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SAUDI ARABIA: FINAL STEP TOWARDS REGIONAL TRADE-MARK LAW



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The new GCC Trademark Law and Implementing Regulations were published in the Saudi Official Gazette on July 1, 2016. The Law is expected to enter into force after 90 days from the publication date.

The GCC Trademark Law, unlike the GCC Patent Law, is a unifying, not a unitary law. The Law was issued in 2006 and revised in 2014. It stipulates a set of provisions that will be applied uniformly across all the GCC countries, in regards to the prosecution and enforcement of trademark rights. It does not offer a unitary registration system, however. The Trademark Offices of each GCC country will remain as the receiving office, and registering a trademark across the six GCC countries will still require filing six separate national trademark applications. Furthermore, the official fees are not expected to be unified and will vary depending on the individual overhead costs of the different TMOs involved.

The definition of a trademark has significantly expanded. Article 2 of the Law includes color marks, sound marks, and smell marks as trademarks, suggesting that it will be possible to secure registrations of unconventional trademarks across the GCC.

Furthermore, multiclass applications are allowed under the GCC Trademark Law, which constitutes a major shift in trademark practices in the once single class application countries in the GCC. The registration requirements have also been updated and now include a provision for foreign words, which entails providing certified translations of the word or phrase and an indication on how to pronounce it in Arabic, as per Article 4 of the Implementing Regulations.

The examination process is harmonized now, with applications being examined within 90 days from the date of submission. The TMO will then notify the applicant of the decision. There is a 90 day period to respond to office actions from the date of notification before the application is considered abandoned. The new Law also talks about the establishment of a Grievances Committee. Examination decisions can be appealed before this Committee before taking the case up to the Court.



The Law introduces new border measures authorizing Customs officials to seize suspected products either on an *ex-officio* basis or following a complaint. The Law also clearly states that the Courts shall order the destruction of products if proven to be counterfeits, and if destruction is not possible, the Courts shall not return the products back to the channels of trade or order re-exportation. There are however a number of issues that remain unclear at this stage when it comes to implementation.

Other features of the new GCC Trademark Law include:

1. Claim of priority, based on an earlier-filed foreign application, is possible
2. Trademark applications accepted by the Registrar will be published for opposition purposes. Oppositions must be filed within 60 days from publication date
3. Trademark registrations are valid for 10 years from filing date and are renewable for like periods. There is a grace period of six months for late renewals
4. A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of five consecutive years after registration
5. The Law recognizes famous trademarks that are well-known in the GCC member states and shall ensure protection thereof even if the marks are not registered
6. The Law gives the right to trademark owners to initiate civil and criminal actions against any infringing party. Penalties include a maximum of five year imprisonment and payment of fines of up to US \$270,000



SYRIA: INCREASE IN PATENT OFFICIAL FEES

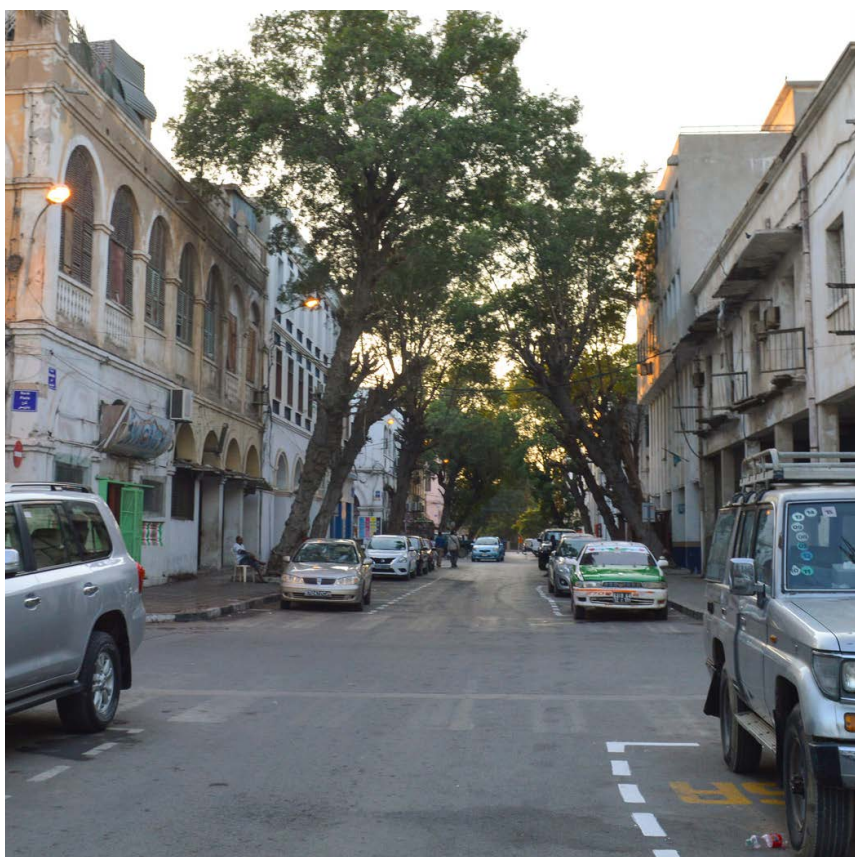
Pursuant to Ministerial Decision no. 1540 of 2016, the official examination fees for patent applications have increased in the country, effective as of July 1, 2016. An increment was also imposed on trademark publication fees back in May of the same year. We have absorbed our costs in both instances, in spite of the increase in fees, and our schedule of charges will remain the same.

