



1-1-2002

# The Development of Modern Trademark Legislation and Protection in Arab Countries of the Middle East

Amir H. Khoury  
*Haifa University School of Law*

Follow this and additional works at: <https://scholarlycommons.pacific.edu/globe>



Part of the [International Law Commons](#)

### Recommended Citation

Amir H. Khoury, *The Development of Modern Trademark Legislation and Protection in Arab Countries of the Middle East*, 16 *TRANSNAT'L LAW* 249 (2002).

Available at: <https://scholarlycommons.pacific.edu/globe/vol16/iss2/3>

This Article is brought to you for free and open access by the Journals and Law Reviews at Scholarly Commons. It has been accepted for inclusion in *Global Business & Development Law Journal* by an authorized editor of Scholarly Commons. For more information, please contact [mgibney@pacific.edu](mailto:mgibney@pacific.edu).

## The Development of Modern Trademark Legislation and Protection in Arab Countries of the Middle East

Amir H. Khoury\*

### TABLE OF CONTENTS

I. INTRODUCTION .....	251
II. THE STRUCTURE AND CONTENT OF TRADEMARK LEGISLATION IN ARAB COUNTRIES OF THE MIDDLE EAST.....	253
A. <i>Surveying Trademark Protection in Arab Countries of the Middle East</i> .....	253
1. <i>The Arab Republic of Syria</i> .....	253
a. <i>Definition and Type of Protectable Marks</i> .....	255
b. <i>The Application Process</i> .....	256
c. <i>Finality of Acceptance and Registration</i> .....	257
d. <i>The Implications of Registration</i> .....	258
e. <i>Maintenance, Duration, and Renewal of Trademarks</i> .....	259
f. <i>Transactions and Changes Affecting Trademark Registrations</i> .....	260
g. <i>Infringement of Trademark Rights</i> .....	262
h. <i>Remedies</i> .....	262
2. <i>The Hashemite Kingdom of Jordan</i> .....	263
a. <i>Definition and Type of Protectable Marks</i> .....	265
b. <i>The Application Process</i> .....	270
c. <i>Finality of Acceptance and Registration</i> .....	271
d. <i>The Implications of Registration</i> .....	272
e. <i>Maintenance, Duration, and Renewal of Trademarks</i> .....	273
f. <i>Transactions and Changes Affecting Trademark Registrations</i> .....	273
g. <i>Infringement of Trademark Rights</i> .....	275
h. <i>Remedies</i> .....	275

---

\* Amir H. Khoury is a Ph.D. candidate, a lecturer at the Haifa University School of Law, and a member of the Israel Bar Association. The author holds an LL.B. degree from the Hebrew University at Jerusalem and a LL.M. degree in International Business and Trade law from Fordham University School of Law (New York City). This research is supported by the Israeli Ministry of Science, Culture and Sport in the framework of the scholarship program for the Israeli Arab students, studying towards the doctoral and postdoctoral degrees. The author extends his sincere appreciation to the Department of Advanced Studies at the Haifa University for its generous financial support throughout his doctoral studies of which this research is a chapter therein. The following work is part of an academic research and should be regarded as such. All the information contained therein is provided as a source of general information on trademarks and other intellectual property issues. This research is not to be regarded as a form of legal advice for one course of action or another, nor is it intended to substitute for professional advice rendered with the full knowledge of the specific circumstances of a given case and proficiency in the laws of the relevant country.

3.	<i>The Kingdom of Saudi Arabia</i> .....	277
a.	<i>Definition and Type of Protectable Marks</i> .....	277
b.	<i>The Application Process</i> .....	279
c.	<i>Finality of Acceptance and Registration</i> .....	281
d.	<i>The Implications of Registration</i> .....	282
e.	<i>Maintenance, Duration, and Renewal of Trademarks Registrations</i> .....	282
f.	<i>Transactions and Changes Affecting Trademark Registrations</i> .....	283
g.	<i>Infringement of Trademark Rights</i> .....	283
h.	<i>Remedies</i> .....	284
4.	<i>The Arab Republic of Egypt</i> .....	285
a.	<i>Definition and Type of Protectable Marks</i> .....	287
b.	<i>The Application Process</i> .....	288
c.	<i>Finality of Acceptance and Registration</i> .....	289
d.	<i>The Implications of Registration</i> .....	290
e.	<i>Maintenance, Duration, and Renewal of Trademarks</i> .....	291
f.	<i>Transactions and Changes Affecting Trademark Registrations</i> .....	292
g.	<i>Infringement of Trademark Rights</i> .....	292
h.	<i>Remedies</i> .....	293
C.	<i>Trademarks and the Arab Boycott of Israel</i> .....	293
1.	<i>Scope of the Boycott and Its Effect on Trademark Registration in the Middle East</i> .....	293
2.	<i>The Boycott's Implementation and Fate</i> .....	295
3.	<i>International Ramifications of the Boycott</i> .....	296
III.	<i>ARAB COUNTRIES IN THE MIDDLE EAST AND TRADEMARK'S "NEW WORLD ORDER"</i> .....	298
A.	<i>Arab Membership in International Conventions and Treaties Pertaining to Trademark Protection</i> .....	298
1.	<i>Regional Arab Intellectual Property Organizations</i> .....	299
B.	<i>An Overview of the World Trade Organization and the Intellectual Property Factor</i> .....	300
1.	<i>Origins of the WTO</i> .....	300
2.	<i>Intellectual Property Within the WTO Framework</i> .....	301
3.	<i>The Obligations that a WTO Membership Entails</i> .....	302
4.	<i>The WTO Accession Process</i> .....	303
C.	<i>Trademark Protection Within the WTO Scheme: TRIPS</i> .....	304
1.	<i>Setting Minimum Standards of Protection</i> .....	305
2.	<i>Enforcement Within National Laws</i> .....	306
3.	<i>Settling Disputes Pertaining to Intellectual Property</i> .....	306

D. WTO Membership of Arab Countries.....	307
1. Egypt's Membership in the WTO.....	307
2. Jordan's Successful Bid to Join the WTO.....	308
3. Saudi Arabia's Bid to Join the WTO.....	310
4. Syria's Delayed Bid to Join the WTO.....	315
5. Israel's Accession to the WTO and Compliance with TRIPS.....	316
IV. THE EFFECTIVENESS OF TRADEMARK PROTECTION AND ENFORCEMENT IN ARAB COUNTRIES OF THE MIDDLE EAST.....	317
A. The First Substantial Encounter of Countries in the Middle East with Intellectual Property Piracy.....	317
B. The Scope, Type, and Trends of Intellectual Property "Piracy" in the Middle East.....	318
C. Judicial Enforcement of Trademark Protection.....	321
1. The Hashemite Kingdom of Jordan.....	321
2. The Arab Republic of Egypt.....	324
3. The Kingdom of Saudi Arabia.....	325
4. The Arab Republic of Syria.....	326
D. Administrative Enforcement of Trademark Protection.....	327
1. The Hashemite Kingdom of Jordan.....	327
2. The Arab Republic of Egypt.....	328
3. The Kingdom of Saudi Arabia.....	329
4. The Arab Republic of Syria.....	331
E. Promoting Awareness to Trademarks and Other IPRs.....	332
1. The Hashemite Kingdom of Jordan.....	332
2. The Arab Republic of Egypt.....	334
3. The Kingdom of Saudi Arabia.....	334
4. The Arab Republic of Syria.....	334
F. Summary of Trademark Protection, Enforcement, and Promotion in ACME.....	335
1. The Hashemite Kingdom of Jordan.....	335
2. The Arab Republic of Egypt.....	336
3. The Kingdom of Saudi Arabia.....	338
4. The Arab Republic of Syria.....	340
5. A Note on Trademarks, the Internet, and E-commerce in Arab Countries.....	340
G. Conclusion: Assessing Trademark Protection in ACME.....	341

## I. INTRODUCTION

In the last decade Arab countries, much like many developing countries, have shown keen interest and political will to join the World Trade Organization (WTO). The protection of Intellectual Property Rights (IPRs) is a crucial

component for becoming a member of the WTO and this research examines the development of trademark protection laws in four Arab countries: the Kingdom of Saudi Arabia; the Hashemite Kingdom of Jordan; the Arab Republic of Syria; and last but not least, the Arab Republic of Egypt. These countries have been selected because they reflect a good spectrum in terms of economy, industry, national wealth, population, and international relations. Suffice it here to note some particularities. Egypt is the largest and the most influential Arab country. Furthermore, Egypt maintains good ties with the West and has also embarked on the road to modernization. Syria, on the other hand, has a relatively closed and undeveloped economy. Likewise, Jordan has a weak but aspiring economy and strong ties to the United States and other Western countries. Saudi Arabia, like Egypt, has strong ties to the West and is the richest country in the oil-rich Arabian Gulf.

My examination of trademarks will be conducted in three spheres, which when combined will produce, I believe, a comprehensive picture regarding the development of trademark laws and protection in Arabic countries of the Middle East (ACME). First, I will explore the evolution of trademark laws in ACME countries and focus on their current structure and content. This “exploration” will be conducted on a “country-by-country” basis. I will divide my discussion of trademark related issues into eight subsections: Definition and Types of Protectable Marks; The Application Process;<sup>1</sup> Finality of Acceptance and Registration;<sup>2</sup> The Implications of Registration;<sup>3</sup> The Implications of Registration;<sup>4</sup> Maintenance,<sup>5</sup> Duration, and Renewal of Trademarks;<sup>6</sup> Transactions and Changes

---

1. This subsection is intended to clarify how trademarks are perceived to exist in the marketplace and how they are intended to function. For example, a law that does not refer to service marks may be seen as reflecting a tendency to limit trademarks to goods rather than services. Such a law would be considered outdated since it overlooks the importance and development of the service sector in the world economy.

In addition to trademarks and service marks, I will discuss additional types of marks such as collective marks and certification marks.

2. This subsection will focus on issues pertaining to filing trademark applications, including the identity of the potential applicant, the documents and details that are required when applying to register a trademark, the ability to file priority applications, and the examination process for trademark applications.

This subsection is intended to highlight the accessibility and viability of registering a trademark in the four ACMEs. I will also try to uncover the rigidity or flexibility of the respective systems.

However, it should be noted that a legal system that operates according to a formalistic set of rules is not necessarily an inefficient system. Such a system, which conducts a thorough examination of trademark applications, may, in fact, indicate diligence and even evade future trademark conflicts between registered marks and new marks.

3. In this subsection, I will examine possible legal maneuvers that may be invoked after a certain mark has been accepted or even registered. I will examine the scope and effectiveness of opposition and/or cancellation proceedings. The former type of action may be initiated following the acceptance of an application for registration. The second type of action may be undertaken after a mark is registered.

4. This subsection will reflect on the implications of registering a trademark, including those that are well-known or famous. Additionally, I will also reflect here on the status of unregistered marks, especially those that are well-known or famous.

5. This subsection will touch on the legal obligations akin to maintaining the validity of a trademark registration. I will examine how a trademark registration may be renewed from time to time.

Affecting Trademark Registrations;<sup>7</sup> Infringement of Trademark Rights; and Remedies.<sup>8</sup> Each subsection discusses issues pertaining to trademark protection and enforcement. This format will be followed in Part II of this Article where I will conduct a country-by-country examination of the respective trademark regimes in the ACME. However, I will also compare and highlight some differences and similarities between the trademark protection regimes in these countries.

The second part of this article is intended to examine the compatibility of the trademark regime in ACME with the “New-World Order” of intellectual property protection. I will examine whether the trademark laws in ACME are in harmony or, rather, in conformity with the modern standards of trademark protection as set by international agreements and conventions. Naturally, this section requires taking a closer look at the processes that took place or that are taking place in these countries as they amend their national trademark legislation to conform with modern standards of trademark protection as set by various international conventions and treaties.

The third part of this article is intended to complement the former two and will examine the effectiveness of trademark protection in ACME by shedding light on the sources, scope, and type of trademark infringement in ACME. In addition, I will examine the extent and impact of anti-infringement mechanisms in these countries. Here, I will deal with judicial as well as administrative enforcement of trademarks. Moreover, I will look at various activities taking place within ACME aimed at promoting the protection of IPRs.

## II. THE STRUCTURE AND CONTENT OF TRADEMARK LEGISLATION IN ARAB COUNTRIES OF THE MIDDLE EAST

### A. *Surveying Trademark Protection in Arab Countries of the Middle East*

#### 1. *The Arab Republic of Syria*

The trademark legal regime in Syria is founded on a number of national laws and legislative decrees each handling various aspects of trademark registration, administration, and protection.<sup>9</sup> The most notable of these laws is Legislative

---

6. In this subsection, I will discuss the various transactions affecting trademarks such as assignments, licenses, mergers, and changes of address and/or name. I will also consider the status of trademarks as collateral or a security interest.

7. Here I will examine the type of actions that may constitute infringement of trademark rights. My analysis will also touch on issues such as comparative advertising, gray market imports, and the clash between trademarks and trade names.

8. In this final subsection, I will examine the legal procedures and relief afforded by law to the proprietor of a trademark whose trademark right is infringed upon. Here, I will also examine the viability of invoking an unfair competition claim.

9. See JOHN R. OLSEN & SPYROS M. MANIATIS, TRADE MARKS, TRADE NAMES AND UNFAIR COMPETITION: WORLD LAW & PRACTICE, SWEET & MAXWELL, Syria § 1 (1998).

Decree No. 47 of 1946,<sup>10</sup> which was consequently amended by Law No. 28 of 1980.<sup>11</sup> This latter law is the main trademark law of Syria today. In addition to this law, Legislative Decrees Nos. 245<sup>12</sup> and 495,<sup>13</sup> both of 1952, provide for compulsory trademark applications and conditions of filing thereof.<sup>14</sup> Furthermore, Syrian Customs Law<sup>15</sup> devotes an entire section to trademarks and indications of origin.<sup>16</sup>

Trademarks were not the only IPR to receive attention in Syria. In February 2001 a new copyright law that complies with the Agreement on the Trade Related Aspects of Intellectual Property Rights (TRIPS) was introduced in Syria.<sup>17</sup> This new law introduced wide and comprehensive copyright coverage and protection, including written works, musical compositions, and computer software.<sup>18</sup> Examining and analyzing this new copyright law is beyond the limits of this research. However, it is worth noting that this law is deemed to be a clear indication of “Syria’s endeavor to enhance its position and to improve its intellectual property laws.”<sup>19</sup> Moreover, this new law is also considered to be a clear “statement of purpose” by the Syrian government to join the Bern Convention in addition to its already existing WIPO membership.<sup>20</sup>

---

10. Effective Oct. 9, 1946.

11. Enacted on Apr. 3, 1980 and effective July 16, 1980.

12. Effective May 26, 1952.

13. Effective Sept. 15, 1952.

14. See OLSEN & MANIATIS, *supra* note 9, Syria § 1. Trademark protection in Syria dates back to the Ottoman Empire, of which Syria was a part. However, Syrian trademark law cancelled all past legislation, including the Ottoman Law of March 11, 1888, the Ottoman Decree Concerning Trade and Industrial Marks of October 8, 1888 and Decision No. 769 of March 19, 1921 pertaining to the temporary protection afforded to participants of the 1921 Beirut Fair.

15. Syria Customs Law No. 9 (1975) (enacted Aug. 6, 1976).

16. See OLSEN & MANIATIS, *supra* note 9, Syria § 1; see also *Summary of Trademark Registration in Syria*, Abu-Ghzaleh Intellectual Property (AGIP), at <http://www.agip.com/countries/syria/t.htm> (last visited July 21, 2002). For a general background, see NJQ & Associates, *Trademarks: Syria*, at [http://www.qumsieh.com/tm\\_filing\\_syria.htm](http://www.qumsieh.com/tm_filing_syria.htm) (last visited Mar. 9, 2003) (copy on file with *The Transnational Lawyer*); see also Fadi Kardous, *Trademarks in Syria*, at <http://www.hg.org/art38.html> (last visited July 21, 2002) (copy on file with *The Transnational Lawyer*).

17. See *February 2001 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/2\\_01.htm](http://www.agip.com/agipnews/bulletin/2_01.htm) (last visited Mar. 8, 2003) (copy on file with *The Transnational Lawyer*) [hereinafter *February Bulletin*].

18. See *id.*

19. *Id.*

20. See *id.*

a. *Definition and Type of Protectable Marks*

Syrian trademark law defines a “trademark” in a vague yet expansive manner. One commentary sums up this definition in the following manner:

*“Any sign used to distinguish the nature and origin of any merchandize or any industrial, commercial, agricultural, forestal or mineral products.”<sup>21</sup>*

This expansive definition of a trademark includes names (both forenames and surnames), denominations, geographical terms, symbols, seals, stamps, letters (not forming a pronounceable word), impressions, numbers, alpha-numeric numbers, figures, marks capable of graphic representation, words, foreign words, devices (logos), labels, seals, holograms, shades of colors, signatures, three-dimensional objects, packaging, and slogans. Although the law includes no definition for service marks, as of 1980<sup>22</sup> Syrian law began to recognize the registrability of service marks by statute.<sup>23</sup> Likewise, protection is applied to collective marks,<sup>24</sup> certification marks, house-marks, designations of origin, and trade names.

Although this broad definition of trademark allows for a wide variety of marks, Syrian trademark law does not recognize certain types of marks. For example, audible sounds, musical notes, and monograms are not considered to be capable of registration. In addition, marks are not registrable if they are found to possess any of the following characteristics: deceptive, immoral, contrary to public policy or in conflict with a mark accorded a prior right. Syria law also limits the scope of this wide definition by providing a list of marks that may not be registered. These include:<sup>25</sup> “names, flags, and symbols of international organizations such as the Red Cross, Geneva Cross, Red Crescent, depiction of a crescent, lion, sun, etcetera. In addition, words such as “United Nations” and abbreviations like: UN, UNESCO, NATO, etcetera are similarly banned from registration.”

---

21. OLSEN & MANIATIS, *supra* note 9, Syria § 1; *see also* Syrian Trademark Law No. 28, art. 64 (1980), available at <http://www.agip.com/laws/syria/t.htm> (last visited Mar. 9, 2003).

22. *See* OLSEN & MANIATIS, *supra* note 9, Syria § 2 (noting that this amendment became effective July 16, 1980).

23. *See id.*

24. *See* Syrian Trademark Law No. 28, art. 66 (1980); *see also* OLSEN & MANIATIS, *supra* note 9, Syria § 4 (explaining that professional, regional, agricultural or industrial groups duly licensed by the Government may apply for the registration of collective marks, so as to make known the origin or proper manner of manufacture of their products). The members of such groups may use the collective mark independently of their individual marks. *Id.*

25. Syrian Trademark Law No. 28, art. 67; *see also* OLSEN & MANIATIS, *supra* note 9, Syria § 1. However, logically, these organizations or states may apply to register their respective marks that are noted in this definition. *Id.*



All state, national, and regional flags and symbols are not registerable. Consequently, names of countries, representations of heads of state, national arms, crests, flags of countries, and local administrative regions are banned from registration.<sup>26</sup>

Specific words such as “Patent,” “Patentee,” “Copyrights,” “Registered Design” or “Registered” may not constitute a component of a trademark. Interestingly, however, no provisions exist regarding the prohibition of marks that are generic or descriptive or that are similar to well-known marks.

*b. The Application Process*

Syrian trademark law appears very flexible in terms of submitting a trademark application. No formal pre-condition of use or intent to use is imposed. In addition, Syrian law lists a wide array of entities that are entitled to file trademark applications. These entities include individuals, legal entities, partnerships, collective groups and other professional, regional or industrial groups. What is more, in practice, no restrictions on holding companies are imposed. In this regard, the only limitation imposed on a foreign applicant is requiring him to appoint a trademark agent or attorney domiciled in Syria.<sup>27</sup>

In 1980, Syrian law adopted the international classification of goods and services.<sup>28</sup> However, an applicant is still entitled to broadly state the specification of the goods/services covered by his mark. Additionally, multi-class applications are permissible. Such applications also entail a reduction of the per-class filing fees.<sup>29</sup> However, where a multi-class application is determined to include an unacceptable class among other accepted classes, the latter are allowed to proceed to registration while only the former is detained.<sup>30</sup>

In addition to the application form, various documents may also be required.<sup>31</sup> For example, sometimes a declaration attesting to compliance with the provisions of the Arab boycott against Israel must be attached.<sup>32</sup> In addition,

---

26. See OLSEN & MANIATIS, *supra* note 9, Syria § 2.

27. See Syrian Trademark Law No. 28, art. 69.

28. See OLSEN & MANIATIS, *supra* note 9, Syria § 2.

29. See *id.* § 4.

30. See *id.* § 2.

31. See Syrian Trademark Law No. 28, art. 71. In addition, Article 72 sets out the requirement for the payment of application fees. See *id.* at art. 72; see also OLSEN & MANIATIS, *supra* note 9, Syria § 2. The following documents may be required: a) Certified copy of home registration or pending application for registration (required to substantiate a basis for application and formalities); b) Certificate of origin legalized by the Syrian Consul and a list of the main ingredients for pharmaceutical or medical products and soaps; c) An application is also required to submit representations of the mark; one Electro-type or ten prints of the mark; d) General powers are also accepted; e) An authorized officer of the corporate applicant must execute such powers. Signature stamps are not recognized.

32. This issue will be dealt with separately later on in this Article. See OLSEN & MANIATIS, *supra* note 9, Syria § 2; see also *February News Bulletin*, *supra* note 17 (noting that “once a trademark application is filed in the office of the Proprietary Protection Department (PPD), it is referred to the local Boycott of Israel Office for the necessary registration clearance”).

documents designating a general or specific Power of Attorney (POA) may be required. Although this POA may be submitted in Arabic, an English translation may also be appended. As of April 2001, the Syrian Proprietary Protection Department implemented a new procedure mandating POA for trademarks to be authenticated by the competent authorities in the applicant's country. Interestingly, no provisions deal with the possibility of filing disclaimers or letters of consent.<sup>33</sup>

Syrian law also allows an applicant to claim international priority under the Paris Convention. An applicant must claim priority at the time of filing his trademark application and must also state the particularities of the priority application, namely its country of application as well as its assigned number and date.<sup>34</sup>

Once an application is submitted it is remitted to examination by the trademark Office. The examination process encompasses all aspects of the application, namely for formalities, distinctiveness as well as potential conflicts with pending applications and existing registrations.<sup>35</sup> However, if the examiner determines the mark unregistrable, the examiner notifies the applicant of why it failed.

### *c. Finality of Acceptance and Registration*

Once an application is submitted, it is remitted to examination by the Trademark Office. The examiner reviews all aspects of the application, namely for formalities, distinctiveness, and potential conflicts with pending applications and existing registrations.<sup>36</sup> If and when an application is accepted, the director of the trademark office publishes it in the "Register of Deposits."<sup>37</sup> Unlike trademark laws in Jordan, Egypt, and Saudi Arabia (discussed below), Syrian law does not provide any provision for opposing the mark. Thus, any application that is accepted proceeds automatically to registration. In addition, the appeals process against the trademark registrar's decision is limited to cases where the trademark application is rejected.

With respect to cancellation proceedings, any interested person may initiate such a proceeding. Cancellation may be based on any of the following grounds:<sup>38</sup>

a. Prior registration, b. Prior use, and c. Prior applications.<sup>39</sup> These grounds are so

---

33. See OLSEN & MANIATIS, *supra* note 9, Syria § 3.

34. See Syrian Trademark Law No. 28, art. 129. In addition, the applicant must provide proof to support his priority claim by submitting a certified copy of a convention application within three months of filing his application with the Syrian Trademark Office.

35. See *id.* at art. 73 (detailing the examination process as well as the possibility of appeal). For further discussion on this point see OLSEN & MANIATIS, *supra* note 9, Syria § 2.

36. See Syrian Trademark Law No. 28, at art. 73.

37. For more on the publication process, see Syrian Trademark Law No. 28, arts. 74-77.

38. See OLSEN & MANIATIS, *supra* note 9, Syria § 3.

39. See OLSEN & MANIATIS, *supra* note 9, Syria § 3. *But see February News Bulletin, supra* note 17 (noting that there is no possibility for appeal even in cases where the application is rejected).

wide in scope so as to engulf grounds for opposition as well. Therefore, it may be deduced that oppositions, although not formally recognized, are in fact possible. Interestingly, however, non-use does not have any negative impact on the validity of a registration.<sup>40</sup>

A cancellation action must be brought before the courts within five years of the filing date. However, where it is shown that an application was filed in bad faith, no such time limitation applies.<sup>41</sup> Cancellation actions are adjudicated by the competent court of first instance. The decision may be appealed before the court of appeals and, ultimately, may be remitted to the court of cassation.<sup>42</sup>

#### *d. The Implications of Registration*

The right to a trademark is granted to the first to file or the first to use the mark in Syria. Trademark rights are recognized through use, and their registration is intended to confirm these rights.<sup>43</sup> After a mark is registered, it is protected in all forms, colors, and sizes.<sup>44</sup> Although registering a mark is not compulsory, in some cases Syrian law necessitates registering a mark used within a specific industry. Such compulsory registration relates to trademarks used on soaps and detergents (in class 3) and pharmaceuticals or medical products (in class 5).<sup>45</sup> This appears to be intended to protect the consumers in those two potentially dangerous sectors. Nevertheless, registration plays a crucial role in substantiating a right over a mark. Indeed, exclusive ownership of a mark may not be claimed if the mark has not been deposited with the Syrian Trademark Office known as “the Office for the Protection of Commercial and Industrial Property.”<sup>46</sup>

In this context, the question that arises is: what protection is granted to marks that are not registered?

The issue of registration, although important for providing full protection to trademarks, is not, as stated above, a pre-condition to granting protection in certain cases. This is evident with respect to the protection of unregistered, but famous trademarks in Syria. For example, the Syrian Ministry of Supply and International Trade clarified this in a 1997 resolution.<sup>47</sup> In that resolution, the Ministry noted that marks that are confusingly similar to unregistered famous marks cannot be registered.<sup>48</sup> Additionally, this resolution stated that trademarks cannot be re-

---

40. Syrian Trademark Law No. 28, arts. 80-84.

41. See Syrian Trademark Law No. 28, art. 82.

42. See OLSEN & MANIATIS, *supra* note 9, Syria § 3.

43. See Syrian Trademark Law No. 28, art. 83.

44. See OLSEN & MANIATIS, *supra* note 9, Syria § 4.

45. See *February News Bulletin*, *supra* note 17 (discussing additional required documentation in this case).

46. Syrian Trademark Law No. 28, art. 83.

47. See *Syria-New Resolution Affecting the Registration of Trademarks*, LADAS & PARRY (Ladas & Parry Newsletters & Bulletins, New York, N.Y.) (last modified July 15, 1997) at [http://www.ladas.com/Bulletins/1997/0797Bulletin/Syria\\_NewTMResolution.html](http://www.ladas.com/Bulletins/1997/0797Bulletin/Syria_NewTMResolution.html) (copy on file with *The Transnational Lawyer*).

48. See *id.* (reporting that the resolution also clarifies that marks may not be registered if they are

registered by a third party until three years have lapsed since their expiration.<sup>49</sup> This type of protection may be intended to protect consumers from confusion, and the “protection” afforded to the expired mark is only a by-product of this. Unregistered marks are also allowed if they are used during official, organized exhibitions held in Syria or other countries.<sup>50</sup>

Prior users of a mark are also afforded protection. A prior user’s right is defended solely on the fact that he has made use of his trademark in the past. This right applies even though the mark is not yet registered in Syria.<sup>51</sup> However, such action is limited to only five years from the date of registration. What is more, even after the expiration of the five-year period, a prior user is entitled to an additional fifteen years of use of his mark.<sup>52</sup> Such a prior user is required to prove continuous use of the mark before the filing of the application of the other, now registered mark.

A right of prior use is transferable with the business, and the owner of such right is entitled to bring civil action or a claim of unfair competition.<sup>53</sup> Importantly, Syrian law, in accordance with article 8 of the Paris Convention, affords protection to trade names that are protected even if they are not registered or included in a pending application.<sup>54</sup>

In Syria the symbol “®” is the accepted form of notice for a registered mark. There are no legal ramifications for not attaching this symbol to registered marks. However, any party that falsely indicates that a mark is registered in Syria is liable to criminal and/or civil penalties, imposed by law. Such provisions are “strictly enforced.”<sup>55</sup> The fact that a mark is registered outside of Syria constitutes no defense in such cases.<sup>56</sup>

#### *e. Maintenance, Duration, and Renewal of Trademarks*

Interestingly, Syrian law does not contain any provision regarding the issue of use as a condition for maintaining the validity of a trademark application.<sup>57</sup> It is therefore apparent that “use” does not constitute a condition for maintenance of a

---

geographical names or appellations of origin, color unless distinctively combined, words expressing a speculative meaning, inherited titles of royalty or nobility (*e.g.*, king, prince) or any other words (*e.g.*, modern, advanced), or if they allow to exaggerate the quality of the product covered by the mark).

49. *See id.*

50. *See* Syrian Trademark Law No. 28, arts. 85-90 (listing various requirements and noting that this protection applies to patents as well as designs and models).

51. *See* OLSEN & MANIATIS, *supra* note 9, Syria § 1. According to this commentary, a solid defense in such lawsuits is for the owner of the registration to show that he was unaware of the prior use of the mark by another at the time that he obtained his registration. *Id.*

52. *See* Syrian Trademark Law, No. 28, art. 84.

53. *See* OLSEN & MANIATIS, *supra* note 9, Syria § 1.

54. *See id.* § 6.

55. *See id.*

56. *See id.*

57. *See id.* § 4.

registered trademark. Similarly, the cancellation proceedings discussed above do not include a “cause of action” based on non-use. Also, as noted above, the owner of the registration is entitled, but not compelled, to place a registration notice of “Marque De’pos’ee.”<sup>58</sup> However, fraudulent use of such notice carries fines and/or imprisonment.<sup>59</sup>

As of the 1980 amendment<sup>60</sup> of Syrian trademark law, trademarks that are registered in Syria remain in effect for ten years from the date of registration.<sup>61</sup> In order to maintain their validity, trademark registrations may be renewed for consecutive periods of ten years each.<sup>62</sup> And, there is no limit on the number of possible renewals so long as the mark is being for the goods or services for which it was registered. When applying for renewal, no proof of use is required.<sup>63</sup> The two main required documents are an application for renewal and a POA.<sup>64</sup> A trademark registration may be renewed up to six months after the set renewal date. However, such late renewal is subject to additional fees.<sup>65</sup> Importantly, Syrian trademark law does not have a restoration provision. Therefore, it appears that no registration may be renewed if more than six months have lapsed since the renewal date.<sup>66</sup>

*f. Transactions and Changes Affecting Trademark Registrations*

Syrian trademark law allows the proprietor of a trademark registration to dispose of, or to transfer rights in his mark in various ways:<sup>67</sup>

- a. Assignment: A trademark registration may be assigned with or without the goodwill attached to the business.<sup>68</sup> The deed of assignment requires the signature of both parties.<sup>69</sup> Syrian trademark law compels

---

58. *Id.*

59. *See id.* (noting that fraudulently indicating that a mark is registered subjects the offender to a fine ranging between 50 and 500 Syrian Pounds and/or imprisonment for a term ranging between three months and three years).

