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# Rules of Well-known Trademarks in Jordan's Trademark Amended Law No 34 of 1999

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## Abstract

This study examines the rule of well know trademarks in Jordan's Trademark Amended Law No. 34 of 1999, and especially analyses its articles 2, 8/12, 26/1/B owing to the fact that these articles are the most importance articles introduced by Jordanian legislation to the Jordanian Trademarks law No. 33 of 1952. Beside that, this study presents some of the decisions adopted Jordanian High Court on legal protection of well known Trademark under the Jordanian's Trademark Amended Law No. 34 of 1999.

## Introduction

A well-known trademark is nothing more originally than an ordinary trademark that has spread through markets, became familiar to all people concerned in the realm of industry, commerce and services, and has been associated with products, commodities and services of high quality and distinction.<sup>(1)</sup> Meanwhile, a trademark's "fame" is usually recognized by many factors, including the magnitude of its differential mark of identification, public confidence and the goods which carry its label. <sup>(2)</sup>

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(1) P.S. Sangal and K. Ponnuswami, Intellectual Property Law, Delhi, India, 1994, p. 138, 147. (See also Background Reading Material on Intellectual Property, Geneva, Switzerland, 1988, p. 188).

(2) Heinz David, "Past and Present Developments in the International Law of Trademarks", Brooklyn J. International Law, Vol. 2, 1975, p. 76.

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So, in view of the linkage between a trademark and the goods used for its distinction, promoting the former would subsequently lead to the promulgation of the latter. Hence handling a trademark by others would suggest to consumers that there does exist a kind of connection between the goods of both: the others and the trademark's proprietor. This may generate, in turn, an unrightful rivalry which the trademark's owner has to face, not only in the commodities he actually deals with, but also in those he never handled at all. Such a problem can even be worse if the trademark's proprietor had not previously registered it abroad, or had never introduced it to world markets. In that case, he would affront serious challenges while defending and preserving his property rights in those countries where the trademark was not registered or used.

It was in this context that the owner of the well-known "Kodak" trademark of cameras stopped and prevented others from using the word (Kodak) for bicycles, as did - before him - the owner of the "Bata" trademark of shoes to others when he prevented them from using the word (Bata), or any of its derivatives for furnishings.<sup>(3)</sup> In a third case, the court ruled in favor of the trademark's owner who refused to let others use his trademark's "ape" picture, as characteristic of his products of undies, even if it is coupled with the word (El Mono), to promote a certain kind of pants. Like-wise, the court ruled out the use of "Cairo Cola" for its similarity in shape, writing, and tone to "Coca Cola", thus avoiding consumer confusion.<sup>(4)</sup>

All that said, protection of well-known trademarks has forced itself as a major issue in international conventions dealing with international property rights<sup>(5)</sup>, and in national legislations as well.<sup>(6)</sup>

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(3) Case of Eastern V. Griffith Cycle Corporation, Report of Patent Cases, Vol. 15, 1998, p. 105; Case of Bata India, V. M/S Pyare Lal and Company, All India Reporter, 1985, p. 242.

(4) Dr Moh'd H. Ismail, International Protection of Trademarks, (PhD thesis, Faculty of Law, Cairo University, 1978, pp. 48-50, p. 311 (Arabic); and also Dr Mustafa K. Taha, Lebanese Commercial Law, first edition, Part 1, 1975, p. 751 (Arabic).

(5) For instance, it was brought into focus in 'Paris Convention of the Protection of Industrial and Commercial Property', (1883 the Paris Convention) (1967). And in 'Agreement on Trade-related Aspects of Intellectual Property Rights' (TRIPS Agreement) (1994).

(6) Dr Sameha Al qulubi, Industrial legislations, Cairo, 2003, p.2003, p.500 (Arabic) see also Dr Jalal Mohumudeen, protiction of Industrial property, Alexandria, 2000 p. 103. (Arabic).

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In Jordan, trademarks are governed by Trademarks Law, 1952 <sup>(7)</sup>; and Trademarks Amended Law, 1999. <sup>(8)</sup> The latter law pays, in fact, an apparent and unprecedented attention to well-known trademarks by appropriating actually more than one article in its rules to deal with this issue. "Article 2" of that document, for instance, defines a trademark; "Article 8/12" prohibits the registration of any analogous, similar or translation of a trademark's name, while "Article 26/1/B" prevents others from using a trademark's name on identical or unsimilar products or services.

