

The Competent Court/Division regarding Qatar Trademark Disputes

Roy Georgiades - Partner - Litigation
- Doha

Background to the Case

The Claimant/our client, a Swiss watchmaker, is the owner of a trademark which had been registered in the office of origin, Switzerland, with the World Intellectual Property Organisation (WIPO) and also registered internationally. 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. 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 (civil division)

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 their trademark differed from that of the Defendant's based on 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 (civil division)

The Claimant/our client appealed against the Judgement before the Court of Appeal based on the aforementioned reasons and argued that the Court of Cassation had previously 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. They also viewed 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 their trademark in Qatar.

Judgment of the civil Court of Cassation

The Defendant did not appeal. However, The Ministry of Business and Trade only appealed against the Judgement before the Court of Cassation based on the following arguments:

- Based on Article 3/3 of the Law no. 7 of 2007 (Settlement of Administrative Disputes) the Administrative Court is alone entitled to look into the administrative disputes relevant to the requests presented by any entities aiming at the cancellation of the final administrative decisions. The controversial decision issued by the Ministry of Business and Trade's Industrial Property Rights Office, thus the Administrative Division should be competent not the Civil Division, especially that Article 3/3 of the Law 7 of 2007 superseded Article 15/5 of Trade Mark Law no. 9 of 2002 which provides that The decision of the TM Office regarding the opposition shall be subject to appeal to the Civil Court...).
- 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 Cassation rejected the Ministry's appeal on the following grounds:

- The decision of the Ministry of Business and Trade's Industrial Property Rights Office is not an administrative decision, because the aforementioned decision was taken regarding a trademark dispute between two private parties, and this dispute related to a private law (i.e. Trademark Law)
- The trademarks were dissimilar and can be distinguished by the consumer; and that the symbol in question was generic.

In the light of the foregoing, the Court of Cassation upheld the judgment of the Court of Appeal and rejected the Ministry's appeal.

Practice Note:

Based on the above, it is crucial for any party wanting to dispute a decision made by the Ministry of Business & Trade to prove his rights on a Trademark, to be aware that the Civil Division is the competent division regarding the Trademark dispute, not the Administrative Division of the Civil Court regarding any controversial decision issued by the Ministry of Business and Trade's Industrial Property Rights Office. Therefore, this Judgment openly reserved the jurisdiction solely to the Civil Division Court.