

The Trademark Act of the Member States of the Cooperation Council for the Arab States of the Gulf

Title I:

Definitions

Article 1: Definitions

In the implementation of the provisions of this Act, the following terms shall have the meanings assigned to each hereunder unless otherwise provided by context:

GCC States: The Member States of the Cooperation Council for the Arab States of the Gulf

Competent Authority: The Ministry in the member state with jurisdiction over trade and mandate to implement this Act.

Minister: The Minister in charge of implementing the provisions of this Act.

Executive Regulations: The regulations issued by the Trade Cooperation Committee in implementation of this Act.

The Register: The Trademark Register.

Article 2

Trademark: A trademark is any name, word, signature, letter, number, address, seal, drawing, picture, inscription, symbol, packaging, pictorial element, figure, one color or more, or a combination thereof, or sign or a group of signs that are used or intended for use to distinguish goods or services resulting from the goods or services of other firms, or to indicate, or to render a service or to indicate that control or inspection has been carried out on goods or services.

A trademark associated with a sound or smell shall be considered as Trademark.

Title II: Procedures

Chapter 1: Procedures of Registration of Trademarks

Article 3

None of the following shall be considered or registered as a trademark or part thereof:

- 1- Marks devoid of any distinctive characteristic or formed of data which is merely nomenclatures given by the established usage of the goods, services, drawings or the natural figures of the goods.
- 2- Expressions, drawings or signs that contravene with public morals or order.
3. Public slogans, flags, military and honorary decorations and other national or otherwise foreign insignia, coins and banknotes and other symbols of a GCC State or any other state, Arab or international organization or any affiliate institutions or any imitation of any of the aforementioned.
- 4- Logos of the Red Crescent or Red Cross and such other similar symbols and the marks being an imitation thereof
- 5- Marks that are identical or similar to symbols of a purely religious character.
- 6- Geographical names and data, should their use create confusion with regard to the origin or source of goods or services.
7. The name, title, picture or logo of a third party unless he or his heirs approve its use beforehand.
- 8- Particulars of honorary and scientific degrees to which the applicant fails to prove his legal entitlement.
9. Marks that may mislead the public or include false statements on the origin or source of goods or services or their other properties as well as the marks that include a fictitious, imitated or forged trade name.
- 10- Marks owned by natural persons or legal entities with whom it is prohibited to deal in accordance with a decision from the Competent Authority.
- 11- Any mark identical or similar to a mark that has been registered or filed by third parties in respect of the same or similar goods or services should the intended registration of the new mark create an impression of its affiliation with the goods and services of the owner of the registered trademark to the detriment of his interests.
- 12- Marks whose registration in respect of some goods or services may devalue the goods or services of a previously registered trademark.
- 13- The marks deemed as just a copy, imitation or translation of a third party's well-known mark or a part thereof with intent to use such marks to distinguish such goods

or services that are identical or similar to those distinguished by the well-known trademark.

14- The marks deemed as just a copy, imitation or translation of a third party's well-known mark or a part thereof with intent to use such marks to distinguish such goods or services that are neither identical nor similar to those distinguished by the well-known trademark but raise the likelihood of bringing harm to the interest of the well-known trademark's owner.

15- Marks that include any of the following words or expressions:

Concession, Concessionaire, Registered, Registered Drawing, Copyright, or any such similar words and expressions.

Article 4

1- No well-known trademark whose fame transcend the boundaries of their first country of registration may not be registered for the same or similar goods or services except if such an application is made by or with the explicit consent of the owner of such well-known trademark.

2- The criterion for determining whether or not a trademark is well-known shall consider the awareness of the intended public of such a trademark in light of its promotion, registration period, use, number of countries where it is registered or where it became well-known, its value or the impact of such a mark on the promotion of the goods or services in respect of which the trademark is used.

3- Well-known trademarks may not be registered even if the distinguished goods or services are not identical or similar to those belonging to the well-known trademark if:

a. The use of the trademark indicated an association between the subject goods or services and those belonging to the owner of the well-known trademark.

b. The use of the trademark has the potential of prejudicing the interests of the owner of the well-known trademark.

Article 5

The following categories of applicants shall have the right to register their trademarks:

- 1- Any natural or legal person holding the nationality of any GCC State, whether such a person is a manufacturer, producer, merchant professional or a service enterprise owner.
2. Foreign persons residing in any GCC State wherein they are authorized to engage in commercial, industrial, professional or service business activities.
- 3- Foreigners holding the nationality of any state that is a member to a multilateral international convention to which a GCC State is a party or any residents therein.
4. Public authorities.

