

## Consumer Protection in The UAE: The Trademarks Act in Light of TRIPS Provisions

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This paper examines trade mark protection and its impact on the consumer in United Arab Emirates IP legislation, entitled Federal Trademarks Act No.37 of 1992. This act has been amended according to Federal Act No.8 of 2002 in the light of provision within the TRIPS Agreement of 1994, Section (2), Article 15. The concept of a trademark centres upon its distinguish features, and this paper addresses the concept of deception in a misleading mark. We consider the criteria for determining that a mark is misleading or deceptive, how such misleading marks may affect the consumer, and the role of the consumer in defining deception.

Further, we also address whether IP laws, mainly the Trademark Act, provide sufficient deterrent and safeguards, or if there is a critical need for additional support, such as Consumers Protection Act or Unfair Competition Act. We highlight the similarities, differences, advantages, and disadvantages of the provisions of the two documents, regarding whether these laws sufficiently cover consumers in law. There are elements lacking in the related laws concerning consumer protection, especially in the Federal Trademarks Act, concerning the time range and scope of protection provided in the Act. We consider if the Act covers the registration period, and if, after the registration period, the Act protects consumers against a mark that has lost its distinctiveness after registration. The IP-related legislation Federal Trademarks Act in particular shall be examined in depth for its flaws and the apparent lack of balance between the interests of trademark owners and that of consumers. We argue that there is an urgent need to amend the Federal Trademarks Law as it fails to balance the rights of trademark owners and those of the consumer, in favour of the owners.

**Keywords:** TRIPS, UAE IP Rights Legislation, trademarks, range of protection, consumer protection, misleading trademarks

This paper will create a comprehensive discourse of trademark protection and its connection to consumers, the UAE intellectual property (IP) legislation, and major IP international instruments, agreements, and conventions. These centres are on the Agreement On Trade-Related Aspects of Intellectual Property Rights (TRIPS).<sup>1</sup> This research focuses on trademarks that may lead to confusion among consumers, as well as the impact on related parties rather than a definition of trademarks and on what can or cannot be protected. We will emphasize, also, the concept of distinctive elements and protection, according to related national legislation and international instruments to provide a comprehensive legal understanding of the concept of trademarks and its impact on owners, consumers, competitors, or any third parties, who may have been affected by trademarks and products, or services linked to the mark's lack of distinctiveness. The role of distinctiveness and the impact that a lack of such distinctiveness may have on consumers may influence

the need for consumer protection, market competition, and unfair practices among competitors. Therefore, we examine the link between IP laws and consumer-protection laws.

To achieve a comprehensive examination and understanding of the element of distinctiveness of a mark or its lack, and thus its link with trademark infringement, it is essential to understand this element when the usual rationale is to grant a trademark. A misleading mark may affect consumer choice and confusion may occur in IP laws, thus reducing the efficiency of trademark law provisions as the sole protector of consumers from misleading marks, and the efficacy of having a measured standard to define what may be considered confusing to consumers. In this paper, we do not intend to examine the concept or definition of trademarks more than is required to understand the concepts that impact a comprehensive understanding and discourse regarding the subject-matter under study: the confusing or misleading trademark. A trademark can be defined as a combination of numbers, words, signs, and colours,

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together or separate, which distinguish a product/service related to the mark from similar products/services that belong to marks owned by competitors.<sup>2</sup> Finally, the discourse of the paper will lead to concrete findings embodied in the conclusion.

