

***The Civil Protection of Well-Known Trademarks:
In Algerian law and international texts
An Action for the Cancellation of Trademark Registration
as a Model***

Saidi Salah

Faculty of Law – University of Algiers 1(Algeria), s.saidi@univ-alger.dz

Received: 25-08-2025

Accepted: 23-03-2026

Published: 01-06-2026

Abstract:

This research paper highlights the importance of civil protection for well-known trademarks, given that they are often subject to infringements and violations, particularly when they are not registered. A well-known trademark enjoys a wide reputation among consumers, which makes it vulnerable to exploitation, imitation, or confusion by third parties. In this context, both international conventions and national legislations have taken on the responsibility of ensuring adequate protection for this category of trademarks, whether officially registered or not.

In this regard, the action for annulment of trademark registration occupies a central position in the legal framework protecting unregistered well-known marks. Registration is not considered a prerequisite for initiating civil protection measures when it comes to well-known marks. Accordingly, the owner of a well-known trademark — even if it has not been filed — is entitled to bring a legal action to annul the registration of any similar mark that may cause confusion or mislead the public, in order to safeguard their rights and the distinctiveness of their brand in the market.

Key words: well-known trademark, civil protection of well-known trademarks, action for annulment of registration of a well-known trademark, effects of annulment action on well-known trademark registration.

1. Introduction

The Algerian legislator did not explicitly define the concept of a well-known trademark. However, it was indirectly addressed in Ordinance No. 03-06 on trademarks, as previously mentioned. Article 8 of the same ordinance states that a well-known trademark is excluded from registration if it has been used for identical or similar goods by another entity, to the extent that it may cause consumer confusion.

Thus, a well-known trademark is originally an ordinary one that gains recognition in the market over time until it becomes familiar to the public. Its protection does not require formal registration. Accordingly, a well-known trademark is one whose reputation has extended

beyond the borders of its country of origin to reach consumers in another country — for instance, trademarks such as **Nokia**, **Coca-Cola**, and **Apple**.

Building on the above, the well-known trademark is considered one of the most important types of trademarks, given the intangible value it adds to the products and services offered by traders, manufacturers, professionals, and service providers in the market.

A well-known trademark serves as an effective tool used by companies to promote their products and distinguish them from those of their competitors in the marketplace.

Given the paramount importance of well-known trademarks—particularly in the context of international trade—most countries have devoted considerable attention to this category of marks. This is evident in the various national legislations and international agreements concluded in this regard. (G.H Bodcnhauen. , 1968, p. 17)

In addition to the provisions established by domestic (national) legislation, which have recognized a special form of protection regardless of whether the trademark is of domestic or foreign origin, it is worth noting that most national legal systems have merely incorporated specific rules regarding the protection of well-known trademarks, without attempting to define the legal meaning of such marks through clear and applicable criteria. This legislative ambiguity mirrors the approach taken in international legal instruments and conventions.

The term "*well-known trademark*" consists of two components:

"**Trademark**" (‘علامة’) is the plural of ‘*alam*’ or ‘*alamat*’, meaning a sign or symbol (Nassar, Sayed Ahmed & Mostafa, Mohamed, 2018, p. 371, 2018, p. 371). A *alam* is something erected in open lands to serve as a guide for those who are lost (Abu al-Fadl Jamal al-Din Ibn Manzur, 2005, p. 264, 2005, p. 264). The word *alama* also refers to a trace, a signal, a tall mountain, a sign, or a banner. (Louis Maalouf, p. 526, p. 526)

The term "*well-known*" (*mashhūra*) is the plural of *mashāhūr*, and refers to that which is widely recognized or known among the public (Nassar, Sayed Ahmed & Mostafa, Mohamed, 2018, p. 371, 2018, p. 518). It

signifies the clarity or prominence of something, as in the expression “he drew his sword openly” or “so-and-so became well known among the people¹ for a certain matter.” (Abi al-Husayn Ibn Zakariya, 2008, p. 518, 2008, p. 518)

In addition to the protection afforded to well-known trademarks² under international agreements,⁷ the Algerian legislator has adopted a similar approach in Ordinance No. 03-06 concerning trademarks, which repealed Ordinance No. 66-57. The latter did not contain any specific provisions regarding well-known trademarks. This legislative omission was addressed in Ordinance 03-06, specifically in Articles 07(8) and 09(4). Under these provisions, the Algerian legislator granted the owner of a trademark the right to prevent any unauthorized third party from using their mark without prior consent³.

