

### III. The trademark system of the Gulf Cooperation Council (GCC)

#### *Introduction*

This chapter sets out the trademark system in the GCC. Part A explains the religious foundations of these countries in order to increase understanding of the GCC position on the registrability of trademarks that raise cultural and public moral concerns. Part B outlines each country's international obligations based on membership of international treaties. Part C discusses the new GCC Trademark Law, which is not yet implemented by all members. The chapter highlights the main challenges to this harmonisation. Part D briefly introduces two peculiarities of trademark regulation in Arab league countries: first, the contentious issue of trademark rights denied to firms linked to a boycotted country, and, second, the prohibition on product classes that violate public morals and religious teachings. Part E considers how a selection of trademarks accepted by EU and/or US examiners would likely be treated by GCC examiners.

#### *A. Legal system, Shari'a law*

*Legal sources of Islamic law.* Islamic countries have both codified and non-codified sources of Islamic law. Codified sources have higher importance. They are: the *Qur'an*, the *Sunnah* (primary sources), and *ijma*.<sup>221</sup> Non-codified law comprises '*qiyyas*' and '*ijtihad*'.<sup>222</sup> '*Qiyyas*' is the concept of strict logical reasoning by analogy and is used to resolve conflict among the three codified sources. *Ijtihad*' is a jurist's tool in Islamic law and jurisprudence that encourages independent thought and deliberation to resolve problems where the other sources of law are silent. These sources form the body of Islamic religious law known as *Shari'a* law – the law of the *Qur'an* and the religious law of Muslims.

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221 Consensus on a point of law by authorized religious scholars after the death of the Prophet.

222 Khoury (n 125).

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*Shari'a*. *Shari'a* (Arabic: شريعة) means “the road to the watering place”, or the “clear path of commandment” to be followed.<sup>223</sup> This is important in the context of legal certainty and evolving norms discussed in Chapter II. Western jurisdictions deal with general rules and apply them to specific instances. *Shari'a* in contrast does not expound general legal principles, “it rather deals with specific instances, or transactions, and propounds rules relating thereto.... general principles must be deduced by analogy.”<sup>224</sup> While the text of the Qur'an cannot be changed or contradicted, critical reasoning through *ijtihad* allows interpretation to draw modern meaning. However, it is considered a prestigious task reserved for qualified religious scholars. Its relevance as a legal tool is said to have disappeared in the early tenth century.<sup>225</sup> ‘*Qiyas*’ remains a legal norm that judges can employ but its use is limited.

*Real property and intellectual property, (IP)*. The Qur'an does not expressly address intellectual property protection but it recognises certain legal concepts that function as a legal basis for IP protection, particularly protection of trademarks.<sup>226</sup> These are: personal rights and autonomy (*Haqq*), the right to income/accumulate wealth (*Mal*) (but in the hierarchy of values, morality is higher),<sup>227</sup> real property rights (private ownership of property cf. absolute ownership which is to God), the right to acquire real property including acquiring new or unclaimed items, and loss of title due to non-use.

*Constitutions*. *Shari'a* law is enshrined in the constitution of the U.A.E by Article 7 of the U.A.E Constitution,<sup>228</sup> in the constitution of Qatar by Arti-

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223 W. M. Ballantyne. Essays and Addresses on Arab Laws (Curzon Press 2000) 33.

224 *ibid* 34.

225 *ibid* 41. Although some reformist Muslim thinkers question the immutability of the text and seek a revival of *ijtihad* for modern society. See, for instance, Tariq Ramadan 'Radical Reform: Islamic Ethics and Liberation' (OUP 2009).

226 Khoury (n 125), citing, Ida Madieha Azmi, Spyros M. Maniatis & Bankole Sodipo, Distinctive Signs and Early Markets: Europe, Africa, and Islam, in Perspectives on Intellectual Property: The Prehistory and Development of Intellectual Property Systems Vol. 1, 123, 132 (Alison Firth ed., Sweet & Maxwell 1997).

227 Khoury (n 125) 77, citing, Syed Nawab Haidar Naqvi, Islam, Economics and Society 73 (Kegan Paul. Intl. 1994)

228 The Constitution of the UAE (1971). The Arabic version is the definitive legal text. Available at: <https://wipolex.wipo.int/en/text/440262>. Article 7: “Islam is the official religion of the UAE. The Islamic *Shari'a* is a main source of legislation in the UAE. The official language of the UAE is Arabic.”

cle 1 of the Constitution of the State of Qatar,<sup>229</sup> and in the constitution of Saudi Arabia by Article 1 of its Basic Law of Governance.<sup>230</sup> However, levels of conservatism differ. This is perhaps hinted at in the wording of the opening articles of the Saudi Arabian and Qatari Constitutions; the former recognises *Shari'a* as all encompassing, almost one and the same ("the constitution *is...*"). The latter places *Shari'a* as "the *main* source..."

