

Islamic Public Policy and Morality Principles and Their Effect on Trade Mark Registration
and Protection in the Light of the TRIPS Agreement

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Abstract

This thesis examines the effects of Islamic public policy and morality on trademarks registration and protection under the Islamic legal system. Public policy and morality play an affective role in determining whether or not a trademark can be recognised as such and is one of the important criteria in determining registration. The aim of this thesis is to explore public policy and morality principles that affect trademarks registration and protection in Shariah by using Kuwaiti law as a case study, especially in relation to the trademark forms, product origin and trademark nationality as well as the nature of the product. This thesis looks at how a country that adopts Islamic Shariah, also applies TRIPS provisions dealing with trademarks registration in relation to public policy and morality. The results of this research show that there are various restrictions imposed strictly by the Kuwaiti public policy and morality principles on trademark. This has a direct impact on trademark recognition and protection in Kuwait. The findings provide a better understanding of trademark recognition in Shariah's perspective and the requirements demanded by Islamic Shariah especially of those who deal with strict Shariah jurisdiction countries. The conclusion suggests that trademark in Islamic Shariah are controlled by a number of public policy and morality rules that can be elicited from the primary Shariah sources of legislation, which has a direct effect on the recognition of trademarks. In addition, there is no full harmony between Shariah public policy or morality and some provisions of the TRIPS Agreement regarding the registration of trademarks. However, there might be a possibility of compromise through finding a formula to satisfy both provisions.

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List of abbreviations

BOIP:	Benelux Office for Intellectual Property
CCPA:	The United States Court of Customs and Patent Appeals
CJEU:	The Court of Justice of the European Union
CTMR:	Community Trade Mark Regulation
EC:	European Commission
ECHR:	European Convention on Human Rights
EUIPO:	European Union Intellectual Property Office
EU:	European Union
GCC:	Gulf Co-operation Council
INTA:	International Trade Mark Association
ISIL:	Islamic State of Iraq and the Levant
KU:	Kuwait
LGBT:	Association for Lesbian, Gay, Bisexual, and Transgender Issues
NBC:	National Broadcasting Corporation
OHIM:	Office for Harmonization in the Internal Market
PBUH:	Peace be Upon Him
TMA:	United Kingdom, the Trade Marks Act 1994
TTAB:	Trade Mark Trial and Appeal Board (US)
TRIP:	Trade Related Intellectual Property Aspects
TRIPS:	Trade-Related Aspects of Intellectual Property Rights
UK:	United Kingdom
US:	United States
USPTO:	United States Patent and Trade Mark Office

WIPO: World Intellectual Property Organization

WTO: World Trade Organisation

Glossary of Arabic terms

Adah: traditions

Al-Dhaman: ensure

Al-Elm: knowledge

Al-Khaliq: creator

Allah: It is an Arabic word of rich and varied meaning, used as the proper name for God

Almanfa'aa alammah: public interest

Al-Riba: interest/usury

Al-Rahim: merciful

Alkhair alaam':public welfare

Aql: mind

Assalah alaam: general goodness

Daruriyat: necessity

Din: religion

Fatwa: a legal opinion based on Islamic sources

Fikri: intellectuel

Fiqh: Islamic jurisprudence

Gharar: high risk transactions, *gharar*

Hadith: Sayings and doings of the Prophet Muhammad (PBUH)

Hajiyyat: needs

Haram: unlawful

Halal: lawful/allowed

Haqq: right

Herz: safe place

Hisbah: Islamic institution dedicated to preserve ethical Standards in the market place and beyond

Hifz: protects / preserves

Hukumat al-adl: the government of justice

Hudood: prescribed punishments

Ijma: consensus

Ijtihad: diligence

Imam: highest rank of scholar

Istislah: public interest

Ka'bah: Sacred House

Kitab: book

Khalifa: Muslim ruler

Madhhab: A term used in reference to a particular 'school of thought in Islam

Mafsadah: evil

Mal: property

Malik: King

Makruh: hateful/unbecoming

Manfah: usufruct

Mujtahid: the independent religious scholars

Milkiyyah: ownership

Manfa'ah: benefits

Maqsasid: objectives

Maslahah: interests

Muhtasib: the market inspector

Mustahabb: desirable or recommended

Nasal: lineage

Nfas: life

Qanun: law

Quran: word of God' revealed to the Prophet (PBUH)

Qiyas: analogical reasoning

Sunnah: the path or the method of the Prophet (PBUH)

Surah: Chapter the Quran

Shura: consultation

Tahsinyat: embellishments

Taweed: compensate

Tazeer: Discretionary punishment

Ulama: A Muslim religious scholar who has attained a considerable amount of Islamic knowledge

Ummah: Islamic community

Urf: custom

Wajib: compulsory/obligatory

Zakat: Compulsory alms-giving

Notes

1- Arabic terms are italicized.

2- The romanisation of Arabic letters follows the Dictionary of Islam system but (without diacritics).

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B- International Conventions

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Nice Classification (NCL) established by the Nice Agreement (1957)

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Chapter One

Introduction to Thesis

1.0 Introduction

Trade marks are becoming an increasingly important element in modern economic life. The main reasons for this are due to the huge leap in the value of trade marks in the market and to the essential and substantial functions they offer to traders and consumers as well as the growth in transnational trade.¹ Accordingly, there is an international trend for the unification of trade mark rules in order to have universally defined, regulated and protected provisions.² This has resulted in a number of international agreements. The most prominent and important among them is the Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).³ This agreement is seen as the core of the trade mark regime as it contains the essential rules that govern trade marks, and has been adopted by the 162 member countries of the World Trade Organization (WTO).⁴

Despite these international agreements, there is still a lack of harmony in the understanding and implementation of some rules of trade mark agreements due to variations in the different legal systems of the member states, which has led to different understanding and enforcement.

Countries that have adopted the Islamic legal system are part of this pattern of variable implementation. This is important because there are 57 countries worldwide where the sources and principles of Islamic Shariah influence their legislation and culture.⁵ The contribution of Islamic countries to the global economy was recently estimated to be worth \$4 trillion – a figure that is growing by 15 to 20 percent annually as the population growth

¹ Joanna Szalewski, 'The International Protection of Trade Marks After the TRIPS Agreement' (1998) 9 Duke Journal of Comparative and International 189.

² Lisa Ramsey, 'Free Speech and International Obligations to Protect Trademarks' (2010) 35 The Yale Journal of International 406, 428.

³ Agreement on Trade-Related Aspects of Intellectual Property Rights (Annex 1c, Marrakesh Agreement Establishing the World Trade Organization, signed 15 April 1994). For other international agreements related to trade marks see, for example, Singapore Treaty on the Law of Trade Marks 2006 (27 March 2006); Madrid Agreement Concerning the International Registration of Marks (27 June 1989 as amended 12 November 2007); Trade Mark Law Treaty (27 October 1994). In this context, it is worth highlighting that the Paris Convention is the oldest convention in this field. Paris Convention for the Protection of Industrial Property (20 March 1883, latest revision 28 September 1979).

⁴ WTO, 'Members and Observers' <https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm> accessed 26 June 2016.

⁵ The Organisation of Islamic Cooperation (OIC) (formerly the Organisation of the Islamic Conference) presents itself as the second largest inter-governmental organisation after the United Nations which has membership of 57 states spread over four continents. See OIC, 'About OIC' <oic-oci.org/oicv2/page/?p_id=52&p_ref=26&lan=en> accessed 11 December 2014.

is double that of global growth. This shows the significance of the Islamic economy to global trade.⁶

The Islamic legal system derives its authority from divine sources; and the international treaties and national secular laws should not contradict with these sources. Religious sources may trump secular, and this has particular significance to some types of legal questions, for example, issues of public policy and morality. To make it clear, Islamic Shariah regimes are likely to differ from other trade mark regimes because of the legislation source and nature and content of its rules. Therefore, variation in laws regulating trade marks arising from Shariah rules is not just further variation but fundamentally different in scope and impact, particularly the potential for a conflict between Islamic Shariah rules and international trade mark regulations which may be difficult or even impossible to resolve by reference to treaty language. Consequently, it would be inaccurate to assume that after the Islamic states joined the TRIPS Agreement, Islamic Shariah rules would no longer be relevant to trade mark matters and would not have any influence on the trade mark regimes and practices, especially in relation to the principles of Islamic public policy and morality.

1.1 Importance of the study

Muslims believe that Islamic Shariah is an independent system that relates to all aspects of life. In general, Islamic Shariah rules have a strong influence on the way Islamic countries deal with trade marks and their ability to comply with the requirements set out in international agreements that govern trade marks. Accordingly, it is essential that the international lawmakers of the global trade mark system give Islamic Shariah due consideration in the drafting of trade mark rules, especially if Islamic states are part of this agreement. In addition, an understanding of Islamic Shariah is also required for corporations and legislators that wish to take into consideration Muslim consumers globally because not doing so could seriously undermine how these consumers relate to trade marks. The potential difficulties are compounded by the fact that, despite the importance of the Islamic public policy and morality principles in governing trade marks, intellectually property rights as a subject are still vague and not well-defined partly because they are a relatively new area in Islamic Shariah which is still being developed.

⁶ Dubai Islamic Economy Development Center, 'Dubai: The Capital of Islamic Economy' <iedcdubai.ae/page/view/5/dubai_the_capital_of_islamic_economy> accessed 4 May 2015.

The difficulty in implementation of the TRIPS Agreement in Islamic countries shows the significant need to shed light on trade mark regulations in these countries and on Islamic public policy and morality principles in order to determine the issues related to these principles in relation to Islamic Shariah objectives. It will also help to find ways to deploy them to pin down the trade marks that are compatible or incompatible with Islamic Shariah rules. In addition, there is an absence in the literature in evaluating the way in which Islamic countries comply with Islamic public policy and morality in relation to international commercial law, especially in respect to trade marks and the direct effect this has on the registration and protection of these by their legal systems. Also, if there is a fundamental incompatibility in this matter, particularly in relation to the effect of the trademark form, product origin and trade mark nationality on trade mark recognition under the Islamic legal system, this may affect the international obligations of the Islamic countries under TRIPS provisions which may lead to these countries not fulfilling their international obligations. In such uncertainty, it is critical to clarify the relationship between Shariah and the Western legal model that underlies TRIPS (for the purposes of the thesis, the terms ‘Western’ refers to the EU, US and UK).

Therefore, in this context, the thesis aims to examine whether the current practices of the Islamic countries, such as Kuwait, that strictly follow Islamic Shariah rules, are compatible with the TRIPS provision relating to trade marks in general and in using the principles of public policy and morality as a ground to reject trade mark registration in particular. In addition, it seeks to propose compromise solutions for the international obligations of Islamic countries under TRIPS and their Islamic public policy and morality principles in respect to trade mark registration and protection.

1.2 Research questions

The main research question is whether or not Islamic Shariah public policy and morality principles are seen as an obstacle for the Muslim countries to meet TRIPS requirements in relation to trade mark recognition and protection. In order to answer this question, the following subset research questions have been carefully selected:

- 1- What is the position of Islamic Shariah rules in relation to the modern concept of trade mark set by the TRIPS Agreement?

- a. How does Islamic Shariah see intellectual property rights in general? Does the basic Islamic Shariah provision recognise, regulate and protect the different modern forms of trade mark?
- 2- What are the Western and Islamic public policy and morality principles and their effect on trade mark recognition?
 - a. What are the Western public policy and morality principles? What is the approach of the Western legal system in the refusal of trade mark registration on grounds of public policy and morality?
 - b. What are the themes and concepts of the Islamic public policy principles and the Islamic public morality principles? What is the relation between them?
 - c. What is the importance and the role of the Islamic public policy and morality principles in relation to trade mark?
- 3- What are the major similarities and differences between Western and Islamic public policy and morality in regards to trade mark registration and protection?
- 4- To what extent do the Islamic countries' approach to refuse trade mark registration on grounds of public policy and morality comply with the provisions of TRIPS?
 - a. What are the different applications of public policy and morality as grounds for refusing trade mark registration in Islamic countries in the light of the TRIPS provisions? Is it possible for Islamic countries to find a balance between their international obligation under TRIPS and the Islamic public policy and morality principles?

1.3 Relationship with literature and originality

From reviewing the literature that looks at Islamic intellectual property rights, it is clear that the amount of literature that discusses this subject, and in particular trade marks within Islamic Shariah, is relatively small. This lack of literature can be seen as a result of these subjects being relatively new for Islamic jurisprudence.

The earlier academic works dealing with intellectual property rights in their modern sense appeared at the end of the last century and were the product of a very limited number

of scholars (eg Dereini,⁷ Al-Bouti,⁸ Al-Farfoor,⁹ Annashmi¹⁰). These sought to investigate the Islamic Shariah perspective of these rights. In general, these works concluded that Islamic Shariah recognized and protected all types of intellectual property types as they are considered *mal* (property).

The subsequent academic research in this field has reached similar conclusions which demonstrates that Islamic Shariah acknowledges and regulates these rights.¹¹ Researchers use slightly different approaches in dealing with this subject, for example, some of them studied the subject from a historical and cultural perspective.¹² However, researchers commonly focus on the general Islamic vision of the concepts of Islamic Shariah rules in relation to the main elements that intellectual property consists of: '*fiker*' (intellectual), '*milkiyyah*' (ownership), '*mal*' (property) and '*haqq*' (right).¹³ Nevertheless, the vast majority of these studies have covered intellectual property in the Islamic jurisdiction in general while very little has been written on the Islamic vision of the trade mark.¹⁴ Of significance here is the research by Al-Mansour.¹⁵ Al-Mansour's thesis addresses the concept of trade marks and their regulation and protection within the provisions of Islamic Shariah. However, there are several observations to be made in respect of his thesis such as that it was primarily concerned with Saudi Arabia trade marks law and did not consider trade marks in the international context, especially the TRIPS Agreement. In addition, significant

⁷ Fathi Dereini, *Haqul Ibtikar fi al-Fiqh al-Islamy Almuqaran* (2nd edn, Dar Al- Risale 1981).

⁸ Muhammad Bouti, 'Al-Hoqouq al-Ma'nawiyah: Haqq-ul Ebda'a-ul Elmy wa Haqq-ul Esm Altijaari' (1988) 5 Journal of Islamic Fiqh Academy 2397.

⁹ Mohamed al-Farfoor, 'Qasim al-Monakashat' (1988) 5 Journal of Islamic Fiqh Academy 2543.

¹⁰ Ajeel Annashmi, 'Al-Haqq al-Ma'anawy: Al-Esm al-Tejaari' (1989) 13 Kuwait University Journal of Shariah and Islamic Studies 281.

¹¹ See, for example, Mohammed Murad, *Hemayat al-Milkiyyah al-Fikriyah min al-Manthour al-Islamy* (Kitab Al Riyadh 2003) 110; Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyah' (Iktisad al Islami, Umm Al-Qura University, Saudi Arabia, May 2005); Silvia Beltrametti, 'The Legality of Intellectual Property Rights under Islamic Law' (2010) The Prague Yearbook of Comparative Law; Bashar Malkawi, 'The Alliance Between Islamic Law and Intellectual Property: Structure and Practice' (2013) 10 Thomas Law Journal 618.

¹² See, for example, John Carroll, 'Intellectual Property Rights in the Middle East: A Cultural Perspective' (2001) 11 Fordham Intellectual Property, Media and Entertainment Law Journal 555.

¹³ See, for example, Hassan al-Amin, 'Bai' Esm al-Tijaari wa-Tarrkhees' (1988) 5 Journal of Islamic Fiqh Academy 2495; Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyah' (Iktisad al Islami, Umm Al-Qura University, Saudi Arabia, May 2005); Ali Al-Milkiyyah al-Fikriyah fi Mizan al-Maqased (Dirasah Muqaranah)' (2008) 3 Kuwait University Journal of Law 265; Ida Madieha Bt. Abdul Ghani Azmi, 'Intellectual Property Laws and Islam in Malaysia' (PhD thesis, Queen Mary University, 1995).

¹⁴ See, for instance, Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, 'Distinctive Signs and Early Marks: Europe, Africa and Islam' (1997) 1 Perspective on Intellectual Property 123; Amir Khoury, 'Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trade Marks' (2013) 43 The Journal of Law and Technology 151.

¹⁵ Mansour al-Mansour, 'Al-Alamatu Attejariyah wa Ahkamuha fi al-Fiqh wan-Nizam' (DPhil thesis, Imam Muhammad Ibn Saud Islamic University, 2002).

developments have occurred in the field of trade mark jurisprudence and regulations since 2002, for example, the approval by the Gulf Co-operation Council (GCC) Supreme Council of the Unified Trade Mark Law in 2012.¹⁶ This may require some of Al-Mansour's research findings to be revisited. There are other written works that address the relation between Islamic Shariah rules within TRIPS. However, these studies are general and do not give specific attention to trade marks in particular.¹⁷

Originality

The significant contribution of this thesis is to fill a gap in the knowledge regarding the relationship between the Islamic Shariah perspective on trade marks and the TRIPS regime. It pays special attention to the role of Islamic public policy and morality principles in respect to trade marks and their impact on the obligations Islamic member states need to meet in order to comply with TRIPS requirements. This thesis studies the recognition and the protection principles of trade marks as addressed in the TRIPS Agreement in light of Islamic Shariah sources and fundamental objectives.

A detailed discussion of the Islamic Shariah perspective on the different forms of trade mark set out in TRIPS will be given. It will explore the rules of protection that may be applied on trade marks within the Islamic legal system. Furthermore, it looks at the determinants of the Islamic public policy and morality principles that governed trade mark, their effect on the recognition and protection, and how they can affect the international obligations of the Muslim countries under the TRIPS regime.

The importance of this thesis is in the way it seeks to uncover the specific principles of Islamic Shariah that will assist in determining the Islamic rules required in order to acknowledge trade marks and identify the points of conflict which will result in the refusal of trade mark protection under the Islamic legal system. In addition, it offers a comprehensive and critical review of Islamic public policy and morality that governs trade mark through a comparative analysis with the Western approach on this matter. Also, the objective of the thesis is to present workable solutions which find a balance between Islamic

¹⁶ The GCC Trade Mark Law No 33 of 2012.

¹⁷ David Price, *The Development of Intellectual Property Regimes in the Arabian Gulf States: Infidels at the Gates* (Routledge 2009); Chad Cullen, 'Can TRIPS Live in Harmony with Islamic Law? An Investigation of the Relationship Between Intellectual Property and Islamic Law' (2010) 45 Science and Technology Law Review; Ezieddin Elmahjub, 'Protection of Intellectual Property in Islamic Sharia and Development of the Libyan Intellectual Property System' (PhD thesis, Queensland University of Technology, 2014).

rules and the requirements of the TRIPS Agreement in respect to the provisions of registration and protection of trade marks. Furthermore, the intention is to develop clear legal criteria to enable compatibility of trademarks with the provisions of Islamic Shariah.

Due to the small amount of literature that relates to this subject, this research can be considered as a primary source for researchers who wish to conduct research in this area.

1.4 Methodology

This study primarily undertakes an examination of the way in which the sources and objectives of Islamic Shariah interact with the subject of trade marks. In particular, it examines the Islamic Shariah rules in terms of theory and practice to ascertain the optimal approach for choosing a particular trade mark from an Islamic perspective while at the same time taking account of the international regulation of trade marks.

The methodologies chosen for this research study are a critical literature review and a comparative analysis. These consist primarily of the analysis of documentary sources which are available in the public domain. The principal documentary sources used in this study consist of published legislation, court rulings, treaties and decisions of well-known and highly respected Islamic institutions in the world.¹⁸ However, some primary sources used in this study are unpublished such as ministerial decisions and unreported cases which were obtained during the course of this study. Concerning the main sacred works, the Quran is consistently referred to through the translation by Saheeh International.¹⁹ As for the Hadiths (statements of the Prophet peace be upon him (PBUH)), the English translation of the six major ones known as ‘the Accurate Six’ will be relied upon.²⁰ In addition, this study has used secondary sources including books, academic articles and conference papers. With regard to analysis of the concepts and issues relating to Islamic Shariah, the classical works constitute the main reference points of the study. Also, more recent and contemporary works of modern scholars have been used throughout this research. This research will be using the term ‘Islamic Shariah’ or ‘Shariah’ interchangeably in order to generally refer to primary

¹⁸ For example, The International Islamic Fiqh Academy, The General Presidency of Scholarly Research and Ifta and The Department of the Ministry of Awqaf and Islamic Affairs in Kuwait.

¹⁹ Saheeh International, *The Quran* (3rd edn, Al-muntada Al-Islamy Trust 2010)

²⁰ Muhammad Bukhari, *Sahih Bukhari* (Muhammad Khan (tr), Darussalam 1997); Muslim ibn al-Hajjaj, *Sahih Muslim* (Nasiruddin al-Khattab (tr), Darussalam 2007); Hafiz Abu Dawud, *Sunan Abi Dawood* (Nasiruddin al-Khattab (tr), Darussalam 2007); Hafiz At-Tirmidhi, *Jami Al-Tirmidhi* (Abu Kalliy (tr), Darussalam 2007); Hafiz An-Nasai, *Sunan An-Nasai* (Nasiruddin al-Khattab (tr), Darussalam 2008); Mohammed al-Qazwini, *Sunan Ibn Majah* (Nasiruddin al-Khattab (tr), Darussalam 2007). In addition, I translated relevant sources not contained in this collection.

and supplementary sources. Meanwhile, detailed referencing will be given for sources that the evidence is derived from. In addition, the study distinguishes between the opinion of classic and modern scholars by clearly stating that the researcher, in a specific matter, is referring to classical Shariah sources and principles or to the modern interpretation or application of such principles.

The research methodology in this research is used on the four different types of legal regimes, namely the TRIPS Agreement, Western legal system, Islamic Shariah and Kuwaiti legal system. This can be divided into two groups: international (TRIPS Agreement/Western) legal system and Islamic/Kuwaiti legal system.

In terms of the international legal system, the methods employed are based upon legal analysis of key provisions that govern trade mark in the TRIPS Agreement and Paris Convention. The relevant rulings of the Panel of the Dispute Settlement Body of the WTO and the literary works that discuss this topic will also be reviewed closely.²¹

On the other hand, the Western legal system will be presented mostly but not exclusively by cases and legislation from the EU²² as well as other similar legal systems, in particular the US²³ and UK,²⁴ and secondary sources including critical literature.²⁵ The reason for this choice is that the EU consists of a large number of countries (number of members states reaching 28) that share similar legal systems which explicitly takes into account the TRIPS provisions for trade marks.²⁶ Consequently, the EU cases can be seen as applications of these provisions. There is also an abundance of case law and literature covering this topic.

²¹ For example, Michael Blakeney, *Trade Related Aspects of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement* (Sweet and Maxwell 1996); Nuno Carvalho, *The TRIPS Regime of Trade Marks and Designs* (Kluwer Law International 2006); See Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (3rd edn, Sweet and Maxwell 2008); Antony Taubman, Hannu Wager and Jayashree Watal, *A Handbook on the WTO TRIPS Agreement* (Cambridge University Press 2012).

²² Directive (EU) No 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1; Regulation 2015/2424 (EU) of the European Parliament and of the Council of December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L341/21.

²³ Trademark Act of 1946 (codified and amended at 15 USC § 1052 (2006)).

²⁴ UK Trade Marks Act 1994.

²⁵ For example, Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 813; John McCarthy, *McCarthy on Trademarks and Unfair Competition* (Thomson-Reuters-West 2005); Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2005); Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008).

²⁶ See, for example, Directive (EU) No 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1, para 41.

Use of the Western legal system in this study will serve to provide us with a broader understanding of TRIPS provisions and their applications, as well as comparisons on some specific points which can further emphasise the objectives of the thesis. In addition, it will be beneficial to build upon identifying the way to apply the exception set out in TRIPS to reject trade mark registration on grounds of public policy and morality as the concepts of public policy and public morals in the EU (as well as the US and the UK) are identical to those set out by the Panel of the Dispute Settlement Body of the WTO.²⁷ The methodology of this study in terms of Islamic Shariah is heavily dependent on the review of both classical and modern texts. The major challenge of this area of study, however, is the lack of literature and thorough discussion on various subjects relating to trade mark in particular and intellectual property in general in Islamic jurisprudence. Furthermore, there are no direct rules in the primary Shariah sources or in the classic Shariah texts that govern this area in the law. This lack of literature also affects discussion on in-depth theories of public policy and morality in the Islamic Shariah as well as in the contemporary legal thought. All this has produced another problem, that of defining and understanding the main concepts of Islamic public policy and morality. This is a direct result of closing the door of *ijtihad* (diligence) for a long period of Islamic history where *taqlid* (intellectual stagnation) was dominating. This, as a result, has led to blindly follow the traditional opinions of *fiqh* institutions' without critically questioning these opinions. However, in the 18th century, Muslim thinkers such as Muhammad Abduh revived diligence.²⁸ Abduh led the way for modern scholars such as, Fathi Dereini, Mustafa Zarqa, Muhammad Al Bouti and Yusuf Qaradawi to produce opinions on how the classical Shariah principles can be adapted to be applied in the modern world.

Therefore, in order to cover the lack of specialised studies on the topic of trade mark in the Islamic legal system, the methods employed in this study are based on examining the main principles of the core sources of Islamic Shariah, the Quran and the Sunnah in particular, as well as the views of the most important classic²⁹ and modern³⁰ scholars

²⁷ Panel Report, 'United States-Measures Affecting the Cross-Border Supply of Gambling and Betting Services' (10 November 2004) WT/DS285/R.

²⁸ See Othman Amin, *Rayid Al-Fikr Al-Misri: Muhammad Abduh* (al-Majlis al-Alá lil-Thaqafah 1955) and see also Arshia Javed and Muhammad Javed, 'The Need of Ijtihad for Sustainable Development in Islam' (2011) 8 IIUC Studies

²⁹ For example, Abu Hamid Ghazali, *Ihya Ulum al-Din* (Kiryata Fotra 1957); Ahmed Ibn Taymiyya, *Majmoua al-Fatawy* (Qurtuba 1969); Ibrahim Shatibi, *Muwafaqat fi Usul al-Shariah* (Al-Maktaba al-Kobra 1975); Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin* (Dar ibn al-Jawziyy 2002); Shihab al-Din al-Qarafi, *Al-Furuq* (al-Resalah 2003).

³⁰ For example, Muhammad Bouti, *Zawabit al-Maslahah fi Shariah al-Islamiyyah* (Reasalah 1979); Yusuf al-Qaradawi, *Halal and Haram Fi al-Islam* (13th edn, Islamic Library 1980); Fathi Dereini, *Haqul Ibtikar fi al-*

regarding subjects which do not necessarily directly relate to the research topic under discussion. These findings will be applied to the context of trade mark subject matter in the modern sense so as to examine it according to provisions set by Islamic Shariah and to qualify it accordingly.

In cases where different jurisprudential opinions exist between the different scholars, and where too many different views exist, which makes it prohibitive to present them all, this study will employ a selective approach based on the most dominant opinions in the subject matter. Evidence for them will then be discussed which will enable the preferred one to be selected for further discussion. However, this research will discuss all existing scholarly opinions that address trade mark issues in relation to Islamic teachings as well as the contemporary concept of trade marks set out in the TRIPS Agreement.

The thesis will use Kuwaiti law as a case study to determine how a country that has adopted Islamic Shariah can also apply TRIPS provisions. Kuwait was chosen because, firstly, there is a modern³¹ and well-defined legal system which can be compared to Western institutional structures. Secondly, Kuwait strictly applies Islamic Shariah laws, according to the Kuwaiti Constitution, the core of the Kuwaiti legal system and the state culture is based upon Islamic Shariah. The second article of the Constitution states that the religion of the state is Islam and that Islamic Shariah is a main source of legislation. Many of the Kuwaiti laws have referring to the importance of respecting the Islamic Sharia rules in general and the Islamic public policy in particular.³² In addition, the vast majority of the Kuwaiti population are Muslims. In the same context, in order to preserve the Islamic identity of the society, the Kuwaiti law prohibits the granting of the Kuwaiti citizenship to non-Muslims.³³ Kuwait is the first GCC countries to adopt a modern trade mark law which refers to public policy and morality as the grounds for refusing trade marks if they are contrary to those principles.³⁴

Fiqh al-Islamy Almuqaran (2nd edn, Dar Al- Risale 1981); Mohammed Abu Zahra, *Usul al Fiqh al Islamy* (Dar al-Fikr al-Araby 1996) and Mohammad Ashour, *Maqasid al-Shariah* (Dar al-Kitab Almasri 2011).

³¹ The Kuwaiti legal system is based on the separation between authorities with cooperation between them. This is stated in Article 50 of the Constitution. Also, Article 163 confirmed that the judge is free in his decision and that it is not allowed to interfere in the course of justice and that the judges are independent and are not subject to any body whatsoever. In addition, the Kuwaiti legal system includes a variety of modern legislations. One of these is the Civil and Commercial Procedure No 38 issued in 1980 which regulates judicial authority in Kuwait regarding the litigation procedures, the shape of courts and their stages and their authority. However, this Act was amended (and is still being amended) and developed to follow modern legal systems.

³² For example, Law Banning the Import of Goods with Verses of the Quran printed on Them. Ministerial Decree No 16 2012.

³³ Kuwait Nationality Law No 15/1959. Article 4, Paragraph 5.

³⁴ Kuwaiti Trade Law No 2 of 1961.

Kuwait is also a member state of a number of Islamic international organisations, which has a direct effect on the Kuwaiti national legal system. In addition, it is a member of the GCC along with five other Islamic countries namely, Bahrain, Oman, Qatar, Saudi Arabia and the United Arab Emirates. The GCC has issued the GCC Unified Trade Mark Law which is used to unify trade mark provisions across all the GCC states.³⁵ Therefore, studying Kuwaiti trade mark law will provide an indicative understanding of all six countries in the GCC and to determine the characteristics of the principles of public policy and morality that have an important effect on trade mark registration in the countries adopting Islamic Shariah rules.

There are four key stages in this thesis. The first stage involves a review of the Islamic literature and the decisions of well-known Islamic institutions in respect to the position on recognition and protection of trade marks addressed in the TRIPS Agreement. The second stage will try to provide a thorough understanding of the public policy and morality principles and concepts and its applications regarding trade mark registration and protection. This will be done through a comparative approach method of Islamic and Western legal systems. The comparison focuses on the key differences and similarities between the two systems regarding the registration and the protection of trade marks in the light of the principles of public policy and morality. This includes a focus on the substantial reasons, whether legal or factual, for such differences and what this comparison reveals about the relationship between TRIPS requirements and Islamic Shariah.

The third stage will evaluate the compatibility between Islamic Shariah rules and TRIPS provisions. It will assess the extent to which Islamic Shariah public policy and morality rules comply or deviate from the obligatory requirements under TRIPS. This will be achieved by analysing the applications of public policy and morality as grounds for refusing trade mark registration in Islamic countries. The final stage will propose a compromise solution between the international obligations of Islamic countries under TRIPS and their Islamic public policy and morality principles in respect to trade mark registration and protection.

1.5 Scope and limitations of the study

The scope of this research is to investigate the Islamic Shariah perspective on the different forms of trade mark, the effects of Islamic public policy and morality on trade mark

³⁵ The GCC Trade Mark Law No 33 of 2012.

registration and protection, and the factors that serve this investigation. This study, therefore, focuses on the main provisions relating to trade mark in the TRIPS Agreement as well as the Paris Convention, particularly in relation to trade marks that were referred to by the TRIPS Agreement.

The Kuwaiti legal system will be used to present the Islamic perspective on trade marks. However, there is a lack of judicial cases in some areas. Therefore, in order to cover the lack of Kuwaiti cases, some cases from other Muslim countries with similar legislations will be used in the study.

There are a number of other hurdles to be overcome. The definition of some legal terms in relation to trade marks in Islamic Shariah have not been sufficiently clarified or put into a contemporary legal form. Further, there is a lack of detail in Islamic scholarly opinions with respect to trade marks as the debate is often around intellectual property rights in general, without much regard to the considerations of differentiating between the types. In Kuwait, it can be stated that a literature discussion pertaining to trade mark is almost non-existent. The same limitation of the lack of literature relating to public policy and morality in the Kuwaiti legal system is also true. However, some of the literature has referred to these subjects in general without deep analyses or investigations of their concepts or elements.

This is due to two main reasons: (1) the modern Kuwaiti legal system is new; (2) intellectual property issues there are considered new subjects. Added to that, the size of the Kuwaiti judicial system is very limited in terms of numbers (around 450 judges and prosecutors in total).³⁶ These limitations as well as others such as the lack of court cases in this field were mitigated by looking at the existing Islamic legal opinions and court cases on this subject. Documentations from other different legal bodies, lawyers and trade mark specialists as well as data from other public domains from around Kuwait and other Islamic countries were also considered.

1.6 Study structure

This thesis is divided into nine chapters. This structure has been carefully chosen in order to serve the thesis arguments and objectives.

The primary aim of Chapter Two is to understand trade mark concepts from the perspective of contemporary law. It introduces the key trade mark concepts and its definition

³⁶ Al-Watan, 'Amn we Mahakim' (Kuwait, 1 September 2012) <<http://alwatan.kuwait.tt/articledetails.aspx?id=221791>> accessed 5 May 2015.

in the TRIPS Agreement. This involves examining some special types of marks; their origin, development and functions. The main principles of TRIPS and its common exceptions are explored.

Chapter Three seeks to provide an overview of the main Islamic law sources as well as analysing and evaluating the position of the rules concerning intellectual property rights. The first part of this chapter provides basic information on Islamic Shariah. It introduces its main concepts and gives a brief account of Islamic Shariah definitions and main sources. The second part evaluates classical and modern Islamic jurisprudence as well as decisions of different Islamic institutions regarding the adaptation of Islamic Shariah to intellectual property rights.

Chapter Four moves from the general enquiry of the previous chapter to a more focused examination of trade mark within Islamic Shariah. This chapter sets out on a historical investigation to explore the first eras of Islam in order to understand the position taken by early Muslims on primitive trade mark elements and forms under Islamic Shariah. A variety of modern Muslim scholars' opinions relating to trade marks are presented. The research then considers trade mark infringement and the methods used to protect trade marks for both the consumer and the owner under Islamic Shariah. The concept of both criminal and civil liability and penalties are presented. This then allows the applicable penalties for trade mark infringement in Islamic Shariah to be determined.

In order to understand the principles of public policy and morality that affect trade mark under the TRIPS Agreement, Chapter Five is an exploration of public policy and morality principles from the perspectives of the two different legal systems: international law and Western law. The chapter will focus on the two main international agreements that deal with the principles of public policy and morality as reasons to reject trade mark registration; these are the Paris Convention and the TRIPS Agreement. The second part provides an overview of Western public policy and public morality which includes (a) the expressions 'public policy' and 'public morality'; (b) the concept of public policy and public morality; and (c) the role of public policy and public morality. In addition, there will be an analysis of the key law cases which include the main rules governing the relationship between trade mark and the principles of public policy and morality.

Chapter Six aims to explore the Islamic public policy and public morality principles and to determine whether a trade mark is acceptable in Islam, using the Kuwaiti case law as means to do that by analysing (a) public policy in Islamic Shariah; (b) public morality in Islamic Shariah; (c) the role played by *al-maslaha* theory in determining the Islamic public

policy and morality principles in general and its effect on trade mark recognition in particular. The chapter will then illustrate the concepts of Kuwaiti public policy and morality principles and their relation to Islamic Shariah provisions. Finally, the chapter integrates the theoretical concepts of Islamic public policy and morality and their applications in the Kuwait legal system in respect to trade mark registration.

In the light of previous chapters, Chapter Seven seeks to discover the extent that Western and Islamic public policy and morality principles are compatible and the role the principles play in trade mark registration and protection. This chapter discusses the differences and similarities between the Western and the Islamic legal systems in regard to using public policy and morality principles as grounds for refusing trade marks. In addition, the chapter highlights the specification, advantages and disadvantages of both the Western and Islamic approach in this regard.

Chapter Eight discusses the key impacts of membership of TRIPS on the Islamic countries. The chapter also explores potential conflict between Islamic trade mark law, the TRIPS provisions and the Islamic Shariah rules in regards to public policy and morality as grounds for refusing trade mark registration. Moreover, the chapter seeks to determine the major conflict between Islamic public policy and morality and the mandatory provisions of TRIPS regarding trade mark registration. This conflict can be seen as an obstacle for the Muslim countries that follow Islamic Shariah rules strictly to fulfil their obligations within TRIPS. Finally, the chapter suggests possible solutions to overcome these difficulties in order to create a sort of balance between the principles of Islamic public policy and morality and the requirements of the TRIPS Agreement.

Chapter Nine reviews the main findings and offers recommendations in order to highlight the position of Muslim countries on TRIPS obligations in respect to trade mark registration. This chapter will also give some suggestions for further research in the future.

Chapter Two

The Rules Governing Trade Mark in TRIPS Agreement

2.0 Introduction

In order to gain an understanding of the main principles relating to trade marks addressed in the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPS),³⁷ it is important to set out the substantial concepts of trade marks and the main obligations under the Agreement.

Therefore, this chapter begins with a brief background on the development of trade marks and explains the central principles and obligations of the TRIPS Agreement. Then, it moves on to provide an overview of the TRIPS definitions and an illustration of the main forms of traditional and non-traditional trade marks. The chapter also includes an explanation of the justification and the key functions of trade marks, and a summary of the basic legal rights of trade mark owners under TRIPS.

2.1 Background of trade mark development

At the end of the nineteenth century, legislation in various jurisdictions started to pay more attention to enacting and setting down rules and provisions to regulate and protect intellectual property rights in their different fields, for example, industrial property and copyright.³⁸ This protection provides the owner of the rights with a sense of security as to their intellectual inventions, writings, innovations and their financial investments in the field of intellectual property, especially in the countries that acknowledge these rights and legally protect them.³⁹ According to Rogers and others, recognition and regulation in the modern

³⁷ Agreement on Trade-Related Aspects of Intellectual Property Rights (Annex 1c, Marrakesh Agreement Establishing the World Trade Organization, signed 15 April 1994).

³⁸ See Justin Hughes, 'A Short History of "Intellectual Property" in Relation to Copyright' (2012) 33 *Cardozo Law Review* 1293, 1340; Fritz Machlup and Edith Penrose, 'The Patent Controversy in the Nineteenth Century' (1950) 10 *Journal of Economic History* 1, 3; Rami Olwan, *Intellectual Property and Development: Theory and Practice* (Springer 2013) 36; Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 5.

The WIPO Convention, the constituent instrument of the World Intellectual Property Organization (WIPO), was signed at Stockholm on 14 July 1967, entered into force in 1970 and was amended in 1979. Art 2 (viii) defines the term 'intellectual property':

'Intellectual property' shall include the rights relating to: literary, artistic and scientific works, performances of performing artists, phonograms, and broadcasts, inventions in all fields of human endeavour, scientific discoveries, industrial designs, trademarks, service marks, and commercial names and designations, protection against unfair competition, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields'.

³⁹ Cornish, Llewelyn and Aplin state that 'Intellectual property protects application of ideas and information that are of commercial value.' See William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property:*

legal system of trade marks began in the late 18th and early 19th centuries when a number of European countries and the United States issued legislation to protect trade marks.⁴⁰ Nevertheless, trade marks are not a new concept; they go far back into ancient history with excavations revealing that Egyptian, Chinese, Roman and Greek manufacturers used trade marks as well.⁴¹

Originally, a trade mark was created to indicate ownership of the goods bearing a mark.⁴² Diamond states that in the late Middle Ages the trade mark was used to ascribe the goods to their producer or maker. Later on, it was also used as a means to prove the ownership of the goods in case of theft or accidents.⁴³ This discriminatory function of trade marks has developed through time to provide a way to distinguish those goods from similar ones in the market.⁴⁴

The definition and concept of a trade mark and its functions has changed over time.⁴⁵ However, the fundamental element of a trade mark is that the sign is a distinguishing

Patents, Copyright, Trade Marks and Allied Rights (8th edn, Sweet and Maxwell 2013) 6. According to Bently and Sherman, in the 16th century the courts began to recognise legal principles in dealing with and protecting marks. Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 713.

⁴⁰ For example, Rogers states that the first modern regulation of trade marks was in England in 1783. In 1838, the English Courts began to take a clear position against trade mark infringement. Around the same time, other European countries and the United States issued trade mark legislation. See Edward Rogers, 'Some Historical Matter Concerning Trade-Marks' (1972) 62 *Michigan Law Review* 239, 251. An additional example, according to Trefigny is that in 1875 France issued the first integrated trade mark legislation. Pascal Trefigny, 'Types of Signs' in Paul Lange (ed), *International Trade Mark and Signs Protections* (Reemers 2010). See in general, Benjamin Paster, 'Trade Marks-Their Early History' (1969) 59 *Trade Mark Repots* 551; Rex Brown, 'The Effect of the European Common Market on Trade Mark' (1959) 49 *The Trademark Reporter* 515, 527; Lionel Bently, 'From Communication to thing: historical aspect of the conceptualization of trade mark as property' in Graeme Dinwoodie and Mark Janis (eds), *Trade Mark Law and Theory* (Edward Elgar 2008).

Note that, trade mark registration system started for the first time in England in 1875. Justice Dean, 'Modern Problems in the Law of Trade-Marks' (1954) 44 *The Trademark Reporter* 107, 109.

⁴¹ For example, Greek pottery dated from 800 to 400 BC has been found with inscriptions of the name of the maker and decorator. Edward Rogers, 'Some Historical Matter Concerning Trade-Marks' (1972) 62 *Michigan Law Review* 239. However, others argue that the history of trade marks goes even further back to 5000 BC, i.e. to the Stone Age. See Gerald Ruston, 'On the Origin of Trade Mark' (1955) 45 *The Trademark Report* 127, 128.

⁴² See John McCarthy, *McCarthy on Trade Marks and Unfair Competition* (Chapter 5, Thomson-Reuters-West 2005); Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Mark* (Columbia University Press 1925) 19; William Browne, *Law of Trade Marks and Analogous Subjects: firm-names, business-signs, good-well, and labels* (Press of John Wilson and Son 1873) 4.

⁴³ See Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Mark* (Columbia University Press 1925) 19, 37.

⁴⁴ According to McKenna: 'the trademark distinctiveness' refers to the extent to which a claimed designation conveys to consumers' information about the source of products or services as opposed to merely conveying product-related information. Protectable trade marks tell consumers something about who stands behind a product or service—they are distinctive of the source of the relevant products or services'. Mark McKenna, 'Teaching Trademark Theory Through the Lens of Distinctiveness' (2008) 52 *Saint Louis University Law Journal* 843, 847.

⁴⁵ See, for example, Kersey defines 'mark of goods' as a 'distinguishing mark whereby every Merchant or Trader knows his own goods.' In Frank Schechter, *The Historical Foundations of the Law Relating to Trade-*

character that can identify the goods affixed to it.⁴⁶ Cornish and Llewelyn state that: ‘The inclusion of capacity to distinguish in the very definition of trade mark ties the system for the most part to its historical basis: that the law's purpose is to protect marks as, in a broad sense, indicators of origin’.⁴⁷ From this, it is clear that the fundamental element in defining the trade mark is that it should be capable of distinguishing one trader's goods from another’s.⁴⁸

Nowadays, trade marks are considered to be an effective element of modern economic life that determines the economic value of the companies which own them.⁴⁹ Trade marks serve traders as well as consumers and they play a multiple role in their economic life.⁵⁰ This important role played by trade marks raised the need to establish a global framework to regulate trade marks. This was achieved with the TRIPS Agreement which has created a level of harmony for legal rules and a minimum level of protection for trade marks internationally.

2.2 TRIPS general principles and overarching obligations

TRIPS was drawn up in 1994 and included in the Marrakesh Convention which created the World Trade Organization (WTO).⁵¹ It is the most important agreement in the

Mark (Columbia University Press 1925) 127. Historically, trademarks related just to goods and did not include services. Daniel McClure, ‘Trade Mark and Unfair Competition: A Critical History of Legal Thought’ (1979) 69 *Trademark Report* 305, 310.

⁴⁶ Bodley states that the only requirement to consider the mark ‘sign’ as a trade mark is to be capable of serving to distinguish the trader’s goods from all other goods in the minds of customers. See in general, Temple Bodley, ‘What is a Trade Mark’ (1882) 2 *Kentucky Law Journal* 151, 152 and 155.

⁴⁷ William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8th edn, Sweet and Maxwell 2013) 652.

⁴⁸ See in general, Ruth Annand, ‘Developments in Registrability: The Definition of a Trademark and its Relationship with the Requirement for Distinctiveness’ (2000) 7 *Perspective on Intellectual Property* 109.

⁴⁹ The computer trade mark *Apple* was the most valuable mark in 2016. It has recorded the highest value ever at 145,918 US million, followed by *Google*, the world’s biggest internet search engine with a value of 94,184 US million dollars and in third place is the South Korean mark *Samsung* with 83,185 US dollars. See Brandirectory, ‘*Top Brands in 2016*’ <http://brandirectory.com/league_tables/table/global-500-2016> accessed in 14 July 2016. See Liz Cratchley, ‘Three-dimensional Trademark: Should the Directive Be Reshaped?’ (2000) 7 *Perspective on Intellectual Property* 139, 140. According to WIPO, the number of trade mark applications internationally filed between 1995 and 2011 multiplied from around 2 million to 4 million applications. WIPO International Report, World International Property Indicators, WIPO Economics and Statistic Series, 2012, 8. Also, according to the latest WIPO report issued in 2013, trade mark class counts grew by 6% in 2012.

⁵⁰ Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Mark* (Columbia University Press 1925) 127; Deven Desai, ‘Brand Theory of Trademark Law’ (2012) 64 *Florida Law Review* 981.

⁵¹ TRIPS is considered to be one of the most important outcomes of the Uruguay Round of the General Agreement on Tariff and Trade (GATT). For further reading see Antony Taubman, Hannu Wager and Jayashree Watal, *A Handbook on the WTO TRIPS Agreement* (Cambridge University Press 2012); Nuno

field of intellectual property rights in general and trade marks in particular,⁵² and established general principles of intellectual property that are recognised and followed by many countries.⁵³

The essence of TRIPS is to overcome obstacles and impediments to international trade and to create adequate and effective protection of intellectual property rights. TRIPS was also intended to ensure that the procedures of intellectual property rights enforcement do not become a barrier to international trade.⁵⁴

Articles 1 to 8 in Part 1 set out the main principles that constitute the heart of the Agreement. These principles impose an obligation on the member states to review their local laws related to intellectual property rights and to check their compatibility with the Agreement's provisions. The main principles of the TRIPS Agreement do not oblige the member states to adopt uniform, formal or objective procedures in relation to intellectual property rights.⁵⁵ Nevertheless, Article 1 Paragraph 1 obliges the member countries to provide no less than the minimum level of protection that is required by the Agreement, although member states can set a higher level of protection.⁵⁶ Article 1 Paragraph 2 states that, for the purpose of the Agreement, the term 'intellectual property' refers to all intellectual property, including trade marks. A number of TRIPS provisions refer to

Carvalho, *The TRIPS Regime of Patent Rights* (2nd edn, Kluwer Law International 2005); Sanjeev Dave, 'TRIPs: International Trademark Law that Promotes Global Trade' (2001) 12 *Journal of Contemporary Legal Issues* 458; Schmidt Szalewski, 'The International Protection of Trademarks After the TRIPS Agreement' (1998) 9 *Duke Journal of Comparative and International Law* 189.

⁵² TRIPS addressed trade marks in the 2nd section in Arts 15 to 21.

⁵³ *ibid* 32. As Kuan states, 'TRIPS has been one of the greatest breakthrough international intellectual property protections ... and it organized the importation of intellectual property protection and brought it into the international trade arena'. Siew Kuan Ng, 'TRIPS Agreement and its Implementation in Relation to Singapore Intellectual Property Law' (1997) 9 *Singapore Academy of Law Journal* 334. The TRIPS Agreement organises eight key elements in the intellectual property rights field: 1. Copyright and Related Rights 2. Trade marks 3. Geographical Indications 4. Industrial Designs 5. Patents 6. Layout-Designs (Topographies) of Integrated Circuits 7. Protection of Undisclosed Information 8. Control of Anti-Competitive Practices in Contractual Licenses. Before TRIPS, the concept and applications of intellectual property provisions varied widely around the world, which caused many problems among countries. See Catherine Seville, 'The Principles of International Intellectual Property Protection: from Paris to Marrakesh' (2013) 5 *WIPO Journal* 95, 100.

⁵⁴ See TRIPS Preamble.

⁵⁵ This is what can be seen clearly from the provisions of the agreement. Sanjeev Dave, 'TRIPs: International Trademark Law that Promotes Global Trade' (2001) 12 *Journal of Contemporary Legal Issues* 458. See Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (3rd edn, Sweet and Maxwell 2008) 206; Michael Blakeney, *Trade Related Aspects of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement* (Sweet and Maxwell 1996) 53.

⁵⁶ See Yoshifumi Fukunaga, 'Enforcing TRIPS: Challenges of Adjudicating Minimum Standards Agreements' (2008) 23 *Technology Law Journal* 868, 876.

conventions relating to intellectual property. However, amongst all these conventions, only the Paris Convention of 1883 (amended in Stockholm in 1967) deals with trade marks.⁵⁷

TRIPS states its objectives in Article 7, which affirms that protection of intellectual property rights should promote technological innovation and technology transfer in such a way as to achieve a mutual benefit to technology users and encourage economic and social welfare in addition to facilitating the balance of rights and obligations. It is worth noting that TRIPS is only binding on WTO members, and the provisions are non-self-executing.⁵⁸ Therefore, nationals of member states do not have the right to have recourse directly to the Agreement's provisions yet not comply with the local laws, unlike the Paris Convention of 1967 which has self-executing provisions.⁵⁹ The TRIPS Agreement contains some provisions that directly regulate the registration and protection of trade marks. Some of these provisions were established previously in older conventions and the TRIPS Agreement did not repeal them but kept and developed them.⁶⁰

2.3 The TRIPS definition of trade marks

The most modern and important trade mark definition is found in the TRIPS Agreement. This definition has been adopted by the member states and has become the global basis by which to define trade marks.⁶¹ Article 15 provides a detailed and flexible definition of a trade mark, including a non-exclusive list of signs, where it identifies that 'a sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade

⁵⁷ Paris Convention for the Protection of Industrial Property (20 March 1883). See TRIPS, art 2 'Intellectual Property Conventions 1. In respect of Parts II, III and IV of this Agreement, Members shall comply with arts 1 through 12, and art 19, of the Paris Convention (1967)'. The Paris Convention is the first international agreement that created a system for the protection of industrial property rights. The aim of the Paris Convention was to harmonize laws relating to industrial property in the widest sense and to set out rules for all member countries to follow. See WIPO, *WIPO Intellectual Property Handbook* (2nd ed, World Trade Organisation 2008) 241.

⁵⁸ Sujitha Subramanian, 'EU Obligation to the TRIPS Agreement: EU Microsoft Decision' (2010) 21 *The European Journal of International Law* 997, 1017.

⁵⁹ Sujitha Subramanian, 'EU Obligation to the TRIPS Agreement: EU Microsoft Decision' (2010) 21 *The European Journal of International Law* 997, 1017.

⁶⁰ The principle of national treatment is one of those provisions. There are other provisions; the TRIPS Agreement has taken the lead to adopt them, most notably, the 'most favoured nation' treatment. See TRIPS arts 3 and 4. See also, Schmidt Szalewski, 'The International Protection of Trademarks After the TRIPS Agreement' (1998) 9 *Duke Journal of Comparative and International Law* 189, 195.

⁶¹ Antony Taubman, Hannu Wager and Jayashree Watal, *A Handbook on the WTO TRIPS Agreement* (Cambridge 2012) 57. See also Nuno Carvalho, *The TRIPS Regime of Patent Rights* (2nd edn, Kluwer Law International 2005) 207. Note that 163 countries are members of the TRIPS Agreement. World Trade Organization (Members and Observers 14 July 2016) See WTO, Members and Observers <https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm> accessed 14 July 2016.

mark'.⁶² Then, the Agreement gives examples of forms that could be trade marks, such as words, letters, numerals and others.⁶³

TRIPS edited and developed the definition of trade mark set out in the Paris Convention in a number of different ways, the most important of which was that it did not confine itself to trade marks on goods but extended to service marks.⁶⁴ According to Westenberg: 'A service mark is used in the sale or advertising of services to identify the services of a particular person and to distinguish them from the services of others'.⁶⁵ Therefore, all the articles that regulate trade marks in TRIPS apply also to service marks.⁶⁶

TRIPS has highlighted the importance of the discriminatory characteristics of a trade mark and has considered these to be the most fundamental aspects of marks.⁶⁷ As described above, the trade mark definition under TRIPS starts with the primary condition which is that any sign or combination of signs with the capability to distinguish the product from another is considered a trade mark.⁶⁸ Note that the TRIPS definition does not define the term 'sign', it merely identifies the sorts of signs that could be distinctive trade marks.⁶⁹ In addition, it has allowed the member states to require that, in order to register a trade mark, it must be

⁶² Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (3rd edn, Sweet and Maxwell 2008) 206.

⁶³ TRIPS art 15 'Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registerability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.'

⁶⁴ Lisa Ramsey, 'Free Speech and International Trade Mark Obligations' (2010) 35 *The Yale Journal of International Law* 406, 409. See also Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 723.

⁶⁵ David Westenberg, 'What's in a Name? Establishing and Maintaining Trade Mark and Service Mark Rights' (1987) 42 *The Business Lawyer* 65.

⁶⁶ Michael Blakeney, *Trade Related Aspects of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement* (Sweet and Maxwell 1996) 53. See also, Ian Kaufman, *Impact of GATT-TRIPS on Trademark Rights* (Hugh Hansen, Chapter International Intellectual Property Law and Policy 2003) 4, 5.

⁶⁷ See Michael Blakeney, *Trade Related Aspects of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement* (Sweet and Maxwell 1996) 53. Note that the Paris Convention preceded TRIPS in the distinctive requirement to acknowledge the sign as a trade mark and then record and protect it. art 6(5) states that the Paris Union members have the right to refuse registration of any mark or championships its registration if it is devoid of any discriminatory character. See Paris Convention, art 6quinquies (B), (ii).

⁶⁸ TRIPS art 15: 'Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark'. This condition is every logical because without it the mark will not can identify origin of the goods or services, the main trade mark function. See Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Mark* (Columbia University Press 1925) 146.

⁶⁹ See Jennifer Davis, 'Between a Sign and a Brand: Mapping the Boundaries of a Registered Trade Mark in European Union Trade Mark Law' in Lionel Bently, Jennifer Davis and Jana Ginsburg (eds), *Trade Mark and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008) 68.

visually perceptible. Accordingly, the member states have the right to exclude smell, taste and sound marks from trade mark registration.⁷⁰

In order to provide a clear understanding of the trade mark in its modern sense under TRIPS, the following part of the chapter explores traditional as well as non-traditional forms of trade marks and their main provisions.

2.3.1 The traditional trade marks forms

According to TRIPS, words whether they are nouns, adjectives, verbs or adverbs can be used as trade marks.⁷¹ Letters or numbers are also potentially acceptable as trade marks.⁷² A trade mark can consist of a name of a company or a personal name and it is universally accepted that names, especially surnames, can be used as trade marks.⁷³ In addition, as it was previously mentioned, Article 15 in TRIPS states that a distinguishing character should be available in the mark to be considered a trade mark. However, the question that arises here is how to identify the elements that can be tested to verify that a mark is distinctive?

This question was answered by the Court of Justice of the European Union (CJEU) which stated that in order to determine the characteristics of a trade mark, it is necessary to assess all the constituent elements of the mark. The most important element that must be considered is the uniqueness of the mark in terms of its form and the consumer's ability to recognise this uniqueness.⁷⁴ In the *Philips* case,⁷⁵ the Court indicated that assessment of the distinguishing features of the mark is done according to the consumer evaluation of the mark and whether or not it could create confusion. According to the criteria for determining a distinguished mark established by the Court, the average consumer estimate is the basic criterion to identify the presence of such distinguishing features. The Court made it clear that an average person is one 'who is reasonably well informed and reasonably observant and circumspect'. It can be seen that the distinctive requirement is not subject to strict criteria but is flexible according to the nature of the consumer which is being targeted by the product

⁷⁰ See TRIPS art 15: 'Members may require, as a condition of registration, that signs be visually perceptible.'

⁷¹ There are many examples of trade marks consisting of a word, which are called the 'The simple trade mark form'. Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 128, 129.

⁷² See Hector Maqueen, Charlott Waelde and Graeme Laurie, *Contemporary Intellectual Property: Law and Policy* (Oxford University Press 2008) 567.

⁷³ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 136.

⁷⁴ *T.I.M.E. ART Ulusararasi Saat Ticareti ve dis Ticaret AS v Office for Harmonisation in the Internal Market* (Trade Marks & Designs) Case C-171/06 P [2007] All ER (D) 278 (Mar).

⁷⁵ *Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 [2003] Ch 159.

and also it is not subject to a judge's discretion but in this case the standard is set based on the consumer of the product.⁷⁶

From a legal point of view, trade marks that consist of an unusual word, such as EXXON for oil, are powerful marks as the distinctive character of the mark is very clear in the public's mind.⁷⁷ Also, normal words that are fixed to unrelated goods or services can have the same strength, for example, 'Apple' for a computer is highly distinguishable.⁷⁸ In addition, a word mark should generally be independent of the appearance of the product.⁷⁹ In contrast to this, the descriptive mark, which simply describes the product that it is affixed to and does not gain a secondary meaning (i.e. when the descriptive mark is unable to denote the origin of goods or services⁸⁰) will not be protected as a trade mark.⁸¹ For example, according to Phillips, the shape of a coffee bean cannot be registered on a coffee product because it is a descriptive mark that describes the nature of the product and would prohibit other coffee producers from using this mark if it were allowed.⁸²

Geographic names (e.g. countries, cities, regions) can be used as trade marks if they have a secondary meaning through their use. For example, YORK trailers and COLUMBIA films and sound recordings. These signs have connotations of their own which are independent of the geographic areas included in their mark and they have developed a secondary meaning over time and through their use.⁸³ However, in all cases, geographical

⁷⁶ See Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 87.

⁷⁷ Donahey states that: 'Distinctiveness is a crucial trade mark concept, which places marks on a ladder reflecting their inherent strength or weakness. The degree of distinctiveness of a mark governs in part the breadth of the protection it can command'. See Scott Donahey, 'Distinctive and Famous - Separate Requirements under the Federal Trade Mark Dilution Act' (2004) 3 John Marshall Review of Intellectual Property Law 174, 176.

⁷⁸ David Westenberg, 'What's in a Name? Establish and Maintaining Trade Mark and Service Mark Rights' (1986) 42 The Business Lawyer 65, 66. Schechter states that 'the mark actually sells the goods. And, self-evidently, the more distinctive the mark, the more effective is its selling power.' Frank Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harvard Law Review 813, 819.

⁷⁹ Lange gives an examples of marks used in the World Cup 2006 'the new made-up word BioID for goods and services in the computer and telecommunication sector and Bistrorant for catering and exclusively promotional advertising slogan LOCAL PRESENCE, GLOBAL POWER for hotel reservations'. Paul Lange, *International Trade Mark and Signs Protection* (Hart 2010) 450.

⁸⁰ Palladino explains the secondary meaning of the trade mark by saying: 'A descriptive term can become a trade mark when, in the public mind, it acquires the distinctiveness that characterizes a trade mark, namely, the ability to indicate source by identifying the goods of one producer and distinguishing them from the goods of others'. Vincent Palladino, 'Assessing Trade Mark Significance: Generalness, Secondary Meaning and Surveys' (2002) 92 Official Journal of the International Trade mark Association 857, 859.

⁸¹ See Sheldon Klein and Christopher Norton, 'The Role of Trademark Use in US Infringement, Unfair Competition and Dilution Proceedings' in Jeremy Phillips and Ileana Simon (eds), *Trademark Use* (Oxford University Press 2005) 333.

⁸² See KV Ahuja, 'Non-traditional Trade Mark: New Dimension of Trade Mark Law' (2010) 32 European Intellectual Property Review 575; Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 145.

⁸³ Catherine Colston, Jonathan Galloway and Kirstie Middleton, *Modern Intellectual Property Law* (2nd edn, Cavendish 2005) 538.

marks cannot be used where they would mislead the consumer as to the origin of the goods or services. The purpose behind this rule is that a geographic name is a common term available to all.⁸⁴ In addition, geographic names should be available to everyone as it may indicate a specific characteristic of that type of product such as the quality of the goods which could mislead and incorrectly influence the consumer if used on products which are not from that area.⁸⁵

TRIPS illustrates further examples of what can be used as a trade mark in Article 15. This includes figures, colours as well as any combination of such signs that could be eligible for registration as trade marks if it is capable of distinguishing the products (goods or services) of one undertaking from those of another according to TRIPS. It is of note that the trade mark definition in TRIPS refers to plurals, i.e. the ‘letters, numerals and colours’, which suggests that there is difficulty in recognising one letter, number or colour as a trade mark.⁸⁶ In short, Article 15(1) in TRIPS states that there must be a distinguishing character for the mark to be considered as a trade mark. It appears from the text that the distinguishing feature required of the mark must be linked to the mark’s ability to distinguish the goods or services that bear the mark.⁸⁷

2.3.2 Non-traditional trade marks forms

Traditionally, a trade mark consists of a word, number or two-dimensional design. However, as a result of international conventions relating to trade marks, the definition of what a trade mark is has been expanded to include new elements due to pressure from trade mark owners who did not want to be limited to the traditional elements.⁸⁸ The definition of

⁸⁴ Phillips states that ‘the imperative that the trader be free to indicate where their goods come from is stronger than the desire of traders to appropriate them exclusively for their personal requirements. Indeed, this imperative is also protected through the availability as defence to an infringement action of the honest use of a place name.’ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 132.

⁸⁵ *Peek & Cloppenburg KG v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (EUIPO) T-379/03.

⁸⁶ At the European level, this subject has been discussed in a number of cases. For example, the EUIPO Board refused the appeal of a car company to register the number ‘7’ as a trade mark for a sports car. *Caterham Car Sale and Coachworks Ltd’s application* Case R63/1999-3 [2000] ETMR 14, 13. The EUIPO guidelines also state that trade marks consisting of one or two letters or digits are devoid of distinctive character except when they are represented in an unusual style. See Guidelines for Examination in the Office, Part C, Opposition, 1/2014.

⁸⁷ TRIPS art 15(1): ‘Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration.’

⁸⁸ Kexin Li, ‘See Where is the Right Balance? Exploring the Current Regulations on Non-traditional Three-dimensional Trade Mark Registration in the United States, the European Union, Japan and China’ (2012) 30 *Wisconsin International Law Journal* 428, 431.

a trade mark in TRIPS has had the biggest effect and has widened the concept of a trade mark to the greatest extent. The type of marks that can be registered as a trade mark has become almost limitless.⁸⁹ Article 15(1) of TRIPS does not require the trade mark to be visually perceptible in order for a member state to register it.⁹⁰ The last paragraph of the Article states that ‘Members may require, as a condition of registration, that signs must be visually perceptible’, i.e., each member state has the right to accept (or reject) tastes, sounds and any other invisible marks from being registered as trade marks.⁹¹

Non-traditional trade marks have been recognised in many legal systems around the world.⁹² According to the International Trade Mark Association (INTA), jurisdictions all over the world are increasingly offering some form of protection for non-traditional marks. The most common are the three-dimensional marks which are collectively referred to as ‘trade dress’.⁹³ On the other hand, the registration of colour, sound and touch are not uniformly applied in all parts of the world.⁹⁴

There is an ongoing debate about the feasibility of equality between non-traditional and traditional marks which is still far from being resolved.⁹⁵ This debate is supported by trade mark owners who want to devise unique marks for their products.⁹⁶ However, in practice, non-traditional trade marks have become more prevalent. This is more consistent with modern business as it is broadly accepted that trade mark owners want the ability to

⁸⁹ See Carlos Correa, *Trade Related Aspects of Intellectual Property Right* (Oxford University Press 2007) 175.

⁹⁰ See Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (3rd edn, Sweet and Maxwell 2008) 206.

⁹¹ See Carlos Correa, *Trade Related Aspects of Intellectual Property Right* (Oxford University Press 2007) 175.

⁹² See, for example, Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1. Art 3: ‘Signs of which an EU trade mark may consist: An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds.’

MMS Karki, ‘Non-traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress’ (2005) 10 *Journal of Intellectual Property Rights* 499.

⁹³ KV Ahuja, ‘Non-traditional Trade Mark: New Dimension of Trade Mark Law’ (2010) 32 *European Intellectual Property Review* 575, 581.

⁹⁴ International Trade Mark Association, ‘*Non-traditional Mark*’

<inta.org/Advocacy/Pages/NontraditionalMarks.aspx> accessed 7 April 2013.

⁹⁵ MMS Karki, ‘Non-traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress’ (2005) 10 *Journal of Intellectual Property Rights* 499. See, in general, INTA, ‘Non-Traditional Trade Marks in Europe – Shape and Colour Trade marks – Common Issues with Obtaining, Exploiting and Enforcing Rights’ (Report prepared by the 2004-2005 Europe Legislation Analysis Subcommittee, March 2005).

⁹⁶ INTA, ‘Non-Traditional Trade Marks in Europe – Shape and Colour Trade marks – Common Issues with Obtaining, Exploiting and Enforcing Rights’ (Report prepared by the 2004-2005 Europe Legislation Analysis Subcommittee, March 2005).

create unique marks for their products.⁹⁷ The most relevant non-traditional marks that relate to the subject of this thesis are three-dimensional marks, and sound and taste as non-visible marks, which will be subject to further discussion in this thesis.

a) Three-dimensional marks

Three-dimensional marks could be the shape or packaging of a product which is seen as the trade mark that distinguishes the product from other products.⁹⁸ Many legislations around the world have been passed to provide legal protection to these types of marks. For instance, in the United Kingdom, the Trade Marks Act 1994 (TMA) considers the shape and the packaging to form part of the trade mark in its definition as well as in the European Trade Mark Directive 2015.⁹⁹ However, some shapes and forms have been prohibited from being registered as trade marks with the primary goal of preventing monopolies in the market.¹⁰⁰

In order to register a three-dimensional mark, the mark must first have characteristics that are independent and separate from the product bearing the mark.¹⁰¹ As mentioned above, a distinguishing characteristic is a fundamental condition that is necessary in order to accept the registration of any trade mark, and the three-dimensional mark is no exception.¹⁰² In addition, shapes cannot be registered if their form is necessary to achieve a technical result; a functional three-dimensional mark cannot be accepted as a trade mark.¹⁰³ In *Philips*, the CJEU decided that the ‘Directive aims to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors’.¹⁰⁴ In other words, this shape is

⁹⁷ Stefano Sandri and Sergio Rizzo, *Non-Conventional Trade Mark and Community Law* (2003 Marques) 1.

⁹⁸ See Annual Review, ‘The Twelfth Annual International Review of Trade Mark Jurisprudence’ (2005) 95 The Trademark Report 267, 342. See also WIPO, ‘Ninth Session Industrial Designs and Their Relation with Works of Applied Art and Three-dimensional Mark’ (World Intellectual Property Organization, 11-15 November 2002) 17.

⁹⁹ TMA 1994 art 1. See also Robert Burrell, Huw Smith and Allison Coleman, ‘Three-dimensional Marks: Should the Directive Be Reshaped’ (2000) 7 *Perspective on Intellectual Property* 139; Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1, art 4(1)(e).

¹⁰⁰ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 146. See, in general, Thomas Hays, ‘Distinguishing Use Versus Functional Use: Three Damnation Marks’ in Jeremy Phillips and Ileana Simon (eds), *Trademark Use* (Oxford University Press 2005) 93.

¹⁰¹ Stefano Sandri and Sergio Rizzo, *Non-conventional Trade Mark and Community Law* (2003 Marques) 45. See also, Robert Burrell, Huw Smith and Allison Coleman, ‘Three-dimensional Marks: Should the Directive Be Reshaped’ (2000) 7 *Perspective on Intellectual Property* 139.

¹⁰² Thomas Hays, ‘Distinguishing Use Versus Functional Use: Three Damnation Marks’ in Jeremy Phillips and Ileana Simon (eds), *Trademark Use* (Oxford University Press 2005) 96. See Robert Burrell, Huw Smith and Allison Coleman, ‘Three-dimensional Marks: Should the Directive Be Reshaped’ (2000) 7 *Perspective on Intellectual Property* 147.

¹⁰³ Stefano Sandri and Sergio Rizzo, *Non-conventional Trade Mark and Community Law* (2003 Marques) 52, 56.

¹⁰⁴ *Philips Electronics NV v Remington Consumer Products* Case C-299/99 para 77.

imposed by the nature of the product. For example, the circular shape of a tyre cannot be registered as a trade mark. The reason for this is because it would be contrary to the purpose of trade mark protection, and protection for this type of mark would cause great harm to competition.¹⁰⁵

In conclusion, a three-dimensional mark can be registered and protected in most cases provided that the mark meets the usual legal conditions required of any type of trade mark. The most important condition is the ability to distinguish the product from another.¹⁰⁶

b) Sound and taste marks

Sounds are divided into two main categories, musical and non-musical: musical sounds which are composed specifically for people to listen to; and non-musical or the natural sounds which are sounds such as thunder, wind, water, animals as well as the sounds created by human action such as clapping and whistling.¹⁰⁷

Although sound marks have existed for many years and are considered to be an influential element for product definition, there is no consolidated system of protection at a global level.¹⁰⁸ TRIPS is silent on the issue of a sound mark and does not give a clear definition on how to recognise or register this type of mark.¹⁰⁹ As for the national legislation in member states, there are a small number of countries that treat this type of mark in the same way as a regular mark.¹¹⁰ However, the majority of the European Union, including Spain, Italy, Austria, France and the European Union Intellectual Property Office (EUIPO) have all recognised sound marks as a trade marks.¹¹¹ In the UK, the TMA 1994 neither includes nor excludes protection for sound marks. The law permits the registration of any mark capable of distinguishing products as long as it can be represented graphically so it is clear that sound marks are capable of registration.¹¹²

¹⁰⁵ World Intellectual Property Organization, 'New Types of Marks' (SCT/16/2, 13-17 November 2006) 2. There are many decisions from the CJEU setting out the provisions for three-dimensional marks. One of the recent cases relating to this type of mark is *Hauck GmbH & Co KG v Stokke A/S and others* Case C-205/13.

¹⁰⁶ There are also other special conditions for this type of mark. See, for example, EU Directive 2015, art 4(1)(i) and (iii).

¹⁰⁷ World Intellectual Property Organization, 'New Types of Marks' (SCT/16/2, 13-17 November 2006) 8, 9.

¹⁰⁸ MMS Karki, 'Non-traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress' (2005) 10 *Journal of Intellectual Property Rights* 502. Stefano Sandri and Sergio Rizzo, *Non-conventional Trade Mark and Community Law* (2003 *Marques*) 139.

¹⁰⁹ EU Directive 2015 is no different from TRIPS and does not provide any further assistance in relation to sound marks.

¹¹⁰ *ibid.*

¹¹¹ EU Directive 2015, art 3; MMS Karki, 'Non-traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress' (2005) 10 *Journal of Intellectual Property Rights* 502.

¹¹² TMA, art 1. 'In this Art a 'trade mark' means any sign capable of being represented graphically'.

The United States is the most liberal country in dealing with non-traditional marks, especially the sound mark.¹¹³ The first recorded sound mark to be registered by the United States Patent and Trade Mark Office¹¹⁴ (USPTO) was in 1951 and was the National Broadcasting Corporation (NBC) chimes.¹¹⁵ Despite encouragement by the USPTO and the fact that sound marks have been recognised in the US for decades, there are only a limited number of registered sound marks, under 155, in the US. These include animal noises, singing or other sounds and spoken words.¹¹⁶

According to the World Intellectual Property Organization (WIPO), 38 out of 76 countries have accepted registration of musical sounds and 28 out of 73 have accepted registration of non-musical sounds as trade marks.¹¹⁷ As with other marks consisting of non-visible signs, sound marks face difficulties in being represented graphically. A written description for the sound mark is considered to be the main solution for this, such as using a musical manuscript or sol-fa notation.¹¹⁸

In this context, it is worth noting that the new Regulation of EUIPO 2015 has excluded the represented graphic requirement of a trade mark as a condition to register a trade mark.¹¹⁹ Paragraph 13 of the Regulation explains this by stating that it can be ‘represented in any appropriate form using generally available technology, and *thus not necessarily by graphic means*, as long as the representation offers satisfactory guarantees to that effect’. According to the WIPO, the vast majority of countries require graphical representation through musical notation for registration of a sound mark or via another format such as a CD or MP3 file.¹²⁰

With regard to taste marks, not all legal systems accept registration of a taste mark. However, unlike the others, taste marks are relatively easy to represent graphically compared to other non-visible signs. The WIPO reports that ‘the graphic representation requirement

¹¹³ Kevin McCormick, “DING” You are Now Free to Register that Sound’ (2006) 96 The Trademark Report 1101.

¹¹⁴ Is the federal agency for granting US patents and registering trade marks. See USPTO, ‘Trademark “Sound Mark” Examples’ <<http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>> accessed in 14 July 2016.

¹¹⁵ Stefano Sandri and Sergio Rizzo, *Non-conventional Trade Mark and Community Law* (2003 Marques) 139.

¹¹⁶ Anne Lalonde and Jerome Gilson, ‘Getting Real with Non-traditional Trade marks: What’s Next After Red Oven Knobs, the Sound of Burning Methamphetamine, and Goats on A Grass Roof?’ (2011) 101 The Trademark Report 186, 200. See USPTO, ‘Trademark “Sound Mark” Examples’ <[uspto.gov/trademark/soundmarks/index.jsp](http://www.uspto.gov/trademark/soundmarks/index.jsp)> accessed 25 January 2014. See Kevin McCormick, “DING” You are Now Free to Register that Sound’ (2006) 96 The Trademark Report 1104.

¹¹⁷ World Intellectual Property Organization, ‘New Types of Marks’ (SCT/16/2, 13-17 November 2006) 8.

¹¹⁸ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 162.

¹¹⁹ EU Directive 2015, art 3.

¹²⁰ World Intellectual Property Organization, ‘New Types of Marks’ (SCT/16/2, 13-17 November 2006) 8.

was satisfied by using a written description of the taste and an indication that it concerns a taste mark'.¹²¹ However, others disagree and believe that the taste mark is no different to the others. For example, Jehoram, Nispen and Huydecoper say that 'it does not seem very likely that today there is a way to represent taste marks in such a way that they satisfy the requirement of (proper) graphical representation'.¹²²

Moreover, it is challenging to try to explain how taste can serve as a trade mark as the consumer cannot normally taste a product before buying it. This point is highlighted by the USPTO; 'further, it is not clear how taste would as a practical matter function as a trade mark. A consumer generally has no access to the products' flavour prior to purchase'.¹²³ In addition, the flavour must not be an inherent feature or natural characteristic of the product but is the advantage provided by the trade mark owner. Therefore, if the mark they are seeking to register is derived from the product itself or is linked to the nature of the product, it is not capable of being registered because the mark is considered devoid of being distinguishable from others and would create a monopoly and in turn would harm other producers.¹²⁴

It can be seen that non-traditional marks are complex and there are many problems with trying to register them. One of the biggest challenges to overcome in respect of registering a non-traditional mark is the ability of the mark to distinguish that product from another and its ability to be graphically represented.¹²⁵ This causes the biggest problem for all non-traditional marks especially if it is to be recognised as a trade mark all over the world.