Given the critical role played by well-known trademarks, it is essential to ensure their legal protection—both to safeguard the legitimate interests of trademark owners against unfair competition in the marketplace, and to protect the broader public interest.

As these trademarks are particularly vulnerable to infringement through unauthorized use or registration by third parties, the issue of their legal protection has asserted itself forcefully within both international conventions and domestic laws. (Salami Miloud, 2012, p. 53, 2012, p. 53) This applies irrespective of whether the trademark is registered or unregistered. A registered well-known trademark enjoys dual protection—civil and criminal. ((Salami Miloud, 2011, p. 164), 2011, p. 164) Conversely, an unregistered well-known trademark is afforded only civil protection, whereby the owner may claim compensation for acts of unfair competition and seek the cancellation of any registration that could cause them harm. (Ali Haroun, 1979, p. 194)

Accordingly, this study will be limited to the civil protection mechanisms available for well-known trademarks, focusing specifically on the **action for cancellation of trademark registration**.

Our analysis will be structured around the following two chapters:

Chapter One: The Nature and Conditions of the Action for Cancellation of Trademark Registration.

Chapter Two: Legal Effects of the Action for Cancellation of Trademark Registration.

Chapter One: The Nature and Conditions of the Action for Cancellation of Trademark Registration

The owner of a well-known trademark who holds priority in terms of either registration or use is entitled to request the cancellation of a trademark that is identical or confusingly similar to their own and is likely to mislead consumers.

In this regard, the holder of a well-known mark is permitted to initiate legal proceedings aimed at invalidating a trademark that may create confusion with their own. This right is enshrined in Article 20 of Ordinance No. 03-06 concerning trademarks, which provides:

“The competent judicial authority may cancel the registration of a trademark retroactively from the date of its filing, upon request by the competent authority or any interested party, if it is established that the trademark should not have been registered...”

In application of this legal provision, the holder of a well-known trademark must resort to judicial proceedings by filing an action for cancellation. This necessitates an examination of the **definition of the action for cancellation of a trademark registration** (*Section One*) and the **conditions for its admissibility** (*Section Two*).

Section One: Definition of the Action for Cancellation of Trademark Registration

The **action for cancellation of trademark registration** refers to a civil legal action brought by the owner of a well-known trademark to protect their mark against any confusion or deception caused by a subsequent registrant who seeks to infringe upon the reputation of the well-known mark.

The opposition procedure begins before the *National Institute of Industrial Property (INAPI)*, within a legally prescribed period that starts from the date of publication in the official gazette of the INAPI and lasts until the expiration of the opposition deadline. During this period, the owner of a well-known trademark may initiate judicial proceedings. However, the INAPI itself may, pursuant to **Article 6 bis (2)** of the *Paris Convention*, invalidate a trademark if it determines that the mark in question qualifies as a well-known mark (Zoubir Hammadi, 2012, p. 13, 2012, p. 13).

Article 6 bis(2) of the Paris Convention provides that: ((Paris Convention, March 20, 1883))

“Upon request of an interested party, the competent authority shall refuse or cancel the registration and prohibit the use of a trademark which constitutes a reproduction, imitation, or translation liable to create confusion with a well-known trademark, as determined by the competent authority in the country where the registration or use has occurred.”

From this provision, we understand that the *Paris Convention* grants the holder of a well-known trademark the right to seek the cancellation of any subsequent registration that is likely to cause harm or confusion among the public. ((Mazen Fathi Al-Jabareen & Enas, 2010, p. 178), 2010, p. 178)

A concrete example can be found in the **unauthorized use of the logo of Al Jazeera Channel** on the facades of internet cafés and barbershops in certain Arab cities. This misuse prompted the channel to repeatedly announce that its logo is a registered trademark and to warn that any imitation constitutes a violation of intellectual property rights.

It should also be noted that the **cancellation of trademark registration only applies to the specific goods or services for which the contested mark was registered**. It does not extend to other unrelated goods or services. This principle is expressly stated in **Article 27 of Executive Decree No. 05-277**, which provides:

“...In cases involving only a portion of the goods or services for which the mark was registered, cancellation shall be limited to that portion of the goods or services.”

Finally, it is important to point out that the **action for cancellation must be brought before the court that has both territorial and subject-matter jurisdiction**, following the general rules established under the *Code of Civil and Administrative Procedure*.

Section II: Conditions for Filing a Claim to Invalidate a Trademark Registration:

To bring a legal action, certain procedural conditions must be met, following the general rules outlined in Article 13 of the Algerian Code of Civil and Administrative Procedure (CCAP), which stipulates:

“No one may bring legal proceedings unless they have legal standing and a current or potential interest recognized by law.”

