

Trade Marks Protection in the State of Qatar: An Analytical and Comparative Study^(*)

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Abstract:

Trade marks play essential roles for commercial institutions, be they establishments or companies, as they serve to distinguish their products or services from those of competitors. Additionally, they aid in building brand recognition and consumer trust. This paper focuses on the topic of trade marks protection in Qatar and comparative law. It analyses the current law, Law No. 7 of 2014, concerning the Issuance of the Law (System) of Trade Marks of the GCC, along with its Executive Regulation, No. 56 of 2023, issued by the Ministry of Commerce and Industry of Qatar.

The paper encompasses an exploration of trade marks, delineating the types of signs eligible for registration in accordance with the aforementioned law and its executive regulation. Additionally, it delves into the registration procedures and the duration of protection afforded by these regulations. Furthermore, it seeks to define, examine, and underscore the significance of well-known marks. Furthermore, the paper scrutinizes the rights conferred by a mark and the obligations imposed upon its owner regarding its usage. It also explores the owner's prerogative to license the mark to a third party. Finally, the paper concludes with a summary of its findings.

The paper views the current trade mark law in Qatar as a major advancement in the right direction. Nonetheless, businesses will require assistance in registering specific types of marks, particularly non-traditional ones.

Keywords: Well-Known Marks, Non-Traditional Marks, Mark Licensing, GCC Trade Mark Law, and Trade Marks Protection.

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1- Introduction:

1-1- General:

The term “trade mark”⁽¹⁾ encompasses any word, name, symbol, device, or combination thereof utilized by manufacturers of goods or providers of services to distinguish their offerings from those of others. Examples include well-known brands such as Qatar Airways, Ooredoo, QNB, Rayan (natural water), Microsoft software, IBM computers, Coca-Cola beverages, and McDonald’s fast food services.

In general, for a sign or any other device to be eligible for registration as a trade mark, it must inherently possess the capability to distinguish the relevant goods or services⁽²⁾.

Registration entails demonstrating that the mark possesses distinctiveness in its own right, as well as establishing the rightful owner of the mark⁽³⁾. Registration is a crucial process as it confers exclusive rights to the owner, granting the latter the authority to prevent any unauthorized third parties from using, in the course of trade, an identical or similar sign for goods or services that are identical or similar to those covered by the registered trade mark. This right is exercised to avoid any likelihood of confusion among consumers⁽⁴⁾.

1-2- The Importance of the Research:

Trade marks essentially serve as a tool for consumers to distinguish between

(1) The author previously authored a research paper on Qatar’s former trade marks law, which the current study partially references. For the earlier research paper, refer to Mohamed Salem Abou El Farag, ‘Trade Marks Protection in Qatar: A Study of the Basic Concepts in the Law No. 9 of 2002’, The Legal and Judicial Journal, Centre for Legal and Judicial Studies, Ministry of Justice, State of Qatar, Vol.4, Iss.2, 2010, pp.105-124.

(2) Art.15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter the TRIPs Agreement) of the World Trade Organisation (WTO). The TRIPs Agreement and the General Agreement on Trade in Services (GATS) and the General Agreement on Tariffs and Trade (GATT- 1994) are the three primary pillars of the WTO. Qatar has been a member of the World Trade Organisation since January 13, 1996. For more details, see: http://www.wto.org/english/thewto_e/countries_e/qatar_e.htm [last visited May 30, 2024]. It is allowed to make registrability depend on distinctiveness acquired through use, Art.15 of TRIPs.

(3) For more details, see: Keith E. Maskus, *Intellectual Property Rights in the Global Economy*, Institute for International Economics, Washington, DC: 2000, p.8.

(4) Art.16 (1) of TRIPs. Unregistered marks are protected by unfair competition action (passing off action in common law countries such as the UK). Nevertheless, the extent and scope of protection provided to unregistered marks will depend upon factors such as the extent to which, and the manner in which the mark in question has been used and has become known.

For more details, see: Mohamed Salem Abou El Farag, *Intellectual Property Law: Basic Concepts*, 2nd Edition, Dar Al Nahda Al Arabia, Cairo, 2009, p.141.

goods or services offered by competing businesses⁽⁵⁾. Hence, trade marks safeguard consumers from deception by ensuring they do not inadvertently purchase inferior goods or services under the mistaken impression that they originate from or are supplied by a different trader⁽⁶⁾. Furthermore, the reputation and goodwill associated with such marks merit protection against all forms of infringement, particularly counterfeiting activities⁽⁷⁾. Indeed, marks serve to protect the businesses with which they are associated.

This highlights the importance of the current research. To our knowledge⁽⁸⁾, there has been no comprehensive research paper that exclusively addresses the protection of key aspects of trademark law, such as protectable subject matters, well-known marks, grounds for refusal of registration, registration of marks, rights conferred by a mark, duration of protection, maintaining registration, cancellation of mark registration on the grounds of non-use, cancellation of registration by the owner, transfer of ownership of the mark, its mortgaging and seizure, and licensing of marks⁽⁹⁾.

It is important to note that the negotiations surrounding the TRIPs Agreement led to the adoption of Articles (15-21). In Qatar, trade mark protection provisions are outlined in the Law No.7 of 2014 Issuing the Trade Marks Law (System) for the Gulf Cooperation Council (GCC) Countries,¹⁰ along with its Executive Regulation No.56 of 2023, issued by the Decree of the Ministry of Trade and Industry of Qatar⁽¹¹⁾.

(5) See: Jeremy Phillips, *Trade Mark Law: A Practical Anatomy*, Oxford University Press, Oxford, UK, 2003, p.25, (expressing that this function of trade mark, i.e. to guarantee the identity of the origin of goods and services, is the “European Court of Justice’s preferred and apparently sole justification” for trade mark protection) [hereinafter: Phillips: TM Law].

(6) *Ibid.*, p.19.

(7) *Ibid.*, pp.17-18.

(8) At least in the English language.

(9) In this regard, see Mohamed Salem Abou El Farag, ‘Trade Marks Protection in Qatar: A Study of the Basic Concepts in the Law No.9 of 2002’, *op.cit.*. This paper, by the same author, focuses on the protection of trademarks under Law No.9 of 2002, with respect to trademarks, trade data, trade names, geographical indications, and industrial designs and models.

(10) This Law was published in Issue no. 11 of the Official Gazette on June 30, (2014), p.5. The following abbreviated title will be used throughout the current research to refer to the above-mentioned law: The Qatari Law of Trade Marks (or TM Law of Qatar). A copy of this Law is available at: <https://www.almeezan.qa/LawView.aspx?opt&LawID=6288&language=ar> (last visited May 30, 2024).

(11) The Minister of Commerce and Industry Decision No. 56 of 2023 Issuing the Executive Regulations of the Trade marks Law (System) for the Gulf Cooperation Council (GCC) Countries was published in Issue no.9 of the Official Gazette on 9 July 2023, p.124. Available at: <https://almeezan.qa/LawView.aspx?> (Last visited 30 May, 2024).

1-3- The Problem of the Research:

The absence of critical studies on Law No.7 of 2014 Issuing the Trade Marks Law (System) for the Gulf Cooperation Council (GCC) Countries and its impact on Qatar's legal system and judiciary presents a significant gap in the academic and practical understanding of trademark law in Qatar. This research addresses this gap by providing an analytical and critical study of the key aspects of trademark regulation under Law No.7 of 2014. It also aims to examine landmark cases issued by Qatari courts to shed light on the application and interpretation of the law in practice.

1-4- Research Methodology:

The research will employ the following methodologies:

- **Descriptive Methodology:** Aims to describe trademark protection in Qatar and in comparative legal frameworks.
- **Analytical Methodology:** Involves analyzing existing information related to trademarks, drawing from studies, research in books, peer-reviewed journals, case law, and other relevant sources.
- **Comparative Methodology:** Focuses on comparing trademark laws and practices in Qatar with those of other jurisdictions.

2- Protectable Subject Matter:

2-1- Definition: What is a Registrable Sign?

The Law No.7 of 2014 encompasses a definition of the expression "trade mark." It is defined as "everything that takes a distinctive character, including names, words, signatures, letters, symbols, numbers, addresses, seals, drawings, pictures, inscriptions, packaging, pictorial elements, shapes, colour, colour combinations, or a combination thereof, or any sign or a group of signs, if they are used or intended to be used to distinguish the goods or services of one establishment (or undertaking) from the goods or services of other establishments (or undertakings), or to indicate the performance of a service, or the conduct of monitoring or inspection of the goods or services." A sound or smell mark can be considered a trade mark⁽¹²⁾.