### **Distinctive Elements of a Trademark**

The function of a trademark is to distinguish the goods or services of the trademark owner from those of others.<sup>3</sup> Therefore, trademarks that lack a distinctive element or prohibited marks, due to the inability of a company to perform the required duty of developing a distinguishing mark, should not be considered a trademark. Hence, the need exists to identify the distinctive features of a trademark and to determine the role of the consumer in identifying these distinctive features. This consideration was addressed in judicial case law (noted in *Scandecor Developments AB v Scandecor Marketing AB*, 2001) 2001 UKHL 21 [UK]. In this case, the United Kingdom House of Lords stated, “a guarantee of the identity of the origin of the marked product by enabling him to distinguish, without any possible confusion, that product from others of a different provenance.”<sup>4</sup>

The UAE Federal Act related to trademark protection adopted the same stance as the abovementioned House of Lords judgment. The Act also accords with the Paris Convention on marks that are prohibited from being considered a legitimate mark (on grounds of refusal of registration).<sup>5</sup> That is to say, the list of what may be considered banned marks or marks that may not be registered (grounds for refusal of registration) follows the list and concept mentioned in Art.6 of the Paris Convention.<sup>6</sup> Lists of grounds for refusal of registration in much trademark legislation hail from a common background driven by the provisions of Paris Convention.<sup>7</sup> As noted in the list adopted by UAE Federal Law, the lack of distinctiveness is among the main grounds for the refusal of trademark registration. This approach has been adopted by the UAE Court of Cassation.<sup>8</sup> The Court decides the basis for the registration of a trademark, in addition to the priority of registration, as the ability of registered trademarks to distinguish certain commodities from others that may be under a similar mark.<sup>9</sup> In addition to its mission to protect from competitors, trademarks are distinctive signs that act as a means of providing required safety measures

for the goods/services of a corporation, according to fair competition and fair practices in the provision of the related legislation.

The role of trademarks connects to the concept of a distinctive mark, which is considered in the basic interests of the parties involved: the owner of the trademark and the competitors on one hand and third parties and consumers on the other hand. A trademark is a concept of protection and its effectiveness in performing its duties relies on the trademark's distinctiveness and ability to act as a deterrent against any unfair competition practices, by providing consumers with the ability to identify the products/services of a certain corporation from those of its competitors.

The UAE IP legislation considers the previously mentioned elements regarding the protection of trademarks and duties and relationships to various parties, including consumers. Even though the legislation may not have explicitly delineated consumers' rights as obtained or granted when a trademark is registered or used, it confirms the rights granted to owners of a trademark versus others, and establishes when such rights commence.<sup>10</sup> Despite the fact that the UAE Federal Trademarks Law clarifies the concept of a trademark and follows the provisions of the TRIPS Agreement and Paris Convention, the law does not have consumer interests as its main goal.

The economic nature of trademark laws and IP-related treaties and conventions is in general the main crux of these laws, in terms of the protection of the economic monopoly of the IP rights of trademark holders. Although the concept of trademarks may be of significant interest, it is not the major focus here as it has been examined in depth in previous studies. The topic of this study is the examination of the procedural process of granting trademark protection through registration in line with the provisions of the related laws. The role played by trademarks which lack distinctiveness may provide legitimate interest in revoking the registration of a trademark, notwithstanding consideration of the basic interests of related parties or third parties.

The range of signs/marks/letters/images and scents, and voices that are single or joint, could be protected by IP-related trademark legislation (trademark law and unfair competition laws specifically). These should link with their ability to help concerned parties distinguish their marks from similar marks and related products. This approach is the same taken by the

Emirati Federal Court of Cassation, as the Court stated in another case that counterfeiting consists of a misleading trademark; hence, this refers to dishonestly confusing consumers regarding a registered trademark and its goods/services, and a counterfeited trademark. The Court clearly defined a counterfeiting trademark as (Counterfeiting, 2004) “synthesizing a similar mark in totality, creating a resemblance that misleads public consumers to whom the marks are addressed, by reason of obscurity between them.” The verdict embodies the concept of distinctiveness by stating that “a trademark is a means of distinction between the products, the commodities and the services” (Trademark, 2004). It confirms the relationship between the lack of distinctiveness and confusion among consumers. The function of a trademark is achieved by distinguishing one commodity from another. However, this has to lead to confusion among consumers due to limited knowledge about misleading trademarks. Without consumer confusion, a trademark could not be considered misleading.<sup>11</sup> The goal is for consumers to have the ability to assess such distinctiveness by discerning if a trademark has a special identity which distinguishes it from other marks.