In addition to these general conditions, the law imposes specific requirements on the owner of the well-known trademark, which must be met for the legal action to be admissible under any circumstances. These include:

(Subsection 1): Proof of prior filing by the owner of the well-known trademark,

(Subsection 2): Likelihood of confusion between the trademarks

(Subsection 3): Non-applicability of the statute of limitations to the claim .These aspects will be addressed in detail as follows:

Subsection 1: Proof of Prior filing by the owner of the well-known trademark

When the owner of a well-known trademark discovers that another mark infringes upon theirs to cause harm or create confusion among consumers regarding the origin of goods or services, they must demonstrate that they were the first to file the trademark. Prior registration establishes ownership and entitles the holder to protection against unauthorized use.

Any party claiming priority must submit a certified copy of the earlier application to the National Institute of Industrial Property (INAPI), duly authenticated by the competent authority, and pay the applicable fee to assert priority.

If the claimant is not the original applicant, they must provide written authorization from the original trademark owner or their legal successor. In the case of a foreign priority claim, it must be asserted at the time of applying; failure to do so results in the forfeiture of the right to claim priority. (Zoubir Hammadi, 2012, p. 13, 2012, p. 148)

Subsection 2: Likelihood of Confusion Between the trademarks

A claim to invalidate a registered trademark by the owner of a well-known mark is only legally permissible if there is a likelihood of confusion between the contested mark and the well-known trademark.

Confusion, in this context, refers to the similarity between the marks that may mislead or deceive the consuming public.

Determining whether a likelihood of confusion exists is a factual issue, and thus falls within the discretionary power of the judge, who evaluates the similarity between the marks and its potential to deceive consumers.

The evaluation is based on similarity rather than difference, as even partial similarity can create confusion for the average consumer.

Therefore, it is sufficient that the principal idea of both trademarks is similar to confuse, whether by phonetic resemblance, visual similarity, or color likeness. Additionally, no third party may use a well-known mark, even on unrelated products or services.

It should be noted that Algerian courts have adopted the position that, for a case concerning a well-known trademark to be considered, there must be a significant degree of similarity between the imitated mark and the well-

known mark. Additionally, the products in question must belong to the same category, such that the resemblance is likely to confuse a substantial segment of the relevant consumer public. Otherwise, the court will rule the claim to be unfounded.

Moreover, the category of consumers of the goods is one of the key factors considered by the judiciary, given that the consumer is a crucial element in the consumption process. Therefore, it is essential to ensure their protection against confusion and deception that may arise from the similarity between trademarks.

Furthermore, imitation occurs through imitation that misleads and deceives the public. This implies the existence of a trademark that resembles a registered trademark to the extent that it causes confusion and deception among consumers. In order for an act to be considered trademark imitation, there must be a close resemblance between the two marks capable of causing confusion. Therefore, the imitation must result in the deception of the public, and the assessment of whether a trademark has been imitated is based on the points of similarity

rather than the differences between the marks. The overall similarity must be evaluated, and the following criteria are used to assess this similarity:

Criteria for Assessing Similarity:

1. Focus on the Points of Similarity between the Marks:

The assessment of imitation is based on a comparison between the original mark and the allegedly similar one, with particular attention paid to the overall points of resemblance. When comparing the marks, they should not be viewed side by side but rather one after the other. Imitation occurs if the similarity between the two marks is sufficient to cause confusion or mistake, regardless of any differences between them. The comparison should be based on the distinctive and protected elements of the marks.

In one well-known case before Algerian courts involving Hammoud Boualem, the owner of the trademark *Selecto*, and the company Zerka, which used the trademark *Selectra*, the court held that there was sufficient similarity and a likelihood of confusion between *Selectra* and *Selecto*. The court's assessment relied primarily on the likelihood of consumer confusion. Importantly, the court did not require actual confusion to have occurred; the mere possibility of such confusion was deemed sufficient. The decision also emphasized the points of similarity over the differences between the marks. This approach mirrors that of the French judiciary, which also considers the potential for consumer deception a key element in determining trademark imitation in cases of mark similarity.

2. Likelihood of Consumer Confusion:

Imitation by similarity requires that the similar mark be capable of confusing the mind of the consumer. Actual confusion does not need to have occurred; rather, the mere possibility of confusion is sufficient to constitute imitation. This was explicitly provided for under repealed Ordinance No. 66/57 concerning industrial and commercial trademarks, which required that the similarity be "likely to mislead the public." The use of the phrase "likely to" clearly indicates that actual confusion is not a prerequisite—only the potential for it.

