



INTERNATIONAL TRADEMARK PROTECTION

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Introduction to Trademarks

Trademarks form a distinct category of the industrial property of any country. It is a worthwhile venture to learn the various dimensions of trademarks so that adequate information is disseminated to their owners, users, and the general public. A trademark indicates the entity's name that is holding the right to the product. Typically, a trademark represents a brand or logo. Trademark is also known as a brand mark, trade mark, or symbol. It plays a significant role in both marketing and advertising. It is attached to the product for the purpose of identification. It is readily used to judge the quality of the product and recognize the origin of the product. Trademarks are typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements. The primary function of a trademark is to indicate the origin of goods or services, to distinguish them from one another. Trademarks are also used as a protective tool for the interests of the brand.

A trademark, trade mark, or trade-mark is a distinctive sign or indicator used by an individual, business organization, or other legal entity to identify that the products or services to consumers with which the trademark appears originate from a unique source and to distinguish its products or services from those of other entities. Types of trademarks for protection are trade names, service marks, and trade addresses. The trade name refers to an entity operating under it, and the service mark refers to the right to use the distinctive signs attached to the services sector.

1.1. Definition and Purpose of Trademarks

Trademarks are used to indicate the commercial source of goods or services. Through their use, consumers associate the quality of the product with the producer. As a result, trademarks play a key role in differentiating the origin of goods, in addition to promoting and protecting the seller's reputation in the market. Trademarks are also intended to bring economic benefits to the holder. This purpose coincides with the commercial function of the trademark. The value of a trademark lies in its ability to convey information and influence consumers' choices. From a consumer's perspective, trademarks serve as a guarantee of origin, indicating the

manufacturer and quality. Over time, a trademark symbolizes the goodwill and reputation in the market. Customers increasingly trust brand names, and brand loyalty is valuable to businesses. Firms are more likely to exert substantial effort to develop and maintain a good reputation if they have assurances that they can protect it. To influence consumer decisions, firms must invest extensively in their trademarks. However, when it comes to international trade or commerce, the importance of trademarks is on the rise and, with it, the need to devise a mechanism for protecting these commercial symbols at the international level. A multinational company in a globalized world cannot afford to ignore its trademark rights in other countries. A worldwide strategy is crucial, and to achieve this, international protection of trademarks is needed. This is where this study begins - i.e., with the locus of trademark protection in the international business.

1.2. Types of Trademarks

Trademark protection laws and practices provide a basis for the extensive application and functioning of trademarks on goods and services across the globe. The 'Convention for the Protection of Industrial Property' of 1883, initially bringing trademarks and patents to



global regulation, envisioned internationally acceptable practices for the protection of these rights. Intellectual property is differentiated by the type of asset it protects. For instance, a certain symbol might function as a trademark, just as a striking shade of colour could be filed as a design. In international protection and enforcement, it is therefore essential to have an understanding of the different types of trademarks.

Trademarks, 'types and forms', are used in order to classify the diverse characteristics of trademarks. Section 1.2.1 discusses traditional trademarks as well as subpart 'Non-Traditional Trademarks', presenting a brief overview of the different categories of signs that function as trademarks. Traditional trademarks are the majority of all types of marks. In the European Union, almost 40 per cent of all registration applications are for words. Figures provide evidence that the propensity to register figurative marks has tended to be higher in respect of international applications according to the Madrid system. Members of international organizations for cross-border trademark registration, such as the European Economic Area's Office for Harmonization in the Internal Market (OHIM), tend to favour coloured logo marks as their trademarks. Both word and figurative marks are registered in vast quantities, and similar third-party opposition statistics for marks containing logos and words were found in the United States. As with colour or shape marks, sound marks in the form of a jingle, normal full orchestra music, or rock & roll song, unless proven distinctive in their own right, will generally be found to be descriptive and hence devoid of any inherent capacity for distinguishing the goods or services or for indicating origin. The position with olfactory marks seems to be similar. In many cases, these marks started life as descriptive marks with no inherent capacity to act as a trademark but have been or are on their way to being registered as a result of consumers recognizing them as indications of origin. It is thus intriguing that colour, shape, sound, or scent functionality

is evident in many cases in the distinctiveness of trademarks.