The GCC states have large expatriate populations and high immigration, notably the UAE and Qatar. Saudi Arabia has the highest proportion of national citizens with 67.3% Saudi nationals. Emiratis comprise only 11.5% of the UAE population, while 14.3% of Qatar's population is Qatari.<sup>231</sup>

*Saudi Arabia.* Arabic is the official language and Islam is the official religion. Citizens are Muslim. Sunni Islam is the dominant sect. The population is 31m in 2015.<sup>232</sup> Article 7 of the Constitution of Saudi Arabia establishes the primacy of Islamic law: "The authority of the regime is derived from the Holy Qur'an and the prophet's Sunnah which rule over this and all other state laws." The interests of the state and the relationship with citizens are made clear in Articles 10-12. It is the resolve and duty of the state to "strengthen the bonds which hold the family together and to preserve its Arab and Islamic values" (Article 10); the state seeks to avoid "dissension" (Article 11) and will prohibit things that may "**lead to** disunity, sedition and division" (Article 12). The right to property is recognised, how-

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229 The Constitution of the State of Qatar (2004). English translation. The Arabic version is the definitive legal text. Available at: <https://wipolex.wipo.int/en/legislation/details/9626>. Article 1: "Qatar is an independent sovereign Arab State. Its religion is Islam and *Shari'a* law shall be a main source of its legislations. Its political system is democratic. The Arabic Language shall be its official language. The people of Qatar are a part of the Arab nation."

230 Basic Law of Governance (promulgated by the Royal Decree No. A/90 dated 27/08/1412H (March 1, 1992)). English translation. The Arabic version is the definitive legal text. Available at: <https://wipolex.wipo.int/en/legislation/details/7973>. Article 1 establishes the *Shari'a* and the Sunnah as its 'constitution' although there is no formal constitution as such: "The kingdom of Saudi Arabia is a sovereign Arab Islamic state. Its religion is Islam, and its constitution is the Holy Qur'an and the prophet's (peace be upon him) Sunnah (traditions). Its language is the Arabic language, and its capital city is Riyadh."

231 31 March 2015 statistics, available at the Demographic and Economic Database, Gulf Labour Markets and Migration website.

232 31million in 2015 according to Gulf Migration, available at: <http://gulfmigration.eu/glmm-database/demographic-and-economic-module/?search=1&cmct=Saudi+Arabia>. CIA World Factbook 28.6million in 2016 <https://www.cia.gov/library/publications/the-world-factbook/geos/sa.html>.

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ever it is not absolute and the state can expropriate property in the public interest.<sup>233</sup>

*UAE.* Both Abu Dhabi (the capital) and Dubai are commercial centres and the most populated of the seven emirates. The UAE population is 6 million as of July 2017.<sup>234</sup> Dubai has the largest population of 2.4 million.<sup>235</sup> The UAE has the seventh highest net migration rate in the world (12.36%). The majority of expatriates are Asians (75%). Westerners follow at 8%.<sup>236</sup> Arabic is the official language and Islam is the official religion (approx. 76% are Muslims).<sup>237</sup>

*Qatar.* English is commonly used as a second language, especially in business. Islam is the official religion, with 67.7% Muslims, 13.8% Christian, 13.8% Hindus. The population is 2.3m as at July 2017.<sup>238</sup> The words “morals” and “ethics” are expressly stated in the Constitution of Qatar: Part Two is dedicated to “The Guiding Principles of Society”. Article 21 states “the family is the basis of the society. A Qatari family is founded on religion, **ethics**, and patriotism”. “[H]igh **morals**” are one of the values upon which Qatari Society is said to be based (Article 18). Private property rights are recognised and limited: “Private property is inviolable; and no one shall be deprived of his property save by reason of public benefit and in the cases prescribed by the law.”<sup>239</sup>

#### *B. GCC IP Treaty Memberships*

The Gulf Cooperation Council (GCC) is an economic and political alliance between six countries in the Arabian Peninsula, all of which are autocracies: the United Arab Emirates (U.A.E.), Bahrain, Qatar, Saudi Arabia, Oman, and Kuwait. The GCC is “the Middle East’s most important region-

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233 Basic Law of Governance Article 1 (1992) Article 18. “The inviolability of private property shall be guaranteed by the state. Private property shall not be expropriated unless in the public interest, and the owner shall be fairly compensated”.

234 Available at: <https://www.cia.gov/library/publications/the-world-factbook/geos/qa.html>. Although the United Nations puts it at 9.3million.

