

Civil Protection of the Trademark: A Comparative Study

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The right to a trademark is a relative and not an absolute right, as the owner of the trademark invokes his right against others only within the limits of products, goods, or services similar to his products, goods, and services. The reason for acquiring ownership in the trademark is not without one of two facts: use and registration. In the first instance, it is based on a material fact represented by the actual use of it, and the second, registration that plays two roles. The registration of a trademark is a preventive means to protect the trademark, as it is a means of informing others of the existence of the trademark and prevents them from using it, as well as being a means of combating counterfeiting. At the same time it is considered a presumptive evidence to prove the opposite by establishing evidence of precedence in all ways. To claim compensation for infringement of an unregistered trademark, an unfair competition claim must be filed, and this requires first that the aggressor be a trademark within the meaning of the law.

Key words: *Civil, trade, trademark.*

Introduction

The trademark occupies an important and distinctive place among the intellectual property rights, and highlights the importance of the role played by a brand as it creates an identity for the goods and services that distinguish it. This enables consumers to choose between goods and services to meet their needs, or to pay owners of trademarks, from merchants, factories and service providers, to improve the quality of their goods and their services, which leads to an increase in commercial activity, (*Salah, 1983*). The registered or unregistered trademark enjoys legal protection as a public asset and, if it is registered, it enjoys both criminal and civil protection, but if it is not registered, it only enjoys civil protection. The attention to the legal and civil protection of trademarks is due to the great importance of the trademarks in differentiating products and the preservation of tradition (*Rajaei, 2000*).

Postulation

The research is based on the hypothesis that the registered or unregistered trademark enjoys protection in the event of an infringement; its protection is inevitable on the legislator because in the absence of that protection, trade and industry will become a target of demolition and spoilers by unleashing unfair competition methods.

Research Problem

To what extent can the trademark be protected, whether registered or not?

Aim of the Study

The study aims to know the conditions and procedures that must be met in order to gain the right to the trademark by defining the scope of this protection, and its effects through the statement of mechanisms to embody civil protection for the mark, and to know the adequacy of the general provisions of the contract, as well as the provisions of tort liability in establishing effective civil protection for the trademark.

Methodology

The researcher followed the descriptive analytical approach, and this is what was imposed by the nature of the subject under study, by examining the nature of civil protection for the trademark, as well as the analytical approach through analysing the legislative texts that fall within the framework of civil trademark protection.

Literature Review

The Concept of Civil Protection of the Trademark

- ***Advantages of the Trademark Right of Protection***

This right in the trademark is seen as a right of a special nature in that it does not fall under the framework of known traditional rights, although sometimes personal rights are said to have their own characteristics, and the reason for launching this feature can be dismissed as being a relative right that is limited to whoever engages in some kind of trade or services (*Abbas, 1967*). On the other hand, it is seen as a temporary right restricted within a legally defined time range, where we find that the legislations agree to limit the right to protect the registered mark within a period of ten years from the date of its registration or the date of submitting its registration application. Also, the advantages of the right to protection of the trademark is a

decision not only for the owner of the mark, but extends to include everyone who has an interest in obtaining this protection, such as the consumer, competitor, and others. This is true as long as the primary purpose is to protect the public from fraud and misleading information, and this is what was stated in Article 4,5,21,24 From the Law on Trademarks and Commercial Structures and Article (6) of the Paris Convention for the Protection of the Right to Industrial Property. Here we find that the right to protect the trademark is a right of a special nature that differs from others (**Bassam, 2009**). Such a right finds a basis in a case of unfair competition that is compatible with the rules of civil liability The right to protection therein is a special type of responsibility regarding personal action, from which we conclude that the right of protection in the ordinary personal aspect of the owner of the mark, cannot be acquired or disposed of while the other side of it is subject to financial presentation. Therefore, the right of protection cannot be considered a mixed moral right that combines financial and personal nature at the same time (**Salah, 2006**).

- ***The Scope of Civil Protection of the Trademark***

According to the general rules in civil liability, the right to civil protection is established for all rights on the basis that every harm to a third party obliges the actor to compensate or repair it if the manufacturer, merchant or service provider commits an act that is prohibited by law, or conflicts with commercial norms. It is necessary to repair and reduce the damage within the framework of the rules (**Mohamed, 2009**). The general responsibility within the laws regarding unfair competition is the best way to protect the moral rights of the commercial place, including the rights of the trademark owner. As for the scope of Iraqi legislation in particular, protection for the trademark and other industrial property rights is based on the general rules of default liability, which stipulates in Article (204) of the Iraqi Civil Law to compensate for any infliction of damage to others, so the scope of protection is limited to one image, which is compensation. However, the Iraqi legislator expanded the scope of protection according to the 1957 Law on Trademarks and Commercial Buildings No. (21), as it added various aspects of protection in granting the use, registration, or cancellation of identical or similar marks, as well as other forms such as circumvention, sale, confiscation, and seizure. The exception is that this Protection is accompanied by the condition of registration for the trademark, which requires a return to the general rules in the civil law referred to when the mark is not registered because the provisions of the 1984 Trade Law No. (30) have no organised provisions on unfair competition (**Adel, 2008**).

