte, il décidait que le gouverneur de chaque province du pays instituerait un comité du même nom par le biais d'un arrêté. Sans nul doute, ce comité et ses représentations provinciales étaient appelés à constituer l'un des bras séculiers de l'État dans la lutte contre la contrefaçon. Par conséquent, l'objectif visé est louable.

Pourtant, l'entrée de cet acteur institutionnel dans la lutte contre la contrefaçon suscite des questions. La première s'est posée dans l'affaire du Comité provincial du nord. Ici, le gouverneur avait, dès le départ, plombé juridiquement cette institution, en lui donnant une composition irrégulière. En effet, au lieu de désigner le délégué provincial de la culture de son ressort comme président ainsi que l'exige l'article 5 de la décision précitée, il s'était lui-même arrogé ce pouvoir. Le sieur Sadjo Mabi, saisi dans la procédure litigieuse, en a logiquement déduit que le gouverneur avait créé un comité autre que celui institué par décision ministérielle. Par conséquent, il s'appuyait sur l'irrégularité de la composition du comité pour demander mainlevée de la saisie.

Pour sa défense, le comité soulève plusieurs arguments dont l'incompétence du juge des référés. Il estime, en

effet, que l'arrêté du gouverneur ayant créé le Comité provincial est un acte administratif dont la connaissance échappe au juge des référés. Fort heureusement, le juge perçoit très efficacement la question de droit à laquelle il doit en réalité répondre : il n'a pas été saisi afin de se prononcer sur la régularité de la composition du comité, mais simplement pour examiner la régularité de la saisie pratiquée par cette instance. Le premier débat inviterait indubitablement le juge à se pencher sur l'acte administratif de création du comité, tandis que le second le borne à voir si ses agissements sont ou non conformes à la loi du 11 décembre 2000. En recadrant ainsi le débat, le juge des référés de Garoua a fort opportunément retenu sa compétence.

Mais, il faut le reconnaître, le juge avait la tâche aisée du moment où la saisie était viciée. Qu'aurait-il décidé si la saisie avait été régulièrement pratiquée? La question peut être examinée sous une double détente : un comité irrégulièrement constitué peut-il procéder à une saisie valable? Par ailleurs, même régulièrement constitué, le Comité provincial et partant le Comité national lui-même ont-ils qualité pour saisir des œuvres contrefaites? L'intérêt principal de ce débat vient de ce que plusieurs pays africains ont créé des comités similaires. Tel est le cas du Bénin¹⁰⁹ et de la Côte d'Ivoire¹¹⁰.

Pour le cas du Cameroun et des pays où aucune précision n'a été faite sur ce point, les deux détentes ci-dessus rappellent un débat ouvert en France à propos des œuvres collectives, eu égard au droit d'agir des titulaires de droits sur de telles œuvres. En effet, la composition irrégulière du comité l'affecte d'un vice originel qui devrait impacter toutes ses actions, de même que pour le titulaire de droits sur une œuvre collective, l'impossibilité de prouver que les contributeurs lui ont cédé leur droit affectent sa titularité d'un vice de même nature. Cherchant donc à profiter de ce vice, il arrivait aux contrefacteurs de tenter de se réfugier derrière l'absence de cession des droits à l'ensemblier qui exploite l'œuvre collective, pour échapper à toute responsabilité. Ainsi par exemple, dans une affaire bien connue, la preuve de la cession des droits à la personne morale qui exploitait l'œuvre et qui était demanderesse à l'action en contrefaçon avait été soulevée comme moyen de défense et avait prospéré devant une cour d'appel qui avait estimé que la société demanderesse n'avait pas justifié avoir bénéficié d'une cession des droits. À cette juridiction, la Cour de cassation française a répondu "qu'en l'absence de revendication du ou des auteurs, l'exploitation de l'œuvre par une personne morale sous son nom fait présumer, à l'égard des tiers recherchés pour contrefaçon, que cette personne est titulaire,

108 Voir pour une application de cette règle en matière de marque : CA Lomé, Arrêt n° 70/15 du 4 mars 2015, *Gnanhoue Nazaire c. Établissements Sola* (obs. LAMOTTE (M.)), ce recueil, chapitre 3, section I).

109 Décret n° 2005-187 du 14 avril 2005, portant création, attributions et fonctionnement de la Commission nationale de lutte contre la piraterie des œuvres littéraires et artistiques.

110 Décret n° 2014-420 du 9 juillet 2014 fixant les attributions, l'organisation et le fonctionnement du Comité national de lutte contre la contrefaçon. Mais il serait sans grand enjeu si la loi a elle-même pris le soin de lui conférer spécialement la qualité pour agir (c'est le cas de la Commission béninoise). Cf. art. 5 du Décret n° 2005/187 du 14 avril 2005 portant création, attributions et fonctionnement de la Commission nationale de lutte contre la piraterie des œuvres littéraires et artistiques.

sur l'œuvre qu'elle soit collective ou non, du droit de propriété incorporelle de l'auteur¹¹¹.

Cette jurisprudence qui établit ce qui est désormais connu comme étant une présomption de titularité liée à l'exploitation est critiquable à maints égards¹¹². De fait, si l'on devait demeurer dans la pureté des principes, la société défenderesse devait rapporter la preuve de sa qualité de cessionnaire des droits, de laquelle devait découler sa qualité à agir en contrefaçon. Ces exigences, a estimé la Cour de cassation, alourdissent la procédure et font le jeu des contrefaçonners. Cette orientation de la jurisprudence française se justifie uniquement par un renforcement de la lutte contre la contrefaçon. Elle peut inspirer le débat qui s'ouvrirait éventuellement autour de la régularité de la composition du Comité camerounais de lutte contre la contrefaçon, dans le même cadre étroit : peu importe qu'il soit constitué conformément à la loi ou non, l'infraction a été commise et doit être sanctionnée. Cette solution qui n'est guère satisfaisante pour l'esprit est parfaitement défendable car, s'il est normal que le tiers contrefacteur critique la réalité de la contrefaçon, une critique portant sur la composition de l'organe qui a enclenché la répression apparaîtrait bien comme un artifice de procédure.

Le même raisonnement semble devoir être avancé par rapport à la qualité pour agir du Comité national et de ses excroissances, les Comités provinciaux. De fait, un contrefacteur saisi pourrait arguer du défaut de qualité de l'un de ces comités. D'un point de vue strictement juridique, cette critique pourrait prospérer. En effet, d'une part, la loi camerounaise sur le droit d'auteur limite les personnes pouvant agir pour la défense des droits d'auteur. Il s'agit naturellement des auteurs eux-mêmes, des titulaires de droits voisins, leurs ayants droit ou ayants cause, ainsi que les organisations de gestion collective¹¹³. D'autre part, l'article 2 de la décision ministérielle créant le Comité national du Cameroun dispose que celui-ci a pour mission "de mener toutes actions tendant à faciliter la lutte contre les atteintes aux droits d'auteur et aux droits voisins, y compris les actions de sensibilisation, d'information et de formation". Il en résulte que la décision n'a apparemment pas voulu conférer aux Comités de lutte contre la contrefaçon le pouvoir de saisir.

Même en changeant de terrain de raisonnement parce que les agissements litigieux constituent une infraction pénale, l'action des comités ne devrait pas être plus conforme à la loi. De fait, l'initiative de l'action publique n'appartient qu'au Ministère public, à la victime et à certaines administrations. Dans ce contexte, les saisies pratiquées d'autorité par les comités en cause devraient toujours être exposées à la nullité. Ceux-ci devraient tout au plus agir comme organes de dénonciation auprès des titulaires de droits

ou se faire consentir mandat d'agir au nom et pour le compte de ces titulaires et/ou de leurs organisations de gestion collective. La présence des représentants de ces sociétés dans les comités ne change rien à cette situation. Ces représentants légitiment son action, mais, d'un point de vue juridique, l'organe n'est pas pour autant investi du droit de saisir sans transiter par une personne habilitée par la loi.

Cependant, la contrefaçon est une infraction essentiellement fugace et les produits qu'elle permet d'écouler en cas de reproduction illicite se caractérisent par leur ubiquité. Dès lors, il n'y a pas de temps à perdre lorsque de tels produits sont localisés. Dans de telles conditions, il paraît normal de permettre à un comité spécial créé par l'État de contribuer à réprimer cette infraction, au besoin en procédant à des saisies. L'efficacité de la lutte contre ce fléau est au prix de l'acceptation de solutions qui ne sont pas forcément satisfaisantes pour l'esprit.

Qu'importe en fin de compte au contrefacteur que la saisie soit pratiquée ou non par une personne qui selon lui n'aurait pas qualité pour saisir si la contrefaçon est avérée et si le déroulement de la saisie a préservé ses droits... Car "peu importe que le chat soit gris ou noir, pourvu qu'il attrape la souris" (*DENG XIAO PING*).

Joseph Fometeu

N. Droit d'auteur – Action en contrefaçon – Obligation pour les juges du fond de motiver explicitement la condamnation – Défaut de réponse aux conclusions alléguant une atteinte au droit à la paternité

La cession des droits d'auteur ne prive pas l'auteur du droit d'être identifié, soit de faire mention de son nom sur tout support de communication au public utilisé par le cessionnaire et il appartient au juge du fond de spécifier dans leurs motifs si le bénéficiaire de la cession a respecté ce principe.

Cour de cassation du Niger, Chambre civile et commerciale, Arrêt du 21 avril 2015, n° 15-040/CIV, SONITEL c. AGENCE KYBIA (préc.)

Observations :

L'arrêt rendu par la Cour de cassation du Niger le 21 avril 2015, déjà commenté plus haut sous l'angle de l'originalité, appelle aussi des observations, et des observations critiques cette fois, sous l'angle de la cession des droits.

Faits : Rappelons que la société SONITEL avait été condamnée par la cour d'appel de Niamey pour avoir utilisé dans le cadre d'une campagne publicitaire une photographie qui lui avait été fournie par l'agence Iman, photographie dont les droits appartenaient à l'agence Kybia.

111 Cass. civ., 1^{re} chambre, 22 février 2000, cité par SIRINELLI (P.), Les bénéficiaires initiaux du droit d'auteur : règles générales, Paris (Lamy, droit des médias et de la communication), étude 118, n° 118-97.

112 Voir sur l'ensemble de la question : LUCAS (A.), LUCAS-SCHLOETTER (A.) et BERNAULT (C.), n.36, n° 1193 et s.

113 Cf. notamment art. 85 al.1.

Dans un second moyen, la SONITEL reprochait à l'arrêt attaqué d'avoir retenu sa responsabilité "pour violation des droits patrimoniaux d'autrui (*sic; sans doute faut-il lire "d'auteur"*), alors que, par application de l'article 31 de l'ordonnance n° 93-27 du 30 mars 1993 sur le droit d'auteur, les droits voisins et le folklore, elle était devenue cessionnaire des droits d'auteur sur la photographie réalisée par l'agence Kybia dont elle avait réglé les factures correspondantes, en sorte qu'elle était fondée à faire de ladite photographie "un usage conforme suivant ses moyens habituels de marketing".

L'agence Kybia, en réponse, invoquait le droit moral garanti par l'article 8 de l'ordonnance précitée et soutenait que nul ne pouvait "lui dénier le droit de revendiquer la paternité de son œuvre que l'agence IMAN a communiquée au grand public à la demande de la SONITEL sans faire référence sur l'affiche, à l'auteur de la photographie ainsi reproduite qu'elle était".

Raisonnement : C'est ce raisonnement de la cour d'appel que va reprendre à son compte la Cour de cassation. Après avoir affirmé que "si le principe de cession des droits d'auteur est admis, il ne doit cependant pas priver l'auteur de faire continuellement référence à lui par la mention de son nom sur tout support de communication au public utilisé par le bénéficiaire", elle constate que les juges du fond n'ont pas spécifié dans leurs motifs "que la SONITEL, par l'agence IMAN interposée, a respecté ce principe ou non", où elle voit une violation de l'article 31 de l'ordonnance de 1993.

Le raisonnement suscite la perplexité. Outre qu'il ne tient pas compte du fait que le droit moral, par principe, ne peut être attaché qu'à l'auteur personne physique, lequel n'était pas à la cause, il semble méconnaître les données du litige telles que le commentateur est fondé à les reconstituer. Si l'agence Kybia avait effectivement invoqué une violation de son droit à la paternité et si la cour d'appel de Niamey ne s'était pas prononcée sur ce point, la situation caractérisait un défaut de réponse aux conclusions méconnaissant l'obligation de motivation et justifiant donc la censure. Force, cependant, est de constater que la question n'était pas agitée dans le pourvoi tel qu'il est présenté par l'arrêt commenté. Le moyen de cassation, en effet, ne portait, ce que semble oublier la Cour de cassation du Niger, que sur la violation des droits patrimoniaux, constatée par la cour d'appel de Niamey et contestée par la SONITEL. La Cour de cassation ne répond pas sur ce point, sauf pour relever de manière laconique que "le principe de cession des droits d'auteur est admis", proposition évidemment trop générale pour qu'on puisse en tirer une quelconque conséquence. Or il lui appartenait, pour faire droit au moyen ou pour le rejeter, de prendre parti clairement là-dessus.

Pour ce faire, il fallait d'abord s'entendre sur le texte applicable. La censure est prononcée, nous l'avons dit, pour violation de l'article 31 de l'ordonnance n° 93-27 du 30 mars de 1993. Il s'agit d'une erreur manifeste. En effet, cet article 31 ne correspond pas du tout au texte transcrit par la cour elle-même en ces termes :

"lorsque l'œuvre est créée pour le compte d'une personne physique ou d'une personne morale, privée ou publique, dans le cadre d'un contrat de travail de l'auteur ou bien lorsque l'œuvre est commandée par une telle personne à l'auteur, le premier titulaire des droits patrimoniaux et moraux est l'auteur, mais les droits patrimoniaux sur cette œuvre sont considérés comme transférés".

Or l'article 31 de l'ordonnance ne traite, comme l'indique son intitulé, que du "titulaire des droits sur les œuvres créées dans le cadre d'un contrat de travail" et il est ainsi libellé :

"Dans le cas d'une œuvre créée par un auteur pour le compte d'une personne physique ou morale (ci-après dénommée "l'employeur") dans le cadre d'un contrat de travail et de son emploi, sauf disposition contraire du contrat, le premier titulaire des droits moraux et patrimoniaux est l'auteur mais les droits patrimoniaux sur cette œuvre sont considérés avoir été transférés à l'employeur dans la mesure justifiée par les activités habituelles de l'employeur au moment de la création de l'œuvre".

En réalité, le texte rapporté correspond mot pour mot au début de l'article 31 de l'annexe VII l'ABR-1999 (reprise par l'article 35.2 dans l'ABR-2015). Au début seulement, car dans l'Accord de Bangui, le texte continue en précisant que les droits "sont considérés comme transférés à l'employeur (*dans une rédaction plus rigoureuse, l'article 35.2 de l'Accord de Bamako respecte la symétrie en ajoutant "ou à cette personne physique ou morale"*) dans la mesure justifiée par les activités habituelles de l'employeur ou de cette personne physique ou morale au moment de la création de l'œuvre". Il revenait donc à la Cour de cassation de contrôler la motivation des juges du fond pour déterminer si les conditions du transfert des droits patrimoniaux énoncées par ce texte étaient réunies.

Encore était-il possible de compliquer l'analyse en posant la question de savoir si le législateur nigérien, qui ne visait que le cas des salariés, renvoyant ainsi au droit commun le cas de l'œuvre de commande, n'offrait pas aux auteurs concernés un meilleur niveau de protection, ce qui aurait pu justifier l'éviction de la disposition de l'Accord de Bangui au profit de la loi nationale. Cela aurait conduit au rejet du moyen.

On le voit, il y avait vraiment matière à discussion, et l'on peut regretter que l'occasion n'ait pas été saisie.

André Lucas

O. Paiement de la redevance du droit d'auteur – Usage effectif des œuvres – Condition d'assujettissement – Capacité de diffusion des œuvres

La représentation ou l'exécution publique de certaines œuvres de l'esprit faisant prétendument partie du répertoire d'une organisation de gestion collective du droit d'auteur est assujettie au paiement des redevances par les utilisateurs dans les conditions fixées par voie réglementaire.

Selon la juridiction régulatrice, une société de téléphonie mobile, en l'espèce la SONITEL, est assujettie au paiement de ladite redevance sans qu'il soit besoin d'établir préalablement qu'elle utilise effectivement les œuvres concernées, le défaut de paiement étant constitutif de la contrefaçon.

Cour d'État du Niger, Arrêt n° 11-250-civ du 1^{er} décembre 2011, SONITEL c. BNDA

Observations :

Les modes contemporains d'exploitation des œuvres de l'esprit sont assez diversifiés, associant câble, satellite et surtout Internet. La représentation publique se définit comme l'"exhibition au public" d'une œuvre, ou mieux le fait de porter l'œuvre à sa connaissance par son exécution : jouer la pièce, la symphonie, réciter le poème¹¹⁴. Quelle qu'en soit leur nature, ces divers moyens d'exhibition du fruit du travail des auteurs permettent à ces derniers de contrôler l'exploitation de leurs œuvres et leur permettre ainsi de vivre de leurs créations. Aussi, il devient donc impérieux, sinon indispensable, de soumettre chacune de ces formes de représentation au monopole de l'auteur dont l'autorisation sera préalablement requise avant l'usage de sa création. Telle est en toile de fond la substance de l'arrêt rendu par la Cour d'État du Niger en date du 1^{er} décembre 2011 dans l'espèce opposant la Société nigérienne de télécommunication (SONITEL) au Bureau nigérien du droit d'auteur (BNDA).