235 End 2015 data, Dubai Statistics Centre.

236 2017 data, available at: <http://worldpopulationreview.com/countries/united-arab-emirates-population/>.

237 See: <https://www.cia.gov/library/publications/the-world-factbook/geos/ae.html>.

238 See: <https://www.cia.gov/library/publications/the-world-factbook/geos/qa.html>

239 Article 17 Charter of Fundamental Rights of the European Union, available at: <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A12012P%2FTXT>

al organisation.”<sup>240</sup> Saudi Arabia is the dominant member.<sup>241</sup> All are first-to-register jurisdictions and there is no common law tort of “passing off”. Each state has its own intellectual property laws and there are also unifying laws (the 1987 GCC Patent Law and the 2006 GCC Trademark Law).<sup>242</sup> They are contracting parties to the principal international IP-related multilateral treaties (see Table 1): [1] **WIPO-administered treaties**: the Berne Convention, Paris Convention,<sup>243</sup> Patent Cooperation Treaty. Only Bahrain and Oman are Madrid Union members (parties to the Madrid Protocol). None is a party to the Madrid Agreement;<sup>244</sup> [2] **The World Trade Organisation**:<sup>245</sup> as WTO members, they are bound by the **Agreement on Trade Related Aspects of Intellectual Property Rights** (TRIPS Agreement, 1994), which sets minimum standards for protection of intellectual property and must be transposed through legislation and/or case law. The GCC countries, with the exception of Bahrain,<sup>246</sup> are not parties to **The Nice Agreement**.<sup>247</sup> However, they apply the Nice Classification to categorise

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240 Anoushiravan Ehteshami, ‘GCC Foreign policy: From the Iran-Iraq War to the Arab Awakening’ LSE Middle East Centre collected papers, Vol 1. April 2015, available at: <http://eprints.lse.ac.uk/>

241 ibid 13. Ehteshami refers to its “geographical domination”; Dar & Pesley, 2006, ‘The Gulf Co-Operation Council: A Slow Path to Integration?’ 24 World Eco. No.9, 1161.

242 Only the Patent Law is ‘unitary’.

243 The Convention took effect in Qatar July 5, 2000; Saudi Arabia March 11, 2004; U.A.E. September 19, 1996; Kuwait December 2, 2014; Bahrain October 29, 1997; Oman July 14, 1999. See <http://www.wipo.int/treaties/en/ip/paris/>.

244 The Madrid-based International Trademarking System allows a bundle of national applications to ensue from a single international application. See [http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf).

245 Qatar acceded January 13, 1996; Saudi Arabia acceded December 11, 2005; Qatar acceded January 13, 1996; Bahrain acceded January 1, 1995; Kuwait acceded January 1, 1995; Oman acceded November 9, 2000 (WIPO). List of members available at: [http://www.wipo.int/wipolex/en/other\\_treaties/parties.jsp? treaty\\_id=231&group\\_id=22](http://www.wipo.int/wipolex/en/other_treaties/parties.jsp? treaty_id=231&group_id=22).

246 Entry into force: December 15, 2005.

247 The Agreement was established in 1957 at the Nice Diplomatic Conference. It established an international classification of goods and services for the purposes of registering trademarks. It has been revised twice (1967 at Stockholm, and 1977 at Geneva) and amended once (1979). The 11th edition of the Agreement entered into force on January 1, 2017, available at: <http://www.wipo.int/classifications/nice/en/preface.html>.

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items for national registration of marks.<sup>248</sup> Different editions of the Nice Classification are in use: the U.A.E. uses the 10th edition, Qatar uses the latest 11th edition,<sup>249</sup> Kuwait uses the 8th edition and Bahrain and Oman use the 10th edition.<sup>250</sup> The use of different editions may reduce the efficiency of filing in several jurisdictions. Saudi Arabia uses its own adapted version of Nice.<sup>251</sup> It contains the products permitted in Saudi applications. However, some items are included that would still certainly be rejected.<sup>252</sup> Only the specific terms in the list can be used in the specification filed, so applicants cannot circumvent an objection by amending the wording.

Table 1: Membership of multilateral agreements in the six jurisdictions.<sup>253</sup>

|              | Madrid System |            |                |                   |       |                  |
|--------------|---------------|------------|----------------|-------------------|-------|------------------|
| Country      | MA 1891       | MP 1989    | Nice Agreement | Nice Edition      | TRIPS | Paris Convention |
| UAE          | No            | No         | No             | 10th              | Yes   | Yes              |
| Qatar        | No            | No         | No             | 11th (45 Classes) | Yes   | Yes              |
| Saudi Arabia | No            | No         | No             | 10th              | Yes   | Yes              |
| Bahrain      | No            | Yes – 2005 | Yes            | 10th              | Yes   | Yes              |
| Kuwait       | No            | No         | No             | 8th               | Yes   | Yes              |
| Oman         | No            | Yes – 2007 | No             | 10th              | Yes   | Yes              |

248 Perhaps this ensures they have autonomy with respect to what classification categories they recognise, although Article 2 of the Nice Agreement permits signatories to exclude certain classification categories.