Ordinance No. 03/06 later adopted a broader understanding of imitation, referring to "any act infringing the exclusive rights of the registered trademark owner..."

3. The Standard of the Average Consumer:

In assessing similarity, in addition to the degree of resemblance and likelihood of confusion, the perspective of the average consumer is also considered. Judges are required to evaluate the likelihood of confusion based on the standard of a reasonably observant and circumspect average consumer, with both marks presented before them. The legislator made no distinction between direct imitation and resemblance by similarity, deeming any act infringing the exclusive rights of the trademark owner a criminal offense. The law adopts a broad definition of imitation, considering both direct copying and imitation by resemblance as forms of direct infringement. The legislator intended to treat all acts that infringe upon the rights of the trademark holder as a single offense subject to the same legal consequences.

Subsection 3: Non-Applicability of Statutory Limitation

Article 6(2) of the Paris Convention provides insight into the limitation period for bringing an invalidity claim:

“A period of at least five years from the date of registration must be granted to request the cancellation of a trademark, and Union countries may prescribe a period within which the use of the mark must be challenged.”

However, the Convention provides an exception to this limitation, specifying that no time limitation shall apply where the mark was registered or used in bad faith. This principle is enshrined in Article 714 of the French Intellectual Property Code. (Zerroui Farha Saleh, 2001, p. 226, 2001, p. 226)

Similarly, Algerian law allows for the invalidation of a trademark that may confuse with a previously registered mark, provided the action is

brought within five years from the date of the disputed registration. An exception exists in cases where the registration was made in bad faith.

Chapter Two: Legal Effects of the Action for Cancellation of a Trademark Registration

The initiation of a legal action to invalidate the filing of a trademark that may confuse with a well-known mark—whether the latter is registered or not—shall, when all the legal conditions for admissibility and proper filing of the claim are met, undoubtedly give rise to significant legal effects. These effects concern both the parties involved (**Section One**) and third parties (**Section Two**), as will be explained below.

Section I: Effects on the Parties:

A trademark is legally presumed to belong to the party who first applied. Priority in filing establishes clear and undisputed ownership among the litigants.

Subsection 1: Effect on the Plaintiff:

If the plaintiff successfully proves ownership of the well-known trademark *v* and priority in registration, they maintain their exclusive rights to the mark. This includes the ability to commercially exploit the trademark and to transfer or license its use to third parties.

It is worth noting that continued protection of the well-known trademark requires periodic renewal of the registration every ten years. (Zoubir Hammadi, 2012, p. 13, 2012, p. 103)

Subsection 2: Effect on the Defendant:

If a judgment is rendered in favor of invalidating the trademark, the defendant loses all rights to the disputed mark. The judgment is recorded in the trademark register, and the cancellation is published in the official bulletin dedicated to trademark invalidations:

Section Two: Effects on Third Parties

A judgment invalidating a trademark carries binding legal force with respect to third parties. Any person intending to use a particular trademark must avoid infringing upon the rights of others. Therefore, prior to using or filing a trademark, one is required to ensure that the mark has not already been registered. This obligation entails continuously updating one's information through regular consultation of the Official Industrial Property Bulletin, which publishes trademark registrations and related modifications.

It is worth noting that the protection of well-known trademarks against infringement by third parties is granted due to the economic value such trademarks inherently possess.

From an economic perspective, trademarks play a significant role. When trademarks achieve their intended purpose—namely, fair competition—they contribute to attracting foreign capital and expertise in the fields of industry, commerce, and services, thereby fostering national economic growth and supporting development.

Moreover, the influx of foreign expertise will compel Algerian enterprises to enhance the quality of their services.

It is also widely recognized that well-known trademarks play a crucial role from a social standpoint. They contribute to shaping intellectual and social development by promoting consumer protection against misleading advertising and enabling consumers to understand the composition of the products they intend to purchase.

Conclusion:

In this study, we addressed the civil protection of a well-known trademark, and the lawsuit to invalidate the filing of a mark as an example of the legal mechanisms established to establish this protection, whether this mark is registered or otherwise.

This is done by filing a civil lawsuit against anyone who registers or uses a mark that causes confusion with his mark, in embodiment of the spirit of Article 20 of Order No. 03/06 relating to marks.

He may also legally file a lawsuit for illegal competition if he suffers damages resulting from his competitors in the market in an illegal manner.