2. Importance of International Trademark Protection

Trademarks have become a core aspect of international trade and are required to be shielded internationally. The expansion of the internet and an exponential rise in e-commerce and cross-border transactions have encouraged businesses to gain territorial dependability and protection for their brands. Due to this, international trademark protection has gained increasing focus in recent times. With a single-minded economic approach towards everything, nations all over the globe have been subject to the process of globalization. Accordingly, the world economy has more and more become an interconnected and mutually reliant phenomenon.

Businesses today have access to international markets, and the very nature of international trade transactions is such that goods are packed in one territory and sold in other territories. Global consumerism has also embraced advanced countries, creating an added chunk of potential opportunity for products manufactured in countries like India. Due to such a globalized environment, products can be imported into a country, having originated from another country. This can result in a possibility of a conflict between trademark owners in various countries unless international trademark protection is obtained. It is important to ensure that a trademark is not in the public domain in any relevant country, as this would pose a hurdle in trademark legislation and could destroy the brand equity that has cropped up from considerable investments made in building a brand.

2.1. Globalization and Trademarks

It is often said, although less often adequately substantiated, that globalization has made national economies and societies more interdependent, more complex and richer. In line with this, cross-border trades and transactions have significantly increased. Such increased commercial interactions not only



lead to the increased need of recognition of one's own business or product, but more ambiguously accentuate that cross-border and cross-national interactions have rendered the protection and use of trademarks more complex. Globalization, while not significantly altering the economic rationale for securing trademark rights, has, however, further highlighted the need for international regulation of trademark protection. According to many economists and social scientists, playing a role in the dynamics of economic relations and facilitating commerce, trademarks serve as a medium capable of transmitting valuable information, influencing the behavior of actual and potential customers, and making the latter rely upon or be attracted to the values or images associated with the goods and services. Global interconnectedness necessitates easy access to brands whose influence can be located all over the world. Modern countries, irrespective of their stages in economic development, are, by and large, places of arrival and departure in the focus of trade and investment all over the world, and with access to global capital and global inputs, there is a readiness for countries to engage themselves with the outer world, which is likely to mount up incentives to import a variety of goods and services into foreign countries or other jurisdictions. This paper delves into the intricate debates which eschew discussions about trademarks. It propounds a case that globalization has an impact on trademark law per se, and underscores the need for a holistic approach to the international protection and the enforcement of these rights.

2.2. Economic Significance of Trademarks

As already indicated, this book concentrates on the international legal aspects of trademark law and should be understood as a postscript to this introductory sub-section, paying tribute to the economic aspect by considering the creation of economically relevant brand values. Therefore, in this subsection no AD effect is traced. Instead, the ways in which trademarks contribute to business value are explored in

order to highlight the significance of trademark law as an operator of economic value. Trademarks make a signifier's meaning highly unlikely to undergo frequent radical alterations. They can therefore be used to target particular tastes, in particular styles or répertoires much as the firm's physical assets can be tailored to its targets, for example to fit particular production or marketing norms. Organizations have long appreciated the necessity and value of such activities in their productive processes. The changing nature of the world economy has led to many governments re-evaluating the economic benefits of national protection to foreign trademark rights. In an increasingly globalized world, commercially valuable trademarks have a strong incentive to obtain international trademark protection, there being a positive correlation between the circulation of products across borders and the value of the trademark the product carries. Hence, efforts to liberalize international trade and level the playing field for international investments are being complemented by growing support for the recognition of international trade mark rights, since "brands" have become an essential feature of international commerce" so that "international investment now is often closely linked with the use of trade marks." The French intellectual property Council considers that, in the current working climate, national protection implies "a gap which deters from making investments in the country offering the protection . . ." whereas, conversely, "multinational companies naturally favor international trade mark protection since their activities transcend national boundaries . . . and no longer simply involve selling a product in a foreign market, but rather the setting up of industrial or commercial establishments." In doing so, governments are influenced not only by the effect of trademark rights on trade, but also by the anticompetitive implications of permitting unfair competition in domestic markets. International protection of trademarks can therefore be beneficial not only in the field of foreign trade, but also in the area of



consumer protection or "welfare" by protecting consumers from confusion as to the commercial origin of the products they are engaging in.