It should be noted that the signs mentioned in the Article are merely examples, and the list is not exhaustive. The cornerstone of the definition of a mark is its requirement to have a distinctive character. This requirement is also

(12) Art. (2) of the Trade Marks Law of Qatar.

a key aspect under the TRIPs Agreement⁽¹³⁾. The distinctiveness condition is affirmed by Article 3(1) of the TM Law of Qatar, which specifies that marks lacking distinctive character will not be eligible for registration as a trade mark⁽¹⁴⁾. Furthermore, any expression, design, or sign contrary to morality or public order shall not be registered as a mark in Qatar⁽¹⁵⁾.

2-2- Service and Control (or Examination) Marks:

Additionally, based on the definition provided above, service marks receive the same level of protection as trade marks⁽¹⁶⁾. This implies that service marks, utilized to signify the provision of services, are entitled to all the benefits and rights granted to trade marks under both Qatari law and the TRIPs Agreement. Such rights include the exclusive rights granted to the owner of a trade mark, the right of priority, special treatment for well-known marks, and enforcement measures against infringement.

Furthermore, the TM Law of Qatar acknowledges the concept of a “Quality or Examination Mark” by stipulating that if any of the examples of signs mentioned in Article 2 of the law are used for “the conduct of monitoring or inspection of the goods or services,” they are eligible for recognition⁽¹⁷⁾.

Article 35 of the TM Law of Qatar states that Juristic Persons, who monitor or examine certain goods or services concerning their source, composition, method of manufacture, quality, subjectivity, or any other characteristic, have the right to apply to the Competent Authority for the registration of a mark designated to signify the conduct of control or examination. However, it is important to note that such a mark may not be registered or transferred without the approval of the Competent Authority⁽¹⁸⁾.

(13) Art. (15) of TRIPs. The Paris Convention for the Protection of Industrial Property (1883) contains no definition of a mark, see WIPO, Implications of the TRIPs Agreement on Treaties Administered by WIPO, (Geneva: WIPO Publication No.464 (E), 1996, reprinted 1997) p.32. Qatar has been a party to this Convention since July 5, 2000, see http://www.wipo.int/treaties/en/ShowResults.jsp?search_what=C&country_id=145C (last visited May 30, 2024).

(14) This is a similar provision to what was stated in Art. 8 (2) of the repealed Law no. 9 of 2002. See also Art.6 quiniens of the Paris Convention which allows signatory countries to deny or invalidate the registration of trade marks which “are devoid of any distinctive character.”

(15) Art. (3)(2) of the TM Law of Qatar. Art. (8) (2) of the repealed Law no.9 of 2002 contained a similar rule. For more details on the concepts of public order and morality, see Jennifer Davis & Łukasz Zelechowski, ‘Bad Faith, Public Policy and Morality: How Open Concepts Shape Trade Mark Protection’ International Review of Intellectual Property and Competition Law, 54 IIC, 2023, pp.859–890, at 874 et seq.

(16) Art. (2) of the TM Law of Qatar.

(17) For more details, Salah Zain ElDin, Intellectual Rights in Qatari Laws, Qatar, 2020, p.394.

(18) Art. (35) (1) of the TM Law of Qatar.

The applicant seeking registration of the control mark must specify in the application that it pertains to a control or examination mark. Additionally, they should attach a copy of the requirements for the use of the marks intended for registration. Importantly, the owner of the registered mark is obligated to inform the Competent Authority of any changes to these requirements, and such changes shall only take effect after approval by the competent authority⁽¹⁹⁾.

2-3- Letters and Numbers:

To qualify for protection as marks under Qatari law, letters and numbers must possess a distinctive characteristic, a requirement also stipulated under the TRIPs Agreement. Once letters or numbers are registered as trade marks, other producers or traders cannot use them to distinguish their own products or services, especially if these products or services are similar. Such usage could potentially lead to confusion with the products or services for which the mark is registered⁽²⁰⁾.

Examples provided include the “4711 Eau de Cologne” Case⁽²¹⁾. This case involved the interpretation of distinctiveness and acquired distinctiveness under EU trademark law. The European Court of Justice (ECJ) ruled that numbers like “4711” could be registered as trademarks if they had acquired distinctiveness through long-term use and consumer recognition. Also, the case involving the number “118”⁽²²⁾. This case addressed the issue of distinctiveness for numerical marks under EU trademark law. The ECJ ruled that numbers could function as trademarks only if they were distinctive and not merely descriptive of the services or goods offered.

(19) Art. (35) (2).

(20) In a case, the Court of Cassation of Qatar decided that “the use of a name [or a mark] that closely resembles another trade name in a way that could mislead the public and cause confusion is prohibited. To determine whether a name has a distinct identity, it should be considered as a whole rather than by examining each component individually. The key is not whether the name contains words or letters from another name, but rather the overall impression it creates in the mind. Therefore, it is not significant if a name shares some segments with another name, as long as this does not result in confusion and mixing between them. However, if the shared segments of a name with another are likely to cause confusion among consumers, especially if they share the fundamental elements of the names, legal protection for the trade name is warranted. This applies even if the names differ in other details or segments. The protection provided by the law does not extend to these elements except to the extent that it prevents confusion with another mark. This does not apply to general or descriptive words or colours that are available for use by everyone and cannot be exclusively owned, monopolized, or protected, as they do not by themselves serve as distinctive marks.” The Court of Cassation of Qatar- Civil Cassation- Session on November 4, 2020, Appeal No. 424 of 2020.

(21) ECJ Decision of February 14, 2002, Case C-299/99, ECJ Reports 2002, I-02033.

(22) Office for Harmonization in the Internal Market (OHIM) v. Telefon & Buch Verlagsgesellschaft GmbH, Case C-51/10 P, Judgment of the European Court of Justice, June 16, 2011.

Among the examples is the case 7-Eleven⁽²³⁾. This case was decided by the United States Trademark Trial and Appeal Board (TTAB). It concerned the distinctiveness and protectability of the “7-Eleven” trademark, particularly in the context of defending it against potential confusion with similar marks. It should be noted that this mark was successfully registered for convenience store services. A competitor’s attempt to use a similar mark was rejected.

Marks such as “BMW” for a certain type of cars, “HSBC” for a well-known bank, “FourFourTwo” for a football magazine, and combinations like “O2” for a particular type of mobile phone services, illustrate the diverse forms that marks can take⁽²⁴⁾.

2-4- Non- Traditional Marks (Smell, Sound, and Taste Marks):

Human olfaction is a potent sense, and manufacturers are increasingly incorporating aromatic scents into their products. However, obtaining registration for a smell mark presents unique challenges. Applicants must visually depict the aroma and demonstrate its distinctiveness from the product itself. Representing a scent visually is perplexing since it is difficult to encapsulate a smell’s essence in a chemical formula; it is the perception of the substance rather than its physical makeup. Describing a scent in writing requires precision to ensure it is unmistakable⁽²⁵⁾. Importantly, the aroma must not stem from the product’s inherent qualities⁽²⁶⁾.

For instance, Chanel’s attempt to register its renowned fragrance (No.5 fragrance) as a smell mark in the UK was rejected because perfume aroma is fundamental to the product⁽²⁷⁾. Despite the inherent difficulties, certain scent marks have indeed passed the distinctiveness test and been granted successful registration. Examples include tennis balls from a Dutch company that emit the aroma of freshly cut grass, darts with a scent described as “the strong smell of bitter beer,” and tyres carrying a floral fragrance reminiscent of roses⁽²⁸⁾.

(23) Inc. v. Wechsler, 83 USPQ2d 1715 (TTAB 2007).

(24) For more details, see Salah Zain Eldin, op. cit., p. 383 et.seq.

(25) WIPO Magazine, ‘Smell, Sound and Taste – Getting a Sense of Non -Traditional Marks’ (2009) 78 WIPO Magazine. Available at: https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (Last visited May 30, 2024).

(26) Ibid.

(27) Ibid.

(28) Ibid. noting that the Office for Harmonization in the Internal Market (OHIM- currently named as The European Union Intellectual Property Office (EUIPO)), however, does not agree with the granting of the two UK registrations (namely, “a floral fragrance/smell reminiscent of roses” and darts with “the strong smell of bitter beer.”).

A variety of visual representations are currently utilized to describe sound marks, with sonograms and spectrograms gaining recognition in emerging areas focused on the depiction and presentation of non-traditional marks. According to the WIPO Standing Committee on the Law of Trade marks, Industrial Designs, and Geographical Indications (SCT), the right to require the mark to be depicted as a musical notation on a stave, or in any combination, with the sound constituting the mark being represented accordingly is reserved by national Offices⁽²⁹⁾. In cases where electronic filing is permitted, “an electronic file may be attached to the application⁽³⁰⁾. However, in many jurisdictions, a musical notation on a stave may be the only adequate representation of the mark”⁽³¹⁾.