Faits : À l'orée de la discorde, le BNDA, organisme public en charge de la gestion collective des droits d'auteur au Niger, avait, par acte extrajudiciaire servi le 22 août 2001, sommé la SONITEL d'avoir à payer entre ses mains la somme de FCFA 540 000 000 représentant la redevance du droit d'auteur due par cette dernière pour la représentation ou exécution publique de certaines œuvres de l'esprit, faisant prétendument partie du répertoire de l'organisme de gestion collective.

Suite à la réponse traduisant le refus par la SONITEL de régler spontanément les sommes réclamées, le BNDA va introduire une action en paiement devant le tribunal régional de Niamey.

Débouté par jugement n° 181 du 28 mars 2003 du fait de son incapacité à prouver que la SONITEL faisait usage des œuvres de son répertoire, le BNDA va interjeter

appel devant la cour d'appel de Niamey. Vidant son délibéré par l'arrêt n° 140/04 du 21 juin 2004 qui a infirmé le jugement n° 181 du 28 mars 2003 du tribunal régional de Niamey, la cour d'appel de Niamey fera droit aux prétentions du BNDA, condamnant la SONITEL au paiement de la redevance. Selon la cour, la lecture conjonctive de l'ordonnance 93-27 du 30 mars 1993 et de l'arrêt n° 157/MCI/MCC du 14 octobre 1997 ne fait pas de l'usage effectif des œuvres une condition déterminante pour assujettir les réseaux téléphoniques au paiement de la redevance due au titre du droit d'auteur.

Sur le fondement de cet argumentaire, la SONITEL va à son tour se pourvoir en cassation devant la Cour d'État du Niger, jouant le rôle de Cour de cassation pendant la période de transition militaire au Niger¹¹⁵.

Raisonnement : Aux juges de l'illustre cour, il revenait de se prononcer sur la question de savoir si l'usage effectif des œuvres protégées est la condition *sine qua non* du paiement de la redevance. La réponse du juge sonne comme une remise en cause des piliers de base du droit d'auteur.

En décidant de soumettre SONITEL au paiement de redevances de droits d'auteur (section II), le tribunal apporte des précisions sur les éléments constitutifs de la représentation (section I).

I. Les éléments constitutifs de l'exécution publique des œuvres

Aux termes de l'article 1^{er} de l'ordonnance 93-027 du 30 mars 1993 portant sur le droit d'auteur, les droits voisins et les expressions de folklore, notamment son alinéa V : "La communication d'une œuvre (...) au public est le fait de rendre l'œuvre accessible au public...".

De la lettre de cette disposition, on peut déceler deux types d'éléments constitutifs de l'activité de représentation publique. Bien que l'usage effectif de l'œuvre soit fortement sous-entendu dans ce texte, la haute juridiction en fait un élément facultatif (1). Par contre, deux éléments sont obligatoires (2), au sens de la cour, pour caractériser l'activité d'exhibition publique : c'est la mise à disposition de l'œuvre d'une part, et l'existence d'un public éventuel d'autre part.

A. L'élément facultatif : l'usage d'une œuvre

Bien que le terme usage ne transparaisse pas explicitement de la lettre de l'ordonnance du 30 mars 1993, il n'en demeure pas moins que c'est une condition déterminante pour caractériser la représentation ou exécution publique des œuvres. L'exégèse de l'ordonnance visée au pourvoi est pourtant sans appel lorsque ce texte dispose que la communication est "le fait de rendre l'œuvre accessible au public...".

115 Voir Ordonnance n° 2010-16 du 15 avril 2010 sur l'organisation, les attributions et le fonctionnement de la Cour d'État.

114 GAUTIER (P.-Y.), n.67, p. 32.

Plus illustratif encore, l'intitulé de l'arrêté n° 157/MCI/MCC du 14 octobre 1997 portant ordre tarifaire relatif au droit d'auteur, aux droits voisins et expressions de folklore. L'article 1^{er} de ce texte réglementaire fixe littéralement les tarifs s'appliquant aux usagers ou clients, utilisateurs des œuvres littéraires et artistiques. Par son intitulé, on comprend bien que l'usage des œuvres est un facteur déterminant pour l'assujettissement au paiement de la redevance.

Cette lecture unitaire de l'ordonnance de 1993 est fidèle aux mécanismes juridiques qui encadrent le droit d'auteur. En autorisant les actes d'exploitation de ses œuvres par les tiers, l'auteur devrait vivre de son art. Les revenus engrangés par ce dernier ne peuvent nécessairement que provenir de l'exploitation contrôlée de ses œuvres, c'est-à-dire de leur usage effectif par les tiers consommateurs du fruit de son esprit.

Malheureusement, c'est ce postulat qui est battu en brèche par la Cour d'État du Niger lorsqu'elle fait de l'usage effectif des œuvres un critère facultatif. Selon la haute juridiction, le débat sur l'usage effectif est rendu redondant par l'instauration d'un plan tarifaire s'appliquant au demandeur au pourvoi classé dans la catégorie "réseaux téléphoniques" des tarifs B8. L'ordonnance 93-27 du 30 mars 1993, prétend la cour, rend inutile le débat sur la question de savoir si la SONITEL diffuse ou non des œuvres artistiques.

Cette position est regrettable et rompt avec les préceptes classiques du droit de la propriété littéraire et artistique. Quid des éléments obligatoires pour caractériser l'activité d'exécution des œuvres?

B. Les éléments obligatoires : une capacité de mettre l'œuvre à la disposition du public

L'ordonnance de 1993 nous donne, à sa seule lecture, les éléments qui caractérisent matériellement l'activité de représentation publique des œuvres. En analysant ce texte, on retient qu'il faut, d'une part, une mise à disposition d'une œuvre et d'autre part, l'existence d'un public éventuel.

En ce qui concerne la nécessaire mise à disposition d'une œuvre, il doit s'agir d'une exhibition de la création, entendue au sens de sa communication au public. Cet élément ne pose sans doute pas beaucoup de difficultés dans la pratique. Néanmoins, la cour semble entretenir l'amalgame quant à son contenu matériel, jugeant dans le cas d'espèce que la capacité de diffusion de l'œuvre par le demandeur au pourvoi suffirait amplement pour qu'il y ait communication et assujettir, *in fine*, ce dernier au paiement de la redevance.

Ensuite, l'ordonnance de 1993 insiste sur l'existence d'un potentiel public à qui l'œuvre devra être communiquée. En effet, la représentation ne donne prise au monopole bénéficiant à l'auteur que si l'œuvre est communiquée au public¹¹⁶. Au sens large, le public s'appréhende par opposition au concept de "cercle de famille". De façon

triviale, il s'agit d'un ensemble de personnes (qui ne sont pas en clientèle avec celui qui met à disposition l'œuvre), qui se retrouve dans un même temps et en un même lieu pour entrer au contact de l'œuvre¹¹⁷. Toutefois, il faut relever que cette définition traditionnelle est loin de correspondre aux nouvelles réalités technologiques de communication des œuvres. Aussi, rompant avec l'unité de lieu et de temps, la jurisprudence a adapté la définition aux exigences de la télédiffusion des œuvres dans plusieurs chambres d'hôtel, pour ce qui est de l'unité de lieu, et leur transmission numérique à la demande, pour ce qui est de l'unité de temps.

Que l'œuvre atteigne ou non son public, elle doit être à sa disposition à telle enseigne que le public puisse y avoir accès, faute de quoi on ne saurait envisager une communication. Sur cette question de la réception effective de l'œuvre par le public, on a vu la réponse de la cour interprétant les dispositions de l'alinéa 2 de l'article 1^{er} de l'ordonnance du 30 mars 1993 qui prévoit que : "Tout procédé qui est nécessaire pour rendre l'œuvre accessible au public, et qui le permet, est une communication, et l'œuvre est considérée comme 'communiquée' même si personne dans le public auquel l'œuvre est destinée ne la reçoit, ne la voit ni ne l'écoute effectivement".

Pour la cour, ce texte fait de la réception effective de l'œuvre par le public une simple faculté. Le plus important est que la communication puisse atteindre le public concerné. On parle ici du droit de mise à disposition au public qui relève du monopole de l'auteur. Illustrant sa position, la cour affirme que "l'usage effectif est réalisé par la seule capacité de la structure considérée à rendre ladite œuvre accessible au public, par la possession et la mise en œuvre d'un dispositif technique approprié; que la circonstance que personne ne l'a reçue, ne l'a vue ou ne l'a écoutée effectivement importe peu".

II. L'assujettissement au paiement de la redevance

Cet assujettissement du demandeur au pourvoi au paiement de la redevance sanctionne la communication non autorisée des œuvres par le demandeur au pourvoi. Concrètement, le juge suprême réitère les condamnations pécuniaires contre la SONITEL (A), sans se soucier des incohérences générées par sa décision (B).

A. Les condamnations pécuniaires de la SONITEL

En substance, il s'agit de la confirmation de la sanction du juge d'appel, condamnant la demanderesse au paiement de la redevance due au titre du droit d'auteur d'une part, et l'allocation des dommages et intérêts au BNDA, défenderesse au pourvoi d'autre part.

En réalité, la redevance n'est qu'une rémunération versée périodiquement, par l'utilisateur qui exploite une œuvre de l'esprit. En principe, cette rémunération correspondrait à un prorata prélevé sur les recettes générées par l'exploitation économique de l'œuvre. Toutefois, il convient de relever que dans la pratique, il est très

116 VIVANT (M.) et BRUGUIÈRE (J.-M.), n.22, p. 34

117 *Ibid.*, p. 343.

souvent difficile, voire impossible, de déterminer la base de calcul de la contribution forfaitaire des usagers d'œuvres. Par conséquent, la rémunération est souvent fixée de manière forfaitaire par un acte réglementaire.

Dans le cas d'espèce, le Bureau nigérien des droits d'auteurs (BNDA) était chargé de la perception, au plan national, des droits d'auteurs échus aux membres de son répertoire. L'arrêté visé au moyen fixait cette redevance au montant annuel de 30 000 F par réseau, pour les fournisseurs de réseaux téléphoniques. La SONITEL disposait, comme cela transparaissait des débats, de deux réseaux téléphoniques sur toute l'étendue du territoire nigérien. C'est donc en conséquence de cause qu'elle fut condamnée au paiement de la somme de FCFA 180 000, correspondant aux redevances dues dans les années 1999, 2000 et 2001.

Au surplus, comme pour être logique avec elle-même, l'auguste juridiction va reconduire la condamnation aux dommages et intérêts prononcée précédemment par la cour d'appel. Ainsi, pour avoir causé à la défenderesse au pourvoi un préjudice résultant de sa résistance abusive à s'acquitter des redevances dues, la SONITEL sera en outre condamnée à payer la somme de FCFA 500 000 à titre de dommages et intérêts.

B. Les critiques à la condamnation du juge suprême

À l'analyse, la décision des juges suprêmes recèle au moins deux incohérences. Avant tout, elle tend à dévoyer la logique rémunératrice qui sous-tend la philosophie même de la redevance, encore perçue comme contrepartie à l'exploitation d'un droit, en se contentant d'instituer une présomption d'usage des œuvres protégées, en lieu et place de leur "usage effectif" par l'utilisateur. Comme si cela ne suffisait pas, la cour force une conception erronée de la rémunération accordée au titulaire du droit comme une forme d'impôt plutôt que de simples redevances.

En effet, il est difficile de rester insensible dans la démarche qu'a choisi le juge suprême qui, voulant motiver la condamnation de la SONITEL, a déduit de sa simple capacité à diffuser les œuvres querellées la principale raison valable du paiement de la redevance par cette dernière, indifféremment de l'exploitation effective des objets protégés. Pourtant, autant dans l'esprit que dans la lettre des textes sur lesquels la cour s'appuie, l'usage ou exploitation effective des œuvres est le fait générateur de la redevance. Le paiement de la redevance n'est que la contrepartie à la consommation du fruit de l'effort intellectuel de l'auteur. L'usage de l'œuvre est un fait juridique, et non une simple vue de l'esprit.

La demanderesse au pourvoi s'ingéniait à le démontrer à la cour, en demandant au BNDA d'apporter la preuve du fait qu'elle communiquait les œuvres protégées au public. Malheureusement pour elle, l'auguste juridiction va balayer son argumentaire d'un revers de la main, en lui opposant l'arrêté n° 157/MCI/MCC du 14 octobre 1997 qui astreint les réseaux de communications au paiement de la redevance. En un mot, à partir du moment où l'activité de l'utilisateur est répertoriée dans cet acte

réglementaire, ce dernier est tenu à la redevance, indifféremment du fait qu'il consomme les œuvres protégées ou pas.

En faisant de l'usage des œuvres une simple faculté, la cour a créé une présomption d'usage au préjudice de ceux qui mobilisent les moyens techniques les mettant en capacité de rendre accessible au public les œuvres de l'esprit. Cette interprétation des textes visés au moyen est lourde de conséquences sur le plan juridique et conduirait au prélèvement des redevances indues.

Par ailleurs, la Cour suprême finit par dénaturer la redevance du droit d'auteur en la transformant en une sorte de prélèvement obligatoire. En droit privé, une redevance est un montant régulier payé au bénéficiaire par l'utilisateur d'un droit de propriété intellectuelle (droit d'auteur, brevet, marque etc.) en contrepartie de l'utilisation de celui-ci. Emprunté de l'anglicisme *royalty*, le paiement de la redevance est conditionné par l'usage du droit dévolu au propriétaire, ce qui dans un contrat synallagmatique ferait de l'exploitation de l'œuvre la cause de ce paiement. C'est en cela même que la redevance se distingue d'une taxe ou d'un impôt, qui sont des formes de prélèvement obligatoires effectués auprès du débiteur sans qu'il n'y ait lieu à une quelconque contrepartie.

Dans ses mémoires, la société SONITEL n'a pourtant cessé de le marteler à cor et à cri, et ce sans succès.

Aristide Fade

P. Procédure – Droit d'auteur – Saisie-contrefaçon – Assignation au fond – Demandeur débouté – Indemnisation du préjudice causé par la saisie

Le demandeur qui est débouté de son action en contrefaçon après avoir été autorisé judiciairement à pratiquer une saisie réelle doit indemniser le saisi des conséquences dommageables de cette saisie.

Tribunal de commerce d'Abidjan, jugement du 2 juillet 2015, n° 1412/15, SOCIÉTÉ ZENITH-PLASTICS CÔTE D'IVOIRE (ZPCI) c. SOCIÉTÉ INDUSTRIELLE DE FABRICATION DE PLASTIQUE EN CÔTE D'IVOIRE (SIFPLAST-CI)

Observations :

Le tribunal de commerce d'Abidjan apporte une réponse convaincante à la question de savoir quelles suites doivent être données lorsque le demandeur en contrefaçon succombe après avoir été autorisé judiciairement à pratiquer une saisie. Il s'agit en l'espèce de dessins et modèles mais les enseignements livrés par le jugement valent de manière générale pour tous les droits de propriété intellectuelle.

Faits : Les faits sont d'une grande banalité. La société ZENITH-PLASTICS Côte d'Ivoire (ci-après ZPCI), spécialisée dans la fabrication et la commercialisation

de matière plastique, a mis au point un modèle de chaussure intitulé Modèle 838 qu'elle a enregistré en 2000 à l'OAPI. Elle l'a fabriqué et commercialisé jusqu'en 2009. En décembre de cette année, la société SIFPAST-CI, qui a pour objet social la fabrication de chaussures en plastique, estimant que le Modèle 838 était la contrefaçon de son modèle SUPER 13 et SUPER 14, enregistré à l'OAPI en 1996 (enregistrement renouvelé en 2003 et en 2008), a saisi sur le marché tous les stocks de chaussures du Modèle 838 entre les mains des clients (le jugement ne dit pas dans quelles conditions cette saisie a eu lieu), puis s'est fait autoriser par le président du tribunal de première instance de Yopougon à pratiquer dans les locaux de la société ZPCI, le 5 janvier 2010, la saisie de tout le matériel de fabrication, du stock de matières et du stock de chaussures Modèle 838, avant d'assigner ZPCI en contrefaçon, en concurrence déloyale et en paiement de la somme de 738 millions de francs CFA à titre de dommages et intérêts.

Elle a obtenu gain de cause devant le tribunal de première instance de Yopougon, dont la décision a été confirmée par la cour d'appel d'Abidjan. Mais l'issue ne lui pas été aussi favorable puisque cet arrêt confirmatif a été cassé le 7 juin 2012 par la Chambre judiciaire de la Cour suprême, laquelle a ordonné la mainlevée de toutes les saisies pratiquées par la société SIFPLAST-CI au préjudice de la société ZPCI et la restitution de tous les biens matériels et de toutes les marchandises sous astreinte de 5 millions de francs CFA par jour de retard à compter de la signification de la décision.

Considérant que la saisie-contrefaçon de 2010 a entraîné la paralysie de toute son activité tout au long de ces péripéties judiciaires, la société ZPCI entend demander réparation de son préjudice. Elle obtient du président du tribunal de commerce d'Abidjan la désignation d'un expert (par ordonnance confirmée par la cour d'appel d'Abidjan), qui évalue son préjudice matériel, commercial et financier à la somme de FCFA 870 536 049. Elle assigne en 2015 la société SIFPLAST-CI pour lui réclamer cette somme, en réparation de la "saisie irrégulière", ainsi que la liquidation de l'astreinte à hauteur de FCFA 335 000 000. La société défenderesse conteste cette demande en faisant valoir qu'elle n'a fait, en pratiquant la saisie querellée, qu'exécuter une décision de justice.

Raisonnement : Le problème est bien connu mais la solution ne coule pas de source. La difficulté ne concerne pas les conséquences d'une éventuelle responsabilité. Il suffit à cet égard de renvoyer au droit commun, qui n'appelle pas ici de commentaire, pour évaluer le préjudice indemnisable. C'est ce que fait le tribunal en homologuant le rapport d'expertise malgré les critiques de la société défenderesse¹¹⁸.