Here, we examine the trademark’s totality rather than individual elements. The Court stated, in exploring the concept of a “misleading resemblance ... The misleading resemblance, account must be made to the degree of the perception and awareness of the public consumers to whom both trademarks are addressed and their ability in distinguishing between them.”<sup>12</sup> The Court confirmed, in its final verdict, that the lack of a misleading perception of resemblance by public consumers between the applicant’s trademark and that owned was insufficient. Thus, the Court dismissed the applicant’s application and allegations of counterfeiting.

It is important here to note that attention should be paid to allowing consumers and third parties to identify products protected by trademarks, to avoid and reduce any possibility of confusion among the public and consumers, as they can readily identify a trademark from its distinctive features or other distinctive criterion. The distinctive features of a trademark require protection through registration, or the granting of a trademark based on use. However, in addition to such distinctiveness, any possible confusion that may arise among consumers should also be removed (as will be analysed in greater detail

in this paper). This doctrine has been confirmed by the European Court of Justice (ECJ) in several rulings, such as in *BMW v Deenik*.<sup>13</sup> The Court also asserted its findings in the Google case.<sup>14</sup> In both cases, the Court rejected the claims of the plaintiffs based on the lack of confusion among the public and consumers. The Court stated that the use of related marks by the accused parties did not create unfair practices. Therefore, no trademark infringement was committed by the accused. The defendants did not use trademarks that satisfied the requirements of the passing-off doctrine,<sup>15</sup> as the public was not confused. The mark of the accused party was sufficiently different from the trademark owned by the plaintiff.

The stand point taken by the ECJ in the above mentioned cases (BMW and Google) has been addressed by national judiciaries in the UAE in Case No. 297/2001 Dubai Court of Cassation Commercial Chamber (Lanzo case). The Court stated that the distinctive factor of a trademark has an essential function—that of dismissing the confusion of the consumer—and must pass the standard of eradicating any possible confusion, no matter how slight.<sup>16</sup> Therefore, the court decided to strike the trademark (Lanzo) as it was confusingly similar to previously registered Trademark No. 12603, date of registration 11/09/1995 (Lanzor). In doing so, the Court removed any possibility of misleading consumers. The verdict confirming the role of procedural measures has, as a deterrent safeguard, the best interests of the involved parties. It has to be mentioned that even though the Federal Trademark law establishes the range of a protectable mark, it however does not create a link between the distinguish ability of the mark and consumers’ rights.<sup>17</sup> Although it states the grounds of a refusal to grant a trademark, it does not establish the main functions of a trademark towards the public/consumers or third parties.

### **Misleading Trademarks and Consumer Confusion**

Legislations state the procedural terms upon which people can obtain a trademark in the UAE according to the law, which is limited to UAE nationals. Foreigners may obtain a trademark on equal terms with nationals in accordance with the rules of equal treatment, dubbed national treatment (NT),<sup>18</sup> as long the trademark has clear-cut distinguishable criteria and avoids any confusion for consumers or any misleading resemblance with an existing trademark. These legal tenets are in line with the provisions of international IP treaties such as TRIPS and the World

Intellectual Property Organization (WIPO),<sup>19</sup> in that these treaties guide the conclusion of the Trademark Registration Treaty of 1973,<sup>20</sup> aligned with the provisions of the Madrid Protocol (Protocol) signed on June 27, 1989, in force on April 1, 1996.<sup>21</sup> The position of IP and trademark-related legislation has, in general, reached a comprehensive agreement on the nature of a mark that ought to be granted protection, according to the provisions of Jordanian and UAE trademark laws. Article 7 stipulated that the combination of images that may be considered a trademark must have a “distinctive character”. In the same Article 7(2), the “distinctive” character is defined as follows (Jordanian, 1952): “For the purposes of this Article, ‘distinctive’ shall mean applied in a manner which secures distinguishing the goods of the proprietor of the trademark from those of other persons.”

