

List of Works Cited

All sources are cited in accordance with the Oxford University Standard for the Citation of Legal Authorities (OSCOLA).

Monographies and Articles

- Abdel-khalik J, 'Disparaging Trademarks: Who Matters' (2015) 20(2) Michigan Journal of Race and Law 288
- Alemanno A and Bonadio E, 'Do you Mind my Smoking? Plain Packaging of Cigarettes under the TRIPS Agreement' (2011) J.Marshall Rev. Intell. Prop. L. 450, 462
- Baird S, 'Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks' (1993) 83(5) Trademark Reporter 661
- Bonadio E, 'Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks' (2015) 19 Marquette Intellectual Property Law Review 43
- — 'Bans and Restrictions on the Use of Trade Marks and Consumers' Health' (2014) 4 Intellectual Property Quarterly 326
- Bone RG;Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law' (2006) 86 Boston University Law Review 547
- Brown Jr. RS, 'Advertising and the Public Interest: Legal Protection of Trade Symbols' (1948) 57 Yale Law Journal 1165
- Carpenter M and Murphy K, 'Calling Bullshit on the Lanham Act: The 2 (a) Bar for Immoral, Scandalous, and Disparaging Marks'(2010) 49 U. Louisville L. Rev. 465
- Cohen FS, 'Dialogue on Private Property' (1954), IX Rutgers Law Review 357
- Dar HA and Presley JR, 'The Gulf Co-Operation Council: A Slow Path to Integration?' (2001) 24(9) The World Economy 1161
- Duff R and Marshall S, 'Abstract Endangerment; Two Harm Principles, and Two Routes to Criminalisation' (2015) 3(2) Bergen Journal of Criminal Law and Criminal Justice
- Ehteshami A, 'GCC Foreign policy: From the Iran-Iraq War to the Arab Awakening' in LSE Middle East Centre Collected Papers 1 (April 2015)
- Fershtman C, Gneezy U, and Hoffman M, 'Taboos and Identity: Considering the Unthinkable' (2011) 3 American Economic Journal: Microeconomics 139
- Fletcher A and Kera D, 'The forty-Fourth Year of Administration of the Trademark Act of 1946' (1991) 81 TMR 601
- Gerhardt DM, 'Trademarks as Entrepreneurial Change Agents for Legal Reform' (2017) 95(5) North Carolina Law Review, 1519

- Gibbons LJ, 'Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law after *Lawrence v. Texas*' (2005) 9(2) *Marquette Intellectual Property Law Review*
- Gilson Lalonde A & Gilson J, 'Trademarks laid bare: Marks that may be scandalous or immoral' (2011) *Trademark Reporter* 1476
- Goble GW, 'Where and What a Trade-Mark Protects' (1927) 22 *U. ILL. L. REV.* 379, 388
- Habachy S, 'Protection of Trademarks and Patent Rights in the Middle East History, Geography and Economics' (1962) 6 *Patent, Trademark and Copyright Journal of Research and Education*
- Khoury AH, 'Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trademarks' (2003) 43(2) *IDEA – The Journal of Law and Technology* 151
- Marks T and Betancourt JC, 'Rethinking public policy and alternative dispute resolution: negotiability, mediability and arbitrability' (2012) 78(1) *Arbitration* 19
- McKenna MP, 'Testing Modern Trademark Law's Theory of Harm' (2009) 95 *Iowa Law Review* 63
- Oswald L, 'Challenging the Registration of Scandalous and Disparaging Marks under the Lanham Act: Who has Standing to Sue?' (2004) 41 *American Bus. L. J.* 251
- Palmer B, 'Saudi Arabia's Trademark Law' (1986) 1(3) *Arab Law Quarterly* 323
- Pollack M, 'Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain-with an example from the Trademark Counterfeiting Act of 1984' (1993) 14 *Cardozo L. Rev.* 1391
- Ramsey LP, 'A Free Speech Right To Trademark Protection?' (2016) 106(1) *Trademark Reporter* 797
- Scassa T, 'Antisocial Trademarks' (2013) 103(5) *Trademark Reporter* 1172
- Schechter F, 'The Rational Basis of Trademark Protection' (1927) 40 *Harvard Law Review* 813
- Shaoping G and Lin Z, 'Human Dignity as a Right' (2009) 4(3) *Frontiers of Philosophy in China* 370
- Snow N, 'Free Speech & Disparaging Trademarks' (2016) 57 *Boston College Law Review* 1675
- Spence M, 'The Mark as Expression/The Mark as Property' (2005) 58 *Current Legal Problems* 491
- Stolte KM, 'How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum' (1997) 8 *Fordham Intellectual Property, Media and Entertainment Law Journal* 505
- Swann, Sr. JB, 'The Trademark Reporter as Catalyst' (2011) 101(1) *Trade Mark Reporter* 81
- Wasserman DI, 'Trading Sex, Marking Bodies: Pornographic Trademarks and the Lanham Act' (2010) 23 *National Black Law Journal*

