

QATAR

Aurore Deeb

(D&C Legal Services)

LEGAL FRAMEWORK

Domestic law

1. What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks in Qatar is the Trademarks Law No. 9 of 2002 with respect to Trademarks, Trade Indications, Trade names, Geographical Indications and Industrial Designs and Templates 9 / 2002.

In addition, the Minister of Commerce and Industry issued on 9 July 2023, a decision adopting the GCC implementing regulation in compliance with the Law No. 7 of 2014, which ratifies the GCC Trademarks Law (the Implementing Regulation).

The Implementing Regulation introduced some procedural amendments to be in compliance with the GCC Trademarks Law.

International law

2. Which international trademark agreements has your jurisdiction signed?

Qatar is a signatory to several international trademark agreements, including the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) under the World Trade Organization. These agreements establish the framework for the protection of trademarks in Qatar and ensure that foreign trademark owners receive protection under Qatari law.

Also, Qatar is signatory of the GCC trademark law, which is a unified trademark law to establish a common trademark system across the GCC member states.

Regulators

3. Which government bodies regulate trademark law?

Trademark law in Qatar is administered by the Ministry of Commerce and Industry. The Department of Intellectual Property at the Ministry oversees trademark registration, examination, and enforcement. This department plays a crucial role in regulating and protecting trademarks in Qatar.

As per article 3 of Law No. 9 of 2002, the office for the Protection of Industrial Property (the Office) shall be responsible for carrying out the duties stipulated in this Law. And in accordance with article 5 the Office shall keep a register wherein shall be entered all registered marks with the details of their owners, notifications of assignments or transfers, the details of licensees, renunciations, renewals, nullities and such other matters relating to marks as may be prescribed in the executive by-law of this Law.

REGISTRATION AND USE

Ownership of marks

4. Who may apply for registration?

Any individual or legal entity, whether domestic or foreign, may apply for trademark registration in Qatar. This includes individuals, companies and foreign entities seeking protection for their trademarks within the country.

It is worth noting that in the event the owner of a trademark is foreign and is not resident in Qatar, he or she shall organize a power of attorney to a resident of Qatar to oversee the registration process.

Scope of trademark

5. What may and may not be protected and registered as a trademark?

According to article 6 of the Law No. 9 of 2002 trademarks that can be registered include: Names, signatures, words, letters, numerals, designs, pictures, symbols, stamps, seals, vignettes, reliefs and any other sign or a variety of colors, a non-functional single colour, sound, or smell, or a combination of signs, if used or intended to be used to distinguish the products of enterprises in the fields of industry, handicraft or agriculture, or private enterprises in the fields of forestry or mining or to distinguish goods sold or services performed in the course of trade.

However, the following cannot be registered as marks or as elements thereof:

- signs free of any distinctive character or that are a mere description of the characteristics of goods or services, or which consist of marks and indications that are the normal designations in use for such goods or services or their normal designs;
- any term, design or sign contrary to morality or public order;
- public emblems, flags and other symbols and names or designations relating either to a country or international organization, as well as any imitation of the above unless with the prior written approval of the relevant authority;
- official signs and hallmarks of any country or relating to its control and guarantee of goods or services, unless with the prior written approval of the relevant authority;
- symbols that are identical or similar to the Red Crescent or Red Cross;
- the picture, name or emblems of a third party unless with his or her prior written approval;

- indications of honorary distinctions to which the applicant cannot prove that he or she is legally entitled;
- signs that are identical or confusingly similar to the public, to a mark already registered or for which an application was filed by a third party for identical or similar goods or services, or signs that are widely famous even though an application was not filed for them or they were not registered in Qatar, regardless of the extent to which the associated goods or services or those for which a registration application was made are identical or similar; and
- signs likely to deceive the public or that contain false details as to the origin or other characteristics of the goods or services, as well as signs that create confusion due to their containing a fictitious, falsified or counterfeit indication or trade name.

Unregistered trademarks

6. Can trademark rights be established without registration?

Qatar follows a ‘first to file’ system for trademark registration, which means that the individual or entity that files a trademark application first is generally granted the rights to that trademark, even if they are not the first to use it in commerce. Unlike some countries that recognize common law or unregistered trademark rights based on prior use, Qatar’s trademark system primarily relies on formal registration.

In Qatar, the first party to successfully register a trademark with the relevant authorities will generally have exclusive rights to that trademark within the registered class or classes of goods and services. This emphasizes the importance of timely trademark registration to secure your rights and prevent potential disputes.

If someone else has already registered a trademark you have been using, it can

be more challenging to claim rights to that trademark based on prior use alone.

Famous foreign trademarks

7. Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

The recognition of foreign trademarks is in line with Qatar's obligations under international agreements. However, proving the fame of a foreign trademark may be required, and evidence of its reputation and recognition in other jurisdictions can support the claim for protection.