In summary, TRIPS created a broad trade mark definition and it is based on the mark's ability to distinguish the product. The forms of trade marks that are mentioned in the definition are examples and not a limitation; this is clear from the use of the words 'In particular' before mentioning the forms of marks.

As it has been observed, there is considerable overlap between the definition of a trade mark and its functions.¹²⁶ In other words, the function of a trade mark may determine

¹²¹ World Intellectual Property Organization, 'New Types of Marks' (SCT/16/2, 13-17 November 2006) 10. See *Sieckmann v Deutsches Patent-und Markenamt* Case C-273/00 [2002] All ER (D) 185 (Dec). Even though this case relates to small marks, it sets a general rule governing and can be applied to other types of non-traditional trade marks.

¹²² Tobias Jehoram, *Constant Nispen and Tony Huydecoper, European Trade mark Law: Community Trade Mark Law and Harmonized National Trade Mark Law* (Kluwer Law International BV 2010) 119.

¹²³ *In re N.V. Organon* 79 USPQ 2d (BNA) 1639 (TTAB 2006) 36, 37.

¹²⁴ *Eli Lilly and Company* EUIPO Case R120/2001-2.

¹²⁵ Kevin McCormick, "'DING" You are Now Free to Register that Sound' (2006) 96 The Trademark Report 113.

¹²⁶ See Frank Schechter, *The Historical Foundations of the Law Relating to Trade Mark* (Columbia 1925) 19.

whether a mark falls within the trade mark definition. Therefore, the next part will illustrate and analyse the justification for trade mark protection and trade mark functions as it is essential to have a thorough understanding of the concept of trade marks.

2.4 The justification and function of trade marks

There is virtually unanimous agreement among researchers that patents and copyright give the incentive to create valuable innovations and literature which benefit the whole of society, not just the inventor or the creator of the innovation.¹²⁷ The question to be asked is whether there is a need to protect trade marks as there is a need to protect the other intellectual property rights.¹²⁸ This is because human creativity in trade marks is not clear in contrast to the other types of intellectual property.

The answer to this question can be found in the role played by trade marks in the business and economic communities and the services they offer to producers and consumers. Due to this fact, there has been a shift towards recognising the significance of protecting trade marks.¹²⁹ In a similar vein, Kratzke argues that originally trade marks consisted of elements such as words, names or symbols which were not worth anything and had no value to society, and therefore did not deserve legal protection. However, these elements do have a value if the trader uses them as a tool to provide potential consumers with information about the product.¹³⁰

For the development of the trade mark's role, nowadays, a trade mark offers various functions to dealers in commerce. Trade marks can be seen as a mixture of both corporate

¹²⁷ See Jeanne C Fromer, 'Expressive Incentives in Intellectual Property' (2012) 98 Virginia Law Review 1745. Hector Maqueen, Charlott Waelde and Graeme Laurie, *Contemporary Intellectual Property: Law and Policy* (Oxford University Press 2008) 8; Dan Burk and Mark Lemley, 'Policy Levers in Patent Law' (2003) 89 Virginia Law Review 1575, 1597-99. Catherine Colston, Jonathan Galloway and Kirstie Middleton, *Modern Intellectual Property Law* (2nd edn, Cavendish 2005) 40.

¹²⁸ Robert Smith, 'The Unresolved Tension Between Trademark Protection and Free Movement of Goods in the European Community' (1992) 3 Duke Journal of Comparative and International Law 89, 90. For example, according to Colston, Galloway and Middleton: 'A trade mark is a sign which is attached to a commodity, rather than a legal device for stimulating the production of the commodity in the first place'. See Catherine Colston, Jonathan Galloway and Kirstie Middleton, *Modern Intellectual Property Law* (2nd edn, Cavendish 2005) 51.

¹²⁹ Ealy states that: 'Thus far, we should expect the utilitarian strongly to favour trade mark protection. According protection to trade mark appears to offer important benefits, and to make our society as a whole better off than it would be without the protection.' Jill Ealy, 'Utilitarianism and Trademark Protection' (2000) 19 The Journal of Contemporary Legal 14.

¹³⁰ William Kratzke, 'Normative Economic Analysis of Trademark Law' (1991) 21 Memphis State University Law Review 201, 204. According to Rogers, the real trade mark value is according to the extent of information it conveys or implies. Edward Rogers, *Good Will, Trade-Marks and Unfair Trading* (AW Shaw 1914) 100.

and consumer identities.¹³¹ Trade mark protection can find its justification in the main functions of the trade mark.¹³² The trade mark indicates the product's origin and makes it possible to distinguish the goods to which it is affixed as shown earlier in the trade mark definition.¹³³ It thus helps to prevent any kind of confusion by consumers between similar goods in the market.¹³⁴ Lemley states that: 'We give protection to a trade mark for one basic reason: to enable the public to easily identify a particular product from a particular source'.¹³⁵

Today, the trade mark not only distinguishes goods from similar ones but also provides a comprehensive system which helps to establish an image or notion in the minds of consumers regarding the value of the trade mark and its distinctive meaning.¹³⁶ For instance, the trade mark provides great features to its owner and to the consumer. To explain this further, concisely, the following section reviews the core functions of trade marks starting with the discriminatory function. This is followed by the communication function and, finally, the function of protecting the establishment of goodwill.

2.4.1 The discriminatory function

The discriminatory function has become the main function of trade marks. The trade mark is generally of considerable significance to consumers, helping to prevent confusion on the consumer's part.¹³⁷ It represents an easy way for the consumer to identify one brand of goods from similar ones. Trade marks also play an important role in protecting consumers from deception and commercial fraud.¹³⁸

¹³¹ Sonia Katyal, 'Trade Mark Intersectionality' (2010) 57 UCLA Law Review 1601.

¹³² See, in general, David Westenberg, 'What's in a Name? Establish and Maintaining Trade Mark and Service Mark Rights' (1986) 42 The Business Lawyer 65.

¹³³ In the USA, the congressional reports show that the main aims behind protecting trade mark are 'to protect the public from deceit to foster fair competition, and to secure to business community the advantages of reputation and goodwill by preventing their diversion from those who have created them to those who have no'. See Jennifer Rothman, *Initial Interest Confusion: The Diversion of Trade mark Law* (Peter Yu (ed), Intellectual Property Information Wealth, Praeger 2007) 94.

¹³⁴ Nicola Bottero, Andrea Mangani and Marco Ricolf, 'The Extended Protection of "Strong" Trade Marks' (2007) 11 Marquette Intellectual Property Law Review 265, 267.

¹³⁵ Mark Lemley, 'The Modern Lanham Act and the Death of Common Sense' (1999) 108 The Yale Law Journal 1687, 1695.

¹³⁶ Laura Heymann, 'Naming, Identity and Trademark Law' (2011) 86 Indiana Journal 381, 393.

¹³⁷ See Thomas Drescher, 'The Transformation and Evolution of Trade Marks—From Signals to Symbols to Myth' (1992) 82 The Trademark Reporter 301, 322 and 323; Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 806, 814.

¹³⁸ See Mark McKenna, 'Testing Modern Trademark Law's Theory of Harm' (2009) 95 Iowa Law Review 63, and Thomalyn Epps, 'Trade Mark: How we get to where we are Today' (2006) 19 The Journal of Contemporary Legal Issues 3.

The discriminatory function remains the principal feature of the trade mark to this day.¹³⁹ To illustrate the importance of this function, legal systems affirm that the recognition and registration of a trade mark depends on its capacity to distinguish goods.¹⁴⁰ It is a denotative function, where a trade mark identifies to the consumer the features and quality of the goods.¹⁴¹

This function of the trade mark also reduces the search costs of the consumer; it provides a quick, conspicuous and clear identifier of goods, even if the consumer has not tried the product before.¹⁴² Bainbridge states that the trade mark is the most effective and easy way for the consumer to select his favourite product without confusing or mixing it up with other products.¹⁴³ In addition, while the trade mark reduces the search costs, it also helps to repeat the buying of products which have met with the satisfaction of consumers and so avoid them buying unwanted goods.¹⁴⁴

It is known that the consumer's choice between similar goods or services is often based on a previous experience with these products.¹⁴⁵ The consumer's previous experience with a product is determined on the basis of proportionality between value and quality.¹⁴⁶ Therefore, a trade mark is the key to distinguishing good products.¹⁴⁷ It is possible to infer from this the importance of the discriminatory function of the trade mark and how it effectively facilitates reaching the preferred product in less time and with less effort.

2.4.2 The communication function; trade mark as source of information

According to Ross, the role played by trade marks as a communication method between traders and consumers in the modern market started in the early nineteenth century.¹⁴⁸ Bone states that '[t]he core of trade mark law, as it is understood today, is based

¹³⁹ See Thomas Drescher, 'The Transformation and Evolution of Trade Marks—From Signals to Symbols to Myth' (1992) 82 *The Trademark Reporter* 38.

¹⁴⁰ Paul Torremans, *Intellectual Property Law* (5th edn, Oxford Pries 2008) 373.

¹⁴¹ Ariel Katz, 'Beyond Search Cost: the Linguistic and Trust Functions of Trademarks' (2010) 5 *BYU Law Review* 1555, 1557.

¹⁴² Bainbridge, D, *International Property* (Pearson Longman 2009) 625.

¹⁴³ See Stacey Dogan and Mark Lemley, 'Trademark and Consumer Search Costs on the Internet' (2004) 41 *Houston Law Review* 777. See also, Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 818, 819.

¹⁴⁴ See Nicola Bottero, Andrea Mangani and Marco Ricolf, 'The Extended Protection of 'Strong' Trade Marks' (2007) 11 *Marquette Intellectual Property Law Review* 266, 269.

¹⁴⁵ Alison Firth, Gary Ilea and Peter Cornford, *Trade mark Law and Practice*, (2nd edn, Jordans 2005) 5.

¹⁴⁶ See in general Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 22, 23.

¹⁴⁷ Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 818.

¹⁴⁸ Robert Ross, 'Corporate Communication and the Trade Mark' (1968) 58 *The Trademark Report* 469, 470.

on a model which I shall call the ‘information transmission model’. This model views trade marks as devices for communicating information to the market¹⁴⁹.

Bradford states that the trade mark is a clear and easy way of communicating information. The trade mark can be seen as an information repository of products and firms.¹⁵⁰ The most important information given by the trade mark to the consumer is the origin of the product or service.¹⁵¹ Hence, the trade mark combines the goods or service information in a form of symbols or images which enable the product to be identified. Due to the importance of this information, trade mark laws are strict about using any information that may cause confusion or deliver false information to the consumer.¹⁵² Ross states that a trade mark that does not carry a message for consumers is worthless. He adds that it is important to highlight the meaning conveyed by the mark which is not only related to the product itself and the mark affixed to it but the mark should introduce a character of its own; without it the mark cannot be seen as an effective trade mark.

Manufacturers and traders use marks to inform the consumers about the product or about the service characteristics and qualities.¹⁵³ In addition, therefore, marks are used as a means of advertising products, which makes companies invest a lot of money in their marks in order to give a good impression to consumers.¹⁵⁴

Trade marks offer a way for consumers to gain information about the product, which helps them to decide which goods or services they need.¹⁵⁵ Nicholas emphasizes that the major reason for the existence and protection of trade marks is that ‘trade marks facilitate and enhance consumer decisions’.¹⁵⁶ From that, it can be seen that a trade mark is an

¹⁴⁹ Robert Bone, ‘Hunting Goodwill: A History of the Concept of Goodwill in Trade Mark Law’ (2006) 86 Boston University Law Review 547, 549.

¹⁵⁰ Laura Bradford, ‘Emotion, Dilution and the Trade Mark Consumer’ (2008) 23 Berkeley Technology Law Journal 1240.

¹⁵¹ See Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Mark* (Columbia Press 1925) 19.

¹⁵² Laura Bradford, ‘Emotion, Dilution, and the trade mark Consumer’ (2008) 23 Berkeley Technology Law Journal 1240, 1241, 1242. Mark Lemley, ‘The Modern Lanham Act and the Death of Common Sense’ (1999) 108 The Yale Law Journal 1687, 1695. See Directive 2015, art 4(1)(g) ‘trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service.’

¹⁵³ Laura Bradford, ‘Emotion, Dilution, and the trade mark Consumer’ (2008) 23 Berkeley Technology Law Journal 1258, 1259.

¹⁵⁴ See generally Ralph Brown, ‘Advertising and the Public Interest Legal Protection of Trade Symbols’ (1948) 57 The Yale Law Journal 1165.

¹⁵⁵ Ariel Katz, ‘Beyond Search Cost: The Linguistic and Trust Functions of Trademarks’ (2010) 5 BYU Law Review 1556.

¹⁵⁶ Nicholas Economides, ‘Trade marks’ in Peter Newman (ed), *The New Palgrave Dictionary of Economics and the Law* (Palgrave 1998) 4 <<http://ssrn.com/abstract=61148>> accessed 16 July 2016.

instrument used by the producer to deliver the product information to the consumer and does not only serve as a distinctive mark.

2.4.3 Protecting goodwill

Goodwill is considered to be a very important benefit to companies and is a valuable but intangible asset to businesses.¹⁵⁷ The CJEU has affirmed that one of the functions of a trade mark is to protect the goodwill of a company.¹⁵⁸ The trade mark achieves two functions for goodwill; firstly, it is a symbol of the company's reputation; secondly, it is a symbol which helps to create, maintain and develop the company's goodwill.¹⁵⁹ The strong bond between goodwill and trade marks has convinced some scholars that trade mark goodwill and business goodwill are the same.¹⁶⁰ In addition, Rogers states that 'a trade-mark is nothing but visualized good will'.¹⁶¹

Lord Macnaghten stated in *The Commissioners of Island Revenue v Muller Co's Margarine* that '[goodwill] is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. ... However widely or extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates'.¹⁶² This definition by Lord Macnaghten issued in 1901 is the cornerstone of the

¹⁵⁷ See Todd Jacobsen, 'Trademark and Goodwill Relationships and Valuation' (2000) 12 Journal of Contemporary Legal Issues 193, 196; Schechter Frank, 'The Rational Basis of Trade Mark Protection' (1927) 40 Harvard Law Review 813, 818, 819.

¹⁵⁸ *SA CNL-Sucal NV v Hag GF AG* Times Case C-10/89 (7 December). See also the comments in Robert Smith, 'The Unresolved Tension Between Trademark Protection and Free Movement of Goods in the European Community' (1992) 3 Duke Journal of Comparative and International Law 90.

¹⁵⁹ Robert Smith, 'The Unresolved Tension Between Trademark Protection and Free Movement of Goods in the European Community' (1992) 3 Duke Journal of Comparative and International Law 90

¹⁶⁰ Megan Bartkowski, 'Trade Mark as Components of Good will' (2006) 19 The Journal of Contemporary Legal Issues 165.

¹⁶¹ Edward Rogers, *Good Will, Trade-Marks and Unfair Trading* (AW Shaw 1914) 85.

¹⁶² *IRC v Muller & Co's Margarine Ltd* [1901] AC 217, 70 LJKB 677. In addition, in the same case Lord Macnaghten said on page 223: '[goodwill] is a thing very easy to describe, very difficult to define'. According to the Law Dictionary, the goodwill of business is 'the expectation of continued public patronage'. Henry Black, *Dictionary of Law* (West Publishing 1891) 543.

From an accounting perspective, goodwill can be defined as 'the intangible resources, factors, and conditions that allow a business to earn above-normal income with the identifiable assets employed in the business'. See Jay M. Smith et al, *Intermediate Accounting* (12th edn, Southwestern College 1995) 437. The Internal Revenue Service (IRS) submitted a detailed definition of goodwill: '(f). In the final analysis, goodwill is based upon earning capacity. The presence of goodwill and its value, therefore, rests upon the excess of net earnings over and above a fair return on the net tangible assets. While the element of goodwill may be based primarily on earnings, such factors as the prestige and renown of the business, the ownership of a trade or brand name, and a record of successful operation over a prolonged period in a particular locality, also may furnish support for the inclusion of intangible value...'. Revenue Service (IRS) 59-60.

definition of goodwill which the courts and many writers have adopted.¹⁶³ In addition, the most notable element that has been emphasised by Lord Macnaghten in this case is that goodwill is considered to be a property that can be bought, sold and acquired.

It is important to indicate that not every business has goodwill. Goodwill can be achieved by the passage of time and with a product or service that has the power to attract consumers.¹⁶⁴ This attraction consists in the goodwill value which is worthy of being protected. Without the ability to attract consumers, it is difficult to prove that a trade mark has goodwill value.¹⁶⁵

Identifying and protecting the source of products and services benefits the owner of the goodwill as it allows him to present his products freely without likelihood of confusion with another similar product. It also allows him to prohibit others from benefiting from the goodwill which is a significant investment to his company.¹⁶⁶ This benefit is also extended to consumers who will choose their favourite product without any confusion. In the absence of goodwill, consumers would have to re-evaluate the products with every purchase.¹⁶⁷

Courts have affirmed that in order to evaluate the goodwill enjoyed by the owner to institute a successful action for passing-off against another trader, it is necessary to own a *recognized goodwill* and not to base the case only on the confusion that might happen between the two products.¹⁶⁸ Therefore, it is logical to state that goodwill is not absolute, it is regionally limited. As such, to bring a passing-off claim in a country or region, goodwill must be situated in this specific country or region.¹⁶⁹

The discriminatory function of a trade mark as indicating the source of a product is a 'must' to protect goodwill.¹⁷⁰ When the sign, symbol or logo is a descriptive word, it is difficult for the owner to gain exclusive rights. Also, with descriptive words, it is difficult

¹⁶³ See for example, Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press) 729.

¹⁶⁴ Robert Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trade Mark Law' (2006) 86 Boston University Law Review 547.

¹⁶⁵ David Tan, 'The Fame Monster Reloaded: The Contemporary Celebrity, Cultural Studies and Passing-off' (2010) 32 Sydney Law Review 291, 293.

¹⁶⁶ Todd Jacobsen, 'Trade Mark and Goodwill Relationship and Valuation' (2000) 12 Journal of Contemporary Legal Issue 193.

¹⁶⁷ See Robert Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trade Mark Law' (2006) 86 Boston University Law Review 547, 549.

¹⁶⁸ *Reckitt and Colman Products Ltd v Borden Inc and others* [1990] 1 All ER 873. This is the main case that sets out the rules on passing off actions and is followed by a number of common law countries such as the UK and Australia. See David Tan, 'The Fame Monster Reloaded: The Contemporary Celebrity, Cultural Studies and Passing-off' (2010) 32 Sydney Law Review 29, 293.

¹⁶⁹ Walter Derenberg, 'Territorial Scope and Situs of Trade Marks and Good Will' (1961) 47 Virginia Law Review 733, 750.

¹⁷⁰ Todd Jacobsen, 'Trademark and Goodwill Relationships and Valuation' (2000) 12 Journal of Contemporary Legal Issues 193.

for the mark to indicate a product source rather than the common meaning. In order for a descriptive word to obtain trade mark protection, it should acquire a secondary meaning. This will happen when consumers use this word to identify a single product.¹⁷¹ Based on that, it is difficult to protect the goodwill of handbags marked 'Elegant Handbags,' for example, because this word is describing the product and this description can be used for any other handbags sold by competitors.

Finally, some trade marks lose goodwill protection because consumers have become accustomed to use this mark for every product of the same nature; the mark has thus lost its discriminatory function as it uses a common trade name.¹⁷² In addition, the more descriptive the mark, the more difficult it is to establish goodwill.¹⁷³ In short, to protect the goodwill associated with a trade mark, that trade mark has to remain capable of indicating the source of the product.¹⁷⁴

After reviewing and discussing the rules and requirements of the legal concept of trade mark, the question that arises at this point is, what are the key consequences of recognising a trade mark regarding the owner's rights? The next section tries to answer this question.

2.5 The substantial rights and protection under TRIPS

The main rights offered to a trade mark owner under TRIPS can be separated into three categories: the exclusive right, the right to have national treatment and the right to protection.

2.5.1 The exclusive right

The most significant result of fulfilling the TRIPS requirements is to be able to register the sign as a trade mark. This will give the trade mark owner certain advantages and an exclusive right to use his sign in the market. The trade mark owner gains independent

¹⁷¹ See Robert Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trade Mark Law' (2006) 86 Boston University Law Review 547, 549.

¹⁷² Molengraaff has illustrated this point, stating that 'it does not constitute an infringement of the rights of the word-mark "Citarin" if another manufacturer of chemical compositions sells his similar product under the name "Methylenocitras natricum", chemically identical with "Citarin" or if he denotes his production on a label or on the covering by this phrase or only by the word "Citarin" in conjunction with his own trademark for chemical products and by his firm name. the same may be said of the words like "Maizena" "Aspirin" "Pyramidon" etc.'. WLPA Molengraaff, 'The Nature of the Trademark' (1920) 29(3) The Yale Law Journal 303, 308.

¹⁷³ See Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 729.

¹⁷⁴ See WLPA Molengraaff, 'The Nature of the Trademark' (1920) 29(3) The Yale Law Journal 303, 306.

ownership over the trade mark which is represented by the right to authorize others to use the trade mark whilst at the same time prevent others (third parties) from using it.¹⁷⁵ Also, once a trade mark is registered, this creates the assumption that the registration is valid. In addition, registration determines the scope of property, which helps to reduce any potential disputes.¹⁷⁶ In addition, the owner of a registered mark has the full right of disposition over the mark. The assignment and the licensing are within the exclusive right of the trade mark owner, and these are endorsed and regulated by the TRIPS Agreement for their economic importance and value. Assignment of a trade mark is the main form of changing ownership.¹⁷⁷ It is usually part of a purchase agreement where trade mark is sold in exchange for an amount of money.¹⁷⁸ TRIPS Article 21, states that ‘the owner of a registered trade mark shall have the right to assign the trade mark with or without the transfer of the business to which the trade mark belongs’.¹⁷⁹ Licensing a trade mark, on the other hand, allows the trade mark owner to grant a third party permission to use the mark.¹⁸⁰ It is a tool for the owner to benefit from his exclusive right of trade mark and is a right which provides the ability to expand geographically and to extend the ‘product diversity’ of a trade mark.¹⁸¹

2.5.2 The right to have national treatment

The trade mark owner has the right to register and protect as well as obtain an exclusive right over his trade mark in other member states of TRIPS that is ‘at least as favourable as that granted to its own citizens’.¹⁸²

¹⁷⁵ TRIPS art 16 para (1) ‘The owner of a registered trade mark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion.’ See Karen Kaiser, ‘WIPO’s International Registration of Trade marks: An International Administrative Act Subject to Examination by the Designated Contracting Parties’ (2008) 9 German Law Journal 1597.

¹⁷⁶ However, registration is not a prerequisite to the use of the trade mark; it is therefore possible to use unregistered trade marks but they will not benefit from the advantages of registering. Lionel Bently and Brad Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press 2008) 781.

¹⁷⁷ An assignment agreement is usually a written agreement that regulates and determines the transfer of IP rights from the original owner to the buyer whether it is a person or organization. See Sindhura Chakravarty, ‘Importance of Assignment Agreements under Intellectual Property Laws in India’ (2009) 14 Journal of Intellectual Property Rights 513, 522.

¹⁷⁸ WIPO, *Introduction to Intellectual Property: Theory and Practice* (Kluwer Law International 1998) 214.

¹⁷⁹ TRIPS art 21 Licensing and Assignment.

¹⁸⁰ See generally Neil Wilkof and Daniel Burkit, *Trademark Licensing* (Sweet and Maxwell 2005).

¹⁸¹ Calboli defines the trade mark owner’s right of licensing as ‘the ability of trade mark owners to authorize third parties to use their marks on a variety of products under specific conditions’. Irene Calboli, ‘The Sunset of “Quality control” in modern trade mark licensing’ (2007) 57 American University Law Review 342, 348. See also, the main importance of trade mark licensing is the benefit it offers to the international business trade. Vernika Tomar, ‘Trade Mark Licensing and Franchising: Trends in Transfer of Rights’ (2009) 14 Journal of Intellectual Property Rights 397, 398.

¹⁸² TRIPS art 3.

The TRIPS Agreement provides for the uniform treatment of trade mark registration by the member states. Article 3 obliges member states to treat foreigners in the way they treat their own nationals in relation to trade mark registration. As further explanation of the intellectual property rights protection mentioned in Article 3, the Agreement states in the footnote that the protection shall include the availability, scope, acquisition, maintenance and enforcement of intellectual property rights. This means that, in case of trade mark registration as a means of protection, members should treat foreigners and nationals equally. Also, the members are not permitted to require the owner of the trade mark to be a national in order to register his trade mark or to require a certain condition of trade mark registration to be applied to foreigners and not to citizens. This is what is called the national treatment.¹⁸³

The Paris Convention preceded TRIPS in creating and regulating the national treatment principle in the field of industrial property rights protection.¹⁸⁴ However, in comparing the two regarding the treatment of foreigners, the Paris Convention in Article 2 Paragraph 1 states that nationals of any member country should receive, regarding industrial property protection, ‘the same’ treatment granted to nationals in all other member countries. As for TRIPS, Article 3, Paragraph 1 states that any member country should confer on any other member country nationals ‘no less’ protection than it confers on its own nationals. Szalewski affirms that a member state of the Paris Convention cannot grant foreigners who are citizens of other member countries a higher protection than it accords to its own nationals.¹⁸⁵ In contrast, TRIPS differs from the Paris Convention as it allows the member states to accord the nationals of other member countries more protection than that which is given to its own citizens.¹⁸⁶ Accordingly, member states of TRIPS can accord preferential advantages to foreigners regarding trade mark registration and protection. This is an application of the rule mentioned in Article 1, Paragraph 1 of TRIPS which allows the member states to provide for a higher level of intellectual property rights protection in their local laws. In addition, Carvalho explains that, even when one of the WTO members does not protect its own citizens, it has the obligation to protect other members’ citizens, while

¹⁸³ See in general, Robert Howse Efraim Chalamish, ‘The Use and Abuse of WTO Law in Investor-State Arbitration: A Reply to Jürgen Kurtz’ (2010) 20 *The European Journal of International Law* 1087, 1094.

¹⁸⁴ See art 2 of Paris Convention.

¹⁸⁵ Schmidt Szalewski, ‘The International Protection of Trademarks After the TRIPS Agreement’ (1998) 9 *Duke Journal of Comparative and International Law* 189, 195. See Paris Convention art 2(1, 2).

¹⁸⁶ Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (3rd edn, Sweet and Maxwell 2008) 180.

under the Paris Convention, if any country does not protect the intellectual property rights of its own citizens, it is not obliged to protect those of foreigners.¹⁸⁷

2.5.3 The right to protection

TRIPS has forced member states to set rules to protect intellectual property rights (including trade marks) in respect of civil and administrative procedures, criminal procedures and border measures.

a) Civil and administrative procedures and remedies

Part 3 (section 2) of TRIPS obliges member states to provide the right-owner with civil and administrative procedures to facilitate the enforcement of his intellectual property rights.¹⁸⁸ Members should authorise courts to issue injunctions to prevent infringement and to impose compensation to redress the damage done to the right-holder.¹⁸⁹

b) Criminal procedures

TRIPS in Article 61 deals with criminal procedures.¹⁹⁰ It states that member states should provide a right-owner with the right to initiate criminal proceedings and legal action for penalties at least in the case of wilful infringement. The remedies range between imprisonment and monetary fines in order to achieve deterrence. The Article also states that, in some particular cases, remedy might require seizure and destruction of the infringed goods.¹⁹¹

c) Border measures

TRIPS Article 50 obliges member states to enable the intellectual property owner to prevent the importation or exportation of any goods that infringe his intellectual property rights on the condition that these suspicions are reasonable.¹⁹² Member states must have procedures to enable the right-owner to obtain a judicial injunction to prevent such

¹⁸⁷ Nuno Carvalho, *The TRIPS Regime of Patent Rights* (2nd edn, Kluwer Law International 2005) 85.

¹⁸⁸ See TRIPS Part 3 Enforcement of Intellectual Property Rights, Section 2: Civil and Administrative Procedures and Remedies.

¹⁸⁹ Mitsuo Matsushita, Thomas Schoenbaum and Petros Mavroidis, *The World Trade Organization: Law, Practice, and Policy* (2nd edn, Oxford International Law Library 2005) 732.

¹⁹⁰ See TRIPS section 5: Criminal Procedures art 61 'Members shall provide for criminal procedures and penalties to be applied at least in cases of wilful trade mark counterfeiting or copyright piracy on a commercial scale.'

¹⁹¹ Carlos Correa, *Trade Related Aspects of Intellectual Property Right* (Oxford University Press 2007) 448.

¹⁹² See TRIPS section 3: Provisional Measures.

art 50, '1. The judicial authorities shall have the authority to order prompt and effective provisional measures: (a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance; (b) to preserve relevant evidence in regard to the alleged infringement.'

importation or exportation.¹⁹³ According to Articles 51 and 52, the right-holder who wishes to suspend the release of infringed goods by customs authorities has to provide the authorities with evidence. This means that he has the burden of proof that there is an infringement to his right.¹⁹⁴

Kumar states that in order for the right-owner to prohibit the infringed goods, this infringement should be clearly visible.¹⁹⁵ This standard is narrower than the owner rights set out in TRIPS Article 16 where the owner has the right to prohibit any goods bearing marks which might cause a 'likelihood of confusion'.¹⁹⁶ In this situation, where the goods are not identical but might only cause confusion, the right-owner cannot resort to the broader measures rules and stop the importation or exportation but only has the right to civil and criminal remedies.¹⁹⁷

2.6 Conclusion

In order to provide an understanding of the fundamental elements governing trade marks under TRIPS, this chapter has looked at the development and the main principles of trade marks in TRIPS and in Western legal systems.

The chapter's main findings indicate that the TRIPS Agreement is the cornerstone for international trade mark regulation and it generally adopts a flexible approach. It extended the meaning of a trade mark to cover a wide range of matters, including non-traditional marks. Moreover, the justification for trade mark protection is mainly based on the functions that a trade mark achieves for traders and consumers and for its economic value. The main criteria for a trade mark is the requirement that the sign should have a distinctive character that deserves protection and registration.

It can be seen from the above discussion that the main obligations of the member states, which are at the same time the rights of the trade mark owners provided by TRIPS, are as follows: (1) the exclusive right the owner of the mark has over its use to identify his products and to prevent others from using it and the right to dispose of his rights to a third

¹⁹³ Mitsuo Matsushita, Thomas Schoenbaum and Petros Mavroidis, *The World Trade Organization: Law, Practice, and Policy* (2nd edn, Oxford International Law Library 2005) 733.

¹⁹⁴ Mitsuo Matsushita, Thomas Schoenbaum and Petros Mavroidis, *The World Trade Organization: Law, Practice, and Policy* (2nd edn, Oxford International Law Library 2005) 733. Art 51 Suspension of Release by Customs Authorities, 52 Application.

¹⁹⁵ Harsh Kumar, 'Border Areas for the Protection of Intellectual Property Rights: An Analysis' (2003)9 *Journal of Intellectual Property Rights* 43, 50.

¹⁹⁶ TRIPS art 16.

¹⁹⁷ Harsh Kumar, 'Border Areas for the Protection of Intellectual Property Rights: An Analysis' (2003)9 *Journal of Intellectual Property Rights* 43, 45.

party either by assignment or by licensing; (2) the right of national treatment in all member states of the TRIPS Agreement; (3) the right to legal protection, in particular, civil and administrative procedures, criminal procedures and border measures.

The analysis of the TRIPS Agreement given above will be used to evaluate the level of harmonization and identify the differences and similarities between TRIPS provisions and Islamic Shariah with respect to trade marks. The next two chapters will explore the fundamental elements of the Islamic legal system in relation to intellectual property issues in general and trade mark in particular.

Chapter Three

The Islamic Shariah Perspective on Intellectual Property Rights

3.0 Introduction

Intellectual property rights is a modern area of law which has been considered by modern Islamic jurists in order to find equivalent or similar principles from classical Shariah that can validate its use in an Islamic country that applies the Shariah. However, Muslim scholars' interest in these rights has increased significantly with their emergence in modern life. This chapter explains how Islamic scholars have attempted to understand intellectual property rights and sets out the Islamic Shariah position on these rights. The chapter begins with a brief explanation of what Islamic Shariah is and its key sources, and it addresses the principle and philosophy of ease and flexibility in Islamic Shariah. The discussion then moves on to existing Islamic literature and a review of Islamic Shariah rules in relation to the main elements of intellectual property rights: *fikriyah* (intellectual), *milkiyyah* (ownership), *mal* (property) and *haqq* (right). The *fatwas* (legal opinions) of Islamic contemporary scholars on these rights will then be considered.¹⁹⁸

3.1 The concept of Islamic Shariah

The literal meaning of 'Shariah' is 'the way or path'. It is an Arabic term used to refer to the place of water. Shariah is derived from the Arabic verb (Sha ra a); in Islamic jurisprudence it means the statement of legal provisions.¹⁹⁹ In Islamic literature, it is common to use the term Shariah to refer to the Quran and the Sunnah of the Prophet Muhammad (PBUH) only.²⁰⁰ Islamic Shariah in general terms are the rules that God has laid down and promulgated to the people through his prophets.²⁰¹ They relate to all aspects of life, such as the way people should treat each other and the method of worshipping God.²⁰²

¹⁹⁸ A '*fatwa*' is a legal opinion or explanation issued by a qualified scholar in relation to Islamic Shariah. See Ahmed al-Hanbali, *Sifat al-Fatwa wa al-Mufti wa al-Mustafti* (Maktab al-Islamy 1960).

¹⁹⁹ Muhammad Abd al-Monem, *Mujam al-Muṣṭalaḥat Alfaz al-Fiqh al-Islamy*, vol 2 (Dar al-Fasila 1999) 327.

²⁰⁰ Edward Moad, 'A Path to the Oasis: Shariah and Reason in Islamic Moral Epistemology' (2007) 62 International Journal for Philosophy of Religion 135, 148. Zarqa defines Shariah differently as a set of beliefs, practical provisions and orders which are necessary to achieve Islam's aims and it is based on three pillars: mental, spiritual and judicial legal system. Mustafa Zarqa, *al-Fiqh al-Islami fi Thawbihi al-Jadid* (8th edn, Hayat 1964) 30.

²⁰¹ Ahmed Ghandour, 'Al-Shariah al-Islamiyyah' in Muhammad Abu Raida and others (eds), *al-Thakafa al-Islamiyyah* (Kuwait University 1989) 165.

²⁰² Mervyn Lewis, 'Islamic Corporate Governance' (2005) 9 Review of Islamic Economic 5, 16. Shariah in this sense includes all three main monotheistic religions; Judaism, Christianity and Islam. The three divine rules are similar in that: a) they come from one source, that is, God. In Surah Nisa 4, verse 163, God says,

Baderin states that ‘Shariah can be also used in a general legal sense in reference to the Islamic legal system as a distinct legal system with its own sources, methods, principles and procedures, separate from other legal systems such as the common law and civil law’.²⁰³

Islamic Shariah is an independent system and there is no relationship between it and secular laws. Although Shariah and secular laws meet on some points they are still different from each other.²⁰⁴ Muslims believe unequivocally that Islamic Shariah is ‘God’s work’ and not a human creation.²⁰⁵ At a conference of international law held at The Hague in 1937, the rector of Al-Azhar University (Muhamad Mustafa) sent a group of scholars to present and discuss the main concepts and provisions of Islamic Shariah. It was reported that some of the outcomes of this conference were that conferees considered Islamic Shariah: a) to be one of the most important sources of public legislation; b) to have its own legal methods to be developed; c) not to be derived from other legislation, i.e. that it is independent and distinct.²⁰⁶ Islamic Shariah covers all areas of law, such as civil, criminal, constitutional, international and financial law. The basic principles are found in the Quran and Sunnah, however, the *mujtahids*²⁰⁷ (scholars) are left to decide on the details using their *ijtihad*²⁰⁸ (diligence).²⁰⁹ This diligence is flexible and may change according to time and place.²¹⁰

‘We have revealed to you [O Muhammad], as We revealed to Noah and the prophets after him. And we revealed to Abraham, Ishmael, Isaac, Jacob, the Descendants, Jesus, Job, Jonah, Aaron and Solomon.’ This verse of the Quran makes it clear that the source of divine law is from God; b. the basic purpose of it is to return people to worship God. In Surah Anbiya, 21 Verse 25, God says, ‘and we sent not before you any messenger except we revealed to him that, there is no deity except Me, so worship Me’; c. They share the general basic principles. For example, the call for Justice among all creatures also the principle of reward and punishment and all of them have acts of worship such as prayer and fasting.

²⁰³ Mashood Baderin, ‘Understanding Islamic Law in Theory and Practice’ (2009) 9 Legal Information Management 186, 187.

²⁰⁴ Abbas Hosni, ‘Khasais al-Tashri al-Islamy’ (1994) 9 Majallat al-Shariah wa al-Dirasat al-Islamiyyah 15, 143.

²⁰⁵ Ahmed Ghandour, ‘al-Shariah al-Islamia’ in Muhammad Abu Raida and others (eds), *al-Thakafa al-Islamiyyah* (Kuwait University 1989) 165.

²⁰⁶ See, Subhi Mahmasani, *The Philosophy of Jurisprudence in Islam* (Farhat Ziadeh (tr), Leiden Brill 1961) 52; Azia Taha, ‘Min ifтираat al-Mustashriqin ala *Hadith* Tawheed’ (1989) 6 Kuwait University Journal of Shariah and Islamic Studies 19, 28, 37.

²⁰⁷ Mujtahid, one who strives to attain to a high position of scholarship and learning. Thomas Hughes, *A Dictionary of Islam* (Scribner Welford & Co 1885) 418.

Mujtahid is an independent religious scholar, a specialist in the deduction of the Islamic rules who do not follow religious opinion except from three major sources, Quran, Sunnah and conscience of the community from all over the Muslim world. Muhammad Barakati, *Al-Tarifat al-Fiqhiyyah* (Dar al-Kotob al-Ilmiyah 2003) 195.

²⁰⁸ Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al-Jawziyy 2002) 41.

²⁰⁹ Ahmed Ghandour, *Al-Shariah al-Islamiyyah* (Kuwait University Press 1989) 169. According to the dictionary, *Ijtihad* is ‘The logical deduction on a legal or theological question by a Mujtahid or learned and enlightened doctor, as distinguished from Ijma, which is the collective opinion of a council of divines.’ Thomas Hughes, *A Dictionary of Islam* (Scribner Welford & Co 1885) 196.

²¹⁰ Abdul Karim Zidane, *Nizam al-Kaza fi al-Shariah al-Islamiyyah* (2nd edn, al-Resala 1989) 22.

Historically, Islamic law came before some modern secular law principles, for example, the punishment is personal, i.e. applied to the actor only, the idea of giving the benefit of doubt to the accused, and the freedom

Muslims are obliged to acknowledge that *Allah* (God) is the sole legislator and Islamic Shariah is the main source of legislation, and that any other sources of law are acceptable as long as they are not inconsistent with the provisions of Islam.²¹¹ There are many verses in the Quran which make it clear that the provisions of Islamic Shariah are mandatory and not optional. For example, in Surah Maidah, 5 verse 47, God says, ‘Whoever does not judge by what Allah has revealed then it is those who are the defiantly disobedient’. Muslims believe that they are under God’s censorship at all times.²¹² In Surah 3 Ali-Imran, verse 5, God says ‘Indeed, from Allah (God) nothing is hidden in the earth nor in the heaven’. As a result, a Muslim’s obligation towards Islamic Shariah comes from self-commitment to the rules.

In this regard, two terms which have a strong link to Islamic Shariah need to be explained: *qanun* (law) and *fiqh* (Islamic jurisprudence). The word *qanun* does not have any root or origin in Islam.²¹³ Ashqar states that the term *qanun* was unknown in the early Islamic period. He believes that the word entered Arabic through the Syriac language.²¹⁴ In Islamic Arabic literature, it is unusual to use the phrase *al-Qanun al-Islami* (Islamic Law) but the writers use the term *al-Shariah al-Islamiyyah* (Islamic Shariah) when referring to Islamic rules and teachings. They also use the term *qanun* to describe modern or secular law only.²¹⁵ Historically, according to Ashqar, the Ottoman Empire used the term law to denote the legal provisions issued by the state to distinguish them from the provisions of Islamic Shariah, especially when there was conflict between state and Shariah provisions.²¹⁶ However, it is clear that in Islamic English language literature it is very common for the terms Islamic Shariah and Islamic law to be used interchangeably.

of contracting. Abbas Hosni, ‘Khasais al-Tashri al-Islamy’ (1994) 9 Majallat al-Shariah wa al-Dirasat al-Islamiyyah 15, 143.

²¹¹ Bandar Al-Otaibi, *Al-Hukm bima Anzal Allah* (2nd edn, 2006).

²¹² Lilian Miles and Simon Goulding, ‘Corporate governance in Western (Anglo-American) and Islamic communities: prospective for convergence?’ (2010) 2 Journal of Business Law 126.

²¹³ Umar al-Ashqar, *Al-Madkhal fi al-Fiqh al-Islamy* (Dar Al-Nafaes 2005) 45.

²¹⁴ Umar al-Ashqar, *Al-Shariah al-Ilahiya laa al-Quwain Jahiliya* (Dar al-Daawa 1983) 21.

²¹⁵ Yusuf al-Qaradawi, *Al-Madkhal fi al-Dirasat al-Islamiyyah* (Dar al Risala 1993) 24. I have noticed that in Islamic English literature the terms ‘Islamic Shariah’ and ‘Islamic Law’ are used interchangeably. In Saudi Arabia, the term ‘Law’ is not used, instead they use the term *al-Nizam* (regulations). For example, they say ‘company regulations’ and ‘labour regulations’ in place of ‘company law’ and ‘labor law’. Also, the term ‘regulatory authority’ is used instead of legislative authority. The Saudi Basic Law of Government. No. A/90- 1991. Act, 67. See also, Ayoub Jarbou, ‘Formal Defect of the Administrative Decision Analytical Study in the Light of the Judgments’ (2011) 56 Aladal Journal 204, 205.

²¹⁶ Umar Al-Ashqar, *Al-Shariah al Ilahiya laa al- Quwain Jahiliya* (Dar al-Daawa 1983) 23.

For the purpose of this research, I will use the term ‘Islamic Shariah’ rather than ‘Islamic law’ when referring to Islamic rules. This is in line with original Islamic literature, the historical context of the Islamic legal system and the sources of Islamic legislation.²¹⁷

With regard to Islamic *fiqh*, it has a direct link to the provisions of the term ‘Shariah’ and is commonly used to refer to Islamic Shariah rules.²¹⁸ *Fiqh* literally means a deep understanding and knowledge of Islam. According to Abu Zahra, Islamic *fiqh* can be defined as ‘the knowledge of the practical Islamic Shariah rules ‘*al-Ahkam*’ which are derived from particular evidence from Islamic Shariah sources’.²¹⁹ As such, Islamic *fiqh* did set rules in the sense that jurists interpreted the main sources and expanded their scope by *qiyas and ijtihad* (i.e. the intellectual effort made by Muslim scholars).²²⁰

In Islamic *fiqh*, there are four main classic schools of thought (*madhahib*): *Hanafi*, *Maliki*, *Shafi* and *Hanbali*.²²¹ There are no disagreements among these schools on the fundamental values and principles of the Islamic religion but there are differences in the details and particulars as each school has independent methodologies for studying, understanding, practising and interpreting religious texts.²²² However, there is a mutual respect between the scholars as they learn from each other and exchange knowledge. For example, Imam al-Shafi was one of Imam Malik students.²²³ In addition, there are other minority Sunni Muslim schools of thought such as *Althahiriya* and *Alabadhiya*.²²⁴ These four schools of thought plus the minority schools are the most significant Sunni Muslim schools and are followed by almost 90% of Muslims.²²⁵ Shias make up to 10% of Muslims²²⁶ and there are several Shia schools of thought, for example *Alja fariya* and *Alzaydiya*. Yet, it is

²¹⁷ Umar Al-Ashqar, *Al-Shariah al Ilahiya laa al- Quwain Jahiliya* (Dar al-Daawa 1983) 23.

²¹⁸ Mashood Baderin, ‘Understanding Islamic Law in Theory and Practice’ (2009) 9 Legal Information Management 186; Yusuf al-Qaradawi, *Al-Madkhal fi al Dirasat al-Islamiyyah* (Dar al Risala 1993) 24.

²¹⁹ Muhammad Abu Zahra, *Usul al Fiqh al-Islami* (Dar al-Faker Araby 1996) 6.

²²⁰ Abbas Husni, ‘Oasis al- Shariah al- Islamiyyah Mokarna ma’a al-Wehdawiyah’ (1994) 1 Kuwait University Journal of Shariah and Islamic Studies 15, 24.

²²¹ The Great Imam Abu Hanifah, al-Numan Alkofiis is the oldest of the four schools (699-767 AD). Malik ibn Anas al-Asbahi (715-795 AD). Muhammad ibn Idris al-Shafi’i (767-820 AD). Ahmad bin Hanbal al-Shaybani (780–855 AD). See Ahmed Taimur, *Nazarah Tarikhiyah fi Hudous al-Mazaheb al-Fiqhiyyah* (Dar al-Akhdiri 1990).

²²² See Ahmed Taimur, *Nazaryah Tarikhiyah fi Hudous al-Mazaheb al-Fiqhyeh* (Dar al-Akhdiri 1990); Ali al-Kafeef, *Asbaab Ikhtilaf ul-Fuqaha* (2nd edn, Dar-al Fiker al-Araby 1996).

²²³ Scientific Research Unit and Ifa, *Al-Madares al-Fiqhiyyh al-Arba’eh* (The Ministry of Awqaf and Islamic Affairs, Kuwait 2015)122.

²²⁴ See Ahmed Taimur, *Nazarah Tarikhiyah fi Hudous al-Mazaheb al-Fiqhiyyah* (Dar al-Akhdiri 1990).

²²⁵ See Pew Research Centre, ‘Sunni and Shia Muslims’ (January 2011) <pewforum.org/2011/01/27/future-of-the-global-muslim-population-sunni-and-shia/> accessed 28 April 2015.

²²⁶ *ibid*.

important to take into account that each school of thought has a different interpretation of the religious texts.²²⁷

To conclude, Islamic Shariah is a set of rules which stems from divine revelation (*wahy*). It provides guidance for believers on how to organise and protect their interests for this world and the hereafter. Its rules are derived from the Islamic sources, particularly the Quran and Sunnah.

3.2 Sources of Islamic Shariah

There are four main sources which provide the basis of Islamic Shariah.²²⁸ The first is the Quran; the second is the Sunnah, the method of the Prophet (PBUH);²²⁹ the third is *Ijma*, which is the consensus reached amongst the majority of scholars in relation to a particular topic; and the fourth is by applying logic to a new situation based on a previous ruling (*Qiyas*).²³⁰ The Quran and Sunnah are the primary and fundamental sources of Islamic Shariah, and all other secondary sources should comply with these in order to obtain Islamic legal legitimacy and not be considered an innovation in the religion (*Bidah*).²³¹

3.2.1 The Holy Quran

The Quran is accepted by all Muslims as the primary and most important source of Islam and there is no controversy or debate about this.²³² It is the first reference point for Islamic Shariah as it is the main source of guidance for Muslims and sets out the main rules in Islam as well as detailed rules in a number of other areas.²³³ The Quran is defined as the

²²⁷ Ali al-Kafeef, *Asbaab Ikhtilaf-ul-Fuqaha* (2nd edn, Dar-al Fiker al-Araby 1996).

²²⁸ Paula Skreslet, 'Basic Primary Source in Islamic Religion' (2008) 1 Journal of American Theological Library Association 49. See also, Muhammad Faithullah, *Fa'refet Usul al-Ahkaam* (Dar Attaqaddom 1989) 17.

²²⁹ Prophet Muhammad (PBUH) who was born in 570 AD is the only person associated with the Islamic legislation of the Quran and Sunnah. This period was known as the 'Prophetic Mission' and started from the time of God's revelation in 610 AD when Prophet Muhammad was 40 years old until his death at age 63. As such, the legislative period of the Quran and Sunnah only spans 23 years and after the death of the Prophet Muhammad (PBUH) there were no further additions to the Quran and Sunnah. Mashood Baderin, 'Understanding Islamic Law in Theory and Practice' (2009) 9 Legal Information Management 186, 188; Safiur Mubarakpuri, *Ar-Raheeq al-Makhtum* (The Ministry of Awqaf and Islamic Affairs, Qatar 2007).

²³⁰ Irshad Abdal-Haqq, 'Islamic Law: An Overview of its Origin and Elements' (1996) 2 The Journal of Islamic Law 1, 29, 32.

²³¹ The Prophet (PBUH) said that '... And beware of newly-invented matters, for every newly-invented [in Islamic religion] matter is an innovation and every innovation is a deviation.' Hafiz Abu Dawud, *Sunan Abi Dawood*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2007) 162 *Hadith* no 4607, 162. See in general Saleh al-Fawzan, 'Al-bida'eh: Ta'rifuha, Anwa'uha, Ahkamuha' (1988) 23 Majallat Al-bohouth al-Islamiyyah 349.

²³² Abdulrahman Soapy, *Mukadimatun al-Derasat al-A'qd fi al-Shariah al-Islamiyyah* (Aleppo University 1998) 52.

²³³ Irshad Abdal-Haqq, 'Islamic Law: An Overview of its Origin and Elements' (1996) 2 The Journal of Islamic Law 1, 8.

‘word of God’ revealed to the Prophet (PBUH) gradually through his life over a period of time (23 years). It is considered to be the main miracle given to him and Muslims recite it as a form of worship.²³⁴

The Quran is the fundamental source of Islamic Shariah and the most authoritative.²³⁵ It is worth mentioning that the Quran was revealed to the Prophet (PBUH) in Arabic; the translated version of the Quran is not called the ‘Quran’ but is regarded as an interpretation.²³⁶ The text in the Quran is the same now as it was at the death of the Prophet (PBUH).²³⁷ The Quran has not been modified nor have any verses (or even words) been added or deleted. God has said in Surah 15 Hijr, verse 9: ‘Indeed, it is we who sent down the message [i.e., the Quran and], indeed, we will be its guardian.’²³⁸

Abu Zahra commented that the Quran legislates in three different ways. The first method is direct legislation with a statement of the reason for the rule and the penalty imposed if violated or the reward for those who abide by it.²³⁹ For example, in Surah Ma’ida, 5 verse 90 God says: ‘O you who believe! Intoxicants and gambling ... are an abomination of Shaitan’s (Satan) handiwork. So avoid (strictly all) that (abomination) in order that you may be successful.’ The second method in the Quran is where a rule is addressed in several verses, and in that instance, to rely upon that rule, it is necessary to consider the meaning of these verses collectively rather than individually. For instance, the provisions that regulate the subject of orphans are addressed in Surah al-Baqarah, al-Nisa, al-Anam and others. The third way in which the Quran provides legislation is in less detail, only giving general provisions, thus allowing for flexibility in Islamic legislation. For example, in Surah, 16 an-Nahl, verse 90 ‘Allah orders justice, and good conduct, and giving [help] to one’s kindred. He forbids indecency, dishonour and insolence. He admonishes you in order that you take heed’. All these meanings mentioned in the verse represent general guidance for Muslims on the way that they should behave. It is clear from that verse that God has listed deeds which are good and those that have been forbidden but these rules are given without any further explanation.

²³⁴ Muhammad Abu Zahra, *Al-Milkiyyah wa Nazariyat al-Eqd fi al-Shariah al-Islamiyyah* (Dar al-Faker Araby 1976) 7; Nouredine Ater, *Uloum al-Quran al-Kareem* (Sabah 1993) 10.

²³⁵ Mashood Baderin, ‘Understanding Islamic Law in theory and practice’ (2009) 3 Legal Information Management 187, 188.

²³⁶ Muhammad Faizullah, *Al-illmamu bi-Usul al-Ahkaam* (Dar al-Tkadam 1989) 64

²³⁷ Ali Abdel Hamid, *Al-Aqeedah al-Islamiyyah* (Kuwait University Press, 1989) 151.

²³⁸ Ali Khan, Islam as Intellectual property, ‘My Lord! Increase me in knowledge” (2001) 31 Cumberland Law Review 631, 639, 643.

²³⁹ Muhammad Abu Zahra, *Al-Milkiyyah wa Nazariyat al-Eqd fi al-Shariah al-Islamiyyah* (Dar al-Faker Araby 1976) 7; Nouredine Ater, *Uloum al-Quran al-Kareem* (Sabah 1993) 10.

Zarqa argues that the Quran in Islamic Shariah is like a constitution²⁴⁰ setting out secular laws for humankind.²⁴¹ It contains sets of rules which provide for the needs of the individual, society and the state including legislation on civil, commercial, criminal and constitutional law.²⁴² In brief, the Quran is the holy book for Muslims which includes all the fundamental principles of Islam Shariah and is the basis of the Islamic religion.

3.2.2 The Sunnah

The Sunnah is the second fundamental source of Islamic Shariah after the Quran and all Muslims must adhere to its teachings.²⁴³ The word Sunnah literally means the path or the road.²⁴⁴ It is defined as the sayings of the Prophet (PBUH) (*al-Sunnah al-Qauliyah*), his actions (*al-Sunnah al-Filiyyah*), and things that the Prophet either approves of or condemns, as well as instances when he praises the words or actions of his companions (*al-Sunnah al-Taqririyah*).²⁴⁵

Beltrametti explains that the ‘Sunnah refers to the way the Prophet lived as a guideline for behaviour, whereas the *Hadith* comprises the actual textual narratives about his life’.²⁴⁶ In general, the term Sunnah is used to denote the words, actions and aspects that the Prophet (PBUH) approves of.²⁴⁷ It is important to understand that not all the Sunnah’s provisions and Islamic Shariah in general are compulsory. Some of these provisions are voluntary but recommended, for example, it is obligatory for Muslims to pray five times a day but it is preferable to pray more than that.²⁴⁸

²⁴⁰ According to the Oxford Law Dictionary a constitution is ‘the rules and practice that determine the composition and functions of the organs of central and local government in a state and regulate the relationship between the individual and the state.’ Oxford Law Dictionary, 2013

²⁴¹ Mustafa Zarqa, *al-Fiqh al-Islami fi thawbihi al-Jadid* (8th edn, Hayat 1964) 67.

²⁴² Mashood Baderin, ‘Understanding Islamic Law in Theory and Practice’ (2009) 3 Legal Information Management 186, 187, 189.

²⁴³ Irshad Abdal-Haqq, ‘Islamic Law: An Overview of its Origin and Elements’ (1996) 2 The Journal of Islamic Law 6.

²⁴⁴ Muhammad al-Ashqar, *Afa’ alu-rrasoul Saleh-Allahu Alyehi wa-Sallem*, vol 3 (Resalah 2003) 17.

²⁴⁵ Other scholars state that the Sunnah is the Prophet Mohamed’s (PBUH) words and deeds in addition to the Quran and the opposite of Sunnah is *Bidah* (innovation). See Muhammad al-Ashqar, *Afa’ alu-rrasoul Saleh-Allahu Alyehi wa-Sallem*, vol 3 (Resalah 2003) 18.

²⁴⁶ Silvia Beltrametti, ‘The Legality of Intellectual Property Rights under Islamic Law’ (2010) The Prague Yearbook of Comparative Law 55, 61. See also the same meaning, Masud ibn Umar al-Taftazani, *Sharh al-Talwih ala al-Tawzih*, vol 2 (Dar al-Kotob al-Ilmiyah 1996) 3.

²⁴⁷ Some Islamic literature uses the terms *Hadith* and Sunnah interchangeably. In fact, this is not accurate because *Hadith* is the Prophet’s words or sayings so in this sense *Hadith* is just part of Sunnah as it includes other elements as mentioned above. See Irshad Abdal-Haqq, ‘Islamic Law: An Overview of its Origin and Elements’ (1996) 2 The Journal of Islamic Law 1, 22.

²⁴⁸ Mahmoud Abu Rih, *Azwaa’ al-Sunnah al-Mohamadia* (6th edn, Dar Almarifa 1957) 13, 14.

God has explained the importance and compulsory nature of the Sunnah in many places in the Quran. For example, in Surah verse 59, ‘O you who believe! Obey Allah (God) and obey the Messenger (Muhammad) ... if you differ in anything amongst yourselves, refer it to Allah and His Messenger, if you believe in Allah and in the Last Day.’ This illustrates the importance of the Sunnah in Islamic Shariah as a source of legislation and its position after the holy Quran; this is the consensus view among scholars of the four schools of thought.²⁴⁹

The Sunnah is an essential point of reference to help explain the provisions of the Quran as it gives detailed explanations about how to interpret the texts and how to apply them in practice.²⁵⁰ For example, it is mentioned in the Quran that all Muslims should pray five times a day but does not explain how this should be done. Muslims refer to the Sunnah for specific guidance on how to pray. Muslim scholars take a great interest in the Sunnah as it adds detail to many of the provisions in the Quran so that it can be applied in practice. Therefore, Muslims scholars do their best to make sure that the Sunnah is free from any incorrect and fabricated rules.²⁵¹

Having said this, it is incorrect to consider the Sunnah as an executive set of rules for Quranic law. In fact, the Sunnah is an independent source from the Quran even though it explains the provisions set out in the Quran. In addition, the Sunnah includes other provisions that are compulsory that the Quran does not cite.²⁵² As the Quran and Sunnah are at the top of the hierarchy and are the most authoritative source of Islamic Shariah, according to scholars there is no contradiction between their provisions and any claim otherwise would be due to a lack of understanding of the text. In all cases, it is unacceptable, according to scholars, to say that there is a realistic/genuine conflict between the Quran and Sunnah as this could be seen as a defect in the religion.²⁵³

²⁴⁹ Mahmoud Abu Rih, *Azwaa' al-Sunnah al-Mohamadia* (6th edn, Dar Almarifa 1957) 12.

²⁵⁰ Mustafa Sibai, *Al-Sunnah wa-Makenatuha fi al-Tashri' al-Islamy* (2nd edn, Dar Alwarraq 1999) 65.

²⁵¹ Mustafa Sibai, *Al-Sunnah wa-Makenatuha fi al-Tashri' al-Islamy* (2nd edn, Dar Alwarraq 1999) 82, 89.

²⁵² See Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 4 (Maktaba al-Kobra 1975) 3. Mahmoud Abu Rih, *Azwaa' al-Sunnah al-Mohamadia* (6th edn, Dar Almarifa 1957) 13, 14. See, for example, the rule on the prohibition of tattooing in Sunnah. Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiruddin al-Kattab (tr), Darussalam 2007) *Hadith* 1989, 137.

²⁵³ See, in general, Muhammad Hifnau, *Al-Ta'aruz wat-Tarjeehu Endeh al-Ousulyeen wa Atharuha fi al-Fiqh al-Islamy* (2nd edn, Dar Alwafaa 1987).

3.2.3 *Ijma* (scholarly consensus)

Ijma is the third source of Islamic Shariah after the Quran and Sunnah. It contains points that were agreed upon by Muslim scholars (*mujtahids*) after the death of the Prophet (PBUH) in the same time period in relation to specific legal provisions.²⁵⁴ *Ijma* is only accepted if there is no text in the Quran or Sunnah that addresses the subject. Also, the provision reached through *Ijma* must not contradict the Quran or the Sunnah.²⁵⁵ *Mujtahid* scholars must have the ability to infer the provisions from primary Islamic sources.²⁵⁶ Surah an-Nisa, 4 at verse 115 of the Quran is often quoted as evidence that authoritative consensus is an acceptable source of legislation where God has warned against the people who violate the path of the believers and who go against the Muslim consensus. The importance of consensus is also evidenced through the Sunnah where the Prophet (PBUH) said, 'My nation will not unite on misguidance, so if you see the differing, follow the great majority.'²⁵⁷ There are two types of consensus:²⁵⁸ the first is *Ijma Sarih* (explicit consensus) where Muslim scholars explicitly agree on a particular ruling together or where they all issue separate opinions that are in agreement with each other;²⁵⁹ the second type is called the *Ijma Sukuti*²⁶⁰ (silent consensus) where a scholar publishes an opinion which is not objected to by any other scholars.²⁶¹

3.2.4 *Qiyas* (reasoning by analogy)

In Arabic, *Qiyas* literally means 'measuring'.²⁶² *Qiyas* is the fourth source of Islamic Shariah. According to Muil Izz al-Din, *Qiyas* technically 'designates legal analogy or syllogism which assimilates the injunction of one case and applies it to a similar one that has

²⁵⁴ Wael Hallaq, *The Oxford Encyclopedia of the Modern Islamic World* (John Espoto (tr), 3rd edn, Oxford University Press 1995) 312; Ahmed Ibn Taymiyyah, *Mawsou'at al-Ijma'a Li-Shayekh al-Islam Ibn Taymiyyah* (Dar al-Bayan al-Haditha 1999) 9. Irshad Abdal-Haqq, 'Islamic Law: An Overview of its Origin and Elements' (1996) 2 *The Journal of Islamic Law* 154.

²⁵⁵ Bernard Weiss, 'Interpretation in Islamic Law: The Theory of Ijtihad' (1978) 26 *the American Journal of Comparative Law* 199.

²⁵⁶ Bernard Weiss, 'Interpretation in Islamic Law: The Theory of Ijtihad' (1978) 26 *American Journal of Comparative Law* 199; Ahmed Ibn Taymiyyah, *Mawsou'atul Ijma'a Li-Shayekh il-Islam Ibn Taymiyyah* (Dar al-Bayan al-Haditha 1999) 9.

²⁵⁷ Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 5 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 3950, 174.

²⁵⁸ Wahbah Zoheily, *Usul-al-Fiqh al-Islamy*, vol 1 (Dar al-Fiker 1986) 551.

²⁵⁹ See Mu'il Yusuf Izz al-Din, *Islamic Law: From Historical Foundations to Contemporary Practice* (Edinburgh University Press 1988) 48.

²⁶⁰ See Mu'il Yusuf Izz al-Din, *Islamic Law: From Historical Foundations to Contemporary Practice* (Edinburgh University Press 1988) 48.

²⁶¹ Yacoub Albhussein, *Al-Ijma* (Al-Rashed 2008) 176.

²⁶² Muhammad Abd al-Monem, *Mujam al-Muṣṭalahat Alfaz al-Fiqh al-Islamy*, vol 3 (Dar al-Fasila 1999) 125.

no specified injunction'.²⁶³ *Qiyas* is used to apply logical rulings by comparing a previous ruling to a new similar situation.²⁶⁴ For example, scholars have ruled that drugs are prohibited as they affect the mind and balance in the same way as wine or liquor. Therefore, it can be reasoned through logical deduction that drugs are also forbidden as they have the same effect on the mind as alcohol, despite there being no express prohibition on their use.²⁶⁵

There is much historical evidence on the use of *Qiyas* in Islamic history which shows that it is an essential source of Islamic legislation.²⁶⁶ The importance of *Qiyas* is that it allows Islamic Shariah to keep up with modern developments, making rulings on situations that had not occurred in the era of the Prophet and were unknown to the early Muslims.²⁶⁷ In other words, the *ijtihad* by modern scholars through *Qiyas* is often the basis for the acceptance of new legal concepts into the modern application of the Shariah. However, in all cases, *Qiyas* should be in line with the provisions set out in the primary Shariah sources: the Quran and Sunnah.

In brief, *Qiyas* can be used to deal with new issues that are not directly regulated by the provisions in the first three sources: Quran, Sunnah or *Ijma*. These are the four main sources of Islamic Shariah which represent the cornerstone of the Islamic legal system but the Quran and Sunnah are the primary sources and all other secondary sources should comply with the primary sources in order to obtain Islamic legal legitimacy.

3.3 The flexibility of Islamic Shariah

After discussing the concept of Islamic Shariah and highlighting its main sources, it is important to note the following issues before exploring intellectual property rights and trade marks from an Islamic perspective to better understand the variation in the legitimate interpretation of the religious texts which leads to some differences among Muslims scholars over doctrinal issues.

²⁶³ Mu'il Yusuf Izz al-Din, *Islamic Law: From Historical Foundations to Contemporary Practice* (Edinburgh University Press 1988) 51.

²⁶⁴ See Wahbah Zoheily, *Usul al-Fiqh al-Islamy*, vol 1 (Dar al-Fiker 1986) 600; Masud ibn Umar al-Taftazani, *Sharh al-Talwih ala al-Tawdih*, vol 2 (Dar al-Kotob al-Ilmiyah 1996) 109; Irshed Abdal-Haqq, 'Islamic Law: An Overview of its Origin and Elements' (1996) 2 *The Journal of Islamic Law* 1, 30.

²⁶⁵ Muhammad Zoheily, 'Ahkam Attakhdeer wa al-Mukhadart Attibeyah wa al-Fiqhiyyah' (2008) 24 *Damascus University Journal of Economic and Legal Sciences* 758.

²⁶⁶ There are numerous examples provided by al-Qaradawi. See Yusuf al-Qaradawi, *Awamil Assa'eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002) 17. See also, Mustafa Zarqa, *al-Fiqh al-Islami fi Thawbihi al-Jadid* (8th edn, Hayat 1964) 73, 74.

²⁶⁷ Zia Zobaie, '*Qiyas al-Shabeh endal-Usulyeen wa Namathejun min Tatbiqatihi al-Fiqhiyyah*' (2006) 6 *Journal of Islamic Science* 194, 194.

Despite Islamic Shariah directing all Muslims, whatever their nationality, language or culture, to abide by the same regulations which derive from the same sources, there is a clear disparity in their application between the different countries, people and times.²⁶⁸ The reasons behind the differences and the impact on Muslim life will be analysed in this part.

Initially, it must be emphasised that Islam is for all people without any exception based on ethnicity, culture, language and colour. Islam is not a religion of the Arabs only but is a religion for all of humanity. In Surah al-Anbiya, 21 verse 107, God says, ‘And We have not sent you, [O Muhammad], except as a mercy to the worlds’. Also, In Surah al-A’raf, 7 verse 158 God says, ‘Say, [O Muhammad], O mankind, indeed I am the Messenger of Allah to you all’. There is some evidence that supports the view that Islam is a global religion.²⁶⁹

The classical scholars believe the differences in the application of Islamic rules is a direct effect of the large amount of flexibility in Islamic Shariah and this is what makes Islam a universal religion, applicable in any time and place.²⁷⁰ Islamic Shariah extends to all humans from different eras and environments, and it continues to be able to adapt the basic rules of Islam to the changes in modern times and in different places.²⁷¹

The key points that can be inferred from scholars in relation to the ability of the Islamic religion to develop over time and to align with human needs in general are given below.

The first is that legal lacuna in Islamic Shariah is deliberate.²⁷² The Prophet (PBUH) said: ‘Allah the Almighty has laid down religious duties, so do not neglect; He has set boundaries, so do not overstep them; He has prohibited some things, so do not violate them; about some things He was silent out of compassion for you, not forgetfulness, so seek not after them’.²⁷³ The scholars say that the aim of this legal lacuna is to allow people in different times to decide what rules suit them.²⁷⁴ As such, Islamic Shariah did not directly legislate

²⁶⁸ See Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al-Jawziyy 2002) 337.

²⁶⁹ Islam is the second-largest religion in the world. Muslims make up about 1.6 billion or 23% of the world’s population. Muslims make up a majority of the population in 49 countries. The Muslims living in Pakistan and India are greater in number than Muslims in the entirety of the Middle East and North African ‘Arab countries’. See Pew Research and Public Life Project, ‘The Global Religious Landscape’ (18 December 2012) <<http://www.pewforum.org/2012/12/18/global-religious-landscape-muslim/>> accessed on 6 March 2014.

²⁷⁰ See Yusuf al-Qaradawi, *Awamil Assa’eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002).

²⁷¹ There is a consensus among Muslim scholars about this idea, i.e. the comprehensiveness of the Islamic religion. See Yusuf al-Qaradawi, *Al-Ijtihad fi al-Shariah al-Islamiyyah* (Dar al-Kalem 1996) 6.

²⁷² See Abdul Wahab Khalaf, *Khlasit al-Tashria al-Islamy* (Dar al-Kalem 1996) 20.

²⁷³ Mohiuddin al-Nawawi, *An-Nawai’s Forty Hadith* (Islamic Presentation Committee) 94.

²⁷⁴ AbdulWahab Khalaf, *Khlasit al-Tashria al-Islamy* (Dar al-Kalem 1996) 20.

many issues and left it to the independent religious scholars (*mujtahid*). As explained earlier, the role of the *mujtahids* begins when there is no clear text in the Quran or Sunnah to deal with a question satisfactorily. Islamic Shariah has control in relation to the *mujtahid*'s method in his search. This means that he is obliged to consult specialists in the field relating to the topic he is investigating in order to have a better understanding of it.²⁷⁵ For example, they would need to consult a doctor before giving an opinion on allowing or prohibiting organ transplants. It is of note that a *mujtahid* can be a male, female or a committee.²⁷⁶ The latter is the most recent form of *mujtahid*.

There are a variety of *Ijtihad* tools. The most well-known and most important is *Qiyas* (reasoning).²⁷⁷ Another tool is the *al-Istislah* (public interest), where there is no special evidence in the Quran or Sunnah that allows or forbids interest but there is a need to protect or organise it.²⁷⁸ *Al-Istislah* should only be applied where there is an indication that protecting or organising affairs in a particular way achieves a benefit or prevents physical or moral harm whether it is actual or potential harm.²⁷⁹ One of the most notable examples of *al-Istislah* in Islamic history is when Abu Bakr, the first Muslim *Khalifa* (ruler) following the death of the Prophet (PBUH), collected the verses of the Quran into one book. The Prophet (PBUH) did not order or forbid the collection of the Quranic verses into one book; Abu Bakr did that because he believed that collecting the verses of the Quran would preserve it and would benefit all Muslims and the Islamic religion as a whole.²⁸⁰ The most prominent contemporary example is the subject of women driving cars in Saudi Arabia. The Saudi scholars acknowledge that there is no evidence in the Quran or the Sunnah that prohibits women from driving, however, some of them believe that there is potential harm to women

²⁷⁵ Muthana Sadeq, 'Usul wa Zawabet al-Ijtihad fi al-Nawazel' (2010) 47 Diyala Journal 588, 596.

²⁷⁶ There is no evidence to show that women are prevented from being diligent and the evidence shows that Muslim women have played a very large role in this field with the most well-known of them being Aisha, wife of the Prophet (PBUH). See Sayed Nadwi, *Seert Aisha* (Dar Alqalam 2003) 326. See also Hamza Hammad, 'Features of the Prophetic Approach/method in making women expert in fiqh (Islamic jurisprudence) Aisha - may Allah be pleased with her - as a model example Women's Conference in Biography of the Prophet' (Women's Conference in Biography of the Prophet, April 2012) <saaid.net/book/19/12608.pdf> accessed 6 May 2014.

²⁷⁷ See Chapter Three, 3.2.4 Qiyas (reasoning by analogy).

²⁷⁸ Yusuf al-Qaradawi, *Awamil Assa'eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002) 24.

²⁷⁹ Abdulaziz al-Rabiah, *Adelat al-Shariah al-Mukhtaleff fi al-Ehtejaj Biha (al-Qiyas, al-Istehsan, al-Istislah, wa al-Istislah)* (2nd edn, Abdulaziz al-Rabiah 1981) 219.

²⁸⁰ Abdulaziz al-Rabiah, *Adelat al-Shariah al-Mukhtaleff fi al-Ehtejaj Biha (al-Qiyas, al-Istehsan, al-Istislah, wa al-Istislah)* (2nd edn, Abdulaziz al-Rabiah 1981) 219. Another tool of *Ijtihad* is '*Istihsan*', i.e. to give a verdict a proof from one's heart with satisfaction, and one cannot express it [only Abo Hanifah and his pupils say so but the rest of the Muslim religious scholars of Sunnah (and they are the majority) do not agree with it]. See Abdulaziz al-Rabiah, *Adelat al-Shariah al-Mukhtaleff fi al-Ehtejaj Biha (al-Qiyas, al-Istehsan, al-Istislah, wa al-Istislah)* (2nd edn, Abdulaziz al-Rabiah 1981) 275.

if they are allowed to drive, such as intermixing between men and women without an acceptable excuse. It can also lead to harassment, unnecessary exposure which exacerbates congestion and other consequences.²⁸¹

The second way that Islam is flexible is that it accepts the diversity of customs in Muslim societies. *Urf* (Custom) is considered to be one of the most important tools that provides flexibility to Islamic Shariah where there is an absence of a legislative text on the subject in Islam. Ghani states that ‘custom is a matter accepted by the common people. As it has been put into practice for so long’.²⁸² Also, he explains that ‘custom and usage are two technical terms of English jurisprudence which are known in Islamic jurisprudence as *Urf* (customs) and *Adah* (traditions). Literally and technically, these terms differ but in usage in society they overlap each other’.²⁸³ Custom in short is what people are accustomed to.

Islamic Shariah respects customs and traditions and recognises the differences between them.²⁸⁴ Therefore, the Islamic Shariah provisions can vary according to the customs and morals for each society as long as they do not violate the basic rules in Islam or where the Shariah rules are clear on a particular matter.²⁸⁵ For example, in Surah al-Baqarah, 2 verse 233, God says, ‘Upon the father is [i.e. the mother’s] provision and their clothing according to what is acceptable’. This verse refers to the custom that it is for the husband/father to pay for his wife and children.²⁸⁶ Muslim scholars rely on this verse as evidence that *urf* or accepted custom in each country is the tool to determine how the husband/father pays for his wife and children. Permitting the diversity of customs contributes in such a way that facilitates the lives of Muslims around the world and allows for globalisation within Islamic Shariah.

²⁸¹ Abd al-Aziz Ibn Baaz: *Majmua al-Fatwah wa Makalat al-Shaykh Ibn Baaz* <<http://www.alifta.net/Search/Result.aspx?language=ar>> accessed 10 March 2014.

²⁸² Hafiz Abdul Ghani, ‘Conditions of a Valid Custom in Islamic and Common Law’ (2012) 3 International Journal of Business and Social Science 306.

²⁸³ Hafiz Abdul Ghani, ‘Conditions of a Valid Custom in Islamic and Common Law’ (2012) 3 International Journal of Business and Social Science 306. There are multiple kinds of legal custom in Islamic Shariah such as customs based on speech and customs based on practice. See, in general Hassanein Hassanein, ‘Mafhoumu al-Urf fi al-Shariah al-Islamiyyah’ (1989) 3 Journal of Shariah and Law United Arab Emirates University 97; Daoud Abdullah, ‘Athar al-Urf fi al-Fatwa wa Tatbiqatihi fi al-Buyou’a endal-Hanafiyeh’ (2008) 7 Journal of the Greatest Imam 91.