3. International Treaties and Agreements

The two most important international treaties crucial in creating a legal framework for additional and concurrent recognition of trademark rights for the same mark in a number of jurisdictions are the Paris Convention for the Protection of Industrial Property and the Madrid System for the International Registration of Marks. The Paris Convention deals with the considerable problem of differing national systems for recognition of patent rights as well as systems of protection for other areas of IP, including trade and service marks. To address the problem of national patent laws snubbing the validity of patent right in other nations due to a prior grant being refused in one jurisdiction on the grounds of lack of patentability in that nation, the Paris Convention is based on the simple principle of treating nationals of the other members to the Convention as national of the country having given them the earlier right.

As a result, each country of the Union is obliged, within the limits of its legislation, to apply the same rules as regards industrial property to foreigners, as to its own nationals. The Madrid Assembly adopted the following two instruments. Protocol relating to the Madrid Agreement concerning the international registration of marks addresses weaknesses identified in the Madrid system in an attempt to make it even more user-friendly. The states that are members of the Madrid Agreement or Protocol in relation to a particular Contracting Party, such as the U.S., are considered as having the same treatment under the Madrid Protocol. The Madrid System for International Registration of Marks allows for the international registration of a mark in a number of different countries, providing essentially a one-stop-shop (filed in the home office) international registration system. In other words, the Madrid Protocol (as amended) allows for filing of a single

application to register a mark internationally, in a number of countries.

3.1. Paris Convention for the Protection of Industrial Property

The Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, established a Union for the protection of industrial property. Commonly referred to as the Paris Convention, this is the first multilateral treaty for the protection of trademarks (as well as patents and industrial designs). The provisions of the Paris Convention, as the first international convention on the subject of trademarks, have continued to play a part in defining the rights of nationals of member countries in international trade in the context of more recent and comprehensive treaties such as the 1958 Madrid Agreement on the International Registration of Marks and the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) concluded within the framework of the World Trade Organization.

The Paris Convention has been concluded in several revisions since 1883. Early revisions, the most significant of which took place in 1891, 1900, 1911, 1925, and 1934, have been superseded. West Germany adhered to the protocol amending the Paris Convention done at Brussels in 1948 (the first post-Second World War revision) on May 1, 1954. The Brussels revision was the first to set out in its explanatory note that the Paris Convention established "neither detailed regulations nor an administrative organization for the international protection of industrial property." The most recent revisions, concluded in Washington in 1967 and Stockholm in 1967 (together known as the "1967 Act") or in Brussels in 1992 and in that year, or in Stockholm in 1967 and in that year (the "1992 Act"), provide the current basis for the operation of the Union today. The Paris Convention takes as its primary subject matter the protection of industrial property and covers patents for inventions, utility models, and industrial designs as well as trademarks and indications of source or appellations of origin



(i.e., for goods that have a certain quality, reputation, or other characteristics based on their geographic origin). The pool of subject matter addressed by the Paris Convention is therefore largely similar to that to be covered by the European Union's Community Trademark Regulation.

3.2. Madrid System for the International Registration of Marks

The Madrid System provides a time-efficient and cost-effective way to obtain and manage trademark rights in multiple countries. The System has grown to become the international trademark registration system that spans the largest number of territories, covering more than 124 countries. In 2019, there were more than 61,200 new international trademark applications filed through the System, a 5.7% increase on the 2018 figure, and a record since the Lisbon Agreement and Madrid Protocol Systems were merged, accounting for some 40% of all global trademark applications during that year. This level of use attests to the popularity and value afforded by the system in terms of easing the administrative procedures for obtaining and managing trademark protection in multiple countries. The number of new international registrations, as recorded during 2019, stood at 62,800 – up 5.8% on the 2018 figure.

The Madrid System is a centralized system under the Madrid Agreement and the Madrid Protocol, both of which are administered by the International Bureau of WIPO in Geneva. It has two basic features: (i) the possibility of obtaining trademark protection in multiple countries on the basis of a single application; and (ii) the opportunity to maintain and renew that protection in respect of several or all of the designated member countries through a single procedural step. The System offers significant advantages, including the easy means to expand a company's brand presence in new and emerging markets, for instance, by simplifying the process of obtaining protection in multiple countries, and the feat of potentially reducing filing and management costs. The System also offers the possibility of foreseeing

expenditure on international trademark protection because it has a simplified fee structure and deadlines for renewal of registrations, thereby providing predictability.

