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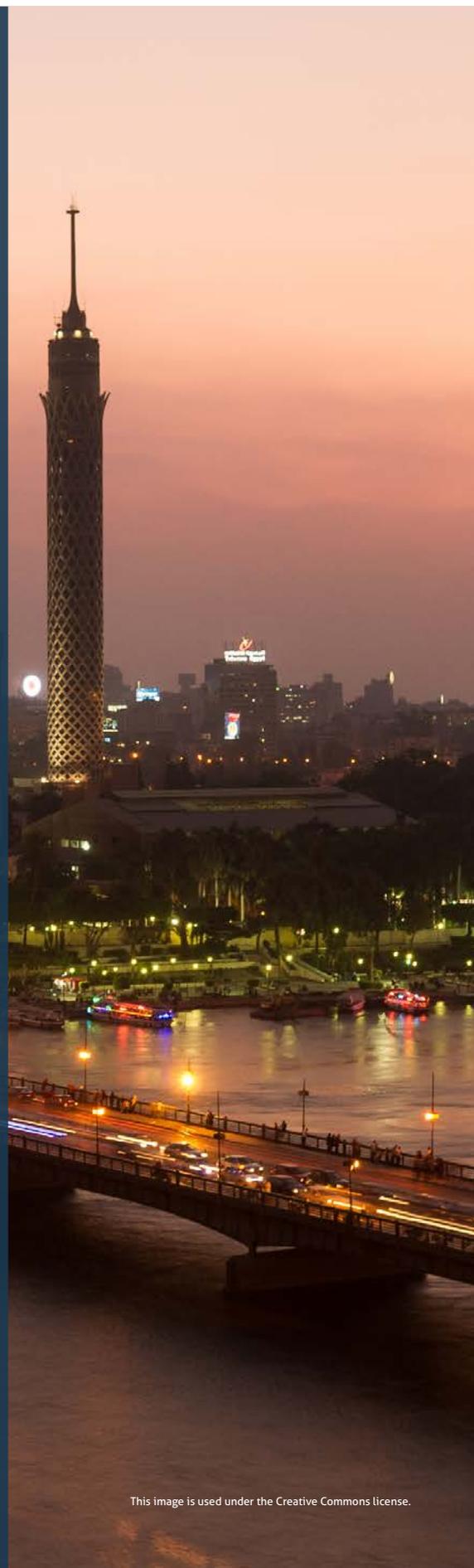
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EGYPT: TAKING THE FAST LANE ON THE PATENT PROSECUTION HIGHWAY PILOT PROGRAM WITH JAPAN

The Egyptian Patent Office (EGYPO) and the Japanese Patent Office (JPO) began a two-year Patent Prosecution Highway (PPH) program on June 1, 2015. The PPH allows an application that has been determined to be patentable in the JPO to undergo an accelerated examination in the EGYPO with a simple procedure upon the applicant's request.

The PPH program utilizes the PCT international work products (PCT-PPH) on the pilot basis. Through the PPH, an accelerated examination may be requested through a written opinion established by the International Searching Authorities, a written opinion established by the International Preliminary Examining Authorities or an international preliminary examination report established by the International Preliminary Examining Authorities.

PPH requirements and procedures according to the JPO are:

REQUIRED DOCUMENTS EXCEPT A PPH REQUEST FORM	FUNDAMENTAL REQUIREMENTS
Claims correspondence table	The Office of Second Filing (OSF) application is in particular relationship with the Office of First Filing (OFF) application* (e.g. The OSF application is an application which validly claims priority under Paris Convention to the OFF application)
A copy of all claims and its translations	OFF application has at least one claim that was determined by the OFF to be allowable
A copy of the Office of First Filing office actions and its translation	All the claims in OSF application sufficiently correspond to the allowable/ patentable claims in OFF applications
Copies of all cited documents	The examination has not begun in the OSF (This requirement doesn't exist in some offices.)
What you need to know:	
Documents 2-4 may be omitted in some cases	*If the PPH adopts the PPH MOTTAINAI ¹ , PPH request is eligible, whether or not the office which provides the examination results is the OFF

¹Mottainai (もったいない) is a Japanese term conveying a sense of regret concerning waste. It reflects a cultural practice that is still present in Japanese culture, which has been adopted internationally.