118 C'est également par application du droit commun que le jugement liquide l'astreinte. Rappelant que cette liquidation n'est pas une simple opération arithmétique consistant à multiplier le nombre de jours de résistance par le montant de l'astreinte, il la réduit, en tenant compte des circonstances de la cause, à la somme de FCFA 200 000 000.

Reste une double interrogation portant :

- I. sur le principe même; et surtout
- II. sur les conditions d'une telle responsabilité.

I. Le principe de la responsabilité du saisissant débouté de son action en contrefaçon

La société défenderesse remettait purement et simplement en cause le principe même de sa responsabilité. Pour elle, elle n'avait commis aucune "voie de fait" et admettre que l'exécution régulière d'une décision de justice puisse être source de responsabilité reviendrait à "engager la responsabilité de l'État qui emploie des magistrats qui rendent les décisions de justice".

Elle n'est pas suivie par le tribunal. Celui-ci reconnaît qu'elle avait certes "le droit de procéder à une saisie-contrefaçon", mais qu'elle n'en est pas moins tenue de réparer le préjudice éventuellement subi par la société saisie. Et d'appeler à la rescousse l'ABR-1999, qui, en permettant "au juge d'imposer un cautionnement au requérant d'une saisie-contrefaçon en matière de propriété industrielle destiné justement à la réparation du préjudice pouvant résulter de ladite saisie", montre que "le principe de la réparation du tiers lésé par la saisie-contrefaçon est bien inclus dans le droit de la propriété intellectuelle". La conclusion, dès lors, s'impose : "Il est donc vain pour la défenderesse de brandir les décisions de justice pour s'exonérer de toute responsabilité".

Le raisonnement mérite en tous points d'être approuvé. L'idée que l'exécution d'une décision de justice ne peut être source de responsabilité n'est pas admissible. De ce point de vue, le tribunal a raison de tirer parti de l'Accord de Bangui et plus précisément, pour ce qui concerne les dessins et modèles industriels, de l'article 33, alinéa 3, de l'annexe IV. Il est intéressant de noter, d'un point de vue historique, que la première loi française sur les brevets d'invention, en 1791, qui a institué la saisie-contrefaçon, prévoyait expressément l'indemnisation de la partie saisie¹¹⁹.

On peut rapprocher de cette situation celle dans laquelle un plaideur exécute un jugement frappé d'appel mais revêtu de l'exécution provisoire. Personne ne conteste qu'en cas d'infirmité de la décision, il doit réparer le préjudice qui a pu être causé par cette exécution. En France, la Cour de cassation statuant en assemblée plénière a énoncé clairement la solution, dont la portée est d'autant plus grande qu'en l'espèce, la décision attaquée avait été spontanément exécutée par la partie perdante¹²⁰.

119 STENGER (J.-P.), Saisie-contrefaçon – Recours après saisie-contrefaçon : Juriscl. Brevets, Fasc. 4634, 2006, n° 130.

120 Cass. ass. plén., 24 février 2006, n° 05-12.679 : JurisData n° 2006-032415 et D. 2006, p. 1085 (note PERROT (R.)).

II. Les conditions de la responsabilité du saisissant débouté de son action en contrefaçon

Les difficultés se concentrent sur la nature de la responsabilité encourue et donc sur les conditions de sa mise en œuvre.

Sur ce point, il faut reconnaître que le jugement commenté n'est pas exempt d'ambiguïté. En effet, il commence par affirmer que l'obligation de réparer le préjudice résulte du principe général de la responsabilité civile délictuelle prescrite par l'article 1382 du Code civil qui dispose que "Tout fait quelconque de l'homme qui cause à autrui un dommage oblige celui par la faute duquel il est arrivé à le réparer", mais c'est pour ajouter immédiatement qu'en matière de propriété intellectuelle "la saisie-contrefaçon est toujours effectuée aux risques du saisissant qui doit indemniser le tiers lésé, s'il se révèle ultérieurement qu'il n'y a pas eu, comme il l'avait prétendu, atteinte au droit intellectuel". Or ces deux propositions ne sont pas conciliables. La première renvoie à une responsabilité pour faute, la seconde à une responsabilité sans faute.

La thèse selon laquelle la responsabilité du saisissant n'est engagée qu'en cas de faute prouvée de sa part ne défie pas la logique. Concrètement, elle signifie que le demandeur en contrefaçon qui a échoué n'est responsable des conséquences de la saisie qu'il a pratiquée avant le jugement sur le fond que si cette saisie a été effectuée dans des conditions révélatrices d'un abus, par exemple avec une publicité destinée à nuire au saisi, ou s'il est établi que le saisissant ne pouvait pas ignorer la fragilité du droit de propriété intellectuelle dont il s'est prévalu.

À l'inverse, il est exonéré si la saisie-contrefaçon s'est déroulée dans des conditions normales ou s'il a pu se méprendre de bonne foi sur l'existence ou la portée de son droit. En France, une partie de la jurisprudence se prononce en ce sens, spécialement en matière de brevets d'invention. Ainsi la Cour de cassation a-t-elle jugé en 1964 que "c'est à bon droit qu'un arrêt rejette une demande en dommages et intérêts pour abus dans l'exécution d'une saisie-contrefaçon de brevet, en repoussant l'argument du demandeur selon lequel l'accomplissement d'une mesure conservatoire, telle que la saisie-contrefaçon, fait peser sur son auteur une véritable responsabilité objective du seul fait qu'elle se révèle injustifiée et préjudiciable, abstraction faite de toute faute"¹²¹.

En l'espèce, cette approche aurait conduit à écarter la demande d'indemnisation. Rien, en effet, dans le jugement ne permet de conforter l'idée d'une saisie abusive, et de ce point de vue, la référence du tribunal aux "saisies irrégulières"¹²² est maladroite car une saisie autorisée par le juge n'est pas en elle-même une saisie

"irrégulière". Par ailleurs, aucun élément n'est avancé qui pourrait accréditer l'idée que la société SIFPLAST-CI était de mauvaise foi et savait que son action était mal fondée.

C'est précisément ce résultat qui est critiquable, ce qui suffit à montrer les défauts de l'analyse. On doit, en effet, se garder d'oublier que la saisie-contrefaçon ne permet d'obtenir que des mesures provisoires, et que plus les mesures en question sont générales, comme c'était le cas en l'espèce¹²³, plus le risque qu'elles font courir est grand. La question est donc bien de savoir qui doit assumer ce risque lorsque l'action au fond n'est pas accueillie. Ainsi posée, elle appelle nécessairement la réponse que donne le jugement commenté lorsqu'il affirme que la saisie-contrefaçon est "toujours effectuée aux risques du saisissant" et qu'il se contente de constater l'absence d'atteinte au droit de propriété intellectuelle revendiqué pour en déduire l'obligation de réparation.

En France, la jurisprudence dominante se prononce en ce sens. Ainsi la Cour de cassation a-t-elle posé le principe que "toute personne qui procède à une saisie-contrefaçon le fait à ses risques et périls et doit dès lors répondre de tous les dommages qui pourraient s'ensuivre"¹²⁴. On notera qu'elle mène le même raisonnement dans l'hypothèse voisine, évoquée ci-dessus, de l'exécution provisoire¹²⁵.

Le tribunal de commerce d'Abidjan, malgré les ambiguïtés relevées ci-dessus, s'inscrit dans ce courant et mérite, à notre avis, d'être approuvé.

André Lucas

Q. Droit d'auteur – Droit international privé – Condition des étrangers – Réciprocité législative opposée à des auteurs étrangers – Convention de Berne – Traitement national

Les auteurs de nationalité étrangère ne peuvent faire valoir leur droit d'auteur au Cameroun qu'en établissant que leur loi nationale accorde aux ressortissants

123 On peut penser que le cantonnement, en pareil cas, est pleinement justifié et donc regretter qu'il n'ait pas été sollicité.

124 Cass. com., 19 octobre 1999, n° 97-12.845. Voir en ce sens STENGER (J.-P.), n.119, n° 130 : "Celui qui use de cette mesure exorbitante et par définition préjudiciable au saisi le fait nécessairement à ses risques dans le cas où elle se révèle injustifiée (...). Par conséquent, dans le cas de la saisie-contrefaçon, si le risque doit être pour le saisi quand on trouve chez lui la preuve d'une contrefaçon, il est en revanche anormal qu'il en soit de même lorsque rien d'illicite n'est constaté", et aussi n° 137 : "Nul n'est forcé de recourir à la saisie-contrefaçon. Mais s'il le fait, il doit en assumer la responsabilité. On ne peut sans compromettre l'institution elle-même se passer d'un équilibre entre le droit du saisissant, qui est exorbitant, et le droit de celui qui a été saisi indûment". – GREFFE (P.), Dessins et modèles, in : JCP E 2000, n° 1280, p. 92 : "Cette jurisprudence doit d'autant plus être approuvée qu'il est constant qu'une saisie est une formalité facultative, elle a un objet essentiellement probatoire, la preuve de l'éventuelle contrefaçon pouvant être apportée par tous moyens".

125 Cass. ass. plén., 24 février 2006, n.148 : "Attendu que l'exécution d'une décision de justice exécutoire à titre provisoire n'a lieu qu'aux risques de celui qui la poursuit". Voir déjà Cass. civ., 1^{re} chambre, 6 juin 1990, in : Bull. civ. 1990, Vol. 1, n° 140 : "même autorisée à titre provisoire, l'exécution d'une décision de justice frappée d'appel n'a lieu qu'aux risques et périls de celui qui la poursuit".

121 Cass. com., 8 juin 1964 : Ann. propr. ind. 1964, p. 254. Voir aussi CA Paris, pôle 5-1, 30 janvier 2013, n° 11/05261 : PIBD 2013, III, n° 982, p. 1132.

122 On ne sait si le pluriel inclut la saisie opérée sur le marché en décembre 2009 ou s'il se rapporte aux seules opérations de saisie pratiquées dans l'entreprise le 5 janvier 2010.

camerounais le même niveau de protection que celui résultant de la loi camerounaise.

Tribunal de première instance de Ngaoundéré, Jugement n° 367/COR du 17 avril 2003, MP et REPAC c. MOHAMADOU AMINOU

Observations:

Le jugement rapporté offre l'occasion de faire le point sur la question de la condition des étrangers en matière de propriété littéraire et artistique. Question cruciale à l'époque de la mondialisation. Question trop souvent confondue, comme on le verra plus loin, avec celle de la loi applicable. Question purement et simplement escamotée, de façon critiquable, par le tribunal de première instance de Ngaoundéré qui prend appui sur une lecture biaisée de la loi camerounaise pour relaxer un prévenu accusé de contrefaçon.

Faits : En l'espèce, des "artistes musiciens", affirmant agir pour le compte du Rassemblement des artistes professionnels et amateurs du Cameroun (RAPAC), avaient fait saisir chez l'intéressé, qui exploitait une discothèque, 2133 cassettes et CD vidéo dépourvus de l'estampille SOCINADA (Société civile nationale des droits d'auteur, organisme de gestion collective opérant à l'époque sur le territoire national). Pour s'opposer aux poursuites, l'avocat plaidait que les supports saisis fixaient des œuvres d'auteurs de "nationalités étrangères" et que l'accusation n'apportait pas la preuve, exigée par la législation camerounaise, que les lois nationales des auteurs en cause assuraient le même niveau de protection que la loi locale aux "chanteurs et musiciens camerounais".

Raisonnement : En faisant droit à cet argument, le tribunal de grande instance de Ngaoundéré méconnaît le principe fondamental du traitement national (section I), sans tenir compte des conditions posées par le droit international conventionnel pour la mise en œuvre d'une très hypothétique réciprocité (section II).

I. Le principe du traitement national

Pour justifier la relaxe, le tribunal invoque la réciprocité prévue par l'article 93.1 de la loi camerounaise du 19 décembre 2000 sur le droit d'auteur, aux termes duquel "les étrangers jouissent au Cameroun du droit d'auteur ou de droits voisins dont ils sont titulaires, sous la condition que la loi de l'État dont ils sont les nationaux ou sur le territoire duquel ils ont leur domicile, leur siège social ou un établissement, protège les droits des Camerounais". Il en déduit que, faute pour le Ministère public et les victimes de justifier que cette condition est remplie par la législation des pays concernés, l'infraction de contrefaçon "ne saurait être caractérisée".

Le raisonnement ne peut emporter la conviction. Il fait, en effet, l'impasse sur l'article 94 de la même loi ainsi rédigé : "Les dispositions de la présente loi relative à la protection des œuvres littéraires et artistiques, aux interprétations, phonogrammes, vidéogrammes et programmes s'appliquent aux œuvres qui ont droit à

la protection en vertu d'un traité international auquel le Cameroun est partie". S'agissant du droit d'auteur, le texte renvoie à la Convention de Berne et plus précisément à son article 5.1, qui prévoit que "les auteurs jouissent, en ce qui concerne les œuvres pour lesquelles ils sont protégés en vertu de la présente Convention, dans les pays de l'Union autres que le pays d'origine de l'œuvre, des droits que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux, ainsi que des droits spécialement accordés par la présente Convention", disposition à laquelle fait écho l'article 5.3 de l'Accord de Bangui, dans sa version issue de l'Acte de Bamako de 2015 ("Les étrangers jouissent des dispositions du présent Accord et de ses annexes dans les mêmes conditions que les nationaux").

Le principe auquel se réfèrent les trois textes cités est celui dit du "traitement national". Il est l'exact contraire de la règle de réciprocité puisqu'il signifie qu'un État "unioniste" (signataire de la Convention de Berne) doit garantir aux ressortissants d'un autre État unioniste (ainsi qu'à tous ceux qui ont leur résidence dans cet État) la jouissance des mêmes droits que ceux dont bénéficient ses propres nationaux, même si ces derniers ne peuvent jouir des mêmes droits dans l'État en question.

C'est une règle qui relève de la condition des étrangers. De la condition des étrangers seulement. De ce point de vue, la formulation de l'article 94 de la loi camerounaise est discutable car, en visant expressément l'application des "dispositions de la présente loi", le législateur risque de donner à penser qu'il énonce une règle de conflit de lois (analyse que l'expression "traitement national" pourrait même conforter). Or les deux questions sont distinctes. Une chose est de savoir si l'étranger peut être privé de la jouissance d'un droit en raison de sa qualité d'étranger, une autre est de savoir quelle loi sera appliquée à la violation de son droit (loi, qui, par hypothèse, n'est pas nécessairement celle du for). Une bonne manière de conjurer le risque de confusion serait d'user d'une terminologie différente en parlant, plutôt que du "traitement national", du principe d'"assimilation des auteurs étrangers aux auteurs nationaux"¹²⁶.

La combinaison des articles 93 et 94 de la loi camerounaise aurait dû dissuader le tribunal de première instance de Ngaoundéré de se risquer à évoquer le "sacro-saint principe de la réciprocité dans les relations internationales". Dès lors que la Convention de Berne peut être mise sur le tapis, le principe, au contraire, est celui du traitement national, la réciprocité n'étant prévue, à l'égard des auteurs unionistes, que dans des cas exceptionnels, par exemple en ce qui concerne le droit de suite¹²⁷. Or la Convention était bel et bien sur le tapis en l'espèce, si l'on s'en tient aux constatations du jugement commenté. On y découvre, en effet, que les auteurs se plaignant de la violation de leurs droits étaient, pour certains, des ressortissants du

126 Voir en ce sens LUCAS (A.), LUCAS-SCHLOETTER (A.) et BERNAULT (C.), n.37, n°1759 et s.

127 Convention de Berne, art. 14 ter al. 2.

Royaume-Uni (*le tribunal évoque, à tort, une nationalité "anglaise"*), du Niger et du Nigéria, ainsi que de l'Inde (*si on accepte de lire ainsi la référence à une nationalité "hindoue"*), quatre pays qui sont membres de l'Union de Berne (*depuis l'origine, pour ce qui concerne le premier*). Le Cameroun étant dans le même cas (*depuis 1960*), ces auteurs-là ne pouvaient, contrairement à ce qui est jugé, se voir opposer une quelconque réciprocité.

II. Les conditions de la réciprocité

Admettons, pour les besoins de la discussion, que certains, parmi les auteurs concernés, aient été ressortissants d'États non unionistes et sans pouvoir justifier d'une résidence dans un État unioniste. L'hypothèse, à vrai dire, est peu probable compte tenu de la dimension planétaire qu'a prise aujourd'hui la Convention de Berne. Elle ne peut cependant être exclue dès lors que la liste des "nationalités étrangères" (*d'ailleurs surprenante puisqu'elle inclut les nationalités "hindoue" et haoussa*), qui se conclut par des points de suspension indiquant que la liste n'est pas exhaustive, n'est donnée par le tribunal qu'à titre indicatif.

À première vue, l'article 93, alinéa 1, de la loi camerounaise, qui subordonne la jouissance du droit d'auteur à une réciprocité législative, semble alors pouvoir trouver à s'appliquer. La solution paraît même pouvoir prendre appui sur l'article 5, alinéa 4, de l'ABR-2015 qui prévoit que les dispositions relatives au traitement national "s'appliquent aux étrangers non ressortissants d'un État partie à une convention internationale à laquelle l'Organisation ou ses États membres sont parties ou les étrangers n'ayant pas leur principal établissement ou leur domicile dans un tel État sous condition de réciprocité".

Mais d'abord, on relèvera que la rédaction de cet article 5, alinéa 4, de l'ABR-2015 laisse à désirer. Outre que la formule "ou les étrangers" procède, à l'évidence, d'une erreur de plume (*il faut lire, pour que la phrase soit correcte : "ou aux étrangers"*), une lecture littérale de la disposition (à partir de la conjonction "ou") lui ferait dire que des étrangers ressortissants d'un État unioniste mais ayant leur résidence dans un État non unioniste seraient soumis à l'exigence de réciprocité, ce qui serait contraire tout à la fois à la Convention de Berne et à l'article 93, alinéa 1, de la loi camerounaise.