249 World Trademark Review Issue 67, 11.

250 <http://www.sabaip.com/en/Resources/IP-Tables/General-Information-on-Nice-Classification-in-the-MENA>

251 (التصنيف الدولي للسلع والخدمات (اتفاقية نيس)) International Classification of Goods and Services (Nice Agreement), at the Trademark Office website.

252 For example, dating services in Class 45, love dolls in Class 10, gambling in Class 41, bar services in Class 43, pork and ham in Class 29, ham glaze in Class 30, Christmas trees in Class 31.

253 Compiled using WIPO statistics. Bahrain shows most participation. Price attributes this to the Free Trade Agreements Bahrain has signed with the US. See Price (n 129).

### C. Harmonisation

The GCC Trademark Law was enacted by the GCC Supreme Council in December 2006 and approved in 2014.<sup>254</sup> It was the culmination of a twenty-year effort.<sup>255</sup> It sets out unifying provisions and standards for registration and enforcement of trademarks across the six GCC states. It should be noted that it is a harmonisation effort, not a unitary law. This means there is no unitary registration or enforcement system and trademarks still need to be registered on a national basis at each national trademark office. A company marketing products or services in all six states must file six separate applications at the six national receiving offices. There are slight differences in the procedural aspects of the national laws. As discussed, Saudi Arabia uses the trademark law in conjunction with the Shari'a law. The law has been ratified by all GCC states<sup>256</sup> but is not effective until implementation regulations are issued. To date, Kuwait, Bahrain, Saudi Arabia and Oman have issued implementing regulations,<sup>257</sup> but it is not clear how far they have gone in applying the new provisions. Excluded Nice classification categories are enumerated in implementing regulations.

*Public order and morality provisions.* The morality and public order exclusions in the new GCC Trademark Law are an amalgamation of the national provisions. Article 3 prohibits registration as a trade mark or an element thereof:<sup>258</sup>

- (2) Any mark breaching the public morals or violating the public order.
- (4) Logos of the Red Crescent or Red Cross and such other similar symbols and the marks being an imitation thereof.
- (5) Marks that are identical or similar to symbols having a purely religious character

*Obstacles to successful harmonisation.* Cultural divergence between GCC countries creates inconsistency in outcomes. An international brand operating in several GCC countries may need to adapt the brand not just for the MENA or GCC region as a whole, but potentially for individual countries, as shown by brands such as NKD PIZZA and Dr ORGANIC (Figure 2). Following rejections in the GCC, NAKED/NAKED PIZZA took the

<sup>254</sup> GCC Trademark Law (n 45).

<sup>255</sup> Price (n 129), 88.

<sup>256</sup> Implementing Regulations by Oman's authorities are pending.

<sup>257</sup> The GCC Trade Mark Law automatically comes into force six months after the Implementing Regulations have been published

<sup>258</sup> See (n 45) Article 3 (2)(4)(5).

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opportunity to rebrand globally to NKD. Dr Organic sought to register its logo containing the globally-recognizable pharmacy cross. It was rejected in Saudi Arabia but proceeded without objection in the UAE.<sup>259</sup> The Egyptian application was also rejected. Advertising campaigns may also need to be adapted. In Unilever's local campaign for its AXE deodorant, the company sought alternative ways to convey the sexual attraction message (Figure 3). Unilever's 2016 campaign "Axe Find Your Magic" and its 2017 UK/US campaign "Is It OK for Guys", present interesting issues.<sup>260</sup> The campaign is a shift away from gender stereotypes. Such messages challenging traditional concepts of masculinity that prevail elsewhere, could be met with objection in MENA/GCC.