60. *See id.* § 3 (highlighting that trademarks registered under the former law—before July 1980—remain valid for the full duration of the periods granted within the old law, *i.e.*, 15, 30, 46 or 60 years). However, upon expiration of these terms, these trademarks become subject to the ten year renewal term set by the 1980 amendment. *Id.*

61. *See* Syrian Trademark Law No. 28, arts. 70, 78 (1980).

62. *See id.* at arts. 70, 80; *see also* *February News Bulletin*, *supra* note 17.

63. The pre-1980 law did not function in accordance with the Nice International Classification of Goods and Services. Therefore, when renewing a mark filed before July 1980, the classes of goods covered by the registration should be designated to the new classification.

64. *See* OLSEN & MANIATIS, *supra* note 9, Syria § 3 (noting that the Power of Attorney is submitted in Arabic, may be either general or specific, and no legalization is required). For details of the required documents, *see* *February News Bulletin*, *supra* note 17.

65. *See* Syrian Trademark Law, No. 28, art. 79.

66. *See id.*

67. *See id.* art. 81.

68. *See* *February News Bulletin*, *supra* note 17; *see also* OLSEN & MANIATIS, *supra* note 9, Syria § 4.

69. *See* OLSEN & MANIATIS *supra* note 9, Syria § 4 (requiring the signature to be either handwritten or under seal, but in either case must be notarized and legalized). The deed of assignment should be in English or

the recordation of a trademark assignment within three months of the effective date of the assignment. Delayed recordation entails a fine.<sup>70</sup> Only after its recordation does an assignment become effective against third parties. Pending applications may not be assigned. In other words, the assignment of an unregistered mark is not legally recognized.<sup>71</sup> That is an additional significance of registering a trademark.

- b. Mergers: Mergers between a corporation that owns a trademark registration in Syria and another corporation, where the latter is the surviving company, is also to be recorded in the Syrian trademark register. Just as in the case of assignments, mergers must be recorded within three months of the effective date of the merger.<sup>72</sup> Similarly, a fine is imposed for late recordation. Upon the registration of the merger, the transfer of rights to the new entity becomes effective against third parties.<sup>73</sup>
- c. Licensing: Licensing is another widely used method of delegating rights in registered trademarks. Syrian trademark law also recognizes this form of transfer of rights. Interestingly, this law does not entail a quality control requirement. A quality control requirement is where the owner of the mark (or licensor) supervises the way in which the licensee is using the mark and the quality of the products/services that are being rendered under that licensed work. A license pertaining to use of a registered trademark should be recorded with the trademark office within three months of the effective date of the license agreement.<sup>74</sup> Such recordation renders the agreement effective against third parties. A minimal fee is imposed for late recordation.
- d. Changes in name and address: In addition to “physical” changes and transfer pertaining to trademark rights such as in the case of assignments, mergers and licensing, Syrian law requires recordation of changes in the name or address of the proprietor of a registration.<sup>75</sup> The rationale behind such a requirement is that the trademarks register should always reflect exact, valid and current information pertaining to trademarks registered

---

French and a sworn Arabic translation be prepared locally. *Id.* The consideration pertaining to the assignment transaction need not be stated on the deed. *Id.* Generally, nominal consideration of one dollar is stated on the deed. *Id.* The deed is filed with a sealed Power of Attorney and executed by the assignee. *Id.*

70. *See id.* (noting that delays in respect of assignments executed abroad are tolerated).

71. *See id.*

72. *See id.* Local Syrian Consul should legalize the merger certificate. In addition, the surviving company should execute a Power of Attorney under seal. The documents should be in English or in French. A sworn translation of these documents into Arabic may be prepared locally. Bilingual documents are accepted.

73. *See February News Bulletin, supra* note 17.

74. *See OLSEN & MANIATIS, supra* note 9, Syria § 5. To record the license, the original license agreement is required and the agreement must be duly notarized and legalized by the Syrian Consul.

75. *See id.* § 4. A change of name certificate should be legalized by the local Syrian Consul. *Id.* However, a change of address certificate may be prepared locally and the change of name certificate may be in English or in French. *Id.* A power of attorney under seal should be filed with the certificate. *Id.*

therein.<sup>76</sup> Any such change not duly recorded within three months entails a recurring and accumulating fine every two months.<sup>77</sup>

- e. Security interest: Syrian law recognizes the enforceability of security interests. This means that a mark can be mortgaged in order to secure an outstanding debt. If such debt is not paid then the mark may be transferred to the creditor. Consequently, a trademark registration may be the subject of a security interest that may be recorded with the trademark office. However, this is not common practice. In fact, it appears that no precedent of this nature exists in Syrian trademark practice.<sup>78</sup>

g. *Infringement of Trademark Rights*

According to Syrian trademark law, any person who forges or intentionally uses a registered trademark without the permission of its lawful owner, or who uses a similar mark with intent to deceive, infringes upon the rights of the owner of the original mark.<sup>79</sup> However, no statutory provision exists within Syria trademark law regarding comparative advertising.<sup>80</sup> It is, thus, unclear if such advertising is ultimately allowed or forbidden.

In cases where a trademark conflicts with a trade name,<sup>81</sup> an owner of the latter may initiate cancellation proceedings against the registration of the former. Such proceedings may only be initiated within five years of registration of the trademark. In such proceedings, the respective priority rights of the trade name and the trademark are measured against each other.<sup>82</sup> Importantly, if the mark is not registered, the owner of the trade name may institute infringement proceedings.<sup>83</sup>

h. *Remedies*

In cases of trademark infringement of registered marks,<sup>84</sup> the registrant is entitled to lodge a complaint with the public prosecutor.<sup>85</sup> The prosecutor, in turn,

---

76. *See id.*

77. *See id.*

78. *See id.*; *see also* Syrian Trademark Law No. 28, arts. 101-05 (1980).

79. *See* OLSEN & MANIATIS, *supra* note 9, Syria § 5.

80. *Id.*

81. *Id.* (noting that Article 24 of the Syrian Commercial Law compels traders to register their names in the commercial register. Furthermore, Article 26 (of the same law) obligates all Syrian and foreign companies with a head office in Syria to submit the deed of incorporation or articles of association).

82. *See id.*

83. *See* Syrian Trademark Law No. 28, art. 106 (discussing embezzlement of trade names).

84. *See id.* at art. 110 (limiting the remedies to owners of registered marks).

85. The prosecutor may act even without any formal complaint. *See* Syrian Trademark Law, No. 28, art. 117. In addition, article 118 defines those authorities entitled to act. *Id.* at art. 118.

may record or seize the infringing products.<sup>86</sup> Civil and/or criminal action must be filed by the registrant before the court within fifteen days of filing a complaint with the public prosecutor or of the drawing of the inventory.<sup>87</sup>

The courts are authorized to impose fines and/or imprisonment against the infringers.<sup>88</sup> In such cases of trademark infringement, the registrant is also entitled to damages, even in cases of acquittal in criminal proceedings.<sup>89</sup> In addition to these penalties, the law authorizes the destruction of infringing products.<sup>90</sup>

The law also imposes “social punishments” in the form of barring the infringer from membership in various political or commercial entities.<sup>91</sup> Indeed, by publishing (in newspapers) the details of the infringer and his deeds, the law attempts to create a deterrent to other potential infringers. The law also sets specific mandatory, minimum penalties for infringements pertaining to pharmaceutical products.<sup>92</sup>

Syrian unfair competition law provides similar remedies as exist under trademark law. This law provides a general norm prohibiting unfair competition.<sup>93</sup> That provision is (apparently) wide enough to cover cases involving industrial property rights.<sup>94</sup> This is because infringement of industrial property, including trademarks can be seen as a form of unfair competition. Patent rights are one type of industrial property rights, as well as trade secrets and industrial designs. Much like the penalties prescribed by trademark law, any acts amounting to unfair competition are punishable by fines and imprisonment in addition to other civil remedies such as injunctions and compensation.<sup>95</sup>

## 2. *The Hashemite Kingdom of Jordan*

Prior to 1999, Jordanian law did not recognize many aspects of modern trademark law. For instance, there was no clear recognition of service marks and no protection

---

86. See OLSEN & MANIATIS, *supra* note 9, Syria § 5. According to Article 113 of Syrian Trademark Law No. 28, courts can also issue seizure orders. See Syrian Trademark Law No. 28, art. 116. In addition, Article 119 defines the venues where such seizures may be carried out. *Id.* at art. 119. Articles 120 to 22 explain the procedures for conducting such seizures. See *id.*

87. See OLSEN & MANIATIS, *supra* note 9, Syria § 5.

88. See Syrian Trademark Law No. 28, arts. 101-05, 123-24; see also OLSEN & MANIATIS, *supra* note 9, Syria § 5. The fines may range from 100 to 500 thousand Syrian pounds and the terms of imprisonment can range from three months to three years.

89. See OLSEN & MANIATIS, *supra* note 9, Syria § 5; see also Syrian Trademark Law No. 28, art. 115.

90. See Syrian Trademark Law, No. 28, art. 112.

91. See *id.* at art. 114.

92. See *id.* at art. 108.

93. See OLSEN & MANIATIS, *supra* note 9, Syria § 6 (referring to Article 93 of Syrian Trademark Law No. 28).

94. See *id.*; see also Syrian Trademark Law No. 28, art. 84.

95. See OLSEN & MANIATIS, *supra* note 9, Syria § 5 (stating the fines that may imposed are equal to those imposed by trademark law; namely, ranging from 100 to 500 thousand Syrian Pounds). This also applies to prison terms, which range from three months to three years. See Syrian Trademark Law No. 28, art. 94.



for well known marks. However, in November 1999, the Jordanian legislature enacted a series of laws and amendments to its existing intellectual property laws.<sup>96</sup> These amendments aimed to bring Jordanian trademark law into conformity with international standards of IP protection as set by TRIPS. TRIPS requires member states to establish a minimum level of IPRs in their national law. With respect to trademarks, however, TRIPS sets various standards, including the recognition of service marks, setting a minimum, renewable term of protection at seven years, defining use requirements, and recognizing well-known marks even if not registered in the specific jurisdiction.<sup>97</sup> Consequently, the amendment covered a wide array of issues within the IP regime of Jordan.<sup>98</sup> These new laws together with other amendments and laws pertaining to other intellectual property matters (geographical indications, patents,<sup>99</sup> and copyrights<sup>100</sup>) rendered Jordan compliant with its TRIPS obligations.<sup>101</sup> Upon introducing these legislative changes, Jordan entered the WTO in 2000 and later signed a bilateral Free Trade Agreement with the United States.<sup>102</sup> Because becoming a member of the WTO and opening up further business with the United States was a priority for Jordan, the implementation of these new amendments was a worthwhile step for the country.

---

96. Jordanian Trademark Law No. 34, Official Gazette No. 4389 (1999), available at [www.agip.com/laws/jordan/t.htm](http://www.agip.com/laws/jordan/t.htm) (last visited Feb. 24, 2003). The amendment was ratified on September 22, 1999, published in the Official Gazette No. 4389 on November 1, 1999, and came into effect a month later. See generally *Frequently Asked Questions on Jordan, August 2001 News Bulletin*, AGIP, at [http://agip.com/agipnews/bulletin/8\\_01.htm](http://agip.com/agipnews/bulletin/8_01.htm) [hereinafter *August News Bulletin*]; see also Diala Al-Alami & Ashraf Atout, *Jordan: Note on New Amendments to the Trademark Law*, ARAB L. Q. 103 (2000) (providing a comprehensive overview of the amendments to the trademark law).

97. See KEITH E. MASKUS, *INTELLECTUAL PROPERTY RIGHTS IN THE GLOBAL ECONOMY*, INST. FOR INT' L ECON. 15-26 (2000).

98. In addition to trademark issues included in the amendment, the amendment covers also covered other issues including nominal workings of patents as well as registration of designs and industrial models. With respect to the former, it should be noted that this legal construction constitutes a substitute to actual exploration of a patent, thereby evading compulsory licensing of said patent. A "Nominal Working of a Patent" may be "attained by publishing a notice in a daily newspaper every two years inviting interested parties to exploit the relevant patent." See *September 2001 News Bulletin*, AGIP, at [http://agip.com/agipnews/bulletin/9\\_01.htm](http://agip.com/agipnews/bulletin/9_01.htm) (last visited Apr. 7, 2003) [hereinafter *September News Bulletin*].

99. See Amending Patent Law of 2001, Provisional Law No. 71, reprinted in *December 2001 News Bulletin*, available at [http://agip.com/agipnews/bulletin/12\\_01.htm](http://agip.com/agipnews/bulletin/12_01.htm) (last visited Feb. 24, 2003) [hereinafter *December News Bulletin*].

100. See Amending Copyright Law of 2001, Provisional Law No. 52 reprinted in *September 2001 News Bulletin*, AGIP, at [http://agip.co/agipnews/bulletin/9\\_01.htm](http://agip.co/agipnews/bulletin/9_01.htm).

101. *King Abdullah Given Award for Efforts to Combat Software Piracy*, JORDAN TIMES, Feb. 7, 2001, at [www.jordanembassyus.org/020720011006.htm](http://www.jordanembassyus.org/020720011006.htm) (last visited Feb. 24 2003) (copy on file with *The Transnational Lawyer*).

102. *Id.*

In this section, I discuss the Jordanian trademark regime from its inception in 1952 to the substantive changes introduced by the new trademark law of 1999.<sup>103</sup> However, the reader should note that the new Jordanian trademark law, “the Amended Trademark Law for the Year 1999,”<sup>104</sup> should be read in conjunction with the “old” Jordanian trademark law of 1952.<sup>105</sup> The new amendment supplements the old law and mainly address the modern developments in trademark law. Although the new amendment mainly contains substantive requirements, it also addresses procedural and administrative functions.<sup>106</sup>

*a. Definition and Type of Protectable Marks*

According to the Jordanian Trademark Law of 1952, various types of marks are registrable. Protection is extended not only to traditional types of trademarks, but to certification marks,<sup>107</sup> collective marks,<sup>108</sup> and corporate names.<sup>109</sup> Jordanian law defines a trademark as:

*“A mark used or proposed to be used upon or in connection with goods so as to indicate that they are the goods of the proprietor of such trademark by virtue of manufacture, selection, certification, dealing with or offering for sale.”*<sup>110</sup>

As such, Jordanian trademark law allows registering marks consisting of words, devices (logos), labels, seals, holograms, shades of colors, signatures or a combination thereof. Trademark protection may also be extended to product trade dress (packaging).<sup>111</sup> Slogans may be registered only if the applicant submits a disclaimer stating these are words only reserved in this combination of the

---

103. See generally ST&P Attorneys and Agents, *Jordan*, at <http://www.stplegal.com/trademarks/trade-marks.asp?ID=62> (last visited Apr. 7, 2003) (copy on file with *The Transnational Lawyer*); see also NJQ & Associates, *Trademarks: Jordan*, at [http://www.qumsieh.com/trademarks/arab/tm\\_filing\\_jordan.htm](http://www.qumsieh.com/trademarks/arab/tm_filing_jordan.htm) (last visited July 21, 2002) (copy on file with author).

104. Jordanian Trademark Law No. 34, Official Gazette No. 4389 (Nov. 1, 1999).

105. Jordanian Trademark Law No. 33 (effective July 1, 1952).

106. See *id.* at art. 3.

107. A certification mark is that used by a “legal person for certifying the origin of goods not manufactured by him or the materials out of which they were made or the manufacturing precision or other characteristic of those goods.” See OLSEN & MANIATIS, *supra* note 9, Jordan § 1 (noting that any entity may apply to register a certification mark if that entity uses the marks to certify the origin, material, mode of manufacture, quality of goods and services, and competency to do so).

108. Jordanian Trademark Law No. 34, art. 10; see also WORLD INTELLECTUAL PROPERTY ORGANIZATION, *INTRODUCTION TO INTELLECTUAL PROPERTY THEORY AND PRACTICE* 185 (1997) [hereinafter *THEORY & PRACTICE*] (noting that a collective mark is owned by a parent/association that allows its members to use its mark).

109. See OLSEN & MANIATIS, *supra* note 9, Jordan § 1. Corporate names may be registered and protected through the Companies Law No. 1 of 1989.

110. See *id.*

111. See Jordanian Trademark Law No. 34, art. 7; see also OLSEN & MANIATIS, *supra* note 9, Jordan § 2.

mark.<sup>112</sup> Notably lacking within the 1952 law is a provision defining or addressing a service mark. What is more, even the international classification system, applicable in Jordan since 1952, did not include service classes.<sup>113</sup> However, this deficiency was remedied by the passage of article 2 of the 1999 Jordanian Trademark Law. Under this piece of legislation, trademarks were redefined as:

*“Any visually perceptible sign used or to be used by any person for distinguishing his goods or services from those of others.”*

On the flip side, Jordanian law also identifies various types of non-registrable marks:<sup>114</sup>

- a. Generic or descriptive marks: Such marks are typically composed of letters or words that are commonly used to distinguish or describe certain goods.
- b. Deceptive marks: deemed to be potentially deceiving for the consuming public, or which allow unfair competition or contain false indications of origin.
- c. Marks perceived to be immoral or contrary to public order.
- d. Marks that are identical or confusingly similar to a registered trademark for the same goods or the same class of goods.
- e. Marks containing religious significance.
- f. Marks containing the picture, name or trade name of another. In this case the registrar would typically require the consent of such person or entity or the consent of their legal representative.

In addition to these unregistrable marks, the following marks are unprotectable except where certain conditions are met:<sup>115</sup>

- a. A mark containing a geographical name, except if that name is not well-known in Jordan.<sup>116</sup>
- b. A mark containing a surname only if that name is not well-known in Jordan. Similarly, a forename is registrable as a trademark if it is not

---

112. Jordanian Trademark Law No. 34, art. 7.

113. This “old” international classification was adopted by Jordanian law on July 1, 1952.

114. Jordanian Trademark Law No. 34, arts. 8-9 This section should be read in conjunction with my above discussion of prohibited marks. These too may not be registered. So there are two groups of marks that may not be registered. Those that are considered marks but are prohibited from registration due to the fact that they belong to another, and those that do not qualify as marks in the first place. See OLSEN & MANIATIS, *supra* note 9, Jordan § 2.

115. See OLSEN & MANIATIS, *supra* note 9, Jordan §§ 2-3.

116. In this regard, see also Jordanian Geographical Indications Law, No. 8, Official Gazette No. 4423 (2000).

identical or similar to the name of a well-known personality or celebrity figure.

- c. Marks consisting of letters not forming a pronounceable word, except if they are combined with a device or that letters are stylized and provided that owner of the mark submits a disclaimer of the letters except in the combination of the mark.
- d. Marks constituting of foreign words, except where the applicant submits a translation of the words and disclaims any of them as required by the trademark registrar.

Much like its Syrian counterpart, the Trademark Law of 1952 details various types of marks for which registration is prohibited in Jordan. These include:<sup>117</sup>

- a. Marks that are identical or similar to names, flags or symbols of international organizations.<sup>118</sup> In addition, marks containing specific symbols such as the Olympic symbol are prohibited from registration.<sup>119</sup> Similarly, certain words and abbreviations are prohibited.<sup>120</sup>
- b. Flags and symbols representing states, nations or regions or marks that are confusingly similar to them. Therefore, arms crests or names of countries as well as representations of heads of state or sovereigns, flags of countries and local administrative regions are all prohibited from being registered as trademarks.<sup>121</sup> However, such a prohibition may be circumscribed where the government authorizes such registration.
- c. Official hallmarks or warranty unless plainly authorized are unprotectable. Official hallmarks refers to insignia of the King or the country or marks indicating an official designation.<sup>122</sup> Similarly, the law prohibits registration of marks that contain words such as: "Patent," and "by Royal Letters Patent." In addition, "Registered," "Patented," "Registered design," "Copyright," and "To counterfeit this Product is Forgery," etcetera.<sup>123</sup>

---

117. See OLSEN & MANIATIS, *supra* note 9, Jordan § 1.

118. Such as the insignia of the Red Crescent, the Red Cross or the Geneva Cross.

119. Similarly, marks containing a depiction of a lion or the sun.

120. A name like "United Nations" and abbreviations like "UN," "UNESCO" or "NATO" would be included in this category of prohibited marks. For more information, see OLSEN & MANIATIS, *supra* note 9, Jordan § 1.

121. See *id.* §§ 1-2 (noting that this category specifically includes public emblems, crests, insignia or decorations of the Hashemite Kingdom of Jordan as well as its military or naval flags as well as honorary decorations). This prohibition similarly applies to words or phrases implicitly or explicitly implying Royal patronage such as "Royal." *Id.*

122. See Jordanian Trademark Law No. 34, art. 8 §§1-3.

123. See OLSEN & MANIATIS, *supra* note 9, Jordan §§ 1-2.

In sum, subject to certain exceptions, the 1952 Jordanian law allows for a wide array registerable marks. Notwithstanding this flexibility, audible sounds, musical notes, and three-dimensional objects are not registrable.<sup>124</sup> This is consistent with the Syrian law discussed above and for much the same reasons are unprotectable.

The Jordanian Legislature supplemented the Jordan Law of 1952 by enacting two separate trade and corporate name registers.<sup>125</sup> Although only applicable to trade and corporate names, the Trade Names Register Law No. 30 of 1953 and the Companies Law No. 30 of 1989 provide further trademark-like protection against confusingly similar trade names or trademarks.<sup>126</sup> This law was necessary because trade names could not be registered, even under the newly amended law.

However, similar limitations to those imposed on trademarks are placed on trade names.<sup>127</sup> For example, trade names may not be registered if they are used for fraudulent or illegal purposes or that violate public or moral values.<sup>128</sup>

From the outset, Article 2 of the amended Jordan law addresses three “new” terms which are substantial in regard to trademark protection, the service mark,<sup>129</sup> the well-known mark,<sup>130</sup> and the collective mark.<sup>131</sup> Each of these types of marks were given the same legal standing as trademarks. Thus, the 1999 amendment allowed for the registration and protection of service marks, well known marks, and collective marks. Prior to the amendment, applicants could only protect service marks under the default of class 16. Now, these marks may be registered and the class for service marks has been divided into four new separate classes of services.

These new classifications became effective on January 1, 2002.<sup>132</sup> Similarly, prior to 1999 no specific provision was aimed at protecting well-known marks, and it was not until the 1999 amendment of Jordanian trademark law that well-known marks were expressly protected. Article 2 of the amended law defines a well-known (famous) mark as:

*“The mark with a world renown whose repute surpassed the country of origin where it has been registered and acquired fame*

---

124. See *id.* at Jordan § 2. Although three-dimensional trademarks may not be registered as trademarks, the Design and Industrial Models Law allows filing such a mark as an industrial model. Such a registration will grant its owner protection for fifteen years. In this regard, see *September News Bulletin*, *supra* note 98.

125. See OLSEN & MANIATIS, *supra* note 9, Jordan § 6.

126. See *id.*

127. See *id.*

128. See *id.*

129. See Al-Alami & Atout, *supra* note 96, at 103 (viewing the addition of service marks as the “most substantial ratification”).

130. See Jordanian Trademark Law No. 34, art. 2 (1999) (defining a well-known mark as that “with a world renown whose repute surpassed the country of origin where it has been registered and acquired fame in the relevant sector among the consumer public in the Hashemite Kingdom of Jordan.”).

131. A collective mark is intended to indicate the affiliation of enterprises using the mark under certain quality standards.

132. See Al-Alami & Atout, *supra* note 96, at 103.

*in the relevant sector among the consumer public in the Hashemite Kingdom of Jordan.”*

However, that is not to say that well-known marks were without protection. In fact, two practical defenses against unauthorized use of well-known marks were employed.<sup>133</sup> First, an examiner that identifies a certain mark as being owned by a third party may, based on his own personal knowledge, refuse to register the mark in the name of the applicant. Second, any party who claimed right to a well-known registered mark was entitled to institute opposition proceedings against its registration.

The amended Jordanian law also provides for well-known or famous marks. Accordingly, the amended Jordanian law now prohibits the registration of a trademark that is identical or similar to or constitutes a translation of a “well-known mark” as defined in TRIPS.<sup>134</sup> This protection extends to cases where the mark applied for is intended to cover similar or identical goods. Where the two marks cover different goods, registration of the new mark is prohibited if deemed to hamper the interests of the owner of the well-known mark or where the new mark may misleadingly cause consumers to associate between the owner of the well-known mark and the new mark.<sup>135</sup>

In determining whether a certain mark may qualify as a well-known mark, Jordanian law draws from two indications: that the notoriety of the mark has surpassed the borders of its country of origin, and that the mark is well-known to the relevant consumer segment in Jordan.<sup>136</sup> Notwithstanding this protection of well-known marks, commentators still advise the registration of such marks to evade problems.<sup>137</sup>

The examination process in Jordanian trademark law would typically focus on the distinctiveness of the mark and on possible conflicts with other pending applications or existing registrations.<sup>138</sup> The registrar is authorized to impose disclaimers for registrations.<sup>139</sup> Broadly speaking, for a mark to be registrable, it must be distinctive, novel, and otherwise not prohibited by law. For example, it is unregistrable where it is contrary to public policy or morality.<sup>140</sup>

In view of the importance hinged on the distinctiveness of a mark as a precondition for its acceptance for registration, the trademark registrar is qualified to

---

133. See OLSEN & MANIATIS, *supra* note 9, Jordan § 2.

134. See Jordanian Trademark Law No. 34, art. 8(12) (prohibiting the registration of marks “whether identical or similar to or constitutes a translation of, a famous trademark.”).

135. See *id.*

136. See *September News Bulletin*, *supra* note 98.

137. See *id.*

138. See OLSEN & MANIATIS, *supra* note 9, Jordan §§ 2-3. In such event, letters of consent by the owner of a prior registration are considered by the registrar.

139. See Jordanian Trademark Law No. 34, art. 12.

140. See OLSEN & MANIATIS, *supra* note 9, Jordan § 2.

require amendments or additions that he deems necessary for mark distinctiveness.<sup>141</sup> In addition, the registrar is entitled to impose territorial limitations on use and on “good-faith” current users of the mark.<sup>142</sup>

*b. The Application Process*

Any person or business is entitled to apply to register a mark in Jordan.<sup>143</sup> Article 6 of the amended Jordanian trademark law states that:

*“A person desiring to have the exclusive use of a trademark for distinguishing goods of his own production, manufacture, selection, or in respect of which he issued a certificate, or goods in which he trades or intends to trade, may apply for the registration of such a mark in accordance with the provisions of the law.”*

In order to register a mark, one need not show prior use of the mark. It is sufficient to base the application on intent to use; however, there is no provision as to when the registrant must use the mark.<sup>144</sup> However, an applicant may need to establish his right to register the mark when challenged.<sup>145</sup>

Jordanian trademark law does not allow for multiple class applications.<sup>146</sup> Separate applications are required for each class. To illustrate this point, suppose Nike wants to register its swoosh symbol, it would register it under class 25 because that is the classification for sportswear. However, if Nike wished to use the same mark on a boardgame, it would have to file under a different classification. Nevertheless, the specification of goods in each class need not be detailed and may be rather broadly stated.<sup>147</sup>

Additionally, Jordanian law is rather lax regarding documentation that is required when applying for a trademark.<sup>148</sup> For example, no special documentation is required to establish the legality of an application. All that is required is a general or specific POA.<sup>149</sup> In this regard, it appears that this simplistic approach to registering trademarks in Jordan contributed to the registration of hundreds of trademarks (most of which are well-known) in Jordan

---

141. *See id.*

142. *See id.*

143. *See* Jordanian Trademark Law No. 34, arts. 6, 11.

144. OLSEN & MANIATIS, *supra* note 9, Jordan § 2.

145. *See id.*

146. *See id.*

147. *See id.*

148. *See id.*

149. *See id.* Such a power of attorney should be in Arabic and must be notarized and legalized; general powers are also accepted.

that were later contested by (generally) foreign third parties who claimed the right to use those marks.

At the time of filing an application, an applicant may claim priority based on a foreign application by noting his claim in the application and disclosing the name of the country of the priority application as well as the application number and date.<sup>150</sup> Article 17 of the amended law addresses cases involving rival claims to identical marks. Such cases are either settled by the parties themselves (coexistence agreement) or referred to the Jordanian High Court of Justice (the highest judicial court in the country).

*c. Finality of Acceptance and Registration*

An applicant has a right to appeal to the High Court if the registrar rejects his application. This does not include cases where the rejection emanates from opposition proceedings.<sup>151</sup> However, where an application is accepted, it is published in the Official Gazette.<sup>152</sup> According to the law, any person has standing to file an opposition (within three months of the publication date) against the registration of a mark.<sup>153</sup> The opposition may be based on a host of causes, including prior registration or prior application or prior use of the mark by another.<sup>154</sup> The trademark registrar is authorized to hear oppositions and decide cases based on evidence submitted before him. The registrar's decision may be appealed before the Jordanian High Court of Justice.<sup>155</sup>

Similarly, a mark registration may be revoked. The amended law (Article 22.1) allows any interested party to request cancellation of a registered mark. Such a petition may be filed with the trademark registrar or the Jordanian High Court.<sup>156</sup> Such a petition may be successful if it is shown that the registered mark had not been used in Jordan for three consecutive years.<sup>157</sup> The petition for cancellation of a registration may be based on any of the following: a) non-use;

---

150. See Jordanian Trademark Law No. 34, art. 41; see also OLSEN & MANIATIS, *supra* note 9, Jordan § 3. Both partial as well as multiple priority are available; consequently, in order to support such a priority claim, a certified copy of a convention application must be filed no later than three months of the filing date in Jordan. See Al-Alami & Atout, *supra* note 96, at 105.

151. See OLSEN & MANIATIS, *supra* note 9, Jordan § 3.

152. See Jordanian Trademark Law No. 34, art. 13.

153. See *id.* at art. 14; see also OLSEN & MANIATIS, *supra* note 9, Jordan § 3 (noting that an extension of time to file an opposition may be granted by filing an extension request before the deadline).

154. See Jordanian Trademark Law No. 34, art. 13 (recognizing the possibility of opposing a trademark based on any reason that causes the mark to be contrary to the law).

155. See *id.* The statement of appeal should be submitted within 20 days of the decision. See *Jordanian Trademark Summary*, AGIP, at <http://www.agip.com/countries/jordan/t.htm> (last visited Apr. 7, 2003) [hereinafter *Jordanian Trademark Summary*].

