DOCTORAL (Ph.D.) DISSERTATION

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THE IMPACT of TRADEMARK USE & REGISTRATION in JORDANIAN, EU & INTERNATIONAL LAW

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Acknowledgment

While I was discomposed to completing this dissertation as the most challenging academic step, several people inspired me. They paved the way for me to achieve this mission. I want to give warm thanks to those who indicated their excellent assistance. At the outset, I would like to show my warm appreciation to my family members whose encouragement and support always motivated me during my study journey. My supervisor, Dr. Zsolt Hajnal, who guided me and constantly corresponded with me to accomplish my dissertation correctly, deserves praise. I would also like to thank the Secretary of the Doctoral School, Dr. Márton Leó Zaccaria, for his cooperation and prompt answers to our inquiries.

Nyilatkozat

Alulírott, **Mohammad Abdulmahdi Alfaouri**, büntetőjogi felelősségem tudatában kijelentem, hogy a Debreceni Egyetem Marton Géza Állam - és Jogtudományi Doktori Iskolában a doktori fokozat megszerzése céljából benyújtott, ***THE IMPACT of TRADEMARK USE & REGISTRATION in JORDANIAN , EU & INTERNATIONAL LAW*** című értekezésem saját önálló munkám, a benne található, másoktól származó gondolatok és adatok eredeti lelőhelyét a hivatkozásokban (lábjegyzetekben), az irodalomjegyzékben, illetve a felhasznált források között hiánytalanul feltüntettem.

Kijelentem, hogy a benyújtott értekezéssel azonos tartalmú értekezést más egytemen nem nyújtottam be tudományos fokozat megszerzése céljából.

Tudomásul veszem, hogy amennyiben részben vagy egészben sajátomként mutatom be más szellemi alkotását, vagy az értekezésben hamis, esetleg hamisított adatokat használok, és ezzel a doktori ügyben eljáró testületet vagy személyt megtévesztem vagy tévedésben tartom, a megítélt doktori fokozat visszavonható, a jogerős visszavonó határozatot az egyetem nyilvánosságra hozza.

Debrecen, July 20, 2023

Aláírás

Recommendation

Student: Mohammad Abdulmahdi Alfaouri
Title: THE IMPACT of TRADEMARK USE & REGISTRATION in JORDANIAN, EU & INTERNATIONAL LAW

Mohammad Alfauri started her studies four years ago in the frame of the LLM course. Since his successful application to the doctorate studies, he has focused on the chosen current topic. During his studies, he regularly consulted, built up the structure and the agenda of the research and the dissertation, and passed all the requirements of the Doctorate School. This long and fruitful period has resulted in the application for the workplace defense of his dissertation.

This dissertation focuses on protecting registered and unregistered trademarks and their legal framework, as well as the relevance and role of trademark protection in developing countries as a critical element for FDI. He identifies the need to shed light on the applicable law in case of an unregistered trademark, the need to identify the stand of the Jordanian legislator, and comparative legislation on the infringements made against trademark-related rights. This study offers results and suggestions for the contemporary problems facing trademarks and answers to the questions below.

Q1 Did Jordanian legislators consider registering or using a trademark essential to protect it? What are the shortcomings of various laws on protecting trademarks in Jordan?

Q2 Did the Jordan Trademark Act protect the rights of consumers?

Q3 Did the Jordan legislator impose compensation on the trademark infringer or forger deterrent to prevent the infringement internationally and nationally level?

Q4 Did Jordan's legislator address the case of the infringement repeating of the protected rights?

Q5 To what extent does Jordan law protect the famous mark?

Q6: did the Jordanian legislator treat the situation where the trademark was violated but not used within the Jordanian territory? In that case, whether the goods concerned with trademark violation were re-exported to be used outside the Jordanian

Q7 Did CJEU fix the coexistence of unregistered local rights with later registered national trademarks?

Q8 Did the US Code establish the legal grounds for initiating a case in a civil court to address accusations of deceptive labeling and misleading advertising related to unregistered trademarks?

Q9 Did the dilution principle enhance the protection of trademarks for widely recognized brands?

Q10 IF trademarks are in use and not registered. What sort of protection is afforded at the EU level to such non-registered trademarks if an alleged similar trademark is registered or applied for?

Q11: Could we consider the attributive system as a particular way of manifesting the declarative system?

Q13:Did Sharia law protect intellectual property rights early?

As in the Introductory chapter, the author discusses and analyzes Jordanian law, its purpose, research questions, objectives, hypotheses, problem statement, methodology, and dissertation structure. It also provides an overview of the research methodology. Besides its amylase why the author chose Jordan law to be a part of this comparative study.

The author investigates trademark legal concepts in the first chapter, as well as trademark framework, concepts, rights, theories, and doctrine positions investigating the EU, domestic laws, and the doctrine's position on trademarks. Moreover, the author has left some issues for discussion, such as famous and domestic trademarks and whether a well-known trademark is the same renowned trademark mentioned in the legal literature and international

agreements such as the Trips Agreement and the Paris Convention. The author also sheds light on the development of Jordan trademarks-related laws. For instance, the old text law did not define trademarks broadly.

. The author investigated both Josef Kohler's theory of intangible assets, and Eugen Ulmer's theory, and the concept of confusion functioning. The chapter also discusses the probability of confusion, its function, and the EUTMR's double identity. It also discusses the likelihood of confusion, its relationship with the similarity of goods, services, and signs, and the criteria for determining the goodwill of a mark. The chapter also covers trademark forms, including names, letters, numbers, symbols, pictures, inscriptions, and drawings.

In Chapter 2 on trademark types, the author discusses the distinction between a well-known and famous mark, their protection, and the reasons behind their refusal. The guide covers the United States, Australia, China, and Japan as examples, and the distinction between "well-known" and "famous" marks. It also covers the registration, real use, and protection of well-known and famous trademarks in different countries, such as the EU, the UK, and France. The author also discusses the concept of a "reputed mark" and its relevance to the public. moreover, the author highlights the importance of a reputed mark in the trademark industry and discusses the importance of a well-known mark in the public's perception and the potential for trademark disputes.

In Chapter 3, the author discusses nontraditional trademarks in the European Union the US, and Jordan including phonetically pronounceable, color-based, shape mark, and black and white marks. The chapter also analyzed the reasons for trademark refusal, including lack of distinctiveness, moreover, the author investigated Jordan's trademark law, JTML, and if it could harmonized with non-traditional trademarks and the relation with prohibited trademarks. The chapter provides a comprehensive overview of these trademark laws.

In chapter 4 “Trademark Registration”, the author discusses trademark registration systems, objectives, and procedural conditions. Besides the Objectives include legality, distinctiveness, novelty, and visual perceptibility. Procedures include trademark registration in Jordan and the EU, a deposit system, and expiration under the principle of exhaustion of trademark rights.

In, Chapter 5, the author discusses trademark usage in the EU, non-traditional trademarks, and trademark abandonment concepts. Besides that, the author sheds light on implicit abandonment, and retirement from trade and industry, and analyzes trademark use nonopposition. Furthermore, the author also covers trademark use in Jordan besides the legal concept of non-use, including the non-use of judicial and legal positions.

Chapter 6 discusses using earlier non-registered trademarks in opposition or infringement proceedings under the EU Trademarks Regulations besides the Benelux Convention. Moreover, this chapter covers legal regulations, business activities, national law, 'earlier rights', passing-off rules, enforcement authority, and the extent of protection. It also sheds light on the coexistence of unregistered local rights with later national trademarks.

Chapter 7 “Unregistered Trademarks by International Law: American Law as an example, the author discusses unregistered trademarks by international law, including American law. It covers the Paris Convention, the TRIPs Agreement, and American federal legislation. In this context, the author discusses deeply how Unregistered trademarks are continuously safeguarded and offer some advantages, the author also analyzes the relationship between dilution and others, including famous marks, suggestive marks, descriptive marks, fanciful marks, arbitrary marks, and digital trademarks. Moreover, the author also discusses the practical principle and case study of infringement, such as using a

trademark to indicate product origin, the registration of immoral or scandalous trademarks, the mental association between a junior user's mark and a recognized mark, and the functional nature of product features.

As for Chapter 8 Bad Faith Matters, In this Chapter, the author analyzed the bad role in determining trademark infringement and protecting trademark rights. To this point, the author took a peek into classifications and definitions of bad faith and investigated bad faith as an unequivocal reason for rejection. Moreover, the author studies the application for an EU Trademark (EUTM and Application submitted with malicious intent. To this point, the author took into consideration the Impact of the BTA Directive Initially Generally, bad faith is seen as unethical and illegal behavior in the field of trademark law. Furthermore, the author discussed the relationship between good faith and bad faith on one hand, and trademark rejected applications upon bad faith focusing on bad faith matters in Jordan.

In terms of Chapter 9"Trademark Protection," the author discusses trademark protection, covering objective, substantive, and formal conditions. The author also covers trademark infringement, including forgery, imitation, false use, and misdemeanors like using the trademark without permission and selling counterfeit goods. Moreover, the author analyzed deeply Tort liability along with the scope of protection. In this regard, the author searched the impact of TRIPS on trademark protection in Jordan, along with the protection under the Paris Convention, and applicable national laws, such as the Jordanian Unfair Competitors and Trade Secret Law, and The JTM along with the right to object to trademark registration and trademark registered cancellation. Moreover, the chapter also discusses resolving trademark infringement, including judicial solutions, and jurisdictions. In this chapter, the author also covers the prevention of unfair competition, simple trademarks, and the recognition of other functions to protect the business value of trademarks

Chapter 10 Compensation, this Chapter discusses compensation for trademark infringement, including compensation under Jordan Trademark Law, unfair competition and trade secrets law, and civil law. It covers the act of trademark infringement, potential confusion between trademarks, damage, and the causal relationship between the act of infringement and the compensation under international unfair competition. The European Union (EU) trademark law outlines specific rights for trademark proprietors, based on whether the third party's use is identical or similar to the protected products or services and the brand's reputation. In this regard, the author searched whether (CJEU) aims to provide a consistent understanding of the proprietor's authority to prohibit usage. Recent legal decisions emphasize the importance of unfair competition in defining the exclusive rights of trademark proprietors, particularly the functions theory, which determines the infringement of all trademarks. The EU employs a dual system of protection, including trademark system reformation, competition law, official trademark offices, trademark priority, examination process, and requirement of use. The chapter also discusses international trademark and unfair competition law, the well-known marks doctrine, and global trademark prophetization.

In Chapter 11. the author discusses resolving trademark disputes through alternative dispute resolutions (ADR) in the EU, traditional EU court enforcement, mediation, negotiations, arbitration, and conciliations. It also discusses the current jurisdiction rules of the EU and trademark protection under alternative dispute resolutions in Jordan. The chapter investigated judicial and arbitration solutions, public claims within the Registrar of Trademarks, and alternative dispute resolutions in Jordan.

As for chapter Chapter 12 “Jordan Trademark and Islamic Law Background,” the author discusses intellectual property in terms of Sharia law and the leading Islamic schools and how these schools dealt with intellectual property **besides that,** the author analyzed the relationship between Jordan's trademark and Islamic law, focusing on the global regime, legal classification in Islam, and intellectual property rights in Sharia law. Moreover, the author sheds light on how Sharia law interacted with intellectual property as tangible property, in addition to the legitimacy of acquiring financial gains, and the recognition of morality rights.

As for chapter 13, the author finished the dissertation with main conclusions and recommendations, which contained the most important result that the author reached besides answering the main questions of the thesis, Moreover, the author concluded his main recommendation in the thesis.

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Debrecen, 23.07. 2023.

supervisor

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List of Abbreviation

ACA Amman Court of Appeal
JCC Jordanian Court of Cassation
3P: third party
ACA Amman Court of Appeal
ADR Alternative Dispute Resolution
AIPMA: Arab Intellectual Property Mediation and Arbitration Society
ATMA American Trademark Act
ATMA the Australian Trade Marks Act
BCIP The Benelux Convention on Intellectual Property
BTA Benelux Trademark Act (as in force on 31 December 1995)
BTIP Benelux Treaty on Intellectual Property (Trademark and Designs
CHL Chinese law
CJEU Court of Justice of the European Union
CJEU Court of Justice of the European Union
CJEU the Court of Justice of the European Union
CJEU the Court of Justice of the European Union
CL Common law
CLJ common law jurisdictions
CLRs Common law rights
CLTM Common law trademark rights
CLTMRs Common law trademark rights
CTM Community Trademark
CTMR: the Community Trade Mark Regulation
EC Council Regulation
EC European Commission
ECC Egyptian Court of Cassation
ECC Egyptian Court of Cassation
EEC Council Directive of the European Economic Community
EP Directive of the European Parliament
EU European Union
EUD EU Directive
EUDL European Union Directive law
EUGC The European General Court
EUGC. The European General Court
EUIPO Office for Harmonization in the Internal Market
EUIPO: European Union Intellectual Property Office
EURs EU Regulation
EUTM: European Union trademark
EUTMR the EU Trade Marks Regulation
EUTMRs the EU Trade Marks Regulation
EUTMs EU trademarks
F I P L: the French Intellectual Property Law

FCA French Court of Appeal
FCA French Court of Appeal in Paris
FCC French Court of Cassation
FCC French Court of Cassation
FCD First Council Directive
FCFI the French Court of the First Instance
FCFI the French Court of the First Instance
FDI foreign direct investment
FTDA Federal Trademark Dilution Act
GAPUPIP The General Assembly of the Paris Union for the PIP: Protection of Industrial Property
GATT: the General Agreement on Tariffs and Trade
GC the Court of Appeal of the European Communities
GC the Court of Appeal of the European Communities (now 'the General Court'
GDP: Gross Domestic Product
GFCJ the Germany Federal Court of Justice
GFCJ: the Germany Federal Court of Justice
GPO: The German Patent Office
GSC the German Supreme Court
GSC the German Supreme Court
GTML German trademark law
GUCL German Unfair Competition Law
HTML Hungarian Trademark law
INTA: International Trademark Association
IPL intellectual property laws
IPRS F l: IPRS French law
IPRS: Intellectual Property Rights
JAL: The Jordan Arbitration Law
JATML Japanese Trademark Law
JAUCL Unfair Competition Law
JCC Jordanian Court of Cassation
JCL Jordanian civil law
JCL Jordanian Commercial Law
JMML Jordanian Merchandise Marks Law
JSC Japanese Supreme Court
JSC Japanese Supreme Court
JSCJ Jordan Supreme Court of Justice
JSCJ Jordan Supreme Court of Justice
JSCJ the Jordanian Supreme Court of Justice
JSCJ the Jordanian Supreme Court of Justice
JSCJ: The Jordanian Supreme Court of Justice JSCJ
JSML the Jordanian Standards and Metrology Law
JSMO: Jordan Standards and Metrology Organization
JTML Jordanian Trademark Law
JUC&TMSL: The Jordan Unfair Competition and Trade Secrets Law
JUCTSL The Jordan Unfair Competition and Trade Secrets Law
KTMA Korean Trademark Act
lA Lanham Act
Madrid Agreement Madrid Convention Concerning the International Registration of Marks of 1891
MDI Marketing Displays, Inc.
NCS: Nice Classification system

Paris Convention Paris Convention for the Protection of Industrial Property
PCJ Palestinian Court of Justice
PCJ Palestinian Court of Justice
PDM punitive damage mechanism
PRC TMO People's Republic of China Trademark Office
PRCTML Trademark Law of the People's Republic of China
PTMRs Prior Trademark Rights
PTO: Patent and Trademark Office
SCLTIDGI Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications
SMEs: Small and medium-sized enterprises
STLT the Singapore treaty on the regulation of trademarks
TDC Tokyo District Court
TDC Tokyo District Court
TFEU: the Treaty on the Functioning of the European Union
TMA: Trademark Act
TMDir Trademark directives
TMDRA the Trademark Dilution Revision Act
TRIPs Agreement Trade-Related Aspects of Intellectual Property Rights
TTAB The Trademark Trial and Appeal Board
UAEFTML UAE Federal Trademarks Law
UCPA the Unfair Competition Prevention Act
UCPA the Unfair Competition Prevention and Trade Secret Protection Act
UCTSL Unfair competitors, and trade secret law
UKTMA the UK Trademark Act
USPTO United States Patent and Trademark Office
UTSA. Uniform Trade Secrets Act
WIPO: World Intellectual Property Organization
WTO The World Trade Organization

Introductory chapter

1. Introduction

The goal of trademark safeguarding is to safeguard the exclusive rights of individuals or businesses over their distinctive signs, such as logos, names, or symbols, to identify and distinguish their goods or services from those of others. serve as indicators of origin. They enable manufacturers and sellers to effectively communicate to consumers the identity of the creator or distributor responsible for the quality of goods or services. The primary objective of trademark legislation is to regulate commercial activities, with trademarks representing the positive reputation and trust that consumers associate with the owner's products or services in the market. The objective of any trademark legislation is dual. One purpose is to ensure public confidence in purchasing a product with a specific trademark, guaranteeing that they will receive the item they desire. Furthermore, when the proprietor of a trademark has dedicated resources, effort, and financial resources to promote the good or service to the general public, they are safeguarded in their investment against unauthorized use by counterfeiters and fraudsters. This is the firmly established legal principle that safeguards the interests of both the general public and the proprietor of a trademark. Trademark law seeks to safeguard the interests of both the public and intellectual property (IP). However, the public's interests protected by trademark law differ significantly due to their distinct origin and purposes.

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In this regard, the history of trademarks in the commercial aspect has witnessed the critical role of trademarks. At that time, trademarks were thought to have originated from the practice of tagging animals long ago, this usage dates back to ancient times. For instance, the ancient Egyptians used to mark cattle. The same mission has extended to our present time, where the proprietors of the camels mark the camels in particular areas to ensure the rights of their proprietors. going through the Roman era the mission of the trademark focused on distinguishing the others' property. Over time, the mark has developed to be a commercial instrument by recognizing the pedigree efficiency of the camels, due to the mark which is recognized. Also, the appearance of the trademark dates back to the Roman Era, when the Romanians put marks on pottery products to prevent theft and copying. Also, the Indians used to put marks on their goods, but the matter also developed. The mark aimed to distinguish between provinces by photographing an animal or object; this was related to the

ancient Egyptians who used these photos to differentiate between their kingdoms and provinces[1].

Nevertheless, this is not absolute. At the commercial level, Italy witnessed that through trademarks by traders for fame. In the Modern Age, some trademark was manifested, and after that, they became famous; in 1886, the Coca-Cola mark appeared, and in 1888, the Kodak mark appeared, and from that time, the trademarks have become indicated to the source of products and services, more than indicated signs to the proprietorship of the things.[2]

The industrial boom, which occurred in the first half of the 20th century, brought about significant transformations in the social and economic landscape worldwide. The introduction of electric motors and railways between the late 19th century and the early 20th century brought about a significant transformation in the economy, resulting in improved effectiveness in manufacturing and the transportation of products. In the past, culture was more aligned with a society of small business proprietors focused on producing.

However, the more recent culture is centered around a society dominated by giant corporations and characterized by a focus on consumption. Nevertheless, individuality was inconsequential: Trademarks were merely maintained over "colorable imitations," which refers to any trademark that closely matches a registered trademark and is likely to cause confusion, error, or defraud goods with similar description features. Under common law, a brand was protected from confusion among consumers and the loss of customers. However, based on existing case law, it was unlikely that a brand would be protected if it was used for items with different descriptive features. As historical events unfolded, the safeguarding of widely recognized and celebrated trademarks has progressively and deliberately been enhanced worldwide,

2. Why did the author choose Jordanian law in his thesis?

The researcher has chosen to include Jordanian legislation in the doctoral thesis for the following reasons:

First, Jordanian legislation has the advantage of being dynamic and claims to be capable of evolving to match the needs of the market. Hence, the researcher had the opportunity to measure the accuracy of this claim by basing Jordanian legislation on both the European Union and the United States.

The first is to look closely at Article 34 of the Jordanian Trademarks Act. This section says, "No one shall be able to file a claim for damages for any infringement of a trademark not registered in the Hashemite Kingdom of Jordan. However, he shall be able to file an action for the annulment of a trademark registered in the Hashemite Kingdom of Jordan by someone who does not own it after having been registered abroad, as long as the reasons he claims are those in this article."

This is an indication of whether this provision raises a real legal problem by preventing any person from bringing a civil action to seek compensation for any infringement of the rights of the proprietor of a trademark that is not registered in the Kingdom. The Unlawful Competition and Commercial Secrets Act No. 15 of 2000, specifically "The text of articles 2/a&b and 3/a," clarifies the extent of civil protection for unrecorded trademarks in Jordan. There are also relevant legal provisions available. This study yielded several results that we monitored at the end of the investigation.

This manuscript was Criticized by commercial jurisprudence for its requirement to register a trademark in the Kingdom to claim compensation for infringement because compensation is linked to the occurrence and verification of damage, which is left to the

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[1] *Elkaswany, and, Ameer, M. Forgery of information of the trademark, Dar Al Thaqafa, Amman,(2010) 1st press, p.19*

2 Landes, William M., and Richard A. Posner. "Trademark law: an economic perspective." The Journal of Law and Economics 30, no. 2 (1987): 265-309.p.400

judiciary to determine. The compensation is unrelated to the trademark registration procedures that the JTML requires. *Salah Zain Al-Din* justifies the Jordanian legislator's requirement to register the trademark in Jordan for the possibility of claiming compensation in case of infringement to the legislator's desire to encourage trademark proprietors to register them with the Ministry of Industry and Trade to identify them. However, this justification- from the author's perspective- is not valid.

A sufficient reason for violating the provisions of the general principles of civil liability gives each offended party the right to claim compensation[3], especially if we know that the judiciary is the decisive factor in determining the entitlement and amount of compensation. It would have been more appropriate for the Jordanian legislator not to require the condition of registering a trademark in Jordan due to its entitlement to compensation due to its infringement

Second, Jordanian legislation presents issues regarding the impact of trademark registration and use, prompting questions about the flexibility and dynamic nature of this legislation in addressing various forms of trademark use and registration. The research aims to investigate the foundations, parameters, and procedures involved in trademark registration in the European Union and the United States and the degree to which Jordanian legislation incorporates these considerations. In addition to working with legal traders and legislators, it's crucial to clarify the procedures involved in registering and safeguarding the law. This is because I aim to attract more investment and trade. I also assist brand researchers in the realm of commercial brand analysis.

Third: This study highlights the importance of trademark provisions by comparing the grounds and parameters chosen by the EU and the US with Jordanian legislation. It also compares the registration procedures provided for by the trademark rules in their legislation with Jordanian legislation, highlighting them. With the proposal to modify Jordanian legislation's draconian procedures, they are seeking to find the best procedures that will help traders take the initiative to record their trade signs. Finally, compare the legal protections provided by the European Union and the United States and see to what extent such legislation is appropriate for society's culture. Modern methods and forms of trade require a specific brand, so the laws of each country may not provide optimal or adequate protection.

Fourth, the researcher has chosen Jordanian legislation because he is aware of it and wishes to pave the way for other researchers to develop it in line with the need and openness of the Jordanian market to attract investment, measure its compatibility with international conventions, in particular the TRIPS Agreement, and measure the impact of this on the Jordanian economy, businessmen, and the middle class.

of this on the Jordanian economy, businessmen, and the middle class.

3. The author's goal of his thesis title, The Effect Of Use And Registration on The Right to the Trademark,

The author's goal of his thesis title, *The Impact Of Trademark Use & Registration In Jordanian, EU & International Law,* is to investigate the correlation between trademark use and registration to approve the mark proprietorship right predominantly and then reflect on these ways to the right over trademark proprietorship to give protection that trademark deserves. In this context, the trademark is the most widespread and connected to trade and economy, which made it occupy an important and distinguished position; it has become the matter that necessitated the provision of appropriate legal protection on the mark; in this

[3] *as indicated in Article (256) of the Jordanian Civil Code.*

regard, the mark's registration establishes proprietorship rights, as the mere registration of the mark is considered a sufficient reason to develop the right to proprietorship.

The question arises: Why did the Jordanian legislator use the system-to prove the right to the trademark and request compensation? Furthermore, the trademark law allowed any stakeholder to request the register to delete any trademarks of others from the record in case they did not use those trademarks in an ongoing and actual manner during the last three years following the registration date.[4]

3.1 Research questions

In light of the information mentioned above, there is a need to shed light on the protection of registered and unregistered trademarks. The applicable law must be cleared in case of an unregistered trademark.[8] There is a need to identify the stand of the Jordanian legislator and compare legislation on infringements against trademark-related rights. Such violations are carried out, though punishments and penalties are enforced on those committing such violations. This study offered answers to the questions below, besides results and suggestions for the contemporary problems facing trademarks:

Q1 Did Jordanian legislators consider registering or using a trademark essential to protect it? What are the shortcomings of various laws on protecting trademarks in Jordan?

Q2 Did the Jordan Trademark Act protect the rights of consumers?

Q3 Did the Jordan legislator impose compensation on the trademark infringer or forger deterrent to prevent the infringement internationally and nationally level?

Q4 Did Jordan's legislator address the case of the infringement repeating of the protected rights?

Q5 To what extent does Jordan law protect the famous mark?

Q6: did the Jordanian legislator treat the situation where the trademark was violated but not used within the Jordanian territory?

Q7 Did CJEU fix the coexistence of unregistered local rights with later registered national trademarks?

Q8 Did the parties Within the EU level have an "earlier right" when the proprietor of a later registered trademark also has an older right?

Q9 Did the US Code establish the legal grounds for initiating a case in a civil court to address accusations of deceptive labeling and misleading advertising related to unregistered trademarks?

Q10 Did the dilution principle enhance the protection of trademarks for widely recognized brands?

Q11 IF trademarks are in use and not registered. What sort of protection is afforded at the EU level to such non-registered trademarks if an alleged similar trademark is registered or applied for?

Q12 As for the question Could we consider the attributive system as a particular way of manifesting the declarative system?

Q13:Did Sharia law protect intellectual property rights early?

3.3 Hypotheses

There are some hypotheses the study tries to test. The first hypothesis is that trademark registration alone gives priority to the acquisition of the right to trademark proprietors in the Hashemite Kingdom of Jordan. This hypothesis is essential to identify the trademark's legal proprietor and indicate the monopoly right based on the Jordanian Trademark Law and the

[4] *Landes, William M., and Richard A. Posner. ibid p. 265–309.*
[8] *Torremans, Paul. Holyoak and Torremans intellectual property law. Oxford University Press, USA, 2019.*

legal provisions governing this property, especially since the law takes registration as a simple hypothesis to acquire the right to proprietorship as may be proved reversible.

The author believes that the consideration of this theme comes from the increase in dealing with trademarks due to the development of technology that has taken it out of the traditional geographical scope. Hence, it needs to search for the priority of the right of proprietorship between registering and using trademarks and how to protect them.

The second hypothesis the study tries to support is that trademark registration and its use determines the amount of legally adequate protection of trademarks. This hypothesis is essential to find a legislative action that goes hand in hand with the principle "Nullum crimen, Nulla poena sine lege, "which means that criminal offenses and penalties are determined only by the law. In this regard, the phenomenon of trademark infringement remains widespread. This phenomenon may be due to the inconsistency of penalties and fines with the benefits and profits the infringer may earn on the trademark.

The third hypothesis stated that the causes of IPR infringements in developing countries related to many reasons, one of them being the TRIPS agreement, which has received many criticisms for its effectiveness and legitimacy and led to preventing them from adopting the necessary measures that mitigate the negative impact on their economic and social life, The question that arises from this assumption is: why do developing countries choose to be part of regional international organizations like the (EU), and TRIPS treaties?

The fourth hypothesis: An 'earlier right' is a non-registered trademark with An earlier unregistered trademark that has been persistently utilized in association with goods or services by an individual or their predecessor before using or registering another trademark for the same or similar products or services. An action is deemed valid if it is legally protected in every way possible.

The fifth hypotheses suggest a new consideration of registering generic terms as trademarks. This change results from a new court decision stating that a generic term booking can be registered as a trademark.

The sixth hypothesis is that intellectual property violations were not widespread in the early age of the Islamic empire, from the seventh century AD until the end of the Ottoman empire, whether or not Islamic Sharia law sanctioned action against intellectual property violations.

Furthermore, at that time, this study suggests that religious morals and considering intellectual property theft as a sin might be the main reason behind respect for intellectual property rights despite the non-existence of real legal sanctions, the fear of God, and the fear of being stigmatized of shame among the society individual as the study’s hypotheses indicate that the main difference between Jordan trademark law and shari'a law is that the intellectual property violation was considered as murder and not as a sin. The law set sanctions for such violations. Despite all of these efforts by the law, intellectual property violations became more widespread than in the early age of the Islamic empire.

3.4 Statement of the Problem

This study aims to determine the priority of acquiring the right to proprietorship of the trademark in the Hashemite Kingdom of Jordan to find the best ways to protect their rights and to determine the causes of trademark infringements.

To this point, the concept of the trademark generally and the right in it mainly needs to be clarified, especially in Jordanian law, due to the inflexibility of the articles. Moreover, there are no judicial decisions to reduce this inflexibility. Therefore, this study aims to improve and clarify the concept of the trademark by comparing it with other legislations, especially the legal provisions that result from using the trademark, whether in the commercial competition scope or the protection of consumers, knowing that legal provisions depend on the concept that legislator adopted, and appears in functions that the legislator approved or applied for the trademark and its components.

Also, the purpose of this study is to determine the priority of trademark proprietorship in the Hashemite Kingdom of Jordan and identify the proper proprietor of the trademark since the law takes registration as a simple clue to approve the proprietorship right as may be proved reversible and already prove the precedence of the use of the trademark.

TRIPS Agreement aimed to shed light on using the trademark preceding its registration. It suggests that the member states are allowed to grant rights that are based on such use. However, the problem of this study is represented in the fact that the Jordanian legislator in the competent law needed to identify the provisions related to the use of the (unregistered) trademark. The latter legislator shed light on the permissibility of considering the trademark registered based on its prior use.

Before registering the trademark, the legislator did not identify the nature of the right to the trademark. the legislator should have shed light on the ability of the proprietor of the unregistered trademark to prevent others from infringing his trademark-related rights and support the unregistered trademark holder to claim compensation in case an infringement was committed against his trademark-related rights. And did not offer protection for the unregistered trademark. Instead, the legislator of the law of illegitimate competition and business secrets suggests that the infringement of the rights related to unregistered trademarks is deemed illegitimate**.**

4. Methodology

As for the methodology, the author depends on different approaches to reach solutions, results, and recommendations in his thesis as follows:

4.1 descriptive approaches

This study will be conducted by a descriptive analysis method to shed light on the roles of determinants in trademark proprietorship by reviewing Trademarks from an international and national perspective to find a satisfactory solution to prove our hypothesis since the law takes registration as a simple hypothesis to acquire the right to proprietorship as may be proved reversible, and already prove the precedence of the use of the trademark.

4.2 The legal comparison

The thesis needed to use a comparing approach to present and analyze the different legal rules of trademarks in particular local legislations (Jordanian) and foreign (international and EU). At the same time, it compares and evaluates them in connection with a particular thesis issue to be examined. The latter method is called legal comparison, which would be worth mentioning separately in the subchapter summarizing the methodology of the doctoral thesis on the other hand, the comparative-legal approach will be applied to reach functionalism.[9]

[9]*Mátyás, B.. Legal Doctrinal Scholarship: Legal Theory and the Inner Workings of a Doctrinal Discipline. Edward Elgar Publishing, 2021,p. 173.*

4.3 The deductive approach

The deductive study will take its place to test our hypothesis, from general observation to more specific facts. The author hypothesizes that a TRIPS Treaty was established to benefit developed countries and large companies to serve their goals. Thus, the developing countries' legislation and economic and consumer ethical attitudes were affected negatively. Hence, we start looking at the international standards to address weaknesses of law enforcement issues and violations of trademark rights.

4.3 The qualitative approach

The author collects relevant data from the EU as a union for developed countries where a successful model based on international standards can be seen to prevent infringements.[10]**.** It can still be described as a qualitative study even though the author uses some numbers and statistics because he mainly focuses on case studies, literature reviews, legal documents, and data analysis. The statistics are only used to support concepts and test our hypothesis. Therefore, the study is generally expressed in texts and words to understand thoughts, experiences, or notions.

Finally, the secondary data is strongly present as the last methodological used in this study. The primary sources for the secondary data are books, legislations, international legal instruments, journal articles, treatises, and statistics done by formal institutions for specific aims that vary from our purpose in the dissertation. Therefore, this study's novelty and originality are not directly from the secondary data collection but from how to analyze and use the data.[11]

5. The structure of the dissertation

This study aimed to identify registration and trademark use's impact on trademark rights under Jordanian compared to EU and international law. Thus, it is divided into an introductory chapter beside the main ten chapters ending with an onclusion and recommendation chapter.

As in the Introductory chapter, the author discusses and analyzes Jordanian law, its purpose, research questions, objectives, hypotheses, problem statement, methodology, and dissertation structure. It also provides an overview of the research methodology. Besides its amylase why the author chose Jordan law to be a part of this comparative study.

The author investigates trademark legal concepts in the first chapter, Trademark framework, concept, Rights, theories, and doctrine positions investigating the EU, domestic laws, and the doctrine's position on trademarks. Moreover, the author has left some issues for discussion, such as famous and domestic trademarks and whether a well-known trademark is the same renowned trademark mentioned in the legal literature and international agreements such as the Trips Agreement and the Paris Convention. The author also sheds light on the development of Jordan trademarks-related laws. For instance, the old text law did not define trademarks broadly.

. The author investigated both Josef Kohler's theory of intangible assets, and Eugen Ulmer's theory, and the concept of confusion functioning. The chapter also discusses the probability of confusion, its function, and the EUTMR's double identity. It also discusses the likelihood of confusion, its relationship with the similarity of goods, services, and signs, and

[10] *Rahi, S. , Research design and methods: A systematic review of research paradigms, sampling issues and instruments development. International Journal of Economics & Management Sciences2017, 6(2), 1-5*

[11] *Babbie, Earl R. The practice of social research. Cengage Au, 2020.*

the criteria for determining the goodwill of a mark. The chapter also covers trademark forms, including names, letters, numbers, symbols, pictures, inscriptions, and drawings.

In Chapter 2 on trademark types, the author discusses the distinction between a well-known and famous mark, their protection, and the reasons behind their refusal. The guide covers the United States, Australia, China, and Japan as examples, and the distinction between "well-known" and "famous" marks. It also covers the registration, real use, and protection of well-known and famous trademarks in different countries, such as the European Union, United Kingdom, and France. The author also discusses the concept of a "reputed mark" and its relevance to the public. moreover, the author highlights the importance of a reputed mark in the trademark industry. and discuss the importance of a well-known mark in the public's perception and the potential for trademark disputes.

In Chapter 3, the author discusses nontraditional trademarks in the European Union and the US, and Jordan including phonetically pronounceable, color-based, shape mark, and black and white marks. The chapter also analyzed the reasons for trademark refusal, including lack of distinctiveness, moreover, the author investigated Jordan's trademark law, JTML, and if it could harmonized with nontraditional trademarks and the relation with prohibited trademarks. The chapter provides a comprehensive overview of these trademark laws.

In chapter 4 “Trademark Registration”, the author discusses trademark registration systems, objectives, and procedural conditions. Besides the objectives include legality, distinctiveness, novelty, and visual perceptibility. Procedures include trademark registration in Jordan and the EU, a deposit system, and expiration under the principle of exhaustion of trademark rights.

In, Chapter 5, the author discusses trademark usage in the EU, non-traditional trademarks, and trademark abandonment concepts. Besides that, the author sheds light on implicit abandonment, and retirement from trade and industry, and analyzes trademark use nonopposition. Furthermore, the author also covers trademark use in Jordan besides the legal concept of non-use, including the non-use of judicial and legal positions.

Chapter 6 discusses using earlier non-registered trademarks in opposition or infringement proceedings under the EU Trademarks Regulation such as Recital 5 of Directive 2008/95 and Directive 2008/95 besides the Benelux Convention. Moreover, this chapter covers legal regulations, business activities, national law, 'earlier rights', passing-off rules, enforcement authority, and the extent of protection. It also sheds light on the coexistence of unregistered local rights with later national trademarks.

In Chapter 7 “Unregistered Trademarks by International Law: American Law as an example, the author discusses unregistered trademarks by international law, including American law. It covers the Paris Convention, the TRIPs Agreement, and American federal legislation. In this context, the author discusses deeply how Unregistered trademarks are continuously safeguarded and offer some advantages, the author also analyzes the relationship between dilution and others, including famous marks, suggestive marks, descriptive marks, fanciful marks, arbitrary marks, and digital trademarks. Moreover, the author also discusses the practical principle and case study of infringement, such as using a trademark to indicate product origin, the registration of immoral or scandalous trademarks, the mental association between a junior user's mark and a recognized mark, and the functional nature of product features.

As for Chapter 8 Bad Faith Matters, In this Chapter, the author analyzed the bad role in determining trademark infringement and protecting trademark rights. To this point, the author

took a peek into classifications and definitions of bad faith and investigated bad faith as an unequivocal reason for rejection. Moreover, the author studies the application for an EU Trademark (EUTM and Application submitted with malicious intent. To this point, the author took into consideration the Impact of the BTA Directive Initially Generally, bad faith is seen as unethical and illegal behavior in the field of trademark law. Furthermore, the author discussed the relationship between good faith and bad faith on one hand, and trademark rejected applications upon bad faith focusing on bad faith matters in Jordan.

In terms of Chapter 9"Trademark Protection," the author discusses trademark protection, covering objective, substantive, and formal conditions. The author also covers trademark infringement, including forgery, imitation, false use, and misdemeanors like using the trademark without permission and selling counterfeit goods. Moreover, the author analyzed deeply Tort liability along with the scope of protection. In this regard, the author searched the impact of TRIPS on trademark protection in Jordan, along with the protection under the Paris Convention, and applicable national laws, such as the Jordanian Unfair Competitors and Trade Secret Law, and The JTM along with the right to object to trademark registration and trademark registered cancellation. Moreover, the chapter also discusses resolving trademark infringement, including judicial solutions, and jurisdictions. In this chapter, the author also covers the prevention of unfair competition, simple trademarks, and the recognition of other functions to protect the business value of trademarks

Chapter 10 Compensation, this Chapter discusses compensation for trademark infringement, including compensation under Jordan Trademark Law, unfair competition and trade secrets law, and civil law. It covers the act of trademark infringement, potential confusion between trademarks, damage, and the causal relationship between the act of infringement and the compensation under international unfair competition. The European Union (EU) trademark law outlines specific rights for trademark proprietors, based on whether the third party's use is identical or similar to the protected products or services and the brand's reputation. In this regard, the author searched whether (CJEU) aims to provide a consistent understanding of the proprietor's authority to prohibit usage. Recent legal decisions emphasize the importance of unfair competition in defining the exclusive rights of trademark proprietors, particularly the functions theory, which determines the infringement of all trademarks. The EU employs a dual system of protection, including trademark system reformation, competition law, official trademark offices, trademark priority, examination process, and use requirement. The chapter also discusses international trademark and unfair competition law, the well-known marks doctrine, and global trademark prophetization.

In Chapter 11. the author discusses resolving trademark disputes through alternative dispute resolutions (ADR) in the EU, traditional EU court enforcement, mediation, negotiations, arbitration, and conciliations. It also discusses the current jurisdiction rules of the EU and trademark protection under alternative dispute resolutions in Jordan. The chapter investigated judicial and arbitration solutions, public claims within the Registrar of Trademarks, and alternative dispute resolutions in Jordan.

As for chapter Chapter 12 "Jordan Trademark and Islamic Law Background," the author discusses intellectual property in terms of Sharia law and the leading Islamic schools and how these schools dealt with intellectual property besides that**,** the author analyzed the relationship between Jordan's trademark and Islamic law, focusing on the global regime, legal classification in Islam, and intellectual property rights in Sharia law. Moreover, the author sheds light on how Sharia law interacted with intellectual property as tangible property, in addition to the legitimacy of acquiring financial gains, and the recognition of morality rights.

As for chapter 13, the author finished the dissertation with main conclusions and recommendations, which contained the most important result that the author reached besides answering the main questions of the thesis, Moreover, the author concluded his main recommendation in the thesis.

Chapter One: Trademark framework, concept, Rights, theories, and doctrine positions

To know trademarks right, first, the author needs to pay attention to the importance of knowing the essence of intangible property. in this context, two scholars lead the intangible assets, Kohler and Ulmer. In this regard, the author will discuss this theory as follows**:**

1. Theory of intangible assets

Comprehending the legal nature of intellectual property is essential when considering its intangible nature. English jurisprudence regards trademarks as subjects that can be acquired solely using the execution of fiction, due to their economic indispensability. In contrast to the English property theory, it is important to acknowledge the contributions of Josef Kohler's work. Within his notion of intangible property, he placed significant emphasis on distinguishing between intellectual creations and tangible objects. Kohler believed that the establishment of property rights was inadequate for safeguarding labor. According to his perspective, the legal structures that safeguard intangible assets are only structurally similar to property rights.

It is important to note Eugen Ulmer's theory of combination, which emphasizes the inseparable connection between personality and property rights associated with intellectual property. Trademarks are more prevalent than personality and property rights. Since moral rights cannot be bought or sold, the rights to intellectual property can be transmitted within their financial framework.

1.1 Josef Kohler's theory of intangible assets

The theory of intangible property rights was developed by Josef Kohler.[12]. Josef Kohler, a renowned German legal scholar, formulated a complex and compelling concept of intellectual property during the late 19th century. He extrapolated concepts of intellectual property into a more comprehensive conception of intangible assets, downplaying their tangible and everlasting characteristics. Kohler contended that society still maintained authority over even traditional property, as real property had repercussions on others. Society bears equal responsibility for the management of intangible assets.

Kohler stressed the significance of personality rights, which safeguard works from alteration and prevent them from dissemination under someone else's name. Nevertheless, the notion of property continued to restrict Kohler. When authors were employed on a contractual basis, the employer held the economic rights, while the personal rights were transferred to the employer. Conversely, a commissioned painter guarantees the creation of the "painting" itself but does not guarantee the "composition," which refers to the creative core of the work[13].

However, he made allowances for portraiture. The person who paid the artist or the portrait's subject possessed full proprietorship of the artwork, including its authorship.

[12] *Delia Lipszyc Copyright and Neighboring Rights, UNESCO · ,1999 P31*
[13] *Baldwin, Peter. The copyright wars: three centuries of trans-atlantic battle. Princeton University Press, 2016.p107*

Similarly, this also applied to portrayals of personal life, such as a painting of a woman's private room workspace. Kohler prioritized work-for-hire and the privacy rights of the commissioner over authority. Establishing the basis of personality rights on property resulted in significant difficulty in preventing such deviation. Kohler's agile efforts to maintain a property-based perspective on authors' rights had little support by the late nineteenth century, as the justification became more focused on personality.

Otto von Gierke, a German judicial researcher, authored the most extensive record of personality-based views throughout the century's transition. Gierke considered authors' rights should be safeguarded within their individuality. Building on Kant's ideas, he established the foundation of these rights in the metaphysical domain. Economic claims are drawn from theoretical ones. The customary economic rights were subject to temporal limitations, transferability, inheritability, and complete alienability. Gierke placed greater significance on the author's ideal rights. He expressed these ideas not in absolute terms, but rather as a direct manifestation of the author's personality. The primary purpose of authorial control was to uphold and safeguard a person's reputation and honor.

However, Gierke also included an additional objective aligned with the moral rights principle, which aimed to guarantee the author's unrestricted ability to achieve their scientific and creative aims. The text implies that two important factors were involved: attribution, which refers to claiming reputation, and integrity, which refers to achieving a purpose. Gierke emphasized the importance of integrity by granting the author the only authority to prevent any alterations to their work and maintain control over its core content. These essential aspects that constitute the author's claims, known as personality rights, cannot be completely transferred to others. It is possible to allocate exploiting rights. However, the essence of the work stayed within the author.

However, Gierke exhibited contradicting behavior. In addition, he asserted that the author has the ability to relinquish all of his privileges, particularly the authority over the work's inherent rights. In contrast to those who adopted his fundamental methodology[14],

Gierke comprehensively understood the fundamental conflict between personality and property, recognizing that property rights entail both absolute and completely transferable rights. Personality claims, on the other hand, were fundamentally untransferable. The bond between the creator and the work was indissoluble. However, due to the creator's mortality, the relationship with his creations was also subject to mortality. Following his demise, his immediate family or other individuals may choose to carry on with the same endeavor.[15]

Von Gierke described three methods by which a legal entity can be established. In addition to formal attributing, which refers to a formal proclamation, and implicit attribution of legal personality by the legal system, he identified a third alternative: "Persönlichkeitkraft." The legal individuality of Dasein arises from his actual existence. Three In this scenario, the foundation of legal identity is established before any legal considerations.

The legal personality of an entity is determined by the factual conditions or specific abilities or characteristics it possesses. ILP goes beyond being only a legal relationship; it is deeply connected to its factual existence (Dasein). The factual existence and attributes of the

[14] *Peter Baldwin The Copyright Wars: Three Centuries of Trans-Atlantic Battle,2016, p109*
[15] *ibid, p114*

entity form the foundation of its legal personality. The term 'pre-juristic being refers to a state or condition that existed before the establishment of legal norms.

It pertains to the attributes or abilities of the social context that give rise to legal personhood. Gierke's thesis posits that a legal persona arises from social circumstances, which he refers to as Genossenschaft, meaning companionship. The term "plurality in unity" in this context pertains to the medieval understanding of communal unity. Therefore, it possesses individuality and autonomy. Legal personality refers to the legal conception of this unity. Ramsay in his introduction to the Legislative Theory of the medieval period.[16]

Three primary theoretical areas within deontological reasoning frameworks can be identified, despite major overlaps: "labor theory, personality theory, and reward theory". These hold particular significance in the domain of intellectual property rights, which is distinguished by a strong focus on human interests.

Nevertheless, they are present throughout intellectual property law as a whole, albeit with varying subtleties. The user's text is empty. It is crucial to clarify that in a democracy that is governed by the principles of legislation, there currently is no concept of natural law, counter to conventional beliefs. The establishment of any intellectual property (IP) system is based on political determination within the legal framework of the relevant jurisdiction, as defined by the constitution and other authoritative legislation. The ideas have limited relevance and only serve as an inspiring conceptual structure having any normative authority. The labor theory posits that individuals have a legitimate claim to property rights that are derived from the effort they exert in acquiring the corresponding assets, hence entitling them to reap the rewards of what they have worked for.

The notion of "tangible property" was originally formulated by John Locke, and subsequently, it was further developed to encompass immaterial things by other scholars. "Personality theory" posits that creating and sharing whatever with people at large is a manifestation of one's personality, that is believed to be influenced by an individual's engagement with external entities. [17]

...

1.1.1 Exploring the Essence of Intangible Intellectual Property

Immaterial Goods Theory, [18]developed by the German academic Josef Kohler, significantly influenced legal studies in Europe in the first part of the twentieth century and served as the backdrop for these discussions. Alf Ross, a Danish legal realist, criticized the idea of intangible or immaterial products in a 1945 review, specifically focusing on the concept of work in copyright law.

Ross contended that the concept of a work being an intangible good, possessing traits akin to those of a tangible commodity but lacking tangibility, was fictional. This is because the work, in and of itself, only exists inside the realm of people's thoughts. Ross argued that the term "work" is merely an abstract concept that represents the interconnectedness of ideas within a sequence of events. As stated by Ross, it was inconceivable to get rid of or take advantage of a piece of work. The fact was that specific manifestations, such as duplicates, could elicit experiences or sensations associated with the content of the ideas that are referred to as the work. According to Ross, copyright is not focused on the thing itself in the same way as intangible property.

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[16] *Cedric Ryngaert, Non-State Actor Dynamics in International Law: From Law-Takers to Law-Makers, Publisher Routledge, 2016, p113*
[17] *Reto Hilty, JyhAn Lee, Kung-Chung Liu, Artificial Intelligence and Intellectual Property,Publisher Oxford University Press, 2021, p56*
[18] *also known as "Immaterialgütertheorie",*

According to him, when a right has an object, it indicates that the actions required by the law for the person holding the right are connected to the use or control of this item. [19] According to Ross, this structure is not included in copyright. The current framework outlines a rights structure that stimulates the pursuit of a goal, and the outcome is the intangible nature of the work as a valuable asset. The true context, however, lies in the fact that the creator of the work is granted the authority to manipulate the tangible circumstances that shape the experience of the piece in question. [20]

Ross's criticism of the idea that work is an intangible asset generated heated discussion in Scandinavian literature over the concept of work and the role of the object in intellectual property law. Despite the various perspectives presented during the debate, Ross's critique of the notion of work as a singular concept, which is treated as an intangible entity akin to physical assets in "real property," was widely accepted and applied to other forms of intellectual property. This discovery highlights a crucial aspect of the conceptual ideas that are recognized as the subjects of legal rights in most intellectual property systems, such as works of art, and trademarks. [21]

In the past, German doctrine has for centuries emphasized a clear separation between monetary and rights to personality[22]. While financial privileges could be transferred, personality rights were considered to be inherently tied to the individual[23.] Josef Kohler was one of the scholars who discussed this distinction in the second half of the nineteenth century. He categorized things into three groups: property that is tangible, intangible, and personality rights.

While Kohler acknowledged numerous similarities between rights in intangible objects and rights in tangibles, he refrained from using the phrase 'property' for intangible objects to prevent any potential confusion between the two classifications. Kohler viewed patents as standard rights in intangible objects that could be freely assigned and licensed. In regards to copyright, Kohler had a contradictory perspective.

Kohler made a distinction between the author's economic right, which he saw as a transferable right in an intangible object, and the right of the writer to their personality. In Kohler's perspective, the primary purpose of trademarks is to safeguard the proprietor's individuality. Following this perspective, which also had an impact on the legal system at the beginning of the twentieth century, trademarks were considered to be individual rights that could not be transferred. Therefore, the legal explanation of a trademark license posed challenges. Based on the prevailing perspective during that period, it was believed that the proprietor of a trademark could only choose to forgo seeking an order of protection and damages. The theory of intellectual property law has evolved significantly given Kohler's time.

Today, trademarks are considered legitimate intellectual property rights that can be transferred and licensed. The Copyright Act of 1965 takes an integrated approach when it comes to the author's rights. It recognizes that the author's right is a comprehensive right that

[19] *Ole-Andreas Rognstad, Property Aspects of Intellectual Property, Cambridge University Press, 2018, p48*
[20] *ibid, p48*
[21] *ibid, p48*
[22] *Huw Beverley-Smith, Ansgar Ohly, Agnes Lucas-Schloetter Privacy, Property and Personality: Civil Law Perspectives on Commercial Appropriation, Publisher Cambridge University Press, 2005, p129*
[23] *Rochelle C. Dreyfuss, Justine Pila · The Oxford Handbook of Intellectual Property Law, Publisher Oxford University Press, 2018, pP339.*

safeguards both their economic and ideal interests. Copyright can be seen as a combination of property and personality rights. In German law, intellectual property cannot be transferred, but its proprietor authorizes various permits[24].

1.2 Eugen Ulmer's theory

One of the theories that emerged between 1878 and 1902 had the most impact and captured the mind was Ulmer's theory. During that time, Germany played a significant role in developing the intellectual foundations of the personalist theory, which was spearheaded by Eugen Ulmer.[25] Eugen Ulmer's The Tree Theory".[26]

Intellectual property rights refer to the legal protection of personal and proprietary elements. It can be understood as two interconnected aspects, like two faces of a coin or separate roots nourishing a common trunk of a tree (as illustrated by Eugen Ulmer's famous tree metaphor). The closest comparable to "intellectual property rights" in terms of economic value is the associated economic rights. Eugen Ulmer perceived the ethical rights of authors as originating from the foundational core of a tree, which both sustains and governs its branches.[27]

Contrary to the dualist methodology, the monist approach views moral and exploitation rights as a unified set of rights, rather than distinct sets which are combined for the sake of effectiveness. It is stated that ethics rights should be upheld regardless of the author's passing and ought to be preserved up until their financial privileges expire[28]. On the contrary, intellectual property rights are regarded as a single right that serves two separate purposes. This approach, formulated by scholars, was officially established in Austria's Copyright Statute in 1936. Today, the monist approach is commonly explained in German copyright casebooks using Eugen Ulmer's "tree theory.

" In his casebook from 1980, Ulmer drew a comparison between copyright and a tree trunk, highlighting the two fundamental aspects: the author's economic interests and their intellectual/personality interests. Each branch of the tree was formed by the author's rights. Some individuals derived their strength from a balanced combination of both roots, while others leaned more towards a particular root or another. Ulmer emphasizes the connection between exploiting rights as well as ethical principles, highlighting that an infringement of ethical principles can result in claims for damages and impact the economic success of a work. Due to this, both sets of rights are generally recognized as rights to intangible assets: The purpose of the rights is to safeguard the author's connection to their work, rather than their identity. One of the key implications of this idea is that an author is unable to trade in or give up their intellectual property.

There is an ongoing debate about the possibility of giving up individual exploitation rights. Opponents of this view highlight the interconnectedness of both sets of rights,

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[24] *Huw Beverley-Smith, Ansgar Ohly, Agnes Lucas-Schloetter, Privacy, Property and Personality: Civil Law Perspectives on Commercial Appropriation, ibid, p129*
[25] *Bruun, Niklas, and Marja-Leena Mansala, eds. Research Handbook on Intellectual Property and Employment Law. Edward Elgar Publishing, 2021.p.72*
[26] *Ysolde Gendreau, Research Handbook on Intellectual Property and Moral Rights2023, p158.*
[27] *Tim Crook Comparative Media Law and Ethics, Publisher Routledge, 2009, P 409.*
[28] *Graham Dutfield, Uma Suthersanen, Dutfield and Suthersanen on Global Intellectual Property Law: Publisher Edward Elgar Publishing, 2020Second Edition 2020,p135.*

suggesting that authors may forfeit certain ethical privileges should they choose to do so[29]. Building upon Ulmer's metaphor, Schack asserts that an author has the authority to grant others access to the fruits of their labor, but they cannot relinquish control over any part of the tree itself. Another significant distinction from the dualist conception is that each category of property rights has an equal duration, typically lasting for 70 years after the author's death. When the author passes away, their copyright is transferred to their heirs as a whole.

This remains true regardless of any familial connection between the author and their heirs. In Austria, multiple heirs are considered the co-authors" On the other hand heirs are entrusted with the author's ethical obligations and must honor the author's desires when utilizing those privileges." [30]A near reconciliation paradoxically, the leading thinker of German intellectual property law in the twentieth century played a role in strengthening the formal requirements for registration. The notion remained grounded in the fundamental importance of safeguarding rights as individuals.[31]

Despite his efforts to clarify, his influencing theory about the relationship between those two disciplines was unable to resolve the conflict. Indeed, in 1929, Eugen Ulmer appeared to offer a definitive resolution to the dilemma in his rehabilitation work. Since then, he has received commendation for effectively harmonizing trademark and unfair competition regulations.

Fair competition avoidance was established to govern business and competitiveness, while the law on trademarks was established to safeguard the rights of individuals. Ulmer refuted this division. However, his view still relied on the fundamental importance of safeguarding individual rights when it came to the issue that needed protecting. He regarded either trademark or unfair competition legislation as components of commercial tort doctrine. Ultimately, this concept was not novel, as both economic sectors were previously identified as interdependent. [32]

Ulmer, on the other hand, provided a more solid basis for the idea. Studying various national laws provided a foundation for developing an initial theory of core policies that transcend borders. Understanding the importance of legal protection in trademarks and firm names is crucial for any business. This aspect of business assets cannot exist independently and requires legal protection. It can be considered an intangible asset alongside other legal rights held by the proprietor. This value is a component of the area that Pisko has described as a "secured sales option." English legal expression defines the concept of "goodwill" ..., while French jargon offers a concise summary of it.

He emphasized the importance of "advertising ability" which was demonstrated through the strategic use of trademarks and trade indicators. Given that all laws prioritize the protection of marketing capability and commercials. He discovered that the positive perception ingrained in the minds of customers was the all-encompassing and sole important topic. Preventing consumer confusion is essential for both trademark protection and unfair competition repression.

Furthermore, Ulmer believed that the register's true purpose necessitated a unique approach to handling registered rights[33]. Acquiring rights under the law of "unfair competition" was possible through the natural use of a trademark in the ordinary conduct of

[29] *Ysolde Gendreau Research Handbook on Intellectual Property and Moral Rights, ibid,, p158.*
[30] *ibid, p159*
[31] *Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, ibid, p42*
[32] *ibid p42*
[33] *ibid, p43*

trade or commerce. Registration and the granting of rights before being utilized in the market, on the other hand, allowed for the development of trademark rights within a specially created space of personal autonomy. This geographic area encompassed the entire country. This function is widely recognized as the cornerstone of trademark advancement and foster parenting.

As Ulmer recognized it was crucial to promote and support the growth of emerging trademarks. As a trusted advisor, the registrant required security to strategically plan and invest in her marketing activities, with a specific focus on enhancing the reputation of her trademark. Ensuring a comprehensive guarantee of rights protection is crucial for fostering a favorable environment for the creation and establishment of new trademarks. From this perspective, there was no other option but to use the register, and any worries about possible negative impacts on competition had to be set aside. whichever is the point of growth and development, the approach of advancing trademarks or preventing confusion will be implemented consequently.

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It was taken for granted that the registration played a crucial role in promoting the growth of trademark rights. [34] In this context, registered rights would be given precedence despite a competitor's unregistered claim or a previously obtained status. Nevertheless, registering was restricted to promoting legal clarity. It served solely as a means to enforce regulations against unfair competition. During the later phases of a trademark's existence, after gaining market recognition, the focus shifts from creating new trademarks to ensuring that there is no misunderstanding among consumers.

In this final phase, the focus is on safeguarding current rights and established market positions of power, rather than on promoting trademarks. This approach challenged the previously prevailing notion of the trademark register's alleged self-sufficiency. The registry was a minor component of the comprehensive system for safeguarding trademarks and goodwill, rather than the only determinant for establishing and enforcing rights. Although Ulmer successfully reconciled the two simultaneous security mechanisms, he did not eliminate the duality. This is mostly due to his definition of trademark rights as intangible assets.

Nevertheless, the prevention of unfair competition continued to be classified as a type of business wrongdoing. The protection of consumers remained an afterthought issue. The protection of customer needs was merely an outcome of protecting particular competitors. Competitors' interest[35]. Given this perspective, it becomes clear why European Union law, as outlined in the Trademark Directive and the Trademark Regulation, does not include provisions for equivalency. The directive's prologue clarifies that trademarks that are "gained via use" are only considered trademarks that are obtained through registration.

Therefore, while national governments can and do safeguard use-based trademark rights, the acquisition and ongoing maintenance of such rights at the community level primarily depend on registration requirements. Ultimately, the establishment of this registration advantage has been supported by a broader, progressively property-focused viewpoint in contemporary European trademark jurisprudence. Both the directive and the regulation use the terms "property" and "proprietor" about trademarks. Given this approach, it is not surprising that both academic opinion and CJEU have adopted a doctrine that focuses on safeguarding the investment of proprietors from a property-oriented standpoint.

Historically, the main purpose of a trademark was to differentiate different items from different competitors and to show the source of the item in question. Specifically, CJEU previously emphasized the assurance of source as the fundamental purpose of the trademark. Yet another distinctive symbol or logo associated with a certain brand or company. The user's text consists of a single number[36].

Trademark law has expanded from a limited range of protection to a broader one, acknowledging the economic versatility of trademarks. Before the unification of trademark law in Europe, several elements of contemporary trademark goodwill were safeguarded by unfair competition law rather than trademark doctrine. Currently, European and national legislators are providing member states the chance to protect famous trademarks from being exploited in a way that is unfair or harmful to the trademark's unique qualities or reputation.

[34] *Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, ibid, p44*
[35] *ibid, p45*
[36] *Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, ibid, p48*

CJEU has expanded its viewpoint on trademark functions, highlighting that trademarks now possess complete authority to prevent confusion.[37]

2. Trademark Concept

The jurists differed in developing a fixed and specific definition of the trademark according to the angle from which that mark is seen. This difference opened the door to legal jurisprudence in determining the doctrine's trademark position. Jurisprudence must be considered to clarify the trademark concept. To this purpose, the author will address the definition of trademarks and the types and forms of trademarks. In this context, the trademark is defined as visible signs that distinguish goods, products, or services from those of others.

The trademark is deemed necessary for protecting industrial and commercial property rights. Most legal texts and legislations are consistent with legal doctrine regarding trademarks' definition. Following the common-law or non-common law doctrine, German law defines a Trademark as: "Any signs, particularly words, including personal names, designs, letters, numerals, sound marks, three-dimensional configurations, including the shape of goods or their wrapping as well as another packaging, including colors and combinations of colors, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as trademarks."

American legislation specified Trademark: as "any word, name, symbol or sign, or any kind of combination thereof, used in business to recognize and differentiate the product of one manufacturer or vendor from those of an additional and also suggest the origin of this good," the phrases "trade name" and also "commercial name" indicate any name made use of by an individual to identify their organization or occupation.

The term "trademark" contains a word, symbol, means, or name, or any type of mix thereof used by an individual(38), or the term "trademark" contains any word, symbol, means, name, or any mix thereof: Used by an individual, or the person with a legitimate intent to use in business and also puts on sign up on the primary register created by this phase to identify and also differentiate their products, consisting of a particular item, from those made or marketed by others and to suggest the resource of the products, even if that resource is unknown In enhancement, the term "service mark" implies any word, symbol, name, or device, or any combination thereof used by a person, or the particular person with a good faith intent to utilize in business and additionally associates with register on the primary record developed by this stage, to recognize as well as also differentiate the services of a particular person, consisting of distinctive service, from others services operators as well as likewise to demonstrate the source of this operator services, even if that source is unknown[39].

Titles, personality names, and other differentiating features of TV or radio shows might be taped as a service mark, considering that they may sell the sponsor's items and goods[40]. In this context, Spanish legislation specified a trademark as a "signable to be described graphically and made use of to distinguish on the market the services or products or of one firm from those of various other business."[41] In addition, the phrase "service mark" indicates

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[37] *ibid, p49-50.*
[38] *Naser. M.A, (), Trademarks and freedom of expression. International Review of Intellectual Property and Competition Law 2014,p52.*
[39] *U.S. Code › Title 15 › Chapter 22 › Subchapter III › § 112*
[40] *U.S. Code › Title 15 › Chapter 22 › Subchapter III › § 112*
41Law No. 17/2001 of December 7, 2001, on Trademarks (Consolidated text including the Amendments made by Law No. 20/2003 of July 7, 2003, on Legal Protection of Industrial Designs)

any symbol, name, word, device, or combination from that place. Such signs may, in particular, be:

(a) combinations of words or even words utilized to recognize individuals;

(b), symbols, figures, Images, and drawings;

(c), numbers, letters, and combinations thence[42.]

(d) Three-dimensional forms, including packaging, the shape of a product wrapper;

(e) Sounds;

(f) Any amalgamation of the signs mentioned in the previous subparagraphs for declaratory purposes. However, unlike most other laws, British law has used the trademarked term as part of common law. This law is called "trademark" law[43], where specified "trademark" means:

Any indication that can be geographically recognized can differentiate the services or goods of one endeavor from those of various other endeavors. A hallmark might contain words (including personal names), styles, products, letters, numerals, forms, or packaging.[44.] By evaluating UK regulation, some say that the proprietors of a hallmark can legitimately protect their mark against violations if the trademark was recorded or has been utilized for some time and has acquired regional distinctiveness (Prior Rights).

French regulation has defined a trademark and "service mark" as a symbol qualified for graphic indication, differentiating a legal or all-natural person[45]. In addition to that, the French law considered the next, in particular, may institute such a sign:

a) Values in all forms, geographical names, word combinations, such as aliases, surnames and, numerals, letters, and abbreviations;

b) Musical phrases and other audio signs files and other;

c) Symbolic indicators such as hems, tags, holograms, seal devices, alleviations, logo designs, manufactured pictures; forms, especially product, and packaging, or those that recognize a service; "plans, mixes, or color shade.[46] French law indicated distinguishing characteristics of a sign as a vital criterion for trademarks or service marks[47].

Besides that, French law stipulated the distinguishing essence of a sign qualified for making a mark. This sign means to be measured relative to the chosen services or goods. It was noticed that French law excluded some signs from enjoying their distinctive nature and some signs from being approved as a mark or a component of a mark[48.] According to the Jordan Act, the trademark was defined as: "Any visible sign used or intended to be used by any person to distinguish its goods, products or services from goods, products or services of others."[49] In another context, "the Standing Committee on the Law of Trademarks, Industrial

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42 YH Collection of Laws for Electronic Access SPAIN, ES080EN Marks, Law (Consolidation), 07/12/2001 (07/07/2003), page 12/63 No. 17 (No. 20)

43The Trade Marks Act 1994 is the law governing trademarks within the United Kingdom and the Isle of Man. It implements EU Directive No. 89/104/EEC (The Trade Marks Directive) which forms the framework for the trademark laws of all EU member states, and replaced an earlier law, the Trade Marks Act 1938.[1] The Act provides both civil and criminal law sanctions for the misuse of registered trademarks. Section 93 of the Act makes enforcement of the criminal sanctions the duty of the local Weights and Measures Authority (usually the Trading Standards department) and imports enforcement powers from the Trade Descriptions Act.

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Similar criminal law provisions are written into the related Copyright Designs and Patents Act.

44Trade Marks Act 1994, article 1

45Article L711-1 (Act No. 96-1106 of 18 December 1996 Art. 12 Official Journal of 19 December 1996)

46Article L711-1 op. cit.

47Article L711-2 op.ci.

48The following may not be adopted as a mark or an element of a mark:

a) Signs excluded by Article 6ter of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised or by paragraph 2 of Article 23 of Annex 1C to the Agreement Establishing the World Trade Organization;

b) Signs contrary to public policy or morality or whose use is prohibited by law;

c) Signs liable to mislead the public, particularly as regards the nature, quality, or geographical origin of the goods or services, see Intellectual Property CODE, Article L711-3(Act No. 96-1106 of 18 December 1996 Art. 12 Official Journal of 19 December 1996)

[49]Jordanian Trademarks Law No. 33 of 1952, article 2 and Trademark Law No. 34 of 1999, article 2.

Designs, and Geographical Indications" defined trademark as: "Any sign or combination of signs, capable of distinguishing the goods or services of an undertaking from the goods or services of another undertaking[50].

"By comparing these laws mentioned above, it was noticed that the legal definition had expanded the scope of the trademark, which is spelled out in expanding the trademark's legal concept to ensure new forms resulting from digital and technical development, such as holograms and three-dimensional models. Based on the legal definitions' analytics, it is noted that all these definitions stipulated the condition of distinctiveness to be considered a trademark; otherwise, it cannot be considered a trademark. Trademarks determine the manufacturer of other goods representing important commercial assets without worrying that lower goods would reduce their revenue or repute by misleading the customer. The primary purpose of trademark legislation is to protect the consumer from needing clarification about the source of the goods. The degree to which the trademark is defensible relies on the likeness of the trademarks, the similarity of the products and services, and whether the trademark has distinctiveness.

Following Hungarian Trademark law, the protection of a Trademark shall be approved for any indicators efficient in being expressed graphically, provided that these can be identifying items or services from those of various other tasks.

. (2) Signs which might be given trademark defense are in particular: (a) words, the mix of words, including individual names and slogans, (b) characters letters, (c) figures, photos, (d) tow- or three-dimensional kinds, including the shape of packaging or items (e) colors, the mix of colors(f) (g)sound signals and mix of indicators under (a) to (f)[51]. Also, this act left out any sign from the mark's defense if it is without any distinct character, specifically, if it is composed of signs or signs that may offer, in trade, to mark the type, top quality, amount, planned function, worth, geographical source or the time of manufacturing of the products or services or making of the "Service," or other qualities of the products or "services," or which have evolved traditional in the existing language or the methods of trade[52].

2.1 Trademarks function concepts

As per the established legal precedent of the Court, the primary purpose of a trademark is to ensure that customers or consumers can easily identify the origins of the good or service that is being marked. This is achieved by allowing them to distinguish it from other products or services that come from a different source, without also any chance of confusion[56].

The statutory concepts of double identity and the possibility of confusion are employed to safeguard trademarks and simultaneously establish the extent of their protection. Therefore, it is crucial to consider whether elements or functions of trademarks deserve safeguarding. Trademarks serve multiple purposes. One of the most basic functions is to serve as indications that show the business-related source of the product or service in question. This is their main purpose. The Court's ruling in the Canon case said that: According to the established legal precedent of the Court, the primary purpose of a trademark is to ensure that the consumer or end user can easily identify the source of the trademarked

[50] *standing committee on the law of trademarks, industrial designs, and geographical indications, WIPO/Strad/inf/1 rev.1, a summary of replies to the questionnaire on trademark law and practice (sct/11/6) p6.*
[51] *Hungarian Act XI of 1997 on the Protection of Trade Marks and Geographical Indications, Article 1*
[52] *ibid, article 2 .*
[56] *(29/09/1998, C-39/97, Canon, EU:C:1998:442, § 28)*

product. This allows them to differentiate it from other products or services that come from a different source, without any chance of confusion[57].

In the case *Hanover Star Milling Co. v. Metcalf* (1916)[58], Two companies are engaged in a dispute over the exclusive use of a trademark for flour, as one company argues that it has invested a greater amount of money in establishing its brand in specific regions.

The question at hand pertains to whether a trademark can solely get protection in markets in which it has been utilized, and whether the exclusive right to use a trademark is contingent upon its priority of acquisition. "The Hanover Star Milling Company" filed a lawsuit against Metcalf and Allen & Wheeler Company for the utilization of the "Tea Rose" trademark for flour. The dispute revolved around inquiries regarding the geographical scope of trademark rights and the proof of usage and market penetration.

The Court of Appeals rendered a verdict in favor of Hanover Company in one case versus it in another, based on the specific allegation and the facts given. The Supreme Court examined the matter and issued an order in favor of Hanover Company against Metcalf for engaging in deceptive advertising by falsely promoting Steeleville's Tea Rose flour as Hanover's[59].

2.1.1 The concept of the possibility of confusion functioning

Proving the risk of confusion along with identifying the appropriate components is a legal matter. The above variables are determined by the applicable laws, specifically the EUTMR and case law. For example, the resemblance of goods and services is a requirement for the risk of confusion[60]. Regarding this matter, the global assessment of the conceptual similarity of the marks in question should be determined by considering the entire impression conveyed by the marks, with special attention to their distinctive and dominating elements[61]. Determining the pertinent factors for assessing whether this requirement is satisfied is also a legal matter. The Court has established that the similarity of goods and services can be determined based on their inherent qualities and intended functions. [62]

These variables are also legal ideas, and creating guidelines to assess them additionally constitutes a matter of law. Yet, the issue at hand is whether and to how far the legal standards for identifying, for example, 'nature', are met in a specific case. The information required includes how they are utilized, whether they are supplementary or not, whether they are in a contest or may be substituted for one another, their propagation routes or areas of sale, their target audience, and their typical origin. [63].

2.2 Article 8(1) EUTMR

Article 8 of the European Union Trade Mark Regulation (EUTMR) grants the proprietor of a pre-existing right the ability to challenge the registration of subsequent EUTM petitions in several circumstances[64].. In this context, the author will focus on the analysis of dual

[57] *29/09/1998, C-39/97, Canon, EU: C:1998:442, section 28*
[58] *Supreme Court of the United States - 240 U.S. 403, 60 L. Ed. 713, 36 S. Ct. 357, 1916 U.S. LEXIS 1463, SCDB 1915-112*
[59] *kalistratova_zhanna, Modern Concepts of Trademark Protection, Central European University (CEU), p34*
[60] *Article 8(1) EUTMR*
[61] *Ulrich Hildebrandt, Trade Mark Law in Europe: Case Law of the Court of Justice of the European Union, Publisher Kluwer Law International B.V., 4th edition,2024, p172.*
[62] *29/09/1998, C-39/97, Canon, EU:C:1998:442).*
[63] *Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2, Final Version, 2020, P728*
[64] *Daniel R. Bereskin, Trademark Dilution and Free Riding, Publisher Edward Elgar Publishing, 2023, p194.*

identity and the probability of confusion within the scope of Article 8(1) of the European Union Trade Mark Regulation (EUTMR). An opposition under Article 8(1) of the European Union Trademark Regulation (EUTMR) can be grounded on preexisting trademark registrations or usage, as well as earlier well-known marks that are recognized.[65]

2.2.1 double identity based on Article 8(1)(a) EUTMR

Oppositions based on identification are allowed under Article 8(1)(a) of the European Union Trade Mark Regulation (EUTMR). According to Article 8(2) of the EUTMR, if the proprietor of a previous trademark objects, an EUTM application will not be approved if it is the same as the previous trademark and if it is for identical products or services that the previous trademark already has protection for.[66]

Article 8(1)(a) of the European Union Trademark Regulation (EUTMR) stipulates that there must be an exact match between the signs being compared and the products or services in question. This scenario is commonly known as 'dual identities'. The determination of whether there exists a dual identity is a legal conclusion that must be determined by directly comparing the two contradictory indicators and the goods/services in question. In cases where a double identity is proven, the opponent does not need to prove the possibility of confusion in order to win; the protection provided by Article 8(1)(a) of the European Union Trade Mark Regulation is absolute. Therefore, in cases when there is a dual identity, there is no requirement to assess the probability of confusion, and the opposition will be unconditionally supported[67].

2.2.2 Article 8(1)(b) of (EUTMR) and assessment of the probability of confusion.

According to the European Union Trade Mark Regulation (EUTMR)[68], if a request for a European Union Trade Mark (EUTM) is opposed, it will not be registered if there is a likelihood of confusion with an earlier trademark. This likelihood of confusion can arise from the identity or similarity between the trademarks and the goods or services they cover. It also includes the possibility of the public associating the EUTM with the earlier trademark. Therefore, unlike instances in which one has a double identity as mentioned earlier, when there only exists a similarity between the symbols and the products or services, or when just one of both of these elements is identical, an earlier trademark may challenge an EUTM application under Article 8(1)(b) EUTMR only if is a likelihood of confusion.

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2.3 Interrelation of Article 8(1)(a) and (b) EUTMR

While the particular circumstances outlined in Article 8(1)(a) and (b) of the European Union Trade Mark Regulation may vary, they are interconnected. Therefore, if Article 8(1)(a) EUTMR is the only ground claimed but there is no clear similarity between the signs as well

[65] *(Article 8(2)(c) EUTMR)*
[66] *Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2, Final Version, 2020, P724*
[67] *ibid, P724*
[68] *Article 8(1)(b) of the European Union Trade Mark Regulation (EUTMR),*

as the products or services, the Office will still consider the case under Article 8(1)(b) EUTMR. This article calls for there to be some degree of similarity between the signs and products or services, as well as a likelihood of confusion. Similarity encompasses scenarios in which the trademark rights and the goods or services in question are similar, as well as scenarios in which the marks are identical and the items or services are similar, or the reverse. Similarly, if an opposition solely relies on Article 8(1)(b) of the European Union Trade Mark Regulation (EUTMR) and fulfills the criteria of Article 8(1)(a) of the EUTMR, it will be addressed under the subsequent rule with no undergoing any assessment under Article 8(1)(b) of the EUTMR.[69]

3 . Defining the Concept of Likelihood of Confusion

The evaluation of the probability of confusion is a mathematical process used in cases where there is a conflict between trademarks in procedures before the Office, the General Court, and the Court of Justice, as well as in infringement proceedings before the courts of the Member States. Neither the European Union Trademark Regulation (EUTMR) nor Directive 2015/2436 37 provide a specific definition of the risk of confusion or a clear explanation of what exactly 'confusion' entails. It is well-established in legal precedent that the concept of likelihood of confusion refers to circumstances where: 1. the public directly confuses two opposing trademarks, mistaking one for the other; 2. the public associates the conflicting trademarks and assumes that the items or services in controversy come from the identical or economically related companies (likelihood of association). The thesis provides a more detailed analysis of both of these circumstances.

The simple occurrence of associating a later trademark with an earlier trademark does not establish a probability of confusion. The judiciary has also determined that marks with highly unique characteristics are afforded greater protection than marks with a less distinctive personality. The idea of the possibility of confusion, as established by the Court, should be considered as a legal term instead of solely a theoretical or factual evaluation. However, its examination does involve considering some features of customer cognitive processes and purchasing patterns. [70]

3.1 Likelihood of confusion and the likelihood of association

In the case of Sabèl v. Puma, Rudolf Dassler, the Federal German Court of Justice thoroughly examined the probability of confusion[71]. At first, the German Patent Office dismissed the opposition since the two signs were not the same. Puma appealed with the German Federal Patents Court and was victorious. Sabel appealed with the Federal Court of Justice. The Federal Court of Justice tentatively determined that there was a potential for confusion due to the resemblance in the 'semantic content' of the signs, meaning that both signs depicted bouncing felines. The court temporarily halted the proceedings to inquire if the resemblance in semantics was enough to determine that the marks were confusingly similar.

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[69] *Abbe Brown, Smita Kheria, Jane Cornwell Contemporary Intellectual Property: Law and Policy, Publisher Oxford University Press, 2023, P 622*
- Daniel R. Bereskin, Trademark Dilution and Free Riding, Publisher Edward Elgar Publishing, 2023, P202
Justine Pila, Seville's EU Intellectual Property Law and Policy2022, P449
- Tamara Capeta, Iris Goldner Lang, Tamara Perišin, The Changing European Union: A Critical View on the Role of Law and the Courts· Publisher Bloomsbury Publishing, 2022, p101.
[70] *Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2ibid, P725*
[71] *(11/11/1997, C-251/95, Sabèl, EU: C:1997:528).*

The following excerpt provides an explanation of the 'global appreciation' test used to determine confusing similarity, as outlined by the JEU.[72]

The Directive's counterparts to Article 8(1)(b) EUTMR and the explanatory statements of the EUTMR made it clear that the concept of "likelihood of confusion" pertains to confusion regarding the source of the product or service. However, the Court had to examine this matter more closely due to conflicting interpretations of the terms "likelihood of confusion" and "likelihood of association," both of which are mentioned in Article 8(1)(b) EUTMR.

The resolution of this issue was necessary due to the contention that the scope of association was wider than that of confusion. This broader scope includes situations where a subsequent trademark evokes an earlier trademark in the consumer's mind, but the consumer does not perceive the goods or services as originating from the same source. The central question in the Sabèl case was whether the phrase 'the probability of confusion includes the likelihood of association' encompassed situations where trademarks were associated but did not cause confusion regarding their origin. The Court determined that the probability of connection is not a substitute for the probability of confusion, but rather it contributes to establishing the extent of confusion.

Thus, in order to determine the possibility of misunderstanding, it is necessary to establish confusion regarding the source or origin[73].

in the Canon case, the Court provided a clear definition of confusion regarding origin. It stated that confusion arises when there is a risk that the public may mistakenly believe that the goods and services in question originate from the same company or from companies that are economically connected. This possibility is what is considered a likelihood of confusion. The presence of a likelihood is contingent upon the public's perception that the goods or services originate from the same entity or, in some cases, from related entities with economic ties (with an emphasis added).

The concept of "likelihood of confusion" refers to the confusion that may arise over the commercial origin of a product or service, particularly when there are economic connections between the parties involved. The crucial factor is that the general public perceives that a single entity has complete control over the goods or services in question. The Court has not provided an interpretation of economically related operations specifically concerning the probability of confusion.

However, it has done so in the context of the free circulation of commodities or services. The Court declared in an Ideal Standard that the following cases are encompassed: products that are introduced into the market by the same business, by a licensed manufacturer, by a parent company, by a subsidiary within the same corporation, or by a particular distribution. ... In each of the described scenarios, control is held by a singular entity: the conglomerate of businesses for items released by its subsidiary, the producer for products sold by a distributor, and the person who grants the license for products sold by a licensee.

Regarding a license, the licensor has the ability to regulate the quality of the licensee's product by incorporating contractual terms that mandate the party obtaining the license to

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[72] Patrick R. Goold, A Critical Introduction to Intellectual Property Law: Texts, Cases and Materials, Publisher Cambridge University Press, 2024, p485

[73]Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2, ibid, P727

adhere to their directions and allowing the licensor to independently confirm this compliance. The purpose of the trademark is to ensure that the origin remains consistent. This is determined not by the company that makes it, but rather by the company's position of supervision.[74]

Therefore, if the consumer believes that the goods or services are being sold by the trademark proprietor, it will be assumed that there is an economic connection. The kind of oversight is presumed to be present in instances where companies are part of the same corporate group, and additionally in cases involving licensing, merchandising, or distribution agreements.

This control is also expected in all other circumstances where consumers usually presume that the utilization of a trademark requires the consent of the trademark proprietor. Hence, the concept of possibility of confusion encompasses two scenarios: when the customer directly mistakes the trademarks themselves; or when the customer establishes a relationship between the competing indications and concludes that the goods/services involved originate from the same or economically related entities.

Therefore, if the recognition of a subsequent trademark only reminds one of a previous trademark, but the customer does not think that they come from the same source, then this connection does not lead to a probability of confusion, even though there is a likeness between the marks.[75]

3.3 Likelihood of confusion and distinctiveness of the earlier mark

The court has determined that the uniqueness of the earlier trademark is a significant factor in determining the likelihood of confusion. This means that the more distinctive the earlier trademark, the higher the chances of confusion. Additionally, trademarks that have a highly distinctive character are afforded greater protection compared to trademarks with a less distinctive character. However, trademarks with low distinctive character will have a reduced scope of protection.

These results imply that the increased uniqueness of the earlier mark can play a crucial role in determining the probability of confusion, even when there is a low similarity between the marks and the goods and services[76]. If the prior trademark has low distinctiveness, it can decrease the probability of confusion.

3.4 Determining the probability of confusion:

inquiries regarding factual and legal matters the concept of possibility of confusion is a legal principle that goes beyond a simple factual assessment of the customer's logical judgments and emotional preferences that influence their cognitive activity and purchasing behaviors. Consequently, determining the probability of confusion relies entirely on legal inquiries and factual evidence.[77]

3.4.1 Fact and law: similarity of goods, services, and signs

Establishing the risk of confusion and determining the relevant criteria is a legal matter. These factors are determined by the applicable laws, including the EUTMR and case law. For

[74] *(22/06/1994, C-9/93, Ideal Standard, EU:C:1994:261, § 34, 37*
[75] *Article 8(5) EUTMR*
[76] *(11/11/1997, C-251/95, Sabèl, EU: C:1997:528, § 22).*
[77] *The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions Publisher Springer Nature, 2019, p145.*

example, the resemblance of products and services is a requirement for the possibility of confusion. Determining the pertinent factors for assessing whether this requirement is satisfied is also a legal matter.

The Court has established a set of criteria to assess the similarity of goods/services, including their inherent characteristics, intended function, manner of utilization, complementarity, competition or interchangeability, distribution channels/points of sale, target audience, and customary origin[78]. is provided. All of these variables are legal notions, and creating the criteria to assess them is also a matter of law. Even so, the issue at hand is if and to what extent the legal standards for establishing, for example, the 'nature' of an instance are met.

Likewise, in the context of comparing signs, the requirement for signs to have the same identity or likeness is necessary for the possibility of mistakes. The issue at hand is that a legal determination considers the possibility of signs having a conceptual similarity under the EUTMR. However, it is a matter of factual analysis to determine, for example, that the word 'fghryz' holds no meaning for the Spanish audience.

3.4.2 Fact and law: evidence in opposition

In legal procedures, the parties are required to assert and, if necessary, substantiate the facts that back up their views. In opposing proceedings, the Office is limited in its assessment of the evidence, facts, and reasoning presented by both sides, as well as the requested remedy. Hence, it is the responsibility of the adversary to articulate the factual grounds upon which the assertion of similarity is founded and to present corroborating evidence. When comparing wear-resistant cast iron to implants for medical use, the Office is not responsible for determining whether wear-resistant cast iron is utilized for medical implants. The opposing party must provide evidence to support their claim, as it appears unlikely.[79]

The applicant's acknowledgment of legal concepts is inconsequential. The Office is still responsible for analyzing and making decisions on these topics. The EUTMR does not contradict this statement. It only applies to the Office's assessment of the facts, evidence, and arguments, and does not cover the legal examination of these. Thus, the parties can reach a mutual understanding of the established evidence, but they cannot decide whether these facts are adequate for establishing the appropriate legal terms, such as the similarity of products and services, the similarity of the signals, and the possibility of confusion.

The Regulation (EUTMR) does not prohibit the Office from considering facts that are already widely known or can be easily found in public sources. For instance, EU consumers will readily recognize PICASSO as a renowned Spanish painter[80]. Nevertheless, the Office is not authorized to provide spontaneous information or reasons (such as reputation or level of expertise of the prior mark).

Furthermore, it is important to note that while particular trademarks may be frequently utilized in everyday language to refer to the products or services they represent, this is not to be regarded as definitive facts by the Office. Put simply, trademarks ought not to be utilized or understood as though they were just a common phrase or a broad classification of items or services.

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[78] *(29/09/1998, C-39/97, Canon, EU: C:1998:442)*
[79] *(14/05/2002, R 684/2000-4, Tinox / TINOX)*
[80] *(22/06/2004, T-185/02, Picaro, EU: T:2004:189; 12/01/2006, C-361/04 P, Picaro, EU: C:2006:25).*

3.4.3 Evaluation of the Relevant Factors for Establishing a Likelihood of Confusion

The crucial moment for evaluating the prprobability of confusion is the day when the opposition resolution is made. If the opposing party depends on the increased uniqueness of a previous trademark, the requirements for this should have been satisfied before the submission date of the EUTM petition (or any prioritization dates) and must still be met at the time the determination is made. Standard protocol in the office is to presume that this is true unless clear indicators suggest otherwise. The relevance of the ruling dates only applies when the EUTM petitioner depends on a diminished level of safeguarding (vulnerability) of the prior trademark.

probability of confusion is the day when the opposition resolution is made. If the opposing party depends on the increased uniqueness of a previous trademark, the requirements for this should have been satisfied before the submission date of the EUTM petition (or any prioritization dates) and must still be met at the time the determination is made. Standard protocol in the office is to presume that this is true unless clear indicators suggest otherwise. The relevance of the ruling dates only applies when the EUTM petitioner depends on a diminished level of safeguarding (vulnerability) of the prior trademark.

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3.4.4. Factors for evaluating the probability of confusion

The assessment of the possibility of confusion involves a systematic evaluation of several elements., Evaluation of goods and services. Pertinent audience and level of attentiveness, Assessment of signs. Uniqueness of the prior mark, Consideration of additional elements, and Global evaluation of the probability of misunderstanding[81]

4. Doctrine's position

Trademarks are considered the most familiar product identifiers[82]. To this point, the legal doctrine agreed on the essence of the trademark, determining it as: "the symbol that is used to distinguish the goods and services of a merchant from the other."[83] Whether it was the name, logo, symbol, or other means utilized to differentiate goods from contending goods in the market to clarify the "product's source[84]. In this regard, the symbol (TM) is defined as" a distinctive sign or indicator of the category used by the legal entity or other individuals, business, or to classify the source of its goods uniquely.

A "service mark" also plays a similar mission as a trademark, identifying and distinguishing services' origins and quality rather than goods[85]. It is worth mentioning that the

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[81] *Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2, Final Version, 2020, P730*

[82] *Sandy Norman, Copy Right in Public Libraries, Fourth Edition, Library Association Publishing, London, P69.*

- What is trademark, ABA, section of intellectual property law,, 3rdedition,2009,p6.

[83] *David G. Resenbaum, Patents, Trademarks & Copy right, Chelsea House Publishers, 1994, P 32-34*

[84] *Stephen Elias, Richard Stim Trademark: Legal Care for Your Business & Product Name, 9th Edition, Publisher: Nolo, Year: 2010, p3.*

- Jessica N. Marshall, Domain Names and Trade Mark at the Inter Section, US Patents, Trade Mark Office, Washington

[85] *Gail Hiduke, J. D. Ryan, Small Business: An Entrepreneur's Business Plan, Cengage Learning, 2013, P 284.*

- Patent and Trademark Office (U S), Protecting Your Trademark: Enhancing Your Rights Through Federal Registration, Basic Facts about Trademarks, Government Printing Office, 2015, P1.

-Gordon V. Smith, Trademark Valuation, John Wiley & Sons, 1997, P40.

-Timothy Lee Wherry, Trademarks in the Digital Age, publisher Scarecrow Press2004, P9.

-Carl Roper, Trade Secret Theft, Industrial Espionage, and the China Threat, CRC Press, 2013,p186.

-Bruce R. Hopkins, David Middlebrooks Nonprofit Law for Religious Organizations: Essential Questions & Answers, John Wiley & Sons, 2008, p236.

-Don R. Leet, Institutions and Markets, Council for Economic Educat, 2003, P54.

trademark" is diverse from the patent and Copyright. In this term, copyright protects the original work of art, literature, or original art[87] indifferent standards of creative levels, [88]While a patent protects inventions.[89]

4.1 Judiciary's concept of trademark

The Jordanian judiciary defines a trademark as a sign that distinguishes the goods of its proprietor from those of other people[90]. It consists of letters, drawings, symbols, or a mixture of these things with a distinctive character[91] If they are manufactured, produced, certified, traded, or offered for sale."[92] The author believes that the text of article two of the JTML- before its amendment, this law needs to identify the broad meaning of the trademark. It only provides a narrow concept of the industrial and commercial trademark without the service mark.[93] The trademark industry has witnessed many developments in the last century. For instance, Communication between countries became easy, leading to increased trade, goods, and services between countries. The concept of trademarks has been emphasized again in sector 2(1) (ZB) of the law[94.]

