

**Trademark Squatting**  
**in**  
**Egypt and Comparative Law**  
**Dr. Walid Ahmed Mohamed Amin**

Doctor of Law, Faculty of Law, Bani Swaif University, Egypt

**ABSTRACT**

This study focused on one of the obstacles that hinder attracting foreign investment, not only in the Arab Republic of Egypt but also in many countries.

When any company thinks of extending its activity to another country, it must first ensure the protection of its products in this country, which begins with the registration of its trademarks, and the problem begins when the company is surprised that its trademark has been previously registered in this country in the name of another person. This is not a coincidence, but there were those who followed this brand, and they expected that this company would enter this market soon, and they deliberately registered its mark in their name; To start bargaining with its owner to assign it.

Trademark squatters often target well-known marks; It is expected that these marks will enter most countries of the world soon. Its owners have the financial capacity to pay the royalties that will be requested. This is what happened with Apple, Starbucks, and other companies.

Many companies have refused to enter the markets of some countries, due to this type of trademark piracy which is called “Trademark Squatting”. This prompted some countries to try to address the trademark squatting. There were judicial and legislative efforts. It has become urgent to start this research, which reviews the problem of trademark squatting of foreign marks in different countries, and the role of the judiciary

and legislators in comparative law, in confronting this phenomenon that threatens foreign investment, to present to the Egyptian legislator judicial and legislative experiences of other countries, that enable him to confront this The phenomenon of trademark squatting of foreign marks.

Key Words: Trademark Squatting – Registration of Marks – First to file – First to use – Comparative law.

## **I. Introduction:**

Generally, National policies matter for attracting foreign investment to a larger number of developing countries and for reaping the full benefits of foreign investment for development. In order for any foreign company to start investing in a country, it must ensure that its products will be protected from imitation in the target country's market. This starts with registering its trademark in this country.

However, there is an obstacle to achieving this in developing countries and others, this obstacle is the unauthorized registration of internationally known trademarks by “pirates” prior to registration by actual owners.

After registering the trademark, a pirate has several options: sell the trademark back to the rightful owner, distribute goods bearing the trademark to consumers who believe they are genuine, exclude the rightful owner from the market by threatening an infringement suit, or use the trademark to market products that differ from those sold by the actual owner.

The first option is the most prevalent, which is to sell the mark again to its legal owner, and this phenomenon is called “Trademark Squatting” and it is what we will focus on in this research.

There is no doubt that the problem of trademark squatting prevents investment from being attracted, which is an obstacle to sustainable development. Therefore, it is necessary to shed light on this phenomenon

in comparative law, in order to reach the best ways to confront it and to benefit from the best legislative experiences to protect the Egyptian market from trademark squatters. Those who represent a real obstacle to attracting investment, and thus hinder the sustainable development of Egypt.

### **Importance:**

The importance of this study comes from presenting the legislative experiences of different countries, to serve as a guiding model for the Egyptian legislator if he decides to enact legislation that limits the phenomenon of “Trademark Squatting” that impedes the attraction of foreign investment in Egypt. It also appears the importance of this research in presenting some judicial precedents of several countries, highlighting how they confront this phenomenon, perhaps illuminating the way for the Egyptian judiciary in confronting this phenomenon.

### **Objective:**

This study will attempt to achieve a main objective, which is to confront the phenomenon of trademark squatting. It has sub-objectives:

- Draw the attention of trademark owners to the necessity of registering their trademarks in the countries to which their investments are expected to be extended.
- Draw the attention of decision-makers in Egypt that the phenomenon of trademark squatting would impede the attraction of foreign investment and prevent sustainable development.
- Paving the way for the Egyptian legislator to enact national legislation that confronts the phenomenon of trademark squatting, by providing legislative experiences for another country.
- Presenting judicial experiences of different countries that highlight their confrontation with the phenomenon of trademark squatting, to be placed in the hands of the Egyptian judiciary.

**Research Problem:**

The research problem lies in the increase in trademark squatting globally, which prevented the entry of many owners of well-known marks to the markets of some foreign countries. This is despite the legal fence imposed by international agreements to protect well-known marks, and despite the fact that the national laws of all countries aim to provide protection to trademark owners, and to ensure that others are prevented from registering their marks. Is protecting well-known marks not enough? Or, Does the national protection of marks in some countries need to be reviewed? And if the answer is in the affirmative, Are there legislative experiences of some countries that can be benefited from?

**Methodology:**

In this research, we will adhere to the comparative approach, which is imposed by the nature of the research. As this study relies on comparative law. One of the objectives of the research, as we mentioned earlier, is to shed light on the legislative efforts of different countries in their confrontation with the phenomenon of appropriation of marks, as well as clarify the judicial efforts in this context, in different countries. Accordingly, we will adhere to the comparative approach in order to achieve the objectives of the research.

**Research Plan:**

To achieve the objective of this research, I should divide it as follow. The First section: What is Trademark Squatting? Second section: How does trademark squatting work in the context of 'first to file' and 'first to use' jurisdictions? Third section: Efforts to confront the trademarks squatting in comparative law. We will discuss these sections in detail as follows:

## II. What is Trademark Squatting?

Article 6(3) of the Paris Convention, implements the doctrine of territoriality by providing that “(a) mark duly registered in a country of the [Paris] Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.” Paris Convention creates nothing that even remotely resembles a “World Mark” or an “International Registration”. Rather, it recognizes the principle of the territoriality of trademarks [in the sense that] a mark exists only under the laws of each sovereign nation<sup>(1)</sup>.

It follows from the incorporation of the doctrine of territoriality into any national law, the courts do not entertain actions seeking to enforce trademark rights that exist only under foreign law.

As a result, the phenomenon of “Trademark Piracy” emerged. this phenomenon can be divided into two related categories. There are brand pirates and there are trademark squatters<sup>(2)</sup>. Brand pirates operate by taking an already known brand or company name and using the name, label, designs, or other description of trade to intentionally confuse a customer into thinking that they are buying an item associated with a particular brand or company<sup>(3)</sup>. In contrast, the second kind of trademark pirate is a “Trademark squatter”, who intentionally files a trademark application for a second party’s registered trademark in a country where a business does not currently hold a trademark registration<sup>(4)</sup>.