Figure 2: Examples of adapted marks.

| Brand       | Trademark  |
|-------------|--|
| NAKED PIZZA | Global<br>  |
| DR. ORGANIC | Dubai<br>  |
|             | UAE<br><br>Saudi Arabia<br> |

259 Survey responses.

260 Is it Ok for Guys: <https://www.youtube.com/watch?v=0WySfa7x5q0>; Find Your Magic: <https://www.youtube.com/watch?v=OOfIcikaRQ>

Figure 3: Examples of adapted advertising campaigns.

|                          | Original marketing   | Middle East marketing  |
|--------------------------|--|--|
| UNILEVER's AXE deodorant |   |   |
| GIVENCHY perfume         | <br>Original Western advertisement<br>“Angé or demon” | <br>Saudi adaptation<br>“Angé ou étrange” |

The UAE is a federation of seven Emirates. Decisions on trademark applications in Dubai often follow the standard of the most conservative Emirate, which is Abu Dhabi. Applying this logic at the GCC level, the lowest common denominator is the most conservative (Saudi Arabia). Thus, it remains to be seen whether there will be one (ultra-conservative) standard or a mixture of contradictory results that cannot easily be reconciled. Decorations for Christmas trees in Class 28 have been rejected in Saudi Arabia and accepted in the UAE. Applicants consistently choose to abandon the application and adopt a different mark, rather than go through appeal proceedings.<sup>261</sup>

Article 51 of the Act appears to place the GCC Trade Cooperation Committee (TCC) in a ‘European Court of Justice’ type of role, whereby it interprets the law for the individual national courts. However, there is no

<sup>261</sup> This statement is true of the UAE, based on survey responses. It is not verified for other GCC jurisdictions.

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central court to facilitate consistent interpretation by the national courts and no further details on how questions will be brought to the TCC.

A particularity is that only two of the GCC countries belong to the Madrid system. These countries can still reject an International Registration on morality grounds. However, undertakings using Madrid in Arab countries and also designating Israel, risked being rejected under the secondary level of the Arab League boycott of Israel.<sup>262</sup> Undertakings are advised to designate Arab countries under the Madrid system and file nationally in Israel.<sup>263</sup>

The case-law review conducted for this paper signals a problem of inconsistent results in the GCC. But note that commentators point to the same problem in other jurisdictions.<sup>264</sup>

#### *D. Boycotts and banned goods*

##### 1. Boycott (“prohibition to deal”) clause

The Arab League<sup>265</sup> has implemented and maintained a trade boycott of Israel since 1945.<sup>266</sup> Notwithstanding its non-binding nature, the boycott is

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262 See Part D, “Boycotts and Banned Goods“.

263 No instances of this have been noted other than in Egypt and Syria, and this may not be the current practice given that the GCC is no longer enforcing the secondary level of the Boycott.

264 See Chapter I (C).

265 Twenty two Middle Eastern and African members countries, of which twelve are also WTO members.

266 The boycott began in 1945 and was formalised in 1948 upon Israel’s proclamation of ‘independence’. There are three levels: The primary boycott applies at the citizen level, prohibiting citizens of Arab League members from “buying from, selling to, or entering into a business contract with either the Israeli government or an Israeli citizen”; bans citizens of an Arab League member from buying, selling to, or entering into a business contract with either the Israeli government or an Israeli citizen” The secondary boycott blacklists businesses that have commercial ties with Israel. The tertiary boycott “prohibits an Arab League member and its nationals from doing business with a company that deals with companies that have been blacklisted by the Arab League”. Not all countries enforce the boycott but details on this are vague. See the Congressional Research Service (CRS) report on the Arab League Boycott of Israel (August 2017) available at: <https://fas.org/sgp/crs/mideast/RL33961.pdf>.

reflected in the national trademark regulations of some GCC countries,<sup>267</sup> as a “prohibition-to-deal” clause.<sup>268</sup> <sup>269</sup> This clause is also present in the GCC Trade Mark Law. Article 3(10) prohibits from registration, “marks owned by natural or legal persons with whom it is prohibited to deal as per a resolution passed by the Competent Authority in this regard”. The situation raises a ‘national treatment’ issue.<sup>270</sup> Survey responses did not indicate cases of rejected or cancelled trademarks arising on this ground.

Some Arab League members no longer participate in all levels of the boycott.<sup>271</sup> The UAE, Qatar, and Saudi Arabia are among countries that enforced the secondary boycott which affects companies doing business with Israel. However, accession to the WTO led to a softening of this stance and in 1994, the GCC announced it would only enforce the primary boycott. The previous provision (TML 1992A, article 24) in the UAE law that gave the Israeli Boycott Office the power to order the Ministry to cancel the registration of a trademark is absent from the GCC Trademark Law.

## 2. Banned items: products and services that cannot be trademarked

Even if a trademark has no immoral meaning (i.e. it is not objectionable on its face, by innuendo, in the context of the goods, or in the context of the criminal message promoted), the goods or services to which it is to be affixed or applied may themselves be deemed immoral or harmful. It is possible to identify two sub-categories of such goods/services: items that

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267 Including the UAE (Article 24 TML 1992A, TMR 1993 Article 34) and Saudi Arabia (Article 2(11)).