156. See OLSEN & MANIATIS, *supra* note 9, Jordan § 3. (noting that before the amendment, the term was two years). The petitioner is at liberty to choose between the two tribunals. *Id.*

157. See Jordanian Trademark Law No. 34, art. 22 (raising the grace period of non-use from two years to three years).



b) contradicting the law; or c) unfair competition.<sup>158</sup> The owner of such registration may defend by showing that his lack of use was due to special circumstances.<sup>159</sup> Indeed, as shown below in my survey of Jordanian court rulings (pertaining to trademarks), the Jordanian courts generally defend well-known marks from being registered by other than their true owners. What is more, registrations of such well-known marks that were later successfully contested were cancelled.

*d. The Implications of Registration*

Registration grants the registrant the exclusive right to use the trademark.<sup>160</sup> However, in Jordan, registration is not always a precondition to providing defense to a mark. This is exemplified in four ways:<sup>161</sup>

- a. A well-known mark may be defended even if not registered in Jordan.
- b. A mark whose registration has expired may not (subject to some exceptions) be registered by a third party within one year from the date of cancellation.<sup>162</sup> This rule is similar to that found in Syrian trademark law.
- c. A first user of a mark may attempt to cancel a subsequent registration. However, he is not entitled to damages but may sue for passing off, which is a cause of action based on the deceptive act of misleading customers as to true origin of the goods.<sup>163</sup>
- d. Temporary protection is granted to marks (even if not registered) that are used during a convention or an exhibition.<sup>164</sup>

In Jordan, the ® symbol is an acceptable form of notice. Not using the symbol has no affect on the validity of the registration.<sup>165</sup> However, where a mark is

---

158. See OLSEN & MANIATIS, *supra* note 9, Jordan § 4 (noting that a petition to cancel must be filed within five years of its registration).

159. See *September News Bulletin*, *supra* note 98. In practice, the owner of a registration, which is the subject of cancellation proceedings, may elect to file a new application for an identical mark. This way if the existing registration is cancelled, then the new “auxiliary” application/registration will fill the resulting void.

160. See Jordanian Trademark Law No. 34, art. 26. The registration is *prima facie* evidence of validity of the registration of the trademark for all subsequent assignments and other transactions. See OLSEN & MANIATIS, *supra* note 9, Jordan § 1.

161. See Jordanian Trademark Law No. 34, art. 26(1)(b).

162. See OLSEN & MANIATIS, *supra* note 9, Jordan § 4 (noting that the registrar may allow such registration by a third party if he is satisfied that there has been no bona fide use of the trademark during two years immediately preceding its renewal date (that lapsed) or that confusion is not likely to arise from use of the mark); see also Al-Alami and Atout, *supra* note 96, at 105.

163. See OLSEN & MANIATIS, *supra* note 9, Jordan § 1.

164. Al-Alami and Atout, *supra* note 96, at 105.

165. See generally *International Trademark Association Forms of Notice Sub-Committee, Issues and*

falsely indicated with ®, a fine might be imposed.<sup>166</sup> In such cases it is no defense to show that the mark is in-fact registered outside Jordan.<sup>167</sup>

*e. Maintenance, Duration, and Renewal of Trademarks*

There is no formal requirement for use of a trademark. However, as discussed earlier, a registered mark that is not used for three consecutive years may be subject to cancellation. The amended law sets the initial term of registration at ten years from the date of filing an application. However, renewal is required to maintain the validity of a registration. A one-month delay in submitting the renewal application is allowed. The registration may be renewed for subsequent terms of ten years each.<sup>168</sup> No proof of use is required when requesting to renew a registration.<sup>169</sup> However, once a registration expires, it is struck from the register and restoration is not possible unless the full application procedure is resubmitted.<sup>170</sup>

*f. Transactions and Changes Affecting Trademark Registrations*

Jordanian trademark law allows the rights associated with a mark to be transferred in essentially three ways. A mark may be assigned, licensed, and transferred as a security interest.<sup>171</sup>

According to Article 19 of the amended law, trademarks may be transferred by assignment, which appears to be the most commonly used method of transfer.<sup>172</sup> Interestingly, one does not automatically transfer any of the intangible assets such as the business reputation or goodwill unless provided for by agreement. In other countries, trademark assignments automatically include the transfer of goodwill.<sup>173</sup> This transfer must meet formal requirements, however. There must be a writing, signed by both parties, usually called a deed of assignment, and a POA signed by the assignee. Finally, it must also be supported by at least nominal consideration.<sup>174</sup> In addition, assignments should be recorded

---

*Policy Committee, International Use and Recognition of Trademark Forms of Notice*, at <http://www.inta.org> (last visited Apr. 7, 2003) [hereinafter INTA] (copy on file with author).

166. See Jordanian Trademark Law No. 34, art. 33.

167. INTA, *supra* note 165.

168. See Jordanian Trademark Law No. 34, arts. 20-21; see also Al-Alami and Atout, *supra* note 96, at 104. Before the amendment, the periods were seven years and 14 years respectively. See OLSEN & MANIATIS, *supra* note 9, Jordan § 4.

169. For details of the documents that are required to renew a registration, see OLSEN & MANIATIS, *supra* note 9, Jordan § 4.

170. See *id.*

171. See Jordanian Trademark Law No. 34, art. 19. Unlike other marks, certification marks can only be transferred with the permission of the registrar.

172. See THEORY & PRACTICE, *supra* note 108, at 214.

173. See Jordanian Trademark Law No. 34, art. 19.

174. See OLSEN & MANIATIS, *supra* note 9, Jordan § 4.

with the trademark office within six months or else the assignee will be subject to penalties, including evidentiary penalties.<sup>175</sup> For example, an unrecorded assignment will not be admissible as evidence of proof of title in litigation proceedings.<sup>176</sup> Only after recording the assignment will it become effective against third parties. Similar to the law of both Syria and Saudi Arabia, only registered trademarks may be assigned and recorded with the trademark office.<sup>177</sup>

The possibility of licensing a trademark is also recognized by Jordanian law, but only with respect to registered marks.<sup>178</sup> The right to license a trademark remains subject to some scrutiny and limitations. For example, the license must be made in a notarized contract and filed with the Register. In addition, no quality control is required for maintaining the validity of license agreements.<sup>179</sup> Moreover, where such a transfer adversely affects competition or creates unfair competition it will not be permitted because the license is subject to Article 9 of the new Trade Secrets and Unfair Competition Law of 2000.<sup>180</sup> This law states that provisions within licensing agreements that prevent or hamper fair competition are void.<sup>181</sup> This rule is worded expansively to include cases where a license agreement overshadows an entire market. This appears to be an anti-trust provision.

When a trademark owning entity merges with another entity, the merger should be recorded with the Trademark Office.<sup>182</sup> Failure to do so prevents the surviving entity from exercising rights over the marks such as filing a renewal application, assigning the mark to others, and even instituting infringement actions.<sup>183</sup>

Jordanian law requires a trademark owner whose name is altered to record such change.<sup>184</sup> Only after its recordation does the change of name become effective against third parties.<sup>185</sup> However, recordation of the license itself is not compulsory.<sup>186</sup>

---

175. See Jordanian Trademark Law No. 34, art. 23.

176. See OLSEN & MANIATIS, *supra* note 9, Jordan § 4.

177. See *id.* (pending applications may not be assigned).

178. See Jordanian Trademark Law No. 34, arts. 26(2)-(3); see also OLSEN & MANIATIS, *supra* note 9, Jordan § 5.

179. See OLSEN & MANIATIS, *supra* note 9, Jordan § 5.

180. The Jordanian Trade Secrets and Unfair Competition Law No. 15, Official Gazette No. 4433 (Apr. 2, 2000), available at <http://www.agip.com/laws/jordan/t.htm>. The previous law that dealt with unfair competition was the Jordanian Merchandize Law No. 19 of 1953; see OLSEN & MANIATIS, *supra* note 9, Jordan §§ 5-6.

181. The Jordanian Trade Secrets & Unfair Competition Law No. 15, art. 9.

182. See OLSEN & MANIATIS, *supra* note 9, Jordan § 5 (noting the documentation needed in order to record such merger includes: a merger certificate or a declaration regarding the merger made by an authorized officer of the surviving entity and a power of attorney from the surviving company).

183. See *id.*

184. See *id.*

185. See *id.*

186. See OLSEN & MANIATIS, *supra* note 9, Jordan § 5; see also Al-Alami & Atout, *supra* note 96, at 105 (stressing that "the duration of the license shall not exceed the protection period afforded by the registration").

Lastly, under Jordanian law, a trademark may also function as a legally enforceable security interest.<sup>187</sup> Again, like the assignment and license, this must be in writing. However, in practice, creating a security interest is rarely exercised.<sup>188</sup> Nevertheless, such a security interest may be recorded with the Trademark Office only if a court order is issued to this effect.<sup>189</sup>

*g. Infringement of Trademark Rights*

Jordanian trademark law deems various acts to constitute trademark infringement.<sup>190</sup> These include:

- i. Use of a registered trademark or a mark confusingly similar to it with respect to goods or services of the same class.
- ii. Engaging in any act (such as selling, storing and exhibiting), which aim is to sell goods under infringing marks.
- iii. Use of another's registered mark for the purpose of promoting goods or services of the same class. Effectively, this could be interpreted to cover cases of comparative advertising.<sup>191</sup>
- iv. Facilitating or assisting a third party in the infringement of another's marks.<sup>192</sup>
- v. An infringement action may also be brought by owners of unregistered famous marks for the goods or services.<sup>193</sup>

*h. Remedies*

Jordanian trademark law affords various types of relief to owners of registered marks.<sup>194</sup> These include seizure, confiscation or destruction of infringing goods.<sup>195</sup> Damages may also be awarded.<sup>196</sup> In addition, infringement

---

187. *See id.*

188. *See id.*

189. *See id.*

190. *See id.* § 6.

191. *See* OLSEN & MANIATIS, *supra* note 9, Jordan §§ 5-6 (highlighting the fact that no special provision exists for comparative advertising).

192. *See* OLSEN & MANIATIS, *supra* note 9, Jordan § 6 (including any manufacturing, engraving or selling of a plate seal that allows others to forge another's trademark or make a confusingly similar imitation of that mark).

193. *See* Jordanian Trademark Law No. 34, arts. 26(b), 38; *see also* Al-Alami & Atout, *supra* note 96, at 103-04.

194. *See* Jordanian Trademark Law No. 34, art. 34.

195. *See id.* at arts. 38-39 (noting that even wrapping, packaging or advertising materials pertaining to such infringing goods may be seized, confiscated or destroyed).

196. *See* OLSEN & MANIATIS, *supra* note 9, Jordan § 6.

constitutes a criminal offence punishable by imprisonment or fines.<sup>197</sup> Therefore, a criminal case may be filed simultaneously with a civil action for damages.<sup>198</sup>

Jordanian courts are authorized to order infringers to cease and desist from infringing actions. In addition, the courts may order the executive authority to carryout search and seizure actions against infringers and their merchandise.<sup>199</sup>

In addition, the new Jordanian IP legislation “bundle” includes another body of legislation bearing on trademark protection, namely The Jordanian Trade Secrets and Unfair Competition Law. Articles 2 and 3 of this law address unfair competition. Article 2 defines “unfair competition” as:

*“Any competition contradictory to the honest practices in the commercial and industrial activities.”<sup>200</sup>*

In addition to this general and expansive definition, the article defines specific conduct deemed to constitute unfair competition, including:

- a. “Activities that may, by nature, cause confusion with entity, products or commercial or industrial activities of one of [the] competitors.”<sup>201</sup>
- b. Causing deprivation of trust from one of the competitors’ entities, products or commercial activities.<sup>202</sup>
- c. Misleading the consumer public with respect to a product’s nature, properties, content, use or method of manufacturing.<sup>203</sup>
- d. Any practice that hampers a product’s reputation or causes confusion regarding the product’s form, shape or presentation.<sup>204</sup>

Importantly, this law specifically recognizes unfair competition related to trademarks or service marks used in Jordan. Such unfair competition can occur for registered and unregistered Jordanian marks.<sup>205</sup> Hence, where a trademark or service mark owner claims an infringement upon his mark, he may also elect to sue for damages in addition to the remedies afforded to him under the trademark law.<sup>206</sup> Additionally, the law allows preliminary injunctions and the seizure of

---

197. The amendment has increased the term of imprisonment from a maximum of three months to one year. Fines have been increased from JD100 (approximately U.S.\$70) to JD3000 (approximately U.S.\$2130).

198. See OLSEN & MANIATIS, *supra* note 9, Jordan § 6.

199. See *id.* The court authorized to hear such cases is the Magistrates Court of First Instance, with the right of appeal to the Appeals Court.

200. See Jordan Trade Secrets and Unfair Competition Law No. 15, art. 2A (2000).

201. See *id.* at art. 2A1.

202. See *id.* at art. 2A2.

203. See *id.* at art. 2A3.

204. See *id.* at art. 2A4.

205. See *id.* at arts. 2B, 2C.

206. See *id.* The author believes these should be read in conjunction with Article 3A.

goods that are the subject of unfair competition.<sup>207</sup> In this regard, the law sets detailed procedures for obtaining and exercising such interlocutory injunctions.<sup>208</sup>

### 3. *The Kingdom of Saudi Arabia*

The Saudi Trademark Law also known as the “trademark regulations”<sup>209</sup> was enacted in 1984.<sup>210</sup> It defines a trademark, addresses various trademark issues, and details procedures for the registration, the publication and the renewal of trademarks. In addition, the law addresses the cancellation as well as the transfer or licensing of registered trademarks. The law also sets trademark fees and prescribes fines and penalties that may be imposed against trademark infringers.<sup>211</sup> The law also details the roles of the administrative and legal entities authorized to implement the law.<sup>212</sup> This law is also supplemented by a new amendment that is primarily concerned with procedures for opposing the registration of a mark, and in some cases, the filing of an application.<sup>213</sup> In this section, I will take a closer look at Saudi trademark legislation.

#### *a. Definition and Type of Protectable Marks*

Article 1 of the 1984 Saudi Trademark Law defines trademarks as:

*“Names or distinct shapes, signatures, words, letters, numbers, drawings, symbols, stamps and prominent inscriptions, or any other sign or combination thereof that are suitable to distinguish industrial, commercial, vocational or agricultural products or projects to exploit forests or natural resources or to indicate that the item on which the mark is carried belongs to the owner of the mark on the grounds of manufacture, selection and invention thereof or trading therewith or to indicate the rendering of a certain service.”*<sup>214</sup>

---

207. See *id.* at arts. 3B, 3F. This article allows for retaining such goods as evidence and disposing of them at a later stage.

208. See *id.* at art. 3C (noting that these procedures are detailed in Article 3C).

209. Saudi Arabia is an Islamic state that abides by Islamic law. As such, the terminology used in referring to laws written by man is distinct from religion-based laws. Man-made laws are referred to as “regulations.” The term “Law” is reserved to religious teaching and rules of conduct set by God.

210. See Saudi Trademark Act No. 75 (1984), available at [www.agip.com/laws/saudi-arabia/htm](http://www.agip.com/laws/saudi-arabia/htm) (last visited May 20, 2002) (noting that this law repeals the earlier law).

211. For a general overview, see ST&P Attorneys and Agents, *Trademarks: Saudi Arabia*, at <http://www.stplegal.com/trademark/tmk-saudi-arabia.html> (last visited July 22, 2002) (copy on file with author); see also NJQ & Associates, *Trademarks: Saudi Arabia*, at <http://www.qumsieh.com/trademarks/arab/tm-filing-saudi-arabia.htm> (last visited July 15, 2002) (copy on file with author).

212. See The Trademark Law of Saudi Arabia No. 75, art. 1.

213. See *id.*

214. *Id.*; see also OLSEN & MANIATIS, *supra* note 9, Saudi § 1 (containing a similar translation). For another translation, see SAM TM Agency, available at <http://www.sauditm.com/general-provisions-articles.htm> (visited July 21, 2002) [hereinafter SAM TM] (copy on file with *The Transnational Lawyer*).

The definition is very broad, allowing various types of marks to be included. However, in spite of this wide definition, holograms, shades of colors, audible sounds, musical notes, three-dimensional objects, packaging, and slogans are not registerable.<sup>215</sup> In this regard, the new amendment has a more limited scope. For example, “[i]n implementing the provisions of this law, trademarks shall be names of distinct shapes, signatures, words, letters, numbers, drawings, symbol . . . [used] to indicate the rendering of a certain service.”

Again, like the two countries discussed above, the old law does not contain an independent definition of a “service mark.” However, it appears that the suffix of Article 1 provides a basic definition. Indeed, various commentators submit that the law recognizes service marks as well as collective and quality control marks (certification marks).<sup>216</sup> Interestingly, the law (due to religious teachings) prohibits registering marks that are intended to cover alcoholic goods (mainly beverages) or retail and wholesale services supplying alcoholic beverages.<sup>217</sup>

Article 2 of the Saudi law includes a list of marks that cannot be trademarks or service marks: generic, descriptive, deceptive, miss-descriptive, immoral or offensive marks. The list also prohibits the registration of official or governmental signs and symbols and marks of a purely religious nature.<sup>218</sup>

- a. Names, emblems, flags, symbols, abbreviations of international organizations, states, nations or regions.<sup>219</sup> This prohibition also applies to any marks bearing similarity to existing marks (imitations).<sup>220</sup>
- b. Official signs used by any government, state or international organization in relation to warranty, quality control or services.<sup>221</sup>

In addition under Article 2(10) of the new Saudi law, the registration of marks identical or similar to well-known marks, as defined by Article 6 of the Paris Convention is prohibited by everyone other than the owner even if they were not previously registered by such owner in Saudi Arabia.

Indeed, the newly amended section also prohibits the registration of marks that are confusingly similar to well-know or famous marks.<sup>222</sup> One commentary

---

215. See OLSEN & MANIATIS, *supra* note 9, Saudi § 2.

216. See Alnowaiser, *December 2001 News Letter*, at <http://www.lfkan.com> (last visited July 3, 2002) (copy on file with author); see also OLSEN & MANIATIS, *supra* note 9, Saudi §§ 1, 5 (referring to collective marks).

217. See *Summary of the Saudi Trademark Registration System*, AGIP, at [www.agip.com/laws/Saudi/hm](http://www.agip.com/laws/Saudi/hm) (last visited May 10, 2002) (copy on file with *The Transnational Lawyer*); see also Alnowaiser, *supra* note 216.

218. See Alnowaiser, *supra* note 216.

219. See OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

220. See *id.*

221. See *id.*

222. See *id.*

notes that a famous mark need not be famous in Saudi Arabia nor internationally famous.<sup>223</sup>

b. *The Application Process*

The application process is open to a wide array of applicants, from natural persons to juridical personas. Although foreigners are allowed to file for trademark applications as well,<sup>224</sup> they must appoint an attorney domiciled in Saudi Arabia to act on the applicant's behalf if they are not domiciled in the Kingdom.<sup>225</sup> Nevertheless, all applicants must file a statement of *bona fide* ownership of the mark the applicant is applying for before the Saudi Trademark Office will consider the mark.<sup>226</sup>

The Saudi Trademark Office examines a trademark application for availability, registrability, and coverage. In this regard, the Saudi Trademark Office would consider whether the mark is sufficiently distinctive and not merely descriptive.<sup>227</sup> Still, however, the goods or services covered by an application may be broadly stated.<sup>228</sup> The multi-class applications are not accepted and a separate application should be filed for each class of goods or services.<sup>229</sup> The Saudi trademark law details various filing requirements, which include: a POA, a list of goods or services, a declaration regarding the boycott of Israel,<sup>230</sup> prints of marks, and the applicant's contact information.<sup>231</sup> Once properly evaluated, the Registrar will send it for publication in the Official Gazette.<sup>232</sup> However, if the mark is cancelled, the applicant may file a complaint directly to the Minister of Commerce. This period starts when notice is received. In addition, if the Minister's decision is not favorable, the applicant may appeal the decision to the Board of Grievance.<sup>233</sup>

The new law recognizes the possibility of filing priority applications.<sup>234</sup> In February 2001, the Saudi trademark Registrar agreed to lax the rules pertaining to foreign priority applications in the Kingdom.<sup>235</sup> Accordingly, the Saudi

---

223. *See id.*

224. *See SAM TM, supra* note 214.

225. *See OLSEN & MANIATIS, supra* note 9, Saudi § 2.

226. *See id.*

227. *See Saudi Trademark Act of 1984, arts. 6-7.*

228. *See OLSEN & MANIATIS, supra* note 9, Saudi § 2.

229. *See id.; see also Saudi Trademark Act of 1984, arts. 6-7.*

230. *See OLSEN & MANIATIS, supra* note 9, Saudi § 2. The declaration requirement is at the discretion of the registrar, but powers of attorney are also accepted.

231. *See Alnowaiser, supra* note 216.

232. *See id.; see also OLSEN & MANIATIS, supra* note 9, Saudi § 2.

233. *See id.*

234. *See Saudi Trademark Act of 1984, art. 9.* The old law in Saudi Arabia did not afford the possibility of claiming international priority applications based on reciprocity; *see also OLSEN & MANIATIS, supra* note 9, Saudi § 3. It should be noted that Saudi Arabia is not a member of the Paris Convention.

235. *See February Bulletin, supra* note 17.



Trademark Office now allows submitting priority documentation within three months of the filing date.<sup>236</sup> In addition, the Registrar now accepts priority documentation certified by a foreign trademark office without legalization by a Saudi consulate. What is more, where the priority application originates from a trademark office located within a WTO member-state, the applicant need not submit a statement of reciprocal treatment.<sup>237</sup>

Saudi trademark law attempts to remain updated regarding trademark protection in the world. One example of this is its adoption of the new classification of goods and services, as introduced by WIPO.<sup>238</sup> This new classification divides services previously classified in class 42 into four new classes, 42 through 45.<sup>239</sup> Saudi law adopted this new classification, which became effective on January 1, 2002.<sup>240</sup> Saudi law evaluates conflicting applications.<sup>241</sup> Further, the trademark Registrar may request the applicant to add disclaimers to the application.<sup>242</sup> According to the latest amendment of Saudi trademark law in February 2002, the trademark office is required to formulate its position regarding a trademark application within sixty days of its filing date. This certainly helps expedite matters. Notably, as shall be shown below, no prior use of a mark is required as a condition for registration.<sup>243</sup>

If an application is rejected by the trademark Registrar, the applicant may initiate a three stage appeal process: first, to the Opposition and Complaints Committee;<sup>244</sup> then to the Minister of Commerce;<sup>245</sup> and finally, to the Board of Grievances.<sup>246</sup> Accepted applications are published in the Official Gazette of the Kingdom.<sup>247</sup>

---

236. *See id.*

237. *See id.* (noting that originally the only countries that enjoyed this exemption were: Austria, France, Germany, Singapore, and the United States).

238. *See* Saba & Co. Group, *News Bulletin, December 2001*, at <http://www.saba.com/bulletin> (last visited May 20, 2002) (copy on file with author). This new classification was introduced by WIPO in an eighth edition of its international classification of goods and services and became effective in January 2002.

239. *See id.* (showing that the services appearing in this new classification scheme are: class 42—scientific, technical and related research and design services, industrial examination and hardware and software development services, in addition to the legal services; class 43—services covering food and beverages; class 44—medical, cosmetics, health, agriculture, and gardening services; class 45—private and social services offered to individuals, in addition to security services designed for protecting property and people).

240. *See Summary of Saudi Trademark Registration System, supra* note 217; *see also* Saba & Co. Group, *supra* note 238. These changes were introduced by the Ministry of Commerce. It should be noted that many countries worldwide adopted these new classes. In fact, the adoption of said classes by Saudi Arabia coincided with similar adoption within Israeli trademark law, *see* amendment of the 4th Annex of the Israeli Trademark Regulations of (1940) effective January 2002.

241. *See* Saudi Trademark Act of 1984, art. 8.

242. *See id.* at art. 10.

243. *See* SAM TM, *supra* note 214.

244. *See* Saudi Trademark Act of 1984, art. 14.

245. *See id.* The minister's decision may be further appealed before the board of Grievances (Court of First Instance).

246. *See* OLSEN & MANIATIS, *supra* note 9, Saudi § 3.

247. *See* Saudi Trademark Act of 1984, art. 15.

c. *Finality of Acceptance and Registration*

Even though a mark may be officially accepted by the examiner and published in the Register, the mark is not necessarily free from attack. Any “interested party” (including the Ministry of Commerce<sup>248</sup>) may file an opposition against a published mark within three months from the date of publication.<sup>249</sup> An opposition may be based on prior registrations, prior applications or the existence of a competing well-known mark.<sup>250</sup> The Oppositions and Complaint Committee presides over the opposition proceedings.<sup>251</sup> Its decision may be appealed to the Board of Grievances by either the opposer or the respondent.<sup>252</sup> If and when all objections and oppositions are set-aside, a trademark is finally registered in the on register, open to public viewing.<sup>253</sup>

A registered trademark may also be subject to cancellation if it is not used for a consecutive period of five years, it violates law or morality, or it is erroneous.<sup>254</sup> In such a case, any interested party may initiate cancellation proceedings before the Grievance Board or the courts of first instance.<sup>255</sup> The basis of cancellation may include: prior registration, non-use, immoral marks or use thereof, and fraudulent registration or maintenance thereof. With respect to non-use, the owner of such a registration may attempt to defend the mark by showing a reasonable cause for non-use.<sup>256</sup>

The above-mentioned February 2002 amendment addresses a host of issues, including.<sup>257</sup>

1. Canceling the Committee of Objections to which the trademark registrar’s decisions were appealed against, according to the current trademark law.
2. Authorizing the Minister of Commerce and Industry to function as an appeals board on the repudiation by the trademark office of an application.<sup>258</sup>

---

248. See OLSEN & MANIATIS, *supra* note 9, Saudi § 3.

249. See Saudi Trademark Act of 1984, arts. 16-17 (detailing the opposition procedures and noting that the law does not allow an extension of an opposition term).

250. See OLSEN & MANIATIS, *supra* note 9, Saudi § 3.

251. See Saudi Trademark Act of 1984, art. 18.

252. See *id.* at art 19; see also *Summary of Saudi Trademark Registration System*, *supra* note 217. Such an appeal may be filed before the board of Grievances (Court of First Instance); see also Alnowaiser, *supra* note 216.

253. See Saudi Trademark Act of 1984, art. 21 (discussing the certificate of registration). The register shall be open to public viewing. *Id.* at art. 24.

254. See *id.* at arts. 29-30.

255. See *id.* (noting that anyone wishing to file a cancellation request against marks that were used continuously for a two-year period after registration must first obtain a court decision to this effect).

256. See OLSEN & MANIATIS, *supra* note 9, Saudi § 3.

257. See Saba, *News Bulletin, March 2002*, at <http://sabaip.com/bulletinmarch/2002> (last visited May 5, 2002) (copy on file with author).

258. Such appeals may be filed within sixty days from receiving the official notice.

3. Determining that objections against trademark registrations should be submitted before the Board of Grievances (Board of Complaints).

*d. The Implications of Registration*

The right over a trademark is given to the first to file in the Kingdom. The law does not compel trademark owners to register their marks.<sup>259</sup> However, registration confers upon the registrant the sole right to use the mark and initiate proceedings against alleged infringers.<sup>260</sup> What is more, the registrant is granted an incontestable right to use the mark after two years of continuous use.<sup>261</sup> However, for a mark to gain protection it must be used as registered.<sup>262</sup> But this right is not immediately extended to an unregistered mark unless the mark enjoys international renown.<sup>263</sup> Nevertheless, lack of registration does not deprive the mark of all protection. One notable demonstration of this is that a trademark, the registration of which has been cancelled, may not be re-registered by a third party for goods or services in the same description unless three years have elapsed from the cancellation date.<sup>264</sup>

With respect notification, registered marks may be designated by an optional notice of "Registered Trademark." This notice of registration entails no legal effect. However, any false claim of registration entails fines or imprisonment.

*e. Maintenance, Duration, and Renewal of Trademarks*

Trademark or service mark registrations remain valid for a period of ten "Higri,"<sup>265</sup> years from the filing date (approximately nine years and eight months according to the "Western" calendar<sup>266</sup>). The registration may be renewed for consecutive periods of ten Higri years each. Until the February 2002 amendment of Saudi trademark law, no grace period was granted for late renewals.<sup>267</sup> This

---

259. See OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

260. See Saudi Trademark Act of 1984, art. 25; see also OLSEN & MANIATIS, *supra* note 9, Saudi § 1. The law also recognizes jointly owned marks, and grants their owners the right of sole use except against other owners. See Saudi Trademark Act of 1984, arts. 43-46.

261. See also Alnowaiser, *supra* note 216, at 2.

262. See OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

263. See *id.* § 1.

264. See *id.* § 4.

265. The Islamic calendar begins on the day that the prophet Mohammed left Mecca where he had originally been persecuted and went to seek refuge in "Medina" where he found supporters and protection. Indeed, the word "Higri" is from the verb "Hagar" which means left, emigrated, separated from. This historical event took place around 614 AD. Hence, the Muslim calendar is about 580 years behind the Gregorian calendar. In addition, the Muslim calendar year is shorter than the Gregorian.

266. See also OLSEN & MANIATIS, *supra* note 9, Saudi §§ 3-4 (listing details for the renewal documents).

267. See Alnowaiser, *supra* note 216, at 2. However, a new trademark application can be filed effectively, re-registering a cancelled mark.

amendment, however, granted a six-month grace period for trademark renewal provided a surcharge is paid.<sup>268</sup> No proof of previous use is required upon requesting renewal. However, a registration that is not used for a continuous period of five years may be subject to cancellation.<sup>269</sup>

*f. Transactions and Changes Affecting Trademark Registrations*

Registered trademarks may be transferred and assigned. A trademark may be assigned without also transferring the goodwill associated with the mark.<sup>270</sup> Meaning intangibles such as reputation are not necessarily transferred automatically. Saudi law also recognizes license agreements where the licensee may use the mark.<sup>271</sup> Quality control is recognized but not compulsory. In order for such an assignment to be effective vis-a-vis third parties, it should first be entered in the Official Gazette and recorded with the Trademark Office.<sup>272</sup> The same applies to mergers and licenses.<sup>273</sup> In addition to updating the trademark register in cases of assignments, licenses, and mergers between an owner of a mark and a surviving entity, the official register should also be updated regarding any changes in the address or name of the current trademark owner.<sup>274</sup>

*g. Infringement of Trademark Rights*

Saudi trademark law deems various actions as infringement. These include unauthorized use of a registered mark, imitation of a registered mark on goods or in relation to services of the same class. In addition, the law prohibits selling, storing or exhibiting<sup>275</sup> goods bearing the mark of another without their permission, where such action is intended for the sale or promotion of goods or services of the same class.<sup>276</sup> This definition is wide enough to include comparative advertising. Hence, it appears that comparative advertising is also prohibited.<sup>277</sup>

---

268. See Saba, *supra* note 257.

269. See OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

270. For a list of the various documents that are needed in order to record an assignment, a merger, or change of name or license, see OLSEN & MANIATIS, *supra* note 9, Saudi §§ 4-5.