Although, UAE legislation has taken a similar approach to identifying the distinctiveness of a mark, it adopted different wording and terminology in Article 3(1) of Federal Law (Trademarks, 2002), by identifying “grounds for refusal of registration” in that “The mark has no property or distinctive character...etc.” UAE and Jordanian legislation has adopted the same concept of distinctiveness. Whereas the former defined and stipulated the concept and its functions, the latter stated that a mark will not be considered a trademark according to the provisions of the law if it lacks distinctiveness.<sup>22</sup> The provisions of the UAE Federal Trademarks Act and the Jordanian Trademarks Act serve the same purpose, and leave to the administrative authority (Trademarks and Patents Registrar) the right to register or dismiss a trademark lacking distinctiveness, and to the appropriate court to confirm or dismiss the administrative action of granting a trademark. This approach is intended to protect trademarks and their main functions and duties. Notwithstanding this, it is common knowledge that the crux of a trademark is to provide the public (consumers) with the ability to identify the goods/services of a certain commercial organization from the products/services provided by competing organizations. Recent verdicts of the UAE Supreme Federal Court adopted the approach stipulated in the provisions of the UAE Federal Trademarks Act. The court stated “that a trademark must have a certain level of relative novelty, either from a products perspective, time of registration or regional location.”<sup>23</sup> According to jurists, the word “novelty” refers to merchants and other traders’ lack of knowledge of the mark, and not

the novelty requirement in objective terms and conditions to grant a patent.<sup>24</sup>

Therefore, the basic elements and information of the manufacturing process of the product or goods is excluded from trademarks. Even though the provisions are comprehensive concerning misleading marks and the rules of refusal to grant trademarks, these provisions deal with defusing misleading marks prior to registration.<sup>25</sup> Notwithstanding this, such provisions have not provided sufficient means and follow-up measures to ensure that the trademark is still functioning and performs its economic and social duties. This is because, if it loses its distinctiveness criteria, the provisions lack the detailed measures to dismiss an infringing mark. The ability to dismiss a misleading trademark is required, as even though the trademark registrar department may strike off an infringing mark, there is no procedure by which consumers can apply for this process, even though it is they who are mostly affected.<sup>26</sup>

The approach taken by the UAE and Jordanian legislation derives from the provisions adopted by French legislation—French Intellectual Property Code Article L 711-3 (c), which stipulates that the infringing marks are the Signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.<sup>27</sup> This approach in the French legislation sheds light on the progressive stance taken in the provisions of the code, as it does not restrict infringement of trademarks solely from the concept of misleading or confusing the consumer. The French IP Code includes a non-exclusive list of what may not be registered as a trademark (Absolute Grounds for Registration).<sup>28</sup> In several verdicts, the French courts have focused on a trademark that may lack a certain element, thereby causing confusion among consumers, who have been misled to accept a certain product/service that has not been delivered by the trademark and its represented goods/services. This facet was clearly noted in the French Court of Cassation Case regarding the trademark Lavablaine, which is a mark registered to protect products that contain wool or laine; in actuality, the products did not contain these, although Lavablaine did include certain elements in its products essential for the existence of a trademark.<sup>29</sup>

The French judiciary has taken a new tack regarding misleading trademarks that present as environmentally friendly marks, but the product/service does not align with such criteria. Certain trademarks and their related

products use environmental friendliness as an excessive marketing tool. Using this style of marketing, and rendering the trademarks in question, a company will claim that the product/service protected by the mark is a green product/service when it is not. The process is called *green-washing* or *écoblanchiment* in French.<sup>30</sup> This stance has been adopted by many French courts, in which it has been confirmed that a trademark that is not truthful about certain elements would be a misleading mark.

Related acts and legislation (Trademarks Act No. 37, 1992 and its amendments) provide sufficient safeguards for the involved parties, considering the interests of the owners or potential owners through many procedural measures that block any unfair competition of competitors, such as the priority of registration (first come, first served).<sup>31</sup> The similarity to existing marks could relate to misleading trademarks, thereby confusing the public/consumers with unfair competition.