Graphically representing taste marks might be simpler⁽³²⁾, as the SCT indicates that “the graphic representation requirement was satisfied by using a written description of the taste and an indication that it concerns a taste mark”⁽³³⁾. However, the challenge of proving distinctiveness is even more daunting, as are the claims regarding functionality.⁽³⁴⁾ For instance, pharmaceutical company Eli Lilly’s attempt to register the taste of artificial strawberries was rejected. In decision R 120/2001-2⁽³⁵⁾, they noted, “[a]ny manufacturer... is entitled to add the flavour of artificial strawberries to those products to mask any unpleasant taste they might have or simply to make them more pleasant to taste... Additionally, consumers are unlikely to perceive the taste as a trade mark; they are more likely to believe it is meant to mask an unpleasant taste of the product....”⁽³⁶⁾.

Similarly, N.V. Organon’s attempt to register an orange flavour for pharmaceuticals was rejected by the USPTO⁽³⁷⁾. The Trade Mark Trials and

(29) Ibid.

(30) Ibid.

(31) Ibid.

(32) See: Simon Geiregat, ‘Trade Mark Protection for Smells, Tastes and Feels’ (2022) 53 ICC-International Review of Intellectual Property and Competition Law, pp. 219-245, at pp. 223-224.

(33) WIPO Magazine, ‘Smell, Sound and Taste – Getting a Sense of Non -Traditional Marks’, Vol.78, (2009) WIPO Magazine. Available at: https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html, (Last visited May 30, 2024).

(34) Ibid.

(35) This decision is available at: <https://www.copat.de/markenformen/r0120-2001-2.pdf>, (Last visited May 30, 2024).

(36) Ibid.

(37) WIPO Magazine, ‘Smell, Sound and Taste – Getting a Sense of Non -Traditional Marks’, WIPO Magazine, Vol.78, (2009).

Appeals Court highlighted the difficulty in establishing how taste can function as a trade mark since consumers only experience the taste after purchase⁽³⁸⁾.

In line with the EU Trade Marks Directive⁽³⁹⁾, signs to be registered must be capable of distinguishing the goods or services of one undertaking from those of other undertakings and be clear and precise to determine the subject matter of the protection afforded to its owner⁽⁴⁰⁾. In other words, it will be sufficed if they can be clearly and precisely determined⁽⁴¹⁾.

Previously⁽⁴²⁾ it was required to be capable of being “represented graphically”⁽⁴³⁾. This change in representation seeks to align with EU market demands for contemporary trade mark types and considers the technical

(38) Ibid.

(39) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks. It is available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32015L2436>. (last visited May 30, 2024).

(40) See Art. (3) of the Directive.

(41) For more details, see: Simon Geiregat, op. cit., p.221 et seq.

(42) The European Court of Justice (ECJ), in the case of Sieckmann v. Deutsches Patent-und Markenamt (Case C-273/00) [2003] ETMR 466, held that Art.2 of the previous Directive did not exclude signs which were not in themselves capable of being perceived visually, such as odours, provided they could be represented graphically. It also held that the “graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified.” The Court went on to lay down seven criteria which the graphic representation must satisfy. It must be: (i) clear, (ii) precise, (iii) self-contained, (iv) easily accessible, (v) intelligible, (vi) durable, and (vii) objective. In this case Mr Sieckmann sought to register an olfactory mark in various classes and attempted to represent the mark in a number of ways: 1- a description of the chemical substance methyl cinnamate (cinnamic acid methyl ester) and its chemical formula (C₆H₅-CH = CHCOOCH₃); 2- provision of an odour sample of the sign in a container; and 3- a description of the scent as “balsamically fruity with a slight hint of cinnamon”). For more details, see Mohamed Salem Abou El Farag, op. cit., p.112.

(43) As for sound marks, the ECJ held in the Shield Mark case (Shield Mark BV v Kist (t/a Memex) (C283/01) [2004] Ch. 97 (ECJ (6th Chamber))). that sound signs were capable of being registered as trade marks provided they are (a) capable of distinguishing the owner’s goods or services, and (b) capable of being represented graphically, particularly by means of images, lines or characters. In relation to the question of graphic representation, the Court confirmed that the Sieckmann conditions had to be met by any graphical representation. Therefore, such a graphical representation must be “clear, precise, self contained, easily accessible, intelligible, durable and objective.”

For example, as mentioned by the Court, representation by a musical stave would be sufficient for registration. However, a mere sequence of notes or a description of a sound using only written language (e.g. «the crow of a cockerel») or onomatopoeia would not be sufficient. The case concerned two sound marks: the first nine notes of the melody “Für Elise” and the crowing of a cock. The reference from the Hoge Raad in the Netherlands asked whether sounds or noises could be registered as trade marks under Art.(2) TMD and, if so, whether the graphic representation requirement was met by musical notes, a description in words, a voice picture or sonogram, a sound carrier, a digital recording which could be listened to on the internet or by a combination of these elements. For more details, see: Mohamed Salem Abou El Farag, op. cit., pp.112-113.

capabilities of representing trade marks in electronic registers⁽⁴⁴⁾. Consequently, in the future, sound marks, multimedia marks, holograms, and other types of trade marks in appropriate electronic formats may also be registered as trade marks, provided there are no grounds for refusal⁽⁴⁵⁾.

It should be noted that the international extension of protection for these new types of trade marks is not feasible at present, as the World Intellectual Property Organization (WIPO) still mandates a reproduction of the trade mark in the form of a two-dimensional graphic representation⁽⁴⁶⁾.

The UK Trade Marks Regulations 2018⁽⁴⁷⁾, which amended the 1994 Trade Marks Act, removes the requirement for graphic representation. In line with section 3, trade mark means “any sign which is capable:

- a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- b) of distinguishing goods or services of one undertaking from those of other undertakings.”

This change therefore paves the way for protection of less traditional trade marks, such as smell, taste, hologram and motion marks⁽⁴⁸⁾. As an example, the change means applicants will be able to secure protection for a motion mark by submitting an MP4 file⁽⁴⁹⁾.

Among the examples mentioned in Art. (2) of the current Qatari TM Law that can be registered as trade marks are sound and smell. Art. (4) of the Executive Regulations of 2023, provides that sound marks must be presented in the form of musical notation or a written description. Additionally, scent marks must be presented with a written description.

(44) German Patent and Trade Marks Office, ‘Information on the amendment of the European Union Trade Mark Directive.’ Available online at: https://www.dpma.de/english/trade_marks/trade_mark_protection/mamog/reform/index.html. (last visited May 30, 2024).

(45) Ibid.

(46) Ibid.

(47) These regulations came into force on 14th January 2019. The regulations are available at: <https://www.legislation.gov.uk/uksi/2018/825/data.pdf> [last visited May 30, 2024].

(48) Vanessa Harrow, ‘The UK Trade Marks Regulations 2018: What is Changing?’ (January 2019), available at: <https://www.novagraaf.com/en/insights/uk-trade-marks-regulations-2018-what-changing#:~:text=Restoration%20of%20trademark%20registration,accept%20the%20request%20for%20restoration.> (last visited May 30, 2024).

(49) Ibid.

It should be noted that the repealed TM Law No.9 of 2002 stated in Article 1 that a trade mark must be visually perceptible, while Article 6 of the same law included sound and smell marks among the examples of signs that can be regarded as trade marks. In a previous research, the author argued that this contradiction could only be resolved by the adoption of a system of graphic representation⁽⁵⁰⁾.

2-5- A Colour as a Mark:

Under the Qatari Trade Marks Law, it is possible to register a combination of colours or a single colour as a trade mark, provided that the combination or the single colour possesses a distinctive character.

Hence, it is permissible to register a “colour or combination of colours” as a trade mark, but only if the colour or combination of colours has a distinctive character⁽⁵¹⁾. Under the repealed TM Law, only combinations of colours or a single non-functional colour could be registered as a trade mark. The repealed law was more specific in this regard, particularly concerning single colours, as it conditioned their registration on being “a single non-functional colour.” It is suggested that such a requirement should remain consistent under the current law.

Colour marks, a type of non-traditional trade mark, have traditionally been challenging to register in the UK⁽⁵²⁾. Despite their broader usage in the EU, precedent has maintained that colour alone lacks the distinctiveness required for protection in the UK. However, a decision was recently issued that could alter this by providing a more defined set of rules for the use of colour marks⁽⁵³⁾. This development opens up potential new and innovative methods for protecting your business’s brand⁽⁵⁴⁾.

(50) Mohamed Salem Abou El Farag, op. cit., p.111.

