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*In. this
issue*

LIBYA

IRAQ

TURKEY

PAKISTAN

IP HIGHLIGHTS

Patent Office Resumes Work and Swiss-Libyan Relations Back to Normal

Missing Files at the Trademark Office

Revised Practice Regarding the Registrability of Trademarks for Retail Services

Launching of Digital Journal of Trademarks

Recordal of Trademark Licenses across the Arab World

2

2

3

3

4

LIBYA
NEWSPATENT OFFICE RESUMES
WORK AND SWISS-
LIBYAN RELATIONS
BACK TO NORMAL

The Patent Office has resumed its operations after a 9-month closure period as a result of the civil unrest in the country. All deadlines falling within this period were already put off until the Office is operational again. Now that the Office is functional, all national phase applications with priority dates falling within the closure period can still be filed. Novelty issues will not be a major concern. In fact, Libya is among the last few countries in the world to require only local novelty for patent applications.

The most important change which has taken place in the country following the recent events is related to the Libya-Switzerland relations. Switzerland has recently established formal relations with Libya's Transitional National Council after a 3-year breakdown of the Swiss-Libyan Diplomatic relations. The implication of this is that it will now be possible to file new patent applications for Swiss applicants in Libya. Also, pending patent applications will no longer be kept on hold.

As it stands at present, Libya's patent legislation is based on Law no. 8 of 1959, published in Official

Gazette no. 11 dated May 25, 1959. The main features are as follows:

1. Patent applications are published in the Official Gazette. Oppositions may be filed within 2 months from publication date.
2. Applications are examined as to form and local novelty.
3. A maintenance fee is due annually on the anniversary of the filing date and is payable as from the date of grant. There is a 6-month grace period for late payment with no surcharge.
4. The term of protection is 15 years from filing date renewable for a further period of 5 years. The protection term for patents related to food-stuffs or drugs or pharmaceutical compositions is limited to 10 years.

The Trademark Office is also expected to resume its activities very soon. Meanwhile, we will be docketing all the instructions we receive from you, preparing all the required forms and diarizing all approaching deadlines in order to ensure proper follow-up and organization. Therefore, we will be able to immediately file all pending trademark applications once the Trademark Office resumes work. We will be updating you on this in due course. We will let you know how deadlines falling within the closure period will be treated once this information is available. We also expect Swiss applicants to be able to file trademark applications once the Trademark Office is operational. Should you have any questions regarding the subject matter, please contact us at libya@sabaip.com

IRAQ
NEWSMISSING FILES AT THE
TRADEMARK OFFICE

A large number of trademark files were destroyed back in 2003 as a result of the war in Iraq. The latest step in the Iraqi Trademark Office's process to rectify the situation was the official announcement on October 11, 2011 to review the files of trademark registrations 23000 to 34999 in order to make sure that the records are in order. By way of background, the Iraqi Trademark Office has already completed the revision of two file batches: (files no. 1 to 16090) and (files no. 16091 to 22999). In case of any missing documents, owners will be asked to complete all requirements by no later than April 11, 2012. Trademark registrations with records that remain incomplete after this date will be considered abandoned. It is not clear at this stage whether the deadline will be extended.

In light of the above, Saba & Co. IP will be reviewing client files in coordination with the Iraqi Trademark Office and will notify clients of any missing or incomplete records. Should you have any questions regarding the subject matter, please contact us at iraq@sabaip.com.

