

Qatar Trademarks Dispute

Ahmed El Amoury - Senior Associate - Litigation / Employment and Incentives / Legislative Drafting / Insurance

a.amoury@tamimi.com - Doha

Background to the Case

The Claimant (a Swiss watchmaker) was the owner of a trademark which had been registered in the office of origin, Switzerland, with the World Intellectual Property Organisation (WIPO) and internationally registered as well. The Claimant lodged an application to register their trademark in Qatar, which consisted of a semi-figurative trademark featuring the company name and a symbol, with the Ministry of Business and Trade's Industrial Property Rights Office. The application was accepted and as part of the examination period was published for opposition purposes in the monthly Official Gazette.

An objection to the registered trademark was filed with the Trademark's Registrar by the Defendant on the grounds that the Claimant's trademark shared an identical symbol to theirs, namely. The Registrar issued a decision upholding the objection made by the Defendant and the registration process was halted.

Ruling of the Court of First Instance

The Claimant contested the decision of the Registrar before the Court of First Instance based on the provisions of Article 6(5) of the Paris Convention (of which Qatar is a signatory state) and Article 8 of Qatar's Trademark Law No 9 2002.

The Claimant stated that the trademark is differed from that of the Defendant's for the following reasons:

- Pursuant to Article 8 (1) of the Trademark Law No 9 of 2002 certain symbols, including the contested one, are generic symbols which cannot be registered as a trademark;
- The two trademarks were different both in size and shape; and,
- The two trademarks differ in the overall appearance and are distinct from one another.

The Court of First Instance rejected the claim on the following grounds:

- The trademarks were similar in appearance;
- The symbol in question was identical to that of the Claimant; and,
- The main distinguishing feature of the trademark being the symbol, would cause confusion to the consumer as to the source of the trademark.

In reaching its decision to uphold that of the Registrar, the Court also took into account the fact that the Defendant had registered their trademark in Qatar before the Claimant did.

Judgment of the Court of Appeal

The Claimant appealed against the Judgement before the Court of Appeal based on the aforementioned reasons and argued that the Court of Cassation had issued a principle which had stated that in assessing the degree of similarity between two trademarks, the trademark should be examined in its entirety and not solely on a particular feature or aspect.

The Court of Appeal overruled the findings of the Court of First Instance and ruled in favour of the Claimant. In deciding the case, the Court of Appeal applied the balancing test, where it viewed the overall aspects of the trademark and concluded that the trademarks were dissimilar and can be distinguished by the consumer; and that the symbol in question was generic and the Defendant could not be afforded

exclusivity of its use. The Court of Appeal ruled that the Claimant be allowed to proceed with the registration of the trademark in Qatar.