²⁸⁴ Daoud Abdullah, ‘Athar al-Urf fi al-Fatwa wa Tatbiqatihi fi al-Buyou’a endal-Hanafiyeh’ (2008) 7 Journal of the Greatest Imam 91, 93.

²⁸⁵ Hassanein Hassanein, ‘Mafhoum al-Urf fi al-Shariah al-Islamiyyah’ (1989) 3 Journal of Shariah and Law United Arab Emirates University 97, 114.

²⁸⁶ See Yusuf al-Qaradawi, *Awamil Assa’eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002) 36. For other examples see Hassanein Hassanein, ‘Mafhoum al-Urf fi al-Shariah al-Islamiyyah’ (1989) 3 Journal of Shariah and Law United Arab Emirates University 97, 125.

The third aspect which shows Islam's flexibility is that there are a number of provisions in Islamic Shariah which are very general and leave the details to the Islamic jurists to decide upon the specific provisions. For example, Islamic Shariah obliges the president of a state to consult with others. In Surah Al-Imran, 3 verse 159, God says, '[O Muhammad] ... ask forgiveness for them and consult them in the matter'.

In other words, the system of government in Islam is based on the principle of *Shura* (consultation).²⁸⁷ The Quran shows that it is compulsory to consult but does not specify a mechanism for it.²⁸⁸ Therefore, the application of this varies among Islamic countries but the differences do not contradict with Islam because Shariah has left this matter to the discretion of the authorities.²⁸⁹

A further positive aspect is the susceptibility of the Quran and Sunnah texts to a diverse understanding and interpretation. Not all texts in Islam give a direct meaning and some allow for multiple interpretations and the different application or understanding of the rules.²⁹⁰ That may be caused by multiple meanings of words which create variation in the understanding of the text.²⁹¹

Moreover, Islamic Shariah takes into account necessity and exceptional circumstances.²⁹² Islamic Shariah has created exceptional provisions for unusual circumstances that may occur. For example, in surah Al-Baqarah, 2 verse 173, God says, 'He has only forbidden to you dead animals, blood, the flesh of swine ... but whoever is forced [by necessity], neither desiring [it] nor transgressing [its limit], there is no sin upon him. Indeed, Allah is Forgiving and Merciful'. Another example is that if a Muslim was

²⁸⁷ In Surah al-Shura, 45, verse 38, God says, '... and whose affair is [determined by] consultation among themselves'.

²⁸⁸ See, in general, Ali al-Mawardi, *al-Ahkam al-Sultaniyyah* (Dar Ibn-Qutaiba 1989); Khalid Jassim, 'Al-Shoura wa Ahkamuha fi Nezam al-Hukm al-Islamy' (2010) 66 *Al-Mustansyriah University-Journal of College of Basic Education* 259. See also Sarmad Ahmed, 'Ashourweh wa Ahkamuha fi Nezam al-Hukm al-Islamy' (2010) 24 *Journal of the Islamic University* 29. It must be emphasised that *Shura* from the Islamic perspective is not the same in Western democracy. There are points of similarity and difference between them. However, this issue is heavily debated among researchers in the field of Islamic policy. See Ali Mourad, 'Al-khitab al- Assiyasi al-Islamy bin Shura wa Dimokratia' (2007) 35 *Journal of Political Science* 117.

²⁸⁹ Yusuf al-Qaradawi, *Awamil Assa'eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002) 41.

²⁹⁰ Hamad Alsadei, *Asbabu Ikhtilafi-il Fuqaha'a fi al-Forou al-Fiqhiyyah* (Islamic University of Medina 2011) 82.

²⁹¹ Ali al-Kafeef, *Asbaab Ikhtilaf-ul-Fuqaha* (2nd edn, Dar al-Fiker al-Araby 1996) 106. For example, the word *Qurooa* has two different meanings in Arabic, the 'menstrual period' and the 'end of the period', so the scholars have different understanding of texts in respect to this word, and therefore their rules vary. See Hamad Alsadei, *Asbab al-Ikhtilaf al-Fuqaha'a fi al-Forou al-Fiqhiyyah* (Islamic University of Medina 2011) 84.

²⁹² Hassan Khattab, 'Qa'aedat al-Zaroorat Tubeeh al-Mahthourat' (2009) 2 *The Journal of Usool al-Nawazel* 160.

going to perish from thirst and could not find anything to drink except alcohol, Islamic Shariah permits him to drink it to survive.²⁹³ Further evidence that Islam is flexible is that Islamic Shariah permits *fatwas* (legal opinions) to be introduced and these vary according to place, time, case and custom.²⁹⁴ One of the clearest examples of how they vary is given in the Sunnah where a young man asked the Prophet (PBUH) if he could kiss his wife during the day in Ramadan.²⁹⁵ The Prophet (PBUH) replied that the act was forbidden but when an old man asked the same question the answer was that the act was permissible. The scholars explain this contradiction by saying that the Prophet (PBUH) took into consideration the age of the person answering the question as the ability to control the sexual desire of young people is less than of an older person.²⁹⁶ Another example is that the punishment for drinking alcohol varies according to the circumstances of each case.²⁹⁷

These are the most prominent reasons behind the diverse provisions and their application in the Islamic world. This flexibility means that Shariah has the ability to meet the requirements for each period of time or place and for all societies throughout history. In short, Islam allows multiplicity and diversity of judgments without violating the basic principles of the Islamic religion. It is worth noting that Islamic principles are not just about what is *halal* and *haram* (lawful and forbidden), there are also other orders which are not compulsory. The orders in Islamic Shariah are made up of five main kinds: 1. *Wajib* (compulsory/obligatory); 2) *Mustahabb* (desirable or recommended), ordered without obligation; 3) *Halal* (lawful/allowed); 4) *Makruh* (hateful/unbecoming), disliked but not forbidden; 5) *Haram* (unlawful), prohibited and punishable from the viewpoint of Islam.²⁹⁸ This indicates that some Islamic Shariah provisions are mandatory and others are optional. This adds a new element in explaining the variation of its application among Muslims.

²⁹³ Hassan Khattab, 'Qa'aedat al-Zaroorat Tubeeh al-Mahthourat' (2009) 2 The Journal of Usool al-Nawazel 160.

²⁹⁴ Imam Ibn al-Qayyim commented on this subject and has dedicated a full chapter to explain it. He gives evidence, terms and reasons for changing fatwa. He made the point about their flexibility. See Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al-Jawziyy 2002) 337.

²⁹⁵ Ramadan is one of the five fundamental pillars in Islam and in this month Muslims fast and do not have sex from dawn to sunset.

²⁹⁶ It is forbidden for a Muslim man to have intercourse with his wife during the day in the month of Ramadan. Anas Ibn Mal, *Muwatta Malik*, vol 2 (Mustafa Babi al-Halabi 1985) *Hadith* no 19, 293.

²⁹⁷ Imam Ibn Al-Qayyim gives a number of examples to prove that changing fatwas is part of the Shariah system. See Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al-Jawziyy 2002) 337 and see also Yusuf al-Qaradawi, *Awamil Assa'eh wal-Murounah fi al-Shariah al-Islamiyyah* (The Supreme Consultative Committee on the Implementation of the Provisions of Muslim Shariah Law 2002) 81. See in the same context, Art 39 of the Majallah el-Ahkam-I-Adliya which states that: 'It is an accepted fact that the terms of law vary with the change in the times'. Majallah el-Ahkam-I-Adliya (Beirut 1884).

²⁹⁸ Abdulla Al-Baidawi, *Minhaj al-Wusul ela Ilm al-Usul* (Risala 2006) 18.

The apparent discrepancy in the application of the Islamic Shariah rules in Islamic communities around the world is not real. The fact is that this variation is part of the system of Islamic legislation. Islam gives flexibility to scholars to use the provisions that suit the circumstances of the community under the umbrella of the main rules of Islamic Shariah which cannot be changed or violated.

3.4 Intellectual property in Islamic Shariah

This section explores the position of Islamic Shariah in relation to intellectual property rights by analysing the legal elements which are relevant to these rights in the Islamic legal system.

3.4.1 Overview and background

The main Islamic Shariah sources do not have clear and direct rules that regulate intellectual property rights in its modern sense.²⁹⁹ There is also unanimity amongst the modern Muslim scholars that the legal term ‘intellectual property rights’ is entirely unknown in Islamic jurisprudence and is therefore a new subject matter in Islam.³⁰⁰ Al-Durayni explains that the reason for the absence of this term in Islamic jurisprudence is due to the absence of intellectual rights in previous centuries in the form that we see them today. Likewise, intellectual creativity did not have the effect, development and maturation that it does today.³⁰¹ He adds that this does not mean that earlier Muslims made no substantial or important innovations as it is clear that Muslim scholars had no need to research this matter to produce legal principles to govern the issues related to intellectual property because of the absence of this type of right.³⁰²

The modern Muslim scholars began to give consideration to intellectual property rights (including trade marks) towards the end of the last century in an attempt to understand

²⁹⁹ See, Muhammad Shalash, ‘Hoquouq al-Melkyat al-Fikriyah bayn al-Qanun wal-Fiqh’ (2006) 3 Najah University Journal for Humanities Research 767, 778; Ihsan Samara, ‘Mafhoum Hoquouq Al-Milkiyyah al-Fikriyah wa Zawabetuha fi al-Islam’ (2005) 8 Journal of Human Sciences 1, 11.

³⁰⁰ According to Lemley, from a historical perspective, the Western legal system only began to use the term intellectual property and start to set rules to govern it in the 19th century. He states that the definition of intellectual property set out in the WIPO has significantly contributed to the term becoming used widely. Mark Lemley, ‘Property, Intellectual Property, and Free Riding’ (2005) Texas Law Review 1031, 1034. See the WIPO Convention Art 2(viii) which defines the term ‘intellectual property’. Ali Almahhdawi, ‘Al-Milkiyyah al-Fikriyah fi Mizan al-Maqased (Dirasah Muqaranah)’ (2008) 3 Kuwait University Journal of Law 265, 307; Muhammad Shalash, ‘Hoquouq al-Milkiyyah al-Fikriyah bayn al-Qanun wal-Fiqh’ (2006) 3 Najah University Journal for Humanities Research 767, 778; Ihsan Samara, ‘Mafhoum Hoquouq al-Milkiyyah al-Fikriyah wa Zawabetuha fi al-Islam’ (2005) 8 Journal of Human Sciences 1, 11.

³⁰¹ Fethi Derein, *Haqul Ibtikar fi al-Fiqh al-Islamy Almuqaran* (2nd edn, al-Resala 1981) 7.

³⁰² Fethi Derein, *Haqul Ibtikar fi al-Fiqh al-Islamy Almuqaran* (2nd edn, al-Resala 1981) 7.

it and to find out what principles could regulate it in Islamic Shariah rules.³⁰³ A serious attempt was observed in the 1970s when Fathi Dereini published his book entitled *Haqul Ibtikar fi al-Fiqh al-Islamy Almuqaran* (The Right of Innovation in Comparative Islamic Jurisprudence).³⁰⁴ The book included a discussion on moral rights from the perspective of Islamic Shariah. Since then, there have been a number of academic research papers that have considered the position of intellectual property rights including trade marks and their position in Islamic Shariah.³⁰⁵

In addition, in 1988 and as a result of the growing interest in this topic nationally and internationally, a conference was organised by the International Islamic Fiqh Academy to put intellectual property rights under the spotlight and to encourage discussion of the subject.³⁰⁶ The result was that many *fatwas* were issued by Muslim scholars (and a general *fatwa* from the Academy) on the subject of intellectual property rights. It is worth stating that a *fatwa* may be issued by one person, a *Mufti*, or by a committee called a Fatwa Committee which comprises a number of *muftis*. For example, in Saudi Arabia there is the General Presidency of Scholarly Research and Ifta,³⁰⁷ and it is the only entity responsible for issuing *fatwas* in Saudi Arabia.

From reviewing the Islamic literature on intellectual property rights, it is clear that the number of books and academic research that discuss this subject, and in particular, trade marks within Islamic Shariah, is relatively limited. In addition, the majority of scholars who have written about this matter focus on copyright and do not give attention to other forms of intellectual property. Most authors only casually refer to other types of intellectual property without any detailed discussion. Khoury explains the issue of copyright in the Middle East from a historical perspective stating that copyright emerged from the Arab special appreciation of poetry and thus the need to safeguard the intellectual property of poets.³⁰⁸ Moreover, there is a lot of confusion and misunderstanding about the subject of intellectual

³⁰³ Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyeh' (Iktisad al Islami, Umm Al-Qura University, Saudi Arabia, May 2005) 9.

³⁰⁴ Fethi Derein, *Haqul Ibtikar fi al-Fiqh al-Islamy Almuqaran* (2nd edn, al-Resala 1981).

³⁰⁵ Intellectual property rights in Islamic Shariah have been discussed by several researchers, and as cited in the literature, Derein's book is the most important. See, for example, Muhammad Murad, *Hemayat al-Milkiyyah al-Fikriyah min al-Manthour al-Islamy* (Kitab Al Riyadh 2003) 110. Ida Madieha BT. Abdul Ghani Azmi, 'Intellectual Property Laws and Islam in Malaysia' (PhD Thesis, Queen Mary University 1995) 8.

³⁰⁶ The International Islamic Fiqh Academy is one of the most important and well-known Islamic institutions which follow the Organisation of the Islamic Conference (OIC).

³⁰⁷ The General Presidency of Scholarly Research and Ifta, <alifta.net/default.aspx?language=ar#1> accessed 10 October 2013.

³⁰⁸ Amir Khoury, 'Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trade Marks' (2013) 43 The Journal of Law and Technology 151, 153.

property rights by some scholars (especially the early scholars) in their literature. For example, they considered that there was no real difference between a trade name and a trade mark. To illustrate this, Muhammad Al Bouti defined a trade name as a good's brand name or store name.³⁰⁹ Amin argues that the term trade name includes store name, trade mark and goodwill because this term is a comprehensive one.³¹⁰ In other words, the early Islamic literature in this area was not accurate in determining the meaning of the terms.

This lack of certainty is confirmed by Mohamed Al-Farfoor during the discussion of papers related to trade name and intellectual property rights in Islamic Shariah that was submitted to the International *Fiqh* Islamic Academy.³¹¹ He said that the basic problem is the lack of knowledge of the Shariah scholars in the field of intellectual property matters in general, including trade mark, because these issues are new for Islamic jurisprudence.³¹²

In short, it can be said that intellectual property rights is a new subject that does not have any direct provisions in the key Islamic Shariah sources (Quran and Sunnah). Therefore, modern Muslim scholars have tried to find the Islamic rules that regulate these rights. In order to have a better understanding of the intellectual property rights within Shariah, the following section analyses the term by exploring the concepts of *al-fikriyah* (intellectual), *milkiyyah* (ownership), *mal* (property) and *haqq* (right) in Islamic Shariah.

Before moving on to the next stage, it should be noted that, Islamic jurisprudence uses the term *milkiyyah* in reference to legal transactions and *mal* in the context of property rights. Therefore, in order to avoid confusion, I will do the same.³¹³

³⁰⁹ Muhammad Bouti, *Al-Hoquq al-Ma'nawiyah: Haqq-ul Ebda'a-ul Elmy wa Haqq-ul Esm Altijaari'* (1988) 5 Journal of Islamic Fiqh Academy 2397, 2407.

³¹⁰ Hassan al-Amin, 'Bai' Esm al-Tijaari wa-Tarrkhees' (1988) 5 Journal of Islamic Fiqh Academy 2495, 2497, 2500.

³¹¹ Mohamed Al-Farfoor, 'Qasim al-Monakashat' (1988) 5 Journal of Islamic Fiqh Academy 2543.

³¹² Mohamed Al-Farfoor, 'Qasim al-Monakashat' (1988) 5 Journal of Islamic Fiqh Academy 2543. In this context, Al-Farfoor suggested that the Academy should utilise legal professionals and traders to act as a consultative body to the Shariah scholars and not to limit the discussions to only those between Shariah specialists. Al-Farfoor believes that to come to the right opinion in any subject, it is of benefit to the Academy to listen to experts in a particular field as the Shariah scholars cannot be knowledgeable on all subjects. Mohamed Al-Farfoor, 'Qasim al-Monakashat' (1988) 5 Journal of Islamic Fiqh Academy 2544.

³¹³ Muhammad Abd al-Monem, *Mujam al-Muṣṭalahat Alfaz al-Fiqh al-Islami* (vol 2, Dar al-Fasila 1999) 191, 216.

3.4.2 The concept of *fiker* (intellect)

Thinking uses the intellect to know the unknown in order to perceive the reality of things and judge them.³¹⁴ Thinking is also defined as using the intellect on an unknown matter and to organise matters in the mind to arrive at real knowledge.³¹⁵

The Quran mentions in several verses the importance of thought and clarifying meanings. In Surah al-Anam, 6 verse 50 God said, 'Say, Is the blind equivalent to the seeing? Then will you not give thought', and in Surah al-Hashr 59 verse 21 God said, 'And these examples we present to the people so that perhaps they will give thought'. Other verses call for people to utilise their intellect and thoughts to understand the real meaning of the Islamic faith.³¹⁶ These verses in their context imply the meanings of pondering and thinking and they go beyond it, i.e. thought being an examination and utilising the mind, judging the reality and perceiving it. The verses also clarify that thinking does not occur except by research and studying things and the presence of knowledge for the purpose of perception is its reality.³¹⁷

Islam is a religion that urges people to gain knowledge and to think creatively in all fields of science, whether religious or secular.³¹⁸ For example, the Prophet (PBUH) said: 'Allah Almighty did not create an illness but that He made a cure for it, known to some and unknown to others ...'.³¹⁹ This *Hadith* encourages scientific researchers to find cures for all diseases as it suggests that this is possible but requires effort and investigation. Throughout history, the rulers of Islamic countries have had great respect for scholars and have relied upon them for advice.³²⁰ They used to pay Muslim and non-Muslim scholars in order to help them to devote themselves to seek knowledge in different areas such as scientific research, writing, innovation and education.³²¹

³¹⁴ Ihsan Samara, 'Mafhoum Hoquouq al-Milkiyyah al-Fikriyah wa Zawabetuha fi al-Islam' (2005) 8 Journal of Human Sciences 1, 28.

³¹⁵ Al-Waseet (2010) <almaany.com/appendix.php?language=arabic&category> accessed 24 October 2013.

³¹⁶ See Surah al-Haj 22, verse 73. See also, Surah al-Baqarah 2 verse 164.

³¹⁷ See in general, Abu Hamid Ghazali, *El-tafakor fi Khalki el-Allah* (Dar al-Fiker 1995).

³¹⁸ Prophet Mohamed (PBUH) said that 'the angels spread their wings to the knowledge seeker in favor to what he is doing'. Abdul Razzaq San'aani, *Musanaf Abdur-Razeq* (al-Maktab al-Islamy 1970) 17727, 17628.

³¹⁹ Sulaiman al-Tabarani, *Al-Mujam al-Awsat* (Dar Al Haramain 1995) *Hadith* no 3699, 97.

³²⁰ Ibrahim Neama, *Baqat Alouroud al-Ndhrah min Hkayat al-Mslmin al-Atrah* (Dar al-Nafaes 1989) 45. The first word of the Quran that was revealed to the Prophet Muhammad (PBUH) was 'Read'. In surah al-Alaq, verse 1, 3, 4. God commanded: 'Read! In the Name of your Lord Who has created ... Who has taught (the writing) by the pen He has taught man that which he knew not.'

³²¹ Ragheb Elsergany, *Matha Qaddam al-Muslimoun lil-Aalem* (4th edn, Iqra 2010) 47. It is well-known that there were many scientific breakthroughs by Muslim scholars in the fields of astronomy, medicine, mathematics and law as well as scientific inventions which are still relevant in present times. See, Tawfiq Alaozpk, 'Al-Hazarah al-Alarabia fi Alndalus wa Atharuha fi Uroubeh' (2010) 5 Majallat Thaqafatna li Dirsat wa al-Bohouth 119, 125, 132.

In short, thinking and creativity for Muslims is an essential part of Islamic faith. Everyone should act on this according to his ability and as a result of that Muslims worship God through research and by gaining useful knowledge.³²²

3.4.3 *Milkiyyah* (ownership)

The need for exclusive ownership is part of human nature so Islam has organised this instinct in a way that is designed to benefit individuals and society in general and to find a balance between private and public interests; Islam has always recognised individual ownership and encourages it.³²³ The right to ownership in Islam is that an individual can own any type of property without having to share it with another person. He has the right to protect it or dispose of it but this action must be carried out according to Islamic Shariah principles.³²⁴ In this context, it must be emphasised that in Islam, God is the owner of all properties and the people's ownership is granted by Him. In Surah Hadeed, 57 verse 7, God says, 'Believe in Allah and His Messenger and spend out of that in which He has made you successive' and in Surah Nur, verse 33, God says 'and give them from the wealth of Allah which He has given you.' This Quranic verses illustrate that everything in this world belongs to God and the right of ownership is a God-given. Accordingly, it should be used in accordance with God's will and rules.

Ibn Taymiyyah defined ownership as the legitimate authority for disposition of a chattel, i.e. to dispose of an item through sale, hire, pledge or other forms of disposal.³²⁵ Taj al-Din al-Subki states that ownership is the authority of a person over a thing whether it is an object or its usufruct.³²⁶ In general, the classic scholars divided ownership into two main categories (1) the complete ownership, where the owner has the full and exclusive rights of enjoyment/ usufruct and the right of absolute disposal and benefits as he owns the object and its usufruct. In addition, complete ownership is permanent. (2) Incomplete ownership, the owner in this case may own just the object or the usufruct but not both.³²⁷ In this type of ownership, it is obligatory that the contract is temporary and indicative of the period, place and type of the

³²² Muhammad al-Hassan, 'Atta'aleef wal-Ibtikar: Mafhoum al-Hoquq bayna al-Shariah wal Qanun' (2010) 30 Majalat dirasat al-Ijtima'iyah 237, 241.

³²³ Abdullah Younis, *Al-Milkiyyah fi al-Shariah al-Islamiyyah wa Dawroha fi al-Iqtisad al-Islami* (Muassasat Shabab al-Jamiah 1998) 81.

³²⁴ Abd al-Hadi al-Najjar, *Al-Iqtisad al-Islami* (Kuwait University 1989) 521.

³²⁵ Ahmed Ibn Taymiyyah, *Majmoua al-Fatawy*, vol 19 (Qurtuba 1969) 21.

³²⁶ Jalal al-Din al-Suyuti, *Ala al-Ashbah Wal-Nazair* (Dar Al Kotob Al Ilmiyah, 1983) 326.

³²⁷ *ibid* 326.

usufruct such as lease contracts.³²⁸ Moreover, in specific cases, the incomplete ownership can become complete after a certain period of time or under certain circumstances. For instance, a person who is under age can gain full ownership rights over his/her properties after reaching the legal age of responsibility.³²⁹ Based on the above, it can be said that the term ownership is more comprehensive than the term property as the ownership includes the property and the usufruct.

Modern Muslim scholars tried to explain the concept of ownership in more details. Abbadi states that ownership is a legal connection between a person and a thing which grants him disposition of it and restricts others from employing this right.³³⁰ This means that 'ownership' is a legal rule, i.e. an attribute which is connected to legal causes, and as such it is an intangible determination which is not perceptible. Despite that, it is only associated with objects and usufruct and does not have an independent existence; the effect of ownership is to enable the owner to benefit from his property.³³¹ These juridical definitions have in common an explication of the relation between the owner and the owned and that he (the owner) is privileged by his ownership, and this privilege confers upon him the right of absolute disposal and benefit, and prevents others from disposition of the same item. This is the reality of the meaning of privilege, and is what the meaning of ownership is based upon.³³²

Ghamidi clarifies the meaning of ownership by explaining that it is the privilege of the owned thing which prevents anyone other than the owner from benefiting from the item or disposing of it, except through his person, or by way of his agent or legal attorney.³³³ He then details the meaning of ownership: (1) the ownership of objects and usufruct, irrespective of whether they are considered to be property or not; and (2) the ownership of rights of all kinds be they financial or not, whenever an individual is privileged in such a way that it grants him the power to restrict and prevent others from benefiting from them and that he has an executive mandate.³³⁴

It should be noted that even the Hanafis restrict *mal* (property) to tangible things which can be stored. This means that they do not consider the usufruct as *mal*, however,

³²⁸ See al-Mawsu'ah al-Fiqhiyyah (2nd edn, 2000) vol 39, 36.

³²⁹ Mustafa al-Zarqa, *Almdkhl Alfkhī Ala'am* (Dar al-Kalem 1998) 334.

³³⁰ Abdul Salam Abbadi, *Al-Milkiyyah fi al-Shariah al-Islamiyyah* (Aqsa Library 1974) 52.

³³¹ Ali Asiri, 'Hoquq al-Milkiyyah al-Fikriyah fi al-Shariah al-Islamiyyah' (2004) 2 Journal Umm Al-Qura University 179, 181.

³³² Ali Alkafeaf, *Al-Milkiyyah* (Dar al-Fiker al-Araby 1996) 19.

³³³ Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyeh, Umm Al-Qura University, Saudi Arabia, May 2005) 16.

³³⁴ Ali Alkafeaf, *Al-Milkiyyah* (Dar al-Fiker al-Araby 1996) 22, 23.

Hanafis recognise that the usufruct can be owned but it still not property *mal*.³³⁵ On the other hand, the majority of Muslim scholars do not make a link between tangibility and ownership or property.

To make it clear, there is consensus among the four schools of thought in ownership not only on tangibles but also on intangibles. Nevertheless, the differences between the majority of scholars and some of the Hanafis scholars (such as Muhammad Ibn Abidin can be seen in the case of the debt ownership as a form of intangible assets.³³⁶ Malik, Abu Hanifa and Shafi consider the debt as property which can be owned while the majority of Hanafis agree that ownership can be over debt but they do not consider it as property as they distinct between the concepts of *milkiyyah* (ownership) and *mal* (property).³³⁷

Islamic Shariah protects ownership by administering a strict punishment when property rights are breached.³³⁸ For example, in Surah, Maidah, 5 verse 38, God says in the Quran, ‘the thief, the male and the female, amputate their hands in recompense for what they earned’. Islam urges people to defend their property even if they die whilst defending it. The Prophet (PBUH) said ‘Whoever is killed defending his wealth, he is a martyr’.³³⁹ All of the above shows the importance that Islam places on property rights.

In summary, ownership in Islamic Shariah is the power a person has over a thing for usage and the right of disposal and to benefit from it in all manners approved of by the law. However, it is necessary to emphasise that Islamic Shariah has taken into consideration societal benefit and that ownership should not lead to public or general harm. This is based upon the general principle that whatever is owned by a person is in principle owned by God. As such, ownership performs a societal role and is not a personal characteristic in Islam.³⁴⁰ This means that ownership is for *Allah* and utility is for people.³⁴¹

In relation to intellectual property, it can be understood that Islamic Shariah permits private ownership and restricts property ownership not only on tangibles but also on

³³⁵ *ibid.* 28, 29.

³³⁶ Ajeel Annashmi, ‘Al-Haqq al-Ma’anawy: Al-Esm al-Tejaari’ (1989) 13 Kuwait University Journal of Shariah and Islamic Studies 353.

³³⁷ *ibid.*

³³⁸ Muhammad Yasin, *Al-Jareemeh wal-Uqoubatu fi al-Islam* (Kuwait University 1989) 178.

³³⁹ Hafiz Abu Dawud, *Sunan Abi Dawood*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2007) *Hadith* no 4772, 253.

³⁴⁰ Bashar Malkawi, ‘The Alliance Between Islamic Law and Intellectual Property: Structure and Practice’ (2013) 10 Thomas Law Journal 618, 623. Ali Alkafeaf, *al-Milkiyyah* (Dar al-Fiker al-Araby 1996) 34.

³⁴¹ Hayatullah Laluddin and others, ‘Property and Ownership Right from an Islamic Perspective’ (2012) 6 Advances in Natural and Applied Sciences 1125.

intangibles. Malik, Abu Hanifa and Shafi agree that ownership can be over usufruct; therefore, it can be stated that the ownership of usufruct relating to trade marks is acceptable from the Shariah perspective. Consequently, the owner of a mark has the full right of disposition over the mark and this includes the trade mark assignment and licensing i.e. the trade mark owner has the right to grant a third party permission to use the mark. It also tries to find a balance between public and private benefit. In brief, Islamic Shariah recognises the ownership of intellectual property rights. Moreover, temporary ownership in the field of intellectual property is not seen as a problem since Islamic Shariah does make permanent ownership mandatory or a condition of ownership.³⁴² In brief, Islamic Shariah recognises the ownership of intellectual property rights including trade mark.

Therefore, in principle, according to the modern application of classical Shariah principles, it can be said that there are no legal issues in Islamic Shariah with respect to the concept of ownership and intellectual property rights. However, in order to reach a thorough understanding of the relationship between ownership and intellectual property right within Shariah, it is important to explore the concept of *mal* (property) in Islamic Shariah.

3.4.4 *Mal* (property)

With regard to *mal*, there is a difference in views amongst classic scholars. The two well-known opinions are of the Hanafis and of the majority.³⁴³

Hanafis restrict *mal* (property) to physical property which can be stored, thus creating a correlation between property and it being tangible.³⁴⁴ As mentioned earlier, the majority of Muslim scholars do not make a correlation between tangibility and property. This means that usufruct, according to them, is regarded as property as well.³⁴⁵

Property according to the majority is all property which has an exchange value between people according to their customs.³⁴⁶ Likewise, Khafif has stated that the majority of scholars have regarded property to be a characteristic of an object based upon the custom of people and their taking it as an item in which they trade. It is not necessary to be a physical

³⁴² Abdul Salam Abbadi, 'Al-Fiqh al-Islamy wal-Hoquq al-Ma'anawiyeh' (1988) 5 Journal of Islamic Fiqh Academy 2467, 2473.

³⁴³ The majority in this case means the schools other than the Hanafi School. Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyeh' (Iktisad al Islami, Umm Al-Qura University, Saudi Arabia, May 2005) 20, 22.

³⁴⁴ Ali Alkafeaf, *Ahkam al- Moamalat al-Islamiyyah* (Dar al-Fiker al-Araby 2008) 28, 29.

³⁴⁵ Abdul Salam Abbadi, 'Al-Fiqh al-Islami wal-Hoquq al-Ma'anawiyeh' (1988) 5 Journal of Islamic Fiqh Academy 2467, 2474.

³⁴⁶ Muhammad Islam, 'Al-Mal: The Concept of Property in Islamic Legal Thought' (1999) 14 Arab Law Quarterly 361, 368.

item which can be stored for future contingencies but it should be easy to acquire at the time of need, and this is also the case for usufruct.³⁴⁷

In this context, and explaining the views of the majority of the scholars, Abbadi has stated that the majority of the classic Muslim scholars expanded the scope of property to whatever is of material value to people and its utility is legally permissible in conditions of ease and free choice, and its usurper or destroyer is held liable.³⁴⁸

In short, according to the majority of classic and modern scholars, there are two conditions that can be used to differentiate between items with regard to whether or not they are property. The first is that it should have monetary value, whether it is physical or usufruct (*manfah*), the second is that its utility should be legal.³⁴⁹

Therefore, it can be seen that the method of the majority of the scholars in constructing the concept of a thing being property based upon its legal utility and it having a monetary value among people³⁵⁰ creates flexibility in the concept of property and makes this understanding of property capable of being developed and modified with the passage of time. This also expands the scope of property so that it incorporates new forms of property in this age which were unknown in previous times.³⁵¹

It can be concluded that an intellectual property right is a type of intangible right (in the form of an usufructuary right) and is not regarded as property by the Hanafis³⁵² due to the condition of physicality not being fulfilled. In contrast, these rights are regarded as property by the majority of Muslim scholars because they have not regarded the physicality of the property and because people have accepted these in their customs. Further, they represent for them a material value due to them being intangible utilities, with the condition that their utility is legal and in accordance with Islamic Shariah.³⁵³

³⁴⁷ Ali Alkafeaf, *Ahkam al-Moamalat al-Islamiyyah* (Dar al-Fiker al-Araby 2008) 30.

³⁴⁸ Abdul Salam Abbadi, 'Al-Fiqh al-Islami wal-Hoquq al-Ma'anawiyeh' (1988) 5 Journal of Islamic Fiqh Academy 2467, 2478.

³⁴⁹ Abdul Salam Abbadi, 'Al-Fiqh al-Islami wal-Hoquq al-Ma'anawiyeh' (1988) 5 Journal of Islamic Fiqh Academy 2467, 2474.

³⁵⁰ Ali Almahhdawi, 'al-Milkiyyah al-Fikriyah fi Mizan al-Maqased (Dirasah Muqaranah)' (2008) 3 Kuwait University Journal of Law 265, 309; Ahmed Youssef, 'Bai' al-Hoquq al-Ma'anawiyeh' (2011) 23 King Saud University-Journal of Islamic Studies 1055, 1070.

³⁵¹ Ahmed Youssef, 'Bai' al-Hoquq ul-Ma'anawiyeh' (2011) 23 King Saud University Journal 1055, 1070; Hassan al-Amin, 'Bai' Esm al-Tijaari wa-Tarrkhees' (1988) 5 Journal of Islamic Fiqh Academy 2495, 2502.

³⁵² Muhammad Shalash, 'Hoquq al-Milkiyyah al-Fikriyah bayn al-Qanun wal-Fiqh' (2006) 3 Najah University Journal for Humanities Research.

³⁵³ Abdel Samie Imam, *Nazarat fi Usol Al-Byou' al-Mamnou'ah fi al-Shariah Al-Islamiyyah wa Mawqif Al-Qawaneen minha* (The Ministry of Awqaf and Islamic Affairs, Kuwait 2012) 26.

3.4.5 The *haqq* (right) in Islam

The term *haqq* has many different uses in the Arabic language.³⁵⁴ Muslim scholars use this term to describe different types of 'right'.³⁵⁵ It is also considered to be one of the names of God and is used in the Quran more than two hundred and fifty times in different contexts.³⁵⁶

Abbadi states that, traditionally, most classic scholars did not specifically define what a right is because the meaning is clear and does not require an explanation.³⁵⁷ However, there have been some attempts to define the term, particularly by modern scholars. The most well-known definition is by Khafif who defines a 'right' as a benefit granted by the legislator, God, to the individual or individuals; the right is anything that has benefit and is protected by law.³⁵⁸ Rights are seen as a gift from God to enable people to organise their lives as He is the owner of all rights.³⁵⁹

In Islamic jurisprudence, there are multiple typologies of rights.³⁶⁰ One of the most important among them, and relevant to the subject of the discussion, is the type which is based on the subject matter of the right *mahal al-haqq*, particularly, financial rights.³⁶¹

The subject matter of rights is divided into two main categories namely financial rights and non-financial rights.³⁶² Financial rights relate to the ownership of *mal* (property).³⁶³ There are three types: (1) the right to commitment, i.e. a right recognized by law arising from the contract of sale where the seller has committed to deliver the thing sold

³⁵⁴ Literally, *haqq* in Arabic has several meanings such as truth, correctness, property, and authentic. *Dictionary of Modern Written Arabic* (3rd edn, J Milton Cowan 1976) 192.

³⁵⁵ Nasser al-Ghamdi, 'Hemayat al-Milkiyyah al-Fikriyah fi Fiqh wa Atharuha al-Iqtisadiyeh' (Iktisad al Islami, Umm Al-Qura University, Saudi Arabia, May 2005) 21, 22.

³⁵⁶ Academy of the Arabic Language, *Mu'jam Alwaseet* (Dar al-Shorouk International 2004) 187.

³⁵⁷ Abdul Salam Abbadi, *al-Milkiyyah fi al-Shariah al-Islamiyyah* (Aqsa Library 1974) 21, 23. According to Ali, the classical Muslim scholars put more emphasis on the literal meaning of the word (*al-haqq*) rather the legal meaning. Engku Ali, 'Re-Defining Property and Property Rights in Islamic Law of Contract' (2003) 11 *Jurnal Syariah* 47, 51.

³⁵⁸ Ali Alkafeaf, *Ahkam al-Moamalat al-Islamiyyah* (Dar al-Fiker al-Araby 2008) 31.

³⁵⁹ Ali Almahhdawi, 'Al-Milkiyyah al-Fikriyah fi Mizan al-Maqased (Dirasah Muqaranah)' (2008) 3 *Kuwait University Journal of Law* 265, 313.

³⁶⁰ For example, a right which is based on the owner of the right *sahib al-haqq*. These type of rights are divided into God's rights, people's rights and the common rights between God and the people. See Osman Althamiry, 'al Haqq fi al-Shariah al-Islamiyyah' (1993) *Majallat Al-bohouth al-Islamiyyah* 352, 362; Abdul Salam Abbadi, *Al-Milkiyyah fi al-Shariah al-Islamiyyah* (Aqsa Library 1974) 89.

³⁶¹ See Osman Althamiry, 'Al-Haqq fi al-Shariah al-Islamiyyah' (1993) *Majallat Al-bohouth al-Islamiyyah* 352, 362; Abdul Salam Abbadi, *Al-Milkiyyah fi al-Shariah al-Islamiyyah* (Aqsa Library 1974) 89.

³⁶² Non-financial rights are rights that are not related to property such as right of custody and the right of children over their parents. See, Muhammad Shabir, *Al-Maamlat al-Maliah fi al-Fiqh al-Islamy* (Dar Nafaes 1996) 36; Osman Althamiry, 'Al-Haqq fi al-Shariah al-Islamiyyah' (1993) *Majallat Al-bohouth al-Islamiyyah* 352, 361.

³⁶³ Osman Althamiry, 'Al-Haqq fi al-Shariah al-Islamiyyah' (1993) *Majallat Al-bohouth al-Islamiyyah* 352, 361; Engku Ali, 'Re-Defining Property and Property Rights in Islamic Law of Contract' (2003) 11 *Jurnal Syariah* 47, 52.

and the buyer has committed to pay the agreed price;³⁶⁴ (2) the moral right or incorporeal right is a right that cannot be perceived by the senses but is in the mind and thoughts such as inventions and innovations, usufruct rights and financial debt;³⁶⁵ and (3) the corporeal right which is an exclusive right over a tangible body where the owner exclusively benefits from it and it gives him a direct authority over that property, for example, the right of ownership over property which gives the owner the exclusive right to use, lease or sell it.³⁶⁶

As mentioned earlier, in 1988 the International Islamic *Fiqh* Academy issued a general *fatwa* recognising intellectual property rights and their financial value.³⁶⁷ As such, it can be said that nowadays there is almost a consensus amongst modern Muslim scholars that Islamic Shariah does protect and does recognise the financial rights of the intellectual property right owner. With regard to moral rights, Islamic Shariah forbids any assault on the creators' moral rights in any form and this issue is the subject of consensus between all scholars of thought.³⁶⁸ Therefore, if taking into consideration the concepts of right and property in Shariah, it can be stated that, according to the majority of scholars,³⁶⁹ owners of intellectual property rights based on Islamic Shariah provisions have the right to fully enjoy the benefits of their property financially and morally.

From the previous explanations of the concepts of *fiker* (intellect), *milkiyyah* (ownership), *mal* (property) and *haqq* (right) in Islamic Shariah, it is obvious that there is no intrinsic contradiction between intellectual property rights and the Islamic legal system. In other words, although the modern meaning of the term 'intellectual property right' is not well-known in Islamic Shariah, the preceding discussion makes it clear that the same principles and protection of rights do still exist in Islam. However, even these rights can be recognised within the Islamic regime although this recognition cannot be taken as absolute as it is subject to a set of controls.

³⁶⁴ Abdullah Younis, *Al-Milkiyyah fi al-Shariah al-Islamiyyah wa Dawroha fi al-Iqtisad al-Islamy* (Muassasat Shabab al-Jamiah 1998) 45.

³⁶⁵ Muhammad Shabir, *Al-Maamlat al-Maliah fi al-Fiqh al-Islamy*, (Dar Nafae 1996) 36; Ajeel Annashmi, 'Al-Haqq al-Ma'anawy: Al-Esm al-Tejaari' (1989) 13 Kuwait University Journal of Shariah and Islamic Studies 281, 308.

³⁶⁶ Muhammad Shabir, *Al-Maamlat al-Maliah fi al-Fiqh al-Islamy* (Dar Nafae 1996) 36.

³⁶⁷ The International Islamic Fiqh Academy, 'Qarart Rakam (5) al-Hoquq ul-Ma'anawiyeh' (1988) 5 Journal of Islamic Fiqh Academy 2549

³⁶⁸ See Amir Khoury, 'Ancient and Islamic Sources of Intellectual Property Protection in the Middle East: A Focus on Trade Marks' (2013) 43 The Journal of Law and Technology 151, 152. See Hussein al-Shahrani, *Hoquq al-Ekhtira' wa-Taleef fi al-Fiqh al-Islamy* (Dar Tiba 2004).

³⁶⁹ Maliki, Shafi and Hanbali scholars.

3.5 Conclusion

This chapter sets out the position taken by Islamic Shariah in respect of intellectual property rights. It can be understood from the above discussion that Islamic Shariah has a basic hierarchy system. The Quran and Sunnah can be found at the top as the primary and most authoritative sources. This is followed by the secondary sources of Islamic Shariah, *Ijma* and *Qiyas*. Muslims believe that God is the only lawgiver, and no one has the authority to change the rules that He has laid down. The elements and mechanisms of Islamic legislation allows it to be adapted and made appropriate to modern life and different eras and environments.

This chapter has shown that the primary sources of Islamic Shariah do not include any texts or direct provisions that regulate intellectual property rights. In the late 20th century, modern Muslim scholars began to consider the issue of intellectual property rights more and the focus was on copyright in particular. The early literature issued by Muslim scholars was not clear on the different types of intellectual property. This chapter has also shown that private ownership is recognised and protected in Islamic Shariah. The majority of Muslim scholars consider the notion of property as both physical and non-physical matters. The vast majority of contemporary Muslim scholars have clear legal opinions and agree that the rules of Islamic Shariah acknowledge and work to protect financial and moral intellectual property rights.

The following chapter explores the place of trade marks and their use in Islamic history. In addition, the chapter will discuss the Islamic criteria for the main types of trade mark and will analyse the protection it assures to the holder of the trade mark right. This will all act as a point of comparison with trade mark provisions in TRIPS.

Chapter Four

The Trade Mark in Islamic Shariah

4.0 Introduction

After discussing and identifying the perspective of Islamic Shariah on intellectual property rights in the broad sense in the previous chapter, this chapter aims to explore the Islamic Shariah provisions regarding trade mark recognition and protection in the light of the TRIPS Agreement. It also examines a different set of materials and principles in order to clarify the stance of Shariah law on how trade marks may be used, justified and protected within the Islamic legal system.

Significant and controversial marks and their legal protection are the main subjects in this chapter. The chapter commences by outlining the notion and the development of the legal ideas similar to trade mark in Islamic history. The reason for this is that Islamic historical events are important in order to understand the substance of Islamic Shariah provisions. The second section looks at the most important forms of marks which are evaluated and judged according to provisions set by Shariah. The section looks first at the word mark and discusses it before moving on to discuss the name mark. After that, pictures and non-traditional trade marks are explored. The third section discusses the rules and the requirements of the trade mark legal protection provided by Islamic Shariah, whether it is criminal or civil. For the criminal aspect of Islamic Shariah, the prohibition of fraudulent acts and the punishment for trade mark infringement is discussed, followed by the rules governing civil compensation of trade mark infringement in terms of the civil aspect.

However, before moving on to the next section, it is important to note that Islam sets down an essential rule which is that everything is permitted in Islam and it is only exceptions which are prohibited.³⁷⁰ The Prophet (PBUH) said that: ‘The lawful is what Allah made lawful in His Book, the unlawful is what Allah made unlawful in his Book, and what He was silent about; then it is among that for which He has pardoned’.³⁷¹ Thus, it can be seen that the circle of permissibility in Islam is larger than the circle of what is forbidden.³⁷² This rule can be applied to the case of trade marks as there is no legitimate reason to exclude it.

³⁷⁰ See, in general, Ahmed Alazaviha, *Qaedat al-Aseli fi alAsha al- Ebaheh* (Imam Muhammad ibn Saud Islamic University 2007); Ahsan Khan Nyazee, *Outlines of Islamic Jurisprudence* (Advanced Legal Studies Institute 2010) 193.

³⁷¹ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 3 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 1726, 456.

³⁷² Ahmed Alazaviha, *Qaedat al-Aseli fi alAsha al- Ebaheh* (Imam Muhammad ibn Saud Islamic University 2007) 137. For example, Islamic Shariah permits Muslims to drink any kind of drink except anything that is alcoholic as has been explained in numerous places in the Quran and Sunnah. The Prophet (PBUH) said,

4.1 Defining ‘Trade mark’ in Islamic Shariah

Islamic Shariah does not define or provide for the idea of ‘trade marks’ in its modern sense, which is also the case for other intellectual property rights as explained in the previous chapter. As a result, trade marks are considered to be a modern issue in Islamic jurisprudence and there is nothing in the Quran or Sunnah that directly addresses this.³⁷³ In addition, there is no dictionary definition in the Arabic language for the term ‘trade mark’, and from a linguistic perspective there is no root for this term in Arabic.³⁷⁴

Most authors agree that the modern revolution in trade mark rules have strong links to the Industrial Revolution in the nineteenth century. This is due to the large growth in industries and the development that occurred to production methods.³⁷⁵ It is therefore understandable that there are no explicit definitions or direct provisions in relation to trade marks in the Quran or Sunnah which has not changed for more than 1400 years.³⁷⁶ Consequently, the absence of a definition of trade marks in Islamic Shariah is not surprising as the concept of modern trade marks was unknown in the early Muslim era. Nonetheless, as the next section shows, there are resources within the early sources of Shariah which can be deployed to cover the same topics.

4.2 Forms and uses of trade marks in Islamic history

The absence of any specific definition or clear regulation on trade marks in Islamic Shariah does not mean Muslims did not use the equivalent of trade marks in the past. In fact, historical evidence suggests a primitive form of trade marks existed in the form of branding.

‘Every intoxicant is unlawful and every intoxicant is Khamr.’ Hafiz An-Nasai, *Sunan An-Nasai*, vol 6 (Nasiruddin al-Kattab (tr), Darussalam 2008) *Hadith* no 5585, 312. From that, it is clear that the forbidden drinks in Islam are limited to mind-blinding drinks (intoxicants) whereas the permitted drinks are any other drink, which are unlimited.

³⁷³ Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, ‘Distinctive Signs and Early Marks: Europe, Africa and Islam’ (1997) 1 *Perspective on Intellectual Property* 123, 150. Salah Zinedine, *Al-Madkhalu Ila al-Milkiyyah al-Fikriyah* (Dar al-Thacafa 2004) 79.

³⁷⁴ See in this meaning, Mansour al-Mansour, ‘Al-Alamatu Attejariyeh wa Ahkamuha fi al-Fiqh wan-Nizam’ (DPhil thesis, Imam Muhammad Ibn Saud Islamic University 2002) 9.

³⁷⁵ This point has been explained clearly in Sidney Diamond, ‘The Historical Development of Trademark’ (1975) 65 *The Trademark Reporter* 265, 281.

³⁷⁶ As explained in the previous chapter, the two fundamental sources are the Quran and Sunnah, which are absolutely immutable. See Chapter Three, 3.2.

Branding or *Al-wasem* in Arabic is the closest model to the concept of trade marks.³⁷⁷ This type of branding system dates back to ancient times, where archaeological evidence indicates that this system was used by the Pharaohs in Egypt on their cattle.³⁷⁸ The book of Genesis also contains several references to branding.³⁷⁹ The early Muslims were no different in this regard; they were known to use branding on some animals according to the regulations set by Islamic Shariah on branding.³⁸⁰ Islam does set rules for branding, for example, the Prophet (PBUH) once saw a donkey whose face had been branded and he cursed those who brand animals in this way.³⁸¹

As a whole, branding can be understood as a sign of ownership either by cutting or cauterizing any part of the animal's body in order indicate the owner's ownership.³⁸² This understanding shows an element of ownership which is in line with the historical function of a trade mark.³⁸³ In general, researchers interested in trade mark history believe that branding is one of the earlier types of modern trade marks.³⁸⁴ McCarthy states that: 'Probably the earliest form of trade mark was the branding of cattle and other animals'.³⁸⁵ Branding was not just applied to cattle but also to wooden casks and in some cases to human beings such as criminals and slaves.³⁸⁶ The Arab tribes before and after Islam would chose a particular form of sign to distinguish their ownership over animals, water wells or even

³⁷⁷ See Ali Alhabrta, *Al-Jamal* (Dar al-Habrta 1990) 105; Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, 'Distinctive Signs and Early Marks: Europe, Africa and Islam' (1997) 1 *Perspective on Intellectual Property* 123, 150.

³⁷⁸ Sidney Diamond, 'The Historical Development of Trademarks' (1975) 65 *The Trademark Report*, 265; Edward Rogers, 'Some Historical Matter Concerning Trade-Marks' (1972) 62 *Michigan Law Review* 239.

³⁷⁹ Sidney Diamond, 'The Historical Development of Trademarks' (1975) 65 *The Trademark Report* 265.

³⁸⁰ See Abdullah Al-Aboudi, 'Arrefq Bilhayawan wa Tahreem zolmihi wa Ta'zibihi' (1991) 34 *Islamic Research Journal* 149, 159.

³⁸¹ It was narrated from Jabir that a donkey that had been branded on the face passed by the Prophet and he said: 'May Allah curse the one who branded him.' Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 5552, 485.

³⁸² Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 813.

³⁸³ William Browne, *Law of Trade-Marks and Analogous Subjects: Firm-names, business-signs, good-well, and labels* (Press of John Wilson and Son 1873) 4. Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 813.

³⁸⁴ Edward Rogers, 'Some Historical Matter Concerning Trade-Marks' (1972) 62 *Michigan Law Review* 239. Sidney Diamond, 'The Historical Development of Trademarks' (1975) *The Trademark Reporter* 65, 265; Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 813.

³⁸⁵ John McCarthy, *McCarthy on Trademarks and Unfair Competition* (Thomson Reuters-West 2005) chapter 5, 1.

³⁸⁶ William Browne, *Law of Trade-Marks and Analogous Subjects: Firm-names, business-signs, good-well, and labels* (Press of John Wilson and Son 1873) 4; See in general, Benjamin Paster, 'Trade Marks-Their Early History' (1969) 59 *Trademark Reports* 551; Rex Brown, 'Rex Brown the Effect of the European Common Market on Trade Mark' (1959) 49 *The Trademark Reporter* 515, 527.

goods.³⁸⁷ Even up to the present, people who have originally descended from one of those tribes still have pride in the sign of their tribe.³⁸⁸

Branding was of great importance for the early Muslims and other ancient nations as the majority of people were illiterate. In Surah Al-Jumuah 62, verse 2, God says, 'It is He who has sent among the unlettered [Arabs] a Messenger from themselves'.³⁸⁹ In brief, most commentators consider that branding is the root of trade marks and not just a system that resembles trade marks.³⁹⁰ In other words, the terms 'brand' and 'trade mark' are synonymous.³⁹¹ In addition, it can be said that branding is not considered to be contrary to Islamic Shariah; the Prophet (PBUH) himself would brand cattle.³⁹²

With the growth of Islamic civilization, trade mark forms and uses developed and became strongly linked to determining the origin of products, which is seen as the key function of a trade mark.³⁹³ This is illustrated by many different examples, such as manufacturers who use special symbols or signs on the weapons they make to demonstrate that they were made by them.³⁹⁴ In particular, some sword makers would put their name and the date of manufacture on the sword because they wanted to distinguish their product from other makers' products as this could affect the value of the sword.³⁹⁵

Ownership marks in Islamic civilization during the Abbasid period, the use of marks developed and became powerful and mandatory in some business sectors.³⁹⁶ During this period, a mark would be used as an indication of quality; and despite the fact that it can be

³⁸⁷ See, in general, Ali Alhabrta, *Camels* (Dar al-Habrta 1990).

³⁸⁸ Ashwaq Bandar and Ali Shraih, 'al-Wasam' ... signs to prove the ownership of camels and affiliation' *Asharq al-Awsat* (Al-Riyadh, 23 August 2012) <<http://archive.aawsat.com/details.asp?section=43&article=692160&issueno=12323#.V5MxtWNsKP8>> accessed 9 December 2015.

³⁸⁹ There is agreement among the Muslim scholars that the Prophet (PBUH) was illiterate. See Mustafa al Sayasneh, 'Al-Omeyyeh fi al-Manzour al-Islamy' (1995) 455 *The Journal of Islamic Research* 121, 123.

³⁹⁰ See, in particular, Frank Schechter, 'The Rational Basis of Trade Mark Protection' (1927) 40 *Harvard Law Review* 813; William Browne, *Law of Trade Marks and Analogous Subjects: Firm-names, business-signs, good-well, and labels* (Press of John Wilson and Son 1873) 4; John McCarthy, *McCarthy on Trade Marks and Unfair Competition* (Thomson Reuters-West 2005) chapter 5, 1.

³⁹¹ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2005) 7. McCarthy states that 'Probably the earliest form of trade mark was the branding of cattle and other animals' McCarthy, *McCarthy on Trade marks and Unfair Competition* (Thomson Reuters-West 2005) chapter 5, 1.

³⁹² See Abdullah Al Aboudi, 'The Humane and the Prohibition of Torture and Oppression' (1991) 34 *Islamic Research Journal* 149, 159; Anas bin Malik said, 'I saw the Messenger of Allah (PBUH) marking sheep on their ears, and I saw him wearing a cloak around his wrist.' Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 4 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 3565, 547.

³⁹³ See Chapter Two, 2.1. See also Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, 'Distinctive Signs and Early Marks: Europe, Africa and Islam' (1997) 1 *Perspective on Intellectual Property* 123, 150.

³⁹⁴ See, in general, King Faisal Center for Research and Islamic Studies, *Al-Asleha al-Islamiyyah: Assoyouf wa-Durou'a* (King Faisal Center for Research and Islamic Studies 1990).

³⁹⁵ See Abdul Rahman Zaki, *Assayfi al-Aalem al-Isalmy* (Dar al-Kitab al-Araby 1957).

³⁹⁶ Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, 'Distinctive Signs and Early Marks: Europe, Africa and Islam' (1997) 1 *Perspective on Intellectual Property* 123, 150.

considered as a state stamp of quality and not an owner's stamp of ownership, it is very similar to the certification mark in modern term.³⁹⁷ The market inspector or *Muhtasib* in Arabic would put his stamp on goods such as pottery and on paper to illustrate that they met the requirements set by the authority which would indicate that the goods were of a certain quality.³⁹⁸ In some cases, the mark inspector would check the scales used by the traders and put his stamp on it to show consumers that they were accurate and the trader was not committing any fraud.³⁹⁹ During the Abbasid period, there was also an obligation on people who were dyeing silk to put their names on their goods as a guarantee to consumers.⁴⁰⁰

In essence, trade mark is a natural development from the idea of branding, and that is a direct result of human evolution. However, nowadays, what differentiates trade marks from other forms of signs is the link to commercial activity and the ability to distinguish the goods or services associated with these signs. Therefore, any form of sign, whether it is a brand or a mark or any other naming, is considered a trade mark if it achieves the previous conditions. Consequently, in order to have an accurate contemporary understanding of trade mark within the Islamic legal system, the following section will analyse the position of Islamic Shariah on the contemporary forms of trade marks, particularly within the TRIPS Agreement.

4.3 Islamic Shariah perspective on contemporary trade mark forms

This part will explore the position of Islamic Shariah on various forms of trade mark using the TRIPS trade mark definition as a guide.⁴⁰¹ As discussed in Chapter Two, the TRIPS

³⁹⁷ There is no common definition of the certification mark. However, for example, the UK TMA 1994 defines the certification mark in Article 50 as a mark 'indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.' See, in general, Jeffery Belson, *Certification Marks* (Sweet and Maxwell 2002).

³⁹⁸ GM Wickens, 'Al-Jasifi on the Hisba' (1956) 3 *Islamic Quarterly* 176, 183; Ida Madieha Azmi, Spyros Maniatis and Bankloe Sodipo, 'Distinctive Signs and Early Marks: Europe, Africa and Islam' (1997) *Perspective on Intellectual Property* 123, 150.

³⁹⁹ Abdul Rahman Al-Shirazi, *Nihayat al-Rutbah fi Talab al-Hisbah* (The Committee of Authoring, Translating and Publishing Press 1946) 19.

⁴⁰⁰ Abdul Rahman Al-Shirazi, *Nihayat al-Rutbah fi Talab al-Hisbah* (The Committee of Authoring, Translating and Publishing Press 1946) 72. It is notable that the Islamic Ottoman Empire issued laws relating to the protection of trade marks in 1879, which were used in Turkey and some other Islamic countries under its control. However, this law did not have a legitimate Islamic root as it was inspired by French legislation. Magdalena Craciun, *Material Culture and Authenticity: Fake Branded Fashion in Europe* (Bloomsbury 2014) 43; Elif Baysan, 'Translation, Imported Western Legal Frameworks and Insights from the Turkish World of Patents' in Şehnaz Gürçaglar, Saliha Paker, John Milton (eds), *Tradition, Tension and Translation in Turkey* (John Benjamins BV 2015) 152.

⁴⁰¹ TRIPS, Art 15. The reason behind chosen this definition as it the most important definition which adopting by the massive majesty of the countries around the world, including the Muslims countries as they member at TRIPS. See Chapter Two, 2.4.

Agreement extended the meaning of a trade mark to cover a wider range of matters. As mentioned above, the circle of permissibility is larger than that which is forbidden; in relation to trade marks, it can be said that all of them are in accordance with Islamic Shariah. As for prohibition, it must be based on clear and legitimate evidence. Therefore, the discussion will focus on the main prohibited/controversial forms within the TRIPS Agreement. This topic can best be tackled under four headings: words mark, names mark, pictures and statues, and non-traditional trade marks.

4.3.1. Words

According to TRIPS, words including names can be used as a trade mark.⁴⁰² Islamic Shariah encourages the use of good words and prohibits ‘bad’ ones, ie swearing or vulgar, rude words etc.⁴⁰³ This is consistent with a number of texts in the Quran, for example, in Surah Ibraheem 14, verse 24, God says ‘a good word like a good tree, whose root is firmly fixed and its branches [high] in the sky’, and in verse 26, ‘And the example of a bad word is like a bad tree, uprooted from the surface of the earth, not having any stability’.

The Prophet (PBUH) said that ‘a good word is a charity’⁴⁰⁴ and Islamic Shariah warns against using malicious words. It follows that there is a general restraint on the use of certain words as trade marks. In addition to all of the above, Islamic Shariah is focused on the Arabic language because it is the language of the Quran. In Surah Yusuf 12, verse 2, God says, ‘Indeed, We have sent it down as an Arabic Quran that you might understand’. Also, it is the language of the Prophet (PBUH). In other words, the whole Islamic religion is based on the Arabic language. Therefore, Muslim scholars place emphasis on learning the Arabic language and its spread around the world.⁴⁰⁵ Islamic Shariah encourages the use of the Arabic language by Arab and non-Arab Muslims in all aspects of life.⁴⁰⁶ Therefore, it can be said that it is better for a trade mark to be in Arabic although this is not obligatory, whether it is made up of words or characters.

⁴⁰² TRIPS, Art 15(1).

⁴⁰³ The Prophet (PBUH) said ‘The believer does not insult the honor of others, nor curse, nor commit Fahishah, nor is he foul.’ Unthinkable that a true believer will indulge in utterance and words that are admittedly filthy and foul. Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 4 (Abu Kallil (tr), Darussalam 2007) *Hadith* no 1977, 76.

⁴⁰⁴ Muhammad Bukhari, *Sahih Bukhari*, vol 2 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 1726, 456.

⁴⁰⁵ Al-Majlis al-Majma, ‘*Al-Ghazw al-Fikkriy*’ (1992) 7 The Journal of the International Islamic Fiqh Academy 886.

⁴⁰⁶ Al-Majlis al-Majma, ‘*Al-Ghazw al-Fikkriy*’ (1992) 7 The Journal of the International Islamic Fiqh Academy 886.

In conclusion, there are two main criteria when using a word as a trade mark in Islamic Shariah: first, that the word or words should not be bad, which is widely interpreted; second, that it is preferable that a trade mark is in the Arabic language, which is for religious purposes rather than ethnic ones. I suggest that a trade mark could be in the local language of the country as well because it is not reasonable for the trade mark to be in the Arabic language in a non-Arab country even if it is a Muslim country. The reason for this is that the provisions of Islamic Shariah strongly call for practicality and convenience, taking into account the interests of Muslims.⁴⁰⁷

4.3.2 Names

The discussion in this section will focus on three particular types of names: the names of God, personal names and place names.

a) The names of God

God in Islam has ninety-nine names and all of them are considered sacred to Muslims.⁴⁰⁸ The Prophet (PBUH) said that, ‘Whoever enumerates them will enter Paradise’.⁴⁰⁹ Imam Ibn al-Qayyim shows that the term ‘enumerate’ includes understanding and perception, and using these names in prayer.⁴¹⁰ In Surah Al-Araf 9, verse, 180, God says ‘And to Allah [God] belong the best names, so invoke Him by them’. The names of God are sacred to Muslims; most of the Quran’s verses include at least one of these names.⁴¹¹ These ninety-nine names are known and agreed upon amongst most Muslim scholars.⁴¹²

The General Presidency of Scholarly Research and Ifta issued a *fatwa* which stated that utilizing God’s names in the commercial field, for example, as trade names or in any commercial activities, is strictly forbidden in Islamic Shariah as this is an insult to these venerable names.⁴¹³ However, some of the God names can be used in any way even as a

⁴⁰⁷ See, in general, Yusuf Al-Qaradawi, *Al-Ijtihad fi al-Shariah al-Islamiah* (Dar al-Kalem for Publishing and Distribution 1996).

⁴⁰⁸ Saeed Al-Qahtany, *Sharhu Asma Allah fi Zoya al-Ketab wa Sunnah* (Safir Press 1988) 5.

⁴⁰⁹ Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 4 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 3560, 161. Some of God’s names, for example, Allah, the Sovereign, the Pure, the Perfection, the Compeller, the Superior, the Creator, the Inventor and the Wise. See Quran Surah al-Hasher 59, verses 23 and 24.

⁴¹⁰ Abdullah Raffia, *Asma Allah* (Dar al-Watan 1996) 117.

⁴¹¹ Abdul Razzaq Al-Bader, *Fiqh Al-Asma Al-Husna* (Dar al-Tawhid 2008) 8. However, scholars believe that the names of God are not limited to a certain number. See also Abdullah Raffia, *Asma Allah* (Dar al-Watan 1996) 131.

⁴¹² Saeed Al-Qahtany, *Sharhu Asma Allah fi Zoya al-Ketab wa Sunnah* (Safir Press 1988) 3.

⁴¹³ Abdullah ibn Ghudayyan and Abdul-Razzaq Atiyyah and Abdul-‘Aziz ibn Baz, General Presidency of Scholarly Research and Ifta’ (1988) The Permanent Committee Fatwas, *fatwa* no 9344, part no 11, 486.

trade mark because these names have general meanings and are not specifically indicative of God.⁴¹⁴ For example, *al-Malik* (The King) is one of the God names but this name is not unique to God alone. Proof of this is that God has called some people kings.⁴¹⁵ In short, even if there are names of God, some of them can still be used to describe or name people or things. In contrast the name *Allah*, for example, should never be used for commercial purposes in any manner as it is exclusively used to mean God.⁴¹⁶

It can be concluded that in Shariah it is forbidden to use some God names as a trade mark; the use of these names is limited to the purposes of worship, learning about God, and deepening the understanding of the Islamic religion. Any other use is therefore unacceptable.⁴¹⁷

b) Personal names

Islamic Shariah has banned certain personal names and this prohibition extends to their use as a trade mark.⁴¹⁸ For example, it is not permitted to use a name that consists of a gesture of slavery to something or someone other than God, for example, the name *Abdul Shams* which means Slave of Sun.⁴¹⁹ This is because its meaning is contrary to Muslim beliefs. All people are slaves only to God so it is permitted to use the name *Abd Allah* which means slave of God.⁴²⁰

There are a number of other types of names which are forbidden by Shariah. These include the names of the devil, pharaohs and names such as the 'King of Kings'.⁴²¹ The Prophet (PBUH) said that: 'The most perfidious (awful) name with *Allah* (that of) a man calling himself King of kings⁴²³ arrogance. or haughtiness suggest which names any and ⁴²²'

⁴¹⁴ Abdul Razzaq Al-Bader, *Fiqh al-Asma al-Husna* (Dar al-Tawhid 2008) 54.

⁴¹⁵ In Surah Yusuf 13, verse 50, God says 'And the King said'. Also in Surah Al-Kahf 18, verse 79, God says 'So I intended to cause defect in it as there was after them a King who seized every [good] ship by force'.

⁴¹⁶ Abdul Razzaq Al-Bader, *Fiqh al-Asma al-Husna* (Dar al-Tawhid 2008) 74.

⁴¹⁷ Abdullah al-Gasen, *Al-Asma al-Husna* (Dar al-Watan 1996).

⁴¹⁸ See generally, Abdul Razzaq Al-Bader, *Fiqh al-Asma al-Husna* (Dar al-Tawhid 2008).

⁴¹⁹ Ibn Qayyim al-Jawziyyah, *Tuhfat al-Mawdood bi Ahkaam al-Mawlood* (Dar Aalm Alfawaid 2008) 165; Bakr Abu Zaid, *Tasmyatu al-Mawlood* (3rd edn, Darussalam 1995) 45.

⁴²⁰ Abdul Aziz Al Rajhi, *Sharh Al-'Aqida fi al-Islam Li Shaykh al-Islam Ibn Taymiyyah* (Dar al-Fazila 1998) 15.

⁴²¹ These names and other names cannot be registered most of the time in Muslim countries. For example, in Saudi Arabia, the Ministerial Agency of Civil Affairs (Ministry of Interior) sets rules that ban names for newborns that are not permissible by Shariah and those socially inappropriate. The Ministerial Agency of Civil Affairs, 'Al-Ahwali il-Maddaniyyeh Tamna-u Khamseen Isman an Mawaleed al-Mamlakeh' (*Okaz*, 13 March 2014) <<http://www.okaz.com.sa/new/issues/20140313/Con20140313683798.htm>> accessed 24 July 2016.

⁴²² Muhammad Bukhari, *Sahih Bukhari*, vol 8 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 6205, 125.

⁴²³ Ibn Qayyim al-Jawziyyah, *Tuhfat al-Mawdood bi Ahkaam al-Mawlood* (Dar Aalm Alfawaid 2008) 167.

In addition, Al-Ghamdi states that a trademark which consists of names of gods of other religions or civilisations is contrary to Islamic Shariah,⁴²⁴ such as the 'Nike' trademark, because the term 'Nike' in Greek is the name of the goddess of victory, and it was the reason behind choosing the name Nike as a trademark for their products.⁴²⁵

With regard to the names of the Quran, some scholars view that, in Shariah, it is *makruh* (disliked) to use the names of the Quran, which are forty-six names;⁴²⁶ this is also the case for the names of the Quran Surahs (chapters).⁴²⁷ This position of rejecting the use of the names of the Quran or its chapter names is adopted by Imam Malik and some *Hanafi* scholars. They state that the names of the Quran or of the chapters must be respected and protected from any misuse.⁴²⁸

After researching this topic, however, I believe that it is possible to trade mark names that are similar to the names of the Quran or Quran chapters. I have adopted this opinion for a number of reasons. The first of these is that I could not find clear evidence in the Quran or Sunnah that prevents the use of these names. Therefore, it is a matter of *Ijtihad*, with the *Hanbali* and *Shafi* schools permitting this use.⁴²⁹ Obviously, these names do not have a strong link to the Quran uniquely. For example, *al-kitab* (book), *al-elm* (knowledge), and *al-haqq* (right).⁴³⁰ The meaning of these names does not directly refer to the Quran but rather to the normal linguistic meaning of the name, which is usually used by people to name other things. For example, the name *al-kitab* is usually used for any kind of book, not just the Quran. However, the case is different in relation to the most well-known name for the Muslim holy book, the Quran, because it has been distinguished from the other names. To further clarify, with regard to Quranic Surahs names, many of the names do not have special religious reference within themselves. Surah names such as *Al-Baqrah* (The Cow), *An-Nisa* (The Women), *Al-Kahf* (The Cave) and *An-Nas* (The People) are clearly general names which do not carry a unique religious reference. However, there are other Surah names that are associated with religious concepts. Examples are *Al-Anbiya* (Prophets) and *Ar-Rahman* (the Entirely Merciful). These names, according to the above discussion, should not be used

⁴²⁴ See Nasser Al-Ghamdi, *Libs al-Rajol: Ahkamah wa Zawabitah fi Fiqh al-Islamy* (3rd edn, Dar Taiba El Khadra) 801.

⁴²⁵ Roger Shepherd, *Praise God, We Won* (West Bow Press 2011) 5.

⁴²⁶ Saleh al-Buleihi, *Al-Huda al-Bayan fi Asmaa il-Quraan* (2nd edn, Dar-Al Sharq 1982) 50.

⁴²⁷ The Holy Quran includes 114 Surah.

⁴²⁸ Asma al-Taleb, *The Provisions of the Newborn in Islamic Jurisprudence* (Dar al-Asmai 2012) 358.

⁴²⁹ Asma al-Taleb, *The Provisions of the Newborn in Islamic Jurisprudence* (Dar al-Asmai 2012) 358.

⁴³⁰ Saleh Alpeleta, *Al-Hoda we al-Bayan fi Asama al-Quran* (2nd edn, Dar al-Sharq Publishing and Distribution 1982) 50, 52; see also, Bakr Abu Zaid, *Tasmyatu al-Mawlud* (3rd edn, Darussalam 1995) 45.

as trade marks because of the religious overtones contained in them and because they are directly linked to the Islamic faith.

In addition to all of the above, it is important to mention the possibility of using some of God's names to name persons but it is prohibited to use them as a trade mark. For example, the Prophet (PBUH) encouraged Muslims to name their children with the famous Muslim name *Abdullah*.⁴³¹ This name cannot be used as a trade mark because of the fact that it contains God's name '*Allah*', and *Allah* is considered the most important God name in Islam; some scholars state that *Allah* is 'The Greatest Name of God'.⁴³² In the same context, the Department of the Ministry of Awqaf and Islamic Affairs in Kuwait has issued a *fatwa* prohibiting traders from using the name *Abdullah* as a trade mark or commercial logo due to the fact that this name includes the word '*Allah*'. Such use could be seen as not respecting the greatest name of God.⁴³³

c) The names of Muslim holy places

There are a range of holy places for Muslims. Mecca in Saudi Arabia is the most important location for Muslims because the *Ka'bah* (Sacred House)⁴³⁴ is the place towards which Muslims pray. Mecca also has many holy sites visited by Muslim pilgrims, for example, Mount Arafat and Mina.⁴³⁵

The second most sacred place for Muslims is Al-Medina Al-Munawarah. This is where the first mosque in Islam was built and where the tomb of the Prophet (PBUH) lies. Many other historical sites are associated with the Islamic religion.⁴³⁶ However, whether Islamic Shariah rules prevent the use of sacred place names as trade marks remains a controversial issue. One opinion is that any use of sacred places names as trade marks is an insult to the values of the Islamic faith. In addition, this usage might mislead consumers as they may link the sanctity of the place and the products bearing the mark. This has been supported by The Federal Supreme Court of the United Arab Emirates which issued a

⁴³¹ The Prophet said, 'The most beloved of names to Allah, the Mighty and Sublime, are 'Abdullah and Abdur-Rahman'. Hafiz Abu Dawud, *Sunan Abu Dawud*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2008) *Hadith* no 4949, 333.

⁴³² See Abdullah Al-dmeji, *Asma Allah al-Husna* (Dar al-Watan 1997) 135.

⁴³³ This *fatwa* based on Quran, Surah Al-Hajj 22, verse 32: 'That [is so]. And whoever honors the symbols of Allah - indeed, it is from the piety of hearts.' The Fatwa Department of the Ministry of Awqaf and Islamic Affairs, no 1064.36/May 1987.

⁴³⁴ See Abdullah al-Shahrani, *Al-Ka'bah Musharafeh: Takreekhuha wa Ahkamuha* (Abdullah al-Shahrani 2012).

⁴³⁵ Muhammad Albanian, *Sifat Salatul Nabi* (11th edn, al-Mearf 1989) 75.

⁴³⁶ See Ibn Hajar Alheichmi, *Thafat al-Zwar aly Qbr al-Nby al-Mkhtar* (Dar al-Sahaba 1992).

judgment rejecting the registration of Mecca Cola as a trade mark.⁴³⁷ The Court decided that MECCA COLA could not be registered because it is an offence against ‘Mecca’, one of the most important religious symbols that comprises many religious places.⁴³⁸ However, some have criticized this ruling and argued that Mecca is a city in Saudi Arabia and even if it comprises holy sites, such as the *Ka’bah* and the *Al Haram* Mosque, it does not make the entire city a religious symbol.⁴³⁹

In addition to all the above mentioned restrictions on the use of names as trade marks, any indecent name from the perspective of Islamic Shariah or any name that may lead to demeaning Muslim beliefs in any way is prohibited. For example, in Saudi Arabia, The General Presidency of Scholarly Research and Ifta has prohibited the use of the name ‘*hoor Een*’ for any commercial purpose including trade marks as it is the name of the brides in heaven for men.⁴⁴⁰ This is considered as exploitation of this name as it insults a name associated with religious meanings for Muslims.

In conclusion, none of these names should be used as a trade mark because such use of these names is prohibited. In short, if the name is one whose use is forbidden by Islamic Shariah then it cannot be used as a trade mark. Shariah is very clear about forbidding the use of names that carry a religious overtone in commerce to prevent any form of abuse of these names which have a special place in the hearts of Muslims.

4.3.3 Pictures and statues

Pictures and three-dimensional shapes are considered to be an essential part of trade mark forms as discussed in Chapter Two.⁴⁴¹ Therefore, in this discussion, it is important to consider the position of Islamic Shariah in relation to these forms of trade mark. The reason behind discussing pictures and three-dimensional shapes in the same section is that the texts which address them in Islamic Shariah are combined.

⁴³⁷ Alittihad, ‘The Feeder Court rejected to register Mecca Cola as trade mark’ (*Al-Ittihad*, 14 February 2012) <<http://www.alittihad.ae/details.php?id=15198&y=2012>> accessed 14 December 2015.

⁴³⁸ See, in general, Mansour al-Mansour, ‘Al-Alamatu Attejariyeh wa Ahkamuha fi al-Fiqh wan-Nizam’ (DPhil thesis, Imam Muhammad Ibn Saud Islamic University 2002) 60.