268 Law No. 9 of 2002 on Trademarks, Trade Names, Geographical Indications and Industrial Designs.

269 Research for this paper found no express clause in the trademark laws of Bahrain, Oman, or Qatar but it may be enacted elsewhere. It is conceivable that, in the absence of a specific clause in the trademark laws, the policy could continue to live under the ‘public order’ provision, given the overwhelming public sentiment among the populations in these countries.

270 “National treatment” is an important rule laid down in Article 2 of the Paris Convention that nationals of each member state enjoy, in the other member states, the same intellectual property protections granted to nationals of those member states. This creates a delicate situation if a country is a contracting party to the Paris convention and trade or diplomatic relations have been severed as part of political solidarity.

271 See Congressional Research Service (CRS) report on the Arab League Boycott of Israel (August 2017), available at: <https://fas.org/sgp/crs/mideast/RL33961.pdf>.

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are illegal under the laws of a country and items that are legal but nevertheless harmful and restricted.

In the GCC, trademarks cannot be registered for products and services that are against religious teachings. These include: alcoholic beverages, pork products, gambling services, escort services, and discos. Some of these goods and services are entirely illegal, such as abortion services, casinos, gambling and escort services. Others like pork, alcohol and discos fall between what is legal and what is illegal. Under Shari'a law and for Muslims, they are not permitted. But due to the large expatriate population the goods and services are available although closely regulated.<sup>272</sup>

*Borderline goods.* Some less-obvious unregistrable products are:

- **Non-Islamic religious charities, services and products**

These items could raise issues if they involve symbols or are considered symbolic, and be rejected for being “identical or similar to symbols having a purely religious character”.<sup>273</sup> If no symbols are involved, the application may be accepted. However, it has a better chance if the filing is worded more generally, such as, “charitable services”, thereby avoiding religious specification.<sup>274</sup> Saudi law is broader than the Qatari and UAE law and would reject on the basis of “violating religion”.<sup>275</sup>

- **Sex toys or similar goods**

These are likely to be rejected under ‘public morals’ and ‘public order’ provisions.<sup>276</sup> <sup>277</sup> Other products like lubricating gels, etc., are likely to be accepted as long as they are not explicitly outlined in the specification. Applicants should use general terms to minimise potential issues.<sup>278</sup>

*Illegal goods.* Upstream moral bars are applied by the GCC by prohibiting registration for illegal products and services. This is a lawful limitation of rights by the state, recognised globally. As Dean J in *New South Wales Dairy Corp* articulated: “Registration of a trade mark does not ordinarily consti-

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272 Survey responses. This is true of the UAE and Qatar, not Saudi Arabia.

273 Article 3(5) of the UAE Trademark Law.

274 Survey responses.

275 Article 2(b): any expression or sign or drawing violating religion, which is identical or similar to a symbol of religious nature.”

276 Article 3(2) of the UAE Trade Mark Law, Article 3(2) of GCC Trade Mark Law, Article 2(c) Saudi Trade Mark Law, Article 8(2) Qatar Trade Mark Law.

277 Survey responses. See also: <http://www.emaratalyoum.com/local-section/other/2011-04-23-1.384040>.

278 Survey responses.

tute a license for what would otherwise be unlawful conduct.”<sup>279</sup> The U.K. Trade Marks Act 1993(2) excludes items that are “prohibited by law.” The U.S. and Canada<sup>280</sup> apply an ‘unlawful use’ doctrine to prohibit trademarks for illegal goods and services. If the item is illegal under federal law, the associated trademark cannot be registered on the Principal Register as it will be considered federally illegal and “scandalous” under section 2(a).<sup>281</sup>

*Harmful goods: appropriation of IP rights and Article 7 Paris Convention.*<sup>282</sup> Downstream public health restrictions are affecting trademark rights in some Western countries. Post-registration brand restrictions are applied to restrict the *use* of registered trademarks on products like tobacco.

#### E. Prospects for registrability in the GCC

The Constitutional language of GCC states indicates a low threshold for harm-based intervention.<sup>283</sup> The governments take on a dominating role as protector of the fabric of society, family structure, ethics and religious values. Qatar’s constitution states: “The family is the basis of society.... founded on religion, ethics and patriotism. The law shall regulate adequate means to protect the family, support its structure, strengthen its ties, and protect maternity, childhood and old age.”<sup>284</sup> The State vows to protect the young from “corruption [and] exploitation.”<sup>285</sup> Saudi Arabia’s Basic Law of Governance recognises the family as the “nucleus” of Saudi society.<sup>286</sup> The State assumes responsibility for “strengthen[ing] family bonds” and “main-

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279 *New South Wales Dairy Corp v Murray Goulburn Co-op Co Ltd* [1991] R.P.C.