Article 6

1. A register shall be established with the Competent Authority and shall be called the "Trade Marks Register", which shall record all trademarks, names and addresses of their owners, particulars of goods or services, any action affected on such trademarks including assignment, licensing, mortgage, renewal, cancellation of any other amendments thereto. Any person with a rightful interest may peruse the Register and obtain certified extracts therefrom.
2. The trademark register in use at the time this Act enters into force shall be merged with the Trademark Register provided for hereabove and shall be considered as a part and parcel thereof.

Article 7

- 1- Any person who registered the trademark with good intentions shall be its owner. The ownership of the mark may not be disputed as long as the mark registration is associated with its use for at least five years without any judicial feuds pertaining the mark.
- 2- Any person first using a trademark before the owner may request the competent court to cancel this registration within five years as of the date of registration, unless the first has been proven to have given an implied or explicit consent to the use of the mark by the registered owner.

Article 8

An application for a trademark shall be filed by or on behalf of the owner with the competent authority on a special form designed for this purpose, subject to the terms and conditions prescribed by the Executive Regulations of this Act.

Article 9

1. A trademark may be registered for one or more of the classes of goods or services, subject to the Executive Regulations of this Act.

2- Goods or Services are not envisaged similar to each other merely because they are under the same class nor the goods or services are considered different to each other merely because they are under different classes of the same classification

Article (10):

If two or more persons concurrently apply to register the same or similar mark(s) for goods or services in the same class , the registration of all applications shall be suspended until one party submits an attested assignment signed by all adversaries and thus ratified by the competent authority, or until a final court decision is rendered in favor of any of them.

Article 14

1- Should the competent authority accept a trademark application, it shall, before entering it in the Register, publish a relevant notice of registration through the means of publication defined by the Executive Regulations of this Act at the cost of the applicant.

2- Any concerned person may oppose in writing at the competent authority to the decision of the registration within sixty days of the publication thereof. In such a case, the Competent Authority shall serve a copy of the objection upon the applicant within thirty days of the date of the objection, after which the applicant shall submit an answer with the Competent Authority in writing within sixty days of the notification date, or else he shall be deemed to have withdrawn the application.

Article 15

1- The Competent Authority shall decide the opposition filed therewith after hearing the opposing party and/or the applicant if necessary.

2- The Competent Authority shall issue a decision to accept or otherwise decline the registration application in the former case of which it may impose any restrictions it deems fit.

3. Any concerned party may appeal the decision of the Competent Authority before the competent court within thirty days from the notification date. Such an appeal shall not preclude the process of accepting the trademark registration unless otherwise decided by the competent court.

Article 16

If no opposition has been filed against the registration of trademark after the lapse of the opposition period, the competent authority shall immediately register the said trademark.

Article 19

The Competent Authority may enter into the Register any data that may have been overlooked and likewise may amend or cross out any data that have been proven to be false or not duly entered therein.

Any concerned person may appeal to the competent court any such relevant procedural action made by the Competent Authority.

Chapter 2: Period of Trademark Protection

Article 20

1- The protection period of a registered trademark is ten years. It may be renewed for similar periods thereafter if the owner submitted an application for that purpose in accordance with terms and conditions prescribed by this Act and the Executive Regulations hereof.

2- A trademark owner may renew a registered trademark within a period of six months following the expiration of the antecedent period.

3- If the prescribed six-month period expires and the trademark owner fails to apply for renewal, the Competent Authority shall strike off the relevant trademark from the Register.

4- The renewal of a trademark shall not require a new inspection and a renewal notice shall be published through such media prescribed by the Executive Regulations irrespective of any opposition that may have been filed by third parties.

Article (21):

Subject to the registration requirements herein, the marks affixed to goods displayed at official international exhibitions or officially recognized exhibitions held inside the State shall enjoy temporary protection. The protection shall be given throughout the display period subject to the registration terms and conditions stipulated in this law. The Executive Regulations shall define the rules and procedures for granting such a temporary protection.

Chapter 4: Assignment, mortgage and seizure of trademarks

Article 27:

1. A trademark may be assigned fully or partially for or without consideration. It may also be subject to mortgage or seizure along with the trading store or enterprise using such a trademark in marking its goods or services, unless otherwise agreed.
- 2- Title to trademarks may be transferred to third parties by inheritance, testament or endowment.
3. Under no circumstances may the assignment, mortgage or seizure of trademarks be effective vis-a-vis third parties except after such actions are annotated in the Trademark Register and published through the means of publication defined by the Executive Regulations of this Act.

