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2015: YEAR IN REVIEW

Our annual “Year in Review” series sums up the most important intellectual property developments and news that unfolded over the past year in the Middle East, North Africa and their neighboring regions.

We are still waiting to see the effects of the political and civil uprisings in Tunisia, Egypt, Libya, Yemen and Syria on the IP protection framework of those countries. While the Libyan TMO began issuing trademark registration certificates after a wait of more than 37 years, nothing significant has unfolded in the remaining countries to date.

On the other hand, countries of the GCC have been relatively busy over the past few months with the introduction of the implementing regulations of the GCC unified trademark law. The regulations will be put into effect across all countries although there will be no unified/centralized filing system as is the case with the GCC patent law. Trademark applications will continue to be filed separately at the TMO of each GCC member state for protection, and the six different GCC countries will maintain their own trademark registers. Having said that, we are presuming at this stage that the official fees will not be unified over all six countries. Seeing that applications will be managed separately at each TMO, we would expect the official fees to vary depending on the individual overhead costs of the different TMOs involved. Nevertheless, we have seen UAE, Kuwait, Bahrain and KSA over the past few months making considerable revisions in their official fees schedules.

An important development that has been under the spotlight over the past few months was the Iran Deal that is expected to have a significant impact on both the economy of the country and global markets. Not only will the energy sector be particularly affected, but it is also anticipated that the economic impact of a partial lifting of sanctions will perpetuate the energy sector into a wide range of industries including consumer products, food and beverage, apparel, pharmaceuticals, and tobacco, among others. Although the US and EU sanctions programs currently in place allow individuals and entities to perform IP-related transactions, with the lifting of sanctions in Iran, we expect many businesses to look into expanding their operations into the country with a growing need for establishing tailor-made local IP protection strategies.

Other notable developments worth pointing out are outlined in the table below:



COUNTRY	
Egypt	Taking the Fast Lane on the Patent Prosecution Highway Pilot Program with Japan <p>The Egyptian Patent Office and the Japanese Patent Office began a two-year Patent Prosecution Highway program on June 1, 2015. The program allows an application that has been determined to be patentable by the Japanese Patent Office to undergo an accelerated examination by the Egyptian Patent Office with a simple procedure upon the applicant's request.</p>
Lebanon	Updated POA Requirements <p>Lebanon declared a revision of the power of attorney authentication requirement on March 21, 2015 stating that all POA submissions after April 10, 2015 must be legalized by the Lebanese consulate.</p>
Iran	Remember to Seal the Deal <p>The Iranian Intellectual Property Office announced that all translated documents, including power of attorney, must bear the seal of the Iranian consulate on every page or at least include a seal indicating number of pages with an official stamp of notary public and the seal of the Iranian consulate. This update applies to all pending and future applications filed at the IIPO.</p> PCT National Phase Entry <p>Patent filings in Iran have seen a significant increase in 2015 as a result of the country's accession to the PCT in 2013. Indeed, the 30 month deadline for PCT applications claiming priority starting from October 4, 2012 was reached on April 4, 2015. Adding on top of that the nuclear deal agreement, and Iran's educated work force and industrial capabilities, we expect to see an increased demand in patent protection as the enforcement landscape starts taking on shape.</p>
Morocco	European Patents Recognized <p>Morocco became the first country not signed up to the European Patent Organization to validate European Patents starting March 1, 2015.</p> Protection of Geographical Indications <p>Morocco concluded an agreement with the European Union in March 2015 concerning the protection of food and agricultural products of specific geographical locations. The geographical indications agreement has yet to be passed by the legislative authorities in Morocco and the European Council and Parliament.</p> Laying Down the Law Update <p>Morocco issued Law No. 23-13 on December 18, 2014, which amends and completes Law No. 17-97 of 2000. The new law entered into force on the date of announcement. The law includes provisions on the protection of patents, integrated circuits, industrial designs, trademarks, and trade names.</p>

COUNTRY	
Oman	Protecting New Plant Varieties Applications for protecting new plant varieties may be filed with the General Directorate for Plant and Animal Research at the Ministry of Agriculture and Fisheries as of June 2015.
Saudi Arabia	PCT National Phase Entry Begins on Schedule The Saudi Patent Office accepted the first PCT national stage entry on February 3, 2015. The requirements, annuity due dates, and fees remain the same as for convention filings.
Libya	Reinstatement of Expired Trademark Registrations The TMO has reportedly opened the door until December 31, 2015 for the reinstatement of trademark registrations which have expired in the years 2013 to 2015. According to the statutory provisions, the protection period is 10 years from filing date. However, the purpose of this exemption is to address the considerable backlog of work that the TMO is currently dealing with which comes as a result of the ongoing unrest in the country leading to an increased load <i>vis-à-vis</i> the present level of resources. With this new arrangement, the TMO is obviously trying to stream-line the flow of work in the best possible way although it is still not clear if the end-of-December deadline is final or will be extended any further.
UAE	Speeding Up the Opposition Process The UAE Trademark Office began the implementation of a special project to clear the backlog of pending opposition cases in March 2015. This project allowed the TMO to hold hearings and issue decisions for all pending opposition cases immediately after holding the hearing sessions.