4. Key Players in International Trademark Protection

International Trademark Protection

Key players in international trademark protection

First and foremost, of all the entities specializing in trademark protection around the world, there is none higher than the World Intellectual Property Organization (WIPO). Established in 1967 as a specialized agency of the United Nations, WIPO aims to encourage creative activity, promote the protection of intellectual property throughout the world, and provide a national framework for consumers. WIPO is devoted to trademark law and hosts several forums focused on gathering professionals from around the world to learn, network, and conduct business. Most notably, WIPO hosts several committees designed to update and develop soft-law doctrines, focusing on various forms of intellectual property (including the Standing Committee on Trademarks (SCT)).

Another significant player when it comes to the protection and practice of trademarks at the international level is the International Trademark Association (INTA). INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property to protect consumers, promote fair and effective commerce, and contribute to the broader public interest. INTA's main focus is the international registration and protection of trademarks. INTA also creates forums and educational opportunities for trademark professionals who are INTA members. This allows different kinds of attorneys and other trademark professionals to gather from around the world to discuss business, learn about recent changes in trademark law, compare trademark registration and use in different countries, and generally learn about the ways in



which other countries and entities function regarding trademarks and intellectual property.

4.1. World Intellectual Property Organization (WIPO)

World Intellectual Property Organization (WIPO)

The protection of intellectual property has been regulated only at the national or regional level. The aims of many countries to create regulations and systems that would apply worldwide like GATT (General Agreement on Tariffs and Trade) finally led to its reform and transformation into WTO (World Trade Organization), which since 1995 embodies the only global system of trade rules and agreements that enforce international standards of intellectual property (TRIPS Agreement) and solves disputes in the field. At the same time, the objective to harmonize international regulations regarding intellectual property enabled the fundamental UN agency for the protection of intellectual property to adopt a uniform principle and methodology. The aims of the World Intellectual Property Organization are, on the basis of its guiding principles, to serve as a prime agency specialized in the field of intellectual property and to operate in many areas of the economy and social life by delivering essential international registries and services; developing international harmonization and cooperation policies; promoting enforcement; providing legal and technical assistance and training; and creating a global reference source in the field for everyone.

Internationally renowned marks, including the famous ones in the country, are placed in a special register run by this organization based in Geneva (2005 – 3133 marks). In accordance with Article 3 of the Convention on the Implementation of the BN marks, they must be made by national laws or administrative provisions. The procedure is similar to national trademark registration: 1) filing a request with the International Bureau, including a reproduction of the trademark and paying the fee, 2) administrative verification of documents, 3) they are published and countries can refuse

registration within 18 months from publication, 4) if not refused, registration is granted and a certificate of international registration is issued.

4.2. International Trademark Association (INTA)

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The International Trademark Association (INTA) is the leading international organization dedicated to the support and advancement of trademarks. INTA is making a substantial contribution to the strengthening of international protection of trademarks through the establishment of international development bodies such as the Communication and Advocacy Group, Legislation and Regulation Committee, Regulatory Affairs Project Team, and Trademark Office Practice Committee. Moreover, INTA places significant focus on lobbying, guiding, and supporting the development of international agreements, directives, and other legislation that have ultimate implications on the administration and enforcement of trademark rights on an international level.

The International Trademark Association has undertaken the following initiatives and held programs aimed at contributing to the protection and enforcement of trademarks around the world: Anticounterfeiting Initiatives, Model Customs Request for Assistance, Training and Technical Assistance, Consumer Awareness Programs, Public Awareness Programs, and Educational Trust.

In addition to that, INTA has developed and introduced programs to promote its trademarks and intends to increase awareness of the need to protect and enforce them. There will be further analysis of each of these initiatives and programs with a view to assessing their efficiency in promoting and enhancing the understanding and enforcement of trademark rights on an international scale.

