

**THE JORDANIAN INTELLECTUAL PROPERTY REGIME: TRIANGLE OF
COPYRIGHT, TRADEMARK, AND PATENT**

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Adhering to international intellectual property standards is crucial for accession to the WTO. In this context, Jordan substantially revised its intellectual property laws to comply with TRIPs by adding new provisions, covering existing gaps, and effectively enforcing the new laws. This is just the first step in a long and bumpy road to achieve higher level of protection but it is a step in the right direction.

I INTRODUCTION

The central concern of this Article is to examine how Jordan fares under the international regimes for protecting intellectual property rights including the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). The TRIPs Agreement requires that, at a minimum, intellectual property laws in member countries of the WTO must conform to its terms.¹ The intellectual property regime in Jordan proved to be a stumbling block for Jordan's accession to the World Trade Organization (WTO).

Jordan committed in its accession to the WTO to comply fully with the TRIPs Agreement without recourse to any transitional period.² The question of Jordan's

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¹ See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) reprinted in The WTO Legal Texts: The Results of the Uruguay Round of Multilateral Trade Negotiations, annex 1C, at 321.

² See Working Party Report, Report of the Working Party on the Accession of Jordan, WT/ACC/JOR/33, para. 230 (December 3, 1999). Despite several attempts by Jordanian officials and negotiators, Jordan was not given a transition period to

compliance has gained importance, especially given the decision by the USTR to un-list Jordan from the watch list of Special 301 in 1999.³ Compliance with TRIPs Agreement and the un-listing from the U.S. watch list of Special 301 helped Jordan accede to the WTO.

The purpose of this article is not to exhaustively narrate the history of intellectual property protection in Jordan, but rather to highlight the areas where changes in Jordan's intellectual property regime were driven by the TRIPs Agreement. This article will examine the copyright, trademark, and patent laws of Jordan and whether they comply with international standards. Higher priority is attached to copyright, patent and trademark because they have broader application in Jordan when compared with other non-traditional areas such as plant varieties and industrial designs. Section II will delineate the current Copyright Law of Jordan and its management. Section III analyzes trademarks protection in Jordan. Section IV examines patent protection in Jordan with emphasis on compulsory licensing and the Jordanian pharmaceutical industry. Section VI furnish with conclusions and recommendations.

II COPYRIGHT LAW

Jordan's 1992 Copyright Law did not meet international standards in many significant respects. Jordan did not adhere to any of the international copyright or neighbouring rights conventions such as the Convention for the Protection of Literary and Artistic Works (Berne Convention) and the Universal Copyright Convention.⁴ However, in 2001, Jordan restructured its copyright law in compliance with the international standards. The following is an examination of the current Copyright Law of Jordan.

comply with its TRIPs obligations. The U.S. and EC firmly held their no-transition position by arguing that every acceding country must comply with TRIPs immediately upon accession.

³ Jordan had been on the U.S. watch list for quite sometime, where the U.S. has closely watched Jordan's intellectual property regime. The situation worsened when there was discussion in 1998 on whether Jordan would be targeted with trade sanctions under Special 301 of the 1988 Omnibus Trade and Competitiveness Act for failing to adequately protect U.S. copyrights, patents, and trademarks.

⁴ See Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, last revised, Paris, July 24, 1971, S. Treaty Doc. No. 99-27, 828 U.N.T.S. 221. See also Universal Copyright Convention, Sept. 6, 1952, last revised, Paris, July 24, 1971, 6 U.S.T. 2731, 216 U.N.T.S. 132.

A *Subject-Matter of Copyright Law*

Jordan's copyright law can be primarily found in the Copyright Law of 2001.⁵ Under the Copyright Law, the subject matter of copyright protection includes literary, scientific, and artistic works.⁶ In the past, computer software was not explicitly covered within the ambit of copyright protection. Now, according to the Copyright Law of 2001, foreign software developers would rely on explicit provisions for protection before licensing their best technologies. Moreover, in the past, Jordan's law did not provide any protection for sound recordings. Now, sound recordings are protected. The list of covered subject-matter in the Copyright Law is not at all inclusive, but rather illustrative since the law uses the statement "in particular these works will be protected" in citing which works to cover.

Prior to Copyright Law of 2001, only Jordanian works or works first published in Jordan benefit from copyright protection. However, the Copyright Law of 2001 changed that so it applies to published or unpublished works of Jordanians and foreigners.⁷ The Copyright Law of 2001 removed the mandatory deposit requirement for foreign works. Thus, the Copyright Law of 2001 requires Jordan to extend its protection to nationals of other countries in a non-discriminatory manner.

The Copyright Law of 2001 considers a work as copyrighted when it is reduced to writing or other material form. There are no other formalities for copyright to be acquired or as pre-condition for filing a lawsuit.⁸ For example, there are no requirements for registration of the work or copyright notice. The Copyright Law of 2001 suggests filing of the best edition of a published work with the Filing Center in the National Library Department.⁹ However, filing is not considered a formality for copyright protection. Filing is considered a procedural step and not condition to secure copyright protection.¹⁰

There are certain works that are excluded from protection under the Copyright Law. Examples include legislations, regulations, judicial decisions, and other official

⁵ See Provisional Copyright Law No. 52 of 2001, Official Gazette No. 4508 (Oct. 1, 2001). The Copyright Law is called in Arabic "droit d'auteur", i.e., in the name of the author. However, Copyright Law translates literally to the "right of copying."

⁶ *Id.* article 3.a. This is in compliance with article 2 of the Berne Convention.

⁷ *Id.* article 53.a.

⁸ See Christopher Sprigman, Reform(aliz)ing Copyright, 57 *Stan. L. Rev.* 485, 495 (2004) (the first copyright statute in 1790, the U.S. Congress required that authors register their copyrights, give notice by marking published copies with an indication of copyright status such as the "©" symbol, as well as other information about copyright ownership. Now, all these requirements are gone altogether).

⁹ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 38 & 45.

¹⁰ Filing a published work in the Filing Center would help the flow of materials to the National Library Department, can be used as evidence in the judicial system, and serve the public interest in an open and comprehensive registry.

texts of a legislative, administrative or legal nature are not protected.¹¹ These laws and texts are considered works of the government. However, legislations, regulations, and other official texts can be copyrighted to the extent that they involve innovation in their arrangement or organization.

B *Exclusive Rights*

There are two types of rights under the Copyright Law: economic and moral rights. Economic rights allow the author of a work to derive financial reward through licensing. A copyright owner enjoys the exclusive right to do the following with the copyrighted work: (1) copy or reproduce, (2) prepare derivative works, (3) distribute, by selling, licensing or other transfer, (4) publicly perform, (5) and publicly display.¹² The copyright owner also enjoys the right to prevent others from practicing these rights.

The right of rental needed clarification in Jordan's copyright law. The right of rental is important because technological advances such as digital audio tape made it very easy to copy films or sound recordings by customers of rental stores.¹³ The right to control commercial rental practices is necessary in order to safeguard the copyright owner's sales market and royalties. Copyright Law of 2001 clearly entertains the right of rental.¹⁴ However, granting the copyright holder authority over how and whether a work is rented in Jordan may affect access and dissemination of the work because renting is cheaper than to buying a work.

Article 8 of the Copyright Law recognizes moral rights.¹⁵ The basis for these rights is the personal linkage between the work and its author.¹⁶ The author has the right to claim or disclaim a work as his own (authorship or paternity) and to safeguard the work from distortion, mutilation, and other amendments which would be prejudicial to his reputation, honour, or integrity. Based on moral rights, an author in Jordan

¹¹ *Id.* article 7.a.

¹² *Id.* article 9.

¹³ See Roberto Garza Barbosa, *Revisiting International Copyright Law*, 8 *Barry L. Rev.* 43, 71 (2007) (discussing rental rights of computer programs and cinematographic works included in article 11 of TRIPs).