With this Review, we attempted to answer many of the questions commonly asked regarding IP procurement in our region in light of the recent fundamental developments. This Review is not intended to be comprehensive. Hence, many details are omitted to avoid complications as much as possible.



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MENA: ESTABLISHING BONA FIDE USE

This article focuses on the bona fide use requirement in the Middle East region, and how the practice differs from that of the US, beginning first with an overview of the statutory provisions on use in the local trademark laws – with an examination of the various procedural contexts in which this issue may arise. The article will then move to address the different documentary evidence that may be taken into consideration when challenging an applicant’s use in administrative or court proceedings.

1. Statutory provisions and applicable practice on use

Use is not required for registration (with the exception of Algeria at the time of renewal). However, failure to use the trademark within a specific period of time will in principle subject a trademark registration to cancellation on the grounds of non-use. However, unlike the United States where a cancellation action is similar to an opposition action in applicable law, the situation is not the same in the Middle East. More specifically, administrative procedures for canceling a trademark are only available in few countries, namely Jordan and Oman. In the remaining countries, cancellation actions must be brought before the local courts, which can greatly increase the time, costs and even predictability of such proceedings.

Another issue to take note of with regards to cancellation due to non-use is the issue of the burden of proof. In most countries, the burden of proof in a cancellation proceeding is usually on the plaintiff in order to prove that the registered trademark should not be registered. This of course renders non-use cancellation actions expensive since a negative, namely, that a mark is not in use, must be proven.