⁴³⁹ See, Omar Obeidat, ‘Controversial Judgment on Religious Trade marks’ (June 2012) <<http://www.tamimi.com/en/magazine/law-update/section-6/june-4/controversial-judgment-on-religious-trademarks.html>> accessed 14 December 2015.

⁴⁴⁰ Abdul Aziz Al-Shaykh and others, *The Permanent Committee for Academic Research and Fatwa* (2008, *fatwa* no 24576)

<<http://www.alifta.net/Search/Result.aspx?language=ar&lang=ar&Act=1&Page=1&fatwaNum=true&fatwaNumID=24576&searchScope=0&highlight=1&SearchCriteria=AnyWord&SearchType=EXACT&SearchMoesar=false&searchkeyword=>>> accessed 11 January 2014.

⁴⁴¹ See TRIPS Art 15; see also Chapter Two, 2.4.2.

Before beginning this discussion, it is important to make it clear that in classical Arabic the term *Sorah* for picture includes both images and statues but the custom is for people to use different names for them.⁴⁴² This clarification is important because in the *hadiths* the Prophet (PBUH) uses the term ‘picture’ to refer to any type of picture or any type of statue, regardless of the materials or methods used to make them.⁴⁴³

Pictures and statues have been discussed at length with considerable disagreement among classic and modern Muslim scholars. Thus, it is difficult to review all jurisprudential opinions that deal with the Islamic position on pictures and statues. Instead, this section will address the most well-known opinions on this subject. The discussion will be divided into three parts:⁴⁴⁴ firstly, it will explore Shariah’s position on pictures and statues of animates (humans and animals); secondly, the discussion will focus on pictures and statues of inanimates; thirdly, it will determine the Shariah standpoint on marks that consist of these forms.

However, initially it is essential to highlight the texts on the subject. The following are some but not all of the *hadiths* that govern pictures and statues in Islamic Shariah. The Prophet (PBUH) said, ‘The painters of these pictures will be punished on the Day of Resurrection, and it will be said to them, Make alive what you have created’.⁴⁴⁵ The Prophet (PBUH) said in another *hadith* that: ‘The people who will be most severely punished from God on the Day of Resurrection will be A-Musawwirun (the image-maker)’.⁴⁴⁶ Furthermore, the Prophet (PBUH) said that ‘The angels do not enter a house in which there is a dog or a picture’.⁴⁴⁷ The angels in this *hadith* refer to the angels of mercy whose entry is a blessing to the people whose homes they enter.⁴⁴⁸ It can also be understood from this *hadith* that if the angels of mercy do not enter your home, then it is a type of punishment that a Muslim receives during his lifetime.

In another *hadith*, the Prophet (PBUH) said, ‘among the people who will be most severely punished on the Day of Resurrection will be those who imitate the creation of

⁴⁴² Muhammad Wasel, *Ahkamu Attasweer fi al-Fiqh al-Islamy* (Dar Teba 1999) 32; al-Mawsu’ah al-Fiqhiyyah (2nd edn, 1988) vol 12, 92, 94.

⁴⁴³ Muhammad Wasel, *Ahkamu Attasweer fi al-Fiqh al-Islamy* (Dar Teba 1999) 66.

⁴⁴⁴ This topic was and still is the subject of controversy among scholars, especially with the great technological development in imaging devices and techniques of sculpture.

⁴⁴⁵ Muhammad Bukhari, *Sahih Bukhari*, vol 9 (Muhammad Khan (tr), Darussalam 1997) *Hadith* 7558, 398.

⁴⁴⁶ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 5537, 479.

⁴⁴⁷ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 5514, 471.

⁴⁴⁸ Al-Imam Abu Zakariya Al-Dimashqi, *Commentary on the Riyad-us-Saliheen* (Muhammad Amin (tr), Darussalam 1999) 1254.

Allah'.⁴⁴⁹ Lastly, the Prophet (PBUH) said 'The Almighty God said: who are most unjust than those who try to create something like my creation? I challenge them to create even a smallest thing; a wheat grain or a barley grain.'⁴⁵⁰

Generally, scholars rely on these texts heavily to build their arguments and judgments in respect of pictures and statues; disagreements between them are centred on understanding and interpreting the practical application of these texts in modern times. Yet, it must be clear that drawing pictures, making statues, filming or taking photography, whether of animates or inanimates, which aim to sanctify worship or for deification is forbidden according to all Muslim scholars as it is a violation of the Islamic faith.⁴⁵¹ However, if the picture or the statue is not to be used in the ways listed above, then the subject is more debatable.

a) Pictures and statues of humans and animals (hand or machine made)

This section will explore opinions given by the most prominent scholars with regard to drawing pictures and making statues. There are three different opinions that relate to this matter:

1. To forbid all kinds of pictures and statues of humans and animals, whether they are handmade or made by machine such as a motion picture like a movie or television or a static picture like a picture taken on a camera. According to Alalbani, the well-known modern scholar who specialised in *hadiths*, an image, whether motion or static, in general is forbidden if it shows any of God's creatures which has a soul. The only exception to this is if there is an essential need (and trade mark would not be considered as an essential need),⁴⁵² for example, if it is a requirement for official documents such as a passport. In addition, al-Fawzan issued a *fatwa* prohibiting images in all their forms. He said that the prohibition includes still and moving pictures such as videos.⁴⁵³ Another scholar, Ibn Baaz says that all images are forbidden in Islam, whether by hand or those created by machines where it is of the

⁴⁴⁹ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 5525, 475.

⁴⁵⁰ Muhammad Bukhari, *Sahih Bukhari*, vol 9 (Muhammad Khan (tr) (Darussalam 1997) *Hadith* no 7559, 398.

⁴⁵¹ See Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 94.

⁴⁵² See, Abu Abdullah Aajurri, *Al-Ibraz li Aqwalu al-Ulama'a fi Hukm Attelfaz wa Attasweer wal-Video* (Dar-Imam Almojaded 2005) 11.

⁴⁵³ Abu Abdullah Aajurri, *Al-Ibraz li Aqwalu al-Ulama'a fi Hukm Attelfaz wa Attasweer wal-Video* (Dar-Imam Almojaded 2005) 43.

image of a living organism.⁴⁵⁴ There are a number of other scholars in the Muslim world that agree with this view.⁴⁵⁵

The scholars that generally prohibit images and statues rely essentially on *hadiths* mentioned above. It is also based on two key issues in particular: (a) people are imitating God when they commit these acts which may be regarded as a challenge to God's power;⁴⁵⁶ (b) throughout history, images and statues of living beings have been seen as 'God' or as a way to worship God for some nations. In Islam, this is strictly rejected and therefore scholars believe that images and statues are an evil to people and can harm their faith by promoting idolatry.⁴⁵⁷

2. To permit drawing pictures and making statues if the purpose is not to worship or to imitate God. This is based on two pieces of evidence. The first is derived from the Quran, in Surah Saba 34, verse 13, God says, 'They made for him [the prophet Solomon] what he willed of elevated chambers, statues'. Scholars concluded that human and animals' statues and pictures are permissible if they were not made for the purpose of worship.⁴⁵⁸ The second piece of evidence, put forward by Imam Muhammad Abdu, is based on the absence of a prohibiting reason. Scholars that support this view believe that the main reason for all the *hadiths* that prohibit drawing pictures or making statues is the prevention of the spread of heathenism and idol worship amongst Arabs and because Islam was in its infancy.⁴⁵⁹ As such, this prohibition is to protect the faith of early Muslims. In other words, this ban is limited to the early period of Islam whereas now the faith in the hearts of Muslims has become stable and the pictures or statues will not harm their faith.⁴⁶⁰

⁴⁵⁴ Abd al-Aziz ibn Baz, *Aljawab-ul Mufeed fi Hukmi Attasweer* (Dar Almanahig 2002) 22. See also Makble Wadani, *Hukm Tasweer Zawat Arwah* (2nd edn, Dar al-Athar 2004) 33.

⁴⁵⁵ There is a group of scholars who have adopted this approach such as Muhammad Albanian, Rabeeh Al-Madkhali, Abdul Aziz Al-Rajhi and Saleh Al-Fawzan. See generally Abu Abdullah Aajurri, *Al-Ibraz li Aqwalu al-Ulama'a fi Hukm Attelfaz wa Attasweer wal-Video* (Dar-Imam Almojaded 2005).

⁴⁵⁶ See, Makble Wadani, *Hukm Tasweer Zawat Arwah* (2nd edn, Dar al-Athar 2004) 33. See also, generally Abdul Rahman Abdul Khaliq, *Akhramu Attasweer fi Asharihyat-ul Isslamiyyeh* (2nd edn, The Society of the Revival of Islamic Heritage 1994).

⁴⁵⁷ Abdul Rahman Abdul Khaliq, *Akhramu Attasweer fi Asharihyat-ul Isslamiyyeh* (2nd edn, The Society of the Revival of Islamic Heritage 1994) 3, 10.

⁴⁵⁸ See in general Muhammad Motaey, *Aljawabu Ashafi fi Ibahati Attasweer al-Photoghrafi* (Khayriyah 1986).

⁴⁵⁹ Mohamed Emara, *Al-A'mal al-Kamila li Imam Muhammad Abdu* (Dar El-Shorouk 1993) 198.

⁴⁶⁰ Mohamed Emara, *Al-A'mal al-Kamila li Imam Muhammad Abdu* (Dar El-Shorouk 1993) 198. The warning of idolatry is not limited to Islam but it is also stated in Judaism and Christianity. See the Bible, Book of Exodus, chapter 20, verses 3, 4 and 5. '3 - Thou shalt not have strange gods before me. 4- Thou shalt not make to thyself a graven thing, nor the likeness of anything that is in heaven above, or in the earth beneath, nor of those things that are in the waters under the earth. 5- Thou shalt not adore them, nor serve them: I am the Lord thy God, mighty, jealous, visiting the iniquity of the fathers upon the children, unto the

3. To agree with the first group that pictures and statues of human and animals is forbidden in Shariah, but not in all cases. This excludes pictures made by electronic devices such as video, camera and sonar. According to this opinion, using these machines for pictures is permissible even if the picture is of a human or animal. Ibn Uthaymeen states that images created using an electronic device are not prohibited by the *hadiths* because a photographer who uses a camera only transmits pictures of the creativity of God's creation. In other words, he captures the creativity of God but does not try to create it. For example, photocopying pages from a book using a copy machine is not intellectual creativity. The creator in this case is the author of the book and not the one who copies it using the machine.⁴⁶¹ Muhammad Motaey is the first of many to differentiate between hand-drawn pictures and those taken with electronic devices; he concludes that photography is not forbidden in Islam because it is free from the act of 'creation'. In fact, imaging is just 'confinement of the light'.⁴⁶² This view is supported by Al-Qaradawi and a number of other modern scholars.⁴⁶³

It can be said that there are two reasons for the dispute among scholars in relation to this issue. The first is that the use of photography began in 1835⁴⁶⁴ and is considered to be a 'modern issue'. It is therefore new to Islamic jurisprudence as there is no conclusive evidence on this from the Quran or Sunnah. The second is that scholars have different interpretations and understanding of the texts of *hadiths* relating to pictures. The first group of scholars forbids all pictures of humans and animals based on their judgement of the general language and meaning of the texts. However, those who consider that pictures taken by an electronic device are permissible have interpreted the texts with more focus on the concepts rather than the literal meaning of the texts.

b) Pictures and statues of inanimate objects

third and fourth generation of them that hate me.' Also in 726 AD in the Byzantine Empire, many of the icons were destroyed by order of the Emperor Leo the third. See Basem Dahdouh, 'Al-Ttaswir Bayn al-Masmuh Wa al-Alamnue Enda al-Arab wa al-Muslimoun fi al-Quran al-Wustaa' (2010) 26 Damascus University Journal of Engineering Sciences 327, 329, 330.

⁴⁶¹ Muhammad al-Uthaymeen, *Majmue al-Fatawi Walrrasayil Muhammad Al-Uthaymeen* (2nd edn, Dar al-Watan 1992) 259.

⁴⁶² Muhammad Motaey, *Aljawabu Ashafi fi Ibahati Attasweer al-Photoghrafi* (Khayriyah 1986).

⁴⁶³ Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 112.

⁴⁶⁴ Christian Manhart, *The Giant Buddhas of Bamiyan: Safeguarding the Remains* (International Secretariat of ICOMOS 2009) 38-40.

The vast majority of Muslim of classic and modern scholars believe that it is permissible to take pictures or make statues of anything that does not have a soul (with the exception of Imam Mujahid bin Jabr and Imam Al Qurtubi),⁴⁶⁵ for example, man-made objects such as ships and cars or natural objects such as trees and mountains.

There are two main pieces of evidence to support this opinion. First, when Ibn Abbas⁴⁶⁶ said to a modeler, 'If you must do that then make (images of) trees and inanimate things'.⁴⁶⁷ The other evidence that scholars rely on is that the Prophet (PBUH) indicated in a *hadith* that cutting off the statue's head is enough to make the presence of the statue permissible.⁴⁶⁸ In a previous *hadith*, it states that on the day of Resurrection God will challenge those who have drawn pictures or made statues and ask them to give life to what they have created. It is clear from this *hadith* that this refers to images and statues made of living things. According to Ibn Baaz, it is not enough to disfigure the picture and the statue so that it loses one of its key elements to be permissible, but one should separate the head from the body for a statue and blur the face of the person in a picture.⁴⁶⁹

4.3.4 Islamic Shariah and trade marks which consist of pictures or three-dimensional shapes

It is necessary to determine in this part the rulings regarding images and statues made in the image and shape of humans and animals which are fabricated as ornaments, for the purpose of art or for commercial purposes (for example, trade marks) and not for the purpose of worship or to challenge God. The above discussion indicates that answering this question is not simple.

One notable *fatwa* relating to this subject was issued by the Permanent Committee for Academic Research and Ifta in Saudi Arabia. Professor K Wafitindok from Holland

⁴⁶⁵ There is almost a consensus among scholars about the permissibility of drawing pictures and making statues of inanimate objects, the most prominent opinions exempted from this agreement are the opinions of Imam Mujahid bin Jabr and Imam Al Qurtubi who rely on Mujahid. Imam al-Nawawi states that there is an agreement about imaging inanimate objects other than Mujahid, who is disliked '*makruh*' imaging the fruit tree. See Al-Hafiz al-Nawawi, *Sharh al-Nawawi Ala Muslim* (International Ideas House 2000) 1123.

⁴⁶⁶ Ibn Abbas was a companion of the Prophet (PBUH) and his cousin, and he is one of the most important scholars of the Quran.

⁴⁶⁷ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 5540, 481.

⁴⁶⁸ The Prophet (PBUH) said, 'Jibrail came to me and said: 'Indeed I had come to you last night and nothing prevented me from entering upon you at the house ... images of man at the door ... So go and sever the head of the image that is at the door so that it will become like a tree stump.' Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 4 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 2806, 164. See also Muhammad Wasel, *Ahkamu Attasweer fi al-Fiqh al-Islamy* (Dar Teba 1999) 32.

⁴⁶⁹ Abd al-Aziz ibn Baz, *Aljawab-ul Mufeed fi Hukmi Attasweer* (Dar Almanahig 2002) 2. See Muhammad Wasel, *Ahkamu Attasweer fi al-Fiqh al-Islamy* (Dar Teba 1999) 234.

requested clarification about a trade mark that his company intended to register. The trade mark consisted of a picture of half a man stretched out with his arms as the wings of a flying falcon. He asked the Committee to tell him if the design could be considered objectionable from a Muslim point of view. The Committee studied the question and answered as follows:

It is not allowed for two reasons:

It is *haram* (prohibited) to make a drawing of a being with a soul, whether human or not. There is evidence from Sunnah to the effect that Allah curses those who make such drawings and for that reason Muslims have to wipe out or exterminate them.

This design resembles the shape of the Cross which is another reason to prohibit it as it harms the Muslim faith.⁴⁷⁰

As such, this *fatwa* has adopted the opinion which forbids all kinds of pictures and statues of animate beings. As a result, according to this *fatwa*, any trade mark that consists of a human or animal picture cannot be accepted as a trade mark in Islamic Shariah. Also, any three-dimensional trade mark will not be accepted if the shape of the mark represents human, animal or any living organism form.

However, in my view there are two major exceptions that affect the prohibition of pictures and statues of animates and thus their uses in a trade mark:

The image is in a position of abasement, for example, images are allowed if they are in a lower position, such as printed on a carpet.⁴⁷¹ In the same context, we can understand that if the trade mark consists of a picture or image then it is still acceptable if the trade mark is fixed to a product that does not praise the picture. For example, a trade mark picture fixed to nappies, shoes and underwear. On the contrary, a picture fixed to a hat/cap is not acceptable due to its location above the head.

When the statue or picture is a child's toy,⁴⁷² all trade marks associated with toys (or with any items that are not often considered as holy or sacred) are permitted. This

⁴⁷⁰ Abdul-Aziz ibn Baz and others, *Trade Marks Having A Human Photo (Fatwas of the Permanent Committee, Group, vol 1, fatwa no 16786*

<<http://www.alifta.net/Search/Result.aspx?language=en&lang=en&Act=1&Page=1&fatwaNum=true&FatwaNumID=16786&searchScope=0&highLight=1&SearchCriteria=AnyWord&SearchType=EXACT&SearchMoesar=false&searchkeyword=>> accessed 9 October 2013.

⁴⁷¹ Abdul Rahman Abdul Khaliq, *Ahkam Attasweer fi al-Shariah al-Isslamiyyah* (2nd edn, The Society of the Revival of Islamic Heritage 1994) 11. It was narrated that Aisha said, 'In my house there was a cloth on which there were images, which I covered a closet which is in the house, and the Messenger of Allah (PBUH) used to pray toward it. Then he said, O Aisha, take it away from me. So I removed it and made pillows out of it.' Hafiz An-Nasai, *Sunan an-Nasai*, vol 1 (Nasiruddin al-Kattab (tr), Darussalam 2008) *Hadith* no 762, 443.

⁴⁷² Abdul Rahman Abdul Khaliq, *Ahkam Attasweer fi al-Shariah al-Isslamiyyah* (2nd edn, The Society of the Revival of Islamic Heritage 1994) 10.

is based on the same reasoning above that the mark associated with a child's toy will not be revered and this can apply for all trade marks consisting of a picture of a living being. Due to the practical nature of the mark, usage does not commonly suggest the revered.

One of the main pieces of evidence which the scholars depend on to permit a child's toy and fictional forms is a *hadith* that is narrated by Aisha. When the Prophet (PBUH) saw among Aisha's dolls a horse with two wings made of cloth, he said: "What is this that I see in the midst of them?" I said, "two wings". He said, "A horse with two wings?" She said, "Have you not heard that Suleiman had horses with wings?" She said, "And the Messenger of Allah smiled so broadly that I saw his molar teeth."⁴⁷³ This *hadith* shows that the Prophet did not object to dolls or fantasy shapes, which indicates the possibility of using pictures, three-dimensional figures of humans and non-existent forms in designing trade marks. This is because using them as a trade mark does not confer on them honour or respect.⁴⁷⁴ Al-Qaradawi explains this point by stating that 'any change in a figure which keeps it from being treated with respect and renders it debased transfers it from the sphere of detestability into that of permissibility'.⁴⁷⁵

The previous *hadith* can be used to criticise the first reason behind the *fatwa* of K Wafitindok mentioned above, which prohibits the trade mark of a picture of half a man stretched out with his arms.⁴⁷⁶ This is due to the fact that this mark contains fantasy shapes which could mean that it is permitted in Shariah. In general, the *fatwas* that deal with trade marks do not prohibit trade marks that consist of animate pictures or shapes.⁴⁷⁷ Therefore, the abovementioned *fatwa*, which was issued in 1994 by the Saudi *fatwa* board, can be seen as an exception. Furthermore, in 2003, the Saudi authority adopted another *fatwa* that permitted the registration of these forms of trade marks.⁴⁷⁸

It is important to note that the prohibition by scholars does not go as far as to prohibit making statues that are temporary with materials that are perishable, for example, dog or bear statues made of chocolate. The reason for this that as this sort items are temporary and

⁴⁷³ Hafiz Abu Dawud, *Sunan Abi Dawood*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2007) *Hadith* no 326, 4932.

⁴⁷⁴ Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 111.

⁴⁷⁵ Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 111.

⁴⁷⁶ *Fatwa* issued by the Permanent Committee for Academic Research and Ifta. See, 4.3.3, third.

⁴⁷⁷ See, for example, Ajeel Annashmi, 'Al-Haqq al-Ma'anawy: Al-Esm-il Tejaari' (1989) 13 Kuwait University Journal of Shariah and Islamic Studies 281; Muhammad Bouti, 'Al-Hoquq al-Ma'nawiyia: Haqq-ul Ebda'a-ul Elmy wa Haqq-ul Esm Altijaari' (1988) 5 Journal of Islamic Fiqh Academy 2397, 2407; Hassan al-Amin, 'Bai' Esm al-Tijaari wa-Tarrkhees' (1988) 5 Journal of Islamic Fiqh Academy 2495, 2497, 2500.

⁴⁷⁸ Abdullatif al-Qarni, 'Almabadi-il Qada'iyyeh Bayna Attaghyeer wa-Ta'adeel' (*The Economic*, 14 April 2010) <http://www.aleqt.com/2010/04/14/article_379065.html> accessed 14 November 2016.

often will not be revered⁴⁷⁹ In other words, if the form of the mark is a three-dimensional object made from materials that disintegrate easily or are consumable in nature such as food, then it is acceptable even if it was in the shape of a human or an animal.

Consequently, in my opinion, it may be difficult to expand the prohibition of using pictures or shapes of creatures as trade marks. As mentioned above, the cornerstone of the prohibition is to prevent people who are trying to imitate God when they use a human or animal as the subject of their images or statues; this is not the purpose of a trade mark, ie there is no intention to challenge God's power which is the main reason for the prohibition. In addition, the image or shape used in a trade mark is not in a position of reverence.⁴⁸⁰ Therefore, from my perspective, it will be acceptable in Islamic Shariah to use pictures of humans or animals as well as pictures and statues of inanimate objects in a trade mark.

4.3.5 The sound and taste marks in Islamic Shariah

TRIPS developed a very broad definition for trade marks that led to the recognition of non-traditional signs as trade marks.⁴⁸¹ As a result, trade mark forms have become unlimited. The aim of this section is to discuss the Shariah position on non-traditional marks, in particular, sound and taste marks.

The rules under Islamic Shariah are that a human has the right to use and enjoy all his senses and he is free to benefit from every one of God's gifts provided they do not violate the provisions of Islamic Shariah. The prohibitions within the Shariah aim to protect the interests of the people.⁴⁸² In other words, Muslims believe that everything forbidden in Islam is harmful and everything that is permissible is beneficial.⁴⁸³

⁴⁷⁹ Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 103.

⁴⁸⁰ See, Christian Manhart, 'The Giant Buddhas of Bamiyan: Safeguarding the Remains' (2009) International Secretariat of ICOMOS 38-40; Middle East Newspaper, 'Intensify International Pressure on the Taliban to Stop the Destruction of what Remains of the Afghan Heritage (Issue 8139, 2001) http://www.aawsat.com/details.asp?article=29852&issueno=8139#.UokNsdI_t0k.> accessed 19 November 2013. Many scholars praised the Egyptian pyramids and other pharaonic antiquities. Several Islamic history sources indicate that the companions of the Prophet (PBUH) have set up their camps at the Egyptian pyramids when Muslims conquered Egypt and they (companions of the Prophet or any early Muslims) did not do anything negative against these antiquities. Muhammad ibn Abd al-Aziz al-Idrisi, *Anwar Alouijram fi Alkshf an Asrar al-Ahram* (Franz Steiner Verlag 1991) 5, 23. Another contemporary example of the Muslim position on living statues is the Qatar Government in 2013 removing the statue of the football player Zinedine Zidane's after his head butt at the World Cup final after severe condemnation from Qatari citizens and locals. Aljazeera, 'Qatar removes Zidane statue after outcry' (October 2013) <<http://www.aljazeera.com/news/middleeast/2013/10/qatar-removes-zidane-statue-after-outcry-201310302338612974.html>> accessed 10 November 2015.

⁴⁸¹ TRIPS Art 15.

⁴⁸² Abdullah Aljidea, *Almouseeqeh wal-Ghena fi Meezan al-Islam* (Al Rayyan Institution 2004) 49.

⁴⁸³ Muhammad Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 23.

a) The sound mark in Islamic Shariah

In principle, Islamic Shariah may allow sound to be used as a trade mark but some sounds are considered to be controversial by Shariah scholars.⁴⁸⁴ Therefore, certain sounds may not be eligible to be used as trade marks from a Shariah perspective. This discussion will relate to two issues: music and singing. Legalisation or prohibition of singing and music has been a hotly debated issue amongst scholars and researchers in both the past and the present. Abu Faraj Al-Baghdadi states that the position under Islamic Shariah is contested as some Muslim scholars believe that music and singing are forbidden and others believe they are permissible.⁴⁸⁵ Imam Shawkaani considered the positions taken by the various scholars in great detail and he concluded that there is disagreement on the prohibition of music and singing amongst the scholars.⁴⁸⁶

Scholars support the prohibition of music and singing based on a range of evidence. For example, in Surah Luqman 31, verse 6, God says, ‘And of the people is he who buys the amusement of speech to mislead others from the way of *Allah* (God) ... Those will have a humiliating punishment.’ Some scholars say that the meaning of the term amusement in this verse is anything which has no benefit, such as singing and music.⁴⁸⁷ In the Sunnah, the Prophet (PBUH) said, ‘From among my followers there will be some people who will consider illegal sexual intercourse (sexual intercourse outside marriage), the wearing of silk, drinking of alcoholic drinks and the use of musical instrument, as lawful’.⁴⁸⁸ Imam Ibn Al-Qayyim said that God vowed that those who allow musical instruments will be punished.⁴⁸⁹

According to the Permanent Committee for Scholarly Research and Ifta, there is an agreement amongst early scholars about the prohibition of music and singing and this strengthens the view that they are not permissible.⁴⁹⁰ Ibn Taymiyyah states that the opinions of the four main schools of jurisprudence of the four Imams (Malik, Abu Hanifa, Shafi and

⁴⁸⁴ The basic rule in Islamic Shariah is that ‘everything is permissible unless there is evidence to the contrary’. Abdul Karim Aldohni, *The Legal and Regulatory Aspects of Islamic Banking: A Comparative Look at the United Kingdom and Malaysia* (Routledge, Taylor & Francis Group 2011) 49.

⁴⁸⁵ Abu Faraj al-Baghdadi, *Talbis Iblis* (Dar Ibn Khaldun 2001) 226, 227.

⁴⁸⁶ Muhammad Shawkaani, *Ibtal Dawa al-Ijma ala Tahrir Mutlaq as-Samaa*, vol 1 (Al-Geal al-Gaded library 2002) 5199, 5260.

⁴⁸⁷ Muhammad Qurtubi, *Al-Jami li Ahkam al-Quran*, vol 14 (Dar Alkotob 1964) 53. See also, Abdul Rahman Al-Saadi, *Saadi Interpretation of the Koran* (Dar Ibn Al-jwzi 2004) 759.

⁴⁸⁸ Muhammad Bukhari, *Sahih Bukhari*, vol 7 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 5590, 286.

⁴⁸⁹ Hammoud Tuwaijri, *Ketabu Fasl al-Khetab fi-Arrdi Ala Abi Turab* (Dar al-Arqam 1998) 82.

⁴⁹⁰ Permanent Committee for Scholarly Research and Ifta, *Assama'a al-Mouseeqeh* (part 26, 241) <alifta.net/Default.aspx?language=en> accessed 9 November 2013.

Hanafi) agree that all musical instruments are forbidden and that a man who sings or who uses a tambourine was named by the early Muslims as '*Mokhanth*' which means 'effeminate'.⁴⁹¹

There are a number of scholars, including Ibn Taymiyyah, who say that there are exceptions to the prohibition.⁴⁹² The first is singing at weddings although this exception only applies if it does not include any forbidden words or deeds in Shariah and only where the wedding is segregated.⁴⁹³ This exception also only applies to women and a tambourine is the only musical instrument that can be used.⁴⁹⁴ The second exception is singing on Islamic festival days or '*Eids*'. It is known that when the Prophet Muhammad (PBUH) entered his house while two girls were singing to Aisha (the Prophet's wife), he did not object. However, when the Prophet's companion Abu Bakr came he objected strongly and said musical instruments were of Satan but the Prophet (PBUH) said, 'leave them, Abu Bakr, every nation has a festival and this is our festival'.⁴⁹⁵ The other examples are war songs and children songs⁴⁹⁶ but it must be emphasised that these songs should not be accompanied by musical instruments.

However, other scholars and researchers have taken a different view about the Shariah position on music and singing. The most prominent of them is Imam Ibn Hazm⁴⁹⁷ who argues that Islamic Shariah does not prohibit singing and music in general.⁴⁹⁸ Ibn Hazm refutes the evidence used by the other scholars to forbid music and singing under Shariah. For example, they rely on the term 'amusement', which is used in Surah Luqman to suggest that music is forbidden. In his opinion, their interpretation of the term 'amusement' is incorrect and actually relates to anything that prevents people from doing their religious duties. As such, he believes that if the music does not distract people from their religious duties then it would be incorrect to use this verse to prohibit music and singing completely.⁴⁹⁹

In short, according to Imam ibn Hazm and others, the prohibition is linked to anything that may distract Muslims from performing their religious duties. For example,

⁴⁹¹ Ahmed Ibn Taymiyyah, *Hukmu Assama'a* (Al-manar Library 1988) 18, 30.

⁴⁹² Abdul Aziz al-Khayyat, 'Al-Estima' Ela al-Malahy' (2005) 479 Journal of Islamic Awareness 29, 33.

⁴⁹³ Abdul Aziz al-Khayyat, 'Al-Estima' Ela al-Malahy' (2005) 479 Journal of Islamic Awareness 29, 33.

⁴⁹⁴ Ahmed Ibn Taymiyyah, *Hukmu Assama'a* (Al-manar Library 1988) 18.

⁴⁹⁵ Muhammad Bukhari, *Sahih Bukhari*, vol 5 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 3931, 167.

⁴⁹⁶ Abdul Aziz al-Khayyat, 'Al-Estima' Ela al-Malahy' (2005) 479 Journal of Islamic Awareness 29, 33.

⁴⁹⁷ Imam Ibn Hazm is considered to be one of the most important scholars in Islamic history. See Muhammad Abu Zahra, *Ibn Hazm: Hayatuhu wal-Fiqh* (Dar al-ficer al-arabi 1954).

⁴⁹⁸ Ali Ibn Hazm, *Rasa'il Ibn Hazm*, vol 1 (Arab Institution for Studies and Publishing 1987) 430.

⁴⁹⁹ Ali Ibn Hazm, *Rasa'il Ibn Hazm*, vol 1 (Arab Institution for Studies and Publishing 1987) 435.

even trade or agriculture would be forbidden if it distracts a Muslim from their prayers.⁵⁰⁰ God has given an example of this in Surah Al-jumu'ah 28, verse 9, when God says, 'O you, who have believed, when [the *adhan*] is called for the prayer on the day of Jumu'ah [Friday], then proceed to the remembrance of Allah and leave trade. That is better for you, if you only knew.'

Imam Ghazali has a clear opinion on the issue of music and singing, namely that they are not forbidden in Islam and he does not believe that they are in opposition to any of the teachings of the Islamic religion. He has discussed his view and the opposing view in some depth in his famous book 'Revive the religious sciences'.⁵⁰¹ Ghazali based his view on a range of alternative evidence, such as an incident when the Prophet Muhammad (PBUH) allowed his wife Aisha to watch a show performed by some Ethiopian people who were playing with spears and dancing.⁵⁰²

Another scholar, Muhammad Abu Zahra, believes that as long as the singing and music does not raise a person's sexual instincts then it is not inconsistent with Shariah and it is permissible ie *halal*.⁵⁰³ There are also a number of other well-known scholars who believe that music and singing are not in conflict with Shariah, such as al-Qaradawi, Emara and Abdullah Aljidea.⁵⁰⁴ Furthermore, according to Aljidea, the companions of the Prophet Muhammad (PBUH), the *Sahaba*, based on accurate and reliable historical evidence which does not prohibit music and singing if it takes into account the general rules of Shariah.⁵⁰⁵

In relation to using sounds as a trade mark, it is clear that Islamic Shariah permits using natural sounds like the sound of waves, the wind or animal sounds like a bird song or a lion's roar, and this point is not in dispute among scholars.⁵⁰⁶ As such, Emara says that it would therefore be unreasonable to prohibit the sounds made by humans but permit those from an animal.⁵⁰⁷

⁵⁰⁰ Abu Hamid Ghazali, *Ihya Ulum al-Din* (Kiryata Fotra 1957) 276; Mohamed Emara, *Al-Ghenau wal-Mouseeqeh Halal am Haram* (Nahthet Egypt 1999) 5.

⁵⁰¹ Abu Hamid Ghazali, *Ihya Ulum al-Din* (Kiryata Fotra 1957) 276.

⁵⁰² Abu Hamid Ghazali, *Ihya Ulum al-Din* (Kiryata Fotra 1957) 276.

⁵⁰³ Muhammad Albanian, *Tahrim Alet al-Tarab* (2nd edn, Aldallal library 1997) 5.

⁵⁰⁴ See Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 291; Mohamed Emara, *Al-Ghenau wal-Mouseeqeh Halal am Haram* (Nahthet Egypt for Printing Press 1999); Abdullah Aljidea, *Almouseeqeh wal-Ghena fi Meezan al-Islam* (Al Rayyan Institution 2004).

⁵⁰⁵ Abdullah Aljidea, *Almouseeqeh wal-Ghena fi Meezan al-Islam* (Al Rayyan Institution 2004); Mohamed Emara, *Al-Ghena'u wal-Mouseeqeh Halal am Haram* (Nahthet Egypt for Printing Press 1999) 7.

⁵⁰⁶ During the research for this thesis, no scholars were found who argued that Islamic Shariah prohibits this kind of sound (natural sounds).

⁵⁰⁷ Mohamed Emara, *Al-Ghena'u wal-Mouseeqeh Halal am Haram* (Nahthet Egypt for Printing Press 1999) 7.

In the light of the above, it is clear that using human sounds as a trade mark is not in conflict with Shariah on condition that the words used comply with the general provisions within Shariah. As for music, there is a deep-seated conflict amongst Shariah scholars which makes it difficult to determine the accurate position of Islamic Shariah on marks that consist of or comprise music. Therefore, to get out of contention, it is preferable not to blend music with singing or to use the sounds of nature (wind or animals) instead of music. The Prophet (PBUH) said ‘leave what causes you doubt and turn to what does not cause you doubt’.⁵⁰⁸ The mark in this case will be out of the scope of dispute and is most likely to comply with Islamic Shariah provisions from the perspective of all scholars, supporters and opponents.

b) Taste trade marks⁵⁰⁹ under Islamic Shariah

Islam has permitted the consumption of many types of food and beverages, with some limited exceptions. These are given below.

1) Alcohol

Islam strictly forbids drinking alcohol and also prohibits all actions relating to it. Anas bin Malik⁵¹⁰ narrated that ‘The Messenger of *Allah* (PBUH) cursed ten involved with wine ‘alcohol’, the one who presses it, the one who has it pressed, its drinker, its carrier, and the one it is carried to, its server, its seller, the consumption of its price, the one who purchases it and the one it was purchased for’.⁵¹¹ It is clear from this that there are ten different types of prohibition in relation to alcohol, which highlights the severity and extent of the prohibition.

In addition to this, the prohibition on alcoholic drinks is not specified by quantity. Muslims cannot drink any amount of alcohol, not even a small amount to taste it. The Prophet (PBUH) said, ‘whatever intoxicates in a large amount, a small amount of it is (also) forbidden’.⁵¹² Therefore, it is not acceptable in Islamic Shariah to permit any taste trade mark

⁵⁰⁸ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 4 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 2518, 510.

⁵⁰⁹ It was previously mentioned that TRIPS identification of a trade mark might include the taste mark. Nevertheless, this mark appears to be the most problematic mark in registration. The first main problem is that the distinctiveness element in this type of mark cannot be distinguished from the product. Also, the difficulty of representing the mark graphically obstructs the registration, in addition to other difficulties. See Stefano Sandri and Sergio Rizzo, *Non-conventional trade Mark and Community Law* (Marques 2003) 154, 156. See also WIPO, *New Types of Marks* (Standing Committee on the Law of Trade mark, Industrial Designs and Geographical Indications, Sixteenth Session Geneva, 13-17 November 2006).

⁵¹⁰ Anas bin Malik was the servant and one of the well-known companions of the Prophet (PBUH).

⁵¹¹ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 3 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 1295, 97.

⁵¹² Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 6 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 3681, 226.

if the mark includes any alcohol, whether it is food or drink. However, it will be acceptable if the mark simulates the taste of alcohol but does not contain it such as non-alcoholic beer.

2) Swine

With regard to swine, there are many verses in the Quran that prohibit Muslims from eating swine. For example, in Surah al-Baqarah 2, verse 173, God says that ‘He has only forbidden to you dead animals, blood, the flesh of swine ...’. Also, in Surah Al-Anam 8, verse 145, God says, ‘... the flesh of swine, for indeed, it is impure ...’. Therefore, Muslims do not eat pork and believe it is harmful to human health. Hanafi Madbouli⁵¹³ says that God is the creator of all things and knows what is beneficial and harmful to people and this is why swine is forbidden.⁵¹⁴ In Shariah, this prohibition includes the consumption or use of any part of the swine, even the skin, because all of it is seen to be impure.⁵¹⁵ As a result, it is unacceptable according to the principles of Islamic Shariah to include any part of the swine in the taste trade mark. Generally, there is agreement between Muslim scholars about the prohibition of both alcohol and swine.⁵¹⁶

Based on the discussion above, the most important result of trade mark compatibility with Islamic Shariah rules is the recognition of trade mark as a property that deserves protection. Therefore, the next section will explore trade mark protection according to the Islamic legal system.

4.4 The protection of trade marks under Islamic Shariah

The modern application of the Islamic Shariah offers legal protection to the rights relating to trade mark for both traders and consumers in accordance with provisions of Islam, including criminal and civil proceedings.

The basic rule in Islamic Shariah is that commercial transactions should be based on clarity, honesty and balance in all aspects. Therefore, Shariah prohibits business transactions which include *al-Riba* (interest)⁵¹⁷ or are high risk transactions, *gharar*, ie a contract which

⁵¹³ The Head of Viruses Department at Benisuef University.

⁵¹⁴ See Hannifin Madbouli, *Scientific Miracles in the Prohibition of Pork* (Tenth Scientific Conference of Scientific Miracles in the Quran and Sunnah, Turkey, 2011); Muhammad Fiaz Qamari, Ifrah raza, ‘Scientific Evidences that Pig Meat (Pork) is Prohibited for Human Health’ (2012) 55 Animal Science 281, 286.

⁵¹⁵ See Al-Mawsu’ah al-Fiqhiyyah (2nd edn, 2000) vol 32, 20.

⁵¹⁶ See, in general, D Nurdeng, ‘Lawful and Unlawful Foods in Islamic Law Focus on Islamic Medical and Ethical Aspects’ (2009) 16 International Food Research Journal 469, 478.

⁵¹⁷ See, Al-Baqrah 2, Surah 275 ‘Allah has permitted trade and has forbidden interest’.

is based on risk or where it is unclear or ambiguous is not permissible.⁵¹⁸ In other words, it can be said clearly that the Islamic commercial transaction was established mainly on honest and fair principles. The protection of trade marks under Shariah will be discussed and analysed in this section as it was previously shown that Islamic Shariah protects property whether it is tangible or intangible.⁵¹⁹ The most important rules relating to the protection of trade marks will be addressed in this part.

4.4.1 The prohibition of fraud

Islamic Shariah strictly forbids all forms of fraud and deceit whether between traders and consumers or among traders themselves.

In Surah An-Nisa 5, verse 29, God says, ‘O you who have believed, do not consume one another’s wealth unjustly [ie unlawfully or under false pretences] but only [in lawful] business by mutual consent’. Saadi explains that this verse emphasizes the prohibition against taking over another’s property by any means. To be consistent with Shariah, taking the property of another is only permissible through honest business dealings, which should be compatible with the rules of Shariah.⁵²⁰ In Surah Al-Mutaffifin 83, verses 1, 2 and 3, it is stated that: ‘Woe to those who give less [than due] who, when they take a measure from people, take in full. But if they give by measure or by weight to them, they cause loss.’ This Quranic verse emphasizes that the people who cheat and take property by means of deception or force will be severely punished by God in the hereafter.⁵²¹

In a *hadith*, the Prophet (PBUH) said, ‘Anyone who cheats us is not one of us’.⁵²² Also, the Prophet (PHUH) said, ‘whoever deceives (people) does not belong to me’.⁵²³ Islam obliges Muslims to be honest in everything they do in their life. In particular, Muslim traders are singled out under Shariah, and those who cheat in any form will get a severe punishment. The Prophet (PBUH) said, ‘The merchants will be raised on the Day of Resurrection as immoral people, apart from those who fear Allah and act righteously and speak the truth (ie

⁵¹⁸ For example, where someone makes a deal in relation to a car but the type of car is not specified this would be prohibited as the buyer will not know if the car is worth the price or not. See also, in general, Abdul-Rahim Al-Saati, ‘The Permissible *Gharar* (Risk) in Classical Islamic Jurisprudence’ (2003) 16 JKAU - Islamic Economics Journal 13, 19; Siddiq Mohamed Lamine Aldharir, *Al-Ghorour fil-Uqoud wa A’atharuhi fi-Tatatbeeqat-ul Mua’asereh* (Islamic Institute for Research and Training 1993).

⁵¹⁹ See Chapter Three, 3.4.4.

⁵²⁰ Abdul Rahman Al-Saady, *Tafsir As-Saady* (Dar-Iban- Jawzi 2004) 177.

⁵²¹ Muhammad Qurtubi, *Al-Jami li Ahkam al-Quran*, vol 9 (Dar Alkotob 1964) 251.

⁵²² Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 1 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 101, 188.

⁵²³ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 1 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 101, 188.

those who are honest)';⁵²⁴ In contrast, the honest merchant will be rewarded on the Day of Resurrection.⁵²⁵ This is a great reward from God as the honest traders will be martyrs on the Day of Resurrection.⁵²⁶ Also, the Prophet (PBUH) said: 'The seller and the buyer have the right to keep or return goods as long as they have not parted or till they part; and if both the parties spoke the truth and described the defects and qualities (of the goods), then they would be blessed in their transaction, and if they told lies or hid something, then the blessings of their transaction would be lost'.⁵²⁷

Moreover, Islamic commercial ethics not only prohibits false claims about products but also prohibits exaggeration of features as this is considered to be fraud and a bluff under Shariah.⁵²⁸ Imam Ghazali also stated that the seller has a duty to point out all the defects of the thing he wants to sell to the buyer, whether small or large defects and if the seller does not do that he is a cheat and has been dishonest.⁵²⁹ In general, Islamic Shariah gives strong protection to consumers as they are seen as the weaker party in the business process.⁵³⁰

These all show the importance of honesty in trade and that commercial transactions in Islam should be built on truth and transparency. It also gives clear general rules that cheating and deceiving people (whether Muslims or non-Muslims) goes against what it is to be Muslim.⁵³¹

As discussed in Chapter Two, trade marks play an important and influential role in determining consumer choice and can add significant financial value to the business as well.⁵³² All these are legitimate interests from the Shariah perspective and deserve to be protected. Therefore, in order to protect the interests of the consumer and the trader, the protection of trade marks becomes necessary in the Islamic legal system.

⁵²⁴ Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 2146, 229.

⁵²⁵ Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 2139, 225.

⁵²⁶ See Quran Surah Al-Nisa 4, verse 69.

⁵²⁷ Muhammad Bukhari, *Sahih Bukhari*, vol 1 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 293, 171. Also, during the farewell Hajj (pilgrimage) the Prophet (PBUH) said: 'Your property and your blood are sacred to you as this month of yours'. (The month of Hajjah is one of the sacred months in Islam).

Muhammad al-Qazwini, *Sunan Ibn Majah* (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 3057, 211.

⁵²⁸ Rana Abbas, 'Advertisement and Islamic: A Muslim's World Perspective' (2011) 1 *Australian Journal of Business and Management Research* 152, 155.

⁵²⁹ Abu Hamid Ghazali, *Ihya Ulum al-Din* (Kiryata Fotra 1957) 276, 333.

⁵³⁰ See, in general, Hamad al-Kubaisi, 'Daw-ru Asharihatu fi Himayat-ul Mustahlek' (The Role of Legislation to Establish a Balance between the Consumer and the Merchant, United Arab Emirates University, 6-8 December 1998) <<https://archive.org/details/hima-mostahlik1>> accessed 26 January 2016.

⁵³¹ Muhammad Hashim, 'Islamic Perception of Business Ethics and the Impact of Secular Thoughts on Islamic Business Ethics' (2012) 2 *International Journal of Academic Research in Business and Social Sciences* 98.

⁵³² See Chapter Two, 2.4.

As explained above, under Shariah, honesty is expected by all parties to an agreement and protection is offered whether the deal is between a trader and consumer or between two traders.⁵³³ As such, it would be prohibited under Shariah to sell goods bearing a fake trade mark of another as that would be considered cheating or taking advantage of the misunderstanding of the consumer, even if it was not created by the trader. Under Islamic rules, traders have a moral obligation towards their customers, buyers and all stakeholders in general, including other traders.⁵³⁴

As was mentioned in the previous chapter, most modern scholars (like Dereini, abbadī and Al Kafeaf) recognise intangible property such as intellectual property, including the exclusive rights of the trade mark owner.⁵³⁵ Thus, the rules on protecting property under Islamic Shariah can be applied to trade marks on the basis that the trade mark is considered to be a very important financial asset.

It can be understood that Islamic Shariah has protected trade marks for the consumer and the trader. It has banned the trader from using a false trade mark because this may deceive a consumer as to the nature, origin and the quality of the product.⁵³⁶ To summarise, any act carried out by a trader that deceives the consumer or other trader or aims to illegally take over their property is strictly forbidden in Shariah, in other words, all business transactions that do not meet the conditions of fairness and transparency required by Shariah are forbidden under Islamic Shariah.

4.4.2 The punishment for trade mark infringement

As mentioned above, under Shariah, those who commit an ‘assault’ on another’s property will be punished in the hereafter.⁵³⁷ The punishment in life for the assaulters will be discussed in this section.

⁵³³ See, in general, Lilian Miles and Simon Goulding, ‘Corporate Governance in Western (Anglo-American) and Islamic Communities: Prospective for Convergence?’ (2010) 2 Journal of Business Law 126, 149.

⁵³⁴ Lilian Miles and Simon Goulding, ‘Corporate governance in Western (Anglo-American) and Islamic Communities: Prospective for Convergence?’ (2010) 2 Journal of Business Law 126, 129.

⁵³⁵ See, in general, Chapter Three, 3.4.

⁵³⁶ Ida Madieha Azmi, Spyros Maniatis and Bankloe So Dipo, ‘Distinctive Signs and Early Marks: Europe, Africa and Islam’ (1997) 1 Perspective on Intellectual Property 123, 154.

⁵³⁷ See also, Muhammad Abu Zahra, *Al-Jareema wa al-Uqubeh fil-Fiqh al-Islamy* (Dar- al-faker Araby 1998) 21. In Surah An-Nisa, verses 29 and 30, God says, ‘O you who believe! Eat not up your property among yourselves in vanities ... If any do that in rancour and injustice, soon shall We cast them into the Fire: And easy it is for Allah.’ It is of note that if the offender has repented, asked for forgiveness from God and returned what he has taken unlawfully from people, he will not be punished in the hereafter. See Muhammad ibn Uthaymeen, *Assiyasiyah al-Shariyyah* (Dar Ibn Hazm 2004) 200.

The crimes that are punishable by Islamic Shariah, i.e. those that can be punished in this life, relate to the five necessities which are religion, life, mind, lineage and property.⁵³⁸ Under Shariah, any harm caused to these five interests has been criminalised,⁵³⁹ for example, apostasy from Islam, murder, alcohol consumption, theft and adultery as well as any statements or actions that violate these fundamental interests in Islamic Shariah. Because Shariah considers these five key themes to be of utmost importance, there are severe penalties to act as a deterrent.⁵⁴⁰

‘Crime’ has two meanings in Islamic Shariah. The first one is the general meaning, ie that it can be any violation of God’s orders. In this context, it is called a ‘crime’ whether this crime has a worldly punishment or punishment in the hereafter only; the other concept is more specific, crime is only a ‘violation’ which has a worldly punishment.⁵⁴¹

A crime can be committed under Shariah in two ways; it can happen by committing something that is banned in Shariah (the positive crime) or it can be where someone has not done something ordered by Shariah (the negative crime).⁵⁴²

Before discussing the types of punishment in Islamic Shariah, it should be known that Shariah takes into account the importance of proving any accusation against the accused given the gravity of the punishments to be applied on them.⁵⁴³ The Prophet (PBUH) said: ‘Avert the infliction of the prescribed punishment as long as you find a way out (i.e., to avoid their infliction)’.⁵⁴⁴ On another occasion, the Prophet (PBUH) said: ‘Avert the legal penalties from the Muslims as much as possible, if he has a way out then leave him to his way, for if the Imam (judge) makes a mistake in forgiving it would be better than making a mistake in punishment’.⁵⁴⁵

Under Shariah there are two types of punishment:

(1) Prescribed punishments or ‘*Al-Hudood*’: these are penalties which have been specified in the Quran and/or Sunnah.⁵⁴⁶ There are only seven types of punishments,⁵⁴⁷ for

⁵³⁸ Muhammad Yasin, *Al-Jareemeh wal-Uqoubatu fi al-Islam* (University Press of Kuwait 1989) 245. Note that the five necessities will be discussed in detail in subsequent chapters.

⁵³⁹ See Muhammad Abu Zahra, *Al-Jareema wa al-Uqubeh fil-Fiqh al-Islamy* (Dar al-faker Araby 1998) 18.

⁵⁴⁰ Muhammad Yasin, *Al-Jareemeh wal-Uqoubatu fi al-Islam* (University Press of Kuwait 1989) 246.

⁵⁴¹ Muhammad Abu Zahra, *Al-Jareema wa al-Uqubeh fil-Fiqh al-Islamy* (Dar-al-faker Araby 1998) 20.

⁵⁴² See Abdul Qadir Odeh, *Attashrih al-Jenaiy fi al-Islam* (Dar al-Kateb al-Araby 1983) 66.

⁵⁴³ Muhammad Yasin, *Al-Jareemeh wal-Uqoubatu fi al-Islam* (University Press of Kuwait 1989) 270.

⁵⁴⁴ Muhammad al-Qazwini, ‘*Sunan Ibn Majah*’ (Nasiudin al-Kattab (tr), Darussalam for Publishers and Distributors 2007) *Hadith* 2545, 458.

⁵⁴⁵ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 3 (Abu Kallyl (tr), Darussalam 2007) *Hadith* no 1424, 208.

⁵⁴⁶ See Abdul Qadir Odeh, *Attashrih al-Jenaiy fi al-Islam* (Dar al-Kateb al-Araby 1983) 634, 639.

⁵⁴⁷ Al-Hudood crimes are: adultery, drinking alcohol, theft, highway robbery, apostasy from Islam and prostitution. See Ashgar Ali, ‘Mohamed Implementation of Hudud (or limits ordained by Allah for serious crimes) in Malaysia’ (2012) 2 International Journal of Humanities and Social Science 237.

example, the amputation of the hand of a thief and lashes for an alcohol drinker.⁵⁴⁸ Crimes and penalties of this type are specific and limited and cannot be subject to the discretion of the judge.⁵⁴⁹

(2) Discretionary punishment or ‘*Tazeer*’ is a type of penalty that is subject to the discretion of the judge and it is for all types of crime.⁵⁵⁰ *Tazeer* punishments can be in different forms, for example, harsh words and threats, beatings, fines including compensation for the victim or putting the criminal in prison; all these actions and more are called *Taziriah* punishments.⁵⁵¹ There are controls that govern the discretionary power of the judge and their punishments should not be exaggerated and should be equivalent to the damage resulting from the crime.⁵⁵² In Surah Al-Nisa 4, verse 58, God says: ‘Indeed, Allah commands you to ... and when you judge between people to judge with justice’.⁵⁵³ In other words, all of these penalties must result in justice and offer consistency.

It can be understood from the previous discussion that Shariah prohibits and punishes in the hereafter the person who commits crimes, including the act of trade mark infringement. The next question to be addressed is whether there are any worldly punishments for this in Shariah. However, there are no texts that directly address this question and there is nothing in Islamic jurisprudence that provides any clear answers because trade mark protection is a modern issue. Two hypotheses will be explored to find the answer.

The first hypothesis is that trade mark is a type of *mal* (property) and in Shariah whoever steals property belonging to another is punished with *al-Hudood* (prescribed penalties). The penalty applied is therefore the amputation of the hand. However, there are problems that arise out of applying the rules of theft on trade mark infringement. For example, in theft, the property which is stolen should be hidden in a safe place (*herz*).⁵⁵⁴ In addition, as mentioned before, some scholars do not recognise the moral rights in property

⁵⁴⁸ The Prophet (PBUH) lashed a drunk with dateleaf stalk and shoes, and Abu Bakr gave a drunk forty lashes. Muhammad Bukhari, *Sahih Bukhari*, vol 8 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 6773, 403 and the Prophet (PBUH) said ‘Allah curses a man who steals an egg and gets his hand cut off, or steals a rope and gets his hands cut off.’ See also, *Hadith* 6783, 407.

⁵⁴⁹ Muhammad Yasin, *Al-Jareemah wal-Uqubat fi al-Islam* (University Press of Kuwait 1989) 271.

⁵⁵⁰ Abdullah Khunain, ‘Zawabit Taqdir al-Uqubeh Attaziriyeh’ (2011) 1 Al- Majalla al-Kazaiyh -The Saudi Ministry of Justice 56, 57.

⁵⁵¹ Taha al-Sabawi, ‘Nezam al-Hesbeh wa-Atha’athirat-ul Mashrou’ah fil-Fikr-il Islami’ (2013) 7 Journal of the Faculty of Humanities 540, 548.

⁵⁵² Muhammad Abu Zahra, *Al-Jareema wa al-Uqubeh fil-Fiqh al-Islamy* (Dar al-faker Araby 1998) 153.

⁵⁵³ The Prophet (PBUH) said: ‘O people, those who have gone before you were destroyed, because if any one of high rank committed theft amongst them, they spared him; and if anyone of low rank committed theft, they inflicted the prescribed punishment upon him. By Allah, if Fatima, daughter of Muhammad, were to steal, I would have her hand cut off.’ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 3 (Abu Kalliy (tr), Darussalam 2007) *Hadith* no 1430, 214.

⁵⁵⁴ Muhammad Ibn Uthaymeen, *Assiyasiyah al-Shariyyah* (Dar Ibn Hazm 2004) 284.

and therefore do not consider trade marks to be property; this is the case, for example, under *Hanafi* jurisprudence.⁵⁵⁵ Therefore, the hypothesis about applying the punishment for theft to trade mark infringement has to be excluded according to the *Hanafi* point of view. This point of view does not recognize trade mark as property which may be a reason to prevent applying the punishment. Despite the fact that Islamic Shariah requires the agreement between scholars to apply *al-Hudood*, this view makes this hypothesis weak and controversial.⁵⁵⁶

The second hypothesis is to use *Tazeer* (discretionary punishment) as these types of punishments are more flexible.⁵⁵⁷ This means that they can be suitable to deal with all sorts of modern crimes such as trade mark infringement since trade marks fall under the category of ‘property’ which is one of the five protected rights under Shariah.⁵⁵⁸ In short, trade mark infringement is a crime in Shariah and the punishment is a matter for the judge’s discretion.⁵⁵⁹ In Islamic history, there are some examples of discretionary sanctions, for example, for the destruction or forfeiture of forbidden products.⁵⁶⁰ This may be applied to goods bearing a counterfeit trade mark. Other penalties for taking other people’s rights are to put the offender in prison or to punish the offender with lashes.⁵⁶¹ It is reasonable to sometimes combine the penalties, for example, destroy or forfeit the fake goods and jail the offender, as well as libel the merchant in media who cheats among people.⁵⁶² In short, trade mark infringement is a crime in Shariah and the punishment is a matter for the judge’s discretion.

To conclude, Islamic Shariah aims to protect the five necessities, and property is one of them. Therefore, trade mark as a property has the full protection in Shariah. A trade mark is protected if it is in line with Shariah teachings. *Tazeer* (discretionary punishment) covers commercial crime or any other crime that is not covered by *al-Hudood* punishment and this includes trade mark infringement.

⁵⁵⁵ See Chapter Two, 3.4.4.

⁵⁵⁶ Muhammad Yasin, *Al-Jareemeh wal-Uqoubatu fi al-Islam* (University Press of Kuwait 1989) 280.

⁵⁵⁷ Muhammad Abu Zahra, *Al-Jareema wa al-Uqubeh fil-Fiqh al-Islamy* (Dar al-faker Araby 1998) 153.

⁵⁵⁸ But the Hanafi exception must be taken into consideration.

⁵⁵⁹ See Abdullah Khunain, ‘Zawabit Taqdir al-Uqubeh Attathiriyeh’ (2011) 1 Al- Majalla al-Kazaiyh -The Saudi Ministry of Justice 56; Taha al-Sabawi, ‘Nezam al-Hesbeh wa al-Tazirat al-Mashrou’ah fi Fikr al-Islamy’ (2013) 7 Journal of the Faculty of Humanities 540.

⁵⁶⁰ Taha al-Sabawi, ‘Nezam al-Hesbeh wa al-Tazirat al-Mashrou’ah fi Fikr al-Islamy’ (2013) 7 Journal of the Faculty of Humanities 540, 586.

⁵⁶¹ Ali Mawardi, *Al-Ahkam al-Sultaniyya* (Dar Ibn-Qutaiba 1989) 285, 339.

⁵⁶² Taha al-Sabawi, ‘Nezam al-Hesbeh wa al-Tazirat al-Mashrou’ah fi Fikr al-Islamy’ (2013) 7 Journal of the Faculty of Humanities 560.

4.4.3 The civil protection of trade mark in Islamic Shariah

In addition to physical punishment, Islamic Shariah forces the offender to compensate (*Al-Taweed*) the victim or the aggrieved party. In Shariah, the party at fault must pay the indemnity to the third party; liability rules arise if three requirements are achieved: error, damage and a causative relationship between the two.⁵⁶³ It is important to state that there are two basic source elements of compensation in Shariah: (1) contractual liability, this issue is related to non-performance of the contract or breach of the terms and usually the aggrieved party is the buyer, whether a consumer or trader;⁵⁶⁴ and (2) tort liability, this is in the case of violation of the order of God which causes damage to the people.⁵⁶⁵

There is a range of evidence which shows that the principle of compensation for damage is known in the Islamic legal system. For example, there was a she-camel that belonged to one of the Prophet's companions and it damaged another person's property. The Prophet ordered the camel's owner to compensate the aggrieved party for the damage.⁵⁶⁶ Also, the Prophet (PBUH) borrowed a bowl and accidentally broke it, then He compensated the owners.⁵⁶⁷ All this confirms that compensation is an essential principle in Islamic Shariah. Compensation is a personal right for the victim or the aggrieved party against the offender who did the wrongful act or the damage.⁵⁶⁸ It is worth mentioning that scholars often use the term *al-dhaman* (ensure) to indicate all forms of legal liability whether it is civil or criminal. Zoheily defined *al-dhaman* as: 'The obligation to compensate the third parties for damage such as property damage, lost property benefits or the partial or full damage to the human body'.⁵⁶⁹

There are two main types of compensation in Islamic Shariah. The first is *deyah* (blood money).⁵⁷⁰ This type is specified by Islamic Shariah and is related to the human body, the amount of *deyah* should be issued by the authority (the legislator) so that it is consistent

⁵⁶³ See Wahba Zoheily, *Nazhariyat al-Daman fi al-Fiqh al-Islamy* (Dar al-Fikr 2012) 24.

⁵⁶⁴ Wahba Zoheily, *Nazhariyat al-Daman fi al-Fiqh al-Islamy* (Dar al-Fikr 2012) 243; Muhammad Siraj and Ali Muhammad, *Mjma al-Zmanat* (Darussalam 1999) 22.

⁵⁶⁵ Wahba Zoheily, *Nazhariyat al-Daman fi al-Fiqh al-Islamy* (Dar al-Fikr 2012) 243; Muhammad Siraj and Ali Muhammad, *Mjma al-Zmanat* (Darussalam 1999) 22.

⁵⁶⁶ Muhammad Al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 2332, 332.

⁵⁶⁷ Muhammad Al-Qazwini, *Sunan Ibn Majah*, vol 2 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 1360, 148.

⁵⁶⁸ See, in general, Mawsu'at al-Fiqh al-Islamy (3rd edn, 2012) vol 10, 663.

⁵⁶⁹ Mawsu'at al-Fiqh al-Islamy (3rd edn, 2012) vol 10, 664.

⁵⁷⁰ Some scholars differentiate between the *deyah* (blood money) and *al-Arsh*. The term *al-Arsh* is more general than *deyah* because it can be used for all types of compensation. However, contemporary jurisprudence uses the term *deyah* to include all the tangible assaults. Note that diya and arsh are limited to physical injury. See, in general, Awad Idriss, *Addiyeh Bayneh al-Uqoubah wa-Atta'weed fi al-Fiqh al-Islamy al-Muqaran* (Dar Helal 1986) 23, 24 and 25.

and no discrimination occurs.⁵⁷¹ In other words, judges do not have the right to estimate the compensation.

The second type of compensation is called the *hukumat al-adl* (the government of justice) and is the opposite of the first type. This type of compensation is estimated by the authority (government, court or arbitrator) as well as the type and amount of compensation and how to fulfil it.⁵⁷² The authority can consult experts and consultant specialists in the case field to help them find the elements to be compensated in the case (error, damage and a causative relationship between the two). Also, they will determine the appropriate amount of and the type of compensation.⁵⁷³ This compensation covers all damages, whether physical, financial or any other type of damage.⁵⁷⁴ In other words, this type is the most comprehensive and flexible when compared with the first type. Therefore, according to the *hukumat al-adl* (the government of justice) the judge decides the compensation that can be applied in the case of trade mark assault.

However, there are general rules governing this discretionary power. In this context, the Ottoman Empire Civil Code gives an explanation of this point in Article 416: 'Indemnification consists of giving a similar thing if it is a thing the like of which can be found in the market, or the value thereof if it is a thing the like of which cannot be found'.⁵⁷⁵ Therefore, in Shariah compensation in kind is considered as the best way to compensate the aggrieved party. This is shown when the Prophet's wife Aisha broke a bowl and discarded what was in it, the Prophet (PBUH) said, 'Food for food and vessel for vessel'.⁵⁷⁶ As such, it can be seen from all the explanations above that the compensation in kind comes first and financial compensation comes second. This arrangement is not optional unless there is an agreement between the parties of the case which form an acceptable agreement in relation to their personal rights.⁵⁷⁷

According to the modern application of classical Shariah principles, three additional points are worth highlighting in relation to compensation for a trade mark owner and consumer in Shariah. Firstly, the damage should be to property.⁵⁷⁸ It is obvious from the

⁵⁷¹ Mowaffak al-Din al-Hanbali, *Al-Mughni* (3rd edn, Dar-Alam Al-kitab 1997) 6.

⁵⁷² Mawsu'at al-Fiqh al-Islamy (3rd edn, 2012) vol 10, 731.

⁵⁷³ Mawsu'at al-Fiqh al-Islamy (3rd edn, 2012) vol 10, 731.

⁵⁷⁴ Kuwait Institute for Judicial and Legal Studies, 'The Civil Law' (Directory Assistance of the Judicial and Legal) section 1, 56 Rights and Duties.

⁵⁷⁵ Majallah el-Ahkam-I-Adliya, Beirut edition, 1884 Act 416.

⁵⁷⁶ Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 3 (Abu Kallyl (tr), Darussalam 2007) *Hadith* no 1359, 148.

⁵⁷⁷ See explanation of contract theory in Shariah. Muhammad Shalby, *Al-Madkhal fi al-Fiqh al-Islamy* (10th edn, al-Dar al-Gamaih 1985) 409.

⁵⁷⁸ Mawsu'at al-Fiqh al-Islamy (3rd edn, 2012) vol 10, 664.

earlier discussion that there is disagreement between the majority of scholars and *Hanafi* jurisprudence which restricts the property to tangible issues.⁵⁷⁹ This dispute is highlighted in relation to this point because this discussion is about the trade mark forms where most of them are intangible issues.⁵⁸⁰ So, interestingly from the *Hanafi* perspective, the trade mark owner can bring a case of physical assault on the shape of a three-dimensional mark. For example, if a tennis racket is designed in a distinctive way and then registered as a trade mark, and a person then destroys this racket, the owner of the three-dimensional mark deserves compensation according to the *Hanafi* school, based on the damage to the racket itself as it is tangible property but not as a trade mark.

On the one hand, therefore, the *Hanafi* school does not consider a trade mark as property. From its perspective, any assault on a trade mark does not deserve compensation. On the other hand, the majority of Muslim scholars see that this condition is achieved in the trade mark due to the fact that intangible things can be considered as property and this is a general opinion of the scholars.⁵⁸¹ Consequently, based on that, it can compensate the owner of the mark for any assault done to the mark which results in damage.

Secondly, the rules of compensation in the case of trade mark assault in Shariah have a link to the concept of property.⁵⁸² In general, according to *Shafi*, *Hanbali*, *Hanafi* and *Maliki* schools, the rule is that the forbidden things are not considered as property from the Shariah perspective. In other words, there will be no compensation in the case of assault against trade marks that conflict with Shariah.⁵⁸³ However, *Hanafi* and *Maliki* placed an exception which is when the forbidden property is owned by a non-Muslim.⁵⁸⁴ In this case, the property owner deserves compensation based on the rules of tort liability.⁵⁸⁵ Yet, in the case of trade mark, we should take into account that *Hanafi* does not recognise trade marks

⁵⁷⁹ Majallah el-Ahkam-I-Adliya, Act 126. Property consists of something desired by human nature and which could be saved. It comprises movable and immovable property. Thus, this definition is confirming the *Hanafi* school views in determining concept of property.

⁵⁸⁰ As it was explained, the forms of trade mark are unlimited. See TRIPS Art 15.

⁵⁸¹ See Chapter Three, 3.4.4.

⁵⁸² Property is the key element of compensation so there is no compensation for things that are not considered to be properties from the Shariah perspective such as air and sand. See page 43.

⁵⁸³ Mustafa Zarqa, *Al-Madkhal li Nazariyat al-Itizam fi al-Fiqh al-Islami* (Dar al-Kalem 1999) 135.

⁵⁸⁴ For example, if Muslims owned wine and a peg, and someone else damaged them, the Muslim is not entitled to gain compensation. See, Al Imam Alauddin al Kasani, *Badai al-Sanai fi Tartib al-Shara'i*, vol 6 (Dar al-Kotob al-ilmiyah 2003) 437. Abbas al-Baz, *Ahkam al-Mal al-Haram* (Dar al-Nafa'es 1998) 126; Imam Ali ibn Hazm, *Almuhallah* (Bayt al-Afkar 2013) 1077; Ibn Qayyim Al-Joziyyah, *Ahkam Ahl al-dhimma* (Ramadi Publications 1997) 183.

⁵⁸⁵ See Abbas al-Baz, *Ahkam al-Mal al-Haram* (Dar al-Nafa'es 1998) 126; Ibn Qayyim Al-Joziyyah, *Ahkam Ahl al-dhimma* (Ramadi Publications 1997) 183.

as property as mentioned earlier. Therefore, a trade mark owner will not benefit from this exception.

Consequently, from a theoretical perspective, and according to *Maliki*, if a mark consists of alcohol, for example, the mark will be protected by Shariah if owned by a non-Muslim, whether the offended is a Muslim or a non-Muslim.⁵⁸⁶ However, if the mark owner is Muslim, then they will not be entitled to any compensation.⁵⁸⁷

It should be made clear that this is a general rule about the property concept in Shariah and that there are other rules in Islam that govern trade mark as property. Hence, it should be taken into account in general that if a mark is in conflict with Islamic public policy and morality, then it will not be entitled to compensation according to the four schools of thought.⁵⁸⁸ Therefore, the Islamic system does not authorise forbidden trade marks and neither does it allow dealing with them. This matter will be discussed further in Chapters Six and Seven of this thesis. In brief, the exception referred to in the *Maliki* school is inconceivable and it has no practical impact on trade marks.

Thirdly, with respect to the buyer, whether it is a consumer or a trader, and the fake trade mark, one of the main factors that negatively affects the contracting⁵⁸⁹ in Shariah is false pretences or misrepresentation "*al-Taghrir*" in the subject of the contract.⁵⁹⁰ According to Zarqa, *Al-Taghrir* are 'the deceptive methods whether they are practical or verbal, used by any of the contract parties to deceive the other party to motivate him to the conclusion of the contract'.⁵⁹¹ As well as this, the *Majallah el-Ahkam-I-Adliya* states that *al-Taghrir* is an untrue description of the thing offered for sale in order to encourage the buyer to purchase.⁵⁹² Suri clarified that an obvious example of *al-Taghrir* is when the seller puts a sign on the goods to deceive the buyer about the quality of the goods.⁵⁹³

⁵⁸⁶ See Wahba Zoheily, *Nazhariyat al-Daman fi al-Fiqh al-Islamy* (Dar al-Fikr 2012) 58.

⁵⁸⁷ Zarqa states that all contracts and legal obligations are obligatory even if they are related to forbidden (haram) issues on the condition that all partners of the deal are non-Muslim. Mustafa Zarqa, *Al-Madkhal li Nazariyat al-Iltizam fi al-Fiqh al-Islamy* (Dar al-Kalem 1999) 135.

⁵⁸⁸ See Wahba Zoheily, *Nazhariyat al-Daman fi al-Fiqh al-Islamy* (Dar al-Fikr 2012) 58; Imam Muhammad al-Disuqi, *Hashiyat al-Disuqi ala al-Sharh al-Kabir*, vol 2 (Dar Ihya al-Kotob al-Arabia) 204.

⁵⁸⁹ According to the *Majallah el-Ahkam-I-Adliya* Act 103, a contract is what the parties bind themselves and undertake to do with reference to a particular matter. It is composed of an offer and acceptance.

⁵⁹⁰ In Islamic jurisprudence, the *Al-Taghrir*, fraud and deceit are almost the same. See, Mohamed Adil and others, 'Tadlis in Islamic Transactions' (2010) 9 Malaysian Accounting Review 43, 55; Kifah Al- Suri, *Attaghrir wa-Atharuhu fi al-Uqoud* (Dar al-Fiker 2007) 165.

⁵⁹¹ Mustafa al-Zarqa, *Almdkhl Alfkhil Ala'am* (Dar al-Kalem 1998) 463.

⁵⁹² *Majallah el-Ahkam-I-Adliya* Act 164.

⁵⁹³ Kifah Al-Suri, *Attaghrir wa-Atharuhu fi al-Uqoud* (Dar al-Fiker 2007) 63.

Therefore, if there is deceit in the contract, the victim has the right to return the products that bear the fake trade mark and should be entitled to a full refund.⁵⁹⁴ As such, those who bought fake products have the right to retrieve what they paid and, in addition, to receive compensation if deception can be proved. However, jurisprudence determines that the products should be returned within three days from the date of discovery of fraud (ie knowing the trade mark is fake); after this period, the buyer is considered to have accepted the products as being genuine.⁵⁹⁵

It can also be seen that, despite the fact that trade marks are considered a modern subject in Islamic Shariah, the second type of compensation, *hukumat al-adl* (the government of justice), can be applied in relation to violation of trade marks as this type of compensation is broad and not limited to a specific type of matter.

4.5 Conclusion

The key purpose of this chapter has been to uncover the perspective of Islamic Shariah regarding trade mark recognition and protection in the light of the TRIPS Agreement.

This chapter has discussed four main points. First, trade marks are considered a modern subject in Islamic Shariah and there is nothing in the primary sources, the Quran or the Prophet's (PBUH) Sunnah, that directly regulate them. In Islamic history, there is enough evidence that indicates that Muslims have used different forms of trade marks in various functions. This usage is in line with the historical development of trade mark usage in general although they were not clearly regulated in these early Islamic eras. It can be seen that in Shariah there are general provisions derived from the Quran and the Sunnah that can be applied to identify the Islamic regulation of trade mark.

Second, through searching the main sources of the Islamic legal system, it can be seen that there are standards that can be adopted to govern trade mark forms. Islamic Shariah is very strict on what it considers to be sacred, whether that is places, names or shapes. Shariah prevents any mark which may constitute an insult to Islamic sacred objects and deals sensitively with anything that may badly affect Muslims' faith.

Third, there are some trade mark forms recognised by the TRIPS Agreement that may conflict with the rules of Islamic Shariah. In other words, harmony between the TRIPS

⁵⁹⁴ Kifah Al-Suri, *Attaghrir wa-Atharuhu fi al-Uqoud* (Dar al-Fiker 2007) 171.

⁵⁹⁵ This buyer's right is called Al-Khiyar (option) in Shariah. This right grants the buyer (or the seller) the option on whether to continue or cancel the contract. Mustafa al-Zarqa, *Almdkhl Alfkhil Ala'am* (Dar al-Kalem 1998) 427; Md Abdul Jalil and Muhammad Rahman, 'Islamic Law of Contract is Getting Momentum' (2010) 1 International Journal of Business and Social Science 175, 186.

definition of trade marks and Islamic Shariah is missing in some aspects. This has a significant impact on the recognition of trade mark protection under Shariah. The trade mark must be compatible with Shariah provisions in order to be protected. In contrast, the marks that contradict with Shariah will not be considered as *mal* (property) and thus do not have the benefit of protection.

Fourth, in Islam, the trade mark may be protected in a number of ways; in the relationship between traders themselves and between them and their consumers, the trade mark is treated as the property of the mark's owner. The rule in Islam is that whoever violates another's property will be punished in life, the *Tazeer* (discretionary punishment), and may also be punished in the hereafter on the Day of Resurrection. This rule is also applied on trade marks. According to the provisions of Islamic Shariah, the trade mark owner has the right to claim compensation in the case of any assault on his mark; this is also the case for a consumer who has bought a fake mark. However, it must be made clear that classical Islamic jurisprudence did not discuss the subject of civil liability with respect to particular trade marks, and this is due to the modernity of the subject.

This chapter has moved from a general discussion on the Islamic Shariah perspective of intellectual property rights, discussed in the previous chapter, to focus on the Islamic Shariah rules governing trade mark in the light of TRIPS provisions. In general, it can be concluded that the Shariah rules governing trade mark recognition and protection are compatible with TRIPS provisions discussed in Chapter Two. The findings of this chapter indicate that there is no clear evidence in the Shariah that can be used to reject the main trade mark forms addressed in TRIPS. In addition, Islamic Shariah provides various types of protection to trade marks such as criminal and civil which also harmonise with the TRIPS provisions.