After registering the trademark, a trademark squatter has several options: (1) sell the trademark back to the rightful owner; (2) distribute

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(1) *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, United States Court of Appeals, Fourth Circuit. Argued: February 28, 2003. Decided: June 2, 2003.

(2) Squatter: A person who settles on property without any legal claim or title. Bryan A. Garner (Editor in chief) *Black’s Law Dictionary* (8th ed. 2004), P. 4394.

(3) Robert Tönnis, *International Branding - An Internationalization Approach on the Marketing Level*, Paper published by GRIN Verlag, (July 2007).

(4) Scott Baldwin, *Don’t Sit and Wait: Stopping Trademark Squatters*, USPTO (February 2013), Available at: <https://www.uspto.gov/custom-page/inventors-eye-don-t-sit-and-wait-stopping-trademark-squatters> last visit: May 26, 2023. At 5 PM.

goods bearing the trademark to consumers who believe they are genuine; (3) exclude the rightful owner from the market by threatening an infringement suit; or (4) use the trademark to market products that differ from those sold by the actual owner<sup>(1)</sup>. But a typical scenario is for a squatter to register the trademark of a foreign brand and wait until the foreign brand owner enters the local market. Once the trademark owner has entered, the squatter may threaten to sue for trademark infringement<sup>(2)</sup>. Then the trademark squatter may demand a heavy price from the trademark owner to abandon, reassign, or license the trademark to stop using his trademark<sup>(3)</sup>.

It may be possible for the brand owner to get the intellectual property office or a civil court to cancel the trademark, but this is costly and may involve considerable delay and legal as well as commercial uncertainty. As a result, the trademark owner may be willing to pay the squatter for abandoning, reassigning, or licensing the trademark<sup>(4)</sup>. In order to clarify this phenomenon practically, we must shed light on the subject of trademark squatting, and Practical cases as follow:

### **A. subject of trademark squatting:**

World Intellectual Property Organization (WIPO) has defined Trademark squatting as the registration or use of a **well-known** trademark that is not registered in the country which has pirated the mark or is invalid as a result of non-use<sup>(5)</sup>.

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(1) Samantha D. Slotkin, Trademark Piracy in Latin America: A Case Study on Reebok International Ltd., 18 LOY. L.A. INT'L & COMP. L. REV. 671, 671 (1996).

(2) Carsten Fink, Christian Helmers, and Carlos Ponce "Trademarks squatters: Evidence from Chile" Economic Research Working Paper No. 22, WIPO Economics & Statistics Series, September 2014, P. 3.

(3) Archi Bhatia "The dirty truth about trademark piracy" Article published on May 15, 2018, updated on: Thu Sep 05, 2019. Available at: <https://yourstory.com/mystory/3872106019-the-dirty-truth-about> Last visit: June 24, 2023. At 11:30 PM.

(4) Carsten Fink, and others, op.cit, P. 1.

(5) Archi Bhatia, op.cit.

On the other hand, there are many definitions of trademark squatting, not based on whether the trademark is well known or not. For example, there are those who<sup>(1)</sup> define trademark squatting as one entity intentionally filing a trademark registration application for a second entity's **registered trademark** in a country where the second party has not yet registered the trademark. and another one<sup>(2)</sup>, saw that trademark squatter operate by first selecting a victim, by scouting what marks are **becoming popular** in another nation. The squatter then checks to see if the mark has been filed for trademark protection in his or her country and simply files for the same mark, files for a similar mark, files in an unregistered class, or a foreign nickname<sup>(3)</sup>.

Upon the above, the trademark subject of squatting may be **registered**, **became popular**, or **well-known**. There is no doubt that the latter (well-known mark) enjoys the highest international protection. However, in practice, there are some problems that we will address later when we talk about the “**first-to-file**” system.

B. Practical cases, the most important of which are:

- When Apple tried to introduce its wildly popular iPhone into one of the biggest markets in the world, China, the company was in for an unpleasant surprise. Though Apple had made the first application for the iPhone trademark with the Chinese Trademark Office (CTMO) in 2002, they only filed in a subclass for “computers and computer software.” Soon after, a Chinese company called Hanwang Technology registered the iPhone mark under the proper subclass that included “phones and mobile phones.” Apple fought in vain to reclaim the mark, and

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(1) Loc.cit.

(2) Frederick A. Palumbo “Trade Show/Fair Piracy and Industrial Espionage” *Journal of Convention & Event Tourism*, 277-292, (December 12, 2018).

(3) Robin Baydurcan “Michael Jordan (partially) defeats Chinese trademark pirate based on unregistered personal-name rights” *Lexology*, (March 14, 2017), <https://www.lexology.com/library/detail.aspx?g=27166825-4a80-41df-ab7d-904208f40f8a> Last visit: June 24, 2023. At: 11 AM.

it ultimately lost in its opposition at the CTMO as well as in an appeal to the Trade Mark Review and Adjudication Board (TRAB). Apple reluctantly paid the \$3.65 million to Hanwang Technology for rights to the trademark<sup>(1)</sup>.

- Another case in point is the U.S. coffee shop chain Starbucks. When entering the Russian market in 2005, Starbucks faced the fact that its trademark was owned in Russia by an individual, Sergei Zuykov, who offered to reassign the trademark for US\$ 600,000. Instead, Starbucks opted to invalidate Zuykov's trademark before court, which resulted in a protracted legal dispute substantially delaying Starbucks's entry into the Russian market.
- Other companies appear to have given in instead of risking litigation. In particular, Zuykov claims to have successfully squatted trademarks belonging to the German car manufacturer Audi. In an interview, he claimed to have sold five trademarks to Audi in 2001 for the price of US\$ 25,000.
- Another example is that of Californian car maker Tesla. Tesla has faced a trademark squatter in China, which substantially delayed its entry into the Chinese market and upon entry, initially forced the company to market its cars only under the brand's English name because the squatter maintained ownership of the trademark on the Chinese name<sup>(2)</sup>.

### **III. How does trademark squatting work in the context of 'first to file' and 'first to use' jurisdictions?**

In general, one can distinguish between two main systems for obtaining trademarks (as extremes). Trademark rights either exist for the "first-to-use" or are granted by a trademark registry to the "first-to-file". Most

(1) Sunny Chang "Combating Trademark Squatting in China: New Developments in Chinese Trademark Law and Suggestions for the Future" *Northwestern Journal of International Law & Business*, Volume 34, Issue 2 Winter, Winter 2014, P. 338.

