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JORDAN: UPCOMING PCT ACCESSION

Pursuant to amending the Patents Law in 2016, the Jordanian Council of Ministers approved the accession of Jordan to the Patent Cooperation Treaty (PCT).

Accordingly, the instrument of accession is being prepared by the Ministry of Industry and Trade and Supply and will be signed on behalf of the government of Jordan and submitted at the World Intellectual Property Organization (WIPO).

During the transitional period into becoming a member of the PCT, the Ministry concerned will raise awareness to familiarize all stakeholders with the Treaty. We expect further developments and news in this area that should clarify the direct benefits of Jordan's upcoming accession to the PCT.



JORDAN: CUSTOMS RECORDAL

Border measures are a key tool in the fight against counterfeiting and piracy and a critical element of a successful intellectual property enforcement system. In the scope of the continuous efforts to create competent border enforcement measures and to provide effective protection, records in Jordan are available at two different authorities, the General Customs Department and the Aqaba Special Economic Zone Authority (ASEZA). Both work separately, however. Furthermore, ASEZA is only concerned with the shipments that are cleared into the free zone only.

One fundamental premise of the recordation system (other than providing a central registry containing information for recorded trademarks) is that it allows Customs officials to adopt an *ex-officio* border system. An *ex-officio* system is different from the standard border system in which a judicial authority orders Customs to detain the infringing shipment after identifying the infringing goods. The key advantage of the *ex-officio* system is that it allows for prompt and proactive action by Customs officials thus avoiding the delays inherently involved in seeking judicial action. Customs officials are always on the lookout for infringing goods and are thus able to act quickly to confiscate counterfeit and pirated merchandise.



The application for recordal should include certain information as required by the applicable policies and must be accompanied by the certificate of registration of the mark and a power of attorney. The Customs will then issue a recordation notice.

The below table lists the required documents for recordal with the General Customs Department and ASEZA:

Recordal with General Customs Department	Recordal with Aqaba Special Economic Zone Authority (ASEZA)
<ul style="list-style-type: none">• Power of attorney, legalized up to the Jordanian consulate• Copy of the registration certificate of the trademark to be recorded• A petition duly executed on behalf of the rights holder• Brochures or images showing how the genuine trademark is being used <p>Recordal is valid for the trademark's protection term, renewable for like periods</p>	<ul style="list-style-type: none">• Power of attorney, legalized up to the Jordanian Consulate• Copy of the registration certificate of the trademark to be recorded• Application form• Brochures or images showing how the genuine trademark is being used <p>Recordal is valid for one year, renewable for like periods</p>

IRAN: TRADEMARK REQUIREMENTS REVISED

Iran recently announced that a legalized extract from the commercial register is required for new trademark applications and oppositions and must be submitted within 60 days from filing date—a simply signed copy is required at the time of filing, however. For renewal applications, a notarized extract from the commercial register is sufficient.



GCC: PROTECTING INNOVATION THROUGH THE REGIONAL PATENT OFFICE

With increasing official or government fees across the board relating to Intellectual Property procurement, regional offices can provide a more cost effective alternative when available. Patent attorneys and law firms worldwide are aware of the European Patent Office (EPO) and in most cases of the Eurasian Patent Organization (EAPO). Possibly due to the lag in emergence and development of certain regions, other regional patent offices are less known and utilized, namely, the GCC Patent Office (GCCPO). In this report, we will discuss the GCCPO in more details.

History and Statistics

The GCCPO, as its name indicates, is the regional office for patent protection in the six GCC member countries: Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates (UAE). The GCCPO is based in Riyadh, Saudi Arabia, and is independent from the Saudi Patent Office, which is also based in the same city.

The GCC Patent Law was introduced in 1992. The first GCC patent application was filed in 1998 and the law was amended in 1999. The related implementing regulations were issued in 2000.

According to the statistics available on the GCCPO website, and as of the end of 2015, approximately 30,000 patent applications have been filed since 1998. Of these, approximately 16,000 applications have been examined and completed and approximately 14,000 are pending, i.e. under formal examination, under substantive examination or other.