In this study, I shall try to examine the governing rules of well-known trademarks as stated in Jordan's Trademarks Amended Law, No 34 of 1999, in three main areas:

- 1 - Definition of a well-known trademark.
- 2 - Scope of protection a well-known trademark.
- 3 - judicial applications regarding well-known trademarks.

### **First: Definition of a Well-known Trademark:**

Jordan's law defines a well-known trademark as the trademark whose worldwide reputation has gone beyond the country where it was originally registered and gained popularity in the concerned sector of the public in the Hashemite Kingdom of Jordan (Article 2). Indeed, this wording falls short of a full definition as it doesn't exactly describe the meaning of "popularity", which is the core of the definition. Rather, this definition has limited itself to the criterion of the trademark's "popularity", and made it of two concomitant parts: a) that the trademark should be of an international reputation that has gone beyond the country where it was originally registered, and b) that it should have acquired "popularity" in the respective sector of Jordan's population.

In its two parts, this criterion is apparently inaccurate. It doesn't define, in its first part, "the internationally well-known trademark", neither does it point out when "a well-known trademark's reputation can

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(7) See also Rules of trademarks, 1952 and Merchandise Marks law, 1953.

(8) Published in the Official journal, No 4389, on November 1, 1999, p. 4299

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be recognized as "having gone beyond the country where it was originally registered", whether it is the country of origin that owns the trademark, or the country where the trademark has an industrial or commercial corporation of its own. In the second part, this criterion is void of "fame" limitation and range. Besides that, there is uncertainty about the meaning of "the respective sector of Jordan's population", whether it is the wholesale or retail dealers of the products, goods, commodities, or services which carry the trademark's label, or it is the public consumer. In fact, "the respective sector of Jordan's population" could be either these or those, or even both.

Moreover, Jordan's law doesn't determine the reason of a trademark's "popularity", neither does it link between this "popularity" and the reason and/or reasons which could lead to it, whereas TRIPS does attach it to the promotion of the trademark<sup>(9)</sup> (Article 16/2 of TRIPS, 1994).

However, it counts with the Jordanian law that it has, in its definition of a well-known trademark, made the latter's protection closely linked to acquiring "popularity" in the respective sector of the population in the Kingdom, and not only because of its reputation abroad. In fact, this law makes it imperative for the trademark to gain popularity in the respective sector of the society in Jordan on the one hand, and tries to adapt to "Article 6 / Secondly" of Paris Convention, and "Article 16" of TRIPS on the other.<sup>(10)</sup>

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(9) Paul J. Heald, Trademarks and Geographical Indication: Exploring the contours of TRIPS Agreement Vanderbilt Journal of translational law, Vol 29, No3, 1996, pp. 635-660.

(10) Article 6/bis of Paris Convention stipulates: 1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. 2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested. 3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith. And Article 16 of TRIPS Agreement reads: 1) The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of =

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Among other factors, this has facilitated Jordan's membership in the World Trade Organization (WTO). Hence no overstatement in saying that this definition of the well-known trademark reflects the concept of the trademark under the two conventions of Paris and TRIPS, and is compatible to the rules of trademarks embodied there in general<sup>(11)</sup>.

It is worth mentioning that before the Trademarks Law was amended in 1999, Jordan's Judiciary had already been settled on that "the owner of a trademark that is registered abroad, known and used in Jordan, shall have the right to object the registration of any similar trademark to his own, if that would confuse the public or encourage unjust rivalry. The law does not, however, provide that the objector should have owned a registered trademark in Jordan."<sup>(12)</sup>

Recently, Jordans High Court confirmed that " the user of a trademark shall have the right to demand that a trademark registered by someone else be deleted if similarity between the two trademarks is proven, and would lead to the confusion of the public, and if dealing with the former was prior to the date of registration of the one requested to be removed, and, finally, if the latter was registered less than five years" (See. Case No 454/99 on 28/2/2000).

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= trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use. 2) Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark. 3) Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect or which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

(11) WIPO, Publication No 832 (A) 2000, p. 8-28. See also, WIPO publication No 435 (E) 1997, pp.50-160 and WIPO, GILL/ IP/ DUB/ 98-Wo, INF/ 133, 1997 pp. 3-6.

