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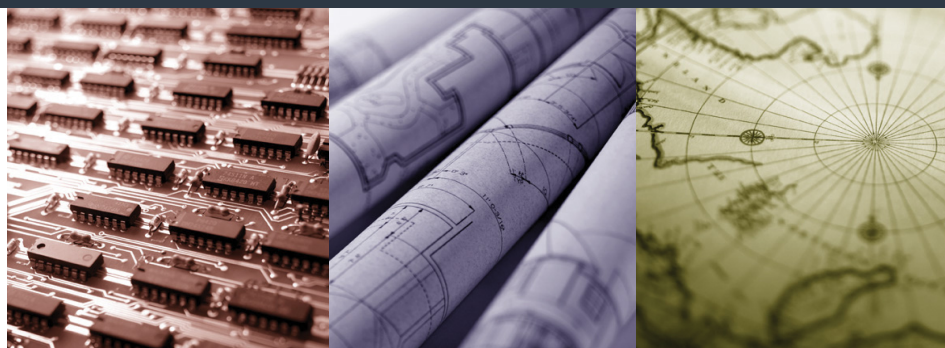


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**April 2015**

**Issue 4**

**A Review of Intellectual  
Property-Related News and  
Developments in the Middle  
East and North Africa**



## **UAE:** *Speeding Up the Opposition Process*



The United Arab Emirates began the implementation of a special project to clear the backlog of pending opposition cases.

Through this project, the trademark office will schedule hearings for all pending opposition cases and will issue decisions immediately

after holding the hearing sessions.

We are currently reviewing all case files we are handling and will update

you of hearing dates and submission requirements.

## **Qatar:** *Patent Official Fees Due*

The Intellectual Property Office in Qatar announced that filing fees, substantive examination fees, and accumulated annuities related to patent applications filed before January 12, 2015, must be paid by July 31, 2015, as reported in the March issue of the *Saba IP Bulletin*.

As for new patent applications, in addition to the filing fees, the IPO will collect the second annuity fees and, if due, the third annuity fees. The substantive examination fees must be settled within six months

from the date of filing in Qatar.

Annuity fees for applications are payable for each one year period between the second and twentieth anniversaries of the date of filing of PCT applications. As for non-PCT applications, the annuity fees are due before the first day of each of the one-year periods they cover. A surcharge will be levied for late payment of annuity fees per year, provided that the payment is made within a grace period of six months.

## **Lebanon:** *Updated POA Requirements*

Lebanon declared a revision of the power of attorney authentication requirement on March 21, 2015. The memo, issued by the Ministry of Economy and Trade, stated that all POAs after April 10, 2015 must be legalized by the Lebanese consulate.

This update will not affect applications filed prior to the aforementioned date.



## India: *Trademark Insights*



India is the seventh-largest country by area and the second-most populous country with over 1.2 billion people in the world. The country shares borders with Pakistan, China, Nepal, Bhutan, Burma, and Bangladesh.

India's GDP, the fourth in the world, is estimated to be \$4.99 trillion, whereas GDP per capita is \$4,000. Services account for 56.9 percent of the GDP composition, followed by 25.8 percent for industry, and 17.4 percent for agriculture. Industries in India include the production of textiles, pharmaceuticals, and software. India mainly exports petroleum products, precious stones, metals, machinery, chemicals, vehicles, and most notably apparel. Imports to India include crude oil, minerals,

precious stones, machinery, fertilizer, and chemicals.

India joined WIPO in 1975 and has acceded to several treaties and conventions. The Indian trademark law protects trademarks as per the Trademark Act, 1999, amended in 2010. India follows the 8th edition of the Nice classification and a single application may include several classes.

The main features of trademark registration are as follows:

### FILING REQUIREMENTS

1. Power of attorney, simply signed. A general power may be used for subsequent filings.
2. Copy of priority document, if priority is claimed, certified.
3. Proof of first use of the

mark in India (or a declaration showing the intention of use).

4. 15 prints of the mark for each application.

Items 1 and 3 must be submitted at the time of filing. Document 2 may be submitted within 6 months from filing date.

### OPPOSITION

Trademark applications accepted by the Registrar are published in the Trademarks Journal. Oppositions may be filed within 3 months from publication date.

### EXTENSION OF TIME

Extension of time for oppositions/counter-oppositions or for responding to office actions is possible.

### PROTECTION TERM

Trademark registrations are

valid for 10 years from filing date and are renewable for like periods. There is a grace period of 6 months for late renewals with payment of a surcharge.

Documents required for renewal: Power of attorney, simply signed; and copy of the certificate of registration of the mark.

### USE REQUIREMENTS

Use of a trademark is not required for registration or renewal of a mark. However, 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.

### SEARCH

An official search may be

*Continued on page 4*

## India: Trademark Insights

*Continued from page 3*



conducted for word marks and devices. It takes approximately 2 to 3 working days for the results to be available. A single application may include several classes. The search report discloses similar and identical trademarks.

### ASSIGNMENT

Registered trademarks may be assigned with or without the goodwill of the business concerned.