5. Trademark Registration Process

The registration process of a trademark usually takes six to eight months, provided that there are no invasions or third-party objections, and national laws and regulations do not foresee



any non-standard term bars. The first formal examination is carried out when the application is filed, as per the list of requirements, which generally includes: a power of attorney, incorporating the barcode where necessary; identification of the applicant and of the sign; a list of the goods and/or services; and, in the case of marks comprising particular elements, a color claim and/or a description. It is also possible to register sound marks, provided that sound sequences are arranged in such a way that it is technically possible to register them.

Examination to see if the sign qualifies for protection because it does not fall within any of the bars of a particular trademark law and to check whether the sign is available in each of the states of potential protection. This phase can be decentralized, meaning that it is carried out by the individual patent and trademark offices as a first stage. The following publication phase gives possible 'objectors' a fair idea of what marks are available and in which area. The phase includes both the publication of trademarks that go through the examination phase without any objections from the trademark office and the publication of trademarks that are opposed by a third party. There is enough time to oppose the registration of a trademark. The possible opposition can be based exclusively on the case of refusal, the same refusal to the sign both in the identification of the goods and services, and the existence of a prior right, not necessarily a trademark. Once the mark is registered, as a patent or as a trademark, the opponents have the possibility to cancel the trademark. Also, in this case, the trademarks are published on a suitable platform.

5.1. Filing Requirements

What are the first steps to successfully apply for international registration of a trademark? In this section, we describe the substance of the application form (MM2 (FR) or MM2 (EN)), and the documents that must accompany the international registration. We will also refer to the formal rules which the application must satisfy in order to be officially filed.

The initial steps of the international registration process include completing and submitting a form for an international trademark application which typically requires the full name and address of the applicant, a representation of the trademark and a list showing the goods and services for which it is used or intended to be used.

5.2. Examination and Publication

After the formalities examination (see 5.1), an actual examination of the application begins. Often, the legal issues are reviewed by a legal examiner only after the actual technical examination has been carried out.

The scope or criteria for refusal of examination differ among Member States. International applications are examined according to the same principles as for national applications. However, it is not possible within the framework of this guide to report on how each individual Member State actually proceeds in matters of examination. In many countries, objection letters are drafted when an examiner is not in a position to approve an application at the first instance. The letter sets out the reasons for refusal and invites the applicant to submit observations which may have a bearing on the examiner's decision. Known conflicting trademarks are cited. In countries operating a two-tier system, a refusal decision is normally taken by a separate legal examiner. Official examination may be completed within weeks or may take up to several years, depending on different factors. Not only the publication times, as set out in Article 173 of the Agreement, but also the examination standards are very important, as they both have serious consequences for the scope of protection. At the end of the examination process, if the opposition period as published has expired, or opposition has been decided against the opponent, the mark is considered "registered". Subsequently, the mark is recorded to the International Register as from the date of publication of the international registration in respect of the Office of the designated or succeeded Contracting Party or Organization.



5.3. Opposition and Cancellation Proceedings

After registration, third parties may challenge the trademark on an ex parte basis or request revocation or invalidation of the trademark because it conflicts with their sign (relative grounds). For the period after registration, the likelihood to be successful in opposing a trademark application is only 15%. In practice, less than 1% of trademarks registered at the European Union Intellectual Property Office (EUIPO) or the World Intellectual Property Organization (WIPO) are opposed by either the applicant of a subsequently filed trademark application, which is equivalent to just 0.5% of European Union (EU) trademark applications.

These rates of opposition are similar to those at the United States Patent and Trademark Office (USPTO). At the EUIPO, 18% of opposition proceedings are settled, 70% are terminated after filing, 10% are partially upheld, and 2% are fully upheld. The authorities Chancellor, Talavera & Haslem in the EU and the U.S. differ on the question which party normally files for opposition. Except for refusal, it is possible to challenge an application for nullity after registration (see e.g. Arts. 165 and 166 Council Regulation (EC) 40/94 and European Union Trade Mark Regulation (2015/C 340; cancellation or EU trademark)) or cancellation before the Cancellation and who may take the initiative to cancel the trademark.