- ***National Organization for Civil Protection***

The trademark derives its national protection from the international provisions that preceded it in this field, and the images of this protection are embodied when confronting acts of unfair competition under national legal provisions that are predominantly administrative and subject

to judicial control and authority. The mark or the request are equally to be written off when the registration occurs in order to prevent the use of that mark in the field of commercial competition, and this protection is valid for either the national brand or the well-known mark (*Amer, 1988*). There are several laws that come under the title of the National Organisation for the Civil Protection of a Trademark, which is set up to prevent the registration of identical or similar marks. The most important advantage enjoyed by the trademark is its inclusion in the legal protection of the local mark if it is not registered in the country concerned, contrary to the general rules in the legal protection established for other marks. This in turn, gives broad frameworks of civil protection that exceed the protection afforded to registered national marks. Although national legislation varies within the scope of this protection, it does prohibit the registration of any mark that matches or resembles the aforementioned mark, when it is used to differentiate (*Muhammad, 2002*) goods that are similar or similar to the goods for which it is famous. This would create confusion among the public concerned with consumers. The effect of this legal provision is primarily to prohibit the registration of the mark corresponding to the well-known or nationally registered trademark, and conformity may signify linguistically or legally the exact conformity of the two marks (*Hussam, 2003*).

As for the prevention of the use of the identical or similar trademark, the legislator has expanded the protection to protect the mark from the use that indicates the relationship of this mark and its connection to the products or services that it carries. Thus it is the right of the owner of the famous trademark, registered or unregistered, to ask the judiciary to rule to prevent others from using his trademark on similar or non-similar products, provided that the use of this mark indicates a link between those non-similar products and the mark and the existence of a possibility that harms the interests of the owner of this mark as a result of this use. This is stipulated in the Jordanian law (*Muhammad, 2011*). As for the law of The Effective Iraqi Trademarks, it did not explicitly mention granting the owner of the trademark the right to prevent the use of a trademark identical or similar to his mark, as is the case with the clear reference to the prohibition of its registration in paragraph (8) of Article (5) of this law. There is also the cancellation or termination of the registered trademark, and we find that the Iraqi legislator has given the right to request the cancellation of the trademark or termination of the trademark for every interested person within five years from the date of registration, provided that the facts of the request for fulfillment are specified and the matter is not restricted to the user of the trademark, as stated in the Egyptian legislation. Thus the Trademark owner can exercise the right to request cancellation of the mark according to the scope of the text mentioned within the five years from the date of registration. When the mark to be cancelled is similar or identical to his trademark, he has the right to request cancellation at any time without being restricted to the period that he submitted to the competent authority that supports that registration of the mark. A period may have been fraudulent or in violation of the law, or the mark may have been used by its registrar, or with a licence from it, with the intent to mislead in the work or services (*Younis, 2008*).

International Organisation for Civil Protection

- ***Civil protection in accordance with the Paris Agreement***

The Paris Agreement of 1883 is considered the international umbrella for the protection of intellectual property rights in general, and industrial property in particular, as it established the unified legal foundations for dealing between the nationals of the signatory countries and laid down principles and standards that must be observed and respected when registering trademarks, requesting their cancellation or preventing their abuse. It was stipulated by the agreement of conditions and criteria, the most important of which regulates the conditions for depositing and registering marks, whereby local law in each Contracting State specifies these conditions (*Jabali, 1998*). As a result, any request filed by a citizen of a Contracting State to register a mark may not be refused. Its registration is not nullified if that mark has not been deposited, registered or renewed in the country of origin, and a mark registered in one of the Contracting States can be registered in any other country including the country of origin and therefore, the nullification or cancellation of the mark in one of the Contracting States does not affect the authority to register it in other contracting states. If a mark is registered correctly in the country of origin, the application for its deposit and protection in its original form must be accepted in other contracting states, provided that registration may be refused in specific cases, especially if the mark touches the rights of others not acquired or lacks (*Faudel, 1994*). A distinctive feature is one that is contrary to the principles, ethics or public order, or misleads the public. If the use of a registered mark is compulsory in any Contracting State, it is not permissible to cancel the registration for not using the mark except after a reasonable period of time has passed and provided that the owner of the mark cannot justify not using it.