(51) It is rightly stated that “colour marks generally are not considered inherently distinctive, as consumers typically perceive colour to be ornamental. Therefore, the USPTO traditionally refused trade mark applications for colour marks where the applicant had not established that the proposed mark acquired distinctiveness [in line with the provisions of the law].... In another case, the court held that some colour marks can be inherently distinctive when used on product packaging if consumers perceive the particular combination and arrangement of colours as indicating source.” For more details, see Practical Law Intellectual Property & Technology, ‘Protecting Non-Traditional Trade Marks’ (2024), available at: [https://uk.practicallaw.thomsonreuters.com/w-008-0911?transitionType=Default&contextData=\(sc.Default\)](https://uk.practicallaw.thomsonreuters.com/w-008-0911?transitionType=Default&contextData=(sc.Default)) [last visited May 30, 2024].

(52) Lindsay Gledhill, ‘Can Colours be Registered as Trade Marks’ (January 2023), available at: <https://harperjames.co.uk/news/colour-marks/> (last visited May 30, 2024).

(53) Ibid.

(54) Ibid.

Cadbury has been attempting for many years to register a specific shade of purple⁽⁵⁵⁾, “named Pantone 2685C,” for their chocolate packaging. Their application aimed to secure protection for the colour as it appears on “the whole visible surface of the packaging of goods” or as “the predominant colour applied to the whole visible surface”⁽⁵⁶⁾. Nestle, a competitor, objected to this application. The Court of Appeal initially sided with Nestle⁽⁵⁷⁾, ruling that the description was not sufficiently clear. The Court found that the representation of the sign did not accurately reflect the description, and the term ‘predominant’ was deemed too vague⁽⁵⁸⁾.

Cadbury conceded that the mark was not inherently distinctive but argued that it had acquired distinctiveness through use⁽⁵⁹⁾. The UK IPO determined that the evidence provided by Cadbury demonstrated that the mark had acquired distinctiveness specifically for chocolate in bar and tablet form, as well as for drinking chocolate⁽⁶⁰⁾. However, this was not true for other goods for which protection was sought, such as chocolate assortments, confectionery, and cakes⁽⁶¹⁾. This decision indicates that the scope of protection for a trade mark involving a single colour will be interpreted strictly, but it also shows that obtaining such a registration is possible⁽⁶²⁾.

2-6- Packaging as a Mark:

For the first time, the law stipulates that packaging can be regarded as a trade mark⁽⁶³⁾. Packaging can be defined as the process of fabricating or creating a package for any product that will be delivered to a consumer. By utilizing distinctive packaging, a consumer can differentiate and identify such a product from those of competitors⁽⁶⁴⁾.

(55) Indeed ‘a unique purple colour.’

(56) Ibid.

(57) *Société des Produits Nestlé SA v. Cadbury UK Limited* [2013] EWCA Civ 1174. Available at: <https://www.bailii.org/ew/cases/EWCA/Civ/2013/1174.html>. (last visited May 30, 2024).

(58) Ibid.

(59) Barker Brettell, ‘Protection of Colours as Trade Marks’ available at: <https://www.barkerbrettell.co.uk/protection-of-colours-as-trade-marks/> (last visited May 30, 2024).

(60) Ibid.

(61) Ibid.

(62) Ibid.

(63) See Art. 2 of the TM Law of Qatar.

(64) Eloise Harding & Felecia Oduntan, (October 2021) ‘Trade Marks Protection for Shapes of Products and Packaging,’ available at: <https://www.mishcon.com/news/trade-mark-protection-for-shapes-of-products-and-packaging> [last visited May 30, 2024].

Generally speaking, for trade dress⁽⁶⁵⁾ to be protected under trade marks law, it must not be functional. A design feature is considered “functional” and ineligible to serve as a trade mark if it is essential to the use or purpose of the article, or if it significantly impacts the cost or quality of the article⁽⁶⁶⁾. The functionality doctrine restricts the range of product configurations and design features eligible for registration under trade mark law⁽⁶⁷⁾.

Furthermore, it is important to differentiate between the following two types of trade dress⁽⁶⁸⁾:

- 1- “Product-packaging” trade dress consists of the overall combination and arrangement of design elements comprising the product’s packaging, encompassing graphics, layout, colour, or colour combinations; and
- 2- “Product-design” trade dress pertains to a product’s shape or configuration and other design features of the product.

The first type can be registered and protected under trade marks law as long as it is inherently distinctive or has acquired secondary meaning through its use in the course of trade. This is because it is recognized by consumers as identifying the source or origin of the product⁽⁶⁹⁾. On the other hand, it is suggested that the second type can only be protected by trade marks law only if it has acquired a secondary meaning through the use of it in the course of trade⁽⁷⁰⁾.

In the UK, packaging can be protected through trade marks, although another type of intellectual property protection might be more appropriate. For instance, the shape of packaging might be more effectively protected by a registered design, provided it is sufficiently novel and has not been publicly disclosed anywhere in the world for more than 12 months⁽⁷¹⁾. Nevertheless, in

(65) For more details on trade dress, see Qadir Qeidary, ‘Shape Mark (Trade Dress) Distinctiveness: A Comparative Inquiry Into U.S. and EU Trade mark Law’, William & Mary Business Law Review, Vol.13, Iss.1, (2021), p.71.

(66) *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995). Available at: <https://supreme.justia.com/cases/federal/us/514/159/> [last visited May 30, 2024]. See also Jeffery A. Handleman, ‘Stretching Trade mark Laws to Protect Product Design and Packaging.’ Available at: [https://country-index.com/\(X\(1\)S\(41jdsbaphjdvep3k141kzob\)\)/articles/article_201.pdf](https://country-index.com/(X(1)S(41jdsbaphjdvep3k141kzob))/articles/article_201.pdf), p.1. (last visited May 30, 2024).

(67) Jeffery A. Handleman, op. cit., p.1.

(68) Ibid.

(69) *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000). Available at: <https://supreme.justia.com/cases/federal/us/529/205/> p.212. See also, Handleman, op. cit., p.3.

(70) Jeffery A. Handleman, op. cit., p.5.

(71) Joanne Ling & Janet Strath, (July 2020), ‘Packaging Trade Marks’, the Chartered Institute of Trade Marks Attorneys, available at: <https://www.citma.org.uk/resources/packaging-trade-marks-blog.html>. (last visited May 30, 2024).

the food and beverage industry, several renowned brands have successfully registered the distinctive shape of their product packaging as trade marks, such as *the bottle of Coca Cola*, the shape of *Toblerone Chocolate*⁽⁷²⁾.

2-7- Marks of Public Benefit Bodies and Professional Institutions:

Article (36) of the Law stipulates that a trade mark may be registered for non-commercial purposes, such as logos (emblems) adopted by public benefit bodies, or used by professional institutions to distinguish their correspondence or to serve as badges (emblems) for their members.

3- Well-Known Marks⁽⁷³⁾:

Under Art.(16) (2) of the TRIPs Agreement⁽⁷⁴⁾ the so-called “well-known” marks are protected. Well-known marks are indeed protected to prevent third parties from exploiting the reputation and goodwill associated with them. This protection aims to safeguard consumers⁽⁷⁵⁾ who seek to purchase goods or services of a certain quality associated with these marks. Brands such as “Coca-Cola” for beverages, “Nike” and “Adidas” for sportswear, “Apple” for electronic appliances, “Mercedes-Benz” for cars, and “Rolex” for watches, among others, are (or could be) protected as well-known marks.

(72) Ibid.

(73) “In the world of trade mark law, there sits a kingdom. It appears separate from the rest of the law and even seems to shine a little more brightly...[this is] the field of famous and well-known marks”, expressed by Rachel Anne Wallace, ‘Chaos in the Realm of Famous and Well-Known Marks’ (2001) 19 (4) Intellectual Property Law Newsletter 16.

(74) Art. (16)(2) in fact states that Art. 6bis of the Paris Convention shall apply, *mutatis mutandis*, to services. Art. 6bis includes detailed rules on the protection of well-known marks.

(75) In considering the nature of the consumers in the State of Qatar, the Court of Cassation ruled that “Given the nature of consumers in the State of Qatar, where the population includes citizens, individuals of Arab nationalities, and others of foreign nationalities with diverse native languages, many residents have become accustomed to using English as a common language for communication across linguistic differences. As a result, business owners often use signs or names in both Arabic and English, either by transliterating the trade name into the other language with the same pronunciation and sound, or by translating the meaning of the name from one language to the other.

With the widespread use of English in this manner, the Qatari legislator - rightly so - has taken steps to elevate the status of the Arabic language. The legislator has mandated not only government entities to use Arabic in all their transactions, contracts, and agreements but also non-governmental entities, including private companies and institutions.