The link between trademarks, unfair competition and consumer protection rights –even though currently non-existing– may provide a connection to bridge the current legislative gap between the previously mentioned legislations, in a manner to create the required balance between the economic monopoly rights of the IP holders and the social economic rights of the consumers.

These safeguards are in harmony with the rules and measures required and established internationally and accepted as minimum standards on the national level through international commercial law and norms.<sup>32</sup> As may be noted, procedural measures, mainly in the form of the registration process, are considered significant protection methods that grant the rightful owner justice, especially to prevent any illegal and unfair competition and situations of misrepresentation. The claim of misrepresentation entails a trademark infringement consisting of three main elements required in common law precedents: (1) the concept of good will or reputation of the trader, (2) misrepresentation on the part of the accused, and (3) damage and economic loss on the part of the trader.<sup>33</sup> Furthermore, other procedural safeguards help to act as deterrent by striking off infringing trademarks.

### **The Trademark Act's Protection of Consumers**

Trademark laws, anti-infringement, and counterfeiting processes stated in trademark legislation, which seek to combat misleading

trademarks and their impact on consumers and competitors, are insufficient. Although trademark legislation might be a useful tool to counter intentional trademark infringement, secondary safeguards are necessary, such as Unfair Competition and Consumers Protection Acts.

The legal nature of infringement and misleading trademarks relates to various legal aspects of trademarks, unfair competition, and consumer protection. As has been highlighted, trademark infringements relate to the lack of a distinctive character, leading to the consumer being confused or misled, and these are strongly connected to the judicial nature of trademark rulings on unfair competition and consumer protection.

Among the three legal theoretical concepts, this link appears in the French judicial application of granting or dismissing a “green mark” or a trademark that provides a description of a commodity that is environmentally friendly or organic in nature. If such a proclaimed green mark confuses consumers or misleads them into believing the company was eco-environmentally friendly when it was not or did not own a distinctive element as claimed,<sup>34</sup> although from a legislative and legal perspective the mainstream approach among scholars is to follow the literal footsteps of law, green washing may fall explicitly in the range of consumer protection law rather than trademark laws. Thus, it is necessary to separate trademark law from consumer protection laws.<sup>35</sup> This approach has been influenced by the French judicial and legislative jurisdiction, as described below. Despite the accurate application of the provisions of the law by the French Court of Cassation through the appropriate application of the provisions of the Trademark Act regarding “grounds of refusal” to grant a trademark, consumer protection is necessary. Among the main reasons to dismiss a mark is the lack of a distinctive element/factor in the mark, thereby misleading consumers or causing them to mistake the product/goods/service as those protected by a mark owned by a competitor.

This concept could be implemented on all types of misleading trademarks, intentional infringements, green-washing, or otherwise. The concept rests on the obvious connection in the legislation understudy between trademarks, unfair competition, and consumer protection.

Article L. 121-1 of the French Consumer Code provides that a commercial practice is misleading

“where it relies on false or misleading claims, indications or representations covering one or more of the following items: ...the essential features of the product or service, namely: its substantial qualities, composition ..., method and date of manufacture, [and] the results which may be expected from its use.” Article L. 121-1-1 provides that the following acts are also misleading: “commercial practices which seek to: ... display a certificate, quality label or equivalent without obtaining the required authorization;... declaring that a professional, including through his/her commercial practices, or that a product or service has been registered, approved or authorized by a public or private body even though this is not the case, or the professional has failed to respect the conditions of this registration, approval or authorization.”

The French Court of Cassation, in its decision issued on 21 January 2014, indicated it is not possible to prove the descriptive character or misleading brand only through the texts of IP law and not through the Consumer Protection Act.

