

COVID-19 IN THE CONCEPT OF THE GCC TRADEMARK LAW: THE EMERGENCE OF A NEW DISTINCTIVE SIGN

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ABSTRACT

Covid-19 Indubitably, this new term is the most used designation all over the World in 2020. It is not restricted to any part of the society neither to any specific country or human activity or age; it is used by everyone, everywhere, in both real world and virtual platform.

A quick search using the keywords Covid-19 and “intellectual property rights” (IPR), will mainly yield articles about the impact of Covid- 19- as a pandemic-on the protection of IPR and the measures to be taken by the World Intellectual Property Organization (WIPO) or other entities-providing legal services related to intellectual property-to preserve the pre-owned IPR and the means of assuring the sustainability of this protection during this pandemic.

Nevertheless, in addition to the necessity of preserving the protection of IPR during this pandemic, a need to analyze and study the legal status of Covid-19 is today eminent: the most used designation as an element of the IPR constituting a new distinctive sign (DS). In turn, this study will analyze Covid-19 not as a “pandemic” but as a “DS”. This study will be the first of its kind in the field of IPR paving the way towards the recognition of the legal status of Covid-19 as a new DS: this is vital knowing that the use of this term must be regulated to avoid confusing or misleading the consumer; such use has to be in conformity with the laws of the distinctive signs prohibiting illegal use as per article 3 of the GCC Trademark Law (GCC TM). This study will reflect how the protection of Covid-19 is recognized as a new DS and its relation with the GCC TM focusing on the International means of protection through Paris Convention and the European Law and mainly the French Law due to the similarities in the stipulations of the French Law especially with regard to article 3 of the GCC TM: in fact, article L 713-2 of the French Code of Intellectual Property enumerates, similarly to the GCC TM, the signs that cannot be registered as trademarks mainly those who are deceptive. The possibility of the protection of the Covid-19 designation as a DS will protect the consumer against any misleading or deceptive use of the aforementioned designation specially that the GCC Trademark Law has explicit stipulations in this regard as previously mentioned.

Keywords: Covid-19, Legal Status, Trademarks, GCC Trademark Law, Distinctive Signs, Confusion, Misleading, Deceptive, Consumer, Intellectual Property Rights.

INTRODUCTION

The World Health Organization (WHO) defines “Covid-19” as a disease caused by a new strain of coronavirus. “CO” stands for corona, “VI” for virus, and “D” for disease. Formerly, this disease was referred to as “2019 novel coronavirus” or “2019-nCov.” The COVID-19 virus is a

new virus linked to the same family of viruses as Severe Acute Respiratory Syndrome (SARS) and some types of common cold (World Health Organization, 2020).

The acronym, Covid-19, is used in the medical field to identify a disease as mentioned in the definition above. However, this identification goes beyond the process of identifying a disease specially that this acronym is nowadays used as a distinctive sign identifying products and/or services from other similar products and/or services mainly used as a disinfectant against Covid-19. In this perspective, the National Environment Agency posted on her website an interim list of household products and active ingredients for disinfection of the Covid-19 virus, (National Environment Agency, 2020). Moreover, some disinfectant products available in the market are using this acronym as a reference to identify that this particular product can be used as an antiseptic against Covid-19. Furthermore, some antiseptic products are referring in their safety messages that disinfecting products is one of the ways to help stop the spread of Covid-19, according to the Centers for Disease Control, (The Clorox Company, 2020). Additionally, other products are confirming that they are considered to be as disinfectants and disinfectant cleaners to be effective against Covid-19, (Sanosil, 2020). Consequently, and based on those examples of the different scenarios of using the neologism Covid-19 the following questions arise:

Why does the neologism Covid-19 accompany the use of trademarks to identify the role of the antiseptic products as mentioned above? Does it have any element of attraction vis-à-vis the consumer who finds himself attracted to buy a product by the acronym Covid-19 conferring a relation of trust and a better image in the eyes of the consumer? Are we witnessing the emergence of a new DS? Can the acronym Covid-19 be considered as a DS similarly to a trademark?