(2) Carsten Fink, *op.cit.*, P. 3.



countries have adopted some kind of first-to-file system<sup>(1)</sup>. The question here is, Which of the two previous systems is a suitable environment for trademark squatting?

### **A. First to File<sup>(2)</sup>:**

In first-to-file countries, the rights to a trademark belong to the first business to file an application for that trademark, even if it was used by another business before. This means that the first business or individual to file for trademark registration has legal protection – not the one who can demonstrate the first use of the trademark<sup>(3)</sup>. This policy provides squatters with an opportunity to rush to register foreign trademarks before the original brand owners have an opportunity to do so. The squatter can then leverage the bad faith registration to extort a payment from the true brand owner. If the brand owner refuses to pay, the squatter will threaten the brand owner with a lawsuit to prevent the brand owner from doing business in the squatter's country<sup>(4)</sup>.

However, there is an exception for well-known trademarks. So we will talk about the well-known mark as an exception from the first-to-file system, and national legislations obstacles, then we should talk about the practical problems of this system as follow:

(1) Opinion A-G Verkade, 13 May 2005 in *Souza Cruz v Tabacalera*, R04/077 Dutch Supreme Court. Para 2.02, Alexander Tsoutsanis "Trade Mark Registrations in Bad Faith" Oxford University Press, New York, 2010, p. 13.

(2) A larger proportion of countries are first to file and include Algeria, Anguilla, Argentina, Austria, Belarus, Belize, Benelux, Bolivia, Botswana, Brazil, Chile, China, Colombia, Croatia, Curacao, Czech Republic, Dominican Republic, Ecuador, El Salvador, Estonia, European Union, Finland, France, Germany, Greece, Guatemala, Hungary, Iran, Japan, Jordan, Kazakhstan, Kuwait, Kyrgyzstan, Lithuania, Mexico, Moldova, Montenegro, Nicaragua, Nigeria, Norway, Peru, Philippines, Poland, Qatar, Romania, Russian Federation, Slovenia, South Korea, Spain, Syria, Taiwan, Uganda, Ukraine, United Kingdom, Venezuela, Vietnam, and Zambia. See: First To File Versus First To Use, Available at [First To File Versus First To Use - Corsearch](#). Last visit: June 24, 2023. At 11:44 AM.

(3) "Making a Mark - An Introduction to Trademarks for Small and Medium-sized Enterprises" World Intellectual Property Organization, WIPO Publication No. 900.1E. p.p. 29-30.

(4) Jonathan H. Love and Patrick Ngalamulume "China: Brand Protection In China—Beware Of Trademark Squatting" 15 September 2022, Article Available at: <https://www.mondaq.com/china/trademark/1230594/brand-protection-in-chinabeware-of-trademark-squatting> Last visit: June 24, 2023. At: 11:47 AM.

## 1. Well-known mark as an exception from the first-to-file system and national legislations obstacles:

The question here, Is the international protection of the well-known mark is sufficient to protect it from squatters?

Paris Convention provides in its Article 6bis that a well-known trademark must be protected even if it is not registered in the country. Article 6bis is restricted to identical and similar goods, however. Often well-known trademarks are used by pirates on totally different goods, or for services. Furthermore, courts sometimes require a trademark to be well-known in the country where piracy is discovered, and deny protection, even if the true owner of the trademark can prove that it is internationally well-known in a considerable number of other countries<sup>(1)</sup>.

As a result, the well-known mark is an exception from the first-to-file system but Provided that the mark has a cross-border reputation in the country which can be demonstrated before courts by way of documents, the squatter may be restrained by a Court. The Court may also grant damages in favor of the proprietor of the well-known trademark. However, if the said trademark does not enjoy cross-border reputation (registered or became popular in its home country), it will be difficult for a proprietor to protect rights in the trademark. As a result, the proprietor may have to negotiate with the squatter for the purchase of the trademark or involve in long-drawn legal proceedings before the tribunal and/or the Court<sup>(2)</sup>.

The legislation and the judiciary in Egypt stipulated that the trademark must be well-known internationally and in Egypt as well, in order for the provisions of the aforementioned Paris Convention to be applied to it.

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(1) WIPO Intellectual Property Handbook, WIPO Publication No. 489 (E), Second Edition, Reprinted 2008, P. 90.

(2) Anoop Verma & Rajalakshmi R "Trademark squatting – Jurisdictional perspectives" 18 August 2022, Available at: <https://www.lakshmisri.com/insights/articles/trademark-squatting-jurisdictional-perspectives/#> Last visit: June 24, 2023. At: 11:49 AM.

Article 68 from Egyptian Intellectual Property Protection Law No. 82 of 2002 stated that “The owner of a well-known trademark, worldwide and in Egypt, shall have the right to enjoy the protection conferred by this Law even if such a mark is not registered in Egypt”.

The Egyptian council of states ruled that “The plaintiff company stated that its trademark is one of the well-known trademarks. And since the Intellectual Property Protection Law promulgated by Law No. 82 of 2002 stipulated that the mark enjoy protection - in the event that it was not registered in Egypt - that it be well-known, then it enjoys the legal protection stipulated in the Egyptian law. This, and since the trademark of the plaintiff company has not been proven famous in Egypt, because... In addition, the trademark owned by the plaintiff company was not registered in Egypt until it obtained the protection stipulated in the Intellectual Property Protection Law No. 82 of 2002. Hence, the contested decision is to reject the objection and register the trademark of the defendant company No. (137500)...The present lawsuit becomes lacking in its legal support is worthy of rejection<sup>(1)</sup>”.

## **2. Practical problems of the first-to-file system:**

### **China:**

This emphasis on being the first-to-file for trademark applications to obtain priority rights has led to prolific trademark application filings, with 371 million trademark applications filed and 5.007 million approved for registration in 2018, and widespread trademark squatting in China<sup>(2)</sup>.

Some brand owners use their marks without registration in China because they believe squatters are unlikely to target their unregistered marks. But squatters are always looking for new victims. And they do not limit their sights to large corporations like Starbucks, Apple, and Tesla, each of which has faced off against trademark squatters in China. The

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(1) State Council, Administrative Court, Economic and Investment Disputes Department, Seventh Circuit, Session 5/23/2015, Case No. 34440 of Judicial Year 65.