Each Contracting State must refuse to register a mark and prevent its use if it creates ambiguity, if it is a reproduction, imitation or translation of another mark, used with identical and similar goods that the competent authorities of that country are known to have, and which concerns a person entitled to benefit from the benefits of the agreement. Each Contracting State must refuse to register the marks that consist of the country's emblems, or a contracting party and its official symbols and references, or include it without a permit to do so. This is to prevent its use (*Hammadi, 2012*), unless the International Bureau of WIPO has been notified of them. The same provisions apply to the slogans of some international governmental organisations, their banners, and other signs, abbreviations and designations thereof. It appears that the Paris Agreement approved several objective principles for providing protection for trademarks, including the principle of national treatment, the principle of precedence, acceptance of registration of marks registered in their country of origin and the principle of independence of marks, in addition to the special protection prescribed for the well-known trademark (*Hossain, 2012*).

- ***Civil Protection in Accordance with the TRIPS Agreement***

The Trade-Related Aspects Agreement of 1994 (TRIPS) is the first international agreement that defines the nature and scope of the obligations of member states, as the texts of the agreement obligate member countries of the World Trade Organisation and review their laws and internal regulations in a manner consistent with the provisions of the agreement, and the agreement focused on civil protection of the trademark on two sides. The first is related to setting general guidelines for procedures for that protection, while the second aspect has identified the most important penalties established in the event of such an attack. The agreement stipulates that the member countries are obliged to implement the provisions of this agreement, and member countries may, without obligation, implement within their laws whatever provides wider protection than what this agreement requires, provided that this protection does not violate the provisions of this agreement within the framework of their legal systems and methods. In this agreement (*Danguolė, 2010*), the term “intellectual property” refers to all categories of intellectual property as stipulated in Sections 1 to 7 of Part Two and members apply the treatment stipulated in the agreement to citizens of other member countries. In summary, the provisions of this agreement did not come with balanced provisions that take into account the extent of industrial and economic disparities for the countries that regulate them and the impact of this on their national interests. Neglecting this principle is a defect in the nature of protection to be granted under the provisions of this agreement and strengthens the fact that this agreement was harnessed to protect the economic activities of wealthy countries at the expense of the interests of poor countries (*Hammadi, 2012*).

The Nature of the Trademark Civil Suit

The civil protection suit is in fact a liability suit for the act constituting illegal competition with the added nature and concept of it due to the nature of the right subject to protection, which is what the merchant enjoys from moral and material rights over the elements of his commercial place, including the trademark, which differs from all other Rights protected under the general rules of civil liability. Although the protection prescribed for trademark owners' rights often requires the elements responsible for negligence and irresponsibility, this does not mean that the provisions of that responsibility cover all aspects of civil protection established for the Hariaa brand (*Faudel, 1994*), where we find that the scope of a case of civil protection sometimes goes beyond the protection of the right to replace the contracted elements of protection. As the trademark is one of the means of free competition to attract customers and introduce products, any abuse of it by unlawful means makes it right for the stakeholder to file a case for unfair competition. As for the scope of the trademark civil protection lawsuit, the objective framework for it is seen in terms of acts of infringement or unfair competition that violate the laws and commercial norms, and if competition is seen as crowding out traders or manufacturers to promote the largest amount of their products or services through attracting

the largest number of clients, this competition must be within the legitimate limits set by the legislation regulating this competition (*Jabali, 1998*).

The Terms of the Trademark Civil Protection Suit

- ***The Error***

The basis for responsibility for personal work is wrong. In order to be asked about compensation for the damage caused by his personal action, he must have committed a mistake and the traditional definition of error is the deviation of a person's behaviour from the behaviour of the ordinary person in the same external circumstances, with his awareness of this deviation and as evident from this definition. The error in tort liability is based on two pillars: deviation and discrimination. The legislator obliges people to take care in all their behaviour, this care is represented in the necessity of vigilance of the person in his behaviour so as not to harm others and it is equal to be a mistake, intentional or unintentional (*Younis, 2008*).