As is the case in many jurisdictions, the protection of famous trademarks is generally based on their recognition and reputation within the country. To receive protection as a famous foreign trademark in Qatar, the mark should be well-known among consumers and relevant stakeholders within Qatar's market. The following are the key points to consider:

- **Recognition within Qatar:** To be eligible for protection, a foreign trademark, whether famous or not, should be recognized and have a reputation among consumers, industry professionals and the public within Qatar.
- **Local market impact:** The foreign trademark's impact on the local market is an important consideration. If it is known and widely associated with particular goods or services in Qatar, it may be eligible for protection.
- **Evidence of fame:** Trademark owners seeking protection for their famous marks in Qatar may need to provide evidence of the mark's fame and reputation within the country. This evidence may include market surveys, consumer testimonials, advertising, media coverage, sales figures and other relevant documentation.
- **Scope of protection:** Once recognized as famous within Qatar, the foreign

trademark may enjoy protection against unauthorized use or registration by others for similar or identical goods or services. This protection helps prevent confusion and dilution of the mark's distinctiveness.

The benefits of registration

8. What are the benefits of registration?

According to article 7 of the trademark law in Qatar, the person who registered the mark shall be deemed to be the absolute owner thereof. The ownership of a mark cannot be contested if the person in whose name the mark is registered has made uninterrupted use of it for a period of at least five years after the date of registration without the initiation of any claim against him or her in dispute of his or her ownership thereof.

And according to article 20 of Law No. 9 of 2002, the owner of a registered mark shall have the right to prohibit third parties from using his mark, or any sign resembling it in such a way as to be likely to mislead the public, in respect of goods or services for which the mark is registered or for similar goods or services.

Hence, registering a trademark in Qatar offers several benefits, including:

- exclusive rights to use the mark for the registered goods and services;
- creates a legal presumption of ownership and validity of the mark;
- enforcement of their rights against infringers;
- access to specialized intellectual property courts in Qatar for enforcement;
and
- border enforcement.

Filing procedure and documentation

9. What documentation is needed to file a trademark application?

What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

To file a trademark application in Qatar, the following documentation is typically required:

- a completed application form after payment of the prescribed fees;
- an original power of attorney, legalized up to the Qatari Consulate if the applicant is not based in Qatar;
- a clear representation of the trademark in JPEG format;
- details of the applicant's name, address and nationality;
- if the applicant is a legal entity; a copy of the commercial registration of the legal entity;
- copy of the authorized signatory identification card or coloured copy of his or her passport;
- if the applicant is an individual, copy of his or her passport, if he or she is a foreign national. However, if the applicant is a Qatari, copy of his or her identification card;
- a list of goods and/or services for which registration is sought, following the Nice Classification; and
- if the applicant is claiming priority, a copy of the priority document with an Arabic translation.

The representation of the mark must be clear and accurate. It can include words, logos, or a combination of both. It should be capable of distinguishing the goods or services of the applicant from those of others.

In Qatar, the process of submitting trademark applications has been streamlined

to offer the convenience of electronic filing. Applicants can take advantage of this efficient system by submitting their trademark applications and paying the filing fees online through the dedicated portal provided by the Ministry of Commerce and Industry.

While not mandatory, conducting a trademark search before filing is advisable to check for conflicts with existing trademarks. Trademark searches can be conducted through an application submitted to the Ministry of Commerce and Industry – Department of Intellectual Property – trademark office. And the associated governmental fees for a search are 1,000 riyals per trademark, per class.

Registration time frame and cost

10. How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

The time frame for obtaining a trademark registration in Qatar can vary but it typically takes around 12 to 18 months from the date of filing, provided there are no objections or oppositions.

The cost of obtaining a trademark registration includes filing fees, attorney fees (if applicable) and any additional fees for services such as conducting searches. The total cost depends on various factors, including the number of classes and the complexity of the application.

However, the updated governmental fees for a trademark registration (including filing, publication and registration fees) amount to approximately US\$1,240.

Registration formally takes effect upon approval by the Trademark Office, accompanied by the payment of the requisite registration fees. Subsequently, the certificate of registration is issued to the trademark owner, signifying the

official recognition of their exclusive rights. It is important to emphasize that from the moment the certificate of registration is issued, the protection of the registered trademark is retroactively traced back to the initial filing date. This hallmark feature ensures that the trademark owner's rights are safeguarded comprehensively, dating back to the inception of the application process.

Several factors, including the possibility of oppositions by third parties, the need for thorough examination, rejection from the trademark office, an office action and appeals, can potentially extend both the duration and expenses associated with securing a trademark registration. Furthermore, it is worth noting that occasional variations in government office hours or reduced working hours during special occasions in Qatar, which can affect the pace of the registration process, should also be considered. Additionally, filing applications across multiple classes or encountering objections may result in heightened costs and extended processing times.