(2) “First-to-use versus first-to-file trademark regimes” Red Points, Article available at: <https://www.redpoints.com/blog/first-to-use-vs-first-to-file-trademark/> Last visit: June 24, 2023. At: 11:50 AM.

cost of registering a mark in China is minimal and squatters will go after almost any mark if there is any chance of scoring a payoff from a brand owner<sup>(1)</sup>.

applicants filed thousands of applications in China, with the intent of brokering the registrations, not to use the marks in commerce. For example, one company filed nearly 6,000 applications in one day, and there are reports of one individual hoarding more than 100,000 registrations. China recently revised its trademark laws to combat these bad-faith trademark registrations. The amendments provide the Chinese Trademark Office with the ability to reject applications that are not made for the purpose of using the trademark. But China remains a hotbed for trademark squatting<sup>(2)</sup>.

### **Turkey:**

often trademark squatters take advantage of the lack of local trademark registration, by legally registering the trademark in their own name. Since Turkey applies a 'first to file' system in terms of trademark protection, it is not possible to avoid such local registration unless an opposition is filed on time by the real owner before the trademark is registered in the name of another person. The Turkish Patent Institute does not require any evidence on the first use of the trademark and does not investigate if the trademark was stolen or not. Therefore, brand owners who have not yet filed to register their trademarks in Turkey may discover that their trademarks have already been registered by a third party<sup>(3)</sup>.

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(1) Jonathan H. Love and Patrick Ngalamulume, op.cit.

(2) Ipid.

(3) Esra Tekil "Ways to fight trademark squatting in Turkey" *Financier Worldwide Magazine*, June 2013 Issue. Available at: <https://www.financierworldwide.com/ways-to-fight-trademark-squatting-in-turkey#.Y6S1anZBy3C> Last visit: June 24, 2023. At: 11:52 AM.

## **B. First to Use<sup>(1)</sup>:**

In first-to-use countries, the owner of the trademark is the person who is the first to use the trademark in the marketplace, irrespective of whether the trademark has been registered. The rights arising out of such actual use are often referred to as “common law” or “unregistered” trademark rights<sup>(2)</sup>.

### **This system is characterized by the benefits enjoyed by prior users. They can<sup>(3)</sup>:**

Opposition of applicants: In a USA opposition proceeding, Blast Blow Dry Bar LLC v. Blown Away LLC d/b/a Blast Blow Dry Bar, the opposer alleged the likelihood of confusion and prior use. The applicant could only rely on the date of filing (i.e., the date of constructive use), on the other hand, the opposer depended on its promotional and hairstyling services (both before the application date) to establish actual use. so the opposition was upheld.

Cancellation of a trademark: A prior user can cancel a registered mark upon proof of prior rights. In a USA Trademark Trial and Appeal Board (TTAB) proceeding named Boi Na Brasa LLC v Terra Sul Corporation a/k/a Churrascaria Boi Na Brasa, this issue arose. The prior user sought to cancel the registrant’s wordmark due to the likelihood of confusion with the former’s trademark, and the cancellation was successful.

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(1) First-to-use countries include Aruba, Australia, Brunei Darussalam, Canada, Costa Rica, Cyprus, Denmark, Fiji, Hong Kong, Iceland, India, Ireland, Israel, Jersey, Kenya, Lebanon, Malawi, Malaysia, Malta, New Zealand, Papua New Guinea, Puerto Rico, Samoa, Singapore, South Africa, Swaziland, Trinidad & Tobago, United States, Uruguay, and Zimbabwe. Many of these registries will have specific limitations and conditions regarding ‘first to use’ rights and it is virtually always the case that registration of a brand as a trademark will confer stronger and less disputable rights than relying on use in any event. See: First To File Versus First To Use, Available at: [First To File Versus First To Use - Corsearch](#) Last visit: June 24, 2023. At: 11:53 AM.

(2) “Making a Mark - An Introduction to Trademarks for Small and Medium-sized Enterprises”, op. cit. p.p. 29-30.

(3) Mercy Munachimso Nwaogazie “First to file v first to use: comprehensive analysis of both systems in the context of trademark registration” Article Available at: <https://blog.iplayers.in/first-to-file-v-first-to-use/> Last visit: June 24, 2023. At: 11:53 AM.

Trademark squatting may not take place in this system even though the first use of the trademark establishes ownership or determines who initially owns the trademark rights. More importantly, using a mark to obtain trademark rights is very difficult for trademark squatters. First, squatters may not really want to use the marks in goods or services. They may have to provide accurate and reliable information about themselves to consumers<sup>(1)</sup>. Second, trademark uses cost a lot of money. For instance, squatters may have to determine whether their proposed marks have been used in the marketplace by conducting researches or having a professional trademark research firm conduct a thorough search for them<sup>(2)</sup>.

### **Malaysia:**

The Malaysian High Court<sup>(3)</sup> decided that the first user of a mark in Malaysia would prevail over a subsequent user. In this case, the plaintiffs and/or their predecessors in title were the first in time to use the “TAMIN” trademark in Malaysia. The use of “TAMIN” by the plaintiffs and/or the predecessors in title commenced in 1951 whereas the defendants commenced use of the “TAMIN” trademark at the very earliest in the 1990s. This use is well after the introduction of the “TAMIN” trademark by the plaintiffs. The High Court’s decision was upheld on appeal.

Pursuant to Section 25 of the Trade Marks Act 1976, any person claiming to be the proprietor of a trademark may make an application to the Registrar for the registration of that mark.

In theory, it allows any person to file an application to register a trademark. In the event, it is a scenario of a trademark squatter that

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(1) Paul L. Bonewitz, “Note, Beyond Confusion: Reexamining Trademark Law’s Goals in the World of Online Advertising” 81 ST. JOHN’S L. REV. 2007, p. 899.

(2) Kitsuron Sangsuvan “TRADEMARK SQUATTING” Wisconsin International Law Journal, Vol. 31, No. 2, 2013, P. 262.