The Indian Supreme Court has ruled that a trademark shall fulfill mark criteria. To this point, the Supreme Court indicated that the mark needs to identify the product or services from those of others.[95] In this regard, the French Court of First Instance in Paris defined a trademark "as a way to guarantee the origin or source of the goods and distinguish it from others' goods." In another decision, the American Ninth Circuit decision, *Lahoti v. Vericheck, Inc.*, determined when a trademark is "distinctive," and therefore, it deserves to be subject to federal protection[96]

4.2 Trademark forms, and criteria

The Jordanian legislator dealt with the types and forms of trademarks in Articles (7 and 8) of the Jordanian Trademark Law. The author will explain these types and forms as follows:

4.3 Criteria for determining the goodwill of the mark

It is known that the legal protection of the famous trademark is based on the extent of the fame of this mark and finding a unified standard to know whether the mark is well-known. The General Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) held in September 1999 a joint session during which a recommendation was developed related to the famous trademark [100].

-Patti Mack-Tucker, What You Should Know Before Starting a Business, Author House, 2010, p41.
-Burton A. Amernick, Patent Law for the Non-lawyer: A Guide for the Engineer, publisher Technologist, and Manager Springer Science & Business Media, 2012, p118.
Martha Sargent, Retire-And Start Your Own Business, Nolo, 2008, p209.
[87]Deborah Morley, .Charles SParker, Understanding ,Computers: Today and Tomorrow, Comprehensive publisher CengageLearning, ,2014p.,634
88Lior Zemer, The Idea of Authorship in Copyright, Publisher Ashgate Publishing, Ltd., 2007, p52
[89] Timothy Lee Wherry, The Librarian's Guide to Intellectual Property in the Digital Age Copyrights, Patents, and Trademarks, American Library Association Chicago and London 2002, P117.
-joseph p. Kennedy and Wayne h. Watkins with Elyse n. Ball, how to invent and protect your invention: a guide to patents for scientists and engineers, a john Wiley & sons, In, publication 2012, p134
90Zain Al Deen, Salah. (). Industrial and Commercial Property (1st ed), Dar Al Thaqafa, Amman, Jordan 2000,p 22.
[91]Decision No. 49/88 Amended Supreme on 31/12/1988 AD, Journal of the Jordanian Bar Association.
[92] Trademarks Law No. (33) of 1952
[93] Trademarks Law No. (33) of 1952 published in the Official Gazette pg. (243) No. 1110 dated 6/1/1952 and its amendments up to Amendment No. (15) of 2008 published in the Official Gazette p.1286) Number 4900 dated 4/16/ 2008.
[94]The Indian Trade Mark Act,1999
[95]Kislay Komal, Trademark Meaning Objective and Infringement, September 29, 2017, www. Setindiabiz .com
[96]Lahoti v. Vericheck, Inc., No. 08-35001, http://www.nossaman.com/what-makes-trademark-distinctive-9th-circuit-clarifies
[100] WIPO, Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999, P3. https://www.wipo.int/edocs/pubdocs/en/wipo_pub_833-accessible1.pdf.

The states of the Paris Union used several guidelines and criteria to determine when the mark was famous. Those criteria are based on the extent to which the mark is known or known to the relevant audience segment. The known to an appropriate audience can be, for instance, determined through surveys of consumption patterns and consumer opinion surveys. Another criterion is the extent to which the mark is used in any aspect of use, area, and geographical scope. Besides that, the duration of advertising and promotion of the mark in any way of existence, the degree of success of advertising campaigns, their geographical scope, the display of products by the mark in international internal markets and exhibitions, the number of products offered in the markets and the volume of sales can decide highly whether the mark is famous or not. The number of countries where the mark or applications for registration are registered, their geographical scope, and the period stipulated for their registration can also indicate whether the mark is famous.[101]

Furthermore, the mark is not required to be registered in all countries in the name of the mark proprietor. The mark may be owned by several companies operating in different countries and regions but belonging to one group or having close ties or relations of participation and cooperation. Besides that, evidence of successful enforcement of the mark rights in neighboring countries, in particular, the recognition by the competent authorities that it is a famous mark. The word "enforcement" should be interpreted broadly, including opposition procedures in which the proprietor of the well-known mark is prevented from registering a mark similar to his mark. Also, the value of the mark may indicate that the mark is famous.

5. Trademark forms.

The Law stipulates that The trademark to be registered must consist of names, letters, drawings, numbers, shapes, colors, or a mixture of these things of a distinct character and can be perceived by looking in a way that ensures that the goods or services of the trademark proprietor are distinguished from the goods or services of other people[102]. Accordingly, the trademark can take the following forms:

51 Names.

The Jordanian legislator has allowed the merchant to take a name or surname as a trademark but provided that this name or surname has a distinctive form from other names. The name or surname of others may be used as a trademark, provided that he agrees to do so. If the name or surname used is for a deceased person, the consent of his heirs must be obtained.

5.2 Letters and Numbers.

The Jordanian Supreme Court of Justice held that the number might be registered as a trademark if this number is composed alone as a trademark. However, suppose it is part of the trademark or is highlighted in a particular form. In that case, there is nothing to prevent it from being registered. The legislator also permitted the registration of a trademark in certain letters. However, letters and numbers must be considered trademarks so they do not lead to public fraud[103].

[101] *Roberta Jacobs-Meadway, Proving Fame for Trademark Dilution Claims, the lexis advisor practice advisor journal, August 26, 2019.,*
[102] *JTML, Article,7.*
[103] *The Jordanian Supreme Court of Justice held in its decision No. 4/53*

5.3 Symbols, pictures, inscriptions, and drawings.

Symbols are those stereoscopic visual drawings such as the face of a human being, animal, or other but concerning images. They are meant to be photographs[104], such as if a person uses his image as a trademark; for example, the founder of KFC restaurants uses it as a trademark. At the same time, the inscriptions were not an example; the founder of KFC restaurants uses his image as a trademark.

At the same time, the Jordanian Supreme Court of Justice did not consider the inscriptions in its decision No. 12/96. Inscriptions are trademarks but include how the trademark can be placed on products. 4: Colors. The Jordanian Supreme Court of Justice considered that there was no similarity between the two trademarks that would lead to public fraud if the color of each mark differed.[105] Protection of the famous mark in Jordan: A-Protection of preventing the registration of a mark similar to a well-known trademark, A trademark that matches, resembles, or constitutes a translation of a famous trademark to use it to distinguish goods identical or similar to the goods for which it is well-known, and that would create confusion with the famous mark or use it for other goods in a manner that is likely to cause harm to the interest of the proprietor of the well-known trademark and suggest a link between it and these goods, as well as marks that resemble or match honorary emblems, flags and other emblems, and names or abbreviated names of international or regional organizations or that offend to our historical values[106].

6. Domestic trademark

In actual reality, trademarks come in two forms: the registered trademark and the unregistered trademark. Usually, unregistered trademarks are regulated by the common law of passing off. Both trademark types share common characteristics of domesticity and specificity. Domesticity is the concept that a trademark will only be protected within the jurisdiction in which it is registered or used. For registered trademarks, domesticity can be established by reference to the Act states.

In this regard, 'the registered trademark has exclusive rights in the trademark which are infringed. The concept of domesticity also applies to unregistered trademarks. The clearest example of this issue is the case of Anheuser-Busch vs Budjovicky Budvar[107]. In this case, the Court of Appeal of the European Communities (now 'the General Court') followed passing off in determining that goodwill, a necessary condition for passing off, has a territorial component. Global recognition of territoriality, or domesticity, of unregistered trademarks is not as straightforward as with registered trademarks. The question is whether to protect the unregistered trademarks of commercial organizations that do not trade within the jurisdiction. Does this mean that unregistered trademarks, at least in some corners of the globe, do not demonstrate domesticity? The author argues that the answer is no because in such cases where the soft line approach is followed, the court will look for evidence of reputation in the trademark within the jurisdiction in question.

The question is not about domesticity; it is instead a question of whether the court is prepared to look for goodwill on the part of the trademark holder or merely reputation. Whichever approach is correct, in thought, unregistered trademarks demonstrate

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[104] *Zaineddin, Salah Salman, Branding in Jordanian Law, Journal of Law (Kuwait) m(33), Issue (4), 2009, p. 150. https://zaineddin.com/ar/home-arabic*

[105] *The Jordanian Supreme Court of Justices, in its decision No. 16/1964,*

[106] *JTML, Article 8.*

[107] *Murray, Andrew D. "Internet Domain Names: The Trade Mark Challenge." International Journal of Law and Information Technology, vol. 6, no. 3, 1998, pp. 285-312. P291*

domesticity[108]. The second characteristic of trademarks in actual reality is specificity. Nevertheless, the trademark can only gain vital protection if there is a likelihood of confusion on the part of the consumer. Protection is limited to those products as the consumer is likely to need clarification on similar trademarks on entirely dissimilar products, such as Penguin chocolate biscuits and books.[109]

7. Trademark Rights

The trademark proprietor can prove his right to the trademark whether the trademark is registered or not. In this regard, trademark rights have specific features, such as limited rights.

7.1 The features of the trademark right

The trademark proprietor can prove his right to the trademark, whether registered or not. In this regard, the author has divided this part into three sections, illustrating the limits of trademark rights in the first section, the permanent rights in the second section, and the exclusivity rights in the third section[110.]

7.2 The trademark right is limited

As mentioned above, the trademark proprietor enjoys several rights and excellencies due to such a proprietorship. The trademark proprietor cannot file a claim against all parties for exercising rights related to his trademark. However, such a claim can be filed against those in the same industry. The logic behind the trademark function is to enable consumers to distinguish products of the same type.

Thus, the trademark proprietor's right is represented in preventing others from using or registering the same trademark and simultaneously protecting the rights of consumers. [111]To this point, Jordanian trademark law suggests in Article 26 that a trademark registration shall grant the proprietor of the trademark the right to use the trademark independently if the registration was carried out following the law.[112]

Article 713/1 of the IPRS French law suggests that the registration of a trademark grants its proprietor the right of proprietorship over the trademark for the represented goods and services. " In this regard, the French Court of Cassation decided to cancel the judgment issued by the French Court of Appeal in Paris, emphasizing the first instance's court judgment issued by the court. The case was about Avera Company filing a lawsuit against two organizations for using the symbol representing the company's trademark and requesting to stop using the symbol and any imitation by organizations.

However, the French court of the first instance and the court of appeal decided to refuse the request filed by Avera Company because the reason for such refusal is that the

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[108] *ibid. P291*

[109] *ibid P291*

[110]*At the national/regional level, trademark protection can be obtained through registration, by filing an application for registration with the national/regional trademark office and paying the required fees. At the international level, you have two options: either you can file a trademark application with the trademark office of each country in which you are seeking protection, or you can use WIPO's Madrid System.*

[111]*Torremans, Paul. Holyoak and Torremans intellectual property law. Oxford University Press, USA, 2019.p125*

[112]*Article 26: The register is permitted to do the following things upon the request of the trademark proprietor:*

1- *The register can correct any error in the name or address of the trademark proprietor*
2- *The register can record the changes that occurred to the name or address of the proprietor of the trademark when having changes to it*
3- *The register can delete any type of product that is mentioned in the trademark records*
4- *The register can record any waiver or notice that is related to the trademark. That applies provided that such waiver or notice doesn't grant exaggerated rights.*

The register can delete any trademark record. An appeal can be filed against each decision issued by the council in under this paragraph before the Supreme Court.

organizations operate in a field that differs from that of Avera Company. Furthermore, this right involves the elements that constitute the trademark.

The right is to be used exclusively to allow people to distinguish the products from the products of other trademarks. The trademark proprietor is not permitted to enjoy an exclusive right to use any element of the trademark elements. For instance, the proprietor cannot enjoy an exclusive right to use a specific color because anyone can create the symbol of his trademark however he wants.

In this regard, Article 4/4 of the Jordanian trademark law suggests that the trademark can include one color or several. In this case, the register or the Jordanian court can assess the distinguishing feature of the trademark.[114] The author believes the elements used in a trademark symbol can be used in other trademarks because they apply to provided elements used differently to avoid confusing the consumer. In this context, the Palestinian Court of Justice issued a judgment regarding a cigarette trademark named (Belmont) and other similar ones called exipamild-belmont and Belmont 2002. It suggests significant differences between those trademarks; thus, it adds that the consumer will be clear.

7.3 The Limited Rights Restrictions

As mentioned above, any product may hold the same symbol of a trademark that provides products of a different type. In this context, The proprietor's trademark right is limited to the exclusive use of the trademark to distinguish his products from others of the same kind. In this regard, the limited trademark rights can be subject to some restrictions, such as quality, region, and elements.

7.4 Trademark Product Quality

The French (IPRS) law indicates that the registration of a trademark grants the proprietor proprietorship over the trademark to the goods and services present in this mark, as article 713/1 suggests. In this regard, the Jordanian Supreme Court of Justice counts that the protection of the trademark is limited to the protection of the products mentioned in the trademark registration certificate. The Jordanian court justified the decision because the trademark proprietor cannot prevent others from using the trademark to represent products of a different type. After all, the trademark registration goal is to enable the consumer to distinguish the products of the trademark from similar products.[115] Article 17 of the JTML has prevented registering a trademark identical to another that provides products of the same type.

If that occurs, the register can refuse to register the trademark until related issues are resolved. Following international law, the proprietorship of a trademark grants the proprietor a monopolized right as a natural result of the exclusive right of trademark proprietorship.

Moreover, the trademark exclusive right is permanent if the proprietor regularly renews the registration every ten years per the procedures stipulated in the aforementioned Intellectual property law. The exclusive right gives the proprietor the right to relinquish the trademark's proprietorship or mortgage or grant third parties a license to use it within the limits of the provisions of the law[116].

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[114] *article 7/4 of JTML states the following:"A trademark may be limited in whole or in part to one or more particular colors. In such instances, the fact that the trademark is limited to such colors shall be taken into consideration by the registrar or the court when deciding on the distinctiveness character of such trademark. If and so far as a trademark is registered without limitation to color, it shall be considered to be registered for all colors".*

[115] *Decision No. 87/39 is issued by the Jordanian Bar Association Journal. 1988, p. 689. the decision issued by the Jordanian Supreme Court in terms of Zara trademark. The latter decision holds No. 2006/344. It was issued by a judiciary consisting Of five members on 20/12/2006. The publications of the Adalah Centre*

[116] *Joanna SCHMIDT- SZALEWSKI & Jean- Luc PIERRE, Droit de la propriété industrielle, 4 è éd, Litec, Paris, 2007, p.235.*

Moreover, suppose the trademark proprietor's right is permanent in this way. In that case, it is a relative right, whether in terms of the type of products designated for placing the mark on them, to distinguish them in terms of the elements that make up the mark or in terms of the place of use of this mark, the trademark proprietor monopolizes its exploitation on The type of products to be distinguished from others, without other types that are not similar or similar.[117] Likewise, the right of the trademark proprietor to monopolize its exploitation is limited to the trademark as a unit distinct from others without the particulars that make up the trademark, as it is permissible to take some of these elements or part of them in the formation of another trademark that is distinct in its entirety from the original trademark and does not cause confusion or confusion with it. The author believes the trademark proprietor's right to his trademark is a limited right rather than an absolute right regarding products and services. The judgments of the judiciary adopt the same view. That means the trademark proprietor can only prevent others from using his trademark symbol if it is used to confuse or deceive the consumers.

7.5 The trademark right region limitation

The trademark is not protected outside the state. That does not apply if the trademark is registered in several countries according to special agreements. The same applies if the trademark is well-known globally, and the trademark protection in the latter case is provided outside the statesuggests the the inside safety the judgmentry issued a The French Judicia [118]. following (Despite that, copying a French trademark and using it on the web- such as Boos, is similar to Hugo Boss-isn't a crime, and that applies unless the products of the copied trademark are existent and traded on the lands of France)[119].

The same approach is adopted by the (WIPO). The latter organization suggests that the (IPRS) law applies to the lands on which the law was issued. That means the right to a trademark is enjoyed on the lands that the proprietor requested and acquired the protection of his trademarkof the rights the limitations enforced on the limited presentingAfter [120]. trademark proprietor, it is necessary to shed light on article 16/1 of the TRIPS Agreement. It states that the proprietor of a registered trademark shall have the exclusive right to prevent all third parties not having the proprietor's consent to use trade identical or similar signs for goods or services in the course which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.

A possibility of confusion shall be presumed in case of an identical sign for identical goods or services. The abovementioned rights shall not prejudice any existing prior rights or affect the possibility of members making rights available based on use. Thus, the TRIPS agreement states that the trademark proprietor enjoys the right to his trademark over the products and services he provides.

Therefore, under this agreement, the proprietor is only entitled to prevent others from using the symbol of the trademark if this symbol is used to confuse or deceive the consumers. Under the TRIPS agreement, the trademark proprietor can allow others to use the trademark symbol for products and services of the same type.

However, such permits must be provided by concluding a trademark license agreement. The same is suggested through the TRIPS agreement for protecting the well-known trademark, even if the trademark is not registered in the states that signed the TRIPS agreement.[121] Moreover, Article (11) of the directive EU 2015/2436 of The European

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[117] *Naim Salameh, The Legal Framework for the Advantages of the Right to a Trademark and the Expiration of Its Ownership, Analytical Comparative Study, Volume (24), Issue (3), 2018, p. 87.*

[118] *Jean BrnardBlais- droit des affairs-L.G.D.J-Paris-2000-p173*

[119] *Cass,COM 11 Janvier 2005-Dalloz-2005-428*

[120] *Fact Sheet Commercialising Intellectual Property: Spin-offs, European IPR Helpdesk Fact Sheet, (15 May 202), www.iprhelpdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Commercialising-IP-Spin-offs.pdf.*

[121] *article 26/3 of TRIPS Agreement.and Article 6 of the Paris Agreement (1967)*

Parliament and the Council states that " This Directive should not deprive the Member States of the right to continue to protect trademarks acquired through use but should take them into account only about their relationship with trademarks acquired by registration."

7.6 Trademark Permanent right

the trademark right is permanent. Although the duration of the trademark's proprietorship is limited to a specific period, it is renewable. Throughout time, the trademark shall become known and acquire more value. This reason justifies the continued retention of its own and the right of proprietorship.

The trademark in this regard is similar to the right of property in kind, and both are permanent rights. It is decided that trademark registration shall provide legal protection from being copied or used by others without the proprietor's permit.[122] It is agreed that trademark proprietorship is not based on registration only, which does not grant the right of proprietorship. The latter right is acquired through use. Registration is based only on a presumption of its use from the date of its making. This presumption may be refuted by those who decided to own the trademark earlier than the registration date and prove the priority in using it earlier.[123]

Article (20) of the JTML states: "The term of proprietorship of trademark rights is ten years from the date of its registration, but its registration may be renewed from time to time following the provisions of this law. At the expiration of the ten years, the registration shall be renewed[124]. In this regard, “The first registration of the trademark, and each renewal of that registration, shall be for no less than seven years, and the trademark registration shall be renewable indefinitely"[125].

The author notes that if the trademark proprietor follows the procedures for renewing the trademark whenever its proprietorship expires, his right to it becomes a permanent right, not a temporary one.[126] Some believe that the right to a trademark is temporary rather than permanent. [127]". That is because its proprietorship is limited to a specific time.

The law determines that period that begins from the date of registration of the trademark and confirms that "however, the trademark proprietor has the right if he wishes to Retain his trademark for another period may request the renewal of the registration of his trademark for another similar period and the renewal of the registration of the trademark can be carried out for a period or successive periods that may reach infinity, which may suggest that the right to a trademark is a permanent right that is not limited to a specific time, but that despite the possibility of the proprietor of the trademark may be renewed from time to time. The trademark right remains temporary because the proprietor fails to restore it and pay its fees. Accordingly, the author notes that the trademark proprietor has a permanent right to his trademark, which applies as long as he renews its registration according to the applicable legislation's provisions.

From this perspective, the proprietorship of the trademark extends to infinity. It should be noted that the right of trademark proprietorship as a permanent right differs from the right

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[122] *Recital 11, European Union Council Directive 2008/95, to approximate the laws of the Member States relating to trade marks (codified version), 2008 O.J. (L 199) 25. The same statement was made in Recital 10 in the Preamble to the Council Directive 89/104/EEC, O.J. (L 40) 1.*

[123] *Press Release, Antitrust: Commission consults on commitments offered by Samsung Electronics regarding use of standard essential patents, EUROPEAN COMMISSION (26 Jan. 2021) https://ec.europa.eu/commission/presscomer/detail/en/IP 13 971*

[124] *the European Court of Justice has adopted a flexible criterion for assessing the satisfaction implicit in the renewal of a trademark.*

[125] *Article (18) of the TRIPS .*

[126] *thomasmccarthy, McCarthy on trademarks and unfair competition § 18.3 (4th ed. 1992) ("A sale of a trademark divorced from its goodwill is characterized as an 'assignment in gross.'")*

[127] *Liguori, Jacopo, Slelective Distribution: The Consequences for Non-Lluxury Products, Mondaq (2020) https://www.mondaq.com/italy/antitrust-en-competition-/1014736/selective-distribution-the-consequences-for-non-luxury-products.*

of patent proprietorship, Industrial designs, and models whose proprietorship expires over a specific time**.**

7.7.1 Trademark Exclusive Right

The abovementioned paragraph sheds light on several rights and advantages that prove the right to a trademark. Among the other advantages that characterize the trademark proprietor's right is that it is exclusive to the products and services that distinguish his trademark. In this regard, this feature is explained through the following two subsections[128]

7.7.2 The Legal Framework of the Trademark Exclusive Right

Acquiring the proprietorship of a trademark provides its proprietor the right to monopolize its exploitation in distinguishing products and goods. Therefore, its proprietor has the right to prevent others from importing, selling, using, or distributing the products subject to this trademark distinction, meaning that only the trademark proprietor can deal with the products used.

The trademark is to be distinguished by any transaction except through the proprietor of the mark, which is equal to whether the trademark is registered. In non-registration, the proprietor enjoys the right to protect his trademark from a civil point of view through an unfair competition lawsuit. That is stated through the French intellectual property law. [129] Article (35) of the JTMLstates the following: "The registration under this law does not prevent any person from using his name, the name of his place of work, or the name of one of his predecessors at work, or from using any accurate description of his goods in terms of type and type and discharging merchandise. It notes that the trademark proprietor's exclusive right is considered permanent if he renews its registration according to the relevant regulations.

The trademark proprietor's exclusive right is to relinquish proprietorship, establish a mortgage, or grant licenses to use it following the law[130]. This principle is also established in French jurisprudence, where French jurisprudence considers the trademark proprietor's right to register the trademark as an exclusive right granted to the proprietor of the right to register the Trademark or to the licensee to use the trademark. Each has the right to use the trademark for his account, except for the right to dispose of it, as he must refer to the rest of his partners to obtain their consent to do so[131].

This right also entails that third parties are prohibited from using the same trademark or imitating it, or using the imitated or copied trademark in other than merchandise or service products that are similar or similar to that trademark that distinguishes the original mark, as this may result in confusion and confusion for the consuming public. The author believes that the trademark proprietor's right to monopolize exploitation is limited to the trademark as a whole as a single unit and does not include the particles that make up the trademark from letters and colors. It has allowed another merchant to use the colors or letters in a similar trademark.

The Egyptian Court of Cassation has confirmed the following: (The decisive factor in distinguishing between two signs is not that the sign contains letters, symbols, or images that are included in the other sign, but rather the general picture that is imprinted in mind as a result of the installation of these images or symbols, or the form that appears in another sign,

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[128]*Adam D. M, (2012). A Lockean Theory of Intellectual Property Revisited. San Diego Law Review, 49:1069.*
[129]*Chronopoulos. A, 2014, Goodwill Appropriation as A Distinct Theory of Trademark Liability: A Study on The Misappropriation Rationale in Trademark and Unfair Competition Law, Intellectual Property Law Section of the State Bar of Texas, 253.*
[130]*Dima. B, (2016). The Nature, Scope, and Limits of Modern Trademark Protection: A Luxury Fashion Industry Perspective. A thesis submitted for the Degree, School of Law, Faculty of Humanities, the University of Manchester.*
[131]*Garner, W. Michael. "Trademarks in Franchising: The Basics." Wake Forest J. Bus. & Intell. Prop. L. 14 (2013): 599.p602*

regardless of the elements from which it is installed, and whether The one in it shared one or more parts of what the other contained). In this regard, the French Court of Cassation stated the following: (The French Court of Appeal justified its decision when it studied the elements of similarity and the elements of difference between the emblems under comparison and concluded that the rectangular balls in dispute do not give the same general impression and that they were excluded from the right of the existence of a forgery as soon as they were not taken. Any possibility of confusion, even if the colors of the balls are similar).

To confirm that the right of the proprietor of the trademark is exclusive, article (713/1) of F I P L suggests that the registration of the trademark grants its proprietor the right of proprietorship over this trademark concerning the products and services it represents In addition, article (16/1) of the TRIPS agreement suggests that the proprietor of the registered trademark shall have the absolute right to prevent all third parties that have not obtained the consent of the proprietor of the trademark from using the same or a similar trademark in their commercial business for the same or similar goods and services, concerning which trademark is registered.

The TRIPS Agreement confirms that the trademark proprietor enjoys an exclusive right over his trademark and has the right to prevent third parties who have not obtained his consent from using the same or similar trademark in his business for the same or similar goods and services to those for which the trademark was registered. Such use may confuse if an identical trademark is used on an identical good or service.

Such right granted to the proprietor shall not prejudice any right that has already arisen or affect the possibility of granting Member States rights in trademarks. Based on usage[134()]. Likewise, the (WIPO) suggested that the effect of the rights conferred on trademarks (other than well-known trademarks) applies to goods or services that are identical or similar to the goods and services covered by the trademark registration. That indicates that the trademark proprietor's exclusive rights belong to the proprietor.

A specific good or service in one or more classes of goods and services, and another company may use the same trademark for different goods or services[135]. Accordingly, the author believes that the legislation is stable under comparison, the provisions of the comparative judiciary, the TRIPS Agreement, and the (WIPO), and that the right of the trademark proprietor over his trademark is exclusive in terms of the type of goods and services that distinguish it, or that may cause confusion among the consumers. It is not permissible for others to use the trademark only with the consent and permission of its proprietor through a license agreement to use it.

7.7.3 The exclusive appendix of the trademark proprietor and the practices Restricting competition.

It is permissible to define the scope of many trademarks, whether through the division of markets and regional distribution, or the division and distribution of products, but the EC opposes the agreements of the division of markets and regional distribution but agrees on the agreements of the division and distribution of products, and that In the (Phildar - Sirdar), where the Commission condemned the distribution and division of markets that took place through a greement of presence between the two brands (Phildar - Sirdar) together so that each of them would be present in the market together in solidarity and the (Sirdar) brand was

[134] *Wadlow, Christopher. "" Including Trade in Counterfeit goods": the Origins of TRIPs as a GATT Anti-counterfeiting Code." Intellectual Property Quarterly 2007.3 (2007): 350-402.p381*

[135] *Wilkins, Mira. "The neglected intangible asset: The influence of the trade mark on the rise of the modern corporation." Business History 34.1 (1992):pp 66-95.*

affiliated with an English company, and the trademark (Sirdar) belonged to an English company, and the trademark The other (Phildar) was affiliated with a French company, in 1964 before the United Kingdom joined the EC, the proprietors of these trademarks agreed not to sell products with the (Sirdar) mark in France, and not to market products bearing the (Phildar) mark in the United Kingdom. In addition, each of them committed themselves not to dispute the validity of the other mark, and the Commission condemned such an agreement.[138]

As for defining the common areas of trademarks by distributing products, the Commission supported its approval in this regard in this case, as each party in it was marketing tobacco under trademarks that would cause confusion and confusion for the consumer and according to the agreement concluded between the two parties, one of them committed not to the use of his trademark except for a specific type of tobacco. For its part, the EC has ordered that the imposition of restrictions on the use of the mark does not constitute restrictions on competition from the point of view of EU law in the absence of similarity and confusion in the consumer.[139]

Among the legitimate rights of the trademark, the proprietor is to give him a degree of supervision over the marketing of the products bearing his trademark, so he establishes a network of distributors in various styles through agreements that include many conditions, such as restricting the freedom to choose customers or suppliers, and the volume of products sold. The mark is to conclude undisputed right of distribution contracts with its distributors, with a promise to each of them of the right to distribute undisputed brand products in his region. However, these legitimate conditions no longer have the same effect and strength.

On the internal level, the legislator fears that these conditions do not contribute to facilitating the conditions of the dominant position or conflict with freedom of trade and equal opportunities for each merchant in his search for customers. At the European level, there is a fear that these conditions, if they are related to several EU countries, will not lead to the "non-fragmentation" of the market or their lack of specialization in abusing the dominant position. Therefore, if the principle of validity of these conditions continues, their effectiveness will become very fragile. The approach to the agreement of trademark exploitation should not aim at or result in the redivision of the market.

Accordingly, the author believes that the trademark proprietor's right over his mark does not violate the principle of freedom of competition and a restriction of competition, as the exclusive rights enjoyed by the trademark proprietor over his mark are legally regulated and recognized. Others have no right to use the mark except through its proprietor. Accordingly, the author notes that the law takes registration as a simple premise to obtain the right of proprietorship as it can prove that it is reversible and already establishes the importance of using the trademark.

The proprietor of a lapsed mark due to non-renewal has the exclusive right to re-file the same trademark within one year from the expiry date[142]. In this context, the Jordanian judiciary has settled that trademark registration is a presumption of the proprietorship of the mark; even if it is a presumption of proprietorship of the mark, it is permissible to demolish this presumption with counter-evidence, which has been recognized by the Court of Justice of the European Union and adhered to it.

The position of jurisprudence, law, and the judiciary regarding non-use is consistent with what the legislation and other jurisprudence have gone into under comparison, as non-use is a

[138] *Wilkins. M, (1992). The Neglected Intangible Asset: The Influence of the Trade Mark on the Rise of the Modern Corporation. Journal of Business History, Volume 34, No. 1, PP. 66-95.*
[139] *Georges Decocq, Ibid,p328.*
[142] *Abu-Ghazaleh Intellectual Property, https://www.agip.com/Agip _Country_Service.aspx?country _key=50&service_key=T*

reason for the expiration of the right to the trademark if the proprietor of the mark does not use it[143], he loses his right to it. However, if it is, there are convincing justifications for the judiciary that non-use results from force majeure conditions and reasons related to the market and the economic establishment of the trademark proprietor, as this prevents a ruling for the forfeiture of its proprietorship.

8. Conclusion

The Jordanian legislator did not give a criterion to differentiate between a well-known and famous trademark. Furthermore, the confusion between the concept of a well-known mark and a renowned trademark remains in legal literature through the interchange of these two concepts to indicate a famous trademark. This difference is because of the required level of fame to achieve the status of fame. However, generally, the difference between a well-known and famous trademark needs to be clarified in any international conventions or national laws of any studies and research by legal scholars. In this context, Frederick Frederic says that the ordinary concept of the term "well-known," according to the dictionary of Miriam Webster—means "widely known" and "known to many" (2010, the Nguyt). Moreover, Jordanian law considers both concepts as one thing; for example, the High Jordanian Court of Justice considered the mark to appeal to a famous, reputable mark in Jordan and nothing more. Protection should be given to the well-known trademark and not to the proprietor of the trademark because the protection of the well-known trademark has implications for the national economy and investment in addition to the citizen's money and health.

Chapter 2 trademarks types

Some jurists went to distinguish between the trademark and the industrial mark. However, this distinction has been resolved by the Jordanian legislator and considered that the work of the industry is the commercial business under its intrinsic nature, and this applies to trademarks and industrial marks, and this is what is stipulated in Article (6) of the Jordanian Commercial Law, where it says :(The following works under their self-nature are commercial businesses: Industrial works to be associated with the agricultural investment. The trademark can also be divided into an individual mark and a collective mark, and the definition of the collective mark is the same as that contained in Article (2) of the Trademarks Law, which is any mark used or intended to be used on any goods to indicate that those goods belong to the proprietor of the mark under its manufacture, production, trade or offer for sale.

Furthermore, the individual trademark may be owned by an individual or a company, while the collective trademark may be owned by more on one hand, such as the mark owned by several institutions, which the Jordanian legislator has dealt with in Article (10) of the JTMLwith the subject of collective marks, provided that the main difference between an individual trademark and a collective trademark is that the individual mark can be transferred and transferred without the need for the permission and approval of the Registrar of Trademarks, while the collective mark may not be transferred or transferred except with the consent and acceptance of the Registrar of Trademarks[144].

1. Famous and Well-Known Marks Practitioner's Toolkit

The issue of whether registering and making use of well-known and famous trademarks in specific countries should be a requirement for protection under national laws has not been explicitly stated in Article 6 bis of the Paris Convention or Article 16(2) and (3) of the TRIPS

[143] *Bouchoux, Deborah E. Intellectual property: The law of trademarks, copyrights, patents, and trade secrets. Delmar, Cengage Learning, 2013.p93.*
[144] *Salah El-Din El-Nahi, Brief on Industrial and Commercial Property, Dar Al Furqan for Publishing and Distribution , 1983 ,p.267.*

Agreement[145]. In this regard, the author will discuss some areas related to this issue as the following:

1.1 Famous mark

The Jordanian law defines a well-known trademark in Article 2 as a trademark with international fame whose fame exceeds the country of origin in which it is registered and has acquired fame in the relevant sector of the public in the Hashemite Kingdom of Jordan, taking into account the instructions issued by the Minister in this regard and following the obligations and duties arising under the agreements related to the protection of the famous trademark to which the Kingdom is a party, provided that these instructions are published in the Official Gazette.

The Jordan Supreme Court of Justice has also dealt in many of its rulings with the subject of the famous mark, including Resolution No. (8/1969), which stated 1f the trademark (Nashed Brothers) of Syrian nationality is known in Jordan, the registration of the mark (Nashed) to be placed on the same class of goods would lead to fraud of the public and the objector as a member of the public has the right to object to the application for registration of this mark as long as the Trademark Law prevents the registration of Any mark when this reason is available), with this type of mark.

The famous mark is a world-famous trademark whose fame exceeded the country of origin in which it was registered and gained the fame of the concerned public sector in The Hashemite Kingdom of Jordan[146]. The Jordanian legislator has granted the famous trademark special protection that exceeds the protection given to other trademarks. This protection was represented by the fact that the well-known mark is protected on all items without being registered with the Registrar of Trademarks.

1.1.1 The difference between a well-known mark and a famous mark.

The difference between a well-known and famous mark is essential since there is confusion between the concept of a well-known mark and a famous mark in the interchange of these two concepts to denote a renowned trademark. Sometimes, a famous trademark is evident. The famous mark is called the well-known mark, while the well-known mark is called the trademark between the two concepts.

This difference is because of the required level of fame to achieve the status of fame. However, the truth is that there is a well-known mark difference that is higher than the level needed to achieve the status of a well-known mark. Generally, the difference between a well-known and famous trademark must be clarified in any international conventions or international trademark laws of countries, as well as in studies and research by legal scholars or lawyers. In this context, Frederic says that the ordinary concept of the term "well-known," according to the dictionary, means "widely known" and "known to many"

Moreover, Jordanian law considers both concepts as one thing; for example, the Jordanian Supreme Court of Justice considered the mark to appeal to a famous, reputable mark in Jordan and nothing more. The Difference Between Famous and Well-Known Marks'

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[145] *Nobuyuki MATSUBARA, Protection of Well Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, p52. https://www.jpo.go.jp/e/news/kokusai /developing/training/ textbook/document/index/protection_of_well-known_and_famous_trademarks_2004.pdf.*

[146] *JTML Article 2.*

suggested recognizing a unique category of well-known marks, i.e., famous ones. Famous marks are traditionally thought to have a greater degree of credibility than well-known marks.

Therefore, it should have a broader scope of protection against unapproved usage of non-competing items or services.in this regard, *Andre R. Bertrand* suggests that the well-known brand appropriate, which is a trademark recognized by a significant fraction of the circles worried about the production, sale, or use of the items in concern and which is viewed as showing a specific origin of these items; and the very famous or famous brand name which would be a trademark known internationally. [147].

An exact, strict distinction between famous and well-known marks is impossible as these concepts are relative. The terms well-known and famous are typically used synonymously or conjunctively due to their equivalent foundation. However, many countries protect and acknowledge famous marks following unfair competition or tort liability law principles. In this context, a well-known mark can be defined as one known to a sizeable public section with a broad reputation reaching different items or services[148].

2. Well-Known Mark:

Defined are marks that are considered to be widely recognized. These insignia will be afforded greater safety. Individuals will be prohibited from registering or utilizing marks that are forgeries of established trademarks. For a trademark to achieve widespread recognition, it must be acknowledged by a pertinent demographic comprising numerous actual or potential customers, individuals engaged in the distribution process, and business services that deal with the corresponding products or services.[149].

2.1 Non-Registerable Trademarks

Trademark registration is prohibited for any kind of service, item description, or product that's misleadingly similar to or identically to an existing registered trademark. Geographic names, description terms, as well as surnames are not subject to registration. [150] The Japanese Patent Office, the Korean IP Office, and the Taiwan IP Office may list well-known marks, which can have both restrictive and relieving consequences for the proprietors of those marks. This is restrictive as it places the onus on renowned trademark proprietors to provide evidence of their marks' renown if they are not included in the list. It is a relief that they no longer endure this strain once their surnames appear on the list. It is recommended that other jurisdictions consider the utility of this Asian approach. [151]

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[147] *Kiny wiston, Famous And Well-Known Trade Marks Versus Domain Names In Cyberspace Posted 21 March 2016, https://www.kennywiston.com/famous- and-well-known-trade-marks-versus-domain-namescyberspace/#:~:text=The%20Distinction%20Between%20Famous%20and%20Well%2DKnown%20Marks&text=Famous%20marks%20are%20traditionally%20considered,non%2Dcompeting%20goods%20or%20services.*

[148] *Kiny wiston, Famous And Well-Known Trade Marks Versus Domain Names In Cyberspace Posted 21 March 2016, https://www.kennywiston.com/famous- and-well-known-trade-marks-versus-domain-namescyberspace/#:~:text=The%20Distinction%20Between%20Famous%20and%20Well%2DKnown%20Marks&text=Famous%20marks%20are%20traditionally%20considered,non%2Dcompeting%20goods%20or%20services.*

[149] *Vijay D. Kulkarni, Gadekar Vithal Laxman, legal aspects of business: e-Book for MBA, 1st Semester, SPPU, Publish Thakur Publication Private Limited, 2023, p216*

[150] *Vijay D. Kulkarni, Gadekar Vithal Laxman, legal aspects of business: e-Book for MBA, 1st Semester, SPPU, Publish Thakur Publication Private Limited, 2023, p216*

[151] *Sun, Haochen, and Barton Carl Beebe, eds. Charting Limits on Trademark Rights. Oxford University Press, 2023, p257.*

2.2 Determination of well-known mark

To determine whether a mark is considered well-known in a Member State, the competent authority considers several factors. These factors include the level of knowledge or recognition of the mark among the relevant public, the extent and duration of the mark's use and promotion, the geographical area in which the mark has been used and promoted, the history of registrations or applications for registration of the mark, the successful enforcement of rights related to the mark, and the value associated with the mark.[152]

The determination in each case will rely on the specific circumstances and may consider additional criteria. The relevant sections of the public encompass current and potential consumers, individuals engaged in distribution channels, and corporate circles active in the trade of similar goods and services. A Member State has the authority to designate a mark as a well-known mark, even if the mark is not widely recognized, or if the Member State uses subparagraph (c), which refers to being known in any relevant segment of the public within that Member State.[153].

2.3 Well-Known Marks Protection

Taking Care of Well-Known Marks When a mark is well-known in a Member State, it must be protected against other well-known marks, business identifiers, and domain names. This protection must start as soon as the mark is well-known in the Member State. Taking into account bad faith when following Part II of these Provisions, bad faith may be one of the things that are taken into account, along with other things[154].

2.4 Well-known mark conflict

A mark is considered to conflict with a well-known mark if it reproduces, imitates, translates, or transliterates the well-known mark, or a significant part of it, in a way that is likely to confuse. This applies when the mark, or a significant part of it, is being used, applied for registration, or already registered for goods and/or services that are the same or similar to those covered by the well-known mark. [155]

If a mark, regardless of the goods or services it represents, is used, applied for registration, or already registered, it will be considered in conflict with a well-known mark if it reproduces, imitates, translates, or transliterates the well-known mark, or a significant part of it. Additionally, if the use of that mark suggests a connection between the goods/services and the proprietor of the well-known mark, and is likely to harm their interests, or if the use of that mark is likely to unfairly weaken the distinctive character of the well-known mark, it would be considered as taking unfair advantage of the well-known mark's distinctiveness. [156] To utilize paragraphs (1)(b)(ii) and (iii), a Member State has the authority to mandate that the well-known mark is widely recognized by the general public[157]

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[152] *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999, p6*

[153] *ibid, p7*

[154] *ibid, p8*

[155] *ibid p9*

[156] *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999, article 4 p9*

[157] *Ibid p9, (notwithstanding paragraphs 2 to 4.*

When a trademark was utilized, officially recorded, or an application for registration was submitted in or for a member state for products or services that are the same or comparable to those covered by the renowned trademark before its establishment of fame in that particular Member State. This is done to determine if the mark conflicts with the well-recognized mark. To determine if a mark is confusingly similar to a well-known mark, it must be assessed if the mark was used, applied for registration, or registered in the Member State for specific products and/or services before the well-known mark gained recognition in that Member State. This statement is valid only if the mark was utilized, officially recorded, or if the registration request was submitted with malicious intent. [159]

2.5 Opposition Procedures

An opposition is an administrative proceeding in which the validity of a trademark right is contested. Frequently, an opposition procedure is time-limited, either before or after the granting of the right in question. Opposition procedures are accommodated and regulated per the national or regional statutes of designated Madrid members under the Madrid System.[160]. If the relevant legislation permits third parties to contest the registration of a trademark, a conflict with a well-recognized trademark under paragraph (1)(a) will serve as a basis for opposition [161].

2.6 Procedures for Invalidation

The proprietor of a registered trademark shall have the right to request, within a minimum of five years from the date the Office publicly disclosed the registration status, that the registration of a mark that conflicts with the registered trademark be invalidated by a decision of the competent authority [162]. In this context, A competent authority has the power to declare invalid the registration of a mark on its initiative. In such a scenario, a conflict with a well-known mark shall not be a ground for invalidation for at least five years from the date the Office publicly disclosed the registration status.[163]

2.7 Utilization Prohibition

The proprietor of a renowned trademark shall have the right to petition the competent authority for an injunction against the utilization of a mark that is in opposition to the renowned trademark. The aforementioned request shall remain valid for a minimum of five years from the date the proprietor of the renowned trademark became aware of the infringement of the conflicting trademark[164.]

2.8 Registration and Use of a well-known trademark in Bad Faith

A Member State may not impose a time limit for requesting the invalidation of the registration of a mark that conflicts with a well-known mark if the conflicting mark was

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[159] *Ibid p9*
[160] *World Intellectual Property Organization, Madrid Yearly Review 2023: The International Registrations of Marks., Publisher WIPO, 2023 p88.*
[161] *Andrew Christie, Blackstone's Statutes on Intellectual Property,Publisher Oxford University Press,16th Edition, 2023,P 406.*
[162] *Ilanah Simon Fhima, Jacques Azéma, Philippe Gilliéron, Yuanshi Bu, Anne Marie E. Verschuur, Marques notoires et de haute renommée / Well-Known and Famous Trademarks, Publisher Université de Genève, 2011, p121.*
- Andrew Christie, , Blackstone's Statutes on Intellectual Property, Ibid , P 413.
[163] *Ilanah Simon Fhima, Jacques Azéma, Philippe Gilliéron, Yuanshi Bu, Anne Marie E. Verschuur, Marques notoires et de haute renommée / Well-Known and Famous Trademarks, ibid, p221.*
- Andrew Christie, , Blackstone's Statutes on Intellectual Property, ibid, P 413.
[164] *Margaret Dowie-Whybrow, Core Statutes on Intellectual Property 2022-23, Publisher Bloomsbury Publishing, 10edetion, 2022, P 528*

registered in bad faith, notwithstanding paragraph (3) [165]. However, A Member State may not impose a time limit for requesting the prohibition of the use of a mark that conflicts with a well-known mark if the conflicting mark was used in bad faith, notwithstanding paragraph (4) [166]. In this regard, when establishing bad faith, the competent authority shall consider whether the person who registered or used the mark in conflict with a well-known mark knew of, or had reason to know of, the well-known mark at the time the mark was used, registered, or the application for its registration was filed. Furthermore, it's important to pay attention that the member state may not impose a time limit for requesting the invalidation of the registration of a mark that conflicts with a well-known mark, provided that the mark in question was registered but never put to use, in contrast to standing paragraph (3).

2.9 Prevent others from using well-known marks

Ensuring the protection of well-known marks in order to avoid unauthorized use When it comes to famous trademarks, the proprietor has the right to stop others from using similar marks for both identical or similar products, as well as for different products.

This is because using the trademark concerning those goods or services would suggest a connection between them and the proprietor of the registered trademark, which could harm the proprietor's interests. ® Put simply, this broader protection is given when using a similar mark for different products would unfairly benefit from or harm the unique identity or reputation of the trademark. Using a sign that resembles a well-known trademark can harm its reputation, weaken the unique identity of the trademark, or exploit the reputation of the well-known trademark for personal gain. [167]

3. Famous and Well-Known Marks Practitioner's Toolkit

In this regard, the author will briefly describe the source of the protection, and if it does apply in registration, opposition, cancellation, and litigation contexts that should be noted. On top of that, the main question worth leaving for discussion is whether the United States has specific recognition or protection for Well-Known Marks.

3.1 United States[168]

Initially, the United States does not have specific statutory recognition/protection for well Known Marks.[169]

The United States recognizes the well-established marks theory as a fundamental principle[170]. In this context, the Lanham Act is the legal framework in the United States that provides statutory protection for trademarks. Although the Lanham Act does not specifically provide legal safeguards for well-known marks[171]., a comprehensive interpretation of U.S. laws, such as the Lanham Act and the PRO-IP Act of 2007, establishes the framework for safeguarding foreign well-known marks in the United States. Well-known mark protection

[165] *Andrew Christie, , Blackstone's Statutes on Intellectual Property, Publisher Oxford University Press, 2014, P 413.*
[166] *ibid p122.*
[167] *Stephen Burley & World Intellectual Property Organization, Introduction to the International Intellectual Property Legal Framework, Publisher WIPO, 2023, p16&17.*
[168] *International Trademark Association, Famous and Well-Known Marks Practitioner's Toolkit, p149, https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/Famous-and-Well-Known-Practitioners-Toolkit-2015.pdf*
[169] *Matthew Rimmer, The Trans-Pacific Partnership: Intellectual Property and Trade in the Pacific Rim, Publisher Edward Elgar Publishing, 2020, p189*
[170] *Irene Calboli, Edward Lee, Trademark Protection and Territoriality Challenges in a Global Economy, Edward Elgar Publishing, 2014, p21.*
[171] *Ibid, p25.*

varies significantly due to the need to interpret U.S. legislation to identify safeguards for such marks, and the fact that trademarks can be enforced in any of the district courts.[172]

The first inquiry pertains to whether the United States of America has explicit acknowledgment or safeguarding for Famous Marks under a Dilution doctrine. Well-known trademarks are safeguarded in the United States under the principle of dilution. The source of the protection comprises the following: (1) Legal protection provided by the Lanham Act as specified in 15 U.S.C. § 1125 (c); and, (2) in specific states, legal protection provided by state statutes. If the usage in question took place before October 6, 2006, and the plaintiff is seeking financial compensation, the court has the option to use the Federal Trademark Dilution statute of 1995.

According to this statute, the defendant is required to provide evidence of actual dilution. Nevertheless, if the supposed mark that is being weakened is used in business for the first time after October 6, 2006, the Trademark Dilution Revision Act of 2006 is applicable. This act permits the plaintiff to achieve success with a lower level of evidence indicating a "likelihood of dilution." A renowned trademark must be widely acknowledged by the broad American public as a distinctive identifier of the goods or services that are provided by the trademark's proprietor. [173] which is commonly seen as equivalent to a widely recognized brand Several state statutes closely resemble or are almost identical to the federal anti-dilution statute, whereas some have significant variations. [174].

Additionally, the author wonders what type of evidence is required to prove that a mark is famous., the "court may consider all relevant factors" regarding fame, such as the ones that follow: "(i) The duration, scope, and geographic distribution of the mark's advertisement and publicity, regardless of whether or not it is advertised and disseminated by the proprietor or third parties." (ii) the overall value, and geographic scope of sales of products or services offered under the mark. (iii) The degree to which the mark is recognized. (iv) Whether the mark was registered on the principal register, under the law of the twentieth of February 1905, or under the Statute of March 3, 1881.[175]. In general, whatever proof ought to be provided is guided by all of these variables and may include any evidence that substantiates any or all of the elements[176].

The utilization of a symbol in promotional activities is strongly indicative of whether or not the symbol generates a high probability of confusion with another symbol[177]. The presence of the mark on designations, containers, or advertising collateral that is specifically targeted toward the product in question provides valuable evidence regarding how potential buyers react to the mark. Courts evaluate trademarks based on how customers perceive them in the marketplace, taking into account how they are presented in marketing. When it comes to a service mark, marketing becomes even more important since the mark cannot be attached to the service, as a trademark can be attached to commodities. Potential consumers often come across the mark in advertisements instead of on the actual product. As a result, the service mark cannot be separated from advertisements whereby it is displayed.[178]

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[172] *ANDREW COOK, Do as WE SAY, NOT As WE Do: A study of the well-known Mark's doctrine in the United States, The John Marshall Review of Intellectual Property Law, 2009, p416*

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[174] *Julian S. Millstein, Jeffrey D. Neuburger, Jeffrey P. Weingart, Doing Business on the Internet: Forms and Analysis, Publisher Law Journal Press, 2024 P 4-38.*

[175] *As per 15 U.S.C. § 1125 (c)(2)(A) of the American federal anti-dilution law and 15 U.S.C. § 1125 (c)(2)(A)*

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[177] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress, and Design Law, Publisher Aspen Publishing, ,2nd edition,2024 P 286*

[178] *Dean K. Fueroghne, Law & Advertising: A Guide to Current Legal Issues, Publisher Rowman & Littlefield,4th edition, 2017, p278*

3.1.1 A Fashionable Example

In 2010, Hyundai Motors aired a television advertisement called "Luxury" that showcased a basketball adorned with a characteristic pattern from Louis Vuitton. The commercial showcased several scenes including police officers indulging in caviar, luxurious boats, blue-collar laborers transporting lobsters, an urban basketball game, and a Hyundai Sonata cruising along a street. The ad sought to reinvent the concept of luxury by highlighting the elegance, excellence, and features of the 2011 Sonata. The advertisement satirized the absurdity of luxury being associated with exclusivity by contrasting luxury emblems with ordinary aspects of life.

011 Sonata. The advertisement satirized the absurdity of luxury being associated with exclusivity by contrasting luxury emblems with ordinary aspects of life.

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In 2006, the federal anti-dilution statute, which safeguards trademark proprietors against dilution, underwent amendment. The 2006 revisions to the Trademark Dilution Revision Act removed the need to provide evidence of actual dilution, enabling plaintiffs to demonstrate probable dilution. The court clarified that blurring refers to the connection that arises when a mark or trade name resembles a well-known mark, causing the well-known mark to lose its uniqueness. The court determined that Louis Vuitton has presented information that fulfills all six blurring characteristics outlined in the TDRA. Furthermore, the analysis of blurring does not necessitate that the two businesses constitute competition with each other. [179]

3.2 Australia

Under s 120(3)[180], the plaintiff is required to demonstrate that its trademark is widely recognized in Australia. The legislation does not define a well-known trademark; however, s 120(4) offers some guidance. A trademark may be widely recognized, even though it is only recognized within the pertinent industry. WIPO has established criteria for sector identification, which encompass current or prospective customers, individuals involved in distribution channels, and business circles. Nevertheless, a trademark that is only well-known in the industry in question will experience an even harder time meeting additional demands than a trademark that happens to be well-known. The time frame, extent, and geographical area of use, as well as registrations and promotions, are additional pertinent conditions.[181].

Australia has explicit provisions for the acknowledgment and safeguarding of Well-Known Marks. Up till now, Section 120 of the Australian Trade Marks Act 1995 (Cth) (3) A person commits trademark infringement if: (a) the trademark is widely recognized in Australia; and (b) the person uses a sign that represents the trademark that is almost identical to, or intentionally similar to, the registered trademark concerning: (i) goods (unrelated goods) that are different from the goods that for which the trademark is registered (registered goods) or are not closely related to the services for which the trademark is registered (registered services); or (ii) services (unrelated services) that are different from the registered services or are not closely related to registered goods; and (c) because the trademark is well known, the sign would likely be interpreted as indicating a connection between the unrelated

[179] *ibid, p280-281*
[180] *Australian Consumer Law and Fair-Trading Act 2012 - SECT 120*
[181] *Mark Davison, Ann Monotti, Leanne Wiseman, Australian Intellectual Property Law, Publisher Cambridge University Press, 2016, p156.*

goods or services and the registered proprietor of the trademark; and (d) as a result, the interests of the registered the proprietor are likely to be negatively affected. (4) The degree of a trademark's recognition in the pertinent industry, whether as a result of trademark marketing or for any other reason, must be considered for determining, in paragraph (3)(a), whether a trademark is widely known in Australia.[182]

Here, the question arises over the type of evidence required to demonstrate the well-known status of a mark. Relevant forms of proof encompass sales data and invoices, which serve to establish the significant volume of sales for goods featuring the trademark. Consequently, this evidence implies that the trademark can be considered well-recognized. Advertising statistics might be valuable in showcasing a significant level of brand utilization within the appropriate market.

Indirect advertising might also be helpful. In addition, online advertisements and other forms of promotion, such as newspaper articles or industrial awards, can be advantageous. Website traffic and a third-party (3P) website can be pertinent and valuable, however, the 3P website is less compelling. Survey evidence can be valuable, however, and its acceptance is subject to stringent criteria[183].

Although Australia does not have explicit protection for Famous Marks under a Dilution theory, it is nevertheless required to provide evidence to demonstrate the fame of a mark[184].

These factors include the date of use, the inherent durability of the mark, geographic distribution, social networking sites, and internet usage. Regarding this matter, the duration of use is merely one factor that indicates the level of recognition of a trademark. Therefore, it is necessary to incorporate historical statistics dating back to the earliest available records of the client[185]. Regarding the inherent integrity of the mark, if the mark is not very unique, it becomes more difficult to prove that it is renowned by the brand proprietor and not well-known in a different context. Conversely, the most relevant proof will come from Australia, ideally encompassing every territory and state in terms of Geographical Covering.

[186]Moreover, Australia is exposed to social media content from foreign websites, live broadcasts of commercial events, and other online features that can be sent through the World Wide Web. Hearsay, which concerns can be surmounted by utilizing exclusions outlined in the Evidence Act.[187]

In this context, the Australian High Court Decision (AUSHC) related to the "NIKE" case involves the plaintiff, "Nike,"[188] a company specializing in sporting goods, and the defendant, "Nike," a company involved in scent products. (AUSHC) upheld that the defendant's utilization of the term "Nike" for scent constituted passing-off and also deceptive and deceitful behavior since the plaintiff's trademark "NIKE" has been acknowledged as a renowned brand, particularly for athletic products. The defendants were forbidden from using

[182] *International trademark association, Famous and Well-Known Marks Practitioner's Toolkit, p12, https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/Famous-and-Well-Known-Practitioners-Toolkit-2015.pdf*
[183] *Ibid,p12*
[184] *Ibid,p12*
[185] *Ibid,p12*
[186] *Ibid,p12*
[187] *Ibid,p12*
[188] *as reported in the 46th of the Intellectual Property Reports, volume46, p 481*

the trademark "NIKE". The Supreme Court of Switzerland ruled in favor of NIKE Sporting on March 24, 1998, in a dispute involving the same chemical. [189]

3.3 China [190]

CHL[191] took into consideration that any visible indication that can offer to identify the goods of an all-natural and legal individual or other company from those of one more might be produced as a trademark for the enrollment application, including any word, color combination form, symbol, alphabet letters, numeral, three-dimensional, and also any mix of the above[192]. There is no legal defense for unregistered trademarks (other than "well-known" marks). "Well-known" marks are likewise now acknowledged under Chinese regulation (the courts, as well as administrative bodies, will undoubtedly take into consideration the level of expertise of the trademark by pertinent customers, the length of usage of the trademark, the portion of attention provided to the mark in China state, and the historical background of the mark)[193.]

In this regard, the (PRCTML) provides legal protection for marks that are widely recognized and acknowledged as well-known. Protection is provided for both well-known marks that are registered and well-known marks that are not registered[194]. According to Article 13 of the PRCTML, individuals who possess a trademark that is widely recognized by the public can seek legal recourse for their well-known mark if they believe their rights have been violated.

A trademark that is a replica, a mimicry, a translation, or anything else that has the potential to confuse, another well-known trademark the fact that has not been registered in China and is the subject of an application for registration for identical or similar products, will be denied registration, and its usage will be prohibited. If a trademark in China is found to be a procreation, imitation, or translation of another well-known trademark, and is being applied for registration for different goods or services, it will be denied registration. Furthermore, the usage of such a trademark will be forbidden if it is likely to cause confusion among the public and potentially harm the legitimate interests of the proprietor of the well-known trademark. Famous trademarks can be identified in administrative and registration procedures by the PRC Trademark Office (TMO), in administrative matters managed by the Administration of Industry and Commerce (AIC), in disputes by the PRC Trademark Review and Adjudication Board (TRAB), and in lawsuits brought by approved People's Courts.[195]

Here, the question arises about what type of evidence is required to prove that a mark is well-known. Specifications for the content When identifying a widely recognized brand, the

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[189] *Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, p63-64 https://www.jpo.go.jp/e/news/kokusai /developing/training/ textbook/document/index/protection _of_well-known_and_famous_trademarks_2004.pdf*

[190] *International Trademark Association, Famous and Well-Known Marks Practitioner's Toolkit, ibid, p20*

191Trademark Law of the People's Republic of China (Adopted at the 24th Meeting of the Standing Committee of the Fifth National People's Congress on August 23, 1982 and promulgated by Order No.10 of the Standing Committee of the National People's Congress on August 23, 1982; amended for the first time in accordance with the Decision on Revising the Trademark Law of the People's Republic of China adopted at the 30th Meeting of the Standing Committee of the Seventh National People's Congress on February 22, 1993; and amended for the second time in accordance with the Decision on Revising the Trademark Law of the People's Republic of China adopted at the 24th Meeting of the Standing Committee of the Ninth National People's Congress on October 27, 2001).

3; and amended for the second time in accordance with the Decision on Revising the Trademark Law of the People's Republic of China adopted at the 24th Meeting of the Standing Committee of the Ninth National People's Congress on October 27, 2001).

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192, Trademark Law of the People's Republic of China, Article 8.

193IBP, Inc., China Business Law Handbook Volume 1 Strategic Information and Basic Laws, Publisher Lulu. com, 2000, p62.

[194] *R. Bird, Robert Bird, Subhash C. Jain, the Global Challenge of Intellectual Property Rights, Publisher Edward Elgar Publishing, 2009 P 83*

[195] *International Trademark Association, Famous and Well-Known Marks Practitioner's Toolkit, ibid, p20,*

following elements must be considered: a. The level of recognition of the trademark among the relevant public;

b. The duration of the ongoing usage of the trademark, including evidence of its use and registration history and extent; c. The continuous duration, extent, and geographical reach of any publicity for the trademark, including evidence of the method, geographical coverage, variety of public media used, and number of published advertisements in advertising and promotional activities; d. The track record of the trademark being protected as a well-known trademark, ranging from evidence that the mark has previously enjoyed protection as a well-known mark in China or as other countries and regions; and e. Other factors related to the trademark's well-known status, involve evidence of output, the amount of sales revenue, pre-tax profits, and sales territory for the main goods associated with the trademark during the most recent three years.

Requirements for quality when applying for recognition of a well-known mark, brand proprietors must produce proof that fulfills the subsequent criteria: a. Revised: to submit and show authentic papers rather than duplicated ones a. Regarding utilization in Mainland China: must present substantiating proof demonstrating the utilization and renown of the trademark specifically inside Mainland China, excluding foreign jurisdictions. c. Evidence ought to be provided before the contested marks' filing date.

It is preferable to obtain proof from an objective third party rather than from the brand proprietor or a biased third party, as evidence from these sources has minimal evidentiary value. There is no information provided. Based on the latest notification, it will be necessary to demonstrate that a mark is well-known either three years after registration or after five years of use.

However, there may be certain circumstances where this criterion is less stringent. The challenge of producing proof that meets the criteria set by the PRC authorities is demonstrated by the limited number of international trademarks acknowledged as well-known marks annually, as depicted in the table provided below. The temporal correlation of proof can establish the preexistence of a mark before the particular date of such evidence. Concerns Regarding the Identification and Safeguarding of Widely Recognized Trademarks When dealing with conflicts related to the opposition or cancellation of a trademark, the primary factor to consider should be whether the mentioned mark has attained the reputation of a well-known trademark before the application date of the challenged mark.

The relevant proof provided by both parties involved, which demonstrates that the mentioned trademark was acknowledged as a well-known trademark after the application date of the disputed mark, has the potential to establish that the cited mark had already attained well-known trademark status before the implementation date of the contesting mark. The proof provided ought to be considered acceptable. [196]

In 2006, the Trademark Office provided a publication that included the overall count of well-known marks acknowledged by the Office. However, it did not differentiate between well-known marks accepted in AIC administrative hearings as opposed to those acknowledged in TMO opposing processes. The data provided solely displays the quantity of widely recognized trademarks acknowledged by administrative agencies. In China, approved

[196] *ibid, p20,*

People's Courts can judicially acknowledge well-known brands. Between 2001 and 2007, over 300 marks were officially acknowledged by the judiciary.

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Since 2006, the Supreme People's Court in China has aimed to create a nationwide system for documenting, evaluating, and making public the trademarks that have been acknowledged as well-known by People's Courts in different geographical areas. Presently, local courts must notify the highest court in the country of verdicts that involve a notable acknowledgment. Nevertheless, the Supreme People's Court has not provided the records for public scrutiny.

In August 1987, the Chinese Trademark Office (TMO) officially acknowledged a foreign trademark (PIZZA HUT) as a well-known mark, marking the first instance of such recognition. In 1989, it achieved the status of being the first well-known Chinese trademark, specifically for Tong Ren Tang. The terms "SAFEGUARD", "DUPONT", and "WAL-MART". [197]

The question that arises here is whether China provides explicit recognition for Famous Marks under a Dilution doctrine, with the decision of the Supreme People's Court to include dilution in Article 13 of the Trademark Law.

While dilution has been mentioned in Chinese courts, it was officially recognized as a component of Chinese trademark law only after the Interpretation of the Supreme People's Court on Several Challenges Regarding the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Famous Trademarks was issued in 2009.

The Chinese idea of 'dilution' is used as a foundation for rejecting the registration of copies, replicas, or translations of widely recognized trademarks. Article 9: If the general public can easily be confused about where a product comes from or how a famous trademark is being used, and if they can be led to believe that there is a licensed use, affiliation, or some other connection between the famous trademark and the company or its operator being sued, then this might be considered a case of "likely to confuse" as stated in paragraph 1 of Article 13 of the Trademark Law.

If the lawsuit can convince the general public that there is an association between the trademark being sued and the well-known trademark, and as a consequence, the distinctive qualities and market value of the well-known trademark are weakened or erroneously used, then this would fall under the circumstances described in paragraph two of Article 13 of the Trademark Law: "...misleading the broad terms public and potentially harming the legitimate interests of the proprietor of the well-known trademark." [198]

4. Distinction Between “Well-Known” and “Famous” mark

The difference between "well-known" and "famous" trademarks is not clearly defined according to international conventions, treaties, national trademark laws, or scholarly papers.

[197] *ibid, p22,*
[198] *International Trademark Association, Famous and Well-Known Marks Practitioner’s Toolkit, ibid, p23,*

4.1 Situation within the United States

Nevertheless, as previously mentioned, certain products or services associated with specific trademarks have been consistently and globally offered and promoted worldwide, resulting in their widespread recognition when it comes to a distinct origin or level of quality. This particular form of the trademark should be classified as a "renowned trademark". Arguments supporting the practical importance of differentiating between "well-known trademarks" and "famous trademarks" are often significant.

The statement in question is from an essay written by Mr. Frederic Mostert, the former President of the International Trademark Association (INTA), in the conventional definition of "well-known" given by Merriam-Webster includes, among other things, being well recognized and familiar to a large number of people[199]. Within the realm of trademark law, a well-known mark is defined as a mark of the fact recognized by a significant portion of the relevant public as being connected to specific goods or services.

There have been frequent suggestions to acknowledge a distinct classification of widely recognized trademarks, referred to as "famous" marks. Famous marks possess a greater level of reputation compared to well-known marks, and as a result, they need a wider range of protection against unauthorized usage of goods or services that do not compete.

4.2 Japan

Differences in Japanese Trademark Law and Unfair Competition Law Japanese Trademark Law and Unfair Competition Law make a distinction between "famous trademark" and "well-known trademark"; however, these words are not clearly stated. Article 4-1-10 of the Trademark Law specifically focuses on safeguarding "well-known or widely known trademarks" within the realm of identical and similar goods or services. However, Article 4-1-15 aims to safeguard "famous trademarks" by preventing any confusion with trademarks belonging to other parties, specifically with different services or products. The primary focus of this clause is on safeguarding "famous trademarks". [200]

In addition, concerning the same objective, considering the defensive indicators of. Article 64 is also focused on addressing potential confusion that may arise between different goods or services. It is also commonly associated with the protection of well-known trademarks. Unfair competition legislation differentiates between "well-known trademarks - well-known indications of goods, services or business" (Article 2-1-1) and "famous trademarks - famous signs of goods, services or business" (Article 2-1-2). In addition, in the latter scenario, it is also effective in preventing unauthorized use and weakening of well-known brands.

The thinking aligns with that of the United States, as mentioned earlier, as the focus of this type of protection ought to focus on "famous trademarks".

To this point, in the case Chanel (plaintiff) v. Snack Chanel (defendant)[201] Under the names "Snack Chanel" or "Snack Charel," the defendant launched a chain of little fast-food

[199] *"The Trademark Reporter, Vol. 86."*
[200] *Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center,JIII,2004 Matsubara, Muraki & Associates, p53-54. https://www.jpo.go.jp/e/news/kokusai /developing/training/ textbook/document/index/protection _of_well-known_and_famous_trademarks_2004.pdf*
[201] *(Supreme Court, Sep. 10, 1998) (Matsue Dist. Court, Jan. 26, 199) (Tokyo High Court, Sep. 29, 1994)*

businesses. The claimant filed a lawsuit against the defendant seeking an order of protection under the old Unfair Competition Law. Whether or not there would be a miscommunication was the key question. One area of uncertainty was that, although each of the defendant's snack restaurants employed no more than three to five people, the plaintiff is a well-known global fashion goods brand, making it hard to determine whether one business was mistaken for the other. Both the District Court and the High Court gave this reasoning great weight, and the plaintiff's claim was dismissed in precise accordance with the relevant" Japanese Unfair Competition Law".

The Japanese Supreme Court (JaSC) confirmed the threat of misunderstanding in a wide sense that considers the senses of the Dilution theory in the appeal case before it. Put another way, the Supreme Court supported the Tokyo District Court's (TDC) decision from 1966, in the Yashica case mentioned above. Regarding this Supreme Court ruling, Mr. Christopher Heath of the Max Plank Institute in Munich said in his article, "In effect, the courts have thereby interpreted the danger of confusion into a danger of dilution particularly in case where confusion was most unlikely due to the different field of business of the plaintiff and the defendant." Keep in mind that the concept of dilution is now obviously contained in the present regulation; consequently, Article 2(1)(ii) of the Japanese Unfair Competition Law offers redress in such circumstances. [202] the question that arises here is whether registration or actual use in a certain country is necessary to protect well-known and famous trademarks.

5. Registration and real use and protection of well-known and famous trademarks.

The provisions of the Paris Convention, TRIPS Agreement, and national trademark legislation in developed countries have acknowledged the significance of adequate protection for "well-known and famous trademarks". Yet, explicit circumstances for trademark protection are absent except for the requirement that these well-known and famous trademarks must be safeguarded even if they are not registered. The issue as to whether the registration and use of well-known and famous trademarks in specific countries should be a requirement for protection under national laws has not been explicitly stated in Article 6 bis of the Paris Convention or Article 16(2) and (3) of the TRIPS Agreement. Japanese law does not explicitly require trademark registration, although it is understood that registration is not necessary. Instead, the real usage of a trademark is regarded as crucial in establishing it as well-known or renowned. Hence, it is imperative to have practical use in a specific context, while the assessment of a trademark's desirability needs to be carried out individually for each situation. [203]

As previously mentioned, under the literal meaning of JaTML[204], trademarks that are both actively used and widely recognized as famous in multiple countries outside of Japan can be used as a basis for rejecting another party's usage for the same mark under Japanese Trademark Law. Thus, if a trademark is considered well-known or famous, it is not always necessary to demonstrate actual use according to JaTML. According to the Unfair Competition Law UCL in Japan, there is no specific provision addressing this issue. However, it can be evaluated and decided on a case-by-case basis, similar to how the Trademark Law operates. In the UK, the Trademark Act protects well-known trademarks[205].

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[202] *Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, ibid, p59.*

[203] *ibid p53-54. f*

[204] *Article 4-1-19 of Japanese Trademark Law*

[205] *UK Trademark Act, Section 56 of the*

It clarifies that a mark must be acknowledged as well-known in the UK, and there is no requirement for use in practice in the country. [206]

6. Case study

To some points, the author tries to explain and analyze the main principles that rule the

6.1 European Union

Directive of the EU Council on the Community Trade Mark (CTM) As previously stated, EU legislation differentiates the level of protection for well-known trademarks and highly reputed trademarks (famous trademarks). Article 4, specifically paragraph 1 in conjunction with paragraph 2(d), protects an earlier trademark when there are similarities between the goods or services covered.

On the other hand, paragraph 3 (and also paragraph 4(a)) offers protection for an earlier trademark even if the goods or services are not similar to those for which the earlier community trademark is registered. This method of determining the extent of protection is explained clearly, focusing on the level of recognition. It is reminiscent of the approach taken in Japan, and potentially also in the United States and Canada.[207]

The case of Canon K.K (JP) v. Pathe Communication (US) in the EU. Canon K.K (JP), the opposing party, argued that their mark and business name "CANON" is widely recognized for TVs, filming, recording equipment, TV transferring devices, and other items in Class 9. They also argued that the trademark "CANNON" belonging to Pathe, specifically for video film cassettes, should not be registered or permitted for use.

The German Patent Office rejected Canon's resistance the products at issue were considered to be dissimilar. Ultimately, the German Supreme Court sought guidance from CJEU to establish a unified understanding of Article 4(1)(b) and 4(4)(a) of the Council Directive of the European Economic Community (EEC). CJEU stated that the "CANON" trademark has been globally acknowledged as renowned. Consequently, the presence of Pathe's "CANNON" trademark ought not to be permitted, as the corresponding products are not similar or identical. The "MARS" case in Germany was heard by the German Supreme Court. The plaintiff in this case is Mars GmbH, while the defendant is Harlekin Geschonke GmbH. In the case at hand, the defendant unlawfully utilized the plaintiff's "MARS" trademark emblem and the complete packaging design of their condoms, without obtaining permission.

The plaintiff initiated legal action against the defendant based on the TML and Unfair Competition Law. In response, the defendant objected, claiming that this constituted a violation of the fundamental right to free speech. “The German Supreme Court” determined that the defendant's utilization of the trademark and slogan constituted an act of infringement of trademarks, as the defendant's products would deceive others into believing that they were authentic promotional items from the plaintiff. Thus, following the court's confirmation of the MARS mark's well-known status and the acknowledgment of the competitive circumstances between the parties, the defendant's actions were deemed in violation of Article 1 of the German Unfair Competition Law. Ultimately, the court dismissed the lawsuit based on

[206] *Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, ibid p53-54. f*
[207] *Ibid, p53-54. f*

constitutional grounds. This decision pertains to the principle of dilution. Those seeking more accurate evidence might consult instances involving "tarnishment". [208]

6.2 United Kingdom

In the United Kingdom, there was a case involving the usage of the brand name "EVERREADY" for both batteries and condoms. This case is similar to the MARS case in Germany, where the use of a well-known mark was prohibited. In the UK, the case was considered a matter of dilution, meaning that the matter of "confusion of origin" did not constitute a necessary factor to be considered. The rules to be followed with this type of argument are outlined in the First Council Directive 89/104/EEC of 1988, specifically in Article 4(3). These rules are also incorporated into both the Community Trademark (CTM) Article 8(5) and the UK Trademark Act Article 5(3).[209]

In the "TIFFANY" case in the case of Tiffany & Co. (opposer) v. Philip Morris (applicant), Philip Morris attempted to register the "TIFFANY" mark for tobacco. A petition was submitted for opposition . Tiffany & Co. subsequently submitted an opposition that was supported by a substantial amount of evidence that demonstrated its substantial reputation as a well-known trademark. Philip Morris, on the other hand, maintained that the very same mark was used concurrently in numerous countries for an extended period. Nevertheless, the U.K. Trademark Office ultimately refused the request Philip Morris' use would probably result in confusion or deception, as cited in Section 11 of the 1938 Trademark Act[210].

6.3 France

Although the Heast Company previously held the trademark "COSMOPOLITAN" for stationary, magazines, and publications, A. Frinas began using "COSMOPOLITAN" for clothes and leather items. Consequently, the Heats Company filed a lawsuit against the defendant. In the initial ruling, the French Court determined that the plaintiff's trademark was officially recognized as well-known. Additionally, the court found that the defendant's illegal use of the same brand for various items does indeed constitute a violation. Subsequently, the French Court of Appeal determined that the defendant's utilization of the identical symbol did not constitute a violation, but rather an act of passing-off intended to diminish the reputation of the plaintiff's renowned trademark. This was done by considering the idea of dilution through blurring.[211]

7. Notorious mark', 'mark with reputation', 'reputed mark', 'renowned mark' in the practice of different countries.

The paper mentioned above analyzes the legal frameworks, both at the international and national levels, that regulate the acknowledgment of renowned, widely recognized, and esteemed trademarks. The report encompasses data from 39 countries, namely Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, China, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Israel, Italy, Japan, Latvia, Luxembourg, Malaysia, Mexico, Netherlands, Philippines, Poland, Portugal, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Trinidad & Tobago, Turkey, the UK, and the USA.

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[208] *Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, ibid, p59-61.*
[209] *ibid p60-62*
[210] *The Trade-mark Reporter - Volume 90, Publisher United States Trademark Association, 1999411*
[211] *The Trade-mark Reporter - Volume 89, 1999, ibid P 311.*

outh Africa, Spain, Sweden, Switzerland, Trinidad & Tobago, Turkey, the UK, and the USA.

in, Sweden, Switzerland, Trinidad & Tobago, Turkey, the UK, and the USA.

The pertinent audience in assessing the level of acknowledgment of renowned, widely recognized, and esteemed trademarks is typically a relevant segment of the public, which may encompass the general public or a specialized demographic. Countries inside the European Union, including Austria, Belgium, Bulgaria, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, The Netherlands, Poland, Portugal, Romania, and others, participate in this procedure.[212]

7.1 The Benelux countries

The Benelux nations, namely Belgium, the Netherlands, and Luxembourg have divergent interpretations of the term "public" when it comes to well-established trademarks. For a mark to be deemed well-known, it must receive a reputation that extends beyond the confines of its industry. The Luxembourg Group asserts that for a trademark to be considered valid, it must have achieved a significant level of recognition among a substantial portion of the general population in the Benelux region.

7.2 The Dutch Group

The Dutch Group takes into account the pertinent industry, while the French Group raises the question of whether the applicable audience should be interpreted differently for well-known and reputable trademarks. The German Group asserts that widely recognized trademarks must have a significant level of fame among the relevant groups, with a barrier of 60-70%. In Korea, the relevant public refers to the specific sector of the public that is pertinent to a particular context, such as trademarks. Various kinds of trademarks necessitate varying levels of recognition from this pertinent public. In Russia, the law does not provide a specific definition for the relevant public. However, when assessing the level of understanding of a trademark, it is permissible to interview potential customers. [213]

7.3 Japan

In Japan, the word "relevant public" refers to the specific group of people that are considered when determining the level of public awareness of a famous mark[214]. This determination is based on the rules outlined in each relevant clause, with renowned marks often having a higher degree of recognition.

7.4 Mexico

In Mexico, the target audience for the relevant industry is considered the relevant public, although, for famous brands, it encompasses the general public. A renowned trademark must

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[212] *Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation,https://www.aippi.fr/upload/Helsinki%202013/sumrep_q234_e_final_230813.pdf p1*

[213] *Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation, ibid, p2*

[214] *Daniel R. Bereskin, Trademark Dilution and Free Riding, Publisher Edward Elgar Publishing, 2023 P 271.*

- Nuno Pires de Carvalho, The TRIPS Regime of Antitrust and Undisclosed Information Publisher Kluwer Law International B.V., 2008 134,

be officially registered and accompanied by detailed information on the target audience, encompassing current as well as potential customers.

8.5 Portugal, Switzerland, Spain, South Africa and Turkey.

In Portugal, the target audience for well-known marks is the general public, whereas, for marks that have an established reputation, it is a specific industry. In Spain, the target audience for well-known marks is the general public, whereas for reputed trademarks it encompasses the general population as a whole. South Africa operates under the assumption that the average person possesses knowledge, but Sweden does not require any evidence to justify the extension of protection. In Switzerland, "famous marks" are required to have widespread recognition among the entire population of the country, but in Turkey, the relevant public is the general population as a whole. In the United States, a trademark achieves renown when it is widely acknowledged and familiar to the general consumer base.[215]

9. The concept of "reputed trademark"

The concept of "trademark with a reputation" or "reputed trademark" is used in EU member states and Switzerland. In contrast, in Egypt, Hungary, Japan, the Republic of Korea, Mexico, Romania, Switzerland, Turkey, and the USA, the term "famous mark" is used. In Canada, both "famous" and "well-known" marks are used, but the criteria to determine what they mean are mostly identical. Australian trademark law recognizes marks that exhibit "widespread notoriety", "highly recognized marks", and "marks that have established a strong reputation in Australia".

In Brazil, the term "highly esteemed" trademarks are also used. Four sections under the Korean Trademark Act stipulate a precise amount of recognition for the trademark. The Japanese Group recognizes the difficulty of addressing this issue because of the unclear phrasing used in legal literature and the intricate principles specified in the Operational Rules. The determination of the relevant public is contingent upon the particular products and services under consideration.

10. Trademarks within the jurisdiction of an EU member and other stats

Trademarks within the jurisdiction of an EU member state gain recognition through their expert function, connection with a particular sector, item characteristics, technical complexity, and intended consumer characteristics including gender and age, geographical location, purchasing power, and distribution method. Trademarks that have achieved distinctiveness or are susceptible to dilution because of their renown warrant acknowledgment. In Korea, the primary demographic for the goods and services associated with the brand considers age and gender as significant criteria. In Mexico, the trademark considers various criteria, including age, culture, gender, specific interests, and other parts of the population.

The pertinent public includes both existing and prospective clients or purchasers, contingent upon the particular item or service under consideration. The Australian Group places the general public as its primary target audience, with a specific emphasis on attaining extensive acknowledgment. Conversely, the Austrian Group focuses mostly on potential

[215] *Summary Report, Thierry CALAME, Sarah Matheson and John Osha, Sara Ulfsdotter, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation,ibid p3.*

clients as their main target audience. The Belgian Group recognizes the absence of a conclusive legal precedent for addressing conflicts related to well-established trademarks.[216]

The target audience in trademark law is an intricate and diverse entity. In China, the term encompasses both current and potential consumers, as well as individuals or organizations engaged in the production or promotion of products and services. Opposition procedures in Canada only pertain to present and potential customers[217].

In the Netherlands, the public's encounter with well-known brands is also significant. In Japan, the size of the target audience is generally larger, unless it specifically pertains to a widely recognized trademark. In Singapore, the relevant public consists of distribution and business enterprises engaged in the trade of commodities or services. In Turkey, the focus is also placed on business circles and distribution networks.

The relevant public may consist of business/professional end consumers, distributors, licensees, and retailers; however, this will vary depending on the specific goods and services in question. In Canada, the applicable public cannot be restricted just to individuals engaged in trade, professional/business end customers, and private end customers.[218]

11. Relevance to the public

The European Trademark Directive does not explicitly define the idea of relevance to the public. However, it can be determined by considering the services and products in question. The level of recognition among the target audience is contingent upon the consumer base size. The determination of the appropriate target audience can differ for various goods and industries within the industry.

The notion of the "relevant public" remains consistent when evaluating the acknowledgment of trademarks in cases involving dilution, free riding, or likelihood of confusion in infringement proceedings. Certain nations, including Argentina, Brazil, Canada, the Republic of Korea, the Philippines, and Turkey, do not take into account the relevant public while evaluating well-known trademarks. The member nations of the European Union attribute dilution or tarnishment to the typical consumer, whereas the German Group focuses on real or potential customers engaging in free-riding. The Dutch Group does not distinguish between a mark that is regarded or well-known and a violation in an individual situation.[219]

In Japan, the involved public plays a vital role in the safeguarding of trademarks, particularly in cases involving dilution, free riding, and the possibility of confusion. In Mexico, the term is commonly associated with the target audience of consumers, which can vary according to the specific characteristics of the brand. In Russia, there is no prevailing public understanding regarding dilution, free riding, or the probability of confusion.

The responsible party for investigating the well-known condition of a trademark is the relevant public, who conducts opinion polls. The evaluation of the pertinent public is a factor

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[216] *Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation,ibid p5*

[217] *,ibid p5*

[218] *Ibid p6*

[219] *Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation, ibid p7*

in registration matters, cases of improper usage, and opposing processes. In Russia, the term "well-known status" is commonly used to refer to the outcome of an opinion survey. The specific target audience is established on an individual basis, using multiple parameters to evaluate the level of acknowledgment.

The evaluation of the pertinent public is vital in diverse legal actions, such as enrollment, opposition, violation, and opposition . It can be utilized to demonstrate the uniqueness of a mark, the presence of ill intent, or the occurrence of unfair competition. In certain situations, countries such as Austria, deem it more pertinent. In Russia, it is employed in surveys to get renowned status. The specific target audience is defined individually, using multiple criteria to evaluate acknowledgment. The Greek Group emphasizes that this assessment is derived from a particular methodology.[220]

The Mexican Group identifies the pertinent audience by conducting market polls. Still, the Singapore Group differentiates between being "recognized by any significant sector of the public in Singapore" and being "recognized by the general public." The determination of the appropriate public in trademark violation lawsuits is contingent upon the case's specific circumstances. The South African Group assesses the level of familiarity of the mark among interested parties, including a substantial percentage of them. The US Group establishes the specific audience that is considered significant in cases involving dilution. Most groups view harmonizations as favorable, with the Hungarian Group asserting that it aligns with Community legal norms.

The Group deems the present mechanism sufficient and hence does not perceive any necessity for harmonization through legal measures. The Latvian Group asserts that there is now no appetite for harmonization. The Finnish Group is doubtful about harmonization due to the significant variations in the nature and characteristics of each product and its market. Similarly, the Israeli Group asserts that while the goal of harmonization is desirable, it is occasionally attainable. Considering the numerous disparities in the elements that are significant in establishing the appropriate target audience, achieving harmonization seems unfeasible[221].

Two groups have failed to respond forward to the part on harmonization. The importance of the relevant public in determining the recognition of a trademark. Certain organizations propose that the appropriate public ought to relate to a certain industry, evaluating the items or services. The Belgian Group proposes the consideration of a broader or more specific target audience based on the nature of the products or services[222].

The Chinese Group proposes that everyday products and services should have comparable importance, but the rest of the relevant public should have a more restricted significance. The Philippines Group concurs, however, the Canadian Group proposes that specialty sectors should not take into account the general public, as it would rely on the broader people's level of expertise. The Canadian Group argues that the general public should not be regarded as the appropriate audience when assessing the popularity or prestige of a trademark within a specialized industry. [223]

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[220] *Ibid p8*

[221] *Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of famous marks, well-known marks, and marks with a reputation, ibid p9*

[222], *ibid p9*

[223],*ibid p9*

The debate on the appropriate audience for assessing the level of recognition of renowned trademarks, widely recognized trademarks, and trademarks with reputations is fragmented among multiple factions. Certain groups, like Argentina, Australia, Greece, Portugal, and Singapore, differentiate between marks based on their level of recognition, with the highest level necessitating acknowledgment among the general population. Some groups propose a narrower range of safeguards for other forms of recognition, limiting it to identical or closely comparable services or products.

The Dutch Group proposes that the target audience for marks with a reputation ought to be limited to the relevant sector of the public. On the other hand, the South African Group argues that the existing test is suitable for violations under Article 6bis of the Paris Convention, but more stringent criteria are required for cases of dilution. In this context, The Spanish Group highlights the significance of aligning the standards for assessing the status of a trademark as well-known, reputed, or famous[224].

Various organizations have proposed distinct parameters for determining the appropriate target audience, encompassing factors such as gender, age, geographical location, cultural background, interests, consumer knowledge, advertising tactics, and additional considerations. The Austrian Group argues against the existence of a legal differentiation between well-known marks, marks with a reputation, and famous marks. Instead, they propose that courts should determine the degree of protection on a continuous scale. The French Group emphasizes the importance of a broader public, beyond merely current or potential consumers, and highlights the relevance for those interested in the manufacturing industry[225].

The UK Group acknowledges the Joint Recommendation and emphasizes the importance of assessing the target market, the products or services at hand, as well as determining if a particular market segment has been involved. The Estonian Group suggests that the requirements outlined in the Joint Recommendation could be utilized to standardize the criteria for determining the appropriate public.

According to the US Group, a mark is considered renowned for dilution reasons when it is generally acknowledged by the general public in the United States as a symbol that identifies the origin of the goods or services provided by the proprietor of the mark. The implementation of harmonization measures would be highly beneficial in establishing clear standards for protection from persecution. [226]

The Japanese Group emphasizes the necessity for each country to specifically establish provisions that enable the prevention of registration or use of a well-known or renowned mark by another party in a foreign country. The Spanish Group recommends examining this topic within the framework of a potential Q234bis. The UK Group emphasizes the importance of legislators and judges worldwide adopting uniform and unambiguous phrasing when referring to well-known trademarks. [227]

[224] *ibid 10-12*
[225] *ibid 10-12*
[226] *ibid 10-12*
[227] *ibid 10-12*

12. Renown or Reputation Mark

The concept of renown or reputation is widely employed in EU trademark law., as defined in the Paris Convention[228] and TRIPS Agreement[229]. The term 'well-known' typically refers to being recognized by a significant portion of the relevant population. According to paragraph two of article 16 of the TRIPS Agreement, when deciding if a trademark is well-known, the awareness of the trademark among the public in the relevant industry needs to be considered. This brings up the question of whether the conventional definition of well-known remains applicable. If not, it closely approximates the concept of 'repute'. Article 5(2)(d) of the Directive and EUTMR Article 8(2)(c) outline the safeguards provided to well-known marks versus subsequent national and EUTM applications. [230]

12.1 General Motors VS Yplon

In the case of General Motors VS Yplon, the Court of Justice of the EU (CJEU) provided a clear definition of the concept of reputation. Upon examining the many linguistic renditions of the phrase in the Directive, the Court determined that a certain level of expertise is necessary. This criterion is also a result of the provisions and intent of the Directive. The CJEU has clarified that Article 10(2)(c) (formerly Article 5/2 of the Directive is applicable only when the relevant public possesses a significant level of awareness, meaning that the earlier trademark had a well-established reputation. Regarding the relevant public, the CJEU determined that the mark must have a reputation within the specific group of people who are affected by the mark. This could be either the general public or a more specific group, such as professionals in a certain industry.

The Court determined that the necessary level of knowledge is considered to be fulfilled when the mark is familiar to a substantial portion of the public that is interested in the goods and services associated with the mark. When determining if a mark has a reputation, it is necessary to consider all pertinent information.

The CIEU referred to the mark's portion of the market. The intense. What is the geographical extent and length of time that the mark is used, and how much money has the company invested to advertise it? The Court explicitly declared that it is impossible to provide a definitive answer about specific percentages of the population that are affected. According to this verdict, it is concluded that a trademark cannot have a reputation without being utilized, or at a minimum being utilized in the past. Moreover, a trademark that has gained a well-known status via extensive usage can still be protected from harm even when it has ceased to be used, as long as it still maintains a favorable reputation among the relevant groups[231].

The judgment of the CJEU aligns with the prevailing global understanding of the term 'well-known mark' as defined in Article 6bis of the Paris Convention and Article 16(2) of the TRIPS Agreement. In certain nations, the term "well-known" is commonly understood to

[228] *second paragraph of Article 6 of the Paris Convention*
[229] *Articles 16 (2) & (3) of the TRIPS Agreement*
[230] *Daniel R. Bereskin Trademark Dilution and Free Riding, P196*
[231] *Ibid, P197*

refer to widespread public knowledge. Nevertheless, the decision made by the CJEU indicates that this does not meet the necessary standard for evaluating reputation.[232]

13. conclusion

The Jordanian legislature has clarified the differentiation between trademarks and industrial markings, establishing that a well-known trademark has gained international recognition surpassing its country of origin and has obtained a reputation within the relevant sector of the public. brand registration is not allowed for any service, item description, or product that is deceptively similar to or the same as an already registered brand. Geographic names, descriptive phrases, and surnames are exempt from registration.