271. See Saudi Trademark Act of 1984, arts. 37-38.

272. See *id.* at art. 38.

273. See *id.* at art 33-34; see also OLSEN & MANIATIS, *supra* note 9, Saudi § 4-5. Mortgages and levies on trademarks are recognized.

274. See *Summary of Saudi Trademark Registration System*, *supra* note 217. The burden is on the trademark owner to update the register regarding such changes.

275. For the purpose of sale.

276. See *Summary of Saudi Trademark Registration System*, *supra* note 219; see also OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

277. See OLSEN & MANIATIS, *supra* note 9, Saudi § 5.

*h. Remedies*

The Board of Grievances oversees trademark infringement actions. This board, located in Riyadh, is the competent tribunal for all civil and criminal aspects of trademark disputes. The applicable relief against trademark infringement includes injunctions and damages. Additionally, infringing goods (including those that are imported) may be seized or even destroyed. What is more, it is possible to have the infringing marks removed.<sup>278</sup> The penalties prescribed by law against those who commit acts amounting to infringement include imprisonment and fines as well as provable damages.<sup>279</sup>

An additional legal tool for dealing with trademark infringement is found in the new Saudi Regulations dealing with commercial fraud.<sup>280</sup> Operatively, these new regulations raise the financial penalties of fraud to a maximum of half a million Saudi Riyals (approximately 133,000 U.S. dollars).<sup>281</sup> A violating store or commercial center may be subject to a mandatory closure of no less than six months. This, by commercial standards, is an extensive period and as such appears to be a powerful deterrent for prospective infringers.<sup>282</sup> These penalties apply to all forms of fraud including those involving trademarks. In addition, these regulations set special and harsher penalties regarding fraud in gold and other precious metals.<sup>283</sup> In addition to these legislative initiatives, the Saudi government has set up administrative bodies to prevent commercial fraud in the Saudi market.<sup>284</sup>

A third legal tool that may be invoked in some cases of trademark infringement is found in the authority that is granted to the Ministry of Trade to refer to religious courts some of the lawsuits pertaining to commercial fraud affecting health or life. The penalties imposed by religious courts are typically even harsher.<sup>285</sup> Therefore, cases directly involving consumer health may subject trademark infringers to harsher penalties, thus making an example of such infringers.<sup>286</sup> For example, consider a situation where a manufacturer sells baby formula of an inferior quality under the trademark of a leading baby formula

---

278. See Saudi Trademark Act of 1984, arts. 55-58; see also OLSEN & MANIATIS, *supra* note 9, Saudi § 6.

279. See Saudi Trademark Act of 1984, art. 54; see also Alnowaiser, *supra* note 216; OLSEN & MANIATIS, *supra* note 9, Saudi § 4.

280. These regulations came to replace the old 1984 regulations dealing with commercial fraud. These regulations reportedly came after an extensive study conducted by the Ministry of Trade. See *September News Bulletin*, *supra* note 98.

281. Instead of the 100,000 Riyals fine prescribed by the old regulations.

282. The old regulations the minimum period of closure at three months.

283. In that case, the fines imposed are six hundred thousand Riyals (approximately U.S.\$160,000) instead of the 400,000 Riyals imposed by the old regulations. What is more, the new regulations impose, in such cases, prison terms of two years for penalties involving commercial fraud in gold or other precious metals.

284. See *September News Bulletin*, *supra* note 98 (noting there the responsibility for prosecuting these violators has shifted to the General Public Attorney).

285. Islamic law is inclined to impose harsher penalties than those imposed by modern criminal or civil laws.

286. See *September News Bulletin*, *supra* note 98.

brand. This commercial fraud may be considered to affect the health of consumers and, as such, qualify for harsher penalties imposed by religious tribunals. Similarly, other counterfeit food or pharmaceutical products or even machinery could fall into this category and be referred to the religious courts. Arguably, even use of deceptive or confusingly similar marks may be considered as sufficient cause to refer such cases to the religious courts.

#### 4. *The Arab Republic of Egypt*

The original Egyptian trademark legislation is Egyptian Law Number 57 of 1939. This law remained almost unchanged for just over forty years.<sup>287</sup> A slight amendment to this law was enacted in 1954. That amendment centered mostly on issues pertaining to offences and penalties.<sup>288</sup>

The amendment process of Egyptian IP laws began in the first half of 2001. As early as April 2001, the draft IP laws of Egypt had been approved by the Council of Ministers and were brought before the People's Assembly and the People's Advisory Council (*Shorah*) for debate and discussion. Following this discussion, the People's Assembly gave its preliminary approval.<sup>289</sup> It is worth noting that this approval preceded the participation of an Egyptian delegation in a WTO meeting, which was held in Geneva.<sup>290</sup> As will be shown, the provisions within the new trademark law are intended to comply with the standards of trademark protection as set by TRIPS.<sup>291</sup> Interestingly, the Egyptian Parliament did not conclude the legal process before the WTO meeting. This may have been owed to purely administrative and procedural reasons or may be reflective of an apprehensive progress towards full compliance with TRIPS by leaving room for possible evasive maneuvers after that meeting.

One indication of possible apprehension is the Parliament's vote to allow a ministerial committee, the IPR council, to manage the enforcement of compulsory licensing of products crucial for national security, public health, and the environment. This council is comprised of ministers responsible for a wide range of issues, including: scientific research, health, trade and industry supply, economy, culture, media, and agriculture.<sup>292</sup> Another reason hinted at by an

---

287. See OLSEN & MANIATIS, *supra* note 9, Egypt § 1 (reporting that there were some amendments pertaining to trademarks: Law No. 143 of 1949, Ministerial Decree No. 198 of 1971; Ministerial Decree No. 239 of 1939; Service Mark Ministerial Decree No. 397 of 1958; and the 1994 amendment to the Law of Commercial Fraud).

288. See Egyptian Law No. 569 of 1954 (amending Articles 32, 33, 34 and 36 of Law No. 57 of 1939).

289. See *April 2001 News Bulletin*, AGIP, at [http://agip.com/news/bulletin/4\\_01.htm](http://agip.com/news/bulletin/4_01.htm) (last visited Apr. 8, 2003) (noting delays in the legislative process with respect to the amended trademark law) [hereinafter *April News Bulletin*] (copy on file with *The Transnational Lawyer*).

290. See *June 2001 News Bulletin*, AGIP, at [http://agip.com/news/bulletin/6\\_01.htm](http://agip.com/news/bulletin/6_01.htm) (last visited Apr. 8 2001) [hereinafter *June News Bulletin*] (copy on file with *The Transnational Lawyer*).

291. See *April News Bulletin*, *supra* note 289.

292. See *June News Bulletin*, *supra* note 290.

Egyptian official is that developed countries have not yet fulfilled their commitments detailed in the WTO agreements, including liberalizing their agricultural products as well as eliminating obstacles hampering entry into their national markets.<sup>293</sup> In other words, it appears Egypt would not rush into implementing all of its WTO obligations before developed countries would embark on implementing their own WTO obligations.

The Egyptian legislative process finally concluded and a new intellectual property law was issued in Egypt on June 2, 2002. The law became effective a month later (July 2, 2002).<sup>294</sup> The Egyptian law includes new definitions for “mark” and “well-known mark” to correspond with the TRIPS definitions. In addition, this law prohibits the unauthorized registration of marks deemed identical to others’ registered and/or well-known marks covering similar goods or services.<sup>295</sup> Effectively, the new Egyptian law introduced new subject-matter that, until then, had not been protected by IP laws. This amendment covers patents, copyright, industrial designs, plant varieties, undisclosed information (trade secrets)<sup>296</sup> as well as trademarks.<sup>297</sup> I will refrain from detailing the substantive changes in all of these fields, as it would be beyond the limits of this research.<sup>298</sup> Suffice it here to note that the new patent law provides for wider patentable subject matter, including: nutrient chemical products, medicaments (pharmaceutical products), and biological processes used in connection with animals and plants. In addition, the new patent law addresses utility models, layout designs, and integrated circuits.<sup>299</sup>

Section 2 of the new IP law is of most interest to this Article, because it discusses trademarks. That section also deals with trade descriptions, geographical indications, designs, and industrial designs.<sup>300</sup> Commentators observe that the new trademark

---

293. Comments to this effect were reportedly made by the Egyptian undersecretary of the Ministry of Economy, Mr. Fouad Qasem. These comments were given by the undersecretary on November 8, 2001 before the departure of the Egyptian delegation to Doha Qatar where the 2001 WTO Secretariat meeting was held. For more details, see <http://arabicnews.com/ansub/daily/011108/2001110839.html> (copy on file with author).

294. See *July News 2002 Bulletin*, AGIP, at [http://agip.com/agipnews/bulletin/7\\_02.htm](http://agip.com/agipnews/bulletin/7_02.htm) (last visited Apr. 8, 2003) (copy on file with *The Transnational Lawyer*).

295. *Id.* It should be noted that even before the inclusion of specific provisions defending well-known marks, Article 5 of the 1939 law was utilized towards providing such protection. This Article prohibits registration of marks that are likely to deceive the consumer.

296. All of these new topics are covered in section one of the new law. For more discussion on the scope of the amendments, see Ragaii El-Dakki & Partners, Library, *Features of the New Egyptian Intellectual Property Law in Egypt*, at <http://www.reldekki.com/lib03.html> (last visited June 27, 2002) (copy on file with author).

297. For a general overview of Egyptian trademark law, see ST&P Attorneys and Agents, *Trademarks: Egypt*, at <http://www.stplegal.com/trademark/tmk-egypt.html> (last visited July 24, 2002) (copy on file with author); see also NJQ & Associates, *Trademarks: Egypt*, at [http://www.qumsieh.com/trademarks/arab/tm-filing\\_egypt.htm](http://www.qumsieh.com/trademarks/arab/tm-filing_egypt.htm) (last visited July 22, 2002) (copy on file with author).

298. For a summary of the various innovations introduced by the new Egyptian IP laws, see *July News Bulletin*, *supra* note 294.

299. See *April News Bulletin*, *supra* note, 289.

300. See El-Dekki & Partners, *supra* note 296.

law does not generally contain radical changes.<sup>301</sup> From the following review of the particularities of Egyptian trademark law this observation appears to be valid.

*a. Definition and Type of Protectable Marks*

The definition of a trademark in Egyptian law is expansive. Article 1 of the Trademarks and Commercial Definitions Law<sup>302</sup> defines a trademark as:

The formalized and the characterized names, signatures, words, letters, figures, drawings, symbols, shops', titles, fiscal and official stamps, pictures, protruded engravings, and any other marks or collection thereof, if they were being employed or needed to be employed for distinguishing products of an industrial process or agricultural exploitation, earth extracts, or any commodity; or for indicating the origin of products or commodities, their kinds, category, guarantee or method of preparation or for indicating the performance of one of the services.

However, after the implementation of the new Egyptian trademark law, this definition was expanded to encompass various other types of protectable marks, including<sup>303</sup> collective marks and certification marks. Moreover, this amendment allowed for the recognition of well-known marks in Egypt and abroad, granting them enhanced protection even if they are not registered or are famous with respect to other classes.<sup>304</sup> Evidencing the wide scope of registrable trademarks is the fact that the Appeals Committee accepted an appeal filed by Beneton Group S.P.A. The Appeals Committee allowed Beneton to register a mark consisting of a rectangular green strip. Thus, the Committee effectively overturned the registrar's refusal to register Beneton's mark because it was not distinctive.<sup>305</sup>

However, interestingly, the new law limits the registration of marks to only those that are visible. Consequently, sounds and smells may not be registered as a trademark.<sup>306</sup> This is rather peculiar since the general trend in trademark law appears to be directed towards expanding rather than limiting trademark subject-matter.<sup>307</sup> The law prohibits the registration of marks that are identical to famous

---

301. *Id.*

302. Egyptian Trademark Law No. 75 (1939), available at [www.agip.com/laws/egypt.htm](http://www.agip.com/laws/egypt.htm) (copy on file with *The Transnational Lawyer*); see also OLSEN & MANIATIS, *supra* note 9, Egypt § 1.

303. See OLSEN & MANIATIS, *supra* note 9.

304. See El-Dekki & Partners, *supra* note 296.

305. *Ninth Annual Int'l Rev. of Trademark Jurisprudence (2002)*, 92 TRADEMARK REP. 229, 374 (Mar.-Apr. 2002) (discussing Beneton Group S.P.A. v. Egyptian Trademark Office, Committee of Appeals, Case No. 9777/99 (Jan. 22, 2001)).

306. El-Dekki & Partners, *supra* note 296.

307. See THEORY & PRACTICE, *supra* note 108, at 186-87; see also PAUL W. REIDL, UNDERSTANDING BASIC TRADEMARK LAW: A PRIMER ON GLOBAL TRADEMARK PROTECTION, 569 PRACTICING LAW INSTITUTE, PATENT, COPYRIGHTS, TRADEMARKS AND LITERARY PROPERTY COURSE HANDBOOK SERIES 283 (1999); Daniel A. Tysver, *Bitlaw: A Resource on Technology Law, Example of Trademark Devices*, at <http://www.bitlaw.com/trademark/devices.html> (last visited June 1, 2002) (copy on file with author); Brown & Michaels,



trademarks even if they cover different goods or services, provided that the use of the new mark insinuates a connection between the proprietor of the famous mark and the said goods or services, use of the new mark adversely affects (harms) the proprietor of the mark, and the famous mark is in fact registered in Egypt (and in other WTO member-states).<sup>308</sup>

*b. The Application Process*

Egyptian trademark law allows a host of applicants (including foreign applicants) to file trademark applications. These can be natural persons, manufacturers, producers or merchants.<sup>309</sup> Rights in a trademark are created by the first to file in Egypt.<sup>310</sup>

The trademark examiner examines trademark applications for compliance with the requirements prescribed by Egyptian trademark law. Article 5 prohibits the registration of various marks, including those that are<sup>311</sup> non-distinctive, generic, descriptive, misdescriptive, immoral, contrary to public order, similar to religious symbols, similar to symbols of countries, significantly misleading geographic origin, portraying an individual (without his consent), deceptive, misleading (regarding quality, origin or producer), or constituting an unauthorized copy or imitation of another's mark. Such a determination by the examiner may be subject to appeal.<sup>312</sup> Also, marks containing certain words are prohibited from registration (*i.e.*, words such as: Patent, Patented, Copyrighted, Registered, Registered Design, etcetera).<sup>313</sup> The trademark registrar is authorized to impose any restrictions or modifications to avoid any confusion with another's registered trademark.<sup>314</sup> During the examination of a trademark application, the Egyptian trademark office may, in accordance with the new law, *ex officio*, refuse to register any mark that is found to be identical or confusingly similar to a well-known mark and is used for identical or similar goods.<sup>315</sup>

---

*Frequently Asked Questions on Trademarks, What Kind of Things Can Be a Trademark?*, at <http://www.lightlink.com/bbm/tmqa.html> (last visited June 1, 2002) (copy on file with author).

308. See OLSEN & MANIATIS, *supra* note 9, Egypt § 2.

309. See Egypt Trademark Law No. 57, art. 4; see also OLSEN & MANIATIS, *supra* note 9, Egypt § 2.

310. See OLSEN & MANIATIS, *supra* note 9, Egypt § 1.

311. See *id.* § 2.

312. See Egypt Trademark Law No. 57, art. 4; see also *Summary of Trademark Registration in Egypt*, AGIP, at <http://agip.com/countries/egypt/t.htm> (last visited Apr. 8, 2002) (copy on file with *The Transnational Lawyer*) [hereinafter *Summary of Trademark Registration*]. The applicant may appeal such a rejection of its application within thirty days of notification. For more details see OLSEN & MANIATIS, *supra* note 9, Egypt § 1.

313. See OLSEN & MANIATIS, *supra* note 9, Egypt § 2.

314. See Egypt Trademark Law No. 57, art. 9.

315. El-Dekki & Partners, *supra* note 296.

Applications for registering any of these mark types requires various documentation and formalities,<sup>316</sup> which include: a POA,<sup>317</sup> depiction of the mark,<sup>318</sup> detailing the class and scope of goods or services to be covered by the mark,<sup>319</sup> and details of applicant<sup>320</sup> and priority documentation where applicable.<sup>321</sup>

Egypt has been a party to the Madrid Agreement Concerning International Registration of Trademarks since 1975.<sup>322</sup> In addition, Egyptian trademark law applies the Nice International Classification of Goods. What is more, Egyptian trademark law introduced in January 1, 2002 reclassifies class 42 and subsequently created classes 42-45.<sup>323</sup> Interestingly, while trademark applications in some classes allow filing for all of the goods or services in that class, other classes require specificity.<sup>324</sup> Multi-class applications are not possible. Each class requires separate applications.<sup>325</sup> What is more, international priority is available under the Paris Convention.<sup>326</sup>

### c. Finality of Acceptance and Registration

Trademark applications approved by the registrar are published in the Official Gazette and serve as notice to any interested party who wishes to file a notice of opposition within sixty days.<sup>327</sup> The basis of such opposition may be: (a) prior registration; (b) prior applications; and (c) prior use. Where the sixty-day period lapses, the published trademark is then registered in the "Register of

---

316. For more on the documents required for filing an application, see OLSEN & MANIATIS, *supra* note 9, Egypt § 2.

317. *See id.*

318. Namely, a printing block and ten prints of the mark for each class.

319. See our discussion regarding classification below.

320. Namely, a certified extract of the applicant's company in the commercial register or a certified copy of the certificate of incorporation, which includes the name, address, nationality, legal status, and profession or nature of the applicant legalized up to the Egyptian consulate.

321. Where priority is claimed, the corresponding priority filing (abroad) must be submitted within three months.

322. Egypt joined the Madrid Agreement Act of Stockholm of 1967 on March 6, 1975.

323. *See Summary of Trademark Registration, supra* note 312.

324. *Id.* (noting that classes 2, 5, 8, 13, 14, 23, 24, 25, 27, 28, 29, 30, and 32-45 allow for filing an application for all goods/services. In the remaining classes, an applicant is required to specify the goods/services or, in practice, omit at least one good. *See* OLSEN & MANIATIS, *supra* note 9, Egypt §1 (noting that it would be possible to cover an entire class with two applications).

325. *See* OLSEN & MANIATIS, *supra* note 9, Egypt § 2.

326. *See id.* § 3.

327. *See* Ragaii El-Dekki & Partners, *supra* note 296 (noting that before the amendment of Egyptian Trademark Law No. 82 (2002), the period for filing an opposition against a trademark under article 13 of Egyptian Trademark Law No. 57 of 1939 was three months). Article 13 also details the procedure of opposition and allows an applicant to represent himself in such proceedings. *Id.* According to Article 13, applicant may elect to be represented by a patent attorney. *Id.* If and when the opposition case is not settled by the registrar or where one party objects to the registrar's decision, the case is referred to other tribunals. For more information, see *Summary of Trademark Registration System, supra* note 312.

Trademarks.”<sup>328</sup> Appeals regarding oppositions may be filed with the court of First Instance.<sup>329</sup>

Prior use is not a prerequisite to register a trademark. However, lack of use exposes it to cancellation proceedings (initiated by an interested party).<sup>330</sup> As amended, Egyptian trademark law allows an interested party to request cancellation of a trademark registration that is not used for three consecutive years.<sup>331</sup> In this regard, only traditional use, *i.e.*, on the product or on documents relating to the service, is considered. Some commentators believe use of a trademark on the Internet as metatagging (in linking or framing) is not sufficient use. The same holds true concerning use by fan clubs or supporters or in parody.<sup>332</sup>

In addition to non-use, the basis of cancellation includes: (a) prior registration; (b) prior applications; and (c) registration contrary to law.<sup>333</sup> Similarly, a bad faith registration is subject to cancellation where it is shown that the trademark was registered in bad faith.<sup>334</sup>

#### *d. The Implications of Registration*

Article 3 of the Egyptian trademark law states:

*“The registrant of a trademark shall be deemed to be the sole proprietor thereof. . . .”*<sup>335</sup>

---

328. See El-Dekki & Partners, *supra* note 296 (noting, similarly, that the new law also limits the time in which a counter-statement may be filed against an opposition to 30 days, instead of three months as was the case before the amendment of the Egyptian trademark law). See Egypt Trademark Law No. 57, arts. 2, 17.

329. See OLSEN & MANIATIS, *supra* note 9, Egypt § 3.

330. In order for a cancellation proceeding to succeed, the petitioner must establish sufficient grounds that the trademark, subject to cancellation proceedings, has not been used (or at least not seriously) for a period of five consecutive years. The proprietor of such a trademark registration can overcome such a petition if he shows that there was reasonable cause for the non-use of the trademark.

331. See Egypt Trademark Law No. 57, art. 22. Before the amendment, the grace period for non-use was five years. It should also be noted that according to Article 25, a trademark registration may be cancelled even if not lawfully registered. See El-Dekki & Partners, *supra* note 296.

332. See Hamdy Gaber, Nadia Haroun & Magda Saad, at [http://www.aippi.org/reports/q168/q168\\_Egypt\\_e.html](http://www.aippi.org/reports/q168/q168_Egypt_e.html) (last visited July 29, 2002) (copy on file with *The Transnational Lawyer*) (discussing the legal requirement to its acquisition, maintenance, and infringement).

333. OLSEN & MANIATIS, *supra* note 9, Egypt § 3.

334. *Summary of Trademark Registration System*, *supra* note 312; see also El-Dekki & Partners, *supra* note 296 (using the term “seriously used”).

335. *Id.*; see also OLSEN & MANIATIS, *supra* note 9, Egypt § 1.

Registration is therefore important for attaining protection. Trademark registration trumps subsequent registration or use of a similar mark by another.<sup>336</sup> However, use of a trademark is not an absolute precondition to its defense. Four examples that may be noted in this regard are:

- a. The defense afforded to well-known marks even if they are not registered in Egypt.
- b. The three-year period during which another may not register a trademark similar to a cancelled trademark registration.<sup>337</sup>
- c. According to Article 8 of the Paris Convention (which Egypt is a member of), trade names are automatically protected even if not registered.<sup>338</sup>
- d. A prior user of a mark (even if not registered) may challenge the subsequent unauthorized registration of his mark by a third party and may institute actions on grounds of passing off.<sup>339</sup>

In Egypt a trademark registration may be notified either by the symbol ® or by the phrase "Registered Trademark." However, there appear to be no ramifications for not indicating a trademark registration in such a way.<sup>340</sup> Egyptian law does, however, prescribe fines and/or imprisonment against those falsely indicating a mark is registered in Egypt. These laws are said to be "strictly enforced."<sup>341</sup> That such mark is registered outside Egypt does not exempt the user of such false notice from penalties.<sup>342</sup>

*e. Maintenance, Duration, and Renewal of Trademarks*

A trademark registration remains valid for seven years from the original filing date.<sup>343</sup> Registrations are renewable (upon request) for consecutive periods

---

336. See OLSEN & MANIATIS, *supra* note 9, Egypt § 6.

337. See Egyptian Trademark Law No. 57, art. 23 (1939).

338. See OLSEN & MANIATIS, *supra* note 9, Egypt § 6; see also INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY 30 (Marshall A. Leafter ed., 2d ed. 1997) (noting that Article 8 of the Paris Convention for the Protection of Industrial Property 1883 states that a "trade name shall be protected in all the countries of the Union without the obligation of filing or registering, whether or not it forms part of a trademark").

339. See OLSEN & MANIATIS, *supra* note 9, Egypt § 1.

340. See INTA, *supra* note 165.

341. *Id.*

342. *Id.*

343. The registration is finalized by the issuance of a registration certificate. The period of the registration's duration had originally been 10 years. However, it was changed within the amendment of the Egyptian Trademark Law. See *January 2001 News Bulletin AGIP*, at [http://agip.com/agipnews/bulletin/1\\_01.HTM](http://agip.com/agipnews/bulletin/1_01.HTM) (last visited Apr. 23, 2003) (copy on file with *The Transnational Lawyer*).

of ten years each, so long as the requirements are met.<sup>344</sup> A three-month grace period is granted for delayed renewals, after which the registration is cancelled by the TMO and soon thereafter removed from the register.<sup>345</sup>

*f. Transactions and Changes Affecting Trademark Registrations*

Trademark registrations may be assigned. A mark may also be transferred through a merger between its owner and a surviving entity. Trademark rights can also be licensed or mortgaged (as security interest) to third parties.<sup>346</sup> For assignments (also through merger), licenses or mortgages to be effective against third parties, they should be recorded in the trademarks register and published in the Official Gazette.<sup>347</sup> Assignments can be made without selling the entire goodwill of the business.<sup>348</sup>

Various documents are required for registering an assignment, license or merger agreement with the Trademark Office. These documents include: a POA, documentation detailing the licensee or assignee; and the license agreement or deed of assignment.<sup>349</sup>

*g. Infringement of Trademark Rights*

Infringement of trademark rights occurs when an unauthorized party uses another's mark. Such is the case with counterfeiting or imitating marks and/or selling products bearing such marks or displaying for sale counterfeit merchandize. Comparative advertising is also prohibited.<sup>350</sup>

Registration and use of the mark are required to establish infringement for non-famous marks. The use requirement refers generally to "traditional" use of a mark, *i.e.*, on the product or paperwork relating to the products and service covered by the mark.<sup>351</sup>

---

344. Egyptian Trademark Law No. 57, art. 21 (1939). The proprietor of the registration needs to file a request for renewal and pay the renewal fees.

345. *See id.* (noting that the TMO issues a notice of reminder indicating the necessity to renew the registration and pay the fees). However, with the request of renewal, a power of attorney legalized up to the Egyptian consulate should be submitted. *Id.*; *see also* OLSEN & MANIATIS, *supra* note 9, Egypt § 3.

346. *See Summary of Trademark Mark Registration System, supra* note 312.

347. *See* Egyptian Trademark Law No. 57, art. 20 (1939).

348. *See* El-Dekki & Partners, *supra* note 296.

349. For a more expansive discussion of the required documentation for registering an assignment or recording a license agreement, merger or change of name/address, *see Summary of Trademark System, supra* note 312; *see also* OLSEN & MANIATIS, *supra* note 9, Egypt § 4-5.

350. *See* Gaber et al., *supra* note 312; *see* OLSEN & MANIATIS, *supra* note 9, Egypt § 5-6.

351. *See* Gaber et al., *supra* note 312.

*h. Remedies*

The trademark law in Egypt prescribes penalties, punishments (imprisonment), and fees against any party who infringes upon the registered trademark of another, *i.e.*, uses or imitates another's trademark without authorization.<sup>352</sup> In other words, only the proprietors of registered marks may prevent others from infringing upon their registered mark and/or recover damages for infringement.<sup>353</sup> The court may impose injunctions allowing the petitioner to document and seize all infringing goods or tools used in the infringement process.<sup>354</sup> Goods may be confiscated or destroyed<sup>355</sup> and the infringing business closed by authorities.<sup>356</sup> Civil as well as criminal proceedings may be initiated against infringers.<sup>357</sup> In addition, the amendment of Egyptian Trademark Law No. 82 of 2002 re-enforces the law by subjecting violators of trademarks or geographical indications to harsher penalties than simply canceling the mark.<sup>358</sup>

*C. Trademarks and the Arab Boycott of Israel*

*1. Scope of the Boycott and Its Effect on Trademark Registration in the Middle East*

The Arab boycott of Israel is a by-product of the on-going Israel-Arab conflict in the Middle East. This boycott has produced a body of regulations aimed at prohibiting natural persons, corporations, and entities domiciled in Israel holding Israeli nationality or promoting Israeli interests worldwide from operating in Arab countries. Persons or businesses violating these laws are placed on the "boycott list." This in turn renders any transaction with them illegal and entails punishment.<sup>359</sup> These boycott regulations are not limited to commercial dealings but extend to all spheres of activity including research and intellectual property (patents, trademarks, trademark assignments and renewals, licenses, industrial designs, etcetera). Consequently, the effect of these regulations prohibit Arab countries from registering the intellectual property of any non-complying entity.<sup>360</sup>

---

352. See Egyptian Trademark Law. No. 57, arts. 33-36 (1939).

353. See *id.* at art. 36.

354. For a detailed description of the possible content and scope of such orders (and the procedures thereof), see *id.* at art. 35.

355. See *id.* at art. 36 (noting that the tools used in the process of making the infringing products may also be destroyed).

356. See *id.*

357. See *id.*

358. See *January News Bulletin*, *supra* note 343.

359. See *April News Bulletin*, *supra* note 289.

360. *Id.*

The boycott operates on three levels:<sup>361</sup>

- a. “Primary” level: Prohibiting direct business dealings with Israel. In the context of trademark protection, Arab businesses may not register trademarks with the Israeli trademark office. In addition, Israeli applicants may not file trademark applications in Arab countries. An example of such regulations, Article 2(11) of the Saudi trademark law, which prohibits the registration of:  
*“Marks which are owned by ordinary or corporate persons or by countries that are boycotted in accordance with a resolution issued by the concerned authority.”*<sup>362</sup>
- b. “Secondary” level: Prohibiting individuals as well as private and public sector firms in Arab league states from doing business with “blacklisted” firms that contribute to Israel’s economic or military development. In the context of trademarks, this means that any foreign firm that registers its marks with the Israeli trademark office will be barred from registering its marks with Arab league states. The logic of this is that registering a mark in Israel is a sufficiently clear indication of business dealings within that country or at least intent to conduct business within Israel.
- c. “Tertiary” level: Prohibiting business dealings with firms that do business with firms that are “blacklisted.” This of course is the most expansive aspect of the boycott where even indirect dealing with Israel would be sufficient to include such entities in the boycott.

With respect to intellectual property, the boycott poses problems on two “fronts.” On the Israeli front, the boycott prohibits any bilateral dealings between Israel and Arab countries that observe the boycott. The second, wider front, is the international front where foreign parties dealing with Israel (directly or indirectly) are prohibited from registering their IP in Arab countries observing the boycott. Understandably, both of these “fronts” apply to trademark registrations. The practical effect is that different trademarks may have to be used in the two jurisdictions. Another measure may require the establishment of subsidiary companies. This, in turn, may affect promotion of the mark, increase expenses of such promotion, and increase packaging costs.

---

361. *International Trade: US, Gulf Cooperation Council to Discuss Investing, Intellectual Property, Trade, Pat. Trademark & Copyright L. Daily (BNA) 1 d2 (Feb. 26, 1996)* [hereinafter *Gulf Cooperation Council*].

362. Saudi Trademark Act No. 75, art. 2(11) (1984). Another similar example is found in Article 30(2), which allows the cancellation of registrations that negate the boycott. *Id.* at art. 30(2).

## 2. *The Boycott's Implementation and Fate*

The effectiveness of the Arab boycott has been eroding over time. In fact, as early as 1995, some contended that the boycott appeared to be “falling of its own weight”<sup>363</sup> due to various factors,<sup>364</sup> the most notable of which are:

1. The peace agreements that Egypt and Jordan concluded with Israel. These two countries do not require any boycott compliance; in fact, their respective trademark offices accept trademark applications connected to Israel and even those of Israeli companies and individuals.
2. In addition to these agreements, there is an increase in commercial dealings between Israel and some Arab states. These relations are maintained on a low-key (or even discrete) level in order to evade various pressures aimed at severing them.