Classification system

11. What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

In Qatar, trademark registration aligns with the International Classification System, consisting of 45 classes encompassing various goods and services. It is important to note that Qatar does not offer the option of multi-class applications, meaning that applicants must file separate applications for each class they wish to cover. This distinction from multi-class systems in other jurisdictions should be considered when planning and budgeting for trademark registration.

However, it is crucial to be aware that goods in class 33 and alcoholic beverages in class 32 are not permitted to register as per Qatari Trademark

Law.

Examination procedure

12. What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Qatar Trademark Office employs a rigorous examination procedure to assess trademark registration applications, ensuring their compliance with the Trademarks Law. This procedure involves a comprehensive evaluation of the application and a thorough check for potential conflicts with existing trademarks registered in Qatar. Should the proposed mark closely resemble or match a previously registered trademark within the same class, the application may face rejection.

Applicants are granted a 60-day window from the date of receiving the Trademark Office's decision to respond to objections or rejections. During this period, applicants can present compelling arguments and supporting evidence in favour of their mark's registration. Additionally, applicants have the option to submit letters of consent from owners of conflicting trademarks as a means to resolve objections. If the prior trademark owner consents to the use and registration of the conflicting mark, the application can progress through the registration process.

Use of a trademark and registration

13. Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds

of non-use?

In Qatar, it is not mandatory to assert the use of a trademark or service mark as a prerequisite for obtaining registration.

It is worth highlighting that to secure protection within Qatar, trademarks must be registered in the country. Nevertheless, applicants have the option to claim priority when registering their trademark in Qatar, provided they submit their application within six months of the date of the foreign application.

Qatar does not impose specific usage requirements for the maintenance of a trademark registration. Nonetheless, it is essential to be aware that non-utilization of a registered trademark for a consecutive five-year period may expose the mark to potential cancellation initiated by third parties on grounds of non-use. Therefore, trademark owners should actively engage with their marks to ensure the ongoing safeguarding of their intellectual property rights.

Markings

14. What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

In Qatar, there are no specific words or symbols mandated for indicating trademark use or registration. However, it is common practice to use the TM symbol for unregistered trademarks and the ® symbol for registered trademarks to notify the public of the mark's status.

While marking is not mandatory, using these symbols can have several benefits:

- Notice to the public: Using TM or ® notifies others of your trademark rights, potentially deterring infringement.
- Preservation of rights: Proper use of markings can help preserve your rights

in a mark and strengthen your position in case of infringement.

- Evidence of ownership: Markings serve as evidence of ownership and can simplify legal proceedings.
- Failing to use appropriate markings may not result in the loss of trademark rights but can impact the ease of enforcing those rights.

Appealing a denied application

15. Is there an appeal process if the application is denied?

In Qatar, an appeal process is available to applicants in the event their trademark application is denied. If a decision made by the Trademark Office is contested, applicants retain the right to challenge and appeal such decisions within 60 days of the date of service of the trademark office's decision. Appeals are directed to the trademark office in the first instance.

Should the decision of the appeal committee at the Ministry of Commerce and Industry's trademark office continue to reject the application, the applicant still has recourse. They may further appeal this decision before the competent court within 60 days of the date of service of the appeal committee's decision at the trademark office.

Third-party opposition

16. Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

In accordance with article 15 of Qatari Trademark Law as amended, trademark

applications are typically subject to a publication process for opposition in Qatar. During this phase, interested third parties are granted a period of two months from the publication date to oppose the application before it proceeds to registration.

The opposition procedure necessitates the filing of a formal notice of opposition with the Trademark Office, in which the opposing party must clearly state the grounds for their opposition and provide supporting evidence for their claim. In response, the trademark applicant is given the opportunity to defend their application and present counterarguments.

However, even if a third party does not oppose a trademark application for any reason, they still maintain the option to seek the cancellation of a registered trademark within a five-year window from the registration date. Grounds for such cancellation actions may include prior rights, non-use of the trademark or bad faith registration.

It is important to note that a brand owner may not oppose a bad-faith application for their mark in Qatar if they lack existing trademark protection in the country. Trademark opposition typically requires the opposing party to hold prior rights or established trademark protection for the concerned mark.

As for the costs associated with third-party opposition or cancellation proceedings, these expenses can vary significantly depending on the complexity of the case and the involvement of legal representation. Factors contributing to the overall costs may encompass legal fees, administrative charges and expenses related to the collection and presentation of evidence.