To conclude, in this chapter it can be clearly seen that Islamic Shariah indirectly indicates the acceptable forms of trade marks that are set out in the TRIPS Agreement. However, on the other hand, Shariah bans all marks that may harm Muslims' faith or show contempt for the Islamic sacred objects. The divergence between the views of Muslims scholars is a prominent feature of the rules dealing with trade mark forms. It is considered a logical consequence of the absence of express provisions to regulate this topic in the main Islamic sources of the Quran and Sunnah. The impact of considering a mark contrary to Shariah principles is to exclude it from legal recognition and protection.

This chapter has focused on two key elements which are the recognition and protection of trade marks. However, in order to reach a thorough evaluation of the

relationship between the TRIPS Agreement and Islamic Shariah, it is important to explore additional elements, which are public policy and morality principles and their effects on trademarks in both systems, TRIPS and Shariah. This stage is essential before making a comparative analysis of Western and the Islamic public policy and morality principles governing trademarks that will come in Chapter Seven of this thesis. The next chapter (Chapter Five) discusses and analyses the concepts of public policy and morality in the TRIPS Agreement and its applications in the Western legal system as grounds of refusal for trade mark registration and the effect on trade mark recognition and protection.

Chapter Five

Public Policy⁵⁹⁶ and Morality Principles within TRIPS and its Application in the Western Trade Mark Legal System

5.0 Introduction

The principles of public policy and morality play a significant role in determining whether or not a trade mark can be recognised as such, and therefore have an important effect on trade mark registration. The purpose of this chapter is to analyse the rules that regulate trade marks which are derived from public policy and morality principles in the light of the TRIPS Agreement. This chapter will be divided into two parts. The first part will investigate how the rules of public policy and morality inform laws at the international level. It will focus on the two main international agreements that deal with intellectual property in general and trade marks in particular: the Paris Convention and the TRIPS Agreement. The second part of the chapter begins by giving the meaning of public policy and morality in the Western legal system to gain a deeper understanding of what those terms mean. The chapter continues with a review and analysis of several decisions concerning public policy and morality as grounds for refusal of a trade mark registration.

5.1 Public policy and morality in laws governing trade marks internationally

Article 15, paragraph 1 of the TRIPS Agreement includes some cases which a country can use as grounds for refusing to register a trade mark.⁵⁹⁷ Paragraph 2 of the article clarifies that the cases are not intended to be exhaustive and are simply examples of situations so member states of TRIPS may be able to exclude a mark from acquiring any rights based on other reasons. In addition, as a result of the solid relationships between the TRIPS Agreement and Paris Convention, TRIPS refers to Paris provisions and its substantive

⁵⁹⁶ It is worth mentioning that the expression public policy (and public order) originally came from an English translation of the French expression 'ordre public'. It is unclear if there is any major difference in content or method between the two concepts in English common law and French civil law. As this does not directly impact the subject of this research, I will use the expression 'public policy' throughout to cover both public policy and public order. See Rosa Gualtieri, 'Legal Concept of Public Order' (1952) 2 *Revue Juridique Themis* 155; Gerhart Husserl, 'Public Policy and Public Order' (1938) 35 *Virginia Law Review* 37, 38.

⁵⁹⁷ TRIPS, art 15: '... shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible'. TRIPS does not provide for registration procedures other than the rules set out at art 15(5) which relates to publishing trade marks and the right to object to the registration of a mark.

conditions in relation to trade mark registration and protection. That can be seen quite clearly in Article 2(1) of TRIPS which obliges member states to comply with the provisions set out in Articles 1 to 12 and Article 19 of the Paris Convention,⁵⁹⁸ as well as Article 15, paragraph 2 of TRIPS.⁵⁹⁹

The Paris Convention has included a number of rules that affect trade mark registration and protection such as that the mark shall not be registered as a trade mark if it consists of official signs and emblems of states.⁶⁰⁰ As this study focuses on public policy and morality, not all refusal cases are addressed. Therefore, this section only explores Article 6 *quinquies* (B)(3) of the Paris Convention which gives an important right to member states to refuse or invalidate the mark that is in conflict with their national public policy or morality principles.

Article 6 *quinquies* (B) gives examples of where registration of a mark may be refused or invalidated if it is not in line with public policy or morality; paragraph 3 of this article states that:

... when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.⁶⁰¹

Four issues arise from this article. Firstly, the effect of considering the mark to be contrary to public policy or morality is that a member country has the right to deny registration or invalidate the mark, and this was the original provision of the article in 1883.⁶⁰² Secondly, there is also an emphasis on marks that are contrary to public policy which can lead to deceiving the public. This new provision was added to the text in the Revision Conference of London in 1934.⁶⁰³ The reason behind this addition was to give the

⁵⁹⁸ TRIPS, Art 2: 'In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967)'.

⁵⁹⁹ TRIPS, Art 15, para 2, 'Paragraph 1 shall not be understood to prevent a Member from denying registration of a trade mark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).'

⁶⁰⁰ Paris Convention, Art 6ter: 'Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations.'

⁶⁰¹ Paris Convention. Art 6 *quinquies* (B), 3.

⁶⁰² GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114.

⁶⁰³ GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114, 116.

member countries the ability to refuse or invalidate trade marks which could be seen as misleading⁶⁰⁴ such as a trade mark providing false information relating to an honours degree or geographical names that are likely lead to consumer confusion in respect to the origin or source of the product and any other information that may deceive the consumer.⁶⁰⁵ Thirdly, a mark may not be considered to be in conflict with public policy or morality if the only reason for it is that the mark does not adhere to a provision of the national trade mark legislation. In other words, it is unacceptable for any member state to reject registration of a trade mark on the basis of its inconsistency with local laws relating to trade marks alone.

It is clear that the Paris Convention limits the member states' authority to use this exception to decline or reject trade mark registration. This is an important application of Article 6 quinquies A(1) which states that: 'Every trade mark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union'⁶⁰⁶ unless it falls within the exceptions listed in the same article in paragraph (b).⁶⁰⁷

In short, there is an obligation in the Convention on the member states to register and protect a trade mark even if it conflicts with national trade mark rules if the rule was not a matter of public policy or morality. Therefore, it can be seen that the Paris Convention positively discriminates towards foreign trade marks even when they are in conflict with national laws as long as they do not relate to public policy or morality.

Finally, the last sentence of Article 6 quinquies (B) states that: 'This provision is subject, however, to the application of article 10 bis'. In 1958, at the Revision Conference of Lisbon, this sentence was added to the text. Article 10 bis of the Convention governs situations where there is unfair competition and the duty of member states is to provide protection for trade marks from this type of forbidden trade practice.⁶⁰⁸

⁶⁰⁴ GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114, 116.

⁶⁰⁵ GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114, 116.

⁶⁰⁶ The article adds that, 'Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.' Paris Convention, Art quinquies A(1) entitles 'Protection of Marks Registered in One Country of the Union in the Other Countries of the Union'. See Canaan Ahmar, 'International Protection of Industrial Property: From the Paris Convention to The Agreement on Trade-Related Aspects of Intellectual Property Rights' (WIPO National Symposium, University of Jordan, Oman, 6-8 April 2004) 10.

⁶⁰⁷ Article quinquies A(1), second sentence: 'subject to the reservations indicated in this Article' which mentions the sole expiation of the article.

⁶⁰⁸ See Paris Convention. Art 10bis, entitled 'Unfair Competition'. The original Convention of 1883 did not cover any specific rules regarding the case of unfair competition. GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 142.

Interestingly, in the first version of the Paris Convention in 1883, the only ground for refusing or invalidating registration of a trade mark was set out in the rules (paragraph 4 of article 6). It stated that filing might be declined if the mark for which it is requested is considered to be in conflict with public policy or morality. This shows the importance of public policy and morality from the time when the Convention was first established.⁶⁰⁹ The conferences in Washington (1911), the Hague (1925), London (1934) and Lisbon (1958) significantly extended the rules relating to refusal and invalidation.⁶¹⁰

According to Bodenhausen, an example of a trade mark which is contrary to public policy is a mark that conflicts with the legal or community rules that are considered essential in that particular country. A clear example of a trade mark that is contrary to morality would be, for example, a mark containing an obscene picture. Other examples of marks that are contrary to public policy are marks that consist of a religious symbol, forbidden political party or the emblem of a public authority.⁶¹¹

Article 6 quinquies (B) includes two further exceptions in addition to public policy and morality that are used refuse the registration of a foreign trade mark.⁶¹² Other than the above, member states do not have any other grounds for refusal or invalidation of a trade mark registration. The sole duty of the relevant bodies of these states is to decide whether any of the given grounds for refusal or invalidation applies.⁶¹³ In other words, these cases set out in Article 6 quinquies (B) are provided as fixed cases rather than offering examples. However, it was not until 2004 that the Panel of the Dispute Settlement Body of the WTO in the *US Gambling* case⁶¹⁴ discussed the terms ‘public morals’ and ‘public order’

⁶⁰⁹ See Paris Convention. Art 10bis, entitled ‘Unfair Competition’. The original Convention of 1883 did not cover any specific rules regarding the case of unfair competition. GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 142.

⁶¹⁰ GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114.

⁶¹¹ GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 116.

⁶¹² Paris Convention, Art 6 quinquies (B)(1) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed:

‘(2) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.’

⁶¹³ Taking into account the application of other articles in the Convention, for example, art 5 (C), 6 bis, 6 ter, and 6 septies and all of them should be applied as well. GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI 1968) 114.

⁶¹⁴ WTO, *United States-Measures Affecting the Cross-Border Supply of Gambling and Betting Services* (10 November 2004) WT/DS285/R. The Panel stated that the term public morals is used in Article XX(a) of the GATT 1994 but not defined and it has not been interpreted by any panel or the Appellate Body. The term

set out in Article XIV (a) of the General Agreement on Trade in Services (GATS) and clarified the meaning of these terms in the context of the WTO.⁶¹⁵ This decision is important as it can be applied to determine the principles of public policy and morality as grounds to refuse trade mark registration.

The Panel stated that ‘the content of these concepts [public morality and public order] for Members can vary in time and space, depending upon a range of factors, including prevailing social, cultural, ethical and religious values’.⁶¹⁶ In addition, the Panel emphasised that ‘Members should be given some scope to define and apply for themselves the concepts of “public morals” and “public order” in their respective territories, according to their own systems and scales of values’.⁶¹⁷ In order to apply Article XIV(a) on the *US Gambling* case, the Panel interpreted the meaning of these terms.⁶¹⁸ The Panel stated that the term ‘public morals’ denotes standards of right and wrong conduct maintained by or on behalf of a community or nation,⁶¹⁹ and that ‘public order’ refers to the preservation of the fundamental interests of a society, as reflected in public policy and law. These fundamental interests can relate, inter alia, to standards of law, security and morality’.⁶²⁰ The Panel suggested that ‘public morals’ and ‘public order’ are two distinct concepts. Nevertheless, to the extent that ‘both concepts seek to protect largely similar values, some overlap may exist’.⁶²¹ Therefore, it is clear from the above that the Panel of the Dispute Settlement Body gave an interpretation of ‘public order/public policy’ and ‘public morality’, and determined the substantive content of the terms within WTO provisions.⁶²² Hence, this interpretation is important in the trade mark case under the TRIPS Agreement as it can be seen as a guide when applying Article 6 quinquies (B), paragraph 3 of the Paris Convention to refuse or invalidate a trade mark according to public policy or morality principles.

‘public order’ is likewise not specifically defined in the GATS. Note that Article 64 TRIPS refers to Articles XXII and XXIII of the GATT 1994 in relation to dispute settlement in order to apply their provisions to any dispute arising under the TRIPS Agreement. The rules of the Dispute Settlement Understanding (DSU) of the WTO Agreement therefore apply to disputes arising under TRIPS between member countries.

⁶¹⁵ General Agreement on Trade in Services (GATS) (15 April 1994) Article XIV: General Exceptions (a) ‘necessary to protect public morals or to maintain public order’.

⁶¹⁶ WTO, *United States-Measures Affecting the Cross-Border Supply of Gambling and Betting Services* (10 November 2004) WT/DS285/R, 237, para 6.462.

⁶¹⁷ *ibid* para 6.461.

⁶¹⁸ *ibid* para 6.462.

⁶¹⁹ *ibid* para 6.465.

⁶²⁰ *ibid* para 6.467.

⁶²¹ *ibid* para 6.468.

⁶²² See, in general, Jeremy Marwell, ‘Trade and Morality: the WTO Public Morality Exception After Gambling’ (2006) 81 New York University Law Review 802.

In brief, TRIPS itself does not explicitly discuss the concepts of public policy and morality. It refers to the Paris Convention which allows member states to refuse trade mark registration if it is contrary to those concepts. Therefore, according to Article 2 of the TRIPS Agreement, the principles on public policy and morality found in the Paris Convention are applied to the rules governing trade marks in the TRIPS Agreement, in particular the trade mark registration principles. It is important to emphasize that this commitment to the provisions of Article 2 in TRIPS does not require the country in question to be a member of the Paris Convention. Consequently, it can be said that the Paris Convention is clearly the main international agreement that sets out the rules of public policy and morality as grounds for refusal or invalidation of the registration of trade marks. What enhances the stature and importance of the Paris Convention in relation to this matter is the reference to it in TRIPS as being the principle source of governance in respect of public policy and morality regarding trade marks as set out in Article 6 quinquies (B) of the Convention.

Therefore, in order to gain a thorough understanding, the next section will focus on public policy and morality principles in the Western legal system, which is seen to be the practical embodiment of Article 6 *quinquies* (B) of the Paris Convention.⁶²³

5.2 Overview of the Western concept of public policy and public morality

Although Western national laws and international conventions deal with public policy and morality, the relevant legislation does not define them.⁶²⁴ The reason for this is that public policy and the concept of morality change according to the changing times, conditions and places. There are no public policy or morality principles that can be used for all times and for all people or nations.⁶²⁵ This was confirmed by the Court of Justice of the

⁶²³ The Board states that ‘The provisions of Article 7(1)(f) CTMR mirror those of Article 6 quinquies B (3) of the Paris Convention (20 March 1883, revised 14 July 1967)’; *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005, 4, para 12. The OHIM Examiner’s Guidelines state that ‘Article 7(1)(f) EUTMR mirrors that of Article 6 quinquies B(iii) of the Paris Convention 1 which provides for the refusal of trade mark applications and for the invalidation of registrations where trade marks are ‘contrary to morality or public order’.

⁶²⁴ Finding a definition is difficult because public policy is a complex concept with social, economic, juridical and political aspects. All these aspects can exist at the same time and in this complexity the definition of public policy is a challenge. See Rosa Gualtieri, ‘Legal Concept of Public Order’ (1952) 2 *Revue Juridique Themis* 155, 158.

⁶²⁵ Gerhart Husserl, ‘Public Policy and Public Order’ (1938) 35 *Virginia Law Review* 37, 42. Gualtieri mentions that, if the legislature does not give a definition to any subject then the responsibility transfers to the jurisprudence to create it. However, jurisprudence in the case of public policy has acknowledged the difficulty of this mission. Nevertheless, all that do not prevent the judiciary and the legal doctrine try to put controls and frameworks accessible to the concept of public policy. See Rosa Gualtieri, ‘Legal Concept of Public Order’ (1952) 2 *Revue Juridique Themis* 155, 159. See Jeremy Marwell, ‘Trade and Morality: The WTO Public Morals Exception After Gambling’ (2006) 81 *New York University Law Review* 802, 816.

European Union (CJEU) when it stated that ‘the particular circumstances justifying recourse to the concept of public policy may vary from one country to another and from one period to another’.⁶²⁶ In other words, the CJEU has dealt with this by stating that EU member countries have a unique duty in determining their public policy (and this includes public morality as well as public security).⁶²⁷

Winfield argues that ‘[t]his variability of public policy is a stone in the edifice of the doctrine, and not a missile to be flung at it. Public policy would be almost useless without it.’⁶²⁸ He adds that public policy is essentially flexible. It can be flexible from one generation to another and from one era to another but also within the same era and generation.⁶²⁹

The CJEU has given some clues as to what can be contrary to public policy although each country has the right to define its own public policy. It has stated that infringement to public policy involves any ‘genuine and sufficiently serious threat affecting one of the fundamental interests of society’.⁶³⁰ From this decision, the CJEU started to limit the freedom of countries to use their own definition of public policy of the concept of their public policy. The CJEU clarifies that for a legal principle to be characterised as public policy there are two criteria that should be taken into account: (1) it must address an actual and serious enough hazard and not just minor damage to the law; and (2) the public policy rule must be in the interests of the society concerned.⁶³¹ In essence, from the two criteria set out above, it can be understood that public policy is about protecting the rules and the fundamental interests of a particular society.

In the same context, Buckley raised the question about the ability of legislators to remove this ambiguity in the term public policy and set clear rules which show the principles which fall under the category of public policy. He clarified this point by stating that if the rules of public policy are stable in society, then the legislature can issue laws in relation to

⁶²⁶ *Van Duyn v Home Office* (Case 41/74) [1975] Ch 358, 378, para 18.

⁶²⁷ *ibid* Ch 358.

⁶²⁸ See Percy Winfield, ‘Public Policy in the English Common Law’ (1928) 42 *Harvard Law Review* 79, 95.

⁶²⁹ *ibid* 93.

⁶³⁰ *Regina v Pierre Bouchereau* (Case 30/77) [1977] 2 CMLR 2.

⁶³¹ *Regina v Pierre Bouchereau* (Case 30/77) [1977] 2 CMLR 2. There are difficulties in defining the concept of what is in the ‘interests’ of society. This idea can be variable and it is unclear how to identify it, where the individuals and clusters of interests are different and may conflict with each other. It is suggested that jurisprudence to cure this dilemma is that the courts find a balance between the sectional interest and community interests and the judiciary is entrusted with defining the concept of the public interest accordingly. As the interests of society are changeable, the judiciary has to be flexible in its statement to allow for changes to the interests of society. See Percy Winfield, ‘Public Policy in the English Common Law’ (1928) 42 *Harvard Law Review* 79, 93. This also explains the flexible nature of the concept of public policy.

those matters. However, because the issues that relate to public policy are complex, courts should have the power to determine its limits.⁶³²

This is also the case with public morality, which is also changeable according to society's current moral standards.⁶³³ The CJEU has set out the important elements to consider in respect of the controls associated with public morality. The Court stated that a government has the right to protect the public morality of its citizens and an agreement should not be interpreted in a way that is contrary to this right.⁶³⁴ To achieve this, each state should identify the moral values of its society, and these values may differ from one country to another. Therefore, each state has the right to preserve its own public morality as well as to determine what violates morality in their society. However, this right is not absolute but must be exercised within the limits of EU laws.⁶³⁵ Therefore, it is clear from the above that it is unacceptable to restrict these concepts with fixed texts. It is impractical to try to keep up with the constantly changing nature of public policy or morality. This must instead be left to the authority of the courts' discretionary power and to public authorities to determine.⁶³⁶

The first idea that comes to mind when considering public policy is how the national authority has its own vision and plans to achieve national and public interests, for instances developing the health, education and the security sectors.⁶³⁷ Taking a broader view, Carroll states that: 'Public policy is designed to serve and benefit the best interest of the majority of the population'.⁶³⁸ In addition, according to Gualtieri, public policy can be seen as identical to public interest.⁶³⁹ Winfield states that public policy is something that is a fundamental part

⁶³² RA Buckley, *Illegality and Public Policy* (2nd edn, Sweet and Maxwell 2009) 90.

⁶³³ Jeremy Marwell, 'Trade and Morality: The WTO Public Morals Exception After Gambling' (2006) 81 New York University Law Review 802, 816.

⁶³⁴ *Henn and Darby v Director of Public Prosecutions* (Case 34/79) [1980] 2 WLR 597.

⁶³⁵ *Ibid*; see also, The Guide of the EC Treaty states that any of the EU countries could decide to prohibit goods on the grounds of morality. While it is up to each EU country to set the criteria for goods that are contrary to the national provisions regarding morality, this discretion should be exercised under the EU law. See EU, 'Free Movement of Goods: The Guide to the Application of Treaty Provisions Governing the Free Movement of Goods' (European Union 2010) 26.

⁶³⁶ It is normal in treaty-making to allow member states to use their own public policy and morality rules as an exception to certain obligations contained in the agreements. The obvious example of that is the Treaty establishing the European Economic Community issued in 1957 Rome (EC Treaty) which did not provide a definition of the method or the concept for the application of public policy or morality and left that for each member state. See Art 36 of the EC Treaty and see also Catherine Kessedjian, 'Public Order in European Law' (2007) 1 Erasmus Law Review 25, 28.

⁶³⁷ Farshad Ghodoosi, 'The Concept of Public Policy: Revisiting the Role of the Public Policy Doctrine in the Enforcement of Private Legal Arrangements' (2016) 94 Nebraska Law Review 686, 699.

⁶³⁸ Alex Carroll, *Constitutional and Administrative Law* (Pearson Education 2011) 686.

⁶³⁹ Gualtieri states that public policy is the public interest, and public interest in short 'is that which enables man in his social milieu to develop fully his potentialities and to enjoy the result of his developed potentialities'. Rosa Gualtieri, 'Legal Concept of Public Order' (1952) 2 *Revue Juridique Themis* 155; Gerhart Husserl, 'Public Policy and Public Order' (1938) 35 *Virginia Law Review* 37, 159.

of the whole body of common law and does not just relate to a particular part of it.⁶⁴⁰ Moreover, as Bewes states, the rules of public policy are of infinite variety, i.e. it is not limited to one branch of law.⁶⁴¹

With regard to public morality, analysing what this means is as difficult as trying to find a definition for the term ‘public policy’.⁶⁴² According to the Oxford Law Dictionary, public morals are defined as ‘the basic moral structure of society’.⁶⁴³ Although this definition is too broad to accurately determine the concept of public morality, it does show that it is up to the society to determine its meaning.

Marwell states that it is ‘difficult to draw substantive boundaries around the term “public morals” based on commonly accepted objective evidence’.⁶⁴⁴ He explains the difficulty of defining public morals and states that public morality could be seen from a religious perspective, for example, eating certain foods and drinking alcohol, or from a cultural view on such things as sexual freedom and human rights. There may also be other sources that can be used to determine the term public morality, which makes it difficult to identify it in a comprehensive manner.⁶⁴⁵ The rules of morality have a variety of sources and it is therefore difficult to find a general and unified concept of the term ‘public morality’. In other words, the concept of public morality cannot be easily determined or confined to certain matters.

Diversity in relation to the concept of public morals and the way in which they are understood is not just found between the different countries and societies but can also be found in the same country and the same society; and this gap will increase with the development of human societies.⁶⁴⁶ For example, in one country, some may support the

⁶⁴⁰ Percy Winfield, ‘Public Policy in the English Common Law’ (1928) 42 Harvard Law Review 79, 95, 98.

⁶⁴¹ Wyndham Bewes, ‘Public Order (Ordre Public)’ (1921) 37 The Law Quarterly Review 315, 319. It can be noted that courts have always been worried about the wide bounds of public policy and what the risks of the vague limitations of public policy might lead to so there should be some clear limits to the concept of public policy. For example, the public policy principle cannot conflict with any existing legislation. Wyndham Bewes, ‘Public Order (Ordre Public)’ (1921) 37 The Law Quarterly Review 315.

⁶⁴² The question of morality is a very complicated one as it is very flexible and has been much debated. It is associated with what is right or wrong, shameful and honest and other concepts relating to morality, and a lot of this debate is philosophical. See, in general, Walter Sinnott-Armstrong, *Moral Skepticisms* (Oxford University Press 2006).

⁶⁴³ Oxford Dictionary of Law (Elizabeth Martin (ed), 7th edn, Oxford University Press 2013) 440.

⁶⁴⁴ Jeremy Marwell, ‘Trade and Morality: The WTO Public Morals Exception After Gambling’ (2006) 81 New York University Law Review 802, 816.

⁶⁴⁵ *ibid* 815.

⁶⁴⁶ See Ronald Dworkin, ‘Lord Devlin and the Enforcement of Morals’ (1966) 75 Yale Law School 987, 989.

rights of homosexuals but within the same society others may hold the belief that it is a sin that should be punished.⁶⁴⁷

Some may argue that there is an agreed set of human morals that are universal, for example, to ban murder, torture, enslavement and genocide, but it is of note that the precise context of this set of morals and the extent of consensus on these issues is still debatable. In other words, there are some subjects that are accepted widely and internationally that are considered to be a violation of public morals to varying degrees.⁶⁴⁸

In all cases, every country has the right to determine the rules around public morality according to the views of their society. It is easy to have a uniform understanding of public morals if the citizens all share the same views, such as issues around what is acceptable in religion and culture. In contrast, it is more difficult to define public morals where there is diversity of religions and cultures amongst the members of a particular country⁶⁴⁹.

The concepts of public policy and morality are closely linked.⁶⁵⁰ Gualtieri has elucidated the relationship between them in stating that ‘the concept of good morals is included within that of public policy, for without a standard of good morals, conformable to the existing conditions in society, public policy cannot be maintained’.⁶⁵¹ However, it is not accurate to say that public policy and public morality are identical in all cases.⁶⁵² Public policy is linked to the sense of ‘governmental previews and provisions’ which seek to protect the higher interests of the community in all key areas, whether political, social or economic, and this also applies to the idea of public morality which aims to protect the morals of that society. This concept of morality may be related to the political, commercial or social aspects of life.⁶⁵³ The protection of sovereignty is an essential function of the state and it follows that a breach of public policy or morality will not be accepted since sovereignty is one of the main elements of the countries. States exercise their sovereignty through protecting these

⁶⁴⁷ *ibid* 989. According to Luco, it is difficult to implement a code of conduct but moral rules can be determined by the function performed and the main function of moral systems is to achieve mutually beneficial community cooperation. Andrés Luco, ‘The Definition of Morality: Threading the Needle’ (2014) 40 *Social Theory and Practice* 361, 386.

⁶⁴⁸ Jeremy Marwell, ‘Trade and Morality: The WTO Public Morality Exception after Gambling’ (2006) 81 *New York University Law Review* 802, 816.

⁶⁴⁹ Ronald Dworkin, ‘Lord Devlin and the Enforcement of Morals’ (1966) 75 *Yale Law School* 987, 816.

⁶⁵⁰ There are a number of examples that show how common the use of these two terms in the same context are used, one of which is stated in EC Treaty, Art 36: ‘the provisions of Articles 30 to 34 shall not preclude prohibitions or restrictions on imports, exports or goods in transit justified on grounds of public morality, public policy or public security ...’. Further examples will be discussed throughout this part.

⁶⁵¹ Rosa Gualtieri, ‘Legal Concept of Public Order’ (1952) 2 *Revue Juridique Themis* 155.

⁶⁵² Christopher Mooney, ‘Public Morality and Law’ (1983) 1 *Journal of Law and Religion* 45.

⁶⁵³ Derek Edyvane, ‘What is the Point of Public Morality?’ (2012) 60 *Political Studies* 147, 162.

two principles and this is a mandatory duty.⁶⁵⁴ An important aspect of public policy and morality can be understood from this.⁶⁵⁵ In addition, public policy and morality offer a justification for the actions of public authorities in situations that are not regulated in legal texts.⁶⁵⁶

In summary, the most notable point in this context is that public policy and public morality concepts do overlap significantly. Their concepts and rules vary according to time and place, and are closely associated with social norms. In addition, any act which violates public policy or public morals is unacceptable; society's interest is above all other interests as it is considered to be the ultimate goal of the two terms.⁶⁵⁷

5.3 The approach of Western legal system to refusal of trade mark registration on grounds of public policy and morality

Trade marks can be seen everywhere; they appear on billboards, televisions, newspapers, social events and in many others places. Companies believe they can communicate with their current or potential customers through them. Thus, it can be said that trade marks are compulsory viewing and are often difficult to avoid.⁶⁵⁸

As a result of intense competition between companies around the world, some companies may seek to offer their products using controversial trade marks in order to draw the attention of consumers, especially if their type of trade mark could stick longer in the mind.⁶⁵⁹ In principle, this activity is acceptable because it is linked to the main function of a trade mark, which is to distinguish the products that it is affixed to. However, a problem can arise where the mark is in conflict with the society's public policy or morals. The approach of these companies might be to prioritise the commercial benefit over public interests, which raises the importance of the authority's interference to protect society by refusing to register

⁶⁵⁴ See, in general, Catherine Kessedjian, 'Public Order in European Law' (2007) 1 Erasmus Law Review 25.

⁶⁵⁵ Wyndham Bewes, 'Public Order (Ordre Public)' (1921) 37 The Law Quarterly Review 315.

⁶⁵⁶ *ibid.*

⁶⁵⁷ Gualtieri states that 'The concept of good morals is included within that of public order, for without a standard of good morals, conformable to the existing conditions in society, public order cannot be maintained.' Rosa Gualtieri, 'The Legal Concept of Public Policy' (1952) 2 *Revue Juridique Themis* 155.

⁶⁵⁸ Patricia Loughlan, 'Oh Yuck! The Registration of Scandalous Trade Marks' (2006) 61 *Intellectual Property Forum* 38.

⁶⁵⁹ Anil Samtani, 'Trade Marks that are Contrary to Public Policy or Morality: The Search for the Right-thinking Man' (2012) 1 *Intellectual Property Quarterly* 39.

offensive trade marks.⁶⁶⁰ This rejection is consistent with one of the underlying purposes of trade mark legislation which is to protect the public.⁶⁶¹

Legislators in the Western legal system adopted various terms in referring to public policy and morality principles as grounds for refusing trade mark registration. Article (4)(1)(f) of the EU Trade Mark Directive⁶⁶² as well as Article 3(3)(a) of the UK Trade Mark Act (TMA) ban the registration of trade marks that are ‘contrary to public policy or to accepted principles of morality’.⁶⁶³ This is very close to what was set out in the Paris Convention.⁶⁶⁴ However, the US Trade Mark Law, the Lanham Act, has adopted different language. The Act bans federal registration of immoral, scandalous or disparaging matter as a trade mark.⁶⁶⁵ Nevertheless, even with the differences in legislative language, the majority of countries adopt a similar perspective in relation to offensive trade marks.⁶⁶⁶

Office for Harmonization in the Internal Market (EUIPO Examiner’s Guidelines set an explanation of the term public policy that is mentioned in Article (7)(1)(f) of the Community Trade Mark Regulation (CTMR); ‘public policy’ refers to ‘the body of Union law applicable in a certain area, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation’.⁶⁶⁷ The Guidelines regarding ‘acceptable morality’ state that: ‘This objection concerns subjective values, but these must be applied as objectively as possible by the examiner’.⁶⁶⁸

However, these terms can still cause ambiguity which can affect registrars, traders and even consumers. According to Phillips, public policy and morality terms are easy to understand but difficult to defend or be applied in specific cases, and in many European

⁶⁶⁰ Patricia Loughlan, ‘Oh Yuck! The Registration of Scandalous Trade Marks’ (2006) 61 Intellectual Property Forum 38, 39; Amanda Scardamaglia, ‘Are you Nuckin Futs? Registering’ (2012) 9 European Intellectual Property Review 628, 629.

⁶⁶¹ Theodore Davis, ‘Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity be Another’s Registered Trade Mark?’ (1993) 54 Ohio State Law Journal 331.

⁶⁶² Directive (EU) No 2015/2436 [2015] OJ L 336/1, Art (4)(1)(f); Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1, Art 7(1)(f).

⁶⁶³ Trade Marks Act, 1994, Sec 3(3)(a) (UK).

⁶⁶⁴ See Paris Convention 1967, Art 6 *quinquies* (B), para 3.

⁶⁶⁵ Section 2(a) of the United States Trade Mark Act of 1949 (Lanham Act). Farley, in her chapter, states that the reasoning behind the use of different terms in this law are not clear. Irene Calboli and Srividhya Ragavan (eds), *Diversity in Intellectual Property: Identities, Interests, and Intersections* (Cambridge University Press 2015) 119.

⁶⁶⁶ See Irene Calboli and Srividhya Ragavan (eds), *Diversity in Intellectual Property: Identities, Interests, and Intersections* (Cambridge University Press 2015) 119.

⁶⁶⁷ OHIM, ‘Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trademarks, Part B’ (2014) (2.6.1.1).

⁶⁶⁸ *ibid* (2.6.2).

countries they are most closely linked with sexual references.⁶⁶⁹ In addition, in the case of the ‘SCREW YOU’ mark, the Court held that ‘[t]he wording of Article 7(1)(f) CTMR is very broad and allows a great deal of room for interpretation’.⁶⁷⁰ This is in line with the above review regarding the nature of public policy and morality provisions as they are not fixed, and judges and examiners have the biggest role in determining the framework and the limits of the two terms.⁶⁷¹ Another issue worth highlighting in this context is the strong intersection between the concepts of public policy and morality. EUIPO’s Guidelines state that ‘[t]he Office considers that “public policy” and “accepted principles of morality” are two different concepts, which often overlap’⁶⁷².

In this context, Johnson suggested that the public policy concept is comprehensive as it may include the morality subject matter: ‘A mark may be objected to on ground of public policy if it is offensive on grounds of race, religion, sex or decency. If a mark has criminal connotations, it may also be objected to under this heading. This ground also catch those marks that could offend moral principles. were Huydecoper and Nispen Jehoram,⁶⁷³’ quite clear on this point. They acknowledge that ‘it is not possible to make a proper distinction between trade marks that are contrary to public order, on the one hand, and trade marks that are contrary to morality.’⁶⁷⁴ In addition, in the text the two terms are commonly used simultaneously and interchangeably.⁶⁷⁵

All this shows the significant overlap between public policy and morality, and the difficulty in distinguishing between the two concepts as reasons to refuse trade mark registration. Thus, in the Western legal system the door is not open to register the mark which is in conflict with public policy or morality. Judge Lenroot explains this in the ‘MADONNA’ mark case: ‘The field is almost limitless from which to select words for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration.’⁶⁷⁶ In other words, almost anything that meets the legal requirements, for

⁶⁶⁹ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford University Press 2003) 67.

⁶⁷⁰ *SCREW YOU - Kenneth v JA Kemp & Co* [2006] OHIM R 495/2005-G, 5, para 14.

⁶⁷¹ The Court was very clear on this point: ‘A judicious application of this provision [of Article 7(1)(f) CTMR] necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting and even threatening trade marks.’ *SCREW YOU - Kenneth v JA Kemp & Co* [2006] OHIM R 495/2005-G, 5, para 14.

⁶⁷² OHIM, ‘Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trademarks, Part B’ (2014) (2.6).

⁶⁷³ Helen Johnson, *A Guide to Trade Mark Law and Practice in Ireland* (Bloomsbury Professional 2011) 102.

⁶⁷⁴ Tobias Jehoram, Constant Nispen and Tony Huydecoper, *European Trade mark Law: Community Trade Mark Law and Harmonized National Trade Mark Law* (Kluwer Law International 2010) 171.

⁶⁷⁵ *ibid.*

⁶⁷⁶ *Riverbank Canning Co* 95 F2d 327, 329 (CCPA 1938) 4.

example, those set out in the EU Trade Mark Directive and Regulation and Lanham Trade Mark Act, can be registered as a trade mark. Nevertheless, there are some limitations as to what subject matter can be valid for registration; action can take the form of blocking or the cancellation of registration of a mark that is in conflict with public policy or morality.

Therefore, the question that the next part will try to address is how to determine whether a particular mark is in conflict with public policy and morality or not. The answer depends upon several important elements and so is not particularly straightforward to arrive at.⁶⁷⁷

To better understand the principles of public policy or morality and its effect on trade mark registration and protection, this part will explore how competent authorities determine whether a mark is contrary to public policy or morality by using illustrative examples. The following pages will mostly, but not exclusively, review several EU and US cases concerning various types of controversial marks that have been evaluated in accordance with public policy and morality provisions. There is no uniform classification of the offensive marks. However, according to case law and researchers in the field, the categorization of marks that are contrary to public policy or morality may be divided into four main categories: (a) sexual and vulgar matters; (b) religious terms and symbols; (c) racial slurs and epithets; and (d) illegal content.⁶⁷⁸

(a) Sexual and vulgar matters

The most common mental image of a mark that is in conflict with public policy or morality is one that is linked to sexual themes. A mark that has a crude sexual connotation may be considered in breach of public policy and/or moral principles.⁶⁷⁹ However, this category is one of the most inconsistent and is very difficult to predict.

In 2004, EUIPO received an application to register the words ‘SCREW YOU’ as a trade mark in connection with goods of various classes, ranging from sunglasses, condoms,

⁶⁷⁷ Baird has pointed out this difficulty by saying, ‘what constitutes scandalous or immoral matter is difficult to define because it may vary depending upon who is asked, when they are asked, and where they are asked.’ Stephen Baird, ‘Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks’ (1993) 83 Trademark Report 661, 664.

⁶⁷⁸ Baird has classified the offensive marks into seven groups: religious nexus, racial slurs or epithets, profane matter, vulgar matter, sexuality, innuendo which suggest or promote illegal activity. Stephen Baird, ‘Moral Intervention in the Trade Mark Arena: Banning the Registration of Scandalous and Immoral Trademarks’ (1993) 83 Trademark Report 661, 704.

Abdel-Khalik was not far from this as he adopted a similar classification of offensive marks. Jasmine Abdel-Khalik, ‘To Live in in-“Fame”-Y: Reconceiving Scandalous marks as Analogous to Famous marks’ (2007) 25 Cardozo Arts & Entertainment 173, 204. See also, Intellectual Property Office of Singapore, ‘Marks Contrary to Public Policy or Morality’ (2009).

⁶⁷⁹ See, *SCREW YOU - Kenneth v JA Kemp & Co* [2006] OHIM R 495/2005-G, 5, para 19.

clothing and alcoholic beverages.⁶⁸⁰ The examiner refused the application pursuant to Article 7(1)(f) of CTMR⁶⁸¹ as she considered the expression ‘SCREW YOU’ to be a slang term synonymous with the word ‘fuck’.⁶⁸² The applicant appealed the decision of the examiner. The appellant's arguments were mainly based on two points: the first one is that the word ‘screw’ is not equivalent to the word ‘fuck’ and even if the two words had similar meanings, the word ‘fuck’ is far more offensive than the former.⁶⁸³ The second point is that the term ‘fuck you’ is seen as extremely offensive in contrast to the term ‘screw you’ which is used in television programmes on British TV broadcasts at normal viewing times, i.e. ‘family time’. This can be seen as good evidence that proves that the term ‘screw you’ is unlikely to cause offence to the public. In addition, the word ‘screw’ is not one of the ‘Seven Dirty Words’ in English language banned from use in US broadcasting media. Secondly, in 2006 the Intellectual Property Office in the UK (UKIPO) had accepted registration of ‘SCREW YOU’ as a trade mark, which confirms the validity of doing so under Article 7(1)(f).

However, the Board of Appeals of the EUIPO did not accept the appellant's arguments and dismissed the appeal, considering that the mark ‘SCREW YOU’ was in conflict with Article 7(1)(f) CTMR. The reasons for the Board’s decision are summarized below.

The Board stated that one of meanings of the word ‘screw’ was as a swear word in English referring to sexual intercourse. The Oxford English Dictionary (and other sources) show that the verb ‘to screw’ is synonymous with ‘fuck’. They classified it as ‘cursing slang’ and the expression ‘screw you’ was very rude and offensive. Regarding the practice of broadcasting services, the Board refuted the appellant's argument that the term ‘screw you’ is used on TV shows in the UK and the US during family viewing time. The Court stated that this did not provide decisive evidence to prove that the mark was not offensive for everyone in society, especially children. The reason for this is that a differentiation is made between the rules that regulate trade mark registration and ones for the freedom of artistic expression as the former is of a ‘higher priority than the freedom of commercial’. In addition, using the term ‘screw you’ on television shows does not give a clear indication of the degree

⁶⁸⁰ *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005.

⁶⁸¹ Article 7(1)(f) CTMR prohibits the registration of ‘trade marks which are contrary to public policy or to accepted principles of morality’. By virtue of Article 7(2) CTMR.

⁶⁸² *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005.

⁶⁸³ *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005.

of harm it may cause to the public. However, it is important to mention that the Board has allowed registration of marks that relate to sexual products.⁶⁸⁴

From this case, it can be understood that using marks that consist of or comprise of sexual and vulgar matters and principles is not necessarily contrary to public policy or morality. However, in blocking the registration of this type of mark, the examiner should ascertain that the mark will most likely cause deep offence to the public as they ‘contain manifestly profane language or depict gross obscenity’⁶⁸⁵ and are not merely rude or repugnant. Therefore, marks that consist of mild sexual or slightly vulgar matters are acceptable according to the Board interpretation of Article 7(1)(f).

Nevertheless, the Board has highlighted the difficulty of assessing a mark’s suitability to be registered as a trade mark when it stated that: ‘It can be extremely difficult to ascertain when a sign crosses the boundary from being merely irreverent or distasteful to being seriously abusive ...’.⁶⁸⁶ This can be seen in the case of the DICK & FANNY mark. The EUIPO examiner refused the application to register DICK & FANNY for ordinary goods and services. The examiner justified his decision by noting that ‘dick’ and ‘fanny’ were slang words referring to the human reproductive organs.⁶⁸⁷ Therefore, the mark would offend English-speaking consumers and so would also be in conflict with Article 7(1)(f) CTMR. However, the Board of Appeal allowed registration of the mark as it ‘does not proclaim an opinion, it contains no incitement, and conveys no insult’.⁶⁸⁸ It also found that the mark did not contain any offensive or sexual messages; the words used in the mark ‘merely designate a thing but they do not transmit any message, secondly the association of two words does not necessarily reinforce the connection of the mark’.⁶⁸⁹ The Board’s discussion made it clear that the sexual content of a mark is not reason enough to reject the mark’s registration under Article 7(1)(f) CTMR.

In line with this is the *McGinley* case in the US⁶⁹⁰ in which the applicant sought to register a mark that consisted of a photograph of a naked man and woman ‘kissing and embracing in a manner appearing to expose the male’s genitalia’.⁶⁹¹ The United States Court

⁶⁸⁴ The Board of Appeal upheld the decision regarding ‘condoms, contraceptives, sex toys (vibrators, dolls)’ in Class 10. *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005-G.

⁶⁸⁵ *Jebaraj Kenneth Application (SCREW YOU)* Board of Appeal (OHIM) Case R 495/2005-G, 4, para 19.

⁶⁸⁶ *ibid* 4, para 19.

⁶⁸⁷ *Dick Lexic Limited’s Application (DICK & FANNY)* Board of Appeal (OHIM) Case R 111/2002-4, 4, para 2.

⁶⁸⁸ *ibid* 4, para 10.

⁶⁸⁹ *ibid* 4 para 9.

⁶⁹⁰ *In Re McGinley* 600 F 2d 481, 482 (CCPA 1981).

⁶⁹¹ *ibid* 1, para 2.

of Customs and Patent Appeals (CCPA) affirmed the examiner's decision and argument that the mark was in conflict with decency and morality under Section 2(a) of Lanham Act. Interestingly, the Court adopted a clear position on the use of nude figures in trade marks: '[I]t is well established in obscenity cases that nudity alone is not obscene ... However, the threshold for objectionable matter is lower for what can be described as "scandalous" than for "obscene"'.⁶⁹² Therefore, it can be said that mere nudity is an acceptable reason to reject a trade mark registration according to Section 2(a) of Lanham Act.⁶⁹³

In the UK, a Hearing Officer refused to allow the word 'FOOK' to be registered as a trade mark following Section 3(3)(a) of the TMA 1994 on the 'basis that it consisted exclusively of the word FOOK which is phonetically very similar or, in some regional dialects, identical to the offensive word FUCK. As such, it was contrary to accepted principles of morality.'⁶⁹⁴ The decision of the appeal confirms that it would not be suitable to permit registration of the word 'fuck' as a trade mark. Although it is commonly used, it is a 'swear word' and can cause great offence to many people. It is considered to be more than just distasteful or smutty. It is clear that, if we accept that the 'mark FOOK has, at least in oral use, the same capacity to cause offence and outrage as the word FUCK in the context of this application, then such oral use cannot be disregarded and 'fuck' word the e, Therefor⁶⁹⁵.' other similar words are not acceptable to use as trade marks because they would contravene the principles of morality in society.⁶⁹⁶

A final, useful example of a vulgar mark can be found in the 'BULLSHIT' case. The Trade Mark Trial and Appeal Board (TTAB) refused to accept this mark under Section 2(a) as the mark was offensive, immoral and shocking to public feeling in the US.⁶⁹⁷

It is important to point out that using such offensive words on television and radio programmes do not make them acceptable. The Board of Appeal in the case of 'FUCKING FREEZING' clarified that even though many people use the term on a daily basis, it is still not part of ordinary language.⁶⁹⁸ In addition, the Board went on to comment that, '[a]lthough

⁶⁹² *In Re McGinley* 600 F 2d 481, 482 (CCPA 1981) 6, note 9.

⁶⁹³ See Stephen Baird, 'Moral Intervention in the Trade Mark Arena: Banning the Registration of Scandalous and Immoral Trademarks' (1993) 83 Trademark Report 661, 723.

⁶⁹⁴ *Kevin Scranage FOOK* (Appeal of application, UKIPO No 2309350/2005) para 9. Note that this mark was registered under OHIM application No 003883006.

⁶⁹⁵ *ibid* para 12.

⁶⁹⁶ Many trade mark applications have been rejected due to their similarity to the word 'fuck' which is considered to be contrary to morality in the EU, US and UK.

⁶⁹⁷ *Tinseltow, Inc* 212 USPQ (BNA) 863 (TTAB 1981).

⁶⁹⁸ *Thomas Türpitz Application ('FUCKING FREEZING!')* First Board of Appeal (OHIM) (1 September 2011) Case R 168/2011-1, 6, para 26.

the word “fucking” may also be used in advertising, on the radio, in films or in song, this does not alter its negative and offensive meaning’.⁶⁹⁹

Therefore, in acceding to this standard, the EUIPO has refused to register a number of marks under Article 7(1)(f) CTMR as they had strong sexual connotations and vulgar meanings such as ‘FUCKING & PERFECT’⁷⁰⁰ and ‘CLITORIS ALLSORTS’⁷⁰¹. This has also been the case in the US. For example, the USPTO refused to register ‘ALL YOU FUCKIN ‘HILLBLLIES SHUT UP’⁷⁰² and ‘I AM BULLSHIT PROOF’⁷⁰³. However, a notable example of what is meant by the difficulty in predicting the authorities’ position on marks that have sexual connotations or vulgar meaning is the ‘I LOVE My Penis’⁷⁰⁴ and ‘Big Cock’ marks.⁷⁰⁵ Both marks are connected with ordinary goods and services such as paper, household and kitchen utensils, clothing, footwear and headgear. Therefore, although these trade marks, from my point of view, contain strong sexual language, the EUIPO has accepted their applications.

Overall, these cases show that the standard with which to evaluate whether to accept or reject the registration of marks that contain sexual content or vulgar meaning depends on the level of the message the mark gives and its effect on the community.

(b) Significant religious terms and symbols

Despite all the debate about the relationship between religion and the state (religious or secular) in the EU, religious identity is still present at both levels. For example, the two major treaties which regulate the EU, the Constitutional Treaty and the Lisbon Treaty, include a reference to religion in the preamble. This shows the influence of religion on EU legislation⁷⁰⁶ as well as on the vast majority of the population.⁷⁰⁷ Hence, the role played by religion in determining public policy or morality principles within the Union is significant

⁶⁹⁹ *Thomas Türpitz Application* (‘FUCKING FREEZING!’) First Board of Appeal (OHIM) (1 September 2011) Case R 168/2011-1, 6, para 27.

⁷⁰⁰ *FUCKING & PERFECT* OHIM Trade Mark Application No 1092500.

⁷⁰¹ *CLITORIS ALLSORTS* OHIM Trade Mark Application No 004252821.

⁷⁰² *ALL YOU FUCKIN ‘HILLBLLIES SHUT UP’* USPTO Trade Mark Application No 8639145.

⁷⁰³ *I AM BULLSHIT PROOF* USPTO Trade Mark Application No 85184150.

⁷⁰⁴ *I LOVE My PENIS* OHIM Trade Mark Filing No 009960841.

⁷⁰⁵ *Big Cock* OHIM Trade Mark Filing No 001422146.

⁷⁰⁶ Council of the European Union, Brussels, Consolidated versions of the Treaty on European Union and the Treaty on the functioning of the European Union (15 April 2008) 6655/08: ‘Drawing inspiration from the cultural, religious and humanist inheritance of Europe, from which have developed the universal values of the inviolable and inalienable rights of the human person, freedom, democracy, equality and the rule of law.’ See also, European Commission, Archives of GOPA, ‘Dialogue with Religions, Churches and Humanisms – Issues: A Soul for Europe’ <http://ec.europa.eu/dgs/policy_advisers/archives/activities/dialogue_religions_humanisms/sfe_en.htm> accessed 1 November 2015.

⁷⁰⁷ See Pew Research Center, ‘The Future of World Religions: Population Growth Projections, 2010-2050’ <<http://www.pewforum.org/2015/04/02/religious-projections-2010-2050/>> accessed 1 November 2015.

and cannot be denied.⁷⁰⁸ Consequently, it is logical to protect people's religious terms, icons and names from any offensive use that is contrary to public policy or the accepted principles of morality according to Article 7(1)(b) CTMR.

The Western legal system approach to adopting and using the name or symbol of a religious group to identify products has been the subject of heated debate.⁷⁰⁹ Probably the most widely referenced cases in this category of decisions are the 'JESUS' and 'MADONNA' marks.

With respect to the word 'Jesus', this is a common first name in many countries. However, it is not a popular first name in Singapore and few would accept it as a first name.⁷¹⁰ The majority of Singaporeans would attribute only one meaning to Jesus and that is in connection with Jesus Christ. For that reason, 'JESUS' has been rejected for registration as a trade mark for clothing in Singapore.⁷¹¹ In the UK, the examiner rejected the registration of the word JESUS as a trade mark for similar reasons. This was justified by the fact that a small minority of the UK population recognise Jesus as an ordinary name, either as a first name or family name. However, a substantial number of the UK population would attribute only one meaning to the word Jesus and that is Jesus Christ.⁷¹² Hence, the mark is contrary to public policy and morality and using it would cause a great offence.⁷¹³ Moreover, the Appeal Court upheld the examiner's decision. The Appeal Court took a clear approach in stating that:

Although the degree to which marketers can safely use religious imagery and words will vary according to context, religion, etc., the nature of the product being marketed can influence whether the marketing communication will cause serious or widespread offence.⁷¹⁴

Nevertheless, the Appeal Court considered the name Jesus to be exceptional as it is so sacred: 'The power of the word JESUS to give rise to the relevant concern is not

⁷⁰⁸ See Ronan McCrea, 'The Recognition of Religion within the Constitutional and Political Order of the European Union' (*London School of Economics and Political Science*, 2009) <http://www.lse.ac.uk/europeanInstitute/LEQS%20Discussion%20Paper%20Series/LEQSPaper10.pdf> accessed 1 November 2015.

⁷⁰⁹ Stephen Baird, 'Moral Intervention in the Trade mark Arena: Banning the Registration of Scandalous and Immoral Trademarks' (1993) 83 *Trademark Report* 661, 712.

⁷¹⁰ Intellectual Property Office of Singapore, 'Marks Contrary to Public Policy or Morality' (2009) 7.

⁷¹¹ *ibid* 7.

⁷¹² UK International Trade Mark Application Serial Nos 689374 & 776058 (18 January 2005).

⁷¹³ *ibid* 18, para 26.

⁷¹⁴ *ibid* 15, para 20.

diminished by the nature of the goods in the different categories specified by the Applicant in the present case Marks Trade of Manual UKIPO the by confirmed is approach This ⁷¹⁵.’ Practice which emphasises that, ‘[w]here a sign has a very sacred status to members of a religion, mere use as a commercial trade mark may be enough to cause outrage’.⁷¹⁶ However, the word ‘JESUS’ has obtained two international trade mark registrations as well as registration in a number of EU countries.⁷¹⁷ In addition, the EUIPO has accepted registration of ‘JESUS’ as a trade mark for different kinds of goods and services.⁷¹⁸

One of the most prominent cases is the case of ‘MADONNA’ in which an American company in the 1930s wanted to register it as a trade mark for wine.⁷¹⁹ The CCPA refused to register this trade mark on the basis that the name refers to the Virgin Mary⁷²⁰ and linking this name to an alcoholic drink would be offensive to Christians due to the sacred position that Mary holds in their religion.

In a similar case, the TTAB upheld the examiner’s decision to refuse an application to register ‘MESSIAS’ as a trade mark on the grounds that ‘MESSIAS’ would be shocking if used on wine and brandy. The Court stated that: ‘it is submitted that to those professing the Christian faith, the term ‘Messias’ would signify Jesus Christ ... we are constrained to agree with the examiner that the use of the word ‘MESSIAS’ as a trade mark for wine and brandy is scandalous and therefore un-registrable’.⁷²¹ In the same context, the TTAB agreed with the examiner in refusing to register the mark ‘KHORAN’ for ‘alcoholic beverages, namely wines’ under Section 2(a) as it is a phonetic equivalent of ‘Koran’. The Court concluded that ‘Muslims would find the mark KHORAN used for wine as disparaging to themselves, their religion and their beliefs’.⁷²² However, in a case that considered AMISH as a mark, the Court overturned the decision of the examiner as it was convinced that using AMISH as a trade mark for cigars was not an insult to the followers or adherents of the Amish faith.⁷²³

⁷¹⁵ The Panel stated that they agreed ‘with the proposition advanced on behalf of the Applicant to the effect that religious significance is not always or necessarily sufficient to render a mark un-registrable under Section 3(3)(a).’

⁷¹⁶ The Manual of Trade Marks Practice sets out guidance on the Intellectual Property Office work practices. (3 March 2009) 173 <<https://www.gov.uk/government/publications/manual-of-trade-marks-practice>> accessed 1 November 2015.

⁷¹⁷ UK International Trade Mark Application Serial Nos 689374 & 776058 (18 January 2005).

⁷¹⁸ For example, ‘JESUS 2000’ No 000671446 OHIM and ‘JESUS’ No 0689374 OHIM.

⁷¹⁹ *Riverbank Canning Co* 95 F2d 327, 329 (CCPA 1938).

⁷²⁰ The court stated that ‘the word “Madonna” is generally understood to refer to the Virgin Mary or to a pictorial representation of the Virgin Mary.’ *Riverbank Canning Co* 95 F2d 327, 329 (CCPA 1938).

⁷²¹ *In re Sociedade Agricola e Comercial Dos Vinhos Messias, SARL* 159 USPQ (BNA) 275 (TTAB 1968).

⁷²² *In re Lebanese Arak Corporation* 94 USPQ 2D 1215 (TTAB 2010) 7.

⁷²³ *In re Waughtel* 138 USPQ 594, 595 (TTAB 1963).

It can be noted that in Holland a Dutch artist submitted a request to register the sign ‘Allah’ as a trade mark for commercial goods (clothes, shoes and other products) but the Benelux Office for Intellectual Property (BOIP)⁷²⁴ provisionally rejected his request based on the lack of a distinguishing element in this mark.⁷²⁵ On the other hand, the BOIP accepted registration of the word ‘JESUS has EU IPO Also, .⁷²⁷clothing for mark trade a as ⁷²⁶, registered the trade mark ‘BUDDHA This ⁷²⁹services. and goods of variety a for ⁷²⁸, difference is acceptable as it reflects the specificity of each society and its right in determining the content of the offensive trade mark.

Overall, it is clear that in the EU and US using religious names or symbols as trade marks is not strictly banned because refusing or allowing this use depends on the goods or services bearing the mark. In other words, the goods or services the mark is attached to will be the main element in determining if this use will cause harm or not. However, using significant religious symbols and words is likely to be refused in the UK regardless of the goods affixed to them.⁷³⁰

Accordingly, it can be concluded that there are varying perspectives on using very sacred words or symbols as trade marks in the Western system. However, as mentioned earlier, this is not strange as it is consistent with the concept of differentiation between countries regarding subjects that are in conflict with public policy and morality even if these countries share a similar legal system. In addition, it is clear from the above that the purpose behind rejecting registration of a trade mark that consists of religious symbols is to protect the feelings of believers, not the sacred symbol itself. Moreover, in general, considering

⁷²⁴ Benelux Office for Intellectual Property (BOIP), Decision 1 December 2006 of the Committee of Ministers of the Economical Benelux Union, amending the Benelux Convention on Intellectual Property (Trade marks and Designs) of February 25, 2005 date to entry into force 2006.

⁷²⁵ See ‘Artist to Appeal Against “Allah” Trade mark Reject’ (10 January 2013) <<http://www.worldipreview.com/news/artist-to-appeal-against-boip-s-rejection-of-allah-trademark>> accessed 25 March 2014.

⁷²⁶ According to the Quran, Jesus is Messenger of Allah (PBUH). In Surah Maryam 16, verse 30, God says ‘[Jesus] said, ‘Indeed, I am the servant of Allah, He has given me the Scripture and made me a prophet’. See also Surah al-Baqarah 3, verse 285, where God says: ‘The Messenger has believed in what was revealed to him from his Lord, and [so have] the believers. All of them have a belief in Allah and His angels and His books and His messengers’.

⁷²⁷ Benelux Office for Intellectual Property (BOIP) Database, ‘The Mark Registration’ Register No 0618251 <register.boip.int> accessed 26 March 2014.

⁷²⁸ See Tapas Aich, ‘Buddha Philosophy and Western Psychology’ (2013) 3 Indian Journal of Psychiatry 165.

⁷²⁹ Office for Harmonization in the Internal Mark (OHIM) Database, Filing No 005848767 <<http://oami.europa.eu/eSearch>> accessed 26 March 2014.

⁷³⁰ Intellectual Property Office of Singapore follows the same approach: ‘If the use of the trade mark will provoke greater offence than mere distaste, or even outrage, the mark will be denied registration without regard to the goods or services claimed for registration.’ Intellectual Property Office of Singapore, ‘Marks Contrary to Public Policy or Morality’ (2009) 5.

whether a mark is offensive does not have to be based on the view of the majority of society but only a substantial segment of it.

(c) Racial slurs and epithets

Public policy and morality provisions work as filters to prevent registering any marks that are in conflict with public interest, and this includes marks that consist of racial slurs, insults or epithets against any group in society as it can have a negative effect on minority groups who may be targeted by this form of racism; it is also harmful to society in general.⁷³¹ If the authority accepted registration of these marks, then it would give the impression that it promotes and supports the use of racial slurs, insults and other derogatory terms.⁷³²

In 2005, the EUIPO received an application to register a trade mark with the word 'PAKI' for use on different categories of goods and services, such as freighting, logistics and skeleton crates.⁷³³ The examiner's decision was to refuse registration of the mark on the grounds that, '[i]n the English-speaking area, the term 'Paki' is disparaging and pejorative'.⁷³⁴ The Board confirmed the examiner's decision and ultimately ruled that: 'There is no doubt that the term 'PAKI', in the English-language, is a pejorative, offensive designation of a Pakistani, or generally speaking, a person from the Indian subcontinent'.⁷³⁵ As a result, the appeal was dismissed and the mark was banned from registration under Article 7(1)(b).

Recently, in June 2015 in the US, a federal judge upheld a decision by the USPTO Appeal Board to revoke six well-known Redskins trade marks. The trade mark used by the American football team had been registered since 1967. The Court ruled that the marks were disparaging to Native Americans. The Redskins mark consisted of a matter that may disparage 'a substantial composite of Native Americans'.⁷³⁶ Similar to this, in 2014 the

⁷³¹ Greenawalt clarified this point: 'Epithets and more elaborate slurs that reflect stereotypes about race, ethnic group, religion, sexual preference, and gender may cause continuing hostility and psychological damage. The harms need not depend on whether listeners are the objects of the epithets or slurs listeners.' Kent Greenawalt, 'Insults and Epithets: are they Protected Speech?' (1990) 41(2) Rutgers Law Review 287, 302.

⁷³² The Court stated, when denying the Applicant's petition to legally change his name to 'Mister Nigger', that 'giving its imprimatur to a request to change a person's name to a surname commonly considered to be a racial epithet might be construed as encouraging or sanctioning a racial epithet, translating to "state action" promoting racial disharmony'. *Lee v Ventura County Superior Court* 11 Cal Rptr 2d 763, 765 (Calif App Ct 1992) 4, para 4. In the long term, there is no doubt that spreading the use of these racist and degrading descriptions in society would lead to feelings of injustice and discrimination which would harm social relations, provoke violence and 'deeply undermine self-esteem among members of the society.' Kent Greenawalt, 'Insults and Epithets: Are they Protected Speech?' (1990) 41(2) Rutgers Law Review 287, 302.

⁷³³ *PAKI Logistics GmbH v OHIM T-526/09 Trade Mark Application*, Case R1805/2007-1.

⁷³⁴ *ibid.*

⁷³⁵ *PAKI Logistics GmbH v OHIM T-526/09 Trade mark Application*, Case R1805/2007-1, 1, para 23.

⁷³⁶ *Pro-Football, Inc v Amanda Blackhorse, et al* Case No 1:14-cv-01043-GBL.IDD (8 July 2015) 69.

TTAB upheld the examiner's decision to refuse registration of the mark 'STOP THE ISLAMISATION OF AMERICA'. This was connected to a campaign to provide information regarding understanding and preventing terrorism yet it was felt that the mark was likely to disparage American Muslims as it could potentially suggest a link between Islam and its followers and terrorism.⁷³⁷

In the case of 'BLACK TAIL', a trade mark for adult magazines featuring naked African-American women, the USPTO refused the application and the examiner's decision was also supported by the Board on the grounds that the words, *based on the dictionary definition*, were considered to be offensive as: 'The mark BLACK TAIL essentially conveys, in vulgar terms, the idea of African-American women as sexual objects.'⁷³⁸ The Board concluded that all women but African-American women in particular would be offended by this mark. However, the Appeals for the Federal Circuit overturned the decision of the Board, affirming the Examiner's refusal to register 'BLACK TAIL' mark. The Appeal stated that the dictionary definition is not enough evidence to determine whether the word is 'scandalous' as there are other non-vulgar meanings of the term 'tail' in the dictionary, such as buttocks and rear end. Hence, the Board failed to base their decision on evidence of which definition would most likely be used by the public.⁷³⁹

Racial slurs or epithets can be diverse and many have been used throughout history. However, in modern times they may be perceived as offensive and incompatible with the development of society.⁷⁴⁰ The main consideration in relation to racial slurs and epithets, as demonstrated by the cases outlined above, is that when the registrar evaluates whether the mark is disparaging or derogatory, it should be based upon the perspective of the group that it refers to rather than society in general.⁷⁴¹

(d) Illegality

A mark will be considered offensive and un-registrable if it promotes or encourages illegal activity. In the US, an examiner refused an application to register 'ACAPULCO

⁷³⁷ *In re Pamela Geller and Robert B. Spencer* 751 F3d 1355; 2014 US App LEXIS 8867; 110 USPQ2D (BNA) 1867.

⁷³⁸ *In re Mavety Media Group* 33 F3d 1367, 1369, 1373, 31 USPQ2d 1923 (Fed Cir 1994) 4.

⁷³⁹ *ibid* 5.

⁷⁴⁰ The Court of Appeal of California explained this point by saying, 'Although the slang epithet "nigger" may once have been in common usage, along with such other racial characterizations as "wop", "chink", "jap", "bohunk", or "shanty Irish", the former expression has become particularly abusive and insulting in light of recent developments in civil rights'. *Alcorn v Ambro Engineering, Inc* 468 P2d 216 (Calif 1970) 6.

⁷⁴¹ See Jasmine Abdel-Khalik, 'To Live in in-"Fame"-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks' (2007) 25 Cardozo Arts & Entertainment 173, 204.

GOLD’ for suntan oil on the grounds that the mark was immoral and scandalous as the term used was commonly understood to mean marijuana.⁷⁴²

The applicant challenged the examiner’s decision and the TTAB did not agree with the examiner’s argument. In their view, it was also necessary to consider the relationship between the mark and the goods that they would be associated with: ‘While the notation “ACAPULCO GOLD” may be a synonym for marijuana, the question as to whether or not a term is scandalous or immoral within the meaning of Article 2(a) of the statute must necessarily be considered in relationship to the goods in connection with which it used’.⁷⁴³ Therefore, even if the mark consists of illegal content, that in itself is not enough of a reason to refuse to register the mark as the examiner must consider what type of goods and services the mark will be used for. In other words, if the mark is associated with goods relating to drugs such as smoking papers, shisha or hashish pipes, then registration of the mark would be refused as it would be seen as encouraging illegal drug use.

In Latvia, an application to register ‘LIVE LIGHT’ as a trade mark associated with tobacco products was refused as it was considered to be in conflict with public policy and socially accepted principles of morality. However, the mark was accepted in relation to advertising services.⁷⁴⁴ The Office’s decision was based on the fact that the ‘LIVE LIGHT’ mark may be seen by the public as an encouragement to consume the tobacco products. In 2008, there was a similar case in France where the Court of Appeal of Paris refused to register ‘EXTASY IF YOU TASTE IT, YOU’LL BE ADDICT’ as a trade mark for alcoholic beverages and beer on the grounds that the expression encourages consumption of an illegal, toxic and harmful product for human beings.⁷⁴⁵ The Court confirmed the examiner’s decision and stated that the mark suggested there was a link between the product and an illegal substance.⁷⁴⁶

In 2004, Sporting Kicks Ltd submitted an application to register the words ‘Inter City Firm’ as a trade mark in Classes 25 and 26.⁷⁴⁷ The examiner objected to the registration of

⁷⁴² *In re Hepperle* 175 USPQ (BNA) 512 (TTAB 1972).

⁷⁴³ Note that the TTAB was refused registration for the mark on other grounds to that of the ACAPULCO GOLD mark for suntan oil as it was likely to be confused with ACAPULCO for makeup products. *In re Hepperle* 175 USPQ (BNA) 512 (TTAB 1972).

⁷⁴⁴ *Live Light* Trade Mark Application M-99-87, Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications (WIPO/STrad/INF/5) 2010.

⁷⁴⁵ Court of Appeal of Paris, 26 September 2008 in WIPO, Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications (WIPO/STrad/INF/5) 2010.

⁷⁴⁶ *ibid.*

⁷⁴⁷ *Inter City Firm* Application No 2376955 (Decision date 11 November 2005 (UK)). Class 25: Clothing, footwear, headgear; Class 26: Lace, embroidery, pins, needles, buttons, hooks, pin badges, badges.

the mark under Section 3(3)(a) of the UK Trade Mark Act 1994 because the words ‘Inter City Firm’ were considered to be contrary to public policy. This is because the term promoted football hooliganism.⁷⁴⁸ He added, ‘It is my opinion that goods bearing the mark would be promoting gangs which provoke violence’.⁷⁴⁹ To support his point of view, the examiner pointed to websites which showed the use of ‘Inter City Firm’ and ‘ICF’ as relating to a group involved in hooliganism. In 2005, a decision was issued by UKIPO which rejected the registration of the mark under Section 3(3)(a) because it was contrary to public policy and because it was described as ‘anti-social branding’.

Additionally, the mark was considered to be likely to cause distress or alarm and, ‘given the renewed interest in groups such as the “Inter City Firm” it is against public policy to register a mark which might be interpreted as glorifying or promoting their exploits’.⁷⁵⁰ This is a clear example of how the mark may have a negative effect on public security, and therefore in order to protect society, public policy is used as grounds for refusing the registration of some forms of trade mark. Interestingly, the trade mark ‘THE SEX PISTOLS’ was registered in the 1970s.⁷⁵¹ It can be debated whether or not it could have been seen as a violation of public policy. However, the mark belonged to a pop group and was not considered to be equivalent to a violent criminal gang.⁷⁵²

In another case, UKIPO refused to register ‘www.standupifyouhateamanu.com’ as a trade mark on the grounds that it conflicted with public policy and morality under Section 3(3)(a). The Judge set out his position by stating that it would ‘increase the incidence of football violence or of other offensive behaviour’.⁷⁵³

In the EU, the Council of the European Union adopted the Common Position that specific measures should be put in place to combat terrorism. As such, any mark promoting the activity of individuals or groups that are contained on a list as having committed terrorist acts in the EU would be in conflict with public policy and would be refused registration.⁷⁵⁴

⁷⁴⁸ *Inter City Firm* Application No 2376955 (Decision date 11 November 2005 (UK)) 3.

⁷⁴⁹ *ibid* 3.

⁷⁵⁰ *ibid* 3, para 18.

⁷⁵¹ *ibid* 3, para 17.

⁷⁵² The Court stated that ‘The Sex Pistols ... were a pop group with the aim of providing musical entertainment, and their activities cannot be compared with that of a criminal gang whose activities centred on violent behaviour.’ *Inter City Firm* Application No 2376955 (Decision date: 11 November 2005 (UK)) 3, para 17.

⁷⁵³ *Manchester United Merchandising Ltd v CDW Graphic Design Ltd* (BL O-464-02 (UK)) 8, para 39.

⁷⁵⁴ Council Decision 2009/62/EC of 26 January 2009 implementing Article 2(3) of Regulation (EC) No 2580/2001 on specific restrictive measures directed against certain persons and entities with a view to combating terrorism [2009] OJ L23/25.

In general, the important factor in this context is to consider the impact the mark will have on the public and what the consequences would be. Therefore, even if a mark promotes illegal activity, it will not be automatically refused registration on the grounds of public policy and/or morality. For example, the mark ‘DEAD LAWYER’ was used on a variety of items but because the mark was used in a humorous way it was not seen as serious encouragement to commit illegal activities.⁷⁵⁵

5.4 Conclusion

The principles of public policy and morality can be used as a ground for the refusal of trade mark registration and protection, and it plays an effective role in banning rights acquisition. This chapter sought to provide a deep understanding of public policy and morality principles and their effect on trade mark.

From the preceding analysis, it can be seen that the two concepts of public policy and public morality in Western legal systems are not identical and there is an overlap. The term ‘public policy’ refers to the national authority of the state and its intention to achieve national goals and overall societal benefits. Yet, the term ‘public morality’ is entirely derived from the society's perspective of what is considered to be morally acceptable or unacceptable, and the aim of this classification is to protect the higher values of society in all social aspects of life.

The trade mark legislations in the Western legal system have adopted various terms in referring to public policy and morality. However, the majority of Western countries have a similar perspective on what is considered to be an offensive trade mark. The marks that are considered contrary to public policy and/or morality can be classified under four main headings as follows:

- (a) sexual and vulgar marks: this type of mark is connected to sexual themes and it is seen as one of the most traditional mark forms that may be considered in breach of public policy and/or moral principles. The standard to evaluate whether the mark is offensive or not in this category depends on the level of sexual or vulgar meaning delivered by the mark and its effect on the public;
- (b) religious terms and symbols: marks consisting of or comprising a religious symbol or name can be a controversial issue for Western legal systems. However, in

⁷⁵⁵ US Trade Mark Registration Application Serial No 74/074, 903.

general within the EU and the US, using religious names or symbols as trade marks is not strictly banned but depends on the goods or services bearing the mark;

(c) racial slurs and epithets: using racial slurs, insults or epithets against any group in society as a trade mark can be a reason to reject mark registration as it is considered to be in breach of public policy and morality principles. Determining if the mark is offensive is based upon the perspective of the group that it refers to rather than society in general;

(d) illegal content: marks that promote or encourage illegal activity are considered offensive under public policy and morality principles and are therefore ineligible for registration due to the negative impact they can have on public security.

The conclusions of this chapter in respect to public policy and morality principles and their effect on trade mark registration and protection in the TRIPS/Western legal systems will be compared with those relating to Islamic Shariah principles in Chapter Seven. The next chapter will involve a critical investigation to determine the principles of the Islamic public policy and morality principles, and will shed light on their effects on trade marks in the Islamic legal system.

Chapter Six

Islamic Public Policy and Morality Principles and their Effect on Trade Mark Recognition

6.0 Introduction

In the previous chapter, the principles of public policy and morality relating to trade marks in TRIPS and the Western system were discussed. This chapter's examination of Islamic public policy and morality is designed to match the equivalent examination of Western public policy and morality.

The aim of this chapter is to highlight influential aspects in the Islamic legal system used to determine whether a trade mark is acceptable in respect of public policy and morality. It will use the Kuwaiti law and cases as a means of providing a deeper understanding of Islamic public policy and morality principles that govern trade mark. This chapter looks at the concept, sources and scope of public policy and morality from an Islamic Shariah perspective. In order to reach an accurate determination of the Islamic public policy and morality principles that govern trade marks, the next section explores the *al-maslahah* theory through a thorough analysis of its impact on trade mark matters. The following section starts with a brief overview of the Kuwaiti legal system and then goes on to discuss the source of public policy and public morality principles. It explores the role of these principles within the Kuwaiti trade marks legal system. The chapter concludes with a discussion on Islamic public policy and morality regarding trade mark use of Kuwaiti law as a vehicle to help clarify its effect on trade marks registration and protection.

6.1 Public policy and public morality in Islamic Shariah

The discussion in this section is divided into two parts. The first part deals with public policy in Shariah to find out the meaning of the term and then the following key questions are answered: Is the term 'public policy' used in Islamic Shariah? Where can the rules of public policy in Islamic Shariah be found? What are the sources of these rules? The second part addresses public morality in Islamic Shariah. It starts by discussing the significance of morals in Shariah, the sources of public morals and the relation between public and personal morals.

6.1.1 Public policy in Shariah

(a) The expression ‘public policy’

The term ‘public policy’ in its modern sense was unknown in the traditional Islamic jurisprudence or by the early Muslims scholars. Nevertheless, some terms have been used in Islamic jurisprudence which are very close to the public policy term although not identical to it, such as ‘*almanfa’aa alammah* (public interest), ‘*alkhair alaam*’ (public welfare) and ‘*assalah alaam*’⁷⁵⁶ (general goodness).

This convergence between these expressions and the public policy concept in its contemporary sense can be understood through the previous part where the meaning of ‘public policy’ was explored in the Western legal system. As explained, public policy principles aim to protect the supreme interests of society and to achieve public benefit.⁷⁵⁷ The Islamic terms mentioned above are closest to the idea of public policy in the Western sense.⁷⁵⁸

(b) Public policy rules are associated with the rights of God

There is a consensus among ancient and modern Muslim scholars that rules based on or relating to God’s rights are not permitted to be violated. These rules aim to achieve public benefit which is higher in degree to special or personal interests and any agreement or contradiction with these rules is void.⁷⁵⁹ This concept represents the fundamental difference between the Islamic and Western approaches regarding public policy.

According to Salahuddin, God’s rights aim to achieve public interest and to protect Muslim society in general. Therefore, God’s rights represent the idea of Islamic public policy.⁷⁶⁰ Zoheily states that the rules of lawful ‘halal’ and forbidden ‘haram’ or as it also known, God’s rights, are nearly the same as the rules of public policy and morality in the modern legal system. These rules in Shariah have a significant impact on society as well as

⁷⁵⁶ Nearly a thousand years ago, Imam al-Mawardi illustrated the importance of general goodness and how it affects individuals, society and the state but without using the term public policy. Therefore, reforms in terms of general goodness – public policy – should be made on the basis of the interests of society and any imbalance in public policy rules could have very negative impacts on the entire society. Ali al-Mawardi, *Adab al-Dunya wa al-Din* (4th edn, Dar Iqraa 1985) 36. See Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 28.