¹⁴ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 9.d.

¹⁵ Article 6bis of Berne Convention requires members to recognize the author's moral right of integrity and the right to claim authorship. See *Berne Convention for the Protection of Literary and Artistic Works*, *supra* note 4. Moral rights are excluded under the TRIPs Agreement. See *TRIPs Agreement*, *supra* note 1, article 9.2.

¹⁶ See Cyrill P. RigaMonti, *The Conceptual Transformation of Moral Rights*, 55 *Am. J. Comp. L.* 67, 110-120 (2007) (a classic question of comparative copyright theory is how to understand the long-standing discrepancy between civil law and common law approaches to moral rights. The inclusion of moral rights in European copyright statutes has been explained by reference to a high level of protection for authors, while the exclusion of moral rights from U.S. copyright legislation has been rationalized as a function of a significantly lower level of authorial protection).

can prevent others from passing off his work as theirs or he can block usage of a work, such as in parody, which he feels will prejudice his honour.¹⁷ Moral rights of authorship and integrity are distinct from the bundle of economic or exploitation rights that are usually associated with copyright. Economic rights of the type mentioned earlier can be transferred or assigned to others in return for royalties. However, moral rights cannot be transferred. Moral rights are inalienable and perpetual.

C *Exceptions*

The Copyright Law of 2001 allows certain exceptions or limitations to the exclusive rights granted to the right holder. These exceptions could be labelled as “fair uses” and “non-voluntary” licenses.¹⁸ The difference between the fair use and non-voluntary license is that under free or fair use exploitation of a copyrighted work is carried out without any authorization from the owner or an undertaking to remunerate the owner of copyrighted work for the use. In addition, free use is not applied through governmental authority. On other hand, exploitation under the non-voluntary license is carried out without any authorization, but with the obligation to compensate the right holder.¹⁹

D *Fair Use Defence*

Under the fair use defence of the Copyright Law, individuals are allowed to make a single copy of the work for private personal purposes provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.²⁰ In Jordan, fair use defences are limited to “published” works. It seems that there is a distinction between published and unpublished works for fair use purposes. As such, a biographer or historian may not use excerpts from an unpublished biography.

In stating the fair use defence, Jordan Copyright Law of 2001 does not define the terms “normal exploitation” and “legitimate interests.” There is little evidence in the drafting history of Jordan Copyright Law that is helpful. Moreover, no cases

¹⁷ See Court of Cassation, Decision No. 2648/2003, Adaleh Legal Publications (2003) (the case involved copying a chapter from the book “Islamic Movements in Jordan 1946-1996” and incorporating this chapter in a new book by another author without reference to the original author).

¹⁸ Article 11 of the Copyright Law of 2001 governs non-voluntary licensing and article 17 governs fair use.

¹⁹ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 11.d.

²⁰ Other examples supporting the fair dealing defences include reproduction of articles published in newspapers or periodicals on current economic, political or religious topics, reproduction for research, illustration for teaching purposes, library use, and short extracts for criticism or review within the limits justified and with proper citation. *Id.* article 17.b & d. Examples of fair use in Jordan Copyright Law comply with article 13 of the TRIPs Agreement.

have been decided by courts in Jordan regarding the interpretation of these terms.²¹ There are certain factors that courts in Jordan take into account when judging whether the case in question involves a fair use defence.²² These factors could include the purpose of the use, nature of the work used, amount of quotation or use of the copyrighted work, and amount of financial gain, if any. Thus, conflict with “normal exploitation” refers to such things as massive amounts of photocopying when it is done for economic gain.

E *Compulsory License*

The compulsory licenses under the Copyright Law of 1992 were in favour of the government of Jordan, for government radio and television broadcasts, or for government-mandated translations and these licenses did not meet international standards. Now, the Copyright Law of 2001 allows non-voluntary or compulsory license for reproducing a work under certain circumstances and conditions without the authorization of the owner.²³ Therefore, non-voluntary licenses are determined

²¹ WTO panel decisions may provide guidance as to how interpret “normal exploitation” and “legitimate interest.” The WTO panel in the US-Section 110(5) of the Copyright Act case defined article 13 of the TRIPS agreement as exception that articulates the scope of the so-called “minor exceptions” doctrine. The panel further delineated that limitations or exceptions to exclusive rights can only be made if three conditions are met: (1) the limitations or exceptions are confined to certain special cases; (2) they do not conflict with a normal exploitation of the work; and (3) they do not unreasonably prejudice the legitimate interests of the right holder. The panel decided that an exception must be well defined in the sense of legal certainty and limited in its scope. A use of a work conflicts with a normal exploitation if it enters into economic competition with the ways in which authors normally extract value from the work. How right-holders normally extract value is to be assessed both empirically and normatively. The empirical element involves an economic analysis of the degree of market displacement caused by the free use of the works at issue. The normative element is to be judged by considering those who are eligible to take advantage of the exception, not just those who are known to be taking advantage of it. Finally, the panel decided that an assessment of unreasonable prejudice involves an economic analysis of the loss of income to right-holders.

See Panel Report, United States-Section 110(5) of the US Copyright Act, WT/DS160/R, paragraph 6.58-6.183 (June 15, 2000).

²² See Noury Khater, Readings in the Copyright Law of Jordan, 12.1 *Mu'tah Journal for Research and Studies* 1, 25-28 (1997). See also Michael W. Carroll, *Fixing Fair Use*, 85 *N.C.L. Rev.* 1087, 1100-1106 (2007) (Many legal scholars, politicians, copyright owners and users and their lawyers agree that fair use is so hard to understand that it fails to provide effective guidance for the use of others' works today. Judges do not share a consensus on the meaning of fair use).

²³ Article 11 of the Copyright Law of 2001 authorizes non-voluntary licenses. Article 11 is in line with the Appendix of the Berne Convention of 1971 that allows these exceptions for developing countries. Article I of the Appendix limits the application of the Appendix to countries which are regarded as developing in conformity with the established practice of the General Assembly of the U.N. Any

specifically in the law and do not result from the discretion of any authority. The purpose of non-voluntary licensing in the Copyright Law of 2001 is the dissemination of copyrighted works to the public where the national legislature fears that the non-availability of these works could hinder the dissemination and development of knowledge. Therefore, a non-voluntary license is essential to assist in the promotion of national literacy and training.

The Copyright Law presents a number of procedural steps which the licensee must accomplish prior to obtaining a license. Article 11 of the Copyright Law sets out a scheme whereby citizens of Jordan can apply to the Minister of Culture for permission to translate foreign works for teaching, scholarship and research purposes. For example, the Copyright Law determine a three-year period as the shortest period before which a citizen of may obtain a translation license if no translation has been published by the author.²⁴ Fair compensation must be paid in respect of the use of any work translated or reproduced via a non-voluntary license.²⁵ There can be no doubts as to the guarantee that the authors would be paid for the use of their works. However, the compensation provision raises the question, how “fair compensation” is measured. The Copyright Law text is rather vague, stating that compensation should be consistent with standards of royalties normally operating on license contracts freely negotiated between a person in Jordan and a person in the author’s country.

F Terms of Copyright Protection

Terms of copyright protection in Jordan were not, until recently, in harmony with the terms of protection required under the Berne Convention and TRIPs Agreement.²⁶ The old Copyright Law of 2001 provided short terms of protection.

developing country member of the Berne Convention which wishes to introduce the special compulsory licenses is required to deposit a declaration notification with the Director General of WIPO. See Berne Convention, *supra* note 4, at app. article I.

²⁴ The Copyright Law of 2001 states that If, after the expiration of a period of three years from the date of the first publication of a literary or artistic work, a translation of such work has not been published in the Arabic language by the owner of the right of translation with his authorization, any national of Jordan may obtain a nonexclusive, non-transferable license from the Minister of Culture to translate the work and publish the work so translated in the Arabic language. See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 11.a &c.