JORDAN: ELECTRONIC TRANSACTIONS NOW POSSIBLE

The Electronic Transactions Law No. 15 of 2015 entered into force in Jordan on May 15, 2015. Article 4 of the law stipulates that ministries and other governmental institutions may allow electronic transactions, including inquiries, filing and other relevant transactions, provided that the authorities concerned have the appropriate system and regulations setup in accordance with the law and its implementing regulations.

This update is expected to pave the way for the electronic filing of applications at the Directorate of Industrial Property. Discussions are currently underway to devise the best mechanism for implementing e-filing and e-payments for industrial property applications in Jordan.

ALGERIA: E-FILING OF INTERNATIONAL APPLICATIONS

The Algerian Patent Office began receiving and processing international applications in electronic form on July 1, 2015.

GAZA: TMO CLOSED ON TUESDAYS

The Trademark Office in Gaza announced that it will close every Tuesday, as of Tuesday, June 30, 2015.

All deadlines falling during this period will be pushed back to Monday.

KURDISH REGION OF IRAQ: Validations Cut Off

It is no longer possible for owners to validate registered trademarks at the Trademark Office in Baghdad up to the TMO in Erbil. Owners can now only file a separate application in the Kurdish region for additional local protection.

By way of background, there are two TMOs operating in Iraq: one in Baghdad and another in Erbil. In principle, the scope of the registration at the TMO in Baghdad still covers the whole country, including the Kurdish region. However, trademark owners may seek additional protection by filing applications at the TMO in Erbil. Protection in the Kurdish region is advisable in certain situations especially in an infringement claim. Trademark owners should of course seek sound advice before they decide on the best route to pursue.

SABA INTELLECTUAL PROPERTY: FEATURED ROUNDTABLE IN MANAGING IP

Hisham Zahr, Director of Operations at Head Office, and Hady Khawand, Country Manager at UAE office, responded to questions on trademark protection in the Middle East, the use of Arabic, and the need for transliteration.

TO WHAT EXTENT ARE TRADEMARK LAWS/REGULATIONS HARMONISED IN THE MIDDLE EAST COUNTRIES?

There is some element of harmonisation with common standards available across the different Arab countries, though each country has the primary responsibility for the regulation of the trademark matters within its jurisdiction and consequently each has its own trademark laws with slight differences in the procedural aspects.

The standard definition of a trademark is common and the absolute grounds of registration are relatively the same with some minor differences. In Saudi Arabia, for example, the trademark law of 2002 is to be used in conjunction with the *Shari'a* law (the body of Islamic religious law). Unsurprisingly, the country demonstrates greater sensitivity to religious tradition. In accordance with *Shari'a* law, trademarks covering alcoholic goods and related retail or wholesale services are prohibited within the kingdom. Presumably, trademarks associated with other prohibited products and practices, including references to such products and practices, would not be registrable as well including gambling devices and pork products.

With the exception of Morocco and Lebanon, ex-officio examination on relative grounds is performed in all countries. Also, nearly all countries except Lebanon provide opposition proceedings prior to registration. Apart from Tunisia, decisions of TMOs in opposition proceedings are binding. The length of protection of a trademark and the method of renewing a trademark is almost the same - 10 years in nearly all countries (with the exception of Lebanon, West Bank, Gaza and Saudi Arabia).

Arab countries are in general first-to-file countries. Therefore, trademark owners with plans to eventually extend into the Middle East should consider filing the trademark applications before someone rips-off the brand equity that was established in the home country and file for the same trademark abroad.



Hisham Zahr



Hady Khawand

When it comes to the treatment of trademarks in a multi-lingual context, trademark laws of Arab countries are traditionally designed to avoid conflicts between marks across different languages, and to provide specifically for the protection of the transliteration of marks. Accordingly, the registration of a trademark in its Latin (original) script in any Arab country should, in general, provide protection against the registration of another confusingly similar transliteration liable to create public confusion. Furthermore, most Arab countries are member states of at least one of the following international agreements that address the protection of trademarks, such as the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement), the Trademark Law Treaty, and the Madrid Agreement Concerning the International Registration of Marks and related Protocol. These systems provide for the protection of rights across different languages and different character scripts as part of the protection against unfair competition.

However, while the transliteration of the mark is protected, likelihood of confusion is easier to prove when comparing marks in the same language. Having said that, registering trademarks in transliterated Arabic script, in addition to their original format, is advisable considering that most Arab countries are in principal governed by civil law – that is, the concept of first to file carries considerable weight. While some countries may offer a limited number of common law rights, registration is highly recommended and can be used as a basis on which to sue an infringer. Needless to say, the risks of a non-use cancellation action must be factored into any filing strategy. However, it is important to note that in most Arab countries non-use cancellation actions must be brought before the local courts, which can greatly increase the time, costs and even predictability of such proceedings.