Moreover, as early as 1994, the GCC announced it that will end its adherence to the “tertiary” and “secondary” levels of the boycott, while “maintaining the primary boycott against Israel.”<sup>365</sup>

3. The rapid changes in the structure and function of the world economy, which are marginalizing Arab countries. In this regard, even the “Oil” industry, which once afforded some Arab countries international influence, has also diminished in scope. This is largely because Western countries’ dependence on Petroleum from the Middle East has decreased in view of new sources and regions that have begun to sell such Petroleum at competitive prices and in substantial quantities.
4. Pressure applied by the United States towards ending the boycott altogether. The U.S. position on the boycott is that the boycott constitutes “an impediment to economic growth and economic development.”<sup>366</sup>

However, despite this slow death of the boycott, it remains formally in effect. Indeed, the boycott regulations pertaining to registration of industrial property remain operative. One clear example, discussed above, is the boycott documentation required by Syria, where applying to register a mark requires an applicant to declare his compliance with the boycott regulations. Similarly, Iraqi trademark law requires all international applicants to submit signed and legalized declarations attesting that they have no dealings with Israel. Most other Arab

---

363. See Gary G. Yerkey, *Anti Boycott Compliance: Arab Boycott of Israel Now Collapsing Under Its Own Weight*, 12 Int'l Trade Rep. (BNA) 45 (Nov. 1995) [hereinafter *Antiboycott Compliance*].

364. See *id.*

365. *Gulf Cooperation Council*, *supra* note 361, at 1.

366. *Id.*



countries do not require such declarations, but may, in practice, refuse applications submitted by Israelis.<sup>367</sup>

Additionally, and in-view of the tragic turn for the worst in the Middle East crisis, the reactivation of the boycott is reportedly being voiced by high ranking officials throughout the Arab World.<sup>368</sup> Indeed, the entire concept of the boycott has been reinvigorated. What is more, the Arab Boycott Office, located in Damascus, Syria, is making renewed attempts to revive the boycott procedure in all Arab countries. One of the highlights of this new attempt was a July 2001 meeting attended by specialized and technical experts on the Arab boycott aimed at attaining such a revival. The meeting produced a paper entitled: "Arab Boycott Against Israel, Between the Past and the Present."<sup>369</sup>

The implementation of the boycott mechanism varies widely from one Arab country to another. Some countries have formal diplomatic relations as well as trade relations (Jordan and Egypt), while other countries have discrete business relations and interests with Israel (mainly Gulf states as well as countries in North Africa such as Morocco). A third "hard core" group has no relations (or at least none that are apparent). This third group includes Iraq, Libya, Syria, and Saudi Arabia. This variance in the degree of implementation of the boycott affects IP issues as well.<sup>370</sup>

### 3. *International Ramifications of the Boycott*

The boycott is not accepted at face value by the entire international community. In fact, the U.S. State Department does not authenticate documents "relating to the Arab Boycott of Israel."<sup>371</sup> In this regard, the U.S. Export Administration Act prohibits U.S. persons from providing certain boycott information.<sup>372</sup> One example of the United States' opposition to the boycott

---

367. See *August News Bulletin*, *supra* note 96.

368. Recently (March 2002), the secretary-general of the Arab League, Mr. Amer Mousa, has given statements to this effect.

369. See *August News Bulletin*, *supra* note 96.

370. The differences over the boycott is in many respects a reflection of the ideological and political struggles within Arab countries. For an analysis of the various issues pertaining to the political struggle within Arab countries, see for example, Bassam Tibi, *The Fundamentalist Challenge to the Secular Order in the Middle East*, 23 FLETCHER FORUM OF WORLD AFFAIRS 191 (1999).

371. This was wording found in a response sent to an American attorney who requested to notarize a "boycott declaration" for purposes of filing a trademark application in Saudi Arabia. See *Trademarks: Fine Upheld for Submitting Boycott Oath in Saudi Trademark Application*, 37 Pat. Trademark & Copyright J. (BNA) 242 (1989) [hereinafter *Fine Upheld*].

372. The U.S. Export Administration Act, 50 U.S.C. §§ 2401-2420; see also *Fine Upheld*, *supra* note 372, at 241. For a concise guide of the U.S. anti-boycott laws, see Greenberg Traurig, LLP, *A Guide to U.S. Antiboycott Laws*, available at <http://www.gtllaw.com/practices/intl-trade/bg/01antiboycott.pdf> (last visited Aug. 10, 2002) (copy on file with *The Transnational Lawyer*). The U.S. Department of Commerce, Bureau of Industry and Security (Office of Antiboycott Compliance) offers information regarding antiboycott issues, including the possibility of making an antiboycott inquiry, case history as well as examples of boycott requirements in various Arab countries. See *Office of Antiboycott Compliance*, at <http://www.bxa.doc.gov/>

involves an American attorney who was found to have violated the Anti-Boycott Regulations<sup>373</sup> by filing a boycott declaration pertaining to a trademark application in Saudi Arabia. According to the U.S. anti-boycott regulations, U.S. citizens must report instances wherein they are requested to take any action supporting restrictive trade practices or boycotts against a country friendly to the United States or any U.S. person.<sup>374</sup> In that case, the violation was said to have occurred because the defendant had completed the Saudi application without duly advising and/or informing the U.S. Department of Commerce.<sup>375</sup> The defendant was fined U.S.\$5000, which he refused to pay. The United States sued to collect the fine, and the district court upheld the imposition of the fine.<sup>376</sup> The defendant unsuccessfully appealed to the U.S. Court of Appeals for the First District, which upheld the ruling (a dissenting opinion was rendered by Judge Brown).<sup>377</sup>

Indeed, as has been shown, the boycott constitutes an obstacle in bilateral relations between Arab countries and the United States as well as the WTO scheme. The Arab boycott of Israel constitutes a segment of a wider discussion pertaining to the validity and justification of opt-out clauses within the WTO agreement.<sup>378</sup> In this respect, some commentators submit that the

*“[o]pt-out clause unduly restricts trade and has specific negative implications for regions engulfed in conflict such as the Middle East that could potentially have enjoyed greater stability resulting from enhanced trade collaboration.”*<sup>379</sup>

---

AntiboycottCompliance/OACAntiboycottRequestExamples.html (last visited Apr. 15, 2003) (copy on file with *The Transnational Lawyer*); see also *U.S. Chamber of Commerce: Antiboycott Issues*, <http://www.uschamber.com/political+advocacy/issues+index/international+and+trade/antiboycott+israel> (last visited Aug. 18, 2002) (copy on file with *The Transnational Lawyer*).

373. COMMERCE AND FOREIGN TRADE SUBTITLE B REGULATIONS RELATING TO COMMERCE AND FOREIGN TRADE, 15 C.F.R. 760-2 (2000).

374. Margaret L.H. Png & Federico Canuto, EXPORT PRACTICE: CUSTOMS AND INTERNATIONAL TRADE LAW, CHAPTER 22; EXPORT CONTROLS OF SPECIFIC INDUSTRIES AND TRANSACTIONS, RESTRICTIVE TRADE PRACTICES—BOYCOTTS (2001).

375. *Fine Upheld*, *supra* note 371, at 242-43.

376. See *id.* (noting that this case appeared in the district court).

377. *Id.* (highlighting the arguments presented by the defendant and the dissenting decision rendered by Judge Brown). Judge Brown's position rested on the proposition that the Act requires the government to prove that the defendant consciously violated the law; see also *U.S. v. Meyer*, 864 F.2d 214 (1st Cir. 1988).

378. GATT Article XIII (WTO) [The Marrakech Agreement Establishing the WTO art. 13, Apr. 15, 1994] allows for the non-application of multilateral trade agreements between specific member states. The opt-out clause was originally established in Article XXXV of the GATT 1947. The WTO is the end result of the Uruguay Round of Multilateral Trade Negotiation.

379. For more on this, see Ariel M. Ezrahi, *Opting Out of the Opt-Out Clauses: Removing Obstacles to International Trade and International Peace*, 31 *LAW & POL'Y INT'L BUS.* 123, 135-36 (1999).

It would be presumptuous (and indeed incorrect) to contend that this short analysis covers the boycott issue. This will be left to other research.<sup>380</sup>

### III. ARAB COUNTRIES IN THE MIDDLE EAST AND TRADEMARK'S "NEW WORLD ORDER"

The international legal framework pertaining to trademark protection is expansive and diverse. Examined in this Part are the obligations undertaken by some Arab countries regarding trademark protection in various international agreements. I first chart out Arab participation in nine international agreements.<sup>381</sup> This chart serves as a further indication of the extent of commitment to trademark protection by Arab countries. Moreover, it may serve as a concise comparative overview regarding trademark protection in various Arab countries and ACME specifically. Nevertheless, the most central agreement in this regard is TRIPS, which is an important pillar of the WTO. Therefore, the following section mostly focuses on the trademark protection mechanisms in TRIPS. However, before attempting to uncover the realm of TRIPS, it is imperative, in my opinion, to understand its place within the World Trade Organization scheme. Hence, I will initially shed some light on the fundamentals of the WTO and examine the process of WTO accession that each one of the four ACME have undergone or are undergoing. This examination will assist in understanding the underlying dynamics of trademark protection and the various interests involved therein.

#### A. *Arab Membership in International Conventions and Treaties Pertaining to Trademark Protection*

The table following this page shows that some Arab countries have become members to various international treaties and conventions. There is, however, no consistent pattern regarding Arab country membership in these international bodies. Generally speaking, leading international conventions and treaties such as the Paris Convention have a wide base of membership in Arab countries. On the other hand, less substantial agreements like the Vienna Convention and the Lisbon Agreements have a thinner base.<sup>382</sup>

---

380. For a concise overview of the Arab Boycott against Israel in 1997, see Howard L. Stovall, et al., *Middle East Commercial Law Developments, International Legal Developments in Review: 1997, Foreign Law*, 32 INT'L LAW. 411, 412 (1998).

381. For the full text of these International Agreements as well as a synopsis, see Leaffer, *supra* note 340.

382. For an updated list of member states for the Paris Convention, Madrid Agreement and/or Protocol, Lisbon Agreements, Trademark Law and Regulations, Nairobi Treaty for the Protection of the Olympic Symbol, Nice Agreement, and Vienna Agreement, see WIPO, *available at* <http://wipo.org>.

Treaty Name	Total Member States	Total Arab Member States	Names of Arab Countries
The Paris Convention for the Protection of Industrial Property	163	15	Algeria, Bahrain, Egypt, Iraq, Jordan, Lebanon, Libya, Mauritania, Morocco, Oman, Qatar, Syria, Tunisia, Sudan, and the United Arab Emirates
Madrid Agreement Concerning the International Registration of Marks	52	5	Algeria, Egypt, Morocco and Sudan
Agreement of Madrid for the Prevention of False or Misleading Indications of Sources of Goods and the additional Act of Stockholm	33	6	Algeria, Egypt, Lebanon, Morocco, Syria, and Tunisia
Lisbon Agreement for the Protection of Appellations of Origin and their International Registration	20	2	Algeria and Tunisia
Trademark Law Treaty and Regulations	28	1	Egypt
Nairobi Treaty on the Protection of the Olympic Symbol	40	6	Algeria, Egypt, Morocco, Oman, Syria, and Tunisia
Nice Agreement Concerning the International Classification of Goods and Services for the Protection of the Registration of Marks	60	4	Algeria, Lebanon, Morocco, and Tunisia
Vienna Agreement Establishing an International Classification of Figurative Elements of Marks	19	1	Tunisia
World Intellectual Property Organization	179	15	Algeria, Bahrain, Egypt, Iraq, Jordan, Kuwait, Lebanon, Libya, Mauritania, Oman, Qatar, Saudi Arabia, Somalia, Sudan, and Tunisia

### 1. Regional Arab Intellectual Property Organizations

The expanding IP activity in the region has also lead to the establishment of numerous professional, semi-governmental entities as well law firms that focus on various IP topics. These entities also appear to play an important role in the local promotion and understanding of IP. Many of these entities have already established their presence in the regional and international scene as well as in cyberspace.<sup>383</sup> Among these are the Arab Society for the Protection of Intellectual Property (ASPIP), the Arab Internet Domain Names Association (AIDNA), and

---

383. For more examples of the activity done by these entities, see *Treaties*, AGIP, at <http://agip.com/treaties/association.htm> (last visited Apr. 23, 2003) (copy on file with *The Transnational Lawyer*). In addition, see lists of local IP law firms in the *Membership Directory* published by the *International Trademark Association INTA: INTA Annual Membership Directory*, 1999-2000, at 69 (Jordan), at 70 (Lebanon), at 103 (UAE), at 88 (Saudi Arabia), at 43 (Egypt), at 81 (Oman), at 70 (Kuwait), at 100 (Syria).

the Jordanian Committee for Intellectual Property in E-Business and the Licensing Executive Society—Arab Countries (LESARAB).<sup>384</sup>

These regional organizations constitute a further indication of the robust nature of IP activity in the region. On the flip side, it may be submitted that such organizations and institutes are intended for “western” consumption (including conventions, organizations, investors, and clientele) and are nothing more than a superficial veil that hides large-scale infringement. The former assessment is the more accurate one, although elements of the latter may also hold water because the bulk of groups and entities interested in IP are in-fact foreign (non-Arab). This issue will be addressed in later research.

## *B. An Overview of the World Trade Organization and the Intellectual Property Factor*

### *1. Origins of the WTO*

The WTO stems from the Uruguay round of trade negotiations,<sup>385</sup> which was completed in December of 1993. In its totality, the WTO embodies about thirty legal agreements as well as a substantial number of supplementary decisions. These were signed by one hundred states in April 1994. Since that date, the number of countries that have signed these agreements (and have become WTO members) has risen to 146.<sup>386</sup> Notably, the majority of these countries (about sixty-eight percent) are classified as “developing countries.”<sup>387</sup> In addition, about thirty of these countries are categorized as “least-developed countries.”<sup>388</sup> Interestingly, no Arab country that is a member of the WTO is classified in this later category. All of these Arab countries are classified in the intermediate category of “developing countries.”

---

384. Some of these also have an established presence on the Internet. For example, see [www.aspip.org](http://www.aspip.org) and [www.aidna.org](http://www.aidna.org).

385. See JOHN JACKSON ET AL., *LEGAL PROBLEMS OF INTERNATIONAL ECONOMIC RELATIONS* 289-326 (3d ed. 1995) (noting that the Uruguay Round of trade negotiations lasted from 1986 to 1994 and resulted in a better defined international organization).

386. For details of the WTO membership, see *Members and Observer*, at [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/org6\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm) (last visited Apr. 9, 2003) (copy on file with *The Transnational Lawyer*).

387. It is worth noting in this regard that the WTO does not provide any definitions of what constitutes a “developed” or “developing” country. Developing countries in the WTO are classified as such on the basis of “self election.” For more on this issue, see PETER GALLAGHER, *GUIDE TO THE WTO AND DEVELOPING COUNTRIES* (2000).

388. See *id.* (providing a list of the WTO members and indicating the countries that are “least developed.” In this regard, Gallagher also explains that this category of “least developed countries” (LDC) is one that is borrowed from a United Nations classification, whereby 48 countries are included in that category (30 of which are WTO members).

The WTO began operations on January 1, 1995 and is regarded as the more sophisticated successor of the General Agreement on Tariffs and Trade (GATT). The WTO perceives itself as a mechanism for facilitating and unifying international trade. As such, the WTO performs the following functions:<sup>389</sup>

1. Administration and implementation of the multilateral and plurilateral trade agreements that makeup the WTO;
2. Forum for multilateral trade negotiations;
3. Assistance to the resolution of international trade disputes;<sup>390</sup>
4. Oversight of international trade policies; and
5. Cooperation with other international institutions involved in global economic policy making.

## 2. *Intellectual Property Within the WTO Framework*

The WTO is comprised of various “multilateral as well a plurilateral agreements.”<sup>391</sup> The five main multilateral agreements binding on all WTO members address various international trade issues:<sup>392</sup>

1. GATT—General Agreement on Tariffs and Trade;<sup>393</sup>
2. GATS—General Agreement on Trade in Services;
3. TRIPS—Agreement on Trade Related Aspects of Intellectual Property Protection;
4. DSU—Understanding on the Dispute Settlement System; and
5. TPRM—Trade Policy Review Mechanism.

The WTO has a host of plurilateral agreements that cover specific trade areas. These agreements are not part of the main WTO engagement. They are only binding on an optional basis. This category of plurilateral agreements includes, for example, agreements pertaining to Civil Aircraft and Government Procurement.<sup>394</sup> As such, intellectual property issues addressed by the WTO within TRIPS are only a part of the WTO framework. The WTO administers and

---

389. For a discussion on the Middle East's role in the World Trade Organization, see [http://www.mid-eastlaw/middle\\_East\\_and\\_the\\_world\\_trade.htm](http://www.mid-eastlaw/middle_East_and_the_world_trade.htm) (last visited May 22, 2002) (copy on file with author) [hereinafter Middle East & WTO]

390. For a discussion regarding the aims and organs of dispute settlement under the WTO, see J. Waincymer, *Settlement of Disputes Within the World Trade Organization: A Guide to the Jurisprudence*, 24 WORLD ECON. No. 9, at 1247 (Sept. 2001).

391. Middle East & WTO, *supra* note 389; see also Meyer-Reumann, *The Endeavors of Gulf Countries to Meet WTO Requirements*, ARAB L. Q. 49 (2001).

392. See GALLAGHER, *supra* note 387, at 21 (explaining that in addition to these multilateral agreements, there are a number of ministerial decisions and declarations that supplement them)

393. *Id.* (noting that there are additional agreements covering trade in goods).

394. *Id.*

enforces the TRIPS agreement through administrative panels and dispute resolution mechanisms.<sup>395</sup>

### 3. *The Obligations that a WTO Membership Entails*

The multilateral agreements within the WTO require members to provide “National Treatment” (treating both imported and domestic products equally) and “Most Favored Nation” (treating all member states equally) status to all goods, services, and IP of all other members.<sup>396</sup> In addition, member-states are required to coordinate their trade policies and national laws in line with their respective obligations undertaken in the WTO.<sup>397</sup>

Also, member-states have to negotiate and comply with other specific obligations under the agreement.<sup>398</sup> These specific obligations address various critical issues without which the WTO would be rendered dysfunctional:

1. Reciprocity and equal treatment: This principle is intended to produce an equilibrium among member states, whereby equal treatment is expected but reciprocity may still be invoked in certain cases.
2. Transparency in trade and legal regimes: A host of obligations in the WTO are intended to strengthen such transparency in trade. Clear and transparent norms pertaining to trade will, it is generally believed, facilitate more efficient international trade. In other words, where trading parties are more easily able to foresee the rules and effects of their trade activities, they can more easily and efficiently calculate their steps. In addition, where disagreements or conflicts between members do arise, legal mechanisms should be capable of handling them. That is why the WTO calls for establishing and maintaining administrative and judicial mechanisms as well as creating inquiry points and publishing and administering trade negotiations.<sup>399</sup>
3. Reducing trade barriers: According to the theory of comparative advantage, the free market forces will create the equilibrium in international trade. Therefore, in essence, the WTO attempts to reduce trade barriers to the lowest possible limits, so as to create a “semi-conductive” market of international trade. To attain this goal,

---

395. See INTA, *TRIPS 2000 Subcommittee Treaty Analysis Committee, Developing Countries Compliance with the TRIPS Agreement*, available at [www.inta.org](http://www.inta.org) (updated ver., Oct. 1999) (copy on file with author).

396. *Id.*

397. Middle East & WTO, *supra* note 389.

398. *Id.*

399. *Id.*

the WTO compels members to refrain from imposing charges and duties on goods in transit as well as quantitative restrictions and trade restrictive business practices.<sup>400</sup>

Consequently, member-states are obligated to carryout various measures, including:<sup>401</sup>

- a. Transparency of economic policy and economic legislation: setting clear tariffs on goods. Such tariffs are intended to be the only form of trade barrier;
- b. Opening national service industries to investors and service providers of other member countries;
- c. Limiting anti-dumping and countervailing duties and reducing levies on transit goods as well as certain duties;
- d. Monitoring and reporting on monopolies and state trading enterprises;
- e. Minimizing the disruptive effect of subsidies and tax incentives;
- f. Adopting (into national legislation) norms and standards aimed at protecting intellectual property rights; and
- g. Protecting the environment.

#### *4. The WTO Accession Process*

For those countries (such as Jordan and Saudi Arabia) that did not become members of the WTO at its inception, membership is achieved through a predetermined process of accession.<sup>402</sup> As shown below, this process of accession also binds countries (such as Syria) that had pulled out of the GATT and did not return by the end of 1994.

Applications of prospective member-states are scrutinized and applicant states must undertake and implement obligations including those dealing with intellectual property protection. Below is an outline of the accession process.<sup>403</sup> The outline will assist in understanding how prospective member-states undertake commitments regarding trademark protection:

- a. Applicant country initiates its accession process by submitting a letter to the WTO indicating its desire to join the WTO.

---

400. *Id.* at 1-2.

401. *Id.* at 1-2; *see also* Meyer-Reumann, *supra* note 391, at 49.

402. For a concise and illustrative summary of the WTO accession process, see Jordanian Ministry of Industry and Trade, *Policy Reform: World Trade Organization Membership Process and Requirements* (published with the assistance of AMIR Program/USAID).

403. Middle East & WTO, *supra* note 389.



- b. Applicant state is required to submit a memorandum detailing all aspects of its trade and economy that have a bearing on WTO agreements.
- c. Following receipt of these documents, the WTO sets up a working party intended to review the memorandum.
- d. Simultaneously, the applicant state is required to engage WTO members in negotiations aimed at establishing its concessions and commitments with respect to goods and services.
- e. During these negotiations, applicant country must submit a special questionnaire dealing with its outstanding accession issues.
- f. If and when the accession negotiations are concluded successfully, the applicant's policies are determined to be compatible with WTO requirements. At this stage, the issue is referred to the working party that conducts a revision of the applicant's tariff protections. The applicant, in turn, is required to undertake certain obligations that are to be fulfilled within a designated timeframe.
- g. Once the parties have done all of the above, the working party submits an accession report to the Ministerial Council. This report typically contains basic terms of the accession, draft protocol of the accession, and agreed schedules.
- h. The Ministerial Council is the WTO body authorized to adopt and approve accession reports. Following such approval, the applicant country signs and (when applicable) ratifies the protocol, thus attaining membership in the WTO.

### C. *Trademark Protection Within the WTO Scheme: TRIPS*

The Agreement on Trade Related Aspects of Intellectual Property Protection (TRIPS) came into effect on January 1, 1995. In general, TRIPS identifies various trade-related norms pertaining to IPRs as well as patents, trademarks, copyright and related rights,<sup>404</sup> geographical indications, industrial designs, layout-designs of integrated circuits, and undisclosed information (trade secrets).<sup>405</sup> In addition to new subject matter and new standards of protection, TRIPS covers basic principles found in preceding IP conventions and treaties.<sup>406</sup>

---

404. See GALLAGHER, *supra* note 387, at 181 (noting that these related rights include rights of performers, producers of phonograms, and broadcasting organizations).

405. For concise summary of TRIPS, see Southcenter, *Main Provisions of the TRIPS Agreement*, at 1-4, <http://www.southcenter.org/publications/trips/tripsmaintext/trans-02.htm> (last visited July 10, 2002) (copy on file with *The Transnational Lawyer*).

406. DANIEL GERVAIS, *THE TRIPS AGREEMENT, DRAFTING HISTORY AND ANALYSIS*, (London, Sweet & Maxwell 1998).

The standards contained within TRIPS covers various issues, the most notable of which are “availability, scope and use of IPRs, effective and appropriate enforcement, multilateral dispute settlement procedures, and transitional arrangements for developing countries.”<sup>407</sup> TRIPS prescribes minimum substantive standards of protection for each of the IPRs. In this regard, TRIPS “spells out” for each IP category the subject matter to be protected, the scope of the right to be granted, and the terms of protection.<sup>408</sup> These minimum standards are essentially derived from the main international conventions that have been “negotiated under the auspices of WIPO.”<sup>409</sup>

Consequently, WTO members are required, through TRIPS, to comply with the substantive provisions of various international agreements and conventions dealing with IP protection, the most notable of which are:<sup>410</sup>

- a. The Paris Convention for the Protection of Industrial Property;
- b. The Bern Convention on the Protection of Literary and Artistic Works; and
- c. The Washington Treaty on Intellectual Property in Respect of Integrated Circuits.

In a nutshell, with respect to trademarks, TRIPS is intended to protect marks and counter trade in counterfeit goods. TRIPS has three main features which assist in attaining such protection for trademarks.<sup>411</sup>

### *1. Setting Minimum Standards of Protection*

With respect to trademarks, TRIPS sets standards pertaining to:

- a. Certain basic rights afforded to owners of trademarks and service marks;
- b. Protection of well-known marks;
- c. Initial minimum term (of seven years) for the initial stage of a trademark registration;
- d. Possibility for indefinite renewal periods for registrations of marks;
- e. Possibility of canceling the registration of a mark due to non-use (subject to exceptions);
- f. The right to use a mark without conditions; and
- g. Issues of licensing and assignment.

---

407. *INTA*, *supra* note 404, at 3.

408. *Id.*

409. *Id.*

410. *Id.* at 182.

411. GALLAGHER, *supra* note 387, at 181.

Notwithstanding these specified, detailed, and unified standards, TRIPS allows its members to exercise some independence, including the right to limit the scope of rights within certain bounds, the right to grant compulsory licenses under certain conditions, and the right to take measures to prevent abusive anti-competitive practices.<sup>412</sup>

## 2. *Enforcement Within National Laws*

In view of the fact that IP protection must be handled by states within their own jurisdictions, TRIPS specifies certain procedures and remedies that are to be made available in the national laws of all WTO members.<sup>413</sup> This defining feature of TRIPS, whereby member states undertake (and are obligated) to amend their national laws, is not to be taken lightly. In this regard, TRIPS varies widely from past IP agreements in that it effectively provides “teeth” that help ensure its implementation and enforcement.

Importantly, the TRIPS obligations undertaken by members are progressively implemented.<sup>414</sup> The deadline for implementation depends upon that member’s classification: “developed countries” had until 1995, “developing countries” had until January 2000; and “least-developed countries” were granted 11 years in which to implement TRIPS, namely until 2006.<sup>415</sup>

## 3. *Settling Disputes Pertaining to Intellectual Property*

The third important feature of TRIPS is its ability to settle disputes between member states regarding IP issues and rights thereof. TRIPS achieves this by applying the WTO “dispute settlement mechanism.” The WTO dispute settlement mechanism is triggered where a conflict arises between members over issues covered by TRIPS.<sup>416</sup> This mechanism also covers disputes pertaining to National Treatment as well as issues of Most Favored Nation status. However, Gray Market (essentially the unauthorized market for specific goods, *i.e.*, some goods are made for export only but creep back into domestic markets) issues are not regulated by TRIPS. Consequently, issues pertaining to exhaustion of IPRs have been left without the scope of the dispute settlement mechanism.<sup>417</sup>

---

412. *Id.*

413. *Id.* at 181.

414. GALLAGHER, *supra* note 389, at 53.

415. *Id.* (noting that those least-developed countries may have the possibility of extending the implementation deadline beyond 2006).

416. *Id.* at 182.

417. *Id.* Indeed, the entire TRIPS agreement.

D. WTO Membership of Arab Countries

In the eight years of the WTO's existence, a number of Arab countries have attained membership in this lucrative club.<sup>418</sup> These countries are Bahrain and Kuwait (both on January 1, 1995), Egypt (June 30, 1995), Qatar (January 13, 1996), the United Arab Emirates (April 10, 1996), Jordan (April 11, 1999), Mauritania (May 31, 1995), Morocco (January 1, 1995), Oman (November 9, 2000), and Tunisia (March 29, 1995). Yemen was granted observer status in mid 1999. Saudi Arabia and Lebanon began their accession process a few years ago.<sup>419</sup> Interestingly, Syria has applied to re-join the WTO after withdrawing because the WTO accepted Israel as a member. Its accession talks are underway.

In order to better understand the impact of the WTO membership on ACME, one must look at the process of the four ACMEs.

1. Egypt's Membership in the WTO

Egypt has been a member of the WTO since June 30, 1995. However, Egypt remains obligated to achieve greater coherence with WTO norms, especially on the following issues:<sup>420</sup>

1. Commitment to more sectors in the trade and services agreement—GATS: Until mid-1999, Egypt had committed to only four of the twelve sectors covered by GATS, namely construction, finance, tourism, and transport. Not surprisingly, Egypt was subjected to pressure toward committing to more sectors in GATS, in accordance with its WTO obligations. Particularly, Egypt was required to “open and liberalize”<sup>421</sup> its telecommunications sector. Indeed, the telecom issue constituted the main area of discussion in the WTO round of trade negotiations held in Seattle in November 1999. In light of this pressure Egypt has offered the sale of up to twenty percent of Telecom Egypt.<sup>422</sup> In 1998, the Egyptian government enacted a series

---

418. For more on WTO membership and compliance (with WTO standards) in the Middle East, see Reema I. Ali & Loubna W. Haddad, *WTO Membership and Compliance in the Middle East Countries*, MEER (Sept. 1999), at 11.

419. See Middle East & WTO, *supra* note 389.

420. Middle East & WTO, *supra* note 389. For a comprehensive analysis of Egypt's obligations and commitments under the GATT/WTO Agreement, see Nathan Associates, Inc., *Development Economic Policy Reform Analysis (DEPRA) Project, Egypt: Obligations and Commitments Under the GATT/WTO Agreements (Final Report)* (Aug. 1999) submitted to U.S. Agency for International Development (USAID-Egypt).

421. Middle East & WTO, *supra* note 389.

422. *Id.* at 4. This issue of Egypt's continued liberalization of its service sectors was one of the focal points of Egypt's (second) Trade Policy review held in June 1999. The review session also debated Egypt's economic environment and its trade policies and practices. While the members of this board commended Egypt on its economic reforms, they stressed that Egypt needed to diversify its exports, attract more foreign investment, and achieve greater transparency.

of laws designed to facilitate foreign investment. These include:<sup>423</sup> the Egyptian Banking Law<sup>424</sup> No. 155 of 1998 and the Insurance Law<sup>425</sup> No. 156 of 1998 as well as others.

2. Moreover, concern continues to be voiced regarding some of Egypt's trade policies and practices with respect to their conformity with WTO requirements. These concerns center on certain tariffs as well as on IP legislation.<sup>426</sup>
3. IP protection and enforcement remains a concern. As I shall show, Egypt appears to be working diligently towards improving protection and enforcement of IPRs. The new Egyptian IP law is a testimony to these efforts.