²⁵ *Id.* article 11.d.

²⁶ The Berne Convention requires certain minimum standards of protection that Berne-signatory countries must accord works. The Berne convention allows signatory countries to exceed this minimum. The minimum term of protection required by the Berne Convention for works created by individual authors, except anonymous works, pseudonymous works, and works made for hire, is fifty years after the death of the author. The term for anonymous and pseudonymous works is fifty years after publication of the work. See Berne Convention, *supra* note 4, art. 19 & 7.1, 828 U.N.T.S. at 251, 235-237. The TRIPs Agreement requires Berne’s

For example, term of protection for cinematographic works was thirty years, for computer software was fifteen years, and with respect to translations was five years. The Copyright Law of 2001 extended terms of protections thus bringing Jordan into compliance with the Berne Conventions and TRIPs Agreement.

Works created by individual authors receive copyright protection for a term of fifty 50 years *post mortem auctoris* (after the death of the author, p.m.a.).²⁷ In the case of works created by joint authors, the term of protection lasts for fifty 50 years *p.m.a.* of the last-surviving author. Copyright in cinematographic works endures for a term of fifty years from the year of publication.²⁸ Photographic and applied art works are protected for twenty-five years.²⁹ The Copyright Law of 2001 does not assimilate applied art and photographic works with other literary works, but rather provides applied and photographic works with protection for shorter periods. The period of protection for performers and producers of phonograms lasts for fifty years calculated as of the fixation was made or the performance took place.³⁰ The term of protection for broadcasting organizations lasts for twenty years as of the date in which the broadcasting took place.³¹

As stipulated under the TRIPs Agreement, the Copyright Law granted the minimum period of protection. Jordan Copyright Law of 2001 standardized the terms of copyright protection. The changed rules pertaining to copyright duration are of critical practical importance because they give authors extended protection to exploit their works.

G Remedies

Under the Copyright Law of 1992, criminal penalties for copyright infringement were too low to deter piracy. For example, criminal penalties were three months in jail and/or a fine not exceeding 1,000 Jordanian dinars (US\$1,400). On the other hand, the Copyright Law of 2001 contains detailed provisions that expressly deal with the question of available remedies for a copyright infringement. Remedies provisions are to be found in articles 46-52 of the Copyright Law.

minimums. The TRIPs Agreement states that its members must comply with articles 1 through 21 of the Berne Convention and the Appendix thereto. See TRIPs, *supra* note 1, article 9.1, at 1201.

²⁷ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 30. The TRIPs Agreement requires the fifty year p.m.a. See TRIPs, *supra* note 1, article 1.3, at 1199.

²⁸ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 31.

²⁹ *Id.* article 32.

³⁰ *Id.* article 23.d. The standard of Jordan's Copyright Law of 2001 is higher since the period of protection under the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations is only twenty years.

³¹ *Id.* article 23.e.

Courts could order the seizure or impoundment of allegedly infringing articles while a copyright case is pending.³² Seizure or impoundment has the purpose of preserving relevant evidence.³³ Those articles can be destroyed or forfeited after judgment.³⁴ The copyright holder may collect a just compensation.³⁵ However, the Copyright Law of 2001 does not determine how to compute compensation against an infringer of a copyright.

In addition to the above remedies, the Copyright Law of 2001 considers infringement of copyright as a criminal offense. The Copyright Law of 2001 increased penalties to imprisonment for a minimum of three months to no more than three years and a fine of not less than 1,000 Jordanian dinars (US\$1,400) up to 3,000 Jordanian dinars (US\$4,231) or both. Criminal sanctions are intended to punish those who commit acts of theft or infringement of copyright and to deter further infringement.³⁶ One can notice that the Copyright Law of 2001 does not distinguish between innocent infringement and willful infringement in terms of punishment. Moreover, the Copyright Law of 2001 does not determine whether counterfeiting should be punished severely than other forms of infringement.

The Copyright Law of 2001 does not adopt border procedures to suspend the release into circulation pirated copyright goods.³⁷ Rather such border procedures are covered under the Customs Law.³⁸ Jordan issued special instruction for border procedures. These instructions require halting clearance of goods that bear visible marks of infringement based on a decision of the competent court.³⁹ In principle, Jordan is in compliance with the TRIPs Agreement concerning border measures and suspension of release by customs authorities.⁴⁰ However, the Copyright Law of 2001 does not provide the Jordanian authorities with the right to initiate border measure actions *ex officio* without the need for a formal complaint by the right holder.

³² *Id.* article 46.

³³ *Id.* article 46.c & d.

³⁴ *Id.* article 47. See also Court of Cassation, Decision No. 2648/2003, *supra* note 27.

³⁵ See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 49.

³⁶ The purpose of punishment is served by imposing a substantial fine or sentencing that corresponds to the seriousness of the crime particularly in cases of repeat offenses. In cases of repetition, penalties would be applied to the maximum.

³⁷ Border measures are different from other enforcement measures in that they involve actions by customs authorities at the borders, rather than by the judicial authorities.

³⁸ The rights holder may petition the court, after depositing a cash or bank guarantee and submitting sufficient evidence, to suspend the release of suspected infringing products. See Customs Law No. 20 of 1998, article 41, Official Gazette No. 4305 (October 1, 1998).

³⁹ See Border Procedures Instructions for the Protection of Intellectual Property Rights No. 7 of 2000, article 3, Official Gazette No. 2457 (October 1, 2000).

⁴⁰ See TRIPs Agreement, *supra* note 1, article 51-60.

III TRADEMARKS

The old Jordanian Trademarks Law of 1952 did not recognize many aspects of modern trademark law. For example, there was no clear recognition of service marks and no protection for well known marks. However, in 1999, Jordan enacted the Trademarks Law of 1999 to comply with the TRIPs Agreement and the Paris Convention for the Protection of Industrial Property (1967).⁴¹

A *Definition Trademarks*

The Trademarks Law describes a trademark in the broadest sense as any visually perceptible sign, such as a word, logo, number, letter, slogan, or color used to distinguish the goods or services of a person from the goods or services of another.⁴² Protection extends not only to traditional types of trademarks, but to certification marks and collective marks. However, the Trademarks Law of 1999 does not apply to other non-traditional trademarks such as sound or smell because a trademark is defined as any visually perceptible sign.⁴³ Trademark protection may also be extended to product trade dress or packaging.

Notably lacking in the old Trademarks Law of 1952 law is a provision covering service marks. Prior to the Trademarks Law of 1999, applicants could only protect service marks under the default of class 16.⁴⁴ However, this deficiency was

⁴¹ The TRIPs Agreement sets various standards, including the recognition of service marks, setting a minimum, renewable term of protection at seven years, defining use requirements, and recognizing well-known marks even if not registered in the specific jurisdiction. See TRIPs Agreement, *supra* note 1, article 15-21.

⁴² See Trademarks Law No. 34 of 1999, article 7, 7.1, 4 & 12, Official Gazette No. 4389 (November 1, 1999). See High Court of Justice, Decision No. 32/1966, Journal of Jordan Bar Association 731 (1966) (the registration of color as a trademark). See also High Court of Justice, Decision No. 49/88, Journal of Jordan Bar Association (1988).

⁴³ Jordan Trademarks Law of 1999 is in compliance with article 15 of the TRIPs Agreement which states that a member "may" require, as a condition of registration, that a sign be visually perceptible. In respect to colors, the limitation of a trademark to a color(s) may be a basis for the establishment of distinctiveness. Colors themselves such as the color orange could be treated as trademarks. Therefore, under Jordan Trademarks Law of 1999, a fragrance trademark can never be registered. The registration of fragrances or sounds would present complex challenges for trademark examiners in Ministry of Industry and Trade in Jordan. It is unclear how fragrances or sounds would be categorized, catalogued, preserved during the registration period, or searched and tested for confusing similarity.