This unfavorable success rate of oppositions supports concerns about frontrunning behavior. Thus, by allowing for ex ante opposition, TMAs enable third parties to challenge the registration of a similar sign "already applied for and demarcates a premature (even perpetual) monopoly" that would weaken the role of the registration system as an "agreement on what marks have been effectively checked against the formalities and the substantive legal hurdles." This registration system is based in good part on the sign's distinctiveness since the bar for signs applied for with the Disputes Office is substantially lower.

6. Enforcement of International Trademarks

Enforcing trademark rights across international borders is extremely difficult, and trademark owners often encounter an insurmountable number of obstacles in preserving their trademarks. Persistence and consistency are the keys to maintaining the recognizable figure that a trademark represents. Regularly pay attention to any labeling or packaging used in independent markets or other accessible trade exchanges as well.

Prevent the importation of unauthorized merchandise from another nation. Select a representative who is knowledgeable about the local area, especially about local usage of trademark law.

6.1. Monitoring and Surveillance

Frontline Engineering comes into play. It is crucial to have measures, strategies, and tools for continuous monitoring and surveillance in place to detect as early as possible infringements of rights, abuse, or empty space. Brand abuse may have significant commercial consequences or cause the loss of trademark rights.

The most proactive level of brand protection is monitoring and surveillance. Surveillance means being vigilant and watchful for possible threats or opportunities. In the context of brand protection, such a proactive measure could prevent the reputation of the brand from being misused by cybersquatters registering the brand with a new gTLD. In addition, monitoring data may present relevant business development information and have an impact on brand strategy. Given the fact that the volume of digital information produced and receiving attention is overwhelming to the human brain, monitoring tools are increasingly important for any company.

Monitoring trademarks Registered trademarks identify the brand's products at the point of sale and are an indication of the company behind the product, as well as its reputation, motivations, and ability to provide products and services of good quality to the public. It is thus in companies' interest to invest money in



preventing their trademark from being misused or tarnished by others, especially when the result of such use is confusion and/or the creation of negative associations, which may impact the competitive edge of a company and produce significant economic losses.

The protection of trademarks from infringement is thus critical because it is a reflection of a business reputation. In fact, the trademark is an indication of where to turn to have the product or service covered by the trademark. For a company, a trademark is the sign of their years and decades of work and know-how. Even the smallest infringer puts the brand at the risk of being a generic term and, in the end, at the risk of losing it. In this sense, every successive undiscovered use of a trademark that is not authorized by the owner creates confusion and erosion of the trademark function. Moreover, social media is a platform where brands' reputations are at high risk and can spread information very rapidly thanks to word-of-mouth type communication. If missed, a mistake made on social media can be very costly to the company and result in significant financial losses.

6.2. Cease and Desist Letters

Another instrument for international trademark enforcement is cease and desist letters. Cease and desist letters or warnings are usually the means of choice to notify a trademark infringer or former competitor of the trademark infringement and to call upon the infringing party to cease and desist from the unauthorized use of the trademark. In practice, a cease and desist letter is often the first step of a formal notice that, in general, aims to end any unauthorized use of a trademark, product configuration, or any other distinguishing sign and to prevent further infringements.

From a legal point of view, the recent European Directive no. 2015/2436 touches final rulings very closely, in that Art. 27 provides that out-of-court measures should not go beyond what is necessary to achieve the protection of the rights invoked. This would also include not intimidating third parties against illegal

activities. Legal risks for the sender of cease and desist letters in Europe are considerably high. Rights holders are only allowed to use cease and desist letters for the notification of a rightful warning. Non-authorized warning letters that lead to cease and desist letters might include trademark cease and desist letters, design warning letters, or warning letters in cases of color or shape mark infringements. The choice of letters depends on the question of whether only the unauthorized use of a sign or the distortion of the product's appearance in commerce shall be forbidden.

6.3. Litigation and Remedies

When it comes to brand protection and when contracting out-of-court proceedings cannot solve the case, there should be detailed and focused attention concerning the available legal channels for litigation, targeted strategies for litigation considering practice, available remedies to obtain through the litigation, and other litigation-related information. Since following a legal path can be significantly costly, knowing the proposed information can prevent waste of resources and time for the brand holders.