Consequently, Law No.7 of 2019 on the Protection of the Arabic Language was enacted. Under Article (8) of this law, all institutions and companies are required to adopt Arabic names. However, those with globally recognized names or products are permitted to retain their foreign names, provided they are accompanied by an Arabic equivalent. Furthermore, Article (10) of the same law requires that trade names and trademarks be written in Arabic, while allowing them to be written in a foreign language, provided that the Arabic text is given prominence as the primary language to be adhered to. Despite the widespread use of foreign languages, particularly English, within Qatar, these legislative measures aim to preserve and promote the use of the Arabic language.” The Court of Cassation of Qatar- Civil Cassation- Session on July 1, 2021, Appeal No. 320 of 2021.

In Qatar, well-known marks are indeed protected. Before delving into the scope of protection afforded to well-known marks under Qatari law, it is advisable to clarify when a mark is considered to be well-known.

3-1- Determination of when the Mark is “Well-known”:

Paragraph 2 of Article 4 of the TM Law of Qatar outlines the criteria for determining when a mark is considered “well-known.” According to this Article, considerations must be given the extent to which the mark is known to the relevant sector of the public as a result of:

- its promotion,
- The duration of its registration or use.
- The number of countries in which it has been registered or has become well-known.
- The value of the mark and its impact on the promotion of the goods or services for which it is used to distinguish.

In this regard, it is worth mentioning that some of the elements mentioned above are indeed included in the TRIPs Agreement. According to Article (16) (2) of the Agreement, WTO Members are obligated to “take account of the knowledge of the trade mark in the relevant sector of the public, including knowledge obtained as a result of the promotion of the trade mark.”

In clarifying such criteria, the following elements are considered⁽⁷⁶⁾:

- i) Public repute (knowledge of the trade mark in the relevant sector): When determining whether a trade mark is well-known, it is crucial to consider the level of awareness of the trade mark within the relevant sector of the public. This can be substantiated through survey evidence⁽⁷⁷⁾;

(76) For further details, see Blakeney, ‘Well-Known’ Marks’ (1994) 16 (11) EIPR 481, pp.482-4; Frederick W. Mostert, ‘When is a Mark «Well-Known»’ (1997) 3 IPQ 377; Norma Dawson, ‘Famous and Well-Known Trade Marks- ‘Usurping a Corner of the Giant’s Robe’ (1998) 4 IPQ 350; and Christopher Morcom, ‘Analysis: Famous and Well-Known Marks’ (1997) 3 IPQ 370, pp. 373-4.

(77) The European Court of Justice in *General Motors Corporation v. Y Plon S.A (CHEVY Case C-375/97)* [1999] ETMR 950 interpreted Art.5 (2) of the previous TM Directive, (which gives the proprietor of a trade mark the right to prevent all third parties ...from using...any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State...) “as meaning that in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which covers.” In respect of the extent of the territory, it decided that “it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of the Member State concerned.”

- ii) Advertising: Article (4)(2) of the Law and Article (16)(2) of the Agreement also mention “knowledge ... obtained as a result of the promotion of the trade mark” in assessing whether a trade mark is well-known. This provision clarifies that the extent of protection granted hinges largely on the renown of the mark, which is often influenced by advertising efforts⁽⁷⁸⁾. Therefore, ““spillover advertising” in the form of television exposure, circulation of international magazines, travel statistics of people who were probably exposed to the mark, and exhibition to the trade and public at international trade fairs, will be of importance”⁽⁷⁹⁾ in determining whether or not it is a well-known mark; and
- iii) Other factors as stated in Article (4)(2) of the Law: a) The history of a mark, including the duration of its registration or use. b) The number of countries in which it has been registered or has become well-known. c) The value of the mark and its impact on the promotion of the goods or services for which the mark is used to distinguish.
- iv) Other factors not stated in Article (4)(2): Attention should also be directed to other factors that may be useful for the competent authority. Some of these significant factors include⁽⁸⁰⁾: 1) findings of repute by trade mark offices in opposition hearings and by courts; 2) the degree of inherent or acquired distinctiveness of the mark; 3) the degree of exclusivity of the mark, and the nature and the extent of use of the same or a similar mark by third parties; and 4) the nature of the goods or services and the channels of trade for the goods or services.

The law provides protection to the owner of a well-known mark, even if the mark is not registered in Qatar. This is evident from paragraph 1 of Article (4) of the Law, which states that it is prohibited to register a well-known mark if its notoriety has extended beyond the borders of the country in which it was registered to other countries for identical or similar goods or services, unless the application is submitted by the owner of the well-known mark or with their explicit consent.

(78) Annette Kur, ‘TRIPs and Trade mark Law’ Friedrich-Karl Beier and Gerhard Schriker (eds.), From GATT to TRIPs: The Agreement on Trade-Related Aspects of Intellectual Property Rights, Vol.18 (Munich: Max Planck Institute for Foreign and International Patent, Copyright and Competition Law, 1996) p. 106.

(79) Mostert, op. cit., p.379.

(80) Ibid., p. 380 et seq.

3-2- Additional Protection to Well-known Marks:

- Similar or Identical Goods or Services:

Article (3)(13) of the TM Law of Qatar stipulates that “it is not a trade mark or part thereof, and it is not allowed to be registered under such a description, the following: ... 13- marks that constitute a copy, imitation, or translation of a well-known trade mark or part thereof owned by a third party, for use in distinguishing goods or services that are identical or similar to those that the well-known trade mark is used to distinguish.”

In this provision, protection is afforded to well-known marks against any sign that constitutes a *copy, imitation, or translation of a well-known mark or part thereof* owned by a third party, if such sign is used to distinguish goods or services that are identical or similar to those distinguished by the well-known mark⁽⁸¹⁾.

According to the wording of paragraph 13 of Article (3), protection is granted to well-known marks against signs that constitute copies, imitations, or translations, regardless of whether the well-known mark is registered in Qatar or an application for it is submitted to the competent authority. This provision applies to goods or services that are identical or similar to those distinguished by the well-known mark.

Indeed, the scope of protection is broad. As outlined in the above-stated paragraph, a sign that comprises a copy, imitation, or translation of a well-known mark shall not be considered a mark or be registered if the application

(81) The Court of Cassation of Qatar decided that “the mere translation of a trade name [or a mark] from Arabic to English or vice versa, or the phonetic pronunciation of the trade name in the corresponding language, does not inherently cause similarity and confusion among consumers. This is unless they share additional features, such as the design of the letters, colours, or other elements, and engage in the same or similar activities, which could elevate the issue to visual deception, or the mental image formed in the consumer’s mind about the name or trade mark.” The Court of Cassation of Qatar- Civil Cassation- Session on July 1, 2021, Appeal No. 320 of 2021.

In this ruling, the court decided that “The legislator has distinguished between a trade name and a trademark. The trade name is limited to the name chosen by a natural or legal person and assigned to their enterprise or products. In contrast, a trademark encompasses a broader scope, including all forms, names, drawings, images, and other elements that give it a unique identity closely associated with the product, goods, or services offered by the user[or owner] of the mark.

A trade name itself can also serve as a trademark simultaneously, depending on how its letters are designed, the colors used in its writing, any frames surrounding it, or any images or symbols blended with it. This could include its integration with one or more of these elements, or others, which generally make it distinctive and form a visual impression in the mind due to this composition. The legislator has granted legal protection to the use of a trade name by a business, even if it is not registered. The owner of the trade name is entitled to prevent others from adopting the same name if such use could mislead or deceive consumers.”

is submitted by a third party and not the owner of the well-known mark, and if it is related to goods or services identical or similar to those distinguished by the well-known mark.

- Non Similar or Identical Goods or Services:

Paragraph 14 of Article (3) of the Law states that it is not considered a trade mark or part thereof, and it is not permitted to be registered under such a description, the following: "... 14- marks that constitute a copy, imitation, or translation of a well-known trade mark owned by a third party, or an essential part thereof, for use in distinguishing goods or services that are not identical or similar to those distinguished by the well-known mark, if such use would indicate a connection between those goods or services and the well-known mark, and if it is likely to cause harm to the interests of the owner of the well-known mark."

The scope of protection for well-known marks, as outlined in this paragraph, is indeed expanded to cover goods or services that are not identical or similar. Therefore, signs comprising a copy, imitation, or translation of a well-known mark owned by a third party, or an essential part thereof, for use in distinguishing goods or services that are not identical or similar to those distinguished by the well-known mark, shall not be considered as a mark or part thereof and cannot be registered under such description if:

1. such use would suggest a connection between those goods or services and the well-known mark.
2. it is likely to cause harm to the interests of the owner of the well-known mark.

It is up to the court to determine whether there is a connection between the goods or services to be distinguished by the mark for which an application has been submitted by a third party and the goods or services of the owner of the well-known mark. Additionally, the court shall decide whether the use of the mark for which an application was submitted by a third party would likely harm the interests of the owner of the well-known mark.

