

SABA
INTELLECTUAL
PROPERTY



**MERRY CHRISTMAS AND
HAPPY NEW YEAR**

IN THIS ISSUE

2016: YEAR IN REVIEW

- GCC: Implementing Regulations of the Unified Trademark Law
- Saudi Arabia: New Patent Law Implementing Regulations
- Kuwait: Joining PCT
- Qatar: Formation of Patent Grievances Committee
- UAE: Updates on Customs Recordal and Specialized IP Courts
- Iran: What You Need to Know
- Iraq: Mandatory Clearance Search
- Egypt: Authorization by the General Organization for Export and Import Control
- Jordan: Signboards in Arabic
- Libya: Reinstatement of Trademarks and Issuance of Registration Certificates



2016: YEAR IN REVIEW

Our annual “Year in Review” series sums up the most important intellectual property developments and news that unfolded over the past year in the Middle East, North Africa and their neighboring regions.

This year marked a milestone achievement for Saba IP, as we have been honored with the IP Firm of the Year award for the Middle East for 2016, conferred during the MIP’s annual Global Awards ceremony that was held in London on March 10, 2016. We are certainly proud to be showcased and celebrated among the best in our industry. Needless to say, our relentless strive for service excellence would not have been possible without the trust of our clients.

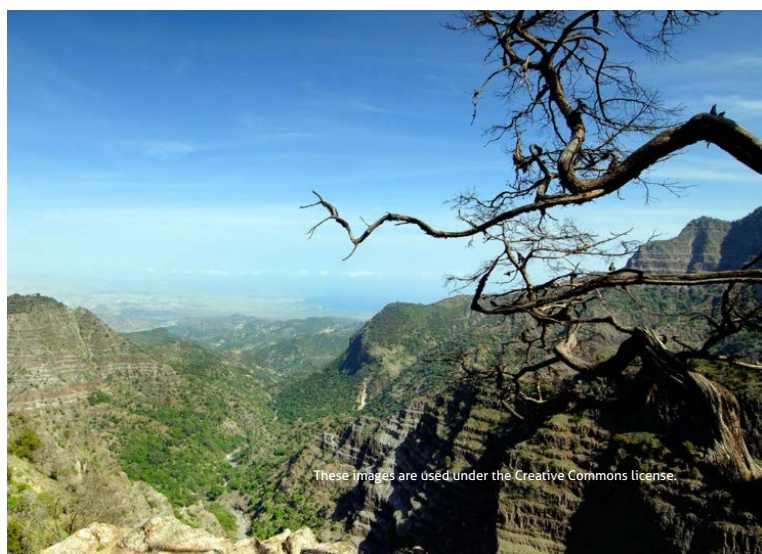
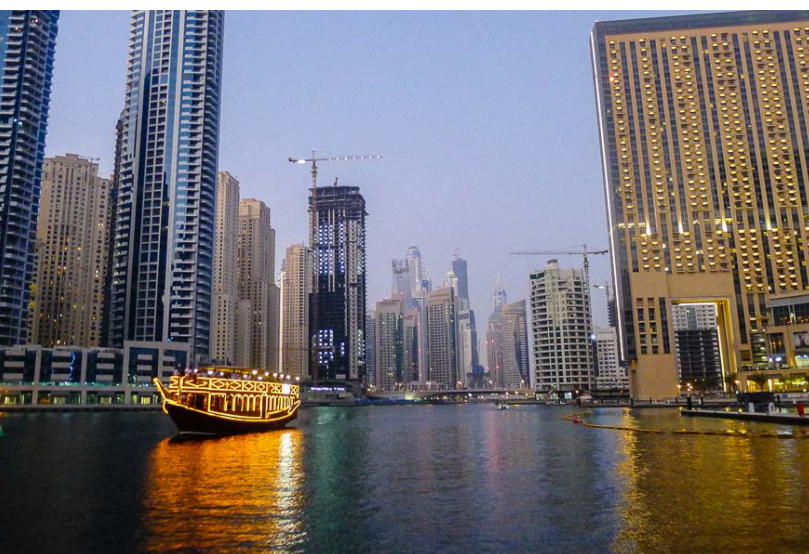
Notable developments in the Middle East and North Africa worth pointing out are outlined below:

GCC: Implementing Regulations of the Unified Trademark Law

On the trademarks front, countries of the GCC were preoccupied with the introduction of the implementing regulations of the GCC unified trademark law. 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, not a unitary law. The Law was issued in 2006 and revised in 2014. It stipulates a set of provisions that are applied uniformly across all the GCC, 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 remain as the receiving office and register trademarks on a national basis. Registering a trademark across the six GCC countries will still require filing six separate national trademark applications. Furthermore, Saudi Arabia, Kuwait, Bahrain, and UAE have considerably increased their official fees over the past few months with Qatar expected to follow suit.

The definition of a trademark has significantly expanded to include color marks, sound marks, and smell marks as trademarks. Furthermore, multiclass applications will be 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. The examination process is expected to be harmonized, 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.



Saudi Arabia: New Patent Law Implementing Regulations

An important development on the patent front in the GCC is Saudi Arabia publishing new Implementing Regulations of the Patent Law to include provisions concerning the national stage entry of PCT patent applications, which entered into force on December 19, 2015. According to the new regulations, the international filing date will be the filing date of a PCT national entry and the base year for calculating annuities. Annuity fees for applications will still be due between January 1 and March 31 of each year, starting with the first payment that will include any back payments the year following the entry date. The usual grace period with a late fee will still apply through June 30 of the same year.



Kuwait: Joining PCT

As for Kuwait, the country became the 149th member of the Patent Cooperation Treaty (PCT) on June 9, 2016, and the sixth Gulf Cooperation Council (GCC) member state to accede to the PCT. The Treaty entered into force on September 9, 2016. With Kuwait's accession, all GCC countries are now members of the PCT, thus enabling the GCC Patent Office to accede to the PCT itself in the future. This update comes after the Kuwaiti Patent Office has stopped accepting new patent applications as of April 4, 2016. It is advising parties interested in seeking patent protection in Kuwait to utilize the GCC Patent Office. As a reminder, a GCC patent application automatically designates all six GCC member countries, and no further validation is required upon grant. It is not yet possible to designate the GCC in PCT international applications or to enter the national (regional) stage via the GCC Patent Office for a PCT international application.



Qatar: Formation of Patent Grievances Committee

In further developments on the patents front, and as part of the country's efforts in advancing its IP procurement, Qatar approved a draft decision on the formation of a Grievances Committee.

The Committee is to be headed by the Director of the Patent Office and its members will be composed of representatives from the Ministry of Economy and Commerce, Qatar Foundation for Education, Science and Community Development, and Qatar Chamber of Commerce. The Committee's main functions will include handling enforcement and litigations concerning registration of patents and compulsory licenses.



