

Instructions for verifying the validity of Trademarks

Ala'a Mohammad Al Bataineh - Head of Intellectual Property - Jordan - Intellectual Property
a.albataineh@tamimi.com - Amman

October 2013

Under the new instructions, No 6 of 2012 ('the Instructions'), the Organisation has established the 'Unit for Fighting Counterfeiting, Investigation and Reporting' ('the Unit'). This is a specialised unit whose purpose is to follow up complaints received from the Internal Control Directorate, which is a directorate inside the Organisation that deals with complaints received from the owners of affected trademarks.

Article 3 of the Instructions details the mechanism by which the Unit is to verify the product holding the trademark. The Unit is to receive the product from the Internal Control Directorate or affected trademark owner, with the following attached:

a) If the product entered Jordan through its borders:

1. The serial number of the Customs declaration.
2. The date of the Customs declaration.
3. Import invoice.

b) If the product was already in the market:

1. The name and address of the shop or the importer who has counterfeited the products.
2. The quantity of the counterfeited products.

The Unit will then photograph the product using high quality cameras and specialised scanners, and send the images to the company who owns the trademark. The trademark owner can then investigate whether the product is original or counterfeit.

If the trademark owner is not satisfied with the photographs the Unit will send a sample of the product, though the trademark owner will have to cover the delivery costs of this.

Once the trademark owner verifies the products they must inform the Unit in writing as to whether the product is indeed counterfeit or original.

If it is confirmed that the product is counterfeit, then under article 30(c) of the Law of the Organisation No. 22 for 2000, the Unit can do the following:

1. If the counterfeit product has entered Jordan through its borders, the Unit in collaboration with the Jordan Customs Department and the importer shall re-export the product.
2. If the forged product was created in Jordan, then it shall be destroyed.

Furthermore, article 4 of the Instructions provide a mechanism to protect trademarks. The trademark owner and the Organisation are to reach an agreement detailing the following:

- A mechanism for verifying trademarks
- A method for corresponding with any parent company should a counterfeit product be found.

- Providing support to the owner of the trademark through training employees or providing equipment such as specialised scanning machines that can ease the procedures for verifying the trademark.
- The annual fee to be paid by the trademark owner to protect the trademark. This is to be no less than JOD 20,000 for each trademark. The amount shall be determined based on the size of the company's work, the amount of its sales, the trademark's fame and its extensiveness, and the ability of the company to protect its trademarks. This fee is to be paid to the Organisation.

Whilst the Unit is new and remains largely untested, it is hoped that it will continue the strengthening of Jordan's commitment and ability to protect trademarks.