In summary, the facts of the case are that the Hero food company began producing jam under the brand *Confipure*. Andros filed a lawsuit to cancel the registration of the mark on the grounds that the brand misled the consumer, because in the recipe PUR, the public will think this product is better than the other. The prosecutor relied on provisions of Articles L. 711-3 c of the IP Code and Article R. 112-7 of the Consumer Protection Act. The Court of First Instance decided it was not permissible to verify the validity of the trademark registration based on the information provided, on the grounds that each item of the brand and the consumer protection Law about them are different. This was then confirmed by the Court of Appeal and Cassation.

The Court’s decision leads to stability and economic relations; other decisions may lead to double punishment for a single act, and the abolition of a milestone available for registration requirements. There is no doubt that the Court’s position inflicts harm on competitors who attempt to evade the obligations imposed by law to protect consumers by registering a sign containing some data that prevent application of the Consumer Protection Act.

However, reference to the text of Article L.711-3 b of IP Law prohibits registration of a trademark in the case of any violation of public order and morality, or in the event their use is prohibited by law. In other words, it is not only IP legislation which has

legislation on geographical indications, as the Consumer Protection Act also covers these.

In France too, we must reference Article R.5121-2 of the French Public Health Act, which prevents the registration of a trademark consisting of an international common label for a particular drug. The standpoint the UAE adopted appears in European and U.S. judiciary implementation.<sup>36</sup> However, this approach should be clarified in a more explicit fashion by the legislator concerning the connection between trademarks, unfair competition, and consumer protection, which should be stated in legislative framework.

### **Conclusion and Assessment**

Do IP laws alone, for example, The Trademark Act; provide sufficient safeguards against misleading trademarks? Or is there a critical need for further support such as the Consumer Protection Act and Unfair Competition Act? Trademark legislation on the local and international levels requires a mark to have a distinctive character/element to be granted the safeguards stipulated in the provisions of related laws or treaties. We have shown that UAE Federal Law 2002 follows in the footsteps of the TRIPS Agreement and Paris Convention, as well as leading European and U.S. IP Rights in general and trademark laws in particular. The legal and judiciary application regarding the distinctiveness element is accurate according to the letter of the law and international provisions of related agreements. To dismiss a trademark due to the lack of the distinctiveness element, it has to mislead consumers, causing confusion among them with marks owned by competitors’ products/services. Even though trademark laws cover both elements of distinctiveness and misleading consumers, trademark laws may be insufficient to provide deterrent safeguards. Unfair competition laws provide a secondary protection to help remove any element of confusion among consumers with similar marks owned by competitors.

Therefore, Consumer Protection Laws are essential, even though the French Court of Cassation and the Consumer Protection Act provisions do not mention any legal connection between trademark law and consumer protection. However, the findings of this paper disagree with the verdict of the Court of Cassation as the provisions alone may not apply to misleading trademarks. However, the use of unfair competition laws, as a tool to create a link between trademark law and consumer protection, as noted in

the case of green washing marks, have no distinctive element, as seen in various French, European, and U.S. judicial applications.

Despite the provisions for UAE trademarks, unfair competition and consumer protection laws do not have any visible or explicit statement related to eco marks; however, no provisions in the UAE IP and consumer protection provisions concern the lack of a distinctive element. Marks which mislead consumers can be applied to future applications, including misleading eco-marks.

### Recommendations

The paper recommends amendments that bridge the legislative gap in IP related legislations and consumers' rights, such as the changes in trademarks Federal Act concerning the lack of clear-cut provisions on the link between the new holy trinity of the trademarks functions, and the owners' and consumers' protection. The paper also recommends creating a fair balance between the economic power of the owners' of trademarks, and the social element of the law has to maintain the consumers' right to be able to distinguish the product/service related to trademarks. There is therefore clearly a lack of criminal provision in both the trademark and unfair competition Act combating trademark infringements related misleading marks, as in counterfeiting marks.