⁴⁴ Now, service marks may be registered and the class for service marks has been divided into four new separate classes of services. See Diala Al-Alami & Ashraf Atout, Jordan: Note on New Amendments to the Trademark Law, Arab L. Q. 103," (2000).

remedied by the passage of the Trademarks Law of 1999.⁴⁵ Given the fact that almost seventy percent of Jordan's Gross Domestic Product comes from services, protection of service marks is essential for the services industry.

B Registration of Trademarks

Any person or business can apply to register a mark in Jordan.⁴⁶ The Trademarks Law of 1999 adopts the intent-to-use system and does not require actual use of a trademark as a condition for filing a registration.⁴⁷ In other words, it is sufficient to base the application on intent to use the mark without the need to show prior use of the mark. The intent-to-use requirement may lead to an increase in the number of trademark applications. Evidence of intent-to-use could be demonstrated through an on-going business.

The Trademarks Law of 1999 does not mandate special documentation when applying for a trademark. The Trademarks Law of 1999 requires only a notarized general or specific power of attorney written in Arabic. At the time of filing an application, an applicant may claim priority based on a foreign application by noting his claim in the application and disclosing the name of the country of the priority application as well as the application number and date.⁴⁸

In general, for a mark to be registrable, it must be distinctive, novel, and otherwise not prohibited by law.⁴⁹ As such, it is unregistrable where a mark is contrary to public policy or morality. The examination process in the Trademark Law of 1999 would typically focus on the distinctiveness of the mark. In view of the importance hinged on the distinctiveness of a mark as a pre-condition for its acceptance for registration, the trademark Registrar is qualified to require amendments or additions that he deems necessary for mark distinctiveness.

C Acceptance and Registration

Where an application to register a trademark is accepted, it is published in the Official Gazette.⁵⁰ Any person could file an opposition, within three months of the

⁴⁵ When a mark is used in connection with services, it is sometimes referred to as a service mark. See Trademark Law Amendment Enacted, Published, 14.3 World Intellectual Property Reporter (BNA) (Mar. 15, 2000) (prior to the amendment of Jordan's Trademarks Law, applicants could only protect service marks under class 16 for publication and printed material).

⁴⁶ See Trademarks Law No. 34 of 1999, *supra* note 42, article 6 & 11.

⁴⁷ *Id.* article 11.1. The Trademarks Law of 1999 is silent as to when the registrant must use the mark.

⁴⁸ *Id.* article 41.

⁴⁹ See High Court of Justice, Decision No. 505/2006 (Jan. 31, 2007) (factors to be taken into account when deciding whether a mark is distinctive or not include the way the mark is written, pronounced, and essential appearance of the mark).

⁵⁰ *Id.* article 13.

publication date, against the registration of a trademark.⁵¹ The opposition may be based on any ground such as prior registration, prior application, prior use of the mark by another, fraudulent information, or economic damage.⁵² The trademark Registrar hears oppositions and decides cases based on evidence submitted before him. The registrar's decision may be appealed before the High Court of Justice.

A trademark registration may be revoked based on a petition filed by any interested person if it is shown that the registered mark had not been used in Jordan for three consecutive years.⁵³ In addition, the petition for cancellation of a registration may be based on contradicting the law or unfair competition. The owner of a registered trademark may defend his registration by showing that his lack of use was due to special circumstances.⁵⁴

D *Duration and Renewal of Trademarks*

The Trademarks Law of 1999 sets the initial term of registration at ten years from the date of filing an application.⁵⁵ However, renewal is required to maintain the validity of a registration. The registration may be renewed for subsequent terms of ten years each.⁵⁶ Once a registration expires, it is struck from the Register and restoration is not permitted unless the full application procedure is resubmitted.

E *Remedies for Trademarks Infringement*

The owner of a registered trademark has the exclusive right to prevent third party not having obtained his consent from using in the course of trade, identical or similar signs for goods or services which are identical or similar to those registered trademarks where such use would result in a likelihood of confusion.⁵⁷ The burden of proving obtaining the consent of the proprietor would fall on the third party.

⁵¹ An extension of time to file an opposition may be granted by filing an extension request before the deadline. *Id.* article 14.1. See High Court of Justice, Decision No. 416/94, Journal of Jordan Bar Association 1854 (1995).

⁵² See Trademarks Law No. 34 of 1999, *supra* note 42, article 14.2.

⁵³ *Id.* article 22. According to the Trademarks Law of 1999, the grace period of non-use was raised from two years to three years.

⁵⁴ In practice, the owner of a registration, which is the subject of cancellation proceedings, may elect to file a new application for an identical mark. This way if the existing registration is cancelled, then the new application will replace the cancelled registration. See John R. Olsen & Spyros M. Maniatis, Trade Marks, Trade Names and Unfair Competition: World Law & Practice, Jordan 1 (Sweet & Maxwell, London 1998).

⁵⁵ See Trademarks Law No. 34 of 1999, *supra* note 42, article 20.1. The old Trademarks Law of 1952 set the initial term of registration and subsequent renewal terms at seven and fourteen years respectively.

⁵⁶ *Id.* article 20.2.

⁵⁷ *Id.* article 26. 1. Where an identical sign is used for identical goods or services, a likelihood of confusion is to be presumed. This is in compliance with article 16 of

The Trademarks Law provides for a cease and desist order.⁵⁸ The Trademarks Law of 1999 provides for an interlocutory seizure of goods, which would take place at the request of the owner of a trademark. Moreover, the Trademarks Law of 1999 specifically provides for destruction or disposal of materials or tools used in the infringement of trademarks.⁵⁹ The Trademarks Law of 1999 provides several penalties against offenders who misrepresent goods or use counterfeit trademarks.⁶⁰

F Well Known Marks

Protection of well known marks in Jordan an area where some reform was needed to ensure compliance with the Paris Convention and the TRIPs obligation to protect well known marks. Due to the lack of explicit provisions preventing the registration of well known marks, many local Jordanian companies filed applications to register well known marks under their own names.⁶¹ The simplistic approach to register trademarks in Jordan contributed to the registration of well known marks.⁶² Trademark rights were granted to the first persons or entities to register in Jordan regardless to prior use in Jordan or elsewhere. This approach allowed a third party to acquire rights to internationally famous marks by registering them in Jordan as their own.

Many foreign owners of well known trademarks had to litigate in Jordan because of the trademark registrations by Jordanian persons. For example, Shaheen International Corporation Co. filed an application to register the mark PILLSBURY in its name in Jordan.⁶³ In another example, Hani Al-Qudsi & Partners, a Jordanian

TRIPs. See Court of Cassation, Decision No. 72/58, Journal of Jordan Bar Association 485 (1956).

⁵⁸ See Trademarks Law No. 34 of 1999, *supra* note 42, article 39.

⁵⁹ *Id.* art. 39.4.

⁶⁰ The Trademarks Law of 1999 has increased the term of imprisonment from a maximum of three months to one year. Fines have been also increased from 100 Jordanian Dinar (U.S.\$70) to 3000 Jordanian Dinar (U.S.\$2130). The Trademarks Law of 1999 provides penalties that include JD100-3000 fine, three months-one year imprisonment, or both.

⁶¹ See Roundup of IP Developments in Arab Region, Patent, Trademark & Copyright Law Daily (BNA) (February 4, 1994). This is not to say that well-known marks were without protection. In fact, two practical defenses against unauthorized use of well-known marks were employed. First, an examiner that identifies a certain mark as being owned by a third party may, based on his own personal knowledge, refuse to register the mark in the name of the applicant. Second, any party who claimed right to a well-known registered mark was entitled to institute opposition proceedings against its registration.

⁶² The Jordanian law is rather lax regarding documentation that is required when applying for a trademark. All that is required is a general or specific power of attorney.