(12) Case No. 171/88 High Court, Jordan Bar Association Journal (here in after referred to as the JBAJ) 1989, p. 933; Case No. 32/87 High Court JBAJ 1988; P. 1297; Case No. 4/53 High Court, JBAJ, 1953, P. 151.

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## **Second: Scope of Protection a Well-known Trademark:**

### **1. Registration Prohibition:**

Article 8/12 of the Jordanian Trademarks law prohibits the registration of "A Trademark which is identical, similar to, or a translation of a well-known trademark for use in distinguishing goods similar of identical to the goods for which it became well-known and which shall create confusion with the well-known mark or for use for goods other than that in a manner which may damage the interests of the Proprietor of the well-known trademark and which may suggest a relation between the Proprietor and that goods."<sup>(13)</sup> Such a prohibition extends to include:

- I. Any trademark that is intended to be registered and "is identical" with a well-known trademark. In such a case, the former appears as if it were a true copy of the latter, i.e. an exact duplication with no differentiation or peculiarity, but similarity and identity of the two.<sup>(14)</sup>
- II. Any trademark that is "similar" to a well-known trademark, i.e. the intended brand for registration be only imitative to a well-known trademark and falls short of being fully identical to it. Thus showing no full identity, but just actual similarity and imitation.
- III. Any trademark that is a "translation" of a well-known trademark. "Translation" here is meant to be the transform of a trademark's from one language to another. In such a case, no identity, analogy, or imitation is used, but a translation of the trademark's into another language and giving it the same meaning irrespective of the language. In fact, it makes no difference whether the well-known trademark's name is written in Arabic, English, French or whatever language.

Meanwhile, and in accordance with the Article under discussion, being identical, similar, or translated are not sufficient for the registration

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(13) Nabeel Law office Team, Intellectual property laws, Amman, 2002, p. 139.

(14) Salah Salman Al Asmar, Exposition of Jordan's Trademarks Law, 1992, p. 167; see also case No 164/88, High court, JBAJ 1989, p. 933.

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prohibition of a trademark, so applying for registration should be based on either of two reasons: 1) that the purpose of its use is to distinguish certain analogous goods to those carrying the well-known trademark. Thereupon, such a use would eventually create confusion between the well-known trademark and the one intended for registration; and 2) that the purpose of this use is to distinguish unsimilar and unidentical goods to those which carry the well-known trademark. Whereupon, that use would probably affect the interest of the owner of the latter on the one hand, and suggests a kind of relation between the proprietor and the goods on the other.

This clearly shows that the law expands the scope of registration prohibition of identical, similar, or translation form of a well-known trademark to include the use of both identical and unidentical goods, once the restrictions mentioned above are provided. Noteworthy is the fact that the script under review has used the word "goods" alone and didn't follow it with "products" or "services". This suggests that it is confined to the trade that is used to distinguish only "goods", thus excluding its validity to the brand used to distinguish "products" or "services". In reality, all the rules stated in the Jordanian Trademarks Law, and deal with those distinguished goods or products, apply also to the trademarks of distinguished services (Article 43).

Still, it should be underlined that the Article under examination is in harmony with the TRIPS Agreement with regard to the protection of well-known trademark<sup>(15)</sup> (Article 16, TRIPS, 1994).

It is also worth mentioning that the Jordanian jurisdiction has effectively challenged cases where owners of foreign trademark's applied for the registration of identical trademark's in the country, and accordingly issued crystal clear rulings.<sup>(16)</sup> It, for instance, "ruled that the appellant's registration of MILLER trademark, which is owned by another company abroad (i.e. Miller Browning Company) that enjoys

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(15) WIPO, Publication No 435 (E) 1997, pp.50-61.

(16) See case No. 215/95 High court, JBAJ, 1996 P. 645; 171/88, High court JBAJ 1989, P. 933; 32/87 High court, JBAJ, 1988 P. 1207.