4- Grounds For Refusal of Registration:

The law specifies that several types of marks cannot be considered as a trade mark or part thereof and cannot be registered under such a description⁽⁸²⁾. These marks, among other things, include marks devoid of any distinctive

(82) Art. (3) of the Law.

characteristic⁽⁸³⁾. These marks also encompass marks consisting of generic information, which is merely the name customarily given to goods and services (generic marks), or marks featuring familiar drawings and common images of goods, expressions, drawings, or signs that contravene public morals⁽⁸⁴⁾ or public order.

Furthermore, the following would not be considered as a mark or part thereof and would not be registered under such a description⁽⁸⁵⁾:

- public emblems, flags, military and honorary badges, national and foreign decorations, coins and paper currency, and other symbols of any of the GCC states or any other country, or of Arab or international organizations or their institutions, or any imitation thereof.
- symbols of the red crescent or the red cross and other similar symbols, as well as signs that imitate them.
- signs that are identical or similar to symbols of a purely religious nature.
- names and geographical indications⁽⁸⁶⁾, if their use would create confusion regarding the source or origin of goods or services.
- a third party's name, title, image, or logo, unless the individual or their heirs provide prior consent for its use.
- data regarding honorary degrees or academic degrees, for which the applicant cannot prove legal entitlement.
- signs that may mislead the public⁽⁸⁷⁾, or that contain false information about

(83) In a decision issued in 2006, the Cassation Court of Qatar decided that the word "Hayat" cannot alone be registered as a trade mark (or a trade name) since it is regarded as a descriptive and normal word, see decision no.103/2006 (civil section), Collection of Decisions of Court of Cassation, 2nd year, 2006, p.357.

(84) E.g. Hallelujah Trade Mark [1976] R.P.C. 605, in which it was refused to register that word for the following reasons: (1) use of the word on women's clothing would offend generally accepted morals of the time and would be contrary to morality within the Trade Marks Act 1938 s. 11; and (2) in any event registration should be refused in the exercise of the Registrar's discretion as it would offend the religious susceptibilities of a not insubstantial number of persons.

(85) Art. (3) of the Law.

(86) On this topic, see Andrea Zappalaglio, 'EU Geographical Indications and the protection of producers and their investments' in Enrico Bonadio and Patrick Goold, *The Cambridge Handbook of Investment-Driven Intellectual Property* (the UK: Cambridge University Press, 2023), Chapter 18, pp.308-328.

(87) In *SOFLENS Trade Mark* [1976] R.P.C. 694, the registration of the mark 'SOFLENS' in respect of contact lenses and their carrying cases and films for training purposes was opposed on the ground that it would, inter alia, be misleading if applied to lenses which were not soft.

the origin or source of goods or services, or their other characteristics, as well as marks that contain a fictitious, imitated, or forged trade name⁽⁸⁸⁾.

- marks owned by natural or juristic persons with whom dealing is prohibited, in accordance with a decision issued by the competent authority.
- any mark that is identical or similar to a mark previously filed or registered by others for the same goods or services, or for related goods or services, if the use of the mark to be registered would create an impression of linking it to the goods or services of the owner of the registered mark, or would lead to harm to their interests⁽⁸⁹⁾.

(88) No confusion should exist between a trademark registered in the Trademark Registry and a trade name recorded in the Commercial Registry. The Court of Cassation of Qatar elaborated on this by stating: “In the case at hand, the appellant relied on the information contained in an excerpt from the Commercial Register No. (69558), which records the appellant’s name in English as “Exclusive Perfumes” and in Arabic as “أكسلوسف بيرفيومز لتجارة العطور”.

Meanwhile, the respondent based their argument on the certificate of trademark registration No. (117325) in Class (3), dated 14/11/2019, issued pursuant to an application submitted on 20/9/2007. This certificate includes the design of the trademark and the English lettering “Exclusive”, topped with a logo containing the letter “E”. The court was required to recognize the difference between the two legal foundations relied upon by the parties and avoid conflating the trade name recorded in the Commercial Register with the trademark filed with the Trademark Office.

The court should have examined the trade name of each party and the precedence of its use, as well as the trademarks of both parties (if any) and the precedence of their registration. It was also necessary to determine whether the appellant had registered a trademark with the Trademark Office, the date of such registration, or whether the appellant had merely registered a trade name. Additionally, the court should have compared the trade names and trademarks (if any) to identify similarities or differences and assess whether these could lead to confusion or deception of the average consumer. However, the contested judgment failed to address these critical considerations. Instead, it merely relied on the similarity of the translated meanings of the names in both Arabic and English, coupled with the identical nature of the business activities, as the sole criterion to determine the likelihood of confusion and consumer deception. This approach resulted in inadequate reasoning and flawed interpretation, leading to an error in the application of the law. Consequently, the judgment must be overturned.” The Court of Cassation of Qatar- Civil Cassation- Session on July 1, 2021, Appeal No. 320 of 2021.

(89) In a decision by the Court of Cassation in Qatar, it ruled that “Given this, and since the contested judgment was based on the decision to cancel and remove the trademark of the appellant’s branch, registered under No. ... on 16/12/2012, on the grounds of similarity between it and the trademark of the first and second respondents in the word «...» and the presence of a flame design in both logos (regardless of its color) for the same fire-fighting products, which was deemed likely to deceive the average, reasonably cautious, and attentive consumer and cause confusion between them. However, examining such similarity requires evaluating all the elements composing both trademarks and the overall impression created in the mind as a result of their combination, regardless of the individual components of each trademark. Particularly, a flame design is a generic symbol that no one should exclusively claim as a distinctive trademark if others use it differently. This flaw in reasoning renders the judgment invalid due to faulty inference, leading to an error in the application of the law, and necessitating its annulment for this reason without the need to examine the remaining grounds of appeal.

Since the case is ready for a final ruling—and based on the foregoing—while the trademark of the

- signs whose registration for certain goods or services results in the devaluation of the goods or services distinguished by the previous mark.
- signs that include the following words or phrases: “Concessioned,” “registered,” “registered fee,” “copyright,” or similar terms and expressions.

Indeed, the current law comprehensively covers the most significant grounds for refusal of registration of a mark or part thereof. It addresses various aspects including marks lacking distinctiveness, misleading signs, unauthorized use of third-party names or symbols, false information, potential confusion with existing marks, and other factors that could undermine the integrity of the registration process.

5- Registration of Marks:

5-1- Persons Entitled to Register Trade Marks:

In accordance with Article 5 of the TM Law of Qatar, the following categories are entitled to register their marks:

- 1- Every natural or juristic person who holds the nationality of any of the GCC countries, regardless of whether they are the owner of a factory, producer, trader, craftsman, or owner of a service enterprise.
- 2- Foreigners who reside in any of the GCC Council countries and are authorized to practice commercial, industrial, craft, or service activity.
- 3- Foreigners belonging to a state that is a member of a multilateral international agreement to which a GCC state is a party or residing in that state.
- 4- Public authorities.

5-2- Ownership of the Mark:

In accordance with Article 7 of the TM Law, the person who has registered a mark in good faith is considered the owner thereof. Ownership of the mark may not be disputed as long as the registration of the trade mark is accompanied by its use for at least five years without the existence of a judicial dispute regarding it.

branch of the first respondent does include a flame design, it is shaped differently from the flame design in the appellants' trademark. Moreover, the two trademarks differ overall, ensuring sufficient distinction between them that would not result in confusion or deception among consumers. Accordingly, the appeal must be rejected, and the contested judgment upheld.” The Court of Cassation of Qatar- Civil Cassation- Session on October 18, 2016, Appeal No. 243 of 2016.

Paragraph 2 of the same Article stipulates that it is permissible for the person who was the first to use the mark to request the competent court to cancel the registration of the mark within five years from the date of registration, unless it is proven that the earlier user explicitly or implicitly consented to the use of the mark by the person in whose name it was registered.

The following should be noted:

- despite the ambiguous wording of this article, which might suggest that rights in a mark could be acquired through registration, it is suggested that under Qatari law, rights in a mark are primarily acquired through usage. In other words, rights to a mark are established by the first person to use it, rather than through its registration⁽⁹⁰⁾. The law stipulates that anyone registering a trademark must do so in good faith. This requirement was not included in the repealed Law No. 9 of 2002. However, Article 26 of the repealed law remains relevant in this context. This article provided that “...the office or any interested party may request the civil court to invalidate the registration of a mark that was unlawfully registered....”
- the repealed Law required the use of the mark within the five years to be of “continuous use” from the date of registration⁽⁹¹⁾. However, such a requirement is not contained in the current law.
- both the current Law and the repealed Law stipulate that there should not be any judicial dispute regarding the mark for the ownership to be fully granted to the person who registers it.
- it is submitted that registration of a mark under the TM Law carries significant weight and has a strong legal impact. Once a mark is registered, the burden of proof shifts to the person who challenges such

(90) See also Samiha El Qalyoubi, *Industrial Property* (Cairo: Dar Al Nahda Al Arabia, 2016 [in Arabic]) p. 555 et seq.