Duration and maintenance of registration

17. How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Trademark registrations in Qatar are initially valid for a period of ten years, starting from the date of the filing date. Subsequently, trademark owners have the option to renew their registrations for additional 10-year intervals by simply remitting the prescribed renewal fees.

It is worth noting that, unlike some jurisdictions, Qatar does not mandate the use of the registered trademark as a prerequisite for maintaining the registration. However, trademark owners should be aware that non-use of their registered mark for a continuous period of five years could potentially render the mark susceptible to cancellation by third parties.

During the renewal process, there are no specific requirements for trademark owners to provide proof of use of the mark. However, it is essential to understand that in the event of a revocation action initiated due to non-use, brand owners will be called upon to furnish compelling evidence of the mark's utilization in order to fend off the cancellation of their registration.

This evidence of use may encompass various forms of documentation and records, which can include:

- Sales figures: Demonstrating the commercial activity involving the trademark, such as sales data or financial reports, can be instrumental in proving genuine use.
- Import reports: Providing records of the importation of goods bearing the registered trademark into Qatar can substantiate its usage.
- Distributorship agreements: Having a distributorship agreement within the country that outlines the distribution and sale of products featuring the trademark can serve as supporting evidence.
- Media materials: Utilization of the trademark in advertising and promotional materials, whether in print, digital or broadcast media, can help establish its ongoing use.

Surrender

18. What is the procedure for surrendering a trademark registration?

The procedure for surrendering a trademark registration in Qatar typically involves submitting a formal request to the Trademark Office. This request should include the details of the trademark registration to be surrendered and the reasons for surrender. Once accepted by the authorities, the registration will be canceled and the mark will no longer be protected.

Related IP rights

19. Can trademarks be protected under other IP rights?

In some cases, a trademark may incorporate a unique and distinctive design element as part of its logo or branding. Qatar, like many other jurisdictions, offers design protection to safeguard the visual appearance of these unique designs. Design protection is typically governed by separate intellectual property laws, specifically those related to industrial designs. To obtain design protection, the owner of the unique design element within the trademark may need to file a separate application for design registration. This registration would cover the visual aspects of the design, such as its shape, pattern or ornamentation, and provide exclusive rights to use and prevent others from copying or imitating the design. However, it should be noted that in practice, the implementing regulations for the design registration is yet to be implemented.

On another hand, copyright protection in Qatar, as in many countries, extends to original creative works, including literary, artistic and certain visual works.

While trademarks primarily serve as source identifiers, they may also include elements of original artistic or creative expression. For example, a logo with an intricate illustration or a tagline with a unique and creative phrase may be eligible for copyright protection. In such cases, the copyright protection would

apply to the creative aspects of the trademark and would be separate from the trademark registration. Copyright protection grants the creator exclusive rights to reproduce, distribute and display their original work.

It is important to note that these additional protections (design protection and copyright protection) are distinct from trademark protection and must be pursued separately through their respective registration processes. Trademark protection primarily focuses on brand identity and the prevention of confusion among consumers regarding the origin of goods and services. In contrast, design and copyright protection centre around safeguarding the visual and creative elements within the trademark.

Trademarks online and domain names

20. What regime governs the protection of trademarks online and domain names?

Protection of trademarks in the online sphere and the regulation of domain names in Qatar are subject to a combination of national laws and international agreements. Qatar, like many countries, is a signatory to international agreements and conventions that govern intellectual property rights, including trademarks. These agreements often provide a framework for the protection of trademarks in the digital environment.

As per Domain Name Regulation: The registration and management of domain names under the (.qa) top-level domain (TLD) are overseen by the Qatar Domain Registry (QDR). QDR has established its own policies and procedures for the registration and administration of (.qa) domain names. These policies include rules for dispute resolution related to domain names, such as cases of cybersquatting or trademark infringement within the domain name space.

The Qatar Trademarks Law extends trademark protection to the online environment. This means that trademark owners have legal recourse to take action against domain name registrations that infringe upon their trademark

rights. If a party registers a domain name that is identical or confusingly similar to an existing trademark and uses it in a way that could mislead or confuse consumers regarding the origin of goods or services, the trademark owner can initiate legal proceedings to protect their rights.

In cases where domain names registered under (.qa) are subject to trademark disputes, QDR may have mechanisms in place for resolving such disputes. These mechanisms may include arbitration or other procedures to determine whether the domain name registration should be transferred or canceled in favour of the trademark owner.

In addition to national mechanisms, Qatar is likely to be part of international domain name dispute resolution systems, such as the Uniform Domain-Name Dispute-Resolution Policy (UDRP) established by the Internet Corporation for Assigned Names and Numbers (ICANN). The UDRP provides a process for resolving disputes related to generic top-level domains (gTLDs) such as .com, .org and certain country-code top-level domains (ccTLDs) if they have adopted the UDRP. Parties can use this mechanism to address domain name disputes that involve trademarks.