International trademark disputes come within the scope of judicial discretion. A principle of territoriality applies among states. Therefore, judicial remedies available against the infringement of the trademark located within the scope of their national laws. To initiate a trademark infringement case all over the world, the brand holder should establish the law of the country where intends to file a lawsuit. However, filing a trademark infringement case can also be made in the field of unfair competition laws. To initiate proceedings in the European Union, the court in the member country of the European Union shall be entitled to file a lawsuit in accordance with the Regulation on the Jurisdiction, Recognition, and Enforcement of Judgments in Civil and Commercial Matters.

There are several remedies in the litigation of international trademark disputes for the trademark holder. When legal actions are filed for infringement of trademark rights and the



unfair competition process, legal proceedings mainly aim to get the defendant to stop unfair competition practices leading to the transfer of profits made by the defendant to the trademark holder. The most common forms of remedy or relief available in international trademark infringement litigation are as follows: Infringement (Preliminary) Injunction, Monetary Damages (including payment of profit popping up out of the infringement practice and compensation for damages that will occur in the future, attorney's fees or legal costs), Periodic Penalty (for unfair competition procedures), etc.

7. Challenges and Emerging Issues in International Trademark Protection

International trademark protection presents major challenges, for example, in the field of trademarks applied to products or services counterfeited or subject to acts of piracy; or in the area of trademarks illegitimately used on the web or registered by third parties with a view to creating gTLD domain names. The same applies regarding attempts to register trademarks known worldwide with the WIPO or the EUIPO with FIRE programs and innovative solutions that, introduced on the web, make the international registration system accessible to applicants, for example, small and medium-sized enterprises, from all over the world. Problems concerning distinctive signs are no longer limited to the unauthorized commercial use of a sign identical to a trademark or distinctive sign.

In the case of goods, nor do they arise only in trade involving counterfeit goods. Very often, rather, infringements are almost indistinguishable from the pair "good quality – reasonable price." Not to be overlooked is the alarming presence of counterfeit agri-food products, cosmetic products, and alcoholic beverages on the international markets. With respect to what has been said so far, the practice of the WIPO Arbitration and Mediation Center regarding ADR procedures in cases of abusive domain name registrations under the UDRP, the Web Dispute Resolution Policy (Web-

DRP), that is, the ADR procedure under the .eu domain name, and the .

7.1. Counterfeiting and Piracy

Although the scope of intellectual property violations encompasses a wide variety of crimes, those related to trademarks are particularly destructive. The illicit duplication of trademarked goods and unauthorized use of distinctive marks on unauthorized goods are termed "counterfeiting" and "piracy," respectively. According to the World Intellectual Property Organization (WIPO), counterfeited and pirated goods represent an average of 2.5% of total global imports, amounting to an annual \$509 billion as of 2016. These counterfeit products range from business software and medicine to luxury items, sporting goods, food and drinks, and fertilizers. Laos, Morocco, Paraguay, Ukraine, and Yemen have particularly high overall counterfeiting and piracy activity, while high-income OECD countries, Eastern Europe, Asia, the Middle East, Africa, Latin America, and the Caribbean are the final destinations for 90% of counterfeit consumables. Counterfeit clothes, shoes, and leather goods account for 30% of total seized goods, with electronic equipment and medical goods making up 27% and 7%, respectively.

7.2. Online Infringements

Trademarks are no longer only displayed prominently on huge billboards and appear in numerous locations. Foreign consumers increasingly purchase goods and services through e-commerce websites rather than traveling abroad. Internet searches make the display of a trademark less obvious than before, leading to an increase in online trademark infringement. In any case, the less obvious a trademark is, the more likely the possibility of infringing trademarks if there is insufficient protection or if the owner fails to enforce it. Investigating unauthorized online trademarks can be highly challenging due to the use of advanced technologies and the rapid pace of the online world.

Social media also has an impact on international trade. Millions of people use the



Internet to communicate through various social media platforms. As users share trademarks digitally, their reach can be significant.

