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SAUDI ARABIA: NEW REGULATIONS FOR ENTERING PCT NATIONAL PHASE

Saudi Arabia recently published new Implementing Regulations of the Patent Law to include provisions concerning the national phase entry of PCT patent applications. These regulations entered into force on December 19, 2015.

Revisions to the Implementing Regulations include the possibility of requesting extensions of time during prosecution, and the possibility to restore abandoned or canceled patent applications.

According to the new regulations, the international filing date will be the filing date of a PCT national entry and the base year for calculating annuities. Annuity fees for applications will still be due between January 1 and March 31 of each year, starting with the first payment that will include any back payments the year following the entry date. The usual grace period with a late fee will still apply through June 30 of the same year.

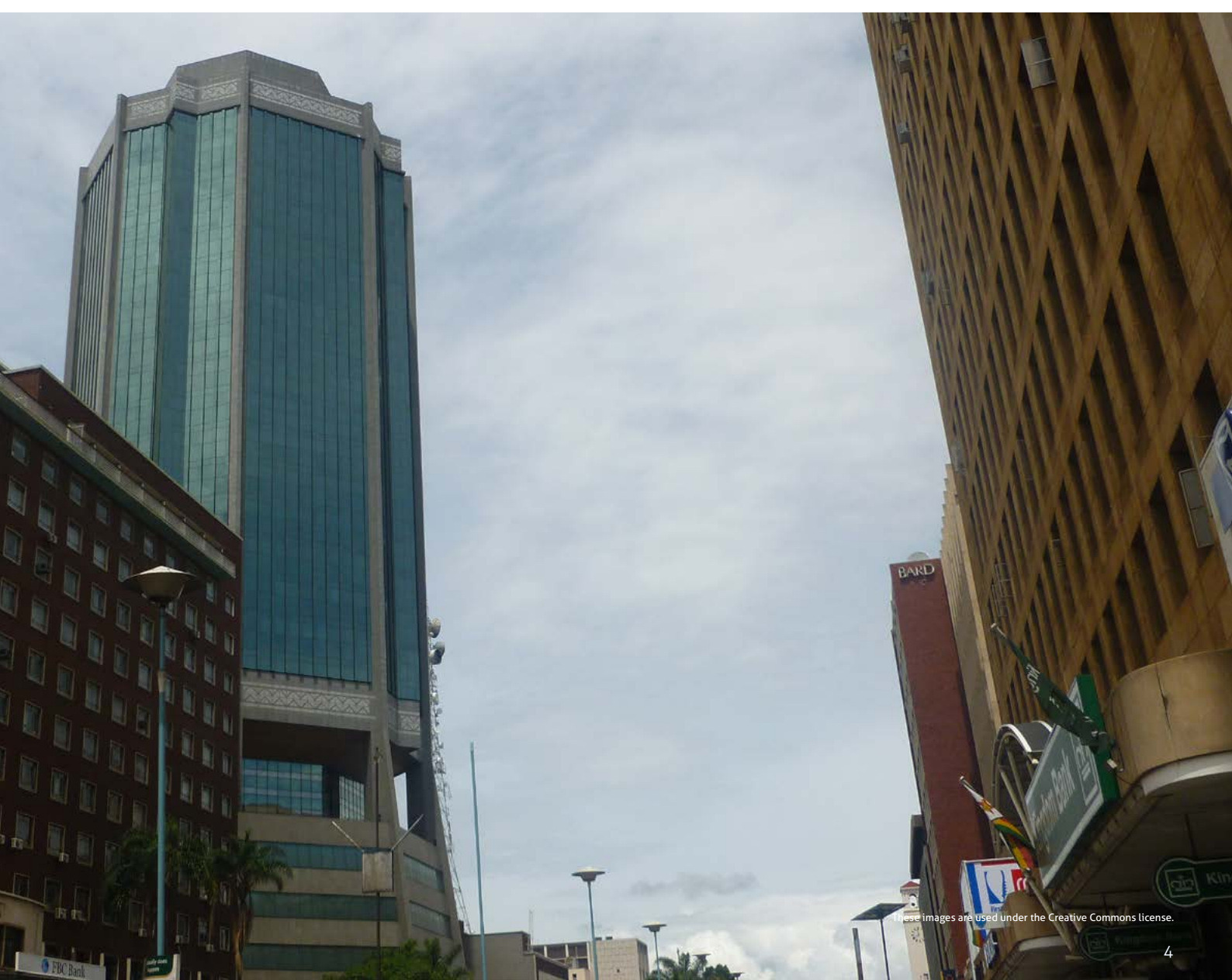


ARIPO: IMPLEMENTING REGULATIONS REVISED

ARIPO recently revised the Implementing Regulations concerning trademarks, patents, and industrial designs, with the amendments entering into force on January 1, 2016.