Ensuite, et l'objection s'adresse aux deux textes cités, la Convention de Berne interdit de raisonner exclusivement en termes de nationalité (ou de résidence). L'article 5, alinéa 1, garantit en effet le traitement national aux auteurs "en ce qui concerne les œuvres pour lesquelles ils sont protégés en vertu de la présente Convention". Or la détermination du pays d'origine joue à cet égard un rôle essentiel¹²⁸. Concrètement, le ressortissant d'un État non unioniste qui publie pour la première fois son œuvre dans un État unioniste a droit au traitement national. En l'espèce, il aurait donc fallu rechercher, au cas par cas, quel était

le pays d'origine (*au sens de l'article 5, alinéa 4, de la Convention de Berne*) des œuvres en cause.

Il est vrai que, même lorsque le pays d'origine est unioniste, l'article 6 de la Convention l'autorise à poser une condition de réciprocité si le pays dont l'auteur (*par hypothèse non unioniste*) est ressortissant "ne protège pas de manière suffisante" les œuvres des auteurs qui sont ses nationaux. Mais cela suppose qu'il fasse "usage de cette faculté" en notifiant au Directeur général de l'OMPI une "déclaration écrite, où seront indiqués les pays vis-à-vis desquels la protection est restreinte, de même que les restrictions auxquelles les droits des auteurs ressortissants à ces pays sont soumis" (art. 6, al. 1 et 3, respectivement). Ce mécanisme, qui n'existait pas dans la version initiale de la Convention, a été introduit lors de la révision de 1928 à l'instigation du Canada qui entendait se réserver cette possibilité de rétorsion à l'encontre de son puissant voisin que sont les États-Unis, lesquels n'avaient pas encore adhéré à la Convention. Mais le Canada n'en a pas usé car il n'a notifié aucune déclaration en ce sens¹²⁹, et il ne semble pas que d'autres pays se soient engagés dans cette voie. Autant dire que l'application du texte dans les circonstances telles que celles de l'espèce relève de l'hypothèse d'école.

La question, on le voit, était complexe et méritait mieux que la réponse péremptoire assénée par le jugement commenté.

André Lucas

129 NORDEMANN (W.), VINCK (K.) et HERTIN (P.W.), *Droit d'auteur international et droits voisins dans les pays de langue allemande et les États membres de la Communauté européenne* (traduit de l'allemand par J. Fournier), Bruxelles (Bruylant), 1983, p. 86.

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Chapitre 7

Concurrence déloyale

A. Concurrence déloyale – Conditions : existence d’une situation de concurrence – Existence des éléments constitutifs de la concurrence déloyale

L’action en concurrence déloyale ne peut prospérer que si les conditions préalables ci-après sont réunies, soit :

- d’une part l’existence d’une situation de concurrence entre le demandeur et le défendeur; et
- d’autre part, la présence des éléments constitutifs de la concurrence déloyale qui sont la faute, le dommage et le lien de causalité entre les deux.

Cour d’État du Niger, Chambre judiciaire, Arrêt n° 13 – 086/c du 4 avril 2013, ADAMOU IDRISSE c. MAHAMAN MINDAOU

Observations:

L’arrêt rendu par la Chambre judiciaire de la Cour d’État du Niger le 4 avril 2013 met en exergue les conditions de succès de l’action en concurrence déloyale. L’affaire qui a donné lieu à cet arrêt opposait Monsieur Adamou Idrissa, promoteur de l’établissement scolaire CSP DESSA, à Monsieur Mahaman Mindaou et autres, promoteurs de l’établissement scolaire CSP GOBIR.

Faits : Les faits de l’espèce étaient fort simples. Bien qu’ayant ouvert effectivement leur établissement après l’obtention des pièces administratives requises, Monsieur Mahaman Mindaou et autres avaient, préalablement à l’obtention de ces pièces administratives, entrepris de recruter des enseignants, d’inscrire des élèves et de faire des affiches publicitaires et des communiqués radiodiffusés relatifs aux conditions et modalités d’inscription scolaire au CSP GOBIR dans le cadre de la rentrée 2008/2009.

Estimant que le fait pour les promoteurs de cet établissement d’avoir commencé leur campagne de promotion, de recrutement des enseignants et d’inscription des élèves avant l’obtention des pièces administratives requises était constitutif de concurrence déloyale, Monsieur Adamou Idrissa, promoteur de l’établissement scolaire CSP DESSA, dont trois des promoteurs de l’établissement scolaire CSP GOBIR étaient d’anciens vacataires, a engagé avec succès une action en concurrence déloyale contre Monsieur Mahaman Mindaou et autres devant le tribunal de grande instance de Maradi. Le jugement rendu par ce tribunal a été infirmé par la cour d’appel de Zinder au motif que les faits reprochés aux promoteurs de l’établissement CSP GOBIR n’étaient pas constitutifs

de concurrence déloyale. En effet, même si les affiches publicitaires et les communiqués radiodiffusés relatifs aux conditions et modalités d’inscription scolaire au CSP GOBIR sont intervenus avant l’obtention des autorisations administratives nécessaires à sa mise en marche, l’ouverture effective dudit établissement a eu lieu après délivrance de ces pièces administratives.

Insatisfait par cet arrêt, Monsieur Adamou Idrissa s’est pourvu en cassation en arguant d’une part que les affiches publicitaires, les communiqués radiodiffusés et le recrutement des élèves prouvent bien que l’école était déjà ouverte, sans aucune autorisation, ce qui s’analyse en des actes de nature à causer un préjudice à autrui et constitue une concurrence déloyale imposant la mise en œuvre des articles 1382 et 1383 du Code civil. Il soutient d’autre part que les agissements fautifs des défendeurs étaient délibérés et guidés par un esprit de vengeance, causant un préjudice à sa propre école de deux manières, et qu’il a subi un double préjudice à cause de ces agissements, à savoir :

- les frais de scolarité extrêmement bas de l’école des défendeurs l’ont obligé à réduire les frais de sa propre école; et
- la disponibilité des enseignants était réduite.

Le problème juridique auquel la Cour d’État du Niger était appelée à répondre était de savoir si les conditions de succès de l’action en concurrence étaient réunies dans le cas de l’espèce.

Raisonnement : Pour répondre à cette question, la Cour d’État du Niger commence d’abord par rappeler les fondements juridiques de la concurrence déloyale, à savoir les articles 1382 et 1383 du Code civil et les articles 4 et 7 de l’Accord révisé de Bangui du 2 mars 1999 instituant l’Organisation africaine de la propriété intellectuelle (OAPI) à laquelle le Niger est partie¹. Elle rappelle ensuite la fonction et les conditions d’exercice de l’action en concurrence déloyale.

- S’agissant de sa fonction, la Cour d’État du Niger présente l’action en concurrence déloyale comme le régulateur nécessaire du droit de la concurrence dont le but premier est le maintien, dans l’intérêt de la liberté du commerce et des affaires, d’une concurrence suffisante, effective et nécessaire à la sauvegarde, non pas seulement de l’intérêt particulier des concurrents, mais de l’intérêt général et de celui

¹ Il convient de préciser qu’il s’agit des art. 4 et 7 de l’annexe VIII de l’ABR-1999, précision que le juge a oublié de faire.

des consommateurs; et

- Quant aux conditions d'exercice de l'action en concurrence déloyale, la Cour d'État du Niger rappelle d'une part que celle-ci nécessite un fait générateur de responsabilité, un préjudice et un lien de causalité entre le fait générateur et ce préjudice et, d'autre part, l'existence d'une clientèle réelle et commune, les deux parties offrant actuellement à la même clientèle des produits ou des services analogues.

Une fois ces rappels faits, la Cour d'État du Niger rejette la deuxième branche du premier moyen pris de la violation des articles 1382 et 1383 du Code civil parce que les conditions de succès de l'action en concurrence déloyale n'étaient pas réunies dans le cas de l'espèce. Elle commence par critiquer le jugement qui avait retenu la concurrence déloyale parce qu'il n'a pu établir ni l'existence d'une situation de concurrence entre les deux établissements avant l'existence légale de l'établissement scolaire CSP GOBIR, ni l'existence d'actes de concurrence déloyale imputables à cet établissement après l'obtention par ce dernier de tous les documents officiels nécessaires à son ouverture.

La Cour d'État du Niger donne ensuite raison à la cour d'appel de n'avoir pas qualifié d'actes de concurrence déloyale les faits dénoncés par Adamou Idrissa, promoteur de l'établissement scolaire CSP DESSA, quand bien même ces faits auraient entraîné la baisse des frais d'inscription pratiqués dans son établissement.

La motivation de l'arrêt rendu par la Cour d'État du Niger nous invite à examiner deux conditions distinctes d'existence de la concurrence déloyale, soit :

- I. l'existence d'une situation de concurrence d'une part; et
- II. l'existence des éléments constitutifs de la concurrence déloyale d'autre part.

Ce commentaire nous donne par ailleurs l'occasion de clarifier une troisième question juridique qui se pose de manière implicite dans l'arrêt et sur laquelle la Cour d'État du Niger aurait dû se prononcer, à savoir

- III. la question du fondement juridique de l'action en concurrence déloyale dans l'espace OAPI.

I. L'existence d'une situation de concurrence

Le fait d'établir l'existence d'une situation de concurrence entre deux professionnels est subordonnée à deux conditions : l'exercice par ces derniers d'activités relevant du domaine de la concurrence (A) et leur attrait pour une clientèle commune (B).

A. L'exercice d'activités relevant du domaine de la concurrence

L'article 1^{er}, alinéa a), de l'annexe VIII de l'Accord révisé de Bangui de 1999 qui définit le domaine de la concurrence déloyale vise comme activités concernées par celle-ci les activités industrielles ou commerciales, auxquelles l'annexe VIII de l'Acte de Bamako de 2015 assimile les

activités libérales, qui sont ignorées par l'Accord de Bangui de 1999. L'activité d'enseignement dont il est question dans l'affaire qui a donné lieu à l'arrêt de la Cour d'État du Niger n'est ni une activité industrielle, ni une activité libérale. Peut-elle être considérée comme une activité commerciale?

Les juges du fond, de même que la Cour d'État du Niger, se sont comportés comme si cela allait de soi, alors qu'il n'en est rien. Pour répondre de manière pertinente à la question posée, il convient de se référer à l'article 3 de l'Acte uniforme relatif au droit commercial général (AUDCG) qui traite des actes de commerce par nature. Aux termes de cet article, un acte de commerce par nature est "celui par lequel une personne s'entremet dans la circulation des biens qu'elle produit ou achète ou par lequel elle fournit des prestations de service avec l'intention d'en tirer un profit pécuniaire". L'activité d'enseignement n'est pas un bien, mais une prestation de service. Mais est-elle accomplie avec l'intention d'en tirer un profit pécuniaire? Elle ne figure pas parmi les actes de commerce par nature énumérés par l'article 3 de l'AUDCG. On peut donc hésiter à la considérer comme un acte de commerce par nature. Mais l'énumération de l'article 3 de l'AUDCG n'est pas limitative. On peut donc fonder la commercialité de l'activité d'enseignement accomplie par les établissements CSP DESSA et CSP GOBIR sur l'intention qu'ils ont de tirer profit de leurs activités, dans la mesure où ces deux établissements les accomplissent contre versement des frais de scolarité. Il ne s'agit donc pas d'une activité philanthropique, mais lucrative. On est en présence d'activités commerciales au sens de l'article 3 de l'AUDCG et par conséquent d'activités relevant du domaine de la concurrence.

La qualification d'une activité d'enseignement comme étant une activité commerciale n'est cependant pas à l'abri des critiques, d'autant plus que l'ordonnance n° 96/035 du 19 juin 1996 portant réglementation de l'enseignement privé au Niger n'éclaire pas sur la nature civile ou commerciale d'une telle activité au Niger. À titre de droit comparé, la loi n° 004/022 du 22 juillet 2004 fixant les règles relatives à l'organisation et au fonctionnement de l'enseignement privé au Cameroun dispose en son article 2, alinéa 1, que l'enseignement privé est un service social d'utilité publique assuré par des partenaires privés. Il est certain que malgré le silence de l'ordonnance nigérienne susvisée sur la nature de l'activité d'enseignement effectuée par les établissements privés, celle-ci est un service social d'utilité publique au Niger comme au Cameroun.

En tant que service social d'utilité publique, l'enseignement privé ne peut pas être considéré comme une activité commerciale, mais comme une activité civile. Or l'annexe VIII de l'Accord révisé de Bangui de 1999 limite le domaine de la concurrence déloyale aux activités industrielles et commerciales. Une conception aussi restrictive du domaine de la concurrence déloyale est cependant critiquable. Aussi, l'annexe VIII de l'Acte de 2015 a-t-elle élargi ce domaine aux activités libérales. Mais cet accord devrait élargir davantage le domaine de la concurrence déloyale en y intégrant toutes les activités

civiles qui s'adressent à la clientèle avec l'intention de se l'accaparer. Sur cette base, on pourrait considérer que les activités d'enseignement menées par les établissements scolaires CSP DESSA et CSP GOBIR, bien qu'étant civiles, sont des activités relevant du domaine de la concurrence.

B. L'existence d'une clientèle

La Cour d'État du Niger reproche au premier juge qui a retenu l'action en concurrence déloyale en se fondant sur le fait que les défendeurs au pourvoi avaient apposé des affiches, fait des communiqués radiodiffusés, recruté des enseignants et inscrit des élèves, alors que leur établissement n'avait encore aucune existence légale, de n'avoir pas dit en quoi leur établissement a pu entrer sérieusement en concurrence avec celui du demandeur et partager avec lui une clientèle commune.

Rappelant par ailleurs que "l'acte de concurrence déloyale intervient toujours en considération d'une clientèle réelle et commune, les deux parties offrant actuellement à la même clientèle des produits ou des services analogues", la Cour souligne deux facteurs traditionnellement considérés afin de déterminer l'existence d'une clientèle, à savoir l'existence d'une clientèle réelle (1) et d'une clientèle commune aux deux parties (2).

1. L'existence d'une clientèle réelle

À partir de quel moment la clientèle d'un fonds de commerce existe-t-elle effectivement? Deux thèses principales ont été défendues en doctrine : la thèse de l'ouverture du fonds de commerce au public² et la thèse de l'exploitation effective de celui-ci³. La Cour de cassation française a préféré la thèse de l'exploitation effective du fonds de commerce à celle qui se satisfait de son ouverture au public. Elle refuse en effet qu'une clientèle en puissance, potentielle, suffise à constituer une clientèle au sens d'élément du fonds de commerce⁴.

Dans le cas de l'espèce, il ressort des constatations faites aussi bien par le juge d'instance que par le juge d'appel qu'il est établi et non contesté par les pièces du dossier et des débats à l'audience que les affiches publicitaires et les communiqués radiodiffusés relatifs aux conditions et modalités d'inscription scolaire au CSP GOBIR sont intervenus avant l'obtention par le directeur dudit établissement des autorisations administratives nécessaires à sa mise en marche. Mais il résulte aussi des mêmes pièces que l'ouverture effective dudit établissement a eu lieu après délivrance des pièces administratives susvisées. Le premier juge s'est fondé sur le fait que les défendeurs au pourvoi avaient apposé des affiches, fait des communiqués radiodiffusés, recruté des enseignants et inscrit des élèves, alors que leur établissement n'avait encore aucune existence légale, pour retenir la concurrence déloyale. Autrement dit, pour le premier juge, les actes préparatoires

suffisent pour qu'il y ait apparition de la clientèle et par conséquent existence de la concurrence. Peu importe qu'il y ait ou non par la suite obtention de l'autorisation d'ouverture, suivie ou non de l'ouverture effective de l'établissement. Le premier juge rejette ainsi à la fois la thèse qui subordonne l'existence du fonds de commerce à son ouverture au public et celle qui subordonne cette existence à son exploitation effective.

Cette solution est à juste titre rejetée par la Cour d'État du Niger pour qui le premier juge ne dit pas en quoi l'établissement CSP GOBIR a pu entrer sérieusement en concurrence avec l'établissement CSP DESSA, sur la base des seuls actes préparatoires suscités. Autrement dit, pour la Haute juridiction nigériane, tant qu'un établissement scolaire n'a pas obtenu l'autorisation d'ouverture, elle n'a pas d'existence légale et ne peut donc pas être considérée comme ayant une clientèle. En matière d'établissement scolaire, l'apposition des affiches, la diffusion des communiqués par voie de radio, le recrutement des enseignants et même l'inscription des élèves ne suffisent pas pour qu'il y ait apparition de la clientèle. Celle-ci est subordonnée à l'obtention de l'autorisation d'ouverture suivie de l'ouverture effective de l'établissement au public.

2. L'existence d'une clientèle commune

La Cour d'État du Niger reproche au premier juge de n'avoir pas dit en quoi l'établissement CSP GOBIR partageait avec l'établissement CSP DESSA une clientèle commune avant l'obtention de l'autorisation d'ouverture par celui-là. La Haute juridiction nigériane s'aligne ainsi sur la conception traditionnelle de la concurrence déloyale⁵, laquelle est partagée par la majorité de la jurisprudence de l'espace OAPI⁶.

Cette conception traditionnelle de la concurrence déloyale est cependant remise en cause aujourd'hui en droit français où l'action en concurrence déloyale n'est plus, dans tous les cas, subordonnée à l'existence d'un rapport de concurrence entre les parties⁷. La faute de concurrence déloyale peut donc être constituée en dehors de l'existence d'une clientèle commune⁸.

Pour apprécier s'il existait ou non une clientèle commune dans le cas de l'espèce, il faut distinguer deux phases : la phase préparatoire à l'ouverture de l'établissement CSP GOBIR et la phase postérieure à l'obtention de l'autorisation d'ouverture de celui-ci.