Article 28:

1. The assignment of the commercial store or enterprise in which the trademark is used shall imply the assignment of such a trademark if deemed closely affiliated with such commercial store or enterprise, unless otherwise agreed.
2. If the ownership of the commercial store or enterprise is assigned exclusive of the ownership of the trademark, the assigner shall have the right to continue to manufacture the same goods or render the same services for which the trademark has been registered and trade in such goods and services, unless otherwise agreed.

Title III: Licensing contracts

Article 29:

The owner of a trademark may license any natural or legal person to use such trademark in respect of all or part of the goods and services for which the trademark is registered. The trademark owner shall have the right to license other persons to use the same trademark and may opt for using it himself unless otherwise agreed. The licensing period shall not exceed the prescribed protection period of the trademark.

Article 30

No restrictions may be imposed on the licensee if such restrictions do not arise from the rights granted by the trademark registration or if they are not necessary for the protection of such rights.

Notwithstanding, a license contract may impose the following restrictions:

1. Restrict the geographical area or period through which the trademark may be used.
2. Impose terms and conditions in compliance with effective controls applicable to the quality of goods and services.
3. Impose on the licensee the obligation of refraining from such acts that may bring harm to the trademark.

Article 31:

The trademark licensing contract shall not be deemed effective unless it is executed in writing. The licensing contract is not required to be recorded in the Register. If such a contract is not recorded in the Register, the Executive Regulations shall define the manner through which the recordal and publication thereof shall be made.

Article 32

The licensee may not assign the licensed rights to third parties nor may subcontract any of such rights unless otherwise is agreed.

Article 33:

The license's contract shall be struck off from the Register upon a request from the trademark owner or licensee after producing evidence of the expiration or termination of such a contract.

The Competent Authority may not strike off a license record unless and after it notifies the other party of such an action, in which case the other party may appeal in accordance with the procedures prescribed by the Executive Regulations.

Title IV: Collective trademarks, certification marks and marks allocated for public bodies or professional institutions.**Article 34:**

1- Collective marks may be registered to distinguish the goods and services of enterprises belonging to members of a legal entity.

The registration of such marks shall be filed by the representative of such entity so that it can be used by the members thereto subject to the conditions and manners he prescribes and the approval of the Competent Authority.

2- An applicant for a collective mark application shall state in the application form that the registered mark is collective and shall attach to the form a copy of the terms and conditions governing the use of the filed trademark.

Under all circumstances, the owner of a registered collective trademark shall notify the Competent Authority of any changes that may affect such terms and conditions. Such a change shall not be effective unless approved by the Competent Authority.

3- After cancellation, a collective trademark may not be registered in the name of a third party in respect of similar or identical goods or services.

4. The competent court upon a request for persons concerned may issue an order to cancel a collective trademark if it establishes that the registered proprietor is the sole user thereof or that he is using or permitting third parties to use it in contradiction to the terms and conditions referred to in Paragraph (2) above or is using it in a way that may mislead the public regarding the origin of the goods or a common feature of the goods or services registered thereunder.

Article 35:

1- Legal entities in charge of controlling or inspecting some goods or services in terms of origin composition, method of manufacturing, quality, integrity or other such characteristic may request the Competent Authority to register a trademark specially for such entities to reflect their monitoring or inspection services.

In all events, such a trademark may not be registered or assigned except with the approval of the Competent Authority.

2- The applicant of a collective mark application shall state in the application form that the registered mark is collective and shall attach to the form a copy of the terms and conditions governing the use of the filed trademark.

Under all circumstances, the owner of a registered trademark shall notify the Competent Authority of any changes that may affect such terms and conditions. Such a change shall not be effective unless approved by the Competent Authority.

Article 36:

Trademarks may be registered for non-commercial purposes such as the logos of public utility institutions or those used by professional institutions to mark their respective correspondences or members.

Article 37:

1- Signs that can be used in the trade context as geographical indicators may be registered as certification or collective trademarks.

2- The Executive Regulations shall define the terms and conditions for the registration of trademarks provided for in Articles 34, 35 and 36 of this Act along with the exhibits that shall be produced for registration purposes and all such matter pertaining thereto. The registration of any such trademarks shall incur all effects stipulated in this Act.