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international reputation, would create an unjust competition and would lead to consumer confusion as it involves a mix-up between the national and foreign commodities. Hence it is imperative to prevent the registration of any trademark that carries the name of similar products." ( case No 120/97 High Court).<sup>(17)</sup>

In this context, Dar Al Dawa for Development and Investment, a national company in Jordan, didn't manage to register the "Tagadar" trademark with a view to distinguishing certain kinds of drugs owing to the objection raised by a foreign company (i.e. Smith Klein and French Layour Anources). Thereupon, the Jordanian Regitstrar accepted the objection, and the High Court in turn supported that decision. In the proceedings of the Court's ruling, we read that "Smith Company has registered a number of trademark's whose main idea is 'Taga', and the medicine's name is solely 'Taga' or with annexed syllables such as 'Tagadial', 'Tagamay', or 'Tagadiane'. The fame of the respondent Smith Company is so wide in this regard that its sales of this drug were \$825 million in 1982, and \$53000 in Jordan in 1983. Therefore, we deem it that the Jordanian company of Dar al Dawa, intended to make advantage of this fame by taking the first syllable of the basic idea of the trademark, i.e. Taga, added another syllable (i.e. dar), thus the name of the trademark required for registration became 'Tagadar' so the appeal is dismissed." (case No 164/88 High court, JBAJ, 1989, P. 924).

## **2. Use Prohibition:**

Article 26/1/B of Jordan's Trademarks Law states that "if the trademark is well-known, but not registered, then its owner shall have the right to request the court concerned to prohibit others from using it on similar or unsimilar products or services, provided that the use of this trademark indicates a connection between those products or services and the well-known trademark on the one hand, and the possible inherent damage of the owner's interest as a result of that on the other. It is also

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(17) Judicial Journal, vol.1, December 1997 Issue No 5, p. 351.

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assumed that confusion may probably be created by using an identical well-known trademark on similar products."<sup>(18)</sup>

This Article deals with the proposition that others may use a registered or unregistered well-known trademark, in the country of use, whether that use is namely aimed at identical or unidentical products or services.

It is also clear that the Article under discussion gives, in this case, the well-known trademark proprietor the right to request from the court concerned to issue a ruling which prohibits others from using his own famous brand on similar or unsimilar products or services. To be successful, the trademark's owner has to present evidence to the effect that:

- A. Such a use indicates a linkage between these products or services on the one hand, and the well-known trademark on the other;
- B. Such a use implies a possible damage to the interest of the trademark's proprietor.

Considering that the Article assumes a confusion occurrence while an identical, similar, or translation of a well-known trademark is used for identical products, and as such no need to present evidence, it doesn't nevertheless presume a confusion occurrence if that trademark is used on unsimilar products, thus making imperative the presentation of evidence to that possibility. In other words, the script takes the confusion occurrence as an assumption in the case of using identical products, and as unpresumed confusion in use of unidentical products.

It should be noted that the Article under review falls short in more than one aspect. There is obscurity, for instance, in the statement that "if the well-known trademark hadn't been registered", a formulation that may suggest it had never been subject to registration at all, neither in its country of origin nor elsewhere, whereas the intention behind that is meant to be the trademark's registration in its country of origin and its non-registration abroad (i.e. the country in which protection is required).

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(18) Nabeel Law office Team, Ibid, p. 139.

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In that case, the trademark's proprietor shall have the right to request the court concerned to prohibit others from using it in the country where it is handled unrightfully, even if it was not registered there.

Ambiguity also surrounded the formulation "prohibiting others from using it". This may imply any other person than its owner, though limitation is restricted here to the use of identical, similar, or translation of a well-known trademark without permission from the owner of the latter.

Note should, however, be made that the Article under examination has limited the prohibition application to the court concerned to be presented only by the owner of the well-known trademark. On my part, I think that such a license should be granted to the Franchisee too

Whatever the matter, the Article under consideration doesn't fix the date of applying for legal action, neither does it limit its time span. Should that order be submitted as of the date the trademark owner got to know of his trademark's use by others? How long should that right be valid?

In fact, the legal wording of Jordan's Trademarks Amended Law, No 34 of 1999, concerning well-known trademarks, does not give answers to these questions. But I think this can be done by having the owner of the well-known trademark demand the prohibition of using it within five years starting from the date of his knowledge of its use by others, as indicated by "Article 25/5" of the Trademarks Law which states that "each application for a trademark deletion from the Registry files shall be presented within five years of the date of the trademark's registration.". This period should start from the proper date of filing the trademark and not from the date of applying for registration<sup>(19)</sup>.

In case NO.188/92, the high court held that: "As concluded by the Court, the case shows that the appellant company, the second - Brown and Anderson Corporation - (a foreign company) owns the registered VICEROY trademark under the registration No 13711 at the trademarks

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(19) Case No. 79/94 High court, JBAJ 1990 P.17; 150/90 High court JBAJ, 1993 P. 28; 64/77 High court JBAJ, 1977 P. 1403...