⁶³ The Pillsbury Company filed an opposition contending that its PILLSBURY mark is a well known mark used to market its ready-made dough and bakery products

Company, filed a trademark application to register the mark “7ELEVEN” in class 16.⁶⁴ Farid Khalaf Company, a Jordanian company, filed to register the mark “MILLER” in Jordan in class 32 for beers.⁶⁵

In other cases, foreign owners of well known marks were unable to prevent registration of similar marks by Jordanian persons. For example, a Jordanian company, Jordanian Trico & Yarn Factory Co., filed a trademark application for “AL TIMSAH” mark, in class 32, which means a crocodile in Arabic, similar to that filed by La Chemise Lacoste, a French company.⁶⁶ In another case, Time Warner Entertainment Company filed an opposition against the registration of the trademark TOTO, a depiction of the famous cartoon character Tweety, in Jordan.⁶⁷

worldwide including Jordan. As a result, a settlement was reached whereby Shaheen agreed to assign the trademark registration over to the Pillsbury Company in return for the latter’s agreement not to initiate legal action for damages or compensation. See Roundup of IP Developments in Arab Region, *supra* note 61.

⁶⁴ The Southland Corporation, a U.S. corporation, filed an opposition claiming that the Jordanian applicant was not entitled to such registration since it uses and owns registrations of the mark “7ELEVEN” in various countries worldwide. The Southland Corporation prevailed in its opposition not so much on the merits but rather on points of procedure. The Jordanian Company did not submit its response to the opposition on time. See *The Southland Corporation (a U.S. Corporation) v. Hani Al-Qudsi & Partners (a Jordanian Company)*, Trademark Registrar’s Decision No. TM/40918/1410 (April 27, 1997) (unpublished). See also High Court of Justice, June 13, 1998, Decision No. 215/97, 1998 Journal of the Jordanian Bar Association 854-856.

⁶⁵ Miller Brewing Company, owner of the famous mark MILLER, filed an opposition and contended that it was the owner of the famous MILLER trademark that is registered and used in several countries worldwide. Miller Brewing Company further contended that the fact that its MILLER mark was not registered in Jordan should not adversely affect the opposition. The Jordanian trademark Registrar ruled in favor of Miller Brewing Company and rejected Khalaf’s application. The Registrar reasoned that Khalaf’s registration would cause consumer deception and constitute unfair competition and false indication of origin of the goods bearing the mark. The Jordanian High Court of Justice affirmed the Registrar’s decision. See *Miller Brewing Company (an American Company) v. Fareed Khalaf Company-Khalaf Stores (a Jordanian Company)*, Trademark Registrar’s Decision No. TM/35571/1142, (April 6, 1997) (unpublished).

⁶⁶ The Registrar rejected Lacoste’s opposition for the registration of “AL TIMSAH” mark on the basis that the two marks, AL TIMSAH and LACOSTE, were in different classes and there was no likelihood of confusion. See *La Chemise Lacoste (a French Company) v. Jordan Trico Yarn Factory Co. (a Jordanian Company)*, Trademark Registrar’s Decision No. 34310/77 (January 6, 1998) (unpublished).

⁶⁷ The Jordanian application was filed by Sobhi Jabri & Sons Co and was intended to cover goods in class 30 (food). In its opposition, Time Warner contended that it owned the rights over its famous “Tweety” character and its opposition should be accepted. However, the Registrar rejected the opposition because no convincing evidence was submitted to prove that Time Warner was using the “Tweety” character with respect to goods in class 30. In addition, the Registrar reasoned that this cartoon character is only protected by copyright law and not trademark law. See *Turner Warner Entertainment Company (an American corporation) v. Sobhi*

Since 1999, well known marks are expressly protected. The Trademarks Law sets out special provisions to protect well known marks. The Law defines well known trademarks as marks that are widely known to the relevant public in Jordan and that enjoy a high international reputation.⁶⁸ Therefore, in judging whether a mark is a well known or not, it is important to determine whether the mark has surpassed the borders of its country of origin and that the mark is well known to the relevant consumer segment in Jordan.

Trademarks Law of 1999 prohibits the registration of a trademark which constitutes a reproduction or translation, liable to create confusion, of a well known mark on identical or similar goods.⁶⁹ Moreover, Trademarks Law of 1999 prohibits the use of a well known, but unregistered, on dissimilar goods and services, provided that the use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use.⁷⁰ Thus, a well known mark may be defended even if it is not registered or the owner does not carry on a business in Jordan. Notwithstanding this protection of well-known marks, commentators still advise the registration of such marks to evade problems

G *Parallel Importation*

The Trademarks Law of 1999 does not clearly address whether parallel imports infringe trademark rights.⁷¹ The Trademarks Law provides the trademark owner, who registered his mark in Jordan, with the exclusive right to “use” that mark.⁷² However, the word “use” is not clearly defined. Courts in Jordan have yet to interpret the term to determine its scope. Many parallel import cases in Jordan involve a corollary dimension of trademarks and commercial agency laws.⁷³ The

Jabri & Sons Co., Trademark Registrar Decision No. TM/29626/78 (January 6, 1998) (unpublished).

⁶⁸ See Trademarks Law of 1999, *supra* note 42, article 2.

⁶⁹ *Id.* article 8.12.

⁷⁰ *Id.* article 26.1.

⁷¹ Parallel imports or gray market goods are genuine goods and not counterfeits, whereby a trademark is misappropriated. Parallel imports involve the importation of genuine goods outside the authorized distribution channels. In other words, a parallel import is the importation of these goods from a foreign source by bypassing the authorized local distributor and trademark licensee therefore allowing the sale of goods directly to retailers or consumers. See Keith E. Maskus, *Parallel Import*, 23 *World Econ.* 1269 (2000).

⁷² See Trademarks Law of 1999, *supra* note 42, article 26.1.

⁷³ The Copyright Law of 2001 does not mention the right to import, although the right to distribute may include importation rights. Moreover, there is no mention for parallel importation among exceptions from copyright protection. See Provisional Copyright Law No. 52 of 2001, *supra* note 5, article 9, 11& 17. There have been no cases addressing parallel imports under the Copyright Law, although courts in Jordan can protect the copyright owner in regards to parallel importation based on court decisions in trademark cases.

Commercial Agency Law deals with exclusive agency contracts, distribution of goods, distribution channels, and territorial limits.⁷⁴

In one case, Jordan Mechanical Engineering Company, a Jordanian company, acted as an agent and distributor of “Maggi” chicken stock cubes, which is a product of Nestle, a Swiss company.⁷⁵ It came to the knowledge of Jordan Mechanical that some Jordanian traders, such as Abdul-Fattah Qunno, imported about 1000 boxes of Maggi cubes (a product of Egypt), which did not conform to the required specifications. The Court of Cassation found that Jordan Mechanical was entitled to preserve its rights as the authorized agent of the manufacturing company for marketing certain goods. In addition, the Court found that Jordan Mechanical Company was entitled to protect its rights in the trademark that was registered for Maggi cubes.

As the facts of the Maggi case illustrate, some parallel importers such as Abdul-Fattah Qunno imported genuine goods that are subject to an agency agreement probably with the purpose of circumventing the agent. The effect of the Court of Cassation decision is that although the Swiss company could not enjoin sales of gray market goods in Jordan, its agent and distributor succeeded in obtaining remedies by having the goods of the parallel importers impounded, destroyed, or exported. Apparently, the quality of Maggi differs from Maggi cubes specifically designed for the Jordanian market. Maggi of Egypt was not designed to comply with consumer specifications in Jordan. By bringing the Maggi case, the agent sought to protect regular trade channels. In this context, Jordan Mechanical raised violations of trademarks and agency laws.

As the Maggi case also illustrates, Customs may not seize gray market goods at the borders. This means that an authorized agent or distributor has to bring a private action against the importer of gray market goods, a task that could prove difficult for several reasons. First, the distributor has to identify the identities of parallel importers. Secondly, bringing a private action is time consuming. Once the identities the parallel importers have been identified, a Jordanian authorized distributor can bring a lawsuit based on an array of theories which embraces trademarks, unfair competition, consumer concerns, and agency law.