The omnipresence of the acronym Covid-19 in the different aspects of our daily life whether in educational, political, economic and many other activities, lead to this study having its merit in analyzing and studying the legal nature of the neologism Covid-19? Rules and regulations must be applicable to control the use of the neologism Covid-19. What if Covid-19 is used wrongly on a product misleading the consumer whose choice was based on the fact that this product is considered to be as a disinfectant against Covid-19? A wrong use of this acronym would cause harm for the consumer and the society if he was deceived and thought that he would be safe from Covid-19 because of the use of this particular disinfectant.

The recognition of the neologism Covid-19 as a DS will be conducted via an analytical study from two different perspectives:

- 1- Covid-19 in the sphere of the Distinctive Signs.
- 2- Covid-19 through the evolution of the concept of Distinctive Signs.

RESULTS AND DISCUSSION

Covid-19 in the Sphere of the Distinctive Signs

Definition of DS and the ability of Covid-19 to be integrated

The definition of the DS is a must in order to understand the concept and check the ability of the acronym Covid-19 to be inserted. The GCC TM, likewise the majority of the trademark laws, has not defined the concept of the DS. Nevertheless, the European doctrine offered a definition who defined the DS by the phonetic and visual means, particularly words or

images, used in the economic and social contexts of our life, for the purpose of designating persons or enterprises as well as the offered products and services in order to distinguish them enabling the consumers to identify them accordingly (Matheley, 1984). Other references are adopting the same approach and the role of the DS to identify the products and services (Hang, 2020). Based on the above, the acronym Covid-19 can be considered as a DS; Hang he is presented by both phonetic and visual means, moreover, words and images referring to this acronym are available quasi everywhere, and its use is omnipresent in our economic and social life identifying the enterprises and the products or services relative to Covid-19, enabling the consumer by that to identify the enterprises as well as the different products and services.

Consequently, if we are considering Covid-19 as a DS, we have to identify to which right it belongs since the concept of DS includes different rights such as trademarks, commercial names, domain names, etc. In other words, can we consider Covid-19 as trademark, commercial name or domain name? The aforesaid DS have in common the social and commercial functions and the relationship between them is obvious specially that the same distinctive sign can be used as trademark and domain name. From the practical approach, the designation Covid-19 is used as a domain name identifying websites, i.e. www.covid-19.com. If the domain name was considered and registered as a trademark (Khater, 2005; Beaurain & Jez, 2001), can we consider Covid-19 and register it as a trademark?

Trademark and Covid-19: Two Dependent Distinctive Signs

The GCC TM does not contain any express stipulation prohibiting the registration of Covid-19 as a trademark. However, the first paragraph of article 3 of the law contains an implicit stipulation prohibiting the registration of Covid-19 as a trademark mentioning that the following shall not be registered as a trademark or an element thereof:

“The mark having no property or distinctive character or that is made of data being only the name given by tradition to familiar goods, products, services or the ordinary drawings and pictures of goods and products.”

Accordingly, Covid-19 as an independent neologism-without being used along with a pre-existing trademark to identify products and or services-cannot be registered as a trademark as it is the way of identifying as disease by the (WHO) as mentioned previously since it is the name given to identify this pandemic. Additionally, the registration of a trademark confers its owner, according to article 7 of the law an exclusive right being the sole owner having the right to use it; hence it is unconceivable to grant the right this one owner to use Covid-19. If Covid-19 cannot be registered and owned by one person as analyzed before, nevertheless, it can be registered as a dependent distinctive sign accompanying a trademark based on the following discussion.