Documents required:  
Power of attorney from the assignee, simply signed; and deed of assignment, notarized.

### CHANGE OF NAME/ADDRESS

Documents required:  
Power of attorney, simply signed; and certificate of change of name/address of the applicant, notarized. For a change of address, only a simply signed power of attorney showing the new address is required.

### LICENSING

License recordal is compulsory but advisable in order to be effective against third parties.

Documents required:  
Power of attorney from licensor, simply signed; and license agreement, notarized.

### MARKING

Marking is not compulsory.

### CANCELLATION

A trademark is subject to cancellation before the Court by any interested party within 5 years from registration date.

### REGISTRATION TIME FRAME

The time frame for completing the registration process is 3 to 4 years.

### THREE DIMENSIONAL TRADEMARK APPLICATIONS

Admissible.

## *E-Filing Now Possible*

The Indian Patent and Trademark Office declared that the e-filing of design applications and applications for the registration of geographical indications is now possible.

This announcement follows India's recent move to go paperless and provide ubiquitous electronic access to pending trademark and patent applications.

## *Announcing INPASS*

India announced the development of the Indian Patent Advanced Search System. The new search tool allows a full-text search to be conducted for Indian patents and patent applications.

According to a statement by the PTO, INPASS supports wild-cards, truncation, and Boolean operators in all the fields of the ST.36 compliant data available with the patent office. This ensures the possibility of advanced searches in the Indian Patent Database.

## **MENA:** *Overview of Trademark Developments in the Region*

### **PARIS CONVENTION: CLAIMING PRIORITY AND PROTECTING FAMOUS MARKS**

All Arab countries are now members of the Paris Convention, with Kuwait being the latest addition. Priority claim requests in Kuwait will become admissible starting 2015. Also, with the Paris Convention membership, all Arab countries are expected to respect Article 6*bis* which applies to non-similar goods or services, provided that use of the later mark indicates a connection to the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged. However, there are no clear regulations or case laws so far that comment specifically on the prerequisites for claiming protection under Article 6*bis*.

One important aspect that should be taken into consideration when addressing the concept of famous marks in Arab countries is the principle of “first-to-file” versus “first-to-use.” Seeing that almost all countries are in principle civil law countries with the code typically

exhaustively covering the complete system of the law, first-to-file is given considerable weight. Needless to say, countries of our region may offer a limited amount of common law rights but this is a matter solely determined by the practitioner handling the case. Therefore, as things stand, registration of marks, even for famous marks, is highly recommended. Mere registration can be a basis to sue an infringer, although the risks of a non-use cancellation action must be factored-in in any filing strategy. However, unlike the United States and most European countries where a non-use cancellation action is similar to an opposition action in applicable law, the situation is not the same in the Arab world. In most 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.

### **SPECIFICATION OF GOODS/SERVICES IN AN APPLICATION**

There are specific considerations applicants should account for when working on the specification of goods/services for trademark applications filed in KSA, UAE, Jordan, Oman and Sudan. Starting with Jordan, Oman and Sudan, claiming class headings is not acceptable at all, and the actual language of the goods or services specified in the registration will define the parameters of the scope of protection of a registration.

On the other hand, pursuant to the introduction of the e-filing system, class headings are acceptable by the TMO of KSA. Even more, the TMO will no longer accept specifications for goods and services that do not exactly match with the Nice specification. Applications with an item that is not explicitly on that list will not be properly docketed into the system, which would basically result in considerable delays.

As far as UAE is concerned, the TMO will no longer issue pre-examination decisions, which can mean that if an examiner is not satisfied with a certain specification of goods, the application will be automatically rejected. This was not the case in the past. The TMO was more flexible in the sense that if anything is seen not to be clear with the specification, the applicant is notified and then given a period of time to make the necessary correction. This being said, applicants should be very careful when specifying the goods/services in a trademark application in UAE, and it goes without saying that claiming class headings would be the safest approach. There is no need to worry about the fact that the exposure risk would be increasing with this wide-ranging claim because the general practice of examiners at the TMO is to look at class-headings as a whole at the time of examination on relative grounds regardless of whether or not there are different trade channels involved.

To wrap up, the process at the UAE TMO is not identical to the one in the KSA. While at the KSA TMO applicants are required to claim class headings and/or use the exact language of the Nice classification, this practice is only a recommendation at the UAE TMO. Applicants may choose their own language in the specification but they may then be more vulnerable to a rejection decision. If for some reason the examiner is not satisfied with the language of the specification, he/she will immediately issue a rejection decision.



## INTA 2015: *Announcement from Saba & Co. IP*

Saba & Co. IP will be attending the 137th INTA Annual Meeting in San Diego, CA from May 4, 2015 to May 6, 2015.

We look forward to seeing you at the conference this year. Kindly email us at [inta@sabaip.com](mailto:inta@sabaip.com) to arrange for a suitable time to meet.

Sincerely,

**INTA TEAM — SABA & Co. IP**



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RAMZI TARAZI



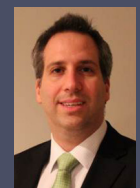
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