In sum, neither the Trademarks Law nor Customs Law does address clearly parallel importation. In reality, foreign manufacturers appoint as their agent or distributor a Jordanian firm which is the exclusive importer and distributor of their goods. By this exclusivity, parallel importation could be practically blocked. The matter of parallel importation can be addressed through case law. Since the current intellectual property regime in Jordan is new, it remains to be seen how court decisions will interplay parallel imports, trademarks law, commercial agency law, public interest, and free trade.

⁷⁴ A commercial agent is an importer, distributor, and trader and a foreign supplier is an exporter. See Commercial Agency Law No. 28 of 2001, article 2, Official No. 4496 (July 16, 2001).

⁷⁵ See Court of Cassation, 1996, Decision No. 95/1418, Journal of the Jordanian Bar Association 957 (1996).

IV PATENTS

In 1999, Jordan introduced its patent legislation replacing the Patents and Designs Law which had been in effect since 1953. The Patents Law was further amended in 2001.⁷⁶ The amendments made to Jordan's law are intended to bring Jordan law into harmony with TRIPs, and meets the requirements that are needed for global economic development.

A *Scope of Protection*

The Patents Law of 2001 defines protected subject matter as well as unpatentable subject matter. A patent can be granted for any invention that meets the patentability conditions in all fields of technology.⁷⁷ The Patents Law requires inventions to be novel, inventive, and capable of industrial application.⁷⁸ What constitutes a "novel invention" is not explicit in the Patents Law. However, novelty is assessed on a worldwide basis, as supposed to an assessment on what has been disclosed in Jordan as was the case under the old Patent Law of 1953.⁷⁹

Some subject matter is considered statutorily unpatentable. Non-patentable inventions include discoveries, diagnostic, therapeutic and surgical methods necessary for the treatment of humans or animals, and living matters such as plants and animals other than microorganisms.⁸⁰ The Patents Law of 2001 does state if computer-related inventions are patentable inventions under the law. However, computer programs could be patentable if they are new, involve an inventive step, and are industrially applicable.

B *The Patent System of Jordan is First-to-File System*

It is a misconception to claim that the patent law of Jordan is based on the first-to-invent principle, rather than first-to-file principle.⁸¹ The first-to-invent principle awards the patent to the inventor who can prove that he was the first to come up

⁷⁶ See Provisional Patents Law No. 71 of 2001, Official Gazette No. 4520 (December 2, 2001).

⁷⁷ *Id.* article 2.

⁷⁸ *Id.* article 3. The requirements for patentability in Jordan Patents Law of 2001 meet those stated in article 27.1 of the TRIPs Agreement. See High Court of Justice, Decision No. 1824/2005, Journal of Jordan Bar Association 2147 (2005) (as a condition for patentability, the invention must be novel not known previously. Thus, the use of new material to produce a well-known product does not qualify as new invention unless such use is accompanied by a type of novelty in production).

⁷⁹ The Patents Law of 2001 grants a one year grace period to file a patent application for an invention that has been disclosed. See Provisional Patents Law No. 71 of 2001, *supra* note 76.

⁸⁰ *Id.* article 4.

⁸¹ See Richard C. Wilder, Letters to the Editor: Playing Cards in the Hashemite Kingdom of Jordan, 2 U. Balt. Intell. Prop. L.J. 237, 238 (1994).

with the invention.⁸² Under a first-to-file system, a patent is awarded to the first who files for a patent regardless whether he was actually the first to invent the invention.⁸³

The misconception was based on the old Jordanian Patent Law of 1953 which awarded patent to “the true and first inventor” of every new invention.⁸⁴ This claim is simply not right. The old Patent Law of 1953 and current Patent Law of 2001 provide several bases for opposition to the grant of a patent, including that the invention has been claimed in any specification for a Jordanian patent which is, or will be, of prior date to the patent the grant of which is opposed. This opposition ground establishes that the patent system of Jordan is a first-to-file system. Furthermore, the old Patent Law of 1953 and current Patent Law of 2001 provide the Registrar with the power to require an amendment if it appears that the invention claimed has been claimed or described in any specification previously lodged or in any patent previously registered.⁸⁵ Therefore, either during examination or opposition, the Jordanian Registrar has the power to refuse to grant a patent on the basis of an application that had been previously filed. In sum, a patent is granted to the first to file.

Despite persistent claims to the contrary, the patent law of Jordan awards patents on the first-to-file principle, rather than the first-to-invent principle. The U.S. is the only country in the world awarding patents on the basis of the first-to-invent principle.⁸⁶ In sum, Jordan, like the rest of world, uses the first-to-file system.

C Disclosure and Examination

The Patents Law of 2001 requires applicants to disclose the invention in a manner sufficiently clear and complete so that for the invention to be carried out by a

⁸² See Ryan K. Dickey, *The First-to-Invent Patent Priority System: An Embarrassment to the International Community*, 24 B.U. Int'l L.J. 283, 294 (2006) (generally, first-to-invent means that the first person who conceives of an invention is entitled to the patent).

⁸³ See Stephanie Gore, *The Harm/Benefit Dichotomy of a First-to-File Patent System*, 1993 U Chi L. Sch. Roundtable 293, 308 (1993) (under this system the Patent Office would determine priority by the date of filing, rather than by the date of invention).

⁸⁴ See Patent Law No. 22 of 1953, article 4.1 (February 17, 1952).

⁸⁵ See Patent Law No. 22 of 1953, article 8.1(2). See also Provisional Patents Law No. 71 of 2001, *supra* note 76, at article 9 & 10.

⁸⁶ See Steve Seidenberg, *A Sea Change in Patent Law*, 92 ABA Journal, 49, 50 (January 2006) (the first-to-invent principle has been in effect since the first U.S. patent was issued in 1790. The first-to-invent patent system is uniquely American. The U.S. Congress introduced a bill, Patent Reform Act (H.R. 2795), that would move the U.S. patent approval process from a first-to-invent to a first-to-file approach in order to align the U.S. law with other countries).

person skilled in the art.⁸⁷ Additionally, the Patents Law of 2001 requires applicants to disclose the best method of making the invention work and to disclose any existing foreign applications and grants.⁸⁸ The Patents Law requires one invention per application.⁸⁹

The Patents Law of 2001 sets out search and examination procedures in order to grant patents.⁹⁰ In practice, however, patent examiners in Jordan rely on the substantive search and examination results of a corresponding application of a foreign patent office, such as the U.S. Patent and Trademark Office (USPTO) or the European Patent Office that may have granted the corresponding patent.⁹¹ Patent examiners in Jordan rely on the substantive search and examination results of a corresponding application of a foreign patent office because examiners in Jordan lack enough knowledge and expertise in patent law. In addition, patent examiners in Jordan desire to expedite the process and facilitate their task since they would only examine the application with respect to formal requirements. However, the Patents Law of 2001 should be modified so as to set forth the procedures under which patent examiners in Jordan may accept the examination carried out by other foreign offices. Moreover, it remains to be seen how a Jordanian court would rule on a patent granted in Jordan based on examination carried out by other foreign offices.

D *Patentee Rights, Duration of Protection, and Remedies*

A patentable invention grants its inventor certain exclusive rights. These rights include preventing non-authorized making, using, offering for sale, or importing for these purposes patented products or processes.⁹² A patentee is entitled to assign or license his exclusive rights.

Patent protection lasts twenty years from date of filing.⁹³ The calculation of length of protection starting from date of filing means that any time spent in prosecuting

⁸⁷ Insufficiency of specifications is a ground for revocation. See Provisional Patents Law No. 71 of 2001, *supra* note 76, article 8.a & c.

⁸⁸ *Id.* article 8.a. Article 29 of TRIPs permits members to require applicants to indicate the best mode of carrying out the invention.