280 *McCabe v. Yamamoto & Co. (America) Inc.* (1989), 23 C.P.R. (3d) 498 (F.C.T.D.).

281 Twenty eight U.S. states have legalized cannabis. This means it can be entered into state registers.. To circumvent federal restriction, cannabis companies are trademarking not the cannabis products/supply service but ancillary products and services e.g. t-shirts, hats etc. This is a way of creating an exclusionary right for the cannabis service without having it, if they can build up a brand, others will be discouraged from copying and selling cannabis under the brand.

282 Bilateral investment treaties. Qatar has bilateral investment treaties (BITs) with Finland, Russia, Turkey, and India. No BITs are recorded for Saudi Arabia or the U.A.E according to WIPO’s records.

283 See Chapter II.

284 Article 21 Constitution of Qatar.

285 Article 22 Constitution of Qatar.

286 Article 9 Basic Law of Governance Royal Order No. (A/91), 27 Sha’ban 1412H – 1 March 1992.

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tain[ing] its Arab and Islamic values.”<sup>287</sup> The State “shall protect the Islamic creed, apply its Shari‘ah, enjoin the good and prohibit evil, and carry out the duty of calling to God.”<sup>288</sup> Members should “maintain solidarity and avoid dissension.”<sup>289</sup> The State shall “prevent whatever leads to disunity, sedition and division.”<sup>290</sup>

*Deriving meaning from words and symbols.* Batey<sup>291</sup> discusses dimensions of meaning in texts. Two different kinds of associations give meaning to text: denotation and connotation. These seem to be species of the genus ‘meaning’. Denotation is the literal meaning of a word/language. Connotation is fluid, subjective, symbolic: “[I]t includes the feelings and emotions a word evokes in people and the sociocultural and personal associations that arise from that person’s race, class, gender, religion”. According to Batey, consumers employ both denotation and connotation to draw meaning from words. But *association* in the mind of the consumer precedes meaning. Thus, it is necessary to identify the associations evoked before the meaning can be understood. Applying Batey’s logic to symbols rather than words, a pertinent example for this paper would be the Christian cross. It *denotes* the instrument by which Jesus was crucified. The *connotation* to Muslims is an allegory of persecution, the Crusades of the medieval period. Thus, Batey’s thesis seems relevant for understanding trademark registration decisions.

In the context of cultural norms in Gulf societies, and the ways through which meaning is derived from texts, it is possible to speculate whether or not a given trademark would be accepted onto the register. The following is a sample of EU/ US-registered trademarks or unregistered brands. It presents the evaluations that might be expected in the GCC. It aims to provide additional insight and clarity on the thinking in the GCC. The observations are based on the opinions of local law firms.<sup>292</sup> <sup>293</sup>

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287 Article 10 Basic Law of Governance Royal Order No. (A/91), 27 Sha’ban 1412H – 1 March 1992

288 Article 23.

289 Article 11 Basic Law of Governance Royal Order No. (A/91), 27 Sha’ban 1412H – 1 March 1992.

290 Article 12 Basic Law of Governance Royal Order No. (A/91), 27 Sha’ban 1412H – 1 March 1992.

291 Mark Batey, *Brand Meaning* (Routledge 2008) Ch 4.

292 Survey responses.

293 There is consensus in most cases among UAE, Qatar and Saudi attorneys. Where there is variation an overall determination is offered to reconcile the contrasting views.

| Mark  | Religious connotation/blasphemy  |
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|  | <p>Athé is the French word for “atheist”. Unless the examiner is unaware of the meaning, it is highly likely to be rejected for “violating religion” in Saudi Arabia, and on policy grounds in the UAE and Qatar.</p>  |
|  | <p>Breath of God.<br/>As above.</p>  |
|  | <p>This trademark “OMG” is analogous to “TGI [Friday’s]”. It may meet with objection if the acronym is spelled out in the application “oh my God”, but not if it is applied as the acronym. The odds are fairly even.</p>  |
| iCREATE   | <p>This mark is more likely than not to be accepted if the goods and services are such that it does not conjure the concept of God’s creation. It is not inconceivable that a conservative examiner would conjure this meaning. In that case, the removal of “i” could help.</p>   |
| Sexual connotation  |  |
| KISS by<br>Rihanna  | <p>Opinion was divided on whether this mark would proceed to registration in the GCC. ‘Kiss’ is problematic in that it can be ascribed an innocent meaning (kiss in the form of a greeting), or a more ‘haram’ meaning (pre- or extra-marital kiss), or the most explicit meaning which is the Arabic meaning of female genitalia. Generally, it is likely to escape the translated connotation in most cases but there is no guarantee. “Kisses” was rejected in Saudi Arabia for Class 30 goods in 2017 in the first instance and on appeal. Nevertheless, many “kiss” formative marks have been successfully registered in the UAE (AQUA KISS cl 3 for Victoria’s Secret Stores Brand Management, Inc. KISS-KISS cl 14 for FMTM Distribution Ltd. POCKETKISS cl 3 for Bath &amp; Body Works Brand Management, Inc.), Qatar, and Saudi Arabia (BIG KISS, KISS, KISS RESIST...) in different Classes.</p> |
| BETTER THAN<br>SEX MASCARA  | <p>This trademark is highly likely to be rejected under the public morals and public order prohibition. The applicant would likely need to remove the offending term “sex”, or render it suggestive “Better than...? Mascara”.</p>   |