The definition of a trademark was broadened to include non-conventional trademarks. However, many issues relating to the examination and enforceability of non-conventional marks remain unclear. E-filing of trademark applications is expected to be implemented in the future, with paper filing remaining an option. Another important development is the introduction of a time limit for responding to office actions. The new time limit is set for two months allowing for the standardization of the registration process.

As for patents, applicants will be able to file divisional applications relating to any pending ARIPO patent application, as per the amended Implementing Regulations. An extension of time may be requested, provided that the request complies with the Regulations.



KUWAIT: COMMITMENT TO IP PROTECTION

Maps of the Middle East illustrate Kuwait as a small country in the region. But what the country lacks in geographic size, it makes up in economic impact. Kuwait is a high income economy backed by the world's sixth largest oil reserves and the Kuwaiti dinar is the highest valued currency in the world. Local industries include the production of petroleum, petrochemicals, cement, shipbuilding and repair, water desalination, food processing, and construction materials. Imports to the country include food, construction materials, vehicles and parts, and clothing.

The following features the important intellectual property developments and news that unfolded over the past year in Kuwait, which coincided with plans to diversify the Kuwaiti economy away from oil, attract more investment, and boost private sector participation in the economy.

One of the most important steps which was taken last year bringing Kuwait more and more in line with the international standards was the country's accession to the Paris Convention. This move is an indication of Kuwait's desire to further align itself with the international IP community standards in general, beyond its WTO membership and accompanying TRIPS agreement. Priority claim requests in Kuwait became officially admissible in the beginning of 2015. Also, with the Paris Convention membership, Kuwait is now expected to respect Article 6*bis*. Needless to say, there are no clear regulations or case laws so far that comment specifically on the prerequisites for claiming protection under Article 6*bis*.

Another important development on the trademark front was the significant increase in official fees across the board that was implemented in the country on January 4, 2016. This is expected to couple with major changes in the way trademark applications are going to be handled and processed. For example, a line item was introduced in the new official fee schedule allowing for special requests that can be admitted at the TMO to expedite the examination of a trademark application which was certainly not the case in the past. This will probably allow for further standardization of the registration procedure by controlling the backlog of work to the extent possible.

On the patent front, the Kuwaiti Patent Office decided early 2015 to begin performing substantive examination of patent applications filed in 2008 and later - another sign of the authority's commitment to improve the IP framework of the country. Although the applications will be examined in-house, the Patent Office has still not issued any new regulations relating to fees or procedures, beyond that upon receipt of an examination report, there will be a six months period to submit a response. To this date, patent applications are only allotted a filing number and filing date as long as the formal requirements are met. We expect more to unfold in the few months to come.



MENA: OPPOSITION PROCEEDINGS IN THE REGION

The opposition system in the MENA region runs smoothly as it comes in line with the underlying provisions of the trademark laws that are in place, as well as numerous treaty obligations including the Paris convention filings and protection of unregistered well-known trademarks. There is no pan-Arab opposition system in view of the fact that a unified filing system similar to the European Union Trademark still does not exist.

Elements and Grounds of an Opposition

Pre-registration opposition proceedings are available in all countries except for a few namely Lebanon and Algeria. Legal cancellation proceedings are the only available course of action in order to contest the registrability of a mark in these two countries.

Opposition proceedings are administrative in all counties (filed before the TMO) except for KSA. Administrative proceedings are, in principle, less expensive than Court proceedings, and are based on written record with jurisdiction mostly limited to the issue of registrability. Being first-to-file countries, the applicant or the authority administering the opposition cannot require the opponent to provide proof of use of the earlier registered mark that is the basis of the opposition. In order to contest use, the applicant must initiate separate non-use cancellation proceedings. The opposition proceedings will not be interrupted pending the issuance of a decision in the cancellation action and vice versa.