8. Case Studies in International Trademark Protection

Case 1. Christian Louboutin SA v Abubacker: International protection. This case has particular international implications given the famous brand registration practices of Christian Louboutin SA, which were held to give a valid mark registrable under Articles 2 and 5(1) of the TradeMarks Act 1994. It is noteworthy that the company had also registered the mark in India, but the registration was not valid under s. 2(1)(m) of the Indian Trademarks Act 1999, as shoes on which the scarlet sole was missing were clearly not distinctive, hence not registrable under s. 9(2)(a). The distinctiveness was acquired through use in the UK.

Case 2. Pentland Group Plc v Missoni SpA: European Trade Marks. The case involves the effect of community trade marks and the effect of a UK mark following registration of the community trade mark. Pentland should have known it was dealing with a number of family businesses, albeit in different jurisdictions. Various companies, including the claimant community, was originally a Nordic trade mark. Missoni registered a UK trade mark, and a United Kingdom company also owned UK registration of the word "miss" and the device of a woman wearing a hat.

Case 3. Youssef's Solicitors (A Firm) v Nooreadh: Trade Mark Infringement. The phrase "COVENTRY SCHEME", which was very distinctive in the United Kingdom where the company operated its business, had not acquired a corresponding reputation in India. The Courts held that the crucial factor in the launch of the decision was whether the Indian lawyers could have realized the existence of the Coventry Scheme in Coventry as being the source of the services. They held the launch sites mere "innocent publication in Kolkata". Moreover, instead of showing serious misrepresentation on the part of the new business, the modest inquiry made by the lawyers figures that there was no

deception as to the origin, and this concluded the Court to hold that the Company has failed to prove deception.

8.1. Famous Trademark Disputes

One of the most famous cases is a conflict over the right to Nike's "Swoosh" logo in Taiwan in 2013. Gao Yaojun tried to register the same mark for sportswear, which Nike Japan Corporation has been using since 1984. The famous American company argued that the symbiosis is a combination of "word and figurative elements" and is unique among consumers in Taiwan. The administrative authority of intellectual property on the island, however, rejected Nike's accusation. Previously, however, Gao Yaojun had a similar application for a Taiwan patent rejected. Two years ago, the Government of the Czech Republic refused the attempt of a Chinese national to register "Bonghwa" as a trademark for goods of all kinds because the "Bonghwa" brand has been famous for a century.

In 2011, Apple won an intellectual property dispute against the Xintong Tiandi. The Hong Kong company wanted to register "I-phone" as a trademark for leather products and other apparel, but Apple convinced the European Union Intellectual Property Office that it would deceive consumers into believing that popular electronic devices bear this trademark. At the beginning of 2016, Apple received initial permission from the United Kingdom's patent office to oppose the Starrett Unit of Liverpool's use of a half-eaten apple as a mark for furniture and related accessories, including "His" and "Her Royal High Chairness". A mark applied for by the Vortex Entertainment (Manchester) company, which was aiming for video games, amusement and play, clothing, groceries and catering services, music recording and performances, was also opposed by the American company.

9. Conclusion and Future Trends

In conclusion, the essay delves into the world of international trademark protection. It begins by discussing the essential nature of trademarks, as well as their role as an asset in modern business. This is followed by a discussion and



critique of the various international treaties and agreements. These treaties formed the current system of trademark registration, which allows registrants to have their marks directly protected in multiple countries. Furthermore, the essay discusses the growing interest in the protection of unregistered, or common-law, trademarks.

In the following section, the role and issues surrounding parallel imports, as well as its relationship to exhaustion, are examined. Moreover, a discussion is offered on the role of the internet and domain names, and the significance of bad faith in the confusion of internet users. Future trends and the implications that these trends may have on trademark regulation have been projected. Given the global nature of business, it is reasonable to assume that as business takes place increasingly on a global scale, so would the institutional design and regulation of trademark enforcement and protection move towards more international simplified and harmonized regulation. With the advent of digitization, the convertibility of marks also will gain importance, and the debate may start on whether a First to Use or First to Register system would be better suited for international protection.

On the innovation front, basic trademarks may no longer be sufficient, and certification marks or collective trademarks may become more valuable in the years to come and may require an international agreement on some form of protection. Meanwhile, growing counterfeiting has also raised the significance of international agreement and enforcement of such regulations in recent times. In this regard, a new international treaty for the enforcement of trademarks, as suggested by WIPO, would be a positive step.

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