As of the end of 2015, 3,992 patents have been granted and issued in various fields. This means that roughly 12,000 applications have been rejected, cancelled or abandoned for various reasons.





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Filing a GCC Patent Application

The GCCPO accepts applications from all over the world. Most foreign applications claim a 12 month priority, similar to a Paris Convention filing, albeit the GCCPO is not a member of the Paris Convention as stated in the table in the introduction.

According to the statistics published by the GCCPO, the top five filers between the years 2011 and 2015 are, in decreasing order: USA, Saudi Arabia, Switzerland, Netherlands and Germany.

The GCCPO is an electronic filing office. All requests, notifications and documents are managed electronically via the GCCPO portal. The following documents, in addition to the disclosure (i.e. title, abstract, description, claims and figures) are required: a legalized POA; a legalized DOA; and a certified copy of the claimed priorities.

Legalization of the above listed documents may be made up to the Consulate of any of the six member states. All the supporting documents may be submitted within 90 days from the filing date. These documents are submitted electronically, as color scans, while the original paper documents have to be maintained in a safe place in case the need arises to re-scan for quality reasons or for actual submission if requested by the patent office.

In addition to these supporting documents, a complete Arabic translation of the disclosure is required, and required to be submitted at the time of filing. The translation has to be provided according to the formatting and requirements of the regulations, i.e. paper size, margin size, etc.

In case the formal requirements are not all met in a timely fashion, the application will be cancelled and a notification to the same will be issued, roughly within a year or so. There is no provision in the regulations for requesting an extension of time at any stage during the prosecution of a GCC patent application.

If all the requirements are met, the application then moves into substantive examination.

Substantive Examination

Substantive examination has to be requested and the related fees settled within 90 days from issuance of the notification to do so by the patent office. This notification is usually issued after two years from filing, depending on the backlog. The GCCPO has been accelerating examination lately.

While the GCCPO examines many of the applications, a number of the application is examined by the Chinese Intellectual Property Office (CIPO) and to a lesser extent, the Austrian Patent Office.

Once started, examination is relatively rapid and depending on the reply to the office actions, a decision may be issued within months from the date of last response.

A favorable decision will result in the grant and publication of the application, which then becomes open to opposition for a period of 90 days. If no opposition is filed, then the patent is issued and may be enforced in all 6 GCC countries without the need for validation.

Patent Maintenance

As is the case in practically all patent systems in the world, the patent term for a GCC patent is 20 years, calculated from the filing year. This part sometimes gets confusing as the calculations are not based on the filing date or priority date as one would expect.

Annuities are due in the first quarter of each year following the filing year. In other words, annuities should be settled between January 1 and March 31 of each year, with a grace period until June 30 with a penalty fee. As an example, for an application filed on any day in 2016, the 1st annuity is due between January 1 and March 31 of 2017. Subsequent annuities are due similarly.

An interesting provision with regards to annuities for GCC patent applications is that after the 4th year, and in case the patent has not granted yet, the patentee is exempt from paying the annuities. Upon grant, the back-annuities will then have to be settled in order to proceed with the issuance.

Enforcement

A GCC patent can be asserted and enforced in all six GCC countries. In case of a suspected infringement or actual infringement in any one of the six countries, legal action may be taken and the GCC patent used to support the plaintiff's case.

The competent court for taking such an action will be the competent judicial authority in the country where the infringement is taking place. There isn't a unified court for the GCC patent system, at least not yet.

Currently, there are no specialized courts in the GCC countries. IP litigations are handled in the courts of first instances or civil courts whichever is applicable, with the exception of Saudi Arabia. The courts have appointed sworn experts who will provide an opinion during patent litigation cases.

In Saudi Arabia, the competent authority is the Committee which is composed of three law specialists and two technical experts. Decisions of the Committee shall be issued by majority vote. An appeal against any decision issued by the Committee may be brought before the Board of Grievances.