This issue does not fall within the framework of our study. By reviewing the rulings on the lawsuit to invalidate the filing of the well-known trademark as a model for civil protection established for the famous mark, we record the following:

First: Results:

1- The well-known trademark was originally nothing but an ordinary mark, then it began to spread in the markets, in a way that made it very well known to most people interested in the world of production, trade, or services, linked to products, goods, or services with distinctive characteristics from a specific, known source.

2- It follows the protection of the well-known trademark from an abstract realistic fact, represented by its reputation (i.e., its fame) and the (fame) that that reputation contained, which led to its expansion in its country of origin, and then its fame overflowed.

3- Regarding the legal protection provided for the well-known trademark, we explained previously that the Algerian legislator has approved dual protection: civil protection and criminal protection, as the latter exceeds the registered mark. However, reality shows us that most famous marks are not registered, and therefore civil protection must be provided because registration is not a condition for this type of protection. What justifies him as the owner of the well-known trademark, whether registered or unregistered, in defending his mark by filing civil lawsuits against whoever registered or used a mark that causes confusion or confusion with his well-known trademark. Its owner can file a lawsuit demanding the cancellation of the filing of the mark that causes confusion or confusion with his mark, embodying the spirit of Article 20 of Order No. 03-06 attached to marks, and against the issue that was the subject of our study. He also has the right to file a lawsuit for unfair competition (this case was not included in our analysis).

Second: Suggestions:

1- The necessity of establishing a specific definition of the well-known trademark to bring its legal concept closer to the broad public, and establishing criteria that can be relied upon to estimate the extent of the mark's fame in the national country. It is also similar to the Jordanian project that defined it in the Jordanian Trademark Law of 1999.

2- The mark, as a moral right, needs legal protection that guarantees its calm and continuous exercise, which is not sufficiently available, as the current law has opened the way for many violations and transgressions against marks, especially those that have gained fame on the global scene (the subject of our study).

References

I. Sources:

I. Legal Texts and Regulations

1. **Paris Convention of March 20, 1883**, as amended several times, ratified by Algeria under Ordinance No. 75-02 of January 9, 1975, concerning the ratification of the Paris Convention for the Protection of Industrial Property, *Official Gazette* No. 10 of February 10, 1975.
2. **Ordinance No. 66-57** of March 19, 1966, concerning factory and trade marks, *Official Gazette* No. 23 of March 22, 1966.
3. **Ordinance No. 03-06** of July 19, 2003, relating to trademarks, *Official Gazette* No. 43 of July 23, 2003.
4. **Executive Decree No. 05-277**, defining the procedures for the filing and registration of trademarks, *Official Gazette* No. 54 of August 7, 2005, as amended and supplemented by **Decree No. 08-366** of October 26, 2008, *Official Gazette* No. 63 of November 16, 2008.

References

1. Books

- Abi al-Husayn Ibn Zakariya**. *Mu'jam Maqāyīs al-Lughah*. Dār Ihyā' al-Turāth al-'Arabī, Beirut, 2008.
- Abu al-Fadl Jamal al-Din Ibn Manzur**. *Lisan al-Arab*, Vol. 10, 1st ed., Dār Ṣādir, Beirut, 2005.
- Hammadi Zoubir**. *La protection juridique des marques commerciales*, Ḥalabi Legal Publications, Beirut, 2012.
- Zerroui Farha Saleh**. *Al-Kamil fi al-Qanun al-Tijari al-Jazairi (Intellectual Property, Industrial and Commercial Property, Literary and Artistic Property Rights)*, Vol. 2, Ibn Khaldoun, Algeria, 2001.
- Mazen Fathi Al-Jabareen & Enas**. *Civil Protection of Unregistered Trademarks under Jordanian Law*, Master's Thesis, Middle East University, Jordan, 2010.

-Nassar Sayed Ahmed & Mostafa Mohamed. *Al-Mu‘jam al-Wasit*, Vols. 1–2, Dār Iḥyā’ al-Turāth al-‘Arabī, 1st ed., Iraq, 2008.

2. Doctoral Thesis

-Salami Miloud. *The Legal System of Trademarks*, Doctoral Dissertation, Faculty of Law, University of Batna, Algeria, 2012.

3. Academic Articles

-Salami Miloud. *The Well-Known Trademark in Algerian Law*, *Dafater al-Siyassa wa al-Qanun* (Politics and Law Journals), No. 4, University of Batna, Algeria, January 2011.

4. References in Foreign Languages

-Ali Haroun. *La protection de la marque au Maghreb*, published by the Office des Publications Universitaires, Algiers, 1979.

-G. H. Bodenhausen. *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, 1968.