⁷⁵⁷ See Chapter Five, 5.2.

⁷⁵⁸ See Abdullah Al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 28.

⁷⁵⁹ Imam Shatibi stated that God has established rules to achieve people’s worldly and after-death interests and any violation of this legislation will lead to an imbalance in the entire social system. See Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 2 (al-Maktaba al-Kobra 1975) 38.

⁷⁶⁰ Salahuddin Jamal al-Din, *Fikret Annizam al-Aam fi al-Elakat al-Khaseh Addawliyyeh Bayna al-Qawaneen al-Wadiyyeh wa-Sharihatul al-Islamiyyah* (Dar Al-fiker Aljamiy 2004) 27, 30.

on individuals. Hence, the reason beyond referring to them as ‘God’s rights’ is to show their importance and highlight their stature in Islamic Shariah.⁷⁶¹ From its general meaning, Sanhoury suggests that ‘Islamic Shariah has the same legal concept of public policy and morality referred to in Western jurisprudence, in principle’.⁷⁶² In other words, he argued that God’s rights in Shariah play the same role that public policy and morality play in the Western legal system.

God’s rights are the rights of the Muslim nation which aim to protect the benefits of all people or the majority of them, mainly the vulnerable who cannot safeguard their own rights.⁷⁶³ God has commanded to respect these rights and other principles relating to them. No one has the authority to violate or change them. This means that God's rights are the principle foundation and the most valuable rules of the Muslim community.⁷⁶⁴ Therefore, it is clear that Islamic public policy can be found in God’s rights principles.

(c) The sources of public policy in Islamic Shariah

Sources of public policy principles in Shariah are the same sources as Islamic legislation: the Holy Quran, Sunnah, *Ijma* and *Qiyas*.⁷⁶⁵ In Islam, it is compulsory for Muslims to obey the ruler’s orders as indicated in the Quran (Nisa 4, verse 59): ‘O you who have belief, obey Allah and obey the Messenger and those in authority among you.’ Based on this verse, legislations issued by public authorities are considered as part of Islamic public policy and must not be violated. Yet, this is conditional upon these legislations not contradicting or overlapping with the main Shariah laws. More generally, the Prophet (PBUH) said: ‘There is no obedience if it involves disobedience towards Allah; obedience is only in that which is right and proper.’⁷⁶⁶

It must be noted that not all the rights of God are considered to be part of Islamic public policy principles. This is due to the fact that these rights are not of an equal standing; only the rights associated with public policy are mandatory, i.e. actions to be carried out and acts forbidden for a Muslim to commit. Imam Shatibi stated that the rights of God are not all mandatory, only those that have a significant impact on human life and after death.⁷⁶⁷ In addition, Imam Quraafi differentiated between the rights of God and personal rights stating

⁷⁶¹ Wahbah Zoheily, *Nazariyat Addarourat al-Shariyyah: Muqaranah Ma’a alQanun al-Wadiy* (4th edn, Risala 1985) 28.

⁷⁶² Abdul Razzaq Sanhoury, *Masadir al-Haqq fi al-Fiqh al-Islamy* (Dar Ehya al-Tourath Arabi 1954) 90.

⁷⁶³ Mohammad Ashour, *Maqasid al-Shariah* (Dar alkitab almasri 2011) 255.

⁷⁶⁴ *ibid* 255.

⁷⁶⁵ See the Sources of Islamic Shariah, Chapter Three, 3.2.

⁷⁶⁶ Muslim ibn al-Hajjaj, *Sahih Muslim*, vol 5 (Nasiruddin al-Khattab (tr) Darussalam 2007) *Hadith* no 4766, 171.

⁷⁶⁷ See Ibrahim Shatibi, *Muwafaqat fi Uşul al-Shariah*, vol 3 (al-Maktaba al-Kobra 1975) 255.

that God's rights are only rules that are based on the orders to do or not to do something.⁷⁶⁸ In other words, they are the mandatory provisions in Shariah. Abul-Enein states that the most prominent characteristic of God's rights can differ from other rights such as personal ones. The rights of God are linked to the achievement of the public interest, even if it conflicts with individual's personal interests.⁷⁶⁹ The reason for this is that personal interests are not associated with God's rights, and hence they are not part of Islamic public policy principles.

In conclusion, the definition of Islamic public policy stated by al-Otaibi is an important way to understand the concept of Islamic public policy. al-Otaibi defines public policy according to Islam as a 'set of provisions and substantive procedures that aim to protect the community and to achieve public benefits for people in life and the hereafter; and no one shall violate or modify these provisions or agree otherwise'.⁷⁷⁰ This definition is superior to other similar definitions as it appears to be the only one that presents the concept of Islamic public policy in such a more comprehensive and detailed manner.

6.1.2 Public morality in Islamic Shariah

(a) The importance of morals

Morality remains an important contributor to the Shariah principles. For example, the Quran and Sunnah attach extreme importance to morals;⁷⁷¹ and morality, for both sources, is considered to be one of the main goals of Shariah. This is illustrated in what the Prophet Mohammed (PBUH) said: 'I have been sent to perfect good moral character',⁷⁷² and by how Mohammed (PBUH) was praised by Allah in the Quran in Surah al-Qalam 29, verse 4: 'and indeed, you are of a great moral character'. This means that the original reasons beyond his message were moral in character.⁷⁷³ Imam Ibn al-Qayyim suggests that good

⁷⁶⁸ Shihab al-Din al-Qarafi, *Al-Furuq*, vol 1 (al-Resalah 2003) 324.

⁷⁶⁹ Badran Abul-Enein, *Tareekhul al-Fiqh al-Islamy wa Nazariyat al-Milkiyyah wal Oqoud* (Dar al Nahda al Arabia 1968) 297.

⁷⁷⁰ Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 55.

⁷⁷¹ Islamic morality regulation includes a vast majority of details on daily Muslim life, for instance, how Muslims eat, drink, sleep, wake, deal with other people, buy, sell, travel, treat animals etc. See in general, Al-Imam Abu Zakariya Ad-Dimashqi, *Commentary on the Riyad-us-Saliheen* (Muhammad Amin (tr), Darussalam for Publishers and Distributors 1999).

⁷⁷² Anas Ibn Mal, *Muwatta Malik*, vol 2 (Mustafa Babi al-Halabi 1985) 904.

⁷⁷³ *ibid* 904. The Prophet (PBUH) said: 'Every religion has its distinctive moral characteristic, and the distinctive moral characteristic of Islam is modesty.' Anas Ibn Mal, *Muwatta Malik*, vol 2 (Mustafa Babi al-Halabi 1985) 905. Moreover, the Prophet (PBUH) said 'The believer may attain by means of good character the status of one who fasts and prays at night'. Hafiz Abu Dawud, *Sunan Abi Dawood*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2007) *Hadith* no 4798, 269.

morals are based on four pillars: patience, chastity, courage and justice, while bad morals are based on ignorance, injustice, lust and anger.⁷⁷⁴

(b) The sources of public morals

Rules of Islamic public morality are found in the sources of Shariah. The Quran as the most important source of legislation asserts public and private morality and hence is perceived as a moral constitution for Muslims.⁷⁷⁵ For example, in Surah Nahl 16, verse 90, God says: 'Indeed, Allah orders justice and good conduct and giving to relatives and forbids immorality and bad conduct and oppression. He admonishes you that perhaps you will be reminded'. As a result, the public morals of Islam are the morals that contain the teachings of the Islamic religion in general and the Prophet (PBUH) Sunnah in particular in Surah Ahzab 21, verse 21, God says: 'There has certainly been for you in the Messenger of Allah an excellent pattern for anyone whose hope is in Allah and the Last Day and [who] remembers Allah often'.

The Prophet (PBUH) is the full model that embodies the Islamic morals; and any behavior that complies with the approach of the Prophet is Islamic. In contrast, any behavior that contradicts with this approach is considered contrary to the Islamic morality. In short, Prophet's (PBUH) manners are the criteria that determine the Islamic morals. Morals in Islam are not based on the society's view of what is moral or what is not but rather on the Shariah view of it. Nevertheless, the society's perception of morals can be accepted if it does not contradict with the Shariah laws; Islam especially takes into account the society's customs/traditions as an important source of Islamic legislation.⁷⁷⁶

(c) Islamic public and private morals

In this context, morals in Islam can be divided into two parts. The first relates to personal behaviours or private actions that do not 'normally' have a serious impact on society. For instance, Shariah sets out rules for sneezing; when a person sneezes, he or she should praise Allah and cover his/her mouth. Meanwhile, others should reply with 'may Allah bless you'.⁷⁷⁷ Islam also encourages Muslims to visit sick people and promises a reward for this act in return. However, if a Muslim does not follow these morals, then he or

⁷⁷⁴ Ibn Qayyim al-Jawziyyah, *Madaarij Saalikeen*, vol 2 (7th edn, Dar al-Kitab al-Araby 2003) 294, 295.

⁷⁷⁵ Khaled Kharraz, *Mawsou'at al-Akhlaq* (Maktaba Atha Ahal 2009) 85.

⁷⁷⁶ See Chapter Three, 3.3. See also in general, John Hursh, 'The Role of Culture in the Creation of Islamic Law' (2009) 84 Indiana Law Journal 1402. A number of jurisprudence books are full of specific details regarding governing public and private Islamic morality. See, for example, Ali Mawardi, *Al-Ahkam al-Sultaniyyah* (Dar Ibn Qutaiba 1989).

⁷⁷⁷ The Prophet (PBUH) said: 'The rights of a Muslim on a Muslim are five: (1) To return the greeting, (2) to visit the sick, (3) to follow the funeral processions, (4) to accept invitations and (5) to reply to the sneezer'. Mohammed Bukhari, *Sahih Bukhari*, vol 2 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 1240, 167.

she will not be due to receive punishment. The reason for this is that these kind of acts are not obligatory but are rather recommended. The nonparticipation in these kind of acts as a result has no negative impact on other and does not jeopardise Islamic public policy and principles.⁷⁷⁸ The second is personal behaviour that has an impact on society. For example, Islam strongly forbids sexual affairs (adultery) outside a marriage relationship for both married and single people.⁷⁷⁹ While Shariah perceives this act as bad moral behaviour, it still calls for punishment for those who commit it, and therefore it is considered as part of public policy principles.⁷⁸⁰ From the above, it is clear that there is overlap between the terms public policy and public morality in the Islamic legal system. Further, it is not easy to find where one ends and the other begins. In addition, some Islamic researchers in this field believe that there is no need to search for these differences as they are nearly identical from the Islamic perspective.⁷⁸¹

To summarise, Islamic public policy and morality are not defined or determined by the society or by legislation but rather are based on Shariah rules which are mostly fixed and unchangeable. Therefore, Islamic Shariah does not accept any national or international agreements that conflict with it. Not all morals are considered to be public morality issues, only those that are obligatory. In practical terms, public morality is part of public policy and there is no need to distinguish between them. To be more precise, Islamic public morals are part of public policy which means that what contradicts with public morals consequently contradicts with public policy. As al-Otaibi states, there is no need to find a separate definition for public morals in the context of discussing public policy as they are intertwined.⁷⁸²

6.2 Islamic public policy and morality within *al-maslahah* theory

In the discussion above, Islamic public policy and morality have been illustrated using a contemporary perspective and it has been found that these concepts overlap and are linked to the rights of God according to Islamic jurisprudence. However, not all the rights of

⁷⁷⁸ Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 60.

⁷⁷⁹ In Surah an-Nur 24, verse 2, God says: 'The [unmarried] woman or man found guilty of sexual intercourse – lash each one of them with a hundred lashes'. Another example is when the Prophet (PBUH) said: 'Allah cursed effeminate men [those men who are in the similitude (assume the manners) of women] and those women who are in the similitude (assume the manners of men)'. Mohammed Bukhari, *Sahih Bukhari*, vol 7 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 5885, 418.

⁷⁸⁰ Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 60.

⁷⁸¹ *ibid* 60.

⁷⁸² *ibid* 60.

God are considered to be a part of Islamic public policy and morality.⁷⁸³ Therefore, to properly understand the impact of Islamic public policy and morality on trade marks, it is necessary to look to an important theory in Islamic jurisprudence – *al-maslahah*.

There are two main reasons behind choosing *maslahah* as a tool to understand the impact of Islamic public policy and morality on trade marks. Firstly, the *maslahah* concept is heavily associated with Islamic public policy and morality principles as it is the purpose of their application.⁷⁸⁴ In other words, commitment to the ideals of Islamic public policy and morality leads to achieving *maslahah*. Secondly, *maslahah* is considered a secondary source of Islamic Shariah which scholars use in order to issue a *fatwa* on a new subject and it is a form of *ijtihad* which is a tool available to accommodate human development across the ages and across all subjects.⁷⁸⁵ In other words, it is one source of Islamic Shariah that deals with modern issues and gives Islamic Shariah flexibility in the way religious texts are interpreted and understood in order to keep up with developments in Muslim societies.⁷⁸⁶ The *maslahah* theory is diverse and includes numerous classifications, details and controversial issues but only the most relevant points to this study will be presented and discussed.⁷⁸⁷

Linguistically, *maslahah* means interests or benefits ‘*manfa’ah*’ and is the antonym of *mafsadah* (evil).⁷⁸⁸ In its most basic sense, *maslahah* means ‘a cause or a goal which is good and brings benefit and prosperity’.⁷⁸⁹ Usually, scholars call the objectives of Islamic legislation ‘*maqasid al-Shariah*’ in their literature.⁷⁹⁰ Several scholars have discussed the

⁷⁸³ Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 99. See also, Ahmed Kholi, *Nazariyat al-Haqq Bayna al-Fiqh al-Islamy wal-Qanun al-Wadiy* (Dar al-Salam 2003) 67.

⁷⁸⁴ Felicitas Opwis, ‘Maṣlaḥa in Contemporary Islamic Legal Theory’ (2005) 12 *Islamic Law and Society* 182, 183. Kholi states that the clear example of God’s rights is ‘the five necessities’ in Islam: religion, life, mind, property and honour. Ahmed Kholi, *Nazariyat al-Haqq Bayna al-Fiqh al-Islamy wal-Qanun al-Wadiy* (Dar al-Salam 2003) 67.

⁷⁸⁵ Mohamad Kamali, *Principles of Islamic Jurisprudence* (3rd edn, The Islamic Texts Society 2003) 351; Muhammad Khan, ‘The Role of the Government in the Economy’ (1997) 14 *American Journal of Islamic Social Sciences* 155.

⁷⁸⁶ Felicitas Opwis, ‘Maṣlaḥa in Contemporary Islamic Legal Theory’ [2005] 12 *Islamic Law and Society* 182, 183.

⁷⁸⁷ It is worth mentioning that there are terms and concepts close in meaning to the concept of *maslahah* (interests), such as *istislah* and *maslahah mursalah*. Among the Muslim Sunni doctrine, *Zahirs* reject the authority of *al-maslahah*. See, in general, Yusuf al-Qaradawi, *Derasah fi Maqasid al-Shariah* (3rd edn, Dar Shorouk 2008). The author discusses the most important debate about the concept of *maslahah* and the mechanism of its application and the difference in doctrinal opinions.

⁷⁸⁸ Mohammed Abdul Naeem, *Mu’jam al-Mustalahat wal-Alfath al-Fiqhiyyah*, vol 3 (Dar al-Fazela 1999) 300.

⁷⁸⁹ Mohamad Laldin, ‘Understanding the Concept of Maslahah and its Parameters when Used in Financial Transactions’ (2013) 3 *Journal of Islamic Business and Management* 151, 153.

⁷⁹⁰ Scholars use several terms to refer to *maslahah* such as interest, aim, reason and purpose. See Nourredine Khadmi, *Alam Maqasid al-Tasharia* (Obeikan 2001) 8.

concept of *maslahah* in depth. The most prominent among them, as referred to in the literature, are Imam al-Ghazali who was the first scholar to set out the original concept and Imam al-Shatibi who significantly developed and refined the *maslahah* concept.⁷⁹¹

Imam al-Ghazali explained that *al-maslahah* is ‘the consideration which secures a benefit or prevents harm and is compatible with the goal and objectives of “*Maqasid Shariah*”, which protects the five necessary values namely, *religion, life, mind, lineage* and *property*’.⁷⁹² He added that anything that protects and secures these elements are deemed to be *maslahah* and anything which violates them is *mafsadah*. Also, anything that prevents *masfadah* is also considered to be *maslahah*.⁷⁹³

Imam al-Shatibi states that there are two types of *maslahah*; the worldly life *maslahah* principles which meet human needs and relate to the subsistence of human life and emotional and intellectual gratification in an absolute sense.⁷⁹⁴ The hereafter *maslahah* is that which relates to the fate of humans after death, either heaven or hell.⁷⁹⁵ Furthermore, he also said that in order to acquire the worldly life and afterlife *maslahah*, the five Shariah values set out above should be protected and preserved as they are the main objectives of Shariah.⁷⁹⁶

According to Al-Shatibi, the main objective of Islamic Shariah is the *maslahah* of society. The obligation in Shariah concerns the security of the *maqasid* of the Shariah (objectives of Shariah), which in their turn aim to protect the *masaleh* of society. *Maslahah* represents one of the basic subject matters of *maqasid* of Islamic Shariah. Consequently, *maqasid* and *maslahah* (interests) become substitutable expressions for the obligations in Islamic Shariah.⁷⁹⁷

Al-Khwarizmi considers *maslahah* to be the protection for Islamic Shariah objectives by removing evil from creation.⁷⁹⁸ According to Bouti, in general, *maslahah* can be defined

⁷⁹¹ Imam al-Ghazali and Imam al-Shatibi played a significant role in establishing and developing the *maslahah* theory in Islamic jurisprudence. Muhammad Khan, ‘The Role of the Government in the Economy’ (1997) 14 American Journal of Islamic Social Sciences 155, 157; Felicitas Opwis, ‘Maṣlaḥa in Contemporary Islamic Legal Theory’ (2005) 12 Islamic Law and Society 182; See also, Imam Abdul Malik Juwayni, *Al-Burhan fi Usoul al-Fiqh* (Dar Al Kotob Al Ilmiyah 1997).

⁷⁹² Imam Abu Ḥamid Mohamad Al-Ghazali, *Al-Mustasfa* (Reasalah 1997) 416.

⁷⁹³ *ibid* 416.

⁷⁹⁴ Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 2 (al-Maktaba al-Kobra 1975) 25.

⁷⁹⁵ *ibid* 33.

⁷⁹⁶ *ibid* 33.

⁷⁹⁷ Muhammad Masud, *Shatibi’s Philosophy of Islamic Law* (2nd edn, Kitab Bhavan 2009) 151.

⁷⁹⁸ Muhammad Al-Shawkani, *Irshad al-Fuhul*, vol 11 (Dar Alfazila 2000) 990.

as a ‘benefit that God wants to his people by securing their religion, life, mind, lineage and property’.⁷⁹⁹

Imam al-Ghazali and Imam al-Shatibi and the vast majority of the scholars who have written about the *al-maslahah* theory have classified the five objectives according to their importance into three categories: *daruriyat* (necessity), *hajiyyat* (needs) and *tahsinyat* (embellishments). The most important of the three is *daruriyat* which has priority over the other categories of *maslahah*.⁸⁰⁰

The three types of *maslahah* are linked to Islamic public policy if they serve the society’s public interest ‘*maslahah ammah*’.⁸⁰¹ Scholars look at Shariah rules as necessary to either prevent evil or bring good.⁸⁰² It is important to clarify that what this research looks at is the public interest of society ‘*ummah*’, which is obligatory since it is linked to the rights of God. Private *maslahah* is excluded from this research unless it has a specific impact or affects society.

According to Bouti, in understanding *maslahah* and determining if the act is considered good or evil, and before issuing a ruling on the grounds of *maslahah*, the following points need to be taken into account:⁸⁰³

- 1- *Maslahah* has to be compatible with the core of the religion and not in conflict with the main sources of Shariah: Quran, Sunnah, *Qiyas* and *Ijma*, and it is then called a legal *maslahah* or ‘*al-masaleh al-shareia*’. For example, if sociologists found that polygamy, which is compatible with the provisions of Islamic Shariah, is harmful to society and they suggest that it should be banned as it is a *mafsadah*, that would not be acceptable because it is in contravention of clear evidence in the Quran and Sunnah which permits polygamy under certain conditions.⁸⁰⁴
- 2- The five *masaleh* of the Shariah are ordered according to their importance and therefore the most essential amongst them is the religion *maslahah*. comes first and

⁷⁹⁹ Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 23.

⁸⁰⁰ Imam Abu Hamid Mohamad Al-Gazali, *Al-Mustasfa* (Reasalah 1997) 417; Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 2 (al-Maktaba al- Kobra 1975) 23. See in general, Abdullaah Jalil, ‘The Significance of Maslahah Concept and Doctrine of Maqasid al-Shari’Ah in Project Evaluation’ (2006) 3 The Journal of Muamalat and Islamic Finance Research 171, 202. See also, Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 119. Scholars explain that the legitimacy of the *maslahah* theory is based upon several pieces of evidence in the Quran, Sunnah, *Ijma* and *Qiyas*.

⁸⁰¹ Mohamad Kamali, *Principles of Islamic Jurisprudence* (3rd edn, The Islamic Texts Society 2003) 351.

⁸⁰² Izzedine bin Abdulsalam, *Alqwa'id al-Kubra* (Dar al-Qalam 2000) 14.

⁸⁰³ Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 44.

⁸⁰⁴ For instance, in Surah An-Nisa, verse 3, God says: ‘And if you fear that you will not deal justly with the orphan girls, then marry those that please you of [other] women, two or three or four. But if you fear that you will not be just, then [marry only] one ...’.

it has priority over the others as it is linked to the worship of God. The following *masaleh* follow in descending order: life, mind, lineage and property. In addition, it must be clear that the concept of *maslahah* in Shariah includes the worldly life and hereafter *maslahah* and the spiritual and physical *maslahah*.

3- Determining the *maslahah* or *mafsadah* of an act is based upon both the nature of the act and its outcome. To identify *maslahah*, there should be cooperation between experts from different fields and Muslim scholars to be sure that the *maslahah* is genuine ‘*haqiqiyyah*’ and that it is also compatible with Islamic Shariah.

In the context of this research, the general consensus of the scholars is that they associate public interests *maslahah* with the five necessity objectives of Shariah and consider any violation of these as *mafsadah*.⁸⁰⁵ The obligatory Shariah rules contain Islamic public policy and morality principles and are for *maslahah ammah* and protect the five necessary objectives of Shariah.⁸⁰⁶ In other words, Islamic public policy and morality aim to preserve *al-masaleh al-shareia*. Therefore, any violation of the five objectives of Shariah: religion, life, mind, lineage and property is considered evil/harm and is contrary to Islamic public policy and morality. Ashour states that Islamic public policy and morality principles are God’s rights; these principles preserve the purpose of Islamic Shariah and represent the best interests of society and any offence against these rights constitutes a violation of the objectives of Islamic Shariah.⁸⁰⁷ Consequently, in order to identify whether a trade mark is in line with Islamic public policy and morality or in conflict with it, the criteria that is used to assess it are the five necessary objectives of Islamic Shariah.

6.3 Public policy and morality principles that govern trade marks in the Kuwaiti legal system

This part of the research is split into two main sections: the first will address the rules on public policy and morality in the Kuwaiti Constitution; the second will look at public policy principles and morality in the Kuwaiti Trade Marks Law (the GCC law). However, it is important to briefly introduce the Kuwaiti legal system and show the relationship between it and Islamic Shariah and the TRIPS Agreement.

⁸⁰⁵ Rasha al-Disuq, ‘Juristic Family Rulings: A Study of Maqsid Al-Sariah’ (2012) 3 International Journal of the Jurisprudence of the Family 145, 149.

⁸⁰⁶ Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 46.

⁸⁰⁷ Mohammad Ashour, *Maqasid al-Shariah* (Dar alkitab Almasri 2011) 225.

6.3.1 The Kuwaiti legal system

Two main topics will be discussed in order to outline the Kuwaiti legal system. The first topic gives the sources from which Kuwaiti law derives its legal system and rule; and the position from the Islamic Shariah from these rules. The second topic illustrates the legislations related to the accession of Kuwait to the TWO.

(a) Kuwaiti law and Islamic Shariah

The Kuwaiti law system derives its legal rules from three sources. Their importance varies: legislation is considered the most important source, then the Islamic Shariah juristic rules and then the customary rules.⁸⁰⁸ This was explained clearly in Article 1, para 2 of the Kuwaiti Civil Law.⁸⁰⁹ This article states that the judge is obliged to execute the legal rules stated in the legislative texts. If the judge does not find a text that deals with the subject, he must apply the rules of Islamic jurisprudence. If the judge does not find such a text, he gives his ruling as per the customary rules.⁸¹⁰ It should be mentioned that civil law is the basis of the Kuwaiti legal system. It is considered the general doctrine which must be applied in any case which has no special text in the other branches of law.⁸¹¹

Legislation are the written legal rules made by the legislative power as per the legal procedures. In Kuwait, the Kuwaiti National Assembly is the body entrusted with issuing laws, as per the Kuwaiti legal system.⁸¹² The executive power has the right to legislate by

⁸⁰⁸ The Kuwaiti Civil Law was issued by Decree No 67 on the 1 October 1980 and entered into on 25 February 1981. Many of the articles in the Kuwaiti Civil Law were inspired by other Arab and Western laws in order to reach the best framework without compromising Islamic Shariah principles. See the Introduction of the Department for Legal Advice and Legislation, *The Kuwaiti Civil Law* (7th edn, Kuwaiti Council of Ministers 2004); See in general, Abdullah Hatem, *Min Huna Badat al-Kuwait* (2nd edn, Dar Qabas 1980) 65; Ian Edge, 'Comparative Commercial Law of Egypt and the Arabian Gulf' (1985) 34 Cleveland State Law Review 129.

⁸⁰⁹ Kuwaiti Civil Law No 67 of 1980, art 1.

⁸¹⁰ This text has been modified partially as the old text states that: 'If there is no text dealing with subject, the Judge's decision shall be in accordance to the custom. If he does not find any rules in custom dealing with the subject, the Judge applies his opinion, taking into account the provisions of Islamic jurisprudence which mostly deals with the current circumstances of the country and its interests as a guide for him.' In other words, custom comes before Islamic jurisprudence as a source of legislation. See the Amendment No 5 Law No 15 of 1996 (Kuwait Gazette No 259, issued on 6 February 1996).

⁸¹¹ Ali Radwan, *Al-Qanun al-Tijarah* (Dar Alfiker al-Arab 1970) 6. Interestingly, the Kuwaiti legislator uses the French civil law system as a basis for Kuwaiti modern civil rules. See, Isa Huneidi, 'Twenty-Five Years of Civil Law System in Kuwait' (1985) 1 Arab Law Quarterly 216. See also, in general, Ian Edge, 'Comparative Commercial Law of Egypt and the Arabian Gulf' (1985) 34 Cleveland State Law Review 129.

⁸¹² See the Kuwaiti Constitution 1962, art 51.

issuing law decrees. Such law decrees should not breach the laws issued by Parliament. Issuing laws is not the original competence of the executive power.⁸¹³

Islamic jurisprudence (*fiqh*) is one of the sources of Kuwaiti law.⁸¹⁴ As explained in Chapter Three, *fiqh* is the intellectual effort made by Muslim scholars and means a deep understanding and knowledge of the Islamic Shariah rules which must be derived from the Quran and/or the Sunnah principles.⁸¹⁵

Custom means the familiar habits of people regarding certain behaviours to the point of feeling that they are mandatory.⁸¹⁶ Custom is considered one of the oldest sources known to human societies regarding the legal rules with which individuals must regulate their affairs.⁸¹⁷ Before the amendment of the Kuwaiti Civil Law No 15 of 1996, custom occupied the second level. That is to say, custom was in second place after Islamic Shariah rules. Custom has two pillars. The first pillar is materialistic.⁸¹⁸ It means individuals are accustomed to a certain rule of conduct. The second pillar is moral. This is the feeling that such conduct is mandatory and that it is necessary not to breach it.⁸¹⁹

Regarding commercial transactions, Article 1 of the Trade Law No 68 of 1980⁸²⁰ shows that its main and first source is legislation which is issued by the competent power (National Assembly), as stated before.⁸²¹ The rules of commercial customs are applied unless there is a specific piece of text in the Trade Law.⁸²² The commercial customs may be general customs or special customs.⁸²³ If there is no commercial custom, the rules of the civil law are applicable in their capacity as general doctrine. legislation considers the rules of Islamic Shariah in the fourth level as one of the sources of commercial law.⁸²⁴ The interpretive judgments of the judiciary should be considered in order to make up for the shortage if the abovementioned sources have no specific judgment regarding a certain matter.⁸²⁵

⁸¹³ See the Kuwaiti Constitution 1962, art 73.

⁸¹⁴ See, in general, Dessouki Abu lail, *Nazaryat al-Haq* (Kuwait University 1996).

⁸¹⁵ See, in general, the Islamic Shariah sources, Mohammad Faizullah, *Fahm Usoul al-Ahkam* (Dar Tkadom 1989); See also, Mohammed Khodari, *Usoul al-Fiqh al-Islamy* (Al Maktaba al-Tigariya Al-Kobra 1969).

⁸¹⁶ Khalifa Hamida, *Al-Nezamu al-Dustoury al-Kuwaiti* (Kuwait University 2010) 24.

⁸¹⁷ Tharwat Abdul Rahim, *Sharh al-Qanun At-Tijari al-Kuwaiti* (Dar Al-Bohoth la-Arab Research 1975).

⁸¹⁸ Khalifa Hamida, *Al-Nezamu al-Dustoury al-Kuwaiti* (Kuwait University 2010) 24, 27.

⁸¹⁹ *ibid* 27.

⁸²⁰ The Kuwaiti Trade Law No 68 of 1980. The Act was published in the Kuwait gazette, 'al- Kuwait Alyoum' No 1338 issued on 5 January 1981.

⁸²¹ The Kuwaiti Trade Law No 68 of 1980, art 1 states that 'provisions of this law shall apply on trade, and on all commercial activity conducted by any person, even if a non-dealer'.

⁸²² Trade Law, art 2.

⁸²³ Mansour Al-Saeed and Ayed al-Marri, *Sharh al-Qanun At-Tijari al-Kuwaiti* (Dar-Alelm 2010) 22, 23.

⁸²⁴ The Kuwaiti Trade Law No 68 of 1980, art 2.

⁸²⁵ See Mansour Al-Saeed and Ayed al-Marri, *Sharh al-Qanun At-Tijari al-Kuwaiti* (Dar-Alelm 2010) 23.

In this context its very important to shed the same light on the Kuwaiti Constitution which is the most important piece of legislation in the Kuwaiti legal system. The Constitution of 1962 is the cornerstone in organising the legal structure of Kuwait.⁸²⁶ The Constitution sets out the three authorities (legislative, executive and judicial) and determines the limits of each power, as well as the general characteristics of Kuwaiti society. The Kuwaiti Constitution is at the top of the legal hierarchy in Kuwait and must not be breached.⁸²⁷ Then come the normal laws issued by the legislative authority represented by the Kuwaiti National Assembly, followed by the bylaws and the administrative decisions.

The second article of the Constitution declares that '[t]he religion of the State is Islam, and the Islamic Shariah shall be a main source of legislation'. This indicates that it is necessary to respect the rules of Islamic Shariah as a basis for the general order in the state as well as the mandatory rules of Islamic Shariah when they are adopted by the legislative power as stated in the Constitution.⁸²⁸ The text indicates that Islamic Shariah is one of the sources of legislation but is not the only source. This allows the legislator to adopt various sources when deciding national laws.⁸²⁹ It is worth noting that the Explanatory note clarified that reference to Islamic Shariah in Article 2 is in fact a reference to *fiqh*.

(b) Kuwait accession to World Trade Organization

The 2001 amendment to the Kuwaiti Trade Law No 68 of 1980 regarding trade marks was issued in execution of an international obligation assumed by joining the TRIPS Convention.⁸³⁰ This was an implementation of a national law issued by the National Assembly which considered the WTO treaty and its attachments a national obligatory law. On 15 April 1994, Kuwait joined the Treaty establishing the WTO and the attachments 1, 2 and 3 which are considered integral parts of the agreement. Kuwait also approved the final

⁸²⁶ See, in general, Mohammad Almoqatei, *Al-Waseet fi al-Nezam al-Dustoury al-Kuwaiti wa Muasasat Assiyasiyah* (2nd edn, Kuwait University 2008).

⁸²⁷ Mohammad al-moqatei, *Al-Waseet fin-Netham il-Dustoury al-Kuwaiti wa Mua'asasatihi Assiyasiyeh* (2nd edn, Kuwait University 2008).

⁸²⁸ Khalifa Hamida, *Al-Nezamu al-Dustoury al-Kuwaiti* (Kuwait University 2010) 39.

⁸²⁹ This text gives the legislator the opportunity to use other sources in addition to Shariah so the Kuwaiti Constitution is flexible in this respect. There have been many attempts to modify Article 2 during the life of the Kuwaiti Parliament to make Shariah the main source of legislation. Most times, the refusal came from the Amir of Kuwait whose approval is required by the Constitution for any constitutional amendment. Adil Tabtabai, *Al-Nezam al-Dustoury al-Kuwaiti* (3rd edn, Kuwait University 1999) 410. Al-Moqatei state that bills to amend Article 2 have been submitted by members of the National Assembly (MPs) several times. The first proposal was submitted on 19 April 1973 followed by further proposals in 1975 and 1981 as well as other years. See, Mohammad al-Moqatei, 'Introducing Islamic Law in the Arab Gulf States: A Case Study of Kuwait' (1989) 4 Arab Law Quarterly 138, 141. This shows the strong desire of a number of MPs to make Shariah the only 'main' source for Kuwaiti legislation.

⁸³⁰ The Explanatory Note of the Law (No 2 of 2001) amending some rules of the Trade Law issued by Decree No 68 of 1980. See, Kuwait Gazette 'al-Kuwait Alyoum' No 498 issued on 1 January 2001.

instrument that included the results of the Uruguay round of multinational commercial negotiations held in the city of Marrakech in Morocco. This is stated in Law No 81 of 1995 which ratified the WTO establishing Treaty.⁸³¹ All the abovementioned was enhanced by the issuance of Law No 2 passed in 1998, accepting Kuwait's joining the agreement to establish the World Intellectual Property Organization (WIPO). Law No 3 issued on 25 May 1999 amended four basic articles of the Law of 1980. Then, Law No 36 of 2014 accepted the accession of the Paris Convention for the Protection of Industrial Property.⁸³²

Most recently in 2015, Law No 13 of 2015 on Trade Marks in the GCC Countries was issued to repeal the trade mark rules set out in the Kuwait Trade Law No 68 of 1980. The provisions of the new trade mark law largely correspond to the previous laws in emphasising Kuwait's commitment to international agreements the country has joined in relation to trade marks.

6.3.2 Public policy and morality in the Kuwaiti Constitution

In principle, it can be said that some articles in the Constitution are considered the minimum standards of public policy and morality so these articles should not be violated or contravened in any way, whether by individual actions, agreements, national legislation or international agreements. Any legal act contrary to any of these articles would be void and would have no legal effect at all.⁸³³

Article 49 of the Constitution states that: 'Observance of public order and respect for public morals are a duty incumbent upon all inhabitants of Kuwait'. This is the general article in the Constitution which highlights the importance of respecting public policy and morality. It is the duty of all residents of Kuwait, whether they are Kuwaitis or other occasional or permanent residents, to respect the rules of public policy and morality.⁸³⁴

In Kuwaiti jurisprudence, there is no specific definition of the terms public policy and morality, and in the most cases there is no differentiation between the concept of public policy and the concept of morality.⁸³⁵ For example, Tabtabai uses the singular term to

⁸³¹ Law No 81 of 1995 accepted the establishment of the World Trade Organization.

⁸³² Kuwait Gazette 'al-Kuwait Alyoum' No 1183 issued on 11 May 2014.

⁸³³ See, in general, Mohammad Almoqatei, *Al-Waseet fi al-Nezam al-Dustoury al-Kuwaity wa Muasasat Assiyasiyah* (2nd edn, Kuwait University 2008) 14; See the Law that Established the Constitutional Court No 14 of 1973.

⁸³⁴ Adil Tabtabai, *Al-Nezam al-Dustoury al-Kuwaity* (3rd edn, Kuwait University 1999) 410.

⁸³⁵ See, for example, Saleh who did not give any definition for the public policy or morality concepts during his comment on art 49 of the constitution and the other articles that mention these terms. Osman al-Saleh, *Al-Nezam al-Dustoury al-Kuwaity wa Muasasat Assiyasiyah fi al-Kuwait* (2nd edn, Dar al-Kotob 2003) 288, 296. See also Khalifa Hamida who defined public policy but ignored the concept of morality. Khalifa Hamida, *Al-Nezam al-Dustoury al-Kuwaity* (Kuwait University 2010) 99.

comment on the concepts of public policy and morality, i.e. he deals with them as if they were one term.⁸³⁶ In addition, when he discusses the term public policy, it includes elements of both public policy and morality.⁸³⁷ Kuwaiti jurisprudence acknowledges the difficulty in finding a clear definition for the concepts of public policy and morality because of the ambiguity of these terms.⁸³⁸

According to Almoqatei, the Kuwaiti concept of public policy and public morality can be understood by Article 2 of the Constitution. It clarifies that the state religion is one that forms the basis of the principles of public policy and morality in Kuwait.⁸³⁹ In addition, Hamida states that Article 2 of the Constitution is one of the most important determinants of the concepts of public policy and public morals in the Kuwaiti legal system.⁸⁴⁰

Hamida uses the example of Law No 44 of 1968 which prohibits eating or drinking publicly during the daytime in the month of Ramadan. These acts are contrary to public policy and public morality, and are an example of the important role that Islamic Shariah plays in determining the principles relating to public policy and morality.⁸⁴¹ This shows the importance of Islamic Shariah and the effect it has on one of the most fundamental human freedoms: the freedom to eat and drink.

Also, the idea of family in Kuwait is based on religious values and is key to Kuwaiti society, which in turn plays a significant role in determining the parameters of public policy and morality. Article 9 of the Constitution states that: ‘The family is the corner-stone of society. It is founded on religion, morality, and patriotism.’ The Islamic religion is a large influence on the Kuwaiti family and on Kuwaiti society itself and this has a significant impact on the concepts and the limitations of public policy and morality.⁸⁴²

Article 35 of the Constitution states: ‘Freedom of belief is absolute. The State protects the freedom of practising religion in accordance with established customs, provided that it does not conflict with public policy or morals.’⁸⁴³ Although the Kuwaiti Constitution

⁸³⁶ Adil Tabtabai, *Al-Nezam al-Dustoury al-Kuwaiti* (3rd edn, Kuwait University 1999) 410.

⁸³⁷ Tabtabai explains the public policy as ‘principles that people used to respect and uphold even without the need for legal rules, and if those principles are violated, that would lead to harming public feelings’. Adil Tabtabai, *Al-Nezam al-Dustoury al-Kuwaiti* (3rd edn, Kuwait University 1999) 410.

⁸³⁸ Adil Tabtabai, *Al-Nezam al-Dustoury al-Kuwaiti* (3rd edn, Kuwait University 1999) 410.

⁸³⁹ Mohammad Almoqatei, *Al-Waseet fi al-Nezam al-Dustoury al-Kuwaiti wa Muasasat Assiyasiyah* (2nd edn, Kuwait University 2008) 155. Article 2 of the Kuwaiti Constitution states that: ‘The religion of the State is Islam, and the Islamic Shariah shall be a main source of legislation.’

⁸⁴⁰ Khalifa Hamida, *Al-Nezamu al-Dustoury al-Kuwaiti* (Kuwait University 2010) 99.

⁸⁴¹ Article 2 in this law gives the Minister of the Interior Affairs the right, during Ramadan, to close any public places, and these are normally restaurants that serve food. See *al-Iftar fi Ramada* Law No 44 of 1968.

⁸⁴² Mohammad Almoqatei, *Al-Waseet fi al-Nezam al-Dustoury al-Kuwaiti wa Muasasat Assiyasiyah* (2nd edn, Kuwait University 2008) 155.

⁸⁴³ Kuwaiti Constitution, art 35.

has recognised the human right to choose a religion or belief, and thus has given people the right to practise it, this right is not absolute but conditional on it not conflicting with Kuwaiti public policy or morality.⁸⁴⁴ This same principle goes for education in Kuwait which is limited by public policy and public morals; this means that only certain topics that are not in conflict with public policy and morals are taught in school.⁸⁴⁵

According to the Kuwaiti Court of Cassation, the term public policy encompasses political, social and economic interests that benefit society as a whole, and therefore has priority over individual interests. The Court stated that there is a duty on all members of society to take these interests into account and it is not permissible for any individual agreements to conflict with them.⁸⁴⁶ From the above, it can be seen that the Kuwaiti Constitution devotes attention to the idea of public policy and public morality, and it is obvious that Islam plays a major role in determining these principles.

In relation to trade marks in Kuwait, it can be said that there is no doubt that any trade mark in conflict with any rules of the Kuwaiti Constitution is considered unacceptable according to the Kuwaiti legal system. It follows, therefore, that any trade mark contrary to Islamic Shariah will not be recognised as a trade mark. In support of this is Article 49 which emphasises the importance of respecting principles of public policy and morality.

The discussion above is around the theoretical aspects of the relationship between the Kuwaiti Constitution and trade marks with regard to public policy and public morality. The practical application could be achieved by a constitutional appeal against any attempt to register a trade mark contrary to any of the articles of the Constitution but especially Article 49 which is based on Shariah principles along with the first part of Article 2 which highlights and confirms the Islamic identity of the state. The result of the appeal if approved is that the Court will decide that the article is contrary to articles of the Constitution, which will lead to the consequence that the contested article will not be considered or recognised.⁸⁴⁷

Therefore, if any law allows the registration of a trade mark that contravenes public policy or morals, the Constitutional Court will announce it as unconstitutional, which will lead to the repeal of the law and its consequences by the competent authority. As illustrated above, Islamic Shariah principles are considered as a key part of public policy and morality in the Kuwaiti legal system and, in particular, the Kuwaiti Constitution. In brief, the Kuwaiti

⁸⁴⁴ Khalifa Hamida, *Al-Nethamu al-Dustoury al-Kuwaiti* (Kuwait University 2010) 84.

⁸⁴⁵ Constitution, art 35(1): Education is a right for Kuwaitis, guaranteed by the state, in accordance with law and within the limits of public policy and morals.

⁸⁴⁶ The Court of Cassation, Case No 842 of 2002.

⁸⁴⁷ See The Law that Established the Constitutional Court No 14 of 1973.

Constitution forbids the registration of any trade mark that is contrary to public policy or morality principles, and Islamic Shariah forms part of these principles.

6.3.3 Public policy and morality in the Kuwaiti Trade Marks Law

The first law in Kuwait in respect of trade marks was issued in 1961.⁸⁴⁸ Before this, customary rules based on the good morals and customs of Kuwaiti trade and the principles of Islamic Shariah were one of the main sources of law,⁸⁴⁹ due to the nature of the conservative Kuwaiti society. Hence, it could be said that Kuwaiti society does not accept trade marks that are contrary to public policy or morality according to its Arabic and Islamic character.⁸⁵⁰

The first trade mark Act in 1961 refers to public policy and morality as the grounds for refusing trade marks if they are contrary to those principles. Article 68 refers to the marks which are not to be considered as trade marks and will not be registered accordingly, as stated in paragraph 2 of the Article: ‘Every expression, drawing and/or sign that are in conflict with morals or contrary to public policy’.⁸⁵¹ It is clear that Kuwait holds the morals of society in high regard and the importance of protecting these can be seen through Kuwaiti legislation such as the trade mark Acts. The second version of the Kuwaiti Trade Marks Law was issued in 1980 as part of the Kuwaiti Trade Law.⁸⁵² Article 61 is almost an exact copy of Article 68 of the first Trade Marks Law 1961.⁸⁵³ It states that a mark: ‘shall not be considered as a trade mark, nor shall it be registered if it has any of the following descriptions... 2- Every expression, drawing or sign that disrupts morals or are contrary to public policy’.⁸⁵⁴

The text above mentions limited forms of trade marks, i.e. expressions, drawings and signs. However, I do not understand the reason behind limiting those specific forms of marks in this article given that the Kuwaiti trade marks definition is very wide and not limited at

⁸⁴⁸ The Kuwaiti Trade Law No 2 of 1961. The Kuwaiti Trade Law No 68 of 1980.

⁸⁴⁹ Yacoub Sarkhou, *Anezam al-Qanouny li al-Alamaat Attijariyyah: Dirasah Muqaranah* (That Alsasil 1993) 16.

⁸⁵⁰ There is evidence of the importance of Islamic law principles used in Kuwait prior to the Trade Marks Law was issued in 1962. For example, the rules applied during the Ottoman Empire and Islamic Code, ‘Majellat al-Ahkam al-Adliya’ and Kuwait’s historical support of Islamic. See, in general, Mohammad Almoqatei, *Al-Waseet fi al-Nezam al-Dustoury al-Kuwaity wa Muasasat Assiyasiyah* (2nd edn, Kuwait University 2008) 156.

⁸⁵¹ The Kuwaiti Trade Law No 2 of 1961, art 68, para 2.

⁸⁵² The Kuwaiti Trade Law No 68 of 1980.

⁸⁵³ Article 62 of the Kuwaiti Trade Law No 68 of 1980 differs from the Article 68 of the Trade Law No 2 of 1961 in only one paragraph. Article 62 added a new reason to reject a trade mark that relates to Israel.

⁸⁵⁴ This paragraph is a copy of art 68, para 2 of the old Trade Law No 2 of 1961.

all, as the definition gives examples of what forms can be trade marks rather than of certain forms. Article 61 states that: ‘A trade mark shall mean anything that takes a distinctive form such as words, signatures, letters, numbers, drawings ... or any other sign or any combination of it ...’.⁸⁵⁵ In my opinion, there is a linguistic error in Article 62, paragraph 2 as it suggests that the article limits its application to three types of trade mark (expression,⁸⁵⁶ drawing and signs) which are listed in the article itself, and it does not mention the other trade mark forms in the aforementioned definition such as marks consisting of names or words. However, it would be illogical for the Kuwaiti legislature to have limited the types of signs that would be refused registration on the grounds of public policy or morality to only the three forms mentioned in the article.

In 2001, the Law Decree No 1 was issued, amending some of the rules contained in Trade Law No 68 of 1980. The definition of trade marks was extended in order to comply with the text of Article 15 in TRIPS.⁸⁵⁷ This amendment also includes Article 62, which has been reworded to: ‘shall not be considered as trade mark, nor shall it be registered if it has any of the following descriptions ... 2- The mark that is contrary to public policy or disrupts to public morals’.⁸⁵⁸ This article covers trade marks in any form and will not allow them to be recognised or registered as a trade mark if it is contrary to Kuwaiti public policy or morals. This amendment is compatible with the contemporary national legislations with regard to trade marks forms and the public policy and public morals.⁸⁵⁹

However, the GCC Law in Article 3(2) bans the registration as trade marks of ‘[e]very expression, drawing or sign that disrupts morals or are contrary to public policy’, i.e. this text is identical to Article 61 of the 1980 law which I criticized above. As such, even though the definition of trade marks in the GCC Law is wide and not limited,⁸⁶⁰ the types of marks that would be refused on the grounds of public policy or morality are limited to the three forms mentioned in the article (expression, drawing or sign). In short, this text is flawed and inaccurate and it does not reflect the legal meaning of this exception to reject trade mark registration. However, Article 3, paragraph 5 sets out a specific provision that bans the registration of ‘[m]arks which are identical or similar to symbols of a purely religious

⁸⁵⁵ Kuwaiti Trade No 68 of 1980. Chapter Two - trade marks and trade data, art 62.

⁸⁵⁶ This term ‘expression’ was not mentioned in the definition of a trade mark and in this context in the article it has a vague meaning.

⁸⁵⁷ See Kuwaiti Trade Law No 68 of 1980, art 61.

⁸⁵⁸ The Law Decree No 1 issued in 2001, amending the Kuwaiti Law No 68 of 1980, art 62, para 2.

⁸⁵⁹ See section 5.2.

⁸⁶⁰ See GCC Trade Mark Law, art 2: ‘A trade mark shall mean anything that takes a distinctive form such as numbers, words, signatures, letters, codes, numbers ...’.

nature'. In other words, the current trade mark law bans in particular the registration of a trade mark that consists of any religious symbols whether they are Islamic or non-Islamic. Sarkhou defined what marks would be contrary to public policy and morality as 'those which consist of obscene images or derived from a political system which is in conflict with the public policy of the State of Kuwait'.⁸⁶¹

In addition to the above, there are many provisions in the Kuwaiti Trade Marks Law relating to public policy. However, the question that arises here is how to differentiate these texts from other texts. The answer to this question comes from the Court of Cassation where the Court gave guidance on how to recognise principles that relate to public policy. The Court indicated that where the terms used in the text suggest that the rule is mandatory, then it would be considered to be a matter of public policy.⁸⁶² Therefore, the articles in the Kuwaiti Trade Marks Law that include words or terms that have an obligatory meaning are considered as public policy principles.

For example, Article 3 begins with the words 'shall not be considered as trade mark, nor shall it be registered if it has any of the following descriptions ...'.⁸⁶³ This gives a precise instruction, and it is clear that the ten cases mentioned in the article should not be accepted as trade marks and this is a matter of public policy. Another example is in Article 14: 'If the competent authority accepted a trade mark, it should advertise it in any means of publication prior to proceeding with its official registration'.⁸⁶⁴ It is clear that these provisions relate to public policy as the provisions include mandatory provisions that are not discretionary. It can be noted that this understanding must take a broad sense which means that any legal provision in the legislative Kuwaiti system, including mandatory terms that relate to trade mark, are considered as part of the public policy and public morality principles governing trade mark.

According to the Trade Mark Act, the competent authority in charge of registering trade marks is the Trade Mark Register Administration. It has the authority to decide whether or not a mark is in conflict with Kuwaiti public policy or morality.⁸⁶⁵ The Trade Mark Act grants the registrar broad powers, including the ability to order changes to a mark where

⁸⁶¹ Yacoub Sarkhou, *Anezhm al-Qanouny li al-Alamaat Attijariyyah: Dirasah Muqaranah* (That Alsasil 1993) 80. Note that this comment was made before the amendment to the 1980 Law. However, it is capable of being applied more generally and is still relevant to the new law.

⁸⁶² The Court of Cassation, Case No 842/2002.

⁸⁶³ Trade Marks Law No 13 of 2015, art 3.

⁸⁶⁴ *ibid* art 14.

⁸⁶⁵ Kuwaiti Trademark Law, art 63 states that 'A register entitled "Trade mark Register" shall be established at the competent Authority, wherein all trade marks, names, addresses of owners and descriptions of the goods'.

there is the possibility of any confusion between the mark and another registered mark or for any other reason as they see fit.⁸⁶⁶ Article 69 states that '[t]he registrar may impose restrictions or modifications to clarify the trade mark in such a way as to prevent confusion with previously registered or deposited marks, or for any other reason at his discretion'.

These broader powers of the registrar can be seen as reasonable because the registrar is the main person in charge of considering the application and ensuring that it does not conflict with any of the trade mark regulations.⁸⁶⁷ For example, if the mark lacks any distinguishing character or is contrary to any of the provisions stated in Article 62 then it can be refused.⁸⁶⁸ In addition, the registrar is also permitted to set down conditions on the use of the trade mark such as requesting that parts of the trade mark are not used individually or are not used in any way that might impose a different meaning on the trade mark.⁸⁶⁹ One of the registrar's duties is to find out whether the mark is compatible with public policy and morality.⁸⁷⁰

Note that, although it is quite clear from the Kuwaiti laws, such as the Constitution (Article 2), the Civil Law (Article 1, para 2) and the Trade Law (Article 1) that Islamic *fiqh*, through the issuing of *fatwas*, plays a pivotal role in the Kuwaiti legal system at both the legislative and judicial levels, Kuwaiti courts or trade mark examiners, in determining whether a mark contradicts the Kuwaiti/Islamic public policy and morality principles do not need to ask for a *fatwa* as they can do that on their own. Moreover, they are not bound by any *fatwa* presented by the litigants.⁸⁷¹ This can be seen in the examples illustrated in the following part.

The next part of the chapter will focus on Islamic public policy and morality and how it affects trade marks, using the Shariah objectives as guidelines and the Kuwaiti cases will provide further clarification.

⁸⁶⁶ Kuwaiti Trade Marks Law No 13 of 2015, art 69.

⁸⁶⁷ Yacoub Sarkhou, *Anezam al-Qanouny li al-Alamaat Attijariyyah: Dirasah Muqaranah* (That Alsasil 1993) 101.

⁸⁶⁸ Kuwaiti Trade Marks Law No 13 of 2015, art 62.

⁸⁶⁹ Yacoub Sarkhou, *Anezam al-Qanouny li al-Alamaat Attijariyyah: Dirasah Muqaranah* (That Alsasil 1993) 102.

⁸⁷⁰ *ibid* 102.

⁸⁷¹ The Kuwaiti Trade Law No 2 of 1962, art 163: 'In administering justice, judges are not subject to any authority'.

6.4 Islamic public policy and morality principles governing trade marks

The *maslahah* theory reflects the importance of public benefit in Islamic Shariah. It provides legal controls and a mechanism for Islamic public policy and morality. In order to make a correct ruling on trade marks, the ‘scale’ of public *maslahah* will be used to weigh the trade mark according to the five Shariah objectives, starting with the most important, religion, followed in descending order by life, mind, lineage and property.

(a) *Maslahah* which protects or preserves religion ‘*hifz al-din*’

This *maslahah* represents the core of Islam and is considered to be the greatest *maslahah* and the highest ranking. It is an absolute and there is consensus about this point amongst all scholars. It is permitted to sacrifice any other *maslahah* for the sake of preserving the *maslahah* of religion.⁸⁷² Moreover, some researchers believe that all *maslahah* are just a part of the interest of the religion ‘*din*’⁸⁷³ as God created people just to worship Him. This is confirmed in Surah Zariyat 56, verse 6, where God says: ‘And I did not create the jinn and mankind except to worship Me’.

The most prominent example presented by scholars to highlight the importance of preserving the *maslahah* of religion is *jihad*, where a Muslim sacrifices himself in order to protect *din*.⁸⁷⁴ Muslim scholars offer ways to preserve Islam as *hifz al-din*, such as by applying its provisions and obeying Shariah rules; inviting non-Muslims to Islam; defending it against any harm; and maintaining the religious beliefs of Islam from any distortion.⁸⁷⁵ Imam Sahibi explains that the framework of preserving religion is by remembering that religion is achieved through the Islamic concepts of faith and charity.⁸⁷⁶

In the light of the above discussion on *maslahah* which protects and preserves *hifz al-din*, Islamic public policy and morality in respect of trade marks can be assessed according to compatibility of the mark with respect to a Muslim’s *faith and rituals* of Islam as they are the cornerstone of the Islamic religion.⁸⁷⁷

The basis of the Islamic faith is the belief in six elements: *Allah*, the angels, the revealed books, the commissioned messengers (peace be upon them), resurrection and the day of Judgement (events of *qiyamah*) and the predestination by *Allah* of all things, both the

⁸⁷² Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 58.

⁸⁷³ Bashir Kubaisi, ‘Al-Maqasidu al-Shariyyah wa Kayfiatu Atta’amul Ma’aha Enda at-Ta’arud’ (2012) 2 Journal of College of the Great Imam 37, 44.

⁸⁷⁴ See, for example, Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 2 (al-Maktaba al-Kobra 1975) 15.

⁸⁷⁵ Mohamed Alyoubi, *Maqasid al-Shariah al-Islamiyyah wa Elaqtuha bil-Adilah al-Shariyyah* (Dar al-Hegra 1989) 193.

⁸⁷⁶ See Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 4 (al-Maktaba al-Kobra 1975) 27.

⁸⁷⁷ See, in general, Muhammad ibn Uthaymeen, *Sharh Usoul al-Eman* (Dar al-Watan 1989).

(seemingly) good and the (seemingly) bad.⁸⁷⁸ These elements are considered very sacred in Islam.

These six elements are an essential part of the Islamic religion so their protection forms part of Islamic public policy and morality. A mark should not disrespect any of the elements that make up the Islamic faith, otherwise it will be considered a violation of the Islamic public policy and morality. For example, as previously described, the mere use of God's name '*Allah*' as a trade mark is forbidden as well as the use of Quranic verses.⁸⁷⁹ Similarly, if the trade mark is in conflict with any of the six elements of faith, for example, if the trade mark contravenes the existence or monotheism of God which is the heart of Islam then it would be forbidden.

In Surah Al-Hajj 17, verse 30, God says: 'And whoever honors the sacred ordinances of Allah, it is best for him in the sight of his Lord'. The most prominent elements of the Islamic Rituals' 'sacred ordinances' are the 'Five Pillars of Islam'.⁸⁸⁰ These rituals and any Islamic symbols associated with the pillars of faith should not be used as a trade mark as they could be used in conflict with public policy and morality. This use may lead to degradation of the sanctity of religion in the hearts of the people and thus prejudice the *maslahah* of religion which is the most important of all *maslahah*.⁸⁸¹

In Kuwait, applications to register trade marks that disparage Islam or any other religions will be refused as these marks are contrary to public policy and morality. This was clarified by the Court when explaining the concept of public policy and public morality relating to trade marks. The Court stated that there is a consensus in the community that Islamic and other religious symbols should be respected. As such, any trade mark that violates the sanctity of these symbols is considered contrary to public policy and public morals, in particular, if it is offensive to God himself.⁸⁸² This interpretation from the Court is consistent with Kuwaiti/Islamic public policy and morality, especially if the Islamic character of Kuwaiti society is taken into consideration, which is that they will not accept

⁸⁷⁸ See, in general, Muhammad ibn Uthaymeen, *Sharh Usoul al-Eman* (Dar al-Watan 1989).

⁸⁷⁹ See Chapter Four, 4.3.

⁸⁸⁰ The Prophet (PBUH) said 'Islam is based on five principles' 1- To testify that *La ilaha illallah wa anna Muhammad ar-Rasul Alla* (none has the right to be worshipped but Allah and Muhammad is the Messenger of Allah); 2- to perform the compulsory Salat; 3- to pay Zakat to poor Muslims; 4- to perform the Hajj pilgrimage to Makkah; 5- to observe *Sawm*, fasting during the month of Ramadan.' Mohammed Bukhari, *Sahih Bukhari*, vol 1 (Muhammad Khan (tr), Darussalam 1997) *Hadith* no 8, 58.

⁸⁸¹ See the concept of *maslahah* to protect the religion in Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 199.

⁸⁸² *Kiss Nail Products Inc v Undersecretary for Commerce and Industry* The Court of First Instance, Case No 4387/2012 (Unreported).

any compromise on religious beliefs. It is worth noting that the court in this matter deals with different religious symbols equally without discrimination in relation to public policy and morality and the trade mark registration. It can be seen from the Court decision that the goods or services attached to the mark can influence whether the mark is offensive or not. However, the Court highlighted that the importance to ban the use of the holy God name in Islam ‘Allah’ as a trade mark. In other words, using the name God to identify goods or services is considered offensive regardless of the context or the uses of the mark. Hence, it is also contradictory with the Kuwaiti/Islamic public policy and morality principles. In the same context, According to public policy and morality principles, the Kuwaiti examiner refused to register a trade mark which consisted of the word ‘ZAGAT’ (*Zakat* is one of the five pillars of Islam).⁸⁸³

This judicial approach is consistent with this *maslahah* representing the core of Islamic public policy and morality, which is for the protection or preservation of religion. As already clarified, the *maslahah* religion is the most important in Islamic Shariah.

(b) *Maslahah* which protects or preserves life ‘*hifz al-nafs*’

The core of this *maslahah* is the preservation of human life. There are several Quranic verses that discuss the wrongful loss of human life. For example, in Surah Al-An'am 6, verse 51, God says: ‘Say, come, I will recite what your Lord has prohibited on you ... and do not kill your children out of poverty; we will provide for you and them ... And do not kill the soul which Allah has forbidden [to be killed] except by [legal] right.’ In Surah Al-Maidah 5, verse 32, God says: ‘... whoever kills a soul unless for a soul [i.e. in legal retribution for murder the death penalty] or corruption [done] in the land [i.e. that requiring the death penalty] - it is as if he had slain mankind entirely’.

These Quranic verses and others show the sanctity of the human soul in Islam. Therefore, this comes second in terms of the goals of Islamic Shariah and trumps the other three elements – mind, lineage, and property – in order to maintain and protect the human soul. The sanctity of the human soul includes all souls regardless of their religion or their origin or social status.⁸⁸⁴ In addition, there is no doubt that suicide is strictly prohibited in Islam as well as any act that leads to it such as hurting any part of the human body (including any aggressive activities).⁸⁸⁵

⁸⁸³ ‘ZAGAT’ The Court of First Instance Case No 2036/2013 (Unreported).

⁸⁸⁴ See Abdul Karim Zidane, *The Zimmīy we Mustamin fī Dar al-Islam* (Resalah 1982) 248.

⁸⁸⁵ There are several Quranic verses that prohibit killing or causing harm to a human, for example, in Surah Al-Baqarah 1, verse 2, God says: ‘Do not throw [yourselves] with your [own] hands into destruction’.

From that, Islamic public policy and morality prohibits any trade mark that may promote or encourage these prohibitions whether by the form of the trade mark or the goods it is affixed to. For example, according to Qaradawi,⁸⁸⁶ Gad Al-Haq and other scholars,⁸⁸⁷ smoking tobacco is forbidden in Islam as it could cause many serious diseases. It is in breach of two of the five objectives of Islamic Shariah, which are to preserve life ‘*hifz al-nafs*’ and property ‘*hifz al-mal*’.⁸⁸⁸ Consequently, tobacco trade marks are in conflict with Islamic public policy and morality. Along the same lines, a mark that consists of names or symbols associated with terrorist organizations is forbidden, for example, al-Qaeda or the Islamic State of Iraq and the Levant (ISIL).

In addition, Islam does not make a correlation between tangibility and *maslahah* which preserves life. This *maslahah* is not limited to the physical assault but it includes moral outrage and an attack on human dignity.⁸⁸⁹ Hence, the Islamic public policy and morality prevent marks consisting of insults, racial slurs and epithets.⁸⁹⁰ In this context, it is worth mentioning that the Kuwaiti Court in the *Kiss Nail* case considered racial, ethnic or gender disparagement as illegal elements that breached public policy and morality. Hence, any marks consisting of these elements will be refused according to public policy and morality.⁸⁹¹ As illustrated earlier, this corresponds to the Shariah concept of *maslahah* which preserves life and protects human dignity.

(c) *Maslahah* which protects or preserves the mind ‘*hifz al-aql*’

The mind is a great blessing from God. It distinguishes humans from animals, and the human mind is the basis of all legal and moral responsibility in Islamic Shariah.⁸⁹² God mentioned the mind in the Quran more than forty times in different contexts. It should be

⁸⁸⁶ Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 77.

⁸⁸⁷ Tareq al-Towers, ‘The rule of religion in smoking habit’ (Al-Mu’tamer al-Iqlimi li-Mukafahatu Attadkheen, Kuwait, April 1998).

⁸⁸⁸ There is no consensus among Muslim scholars about the prohibition of smoking. For example, according to Abd al-Ghani al-Nablusi, Abdul-Qader al-Tabari and others, there is no clear evidence in Islamic Shariah that ban smoking tobacco and then this act is permissible. See Al-Mawsu’ah al-Fiqhiyyah (2nd edn, 1987) vol 10, 150. See also Muhammad al-Khayat, *Islamic Ruling On Smoking* (2nd edn, World Health Organization: Regional Office for the Eastern Mediterranean 2000).

⁸⁸⁹ Hussein Alosrj, ‘Nazariyatu Maqasid Ashariyah wa Atharuha fi Bina’a al-Mujtama’a’ (2012) 203 Diyala University Faculty of Islamic Sciences 1670, 1675.

⁸⁹⁰ God says in Surah al-Hujurat, verse 11 that: ‘O you who have believed, let not a people ridicule [another] people; perhaps they may be better than them; nor let women ridicule [other] women; perhaps they may be better than them. And do not insult one another and do not call each other by [offensive] nicknames. Wretched is the name of disobedience after [one’s] faith. And whoever does not repent - then it is those who are the wrongdoers.’

⁸⁹¹ *Kiss Nail Products Inc* Application No 132202/2012. The Kuwaiti Ministry of Commerce and Industry decision 14-10-2012 (Unreported).

⁸⁹² Mohamed Alyoubi, *Maqasid al-Shariah al-Islamiyyah wa Elaqtuha bil-Adilah al-Shariyyah* (Dar al-Hegra 1989) 235.

used to make logical judgments and prove the validity of the Islamic faith.⁸⁹³ For example, in Surah Al-an-Nahl 16, verse 11, God says: ‘He causes to grow for you thereby the crops, olives ... Indeed in that is a sign for people who give thought’, and in verse 12, ‘He has subjected for you the night and day and the sun and moon and the stars are subjected by his command. Indeed in that are signs for people who reason’.

Based on the above and other reasons, Islamic Shariah prohibits everything that intoxicates the mind in away that affect how they act or influence their awareness of their actions. Imam Razi states that ‘the mind is the noblest characteristic of a human and the first enemy to it is alcohol’.⁸⁹⁴ Imam Ghazali makes it clear that the reason behind prohibiting alcohol and anything else that has the same effect is because it blinds the mind. This is problematic as protecting the mind is one of the goals of Shariah as it determines human competency and enables the fulfilment of Islamic obligations.⁸⁹⁵ In addition, Umar bin al-Khattab, the second Khalifa of the Muslims, said that alcohol makes people lose their *al-mal* (money) and their *aql* (minds).⁸⁹⁶ It is clear then that Islamic Shariah prohibits anything that disrupts the mind or makes it weak because of the impact it can have on various sectors of society: social, economic, security and other important sectors.⁸⁹⁷

As the *maslahah* of the mind is so important, any trade mark consisting of or presenting materials that have a negative impact on the human mind is considered to be contrary to Islamic public policy and morality. An obvious example in this context are marks that consist of illegal elements in which a taste mark contains alcohol. The Criminal Code in Kuwait strictly bans alcohol.⁸⁹⁸ So, put simply, any taste trade mark that includes alcohol (or any kinds of illegal drugs) is forbidden from being registered as a trade mark in Kuwait.⁸⁹⁹ Although there is no specific provision in the GCC Trade Mark Law that deals with these issues, these are considered contrary to public policy and morality in Kuwait as it has been inferred from other relevant laws.

(d) *Maslahah* which protects or preserves lineage ‘*hifz al-nasal*’

There are two areas that must be discussed in respect of this *maslahah* which may have an impact on the treatment of trade marks. First, this *maslahah* relates to the importance

⁸⁹³ Mohamed Abdul Baqi, *Mu'jam al-Quran* (Dar al-kotob masriyah 1944) 468.

⁸⁹⁴ Mohammed al Razi, *Tafsir al-Kabir*, vol 6 (Dar al-Fikr 1981) 49.

⁸⁹⁵ Abu Hamid Mohammed Ghazali, *Shifa Al-Ghalil* (Irshad 1971) 160.

⁸⁹⁶ Mohamed al-Sarakhsi, *Al-Mabsut*, vol 24 (Dar al-Marefah 1989) 2.

⁸⁹⁷ Yusuf al-Alim, *Al-Maqasid al-Ammah li al-Shariah* (2nd edn, International Islamic Publishing House 1994).

⁸⁹⁸ The Kuwaiti Criminal Law No 16 1960, art 206.

⁸⁹⁹ Note that the GCC Law definition of trade mark did not mention taste mark as it did with smell and sound marks. See the Kuwaiti Trade Mark Law No 13 of 2015, art 3.

of reproduction and the continuation of the human race.⁹⁰⁰ The Prophet (PBUH) said: ‘O young men, whoever among you can afford it, let him get married’,⁹⁰¹ and He said: ‘Marry the one who is fertile and loving, for I will boast of your great numbers.’⁹⁰² In general, Shariah encourages having offspring and building a family, and therefore having a vasectomy or hysterectomy should only be for medical reasons and permanent forms of contraception are prohibited.⁹⁰³

The second one is the prohibition of sex outside marriage or any sexual acts that are inconsistent with the provisions of Islamic Shariah such as homosexuality and lesbianism.⁹⁰⁴ Islamic Shariah strictly forbids adultery of any kind as it may cause mixing of lineages. In Surah Al-Isra 17, verse 32, God says: ‘And come not near to the unlawful sexual intercourse. Verily, it is a *Fahishah* [i.e. anything that transgresses its limits (a great sin)], and an evil way (that leads one to Hell unless Allah forgives him).’ In Surah Al-Nur 24, verses 30 and 31, God says: ‘Tell the believing man to reduce of their vision’⁹⁰⁵ and guard their private parts’, ‘Tell believing men to lower their gaze and guard their private parts’, and verse 31 continues with ‘And tell the believing women to lower their gaze and guard their private parts’ Therefore, according to Islamic Shariah sex is only permissible within a marriage to avoid the corruption of morals and the mixing of lineages.⁹⁰⁶

When applying all of the above to trade marks, any trade mark that encourages permanent contraception and childlessness or promotes products or services for the same purpose or any trade mark that is overtly related to sex or affixed to sexual goods or services would be contrary to Islamic public policy and morality and would be in conflict with the preservation of lineage (*hifz al-nasal*) which is the fourth objective of Islamic Shariah.⁹⁰⁷

⁹⁰⁰ Mohamed Alyoubi, *Maqasid al-Shariah al-Islamiyyah wa Elaqtuha bil-Adilah al-Shariyyah* (Dar al-Hegra 1989) 248. Ashour states that scholars did not give a clear explanation of the preservation of lineage and it is a contentious issue which needs to be clarified. His explanation can be found in Mohammad Ashour, *Maqasid al-Shariah* (Dar alkitab almasri 2011) 138.

⁹⁰¹ Hafiz An-Nasai, *Sunan An-Nasai*, vol 4 (Nasiruddin al-Kattab (tr), Darussalam 2008) *Hadith* no 3213, 89.

⁹⁰² *ibid* *Hadith* no 3229, 99.

⁹⁰³ Mohamed Alyoubi, *Maqasid al-Shariah al-Islamiyyah wa Elaqtuha bil-Adilah al-Shariyyah* (Dar al-Hegra 1989) 248. See Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 191.

⁹⁰⁴ Mohamed Alyoubi, *Maqasid al-Shariah al-Islamiyyah wa Elaqtuha bil-Adilah al-Shariyyah* (Dar al-Hegra 1989) 248. The Prophet (PBUH) said ‘Whoever you find doing the action of the people of Lut, kill the one who does it, and the one to whom it is done’. Mohammed al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiruddin al-Khattab (tr), Darussalam 2007) *Hadith* no 2561, 469.

⁹⁰⁵ Looking only at what is lawful and averting their eyes from what is unlawful.

⁹⁰⁶ See Yusuf al-Qaradawi, *Halal and Haram fi al-Islam* (13th edn, Islamic Library 1980) 144.

⁹⁰⁷ However, this provision does not apply if these sexual products are in the framework of marriage and the services or goods, for example, intended to increase fertility.

The following examples will help to clarify how the Islamic authorities may deal with trade marks with sexual content. Sexy Hair Concepts LLC was an American company which filed an application to register their name as a trade mark in Kuwait. The mark spells ‘Sexy’ in Latin letters next to a star, in respect of the goods in Class 3.⁹⁰⁸ The examiner rejected the application under the grounds that the trade mark was in conflict with Article 62, paragraph 2 (of Law No 1 of 2001), i.e. the examiner considered the mark to be contrary to public policy and the accepted principles of morality in Kuwait.⁹⁰⁹

In another example, Kiss Nail Products Inc. was a company that applied to register its mark ‘KISS’ written in Latin letters, in respect of products in Class 21.⁹¹⁰ In this case, the examiner also refused to register the mark according to Article 62, paragraph 2 (of Law No 1 of 2001).⁹¹¹

Kiss Nail Products Inc appealed the examiner’s decision to the Competent Court. They argued that the refusal to register the trade mark because of the word ‘Kiss’ was an incorrect application of Article 62, paragraph 2. In addition, the appellant added that ‘KISS’ was a well-known trade mark in nail care products and artificial nails. Moreover, this mark had been registered in many countries and the appellant gave examples of other Muslim countries which had accepted registration such as Indonesia, Malaysia, Pakistan, Brunei and Kazakhstan.⁹¹² Therefore, the Appellant’s argument was that there was no acceptable legal reason to justify the examiner’s decision to refuse to register ‘KISS’ as a trade mark.

The Court⁹¹³ began giving its decision by emphasising the importance of protecting public policy and morality. The Court stated that the word kiss translates to ‘*qubla*’⁹¹⁴ in Arabic. Therefore, the trade mark was contrary to public policy and breached public morality as it was in conflict with Islamic values. The Court explained that the trade mark was contrary to the principles of virtue, which Islamic Shariah encourages. In addition, Shariah does not promote or encourage sexual inferences and this mark conflicts with these values. The Court was in agreement with the decision made by the examiner that the trade mark was contrary to an accepted principle of morality and the appeal was dismissed. It can be seen from this Court decision that the grounds for refusal to register the mark ‘KISS’ was because

⁹⁰⁸ Hair care products such as shampoos, hair creams, hair clips etc. The Law Appendix 1, Class 3.

⁹⁰⁹ *Sexy Hair Concepts LLC* Application No 147015/2014. The Kuwaiti Ministry of Commerce and Industry decision. ‘SEXY’ Trade Mark in 13-5-1994 (Unreported).

⁹¹⁰ Equipment of nail treatment. Appendix 1, Class 21.

⁹¹¹ *Kiss Nail Products Inc* Application No 132202/2012, Kuwaiti Ministry of Commerce and Industry decision 14-10-2012 (Unreported).

⁹¹² Portfolio of documents submitted by the applicant company. Case 4387/ 20121.

⁹¹³ *Kiss Nail Products Inc* Court of First Instance, Case No 4387/2012 (Unreported).

