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Oman has officially adopted the Gulf Cooperation Council Trademark Law as of Monday July 31, 2017. The decision, which was promulgated by Royal Decree no. 33 of 2017, was published in the Official Gazette on July 30, 2017. We now await issuance of the Implementing Regulations by the authorities concerned, which is expected to coincide with a significant increase in official fees. It is therefore advisable to attend right away to any renewal due over the next 12 months to benefit from the existing official fees. Immediate filing of new applications is also recommended seeing that the potential savings on official fees resulting from early filing could be fairly substantial and worth the effort.

The GCC states, namely, Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and the United Arab Emirates, have been involved in the coordination of intellectual property since the late '80s. The GCC Patent Regulations and the Statute of the GCC Patent Office were approved in 1992 and the GCC Patent Office commenced operations in 1998, and granted its first patent in 2002. The GCC Trademark Law - unlike the GCC Patent Law - is a unifying, but 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 states, 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 will register trademarks on a national basis. Registering a trademark across the six GCC countries will still require filing six separate national trademark applications.

The definition of a trademark has significantly expanded, given the adoption of the GCC Trademark Law by the member states. 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 such marks 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.

OMAN | GCC TRADEMARK LAW APPROVED

OMAN

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.

Other features of the GCC Trademark Law are:

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



JORDAN | E-FILING OF INTERNATIONAL PATENT APPLICATIONS



JORDAN

Given Jordan's unrelenting commitment to the protection of intellectual property, the Jordanian Patent Office announced that it will begin receiving and processing local and international applications in electronic form via ePCT filing in its capacity as the receiving office.

This news follows the recent amendment and publication of Patent Law no. 16 and Patent Law no. 17 in the Official Gazette on May 16, 2017 - both laws entered into force on June 16, 2017.

By way of background, the new regulations set forth in the aforementioned laws stipulate (1) the possibility of electronic filing of patent applications, which will be published after 18 months from the filing date or the priority date, (2) the possibility of withdrawing a patent application prior to its grant, and (3) prohibiting the importation of patented items by the patent licensee, if the license agreement restricts the import of said products into Jordan.

Jordan remains a country with high aspirations that welcomes foreign investments. A healthy balance between the latter and local development is bound to be beneficial for the country's own growth.

IRAQ | TRADEMARK OFFICE IN KURDISH REGION RESUMES OPERATIONS

After a brief disruption, the Trademark Office in the Kurdish region of Iraq has resumed operations and is currently accepting trademark applications. It is worth noting that there are two Trademark Offices in Iraq, the aforementioned office in Erbil and another in the capital, Baghdad.

In principle, the scope of the registration at the Baghdad TMO covers the whole country, including the Kurdish region. Nevertheless, with the reopened TMO in Erbil, trademark owners now have the option of seeking additional protection in the Kurdish region.

The TMO in Erbil follows the 7th edition of the Nice classification. Trademark examination is performed on formal, absolute, and relative grounds and oppositions may be filed within 90 days from publication date. The protection term for a registered trademark is 10 years from filing date and is renewable for like periods.

Protection in the Kurdish region may be advisable in certain situations, especially in an infringement claim - the more solid the portfolio is, the better the trademark owner's position will be in bringing an infringement claim in the future. However, trademark owners should of course seek sound advice before they decide on the best route to pursue.

IRAQ



SAUDI ARABIA | REMEMBER TO RECORD YOUR LICENSE



Article 31 of the Gulf Cooperation Council Trademark Law, which is applied in Saudi Arabia, states that "[a] contract licensing the use of a trademark shall only be valid, unless it is written, and it is not a must to be recorded in the Trademarks Register." The Law further elaborates that "[i]f same is recorded in the Register, the method of recording and announcement shall be determined in the Executive Regulations."

Hence, the question arises if it is mandatory to record trademark licenses in Saudi Arabia? Given that the Law does not stipulate that license recordal is mandatory, then the answer is clearly no. Is this a recommended practice, however? The short answer is yes, it is recommended to record licenses with the Saudi Trademark Office. In other words, recording is advisable in order for the license and the rights of the licensee to have effect against third parties. Furthermore, failure to record an agreement may have the following implications:

1. It can undermine attempts by the licensee to enforce rights against infringers who are claiming to be using the mark in good faith. However, failure to record a license does not mean that the licensee will not be able to bring a Court action against a counterfeiter or another party who infringes a mark in bad faith.
2. It can undermine attempts by the licensee to enforce rights against any cancellation action brought by a third party based on non-use. In principle, ineffective use of a trademark in Saudi Arabia within five consecutive years preceding date of filing for cancellation will subject a trademark registration to cancellation on the grounds of non-use.

Another issue worth noting is whether local municipal authorities in Saudi Arabia will require a license recordation to allow the use of the mark on signboards by the licensee in their respective jurisdictions. Some municipal officers might insist on having the license recorded with the TMO, while others are more flexible and only require a signed agreement between the two parties, as per the Law.

OAPI | TRADEMARK OFFICE ADOPTS THE 11TH EDITION



The Trademark Office of the African Intellectual Property Organization, commonly referred to as OAPI, recently announced that it is adopting the 11th edition of the Nice classification. OAPI is composed of 17 French speaking African states: Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal, and Togo. OAPI's headquarters are located in Yaoundé, the capital city of Cameroon.

By way of background, the amendments in the 11th edition cover 15 class headings and explanatory notes for seven classes. Furthermore, the list of goods and services was extended by 334 terms. Major revisions in the 11th edition include:

- Class headings affected by current revisions are those numbered 3, 6, 10, 14, 16, 17, 18, 20, 21, 22, 24, 26, 28, 31 and 45
- All serving utensils are grouped under class 21 instead of class 8
- The addition of unlocking of mobile phones under class 42
- The addition of dog walking, kimono dressing assistance, and conducting religious ceremonies under class 45
- The addition of eyelash brushes and foam toe separators for use in pedicures under class 21
- The addition of herbal extracts for cosmetic purposes under class 3
- The addition of herbal extracts and physiotherapy preparations for medical purposes under class 5
- The addition of body composition monitors under class 10
- The addition of several new goods under classes 29 and 30, including guacamole, onion rings, falafel, bibimbap, dulce de leche, almond, peanut and coconut milks, as well as nut- and chocolate-based spreads. Escamoles (prepared edible ant larvae) and edible insects have also been added under classes 29 and 31

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