WHAT ARE THE ADVANTAGES/DISADVANTAGES FOR INTERNATIONAL BRAND OWNERS OF CHOOSING AN ARABIC TRADEMARK?

Over the past years, Arab economies have opened up and more and more brand owners are looking into the Middle East to market their products. Therefore, it is now increasingly important for owners to take into account considerations of language and culture. The process of transliteration of a trademark into its local character or language is important for trademark owners seeking to promote or sell their products in that market because many consumers will identify goods by their local-character trademark.

Also, in many countries, use of a mark in Arabic may not be a matter of choice but is a statutory requirement governed by local regulations. These include resolutions and directives by the national FDAs, Ministries of Health or Trade, Consumer Protection laws as well as municipal or civic guidelines regulating the use of trademarks in advertising, print on packaging, publications, signboards, etc. To elaborate, many Arab countries call for the compulsory use of the Arabic script of a mark on certain products and in certain industries. For example, marks on signboards in Kuwait, Qatar, Saudi Arabia, and the UAE must appear in Arabic in compliance with the local regulations. Therefore, it becomes advisable to register the transliteration in the local script. On a side note, the Gulf – with UAE on the lead – has major retail space under development more than anywhere else in the world. This will ultimately lead to a higher demand for signboard permits with a display of marks in Arabic.

There is also similar regulatory language requirement for pharmaceutical packaging in almost all Arab countries by virtue of which trademarks used on pharmaceutical products should be bilingual with Arabic always being one of the languages used. This is specifically the case in Algeria, Egypt, Morocco, Qatar, Saudi Arabia, Tunisia, and the UAE.

COUNTRY	USE OF ARABIC COMPULSORY	LOCAL AUTHORITY	LAW / REGULATION
Algeria	Yes	Ministry of Health	Decree of 14 Dec 2008
Bahrain	No		
Egypt	Yes	Ministries/Municipalities	Commercial laws and Municipal regulations on signboards
Gaza & West Bank	No		
Jordan	No		
Kuwait	Yes	Kuwait City Municipal Council	Law 172/2006 and Decree 463/21/2005 on signage
Lebanon	No		
Morocco	Yes	Ministry of Health and Ministry of Trade	Resolution 17-04 of 22 Nov 2006 and Decree 2-01-1016 on foodstuffs
Oman	No		
Qatar	Yes	Ministry of Health Doha Municipality	Resolution no. 3 of 1938 and Regulations on signage
Saudi Arabia	Yes	Riyadh Municipality	Regulations on signage
Syria	No		
Sudan	No		
Tunisia	Yes	Tunis Municipality	Decree of 6 Aug 1957
UAE	Yes	Dubai Department of Economic Development	Consumer Protection Law 24 of 2006 and Federal Law no 4 of 1979
Yemen	No		

In countries where use in Arabic is not a requirement, there are a number of variables brand owners need to factor-in to ultimately decide on whether or not to use and register in Arabic including:

- *Nature of mark:* Trademark practitioners should work together with the business to establish a clear and consistent process in order to decide which of their marks need to be in Arabic script. House marks and trademarks of key products should be the first set of marks to file for in Arabic.
- *Duration:* Marks used in the long run should definitely be prioritized over marks with a short-term initiative.
- *Importance of market and cost considerations:* It is important to select countries in a way that would enable trademark owners to eventually establish a solid portfolio in order to enforce their rights.
- *Extent of dilution:* Unlike the United States, Arab countries have no express anti-dilution provisions in their trademark laws or elsewhere. Nevertheless, many countries have introduced provisions into their laws on the "likelihood of confusion" between conflicting marks as part of their implementation of the TRIPS Agreement. In principle, the reference to certain provisions of the laws on the "likelihood of confusion" should provide a basis for actions in cases of dilution. With this in mind, trademark owners may choose to register in Arabic as a part of an overall offensive strategy against the threats of dilution.

Clearly, a key disadvantage of choosing an Arabic trademark is the additional costs of clearance and registration. However, in our opinion, the benefits of using and protecting a mark in Arabic outweigh the associated costs.

WHAT FACTORS SHOULD BRAND OWNERS CONSIDER WHEN CHOOSING AN ARABIC TRADEMARK? IS IT SUFFICIENT TO TRANSLITERATE THEIR WESTERN MARK OR SHOULD THEY BE MORE CREATIVE?

