

Contributing firm  
**United Trademark & Patent Services**



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### **Legal framework**

Qatar is located on the Arabian peninsula, sharing a border with Saudi Arabia on the south but otherwise surrounded by the Persian Gulf. Although a small state covering approximately 11,437 square kilometres with a population of around 1.54 million, it is an oil-rich country with a gross domestic product (purchasing power parity) of \$95.130 billion and per capita income estimated at \$86,669 – the highest in the world. The country is also a member of the Gulf Cooperation Council.

Qatar is a civil law country which applies *Sharia* (Islamic) law in some aspects of family law, inheritance and certain criminal acts. Trademark matters are governed by the Law on Trademarks, Geographical Indications and Industrial Designs (9/2002), which repealed the earlier Trademarks Law (3/1978).

Qatar is also a signatory to the following treaties and conventions:

- the World Intellectual Property Organization (WIPO) Convention;
- the Paris Convention for the Protection of Industrial Property;
- the Berne Convention for the Protection of Literary and Artistic Works;
- the Nairobi Treaty on the Protection of the Olympic Symbol;
- the WIPO Copyright Treaty;
- the WIPO Performance and Phonograms Treaty; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

The Qatari government has made trademark rights a priority. Rights holders can obtain protection by filing petitions or lawsuits before the Industrial Property Tribunal, as well as the civil and criminal courts. The Trademarks Law protects trademarks that are registered in Qatar. Such marks may include names, signatures, words, letters, numbers, designs, pictures, symbols, stamps, seals, sketches and any

other signs, colors, sounds, smells or combinations thereof, if used or proposed to be used to distinguish products or services offered in the course of business.

As Qatar is a signatory to the Paris Convention, lawsuits may be filed before the courts to enforce rights in well-known trademarks even if they are not registered in Qatar.

### **Controlling contractual relationships with third parties**

Qatar has its own agency and distributorship laws, which can act in favour of local agents. Agency agreements should be executed in writing and then registered to comply with the law. Terminating an agency relationship is not possible unless a major breach of contract has taken place, even if the contract is for a fixed term. In cases where the contract is terminated without mutual consent or proper justification, the ministry, if entitled, may place an embargo on goods and the agent can file a lawsuit for damages and compensation against the principal.

Hence, it is essential to seek assistance from a local attorney when entering into a contractual relationship with third parties.

### Border measures

So far, it has not been possible to record trademark registrations effectively with Qatari Customs. However, if information about counterfeit goods being imported into the country is available and the rights holder has a valid Qatari trademark registration, it may file a complaint before Customs detailing the container number, date of arrival and other pertinent details.

The Trademarks Law does not authorize seizure of goods in transit. Hence, counterfeit goods that are not unloaded in the Qatari territory usually remain beyond Customs' jurisdiction.

### Criminal prosecution

A criminal action in Qatar can be filed by the rights holder's attorney, either directly with the local police or with the public prosecutor. Article 55 of the Trademarks Law states that officers appointed by an order of the minister shall have the status of judicial police for establishing offences that violate the Trademarks Law.

The relevant articles of the Trademarks Law are reproduced below:

*Article 20: The owner of the registered mark shall have the right to prevent third parties from using its mark or any denomination that is likely to deceive the public in respect of the goods or services for which the mark has been registered or similar goods or services.*

*Article 47: Without prejudice to any severer penalty provided for in another law, persons committing one or more of the following acts shall be liable to imprisonment for a term not exceeding two years and to a fine not exceeding QR20,000 or to either of those penalties:*

1. Any person counterfeiting or imitating a registered trademark, trade name, geographical indication or industrial design or model in a manner that is likely to deceive or confuse the public.
2. Any person maliciously making use of a counterfeit or imitated mark, trade name, geographical indication or industrial design or model.
3. Any person fraudulently affixing on or using in connection to his goods or services, a mark, a trade name or a geographical indication belonging to another person.
4. Any person who knowingly sells or

*offers for sale or distributes, or holds for the purpose of sale, goods bearing a counterfeit, imitated or wrongfully affixed or used mark, trade name, geographical indication or industrial design or model.*

5. Any person who knowingly and unlawfully offers services under a registered mark, trade name, geographical indication or industrial design or model.

*Article 48: Without prejudice to any severer penalty provided for in another law, persons committing one or more of the following acts shall be punished by imprisonment for a term not exceeding one year, and to a fine not exceeding QR10,000 or to either of these penalties:*

1. Any person using an unregistered mark in the cases prescribed in paragraphs 2 to 10 of Article 8 of this law.
2. Any person violating the provisions of Articles 30 and 31 of this law.
3. Any person falsely indicating on his goods, services, business papers or other materials any information that might lead to believe that the mark, trade name or industrial design or model has been registered.

*Article 49: In case of recurrence, the penalties provided for in Articles 47 and 48 herein shall be doubled and both penalties of imprisonment and fine shall become inevitable.*

*Article 50: In all cases provided for in Articles 47, 48 and 49 of this law the court shall order the publication of the verdict in one or more daily newspapers at the expense of the convicted party and the closure of the enterprise for a period not less than 15 days and not more than six months, the confiscation of the equipment and material used in the counterfeiting or imitation as well as the confiscation of the counterfeit or imitated products, even in case of the acquittal.*

### Preliminary measures

A complaint can be filed with the Industrial Property Tribunal (the preferred method), local police or the public prosecutor. Filing a complaint usually results in a raid and the confiscation of suspected counterfeits. Once the goods have been seized, the authorities undertake the necessary investigations and the infringers are punished in accordance with the legal provisions set out above. The counterfeit goods seized in the raids are also destroyed.