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registry of the Ministry of Industry and Trade, Category 34, Tobacco, manufactured and non-manufactured. Its registration has been renewed for 14 years as of July 16, 1982. On May 17, 1992, an imported shipment of cigarettes arrived in Aqaba Port for "Khirfan Brothers Company", (a local company), carrying the VICEROY brand on the boxes of these imported cigarettes. The appellant filed a lawsuit at the Magistrate - Criminal Court in Amman on May 21, 1992, demanding legal action against Khirfan Brothers Company - the defendant - for its violation of the Trademarks Law and for its transgression on the appellant's brand. On July 14, 1992, Khirfan Brothers filed at our court a lawsuit requesting the deletion of the trademark that belongs to the appellee in accordance with "Article 22" of the Trademarks Law No 33 of 1952, saying that the latter hasn't used this trademark for two years prior to July 14, 1992. We see it well-established that the imported tobacco doesn't carry on its boxes or grosses any sign of the place of its manufacture or name of manufacturer, hence it is of anonymous made and country of origin. As the name VICEROY, that is attached to the imported goods, is the same as the one registered in the name of the appellee company, then the importer is in the position of who has brought into Aqaba Port goods of unknown manufacture and origin to compete with a properly registered trademark in Jordan. And since dealing with anonymous goods that compete with an already registered and owned trademark would create delusion and deception among the public, then processing such goods can never be entitled to a legal protection that qualifies to challenge the proprietor of the registered trademark and as such, no legitimate interest is available to file this lawsuit. Therefore, the Court decides to dismiss the case by majority of its members.(Issued on 21 Shawwal 1314 H corresponding to 13 April 1993)."<sup>(20)</sup>

In infringement to this ruling we read: "I disagree with the majority of the respectful panel in the conclusion it has reached, which includes the dismissal of the case owing to the lack of the appellant's interest. But with reference to "Article 22" of the Trademarks Law, and as it is proven

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(20) JBAJ, 9 and 10 Double issue, 1994, p. 1981.

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that the appellants are merchants who deal with various kinds of goods, including cigarettes, then they have a legitimate interest in demanding the deletion of the trademark, subject of this lawsuit, from the trademarks registry for not using it for two years before the date of filing this case. For as long as that trademark is registered in the name of the appellant, all other merchants, including the appellees, are prohibited from using it, otherwise they would be subject to criminal punishment. Yet in the case of the trademark's deletion from the registry, the appellants and other merchants are lawfully right to use it. Hence, the appellants' interest is available in this lawsuit, and should accordingly be counted for. But as the hearsay evidences, especially the testimonies of the officials of the Ministry of Supply, point out that the appellee company never used the trademark under contestation during the last two years that preceded the date of the deletion request, due to the fact that cigarette imports were only commissioned to the above-mentioned ministry which never imported or agreed to importing cigarettes carrying that label to Jordan. This means that the brand was not used in the sense stated in Article 22, neither is there protestation against using a quantity of cigarettes carrying this trademark in the duty free at the airport to the effect of the intended use in the afore-mentioned Article 22, because the very use concerned in a restricted zone does not mean the use in general. Therefore, and contrary to the judgment of my colleagues, I deem it right to delete trademark No 13711 (VICEROY) under contestation from the register. (Issued on 21 Shawwal 1314 H, corresponding to 13 April 1993)."<sup>(21)</sup>

### **3. Cancellation of a Registered Trademark:**

We said previously that the Jordanian Law prohibits the registration of "a trademark that is identical, similar, or translation of a well-known trademark" whenever the provisions and conditions of Article 8/12 of the Jordanian Trademarks Law are available. It also prohibits the use of

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(21) Ibid, p. 1985.

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such a trademark when the provisions and conditions of Article 26/1/B of the same law are abound.

But what is the rule if some people manage to register "a trademark that is identical, similar, or translation of a well-known trademark"? Taking into consideration that such a registration may happen by a registrar's mistake (Article 15/1) or in violation of the Law (Article 25/5) of Jordan's Trademarks Law respectively. It could also happen by means of good or bad will, as was envisioned before and after the law amendment. Hence the question: who has the right to request cancellation?