It is necessary to safeguard a widely recognized trademark against other widely recognized trademarks, company identifiers, and domain names. Opposition processes refer to administrative actions in which the legitimacy of a trademark claim is challenged, typically within a specified time frame. A trademark owner has the authority to ask for the cancellation of a conflicting trademark registration by the appropriate governing body.

Well-known marks do not have specific legislative recognition or protection in the United States. The Lanham Act offers statutory safeguarding for trademarks, while certain states give legal protection through state statutes. In Australia, it is necessary for a trademark to provide evidence of its extensive recognition within the relevant industry. WIPO has defined specific criteria for sector identification. However, a trademark that is merely well-known within the industry may encounter even more intense competition.

The precise definition of "well-known" and "famous" trademarks may vary, but they are acknowledged by multiple international conventions, treaties, national trademark laws, and scholarly publications. Specific trademarks in the United States have continuously and widely offered and marketed certain items or services, leading to their widespread recognition worldwide. In Japan, the differentiation between a "famous trademark" and a "well-known trademark" is not explicitly defined. However, Article 4-1-10 of the Trademark Law specifically aims to protect "well-known or widely known trademarks" about identical or comparable goods or services.

The EU Council Directive on the Community Trade Mark (CTM) establishes distinct levels of protection for well-known trademarks and highly regarded trademarks (famous trademarks). The appeal case before the Japanese Supreme Court established the existence of a broad interpretation of the Dilution theory, which includes the potential for misunderstanding. The current rule now incorporates the concept of dilution, and the Japanese Unfair Competition Law, namely Article 2(1)(ii), provides remedies in such situations.

The Canon K.K (JP) v. Pathe Communication (US) case in the EU centered around the utilization of a widely recognized trademark. Conversely, the Tiffany & Co. (opposer) v. Philip Morris case in the UK was primarily concerned with dilution, indicating that the issue of "confusion of origin" was not deemed essential for consideration.

This article analyzes the legal frameworks that regulate the acknowledgment of prestigious, generally acknowledged, and highly regarded trademarks in 39 nations. The appropriate

[232] *ibid P197*

target audience for evaluating recognition is usually a specific subset of the population, which can encompass the general public or a specific demographic. In the Benelux nations, including Belgium, the Netherlands, and Luxembourg, there are differing interpretations of the term "public". The Dutch Group focuses on the relevant sector, while the French Group raises concerns about the interpretation of widely recognized and respected trademarks. The responsible party for investigating the well-established status of a trademark and conducting surveys is the relevant public. The European Trademark Directive does not provide a specific definition for the word "relevance to the public." However, this can be found by evaluating the services and products involved. The discussion over the suitable target audience for evaluating the acknowledgment of well-known, universally acknowledged, and esteemed trademarks is divided among many groups. The notion of notoriety or repute is extensively utilized in EU trademark law, as stipulated in the Paris Convention and TRIPS Agreement.

Chapter 3 Nontraditional trademark

There is an increasing trend in using innovative branding techniques that use unconventional sensory experiences, such as sound, aroma, taste, or touch, to target different senses of human beings. In recent years, non-traditional trademarks have received significant attention in the news. This is primarily due to the coverage of internationally renowned companies like Coca-Cola, Toblerone, and Tiffany and Co., which have encountered notable successes and failures in registering these trademarks. Is it advisable for other firms to adopt this trend?

1. What is the definition of a non-traditional trademark?

Recently, a new subset of trademarks known as "non-traditional marks" has emerged alongside the proliferation of digital trademarks. Any indication, whether visible or not, can be classified under this umbrella. Marks that may be seen include holograms, three-dimensional symbols, color symbols, position symbols, gesture symbols, book or movie titles, signs that can be seen in motion or multimedia, and slogans. Sound marks and olfactory marks (smell marks) are examples of non-visible indicators. Flavor imprints, as well as texture imprints.[233]

Trademarks serve the purpose of differentiating the products and services of one brand from those of other companies. The primary objective of any trademark is to distinguish the goods or services from those of other dealers. Furthermore, its objective is to establish a distinctive symbol that consumers will link to a specific brand, its attributes, and its level of excellence. Typical examples of trademarks include Numerals, Vocabulary; and Logos, Signs, Alternatives, permutations of a few of these components. In addition to these conventional types of trademarks, there are also a variety of other types of trademarks, including Color; Acoustic vibrations; Form of commodities; Olfaction; Tactile sensation; surface quality; and holographic imprints.

2. Legislation concerning Non-traditional trademarks in (EU) and (US)

Adopted in March 2006[234], The Singapore Treaty on the Law of Trademark *STLT* updates the global trademark framework by broadening the scope of enforceable trademarks to encompass nontraditional marks, such as sensory marks, color, location, and motion marks, amongst others. Members have the authority to mandate electronic submission of files.

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[233] *Tshimanga Kongolo, African Contributions in Shaping the Worldwide Intellectual Property System, Publisher Routledge, 2016, p45*

[234] *Joachim Kobuss, Alexander Bretz, Arian Hassani, become a Successful Designer – Protect and Manage Your Design Rights Internationally, Walter de Gruyter, 2012, p124.*

In addition to the TRIPS agreement, which aimed at establishing new types of trademarks and standardizing trademark laws among its members, *STLT* has established the necessary intellectual and administrative components for the safeguarding and management of trademarks across all tiers. Countries have modified their regional trademark laws based on international law, taking into consideration mutually beneficial agreements to safeguard and facilitate international in-nature trademark inquiries and registrations.[235].

Both the US and the EU allow owners of rights to safeguard any element of a brand that differentiates the origin of the products, as long as it is unique and not just descriptive or utilitarian. Non-traditional markings may include noises, colors, shapes, actions, holographic images, smells, tastes, and textures. Trademark registration can protect marks that can differentiate from other kinds of goods and services. Nevertheless, in reality, acquiring legal recourse for nontraditional marks may prove a challenging endeavor[236].

2.1 EU

Peculiar kinds of trademarks serve to safeguard distinctive and popular visual elements of products that have gained widespread recognition, such that the general public associates these features with the product. Additionally, it grants the proprietor a distinct competitive edge in the production and marketing of these products and packaging. In this regard, the author will examine various forms of non-traditional marks and analyze the inherent barriers involved with their licensing in the EU, US, and Jordan as follows:

Signs eligible for registration must possess the ability to differentiate the goods and amenities of one company from those of others. Additionally, they have to be allowed to be presented visually in a manner that enables both authorities and the general public to clearly and accurately understand the nature of the registration.[237].

2.1.1 Main background

EUTMR states that a trademark may consist of: “any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or the packaging of goods, or sounds, provided that such signs are capable of being represented on the register, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor'.[238]

Before the 2015 EU trademark reform, *'CTMR* stated that a community trademark might be composed of any signs that could be visually depicted.[239]. The *CJEU* observed that the *CTMR*, a directive of the Council, permits the registration of any signs, even those that are not visually perceivable, for so long as they can be graphically represented and are capable of distinguishing the goods or services of one company from another.[240]. The graphic depiction must adhere to specific standards, including clarity, precision, self-containedness,

[235] *Sreenivasulu N.S, Law Relating to Intellectual Property, Partridge Publishing, 2013, p48.*
[236] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, 2018, https://www.worldtrademarkreview.com/article/non-traditional-trademarks-comparative-analysis*
[237] *Tanya Frances Aplin, Tanya Aplin, Jennifer Davis, Intellectual Property Law: Text, Cases, and Materials, Publisher Oxford University Press, 2022, p375*
[238] *Article 4 of EUTMR (2017/1001)*
[239] *'CTMR (EC) No. 207/2009*
[240] *Tanya Frances Aplin, Tanya Aplin, Jennifer Davis, Intellectual Property Law: Text, Cases, and Materials ibid, p375*

accessibility, intelligibility, durability, and objectivity. Practically speaking, visual indications are more inclined to fulfill these criteria and, hence, have a higher probability of being officially recorded.[241]. In this context, the *CJEU* decision in the case "*Dyson Ltd v Registrar*"[242] Trademarks support the claim that not all signs whitethorn establish a right to be registered as a trademark.

The (*EUTMR*) has removed the need for a visual representation of a trademark on the Register of European Union trademarks (the 'Register')[243]. A trademark can be shown on the Register in any form as long as it can be recognized by (*EUIPO*) and the general public. Consequently, this modification permits a broader range of signs to be officially recognized as European Union trademarks.

3. Nontraditional trademark in the EU

Non-traditional trademarks encompass trademarks that protect unconventional elements such as shapes, colors, smells, or sounds. Although being a minority of the total number of trademarks registered at (EUIPO), these marks are often used by enterprises as a creative and effective way to distinguish their products or services. In this regards, the author will anylise

3.1. Phonetically pronounce them

The *EU* Previously, *EUTMs* were required to have the ability to be visually represented for them to be eligible for registration. Consequently, musical scores were commonly used to express sound marks. Additional depictions, including sonograms and spectrograms, were also deemed acceptable, as long as they accurately portrayed pitch, temporal improvement, and volumes.[244].

EUIPO started accepting sound files as part of internet-based applications in 2005. Initially, it was necessary to include a visual depiction alongside these. Since the implementation of the EU trademark reforms, the *EUIPO* and national IP offices have the option to adopt digital sound recordings as the exclusive form of representation for a sound mark application. Consequently, it has theoretically become more convenient for rights holders to register sounds as trademarks officially. Nevertheless, they are still required to overcome the obstacle of distinctiveness.
The condition for distinctiveness frequently poses more limitations than the necessity for graphical representation when it comes to non-traditional marks. In the case of Globo *Comunicação e Participações S/A v EUIPO*[245], Globo submitted an application for a trademark consisting of musical notes arranged on staff, along with a clef, rests, and erroneous.

The court observed that for a sound mark to be eligible for registration, it must possess a distinct quality that allows potential customers to recognize it as a trademark. Additionally, it should not be composed of something that functions or a mere sign lacking any intrinsic features. The appeals court concluded that Globo's sign was deemed to possess an "excessive simplicity" and could not thus effectively communicate a memorable message to consumers.

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[241] *Igor Demcak, Guide to non-traditional trademarks in the EU and the US: definitions, laws, and examples, February, https://www.tramatm.com/blog/category/legal/guide-to-non-traditional-trademarks-in-the-eu-and-the-us-definitions-laws, 2023*
[242] *Dyson Ltd v Registrar Case C-321/03, EU:C:2007:51, [2007] ECR 1-687*
[243] *EUTMR, No. 2015/2424, which became effective on 23 March 2016 and was subsequently codified as 2017/10012.*
[244] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[245] *Globo Comunicação e Participações S/A v EUIPO (Case T-408/15)*

Consequently, customers would not consider it as a trademark until it had gained distinction via usage. Regarding this matter, the court determined that the technical subtleties that Globo alleged in the sound were not audible during playback. If Globo had provided a recording of a musical instrument (or device) producing a unique and unconventional sound, it could have potentially qualified for legal protection.

3.1 Color-based trademark

Individual colors could be filed as *EU* trademarks if these have gained distinctiveness. While it requires a symbol to be displayed to be claimed[246]-Colors, as well as mixtures of these components, might be part of a request for protection due to their significance. Thus far, the CJSC has established in the matter of *Red Bull GmbH v EUIPO*[247] –that the application for registration contains a methodical organization that links the colors in a pre-established and consistent manner. When applying for color marks, it is customary to use globally renowned identifying codes, such as Pantone. By utilizing an established and accurate grading structure, appellants can verify that the extent of safeguarding they are seeking is unambiguous and well-defined.

No doubt that Color marks can manifest in a variety of ways, such as a single color, an amalgamation of colors, symbolic colors, or colors that have been used on products or packages.[248]. While color can be considered a sign, it is typically a basic characteristic of objects.[249].

However, when evaluating a color trademark, the register will take into account whether or not the color has the capacity to distinguish between the origin of the items or services in question and differentiate them from other similar products in the perception of the target audience. For instance, the EUIPO has declared that the shade of turquoise is a fundamental color that is readily associated with products like home linen, paint, and ornamental things by people in general. Therefore, although turquoise blue may symbolize a decorative trademark, it cannot be regarded as unique. This position also advocates for an overall interest in not excessively limiting the range of colors available to other companies that provide similar goods and services.[250]

There is a contention based on the public's concern that colors that are not restricted to a certain area should remain accessible to everyone. It is well acknowledged that colors can serve as trademarks on their own, contingent upon the particular setting in which they are employed. Notable instances of enrolled color trademarks involve gas stations' use of the color green, the *EUIPO's* recognition of the colors green and yellow for agricultural machinery, Heinz Beans' use of the color turquoise in the United Kingdom Australia's recognition of the color terracotta for insulation pipes, and the US's recognition of the color pink for fiberglass. Cadbury Chocolate's use of the color purple in Ireland[251].

As a result, requests that encompass a wide range of products and services are less likely to be approved compared to applications that are more narrowly focused. Furthermore, the worldwide accepted color codes have a restricted range of options. Consequently, significant

[246] *Nari Lee, Niklas Bruun, Mingde Li · Governance of Intellectual Property Rights in China and Europe, Publisher Edward Elgar Publishing, 2016, p142*
[247] *Red Bull GmbH v EUIPO, Joined Cases T-101/15 and T-102/15)*
[248] *Helen Johnson, A Guide to Trade Mark Law and Practice in Ireland, Publisher Bloomsbury Publishing,2nd edition, 2023, p248*
[249] *Justine Pila, Seville's EU Intellectual Property Law and Policy, publisher Edward Elgar Publishing, 2022, P382-383*
[250] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[251] *Helen Johnson, A Guide to Trade Mark Law and Practice in Ireland, ibid, p248*

proof is required to demonstrate that the public associates a specific hue with the commodities sold by the person submitting the application. Notable instances of single-color trademarks that have been registered successfully include 3M's trademark for the color the canary yellow on their post-it notes, and *Christian Louboutin's* trademark for the color red applied exclusively to the soles of their shoes.[252]

Customers aren't used to forming conclusions regarding the source of products solely because of the color of their package or the color of the products themselves. Typically, there is an extra graphic or textual component. Consequently, a color is not typically recognizable in its own right. Furthermore, the pertinent public is seldom able to impartially evaluate goods in a variety of vibrant colors, resulting in a restricted number of colors that it is possible to differentiate. In the same vein, the number of distinct colors that can be used as possible trademarks to differentiate between items or services is restricted.[253]

The *CJEU* has recognized that certain trademark registrations for particular services or items can restrict the variety of colors that can be used. Nevertheless, a unique and recognizable identity might be developed by regular utilization. The Court in the case of "Heidelberger Bauchemie" examined the possibility of registering combinations of colors, specifically blue and yellow, which the corporation argued were utilized in all possible variations. The Court noted that colors have little intrinsic ability to convey accurate data, but they can develop unique characteristics. The test is analogous to *EU* law, guaranteeing the accessibility of colors for other merchants. When it comes to a hue, it is impossible to have uniqueness without any previous use, particularly in extraordinary situations and with a limited range of products or services. Alternate forms of typical forms for a specific product are probably going to be considered as lacking uniqueness.[254]

However, in order to prevent the concentration of power in a single entity, legislators and judicial bodies have set multiple requirements that must have been met prior to color being granted legal protection. These minimum standards are addressed at various stages of the doctrinal examination. The case law of (*CJEU*) includes instances of 'registration' situations. US courts frequently adjudicate matters about "customer confusion" and "functioning" along with the concept of "supplementary meaning." The matter under the law (*CJEU*) deals with matters related to trademark eligibility and uniqueness of colors. [255]

The initial lawsuit revolved around Libertel, a mobile phone provider, submitting 'orange' as a trademark to the Benelux trademark office. According to the *CJEU*, when it comes to a hue by itself, it is typically quite unlikely for it to be identifiable without prior use, save in rare situations. Therefore, color can only be officially registered if it has reached a certain level of uniqueness concerning the goods services, or products it is being registered for. Currently, there is no practical value or relevance regarding the goods or services that the licensing is being requested. Practical application in the market is essential. A color will only be considered unusual in extremely rare situations where it has not been used before. The Court has imposed this constraint since colors are predominantly utilized for embellishment and decoration.[256],

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[252] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[253] *Justine Pila, Seville's EU Intellectual Property Law and Policy, publisher Edward Elgar Publishing, 2022, P382-383*
[254] *Justine Pila, Seville's EU Intellectual Property Law and Policy, ibid P382-383*
[255] *Enrico Bonadio, Aislinn O'Connell, Intellectual Property Excesses: Exploring the Boundaries of IP Protection, Publisher Bloomsbury Publishing, 2022, p244.*
[256] *ibid, p244.*

3.2 Smell trademark

In case *Sieckmann v Deutsches Patent- und Markenamt*[257]. Traditionally considered as a practical application over trademark color[258] Mr. Sieckmann applied for a German trademark for a smell. The CJEU clarified the intended use of graphic representation in that case Graphic representation' necessitated that the insignia be visibly displayed to facilitate its precise identification, according to the Court.

The latter was necessary for the system of registration to function properly, as it was necessary to ensure that the range of safeguarding was clearly defined along with ensuring that the Register was available to all important stakeholders, including the government (as the Register's management) along with other traders. As a result, the representation was required to be "objective, durable, intelligible, independent, and clear." [259]

The 'Sieckmann 7' requirements are frequently referred to as such. In theory, a smell might be registered as a trademark since it conveys something to the customer. Nevertheless, the CJEU determined that all three approaches put forward by the German trademark registry for illustrating the smell of cinnamon a chemical structure (which in turn could have only made known the substance itself, not its smell), a verbal explanation, or a sample did not satisfy the above requirements. The Court was limited by the structure of the Art. TFEIJ guidance, which posed a succession of closed-ended questions rather than soliciting broad guidance regarding how to represent a smell[260].

Previously, according to EU trademark law, a mark needed to have the ability to be visually represented. The German trademark authority rejected this mark because it was unlikely to be visually represented and lacked distinguishing characteristics. [261] The case was brought before the (GSC) and subsequently referred to the Court of Justice of the European Union (CJEU). They included one of the most renowned phrases in trademark law, which states that the depiction of the mark must be 'clear, exact, self-contained, easily accessible, comprehensible, durable, and objective'. (CJEU) issued its ruling in the case of Libertel after six months. A mobile telecoms business aimed to officially register the color orange as a trademark for their equipment and services in the Benelux region. The application was rejected and subsequently referred to the (CJEU). [262].

Following the change of EU trademark law in 2015[263], it is no longer necessary for a mark to be visually depicted. However, the standards of accuracy as well as clarity are now specified

[257] *C-273/00 Sieckmann v Deutsches Patent- und Markenamt [2002] ECR I-1 1737.*
[258] *Tanya Frances Aplin, Jennifer Davis, Intellectual Property Law: Text, Cases, and Materials, Publisher Oxford University Press, 2017, p366*
[259] *Stavroula Karapapa, Luke McDonagh, Intellectual Property Law, Publisher Oxford University Press, 2019, p243*
[260] *Stavroula Karapapa, Luke McDonagh, Intellectual Property Law, Publisher Oxford University Press, 2019, p243*
[261] *R. Bird, Robert Bird, Subhash C. Jain ·, The Global Challenge of Intellectual Property Rights, Publisher Edward Elgar Publishing, 2009, p185*
[262] *Hayleigh Bosher, Eleonora Rosati, Developments and Directions in Intellectual Property Law: 20 Years of The IPKat, PublisherOxford University Press, 2023, p374.*
[263] *EU Directive2015/2436*

in EUTMR regulation. "The shift from using visual symbols has not increased to non-conventional marks being officially recognized. Specifically, there are no scents or smells registered as trademarks in the European Union Trademark register."[264] The most recent registration specifically for a single color was in 2014, however, there have been a few registrations for combinations of two or more hues since then, although not many. Numerous methods of registering 3D shapes, however, do not hold up well when tested or questioned by other parties. Non-traditional marks attract considerable interest in the trademark field, possibly due to the issues they present. However, it is uncommon for the typical trademark attorney to encounter them, if at all. [265].

3.3 Shape mark

Assuming a unique configuration acquiring registration for shape markings is widely recognized as challenging, as registries and courts frequently determine that a shape by itself cannot serve as a distinctive indicator of origins. Instead, they place greater importance on any verbal features accompanying the applied-for mark.

Within the European Union, Article 7 of the EU Trademark Regulation outlines the main factors to be taken into account when determining the eligibility of shape marks for registration. Specifically, signs cannot be registered if they solely consist of "the form that arises from the inherent characteristics of the goods, or the form of goods that is necessary to achieve a technical outcome, or the form that significantly adds value to the goods."

Even if additional aspects are added to a mark, it may still be ineligible for registration if, in the perception of the relevant customer, its shape simply represents the items for which registration is being sought. In this scenario, the shape will be categorized as either descriptive or non-distinctive.

The registration for the Scrabble tile as a shape mark was rejected in 2013 due to the possibility of the mark encompassing various combinations of each tile. The registration for the Scrabble tile as a shape mark was denied in 2013 due to the possibility of the mark covering various combinations of each tile.

The image is credited to Indre Pau/Shutterstock.com. There are also other legal obstacles to registering forms as trademarks, even if the requirement for graphic representation is eliminated. Case law has demonstrated that attempts to register shape markings solely based on their verbal descriptions can be unsuccessful due to a lack of clarity, precision, and neutrality. In the instance of Dyson v Registrar of Trademarks[266] (CJEU) ruled that Dyson was not allowed to register the idea of a "transparent bin or collection chamber forming part of the external surface of a vacuum cleaner" because it could have various appearances. In the case of JW Spear & Son Ltd v Zynga Inc, [267]the makers of Scrabble were unable to register the shape of a scrabble or word tile. The application described the tile as "a three-dimensional ivory-colored tile with a letter of the Roman alphabet and a number from 1 to 10 on the top surface." The court determined that the mark did not qualify as a sign because it had the potential to encompass numerous signs that might be created by rearranging, displaying, and combining the numbers and letters on each tile.
Motion trademarks and holograms are used for mobility.
obility.

[264] *Article 4(b) of the 2017/1001 (EUTMR) regulation*
[265] *Hayleigh Bosher, Eleonora Rosati, Developments and Directions in Intellectual Property Law: 20 Years of The IPKat, ibid, p374.*
[266] *Dyson v Registrar of Trademarks (Case C-321/03*
[267] *JW Spear & Son Ltd v Zynga Inc ((2013) EWCA Civ 1175),*

Before the elimination of the necessity to visually depict trademarks, motion marks were commonly safeguarded by graphical representations consisting of a sequence of frames that, when observed consecutively, displayed the relevant motion. Notable trademarks registered using this method include Kraft Foods' trademark for chocolate confectionery, which features the image of a chocolate orange being broken apart, and Asda's registration for a double-tap on the back pocket of pants or a skirt Likewise, applicants for registering an EU hologram mark were required to include images of every distinct perspective of the hologram unless the mark was sufficiently uncomplicated that its appearance remained unchanged regardless of the viewing angle.
cants for registering an EU hologram mark were required to include images of every distinct perspective of the hologram unless the mark was sufficiently uncomplicated that its appearance remained unchanged regardless of the viewing angle.
nts for registering an EU hologram mark were required to include images of every distinct perspective of the hologram unless the mark was sufficiently uncomplicated that its appearance remained unchanged regardless of the viewing angle.
Consequently, the need for visual depiction posed a significant challenge for applicants in presenting comprehensive depictions of their trademark. After the elimination of this prerequisite, the process of applying has become significantly easier, as motion markings and holograms can now be registered by submitting a video showing the specific mark.

For holographic marks, applicants have the option to provide a duplicate of the hologram. In April 2018, ZWILLING JA Henckels AG a trademark of the knife manufacturer in Germany[268] became the first brand owner to utilize this new structure by applying for the trademark "*LET THE AROMA RAIN DOWN LA COCOTTE*". Furthermore, starting October 1, 2017, more than 30 applications for motion marks have been submitted, making use of the opportunity to include videos. The United States Short, repeated motions can also be legally protected in the United States.

Applicants are required to submit and the submission should include a visual representation of the mark, which can be just one location in movement or up to five freeze frames. Additionally, a written explanation of the mark should be provided. Finally, a specimen should be included that demonstrates the repeated motion along with how the mark is utilized for the products and services in question. Video clips, a series of still images, or screenshots are all suitable examples.

Trademarks will be denied registration if the movement of the trademark is essential to the functionality or usefulness of the product, such as when the limbs of a grasping instrument swing in and out to grasp items. The motion marks that have been successfully registered include Meetup's US Registration 5536323, which involves a swarm of dots moving to form the letter 'M'. Another registered motion mark is Dallas Fort Worth Airport's US Registration 5536125, which features a straight line shifting through the airport's logo. Lastly, US Registration 4471065 involves the movement of the letters in the word ENERGY shifting to spell GREEN.
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the airport's logo. Lastly, US Registration 4471065 involves the movement of the letters in the word ENERGY shifting to spell GREEN.

[268] *Henry van de Velde, Henry van de Velde: Selected Essays, 1889–1914, Getty Publications, 2022, p247.*

To apply to register a hologram as a trademark in the US, the person applying must present proof demonstrating that customers will recognize the hologram as a distinctive symbol of a particular brand or product. If there is no proof of customer acknowledgment, the investigating attorneys will reject the registration as invalid. Holograms featuring several perspectives are going to be rejected for registration if the person applying intends to register more than one trademark. Due to these restrictions, acquiring a US registration for a hologram is exceptionally difficult.
uiring a US registration for a hologram is exceptionally difficult.
iring a US registration for a hologram is exceptionally difficult.

3.4 Taste mark

The protection of tastes as trademarks has historically been challenging inside the European Union due to the necessity of providing a graphical depiction in addition to a description, sample, or chemical formula. Furthermore, some intellectual property offices have contended that a flavor cannot be considered a trademark. This is mostly because buyers can only experience the taste of the items in dispute right after they have made the purchase.

While it is no longer obligatory to visually depict a trademark in an application, a sample of the taste or an explanation of it would be unlikely to meet the requirements of being "clear, precise, self-contained, easily accessible, intelligible, durable, and objective." This is particularly true because tastes are subjective and exceedingly hard to pin down and compare.

Overcoming the problems of establishing individuality and proving that a taste is not solely a functional outcome of the things themselves is exceptionally arduous. Typically, customers find it challenging to differentiate between the inherent taste of a product and the specific formula employed by the manufacturer, which sets its products apart from those of its rivals.

Applying for a taste mark may include disclosing a recipe that was previously kept as highly protected proprietary information, such as the recipes for Coca-Cola, McDonald's Big Mac sauce, or KFC chicken. Despite potential legislative changes that could simplify the registration of taste marks, corporations might opt to prioritize trade secrets as their main form of protection, rather than taking the risk of disclosing their recipes to the public domain.

3.5. 3rd, black and white mark

It is not surprising that a greater number of black and white marks are rejected for registration compared to color marks. Similarly, a higher number of marks lacking non-3D features are also rejected for registration compared to those containing such features. The reason for this is the fact that both color and non-3D elements, as long as they are significant, may be beneficial to making the mark distinct from those currently present in the market, and so less likely to be seen as lacking distinctive qualities. Similarly, it is reasonable to anticipate that a larger number of product forms would be rejected for registration compared to container shapes, as the former is more likely to significantly impact competition. Businesses have historically utilized packaging materials to communicate details about their products, which consumers may be more inclined to interpret as indicators of origin compared to the product's physical structure[269].

[269] *Estelle Derclaye Research Handbook on Empirical Studies in Intellectual Property Law, Publisher Edward Elgar Publishing, 2023, p266*

The CJEU's precedent states that issues of competition should only be formally evaluated as part of the Article 7(1)(e) analysis, which can be hard. These data imply that the impact on competition could be indirectly assessed through Article 7(1)(b), which was originally proposed by Dinwoodie. This is because there is a higher rate of refusal for registration of marks that are likely to limit competition.[270]

3.6 Is Lack of Distinctiveness the Most Common Reason for Marks to be Refused?

The hypothesis claimed that the most common reason for marks to be denied registration was going to be a failure to demonstrate uniqueness. Descriptive statistics were employed to evaluate the issue that was most frequently utilized as the foundation for marks being declined. [271]

It is important to note that a mark can be rejected for multiple reasons. The data shown below clearly indicates that what was the most prevalent cause for marks being denied registration, accounting for 92.4% of decisions with stated reasons, was lack of uniqueness. Therefore, the hypothesis was validated. Following that, the associated reasons were mentioned in only 5.6% of verdicts. Following the first indent, the second indent (5.2%,) and third indent (4.0%,) were subsequently presented. Descriptiveness was only present in 2.4% of cases. Furthermore, as per the jurisprudence of the Court of Justice of the European Union (CJEU), competition concerns only need to be directly taken into account, at the very least, as a component of the examination under Article 7(1)(e). These data imply that the impact on competition could be indirectly assessed through Article 7(1)(b), which was earlier proposed by Dinwoodie. [272]

This is because there is a higher rate of refusal for registration of marks that are likely to limit competition. One disadvantage of the present research is that it only investigated denied marks. Therefore, we are unable to utilize this data to verify the relationship between black-and-white shapes of goods or marks.[273]

4. United State

The American legislator indicates clearly that a TM may be made up of “any word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others”[274].

However, under US law, not all forms of trademark registrations at the federal level are required to have a graphic representation. This is in contrast to the previous requirements under EU law before the change. According to the requirements of (USPTO), those applying for a non-traditional trademark must include a clear drawing with the initial request so as to establish a submission date for any trademark registration application. The illustration replicates the mark in the Trademark Official Gazette and on the registration certification. The USPTO implemented a registration process specifically designed for non-visual markings, known as "mark drawing code 6".

This kind of classification is used for registering noises, fragrances, and various other non-visual marks. In this regard, the drawing code's presence indicates that, according to U.S.

[270] *ibid p266*
[271] *ibid, p286*
[272] *ibid p286*
[273] *ibid, p286*
[274] *The Lanham Act, 15 U.S.C. §§ 1051 et seq., was enacted by Congress in 1946.*

law, official requirements permit the safeguarding of non-traditional signs, even those that are not visual in nature. In addition to meeting the formal requirements, every mark must satisfy certain substance conditions: (i) it must possess a unique and recognizable personality; (ii) it must be actively used; and (iii) it must get around the obstacles to legal protection outlined in the Trademark Act of particular importance for non-traditional marks is the demand to avoid efficiency. Instances of Typical Trademarks, popular businesses have registered several cases of unusual trademarks.

Form trademarks that have been registered with accomplishment include the distinctive shoe form of Manolo Blahnik, the design of the Longchamp Le Pilage bag, the packaging of a Toblerone chocolate bar, the iconic 4-bar shape of KitKat chocolate, and various more. Notable registered sound trademarks include the Audi 'heartbeat' sound logo, the 'Intel Inside' musical jingle, the Samsung ringtone, the Renault 'Passion for Life' sound logo, the Nissan 'Innovation that Thrills' sonic logo, the Netflix sound logo, the Nokia melody, and the BMW sound logos, among others. Notable instances of currently registered color trademarks include T-Mobile's Magenta, Milka-chocolate's Lilac, Tiffany and Co.'s Blue, Fiskars Scissors' Orange, Reese's Orange, United Parcel Service's Brown, and others. [275]

4.1 Sound trademark

The USPTO also allows for the submission of digital sound recordings to identify sound markings, however, a comprehensive description of the mark is also required. Furthermore, suppose the sound trademark incorporates music or lyrics set to music. In that case, the USPTO advises applicants to provide musical scores as a supplementary component to the written description of the trademark.[276].

Sound markings that serve as identifiers of origin are eligible for protection in the United States, as long as they are arbitrary or possess distinctive qualities. Only sounds that have gained distinctiveness via frequent use and marketing in marketplaces over enough time can be listed on the main Registry about an item's ordinary operation.

In the case of re-Powermat Inc. vs TTAB,[277] The TTAB determined that the 'chirp' sounds produced by battery chargers, characterized by a fluctuation in pitch, are frequently linked with the normal functioning of a charger. As a result, these sounds do not possess related distinctiveness and must demonstrate proof of gained distinctiveness to be considered to be eligible for registration. Establishing established uniqueness typically necessitates demonstrating that the sound: Term has been extensively and solely employed as a registered trademark in the US for not less than five years. Additionally, it has been prominently showcased for customers as a distinct identification of the manufacturer through significant advertising and promotional efforts.

4.2 Color trademark

In the United States, an object can be registered with a color or color combination if it has gained uniqueness and is not used for practical purposes. Trademark registrations include color drawings that represent color marks, along with written statements that specify the name of the color or colors and provide a description of how and where they are put onto an

[275] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, p3*
[276] *ibid p9*
[277] *rePowermat Inc vs TTAB (105 USPQ2d 1789, 1793 (TTAB 2013)),*

object. The USPTO has also approved the use of identifying numbers from commercial identification systems, such as Pantone, as a component of the color-mark assertion.[278].

Color markings are not naturally distinctive in the US; hence applicant must provide evidence of developed distinctiveness in order to obtain trademark protection. Typically, this necessitates providing evidence of widespread usage, sales, and promotion that emphasizes the color as a distinctive mark. Demonstrating that color is not functional can be a major challenge for applicants, and the US system employs different methods to establish the meaning of 'functional'. Functional colors are indispensable for the utilization or intended function of the object, and if they impact the cost or quality of the article, they cannot be registered. A color can also serve a practical purpose if it is more cost-effective to produce or utilize. Although facing challenges, certain single-color trademarks have been deemed non-functional and have gained uniqueness in the United States. Examples include Robin's egg blue for Tiffany packaging and chocolate brown for UPS delivery services[279].
Furthermore, a color can be considered "functional" when it is necessary for the intended usage or function of the object, or if it has an impact on the cost or worth of the article, as demonstrated in the situation of" *Qualitex Co v Jacobson Prods Co*".[280] In such cases, the color cannot be registered. Orange and yellow are chosen as functional colors for precautionary signage due to their high visibility, but pink is selected as a functional color for surgical incision treatments because it closely mimics specific hues of human skin. Color can also have a practical purpose if it is more cost-effective to produce or utilize, such as when it is a by-product of the production process.[281].

4.3 Shape marks

Shape marks can be a valuable instrument for protecting intellectual property rights in the United States. However, brand owners encounter two main challenges when asserting that the shape of a product serves as a trademark: utility and distinctiveness. If a shape mark is determined to have a functional purpose, it is not eligible for registration.

Similar to color marks, a form mark is considered functional and hence cannot be registered if it is necessary for the use or purpose of the goods, or if it has an impact on the cost or quality of the product. Applicants must be aware that even if a shape is highly distinctive, it will not receive trademark protection if there is a utility patent that reveals the functional aspects of the shape. In the case of re Howard Leight Indus, LLC (TTAB) determined that the applicant's ended practicality patent, which explicitly describes and claims the practical benefits of the bullet-shaped headphones, and demonstrates that the form of the earplugs affects their quality, is enough evidence to establish that the configuration is functional.[282]..

Unlike shape marks, US design patents are not necessarily at odds with the idea of shape marks. Design patents can strengthen an applicant's assertion that their use of a specific shape

[278] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[279] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[280] *Qualitex Co v Jacobson Prods Co, 514 US 159, 165, 34 USP1163-64 (1995),*
[281] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*
[282] *Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, ibid 2018*

in the market has proven restricted for a long time. This, in turn, supports their argument about how the mark has gained recognition and uniqueness among customers.

A shape's uniqueness is crucial to securing registration and effectively maintaining unconventional trademarks. A trademark that comprises a product design is not intrinsically distinctive and consequently is unable to be registered unless the person seeking registration can prove that the mark has gained distinctiveness as Wal-Mart Stores, Inc. v Samara Bros.[283]

Occasionally, a disagreement may occur regarding whether or not the claimed content of the form is just the result of the product's design or if it qualifies as product packaging. The distinction between product packaging and product design or setting is crucial when assessing how much responsibility the applicants have. Product containers may be innately distinctive and capable of functioning as a trademark from the beginning. On the other hand, the item design or arrangement may not be inherently distinctive. In the case of "In re Pacer Tech", it was determined that a product's cap packaging was not inherently distinctive and did not function as a trademark because its "winged configuration" was simply a variation or elegance of a basic design scheme for an adhesive product applicator cap. Individuals who wish to register a product design or use an unregistered item design in a legal dispute must provide strong evidence that the design has gained enough uniqueness to be considered a trademark. This requirement was demonstrated in the case of “In re Gibson Guitar Corp, [284]Where it was determined that 66 years of use was not enough to establish distinctiveness for the guitar design, certain fundamental shapes are so widely used that they may never meet the necessary criteria to be eligible for trademark protection. Prolonged utilization of a singular form will aid in establishing a recognizable identity, but it may not suffice to fulfill the obligation of the rights holder to substantiate this claim. Frequently, the party claiming acquired uniqueness in a shape mark must demonstrate a track record of targeted marketing, that develops a connection in customers' minds between the design's usage and its origin. Furthermore, especially in the context of legal disputes, the party making the claim may be required to hire an expert who can use a consumer survey to prove that the public identifies the shape of the product as a distinctive sign of its origins.
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4.4 The Taste Mark

While tastes can be recognized as trademarks in the United States, TTAB has determined that tastes are not intrinsically unique. This is because flavor is usually a characteristic of the products and does not strongly identify the source. To register a taste mark, the applicant must provide evidence that the specific flavor or taste in question has developed a unique and recognizable quality.

[283] *Wal-Mart Stores, Inc v Samara Bros, 529 US 205 (2000)).*
[284] *Gibson Guitar Corp, 61 USPQ2d 1948 (TAB 2001),*

Another challenge in obtaining a trademark for taste is that flavor is frequently determined to have a utilitarian function rather than serving as a means of identifying the source. Consequently, like other non-traditional trademarks, functional tastes cannot be registered.

In the case of re NV Organon, a pharmaceutical business sought to register the orange flavor it utilized for the coating of pills and tablets. The TTAB determined that the flavoring was functional due to its ability to enhance patient compliance, which in turn gives a competitive advantage. This conclusion was based on the fact that the flavoring was successful in attaining increased patient compliance, which is considered a utilitarian characteristic. Since patients were more inclined to consume their medication when it had an orange flavor, and since medicine is often flavored for these reasons, the TTAB concluded that the orange flavor had a practical function. Consequently, it was deemed ineligible for trademark registration.

US courts have recognized that flavor has a functional role in food, alongside its role in medicine. In the case of New York Pizzeria, Inc v Syal[285], the court determined that consumers were willing to spend more than just the cost of satisfying their fundamental hunger demands since flavor had an impact on the quality of the food in addition, the court determined that if consumers are inclined to visit a specific restaurant due to the unique flavors of its food, then these flavors confer a competitive edge to the dining establishment, so fulfilling a practical objective.

While it is possible to register flavors as taste marks in the United States, it is challenging for applicants to demonstrate that a flavor has acquired secondary meaning or distinctiveness and that it operates for a non-functional purpose. This requirement makes it challenging for US trademark those applying to successfully register flavors as trademarks.

5. Nontraditional trademark registration in Jordan

When it comes to nontraditional marks in Jordan, the main question arises whether Jordan legislators accept to register these marks or not. to answer this question, we need to harmonize the way the Jordan legislator defines trademark, on one hand, and which marks he planned to register on the other hand.

In Jordan, non-traditional marks such as sound marks, motion marks, holograms, and color marks can be registered as trademarks. The process for registering these non-traditional marks is similar to registering traditional word or design marks, with the additional requirement of submitting a clear description or graphical representation of the mark.

5.1 Definition trademark

The JTML defines a mark as a symbol or indicator that is employed or intended to be employed by an individual to differentiate their own commodities, products, or services from those of others. It is important to note that the Jordanian lawmaker did not address this specific mark in JTML.[286].

This law addressed certain types of trademarks but did not specifically mention nontraditional marks. However, the article established a general requirement in its first paragraph stating that a trademark must possess a unique characteristic to be eligible for registration. It listed

[285] *New York Pizzeria, Inc v Syal 56 F Supp 3d 875, 882 (SD Texas 201.*

[286]. *Muayad Ahmad Obeidat, Khalid Mohamed Dganni, and Nada Zuhair Al-Feel. "Hologram Trademark Between Its Essence and Legal Provisions". Migration Letters, vol. 20, no. S1, July 2023, pp. 1046-57, doi:10.59670/ml. v20iS1.3655.*

examples such as names, letters, numbers, shapes, and colors, but it also allowed for other types of trademarks that can be visually perceived, without specifying any limitations. Attempting to analyze the content of the law.
It has been discovered that unconventional symbols, such as hologram marks, are capable of being officially registered as trademarks to differentiate items, services, and products from other individuals. This is based on the request of the rule stated in this article, which classifies hologram marks as possessing a distinctive characteristic that can be visually perceived. Furthermore, the Jordanian legislator has explicitly forbidden the registration of this trademark within Article 8 of the Jordanian Trademark Law.[287]
As to Article 8 of the JTML, it is prohibited to register Marks as trademarks.

5.2 JTML and prohibited trademarks

According to the JTML, the following items may not be legally recognized as trademarks:
1- Any marks that have a resemblance to the symbol of His Majesty the King, royal crests, or the word royal, as well as any other words, characters, or representations that may create the impression that the applicant has the royal endorsement, are prohibited.
2- The emblems or adornments of the government of the Hashemite Kingdom of Jordan or those of foreign states or countries, unless authorized by the appropriate authorities.
3- Marks denoting official designations, unless their use is required by the relevant authorities to whom the mark belongs or is under their jurisdiction.
4- Marks that bear a resemblance to the national flag, military or naval banners of the Hashemite Kingdom of Jordan, its honorary awards or insignia, or the national, military, or naval flags.
5- Marks containing the words and phrases: "patent", "patented", "by the royal patent", "registered", "registered design", "copyright", "counterfeiting is a forgery", or similar terms.
6- Marks that are in opposition to public order or morals, or that result in deceiving the public, or marks that promote unfair competition in trade, or include false indications about their true origin.
7- Marks that are commonly used in trade to distinguish or describe goods, or words that have a geographical or surname meaning, cannot be registered unless they are represented specially. However, marks that have a distinctive character, as defined in items 2 and 3 of Article (7), can still be registered.
8- Marks that are the same or similar to symbols that have a purely religious meaning.
9- Marks that incorporate the image, name, or brand name of an individual, or the name of a corporation or organization, without the explicit agreement of the respective individual or entity. When dealing with individuals who have just passed away, the registrar has the authority to request permission from their legal representatives.[288].
10- A mark that is similar to a mark owned by someone else and already recorded in the register for the same items or category of goods for which the mark is proposed to be registered, or a mark that closely resembles such a trademark to the point of potentially misleading third parties.

11- Marks that resemble or are identical to the emblems of the Red Crescent or the Red Cross on a white background, or the emblems of the Red Cross or the Cross of Geneva. [289].
12- A trademark that is the same or similar to a well-known trademark, or a translated version of it, and is used on similar or identical goods, can be confused with the well-known mark. It can also be used on different goods in a way that harms the legitimate interests of the

[287] *Ibid, pp. 1046-57,*
[288] *JTML, Article 8*
[289] *JTML, Article 8*

proprietor of the well-known mark and creates a false relationship between the proprietor and those products. This also applies to trademarks that are similar or identical to honorary badges, flags, insignia, names, acronyms belonging to international or local organizations, or those that go against our Arab as well as Islamic values.[290].

6. Advantages and difficulties of unconventional trademarks

Registering these trademarks can be considerably more challenging, since they may require substantiation of usage to attain registration. You must demonstrate that the general public has associated specific attributes of your products or services with the company's name. Although there have been instances of form and sound trademarks being adequately registered, the likelihood of registering texture or touch and a holographic trademark appears to be extremely low or insignificant. This is due to these types of trademarks cannot be visually portrayed, as touch/texture trademarks might currently simply be acknowledged through the sense of touch.

However, registering non-traditional marks can offer businesses an essential benefit in safeguarding crucial elements of their goods and services promotion. Additional advantages of registering such a trademark involve the capacity to limit or prevent other businesses from utilizing an item or services with perplexingly comparable characteristics, distinguish your product or brand, and acquire an outstanding reputation. Proficient trademark attorneys can assist in navigating the procedure for applying for non-traditional trademarks, ensuring the safeguarding of vital assets associated with your business. The user's text is a single letter "T".

There is a noticeable trend towards filing of shapes for trade style. However, the rise of 3D printing methods may cause enterprises to move away from using this sort of sign. This depends on the assumption that the unpermitted utilization of form marks will experience a substantial surge due to the advent of 3D printing, resulting in a decrease in the value of product designs that lack word marks or equivalent logos. Although it may appear improbable shortly, this could occur against the prevailing pattern of trademarking activities in Australia. IP Australia reported a 14 percent rise in submissions in 2015, routinely getting approximately 100-150 requests for design marks each year over the past decade. Considering the fact that there is currently a surge in the utilization and legal protection of shapes and trade dress due to the popularity of 3D printing, there will inevitably be a set of outcomes that policymakers along with judges must address, leading to the examination of delicate policy issues. Initially, the utilization of 3D printing and the process of registering 3D shapes may bring up past controversies over the purposes of trademarks, the justification for registering shapes and other non-traditional signs as trademarks, and the broader enlargement of what can be registered as subject matter. It might even prompt a reassessment of the role of the trademark in addition to its financial purpose as a symbol of source, which is crucial to the contemporary justification of the trademark statute as a strategic change toward trademarks[291].

[290] *JTML, Article 8*

[291] *Dinusha Mendis, Mark Lemley, Matthew Rimmer,3D Printing and Beyond Intellectual Property and Regulation. Publisher Edward Elgar Publishing, 2019, p312.*

Conclusion

As a result, there is no reason to prevent nontraditional trademarks from being registered in Jordan if comply with trademark conditions despite Jordan's legislator didn't set specific regulations to register such trademarks.

Non-traditional registrations of trademarks are few in the E U. From 1996 to 2012, the majority (99%) of trademark applications in the European Union (EU) were for either word or figurative marks. Although the recent elimination of the need to visually represent marks has made the application process easier for certain unconventional types of marks (such as sound marks, motion marks, and touch marks), there appears to be a minimal rise in requests for execution, least with regards to the EUIPO.

To gain registration, a sign must be distinctive and non-descriptive, regardless of how it is designated. Non-traditional trademark proprietors frequently face a challenging task and must provide proof of acquired distinctiveness to show that the public associates an identifiable product feature with an entity in particular.

The procedure for submitting a non-conventional trademark in the US is reasonably simple. Nevertheless, candidates encounter comparable obstacles when it comes to registration and even compliance. The primary obstacle frequently lies in proving that a non-conventional mark lacks functioning, considering the diverse interpretations of 'functionality' under US trademark law. For rights holders who can conquer this obstacle, the subsequent significant hurdle is frequently demonstrating that a non-traditional symbol has gained uniqueness in the market and is now recognized as representing the origin of the products or services in question. Merely having exclusive use for a long time may not be sufficient to fulfill every requirement of this rigorous criterion.

Chapter 4 Trademark registration

A trademark can be given protection based on either usage or registration. Traditionally, both courses of action have been established; however, trademark protection systems typically combine both components today. The author will examine trademark registration and usage to understand how both would protect trademark rights.

1. Trademark registration system

The root of trademark registration esteem from the Paris Convention for the Protection of Industrial Property of March 20, 1893 ("the Paris Convention") places contracting. Nations are responsible for offering a trademark register. Among around one hundred States, Jordan has abided by the Paris Convention. Almost all countries today attend a trademark register, and complete protection of the trademark is secured by registration. Nevertheless, users still play a crucial role.

First, in countries that generally base trademark protection on usage, registering a trademark confirms the trademark ideal obtained by usage. As a result, the first user has priority in a trademark dispute, not the one who first enrolled the trademark[292]. This procedure has been chosen by the USA, Indonesia, the Philippines, and all nations with systems of law on the standard British model (Singapore, India, Hong Kong, and others). Furthermore, usage significantly affects many other elements of the registration process and

[292] *Hemant Kumar, principles of copyright law and intellectual property law, Publisher Horizon Books (A Division of Ignited Minds Edutech P Ltd), 2021, P168.*

the defense of an enrolled trademark. Some countries, for instance, Maldives, Angola, Nepal, and Bhutan, have no trademark register.

The assumption here is based on the presumption that a trademark registration principle can be found in the parties' states focusing on trademark registration rights emanating from such registration. In this regard, the author will examine the assumption of trademark protection based on the registration system and then explain the impact of registration over trademark protection as follows:

1.1 Trademark registration conditions

Objective and procedural conditions must be met for the trademark's legal protection. From a realistic point of view, these conditions are necessary for the mark's existence.

1.2 Objective conditions

The objective conditions are essential to enable the trademark to be registered. In this respect, legality is the primary condition that makes trademark proprietors qualified to register their trademark

1.2.1 legality condition

The legality of a trademark means that it should not be in violation of public order and morals or prohibited by law; that is, legal texts allow for its registration. For example, according to JTML, it is not permissible to register a mark that resembles the king's emblem or royal symbol, and so on[295]. The trademark legality indicates that it should not be contrary to public morals or prohibited by law. For instance, it is not permissible to register a trademark that resembles the king's motto or public property**.** To be registered, the trademark must enjoy legitimacy and be free from any violation of the law or public order and morals.

It must not be one of the trademarks whose registration is prohibited under the provisions of the law. This condition is flexible because the term's meaning (violation of public rules and moral norms) differs from one state to another and from one period to another. The trademark to be registered must be visually perceptible. In addition to the substantive conditions for trademarks, there must be formal conditions for registering such trademarks. Formal conditions are the procedures that follow the registration of a trademark, starting from the submission of the registration application and ending with the issuance of a trademark registration certificate, Suppose the Trademark registration is registered as previously. In that case, it gives its proprietor internal protection from the date of application. It prioritizes the applicant against anyone who uses the same or similar mark after application.

As for the unregistered mark, protection is limited according to the Trademarks Law in those cases where the mark is well known. However, the attack on the unregistered trademark entitles its proprietor to protect it by filing an unfair competition lawsuit, as it applies to well-known, registered, and unregistered trademarks. Also, acts of unfair competition are material acts that can be proven by all means of proof, including the testimony of witnesses and presumptions. It should be noted that the criterion in determining the act of trademark infringement is the harm to the merchant and his commercial shop, which leads to customers leaving him, which requires talking about the element of damage.[296]

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[295] *Baker Menwer Abdelharahman Al-Saaideh, Legal Protection of Famous Trade Marks in the Jordanian Legislation and International Agreements, 2017*3، *2017, Supplement 3, Issue 4, 44 Dr Studies, Sharia and Law Sciences, MG44 ،p 347. Ibid Article 8*

[296] *am. heart ass'n et al., deadly in Pink: big tobacco steps up its targeting of women and girls 1 (2009), available at http://www.tobacco freekids.org/content/what_we_do/industry_watch/deadly_in _pink/deadlyinpink _0218 2009_FINA L.pdf (describing PMI's deliberate marketing effort to make its cigarettes more appealing to women by using colors and packaging that resemble cosmetics); McGrady, supra*

1.2.2 Distinctiveness condition

The trademark should be distinctive (with a distinguishing characteristic): The trademark should have its distinct shape, personality, and factors to prevent customers from falling into (confusing) products bearing a similar trademark. Distinctiveness would reduce the ability of the trademark proprietor to demonstrate a "likelihood of confusion." [297]

The trademark must have a distinctive shape, personality, and characteristics to prevent customers from confusing products with a similar trademark. Names, letters, numbers, shapes, and colors may distinguish the character. In this regard, the trademark is placed in a form that distinguishes the goods. Accordingly, the stakeholder who wants to be independent in using the trademark to identify the goods that he produces and manufactures or the goods that he trades in or intends to trade in can register that trademark under the provisions of the JTMLas it is one of the most important assets owned by companies, the trademark bridges the consumer and the products because it builds an image for consumers that reflects the quality of products or services. This image creates a solid relationship between the producer and the consumer.

Furthermore, a new form of trademark emerged called a collective trademark. Due to such dramatic changes, the well-known registered trademarks needed to be protected.[298]. All trademarks, whether the provisions of the Trademarks Law, govern goods, services, famous marks, or collective marks.[299]

1.2.3 Novelty Condition

Novelty Condition indicates that the trademark is new in general, so it has not been previously used or registered on the same goods or products (or services) from another person.

1.2.4 Visual perceptibility condition

the elements included in the trademark formation are tangibly perceptible, such as names, signatures, drawings, images, Inscriptions, and more. Accordingly, the mark is not registrable if it is composed of non-material elements, such as musical and vocal tones, or can be distinguished by smell or taste. Perhaps this is due to the difficulty preserving such mark models and the excessive costs.

1.3 Procedural (formal) conditions.

implementation of the procedural requirements imposed on the parties. In this sense, the procedural conditions are usually related to the registration application and period of the registered trademark.

The Trademarks Law obligates anyone who wishes to independently use a trademark according to the provisions of the commercial law to request the registration of that mark

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note 16, at 55–56 (discussing the regulatory measures intended to restrict the use of "light" and "mild" on cigarette packaging); see also Amir H. Khoury, Three Dimensional Objects as Marks: Does a "Dark Shadow" Loom over Trademark Theory?, 26 CARDOZO ARTS & ENT. L.J. 335, 336–37 (2008) (discussing examples of products that use container shape as functional equivalents of trademarks).

[297] World Trade Organization, Dispute Settlement Reports 2020: Volume 4, Pages 1523 to 2038, Publisher Cambridge University Press, 2022,p 1798.

[298] The amended law defines a collective trademark as "The mark used by a legal person to certify the source of goods not of his manufacture, the materials made from them, their quality, the method of production, the accuracy used in their manufacture, or other features and characteristics of those goods."

[299]The Trademark Directive was revised in 2008 and 2015. Nevertheless, there remains diversity among the rules guiding national trademark registration, revocation, and invalidity (c.f. Herz and Mejer, 2016; Max Planck, 2011).

under Article 6 of the law as "anyone who desires to independently use a trademark to distinguish the goods that It is produced, manufactured, elected, or issued a certificate with it or the goods that the holder trades or intends to trade. For these provisions, the holder can request the registration of that mark following the law. the holder also authorizes everyone who claims to be the proprietor of a trademark that has been used or intended to be used and wishes to register that to the registrar of Trademarks following the written The trademark must apply to the prescribed assets, and this is what is stipulated in Article (11) of the Jordanian Trademarks Law[300].

As a result of the application for registration, the law gave the trademark registrar full power to reject or accept any application without restriction or condition. The Trademarks registrar may accept the application for trademark registration with modification in the method of use because this authority is restricted by provisions (26) or place the use of the law, as the law allows the applicant to challenge the decision of the registrar with the Jordanian Supreme Court of Justice, and this is what is stipulated in Article (11) in its third paragraph.

The Trademarks Law required the registrar to register a mark upon his acceptance. Advertising in the application for registration or amending it regarding acceptance in the local newspapers shall be at the applicant's expense for registration. Since announcing a trademark registration is to inform others of its registration, whoever has an opposition must submit it within the legal period. In this regard, "Any person may object to the registrar against the registration of any trademark within three months from publishing the announcement of submitting the application for its registration or during any other period specified for this purpose[301]. The notice of applications was published before the enforcement of this law, so the period during which the opposition may be submitted and how it may be submitted shall be determined according to the Trademarks law in force at the date of publication. The applicant for registration is considered to have abandoned his application. Upon submitting a response statement to the submitted opposition, the registrar, in turn, notifies a copy of the response statement to the opposition or the objector to the registration. After the registrar hears the statements of each of the parties to the opposition and their statements, if necessary, he decides to allow the registration of the appeal before the trademark or rejection. Its decision is acceptable from the date of its issuance to the Jordanian Supreme Court of Justice within twenty days[302].

As decided by following all the previous legal procedures and following the law, the registrar issues a certificate of registration for the trademark in the applicant's name. The mark is registered on the date of the application, given that this date is the registration date for the trademark. In addition, the Jordanian legislator has set the period of proprietorship of the trademark to ten years from the date of its registration.

However, it occasionally permitted trademark registration at the proprietor's request. It required the registrar to renew that mark's registration for another ten years. Thus, other successive ones may reach an end if he so desires.

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[300] *Baker Menwer Abdelharahman Al- Saaideh ,Legal Protection of Famous Trade Marks in the Jordanian Legislation and International Agreements, 2017،3 2017, Supplement 3, Issue 4, 44 Dr Studies, Sharia and Law Sciences, MG 44 ،p 347.*
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[301] *JTML article 14/1*

[302] *ibid, article 14/6*

The term of proprietorship of trademark rights is ten years[303], and the provisions of the law may apply. As for the Renewal of its registration for a similar period following the Renewal of registered or renewed trademarks before the entry into force of the provisions of this law upon the expiry of their term of ten years.

Moreover, it is an interconnected system, from the application submission until its approval and certification, where the trademark is registered within the country following the legal provisions in force. To protect his mark from being assaulted so that he can claim compensation for any losses or damages incurred due to this infringement. Commercial.

Trademark registration in Jordan.

The Jordanian legislator set several guidelines and conditions for registering the trademark. However, the legislature did not make this registration obligatory. Hence, the proprietor can use the trademark without registering it.

However, trademark registration is a requirement for the legal protection of the trademark against any infringement.[304]. One thing the trademark proprietors must be worried about in case they do not register their trademarks is that they are not entitled to file a complaint against someone's use of the trademark. The only way to protect a trademark is to register it, and trademark registration is the point from which the legal protection of the trademark begins.

Further, registration has nothing to do with usage, as it is possible, as we have previously explained, to use the mark without registering it[305]. According to the Jordanian trademark law, the legislator specified the approved trademark but did not limit it to specific forms, which gives the court the discretion to designate another form of trademark[306]. In this regard, the law stipulated that a trademark must be unique in terms of names, letters, numbers, shapes, colors, or a combination of those elements. To register a trademark, it must be perceivable by sight. In this context, the law used the word and so on, which gives the subject Jordanian court discretion to determine whether a trademark form can be approved. Due to the importance of the commercial relationship, most legislations add the right to a trademark, which is considered to exist from the moment of registration, which is a way to prove trademark proprietorship confirmed by TRIPS.

To this point, the actual use of the trademark is a condition to accept or reject trademark registration, except in the case in which the applicant does not use that trademark before the lapse of three years from the registration date[307].

Nevertheless, an aspect of jurisprudence suggests that the proprietorship of a trademark can be fulfilled before the usage, with no registration[308]. Based on the previous, it can be concluded that the reasons that lead to gaining the right to a trademark may be material and legal facts, such as use and registration. Accordingly, the trademark proprietor is established by use, and registering this mark is considered a determination of the proprietorship. Suppose the proprietorship is proven by use for a certain period after the registration without dispute. In that case, the registration shall be considered the origin of the right of the trademark[309].

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[303] *Ibid Article 20*

[304] *Jordanian High Court of Justice (J.H.C.J): 65/1972; 87/1972; 49/1988; 171/1988; 120/1997; 470/2007; 50/2007; 510/2008;170/2011; 524/2011; 298/2012.*

[305] *Qarman, Abdul Rahman Al-Sayed (2003) Modern trends in protecting well-known trademarks: a comparative study between Egyptian and French laws in light of the TRIPS Agreement and the rules of the WIPO Organization .Cairo: Dar Al Nahda Al Arabiya, p179.*

[306] *JTML Article 1/7*

[307] *Qiyam, Khaled (1997), General Principles of Jurisprudence, Mutah University Publications, first edition, p. 166*

[308] *JTML Article (22/1), UAE Federal Trademarks Law for the NO. 37, year 1992 AD, No. (37), p. 196*

[309] *Al-Nahi, Salah Al-Din Abdul Latif Al-Wajeez in Industrial and Commercial Property, University of Jordan Publications, first edition, p. 252*

If the right to a trademark is proven, it can enjoy legal protection. This protection is claimed through filing a civil lawsuit based on tort liability or a lawsuit of unfair competition. If the trademark is registered, protection is claimed through filing a case against those who infringed the right of proprietorship.

The fixed right to own the trademark is limited to a specific time, unlike what the stakeholder believes in the right of proprietorship concerning real estate or other property, which is characterized as not restricted to a particular time[310]. the JTMLstates: "The term of proprietorship of trademark rights is ten years from the date of its registration, and its registration may be renewed for a similar period following the provisions of this law."[311] Therefore, the author believes that the legislator's limitation of the proprietorship of trademark rights to ten years is incompatible with the nature of the right of proprietorship, which is the essence that gives the proprietor the right to dispose of owned funds in all aspects of legally acceptable behavior[312].

In this context, article (18) of the TRIPS agreement states that the registration period shall be no less than seven years, adding that this period is renewable indefinitely and for the same period each time. From those above, there are three systems for creating and acquiring the right in a trademark, based on which this trademark enjoys protection: the use system, the registration system, and the mixed system. This study sheds light on these systems and the extent to which legal protection is granted to them.

2. Trademark registration in the EU.

Trademark registration has had accumulative legal experience for about 90 years[313]. This standard (First come, first served) should have given more importance to potential stakeholders; it is essential to examine trademark registration to understand to what extent such a system would provide equal rights to potential stakeholders. In this regard, the trademark registration mechanism gives a fair margin to every possible stakeholder. In this context, two registration techniques are embraced by those states that adopted the registration of trademarks (most countries around the globe) and those that have adopted the exam method, for instance, those that do not use France.[314] As most states use trademark inspection systems, it continues to the substantive examination, which evaluates the application of absolute and relative rules if a trademark is not opposed.[315]

However, the trademark is registered if an application efficiently passes the substantive examination. [316]Trademark inspection has two types "absolute" and "relative. The absolute inspection includes the trademark to examine registration validity. It is used if the trademark is regarded as typically nonqualified to be registered. However, regardless of whether to accept or reject the trademark registration, this inspection system will play a crucial role in shrinking the efforts, conflicts, and damages if the contested trademark is accepted to be registered without such an examination system.

Furthermore, the stakeholder would have the monopoly right based on descriptiveness, the product shape, deceptiveness possibility, or a geographical area. Additionally, the absolute standard highly relates to diversity, besides public interest purposes. Common law countries like the UK, and the USA, often use this system. The second type is the relative

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[310] *This definition has been articulated by the European Court of Justice in the case (C-337/95) Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV concerning the use of the trademark of a top-notch perfume by a parallel importer in advertising.*

[311] *Jordanian Trademarks Law Article 20/a*

[312] *JTML Article (20/a)*

[313] *Amanda Michaels, Andrew Norris, A Practical Guide to Trade Mark Law, Publisher Sweet & Maxwell, 2002, p v.*

[314] *Tom Blackett Trademarks, publisher Palgrave Macmillan UK, first edition, 1998, p45*

[315] *Stef van Gompel, Formalities in Copyright Law: An Analysis of Their History, Rationales and Possible Future, Volume 23 of Information law series, publisher Kluwer Law International B.V, Netherlands ,2011, p39*

[316] *Carsten Fink, Christian Helmers, Carlos Ponce, Trademarks Squatters: Evidence from Chile, Volume 22 of WIPO Economic Research Working Paper, World Intellectual Property Organization,2014, p20.*

ground, which implies the reasons put down in the trademark substitute to register the mark based on the connection with other earlier trademarks[317]. That entails the trademark registries searching for their database to see if any previous enrollments conflict with the mark that has been requested. In this context, the trademark distinction policies will differ from country to country[319].

Additionally, the global protective range is contrasted from country to country[320]. Accordingly, it is expected that the process based on this system is commonly costly and complicated, and the importance given to each case might differ from country to country. In this context, in Sabel BV v. Puma AG." " the Germany Federal Court of Justice" ruled that:" the marks' visual, aural and conceptual similarities must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components[321].

In this regard, most common law states such as the United Kingdom, and the United States have adopted the comparative assessment method, besides noncommon law states such as Spain Japan, and Scandinavian countries[322].

Denmark changed the registration system from relative to absolute in 1999. Remarkably, Germany has adopted a definitive examination treatment and left it to the trademark holders to oppose applications if they believe they conflict with their existing registration(s).

3. Deposit system

The deposit system is to register a trademark without being subject to any examination on relative or absolute grounds. The principle beyond that is based on the registry's mission to register trademarks. Accordingly, any dispute should be settled in the courthouses. To this point, the legitimate proprietor who first registered the trademark would typically be privileged to avoid using subsequently filed registrations. Some countries have adopted this system, such as Austria, Italy, and France, besides the Benelux, which contains the economic union of Holland, Belgium, and Luxembourg[325]. The EU directive recognized the effective registration of trademarks indicating that "Trademarks fulfill their purpose of distinguishing goods or services and allowing consumers to make informed choices only when they are used on the market."[326]

A requirement of use is also necessary to shrink the total number of trademarks registered and protected in the union. Consequently, registered trademarks must be used in connection with the goods or services in case conflicts arise between them. If they are not used in that connection within five years of the date of the completion of the registration procedure, they will be liable to be canceled.[327]

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[317] *Intellectual Property Office of Singaporerelative grounds for refusal of registration, Singapore, Version 4 (November 2015), p3*

[319] *Industrial Fabric Products Review, Publisher Industrial Fabrics Association International, 1995 Volume 72, Issues 7-12 - Page 296*

[320] *Trademark Manual of Examining Procedure (TMEP, United States. Patent and Trademark Office - 1993 P 1207-4*

321trade marks ACT 1994 in the matter of international registration, no 717233 and the request by inn crystalvertriebs gmbh to protect a trade mark in class 21 and in the matter of opposition thereto by Waterford wedgwood plc under No 70262, https://www.ipo.gov.uk/t-challenge-decision-results/o05902.pdf, p5

322Records of the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty - Singapore, 2006, Volume 329 of WIPO publication Singapore Publisher WIPO, Geneva ,2010 p422

325Frank R. Abate, The Oxford Desk Dictionary of People and Places, Publisher Oxford University Press, 1999 p 483

- Angus Stevenson, Oxford Dictionary of English, Publisher OUP Oxford,3rd edition, 2010, p 154.

- Els Witte, Jan Craeybeckx, Alain Meynen, Political History of Belgium: From 1830 Onwards, p 406

[326] *The EU directive recognized the effective registration of trademarks Article 31.*

[327] *Judgment Of the Court of Justice of The European Union (C-809/18 P)*

(*Figure 1 Examination systems complete examination: "Absolute" and "relative" assessment partial examination: "absolute" assessment only.*[328]

Country	System used
Denmark	Partial Examination
UK	Full Examination
France	No Examination
Germany	Partial Examination
Benelux	No Examination
Spain	Full Examination
Italy	No Examination
Sweden	Full Examination
USA	Full Examination

4. Expiration under the Principle of Exhaustion of Trademark Rights.

This mentioned principle means the forfeiture of the right of the trademark proprietor to prevent others from importing the products covered by a protection as soon as he puts those products into circulation in the market of any country, whether by himself or through one of his affiliates or with his consent.[329]

The right to the trademark is exhausted when it is impossible to use to prevent the continuation of the commercial sale of goods bearing a trademark. As soon as the proprietor of the mark has willingly placed the product that bears it in circulation, exhausting his right towards this mark, the state can no longer rely on his right to the mark to control the product's fate bearing this mark. It believes that applying this principle to its launch means that the proprietor of the mark has the right to prevent others from importing all the products covered by protection, including the products that were put up for sale abroad through the proprietor of the mark, either by himself or with his consent, which leads to impeding the circulation of products through International borders. Therefore, some legislation has broadened the scope of the trademark proprietor's right to prevent the import of protected products by codifying the principle of international exhaustion of intellectual property rights.

The mainstream of French jurisprudence believes that the rights enforcement mechanism reconciles the requirements of intellectual property law with the principle of freedom of movement of goods. This mechanism was stipulated in French Intellectual Property Law[330], according to which the right granted by the mark to its proprietor is not allowed. This mark is prohibited for products offered for sale in the European Economic Community or the European economic area bearing this trademark. The enforcement of the rights will only play its role if the product is traded for the first time in one of the countries of the European Union with the consent of the trademark proprietor, and paragraph (5) of article (713/4) provides an exception for enforcement in the case of legitimate motives, such as infringement of the trademark's reputation.[331] The author believes that the TRIPS Agreement has taken a negative stance on the issue of the exhaustion of intellectual property rights, citing what the Agreement stipulates. To this point, the TRIPS agreement indicates that "taking into account the provisions of Articles (3 and 4), the dispute settlement under this agreement; does not include what can be used to deal with the issue of the expiration of intellectual property rights[332]. the author considers that the provision of this article confirms that the commitment of the member states of the World Trade Organization to implement the principle of exhaustion of intellectual property rights may not be derived from the texts of the Tries Agreement, as the mentioned agreement did not take any favorable position on the issue of

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[328] *Tom Blackett, Trademarks, publisher Springer, 2016,p47*

[329] *Badawi, Bilal Abdel Muttalib, The Evolution of International Mechanisms for the Protection of Industrial Property Rights (a study in the light of the TRIPS Agreement and previous agreements) Dar Al-Nahda Al-Arabiya, Cairo, 2006, p. 82.*

[330] *FIPLArticle (713/4)*

[331] *Al-Sagheer, Hossam El-Din, ibid, p. 81*

[332] *TRIPS agreement Article (6)*

exhaustion of intellectual property rights. Its texts may not be interpreted in such a manner. It creates an obligation for member states to apply the principle of exhaustion or exempts them from its application, and this means that the agreement leaves the legislation of member states completely free to adopt the principle of exhaustion of (IPRS) to apply it according to their national interest[333].

5. Conclusion

The burden of approving identical or confusingly similar trademarks has two parts. First, the complainant must show that they have rights to the trademark. Second, the complainant must show that the trademark is identical, or confusingly similar, to that trademark. The easiest way to prove rights in a mark is through trademark registration. One of the essential features of trademarks is that it is one of the crucial means to the success of the economic project, as it is its means in the field of competition with other projects at the international and local levels alike by use so that the right is acquired through the actual use of it. Obtaining the right does not require a specific act but rather the use of the mark. Despite the emergence of the right to the used trademark, it did not have protection like the registered trademark.

It enjoys more legal protection than the unregistered trademark because it enjoys criminal protection, a shortcoming in Jordanian legislation. Therefore, the author believes the registration policy, which was based on a first-come, first-served basis,[334] did not protect the potential stakeholders, especially trademark holders.

On the other hand, the trademark registration system was structured to prevent potential conflict or expected infringement because time is essential. Besides the adverse effects on the company, trademark, and countries, every second would cost much money and effort. Also, adopting an absolute examination of trademark registration grounds will reduce the frequency of conflicts and could almost prevent them early before they escalate and protract.

Furthermore, the mark's registration establishes the right of proprietorship, as the mere registration of the mark is considered a sufficient reason to develop the right to its proprietorship. Any previous use of it has occurred as the precedence after the registration.

The TRIPS Agreement expressly prohibited member states from imposing use as a precondition for applying for registration. member countries may make registrability dependent on the use[335]. However, the actual use of a mark may not be considered a condition for its registration. Rejection of a registration application is simple because the intended use has yet to occur three years before the application's submission date expires. The Jordanian Trademark Law indicates that "the registration of a person as the proprietor of a trademark is evidence of the original intent of the registration of that mark. It is clear from the text of the two articles mentioned that the Jordanian trademark law has made the registration of the mark indicate that the right to The mark alone determines the effect of registration; that is, the registration of the mark is nothing but a legal presumption of the proprietorship of the mark for the person who registered it. However, that presumption needs to be more conclusive, and proving the opposite to the audience is permissible.

Chapter 5 Trademark Usage System

[333] *ibid , article 6*
[334] *B.C. Nirmal, Rajnish Kumar Singh, Contemporary Issues in International Law: Environment, International Trade, Information Technology and Legal Education, Publisher Springer, 2018,p461.*
[335] *JTML Article (3/15)*

The trademark right arises from the fact of actual use. Acquiring the right does not require a specific act; it entails a legal use to own the trademark. Many legislations and courts have adopted this right. In this context, the author will shed light on the trademark use right to obtain protection against infringement of trademark rights as follows:

Trademark Use in the EU

The exclusive right an EUTM provides is always based on registration. Even less, the establishment cannot obtain protection by starting to use a trademark. According to article (b) of the CTMR, an application for an EUTM shall, at the applicant's choice, either be filed at the Office, EUIPO, or the central industrial property office of a member state.

The member States are not, however, according to the directive compromise Text, deprived of the right to continue to protect trademarks acquired through use. As for the application for registration[341], it is now suggested in Article 25 of the regulation Compromise Text that an application for an EU trademark shall be filed exclusively at the office. This suggestion is supported by noting that there has been a gradual decline in EUTM filings at the Member States' intellectual property offices. With the introduction of electronic filing, it is no surprise that the number of EUTM applications at the local offices today is insignificant. One crucial change proposed relates to the graphical representation.

1.1 Non-traditional trademarks

Non-traditional trademarks such as sensorial signs (smell, sound, touch, movement, single color) have always been problematic in the current trademark law system. In a registration-based system, there is a need to establish an objective register that identifies the subject of property protection and notifies the public and the relevant authorities. On the other hand, when these signs are used, they are often subjectively experienced and may be devoid of objectivity. The graphical representation requirement in the law, in this context, has functioned as a proxy to give the register a sense of objectivity and thus has been used as a criterion for the trademark offices to refuse registration of signs that are devoid of[342]

1.2 Trademark abandonment

Abandonment is one of the cases of trademark proprietorship expiry, where the trademark proprietor keeps his trademark. However, there are several cases in which his right expires ,(343)including abandoning the trademark. Therefore, the author, in this requirement, explores the provisions of abandonment in the following two subsections:

1.3 Abandonment concept

Abandonment is one of the cases of the expiration of the right to a trademark. It can be defined as giving up a trademark to relinquish its proprietorship. That results in the demise of the trademark, and leaving takes two forms: the image of explicit abandonment and the image of implicit abandonment, and the abandonment is explicit as if the assignment is made. The trademark is explicitly declared by its proprietor. Thus, the proprietor does not adhere to their proprietor based on his acknowledgment or the basis of an agreement between him and third parties.

The abandonment is implicit because it is extracted from several aspects suggesting the trademark's abandonment. If a third party used it without the opposition of its proprietor and

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[341] *Nari Lee, Niklas Bruun, Mingde Li, Governance of Intellectual Property Rights in China and Europe, Publisher Edward Elgar Publishing, 2016,p143.*

[342] *Nari Lee, Niklas Bruun, Mingde Li, Governance of Intellectual Property Rights in China and Europe, ibid,p144.*

[343] *Tarawneh. J, Anew classification for trademark functions, Intellectual Property Quarterly, 2016,352-370.*

without defending his right to own the trademark or not using it after registering it within a certain period. Amongst the cases of implicit abandonment is the retirement of its proprietor from practicing the trade or the industry that uses the trademark to distinguish its products. That will be explained in the second section. It is also helpful to note from the text of article (22/1) of the JTML that abandonment is one of the cases of expiration of trademark proprietorship.[345]

Thus, the author notes that for the trademark to be considered abandoned, the proprietor has to leave it to relinquish its proprietorship. If this intention is absent, abandoning the trademark is not considered.

1.3.1 Implicit abandonment of the trademark

In this section, the author will deal with images of cases of implicit abandonment. The implicit abandonment of the trademark is an issue extracted from the circumstances of reality, and it falls within the scope of the judge's discretion. Amongst the cases of implicit abandonment of the trademark are the following ones:

1.3.1.1 Retirement from trade or industry

Retirement from trade or industry by the trademark proprietor shall lead to the demise of competition with other projects. Thus, the function of the trademark is lost due to the absence of the products that distinguish it. However, if the retirement was temporary, it is not considered evidence of abandonment of the trademark because it may return to practicing trade again and use the same trademark. After a long time, it becomes inevitable that the merchant has retired from trade and everything related to it, including the trademark he was using.[346]

1.4 Trademarks use nonopposition

This form indicates that the trademark proprietor does not object to others' trademark use. If a third party uses the same trademark and its proprietor does not object, he is considered to abandon it. However, suppose the non-opposition of the trademark proprietor to use it by others is a form of tolerance with another competitor.

This non-opposition proves the proprietor's intention to abandon the trademark in that case. Its proprietor does not expire.[347] Some believe that the transformation of the trademark into a descriptive trademark is an involuntary inheritance, meaning that the trademark is transformed into a name that indicates the gender of the goods or services.

In this context, IPL in this regard stipulates the forfeiture of the rights of the proprietor whose action led to the common designation of the product or service in the commercial market or the occurrence of a personal error related to the nature, quality, and origin of the product or service[348]. and in this also the ruling of the French judiciary. The invalidity of the (E-Learning) trademark due to its widespread use in the press since March 2000, which loses the condition of distinction.

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[345] *Article 22 of the JTML No. (33) of 1952 states:*
1- Subject to the provisions of Article 25 of this law, any interested person may request the registrar to cancel the registration of any trademark registered by another person if he has not used it effectively and continuously during the three years preceding the application unless the trademark proprietor proves that the non-use of it is due to circumstances private commercial or to justified reasons that prevented its use.
2- The use by third parties of a trademark registered with the consent of its proprietor shall be deemed to be a use thereof to continue its registration under the provisions of paragraph 1.
[346] *Mohsen Shafiq,(1984) Technology Transfer from the Legal Perspective,Cairo University. Dar Al Nahda Al Arabiya 1998, p26..*
[347] *Zaineddin, Salah Salman, Branding in Jordanian Law, Ibid, p. 150.*
[348] *Article (714/6) of the French Intellectual Property Law.*

Examples of the transformation of the trademark into a descriptive trademark include the following example: The "Xerox" trademark became used to denote paper photocopiers. Although these machines consist of different brands, as well as the "Frigidaire" trademark used to distinguish a type of refrigerator, it has become, with time, a name given by the general public to refrigerators in general. The source of the products, so that their everyday use loses the ability to distinguish the products of a particular project(349).

The author believes that the trademark proprietor must carry out publicity campaigns to prevent the trademark from becoming a descriptive mark, constantly inform the public about it, and follow legal procedures against anyone who illegally exploits the trademark. However, abandonment of the trademark is not considered if sovereign decisions prohibit using certain trademarks to boycott a particular country's products.[350] Accordingly, if the abandonment occurred without the trademark proprietor objecting to its use by others, it is permissible. Any person may take it as their trademark; thus, the trademark proprietor loses it and cannot dispose of it.

In France, Registrar: V. Giacobbo-Peyronnel, the case for non-use is filed before the French court no (C-654/15) of First Instance, and non-use is achieved in the absence of severe exploitation within five years continuously and without any legitimate excuse to prove his exploitation of the trademark or failure to exploit it due to sound legal reasons[351].

However, the law excludes non-use if the trademark proprietor uses a trademark close to it rather than his trademark as it is.[352] The French Court of Paris (C-568/21) confirmed the same, suggesting that using a trademark under a form different from the original registration but acceptable is permissible.

The trademark proprietor remains without losing it, provided the use is proven for each product. However, it is not considered as such for similar products.[353] The French Court of Cassation ruled: "The French Court of Appeal held that the combination of articles No. (712/9; 712/25) of the Intellectual Property Code allows the last renewal of the registered trademark during the new filing based on the amendment of the trademark and the expansion of the list of products or services targeted through this registration.".

This expansion clearly shows that the trademark has several conditions to be struck off. Those conditions follow EU directive law. The first condition is that five consecutive years have passed when it is proven that its proprietor has not used the trademark. The second condition is that the application is submitted to the court, not the registry office. The third one is that the court ruling is enforceable [354] .

Moreover, the Supreme Court of Sweden has issued a judgment in the case of Länsförsäkringar, C-654/15. European Union trademark - Lack of authentic utilization Following ruling C-654/15, the Supreme Court concluded that there was no violation of the applicant's rights within art 9, paragraph 1, sub-paragraphs a) or b) of regulation no. 207/2009 on the EUTM According to the above ruling, the Supreme Court determined that the owner of a trademark has the right to prevent the use of a sign that is the same or similar to their trademark within five years of its registration, without needing to prove actual use of the brand. Nevertheless, this fact does not relieve the proprietor from the responsibility of

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[349] *Zaineddin, Salah Salman, Branding in Jordanian Law, Ibid, p. 159.*

[350] *Smith. R. S, (1992), The Unresolved Tension Between Trademark Protection And Free Movement of Goods in The European Community, Duke Journal of Comparative & International Law, 89.*

[351] *Registrar: V. Giacobbo-Peyronnel, French court no (C-654/15)*

[352] *Article (714/5) of the FIPL.*

[353] *Article (53) of the JTML.*

[354] *. Sawyer, Laura Phillips. US antitrust law and policy in historical perspective. Harvard Business School, 2019.*

demonstrating the presence of a probable state of confusion[355]. In this instance, a comprehensive evaluation did not determine the existence of such a hazard[356].

Accordingly, the author believes that every stakeholder may apply to cancel the trademark registration due to the absence of a sincere intention from its proprietor to use it or not to use it on the goods for which it was registered. It is permissible to apply for cancellation in case of non-use during the period mentioned in the law. However, if non-use results from market conditions such as faltering commercial conditions or economic conditions of the trademark proprietor, others may use it. Bearing that these conditions fall under the jurisdiction of the court that has discretion, the non-use of the trademark becomes permissible.

1. Trademark use in Jordan

The trademark use before registration within the fair competition is considered a legitimate act. Based on that, the unregistered trademark proprietor has only the right to use it; he still enjoys civil protection over his trademark rights[357]. Suppose the actual use of the trademark earns the right on a public basis; then, registration entails gaining the right to the trademark because it is the way to enjoy the trademark proprietorship with competent authority by specific legal procedures. Therefore, a registered trademark has more legal protection than an unregistered trademark because it has the privilege of legal protection.

Based on the TRIPS agreement, the registration provides a ground for trademark proprietorship, even though It does not make the actual use of the trademark a condition for acceptance or rejecting the registration except in the case in which the applicant does not use his trademark for more three years from the date of applying[358]. In this context, the TRIPS agreement has allowed the member states to register the marks according to their use of it[359]70. In this regard, Article (6) of the Agreement mentioned above applies the rights granted to the registered trademark proprietor, as he has the absolute right to give others the right to use the same or a similar mark in his business.

Accordingly, when a trademark is registered, the proprietor would have the exclusive right to the property and the right to monopolize its use[360]. There is also a mixed system. In that respect, this system is based on use and registration as a reason for the emergence of rights and proprietorship and to give it legal protection. According to this system, the trademark registration applicant must prove the use of it[361].

In this regard, the Jordanian Supreme Court of Justice has confirmed this theme, indicating that "if the right of the person in whose name the mark was registered conflicts with the right of the user of this mark, the person who used it shall have priority over the person in whose name it was registered, and the user has the right to request an amendment of the registration if there is a similarity between the two marks would lead to deceiving the public[362]."

This system is represented by American law. However, it was not adopted in Jordan because it did not require prior use of the mark registration. It is sufficient for the applicant to

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[355] *https://curia.europa.eu/jcms/upload/docs/application/pdf/2023-07/flash-monitoring_of_preliminary_rulings-3-2017_en.pdf*

[356] *Swedish Supreme Court, Judgment of Länsförsäkringar, C-654/15], n, ruling of 22.11.2017 (SV)*

[357] *Al-Nahi, Salah Al-Din Abdul Latif: Al-Wajeez in Industrial Property, Ibid, p. 25*

358Muhammadin, Jalal: Fulfilling the Legal Protection of Industrial Property, previous reference, p. 115

[359] *Article 5/3 of the TRIPS agreement*

[360] *Stakheyeva, Hanna, Intellectual Property and Competition Law: Understanding the Interplay (In Bharadwaj, ashish et al. eds., multi-dimensional approaches towards new technology 3-19, springer 2018)*

[361] *catherine seville, eu intellectual property law and policy 311 (edward elgar publishing 2016)*

[362] *Al-Sanhoury, Abdel Razzaq: The Mediator in Explaining Civil Law, Part VIII, Arab Heritage Revival House, Beirut - Lebanon, without a published copy, p. 540.*

intend to use the mark in the future after registering the mark; this is stipulated in JTMLto be used within three years from the date of registration because it is only permissible to use the mark up to three years[363].

Therefore, registration does not create a right to the proprietorship of the trademark. In this regard, the question arises: what if the proprietor did not use his trademark? Would he have the right to keep this right, or is there any risk by not using his trademark? To answer this question, the author will illustrate the importance of not using the trademark for a specific time and keeping the trademark abandoned.

3. Unused trademark

The author will examine the cases of expiration of the right of the trademark. In this respect, in the case that the proprietor abandoned the trademark, whether explicitly or implicitly, as can be seen from the circumstances of the case. , the author in this area examines the non-use of the trademark as a case of expiration of the trademark right by its proprietor as the following:

3.1 The legal concept of non-use

Non-use means that the proprietor of the trademark voluntarily stops using his mark. For example, he stops using it according to the products, goods, and services designated for him after a specific time has passed since it was not used.[364] Article (22/1) of the JTML allows any person to request the cancellation of the registration of any trademark in case the trademark proprietor does not have a sincere intention to use it or does not use it. The position of the Jordanian judiciary in its jurisprudence must adhere that any person of interest may request the registrar to cancel the registration of any Trademark[365] .

To this point, article (19/1) of the TRIPS Agreement states the following: "If use is required to maintain a registration, the registration may be canceled only after an uninterrupted period of at least three years of non-use unless the trademark proprietor shows valid reasons based on the existence of obstacles to such use. Circumstances arising independently of the will of the trademark's proprietor which constitutes an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use".

In France, a case for non-use is filed before the French Court of First Instance, and non-use is achieved continuously in the absence of severe exploitation within five years without any legitimate excuse. Proof of trademark exploitation or failure to exploit it due to legal reasons. However, the law excludes non-use if the proprietor uses a similar trademark instead of his original one[366].

The French Court of Paris confirmed this situation. It indicated that the use of a trademark under a form different from the original registration but which is acceptable is considered permissible. The trademark proprietor remains without losing it, provided the use is proven for each product. However, it is not viewed as such for similar products[367]. In this regard, the French Court of Cassation ruled: "The French Court of Appeal held that the combination of Articles (712/9; 712/25) of the French Intellectual Property Code allows the

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[363] *this is stipulated in Article (1/1) of the JTML No. (34) of (1999)*
[364] *Rothman, Jennifer E. "Initial interest confusion: standing at the crossroads of trademark law." Cardozo L. Rev. 27 (2005): 105.p124*
[365] *JTML, Article 25*
[366] *Article (714/5) of the FIPL*
[367] *Robert G. Bone, Schechter's Ideas in Historical Context and Dilution's Rocky Road, 24 Santa Clara High Tech. L.J. 469 (2008). Issue (3),p505*

prior renewal of the registered trademark during the new filing based on the amendment of the trademark and the expansion of the list of products or services targeted by this registration." There are several conditions for the trademark to be struck off. Those conditions are the ones below :

1. Five consecutive years have passed, during which it has been proven that the trademark's proprietor has not used it.
2. The application is submitted to the court, not the registry office.
3. It is also required that the court ruling be enforceable.

The author believes that every stakeholder can file a request to cancel the trademark registration due to the absence of a sincere intention from its proprietor to use it or not on the goods it was registered for. It is permissible to apply for cancellation in the event of non-use within the legally specified period. However, if non-use was the result of market conditions, faltering commercial conditions, or economic conditions of the trademark proprietor, bearing in mind that these conditions fall under the jurisdiction of the court that has discretion, and the non-use of the trademark becomes permissible, and others may use it[368].

3.1.1 The non-use judicial and legal position

The forfeiture of the right in the mark for not being exploited is one of the forms of the expiry of the right in the trademark. To this point, the author will analyze both judicial and legal positions as follows:

3.2.1 trademark Nonuse of judicial position

. The French court issued a judgment of the first instance located in the same place of residence of the proprietor of the mark whose forfeiture is decreed. For example, each stakeholder has the right to claim that they are one of the competitors. Because of this right, this forfeiture lawsuit is not prescriptive.

It may be claimed as an original, backup, or incidental request. This verdict is confirmed by the provisions of FIPL[369], which requires losing the right to the trademark proprietor who does not seriously use his products and services specified in the registration certificate during an uninterrupted period of five years. Any interested party may apply for the relinquishment of the right to the mark before the judiciary. Suppose the request is related to a part of the products or services mentioned in the registration certificate. In that case, the forfeiture does not exceed only the products or services concerned and the severe use of the trademark that begins or takes place later than five years. The two mentioned in the first paragraph of the article previously explained above shall not be hampered if it was conducted within three months before the request for forfeiture and after the proprietor was aware of the possibility of submitting this request. Proving the exploitation of the mark falls on the shoulders of the proprietor in the event of a request for its fall. All methods of proof may prove it, and the forfeiture results from the expiry of the five years and have an absolute and final effect.[370]

The plaintiff does not have to prove its proprietor's non-exploitation of the mark, as it is impossible. However, the defendant must prove his exploitation of the mark to escape the request for forfeiture, whether by establishing the real and severe exploitation or providing a justification for non-exploitation. It must be proven that this exploitation is within five years,

[368] *Article (53) of the JTML*
[369] *The Article (714/5) of the French Intellectual Property Law,*
[370] *Khater Lutfi, Encyclopedia of Intellectual Property Rights Industrial Property -; Egypt (2003).p177.*

a final limitation period. This lapse period begins to be calculated from the day the registration is announced.

Heavy mark use is considered if many product advertisements bear the same mark. Some cases may justify the non-use of the mark. The judiciary accepts it and prevents the mark from falling, such as the existence of a force majeure case that prevents the use of the mark or facilitates obtaining the raw materials necessary for the implementation of the product bearing the name of the mark, such as cases of war, like an earthquake or a flood. For example, there may be a legal impediment to using the mark, such as not issuing a medical license for the drug. If the case for dropping is accepted, the right of the proprietor of the mark over his mark will be forfeited in whole or in part, and the forfeiture ruling will be published in the National Register of Marks.