Title V: Enforcement of rights**Article 38:**

1- If a right holder has justifiable reasons to believe of the possibility of importation of imitated or counterfeit goods or otherwise goods that hold a trademark similar to his own registered trademark in a manner that confuses the public, he shall have the

right to file a written petition with the authority in charge of customs release to suspend such goods from release and prevent the trading thereof.

The petition shall be supported by evidence adequate for convincing the said authority of a prime facie infringement of the trademark right holder. It shall also include adequate information reasonably available with the petitioner to allow the said authority to reasonably detect the subject petition goods.

2- The custom release authority shall notify the petitioner in writing of its decision on his petition within seven days from the petition date. If the petition is granted, the decision shall be valid for one year from the date of the petition or until the expiration of the trademark protection, whichever expires first, unless the petition requires a shorter time.

3- The custom release authority may require the petitioner to submit a warranty or equivalent guarantee that is sufficient to protect the respondent and the competent authority and to avoid abusing the right to petition for the suspension of custom release.

4- Without detriment to the above provisions, the custom release authority may, of own motion without the need for the right holder or a third party to submit a petition or application, decide to suspend the release of imported or transit goods or the goods prepared for re-export upon their arrival to the custom territory under its jurisdiction, if it has adequate rime facie evidence that such goods are imitated or illegally hold a trademark similar to a registered trademark to the extent that it confuses the public.

8- The Minister of Finance, after coordinating with the Minister, shall issue a decision prescribing the conditions, controls and procedures pertaining to petitions for the suspension of custom releases, the decision to be taken thereon and documentation requirements. Nevertheless, such requirements shall not be set in a manner that impedes recourse to the aforementioned petition.

For the purposes of this article, the phrase “imitated goods” shall mean any goods, including the packages thereof, that hold without license a trademark that is similar to another trademark registered in respect of the same goods or that has such intrinsic elements making it impossible to distinguish it from the registered trademark.

Article 39:

The provisions of Article 38 of this law shall not apply to any of the following:

- a. non-commercial items in small quantities that are found among the belongings of passengers or that are sent in small parcels.
- b. goods that have already been traded in the market of the exporting country by the holder of the trademark right or with his consent.

Article 40:

1. In cases of infringement or for the prevention of imminent infringement on any of the rights prescribed by this Act, the right holder may submit a petition to the competent court on the subject dispute requesting a writ for the enforcement of one or more preventive actions including the following:

- a. provide a detailed description of the alleged infringement, the subject infringement goods and such material, tools and equipment used or intended to be used in the infringement and preserve relevant evidence.
- b. seize any of the things mentioned in the above paragraph along with any proceeds made from the alleged infringement.
- c. prevent the alleged subject infringement goods from accessing commercial channels and prevent its exportation including the imported goods upon their custom release.
- d. stop or prevent the infringement

2- The court may require that the petitioner submit all the evidence that he has to support the alleged infringement of the right or to prove that the infringement is about to happen. It may also require him to submit any information that is deemed necessary for the competent authority to enforce the precautionary action sought by identifying the concerned goods.

3- The court shall decide the petition within a maximum period of ten days from the date of the petition unless in extraordinary cases, subject to the court's discretion.

4- The court may issue if necessary a writ upon the petitioner's request without the need to summon the other party if the delay in issuing such a writ will likely result in causing the petitioner an inescapable harm or in case of fear of disappearance or destruction of the evidence. In this case, the other party shall be forthwith notified of the writ upon its issuance. If necessary, the notification may be made immediately after the enforcement of the writ.

5- If the court decides to take a precautionary measure without summoning the other party, the respondent may after being notified of the matter challenge the order before the competent court without twenty days from the notification date. In such a case, the court may decide to uphold, amend or strike down the writ.

6- The court may require the petitioner to submit a warranty or equivalent guarantee that is sufficient to protect the respondent and to avoid abusing the right to petition. Nevertheless, the value of such guarantee shall not be too large with the effect of unreasonably inhibiting the right to request the enforcement of the above mentioned precautionary measures.

7- The right holder may file the case on the origin of the dispute within twenty days from the date of the writ for precautionary measure or from the date of notification of rejecting the appeal prescribed in Paragraph (5) of this article. Failure to comply with this provision shall render the writ revoked upon the request of the respondent.

Article 41:

2- If the right holder sustains harm as a direct result of infringement on any of his rights prescribed by this Act, he may bring action with the competent court to claim adequate compensatory damages that may have afflicted him including any profits gained by the respondent.