(3) The Malaysian High Court, Syarikat Zamani Hj Tamin Sdn Bhd & Anor v Yong Sze Fun & Anor [2012 1 MLJ 585].

succeeds in registering the same, the true proprietor i.e. the first user (especially for small and medium enterprises) may be put in a dilemma to decide whether to pay a ‘ransom’ in order to acquire its own mark or fight it out in court which in either case, will incur a substantial cost. To provide some check and balance against the above scenario happening, the Malaysian Registry has a practice that requires all trademark applicants to submit a Statutory Declaration to affirm that they are the bona fide proprietor of the trademark to be registered before a Commissioner for Oaths. Any person giving false declaration is punishable under the Penal Code (criminal offense) pursuant to Section 3 of the Statutory Declarations Act 1960<sup>(1)</sup>.

### **Australia:**

Adopts a ‘first to use’ approach to trademarks. This means that if squatters aren’t the first to use a trademark, it’s fairly easy to undermine their ownership of it. If a ‘squatter’ wants to use a trademark registration to make a profit, they have to be the first to use it in Australia. Even if a ‘squatter’ is the first user, you can oppose their trademark registration. Grounds for opposition include no intention to use it, and bad faith applications. The Patent Examiner’s Manual provides useful examples of what a bad-faith application looks like. These examples capture trademark squatting. One example involves a person who identifies overseas trademarks which haven’t been used in Australia yet. If they register it ‘for the express purpose’ of selling it to overseas owners when they enter the Australian market, this would be in bad faith<sup>(2)</sup>.

### **C. Combining the “first-to-use” with the “first-to-file” system:**

Other countries managed to strike a better balance, in combining the first-to-use principle with the first-to-file system, such as, for example,

(1) Chin Khang Juin “Trade Mark Protection for First User” Henry Goh & Co. Available at: <https://henrygoh.com/downloads/trade-mark-protection-for-first-user.pdf> Last visit: June 24, 2023. At: 11:55 AM.

(2) Beulah Pene “What Is Trademark Squatting?” April 16, 2021. Available at: <https://lawpath.com.au/blog/what-is-trademark-squatting> Last visit: June 24, 2023. At: 11:56 AM.

Belgium (1879) and the United Kingdom (1938). The fact that countries can run a first-to-use alongside a first-to-file system is still recognized today in the preamble of the Trademark Directive and in Article 16-1 TRIPs<sup>(1)</sup>.

### **Egypt:**

According to Article 65 of the current Intellectual Property Rights Protection Law No. 82 of 2002, ownership of a mark arises through use and not through registration, and registration is only evidence of the priority of use. This presumption is simple, and its reversal may be proven within the five years following the date of registration. This means that the law protects the one who used the mark even though he did not register it, provided that if the mark was registered and the registration was associated with its use without a dispute from anyone within the five years following the date of registration, then the presumption becomes conclusive, and no one is accepted to claim ownership of it on the basis that he was earlier in using it The mark in whose name it is registered<sup>(2)</sup>.

It should be noted that the current law has set aside Article 3 of the repealed Law No. 57 of 1939, which was previously argued to be unconstitutional based on giving preference to the ownership of the mark to those who did not register it in the first place and was able to prove that he used it at a date prior to its registration. Thus, the text is contrary to the provisions of Articles (4, 23, 32, and 49) of the Constitution.

However, the Supreme Constitutional Court found that there was no loss of precedence in registering a mark. Rather, the legislator sought, through this text, to establish a justified and justifiable balance between the interest of the one who initiated the registration of the mark, and

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(1) Alexander Tsoutsanis op.cit, p. 15.

(2) Dr. Walid A. M. Amin "Registration of Trademarks internationally according to Madrid System between the international texts and the national legislation for the United States of America, European Union and the Arab Republic of Egypt (Legislatively, jurisprudence, and judiciously) first edition, 2021, p. 718.



the interest of the one who used it on a date prior to its registration. Making the resolution of this matter - in the event of a dispute - in the hands of the judiciary. It aims to achieve a legitimate goal. As a means of distinguishing products and commodities with the aim of contrasting them in order to remove any confusion. The legislator was committed to choosing the legislative pattern that he saw as logically related to the purposes he pursued. Without violating the provisions of the Constitution<sup>(1)</sup>.


However, the field is open to trademark squatters; As there is nothing to prevent the filing of trademark registration applications for unused marks, and there is no requirement for the owner of the registered mark to provide evidence of his use of the mark that was previously registered.

V. Efforts to confront the trademarks squatting in comparative law:

We will address the efforts exerted to confront the trademarks squatting, whether judicial or legislative efforts, as follows:

### A. judicial efforts:

#### China:

“**In-Sink-Erator**” Case<sup>(2)</sup>: In-Sink-Erator – is a world-renowned brand in the field of food waste disposers. Emerson Electric Co. (“Emerson”) filed to register the In-Sink-Erator trademarks in Latin and Chinese characters in China in 1994 and 1998, respectively, and filed to register of the graphic trademark “” in 2006.

(1) Case No. 209 of Judicial Year 23 (Constitutional), Session 7 of March 2004 AD, No. 74, pg. 458 et seq.

(2) Xu Jing and Ye Wanli “Trademark Piracy Results in Civil Liabilities? Note on Emerson Electric V. Xiamen Anjier” April 15, 2022. Available at: <https://www.kwm.com/cn/en/insights/latest-thinking/trademark-piracy-results-in-civil-liabilities-note-on-emerson-electric-v-xiamen-anjier.html>. Last visit: June 24, 2023. At: 12:02 PM. See also: *Dan Plane* “In-Sink-Erator Case Demonstrates Chinese Courts’ Increasing Willingness to Punish Trademark Piracy Using the AUCL” SEPTEMBER 1, 2022. Available at: [https://sips.asia/knowledge/trademark-enforcement/in-sink-erator-case-demonstrates-chinese-courts-increasing-willingness-to-punish-trademark-piracy-using-the-aucl/#\\_ednref1](https://sips.asia/knowledge/trademark-enforcement/in-sink-erator-case-demonstrates-chinese-courts-increasing-willingness-to-punish-trademark-piracy-using-the-aucl/#_ednref1). Last visit: June 24, 2023. At: 12:03 PM.

These trademarks were approved for registration on goods in Class 7 “Food Waste Disposer” and Class 11 “Water Purification Device” (the “In-Sink-Erator Trademarks”). In-Sink-Erator Trademarks had enjoyed a certain degree of fame in China as early as 2010 by Emerson’s continuous and extensive use in commerce.