⁹¹⁴ Kiss and ‘*Qubla*’ in Arabic have the same meaning.

of the Islamic public policy principles and Eastern culture and traditions as they form the basis of public policy and morality in Kuwait. The Court gave guidance on how to recognise principles that relate to public policy and morality which may affect trade mark registration as it considered the conflict with Eastern culture and traditions as an acceptable reason to reject the trade mark. In short, the court extends the meaning of public policy and morality to cover a wide range of matters. However, the Court merely discussed the literal meaning of the mark in Arabic and did not address the pronunciation of the actual word in the local Arabic language, which is provocative (the word ‘kiss’ has a sexual meaning in Arab slang).⁹¹⁵

(e) *Maslahah* which protects or preserves property (*hifz al-mal*)

As mentioned earlier, the five necessary Shariah objectives are not on the same level; religion comes first followed in descending order by life, mind, lineage and property.⁹¹⁶ Consequently, although registration and protection of trade marks are seen as *maslahah* for the protection of property (*hifz al-mal*), these trade marks will be considered as *mafsadah* if they are in conflict with any of the other *masaleh* as the *maslahah* in the protection of property is the least important of the five necessary objectives of Shariah.⁹¹⁷

Preservation of *mal* (property) is the fifth goal of Islamic Shariah. Shariah has attached importance to it by setting out how to manage and preserve it. According to the scholars, Islamic Shariah has two key methods to achieve this goal. First, Islam prohibits theft, fraud, bribery and any other act that may lead to taking other people’s property illegally or without any right to it.⁹¹⁸ In Surah Al-Baqarah 1, verse 188, God says: ‘And do not consume one another’s wealth unjustly’. In addition, Islamic Shariah stipulates strict penalties for offences against property to act as a deterrent, such as in Surah Al-Maida 5, verse 38, when God says: ‘[As for] the thief, the male and the female, amputate their hands’.

⁹¹⁵ In another case, the Court revoked the decision of the Ministry of Commerce to refuse registration of ‘Love Fury Kiss’ as a trade mark and obliged the competent authority to accept registration as it was not considered to conflict with Kuwaiti norms, public policy or acceptable morality. *Nine West Company v Undersecretary for Commerce and Industry* Court of Appeal, Case No 2973/2012 (Unreported). However, the Ministry of Commerce has challenged this decision before the Supreme Court. Nevertheless, the final judgment has not been issued on this matter until the submission of this thesis. Case No 378/2014.

⁹¹⁶ Mohammed Bouti, *Zawabit al-Maslahah fi al-Shariah al-Islamiyyah* (Reasalah 1979) 58.

⁹¹⁷ *ibid* 58.

⁹¹⁸ Nourredine Khadmi, *Alam Maqasid al-Tasharia'* (Obeikan 2001) 85.

Secondly, Shariah sets out several rules which aim to protect property. For example, it forbids *riba* (interest), the negative repercussions of usury are not limited to finance but extend to all aspects of life.⁹¹⁹ In Surah Al-Baqarah 1, verse 276, God says: ‘Allah will destroy *Riba* [usury] and will give increase for *Sadaqat* [deeds of charity, alms, etc.], And Allah likes not the disbelievers, sinners’. It also forbids gambling as it has disastrous effects on the country’s economy and personal money.⁹²⁰ In Surah Al-Baqarah 1, verse 219, God says: “‘They ask you about the wine and gambling.’ Say, ‘In them is great sin and [yet, some] benefit for people. But their sin is greater than their benefit’”.

This topic is broad and the elements listed above are just some examples of how property is protected in Islamic Shariah.⁹²¹ Therefore, it can be seen that any act that causes harm to *al-mal* is considered to be in conflict with Islamic public policy and morality. As such, any trade marks that are linked to goods or services relating to gambling companies will not be accepted. In other words, trade marks relating to these forbidden products will not be considered as property and will not have any protection under the Islamic legal system as they are conflict with the Islamic *maslahah* that preserves property. Note that the Criminal Code in Kuwait strictly bans gambling.⁹²² However, it is difficult to find a Muslim country that does not register a conventional bank's trademark.

In conclusion, in Islam, public benefit can be achieved by respecting the five objectives of Islamic Shariah and being mindful of Islamic public policy and morality principles in the legal framework.

6.5 Conclusion

This chapter has focused heavily on the key provisions of the theory of *al-masalah* in Islamic Shariah in order to determine public policy and morality principles that govern trade marks and to explore their effect on trade mark recognition and protection.

The chapter’s findings suggest that in the Islamic legal system the term ‘public policy’ is unknown in early Islamic jurisprudence. However, Muslim scholars used other terms that were similar but not identical to it. Public policy in Shariah is linked to God’s

⁹¹⁹ Yusuf al-Alim, *Al-Maqasid al-Ammah li al-Shariah* (2nd edn, International Islamic Publishing House 1994) 508.

⁹²⁰ *ibid* 515.

⁹²¹ See, Yusuf al-Alim, *Al-Maqasid al-Ammah li al-Shariah* (2nd edn, International Islamic Publishing House 1994) 498, 571.

⁹²² The Kuwaiti Criminal Law No 16 of 1960, art 205.

rights which aim to achieve public interest. The sources of Islamic public policy are the sources of the Islamic legislation (Quran, Sunnah, *Ijma* and *Qiyas*).

The morals within the Shariah are an essential part of the Islamic legal system. The public morals of Islam are derived from the general rules of Shariah and in particular the morals of the Prophet Muhammad (PBUH). Islamic public policy and morality are not defined or determined by society or legislation but are based on Islamic Shariah provisions which are mostly fixed and unchangeable. Generally, there is crossover between the two terms.

The *al-maslahah* theory provides a developed understanding of public policy and morality principles and how they can be applied when determining whether a mark is offensive from an Islamic Shariah perspective.

With respect to Kuwaiti public policy and morality, it is clear that Islamic rules play a pivotal role in Kuwaiti law in general and on the scope of public policy and morality in particular. Public policy and morality measures regarding trade mark registration in Kuwait are derived from Islamic teachings.

According to the public *maslahah*, a mark should be compatible with the five objectives of Shariah which seeks to protect and preserve religion, life, mind, lineage and property. Accordingly, in order to accept a sign as a trade mark under Shariah jurisprudence, it has to comply with these five objectives regardless of society's point of view on it. In other words, the point of view of society will be ignored if it clashes with Islamic objectives and rules and vice versa. In addition, the elements that have been discussed above are the general controls for judging the validity of a trade mark under Shariah rules but every trade mark should be assessed according to each Muslim society and how certain content used in a trade mark is interpreted. For example, as mentioned above, the word 'kiss' has a sexual meaning in Arabic slang but in non-Arab Muslim societies this mark would be accepted.

After identifying and discussing the public policy and morality principles that govern trade marks from the Western and Shariah perspective in Chapter Five and Chapter Six, the next chapter will take an analytical and comparative approach in addressing the similarities and differences in order to determine the nature of the relationship between these two systems.

Chapter Seven

The Influence of Public Policy and Morality Principles on Trade Marks Recognition and Protection: A Comparative Discussion of the Western and Islamic Legal Systems

7.0 Introduction

It is clear from the analysis provided in the previous chapters regarding public policy and morality as grounds for refusing trade mark registrations within Western and Islamic legal systems that despite their very different starting points both share nearly all the same categories of offensive marks.⁹²³

This chapter will highlight the most influential aspects that determine the extent of trade marks compliance with the rules of public policy and morality. It will also consider the implications of both the similarities and differences between Western and Islamic views of public policy and morality. Specifically, the chapter will address the impact of external variables on criteria for accepting trademarks, the concept of the offensive mark and its uses and interventions by the authorities.

7.1 The effect of changes in conditions on public policy and morality standards

The previous discussion in respect of Western public policy and morality (in Chapter Five) showed clearly that standards change according to time, place and circumstances. This is because public policy and morality principles stem from the perspective of the society or the public authority at a particular point in time, representing the public moral norms and fundamental interests of that society. However, the situation is radically different for Islamic public policy and morality as was shown in Chapter Six. This can be seen as the fundamental difference between the two systems. It also has an effect on the other aspects of difference that will be discussed throughout the chapter.

In respect of standards changing over time, the Board of Appeal has made it clear that:

[L]anguage and the concept of acceptable principles of morality are constantly changing. Whether language and morals adapt to society or society gradually adapts to language and morals can remain an open question. The fact is that words or actions

⁹²³ See, in general, Salahuddin Jamal al-Din, *Fikret Annitham al-Aam fi al-Elakat al-Khaseh Addawliyyeh Bayna al-Qawaneen al-Wadiyyeh wa-Sharihatul al-Islamiyyah* (Dar Al-Fiker Aljamiy 2004) 27.

that were contrary to acceptable principles of morality could be morally acceptable tomorrow.⁹²⁴

There is much evidence for this in previous case law. In the *Old Glory Condom* case, the TTAB stated that ‘what was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint)’.⁹²⁵ The most famous example of the change in moral standards over time was seen in the *Madonna* case. In 1938, use of the word ‘Madonna’ as a trade mark for wine was considered scandalous but by 1987 ‘MADONNA’ was registered as a trademark for a singer even though the singer herself used it in a sexual way.⁹²⁶

In the case relating to the ‘HALLELUJAH’ trademark,⁹²⁷ the Court set out guidelines for registration starting with the principle that a trademark assessment in relation to morality must be consistent with the time of the application to register it: ‘it is well established that the registrability of a trademark must be judged as at the date of its application ...’.⁹²⁸ The Court explained the reasoning behind that as: ‘When *religious and moral standards* are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where others have given a clear lead. While he must not remain isolated from the day-to-day world, frozen in outmoded moral principles, he must equally not presume to set the standard’.⁹²⁹

In another case the examiner gave a clear statement on his judgement of the mark: ‘I am exercising my own judgment on this issue based upon my belief of the generally accepted morals of today’.⁹³⁰ This illustrates that judgments on trade marks are supposed to be based on a contemporary understanding of the concepts of what is considered to be right and wrong and acceptable or unacceptable in society.

In the case of the trade mark ‘JESUS’, which was mentioned earlier, the IPO and the judge denied the recognition of the word Jesus as a trade mark while in many other EU countries the EUIPO and the BOIP have accepted the same word to be registered as a trade

⁹²⁴ *Thomas Türpitz Application* (‘FUCKING FREEZING!’) Board of Appeal (OHIM) Case R 168/2011-1, 6, para 24.

⁹²⁵ *In re Old Glory Condom Corp* 26 USPQ 2.d 1216, 1220 fn 3 (TTAB 1993).

⁹²⁶ *MADONNA* Registration No 1463601 for clothing; and registration No 1473554 for entertainment services, USA.

⁹²⁷ *Hallelujah Trade Mark* [1976] RPC 605.

⁹²⁸ *ibid.*

⁹²⁹ *ibid.*

⁹³⁰ *Gazillion’s Trade Mark Application* No 2232411/2002 ETMR 63.

mark.⁹³¹ This supports the idea that an offensive mark can differ from one territory to another, allowing a trade mark to be registered in one country which is seen as offensive in another.

It is important to highlight the fact that variances are not limited to morality but extend to include public policy. There are trade marks that are considered to be offensive nowadays that used to be acceptable in the past. For example, using the word nigger. 'NIGGER HEAD' or 'NIGGER-HAIR TOBACCO' trade marks used to be acceptable in terms of public policy in the US at the time of perceived white supremacy in the 19th century. However, today, after public policy has changed, these are considered offensive due to their racist connotations.⁹³²

As discussed in Chapter Six, Islamic public policy and morality are mainly based on the preservation of the five objectives which seek to protect and preserve religion, human life, human minds, lineage and property, and any trade mark that goes against these objectives is prohibited regardless of what members of society think about it. The criterion that defines whether a trade mark violates public policy and morality is full compliance with laws and teachings set by God. There are some fixed rules in Islamic Shariah, ie immutable principles that cannot be changed. This means that trade mark decisions based on Islamic public policy and morality are not necessarily based simply on society's view on the matter.⁹³³ The decision to accept or reject trade marks is not necessarily linked to the interests of the community but to the Shariah goals on the basis that God knows what is in the best interests of human beings more than humans themselves.⁹³⁴ This is a fundamental difference between the Islamic and Western systems in respect of the source of public policy and morality principles. As a result, the trade mark examiner in an Islamic system will focus first on the five necessary objectives of Islamic Shariah and not on society's view on the trade mark. This makes the rules of Islamic public policy and morality less vague than those of the Western system.

In other words, in contrast with the Western system, the public policy and morality principles and the standards in Islamic Shariah do not often change over time and place

⁹³¹ See Chapter Five, 5.3(b).

⁹³² See Kimberly Pace, 'The Washington Redskins Case and the Doctrine of Disparagement: How Political Correct Must a Trade Mark be?' (1994) 22 *Pepperdine Law Review* 7, 9; Regan Smith, 'Trade Mark Law and Free Speech' (2007) 42 *Harvard Civil Rights-Civil Liberties Law Review* 451, 480.

⁹³³ See, Salahuddin Jamal al-Din, *Fikret Annitham al-Aam fi al-Elakat al-Khaseh Addawliyyeh Bayna al-Qawaneen al-Wadiyyeh wa-Sharihatul al-Islamiyyah* (Dar Al-Fiker Aljamiy 2004) 27.

⁹³⁴ See Chapter Six, 6.4.

because the source of the rules derives from fixed divine legislation.⁹³⁵ The Quran and Sunnah are constant and have not changed for over 1400 years and will not change in the future. For example, as explained in Chapter Four,⁹³⁶ the word *Allah* or God should never be used as a trade mark and any application to register it will be rejected based on Islamic public policy and morality.⁹³⁷ The use of the word *Allah* (or any of the Quranic verses) is forbidden regardless of the time or place as it would be considered to be in conflict with *maslahah* which protects and preserves the religion ‘*hifz al-Din*’. As explained before, the unchangeable provisions in Islam are an essential part of Islamic Shariah as those rules represent the core of the Islamic religion which is fixed.⁹³⁸

It should be noted that any change in circumstances may affect a trade mark positively or negatively. In this case, Western and Islamic Shariah public policy and morality standards are in harmony as their provisions to allow judgements to be made depend on the circumstances at the time. The ‘BIN LADIN’ trade mark is a good example. In this case, the trade mark did comply with Western principles of public policy and morality. However, over recent years the current circumstances mean that the mark is in conflict with these principles. The ‘BIN LADIN’ trade mark is actually the name of a well-known Saudi Arabian company. However, this mark was rejected as it was considered contrary to public policy and morality. This decision was made by the Second Board of Appeal of EUIPO because the events of 11 September 2001 in the USA suggest a reference to the Islamic extremist group that carried out the attack;⁹³⁹ the ‘BIN LADIN’ trade mark before that date had not been seen as contrary to the public policy and morality of EU countries.

In the case of Islamic Shariah, there are no special provisions banning the use of colours as trade marks. At the present time, after the Association for Lesbian, Gay, Bisexual and Transgender Issues (LGBT) began to use a rainbow flag as a symbol of homosexuality,⁹⁴⁰ this combination of colours that make up the rainbow may not be

⁹³⁵ See Chapter Six, 6.1.

⁹³⁶ See Chapter Four, 4.3.2(b).

⁹³⁷ Abdullah ibn Ghudayyan and Abdul-Razzaq Atiyyah and Abdul-‘Aziz ibn Baz, General Presidency of Scholarly Research and Ifta, (1988) The Permanent Committee Fatwas, *fatwa* no 9344, part no 11, no 486; Abdul Razzaq Al-Bader, *Fiqh al-Asma al-Husna* (Dar Al Tawhid 2008) 74.

⁹³⁸ Fixed Shariah rules are the ones relating to the Quran and Sunnah. However, laws derived from other sources of Shariah such as *qiyas* can be a little flexible and can be changed according to conditions relating to time, place and interests that better serve the society. In this situation, judges have more discretionary power to identify the laws in accordance with these interests. See, in general, Chapter Three, 3.3; Fathi Drini, *Khsaa's al-Tasharia' al-Islamy fi Assiyasah wa al-Hokm* (3rd edn, Risala 2013) 201, 202.

⁹³⁹ *Bin Laden* Trade mark Application No 02223907/2004-2 Decision of the Second Board of Appeal (29 September 2004) in Case R 176/2004-2.

⁹⁴⁰ Association for Lesbian, Gay, Bisexual, and Transgender Issues (LGBT) <<http://www.algbtcal.org/>> accessed 21 September 2015.

acceptable as a trade mark. This is because this combination would now be considered contrary to Islamic public policy and morality as this is in conflict with *maslahah* which protects and preserves lineage, '*hifz al-nasal*'. In Islam, homosexuality is a great evil and may be punishable by death.⁹⁴¹ Therefore, only if the rainbow symbol loses its meaning as a homosexual symbol, then Shariah will accept this combination of colours as a trade mark.

In this context, two additional points that represent a significant difference between the two systems, the Islamic and the Western, are analysed below.

(a) the limits of public interest

What distinguishes Islamic public policy and morality principles from those of the Western regime is that they serve two parallel purposes; secular and divine/worldly and hereafter. In the Islamic system, the trade mark must be examined with worldly and hereafter interests in mind.⁹⁴² However, if worldly interests conflict with the hereafter, then the priority should be the interests of the hereafter.⁹⁴³ The Islamic faith does not consider death as the end so attention is given to the best interests in the afterlife.⁹⁴⁴ Even if there is a general consensus within the society that a trade mark will potentially achieve financial and economic benefits to the society and would not harm their morals, this is not sufficient if this trade mark is in conflict with one or more of the Islamic pillars of faith. Imam Quraafi states that God has arranged worldly and hereafter interests to obey Him and avoid sin.⁹⁴⁵

(b) scope of public policy and morality principles

Shariah regulates all aspects of human life, hence the application of Islamic public policy and morality principles have become wider and more comprehensive.⁹⁴⁶ These principles cover many areas which those in Western systems would consider to be personal matters which are not subject to public policy or public morality principles. These are issues that relate to personal freedom or choice which a public authority does not have the right to

⁹⁴¹ The Prophet (PBUH) said: 'Whoever you find doing the action of the people of Lut, kill the one who does it, and the one to whom it is done'. Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiruddin al-Kattab (tr), Darussalam 2007) Hadith No 2561, 469. In Islam, there is a consensus that homosexuality is a criminal offence according to Islamic Shariah. However, Muslims scholars have different views on the punishment for committing same-sex intercourse whether they are lesbians or gays. See Shafi Bello, 'The Punishment of Homosexuality in Islamic Contemporary World, Malaysia, Iran, Pakistan and Saudi Arabia as a Case Study' (2012) 1 Journal of Homosexuality 1, 15.

⁹⁴² Ibrahim Shatibi, *Muwafaqat fi Uṣul al-Shariah*, vol 4 (Maktaba al-Kobra 1975) 37.

⁹⁴³ *ibid* 39.

⁹⁴⁴ Muhammad Bouti, *Zawabit al-Maslahah fi Shariah al-Islamiyyah* (Reasalah 1979) 46.

⁹⁴⁵ Shihab al-Din al-Qarafi, *Al-Furuq*, vol 2 (al-Resalah 2003) 6.

⁹⁴⁶ Adnan Imamate, *Tajdid Alfikr al-Islami* (Dar ibn al jawzi 2003) 23.

govern. For example, according to Islamic public policy and morality, it is strictly forbidden for Muslims and non-Muslims to eat or drink publicly during the daytime in the month of Ramadan. Therefore, the breadth of topics that Islamic public policy and morality covers which will directly affect the registration of trade marks is far wider than what is regulated in the Western legal system.

For example, if there is an application for a trade mark that is associated with products that encourage men to wear clothes or accessories that are similar to women or vice versa, although that will be acceptable under Western public policy or morality as it relates to personal choice,⁹⁴⁷ this would be considered as contrary to Islamic public policy and morality.⁹⁴⁸ Another example is a trade mark that sells a service that allows a man and woman to live together and have children without marriage or one that facilitates the marriage of a Muslim woman to a non-Muslim such as through a civil marriage.⁹⁴⁹ This trade mark would be contrary to Islamic public policy and morality as it promotes prohibited activities from an Islamic point of view.⁹⁵⁰ In contrast, in a Western legal system these acts may be deemed as a private right, ie the right to choose who to live with, who to marry or whether to live with a partner outside of marriage or to have children outside of marriage. From this, it can be concluded that Islamic public policy and morality principles and their application in relation to trade marks is broader as they regulate areas that would be considered outside the scope of public policy or morality principles in a Western regime.

In conclusion, Islamic public policy and morality standards are stable, especially if the subject relates to Islamic core values. However, if they are new issues facing Muslim society, then Islamic Shariah accepts changes in ruling according to changes in circumstances of each case. In the Western system, public policy and morality principles are based on public interest and the community's vision of morality at a particular point in time which can change from one generation to another.⁹⁵¹

⁹⁴⁷ See in general, European Court of human Rights, <echr.coe.int/Pages/home.aspx?p=home&c=> accessed in 10 March 2015.

⁹⁴⁸ The prophet (PBUH) said 'Cursed are men who imitate women and women who imitate men' Muhammad al-Qazwini, *Sunan Ibn Majah*, vol 3 (Nasiudin al-Kattab (tr), Darussalam 2007) *Hadith* no 1904 p 93.

⁹⁴⁹ Jean-François Renucci, *Introduction to the European Convention on Human Rights: The rights guaranteed and the protection mechanism* (Council of Europe Publishing, 2005) 43.

⁹⁵⁰ Zahidul Islam: 'Interfaith Marriage in Islam and Present Situation Global' (2014) 2 *Journal of Politics and Law Research* 36, 47.

⁹⁵¹ As previously explained, the fundamental sources of Islamic Shariah, the Quran and Sunnah, are fixed and cannot be modified or cancelled in any way. See Chapter Three, 3.2. Also see Salahuddin Jamal al-Din, *Fikret Annitham al-Aam fi al-Elakat al-Khaseh Addawliyyeh Bayna al-Qawaneen al-Wadiyyeh wa-Sharihatul al-Islamiyyah* (Dar Al-Fiker Aljamiy 2004) 29.

7.2 The subject matter of trade marks that are contrary to public policy or morality

As it can be seen from earlier chapters, the subject matter that is usually in conflict with public policy and/or morality is generally similar in both Western and Islamic legal systems. For example, in both systems, marks that contain sexual content, religious terms and symbols or relate to illegality are considered to be contrary to public policy and/or morality.⁹⁵² However, although there are similarities between the two systems, there are still a number of differences between them. The ones of most importance can be divided into two main categories.

(1) Differences in the significance of certain concepts

A useful example of this are those relating to sexual or vulgar marks. Trade marks that include nudity are rejected in both systems. However, trade marks of women wearing swimming costumes may be acceptable in Western systems but would be strongly rejected under Islamic public policy and morality principles.⁹⁵³ As such, in essence, although there may be agreement between the two legal systems in relation to the overall concept, there may be a variation in opinion on what is considered to be appropriate, and therefore it may be rejected in one but not in the other.

Another example relates to religion and holy symbols. The Western legal system deals with different religious names and symbols equally without discrimination and applies this uniformly to all religions without exception in relation to trade mark registration. The standard approach is that using any religious name or symbol as a trade mark will be rejected if the product associated with the mark is forbidden in a relevant religion or if this use of the religious name or symbol will be considered by followers as inappropriate.

The *Madonna* and *Senussi* cases are good illustrations of the variance between the two systems in dealing with religious terms and symbols.⁹⁵⁴ These cases illustrate that in Western legal systems all faiths in society are protected. Use of the term 'religion' does not just refer to a particular religion such as Christianity or Islam but includes all religions and faiths.

⁹⁵² Chapter Five, 5.3(a) and Chapter Six 6.4(d).

⁹⁵³ See the Islamic conditions for the female appearance, Samantha Fede, '(Re) Envisioning the Veil' (2013) 16 Journal of the Centre for the Study of Implicit Religion and Contemporary Spirituality 443.

⁹⁵⁴ *Riverbank Canning Co* 95 F.2d 327, 329 (CCPA 1938). In the *Senussi* case, the applicant tried to register 'SENUSSI' as a mark for cigarettes. Senussi is the name of a Muslim sect and they forbid the use of cigarettes. *In re Reemtsma Cigarettenfabriken G.m.b.H.* 122 USPQ (BNA) 339 (TTAB) 1959).

Conversely, religion and the holy symbols protected under Islamic public policy and morality relate only to the Islamic faith as *maslahah*, which protects or preserves religion ‘*hifz al-Din*’, and this refers specifically to Islam and not any other religion.⁹⁵⁵ In Surah al-Imran, verse 85, God says: ‘And whoever desires other than Islam as religion – never will it be accepted from him, and he, in the Hereafter, will be among the losers’. In Surah Al-Imran 2, verse 19, God says: ‘The religion before Allah is Islam’. This view is clear in Muslim literature and the means mentioned by Muslim scholars to preserve the interests of the religion are only linked to Islamic religion. However, in general, that does not mean that Islamic Shariah accepts the abuse of other religious sacred symbols, especially of the heavenly religions (Judaism and Christianity).⁹⁵⁶ Nevertheless, it is clear that scholars do not consider Islam and other religions as equal in contrast to Western legal systems. To be more specific, to refuse the registration of a trade mark that consists of a religious holy symbol, the followers of that religion have to prove that this use disparages their beliefs. This is not applicable to Muslims because Islamic religious symbols are protected by the rules of public policy and morality regardless of the harm their use causes to Muslims.

In Kuwait, for example, the law entitled ‘Banning the Import of Goods with Verses of the Quran Printed on Them’ has focused heavily on the Islamic religion but did not ignore the other monotheistic religions. This law has put general rules that are applicable on trade marks. Article 1 of the law forbids the importation, marketing, promotion, display or sale of any products which have the following printed or written on them (this obviously includes trade marks).⁹⁵⁷

The name of God ‘*Allah*’, as discussed previously, God in Islam has ninety-nine names and among them, the name ‘*Allah*’ has the most sanctity as this name is exclusively used to mean ‘God’, the one and only.⁹⁵⁸ The law only forbids the use of ‘*Allah*’ and not the other ninety-eight names for God.

Verses of the Quran, the Quran is made up of 6236 verses and is the primary and most important source of guidance for Muslims on Islam.⁹⁵⁹

⁹⁵⁵ Bashir Kubaisi, *Al-Maqasidu Ashariyeh wa Kayfiatu Atta'amul Ma'aha Enda at-Ta'arud* (2012) 2 Journal of College of the Great Imam 37, 46. See also, Nasser al-Aqal and Nasser Alqefari, *Al-Moujaz fi al-Adyan wa al-Mazahib al-Muasirah* (Dar al-Asomaie 1992) 10.

⁹⁵⁶ See, in general, Saleh al- Ayed, *Hoqouq Ghayri al-Muslimeen fi Bilad al-Islam* (4th edn, Agency of Publications and Scientific Research 2008). In Kuwait, for example, the Kuwaiti Criminal Code criminalises an act which insults any religion or faith. The Kuwaiti Criminal Law, arts 109 and 110.

⁹⁵⁷ Law Banning the Import of Goods with Verses of the Quran printed on Them. Ministerial Decree No 16 2012.

⁹⁵⁸ See Surah Al-Araf, verse 9, 180.

⁹⁵⁹ See Abdulrahman Soapy, *Mukadimatun le-Derasat al-Eqdi fi Shariah al-Islamyyah* (Aleppo University 1998) 52.

Sayings of the Prophet (PBUH) or '*hadith*' or the religious remembrance '*zikr*'; Hadiths of the Prophet Muhammad (PBUH) is the main part of the Sunnah which all Muslims must follow. Sunnah is the second fundamental source of Shariah after the Quran.⁹⁶⁰

Drawings of holy places and pictures of the Prophets; a clear example of a holy place is the *Ka'bah* or the (Sacred House) and pictures of all Prophets such as Abraham, Jacob and Jesus (Peace be upon them) are forbidden from depiction in this way.⁹⁶¹

If the use of any of the elements listed above would lead to disparaging, ridiculing or offending of any of the Abrahamic or Islam religions, then it would be contrary to public morals or public policy.

Therefore, trade marks are subject to this law and should be not be in conflict with it, whether it is a registered or unregistered trade mark.⁹⁶² This means that any products bearing such trade marks will not be allowed to enter Kuwait. It is worth mentioning that this Law relates only to the three monotheistic religions. From the article's context, it is clear that the matters in the article were stated only as an example of what goods could be banned for religious or moral reasons, and do not include all possibilities.

In addition, Article 2 of the law has banned printing the verses of the Quran into shapes of animals or any other animate beings or any form that is in the shape of holy places, religious symbols or statues which would be contrary to public policy or morality. This article can be applied to three-dimensional trade marks. It is also noteworthy that Article 2 has banned the use of the shape of all religious symbols in the design of any goods. This is not limited to the monotheistic religions unlike Article 1. According to the legal context of Article 2, I think its aim is to ban any goods that are contrary to Islamic Shariah principles, for example, making statues for other religions' Gods is forbidden as it violates the Islamic rules. There is also a more general requirement contained in the article that states that the shape of any product should not be in conflict with Kuwaiti public policy.

In conclusion, this Law is entirely in line with Islamic public policy and morality relating to trade marks, and it is clear that the law has been designed to ensure that the use

⁹⁶⁰ Irshad Abdal-Haqq, 'Islamic Law: An overview of its Origin and Elements' (1996) 2 Journal of Islamic Law 1, 6.

⁹⁶¹ Law Banning the Import of Goods with verses of Quran printed on Them, art 1. It is also forbidden to use the Quran or Hadith to package products. See art 3 of the Law.

⁹⁶² It is important to highlight that the GCC Trade Marks Law does not require use of the mark in order to acquire registration so with regard to trade mark use, there is no difference between the registered and unregistered trade mark. However, the TRIPS principles relate to registration and protection of the trade mark but not to the use of the trade mark.

of a trade mark, whether registered or unregistered, is harmonized with the Islamic Shariah objective of protecting the religion.

(2) Trade marks and the effect of the related goods or services

Several court decisions in the EU, US and the UK have shown that the type of goods or services that bear the mark can affect whether the trade mark is accepted or rejected for registration.

EUIPO refused to register the mark ‘SCREW YOU’ in association with some products such as clothing and headgear. However, the Office did accept registration of the same mark in connection with condoms, contraceptives and sex toys (vibrators, dolls), which shows that using this mark in a sexual context has prevented it from being rejected for registration under Article 7(1)(f) CTMR.⁹⁶³ The logic behind such an approach is that the purchasers of these products are not likely to be shocked by that trade mark.⁹⁶⁴

In a different category, the US Court in the case of ‘MADONNA’ made it quite clear that the reason behind rejecting registration of the mark was because it would be considered ‘shocking’ if used for wine.⁹⁶⁵ However, it does not mean that the mark ‘MADONNA’ could not be used for other types of goods and services. In fact, the applicant in this case had already used and registered the term as a trade mark for goods of various kinds. The Court acknowledged that Madonna is a very holy name but suggested that using it commercially would depend on the goods or services that would bear the mark.⁹⁶⁶ Judge Lenroot stated: ‘Of course, the word “Madonna” is not per se scandalous. ... it is therefore obvious that, in determining whether a mark consists of or comprises scandalous matter, consideration

⁹⁶³ Requests by Basic Trademark SA for Protection in the UK of International Trade Mark Application Serial Nos 689374 & 776058 UKIPO Decision BL O/021/05 (18 January 2005) applications denied paras 15-20.

⁹⁶⁴ Enrico Bonadio, ‘Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trade Marks’ (2015) 191 *Marquette Intellectual Property Law Review* 39, 46.

⁹⁶⁵ The Court has emphasized that, ‘The only question involved herein is whether the word “Madonna”, as a trade-mark for wines, comes within the scope of the aforesaid section prohibiting the registration of any mark that “consists of or comprises immoral or scandalous matter”.’ The Court affirmed the decision of the Commissioner of Patents which states that ‘[the mark MADONNA] use upon wine for beverage purposes would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it ...’ *Riverbank Canning Co* 95 F.2d 327, 329 (CCPA 1938) 2.

⁹⁶⁶ The Court stated that: ‘The Virgin Mary stands as the highest example of the purity of womanhood, and the entire Christian world pays homage to her as such. Her representation in great paintings and sculpture arouses the religious sentiments of all Christians.’ *Riverbank Canning Co* 95 F.2d 327, 329 (CCPA 1938) 4.

ordinarily must be given to the goods upon which the mark is used'.⁹⁶⁷ Also, as mentioned in the case of the 'JESUS' trade mark, the Court stated that 'the nature of the product being marketed can influence whether the marketing communication will cause serious or widespread offence'.⁹⁶⁸

Some trade marks may have more than one meaning. In that case, the registrar needs to consider the nature of the product to decide whether the mark is likely to be perceived as something that would cause offence.⁹⁶⁹ The Intellectual Property Office of Singapore explains this by using the word 'hooker'. In their view, it may be acceptable to use this as a trade mark in connection with boat anchors whilst the same mark may be refused in relation to adult magazines.⁹⁷⁰ However, I disagree with the example given in respect of the word being used for adult magazines because the consumers of this product have different moral standards in respect of sex in comparison to, for example, children or other people who would not purchase this type of product.⁹⁷¹ In other words, the context where the mark is used might save a mark registration application from rejection.

It is worth considering whether the Islamic system should take the same approach. Marks consisting of words or symbols that have great religious significance in Islam would certainly be denied registration on the basis of public policy and morality under Islamic Shariah regardless of the goods or services bearing the mark, even if the product has a religious character. To use the names of God such as *Allah*, *Ar-Rahim* (Merciful), the *Al-*

⁹⁶⁷ Interestingly, the Judge Lenroot was quite clear that using the name 'Supreme Being' as a trade mark is unacceptable regardless of the goods or services that the mark would be used for. The Judge stated: 'Everyone would concede that an application to register the name of the Supreme Being as a trade-mark would be properly rejected' *Riverbank Canning Co* 95 F.2d 327, 329 (CCPA 1938) 3. Baird has sharply criticized this opinion from several angles. For example, he suggests that Judge Lenroot built his ruling upon an inaccurate hypothesis by saying that there is only one name for the Supreme Being. He said, 'surely there are as many names as there are faiths. Indeed, GOD, ALLAH, JAHWEH, LORD, ISHWARA, RAMA, VISHNU, KRISHNA, and a multitude of other names'. Stephen Baird, 'Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks' (1993) 83 Trademark Reporter 661, 706.

⁹⁶⁸ The Court states that: 'I agree with the proposition advanced on behalf of the Applicant to the effect that religious significance is not always or necessarily sufficient to render a mark un-registrable under Section 3(3)(a).'

⁹⁶⁹ Intellectual Property Office of Singapore, 'Marks Contrary to Public Policy or Morality' (2009) 9. See, in general, Christine Farley, 'Stabilizing Morality in Trade Mark Law' (2014) 63 American University Law Review 1019, 1021.

⁹⁷⁰ Intellectual Property Office of Singapore, 'Marks Contrary to Public Policy or Morality' (2009) 9.

⁹⁷¹ I also support my point of view by the Court decision in the case involving the mark; 'SCREW YOU'. The Court in this case stated that: 'A person who is sufficiently interested in such items to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations.' *SCREW YOU - Kenneth v. J.A. Kemp & Co.* [2006] OHIM R 495/2005-G, 8, para 29.

Khaliq (Creator) and all the verses of the Quran as a trade mark would be considered offensive and therefore un-registrable.⁹⁷²

On the other hand, there are some marks that consist of Islamic words or symbols that may be acceptable to use in a commercial context if the goods or services that they are used on are *halal* according to Shariah rules. The word 'Islamic' can be used as a trade mark in connection with permissible '*halal*' goods and services on the condition that it is not used in an offensive context. For example, 'Islamic' can be a trade mark for charities, educational institutions or Islamic financial activities but would not be appropriate on goods such as shoes or condoms as it would be offensive and put it in conflict with Islamic public policy and morality.⁹⁷³

This rule also applies to words or symbols of other religions. Therefore, trade marks using the Christian cross, images of Gautama Buddha or images of Hindu gods are likely to be denied registration regardless of the goods or services they are connected to.⁹⁷⁴ However, it should not be understood that under Islamic public policy and morality other religions' symbols would be protected because they themselves might be considered offensive marks if they are in conflict with Islamic faith and dogma.⁹⁷⁵

In other words, according to the modern application of classical Shariah principles, using the name of other religious groups or symbols to identify goods or services is considered offensive regardless of the context or the uses of the mark as this is seen as contradictory with *maslahah* which protects or preserves '*hifz al-Din*'.⁹⁷⁶ Moreover, as explained in Chapter Four, the use of non-Muslim religious symbols as trade marks could be permissible or acceptable depending on the nature of the trade mark itself as well as the goods or services attached to it.⁹⁷⁷ For example, a trade mark that portrays Buddha can be acceptable if attached to footballs or hygiene products but may not be permissible if attached to clothes. The reason for this is that in the first example the use of this trade mark is not too

⁹⁷² See, in general, Abdul Razzaq Al-Bader, *Fiqh al-Asma al-Husna* (Dar al-Tawhid 2008) 54. Muhammad ibn Saleh al-Uthaymeen, *Fatawa Arkan al-Islam* (Dar al-Thuraya 2001) 66.

⁹⁷³ For example, *ISLAMIC RELIEF* No 004214334 (OHIM); *ALSAFA ISLAMIC BANKING* No 004276911 (OHIM).

⁹⁷⁴ See Chapter, 4.3.3.

⁹⁷⁵ Abdul-Aziz ibn Baz and others, *Trade Marks Having A Human Photo*, Fatwas of the Permanent Committee, Group, vol 1, *fatwa* no, 16786 <alifta.net/Default.aspx?language=en> accessed 9 October 2013.

⁹⁷⁶ See, in general, Muhammad ibn Uthaymeen, *Sharhu Usoul al-Eman* (Dar al-Watan 1989).

⁹⁷⁷ See, Chapter 4, 4.3.3. See also, Yusuf al-Qaradawi, *Halal and Haram Fi al-Islam* (13th edn, Islamic Library 1980) 111.

personal nor does it reflect personal belief while in the second example it could indicate otherwise.⁹⁷⁸

In addition, under Islamic Shariah, the different kinds of consumers are not taken into consideration when deciding whether to register a trade mark or not, unlike the case in the Western system. The EUIPO's approach to registering the 'SCREW YOU' mark was that consumers purchasing products of a sexual nature would not be shocked by that trade mark.⁹⁷⁹ The Office stated:

In relation to artificial breasts and breast pumps of a type that is normally sold exclusively in sex shops, the Board considers that the relevant consuming public is unlikely to be perturbed by the use of the term 'SCREW YOU' as a trade mark. ... Condoms are of course now sold in supermarkets and advertised on television, though not at a time when children are likely to be watching.⁹⁸⁰

Furthermore, according to the Western legal system, some members of society are in need of more protection than others, ie children and young people, in that 'there is a public interest in ensuring that children and young people, in particular, are not confronted with offensive words in shops that are accessible to the general public'.⁹⁸¹ From this, it can be seen that it is important to consider the target customer when evaluating the mark for a product and what other conditions there are governing the sale or marketing of the product in question as well as other elements.⁹⁸²

However, this classification does not exist in Islamic Shariah. For example, it is in conflict with Islamic decency to use pictures of a naked or indecently dressed woman/man,⁹⁸³ or to use a sexual word as a trade mark regardless of the goods or services they are attached to, for instance, condoms or other sex products. In short, if the mark itself

⁹⁷⁸ 'Ad! bin Hātim said: 'I came to the Prophet (PBUH) while I had a cross of gold around my neck. He said: 'O 'Adi! Remove this idol from yourself!'. Hafiz At-Tirmidhi, *Jami Al-Tirmidhi*, vol 5 (Abu Kalliy (tr), Darussalam 2007) Hadith No 3095, 402. See also, *Al-Mawsu'ah al-Fiqhiyyah* (2nd edn, 1988) vol 12, 88.

⁹⁷⁹ The Board states that: 'A person who enters a sex shop or visits a website devoted to sex products is, by definition, unlikely to be offended by a trade mark which contains crude, sexually charged language'. *SCREW YOU - Kenneth v J.A. Kemp & Co.* [2006] OHIM R 495/2005-G, 8, para 29.

⁹⁸⁰ *SCREW YOU - Kenneth v J.A. Kemp & Co.* [2006] OHIM R 495/2005-G, 8, para 29.

⁹⁸¹ *Thomas Türpitz Application ('FUCKING FREEZING!')* Board of Appeal (OHIM) of Case R 168/2011-1, 6, para 25.

⁹⁸² The evaluation of trade marks which are openly shown in public market places shown 'It is normally necessary to consider the goods and services for which registration of the mark is sought, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive'. OHIM, 'Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade mark and Designs) on Community Trade Mark, Part B' (2014) (4).

⁹⁸³ Islamic Shariah prevents women from showing their 'adornments' except to, for example, their 'mahram'. The Arabic term 'mahram' means the next of kin that the woman cannot marry, such as her brothers. See Aisha Boulanour, 'The Notion of Modesty in Muslim Women's Clothing: An Islamic Point of View' (2006) 8 New Zealand Journal of Asian Studies 134, 135.

is considered to be in conflict with Islamic public policy and morality then it will not be considered as a trade mark and the nature of the goods or services upon which the mark is used is irrelevant and does not affect the decision to reject the mark from registration. In addition, this rule is restricted to a type of consumer, hence the conflicted mark is prohibited for all people, the young and old, males and females.

7.3 The public authority's role in the Western and Islamic legal systems

In the Western legal system, there is a debate about the role the competent authority plays in assessing whether or not a mark is contrary to public policy and morality. Some argue that this judgement is better left to the market, ie if the mark is really offensive, general consumers will refuse to buy the relevant goods or services that relate to the mark and that will lead to the mark being withdrawn from the market without intervention from public authorities.⁹⁸⁴ This point of view has been criticized as in some cases buyers will perceive the offensive mark as attractive;⁹⁸⁵ this has been clarified by the 'DICK HEADS' trade mark. The Appeal Board states that, 'some people may well buy applicant's promotional items because of the scandalous nature of the mark, for "shock" value, but this does not mean that the mark, in the context in which it is used, is not offensive to a substantial composite of the general public'.⁹⁸⁶ In addition, it can be understood that the sales figures of the goods or services associated with a trade mark are not enough to prove that a mark is not offensive. Therefore, the competent authorities should intervene (namely, trade mark examiners and judges) as it is essential to protect society's sensibilities.⁹⁸⁷

This debate has no place in the Islamic system as the first duty of any Muslim public authority is to protect the five necessary values, namely, religion, life, mind, lineage and property.⁹⁸⁸ The assessment of the trade mark will be based on these five elements regardless of the position of consumers or even the general public.

With respect to the powers of the competent authorities in determining whether or not the mark is shocking to society, the judgments made by the courts have made it clear that

⁹⁸⁴ See Anne Gilson LaLonde and Jerome Gilson, 'Trade Marks Laid Bare: Marks that May be Scandalous or Immoral' (2011) 101 Trademark Report 1476, 1485.

⁹⁸⁵ See, in general, Enrico Bonadio, 'Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trade Marks' (2015) 191 Marquette Intellectual Property Law Review 39, 49.

⁹⁸⁶ *In re Wilcher Corp* 40 USPQ 2.d 1929, 1934 (TTAB 1996).

⁹⁸⁷ Anne Gilson LaLonde and Jerome Gilson, 'Trade Marks Laid Bare: Marks that May be Scandalous or Immoral' (2011) 101 Trademark Report 1476, 1485.

⁹⁸⁸ See Abdullah Al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 84.

the registrar should not be considered as the censor or the judge of morality in society.⁹⁸⁹ The duty of the registrar is to determine whether the mark is contrary to morality in accordance with society's current understanding of morality, ie his decision should mirror the opinion of society without regard to his personal opinion on the subject.⁹⁹⁰ The judiciary does not have the right to determine the public morality principles but their decisions should reflect the point of view of society.

In the same way, the Islamic judiciary has no role in determining principles of public policy or morality in the Muslim society as these principles are, in general, derived directly from the Islamic Shariah rules.⁹⁹¹ In other words, judges in Muslim societies do not have discretionary power in order to determine principles of public policy and morality.⁹⁹² Accordingly, any trade mark which is contrary to any of the five necessary Shariah *maqasid* (objectives) cannot be in agreement with public policy and morality even if there is an agreement within the society about it.⁹⁹³

However, the question that arises is whether the prohibition of registering the offensive mark is an appropriate way for a public authority to protect the fundamental interests and values of society. This question is not easy to answer especially if it is acknowledged that even if the registration of the mark is rejected, the applicant can still use the mark in the course of business as registration is not a requirement for use. This has been confirmed in a number of decisions in both the EU and US.

For example, the US Court in the *Redskins* trade mark case stated that: 'To be clear, the Court's judgment is not an order that precludes PEI from using the marks in commerce'. The Court went further by stating that: 'Nor does the Court's ruling that the Redskins Marks consisted of matter that "may disparage" a substantial composite of Native Americans during the relevant time period preclude sports fans collecting, wearing, or displaying the Redskins marks'.⁹⁹⁴ Another example is given by the Court in the *Gazillions* trade mark case which stated that the 'primary objective of the system of registration of trade marks is to protect

⁹⁸⁹ For example, the Court stated that: 'He must not lag so far behind the climate of the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive.' *Gazillion's* Trade Mark Application No 2232411/2002 ETMR 63.

⁹⁹⁰ *Gazillion's* Trade Mark Application No 2232411/2002 ETMR 63.

⁹⁹¹ Abdullah Al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia for Publishing and Distribution 2008) 84.

⁹⁹² See Salahuddin Jamal al-Din, *Fikret Annitham al-Aam fi al-Elakat al-Khaseh Addawliyyeh Bayna al-Qawaneen al-Wadiyyeh wa-Sharihatul al-Islamiyyah* (Dar Al-Fiker Aljamiy 2004) 30.

⁹⁹³ See, in general, Chapter Six, 6.4.

⁹⁹⁴ *Pro-Football, Inc v Amanda Blackhorse, et al* Case No. 1:14-cv-01043-GBL.IDD (8 July 2015) 69.

both traders and the public ... the system does not prevent a trader using a mark but merely denies him the protection of registration ...'.⁹⁹⁵ Therefore, in the Western legal system, the owner of a mark that has been rejected will lose the benefit of the official regulation of the mark but he can continue to use it in the open market which can be seen as a paradox.

This begs the question, if an applicant for an offensive mark can still use it, why is it important to reject registration of the mark for the reason of protecting public policy and morality. In this debate, Baird raises a significant point in respect of the economic incentive to continue with the use of an unregistered mark.⁹⁹⁶ In his view, the lack of legal protection can put the mark in a weak position and decrease its economic value. The owner of the mark may then lose motivation to continue using it.⁹⁹⁷ Loving holds the view that refusing a trade mark registration would reduce the value of the mark so dramatically that a trader would most probably abandon it voluntarily.⁹⁹⁸

In other words, the policy of banning registration of marks that are contrary to public policy and morality are considered as a way for the authority to discourage the use of offensive marks. This was mentioned in the *FCUK* trade mark case where the Court stated that 'the policy of the law would be to adopt measures (against the offensive trade mark) which reduces the likelihood of it being disseminated'.⁹⁹⁹

From my point of view, the Western legal system approach can be deeply problematic in terms of protecting society from offensive marks and can result in an adverse outcome. If the mark is then rejected or cancelled, it may encourage other traders to use the offensive mark while it is still unregistered. In addition, customs and border authorities will not block the import of foreign products that use the offensive mark so the impact of rejecting or cancelling this mark could cause negative consequences as it may increase its users.¹⁰⁰⁰

There is a serious question mark over whether the owner of an offensive mark has any legal protection under any other law. If the mark is considered to be offensive then

⁹⁹⁵ *Gazillion's* Trade Mark Application No 2232411/2002 ETMR 63.

⁹⁹⁶ Stephen Baird, 'Moral Intervention in the Trade Mark Arena: Banning the Registration of Scandalous and Immoral Trade Marks' (1993) 83 *Trademark Reporter* 661, 675, 676.

⁹⁹⁷ *ibid* 675, 676.

⁹⁹⁸ Paul Loving, 'Native American Team Names in Athletics: It's Time to Trade These Marks' (1992) 13 *Loyola of Los Angeles Entertainment Law Review* 1, 2.

⁹⁹⁹ *French Connection Ltd.* UKIPO No 2184549 (BLO/137/06, Dennis Woodman, Application for Invalidity) (17 May 2006) para 29.

¹⁰⁰⁰ Christine Farley, 'Registering Offense: The Prohibition of Slurs as Trademarks' in Irene Calboli and Srividhya Ragavan (eds), *Diversity in Intellectual Property: Identities, Interests, and Intersections* (Cambridge University Press 2015) 126, fn 107.

logically it will not be afforded protection under any other law.¹⁰⁰¹ Otherwise, there would be no acceptable justification for banning the trade marks that are contrary to public policy and morality from registration as this would be an easy way to circumvent the law.¹⁰⁰² However, according to Farley, this point has not been ruled on yet so it is difficult to give a definite legal opinion.¹⁰⁰³ Baird holds the view that if the mark ‘is unfit for registration, it may also be unfit for common law protection’.¹⁰⁰⁴ The USPTO in the case of the *Redskins* trade mark was more clear by stating that although the registration of the mark had been cancelled, the owner of the offensive trade mark ‘may still have rights in the mark based on use, known as “common law” rights – and those use-based rights may continue to exist even if a federal registration is cancelled’.¹⁰⁰⁵

In short, in a Western legal system, if the trade mark is considered offensive and has been rejected or cancelled, it will lose the legal registration and the benefits offered by the authorities.¹⁰⁰⁶ However, the owner of the trade mark can still use the mark. It is noteworthy that in Western legal systems, when refusing trade mark registration on the grounds of public policy and morality principles, courts often justify their rulings on the basis of a trader’s right to free speech.¹⁰⁰⁷ Banning or cancelling offensive trade mark registration is not in conflict with the right of commercial expression and free speech as the ruling does not ban the trade mark owner from using it in the market.¹⁰⁰⁸ For example, in the *McGinley* case, the

¹⁰⁰¹ Paul Loving, ‘Native American Team Names in Athletics: It’s Time to Trade These Marks’ (1992) 13 *Loyola of Los Angeles Entertainment Law Review* 1, 2; Christine Farley, ‘Registering Offense: The Prohibition of Slurs as Trademarks’ in Irene Calboli and Srividhya Ragavan (eds), *Diversity in Intellectual Property: Identities, Interests, and Intersections* (Cambridge University Press 2015) 125.

¹⁰⁰² Stephen Baird, ‘Moral Intervention in the Trade Mark Arena: Banning the Registration of Scandalous and Immoral Trade Marks’ (1993) 83 *Trademark Reporter* 661, 791.

¹⁰⁰³ Christine Farley, ‘Registering Offense: The Prohibition of Slurs as Trademarks’ in Irene Calboli and Srividhya Ragavan (eds), *Diversity in Intellectual Property: Identities, Interests, and Intersections* (Cambridge University Press 2015) 126.

¹⁰⁰⁴ Stephen Baird, ‘Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trade Marks’ (1993) 83 *Trademark Reporter* 661, 673 note 39.

¹⁰⁰⁵ See the USPTO Media Fact Sheet of Trade Mark Trial and Appeal Board (TTAB) Decision in *Blackhorse v Pro Football, Inc* (TTAB Cancellation No 92046185).

¹⁰⁰⁶ The benefits of federal registration are:

(a) The legal presumptions of ownership; (b) Use of the federal registration ® symbol; (c) To record the registrations with the US Customs and Border block the importation of infringing or counterfeit foreign product. See the USPTO Media Fact Sheet of Trademark Trial and Appeal Board (TTAB) Decision in *Blackhorse v Pro Football, Inc*. (TTAB Cancellation No 92046185).

¹⁰⁰⁷ Such as art 10(1) of the European Convention on Human Rights (ECHR), which reads:

‘Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.’

¹⁰⁰⁸ See, for example, *Tech Ltd v OHIM* [2011] Gen Ct T-232/10, paras 69-71; See, in general, Ilanah Fhima, ‘Trade Marks and Free Speech’ (2013) 44 *International Review of Intellectual Property and Competition Law* 293. In the case of the *Redskins* trade marks, the Court states that ‘Courts do not create trade marks, only businesses like PFI control their own destiny with respect to how the public discerns the source and origin of PFI’s goods and services.’ *Pro-Football, Inc v Amanda Blackhorse, et al*. Case No. 1:14-cv-01043-GBL.IDD (8 July 2015).

Court highlighted that ‘with respect to the Appellant’s First Amendment rights, it is clear that the PTO’s refusal to register the Appellant’s mark does not affect his right to use it ... No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, the Appellant’s First Amendment rights would not be abridged by the refusal to register his mark.’¹⁰⁰⁹

However, with regard to modern application of Shariah there is no doubt that the reason for refusal to register a mark is to prevent its use. An offensive trade mark within Islamic Shariah is seen as *mafsadah* (evil).¹⁰¹⁰ The duty of the Islamic authority is to protect Muslim society from any kind of *mafaseds* and this prohibition is administered by the powers held by the authorities.¹⁰¹¹ Commitment to the provisions of Islamic Shariah is not optional, especially if they relate to the higher interests of Muslim society. In Surah al-Ahzab, verse 36, God says, ‘It is not for a believing man or a believing woman, when Allah and His Messenger have decided a matter, that they should [thereafter] have any choice about their affair.’ According to Imam Ibn Kathir, this verse is general and makes it clear that the Islamic rules are not subject to human discretion in any way.¹⁰¹² In addition, if a trade mark is in conflict with Islamic public policy and morality, then a Muslim should not use it or use the products affixed to it. For example, if there is a trade mark that consists of the name *Allah*, then a Muslim should not deal with this trade mark as it would be prohibited or ‘*haram*’.¹⁰¹³

As it can be concluded from chapters Three, Four and Six, according to the perspective of Islamic Shariah and in order to acknowledge and protect a trade mark, the mark should be compatible with Islamic Shariah concepts of *fiker* (intellectual), *milkiyyah* (ownership), *mal* (property) and *haqq* (right) as well as the five objectives of Shariah. Therefore, Islamic Shariah does not recognise any *haqq* or *milkiyyah* if it is associated with trade marks that are inconsistent with the main Islamic provisions and objectives as Khafif

¹⁰⁰⁹ *McGinley* 660 F.2d 481; 1981 CCPA LEXIS 177; 211 USPQ (BNA) 668, 5. The first Amendment to the United States Constitution states, ‘Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press ...’ The Constitution of the United States. Amendment 1 – Freedom of Religion, Press, Expression. Ratified (15 December 1791).

¹⁰¹⁰ See Chapter Six, 6.2.

¹⁰¹¹ Muhammad Khan, ‘The Role of the Government in the Economy’ (1997) 14 American Journal of Islamic Social Sciences 158.

¹⁰¹² Ismail Imad Eddin, *Tafsir Ibn Kathir* (Dar Taiba 1999) 423.

¹⁰¹³ See chapter Six, 6.4.(a). Moreover, also Muslims, according to Shariah, are encouraged to try and influence change where there is a violation of Islamic principles. For instance, any reliable Muslim (i.e. lawyer, judge or legislator) are strongly encouraged to take actions that lead to the suspension or removal of this trade mark. The Prophet (PBUH) said: ‘Whoever among you sees an evil, let him change it with his hand; if he cannot, then with his heart and that is the weakest of Faith’. Hafiz An-Nasai, *Sunan An-Nasai*, vol 1 (Nasiruddin al-Kattab (tr), Darussalam 2008) Hadith No 511, 30.

defines the right in Shariah as anything that has benefit and is protected by the law.¹⁰¹⁴ As discussed earlier, Shariah's *milkiyyah* has to be over things that are legally permissible. Hence, if the trade mark is in conflict with Shariah, it will be seen as evil, not beneficial nor deserving of protection.¹⁰¹⁵

In addition, according to the concept of *mal* in Islam, the offensive marks will not be considered as property and do not get any kind of protection as they are in conflict with Islamic public policy and morality.¹⁰¹⁶ This is because offensive marks do not meet the two conditions set by the majority of scholars to be recognised as property. The two conditions are: to have a monetary value, whether physical, corporeal or usufruct '*manfah*'; and to have a legal utility.¹⁰¹⁷ Accordingly, it can be said that there is no legitimate interest from the Shariah perspective to protect an offensive trademark. Therefore, the Islamic authority will not offer any legal protection (whether criminal or civil) to the rights relating to trade mark that are in conflict with the Shariah rules or objectives.¹⁰¹⁸ Moreover, the use of an offensive mark may result in criminal punishment. In brief, Islamic Shariah does not register, protect or allow the use of any mark that is in conflict with Islamic public policy and morality.

7.4 Conclusion

A comparison between Western and Islamic principles of public policy and morality regarding trade marks has shown that although they both share the same categories for what is considered to be offensive, there are three key differences between them. The first is the largely static nature of public policy and morality standards in the Islamic legal system as it is derived from fixed divine legislation. This is in contrast to the Western legal system where the public policy and morality standards are changeable according to time, place and circumstances. The similarity between the two systems in this context can be seen in the case of changes in circumstances which may affect trade mark registration positively or negatively. The second is the subject matter of marks. Western and Islamic legal systems share the same classification for marks that are contrary to public policy and morality. However, the difference between them lies in the meaning of certain concepts in each legal system and the effect of the nature of the goods or services on trade mark registration. The

¹⁰¹⁴ See Chapter Three, 3.4 and also Chapter Six, 6.4.

¹⁰¹⁵ See Chapter Three, 3.4.3.

¹⁰¹⁶ Muhammad Islam, 'Al-Mal: The Concept of Property in Islamic Legal Thought' (1999) 14 Arab Law Quarterly 361, 368.

¹⁰¹⁷ See Chapter Three, 3.4.4.

¹⁰¹⁸ See Chapter Four, 4.4.1 and 4.4.2.

third is the role played by public authorities in evaluating the mark. In the Western system, the role of the competent authorities in determining whether a mark is offensive is only to reflect the point of view of society. However, in all cases, rejecting a trade mark registration will not ban the owner from using the mark but will only take away the benefit of official registration. However, with regard to the Islamic system, if a mark is considered to be offensive, then the trade mark owner cannot use the mark at all let alone register it as it is seen as '*mafsadah*'.

Chapter Eight

TRIPS and Islamic Public Policy and Morality: Harmony or Dissonance

8.0 Introduction

The purpose of this chapter is to evaluate the extent to which Islamic legislation complies with or deviates from Islamic public policy and morality principles and the trade mark provisions in TRIPS. In particular, the chapter seeks to determine whether there is substantial conflict between the principles of Islamic public policy and morality and the international harmonization of trade marks set out in the TRIPS Agreement. Against this background, it suggests compromise solutions that minimise the conflict between Shariah public policy and morality and the provisions of TRIPS.

This chapter of the study also examines how the Kuwaiti legislature has balanced Kuwait's international obligations as a member state of TRIPS and its compliance with Islamic public policy and morality principles. In addition, the research explores the conflict between the Kuwaiti Trade Mark Law (the GCC Law) and the implementation of TRIPS, the impact of Shariah on public policy and morality and how these differences can be resolved.

8.1 Joining TRIPS from the perspective of Islamic Shariah

Given the large variation in the type of member states of the WTO,¹⁰¹⁹ there are two key issues to be noted.

(a) Muslim countries have chosen to operate within the global framework (TRIPS)

In general, integration between Muslim and non-Muslim countries by joining together to set international legal provisions is not contrary to Islamic rules. The main sources of Islamic Shariah, the Quran and Sunnah, have set rules that regulate treaties and contracts, and they permit the signing of treaties with non-Muslims.¹⁰²⁰ In Surah al-Anfal 4, verse 72, God says: 'And if they seek help of you for the religion, then you must help, except against a people between yourselves and whom is a treaty. And Allah is seeing of what you

¹⁰¹⁹ See, 'Members and Observers' <www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm> accessed 12 April 2016.

¹⁰²⁰ Labeeb Bsoul, 'The Concept of a Treaty in Islamic Jurisprudence' (2010) 7 Journal of Islam in Asia 55, 61; see, in general, Osman Dmerieh, *Al-Muahadat Addawliyah fi Fiqh al-Imam al-Muhammad Asheebani* (Rabitat al-Alam al-Islami 1997).

do'. Islamic Shariah places emphasis on the necessity of complying with treaties and not breaching their provisions. In Surah al-Maidah 5, verse 1, God says: 'O you who believe, fulfil [all] contracts'.¹⁰²¹ In addition, in Surah al-Tawbah 9, verse 4, God says: 'Excepted are those with whom you made a treaty among the polytheists ... so complete for them their term'. These Quranic verses expressly show that Shariah authorises international treaties and places an obligation on Muslim countries to adhere to their provisions.¹⁰²² The Prophet (PBUH) concluded and committed to many treaties and set an example for all Muslims as to the importance of fulfilling obligations contained in their agreements.¹⁰²³ In short, an Islamic country's commitment to an international treaty is a religious duty based on the Quran, the Sunnah and the consensus among scholars of Islam.¹⁰²⁴

However, there is a fundamental prerequisite imposed by Islamic Shariah which requires that any transactions that take place must not be contrary to the rules of Islam.¹⁰²⁵ As explained in Chapter Seven, commitment to the provisions of Islamic Shariah is not optional, especially on issues that relate to the Islamic higher rules interests.¹⁰²⁶ Consequently, it is not permissible for a Muslim to comply with a provision in an international agreement or any agreement that is contrary to the mandatory rules or objectives of Islamic Shariah. In general, it is forbidden for a Muslim to enter into any agreement that is inconsistent with the provisions of Islam.¹⁰²⁷

(b) Intellectual property rights are recognised as property in the Islamic legal system

Most Islamic countries have adopted the views of the majority of Muslim scholars that intellectual property elements (including trade mark) are a type of *mal*. The exception

¹⁰²¹ This includes promises, covenants, oaths, etc. Footnote 212, in Saheeh International, *The Quran* (3rd edn, Al-muntada Al-Islamy trust 2010) 141.

¹⁰²² Abu al-Wafa states, according to the traditional Islamic jurisprudence that an international treaty can only be with non-Muslims. See Ahmed Abu al-Wafa, *Al-Muahadat Addawliyah fi al-Shariah al-Islamiyyah* (Dar Al Nahda 1990) 10; Chad Cullen, 'Can TRIPS Live in Harmony with Islamic Law? An Investigation of the Relationship Between Intellectual Property and Islamic Law' (2010) 45 Science and Technology Law Review 45, 50.

¹⁰²³ Osman Dmerieh, *Al-Muahadat Addawliyah fi Fiqh al-Imam al-Muhammad Asheebani* (Rabitat al-Alam al-Islami 1997) 32.

¹⁰²⁴ Early Muslims have concluded various treaties with non-Muslims, such as commercial, military and magistrate treaties. See Muhammad Ateya and Zbar al-Abadey, 'Usoul al-Elaqat Addaoulieh fi al-Fiqh al-Islamy wa Ra'ai al-Imam Asheebani fi Hukm Al-Mua'hadat' (2011) 3 Tikrit University 76, 95, 98.

¹⁰²⁵ See Muhammad Ateya and Zbar al-Abadey, 'Usoul al-Elaqat Addaoulieh fi al-Fiqh al-Islamy wa Ra'ai al-Imam Asheebani fi Hukm Al-Mua'hadat' (2011) 3 Tikrit University 76, 97.

¹⁰²⁶ See Chapter Seven, 7.3.

¹⁰²⁷ For example, the Prophet (PBUH) says: 'There is no obedience if it involves disobedience toward Allah. Rather obedience is only (required) in that which is good.' Hafiz An-Nasai, *Sunan An-Nasai*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2008) Hadith No 4210, 137.

to this are the Hanafis who have restricted the meaning of a property to material physical things and do not include intellectual matters.¹⁰²⁸ In addition, as explained in Chapter Three, all of the intellectual property elements are consistent with the Islamic Shariah concepts of *milkiyyah* and *haqq*. Therefore, it can be concluded that the TRIPS provisions, in principle,¹⁰²⁹ are compatible with Islamic Shariah as it is a beneficial agreement that aims to protect property. The TRIPS provisions support one of the legitimate interests in Islam: *maslahah* – the protection of property ‘*hifz al-mal*’.¹⁰³⁰

Moreover, according to Chapter Six, it can be said that, generally, the main objectives of Islamic Shariah, in particular *maslahah* ‘*hifz al-mal*’,¹⁰³¹ significantly intersect with international regulations in TRIPS which recognise the existing international intellectual property rights framework. As a result, Islamic member states of TRIPS are under a sacred duty to uphold the requirements regarding trade mark protection for two reasons: first, TRIPS is an agreement and Muslims are obliged to fulfil the contracts they enter into; second, as Islamic states, they have a religious obligation to protect people's property – in this context, the protection includes the rights of the trade mark owners. In brief, the religious duty to honour the TRIPS Agreement applies because the agreement is not contrary to Shariah rules and it contributes to achieving one of the objectives of Islamic Shariah. This leads us to conclude that the application of the agreement is a religious duty itself.

In addition, following new regulations in Islamic countries regarding trade mark forms, it is obvious that there is a significant development in the understanding of the trade mark concept and function. This has led to accepting a variety of trade marks within the Islamic legal system. For example, in order to comply with the text of Article 15 in TRIPS, the Kuwaiti parliament (as well as the GCC countries) has amended the definition of trade mark and extended it to include all the trade mark types.¹⁰³²

Another example of this can be seen in the new approach that was taken by the Saudi judiciary in 2003 to accept the picture of a living organism (picture of a human or an animal)

¹⁰²⁸ See Chapter Three, 3.4.4.

¹⁰²⁹ See, Bashar Malkawi, ‘Intellectual Property Protection from a Shariah Perspective’ (2013) 16 Southern Cross University Law Review 87, 116.

¹⁰³⁰ Chad Cullen, ‘Can TRIPS Live in Harmony with Islamic Law? An Investigation of the Relationship Between Intellectual Property and Islamic Law’ (2010) Science and Technology Law Review 45, 50. See also, Chapter Six, 6.4(e).

¹⁰³¹ See Chapter Six, 6.4(e).

¹⁰³² The amendments made to Art 61 covered some aspects of trade marks, by adding descriptive factors, colour, sound and smell marks. This is in addition to any forms, which are intended to be used to differentiate between goods, products or services, to comply with the text of Art 15 of TRIPS. See, The Law Decree No 1 issued in 2001, amending the Trade Law No 68 of 1980, art 62, para 2. See also, GCC Trade Marks Law, art 3.

as a trade mark. The Saudi Office of the Ombudsman has justified this change by stating that the purpose behind creating an image is the key factor in determining the Shariah position regarding this object. Moreover, as trade marks are created to be used as tools to distinguish goods and services from similar ones in the market rather than to be used in religious or sacred contexts, there is no harm in registering signs consisting of a picture of a living being as a trade mark.¹⁰³³ Also, in Iran,¹⁰³⁴ the court of first instance upheld the decision of the Trade Mark Office to reject the registration of ‘SHAHRZAD’ which consisted of a picture of a woman in relation to a tea product since it was believed that this mark was in conflict with Islamic public policy and morality. However, the appellate court reversed the decision of the Trade Mark Office later, stating that the use of such an image was not inconsistent with good morals and thus could be used as a trade mark within Islamic public policy and morality principles.¹⁰³⁵ This legislative development is consistent with the contemporary Islamic understanding of trade mark forms and uses, thus confirming the conclusion reached in Chapter Four of this thesis.¹⁰³⁶

8.2 TRIPS requirement to protect trade mark within Islamic Shariah

As illustrated in Chapter 2, Article 1, paragraph 1 of TRIPS obliges member states to provide no less than the minimum level of protection that is required by the agreement. Article 65 TRIPS states that the member states must be committed to implementing the rules of the agreement. This means that the rules of this agreement are mandatory on the states that sign up to it. They should therefore do everything necessary to comply with the legal rules set out in the agreement.¹⁰³⁷ The provisions in TRIPS enforce a comprehensive system on member states to protect intellectual property rights which include civil and administrative procedures, criminal procedures and other border measures.¹⁰³⁸ Therefore, as Islamic Shariah rules play a dominant role in Muslim countries, the basic question in this

¹⁰³³ Abdullatif al-Qarni, ‘Almabadi al-Qada’iyyeh Bayna Attaghyeer wa al-Ta’adeel’ *The Economic* (Riyadh, 14 April 2010) <http://www.aleqt.com/2010/04/14/article_379065.html> accessed 14 November 2016.

¹⁰³⁴ Note that Iran did not obtain WTO membership yet but has an observer status. However, Iran as a member has been part of the Paris Convention since 1959. See WIPO Administered Treaties <www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=2> accessed 12 April 2016.

¹⁰³⁵ Muhammad Badamchi, ‘Iran’ (World Trademark Yearbook, 2006) 183, 186.

¹⁰³⁶ See Chapter Four, 4.4.3.

¹⁰³⁷ Arts 65/66 of TRIPS divided the world’s countries into three categories. It also allocated a different legal status for each category of member states which joined the WTO. There were three categories: (1) developed countries (2) developing countries (3) less developed countries.

¹⁰³⁸ See TRIPS Part 3 Enforcement of Intellectual Property Rights, Section 2: Civil and Administrative Procedures and Remedies; Section 5: Criminal Procedures Art 61; Section 3: Provisional Measures Art 50. Part 6: Sanctions (42-44).

context is whether Shariah limits the ability of Islamic member countries to comply fully with the protection requirements in the TRIPS.

A review of intellectual property regulations including trade mark laws in Muslim countries suggests that these regulations provide a protection regime for owners of trade marks. These can be seen as serious attempts to meet the required standards of TRIPS in relation to protection matters. In addition to civil and administrative procedures, the GCC Trade Mark Law No 13 of 2015 sets out the legal steps to be taken against anyone who violates the rights of trade mark owners. The law gives the trade mark owner the right to request that the competent authorities refuse customs release for products that are imitations or fakes or where the products bear marks that are similar to their mark as it would mislead consumers.¹⁰³⁹ Penalties may include imprisonment for a period not exceeding three years and a fine not exceeding one million SR or the equivalent in other GCC currencies.¹⁰⁴⁰ Many Muslim countries have taken a similar legal approach to the GCC's Trade Mark Law, such as the Egyptian Intellectual Property Law No 82 of 2002 and the Jordanian Trade Marks Law No 34 of 1999. In addition, registered and unregistered trade mark owners can enjoy protection of their trade marks through general unfair competition principles and can claim compensation through the Civil Law.¹⁰⁴¹ It is worth noting that these legal rules are no different to those applied in the Western legal systems in respect of legal protection for trade marks.¹⁰⁴²

Therefore, in principle, according to the above examples, Islamic Shariah rules do not present any obstacles to Islamic member countries who are part of TRIPS which prevent them from complying with the requirements of the agreement in respect of trade mark protection. Moreover, the comparison between the trade mark protection forms set by TRIPS and those set by Shariah, discussed previously in Chapter Four, shows a high level of

¹⁰³⁹ See GCC Countries Trade Mark Law No 18 of 2007, part 5: Rights Enforcement (38-41).

¹⁰⁴⁰ See GCC Trade Marks Law, part 6: Sanctions (42-44). See also, The Kuwaiti Trade Mark Law 2001, chapter 3, acts 92 to 95. See, generally, David Price, *The Development of Intellectual Property Regimes in the Arabian Gulf States: Infidels at the Gates* (Routledge 2009) 92.

¹⁰⁴¹ See, the Kuwaiti Court of Cassation states that unfair commercial competition is considered to be a tortious act that results in the tortfeasor with legal liability having to compensate for the damage caused according to art 272 Civil Law. Court of Cassation No 192 of 2002. In other words, a registered/unregistered trade mark owner has the right to claim for a civil damages i.e. to obtain compensation as a result of the unlawful use of the mark. The right to compensation is based on the Kuwaiti Civil Law which states that any person who commits an act that causes damage to another party will be liable to compensate for such damage. Similar rules are applied in The Egyptian Civil Law Act 163, No 43131 of 1948 and The Jordanian Civil Law Act 269, No 43 of 1976.

¹⁰⁴² See, in general, Bhaskar Thakuria, 'Principles Governing Damages in Trade Mark Infringement' (2010) 15 Journal of Intellectual Property Rights 374; Mary LaFrance, 'Passing Off and Unfair Competition: Conflict and Convergence in Competition Law' (2011) 5 Michigan State Law Review 1413.

compatibility between the two legal regimes.¹⁰⁴³ As discussed earlier, the basic rule in Islamic Shariah is that a trade mark is property and has full protection. Trade mark criminal protection in Shariah is based on the discretionary punishment ‘*tazeer*’ which is subject to the discretion of the competent authorities (such as ruler and judge). This means that the rules derived from TRIPS which have been adopted from Muslim countries can be considered part of the Islamic criminal regulations regarding trade mark. In addition, as was pointed out in the same chapter, compensation is an essential principle in Islamic Shariah which preserves the general rights of people and their property.¹⁰⁴⁴ The Government of Justice, ‘*hacamat adel*’, can be consistent with the compensation related to violation against trade marks as this sort of compensation is broad and is not limited to a specific type of matters. Furthermore, Islamic Shariah allows for the destruction or forfeiture of forbidden products which bear counterfeit trade marks.¹⁰⁴⁵

Accordingly, it can be seen that Islamic legislation is flexible enough to recognise modern issues including the protection provided by TRIPS.¹⁰⁴⁶ Also, implementing TRIPS provisions in Islamic jurisdictions make them part of the Islamic legal system in those countries.¹⁰⁴⁷ Applying this understanding leads to three conclusions: firstly, Islamic member countries’ obligation to protect trade marks is considered a religious matter and the protection of property is an essential part of Shariah (in fact, is one of its main aims);¹⁰⁴⁸ secondly, a Muslim’s obligation to Islamic Shariah is subjective, and in Islam those who violate another’s property rights (including trade marks) may be punished in the afterlife on the Day of Resurrection;¹⁰⁴⁹ and thirdly, Islamic Shariah rules, in relation to trade mark protection, do not discriminate between registered and unregistered trade marks (or between well-known and normal trade marks). They consider trade mark as property which deserves to be protected regardless of its registration status. Accordingly, it acknowledges the effect of considering trade mark protection regulations set by TRIPS as part of Islamic Shariah rules, and it makes this protection more effective and wider than what TRIPS requires from Muslim countries. This is especially important when considering that some Muslims are

¹⁰⁴³ See Chapter Four, 4.4.3.

¹⁰⁴⁴ See, Houry Almhita, ‘Divergence Among Scholars in Applying the Principle of Compensation for Damage in Islamic Law’ (2011) 9 Journal of Anbar University of Human Sciences 89.

¹⁰⁴⁵ See Chapter Four, 4.4.2(2).

¹⁰⁴⁶ See Chapter Three, 3.3. See also Chad Cullen, ‘Can TRIPS Live in Harmony with Islamic Law? An Investigation of the Relationship Between Intellectual Property and Islamic Law’ (2010) Science and Technology Law Review 45, 58.

¹⁰⁴⁷ See, in general, Chapters Six, 6.3.1. (c).

¹⁰⁴⁸ See Chapter Four, 4.4.2(2).

¹⁰⁴⁹ See Chapter Four, 4.4.2(2).

reluctant to enforce intellectual property rights because from their perspective international agreements are just a tool in the Western struggle for hegemony over Muslim countries.¹⁰⁵⁰

Beltrametti states that:

... the association made with “the West” is often negative, and this notion spreads over to intellectual property rights. Some take it a step further and argue that it is a new tool of the West to monopolize the economic system of predominantly Muslim countries.¹⁰⁵¹

Consequently, concluding that trade mark protection provisions set by TRIPS comply with Islamic rules will place them under the umbrella of Shariah, thus increasing their respect in the Muslim world on both individual and official levels.