Books

- Allan TRS, *Constitutional Justice: A Liberal Theory of the Rule of Law* (OUP 2001)
- — The Sovereignty of Law, Freedom, Constitution and Common Law (OUP 2013)
- Ballantyne WM, *Essays and Addresses on Arab Laws* (Curzon Press 2000)
- Batey M, *Brand Meaning* (Routledge 2008)
- Bently L, 'The Making of Modern Trade Marks Law: The Construction of the Legal Concept of Trade Mark (1860-80)' in Bently L, Davis J, and Ginsburg C (eds), *Trade Marks and Brands.. An Interdisciplinary Critique* (CUP 2010)
- — 'From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property' in Dinwoodie GB and Janis MD (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Cheltenham: Edward Elgar Publishing 2008)
- — and Davis J, and Ginsburg JC (eds), *Trade Marks and Brands. An Interdisciplinary Critique* (CUP 2010)
- Bodenhausen GHC, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (as revised at Stockholm in 1967)
- Davison MD, Horak I, and The Hon. Justice Gummow WMC, *Shanahan's Australian Law of Trade Marks and Passing Off* (5th edn, Thomson Reuters 2012)
- de Carvalho NP, *The TRIPS Regime of Trademarks and Designs* (2nd edn, Kluwer Law International 2011)
- Galligan DJ, *Discretionary powers: A Legal Study of Official Discretion* (Clarendon Press 1986)
- Gibbons LJ, 'Trademarking the Immoral and the Scandalous: Section 2(a) of the Lanham Act' in Peter K. Yu (ed), *Intellectual Property and Information Wealth: Issues and Practices in the Digital Age* (Volume 3, Ch 4, Praeger Publishers 2007)
- Hansen PW, *Intellectual Property Law and Practice of the United Arab Emirates* (OUP 2009)
- Landolt PL, *Modernised EC Competition Law in International Arbitration* (Kluwer Law International 2008)
- Lloyd D, *Public Policy: A Comparative Study in English and French Law* (London: Athlone Press, 1953)
- Mill JS, *On Liberty* (J. W. Parker and Son 1859)
- Phillips J, *Trade Mark Law; A Practical Anatomy* (OUP 2003)
- Price D, *The Development of Intellectual Property Regimes in the Arabian Gulf States. Infidels at the Gates* (Routledge 2012)
- Ramadan T, *Radical Reform: Islamic Ethics and Liberation* (OUP 2009)
- Schechter FI, 'The Genesis of the Modern Law Relating to Trade-Marks' in Dinwoodie GB and Janis MD (eds), *Trade mark and Unfair Competition Law: Themes and Theories (Critical Concepts in Intellectual Property Series)* (Volume I, Edward Elgar Publishing 2014, and as reviewed by Hyland G, Columbia Legal Studies (2011))

List of Works Cited

Turner JH, *Revolt from the Middle. Emotional Stratification and Change in Post-Industrial Societies* (Routledge 2017)

Other Secondary Sources

CIA, World Factbook, www.cia.gov/library/publications/the-world-factbook/geos/sa.html

Edward Smith (2009), Absolute Grounds paper submitted by United Kingdom for SCT Assistant Principal Hearing, available at: www.wipo.int/export/sites/www/sct/en/comments/pdf/sct21/ref_uk.pdf

EUIPO, 'Guidelines for examination Trade mark, Part B Examination – Absolute Grounds of Refusal' (24 May 2016).

Gulf Labour Markets and Migration, available at: <http://gulfmigration.eu/glmm-database/demographic-and-economic-module/?search=1&cmct=Saudi+Arabia>

Johnson, 'Swearing: The Last Taboos' (Blog: Prospero, 21 January 2015), available at: <https://www.economist.com/blogs/prospero/2015/01/johnson-swearing>.

WTR Yearbook 2017 - Trade mark procedures and strategies: France (World Trade mark Review, available at: www.worldtrademarkreview.com/Intelligence/Yearbook/2017/Country-chapters/France)

WTR Yearbook 2017 - Trade mark procedures and strategies: Germany (World Trade mark Review, available at: www.worldtrademarkreview.com/Intelligence/Yearbook/2017/Country-chapters/Germany).