LICENSING AND ASSIGNMENT

Licences

21. May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

Recording a licence against a trademark in Qatar is a formal process that solidifies the relationship between the licensor and licensee while ensuring legal recognition of their rights and responsibilities. This process involves submitting the licensing agreement to the Qatar Trademark Office, accompanied by a request for recordation.

The significance of recording a licence extends beyond mere formality. It serves as a protective measure for both parties, safeguarding their respective rights and interests. Furthermore, recordation plays a pivotal role in maintaining the integrity and reputation of the licensed trademark.

A typical licensing agreement incorporates various clauses that define the terms and conditions of the arrangement. These include:

- **Quality control clauses:** Quality control clauses are fundamental elements of the licensing agreement. They establish the standards and criteria that the licensee must adhere to when utilizing the licensed trademark. These standards are essential for upholding the trademark's reputation and ensuring consistency in its use.
- **Scope and geographic territory:** The agreement precisely outlines the scope of the licence, specifying which trademark(s) are subject to the licence and the geographic territory in which the licensee is authorized to employ the trademark. This delineation prevents ambiguity and provides clarity to both parties.
- **Limitations and restrictions:** To maintain the integrity of the trademark, the licensing agreement includes clauses that detail any limitations or restrictions on the use of the trademark. These restrictions may pertain to sublicensing, modifications to the trademark or constraints on its utilization within specific industries or sectors.
- **Responsibilities and obligations:** Clearly defined responsibilities and obligations are delineated for both the licensor and the licensee within the agreement. This includes their commitment to compliance with relevant laws and regulations, ensuring that the use of the trademark remains in accordance with legal requirements.

Assignment

22. What can be assigned?

In accordance with article 21 of the Qatari Trademark Law, the ownership of a registered trademark in Qatar can be assigned or transferred in two primary ways.

With the business

Trademark ownership can be assigned or transferred along with the entire business that uses the mark to distinguish its goods or services. In this case, the trademark is closely tied to the business as a whole. This means that both the trademark and the associated enterprise are transferred together as a package. This scenario typically involves the transfer of goodwill, as the mark is an integral part of the business's reputation and value.

Without the business

Alternatively, trademark ownership can be assigned or transferred independently, without transferring the entire business along with it. In this situation, the trademark is separated from the enterprise. The original owner (assignor or transferor) retains the right to continue using the mark for the goods or services for which it was initially registered. This retention of rights by the assignor or transferor is typically allowed unless there is a specific agreement to the contrary.

Therefore, based on the provided article of law, it is clear that trademark assignments in Qatar can involve both the transfer of the mark with the associated business (including goodwill) or the transfer of the mark alone, depending on the terms of the assignment agreement and the intentions of the parties involved. Other business assets do not need to be assigned to make the trademark assignment valid, as the assignment can focus solely on the trademark itself, with or without the enterprise. The key factor is the agreement between the parties and the specific terms outlined in the assignment documentation.

Assignment documentation

23. What documents are required for assignment and what form must they take? What procedures apply?

The assignment of a trademark must be documented in a written agreement. This written agreement should outline the terms and conditions of the assignment, including the details of the parties involved (assignor and assignee), the description of the trademark being assigned, and any specific terms or restrictions related to the assignment. It must be signed by the contracting parties, that is, the assignor (original trademark owner) and the assignee (new trademark owner). The signatures of the parties are essential to validate the assignment.

If the signatures of the contracting parties cannot be obtained before the relevant officer at the Trademark Office, their signatures must be officially endorsed before the relevant verification authority. This endorsement serves as official confirmation of the parties' agreement to the assignment.

While not explicitly mentioned in the article of law, it is a common practice to have the assignment agreement notarized for added legal validity. Notarization involves having the signatures of the parties authenticated by a notary public, which can provide an extra layer of assurance regarding the authenticity of the document.

Validity of assignment

24. Must the assignment be recorded for purposes of its validity?

According to the article 21 of the Qatari Trademark Law, recording the assignment is not a strict requirement for the validity of the assignment itself. However, recording it is mandatory for enforcement purposes and provide legal recognition and documentation of the transfer of ownership towards third parties. Recording an assignment is essential to establish legal clarity, protect

the rights of the assignee and ensure that the new owner's details are officially recognized.

Security interests

25. Are security interests recognized and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Security interests in trademarks can be recognized in Qatar. These security interests can take various forms, including pledges or mortgages. While notarization is not explicitly required, parties may choose to notarize security agreements for added legal certainty.

Recording security interests is not mandatory for their validity; however, it is required to ensure that the security interest is enforceable against third parties and recognized in the case of disputes.