### Remedies

Remedies that can be sought in a criminal action are as follows:

- raids on the premises where counterfeit goods are stored;
- seizure of goods;
- destruction of counterfeit goods; and
- penalization of the infringer.

### Civil enforcement

The Trademarks Law provides civil remedies for the rights holder in cases where a trademark is infringed by a third party. These can be enforced through filing a lawsuit before the court of competent civil jurisdiction. The relevant articles of the Trademarks Law concerning civil actions are reproduced below for reference:

*Article 46:*

- 1) Any interested person may obtain from the competent civil court, by a petition, an order directing the implementation of the appropriate preventive measures including, in particular, the following:

(a) The establishment of a detailed descriptive inventory of goods manufactured locally or imported, packaging, papers, sign-boards or other articles bearing a counterfeit, imitated or wrongfully affixed or used mark, or any false or unlawful indication, trade name, industrial design or model or geographical indication, as well as a report counting and describing documents or material used in the commitment of any of the aforementioned acts.

- (b) Seizure of articles mentioned in the preceding paragraph, provided that such seizure does not take place until the applicant deposits a security to the office of the court, on the basis of an estimate made by the court to prove the seriousness of the petition and to indemnify the accused when necessary.
- 2) The order of the court could include the appointment of one or more experts to assist in the preparation of the inventory and in implementing the attachment.
- 3) After seizure, the adequacy of the security deposited by the petitioner may be contested by lodging an action before the competent court.
- 4) The preventive measures shall, in all cases, become null and void unless followed by a civil or criminal action initiated against the party in respect of

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- whom the measures were taken within 10 days from the date of the court order.
- 5) The accused may initiate an action for damages when the seizure takes place. The action shall be notified to the complainant and the competent civil court within 90 days from the expiration of the period indicated in the preceding paragraph or after the final dismissal of the complainant's action, otherwise the accused shall forfeit his right to initiate such an action.
- 6) The security is restored to the complainant in the following cases:
- If a final ruling is delivered in his favour.
  - If the period of the 90 days provided for in paragraph 5 of this article elapses and the accused did not initiate an action for damages for the seizure,
  - If a final ruling is passed rejecting the action filed by the accused.

Article 51: Any concerned person may initiate an action in front of the competent civil court to prohibit the continuation of the infringement provided for in Articles 47 and 48 herein or to prevent its occurrence as well as claiming the rightful indemnifications.

Article 52:

- The competent civil court may order the confiscation of the seized products and the closure of the enterprise for a period not less than 15 days and not exceeding six months. The ruling shall be published in one or more daily newspapers at the expense of the convicted party.
- The court shall order the destruction of the counterfeited marks, indications,

trade names or industrial designs or models or the products bearing the aforementioned which unlawfully bear false or illegal indications even in case of acquittal.

### Remedies

The following remedies are available by way of civil actions:

- a precautionary attachment;
- an interim injunction;
- a perpetual injunction and attachment with declaration that the goods are counterfeit;
- the preparation of a list of alleged counterfeit goods and equipment;
- seizure of the counterfeit goods;
- closure of the premises;
- the appointment of an expert;
- a claim for costs and damages; and
- the judgment's publication in newspapers.

### Anti-counterfeiting online

The draft E-commerce Law is now ready and pending approval by the ministry. Although Qatar is adamant about adopting an effective law for online transactions, cybersquatting and phishing, the law is still under consideration. So far, matters related to online transactions, domain name infringement and other issues concerning online intellectual property have been prosecuted under different laws, depending upon the crime.

Domain name infringement matters can also be pursued through a complaint before the WIPO Arbitration and Mediation Centre, whose decisions may be executed before the local domain name registry. In addition, such decisions hold compelling evidentiary value before courts of law.

A lawsuit before the local courts could also be filed to redress the rights of a trademark owner under the copyright and trademark laws. The courts are proactive in providing relief to rights holders and restoring their rights equitably.

### Preventive measures/strategy

While specific strategies should be developed in accordance with the circumstances of the case, the following general principles, among others, should be borne in mind:

- Always file trademark, copyright, design and patent applications.
- Develop a market surveillance programme to monitor the local market. This should keep a watch on retail and wholesale shops, exhibitions, the media, the Internet and trademark publications.
- Conduct annual trademark searches in the relevant classes to monitor the register.
- Publish cautionary notices periodically in widely circulated English and Arabic language newspapers to increase the general public's awareness and to demonstrate the rights holder's active vigilance.
- Conduct annual training programmes for administrative authorities to increase awareness of how to differentiate counterfeits from originals.
- Initiate administrative actions against counterfeits and file oppositions against conflicting trademarks. [WTR](#)



## Biographies

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Essam Shafiq is a member of the United Trademark & Patent Services team. As a Jordanian national, he is a native Arabic speaker and is also fluent in English. Mr Shafiq obtained his law degree from Mu'tah University, Jordan in 1996 and joined the firm in 2000. He handles contentious and non-contentious matters, including drafting patent and trademark applications, and advising in trademark prosecution and infringement cases. Mr Shafiq also handles opposition proceedings and litigation.