2 WEILL et CHABASSE, Création et disparition du fonds du commerce : Juriscl. Fonds de commerce, Fasc. VI.

3 COHEN, La propriété des fonds de commerce exploités dans les immeubles spécialisés : JCP G, 1955, I, p. 1222.

4 Cass. com., 27 février 1973 (2 arrêts) : JCP G, 1973, II n° 17403 (obs. A.S.); Cass. civ. 3^e chambre, 18 mai 1978 : Bull. Civ, III, n° 205, p. 159.

5 Voir MERMILLOD (L.), Essai sur la notion de concurrence déloyale en France et aux États-Unis, Paris (LGDJ), 1954, p. 60; ROUBIER (P.), Le droit de la propriété industrielle, Tome 1, Paris (Sirey), 1952, p. 108.

6 TGI Douala, Arrêt n° 112 du 5 mai 1978, *Ets SECAREC c. S.G.B.C., MERCEDES SEAC*; TGI de Yaoundé, Arrêt 175 du 11 décembre 1985, *Société Philip Morris Inc. c. Société Vistamil SL.*; CA Douala, Arrêt 10/C du 21 novembre 1969, *Cie des transactions commerciales (C.T.C.) c. Cie des transactions commerciales (C.T.C.)*.

7 Cass. com., 8 novembre 1994 : Bull. civ., IV, n° 325; Contrats Concurrence Consommation, 1995, n° 6 (obs. VOGEL (D)); D. 1995, Somm. 209 (obs. SERRA (Y.)); VOGEL (L.), Droit français de la concurrence : JCP E 1995, I, p. 492.

8 Voir dans ce sens, RIPERT (G.), ROBLOT (R.), VOGEL (L.), Traité de droit commercial, Tome 1, 18^e éd., Vol. 1, n° 730, pp. 595 et 596 et toute la jurisprudence citée.

- Dans la phase préparatoire à l'ouverture de l'établissement CSP GOBIR, la condition d'existence d'une clientèle commune entre les deux établissements en cause n'était pas remplie parce que l'établissement CSP GOBIR n'avait pas encore de clientèle. Seul l'établissement CSP DESSA qui fonctionnait déjà avait une clientèle. C'est donc à juste titre que la Cour d'État du Niger a déclaré qu'en se fondant sur le fait que les défendeurs au pourvoi avaient apposé des affiches, fait des communiqués radiodiffusés, recruté des enseignants et inscrit des élèves, alors que leur établissement n'avait encore aucune existence légale, le premier juge ne dit pas en quoi un tel établissement a pu partager avec celui du demandeur une clientèle commune.
- Dans la phase postérieure à l'obtention de l'autorisation d'ouverture par l'établissement CSP GOBIR, il est incontestable que les deux conditions d'existence d'une clientèle rattachée à cet établissement et d'une clientèle partagée par les deux établissements étaient réunies. En effet, les deux établissements exerçaient une activité similaire, identique.

C'est en raison de cette évidence que la Cour d'État du Niger n'a pas cru devoir se prononcer de manière explicite sur la condition d'existence d'une clientèle commune dans la phase postérieure à l'obtention de l'autorisation d'ouverture par l'établissement CSP GOBIR, préférant ainsi se focaliser sur l'existence des éléments constitutifs de la concurrence déloyale imputée aux défendeurs au pourvoi par le demandeur.

II. L'existence des éléments constitutifs de la concurrence déloyale

Le succès de l'action en concurrence déloyale est subordonné à l'existence des éléments constitutifs ci-après : le fait générateur de responsabilité ou la faute, qui est un acte de concurrence déloyale, le dommage et le lien de causalité entre celui-ci et celui-là. La Cour d'État du Niger rappelle fort opportunément ce triptyque. Cette dernière ne s'est cependant pas attardée sur la condition du préjudice (B) et du lien de causalité (C), mais uniquement sur le fait générateur de concurrence déloyale (A).

A. Le fait générateur de concurrence déloyale

Pour la Cour d'État du Niger, "le fait générateur de responsabilité, pour sous-tendre une action en concurrence déloyale, doit résider dans une intervention fautive sur le marché, trouvant son fondement dans les articles 1382 et 1383 du Code civil, ladite faute consistant dans la violation de devoirs dans l'exercice de la liberté de la concurrence qui traduit des impératifs de loyauté, d'honnêteté et d'intérêt social".

Cette définition de la concurrence déloyale est conforme à celle consacrée par la jurisprudence antérieure et par les différents Actes successifs de l'Accord de Bangui⁹. Pour ces sources jurisprudentielle et conventionnelle, les actes constitutifs de concurrence déloyale sont ceux

qui sont contraires aux usages honnêtes admis dans les milieux professionnels.

Sur la base de ce critère de la déloyauté, de nombreux actes et pratiques ont été considérés comme déloyaux par la jurisprudence et les différents Accords de Bangui :

- le dénigrement qui peut porter soit sur la personne, soit sur les établissements et les produits concurrents;
- la désorganisation qui peut porter sur la production, le personnel ou sur l'activité et les méthodes commerciales de l'entreprise concurrente;
- la confusion qui peut porter sur l'établissement, les produits ou le personnel d'un concurrent, etc.

Pour la Cour d'État du Niger, la faute constitutive de concurrence déloyale doit être expressément constatée par les juges du fond, la qualification que ceux-ci font des faits qui leur sont soumis étant soumise à contrôle.

C'est en vertu de ce pouvoir de contrôle que la Haute juridiction nigérienne reproche au premier juge de n'avoir pas dit en quoi "les agissements des défendeurs, après l'obtention de tous les documents officiels nécessaires ont eu pour effet de tromper le public au détriment du CSP DESSA, ou de dénigrer celui-ci, ou encore de désorganiser en particulier son établissement, ou en général le secteur de l'enseignement privé dans la région". Point n'est besoin de consacrer des développements sur les actes déloyaux dont le demandeur au pourvoi n'a pas pu établir l'existence, à savoir la tromperie envers le public au détriment du CSP DESSA, le dénigrement de celui-ci, la désorganisation de cet établissement en particulier et du secteur de l'enseignement privé dans la région en général.

Fort du constat de l'inexistence d'actes de concurrence déloyale, la Cour d'État du Niger a donné raison à la cour d'appel d'avoir débouté le sieur Adamou Idrissa de son action en concurrence déloyale.

Il était d'ailleurs difficile qu'un fait générateur de concurrence déloyale soit imputé aux promoteurs de l'établissement CSP DESSA tant dans la phase préparatoire de l'ouverture de cet établissement que dans la phase postérieure à l'obtention de l'autorisation d'ouverture.

- Dans la phase préparatoire de l'ouverture de leur établissement, il n'y avait encore ni clientèle réelle, ni clientèle commune. Ces deux conditions préalables n'étant pas réunies, il ne pouvait dès lors pas y avoir d'acte de concurrence déloyale. Ce que contestait le demandeur au pourvoi. À supposer même que l'établissement CSP GOBIR ait commencé à fonctionner sans autorisation d'ouverture, il devait y avoir concurrence interdite¹⁰ et non concurrence déloyale.
- Dans la phase postérieure à l'obtention de l'autorisation d'ouverture, il y avait bien une clientèle

10 Il y a concurrence interdite lorsqu'une personne se livre à une activité soumise à une autorisation préalable sans avoir obtenu une telle autorisation.

réelle et commune. L'exigence classique du lien de concurrence était donc remplie. Mais y avait-il acte ou pratique contraire aux usages honnêtes admis dans les milieux professionnels? Le promoteur de l'établissement CSP DESSA n'a pas réussi à le rapporter. En tout état de cause, l'exercice de son activité par l'établissement CSP GOBIR après l'obtention de l'autorisation d'ouverture ne peut pas être constitutif de concurrence déloyale. Cet exercice est l'expression même de la libre concurrence.

C'est ce que rappelle fort opportunément la Cour d'État du Niger en faisant bien la distinction entre les mots concurrence et concurrence déloyale, "le premier étant l'ensemble des règles juridiques gouvernant les réalités entre acteurs économiques dans la recherche et la conservation de la clientèle et la deuxième s'entendant des procédés contraires à la loi et aux usages constitutifs d'une faute de nature à créer un préjudice à autrui".

Une double conséquence est attachée à la reconnaissance de la libre concurrence.

- La première est la libre fixation des prix des produits ou des services par chaque professionnel, au besoin en pratiquant les prix plus bas que ceux pratiqués par les autres professionnels qui l'ont précédé sur le marché. Il convient de souligner que le contrôle du niveau des prix ne relève d'ailleurs pas du droit de la concurrence déloyale, mais du droit des pratiques anticoncurrentielles. Le fait pour les promoteurs de l'établissement CSP GOBIR de fixer le montant de la scolarité à FCFA 43 000 et non à FCFA 60 000, prix que pratiquait l'établissement CSP DESSA, n'est donc pas constitutif de concurrence déloyale, comme le prétend le promoteur de CSP DESSA.
- La seconde conséquence est la licéité du dommage concurrentiel. La compétition pour la recherche de la clientèle étant libre, tout professionnel peut s'attirer la clientèle d'autrui. Autrement dit, la liberté de la concurrence permet d'attirer les acheteurs, même s'ils sont déjà clients d'un concurrent. Comme le dit un auteur, "la liberté d'agir du concurrent qui cause le dommage l'emporte alors sur la sécurité de son rival malheureux"¹¹. Le promoteur de l'établissement CSP DESSA n'est donc pas fondé à se plaindre de la chute de ses effectifs à cause de l'ouverture de l'établissement CSP GOBIR. Il s'agit d'une conséquence normale de la libre concurrence.

Une voie différente de l'action en concurrence déloyale pouvait cependant être explorée par le promoteur de CSP DESSA : celle de l'action en violation d'une obligation de non-concurrence, si jamais une clause de non-concurrence avait été stipulée dans les contrats de travail qui liaient son établissement à ses anciens enseignants vacataires devenus ses concurrents. Le fait que ces derniers aient ouvert un établissement scolaire concurrent à celui de leur ancien employeur n'est pas en soi constitutif de concurrence déloyale, mais pouvait

constituer une concurrence anti-contractuelle si l'ancien employé était soumis à une obligation conventionnelle de non-concurrence valable.

B. Le préjudice en matière de concurrence déloyale

Malgré le rattachement de l'action en concurrence déloyale à la théorie de la responsabilité civile, la nécessité du préjudice comme condition de succès de cette action reste controversée en doctrine. Deux grands courants d'opinions se sont dégagés, chacun prétendant traduire le droit positif.

- Pour le premier courant et le plus ancien, le demandeur doit faire la preuve d'un préjudice alors même qu'il ne demanderait que la cessation de la concurrence déloyale¹². Les auteurs qui soutiennent cette thèse se fondent sur le fait que la concurrence déloyale trouve son fondement dans l'article 1382 du Code civil qui exige en toute hypothèse et par principe la preuve d'un préjudice. Ils ont donc une conception assez large du préjudice dans la mesure où ils admettent non seulement le préjudice réalisé, mais également le préjudice éventuel.
- Cette conception est repoussée par les autres auteurs du second courant¹³. En effet, selon le Doyen ROUBIER, l'action en concurrence déloyale ne doit pas être simplement assimilée à l'action en responsabilité civile. Deux hypothèses doivent être distinguées : si le demandeur réclame des dommages et intérêts, il doit faire la preuve du préjudice dont il a souffert; par contre, s'il ne les réclame pas, mais demande plutôt l'interdiction des moyens déloyaux, il pourra l'obtenir "sans autre condition que celle de l'intérêt né et actuel que possède nécessairement tout concurrent à ne pas avoir à lutter contre de tels moyens"¹⁴. Pour résumer la pensée de ROUBIER, on peut dire que "l'existence du préjudice est une chose normale, mais la démonstration n'en est point nécessaire pour le succès de l'action en concurrence déloyale, à moins que le demandeur ne réclame des dommages et intérêts"¹⁵.

L'Accord de Bangui de 1999 et l'Acte de 2015 semblent s'être alignés sur la thèse doctrinale qui exige l'existence d'un préjudice. L'article 1^{er}, alinéa 1)b), de l'annexe VIII de l'ABR-1999 dispose, en effet, que toute personne physique ou morale peut agir en concurrence déloyale lorsqu'elle est lésée ou susceptible d'être lésée par un acte de concurrence déloyale¹⁶. Il ressort de ce fragment de texte que l'action en concurrence déloyale est ouverte lorsque le préjudice est avéré ou lorsqu'il est potentiel. Lorsque le préjudice est avéré, la personne lésée peut agir entre autres en réparation du préjudice qu'elle a subi. En revanche, lorsque le préjudice n'est que potentiel, la personne susceptible d'être lésée ne peut pas agir en réparation dudit préjudice potentiel. Elle

11 PRIEUR (R.), Contribution à l'étude de la concurrence sur le marché : RTD Com. 1960, p. 521.

12 DESPAGNE (F.), Note sous Cass. Req, 29 mai 1894 : D.P. 1894, I, p. 521; ALLART (H.), Traité pratique et théorique de la concurrence déloyale, Paris, 1892, n° 7; GODINOT (H.), La concurrence déloyale ou illicite, Thèse, Nancy, 1932, p. 32.

13 ROUBIER (P.), n.5, n° 111, pp. 507 et s.; GIVERDON (C.), Les délits et quasi-délits commis par le commerçant dans l'exercice de son commerce : RTD Com. 1953, n° 23, p. 862.

14 *Ibid.*, p. 509.

15 *Ibid.*

16 Cet article est repris *in extenso* par l'art. 1^{er} al. 2)b) de l'ABR-2015.

ne pourra exercer qu'une action visant la suppression de la situation déloyale¹⁷ de l'Accord de 1999 qui vise parmi les sanctions de la concurrence déloyale les injonctions (cet article est devenu l'article 1^{er}, alinéa 2)b), dans l'ABR-2015).

La jurisprudence de l'espace OAPI quant à elle est partagée entre les deux thèses. Si certains juges se sont alignés sur la thèse de ROUBIER¹⁸, d'autres par contre exigent toujours la preuve du préjudice souffert, même s'ils ont réduit à l'extrême cette condition afin de sanctionner certains faits particulièrement blâmables. Ainsi, il arrive que les tribunaux se contentent d'un préjudice minime¹⁹ et même simplement moral²⁰. Cette dernière jurisprudence a été consacrée par l'ABR-2015 dont l'article 8 de l'annexe VIII vise parmi les dommages réparables le préjudice moral²¹.

Bien que n'ayant pas retenu la concurrence déloyale, la Cour d'État du Niger a quand même tenu à rappeler que le succès de l'action en concurrence déloyale nécessite un préjudice. Comme en matière de responsabilité civile, la preuve du préjudice subi incombe au demandeur à l'action en concurrence déloyale. Mais cette preuve ne consiste pas uniquement en la démonstration d'un détournement effectif de clientèle ou d'une baisse du chiffre d'affaires²². Il suffit au demandeur d'établir que les moyens déloyaux ont attiré à son concurrent de nombreux acheteurs²³. Dans ces conditions, la fixation des dommages et intérêts destinés à réparer le préjudice subi s'avère délicate. C'est la raison pour laquelle on constate que le plus souvent, les tribunaux allouent au concurrent lésé un franc symbolique de dommages et intérêts. Le caractère symbolique des dommages et intérêts alloués au concurrent n'est pas de nature à dissuader les auteurs des actes de concurrence déloyale. Seule la cessation de l'acte déloyal, assortie éventuellement de la publicité du jugement, constitue la meilleure sanction à l'encontre d'un concurrent déloyal.

C. Le lien de causalité entre le fait générateur de responsabilité et le préjudice

Le troisième élément constitutif de la concurrence déloyale rappelé par la Cour d'État du Niger est le lien de causalité entre l'acte de concurrence déloyale et le préjudice. Mais contrairement à la faute et au préjudice,

le lien de causalité n'a pas beaucoup retenu l'attention des tribunaux et de la doctrine.

En principe, l'exigence d'un lien de causalité signifie que le préjudice subi par le concurrent doit être la conséquence directe de l'acte déloyal. Mais, dans de rares cas où ils ont eu à se prononcer, les tribunaux ont fait preuve de beaucoup de souplesse dans l'appréciation du lien de causalité. Ainsi, dans une espèce où elle a eu à statuer, la Cour de cassation française a approuvé l'allocation des dommages et intérêts alors qu'il n'était pas établi que la diminution du chiffre d'affaires d'une entreprise résultait strictement des procédés fautifs du concurrent²⁴.

Cette souplesse de la jurisprudence n'est guère étonnante. D'une part, l'instabilité de la clientèle rend l'établissement et l'appréciation du lien de causalité très difficile et hypothétique. D'autre part, du moment où les tribunaux n'exigent pas systématiquement la preuve d'un préjudice certain, mais se contentent même d'un préjudice éventuel pour prononcer la condamnation, l'exigence du lien de causalité s'en trouve allégée, voire supprimée.

III. Le fondement juridique de l'action en concurrence déloyale

La théorie de la concurrence déloyale comme moyen de moralisation de la concurrence a été admise dans la quasi-totalité des pays ayant opté pour le libéralisme économique²⁵. Les méthodes de construction ont cependant été différentes. En droit français par exemple, en l'absence d'un texte spécial réprimant les pratiques concurrentielles jugées déloyales, c'est la jurisprudence et la doctrine qui, depuis le XIX^e siècle, ont élaboré la théorie de la concurrence déloyale. Cette construction s'est faite sur la base des articles 1382 et 1383 du Code civil. La concurrence déloyale n'est donc au départ qu'une hypothèse particulière de responsabilité civile délictuelle du fait personnel.

La théorie de la concurrence déloyale ainsi construite a été introduite dans certains pays d'Afrique noire francophone par le biais de la colonisation française, où elle est restée pendant longtemps une construction jurisprudentielle. Il a fallu attendre l'AB-1977 pour voir la consécration légale de la théorie de la concurrence déloyale dans certains pays d'Afrique noire francophone membres de cette Organisation.