ENFORCEMENT

Trademark enforcement proceedings

26. What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialized courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Trademark owners in Qatar have multiple legal avenues available to enforce their rights against infringing or dilutive use of their marks. These proceedings encompass civil actions in the courts, administrative actions, and customs enforcement measures. Here is a more detailed explanation of these enforcement mechanisms:

Civil actions in the courts

In Qatar, intellectual property cases, including trademark disputes, are typically handled by specialized judges within the civil courts. While there are no dedicated trademark courts, these judges ask the help of specialized experts who assist the judges and court with the evaluation of infringement or unfair competition.

Trademark owners can initiate civil actions against infringing parties in the Qatari civil courts. This process allows trademark owners to seek remedies such as injunctions, damages and orders for the destruction of infringing goods.

Criminal enforcement

In addition to civil actions, Qatar's Penal Code includes provisions related to trademark infringement, categorizing it as a criminal offence.

These criminal provisions can lead to severe penalties for individuals or entities found guilty of trademark counterfeiting or infringement. Penalties may include substantial fines and imprisonment.

Criminal enforcement serves as a strong deterrent against trademark counterfeiting and piracy, emphasizing the seriousness of trademark infringement in Qatar.

Administrative actions

The Qatar Ministry of Commerce and Industry, specifically the Trademark Office, plays a crucial role in administrative actions related to trademarks.

Trademark owners can file administrative complaints with the Trademark Office, alleging trademark infringement or other violations. The Trademark Office has the authority to take administrative measures, including issuing warnings, fines, or orders for the seizure of counterfeit goods.

Administrative actions offer a streamlined and efficient means of addressing

trademark disputes without the need for a full judicial process.

Customs enforcement

Qatar has established customs enforcement measures to prevent the import and export of counterfeit and infringing goods.

Trademark owners can work closely with Qatari customs authorities to register their trademarks and provide information about genuine products. Customs officers can then monitor and detain suspicious shipments, helping to combat the trade in counterfeit goods at the border.

Procedural format and timing

27. What is the format of the infringement proceeding?

Infringement proceedings in Qatar typically follow a civil format. While specific procedures may vary, they generally involve filing a complaint, presenting evidence, and engaging expert witnesses if necessary.

A specialized judge or panel of judges within the civil courts decides trademark infringement cases.

The duration of trademark infringement proceedings can vary depending on case complexity and court caseload. Typically, proceedings may take several months to a few years to reach a resolution.

As per criminal enforcement mechanisms, it involves reporting the infringement to the public prosecutor, who will initiate an investigation. If there is sufficient evidence, the case may proceed to criminal prosecution.

Burden of proof

28. What is the burden of proof to establish infringement or dilution?

In trademark infringement cases in Qatar, the burden of proof primarily lies with the trademark owner, which means that it is the responsibility of the

trademark owner to provide evidence and establish their case. To be successful in such cases, the trademark owner must demonstrate specific elements.

First, they need to show that there is a likelihood of confusion between their registered trademark and the defendant's use of a similar or identical mark. This likelihood of confusion typically arises when consumers could be misled or confused into believing that the products or services associated with the defendant's mark are connected to or endorsed by the trademark owner.

Additionally, the trademark owner may also need to prove that the defendant's use of the mark is likely to cause harm to the distinctiveness or reputation of their trademark. This means that they must present evidence showing that the defendant's activities, such as unauthorized use or counterfeiting of the mark, are negatively impacting the reputation and uniqueness of the registered trademark.

Standing

29. Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

In Qatar, trademark owners, exclusive licensees who hold the right to enforce, and authorized agents all have the legal standing to pursue remedies when they believe that trademark violations have occurred. This means that they are entitled to take legal action against individuals or entities they suspect of infringing upon their trademark rights.

When we mention 'exclusive licensees with the right to enforce', it implies that not all licensees have the authority to enforce trademark rights. However, if an exclusive licensee has been granted the specific right to enforce trademark protections by the trademark owner, they can also initiate legal proceedings against potential infringers.

These remedies primarily involve civil actions, which can be pursued through

the Qatari judicial system. In civil cases, the party alleging trademark violations seeks legal remedies such as injunctions to stop the infringing activities, damages or compensation for losses incurred, and the potential destruction of counterfeit goods.

Furthermore, in cases where trademark violations are considered criminal offenses, such as counterfeiting or wilful trademark infringement, criminal complaints can be filed. Importantly, both the trademark owner and their authorized representatives, including legal counsel acting on their behalf, can initiate such criminal complaints. These complaints can lead to criminal proceedings, and if the defendant is found guilty, they may face penalties such as fines or imprisonment.

Border enforcement and foreign activities

30. What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

In Qatar, border enforcement measures are available to prevent the import and export of infringing goods. These measures are in line with international standards and agreements related to intellectual property rights protection.