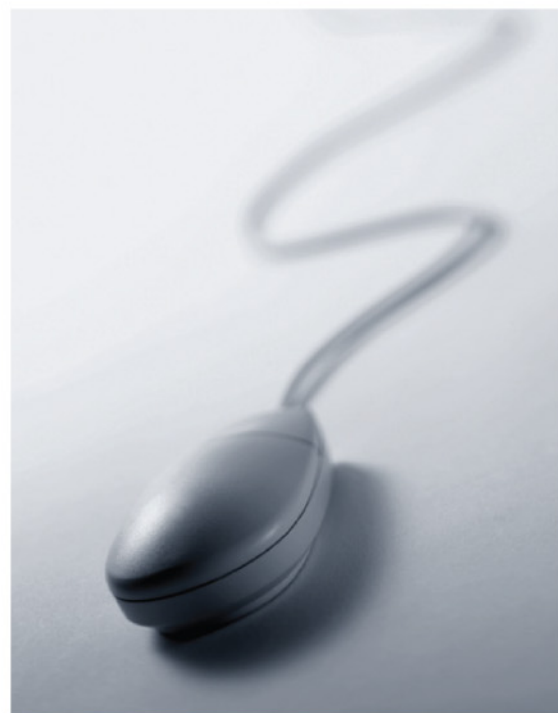
TURKEY NEWS

REVISED PRACTICE REGARDING THE REGISTRABILITY OF TRADEMARKS FOR RETAIL SERVICES

The practice of the Turkish Patent Institute (TPI) regarding the registrability of trademarks for retails as a service has recently been reviewed in particular with regards to the specification of the type of retail concerned. Previously, class 35 was generally described as "services of bringing together a variety of goods, enabling customers to conveniently view and purchase those goods" which was used to provide a wide coverage for a trademark without any limitations to a certain group of services within the same class. As a consequence, it was not required to specify in what activities services in class 35 exactly consist, nor was it required to indicate the type of establishment undertaking the retails sales. The implications of this is that if a trademark is already registered in class 35, no applicant will be able to register an identical or similar trademark for the same services even if both marks deal with retailing and sale of totally different goods.

However, based on the new revisions, the TPI may accept the co-existence of identical or similar marks in class 35 in the name of different owners as long as details are provided with regard to the goods or types of goods to which those services relate. What is required is a reference to the goods or type of goods sold at retail in order to distinguish a mark from a previously registered one. Therefore, if a trademark owner has registered the trademark for retail services of specific goods, it will be possible for other trademark owners to register the same trademark for retail services of other goods. The reasoning is that the protection for marks claiming retails services is exactly not conferred to the actual act of sale of those goods. The TPI will of course draw the appropriate conclusions from these principles when it comes to examining the confusing similarity between the marks. Conflicts between trademarks claiming retail services for different goods will continue to be judged according to the normal criteria.

By way of background, the current approach of other Trademark Offices from our region regarding the registrability of trademarks for retails services is not the same. Some Offices accept "retail services" as a plain term (such as the Trademark Offices of Algeria, Egypt, Jordan, Kuwait, Libya, Morocco and Tunisia), while others (including the Trademark Office of the UAE) insist on a formulation like "the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase these goods".



PAKISTAN NEWS

LAUNCHING OF DIGITAL JOURNAL OF TRADEMARKS

On October 20, 2011, the Trademark Office launched an on-line Journal of Trademarks. This means that all trademark applications accepted by the Registrar are now published or accessible to the public via the Intellectual Property Office website. This on-line Journal is an opportunity for third parties to oppose against a prospective mark. Oppositions may be filed within 2 months from publication date.

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

IP HIGHLIGHTS

RECORDAL OF TRADEMARK LICENSES ACROSS THE ARAB WORLD

This article addresses a major concern of businesses concerning trademark registrations, namely, trademark license recordal requirements. In principle, many countries that record trademark license contracts require certified signatures of both parties, a certified (and even legalized) copy of the entire license agreement, and various other formality requirements that are burdensome, time-consuming and costly for businesses having to record those trademark licenses. So it would be important to address the question of license recordal requirements in the Arab region. The following table sets forth basic information on the subject including:

- Whether license recordal is compulsory or not
- Whether license recordal is possible with respect to trademark applications
- The documents required by the Trademark Office for license recordal applications

In general, license recordal is not compulsory in all Arab countries, except for Iraq, Libya, Oman, Qatar and Syria. Noticeably, the common practice and the implementing regulations of the trademark laws of the Arab world do not require the recordal of trademark licenses, and there are no relevant penalties for failure to record. However, recording is only necessary and advisable in order for the license and the rights of the licensee to have effect against third parties. In other words, failure to record an agreement may have the following implications:

- (1) It can undermine attempts by the licensee to enforce rights against infringers that 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 within a specified period of time in the countries of the Arab region will subject a trademark registration to cancellation on the grounds of non-use.