Despite these pending issues, Egypt (as well as Kuwait and recently Jordan) are seen as the most "visibly active"<sup>427</sup> Arab countries in their efforts to achieve compliance with WTO standards and requirements.<sup>428</sup>

## 2. Jordan's Successful Bid to Join the WTO

Jordan requested to join the WTO on September 25, 1995. Jordan's accession negotiations, mainly with the United States, revolved around a host of issues, including IP protection, privatization, market access, investment, and reduction of import duties.<sup>429</sup> As shown below, in its bid to join the WTO Jordan was required to boost its protection for IPRs. At that time, the United States had voiced concerns and issued warnings over the lack of IP laws in Jordan.

Initially, Jordan's response to the WTO requirements appeared to be limited to promises of "future action."<sup>430</sup> However, Jordan did introduce many changes in its legislation, most notably with respect to the protection of IPRs.

The bilateral negotiations held between Jordan and the United States focused mainly on IP protection.<sup>431</sup> After negotiations between the U.S. and Jordan

---

423. Howard L. Stovall & Harold Ullman, *Middle East Commercial Law Developments*, 33 INT'L LAW. 753, 753-54 (1999). For more examples of Egypt's steps towards innovation and privatization, see *id.* at 753-55.

424. *Id.* at 754 (contending that this banking law permits foreign ownership of Egyptian banks (up to a 10% cap on shares owned by any one party)).

425. *Id.* at 754. This law amended Egyptian Law No. 91 of 1995 by "removing the forty-nine percent ceiling on foreign ownership, permitting privatization of national insurance companies and abolishing the ban on foreign nationals serving as corporate officers."

426. Middle East & WTO, *supra* note 389.

427. *Id.* In addition, Egypt is one of 14 developing countries (and 5 developed countries) that founded the Advisory Center on WTO Law. This Center is to provide seminars on WTO jurisprudence and legal advice on WTO legal questions. This Center began its operation at the end of 2000, and its membership is open to all WTO member states.

428. *Id.*

429. *Id.*

430. *Id.*

431. Gary G. Yerkey, *Intellectual Property: US, Jordan Hold Talks in Effort to Avoid Sanctions over IP Protection*, 15 Int'l Trade Rep. (BNA) 661 (Apr. 1998).

lingered over the protection of IPRs and even after 1998, three years after Jordan formally requested to join the WTO, the United States continued to express “serious concerns” surrounding the inadequacy of IPR protection in Jordan.<sup>432</sup> Among other things, the United States was troubled by the lack of patent protection for pharmaceutical products as well as deficiencies in copyright and trademark laws.<sup>433</sup>

Much like copyright protection, Jordan’s trademark protection was criticized. For example, the pre-amended Jordanian trademark law granted trademark rights to persons or entities first to register in Jordan, without regard to prior use in Jordan or elsewhere. This approach allowed third parties to acquire rights to internationally famous marks by registering them in Jordan as their own.<sup>434</sup> This situation was completely unacceptable to western countries, especially the United States. Thus, the Jordanian government was subjected to substantial pressure to improve its protection of IPRs. This pressure proved effective as it coincided with Jordan’s bid to join the WTO.<sup>435</sup> During the course of these negotiations, which were spread over years, the United States made it clear that if Jordan did not resolve these outstanding IP issues, Jordan would be targeted under the special 301 provision of the 1998 U.S. Omnibus Trade and Competitiveness Act, which allows the United States to take unilateral trade action against countries that do not adequately protect U.S. intellectual property.<sup>436</sup> These somber “warning shots” across Jordan’s bow, issued in April 1998, were not to be taken lightly since Jordan had already been placed on USTR’s “watch list” the year before (in April 1997).<sup>437</sup>

Following these developments, the Jordanian government diligently approved IP legislation satisfying the TRIPS mandate. In return, the U.S. Trade Representative (USTR) announced on December 10, 1999 that the United States was removing Jordan from its the watch list. What is more, the USTR praised Jordan for demonstrating an “impressive level and strength of commitment toward providing effective protection for all forms of intellectual property.”<sup>438</sup> However, the USTR maintained that Jordan would remain subject to future

---

432. *Id.*

433. Gary Yerkey, *Intellectual Property: U.S. Removes Jordan from “Watch List” of Special 301 Nations Failing to Protect IP*, 16 Int’l Trade Rep. (BNA) 2047 (Dec. 1999).

434. Joseph Sofer, et al., *Piracy Development in the Middle East*, 5-6 J. OF PROPRIETARY RIGHTS 26 (1994).

435. *Id.*

436. Yerkey, *supra* note 431 at 661 (reporting that Mr. Stuart E. Eizenstat, the U.S. Undersecretary of State for Economic, Business and Agricultural Affairs, said that the discussions would influence, in particular, whether Jordan will be targeted under the special 301 provision). The Undersecretary reportedly stated: “. . . we are hopeful that steps can be taken to avoid [this] . . . but this will depend on what progress is being made in Jordan.”)

437. For more, see BNA, *USTR’s Annual IP Report for 1997*, 14 Int’l Trade Rep. (BNA) 812 (May 7, 1997).

438. Yerkey, *supra* note 433, at 2047.

review with respect to actual implementation and enforcement of its improved regime for protection of intellectual property.<sup>439</sup>

Once these obstacles were removed, Jordan was able to proceed towards WTO membership. Consequently, on April 11, 2000, Jordan became the 136th member of the WTO<sup>440</sup> and Jordan's population welcomed its removal from the U.S. watch list. The Jordanian National Center for Intellectual Property Rights, which announced this removal, submitted that the door to foreign direct investment was opened thanks to proper enforcement of IP laws. The Center indicated that this new openness was largely a result of Jordan's joining the WTO and concluding a Free Trade Agreement with the United States.<sup>441</sup>

Some diplomats are said to have described Jordan's accession bid to the WTO as being "paved with good intentions."<sup>442</sup> Others indicate that the Clinton administration played a vital role in pushing hard to help ensure the removal of obstacles in the path of Jordan's bid. According to this view, Jordan's successful bid is in many respects owed to the Jordanian-Israeli peace agreement declared in Washington and signed in October 1994.<sup>443</sup>

Despite the welcoming gestures made by the United States as well as some Jordanian commentators, there are those who question the benefit of the WTO for Middle East trade.<sup>444</sup>

### 3. *Saudi Arabia's Bid to Join the WTO*

Saudi Arabia is requested accession to the WTO dates back to December 12, 1995.<sup>445</sup> Following that request, a working party was soon established (in early 1996).<sup>446</sup> However, although seven years have lapsed since then, Saudi's accession has not yet come into effect.

The on-going accession talks and bilateral negotiations between Saudi Arabia and WTO members have highlighted various issues requiring resolution. These issues include the "protection of IPRs, reduction of tariff levels, amendment of agency laws and settlement of legal disputes."<sup>447</sup>

---

439. *Id.*

440. *See Jordan Joins WTO as the 136th Member*, JORDANIAN TIMES, at <http://www.jordanembassyus.org/04122000005.htm>. Note that Jordan signed two plurilateral WTO accords on government procurement and trade in civil aircraft.

441. *See February 2002 News Bulletin*, Saba, at [www.saba.org](http://www.saba.org) (copy on file with author).

442. *Jordan First to Join WTO from the New Batch of Arab Countries Seeking Accession*, in WORLD TRADE AGENDA, at <http://www.tradeagenda.com/news99/99172.html> (Dec. 17, 1999).

443. *Id.*

444. *Id.*

445. *See Meyer-Reumann*, *supra* note 391, at 50 (noting that during the 1980s, the Kingdom expressed its interest in becoming a GATT member). However, according to this commentator, Saudi Arabia never applied for full GATT membership but kept an observer status. *Id.*

446. *See Middle East & WTO*, *supra* note 389.

447. *Id.*; *see also Meyer-Reumann*, *supra* note 391, at 50; *see also Richard Dean*, *WTO: Warm Welcome?*, GULF BUS., Apr. 2000, at 37.

The Saudi government, on its part, did not sit idle, but made substantial steps towards overcoming some of these obstacles, the most notable of which are:

1. Increasing and facilitating direct foreign investment in Saudi Arabia. On April 15, 2000 this resulted in the new Foreign Capital Investment Law.<sup>448</sup> In addition, the Saudi Government is considering establishing an investment body whose role is to review the current laws and propose incentives to foreign investors.<sup>449</sup>
2. More significantly, Saudi Arabia has made efforts toward privatization. One manifestation of this is its corporatization of its telecommunications sector and its subsequent creation of the Saudi Telecommunication Company. In addition, Saudi Arabia has embarked on restructuring its electricity sector as well as privatization of its national airlines.<sup>450</sup>

Despite these efforts on the part of the Saudi government, its bid for accession to the WTO has not yet been approved. Some commentators maintain that direct responsibility for this delay rests squarely on the shoulders of the Saudi government and its lack of sincere interest in advancing the accession process.<sup>451</sup> Some commentators go further in asserting that the Saudis are purposefully delaying the process. However, it is clear that the following are various contributing factors:<sup>452</sup>

1. The recent rise in world oil prices strengthened Saudi Arabia's (the leading member in OPEC) economy and lessened its incentive to join the WTO. This position was, reportedly, visible in the Saudi attitude to the accession during the meeting of the working party held in October 2000 at Geneva. As noted earlier, it appeared to some as though the Saudis were deliberately slowing their accession bid.
2. In spite of various tariff cuts and bindings offered by the Saudis during the negotiations, trading partners remained firm in their position in asking for more concessions in the field of services and specifically telecommunications, distribution, insurance, and banking.<sup>453</sup> With respect to the last category, the Saudis cited various religious constraints dictated by Islamic banking.<sup>454</sup> This complicated

---

448. In this regard, it should be noted that as early as 1998 Saudi was considering amendments to its foreign capital investment code.

449. See Middle East & WTO, *supra* note 389.

450. *Id.*

451. *Id.*

452. WORLD TRADE AGENDA, (iss. 00/20, Nov. 2000), at <http://www.tradeagenda.com/news2000/wto00203.htm> (last visited May 22, 2002) (copy on file with author).

453. *Id.*

454. *Id.*



the picture even more. The Saudis also imposed religious constraints regarding certain foods and cultural issues.<sup>455</sup>

3. An additional “sticking point”<sup>456</sup> is the Arab boycott of Israel. Apparently, Saudi Arabia is not ready to abolish the boycott. As noted earlier, this has contributed to straining relations with the United States, which observes anti-boycott rules.

The protection of intellectual property also plays an important role in the negotiations of the working party presiding over the Saudi bid. Indeed, as early as 1996, the Saudi policy (or lack thereof) on intellectual property came under heavy scrutiny by WTO member states. This harsh line led by the United States and the European Union brought the issue of intellectual property enforcement, especially with respect to counterfeit goods, to the forefront of these accession talks.<sup>457</sup> Saudi Arabia responded to these concerns with understanding, but reiterated its resolve to join the WTO as soon as possible.<sup>458</sup>

Curiously, although Saudi Arabia was removed in 1989 from the “priority watch list,” it remained for more than a decade (after that) on the “watch list” of countries being monitored for failing to adequately protect U.S. intellectual property, such as sound recordings and pharmaceutical products.<sup>459</sup>

It appears the Saudi legal reform process has not been dormant. In October 2001, the Saudi Council of Consultants (*Shourah*) reviewed a draft trademark law proposed by the *Shourah*'s Economic Affairs Committee.<sup>460</sup> The proposed law is intended to replace the existing trademark law and encompass all aspects of trademarks, including application, examination, registration, transfer, licensing, and protection. In addition, this expansive piece of legislation is intended to incorporate various regulations and practices adopted by the Saudi trademark office.<sup>461</sup> After its review, this draft law will be forwarded to the Council of Ministers for final consideration and approval.<sup>462</sup>

In addition to this notable legislative process, the Saudi government issued in September 2001 a ministerial decision that implemented the new classification of goods and services into Saudi law. Therefore, Saudi trademark law now has

---

455. *Id.*

456. *Id.*

457. The Bureau of National Affairs, *Intellectual Property; Saudi Arabia Faces Questions in WTO on Intellectual Property*, 13 Int'l Trade Rep. (BNA) 1756 (Africa/Middle East, Nov. 13, 1996).

458. *Id.* (reporting that Saudi Commerce Minister Osamah Bin Jaafar Bin Ibrahim Fagih led a 40-person delegation to the meeting, recognizing these concerns over copyright protection and protection against counterfeit goods in his country). Notwithstanding, the Minister noted: “. . . we are very concerned to move this process forward and hope that we can see Saudi Arabia as a member of the WTO by mid-1997.” *Id.*

459. Bureau of National Affairs, *Foreign Trade, USTR*, 53 Pat. Trademark & Copyright J. (BNA) 187 (1999).

460. See *October 2001 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/10\\_01.htm](http://www.agip.com/agipnews/bulletin/10_01.htm) (last visited Apr. 9, 2002) [hereinafter *October News Bulletin*] (copy on file with *The Transnational Lawyer*).

461. This expansive and comprehensive law includes 62 articles.

462. See *October News Bulletin*, *supra* note 460.

forty-five classes of goods and services in accordance with the amended Nice classification of goods and services.<sup>463</sup>

It should be noted that the delay in Saudi Arabia's entry into the WTO does not rest solely on intellectual property issues. In fact, as discussed above, some commentators blame the delay on the lack of sufficient access to various business and service sectors within the Kingdom of Saudi Arabia. These sectors with insufficient access include telecommunications, oil, health, insurance, pharmaceuticals, and banking.<sup>464</sup>

The prospects of Saudi Arabia joining the WTO remain bleak and the saga continues. Despite the longevity of the Saudi negotiation process (since 1995), commentators generally agree that WTO membership (for Saudi Arabia) "remains a goal that will not be realized any time soon."<sup>465</sup> In this context one commentator has summarized the situation as follows:

*"The WTO wants to see a more concerted effort by the Saudi Arabian government to combat intellectual property piracy before member countries such as the European Union and the United States lend their support to Saudi Arabia's long-overdue admittance to the international trade organization."*<sup>466</sup>

This situation renders Saudi Arabia the only country in the Gulf Cooperation Council (GCC) outside the WTO.<sup>467</sup> The other members of the GCC - Bahrain, Kuwait, Oman, Qatar, and United Arab Emirates (UAE) - are members of the WTO.<sup>468</sup> In addition, some of the GCC states (such as Kuwait) have joined

---

463. *Id.* WIPO amended the Nice Classification of the existing class 42 into four new classes, 42 through 45. This new classification, which became effective on January 1, 2002, has been adopted by many countries worldwide, including Jordan and Israel. Service classes 42 through 45 will read as follows: class 42: Scientific and technological services and research and design thereto; industrial analysis and research services; design and development of computer hardware and software; legal services. Class 43: Services for providing food and drink; temporary accommodation. Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agricultural, horticulture and forestry services. Class 45: Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

464. Alnowaiser, *supra* note 216.

465. *Id.*

466. Alnowaiser, *Newsletter June & July 2001*, at <http://www.lfkan.com> (July 2001) (copy on file with author).

467. For a review of the commitment to WTO requirements by Gulf countries, see Meyer-Reuman, *supra* note 391. The countries surveyed in that review include the UAE, Saudi Arabia, Bahrain, Kuwait, Oman, Qatar, and Yemen.

468. Alnowaiser, *supra* note 466. In addition to these members of the GCC, other Arab countries have attained WTO membership, including Egypt, Jordan, Morocco, and Tunisia. Additional Arab countries such as Sudan, Algeria, Lebanon, Yemen, and Syria are seeking WTO membership.

WIPO.<sup>469</sup> This creates an odd situation since Saudi Arabia is the (uncontested) dominant member of the GCC.<sup>470</sup>

GCC appears to be very active in bringing its member states to update their respective IP laws in line with the TRIPS (WTO) standards.<sup>471</sup> In January 2002, the GCC held its fifty-second Summit in Riyadh, Saudi Arabia during which its ministers called upon the member-states to conform with TRIPS. What is more, a special team is responsible for following up with the member states on this legal process.<sup>472</sup>

The GCC activities pertaining to IP protection have been going on for some time now and have not been limited to conferences and meetings. In late 1998, the GCC officially opened its patent office in Riyadh (Saudi Arabia).<sup>473</sup> According to the GCC patent system, "patent holders are able to register their patent at one location to cover the six GCC countries."<sup>474</sup> In other words, once a patent owner registers his patent with the GCC patent office, he is automatically afforded protection throughout the GCC member countries.<sup>475</sup> Indeed, the GCC patent application and examination process is well underway, although some commentators contend that additional amendments are warranted.<sup>476</sup>

In April 2001, the GCC Patent System was the focal point of a meeting organized by WIPO. The meeting, which was attended by representatives of all GCC member states, dealt with changes in the patent system.<sup>477</sup> This full attendance provides a showing of the importance afforded to IP issues by these countries.

---

469. Kuwait joined WIPO in April 1998; its membership became official in July of the same year. For a report on this, see *Kuwait Joins WIPO*, 15 Int'l Trade Rep. (BNA) 935, at 1 (1998).

470. For an analysis of the intra-regional integration among GCC countries, see Dar & Presley, *The Gulf Co-Operation Council: A Slow Path to Integration?*, 24 WORLD ECO. No. 9, at 1161 (Sept. 2001).

471. For more on the GCC's activities with respect to reviewing the IP system, see Saba, *News Bulletin January 2002*, at <http://www.saba.org/bulletin> (last visited Jan. 2002) [hereinafter *January 2002 Newsletter*] (copy on file with the author).

472. See *February 2002 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/2\\_03.htm](http://www.agip.com/agipnews/bulletin/2_03.htm) (copy on file with *The Transnational Lawyer*).

473. The GCC patent Office became operational in February 1999.

474. Stovall & Ullman, *supra* note 423, at 760.

475. *Id.*

476. See *May 2001 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/5\\_01.htm](http://www.agip.com/agipnews/bulletin/5_01.htm) (last visited Apr. 9, 2003) (copy on file with author). The GCC Patent Office was inaugurated on February 21, 1999 in Riyadh, Saudi Arabia. Reportedly, this new Patent Office began its activities in stride, and within only four months (by April 2001), 72 patents had already passed the initial substantive examination stage. Thereafter, the patents were transferred to the GCC member states for their comments and, ultimately, their approval.

477. See *July 2001 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/7\\_01.htm](http://www.agip.com/agipnews/bulletin/7_01.htm) (last visited Apr. 9, 2003) (copy on file with author) (reporting that the meeting was held on April 24-25, 2001 in Doha, Qatar, and attended by representatives of the six states comprising the GCC: Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and UAE).

#### 4. Syria's Delayed Bid to Join the WTO

In November 2001, Syria officially requested to join the WTO. In its request, Syria stated its commitment to the objectives of the WTO.<sup>478</sup> This step, undertaken by the Syrian government, had been preceded by a long and harsh debate within Syria over the question of accession to the WTO.<sup>479</sup> In fact, this disagreement was evident within the Syrian cabinet. While the Syrian Ministry of Economy favored accession to the WTO, the Ministry of Finance opposed joining the WTO, reasoning that would adversely affect Syria's revenues from excise and duties.<sup>480</sup>

Reportedly, in 2000, the Syrian government called on the Ministry of Economy to form a committee of experts, which was to study the implications of Syria's prospective accession to the WTO. The committee found that while in the short run Syria's financial interests would be damaged, in the intermediate and long run there would be positive results for the country. Consequently, Syria has applied for full membership in the WTO rather than the limited observer status as was initially contemplated.<sup>481</sup>

In 1947, Syria was among the first countries to join GATT; however, just three years later (in 1951) Syria pulled out of the GATT in protest of Israel's accession to GATT.<sup>482</sup> The WTO allowed countries that withdrew from GATT to re-join until 1994, but Syria missed that window of opportunity.

Consequently, Syria's current application has been treated by the WTO as a fresh application and, thus, entails all of the procedures and preconditions set by the WTO for any state wishing to join the organization.<sup>483</sup> Essentially, Syria is now required to undergo the entire accession process and engage in negotiations with the WTO and with each of the WTO member states separately. Similarly, Syria is required to submit a comprehensive memorandum detailing the state of its economy as well as the rules pertaining to intellectual property, foreign trade, investment, and monetary structure.<sup>484</sup> In fact, some Syrian officials reportedly claimed that this was a result of Israeli and U.S. pressure to delay Syria's acceptance into the WTO.<sup>485</sup>

---

478. See *Syria Has Officially Asked to Join WTO*, Arabic News, at 1, <http://www.arabicnews.com/ansub/daily/day/01113/2001111317.html> (last visited July 4, 2002).

479. In fact, Syria's request came only after the consent of the ruling Ba'ath party.

480. See *Business*, at [www.Syria-online.com](http://www.Syria-online.com) (copy on file with author).

481. Mr. Ghassan Habash, in his capacity of Director of the International Department at the Syrian Ministry of Economy, clarified Syria's application for full membership within the WTO.

482. *Id.*

483. *Syria Has Officially Asked to Join WTO*, *supra* note 478.

484. *Id.* In preparation for these accession talks and negotiations, Syria formed four committees. Each was entrusted with one of the said issues, including foreign trade, services, and monetary affairs.

485. See, e.g., *Al-Rifai: Israel Tries to Delay Discussions on Syria's WTO Bid*, at 1, [www.syria-report.com/news104.htm](http://www.syria-report.com/news104.htm) (last visited July 3, 2002). The report refers to comments made by the Syria Economy Minister, Mr. Ghassan Al-Rifai, in an interview with Al-Hayat newspaper. For more on this, see *Syria and the WTO, Syria: Economics*, Arabic News, Nov. 17, 2001, at 1, <http://www.arabicnews.com/ansub/daily/day/01117/2001111713.html>.

Syria has, reportedly, actively sought support for its bid from European countries.<sup>486</sup> Additionally, Syria has been looking beyond the WTO and considering an association agreement with the EU as well as additional free trade agreements with Arab countries.<sup>487</sup>

##### 5. Israel's Accession to the WTO and Compliance with TRIPS

Israel, much like the four ACMEs, has introduced amendments to its IP law. The amendment to Israel's IP laws came into force on January 1, 2000, the deadline for Israel's compliance with the WTO-TRIPS provisions.<sup>488</sup>

The amendment (much like its Jordanian counterpart) addressed various IP issues. In general terms, the amendments pertaining to trademark protection and enforcement introduced into the Israeli Trademark Ordinance are:

- a. Introduction of the concept of well-known marks.<sup>489</sup>
- b. Defining the functions of trademarks as geographical indications.
- c. Lowering the distinctiveness threshold required when basing a trademark registration, in accordance with section 6 Quinquies of the Paris Convention (*i.e.*, the *telle quelle* provision).
- d. Extending the non-use grace period by one year (from two to three years).
- e. Encouraging the Israeli customs authorities to intervene in cases relating to goods suspect of trademark infringement.

While other Middle Eastern countries<sup>490</sup> and the Palestinian Authority<sup>491</sup> have embarked on legislative changes pertaining to IP protection, these changes are not addressed in this Article.

---

486. See *Syria Has Officially Asked to Join WTO*, *supra* note 478.

487. *Id.* Mr. Al-Rifai also, reportedly, noted Syria seeks to have FTAs with all of the Arab Countries by 2004.

488. Dr. Ilan Cohen, *Israel: Amendments of Israeli IP Laws Complying with TRIPS*, MONDAQ BUS. BRIEFING, July 6, 2001, at 2. For a general survey of all of the IP field in Israel, see *Recent Developments in Intellectual Property Rights in Israel*, ISRAELI MINISTRY OF JUSTICE, Jerusalem) (Feb. 2001).

489. For an in-depth analysis of the protection afforded to well-known and famous marks in Israel before and after the amendment of Israeli trademark law, see Amir H. Khoury, *Protection of Well-Known and Famous Trademarks in Israel: TRIPS from Manhattan to the Dawn of a New Millenium*, 12 FORDHAM J. INTEL. PROP. MEDIA & ENT. L.J. 991 (2002).

490. In the early part of 1998, Lebanon began preparing its bid to join the WTO. Just as in the case of other countries wishing to join the WTO, Lebanon started a major overhaul of its "decades-old" IP laws. For more on this, see for an example *Briefs: Patents, Trademarks and Copyright Law, News Development Briefs*, Pat. Trademark & Copyright L. Daily (BNA) (Apr. 17, 1998).

491. The Palestinians have also been trying to boost IP protection in the Palestinian National Authority areas. Only recently, in the thick of the current tragic situation, have the Palestinians established a center for IPRs. The first meeting was held in Ramallah on February 10, 2002. See Al-Hayat-al-Jadidah, Newspaper, Ramallah (published in Arabic Feb. 12, 2002).

In summary, it is evident that all countries wishing to join the WTO or who are already members of this organization have had to, among other things, raise the level of protection afforded to all types of IP, including trademarks. The United States appears to be the vanguard or even the guardian of such protection and the propelling force behind legislative amendments adopted by prospective member-states in the Middle East.

#### IV. THE EFFECTIVENESS OF TRADEMARK PROTECTION AND ENFORCEMENT IN ARAB COUNTRIES OF THE MIDDLE EAST

In the first two Parts of this Article examined the current trademark laws in ACME and illuminated their conformity with modern standards of trademark protection. To complete this discussion, it is necessary to see how trademark protection actually functions. Here, I will address the effectiveness of trademark enforcement in ACME, shedding light on the scope and types of trademark infringement and the way in which they are mitigated.

##### A. *The First Substantial Encounter of Countries in the Middle East with Intellectual Property Piracy*

Concerns for IP piracy in the Middle East began emerging as early as the mid-1980s. This concern coincided with the strengthening of IP protection in the Far East. In the second part of the 1980s, the United States successfully concluded negotiations with a number of Far East countries, namely Korea and Singapore. These talks were aimed at boosting protection for United States. IPRs in those countries.<sup>492</sup>

Singapore, the center for IP piracy at the time, had enacted and enforced a copyright law with firm penalties against piracy.<sup>493</sup> This change of attitude in Singapore came in large part as a result of the Generalized System of Preferences (GSP) in the form of trading rights granted by the United States.<sup>494</sup> Following this success, the United States negotiated with Indonesia, the second biggest pirating center in that region at that time. Similar arrangements were concluded with Malaysia and Thailand, and negotiations were initiated with Taiwan and China.

The main feature of all of these agreements, at the time, was that they were based largely on bilateral arrangements between the United States and each of these countries. The GSP trading rights were the “carrot” with which the United States was able to secure protection for its IP.<sup>495</sup>

---

492. Staff Editor, *Conferences: U.S. Continuing Efforts to Negotiate Bilateral Agreements to Curb Piracy*, 37 Pat. Trademark & Copyright J. (BNA) 11 (1988).

493. *Id.*

494. *Id.*

495. *Id.*

Some commentators contend that this trend of strengthening IP protection within countries of the Far East led to a measured shifting of the counterfeiting industry to countries in the Middle East.<sup>496</sup> In other words, the IP piracy industries in both regions appear to be connected. Another view holds that IP piracy is but a natural stage of a region's development towards industrialization.

*B. The Scope, Type, and Trends of Intellectual Property "Piracy" in the Middle East*

Until the early 1990s, most countries in the Middle East did not have copyright laws and copyright "piracy" flourished unabated in the region. For example, Abu Dhabi (of the UAE) was considered to be the "new home" of the Indonesian IP pirates. In 1988, Abu Dhabi's pirating industry was estimated to be worth around an annual U.S.\$750 million.<sup>497</sup> In the 1980s, the United States initiated talks with major countries of the Middle East region including Egypt, Saudi Arabia, and Turkey.<sup>498</sup>

Initially, in the early 1990s, U.S. officials classified Jordan as a piracy haven. Piracy activity in Jordan was found, according to U.S. officials, to "inhibit foreign investment in technology transfers and joint ventures."<sup>499</sup> Indeed, in 1995 the Jordanian Copyright Protection Committee estimated that ninety-five percent of all corporate software sold in Jordan were in-fact illegal copies.<sup>500</sup> Needless to say, this finding posed a real question as to the effectiveness of the Jordanian copyright law that had been enacted only two years earlier (in 1993).

With respect to intellectual property protection, Saudi Arabia has accumulated a "negative record." As early as the late 1980s, Saudi Arabia had made its "mark" as one of the leading violators of U.S. IP rights. In fact, according to a report by the International Intellectual Property Alliance (IIPA), Saudi Arabia (together with China) stands out as the "most egregious violator of U.S. copyright. . . ."<sup>501</sup>

It is also worth noting that Egypt was among the other ten countries cited by that report. The report maintained that the twelve countries noted within are "problem" countries engaged in piracy of U.S. books, software, motion pictures, videos, and recordings.<sup>502</sup> The report concluded that the sum of such violations

---

496. *Id.*

497. *Id.*

498. *Id.*

499. Part of a statement by Undersecretary of Commerce Mr. Ron Brown while on a visit to Jordan in February of 1994. For more information, see Sofer, *infra* note 504, at 26.

500. *Id.* This finding was surprising because it came two years after the enactment of the 1993 Jordanian Copyright Law.

501. *Foreign Trade: Two Worst Copyright Pirates Are China and Saudi Arabia, Report Says*, 37 Pat. Trademark & Copyright J. (BNA) 673 (quoting the IIPA report of April 29, 1989).

502. *Id.* at 673 (noting that the other nine countries cited by the IIPA report were South Korea, India, the Philippines, Taiwan, Brazil, Indonesia, Thailand, Nigeria, and Malaysia).

cost U.S. firms approximately U.S.\$103 billion in lost sales.<sup>503</sup> The report also detailed the breakdown of these losses among the twelve countries. Saudi Arabia was “accredited” with U.S.\$189 million of these losses.<sup>504</sup>

The report also detailed the nature of the infringements in each country. With respect to Saudi Arabia, the activity of “Super 747” stores was cited. The report alleged that this Saudi chain-store was selling pirated reprints of music recordings ranging from folk to Michael Jackson.<sup>505</sup> In addition, there is reportedly a widespread availability of counterfeit consumer products and automobile spare parts in Saudi Arabia.<sup>506</sup>

A March 2001 report by the U.S. Department of State submitted that the most “pervasive problem” in Saudi IP protection is the “proliferation of pirated manufacturers and importers of unauthorized copies of brand name products.” The report estimates that illegal copies of all major brand consumer goods constitute from twenty-five percent to upward of fifty-percent of the Saudi market.<sup>507</sup>

The Egyptian film and entertainment companies continue to assert that their annual losses (due to video piracy) are in excess of \$14.5 million. The industry attributes this bleak situation to lack of sustained counter-piracy activities by the police (*i.e.*, inadequate copyright protection).<sup>508</sup>

Copyright piracy has also had its bearing on trademark infringements in Egypt. Many pirated video tapes, cassettes, and CDs carry forged trademarks and/or are placed in packaging confusingly similar to the original trademarks or which getup is confusingly similar (thus constituting passing off). Therefore, the concerns noted above regarding copyright come into clear interplay with trademark protection.