Xiamen Anjier Water Angel Drinking Water Equipment Co., Ltd. (now called as Xiamen Home Spring Drinking Water Equipment Co., Ltd., “Xiamen Anjier”) was established in 2008. Starting from December 2010, Xiamen Anjier filed to register trademarks that were identical with the In-Sink-Erator Trademarks on goods and services that were closely associated with those offered by Emerson in several classes. Emerson had to file oppositions, opposition appeals and even court appeals against decisions on opposition appeals to defeat these bad-faith filings. After Beijing High People’s Court ruled in its appellate review that Xiamen Anjier’s piracy violated Article 41 of the Trademark Law (2001)<sup>(1)</sup>, the legal representative of Xiamen Anjier – Wang Yiping – registered another company called Xiamen Hai Na Bai Chuan Network Technologies Co., Ltd. (“Xiamen HNBC”) to continue the piracy with Xiamen Anjier.

As of the filing date of the civil action, Xiamen Anjier and Xiamen HNBC had filed 48 trademarks that were identical or similar with the In-Sink-Erator Trademarks in 14 classes, 47 of which were represented by the same trademark agent named Xiamen Xingjun Intellectual Property Co., Ltd. (“Xiamen Xingjun”).

In March 2020, Emerson sued Xiamen Anjier, Xiamen HNBC, Wang Yiping and Xiamen Xingjun for unfair competition with Xiamen Intermediate People’s Court, seeking injunctive reliefs, damages, and an order for eliminating negative effects. On April 22, 2021, Xiamen Intermediate People’s Court rendered its first-instance judgment<sup>(2)</sup>,

(1) Case Docketing Numbers: (2015) Gao Xing (Zhi) Zhong Zi Nos. 3968, 3969, 3970, and 3978.

(2) Case Docketing Number: (2020) Min 02 Min Chu No. 149.

finding that the defendant's trademark piracy violated Article 2 of the Anti-Unfair Competition Law. Xiamen Anjier, Xiamen HNBC and Wang Yiping constituted joint infringement, and Xiamen Xingjun constituted contributory infringement. The court issued an injunctive order against all four defendants enjoining them from filing to register any trademarks that are identical or similar with the In-Sink-Erator Trademarks, granted an award of damages to compensate Emerson for the losses of attorney fees and reasonable expenses incurred by stopping trademarks piracy, and issued an order to the defendants to make a statement on a national-wide media to eliminate negative effects. Xiamen Anjier and Xiamen HNBC withdrew all trademark applications before the hearing. On September 27, 2021, Fujian High People's Court rejected the appeals filed by the defendants and affirmed the first-instance judgment<sup>(1)</sup>.

This is the very first case the People's Court finds that trademark piracy without substantial use or malicious assertion of the pirated marks also constitutes a violation of Article 2 of the Anti-Unfair Competition Law.

The first-instance court first clarifies that the dispute is actionable, that is, a civil claim for recovery of attorney fees against trademark piracy is a lawsuit for civil liability arising from property relations as the result of trademark piracy and can be adjudicated in a civil court. In the meantime, the court clarifies that the trial of such civil disputes does not interfere with CNIPA's administrative authority over managing the trademarks registration system.

The court rules that the "In-Sink-Erator" Trademarks had already had a certain influence in the field of food waste disposers and water purification devices as early as 2005. Xiamen Anjier and Xiamen HNBC could not provide a reasonable explanation for their intention for these filings and their "source" of the design related to register identical or similar trademarks on different classes, which obviously exceeds their

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(1) Case Docketing Number: (2021) Min Min Zhong No. 1129.

needs in normal business operation. Furthermore, the court further holds that Xiamen Anjier's piracy forced Emerson to file oppositions, invalidations, administrative court appeals and finally civil lawsuits to safeguard its legitimate rights and interests, which to a certain extent interfered with the normal business operation of Emerson. In addition, the court also considered the fact that Xiamen Anjier, Xiamen HNBC and Wang Yiping, their legal representative and person in charge, had filed to register trademarks identical or similar with more than 100 trademarks that were identical or similar to famous brands in China, such as Dow, Daimler, Unilever, etc.

Based on the above facts, the first-instance court holds that the two defendants' piracy of the In-Sink-Erator Trademarks violated the principle of good faith, disrupted the order of fair market competition, damaged the legitimate rights and interests of the plaintiff, violated Article 2 of the Anti-Unfair Competition Law, and constituted unfair competition.

### **India:**

India, in its Trademarks Act, has provided for the protection of foreign trademarks concerning the "Trans-border Reputation" principle.

**Dongre v. Whirlpool Corporation<sup>(1)</sup>:** Plaintiff used to distribute products to US Embassy in India exclusively, but after some time they entered into a partnership with TVS, and subsequently the mark registered to them was abandoned by them and hence was registered by the defendant. This registration was opposed by TVS Whirlpool, but the opposition was not accepted by the registrar of the trademark. Although on finding out that the company owned by NR Dongre was marketing inferior quality machines under the name Whirlpool, TVS Whirlpool filed an appeal in the High Court seeking a permanent injunction.

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(1) N.R. Dongre and ORS. V Whirlpool Co. and ANR., HON'BLE Supreme Court of India, (1996) 5 SCC 714, 30th August 1996.

The Hon'ble Supreme Court observed that the Whirlpool Corporation was the prior user of the trademark since the year 1937, however, the appellants applied for the said trademark only in 1986. The Court stated that the principle on which passing off action is based states that no person must sell his goods as the goods of another.

The Court further stated that 'whirlpool' is the registered trademark of the respondents since 1937 in 65 countries wherein they have continuously been in business. It was also noted that even though Whirlpool products were only sold to the US embassy in India, however, the brand name 'Whirlpool' was often advertised in international magazines having wide circulation in India and as a result, it was gaining a well-known reputation in India. Subsequently, the respondents acquired a transborder or spillover reputation with the 'Whirlpool' mark by which people identified washing machines and other such electrical goods.

The Court also stated that since the mark 'whirlpool' has become synonymous with washing machines and other such electrical appliances of the respondents, the people intending to buy their goods will most likely be confused or deceived if the appellants continue to sell their goods under the same mark 'whirlpool'. If the appellant is allowed to sell his goods under the same mark then the respondents might suffer heavily as the goods sold by the appellants are of inferior quality than that of the respondents. Based on the above-mentioned grounds, the Apex Court upheld the decision of the Delhi High Court and dismissed the appeal with a cost of Rupees 10,000.