Even if prior rights are not established locally, an opposition can still be filed based on fame. The extent to which a trademark is considered famous is usually determined according to the international standards for the protection of well-known trademarks (Article 6bis of the Paris Convention) as well as the local standards for well-known trademark protection. Any probative evidence will be accepted, and a determination will be based on the totality of the evidence, including such factors as (i) the duration and geographic extent of sales; (ii) sales figures; (iii) advertising figures and samples of advertising; (iv) awards, reviews and press reports; (v) the reputation of the mark within the relevant trade and consumer groups in the country; and (vi) expert testimony and surveys designed to assess the recognition of brand names.

Other admissible grounds for opposition include: absolute grounds; bad faith issues; rights under Article 6septies of the Paris Convention (registration in the name of the agent or other representative of the proprietor of the mark); rights under Article 8 of the Paris Convention (trade names); rights under Article 6ter of the Paris Convention (Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations); offenses against public policy or principles of morality. This list should certainly not be considered exhaustive and conclusive.

Time for Filing Opposition and Extension Requests

Requests for extending an opposition are only possible in Jordan but approval is not granted automatically. Reasons for the request must be fully explained and considered acceptable. Extension is allowed only if the power of attorney, which is necessary at the time of filing the opposition, is not available. Anyone may oppose within the original 3-month opposition period, but only those who obtain extensions of time to oppose may file during an extended opposition period.

The opposition period ranges between 60 to 90 days from publication date in almost all MENA countries. As an exception, Iran has a 30-day opposition period, while Sudan's opposition period lasts up to 8 months from publication date.

Procedure and Withdrawal

The work-flow platform in all countries does not eliminate the need for paper. There are still no electronic means for filing oppositions and for issuance of decisions. Generally speaking, as the party bringing the case, the opponent is responsible for submitting a brief on the case. The applicant is then expected to file a counter-statement, and the opponent will have the option to reply. In few countries, such as Syria, there are time frames and page limits associated with the filing of the briefs, while in Jordan, for example, the number of pages for submission is open with a regulatory requirement to submit the evidence in the form of an affidavit along with exhibits substantiating the claims.

Hearings are conducted as oral arguments in support of the opposition proceedings only in few countries including Jordan, Kuwait and Oman. Limited evidence and testimony may also be presented in hearings to supplement the legal arguments. On the other hand, in countries such as Morocco and Egypt, proceedings are only a written record with an oral hearing held only if requested by one of the parties. No new evidence can be introduced if an oral hearing is appointed. Oftentimes, the examining authority takes this time to ask questions about facts and arguments that were not clear in the parties' briefs.

Usually, either party can withdraw from proceedings at any time, but the opposition proceedings will remain active until an official notification is issued by the TMO attesting the withdrawal.

COUNTRY	Opposition
Algeria	Trademark applications are published in the Official Gazette after registration, and there is no provision for filing an opposition to the registration of a mark.
Bahrain	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 60 days from publication date.
Egypt	Trademark applications accepted by the Registrar are published in the Trademark Gazette. Oppositions may be filed within 60 days from publication date.
Gaza	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 3 months from publication date.
Iran	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 30 days from publication date.
Iraq	Trademark applications accepted by the Registrar are published in the Trademarks Bulletin. Oppositions may be filed within 90 days from publication date.
Jordan	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 3 months from publication date.
Kuwait	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 60 days from publication date.
Lebanon	Registered trademarks are published in the Official Gazette. Oppositions to any registered trademark may be filed before the court.

COUNTRY	Opposition
Libya	Trademark applications accepted by the Registrar are published in the Official Gazette before registration. Oppositions may be filed within 3 months from publication date.
Morocco	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within two months from publication date.
Oman	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 90 days from publication date.
Qatar	Trademark applications accepted by the Registrar are published in the Gazette of Trademarks. Oppositions may be filed within 4 months from publication date.
Saudi Arabia	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed before the Board of Grievances (First Instance Court) within 90 days from publication date.
Sudan	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 8 months from publication date.
Syria	Trademark applications accepted by the Registrar are published in the Trademarks Journal. Oppositions may be filed within 90 days from publication date.
Tunisia	Trademark applications accepted by the Registrar are published in the Industrial Property Bulletin. Oppositions may be filed within 60 days from publication date.
UAE	Trademark applications accepted by the Registrar are published in the Trademark Bulletin and two local newspapers. Oppositions may be filed within 30 days from last publication date.
West Bank	Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 3 months from publication date.
Yemen	Trademark applications accepted by the Registrar are published in the Trademark Magazine. Oppositions may be filed within 90 days from publication date.

Should you have any questions, or require any additional information, please contact us at news@sabaip.com

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