The court shall determine what constitutes sufficient damages provided that it shall consider in their calculation the value of the subject infringement goods or service in light of such information provided by the complainant such as the retail price, any other legitimate standard he may invoke or expert testimony.

2- Instead of claiming damages, including any profits gained by the offender in accordance with the above paragraph, the right holder may request at any time before the case is decided to be appropriately compensated if it is proven that the infringement was perpetrated by using the trademark by offering a deliberate imitation or other form of the usage of the goods.

3- On deciding cases related to the rights prescribed by this Act, the competent court may order the following:

a. seize the goods that are suspected of involving infringement and any such material or tools and evidence related thereto.

b. force the offender to stop the infringement, prevent the exportation of such goods that infringe upon the rights prescribed in this Act and prevent the imported

infringing goods from entering the commercial channels directly upon their custom release.

c. force the offender to furnish the competent court or the right holder any information at hands in relation to any person or entity that took part in committing the infringement, the ways of producing and distributing such goods and services including the disclosure of the identify of any person who was involved in the production or distribution of the goods and services and his own channels of distribution.

4- The competent court, upon the request of the right holder, shall order the destruction of the goods proven to be imitation, except in extraordinary cases, without awarding any compensation or damages to the respondent. It may also order without delay the destruction of such material and tools used in the manufacturing or production of the imitated goods without awarding any compensation or damages to the respondent. The court may furthermore, in such cases it deems exceptional according to its sole discretion, dispose of such goods outside the commercial channels in a manner that shall prevent any further possible infringements.

As an alternative to the destruction of goods, material and tools used in the manufacturing of production of the imitated goods, the court may order to dispose of such goods, material and tools outside the commercial channels, should the destruction thereof be deemed to result in unacceptable damages to public health or the environment.

5- The removal of the trademark that was illegally placed on the imitated goods shall not count alone as adequate grounds for the release thereof into commercial channels.

6- The competent court shall estimate the expenses and fees of those whom it commissions in relation to the case including experts and specialized persons. The fees and expenses shall be commensurate with the size and nature of the assignment of the commissioned persons in a manner that does not preclude resort to such procedures.

Article 43

In the case of repeat offenses, the offender shall be punished by a maximum of double the original penalty. The business place or enterprise shall also be closed down for a period not less than fifteen days but not exceeding six months and the

relevant sentence shall be published at the expense of the offender in accordance with such procedures defined by the Executive Regulations.

In implementing the provisions of this Act, a repeat offender is one who has been sentenced on the grounds of an offense stipulated herein and repeats another similar offense within a period of three years from the date of the final verdict delivered on the previous offence.

Article 44:

The respondent may pursue damages from claims lodged by an ill-intended complainant as a result of invoking the procedures prescribed in Article 40 of this Act. Such an action may be taken within ninety days of the expiration of the period prescribed in that same article, if the garnishor has not revoked his claim, or from the date of the final decision on the garnishor's claim on the trademark. Except where otherwise is stipulated in the court decision, the financial guarantee may not be released to the garnishor unless a final decision is issued by convicting the garnishee or after the lapse of the grace period given for the lodging the case.

Title VII: Closing Provisions:

Article 45

Officers in charge of implementing the provisions of this Act and any decisions issued thereby designated by a decision following the procedures of each GCC State shall have the judicial police status, and as such shall have the right to access any places falling under their jurisdiction in the context of implementing this Act and for the purpose of handling violations.

The Competent Authorities shall afford such officers the facilities required for the performance of their tasks.

Article 46

The Competent Authority may establish a publically accessible electronic system and database including an internet portal offering such services as trademark filing and renewal applications and following up and completion of the requirements for trademark registration.

Article 47

All trademarks previously registered in accordance with effective laws, decisions or bylaws before this Act enters into effect shall be deemed as valid and shall enjoy the same protection afforded herein.

Article 48

The provisions of this Act shall apply to all pending trademark applications filed before this Act enters into force, provided that such pending applications shall be amended so as to comply with the provisions of this Act.

Article 49

Nothing in this law shall prejudice any controls or obligations enshrined by bilateral and international conventions in force in respective the GCC State.

Article 50

The Executive Regulations shall define the fees to be charged for the procedures stipulated in this Act and the Executive Regulations.

Article 51

The Commercial Cooperation Committee shall have the right to construct or propose and amendment to this Act.

Article 52

The Commercial Cooperation Committee shall issue the Executive Regulations of this Act.