However, the law did not allow the mark to be written off. The French judiciary also considered that the severe and continuous use of the emblem as a sign for specific products and services in the deposit by a company branch allows for the exclusion of the right to forfeit.

3.2.2 The non-use legal position

Two opinions have emerged concerning the expiration of trademark proprietorship for non-use. The first opinion suggests that the trademark proprietor is permanent and does not depart from its proprietor, no matter how long the period of non-use is. The other circumstances lead to an abandonment of the trademark. As for the second opinion**,** it suggests that the proprietorship of the trademark arises from its proprietor's use, which is the principle. Accordingly, this proprietorship expires if the proprietor stops using it.[371] Some French jurisprudence experts believe that the proprietorship of the trademark may expire upon the abandonment of the trademark due to non-use; that is, the expiration of the proprietorship of the trademark due to non-use presumes that the proprietor abandons the trademark and that failure to use it is a presumption that the will of the trademark proprietor will leave it. It adds to the need to differentiate between unregistered and registered trademarks. Since the unregistered trademark proves the right to use it, this right disappears after use if the intention of leaving accompanies non-use because use is the title deed of the trademark, and it is the source of this right. Furthermore, the proprietorship does not expire due to non-use only[372].

The case mentioned above of cancellation is one of the forms of abandonment that can be learned from the non-use of the trademark for a specific duration of time and following particular conditions, where the French court may order the cancellation of the trademark if it is proven that the trademark has not been used seriously for five consecutive years unless the trademark proprietor presents convincing reasons calling for by not using it during the mentioned period, but this does not lead to considering non-use one of the reasons for the expiration of the right in the mark, nor does it lead to considering the cancellation of the registration as one of the reasons for expiration as well. Instead, the reason behind the expiry of the right to the trademark is the abandonment of the trademark due to non-use.[373]

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[371] *Obayuwana. A ,Unintentional trademark expansion and unfair competition in cyberspace: the domain name phenomenon, European Intellectual Property Review2012, 177-187.*

[372] *Naser, M. A., and Haddadin, S. H, The Unnatural Nature of Intellectual Property: An Example from a Developing Country, E.I.P.R, 35(6), 2013, P341-351.*

[373] *Neil Wilkof, Shamnad Basheer, Overlapping Intellectual Property Rights, Publisher OUP Oxford, 2012 P lxxviii*

- Naser, Mohammad Amin. "Trademarks and freedom of expression." IIC-INTERNATIONAL REVIEW OF INTELLECTUAL PROPERTY AND COMPETITION LAW 40.2 (2009): 188-205.

It is possible to cancel the trademark registration for non-continuous use without convincing reasons. The (WIPO) suggests that the trademark should be used in general immediately upon its registration. Otherwise, it will be subject to cancellation at the request of any other person who can prove that it was not the subject of it. Use, and in most countries, the trademark is only written off in this case if it is proven that at least three years have passed without its use. Prove that circumstances beyond his control prevented him from using the trademark despite his sincere intention to use it, so it is not permissible to write off the trademark.[374]

4. Conclusion

Based on the jurisprudential opinion that adopts the idea that the use of a trademark creates the right to own the trademark and that registration only reveals that right, it was appropriate for the Jordanian legislator to explicitly stipulate that proving proprietorship of the trademark is through the use and thus grants the right to seek compensation, especially since it was specified in Article 34 of the Trademark Law that failure to register a trademark does not grant it any legal protection. The author also believes that the Jordanian legislator should provide a text for the well-known trademark because most trademarks are foreign and that the Jordanian legislator should not require registration to give protection to the famous trademark; in addition that such protection granted by the Jordanian legislator is not sufficient because it is limited only to The right to delete the trademark without the right to claim any compensation.

Chapter 6 earlier non-registered trademarks in the event of oppositions or infringement proceedings under the EU Trademarks Regulation.

An 'earlier right' is defined as a non-registered trademark that has been consistently used in connection with products or services by an individual or another party in ownership, starting from the date before either the use of the first-mentioned trademark or a specific point in time[375]. In this regard, the author will take into consideration some important issues including legal regulations such as Directive 2008/95 and The Benelux Convention, besides that, the business activities and the national law governing the use of the earlier mark, and the 'passing-off' rule takes into account Enforcement authority and applicable law with some Case studies, for instance, the Classic Coach Company case as follow

1. legal regulations

In this regard, the author will discuss the importance of some regulations including Recital 5 of Directive 2008/95, Directive 2008/95, and the Benelux Convention as follows

1.1. Recital 5 of Directive 2008/95

The Member States should retain the right to protect trademarks acquired through usage, but this Directive should only consider them in connection to trademarks obtained through registration.

The directive applies to all registered trademarks or applications for registration in a Member State as an individual trademark, collective mark, guarantee mark, or certification

[374] *DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks*

[375] *Lazaros G. Grigoriadis, Trade Marks and Free Trade: A Global Analysis, Publisher Springer, 2014,p408*

mark[376]. It also applies to trademarks registered or applied for registration in the Benelux Office for Intellectual Property or through an international registration that has an effect in a Member State.

In terms of 'Further grounds for refusal or invalidity concerning conflicts with earlier rights,' 'Any Member State has the option to add that a trademark cannot be registered or, if registered, can be declared invalid if: (b) rights to a non-registered trademark or another sign used in trade were obtained before the date of application for registration of the subsequent trademark, or the date of the priority claimed for the application for registration of the subsequent trademark, and that non-registered trademark or sign allows its proprietor to prohibit the use of a subsequent trademark; (c) the use of the trademark can be prohibited under a previous right other than the rights mentioned in paragraph 2 and point (b) of this paragraph, especially.'[377]

(i) a right to a name;
(ii) a right of personal portrayal;
(iii) a copyright;
(iv) an industrial property right;

. Section 5 of that directive, titled 'Rights granted by a trademark,' states: The registered trademark grants exclusive rights to the proprietor. The proprietor has the right to prohibit the unauthorized use of any sign that is the same or similar to the trademark if it relates to similar services or products. This includes signs that could create confusion or an association between the sign and the trademark.

2. Any Member State may also grant the proprietor the right to prohibit any unauthorized use of a sign

in a trade identical or similar to the registered trademark, even if it is used for goods or services different from those covered by the trademark. This is applicable when the trademark has a reputation in the Member State, and the use of the sign without proper justification exploits or harms the distinctive character or reputation of the trademark.

3. The following activities may be prohibited under paragraphs 1 and 2, among other things:

(a) Attaching the sign to the goods or their packaging; (b) Presenting the goods, or making them available for sale or stocking them for these purposes under that sign, or offering or providing services under it; (c) Importing or exporting the goods under the sign; (d) Utilize the sign on business documents and promotional materials.

Paragraphs 1 to 4 will not impact any provisions in a Member State that pertain to safeguarding against the misuse of a symbol for purposes other than distinguishing goods or services. Such misuse, without valid justification, would exploit or harm the trademark's unique nature or reputation.

The Directive 2008/95, discusses the "Limitation of the effects of a trademark." Accordingly, the trademark proprietor cannot prevent a third party from using their name or address in business activities. Additionally, the trademark proprietor cannot prevent a third party from using an earlier right that is only applicable in a specific locality, as long as the laws of the Member State recognize that right and it is limited to the territory where it is recognized[378].

Article 9 of that directive discusses the 'Limitation in consequence of acquiescence.' According to this article, if the proprietor of an earlier trademark in a Member State has given consent for the use of a later trademark for five consecutive

[376] *Article 1 Recital 5 of Directive 2008/95,*

[377] *Article 4 Recital 5 of Directive 2008/95*

[378] *Directive 2008/95, Article 6.*

years, knowing about such use, they will no longer have the right to challenge the validity of the later trademark or oppose its use for the products or services that it has been used for, unless the registration of the later trademark was done in bad faith.

2. Any Member State has the option to extend the application of paragraph 1 to include the proprietor of another pre-existing right mentioned in Article 4(4)(b) or (c), with the necessary modifications.

3. In situations described in paragraphs 1 and 2, the proprietor of a trademark registered later cannot challenge the use of an earlier trademark, even if the earlier right is no longer enforceable against the later trademark.

1.2. Directive 2008/95

Directive 2008/95 was repealed and replaced, with effect from January 15, 2019, by Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015, to approximate the laws of the Member States relating to trade[379]. The content of Article 6(2) of Directive 2008/95 now appears, in essence, with only drafting changes in Article 14(3) of Directive 2015/2436. However, because of the date of the events in the main proceedings, this request for a preliminary ruling must be examined in light of Directive 2008/95.

1.3 The Benelux Convention

The Benelux Convention on Intellectual Property (Trade Marks and Designs), signed on February 25, 2005, at The Hague by the Kingdom of Belgium, the Grand Duchy of Luxembourg, and the Kingdom of the Netherlands, became effective on September 1, 2006. Article 2.20, titled 'Extent of protection,' states in paragraph 1 that the registered trademark grants exclusive rights to the proprietor.

In terms of civil liability, the proprietor of a trademark has the exclusive right to prevent any third party from using a sign in a trade that is identical or similar to the trademark and could cause confusion among the public. This includes the possibility of the sign being associated with the trademark. Additionally, using a sign in a way that does not distinguish goods or services and without a valid reason that takes unfair advantage of or harms the distinctive character or reputation of the trademark is also prohibited.

In terms of the restriction of the exclusive right, the Benelux Convention addresses the limitations of trademark protection. It states that having exclusive rights to a trademark does not give one the authority to prevent the use of a similar sign in the trade as long as that sign is protected by an earlier right that is specific to a particular locality and recognized by the legal provisions of any Benelux country, within the applicable territory[380].

As per the EU Trademarks Regulations, unregistered prior trademarks are safeguarded during oppositions or infringement cases. Registering a trademark provides essential protection against unauthorized use by others, ensuring its safeguarding on a national, European Union, or global scale.

By EU law, a registered trademark proprietor has the right to oppose an EU trademark application and seek the invalidation of a similar trademark if it is deemed earlier. Several trademarks are utilized without undergoing the registration process. What kind of protection does the EU offer for unregistered trademarks in cases where a similar brand is registered or being sought after? According to Article 8(4) of Council Regulation (EC) No 207/2009,

[379] *marks (ON 2015 L 336, p. 1)*

[380] *Benelux Convention, , Article 2.23*

specific criteria must be met for a trademark application to be denied if it clashes with a pre-existing unregistered trademark.

EU jurisprudence has established four conditions that must be satisfied for an unregistered trademark to potentially contest the registration of an EU trademark, either during the application process or through invalidation after the trademark has already been registered.

2. Business activities

The mark must be used in business activities. It must have significance beyond only a local level. The proprietorship of the mark must have been established by the laws of the member state where the mark was utilized before applying for registration of the EU trademark or its priority date.

The mark must grant its proprietor the ability to prevent using a later trademark.[381.] Determining the existence of such conditions is complex. The European General Court restated that EU law interprets the first two conditions in the Greylag Investment Ltd case, which are evident. The remaining two conditions must be evaluated based on the applicable law for the mark in question. Only the individual national law can determine if the trademark claiming earlier use predates the EU trademark being challenged. Various results can be anticipated in different circumstances due to varying legislation, leading to uncertainty for proprietors of unregistered trademarks. Nevertheless, ambiguity is necessary when a trademark remains unregistered and needs complete protection.

2. The national law governing the use of the earlier mark

The European General Court has declared that the decision is with the opponent. The applicant must demonstrate that the mark in question is covered by national law and permits the prohibition of using a subsequent trademark.[382] The opponent must prove to the court that, according to its national law, the unregistered trademark provides sufficient protection as a 'trademark' and that the opposition trademark may be rejected based on a previously unregistered trademark. The opponent is responsible for establishing that the law supports their opposition. The European General Court requires specific details that define the content of the law.[383] In the ANIMAL case of 2016[384].

The European General Court ruled that the applicant failed to submit proof regarding the national statute on which the invalidity application was founded concerning a non-registered prior mark. The applicant stated that they had used the word mark ANIMAL for several years in various European Union member states and presented documentation of this usage throughout time. The applicant did not specify the legal provisions on which the invalidity claim was based. This is a crucial distinction in demonstrating opposition or invalidity applications depending on whether the earlier mark is registered.

According to Paragraph 8(4), the decision on whether a later trademark can be rejected or banned due to an unregistered earlier mark should be determined by the national law

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[381] *BR IP Holder LLC v OHIM with the other party being Greyleg Investment Ltd, Case T-62/14, decided by the General Court (Ninth Chamber) on 21st January 2016, Paragraph 19*
[382] *Benelux Convention, , Article 2.2323.*
[383] *Universal Protein Supplements Corp. v EUIPO, with the intervener being H Young Holdings plc, Joined Cases T-727-14 & 728/14, decided by the General Court (Fourth Chamber) on 29 June 2016, Paragraph 27*
[384] *Ibid.*

governing the use of the earlier mark. According to the EU Trade Marks Regulation, the applicant must present this evidence thoroughly during an opposition or infringement action. In the example above, the plea was denied due to insufficient evidence rather than lack of merit.

National laws in different member states are not entirely standardized regarding trademarks, registration, use, and protection procedures. Maltese legislation does not include an opposition process for trademark applications once published, unlike the mechanism for EU-registered trademarks under EU laws. Once a trademark is registered, the proprietor of an earlier registered trademark can seek recourse through infringement procedures. [385]In Malta, a Maltese-registered trademark is not considered infringed by using an earlier right during trade.[386]

3.1 An 'earlier right' is a non-registered trademark.

An 'earlier right' is a non-registered trademark that has been consistently used in connection with goods or services by an individual or their predecessor before using or registering another trademark for the same or comparable products or services. This earlier right is considered valid if its use is legally protected in any way. Under Maltese law, trademark registration can be considered unlawful if there is an earlier right unless the proprietor has agreed to the registration.[387] The trademark may not be registered initially due to the reasons mentioned above.[388]

An opponent can likely use these provisions as a foundation for legal action under EU law if the non-registered mark is used by its proprietor in Malta, as long as the use is not only of local importance. To succeed, the requirements of EU law must be demonstrated alongside Maltese law. The EU judicial bodies are responsible for interpreting the legislation based on the proof presented by the petitioner and applying it to the specific situation.

3.2 'passing-off' rule

UK law includes provisions for protecting unregistered marks using the 'passing-off' rule, which numerous applicants have utilized over the years. The EU legal system has acknowledged goodwill, deception, and harm or the possibility of damage as the foundation of this UK domestic legislation.

Hence, these factors need to be adequately demonstrated to establish that the registered (or applied for) trademark should not be permitted due to its infringement on the proprietorship rights of a prior non-registered trademark. The applicant must demonstrate these factors before the relevant EU Court for a claim under Article 8(4) to be recognized.[389] Some EU member states may protect unregistered trademarks within their territory, although the approach is only consistent across some countries. The components and standards for this protection vary and must be reviewed by an EU judicial entity after being substantiated by the applicant in an instance under Article 8(4) of the EU Trade Marks Regulation. Non-

[385] *Trademarks Act (Chapter 416 of the Laws of Malta), Articles 14 – 20*
[386] *Ibid. Article 11 (3)*
[387] *Ibid. Article 43 (2)*
[388] *Ibid. Article 6 (4)*
[389] *The General Court dismissed an appeal claim in Tresplain Investments Ltd v OHIM with intervenor Hoo Hing Holdings Ltd, Case T-303/08, which the Commission of Appeal's ruling had previously determined. The Board had evaluated the facts of the case in light of British law and all three elements. The decision was handed down on December 9, 2010, by the General Court of the United Kingdom.*

registered trademarks do not receive the same level of protection as registered trademarks, whether at a national or EU level. It is reasonable that registered trademarks receive more protection under national and EU law due to their being registered. However, many European trademarks still need to be registered.

Various government agencies have launched campaigns promoting the benefits of registering trademarks. The Maltese commerce authority has initiated efforts to promote and raise awareness among businesses about safeguarding their assets and registering trademarks already being utilized. Various factors such as apathy, disinterest, ignorance, or the misconception that registration is unnecessary may contribute to this number. The different national procedures and limited protection for unregistered marks may show that firms' unregistered marks are adequately safeguarded and do not need extra rights. This belief is not entirely accepted in reality.[390].

3.3 Enforcement authority and applicable law.

The interpretation of "Brussels I" can be used because the facts are the same, and the right being protected is the same as the EU trademark[391]. The exclusive distribution deal between the defendants was enough to show that the facts are the same and that the rule can be used. This event might make the claimant's infringement claims more likely to be linked, allowing people from different countries to be sued in the courts where one of them lives if they are all charged with infringement for a similar offense and have a deal to only sell the goods to each other. To this point, the CJUE made a preliminary decision in the case of Advance Magazine Publishers Inc. v. Beverage City & Lifestyle GmbH, MJ, [392]

3.4 Extent of Protection

It is important to note that an injunction can only be used to protect an EU brand known throughout the EU. Usually, the court first grants a preliminary injunction that applies to the whole EU since the trademark is well-known in many of the EU. In addition, the court used Article 126(1) of the EU Trademark Regulation to allow a temporary blocking order to be made across the whole EU.

The interesting question arises as to whether a trademark with a reputation has a limited geographical scope. In this regard, the[393] Court Orders the Hanseatic Higher Regional Court in" Hamburg, HUGO BOSS".[394] This ruling pertains to the possibility of issuing injunctions across the European Union to safeguard a trademark, including its reputation, in cases when the infringement happened in only a portion of the EU.

The German Court has determined that an injunction can only be issued to protect an EU trademark with a recognized reputation across the European Union. Hugo Boss, the high-end fashion brand (the applicant), possesses the EUTM 'BOSS' for garments in Class. The accused party, a retail establishment specializing in discounted apparel, presented merchandise including the expressions 'THE REAL BOSS' and 'I AM THE BOSS.' Hugo Boss requested a court order to prevent infringement, alleging a violation of the EU Trade Mark Regulation (EUTMR)[395].

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[390] *Jean-Pie Gauci-Maistre, the protection afforded to non-registered earlier trademarks in the event of oppositions or infringement proceedings under the EU Trademarks Regulation. https://gmxlaw.com/publication/the-protection-afforded-to-non-registered-earlier-trade-marks-in-the-event-of-oppositions-or-infringement-proceedings-under-the-eu-trade-marks-regulation/*

[391] *"Brussels I" Article 8(1) of Regulation (EU) No. 1215/2012. Article 8(1) of Regulation No 1215/2012*

[392] *Advance Magazine Publishers Inc. v. Beverage City & Lifestyle GmbH, MJ, Beverage City Polska Sp. z o.o., and FE on September 7, 2023*

[393] *recent case-law on infringement and enforcement of intellectual property rights, p11-12, euwipo.*

[394] *HUGO BOSS" Trade Mark Management GmbH & Co. KG, February 22, 2023.*

[395] *Article 9(2)(c) (EUTMR)*

The Hamburg District Court initially issued an EU-wide preliminary injunction, ruling that using the word 'BOSS' on the defendant's products meant drawing the consumers' attention to that word, damaging the previous trademark's promotional and outreach purposes. The defendant lodged a lawsuit against the ruling with the District Court of Hamburg (Higher Courts).

The Court upheld the claimant's position that Hugo Boss had a recognized reputation in Germany, which was deemed to extend to a significant portion of the European Union under Article 9(2)(c) of the EUTMR. The study also concluded that the signs were significantly alike, allowing consumers to infer a connection between them.

The Court acknowledged that the appellant's use of those signs unfairly exploited Hugo Boss' image when selling its products. After determining responsibility in this matter, the Court authorized the issuance of a temporary restraining order across the European Union under Article 126(1) of the European Union Trade Mark Regulation. The Court dismissed the appellants' disagreement and ruled that an injunction based on an EU trademark with a recognized reputation can only be awarded across the European Union.

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In the 'fight software' case, the CJEU ruled that if confusion is probable, a restraining order must be issued to the European Union unless the plaintiff can prove no confusion in certain parts of the EU. This case prompts intriguing inquiries concerning the geographic scope of an injunction, mainly whether an injunction for an EU trademark with a reputation must invariably be awarded over the entirety of the EU.

3.5 The coexistence of unregistered local earlier rights with later registered national trademarks

Upon initial decision, demand pertains to the analysis of Article 6(2) of Directive 2008/95/EC of the European Parliament and the Council dated October 22, 2008, which aims to harmonize trademark legislation across the member nations. The request has been made in a legal case involving X BV, a company that provides coach passenger transport services, and Classic Coach Company vof, another company that provides coach passenger transport services.

3.5.1 Classic Coach Company,

The case involves two individuals, Y and Z. The issue is a possible infraction of X's Benelux trademark by Classic Coach, Y, and Z. In this case, the main dispute involves two brothers participating in a general partnership called 'Reis- enTouringcarbedrijf Amersfoort's Bloei.' The partnership was based in Amsterdam, The Netherlands, and operated an individual transportation by coach. From 1968 to 1977, both brothers participated in this partnership. Before 1971, their father also provided occasional coach transport services, as he had been involved in this industry since 1935. In 1975, one of the brothers (referred to as 'Brother 1') established X, which began using two other commercial names in 1975 or 1978. One of these names somewhat matched the brothers' surname.

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In 1977, after “Brother 1” left the company that was founded in 1968, “Brother 2” carried on the company's operations with his wife as a co-proprietor in the form of a limited liability company. They kept the same company name as the one created in 1968. In 1991, “Brother 2” partnered with his wife for tax optimization. “Brother 2” and his wife owned two separate firms that existed simultaneously. Each company had signs on their vehicles that bore Brother 2's name. In 1995, following the demise of sibling 2, his two sons, Y and Z, took over his endeavors and established Classic Coach in the Netherlands to carry on his work. For several years, the Classic Coach coaches have had a sign on the rear of the coach that includes Brother 2's name, specifically the first letter of his first name followed by his last name. Additionally, X owns a Benelux wordmark that was officially registered on January 15, 2008. This mark covers various services in Class 39 of “the Nice agreement”, which pertains to the International Classification of Goods and Services for the Registration of Marks. These services include those offered by a coach company. The symbol represents the shared last name of brothers 1 and 2.

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Under those conditions, X initiated legal actions before (the District Court, The Hague, Netherlands[396]), requesting, among other things, a court order to permanently stop the defendants in the main case from violating its Benelux wordmark and trade names. X took legal action based on the defendants' usage of the sign associated with Brother 2's name, which violated X's trademark rights under Article 2.20(1)(b) and (d) of the Benelux

[396] *the Rech bank Den Haag*

Convention, as well as its trade name rights under Article 5 of the Handelsnaamwet (Law on trade names).

In the primary processes, the respondents disputed the claimed violation, primarily citing the Benelux Convention[397]. This provision essentially incorporates Article 6(2) of the First Council Directive 89/104/EEC of December 21, 1988, which aims to harmonize trademark laws among Member States[398]. This directive aligns with Article 6(2) of Directive 2008/95. In addition, the defendants in the main proceedings raised opposition s to the alleged trademark violation by claiming estoppel, among other arguments. On May 10, 2017, the Rechtbank Den Haag (District Court, The Hague) ruled in favor of X's action. However, on February 12, 2019, (the Court of Appeal, The Hague, Netherlands)[399] overturned the previous verdict and rejected X's appeal. 28 X appealed on a legal basis against the ruling above to the Hoge Raad der Nederlanden (Supreme Court of the Netherlands). The Supreme Court expresses uncertainty regarding the definition of an 'earlier right[400] referred to in Article 6(2) of Directive 2008/95.

According to the Court, it is possible that if an earlier right is assumed, it must have the ability to legally prevent the trademark holder from using the mark under the relevant national laws. The legislative history of that clause indicates that the wording in the initial proposal, which aimed to broaden its application to include previous rights of local importance that are no longer valid against a later registered mark, was eventually not accepted. FFurthermore, it is possible to consider that to establish the existence of a prior right held by a third party, and it is crucial to determine whether the trademark proprietor possesses an even earlier right, as acknowledged by the legislation of the relevant Member State, with regard to the sign that has been registered as a trademark.

Furthermore, it is possible to consider that to establish the existence of a prior right held by a third party, and it is crucial to determine whether the trademark proprietor possesses an even earlier right, as acknowledged by the legislation of the relevant Member State, with regard to the sign that has been registered as a trademark.

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If such an earlier right does exist, it is necessary to ascertain whether the alleged prior right of the third party can be legally prevented based on that earlier right. The Gerechtshof Den Haag (Court of Appeal, The Hague) determined that X, the proprietor of the Benelux trademark, had prior trade name rights to the defendants in the main matter regarding the sign registered as a trademark.

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Nevertheless, the Court determined that X's power to ban the defendants from using the trade name corresponding to Brother 2's name in the main proceedings was lost because of the constraints resulting from X's acceptance or agreement. Therefore, X cannot prevent the defendants in the main proceedings from using that trade name due to its preexisting trade name rights. The evaluation of the strengths of the legal challenge made against the

[397] *Article 2.23(2) of the Benelux Convention*
[398] *(OJ 1989 L 40, p. 1).*
[399] *the Gerechtshof Den Haag*
[400] *Article 6(2) of Directive 2008/95*

assessment of the Gerechtshof Den Haag (Court of Appeal, the Hague) would rely on the extent of the definition of 'prior right' in Article 6(2) of Directive 2008/95.

s preexisting trade name rights. The evaluation of the strengths of the legal challenge made against the assessment of the Gerechtshof Den Haag (Court of Appeal, the Hague) would rely on the extent of the definition of 'prior right' in Article 6(2) of Directive 2008/95.

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(The Supreme Court of the Netherlands)[401] asserts that we should consider all the trade names in question in the main proceedings as legally recognized rights in the Netherlands under Article 6(2). 33 In this situation, (the Supreme Court of the Netherlands)[402] opted to pause the legal proceedings and seek clarification from the Court of Justice by asking the following questions:

(1) Does an "earlier right" of a third party, as mentioned in Article 6(2) of Directive 2008/95, exist if the third party has used an established right according to the laws of the relevant Member State before the trademark was filed? Or (b) is it necessary for the third party, because of that earlier right, to have the legal authority under national legislation to prohibit the trademark used by the trademark holder?

k used by the trademark holder?

(2) When addressing Question 1, it is important to consider whether the trademark holder possesses a prior right (acknowledged by the laws of the specific Member State) related to the sign that has been registered as a trademark. Furthermore, it is relevant to determine whether the trademark holder can prohibit the third party from using the claimed "earlier right" based on that previously acknowledged right.'Examination of the questions presented.' The referring Court's first question seeks clarification on whether Article 6(2) of Directive 2008/95 necessitates that the proprietor of an 'earlier right' must be able to prohibit the use of a later trademark by its proprietor to establish the existence of such a right.

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The order for reference indicates that the primary proceedings include a disagreement regarding conflicting trade names that are either the same or comparable.

These trade names are all recognized by national legislation, and one of them has been enrolled as a trademark by its proprietor. According to the data provided in the decision, the registered trademark proprietor can no longer legally object to a third party's use of an identical or similar trade name due to limitations resulting from surrender. This is by the relevant national law.

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It is important to note that the concept of an 'earlier right,' as defined in Directive 2008/95, should be interpreted in line with similar concepts in international law[403]. This interpretation should be based on the context and intent of the appropriate sections on intellectual property in international treaties. This approach is supported by the judgment in several cases and the relevant case law[404].

Based on the Court's case law, it is clear that a trade name is considered a kind of intellectual property under Article 1(2) of the TRIPs Agreement. Furthermore, Article 2(1)

[401] *The Hoge Raad der Nederlanden*
[402] *the Hoge Raad der Nederlanden*
[403] *Article 6(2) of Directive 2008/95*
[404] *cases of Stim and SAMI (C 753/18, EU: C:2020:268, paragraph 29) April 2, 2020.*

of the TRIPs Agreement explicitly includes safeguarding trade names, as outlined in Article 8 of the Paris Convention. According to the TRIPs Agreement, members of the WTO have to safeguard trade names[405]. According to the TRIPs Agreement, the right being referred to must already exist and be protected when used to counter the claims of the trademark proprietor with whom it is in conflict[406]. [407]Furthermore, although Article 8 of the Paris Convention ensures the protection of trade names without the need for registration, both Article 16(1) of the TRIPs Agreement and Article 8 of the Paris Convention do not prohibit, in principle, national laws from imposing requirements on the use or awareness of a trade name[408]. In this context, priority refers to the requirement that the right in question must have been established before granting the trademark claimed to be in conflict. This requirement reflects the principle of prioritizing the previous exclusive right, which is a fundamental principle of trademark law and, more broadly, of all industrial property law[409].

Moreover, according to Directive 2008/95[410], the term 'earlier right' encompasses, among other things, an industrial property right, which is just one form of intellectual property. Article 1(2) of the Paris Convention establishes that a trade name is an industrial property right. Despite the main objectives of Directive 2008/95[411] being distinct from those mentioned in Article 6(2) of the same directive, which is to allow the proprietor of a prior right to oppose the registration of a trademark or request the invalidation of a registered trademark, it is important to note that the term 'earlier right' used in both provisions must have the same meaning. This is because the European Union legislature has not intended to give it a different interpretation, as stated in the Football Association Premier League and Others case[412].

Therefore, a trade name can establish a prior right to invoke Article 6(2) of Directive 2008/95. Regarding the conditions for applying the Directive[413], it is important to keep in mind that a provision of EU law that does not explicitly refer to the laws of Member States in determining its meaning as well as scope should generally be interpreted independently and consistently throughout the European Union. This interpretation should consider the legislation's wording, context, and objectives.

This principle has been established in previous court judgments and the relevant case law. [414]it is important to note that this provision does not require a third party to be able to forbid the utilization of an afterward identity to assert its right against its proprietor. The requirements for asserting this right include the employment of the trademark in the course of commerce, the importance of the right, applicability in a specific locality, and recognition by the laws of the Member State in question.

The context of that provision and the general framework of Directive 2008/95 support that interpretation. According to Article 4(4)(b) and (c) of the instructions, the member state has the option to prohibit the registration of a trademark or declare it invalid if the rights to a sign used in trade were obtained before the application for registration of the subsequent trademark or the claimed priority date for the application.

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[405] *as stated in the ruling of November 16, 2004, Anheuser-Busch, C 245/02, EU: C:2004:717, paragraph 91*
[406] *Article 16(1) of the TRIPs Agreement*
[407] *This requirement is clarified in the November 16, 2004 judgment, Anheuser-Busch, C 245/02, EU: C:2004:717, paragraph 94.*
[408] *This was confirmed in the November 16, 2004 judgment, Anheuser-Busch, C 245/02, EU: C:2004:717, paragraphs 96 and 97*
[409] *(see, in this regard, the ruling of November 16, 2004, Anheuser-Busch, C 245/02, EU: C:2004:717, paragraph 98)*
[410] *Article 4(4)(c) of Directive 2008/95,*
[411] *Article 4(4)(c) of Directive 2008/95*
[412] *Football Association Premier League and Others, C 403/08 and C 429/08, EU: C:2011:631, paragraph 188.*
[413] *Article 6(2) of Directive 2008/95.*
[414] *Regarding the wording of Article 6(2) of Directive 2008/95,*

The sign grants its proprietor the authority to forbid the use of a later trademark and, additionally, allows for the restriction of trademark usage if it conflicts with an earlier right, such as an industrial property right. Contrary to the reasons for rejecting or invalidating a trademark due to conflicts with existing rights, as specified in Article 4(4)(b) and (c) of Directive 2008/95, which aim to either halt the registration of or revoke an existing mark, Article 6(2) of the same directive only allows for a restriction of the rights granted by a registered trademark, as outlined in Article 5 of the directive. Moreover, the 'earlier rights' concept defined in Article 6(2) of Directive 2008/95 is limited to a specific locality.

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This implies that, from a geographical point of view, these rights cannot extend to a region as extensive as that protected by a registered trademark, as trademarks typically cover the entire territory for which they are registered. This approach, which allows for more flexible conditions in limiting the rights of a trademark that has been registered compared to the requirements for preventing registration or declaring it invalid, aligns with the objectives of Directive 2008/95.

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The directive balances the trademark proprietor's desire to protect its primary purpose and the interests of other economic operators who need signs to represent the products or services they provide. The legislative record can not challenge the literal meaning of the provision in question.

However, the history of legislation of an EU act may offer relevant information for its interpretation[415]. It is important to mention that when Directive 89/104 was adopted, which was later codified by Directive 2008/95, the exact wording of the current Article 6(2) of that directive, as suggested by the Italian delegation to the Council of the European Union, was not fully accepted. The suggestion to the delegation suggests that the restriction on the mark's impact would still apply, even if the earlier right cannot be used toward the subsequently enrolled trademark. However, it should not be assumed from this that the EU legislature intended to narrow the scope of Article 6(2) of Directive 2008/95 to only earlier rights that allow the proprietor to forbid the use of the following mark.

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This condition would render that provision ineffective as it would equate the requirements for its application with the requirements for the application of the additional grounds for refusal or invalidity specified in Article 4(4)(b) and (c) of that directive.

[415] *the ruling of January 13, 2022, Germany and Others v Commission, C 177/19 P to C 179/19 P, EU: C:2022:10, paragraph 82)*

According to Article 6(2) of Directive 2008/95, to be legally binding against the proprietor of a later trademark, it is generally enough for the earlier right, which is limited to a specific area like a business name, to be acknowledged by the laws of the relevant Member State and utilized in commercial activities. According to Directive 2008/95, national legislation requiring an earlier right to give its proprietor the power to ban the local utilization of a trademark registered later would exceed the criteria set out in Article 6. This is because Article 6, along with Articles 5 and 7, fully harmonizes the rules regarding the rights granted by a trademark and defines the rights of trademark proprietors in the European Union[416]. It is important to consider that a prolonged and honest simultaneous use of two similar signs to represent identical items does not and is not likely to undermine the fundamental purpose of the trademark, which is to ensure that consumers can identify the source of the goods or services.

The regulations regarding unfair competition may examine any dishonesty related to those signs in the future. [417]Based on the previous consideration, the response to the initial query is that the Directive [418]has to be determined as stating that it is not necessary for the proprietor of an 'earlier right' to have the ability to prevent the use of a later mark by its proprietor to prove the existence of such a right.

3.6 Selective Distribution Systems within the Framework of Exceptions to the Principle of Trademark Exhaustion.

The commonly held belief that the disturbance to a" selective distribution system" inherently tarnishes the reputation of the proprietor of the trademark who established the system ignores the reality that trademark owners who have established "selective distribution systems" frequently sell their products to independent traders.[419]

The occurrence of such transactions typically violates the contractual responsibility owed by those owners towards specific merchants to not offer commodities to independent merchants. However, this does not impact the implementation of the fundamental concept of the free movement of goods, which forms the basis for the freedom of parallel trade. Indeed, depending on the specific circumstances of each situation, the inclusion of a trademark carried by perpendicular imported merchandise in the marketing materials of a standalone seller or in the context of how the goods are sold may potentially cause harm or pose a risk of harm to the reputation of that trademark. It could also be seen as an unfair exploitation of that reputation. [420]

However, it is important to note that such an outcome is a separate matter to consider. Hence, the interference with a specific distribution system by an autonomous merchant does not qualify as a "valid justification"[421]

3.6.1 The case of Coty v. ALDI SÜD

This case pertains to selective distribution systems within the framework of exceptions to the principle of trademark exhaustion[422].

The German Court thoroughly analyzed the criteria for product presentation that resellers must meet to maintain the brand's reputation and take advantage of fatigue. The Court

[416] *This interpretation is supported by the judgment of September 22, 2011, in the case of Budějovický Budvar (C 482/09, EU: C:2011:605, paragraph 32.*
[417] *This can be seen in the September 22, 2011 judgment, Budějovický Budvar, C 482/09, EU: C:2011:605, paragraphs 82 and 83.*
[418] *second paragraph of Article 6 of Directive 2008/95*
[419] *Lazaros G. Grigoriadis, Trade Marks and Free Trade: A Global Analysis, Publisher Springer, 2014,p408*
[420] *Ibid,p408*
[421] *Article 7 (2) of Directive 2008/95/EC and Article 13 (2) of Regulation (EC) 207/2009.*
[422] *Coty v. ALDI SÜD, No 20 U 278/20, was heard by the Court of Düsseldorf.*

considered the trademark proprietor's conflicting interests in safeguarding the mark's reputation and the reseller's motivation for offering the items in question. It concluded that the reseller cannot promote the goods in a manner that diminishes the trademark's value by harming its appeal, esteemed image, or sense of luxury. The claimant, Coty, held the licenses for the 'JOOP!' and 'Calvin Klein' trademarks specifically for perfumes.

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This corporation employed a discerning distribution strategy to promote and sell perfumes. However, ALDI SÜD (the 'defendant'), a company not part of the selective distribution system, sold these perfumes in its stores. The perfumes were displayed in drawers, glass cabinets, multimedia items, and discount bins. Furthermore, ALDI SÜD promoted the perfumes in their weekly promotional brochure for Valentine's Day. Considering the information mentioned, Coty initiated legal proceedings before the District Court of Düsseldorf, Germany. They alleged that the promotion and advertising of the JOOP! Calvin Klein fragrances hurt the reputation of the legally owned trademarks. The Court determined that the perfumes were not considered high-end goods. Hence, their reputation would not have been negatively affected by the advertising and promotional activities conducted by ALDI SÜD. The claimant appealed to the Higher Regional Court of Düsseldorf, which rendered a verdict in favor of the claimant, concluding that the way the fragrances were displayed in ALDI SÜD stores constituted a violation of the plaintiff's trademarks. The trade's reputation may be negatively affected by such behavior, which could provide a valid basis for opposing the continued sale and marketing of the fragrances, thereby violating the principle of exhaustion[423].

Conversely, including the perfumes in the every-week promotional brochure did not violate trademarks. The fragrances were designated, particularly the merchandise showcased in the booklet. In addition, the brochure promoted.

4. Conclusion

A European Union (EU) law called Directive 2008/95 covers trademarks that are used but not registered trademarks. The order covers all trademarks that are registered or that are being registered in a Member State. This includes individual, collective, guarantee, and certification marks. This also applies to trademarks registered or applied to be registered with the Benelux Office for Intellectual Property or through a foreign registration that works in a Member State.

Any Member State can also let the proprietor of a trademark stop anyone else from using a sign in business that looks like or is the same as the trademark without permission, even if the sign is used for something other than the trademarked goods or services. It also discusses "Limitation of the effects of a trademark," which means that the proprietor of a trademark can't stop someone else from using their name or address in their business or from using an older right that only works in a certain area. The order also lets the proprietor include the proprietor of another pre-existing right listed in Article 4(4)(b) or (c) in the scope of paragraph 1.

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[423] *Article 15(2) of the EUTMR.*

Directive 2008/95 was thrown out and replaced by Directive (EU) 2015/2436. This new law brings together the trademark rules of all the Member States. The Benelux Convention on Intellectual Property (Trademarks and Designs) was signed by the Netherlands, Belgium, and Luxembourg in 2005.

It went into effect on September 1, 2006. The proprietor of a trademark has certain rights that no one else has. For example, they can stop other people from using a sign that looks exactly like the brand and could confuse people. But the Convention also says that having exclusive rights doesn't mean you can stop other people from using a similar sign in trade, as long as it's protected by an earlier right specific to that place and is recognized by the law of any Benelux country in that area. EU Trademarks Regulations protect earlier trademarks not registered during opposition or infringement cases.

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The EU protects against unauthorized use by others, ensuring it is safe on a national, European Union, or world level. An unregistered trademark must meet four conditions to challenge the registration of an EU trademark: it must be used for business purposes, it must be owned according to the laws of the member state where it was used before applying for registration of the EU trademark or its priority date, and it must be able to stop someone else from using a later trademark.

The "passing-off" rule, which is the basis of EU domestic law, is used by UK law to protect unregistered marks. This rule takes into account kindness, deception, and harm. For an applicant to be accepted, they must show these things to the appropriate EU Court. Some EU member states may protect trademarks that aren't listed in their own countries, but this is only the case in some countries. Some different parts and rules make up this security, and an EU court must look at them after being supported by the applicant in a case under Article 8(4) of the EU Trademarks Regulation. When registered, a trademark is protected more by national and EU law. However, many European trademarks still need to be registered.

CHAPTER 7 Unregistered Trademarks by International law: American Law as an example

The United States was chosen for this comparative study instead of China because the United States is also considered the largest economy in the world. The same is true of the European Union, which is regarded as the most considerable economic dependency in the world. Both parties are concerned with protecting intellectual property rights and trademarks to a large extent through developing their legislation.

Therefore, the answer lies in the strength of American law and its harmony with developments in intellectual property. Its strict commitment to protecting trademarks, unlike China, for example, even though it is considered one of the largest economies in the world, is still considered or stigmatized as the country that violates trademarks and imitates them the most in Asia and all over the world. However, some countries are deemed credible in protecting trademarks even if they are not registered, for instance, in South Korea. Famous trademarks are eligible for legal protection in Korea under the Trademark Act (TMA) and the Unfair Competition Prevention Act.

The current Korean TMA lacks explicit rules for safeguarding business indications. Contrarily, the Unfair Competition Prevention Act (UCPA) provides a significantly more comprehensive range of indications protection than the Trademark Act (TMA). UCPA protects registered and unregistered marks that have gained widespread recognition, whereas the TMA only protects registered marks.

Suppose customers widely recognize a product configuration and potentially need clarification. In that case, it can also be protected under Article 2(1)i) and (ii) of the UCPA, provided that the configuration of the product can demonstrate its origin. It is satisfactory if this role is simply secondary.

Hence, to be eligible for protection under the UCPA, two primary conditions must be met: firstly, the infringed indication must have a significant level of recognition, and secondly, the infringing indication must be confused. The primary legal framework for safeguarding well-known marks in Korea is the Trademark Act (TMA). Additionally, the Unfair Competition Prevention and Trade Secret Protection Act (UCPA) can be used as a supplementary measure to protect a well-known unregistered mark from anyone attempting to exploit the reputation and positive associations linked to such mark[425].

In 2001, the UCPA and the TMA were amended to include a legal framework for combating dilution. Legally speaking, the two have minimal distinction as they aim to safeguard the reputation of individuals or corporations utilizing trademarks. Although the TMA does not provide exclusive rights for unregistered trademarks, the UCPA serves as an additional form of shielding, particularly for well-known trademarks that remain unregistered. [426]

1. International legal regulations:

In international law, the main agreements and conventions lead the approach related to trademarks such as the Paris Convention and TRIPS agreement as follows;

1.1 The Paris Convention

The Paris Convention[427] Provides: 'The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition[428].' the Paris Convention provides that trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.'[429]

1.2 The TRIPs Agreement

Article 1 of the TRIPs Agreement, headed 'Nature and Scope of Obligations,' provides in paragraph 2: ' For this agreement, the term "intellectual property" refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.'

Article 2 of that Agreement, entitled 'Intellectual Property Conventions,' provides in paragraph 1: ' In respect of Parts II, III and IV of this agreement, Members shall comply with Articles 1 through 12 and Article 19 of the [Paris Convention].'

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[425] *Kung-Chung Liu, Annotated Leading Trademark Cases in Major Asian Jurisdictions, PublisherRoutledge, 2019, P280*
[426] *ibid, P280*
[427] *Article 1(2) of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, last revised in Stockholm on July 14, 1967, and amended on September 28, 1979*
[428] *(United Nations Treaties Series, vol. 828, No 11851, p. 305; 'the Paris Convention')*
[429] *Article 8 of the Paris Convention*

TRIPs Agreement, which is headed 'Rights Conferred,' the proprietor of a registered trademark shall have the exclusive right to prevent all third parties not having the proprietor's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion. A possibility of confusion shall be presumed when using an identical sign for identical goods or services. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available based on use.'[430]

2. Unregistered trademarks By both federal and state legislation

the United States Code–establishes a legal basis for filing a lawsuit in civil court to address allegations of deceptive labeling of products and misleading advertising. This legislation offers federal safeguarding for marks that have not been officially registered. Unregistered marks not formally recognized by the United States Patent and Trademark Office (USPTO) may still receive protection at the state level under common law or statutes related to unfair competition. Most states have implemented the Uniform Deceptive Trade Practices Act or the Model Trademark Bill[431].

2.1 Continuously safeguarded

Unregistered brands can nonetheless receive protection under common law and unfair competition rules.[432]. With trademark registration, the proprietor's legal recourse would have been expanded to the specific geographic locations where they conduct business. This implies that he can prevent another user from utilizing the mark inside his geographical region, regardless of the other user's prominence as a corporation. You can assert trademark rights if a registered trademark is unique and identifies or differentiates the goods or services you sell. A trade name for your firm and an unregistered trademark are entities and do not have equal legal protections under a federal trademark. While the scope of a trademark's protection is confined to the specific geographical area where you utilize your unregistered trademark, it is possible to safeguard an unregistered but legitimate trademark from unauthorized use and weakening through common law. To prevent someone from using the trademark without your permission, you can send a letter asking them to cease using it.

Nevertheless, to initiate legal proceedings, it is imperative to substantiate the validity of your trademarks, typically limited to state or local jurisdictions. Filing a lawsuit in federal court is available only under two conditions: if the infringer resides in a state different from yours and the disputed amount exceeds $75,000, or if the case hinges on the interpretation of the Lanham Act or other federal legislation.

Being the initial applicant for trademark registration does not automatically provide priority for obtaining the trademark.[433] However, the initial use date determines the highest-priority right to the trademark. Even if you are a small and relatively unknown business with unregistered trademarks, you can still obtain trademark rights restricted to a specific location. Nevertheless, submitting a registration request establishes the filing date, which is regarded as utilizing a trademark. This registering date takes precedence over any subsequent use of the mark in everyday business activities; if a trademark is approved, it will be retroactively registered to the date of the application.[434] Additionally, it grants precedence to any

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[430] *Article 16 of the TRIPs Agreement in paragraph 1*
[431] *Section 1125(a) of Title 15 of the United States Code*
[432] *Pranvera Këllezi, Bruce Kilpatrick, Pierre Kobel, Liability for Antitrust Law Infringements & Protection of IP Rights in Distribution, Publisher Springer, 2019, p239*
[433] *Gene K. Landy, Amy J. Mastrobattista The IT / Digital Legal Companion: A Comprehensive Business .2008, p71.*
[434] *Ann Harrison, Music: The Business - 6th Edition: Fully revised and updated, including the latest changes to Copyright law,· Publisher Random House 2014, P 231.*

subsequent applicants who register a trade. An official register will be issued if the registration application is successfully processed.

2.2 Advantages of Trademark Registration

An unregistered trademark proprietor denied registration due to legislative prohibitions may nonetheless have protection under the common law for infringement under Section 43(a) of the Lanham Act. [435] Allegations of unfair competition are considered, especially in instances involving trademarks, trade names, and unregistered rights.

The rights that result from registration are governed by the law of the state where the registration *took place.*[436]

Utilizing unregistered trademarks may have confused, but it did not violate the unfair competition statute. The trademark's goodwill, also known as Verkehrsgeltung in German, is the fundamental essence of its value and reputation. Twenty-live within the United States[437]

Nevertheless, there are other benefits to registering a trademark utilized in commerce between states. These benefits encompass the ability to initiate legal action against someone who violates intellectual property rights in a federal court, the status of being immune to the challenge after five years of registration, the assumption of proprietorship, increased legal remedies, and the dissemination of information regarding proprietorship to individuals across the country. The concept of incontestability provides a valuable advantage by preventing a trademark from being challenged only on the grounds of being descriptive, even if it is indeed descriptive.

Obtaining trademark registration is particularly crucial when conducting online business. Registering a domain name can be quite advantageous when engaged in a dispute with someone over its proprietorship. Furthermore, sales on the Internet are more extensive. Registering a trademark can have long-term worth, even if its immediate benefits may not be evident to a small business. A trademark is a type of intellectual property seen as a valuable resource contributing to the worth of a firm. [438]

Famous yet unregistered trademarks might seek commercial redress through the Anti-Unfair Competition Act. On the one hand, this demonstrates that the Anti-Unfair Competition Act supplements.[439] The regulations governing unregistered marks are based on unfair competition or unfair commerce considerations. It is deemed unjust for someone to use the goodwill they have established about an identity to sell competitive goods or services. A famous unregistered trademark can be protected against dilution.[440]

3. Trademark. Dilution.

Trademark diluting is a legislative term that enhances trademark protection for proprietors of well-known brands. It differs from trademark infringement.[441] Under the Interim Regulations, a well-known trademark rights proprietor can only request that the violating behavior be prohibited and has no recourse to damages. The mentioned issues can be resolved.[442]

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[435] *Graeme B. Dinwoodie, Mark D. Janis Trademarks and Unfair Competition: Law and Business, 2018*
[436] *Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, publisher Cambridge University Press, 2017, p230*
[437] *Dušan V. Popović, Ivana Kunda, Zlatan Meškić ,Balkan Yearbook of European and International Law 2021 · 2022, PublisherSpringer Nature, 2022, p10*
[438] *https://www.justia.com/intellectual-property/trademarks/unregistered- trademarks/#:~:text =If%20you%20do%20not%20register, in%20your%20geographic%20area%20only.*
[439] *Jichun Shi, Renmin Chinese Law Review: Selected Papers of The Jurist, 2014, p288*
[440] *Adam Brookman Trademark Law, 2014, P 8-12*
[441] *C. Kerry Fields, Kevin C. FieldsThe Legal Environment of Business 2022, P 143.*
[1]4 *YimeeiGuo, Research on Selected China's Legal Issues of E-Business 2014 ,P 162,*

3.1 famous mark

A famous mark has been accepted by the broad American public as an indication of the origin of the products or services, and the established parameters for determining fame in trademark dilution cases have been decreased. The process of dilution has not been discussed until now. One exception safeguards the use of a mark for noncommercial purposes, as stated in § 1125 (c) (3) (c). Another provision protects the right to use a trademark in a manner that parodies, criticizes, or comments on the well-known proprietor of the mark. [443]

3.2 Mark's Strength

Marks must have a secondary meaning to be registrable.[444] When selecting a trademark, the level of "distinctiveness" is the widely recognized criterion for measuring the mark's power. It is a crucial objective for intellectual property experts and their teams of marketers. Implementing a more definitive trademark will effectively differentiate the proprietor's goods or services from others as well, but it may encounter significant resistance if a similar term already exists.

A less robust trademark may require more effort to protect and may provide less uniqueness to the brand, but it can benefit from the concept of "strength in numbers," which means that no firm or brand can assert exclusive proprietorship of the term. Trademarks are categorized into various classifications that can be utilized to assess the relative potency of a mark. Every kind of phrase presents distinct difficulties and necessitates distinct approaches during the search process.[445.] Generic marks have no strength as trademarks. The strength of all other trademarks is a function of the mark's uniqueness compared to the goods or services coupled with the level of consumer recognition of the trademark.[446]

What is acquired distinctiveness or secondary meaning? Acquired distinctiveness and secondary meaning are different terms for the same thing. A mark must have a specific quantum of distinctiveness to be treated as a trademark. That distinctiveness can be inherent in the mark, i.e., intrinsic distinctiveness, or developed in the consumers' minds, i.e., acquired distinctiveness.

Acquired distinctiveness may be considered consumer trademark recognition as an identifier of source, sponsorship, affiliation, or other business relationship. Do trademarks need acquired distinctiveness before a registration may be sought? Trademarks do not have to be used before a trademark registration, but other business relationships may exist. Do trademarks need to acquire distinctiveness before a registration may be sought? Trademarks do not have to be used before a trademark registration is sought. The question arises here whether "the person has to be using the trademark before seeking a registration?" on the Application Procedure page.

To be registered on the principal register, all trademarks must have a specific quantum of distinctiveness. Marks that are neither generic nor descriptive of the goods or services are said to have enough "inherent distinctiveness" to be registered without proof of "acquired distinctiveness." Descriptive and particular case trademarks can be registered on the supplemental register without proof of acquired distinctiveness, although the rights offered are nominal. Descriptive and specific case trademarks can be registered on the principal register upon proof of acquired distinctiveness (which is presumed after the trademark has been on the supplemental register for five years)[447].

The question arises here what marks must have acquired distinctiveness before being considered trademarks? The following marks need proof of acquired distinctiveness before they are considered

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[443] *Russell L. Weaver, Steven I. Friedland, Richard D. Rosen, Constitutional Law: Cases, Materials, and Problems Fifth Edition, 2023 Case Supplement271*
[444] *Dan Hunter, The Oxford Introductions to U.S. Law: Intellectual Property, Publisher Oxford University Press, 2010, P 153.*
[445] *Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, Publisher John Wiley & Sons, 2011, P238.*
[446] *Melvin Joseph DeGeeter, Technology Commercialization Manual: Strategy, Tactics, and Economics for Business Success, Publisher Med-Launch, Inc., 2004, p249.*
[447] *Ibid, p249.*

trademarks: 1) marks that describe the goods or services, 2) foreign terms that translated are descriptive, 3) single colors, 4) surnames, 5) misspellings of descriptive terms, 6) product configurations (usually) and 7) geographically descriptive marks. How can acquired distinctiveness be proven? Acquired distinctiveness can be proven either directly or indirectly by any evidence that would be admissible in Court. How can trademark rights be lost? The standard methods for losing trademark rights are stopping the use Of the trademark, allowing the trademark to become generic, failing to prosecute infringements, improper licensing of the rights, improper assignment of the rights, and too significant of a change in quality or character of the goods or services[448].

To be registered on the principal register, all trademarks must have a specific quantum of acquired distinctiveness, also known as secondary meaning, which refers to a trademark's ability to become distinctive and associated with a particular source or origin through extensive use in commerce. When a mark is initially used, it may not be inherently distinctive and may be considered descriptive or generic. However, over time and with continuous use, a mark can acquire distinctiveness in the minds of consumers. [449].

The trademark proprietor must demonstrate that the mark has acquired secondary meaning to establish acquired distinctiveness. This means that consumers have come to associate the mark with a particular source of goods or services rather than its original descriptive or generic meaning. Several factors can be considered when determining acquired distinctiveness, including the duration and extent of use, advertising and promotion efforts, consumer surveys, and any evidence of actual consumer association between the mark and the source of goods or services.

Once acquired distinctiveness is established, the mark may receive more robust legal protection and become eligible for trademark registration. It is essential to consult with a qualified intellectual property attorney or trademark professional for guidance on establishing acquired distinctiveness for a specific mark. [450].

to qualify as a trademark, it must be "distinctive." The relationship between a term (or symbol or other indicia) and the products or services it is used in conjunction with generates distinctiveness. When a term identifies the origin or sponsor of the products or services with which it is used, it is considered distinctive. Without consumer comprehension, a term is not distinctive enough to warrant safeguarding trademark laws.

A phrase may acquire distinctiveness through its usage in the marketplace or due to its fundamental features and the situation where it is employed.[451] In the case "Abercrombie & Fitch Co. v. Hunting World, Inc.[452]," *Justice Friendly* established an approach for determining distinctiveness, known as the “spectrum." This paradigm is now routinely applied in situations containing word marks, regardless of whether they have been registered or unregistered. Justice Friendly proposed a classification system for marks, including four categories: generic, descriptive, suggestive, and arbitrary or whimsical. A generic phrase referring to a word representing the general category to which a product or service belongs may never be considered distinctive. Refer to Section 14(3) of the Lanham Act, which states that a registration can be revoked at any point if the registered mark becomes the common name for the underpinning items or services. [453] For instance, Use "BEER" as a reference for beer-related items.

Trademark protection cannot be granted to a word that only describes the characteristics of the underlying items or services. The Lanham Act prohibits the registration of solely descriptive marks.[454]. Take the example of "Car-Freshener" as an automotive air deodorizer. A descriptive phrase is a term that does not refer to a specific source and is used by other producers to describe the characteristics of their products. Yet, legal safeguards may be granted if the phrase gains distinctiveness via usage, meaning it develops an extra meaning. Refer to Lanham Act 2(f) for an exception regarding marks with secondary meaning.

According to this act, the PTO has the authority to assume, without further evidence, that a mark has a secondary meaning if it has been used for five years. A word that implies (rather than describes)

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[448] *ibid, p249.*
[449] *ibid , p249.*
[450] *ibid, p249.*
[451] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress and Design Law, Publisher Aspen Publishing, 2nd edition, 2024, p56.*
[452] *Abercrombie & Fitch Co. v. Hunting World, Inc., 531 F.2d 4 (2d Cir. 1976),"*
[453] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress and Design Law, ibid, p56.*
[454] *Lanham Act 82(e)(1),*

the characteristics or attributes of the underlying items or services is eligible for trademark protection under the Abercrombie spectrum without the requirement of demonstrating secondary meaning[455]. For instance, the term "habitat" evokes connotations related to domestic decor. The differentiation between suggestive marks and purely descriptive marks is frequently nuanced, and tribunals have devised a range of methodologies to examine this matter. In the case of *Zatarains, Inc. v. Oak Grove Smokehouse, Inc*[456], the court made a ruling.

There are four criteria for differentiating between suggestive and purely descriptive marks: The assessment includes evaluating the definition in a dictionary of the term in question to determine if it accurately describes the product's features. Additionally, it involves assessing whether a specific level of imagination is required to connect the term to the underlying products. Another aspect of the test is determining if competitors need to use the term to sell their products. Lastly, the test considers the extent to which others have used the term in marketing similar products. Ultimately, a phrase can be classified either to demonstrate secondary meaning. An arbitrary term refers to a typical English phrase that does not directly connect to the products or services it represents. For example, "Apple" represents computers despite not having an obvious tie to the product. A fanciful name is a neologism that serves solely as a distinctive identifier for fundamental products and services[457],

Consequently, marks that lack clarity, are based on personal judgment, or are impractical are considered to have inherent distinctiveness. The reason for this is that they are presumed to be distinct entities in their own right without any evidence of genuine adoption in the market. Markings that are purely descriptive and have generated secondary meaning are not intrinsically distinctive. However, markings that have gained distinctiveness over time are considered distinctive.[458] The uniqueness requirements outlined in Abercrombie were derived from instances concerning word marks, as is often the case with trademark law regulations. The question worth leaving for discussion here is what is the appropriate method for judges and the PTO to evaluate distinctiveness in matters involving trade dress or other nonverbal marks? Moreover, How about a logo similar to the Nike Co. "swoosh" mark commonly used on shoes and other products?

The swoosh serves as a distinctive symbol for athletic footwear. Nevertheless, it is challenging to determine the uniqueness of less well-known trademarks, particularly when considering their inherent distinctiveness. Would using a blue square as a marking for Nike goods be considered distinctive? What sets the Swoosh apart? Nevertheless, when logos or other nonverbal symbols denote their origin, how can one determine their uniqueness? Precisely, how can one determine if something possesses inherent distinctiveness? Several courts have attempted to utilize the Abercrombie spectrum to assess the uniqueness of logos and other nonverbal identifiers, including the whole packaging of items.

In the case of ***Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*** [459]The court tried to utilize the Abercrombie spectrum to ascertain the distinctiveness of Kendall-Jackson's “grape leaf” mark featured on its wine bottle labels. The tribunal initially proposed that this mark could possess intrinsic distinctiveness according to Abercrombie's "standard" criteria: Utilizing a “grape leaf” as a symbol for wine would generally possess intrinsic distinctiveness as it implies, instead of explicitly describes, the product. To establish a connection between the leaf and what is being produced, one must undergo two or three stages. For example, a "grape leaf" originates from a grapevine that bears grapes, which are then used to manufacture wine.

According to the conventional test, a “grape leaf” has the potential to imply and possess inherent distinctiveness. Nevertheless, due to the widespread use of “grape leaf” emblems by numerous wine manufacturers, they have lost their distinctiveness and become commonplace. Individually, a "grape leaf" cannot distinguish between distinct brands because the same logic connects the same symbol to the product in every instance: A “grape leaf” implies the presence of a grapevine, which signifies the existence of grapes, ultimately suggesting the production of wine. Due to its extensive use in the business, the “grape leaf” has become incapable of distinguishing between brands Idem. However, the tribunal acknowledged that specific “grape leaf” representations on wine bottles may include unique

[455] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress, and Design Law, Ibid p56.*
[456] *Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir. 1983),*
[457] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress and Design Law, ibid, p56.*
[458] *Ibid p57.*
[459] *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042 (9th Cir. 1998)*

characteristics. Idem. However, the court determined that Gallo was not imitating any unique elements of Kendall-Jackson's "grape leaf" emblem, if any. [460].

3.3 A suggestive trademark.

A suggestive trademark denotes a characteristic or attribute of the item or service. They are designed to stimulate a consumer's imagination and imply specific qualities of the item or service without being overly explicit. A few instances of brand names are Mustang for a type of car and Arrid for a kind of antiperspirant. Mustang evokes the characteristics of velocity and power, whilst Arrid indicates that the item will ensure your dryness. While not as strong as an arbitrary or fanciful mark, a suggestive mark is still more potent than a descriptive or generic one. When seeking a suggestive mark, it is important to consider other uses of similar "suggestions" that could potentially confuse. The utilization of synonymous terms plays a significant role in the search for suggestive marks. For instance, when searching for Cherry Boom! You may come across phrases like Cherry Pow with similar meanings in soda pop.[461]

3.4 Descriptive mark

A descriptive mark Descriptive marks clearly describe the product or service they represent.[462] These symbols need less cognitive effort from the user to evoke product characteristics. "Descriptive marks" frequently consist of several descriptive or generic terms and are less intense than suggestive, arbitrary, or imaginative names.

These brand names present difficulty in research due to the significant number of results they can generate in connected and unconnected businesses for identical and similar records. Therefore, the challenges of dealing with descriptive markings frequently revolve around concentration and size, resulting in search results that might either be highly specific or excessively broad. However, if a name accurately represents the product, unless the concept itself is entirely novel, it is likely, that someone has already conceived of it.[463]

However, descriptive marks are not considered distinctive and can only be protected if they develop a secondary meaning.[464] Descriptive phrases acquire strength and legal protection as trademarks by establishing "secondary meaning" or "secondary association." Suppose a proprietor can demonstrate that her trademark has acquired an additional meaning, distinct from the basic descriptive phrases employed in the mark, as well as that this secondary meaning establishes a strong connection between the products produced under the mark and a specific manufacturer. In that case, the proprietor's claim is valid. In such a scenario, the trademarks can be legally enforced to prevent others from using these specific descriptive terms in the same combination and arrangement to describe the items of the second user.[465]

3.5 Fanciful mark

Imaginative symbols are devised to symbolize a product or service. They lack an independent definition or significance other than serving as a designation or brand for that specific product or service. Fanciful marks are regarded as the most essential form of mark. A prime illustration is Kodak, renowned for its photographic film production.

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[460] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress and Design Law, ibid, p57.*
[461] *Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, Publisher John Wiley & Sons, 2011, P238.*
[462] *ibid, P238.*
[463] *Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, Publisher John Wiley & Sons, 2011, P238.*
[464] *Haochen Sun, Barton Beebe, Charting Limits on Trademark Rights, Publisher Oxford University Press, 2023,p45*
[465] *Leonard D. DuBoff, Michael D. Murray, Art Law: Cases and Materials, ibid,p178.*

Most drug companies typically choose imaginative trademarks. While there are other legal and regulatory grounds for doing so, one primary argument is that using a whimsical mark for a drug minimizes the chance of confusion. In the pharmaceutical sector, the mistake between two medications can have severe consequences, including physical injury and potential fatality. Consequently, the PTO and health regulatory authorities, such as the Food and Drug Administration in the United States, supervise the approval of pharmaceutical names. Names are devised and chosen to provide maximum robustness and minimize the likelihood of being mistaken for others. Elaborate symbols are employed for this purpose.

Occasionally, there are situations where the distinction between imaginative and provocative becomes unclear. This occurs when a word appears to be a newly created or artificial term, but its origin implies a suggestive connotation, potentially crossing the boundary. Claritin, a brand of allergy treatment, and Acura, a brand of cars, are examples of whimsical trademarks that may also aim to implant a suggestive idea in the buyer's mind. The primary obstacle in searching for imaginative phrases is that searches must be strong and sufficiently thorough to encompass all pertinent designations[466].

3.6 Arbitrary Mark.

An arbitrary mark is a commonly used term unconnected to the product or service.[467]. Arbitrary markings are the most potent form of mark.[468]Examples include Shell for petroleum and Apple for personal computers. These marks possess intrinsic strength as long as no other entity has registered the term in a comparable industry.

The power of these marks challenges the search method, leading to a broader categorization of related trade areas compared to weaker trademarks. [469] Trademark symbols that lack any descriptive meaning are typically applied randomly to an item or service. However, they gradually become linked to that particular item and service as time passes. The majority of random markings consist of one or more words or a combination of letters that are already part of a language but do not have any specific meaning attached to them[470].

A significant number of well-known trademarks first originate as arbitrary symbols, which over time become strongly linked in consumers' minds with the corresponding product or service. For instance, "The Golden Arch of McDonald's "might have initially lacked significance and may currently lack value for individuals unfamiliar with its connotation. Generic phrases are not eligible for protection as they are commonly used to designate all items or services of a particular sort.[471]

3.7 Digital trademark

Furthermore, one of the most exciting kinds of trademarks is a new stream that claims that domain names can be considered digital trademarks.[472]. To this point, this vision pays attention to legal principles. Registration of a domain name does not automatically grant trademark rights.[473] However, a new mainstream supported by the American Supreme Court claims that domain names with generic terms can be registered as trademarks. In this context, The U.S. (PTO) rejected the registration of "Booking.com" as a trademark, the supreme court rejected PTO's claim and granted permission to register the domain name

[466] *Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, Publisher John Wiley & Sons, 2011, P238.*
[467] *Ibid, P238.*
[468] *Scott, Scott on Multimedia Law, 4th Edition, Publisher Wolters Kluwer, 2019.p5-28.*
[469] *Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, ibid, P238.*
[470] *Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, PublisherNolo, 2022, p. 450.*
[471] *ibid, p. 450.*
[472] *Wahdani fahed, Zbornik radova Pravnog fakulteta, Novi Sad 2022, vol. 56, iss. 2, pp. 621-647*
[473] *Stephen Fishman, Trademark: Legal Care for Your Business & Product Name, Publisher Nolo, 2022 P 59*

booking .com as a trademark as an unprecedented legal case opening the door to more new conflicts in the cyber and geographical area [474]

3. Practical principle and Case study

Hetronic, an American corporation, produces remote-control devices specifically designed for use with construction machinery. Arbitron Austria, previously authorized as a Hetronic distributor, asserted proprietorship of a significant portion of Hetronic's intellectual property and proceeded to utilize Hetronic's trademarks on the items it marketed. Hetronic initiated a lawsuit against Abitron in the Western District of Oklahoma, invoking the Lanham Act,[475].Hetronic was granted a jury award of around $96 million[476].

The Tenth Circuit upheld the decision, determining that the Lanham Act applied "all of Abitron's infringing activities conducted outside the United States."The Supreme Court rendered a decision to invalidate or annul. Applying the presumption against extraterritoriality, it is determined that the parts of the Lanham Act do not have jurisdiction beyond national borders[477].

These sections only apply to cases where the unauthorized use of a trademark in trade is limited to domestic activities. Neither clause explicitly states that it applies outside of the territory or provides any other obvious indication that it is one of the few provisions that still apply abroad. Both laws explicitly forbid the utilization of protected trademarks in commercial activities if such usage is very probable to confuse. The Court took into account the location of the action about the statutory prohibitions, specifically the unauthorized "use in commerce" of a protected brand under specified conditions, as sections 1114(1)(a) and 1125(a)(1) do not have extraterritorial application. The distinction between foreign and domestic applications of these rules is determined by the concept of "use in commerce."

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4.1 infringement has employed a trademark to indicate the origin of its products.

When the party accused of infringement has employed a trademark to indicate the origin of its products, such utilization falls within the central domain of trademark legislation. It is not granted distinct constitutional protection under the First Amendment

4.1.1 Jack Daniel's Properties, Inc v. VIP Products LLC (2023)[478]

VIP produces a canine chew toy that resembles a Jack Daniel's whiskey bottle, with the brand name "Jack Daniel's" being altered to "Bad Spaniels." "Old No. 7 Brand Tennessee Sour Mash Whiskey" is transformed into "The Old No. 2 On Your Tennessee Carpet." Jack Daniel demanded that VIP cease selling the toy.

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[474] *ibid P 59*
[475] *specifically sections 15 U.S.C. 1114(1)(a) and 1125(a)(1)*
[476] *Shilling, Lawyer's Desk Book, Publisher Wolters Kluwer, 2018 2nd Edition, P 10-57*
[477] *Hendrik. Zwarensteyn, Some aspects of the extraterritorial reach of the American antitrust laws, Publisher Springer Science & Business Media, 2013,p117.*
[478] *Ibid.p117.*

VIP requested an injunction to determine that Bad Spaniels did not violate or weaken Jack Daniel's trademarks. Jack Daniel's filed a counterclaim. The Lanham Act provides a precise definition of a trademark based on its principal purpose, which is to identify the origin of a product and differentiate it from other sources. In a typical infringement case, the evaluation focuses on whether the defendant's trademark utilization is "probable to result in confusion, error, or deception." [479]In a typical dilution case, the focus is on whether the defendant has caused damage to the reputation of a trademark.

VIP referenced the "Rogers test," which mandates the dismissal of an infringement claim when it involves "expressing works" unless the plaintiff can demonstrate either that the use of a trademark in question "lacks artistic relevance to the underlying work" or that it "explicitly misleads regarding the origin or content of the work." The Ninth Circuit issued a favorable ruling in favor of VIP.

The American Supreme Court rendered null and void. The Rogers test is not applicable when a purported infringement uses a trademark as an indication of origin for their products. Consumer confusion over origin is most likely when an individual employs someone else's brand as their trademark. Bad Spaniels does not inherently qualify for Rogers' protection because of its "conveyance of a hilarious theme." VIP employed the Bad Spaniels brand and trade dress to identify their products' origin. While VIP's attempt to imitate Jack Daniel's does not warrant using the Rogers test, it could potentially impact the evaluation of the trademark in the subsequent analysis.

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The Lanham Act establishes a legal claim for weakening well-known trademarks, which can be successful even without confusion.[480] A renowned mark is a mark that is widely acknowledged by the public as indicating the origin of the items belonging to the proprietor of the mark[481]. The dilution of a mark can occur through tarnishment, which is distinct from blurring and not applicable in this context, and to the statute[482], if there is a similarity between two marks, one of which is famous, it may harm the famous mark's reputation and result in the proprietor of the other mark being held responsible.[483]

4.1.2 Patent and Trademark Office v. Booking.com. B.V.

A generic term that refers to a category of items or services cannot be registered as a federal trademark. Booking.com, a website allowing users to make travel reservations, applied for federal registration of trademarks incorporating the phrase "Booking.com." The U.S. Patent and Trademark Office (PTO) denied enrollment, stating that "Booking.com" was a generic term for online hotel reservation services. The Fourth Circuit upheld the District Court's ruling that "Booking.com" is not generic, in contrast to the term "booking" itself.

the term "booking" itself.

The American Supreme Court upheld the decision. The term "generic.com" is considered a generic name for a specific category of products or services only if customers perceive it as such. Determining whether a compound term is generic hinges on whether that term indicates to consumers a category of products or services when considered. Consumers do not view the name "Booking.com" in that manner.

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[479] *15 U.S.C. 1114(1)(A) and 1125(a)(1)(A).*
[480] *United States Reports volume 537,p 431*
[481] *Section 1125(c)(2)(A)*
[482] *Section 1125(c)(1).*
[483] *Jack Daniel's™ Properties, Inc. v. VIP Products LLC, 599 U.S. (2023), https://supreme.justia.com/cases/federal/us/599/22-148/case.pdf*

Each Internet domain name can only be held by a single company at any moment. Therefore, a word like "generic.com" can indicate a direct connection with consumers to a particular website. A rigid legal theory that ignores consumer perception would not align with a fundamental tenet of the Lanham Act. The worries of the PTO's policy do not endorse a universal prohibition on registering "generic.com" keywords. Multiple principles guarantee that registering a domain of "Booking.com" would not grant its proprietor exclusive rights over the term "booking."

4.1.2.1 Explanation

Primary Holding The phrase "Booking.com," when combined with ".com," is not disqualified from being registered as a trademark because consumers do not consider it a generic name for a category of products or services.

A generic term that refers to a category of items or services cannot be registered as a federal trademark. The respondent, Booking.com, a company that operates a travel-reservation service under the same name, applied for federal registration of trademarks that use the word "Booking.com." The U.S. Patent and Trademark Office (PTO) rejected the registration of "Booking.com" as a trademark, stating that it is a common term for online hotel reservation services. Booking.com requested a legal review, and the District Court concluded that the phrase "Booking.com" is not generic, unlike the standalone term "booking." The Court of Appeals upheld the District Court's decision, concluding that there was no mistake in the District Court's evaluation of how consumers interpret the term "Booking.com." The appellate court also dismissed the PTO's argument that, as a general rule, combining a generic term such as "booking" with ".com" results in a generic combination.–Ruling: The term "generic.com" is considered a generic name for a specific category of products or services only if consumers perceive it as such. [484]

Determining whether a compound phrase is generic depends on whether that term indicates to consumers a category of products or services when considered as a whole. The lower courts have concluded, and the PTO no longer disagrees, that consumers do not perceive the term "Booking.com" in that manner. Since customers do not perceive "Booking.com" as a generic name, it is not considered generic. [485]

In contrast to that determination, the PTO advocates for a nearly absolute rule: Combining a generic phrase with a generic Internet domain name suffix such as ".com" results in a generic combination. The PTO's previous actions do not support the rule proposed by the PTO and are not backed by trademark law or policy.[486]

The proposed ruling by the PTO is not a logical consequence of Goodyear's India Rubber Glove Mfg Co. v. Goodyear Rubber Co.,[487] The PTO argues that Goodyear demonstrated that adding a generic business identification such as "Company" to a generic phrase does not grant trademark eligibility. As per the PTO, appending ".com" to a generic phrase, similar to appending "Company," does not convey any meaning that identifies the source. The concept needs to be revised since only one entity can possess a particular Internet domain name at any moment.

Therefore, a phrase like "generic.com" could suggest a connection with a specific website to customers. Furthermore, a rigid legal theory that completely ignores consumer impressions is inconsistent with a fundamental principle of the Lanham Act: Categorizing a specific phrase as generic or nongeneric is determined by how consumers interpret its

[484] *Ibid. p 6 to 14.*
[485] *Ibid. p 6 to 7.*
[486] *Ibid. p 7 to 14.*
[487] *Glove Mfg Co. v. Goodyear Rubber Co., 128 U.S. 598 case.*

meaning. Specifically, it depends on whether consumers see the term as a general name for a group or as a term that can differentiate between different members within the group[488]

The considerations of the PTO's policy do not justify a blanket prohibition on registering words that are "generic.com." The PTO argues that granting trademark protection to "Booking.com" would grant the proprietor excessive authority over identical wording that should be available for unrestricted use by others. That issue applies to any descriptive trademark. To prevent the anti-competitive consequences identified by the PTO, certain legal principles are in place to ensure that the registration of "Booking.com" does not grant its proprietor exclusive rights to the term "booking."

The PTO also questions the necessity of trademark protection for proprietors of "generic.com" brands, given their already established competitive advantages. Nevertheless, these benefits do not automatically prohibit a trademark from being eligible for federal registration. Ultimately, the PTO recommends that Booking.com could explore alternative solutions within trademark law. However, there is no justification to withhold from Booking.com the same advantages that Congress has granted to other trademarks that meet the criteria of being non-generic.[489]

4.1.3 willfully infringed the plaintiff's trademark as a precondition to a profits award.

A plaintiff in a trademark infringement lawsuit must not show that a defendant willfully infringed the plaintiff's trademark as a precondition to a profits award. Romag and Fossil arranged to include Romag's rapid fasteners in Fossil's leather products.

4.1.3.1 Romag Fasteners, Inc. v. Fossil, Inc. (2020)

Ultimately, Romag uncovered that Chinese firms producing Fossil merchandise employed fraudulent Romag fasteners. Romag filed a lawsuit against Fossil and specific Fossil shops, accusing them of violating its trademarks under 15 U.S.C. 1125(a). The district court denied Romag's request for an award of profits, relying on previous decisions from the Second Circuit. This decision was based on the jury's determination that although Fossil had acted callously, they did not find sufficient evidence to support Romag's claim that Fossil had behaved intentionally.

mag's claim that Fossil had behaved intentionally.

ag's claim that Fossil had behaved intentionally.

The Supreme Court nullified. A plaintiff in a lawsuit for trademark infringement is not obligated to demonstrate that the defendant intentionally violated the plaintiff's registered trademark to be eligible for a percentage of earnings. Section 1117(a) of the Lanham Act, which deals with penalties for trademark breaches, stipulates that proving willfulness is necessary to receive a monetary settlement in a lawsuit under section 1125(c) for trademark dilution. However, section 1125(a) has never demanded such proof. The Act frequently and explicitly addresses mental states, demonstrating that Congress did not intend to include them indirectly.[490].

4.1.4 Registration of immoral or scandalous Trademarks

The Lanham Act's prohibition on registration of immoral or scandalous trademarks violates the First Amendment. The Lanham Act's limitation on registering illicit or disgraceful trademarks violates the First Amendment

[488] *Ibid. P 8 to 11.*
[489] *Ibid. Pages 11 to 14.*
[490] *https://supreme.justia.com/cases/federal/us/590/18-1233/*

4.1.4.1 Iancu v. Brunetti (2019)

Brunetti applied for federal registration of the FUCT trademark. The Patent and Trademark Office rejected the application submitted by the individual based on a clause of the Lanham Act that forbids the registration of trademarks that contain "immoral" or "scandalous" content, as stated in 15 U.S.C. 1052(a). The Supreme Court upheld the decision of the Federal Circuit, ruling that the clause violates the First Amendment.

The Court acknowledged that it had previously declared the Act's prohibition on registering marks that "disparage" anyone, whether alive or deceased, as unlawful. The criterion of "immoral or scandalous" also exhibits perspective discrimination. Expressing material is deemed "immoral" if it contradicts integrity, purity, or good morals, is wretched, or cruel. The Act allows for the registration of marks that uphold society's sense of decency and morality, not marks that degrade or belittle those ideals. Material is considered "scandalous" when it causes offense to one's mind or moral sentiments, elicits strong disapproval, or invites censure.

The Act permits the registration of marks that align with society's standards of morality and appropriateness but not those that go against them. The statute explicitly differentiates between beliefs that conform to conventional moral standards and those that oppose them. The Court dismissed the contention that the Act can be interpreted in a way that restricts its scope. The criterion of "immoral or scandalous" does not limit itself to vulgar, sexually explicit, or profane marks. Furthermore, it does not solely pertain to marks that are very oppositionable in their form of expression, regardless of the viewpoint. If the government's suggestions were followed, it would not be an interpretation of the legislation that Congress passed but rather the creation of a new statute.[491]

4.1.5 The registration of trademarks that may belittle or cause scorn or dishonor to any individual,

The section of the Lanham Act that prohibits the registration of trademarks that may belittle or cause scorn or dishonor to any individual, whether alive or deceased, violates the Free Speech Clause of the First Amendment.[492].

4.1.5.1 Matal v. Tam (2017)

The rock band, "The Slants",, deliberately selected that name to mitigate the pejorative impact associated with the phrase, which is commonly used to demean individuals of Asian descent. The request for registering the name was rejected by the Patent and Trademark Office (PTO) under 15 U.S.C. 1052(a)[493], which forbids the registration of trademarks that could potentially "disparage . . . or bring . . . into contempt or disrepute[494]" any "persons, living or dead."

The Supreme Court upheld the Federal Circuit's decision, ruling that the clause is illegal. The Court initially dismissed the contention that the Article exclusively pertains to individuals or legal entities. The Court subsequently determined that the clause is subordinate to the Free Speech Clause, which does not restrict government speech[495]. Trademarks are considered expressions of private entities rather than being classified as governmental speech.

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[491] *Elena KaganIancu v. Brunetti (2019), 588 U.S. (2019) https://supreme.justia.com/cases/federal/us/588/18-302/case.pdf*

[492] *Katherine A. Currier, Thomas E. Eimermann, Marisa S. Campbell, Introduction to Law for Paralegals: A Critical Thinking Approach, Aspen Publishing, 2023,p531.*

- Irene Calboli, Srividhya Ragavan, Diversity in Intellectual Property: Identities, Interests, and Intersections, Cambridge University Press, 2015, p105.

- Emmanuel K. Ngwainmbi, Dismantling Cultural Borders Through Social Media and Digital Communications: How Networked Communities Compromise Identity Springer Nature, 2022, p81

[493] *Alexander Brown, Adriana Sinclair, Routledge, The Politics of Hate Speech Laws, 2019.*

[494] *Kent R. Middleton, William E. Lee, Daxton Stewart, The Law of Public Communication: update 2017, Routledge, 2016 P 277.*

[495] *James M. Masnov Rights Reign Supreme: An Intellectual History of Judicial Review and the Supreme Court Publisher McFarland, ,2023, p188.*

"If trademarks are considered government speech upon registration, then the Federal Government is engaging in extensive and nonsensical expression." The disparagement provision prohibits registering any mark deemed opposition able by a significant portion of any group's members. That constitutes prejudice based on one's perspective. Banning the public speech of ideas is not justified because these ideas may harm specific individuals. The disparagement clause cannot bear scrutiny, even under a more lenient assessment standard. It fails to fulfill a significant purpose and needs to be specifically tailored.

4.1.6 Mental association between the junior user's mark and a recognized mark.

The burden of negating any risk of confusion among consumers regarding the origins of the impacted products or services is not placed on a defendant who raises the trademark fair use argument.[496]

4.1.6.1 Moseley v. V Secret Catalogue, Inc. (2003)[497]

Merely establishing a mental association between the junior user's mark and a recognized mark is insufficient to prove illegal dilution, especially where the marks in question are different. Dilution is an independent legal claim that empowers the proprietor of a widely recognized trademark to prohibit the utilization of comparable markings in manners that negatively impact the general public's opinion of the renowned mark.[498]

The army colonel forwarded a duplicate of an advertisement for a retail store called "Victor's Secret" to the respondents, linked corporations that possess the VICTORIA'S SECRET trademarks. The colonel perceived this act as an endeavor to exploit a well-regarded trademark to endorse indecent and cheap items. The respondents requested that the respondents cease using the name. However, the petitioners responded by altering the store's name to "Victor's Little Secret."

The respondents, after that, initiated legal proceedings, claiming, among other things, the diminishment of renowned trademarks as stipulated by the Federal Trademark Dilution Act (FTDA). The 1995 amendment to the Trademark Act of 1946 outlines the criteria for determining if a mark is "distinctive and famous," as stated in 15 U.S.C. § 1125(c)(1). It also defines "dilution" as the reduction in the ability of a well-known mark to identify and differentiate products or services Section 1127[499]. To substantiate their assertions that the actions of the individuals filing the petition were likely to diminish the uniqueness of their trademark and harm its reputation, the opposing party provided a sworn statement from a marketing specialist.

The expert elucidated the significance of the opposing party's trademark but did not offer any viewpoint regarding the effect of the petitioners' utilization of "Victor's Little Secret" on said significance. The District Court ruled in favor of the respondents by granting them summary judgment on the FTDA claim.

The Sixth Circuit upheld this decision, stating that the respondents' mark was "distinctive" and that the evidence demonstrated "dilution" despite the absence of proven actual harm. The Fourth Circuit's conclusions that the FTDA necessitates proof of a defendant using a junior mark that is similar enough to the infamous mark to create a mental association in consumers and that this relationship led to actual financial damage by reducing

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[496] *Craig Allen Nard, Michael J. Madison, Mark P. McKenna, The Law of Intellectual Property · Publisher Aspen Publishing, 2017*

[497] *Daniel R. Bereskin, Trademark Dilution, and Free Riding, Publisher Edward Elgar Publishing 2023, P79.*

[498] *Richard A. Spinello, Herman T. Tavani Intellectual Property Rights in a Networked World: Theory and Practice Publisher Idea Group Inc (IGI), 2005,p125,*
- Henry H. Perritt, Digital Communications Law, Publisher Wolters Kluwer · 2010, P10.

[499] *Trademark Act of 1946 as stated in 15 U.S.C. § 1125(c)(1).*

the selling power of the famous mark as a marketing agent for its products or services was also overruled by the court. [500]

In contrast to the customary development of infringement law, the restrictions on trademark dilution are not derived from common law and do not stem from a desire to safeguard consumers. The FTDA refers to the approximately 25 state trademark dilution laws before it. These laws address both the harm to corporate reputation (tarnishment) and the weakening of the unique characteristics of a trademark or trade name (blurring). The legislative context of the FTDA explicitly states that the goal of the act is to safeguard renowned trademarks from any subsequent uses that diminish the mark's uniqueness or bring discredit or disrespect to it, even in the absence of a probability of confusion.

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safeguard renowned trademarks from any subsequent uses that diminish the mark's uniqueness or bring discredit or disrespect to it, even in the absence of a probability of confusion.

The respondents' mark is undeniably precious, and the complainants have not disputed the determination that it is "famous." Furthermore, they do not argue that protection is limited to the same applications of well-known trademarks, nor do they suggest that the law should be interpreted more restrictively in a situation like this. However, they argue that the law necessitates evidence of tangible damage rather than just the possibility of injury. The disparity between the state and federal statutes illuminates this inquiry. The above statement consistently mentions the "probability" of injury rather than actual harm. However, the FTDA offers a remedy if someone else's business use of a trademark or trade name "diminishes the unique characteristic of the mark," [501]

Therefore, it unequivocally necessitates a concrete demonstration of dilution. This conclusion is substantiated by the description of "dilution" provided by the FTDA in section 1127. However, it is unnecessary to provide evidence of actual loss of sales or profits to demonstrate the effects of dilution. The Court disagrees with the Fourth Circuit's Ringling Bros. decision insofar as it implies otherwise. However, the Court concurs with the conclusion reached by the Fourth Circuit that, in cases where the marks in question are not identical, the mere mental association of the junior user's mark with a well-known mark is insufficient for proving legally actionable dilution. This association does not always diminish the famous mark's ability to distinguish the goods of its proprietor, as required by the FTDA's dilution requirement.

This case's available evidence is insufficient to justify granting summary judgment on the dilution count. No evidence indicates that Victoria's SECRET mark has lost its ability to identify and differentiate between products and services offered in Victoria's Secret stores or promoted in its catalogs. The officer focused solely on the petitioners, rather than the responses, in response to the advertisement.

The expert respondents did not mention the influence of the petitioners' names on the potency of the respondents' trademarks. The presence of challenges in proving actual dilution does not justify disregarding the need to establish a fundamental aspect of a statutory infringement. [502]

4.1.7 A product feature is functional and thus not protectable.

A product feature is functional and thus not protectable as trade dress if it is essential to the use or purpose of the article or affects the cost or quality of the article. Also, a functional

[500] *See in Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449.*
[501] *FTDA Section 1125(c)(1)*
[502] *Justine Pila, Seville's EU Intellectual Property Law and Policy ibid P 434.*

feature is exclusively used, which would put competitors at a significant non-reputation-related disadvantage.[503.]

4.1.7.1 TrafFix Devices, Inc. v. Marketing Displays, Inc. (2001)

Marketing Displays, Inc. (MDI) currently possesses expired utility rights for a mechanism known as the "dual-spring design." This mechanism maintains upright portable roadways and other outdoor signs under unfavorable wind conditions.

MDI asserts that its sign stands were easily identifiable to purchasers and users due to the prominent placement of the patented design towards the base of the sign's stand. Following the expiration of the patents, TrafFix Devices, Inc. started selling sign supports with a dual-spring mechanism that was taken from MDI's design. In response, MDI filed a lawsuit under the Trademark Act of 1946, alleging trade dress infringement, among other claims.

The District Court approved TrafFix's request for summary judgment, concluding that there was insufficient evidence for a fact-finder to determine that MDI had proven a secondary meaning in its claimed trade dress. In other words, consumers did not associate the appearance of the dual-spring design with MDI. Additionally, the court found that the trademarked design was ineligible for trade dress protection because it served a functional purpose.

The Sixth Circuit issued a reversal of the previous decision. The argument is that the District Court made a legal mistake by only considering the dual-spring design when assessing MDI's trade dress. It is argued that a competitor must demonstrate a way to hide or differentiate its design from MDI's. Based on Qualitex Co. v. Jacobson Products Co., it is explained that protection for trade dress may only be refused on functionality grounds if the sole incorporation of a characteristic puts competitors at a significant disadvantage unrelated to reputation. Additionally, it is mentioned that there is a disagreement between both Circuits regarding whether or not an expired utility patent prevents trade dress from safeguarding the design of an item.

4.1.7.2 Wal-Mart Stores, Inc. v. Samara Brothers, Inc[504]

Samara Brothers, Inc. is a company that creates and produces a range of apparel specifically for children. Wal-Mart Stores, Inc., entered into a purchase agreement with a supplier to make clothing items designed according to Samara apparel images. Upon finding that Wal-Mart and other shops were selling counterfeit products, Samara initiated legal proceedings, alleging, among other things, the violation of unregistered trade dress under §43(a) of the Trademark Act of 1946 (Lanham Act).

Samara was the recipient of a favorable verdict from the jury. Wal-Mart subsequently filed a move for judgment as a matter of law, contending that there was inadequate evidence to establish that Samara's apparel designs could be legally safeguarded as distinctive trade dress under Section 43(a). The District Court rejected the motion, and Samara was granted relief. The Second Circuit upheld the rejection of the motion.

Retained: In a legal action under section 43(a) for violating unregistered trade dress, an item's unique design is considered distinctive and eligible for protection only if it can be proven to have acquired a secondary meaning. [505]

(a) The Lanham Act, specifically under Section 43(a), not only safeguards registered trademarks but also provides producers with the right to take legal action against any individual who uses a "symbol or device" that is likely to create confusion about the source of their goods.

