



Abu-Ghazaleh Intellectual Property (AGIP)

*Member of Talal Abu-Ghazaleh Global
(TAG.Global)*

The Arab Organization for Global Professional Services

مجموعة طلال أبوغزالة
Talal Abu-Ghazaleh Organization 

Regional Experiences and National Case Studies on IP Systems

Presented by: Deema Abu Zulaikha

Brand Protection Enforcement

Selected Cases

First Case

Jurisdiction



The Arab Organization for Global Professional Services

مجموعة طلال أبوغزالة
Talal Abu-Ghazaleh Organization



www.tagorg.com

Syrian Legislations

- **Legislative Decree No. 47**
 - **IP Law No. 8 of 2007**

Type of Action

Cancellation action
against registration
of an identical
trademark (word
and logo) in class
(42).



Competent Authority

- The Special Committee of Protecting Well-Known TMs.

Type of Brand



Legal Basis of Well- known Trademarks Protection in Syria

Legislative Decree No. 47

“Conditions of Protection”

- The original TM will be protected even if it is not registered in Syria.
- The original TM shall be well-known.
- The counterfeit TM shall be identical or confusingly similar (on similar or different goods or services).
- The renown of the TM shall be proved in Syria **AND** Abroad.

Legislative Decree No. 47 “Conditions of Protection”

- The aspects of similarity shall lead:
 - 1- the customer to believe that there is a relation between the well-known TM and the counterfeit TM
 - 2- to cause damages to the rightful owner
 - 3- unjustified utilization of the TM

- The well-known trademark was not registered in Syria by the owner.
- The well-known trademark was not actually used in Syria by the owner.
- The well-known trademark is registered and actually used worldwide and precisely in the neighboring countries to Syria.

- The infringer registered the same word mark and logo in the same class (42).



Legal Procedures



- **A cancellation action had been filed before the Special Committee for Well-Known Trademarks and was based on:**
 - Evidences prove the worldwide registration of the trademark.
 - Evidences prove the actual use of the well-known trademark worldwide and in neighboring countries which are connected with the Syria with integrated relationships.

- Evidences prove the actual use of the well-known trademark worldwide and in neighboring countries (Jordan) which are connected with Syria with integrated relationships. Syrians are visiting Jordan on a daily basis and know the Jordanian market very well.

- The bad intention of the infringer, as follows:
 - Take an unlawful advantage of the international fame of the trademark.
 - The infringer had previously registered other well-known brands for fast food services and they were cancelled by virtue of a judicial decision.
- The legal protection the Syrian Law confers to well-known trademarks even if not registered.

Decision



The Committee decided to cancel the registration of the infringing trademark.

Brand Protection Enforcement

Selected Cases

Second Case

Jurisdiction



The Arab Organization for Global Professional Services

مجموعة طلال أبوغزاله
Talal Abu-Ghazaleh Organization



www.tagorg.com

UAE Legislations

- Federal Law No. 37 of 1992 on Trademarks (amended by Law No. 19 of 2000 and Law No. 8 of 2002)

Competent Authority

- First Instance Commercial Court

Type of Brand



Zalatimo Brothers for Sweets Vs. Zalatimoh for Arabic Sweets



Zalatimo Brothers for Sweets Vs. Zalatimoh for Arabic Sweets



Zalatimoh Arabic Sweets L.L.C

زلاطيموه للحلويات العربية ش.ذ.م.م

Type of Action

- TM infringement and cancellation of a trade name.

trade name

Infringement Action:

- Registering a trade name in the UAE which is identical to a well-known trademark registered in the UAE, regionally and internationally.
- Using similar business theme of the original shops as well as similar domain names, websites and social media pages.
- Using the same theme of the products trade dress.



- The infringer was an employee of the original owner.
- The infringing trade name is confusingly similar with the original trademark and trade name and the overall final impression.
- The infringer used the same logo and business theme of the owner.

FACTS

- The original trademark is registered in the UAE in class (42), in the country of origin Jordan, regionally and internationally.
- The owner uses his trademark in the UAE markets since 2005 through online shopping and other commercial transactions.

Legal Base

- *Article (17) of the UAE Trademarks Law:*

“Any person who registers a mark shall be deemed its sole owner. The ownership of such mark may not be disputed if the person who registers it, uses it continuously for at least (5) years from the date of registration without an action being lodged against him ruling for its validity”

Legal Base

- *Article 8 of Paris Convention* provided that:
 - A 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.
- *Article 6bis of Paris Convention* confirmed the protection of well-known trademarks.

Thinking Out of the Box

How to prove the use of a TM while the owner doesn't operate the business through actual stores in the UAE ?

Supporting Evidences

- List of purchases performed in Jordan through credit cards issued from banks in UAE to buy original products.



Supporting Evidences

- List of TM registrations worldwide.
- Proofs of prior use.



Supporting Evidences

- Appreciation letters from the UAE Embassy in Jordan.
- Copies of shipment policies which prove shipping the original products to many countries all over the world.
- Copies of shipment policies which prove shipping our client's products to UAE.

Court Decision



The court issued its decision to **revoke** the registration of the infringer's trade name and to **stop** any infringement action and to **remove** all infringement aspects from their shop, exhibits and social media pages.

Thank you



The Arab Organization for Global Professional Services

مجموعة طلوع الغد
Talal Abu-Ghazaleh Organization



www.tagorg.com