This case has thereby set a precedent for the recognition of the doctrine of trans-border reputation and trademark squatting in India<sup>(1)</sup>.

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(1) Archi Bhatia, op.cit.

## **Egypt:**

**The court halted the trademark registration procedures due to bad faith<sup>(1)</sup>:** Since the plaintiff company was the first to use its trademark in the Arab Republic of Egypt, through its agent - the defendant - which was acknowledged by the defendant in the memorandum of understanding. But it did not abide by that agreement and proceeded to register the mark in its name. After the plaintiff company turned to another Egyptian agent - Al-Yamama Trading and Distribution Company - the defendant company then made a police record. Harmful to the plaintiff company whose goods were withheld, and were not distributed in the Arab Republic of Egypt because of these police records.

Accordingly, the initiative of the defendant company to request the registration of this mark in its name entails bad faith and malicious intent for the plaintiff company, and since the management has rejected the plaintiff company's objection, and has decided to proceed with the procedures for registering this mark, then it has violated the provisions of the law and the considerations for which it was legislated. Then the court decided to cancel the decision with the consequences that would follow, the most important of which is the suspension of the registration of the aforementioned mark in the name of the defendant company. It is worth noting that the Supreme Administrative Court approved this ruling.

## **B. legislative efforts:**

### **Australia:**

Until the Act was amended by the Trade Marks Amendment Act 2006 there was no provision for opposing registration on the basis that the application for registration was made in bad faith. The Registrar's experience had shown that such a provision was necessary because of instances where trademark applicants deliberately set out

(1) Appeal No. 28008 for the year 56 BC. Supreme Administrative Court. Fifth arrondissement. Saturday session, June 4, 2011 AD.

to gain registration of their trademarks, or adopted trademarks, in bad faith. Examples included:...

“persons who identify trademarks used overseas but with no Australian use as yet who then apply to register the trademarks in Australia for the express purpose of selling them to the overseas owners”<sup>(1)</sup>.

The Patent Examiner’s Manual provides useful examples of what a bad-faith application looks like. These examples capture trademark squatting. One example involves a person who identifies overseas trademarks which haven’t been used in Australia yet. If they register it ‘for the express purpose’ of selling it to overseas owners when they enter the Australian market, this would be in bad faith<sup>(2)</sup>.

### **India:**

Section 34 protects the rights of individuals who have been using their marks continuously for a considerable duration. The provision establishes that no party with a registered trademark will be allowed to violate the rights of another party who has been using a similar/identical mark, in the same class of goods or services, prior to (I) the first date of use of such trademark or (II) the date of registration of the trademark.

The key elements to the following provision are – (I) the marks in contention must be in similar classes based on goods or services (as per the NICE classification) (II) the usage of the unregistered mark must be continuous in duration and must not have been interrupted (III) the unregistered mark must have been in use prior to the date of registration of the latter mark or the first date of use established in the registration of the latter mark<sup>(3)</sup>.

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(1) Australian Trademarks Manual of practice and procedure “46.4. Grounds for opposition to registration of national trademarks - 4.8 Registration may be opposed on the ground that the application was made in bad faith – 62A” Date Published 20 Apr 2022, Available at: [46.4. Grounds for opposition to registration of national trade marks | IPA Manuals \(ipaaustralia.gov.au\)](https://www.ipaustralia.gov.au/46.4-Grounds-for-opposition-to-registration-of-national-trade-marks-IPA-Manuals) Last visit: June 24, 2023. At: 12:07 PM.

(2) Beulah Pene, op.cit.

(3) Trade Marks Act, 1999, § 34, No. 47 of 1999, India Code.

## **China:**

On 13 January 2023, the China National Intellectual Property Administration (CNIPA) issued a draft amendment to the Trademark Law with the goal of strengthening the regulations relating to bad faith trademark registration. The draft aims to continue to up the ante in the fight against bad faith squatters and these new amendments seek to codify landmark court rulings (i.e. trade mark hijacking attracts tortious liability and constitutes unfair competition), incorporate best practices, as well as reinforce regulations against these squatters. Interestingly, a mechanism to transfer squatted trademarks to their rightful owners has been proposed. Other amendments aim to remove bad faith or unused registrations from the trademark register by prohibiting duplicate applications and implementing a proof of use requirement every five years<sup>(1)</sup>.

### **The main features of the draft are<sup>(2)</sup>:**

Article (22) defines “bad faith” trademark registration as:

- Applying for a large number of trademark registrations without the purpose of use, thereby disrupting the order of trademark registration;
- Applying for trademark registration by deception or other improper means;
- Applying for registration of a trademark that is harmful to national interests, social public interests, or has other major adverse effects;

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(1) Rachel Tan, and others “China: Public Comment Sought For Proposed Amendments To The Chinese Trade Mark Law” 31 January 2023, Available at: <https://www.mondaq.com/china/trade-mark/1277072/public-comment-sought-for-proposed-amendments-to-the-chinese-trade-mark-law#:~:text=China%3A%20Public%20Comment%20Sought%20For,The%20Chinese%20Trade%20Mark%20Law&text=On%2013%20January%202023%2C%20the,bad%20faith%20trade%20mark%20registration>. Last visit: June 24, 2023. At: 12:07 PM.

(2) Arendse Huld “Amendments to China’s Trademark Law – Improving IP Use and Protection” *China Briefing*, February 20, 2023, Available at: <https://www.china-briefing.com/news/amendments-to-china-trademark-law-improving-ip-use-and-protection/> Last visit: June 24, 2023. At: 12:49 PM.



- Violating the provisions of Articles 18 [prohibiting the copy, imitation, or translation of a well-known trademark], 19 [restricting agents or representatives from registering trademarks of the principal or represented person in their own name without authorization], and 23 [restricting preemptive registration of a trademark that already has a certain level of influence] of this Law, deliberately damaging the legal rights or interests of others or seeking illegitimate interests; or
- Applying for trademark registration in other malicious ways.

