

Introduction

1. Background

Ever since a legal concept of ‘trademark’ began to emerge after 1860,² the law regulating trademarks has often been asked to define the contours of this ‘brand’ of property right. Modern day developments continue to raise the issue of the boundaries of trademark rights and the influence of signs and symbols on society. Terrorist attacks, political upheaval, revolutions, changing social and moral norms, public health challenges, discrimination, and inequities - all of these transformative events and unfortunate realities grow the market for new trademarks. Firms choose words, slogans, devices that tap into the current discourse. Ubiquitous social media puts more focus on the trademarks that do or do not make it onto the register.

Trademark protection is given for signs that are “capable of distinguishing the goods or services of one undertaking from those of other undertakings”.³ Trademarks that are contrary to morality or public order present an ongoing problem. Barring them from the register to protect public sensibilities and “religious, social or family values”⁴ may come at the expense of fundamental liberties like free speech. Another problem is that morality is culturally circumscribed, which does not lend itself to legal consistency in trademark decisions. These issues have been extensively explored in judicial and academic commentary. There has been less discussion about how these problems manifest themselves in socially and morally conservative jurisdictions, such as GCC countries. Also lacking is a deeper, more meaningful discussion of the perceived detriment of immoral trademarks. This thesis attempts to make a start on these two areas.

2 Lionel Bently, ‘The Making of Modern Trade Marks Law: The Construction of the Legal Concept of Trade Mark’ (1860-80) in L. Bently, J. Davis, and C. Ginsburg (eds), ‘Trade Marks and Brands’ (Cambridge University Press 2008), 3-41.

3 The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS agreement), Article 15(1).

4 Ghazilian's Trade Mark Application [2002] R.P.C. 33, [21].

2. Scope and geographical focus

The aim of this thesis is to analyse how the moral bar to trademark registration is applied in the GCC and the impact of Islamic law in this regard. It also maps out current classifications for immoral trademarks and proposes an alternative way of viewing the area, based on the concept of harmful trademarks. In exploring the notion of ‘harm’, there is an underlying premise that along with the benefits of trademarks, trademarks have the potential to lead to socially detrimental outcomes. Indeed, some have argued that a proliferation of offensive or exploitative trademarks can instigate or perpetuate alienation, and normalise harmful narratives.

The terrain is the Gulf countries and the units of analysis are three member countries: the United Arab Emirates, the State of Qatar, and the Kingdom of Saudi Arabia (henceforth UAE, Qatar, Saudi Arabia). They are chosen because they represent a spectrum of gradation in conservatism. Case law indicates that the gradations among them might hinder effective regional harmonisation of trademark laws under the new transnational GCC Trademark Law. The analysis includes European and U.S. regulation of trademarks for jurisdictional comparison. This means that cultural divergence will be illustrated on two levels: among the GCC countries and between the GCC bloc and the West.

3. Legal focus

The legal basis of this thesis is the optional moral exclusion under Article 6quinquies (B)(iii) of the Paris Convention, which states that trademarks that are “contrary to morality or public order” can be refused registration or cancelled.⁵

5 Paris Convention for the Protection of Industrial Property (1883), available at: www.wipo.int/treaties/en/text.jsp?file_id=288514

4. Methodology

This is a legal and ethnographic study, and positivist in approach.⁶ Data collection is through trademark databases,⁷ review of academic and judicial literature, and surveys of five law firms in Dubai, Doha and Riyadh. The literature reviewed includes trademark law, legal and religious texts, semiotics, and the power of brands. The robustness of survey results relies upon respondents having been sufficiently introspective to be able to relate their experience to the questions and to describe their experiences.

5. Chapter outline

Chapter I discusses commonly articulated problems of moral exclusions applied to trademarks. It is positioned as the opening chapter to bring the pervasive issues to the forefront at the outset, which frames the paper. The discussion shows there are countervailing interests of the state, traders and consumers, and these are difficult to balance. The concept of harm is introduced as a way to better understand the standard applied to moral bars in the Islamic countries of the GCC. Chapter II sets out the sources of trademark law and the rights and obligations that countries have in regulating trademarks. It considers the functions of trademarks and the benefits of registration, before then introducing the idea of moral bars that threaten these benefits. Chapter III presents the foundations of the GCC trademark system and discusses recent developments. Two exclusions that are largely unique to the GCC region are: a bar on trademarks associated with goods and services that are illegal or immoral under Shari'a law, and a political bar on trademarks from countries under sanction or embargo. With regard to the former, the chapter presents types of products that cannot be trademarked in the Gulf. It is apparent that there are more- and less-obvious ones. A comparison of how other jurisdictions deal with unlawful goods is offered. Chapter IV compares and contrasts rationales that underlie trade-

6 The proposed harm-based classification scheme/taxonomy in Chapter V and discussion of collective harm due to a proliferation of certain trademarks (e.g. pornographic, misogynistic) in Chapter I (A), may justify a normative analytical approach, however, the taxonomy should be seen strictly as a 'capture' tool, casting a wider net over contemporary trademark practice and social concerns across jurisdictions. Regarding the proliferation/accumulation argument, it is particularly conducive to future normative research.

7 EUIPO, UKIPO, TMVIEW, USPTO, WIPO Global brands database.

mark rejections in the Gulf, with those of the UK/EU and the US. Chapter V elucidates, through case-law examples, the thresholds of the moral bars applied in the three jurisdictions of this paper. Building on the discussion of harm, an alternative (jurisdiction-agnostic) taxonomy is presented.