Border enforcement typically involves the collaboration of customs authorities, intellectual property rights owners (including trademark owners) and relevant government agencies. The key measures include recording by the trademark owners their trademarks with the Qatari Customs Department. This recordation allows customs authorities to monitor and detain goods suspected of infringing registered trademarks. When infringing goods are identified at the border, customs officials can detain them, notify the trademark owner or their representatives, and initiate legal actions.

If customs authorities suspect that imported or exported goods infringe upon registered trademarks, they can detain and seize those goods pending further

investigation. The rights owner is then informed, and they can take legal action to enforce their rights.

Subsequently, trademark owners can initiate legal actions, including civil and criminal proceedings, against parties involved in the import, export, distribution or sale of infringing goods. Penalties for trademark infringement can include fines and imprisonment.

Qatar may also cooperate with other countries and international organizations to address cross-border infringement issues. International agreements and treaties facilitate collaboration in combating intellectual property rights violations.

Regarding activities taking place outside the country of trademark registration, it is possible for such activities to support a charge of infringement or dilution in Qatar under certain circumstances. Qatar recognizes the territorial principle, meaning that trademark rights primarily apply within its jurisdiction. However, there are situations where extraterritorial actions can be considered relevant:

- If goods are legitimately placed on the market by the trademark owner or with their consent in another country (parallel imports) and are subsequently imported into Qatar without authorization, trademark owners may argue that this constitutes infringement. The legal status of parallel imports can be complex and may vary depending on the specific facts and legal arguments presented.
- In cases involving online sales, if goods bearing infringing trademarks are available for purchase by consumers in Qatar through international e-commerce platforms or websites, this could potentially be considered as infringing activities within Qatar's jurisdiction.

The legal assessment of such cases would depend on the specific facts and applicable laws. Trademark owners should seek legal advice to address such complex situations effectively.

Discovery

31. What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

In Qatar, the process of obtaining evidence in civil cases, including trademark-related disputes, differs from that in criminal proceedings. Qatar's legal system does not provide for the formal discovery or disclosure mechanisms commonly found in some other jurisdictions, such as the United States.

In civil cases, parties typically rely on their own evidence and arguments to support their claims or defenses. This means that obtaining evidence from adverse parties, third parties or parties located outside the country may not follow standardized discovery procedures commonly seen in countries with more extensive discovery rules.

Instead, parties in Qatar's civil cases are often required to present their evidence and arguments directly to the court during the trial phase. The court may issue specific orders to produce certain documents or evidence if it deems them relevant to the case. However, this process is generally more controlled by the court and may not involve extensive pretrial discovery as seen in some other legal systems.

It is essential to note that the rules and procedures for evidence collection in Qatar's criminal proceedings may differ significantly from those in civil cases. Criminal cases are typically handled by law enforcement authorities, and evidence collection follows specific criminal procedure laws and regulations.

Timing

32. What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on

appeal?

The duration of trademark infringement or dilution actions in Qatar can be influenced by several factors, including the complexity of the case, the current caseload of the courts and other procedural considerations. While it is important to note that these time-frames are provided as a general guideline and may vary from case to case, we can offer a rough estimate to provide some context.

In a relatively smooth proceeding (though without guarantee), the process before the first instance court may typically take between six and eight months. This period encompasses various stages, including case filing, preliminary hearings, evidence submission, trial preparation and the trial itself.

In cases where preliminary injunctions are sought, they can often be obtained relatively quickly, allowing trademark owners to take immediate action to halt potential infringing activities.

However, it is essential to recognize that the timeline can be extended if the case is particularly complex or if there are delays in court proceedings due to factors such as the court's caseload or scheduling conflicts.

Furthermore, in the event that either party decides to appeal a court decision, additional time must be allocated for the appeal process. Before the appeal court, trademark infringement or dilution actions may take up to approximately six months, depending on the specific circumstances of the case and the appellate court's schedule.

Limitation period

33. What is the limitation period for filing an infringement action?

In Qatar, the limitation period for filing an infringement action is not explicitly defined in the Trademarks Law. However, it is advisable to take prompt legal action upon discovering an infringement to maximize the chances of a

successful outcome.

Nevertheless, it should be noted that, although there is no explicit defined limitation period under the trademark law, we should seek the provisions of the civil code, which differ between two limitation period:

- **Three-Year Limitation:** In cases where trademark owners have knowledge of the damages and the person responsible for causing the damage, there is a limitation period of three years from the date when this knowledge is obtained. This means that if trademark owners become aware of the damages caused by trademark infringements and can identify the party responsible for the infringement, they have a three-year window to initiate civil legal proceedings.
- **Fifteen-Year Limitation:** In situations where the damage and the party causing the damage are not known or cannot be reasonably identified, there is a longer limitation period of 15 years. This extended time-frame allows trademark owners to take legal action even when the responsible party or the full extent of the damages is unclear.