Patents relating to pharmaceutical products were also pirated on a wide scale. A survey of seventeen multinational research-based companies conducted over a three-year period (1996-98) revealed that Jordanian companies had applied and

---

503. *Id.*

504. The IIPA report stated that China alone was responsible for approximately one third of these U.S. losses (U.S.\$411 million). South Korea and India more responsibly for U.S.\$135 million and U.S.\$127 million, respectively. The remaining \$100 million is distributed among the remaining eight countries listed by the report.

505. With respect to China, the report cited Chinese-based businesses that were allegedly engaged in the reprint of unauthorized textbooks worth around U.S.\$100 million annually. Interestingly, the report had cited barriers to U.S. copyright materials such as in South Korea. According to the report, the Korean motion picture industry was actively engaged in keeping U.S. motion pictures out. Various methods were allegedly employed to the end, including “vandalizing movie houses and planting live snakes in theaters showing American films.” For more information, see *Two Worst Copyright Pirates*, *supra* note 501, at 673.

506. See *Trade Regulations and Standard*, at <http://www.tradeport.org/ts/countries/saudiarabia/regs.html>, (last visited July 29, 2002).

507. *The Bureau of Economic Affairs, 2000 Country Reports on Economic Policy and Trade Practices*, U.S. DEP'T OF STATE, at 6 (Mar. 2001). This estimate regarding the volume of illegal copies remained unaltered in the ensuing 2001 report.

508. See *January 2002 Newsletter*, at [www.saba.com](http://www.saba.com) (copy on file with author) (noting that report said losses to the Egyptian film industry stand at around \$15 million).



registered seventy internationally protected pharmaceutical products.<sup>509</sup> This survey stated that

*“[m]ore than 50% of these pirated products are of American origin. Reportedly, the damage these companies inflict on leading American products is enormous and estimated to be in the range of U.S.\$25,000,000 to U.S.\$50,000,000 per year, especially in export markets in the Middle East and North Africa region.”*<sup>510</sup>

However, these trends appear to have subsided in the Middle East. The four ACMEs subject to this research have embarked not only on formulating modern IP legislation, but also on promoting IP protection and enforcement through the judiciary and executive branches. The “piracy” of CDs in the Middle East has reportedly been on a downward slope since the beginning of the early 1990s.<sup>511</sup> In March 1991, the Industrial Federation of the Phonographic Industry (IFPI) reported that piracy (in CDs) had fallen in the Middle East to only U.S.\$58.3 million.<sup>512</sup>

The following is an examination of the commitment of ACME to the enforcement of laws protecting IPRs. However, in order to remain within the bounds of this research the examination (and discussion) will focus on trademarks, service marks, and other types of marks while reviewing various judicial decisions rendered by tribunals in the respective countries. This will also function as a beacon regarding the courts’ commitment to the protection of trademarks. I will also further examine various manifestations of the enforcement, awareness, and promotion of trademarks in these countries.

In summary, the examination of trademark enforcement will be divided into three sections: the judicial, the administrative, and the academic-promotional. Within these three respective groups, I have chosen to address the situation in each one of the four countries separately addressed. This will simplify the examination process and contribute to the success of the assessments and comparisons that will be conducted at the end of this part.

---

509. See Consumer Project on Technology, at <http://www.cptech.org/ip/health/phram/nte-98/jordan.html> (last visited July 4, 2002) (copy on file with author).

510. *Id.*

511. *IFPI, Issues Report on Worldwide Piracy*, Pat. Trademark & Copyright L. Daily (BNA), at 5. (June 6, 1991)

512. *Id.* at 5-6. The IFPI further, reportedly, stated that the Middle East is not the only region where CD “piracy” had been curbed. In this context, the IFPI specifically noted Singapore, where pirates controlled 85% of the CDs. At that peak (1984), “pirates” were earning approximately \$17 million, and in contrast, the “legal” (licensed) industry was making only \$6 million. The new copyright law in Singapore reversed this pattern within three years. The “pirates” earnings slumped to only \$0.6 million and the licensed industry grew to \$36 million! For more discussion on this topic, see Article Six.

C. *Judicial Enforcement of Trademark Protection*

1. *The Hashemite Kingdom of Jordan*

Due to the lack of explicit provisions (before the amendment of Jordanian trademark law) preventing the registration of well-known marks, many local Jordanian companies filed applications to register well-known marks in their own name. Such applications were accepted and registered except in cases where a third-party filed an opposition in time and succeeded in the ensuing proceedings.<sup>513</sup> Thus, many foreign owners of well-known marks found themselves unable to register their marks in Jordan due to earlier registration of the same marks by Jordanian persons. Consequently, a large part of these trademark owners were forced to enter into distributorship agreements with those registrants in Jordan.<sup>514</sup> One example (in the early 1990s) involved the PILLSBURY mark. Shaheen International Corporation Co. had originally filed an application to register the mark PILLSBURY (in its name) in Jordan. The Pillsbury Company filed an opposition contesting such registration and contending that its PILLSBURY mark is a well-known mark used to market its readymade dough and bakery products worldwide, including in Jordan. The Pillsbury Company further argued that Shaheen's purpose was to mislead consumers in the Jordanian market. Consequently, a settlement was reached whereby Shaheen agreed to assign the trademark registration over to the Pillsbury Company in return for the latter's agreement not to initiate legal action for damages or compensation.<sup>515</sup>

In another case, Hani Al-Qudsi & Partners, a Jordanian Company, filed a trademark application to register the mark "7ELEVEN" in class 16. The Southland Corporation, a U.S. corporation, filed an opposition claiming that the Jordanian applicant was not entitled to such registration. Southland further contended that it uses and owns registrations of the mark "7ELEVEN" in various countries worldwide.<sup>516</sup> The Southland Corporation prevailed in its opposition. However, this case appears to have been decided in favor of Southland not so much on the merits but rather on points of procedure. The Jordanian Company had not submitted its response to the opposition on time.<sup>517</sup>

---

513. See Amman, *Arab Region: Roundup of IP Developments in Arab Region*, Pat., Trademark & Copyright L. Daily (BNA) (N. Afr.) (Feb. 4, 1994).

514. *Id.*

515. *Id.*

516. INTERNATIONAL TRADEMARK ASSOCIATION, TRADEMARK LAW HANDBOOK 1999, ANNUAL REVIEW OF DEVELOPMENTS IN TRADEMARK LAW PRACTICE 172 (Lanning G. Bryer & Reese Taylor eds., vol. 2 1999) (reporting on the case involving trademark application number 40918 7Eleven in class 16). The Trademark Registrar's Decision No. TM/40918/1410. The Southland Corporation (a U.S. Corporation) v. Hani Al-Qudsi & Partners (a Jordanian Company), rendered on April 27, 1997 (unpublished), and the Trademark Registrar's Decision No. 40918/1410 of June 11, 1997 (unpublished). In addition, see the High Court of Justice Resolution No. 12 case No. 215/97, rendered on June 13, 1998 and published in the Lawyer's Association Journal, at 854-56.

517. *Id.* Reportedly, the Trademark Registrar had accepted the opposition on the basis that the Jordanian

Another notable case involved an opposition filed by Miller Brewing Company, owner of the famous mark MILLER, against the registration of the mark in Jordan by Farid Khalaf Company (owner of Khalaf stores), a Jordanian company. The applicant had filed to register that mark in Jordan in class 32 (for beers). Miller contended that it is the owner of the famous MILLER trademark (for beers in class 32) that is registered and used in several countries worldwide. Miller further contended that the fact that its MILLER mark is not registered in Jordan should not adversely affect the opposition.

The Jordanian trademark registrar ruled in favor of Miller Brewing Company and rejected Khalaf's application. The Registrar reasoned that Khalaf's registration would cause consumer deception and constitute unfair competition and false indication of origin of the goods bearing the mark.<sup>518</sup> Consequently, Khalaf appealed the ruling. However, the Jordanian High Court of Justice affirmed the registrar's decision.<sup>519</sup>

Doctor's Association Inc., an American company, initiated a cancellation action against a Jordanian trademark registration in SUBWAY (in class 30).<sup>520</sup> The request for cancellation of registration was based on the fact that the registration of Al-Nasser & Mosely Company (a Jordanian company) is not the rightful owner of the mark. Doctor's Association Inc. contended that it owned registrations of the mark covering various goods and services in various countries but not Jordan. The trademark registrar accepted Doctor's Association Inc.'s claims and held that it had sufficiently established its long-time ownership of the mark. Hence, the registrar determined that registration in the name of Al-Nasser & Mosely Company would cause confusion and constitute unfair competition.<sup>521</sup>

The Walt Disney Company case is another example of protection being extended to well-known marks. In this case, the trademark registrar cancelled the registration of ten trademarks registered in the name of the Jordanian Halawani Industrial Company for potato chips in international classes 29 and 30. The registrar held that those marks, which included the characters of WINNIE THE

---

respondent did not submit the counter statement in due time. Following this decision, the respondent approached the Registrar explaining that its delayed response was a result of a delayed receipt of the opposition statement. Upon this, the Registrar cancelled his initial decision and allowed the respondent to submit his said response. The Southland Corporation appealed this latter decision. The Jordanian High Court of Justice accepted the appeal, reasoning that the Registrar was not authorized to change his initial ruling and that only an appeals court was entitled to review and reverse that decision. Therefore, the High Court concluded that the respondent should have appealed the Registrar's initial decision instead of asking the Registrar to cancel said decision.

518. *Id.* at 156 (reporting on the Trademark Registrar's Decision No. TM/35571/1142, Miller Brewing Company (an American Company) v. Fareed Khalaf Company-Khalaf Stores (a Jordanian Company), rendered on April 6, 1997 (unpublished)).

519. *Id.* (reporting on the Jordanian High Court of Justice Resolution No. 26, Case No. 120/97 (unpublished)).

520. Registration No. 29918.

521. Bryer & Taylor, *supra* note 516, at 171-72 (reporting on the Trademark Registrar's Decision No. TM/29917, Doctor's Association, Inc. (an American company) v. Al-Nasser & Mosely Company (a Jordanian company), rendered on July 28, 1997 (unpublished)).

POOH, DUMBO, ALADDIN and LION KING, were well-known marks owned, registered, and used worldwide by the Walt Disney Company. The registrar based his decision on Article 8(12) of the amended trademark law of Jordan, which prohibits the registration of a mark that is

*“[i]dential or similar to, or constitutes a translation of, a well-known mark for use on similar or identical goods to those for which that one is well-known and whose use would cause confusion with the well-known mark, or for use on different goods in such a way as to prejudice the interest of the owner of the well-known mark and lead to believing that there is a connection between its owner and those goods. . . .”*<sup>522</sup>

As expected, the owner of the cancelled registration appealed the registrar’s decision. However, the Jordanian Supreme Court (on February 21, 2001) upheld the decision, and the registrations were ultimately cancelled.<sup>523</sup>

As shown above, these cases materialize in favor of foreign entities claiming rights over certain marks they own and use outside Jordan. However, this is not always the case and suffice it to note two cases in this regard. First, a result inapposite to that of the above-referenced MILLER case was reached by the trademark registrar in opposition proceedings initiated by La Chemise Lacoste (a French Company) against the registration (in Jordan) of the trademark AL TIMSAH (& Crocodile device) in class 32.<sup>524</sup> A Jordanian company, Jordanian Trico & Yarn Factory Co., filed this Jordanian trademark application for a crocodile device like that filed by Lacoste. In its opposition, Lacoste contended that the opposed mark would cause confusion with its well-known mark LACOSTE (& Crocodile device) that is registered in classes 3, 9, 14, 18, 25, and 28.<sup>525</sup> The registrar rejected Lacoste’s opposition on the ground that the goods covered by respondent’s mark were in different classes than the goods covered by Lacoste’s opposer’s mark. Hence, the registrar found no likelihood of confusion.<sup>526</sup> Lacoste appealed this decision before the Jordanian High Court of Justice, however, to no avail.<sup>527</sup> This decision was rendered in 1998 before the amendment of Jordanian trademark law, which was discussed in the previous sections. Therefore, in view of the well-known mark doctrine (found in the new trademark law) and in view of the new unfair competition law, it is doubtful if the same result would be reached today. Additionally, it is rather odd that the registrar did not accept the opposition

---

522. Jordanian Trademark Law No. 34, Official Gazette of Jordan No. 4389.

523. See *February News Bulletin*, *supra* note 17.

524. See Bryer & Taylor, *supra* note 516, at 126 (discussing this case involving Jordan TM number 34310).

525. See *id.* Jordanian Registration Numbers 20769, 20863, 20765, and 20768.

526. See Bryer & Taylor, *supra* note 516, (reporting Jordanian Trademark Registrar’s Decision No. 34310/77, La Chemise Lacoste (a French Company) v. Jordan Trico Yarn Factory Co. (a Jordanian Company), rendered on January 6, 1998 (unpublished)).

527. See *id.* (reporting Jordanian High Court of Justice Resolution No. 28, July 19, 1998 and Case No. 23/98 (unpublished)).

based on the fact that it is persuasive that the phrase “AL TIMSAH” means “the Crocodile” (in Arabic), thus adding even more weight to the possible effect of confusion between the mark AL TIMSAH and the well-known mark LACOSTE, which also means Crocodile in French. In addition, the registrar overlooked the fact that the crocodile device (appearing in both marks) is a visually dominant component of the marks, thereby increasing the likelihood of confusion between these marks.

In another case, Time Warner Entertainment Company filed a notice of opposition against the registration of the trademark TOTO (in Jordan & depiction of the famous cartoon character “Tweety”).<sup>528</sup> The Jordanian application was filed by the Jordanian Sobhi Jabri & Sons Co. and was intended to cover goods in class 30 (foods). In its opposition, Time Warner contended that it owns the rights over its famous “Tweety” character, and as such, its opposition should be accepted.<sup>529</sup> However, the Registrar rejected the opposition ruling because no convincing evidence was submitted to prove that Time Warner was using the “Tweety” character with respect to goods in class 30. In addition, the Registrar reasoned that this cartoon character is only protected by copyright law and not trademark law.<sup>530</sup>

For the sake of clarity, we will note that although a large number of cases involve foreign entities, some other cases involve only Jordanian parties. One such decision rendered by the Jordanian High Court of Justice confirmed (on June 28, 2000) the trademark registrar’s decision to cancel the registration of the trademark ATHINA in the name of Al Aqsa Laboratories (covering cosmetics in class 3). The Jordanian company Nader Atmeh & Partners Co. was the owner of the trademark ANITA (for cosmetics in classes 3 and 5). This cancellation had been requested by the Jordanian Company, arguing that the mark ATHINA was confusingly similar to its mark ANITA.

## 2. *The Arab Republic of Egypt*

Two cases decided by Egyptian courts in March and May of 2001 (respectively) are representative of the level of commitment of the judicial system of Egypt with respect to the protection of well-known marks. The two cases involved oppositions filed by Gianni Versace, the owner of the well-known mark VERSACE that is also registered in Egypt. The two oppositions were filed against the registration of the mark FERSATSHI (for ready-made clothes). The

---

528. *See id.* at 338 (addressing the case of Jordanian Trademark Registration No. 29626–TOTO and depiction of the famous cartoon character “Tweety”).

529. *See id.*

530. *See id.* at 338 (referring to Trademark Registrar Decision No. TM/29626/78, Turner Warner Entertainment Company (an American corporation) v. Sobhi Jabri & Sons Co., decision rendered on January 6, 1998 (unpublished)).

other opposed mark was for the word mark FERSATCHI in English and Arabic with face design in penal.

The Egyptian High Court<sup>531</sup> affirmed the trademark registrar's decision to accept the two oppositions. The court reasoned that opposed marks might cause confusion with the VERSACE mark, which is a well-known mark worldwide and is also registered in Egypt. The VERSACE ruling barred both FERSATCHI marks from registration due to their likelihood of confusion with VERSACE marks.

However, in order to complete the picture, it should be noted that that not all cases (in Egypt) involving claims of likelihood of confusion have produced similar result. In fact, some cases have produced the opposite results. One such case involved an opposition filed against the registration of the mark TEA - DISCOVER THE GOODNESS (with cup design). The Egyptian trademark registrar accepted the opposition based on a likelihood of confusion between the opposer's mark and the opposed mark. The owner of the opposed mark - The Food and Agricultural Organization of the UN Bureau (Regional Europe)-was successful in its appeal before the appeals committee, which reversed the registrar's decision and allowed the registration of this mark, citing sufficient differences (both phonetically and visually) between the opposer's mark and the opposed mark.<sup>532</sup>

### *3. The Kingdom of Saudi Arabia*

It should be noted that Trademark protection in Saudi Arabia began in the late 1980s. Jurisdictional decisions pertaining to trademark protection in the kingdom have been rendered as early as 1988 and before. In 1988, a Saudi court ordered Al-Jazirah, a Saudi based manufacturer, to desist from further sale of disinfectant detergents, bearing the BETTOL mark. The reasoning being that, this mark constituted an illegal imitation of the mark DETTOL owned and used by a UK manufacturer Rickitt & Colman that manufactured detergents under the DETTOL mark. Interestingly, however, the Saudi court did not impose any penalty or fine and did not even impose on Al-Jazirah an obligation to pay damages.<sup>533</sup>

---

531. See Egyptian High Court of Appeals, Case Nos. 2526/116, Gianni Versace S.P.A. v. Ahmed Abu Elhassan & Co., March 12, 2001; see also Egyptian High Court of Appeals, Gianni Versace S.P.A. v. Ahmed Ahmed Abu Elhassan & Co., May 23, 2001. Both cases are reported by the TRADEMARK REPORTER, *The Ninth Annual International Review of Trademark Jurisprudence*, TMR, Mar.-Apr. 2002, at 373-74.

532. See Committee of Appeals, Case No. 9682/99, the Food and Agriculture Organization of the United Nations-Bureau Regional Europe v. Egyptian Trademark Office, Committee of Appeals Decisions, January 1, 2001, reported by the Trademark, supra note 531, at 374. The mark owned by the opposer is not clear from the report. Therefore, I am unable to assess the decision on its merits.

533. See S. Shaaban, *Commercial Transactions in the Middle East: What Law Governs?*, 13 L. & POL'Y INT'L BUS. 157, 170 (1999).

#### 4. *The Arab Republic of Syria*

Syrian courts have also been defending trademarks. In an unreported case, the Henkel KGaA owner of a 1971 Syrian “CRÈME 21” trademark registration in Syria—CREME 21 (covering cosmetic products,) sued Syrian citizens whom were engaged in the sale of cosmetic products bearing a forgery of Hankel’s mark.<sup>534</sup>

The Syrian court accepted Henkel’s lawsuit contending that the defendants committed a crime of imitating another’s registered mark. Due to this deceptive use, the court ordered the culprits to pay the sum of five hundred thousand Syrian pounds as compensation for damages suffered by the plaintiff. A public rights case (criminal) was also initiated against the culprits. However, these criminal proceedings were subsequently dropped due to their inclusion in the Syrian Amnesty Law no.18, of 1995<sup>535</sup>.

Another case involving Henkel KGaA dealt with an infringement of Henkel’s mark DIXAN (and oval design) for detergents. A Syrian individual had sold detergents under a mark similar to the oval design found in Henkel’s mark. The Syrian criminal court found defendant guilty of imitating Henkel’s trademark. Defendant’s actions were deemed to constitute a criminal offence. However, as in the case discussed above, the offender was pardoned in accordance with Amnesty Law no. 18 of 1995. Notwithstanding, Henkel, however, they were entitled to bring civil action against the culprits and to request compensation for its losses.<sup>536</sup>

One commentary outlines the judicial problems affecting trademark protection in Syria as follows:<sup>537</sup>

*“In 1995, a large U.S. firm detected a violation of one of its trademarks in Syria. Having registered its trademark previously, the U.S. firm filed suit in Syrian court against the responsible firm; the Damascus Chamber of Commerce successfully mediated a satisfactory settlement. Had the case gone to court, it likely would have received a fair hearing, but any financial award would have been in Syrian pounds, an unconvertible currency. Requests for payment in foreign exchange would probably be delayed indefinitely.”*

Syria’s lack of membership in the WTO does not represent a lack of interest in IP within Syria. On the contrary, Syrian courts appear to be keen and capable of protecting trademarks. In fact, as noted earlier in this Article, some contend

---

534. See Bryer & Taylor, *supra* note 516, at 323.

535. See *id.*

536. *Seventh Annual International Review of Trademark Jurisprudence*, TRADEMARK REP., (Mar.-Apr. 2000, at 417-18.

537. See *Small Business*, at <http://home3.americanexpress.com/smallbusiness/resources/expandin.../11166020.shtml> (last visited Aug.15, 2002) (copy on file with author).

that this lack of membership is not due to failure in IP protection (or other WTO commitments), but rather to hurdles put in place by the United States and Israel.

*D. Administrative Enforcement of Trademark Protection*

Administrative protection of trademarks may be divided into two main sectors, the “internal” and the “external.” The internal protection includes all the administrative entities engaged in finding or seizing counterfeit goods.<sup>538</sup> These entities include the police and specific taskforces empowered to carry out such actions such as searches and seizures. As will be shown below, some of these entities operate under the direct authority of, among others, the specific ministries, namely trade, commerce, industry, interior, etcetera. The external protections refer to countries preventing the free movement of counterfeit goods, both in and out of the country.

The customs authority is entrusted with the task of seizing any incoming goods that infringe trademarks. In some cases, customs may also be able to seize outgoing infringing goods. Indeed, various international IP agreements emphasize that customs authorities may play an important role in order to better enforce IP rights worldwide. Requirements to this effect are also set out in TRIPS.

*1. The Hashemite Kingdom of Jordan*

The beginning of 2001 brought a surge of activity on the anti-piracy front in Jordan. A raid carried out by the Jordanian police in March of 2001 resulted in the seizure of unlicensed Microsoft software as well as “pirated” CD’s.<sup>539</sup> The subject of this raid was a targeted computer re-seller located in Amman, who had loaded computers with unlicensed Microsoft Software, including Windows98 and Office97. In addition, the retailer reportedly burned CDs containing unlicensed software.<sup>540</sup> In July 2000, a raid was conducted in Jordan against traders selling chisels and screwdrivers bearing the famous STANLEY mark (owned by the U.S. firm of Stanley Works). These raids yielded a substantial quantity of counterfeit products, and his “bounty” was confiscated and later destroyed.<sup>541</sup>

With respect to external enforcement, the Jordanian Customs Department has also enhanced the external enforcement of IPRs by setting up the Procedures

---

538. For more on anti-counterfeiting activity in the Middle East, see Stuart Adams, *Tackling Counterfeiters in the Middle East*, 29 TRADEMARK WORLD (Aug. 2000)

539. See *March 2001 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/5\\_01.htm](http://www.agip.com/agipnews/bulletin/5_01.htm) (last visited Apr. 9, 2003) (copy on file with *The Transnational Lawyer*).

540. See *id.*

541. See NJQ & Associates, “STANLEY”-Police Raid on Counterfeit Products in Jordan, [http://qumsieh.com/news/circular\\_august2000.htm](http://qumsieh.com/news/circular_august2000.htm) (last visited Aug. 18, 2002) (copy on file with author). The report also contains photographs taken during and after destroying the counterfeit products.



Tariffs Division.<sup>542</sup> In April 2001, the Jordanian customs authority required trademark owners to provide it with copies of their respective trademarks and basic owner information to assist customs in identifying counterfeit products before they enter the country. The Jordanian Customs Law was also amended to meet “external” challenges pertaining to IP infringement.<sup>543</sup> The amendment provides the judiciary with powers to impose *ad hoc* measures to prohibit the clearance of imported counterfeit goods.<sup>544</sup> Under this law, the owner of an IPR petitions the court to order customs authorities to seize certain shipments suspected of containing infringing goods.<sup>545</sup> Jordanian customs has seized approximately ten thousand counterfeit compact disks. The procedures in such seizures require notification of the owner of the infringed trademark or copyright notification, and the infringed party must petition the court for the destruction of the counterfeit goods destroyed or re-exported.<sup>546</sup>

Various sources indicate that the Jordanian customs and the Directorate of Industrial Property at the Ministry of Industry and Trade have substantially contributed to the protection and enforcement of IPRs as well as the enforcement of legal rights thereof.<sup>547</sup> As a result of this diligence, IP violation-related court cases have surged.<sup>548</sup>

## 2. *The Arab Republic of Egypt*

In Egypt, not only trademark protection has come under criticism. Reports indicate that, notwithstanding the new Egyptian copyright law, video piracy in Egypt is on the rise. According to some observers, this is owed to defects in the law and procedural hurdles. Most notably, these observers point to the insufficient fines and prison sentences imposed on infringement.<sup>549</sup> In addition, much is blamed on legal proceeding where verdicts are issued no earlier than six months after initiating such proceedings.<sup>550</sup> Similarly, judicial interlocutory actions seeking search and seizure orders are perceived to be slow and cumbersome.<sup>551</sup>

---

542. For a detailed report on the Jordanian Customs Department, see NJQ & Associates, *Jordan—The Role of Customs Department in Intellectual Property Protection*, News Letter Circular December 2001, at <http://www.qumsieh.com/news/circular-december2001.htm> (last visited Aug. 18, 2002) (copy on file with author).

543. See *April News Bulletin*, *supra* note 389 (referring to Amendment Number 20 of the Jordanian Customs Law of 1998).

544. See *id.*

545. In such cases, the petitioner is required to substantiate his right over the IP. The courts are required, by law, to lend an expedited decision within three days of filing the petition. These decisions are subject to appeal. For a detailed look Jordanian customs proceedings, see *April News Bulletin*, *supra* note 291.

546. See *id.*

547. See Saba, *supra* note 238 (reporting on Jordanian Statements by an Official of the National Center for Intellectual Property Rights).

548. See *id.* (noting that the number of these cases is estimated at about 600).

549. See *id.*

550. See *id.* (noting that passing a verdict takes from six months to a year).

551. See *id.* This is an exceedingly long time when a rapid raid operation is required.

These results are rather surprising because Egypt had introduced amendments to its copyright law. Since that time, the Egyptian anti-piracy police have carried out raids aimed at piracy.<sup>552</sup> The amendments caused a substantial increase in penalties and raids by the anti-piracy police units in conjunction with the Censorship Department. There is substantial ground for a conflict between trademarks and domain names in Egypt. The reason for this rests largely on the fact that the Egyptian ISP registers domain names on a “first come, first register” basis.<sup>553</sup> Furthermore, there is no pre-screening process of the requested domain name against registered trademarks or company names.<sup>554</sup> In view of this potential for conflict between trademarks and domain names, Egyptian law has developed procedures to mitigate such conflicts. For example, any party contesting the registration of a domain name may initiate legal proceedings. The Egyptian court may sustain legal proceedings where proof of ownership of the disputed domain name is provided. This may be done by presenting a trademark registration or showing the existence of a company name in Egypt that is owned by the owner of the domain name or its agent.<sup>555</sup>

### 3. *The Kingdom of Saudi Arabia*

Some notable examples of the Saudi’s resolve to enforce trademark (as well as other IPRs) protection is demonstrated by the following cases:

- a. In 1999, commercial quantities of watches and wallets bearing the well-known mark CARTIER were introduced into the Saudi market.<sup>556</sup> In response, Cartier S.A. sued a well-known Saudi chain store that developed counterfeit products. The Saudi court ordered this store to halt all unauthorized use of Cartier’s marks and refrain from the sale of counterfeit products. In addition, the local chain store was ordered to pay compensation to Cartier S.A. as prescribed by Saudi law.<sup>557</sup>

---

552. See *February 2002 News Bulletin*, *supra* note 472. The raids are typically executed in conjunction with the Egyptian Censorship Department.

553. The documentation required for registering a domain name is detailed in *Summary of Egyptian Trademark Registration*, *supra* note 312.

554. See *id.* at 3. The Regional Information Technology and Electronics Center (RITEC) has since 1999 allowed for the registration of domain names in Egypt.

555. See *id.* Where an entity is dissolved, a domain owned by it will be reallocated. It is worth noting that unlike trademarks, domain names are not transferable as such. They are, however, transferable if its owning entity is sold or merges with another (surviving) entity. In addition, domain names require annual renewals without which loss of right over it will occur.

556. See Bryer & Taylor, *supra* note 516, at 280-81 (noting that this was an unreported case).

557. See *id.* at 281. Article 54 of Saudi Trademark Law states that: “[w]hoever sustained damage under the commission of the contravention provided for in the Rules shall have the right to demand that the perpetrator should compensate him appropriately for the damage.”

- b. At the end of 2001, a joint raid on a tailor shop in Jeddah conducted by the Saudi police and passports department led to the arrest of twelve people (four of whom had no valid domicile documentation). The twelve detainees manufactured clothing items bearing trademarks of famous brands.<sup>558</sup> Trademark infringements pertaining to clothing items are, to say the least, not unique. In fact, the sale of counterfeit Levi-Strauss brands in Saudi Arabia and the UAE is well known.<sup>559</sup>
- c. Around the same period, the Saudi ministry of commerce carried out counter-piracy operations in various cities around the Kingdom, including the capital (Riyadh), Jeddah, and Dammam. Reportedly, these raids led to the seizure of approximately \$150,000 of unlicensed software and hardware.<sup>560</sup>
- d. In the early part of 2002, the Saudi authorities conducted a raid in Al-Bath, a district located in the capital, Riyadh. The joint raid conducted by the police and the copyright department (at the Ministry of Industry) led to the seizure and confiscation of several thousand illegal video tapes and copies of electronic games.<sup>561</sup>

All of these operations were carried-out within a three-year period and this is a further indication of the expansion of anti-piracy activity in the Kingdom. Just several years ago, enforcement would have taken a much longer time, but pressure from the United States and the WTO have motivated the Saudis to take a tougher approach. Saudi Arabia's attempt to further strengthen trademark enforcement in the Kingdom is an on-going process. The Saudi legal advisory council (*Shorah*) has discussed draft regulations pertaining to trademark protection. The draft centered on Article 9 of the Saudi Trademark Law dealing with retribution and penalties that may be imposed against imitators or counterfeiters of registered trademarks.<sup>562</sup> These meetings are seen by some as the unwavering efforts of the Saudi government toward enforcement and restructuring the Saudi IP system.

In order to evade possible conflicts between trademarks and domain names, the Saudi Network Information Center (SaudiNIC)<sup>563</sup> requires that applicants for a domain name registration show ownership of the name by providing a Saudi

---

558. See Saba, *supra* note 240, at 3.

559. See *January 2002 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/1\\_02.htm](http://www.agip.com/agipnews/bulletin/1_02.htm) (last visited Apr. 7, 2003) (copy on file with *The Transnational Lawyer*).

560. See *id.*; see also *December News Bulletin*, *supra* note 99.

561. See *February 2002 News Bulletin*, *supra* note 472. In addition to this crackdown against infringements of trademarks and other IPRs, the Saudi's have also been trying to combat the use of substandard cosmetics (and their components) as well as the sale of expired foods. These industries appear to be akin with the counterfeiting industries.