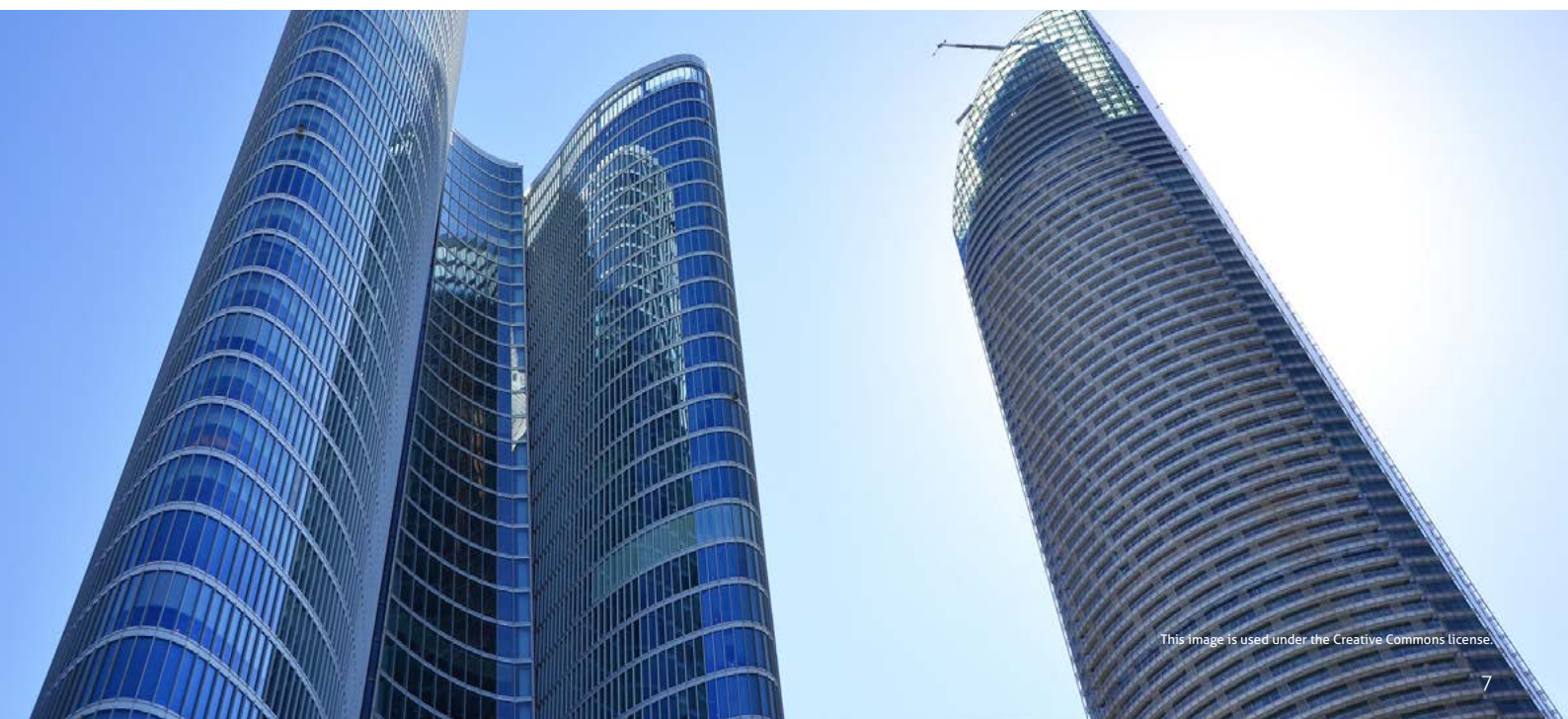
2. Standards of use

Notwithstanding the complicated legal proceedings of a non-use cancellation action, it will be important to establish valid and genuine use in the countries of the Middle East. It will be necessary for the trademark to be directly used by the sale of goods bearing the trademark (or rendering of services under the trademark, as the case may be). Other standards of use are available but are not clearly defined in the underlying laws and regulations.

In fact, the body of case law adjudicating the issue of a bona fide use does not clearly shed light on the types of affirmative activities and explanations for the absence of active plans that will be deemed sufficient proof of a bona fide use, either in a summary judgment motion or at a trial. We can at least list out the activities that could be deemed indicative of the presence of a bona fide use including:

- conducting a trademark availability search;
- performing preparatory graphic design work or labeling on sales material for the products;
- using the mark in international jurisdictions;
- testimony regarding informal, unwritten business plans or market research;
- obtaining necessary regulatory permits;
- obtaining a correlative domain name for the mark or setting up a website;
- making contacts with individuals who might help develop a business;
- correspondence mentioning the planned use of the mark in the country;
- attempts to find licensees in the country;
- having a credible marketing reason for deferring product introduction (US sanctions)

We obviously can rely on all of the aforementioned in our defense but the outcome is definitely not conclusive. Therefore, the question of valid use can only be tackled from a practical perspective, meaning that the answer to what constitutes valid use should never be considered as definite and exhaustive.



COUNTRY	REGULATORY PROVISION
Egypt	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years.
Jordan	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 3 consecutive years preceding date of filing for cancellation.
Kuwait	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years preceding date of filing for cancellation.
Lebanon	No provisions for cancellation due to non-use.
Oman	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years from registration date.
Qatar	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years preceding the date of filing for cancellation.
Syria	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 3 consecutive years preceding the date of filing for cancellation.
UAE	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of a mark for a period of 5 consecutive years from registration date.
Yemen	A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years preceding date of filing for cancellation.



MENA: ARAB CONTRACTING PARTIES TO THE WIPO ADMINISTERED TREATIES (2015)

	Algeria	Bahrain	Egypt	Iraq	Jordan	Kuwait	Lebanon	Libya	Morocco
Berne Convention	●	●	●		●	●	●	●	●
Brussels Convention		●					*		●
Madrid Agreement (Source)	●		●				●		●
Nairobi Treaty	●		●						●
Paris Convention	●	●	●	●	●	●	●	●	●
Patent Law Treaty	*	●					*		
Phonograms Convention			●						
Rome Convention	●	●					●		
Trademark Law Treaty		●	●						●
WIPO Copyright Treaty	●	●			●				
WIPO Performances and Phonograms Treaty	●	●			●				●
Budapest Treaty		●			●				●
Hague Agreement			●						●
Lisbon Agreement	●								●
Madrid Agreement (Marks)	●		●						●
Madrid Protocol	●	●	●						●
Patent Cooperation Treaty	●	●	●					●	●
Locarno Agreement	*								
Nice Agreement	●	●	●				●		●
Strasbourg Agreement			●		●				
Vienna Agreement					●				
The International Union for the Protection of New Varieties of Plants					●				●

* Signature ● In Force

MENA: ARAB CONTRACTING PARTIES TO THE WIPO ADMINISTERED TREATIES (2015)

	Oman	Qatar	Saudi Arabia	Sudan	Syria	Tunisia	UAE	Yemen
Berne Convention	●	●	●	●	●	●	●	●
Brussels Convention	●							
Madrid Agreement (Source)					●	●		
Nairobi Treaty	●	●			●	●		
Paris Convention	●	●	●	●	●	●	●	●
Patent Law Treaty	●		●	*				
Phonograms Convention								
Rome Convention					●		●	
Trademark Law Treaty	●							
WIPO Copyright Treaty	●	●					●	
WIPO Performances and Phonograms Treaty	●	●					●	
Budapest Treaty	●	●				●		
Hague Agreement	●				●	●		
Lisbon Agreement						●		
Madrid Agreement (Marks)					●			
Madrid Protocol	●					●		
Patent Cooperation Treaty	●	●	●	●	●	●	●	
Locarno Agreement								
Nice Agreement					●	●		
Strasbourg Agreement								
Vienna Agreement						●		
The International Union for the Protection of New Varieties of Plants	●					●		

* Signature ● In Force

SABA
INTELLECTUAL
PROPERTY



Having someone to protect has been
our favorite gift so far.