(91) The Court of Cassation of Qatar ruled that the provisions concerning the protection of trade marks “highlight that trade marks are essential for distinguishing the goods and services produced by one establishment from those produced by others. Any confusion or similarity between them can harm the trade mark owner.

Therefore, the Qatari legislator has ensured protection for trade marks, outlining the method for their registration, the necessary conditions and regulations, and the effects of such registration. Among these effects is the ownership of the trade mark by the one who registered it first, provided they continue to use it actively for five consecutive years without any dispute from the date of registration. Once ownership is established, it cannot be contested as long as the protection period is in effect, whether during the initial ten-year protection period or through successive renewals. This protection for the trade mark can only be revoked in specific cases, including if the trade mark owner fails to apply for renewal within more than three years.” The Court of Cassation of Qatar- Civil Cassation-Session on January 19, 2021, Appeals No. 509 and 515 of 2020.

registration. To succeed in his claim, he will have to prove that he was the first to use the mark in question.

- it is evident that the registration of a mark and its use for five years from that point shall block any challenge to cancel its registration, even if the challenge comes from an earlier user⁽⁹²⁾.
- if it becomes evident that the registration has been associated with bad faith⁽⁹³⁾, a petition for its cancellation of the mark may be filed at any time by the competent authority or by anyone concerned⁽⁹⁴⁾. Such a claim must be submitted to the competent court⁽⁹⁵⁾. Once a final ruling is presented, the competent authority is required to cancel the registration of the mark in question⁽⁹⁶⁾.

6- Rights Conferred by A Mark:

According to Article 17 (2) of the TM Law of Qatar, the owner of a registered trade mark shall have an exclusive right:

- to use the mark; and
- to prevent third parties, if they do not obtain his consent, from using it and from using any identical or similar sign, including any geographical indication, in the course of trade to distinguish goods or services related to those for which the mark is registered, if this use is likely to cause confusion among the public. This confusion is assumed to occur if the same mark or a mark similar to it is used to distinguish goods or services similar to those for which the mark is registered.

Generally speaking, the right to use a mark includes:

- a) The mark owner's right to affix it on goods, containers, packaging, labels, *etc.*, or to use it in any other way in relation to the goods for which it is registered.
- b) The right to introduce the goods to the market under the trade mark.
- c) The right of the mark owner to use his mark in advertising, on business

(92) Art. (7) the TM Law of Qatar.

(93) For more details on the meaning of bad faith, see Jennifer Davis & Łukasz Zelechowski, *op. cit.*, p.861 et seq.

(94) Art. (22) of the TM Law of Qatar.

(95) *Ibid.*

(96) *Ibid.*

papers, documents, etc.⁹⁷ With regard to the trade mark owner's right to exclude others from using the mark, it allows him to "object to the use of confusingly similar marks in order to prevent consumers and the public in general from being misled"⁽⁹⁸⁾.

Marks grant relative exclusive rights as regards the type of products or services they are used to distinguish⁽⁹⁹⁾, as to the elements which it is consisted of, and finally as to the place in which it is used (unless it is registered according to an international convention or treaty or it is considered a "well-known" mark under the Paris Convention). The exclusive rights of the trade mark owner are infringed by the use in the course of trade of the mark in question by third parties, if done without the consent of this owner.

In accordance with Art.(16) (1) of the TRIPs Agreement, the owner of a registered trade mark is granted the exclusive right to prevent all third parties not having his consent from using in the course of trade identical or similar signs for identical or similar goods or services where such use would result in a likelihood of confusion. The likelihood of confusion is presumed in cases where an identical sign for identical goods or services is used.

It should be noted that if the mark is registered, the registration effect shall be effective from the date of submission of the application⁽¹⁰⁰⁾. Once registration is completed, the owner of the mark shall be given a certificate containing the following information⁽¹⁰¹⁾:

- 1- The trade mark registration number.
- 2- The priority number and date, and the country in which the application was filed, if any.
- 3- The date of submission of the application, the date of registration of the mark, and the date of expiration of the protection term.
- 4- The name, surname, place of residence and nationality of the owner of the mark.
- 5- An identical copy of the mark.

(97) WIPO, WIPO Intellectual Property Handbook: Policy, Law and Use (Geneva: WIPO Publication No. 489(E), 2001) p.82.

(98) Ibid.

(99) Art. 17 of the current TM Law of Qatar.

(100) Ibid.

(101) Ibid.

- 6- A statement of the goods or services for which the mark is allocated, and a statement of their category.

7- Duration of Protection:

A registered mark will be protected for a period of ten years renewable for another period or other periods through renewal applications made by its owner⁽¹⁰²⁾. Protection to start from the date of the filing of the application for registration⁽¹⁰³⁾.

It should be noted that a renewable application should be submitted in the last year of the protection term, taking into consideration the requirements stated in this law and its executive regulations⁽¹⁰⁴⁾. The trade mark owner is entitled to renew the registration of the registered mark within the six months following the expiration of the registration⁽¹⁰⁵⁾. If this period elapses without submitting a renewal application by the trade mark owner, the competent authority shall cancel the trade mark from the register⁽¹⁰⁶⁾. The renewal shall be made without any new examination and shall be announced by means of publication determined by the executive regulations and without taking into account any objection from others⁽¹⁰⁷⁾.

8- Maintaining Registration and Cancellation of Mark Registration on Grounds of Non-Use:

If an application for registration satisfies all the requirements of the law, including that the mark is distinctive and not excluded under the law, the mark will be registered. The registration will last for the specified term and can be renewed indefinitely for further terms of ten years. It is important for the mark owner to maintain the use of his mark to avoid challenges on grounds of non-use⁽¹⁰⁸⁾.

An application for the cancellation of a mark on grounds of non-use may be made if the mark has not been seriously used, either by the owner himself or a third party, for five consecutive years in Qatar⁽¹⁰⁹⁾. It is required that the

(102) Art. (20) of the TM Law of Qatar.

(103) Art. (17) (1) of the TM Law of Qatar.

(104) Ibid., Art. (20) (1).

(105) Ibid., Art. (20) (2).

(106) Ibid., Art. (20) (3).

(107) Ibid., Art. (20) (4).

(108) Ibid., Art. (24).

(109) Ibid.

application be submitted by any concerned party to the competent court and not to the Trade Marks Office⁽¹¹⁰⁾.

The existence of proper reasons will be deemed as blocking the cancellation of registration of marks for non-use. Therefore, the court must, before ordering the cancellation, be convinced that the non-use of the mark did not result from the existence of any obstacles or other proper reasons, such as import restrictions or other government requirements for goods or services protected by the mark in question.

9- Cancellation of the Registration of a Mark by Its Owner:

The Qatari Law entitles owner of a registered mark to request that the mark to be struck off from the registry, whether such a request is about all or some of the good or services for which the mark is registered⁽¹¹¹⁾. Such a request must be submitted to the competent authority in accordance with the conditions and procedures stipulated in the executive regulations⁽¹¹²⁾.

In case of the mark is licensed to be used according to a contract entered in the registry, it may not be struck off except with a written approval of the beneficiary of the license, unless the beneficiary of the license explicitly waives this right⁽¹¹³⁾.

If the mark has been struck off from the register, either by a request of the owner of the mark or by a third party claiming the non-use of the mark, it may not be re-registered for the benefit of a third party for the same goods or services, or for similar goods or services, except after three years have passed from the date of cancellation⁽¹¹⁴⁾. This is unless such a cancellation is based on a ruling from the competent court, and this ruling has set a shorter period for re-registering the mark⁽¹¹⁵⁾.

10- Transfer of Ownership of The Mark, Its Mortgaging, and Its Seizing:

Ownership of a trade mark may be transferred, either wholly or partially, with or without compensation, mortgaged, or seized with the commercial concern or exploitation enterprise whose goods or services the trade mark is

(110) Ibid. Art. (24).

(111) Art. (23) of the TM Law of Qatar.

(112) Ibid., Art. (23).

(113) Ibid.

(114) Ibid., Art. (25).

(115) Ibid.

used to distinguish, unless otherwise agreed upon⁽¹¹⁶⁾.

It is also permissible to transfer the ownership of a trade mark by inheritance, will, or gift⁽¹¹⁷⁾. In all cases, transferring, mortgaging, or seizing ownership of a trade mark shall not be considered proof against third party unless it is entered into the trade mark registry and published by any means of publication specified by the executive regulations⁽¹¹⁸⁾.