Transliteration into the Arabic script is not without challenges, as certain consonants and vowels have no equivalent in the Arabic language such as the letter V and the letter P. Common practice is either to substitute, for instance, the letter with the next best option (the Arabic letter pronounced B is used to transliterate PEPSI which would be so as to read BEBSI, and the Arabic letter F is used to transliterate OLD NAVY as to read OLD NAFY) or to borrow letters from the Persian alphabet, closest to Arabic, and which would be widely understood by the public (this practice is used to owners of trademark VIRGIN).

When the trademark in question can be transliterated in different phonetic renditions, a vast scope of inconsistencies may come as a result of this. Careful thought and consideration must therefore be taken from the outset to select the most accurate and appropriate transliteration and to ensure that this version is consistently used. For example, if a brand owner registers one version of an Arabic transliteration but ends up using another in the market place, the trademark registration may become vulnerable to a non-use cancellation action. Furthermore, the use of more than one transliteration could create uncertainty in the minds of consumers.



Another factor to account for is the coinage of marks such as NIKE, KODAK or LEXUS which crucially differ from generic or descriptive marks in that they require a high degree of advertising, promotion and quality control for the consumer to relate the goods or services to the marks, and create the required association. There is a risk that by not protecting the Arabic rendition of a mark, consumers will not be able to develop recognition of the brand or may even develop their own inaccurate Arabic names when referring to the mark resulting in a weak brand identity. Therefore, by registering the correct Arabic version of a mark, a brand owner can ensure that consumers have clear visibility as to the origin of the goods or services and eventually be able to build up brand equity.

An additional challenge would arise when marks would have a negative connotation when transliterated into Arabic, which would justifiably cause outrage or would be subject to censure as being significantly to undermine current religious, family or social values. Generally speaking, a trademark shall not be registered if it is contrary to public policy or to accepted principles of morality. Needless to say, the two exceptions would relate to the intrinsic qualities of the sign, rather than the manner in which it is used. Trademark owners dealing with this obstacle would eventually choose not to transliterate. Also, performing a connotation analysis should always be a preliminary step before any name is selected.

ARE TRADEMARKS IN ARABIC SCRIPT EXAMINED IN THE SAME WAY AS THOSE IN EUROPEAN LANGUAGES (EG REGARDING DISTINCTIVENESS)?

Examination is the same – that is, the standard distinctiveness terms apply for Arabic marks as well. Generally speaking, the trademark is usually examined as a whole and certain elements of the mark may be disclaimed (where allowed), but it is the overall level of distinctiveness, which must determine whether the mark is registerable. Disclaimers may be given voluntarily by the applicant in its application to register the mark provided the mark as a whole is not disclaimed. Also, examiners in some countries such as Sudan may ask for the disclaimer of any component of a trademark which is not independently registerable.

ARE THERE ANY POINTS TRADEMARK OWNERS SHOULD BEAR IN MIND ABOUT USE OF TRADEMARKS IN ARABIC VS EUROPEAN LANGUAGES?

As we have already established, problems can arise when it comes to enforcing trademark rights against third parties using or attempting to register confusingly similar Arabic transliterations. It is always easier to enforce marks in the same language. We can even expect problems of a wider scale when trying to enforce against confusingly similar translations. The translation of a trademark into Arabic will certainly be visually and phonetically different from the original mark in English. In addition, there may be more than one possible translation into Arabic for any given word and relying solely on registration of a trademark in English to provide protection for its Arabic translations can be problematic. It is worth pointing out that some degree of protection is afforded to well-known trademarks under Article 6*bis* of the Paris Convention against translations liable to create public confusion. However, as its definition clearly implies, Article 6*bis* applies only to well-known trademarks and the extent to which a trademark is considered famous in Arab countries is usually determined according to the international standards for the protection of well-known trademarks as well as the local standards. Any probative evidence will be accepted, and a determination will be based on the totality of the evidence, including such factors as:

- The duration and geographic extent of sales
- Sales figures
- Advertising figures and samples of advertising
- Awards, reviews and press reports
- The reputation of the mark within the relevant trade and consumer groups in the country
- Expert testimony and surveys designed to assess the recognition of brand names

The bottom line is it can be difficult to rely solely on the provisions of Article 6*bis* leaving many marks exposed to infringement if the translation is not registered within the relevant country.

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 Zerkoutoui
Residence Zerkoutoui
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