In cases where trademark owners intend to pursue criminal proceedings, it is essential to note that the claim should be submitted within one month of becoming aware of the infringement. This requirement underscores the need for swift action in addressing trademark violations through the criminal justice system.

Litigation costs

34. What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The costs associated with trademark infringement or dilution actions in Qatar can vary significantly depending on the complexity of the case, legal representation and court fees. A typical range for litigation costs, including trial

preparation, trial and appeal, may span from several thousand Qatari riyals to tens of thousands or more.

Traditionally, Qatar does not have a system of cost recovery for successful plaintiffs in trademark infringement cases. Parties usually bear their own legal expenses.

Appeals

35. What avenues of appeal are available?

In Qatar, appeals from decisions related to trademark infringement cases can be made to higher courts within the civil judicial system. The Court of Appeal and the Court of Cassation are the main appellate stages available to parties dissatisfied with lower court decisions.

Defenses

36. What defenses are available to a charge of infringement or dilution, or any related action?

In trademark infringement cases in Qatar, there are several common defenses that defendants may employ to challenge the claims made by the trademark owner. These defenses are essential elements of legal proceedings and can significantly impact the outcome of the case. Here, we will elaborate on these defenses.

A primary defence in trademark infringement cases is to argue that there is no likelihood of confusion between the defendant's mark and the plaintiff's mark. This defence may involve demonstrating that the marks are sufficiently distinct or that they are used in different markets or for unrelated goods or services. For instance, if one mark is used for automotive parts, and the other is used for food products, the argument could be made that consumers are unlikely to confuse the two.

Defendants may also assert that their use of the trademark falls within the scope of fair competition. They may argue that they are not attempting to deceive consumers or infringe on the distinctiveness of the plaintiff's mark. Instead, they are engaging in legitimate competition within the same industry or market. This defence can be particularly relevant when both parties are offering similar goods or services.

Another defence is to challenge the plaintiff's trademark rights. Defendants may argue that the plaintiff does not possess valid and enforceable trademark rights in Qatar or that the trademark is merely descriptive or generic. This can involve presenting evidence that the plaintiff's mark has not acquired distinctiveness or that it is commonly used in the industry to describe the goods or services.

In cases where a trademark has become a generic term for a category of goods or services, defendants may assert that their use of the mark is generic and not infringing. They may argue that the mark has lost its distinctiveness and is commonly used to refer to all products or services of that type. This defence can be complex and requires evidence of the generic nature of the mark.

Defendants may also invoke the statute of limitations as a defence. They can argue that the plaintiff's claim is time-barred because it was not filed within the applicable limitation period, typically three years under civil law or within one month for criminal proceedings upon knowledge of the infringement.

Remedies

37. What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

Successful parties in trademark infringement actions may be eligible for a range of remedies, including injunctive relief, damages and the seizure and destruction of infringing goods. Qatar's legal system provides for both preliminary and permanent injunctions.

Monetary relief may include compensation for actual damages suffered by the trademark owner due to the infringement. The calculation of damages can be based on factors such as lost profits or a reasonable royalty.

Criminal remedies: Criminal remedies for trademark infringement can include fines and imprisonment, as provided for in the Qatari Penal Code.

ADR

38. Are ADR techniques available, commonly used and enforceable?

What are the benefits and risks?

ADR Techniques, including arbitration and mediation, are accessible and applicable for trademark disputes in Qatar. These methods provide parties with an alternative means of resolving conflicts outside of the traditional litigation process.

Arbitration and mediation can offer several advantages over litigation, although it is worth noting that, while possible, they are not commonly used in Qatar for trademark infringement or dilution disputes. Nevertheless, here are the key points regarding ADR in Qatar:

- **Flexibility and efficiency:** ADR procedures, such as arbitration and mediation, provide a more adaptable and potentially swifter resolution process compared to traditional courtroom litigation. This flexibility can be particularly advantageous when parties seek a timely resolution of their trademark disputes.
- **Informal nature:** ADR proceedings tend to be less formal than traditional court proceedings. This informality can make it easier for parties to engage in discussions, negotiations and settlement talks in a less rigid environment.

Outcomes reached through ADR processes are legally binding and enforceable in Qatar, provided they are in compliance with local laws and regulations.

While ADR is available and can be a viable option for trademark disputes in Qatar, it is essential to recognize that it is not frequently employed for such cases in practice. Traditional litigation remains the more common avenue for addressing trademark infringement and dilution disputes.

UPDATE AND TRENDS

Key developments of the past year

39. Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

No updates at this time.

** The information in this chapter was accurate as at January 2024.*