Indeed, the legal scripts concerning the well-known trademark, as formulated in Jordan's Trademarks Amended Law, no 34 of 1999, do not deal with this case, neither do they touch upon answering these questions. So I think I would probably be correct when I say that the trademark's owner has no other way, in principle, than prompting a demand for the cancellation of the registered trademark that is "identical, similar, or translation of a well-known trademark" under Article 34 of the above-mentioned law, which stipulates that "no one shall have the right to file a lawsuit of compensation for transgression on an unregistered trademark in the Kingdom, but shall have the right to demand the registrar to annul a trademark that had been registered by a person who doesn't own it, and after having been registered abroad." I also think I am right in this understanding basing myself on the indications drawn from "Article 8, Article 15/1, and Article 25/5" of the same law, especially the latter which states that "a trademark cancellation request should be filed within five years of time starting from the date of registration of the trademark concerned, irrespective of the good or bad will of who made the registration". However, the good and bad will in registry should be differentiated. That is, the cancellation request should be filed within five years from the date of registration once that was managed with a good will, and without linking the cancellation request with any period of time if the brand was registered with a bad will.<sup>(22)</sup>

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(22) See Article 6 of Paris Convention for Protection of Industrial and Commercial Property.

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In my understanding, there would be no harm anyway if the cancellation order is presented by the owner of the well-known trademark or anybody else (Article 14 of Jordan's Trademarks Law), while keeping in mind that the law itself restricts the prohibition order of others from using a well-known trademark to its owner as pointed out earlier. However, the owner of the well-known trademark, and the like, can also file the cancellation order of "identical, similar, or translation of his own trademark" on basis of the fact that the trademark subject for cancellation from the registry is one of those legally banned trademark's in accordance with Paragraph 12 of Article 8, or on that maintaining such a trademark in the registry would create an unjust rivalry, and confuse the public, or on any other legal reference that makes viable basis for a cancellation order.

In this context the High Court observed that "the owner of a trademark registered abroad shall have the right to file a lawsuit to foil the registration of such a trademark in the Hashemite Kingdom of Jordan if maintaining its registration contravenes with public order and morale, or leads to public confusion through the promulgation of the goods which carry its label."<sup>(23)</sup>

In Subhi Jabri Company (a Jordanian company)V. Gelati Cortina (a Lebanese company) in their dispute on the GIANT trademark. In this case, the Jordanian company had registered the afore-mentioned trademark under Category 30. The Lebanese company objected to that officially before the Jordanian trademarks registrar, and demanded the cancellation of the trademark. This demand was based on the claim that the trademark was owned and registered in its name for a long time in Lebanon. The Jordanian registrar accepted the objection and ruled for the abolition of the trademark in Jordan. As the Jordanian company appealed to the High Court, the latter seconded the registrar's decision. The High Court observed in that the user of the trademark has the right to request the cancellation of its registration, if similarity between the two trademark's is proven to be creating confusion among the public, and if

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(23) Case No 4/53, High court JBAJ, Issue No 4, First Year, p. 151.

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handling the former trademark occurred prior to the date of registration of the trademark that is requested to be cancelled, and while five years have not elapsed yet since its registration.

As the papers of the lawsuit show to the Court, the appellant company (the Lebanese company) does own the trademark GIANT and it is registered in its name abroad (Republic of Lebanon) by an apparent trademark registration document that is presented in these papers. Indeed, the papers, bills, statements under oath and daily sale vouchers also confirm that the appellant company had used the above-mentioned trademark prior to the registration date of the trademark demanded for abolition at a time when it has become known in its form, distinguished in goods, widespread in reputation, and is settled in Lebanon.

It is also clear that the two trademarks are identical in name (i.e. in writing and pronunciation) thus leading to public confusion as they are both of the same category of goods (i.e. cream and gelati). In addition, five years have not elapsed yet since it was registered. Therefore, the legal conditions provided by the Jordanian Law for the cancellation of a trademark that is registered under the name of another person are available, and the decision of the trademarks registrar to this effect is right and is issued in proper harmony with the law; hence all reasons for the appeal are out of question and must be dismissed. (Case No. 454/99 High Court, 28/2/2000).