L'ABR-1999 accorde une plus grande importance à la concurrence déloyale non seulement en lui consacrant toute une annexe, à savoir l'annexe VIII, mais également en densifiant le nombre d'articles consacrés à la concurrence déloyale : on est en effet passé d'un seul article à huit articles. L'ABR-2015 reprend presque à l'identique l'annexe VIII de l'ABR-1999.

17 Voir art. 1 al. 1 let. b de l'ABR-2015.

18 CA Douala, Arrêt n° 10/C du 21 novembre 1969, n.6 : "Au surplus, la mesure tendant à la suppression d'une situation illicite présente un caractère préventif et peut être ordonnée même en l'absence de tout préjudice."

19 *Ibid.*

20 TGI de Yaoundé, Jugement civil n° 382 du 22 juin 1983, *Directeur de l'entreprise MECAF c. Menuiserie camerounaise industrielle* : "Attendu que la demanderesse ne rapporte et n'offre pas de rapporter la preuve du préjudice matériel invoqué; que par contre il est certain que les agissements de la MECAF ont causé un préjudice moral à la M.C.I.". Confirmé sur ce point par la CA Yaoundé, *Directeur de l'entreprise MECAF c. Menuiserie camerounaise industrielle, inédit*, Arrêt n° 58/Civ du 4 décembre 1985.

21 Art. 8 de l'annexe VIII : "La juridiction nationale compétente prend en considération les conséquences économiques négatives, dont le manque à gagner, subies par la partie lésée, les bénéfices réalisés par l'auteur de l'acte illicite et le préjudice moral causé à la victime."

22 CA Paris, 3 avril 1995 : D. 1996, Somm. 254; Cass. com., 25 janvier 2000 : PIBD, 2001, III, p. 154, P.A., Cass. com. 18 juillet 2000, note MALAURIE-VIGNAL (M.), P.A., Cas. com. 3 juillet 2000, note MATHEY (N.).

23 CA d'Orléans, 29 mars 1889 : D.P., 1890, II, p. 134; CA Rouen, 8 novembre 1899 : D.P. 1900, II, p. 338.

24 Cass. com., 16 octobre 1957 : Bull. Civ. III, p. 265.

25 ROUBIER (P.), n.5, p. 1.

Mais depuis l'entrée en vigueur de l'AB-1977, de nombreux juges de l'espace OAPI continuent de viser dans leurs décisions relatives à la concurrence déloyale, soit uniquement l'article 1382 du Code civil²⁶, soit à la fois l'article 1382 du Code civil et les dispositions de l'Accord de Bangui consacrées à la concurrence déloyale comme l'a fait la Cour d'Etat du Niger dans le cas de l'espèce, soit uniquement l'Accord de Bangui²⁷.

Certes, le critère de la déloyauté consacré par la jurisprudence sur la base de l'article 1382 du Code civil est identique à celui consacré par les Accords successifs de Bangui, mais il nous semble qu'il n'est plus opportun, sauf dans l'hypothèse de la concurrence parasitaire non économique²⁸, de fonder la concurrence déloyale sur l'article 1382 du Code civil ou de viser ce texte en même temps que les dispositions pertinentes de l'Accord de Bangui. Ces dernières se suffisent à elles-mêmes. Même si le demandeur à l'action en concurrence déloyale fonde son action sur l'article 1382 du Code civil, le juge qui donne une suite favorable à cette action devrait procéder à une substitution de textes et fonder sa décision sur les dispositions pertinentes de l'Accord de Bangui. De même, si les juges du fond fondent leurs décisions sur l'article 1382 du Code civil, les juges de cassation des États membres de l'OAPI devraient procéder à une substitution de base juridique, car ils sont garants de la bonne application du droit par les juges du fond.

Grégoire Jioque

B. Stockage pendant une longue période des bouteilles de distribution de gaz d'un concurrent – Sabotage d'autres bouteilles de gaz – Désorganisation du réseau de vente du concurrent établie – Inopportunité de l'élément intentionnel

Constitue un acte de concurrence déloyale par désorganisation du réseau de vente d'un concurrent le fait, pour une société qui commercialise le gaz industriel et médical, de stocker pendant une longue durée une quantité importante des bouteilles de gaz d'une société concurrente et de saboter d'autres bouteilles de gaz.

Tribunal de commerce d'Abidjan, Jugement n° 2234/2015 du 31 juillet 2015, LA SOCIÉTÉ AIR LIQUIDE CÔTE D'IVOIRE SA c. LA SOCIÉTÉ D'OXYGÈNE ET D'ACÉTYLÈNE DE CÔTE D'IVOIRE DITE SOA-CI

26 Voir par exemple : Cour suprême de Côte d'Ivoire, Chambre judiciaire, 6 juin 2003, *Société Sogec-Ivoire c. Société Ivoiral* (obs. FADE (A.), ce recueil, chapitre 7, section D); Cour suprême de Côte d'Ivoire, Chambre judiciaire, 1^{er} juin 2006, *Société Sogec-Ivoire c. Établissements Mroui & Frères*, inédit.

27 Voir par exemple TGI de Douala, Jugement civ. n° 192 du 15 décembre 2000, *Société Moulinex SA c. Vapsan trading Co et autres* (obs. NDEMA ELONGUE (M-L)) : Revue scientifique de la propriété industrielle la GAZELLE, n° 001, novembre 2007, pp. 17 et s.; Cour suprême du Sénégal, Arrêt n° 57 du 17 mai 2017, *Sonatel Mobiles SA c. Agence Touba Sénégal et le groupe GPS* (ce recueil, chapitre 3, section M).

28 Voir Tribunal de commerce d'Abidjan, 19 décembre 2017, *Madame Amissah Marielle c. 1. Soumahoro Maury Fere, 2. MGROUPE, 3. MTN Côte d'Ivoire, 4. Le bureau ivoirien du droit d'auteur* (obs. LUCAS (A.) et JIOGUE (G.), ce recueil, chapitre 6).

Observations :

L'annexe VIII de l'ABR-1999 donne une liste non limitative des procédés de concurrence déloyale. Parmi ces procédés figure la désorganisation de l'entreprise concurrente et du marché²⁹ qui est considérée comme la forme la plus brutale de concurrence déloyale. La désorganisation de l'entreprise concurrente et du marché peut revêtir plusieurs formes, mais celle dont il est question dans le jugement rapporté du tribunal de commerce d'Abidjan du 31 juillet 2015 est la désorganisation du réseau de vente d'une entreprise concurrente.

Faits : Ce jugement met en présence deux sociétés concurrentes, la société Air Liquide, la demanderesse, et la SOA-CI, la défenderesse, qui ont pour activité la commercialisation du gaz industriel et médical. Dans le cadre de ses activités, chacune des sociétés vend des bouteilles estampillées en son nom à ses clients.

Informée, avec des prises de vue à l'appui, que des bouteilles lui appartenant se trouvent dans l'atelier de maintenance de la défenderesse, la demanderesse a sollicité et obtenu par ordonnance une autorisation de procéder à un constat dans les locaux de la défenderesse. Il est ressorti de ce constat fait par voie d'huissier les constatations suivantes :

- 43 bouteilles se trouvent dans les locaux de la défenderesse;
- sur les 43 bouteilles, 31 bouteilles sont sans robinets et 12 avec robinets;
- la SOA-CI a estampillé des bouteilles lui appartenant de son nom commercial.

Outre ces constatations, l'huissier instrumentaire a également découvert plusieurs bouteilles rouillées dans les locaux de la défenderesse et, en raison de leur état de dégradation avancée, il n'a pu déterminer le propriétaire desdites bouteilles. Mais pour la demanderesse, tout porte à croire que ces emballages lui appartiennent dans la mesure où la défenderesse n'a aucun intérêt à laisser ses propres emballages se retrouver dans un tel état.

La demanderesse déduit de ces constatations :

- a. d'une part que la défenderesse récupère les emballages lui appartenant et commercialise son gaz dans lesdits emballages en y apposant son nom commercial; et
- b. d'autre part, qu'elle est victime de la désorganisation de son réseau de distribution par la défenderesse qui a stocké ses bouteilles dans ses locaux. Elle demande par conséquent au tribunal de condamner la défenderesse à la réparation du préjudice qu'elle lui fait subir par cet acte de concurrence déloyale.

29 Cf. art. 7 de l'annexe VIII de l'ABR-1999. Cet article est repris *in extenso* par l'ABR-2015.

Raisonnement : La question à laquelle le tribunal était invité à répondre était celle de savoir s'il y avait désorganisation du réseau de distribution de la demanderesse. Le tribunal a répondu à cette question par l'affirmative. Selon lui en effet, la défenderesse a intentionnellement stocké les bouteilles de la demanderesse dans ses locaux pendant plusieurs jours pour les utiliser, et cet acte constitue bien un acte déloyal. Il poursuit que cet acte désorganise le réseau de distribution de la demanderesse en ce sens qu'en raison du stockage de plusieurs de ses bouteilles, celle-ci ne peut pas satisfaire sa clientèle, contrairement à la défenderesse qui, disposant d'une quantité importante de bouteilles, pourra faire face aux besoins de ses clients à elle.

Il ressort de la motivation de la décision du tribunal que celui-ci s'est fondé sur deux éléments pour retenir la désorganisation du réseau de distribution de la demanderesse : un élément matériel et un élément intentionnel. Mais s'il est nécessaire, pour que la désorganisation du réseau de distribution constitutive de concurrence déloyale soit caractérisée, qu'il y ait un acte matériel (I), l'exigence de l'élément intentionnel est depuis longtemps devenue inopportune (II).

I. La nécessité d'un acte matériel dans la caractérisation de la désorganisation du réseau de distribution du concurrent

À la suite de la jurisprudence fondée sur l'article 1382 du Code civil, l'article 7, alinéa 1, de l'annexe VIII de l'ABR-1999 affirme le caractère déloyal de la désorganisation de l'entreprise concurrente et du marché en ces termes : "Constitue un acte de concurrence déloyale tout acte ou toute pratique qui, dans l'exercice d'activités industrielles ou commerciales, est de nature à désorganiser l'entreprise concurrente, son marché ou le marché de la profession concernée"³⁰.

En considérant comme déloyal tout acte ou pratique qui "est de nature à désorganiser l'entreprise concurrente", l'article 7, alinéa 1, affirme qu'il n'est pas nécessaire que l'acte ou la pratique ait déjà produit les effets. Il suffit que l'acte ou la pratique soit potentiellement susceptible de désorganiser l'entreprise concurrente, son marché ou le marché de la profession concernée.

L'article 7, alinéa 2, donne une liste non limitative des procédés de désorganisation. Il ressort de cette liste deux catégories de désorganisation : les procédés de désorganisation d'un opérateur en particulier et les procédés de désorganisation du marché dans son ensemble. Entrent dans la première catégorie la suppression de publicité, le détournement de commandes et la désorganisation du réseau de vente. Entrent en revanche dans la deuxième catégorie la pratique de prix anormalement bas et le non-respect de la réglementation relative à l'exercice de l'activité concernée.

Dans le cas de l'espèce, la demanderesse sollicite la condamnation de la défenderesse pour concurrence déloyale au motif que cette dernière a désorganisé son réseau de distribution en stockant certaines de ses bouteilles dans ses locaux et en sabotant d'autres. La défenderesse prétend en revanche que la présence des bouteilles dans ses locaux n'est pas constitutive d'un acte de concurrence déloyale. Il s'agit, selon elle, plutôt d'une pratique dans le milieu du gaz. En effet, dans le secteur de la distribution du gaz, les clients viennent souvent pour le rechargement du gaz auprès d'un distributeur avec des bouteilles appartenant au concurrent. Celles-ci sont alors mises de côté vides pour être récupérées par le client par la suite, car ces bouteilles sont garanties par une somme d'argent par les clients. La défenderesse indique que c'est dans ce contexte que les 43 bouteilles litigieuses se sont retrouvées dans ses locaux et que des bouteilles lui appartenant ont été retrouvées aussi dans les locaux de la demanderesse. La défenderesse soutient par ailleurs qu'elle n'a ni rempli de gaz, ni utilisé à des fins commerciales les 43 bouteilles litigieuses qui étaient vides et entreposées dans un endroit précis comme cela ressort du procès-verbal de constat. La défenderesse avance d'autres arguments de procédure qui ne méritent pas attention dans le cadre de ce commentaire.

Fort de arguments de fond susvisés, la défenderesse conclut à l'inexistence d'un acte de désorganisation pouvant engager sa responsabilité.

Pour trancher le litige, le tribunal a d'abord procédé à la définition de la désorganisation qui est, selon lui, "un dommage consistant en une atteinte certaine et significative subie par une organisation économique, de nature à faire obstacle à son fonctionnement". La pertinence de cette définition ne peut pas être appréciée par rapport à l'article 7 de l'annexe VIII de l'Accord de Bangui révisé du 24 février 1999 qui ne donne aucune définition de la désorganisation. Il se contente en effet d'affirmer le caractère déloyal de ce procédé et de faire une énumération non limitative des hypothèses de désorganisation. Il ressort de la définition donnée par le tribunal que l'acte ou la pratique en cause doit être de nature à faire obstacle au fonctionnement de la victime de cet acte ou de cette pratique, ce qui revient à définir la désorganisation par elle-même. Mais le plus important est moins la définition de la désorganisation en elle-même que la caractérisation du procédé de désorganisation en cause, ce qui, dans le cas de l'espèce, est la désorganisation du réseau de distribution de la demanderesse par la défenderesse.

Pour retenir l'existence de ce procédé, le tribunal s'appuie d'abord sur le nombre de bouteilles de la demanderesse retrouvées chez la défenderesse pour écarter la pratique en cours dans le secteur de la distribution du gaz invoquée par cette dernière. Selon le tribunal, "si tant est que cette pratique existe dans ce milieu, la défenderesse ne rapporte pas la preuve qu'une société concurrente peut garder dans ses locaux une aussi importante quantité de bouteilles". Il s'appuie ensuite sur le sabotage des bouteilles de la demanderesse par la défenderesse. Pour le tribunal en effet, cette dernière ne rapporte

30 Ce texte est repris *in extenso* par l'art. 7 al. 1 de l'annexe VIII de l'ABR-2015.

pas non plus la preuve qu'une société peut démonter les robinets et les chapeaux des bouteilles de son concurrent comme c'est le cas en l'espèce. Le tribunal s'appuie enfin sur le fait que la défenderesse "a mis son étiquette sur certaines bouteilles objets du présent litige pour les commercialiser au détriment de la société AIR LIQUIDE". Au regard de ces constatations, c'est à juste titre que le tribunal a conclu qu'il y a concurrence déloyale par désorganisation du réseau de distribution de la demanderesse en ce sens "qu'en raison du stockage de plusieurs de ses bouteilles, celle-ci ne peut satisfaire sa clientèle contrairement à la SOA-CI qui, disposant d'une quantité importante de bouteilles, pourra faire face aux besoins de ses clients à elle".

Outre l'existence de l'acte matériel de désorganisation du réseau de distribution de la demanderesse, le tribunal a également invoqué, pour caractériser cette désorganisation, l'élément intentionnel dont l'opportunité en matière de concurrence déloyale est discutable.

II. L'inopportunité de l'élément intentionnel dans la caractérisation de la désorganisation du réseau de distribution du concurrent

Pour retenir dans le cas de l'espèce la désorganisation du réseau de distribution de la demanderesse par la défenderesse, le tribunal se fonde entre autres sur le fait que cette dernière "a intentionnellement stocké les bouteilles dans ses locaux pendant plusieurs jours pour les utiliser". Il résulte de cette motivation que le tribunal fait de l'intention un élément constitutif de la concurrence déloyale en général et de la désorganisation du réseau de distribution de la victime en particulier. Or l'article 7 de l'annexe VIII de l'Accord de Bangui révisé du 24 février 1999 sur la désorganisation de l'entreprise concurrente et du marché, comme tous les autres articles de l'annexe VIII qui consacrent d'autres hypothèses de concurrence déloyale, ne fait pas de l'intention un élément constitutif de la concurrence déloyale (*la même solution est consacrée par l'annexe VIII de l'Acte de 2015*).

L'Accord de Bangui s'aligne ainsi sur la jurisprudence rendue sur le fondement de l'article 1382 du Code civil qui, depuis l'important arrêt de la Cour de cassation française du 18 avril 1958³¹, a évincé l'intention des éléments constitutifs de la concurrence déloyale. Il serait d'un grand intérêt de retracer l'évolution de la jurisprudence sur la question de l'intention en matière de concurrence déloyale.

Schématiquement, on peut dire que trois grandes étapes ont marqué cette évolution, avec, au centre de celle-ci, une question principale : l'acte de concurrence déloyale doit-il être ou non un acte intentionnel ? Pendant longtemps, la réponse n'a pas paru douteuse à la jurisprudence. Elle exigeait, pour qu'il y ait concurrence déloyale, qu'il y ait eu intention frauduleuse, c'est-à-dire mauvaise foi. Cette opinion était soutenue aussi bien

par les juges du fond³² que par la Cour de cassation française qui a affirmé dans plusieurs de ses arrêts que "la déloyauté de la concurrence suppose la mauvaise foi"³³. Selon ce premier courant jurisprudentiel, l'absence de mauvaise foi était donc exclusive de la concurrence déloyale.