### References

- 1 Article 6 of the Paris Convention for the Protection of Industrial Property (1883) latest amended (1967) (herein after Paris Convention).
- 2 TRIPS Agreement Article (15/1)1994 "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other under takings, shall be capable of constituting a trademark."
- 3 *Laugh It Off Promotions CC v SAB International (FINANCE) BV* [2005] ZACC 7 [South Africa]. This is similar to the concept of Art.10 and 11 of Executive Regulations No.12, 2007 of Federal Act Consumer's Protection No.24, 2006.
- 4 *VERIMARK (PTY) LTD v BMWAG* [2007] ZASCA53 [South Africa]. ECJ, 16 November 2004, Anheuser-Busch/BudějovickýBudvar,C-245/02,ECR2004,I-10989.*DYSON LTD v REGISTRAR OF TRADEMARKS* ECJ, 25 January 2007, C-321/03, ECR2007,I-687. *Lancôme v OHIM* ECJ, 25 February 2010, C-408/08P, ECR 2010, I-1347.
- 5 Article 6 (sub paragraphs 1–10) Paris Convention Article 3 Trademarks Act No.37, 1992 and its amendments.
- 6 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks. Date of effect: 27/12/1988; Entry into force Date. <http://data.europa.eu/eli/dir/1989/104/oj> (accessed on 16 September 2016).
- 7 Section 3(1/b) Trademarks Act 1994 Absolute grounds for refusal of registration. It mentions that a mark shall be refused registration if a mark has no distinctive feature it states 'b. trademarks which are devoid of any distinctive character,' also, see General Court, 5 October 2011, PAKI Logistics/OHIM (PAKI), and T-526/09.
- 8 Article 7(2) Federal Trademarks Act No.37, 1992 amended by Law No.7 2002 regarding Trademarks (hereinafter Federal Trademarks Act No. 37 of 1992 and its amendments) Art. 8(10) Trademarks Act No. 33 of 1952 and its amendments.
- 9 Court of Cassation Case no.234/2004(deletion of a Trademark, Priority of registration, distinguish ability of a trademark) at the Judicial Code x527-532.
- 10 It has, however, mentioned the rights of consumers in specified related legislations such as the Consumer Protection from Commercial Deception Act as will be detailed later in this paper and is relatable to trademarks infringement and unfair competition.
- 11 The Jordanian Court of High Justice Case No (372/2003) (Five Bench Chamber) issued 20/11/2003 published at Adaleh Centre publications (AR). We have applied Jordanian judicial applications on the subject matter due to the almost identical legal IP protection system, registration and striking of trade marks in the United Arab Emirates and Jordan are very similar. The Jordanian Trademarks Act No 33, 1952, and its latest amendments in 2008 mirror the provisions of UAE Trademarks Act. UAE Court of Cassation Case no.356/2004(ConfusingConsumersandMisleadingTrademark/CounterfeitingofTrademark) at the JudicialCodex259-262.
- 12 Court of Cassation Case no.356/2004, pp.261–62.
- 13 *Bayerische MotorenwerkeAG(BMW) and BMW Nederland BV v Ronald Karel Deenik* ECJ (C- 63/97), Judgment of the ECJ, 23 February 1999.
- 14 *Google France SARL and Google Inc. v Louis Vuitton Malletier SA* ECJ (C-236/08), 22 September 2009.
- 15 The Holy Trinity of Passing off (1) good will or reputation of the trader,(2) misrepresentation on part of the accused,(3) damage and economic loss on the part of the trader.
- 16 Author's translation from the Arabic text of UAE 2001 Dubai Court of Cassation Commercial Chamber Case No.297/(LANZO case).
- 17 Article 3 (1 and 6) Trademarks Act No. (37) OF 1992
- 18 Article 4 and 5 Trademarks Act No. (37), 1992 and its amendments.
- 19 Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization [hereinafter WTO Agreement], Annex 1C, Legal Instruments—Results of the Uruguay Round vol. 31; 33 I.L.M. 81 (1994) [hereinafter TRIPS].
- 20 Leaffer M A, The new world of international trademark law, *Marquette Intellectual Property Law Review*, 2 (1) (1998) 13–14.
- 21 Leaffer M A, The new world of international trademark law, *Marquette Intellectual Property Law Review*, 2 (1) (1998) 25.
- 22 Article 8(10) Trademarks Act No. 33 of 1952 and its amendments "A mark identical with one belonging to a different proprietor which is already entered in the register in respect of the same goods or class of goods for which the mark is intended to be registered."