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[503] *Peter K. Yu, Intellectual Property and Information Wealth [4 volumes]: Issues and Practices in the Digital Age [4 volumes] · 2006, PublisherBloomsbury Publishing USA, 2006, p221.*

[504] *CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT No. 99-150. Argued January 19, 2000-Decided March 22, 2000*

[505] *https://supreme.justia.com/cases/federal/us/529/205/case.pdf Pages 209 to 216.*

The scope of the components that can cause confusion, which can be addressed under § 43(a), extends beyond word marks and symbol marks. It also includes "trade dress," which initially referred only to the packaging of an item but has been broadened by several Courts of Appeal to include the product's design. The courts above have accurately inferred that trade dress serves as a "symbol" or "device" under the Lanham Act. While § 43(a) does not directly mandate that a manufacturer demonstrate the distinctiveness of its trade dress, courts have consistently applied this prerequisite. This is because, without distinctiveness, the trade dress would not fulfill the criteria of § 43(a) by confusing its origin.

When assessing distinctiveness, courts distinguish between inherently distinctive marks - meaning that their inherent characteristics help identify their specific source - and marks that have gained distinctiveness using secondary meaning - indicating that, in the thoughts of the public, their paramount importance is determining the origin of the good in question rather than the item itself. According to this Court's ruling, it has been established that some types of mark-color combinations can never be considered fundamentally unique. Yet, they remain entitled to protection if evidence of secondary significance is presented. [506]

Design, such as color, does not possess inherent distinctiveness[507]. The ascription of inherent uniqueness to specific types of word marks and product packaging arises due to the fundamental intention of associating a particular word with a product or enclosing it in a distinctive package, primarily to indicate the origin of the goods. If there is no reason to believe that consumers will interpret an attached term or package as an indication of the source, then the inherent distinctiveness will not exist. In product design, just like with color, customers understand that the purpose of these features is not primarily to identify the source but rather to enhance the usefulness or attractiveness of the product. [508]

The symbol "(c)" represents the copyright symbol. The Court's finding in Two Pesos, Inc. v. Taco Cabana, Inc. does not apply to the present case. This is because the trade dress in question, in that case, referred to the decoration of the restaurant, which is different from product design.

Restaurant decoration can be considered either product packaging or something similar to product packaging, and it is not relevant to the present instance. Although differentiating between two pesos may require tribunals to establish intricate distinctions between trade dress related to item design and the product's packaging, the amount of time and effort of making such distinctions will be significantly lower than determining whether a product design is inherently distinctive. When there are situations where it is difficult to decide, courts should prioritize prudence and identify trade dress that is unclear as the product's design, which would then necessitate the presence of secondary meaning.[509]

5. Conclusion

The United States and the European Union are significant players in protecting intellectual property rights and trademarks. American law is strong in its harmony with intellectual property developments, while China is stigmatized as the country that violates and imitates trademarks the most in Asia. International legal regulations include the Paris Convention and the TRIPs Agreement, which outline the rights of registered trademark proprietors to prevent third parties from using identical or similar signs for goods or services.

To this point, Trademarks are categorized into various classifications, including generic, descriptive, suggestive, and arbitrary or whimsical. The Lanham Act prohibits the

[506] *The case of Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, https://supreme.justia.com/cases/federal/us/514/159/case.pdf 162-163,*
[507] *Graeme B. Dinwoodie, Mark D. Janis Trade Dress and Design Laws, Publisher Aspen Publishing, 2022,p87.*
[508] *https://supreme.justia.com/cases/federal/us/529/205/case.pdf, ibid P 212 to 214.*
[509] *Ibid, P 214 to 215.*

registration of solely descriptive marks, but legal safeguards may be granted if the phrase gains distinctiveness via usage. Moreover, unregistered marks not formally recognized by the USPTO may still receive protection at the state level under common law or statutes related to unfair competition. Most states have implemented the Uniform Deceptive Trade Practices Act or the Model Trademark Bill. Unregistered brands can still receive protection under common law and unfair competition rules.

Descriptive marks describe the product or service they represent, making them less intense and requiring less user cognitive effort to evoke product characteristics. Fanciful marks are essential for symbolizing a product or service, while arbitrary marks possess intrinsic strength as long as no other entity has registered the term in a comparable industry.

A new stream of trademarks claims that domain names can be considered digital trademarks. This vision pays attention to legal principles, as domain name registration does not automatically grant trademark rights. Under competition law, unregistered trademarks may be subject to restrictions, such as confusing or misleading consumers about a product's origin.

Chapter 8 Bad Faith Matter

Bad faith plays a vital role in determining trademark infringement and protecting trademark rights. Generally, bad faith is seen as unethical and illegal behavior in the field of trademark law. If a trademark proprietor can demonstrate that another individual has engaged in malicious intent, they may have the ability to effectively contest the registration or utilization of the trademark.[510]. In this regard, the author will analyze this concept and how it has affected the trademark's stakeholders as the following:

1. classifications and definitions

Bona Fide (malicious purpose) Bad faith refers to an intellectual situation marked by a deliberate intention to mislead customers through the use of a competitor's brand or mark or a comparable one that may confuse them. Infringing a trademark or dilution can be shown without proving bad faith.[511] It refers to conduct that is considered unfair or indecent.[512] In the context of trademark law, Bad faith pertains to the deliberate and deceitful utilization or registration of a registered trademark in unfair competition with other enterprises. Bad faith can also denote a deliberate infringement of the rights of a trademark proprietor.[513].

In this regard, the key remedy for the issue of malicious trademark registration is establishing a standardized and universally applicable recognition criterion for identifying malicious intent. This approach has the potential to effectively address a wide range of difficulties associated with trademark registration. Regarding operational administration, it is crucial to thoroughly assess whether or not the trademark registration petitioner has any malevolent

[510] *Igor Demcak, 4 types of bad faith trademark applications that will be rejected, March 2023. https://www.tramatm.com/blog/category/legal/4-types-of-bad-faith-trademark-applications-that-will-be-rejected*
[511] *Matthew L. Cole, The Complete Guide to Patents, Copyrights, and Trademarks: What You Need to Know Explained Simply, Atlantic Publishing Company, 2008, p113*
[512] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p201.*
[513] *ibid*

intent. [514] Whether the trademark applicant is aware or should be aware of the existence of previous rights mostly hinges on assessing the contender's desire to monopolize the trademark maliciously, their genuine purpose of utilizing it, and other relevant criteria. [515]

In the context of trademark registration, the awareness or reasonable knowledge of the person seeking registration of previous ownership is crucial. The distinction between actual knowledge and the expectation of knowledge must be considered on a case-by-case basis since they have various implications. If the person applying has left no justifiable grounds for being unaware of the validity of prior rights, including the trademark or prior rights being widely recognized in their daily life, they still need to be considered to have shown a little carelessness' if they were unaware; however, if the trademark registration candidates can provide evidence that they genuinely weren't aware, they may not be deemed to have acted with 'malicious' intent.

Furthermore, the period during which the person applying for a trademark is a crucial aspect in assessing their level of malevolent intent. If the person who applies to earn trademark registration ends up aware of any prior rights associated with the trademark after applying, they will not be considered to have acted with a malicious purpose. This is because they did not harbor any intention to infringe on the prior rights of others at the moment of usage. [516] However, if the applicant has knowledge of the beforehand advantages and nevertheless proceeds with the registration, the situation can be assumed that they are acting maliciously. In this case, there is no need to further investigate whether they intended to infringe on the earlier rights of others[517].

2 Bad faith is an unequivocal reason for rejection.

Bad faith is a definitive reason for rejection according to the TMDir. However, in reality, registering institutions do not apply the concept of ill faith to their initiative. In the context of the B VIE, the concept of bad faith is primarily used by third parties who have a conflicting interest in utilizing the same sign as a trade name or registering it as a trademark to argue for its invalidity. Section 3.1 of the TMA explicitly identifies bad faith as an absolute reason for rejecting a trademark application. According to Article 51.1. b of the Trademark Regulation, bad faith is considered an absolute reason for invalid. Since its modification in 2004, the German trademark law GTML includes a clause about bad faith. The modification was introduced because the descriptive system of trademark application under the 1995 GTML resulted in instances where individuals enrolled signs of significant cultural importance (such as the name and image of Johann Sebastian Bach, an artwork of Mona Lisa, or the portrait of Marlene Dietrich) as trademarks to extract licensing costs from those who wished to use these signs. The public's strong protest in response to these 'abusive' registrations prompted lawmakers to create a provision for rejecting applications made in bad faith, in order to address such instances of 'trademark snatching'. The grounds for refusing or invalidating based on bad faith might assist a particular artist in asserting their rights and is indicative of a sophisticated culture. [518]

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[514] *Rui Su, On the Regulation of Bad Faith Trademark Registration International Journal of Education and Humanities, ISSN: 2770-6702 | Vol. 5, No. 3, 2022, p 194.*
[515] *ibid, p 194.*
[516] *Rui Su, On the Regulation of Bad Faith Trademark Registration International Journal of Education and Humanities, ibid, p 194.*
[ib] *ibid, p 194.*
[518] *Wolfgang Sakulin, Trademark Protection and Freedom of Expression: An Inquiry Into the Conflict Between Trademark Rights and Freedom of Expression Under European Law, Kluwer Law International B.V., 2011, p211*

3. Application for an EU Trademark (EUTM) and the concept of bad faith

If an EUTM implementation is filed before the joining currently for a term that is descriptive or otherwise capable of enrollment in the official language of the newly admitted Member State, solely to get exclusive rights for a non-registrable term or inappropriate reasons, the Office will view it as having been made in bad faith. During the examination stage, ill faith does not have any practical impact because it does not serve as a complete basis for rejection. Therefore, the Office does not have the power to raise opposition to its initiative. The Office is only going to fulfill its responsibilities regarding "bad faith submissions" when an application for an acknowledgment of legality is submitted. The national offices of the recently admitted countries noun plural of country. Report Word is similarly committed to combatting dishonesty in the framework of expansion. EUTM applicant ought to be aware that, notwithstanding the absence of any reasons for refusal throughout the registration process, their EUTM registrations may still be challenged in the future under the EUTMR.[519]

3.1 Application submitted with malicious intent

According to the BTIP, an applicant fails to secure a trademark right if somebody for the trademark is in consideration with malicious intent. BTIP provides two illustrative examples of circumstances involving poor faith. The BTIP[520] specifies the circumstances under which the cancellation of a trademark that was acquired in violation of the BTIP can be requested and specifies who can make this request[521]. The ability to invoke bad faith is outlined in the BTIP Directive[522]. Member States have the discretion of selecting this as a basis for rejection as/or invalidity and make it a possible ground. The majority of the nations that were members were already utilizing this option in some way or otherwise. Article 52(1)(b) of the Regulation also refers to the act of intentionally applying a reason for legitimacy. [523]

3.2 Impact of the BTA Directive Initially

Article 4(6) of the BTA introduced the option to claim bad faith, which was implemented in the same manner as it has now been stated in BTIP.[524]. Throughout the BTA, a significant body of legal rulings emerged that specifically addressed the interpretation and application of the word 'bad faith'. The primary focus of this particular instance of law is on the two instances of dishonest intent outlined in Article 2.4(f)(10) and (20) of the BTIP. [525]However, Finland and Sweden do impose sanctions on knowledge of prior use of a trademark by another party. In addition to the possibility of invalidation, France also offers the possibility of revindication by the 'aggrieved party'. Denmark has opted for a very limited implementation.[526]

One can question the degree to which the legislation, as it was being constructed and understood during that time when the BTA was in effect, had been affected by the Directive

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[519] *(Article 59(1)(b) EUTMR)*

[520] *Article 2.28(3) of the BTIP*

[521] *Article 2.4(f) of the BTIP*

[522] *Article 3(2)(d) and Article 4(4)(g) of the BTIP Directive*

[523] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p199.*

[524] *Article 2.4(f) of the BTIP.*

[525] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law,. Ibid, p199.*

[526] *ibid p199.*

in question. As previously said, the Directive provides the member states with the choice to utilize ill faith as a barrier to obtaining a trademark right. It is presumed that this grants the Member States a wide latitude for formulating regulations on this matter. Nevertheless, the phrase 'bad faith' in the Directive probably has a distinct and precise definition. This contention is supported by the presence of an identical term in the Regulation as well, which suggests that it deserves to be examined. Therefore, any national application in statute or legal precedent that deviates from this interpretation is deemed undesirable. [527] Both the EU Directive and the Regulation do not define the phrase 'bad faith'. Neither the BTIP, the 'old' BTA, nor the Joint Commentary of the Assemblies of the Member States to the BTA address this issue extensively[528]. In BTIP, two instances are provided where bad faith is presumed[529]. The first is when an applicant files a trademark application knowing or would have known about the prior legitimate use of a comparable trademark for identical products or services inside the Benelux by a third party. The second is when an applicant, due to a close connection with a different entity, is aware of that other party's legitimate use beyond the Benelux, which ought to have occurred three years after the filing.[530]

According to the Joint Commentary, in these circumstances (bad faith) arises solely from the collection of information. One may wonder whether having knowledge of someone else's previous use of an identical or similar trademark in good faith might be considered as acting in bad faith. It is commonly observed that without additional clarification and legal precedent from the ECJ, the specific meaning of the word 'bad faith' in Community law remains uncertain. Simultaneously, there is a widespread assumption that the phrase must specifically pertain to actions that can be classified as inappropriate or with a small degree of defect. [531] The (CJEU) has affirmed this series of legal precedents, ruling that bad faith encompasses registering a trademark with the goal of "dilution, in an approach that is incompatible with honesty." [532]

To provide further clarification, an application submitted for a trademark that contradicts the prior rights of a different party, as explained in the preceding sections of this chapter, is typically not allowed and therefore, if these phrases are widely employed, is generally considered opposition able. However, ignoring another party's previous rights does not typically qualify as 'bad faith'. More actions or behaviors are needed to reach a level of reprehensibility that would be considered as constituting bad faith. The existing case law regarding Article 52 Regulation has consistently defined the term 'bad faith' in line with the discussion in this section. However, it is important to note that the case law emphasizes the seriousness of the behavior referred to by this term. Intersection with additional reasons for inadmissibility The preceding paragraph already hinted at an argument that has now been openly stated: if someone intentionally ignores or dismisses the reasons for unconstitutionality outlined in the BTIP, and their actions can be considered significantly blameworthy, it is probable that they both the particular cause for unconstitutionality in question and the reason of 'bad faith' can be used toward the relevant filing.

[527] *ibid, p200.*
[528] *ibid p200.*
[529] *Article (20) of the BTIP*
[530] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p200.*
[531] *ibid, p200*
[532] *Graeme B. Dinwoodie, Mark D. Janis, Research Handbook on Trademark Law Reform, Edward Elgar Publishing, 2021, p62*

For instance, a complaint is submitted for a trademark that clashes with a mark that expired within a two or three-year period before the filing, as mentioned in the BTIP.[533]. If a proposal is submitted with the awareness that it violates the rights of the opposing party, not only can the grounds specified in Article 2.4(c) or (d) be cited, but 'bad faith' can also be invoked. There is no basis for assuming a person to "specialist rule" is subordinate to the other; furthermore, it is unclear which standard would have been given priority in that scenario. The concept of contemporaneous relevance is undoubtedly logical. [534]

Both the United States and the European Union trademark laws explicitly forbid the submission of trademark applications made in bad faith.[535] To this point, both of them have legal protections that enable the legitimate proprietor of an existing trademark to contest a dishonest application for trademark or registration. Furthermore, both nations impose legal repercussions on individuals who submit trademark applications in bad faith, which may include opposition , cancellation, and violation procedures[536].

Under the Lanham Act, the laws of the USA prohibit the submission of requests for trademarks with malicious intent. The Lanham Act forbids the registering of marks that have a high probability of confusing with an existing brand, or that are knowingly exploited with malicious intent to wrongfully claim the favorable track record or goodwill associated with an already existing trademark. The Lanham Act also permits the annulment of trademarks that were acquired via deceit or misrepresentation. [537]

'Bad faith' behavior is also observed in the practices of the EU Member States. For instance, engaging in the act of making misleading or deceptive claims (which incorporates intentionally hiding information) when submitting a trademark application is occasionally observed.[538]
The (EUTMR) explicitly forbids the submission of trademark applications with malicious intent in the EU.[539] According to (EUTMR), bad faith is defined as a deliberate effort to unfairly exploit the unique characteristics or reputation of a previously registered trademark. It also encompasses scenarios when the person filing has not planned to utilize the trademark in association with the goods or services specified in the application for trademark registration.[540]

The EUGC upheld an earlier (EUIPO) decision, which considered Hasbro to have acted in bad faith.[541]Based on EU legislation, a trademark registration can be declared invalid [As] it can be shown that the trademark proprietor was acting "in bad faith" when filing the trademark application. [542]The party requesting the invalidation must meet the burden of proof to establish such a claim. However, our legislation does not define "bad faith," It is taken for granted that the applicant's good faith is assumed until proven otherwise. However, once this

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[533] *Article 2.4(c) or (d) of the BTIP*

[534] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, ibid, p201.*

[535] *Igor Demcak, 4 types of bad faith trademark applications that will be rejected, March 2023. https://www.tramatm.com/blog/category/legal/4-types-of-bad-faith-trademark-applications-that-will-be-rejected*

[536] *ibid*

[537]*Igor Demcak, 4 types of bad faith trademark applications that will be rejected, March 2023 ibid*

[538] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p201.*

[539] *Article 4 of the (EUTMR)*

[540] *ibid*

[541] *Hasbro v. EUIPO, Kreativni Dogadaji, Case T-663/19, EU: T:2021:211 (bad faith established on the basis that although refiling per se is not prohibited, doing so to intentionally bypass the use requirements undermines the very normative basis for s: ranting trade mark rights). Lionel Bently, Brad Sherman, Dev Gangjee, Phillip Johnson, Intellectual Property Law, Publisher Oxford University Press, 2022, p1035, note 320*

[542] *Justine Pila, Seville's EU Intellectual Property Law and Policy, Publisher, Edward Elgar Publishing, 2022, p456*

assumption is denied, the mark's proprietor can reasonably explain the objectives and commercial logic pursued by the application. Whether the applicant obtained an advantage or caused harm through the repeat filing is irrelevant to assessing bad faith. Although the (CJEU) has long stated that the assessment of bad faith "must be the subject of an overall assessment, considering all the factors relevant to the certain case," bad faith conditions were initially involved in cases of intentional registrations of 3P signs. The European Court and the EUIPO have recently shed some light on different factors or behaviors that may constitute bad faith.[543].

In the case of Koton[544], the court indicated that the notion of bad faith is broader than deliberate registrations of 3P signs for identical or similar goods; the lack of commercial logic underlying the application may suffice to establish lousy faith that the proprietor of an earlier mark that includes a very early stylized form of 'Koton' for Classes 2.

The EUIPO allowed the registration for services in Class, and the opponent sought the declaration of invalidity for bad faith. The EUIPO and the General Court rejected the application because there could be good faith with identity and similarity between the goods or services for which the marks were registered. [545]In the Skykick and Copernicus[546], the court decided that bad faith exists where trademarks are filed with no intention to use, but only if, at the time of application, there existed a dishonest intention of undermining the interests of third parties or an intention to obtain exclusive rights for purposes falling outside the functions of the trade mark[547]. In particular, the concept of bad faith covers abusive filing practices such as "priority traps" laid by trademark squatters. Registering a trademark intended to parody or even "annoy" another trademark holder may not constitute bad faith. In another case, the EU court demonstrated that registering a copyrighted work may constitute bad faith. [548]Furthermore, the court confirmed that repeat filing made to avoid the consequences entailed by the non-use of earlier marks might constitute a relevant factor capable of establishing bad faith on the part of the person who filed that mark.[549]

4. Good faith vs bad faith

The norm of good faith is not effectively enforced when applicable in China, thereby failing to adequately discourage dishonest actions. Certain trademark petitioners strategically pursue a large number of trademarks with the sole purpose of using the notice-and-take-down requirement on different online retailers engaging in racketeering activities against other market participants. However, the judicial system does not sanction certain dishonest conduct within the premise of good faith. These activities encompass the act of licensing a widely recognized foreign brand or the name of a famous person using the legal principle of first-to-file, or utilizing an advantageous market position to rapidly promote the use of previously trademarked goods belonging to other parties. Courts occasionally misapply specific judicial principles, such as the concurrent existence of trademark philosophy or market structure doctrine, when determining the risk of confusion in a case. They mistakenly give excessive importance to a competitor's market share during the litigation process. This diminishes the

[543] *Ibid, p456*
[544] *P Koton.C-104/18*
[545] *Justine Pila, Seville's EU Intellectual Property Law and Policy, ibid p456*
[546] *Skykick and T-82/14, Copernicus, the court decided that C-371/18*
[547] *ibid*
[548] *Cancellation n° 33843 Flower Thrower (EUIPO)*
[549] *T-663/19 Hasbro. Inc:*

level of trust during the process of applying for a trademark. The latter phenomenon is demonstrated in the case of Boss v. Bosssunwen.[550].

5. Bad faith matters in Jordan.

As for bad faith matters, for instance, section 38 of the JTML requires that an offense be committed for the acquisition of goods intended for sale bearing a trademark that achieves the following elements: the physical presented in existence of a trademark owned by others and registered according to the law and that the products bear a trademark that is considered an offense and are used illegally. Besides that, the law requires Science and Will. In this regard, Amman Court of Appeal (ACA) decided that since the first element and the second element are available to the defendant, the prosecution has not provided any evidence that the defendant knew that the products imported before him bear a false or copycat mark. Therefore, that element is not available to the complainant. With the loss of the flag, the defendant must be declared not to be responsible for the offense against him or her[551].

The Jordanian Court of Cassation (JCC) decided (JUCCSA)[552] Considered that any practice that might impair the reputation of the product, create confusion as to its external appearance, mislead the public or, if the acts were related to a trademark, would be unlawful competition in commercial matters[553]. Where it has been established that the defendant marketed and stored goods bearing the claimant's mark and name intentionally, the defendant has engaged in unlawful competition.[554]

The question raised in terms of bad faith is in used but not registered trademark. In this context, the Jordanian Court of Cassation (JCC) decided in Optim Neuterchen VS Optim Neuterchen Inc.[555] According to (JUCA)[556], the legislator has established as a necessary condition for the existence of Unfair competition for the trademark the fact that the trademark is used in the Hashemite Kingdom of Jordan regardless of whether it is registered or not and that it leads to public deception. Since the subject of unfair competition in this case relates to the tradition of a trademark, consideration must be given to the availability of the conditions for unlawful competition in respect of the trademark. Since the distinction was made against him, he imported foods bearing the same brand as Optim Neuterschen's products, but these foods bear a copycat mark and his work against him by importing foods bearing a copycat and unenacted mark to impose their presence and placing them on the market is considered to be an illegal act of competition.

Since the *World Sports Center* is the sole official agent and distributor of the ideal food brand (*Optim Neuterchen*) for food supplements in Jordan under the authority of the organizing company of the Clerk of Justice of the U.S. State of Illinois and registered in the register of commercial agents, it is the exclusive agent and distributor of the ideal food brand *Optim*

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[550] *Dan Prudhomme, Taolue Zhang, China's Intellectual Property Regime for Innovation: Risks to Business and National Development, Springer, 2019, p36.*

[551] *(ACA) decision No. 1291/2009 (triple body) 1/2/2009*

[552] *that Article II of the Jordanian UNFAIR Competition and Commercial Secrets Act No. [15] of 2000 (JUCCSA)*

[553] *Article II of the Jordanian UNFAIR Competition and Commercial Secrets Act No. [15] of 2000 (JUCCSA) in paragraphs [a, b]*

[554] *the Jordanian Court of Cassation (JCC) No. 3388/08 (Penta body) of 9 July 2009*

[555] *Optim Neuterchen VS Optim Neuterchen Inc. Jordanian Court of Cassation (JCC) decision No. 3539/2005 (Penta body) of 25 April 2006*

[556] *articles 2/a and 3/a of the Jordanian Unfair Competition Act (JUCA)*

Neuterchen Inc. for food supplements. Since the distinction against him had imported the products and placed them on the market before knowing that the characteristic was the sole official agent and distributor of the products of *Optim Neuterschen* before he had been notified of the distinction. Since he had been warned or notified that he had become the official and exclusive distributor of those products, the distinction had not been demonstrated that he had promoted branded goods produced by the ideal food company, Optim Neuterschen. That was confirmed by witness *Hussein Mohamed Asim*, who testified that after 2000 he had asked him to delete Optim ' s expression of the posters because another company had taken the agency and had no connection. Thus, the requirements of Article II, paragraph b, of the Unlawful Competition Act are not available after the privileged has ceased to raise or import the products after the date of 15 August 2001 on which he was notified of the notice and the plaintiff's claim is therefore lost in its legal enactment and must be returned[558].

JUCCSA considered that any practice that might impair the reputation of the product, create confusion as to its external appearance, mislead the public or, if the acts were related to a trademark, would be unlawful competition in commercial matters[559]. Where the defendant has been found to have marketed and stored goods bearing the claimant's mark and name, knowing that and intentionally, it has engaged in unlawful competition[560].

6. The extent of the impact on preexisting rights.

By assessing the prevalence of previous rights, it is possible to ascertain if the applicant is aware of these rights before their submission date, therefore determining their subjective state of mind. In general, the assessment regarding a trademark determined by administrative structures is primarily based on the recognition of well-known trademarks to ascertain the level of their fame. It is important to note that a disagreed trademark does not have to be famous to reach the same level of contribution as a well-known trademark. Instead, it must have an appropriate level of contribution within its specific sector or region. [561] This means that clients in the geographic area should associate the trademark with its corresponding goods. The greater the influence of the contested trademark, the higher the likelihood that the organizations involved are aware or would be aware of it, making it inclined to be considered "malicious."[562]

Considered an act of bad faith, the act of trying to take proprietorship of indications that somebody else has a stronger claim to is commonly known as trademark counterfeiting. This can occur when prosperous trademarks belonging to other individuals are registered in foreign countries to use them nationally in the future. Once the initial owner starts using the trademark locally, they can be coerced or threatened, and the registration of the trademark disregards the objectives of other third parties that have previously established rights or interests. The two specific forms of 'bad faith' outlined in Article 2.4(f)(10) and (20) belong to the final classification listed. Nevertheless, in a way that is not a genuine recourse to a trademark initiated before the relevant filing. Based on the vast legal precedent, it can potentially be inferred that this particular variation has been used in good faith before the

[558] *Jordanian Court of Cassation decision No. 3539/2005 (Penta body) of 25 April 2006*
[559] *Article II of the Unfair Competition and Commercial Secrets Act (JUCCSA) No. [15] of 2000 in paragraphs [a, b]*
[560] *Decision of the Jordanian Court of Cassation (JCC) No. 3388/08 (Five Body) of 9 July 2009*
[561] *Rui Su, On the Regulation of Bad Faith Trademark Registration International Journal of Education and Humanities, ISSN: 2770-6702 | Vol. 5, No. 3, 2022, p 194.*
[562] *ibid, p 194.*

formation of a registered trademark. [563]The act of registering the trademark with malicious intent will be denied. [564] An application for a trademark that is filed with deceptive intent to use it may nevertheless be authorized, even if it is done in bad faith. On the other hand, a person who has registered a trademark with malicious intent may be able to protect it from being invalidated. [565]
On top of that, registering a trademark in a country or territory without real aim to be utilized, just to prevent others from using the same or a similar trademark in that specific jurisdiction. When a party registers a trademark to obstruct a competitor from utilizing a comparable trademark, they are deviating from the trademark's intended function and instead employing it to impede fair competition in the business environment. Such activity might detrimentally impact the competitor's capacity to conduct business and confer unjust advantages to the entity that has registered the trademark.

Submitting a trademark application using inaccurate or deceptive information, such as falsely asserting prior usage or proprietorship of the trademark. Applications for trademark registration must present precise and authenticated data by trademark law. Submitting a trademark application with inaccurate or deceptive data is a deliberate and deceitful effort to deceive the trademark office and obtain unjust benefits in the registration processes. Such action has the potential to compromise the validity of the trademark process and undercut the values of fair competition.[566]

6.1 Trademark rejected applications upon bad faith.

Innocent applications can pose a serious issue in trademark registration because they can hinder legitimate competitors in the marketplace environment and may harm the credibility and goodwill of established trademarks. Trademark proprietors must comprehend the possibility of detrimental effects of trademark applications made in bad faith and be aware of legal measures that are in place to thwart such attempts.[567]

In this regard, applying for a trademark that is the same or very similar to an already existing trademark, with the purpose of confusing consumers. The primary objective of trademark law is to safeguard customers from any potential confusion or deceit in the market, while also guaranteeing that trademarks are utilized to identify and differentiate the origin of products and services. When a party deliberately registers a trademark that is similar to another to deceive consumers, they are contravening the fundamental tenets of trademark law and engaging in dishonest behavior.

Moreover, utilizing a trademark that is indistinguishable or perplexingly comparable to a preexisting trademark right, on the established trademark's repute and positive associations. Utilizing a trademark that is indistinguishable or perplexingly comparable to an already established trademark represents a malevolent application due to its deliberate and deceitful endeavor to profit from the reputation and positive image of the existing brand without proper authorization or consent. Deliberately employing a like trademark can also inflict harm upon the lawful proprietor of the preexisting trademark by diminishing its unique nature or compelling the proprietor to allocate time and resources towards safeguarding its rights in the

[563] *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p202.*
[564] *Chenguo Zhang, Balance, and Limitation of Intellectual Property Protection in China: The Latest Law Amendments and Judicial Development Under Micro-Comparative Perspectives and Limitation of Intellectual Property Protection, Springer Nature, 2022 p 199.*
[565] *Yuwen Li, Cheng Bian, China's Foreign Investment Legal Regime: Progress and Limitations, Routledge, 2022, p126*
[566] *Igor Demcak, 4 types of bad faith trademark applications that will be rejected, March 2023. https://www.tramatm.com/blog/category/legal/4-types-of-bad-faith-trademark-applications-that-will-be-rejected*
[567] *Ibid.*

brand. Engaging in this kind of conduct is regarded as unethical and may result in legal ramifications, such as being sued for trademark violations or infringement of intellectual property if the legitimate owner contests the use of a similar trademark.

7. Conclusion

Bad faith is a crucial concept in trademark law, where someone intentionally uses a competitor's brand or mark to deceive others. It can be used to show trademark infringement or dilution without showing bad faith or to intentionally violate the rights of a brand owner. To prevent trademark registration with bad intentions, there needs to be a universally accepted way to determine if someone is trying to harm the property. The time frame in which a person files for a trademark is also important. If the applicant knows about the benefits ahead of time and still goes through with the register, they are likely acting dishonestly.

(TMDir) states that bad faith is a reason for refusal, but registering agencies do not use this concept on their own. The Trademark Regulation (TRM) also allows Member States to use "bad faith" as a reason for refusing or throwing out an agreement. The BTA Directive added the ability to claim bad faith, but it is unclear what "bad faith" means in the Directive and Regulation.

It is generally prohibited to apply for a brand that goes against someone else's existing rights, but ignoring someone else's rights does not usually count as "bad faith." The BTIP and Regulation work together to set rules for determining the legality of trademark applications, but the idea of contemporaneous relevance remains important as it protects the right to a brand.

EU & US have rules against filing trademark applications made in bad faith. In the US, the Lanham Act prevents registration of marks that are likely to be confused with an existing brand or used maliciously to take advantage of the good reputation or track record of an existing trademark. Both the EU and the US have legal protections that allow the rightful owner of an existing trademark to fight a dishonest application for trademark or registration.

Bad faith behavior can be seen in the way EU Member States do business, such as making false or misleading promises when applying for a trademark. Article 4 of the EUTMR makes it clear that people cannot apply for trademarks in the EU with bad intentions, which is described as trying to unfairly take advantage of the unique qualities or reputation of a trademark that has already been registered. An earlier decision by the EUIPO was upheld by the EUGC, which said Hasbro had acted in bad faith.

The EU court has shown that filing the same mark more than once to avoid the effects of not using earlier marks could be a factor that can be used to prove bad faith on the part of the person who filed that mark. In a case heard by the Jordanian Court of Cassation (JCC), the World Sports Center was found to have brought in products and sold them without realizing it was the only official agent and distributor of the Ideal Food brand (Optim Neuterchen) for food supplements in Jordan.
Trademark counterfeiting occurs when someone tries to take ownership of signs that someone else has a better claim to. There are four main types of bad faith trademark applications including Applying for a trademark that looks too much like an existing trademark to trick people or using a trademark that looks too much like an existing trademark. Furthermore, one

of the common ways is registering a trademark in a country or territory that doesn't want it to be used, or sending in a trademark application with false or misleading information.

CHAPTER 9 Trademark Protection

There is no protection for a trademark unless it is registered in Jordan following the formal and substantive procedures and conditions required by law. In this context, the author will explain objective conditions besides the infringement mechanism as follows:

1. Trademark protection

1.1 Objective conditions

Objective conditions are those conditions that focus on the same trademark to be registered, i.e., that the trademark is a new distinction, legitimate and perceptible by consideration, and the trademark is intended to have its subjectivity to prevent customers from confusing products bearing a similar trademark[568]; A trademark normally used in trade to distinguish the types and varieties of goods unless it is especially highlighted and this special form becomes distinctive of the goods of that mark proprietor[569].

The number may not be registered as a trademark unless the number is specifically highlighted. For this reason, the mark is registered, The Jordanian Supreme Court of Justice ruled that "third parties shall not be prevented from using the same mark to distinguish another commodity that differs from it, since this does not give rise to confusion or confusion between the bearing goods of the same mark unless the goods are similar, and the proprietor of the mark may not invoke it except against competitors engaged in trade or industry of the same kind, since the purpose of the mark is to distinguish products and prevent confusion between them and similar products[570] ".

This decision would narrow the similarity criterion and give greater freedom to merchants using the same or another similar mark on other types of goods. In this context, the author concludes from that the criterion in protecting a registered trademark is the fraud and deception of the public by using a trademark identical or similar to the registered trademark, and there is no problem in identifying identical trademarks, but the problem lies in identifying similar trademarks.

The Jordanian Supreme Court of Justice outlined the criteria for similarity leading to public fraud, which are as follows: the criterion of the basic idea in the trademark, which must be distinctive, and the criterion that the main manifestations of the mark are considered and not their partial details, since the imitation that constitutes an infringement on a trademark is that which falls on the main part of the mark, not on its partial details, the criterion of the of goods bearing the mark, and the criterion of the possibility of confusion. between them and the other mark by looking or hearing its sin, and the criterion of not assuming that the consumer, when buying the gocK1s, examines its trademark carefully and compares it with the other.

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[568] *Abdullah A1-Khashrom, A1-Wajeez in Industrial and Commercial Property, 1st Edition, Dar Wael Publishing, 2005, p. 178*
[569] *Deborah E. Bouchoux, Intellectual Property: The Law of Trademarks, Copyrights, Patents, and Trade Secrets,ipid,p 22.*
[570] *Jordanian Supreme Court of Justice, decision No. 39/1988*

These standards aim to protect the consumer public, preventing them from becoming fraudulent[571]. If fraud is still suspected, there is no room for claiming similarity between trademarks.

As for legality, the trademark must be legitimate. The trademark is illegal if it violates a legal text, public order, or morals. The registrar of Trademarks may refuse to register the mark if its pronunciation contradicts morals and public morals. what may not be registered as a trademark due to the attachment of this mark to the official or religious capacity, its similarity with another trademark, or other reasons[572].

The Jordan trademark law specifies the cases in which the trademark may not include marks that resemble the King's emblem and the government's emblem and decorations or marks that indicate an official capacity.

1.2 Substantive conditions

The substantive conditions have been specifically specified, namely, the condition of capacity, the condition of novelty, and the condition of legality. Therefore, it is not permissible to impose other conditions for trademark registration, such as the requirement of writing the trademark, which is not considered mandatory but optional[573].

1.3 Formal conditions

In addition to the substantive conditions that must be met in the trademark to enjoy protection, formal conditions must be available in this mark. And formal conditions mean those procedures that follow the registration of the trademark, as they start from the date of submitting the registration application and end with the issuance of a registration certificate for the trademark,[574] If the trademark is registered, it enjoys internal protection from the date of submission of the application and gives priority to the applicant against any person using the same mark or a similar mark after the date of applying, as for the unregistered mark, its protection is limited according to the Trademark Law in those cases where the mark is famous.

But the assault on the unregistered trademark entitles its proprietor to protect it by filing an unfair competition lawsuit, as the unfair competition lawsuit applies to registered and unregistered trademarks, famous and non-famous, and the acts of unfair competition are material acts that can be proven by all means of proof, including Testimony of witnesses.

Completing the trademark registration process in the form stipulated in the law provides the trademark with two types of protection: civil protection and criminal protection. Furthermore, criminal protection revolves around the existence and non-existence of registration.

If registration is carried out, criminal protection is established. If there is no registration, there is no criminal protection, meaning that the assault on the registered trademark constitutes a crime punishable by law throughout its registration, but when is the trademark considered registered until the criminal protection prescribed by the law is established? It cannot be said that criminal protection begins from the date of submitting the registration application but begins with the completion of the registration process stipulated in the law[575];

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[571] *No. 108/65*
[572] *JTML Article 8*
[573] *JTML No. 33 of 1952on Article 22*
[574] *Samiha Qalyubi, Ibid, p. 164.*
[575] *Jordan Trademarks Law Article 38/1*

using a trademark registered under the law means that a trademark has met all the requirements contained in the law, and the matter does not apply to applications submitted for the registration of a trademark because these applications do not produce any legal effect for the applicant related to legal protection.

It should be noted that the criminal protection of the trademark lapses in two cases[576]: first, the trademark is the personal name or commercial address of others, as stipulated in Article 36 of the JTML. Second, invalidity of trademark registration when the trademark loses the condition of legality, novelty, or other formal and substantive conditions. The main point of this study is to find the connection between registrations and usage to the scope of the protection given to trademarks.

In this context, the margin of protection can be measured by the amount of trademark infringement. As much as the protection given to the trademark increases, the infringement will be less. From this point of view, trademark infringement on trademark rights needs to be examined, and then the applicable legislation needs to be examined. After that illustration, the tools used to stop these kinds of trademark infringement, whether by the court or other alternative solutions policies as the following:

2. Trademark Infringement

The trademark occupies an important and distinctive place between industrial and commercial property rights, so it has an additional value added to the value of the commercial shop. Perhaps the reason for this is due to the spread of the trademark and its close connection with trade and economy more than the rest of the other industrial and commercial property rights, as the increase in competition between merchants and the consumer's purchase depending on the quality of the product or service prompted merchants to use marks that distinguish their products and services from other similar products and services.

In this regard, the author will show the legal protection of the trademark and the forms of trademark infringement, including trademark forgery and imitation. The infringement on the trademark by imitating and counterfeiting it is a crime that requires the establishment of a civil and criminal lawsuit, as this attack harms both the producer, the consumer, and the state; it harms the product by losing the marketing of its products. It also offends the consumer because the illegal imitation of goods and services will reduce the quality of the original product or service. In some industries, such as pharmaceuticals, illegal counterfeiting may negatively affect patients' public health.

In addition, counterfeiting and counterfeiting Marks will weaken investment opportunities, especially foreign ones, in the country due to the role of the trademark in marketing local and international products and services and due to the importance of the trademark in commercial life.

Multiple forms of infringement have emerged, including piracy of the trademark, such as a merchant using an identical trademark or a similar mark belonging to others by placing it on his products or services without the permission of its proprietor or using this trademark to advertise his products or services, or falsely claiming to register a trademark, this at the local level. At the international level, some well-known marks may be used by non-proprietors to market their products or services through modern communication, especially Internet

[576] *Abdullah A1-Khashrom, , Ibid, p. 190.*

programs, which necessitated the provision of appropriate legal protection civilly and criminally, locally, and internationally. The trademark registration in the Kingdom is entitled to compensation in case of infringement[577].

This restriction remained required despite the issuance of the law amending the Jordanian Trademarks Law. The civil protection of the trademark is not limited to requesting compensation but also includes stopping the infringement.

However, the right to request compensation, which is usually associated with a request to stop the infringement, is considered the most important right of the trademark proprietor if another person infringes his trademark. and this right is determined under the general principles of civil liability granted every injured person the right to claim compensation as a result of being subjected to a harmful act[578].

Therefore, this right is related to trademark infringement and damage on the part of the trademark proprietor, whether the trademark is registered or not. The criminal protection of a trademark is linked to the registration of that infringed trademark. Therefore, the unregistered trademark does not Enjoy any criminal protection. This protection is focused on the same right to the trademark regardless of the value of the goods, goods, or services that the trademark is used to distinguish it, even if the trademark proprietor does not suffer damage due to the infringement of his trademark.

The criminal protection of the trademark is restricted in terms of time and place; in terms of time, there is no protection for the trademark except during the period of its registration, which is ten years, or in the stage of its renewal. Still, regarding location, the scope of protection is limited to the territory of the country where the trademark is registered, without prejudice to international conventions and treaties. There is no doubt that one of the main goals of the TRIPS agreement is to provide international protection for trademark rights[579]. A registered trademark grants the person concerned the right to file a criminal case demanding the punishment of the infringer and another legal case requiring the punishment of the infringer civil. Most often, the legal case is filed by subordination to the criminal case. There is no evidence suggesting that each case is filed independently. The criminal case differs from a civil lawsuit in several aspects.[580]

The criminal lawsuit may only be filed by the trademark proprietor or the person whose proprietorship has devolved, in addition to the public prosecution, which has the original jurisdiction in this lawsuit. The trademark or from others such as the merchant or even the ordinary consumer, and this is due to the nature of this lawsuit, as it aims to compensate the damage resulting from the harmful act, whether this damage is material or moral, on the other hand, it is required to file a criminal lawsuit that the trademark is registered. While this is not required to file a legal case and on a third party, the penalty in the criminal case is imprisonment for a specific period and a fine of a certain amount or one of them. Between them, the penalty in the legal case is the judgment on the person who infringed to compensate the injured and Appreciated by the trial court.[581]

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[577] *the Jordanian Trademarks Law of (1952) Article 34.*
[578] *the Jordanian Civil Code Article256*
[579] *Cross, F. B., & Miller, R. L. (2020). The Legal Environment of Business: Text and Cases (11th ed., p. 166). Boston,USA: Cengage Learning.*
[580] *McKeown. J, (2016), McKeown's Brand Management in Canadian Law Newsletter, Intellectual Property Newsletters, Brand MGT. NWS. 2016-04.*
[581] *(The distinction between civil and criminal responsibility). Dr. KhamisKhader, Journal of Law and Economics, Issue One and Two, Year 46, p. 30*

The various legislations did well when they protected the right to trademarks, as this contributes a lot to eliminating the most necessary means of deceiving the public and deceiving about the quality and source of what they want to buy from different goods and products, as long as the trademark is a means of informing the public of the truth of the source of those goods and products and their quality, as well as that contributes to the stability of economic and commercial security alike.

2.1 Trademark Infringement Patterns

The Jordanian law defines the crimes that pertain to trademark rights, drawing clear limits of criminal protection for trademarks through Jordanian Trademarks Law[582]. As well as through the Jordanian Merchandise Marks Law[583], and these articles included acts that constitute an infringement of the trademark right and the penalty prescribed for the perpetrator of such infringement or attempted to commit, assisted, or offered to him. In light of that, trademark infringement in Jordanian law takes several forms.

The main form of infringement is that Jordanian law prohibits using a mark similar to a famous trademark even if it is not registered in Jordan, which means the famous mark is protected from use even before it is registered in Jordan. In this context, if the trademark is well-known, even if it is not registered, then the proprietor has the right to request the competent Jordanian court to prevent others from using it on similar or non-similar products or services,[584] provided that the use of this mark indicates a link between those products or services and the famous mark and the possibility that the interests of the proprietor of this mark will be harmed as a result of this use and is assumed the likelihood of confusion if a famous mark is used on similar products. (c) Protection from infringement of the well-known trademark. Suppose the renowned trademark is registered in Jordan. In that case, it enjoys all forms of protection.

However, is it permissible to claim compensation for infringement of a well-known trademark in Jordan if it is not registered? Jordanian law deprives the proprietor of the famous mark of claiming compensation for the infringement of his mark inside Jordan if it is not registered[585].

No one shall be entitled to file a claim for damages for any infringement of a trademark not registered in the Kingdom. However, he is entitled to apply to the registrar for the invalidation of a trademark registered in the Kingdom by a person who does not own it after it was registered abroad if the reasons he claims are the reasons mentioned in paragraphs 6, 7, and 10 and 12 of Article (8) of this Law.

The Jordanian legislator decided to protect the trademark under some conditions and limitations. In this regard, the trademark must be explicitly registered to a temporal and spatial scope. Also, it set special restrictions focused on the same trademark. The author will shed light on the most common infringement patterns on trademark rights, including Forgery or imitation of the trademark and False use of registered trademarks[587].

[582] *Article 38 of the Jordanian Trademarks Law No. 33 of 1952 and amended Law No. 34 of 1999*
[583] *Article 3 of the Jordanian Merchandise Marks Law No. 19 of 1953,*
[584] *Article 25, JTML*
[585] *Article 33 Of JTML*
[587] *Article (38/b) JTML*

2.1.1 Forgery or imitation of the trademark.

JTML and Jordan Goods Marks Law regulated the provisions for the crime of counterfeiting a trademark[588]. The legislator has focused on forgery and imitation. The question arises: Do counterfeiting and imitation differ, or do they have the same meaning?

At first, glance, whoever reads these two terms can see a difference in meaning; the author finds that these terms lead to the exact meaning despite some legal commentators believing that forgery is conducted only through the literal transfer of the trademark in complete and identical transfer.

In contrast, imitation is undertaken through the transfer accompanied by interpretation or modification, leading to the similarity between the two marks[589]. In this regard, the Jordanian legislator has gone to non-discrimination Between the forgery of the trademark and its imitation and has made them two images of the material element of the crime.

These two images are two sides of one crime, which is the forgery of the trademark, and the position of the Jordanian legislator on this issue is apparent in the text of Article (5) of the JTML and through this text, it is clear to us that the acts on which the material element of the crime of counterfeiting a trademark is divided into two pans: The first is to create a trademark identical to the original mark, and the second is to find changes to an original trademark that already exists.

The material element of this crime is the act of forgery, which is achieved by fabricating a mark that is entirely identical to the original mark or transferring the principal parts thereof so that the forged mark approaches the original mark, as a person promises that he has forged a trademark if he manufactures that trademark or any mark close to it in a way that leads to deception and without the consent of its proprietor, or if he forges any actual trademark, whether by changing it. Adding to it, distorting it, or otherwise.[590]

It is noted that for this act of forgery to constitute a material element in the crime of forgery of the mark, two things must be available; the first is that it is carried out in a way that leads to the deception and deception of others, and thus its inability to distinguish between the goods bearing the forged or counterfeit mark, and the goods bearing the original mark, Second: that it is carried out without the consent of the proprietor of the mark, but if the act does not lead to the deception of others, and was done with the permission of the proprietor of the mark, it does not constitute forgery, and then it is not considered an assault.

The burden of proving the consent of the proprietor of the mark lies on the accused and it is not considered an assault., and in all cases, acts of forgery or imitation of the mark used must occur on the same class of goods for which the trademark is registered. The moral element is the crime of counterfeiting or imitating a trademark with the intention of fraud, as this crime must have the intention to defraud the perpetrator, as forgery is not punishable unless it is carried out in bad faith.

The adoption of a mark that is similar in its entirety to the original mark of the product, which may lead to misleading the public or deceiving it into thinking that it is the original mark, which is different from the crime of counterfeiting trademarks, which is the transfer of the registered mark literally and entirely so that it appears identical to the original mark.

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[588] *Article 5 JTML,*
[589] *https://jordan-lawyer.com/2022/03/20/*
[590] *Abdullah A1-Khashrom, previous reference, p. 222.*

In this regard, the offense is infringing on a trademark (imitation of a trademark) registered in violation of the provisions of the law and imitating it in a way that leads to misleading the public in violation of JTML [591].

2.1.2 Trademark imitation

In terms of forgery and counterfeiting, the legislator did not require prior knowledge from the defendant that the trademark carried by the goods imitates the trademark owned by the complainant, exempted the complainant from the burden of proving the bad faith of the offender if it is demonstrated through the seized samples and through the experience report that the defendant imitated the trademark. Based on the law, the seized goods must be confiscated and duly destroyed, provided the destruction expenses are on the defendant[592].

2.1.3 False use of the trademark.

The False use of the trademark has been regulated under trademark law of the Trademarks Law[593] and Jordan trade Marks Law, which stipulated (that whoever uses the goods in a void use of a trademark or a mark close to another mark in a way that leads to deception shall be punished by imprisonment for one year or a fine of one hundred dinars or both of these penalties)[594] and the use in this crime is intended to simply put the counterfeit or counterfeit mark on the commodity in a way that leads to deceiving or misleading the public Article (6) of the Jordan Goods Marks Law that there is no difference between the way or manner in which the trademark is used, and that the user has been done by copying, engraving, printing or in any other form.

Suppose the invalid use of the registered trademark is considered a crime punishable by law and leads to the establishment of the material element of it but concerning the moral aspect of this crime. In that case, it is necessary to have criminal intent, that is, the will of the person to use a registered trademark is void and that this mark is imitated or forged, and that its use in this way leads to cheating and deceiving the public[595]

Suppose it concludes that this crime is one of the intentional crimes committed with the intention of fraud. In that case, the person can prove his good faith by proving that he is unaware of others' trademark proprietorship**.**

2.1.4 Misdemeanor of using the trademark without permission

The misdemeanor of trademark use without the trademark proprietor's permission violates the Law[596]. Besides that, the Jordanian legislator dealt with the Misdemeanor of tampering with the information contained in the statement card, deceiving the consumer through misleading advertising of products violating the Standards and Metrology Law[597]which governs the trademark's illegal use[598].

2.1.5 Selling or offering counterfeit forged trademark goods.

Selling, displaying, or acquiring goods bearing a counterfeit trademark is to take a mark that is similar in its entirety to the original mark of the product, which may lead to misleading or deceiving the public by making them believe that it is the original mark [599] The legislator

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[591] *Article 37/1/A of the JTML*
[592] *Jordan Trademarks Law 38/4 Article*
[593] *trademark law article (38/1 lb)*
[594] *Article (3) of the jordan Goods Marks Law*
[595] *Muhammad Hassan Abbas, Ibid, p. 255.*
[596] *JTML Article 37/1/b*
[597] *Article 36/A/8 of the Standards and Metrology Jordan Law*
[598] *the provisions of Article 36/A/10 of the Jordanian Standards and Metrology Law*
[599] *Jordan the Trademark Law Article 37/2 of and Jordan Cybercrime Law.Article 15*

has requested, in the realization of the occurrence of this crime. This material element is selling goods bearing a counterfeit trademark through any means.

The legislator did not require prior knowledge from the defendant that the trademark carried by the goods is imitating the original trademark. In this regard, Jordanian court rules according to the Code of Criminal Procedure[600] to the defendant of the crime of selling goods bearing a counterfeit trademark in violation of the Law[601]. The Jordanian court can take the maximum limit according to its convictions in assessing the appropriate penalty through different mechanisms, for instance, Jordan Trademarks Law[602].

although it amended most of the provisions of the Trademarks Law of 1952 in line with hermonisation Jordan's legeslations to the WTO, however, the formintioned law has kept the requirment the registration of the trademark in the Kingdom for the possibility of claiming[603].

On top of that, the Jordan Unfair Competition and Trade Secrets Law has been considered an unfair competition related to a trademark used in Jordan, whether registered or unregistered,[604] as long as it leads to misleading the public. In addition, the Civil Code gives a person who has infringed his trademark the right to claim compensation following the general principles of civil liability[605].

Furthermore, to claim compensation for infringement of a registered or unregistered trademark, an unfair competition lawsuit. Must be filed, and this first requires that the victim be a trademark within the meaning of the law by completing a set of substantive conditions (if the trademark is unregistered) and completing the substantive conditions and formal conditions together (if the trademark is registered only).

Based on an unfair competition lawsuit, the elements of civil liability must be established in particular: Act, damage, and causation. The act is trademark infringement by using the same or similar mark by another merchant without the trademark proprietor's permission or attempting to use the mark in advertising and marketing his products.

As for the damage, it must be sure that it has or will inevitably occur. The damage may be material to the merchant in his financial disclosure or moral damage to his reputation and the reputation of his products. Moral damage is always achieved as soon as the incident of assault on a trademark occurs through the reluctance of people to deal with products carried by his trademark, and this leads to a decrease in the merchant's sales and loss. There must be a causal relationship between the trademark infringement act and the damage by the offender against his mark.

Fourth: Several crimes may occur on the trademark, including the crime of counterfeiting or imitating the trademark, acquiring goods to sell, selling goods, or offering goods bearing a forged or counterfeit mark for sale, and the crime of false use of the trademark.

3. Scope of protection of the trademark temporally and spatially.

The protection of the trademark is limited to the period of proprietorship, which is ten years from the date of its registration. However, the mark's registration may be renewed from time to time following the provisions of the law. The registered trademark proprietor can renew his mark for ten years from the expiry of the first registration period or the end date of

[600] *Article 178 of the Jordan Code of Criminal Procedure.*
[601] *JTML Article 37/2.*
[602] *Ibid*
[603] *JTML article (34)*
[604] *The Jordan Unfair Competition and Trade Secrets Law No. 15 of 2000.*
[605] *The Jordanian Civil Code, Article 256.*

the last registration. Suppose the proprietor of the trademark does not renew it. In that case, the registrar may delete it, and then its legal protection will be eliminated.

Regarding the geographic location, the scope of criminal protection is limited to the state's territory where the trademark is registered, without prejudice to international conventions and treaties. Therefore, there is no protection for a trademark registered in Jordan and being violated outside Jordan, nor protection for a trademark registered outside Jordan and infringed on in Jordan unless it is protected by an international treaty to which Jordan is regulated.[608]

In this context, the Madrid Convention provided international protection for trademarks in the countries of the Union as long as that trademark was registered in its country of origin[609]. The registered mark was deposited with the International Bureau for the protection of industrial Property. However, JTML has criminalized anyone who guides, participates, or assists, while in Jordan, in arranging the commission of an act outside Jordan, which is considered a crime under this law punishable as an actor. For the crime, proceedings shall be taken against him, and he shall be sentenced and convicted in the Kingdom as if the crime had been committed therein.

3.1 The Impact of TRIPS on Trademark Protection in Jordan

In the existing business environment, producers try to distinguish their commodity from other producers' products to discourage and restrict illegal competition practitioners' efforts. Thus, there is a need to merge to have trademarks. Trademark refers to the producer turning to put a word, name, mark, drawing, symbol, or design to refer to the products or services belonging to the trademark proprietor due to having the right of manufacturing, producing, trading, or selling these goods.[652]

In this regard, the question arises as wether why has the trademark received significant attention from legislators in all countries. Why do laws consider trademarks to be valuable assets? For example, France enacted the Trademark Law in 1857, and Britain passed the Trademark Law of 1875.

The Ottoman Empire enacted the Trademark Law in 1879, which became valid in Jordan until the government enacted this law after the independence in 1952[653]. Intellectual property (IP) laws have deemed a balance between interested parties to meet their primary goals through appropriate procedures and grant the proprietor the right to apply a monopoly by using a particular item for a specific period. It also provides legal protection for the creators of original work. That covers three well-defined sets of rights, which are copyrights, trademarks, and patents

3.2 Protection under the Paris Convention

The Paris Convention does not regulate the conditions for the filing and registering marks, as the local law in each contracting country defines these conditions. As a result, no application filed by a national of a contracting State for the registration of a mark may be

[608] *Zain Al-Din, Salah, Branding in Jordanian Law, Journal of Law (Kuwait) m (33), Issue (4), 2009., p. 13..*
[609] *Article (2) of the Madrid Convention Concerning the International Registration of Marks of 1891*
[652] *.Lessig, Lawrence. The Future of Ideas: The Fate of the Commons in a Connected World. Vintage Books, 2002.p.22.*
[653] *The Jordanian Trademarks Law No. 33 of1952).*

refused or its registration invalidated on the ground that such mark has not been filed, registered, or renewed in the country of origin[678].

The registration of a mark in one of the contracting states is not linked to the possibility of registering it in any other country, including the country of origin. Consequently, the invalidation or cancellation of the registration of a mark in one contracting state shall not affect its registration's validity in all other contracting states[679].

Furthermore, suppose a mark is validly registered in the country of origin. In that case, the application for filing and protection in its original form must be accepted in the other contracting states. However, registration may be refused in specific cases, especially if the mark violates the acquired rights of others, lacks a distinctive feature, is contrary to moral principles or public order, or is liable to mislead the public[680].

To this point, using a registered mark is compulsory in any contracting state. In that case, the registration may not be canceled for non-use of the mark except after the lapse of a reasonable period, provided that the mark's proprietor cannot justify non-using his mark[681]. The Convention has also indicated that each contracting state shall refuse to register the mark and prevent the use thereof if it is liable to confuse because it is a reproduction, imitation, or translation of another mark used in identical and similar goods that the competent authorities of that state consider known in it and about a person entitled to benefit from the benefits of the Convention.

Moreover, each contracting state shall also refuse to register marks of or unauthorizedly incorporate the emblems, symbols, and official signs of the contracting states and shall prevent their use, provided that the International Bureau of WIPO has been notified of them. The same provisions apply to some intergovernmental organizations' emblems, flags, other signs, abbreviations, and designations.

The registration may not be canceled in any country where the registered mark is compulsory Except after the lapse of a reasonable period and if the person concerned did not justify the reasons that led to its suspension[682]. The use of the industrial or commercial trademark by the proprietor in a manner different from the form with which it was registered in one of the United States does not result in the invalidity of the registration or the reduction of the protection granted to the mark when the difference is in elements that do not affect the distinctive character of the mark.

The simultaneous use of the same mark on identical or similar products by industrial or commercial establishments considered partners in the proprietorship of the mark following the provisions of the national law of the country in which protection is sought does not prevent the registration of the mark or diminish in any way the protection granted to that mark in any country.

A country of the union provided that such use does not lead to misleading the public and does not conflict with the public interest. The countries that signed the agreement must undertake, on their own, if their legislation permits this, or at the request of the person

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[678] *Summary of the Paris Convention for the Protection of Industrial Property (of 1883), https://www.wipo.int/treaties/ar/ip/paris/summary_paris.html*

[679] *ibid*

[680] *ibid*

[681] *ibid*

[682] *Paris convention to protect industrial property of March 20, 1883, amended at Brussels on December 14, 1900 Washington on June 2, 1911, The Hague on November 6, 1925, London on June 2, 1934, Lisbon on October 31, 1958, Stockholm on July 14, 1967 Revised on October 2, 1*

concerned, to refuse or invalidate the registration of any trademark similar to a well-known registered trademark that was copied, imitated, or translated.

Under article 6/2, the author notes that main difference presents in distinction of a famous mark from an ordinary one that it is not registered, unlike an ordinary trademark that it can be registered in a country other than the one in which it was registered.

In this regard, it was noticed that the Paris Convention prohibited copying, imitation, copying, or translating a trademark in a manner that would create confusion for the consumer, mainly if a well-known trademark primarily uses these products. One can understand the case of preventing or refusing to register from text no (1). Article 6 of the agreement gave five years to enter the registration for the marks that were copied, imitated, or translated if their registration was in good faith.

However, if their registration needed to be in good faith, the Paris Convention allowed their application at any time. To this point, the TRIPS Agreement differs from the Paris Convention in several ways. For instance, it did not regulate one type of intellectual property branch. Instead, it dealt with most intellectual property branches[684]; both *TRIPS Agreement & and Paris Convention* kept the same obligations of member states without eliminating them. Furthermore, the Paris Convention did not identify well-known trademarks.

In contrast, the ordinary trademark was determined according to the TRIPS trademark agreement as a group of marks distinguishing goods and services produced by one institution from another. Accordingly, the TRIPS Agreement has added a new mark, which is the service mark. The author believes that trademarks have received much attention due to the rapid and tremendous development of industry and commerce.

To this point, there are companies whose budgets exceed entire countries, indicating that the trademark became essential as a commercial service. For instance, Royal Jordanian, Zain, and Hilton are valuable and crucial trademarks in Jordan.[685] To this point, article 16/1 of the TRIPS agreement sheds light on a state of confusion when a trademark is used by someone who does not have the right to use it. That occurs through imitation and conformity to the original mark.[686]

3.3 Trademark Protection under Applicable National Law

Some national legislation found some defects, and Jordan was no exception. These defects might be considered a threat to trademark protection. For this reason, international legislation was enacted due to inconsistency between the national texts governing the same trademark, which subjected it to adequate protection in one country and deprived it of it in another.

Enacting several international agreements, such as the Paris Convention and TRIPS agreements, have set a red line for the protection of the trademark, which national legislation cannot violate. The international agreements that address the issues related to trademark protection, such as TRIPS, were concluded due to the development of the global economy. This agreement stemmed from (the WTO) on April 15, 1994. the Hashemite Kingdom of

[684] *Feenstra, R.C., Inklaar, R., Timmer, M.P., 2015. The next generation of the penn world table. Am. Econ. Rev. 105 (10), 3150–3182.*
[685] *Abdul Rahman, Muhammad Alyan, Protection of Trademarks and Trade Data in Egyptian Law and the TRIPS Agreement, 1st Edition, Cairo, Al-Israa Press.p88.*
[686] *See Article 16/1 of the TRIPS Agreement.*

Jordan has approved the TRIPS since it joined the (WTO) in 2000[687]. Based on the provisions of the Paris Convention, many basic rules govern a trademark.

3.3.1 Trademark protection under Jordan laws

The trademark theories are essential, considering that they are the rationale for such a system and on which most of the trademark laws have been developed. It concentrates on trademark proprietor rights and the extent of such proper protection. As modified, the relevant JTML, " JUCTMSL defines the trademark and determines the legal protection provided for such trademark. In evaluating the arrangements of the claimed Laws, several issues and notes should be discussed and investigated in two main areas. In this regard, the above matters will be covered in two main subjects: one will analyze the Unfair Competitors Law, and the second will discuss the Trademark Law.

3.3.1.1 Protection under Jordan's Unfair Competitors Principles [688]

The declared JUCTMSL law is formulated of 11 Articles[689]. The first three Articles focus on unfair competition and the stakeholder's right to claim compensation for any harm induced to him based on illegal commercial practices. They, moreover, handle the lawful procedures that should be followed in this regard[690].

For more explanation, post 2 of the declared Law offers unreasonable competition practices, where Para 1/a/2 states: "The activities that may occur by nature cause confusion with ... products ...". Para 2 of Article 2 states: "Incorrect assumptions in practicing the trade, triggering deprivation of trust from ... or products". Para 3 of Post 2 attends to presumptions that use in commerce may "deceive the public." Para 4 of Article 2 suggests the practices that decrease the product's reputation or trigger confusion. b) the same article indicates unfair practices related to the trademark, whether registered or not, that might delude the public[691].

Moreover, such behavior is believed to present unfair competitors. Para (c) of the same article suggests that the provisions included in paragraphs of article 2 will operate to the services as applicable. Article 2 of the explained Law mentions instances of practices of unfair competition. The Jordanian legislator considers that any act contrary to reasonable practices in commercial affairs is a practice of unfair competition that allows any interested litigant hurt to take legitimate treatments.[692].

Thus, methods of proof are exhaustive and subject to the Jordan Evidence Law and other legal and financial rules. The question emerges: what is the standard utilized to determine the character of fair practices in economic and industrial affairs?

On which foundation are unreasonable practices defined? Has the Jordanian lawmaker made plenty of room to keep Article 2 of the claimed Law in line with the fast advancement in the investment and the trading world? Has he pointed out examples and prevented restrictions concerning unreasonable financial or industrial practices and let every case to its circumstances determine if it is a fair or unjust practice?

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[687] *Peter, K. Yu. "The objectives and principles of the TRIPS agreement." The Regulation of Services and Intellectual Property. Routledge, 2017.pp 255-322.*

[688] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. master thesis, non-published, Middle East University May 2021,p67-80*

[689] *JUCTMSL Jordan Unfair Competitors and Trade Secret Law No. 15 of 2000*

[690] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. master thesis ibid,p67-80*

[691] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. master thesis Ibid,p67-80*

[692] *Ibid,p67-80*

The staying Articles of the suggested law deal with the legitimate procedures that should be observed by anyone affected by any practice of unfair competitors and how he can get reasonable compensation for the damage triggered to him. Post 3 of the same Law states that "every interested participator might claim payment for the damage triggered to him due to unfair competitors." The Jordanian lawmaker considers that unfair competitors' practices consist of trademarks[693].

Any act that misinforms the general public or produces confusion with the institution of a competitor is little competition. This situation suggests that the Jordanian lawmaker allows any interested party to carry a suit to claim settlement for the damage triggered to him due to unjust competitors.

The public deserves to bring a settlement action if it has possibly been deceived due to an incorrect trademark. Upon the preceding, it is noticed that the pointed out law provides actual protection to the general public, the proprietor, and the competitor, respectively, so that they prevent confusion, untrue accusations, or any practices that might deceive them. Suppose he deals with any practice of unfair competition that causes damage to him. In that case, it is also seen that any individual of public society may be interested.**[694]**

Further, a competitor trader might think about any claim for settlement for any damage triggered to him due to unreasonable competitors. It is an initial note since it will be shown that such articles oppose other posts of Jordanian laws on the shield of trademarks. This paper argues that the phrasing of articles of the declared law proves the financial investment and asserts the nature of the trademark, where the practices of unfair competitors are the practices that contradict fair practices in commercial field. Simply put, the trademark is considered part of commercial affairs.[695]. It is recognized that the provisions of the mentioned law are worded to serve the interest of the proprietor /competitor and consumers and not to offer protection for the trademark itself.[696].

In this context, the scientist argues that the Jordan legislator has already dealt explicitly with unfair practices in industrial and trading affairs, as previously described. It has been thought that any action related to the trademark is a reasonable practice in financial and industrial affairs and that any practice opposite to the same is unfair competition. It indicates that the protection is concentrated on the stability of all matters associated with commercial and trading affairs and the maintenance of justice among gamers in this domain[697].

The Jordanian legislator has specifically mentioned the rivals and the general public. The Jordanian legislator has already considered the proprietor and competitor as one party.[698].Moreover, the actual shield is provided to the parties that play an essential function in forming and continuing all industrial and commercial affairs.

A trading or a financial world without traders/proprietors and a client audience is not imagined. The proper protection given to any injured person under this law as a result of any practice of little competition is civil protection. It suggests that an injured person should submit a civil action for compensation regarding the damage caused to him due to such practices.

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[693] *Ibid,p67-80*
[694] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. ibid,p67-80*
[695] *Ibid,p67-80*
[696] *Ibid,p67-80*
[697] *Ibid, 2021,p67-80*
[698] *Ibid, 2021,p67-80*

For this reason, the problem of evidence lies with the plaintiff that he ought to show that the offender has worked out a course of unfair competition and that such practice has certainly triggered damage to the complainant requiers financial settlement. The value of damage requires technical knowledge. All matters pointed out above undergo proof and established legal and financial proceedings.

Thus, the Jordanian Trademark Law does not protect the trademark itself. Instead, a judicial shield is given to unfair financial and commercial practices. The trademark is in this category; it belongs to industrial and commercial practices, proving the trademark's financial investment nature[699]..

Even more, the stated law does not determine the character of the trademark spastically. The declared law aims to protect fair trading and industrial practices from infringement. Though the said law protects the practices associated with the trademark, as mentioned previously, the primary issue is still unsolved, even under the pointed-out direction, where the nature of the trademark is not concluded. The protection is approved for the rights of consumers/proprietors and the client audience damaged by unfair competition[700].

3.1.1.2 Protection under Jordan Trademark Law

The relevant JTML provisions ought to be discussed to recognize whether they deal with the nature of the trademark. After evaluating the requirements of the pointed-out law, it was noted that the trademark is specified in Article 2. Such a meaning resembles the descriptions of many of the trademark rules in other states[701].

. The explained rule did not indicate the essence of the trademark, and it incorrectly explained the shape of the trademark. However, it describes its nature, the trademark proprietor's right to such, and how much functionality and rights are offered protection. In this context, article 2 of the same Law states, "trademark: any visible indication used or planned to be utilized by anyone to differentiate his items, services or products from others." It suggests that the goal of using the trademark is commercial, which stresses the trademark's financial nature[702].

The main functionality is the distinction. In other words, the trader/proprietor should utilize visible marks to identify his products, items, or services from others. It is an investment feature and aims to prove the nature of the trademark's financial investment. The seeable mark can not be imagined by an individual who owns services, products, or goods and desires to classify them from others. In addition, this capability is a right to whoever means or uses it to identify his products or services. The law protects such rights, as explained later on.

In this regard, article 7 of the demonstrated Law offers for registerable trademarks, needing that such trademark has a different pattern that can be identified by a vision to attain the main feature of a trademark, i.e., distinction. Article 8 indicates the trademarks that can not be registered as trademarks, and this proof shows the dilution theory. Para 12 of Post 8 of the declared Law, as changed in 1999, discusses the "Dilution Theory" and protection of the famous trademark right.

Under Para (b) of Post 25 of the declared law, well-known trademarks are protected even if not enrolled in the Kingdom. Suppose it causes or may cause injury to a famous trademark holder. In that case, such protection prolongs the use of a trademark quite similar to a well-known trademark worrying about different products or items. The

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[699] *Maisa'a Mahmoud Al-Fayyad ,The Legal Nature of Trade Mark . master thesis , non published, Middle East University May, 2021,p67-80*

[700] *ibid,p67-80*

[701] *Ibid ,p67-80*

[702] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. master thesis, non-published, Middle East University May 2021,p67-80*

potential damage is prevented under the article, which offers that "and the possible harm to the rate of interest of such trademark holder due to such use."

The question that arises to her is, What was the shield given to the trademark? The protection is offered to the well-known trademark proprietor and not to the trademark proprietor of any, perhaps even if it is enrolled in the Kingdom. An examination of the articles of the suggested law reveals that the Jordanian lawmaker does not specify the character of the trademark itself[703].

In contrast, the law concentrates on the mission of the trademark and the proprietor's rights. The Jordanian lawmaker embraces this theory. In Para 10 of Post 8, the law averts a trademark's registration that is very much the same as any other trademark previously enrolled for the same items for which the new trademark will be registered. It assures that the shield approved right here is for the proprietor's right and function of a trademark, i.e., distinction, which only serves the trademark proprietor's interest. It confirms the confusion between the nature of the proprietor and the trademark's right, where both are regarded as the same thing. Such confusion has already appeared due to concentration on the character of the trademark holder's right to the, where such right has possibly been explained. Its nature and range have probably been identified to specify the degree of proper legal protection for such a right. It could be mentioned that the protection offered to a trademark function has undoubtedly been provided at first to the proprietor's right to utilize the trademark to differentiate his products/services from those of others. In answer to the debate that trademark law protects the customers' rights by avoiding any confusion, registration, or usage of any similar trademark for identical items/services, it could be claimed that trademark law has protected the rights of the proprietor but indirectly. Utilizing the same trademark for quite similar goods leads to harm to the trademark proprietor's interest, which is an event of confusion. If such confusion happens, only the proprietor can start a criminal or civil suit against this violation following the appropriate Jordanian Trademark law, where such rights do not consist of the customers.

Simply put, such protection is granted to the trademark proprietor's rights, not to the consumers or the trademark itself. On the other hand, the Unfair Competitors Law enables any interested person, including the customers, to bring a lawsuit for any damage triggered by unjust competitors[704]. According to Post 3 of the Jordan Unfair Competitors, every stakeholder has the legal right to claim compensation for the damage caused to the stakeholder due to unfair competition.

Under Para (B) of Article 2, practice is considered little competition if such guidelines associated with a used trademark, whether enrolled or not, misinform the public. It confirms the right of the customer public to submit an action for settlement for any damage caused to them due to any practice of unjust competitors.

Yet, the JTML indicates that "No individual might submit a payment action for any violation on any trademark that is not enrolled in the Kingdom. However, such a person may submit a demand for termination of a trademark that has been enrolled by a person who does not hold it after being enrolled outside Jordan if the premises on which he depends are those discussed in Paragraphs 6, 7, 10, and 12 of article 8 of this Law".[705] According to the "Lex specialis derogat lege basic "rule, it is detected that Post 33 of the Trademark Law limits Article 3 and Paragraph 2 of Article 2 thereof. The question is, under the Unfair Competition Law and in connection with the arrangements of the Trademark Law, does the client audience have the right to bring a compensation action for any damage triggered to them based on any practice of little competition worrying a trademark not registered in the Kingdom? The author

[703] *Ibid,p67-80*
[704] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark, ibid, 2021,p67-80*
[705] *article 8 of JTML*

argues that the response is Yes. The basis for such action is the Unfair Competitors and the Trademark Law.

Nevertheless, such right is limited to Trademark Law, where Post 38 indicates that "when filing the civil or criminal action or while such action is being heard, the proprietor of an enrolled trademark in the Kingdom may request the court to do the following, provided that his demand is accompanied by a bank or cash guarantee acceptable to the Jordanian court ..." [706].

The remaining paragraphs of the explained article provide the procedures the trademark proprietor might take according to the requirements discussed in the article. It implies that such a right is expressly provided to the trademark holder. It needs to be addressed that the trademark proprietor is provided criminal and civil proper protection according to article 37 of the suggested Law, where the Jordanian lawmaker thinks about the infringement on any enrolled trademark guilty, and that the trademark holder can bring either a civil action or a criminal action, or both if his trademark is infringed. This study argues that the proper protection provided under the JTML is just offered for the trademark holder rights and not for the trademark per se, as the trademark is not lawfully illustrated in a manner that explains the legal character, stakeholders, and other elements.

Additionally, the legal character of the trademark is not recognized or examined in the mentioned law. The JTML confounds the trademark's character with the trademark's capability, as shown in the law[707]. The right holder is the foundation of proper protection under the law. It is also noted that all articles of the claimed law concerning using the trademark are based upon the proprietor's right and not on the nature of the trademark itself. Simply put, the proprietor's right to grant legitimate protection for the same trademark is warranted. This right is the reason for the variance in the facility and validation of the entire trademark system.

For this reason, a monopoly will undoubtedly happen when proper legal protection is widely given. The concern is whether an unregistered trademark enjoys any legitimate adequate protection under the relevant laws.[708] Para B of Article 25 of the JTML offers that "if the trademark is famous and even if not registered, proprietor of such trademark might request the Jordanian court to avoid others from use it on any very similar service or products, provided use of such trademark shows a significance between such service or products and the famous trademark or that interest of the holder of such trademark may incur injury due to such usage." It demonstrates that the only legal and proper financial protection provided to unregistered trademarks is supplied to the well-known trademark whose appeal overextends the state where it is enrolled. It means unregistered trademarks do not relish any legal and financial protection unless they are famous. The Jordanian legislator embraces the dilution theory, where proper legal protection involves using a well-known unregistered trademark.

Furthermore, it demonstrates that the dilution hypothesis is the application of monopoly. It is noticed that the Jordanian lawmaker has likely expanded. They protect well-known trademarks, whether enrolled or unregistered, which results in a trust. [709] The confusion between the legal character of the trademark and the nature of the holder and considering them something possesses driven the Jordanian lawmaker in the JTML to offer a judicial shield to the trademark holder's right and not to the trademark itself. The legal character of the trademark has probably not been dealt with by the laws that have already handled the trademark. Though the Jordan Unfair Competitors Law grants judicial shield to the rights of customers/ proprietors and consumer audience and considers them players in

[706] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. ibid,p67-80*
[707] *The Jordan Trademark Article 2.*
[708] *Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. ibid, 2021,p67-80*
[709] *ibid,p67-80*

the financial market worrying financial and commercial affairs and considers all matters connected to the trademark to be consisted of, it does not like the Trademark Law, recognizes nature of trademark and examines the foundation of giving protection to the trademark holder as discussed previously.

Further, the JTML expands the proper legal protection approved to the trademark proprietor's right. It expressly adopts the dilution hypothesis quite similar to other laws on trademarks, resulting in a monopoly. The nature of the proprietor's right is the grounds and the justification for the current trademark system, which will undeniably result in monopoly and drawbacks in the pointed-out system. The option is to recognize the nature of the trademark and adopt such nature as a foundation for the trademark system. Such nature is the premise for the legal shield that should be provided under the laws on trademarks. The proprietor's and customers' rights and the consumer audience must be treated equally.[710] Trademarks had enjoyed wide applications before the Jordanian judiciary, the widest of which was in the field of higher justice lawsuits related to the appeal of the various trademark registrar's decisions regarding opposition s to trademark registration and numbering lawsuit matters. It falls within the scope of the jurisdiction of the Jordanian Supreme Court of Justice and among the forms of civil trademark protection: the right of opposition and promotion.

3.1.1.2.1 Object the trademark registration

After announcing the application and the initial approval of registration, the law guarantees the proprietor of the registered trademark the right to submit an opposition against any mark published in the Official Gazette within three months, based on the Trademarks Law. The right of opposition is guaranteed to the proprietors of registered or used trademarks or any consumer public who may believe that the accepted mark is identical or misleadingly similar to the source of the goods or services or another previously invented or registered trademark.

3.1.1.2.2 Trademark Registered Cancelation

The Jordanian legislator has ensured trademark proprietors. Their innovators file a lawsuit for the promotion, invalidation, or cancellation of a registered trademark - after it is too late an opposition period - within five years from the date of registration of the mark whose registration arose from unfair competition or was registered without justification[711]. The trademark application shall be submitted to the Registrar of Trademark. After submitting it, the registrar may refer the matter to the Jordanian Supreme Court of Justice for consideration. In the course of presenting the regulations, the Jordanian Supreme Court of Justice decided that if the proprietor of the mark - the defendant against him - failed to submit a response statement, he would be responsible for his registered mark, as this provision is specific and is not considered to have abandoned the cases of opposition that are submitted to the application for registration of the trademark[712]. It does not apply to requests to cancel the registration of a registered trademark submitted, as is apparent[713]. From the text and the wisdom behind it, the lettering is tantamount to the expropriation of proprietorship. To verify the validity of the claim of the applicant of the lettering, it is necessary to prove that the proprietor of the mark is not entitled to this proprietorship and delete it from the register with firm evidence that is not subject to doubt, unlike the opposition request that claims. Therefore, the Jordanian court decided to cancel the removal of his mark from the register,

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[710] *Ibid ,p67-80*

[711] *Baker Menwer Abdelharahman Al- Saaideh, Legal Protection of Famous Trade Marks in the Jordanian Legislation and International Agreements, 2017؛ 2017, Supplement 3, Issue 4, 44 Dr. Studies, Sharia and Law Sciences, MG44 ،p 347.*

[712] *JTML articles 11-14*

[713] *JTML Article 25.*

and if the registrar did not find it necessary to rule that the evidence provided by the applicant for the promotion to delete the mark from the register was sufficient to prove the proprietorship of that mark or sufficient to prove the ineligibility the proprietor of this mark may not be entitled to the application.

It is worth noting that the Jordanian legislator has prohibited the filing of a civil lawsuit from demanding compensation for an infringement of a trademark that is not registered in the Hashemite Kingdom of Jordan, where the legislator stipulates that "No one has the right to file a claim for damages for any infringement of a trademark that is not registered in the Hashemite Kingdom of Jordan.[714]"

Therefore, the principle is that a trademark only acquires civil protection if registered in the Kingdom, except after Jordan joined the World Trade Organization WTO. In 1994, Jordan was required to abide by all the agreements of the WTO, in particular the TRIPS Agreement. Since Article 34 of the Trademarks Law contains TRIPS, it is not included in the two Jordanian trade agreements. It came in violation of the text of its article No. (45) that "the proprietor of the trademark has the right to claim compensation as a result of the infringement he suffered from the use or imitation of the trademark even if this person was not registered with the trademark, and he has the right to request fair and appropriate compensation for the damage incurred. [715]

Therefore, there is an exception concerning the civil protection of the unregistered trademark. This exception is limited to the well-known trademark, as it gained civil protection even if it was not registered in the Kingdom. In this regard, "if the mark is not registered, its proprietor has the right to request that the trademark be well-known. The competent Jordanian court prevents others from using it on similar products or services.[716].

Alternatively, not identical, provided that the use of this mark indicates a link between those products or services and the well-known mark, the possibility that the interests of the proprietor of this mark may be harmed as a result of this use, and the possibility of confusion arises in the case of using an identical well-known trademark on similar products. The author finds that the Jordanian legislator has given the right to every interested party to claim compensation for the damage incurred as a result of any unfair competition, whether trademark registered or unregistered, that leads to misleading the public and has been infringed upon, its proprietor can claim appropriate compensation as a result of unfair competition.

Thus, compensation can be claimed in the event of an infringement on a trademark Used in the Kingdom, regardless of whether it is registered or unregistered, whenever such use leads to misleading the public based on the Jordanian Unfair Competition Law and Trade Secrets[717]

The connection between criminal trademark protection and the civil protection of the trademark is similar to that of the civil protection of the trademark.

The increase in trademark infringement prompted countries to enact laws prohibiting infringement and punishment for counterfeiting or imitating it. The Jordanian legislator drew the limits of criminal protection of trademarks in the Trademarks Law, as the trademark must be registered in the Hashemite Kingdom of Jordan.

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[714] *JTML Article 34 .*

[715] *Baker Menwer Abdelharahman Al- Saaideh, Legal Protection of Famous Trade Marks in the Jordanian Legislation and International Agreements, 2017، 2017, Supplement 3, Issue 4, 44 Dr. Studies, Sharia and Law Sciences, MG44 ،p 349.*

[716] *JTML No. 34 of 1999 article26, Paragraph B.*

[717] *Jordanian Unfair Competition Law and Trade Secrets No. 15 of 2000*

Therefore, the criminal protection of the trademark is linked to the registration of the trademark, as the unregistered trademark does not enjoy any criminal protection. In addition, the scope of the criminal protection of the trademark relates to the right to the mark only without regard to the registered goods or merchandise under it. It is also not required that the assault on the registered mark result in damage to its proprietor because the criminal lawsuit requires only the occurrence of the act of assault and the criminal intent. Hence, the damage is necessary for a civil lawsuit without the criminal intent.

Regarding the protection of the trademark in terms of place and time, there is no protection for the trademark except during the period of its registration (10 years) or in the stage of its renewal. As for the place, the trademark protection is limited to the territory of the country where this mark was registered without prejudice to the agreements and international treaties. It should also be noted that the criminal protection of a trademark gives its proprietor the right to file a personal rights claim.

The position of the Jordanian legislator on this matter can be seen by referring to the Trademarks Law, as it stipulated the imposition of a criminal penalty that may reach one year, or a fine that may reach three thousand dinars, or both penalties imposed on anyone who commits with intent to deceive the security of the acts he attempts, aids, or abets to execute the following subsequent actions including.

Counterfeiting, imitating a trademark. Or using a trademark owned by others without rights. Beside that, Selling goods bearing a forged or imitated trademark, offering them for sale, or acquiring them with the intent of selling them. The legislator did not neglect to add criminal protection to the trademark, which is evident from the text of the article.[719]. Accordingly, the author will briefly explain the crimes against the trademark mentioned in the Jordanian Trademarks Law, which is the applicable special law.

The crimes are counterfeiting a trademark or completely imitating the mark. By forgery, what is meant is the transfer of the actual mark without alteration. At the same time, imitation makes a similar mark to the exact mark. It resembles it in its general form, so it may mislead the consumer into thinking it is the original mark. Of course, for this crime to occur, the forgery or imitation of the registered trademark must lead to deception and deception of the public, even if the occurrence of this is a possibility.

3.3 Protection trademark under EU law

The basic treaties EU law represents the primary source of the legislation core in the European Union. Such legislative laws based on basic treaties are considered secondary EU law[720]. Trademark rights are known in the EU Charter of Fundamental Rights[721]. For IP, the primary regulators are found in the directives and regulations. [722] (EUTMR)[723] and (EUTMD) govern the Trademarks in the EU by guiding the legislators in the Member States to prepare uniform legislative rules[724]. The motivation behind this is access protection to the internal market and access to a unitary EU trademark. In this regard, all member states are subject to the same regulation[725]. The only way to obtain an EU trademark is by

[719] *The Jordanian Merchandise Marks Law No. 19 of 1953, article 257, and the Jordanian Penal Code, Article 3..*
[720] *Hoffrichter, Pinja. "Bad faith and evergreening in EU trademark law." (2022).P.18*
[721] *Article 17/2 of the EU Charter of Fundamental Rights.*
[722] *Kur, Annette & Dreier, Thomas: European Intellectual Property Law: text, cases and materials. Cheltenham, UK: Edward Elgar Publishing, 2019. (Kur, Dreier 2019) p. 49.*
[723] *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 trademarks*
[724] *Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark*
[725] *The purpose of directives in general is set forth in the Treaty on the Functioning of the European Union Article 114*

registration[726]. The stakeholder should fill out an application for registration to become the mark's proprietor within the EU region unless the stakeholder finds an earlier trademark[727]. The EU trademark regulation indicated that the proprietor of the EU trademark could prevent others from using a similar or identical mark in business related to services or goods in the EU[728]. It is an exclusive right to the registered parties. Officially, the proprietor's right was not a condition to use during registration. In this respect, The EU Intellectual Property Office (EUIPO) gives the proprietor the monopoly right in the EU territory for ten years. It can be renewed every ten years at the proprietor's request. Answering the Danish Supreme Court in terms of the concept of bad faith in the Malaysia Dairy case about Article 4(4)(g) of EU Trademark law and whether it is a concept that should be given the same interpretation all over the EU or whether it is a term for a legal criterion that is used according to the domestic law principles of members. [729] The CJEU has embraced the principle of determining the concept of bad faith and confirmed that lousy faith had become an autonomous term of the EU code, which must be given a comprehensive interpretation in the multiple devices of the EU trademark code[730]. In the previous case, the Danish court reaffirmed the significance of thoroughly applying EU directives law by harmonizing legal terms in directives. The verdict shows that the legal terms in the European Trade Mark Directive and the European Trade Mark Regulation should be interpreted similarly. Finally, The CJEU directed all organ states in the EU to comply verbatim with the EU statutes, regardless of whether such a statute is compulsory or optional[731].

4. Resolving trademark infringement

When it comes to infringement, it assumes the protection was enough. In this regard, the way to eliminate the infringement would be by the judiciary or alternative solution as the following;

4.1 Judiciary solution

in a judiciary solution, the court uses its authority to eliminate infringements on trademark rights. In this regard, the court uses its authority, whether by personal jurisdiction or in rem jurisdiction

4.1.1 EU Jurisdiction

As for the jurisdiction in the EU, it is interesting because the EU consists of several countries and simultaneously shapes one geographical political block. According to the international jurisdiction rules, article 202 declared that based on international agreements and EU legislation, the EU court could have those laws or agreements to practice international jurisdiction according to protective and provisional measures, taking in mind that another EU court may also have such authority to exert temporary defensive actions to protect interests found within the jurisdiction of the subject court which have an appropriate link with the court territory to achieve the procedures carried out in another country without prejudice to practical rules of EU [732]." The EU court can practice actions over personal,

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[726] *Article 6 EUTMR: Means whereby an EU trade mark is obtained. An EU trade mark shall be obtained by registration.*
[727] *Kur, Annette, Not Prior in Time, But Superior in Right: How Trade mark Registrations Can be Affected by Third Party Interests in a Sign (Kur, May 24, 2013). IIC - International Review of Intellectual Property and Competition Law, 2013 Vol. 44, Issue 7, pp 790-814, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 13-10,: https://ssrn.com/abstract=2253888 (Kur 2013)*
[728] *The EU trademark regulation indicated in Article 9*
[729] *EUTMR Art. 52*
[730] *Case C-320/12, Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter og Varemærker, MALAYSIAN DAIRY, para 21*
[731] *Schnepper EB, 'Dairy in Denmark: Bad Faith and Compliance with the European Interpretation' (2014) 9 Journal of Intellectual Property Law and Practice 11 (Schnepper EB 2014) p. 11–13*
[732] *European Law Institute, unidroit, eli-unidroit model european,rules of civil procedure From Transnational Principles to European Rules of Civil Procedure, Oxford University Press,1st edition, 2021,p237.*

intellectual, or real property in rem jurisdiction. In this sense, jurisdiction is still based upon global territoriality. For that purpose, it has been expected that the national court would practice jurisdiction in particular scenarios. For instance, the national court would have jurisdiction over illegal behavior in its region, individuals, and property within its boundaries. Besides, it can practice the power outside the geographical borders if the action conducted outside its boundaries impacts its region. [733] In actual practice, it is expected to infringe on global trademark-related legal rights[734]. The jurisdiction is limited to persons or property. As for subject matter jurisdiction, the EU court must hear the claim brought before it. As for personal Jurisdiction, the EU court must hold authority over the parties outside the EU court state. Moreover, as for the in rem jurisdiction, the court must have the power over the contested property, which often lies outside the court boundaries of the state[735].

4.1.1.1 Personal EU jurisdiction

Over the years, "personal jurisdiction" strongly originated in territoriality criteria. Countries could only exercise power over other bodies within their borders as independent states. In this context, typical "personal jurisdiction manages state geographical boundaries besides international litigation, national boundaries, and territorial restrictions on state tribunal power over the foreign party supposed to live or reside in a foreign land.[736]. A core principle is that the state court must have jurisdiction over a conflict to hold a practical and applicable verdict. Suppose the court cannot support its proper jurisdiction. In that case, any judgment will be in jeopardy of mere nullity and unable to force such individuals to abide by the court decisions or practice the court any power over their property[737]. In this regard, a court of law must initially have personal jurisdiction to hear the particular claim.