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| <br> | <p>Opinion was divided on whether these two trademarks "Miss Bikini" and "Bikini Island" would proceed to registration in the GCC. Two respondents opined that both the word 'bikini' and the 'bikini devices' (bikini briefs; woman in a bikini) would raise objection. One respondent distinguished "Bikini Island" as more susceptible to rejection. In relation to "Miss Bikini", registrability may depend on whether the examiner would be swayed by the applicant's description in the specification of a "heart-shaped logo which is split into three parts" rather than "bikini briefs".</p>  |
| <p>TANTRIC CONDOMS</p> <p>SMART GIRL CONDOMS</p> <p>OMG CONDOMS</p>  | <p>Opinion was divided on whether these three trademarks for condoms would proceed to registration in the GCC. As discussed in Part D.2. of this Chapter, condoms would not normally face objection. Indeed, Durex is a registered trademark in the UAE, Qatar and Saudi. But these three trademarks carry additional connotations. Some respondents expected the marks to be rejected on morality and public order grounds. The connotation of "tantric" sex was highlighted by one respondent. Another respondent recommended removing the word "condom" entirely as a way of minimising objection and also broadening protection. Certainly, tantric alone may still be rejected.</p> |
| <b>Sedition?...</b>  |  |
| <p>ANARCHY (deodorant spray)</p> <p>ANARCHY REIGNS (PlayStation game)</p>  | <p>Opinion was divided on whether these two trademarks would proceed to registration in the GCC. Some responses indicated they may fall foul of the public order provision though not necessarily. Other responses fell on either side; on the one side, it was suggested that the mark would be rejected, especially following the 'Arab Spring'. The fact that "Anarchy Reigns" was related to a PlayStation game would not matter. On the other side, it was asserted that these would proceed to registration.</p>   |
| <b>Taboo</b>   |  |
| <p>TOMBOYX</p>   | <p>This trademark divided opinion. Some respondents considered that such a mark would be rejected on morality and public order grounds. The idea of non-traditional gender roles could be problematic. Indeed, any hint of cross-dressing or homosexuality is taboo and sits uncomfortably with Islamic teachings. However, it is possible that the examiner would not pick up on the meaning if the applicant stated in the application that it is a made-up word (by virtue of the 'X').</p>   |
| <p>GIRLFRIEND</p>  | <p>This is a borderline case in the sense that it would likely be rejected as the concept of a girlfriend or boyfriend is not recognised in Islam, however, it could succeed on appeal.</p>  |

### *Conclusion*

This chapter examined the legal system and cultural norms of the GGC Region. It found that the constitutional language provides a window into the treatment of inappropriate trademarks at the practitioner level. Because Islamic law is enshrined in the constitutions of GCC states, the desire to shield citizens from influences that are not conducive to the public good is a predominant factor. The chapter revealed high expatriate populations in these countries, which has implications for the “relevant public” as a legal standard for assessing registrability and infringement in the Region. Finally, a small selection of ostensibly innocuous signs was presented to local practitioners to test the prognosis for successful registration in the GCC. Responses showed a level of uncertainty with regard to how examiners would perceive the signs. Despite this uncertainty, responses affirmed the fact that fading taboos in the West remain intact in Gulf societies. Even mildly risqué marks may be refused. An important insight for brand owners is that some concepts are simply not recognised in Islamic cultures. Signs or advertising suggestive of androgyny or cross-dressing, for instance, are unlikely to proceed to registration in the GCC. Similarly, signs suggestive of sex or pre-marital relationships (boyfriend, girlfriend) are also at risk of refusal. Notwithstanding this fact, applicants can improve prospects by drafting the description in the specification in general terms. In the event of insurmountable objections, companies can seize new opportunities such as global rebranding, as in the case of NAKED/NKD.