Cette jurisprudence, approuvée par certains auteurs³⁴, a été critiquée par la majorité de la doctrine³⁵. Pour cette partie de la doctrine, l'action en concurrence déloyale n'étant qu'un cas de responsabilité civile, il devrait suffire d'une faute de négligence ou d'imprudence du concurrent pour engager la responsabilité de ce dernier. L'exigence de la mauvaise foi paraît donc excessive. La critique des auteurs amena la jurisprudence à l'assouplissement de sa doctrine. Elle admit, même en l'absence de mauvaise foi, la responsabilité du concurrent lorsque celui-ci avait simplement commis une faute quasi délictuelle. Cette tendance jurisprudentielle s'exprimait dans deux séries de décisions. Les unes, tout en reconnaissant que l'auteur de l'acte de concurrence n'avait pas agi avec mauvaise foi, ou se refusant même à la rechercher, relevaient cependant à son encontre une faute d'imprudence ou de négligence et le condamnaient sur le fondement de cette faute³⁶. Les autres, après avoir recherché la faute du concurrent prétendument déloyal, constataient qu'elle n'existait pas, et ne prononçaient aucune condamnation malgré le préjudice subi³⁷. Mais la jurisprudence et certains auteurs qualifiaient cette concurrence "interdite" en vertu de la faute quasi délictuelle de "concurrence illicite" pour la distinguer de la concurrence déloyale proprement dite, constituée par une faute intentionnelle. La distinction ne se limitait pas au plan terminologique. En effet, bon nombre d'auteurs et de décisions de justice attachaient à cette distinction une double conséquence.

- La première de ces conséquences était d'ordre procédural. Le tribunal saisi d'une action en concurrence déloyale était tenu de rejeter la demande en l'absence de mauvaise foi, sans pouvoir relever une "concurrence illicite"³⁸.

32 Voir notamment : CA Grenoble, 3 mai 1954 : D. 1954, p. 426 : Il est de doctrine et de jurisprudence constante que l'action en concurrence déloyale n'est admise que si le demandeur prouve "que ... le concurrent pratique des manœuvres dolosives pour tenter de détourner la clientèle, la mauvaise foi caractérisée étant un élément essentiel de la concurrence déloyale"; CA Lyon 9 juin 1955, cassé par Cass. com. 18 avril 1958 : D. 1959, p. 87, Note DERRIDA (F.) : "Attendu que la concurrence déloyale, qui consiste dans toute manœuvre destinée à attirer à soi la clientèle d'autrui, suppose la mauvaise foi."

33 Cass. Req. 9 mars 1870 : D.P. 1871, I, p. 211; Cass. Requ., 18 novembre 1903 D.P. 1904, I, p. 10; S. 1904, I, p. 84; 26 févr. 1907 : D.P. 1908, I, p. 27.

34 Voir Plaisant, Note au J.C.P. 1948, II, 4035; Esmein, Note au J.C.P. 1958, II, n° 10535.

35 Voir CHAVANNE (A.), Juriscl. Responsabilité civile, Fasc. XVII bis A, n° 41; GENY (S.), Note : S. 1937, II, p. 1; SAVATIER (R.), Traité de la responsabilité civile, Tome 1, n° 50; ROUBIER et CHAVANNE, Chroniques à la R.T.D. Com. n° 1955, p. 837, n° 11 et 1958, p. 102, n° 18; CROUANSON, De l'élément de faute dans la concurrence déloyale, Thèse AIX, n° 1925, p. 24.

36 CA Toulouse, 4 janvier 1954 : D. 1954, p. 116; CA Chambéry, 2 février 1954 : D. 1954, p. 297; CA Paris, 14 février 1958 : J.C.P. 1958, II, n° 10535 (note ESMEIN (P.)).

37 CA Rennes, 28 novembre 1922 et sur pourvoi, Req. 16 juill. 1925 : Ann. prop. ind. 1928, p. 24; Tribunal de commerce de la Seine, 29 juin 1927 : Gaz. Pal. 1927, II, p. 416; CA Paris, 5 juillet 1954 : S., 1955, II, p. 1 (concl. DUPIN).

38 Cass. req., 9 mars 1870 et 18 novembre 1903, préc., note 33; CA Grenoble, 26 juin 1906 : Ann. prop. ind. 1907; CA Poitiers, 5 novembre 1935 : S., 1937, II, p. 1, (note GENY).

- La seconde conséquence concernait l'appréciation des dommages et intérêts. En cas de mauvaise foi, la responsabilité devait être aggravée. En revanche, la bonne foi devait profiter au défendeur en ce qui concerne l'étendue des dommages et intérêts³⁹.

La majorité des auteurs ont critiqué cette distinction tant dans sa terminologie que dans les effets que l'on a voulu en tirer⁴⁰.

La troisième étape de l'évolution jurisprudentielle est marquée par l'arrêt de la Cour de cassation du 18 avril 1958. Cet arrêt retient l'attention quant à sa motivation qui est la suivante : "Attendu que l'emploi par un commerçant du nom d'un homonyme dans des conditions créant une confusion entre deux établissements est constitutif d'un quasi-délit qui ne requiert pas un élément intentionnel". Dans cet arrêt de principe, la Cour de cassation a adopté la conception objective de la concurrence déloyale et a répudié la distinction purement terminologique et parfaitement inutile entre la concurrence déloyale et la "concurrence illicite"⁴¹.

Malgré la résistance de certains juges⁴², les juges de l'espace OAPI se sont largement alignés sur la jurisprudence inaugurée par l'arrêt de la Cour de cassation française du 18 avril 1958. En effet, la majorité des décisions rendues ne subordonnent plus l'admission de l'action en concurrence déloyale à la preuve de la mauvaise foi du défendeur⁴³. En somme, si la preuve de la faute est à la fois nécessaire et suffisante, la faute d'imprudence ou de négligence engage, au même titre que la faute intentionnelle, la responsabilité de son auteur pour concurrence déloyale⁴⁴.

Au regard de l'évolution de la jurisprudence ainsi retracée et de la position de l'ABR-1999 et de l'ABR-2015, le constat qui mérite d'être fait est que la décision du tribunal de commerce d'Abidjan du 31 juillet 2015 est en déphasage avec le droit positif et ne saurait être approuvée. Certes, une entreprise ne peut pas stocker

une quantité importante des bouteilles de gaz de son concurrent, et en saboter d'autres, sans avoir l'intention de désorganiser son réseau de distribution. Mais cette intention ne doit pas être considérée comme un élément constitutif de la concurrence déloyale.

Grégoire Jiogue

C. Action civile en contrefaçon et concurrence déloyale – Intervention volontaire – Licencié non exclusif – Recevabilité

Fait une mauvaise application de l'article 46 de l'annexe III de l'ABR-1999 le juge d'instance qui déclare irrecevable l'intervention volontaire du bénéficiaire d'une licence non exclusive de marque dans l'instance en contrefaçon et concurrence déloyale initiée par le titulaire, au motif que celui-ci défend les mêmes intérêts, alors même qu'il est établi que l'intervenant volontaire poursuit l'indemnisation du préjudice qui lui est propre.

Par ailleurs, les exigences de l'article 41, alinéa 1^{er}, du texte précité, en l'occurrence l'inaction du titulaire de la marque et la mise en demeure préalable, concevables en matière de contrefaçon, sont inapplicables dans le cadre de l'action en concurrence déloyale.

Tribunal de grande instance de Ouagadougou, Jugement n° 139/2005 du 23 mars 2005, LA STÉ U.NV c. T.A

Observations:

Attribut du droit exclusif, le droit d'exercer l'action civile en contrefaçon d'une marque appartient principalement au titulaire de ladite marque. Ce principe dégagé par l'article 46.1) de l'annexe III de l'Accord de Bangui, Acte du 24 février 1999, admet cependant quelques atténuations : le bénéficiaire d'un droit exclusif d'usage, c'est-à-dire le licencié exclusif, dispose également de la faculté d'initier cette action sous deux conditions cumulatives, à savoir l'absence d'une clause contractuelle contraire et la mise en demeure préalable du titulaire originaire. En revanche, le bénéficiaire d'une licence non exclusive ne peut qu'intervenir dans l'instance en contrefaçon déjà pendante en vertu de l'alinéa 2 du texte de loi précité. L'on s'interroge dès lors sur la pertinence du jugement du tribunal de grande instance de Ouagadougou ci-avant rapporté, ayant déclaré irrecevable l'intervention volontaire du bénéficiaire d'une licence, en l'espèce la société U. Côte d'Ivoire dans le cadre d'une instance en contrefaçon initiée par le titulaire de la marque contrefaite.

Faits : En effet, victime de la contrefaçon de sa marque de poudre à laver "OMO" enregistrée à l'OAPI, la société U. NV a attiré T.A, le présumé contrefacteur, devant ledit tribunal pour contrefaçon et concurrence déloyale sur le fondement des articles 47 et 49 de l'annexe III de l'Accord de Bangui précité, après avoir fait pratiquer une saisie-contrefaçon de 2616 cartons de poudre à laver "MIMO" appartenant à T.A en raison des similitudes des inscriptions et couleurs de l'emballage desdits produits

39 Cass. req., 1^{er} juin 1874 : S. 1875, I, p. 111.

40 Voir notamment : MAUNOURY, Du nom commercial, Thèse, Paris (Hachette), 1894, p. 275.

41 ROUBIER (P.) et CHAVANNE (A.), Chroniques : RTD Com. 1959, p. 425; DERRIDA (F.), Note sous Cass. com., 18 avril 1958, D. 1959, p. 87 (note DERRIDA (F.)). Pour cet auteur, "il ne doit plus y avoir de différence entre concurrence déloyale et concurrence illicite : l'une et l'autre engagent sur les mêmes bases, en vertu des mêmes principes, la responsabilité de leur auteur."

42 Voir TGI de Yaoundé, Jugement n° 382 du 22 juin 1983, *Menuiserie camerounaise industrielle (M.C.I.) c. MECAF et SOPECAM* : "En faisant passer pour sienne, dans la présentation qu'elle a délibérément faite aux journalistes de la SOPECAM, la réalisation des deux bâtiments sur pilotis concernés qu'elle savait avoir été construits par la M.C.I., la MECAF s'est indubitablement livrée à une concurrence déloyale caractérisée par la confusion qu'elle a créée de mauvaise foi entre les deux entreprises."

43 Voir par exemple : Cour suprême de Côte d'Ivoire, Chambre judiciaire, 6 juin 2003, *Société Sogec-Ivoire c. Société Ivoiral* (obs. FADE (A.)), ce recueil, chapitre 7, section D); Cour suprême de Côte d'Ivoire, Chambre judiciaire, 1^{er} juin 2006, *Société SOGEC-IVOIRE c. Établissements MROUI & FRÈRES*, inédit; TGI de Douala, Jugement civil n° 192 du 15 décembre 2000, *Société Moulinex SA c. Vaspan trading co et autres* (obs. NDEMA ELONGUE (M.-L.)); Cour suprême du Sénégal, Arrêt n° 57 du 17 mai 2017, *SONATEL Mobiles SA c. L'Agence Touba Sénégal et le groupe GPS* (obs. NDEMA ELONGUE (M.-L.)), ce recueil, chapitre 3, section M).

44 Voir CA Douala, Arrêt n° 10/C du 21 novembre 1969, n.6, inédit, qui parle de faute quasi délictuelle, de négligence ou d'imprudence engageant la responsabilité du défendeur.

avec ceux revêtus de la marque "OMO". La société U. Côte d'Ivoire est intervenue volontairement dans cette instance pour solliciter la réparation du préjudice propre, en vertu de la licence de commercialisation de la poudre à laver "OMO" à elle consentie par la société U. PLC, bénéficiaire d'un droit exclusif d'usage de ladite marque.

T.A a derechef plaidé l'irrecevabilité des deux actions motifs pris du défaut de preuve de non-radiation et de non-déchéance, du défaut du cautionnement et de l'incompétence du juge ayant délivré l'ordonnance de saisie-contrefaçon. S'agissant singulièrement de l'intervention volontaire, T.A a prétendu que le titulaire de la marque ayant déjà agi pour la défense des mêmes intérêts que ceux intéressant U. Côte d'Ivoire, celle-ci n'a plus qualité pour agir. Plaidant au fond, il a prétendu avoir acheté la poudre à laver "MIMO" contenue dans des cartons au port de TEMA au Ghana et ce n'est qu'à Ouagadougou qu'il s'est rendu compte de la ressemblance de ces produits avec ceux marqués "OMO".

Raisonnement : Abstraction faite de la question de recevabilité des actions présentées (section I), le tribunal était également appelé à se prononcer sur le bien-fondé des actions conjointes en contrefaçon et concurrence déloyale (section II).

I. La recevabilité des actions

Dès l'orée de l'instruction de cette affaire, T.A a plaidé l'irrecevabilité tant de la demande principale (A) que de l'intervention volontaire (B).

A. La demande principale

À côté des conditions classiques de recevabilité d'une action en justice prévues par les Codes nationaux de procédure civile des États signataires de l'Accord de Bangui, le propriétaire de la marque initiateur d'une action en contrefaçon doit pouvoir justifier de sa propriété et de l'étendue de ses droits en produisant aux débats le certificat d'enregistrement de sa marque au risque de voir son action rejetée. Dans l'espèce commentée, T.A a convoqué trois motifs à l'appui de sa fin de non-recevoir, notamment le défaut de preuve de non-radiation et de non-déchéance, le défaut du cautionnement et l'incompétence du juge ayant délivré l'ordonnance de saisie-contrefaçon.

L'on perçoit d'emblée qu'en dehors du moyen tiré de l'incompétence du juge ayant prescrit la saisie-contrefaçon, lequel ne soulève du reste pas une question spécifique au droit de la propriété intellectuelle, les deux précédents moyens ne peuvent valablement faire obstacle à la recevabilité d'une action en contrefaçon. En effet, la production de la preuve de non-radiation et de non-déchéance, ainsi que le cautionnement éventuel, sont des exigences légales préalables à la prise d'une ordonnance de saisie-contrefaçon et non des conditions de recevabilité de l'action en contrefaçon⁴⁵. L'exigence de la preuve de non-radiation et de non-déchéance a d'ailleurs été supprimée par l'article 51.2)

de l'Acte de Bamako du 14 décembre 2015 qui dispose : "L'ordonnance est rendue sur requête et sur justification de l'enregistrement de la marque". L'entrée en vigueur de ce texte facilitera désormais l'obtention de cette mesure conservatoire par les titulaires des marques, en particulier ceux résidant hors du siège de l'OAPI qui, du fait de leur éloignement, avaient des difficultés à se faire délivrer en urgence les certificats de non-radiation et de non-déchéance, même par la voie électronique.

En tout état de cause, les vices entachant la saisie-contrefaçon ne sauraient raisonnablement paralyser l'instance en contrefaçon introduite au fond et dans le cadre de laquelle le titulaire de la marque peut valablement se prévaloir de la mosaïque de preuves qu'offre le droit commun. L'on comprend aisément la facilité avec laquelle le juge a rejeté la fin de non-recevoir excipée par T.A relativement à la demande principale en contrefaçon et concurrence déloyale, même si les motifs invoqués à l'appui ne sont pas convaincants. De fait, la demande principale a été initiée par la société U. NV sur deux fondements distincts, à savoir la contrefaçon et la concurrence déloyale, en sorte que l'irrecevabilité de la première laisse subsister la seconde non soumise aux mêmes exigences de forme. La production du certificat de non-radiation et de non-déchéance et le cautionnement ne sont pas requis dans le cadre d'une action en concurrence déloyale fondée sur le droit commun de la responsabilité du fait personnel réglementé par les codes civils nationaux.

En effet, l'action complémentaire en concurrence déloyale relevant du droit commun de la responsabilité civile est soumise aux conditions classiques de recevabilité d'une action en justice.

B. L'intervention volontaire

Les faits révèlent que la société U. Côte d'Ivoire a bénéficié d'une sous-licence non exclusive de sa consœur, la société U. PLC, elle-même bénéficiaire d'une licence exclusive à elle concédée par la société U. NV titulaire de la marque "OMO". Et c'est sur le fondement de l'article 46.2) de l'Accord de Bangui, Acte du 24 février 1999, que la société U. Côte d'Ivoire s'est portée intervenante volontaire dans la présente instance. Le tribunal a rejeté son action au visa de l'article 46.1) de l'accord susvisé, texte inapproprié en l'espèce puisqu'il vise plutôt le cas du bénéficiaire d'une licence exclusive. Or, U. Côte d'Ivoire, tel que démontré précédemment, est partie à un contrat de licence simple et dispose de ce fait de la faculté d'intervenir dans l'instance en contrefaçon introduite par le titulaire originaire en vertu de l'article 46.2) précité. C'est donc à tort que le juge a privé ce plaideur de la possibilité de réclamer réparation du préjudice propre qu'il estime avoir subi du fait des agissements de T.A.

La décision rapportée est d'autant plus critiquable de ce point de vue que l'intervention volontaire de la société U. Côte d'Ivoire a pour objet la réparation du préjudice subi du fait de la concurrence déloyale, régime de protection non régi par les dispositions des articles 46.1) et 2) de l'Accord de Bangui. Il importe de préciser à ce stade,

45 Cf. art. 48 de l'annexe III de l'ABR-1999.

contrairement à la position du juge dans cette affaire, que le bénéficiaire d'une licence d'exploitation d'une marque, quelle qu'en soit la nature, subit un préjudice propre du fait de la contrefaçon ou de la concurrence déloyale en rapport avec ladite marque l'habilitant à solliciter une indemnisation conséquente. Toutefois, l'Acte de Bamako du 14 décembre 2015 semble exclure le licencié simple du cercle des personnes habilitées à solliciter l'indemnisation par voie d'intervention volontaire. Est-ce une simple omission ou une volonté délibérée du législateur communautaire? L'hypothèse d'une omission paraît plausible d'autant plus que cette question est réglée par le même accord en matière de brevet d'invention⁴⁶, de modèle d'utilité⁴⁷ et de dessins et modèles industriels⁴⁸.

II. Le bien-fondé des actions

Nous apprécierons le bien-fondé des actions en contrefaçon et concurrence déloyale engagées au regard des modalités de l'invocation conjointe desdites actions (A) et des sanctions qui en résultent (B).