⁸⁹ If there are related inventions, then documents must show a unity of invention. This would allow claims to different inventions that fall under the same inventive concept. *Id.* article 8.a & 9.a.

⁹⁰ *Id.* article 8. In addition, articles 18-24 of the Patents Regulation of 2001 address examination procedures.

⁹¹ Telephone Interview with Khaled Arabeyyat, Director of Industrial Property Protection Directorate, Ministry of Industry and Trade (July 26, 2008).

⁹² See Provisional Patents Law No. 71 of 2001, *supra* note 76, article 21.a. See also Court of Cassation, Decision No. 1013/1990, *Journal of Jordan Bar Association* 1149 (1992).

⁹³ See Provisional Patents Law No. 71 of 2001, *supra* note 76, article 17. Previously, patents were protected for a period of sixteen years. Thus, the Patents Law of 2001 extended the term to twenty years. This is in compliance with article 33 of TRIPs. See High Court of Justice, Decision No. 114/2000, *Judicial Journal* 353 (2000).

the invention in the Jordanian patent office will be discounted from the twenty years. Civil and criminal remedies are available if the patentee's exclusive rights are infringed. In patent infringement proceedings, the court may impose jail terms, monetary fines, or award damages.⁹⁴ The Patents Law sets out special provisions regarding the burden of proof in civil proceedings in infringement of process patents.⁹⁵

E *Compulsory Licensing*

The Patents Law of 2001 has provided for a compulsory license to exploit a patent without the permission of the patent holder in certain circumstances.⁹⁶ The Patents Law authorizes granting a compulsory license for the services of the government for national defence, emergency, or for public non-commercial use purposes.⁹⁷ To date, there has never been a single national defence case that would justify a compulsory license. However, the compulsory license provision is important and is related to Jordan's national public policy. The Patents Law stipulates another circumstance for granting a compulsory license whereby the patentee abuses his rights by preventing others from competing fairly.⁹⁸ Finally, the Patents Law grants compulsory licenses in cases of a failure to work or use the invention.⁹⁹ The Patent Law however, does not define the term "work" or "use" of inventions. Therefore, it is questionable whether the use should be associated with the exclusive rights of the patentee.

Similar to the TRIPs Agreement, under Jordan's Patent Law certain conditions must be met before a compulsory license will be granted. The interested party should first try to amicably negotiate a license with the patentee.¹⁰⁰ Under Patent Law, the

⁹⁴ Imprisonment term ranges between three months to one year and a fine can be assessed between 100 Jordanian Dinar and 3000 Jordanian Dinar. See Provisional Patents Law No. 71 of 2001, *supra* note 76, article 32.

⁹⁵ Where a process patent is allegedly have been infringed through the use of a product made directly by that process, it can be very hard for the patentee to prove that the defendant's product, though identical, was made through the use of the patented process. Accordingly, the Patents Law provides that any identical product when produced without the consent of the patent owner shall be deemed to have been obtained by the patented process if there is a likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used. *Id.* art. 34. This is in compliance with article 34 of TRIPs.

⁹⁶ *Id.* article 22-26.

⁹⁷ *Id.* article 22.a.

⁹⁸ *Id.* article 22.c.

⁹⁹ Any interested person may seek a compulsory licensing if the patentee does not work his invention for three years after the issue of the patent, or four years from the filing date of application. *Id.* article 22.b (1).

¹⁰⁰ *Id.* article 23. See Sara M. Ford, Compulsory Licensing Provisions under the TRIPs Agreement: Balancing Pills and Patents, 15 Am. U. Int'l L. Rev. 941, 960 (2000).

compulsory license shall be granted principally to supply the national market.¹⁰¹ When granted, a compulsory license should be non-exclusive.

If the circumstances leading to the granting of a compulsory license cease to exist, the Minister of Industry and Trade may suspend or terminate the compulsory license by considering the legitimate interests of the licensee(s) so authorized. In other words, if the Minister of Industry and Trade realizes that the compulsory license is no longer necessary, he may suspend or terminate it. Another motivation for the suspension or termination of a compulsory license may be the failure of the compulsory licensee to meet the requirements and conditions as stipulated prior to the grant.

F *The Jordanian Pharmaceutical Industry and the TRIPs Agreement*

The pharmaceutical industry in Jordan is several decades old, where the first domestic maker started business in the early 1960s.¹⁰² Today, the pharmaceutical industry consists of seventeen small to medium-sized private firms employing approximately 8,000 people.¹⁰³ Domestic drug makers export about sixty percent of their production while the rest is destined for local consumption.¹⁰⁴ Hence, the pharmaceutical industry is an important source of foreign exchange.

The problem of the intellectual property regime in Jordan was acute in the pharmaceutical sector, where patented drugs were manufactured without licenses. The Patents and Designs Law of 1953 was deemed as an inadequate.¹⁰⁵ This state of affairs led to patent infringements of pharmaceuticals.¹⁰⁶

After modifications, the Patents Law permits the granting of patents for foodstuffs and pharmaceuticals.¹⁰⁷ However, these modifications will only come into effect

¹⁰¹ See Provisional Patents Law No. 71 of 2001, *supra* note 76, article 23.f.

¹⁰² See Implications of WTO/TRIPS for Technology Transfer in the Pharmaceutical Industry, U.N. Economic and Social Commission for Western Asia, at 31, U.N. Doc. E/ESCWA/TECH/1997/7 (1997).

¹⁰³ *Id.*

¹⁰⁴ Production is confined to generics, packaging of imported formulations, and production of formulations based on imported active ingredients. Most raw materials, packaging equipment, and other auxiliary materials are imported. Some drug formulation and packaging activities are conducted under licensing agreements with multinational corporations. *Id.* 32-33, 35.

¹⁰⁵ See 1997 Special 301 Report, *available at* <http://www.ustr.gov/pdf/special.pdf> (April 30, 1997) (citing the shortcomings of the patents law regarding pharmaceuticals).

¹⁰⁶ See 1998 Special 301 Report, *available at* <http://www.ustr.gov/pdf/special.pdf> (May 1, 1998). *See also* 1999 Special 301 Report, *available at* <http://www.ustr.gov/pdf/special.pdf> (April 30, 1999).

¹⁰⁷ See Provisional Patents Law No. 71 of 2001, *supra* note 76, art. 36.a. Even though the TRIPs Agreement does not directly extend patent protection to pharmaceuticals, they are however afforded patent protection by virtue of article

three years after Jordan becomes a WTO member.¹⁰⁸ In the meantime, a provision was made for securing a filing date for applications for pharmaceuticals.¹⁰⁹ Additionally, a provision was made for obtaining exclusive marketing rights during this period.¹¹⁰ Therefore, pharmaceuticals, drugs, and agriculture chemicals, previously not patentable, are now patentable under the Patents Law of 2001.

The Patents Law will bar domestic firms from copying patented drugs. Thus, Jordanian drug firms will no longer be able to reproduce patented medicines simply by using a different process. It will be several years before one could predict the impact of Jordan's Patent Law on its pharmaceuticals industry, though the shift to product patent system could make prices of medicines increase.

V ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS IN JORDAN

Compliance with the TRIPs provisions and other international agreements requires strong enforcement of Jordan's intellectual property laws. Although intellectual property laws in Jordan come closer to conforming with TRIPs, they are considered relaxed and not effectively enforced. Enforcement of intellectual property rights in Jordan is an area where many factors inform policy enforcement which reflects the current status of enforcement of intellectual property rights.

A *Administrative and Cultural Factors Undermine Enforcement Efforts*

Enforcement of intellectual property rights is not cheap.¹¹¹ Enforcement of intellectual property rights requires appropriation of millions of dollars that would capture a good portion of the annual budget of Jordan. Therefore, any action plan such as raids, seizures, arrests, or education campaigns to reduce intellectual property infringement is constrained by limited financial resources.