It is worthy noting that the transfer of ownership of the commercial concern or the exploitation enterprise include the registered trade marks under the name of the transferee, which can be considered closely related to the commercial concern or the enterprise, unless agreed otherwise⁽¹¹⁹⁾. Furthermore, if the ownership of the commercial concern or the enterprise is transferred without transferring the ownership of the trade mark itself, the transferee may continue to manufacture the same goods or provide the same services for which the trade mark was registered, or trade in them, unless agreed otherwise⁽¹²⁰⁾.

11- Licensing of Marks:

Under the TRIPs Agreement, WTO Members are permitted to license and assign trade marks⁽¹²¹⁾. This means that trade mark owners have the right to grant permission (license) to others to use their trade mark, and they can also transfer (assign) their ownership of the trade mark to another party. This provision helps facilitate business transactions and the commercial exploitation of trade marks across borders.

Furthermore, the TRIPs Agreement allows WTO Members to establish their own rules and regulations regarding the conditions of licensing and assignment of trade marks⁽¹²²⁾. This means that each member country can determine the terms under which trade marks can be licensed or assigned within their jurisdiction. These conditions may include factors such as the

(116) Ibid., Art. (27).

(117) Ibid. It was recently ruled that the transfer of the trade mark ownership requires, as a general rule- a written assignment before the competent authority. However, in case of the transfer of the ownership of the business itself, its merger with another, or its inheritance, the trade mark ownership is transferred directly with the business without the need for a written assignment. The Court of Cassation of Qatar- Civil Cassation- Session on January 19, 2021, Appeals No.509 and 515 of 2020.

(118) Ibid.

(119) Ibid., Art. 28.

(120) Ibid.

(121) Art.21 of TRIPs.

(122) Ibid.

duration of the license or assignment, the scope of the rights granted, and any restrictions or limitations imposed on the use of the trade mark by the licensee or assignee.

However, other fundamental provisions of the TRIPs Agreement should be taken into account, namely Art. (20). This Article aims to ensure that the use of trade marks is not encumbered in an unjustifiable manner, thereby safeguarding the rights of trade mark owners. It prohibits certain types of requirements or conditions that may hinder the effective use of trade marks in trade. These include:

- i) Use of a trade mark with another: This signifies restrictions or requirements that force the owners of a trade mark to use their mark in conjunction with another trade mark or element, which may unnecessarily limit their ability to distinguish their goods or services.
- ii) Use in a special form: This disallows requirements that mandate the use of a trade mark in a specific format, style, or presentation that is different from the customary or usual form of the trade mark. Such requirements could hinder the trade mark owner's ability to effectively use their mark in the course of the trade.
- iii) use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings: This prohibits conditions or restrictions that would undermine the distinctive character of a trade mark, making it less effective in distinguishing the goods or services of one business from those of others. This could include requirements that dilute the distinctiveness of the mark or diminish its recognition among consumers.

By disallowing such types of requirements, Article 20 of the TRIPs aims to ensure that trade mark owners have the freedom to use their marks effectively in trade, without unnecessary burdens or impediments imposed by regulations or conditions that could undermine the value or effectiveness of their trade marks.

The Qatari law grants an owner of a mark a right to license the use of the mark to a natural or judicial person.⁽¹²³⁾ Under the law, a licence agreement may be general or limited to all or some of the services or products onto which the mark is registered.⁽¹²⁴⁾ The owner of the mark is to have the right

(123) Art. (29) of TM Law of Qatar.

(124) Ibid.

to grant licences for the exploitation (use) of the mark and to continue to use it himself, unless agreed otherwise in the licence agreement⁽¹²⁵⁾. Duration of licence agreement may not be longer than the protection of the mark⁽¹²⁶⁾.

The licence agreement must be in writing⁽¹²⁷⁾ and must be signed by the parties in order to be valid. It is not required to record it in the registry. However, if recorded, the Executive Regulations is to specify the method of recording and announcement⁽¹²⁸⁾.

The licensee cannot be subjected to restrictions that are not inherent in the rights granted by the trade mark registration or unnecessary for the preservation of these rights⁽¹²⁹⁾.

However, the licensing contract may include the following restrictions⁽¹³⁰⁾:

- 1- Defining the geographical scope or duration of trade mark use.
- 2- Conditions required for effective quality control of goods or services.
- 3- Obligations imposed on the licensee to refrain from any activities that may result in harm to the trade mark.

The licensee may not assign it to others or grant sublicenses without agreement to the contrary⁽¹³¹⁾.

The owner of it is required to exercise continuous control on the licensee as regards the goods and services in connection with which the mark is used⁽¹³²⁾.

The recordation of the license agreement is removed from the registry upon the request of the trade mark owner or the licensee after providing evidence of the termination or cancellation of the license agreement. The removal is not carried out until the other party is notified of the request for removal, and they have the right to object to it according to the procedures specified in the executive regulations⁽¹³³⁾.

(125) Ibid.

(126) Ibid.

(127) Ibid. Art. (31).

(128) Ibid. Art. (31).

(129) Ibid. Art. (30) (1).

(130) Ibid. Art. (30) (2).

(131) Ibid., Art. (32).

(132) Ibid.

(133) Ibid., Art. (33).

The TRIPs Agreement expressly prohibits the use of compulsory licensing of trade marks. As a result of this Article, the trade mark is the only category of all categories relating to IP included in the TRIPs Agreement that is expressly excluded from compulsory licensing⁽¹³⁴⁾. The reason why compulsory licensing of trade mark is excluded seems to be obvious. That is due to the main objective of trade mark that is to distinguish the products or services of one undertaking from the others'. Therefore, if it is used without the consent of the owner, it might mislead the public as to the origin and the quality of the products⁽¹³⁵⁾. This, of course, applies to Qatar even though there is no provision for such a prohibition since it is required to observe the rules and obligations of the TRIPs Agreement.

12- Conclusion:

The paper addresses a significant issue: the protection of trademarks in Qatar. A trade mark serves as a straightforward mechanism for producers and merchants to communicate the quality and origin of their products to consumers. As a result, producers and merchants often invest substantial resources in building their reputation and promoting their trade marks and other distinctive identifiers. This investment grants them the exclusive right to use these marks. However, if other producers or merchants misuse these trade marks or sell associated products at lower prices, it can undermine the original producers' and merchants' efforts, resulting in reduced returns on their investments⁽¹³⁶⁾.

Additionally, consumers benefit significantly from trade mark protection as it reduces the effort and time required to search for products by eliminating confusion in identifying them. This reduction in search costs is considered the "greatest social advantage" of trade mark protection⁽¹³⁷⁾.

As I stated in a previous research paper, "the rules and regulations contained in the Trade Marks Law (Law No.9 of 2002) represented a step forward in the direction of implementing the standards of protection concerning trade marks as set out in the TRIPs Agreement. These have led to— it is submitted—improved protection in Qatar and other WTO Members. For example, the Agreement extended the provisions of the Paris Convention on the protection

(134) Kur, op. cit., at 114

(135) Ibid.

(136) United Nations Conference on Trade and Development (UNCTAD), The TRIPs Agreement and Developing Countries (New York: United Nations Publications, 1996, p.42.

(137) Ibid.

of well-known marks to service marks and to situations of dilution by the use for dissimilar goods and services if the interests of the owner would be damaged.”⁽¹³⁸⁾.

Furthermore, I stated that “the drafters of the Law, however, missed exploiting the opportunity to have a modern trade marks law. It is without doubt to admit that the minimal content of the law lags behind the new developments in this field. It lacks, among other things, a modern definition of marks, provisions detailing absolute and relative grounds for refusal of registration, provisions setting in full detail the exclusive rights conferred by a registered mark, statements clarifying the activities that can amount to infringements to a registered mark, and provisions defining limitations on the effect of a registered mark”⁽¹³⁹⁾.

However, the current law (GCC Trade Mark Law) addresses several of the previously mentioned concerns. For instance, it provides a definition of a trademark that aligns with modern legal developments in most countries. Additionally, it includes a comprehensive list of signs that are ineligible for registration as trademarks or as part thereof. Notably, the law effectively addresses the protection of well-known marks. These provisions are consistent with the prevailing regulations in numerous jurisdictions.

In broad terms, the updated provisions are advantageous for both Qatari producers and traders. Furthermore, they, along with non-Qatari merchants, benefit from the protections outlined in the TRIPs Agreement, particularly through the full enforcement of procedures designed to combat the trade of counterfeit goods among WTO Members.

(138) Mohamed Salem Abou El Farag, op. cit., p.123.

(139) Ibid., p.124. These notes are inspired by the UK 1994 TMA and the TM Directive.

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