Furthermore, the tribunal must have authority over the entailed parties or the contested property. In this regard, Individuals undergo "personal jurisdiction" while the property undergoes "rem jurisdiction. The plaintiff cannot obtain a judgment in favor of Personal Jurisdiction over the trademark if the court fails to exercise individual authority over a foreign citizen or non-resident defendant. On the other hand, if an individual or firm does not have adequate minimum relations with a state, the court can practice the subject to individual jurisdiction. Therefore, if a company operates solely in Jordan, it can not safeguard itself in Belgium[739].

Figuring out when a tribunal tries to conjure up "jurisdiction" over an individual who does not have legal residence has constantly been more complicated. In this context, given that jurisdiction is always readily found in a defendant's country area of residence, a complainant might often choose to submit the claim to the defendant state. Nonetheless, legal and practical worries typically push complainants to offer a lawsuit in their country[740].

4.1.1.2 In Rem jurisdiction

Courthouses tend to believe that any case within a territorial border suffices to claim jurisdiction or apply local legislation. Based on the belief that since the local application of a legal system is ideal, using that same rule worldwide is likewise appropriate. Besides personal jurisdiction, rem jurisdiction can be crucial in resolving contested trademarks. [747]

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[733] *Michael Xun Liu, Jurisdictional Limits of in rem Proceedings Against domain Names,:,p470.*
[734] *Deborah E. Bouchoux, A Practical Introduction to Paralegal Studies: Strategies for Success, Publisher Wolters Kluwer Law & Business, newyork, 3RD Edetion, 2021,p101.*
[735] *Anselmo Reyes, Wilson Lui, Direct Jurisdiction: Asian Perspectives, Publisher Bloomsbury Publishing, 1st edition,2021 P73*
[736] *Howard M. Erichson Inside Civil Procedure: What Matters and Why? Publisher Wolters Kluwer, new York, 3rd edition 2018, p603.*
[737] *Michael Xun Liu, Jurisdictional Limits of in rem Proceedings Against domain Names, ibid, p469.*
[739] *Deborah E. Bouchoux, A Practical Introduction to Paralegal Studies: Strategies for Success ,p101.*
[740] *ira s. Nathenson ,showdown at the domain name corral: property rights and personal jurisdiction over squatters, poachers and other parasites ibid.*
[747] *Peer Zumbansen, The Many Lives of Transnational Law: Critical Engagements with Jessup's Bold Proposal, ,p242.*

On top of that, in rem jurisdiction, a complainant can initiate legal action over property possession in the courts where the property lies, whether it is physical or intellectual property. To this point, the challenges of jurisdiction must be taken into consideration. For instance, intellectual property legal rights are subject to the court's sole jurisdiction where the property lies. This is only sometimes where the particular court's jurisdiction can prevent other countries' tribunals from exerting jurisdiction over the same case. Because there are no unique stipulations for global jurisdiction on any issue related to intellectual property conflict, all the problems concerning intellectual property are exempt from the particular jurisdiction Of any solitary court of any other country, even though the legitimacy of registered trademark rights undergoes sole jurisdiction in other foreign legal procedures such as "Brussels Regulation A24 (4) of Eus.[748]

4.1.2 Jordan jurisdiction

The Jordanian Supreme Court of Justice JSCJ has judgments concerning trademarks. Evaluating these judgments reveals that the Court has possibly safeguarded worldwide famous trademarks in cases of trademark registrations comparable to unregistered global trademarks,

4.1.2.1 Protecting Unregistered Trademark

The Jordanian Court has decided that since the registered trademark resembles a trademark owned by a boycotted company, registering the same or a similar trademark at the Ministry of Trade and Industry is, therefore, contrary to Article 8/6 of the Jordanian Trademark Law, which prohibits registering trademarks that are contrary to public order and morality or leads to the deception of the public.[749]

4.1.2.2 confusion

The Jordanian Court has stated that Article 8/10 prohibits the registration of a trademark that resembles a trademark owned by another person, which might lead to deception. Since the factors affecting the decision are the general concept of the trademark, the general appearance, classes of goods, and the purchasers of such goods, and since there are similarities between the trademark owned by the applicant and the trademark to be registered by the appellee in the general appearance, and in the classes of goods (cosmetics), and since such registration leads to deceiving and misleading the public, the Registrar shall thus accept the opposition submitted by the appellant and decide not to proceed with the registration formalities following the law.[750] Regarding using the trademark, the Jordanian Court recently determined that the trademark user who ended up being distinct from their items deserves to cancel the registered trademark in another person's name[751]. If the user proves that there is a similarity between the two trademarks, which may misinform the public, and if using the first trademark foregoes, i.e., the date of registering the trademark based on revocation, and if the trademark subject to cancellation has recently not been registered for more than five years [752]Appropriately, given that the appellant owns a registration of the same trademark

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[748] *Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, 2017, 15th edition, p397. (Convention on jurisdiction and the enforcement of judgments in civil and commercial matters): This Convention shall apply in civil and commercial matters whatever the nature of the court or tribunal. Also provided Exclusive jurisdiction of a Member State court, regardless of the residence of the parties in which the trademarks deposit or registration has been applied for has taken place.*
en place.
n place.
[749] *Case No. 93/95 the latest judicial trademark decisions of the jordanian high court of justice Arab Law Quarterly, Vol. 12, No. 3, September 1997,p 338*
[750] *Case No. 27/95*
[751] *Case No. 306/95,*
[752] *Articles 34 and 25/5 of the Jordanian Trademarks Law No. (33) for the year 1952.*

abroad and has recently used it before registering the trademark subject to cancellation in the name of the appellee, and as long as the appellant has used his trademark in Jordan through exporting products bearing the said trademark up until his trademark ended up being well-known, and given that the two trademarks are identical in letters, look, and pronunciation, and are utilized for the same items, considering that such similarity may Confuse and misguide the general public, and since the trademark topic to cancellation has undoubtedly not been registered for more than five years, the determination of the Registrar to dismiss the trademark was subject to cancellation from the records in the name of the appellee is, for that reason, under the law[753] . In another case, the Jordanian Court decided that the similarity that may lead to public deceit is that of the whole trademark, not only one of its components. The Jordanian Court also stated that, in addition to the name, several elements differentiate between a trademark and another, such as its pronunciation, spelling, and design. Accordingly, the differences between the opposed trademark and the trademark owned by the appellant based on pronunciation and obvious differences in designs led to reject the opposition against the trademark registration as submitted by the appellant according to the provisions of the law. [754] Furthermore, The Jordanian Court decided that the spread of international trade (and the variety of its scopes and purposes) does not prevent protection of the rights that result from registering or using a particular trademark. The spread of international trade does not permit infringing upon others' rights.

The Jordanian Court also declared that the possibility of confusion between two trademarks by looking at them or hearing their appellations is enough to determine their similarity. For that reason, it is not permitted to register a later trademark since the trademark law is legislated for those who do not examine the trademark, not for those who do discuss it. Accordingly, the Registrar's decision to reject the trademark registration in the appellant's name due to its similarity to another registered trademark (which will lead to public deceit) is following the law. Jordan's High Court of Justice has rejected an appeal from LACOSTE requesting cancellation of the trademark "Crocodile and device[755]., LACOSTE filed a lawsuit to rescind the decision issued by the Registrar of Trademarks, rejecting the company's opposition to registering the trademark "Crocodile and device" in class 17 for use on nylon bags[756]. The plaintiff claimed it was representative of the French company, "La Chemise Lacoste," which owns the trademark "LACOSTE with crocodile device.

The grounds for the appeal can be summarised as the Registrar of Trademarks has made a wrong decision that there was no similarity (that could deceive the public) between the trademark to be registered and that of "LACOSTE." Furthermore, the Trademarks Registrar made an error in deciding that the application for registration was not contrary to the Trademarks Law[757]. Besides that, The Registrar of Trademarks has made mistakes in all factual and legal matters. The plaintiff thus requested that the appealed decision be repealed and that the defendant be liable for official fees, court expenses, and lawyers' charges.

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[753] *Case NO 306/9S, the latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997,p 338p 339*

[754] *the latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997,p 338 P340*

[755] *Case No. 9/95 the latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997,p P340*

[756] *on 12 March 1996*

[757] *provisions of Article 8, paragraph 6 of the Trademarks Law*

Marks that are contrary to public order or morality or which lead to deceiving the public), and alternatively, marks that encourage unfair trading competition or contain false indications of their origin. or Marks consist of figures, characters, or words commonly used in trade to distinguish or describe kinds of goods or their classes, or the type or class of goods shall not be registered as trademarks[758].

Alternatively, words whose ordinary signification is geographical or a surname, unless having a distinctive character, as provided for in paragraphs 2 and 3 of Article (7). 10. A mark identical to one belonging to a different proprietor which has already been entered in the register in the same goods or class of goods for which the mark is intended to be registered, or closely resembling the trademark to the extent that it may lead to deceiving third parties. Since the Jordanian court found no similarity in the design of the trademark in its essential feature that would lead to public deception, as well as no similarity in pronunciation) writing or use of goods) and since the Jordanian court does not grant protection except for trademarks registered in the same class of goods as per[759]

Table No. (2)

statistical data on the sample holding copied trademarks. Actions by the organization were taken against those samples [760]

Number of samples	Year	No.
299	2019	1
276	2020	2
296	2021	3

Department and the quantity of each item for the year (2019):[786]

Table No. (3)

Unit	Quantity	Number of cases of violation	item	No.
Pair	234759	12	Shoes	1
Piece	229094	14	Clothes	2
Item	878	3	Watches	3
cruise	2522	2	Tobacco and accessories	4
dozen	4490768	29	Personal Care Products	5
Ball	4200	1	Football	6
Bottle	2190494	21	Perfume	7

5.Conclusion

Historically, British private law prioritized remedies over rights, with statutes being vaguely phrased and mostly constructed in administrative terminology. Rights were derived from customary and moral ideas, rather than being restricted by governmental borders. German and US trademark conflicts doctrine exemplify the historical development of common and civil law. Trademark and unfair competition legislation in the United States, under common law, is centered around the protection of benevolence, regarding political

[758] *Article 8 (paragraphs 6, 7, and 10) Jordan trade mark law*

[759] *the latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997, P341*

[760] *The Jordan Customs Department, statistical data on the sample holding copied trademarks. Actions by the organization were taken against those samples, non-published statements from 2019-2021. personal meetings with The Jordan Customs Department, June 2022.*

[786] *Article 7 of the JTML .*

boundaries. Nevertheless, there are notable distinctions in the protection of marks across German, European, and US doctrine. These distinctions encompass the recognition of trademarks as property, the division of protection of rights and conduct prohibition within the legal framework, and the inclusion of public interest considerations in unfair competition doctrine. In the United States, the safeguarding of trademarks and prohibition of unfair competition is primarily focused on preserving the value of goodwill, which is strongly linked to the growth of the marketplace. Consumer protection, on the other hand, is considered of lesser importance.

Traditionally, English private law has prioritized the expansion of writs instead of individual rights. Regulations have been designed in a way that gives judges broad discretion and are often expressed as commands. The conceptual underpinning of rights can be traced back to customs and moral concepts that are not explicitly linked to political borers. German and US trademark conflict doctrines exemplify the historical development of common law and civil law, respectively.

In the context of US common law, the oversight of trademarks and unfair competition has consistently focused on the protection of benevolence, regardless of the borders of politics. Nevertheless, there exist distinctions among German, European, and US doctrines. In German and European law, the notion of trademark-as-property protection is still being used. This involves a clear demarcation between protecting the rights associated with trademarks and preventing certain behaviors related to trademarks. The origins of unfair competition law can be traced back to its genesis in tort law, where the emphasis was mostly on protecting the rights of individuals with less consideration for consumer protection.

In the United States, both the safeguarding of trademarks and the suppression of unfair competition are based on the principle of protecting goodwill, which is directly linked to the expansion of markets. Safety for customers has consistently been a significant priority, however, there is a noticeable tendency towards appeasement. The lex loci protectionism rule in trademark conflicts law has recently been diluted to accommodate contemporary communication and marketplace realities.

To redefine conflict doctrine for the 21st century, it is necessary to get around many dichotomies. In European doctrine, the separation between trademark protection and unfair competition prevention has raised concerns, especially due to the concept of privileges conferred by the state as well as the growing emphasis on the profitability of intellectual property rights. This has resulted in a clear division within the area.[787]

Obtaining compensation for abuse requires understanding the importance of trademark proprietorship in the Hashemite Kingdom of Jordan. Furthermore, It is crucial to identify the rightful proprietor of the trademark and the extent of a monopoly given by JTML and relevant legal provisions over it.

Despite trademark being a fundamental requirement for establishing proprietorship, the Trademarks Law has indicated that the legal use of a registered trademark is exclusively reserved for its proprietor, who possesses the authority to prohibit others from utilizing identical marks." The author asserts that the ability to prohibit others from using identical or similar marks on similar products is restricted to the registered mark.

[787] *Tim W. Dornis, Trademark and Unfair Competition Conflicts Historical-Comparative, Doctrinal, and Economic Perspectives ,Cambridge University Press, 2017 pp. 6 - 75*

When it comes to infringement, individuals who possess an unregistered trademark do not have the right to do so. According to the law, individuals are not permitted to seek compensation for any violation of an unregistered trademark within the Kingdom.

Chapter 10 Compensation Due to the Trademark Usage and Registration Violating

Everyone whose trademark-related rights are violated is entitled to claim compensation, and that is based on the general rules of liability in civil law. He is entitled to compensation for violating commercial laws and committing illegitimate works that cause financial and moral damages.[788] The legislator acknowledged the right to claim compensation if the trademark-related rights are violated and the trademark proprietor incurs damages. Consumers who incur damages due to forging or copying a trademark are entitled to file a lawsuit and claim compensation for the damages.

The same applies to the business people and agents who sell commodities and services and incur damages.

Such damages are attributed to violating trademark-related rights, including financial or moral damages. Thus, the basis for making compensation claims is represented in the act of violating trademark-related rights. The stakeholder who suffered damage due to infringement over a trademark involving illegitimate competition is entitled to file a lawsuit claiming compensation for the damages.

The ones who do the damage shall be committed to giving compensation. The author sheds light on this issue through two sections:[789] Moreover, famous trademarks that are non-registered and used will be given the right to civil protection only, and therefore, the criminal protection provisions will not apply according to the provisions of the Unlawful Competition Law, and that does not achieve a general deterrent. Since the majority of trademarks that are world-renowned on an international scale are not registered in Jordan

1. Trademark Infringing Compensation

According to the Jordanian Civil Code, "Any harm to others obliges the doer, even if he is not distinguished, to guarantee the harm."[790] Under this article, civil protection is established for all rights based on the general rules of liability in civil law, as everyone who has been assaulted has the right to claim compensation for material and moral damage incurred by him. Therefore, anyone who has been attacked on his trademark can claim compensation based on this subject. (791)

In addition, the attack on a trademark by imitation, forgery, or by using it without the consent of its proprietor constitutes a flagrant attack on the trademark law and an act of unfair competition. The way to meet this goal is considered unfair competition. Everyone who has suffered harm has the right to claim compensation for every material and moral damage resulting from unfair competition.[792]

Thus, the trademark is supposed to be protected under civil law from three sides:

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[788] *Bassam Abed Alrahman Tbaishat. Legal protection of trademark in the light of the Jordanian and Egyptian laws and interactional agreements. AlamAlkotobalhadith le nasherwatawzee'. Jordan, 2009, p. 235*

[789] *Wilf, Steven. "Who authors trademarks." Cardozo Arts & Ent. LJ 17 (1999): 1. P1*

[790] *Article No. (256) of the Jordanian Civil Code (26)*

[791] *Upadhye, Shashank. "Trademark Surveys: Identifying the Relevant Universe of Confused Consumers." Fordham Intell. Prop. Media & Ent. LJ 8 (1997): 549.p556*

[792] *Article No. (267) of the Jordanian Civil Code.*

1. Concerning the Trademark Law, which prohibits all forms of trademark infringement and piracy and provides the infringer of his trademark the right to claim compensation and stop the violation of his trademark[793]

2. From the Point of view of the UCL, the Incident of Infringement of a Trademark constitutes an act of unfair competition.

3. From the point of view of the general rules of civil liability, the infringement of a trademark causes damage to merchants that requires compensation.

Accordingly, the author discusses the legal basis for the right to compensation in the Trademarks Law, the Unfair Competition Law, Trade Secrets, and the Jordanian Civil Law in three demands:

1.1 Compensation under the Jordan Trademark Law

Jordanian Trademark Law[794] regulates the subject of the right to claim compensation for infringement of a trademark [(795)]. This article suggests that the trademark be registered in the Kingdom to claim compensation in case of infringement. This text was Criticized by commercial jurisprudence for its requirement to register a trademark in the Kingdom to claim compensation for infringement because compensation is linked to the occurrence and verification of damage, which is left to the judiciary to determine. The compensation is unrelated to the trademark registration procedures that the JTML requires. *Salah Zain Al-Din* justifies the Jordanian legislator's requirement to register the trademark in Jordan for the possibility of claiming compensation in case of infringement to the legislator's desire to encourage trademark proprietors to register them with the Ministry of Industry and Trade to identify them. However, this justification- from the author's perspective- is not valid.

A sufficient reason for violating the provisions of the general principles of civil liability gives each aggrieved party the right to claim compensation[796], especially if we know that the judiciary is the decisive factor in determining the entitlement and amount of compensation. It would have been more appropriate for the Jordanian legislator not to require the condition of registering a trademark in Jordan due to its entitlement to compensation due to its infringement.[797]

It was hoped that the Jordanian legislator would amend this text significantly after amended intellectual property legislation for Jordan's accession to the (WTO) to comply with the provisions of regulating intellectual property rights under (the TRIPS) agreement. Those rights constitute one of the most important axes of the (WTO). However, the law amending the Trademarks Law was issued. for the year (1999), retaining the text of Article (34) as in its old version regarding the ability to claim compensation, as this article states the following: "No one has the right to file a claim for compensation for any infringement of a trademark not registered in the Kingdom…."

Thus, the Jordanian legislator has limited the right to claim compensation in case of infringement of the trademark registered in the Kingdom. The unregistered trademark in the Trademark Register remains outside the civil protection framework represented by compensation.[798]

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[793] *Article No. (268) of the Jordanian Civil Code..*
[794] *Article No. (34) of the JTML No. (33) of (1952)*
[795] *Smith, Robert S. "The unresolved tension between trademark protection and free movement of goods in the European Community." Duke J. Comp. & Int'l L. 3 (1992): 89.*
[796] *as indicated in Article (256) of the Jordanian Civil Code.*
[797] *See, eg, Donald Harris, 'Trips and Treaties of Adhesion Part II: Back to the Past or a Small Step Forward?' (2007) Michigan State Law Review 185; Michael P Ryan, Knowledge Diplomacy: Global Competition and the Politics of Intellectual Property (1998); Susan K Sell, Power and Ideas: North-South Politics of Intellectual Property and Antitrust (1998); Peter Drahos and John Braithwaite, Information Feudalism: Who Owns the Knowledge Economy? (2002).*
[798] *Article No. (34) of the JTML.*

Through analyzing the position of the Jordanian legislator regarding the requirement to register a trademark to claim compensation for infringement and its insistence on requiring such a condition even after the issuance of the Law amending the Trademarks Law of 1999, it is worth referring to the provisions of the (TRIPS) regulating the trademark, especially the text related to the civil procedures and penalties[799] The TRIPS agreement has many legal effects on trademark registration. However, trademark registration is not required to claim compensation against infringement. According to TRIPS Agreement[800], registration gives the trademark proprietor the absolute right to prevent others from using the same or a similar trademark in his business for the same type of goods or services identical to those for which the trademark was registered as long as this has been done use without the consent of the proprietor of the registered trademark[801]

Accordingly, (TRIPS did not require prior registration for claiming compensation for any infringement, significantly if the Jordanian legislator has amended the trademark law in line with the provisions of TRIPS based on JTML[802]. By reference to (TRIPS)[803], the author finds that it has given the judicial authorities in the member states of this Agreement the power to order the infringer to pay the right holder fair and appropriate compensation for the damage caused to him due to the infringement of his right to the trademark, in addition to the expenses he incurred[(804)], which may include the appropriate attorney's fees. The judicial authority can order the recovery of the profits made by the infringer.

Therefore, the right of the aggrieved to claim compensation for the damage incurred by him due to the infringement of his trademark is not linked to the trademark registration with the competent reference (JMIT). Accordingly, the author does not find a clear justification for the position of the Jordanian legislator, especially after the issuance of the law amending the Trademarks Law, which was taken entirely from the TRIPS Agreement. Therefore, the provisions of Article No. (34) This law was supposed to align with the provisions of this international agreement.

1.2 Compensation under the law of unfair competition and trade secrets

The Jordan Unfair Competition and Trade Secrets Law was issued following Jordan's accession to the WTO to regulate unfair competition and trade secrets. In the field of unfair competition, this law clarifies the acts considered unfair competition, for example, but not limited to (M2). It also clarifies the civil protection in the case of unfair competition, which is the claim for compensation for damage and the cessation of the infringement (M3). Among the acts of unfair competition under Article (2/b) are those related to a trademark used in Jordan, whether registered or not, leading to misleading the public. Thus, the restriction set by the JTML for claiming compensation for the infringement of a trademark-related right, which is the registration, has been exceeded by the Law of Unfair Competition and Trade Secrets.[805]

In other words, the deficiency in Article No. (34) of the JTML has been filled by Article No. (2/b) of the Unfair Competition and Trade Secrets Law, claiming compensation for trademark infringement has become possible because this infringement constitutes an unfair competition that is approved by Article (3) of the Law of Unfair Competition and Trade Secrets. Accordingly, every stakeholder has the right to claim compensation for the damage

[799] *TRIPS Agreement, above n 2, art 44(1).*
[800] *Article No. 19/1 of the TRIPS Agreement*
[801] *Marrakesh Agreement Establishing the World Trade Organization, opened for signature 15 April 1994, 1867 UNTS 3 (entered into force 1 January 1995), annex 1A (General Agreement on Tariffs and Trade) 1867 UNTS 190 ('GATT 1994').*
[802] *Article No. (34) of the JTML*
[803] *Article No. (45) of the (TRIPS)*
[804] *Robert E Hudec, Essays on the Nature of International Trade Law (1999) 174. Hudec chaired the Panel in Canada — Pharmaceutical Patents.*
[805] *TRIPS Agreement, above n 2, art 64(3).*

he sustained due to unfair competition[806]. In this regard, one may wonder whether the first law to apply is the trademark law or the law of unfair competition and trade secrets. Since both laws are private, there is no law superior to the application of the other law. Therefore, the matter depends on the law best suited to the stakeholder.

The author argues that it is not possible to apply the provisions of the Jordanian Trade Law[807], which permitted the reference to the requirements of the Civil Code of the Commercial Law in the broad sense (the Jordanian Trade Law of 1966, the complementary laws of the Trade Law, and the Trademarks Law is vacant due to the presence of an explicit text[808], deals with the possibility of claiming compensation for the infringement of a trademark(809)

Accordingly, a claim for compensation for the infringement of a registered trademark in Jordan can be established based on [810]Trademarks Law, which gives the injured person the right to claim compensation for the infringement of his registered trademark, and also based on unfair Competition and Secrets Law[811] because infringement constitutes an act of unfair competition. (812) But if the trademark is not registered in Jordan, a claim for compensation can only be the Jordanian Unfair Competition and Trade Secrets Law[813], which did not require the trademark to be registered in Jordan because trademark infringement is considered an act of unfair competition[814]

1.3 Compensation under Civil Law

Civil liability is the obligation to compensate for damage. It may be a contractual liability arising from a contract, and it may also be a tort liability arising from a breach of a legal obligation, which is not to harm others, as mentioned previously. The liability of the infringer on a trademark is tortuous, not contractual because if there is an agreement between two merchants that stipulates the regulation of competition or non-competition, in the event of a violation of such an agreement, the contractual liability is based not on the basis that it is an act of unfair competition, but rather a prohibited competition. default[815]

The Jordanian Civil Code regulates tort liability and gives anyone who has suffered harm the right to claim compensation even if he is not distinguished[816]. based on that, a person whose trademark-related right has been infringed has the right to claim compensation if the damage incurred exists. Registering a trademark in the Kingdom is not required to claim compensation under this article that regulates civil liability. Accordingly, compensation can be claimed in the event of an infringement on a registered or unregistered trademark without requiring certain formalities such as prior registration of the trademark as long as the plaintiff can prove the elements of civil liability[817], namely: the act, the damage, and the causation relationship[818]

The Jordanian Civil Code requires compensation for material damage and moral damage whereas the right to warranty also includes moral damage. Every infringement on others'

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[806] *Council for Trade-Related Aspects of Intellectual Property Rights ('TRIPS Council'), Non-Violation and Situation Complaints, WTO Doc IP/C/W/349/Rev.1 (24 November 2004) (Summary Note by the Secretariat Revision).*
[807] *Article 2 JTML*
[808] *Article. (34) of JTML*
[809] *See, eg, EC — Trademarks and Geographical Indications, WTO Doc WT/DS290/R (15 March 2005) [3.1] (Report of the Panel).*
[810] *Article (34) of the JTML*
[811] *Article (2/b) of the unfair Competition and Secrets Law commercial trade because*
[812] *EC, Trademarks, and Geographical Indications, WTO Doc WT/DS290/R (15 March 2005) [7.25] (Report of the Panel).*
[813] *Article (2/b) of the Unfair Competition and Trade Secrets Law*
[814] *EC , Trademarks and Geographical Indications, WTO Doc WT/DS290/R/Add.1 (15 March 2005) (Report of the Panel), annex A-3 (Oral Statement of Australia: First Substantive Meeting) (23 June 2004) 36*
[815] *TRIPS Agreement, above n 2, art 3.*
[816] *Article No. 256 of the Jordanian Civil Code*
[817] *Article No (256) of the Jordanian Civil Code*
[818] *Simon Crean, Australian Minister for Trade, 'Australia to Negotiate an Anti-Counterfeiting Trade Agreement (ACTA)' (Press Release, 1 February 2008)*

freedom, honor, reputation, social position, or financial consideration makes the offender responsible for the guarantee."[819] Cvil compensation limits the damage incurred, which is the loss incurred by the creditor without the lost profit[820]. On top of that, "If the guarantee is not estimated in the law or the contract, the court shall estimate it in a manner equal to the damage that occurred at the time of its occurrence. [(821)] Suppose the final compensation assessment is impossible when the case is instituted, the judge can rule for temporary compensation[822] retaining the right of the aggrieved party to demand within a specific period a reconsideration of the compensation assessment.[823] In addition, the damages in Jordanian civil law may be caused by directness or cause.

He caused it to others without considering whether his act was a mistake, and this is what Article 256 of the Jordanian Civil mentioned previously. Some jurisprudence has criticized this text because it leads to the arrangement of responsibility and compensation just because a person performs a behavior, even if it does not constitute an assault on a right. The third party, as the damage may be achieved by the presence of a causal relationship between him and the act, but the act may be legitimate, and for this, it is necessary to stipulate the infringement in the direct action so that he is responsible for providing a compensation covering the damages he caused to others[824]

1.3.1 Unfair Competition Claim

The unfair competition lawsuit arises as a result of the infringement of a trademark[825], the civil liability must be established including the act, damage, and causal relationship[826] as follows:

1.3.1.1 The Act of Trademark Infringement

The tort responsibility in Jordanian civil law does not require an error to establish the tort responsibility. Rather, it is sufficient that the act is harmful, which leads to harm in itself. Therefore, it is not required for the liability to be established, that is, aware of the meaning of deviation or infringement in his work. The error that the law requires to establish tort liability is synonymous with transgression in Islamic jurisprudence, which is the deviation in behavior, whether through negligence and negligence or deliberately, that leads to harm to others. Accordingly, the competing trader is obliged to compensate the damages he causes to the other trader, regardless of whether his act constitutes a mistake or not, because the article, as mentioned earlier, violated the objective responsibility of the one who caused the damage without regard to the activity he was doing, whether it was a mistake or not. Some jurisprudence criticizes this text because it exposes a person to a claim for compensation simply for his conduct or any behavior, even if it does not constitute an infringement on the rights of others, which may lead to his frustration.[827]

The harmful act in the unfair competition lawsuit presumes the existence of competition between two traders, one of whom performs an act of unfair competition, whether

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[819] *Article No. (267) of the Jordanian Civil Code.*
[820] *Article No. (363) of Jordanian Civilians*
[821] *TRIPS Council, Enforcement of Intellectual Property Rights: Communication and Coordination as a Key to Effective Border Measures, WTO Doc IP/C/W/492 (31 May 2007) [26] (Communication from Switzerland).*
[822] *Article 268 Jordanian Civilians*
[823] *William E. Ridgway, Revitalizing the Doctrine of Trademark Misuse, 21 BERKELEY TECH. L.J. 1547, 1557–58 (2006) (discussing the distinctions between trademark law and patent and copyright laws)*
[824] *SgangCaterina, A plea for digital exhaustion in EU copyright law, 9 J. Intell. Prop. Info. Tech. & Elec. Com. L. 217 (2018).*
[825] *Article 256 of the Jordanian Civil Code*
[826] *Al-Haija, Mohammad Abu. "The Legal Nature of Trade Mark." PhD diss., Middle East University (2021).p 68.*
[827] *TRIPS Agreement, supra note 36*

intentionally or negligently[828], and lacking foresight. Jurisprudence has been used to determine what the harmful act means and the criterion of the extent to which that act violates the rules of honesty, honor, and integrity in trade[829.]

In this regard, the Unfair Competition includes the infringement of a trademark belonging to third parties in the Kingdom, whether the trademark is registered or not[830], and leads to misleading the public[831]. To this point, any competition that contradicts honest practices in industrial or commercial affairs and, in particular, the following shall be considered an act of unfair competition:-

1- Acts that, by their nature, confuse with the establishment of a competitor, his products, or his industrial or commercial activity.

2- Claims that are not true in the practice of trade may cause discrediting a competitor's establishment, products, or industrial or commercial activity.

3- Data or allegations whose use in the trade may mislead the public regarding the nature of the products, the method of manufacture, their characteristics, quantities, or suitability for use.

4- Any practice that may affect the product's reputation needs to be clarified regarding its external appearance or presentation or misleads the public when announcing its price or calculation method. Suppose the unfair competition is related to a trademark used in the Kingdom, whether registered or not, leading to misleading the public. In that case, the provisions of Paragraph (A) of this Article shall be applied.[832] The provisions in Paragraphs (A) and (B) of this Article shall apply to services as the case may be.[833]

It is worth noting that the images of unfair competition specified were mentioned by example but were not limited[834]. Therefore, other unfair competition cases can be measured in the current images. Due to the existence of a particular clause on the trademark used, whether registered or not, it will not address the forms of unfair competition mentioned in Paragraph (A) of Article Two of this Law, and it will limit the discussion to Paragraph (B) of the same article that deals explicitly with the trademark.[835]

The trademark includes the industrial trademark, and therefore, the trademark can distinguish agricultural products and land investors, that is, everything included in commercial dealings, whatever the nature of the source of the products[836].

For example, is the Pepsi-Cola mark for drinks with Service Marks a type of trademark? Service marks are those that take the form of specific badges to distinguish certain services, such as the badges placed by car service stations, such as providing a service to lubricate cars or the badges that they put Laundry on the clothes that are cleaned or dyed, as well as the badges used by hotels and restaurants, for example (The Four Seasons) to serve restaurants.

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[828] *Article (256) of the Jordanian Civil Code in light of articles (61, 257/2, and 291) of the same law and articles (918 - 920) of the provisions of the Judicial Judgments Code*

[829] *UK Trade Marks Act, 1994, c. 26, § 10*

[830] *The Tjordanian Unfair Competition and Trade Secrets Law showed the forms of unfair competition Article 2*

[831] *the Unfair Competition and Trade Secrets Law (2000) Article (2)*

[832] *Ross D. Petty, The Development of Trademark Law and the Concept of Brand Marketing in the United States Before 1946, 31 J. MACRO MARKETING 87, 90. 93–94 (2011) (tracing the history of brand marketing, or trademark advertising, and the various studies conducted on consumer beliefs); also supra notes 277–78. See generally L. R. Geissler, Association-Reactions Applied to Ideas of Commercial Brands of Familiar Articles, 1 J. APPLIED PSYCHOL. 275 (1917) (studying consumers' associations between brands and products).*

[833] *Eugene C. Lim, Dilution, the Section 22 Debacle, and the Protection of Business Goodwill in Canada: Some Insights from U.S. Trademark Law and Policy, 101 TRADEMARK REP. 1232, 1268 (2011) (articulating the incentive rationale underlying patent and copyright protection); also Benjamin N. Roin, Unpatentable Drugs and the Standards of Patentability, 87 TEX. L. REV. 503, 506 (2009) (describing how the inability to obtain patents thwarts drug development). But see micheleboldrin & david k. Levine, against intellectual monopoly 11 (2008) (arguing that intellectual-property protections do not motivate the development of innovations or increase creativity)*

[834] *Article 2 of Jordanian Unfair Competition and Trade Secrets Law*

[835] *See, e.g., Charles W. Adams, Allocating Patent Rights Between Earlier and Later Inventions, 54 ST. LOUIS U. L.J. 55, 56 (2009) (describing the need to maintain incentives for new creations in the context of patent law).*

[836] *Article 1/3 of the Paris Convention*

The Jordanian legislator also recognized the famous brand whose fame exceeded the borders of the original country in which it was registered with the development of Trade and ease communication between countries and support trade flow, furthermore, it increases goods and services movement among world countries. there was a need to protect famous trademarks whose fame exceeded the borders of the country in which they were registered. The amended law also adopted the Collective Marks, which Article (2) defines as "The mark used by a legal person to certify the source of goods not of his manufacture, the materials made of them, their quality, the method of production, the accuracy used in their manufacture, or other features and characteristics for those goods.

For example, the CIO) mark and all these marks, whether they are goods or service marks, well-known marks, or collective marks, are all subject to the provisions of the Trademarks Law[837]. The distinctive trademark is intended to have its own identity to prevent customers from confusing products with similar trademarks.

Therefore, it is not permissible to register a trademark usually used in commerce to distinguish the types and types of goods unless it is specifically highlighted. This particular form becomes the distinguishing feature of the trademark proprietor's goods.

A number may not be registered as a trademark unless the number is especially highlighted. The Jordanian High Court of Justice has authorized the registration of the number (4711) as a trademark of a German perfume company, as this number has been used distinctively on perfumes for a long time, and in this context, the High Court of Justice indicated that if this number is part of the trademark or is highlighted in a particular form, then, there is nothing in this law to prevent its registration and it is not permissible to register a standard description or drawing.

Moreover, the registration does not earn the mark nor grant it legal protection, and in this context, the Supreme Court of Justice decided if the drawing used in the trademark to be deleted from the standard fees does not constitute a distinguishing mark itself, and does not distinguish the proprietor s's goods from the others. the court explained that the mere use of this drawing alone by the plaintiffs does not constitute an infringement of these marks registered by the plaintiff against him. [839]

In this context, the Supreme Court of Justice did not permit the registration of the word "STANDARD" as a trademark because this word is usually used in commerce to distinguish the types of goods. To this point, the trademark is distinct to prevent the public from being deceived by using a trademark identical or similar to the registered trademark, even if it differs from the registered trademark. The Jordanian Supreme Court of Justices outlined the criteria for similarity leading to deceiving the public.[842]

The basic idea of the trademark is evident through the name, shape, drawing, pictures, seal, letters, or inscriptions that compose it. The Supreme Court of Justices decided that (no similarity would lead to the deceit of the public between the trademark (Lomax) and the trademark (Forex) because the two names are different. The first contains various images and is identified by three colors that distinguish it from the second, which does not have images. It was noticed the main manifestations of the mark, not its partial details:

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[837] *William Sloan Coats & Jennifer L. Co, Location, Location, Location: The Impact of Omega v. Costco on the Applicability of the First Sale Doctrine in the Grey Market, 1063 PLI/PAT 407, 411 (2011)*

[839] *The Jordanian Supreme Court of Justices, decision No. 65/108,*

[842] *The Jordanian High Court of Justice caseNo.93/95https://www.jstor.org/stable/3381848*

The imitation that constitutes an attack on a trademark is an imitation that falls on the central part of the mark and not on its partial details. In this regard, the Supreme Court of Justice decided (that similarity in an essential part between two trademarks would lead to deceiving the public). In another decision, the High Court of Justice agreed that (it is understood from Articles 7/2 and 8/10 of the Trademarks Law) the similarity.

What is forbidden by law is the resemblance that occurs in the whole sign, not in just a part of its parts. Therefore, there is no similarity between the sign (7-up) and the Bubble UP sign that would deceive the public, as there is a difference between them in pronunciation, drawing, and form. For this, there is nothing to prevent from registering the mark (Bubble Up). The Supreme Court of Justice used the term type instead of class, which would narrow the similarity criterion and give greater freedom to traders to use the same trademark or another similar mark on other types or goods. The Supreme Court allowed the registration of two identical marks under one category. The first trademark was for fish and tuna. In contrast, the second trademark belonged to the rest of the goods under a category, as it decided that (it does not prevent others from using the same trademark to distinguish another commodity that differs from it, as it does not result in confusion or confusion between the goods bearing the same trademark). The goods were not close together, and the proprietor of the mark may not invoke them except in the face of competitors who engage in trade or industry of the same kind because the purpose of the mark is to distinguish the products and prevent them from being confused with similar products.[843]

1.3.1.2 Possibility of confusion between trademarks by seeing or hearing the name

A trademark may lead to deceiving the public, whether by looking at it or hearing the name given to it. In this case, the Supreme Court of Justice decided that no similarity leads to the public between the mark (General Electric) and the mark (General) because the second mark is composed of one word and does not lead to a difference in the same meaning as the second mark. When purchasing the goods, it is not assumed that the consumer carefully examines its trademark and compares it with others. This criterion didn't consider the consumer a trademark expert when purchasing trademarked goods and services.

In this context, the Supreme Court of Justice previously confirmed that (the consumer is not supposed when buying a commodity to conduct a thorough examination of the trademark, especially if the consumer is a commoner, because the trademark law is legislated for those who do not check).[844] In addition, the trademark intended to be used must be new, and no one has previously used or registered it to distinguish its products, goods, or services. The novelty condition is restricted to the type of products and time and place. The trademark applicant must specify the type of goods he wishes to register. The trademark system in the Fourth Schedule classifies the goods, as each application must include the specific class in which the trademarks will be registered.

The class usually includes many types of goods that fall under it. Suppose a trademark is registered on some kinds of goods in a particular category. In that case, the legal protection does not extend to all types of goods in that category. Suppose a trademark is registered to include all goods in a particular category. In that case, the trademark proprietor does not enjoy legal protection if another person uses that trademark on a variety other than the one in which the trademark was registered. Well-known trademarks are excluded from this, as the well-known trademark cannot be used in a category other than the one for which the goods or

[843] *Weinberg, Harold R. "Is the Monopoly Theory of Trademarks Robust or a Bust?." J. Intell. Prop. L. 13 (2005): 137.pp 141-145.*
[844] *Gill. K, The Definition of a Trade-mark, Distinctiveness, and Use, Gill: Fox on Canadian Law of Trade-marks and Unfair Competition.*

service were registered due to the consumer's attachment to this trademark, which leads to misleading and deceiving the public.[845]

Also, trademark protection is limited to the trademark proprietorship period, which is ten years from the date of its registration. However, trademark registration may be renewed from time to time following the provisions of the law[846]. The proprietor of a registered trademark may renew his mark for ten years from the expiry date of the first registration period or the expiry date of the last registration[847]. Suppose the trademark proprietor does not renew it. In that case, the registrar may strike it off from the register, and the legal protection is lost. Regarding location, the scope of protection is limited to the territory of the country where the trademark is registered, without prejudice to international conventions and treaties. Accordingly, there is no protection for a trademark registered in Jordan. The attack occurred outside Jordan, just as there is no protection for a trademark registered outside Jordan. The attack happened in Jordan unless it was protected by an international treaty organized for it by Jordan. Likewise, the trademark must be legitimate if it violates a legal text, public order, or morals, as Article 8/6 claims.

The trademark registrar may refuse to register the mark if its pronunciation contradicts morals and public morals. the JTML clarifies what may not be registered as a trademark due to the official or religious nature of this mark, its similarity with another trademark, or other reasons.[850]

1.3.1.3 Damage

Damage can be defined as every harm caused to a person, which is an inevitable result of the harmful act, which may be material and affect the financial disclosure of the person and may be moral that affects dignity, honor, presentation, emotion, economic or social consideration· Moreover, practical damage can be awarded to compensate the plaintiff for quantifiable monetary losses[851].

In this context, compensation claim cannot be made through illegitimate competition. That applies unless the act of infringing the trademark-related right caused damage to the trader involved in the competition. It can only be made by proving that damage has occurred. The claim shall be rejected if the damage is not proven because a rule suggests no lawsuit without interest. Article 1/3 of the Jordanian Law of the Civil Proceeding indicates that.

A request could be submitted to the court with jurisdiction to stop the illegitimate competition even if this competition did not cause any damage (Part 3/C of the law of illegitimate competition and business secrets**.** This damage can be financial or moral. In this regard, moral damage is represented by harm to the stakeholders' reputation. The financial damage is represented in the damage to his funds or things. The damage shall lead to reducing or eliminating the economic value of things**[852].**

It is stipulated in the material damage that it arises from a legitimate interest, such as the proprietorship of a trademark or even its use for a while. It is also stipulated that the damage to be compensated be sure to occur, i.e., it is proven with certainty that it has occurred, and therefore, if the damage to be compensated is sure to be. It has occurred or will inevitably

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[845] *George. M, and D'Amato. N, (1978). Consumer Confusion & Trademark Infringement. Journal of Marketing, Vol. 42, No. 2, pp. 48-55*

[846] *(M20/1).*

[847] *following Article (21/2)*

[850] *Article 8 of the JTML*

[851] *Roger LeRoy Miller , Business Law Today, Standard: Text & Summarized Cases Publisher Cengage Learning,11 edetion, 2016 P 90.*

[852] *Patrick Barta& Christina Passariello, Global Liquor Makers Fight Graphic Labels in Thailand, WALL ST. J., Sept. 17, 2010, at B1; see also Committee on Technical Barriers to Trade, Notification, G/TBT/N/THA/332, at 2 (Jan 21, 2010), available at http://docsonline .wto.org/imrd/directdoc.asp?DDFDocuments/t/G/tbtn10/THA332.doc (alterting WTO members of proposed Thai regulations)*

happen so the court will have no choice but to award compensation proportional to the amount of damage.

As for the potential damage that is not known whether it will occur in the future or not, there is no compensation for it, just as the damage must be direct, that is, the damage should result in the verb directly, there is no interfering between the action and the harm another verb.[853]

Accordingly, the merchant whose trademark is being infringed can claim compensation for the damage, which is the reduction of his sales. However, if the damage will inevitably occur in the future, through the financial loss that will occur to him due to his inability to market his products or the lack of demand to buy them, or if the damage is probable but not inevitable, then the aggrieved party cannot claim compensation but can claim its cessation (M/C) of the Unfair Competition and Trade Secrets Law. Therefore, the compensation claim is only for the damage incurred.

The court can order compensation if the damage is realized on the side of the infringer of his trademark and takes the necessary measures to prevent the continuation of this damage(854), which is called stopping the infringement. It is one of the forms of civil protection for the trademark. The proprietor of a trademark registered in the Kingdom has the right when filing a civil, criminal lawsuit to request the court to stop the infringement and precautionary seizure of the goods in respect of which the infringement was committed and to preserve the evidence related to the infringement[855].

The request to stop the infringement is linked with registering the infringed trademark[856]. It is not permissible to request a halt to infringing a trademark not registered in Jordan. However, the opposite is true in Jordanian legislation[857]

The damage can also be moral, such as disinforming the quality of products. Compensation for moral damage does not aim to redress the damage as compensation for material damage. It is challenging to estimate moral damage financially. However, the damage can be compensated indirectly by giving the aggrieved party financial compensation. The Infringement on a trademark causes necessary material and moral damage simultaneously.

The incident of attacking a trademark, even if it does not cause direct material damage to the trademark proprietor, affects the reputation of the product or service provided by the trademark proprietor and affects the customer's view of this product or service in the future. It limits his desire to deal with it, which will inevitably affect the marketing of that product or service and thus translate moral damage into tangible material damage. It is also stipulated in the moral damage that the damage is not probable[858] .

The burden of proof of damage rests with the plaintiff seeking compensation for infringement of his trademark. Acts of unfair competition shall be proven by all means of evidence, notably by certificate, inspection, and experience. Damage can be proven in an unfair competition lawsuit due to trademark infringement by diverting customers from the

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[853] Allison N. Ziegler, Comment, Online Auction House Liability for the Sale of Trademark Infringing Products, 14 MARQ. INTELL. PROP. L. REV. 215, 229–30 (2010) (observing that under French tort law, online auction houses such as eBay may be liable for negligent conduct resulting in contributory trademark infringement); French Trademarks, INTELL. PROP. INFO., http://www.casalonga.com/French-Trademarks?&lang=en (last visited Mar. 15, 2012) (outlining the various penalties for trademark infringement and noting that criminal infringement may result in four years in jail).

[854] TRIPS Agreement, supra note 36, at art. 8(1) ("Member) [states] may adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development . . . ."); Paris Convention, supra note 102, at art. 6quinquies(B)(3) (providing that governments may refuse to register trademarks that are "contrary to morality or public order and, in particular, of such a nature as to deceive the public.").

[855] Article (39) of the JTML.

[856] Article (39) of the JTML.

[857] the Jordanian Illegal Competition and Trade Secrets Law (M3/2).

[858] See, e.g, Helbling. T, (2017), Shapes as trademarks? The struggle to register three-dimensional signs: a comparative study of United Kingdom and Swiss law, Intellectual Property Quarterly, I.P.Q. 1997. See also, e.g, Chalmeta. B. T, (2011), The importance of the trade mark distinguishing function in Spanish law, European Intellectual Property Review, E.I.P.R. 2011, 33(7), 419-424

plaintiff to other products due to the defendant's unlawful means. It is true that the merchant does not have a right of proprietorship over his customers and cannot prevent them from dealing with other merchants' products. However, merchants seek to retain and attract new customers by legitimate commercial means[859].

1.3.1.4 The Causal Relationship Between the Act of Infringement and Harm Act

The causation relationship or the link is necessary for convening civil liability and determining its extent, i.e., determining the extent of compensation resulting from this responsibility. The act is required to achieve the harm; that is, had it not been for it, the damage would not have occurred[860]. There is a causal relationship between the act and the damage, even if the act resulted in one harm and hit several funds owned by different people. The harm must result from the act directly, i.e., that another act does not preclude the action and harm that resulted from the first act. The causation link does not raise any problem if the final result of the action was done through the offender's act alone. However, the problem arises if several reasons contribute to achieving the result, such as the participation of the victim's act or others to attain it[(862)].

1.3.1.5 Tort liability

Harmful act or damages is every action that leads to harm to others illegally without regard to the discrimination of the actor and here and in the field of application of the texts combined means the harmful act here is the severe error issued by the employer and represented by negligence and negligence in maintenance or provision of public safety means for his workers.

More often than not, the damages expert proceeds on the hypothesis that the defendant committed the harmful act and that the act was unlawful. Accordingly, it assumes that the plaintiff is entitled to compensation for losses sustained from a dangerous act of the defendant[863].

The characterization of the causal relationship in this regard is the link of the damage to the destructive act; the link that the damage is a result and consequent on the actions and behaviors of the others. to this point, conditions must be met for such damage to be compensable: The moral damage must be direct and be realized now or in the future, and additionally, it must have yet to be compensated.

And finally, it must be personal, where It results from infringing on the injured party's legitimate right or interest. The assessment of such damage shall be based on what has been proven in the fact of the damage that the injured person was injured in one of the forms mentioned earlier, whether in freedom, honor, reputation, or social or financial status. In terms of jurisprudence, the author believes that the Jordanian judiciary has settled that the following matters should be taken into account.

It's worth mentioning that jurisprudence has created several theories to determine the causal relationship, including a theory of the equivalence of the causes that considers it necessary to take into account all the causes that participated in causing the harm, including the theory of the productive cause, which called for the necessity to distinguish between

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[859] *Rosler. H, (2007), The rationale for European trade mark protection, European Intellectual Property Review, E.I.P.R. 2007, 29(3), 100-107.*

[860] *See, e.g, Wadlow. C, (2007), "Including trade in counterfeit goods": the origin of TRIPS as a GATT ant counterfeiting code, Intellectual Property Quarterly, I.P.Q. 2007, 3, 350-402.*

[862] *cross. john t, 2008, the lingering legacy of trade-mark cases, michigan state law review, 367.*

[863] *National Research Council, Reference Manual on Scientific Evidence: Publisher National Academies Press, Third Edition,2011,p421.*

accidental causes and productive causes to consider the productive causes. To claim compensation through an unfair competition lawsuit due to trademark infringement, there must be a causal relationship between the infringement committed or caused by the trademark infringer and the damage caused to the trademark proprietor who has been infringed.

It is impossible to prove this causal relationship between the act of infringement and the damage. In that case, it is not possible to claim compensation for the damage caused to the trademark proprietor, as if the damage incurred to the trademark proprietor may have been the result of the actions of others and not the action of the defendant or as a result of the trademark proprietor's mistake.[864]

A civil lawsuit is distinguished from a criminal lawsuit in the case of trademark infringement. The criminal lawsuit requires that the trademark be registered. As it was mentioned earlier, no criminal protection exists for a trademark not registered in Jordan.

A civil lawsuit can be initiated whether the trademark is registered (with a difference in the legal basis between the two cases).

It is also possible to award compensation to the trademark proprietor, even if the criminal court acquits the defendant for the lack of criminal intent, as the compensation is linked to the existence of the damage, whether this damage was caused intentionally or by mistake If there are multiple victims, each of them may file a lawsuit independently of the others, provided that the damage is proven against him. In addition, an unfair competition lawsuit can be instituted against the one who committed the incident of infringing a trademark and everyone who participated with him in the act of infringement, provided that he proves his knowledge of the illegality of the work, or he could have known about that, such as the proprietor of the printing press who prints cards bearing counterfeit trademarks.[865]

typically involves the unauthorized use of a registered trademark in a way that will likely cause confusion or deceive the public. This can include using a similar mark on similar goods or services or using the mark to dilute its distinctiveness. Infringement of trademarks under continental tort law follows similar principles but may be defined and enforced differently in different countries as follows :

1.4 Common law

Common law trademark rights CLTMRs refer to the rights that are obtained through the use of a name in connection with particular items and services, without the need for registration. These rights can have an impact on both the process of applying for and registering a trademark. These rights are inherent and do not require registration, but they can create issues when it comes to the exclusive use of a trademark that is registered. Common law trademark rights in the United States are established via the utilization of the mark in commercial activities[866].

Nevertheless, there are provisions in place to safeguard the rights of unregistered trademarks, such as Yocco's, as federal legislation explicitly deals with common law - unregistered

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[864] *see, e.g, chronopoulos, apostolos, 2014, goodwill appropriation as a distinct theory of trademark liability: a study on the misappropriation rationale in trademark and unfair competition law, intellectual property law section of the state bar of texas, 253. see also, e.g, carter, stephen l, 1993, , does it matter whether intellectual property is property?, faculty juristship series, 2259*

[7] *23 Michaell J. Brennan (1961). Economic Man. JSTOR, Vol. 44, No. 2, pp. 126-132, Penn State University Press.*

[866] *Charles Riddle, Common Law Trademark Rights What are Common Law Trademark Rights? Why are they Important? February 21st, 2019, https://esquiretrademarks.com/common-law-trademark-rights/#goods*

trademark rights. The Trademark Act explicitly permits the denial of a trademark application by an individual who possesses CLRs in the mark.

The objection method enables the general public to impede or invalidate your trademark application on the grounds of CL rights. The responsibility of the Trademark Office does not include investigating unregistered marks. Instead, it focuses solely on finding registered marks that could potentially hinder the approval of trademark applications.

Trademark cancellation proceedings can utilize common law trademark rights to invalidate a registered trademark. A trademark owner who has not registered their trademark might request the cancellation of your trademark registration at any point before the registration becomes legally immune to challenge[867].

To be eligible to file a lawsuit for violation, the person who is suing must possess "PTMRs" under CL. The Supreme Court has recently restated the principles of CLTM regulations, affirming that the individual or entity who initially utilizes a unique mark in commercial activities automatically obtains legal exposure to that mark.

CLTM is significant as they have an impact on each process of applying for and registering a trademark. They can obstruct applications at the same time invalidate registrations, and face legal action for violation.[868]

Opposition proceedings allow third parties to obstruct your trademark application. The Trademark Act explicitly permits the obstruction of a trademark application by an individual who possesses common law rights in the mark.

The American Trademark Act ATMA allows for the rejection of a trademark application if the defendant's mark is similar to a mark already registered in the Office, or a mark or trade name previously used in the United States by another party and has not been abandoned[869]. This similarity is likely to cause confusion, mistake, or deception if utilized on or in conjunction with the defendant's products or services.

The question that arises by the author here is How does this situation unfold within the framework of trademark application? After submitting a trademark application, it will undergo examination. Once the request successfully undergoes inspection, it is subsequently made available for opposition. The opposition procedure affords the general public the option to impede opposition requests on the grounds of CLR

The Trademark Office is not accountable for conducting searches for unregistered marks. They exclusively seek registered trademarks that could impede the approval of your trademark registration. The opposition procedure fulfills the necessary need of addressing CLRs as stipulated by the Trademark Act.

Registration of trademarks can be invalidated by asserting CLTMRs Trademark revocation proceedings might be utilized to invalidate trademark registration. This is analogous to a post-registration opposition proceeding, as opposed to taking place while following the entire application procedure.

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[867] *Charles Riddle, Common Law Trademark Rights What are Common Law Trademark Rights? Why are they Important? February 21st, 2019, https://esquiretrademarks.com/common-law-trademark-rights/#goods*
[868] *Ibid.*
[869] *American Trademark Act, specifically 15 U.S.C. § 1052(d),*

Under common law, an unregistered trademark owner has the ability to request the cancellation of trademark registration at any point before the registration being unquestionable. Once the owner submits a Section 15 Announcement, the trademark registration becomes indisputable. Such might be accomplished following a period of 5 years from the date of registration and is usually included as a component of a combined Section 8 and 15 Declaration of Continued Use and Incontestability.

If someone possesses common law trademark rights, they have the ability to take legal action against you for violation. Despite possessing a trademark registration, you remain susceptible to a lawsuit for violating a trademark from an individual who holds CLTMRs

According to the ATMA, individuals can file a lawsuit if someone uses a name that creates confusion with another individual's products, services, or business operations[870]. When an individual utilizes a word, term, name, symbol, or any other representation that is likely to create confusion, mislead, or deceive regarding their relationship with, connection, or collaboration with another individual, or the source, sponsorship, or endorsement of their goods, services, or commercial activities by another individual. To be eligible to file a lawsuit for infringement, the Plaintiff must possess "Prior Trademark Rights" under common law[871].

The legal principle that has been firmly established by the courts is that the individual or entity who first uses a trademark consistently is recognized as the rightful owner. The rights associated with a trademark are established based on the date when the mark was first used in commercial activities. The individual or entity that initially utilizes a trademark in commercial activities is referred to as the "senior user" and possesses "priority" beyond subsequent "junior users". The individual who initially utilizes a mark that can be protected in commercial activities and consequently has legal entitlements to that mark. Essentially, a trademark represents the established reputation of a corporation. Goodwill cannot exist absent the usage of the mark.
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1.4.1 Common law principle of trademark

The American Supreme Court has restated the common law principle of trademark: "The individual who initially utilizes a unique symbol in business transactions thereby obtains ownership of that symbol." The case of B & B Hardware, Inc. v. Hargis Industries, Inc., is a legal matter that was decided by the Supreme Court[872].

The American Supreme Court establishes that the rights associated with a trademark are determined based on the date when the mark was first used in commercial activities. The party that initially utilizes a trademark in commercial activities is said to have precedence

[870] *American Trademark Act, 15 U.S.C. Section 1125(a),*
[871] *1125(a) of Title 15 of the United States Code on the Cornell Law School website.*
[872] *The case of B & B Hardware, Inc. v. Hargis Industries, Inc., 135 S. Ct. 1293, 1299, 1310, 191 L. Ed. 2d 222, 113 U.S.P.Q.2d 2045 (2015)*

over later users. The case of Hana Financial, Inc. v. Hana Bank, established trademark priority[873].

Courts usually have determined that a common law senior user is allowed to bring a claim for infringement against the owner of a registered trademark[874], even if the trademark is considered incontestable. The person who is the first to use a unique symbol in business gains the rights to that symbol."[875]

1.4.1.1 B&B Hardware, Inc. v. Hargis Indus., Inc.,

In the case, Hargis attempted to apply to secure its trademark for SEALTITE with the United States Patent and Trademark Office. B&B objected to the registration, arguing that SEALTITE bears a striking resemblance to B&B's SEALTIGHT trademark. The (TTAB) determined that the trademark registration of SEALTITE should be denied due to the high probability of confusion. Hargis refrained from pursuing a review by the courts. Subsequently, during a legal case involving a violation, B&B contended that Hargis was prevented from challenging the probability of confusion due to the conclusion made by the TTAB. The district court held a different opinion. The Eighth Circuit upheld the decision. The Supreme Court overturned the decision. If the remaining requirements of the rule are satisfied, issue prohibition ought to be applicable when the usages that were decided upon by the TTAB are essentially identical to those presented to a court. Issues the avoidance arise when Congress empowers authorities to settle conflicts unless the opposing legislative intent is obvious. Both the wording and organization of the Lanham Act [876]do not provide evidence to contradict the assumption that preclusive effect is preferred. There exists no definitive explanation as to why registration determinations can never satisfy the basic requirements of concern prohibition. The fact that plenty of registrations do not meet those requirements is not an indication that some of them will. Both trademark registrations and infringing cases are subject to the same test for determining the risk of confusion. The criteria employed by the TTAB and the courts to evaluate the probability of confusion are not fundamentally distinct; the actual legislative text is largely identical. The establishment of a complex registration system by Congress affirms that registration determinations can have sufficient importance to serve as a basis for matter prohibition[877].

1.5 continental law

In terms of Trademark compensation and infringement in continental law, Infringement of a trademark occurs when a third party uses a trademark that is identical or confusingly similar to a registered trademark in connection with goods or services that are identical or similar to those covered by the registered trademark, creating a likelihood of confusion among consumers.[878]

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[873] *Hana Financial, Inc. v. Hana Bank, 135 S. Ct. 907, 909, 190 L. Ed. 2d 800,113 U.S.P.Q.2d 1365 (2015)*
[874] *American trademark act 15 U.S.C. § 1125(a) and § 1065*
[875] *Charles Riddle, Common Law Trademark Rights What are Common Law Trademark Rights? Why are they Important? February 21st, 2019, https://esquiretrademarks.com/common-law-trademark-rights/#goods*
[876] *Lanham Act (15 U.S.C. 1051)*
[877] *https://supreme.justia.com/cases/federal/us/575/138/*
[1]*1C. Priyaa, Viji Vinod, Guruprasad Y.K · Intellectual Property Rights: Law, Legal Provisions, Technological Act, Publisher SK Research Group of Companies, 2024, p78.*
- Christoph Antons, Michael Blakeney, Intellectual Property Law in South East Asia, Publisher Edward Elgar Publishing, 2023, p53.

The international harmonization of legal norms presents issues for regulating damages in IP prosecution. Legal transplanting, a method employed to promote harmonization, can result in disorganized and occasionally conflicting transfers of IP norms. This might place states that do not adhere to established norms in a position where they must creatively construe or choose which global agreements to violate. The conflict between convention terms and constitution requirements can give rise to problems between constitutional laws and international treaty law, since states may be compelled to violate fundamental principles of civil law when compensation is coupled with penalty. The US policy on exporting damages necessitates the implementation of mandatory criminal penalties for IP violations, thereby undermining constitutional norms about due processing and equitable trial. Certain countries have incorporated both monetary penalties and compensating regimes into their legal systems. However, the implementation of both systems concurrently needs to be accomplished through rules that lack consistency.[879]

1.5.1 Damages Classification

If there is an act of infringement, harm caused, and a clear connection between the two, it may be appropriate to pay damages. Various categories of damages have been created and established to address instances of IP violation. While the details and substance of each award may differ depending on the jurisdiction, a shared nomenclature might be suggested. The resulting categories or sorts of damages can be classified based on whether they serve compensation or punishing purposes. Often, the determination as to whether they serve compensating or punishing purposes is crucial in many instances. In many instances, a single solution can serve both purposes and also aim to deter. Due to this factor, the suggested classification is controversial and several names might carry varying interpretations across various jurisdictions. However, this language might provide insight into an area that is marked by diversity among different national legal systems and where there are occasionally unclear distinctions between compensatory as well as punitive damages.[880]

There are situations where it might prove more suitable to impose unjust profit on the offender rather than real harm. This is especially accurate in cases when it is challenging to establish the loss suffered by the party that ultimately prevails, or when the gains obtained by the party that violates exceed the real harm caused. If there is a situation where the violation occurs unintentionally, the right proprietor may be compensated through the reimbursement of unfair profits. Nevertheless, there are differences in the way that different legal systems handle this issue, with certain jurisdictions only considering situations of deliberate or careless violation. Engaging in actions that violate intellectual property rights may need the provision of further details, and the laws of certain countries regarding patents may mandate the notification of the party accused of infringement. Damages in trademark cases can only be granted if the violating party has been adequately notified by the trademark owner. The TRIPS Agreement recognizes the existence of this dichotomy and accepts that lost earnings might be considered for determining damages in circumstances of careless or deliberate violation. Nevertheless, the remuneration of unjust gains might surpass the compensating role and become too compensating. In order to prevent the occurrence of excessive reimbursement and punitive consequences, it is not permissible to take into account lost profits in the calculation of unfair gains obtained by the infringement. The right may receive

[879] *Seuba, Xavier. The global regime for the enforcement of intellectual property rights. Cambridge University Press, 2017. p258*
[880] *Ibid p, 258*

compensation for ethical injuries, which fully covers the actual harm they have incurred, excluding any moral harm[881].

Moral bias is intricately linked to the rights associated with the personality of an individual. For example, an artist has the entitlement to be treated with regard for his name, his abilities, and his performance. This right is inherent and cannot be taken away or expire, and it is closely connected to his individuality. Therefore, it is quite straightforward to identify moral bias when individuals experience violations. Regarding other classifications of IP, which include trademarks, and the harm experienced by legal entities. Infringements of trademarks can have negative consequences on the trustworthy status of a trademark, harm its reputation for integrity, and cause market confusion. Nevertheless, it is important to note that these consequences are primarily financial and ought not to be considered ethical injuries. [882]Moreover, in Christian Lifers v Producciones Mandarina, S.L. and Mediaset Esparia883Supreme Court, of Spain, ruled that:" according to Article 13(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as allowing a person harmed by an infringement of his intellectual property right, who claims calculated compensation for material damage, per point 1(b) of the second subparagraph of that article, based on the number of royalties or fees that would have been due to him if the infringer had applied for authorization to use the intellectual property right at issue, to claim, in addition, compensation for his non-material damage as provided for in paragraph 1/(a) of the second paragraph of that article.

had applied for authorization to use the intellectual property right at issue, to claim, in addition, compensation for his non-material damage as provided for in paragraph 1/(a) of the second paragraph of that article.

ad applied for authorization to use the intellectual property right at issue, to claim, in addition, compensation for his non-material damage as provided for in paragraph 1/(a) of the second paragraph of that article.

1.5.1.1 Moral Damage

The issue of moral harm to a legal personality was highly debated[884]. In this context, the ruling in Morris-Garner has provided clarification on the issue of trademark violations leading to moral harm. In his ruling judgment, Lord Reed clarified that under common law, damages can be given based on the value of the unauthorized use of property. This applies to both tangible movable and immovable property and can be claimed through actions such as detinue, conversion, or trespass[885].The primary party who can initiate proceedings for violation is the legitimate proprietor of the IPR [886]. The aggrieved individual has the right to petition an appropriate jury for a civil trial[887].

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[881] *Ibid p, 259*
[882] *Ibid p260*
[883] *13 CJEU, Case C-99/15, Christian Lifers v Producciones Mandarina, S.L. and Mediaset Esparia https://curia.europa.eu/juris/document/document.jsf;jsessionid=D300458187E18C8081E3258845D51BA6?text=&docid=175159&pageIndex=0&doclang=fr&mode=lst&dir=&occ=first&part=1&cid=8614231*
[884] *Giacinto della Cananea, Roberto Caranta, Tort Liability of Public Authorities in European Laws, Publisher Oxford University Press, 2021 P159.*
[885] *Kung-Chung Liu, Annotated Leading Trademark Cases in Major Asian Jurisdictions, , p402*
[886] *Pierre Kobel, Pranvera Këllezi, Bruce Kilpatrick Competition Law Analysis of Price and Non-price p447 · 2021*
[887] *A. Inzelt, Jan Hilton · Technology Transfer: From Invention to Innovation Publisher Springer Science & Business Media, 2013 P 316.*

Compensation for ethical injuries is provided to the rightful owner in order to redress the tangible harm they have experienced, which may include any emotional or psychological harm. Moral bias is intricately linked to the entitlements associated with an individual's character, such as the entitlement to have their name, abilities, and achievements respected. However, it is important to note that compensation for IP, such as trademarks, is not to be considered as moral damages. Overwhelmed losses serve as compensation for the losses experienced by plaintiffs, rather than as a means of punishing a defendant for their actions. Aggravated damages are permitted in numerous legal systems, whereas punitive damages are not permitted. When both aggravated and exemplary damages are recognized, extraordinary damages are only given after severe losses and take into account the punishing aspect that constitutes the latter. This differentiation enables a supplementary method to address the violation.[888]

Concerning the PDM within the realm of trademark rights, the calculation of required compensation should be based on compensatory losses, and the application of punitive damages ought to operate concurrently with the legal reimbursement.[889]

In common law countries, legal orders frequently grant damages that exceed the entire restitution for harm caused to the rightful holder. These damages encompass exemplary damages, supplementary damages, punitive damages, and pre-established damages intended to serve as a deterrence. There is significant variation among different countries' legal systems in terms of language usage, types of intellectual property, and the extent of punitive damages. Exemplary damages are typically awarded in common law jurisdictions for tortious acts and violations of constitutional rights. Non-compensatory categories of damages aim to impose punishment and discouragement in civil proceedings. Punitive damages are granted when the defendant's behavior is especially malevolent or restrictive, and serve to demonstrate judicial displeasure or indignation. Additionally, they serve as a deterrent, fulfilling both particular and generalized preventative objectives. The monetary payment of punitive damages in certain countries is solely aimed at deterrent. Punitive damages are granted for several classifications of IP.[890'].

1.5.1.2 Punitive Damages.

PDs which are commonly referred to as exemplary damages, originated as a part of the common law system in England[891]. PDs also referred to as exemplary damages in the USA[892], were not aimed at punishing the party responsible, instead being intended to supplement compensatory damages as a form of recompense to the plaintiff for the general service that is of holding the defendant accountable in circumstances where the defendant's behavior was exceptionally shocking. In the United States, PDs have evolved as a distinct method to penalize those responsible for their actions. Due to the quasi-criminal intent behind punitive damages, these damages have faced significant opposition over time. Consequently, the court system has formulated multiple regulations to restrict the granting of PDs. PDs in IP

[888] *Ibid p262*
[889] *Chenguo Zhang, Balance and Limitation of Intellectual Property Protection in China: The Latest Law Amendments and Judicial Development Under Micro-Comparative Perspectives, Publisher Springer Nature, 2022 p204*
[890] *Xavier Seuba, The Global Regime for the Enforcement of Intellectual Property Rights, Publisher Cambridge University Press, 2017, Ibid p266*
[891] *Terence P. Ross · Intellectual Property Law: Damages and Remedies Publisher Law Journal Press,2000, P1-19*
[892] *Katy Barnett, Katy Eloise Barnett, Sirko Harder, Remedies in Australian Private Law, Publisher Cambridge University Press, 2014, P311*
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litigation are mostly applicable to CL cases involving claims of infringement of trademarks. PDs are not recoverable in the United States under either the federal intellectual property statutes or the Uniform Trade Secrets Act. In the United States, IPLs primarily rely on constitutionally expanded damages as a means of addressing augmenting damages, compared to PDs. [893]

1.5.1.3 Statutory Enhanced Damages.

Statutory augmented damages pertain to the provision or obligation in law to grant more than one of the compensating damages, usually in the form of double or triple damages. Statutes that employ these damage multipliers are designed to function as liquidated compensation for a certain form of illegal civil behavior, where it is not possible to fully demonstrate the real losses incurred. Statutory increased damages, unlike punitive penalties, serve the objective of ensuring that the plaintiff is adequately and justly remunerated rather than solely punishing the offender. Statutory increased damages have a crucial impact on intellectual property cases. Since an enlarged award is only applicable in circumstances where the violation was "willful," it is clear that this type of decision is aimed at discouraging violation. In the same vein, according to ATML, the court has the authority to issue an award for any sum greater than the actual damages determined, up to a maximum of triple that sum.[894]

1.5.1.4 Nonmonetary remedies

Nonmonetary remedies can take a variety of forms[895.] In IP litigation, however, nonmonetary remedies are usually coercive remedies. there is a range of judicial remedies that seek to reverse an unjust enrichment. They include both common law remedies award of money had and received, and proprietary remedies [896]

The coercive remedies relied on the distinct authority to issue an authoritarian individual order over the plaintiff, who was instructing them to engage in certain behavior, and imposing a penalty if they failed to comply[897]. A coercive remedy is a court order that compels a person who has engaged in a civil violation to stop their actions, with the threat of criminal consequences such as jail or a fine.

The injunction is widely recognized as the most prominent kind of coercive remedy. Anglo-American jurisprudence required the development of specific concepts to guide the utilization of these statutory powers. Delegating this authority to administrations facilitated the establishment of boundaries on the use of this judgment. These limitations have developed into overarching concepts that still govern the application of equity in Anglo-American legal practice today. Initially, fairness was a nonjudicial solution, but it later developed into a judicial solution. In reality, in the United States, the fields of equity and law have mostly combined and are currently overseen by one appellate court that has broad authority. Nonmonetary remedies can be highly advantageous for intellectual property owners who wish to defend their intellectual property rights. [898]

1.5.1.6 Additional Damages

[893] *Rochelle C. Dreyfuss, Justine Pila, The Oxford Handbook of Intellectual Property Law, Publisher Oxford University Press, 2018, p674.*
[894] *Ibid, p674.*
[895] *Terence P. Ross · Intellectual Property Law: Damages and Remedies Publisher Law Journal Press,2000, P 10-1*
[896] *Andrew Burrows, Principles of the English Law of Obligations, Publisher Oxford University Press, 2015, p327*
[897] *Randy E. Barnett, Nathan B. Oman, Contracts: Cases and Doctrine, Publisher Aspen Publishing, 2021, p156*
[898] *Terence P. Ross · Intellectual Property Law: Damages and Remedies ibid, P 10-1*

In certain legal countries, judges have the authority to grant supplementary compensation to individuals who have committed severe IP infringements, based on their deliberate purpose. These monetary damages are distinct from exemplary damages and are granted under certain statutory conditions. The contentious character of extra penalties has been the subject of dispute, although various considerations support their examination. The infringer's deliberate behavior is crucial, as the awards are determined by the flagrancy of their activity and the advantage gained by the defendant. The noncompliant conduct of the violator might likewise serve as an indication. Supplementary damages are sought as a means of enforcment and are only awarded once a compensation judgment has been established.[899]'.

1.5..1.7 Statutory Damages

Statutory damages are legal remedies that have been created by law to resolve challenges in determining the exact amount of loss or uncovering unjust profits due to difficulty in gathering evidence or determining the facts. They are frequently granted as a result of unintentional violations when it is challenging to determine the exact financial harm suffered by the owner of the rights or the unjustified benefit obtained by the person who violated the rights. Statutory punitive damages, while having a long history in the United States, are not frequently used as a legal remedy in other countries. Statutory damages for IP can only be recovered in 24 out of the 117 Member States of WIPO. Nevertheless, trade agreements advocated by the United States have the potential to alter this circumstance. Defendants are required to collectively and individually compensate the plaintiff for non-monetary harm. To establish their case, the plaintiff is required to provide evidence demonstrating both the psychological distress they experienced and a clear connection between the infringement of their IPRs and the breach of their individuality rights.[900]

1.6 Indirect Illegality in the European Union

The legal principle that does not provide compensation for those who have been harmed, the Court of Justice determined that under EU law, a right to reimbursement is only acknowledged if three criteria are fulfilled: the presence of a sufficiently grave violation of a legal provision aimed at granting rights to individuals, the occurrence of harm, and a causal connection between the violation of the provision and the harm suffered by the affected parties. The Court of Justice has not imposed compensation in any cases where the indirect invalidating effects of EU soft law were involved. To establish these criteria, it will be essential to illustrate that by ignoring the soft law instrument, a hard law regulation or principle that aimed to grant individual rights had also been violated. This situation can occur when soft law, which guides the actions of private entities, is integrated into EU secondary legislation, such as in the context of harmonized standards.
blish these criteria, it will be essential to illustrate that by ignoring the soft law instrument, a hard law regulation or principle that aimed to grant individual rights had also been violated. This situation can occur when soft law, which guides the actions of private entities, is integrated into EU secondary legislation, such as in the context of harmonized standards.
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[899] *Seuba, Xavier. The global regime for the enforcement of intellectual property rights. Cambridge University Press, 2017. Ibid p266*
[900] *Dušan V. Popović, Ivana Kunda, Zlatan Meškić, Enis Omerović, Balkan Yearbook of European and International Law 2021, Publisher Springer Nature, 2022, p88, margin 66*

Noncontractual liability will only occur in instances of clear and significantly grave violations, which must be obvious and severe, rather than the violation of non-binding EU soft law. It may be simpler to demonstrate in situations where EU or national legislation includes specific EU non-binding guidelines, such as standardized norms.

When there is a breach of the obligations to consider and provide reasons for deviating from EU soft law, it becomes highly challenging to establish a clear cause-and-effect relationship between the breach of these obligations and the harm experienced by the non-governmental entity. The entitlement to a well-reasoned determination is an integral component of both the entitlement to an efficient judicial safeguard and the entitlement to competent administrative governance.[901]

1.6.1 The conditions for awarding damage

Trademark protection primarily relies on state legislation. Practically speaking, European as well as developing nations will inevitably hold divergent viewpoints regarding the extent of IP safeguarding. Effective and cautious protection is of particular importance in the international relations context.[902]

The criteria for granting compensation for the responsibility of public authorities encompass the presence of harm, illegal behavior, civil legal responsibility, a causal link between the activity and the harm, foreseeability, and the inability to prevent the loss through legal means. There is a disagreement on the objective grounds for legal responsibility, which has led to the development of the doctrine of severe error in the application and interpretation of law. Government culpability may only result from a grave violation of legislation[903].

Before the small modification of the legal framework by the new CC, it was not feasible to grant compensation for legislative acts. Starting from 2018, civil courts are obligated to adhere to the interpretation provided by administrative courts. The principles governing the award of the sum in question are as follows: full reimbursement of the complete loss, the claimant's obligation to demonstrate the infringement, the precise quantification of the loss, and establishing a causal connection between the infringement and the damage. The assessment of revenue loss typically relies on expert testimony.
infringement and the damage. The assessment of revenue loss typically relies on expert testimony.

Two primary issues arise from judicial rulings: establishing the gravity of the violation and demonstrating the causal connection between the violation and the claimed harm, particularly the financial loss. This issue also occurs when applying the fundamental concepts of responsibility, particularly in situations when the legal relationship is not public.[904]

1.6.1.1 The causal link between infringement and loss suffered

[901] *Petra L. Láncos, Napoleon Xanthoulis, Luis Arroyo Jiménez, The Legal Effects of EU Soft Law: Theory, Language and Sectoral Insights, Publisher Edward Elgar Publishing, 2023, p27*
[902] *Heidi Lautjärvi, White-Collar Business Crime, Publisher BoD - Books on Demand, 2023, p144.*
[903] *Giacinto della Cananea, Roberto Caranta, Tort Liability of Public Authorities in European Laws, Publisher Oxford University Press, 2021, p59*
[904] *ibid p59*

The claimant's entitlement to seek compensation for their losses hinges on their ability to convince the court that their losses are a direct result of the defendant's violations. Considering just the specific services provided by the plaintiff, the tribunal determined that there was no direct connection between the defendant's infringing and the plaintiff's loss of revenue. This conclusion was based on the fact that consumers wouldn't automatically infer that the defendant is affiliated with the claimant.

Consequently, merely a small number of damages were granted. Nevertheless, it is argued that the court's determination regarding the lack of causation is perplexing. When evaluating the financial losses incurred due to confusion, the court's responsibility is to ascertain the percentage of the defendant's customers who have been affected, rather than analyzing the losses on an individual basis. Although the proof presented by both sides for or against an assertion of cause and effect is unclear, it is not appropriate to arrive at that there's no link between the two based solely on conclusions about the character of the claimant's services. This conclusion suggests that no consumers could have been deceived in any way. This implies that businesses providing specific health care might think about not registering their trademarks in order to avoid potential confusion and subsequent harm. Furthermore, it indicates that the well-established legal principle that requires every pertinent detail to be supported by proof and proven could be easily disregarded[905].

1.6.1.2 Exemplary damages

The role of exemplary damages in trademark violation proceedings is ambiguous. The investigation begins with the assumption that exemplary damages cannot be chosen by a successful claimant in a trademark infringement lawsuit. Therefore, the key question is whether a tribunal has the authority to award such penalties under common law. In the case of Main-Line v United Overseas Bank ("Main-Linc"), *Judge Tay* expressed skepticism towards the court's statement in Cryoviva that exemplary damages apply to all legally binding intellectual property rights. Tay argued that the English position, as presented in the Intellectual Property Regulations 2006, seems to be more lenient in granting exemplary damages. Furthermore, Tay suggested that if Parliament had intended to allow for exemplary damages to be awarded, similar to the additional damages under the Copyright Act, it likely would have explicitly stated so. In the instance of the General Tire case, a similar stance was taken, stating that damages ought to be imposed generously, but to compensate the plaintiffs rather than punish the defendants. The position in Main-Line and General Tire is uncertain due to the Court of Appeal's ruling in ACB v. Ibomson Medicar ("ACT"), which examined the matter of punitive damages in tort law. Despite the court's rejection of Rookes and its decision that it is expected to no longer be an element of Singapore law, the court still concurred with Lord Wilberforce in *Cassell v Broome* that the civil law's operation is not solely compensating, even if it is mainly so. The court ultimately determined that "exemplary damages can be granted in cases of tort when the entirety of the defendant's behavior is exceptionally shocking and justifies retribution, prevention, and censure. It is important to mention that the court did not differentiate between traditional law and CL[906].

2. Compensation under international unfair competition

[905] *Kung-Chung Liu, Annotated Leading Trademark Cases in Major Asian Jurisdictions, Publisher Routledge, 2019, p405*
[906] *Kung-Chung Liu, Annotated Leading Trademark Cases in Major Asian Jurisdictions, ibid, p405.*

Federal courts' jurisdiction in cases involving registered trademarks left the nature and scope of trademark rights under the domain of the common law. As commerce expanded across state lines, diversity of citizenship jurisdiction brought more and more cases involving disputes over unregistered trademarks and unfair competition into federal courts. Consequently, federal courts increasingly decided cases under the rules of federal common law and without regard to state precedents.

As a result, state sovereignty was a negligible concern in the cross-border regime of trademark and unfair competition law. However, adjudication in state courts also neglected choice-of-law issues.

In particular, local rules on pleading, proof, and presumptions concerning the content of "foreign" laws (i.e., the legal regimes of other states) contributed to this development. While state courts always took judicial notice of forum law, the laws of different states were regarded as fact, and these laws had to be pleaded. Accordingly, unless established by a legal presumption, the content of foreign laws had to be proven. In addition, any foreign law presumptions were founded on an assumption of typical law homogeneity. Hence, it was presumed. Assumption of typical law homogeneity.

Therefore, it was thought that a foreign regime would accommodate the general principles of common law. Furthermore, if the forum's common law differed from other states' standard law rules on a specific issue, and if the foreign common law was also unclear concerning its content, the "general rule was that that view of the common law taken by the courts of the forum will prevail in the absence of evidence of contrary rulings by the[907] In general, unregistered trademarks are protected under common law, which means that the proprietor of an unregistered trademark can still take legal action against someone who infringes on their trademark rights. However, the level of protection offered to unregistered trademarks may vary depending on the jurisdiction and the case's specific circumstances[908].

Under competition law, the use of unregistered trademarks may be subject to certain restrictions. For example, suppose a company uses an unregistered trademark to confuse or mislead consumers about a product's or service's origin. In that case, this may be considered an unfair business practice and a violation of competition law.[909].

In some cases, companies may also use unregistered trademarks in a way that constitutes anti-competitive behavior, such as blocking competitors from entering a market or maintaining a dominant position in a particular industry. This behavior may be scrutinized under competition law, resulting in legal action against the offending company. Overall, while unregistered trademarks can provide some level of protection for brand proprietors, it is essential to be aware of their use's potential competition law implications.[910]

2.1 Trademark and Competition Law

In this place, the author will examine the correlation between trademark rights and unfair competition legislation, with a specific emphasis on the influence of globalization. The text examines the function of federal laws in safeguarding consumers and granting market participants the ability to initiate legal proceedings in federal court. The chapter also discusses the impact of the Court of Justice of the European Union (CJEU) on national legislation and jurisdiction. Moreover, the author will examine the possibility of infringement claims arising from any location, as trademarks can be accessible globally, posing a challenge

[907] *Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, Publisher Cambridge University Press, 2017, p 136.*
[908] *Ibid, p 136.*
[909] *ibid, p 136.*
[910], *Ibid, p 136.*

in safeguarding branded identities against actors seeking to expand their international market presence.[911]

To safeguard the effectiveness of trademarks, it is necessary to protect the utilization of identical signs by third parties in a manner that may confuse consumers[912]. Trademark law has always been responsible for ensuring such protection. Trademarks serve as a vital commercial asset for businesses, aiding consumers in making informed purchasing decisions. They might be utilized to establish an appealing portrayal of the products or services they represent through advertising and marketing.

Over time, the trademark can acquire a significance that goes beyond just identifying the goods or services[913] it represents and instead communicates specific qualities and ideals, such as a luxurious lifestyle, excitement, or youthfulness. By engaging in this practice, the brand acquires enhanced selling prowess, which refers to its ability to attract and retain customers. By enhancing the perceived worth of the specified products among consumers, the trademark enables its proprietor to demand a greater price for them.

The latter exposes the proprietor to the business practices of other parties who may seek to undermine the appeal of the trademark or exploit its reputation and status without making the required effort and investment. Engaging in such actions might have detrimental effects on the trademark proprietor's business and provide an unfair advantage in the market, so qualifying as unfair competition. This article demonstrates the evolution of EU trademark law, which first aimed to safeguard consumers from confusion, but has now expanded to also safeguard the business value of trademarks and protect their proprietors from harmful or unfair commercial actions that exploit this value. Simultaneously, the Court of Justice of the EU (CJEU) has been cautious in permitting methods that can be considered acceptable within the realm of fair competition.

EU trademark law is evolving into an EU law that deals with unfair competition related to the use of trademarks. In this regard, the author aims to elucidate these advancements by examining the rationales behind particular policy choices and rulings made by the Court of Justice of the European Union (CJEU), as well as the broader framework of EU legislation on unfair competition. Eventually, the reader gains comprehension of how EU legislation deals with safeguarding the economic worth of trademarks. [914]

The primary objective of the European Competition Law framework is to proactively mitigate market obstacles and uphold equitable competition. The initial treaty of the European Economic Community in 1958 incorporated the fundamental concepts of competition law. The initial Commissioner on Competition Policy highlighted the significance of consolidating unfair competition laws by employing conventions or aligning legislation across nations.[915].

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[911] Tim W. Dornis Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, Publisher Cambridge University Press, 2017, p1.

[912]Ryan Abbott, Research Handbook on Intellectual Property and Artificial Intelligence, Publisher Edward Elgar Publishing, 2022, p319.
- Carlos Correa, Trade Related Aspects of Intellectual Property Rights A Commentary on the TRIPS Agreement, Publisher Oxford University Press, 2nd edition ,2020, p176

[913] Reiga Ritomiea Ariescy, Luqita Romaisyah, Devy Sylvia Puspitasari, EBGC 2019: Proceedings of the 2nd International Conference on Economics, Business, and Government Challenges, EBGC 2019, 3 October, UPN " Veteran" East Java, Surabaya, Indonesia2020, Publisher European Alliance for Innovation, 2020, p75

[914]Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p151, ji_2021_30_152.pdf (juridicainternational.eu)

[915] Bart Custers, Eduard Fosch-Villaronga, Law and Artificial Intelligence: Regulating AI and Applying AI in Legal Practice, Publisher Springer Nature, 2022, P366

2.2 Prevention of unfair competition

Trademark Directive and the EU Trade Mark Regulation specify the specific rights that trademark proprietors have under EU trademark law[916]. The rights associated with the trademark are contingent upon whether the third party's utilization of the mark is indistinguishable or comparable to the safeguarded goods or services, and whether the mark possesses a recognized reputation. The CJEU's objective is to offer a consistent understanding of the proprietor's authority to prohibit usage. Recent legal precedents highlight the significance of unfair competition in defining the exclusive rights of trademark proprietors, specifically concerning the functions theory that determines the infringement of all trademarks.[917]

In this regard, the legal recognition of citizens' ability to sue actors engaged in anticompetitive practices is not explicitly stipulated by law but rather stems from the case law established by CJEU.[918]

2.2.1. Simple trademarks – the theory of the functions as a means to protect fair competition.

Articles 10(2) of the Trade Marks Directive and 9(2) of the EU Trade Mark Regulation specify the specific rights that trademark proprietors have under EU trademark law. The rights associated with the trademark depend on whether the third party's use of the trademark is identical or similar to the protected products or services, and whether the brand has a reputation.

The CJEU's objective is to offer a consistent understanding of the proprietor's authority to prohibit usage. Recent legal decisions highlight the importance of unfair competition in defining the exclusive rights of trademark proprietors, especially concerning the functions theory, which determines the infringement of all trademarks.[919] In this regard, in the case of News and Media Holding v. VersaMedia[920], the claimant, who possesses national trademarks No 187927 and No 18792, requested legal recourse against unfair competition from the publisher of MOJE ZDRAVIE. The District Court issued an interim injunction and dismissed part of the lawsuit, while the Regional Court affirmed this judgment. The opponent was ordered to stop using the logo on the cover until an official determination was made on the substantive circumstances.[921].

2.2.2. Recognition of other functions – protecting the business value of trademarks

The CJEU has acknowledged the significance of additional functions, such as communication, investment, and advertising, in safeguarding the commercial worth of trademarks.

Originally, trademarks were used to ensure the source and excellence of a product, but these roles were deemed significant and warrant safeguarding independently. The CJEU subsequently recognized that trademark proprietors can enforce their exclusive rights under Article 10(2)(a) of the TMD only when a third party's use of the mark has an impact on, or has the potential to impact, the functions of the trademark. The advertising function of a trademark refers to the utilization of a mark for advertising purposes to inform and convince consumers. In this regard, the Paris Court of Appeal has confirmed the decision of the lower

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[916] *Articles 10(2) of the TM Directive and 9(2) of the EU Trade Mark Regulation*

[917] *Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, ibid, p153,*

[918] *ibid, P 417*

[919] *Ibid, p154,*

[920] *Regional Court Banská Bystrica (Krajský súd Banská Bystrica), case 41CoPv/9/2019*

[921] *Euipo, Recent Case-Law On The Infringement And Enforcement Of Intellectual Property Rights, July 2024, Ibid,,p 214.*

court in the case of Citroën v Polestar[922], ruling that the use of the Polestar logo violates Citroën's two French trademarks. Citroën, a subsidiary of the PSA Group, possesses two French figurative trademarks that feature the 'two chevrons' emblem, which serves as the identifying symbol for all of its automobile lines. Polestar Efficiency, a car manufacturer within the Volvo Group based in Sweden, specializes in the production of electric vehicles. In 2017, the PSA Group formally demanded that Volvo Car Corporation stop using the trademarks in question. However, (Volvo Car Corporation) declined to comply with the letter of demand. In 2018, PSA Group initiated legal proceedings to challenge the validity of the two trademarks with the Office (EUIPO). However, the EUIPO dismissed these efforts. Citroën has lodged appeals against these verdicts, The Paris Court of Appeal ruled in favor of Citroën, directing Polestar to compensate Citroën with EUR 150,000 as compensation and imposing a six-month ban on Polestar from using the disputed signage in France.[923]

The proprietor of a trademark has the right to prevent a third party from using the same sign without the proprietor's permission if such use negatively impacts the proprietor's ability to utilize the mark for sales promotion or as a tool for commercial strategy. [924] Nevertheless, the (CJEU) has limited the extent of the advertising function, stating that using a sign that is identical to someone else's trademark in some situations does not pose a risk to the advertising function. The primary purpose of a trademark's investment is to enable the proprietor to establish and maintain a strong reputation that may attract new customers and foster their loyalty via the use of advertising and other business strategies.[925] In this regard, The case SHR, Louis Vuitton v Rich-Ycled926, pertains to the utilization of a widely recognized Louis Vuitton brand in the process of recycling, promoting, and trading clothing. Rich-Ycled manufactures clothing utilizing non-original Louis Vuitton fabrics, which violates Louis Vuitton's trademark rights and the Advertising and Sales Standards Act. The court determined that the utilization of counterfeit merchandise constitutes a violation, and the utilization of authentic Louis Vuitton products was not deemed justifiable.[927]

The CJEU has set a rigorous criterion for diminishing the investment function of a trademark. Merely using the same sign as another party in fair competition does not sufficiently prove a negative impact on the trademark's investment function. Nevertheless, the proprietor of the trademark must adjust their endeavors to obtain or maintain a favorable reputation. The CJEU has restricted the use of the communication function of a trademark since it cannot exclusively depend on a competitor using an identical sign to persuade customers to switch from goods or services associated with that brand[928].