The new draft amendments also outline the penalties for violation of the provisions of Article 22. Under Article 67 of the draft amendments, engaging in any of the above behavior can result in a warning and a fine of up to RMB 50,000 (US\$7,280). In serious cases, a fine of RMB 50,000 to RMB 250,000 (US\$36,402) may be imposed. Any illegally gained income will also be confiscated. Meanwhile, Article 83 allows for people or businesses that have been impacted by one of the “bad faith” registration behavior described above to file a lawsuit in a people’s court, if the illegal behavior causes a loss. The compensation must cover at least the reasonable expenses paid by the other party to stop the bad-faith application for trademark registration.

### **Egypt:**

It appears from the text of Article 65 of the Egyptian Intellectual Property Rights Protection Law No. 82 for the year 2002 that the basic principle in registering a mark is that it does not in itself create a right in its ownership, and registration is only a presumption of it, which every interested party may refute and undermine, by establishing evidence of the precedence of using the mark. As an exception to this, the legislator confirmed the ownership of the mark to the one who registered it and continued to use it permanently for a period of five subsequent years,

without being challenged by anyone in that through a lawsuit in which the dispute was ruled valid so that the registration becomes after the expiry of this period establishing the right of ownership over the mark. Unless the registration was done in bad faith, then the commitment to this deadline is lifted<sup>(1)</sup>.

However, there are many cases of trademark squatting of well-known marks; because the law required to protect the well-known mark, the mark must be well-known in Egypt as well.

As a result, as soon as the rightful owners of the mark begin to register it, it seems to them that it was previously registered by the squatters. Negotiations begin to transfer the registration to them.

So, in my humble opinion, the Egyptian legislator should take advantage of the Chinese draft bill, Where he must follow suit in the following points:

- Proposing a mechanism to transfer squatted trademarks to their rightful owners.
- Remove bad faith or unused registrations from the trademark register by implementing a proof of use requirement every five years.
- The broadening of the concept of bad faith to include the filing of a large number of trademark applications without the purpose of use, applying for trademark registration by deception or other improper means, or applying for registration of a trademark that is harmful to national interests, and social public interests.
- Prohibiting the copy, imitation, or translation of a well-known trademark.
- Restricting agents or representatives from registering trademarks of the principal or represented person in their own name without authorization.
- Restricting preemptive registration of a trademark.

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(1) Dr. Walid Amin, op.cit, p. p. 928-929.

## VI. CONCLUSION:

This research sheds light on the phenomenon of “trademark squatting” which threatens foreign investment in the world with its impact. Comparative law was researched to find out the best mechanisms to confront it. The research concentrated on three main points;

**First:** What is Trademark Squatting? It was necessary to research an issue of what is the subject of trademark squatting, In order to get to know this phenomenon more clearly, it was necessary to shed light on practical cases.

**Second:** We searched here How does trademark squatting works in the context of ‘first to file’ and ‘first to use’ jurisdictions?

Egypt combines the “first-to-use” with the “first-to-file” system. However, the field is open to trademark squatters; As there is nothing to prevent the filing of trademark registration applications for unused marks, and there is no requirement for the owner of the registered mark to provide evidence of his use of the mark that was previously registered.

**Third:** Efforts to confront the trademarks squatting in comparative law. Whether judicial efforts or legislation efforts.

### Recommendations:

By the end of this research, I have the honor to draw the attention of the Egyptian legislator to the need to benefit from the Chinese draft bill, to amend the Egyptian Intellectual Property Law No. 82 of 2002 to ensure the following points:

- 1) Proposing a mechanism to transfer squatted trademarks to their rightful owners.
- 2) Remove bad faith or unused registrations from the trademark register by implementing a proof of use requirement every five years.

- 3) The broadening of the concept of bad faith to include the filing of a large number of trademark applications without the purpose of use, applying for trademark registration by deception or other improper means, or applying for registration of a trademark that is harmful to national interests, and social public interests.
- 4) Prohibiting the copy, imitation, or translation of a well-known trademark.
- 5) Restricting agents or representatives from registering trademarks of the principal or represented person in their own name without authorization.
- 6) Restricting preemptive registration of a trademark.

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## الاستيلاء على العلامة التجارية في مصر والقانون المقارن

د. وليد أحمد محمد أمين

دكتوراه في القانون، كلية الحقوق، جامعة بني سويف - مصر

### المستخلص

ركزت هذه الدراسة على إحدى العقبات التي تعرقل جذب الاستثمار الأجنبي، ليس في جمهورية مصر العربية فحسب، بل في عديد من البلدان.

فحينما تفكر أي مؤسسة في تمديد نشاطها إلى دولة أخرى، فلا بد أن تضمن أولاً حماية منتجاتها في هذا البلد. والذي يبدأ بتسجيل علامتها التجارية، وتكمن المشكلة حين تضاجئ الشركة بسبق تسجيل علامتها في هذا البلد. فهذه ليست مصادفة، بل هناك من كان يتابع هذه العلامة، وكان متوقعاً دخولها في هذا السوق في وقت قريب، وتعتمد تسجيل علامتها باسمه؛ ليبدأ في مساومة صاحبها للتنازل له عليها.

وغالباً ما يتم استهداف العلامات التجارية ذائعة الشهرة؛ فمن المتوقع دخول هذه العلامات في أغلب دول العالم في وقت قريب. ولدى أصحابها القدرة المالية على دفع الإتاوات التي سيتم طلبها. وهو ما حدث مع شركة أبل، وشركة ستاربكس، وغيرهم.

وقد رغبت عديد من الشركات عن دخول أسواق بعض البلدان بسبب هذا النوع من القرصنة على العلامات والذي يسمى «الاستيلاء على العلامات». ما دفع بعض البلدان إلى محاولة التصدي لهذه الظاهرة، فبدأت لنا جهود قضائية، وأخرى تشريعية.

وبات من الملح الولوج في هذا البحث الذي يستعرض مشكلة الاستيلاء على العلامات التجارية الأجنبية في بلدان مختلفة، ودور القضاء، والمشرعين في القانون المقارن، في مواجهة هذه الظاهرة التي باتت تهدد الاستثمار الأجنبي، ولنقدم للمشرع المصري تجارب قضائية، وتشريعية لدول أخرى؛ تُمكنه من مواجهة ظاهرة الاستيلاء على العلامات الأجنبية.

الكلمات المفتاحية: الاستيلاء على العلامة التجارية - تسجيل العلامات التجارية - أول من أودع - أول من استخدم - القانون المقارن.