### **Third: Judicial Applications:**

Reviewing Jordanian jurisprudence in the aftermath of the amendment of the trademarks law, it seems that the above-mentioned shortfalls, ambiguity, or contradictions implied in the Articles of the Amended Law no 34 of 1999, especially Articles: 2, 8/12, 26/1/B which deal with the "popularity" of the trademark, are reflected on the jurisdiction in more than one ruling.<sup>(24)</sup>

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(24) See for instance: Ruling No 34, case 428/2000, High court, of 21/2/2001; Ruling No 35, case 431/2000, High court of 21/2/2001; Ruling No 37, case 430/2000 High court, of 21/2/2001; Ruling No 38, case 432/2000, High court, of 21/2/2001; and Ruling No 29, case 429/2000, High court, of 21/2/2001.

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In his decision No 8834 of 21 August 2000, the trademarks registrar in Jordan rejected for example, the registration order of LIONGING trademark that was submitted by the Halawani Industrial Company, on basis that the trademark is "a well-known trademark" and owned by Walt Disney Company - Disney Enterprise. Halawani Company appealed to the Hihg Court which ruled out the appeal by majority of its panel members drawing on Article 8/12 of the law. The Ruling reads in part: "In this issue, we see that the LIONGING brand appealed for registration under the name of the appelee is a well-known trademark and owned by Walt Disney Company - Disney Enterprise - under LIONKING, with one different letter: K for G. This is clearly proven by the documents attached to the appellant declaration under whose name the brand is registered in most countries of the world, including the USA, Britain, Germany, Canada, Burma, Egypt, Kuwait, and Lebanon, on dates prior to that of the appelee's application of registration, and while the Walt Disney Company has been using the LIONKING brand to realize its purposes in several sorts of goods, including those of Category"30.

“With reference to Article 8 of the Trademarks Amended Law no 34 of 1999,

we find that its 6th and 12th paragraphs prohibit the registration of:

6. trademarks which contravene with public order and morale or lead to public confusion, or those which encourage unrightful trade competition, or those which indicate other than their country of origin;
12. identical, similar, or translation of a well-known trademark used for purposes of distinguishing similar or identical goods to those characteristic of the brand and would eventually create confusion with the famous one, or for using it in other goods in a way that would probably damage the interest of the well-known brand proprietor and suggest a kind of linkage between them.

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**Also we find Article 11 of the same law stipulates that:**

1. He who claims to be a trademark's proprietor, that was used or intended to be used, and wishes to register it shall have the right to properly apply for that in writing to the registrar.
  2. The registrar may dismiss, while observing the rules of this law, such application unconditionally, or accept it with certain conditions, amendments, or modifications of the way, place, and otherwise of its use.
- Since the concerned LIONGING trademark, which is applied for registration by the appellee, is identical and similar to the LIONKING trademark, except the letter "G" instead of "K", and is owned by Walt Disney Company and registered under its name in many countries in the world prior to the appellee's application for registration, thus leading to public confusion and encouraging unrightful trade rivalry;
  - While our Court's discretion has settled on granting protection to well-known trademarks, irrespective of their registration or handling in the Kingdom, where protection is not confined to the trademark alone, but to the public as well from deception, misleading and delusion So that we resolve by majority to turn down the appeal"<sup>(25)</sup>.

As for the dissenting opinion in the panel on the same case, we read:<sup>(26)</sup>"with full respect to the esteemed majority of the panel, we disagree with the conclusion they have reached. This is explained by the fact that 'Article 2' of the trademarks Law No 33 of 1952 and its amendment by Law No 34 of 1999 define a well-known trademark as 'the trademark whose worldwide reputation has gone beyond the country where it was originally registered and gained popularity in the concerned sector of the public in the Hashemite Kingdom of Jordan;'

"And also by Article 8/12 of the same law after amendment, which prohibits the registration of 'analogous, similar, or translation of a well-known trademark for using it to distinguish similar or unsimilar goods to

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(25) Ruling No 39, case 429/2000, High court issued and made public on 28 Thul Qeida 1421 H.

(26) Ibid.

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those which have brought about its popularity, and would thereupon create confusion with the well-known or its use of other goods that may damage the interest of its proprietor and suggest a linkage between him and these goods.

"Concluding from the above, even with holding back the registration of the defined trademark in Paragraph 12 of Article 8 provides that this very trademark should be 'similar, analogous, or translation of a well-known trademark'

"And since the appellant has based itself in its appealed decision only on the rules of the afore-mentioned Paragraph 12, and not on any other item of Article 8,

"And as nothing in the trademark's record, that is filed by the appellant in the case, nor in the attached documents to the appellant's declaration, indicates that this trademark is registered in 'The Hashemite Kingdom of Jordan, or well-known to consumers in Jordan in the sense meant by the definition as stipulated in Article 2 of the above-mentioned Trademarks Law;' and that the appellant should have made sure, before filing the appeal, that the script of Paragraph 12 and the definition of the trademark apply to the subject case of the case. As the appellant fell short of that, then his appeal is doomed premature and has to be abolished.