DJIBOUTI: ONBOARD THE PCT TRAIN

Djibouti became the 150th member of the Patent Cooperation Treaty (PCT) on June 23, 2016. The Treaty is expected to enter into force on September 23, 2016. This development is indicative of the country's drive and motivation to develop its patent filing system.

The table below lists the jurisdictions in the Middle East and North Africa region that are members of the PCT.

Jurisdiction	Entry into force
Algeria	March 08, 2000
Bahrain	March 18, 2007
Cyprus	April 01, 1998
Egypt	September 06, 2000
India	December 07, 1998
Iran	October 04, 2013
Libya	September 15, 2005
Morocco	October 08, 1999
Oman	October 26, 2001
Qatar	May 03, 2011
Saudi Arabia	August 03, 2013
Sudan	April 16, 1984
Syria	June 26, 2003
Tunisia	December 10, 2001
Turkey	January 01, 1996
United Arab Emirates	March 10, 1999



MENA: PATENTING IN AN INNOVATION HUB

Over the past several years, almost every country in the Middle East and North Africa (MENA) region has updated, revamped or introduced new patent laws in regards to pharmaceuticals; with many adopting internationally accepted practices. While in the past only pharmaceutical processes were patentable, it is now possible to patent pharmaceutical products or substances. In most cases, only new chemical entities are patentable, while in others, second medical use or Swiss-type claims are allowed. In some countries, patent term extension is possible if certain conditions are met. Morocco is an example where a supplementary protection certificate is issued for a period covering the number of days of delay in the event of unjustified delays by the authorities in awarding the authorization for marketing approval.

The number of MENA countries with PCT membership is increasing, alongside trade agreements between those countries and the US or Europe. These afford prospects for businesses looking to penetrate new markets with growth opportunities.

Procedures at different patent offices vary substantially. In many countries, substantive examination as to novelty, inventiveness, and applicability is performed locally. In some countries, the same is outsourced to foreign patent offices. What is allowed under each local patent law also varies. In Egypt, it is not allowed to claim method of treating or use of a product, be it to diagnose, treat, or prevent. The Egyptian Patent Office does not even allow Swiss-type claims. Such is not the case in Saudi Arabia where medical use and Swiss-type claims are allowed, while methods of treatment are not.

The overall trend in the legal environment in the MENA has been dealing with the ubiquitous problem of counterfeiting and imitators, such as generic brands. Porous borders, as well as inadequate border control, lead to substantial losses in sales and profits. Patent owners may be resistant to registering and penetrating a market where legal recourse against imitators is ineffective or unavailable. If we were to extrapolate on the evolution of the legal enforcement as it applies to trademarks, it is to be expected that the legal environment surrounding patents will follow suit in providing the adequate protection.



Customs in various MENA countries have become very active when it comes to trademarks. In Saudi Arabia, for example, it has become increasingly difficult for an infringer to import counterfeit goods. Customs check the Trademark Office records if they suspect counterfeit consignments. In 2012, concerted efforts and joint planning by the Commercial Anti-Fraud Department and the Customs Authorities led to a successful year in fighting piracy and suspending a considerable amount of counterfeit imported into the country, including pharmaceutical products.

Other countries have updated their laws to better protect the consumer as well as enable rights holders to take actionable measures. In Egypt, for instance, IP Law no. 82 for the year 2002 introduced new provisions on enforcement against counterfeiting. In these provisions the judges have the competence to issue provisional measures such as seizure of goods to determine infringement and preserve evidence. With regards to sanctions, this IP law increased the amount of fines and imposed new remedies. Some of these remedies include confiscation and destruction of infringing goods and the tools or equipment used in the infringement. Enforcement in Egypt was taken further by providing an IP unit in the police force, as well as teams of civil inspectors who are authorized to seize infringing goods from the market.

In short, protection of patents is a challenging and labor intensive process that requires special consideration and handling. Inventors and owners must be able and ready to adopt a model that incorporates both legal as well as regulatory approaches in order to arrive at well-established protection strategy.

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



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