Despite the fact that the denomination Covid-19 is excessively used in both real and virtual words, however, the scenario of use differs from one person or one entity to another; Covid-19 might be used on the product or service along with the trademark to identify in the eyes of the consumer that this antiseptic product per example is anti-Covid-19 or that this medicine can heal from Covid-19 or that this vaccine is conceived for the aforementioned decease. Subsequently, this acronym is used dependently with the trademark augmenting its element of attraction and identification vis-à-vis the consumer playing the role of an auxiliary to the trademark. Based on the above, if the neologism cannot be registered as an independent

trademark, it can be registered along with a valid trademark augmenting its element of attraction and its distinctive role; per example, if XYZ is a valid trademark, we can register another trademark as XYZ Covid-19 linking by that the products identified by the trademark to a specific role it plays in connection with the disease as mentioned above. Having said that, Covid-19 can be registered along with a trademark as an element of differentiation and distinction conferring to the owner of such a trademark an exclusive right for such a use.

The concept of DS is not rigid. It is evolving along with the society and this evolution will play an additional role to what was demonstrated in the previous paragraph to insert Covid-19 in this concept.

Covid-19 through the Evolution of the Concept of Distinctive Sign

The concept of distinctive signs is in a perpetual evolution throughout the development of the functions of the distinctive signs: this functional evolution is showing the flexibility of the concept to include new distinctive signs likewise the acronym Covid-19.

Evolution through the existence of new distinctive signs

The use of distinctive signs date from the Antiquity. In the old Greece, signs were used on sculptures and paintings (Roubier, 1952), the Romans used to identify their potteries by specific signs as well (Chavanne & Burst, 1998), as for China and Japan, they were referring to their porcelain fabrications using specific signs (Roubier, 1952). On a later stage, new distinctive signs paved their way with the commercial and economic evolution within the society with the existence of new objects that must be identified and distinguished one from another. In fact, we have witnessed the emergence of new distinctive signs like the commercial name identifying a certain commercial activity related to a certain corporation as well as the domain names identifying the internet activities and the websites (Khater, 2005).

Evolution through the multiple functions of the distinctive signs

Distinctive signs are known for their commercial and social functions, (Marino, 2020); the acronym Covid-19 is going along with the commercial function of the distinctive signs while it is playing a crucial role to attract the consumers: In fact, the CEO of Clorox mentioned on CNBC in May 2020 that there is a "*high demand for disinfectant products amid coronavirus pandemic*", (Cramer, 2020). The above statement shows that the consumers are linking the purchase of Clorox products because they are considered and antiseptic against Covid-19; this neologism has augmented the demand and attracted the consumers and this is one of the major functions of distinctive signs played by Covid-19.

As for the social function of distinctive signs, Covid-19 seems to be joining the distinctive signs of the Red Cross or Red Crescent that were considered by Geneva Convention of 12 August 1949 as signs identifying the health and medical sector from other sectors (Cauderay, 1990).

CONCLUSION

Protection against illegal use of Covid-19

The novelty of the subject matter of this study renders it a challenge to recognize Covid-19 as a distinctive sign to prohibit its illegal use misleading and confusing the consumer. The GCC TM law constitutes a pillar for that protection specially that it is reflecting the interest of the Kingdom of Saudi Arabia to protect trademarks through the accession to different international treaties in line with such protection such as Paris Convention. From another perspective, the GCC TM is protecting the consumer prohibiting in the paragraph 9 of article 3 the registration of a TM of any sign that may mislead the public or include misstatements on the properties of the products or services. The Saudi Courts are implementing and applying the stipulation of the GCC TM law in this regard, and the issued decisions are canceling trademarks if they are source of deception and confusion vis-à-vis the consumer (Board of Grievances decision number 6439 of 2018, decision n. 5264 of 2017). In fact, the registration of a misleading sign, considered as an illegal sign, confers to the competent Authority and any concerned party according to article 22 of the GCC TM, the right to apply for the cancellation of that illegal sign before the courts of Jurisdiction.

In conclusion, we can affirm that in the context of the GCC TM, the use of this acronym must not mislead the public including misstatement on the properties of the products or services should they not have any effect or relation with Covid-19; if the GCC Courts did not encounter any case until now about conflicts that may arise from the legal status of Covid-19 as a distinctive sign, it does not mean that this will not happen soon. Meanwhile, the GCC TM law is delimiting the boundaries of the emergence of a new distinctive sign: Covid-19.

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