WTR Yearbook 2017 - Trade mark procedures and strategies: Italy (World Trade mark Review, available at: www.worldtrademarkreview.com/Intelligence/Yearbook/2017/Country-chapters/Italy)

International Treaties

Paris Convention for the Protection of Industrial Property of March 20, 1883; 21 UST 1583, 828 UNTS 305

Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967, and as amended on September 28, 1979

Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on June 27, 1989, as amended on October 3, 2006 and on November 12, 2007

European Convention for the Protection of Human Rights and Fundamental Freedoms, as amended by Protocols Nos. 11 and 14, 4 November 1950, ETS 5

TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [TRIPS Agreement]

WTO Agreement: Marrakesh Agreement Establishing the World Trade Organization, Apr. 15, 1994, 1867 U.N.T.S. 154, 33 I.L.M. 1144 (1994) [hereinafter Marrakesh Agreement or WTO Agreement]

European Patent Convention (1973)

European Union Legislation

Charter of Fundamental Rights of the European Union (CFR)

Convention for the Protection of Human Rights and Fundamental Freedoms (European Convention on Human Rights, as amended) (ECHR)

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark [2015] OJ L 341

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December to approximate the laws of the Member States relating to trade marks [2015] OJ L 336

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L 299

UK Legislation

Trade Marks Act 1994

US Legislation

Trademark Act 1946 (the ‘Lanham Act’)

GCC Legislation

Bahrain: Law No. (11) For the year 2006 on Trademarks

Kuwait: Decree-Law No. 68 of 1980 (Trademarks), as amended by Decree-Law No. 10 of 1987 and Law No. 1 of 2001

Oman: Industrial Property Rights Law (promulgated by the Royal Decree No. 67/2008)

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

Saudi Arabia: Law of Trademarks (promulgated by Royal Decree No. M/21 of 28 Jumada I 1423 (August 7, 2002))

Trademarks Law of the Gulf Cooperation Council States (2006)

United Arab Emirates: Federal Law No. 37 of 1992 on Trademarks (as amended by Law No. 19 of 2000 and Law No. 8 of 2002)

List of Works Cited

Other national legislation

- Brazil: the Law on Industrial Property (9,279/1996)
Chile: Industrial Property Law (19.039)
Egypt: Law No. 82 of 2002 Pertaining to the Protection of Intellectual Property Rights
France: Law 1991-7 of January 4, 1991 on Trademarks and Service Marks
Iran: Patents, Industrial Designs and Trademarks Registration Act of the Islamic Republic of Iran (2008)
Iraq: Law No. 21 of 1957 on Trademarks and Trade Names
Jordan: Law No. 33 of 1952 on Trademarks amended by Law No. 34 of 1999 Amending the Trademarks Law
Lebanon: Laws and Systems of the Commercial and Industrial Property in Lebanon Resolution No. 2385, issued on January 17th, 1924, amended by the Law of 31 January 1946
Libya: Article 5(b), Trademarks Law
Malaysia: the Trademarks Act 1976
Morocco: Law No. 17-97 on the Protection of Industrial Property (as modified and supplemented by law 31.05)
Poland: Act of June 30, 2000, on Industrial Property (consolidated version of November 29, 2013)
The Republic of Sudan: The Trademarks Act (1969 Act No.8)
Turkey: Decree-Law No.556 Pertaining to the Protection of Trademarks in force as June 27, 1995

Cases

EU

- C-487/07 L'Oreal SA v. Bellure NV [2009] ECR I-05185
R 0495/2005-G – SCREW YOU; R 495/2005-G – SCREW YOU
R 111/2002-4, Dick Lexic Limited's Application (Dick and Fanny)
R711/199-3, Myles Ltd's Application, 5 December 2001 (OHIM)
T-232/10 Couture Tech Ltd v OHIM
Je Suis Charlie Trademark Application 1668521

UK

- Fook Trade Mark Application O-182-05
Ghazilian's TM Application [2002] R.P.C. 628
Philips Electronics NV v Remington Consumer Products Ltd [1998] ETMR 124
French Connection Ltd., No. 2184549 v. Woodman, No. 81862, Dec. O-137-06 (May 17, 2006) (U.K.)

Masterman's Design [1991] RPC 89

Basic Trademark SA's Trade Mark Application O-021-05 [2005] RPC 25 (Jesus Trade Mark decision)

Arsenal Football Club plc v. Mathew Reed [2001] ETMR 860

US

In re Old Glory Condom Corp., 26 U.S.P.Q. 2d (BNA) 1216, 1220 (T.T.A.B. 1993)

In re McGinley, 660 F.2d 481, 486 (C.C.P.C.1981)

Matal v. Tam, 582 U.S. ____ (2017)

In Re Tam, 808 F.3d 1321 (Fed. Cir. 2015)

Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005)

In re Lebanese Arak Corp., 94 USPQ2d 1215 (TTAB 2010))

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co 316 U.S. 203, 205 (1942)