562. The *Shourah* meeting took place in November 2001.

563. SaudiNIC started accepting domain name registrations in 1999.

trademark registration or commercial registration.<sup>564</sup> This appears to be a form of pre-emptive enforcement intended to prevent domain name disputes. Interestingly, however, SaudiNIC is under no legal obligation to screen domain name registrations because they are granted on a first-come, first-register basis. What is more, SaudiNIC does not handle any disputes between parties over the right to use a particular domain name. The courts adjudicate such conflicts.<sup>565</sup>

In conclusion, it appears that trademark and copyright protection are “alive” in Saudi Arabia and other Gulf states<sup>566</sup> and that the Saudis have undertaken notable efforts to curb copyright piracy and trademark counterfeiting.<sup>567</sup> The remaining crucial question is whether more resources are being devoted to anti-piracy or piracy efforts. Future IP piracy rates within Saudi Arabia will provide the answer to this important question.

#### *4. The Arab Republic of Syria*

Administrative responsibility for IP protection and enforcement is delegated to the Office of Property Protection in the Syrian Ministry of Supply and Internal Trade. The Syrian administrative bodies are known to carry out raids on computer software pirates. However, enforcement is sporadic and requires companies themselves to monitor the market for possible infringers.

In addition, the Syrian government created a special directorate to prevent unauthorized use of trademarks and the Directorate of Intellectual Property Protection (DIPP) to aid in enforcement of IPRs. The DIPP issued regulations banning the use of foreign names for local trademark registration. In cases of unauthorized use of trademarks, a claim should be submitted to DIPP. Similarly, a lawsuit and request for an injunction should be submitted to a competent court. Interestingly, it is quite difficult to obtain monetary compensation in such cases because of the lack of means in enforcement. Therefore, most cases are settled out of court.

---

564. See *Summary of Trademark Registration-Saudi Arabia*, *supra* note 217.

565. Effectively, SaudiNIC exempts itself from verifying such potential conflicts or acting as an arbitrator between the parties.

566. The United Arab Emirates has been notably active in combating counterfeit products sold under well-known marks. In April 2001, a substantial search and seizure operation was simultaneously conducted at three Emirates of the UAE (Dubai, Sharjah, and Abu Dhabi). The operation yielded a very large quantity of counterfeit clothing items bearing the famous mark CK CALVIN KLEIN. For a report on this operation (including pictures of some of the seized products), see NJQ & Associates, at [http://www.qumseh.com/news/circular\\_april2001.htm](http://www.qumseh.com/news/circular_april2001.htm) (last visited Aug. 15, 2002) (copy on file with author). In addition, the UAE is considering developing a new trademark online application system that is to be implemented by the trademark office in the UAE.

567. This is the view that various practitioners and commentators hold.

E. *Promoting Awareness to Trademarks and Other IPRs*

Amending the law and enforcing it is not sufficient to effectively protect IPRs. Promoting awareness to IPRs is the third and necessary side of this triangle. The following is a discussion of the viability, nature, and scope of IPR promotion in ACME.

1. *The Hashmite Kingdom of Jordan*

Jordanian academic institutions have a substantial role in promoting IP issues on two parallel fronts. First is in the form of academic teaching programs, and second is in the form of general academic meetings and seminars. With respect to formal academic teaching, the University of Jordan is on the way to introducing a Master's of Law program in IP. This joint project between the University and WIPO is intended to provide the Jordanian legal and commercial communities with "a qualified manpower that is capable of dealing with local IP issues."<sup>568</sup> This is especially true in view of the amended trademark law discussed in the previous sections.<sup>569</sup>

As for general academic programs, some recent examples that give an indication of the growing attention to the field of IP are:

- a. In April 2001, the Jordanian University in Amman in conjunction with WIPO held a conference on IP and e-commerce.<sup>570</sup> This conference placed special emphasis on the protection of domain names, the protection of information relayed through the Internet, and the resolution of disputes pertaining to the Internet. The conference reportedly found a good response from both the public and private sectors in Jordan.<sup>571</sup>
- b. Another seminar was held in Amman in May 2001. This seminar was organized by an EU Commission delegation and the EU Embassies in Jordan and was attended by members of the Jordanian government.<sup>572</sup> The seminar discussed various IP issues, including the trademark

---

568. See *June 2002 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/6\\_02.htm](http://www.agip.com/agipnews/6_02.htm) (last visited Apr. 9, 2003) (copy on file with *The Transnational Lawyer*) (reporting that the Master's Program is expected to start with 20 to 30 students) (copy on file with *The Transnational Lawyer*). The materials, mostly in English, will be provided by WIPO. The lectures will initially be mostly foreign. Some Jordanian lecturers are undergoing a special IP course in the United Kingdom.

569. See *supra* Part II.A.2.

570. This was a three-day event (April 21-23) organized by the School of Law, Jordan University. For more details, see *April 2002 Newsletter*, Saba, at <http://www.saba.com> (copy on file with author).

571. See *id.* (noting that present at the conference were participants from the Jordanian Chamber of Commerce and Industry as well as ministers from the Ministries of Trade, Industry, Justice, and Communications and representatives of banks, financial institutions, internet companies were also there).

572. See *July News Letter*, *supra* note 477 (reporting that the seminar was attended by HRH Prince Hassan Bin Talal as well as representatives of the Jordanian Ministry of Industry and Trade).

registration system, trademark infringement, and protection of well-known marks.<sup>573</sup>

- c. WIPO and the Jordanian Association of Manufacturers of Pharmaceutical and Medical Appliances and the Jordanian Ministry of Industry and Trade held a seminar at Amman in June 2001. This seminar focused on licensing and transfer of technology.<sup>574</sup>
- d. In September 2001, the Jordanian Ministry of Industry and Trade in cooperation with WIPO held a seminar in Amman on the amended Nice classification System.

In addition to their academic and promotional contributions, these seminars play a substantial role in formulating trademark policy in Jordan.<sup>575</sup> Moreover, an increasing number of distinguished and internationally recognized speakers are attending, which is indicative of progress. The Jordanian National Center for Intellectual Property Rights has also been working at the “grass roots” level in order to provide more public awareness of IPR protection. In particular, the Center has focused on high school students and industrialists as well as business people. In addition, it has also been directing its message towards professionals such as lawyers and members of the chamber of commerce<sup>576</sup> by focusing on contemporary trademark issues, including Internet domain names. April 2001 was the first meeting of the Arabic Internet Names Consortium (AINC).<sup>577</sup> The Arabic Working Group of the Multilingual Internet Names Consortium (MINC) supported this meeting. The meeting included a seminar portion on the Arabization of domain names.<sup>578</sup>

In Dubai on October 2001, registering Arabic domain names was discussed and accepted.<sup>579</sup> Such Arabization will present new possibilities for marks depicted in Arabic. However, it may also inadvertently contribute to new infringements on the Internet because until now domain names have only been written in Latin letters. Thus, this may foster new legal challenges especially with respect to trademark protection and enforcement.

---

573. *See id.* (reporting that the seminar and workshop were held on May 30 through 31 at the Radisson-SAS Amman). In addition to the above mentioned issues pertaining to trademarks, the seminar also discussed various copyright issues, including media, broadcasting, filmmaking, and fair-use as well as conditions for patentability.

574. *See id.* (noting that this two-day seminar was held on June 4 and 5 of 2001).

575. *See September News Bulletin, supra* note 98. This two-day seminar was held on September 17 and 18 of 2001. It has been speculated by AGIP that the Jordanian government’s aim from such a seminar is to pave the way toward joining the Nice classification system.

576. *See February 2002 Newsletter, Saba*, at <http://www.saba.org> (copy on file with author).

577. *See March 2001 News Bulletin, supra* note 539. AINC was initially set up during the ICANN meeting on November 13 through 16, 2000.

578. *See id.*

579. *See id.*

## 2. *The Arab Republic of Egypt*

Concern for intellectual property protection in Egypt has reached the highest levels of the Egyptian administration. This is evidenced by a meeting held between President Mubarak of Egypt and WIPO Director General, Dr. Kamel Idris.<sup>580</sup> There is no doubt that such a meeting between the leaders reflects the level of importance that Egypt awards to IP protection. The creation of the Egyptian non-governmental organization, The Center of Intellectual Property Studies, is intended to modernize the Egyptian IP system.<sup>581</sup>

## 3. *The Kingdom of Saudi Arabia*

Much like the situation in Jordan, the Saudis together with other members of the GCC are becoming increasingly active in promoting IP protection through various activities. One example is a training course attended by representatives of both the private sector and governmental authorities from Bahrain, Qatar, Saudi Arabia and the UAE, and Doha, Qatar during February 2002.<sup>582</sup> The course was organized by the Gulf Council for Industrial Consulting (GCIC) and WIPO, and was intended to foster and promote better use of patent information in the Gulf region. The member states, in turn, expressed their commitment to eradicating counterfeiting in their respective countries.<sup>583</sup> Finally, in mid-2002, the Patent Department at King Abdel Aziz City for Science and Technology, WIPO, and the International Union for the Protection of New Varieties of Plants held a workshop on IPR protection. This workshop reportedly focused on the protection of industrial designs, modern integrated circuit designs, and new plant varieties.<sup>584</sup>

## 4. *The Arab Republic of Syria*

Syria has also engaged in promoting IP protection and awareness on the national level. One example of this is a national seminar held in April 1999 at Damascus, under the theme "Inventiveness and Intellectual Property Rights as Resources for Economic Development."<sup>585</sup> The seminar was a joint project between WIPO and the Syrian Ministry of Supply and Internal Trade.

Some commentators contend that the meeting reiterates the Syrian Government's attempt to promote ingenuity and "encourage public and private

---

580. See *April 2001 News Bulletin*, *supra* note 289. The meeting was held in March 2001.

581. See *id.*

582. See *May 2002 News Bulletin*, AGIP, at [http://www.agip.com/agipnews/bulletin/5\\_01.htm](http://www.agip.com/agipnews/bulletin/5_01.htm) (last visited Apr. 23, 2003) (copy on file with *The Transnational Lawyer*) (June 2002). This three-day course (February 11-13, 2002), was held in conjunction with WIPO.

583. See *id.*

584. See *June 2002 Newsletter*, Saba, at [www.saba.org](http://www.saba.org) (copy on file with author).

585 See Saba, *supra* note 570.

institutions to invest in viable domestic inventions.”<sup>586</sup> The seminar addressed various IP issues and focused on underdeveloped economies. Among the topics of concern were:<sup>587</sup>

- a. The required infrastructure for innovative activities in underdeveloped economies.
- b. Employing IP in the field of commerce to develop the business sector.

In addition, Syria held a national exhibition of ingenuity and invention that coincided with the seminar,<sup>588</sup> and foreign companies have attempted to promote awareness of IP piracy in Arab countries. For example, Genius Computer Technology (GCT) initiated one such effort in Syria<sup>589</sup> as well as in Egypt and Lebanon. Furthermore, GCT tried to educate the market about the risks of substandard counterfeits.<sup>590</sup>

#### *F. Summary of Trademark Protection, Enforcement, and Promotion in ACME*

##### *1. The Hashemite Kingdom of Jordan*

Jordan’s commitment to the protection of IP is clearly reflected in a prize awarded to H.M King Abdullah II of Jordan in February 2001. The Business Software Alliance (BSA) awarded this prize, which recognized the King’s efforts to strengthen IP enforcement and combat software “piracy.”<sup>591</sup> The King is considered to be the driving force behind the new IP legislation in Jordan.

In Jordan there has been recent emphasis on the role of the Judiciary. It is generally accepted that an independent judiciary will be more equipped to maintain

---

586. *Id.*

587. *See id.* at 6-7. In addition to these, the seminar discussed: 1. Setting up an international framework for the protection of IP; 2. Promoting inventiveness according to IP rules and regulations; 3. Assessing the commercial and technical viability and feasibility of inventions and research; 4. Planning policies for marketing inventions and research; 5. Highlighting the role of inventors societies and associations; 6. Sponsoring services that promote invention; and 7. Supporting inventors, researchers as well as local industries.

588. This exhibition was attended by a number of Arab as well as foreign countries, including Saudi Arabia, Tunisia, Libya Lebanon, Algeria, Jordan, the Netherlands, and Iran.

589. This activity, especially in view of the growing number of Genius counterfeit products in the market and in view of the fact that Genius growth in the region, has been massive (the year 2002 witnessed a 55% increase as compared with 2001). *See Distributors Fight Fakes*, Genius, at [http://www.geniusnet.com/tw/fake/gct\\_fight.htm](http://www.geniusnet.com/tw/fake/gct_fight.htm) (June 2002) (copy on file with author).

590. *See id.*

591. *See King Abdullah Given Award for Efforts to Combat Software Piracy*, AGENCY FRANCE PRESS, at 1 (Feb. 6, 2001) [hereinafter *King Abdullah*] (reporting that King Abdullah is the second world leader to receive the award in 2001, following Irish Prime Minister Bertie Ahern who was recognized by the BSA for his efforts in Europe).



equity and preserve rights.<sup>592</sup> This is reflected in the field of intellectual property where judicial decisions provide protection to marks even beyond the letter of the law.<sup>593</sup> Indeed, according to some commentators, Jordan and the United Arab Emirates are among the “best performing countries in the Middle East for pushing ahead with legislation to enforce IPRs and clamp down on software piracy.”<sup>594</sup>

Of the four ACMEs, Jordanian Law stands out in that it sets the most expansive defenses to trademarks. In essence, Jordanian law abides fully with standards of protection as set by TRIPS.

## 2. *The Arab Republic of Egypt*

Egypt was required, in accordance with its WTO-TRIPS commitments to improve its IP laws and enforcement. However, Egypt has been lagging in advancing its IP protection. Consequently, Egypt was placed on the special 301 “Priority Watch List” in 1997. Egypt remained on the list during 1998 and 1999.<sup>595</sup> In this context, the U.S. State Department criticized the Egyptian Trademark System in the following manner:

*“The current trademark law, law No. 57 of 1939, is not enforced strenuously and the courts have only limited experience in adjudicating infringement cases. Fines amount to less than U.S.\$100 per seizure, not per infringement. Applications for judgments and enforcement must be made separately in each of the 26 governorates.”*<sup>596</sup>

A similar position was echoed by other commentators noting that IP protection in Egypt remains “patchy” due to the acute need for better IP enforcement. These commentators point to the lack of resources and institutional capacity within the Egyptian government for conducting enforcement activities.<sup>597</sup>

An INTA subcommittee voiced a similar position in a 1999 report, noting that Egyptian trademark law was lacking in the following areas:<sup>598</sup>

1. Protection for well-known marks was limited to cases involving use of such a mark on similar goods instead of extending protection for well-known marks beyond the goods or services that it is used for.

---

592. See *February Bulletin*, *supra* note 17 (noting that H.M. King Abdullah II of Jordan adopted the recommendations submitted by the Royal Board for Judiciary Development, namely calling for enhancing the status of the judiciary, thus bringing about a stronger and more efficient judicial system).

593. *E.g.*, before the 1999 amendment of Jordanian trademark law.

594. See *King Abdullah*, *supra* note 591, at 1.

595. U.S. STATE DEP'T, *Egypt: 1998 Country Report on Economic Policy and Trade Practices*, at 7 (last visited July 5, 2002) [hereinafter Egyptian Country Report].

596. See *id.*

597. See *A Guide to Business in Egypt*, at <http://pimanagemnet.org/egypt3.htm> (citing a report by the Economist Intelligence Unit) (Country Forecasts for the 1st Quarter of 1999).

598. See International Trademark Association, *supra* note 401.

2. Assignment of marks had to include the entire business.
3. The Egyptian enforcement system was found to be excessively complicated.
4. Lack of clear procedures pertaining to withholding infringing goods by the customs authorities.

As noted above, Egypt has contemplated an overhaul of its IP system and legislation including trademarks. This is expected to significantly boost trademark protection and enforcement.<sup>599</sup> Support for the new IP legislation appears to be across the board. It is not limited to the governmental sector. Rather it extends to IP professionals and the private sector.<sup>600</sup> In March 2002, a conference attended by Egyptian IP professionals hailed the new IP law declaring that the laws “provide comprehensive forms of protection equally serving the interests of industrial and developing nations.”<sup>601</sup>

Furthermore, the attendees reportedly “affirmed that developing countries could benefit from the flexibility of some provisions of the international agreements which regulate trade in conciliation and coordination with the industrialized countries.”<sup>602</sup> These IP professionals contended that the new IP law promoted competition among local pharmaceutical firms and manufacturers.<sup>603</sup> Supporters of the new law expect that the new laws will reduce piracy, thus cutting down the price of authentic software. The logic behind their contention is that until the recent laws, and in view of vast piracy, a portion of the price of authentic software was directed toward combating piracy. The argument continues that enhanced protection for IPRs will attract international software investments in the Egyptian market, thus revitalizing the national economy.<sup>604</sup> Some sources contend that Egyptian law has had notable success in the protection of computer software, noting a software piracy of fifty-six percent of software sold in the Egyptian market. However, this rate, although reflective of some success, still falls substantially short of the international rate of software piracy ranging between twenty-six and thirty-two percent. The United States Agency for International Development’s (USAID) trade summary of Egypt plainly reported that “infringement of trademarks and industrial design piracy remain a problem, as does enforcement and prosecution of infringement violations.”<sup>605</sup> Nevertheless, the report was somewhat optimistic in that it stated

---

599. See Egyptian Country Report, *supra* note 595.

600. See Saba, *supra* note 238.

601. See *id.*

602. *Id.*

603. See *id.* They also contended that such competition would allow consumers to choose from a wide variety of merchandise and from a competitive list of prices.

604. See *id.* In a related matter, computer retailers in Egypt called for a reduction of tariffs and customs imposed by developing countries in order to reduce the market price of original computer software, thus reducing the incentive and profitability of piracy.

605. *Report on Egypt, Foreign Trade Barriers*, USAID, at 98.

“the new draft of intellectual property rights law should offer improved protection for trademarks and industrial designs.”<sup>606</sup> Like the other ACMEs, there has been a substantial shift towards not only modernizing legislation and boosting enforcement, but also towards promoting IPRs and furthering IPR study. This has filtered into the legislature’s growing awareness and recognition of this issue. One of these meetings (November 2001) took place at the WIPO headquarters in Geneva. Reportedly, this discussion was headed by the WIPO Director General who echoed the WIPO’s 2001 position that Egypt is in dire need of a robust IP system.<sup>607</sup>

These new amendments of various fields of IP clearly indicate that Egypt’s new IP laws are aimed at fulfilling its TRIPS obligations by introducing laws embodying standards set by TRIPS.

As shown above, amending IP laws in accordance with the provisions of TRIPS sought to strengthen Egypt’s standing within the WTO. The question that remains is whether this trademark legislation actually contributes to Egypt’s national economy.

### 3. *The Kingdom of Saudi Arabia*

In March 2001, the U.S. State Department recognized the efforts of the 2002 Saudi legislation. However, it remained critical of the level of enforcement of the law (as well as all other IP fields). A report by the U.S. State Department stated:

*“Although the terms of legislation in Saudi Arabia to protect intellectual property rights are generally sufficient, enforcement of intellectual property rights is lacking and abuses are common.”*<sup>608</sup>

Consequently, Saudi Arabia remains on the USTR’s “Special 301 Watch List.”<sup>609</sup> Nonetheless, this constitutes an improvement when compared with the situation in 1996 during which time Saudi Arabia was placed on the more feared “Priority Watch List.”

Because of this situation as well as other political factors, Saudi Arabia’s bid to join the WTO remains unsuccessful. In the meantime, however, Saudi Arabia continues its efforts toward achieving that goal and has initiated a process of revising all of its IP legislation to bring it into conformity with the TRIPS standards of protection. In this regard, more enforcement on the street is

---

606. *Id.*

607. See *January 2002 News Bulletin*, *supra* note 559.

608. See BUREAU OF ECONOMIC AFFAIRS, U.S. DEP’T OF STATE, *2000 Country Reports on Economic Policy and Trade Practices*, at 6 (Mar. 2001) [hereinafter *Country Reports*]. These findings remained almost unchanged in the ensuing report the following year (2001). See BUREAU OF ECONOMIC AFFAIRS, U.S. DEP’T OF STATE, *2001 Country Reports on Economic Policy and Trade Practices*, at 6-7.

609. See *2000 Country Reports*, *supra* note 609, at 6.

occurring. Indeed, the U.S. Department of State recognized the Saudi government protection of IPRs during 2001. In one report, the U.S. Department of State observed:

*“The Ministry of Commerce established a Fraud Control Department in spring 2001. The office has engaged in a number of raids and shop closures in Saudi Arabia and has begun an active publicity campaign.”*<sup>610</sup>

The U.S. Department of State contended that this improvement was a result of the more active role undertaken by U.S. industries and their cooperation with the Kingdom’s ministries of commerce, information, and interior.<sup>611</sup>

In addition to its national legislation, Saudi Arabia has also joined international organizations dealing with IP protection (mainly WIPO and the International Copyright Convention). This is a further testimony to Saudi Arabia’s keenness toward improving IP protection and enforcement within its territory. Moreover, Islam appears to firmly support the moral and conceptual basis of IP protection. One commentator summed up this issue of IP protection in Saudi Arabia as follows:

*“Originally, Saudi’s intellectual property laws were detailed in forty articles of legislation. In 1984, they were repealed with regulations more in line with modern international standards. The new laws, among other things, gave added protection to trademarks with an international reputation, whether they were registered in the kingdom or not. Yet some problems persisted in enforcing the laws. These problems with enforcement have been mistakenly attributed to the lack of Islamic support for intellectual property protection.”*<sup>612</sup>

The wording of the Saudi Trademark Law, its scope of coverage, and the general tendency to improve IP legislation, enforcement, and promotion lead to the conclusion that the Saudi system is moving (in stride) towards implementing modern standards of trademark protection.

---

610. *Id.* at 7.

611. *See id.*

612. *See* S. Shaaban, *supra* note 533, at 170.

#### 4. *The Arab Republic of Syria*

The Syrian Trademark Law was not the only IP law amended in Syria. The trademark amendments were only part of a bundle of legislative amendments within the Syrian IP scheme.

It has been observed that “Syria within the course of this year [2001] actively worked to improve all of its IP laws.”<sup>613</sup> Notably, in September 2001, the Syrian Government issued a decree aimed at formally implementing the Syrian copyright Law of 2001.<sup>614</sup> This new law affords protection of copyrightable subject matter, including written works, musical compositions, and computer software where such materials have been duly registered in Syria in accordance with this new law.<sup>615</sup> Until this new law, it was exceedingly difficult to protect and prosecute copyrights in Syria. It is, therefore, not surprising that this new Syrian Copyright law has been hailed as a major contribution to IP protection in Syria. Syria appears well on the way to entering the Berne Convention, a further step on the way to enhancing copyright protection.<sup>616</sup>

An even more explicit testimony of Syria’s policy toward enhancing IP protection is found in a statement by its Minister of Supply and Trade in which he expressed Syria’s readiness to join WIPO, the Madrid Protocol for International Registration, and the Patent Cooperation Treaty (PCT). The Syrian courts appear to be willing and able to do their share in repelling trademark infringements in that country.

#### 5. *A Note on Trademarks, the Internet, and E-Commerce in Arab Countries*

Clearly, trademark issues pertaining to the Internet are, by far, not limited to questions of domain names. This Article has touched upon the potential clash between trademarks and domain names in ACME. Trademarks are used (and abused) on the Internet in various ways, including, for example, cyber squatting, improper meta-tagging, framing, selling the mention of a famous trademark as a keyword or trigger, etcetera.<sup>617</sup> In addition, the meta-territoriality characteristic of the Internet generates various legal questions regarding jurisdiction and applicable law. Suffice it to note here that there has been a growing awareness in

---

613. See *September News Bulletin*, *supra* note 98.

614. See Decree No. 1275/F issued by the Syrian Government on September 4, 2001. Implementing Syrian Copyright Law No. 12 of February 27, 2001.

615. The registration of such copyrightable subject-matter is done at the Department of Copyright Protection that is attached to the Syrian Ministry of Culture. The registration process requires filing three copies of the work and a notarized power of attorney if the applicant is represented. In addition, applicant is required to submit a statement divulging the full name, address, nationality, and profession of the applicant. A copyright certificate is issued at the end of the registration process.

616. See *September News Bulletin*, *supra* note 98.

617. The complexity of trademark use on the Internet is discussed in various writings. One notable article that focuses on Kuwaiti law is especially worth noting: Dr. Mahmoud A. Al-Kandari, *Infringement of Copyright and Trade Marks in Electronic Commerce: A Kuwaiti and Comparative Approach*, ARABL. Q. 3 (2002).

ACME to legal issues pertaining to e-commerce generally. For example, the draft Egyptian “Law on E-Commerce” of January 2001<sup>618</sup> regulates issues pertaining to commerce, and this law deals with domain names and consumer protection as well.<sup>619</sup> In addition, this draft law details the proceedings in cases of infringement, defines crimes, and prescribes penalties.<sup>620</sup>

### G. Conclusion: Assessing Trademark Protection in ACME

When attempting to assess trademark protection and enforcement by Arab countries, it is helpful to contrast the findings with situations in other developing countries. Such a comparison may assist in clarifying the relative measure of ACME compliance with IP norms and standards.

A notable study, which was concluded in 2000, reviewed the compliance of forty-six developing countries worldwide with the TRIPS agreement. The study highlighted the following collective trends, and characteristic of trademark protection (or rather lack thereof) in those developing countries:<sup>621</sup>

1. Lack of sufficient protection for service marks.
2. Lack of recognition of non-traditional marks composed of alphanumeric marks and combinations of colors.<sup>622</sup>
3. Lack of recognition or protection for well-known marks.<sup>623</sup>
4. Uneven protection for geographical indications (many times at the expense of trademarks that had been registered in good faith before the geographical indication acquired protection in the relevant jurisdiction).<sup>624</sup>

---

618. This draft law was published in Al-Khaleej newspaper on Monday, January 29, 2001. For an English translation thereof, see Al-Tamimi & Co., *Egypt: Draft Law on E-Commerce*, ARAB L. Q. 288 (2001).

619. *Id.* (documenting the requirements of the draft law in arts. 1 & 12-21)).

620. *Id.*

621. See INTA, *supra* note 395. The report includes summaries of TRIPS non-compliance during 1999 for the following countries: Antigua, Argentina, Barbados, Botswana, Brazil, Brunei, Colombia, Cuba, Cyprus, Egypt, El Salvador, Fiji, Gabon, Guatemala, Guyana, Hong Kong (China), Indonesia, Israel, Ivory Coast, Malaysia, Malta, Mauritius, Mexico, Morocco, Namibia, Philippines, Swaziland, Thailand, Uruguay, AND Zimbabwe. The report also includes a similar summary for other developing countries, concluded in 2000. This second group includes: Chile, Estonia, India, Jamaica, Kenya, Korea, Kuwait, Nicaragua, Nigeria, Pakistan, Paraguay, Poland, Qatar, Turkey, St. Lucia, Saint Vincent, and UAE.

622. See TRIPS art. 15 (recognizing that any sign or combination of signs capable of distinguishing goods or services of one undertaking from those of another is eligible to be registered as a mark). Such marks may include personal names, letters, numerals, figurative elements, and combinations of colors.

623. See TRIPS art. 16 (requiring the protection of well-known marks afforded by Article 6*bis* of the Paris Convention should also extend to service marks and apply when there is no similarity between the goods or services covered by the respective marks, so long as it is determined that use of the other mark may indicate a connection between said mark and the owners of the well-known mark and damage such owner).

624. See TRIPS art. 24(5) (upholding the eligibility of registering a mark that has been applied for or registered in good faith or where rights to a mark have been acquired through use in good faith, either before the date of application of the geographical indication or before the geographical indication became protected in its

5. Lack of satisfactory, prompt, and effective legal and customs procedures that would assist the proprietor of a mark to halt importation of infringing products.<sup>625</sup>

Based on these findings, it appears that trademark protection in Arab countries is characteristic of many other developing countries worldwide. However, the recent legislative amendments and judicial, administrative, and promotional activities indicate that Arab countries are advancing towards further protection and enforcement.

Trademark protection and enforcement in the ACME appears to have progressed in stride towards meeting the international standards of protection set out in various agreements, mainly TRIPS. This also appears to be the case with Arab countries across the board.<sup>626</sup>

Indeed, the trademark laws and regulations within these four Arab countries appear to contain most (if not all) of the main standards of trademark protection set by TRIPS (as well as the other international treaties and conventions relating to trademark protection). In addition, the courts in these Arab countries appear keen to extend apt protection to trademarks, including those that are not registered in their respective jurisdictions. This trend is especially notable in Jordan.

Interestingly, trademark protection is not being left to the legislature and the judiciary. Notable 'grass root' promotion is taking place in these countries. This is being achieved through academic, business, and international channels. In this regard, I note the substantial role played by WIPO in ACME. In fact, it is evident that WIPO has been active in boosting the IP system in many other Arab countries.<sup>627</sup> WIPO has consistently emphasized that the legislature plays a crucial role in ensuring the enactment of a "proper"<sup>628</sup> IP legislative framework. Indeed, WIPO's activism flows from its conviction that a robust IP system would help developing countries secure a competitive edge in knowledge-based economies of the 21st Century.<sup>629</sup>

In short, among the four Arab countries, Jordan is the leading one in improving trademark protection and enforcement. The other three Arab countries are following behind (in varying distances) . This trend of full IP compliance and

---

country of origin). In other words, the validity of a trademark registration or the right to use a mark is not automatically eroded just because such a mark is identical or similar to a geographical indication.

625. *See id.* at art. 51 (allowing customs to suspend the release of goods which are suspect of the infringement). Article 50 allows for adopting provisional measure without first offering the perspective defendant (culprit) an opportunity to be heard, in particular, where any delay is likely to inflict irreparable harm and where there is a demonstrable risk that evidence might be destroyed.

626. For example, countries of the GCC, Lebanon, and Tunisia.

627. One additional WIPO initiative is that of sponsoring research fellows from Arab countries for the special one-year program. *See January 2002 News Bulletin, supra* note 559.

628. *See id.*

629. According to a WIPO report, its Director General submitted to the Egyptian Delegation various suggestions of ways in which Egypt can utilize and capitalize on its rich cultural heritage by exploring digital technologies, for example, by making museum collections visually available over the Internet.

enforcement appears to be part of a larger move by Arab countries towards opening their economies to the world. In this context, one commentator observed:

*“The economic environment in many Arab countries has been changing: Governments are no longer trying to protect their economies from the rest of the world, but rather selecting the advantages of participation in the global economy. As a result, Arab legal systems are facing new challenges, and at an ever increasing pace”*<sup>630</sup>

---

630. See Howard L. Stovall, *Arab Commercial Laws—Into the Future*, 34 INT’L LAW. 839, 847 (2000).



\* \* \*