**Season's
Greetings**

THE SABA NETWORK

Head Office

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 45 48 88
Fax: +961 5 45 48 44
E-Mail: headoffice@sabaip.com

Algeria

Cabinet Boukrami
(In cooperation with Saba & Co. IP)
Centre Commercial et d'Affaires El Qods, BU 10-04B
Cheraga 16002
Algiers, Algeria
P.O. Box 86 Centre Commercial et d'Affaires El Qods,
Cheraga 16002
Tel: +213 21 34 11 61
Fax: +213 21 34 11 62
E-Mail: algeria@sabaip.com

Bahrain

Bahrain Tower, Al-Khalifa Road
Manama, Bahrain
P.O. Box 21013
Tel: +973 17 210 301
Fax: +973 17 224 699
E-Mail: bahrain@sabaip.com

Cyprus

Mitsis Building #2
14, Makarios Avenue
1065 Nicosia, Cyprus
P.O. Box 21143
1502 Nicosia
Tel: +357 22 755 434
Fax: +357 22 754 037
E-Mail: cyprus@sabaip.com

Djibouti

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 45 48 88
Fax: +961 5 45 48 44
E-Mail: djibouti@sabaip.com

Egypt

10 Aisha El Taymouriah Street
Garden City, CP 11451
Cairo, Egypt
P.O. Box 129, Mohamed Farid
Tel: + 20 2 279 59686
Fax: + 20 2 279 52314
E-Mail: info@sabaip-eg.com

Ethiopia

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 45 48 88
Fax: +961 5 45 48 44
E-Mail: ethiopia@sabaip.com

Gaza

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: gaza@sabaip.com

Iraq

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: iraq@sabaip.com

Jordan

56 Prince Shaker Bin Zaid Street
Al Shemissani
Amman, Jordan
P.O. Box 840553, Amman 11184
Tel: +962 6 464 2145
Fax: +962 6 464 2159
E-Mail: jordan@sabaip.com

Kuwait

Al Hajri Building
Al-Shuhadaa Street
Kuwait, Kuwait
P.O. Box 1245, 13013 Safat
Tel: +965 2 242 3428
Fax: +965 2 240 2243
E-Mail: kuwait@sabaip.com

Lebanon

Saba House,
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9420
Tel: +961 5 45 48 40
Fax: +961 5 45 48 42
E-Mail: lebanon@sabaip.com

Libya

Saba House,
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: libya@sabaip.com

Morocco

185 Boulevard Zerkoutouni
Residence Zerkoutouni
Casablanca 20330
Casablanca, Morocco
P.O. Box 13 921
Casablanca 20032
Tel: +212 522 251 530
Fax: +212 522 251 603
E-Mail: morocco@sabaip.com

Oman

Muscat International Centre
Beit Al Falaj Street
Muscat, Oman
P.O. Box 2027 Ruwi
Postal Code 112, Sultanate of Oman
Tel: +968 248 111 26
Fax: +968 248 111 28
E-Mail: oman@sabaip.com

Qatar

Gridco Building
C Ring Road
Doha, Qatar
P.O. Box 14035
Tel: +974 44 42 3992
Fax: +974 44 32 4106
E-Mail: qatar@sabaip.com

Saudi Arabia

Al Hadaf Marks Services LLC
(In Cooperation with Saba & Co. IP)
Al-Oula Building, King Fahd Road
Riyadh, Saudi Arabia
P.O. Box 61145
Riyadh 11565
Tel: +966 11 2079596
Fax: +966 11 2079598
E-Mail: saudi@sabaip.com

South Sudan

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: southsudan@sabaip.com

Sudan

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: sudan@sabaip.com

Syria

Adib Khair Building
Fardos Street
Damascus, Syria
P.O. Box 460
Tel: +963 11 223 6628
Fax: +963 11 222 6280
E-Mail: syria@sabaip.com

Tunisia

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: tunisia@sabaip.com

United Arab Emirates

Al Rostamani Building,
Al Ettihad Street, Deira
Dubai, UAE
P.O. Box 42259
Tel: +971 4 2959 650
Fax: +971 4 2959 651
E-Mail: uae@sabaip.com

West Bank

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
P.O. Box 11-9421
Tel: +961 5 454 888
Fax: +961 5 454 844
E-Mail: westbank@sabaip.com

Yemen

Hadda Towers, Building #7
Hadda Street
Sana'a, Yemen
P.O. Box 1493
Tel: +967 1 420 595
Fax: +967 1 420 596
E-Mail: yemen@sabaip.com