The harm to the reputation of the trademark must have a probable impact on the purchasing decisions of the typical consumer of the related products or services. The CJEU acknowledges that a trademark can communicate information about aspects other than the

[922] *d'appel de Paris, Pôle 5 – Chambre 1, nr 20/12598 (Citroën v Polestar) [14 December 2021]*
[923] *Euipo, Recent Case-Law On The Infringement And Enforcement Of Intellectual Property Rights, July 2024, Ibid, p227.*
[924] *Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p155, ji_2021_30_152.pdf (juridic international. EU)*
[925] *Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p155, ji_2021_30_152.pdf (juridic international. EU)*
[926] *Court (Sø- og Handelsretten), case BS-43965/2018-SHR, Louis Vuitton v Rich-Ycled [06 January 2020]*
[927] *Euipo, Recent Case-Law On The Infringement And Enforcement Of Intellectual Property Rights, July 2024, Ibid, p216.*
[928] *Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p156, ji_2021_30_152.pdf (juridic international. EU)*

source of the products or services it represents, such as intangible qualities of the product or the manufacturing entity. Nevertheless, it remains ambiguous how to differentiate the safeguarding of this purpose from the acknowledgment of the excellence and financial commitment associated with trademarks, particularly when the excellence of goods encompasses their intangible attributes.[929]

2.3 EU trademark protection

Registering a trademark is a highly effective strategy for establishing and protecting a company's reputation[930]. In this regard, it's worth mentioning that Most jobs and 39 percent of its GDP[931] in the EU were created by trademark-intensive industries[932]. Then it's logical to understand that registering a trademark is a way to ensure that no one else uses it.[933]

In Europe, trademarks can be registered either at the national level as a national trademark or at the EU level as an EUTM. The EC consistently examines the trademark system in the EU to identify methods for enhancing its efficacy and ease of use for businesses.

2.3.1 The European Union employs a dual system of protection.

There are two primary methods for registering a trademark in the European Union. One option is to register them at the national level through the industrial property offices of EU countries. Alternatively, they can be registered at the EU level as a (EUTM) through the (EUIPO).

(EUTMs) exist simultaneously and are mutually supportive. A trademark can be registered either at the (EU) level or the national level. The EUTM system comprises a unified registration process that confers upon the proprietor an exclusive entitlement in all member states of the European Union. This dual system fulfills the needs of enterprises of varying sizes, industries, and geographical reach. Small and medium-sized enterprises (SMEs) or local firms that do not require protection across the entire EU may find national trademarks more advantageous. The regulations about the registration of trademarks at the national level in the EU were initially standardized in 1989. The EUTM was established in 1994[934].

2.3.2Trademark system reformation

Trademark rules and registration procedures differ across different nations. Every nation has its own set of regulations and protocols for the registration and safeguarding of trademarks, and these regulations might vary considerably from one country to another. The United States and the EU are highly sought-after locations for trademark registration globally, primarily because of their robust legislative frameworks, well-developed trademark systems, and extensive levels of protection. Nevertheless, there are notable distinctions in the procedure of trademark registration in various jurisdictions.[935] The question arises What is the competition law in the EU?

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[929] *Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p156, ji_2021_30_152.pdf (juridic international. EU)*

[930] *Okojie, Victoria, Igbinovia, Magnus Osahon, Global Perspectives on Sustainable Library Practices, Publisher IGI Global, 2022, P 270.*

[931] *Debra Johnson, Colin Turner, European Business, Publisher Routledge, 2015, p100*

[932] *Kung-Chung Liu, Uday S. Racherla, · Innovation and IPRs in China and India: Myths, Realities and Opportunities Publisher Springer, 2016, p30.*

- OECD, European Union Intellectual Property Office, Illicit Trade in Counterfeit and Pirated Goods Mapping the Economic Impact: Mapping the Economic Impact, Publisher OECD Publishing, 2016, p27.

[933] *Andrew Murray, Information Technology Law: The Law and Society, Publisher Oxford University Press,4th edition, 2019, P364*

[934] *Koen Lenaerts, Piet Van Nuffel, Tim Corthaut EU Constitutional Law, Publisher Oxford University Press, 2021·, p470.*

[935] *EUROPEAN COMMISSION, Trade mark protection in the EU, https://single-marketeconomy.ec.europa.eu/industry/strategy/intellectual-property/trade-mark-protection-eu_en*

2.3.3 Competition Law in the EU

Competition is an essential aspect of the market in which parties strive to advance their interests by delivering superior alternatives. It is a phenomenon that takes place between buyers and sellers, exerting an impact on the decision-making processes. Competition can influence multiple facets such as quality, weight, look, power, durability, and terms. competitiveness law in the EU fosters competitiveness within the European Single Market.[936] In this regard, the FIFA v Puma SE case[937] is a significant legal dispute that resolved a long-standing conflict between (FIFA) and the German sportswear company Puma. FIFA, the organization in charge of arranging the 2022 World Cup in Qatar, initiated legal action against the registration and utilization of two trademarks, namely 'PUMA WORLD CUP QATAR 2022' and 'PUMA WORLD CUP 2022'. The Swiss Supreme Court determined that PUMA's trademarks were deceptive, and FIFA's trademarks 'QATAR 2022' and 'WORLD CUP 2022' did not possess intrinsic uniqueness. Puma was instructed by the tribunal to cease utilizing the trademarks for specific sports items, clothes, and accessories due to unfair competition and the deceptive manipulation of customers. "The commercial court" noted that the marks were deceptive, which might be considered an act of unfair competition according to Article 3(1)(b) of the Swiss Unfair Competition Act (UWG). The court has also remanded the case to the Handelsgericht des Kantons Zürich to obtain temporary restraining orders. The case illustrates that FIFA has the authority to prohibit 3rd parties the form from using deceptive symbols that suggest a connection with the event, even if it does not officially own the trademarks.[938]

The subsequent inquiry is as follows: What distinguishes United States trademark law from EU trademark law?

In the United States, an individual or entity can get specific legal rights associated with a trademark by becoming the initial user of the mark in commercial activities, regardless of undergoing the registration process. Trademark protection in the EU is contingent upon registration. Requirements for registration and utilization in commercial activities[939].

A key distinction lies in the fact that the EUIPO carries out both formal and substantive examinations of trademark applications, whereas the USPTO largely emphasizes fundamental inspection. [940]In this regard, it might be raised the question is whether US trademarks apply in the EU. The proprietor of a trademark can potentially utilize their USPTO trademark application or registration as the foundation for acquiring trademark safeguard in the EU via the Madrid Protocol. Submit a single submission to apply for the protection of an application that is also referred to as a Community Trademark. [941]

2.3.4 Official Trademark Offices

With a robust legal framework for safeguarding trademarks, the United States Patent and Trademark Office (USPTO) is among the largest and most renowned trademark registration offices in the world. Based on official statistics from the USPTO, the number of trademark

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[936] *Paweł Kaczmarczyk, Selected Regulations against Anti-Competitive Practices according to EU Law, , publikacje.pan.pl. pan.pl, P205*

[937] *– Injunction Handelsgericht des Kantons Zürich – Fédération Internationale de Football Association (FIFA) v Puma SE, Case HG220065-0 [6 April 2022)*

[938] *euipo, recent case-law on the infringement and enforcement of intellectual property rights, July 2024, https://euipo.europa.eu/tunnel web/secure/webdav/guest/document_library/observatory/documents/reports/New_Case_Law_en.pdfIbid, p246*

[939] *The Indus Entrepreneurs, Essentials of Entrepreneurship: What it Takes to Create Successful Enterprises, Publisher John Wiley & Sons, 2003, p71.*

[940] *Igor Demcak, Trademark registration in the US: Statement of Use requirement,https://www.tramatm.com/blog/category/legal/trademark-registration-in-the-us-statement-of-use-requirement, February 2023*

[941] *Gerald B. Halt, Jr., John C. Donch, Jr., Amber R. Stiles, Robert Fesnak, Intellectual Property in Consumer Electronics, Software and Technology Startups, Publisher Springer Science & Business Media, 2013, p47.*

- Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, 2024, P401.

applications lodged in 2021 was estimated to be around 576,000, while the number of trademark registrations issued amounted to around 480,000. These figures include applications and registrations for both domestic and

international trademarks.

It is a desirable choice for businesses seeking to defend their brand throughout the EU, as the (EUIPO) administers a unified registration system for trademarks in all 27 EU member states. Official statistics from the (EUIPO) indicate that in 2020, the EUIPO granted trademark registrations for approximately 160,000 entities and received roughly 173,000 trademark submissions[942].

2.3.5 Trademark Priority

Priority in trademark refers to the right of an individual or company to have their trademark recognized and protected over others who may have similar trademarks. It is a legal concept that determines who has the first claim.

In the United States, the trademark system is based on the principle of "first to use." This means that the party that first uses a trademark in business often has stronger legal rights compared to others that use the same or a similar trademark later on. Under the first-to-use system

in the US, a firm can acquire common law trademark rights by simply using the mark in commerce, without the need to register the mark with the United States Patent and Trademark Office (USPTO). Nevertheless, the act of registering

a trademark with the USPTO can offer further legal advantages and safeguards. These include widespread acknowledgment of the trademark proprietor's assertion of rights to the mark, the authorization to use the ® symbol and a legal assumption of proprietorship and legitimacy of the mark.

On the other hand, the EU operates under a "first to file" trademark system. This means that the party who submits a trademark application to the (EUIPO) first will have greater rights than any later users of the same or similar trademark, regardless of whether they have used the trademark in business. Under the first-to-file system in the European Union, it is crucial for firms to promptly apply for trademark registration to get priority over competitors who may apply[943].

2.3.6 Examination process

The trademark assessment processes of the EU and the United States are different. The EUIPO carries out both formal and substantive examinations of trademark applications, ensuring that they comply with formal criteria and possess distinctiveness. The US Patent and Trademark Office (USPTO) primarily emphasizes the thorough assessment of patent applications, although the EU (EU) allows three months for opposition after the publication

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[942] *Ingrida Behri Mustafa, Lira Spiro, Legal Protection of Trademarks, the Albanian Legal Framework for Their Protection Between Defining Similarities and Differences of the European and American System, Interdisciplinary Journal of Research and Development ISSN 2410-3411 (online) / ISSN 2313-058X (print) Vol 11 No 1 / March 2024, p158*

[943] *Justine Pila Seville's EU Intellectual Property Law and Policy - Page 325books.google.jo › books*

, Publisher Edward Elgar Publishing, 2022, P 325.

- Ahmed Adel The Future of Intellectual Property Rights in the Age of Artificial Intelligence, Publisher the Writer Operation, 2024, p164.

- Martin A. Bader, Sevim Süzeroğlu-Melchiors, Intellectual Property Management for Start-ups: Enhancing Value and Leveraging the Potential, ibid p432.

of a patent[944]., and the United States (US) offers the option to extend this term for up to six months[945].

2.3.6.1 Requirement of Use

Neither the USA nor the EU have distinct usage criteria for trademarks[946], albeit with modest variations in the specific rules. To preserve the registration and protection of a trademark in the USA, the proprietor must actively use the trademark in commercial activities[947]. Trademark usage is a standard criterion throughout the trademark registration procedure in the United States. When submitting a trademark application in the United States, entrepreneurs must clearly state the legal justification for their eligibility to register a trademark at the federal level. This is referred to as a filing foundation.

Business proprietors must fulfill all the legal prerequisites for the filing basis they select, as they have various options available. The two most prevalent types are commercial usage and intended use. According to the Lanham Act, a trademark registration can be invalidated if the proprietor fails to use the mark in commercial activities for a consecutive period of three years. Furthermore, if a trademark proprietor initiates legal action to uphold their registered trademark rights, it may be obligated to provide evidence of their utilization of the mark in commercial activities related to the pertinent goods or services.

To maintain registration as well as safeguard a trademark in the European Union, the proprietor of the trademark is required to utilize the trademark in commerce within the EU. Nevertheless, there exist five years following registration during which the trademark proprietor is exempt from the obligation to provide evidence of commercial use. If the registered trademark is not utilized in association with the appropriate items or services during this time frame, it could be susceptible to cancellation or revocation.

Trademark rules differ among states, making it crucial to acquaint oneself with the requisite regulations and prerequisites before commencing the application procedure. Moreover, in case stakeholders are contemplating entering the EU or US market, obtaining assistance from a seasoned trademark attorney will undoubtedly provide the required protection for the stakeholder firm.[948]

In this regard, both the United States and the EU utilize the Nice Classification system[949], which categorizes goods and services into 45 classes to register a trademark. The United States has extensive categories encompassing a wide range of commodities or services, but the EU has more specific categories, necessitating several applications to

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[944] *Justine Pila Seville's EU Intellectual Property Law and Policy - Page 325books.google.jo › books*
, ibid, P 365.
- Gamet-Pol, Franchise Agreements Within the European Community, Publisher Martinus Nijhoff Publishers, 2023 p 98
- Ahmed Adel The Future of Intellectual Property Rights in the Age of Artificial Intelligence, ibid, p164.
- Martin A. Bader, Sevim Süzeroğlu-Melchiors, Intellectual Property Management for Start-ups: Enhancing Value and Leveraging the Potential, ibid, p432.
[945] *Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, 2022, p461*
- Stephen Fishman, Working for Yourself: Law & Taxes for Independent Contractors, Freelancers & Gig Workers of All Types, Publisher Nolo, 12edn ,2022, p62
[946] *Mark J. Davison, Ann L. Monotti, Leanne Wiseman, Australian Intellectual Property Law, publisher Cambridge University Press, 2020 P 603*
[947] *Nazanin Aslani, Hashtags, and Trade Marks: A Comparative Legal Approach, Publisher Edward Elgar Publishing, 2024, P132*
- Sidne K. Gard, Elizabeth Townsend Gard, Just Wanna Trademark for Makers: A Creative's Legal Guide to Getting & Using Your Trademark Publisher C&T Publishing Inc, 2023, P185.
- Stephen Fishman, Trademark: Legal Care for Your Business & Product Name, Publisher Nolo, 2022, P 177.
[948] *Igor Demcak, 4 Differences between trademark registration in the US and the EU https://www.lexology.com/firms/tramatm/igor_demcak, March 22, 2023*
[949] *World Intellectual Property Organization, World Intellectual Property Indicators, Publisher WIPO, 2023. P 194*
· 2023, P 194

safeguard all goods or services[950]. In the US, it is permissible to assign multiple classifications to a single product or service, a practice known as "dual classification." However, in the EU, only one category is allowed[951].

3. International Trademark and Unfair Competition Law

The relationship between markets and rights has significantly impacted the field of trademark and unfair competition conflicts law, as the fundamental concepts of trademark protection under common law might extend beyond national boundaries. The "Bulova test," which was created by the Supreme Court in 1952 to resolve foreign trademark and unfair competition disputes, focuses on the impact of these conflicts on commerce within the United States.

Although there is uncertainty over the specific technicalities of extending foreign rights into the United States, market extensions do involve the simultaneous application of rights across different countries. Trademark rights can transcend national borders, whether they originate from foreign countries or within the United States. The "well-known marks" theory is a means by which the United States fulfills its commitments under article FBIs of the Paris Convention. Its purpose is to prevent any confusion with other well-known marks.[952] Examining whether legal precedent addresses the safeguarding of foreign trademarks provides valuable insights into comprehending Bulova, despite the contrasting situation of foreign rights expanding into the USA compared with domestic rights extending beyond national borders.[953]

3.1 The Well-Known Marks Doctrine:

Transnational goodwill protection has been a topic of debate in trademark law, with early examples found in the 1936 and 1959 New York Supreme Court cases. In the first case, the doctrine of unfair competition was extended to protect a restaurant in France that had become famous under the name "Prunier." In the second case, the protection was extended to the market in which the meaning of the original mark had become known. However, the doctrine of an international zone of expansion has become increasingly problematic under modern socioeconomic circumstances.

Two bedrock principles of American trademark law have come into sharp conflict: the requirement of territorial trademark "use" as a precondition for rights acquisition and the understanding that trademark protection must conform to market penetration. Courts have increasingly reverted to the paradigm of goodwill and its detachment from national-political territories. Recent cases have highlighted the importance of consumer mobility and the need for a famous mark exception to the territoriality principle. Trademark law is at its core about protecting against consumer confusion and "palming off," and there can be no justification for using trademark law to fool immigrants into thinking they are buying from the store they liked back home.[954]

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[950] *Josep Solà, Ricard Delgado-Gonzalo, The Handbook of Cuffless Blood Pressure Monitoring: A Practical Guide for Clinicians, Researchers, and Engineers- Publisher Springer Nature, 2019, P 197.*
- The late Catherine Seville, EU Intellectual Property Law and Policy: Publisher Edward Elgar Publishing, 2016 Second Edition, p 222
[951] *Igor Demcak, 4 Differences between trademark registration in the US and the EU https://www.lexology.com/firms/tramatm/igor_demcak, March 22, 2023*
[952] *Tim W. Dornis Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, Publisher Cambridge University Press, 2017, p151.*
[953] *ibid, p152.*
[954] *Dornis, Tim W. Trademark and unfair competition conflicts: historical-comparative, doctrinal, and economic perspectives. ibid, p154.*

The Well-Known Marks Doctrine, a personality rights idea from the 19th century, states that the reputation of a business cannot be detached from the source that provides the market, similar to how a person's reputation cannot be detached from the person. The goodwill of a trademark is intrinsically linked to the proprietor's business activity, and the trademark and company establishment are closely tied in terms of location and proprietorship. The location where the reputation and value of a wordmark are established is the location of the global enterprise that creates the product unless that enterprise employs different trademarks specific to each country. Unilever's margarine is known by different names in different countries[955]. This idea, referred to as the "indivisible or unitary theory of goodwill," was also advocated by other proponents.[956]

Most courts and legal scholars have dismissed the idea of unitary goodness, contending that its applicability hinges on the extent of a corporation or trade. Critics contend that transnational products may exhibit varying attributes across different countries, which can be attributed to local preferences. They claim that it is important to differentiate between distinct aspects of goodwill. The fundamental inquiry persists: what would occur in situations where neither product distinctiveness nor consumer perception offers a definitive directive for the geographic or territorial division of markets?[957]

The complainant's business in this country has suffered harm due to unfair competition, which has reduced or has the potential to reduce its international commerce. Furthermore, the court adopted the concept of globally consistent norms of integrity in business, in addition to the framework for national hurt caused by foreign trade.[958]

3.2 Global Trademark Prophetization

The trademark and unfair competition conflict legislation in the United States exhibits a specific dilemma. Starting in the 1930s, judges and researchers in the field of trademark law grew more careful when it came to expanding protection to far-reaching product markets. Furthermore, the matter of preventing anticompetitive extensions was vigorously discussed in national legislation, and decision-makers were worried by worries regarding trademark monopolies. The expansion of rights continues to be scrutinized with a critical perspective[959]. However, conflict philosophy never acknowledged the negative consequences of substantial protection. In the realm of trademark conflict law, there has been a prevailing trend that consistently expands property rights and prioritizes domestic interests. There are other potential causes for this advancement.

The phenomenon of trademark extraterritoriality can arise from either a lax or inattentive interpretation of legal precedents or from a well-intentioned (though perhaps naive) desire to safeguard international consumers and promote the effectiveness of overseas markets. Specifically, the issue being discussed is the effectiveness of a method that relies on the extraterritoriality of rights. The doctrinal and structural basis of trademark rights were built on the common law benevolence model, which emphasized the organic, market-based, and nonterritorial nature of these rights[960].

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[955] *In England, it is called "White Lune," in Germany, it is called "Blauband," in Holland it is called "Start," in Belgium it is called "Solo," in France, it is called "Astra," and in Turkey it is called "Sava."*
[956] *ibid, p, 157.*
[957] *ibid, p 158.*
[958] *ibid, p, 165.*
[959] *Dornis, Tim W. Trademark and unfair competition conflicts: historical-comparative, doctrinal, and economic perspectives. ibid, p185.*
[960] *ibid, p186.*

This analysis of issues in trademark and unfair competition doctrine has uncovered a significant difference between the legal systems of common law and civil law. The fundamental principle of civil law doctrine is around the notion of privileges bestowed by the state. The establishment of trademark rights within specific territories is a direct consequence of German pragmatism.

In contrast, US common law has never been tied to territoriality in the same way. Instead, the focus has always been on protecting rights based on usage. These rights are generally linked to the market activity of their proprietors. Nicholas de Belleville Katzenbach has provided a clear and insightful explanation of this significant difference between English and continental law in broad words. The same applies to the comparison between US common law and German or European civil law. [961]

4. Conclusions.

These specific provisions do not allow the unregistered mark proprietor to stop encroachment. Moreover, the claim for compensation for the damage raises some important questions. For instance, what are the reasons that might force the legislators to implement these provisions? Do these provisions apply to all unregistered trademarks in Jordan, including national or international marks? In addition, the author believes that the legislator failed to adequately protect unregistered trademarks, making it difficult to claim compensation for infringement. The author suggests that the legislator consider amending Article 25 of the Trademarks Law to protect mixed trademarks. The author proposes that the Jordanian legislator adopt a mixed system instead of one that depends only on the registration system.

Cconcerning unfair competition, the legislator equated the well-known and local trademarks concerning the protection and stipulated that the trademark should be infringed and that the mark must be used within Jordanian territory. Whether that trademark was violated but not used within Jordanian territory arises. The goods resulting from the violation of that trademark were re-exported to be used outside the Jordanian territory, as the Jordanian legislator stipulated the actual use of the trademark that was violated. The author believes this is an obstacle to providing the necessary protection.

The trademark proprietor can demand the cessation of the infringement by an urgent request even before the damage has occurred. In this case, the plaintiff aims to prevent damage in the future due to the existence of trademarks similar or identical to his trademark. The plaintiff has no right to compensation because the damage has not been realized.

It is possible to claim compensation for infringement of a registered trademark before the criminal courts if the criminal case has been filed, which is called claiming a personal right. For this purpose, in all cases, to file a claim against trademark infringement registered in Jordan or not with due regard to the legal basis for filing a lawsuit between the registered and unregistered trademark, the injured party must prove the infringement fact as forgery or imitation of the trademark or its use without the consent of its proprietor. Alternatively, for any other act that caused harm to the trademark proprietor, the plaintiff must also prove that

[961] *ibid, p186.*

the loss incurred by him was a result of the act of the assault. He must prove that he incurs the loss.

The lost profit, such as the decline in the plaintiff's sales, shall be included in the loss calculation. A causal relationship must be established between the incident of infringement and the damage sustained by the plaintiff under the general rules of Civil responsibility. Therefore, in all cases, the umbrella of civil protection and the compensation claim is the claim of unfair competition.[966]

Chapter 11: Resolving Conflicts stem from Trademark Use and registration through ARD rules

Trademark protection in the domestic market supports economic expansion due to the shrinking risk of piracy[967]. Furthermore, this protection reduces foreign and domestic companies' ability to imitate trademarks, whereby a firm's market power is increased. Undeniably, IP is an essential impetus to a developing country's economic growth and development. However, an effective legal system is critical to realizing intellectual property rights' social and economic benefits by providing remedies for trademark infringement and regulating the use of legitimate IP rights.[968] In this context, the author will discuss ARD rules during the EU law and Jordan law as follows:

1. Trademark Protection under Alternative Dispute Resolutions in the EU

To this purpose, recognizing the functions of IP rights, including trademarks, enhances contribution to the country. However, trademark laws are significantly affected by the procedures used to enforce the rights. The enforcement efforts of a country greatly influence trademark rights, including how they should be recognized and enforced.

With this said, trademark rights are comprehensive, causing a concern that the traditional enforcement of EU courts may need to be revised to solve disputes.

1.1 Is (ADR) preferable for trademark rights dispute resolution?

Convectional litigations may undermine the value of trademarks, plus the underlying rights of the parties. However, formal trademark rights disputes continue to be brought before the legal EU courts despite their ineffectiveness in handling these claims. Worse, those trademark problems are treated similarly to criminal and civil issues.

How can the legal system facilitate the use of trademarks even as some aspects of the law are ineffective in warranting success? Considering the deficiencies in the legal system as a recourse of trademark rights and the inclination of the Sharia law towards agreeable reconciliations, (ADR) methods, especially arbitration and mediation, have increased.

In that context, the study tends to answer the primary question that supports the research: "Is (ADR) preferable for trademark rights dispute resolution"? Are trademark rights disputes arbitral? The research question mentioned above is relevant to the research problem since the answer to that question can help to find a way to improve the Jordanian ADR Law and address the issues presented. In most countries, particularly (the EU), the alternative approach to dispute resolution is no longer considered an alternative approach but a part of the legal process of the judiciary[969]. This preference is partly reflected by the introduction of

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[966] *Brown Jr, Ralph S. "Advertising and the public interest: legal protection of trade symbols." Yale LJ 57 (1947): 1165. PP 1165- 1206.*
[967] *Laik, Kaushik. "Role of Intellectual Property in Economic Growth." Journal of Intellectual Property Rights 10.6 (2005).pp 465-473.*
[968] *Malkawi, Bashar H. "The feasibility of alternative dispute resolution to resolve intellectual property disputes in Jordan." (2013),pp. 146–153.*
[969] *Gayo, Sabela. "THE USE OF MEDIATION AS AN ALTERNATIVE DISPUTE RESOLUTION IN THE RESOLUTION OF INTELLECTUAL PROPERTY RIGHTS DISPUTES." International Asia Of Law and Money Laundering (IAML) 1.2 (2022),pp.101-106.*

legislation that makes it mandatory for conflicting parties to consider ADR before litigations that wish to preserve an ongoing relationship after a dispute resolution. At the same time, trademark rights claims typically cross domestic borders. They involve several parties from different jurisdictions with conflicting legal interests[970].

1.2 traditional enforcement of EU courts

In this regard, trademark laws are highly specialized and technical. Trademark rights claims may be under separate proprietorship, licensed, and assigned wholly or partially to individuals or business entities. [971] With this said, trademark rights are comprehensive, causing a concern that the traditional enforcement of EU courts may need to be revised to solve disputes. Convectional litigations may undermine the value of trademarks, plus the underlying rights of the parties.

However, formal trademark rights disputes continue to be brought before the legal EU courts despite their ineffectiveness in handling these claims. Worse, those trademark problems are treated similarly to criminal and civil issues. How can the legal system facilitate the use of trademarks even as some aspects of the law are ineffective in warranting success? Considering the deficiencies in the legal system as a recourse of trademark rights and the inclination of the Sharia law towards agreeable reconciliations, (ADR) methods, especially arbitration and mediation Additionally, the strict legal court resolution does not give a margin of interaction between the parties of the conflict. ADR provides an alternative solution to litigations, referring to several non-judicial procedures for handling disputes between parties.

1.3 ADR, mediation, negotiations, arbitration, and conciliations

ADR includes mediation, negotiations, arbitration, conciliations, and neutral evaluation. Arbitration and mediation are relevant to this discussion. In this regard, arbitration is a simplified version of a trial where the parties consent to present their claims to the committee of arbitrators, deliberate about the case, and finally issue a written decision binding to the parties.

On the other hand, mediation typically involves a mediator who is the neutral third party. The mediator intervenes to help the parties to solve the contested issue amicably. Albeit non-binding, mediation allows the parties to address their disagreements and continue a viable working relationship.

Most important is the assurance of certainty in resolving the dispute considering the breadth in scope, plus the complexity that may create ambiguity in handling trademark cases. For example, parties often come from different countries with different legal systems. Thus, ADR may be a more reliable option for resolving disputes because it provides a single forum for dispute resolution rather than multiple provisions, where each claimant files a lawsuit in different jurisdictions.

Unlike the courts, ADRs operate with strict privacy and confidentiality. Thus, they allow parties to resolve their differences amicably without jeopardizing future business relationships. Compared to litigations, ADRs provide quicker resolutions because arbitration offers flexibility.

The parties agree on the best timing and the administration of the proceeding. ADR mechanisms are also relatively inexpensive and conversant to litigations. Litigations may span for years and require attorney fees, thousands, and even millions in settlements. In that regard, ADR approaches are flexible and allow the parties to align the issues to their needs

[970] *De Werra, Jacques. "Can alternative dispute resolution mechanisms become the default method for solving international intellectual property disputes." Cal. W. Int'l LJ 43 (2012): p.39*

[971] *Corbett, Susan. "Mediation of Intellectual Property Disputes: A Critical Analysis." New Zealand business law quarterly 17 (2011),pp. 51-67.*

rather than stick to rigid traditional court structures[972]. The 'ordinary Jurisdiction' stipulations of the ADR Rules [973]

Nevertheless, the last interpretation mentions that 'the results of ADR will be binding on both participants and the registry unless judiciary proceedings are started within scheduled 30 days of the notice of the result of the ADR procedure to the parties. It is believed that the ADR Rules relevant to give jurisdiction seem questionable. Nonetheless, in case a lawsuit is brought under a court having Jurisdiction complying with the relevant EU territory rules. Within the conception of 'mutual jurisdiction,' the court can use sections B12(a) and B12(d) of the ADR Rules.[974]

1.4 The current jurisdiction rules of the EU

The current jurisdiction rules of the EU do not contain arbitration yet hold Article 12, which declares an outright exclusion of mediation to its extent. It suggests that any participant state court can analyze the credibility of an arbitration provision and refer matters to adjudication. Frequently, in commercial and business contracts, there will be directed "alternative dispute resolution "(ADR) clauses under which the participants have consented to attempt a form of ADR, typically culminating in mediation.

These stipulations are enforceable, based on the common disagreements of incorporation and reasonableness, and usually consist of (relying on the nature of the contract) suggested ADR procedures, such as conciliation, complied with by arbitration, then adjudication, and also, lastly, arbitration.[975].

Furthermore, the ADR Rules will not limit the tribunal power of the member state that does not have a 'Mutual Jurisdiction' to adopt judgments such as limiting orders or interim injunctions dealt with by the EU Registry. Depending on the ADR rules, the analysis and application of their provisions are to be done 'under the EU. The legal framework will undoubtedly prevail in the instance of conflict. Regarding the choice of legislation, However, the discretion of ADR techniques is limited to the parties.

2. Trademark Protection under Alternative Dispute Resolutions in JORDAN

trademark rights primarily depend on the facilitative and enforcement framework of a country. However, the existing legal enforcement mechanisms may need to improve their effectiveness. Within the context of Jordan, the country, through the secretary for Industry and Trade, agrees that implementing IP laws is a prerequisite for the inflow of (FDI) in the economy. According to the policymakers, a remarkable gain would be presented in creating a better image of Jordan's ability to bring FDI, which is a solution to some of the economic challenges that the country faces. Nevertheless, Jordan's courts have minimal exposure to IP cases, indicating IP's low impact on the Jordanian economy. *Nesheiwat* contends that the enforcement and implementation of trademark rights are weak because there is a lack of coordination between the enforcement agencies that can handle the infringement of trademarks[976].

2.1 Judiciary and Arbitration Solutions

The authority handling such infringement claims resorts to judiciary rather than arbitration solutions. The Jordanian ADR still needs more work, but some ADR mechanisms

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[455] *Corbett, Susan. "Mediation of Intellectual Property Disputes: A Critical Analysis." New Zealand business law quarterly 17 (2011),p.53.*
[973] *article 22 (13) Regulation (EC) No 874/2004.*
[974] *Pedro de Miguel Asensio, Conflict of Laws and the Internet Publisher Edward Elgar Publishing,1st edition, 2020,5.54*
[975] *Susan Cunningham-Hill, Karen Elder, Civil Litigation 2019-2020, Publisher Oxford University Press ,UK,12th Edition,p92.*
[976] *NESHEIWAT, FERRIS. "The Compliance with Intellectual Property Laws and their Enforcement in Jordan-A Post-WTO Review & Analysis." (2012). p142.*

are available in the traditional courts. For example, conciliation and mediation were enacted in 2006 under the Mediation Law. This law also governs commercial disputes. Mediation law allows judges and private mediators to settle disputes.

Since the courts typically involve substantive claims and evidential reviews[977]. The use of ADR to solve trademark rights still needs more work to keep pace with other legislation. In this regard, the question is whether trademark infringement can be arbitrated. Proponents argue that trademark rights claims are arbitrable.

In contrast, Ingen-Housz (2011) argues that some matters about validity, infringement, and other trademark rights claims may not be arbitrable. Aside from scholars' views, Jordan's courts and administrative agencies have an exclusive right to listen to trademark rights-related cases. However, Jordanian law does not contain specific statutory language that guarantees the arbitrability of trademark rights claims. For example, Jordanian courts can only be commissioned to investigate allegations of violation of a business that prints, reproduces, and distributes illegal trademarks.

The law also provides criminal sanctions for trademark rights infringement. [978] Given the infancy of Jordanian laws, they are expected to be underdeveloped enough to handle infringement claims. For example, Malkawi argues that there is no distinction between the invalidity of trademark rights, including trademarks raised in defense of infringement claims, and a claim seeking to revoke the exclusive trademark rights[979].

2.2 Arbitration

Arbitration only covers specific areas, for example, issues of a lapse in protection and the cancellation of registered trademark rights fall within the Jordanian High Court Jurisdiction. Therefore, Jordanian laws are mostly silent on the arbitration of trademark rights and are also limited to the claims that can be addressed. Ultimately, the authority to determine trademark rights claims lies in the judiciary or the state authority body relevant to the claim being pursued. Elsewhere, the Jordanian Arbitration Law widens most of the limitations of the legal courts to cover all legal disputes despite the nature of the dispute's subject matter and the legal nature of the relationships about the contested right. Arbitration law is open to all forms of arbitration, from civil to commercial claims and even contractual to non-contractual claims.

Arbitration is limited to disputes that cannot be conciliated (Alawamleh et al., 2018). The Jordanian Arbitration courts do not consistently deliver specific cases that can be addressed. Thus, the panel of arbitrators can listen to any trademark rights disputes. However, the question relates to whether the arbitrators can hear cases of trademark rights that do not have a contractual agreement. Private claims related to obligations and contractual rights, including license agreements and royalties, can be arbitral.

2.2.1. public claims within the Registrar of Trademarks

In contrast, public claims that fall within the registrar of Trademarks cannot be arbitrated. However, the Jordanian courts need to be more vocal on specific rights issues that ADRs can resolve. As it stands, most Jordanians prefer to use litigations because they can appeal for a judicial decision. A disadvantage of Jordanian arbitration law is that it excludes appellate reviews.

This disadvantage does not mean that arbitral decisions are never reviewed. Reviews exist, but it is constrained. Along these lines, arbitration laws have limited legal barriers in settling trademark disputes in Jordan. As mentioned, IP laws and ADR mechanisms for

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[977] *Al Tamimi, Essam, ed. Practitioner's guide to arbitration in the Middle East and North Africa. Juris Publishing, Inc., 2009.p.299*
[978] *Nesheiwat, F, Ibid 111, 118.*
[979] *Malkawi, Bashar H. "Intellectual property protection from a Sharia perspective." Southern Cross University Law Review 16 (2013): 87-121.*

settling trademark rights in Jordan still need more jobs to be enhanced. For example, claims that fall under public authority, such as copyright laws, are immediately relieved. Criminal sanctions are imposed when they are vested in the state. However, parties that seek injunctive relief may be forced to wait until an arbitration panel is formed.

The process can be long, mainly when one party deliberately employs delay tactics. In such a case, the claimants may be forced to resort to traditional courts, which are readily available to issue injunctive relief. The Jordan Arbitration Law has kept silent about the authority of tribunals to grant interim relief. This matter is an aspect of other arbitration procedures that require court interventions. The arbitrator needs to have the authority to enforce the order. In that direction, the traditional courts can only apply the interim measure. [980] In that respect, the need for more expertise is another challenge affecting the use of ADR for dispute resolution in Jordan. With this in mind, In ADR mechanisms, the dispute parties commonly select the arbitrator who can deal with their case of a dispute. However, trademark rights-related disputes often involve sophisticated technologies and complex valuation issues. Since trademark rights still need an expert arbitrator, trademark rights proceedings are less productive and have less acceptable outcomes.

Despite the ineffective arbitration, the Jordanian government has recently supported enforcing trademark rights. For example, the (AIPMAS) was established in 2003 to address expert trademark rights arbitrators shortages by creating training centers to train judges and arbitrators on complex IP issues. In the meantime, the disputing parties can enlist well-known arbitrators outside Jordan to oversee the arbitration.

In fact, in 2008, the JAL was rectified to allow Jordanian lawyers to engage non-Janian lawyers and others with experience to help resolve arbitration claims[981]. Such an additional recourse to foreign legal counsel and other relevant provisions, especially in international law arbitration, is favorable to settling internal arbitrations, including trademark rights disputes.

Global integration of markets has accelerated the arbitration of intellectual property disputes. To this end, ADR also offers cross-border parties a viable opportunity to go beyond the traditional system of litigations. Since joining the WTO, Jordan has taken tremendous steps to modernize its trademark rights and ADR legislation by implementing new laws and rectifying the most critical aspects to facilitate international trade. However, the laws do not provide a recourse for settling IP-related claims. With time, Jordan may develop applicable precedents for solving trademark rights disputes.

The government will play a significant role in gradually and inevitably implementing Arbitration Laws that consider trademark rights claims. The author believes ADR may be an effective mechanism for settling trademark rights disputes. However, the enforcement mechanism of ADR in Jordan needs to be developed and resolved before the process becomes effective. In any case, all key actors should join forces to ensure that arbitration laws are comprehensive and meet the needs of the stakeholders with particular reference to specific trademark rights claims.

The laws should also be able to provide equitable justice and operate just like the courts in settling trademark rights claims. Creating a statutory provision for ADR for trademark rights disputes may help enhance IP applications in Jordan. Lastly, since studies examine trademark rights enforcement and even ADR within some countries, it would be necessary to undertake more research to understand trademark rights issues settled in and out of the courts.

Conclusion

Trademark protection in the EU promotes economic expansion by mitigating the dangers of piracy and enhancing market influence. Intellectual property rights (IP) play a crucial role

[980] *Ghazwi, Mohamed & Jarrah, Mash'al & Mahasneh, Medyen. (2019). Critical Analysis of Granting Interim Measures in Arbitration in the Context of Jordan Arbitration Law No. 16. 2018. Beijing Law Review. 10. 1100-1115. 10.4236/blr.2019.104059.*

[981] *the Jordanian Arbitration Law No. (31) In 2001*

in developing countries' economic growth and development. However, the effectiveness of trademark laws is greatly influenced by the techniques used for enforcement. EU courts may need to reconsider their enforcement methods to address trademark issues more effectively, as conventional litigation approaches could potentially diminish the significance of trademarks and the rights of the involved parties.

ADR approaches, such as arbitration and mediation, have become more significant because of shortcomings in the judicial system and Sharia law's tendency to favor amicable resolutions. ADR offers alternative methods to resolve disputes, such as mediation, discussions, arbitration, conciliation, and neutral review. Arbitration is a streamlined alternative to a trial in which parties agree to present their claims to a panel of arbitrators, discuss the case, and produce a written ruling that is legally binding on the parties involved. Mediation is when an impartial third party steps in to assist parties in reaching a peaceful resolution to a disputed matter, ensuring a definitive resolution of conflicts.

ADR functions with stringent privacy and confidentiality measures, providing expedited results and adaptability. It is cost-effective and enables parties to tailor issues according to their need instead of adhering to inflexible traditional judicial systems. The efficacy of the Jordanian ADR Law might be enhanced in resolving trademark rights conflicts and guaranteeing the utilization of intellectual property rights within the European Union.

The jurisdiction for disputes regarding trademarks is provided by the (ADR) Rules in the EU, but, its usefulness is uncertain. In Jordan, the country's courts have little involvement in intellectual property (IP) matters, suggesting inadequate enforcement and application of trademark rights. The efficacy and execution of trademark rights are compromised as a result of insufficient collaboration among enforcement agencies. The Jordanian (ADR) system requires further improvement, although, traditional courts do offer specific procedures such as conciliation and mediation as per the Mediation Law.

The issue of whether trademark infringement can be settled through arbitration remains unresolved. The legal framework in Jordan does not have explicit statutory provisions that ensure the possibility of resolving disputes related to trademark rights through arbitration. The responsibility for adjudicating trademark rights disputes rests with either the judiciary or the appropriate state regulatory body overseeing the specific claim in question. The Jordanian Arbitration Law extends the scope of legal courts to encompass all types of legal disputes, such as civil, commercial, and non-contractual claims, by removing most of the constraints. Nevertheless, the panel of arbitrators is limited to adjudicating matters involving trademark rights that are not governed by a contractual arrangement.

Claims that are under the jurisdiction of the Trademarks registrar cannot be resolved through arbitration. Jordanian courts should actively address and express their stance on particular rights concerns that can be resolved through alternative dispute resolution (ADRs). The majority of Jordanians like litigations as they provide the opportunity to seek a court verdict through the process of appeal. Nevertheless, the Jordanian arbitration legislation explicitly prohibits appellate reviews, although this does not imply that arbitral conclusions are immune to scrutiny. Consequently, arbitration regulations in Jordan have imposed few legal obstacles in resolving trademark disputes.

The Jordanian laws about intellectual property and the processes for resolving trademark disputes through alternative dispute resolution (ADR) require improvement. Public authority cases are promptly resolved, although obtaining injunctive relief may be delayed due to the use of strategies to prolong the process. Conventional courts can only

provide temporary measures, but the Jordan Arbitration Law does not have the power to award temporary measures.

Trademark rights-related disputes can entail complex technologies and valuation concerns, necessitating the involvement of expert arbitrators. The Jordanian government has endorsed the enforcement of trademark rights by utilizing the services of the (AIPMAS). Additionally, they have permitted Jordanian lawyers to collaborate with lawyers from other countries to settle arbitration issues.

The process of global integration has expedited the resolution of intellectual property disputes through arbitration, providing parties from different countries with a practical alternative to conventional legal proceedings. The government will have a substantial role in enacting Arbitration Laws that take into account issues related to trademark rights. ADR, or Alternative Dispute Resolution, has the potential to effectively resolve conflicts related to trademark rights. However, it is crucial to establish and address enforcement measures.

Chapter 12 Jordan trademark and Islamic law background

The primary origin of the law is the JORDAN Constitution of 1952). The country's legal system is founded upon Islamic law and French codes[982]. Undoubtedly, intellectual property rights are a significant challenge in most countries worldwide[983]. To this point, (IPRs) in Islamic law, often known as Sharia, are a subject of study and consideration. Arab societies acknowledged the notion of intellectual property, such as cattle labels and poems, before the rise of Islamic civilization.

1. Important background

Authors who seek financial compensation for their poems are also protected by society against plagiarism. In addition, this society had some knowledge of intellectual property rights, albeit in a basic form, particularly about trademarks and copyrights[984]. It is regarded as a harmonious position that strikes an appropriate equilibrium between acknowledging individual proprietorship rights and upholding the benefits of society. However, certain scholars argue that Sharia law does not directly address protecting intellectual property rights and lacks specific regulations similar to those found in inheritance cases. On the other hand, some scholars suggest that the fundamentals and interpretations of Sharia law could offer such protection.

Furthermore, according to Islamic literature, the most extreme perspective regards intellectual property rights (IPRs) as a means employed by industrialized nations to gain advantages rather than benefiting the Muslim community[985]. Most Islamic schools, except the "Hanafi" School, have generally accepted the concept of intellectual property, such as intangible property. The Hanafi School, however, only recognizes tangible property. Their reason is that knowledge and science should be accessible to everyone, including Muslims, and therefore, intangible assets are incompatible with business or trade.[986] Jordanian Literature Intellectual property law encompasses various legal areas, each characterized by its specialized language. Copyright law safeguards the exclusive rights to "innovative artistic creations," encompassing computer software, music, video, architecture, drama, and

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[982] *Oleg Igorevich Krassov, Evgeny Olegovich Krassov Land Law in Middle Eastern Countries - Publisher XSPO, 2022, P 112*

[983] *Amy l. Atchison, Political Science Is for Everybody: An Introduction to Political Science, University of Toronto Press, 2021, p. 389.*

[984] *Khoury, Amir H. "Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trademarks." Idea 43 (2003): 151.*

[985] *Melhem, Basem, Hitham Haloosh, and Qais Ali Mahafzah. "The perspective of moral and financial rights of intellectual property in Islam." Arab Law Quarterly 23.4 (2009): 457-468.*

[986] *Raslan, Heba A. "Shari'a and the Protection of Intellectual Property-the Example of Egypt." Idea 47 (2006): 497.//and / Jamar, Steven D. "The protection of intellectual property under Islamic law." Cap. UL Rev. 21 (1992): 1079.*

literature. Trademark law protects brand elements such as symbols, words, and phrases that recognize services, enterprises, and items. Patent law protects the rights of an innovation for a specific duration as established by legislation.

These encompass the domains of design, plant, and utility. Infringements refer to the unauthorized copying, usage, or exploitation of a work protected by intellectual property regulations without the rightful proprietor's consent. The current impact of collective culture on intellectual property (IP) in the Arab world is characterized by values such as cooperation, community belonging, tribal solidarity, mutual trust, commitment, and support. According to the literature, this influence imposes several constraints on individual autonomy, resulting in diminished individual accountability and restricted freedoms. Thus, Jordan, as a member of the Arab world, exhibits a similar culture driven by the elements above, resulting in a diminished concern for protecting intellectual property rights (IPRs) and a tendency to engage in violations with others.

Jordan also anticipates others to adopt the same behavior, particularly in the pirate context[987]. Nawafleh (2010) argues that robust intellectual property rights (IPRs) are essential for (FDI) in Jordan, particularly in the information technology industry. *Al Sharari and Sirhan* concurred with *Nawafleh's* viewpoint that there is a pressing need for additional human resources to implement intellectual property rights (IPR) enforcement effectively in Jordan. Conversely, inadequate IPRs have resulted in decreased research and development operations and a decline in job opportunities[988].

Nevertheless, this outcome was reached without local evidence supporting such a conclusion. Instead, it relied on foreign reports and research conducted by foreign scholars, which focused on the advantages of intellectual property (IP) rather than a particular evaluation of the local circumstances. This local evaluation indicates that IP laws have minimal influence on the inflow of foreign investments[989]. In Jordan, the enforcement of (IPRs) is inadequate due to an absence of cooperation among the several enforcement bodies that assert their authority to address infringements. In addition, *Nesheiwat* argues that they prioritize legal measures, such as criminal and civil remedies, rather than economic solutions[990]. This approach focuses on introducing innovative products, reducing the financial motivation for those who engage in infringement. In addition, governmental institutions responsible for enforcing intellectual property (IP) laws, such as police departments, the judicial system, excise agencies, and customs.

The administration needs to prioritize addressing IP infringement of rights. As a result, the potential hazards and expenses associated with safeguarding intellectual property rights (IPRs) are heightened due to prevailing social behaviors and procedures. [991]The previous empirical literature has established a U-shaped relationship between income level and the intensity of (IPR) protection.

Wealthy individuals in developing countries such as Kuwait and Saudi Arabia, as well as income level and IPR protection, benefit the economy and enable businesses to participate in creativity. However, both factors hurt economic development in low-income developing countries like Jordan and Egypt.[992]

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[987]*Kurman, Jenny. "Why is self-enhancement low in certain collectivist cultures? An investigation of two competing explanations." Journal of Cross-Cultural Psychology 34.5 (2003): 496-510.*

[988] *Alfaouri, Mohammad Abdulmahdi Amin. "THE IMPACT OF TRIPS ON IPRs PROTECTION IN JORDAN, AS A PRIME EXAMPLE OF A DEVELOPING COUNTRY." Oradea Journal of Business and Economics 5.special (2020): 154-162.//*

[989] *Nesheiwat, ibid, p 44*

[990]*ibid, p72*

[991]*(Papageorgiadis and McDonald, 2018; Al-Khashroom, 2002).*

[992] *Hwang, Hong, Jollene Z. Wu, and Eden SH Yu. "Innovation, imitation and intellectual property rights in developing countries." Review of development economics 20.1 (2016): 138-151.*

224- Malkawi, ibid, p91

2. Islamic perspective on intellectual property outcome

IP is a creation of Western societies' cultural and legal framework. It originated with the Venetian patent statute of 1474 and the Statute of Anne in 1710. It has since evolved through the Berne Convention and the TRIPS Agreement, which were influenced by the legislative priorities of several European countries and, later, the US. The underlying purpose behind the doctrinal development of comparative intellectual property laws is to establish proprietorship rights over ideas and creative works, compensate producers for their investments, or optimize the accumulation of knowledge and cultural creations.

It is essential to identify the Islamic perspective on managing intellectual output and investigate whether this perspective differs from the predominant doctrinal systems of intellectual property. Specifically, it must address the reasons and methods by which Islamic legal doctrine assigns property rights to intellectual creations. The Islamic perspective on intellectual property (IP) is situated within an extensive structure encompassing various dimensions and is rooted in a more comprehensive social justice ideology.

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The main characteristic of this approach is that (IP) is not regarded as a justifiable accolade for the brilliant individual inventor or a means to optimize creativity for the maximum societal benefit. From an Islamic perspective, (IP) is situated within an intricate framework of ethical and practical factors. This framework does not automatically dismiss the use of merit and utility-based reasons for IP but instead places them within a broader context of justice and moral values. The tenets above allocate rights and responsibilities in the governance of culture and knowledge to meet fundamental human needs, enabling individuals to lead healthy and productive lives, foster intellectual capacities, and strengthen their ethical impact on the world. The imperative to compensate investors who provide information to enhance its output must adhere to the idea of equitable equal access to opportunities.

The monopolistic authority over intellectual content should be kept from being translated into the capacity to consolidate control over said content consistently. It is essential to ensure that individuals who engage with guarded intellectual content are fairly limited in their ability to modify or utilize their knowledge and cultural mediums due to financial constraints or the need for authorization from those who control access to these rights. IP (Internet Protocol) is ubiquitous. It intervenes to oversee the allocation of rights and responsibilities for accessing a wide range of knowledge and cultural materials. Patents govern the availability of fundamental knowledge that forms the basis of innovations in medicine, food, and technologies that enhance our daily lives and increase efficiency.

Copyright regulates the accessibility and utilization of educational resources across various academic levels and cultural creations, encompassing literature, art, and digital content disseminated on internet-based platforms. IP significantly affects individuals' capacity to lead healthy lives and utilize their intellectual capacities to transform texts, images, and inventions in their surroundings into innovative formats. The worldwide structure of the Internet Protocol (IP) was primarily established through two crucial milestones. In the late nineteenth century CE, a consensus was reached among prominent European colonial powers, such as Belgium, France, Italy, Portugal, and the United Kingdom, establishing the Berne and Paris conventions. These agreements were explicitly designed to safeguard copyrights and patents. The conversation at that time mostly revolved around creators, as reflected in the vocabulary.

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2.1The global regime

The ' global regime aimed to incentivize authors and inventors by granting them property rights over their innovation and culture. This was done to stimulate the growth of international markets. Sam Ricketson and Jane Ginsburg observed that the primary focus of the drafters of the 1886 Berne Convention for the Protection of Literary and Artistic Works was to safeguard the individual rights of authors and enhance the extent of protection granted to them. In 1994, the second significant achievement was reached with negotiations and the finalization of the (TRIPS Agreement). During that period, the United States became a significant new participant in the global intellectual property (IP) arena, joining the established colonial club. Its entry profoundly impacted the extent and potency of property rights about knowledge and culture.

On this occasion, the focus of the forum and the items discussed in the negotiation process agenda primarily revolved around commerce and trade. The commerce event included discussions on intellectual property (IP) matters, which were crucial in shaping the framework of the World Trade Organization (WTO). The investigation of the Uruguay Round, which preceded the implementation of the TRIPS Agreement, demonstrates that the allocation of rights and responsibilities in the realm of information and culture was predominantly deliberated on financial terms. Enhancing and fortifying property rights through innovations and other forms of cultural expression were perceived as the most effective means to stimulate incredible innovation and creativity for the most significant benefit of the inhabitants in the countries that signed the Agreement.

Essential players in industries that heavily rely on intellectual property, such as pharmaceuticals, computer software, entertainment, and biotechnology, pressured countries that export intellectual property, particularly the US, to establish additional rights, reinforce them, and implement robust enforcement procedures. The objective was to enhance their market presence in developing countries.

Education and cultural knowledge are the standard, whereas availability is the rarity. In general, the other regions of Asia, Africa, and South America adopted the current global framework of IP. The user did not provide any text. Before the TRIPS agreement, intellectual property regulations were introduced into the legal frameworks of emerging nations through colonialism. Indeed, four prominent nations - France, Germany, Spain, and the United Kingdom - utilized Article 19 of the Berne Act, a provision within the Berne Convention for the Protection of Literary and Artistic Works, on September 9, 1886[993]. This provision granted them the authority to join the Agreement to benefit their territories, extending the reach of copyright laws to most developing countries. The TRIPS aimed to strengthen and broaden the power and extent of the “intellectual property “rights established under previous systems[994]. Even though the developing nations of Asia, Africa, and South America were sovereign at the commencement of the discussions in 1986, their impact on establishing standards for the Agreement was negligible. Upon examining the historical trajectory of the TRIPS Agreement discussions, Peter Drahos and John Braithwaite uncovered a notable discrepancy in the relative bargaining power between developed and developing nations, with the United States assuming a prominent leadership role.

Major industrialized nations possessed a clear and precise understanding of their objectives. *'Illey* arrived equipped with customized draft clauses designed to safeguard their interests—significant payers of taxes. Developing nations require sufficient information and expertise regarding the potential impacts of the TRIPS rules on the availability of medical and educational resources and indigenous innovation capabilities. In addition, the United States pressured developing nations to comply with the minimal requirements for “intellectual property “protection.

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[993] *James Raven, The Oxford History of the Book Oxford University Press, 2023, P 289.*
- Biotechnology Law and Policy: Emerging Legal Issues, Cases and Materials, Springer Nature, 2023 p78.
[994] *Matthew David, Debora Halbert · The SAGE Handbook of Intellectual Property 2014, p 136.*

The American regulation was enforced in 1989 to target developing countries who opposed the US perspective on the content of the TRIPS Agreement.[995] Brazil and India have been put on the Priority Watch List, signifying they are the country's most deserving of trade penalties. On the other hand, Argentina, Egypt, and Yugoslavia were included in the Watch List. Developing nations could not engage.

In negotiations, they had to either agree to the minimal criteria advocated by the US and its allies or risk facing penalties that would inevitably damage their economy in the immediate future. Here is a preliminary depiction of how the existence of an "intellectual property "item would be shaped according to the prevailing theoretical frameworks of the international "intellectual property "system: If an individual creates a musical composition, they have the option to either have somebody perform and disseminate it without charge or to sell it to others.

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minate it without charge or to sell it to others.

Nevertheless, the most promising opportunity to generate substantial wealth would likely arise if a prominent distributor, such as Universal Music Group (UMG), opted to acquire your copyright in exchange for a one-time payment. UMG is granted the authority by copyright law to commercially distribute the song to the public and exercise dominion over its usage, including the manner, timing, and locations of its utilization by others.

Essentially, if another individual were to utilize the music, either in its whole or a portion of it, to produce a documentary or a family video to be shared on the Internet, they would be required to acquire consent from UMG and maybe compensate them with fees. UNIG has the option to deliberately delay their response when approval is needed. The song attains cultural significance when performed inside the public domain. Copyright law does not categorize it in that manner; rather, it is regarded as an intellectual creation safeguarded by various legal accountability regulations.

There are several situations in which the law permits content reuse for specified reasons related to education, free expression, etc. Furthermore, it is accurate to state that certain countries have a comprehensive "fair use" privilege, which permits the creation of creative works using copyrighted material. Nevertheless, the author will demonstrate throughout this book that licenses to reuse are presented as exemptions that should be understood restrictively. These rights are not recognized as legal entitlements for the general public, which can be utilized to transfer power and initiate change.[996].

The notion of "intellectual property "is not novel. British law protected intellectual rights in 1710, and the Statute of Monopolies in 1623 provided legal protection for creative works[997]. During the 19th century, the term "intellectual property" emerged[998]. Throughout the years, numerous legal rules about "intellectual property "have developed, and the legal principles related to "intellectual property "have undergone development. Poetry held greater vergence during the pre-Islamic period, and its creators were Held in high regard and esteemed. Poets received remuneration for publishing and disseminating their writings as a token of acknowledgment of the worth of their creations. Three Lesser accomplished poets were enticed to engage in different sorts of larceny to augment their reputation and financial status.

Nevertheless, these poets were typically excluded from mainstream cultural circles.[999] During the time before the rise of Islam, communities placed importance on intellectual creations and considered them as potential forms of intellectual property, particularly in terms of moral rights.

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[995] *American Trade Act section 301*

[996] *Ezieddin Elmahjub, An Islamic Vision of Intellectual Property: Theory and Practice, Publisher Cambridge University Press, 2019, p4*

[997] *Sherman Brad and Lionel Bently, The Making of Modern Intellectual Property Law: The Brit- ish Experience (Cambridge University Press, 1999) 207. The origins of copyright and patent law are now seen as located in the British Statute of Anne 1710 and the Statute of Monopolies 1623:*

[998] *Mark A Lemley, 'Property, Intellectual Property, and Free Riding' (2005) 83 Texas Law Review 1031, 1035.*

[999] *Amir H Khoury, 'Ancient and Islamic sources of Intellectual Property Protection in the Middle East: A Focus on Trademarks' (2003) 43 IDEA: The Journal of Law and Technology 151, 153.*

However, this acknowledgment was still in its early stages and still needs to be fully developed. Sharia, along with civil law, Jewish law, and common law, is recognized as one of the prominent legal systems worldwide, and it adheres to the principles of law and the process of lawmaking. Understanding Sharia law and its origins is crucial to gathering proof of the correlation between the proprietorship of "intellectual property "and Islam[1000].

2.2 The Legal Classification in Islam

In Islam, the law can be categorized into two main components: the revealed and non-revealed. In its disclosed manifestation, the Sharia derives its authority from two primary sources: the Qur'an, the Last Testament, and the teachings of the prophet, encompassing both traditions and "Sunnah." There are undisclosed origins of Sharia law that Muslim legal scholars formulated after disclosing the holy Qur'an and the *"Sunna."* Furthermore, Islam is a comprehensive religion encompassing laws governing all aspects of life. Islamic rules encompass many subjects, including specific times for daily prayers and fasting, restrictions on consuming particular foods, regulations on getting married, passing on wealth, and business. [1001]

Islam developed as a religion that encompasses both the spiritual and worldly parts of life, aiming to govern the individual's connection with Allah and human interactions within a societal context. Hence, Islamic law regulates nearly every facet of existence. Incorporate Ijma, which refers to the consensus of Muslim scholars on law matters, and Qiyas, a precise logical perceptive used in *Ijtihad*. The following sources are considered authoritative in the field of jurisprudence (Usul al-fiqh), which encompasses both deductive (from general principles to specific cases) and inductive (from particular cases to general principles) modes of reasoning.

Additional sources for undisclosed law under Sharia encompass ijtihad (individual intellectual endeavor and autonomous logic), "Istihsan" (fairness or juristic preference), "Istishab" (presumption of uniformity), Istishab" or "Masala "(perspective based on public interest), "Darura" (compulsion), "Urf" (custom), and the fatwa giving of Muftis (jurisconsults), such as the "Egyptian grand mufti Muhammad Abduh."[1002]

If it is not feasible to find an explicit endorsement of a lawful proposal in the "Qur'an and "Sunna," a Muslim legal expert will endeavor to identify a precedent that all legal academics or jurists universally accept. Reach a consensus on a specific legal principle or understanding. Consensus can be considered a reliable authority for legal matters. Analogical reasoning, or qiyas, is characterized by a stringent approach. Initially, it is imperative to locate a passage in the Qur'an, a prophet's "Sunna," or a guideline that has been unanimously agreed upon as the starting point. First, we must identify the situation's cause, purpose, or reason. Then, we have to explain the connection between each aspect: the component with a rule and the one to which we consider applying the rule. This clarification ought to prove that expanding the rule is justified. For instance, the Qur'an's prohibitions of consuming *Alcohol* encompass all other alcoholic beverages without any ambiguity. [1003]However, the exemption from fasting due to illness and travel cannot be expanded. Introducing the notion of difficulty into the discussion is unproductive as travelers would only occasionally perceive fasting as burdensome.

Furthermore, hardship is a complex and ambiguous notion. The underlying intention or rationale behind the rule is not just to create difficulty. Hence, the expansion of the leniency would not be specific or well-defined and specified. [1004]Consensus among Muslim academics affirms that

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[1000] *,p88*

[1001] *M Cherif Bassiouni & Gamal M Badr, 'The Shari'ah: Sources, Interpretation, and Rule-Making' (2002) 1 UCLA Journal of Islamic & Near East Law 135, 149.*

[1002] *Hasbullah Haji Abdul Rahman, 'The Origin and Development of Ijtihad to Solve Modern Complex Legal Problems' (1999) 43(2) The Islamic Quarterly 73, 75–6;*

[1003] *Gamal M Badr, 'Islamic Law: Its Reaction to Other Legal Systems' (1978) 26 American Journal of Comparative Law 187, 189.*

[1004] *Malkawi, ibid, p91*

the “Qur'an” serves as the fundamental basis of Islamic jurisprudence.

Nevertheless, they hold divergent opinions regarding the hierarchy of other sources of Islamic law. As a result, four main law schools have emerged in” Sunni Islam”: the “Hanafi, *Maliki, Shafi'i,* and *Hanbali*.”[1005]The Abou Hanifa scholars base their legal judgments on rationality and personal decisions, drawing upon analogy and fairness as legal foundations. The “Maliki School” adheres strictly to the Prophet's teachings, “Sunna,” and downplays the Significance of personal opinion. The Shafi'i School has endeavored to harmonize the ideas of the Maliki and Abū Hanifa schools, which enjoyed significant patronage from the caliphs and flourished in competition with other doctrinal schools. [1006]

Al Shafi'i, the progenitor of the al-Shafi'i law school, established the field of Islamic jurisprudence. He was the inaugural jurist to collate and systemize Islamic sources of law.The Hanbali School is renowned for its rigorous adherence to the “Qur'an and “Sunna” texts. The analogy is acknowledged as a foundation of Hanbali jurisprudence.

The Sharia encompasses a comprehensive framework that categorizes all potential human actions into five distinct classifications: obligatory, recommended, neutral, disagreeable, or banned. Allah, the ultimate legislator, determines these classifications. Eighteen Prayers and fulfilling the obligation of paying Zakat are necessary, whereas drafting a will is advised. [1008]Engaging in activities such as drinking alcohol and eating non-halal food are severely forbidden.

“The Quran” and other sources of Sharia do not guide other actions. In this scenario, these behaviors are deemed permissible based on the principle that everything is allowed until specifically banned by Allah. The acceptability of “intellectual property “protection is often justified by the absence of any explicit statement(s) opposing it in the Qur'an or other Sharia sources. “*The Caliph,”* who serves as Allah's representative among his people, or in contemporary terminology, the government, has the freedom to take action as long as the laws implemented are based on Sharia principles. The categorization of actions demonstrates the extent of adaptability and practicality adopted by Islamic law.

2.3 Intellectual property rights in Sharia law

Islamic law did not specifically govern “intellectual property “rights with explicit and specific regulations akin to those about religious obligations or inheritance. Nevertheless, Sharia's various origins of law encompass several regulations and illustrations that facilitate the establishment of links between “intellectual property “and Islamic law. This article explores the origins and evolution of “intellectual property “standards designed to fulfill the requirements of the time. It also evaluates the justifications and responses for protecting “intellectual property “per “Sharia law.”

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2.3.1 Intellectual property as a tangible property.

Muslims hold the belief that all property is the rightful possession of Allah. [1010]The private property proprietor is a trustee or agent for Allah, the ultimate proprietor. However, Islam highly values the sanctity of private property.

[1005] *David Bonderman, 'Modernization and Changing Perception of Islamic Law' (1968) 81 Har- vard Law Review 1169, 1174.: ibid.*

[1006] *Wilferd Madelung, edited by Sabine Schmidtke, Studies in Medieval Muslim Thought and History Publisher Taylor & Francis, 2022,P42.*

[1008] *Quran the last testament, 2:43, 149, 180*

[1010] *The Qur'an states 'Unto Allah belonged whatsoever is in the heavens and whatsoever is in the earth'. See also Qur'an 3:129*

During his final journey, Prophet Muhammad stated that a Muslim is not permitted to claim proprietorship of any property belonging to another Muslim unless it is willingly given as an act of kindness. Do not harm yourselves by mistreating his heart[1011]. Sharia law balances collective proprietorship and individual rights and property, drawing from Western concepts, namely those of English and North American origin. Most Sharia law schools concur on the acknowledgment of "intellectual property "as a form of property. The Hanafi School deviates from the norm in its interpretation of property.

This mainly stems from a debate on the appropriate criterion for defining what can be classified as mal (money). As per the Hanafi School, *Heiaza* (physical proprietorship) is the sole valid monetary criterion[1012]. They exclusively accept tangible assets as payment and eventually as property[1013]. Therefore, the Hanafi School primarily focuses on tangible items that can be perceived.

Through the five senses, it is considered property. According to Sharia law, they cannot be granted legal rights as intellectual property due to the abstract character of concepts resembling celestial things. Conversely, the Malki, Shafie, and Hanbali Schools concur that the appropriate standard should be *Manfa'a*, which refers to utility.[1014].

These schools see both material and intangible assets as property. Property refers to any tangible or intangible asset that is useful and valuable. Therefore, it might be inferred that "intellectual property "protection would be considered an authorized action. According to Sharia law, individuals can get real assets possession of either through contractual agreements or other ways. According to the concept of appropriation, an individual is allowed to. One might obtain a proprietorship of unoccupied real estate by developing and utilizing it to generate income. Private property proprietorship can also be obtained by obtaining and possessing elements from the soil or public land.

This resembles Locke's labor theory and the 'sweat of the brow' criterion in the context of "intellectual property "rights.[1015] Therefore, proprietorship is granted to an individual who puts forth efforts in creating materials and is consequently entitled to the benefits of their work. Individuals who invest their time and effort in producing original creations, whether tangible or intangible, should have the right to receive the worth of their creations.

Sharia acknowledges the principles of the division of proprietorship and the utilization of assets by third parties. These notions can enable the person with a title to separate proprietorship and usage by offering a third party the privilege to utilize the property rights by surrendering possession. The division of proprietorship rights for property under Sharia law is analogous to the contemporary system of granting licenses for "intellectual property "rights.[1016]

While Sharia law does not explicitly include specific provisions for protecting intellectual property, it can be argued that "intellectual property "is not forbidden under Sharia law. There are no explicit prohibitions in the original texts of Sharia that restrict proprietorship of physical goods. The term "property" in Sharia law might possess multiple interpretations, necessitating an examination beyond traditional definitions. Sharia law can adapt to incorporate and safeguard "intellectual property "rights in response to changing circumstances.

[1011] Muhammad Al-Ghazali, Understanding the Life of the Prophet Mohammad (International Islamic Federation Student Organization, 1997), 457.
[1012] Muhammad Wohidul Islam, 'Al-Mal: The Concept of Property in Islamic Legal Thought' (1999) 14 Arab Law Quarterly 361, 363.
[1013] Ibid 361, 364.
[1014] Ibid Quarterly 361, 363.
[1015] Donna M Byrne, 'Locke, Property, and Progressive Taxes' (1999) 78 Nebraska Law Review 700, 703
[1016] Winston, Elizabeth I. "Why Sell What You Can License-Contracting around Statutory Protection of Intellectual Property." Geo. Mason L. Rev. 14 (2006): 93.p 120

2.3.2 The Legitimacy of Acquiring Financial Gains

Historically, the purpose of "intellectual property "protection has been to motivate innovation. The economic incentive hypothesis grants writers or inventors the sole privilege to reproduce their creations for a restricted duration. "Intellectual property "proprietors have the right to reap the advantages of their creative work fully. Owners of "intellectual property "rights can transfer their rights to individuals or entities who may place a higher value on them. However, the economic incentive hypothesis is only partially accurate.

"Intellectual property "also encompasses a crucial dimension of natural rights. An individual who works on resources that are not owned by anybody or are collectively owned possesses an inherent entitlement to the outcomes of their labor, and it is the responsibility of the government to acknowledge and uphold this intrinsic entitlement. Assigning a patent right to an inventor recognizes that the innovation would not have been created without the inventor's efforts and restricts access to the invention by others.

Anyone's ability to access or utilize the invention depends on obtaining the patent holder's consent. "Intellectual property "can also be justified on the grounds of trade and profit, in addition to the traditional justifications of property and hard effort. Trade encompasses not only tangible goods but also involves the exchange of "intellectual property "items to generate profits. Sharia promotes commerce with some limitations. Generating profit encompasses various forms of commerce and intellectual assets. Creators should be entitled to a concrete reward for their commitment of time and effort. Generating a financial gain does not inherently validate intellectual property but permits it. Profit-making aligns with the financial motivation concept of the "intellectual property" right.

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The quest for gain is not inadequate but a commendable endeavor. The Qur'an affirms no wrongdoing in seeking legitimate gains from one's Lord. Furthermore, it declares, 'Oh, you who have faith!' Do not squander your possessions on frivolous things among yourselves. Instead, engage in trade and commerce with one another through mutual friendliness. The Qur'an also states: 'O my people! Administer justice impartially, ensuring fairness and accuracy in measuring and assessing people's possessions. Furthermore, refrain from engaging in evil actions that promote the degradation of the earth. These verses indicate the potential for producing profits. According to various assessments, numerous writers in the early Islamic era sustained themselves financially with their literary creations.

Caliphs would hire authors to make books in exchange for remuneration. [1017]Emirs, who held prestigious positions like a prince, would compensate poets who spoke highly of them. [1018]The payments were legally enforceable and not considered an honorarium. They were given in exchange for completing an intellectual production, like with the current concept of works done for hire. Dedications have a lengthy historical legacy. Authors in dire financial circumstances devoted their literary creations to rulers or affluent individuals with the expectation of getting a valuable present or reward. The key driving force throughout the period was financial incentives. The *Shafi'I, Hanbali,* and *Maliki legal* traditions allow for the inclusion of incentives, such as leases, in financial agreements.[1021]. "Intellectual property "treaties encompass financial components, enabling "intellectual property "rights holders to recoup what they invested from what they have created. Nevertheless, proponents of the Hanafi school of law contend that knowledge or science should not

[1017] *Malkawi, p91*

[1018] *Emirs came to use such poets towards propagandistic ends. See Abdul-Fattah Kileto, Writing and Tanasukh: The Concept of Author in Arabic Culture (Casablanca: The Arabic Cultural Centre, 1982) 34–5.*

[1021] *Hasan M Buda, Rights and Obligations of Author in Publication Contract in Light of Islamic Fiqh (2005), 94*

be considered equivalent to trade or industry.[1022].

Individuals ought to commit themselves to disseminating information without anticipating monetary compensation. There should be no hindrance to replicating original substances, as the extensive distribution of knowledge benefits everyone.[1023]. These Hanafi academics believe that specific types of "intellectual property "should be considered public assets and that knowledge, along with its creations, should be utilized for the collective welfare of humanity. Conversely, it is acknowledged that creativity cannot thrive unless an individual is justly remunerated for their endeavors. The majority of Sharia schools of law acknowledge that it is lawful to earn profit from one's endeavors.

The Qur'an, "Sunna," and distinctive symbols of Islam, such as mosques and the welcoming of "Assalam-u-Alaikum" (peace be upon you), collectively form an exceptional manifestation of intellectual property. [1024]Hence, it is vital to safeguard and capitalize on the creative endeavors of individuals. Distinguishing features exist between widely recognized forms of secular "intellectual property "rights, like copyrights, patents, and trademarks, and knowledge-based Islam. The former results from human intelligence, creativity, and hard work. Unlike other types of assets, humans cannot generate Islamic assets. "Intellectual property "typically has a commercial purpose and is safeguarded for a limited period.

Contrary to intellectual property, the safeguarded knowledge of Islam is not available for purchase or commercial use, and it remains eternal. The sacred teachings of Islam are universally accessible for the collective welfare of humanity. Reproduction and dissemination of the Qur'an can be done without any restrictions or financial obligations towards individuals, families, or nations. This work has been copyrighted indefinitely as the genuine creation of Allah. None of these assets can be claimed as the property of any individual, family, or nation.

proprietorship does not extend to the knowledge-based assets of Islam, in contrast to "intellectual property." According to Sharia law, one may inquire whether a writer or inventor can recoup more than what they initially invested in their work. It is indisputable how a writer or inventive can recoup what they originally invested.

However, individuals with "intellectual property" rights can accumulate riches excessively in specific cases. This may give rise to the problem of riba. Fourth, in Sharia law, earning profits without putting forth significant effort over a long time is considered *riba*. The Qur'an states, 'Allah has made buying and selling permissible and interest unlawful.'[1025]

2.3.3 A recognition of rights of morality.

Moral and ethical rights are associated with the authors. Separate from the set of rights that safeguard commercial interests in artistic creations. Moral rights encompass four fundamental entitlements: the entitlement to be credited, the entitlement to preserve the work's integrity, the entitlement to disclose the work's creation, and the entitlement to retract the work. Financial entitlements can be conveyed or allocated to others in exchange for royalties. Conversely, moral rights are not capable of being transmitted. [1026]Ethical obligations are inherent and everlasting. But, the original author of the copyrighted work always retains moral rights.

The foundation for these rights lies in the inherent connection between the work and its creator. The author is entitled to assert or renounce the proprietorship of a piece of work

[1022] *Ibid p 88*
[1023] *Ibid, p94.*
[1024] *Khan, Ali. "Islam as Intellectual Property'My Lord! Increase Me in Knowledge.'." Cumberland Law Review 31 (2001): 361.p15-20*
[1025] *Holy Qur'an 2: 275–278*
[1026] *Brian Angelo Lee, 'Making Sense of "Moral Rights" in Intellectual Property' (2011) 84 Tem- ple Law Review 82.*

(authorship) and protect it from alterations, defacement, and other modifications that could harm their reputation or honor (integrity).[1027] According to moral rights, an author has the right to prevent others from claiming their work as their own or restricting the use of their work, such as in parody, if they believe it will harm their reputation. By scrutinizing the history of pre-Islamic and Islamic eras, one might discern the emergence of primitive moral entitlements.

During the pre-Islamic period, a poet would publicly perform his poems, so asserting his exclusive rights over them.[40]. The poems performed during such localized public gatherings would spread widely over the entire region, attributing the name of the original poet. Recitation and attribution of the author's name were fundamental moral rights. The unauthorized use might have been interpreted as a sign of contempt towards the poet, which could have potentially sparked a public backlash. Public reading at that period is similar to the contemporary practice of exposure.

4. Conclusions

A comprehensive comprehension of the origins of Islam is essential for determining the fundamental principles that underpin safeguarding "the rights to intellectual property. From a conceptual standpoint, it is accurate to assert that there is a greater convergence in the connection between the protection given to "intellectual property "and the essence of the Sharia, especially when examined from a historical viewpoint. The Muslim world is familiar with "intellectual property "(IP). While there is an ongoing discussion amongst Muslim academics, "intellectual property "has been understood to be a component of personal property.

Sharia acknowledges certain fundamental types of "intellectual property" rights. Proper attribution must be provided to the originator of the idea. Most Sharia schools of law allow for the acquisition of profit from an individual's endeavors. An author or inventor can recover their initial investment and more if the sum paid is equitable and commensurate with the time and work expended. "Intellectual property" grants the exclusive right to exploit for a particular duration commercially. "Intellectual property "theft incurs criminal sanctions, including fines and imprisonment.

Nevertheless, having current "intellectual property "rules that adhere to the TRIPS agreement does not provide a complete solution to the difficulties of enforcing them. Arab countries have implemented numerous "intellectual property "laws, but their enforcement is often inadequate. Religious views, traditional societal norms, and economic issues contribute to this situation. Some maintain the belief that property is common and belongs to Allah. According to this perspective, distributing" intellectual property "items is not considered a breach.

The primary objective of creativity is the widespread distribution of information for the benefit of society as a whole. Moreover, specific individuals saw the infringement of "intellectual property "rights as a method of seeking retribution for the Western domination of Arab nations, whether in terms of commerce or other aspects. Another challenging aspect that impedes the safeguarding of underlying "intellectual property "in the Islamic world is the inherent communal character of Arab culture. This poses difficulties in introducing "intellectual property "concepts into a society that strongly supports community principles.

The Jordanian Trademark Law offers punitive safeguards for trademarks that have been officially registered while providing no legal protection for trademarks that have not been registered. The protection is temporally and geographically restricted, with coverage exclusively applicable during the ten-year registration period or renewal phase. International conventions or treaties do not exclude protection. Under the provisions of a bilateral agreement or international convention that provides reciprocal protection, every citizen of the member state has the right to apply to the registrar to safeguard their trademark.

[1027] *Lorie Graham and Stephen McJohn, 'Thirty-Two Short Stories About Intellectual Property' (2010) 3 Hastings Science & Technology Law Journal 1, 66.*

The scope of protection is confined to the geographical boundaries of the registered jurisdiction, with no provision for preserving a registered trademark beyond the borders of Jordan. Cheating can lead to incarceration, monetary fines, or penalties for counterfeiting, unauthorized use, or selling items containing a registered trademark. Moreover, failure to register a trademark can lead to a penalty of up to 50 dinars for each violation.

Despite its mainstream support for intellectual property, the property violation depended on the religious conscience of individuals to protect intellectual property at that time, contrary to modern days. Despite the severe punishments of the Jordanian law, this phenomenon is still present in society. One of the reasons for that is the nature of society; it seems this kind of violation makes people feel guilty, maybe because they don't believe that using fake brands is allowed religiously. Furthermore, the authors believe that the Jordanian legislator did not consider tightening the penalty for duplication of intellectual property violations. To protect intellectual property effectively, the Jordanian legislator must take into consideration the EU law that severely punishes intellectual property.

Chapter 13 Conclusion and Results and 'Recommendations'

In this study, the author answered the primary question to approve the hypothesis that those questions stem from them as follows :

1. Conclusion and Results

A1 to Q1 *As for whether the Jordanian legislator considers registering or using a trademark essential to protect it? What are the shortcomings of various laws on protecting trademarks in Jordan? This study identified the priority of the trademark rights protection standards in Jordan. Besides that, the study successfully recognizes the rights of trademark proprietors. The author highlights the trademark monopoly under the JTML and the legal provisions governing trademark protection and proprietorship.*

In this regard, the author has analyzed Jordanian law and taken the registration as a clue for trademark proprietorship as it can prove that it is reversible and has already established the priority of trademark use. In this context, the Jordanian judiciary has settled trademark registration as a presumption of the mark proprietorship; even if it is a Presumption of proprietorship of the mark, it is permissible to demolish this presumption with counter-evidence."

This verdict has been recognized by the Court of Justice of the EU and adhered to." the burden of prior use falls on the plaintiff. The plaintiff has the right to prove this through all means of proof because the fact of the earlier use is material". It is noted that the easiest way to establish rights in a trademark is through trademark registration. Despite the emergence of the right to the used trademark, it did not have protection like the registered trademark, which means the registered trademark enjoys more legal protection than the unregistered trademark. The deficiencies of different laws on trademarks can be detailed as follows: the JTML provides that if the trademark is not registered in the Kingdom, no person may file a compensation action for any infringement on any trademark[1079]. However, Jordan law may request a cancellation of a trademark registered by someone who does not own it. According to JTML, the legislator did not consider the efforts exerted by the proprietor of a famous trademark in promoting the trademark and maintaining the quality of the product or

[1079] : *Article 33 of the JTML*

service it represented when withholding compensation for him in case his trademark was not registered. In this context, it is apparent that the JTML violates the general rules of civil liability stipulated in the Civil Code, specifically compensation for the harmful act. Accordingly, a claim for compensation for infringement of an unregistered trademark in Jordan cannot be established; Trademarks Law grants the injured person the right to claim compensation for infringing his registered trademark only[1080].

Also, JTML provides that "the proprietor of a trademark registered in the Kingdom may request the Jordanian court to do the following, provided that his request is accompanied by a bank or cash guarantee acceptable to the court…,....." when he was filling his civil or criminal case or while such action is being heard. Such a right is exclusively given to the trademark proprietor.

Moreover, the law of unfair competition and trade secrets unequivocally did not provide civil protection for trademarks not registered in the Kingdom or used inside[1081]*. However, It remains subject to infringement without civil protection due to the existence of trademark law*[1082]*. The infringement of a right related to a trademark entered in Jordan and not used in it remains outside the scope of the protection because the latter has assumed the absence of competition by the absence of actual use of trademarks - infringed upon - in the Jordanian market.*

A2 to Q2 *The fundamental question is whether the Trademark Act protects the rights of the consumers. According to Trademark Law, the trademark proprietor has the right to initiate a civil or criminal lawsuit against any infringement to prevent any confusion, registration, or use of any similar trademark for similar products and services. In other words, legislators discarded the idea that the customers are the target group in the investment industry and marketing process.*

Both can determine the trademark value according to the percentage of demand to make any trademark popular in the market. Therefore, trademark proprietors and competitors will continuously make efforts to attract consumers. Thus, the trademark system should not deny the consumer audience's role without consideration. Finally, the provisions of the trademark code must provide legal protection based on the trademark's nature, not only on the proprietor's right to it. Legal protection must be given to the trademark.

The provisions of the trademark laws should be based on such trademark and their nature, not only on the proprietor's right to them. Since most famous trademarks are not registered in Jordan, the author believes that the Jordanian Trademarks Lawn needs to be amended to protect famous unregistered trademarks[1083]*.*

A3 to Q3 *The study's main question is whether the legislator imposes compensation on the trademark infringer or forger deterrent to prevent the infringement internationally and nationally. This study shows that the phenomenon of trademark infringement remains widespread, and the reason for this may be due to the inconsistency of penalties and fines with the benefits and profits that the infringer may earn on the trademark. Therefore, the value of the prescribed fines should be increased, and penalties for physical coercion should be tightened. One of the trademark infringement indicators in Jordan is the annual statistics of counterfeit trademarks seized by the concerned authorities. Furthermore, the vision of*

[1080] *Article No. (33) of the Trademarks Law*
[1081] *Articles (2/A & B) and (3/A) of the Law of Unfair Competition and Trade Secrets No? (15) of 2000 e*
[1082] *Article (33) of trademark law*
[1083] *article No (33) of the JTML.*

governmental and administrative institutions applying the IP's law, such as the police department, excise agencies, and Customs Directorate, do not consider IP, including trademark infringement in particular, to be a prime priority. Accordingly, as the author believes, this vision would increase the risks and costs linked to the protection given to the trademark.

The presence of a particular intent in the trademark forgery is not required to consider the existence of the moral element. It is sufficient to have the general intent represented in the direction of the perpetrator's will to forge the registered trademark with knowledge of this and its trademark others' proprietorship existence *in contrast to the crime of imitation that requires the availability of a particular intent represented by fraud which leads to having the public misled. Therefore, as the author believes, it was better to refrain from stipulating the necessity of having a personal intent in all the crimes involving trademark infringement in trademark Law*[1084].

Searching for fraud intent will necessarily narrow the protection against the forged trademark. ***In this regard, the author recommends amending the Trademarks Law through the deletion of the expression "committed with intent to defraud" from it because some crimes do not require particular intent, as is the case in the trademark forgery crime,*** *leaving this to the judge's discretion concerning the moral element)*[1085] *. from Paragraph (1) and merging it with Paragraph (2) and stipulating its independence in terms of rulings, punishment and attempting to do so because the existent text gives the initiation of the same crime a punishment more remarkable than the complete crime due to its applicability to the law as mentioned above*[1086].

A4 to Q4 *whether the Jordanian law addressed the infringement repeating of the protected rights. The study indicated that the Jordanian legislator did not address the case of the infringement repeating of the protected rights. The EU legislator addressed this case*[1087], *stating that the offender is subject in such a case to a repeated fine imposed on him for the duration of the violation after the issuance of the judgment. The author believes that the Jordanian legislator should adopt the same principle.*

A5 to Q5 As *for whether Jordanian law protects the famous trademark, to what extent is this protection applied, and whether it is criminal or civil, the Law provides trademark proprietors with criminal and civil protection*[1088]. ***The trademark proprietor has the right to bring either a civil or criminal action, or both, if his trademark is violated where the Jordan legislation considers the breach of any registered trademark punishable***. *Since most famous trademarks are not registered internationally in Jordan, the question arises: is a famous unregistered trademark adequately protected under the relevant codes? Thus, a legal problem emerges in protecting Jordan's well-known and unregistered trademark. The infringement of an unregistered trademark that is not used in Jordan remains out of the scope of the protection provided by the texts as mentioned above against unfair competition because the latter has assumed the absence of competition by the absence of actual use of trademarks - infringed upon - in the Jordanian market.*[1089] *In this regard, the Jordanian legislator offered legal protection for the famous trademark, even if the trademark was not registered (Protection by Cancellation). The legislature grants the trademark proprietor the*

[1084] *in article No. (37) of the Trademarks Law*
[1085] *Article 37 of the Jordanian Trademarks Law.*
[1086] *the article 37 of Jordanian Trademarks Law*
[1087] *in Article 11 of the Directive of Enforcement*
[1088] *Article 37 of the Trademark*
[1089] *In Article 25, Para (B) of the JTML*

right to ask the Jordanian competent court to prevent others from using the trademark related to similar services or products.

Despite the legislator not being satisfied with that, the protection involved preventing others from using the mark on non-similar services or products; it stipulates that using this trademark indicates a relationship between those products or services and the well-known trademark. *It also stipulates the possibility that the interests of the famous trademark proprietor would be negatively affected by this use. In this case, the proprietor of the famous trademark must prove the harm.*

Unequivocally, neither unfair competition law nor trade secrets provide civil protection for unregistered famous trademarks in the Kingdom or those used inside the Kingdom[1090]. However, it remains subject to infringement without civil protection due to the existence of this law[1091]. Hence, infringement on the trademark, whether used or unused, registered or unregistered, is deemed an act of unfair competition. Furthermore, this infringement leads to misleading the public. Therefore, the nonuse and nonregistration of famous trademarks do not give them the right to be subject to civil protection according to the said law. Therefore, the provisions of the Jordanian Unfair Competition Law and Trade Secrets [1092]did not exceed the legal problem raised by the Trademark Law and amended Law[1093].

Moreover, famous trademarks that are unregistered and used will be given the right to civil protection only. The criminal protection provisions will not apply according to the Unfair Competition Law, which does not achieve a general deterrent*.*

As for the study hypothesis related to the question of whether the most important reasons for trademark rights violations are in developing countries, The author believes there are many causes of trademark infringements. One of them is the TRIPS agreement, which has received much criticism for its effectiveness and legitimacy, especially in developing countries that consider it a rent-collection device with potentially destructive effects on public health, economic development, and education in most countries. The TRIPS agreement was prepared in a way that is believed to achieve the interests of all signatory States and to access free trade and technology diffusion; for that, TRIPS set the minimum protection standards that member states must adhere to and gave the members full free to adopt higher standards to mark the scope of protection if it was to their benefit. Nevertheless, when we look at how the TRIPS agreement was prepared, we note that it did not come with radical changes in the intellectual property rights protection system that was prevalent before it.

However, the author gathered previous agreements and treaties with some additions, such as amendments in the minimum protection periods for different forms of intellectual property, and Provided TRIPS with a dispute settlement mechanism. ***Moreover, advanced countries like the United States threatened developing countries with sanctions if they did not amend their legislation retroactively according to TRIPS agreement standards****. This request prevented them from adopting necessary measures to mitigate the negative impact on their economic and social life. Furthermore, the benefits of the TRIPS agreement and its function are not as advertised because it targets particular sections of society in those countries that appear to win the most from it. For that reason, large corporations practiced tremendous pressure to adopt this agreement because they are the real winners of TRIPS.*

[1090] *Articles (2/A & B) and (3/A) of the Law of Unfair Competition and Trade Secrets No. (15) of 2000*
[1091] *of Articles 2 and 3 of this law*
[1092] *Jordanian Unfair Competition Law and Trade Secrets No. (15) of 2000*
[1093] *see text of Article No. (33) of the JTML No. (33) of 1952, and amended Law No. (34) of 1999.*

Based on the mentioned above, the gross domestic product per capita in developing countries (low-income), economic policies, weakness of law enforcement, behaviors of governmental institutions that apply the enforcement of IP who do not consider IP infringement to be a priority, and the consumer's ethical who affected by the collectivist cultures at present (share infringements with others and expects them to follow the same actions, especially in piracy) are essential factors to explain the weakness level of IP protection. On the other hand, the empirical literature found that the relationship between income level and the intensity of IPR protection is U-shaped. For low-income developing countries, these two variables negatively impact economic development.