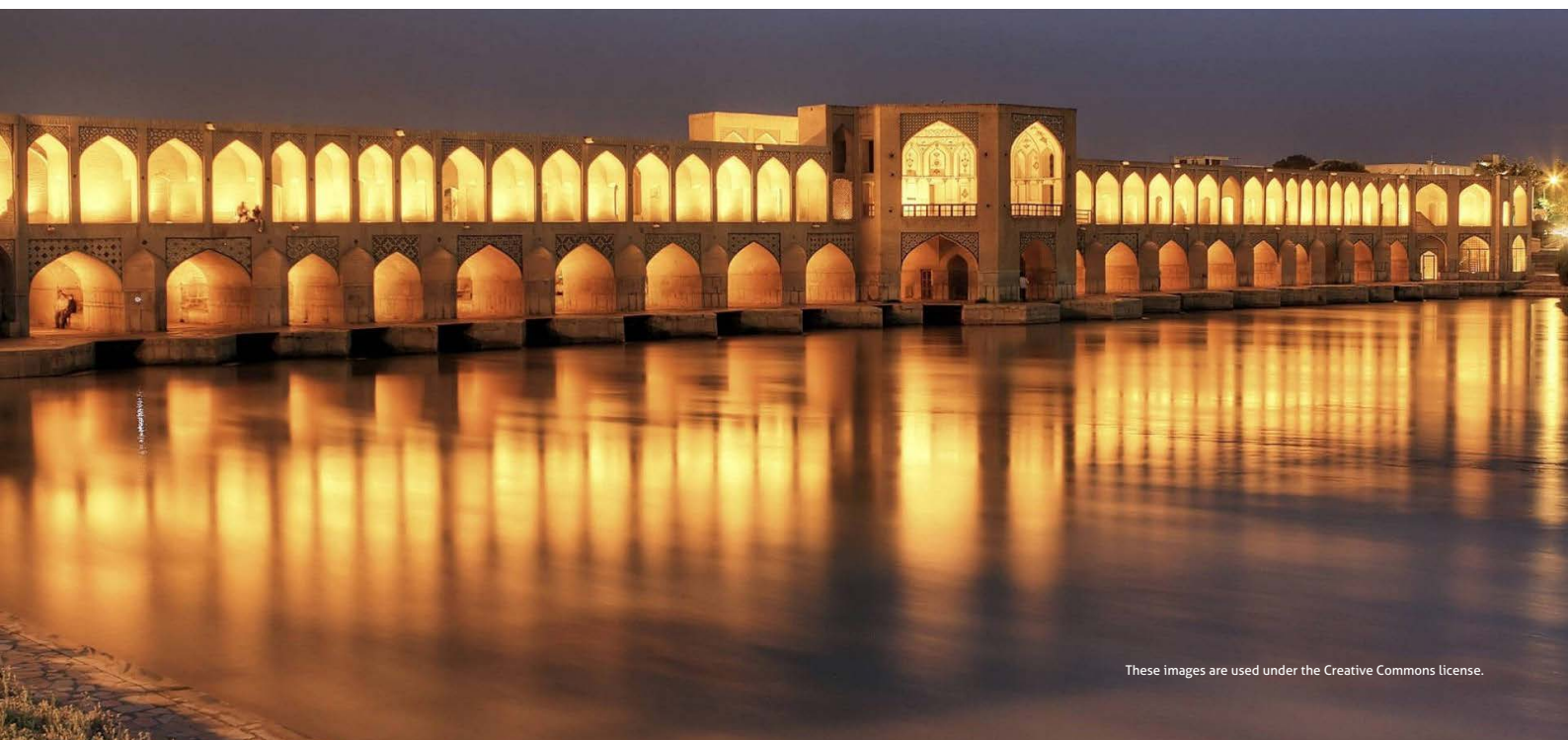
UAE: Updates on Customs Recordal and Specialized IP Courts

It is possible to file for Customs recordal in five out of the seven Emirates of the United Arab Emirates, mainly: Abu Dhabi, Dubai, Sharjah, Ajman, and Ras Al Khaimah. Furthermore, the Dubai Department of Economic Development (DED) launched a new electronic system for recording trademarks and processing complaints against importers and distributors of suspected counterfeits.

Furthermore, in its continuous effort to boost intellectual property protection in the region, the UAE is setting up specialized IP courts across the country, as per Ministerial Resolution No. 137 for 2016. This applies to federal courts and hence, emirates which have their own court system, such as Dubai and Ras al-Khaimah, are not subject to this resolution.

The Judicial Inspection Department will provide specialized training to local judges to assist them with all the procedures and technicalities associated with IPR cases. An increased judicial competence is anticipated to result in effectively and efficiently resolving disputes.





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Iran: What You Need to Know

Lifting of sanctions: Although the US and EU sanctions programs currently in place allow individuals and entities to perform IP-related transactions, with the lifting of sanctions in Iran, many businesses will look to expand their operations into the country with a growing need for establishing tailored local IP protection strategies. Therefore, brand owners should start reviewing and assessing their existing trademark portfolio in the country in order to ensure that their portfolio management strategies are aligned with the overall business strategy. A trademark audit in Iran should now be a priority for different reasons including: (1) revealing significant gaps in protection so that remedial steps may be taken, (2) identifying applications and registrations that are no longer aligned with the business and determining the appropriate actions to take, and (3) uncovering potential risks, such as infringement, before they materialize. Now is also the best time to monitor the marketplace to identify third party infringements which were difficult to control during the boycott.