- 23 Court of Cassation Case No. 320/2000, Court of Cassation collective Verdicts Gazette, 556.
- 24 Khatter N, Explanatory Principles of Intellectual Property—Industrial Property, 2nd edition (Wael’s House for Publications, Amman, Jordan), 2010, p. 280; Chavanne D A & Burst J.-J. *Droit de la Propriété Industrielle* (Daloz, Paris), 1998, 548.
- 25 Article 3 (1-14) Federal Trademarks Act No. (37).
- 26 As seen in the formation of the trademarks committee and its members Federal Trademarks Act No. (37) Article 13.
- 27 It entered into force in Act No. 96-1106 of 18 December 1996 Art. 12 Official Journal of 19 December 1996. It has to be mentioned that this text is driven from the principles mentioned in the provisions of Article 6 of Paris Convention 1883 and provisions of Article 7(b) under the title of “Absolute grounds for refusal” “(b) trademarks which are devoid of any distinctive character.”
- 28 The provisions of Trademarks Act 1994. It has to be confirmed that the provisions of both UAE and Jordanian Trademarks Acts have the footsteps of the French legislation and adopted a non-exclusive list of the marks that will not be considered a trademark.
- 29 Cass.com. 19 December 1956, JCP1957, II, n9965.
- 30 Lane E L, Green washing 2.0, *Columbia Journal of Environmental Law*, 38 (2) (2013) 279–331.
- 31 Article 5 United Arab Emirates Federal Trademarks Act No. 37 of 1992 and its amendments. The Jordanian Court of High Justice Case No (344/2006) (Five Bench Chamber) issued 20/12/2006 published at Adaleh Centre publications. (AR) Al Husban N, Jordanian Judicial Perspective on Intellectual Property Issues, *Proceedings of Intellectual Property and Economic Growth Conference 2014* (Kuwait, 30-03-2014), 13.
- 32 TRIPS Agreement 1994.
- 33 *Erven Warnink B V v J Townend & Sons (Hull) Ltd.*, [1979] AC 731, [1980] R.P.C. 31 known as the Advocate Case. Also, see *Reckitt & Colman Ltd v Borden Inc* [1990] 1AllE.R.873.
- 34 There has been a rich history of French judicial application of the distinctiveness character/element as a main factor to grant or dismiss the so-called green marks if they lack the distinctiveness element. Trademarks act as tools to tackle green-washing marks. Therefore, protecting consumers via guaranteeing the origin of the product as the Paris Court of Appeal 4<sup>th</sup> division, 14<sup>th</sup> December 1994, *PIBD* 1993, 544, III, 322, in which it stated “a trademark serves to guarantee to consumers the origin of the product by allowing them to distinguish it from those from other sources.” Court of Appeal of Paris, 27 September 2008, *PIBD* 2008, no 884, II, no. 629. TPICE, 12 June 2007, case *Mac-Lean Fogg/OHIM*, T-339/05.
- 35 Rapport d’études 2011, *Publicité & Environnement*, March 2012, 20–21. Also see in the same meaning Henry G, *Technologies Vertes et Propriété Intellectuelle—Green Tech and IP Rights* (LexisNexis, New York), 2013, 404–405.
- 36 There have been quite a number of trademark applications containing the term *Green* in recent years, increasing dramatically from 1,100 in 2006 to 3,200 in 2008. Lane E L, Consumer protection in the eco-mark era: A preliminary survey and assessment of anti-green washing activity and eco-mark enforcement, *John Marshall Review of Intellectual Property Law*, 2010, 744. Communication from the Commission to the European Parliament and the Council. Building the Single Market for Green Products. Facilitating better information on the environmental performance of products and organizations, COM (2013) 196 final, 9 April 2013, 39.