- ***The Damage***

It is not enough that an error occurs from the competing merchant, manufacturer or service provider to establish liability. Rather, this error must result in damage to the competing merchant. If the element of damage does not result, the civil liability is negated pursuant to the general rule (no case without interest) and the person who claims the damage must provide evidence. The damage is defined as an infringement of a human right or a legitimate interest, and the damage can prejudice the reputation of the merchant or the trademark, or it can prejudice its ownership or the swooping of customers. The damage is not required to be gross or slight (*Muhammad, 2011*), but rather it must be realised and it should be the result of a violation of the legitimate interest of the victim. As for its type, there has to be real damage that has to be compensated for it to be investigated, and that is, what has happened immediately or who will be affected in the future, where all the effects or some of them have not yet been shown. There is the damage resulting from the violation of the legitimate interest of the aggrieved party. It is intended that the trademark is a legitimate right of the merchant, the manufacturer or the service provider, and this is the case if it meets all the substantive conditions and is regularly exploited by its owner, and this is divided into two types; the oppression of customers, and the moral damage represented by affecting the reputation or reputation of the merchant, both of which require compensation, because the result affects the value of the commercial store and the brand as it affects the competitor (*Hussam, 2003*).

- ***A Causal Relationship between Error and Damage***

The causal relationship is the third pillar of responsibility, and it is intended that if there is an element of error and damage, then the damage must have arisen from the error itself. The causal link between error and damage is a delicate matter and this is due to two main reasons. The first is that many causes often contribute to damage events, and so it is necessary to know the extent to which each of these causes contributes to damage. This is called multiple causes. The second reason is in the case of there being an error which can be the cause of several successive damages, and this condition is called the unity of cause and sequence of damages (**Muhammad, 2002**).

The Time Range of the Protection Suit

- ***Time Zone for Temporary Protection***

This type of protection requires that the owner of the trademark enjoys temporary protection for his trademark, and this protection was established in order to encourage the owners of the products to display in exhibitions outside the regional domain even if their trademark was not registered in the country in which the offer is made, provided that the trademark is protected in its own country. The timeframe for temporary protection is the duration of the show only, but whoever has obtained a temporary protection certificate for a mark, must guarantee to submit an application for registration within a period not exceeding six months from the date of entry of the products marked in the exhibition, and this protection is renewed according to the following images (**Amer, 1988**):

1. The protection granted after the expiration of the registration period, is an additional and temporary protection for the mark ending the registration, despite the expiry of the scope of its careful protection from registration. In some legislations this is for a period of one year from the date of expiry of the registration period, such as Jordanian legislation, while the Egyptian legislation specifies six months. Other legislation exceptions specify after at least one year has passed from the date of its cancellation (**Hossain, 2012**).

The protection afforded to the abandoned mark means that the trademark will acquire its existence and ownership by the use case, and if it is left, this property will be removed. However, legislation has created a grace period for the owner of the mark, according to which he can protect an exception mark from the general rules that must be written off upon abandonment (**Adel, 2008**). This grace period is limited to three consecutive years in Jordanian-Iraqi legislation, and the Egyptian legislation has expanded to five years. This trend was confirmed by a decision of the Federal Court of Cassation in Iraq stating that the court had to investigate whether the second defendant company whose trademark was registered in its name

had used it for a continuous period of three years after registration or not, to know whether the company's claim has a legal basis (*Abdullah, 2008*).

Results

- The right to a trademark is a relative and not an absolute right, as the owner of the trademark invokes his right against others only within the limits of products, goods, or services similar to his products, goods, and services.
- The reason for acquiring ownership in the trademark is not without one of two facts, use and registration. In the first, it is based on a material fact represented by the actual use of it, and the second, registration that plays two roles, the first decision of ownership alone is sufficient reason to gain ownership.
- The registration of a trademark is a preventive means to protect the trademark, as it is a means of informing others of the existence of the trademark and to refrain from using it, as well as being a means of combating counterfeiting and fraud, but at the same time it is considered presumptive evidence to prove the opposite by establishing evidence of precedence in all ways.
- To claim compensation for infringement of an unregistered trademark, an unfair competition claim must be filed. This requires first that the aggressor be a trademark within the meaning of the law, by completing the substantive terms on which it is based, and for the unfair competition suit to occur, an element of civil liability must be defined as an act of transgression, harm, and causation.

Recommendations

- Establish a unified legal entity concerned with intellectual property rights within an organised and comprehensive legislation with all the mentioned rights that guarantees the unity of procedures, activities and efforts for inspection and oversight with emphasis on finding an administrative and judicial cadre specialised in intellectual property.
- Update methods to address violations that affect the rights of consumers and trademark owners by developing the research field and emphasising the role of oversight in coordination with the General Authority of Customs and Border Crossings.
- Adopt the distinction feature as a basic criterion in accepting the registration of trademarks and providing protection for them, regardless of the forms and images that appear on them, and seeking the assistance of experts with expertise.
- Include the consumer with the right to request precautionary measures, similar to the owner of the registered mark.



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