"To say that 'suffice' it to mention that the LIONKING trademark is owned by Walt Disney and registered in most countries on the world, is actually irrelevant since the appellant hasn't presented any evidence of its registration in Jordan, most countries of the world, and/or it is a well-known trademark to the Jordanian public in the sense underlined above. Moreover, the trademark's popularity in some countries of the world doesn't necessarily mean it has become so in the Hashemite Kingdom of Jordan. Hence, having said all that, and contrary to the opinion of the esteemed majority, we deem the appealed ruling be dissolved." (Ruling No 39, case 429/2000, High court of 21/2/2001).

Thus, if Articles which regulate the rules of well-known trademarks are taken into consideration, then it seems obvious that the difference between the decision of the majority and the dissenting one in the above-

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mentioned case emanates from a different approach to determining "the concept of a trademark" on the one hand, and from the criterion of a trademark's "popularity" on the other.

As for me, I strongly believe that the dissenting opinion is more effective than that of the majority of the panel, though rejecting the registration of that trademark was possible in accordance with Paragraphs 6, 9, and 10 of Article 8 of the Trademarks Law (i.e. leading to public confusion), and with no need of reference to Paragraph 12 of the same article, as the latter deals specifically with the a well-known trademark in the legal sense which is missing in the case subject to ruling, and in spite of our admission that the trademark is not unrecognized, but definitely not well-known in the legal sense of "popularity" in the Jordanian law.

### **Conclusions and Recommendations**

1. The definition of a well-known trademark, as brought about by the Jordanian Trademarks Law no 34 of 1999, echoes the well-known trademark conception under "Article 6 - Secondly", of the Paris convention, and "Article 16" of TRIPS. But the Jordanian law doesn't condition a trademark's "popularity" with the outcome of its promotion by its owner, or the like, as TRIPS does (Article 16/2). This necessarily invites the Jordanian legislator to make a link between the well-known trademark on the one hand, and the means leading to that end on the other, especially the marketing mechanism which requires the owner's care, support and encouragement, and the subsequent burden he would carry in terms of time, funds and effort to bring his trademark to the realm of fame.
2. In "Article 8 - Paragraph 12", the Jordanian legislator is limited only to the term "goods" and didn't follow it with "products" or "services" as he did in "Article 26/1/B". This could suggest that the protection approved of by the Jordanian Law for a well-known trademark could be confined to trademarks that are used to distinguish only "goods", and as such excludes the trademark that is used to distinguish "products" or "services". Hence, there is need to adapt the afore-mentioned paragraph so that ambiguity is removed

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3. In its formulation, "Article 26/1/B" involves several shortcomings. It, for instance, states that "if the trademark is well-known, though not registered" This is quite ambiguous, and may suggest that it was never subjected to registration, neither in its country of origin nor anywhere else. Indeed, attention is conceived in that the trademark is registered in its country of origin and not registered in the country where its protection is claimed. The article also stipulates "the prohibition of its use by others". Again, this is not void of obscurity, as it may suggest the exclusive prohibition from using it by anybody, whereas its use by others is meant to be without permission from its proprietor or used unlawfully. The Article moreover says "the trademark owner shall have the right to request the court concerned" This means that such a request is limited only to the trademark's owner and no one else. There is no reason for that in view of the fact that consumer protection and combating unrightfully rivalry are main aims of the Trademarks Law. In addition, Article 26/1/B doesn't define the period during which filing such an application is obligatory, neither does it fix when it should start; ... Hence, the article under review needs to be adapted so that ambiguity, obscurity, defect, and contradiction will be overcome.
  4. The Jordanian Trademarks Law doesn't deal with the question of some people having managed to register a trademark that is identical, similar, or a translation of a well-known trademark, whether that occurred by a registrar's mistake or breach of the law. Hence, the owner of a well-known trademark, or the like, must have the right to demand the abolition of such a trademark from the registry during a fixed period of time by means of a clear-cut text in the trademarks law.

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