It is worth noting here that none of the countries of the Arab world (except for Lebanon) are members of the Singapore Treaty (adopted in Singapore on March 27, 2006 and entered into force on March 16, 2009), which imposes limits on license recordal requirements as well as on the penalties associated with the failure to record licenses. Future accession to this Treaty will of course help in creating common standards across the Arab world for procedural aspects of trademark registration and licensing.

COUNTRY	IS IT NECESSARY TO RECORD A LICENSE AGREEMENT BEFORE THE TRADEMARK OFFICE SO THAT IT BECOMES EFFECTIVE AGAINST THIRD PARTIES?	WHAT ARE THE DOCUMENTS REQUIRED FOR THE RECORDAL?	IS IT POSSIBLE TO RECORD A LICENSE AGREEMENT BASED ON A TRADEMARK APPLICATION?
Bahrain	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, legalized; and license agreement, legalized.	No. A license may be recorded for trademark registrations only.
Egypt	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney from licensor, legalized; power of attorney from licensee, legalized; license agreement, legalized; and certificate of incorporation of the licensee, legalized.	No. A license may be recorded for trademark registrations only.

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Iraq	License recordal is compulsory in order to be effective against third parties.	Power of attorney, legalized; and license agreement, legalized.	Yes
Jordan	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, legalized; and license agreement, legalized with Arabic translation.	No. A license may be recorded for trademark registrations only.
Kuwait	License recordal is not compulsory but advisable in order to be effective against third parties.	If the licensee is a Kuwaiti national, the license agreement may be recorded at the commercial register and not the Trademark Office. A legalized extract from the commercial register would then be duly recognized by the Courts should a conflict arise.	Yes
Lebanon	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, simply signed; and license agreement; legalized.	Yes
Libya	License recordal is compulsory in order to be effective against third parties.	Power of attorney, legalized; license agreement, legalized, with sworn Arabic translation; and certificate of incorporation or extract from the commercial register, legalized, with sworn Arabic translation.	Yes
Morocco	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, simply signed and sealed; and license agreement, notarized with French translation.	No. A license may be recorded for trademark registrations only.
Oman	License recordal is compulsory in order to be effective against third parties.	Power of attorney, legalized; license agreement, legalized; and copy of certificate of incorporation, certified.	No. A license may be recorded for trademark registrations only.
Qatar	License recordal is compulsory in order to be effective against third parties.	Power of attorney, legalized; license agreement, legalized; and copy of certificate of incorporation of licensee.	Yes
Saudi Arabia	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, legalized; license agreement, legalized; and original Saudi registration certificate of the mark for endorsement.	No. A license may be recorded for trademark registrations only.
Sudan	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney from the licensor, legalized; power of attorney from the licensee, legalized; license agreement, legalized; certificate of incorporation of licensee, legalized; and the original registration certificate of the mark(s) for endorsement.	Yes
Syria	License recordal is compulsory in order to be effective against third parties. The license agreement must be recorded within 3 months from effective date otherwise a surcharge is levied.	Power of attorney, legalized; and license agreement, legalized.	No. A license may be recorded for trademark registrations only.
Tunisia	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, simply signed; and license agreement, legalized with French translation.	Yes
United Arab Emirates	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, legalized; license agreement, legalized; and a copy of registration certificate of the mark.	No. A license may be recorded for trademark registrations only.
Yemen	License recordal is not compulsory but advisable in order to be effective against third parties.	Power of attorney, legalized; and license agreement, legalized.	No. A license may be recorded for trademark registrations only.

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