A. Les modalités de l'invocation conjointe des actions

L'action principale initiée par la société U. NV titulaire originaire de la marque "OMO" a pour fondement les articles 37 de l'annexe III, 2, 3, et 4 de l'annexe VIII de l'Accord de Bangui, Acte du 24 février 1999, traitant respectivement de la contrefaçon et de la concurrence déloyale. Les données factuelles ne permettent cependant pas de tracer une ligne de démarcation entre les deux régimes de protection, le raisonnement du juge dans la décision commentée en est une illustration :

"Attendu en l'espèce que des pièces versées au dossier, les produits de la marque 'MIMO' présentent des similitudes autant sur les inscriptions que sur les couleurs des emballages avec ceux de la marque 'OMO'; Que la marque 'OMO' étant une marque légalement enregistrée et protégée, alors que la marque 'MIMO' ne l'est pas, ces actes d'imitation constituent une contrefaçon, et par la confusion et la tromperie que les produits de la marque 'MIMO' pouvaient occasionner au sein du public, ces actes constituent même des actes de concurrence déloyale; que la société U.NV est ainsi fondée en sa demande, d'où qu'il convient d'y faire droit".

Cet attendu ne permet pas de distinguer avec précision les actes constitutifs de contrefaçon de ceux justiciables du chef de concurrence déloyale. Pourtant, il est acquis tant en doctrine qu'en jurisprudence que l'action complémentaire en concurrence déloyale ne peut être accueillie que si elle se fonde sur une faute dommageable distincte par hypothèse du comportement constitutif de contrefaçon et dès lors non couverte par la qualification de contrefaçon et non

sanctionnée⁴⁹. En l'espèce, la société U. NV a prétendu que la contrefaçon était caractérisée au regard de la similitude des inscriptions et couleurs de l'emballage de la poudre à laver "MIMO" avec celle marquée "OMO" et que la concurrence déloyale provenait de la confusion résultant de l'imitation de la présentation de l'emballage de la poudre "OMO" par les distributeurs de "MIMO". Le même fait aurait alors été qualifié par le juge à la fois de contrefaçon et de concurrence déloyale, toute chose qui impacte négativement la consistance des dommages et intérêts auxquels la victime pourrait prétendre.

B. Les sanctions conséquentes

La société U. NV a réclamé le remboursement des frais exposés à l'occasion de la présente procédure ainsi que la somme de FCFA 250 000 000 au titre du manque à gagner résultant des méventes qu'elle a connues du fait de la contrefaçon alléguée. Ces demandes ont été rejetées faute de justificatifs. Évidemment, les méventes tout comme les frais de procédure doivent être prouvés par la production des pièces comptables afférentes dont l'absence prive le juge d'éléments objectifs d'appréciation. Le jugement rapporté n'appelle aucune observation particulière sur ce point. Toutefois, il convient d'indiquer que la condamnation pour contrefaçon et concurrence déloyale devrait entraîner l'allocation des dommages et intérêts séparés compte tenu de la nature duale de la faute alléguée. La question certes n'a pas été spécifiquement abordée par le juge qui s'est à juste titre cantonné à l'examen de la demande telle que présentée par la société U. NV qui a omis de ventiler sa demande. Les juridictions des pays signataires de l'Accord de Bangui ont tendance à ignorer cette différence de régime entre les deux actions, surtout lorsqu'elles sont exercées conjointement comme en l'espèce. Dans une intéressante affaire mettant en cause deux sociétés commerciales de Douala au sujet des marques "MOULINEX" et "MAMMONLEX", le tribunal de grande instance de cette ville avait condamné la société convaincue de contrefaçon à payer la somme globale de FCFA 20 000 000 à titre de dommages et intérêts pour contrefaçon et concurrence déloyale⁵⁰.

Max Lambert Ndéma Elongué

D. Dessin ou modèle industriel – Concurrence déloyale – Similitude de nature à créer une confusion dans l'esprit du consommateur – Faute – Préjudice – Détournement de clientèle – Réparation

Commet une faute au sens de l'article 1382 du Code civil, constitutive de la concurrence déloyale, une société qui met sur le même marché un modèle de cuvette similaire à celui commercialisé antérieurement par sa

46 Cf. art. 63 al. 2 de l'annexe I de l'ABR-2015.

47 Cf. art. 55 al. 3 de l'annexe II de l'ABR-2015.

48 Cf. art. 33 al. 1 de l'annexe IV de l'ABR-2015.

49 PASSA (J.), Droit de la propriété industrielle (Marques et autres signes distinctifs, dessins et modèles), Tome 1, Paris (LGDJ), 2006, p. 453.

50 Voir par ex. TGI du Wouri (Douala), Jugement civil n° 192 du 15 décembre 2000, *Moulinex SA c. Vaspan Trading Cie* (obs. NDEMA ELONGUE (M.-L.)) : Revue scientifique de la propriété industrielle la Gazelle n° 0001, novembre 2007, pp. 17 et s.

concurrente, créant ainsi une confusion dans l'esprit du consommateur qui a pu conduire à un détournement de clientèle.

Cour suprême de Côte d'Ivoire, Arrêt n° 816 du 9 juillet 1997, SOCIÉTÉ SOGEC-IVOIRE c. SOCIÉTÉ IVOIRAL

Observations:

La liberté de concurrence n'autorise pas les entreprises à recourir aux comportements contraires aux usages loyaux du commerce pour nuire à un concurrent afin de détourner sa clientèle. La protection par la concurrence déloyale sanctionne de ce fait tout usage excessif de la libre concurrence dans la compétition économique⁵¹. Par nature, la concurrence déloyale est une infraction polymorphe⁵². Outre la définition classique des actes de concurrence déloyale posée à l'article 10bis, alinéa 2, de la Convention de Paris pour la protection de la propriété industrielle, le droit OAPI distingue quatre principaux actes synonymes de déloyauté : la recherche de confusion, le dénigrement, la désorganisation et la divulgation⁵³. Lorsque, dans l'esprit du consommateur, un signe distinctif renvoie à l'image d'une entreprise donnée, tout acte d'un concurrent qui crée ou risque de créer la confusion quant à l'origine des produits renfermant ledit signe constituera un acte de concurrence déloyale⁵⁴. C'est ce que rappelle l'arrêt ci-dessus rapporté, rendu par la Cour suprême de Côte d'Ivoire, dans l'espèce opposant la société SOGEC-Ivoire à la société IVOIRAL.

Faits : Les faits de la cause se résument aisément. La société SOGEC-Ivoire, spécialisée dans le commerce d'ustensiles ménagers, avait fabriqué un modèle de cuvette dénommée AFFOUE 16 A/C. Pour une commercialisation optimale de son produit, SOGEC avait conclu un contrat de sous-traitance avec la société IVOIRAL. La discorde naît après l'arrivée du terme du contrat de sous-traitance. Reprochant à la société IVOIRAL d'avoir mis sur le marché un modèle de cuvette TASSA 16/B, réplique de sa cuvette AFFOUE 16 A/C, SOGEC-Ivoire l'a assignée en réparation devant le tribunal de première instance d'Abidjan. Par jugement n° 79 du 4 février 1998, ladite juridiction va faire droit à sa demande.

Insatisfaite par le jugement ainsi rendu, la société IVOIRAL va interjeter appel devant la cour d'appel d'Abidjan qui, par arrêt n° 816 rendu le 9 juillet 1999, a infirmé le jugement préalablement rendu, d'où le pourvoi de la société SOGEC-Ivoire.

Raisonnement : La question de droit qui était posée à la cour était de savoir si la commercialisation par la défenderesse au pourvoi du modèle de cuvette TASSA 16/B peut constituer une forme de concurrence déloyale. À cette question, la cour a répondu par l'affirmative dès lors qu'il existe un rapport concurrentiel entre les parties litigantes, et que sont réunis les éléments constitutifs de l'action en concurrence déloyale. Exigence d'un rapport de concurrence et éléments constitutifs de l'action en concurrence déloyale feront l'objet des développements ci-après.

Primo, il faut dire que contrairement à l'article 10bis, alinéa 2, de la Convention de Paris qui exige que l'acte déloyal soit un acte de concurrence, les dispositions de l'Accord de Bangui ne visent pas expressément "tout acte de concurrence". Pourtant, la concurrence déloyale n'a de sens que si l'auteur de la déloyauté et sa victime sont en position de concurrence, c'est-à-dire que leurs activités sont rivales, et que tous deux touchent une clientèle identique⁵⁵.

Secundo, l'action en concurrence déloyale étant une variante de l'action en responsabilité civile fondée sur les articles 1382 et suivants du Code civil, sa mise en œuvre suppose la réunion des éléments constitutifs que sont : un *fait générateur* qui est l'acte ou le comportement déloyal, un *dommage* et le *lien de causalité* entre le fait générateur et le dommage.

Tout d'abord, en ce qui concerne le fait générateur de l'action en concurrence déloyale, l'Accord de Bangui parle d'"acte" ou de "pratique" afin de préciser que le fait générateur s'entend non seulement d'un "acte" *stricto sensu*, mais aussi de tout comportement par omission. Au rang des omissions, il peut s'agir du défaut de publication d'un rectificatif ou d'un complément d'information concernant les résultats d'un essai de produit publiés dans une revue de consommateurs⁵⁶. En dépit de leur forme très variée, quatre principaux faits sont souvent le fondement de l'action en concurrence déloyale : la recherche de confusion, le dénigrement, la désorganisation et la divulgation⁵⁷.

Les actes recherchant la confusion sont très souvent le fondement d'une action en concurrence déloyale. La loi sanctionne la déloyauté, que la confusion soit intentionnelle ou non. Il convient de relever qu'il n'est même pas nécessaire que la confusion recherchée par son auteur soit effectivement créée. Même si c'est moins souvent le cas, la loi sanctionne également le simple "risque de confusion", constituant un fondement valable de l'action en concurrence déloyale. Dans ce sillage, l'article 2, alinéa 1, de l'annexe VIII de l'ABR-2015 dispose à cet effet : "Constitue un acte de concurrence déloyale tout acte ou pratique qui, dans l'exercice d'activités industrielles ou commerciales, crée ou est de nature à créer une confusion avec l'entreprise d'autrui ou ses

51 EDOU EDOU (P.) (éd.), Le contentieux de la propriété intellectuelle dans l'espace OAPI : Guide du magistrat, Genève (OMPI), p. 86.

52 L'expression a été utilisée par Madame OUMOU Khaïry Ndao, le droit comparé de la contrefaçon et de la concurrence déloyale : l'exemple de la France et du Sénégal, Thèse de doctorat, Université de Toulouse, 14 décembre 2015, p. 27.

53 EDOU EDOU (P.), n.51, pp. 85-86; ROUBIER (P.), n.5, pp. 536 et s. Voir également art. 2 à 6 de l'annexe VIII de l'ABR-1999.

54 OMPI, Dispositions types sur la protection contre la concurrence déloyale, Genève (OMPI), 1996, p. 16.

55 Voir Cour d'État du Niger, Chambre judiciaire, Arrêt n° 13 - 086/c du 4 avril 2013, *Adamou Idrissa c. Mahaman Mindaou* (obs. JIOGUE (G.)), ce recueil, chapitre 7, section A).

56 Cf. OMPI, n.54, p. 8.

57 EDOU EDOU (P.), n.51, pp. 85-86.

activités, en particulier avec les produits ou services offerts par cette entreprise". Les tribunaux exigent que soit rapportée la preuve d'acte qui crée ou qui est de nature à créer un risque de confusion dans l'esprit du public, faute de quoi ils rejettent l'action en concurrence déloyale. Dans une décision rendue par la cour d'appel de Quémé, l'appelant n'avait pas pu établir le fait que les actes posés par son contradicteur fussent de nature à créer la confusion dans l'esprit du public⁵⁸. La cour a conséquemment rejeté son action en concurrence déloyale en décidant :

"Attendu par ailleurs qu'aux termes des dispositions de l'alinéa b de l'article 17 de l'Accord de Bangui, sont illicites 'tous faits quelconques de nature à créer une confusion ou une tromperie par n'importe quel moyen avec le nom commercial, l'établissement, les produits, les services ou l'activité industrielle ou commerciale d'un concurrent.'

"Attendu que la seule introduction au Bénin par un vendeur d'un produit, en sachant qu'il existe sur le marché un produit similaire et mieux connu ne suffit pas à établir qu'il a connaissance du caractère contrefaisant dudit produit; il y a certes concurrence, mais la concurrence déloyale doit être établie en rapportant la preuve des manœuvres déloyales tendant à créer une confusion ou une tromperie"⁵⁹.

La confusion peut être créée de plusieurs manières. L'article 2, alinéa 2, de l'annexe VIII de l'ABR-2015 nous en donne quelques-unes, notamment lorsque dans l'usage d'une marque, d'un nom commercial ou autre signe distinctif d'une entreprise, un acte crée ou risque de créer une confusion quant à l'identité d'origine des produits ou services qu'ils accompagnent. Très souvent, la confusion naît de l'usage d'une marque utilisée par le concurrent déloyal qui, de par ses similitudes avec une marque préexistante, enregistrée ou non, crée ou risque de créer la confusion dans l'esprit du public. Dans une espèce jugée par le TGI de Ouagadougou, la confusion était entretenue par l'usage des marques similaires OMO et MIMO⁶⁰. La seule condition étant que l'action complémentaire en concurrence déloyale se fonde sur une faute dommageable distincte par hypothèse du comportement constitutif de contrefaçon⁶¹. Il n'en demeure que la confusion puisse naître également de l'usage d'un signe distinctif autre que ceux protégés par l'Accord de Bangui. C'est le cas des signes utilisés par une entreprise pour conférer une certaine identité à celle-ci et aux produits qu'elle fabrique ou aux services qu'elle fournit.

Dans le cas de l'espèce rapportée, la confusion était créée par l'aspect extérieur des produits concurrents, plus précisément leur forme. Usant de son pouvoir d'évocation lui permettant de statuer à nouveau, la Haute Cour constate que "l'expertise ordonnée par le jugement avant dire droit n° 299 du 17 avril 1996 du tribunal de première instance d'Abidjan a fait état d'une similitude quasi identique des modèles de cuvettes en cause; Que cette similitude de nature à créer une confusion dans l'esprit du consommateur qui a pu conduire à un détournement de clientèle préjudiciable à la SOGEC-IVOIRE ayant subi un préjudice matériel certain résultant du manque à gagner du fait de la perte d'une partie de sa clientèle ...". Par ailleurs, la confusion peut naître de l'emballage⁶², de la couleur⁶³ ou d'autres caractéristiques non fonctionnelles du produit.

Comme le prescrit l'article 1382 du Code civil, l'acte de concurrence déloyale doit causer à la victime un préjudice pour ouvrir droit à réparation. En matière de concurrence déloyale, le préjudice résulte le plus souvent du dévoiement de la clientèle du concurrent. C'est donc cette perte de clientèle, fût-elle de quelques clients seulement, qu'il convient d'indemniser. Cependant, il importe peu que les clients visés par le comportement malhonnête aient été effectivement détournés au profit du concurrent déloyal. Dans certains cas, il arrive que la perte de clientèle puisse bénéficier à un concurrent autre que l'auteur de la déloyauté. Mais très souvent, c'est l'auteur de l'acte qui en tire le profit. Ce fut le cas dans l'espèce rapportée.

Comme toute action en responsabilité civile, l'action en concurrence déloyale vise à réparer un préjudice déjà né au moment de son exercice. En l'absence d'un préjudice né ou lorsque ledit préjudice est simplement éventuel, l'action en concurrence sera vouée à l'échec. Tout au long des débats, il avait été prouvé que la SOGEC-Ivoire avait perdu une partie de ses clients tournés désormais vers l'acquisition des cuvettes commercialisées par son concurrent. La réalisation du dommage était donc clairement établie, même si la motivation de la cour laisse planer du doute à cet effet lorsqu'elle affirme que la similitude de nature à créer la confusion "a pu conduire à un détournement de clientèle...".

Outre le préjudice, le succès de l'action en concurrence déloyale repose sur l'existence d'un lien de causalité entre l'acte contraire aux usages honnêtes et la perte de clientèle subie par la victime. Il s'agit d'établir le lien pouvant exister entre les agissements du concurrent et le préjudice subi par l'entreprise. La jurisprudence fait preuve d'un grand pragmatisme dans l'appréciation du lien de causalité. Dans l'affaire commentée, la cour met en relief cette exigence de causalité en précisant que le "préjudice matériel certain résultant du manque à gagner du fait de la perte d'une partie de sa clientèle".

58 Voir CA Quémé, Arrêt n° 14 du 9 novembre 1989, *Reckitt et Colman c. Société d'Import-Export (SIMEXPRO)*.

59 *Ibid.*

60 TGI de Ouagadougou, Jugement n° 139/2005, *La Sté U.NV c. T.A*. Voir aussi TPI d'Abidjan, Jugement civil du 10 avril 1989, *Société PACO RABANNE PARFUMS c. M.A.EL G.*

61 PASSA (J.), n.49, p. 453.

62 TPI d'Abidjan, Jugement civil du 10 avril 1989, *Société Paco Rabanne Parfums c. M.A. EL G.*

63 TGI du Wouri (Douala), Jugement n° 192 du 15 décembre 2000, *Société Moulin SA v. Société VAPS.*

Tous les ingrédients étaient réunis pour le succès de l'action en concurrence déloyale introduite par la société SOGEC-Ivoire.

Aristide Fade



World Intellectual Property Organization
34, chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20
Switzerland

Tel: +41 22 338 91 11
Fax: +41 22 733 54 28

For contact details of WIPO's
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Organisation Africaine de la Propriété Intellectuelle
Rue Hyppodrome, 158 Place de la Préfecture
B.P. 887 Yaoundé
Cameroun

Tel : +237 222 20 57 00
www.oapi.int/index.php/fr/
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