***Moreover, the intellectual property law needed to apply severe criminal sanctions in conjunction with civil remedies owing to the fact of the general deterrence to enhance the commitment to the law**, hence extending to the liability of the corporates in both developing and developed countries, not only but also, the application of criminal sanctions strictly will achieve two things, firstly, preventing the rights holders from attempting to extend their rights behind the terms of the grant, and secondly, preventing the imitators from infringements. Finally, the IP law in Jordan has been built like many developing countries under the pressure of the advanced countries and donors, thus the impact on the economy nominally because it is not suitable for economic development but protects the interests of the foreign corporations, moreover, it is not fit with Jordanian culture because they are unable to touch the results for their economic benefits.*

It is essential to rectify the gaps in IP law in Jordan by discussing IPRs from a localized analysis approach instead of a global perspective to reduce tension between the competitive social objectives and admitting private rights to support innovation. This understanding can then be used to impact the discussion of trade agendas and international IP. Also, adopting a tiered system would have been more harmonizing from a global perspective, offering more differential treatment and substantial according to the countries' needs and development, instead of adopting a 'one-size-fits-all" definitely inappropriate.

*Besides, the study tried to approve the hypothesis and answer their esteemed question. The author could also find the leading issues shaping obstacles to protecting trademark rights. In this regard, **the author argues that trademark registration is mandatory, especially for local trademarks, not for famous trademarks**. At the same time, the legislation stipulates trademark registration as a condition for compensation. The author believes it would be much better if the legislature made registration mandatory for all local or famous trademarks. The author believes that protection should be given to the well-known trademark and not to the proprietor of the trademark because the protection of the well-known trademark has implications for the national economy and investment in addition to the citizen's money and health.*

Furthermore, Jordanian legislators need to give a criterion to differentiate between well-known and famous trademarks or international agreements such as the TRIPS agreement and the Paris Convention.

A6 to Q6: did the Jordanian legislator treat the situation where the trademark was violated but not used within the Jordanian territory?

*Concerning unfair competition, the legislator equated the well-known and local trademarks concerning the protection and stipulated that the trademark should be infringed and that the mark must be used within Jordanian territory. **Suppose that the trademark was violated but not used within the Jordanian territory.***

In that case, whether the goods concerned with trademark violation were re-exported to be used outside the Jordanian territory, as the Jordanian legislator stipulated the actual use of the violated trademark. The author believes this is an obstacle to providing the necessary protection*. The main objective behind the subject matter of the letter is to search for eligibility in the trademark based on use or registration and to identify and know the actual proprietor to reach adequate protection for the trademark, taking into account that failure to provide such security for the trademark will reflect negatively on the national economy And investment in addition to the health of the consumer if this mark is related to health and food.*

A7 to Q7 *as to whether CJEU fixes the coexistence of unregistered local rights with later registered national trademarks. The (CJEU) made a ruling regarding the coexistence of local earlier rights without registration with later national trademarks that were registered. This ruling pertains to the interpretation of Article 6(2) of Directive 2008/95/EC, which has now been replaced by Article 14(3) of Directive 2015/2436/EU. The case arose from using their shared surname as a distinctive symbol.*

The proprietors, who had already used the same surname in their business, were also involved in the industry. There were several factors to be taken into consideration, including a national rule that allows for the use of an earlier similar sign of local significance recognized by the State, as per Article 6 (2) of Directive 2088/951094.

The case was brought before the Dutch Supreme Court, which decided to pause the proceedings and ask the Court of Justice of the European Union (CJEU) for guidance on two questions. The Court doubted the meaning and scope of "earlier right" regarding a trademark registered later, as outlined in Article 6 (2) of Directive 2008/95. Additionally, the Court sought clarification on prioritizing earlier rights that coexist[1095.]

The Court's initial uncertainty concerned whether the "prior right" mentioned in the provision grants its proprietor the authority to prevent using a later-registered mark. The CJEU clarified that, for an earlier right to be enforceable against the proprietor of the later-registered mark, it must meet the criteria of seniority, commercial and local use, and be acknowledged as an industrial property right by the Member State in which it is enforced. However, such a right does not necessarily render the registration of the later mark invalid or an obstacle to its use.

A8 to Q8 *As for the question of whether a party could have an "earlier right" when the proprietor of a later registered trademark also has an older right. The CJEU clarified that conflicts between registered trademarks and earlier rights are governed by EU law. In comparison, conflicts between "earlier rights" are assessed under the national law of the Member State involved*[1096]*. A right still before the "earlier right" can invalidate that earlier right if it is recognized and protected by national law when it is invoked. The National Court will determine this based on its national law. Suppose the still earlier right cannot be used against the earlier trademark right due to limitations like acquiescence.*

[1094] *Elena Martini and Francesca Perotti, The CJEU on the coexistence of unregistered local earlier rights with later registered national trademarks4 Jul, 2022, https://www.martinimanna.com/blog/the-cjeu-on-the-coexistence-of-unregistered-local-earlier-rights-with-later-registered-national-trademarks*

[1095] *ibid*

[1096] *Elena Martini and Francesca Perotti, The CJEU on the coexistence of unregistered local earlier rights with later registered national trademarks4 Jul, 2022ibid*

As an impact of unregistered trademarks in international laws, this study indicated that for The United States and the EU play a crucial role in safeguarding intellectual property rights and trademarks. The strength of American law lies in its alignment with advancements in intellectual property and its unwavering dedication to safeguarding trademarks. Nevertheless, China continues to be stigmatized as the nation that most frequently infringes trademarks and engages in imitation inside Asia.

This study also investigated the Paris Convention an international legal regulation that safeguards industrial property. It ensures that registered trademark proprietors have the right to prevent others from using identical or similar signs for goods or services that are the same or similar to those covered by the trademark. The TRIPs Agreement outlines these rights in detail.

***A9 to Q9 As for** If the US Code establishes the legal grounds for initiating a case in a civil court to address accusations of deceptive labeling and misleading advertising related to unregistered trademarks?. This study showed that Unregistered trademarks that are not officially recognized by the USPTO may nonetheless be protected at the state level through common law or statutes about unfair competition. The majority of states have adopted either the Uniform Deceptive Trade Practices Act or the Model Trademark Bill.*

The study analysis pays attention to that Unregistered brands are eligible for protection under common law and unfair competition regulations. Trademark registration grants the proprietor the ability to seek legal action in particular geographical areas where they operate their business. Nevertheless, unlawful utilization and degradation can transpire via customary legal principles. Lawsuits can be filed in federal court in two specific situations: when the person accused of infringement lives in a separate state and the disputed amount is more than $75,000, or when the issue revolves around the interpretation of the Lanham Act or other federal statutes.

***A10 to q10** As the dilution principle enhance the protection of trademarks for widely recognized brands? Trademark infringement and the act described here vary in that the latter enables a renowned trademark proprietor to seek a prohibition on the breaching behavior without seeking compensation for damages. The public readily recognizes famous trademarks as indicators of the source of items or services, hence narrowing the criteria for establishing fame in cases involving trademark dilution.*

For a mark to be eligible for registration, it must possess a secondary meaning. And to this, The mark's distinctiveness is a commonly accepted factor used to assess its strength.

A more conclusive trademark distinguishes the proprietor's products or services from others, although it may encounter opposition if a comparable mark or name already exists. The study concluded that a trademark with less resilience may necessitate greater exertion to safeguard and offer a diminished level of distinctiveness to the brand, however, it can derive advantages from the notion of "collective strength."

To this point, the Lanham Act bans the registration of marks that are merely descriptive, although legal protections may be provided if the word becomes distinctive via usage. If a mark has been used for five years, the PTO has the power to presume that it has acquired a secondary meaning.

The distinction between suggestive and strictly descriptive marks entails assessing the term's definition, creativity, competition, and marketing utilization. A phrase can be categorized as either arbitrary or fanciful. Arbitrary terms refer to products or services that lack a clear relationship, while fanciful names are used to uniquely identify important

products. Marks that lack clarity, are based on human judgment, or are impractical are inherently distinctive, whereas solely descriptive marks acquire secondary meaning.

It is essential to comprehend the distinctiveness criteria specified in Abercrombie while assessing trade dress or nonverbal trademarks. Courts have employed the Abercrombie spectrum to evaluate the distinctiveness of logos and other nonverbal identifiers. However, the broad usage of the standard criterion has resulted in the loss of individuality.

A suggestive trademark refers to a distinctive feature or quality of a product or service that stimulates the consumer's imagination and implies certain attributes without being too obvious.. Although not as powerful as arbitrary or whimsical marks, suggestive marks possess greater strength compared to descriptive or generic ones. To summarize assessing the distinctiveness of trademarks is an intricate procedure that necessitates the meticulous evaluation of multiple elements, such as the utilization of equivalent phrases and the likelihood of causing misunderstanding.

The study also indicated that Descriptive marks provide a clear description of the product or service they represent. As a result, they are less intense and do not require as much cognitive work from users to understand the attributes of the product. One way to protect them is by establishing a secondary meaning or association that creates a strong link between the things made under the mark and a particular producer. Elaborate symbols are crucial for representing a product or service, such as Kodak's manufacture of photogrphic film o the pharmaceutical brands Claritin and Acura.

Arbitrary marks refer to regularly used phrases that have no direct connection to the product or service, such as Shell for petroleum and Apple for personal computers. These marks have inherent robustness as long as no other organization has registered the word in a similar industry. Generic expressions cannot be protected as they are generally used to refer to all things or services of a specific kind. Furthermore, the study concluded that Unregistered trademarks receive protection under common law, enabling proprietors to initiate legal proceedings against individuals who violate their rights.

Nevertheless, the degree of safeguarding can differ based on the legal authority and the case's particular circumstances. Unregistered trademarks can be restricted under competition law if they cause confusion or mislead customers regarding a product's provenance. Companies may engage in anti-competitive activity by utilizing unregistered trademarks to impede competitors from joining a market or to sustain a dominant position within a specific industry.

The study also took into consideration theories in the intellectual property industry and kept them up to date, in this regard, the study paid attention that there is a fresh wave of trademark claims suggesting that domain names might be regarded as digital trademarks. Nevertheless, this perspective acknowledges the significance of legal considerations, as registering a domain name does not inherently provide trademark rights. With the growth of commerce between different states, federal courts started handling more legal matters related to conflicts over unregistered trademarks and unfair competition due to the jurisdiction based on diversity of citizenship.

In this regard, the evolution of digital trademarks has been influenced by competition law aspects, as federal courts have started to rule cases based on federal common law rather than state precedents. As a result, there is a dearth of choice-of-law concerns, specifically about local regulations for the presentation of legal claims, evidence, and assumptions regarding the substance of foreign laws. The prevailing principle is that the perspective of

the common law adopted by the courts in the forum will hold unless there is evidence of conflicting judgments from other states.

In the case of Patent and Trademark Office v. Booking.com, the Supreme Court affirmed the ruling that it is not permissible to register a generic phrase as a federal trademark. The term "generic.com" i classified as a generic name for a particular category of products or services solely based on user perception. The Supreme Court determined that customers do not perceive the phrase "Booking.com" in the same way, as each Internet domain name can only be owned by one company at a time.

The rules of the PTO do not provide a valid reason for a complete ban on registering phrases that are considered "generic.com." The PTO contends that providing trademark protection to "Booking.com" would confer an unreasonable level of control to the proprietor over the same phrasing, which should be accessible for unrestricted use by others. To avoid the anti-competitive outcomes indicated by the PTO, specific legal standards are implemented to guarantee that the registration of "Booking.com" does not confer exclusive rights to the term "booking" upon its proprietor.

This study profoundly analyzes the main differences between Sharia law and Jordan's trademark law. It shows that during the Islamic empire, sharia law dominated all life parts, and the violation of intellectual property was not a huge phenomenon. The study indicates that the main reason behind that was a religious sensation, and such wrongdoing was seen as a sin in front of God; moreover, the person who committed such immoral behavior was stigmatized by shame among his society individuals. But in terms of the Jordan state, the trademark violation is considered murder, and the person who committed such violation was given a punishment, according to Jordanian legislation.

***A11 to Q11** IF trademarks are in use and not registered. What sort of protection is afforded at the EU level to such non-registered trademarks if an alleged similar trademark is registered or applied for? According to also known as the EU Trademarks Rules, a trademark request can be denied registration if it conflicts with an earlier non-registered trademark. This provision outlines the circumstances that must be met for such prohibition. Following the provided clause, EU legal decisions have generally determined that four requirements must be met for an unregistered trademark to potentially be utilized to challenge the registration of an EU trademark, regardless of whether it continues to be in the filing phase or is currently registered and is subject to invalidity.*

The cumulative circumstances, as established in the 2016 Greylag Investment Ltd case, include in the following order: the mark must be utilized in the process of conducting business, and it also must possess a value that extends beyond a basic local scope. Furthermore, the entitlement to that particular trademark has to have been obtained through the legislation of the member state where the trademark was utilized before the application for registration of the EU trademark, or its priority at this point. Additionally, the trademark must grant its owner the authority to forbid the utilization of an afterward trademark. Determining the existence of such situations is not easily accomplished. Several European Union member states may provide a degree of safeguarding for unregistered trademarks inside the boundaries of their borders.

Nevertheless, the components and standards that constitute this safeguard vary and must be acknowledged by an EU court after being substantiated by the petitioner in a lawsuit grounded on Article 8(4) of the EU Trademarks Regulation. Hence, it is evident that the

degree of safeguarding for unregistered trademarks that are in use is inadequate compared with trademarks that have been registered either on a national or EU basis. This appears to be a logical conclusion as registered trademarks receive greater protection within either national or EU legislation due to their registration with the EU. However, numerous trademarks across Europe continue to remain unregistered. Various governmental entities have launched initiatives to promote the legalization of trademarks by highlighting the obvious advantages of registration.

A12 TO Q12 *As for the question it can be considered that the attributive system as a particular way of manifesting the declarative system. Regarding the question, can we view the attributive system as a distinct method of expressing the declarative system? The answer would be yes so for several reasons. Firstly, the declarative system, which was the original trademark protection system in Europe, still holds significance. Secondly, there are certain EU jurisdictions where unregistered trademarks continue to be protected.*

Thirdly, the safeguarding of unregistered trademarks can closely align with the original purpose and extent of trademark protection. Fourthly, the protection of trademarks through use reflects the image of actively used trademarks in the market. Lastly, the protection of unregistered trademarks is in line with the rapid economic trends of today.

A 13 TO Q13 *Did Sharia law protect intellectual property rights early? Sharia law does not have explicit provisions for safeguarding intellectual property rights (IPRs). The unapproved replication, use, or exploitation of a work subject to intellectual property rights (IPRs) without the express consent of the rightful proprietor constitutes an infringement. Substantial intellectual property rights (IPRs) are crucial in Jordan for attracting FDI, especially in the information technology sector. Insufficient enforcement has led to declining research and development activities and job prospects.*

A well-established correlation between income level and the degree of intellectual property rights (IPR) protection shows a U-shaped pattern. Wealthier individuals contribute to the economy, and firms engage in creative activities that result in mutual benefits. ***Countries with low incomes in the development process, such as Jordan and Egypt, have these consequences. Intellectual property (IP) is a cultural and legal system in Western societies. The global regime sought to motivate authors and inventors by bestowing property rights over innovation and culture to foster international market expansion.***

Sharia law establishes intellectual property rights based on Islamic principles, which aim to balance the rights of the group and those of individuals. The Hanafi School considers only physical assets property, whereas the Malki, Shafie, and Hanbali Schools regard physical and non-physical goods as property. Under Sharia law, intellectual property protection is recognized as a legitimate action that enables individuals to obtain tangible goods through contractual agreements or other methods.

In Sharia law, intellectual property has encouraged creativity by giving writers or inventors the right to copy their creations for a limited time, based on the economic incentive hypothesis. Nevertheless, this hypothesis is only partially correct. The reason for intellectual property rights lies in their ability to facilitate trade, generate profit, and complement the conventional arguments of property proprietorship and diligent labor.

As for the usage and registration of a trademark, based on the jurisprudential opinion that the use of a trademark creates the right to own the trademark and that registration only reveals such that right, it was appropriate for the Jordanian legislator to explicitly stipulate

that proving proprietorship of the trademark is through the use and thus grants the right to seek compensation, especially since it was specified in JTML that failure to register a trademark does not grant it any legal protection.

The author also believes that the Jordanian legislator should provide a text for the well-known trademark because most trademarks are foreign and that the Jordanian legislator should not require registration to give protection to the famous or well-known trademark; *in addition that such protection granted by the Jordanian legislator is not sufficient because it is limited only to the right to delete the trademark without the right to claim any compensation. Moreover, the author has deeply investigated tort liability, where the legislator stipulated terrible faith as a condition for proving tort liability, which, as the author believes, narrows the scope of trademark protection. Bearing that the stakeholder affected by trademark infringement is limited to the trademark proprietor and the consumer, the right to compensation must be taken for granted.*

2. Recommendations

The JUCTSL[1097] considered it a form of unfair competition that the benefit of a trademark used in Jordan, whether registered or not, as long as it leads to misleading the public. In addition, Article (256) of the JCC grants the right to claim compensation for the ones whose trademark-related rights were infringed following the civil liability provisions. It suggests deleting Article 2/b of the JUCTSL that dealt with the issue of an unregistered trademark in Jordan because it will be considered a repetition. It is not justified to amend article No. (33) of the JTML, as the JUCL did not consider the registration issue in the event of non-use, as it may infringe on a famous registered trademark that has not been used yet. The legislator recommends amending Article (2/b) of JUCTSL by deleting paragraph (b) to violate well-known trademarks subject to the text of Article (2/a) of the JUCTSL.

The author suggests revising the legislator's restriction on the duration of trademark rights. This principle contradicts the inherent nature of sole proprietorship, which grants the proprietor the authority to manage their assets in all legally permissible ways. The TRIPS agreement specifies that the registration period should be a minimum of seven years, and it can be renewed in perpetuity for the same duration at every renewal. The author recommends the trademark proprietor's ability for exclusive utilization is restricted to the trademark as a whole entity and does not encompass individual components such as lettering and color. Permitting another merchant to utilize the same colors or fonts in a comparable trademark is advisable.

The author suggests that the trademark proprietor's right to his trademark is a restricted right instead of an unconditional right concerning the goods and services in question. The judiciary's verdicts adhere to the same perspective.

The trademark proprietor has the authority to prohibit anyone from employing their trademark symbol, but only if it is utilized in a way that confuses or deceives customers. The author proposes that the text of Article Two of the JTML- before its amendment - should clearly define the comprehensive scope of a trademark.

It offers a limited understanding of the industrial and commercial trademark, excluding the service mark. The trademark industry has seen numerous in the past century. the author recommends the Jordanian legislator adopt the same principle the EU legislator used to

[1097] *The Jordanian Unfair Competition and Trade Secrets Law No. (15) of 2000*

address that the offender is subject in such a case to a repeated fine imposed on him for the duration of the violation after the issuance of the judgment. Since most famous trademarks are not registered in Jordan, the author recommends that the JTML be amended to protect famous unregistered trademarks.

The author suggests that the Jordanian legislators and law enforcement have to take into account that it needs to rectify shortcomings of various laws and reunite the procedures to protect trademarks in Jordan by harmonizing all types of legislation horizontally to meet the minimum threshold of the protection and to prevent a conflict of laws as for legal rule in the EU, where the Union set obligatory measures, procedures, and remedies to harmonize all types of IP[1098]. This enforcement directive was applied horizontally rather than vertically to deal with all certain areas, whereas the previous directives were vertical.

Finally, legal protection must be given to the trademark proprietor. The trademark laws' provisions must be based on the trademark itself and its nature since most trademarks are internationally famous and not registered in Jordan. This study recommends amending article No (33) of the JTML to include the protection of famous unregistered trademarks.

List Of Bibliography

1. Literature

1. *1 ABA, what is a trademark, ABA section of intellectual property law, 3rdedition, 2009,*
2. *[1] A. Inzelt, Jan Hilton · Technology Transfer: From Invention to Innovation Publisher Springer Science & Business Media, 2013 P 316.*
3. *1 Abdullah A1-Khashrom, A1-Wajeez in Industrial and Commercial Property, 1st Edition, Dar Wael Publishing, 2005,*
4. *[1] Abercrombie & Fitch Co. v. Hunting World, Inc., 531 F.2d 4 (2d Cir. 1976),"*
5. *[1] Abu-Ghazaleh Intellectual Property, https://www.agip.com/Agip _Country_Service.aspx?country _key=50&service_key=T*
6. *[1] Adam Brookman Trademark Law, 2014.*
7. *1 Advance Magazine Publishers Inc. v. Beverage City & Lifestyle GmbH, MJ, Beverage City Polska Sp. z o.o., and FE on September 7, 2023*
8. *1 Ahmed Adel The Future of Intellectual Property Rights in the Age of Artificial Intelligence, Publisher the Writer Operation, 2024.*
9. *Alfaouri, Mohammad Abdulmahdi Amin. "THE IMPACT OF TRIPS ON IPRs PROTECTION IN JORDAN, AS A PRIME EXAMPLE OF A DEVELOPING COUNTRY." Oradea Journal of Business and Economics 5.special (2020): 154-162*
10. *Al Tamimi, Essam, ed. Practitioner's guide to arbitration in the Middle East and North Africa. Juris Publishing, Inc., 2009.*
11. *[1] Ali Khan, 'Islam as Intellectual Property "My Lord! Increase me in Knowledge"' (2001) 31 Cumberland Law Review 631, 632–5, 649–50.*
12. *[1] Allen, M. J, (1991), The Scope of Confusion Actionable under Federal Trademark Law: Who Must be confused and When? 26 Wake Forest Law Review Association.*

[1098] *Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on enforcing IPRs*

13. [1] Allison N. Ziegler, Comment, Online Auction House Liability for the Sale of Trademark Infringing Products, 14 MARQ. INTELL. PROP. L. REV. 215, 229–30 (2010.
14. [1] Amir H Khoury, 'Ancient and Islamic sources of Intellectual Property Protection in the Middle East: A Focus on Trademarks' (2003) 43 IDEA: The Journal of Law and Technology 151, 153.
15. [1] Amy l. Atchison, Political Science Is for Everybody: An Introduction to Political Science, University of Toronto Press, 2021.
16. [1] Andrew Burrows, Principles of the English Law of Obligations, Publisher Oxford University Press, 2015, p327
17. [1] Andrew Christie, Stephen Gare, Blackstone's Statutes on Intellectual Property, Publisher Oxford University Press, 2016.
18. [1] Andrew Cook, Do as We Say, not as we do: A study of the well-known Mark's doctrine in the United States, The John Marshall Review of Intellectual Property Law, 2009.
19. [1] Andrew Murray, Information Technology Law: The Law and Society, Publisher Oxford University Press,4th edition, 2019.
20. [1] Angus Stevenson, Oxford Dictionary of English, Publisher OUP Oxford,3rd edition, 2010.
21. [1] Ann Harrison, Music: The Business - 6th Edition: Fully revised and updated, including the latest changes to Copyright law, · Publisher Random House 2014.
22. [1] B.C. Nirmal, Rajnish Kumar Singh, Contemporary Issues in International Law: Environment, International Trade, Information Technology and Legal Education, Publisher Springer, 2018.
23. [1] Baker Menwer Abdelharahman Al-Saaideh, Legal Protection of Famous Trade Marks in the Jordanian Legislation and International Agreements, 20173، 2017, Supplement 3, Issue 4, 44 Dr Studies, Sharia and Law Sciences, MG. 44
24. [1] Bart Custers, Eduard Fosch-Villaronga, Law and Artificial Intelligence: Regulating AI and Applying AI in Legal Practice, Publisher Springer Nature, 2022.
25. [1] Biotechnology Law and Policy: Emerging Legal Issues, Cases and Materials, Springer Nature, 2023.
26. [1] Brian Angelo Lee, 'Making Sense of "Moral Rights" in Intellectual Property' (2011) 84 Temple Law Review 82.
27. 1 Bruun.N and Marja-Leena. M, Research Handbook on Intellectual Property and Employment Law. 2021. https://doi.org/10.4337/9781782547259
28. [1] C. Kerry Fields, Kevin C. Fields the Legal Environment of Business 2022.
29. [1] Cancellation nº 33843 Flower Thrower (EUIPO).
30. 1 Carlos Correa, Trade Related Aspects of Intellectual Property Rights A Commentary on the TRIPS Agreement,
31. [1] Carter, Stephen l, 1993, does it matter whether intellectual property is property? Faculty Juristship Series, 2259.
32. [1] Cedric Ryngaert, Non-State Actor Dynamics in International Law: From Law-Takers to Law-Makers, Publisher Routledge, 2016.
33. [1] Charles Riddle, Common Law Trademark Rights What are Common Law Trademark Rights? Why are they Important? February 21st, 2019, https://esquiretrademarks.com/common-law-trademark-rights/#goods
34. [1] Charles W. Adams, Allocating Patent Rights Between Earlier and Later Inventions, 54 ST. LOUIS U. L.J. 55, 56 (2009) (describing the need to maintain incentives for new creations in the context of patent law).
35. [1] Chenguo Zhang, Balance and Limitation of Intellectual Property Protection in China: The Latest Law Amendments and Judicial Development Under Micro-Comparative Perspectives, Publisher Springer Nature, 2022 p204
36. [1] Chenguo Zhang, Balance, and Limitation of Intellectual Property Protection in China: The Latest Law Amendments and Judicial Development Under Micro-Comparative Perspectives and Limitation of Intellectual Property Protection, Springer Nature, 2022 p 199.
37. - Christoph Antons, Michael Blakeney, Intellectual Property Law in South East Asia, Publisher Edward Elgar Publishing, 2023, p53.
38. [1] chronopoulos, Apostolos, 2014, goodwill appropriation as a distinct theory of trademark liability: a study on the misappropriation rationale in trademark and unfair competition law, intellectual property law section of the State Bar of Texas, 253.
39. [1] Corbett, S, 2011. Mediation of Intellectual Property Disputes: A Critical Analysis. New Zealand Business Law Quarterly. 17.
40. [1] Council for Trade-Related Aspects of Intellectual Property Rights ('TRIPS Council'), Non-Violation and Situation Complaints, WTO Doc IP/C/W/349/Rev.1 (24 November 2004) (Summary Note by the Secretariat Revision).
41. 1 Cross, F. B., & Miller, R. L. (2020). The Legal Environment of Business: Text and Cases (11th ed., p. 166). Boston, USA: Cengage Learning.
42. [1] Cross. John T, 2008, the lingering legacy of trade-mark cases, Michigan State Law Review.
43. [1] Dan Hunter, The Oxford Introductions to U.S. Law: Intellectual Property, Publisher Oxford University Press, 2010.
44. [1] Dan Prudhomme, Taolue Zhang, China's Intellectual Property Regime for Innovation: Risks to Business and National Development, Springer, 2019, p36.
45. [1] Daniel R. Bereskin, Trademark Dilution, and Free Riding, Publisher Edward Elgar Publishing 2023.
46. [1] Dean K. Fueroghne, Law & Advertising: A Guide to Current Legal Issues, Publisher Rowman & Littlefield,4th edition, 2017.
47. [1] Deborah E. B, (2000). Intellectual Property: The Law of Trademarks, Copyrights, Patents and Trade Secrets, 4th Edition, Delmar, Cengage Learning, NY, USA.
48. [1] Deborah E. Bouchoux, A Practical Introduction to Paralegal Studies: Strategies for Success, Publisher Wolters Kluwer Law & Business, New York, 3RD Edition, 2021.
49. [1] Deborah E. Bouchoux, A Practical Introduction to Paralegal Studies: Strategies for Success.
50. [1] Deborah E. Bouchoux, Intellectual Property: The Law of Trademarks, Copyrights, Patents, and Trade Secrets Publisher Cengage Learning, 5th edition,2016.
51. [1] Delia Lipszyc Copyright and Neighboring Rights, UNESCO ·,1999,
52. [1] Dinusha Mendis, Mark Lemley, Matthew Rimmer,3D Printing and Beyond Intellectual Property and Regulation. Publisher Edward Elgar Publishing, 2019.
53. [1] Donald Harris, 'Trips and Treaties of Adhesion Part II: Back to the Past or a Small Step Forward?' (2007) Michigan State Law Review.
54. [1] Donna M Byrne, 'Locke, Property, and Progressive Taxes' (1999) 78 Nebraska Law Review.
55. [1] Dušan V. Popović, Ivana Kunda, Zlatan Meškić, Enis Omerović, Balkan Yearbook of European and International Law 2021, Publisher Springer Nature, 2022, p88, margin 66

56. [1] *EC, Trademarks and Geographical Indications, WTO Doc WT/DS290/R/Add.1 (15 March 2005) (Report of the Panel), annex A-3 (Oral Statement of Australia: First Substantive Meeting) (23 June 2004) 36*
57. [1] *EC, Trademarks and Geographical Indications, WTO Doc WT/DS290/R (15 March 2005) [3.1] (Report of the Panel).*
58. [1] *Elena Martini and Francesca Perotti, The CJEU on the coexistence of unregistered local earlier rights with later registered national trademarks4 Jul 2022, https://www.martinimanna.com/blog/the-cjeu-on-the-coexistence-of-unregistered-local-earlier-rights-with-later-registered-national-trademarks.*
59. [1] *Elizabeth I Winston, 'Why Sell What You Can License? Contracting Around Statutory Protection of Intellectual Property (2006)*
60. [1] *Els Witte, Jan Craeybeckx, Alain Meynen, Political History of Belgium: From 1830 Onwards,*
61. [1] *Emirs came to use such poets for propagandistic ends. See Abdul-Fattah Kileto, Writing and Tanasukh: The Concept of Author in Arabic Culture (Casablanca: The Arabic Cultural Centre, 1982) (in Arabic), 34–5.*
62. [1] *Enrico Bonadio, Aislinn O'Connell, Intellectual Property Excesses: Exploring the Boundaries of IP Protection, Publisher Bloomsbury Publishing, 2022.*
63. [1] *Estelle Derclaye Research Handbook on Empirical Studies in Intellectual Property Law, Publisher Edward Elgar Publishing, 2023.*
64. [1] *Eugene C. Lim, Dilution, the Section 22 Debacle, and the Protection of Business Goodwill in Canada: Some Insights from U.S. Trademark Law and Policy, 101 TRADEMARK REP. 1232, 1268 (2011) (articulating the incentive rationale underlying patent and copyright protection).*
65. [1] *EUROPEAN COMMISSION, Trade mark protection in the EU, https://single-marketeconomy.ec.europa.eu/industry/strategy/intellectual-property/trade-mark-protection-eu_en.*
66. [1] *European Law Institute, unidroit, eli-unidroit model European, rules of civil procedure From Transnational Principles to European Rules of Civil Procedure, Oxford University Press,1st edition, 2021.*
67. *Euipo, RECENT CASE-LAW ON THE INFRINGEMENT AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS, July 2024, https://euipo.europa.eu/tunnel web/secure/webdav/ guest/document library/ observatory /documents/reports/New_Case_Law_en.pdf,*
68. [1] *Ezieddin Elmahjub, An Islamic Vision of Intellectual Property: Theory and Practice, Publisher Cambridge University Press, 2019.*
69. [1] *Football Association Premier League and Others, C 403/08 and C 429/08, EU: C:2011:631.*
70. [1] *Gamal M Badr, 'Islamic Law: Its Reaction to Other Legal Systems' (1978) 26 American Journal of Comparative Law.*
71. [1] *Gene K. Landy, Amy J. Mastrobattista the IT / Digital Legal Companion: A Comprehensive Business .2008.*
72. [1] *George Mason Law Review 93, 99 (2006); R Justin Koscher, 'A Patent Pool's White Knight: Individual Licensing Agreements and the Precompetitive Presumption' (2009) 20 DePaul Journal of Art, Technology & Intellectual Property Law 53,*
73. [1] *Gerald B. Halt, Jr., John C. Donch, Jr., Amber R. Stiles, Robert Fesnak, Intellectual Property in Consumer Electronics, Software and Technology Startups, Publisher Springer Science & Business Media, 2013.*
74. [1] *Giacinto della Cananea, Roberto Caranta, Tort Liability of Public Authorities in European Laws, Publisher Oxford University Press, 2021 P159.*
75. [1] *Gibson Guitar Corp, 61 USPQ2d 1948 (TAB 2001),*
76. *1 Gordon V. Smith, Trademark Valuation, John Wiley & Sons, 1997.*
77. [1] *Graeme B. Dinwoodie, Mark D. Janis, Jason Du Mont, Trade Dress, and Design Law, Publisher Aspen Publishing, 2nd edition,2024.*
78. [1] *Graeme B. Dinwoodie, Mark D. Janis, Research Handbook on Trademark Law Reform, Edward Elgar Publishing, 2021, p62*
79. [1] *Graham Dutfield, Uma Suthersanen, Dutfield and Suthersanen on Global Intellectual Property Law: Publisher Edward Elgar Publishing, 2020Second Edition 2020.*
80. *1 Haochen Sun, Barton Beebe, Charting Limitations on Trademark Rights, Publisher Oxford University Press, 2023.*
81. [1] *Harold. R. W, (2005). Is the Monopoly Theory of Trademarks Robust or Bust. Journal of Intellectual Property Law, Vol. 13.*
82. [1] *Hasan M Buda, Rights and Obligations of Author in Publication Contract in Light of Islamic Fiqh (2005), 94*
83. [1] *Hasbullah Haji Abdul Rahman, 'The Origin and Development of Ijtihad to Solve Modern Complex Legal Problems' (1999) 43(2) The Islamic Quarterly 73.*
84. [1] *Hayleigh Bosher, Eleonora Rosati, Developments and Directions in Intellectual Property Law: 20 Years of The IPKat, Publisher Oxford University Press, 2023.*
85. [1] *Heidi Lautjärvi, White-Collar Business Crime, Publisher BoD - Books on Demand, 2023, p144.*
86. [1] *Helbling. T, (2017), Shapes as trademarks? The struggle to register three-dimensional signs: a comparative study of United Kingdom and Swiss law, Intellectual Property Quarterly, I.P.Q. 1997.*
87. [1] *Helen Johnson, A Guide to Trade Mark Law and Practice in Ireland, Publisher Bloomsbury Publishing,2nd edition, 2023, p248*
88. [1] *Hemant Kumar, Principles of Copyright Law and Intellectual Property Law, Publisher Horizon Books (A Division of Ignited Minds Edutech P Ltd), 2021.*
89. [1] *Hendrik. Zwarensteyn, Some aspects of the extraterritorial reach of the American antitrust laws, Publisher Springer Science & Business Media, 2013.*
90. *1 Henry H. Perritt, Digital Communications Law, Publisher Wolters Kluwer · 2010.*
91. [1] *Henry van de Velde, Henry van de Velde: Selected Essays, 1889–1914, Getty Publications, 2022.*
92. [1] *Hoffrichter, Pinja. "Bad faith and evergreening in EU trademark law." (2022).*
93. [1] *Howard M. Erichson Inside Civil Procedure: What Matters and Why? Publisher Wolters Kluwer, New York, 3rd edition 2018.*
94. [1] *Huddadeen*, A.B,. The Effect of The Agreement on Trade-Related Aspects of Intellectual Property Rights" TRIPS" on the Jordanian Economy. Master Thesis, Al al-Bayt University, Mafraq, Jordan. 2007.
95. [1] *Huw Beverley-Smith, Ansgar Ohly, Agnes Lucas-Schloetter Privacy, Property and Personality: Civil Law Perspectives on Commercial Appropriation, Publisher Cambridge University Press, 2005, p129*
96. [1] *Hwang, Wu, and Yu,. Impact of Intellectual Property Rights Protection on Less-Developed Countries: A Vertically Related Market Model", published in 2016.*

97. [1] Igor Demcak, 4 Differences between trademark registration in the US and the EU https://www.lexology.com/firms/tramatm/igor_demcak, March 22, 2023
98. [1] Igor Demcak, 4 types of bad faith trademark applications that will be rejected, March 2023. https://www.tramatm.com/blog/category/legal/4-types-of-bad-faith-trademark-applications-that-will-be-rejected
99. [1] Igor Demcak, Guide to non-traditional trademarks in the EU and the US: definitions, laws, and examples, February, https://www.tramatm.com/blog/category/legal/guide-to-non-traditional-trademarks-in-the-eu-and-the-us-definitions-laws, 2023
100. [1] Igor Demcak, Trademark registration in the US: Statement of Use requirement, https://www.tramatm.com/blog/category/legal/trademark-registration-in-the-us-statement-of-use-requirement, February 2023
101. [1] Ilanah Simon Fhima, Jacques Azéma, Philippe Gilliéron, Yuanshi Bu, Anne Marie E. Verschuur, Marques notoires et de haute renommée / Well-Known and Famous Trademarks, Publisher Université de Genève, 2011.
102. 1 Industrial Fabric Products Review, Publisher Industrial Fabrics Association International, 1995 Volume 72, Issues 7-12 .
103. [1] Ingrida Behri Mustafa, Lira Spiro, Legal Protection of Trademarks, the Albanian Legal Framework for Their Protection Between Defining Similarities and Differences of the European and American System, Interdisciplinary Journal of Research and Development Vol 11 No 1 / March 2024.
104. 1 Intellectual Property Office of Singapore relative grounds for refusal of registration, Singapore, Version 4 (November 2015).
105. [1] International Trademark Association, Famous and Well-Known Marks Practitioner's Toolkit, p149, https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/Famous-and-Well-Known-Practitioners-Toolkit-2015.pdf
106. 1 Irene Calboli, Srividhya Ragavan, Diversity in Intellectual Property: Identities, Interests, and Intersections, Cambridge University Press, 2015,
107. [1] Irene Calboli, Edward Lee, Trademark Protection and Territoriality Challenges in a Global Economy, Edward Elgar Publishing, 2014.
108. [1] Jamar, Steven D. "The protection of intellectual property under Islamic law." Cap. UL Rev. 21 (1992): 1079.
109. [1] James ND Anderson & Noel J Coulson, 'The Muslim Ruler and Contractual Obligations' (1958) 33 New York University Law Review 917, 929.
110. [1] James Raven, The Oxford History of the Book, Oxford University Press, 2023.
111. [1] Jean-Pie Gauci-Maistre, the protection afforded to non-registered earlier trademarks in the event of oppositions or infringement proceedings under the EU Trademarks Regulation.
112. [1] Joachim Kobuss, Alexander Bretz, Arian Hassani, become a Successful Designer – Protect and Manage Your Design Rights Internationally, Walter de Gruyter, 2012.
113. [1] Joanna SCHMIDT- SZALEWSKI & Jean- Luc PIERRE, Droit de la propriété industrielle, 4 è éd, Litec, Paris, 2007.
114. [1] Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999.
115. [1] Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997.
116. [1] Josep Solà, Ricard Delgado-Gonzalo, The Handbook of Cuffless Blood Pressure Monitoring: A Practical Guide for Clinicians, Researchers, and Engineers- Publisher Springer Nature, 2019.
117. 1 joseph p. Kennedy and Wayne h. Watkins with Elyse n. Ball, how to invent and protect your invention: a guide to patents for scientists and engineers, a john Wiley & sons, In, publication 2012.
118. [1] Joseph. S, (2004). Menger's theory of monopoly price in the years of high theory: the contribution of Vernon A. Mund. Managerial Finance, 30 (2).
119. 1 Journal of the Jordanian Bar Association.
120. [1] Julian S. Millstein, Jeffrey D. Neuburger, Jeffrey P. Weingart, Doing Business on the Internet: Forms and Analysis, Publisher Law Journal Press, 2024.
121. [1] Justine Pila, Seville's EU Intellectual Property Law and Policy, publisher Edward Elgar Publishing, 2022.
122. [1]kalistratova_zhanna, Modern Concepts of Trademark Protection, Central European University (CEU).
123. [1] Karine Disdier-Mikus, Heather Dunn, Gina Durham, Désirée Fields, and Nancy Larrieu, Non-traditional trademarks: a comparative analysis, World trademark review, 2018, https://www.worldtrademarkreview.com/article/non-traditional-trademarks-comparative-analysis.
124. [1] Katherine A. Currier, Thomas E. Eiermann, Marisa S. Campbell, Introduction to Law for Paralegals: A Critical Thinking Approach, Aspen Publishing, 2023.
125. [1] Katy Barnett, Katy Eloise Barnett, Sirko Harder, Remedies in Australian Private Law, Publisher Cambridge University Press, 2014, P311
126. [1] Kaushik, K, 2005. Role of intellectual property in economic growth. Journal of Intellectual Property Rights. 10. 465-473.
127. [1] Khoury, Amir H. "Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trademarks." Idea 43 (2003): 151.
128. [1] Kiny Wiston, Famous and Well-Known Trade Marks Versus Domain Names in Cyberspace, MARCH 2016, https://www.kennywiston.com/famous-and-well-known-trade-marks-versus-domain-names-in-cyberspace/
129. [1] Koen Lenaerts, Piet Van Nuffel, Tim Corthaut EU Constitutional Law, Publisher Oxford University Press, 2021.
130. [1] Kung-Chung Liu, Annotated Leading Trademark Cases in Major Asian Jurisdictions, Publisher Routledge, 2019.
131. [1] Kung-Chung Liu, Uday S. Racherla, · Innovation and IPRs in China and India: Myths, Realities and Opportunities Publisher Springer, 2016,
132. [1] Kur, Annette & Dreier, Thomas: European Intellectual Property Law: text, cases and materials. Cheltenham, UK: Edward Elgar Publishing, 2019. (Kur, Dreier 2019)
133. [1] Kur, Annette, Not Prior in Time, But Superior in Right: How Trade mark Registrations Can be Affected by Third Party Interests in a Sign (Kur, May 24, 2013). IIC - International Review of Intellectual Property and Competition Law, 2013 Vol. 44, Issue 7, pp 790-814, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 13-10, https://ssrn.com/abstract=2253888 (Kur 2013)
134. [1] Kurman, Jenny. "Why is self-enhancement low in certain collectivist cultures? An investigation of two competing explanations." Journal of Cross-Cultural Psychology 34.5 (2003): 496-510.

135. [1] L. R. Geissler, Association-Reactions Applied to Ideas of Commercial Brands of Familiar Articles, 1 J. APPLIED PSYCHOL. 275 (1917) (studying consumers' associations between brands and products). Publisher Edward Elgar Publishing, 2022.
136. [1] Lanning G. Bryer, Scott J. Lebson, Matthew D. Asbell, Intellectual Property Operations and Implementation in the 21st Century Corporation, Publisher John Wiley & Sons, 2011, P238.
137. [1] Lazaros G. Grigoriadis, Trade Marks and Free Trade: A Global Analysis, Publisher Springer, 2014.
138. Lee, Jyh-An, Reto Hilty, and Kung-Chung Liu, eds. Artificial intelligence and intellectual property. Oxford University Press, 2021.
139. [1] Lionel Bently, Brad Sherman, Dev Gangjee, Phillip Johnson, Intellectual Property Law, Publisher Oxford University Press, 2022, p1035, note 320
140. [1] Loon. N. W. (2009), Trade Marks, Language and Culture: The Concept of Distinctiveness and Public Juris, Singapore Journal of Legal Studies, 2009 Sing. J. Legal Stud. 508.
141. [1] Lorie Graham and Stephen McJohn, 'Thirty-Two Short Stories About Intellectual Property' (2010) 3 Hastings Science & Technology Law Journal 1, 66.
142. [1] M Cherif Bassiouni & Gamal M Badr, 'The Shari'ah: Sources, Interpretation, and Rule-Making' (2002) 1 UCLA Journal of Islamic & Near East Law.
143. [1] Maisa'a Mahmoud Al-Fayyad, The Legal Nature of Trade Mark. Master thesis, non-published, Middle East University May 2021.
144. [1] Malkawi, B. H. (2010). The Jordanian intellectual property Regime: triangle of copyright, trademark, and patent. Macquarie J. Bus. L., 7, 237.
145. [1] Margaret Dowie-Whybrow, Core Statutes on Intellectual Property 2022-23, Publisher Bloomsbury Publishing, 10edetion, 2022.
146. [1] Mark A Lemley, 'Property, Intellectual Property, and Free Riding' (2005) 83 Texas Law Review.
147. [1] Mark Davison, Ann Monotti, Leanne Wiseman, Australian Intellectual Property Law, Publisher Cambridge University Press, 2016.
148. [1] Mark J. Davison, Ann L. Monotti, Leanne Wiseman, Australian Intellectual Property Law, publisher Cambridge University Press, 2020 P 603
149. [1] marks (OJ 2015 L 336.
150. [1] Marrakesh Agreement Establishing the World Trade Organization, opened for signature 15 April 1994, 1867 UNTS 3 (entered into force 1 January 1995), annex 1A (General Agreement on Tariffs and Trade) 1867 UNTS 190 ('GATT 1994').
151. [1] Matthew David, Debora Halbert · The SAGE Handbook of Intellectual Property 2014.
152. [1] Matthew L. Cole, The Complete Guide to Patents, Copyrights, and Trademarks: What You Need to Know Explained Simply, Atlantic Publishing Company, 2008, p113
153. [1] Matthew Rimmer, The Trans-Pacific Partnership: Intellectual Property and Trade in the Pacific Rim, Publisher Edward Elgar Publishing, 2020.
154. [1] Melhem, Haloosh, and Mahafzah, 2009.
155. [1] Melvin Joseph DeGeeter, Technology Commercialization Manual: Strategy, Tactics, and Economics for Business Success, Publisher Med-Launch, Inc., 2004.
156. [1] Muayad Ahmad Obeidat, Khalid Mohamed Dganni, and Nada Zuhair Al-Feel. "Hologram Trademark Between Its Essence and Legal Provisions". Migration Letters, vol. 20, no. S1, July 2023, pp. 1046-57, doi:10.59670/ml. v20iS1.3655.
157. [1] Muhammad Al-Ghazali, Understanding the Life of the Prophet Mohammad (International Islamic Federation Student Organization, 1997),.
158. [1] Muhammad Wohidul Islam, 'Al-Mal: The Concept of Property in Islamic Legal Thought' (1999) 14 Arab Law Quarterly 361, 363.
159. [1] Murray, Andrew D. "Internet Domain Names: The Trade Mark Challenge." International Journal of Law and Information Technology, vol. 6, no. 3, 1998, pp. 285-312.
160. [1] Naim Salameh, The Legal Framework for the Advantages of the Right to a Trademark and the Expiration of Its Ownership, Analytical Comparative Study, Volume (24), Issue (3), 2018.
161. Nard, Craig Allen, Michael J. Madison, and Mark P. McKenna. The law of intellectual property. Aspen Publishing, 2017.
162. [1] Nari Lee, Niklas Bruun, Mingde Li · Governance of Intellectual Property Rights in China and Europe, Publisher Edward Elgar Publishing, 2016,
163. 1 Naser. M.A., (2014), Trademarks and freedom of expression. International Review of Intellectual Property and Competition Law
164. [1] National Research Council, Reference Manual on Scientific Evidence: Publisher National Academies Press, Third Edition,2011.
165. [1] Nazanin Aslani, Hashtags, and Trade Marks: A Comparative Legal Approach, Publisher Edward Elgar Publishing, 2024.
166. [1] Nesheiwat, F. K, 2012. The Compliance with Intellectual Property Laws and their Enforcement in Jordan- A post-WTO Review & Analysis, Durham theses, Durham University. Available at Durham E-Theses Online: http://etheses.dur.ac.uk/3639/
167. Ng, Catherine. "A Common Law of Identity Signs." Intellectual Property Journal 20.3 (2007): 285.
168. [1] Nobuyuki MATSUBARA, Protection of Well-Known and Famous Trademarks Japan Patent Office Asia-Pacific Industrial Property Center, JIII,2004 Matsubara, Muraki & Associates, p52. https://www.jpo.go.jp/e/news/kokusai_/developing/training/ textbook/document/index/protection _of_well-known_and_famous_trademarks_2004.pdf
169. [1] Nuno Pires de Carvalho, The TRIPS Regime of Antitrust and Undisclosed Information Publisher Kluwer Law International B.V., 2008 134,
170. [1] OECD, European Union Intellectual Property Office, Illicit Trade in Counterfeit and Pirated Goods Mapping the Economic Impact: Mapping the Economic Impact, Publisher OECD Publishing, 2016.
171. [1] Okojie, Victoria, Igbinovia, Magnus Osahon, Global Perspectives on Sustainable Library Practices, Publisher IGI Global, 2022.
172. [1] Ole-Andreas Rognstad, Property Aspects of Intellectual Property, Cambridge University Press, 2018.
173. [1] Oleg Igorevich Krassov, Evgeny Olegovich Krassov Land Law in Middle Eastern Countries - Publisher XSPO, 2022.

174. [1] Patent and Trademark Office (U S), Protecting Your Trademark: Enhancing Your Rights Through Federal Registration, Basic Facts about Trademarks, Government Printing Office, 2015.
175. [1] Patrick R. Goold, A Critical Introduction to Intellectual Property Law: Texts, Cases and Materials, Publisher Cambridge University Press, 2024,
176. 1 Patti Mack-Tucker, What You Should Know Before Starting a Business, Author House, 2010.
177. [1] Paweł Kaczmarczyk, Selected Regulations against Anti-Competitive Practices according to EU Law, publikacje.pan.pl. Pan.
178. [1] Pedro de Miguel Asensio, Conflict of Laws and the Internet Publisher Edward Elgar Publishing,1st edition, 2020,5.54
179. [1] Peer Zumbansen, The Many Lives of Transnational Law: Critical Engagements with Jessup's Bold Proposal,
180. [1] Peter K. Yu, Intellectual Property and Information Wealth [4 volumes]: Issues and Practices in the Digital Age [4 volumes] · 2006, Publisher Bloomsbury Publishing USA, 2006,
181. [1] Petra L. Láncos, Napoleon Xanthoulis, Luis Arroyo Jiménez, The Legal Effects of EU Soft Law: Theory, Language and Sectoral Insights, Publisher Edward Elgar Publishing, 2023,
182. Petty, Ross D. "The codevelopment of trademark law and the concept of brand marketing in the United States before 1946." Journal of Macromarketing 31.1 (2011): 85-99.
183. [1] Pierre Kobel, Pranvera Këllezi, Bruce Kilpatrick Competition Law Analysis of Price and Non-price p447
184. [1] Pranvera Këllezi, Bruce Kilpatrick, Pierre Kobel, Liability for Antitrust Law Infringements & Protection of IP Rights in Distribution, Publisher Springer, 2019.
185. [1] R. Bird, Robert Bird, Subhash C. Jain ·, The Global Challenge of Intellectual Property Rights, Publisher Edward Elgar Publishing, 2009.
186. [1] Ralph. S. B. Jr, (1948), Advertising and the Public Interest: Legal Protection of Trade Symbols. The Yale Law Journal, Vol. 57, No. 7.
187. [1] Randy E. Barnett, Nathan B. Oman, Contracts: Cases and Doctrine, Publisher Aspen Publishing, 2021, p156
188. [1] Rasmus Dalgaard Laustsen, The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions Publisher Springer Nature, 2019.
189. [1] Recent case-law on infringement and enforcement of intellectual property rights, p11-12, euwipo.
190. [1] Reiga Ritomiea Ariescy, Luqita Romaisyah, Devy Sylvia Puspitasari, EBGC 2019: Proceedings of the 2nd International Conference on Economics, Business, and Government Challenges, EBGC 2019, 3 October, UPN " Veteran" East Java, Surabaya, Indonesia2020, Publisher European Alliance for Innovation, 2020.
191. [1] Richard A. Spinello, Herman T. Tavani Intellectual Property Rights in a Networked World: Theory and Practice Publisher Idea Group Inc (IGI), 2005.
192. 1 Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, ,2017 2022,2024.
193. [1] Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, 2022.
194. [1] Richard Stim, Patent, Copyright & Trademark: An Intellectual Property Desk Reference, Publisher Nolo, 2017, 15th edition.
195. [1] Roberta Jacobs-Meadway, Proving Fame for Trademark Dilution Claims, the Lexis advisor practice advisor journal, August 26, 2019.,
196. [1] Rochelle C. Dreyfuss, Justine Pila · The Oxford Handbook of Intellectual Property Law, Publisher Oxford University Press, 2018.
197. [1] Rochelle C. Dreyfuss, Justine Pila, The Oxford Handbook of Intellectual Property Law, Publisher Oxford University Press, 2018, p674.
198. [1] Roger LeRoy Miller, Business Law Today, Standard: Text & Summarized Cases, Publisher Cengage Learning,11 edition, 2016.
199. [1] Roman, Abdel Rahman El-Sayed (2003) Recent trends in the protection of the famous mark A comparative study between French and Egyptian laws in the light of the TRIPS Agreement and the rules of WIPO. Dar Al Nahda Al Arabia, Cairo.
200. [1] Rosler. H, (2007), The rationale for European trade mark protection, European Intellectual Property Review, E.I.P.R. 2007, 29(3), 100-107.
201. [1] Rui Su, On the Regulation of Bad Faith Trademark Registration International Journal of Education and Humanities, ISSN: 2770-6702 | Vol. 5, No. 3, 2022, p 194.
202. [1] Russell L. Weaver, Steven I. Friedland, Richard D. Rosen, Constitutional Law: Cases, Materials, and Problems Fifth Edition, 2023 Case Supplement.
203. [1] Sandy Norman, Copy Right in Public Libraries, Fourth Edition, Library Association Publishing, London.
204. [1] Sawyer. L. P, (2019). US Antitrust Law and Policy in Historical Perspective. Harvard Business School.
205. [1] Scott, Scott on Multimedia Law, 4th Edition, Publisher Wolters Kluwer, 2019.
206. [1] Sherman Brad and Lionel Bently, The Making of Modern Intellectual Property Law: The British Experience (Cambridge University Press, 1999) 207. The origins of copyright and patent law are now seen as located in the British Statute of Anne 1710 and the Statute of Monopolies 1623.
207. [1] Shilling, Lawyer's Desk Book, Publisher Wolters Kluwer, 2018 2nd Edition,
208. [1] Sidne K. Gard, Elizabeth Townsend Gard, Just Wanna Trademark for Makers: A Creative's Legal Guide to Getting & Using Your Trademark Publisher C&T Publishing Inc, 2023.
209. [1] Sirhan, A.A., Intellectual Property and Copyright Laws and Their Impact on Digital Resources in Jordan (May 2011), pp.7-13.
210. [1] Smith. R. S, (1992), The Unresolved Tension Between Trademark Protection and Free Movement of Goods in The European Community, Duke Journal of Comparative & International Law, 89.
211. [1] Sreenivasulu N.S, Law Relating to Intellectual Property, Partridge Publishing, 2013.
212. [1] Stavroula Karapapa, Luke McDonagh, Intellectual Property Law, Publisher Oxford University Press, 2019.
213. [1] Stephen Fishman, Trademark: Legal Care for Your Business & Product Name, Publisher Nolo, 2022.
214. Stephen Fishman, Working for Yourself: Law & Taxes for Independent Contractors, Freelancers & Gig Workers of All Types, Publisher Nolo, 12edn,2022,
215. Summary of the Paris Convention for the Protection of Industrial Property (of 1883), https://www.wipo .int/treaties/ar /ip/paris/summary_paris.html.
216. Summary Report, Thierry CALAME, Sarah MATHESON and John OSHA, Sara ULFSDOTTER, Anne Marie VERSCHUUR and Kazuhiko YOSHIDA, Question 234 Relevant public for determining the degree of recognition of

famous marks, well-known marks, and marks with a reputation,https://www.aippi.fr/upload/Helsinki%202013/sumrep_q234_e_final_230813.pdf .

217. *[1] Susan Cunningham-Hill, Karen Elder, Civil Litigation 2019-2020, Publisher Oxford University Press, UK,12th Edition.*
218. *[1] Tanya Frances Aplin, Jennifer Davis, Intellectual Property Law: Text, Cases, and Materials, Publisher Oxford University Press, 2017.*
219. *[1] Tanya Frances Aplin, Tanya Aplin, Jennifer Davis, Intellectual Property Law: Text, Cases, and Materials, Publisher Oxford University Press, 2022,*
220. *[1] Terence P. Ross · Intellectual Property Law: Damages and Remedies Publisher Law Journal Press,2000, P1-19*
221. *[1] The case of B & B Hardware, Inc. v. Hargis Industries, Inc., 135 S. Ct. 1293, 1299, 1310, 191 L. Ed. 2d 222, 113 U.S.P.Q.2d 2045 (2015)*
222. *[1] the Intellectual Property Reports, volume46.*
223. *[1] The Jordanian Bar Association Journal. 1988.*
224. *1 The late Catherine Seville, EU Intellectual Property Law and Policy: Publisher Edward Elgar Publishing, 2016 Second Edition.*
225. *[1] the latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997, P341*
226. *[1] The Trade-mark Reporter - Volume 90, Publisher United States Trademark Association, 19994.*
227. *[1] The Trademark Reporter, Vol. 86.*
228. *[1] Tim Crook Comparative Media Law and Ethics, Publisher Routledge, 2009 .*
229. *[1] Tim W. Dornis Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, Publisher Cambridge University Press, 2017.*
230. *Tobias Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p201.*
231. *Cohen Jehoram, Constantinus Johan Jozef Clemens van Nispen, Tony Huydecoper, J. L. R. A Huydecoper, European Trademark Law: Community Trademark Law and Harmonized National Trademark Law, Kluwer Law International B.V., 2010, p201.*
232. *TRIPS Council, Enforcement of Intellectual Property Rights: Communication and Coordination as a Key to Effective Border Measures, WTO Doc IP/C/W/492 (31 May 2007) [26] (Communication from Switzerland).*
233. *Tshimanga Kongolo, African Contributions in Shaping the Worldwide Intellectual Property System, Publisher Routledge, 2016.*
234. *Ulrich Hildebrandt, Trade Mark Law in Europe: Case Law of the Court of Justice of the European Union, Publisher Kluwer Law International B.V., 4th edition,2024.*
235. *United Nations Treaties Series, vol. 828, No 11851, p. 305; 'the Paris Convention'*
236. *United States Reports volume 53.*
237. *Vijay D. Kulkarni, Gadekar Vithal Laxman, legal aspects of business: e-Book for MBA, 1st Semester, SPPU, Publish Thakur Publication Private Limited, 2023.*
238. *Wadlow. C, (2007), "Including trade in counterfeit goods": the origin of TRIPS as a GATT ant counterfeiting code, Intellectual Property Quarterly, I.P.Q. 2007.*
239. *Wahdani Fahed, Zbornik radova Pravnog fakulteta, Novi Sad 2022, vol. 56, iss. 2.*
240. *Wal-Mart Stores, Inc v Samara Bros, 529 US 205 (2000)).*
241. *Wilferd Madelung, edited by Sabine Schmidtke, Studies in Medieval Muslim Thought and History Publisher Taylor & Francis, 2022, P 42.*
242. *William Sloan Coats & Jennifer L. Co, Location, Location, Location: The Impact of Omega v. Costco on the Applicability of the First Sale Doctrine in the Grey Market, 1063 PLI/PAT 407, 411 (2011)*
243. *WIPO, Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999, P3. https://www.wipo.int/edocs/pubdocs/en/wipo_pub_833-accessible1.pdf.*
244. *Wolfgang Sakulin, Trademark Protection and Freedom of Expression: An Inquiry Into the Conflict Between Trademark Rights and Freedom of Expression Under European Law, Kluwer Law International B.V., 2011, p211*
245. *World Intellectual Property Organization, Madrid Yearly Review 2023: The International Registrations of Marks., Publisher WIPO, 2023 p88.*
246. *World Intellectual Property Organization, World Intellectual Property Indicators, Publisher WIPO, 2023.*
247. *World Trade Organization, Dispute Settlement Reports 2020: Volume 4, Pages 1523 to 2038, Publisher Cambridge University Press, 2022.*
248. *[1] Xavier Seuba, The Global Regime for the Enforcement of Intellectual Property Rights, Publisher Cambridge University Press, 2017.*
249. *Yelnik. A, (2010), Commercial value of trademarks: do current laws provide brands sufficient protection from infringement? European Intellectual Property Review, E.I.P.R. 2010, 32(5), 203-219.*
250. *YH Collection of Laws for Electronic Access SPAIN, ES080EN Marks, Law (Consolidation), 07/12/2001 (07/07/2003), page 12/63 No. 17 &No. 20.*
251. *Ysolde Gendreau Research Handbook on Intellectual Property and Moral Rights, Publisher Edward Elgar Publishing, 2023.*
252. *Yuwen Li, Cheng Bian, China's Foreign Investment Legal Regime: Progress and Limitations, Routledge, 2022, p126*
253. *TMEP, United States. Patent and Trademark Office - 1993.*
254. *Tokyo High Court, Sep. 29, 1994).*
255. *The Indus Entrepreneurs, Essentials of Entrepreneurship: What it Takes to Create Successful Enterprises, Publisher John Wiley & Sons, 2003.*
256. *Michaell J. Brennan (1961). Economic Man. JSTOR, Vol. 44, No. 2, pp. 126-132, Penn State University Press.*
257. *Yimeei Guo, Research on Selected China's Legal Issues of E-Business 2014.*
258. *[1]1C. Priyaa, Viji Vinod, Guruprasad Y.K · Intellectual Property Rights: Law, Legal Provisions, Technological Act, Publisher SK Research Group of Companies, 2024, p78.*
259. *1latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997, p P340*
260. *A Paris, 4ch.A,15des2004, PIBD,2005, n803,111.*
261. *Abdul Rahman, Muhammad Alyan, Protection of Trademarks and Trade Data in Egyptian Law and the TRIPS Agreement, 1st Edition, Cairo, Al-Israa Press.*

262. Adam D. M, (2012). A Lockean Theory of Intellectual Property Revisited. San Diego Law Review, 49:1069.
263. Albert CHAVANNE, et JEAN-Jean-Luc PIERRE, 2007.
264. Alexander Brown, Adriana Sinclair, Routledge, The Politics of Hate Speech Laws, 2019.
265. Al-Nahi, Salah Al-Din Abdul Latif Al-Wajeez in Industrial and Commercial Property, University of Jordan Publications, first edition, p. 252
266. Al-Qalyubi, Samiha, previous reference.
267. Al-Sanhoury, Abdel Razzaq: The Mediator in Explaining Civil Law, Part VIII, Arab Heritage Revival House, Beirut - Lebanon, without a published copy.
268. [1]am. Heart Ass'n et al., deadly in Pink: big tobacco steps up its Targeting of Women and Girls 1 (2009), available at http://www.tobacco freekids.org/content/what_we_do/industry_watch/deadly_in _pink/deadlyinpink _0218 2009_FINA L.pdf (describing PMI's deliberate marketing effort to make its cigarettes more appealing to women by using colors and packaging that resemble cosmetics); McGrady, supra note 16, at 55–56 (discussing the regulatory measures intended to restrict the use of "light" and "mild" on cigarette packaging); see also Amir H. Khoury, Three Dimensional Objects as Marks: Does a "Dark Shadow" Loom over Trademark Theory?, 26 CARDOZO ARTS & ENT. L.J. 335, 336–37 (2008)
269. Amanda Michaels, Andrew Norris, A Practical Guide to Trade Mark Law, Publisher Sweet & Maxwell, 2002, p v.
270. Anselmo Reyes, Wilson Lui, Direct Jurisdiction: Asian Perspectives, Publisher Bloomsbury Publishing, 1st edition,2021 P73 Available at: http://etheses.dur.ac.uk/3639/.
271. [1] Babbie, E. R. (2020). The practice of social research. Cengage Au.
272. [1]Badawi, Bilal Abdel Muttalib, The Evolution of International Mechanisms for the Protection of Industrial Property Rights (a study in the light of the TRIPS Agreement and previous agreements) Dar Al-Nahda Al-Arabiya, Cairo, 2006.
273. [1]Bassam Abed Alrahman Tbaishat. Legal protection of trademark in the light of the Jordanian and Egyptian laws and interactional agreements. Alam Alkotob alhadith.
274. [1]Benjamin N. Roin, Unpatentable Drugs and the Standards of Patentability, 87 TEX. L. REV. 503, 506 (2009) (describing how inability to obtain patents thwarts drug development). But see michelebоldrin & david k. Levine, against intellectual monopoly 11 (2008) (arguing that intellectual-property protections do not motivate the development of innovations or increase creativity)
275. [1]c.f. Herz and Mejer, 2016; Max Planck, 2011).
276. 1Carsten Fink, Christian Helmers, Carlos Ponce, Trademarks Squatters: Evidence from Chile, Volume 22 of WIPO Economic Research Working Paper, World Intellectual Property Organization,2014.
277. 1Catherine Seville, EU Intellectual property law and Policy 311 (Edward Elgar Publishing 2016)
278. [1]Chalmeta. B. T, (2011), The importance of the trade mark distinguishing function in Spanish law, European Intellectual Property Review, E.I.P.R. 2011, 33(7).
279. [1]Chronopoulos. A, 2014, Goodwill Appropriation as A Distinct Theory of Trademark Liability: A Study on The Misappropriation Rationale in Trademark and Unfair Competition Law, Intellectual Property Law Section of the State Bar of Texas, 253.
280. [1]Committee on Technical Barriers to Trade, Notification, G/TBT/N/THA/332, at 2 (Jan 21, 2010), available at http://docsonline .wto.org/imrd/directdoc.asp? DDFDocuments/t/G/tbtn10/THA332.doc (alterting WTO members of proposed Thai regulations)
281. David G. Resenbaum, Patents, Trademarks & Copy right, Chelsea House Publishers, 1994.
282. 1Deborah Morley, .Charles SParker, Understanding ,Computers: Today and Tomorrow, Comprehensive publisher Cengage ,Learning, 2014
283. Debra Johnson, Colin Turner, European Business, Publisher Routledge, 2015.
284. [1]Dewerra, J. 2012. Can Alternative Dispute Resolution Mechanisms Become the Default Method for Solving International Intellectual Property Disputes? California Western International Law Journal. 43.
285. Dima. B, (2016). The Nature, Scope, and Limits of Modern Trademark Protection: A Luxury Fashion Industry Perspective. A thesis submitted for the Degree, School of Law, Faculty of Humanities, the University of Manchester.
286. [1]Don R. Leet, Institutions and Markets, Council for Economic Educat, 2003.
287. [1]Elkaswany, and, Ameer, M. (2010) Forgery of information of the trademark, Dar Al Thaqafa, Amman, 1st press.
288. 1Emmanuel K. Ngwainmbi, Dismantling Cultural Borders Through social media and Digital Communications: How Networked Communities Compromise Identity Springer Nature, 2022.
289. Fact Sheet Commercialising Intellectual Property: Spin-offs, European IPR Helpdesk Fact Sheet, (15 May 202), www.iprhelpdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Commercialising-IP-Spin-offs.pdf.
290. 1Feenstra, R.C., Inklaar, R., Timmer, M.P., 2015. The next generation of the Penn World table. Am. Econ. Rev. 105 (10), 3150–3182.
291. Frank R. Abate, The Oxford Desk Dictionary of People and Places, Publisher Oxford University Press, 1999 .
292. 1Gail Hiduke, J. D. Ryan, Small Business: An Entrepreneur's Business Plan, Cengage Learning, 2013.
1Gamet-Pol, Franchise Agreements Within the European Community, Publisher Martinus Nijhoff Publishers, 2023.
293. [1]Garner. W. M, (summer. 2014), Trademarks in Franchising: The Basics, Wake Forest Journal of Business and Intellectual Property Law.
294. [1]Gayo, S., 2022. the use of mediation as an alternative dispute resolution in the resolution of intellectual property rights disputes. International Asia of Law and Money Laundering (IAML), 1(2).
295. [1]Gea Lepik, Protecting Trade Mark Proprietors Against Unfair Competition in EU Trade Mark Law, https://doi.org/10.12697/JI.2021.30.17,p151, ji_2021_30_152.pdf (juridicainternational. eu)
296. [1]George. M, and D'Amato. N, (1978). Consumer Confusion & Trademark Infringement. Journal of Marketing, Vol. 42, No. 2.
297. [1]Ghazwi, Mohamed & Jarrah, Mash'al & Mahasneh, Medyen. (2019). Critical Analysis of Granting Interim Measures in Arbitration in the Context of Jordan Arbitration Law No. 16. 2018. Beijing Law Review. 10. 1100-1115. 10.4236/blr.2019.104059.
298. [1]Gill. K, The Definition of a Trade-mark, Distinctiveness, and Use, Gill: Fox on Canadian Law of Trade-marks and Unfair Competition.
299. [1]Graeme B. Dinwoodie, Mark D. Janis Trade Dress and Design Laws, Publisher Aspen Publishing, 2022.
300. [1]Graeme B. Dinwoodie, Mark D. Janis Trademarks and Unfair Competition: Law and Business, 2018
301. 1Hall, B., Helmers, C., 2018. The Impact of International Patent Systems: Evidence from European Patent Convention. NBER Working Paper 24207.

302. [1]Helen Johnson, A Guide to Trade Mark Law and Practice in Ireland, Publisher Bloomsbury Publishing,2nd edition, 2023.
303. [1]https://supreme.justia.com/cases/federal/us/590/18-1233/
304. [1]https://www.justia.com/intellectualproperty/trademarks/unregisteredtrademarks/#:~:text=If%20you%20do%20not%20register,in%20your%20geographic%20area%20only.
305. [1]Hwang, H., Wu, J.Z. and Yu, E.S., 2016. Innovation, imitation and intellectual property rights in developing countries. Review of Development Economics, 20 (1).
306. 1IBP, Inc., China Business Law Handbook Volume 1 Strategic Information and Basic Laws, Publisher Lulu. Com, 2000, p62.
307. [1]Intellectual Property Office (EUIPO Guidelines for Examination of European Union Trade Marks European Union Part C Opposition Section 2, Final Version, 2020.
308. [1]Ivana Kunda, Zlatan Meškić, Balkan Yearbook of European and International Law 2021
309. [1]Jack Daniel's™ Properties, Inc. v. VIP Products LLC, 599 U.S.(2023), https://supreme.justia.com/cases/federal/us/599/22-148/case.pdf
310. Jalal, Wafaa Muhammadin, Legal protection of industrial property according to (TRIPS) Agreement , Alexandria: New University House, 2004.
311. [1]James M. Masnov Rights Reign Supreme: An Intellectual History of Judicial Review and the Supreme Court Publisher McFarland, ,2023, p188.
312. [1]Jean Brnard Blais- droit des affairs-L.G.D. J-Paris-2000.
313. [1]Jessica N. Marshall, Domain Names and Trade Mark at the Inter Section, US Patents, Trade Mark Office, Washington
314. [1]Jichun Shi, Renmin Chinese Law Review: Selected Papers of The Jurist, 2014.
315. [1]Judgment Of the Court of Justice of The European Union (C-809/18 P).
316. Justine Pila, Seville's EU Intellectual Property Law and Policy2022.
317. [1]Kent R. Middleton, William E. Lee, Daxton Stewart, The Law of Public Communication: update 2017, Routledge, 2016.
318. 1Kislay Komal, Trademark Meaning Objective and Infringement, September 29, 2017, www. Setindiabiz .com
319. l Bruce R. Hopkins, David Middlebrooks Nonprofit Law for Religious Organizations: Essential Questions & Answers, John Wiley & Sons, 2008.
320. l Carl Roper, Trade Secret Theft, Industrial Espionage, and the China Threat, CRC Press, 2013.
321. [1]Landes, W.M., Posner, R.A., 1987. Trademark law: an economic perspective. J. Law Econ.30.
322. lBurton A. Amernick, Patent Law for the Non-lawyer: A Guide for the Engineer, publisher Technologist, and Manager Springer Science & Business Media, 2012, p118.
323. lenasherwatawzee'. Jordan, 2009, p. 235
324. [1]Lessig, L., 2002. The future of ideas: The fate of the commons in a connected world. Vintage.p22.
325. [1]Liguori, Jacopo, Selective Distribution: The Consequences for Non-Lluxury Products, Mondaq (2020) https://www.mondaq.com/italy/antitrust-en-competition-/1014736/selective-distribution-the-consequences-for-non-luxury-products.
326. [1]Lionel Bently, Brad Sherman, Dev Gangjee, Phillip Johnson, Intellectual Property Law, Publisher Oxford University Press, 2022, p1035, note 320
327. 1Lior Zemer, The Idea of Authorship in Copyright, Publisher Ashgate Publishing, Ltd., 2007.
328. Liu, Michael Xun. "Jurisdictional Limits of in rem Proceedings Against Domain Names." Mich. Telecomm. & Tech. L. Rev. 20 (2013): 467.
329. [1]Malkawi, B. W, 2013. The feasibility of alternative dispute resolution to resolve intellectual property disputes in Jordan. Journal of Intellectual Property Law & Practice, 8(2), pp. 146–153, https://doi.org/10.1093/jiplp/jps210
330. Malkawi, Bashar H. "Intellectual property protection from a Sharia perspective." Southern Cross University Law Review 16 (2013): 87-121.
331. [1]Margreth Barrett, Intellectual Property, 2008.
332. Martha Sargent, Retire-And Start Your Own Business, Nolo, 2008.
333. [1]Mátyás, B. (2021). Legal Doctrinal Scholarship: Legal Theory and the Inner Workings of a Doctrinal Discipline. Edward Elgar Publishing,
334. [1]McKeown. J, McKeown's Brand Management in Canadian Law Newsletter, Intellectual Property Newsletters, Brand MGT. NWS. 2016.
335. [1]Michael P Ryan, Knowledge Diplomacy: Global Competition and the Politics of Intellectual Property (1998)

336. Michaell J. Brennan (1961). Economic Man. JSTOR, Vol. 44, No. 2, pp. 126-132, Penn State University Press.
337. [1]Nabulsi, O. N, 2009. The Practitioner's Guide to Arbitration in the Middle East and North Africa. Juris Arbitration Law. Available from https://arbitrationlaw.com/library/hashemite-kingdom-jordan-chapter-5-practitioners-guide-arbitration-middle-east-and-north. Accessed [8 August 2020.
338. 1Naser, Mohammad Amin. "Trademarks and freedom of expression." IIC-INTERNATIONAL REVIEW OF INTELLECTUAL PROPERTY AND COMPETITION LAW 40.2 (2009): 188-205.
339. [1]Naser. M.A., (2014), Trademarks and freedom of expression. International Review of Intellectual Property and Competition Law.
340. [1]Neil Wilkof, Shamnad Basheer, Overlapping Intellectual Property Rights, Publisher OUP Oxford, 2012 P lxxviii
341. [1] Nesheiwat, F., 2012. The Compliance with Intellectual Property Laws and their Enforcement in Jordan-A Post-WTO Review & Analysis (Doctoral dissertation, Durham University, U.K.).
342. [1]Obayuwana. A, (2012), Unintentional trademark expansion and unfair competition in cyberspace: the domain name phenomenon, European Intellectual Property Review, 177-187.official Journal of 19 December 1996)
343. [1]Papageorgiadis and McDonald, 2018; Al-Khashroom, 2002.
344. [1]Patrick Barta& Christina Passariello, Global Liquor Makers Fight Graphic Labels in Thailand, WALL ST. J., Sept. 17, 2010, at B1;
345. [1]Peter Baldwin The Copyright Wars: Three Centuries of Trans-Atlantic Battle, p109 Posted 21 March 2016, https://www.kennywiston.com/famous-and-well-known trademarksversusdomainnamescyberspace/#:~:text=The%20Distinction%20Between%20Famous%20and%20Well%2DKnown%20Marks&text=Famous%20marks%20are%20traditionally%20considered,non%2Dcompeting%20goods%20or%20services.
346. [1]Peter Drahos and John Braithwaite, Information Feudalism: Who Owns the Knowledge Economy? (2002).

347. [1]Press Release, Antitrust: Commission consults on commitments offered by Samsung Electronics regarding use of standard essential patents, EUROPEAN COMMISSION (26 Jan. 2021) https://ec.europa.eu/commission/presscomer/detail/en/IP 13 971 Publisher Oxford University Press, 2021.
348. [1]Qiyam, Khaled (1997), General Principles of Jurisprudence, Mutah University Publications, first edition.
349. [1]Rahi, S. (2017). Research design and methods: A systematic review of research paradigms, sampling issues, and instruments development. International Journal of Economics & Management Sciences, 6(2).
350. [1]Recital 11, European Union Council Directive 2008/95, to approximate the laws of the Member States relating to trade marks (codified version), 2008.
351. 1Records of the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty - Singapore, 2006, Volume 329 of WIPO publication Singapore Publisher WIPO, Geneva,2010.
352. Robert E. Hudee, Essays on the Nature of International Trade Law , chicago journal of International Law , (1999)
353. [1]Robert. G. B, (2008), Schechter's Ideas in Historical Context and Dilution's Rocky. Forthcoming in 24 Santa Clara Computer & High Technology Law Journal (2008).
354. [1]Ronald J. Nessim, Criminal (and Civil) Trademark Infringement: What Statute of Limitations Applies? 76 J. PAT. & TRADEMARK OFF. SOC'Y 933, 937 (Dec. 1994).
355. [1]Rothman. J. E, (2005), Initial interest confusion: Standing at the crossroads of trademark law. Cardozo Law Review.
356. [1]Ryan Abbott, Research Handbook on Intellectual Property and Artificial Intelligence, Publisher Edward Elgar Publishing, 2022.
357. [1]Salah A1-Din A1-Nahi, A1-Wajeez in Industrial and Commercial Property, Dar A1-Furqan for Publishing and Distribution, 1982.
358. [1]Schnepper EB, 'Dairy in Denmark: Bad Faith and Compliance with the European Interpretation' (2014) 9 Journal of Intellectual Property Law and Practice 11 (Schnepper EB 2014) .
359. [1]Sgang Caterina, A plea for digital exhaustion in EU copyright law, 9 J. Intell. Prop. Info. Tech. & Elec. Com. L. 217 (2018).
360. [1]Shafiq Mohsen,(1984) Technology Transfer from the Legal Perspective,Cairo University. Dar Al Nahda Al Arabiya 1998.
361. [1]Simon Crean, Australian Minister for Trade, 'Australia to Negotiate an Anti-Counterfeiting Trade Agreement (ACTA)' (Press Release, 1 February 2008).
362. [1]Smith. R. S, (1992), The Unresolved Tension Between Trademark Protection and Free Movement of Goods in The European Community, Duke Journal of Comparative & International Law.
363. 1Stakheyeva, Hanna, Intellectual Property and Competition Law: Understanding the Interplay (In Bharadwaj, Ashish et al. eds., multi-dimensional approaches towards new technology 3-19, springer 2018).
364. Standing committee on the law of trademarks, industrial designs, and geographical indications, WIPO/Strad/inf/1 rev.1, a summary of replies to the questionnaire on trademark law and practice (sct/11/6) .
365. 1Stef van Gompel, Formalities in Copyright Law: An Analysis of Their History, Rationales and Possible Future, Volume 23 of Information law series, publisher Kluwer Law International B.V, Netherlands,2011.
366. [1]Stephen Burley & World Intellectual Property Organization, Introduction to the International Intellectual Property Legal Framework, Publisher WIPO, 2023.
367. 1Stephen Elias, Richard Stim Trademark: Legal Care for Your Business & Product Name, 9th Edition, Publisher: Nolo, Year: 2010.
368. [1]Susan K Sell, Power and Ideas: North-South Politics of Intellectual Property and Antitrust (1998).
369. 1Tamara Capeta, Iris Goldner Lang, Tamara Perišin, The Changing European Union: A Critical View on the Role of Law and the Courts· Publisher Bloomsbury Publishing, 2022,
370. [1]Tarawneh. J, (2016), A new classification for trademark functions, Intellectual Property Quarterly.
371. [1]The latest judicial trademark decisions of the Jordanian High Court of Justice Arab Law Quarterly, Vol. 12, No. 3, September 1997.
372. [1]Thomas McCarthy, McCarthy on trademarks and unfair competition § 18.3 (4th ed. 1992)
373. [1]Tim W. Dornis, Trademark and Unfair Competition Conflicts: Historical-Comparative, Doctrinal, and Economic Perspectives, publisher Cambridge University Press, 2017.
374. 1Timothy Lee Wherry, The Librarian's Guide to Intellectual Property in the Digital Age Copyrights, Patents, and Trademarks, American Library Association Chicago and London 2002.
375. Timothy Lee Wherry, Trademarks in the Digital Age, publisher Scarecrow Press2004,
376. 1Tom Blackett Trademarks, publisher Palgrave Macmillan UK, first edition, 1998,
377. [1]Torremans, Paul, holyoak, and Torremans intellectual property law (Oxford University Press 2019)
378. [1]Upadhye. S. (1998), Trademark surveys: Identifying the relevant universe of confused consumers. Fordham Intellectual Property, Media and Entertainment Law Journal.
379. [1]Vijay D. Kulkarni, Gadekar Vithal Laxman, legal aspects of business: e-Book for MBA, 1st Semester, SPPU, Publish Thakur Publication Private Limited, 2023.
380. [1]Wadlow, C. (2007). " Including Trade in Counterfeit goods": the Origins of TRIPs as a GATT Anti-counterfeiting Code. Intellectual Property Quarterly, 2007(3), 350-402.
381. [1]Wilf, Steven. "Who authors trademarks." Cardozo Arts & Ent. LJ 17 (1999): 1.
382. [1]Wilkins. M, (1992). The Neglected Intangible Asset: The Influence of the Trade Mark on the Rise of the Modern Corporation. Journal of Business History, Volume 34, No. 1.
383. [1]William E. Ridgway, Revitalizing the Doctrine of Trademark Misuse, 21 Berkeley Tech. L.J. 1547, 1557–58 (2006) (discussing the distinctions between trademark law and patent and copyright laws)
384. 1Zain Al Deen, Salah. Industrial and Commercial Property (1st ed), Dar Al Thaqafa, Amman, Jordan 2000
385. [1]Zain Al-Din, Salah, Branding in Jordanian Law, Journal of Law (Kuwait) m (33), Issue (4), 2009.
386. Tom Blackett, Trademarks, publisher Springer, 2016.

2. *Agreements* & Conventions

- *Benelux Convention on Intellectual Property (Trade Marks and Designs), signed on February 25, 2005*
- *Brussels 1 agreement*
- *Madrid Convention Concerning International Registration of Marks of 1891*
- *Paris Convention to Protect Industrial Property of March 20, 1883,*
- *Trade-Related Aspects of Intellectual Property Rights (TRIPS Treaty)*
  World trade organization

3. legislations

3.1 international legislations

- *American Trademark Dilution Revision Act of 2006*
- *Australian Consumer Law and Fair-Trading Act 2012 - SECT 120*
- *Australian Trade Marks Act 1995*
- *Federal Trademark Dilution Act*
- *Iraqi Civil Law No. 191*
- *Japanese Trademark Law*
- *Japanese Unfair Competition Law*
- *Korean Trademark Act*
- *Kuwaiti Civil Law No. 227*
- *Lanham Act and PRO-IP Act of 2007,*
- *Trademark Law of the People's Republic of China*
- *UAE Federal Trademarks Law for the year 1937 AD, No. (37).*
- *UK Trademark Act*

3.2 EU legislation

- *BTIP*
- *Cancellation n° 33843 Flower Thrower (EUIPO)*
- *Council Directive of European Economic Community*
- *Council Regulation (EC) No 207/2009,*
- *Directive (EU) 2015/2436*
- *DIRECTIVE (EU) 2015/2436 OF EUROPEAN PARLIAMENT AND OF COUNCIL of 16 December 2015 to approximate laws of Member States relating to trademarks.*
- *DIRECTIVE 2004/48/EC OF EUROPEAN PARLIAMENT AND OF council of 29 April 2004 on enforcement of intellectual property rights.*
- *Directive 2008/95/EC of European Parliament and Council dated October*
- *Directive 2015/2436*
- *directive EU 2015/2436 of the European Parliament and Council*
- *EU Directive 89/104*
- *EU directive law*
- *European Union Trade Mark Regulation,*
- *First Council Directive 89/104/EEC of December 21, 1988*
- *French Intellectual Property Code*
- *German Unfair Competition Law*
- *Recital 5 of Directive 2008/95*
- *Regulation (EU) 2017/1001 of the European Parliament and of Council of 14 June 2017 on European Union trademark*
- *Regulation (EU) No. 1215/2012 (called "Brussels I").*

3.3 Jordan legislation

- *Act xi of 1997 on the protection of trademarks and geographical*
- *Civil Law No. 256*
- *Explanatory notes for Jordanian civil law. Part one*
- *Goods Marks Law*
- *Trademarks Law No. 33 of 1952 and amended Law No. 34 of 1999*
- *Law No. 17/2001 of December 7, 2001, on Trademarks (Consolidated text including Amendments made by Law No. 20/2003 of July 7, 2003, on Legal Protection of Industrial Designs)*
- *Merchandise Marks Law No. 19 of 1953*
- *Standards and Metrology Law*
- *Unfair Competition and Commercial Secrets Act (JUCCSA) No. [15] of 2000 in paragraphs [a, b]*
- *Unfair Competition Prevention Act*

4. Courts

- *Amman Court of Appeal*
- *Court of Appeal of the European Communities (now 'the General Court'*
- *Court of Justice of the European Union*

- *Egyptian Court of Cassation*
- *EU Trade Marks Regulation*
- *European General Court*
- *French Court of Appeal in Paris*
- *French Court of Cassation*
- *French Court of the First Instance*
- *German Federal Court of Justice*
- *German Supreme Court*
- *Japanese Supreme Court*
- *Jordan Supreme Court of Justice*
- *Jordanian Court of Cassation*
- *Jordanian Supreme Court of Justice*
- *Palestinian Court of Justice*
- *Tokyo District Court*
- *Swedish supreme court*

5. cases

5.1 EU cases

- *Anheuser-Busch vs Budjovicky*
- *Argo Development and Manufacturing Ltd v OHIM*
- *Barluschke v Dalloz*
- *BR IP Holder LLC v OHIM*
- *Canon K.K (JP) v. Pa Communication (US) in European Union*
- *Cauchy sport*
- *Ccommission v Council Judgment.*
- *Chanel v. Snack Chanel*
- *Christian Dior SA and Parfums Christian Dior BV v Evora BV*
- *Dušan V. Popović,*
- *Dyson v Registrar of Trademarks*
- *European Court of Justice in case (C-337/95) Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV concerning the use of a trademark of a top-notch perfume by a parallel importer in advertising*
- *GGermany and Ors v Commission,*
- *Globo Comunicação e Participações S/A v EUIPO (Case T-408/15)*
- *Hasbro v. EUIPO, Kreativni Dogadaji*
- *Heast Company VS A. Frinas*
- *HUGO BOSS" Trade Mark Management GmbH & Co. KG, February 22, 2023.*
- *Spain and Italy v Council, Jjudgment of 16 April 2013, joined cases C-274/11 and C-295/11, ECLI:EU: C:2013:240, paras. 17 and following*
- *Judgment of 31.03.1971, Case C-22/70 Commission v Council, ECLI:EU: C:1971:32.*
- *Red Bull GmbH v EUIPO*
- *Tiffany & Co. v. Philip Morris*
- *Uuniversal Protein Supplements Corp. v EUIPO*
- *General Motors VS Yplon*
- *Swedish supreme court , Judgment of Länsförsäkringar, C-654/15], n, ruling of 22.11.2017 (SV)*
- *Registrar: V. Giacobbo-Peyronnel, French court no (C-654/15) 26 September 2018*
- *Christian Lifers v Producciones Mandarina*
- *FIFA v Puma SE case*
- *Louis Vuitton v Rich-Ycled*
- *Citroën v Polestar*

5.2 International Cases

- *Abercrombie & Fitch Co. v. Hunting World, Inc*
- *B&B Hardware, Inc. v. Hargis Indus., Inc*
- *Coty v. ALDI SÜD/ Rights exhaustion*
- *Elena KaganIancu v. Brunetti (2019), 588 U.S. (2019) https://supreme.justia.com/cases/federal/us/588/18-302/case.pdf*

- *Glove Mfg Co. v. Goodyear Rubber Co., 128 U.S. 598 case.*
- *Hanover Star Milling Co. v. Metcalf*
- *Jack Daniel's Properties, Inc v. VIP Products LLC*
- *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042 (9th Cir. 1998)*
- *Lahoti v. Vericheck, Inc*
- *New York Pizzeria, Inc v Syal 56 F Supp 3d 875, 882 (SD Texas 201.*
- *Patent and Trademark Office v. Booking.com. B.V. (2020)*
- *Qualitex Co v Jacobson Prods Co, 514 US 159, 165, 34 USP1163-64 (1995),*
- *rePowermat Inc vs TTAB*
- *Romag Fasteners, Inc. v. Fossil, Inc. (2020)/*
- *Wal-Mart Stores, Inc. v. Samara Brors*
- *Zatarains, Inc. v. Oak Grove Smokehouse*
- *Main-Line v United Overseas Bank*
- *ACB v. Ibomson Medicar ("ACT*
- *Cassell v Broome*
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5.3 Jordan cases

- *Derby case Decision of Jordanian Supreme Administrative Court No. 387/2021 dated 11/17/2021*
- *Jordanian High Court of Justice (J.H.C.J): 65/1972; 87/1972; 49/1988; 171/1988; 120/1997; 470/2007; 50/2007; 510/2008;170/2011; 524/2011; 298/2012.*
- *Jordanian Supreme Court in terms of Zara trademark. The latter decision holds No. 2006/344. It was issued by a judiciary consisting of five members on 20/12/2006. Publications of Adalah Centre*
- *The Jordanian Supreme Court issued a decision regarding the Zara trademark. The latter decision holds No. 2006/344. It was issued by a five-member judiciary on 20/12/2006, publications of Adalah Centre.*
- *Nashed Bror's case*
- *Optim Neuterchen VS Optim Neuterchen Inc*
- *The Supreme Court of Justice defined trademark in its Decision No. (49/1988), issued on 12/31/1988 and published in Bar Association magazine, as "letters, drawings, signs, or a mixture of se things having a distinctive character and not violating public order and whose purpose is Distinguishing one good, good or service from another.*
- *Zara trademark*