Specification of goods/services: The TMO no longer accepts general terms for goods and services on the application. Trademark applicants will be asked to submit the exact WIPO serial number for each item of interest, and as it appears for the time being, the list of goods/services of the Iranian e-platform is not fully inclusive all of WIPO serial numbers. Applications with an item that is not explicitly on that list will not be properly docketed into the system, which would result in considerable delays.

International registrations: The process of local publication of Madrid applications designating Iran is being interrupted because of the lack of coordination between the TMO and the authorities administering the Official Gazette. The only way to set the work flow back on track is to submit a separate request for publication before the authorities administering the Official Gazette and settle the related publications fees per application.

Iraq: Mandatory Clearance Search

A prior trademark clearance search is now a prerequisite for every trademark application submitted at the TMO before the filing particulars are issued. This new line of practice could at some point cut down the backlog of work by essentially reducing the time it takes to perform examination on relative grounds at a later stage. If the proposed trademark is found to be available following the clearance search, the application will then follow the standard registration procedure. This revised practice will not apply to Paris convention applications in order to safeguard the priority period.

Egypt: Authorization by the General Organization for Export and Import Control

According to the new regulations that will come into effect on March 15, 2016, imported goods will not legally enter into the Egyptian market unless the merchandise is authorized by the General Organization for Export and Import Control (GOEIC).

In order to obtain authorization, importers are required to record the name of the manufacturer, as well as the corresponding trademark registration of the imported products at the GOEIC. This comes as a necessary step to ensure that the imported goods are not counterfeits. It will be sufficient for importers of products with multiple entries per year to record of the name of the manufacturer and the trademark registration only once, unless the particulars of the manufacturer and/or the trademark registration have changed. Another recordal will be required in such a case.

Requirements for the recordal of the name of the manufacturer: (1) Certificate of incorporation; (2) List of the manufacturer's products and trademarks; (3) Certificate evidencing that the factory has a quality control system, issued from an authority recognized by the International Laboratory Accreditation Cooperation (ILAC), International Accreditation Forum (IAF), or any Egyptian or foreign authority approved by the Minister responsible for foreign trade

Requirements for the recordal of trademark registration: (1) Certificate of trademark registration, local or foreign. The registration in the home country is preferable if owners opt for the submission of the foreign registration; (2) Certificate issued from the company owning the trademark regarding the distribution centers that are authorized to distribute the products bearing the trademark; (3) Certificate evidencing that the company owning the trademark has a quality control system/quality assurance, issued from an authority recognized by ILAC, IAF, or any Egyptian or foreign authority approved by the Minister responsible for foreign trade.



Jordan: Signboards in Arabic

Jordan joins Egypt, Oman, Qatar, UAE, Saudi Arabia, Yemen and Syria in their call for the compulsory use of the Arabic script of a mark on signboards. This comes pursuant to the provisions of Article 5 of Law no. 35 of 2015 for the protection of the Arabic language introduced in the country on July 1, 2015. The Article allows for the use of a language on the signboards other than Arabic as long as the Arabic part appears in a much bigger font. The scales are not explicitly identified in the Law.

Law no. 35 of 2015 became effective on September 1, 2015. Based on Article 16 of the Law, all affected parties have until September 1, 2016 to ensure full compliance with the underlying provisions. Violations will be subject to fines ranging between USD\$1,400 to USD\$4,200.

Seeing that use of a mark in Arabic is not a matter of choice but is a statutory requirement governed by local regulations, it becomes advisable to register the transliteration in the local script in class 35, in addition to the registration in the Latin version. Clearly, a key disadvantage of filing an Arabic trademark is the additional costs of clearance and registration. However, the benefits of protecting a mark in Arabic outweigh the associated costs. Problems can certainly 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.

Libya: Reinstatement of Trademarks and Issuance of Registration Certificates

The TMO has reportedly opened the door for the reinstatement of trademark registrations which have expired in the years 2013 to 2015. It is still not clear for how long will the extension last and, for this reason, interested applicants should file their requests as soon as possible. Also, the TMO began issuing registration certificates in October 2015 for applications in the 5000 series but the process was interrupted at a later stage.



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



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