8.3 The nature of the goods and services preventing trade mark registration in Islamic countries

The key finding of Chapter Six and the analysis of the principles of Islamic public policy and morality both confirm that these principles can play an essential and effective role in terms of creating a balance between Islamic Shariah rules and international regulations that protect trade marks, ie the co-existence between the two legal systems (Islamic and international) would not be possible without the public policy and morality exception in TRIPS which allows a member state to refuse trade mark registration on the grounds of public policy or morality.¹⁰⁵² However, Article 7 of the Paris Convention and Article 15(4) of the TRIPS Agreement present a major problem to Muslim countries in terms of their obligations. These articles limit the Islamic countries’ right to reject the registration of a trade mark. Most provisions in the TRIPS Agreement are compulsory and member countries cannot choose to abide by some and ignore others, and this applies to provisions set by Articles 7 Paris and 15(4) TRIPS. Both state that ‘the nature of the goods (and the services in TRIPS) to which a trade mark is to be applied shall in no case form an obstacle to registration of the trade mark’. To make it clear, all provisions set by TRIPS are mandatory for Muslim countries. Therefore, consistent with these articles it would be unacceptable to

¹⁰⁵⁰ Rami Olwan, *Intellectual Property and Development: Theory and Practice* (Springer 2013) 186; Chad Cullen, ‘Can TRIPS live in Harmony with Islamic Law? An Investigation of the Relationship Between Intellectual Property and Islamic Law’ (2010) *Science and Technology Law Review* 45, 59.

¹⁰⁵¹ Silvia Beltrametti, ‘The Legality of Intellectual Property Rights under Islamic Law’ (2010) *The Prague Yearbook of Comparative Law* 55, 87.

¹⁰⁵² As explained in Chapter Five, TRIPS itself does not explicitly discuss the concept of public policy and morality. It refers to the Paris Convention which allows member states to deny trade mark registration if it is contrary to those concepts. See, art 2 of the TRIPS Agreement.

refuse to register a trade mark from a member state of TRIPS on the grounds that the mark is affixed to products that are contrary to public policy or morality.

In short, TRIPS limits the situations in which trade mark registration can be rejected. Consequently, this places Islamic countries in a difficult position: on the one hand, they have an international obligation to register trade marks even if these marks are associated with forbidden goods or services, on the other hand, Islamic Shariah rules prohibit the registration of these kinds of trade marks and consider it to be a sin. To be more specific, the discussion centres around situations where the refusal to register a trade mark is based on the nature of the product that the mark was going to be (or already is) affixed to and not because of the trade mark itself. Therefore, consistent with these articles (7 Paris and 15(4) TRIPS) it would be unacceptable to refuse to register a trade mark from a member state of TRIPS on the grounds that the mark is affixed to products that are contrary to public policy or morality. This is a thorny subject because this matter raises a question about the limits of the state's authority to accept or reject the registration of a trade mark.

According to Lutfi and Davison, the aim of these provisions (Articles 7 Paris and 15(4) TRIPS) was to find a balance between achieving the protection of trade marks and the rights of member states to prevent their use on goods or services that conflict with their public policy or morality,¹⁰⁵³ as well as protecting the right of the trade mark owners from the unlawful use of their trade marks for other similar or non-similar products in any country.¹⁰⁵⁴ In line with the previous explanation, the key purpose of TRIPS was to protect the trade mark itself, regardless of the product that it may be associated with. As such, it is logical to set the rule above which distinguishes between the trade mark and the products affixed to it. However, this may be considered to create an unacceptable situation as it forces member states to register trade marks of products that will not be used in their markets.¹⁰⁵⁵ At the same time, it must be made clear that there is no harm in registering trade marks of products that are contrary to public policy or morality in this context because registration of

¹⁰⁵³ Muhammad Lutfi, *Ta'atheer Itifaqiyya Ajawaneb al-Mutasileh bil-Tijareh min Huqouq al-Milkiyyet al-Fikriyah "TRIPS" ala Tashria'at al-Buldan al-Arabiyyeh* (Al-alm al-Araby 1999) 51; Mark Davison, 'The Legitimacy of Plain Packaging Under International Intellectual Property Law: Why There is No Right to Use a Trademark Under Either the Paris Convention or the Trips Agreement' in A Tania Voon and others (eds), *Public Health and Plain Packaging of Cigarettes: Legal Issues* (Edward Elgar 2012) 91.

¹⁰⁵⁴ See Adnan Brnbu, *Al-Tanzeem al-Qanuny lil-Alamat al-Tijarieh Dirasah Muqaranah* (Al-Halaby 2012) 131. See also, Muhammad al-Shammari, 'Himayat al-Alamah al-Tijarieh fi Dou'a Itifaqiyat al-Jawaneb al-Muta'aliqeh bil-Tijareh min Hoqouq al-Milkiyyah al-Fikriyah' (DPhil thesis, Cairo University 2004) 202.

¹⁰⁵⁵ Muhammad al-Shammari, 'Himayat al-Alamah al-Tijarieh fi Dou'a Itifaqiyat al-Jawaneb al-Muta'aliqeh bil-Tijareh min Hoqouq al-Milkiyyah al-Fikriyah' (DPhil thesis, Cairo University 2004) 202.

the trade mark does not force the country to allow the forbidden products or services to be sold but it still protects the trade mark.¹⁰⁵⁶

In terms of how Islamic countries actually deal with these texts, in the Kuwaiti Trade Mark Law, for example, there is no rule that allows or forbids the registration of a trade mark that is associated with forbidden products. However, as highlighted in Chapter Six, the TRIPS Agreement and the Paris Convention principles are considered to be part of national Kuwaiti law.¹⁰⁵⁷ Therefore, if the Trade Mark Law or the competent authority prevents registration of a trade mark for use on forbidden products from a legal perspective, this act can be seen as contrary to Kuwait's national and international obligations.

The overview of the Kuwaiti Trade Mark Classification List of Goods and Services suggests that the practice in Kuwait by the authorities is contrary to TRIPS Article 15, paragraph 4 and Article 2, which refers to Article 7 of the Paris Convention, because they reject trade marks for products forbidden in Kuwait even if the mark itself is compatible with the Trade Mark Law.¹⁰⁵⁸ In other words, it can be said that this classification violates international agreements signed by Kuwait which have become national laws.

A further problem arises in this context about the rights relating to trade mark use. If Muslim countries adhere to the provisions of Articles 7 Paris and 15(4) TRIPS and register trade marks regardless of the nature of the products, then this registration, according to some writers such as Gervais, will give the trade mark owner the full right to use it even if the country bans the import and sale of the products.¹⁰⁵⁹ This would mean that the owner of the trade mark can continue to use it to advertise and promote forbidden products in the markets of Muslim countries. In this case, banning the import and sale of the products will not be effective if products can still reach the targeted customers without having permission from the national authorities, for example, when the goods and services are available online such as business activities associated with gambling or sites promoting sexual services. If this is the case then, even if a country has the right to ban the sale of certain goods and services

¹⁰⁵⁶ Mark Davison, 'The Legitimacy of Plain Packaging Under International Intellectual Property Law: Why There is No Right to Use a Trademark Under Either the Paris Convention or the Trips Agreement' in A Tania Voon and others (eds), *Public Health and Plain Packaging of Cigarettes: Legal Issues* (Edward Elgar 2012) 90.

¹⁰⁵⁷ See Chapter Six, 6.3.1.(4)(c).

¹⁰⁵⁸ See Appendix 1 of the Implementing Regulations of the Trade Mark Law in Kuwait.

¹⁰⁵⁹ See in general, Daniel Gervais, 'Analysis of the Compatibility of Certain Tobacco Product Packaging Rules with the TRIPS Agreement and the Paris Convention (30 November 2010)' (Report prepared for Japan Tobacco International). See also, Memorandum from Lalive to Philip Morris International Management SA, 'Why Plain Packaging is in Violation of WTO Members' International Obligations under TRIPS and the Paris Convention (23 July 2009)' (Lalive Report).

according to Gervais and others, there is broad consensus across the WTO about this right. However, this right becomes useless as indicated above.¹⁰⁶⁰

Some scholars argue that there is no obligation in TRIPS (nor in the Paris Convention) on a member country regarding the right to allow the use of trade marks. For example, Davison has taken a clear approach in answering the question of whether there is a right under Paris or TRIPS to use a trade mark by stating that: ‘There is no express or implied right to use a trade mark under the Paris Convention or the TRIPS Agreement’,¹⁰⁶¹ ie there is no legal relation between registering the trade mark and the right to use it. Even if this argument were accepted, the problem will continue to exist in relation to Articles 7 Paris and 15(4) TRIPS. The reason for this is that both articles require the concerned authorities to ensure protection for trade marks associated with forbidden products and services. The most notable consequence of registrations of this kind of mark is to recognise them as property which constitutes a clear violation of the concepts of property, ownership and right in Islamic Shariah,¹⁰⁶² which will lead to substantial conflict with Islamic public policy and morality principles.

The Prophet (PBUH) said: ‘There is no obedience if it involves disobedience toward Allah. Rather obedience is only (required) in that which is good’.¹⁰⁶³ Therefore, it is not acceptable to argue that Islamic countries have an international obligation under WTO/TRIPS to adopt their provisions; this would not be recognised as a valid reason to follow provisions even if some of the provisions are in conflict with Islamic Shariah rules.¹⁰⁶⁴

To return to the Kuwaiti example, a possible way of solving the contradiction between the Kuwaiti Trade Mark Law and TRIPS could be as follows. The Kuwaiti authorities could add a new classification which allowed registration of trade marks for

¹⁰⁶⁰ Gervais clearly states that ‘no-one doubts that WTO Members can ban the sale of certain products (e.g. pharmaceuticals, fireworks, alcohol and tobacco).’ Gervais *ibid* 21. In addition, Davison confirmed Gervais’ statement by stating that: ‘This statement is no doubt true’. Mark Davison, ‘The Legitimacy of Plain Packaging Under International Intellectual Property Law: Why There is No Right to Use a Trademark Under Either the Paris Convention or the Trips Agreement’ in A Tania Voon and others (eds), *Public Health and Plain Packaging of Cigarettes: Legal Issues* (Edward Elgar 2012) 90.

¹⁰⁶¹ Mark Davison, ‘The Legitimacy of Plain Packaging Under International Intellectual Property Law: Why There is No Right to Use a Trademark Under Either the Paris Convention or the Trips Agreement’ in A Tania Voon and others (eds), *Public Health and Plain Packaging of Cigarettes: Legal Issues* (Edward Elgar 2012) 108.

¹⁰⁶² See Chapter Three, 4.3.

¹⁰⁶³ Hafiz An-Nasai, *Sunan An-Nasai*, vol 5 (Nasiruddin al-Kattab (tr), Darussalam 2008) Hadith No 4210, 137.

¹⁰⁶⁴ See Osman Dmerieh, *Al-Muahadat Addawliyyeh fi Fiqh al-Imam al-Muhammad Asheebani* (Rabitat al-Alam al-Islamy 1997) 60.

goods or services that were forbidden in Kuwait such as alcoholic beverages.¹⁰⁶⁵ This is because the Kuwaiti Trade Mark Law does not explicitly forbid registering trade marks on the basis of the nature of the product, and Kuwaiti law deals with the trade mark independently from the products. If a new classification were added for products that are forbidden in Kuwait, it would allow the trade mark to be registered but the product itself would still be banned.¹⁰⁶⁶ Nevertheless, this would pose a problem in relation to Article 24 of the Kuwaiti Trade Mark Law which allows revocation of any trade mark that has not been used for five years. Having said that, trade mark revocation is not automatic and requires a court order which would not be issued until an investigation was conducted into the reason why it had not been used before revoking the trade mark. Therefore, it is possible that the court can decide not to revoke the mark for non-use in Kuwait if there is a compelling reason not to do so.¹⁰⁶⁷ In this case, the court might consider the Kuwaiti law which prohibits the trade of these products as a compelling enough reason. This is consistent with Article 19 TRIPS which considers the import restrictions or other government requirements on a product as valid reasons for non-use of the trade mark. Therefore, in this type of case, the registration of the trade mark would not be revoked.¹⁰⁶⁸

From modern Shariah perspective, allowing the registration of a trade mark of a forbidden product is in conflict with Islamic Shariah rules. In Surah Al-Maidah 5, verse 2 of the Quran, God says: ‘And cooperate in righteousness and piety, but do not cooperate in sin and aggression’. A Muslim should not directly or indirectly co-operate in contributing towards facilitating things that are forbidden, and those who assist with things that are forbidden are guilty or sinful even if they did not commit the forbidden act.¹⁰⁶⁹ Imam Qurtubi states that anyone who leads to a sin is similar in guilt to the one who does it.¹⁰⁷⁰ To make it clear, if the registration of the mark may lead to a breach of one of the five necessary Shariah objectives, then the registration becomes *mafsadah* from an Islamic perspective.

¹⁰⁶⁵ See The Nice Classification (NCL) established by the Nice Agreement (1957) which is an international classification of goods and services applied to the registration of marks, Class 33 - alcoholic beverages (except beers). The Kuwaiti trade marks classification does not include a similar category to Class 33. Therefore, it is not possible to register any trade marks relating to alcoholic beverages in Kuwait.

¹⁰⁶⁶ TRIPS does not oblige Member States to allow the introduction of goods and services that are contrary to public policy or morality of the country in question.

¹⁰⁶⁷ See Kuwaiti Trade Mark Law (GCC) art 24.

¹⁰⁶⁸ TRIPS, art 19, para 1: ‘Circumstances arising independently of the will of the owner of the trade mark which constitute an obstacle to the use of the trade mark, such as import restrictions on or other government requirements for goods or services protected by the trade mark, shall be recognized as valid reasons for non-use.’

¹⁰⁶⁹ Abdul Rahman Al-Saady, *Tafsir As-Saady* (Dar-Iban-Jawzi 2004) 228.

¹⁰⁷⁰ Muhammad Qurtubi, *Al-Jami' li Ahkam al-Quran*, vol 6 (Dar Alkotob 1964) 47, 48.

In addition, as mentioned in Chapter Two, there is no doubt that trade marks play an important role in promoting the product that they are affixed to as it helps increase their profile and strengthens its position amongst consumers.¹⁰⁷¹ Therefore, if the product is forbidden in Shariah, the registration of the trade mark belonging to this product will also be forbidden because the product would benefit from it and this can be considered as giving support to the forbidden product.

The position of Kuwait is difficult because, on the one hand, if Kuwait makes an amendment to its trade mark classification to include forbidden goods and services in order to comply with TRIPS, it would be in conflict with Islamic Shariah rules. However, if nothing changes, then Kuwait will continue to be in breach of its obligations under TRIPS, and this is the dilemma.

From my point of view, the best action to take would be to add a new class for forbidden goods or services in the Trade Mark Classification List stipulated in the Executive Regulations of the Trade Mark Law so the applicant can still file an ‘application’ to register the trade mark and will therefore be in compliance with the TRIPS requirement. Note that, the actual use of the trade mark is not a condition for filling the application in Kuwait, and this is consistent with TRIPS requirement.¹⁰⁷²

Therefore, it would also be important to make an amendment to the Kuwaiti Trade Mark Law to make trade mark registration dependent on use and then this amendment would not be in conflict with TRIPS. According to Article 15, paragraph 3 of TRIPS: ‘Members may make registrability dependent on use. However, actual use of a trade mark shall not be a condition on filing an application for registration.’ In this case, Kuwaiti authorities would be able to refuse registration of the trade mark because of the lack of actual use. There are many states that have trade mark laws which require proof of use before accepting registration of the mark. The most prominent of these is the Lanham Act, the American trade mark law.¹⁰⁷³ Further, this proposal is consistent with Article 19 of TRIPS because the article establishes controls for the revocation of a trade mark which is already registered in case the mark is not used, but the article is not related to the condition requiring the use of the trade mark before the registration is accepted. This is clear from the first sentence in Article 19: ‘1. If use is required to maintain registration ...’. In other words, the text suggests that a

¹⁰⁷¹ See, in general, Chapter Two, 2.4.

¹⁰⁷² TRIPS art 15, para 3.

¹⁰⁷³ See Paul Heald, ‘Trade Mark and Geographical Indications: Exploring the Contours of the TRIPS Agreement’ (1996) 29 *Vanderbilt Journal of Transnational Law* 635, 660.

registered trade mark should be used but not that the trade mark should have been used before being registered which is allowed by Article 15, paragraph 3: ‘Members may make registrability dependent on use’.¹⁰⁷⁴ In essence, there are two issues relating to the use of trade marks in TRIPS: the first is the requirement of use of the trade mark prior to filing the application, and the other is about use of the trade mark to maintain the validity of the trade mark registration.¹⁰⁷⁵

Under my proposal, the Kuwaiti authority will permit the owner of the trade mark to file the application for registration and after a certain period of time, such as three years, the Kuwaiti authority can refuse to register the trade mark on the grounds that the applicant did not use the trade mark during this period even if the reason for non-use was a restriction on import or any other Kuwaiti law that bans certain products in Kuwait. This is because the rule of Article 19 TRIPS only deals with maintaining the trade mark registration and not the registration per se.¹⁰⁷⁶ As a result of this amendment, the competent authority could refuse to register a trade mark based on non-use and not based on the nature of the products themselves. In this way, Kuwait can meet its international obligations as well as keeping in line with Islamic public policy and morality principles.

In fact, the majority of countries that are affected by these texts (Articles 7 Paris and 15(4) TRIPS) are Muslim countries, such as Kuwait, Saudi Arabia and Iran, because they forbid products that are in conflict with Shariah teachings and then refuse registration of trade marks linked to these products. Therefore, some countries, such as Saudi Arabia, have been reluctant to join the TRIPS Agreement.¹⁰⁷⁷ However, the solution suggested earlier, in the case of Kuwait, appears to be the most valid one, which is to refuse the registration of trade marks for forbidden products based on non-use rather than the nature of the products themselves. This solution creates a balance between international obligations of Muslim countries and Islamic public policy and morality principles.

With regard to protecting well-known trade marks, which are usually targets for infringement, if these marks are associated with forbidden products and a Muslim country refuses registration, then the mark will be still protected in these countries under Article 6

¹⁰⁷⁴ TRIPS art 15, para 3.

¹⁰⁷⁵ See, in general, Mark Davison, ‘Use and Non-use in Trademark Law’ in Jeremy Phillips and Ileana Simon (eds), *Trade Mark Use* (Oxford University Press 2005) 20.

¹⁰⁷⁶ This solution to create compatibility between Islamic Shariah rules and TRIPS was mentioned briefly by Carvalho. See, Nuno Carvalho, *The TRIPS Regime of Trade Marks and Designs* (Kluwer Law International 2006) 331.

¹⁰⁷⁷ See Adnan Brnbu, *Al-Tanzeem al-Qanuny lil-Alamat al-Tijarieh Dirasah Muqaranah* (Al-Halaby 2012) 131. See also, Muhammad al-Shammari, *Himayat al-Alamah al-Tijarieh fi Dou’a Itifaqiyat al-Jawaneb al-Muta’aliqeh bil-Tijareh min Hoquq al-Milkiyyah al-Fikriyah* (DPhil thesis, Cairo University 2004) 202.

Paris, which is incorporated into TRIPS by Article 16(2). These provisions also protect well-known marks.¹⁰⁷⁸ The Paris Convention (in Article 6) obliges all the member states to protect well-known trade marks by upholding the owner's exclusive rights which include refusal to register the mark or by deleting the registration or banning its use.¹⁰⁷⁹ This also includes copies, imitations or translations of a well-known trade mark even if the well-known trade mark has not previously been registered.¹⁰⁸⁰

Now, in the case of Muslim countries that follow Islamic Shariah rules strictly, the way they deal with the provisions in Articles 7 Paris and 15(4) TRIPS is similar to the approach of the Kuwaiti authority in dealing with these provisions – they ignore the provisions in these articles and continue to refuse registration based on the nature of the goods and/or services instead.¹⁰⁸¹ For example, the Iranian authorities refused to register a trade mark because of its connection with alcoholic beverages which are contrary to Islamic Shariah.¹⁰⁸² In addition, in Saudi Arabia the competent authorities refused to register a trade mark, citing Shariah, as the mark was to be used for a movie production company. In their view, the registration would be in conflict with Surah Al-Maidah 5, verse 2, where God says: 'O you who have believe ... cooperate in righteousness and piety, but do not cooperate in sin and aggression. And fear Allah; indeed, Allah is severe in penalty'.¹⁰⁸³ In other words, registration of a mark will be prevented if it will be used with goods or services that are forbidden in Islamic Shariah.

¹⁰⁷⁸ Stephan Chong, 'Protection of Famous Trade Marks Against Use for Unrelated Goods and Services: A Comparative Analysis of the Law in the United States, the United Kingdom and Canada Recommendations for Canadian Law Reform' (2005) 95 Official Journal of the International Trademark Association 642, 645, 646.

¹⁰⁷⁹ Paris art 6 bis: 'The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trade mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.'

¹⁰⁸⁰ The well-known mark holds great value and economic significance for its owner and acts as an enticing element to consumers. For this and more, TRIPS and the earlier Paris Convention have special provisions for the protection of well-known marks and the exclusive rights of its owner. Danguole Klimkeviciute, 'The Legal Protection of Well-known Trademarks and Trademarks with a Reputation: The Trends of the Legal Regulation in the EU' (2010) 3 Member States Social Sciences Studies 229, 256; Hossam Al-Saghir, 'Well-Known Trademark Protection' (National Training for Diplomats Workshop WIPO, Oman, 5-7 September 2005) WIPO/IP/DIPL/MCT/05/8.

¹⁰⁸¹ See the Saudi Law of Trade marks (GCC) (26 April 2014).

¹⁰⁸² Muhammad Badamchi, 'Iran' (World Trademark Yearbook, 2006) 183, 186

<<http://www.worldtrademarkreview.com/Intelligence/Yearbook/2006/Country-chapters/Iran>> accessed 27 January 2016.

¹⁰⁸³ The Saudi Office of the Ombudsman. Decision No 56/3 of 1999 mentioned in Mansour al-Mansour, 'Al-Alamatu Attejariyeh wa Ahkamuha fi al-Fiqh wan-Nizam' (DPhil thesis, Imam Muhammad Ibn Saud Islamic University 2002) 316, fn 3.

The current legal position in Muslim countries regarding Articles 7 Paris and 15(4) TRIPS is difficult. Practical application suggests that these countries have disregarded the provision of Articles 7 Paris and 15(4) TRIPS as they continue to refuse trade mark registration based on the nature of the goods and/or services. This means that WTO Islamic members may be in violation of the Paris Convention (and TRIPS Article 15.4). As such, WTO members have the right to challenge Islamic members' compliance with the TRIPS Agreement before the WTO Dispute Settlement Body. If Islamic members are found to be in violation of their TRIPS obligations, then the Islamic members could face international legal sanctions unless they adhere to the Dispute Settlement Body recommendations.¹⁰⁸⁴

In conclusion, critical analysis of the actions taken by Islamic countries in relation to the provisions set out in Articles 7 of the Paris Convention and TRIPS 15(4) makes clear that there is a breach of these articles by strict Islamic countries. The only solution available to these countries is to make legislative amendments to their rules with regard to this issue such as in the case of the Kuwaiti Trade Mark Law.

8.4 The dilemma of the national treatment obligations within the Islamic Shariah rules

The discussion in the earlier sections focused on the impact of trade mark forms as well as how the nature of the product itself may affect the acceptance of a trade mark for registration in the Islamic legal system. However, another issue in respect to trade mark regulation relates to the source of the product and where the trade mark has originated from. In Kuwait and in many other Islamic countries¹⁰⁸⁵ there is a specific body to identify trade marks and products which originate in Israel. This is called the Israel Boycott Office within Customs Administration.¹⁰⁸⁶ According to Article 3, paragraph 10 of the Kuwaiti Trade Mark Law (GCC), it is not permitted to register any '[m]arks owned by natural or artificial

¹⁰⁸⁴ See TRIPS Art 64(1) Dispute Settlement.

¹⁰⁸⁵ See, for example, the Saudi Trade Marks Law (GCC) (26 April 2014) art 3, para 10. See also, Israel Boycott Law (23 November 1962). See the UAE Trade Mark Law, Federal Law No 37 of 1992, and the amended Law No 8 of 2000, art 10.

¹⁰⁸⁶ Kuwaiti Trade Mark Law (GCC), art 3, para 10. See the Customs Administration Resolution No 72. Customs Administration. Starting from 1948, the Arab League countries have kept an official boycott of trade with Israel and any companies that trade with it. However, in 1979 Egypt and Israel entered into a peace treaty, and Egypt and some other Arab countries did not officially participate in the boycott. In addition, Jordan and some members of the Gulf Cooperation Council (GCC) have ended their participation in the boycott. It is worth mentioning that because of this boycott against Israel, in 1977 the USA issued legislation specifically designed to counteract the Arab League's boycott of Israel. See Paul Kilmer and Michael Mlotkowski, 'U.S. Economic Sanctions and Anti-Boycott Laws' (2012) International Trademark Association 3. See also, Amir Khoury, 'The Development of Modern Trademark Legislation and Protection in Arab Countries of the Middle East' (2003) 16 The Transnational Lawyer 251, 293.

persons with whom dealing is banned pursuant to a decision issued in this respect by the competent authority'.¹⁰⁸⁷ Therefore, this rule currently applies to trade marks owned by Israeli companies only and Israeli trade marks of products made in Israel, even if the trade mark owner is not Israeli, and also any other trade marks that are similar to any Israeli marks, symbols or mottos even if the products are not of Israeli origin.¹⁰⁸⁸ As such, the question to consider here is whether this article is in breach of the TRIPS Agreement, particularly Article 3 on 'National Treatment' which states that each member state will give nationals of other member states no less than the same treatment that it grants to its citizens with regard to the protection of intellectual property.¹⁰⁸⁹ Israel has been a member of TRIPS since 1995¹⁰⁹⁰ and according to Article 3 in respect of trade marks, Kuwait should treat Israeli citizens the same as it treats Kuwaiti citizens. As a result, it can be said that the Kuwaiti Trade Mark Law, which does not allow the registration of any Israeli trade mark, is in conflict with Article 3 'National Treatment' of TRIPS. The answer would be for the Kuwaiti legislator to delete paragraph 10 which can be used to discriminate against Israeli citizens in order to meet TRIPS provisions. In addition, as Kuwait joined the Paris Convention recently (in 2014), it is also in conflict with Article 2, paragraph 1 of the Paris Convention.¹⁰⁹¹ This was the opinion of the Kuwaiti government when making amendments to cancel Article 62, paragraph 7 that allowed the registration of the Israeli trade mark in Kuwait in 1999 which was then rejected by the National Assembly.¹⁰⁹² In 2001, the National Assembly kept this principle (set in Article 62, paragraph 7) in the latest amendment of the Trade Mark Law.¹⁰⁹³ The Kuwaiti government presented another proposal to cancel the offending paragraph but this was also rejected by Parliament.¹⁰⁹⁴ In conclusion, the rule for boycotting the Israeli trade mark still exists under the current Kuwaiti Trade Mark Law, ie the GCC Law. Consequently, according to the Kuwaiti government's perspective, this may be considered out of line and in conflict with the TRIPS Agreement which may lead to Kuwait being held liable at an international level.

¹⁰⁸⁷ See, the Decree No 21 of 1964 regarding the Unified Law of Boycott of Israel.

¹⁰⁸⁸ See, Ministerial Decrees No 130 of 1957 and No 134 of 1958 regarding Boycott of Israeli goods and signs.

¹⁰⁸⁹ See Chapter Two, 2.5.2.

¹⁰⁹⁰ Israel's participation in the WTO; Israel has been a member of the WTO since 21 April 1995 and a member of GATT since 5 July 1962. See WTO, 'Member Information: Israel and the WTO' <https://www.wto.org/english/thewto_e/countries_e/israel_e.htm> accessed 8 December 2014.

¹⁰⁹¹ Paris Convention, art 2, para 1: 'National Treatment for Nationals of Countries of the Union'.

¹⁰⁹² See the Law explanation note of Law No 3 of 1999, art 2.

¹⁰⁹³ Law Decree No 3 of 1999, amending some rules of the Commerce Law 1980.

¹⁰⁹⁴ See, Report of Legislative Committee (7 December 1999) 2 (Kuwait).

It is worth making it clear that the text addressed in the GCC Trade Mark Law extended the concept of boycott to include any natural or artificial persons from any nationality, not only Israeli trade marks. In other words, the Law gives the right to the Kuwaiti competent authority to decide not to register any trade mark if it belongs to a country that a competent authority has decided to ban dealing with.

Although this is the general view on Article 3, paragraph 10 of the Kuwaiti Trade Mark Law (GCC), some have tried to justify the legal ban on registering Israeli trade marks in Kuwait as this would be contrary to Kuwaiti public policy. According to Sarkhou, the rules forbidding registration of Israeli trade marks and any other marks with a connection to Israel form part of Kuwaiti public policy.¹⁰⁹⁵ This view holds that even if the text that boycotts Israel does not exist in the Law, these marks would still be forbidden in Kuwait as it is contrary to public policy. He adds that this is a natural result of the state of relations between Israel and Arab nations, including Kuwait, because of the Israeli occupation of Palestine.¹⁰⁹⁶ If this justification is accepted, then Article 6 quinquies (B) of the Paris Convention can be applied. In this case, Kuwait would not be in breach of any of the provisions of TRIPS (or Paris Convention Article 2), and in particular Article 3: the 'National Treatment' principle, as Israeli trade marks would be contrary to Kuwaiti public policy.

However, from my point of view this argument does not comply with the substantive provisions of TRIPS. It is important to emphasise in this context that the TRIPS Agreement can be seen as a technical agreement relating to the provision of minimum protection for intellectual property rights and is a legal instrument.¹⁰⁹⁷ The TRIPS Agreement philosophy is based on equality between member states in TRIPS which can be seen clearly from Article 3, and hence this text is not subject to political conflicts between member states. Member states are obligated by Article 3 of TRIPS to treat citizens of other member states the same as their own citizens. In addition, the provisions in Article 4 of TRIPS (most favoured nation)¹⁰⁹⁸ enhance this meaning further, and it can be concluded that the exception for refusing registration should only be for certain reasons relating to the trade mark itself and

¹⁰⁹⁵ Yacoub Sarkhou, *Anezam al-Qanouny li al-Alamaat Attijariyyah: Dirasah Muqaranah* (That Alsasil 1993) 89.

¹⁰⁹⁶ *ibid* 89.

¹⁰⁹⁷ See the TRIPS Preamble: 'Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights'.

¹⁰⁹⁸ TRIPS, art 4: 'With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members.'

this exception should not be made a general one. Moreover, Sarkhou did not justify how the registration of the Israeli trade mark would affect the public policy in Kuwait. It is of note that the TRIPS Agreement does not oblige Kuwait to allow Israeli products into the Kuwaiti market. In summary, it can be stated that Article 3, paragraph 10 of the Kuwaiti Trade Mark Law is in conflict with TRIPS provisions (and also the Paris Convention Article 2). Therefore, in order to fulfil the TRIPS requirements, the Kuwaiti National Assembly should delete/amend this paragraph to allow the Israeli trade mark to be registered as the Kuwaiti government suggested. Note that Article 3, paragraph 10 (and other relevant laws¹⁰⁹⁹) relate to Israeli trade marks and it is to do with the Israeli nationality and not the Jewish religion. For example, if a British Jewish trader wants to register his trade mark in Kuwait, then that would be acceptable. In contrast, the Kuwaiti authorities would reject registration of a trade mark from a Muslim Israeli trader.

In respect to the Shariah viewpoint regarding this matter, as mentioned before, in Islamic Shariah everything is permissible except what is proven by text to be impermissible.¹¹⁰⁰ Doing business with a non-Muslim is permissible in Shariah and there is much evidence to show that the Prophet (PBUH) entered into many commercial dealings with non-Muslims as have generations of Muslims ever since.¹¹⁰¹ It is worth mentioning that Muslim merchants played an important role in the spread of Islam amongst the different nations.¹¹⁰² This shows that doing business with non-Muslims was always permitted in Islam and the Israelis/Jews were not an exception to this.

However, Islamic Shariah acknowledges the idea of economic boycott, something which has its roots in Islamic history.¹¹⁰³ Therefore, it can be seen that even the national treatment provision set out by TRIPS in Article 3 is one of the mandatory provision, and all member states of TRIPS must adhere to it. Yet, this provision may be seen as a real dilemma for the Islamic countries that strictly follow the Islamic approach. To make it clear, Islamic

¹⁰⁹⁹ See, for example, Decree No 21 of 1964 regarding the Unified Law of Boycott of Israel and Ministerial Decree No 130 of 1957 regarding Boycott of Israeli Goods.

¹¹⁰⁰ See Chapter Four, 4.0.

¹¹⁰¹ For example, as narrated by Aisha: 'The Prophet (PBUH) died while his armor was mortgaged to a Jew for thirty Sa's of barley'. Muhammad Bukhari, *Sahih Bukhari*, vol 5 (Muhammad Khan (tr), Darussalam 1997) Hadith No 4467, 452.

¹¹⁰² Abdullah Bazinh, *Intishar al-Islam fi Afriqyya Janoub Al-Sahra'a* (7th October University Misurata 2010) 111.

¹¹⁰³ For example, the Prophet's (PBUH) companion Thumam, after becoming a Muslim, said to the Mecca infidels: 'No, by Allah! Not a single grain of wheat will come to you from Yamama unless the Prophet (PBUH) gives his permission'. Muhammad Bukhari, *Sahih Bukhari*, vol 5 (Muhammad Khan (tr), Darussalam 1997) Hadith no 4372, 401. The Prophet (PBUH) did not deny this act by Thumam, thus it became as a Sunnah '*al-Sunnah al-Taqririyah*'.

Shariah does not fully accept this ‘national treatment’ provision without any exceptions. As discussed in Chapter Six, public interests are associated with the five necessity objectives of Shariah: religion, life, mind, lineage and property. Any violation of these is considered *mafsadah* (evil).¹¹⁰⁴ Therefore, if any provision in TRIPS forces Muslim countries to do any deed that may cause harm to the Islamic legal objectives ‘*al-Masaleh al-Shareia*’, then this provision becomes illegal and Muslims under the sacred obligation should not obey it.¹¹⁰⁵ This issue in its general context was discussed in detail by Imam Ibn al-Qayyim and through this explanation the perspective of Muslim scholars regarding the national treatment can be understood.¹¹⁰⁶ Ibn al-Qayyim explained that dealing with non-Muslims is permissible, and it is a permissible means to achieve benefit. However, this means is forbidden if it causes more harm than benefit. The TRIPS Agreement is permissible in principle but, in general, Muslim scholars believe that dealing with Israel will benefit their economy. Since Israel is occupying a Muslim country, this dealing is prohibited because it leads to harming the Muslim efforts to liberate Palestine.

Muslims believe that Palestine (a holy land which includes the Al-Aqsa Mosque¹¹⁰⁷) is being occupied by Israel. In order to help the Muslims fight for their rights in Palestine and harm Israelis economically, a great number of Islamic organizations and contemporary scholars have issued *fatwas* to boycott Israel in all fields, especially economically against both the state and individuals. The clearest and most important example of this is the position taken by the OIC,¹¹⁰⁸ the largest and most important international Islamic organization. The OIC has encouraged member states, including Kuwait, to boycott Israeli products and companies in all fields.¹¹⁰⁹ In addition, the European Council for Fatwa and Research has also issued a *fatwa* to boycott Israel and prevent all kinds of interactions with it.¹¹¹⁰ Moreover, very well-known modern Muslim scholars, such as al-Qaradawi, Jad Al-Haq (formerly the Grand Imam of Al-Azhar), Muhammad Tantawy (Imam of Al-Azhar), Nasr

¹¹⁰⁴ See Chapter Six, 6.2.

¹¹⁰⁵ See Chapter Six, 6.2.

¹¹⁰⁶ Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al -Jawziyy 2002) 554.

¹¹⁰⁷ Al-Aqsa Mosque was the first Qiblah of the Muslims. Qiblah means direction Muslims put their faces and bodies forward when performing prayers. In Surah Al-Isra 17, verse 1, God says: ‘Exalted is He who took His Servant by night from al-Masjid al-Haram to al-Masjid al-Aqsa, whose surroundings We have blessed’.

¹¹⁰⁸ The Organisation of Islamic Cooperation (OIC) (formerly the Organisation of the Islamic Conference) presents itself as the second largest inter-governmental organisation after the United Nations which has a membership of 57 states spread over four continents. See OIC, ‘About OIC’ <http://www.oic-oci.org/oicv3/page/?p_id=52&p_ref=26&lan=en> accessed 11 December 2014.

¹¹⁰⁹ See, for example, the Report of the Annual Coordination Meeting of Ministers of Foreign Affairs of the OIC Member States (New York, 28 September 2012) art 9.

¹¹¹⁰ The European Council for Fatwa <<http://e-cfr.org/new/>> accessed 5 February 2016.

Wasel, Shahatah and many others, have issued *fatwas* calling for the boycott of the Israeli economy based on similar reasons. They stated that the economic boycott is a kind of *jihad* (holy fighting in the cause of *Allah*) and Muslims should boycott Israel in all aspects which includes commercial transactions. According to these scholars, this boycott is a religious obligation and represents compulsory obedience to God.¹¹¹¹

In this context, as argued by the vast majority of scholars, determining the *maslahah* (interests) or *mafsadah* (evil) of an act is not only based upon the nature of the act but its outcome as well as what the act leads to,¹¹¹² ie taking into account the advantages and disadvantages of the boycott. Therefore, in order to decide whether dealing with Israelis is contrary to Islamic public policy and morality, the Muslim legislature must take into consideration the results of that on the country's interests. Therefore, some *fatwas* issued for the boycott of Israeli products, for example, by Imam Abdul Aziz bin Baz who was the head mufti in Saudi Arabia, are left for each state to decide whether to enforce them according to their interests.¹¹¹³ For instance, they believe it is not appropriate to issue public *fatwas* for all Muslims in this topic because of the different conditions (such as economic status) of each Muslim country.¹¹¹⁴ This approach is in line with the concept of the legislative flexibility of Islamic Shariah.¹¹¹⁵

In addition, according to such scholars al-Qaradawi and Shahatah,¹¹¹⁶ this boycott is considered as 'economic *jihad*' if it is done for the sake of God. In Surah Al-Tawbah 21, verse 41, God says: 'But the messenger and those who believe with him strive with their wealth and their lives. Such are they for whom are the good things. Such are they who are the successful'. Also, in verse 88, God says: 'Go forth, light-armed and heavy-armed, and

¹¹¹¹ Many well-known Muslim scholars have issued *fatwas* on boycotting the Israeli economy. For more about these fatwas see, Husin Shahatah, *Al-Muqata'ah Iqtisadiyah wa Thalekah Ada'af al-Iman* (Almaktaba al-Kubra alislamia 2006) 17; Yusuf Qaradawi, 'Al-Qaradawi Yad'ou lil-Jihad bi-Kuli Anwa'eh wa Qat'a Al-Elakat Ma'a Isra'eel' <<http://www.qaradawi.net/new/Articles-33>> accessed 4 February 2016; see also, Jean Usunier and Julie Lee, *Marketing Across Cultures* (5th edn, Pearson Education 2009) 250, 251.

¹¹¹² See, Ibrahim Shatibi, *Muwafaqat fi Ushul al-Shariah*, vol 2 (Al-Maktaba al-Kobra 1975) 257; Abdullah al-Otaibi, *Annizam al-Aam fi Dawlah al-Muslimah* (Dar-Kenouz Eshbilia 2008) 97.

¹¹¹³ See Abdul Rahman al-Sudais, 'Al-Imam Abdul Aziz Bin Baz wa Usoul Manhajihi fi al-Fatwa' (2007) 81 Majallat Al-bohouth al-Islamiyyah 237, 281.

¹¹¹⁴ See Anas Yunus and others, 'An Analysis of Fiqh al-Waqi (An Understanding of Contemporary Problems) on the Ruling of Compulsory Boycott of KFC (Malaysia)' (2013) 3 International Journal of Humanities and Social Science 194, 196.

¹¹¹⁵ See Chapter Three, 3.3. See also, Ibn Qayyim al-Jawziyyah, *Ilam al-Muwaqqin an Rabb al-Alamin*, vol 4 (Dar ibn al-Jawziyy 2002) 337.

¹¹¹⁶ Husin Shahatah, *Al-Muqata'ah Iqtisadiyah wa Thalekah Ada'af al-Iman* (Almaktaba al-Kubra alislamia 2006) 15; Yusuf Qaradawi, 'Al-Qaradawi Yad'ou lil-Jihad bi-Kuli Anwa'eh wa Qat'a Al-Elakat Ma'a Isra'eel' <<http://www.qaradawi.net/new/Articles-33>> accessed 4 February 2016; See also, Jean Usunier and Julie Lee, *Marketing Across Cultures* (5th edn, Pearson Education 2009) 250, 251.

strive with your wealth and your lives in the way of Allah! That is best for you if ye but knew.’

All of the above suggests that a boycott is a matter of a religious nature associated with the Islamic objectives ‘*al-Masaleh al-Shareia*’. This is consistent with what was explained in Chapter Three that Islamic Shariah is a comprehensive system that touches upon all aspects of life.¹¹¹⁷ In addition, it is important to understand that an economic boycott should be targeted towards all countries that harm Islam and its five necessity objectives, and it is not just limited to Israel. For example, in 2014 Saudi Arabia considered a trade boycott of the Netherlands after a Dutch politician from the far-right printed stickers that displayed anti-Islam slogans in the colours of the Saudi flag.¹¹¹⁸ Also, for similar reasons and on many occasions a number of *fatwas* have been issued calling for an economic boycott of different countries such as Denmark and the United States.¹¹¹⁹ These examples suggest that the idea of ‘national treatment’ in its absolute sense and without exception is not in line with the Islamic concepts of the *maslahah* and *mafsadah*.

As described on the previous page, TRIPS provisions are mandatory, not optional, for the countries signed up to the WTO Agreement. The Lalive Report points this out clearly by stating: ‘complying with TRIPS is not a matter of policy choice for individual WTO Member States but rather a matter of complying with an existing legal duty’.¹¹²⁰ Therefore, it seems that there is no acceptable legal justification to avoid the application of the main principle which TRIPS has emphasised twice: directly in Article 3 and indirectly as incorporated into the TRIPS Agreement via TRIPS Article 2. The latter requires members of the WTO to comply with this and other relevant provisions of the Paris Convention. Merchant agrees with this opinion which suggests that Arab states’ boycott of Israel makes them refuse to register the Israeli trade mark, whether owned by an Israeli, an individual or a corporate body, and the reason behind this is the conflict with the national treatment principle. He states that: ‘However, notwithstanding their accession to the Convention these

¹¹¹⁷ See Chapter Three, 3.1.

¹¹¹⁸ Raissa Kasolowsky, ‘Netherlands: Saudi Arabia may curb trade ties over Wilders' anti-Islam slogans’ (*Reuters*, 17 May 2014) <<http://www.reuters.com/article/us-netherlands-saudi-wilders-idUSBREA4G05420140517>> accessed 8 February 2016.

¹¹¹⁹ Yusuf Qaradawi, ‘Qaradawi Al-Qaradawi Yad’ou lil-Jihad bi-Kuli Anwa’eh wa Qat’a Al-Elakat Ma’a Isra’eel’ <<http://www.qaradawi.net/new/Articles-33>> accessed 4 February 2016. See, in general, Muhammad Albayati and others, ‘Participate in Boycott Activities Toward Danish Products from the Perspective of Muslim Consumer’ (2012) *June American Journal of Economics* 120.

¹¹²⁰ See also, Memorandum from Lalive to Philip Morris International Management SA, ‘Why Plain Packaging is in Violation of WTO Members’ International Obligations under TRIPS and the Paris Convention’ (23 July 2009) (Lalive Report) 5, para 13.

“boycotting” countries continue to apply their boycotts, and in doing so they violate Article 2(1) of the Convention’.¹¹²¹

Yet, Muslim members of the WTO that boycott Israel would most likely not be in conflict with TRIPS requirements if they invoked the Article XIII set out in the WTO Agreement, known as the ‘non-application’ or ‘opt-out’ clause.¹¹²² This article permits the non-application of WTO rules in relation to specific members – even if both countries are members of the WTO and have no obligations between them. Kontorovich states that: ‘indeed, the no application clause was created to allow pairs of nations that do not recognize each other to join the agreement and thus at least secure free trade benefits in their relations with all other nations’.¹¹²³

However, the non-application clause cannot be invoked at any time; it can only be done at the time when the member joins the WTO.¹¹²⁴ It is surprising, therefore, that up to the present none of the Muslim countries that are WTO members which boycott Israel has invoked the right of non-application. This was the case, for example, with the accessions of Saudi Arabia in 2005 and Yemen in 2014.¹¹²⁵ To conclude, although the WTO agreement allows the Islamic boycott of Israel within the non-application clause set out in Article XIII, no Islamic country has ever invoked it. Therefore, the current trade mark rules that ban the registration of Israeli trade marks violate the national treatment provision set out in the TRIPS.

In brief, from an Islamic Shariah perspective, the effect of product origin and trade mark nationality on trade mark registration is subject to the discretion of the competent authorities, which must consider the results as well as the advantages and disadvantages of their decision on the five necessary Shariah objectives. However, as mentioned above, equality between member states set out in Article 3 of TRIPS (also in Article 2 of Paris) is a

¹¹²¹ D Marchant, ‘The Trademark Forum the Paris Union-Decline and Fall?’ (1978) 268 Trademark Report 206, 207.

¹¹²² Marrakesh Agreement Establishing the World Trade Organization, art XIII: Non-Application of Multilateral Trade Agreements between Particular Members

1. This Agreement and the Multilateral Trade Agreements in Annexes 1 and 2 shall not apply as between any Member and any other Member if either of the Members, at the time either becomes a Member, does not consent to such application.

¹¹²³ Eugene Kontorovich, ‘The Arab League Boycott and WTO Accession: Can Foreign Policy Excuse Discriminatory Sanctions?’ (2003) 4 Chicago Journal of International Law 283, 293.

¹¹²⁴ Art XIII, ‘para 1 shall apply between a Member and another Member which has acceded under Article XII only if the Member not consenting to the application has so notified the Ministerial Conference before the approval of the agreement on the terms of accession by the Ministerial Conference.’

¹¹²⁵ WTO Analytical Index: Marrakesh Agreement Marrakech Agreement Establishing the World Trade Organization <wto.org/english/res_e/booksp_e/analytic_index_e/wto_agree_04_e.htm> accessed 8February 2016.

basic rule of the agreement. As such, it may not be acceptable under this article, from an international law perspective, to breach this provision on the grounds of the nation's public policy principles.¹¹²⁶

8.5 Conclusion

The purpose of this chapter has been to analyse the extent to which Islamic countries comply with or deviate from trade mark provisions in both Shariah and TRIPS, and to propose compromise solutions between the international obligations of Islamic countries under TRIPS and their Islamic public policy and morality principles.

It can be seen from the preceding analysis that the Islamic Shariah rules do not present any obstacles to Islamic members fulfilling the standards of trade mark protection requirement in TRIPS whether civil or criminal. In fact, Shariah protects property, and those who violate others' property rights (including trade marks) may be punished in the afterlife on the Day of Resurrection. In addition, the level of protection for the unregistered trade mark is similar to the registered ones and this in fact ensures a higher protection than the TRIPS requirements of trade mark protection.

In this chapter, it has been emphasised that the necessary five Shariah objectives are not on the same level, with religion coming first followed in descending order by life, mind, lineage and property. This means that even if the mark is considered as property in Shariah, it will not be considered as such if it is in conflict with or leads to a conflict with other Islamic objectives. Accordingly, this chapter has proved that a trade mark registration should be refused if the nature of the product the mark was going to be (or already is) affixed to is in conflict with Islamic public policy and morality, even if the trade mark itself is acceptable. The Kuwaiti trade mark is compatible with this trend. However, this practice in Kuwait is contrary to TRIPS. Hence, the thesis has suggested legal amendments that would enable Kuwait (and the other Islamic countries which adopted a similar approach) to meet the international obligations as well as to keep in line with Islamic public policy and morality principles. In addition, the Kuwaiti law has not permitted the registration of any trade mark that is identical or similar to an Israeli mark, symbol or motto. This is considered a breach of the TRIPS provisions and could lead to international liability on Kuwait. In this context, a *fatwa* was issued that has called for the boycott of Israeli products. Yet, this *fatwa* has

¹¹²⁶ See D Marchant, 'The Trademark Forum the Paris Union-Dilemma and Fall?' (1978) 268 Trademark Report 206, 207.

given each state the freedom to decide their course of action according to each state's interest. Accordingly, the chapter has suggested that the Kuwaiti authority (and other Islamic countries) needs to amend its legislation and allow the registration of Israeli trade marks in Kuwait in order to avoid international liability.

Chapter Nine

Conclusion and Future Work

Islam is one of the main faiths in the world. It is a holistic religion that governs all aspects of life. Many countries are heavily influenced by Shariah law sources and objectives. Shariah law is based on a number of sources, with the Holy Quran and the Sunnah of the Prophet (PBUH) the most important ones. The Islamic legal system combines both stability and flexibility. This poses challenges and opportunities for the future of trade mark law and the use of public policy and morality in international trade. The challenges arise from the strong Shariah resistance to legal rules that are in conflict with the main Islamic objectives, which may be difficult to reconcile with acceptable limits in the Western approach to trade mark protection and the impact of public policy and morality. The opportunities arise because of Islam's flexibility and openness to different social, cultural and religious backgrounds, and to all aspects including commercial transactions, without jeopardising Islamic objectives and core principles.

Nowadays, trade marks are an essential element in modern economic life due to their critical importance to traders and consumers. Therefore, it is inevitable that trade mark law will need to be considered, including the role played by public policy and morality in recognising trade marks. This is because of their importance in international trade and in particular due to the wide membership of TRIPS. The TRIPS Agreement in this context is the cornerstone of the international legal system which governs trade marks. This agreement has a strong influence on the majority of countries including Muslim countries, especially in the scope of trade mark registration. Public policy and morality principles, according to TRIPS, are one of the main explicit exceptions that need to be considered in the case of trade mark registration. Therefore, this thesis has sought to look at the impact of Islamic Shariah public policy and morality on trade mark registration and protection within the framework of TRIPS provisions at both the theoretical and practical levels. In addition, this thesis has investigated the possible tensions between Islamic Shariah and TRIPS provisions and the ways to overcome these tensions. Furthermore, this thesis has sought to come up with the 'true' meaning of Islamic public policy and morality in light of the *masalah* (objectives) of Islamic Shariah.

9.1 The main findings of this thesis

9.1.1 Islamic Shariah and intellectual property rights

There is a general consensus amongst Muslim scholars that the legal term ‘intellectual property right’ is a new subject matter for Islamic jurisprudence. The reason this term was absent from Islamic jurisprudence is due to the fact that ‘intellectual rights’ took a substantially different form in the early centuries of Islam compared to recent times.

The in-depth analysis of the literature relating to the concept of ‘intellectual property rights’ in Islam has indicated that there are no direct laws or texts in both the Holy Quran or Sunnah that regulate these types of rights in Islamic jurisprudence. Interest in this topic began to grow in the late 20th century when many Islamic studies and publications started to tackle and address issues relating to it. This emerging literature was used in Chapter Three of this thesis to analyse the essential components of the ‘intellectual property’ concept and the Islamic Shariah position on the theory of intellectual property. According to this, the findings of this research support and develop the results found in previous academic works on intellectual property, especially how Islamic Shariah fully accepts ownership over ideas and emphasises the importance of protecting them. Within this context, it is important to highlight a number of issues.

First, the concept of ‘ownership’ in Islam has a special meaning as the owner of all property is God. All property belongs to him as the creator of all things, which means he is the only who can inherit his own creations. Hence, individuals have limited ownership qualities and they are not entitled to full personal ownership since their actions are subject to the rules and laws of God. This understanding of ownership in Islam justifies all the rules that regulate trade marks in Islamic Shariah. In addition, as the trade mark owner is an agent for managing God’s property, he has a sacred obligation to follow God’s provisions in this matter.

Second, there are two separate opinions amongst Muslim scholars regarding ownership. The Hanafis on the one hand regard ownership as being over tangible physical materials and objects. According to this opinion, ownership over ideas, as in the case of intellectual property, is not possible. The majority of Muslim scholars, in contrast, are against this notion. They accept intellectual property ownership as long as it does not contradict with the general public interest and if it does then the general public interest has priority over personal ownership. Therefore, although Islamic Shariah recognises personal ownership, it still regulates it through making it conditional to serving the general public

interest, which is associated with Islamic Shariah principles. This highlights the consensus amongst scholars that trade marks contrary to the public interest or Islamic Shariah rules in general will not be considered as property. Therefore, the trade mark becomes ineligible for registration or protection and its owner will not be entitled to any rights.

9.1.2 Trade mark forms and protection under Islamic Shariah

The term ‘trade mark’ in its current definition, as in the case of ‘intellectual property’, is a relatively new subject in Islamic Shariah as discussed in Chapter Three. In order to provide a comprehensive understanding of the Islamic Shariah position on trade marks, Chapter Four has answered the first key research question through discussing the position of Islamic Shariah from the various forms of trade marks by taking into account the TRIPS definition of trade mark. Accordingly, this thesis has, it is believed for the first time, evaluated the trade mark forms set out in TRIPS according to Islamic Shariah rules.

The discussion in Chapter Four established the following. First, trade marks can take the form of a word or words if certain criteria are followed. According to the modern interpretation of Islamic Shariah, the first criterion is that a word or words used in trade mark should not imply any negative or bad meaning. The second criterion is that it is better if the word used in the suggested trade mark is in the Arabic language. This is for religious considerations rather than ethnic ones. When Arabic is not used in the country where the trade mark is to be registered, then it is proposed that both Arabic and the local language are used in this trade mark. However, there is no evidence in Islamic Shariah that suggests an obstacle to use just the non-Arabic words as trade marks.

Second, the research has concluded that three types of names are prohibited from being used as trade marks. The first is the ninety-nine names of God. The research has indicated that there is a strong general consensus amongst all Muslim scholars that the use of these names is considered as an insult to the holy names. At the same time, it is permissible to use some of God’s names in a very specific way where the use of these names has a general meaning that in no way could refer to God. The second is the use of names of other religions or civilisations or even some personal names that have the name of God as part of the name. The third prohibited category of names are names of Muslim holy places. The ban relates to fears about abusing such names in commercial activities, especially those names that have religious overtones that might have an influence on the hearts of Muslims.

Third, the discussion has shown that there is significant disagreement between Muslim scholars regarding the use of pictures and statues as trade marks. A thorough analysis of the different views offered by scholars has shown that the majority of scholars are likely to accept this use as long as it abides by Islamic Shariah rules.

Fourth, the broad definition of trade marks in TRIPS as discussed in Chapter Two has led to the emergence of non-traditional signs as trade marks. These trade marks include a) sound marks which the Islamic Shariah rules permit under the condition they abide by Islamic teachings; and b) taste trade marks which are allowed with the exception of using these trade marks with food or drink prohibited in Islam such as alcohol.

Fifth, it has been illustrated also that Islamic Shariah respects the integrity of a trade mark and thus safeguards it through criminal and civil laws. It was shown that Islamic Shariah perceives a trade mark as a property right whose violation is punishable. Yet, it has also been shown that this type of violation of right is not equal to stealing a tangible object that can be taken and hidden somewhere. Thus, prescribed Islamic Shariah rules that apply to this context '*al-Hudood*' cannot be applied (ie amputation of the hand). Instead, in the case of trade marks, it was indicated that discretionary punishment, '*Tazeer*', applies. These kinds of punishment vary according to the size or the level of damage caused, and they require those who violate these rights to compensate for the cost of damage created. The finding described above is very important as it determines the types of Shariah punishment in case of the violation of the rights associated with trade marks. In addition, it clarifies that although Islamic Shariah considers trade mark as a property, it does not apply the rules of theft on trade mark infringement.

9.1.3 The concept and the application of public policy and morality relating to trade mark

The findings of chapters Five, Six and Seven are closely related. These three chapters are designed to follow through on a series of separate but interconnected questions.

In order to answer the second research question on Western public policy and morality principles and their effect on trade mark registration, Chapter Five establishes that the terms public policy and morality in Western legal systems are not identical although they do overlap. The term 'public policy' refers to national goals and overall societal benefits. However, the term 'public morality' is non-governmental and derived from society's view of what is considered to be morally acceptable or unacceptable, and it aims to protect the

higher values of society in general. There is no difference between TRIPS and the Western legal system regarding the concepts of public policy and morality. Accordingly, the application of the principles of public policy and morality as part of trade mark registration in the Western legal system is in harmony with TRIPS provisions.

In the majority of Western countries, the marks that are considered contrary to public policy and/or morality can be classified under four main headings:

- (a) sexual and vulgar marks. This type of mark is associated with sexual or vulgar themes which have an unacceptable level of sexual or vulgar meaning delivered by the mark and its effect on the public.
- (b) religious terms and symbols; marks comprising a religious symbol or name that can be a debatable question between Western legal systems. In general, it can be said that within the EU and the US, using religious names or symbols as trade marks is not strictly banned but it depends on the products associated with the mark.
- (c) racial slurs and epithets; using racial slurs, insults or epithets against any group in society as a trade mark is considered to be in conflict with public policy and morality principles.
- (d) illegal content: marks that promote or encourage illegal activity are considered offensive under public policy and morality principles and are therefore ineligible for registration due to the negative impact they can have on public security.

However, determining whether the mark is offensive is based on the viewpoint of the group that it refers to rather than the whole society.

Chapter Six established that God's rights are present in the general scope of Islamic public policy and morality. Also, Islamic public morals are part of public policy so what contradicts with public morals consequently contradicts with public policy. It was also established that '*maslahah*' is a cornerstone in the Islamic legislations as it symbolises the very purpose of having Islamic Shariah objectives, '*Maqasid al-Shariah*'. The objectives of Shariah are to protect the five necessary values, namely religion, life, mind, lineage and property. These values are not all at the same level, the most essential among them is the religion's *maslahah* as it relates to the religion's beliefs and practices. These five are key to ensuring the wider public interest of the entire nation, '*Maslahatu al-Umaah*'. The finding of this chapter answers one of main question of this research relating to the concepts of Islamic public policy and morality principles and their effect on trade mark recognition.

This thesis has illustrated the solid relationship between the Islamic public policy and morality principles and the *al-Maslahah* theory as it clarifies that these principles are

the main boundaries to safeguarding the five main objectives: religion, life, mind, lineage and property. It is clear that commitment to the ideals of Islamic public policy and morality leads to achieving *maslahah* and vice versa. In addition, the three types of *masalah*, necessity '*daruriyat*', needs '*hajiyyat*' and embellishments '*tahsinyat*', are linked to Islamic public policy and morality only if they serve the society's public interest, '*Maslahah Ammah*'.¹¹²⁷ In Islamic Shariah, there is an overlap between the terms public policy and public morality. In addition, this chapter has demonstrated that Islamic Shariah is an integral element in the Kuwaiti public policy and morality system.

Based on this relationship, this thesis has applied, for the first time, the *al-Maslahah* theory as a guideline to determine whether or not trade marks are in line with Islamic public policy and morality. This was done through an analysis of case law, legislations and *fatwas* to provide a deeper understanding of the relationship between the *al-Maslahah* theory, Islamic public policy and morality, and trade mark.¹¹²⁸

The key findings are summarised here. It has been shown that protecting or preserving religion is the highest *maslahah*. It is an absolute requirement and there is a consensus about this point among all Muslim scholars. Hence, the assessment as to whether a trade mark is compatible with Islamic public policy and morality is based upon the respect it demonstrates to the Islamic faith and its rituals as they are the cornerstone of the Islamic religion. In other words, in order to recognise the mark, it should not disrespect any of the Islamic elements that make up the Islamic faith and rituals. Otherwise, it will be considered a violation of Islamic public policy and morality. In the context of Kuwait, applications to register trade marks that disparage Islam or any other religions will be refused as these marks are contrary to trade mark law which bans registration of any trade mark that consists of religious symbols and it considers such trade marks to be in conflict with principles of public policy and morality.

The basis of *maslahah*, which protects or preserves life, is the preservation of human life in general regardless of the religion, nationality or social status of the individual. This *maslahah* comes second in terms of the objectives of Shariah and trumps the other three elements: mind, lineage and property. Therefore, a trade mark is seen to be in conflict with Islamic public policy and morality and is prohibited under Shariah if it consists of, promotes or encourages elements that harm human life whether by the trade mark form or the goods

¹¹²⁷ See Chapter Six, 6.2.

¹¹²⁸ See Chapter Six, 6.4.

it is affixed to. Consequently, it has been found that, for example, tobacco trade marks are in conflict with Islamic public policy and morality.¹¹²⁹ This also applies to marks that consist of names or symbols associated with terrorist organizations. In addition, Islam does not limit this *maslahah* to physical assault but includes moral outrage to human dignity. Hence, Islamic public policy and morality prevent marks that consist of insults, racial slurs and epithets. The Kuwaiti Court has considered racial, ethnic or gender disparagement as illegal elements that breach public policy and morality. Hence, any marks that consist of these elements will be refused according to public policy and morality.

The rules of Islamic Shariah have prohibited everything that makes the mind absent or affect people's perceptions. Therefore, according to the modern interpretation of Shariah, a trade mark involving or presenting materials that have a negative influence on the human mind is considered to be contrary to Islamic public policy and morality; this means that alcohol and illegal drugs violate the goal of Islamic Shariah which preserves the mind, '*hifz al-aql*'. The Criminal Code in Kuwait therefore strictly bans alcohol.

The *maslahah* which protects or preserves lineage is related to two areas: the importance of reproduction and the continuation of the human race. Therefore, it is quite clear from the Shariah rules that Islam encourages having offspring and building a family. At the same time, it strictly forbids adultery of any kind as it may cause the mixing of lineages, as well as any sexual acts that are inconsistent with the provisions of Islamic Shariah such as homosexuality and lesbianism. Consequently, any trade mark that encourages permanent childlessness, consists of sexual elements or is affixed to sexual products would be in conflict with Islamic public policy and morality. In this context, the Kuwaiti courts reject the registration of a trade mark that has sexual meaning.

The *maslahah* which protects or preserves property, '*hifz al-mal*', is the least important of the five necessary objectives of Shariah. Any of the other four *masalah* can take precedence over this one. Therefore, as illustrated in Chapter Three, a trade mark is considered as *mal* and must be protected. However, trade marks will be considered as *mafsadah* (evil) if they are in conflict with any of the other *masalah* (interests) as the interests are in the protection of property '*hifz al-mal*'. As such, if a trade mark relates to a forbidden financial activity, it will be considered to be in conflict with Islamic public policy and morality.

¹¹²⁹ It is noted that tobacco trademarks prevalent in Islamic countries therefore it can be said this the Islamic rules of ban the tobacco trademarks are not practically implemented.

After identifying the Western and Islamic public policy and morality principles and their effect on trade mark recognition, the discussion in Chapter Seven went on to answer the research question about the major differences and similarities between Western and Islamic public policy and morality in relation to trade mark registration and protection. Based on my review of the existing literature, this is the first time that a comparative analysis has been conducted of the principles and practices and the use of the principles of public policy and morality as grounds to ban trade mark registration in both systems. Although it is clear that both systems share nearly the same categories of offensive marks, there are still some points of difference between them, which will be summarized below.

In Islamic Shariah, public morality comes under the umbrella of public policy and cannot be separated from it, while in the Western system each of these refers to a different concept. This overlap between public policy and public morality is obvious when it comes to the adoption of Islamic Shariah in the Kuwaiti jurisprudence and judiciary. The Islamic public policy and morality principles serve both the secular and the divine (worldly and hereafter) interests of society and individuals yet the divine interests are always prioritised in case a conflict between the two interests arises. This is unlike how Western laws prioritise worldly life interests.

In general, the Islamic public policy and morality standards of judgement on trade mark are mostly rigid as they are derived from fixed divine legislation. In contrast, Western public policy and morality standards are changeable according to time, place and circumstances. Therefore, unlike the Western system, the offensive trade mark in Shariah often remains forbidden in spite of changes in time or place. In Islamic Shariah, any trade marks that conflict with safeguarding any of the previously mentioned five objectives are strongly prohibited and are perceived as '*mafsadah*' (evil) regardless of what the society would think about these trade marks. These trade marks will be seen as contradicting Islamic public policy and morality. Contrary to this, the society's and/or the government's point of view is very essential when deciding elements of public policy and morality in the Western legal system and these elements are due to change according to the changing interests of the society or government policies.

Although Islamic and Western public policy and morality principles share common features, these are of varying degrees. The ones of most importance can be divided into two key categories. The first is the different meanings of the key concepts in the two systems. Although there are many common terms to describe the offensive marks, the concepts of these terms are not identical. The second is that in the majority of cases under the Islamic

system, the different kinds of consumers are not taken into consideration when deciding whether to register a trade mark or not. This is different in the Western system which considers the target customer of the products as one of the main elements in evaluating the mark. In the Western system, even if the registration of a trade mark is rejected or cancelled on the grounds of public policy and/or morality, the owner can still use the mark in the course of business as registration is not a requirement for use. In addition, the owner still has the right in the mark according to common law. However, the situation is radically different under the Islamic system; banning or cancelling an offensive trade mark registration leads to a ban on its use and the trade mark owner will not have any rights for or protection on his trade mark as it is not considered *mal*. This issue has been illustrated in the discussion in Chapter Four.

9.1.4 TRIPS and Islamic Shariah: harmony or dissonance

Having established the similarities and differences between Shariah and Western approaches to trade marks, Chapter Eight provided a more specific analysis of the public policy and morality provisions. These provisions are generally informed by Western concepts of public policy and morality but in a form that is legally binding to countries that apply Islamic Shariah and that have become members of TRIPS, including Kuwait. Chapter Eight goes further in investigating the level of harmony between Islamic public policy and morality principles and TRIPS through analysing Islamic countries' practices under the TRIPS regime. The research has found that it is understood that Muslim countries that joined the TRIPS Agreement have recognised a trade mark as *mal*. Hence, it can be concluded that the TRIPS provisions, in principle, are compatible with Islamic Shariah whose provisions support one of the legitimate interests in Islam: *Maslahah* the protection of property '*hifz al-Mal*'. Therefore, Islamic countries have come under a religious obligation to protect trade marks for two reasons: first, TRIPS is an agreement and Muslims are obliged to fulfil the contracts they enter into; second, as Islamic states, they have a religious obligation to protect people's property. This religious dimension has increased their respect in the Islamic world.

In terms of the TRIPS requirement to protect trade marks as illustrated in Chapter Two, it is clear that trade mark laws in Muslim countries indicate that these regulations provide a level of protection for owners of trade marks that meet the required standards of TRIPS. This means that Islamic Shariah provisions do not present any obstacles to Islamic members of TRIPS from fulfilling requirements in the agreement in respect of trade mark

protection. Furthermore, the protection of intellectual property rights including trade mark under Islamic Shariah, which was discussed previously in Chapters Four and Eight,¹¹³⁰ shows a high level of compatibility between the two legal regimes. Chapter Eight shows two important findings in this regard. Firstly, if someone violates another's property rights (including trade marks), they may be punished in the afterlife on the Day of Resurrection. Secondly, Shariah rules relating to trade mark do not discriminate between registered and unregistered trade marks (or between well-known and normal trade marks).

In addition, Chapter Eight aimed to answer the question about the extent to which the approach of Islamic countries to refusing trade mark registration on grounds of public policy and morality comply with the provisions of the TRIPS. It examined the level of compatibility between Islamic public policy and morality principles and TRIPS provisions as guiding frameworks for accepting or refusing trade mark registration. Accordingly, this thesis has suggested, it is believed for the first time, practical solutions to maintain a balance between the international obligations of Islamic countries as member states of TRIPS and Islamic public policy and morality principles.

The findings in this chapter indicate that there are two major potential conflicts relating to the effect of product nature and trade mark nationality on trade mark registration. The first is that the public policy and morality exception in TRIPS, which allows a member state to refuse a trade mark registration on the grounds of public policy or morality, plays a pivotal role in maintaining harmony between Islamic Shariah and TRIPS. However, the provisions set out in Article 7 of the Paris Convention and Article 15(4) of the TRIPS Agreement, which oblige member states to register trade marks regardless of the nature of the products, remain a major problem for Muslim countries. The reason for this is that these provisions are in conflict with Islamic public policy and morality. As a result, Islamic countries that follow Islamic Shariah rules have strictly ignored these provisions and have continued to deny the registration of trade marks linked to forbidden goods and/or services. This means that these Islamic countries are in violation of TRIPS Article 15(4). Therefore, the other WTO members have a right to challenge Islamic members' compliance with the TRIPS Agreement before the WTO Dispute Settlement Body. Accordingly, the thesis has suggested that Muslim countries should amend their trade mark laws in order to allow for

¹¹³⁰ See Chapter Four, 4.4.2. and Chapter Eight, 8.2.

the registration of trade mark regardless of the products they are associated with, in so doing avoiding their international liabilities.¹¹³¹

The national treatment obligation, set out in TRIPS Article 3, is considered to be another problem that negatively affects the compatibility of Islamic Shariah and TRIPS. It is not acceptable according to Islamic public policy and morality to adopt the ‘national treatment’ principle absolutely and without any exceptions, as in the case of boycotting Israel which has led to rejecting Israeli trade mark registration in some Muslim countries. This boycott can be explained as a matter of a religious nature associated with the Islamic objectives, ‘*al-Masaleh al-Shareia*’. Therefore, Muslim members rejecting such registrations are violating Article 3 as Israel is a member of TRIPS. However, Muslim countries could boycott Israel without being in conflict with Article 3 if they were to invoke the right of non-application set out in Article XIII of the WTO. This exception allows the non-application of WTO rules (including TRIPS provisions) in relation to specific members. Nevertheless, for some unknown reason, none of these countries have invoked the right of non-application and/or have had the chance to benefit from this exception.¹¹³²

9.2 Recommendations and further works

It can be said that, in general, Islamic Shariah rules present some major obstacles to Islamic member countries complying with the requirements of the TRIPS Agreement. There are two significant problems that face Islamic countries in TRIPS: (a) the provisions set out in Article 7 of the Paris Convention and Article 15(4) of the TRIPS Agreement, which limit the Islamic countries’ right to reject the registration of a trade mark as an obligation to register trade marks even if these marks are associated with forbidden goods or services; (b) the obligation of ‘national treatment’ set out in Article 3 of TRIPS to treat citizens of other member states the same as their own citizens.

Therefore, this thesis has adopted the following recommendations and suggestions that relate to improving the relationship between TRIPS regulations and the Islamic regime in respect to trade mark registration and protection.

¹¹³¹ See Chapter Eight, 8.3.

¹¹³² See Chapter Eight, 8.4.

9.2.1 Recommendations and suggestions for legislators

In order to meet their international obligations, Muslim countries are required to amend their national laws to be consistent with TRIPS in relation to rejecting a trade mark registration based on the nature of the products as reflected in Article 15, paragraph 4 of the TRIPS Agreement as well as Article 7 of the Paris Convention. Muslim legislators must make two amendments to the regulations governing trademark: (a) make the actual use of a trade mark a condition on the registration of trade mark (but not filing an application for registration); (b) add a new classification which permits the owner of the trade mark to file the application for registration of trade marks for goods or services that are forbidden in Shariah. Thus, Islamic countries can refuse to register a trade mark on the grounds of a lack of actual use (as Islamic countries can ban the import and sale of the products forbidden in Shariah) and not on the basis of the nature of the products themselves. In this case, Muslim countries' national laws can remain in line both with TRIPS obligations and Islamic Shariah rules. In addition, the national treatment obligations set out in Article 3 of the TRIPS Agreement, which obligates Member States to treat citizens of other member states similar to their own citizens, is one of the substantive provisions in TRIPS. As such, it is not an acceptable legal justification to avoid the application of Article 3. Therefore, this provision may be seen as causing a real dilemma for the Islamic countries that strictly follow the Islamic approach as Islamic Shariah does not accept this provision of 'national treatment' absolutely and without any exceptions. Hence, it is highly recommended for legislators (or competent authorities) in Islamic countries that are not TRIPS members and are intending to join the agreement to seek to invoke the exception addressed in the WTO (the non-application clause set out in Article XIII). This exception is important, especially if they are planning on boycotting the Israeli trade mark since this exception can make this boycotting acceptable under TRIPS provisions.

9.2.2 Recommendations and suggestions for Shariah scholars and *fatwa* committees

It is evident from the discussion above that there is a real need to conduct studies on *fatwas* by Muslim scholars to analyse in depth the concept of intellectual property in order maintain the strong development in this area. To achieve this, *fatwa* committees and *muftis* must take into account legal opinions of experts in the field of intellectual property. In other

words, the study highly recommends that *fatwa* committees should consist of two types of members: Islamic Shariah scholars and experts in the field of intellectual property.

Furthermore, the significant development in trade mark forms and functions and their economic value makes it necessary for *fatwa* institutions to reconsider their position in relation to the different forms of trade marks. Their position on whether to accept a trade mark or not should not be based on the elements this trade mark is composed of but rather by looking at these elements according to the roles these trade marks perform. Each trade mark form should be examined individually in order to determine the correct Shariah position on it. This will help avoid issuing trade mark *fatwas* that are too general and unrealistic.

Moreover, in order for the international rules associated with trade marks to be respected by a large number of Muslim jurisdictions, the lawmakers need to take into consideration the main obligatory principles of Islamic Shariah. This can be achieved by adding some additional exceptions to avoid any conflict between Islamic public policy and morality and the obligatory requirements set out in international conventions. However, none of this can be done without clarifying the Islamic rules that govern trademarks. Therefore, Islamic scholars, in particular those affiliated with the well-known Islamic institutions, need to issue official guidelines to clarify the Islamic regulations on trade marks that can be followed by international lawmakers. In this context, it is highly recommended to create an international Islamic standards setting body similar to the bodies in the Islamic financial sector such as the Accounting and Auditing Organization for Islamic Financial Institutions (AAOIFI) and the Islamic Financial Services Board (IFSB) to issue these guidelines.

9.2.3 Future work

This thesis is the first one to focus on Islamic public policy and morality and their impact on trade mark registration and protection in the light of the TRIPS Agreement. Hence, this thesis has laid a good foundation to the following research subjects in the field of Islamic public policy and intellectual property rights:

1. An analysis of the effects of the legal acts of both natural and artificial persons on trade marks that are in conflict with Islamic public policy and morality within the Islamic Shariah legal system.
2. A study of the effects of public policy and morality on the other branches of intellectual property rights within the TRIPS regime.

In addition, the findings of this thesis are significant for legislative amendments that can be offered to WTO (and to any other international organization). It will help to avoid conflict between Islamic public policy and morality with regard to trade marks in particular and intellectual property rights in general.

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