Jordan also experiences lack of sufficient human resources. For example, the Industrial Property Protection Directorate at Ministry and Industry and Trade has thirty-five professional, trademark and patent examiners, and support staff.¹¹² Until recently, these examiners were not required to be lawyers with intellectual property

27.2 & 3 which specify what products are non-patentable. In that list pharmaceuticals are not included.

¹⁰⁸ *Id.* article 36.e.

¹⁰⁹ *Id.* article 36.b.

¹¹⁰ *Id.* article 36.d.

¹¹¹ See Patents and the Poor, *Economist* 22 (June 23, 2001) (the cost for a poor country to build just a bare-bones infrastructure to implement TRIPs is roughly \$1.5-2 million).

¹¹² See Report of the Industrial Property Protection Directorate of Ministry of Industry and Trade, 3 (2008) (on file with the author). The number of trademark and patent examiners at the Ministry of Industry and Trade in Jordan constitutes a fraction of the some 7000 employee at the USPTO.

knowledge and expertise, having background in science and technology, or taking patent bar-like exam.

An effective intellectual property regime requires an effective well-trained customs service.¹¹³ General weaknesses inherent in the national judicial system are apparent in the area of intellectual property law. Judicial remedies in Jordan are futile due to unreasonable delays and lack of interim injunctions, and indeed are rarely sought.¹¹⁴ This is probably attributable to the novelty of Jordan's court structure for the adjudication of intellectual property disputes, and the lack of intellectual property experience of Jordanian judges.

Factors distinct from administrative and judicial structures, but just as deeply-rooted in the culture of Jordan, impede governmental efforts at heightened enforcement. Scepticism towards intellectual property tends to undermine the effects of enforcement measures. This attitude stems from the lack of benefits to the national interest which the Jordanian public believes would result in the event greater intellectual property protection is granted.¹¹⁵ For example, most trademark and patent applications in Jordan are owned by foreigners.¹¹⁶

The enforceability of intellectual property in Jordan may often be determined by political and cultural sentiments that a religiously-based law is necessary barrack

¹¹³ In addition to focusing on smuggling, accurate goods classification and tariff collection, compliance with security measures, the customs service in Jordan should enforce intellectual property rights. While caring about intellectual property rights, it is also of equivalent importance not to restrict trade. The customs service in Jordan may adopt a "selective" system as in the health and food safety rules whereby certain selected imports maybe examined to detect intellectual property violations.

¹¹⁴ The Jordanian Court of Cassation handled very few intellectual property cases. Between 2000 and 2006, the Court of Cassation heard two cases only. It is not just the number of cases that is dearth, but also the cases before the Court did not raise fundamental issues such as what types of inventions can be protected in patent law and, if so, how. See Court of Cassation, Decision No. 99/2797, Journal of the Jordanian Bar Association (2000). See also Court of Cassation, Decision No. 2003/2648, Journal of the Jordanian Bar Association (2003).

¹¹⁵ Many observers argue that the main effects of TRIPs are to redistribute economic rents from poor countries to the rich. See Keith E. Maskus, Regulatory Standards in the WTO: Comparing Intellectual Rights with Competition Policy, Environmental Protection, and Core Labor Standards, 1 World Trade Rev. 135, 137-138 (2002).

¹¹⁶ On average, the Industrial Property Protection Directorate in Jordan receives 170 patent and 5000 trademark applications a year. See Report of the Industrial Property Protection Directorate of Ministry of Industry and Trade, *supra* note 131, at 12. Foreign countries accounted for the biggest filings. Therefore, there is discrepancy in the ratio of domestic vs. foreign filings which could be translated into deficit in terms of paying patent and trademark royalties to intellectual property creditors.

against Westernization and the domination of Western culture.¹¹⁷ Therefore, violating intellectual property rights are means of revenge for the West's colonization of Jordan. Moreover, the traditions of consensus building, sharing in common, and concern for the protection of societal good is reflected in the basis of relationships in Jordan. There are different segments of the Jordanian society which would be affected by the high cost of acquiring intellectual property products because intellectual property is based on individual rights and paid access for those who can afford it.¹¹⁸

B *Intellectual Property Enforcement Record*

Given the limited resources and the cultural factors with which they have to work, employees of the Copyright Protection Office, police officers, and customs officials have done an outstanding of improving enforcement of intellectual property rights and creating a culture of intellectual property awareness in Jordan. There has been a significant increase in the number of inspections by law enforcement to clamp down on intellectual property violations. The Copyright Protection officers carried out about 444 inspections in 2008 with an estimated 148 cases of intellectual property violations.¹¹⁹ The inspections have been spread out to cover wider geographical areas in Jordan such as the cities of Irbid, Zarqa, and Amman. For example, in 2008, the Copyright Protection officers found 174 cases of violations in Amman, 32 cases in Irbid, 20 in Zarqa, 11 in Aqaba, 11 in Karak, and 3 in Mafraq.¹²⁰

Jordan has attached great importance to the publicity and training of intellectual property rights. Jordan opened special columns on newspapers, radio and television lectures, contests, and organized training courses to popularize intellectual property knowledge.¹²¹

¹¹⁷ See John Carroll, *Intellectual Property Rights in the Middle East: A Cultural Perspective*, 11 *Fordham Intell. Prop. Media & Ent. L.J.* 555, 574 (2001).

¹¹⁸ See Suha Ma'ayeh, *IPR Enforcement Improved Gets Mixed Reviews*, *Jordan Times* 10 (May 10, 2001) (without pirated software, my son could not have excelled in an Auto Cad program which I purchased for 3 Jordanian Dinar, said one Jordanian citizen, adding that the price of the original software is way beyond his reach).

¹¹⁹ See *Statistics on Enforcement on Intellectual Property Protection*, the National Library (2008) (on file with the author).

¹²⁰ *Id.*

¹²¹ See *Jordan Police Intensify Action Against Piracy*, *Jordan Times* 18 (May 15, 2001). In collaboration with the Ministry of Education, a national campaign was launched in 2005 to increase public awareness about intellectual property. The campaign included a quiz about intellectual property that was distributed to more than 150,000 school-aged students through various schools. Prizes were distributed to the winners of the quiz.

Enforcement of intellectual property in Jordan should be commended. In only few years, Jordan changed its norms and standards in intellectual property. Moreover, Jordan created a workable system for intellectual property protection.

V CONCLUSION

This article has examined the intellectual property regime in Jordan. Being a member of the WTO, Jordan is obliged to meet recommendations of the TRIPs Agreement. Therefore, as a good starting point for a new character to the intellectual property regime, Jordan enacted several new intellectual property laws to comply with TRIPs.

Jordan intellectual property laws have almost laid down the same conditions and requirements as provided for under the TRIPs Agreement. Computer programs are protected under the copyright regime. The current trademarks law provides provisions covering service marks and well known marks. Jordan patent law also provides protection to all patented inventions. In addition, Jordan patent law introduced provisions relating to pharmaceuticals. However, Jordan intellectual property laws have failed to set out some clarifications. For example, in stating the fair use defence, Jordan Copyright Law of 2001 does not define the terms “normal exploitation” and “legitimate interests.” In addition, Jordan patent law is silent as to the meaning of “use” or “exploitation” of an invention or what constitutes a “novel” invention.

The battle against intellectual property piracy and counterfeiting in Jordan most likely cannot be resolved by legislative enactments and regulatory measures alone. The enforcement of these intellectual property enactments is the mean to accomplish effective protection for intellectual property. Close examination reveals an overall disproportionate burden in the area of enforcement of intellectual property rights in Jordan. The ability to provide heightened protection of intellectual property rights has been severely limited by administrative deficiencies that include inadequate expertise and funding. Social and cultural factors also affect the ability of protection of intellectual property rights. The acceptability of intellectual property is critical for Jordan because the enforcement will depend upon the legitimacy of intellectual property.