In closing

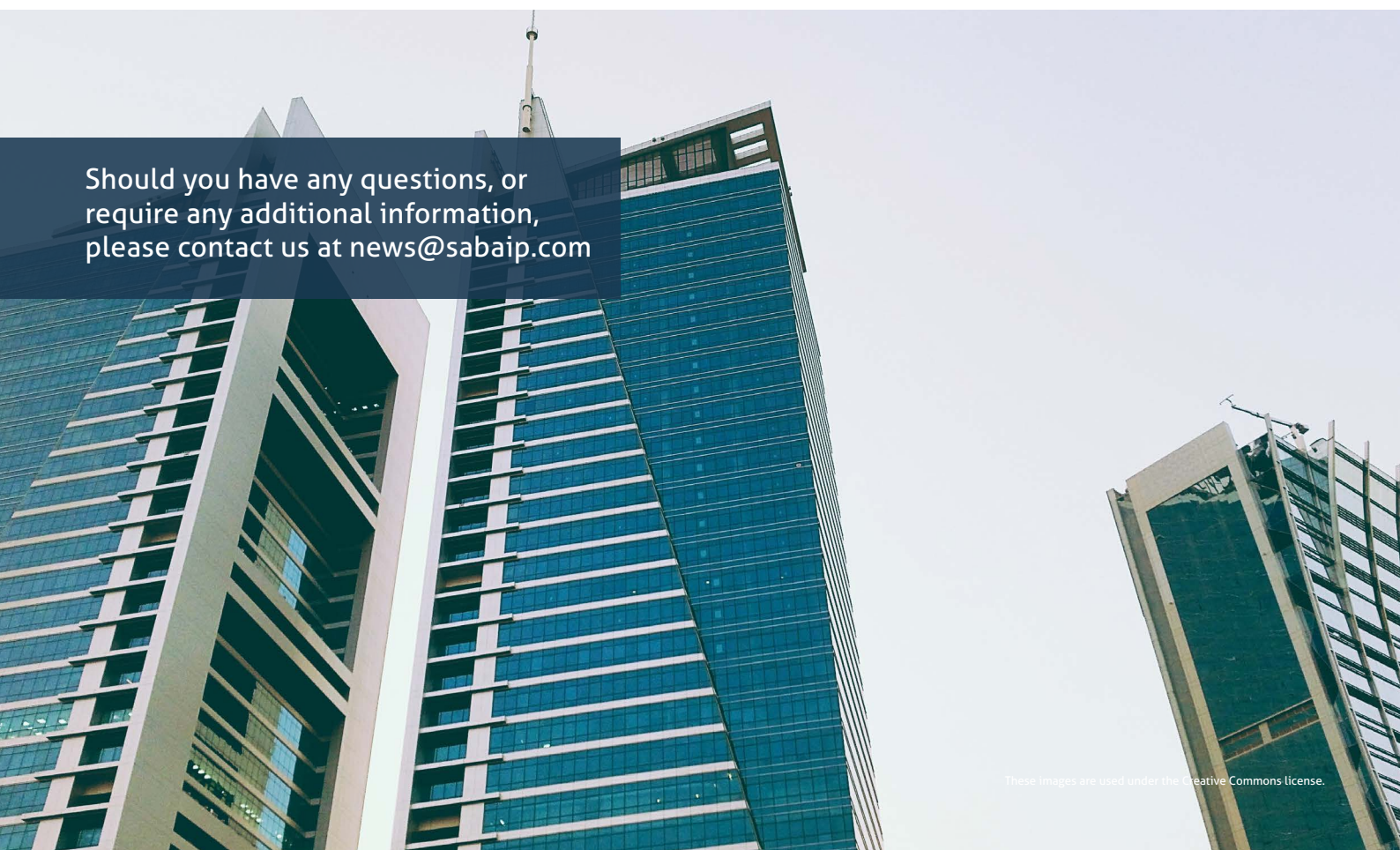
Needless to state, and in the interest of not losing the readers, many details relating to the sections above have been omitted. Nevertheless, the main points and ideas have been introduced and presented.

Simply by looking at various statistics related to the region, there is no doubt of the growth this particular area of the Middle East has experienced over the past decade and is expected to maintain a sturdy growth for the coming years. Investments for the development of various industries as well as in innovation can be seen in the two largest economies of the GCC, namely Saudi Arabia and the UAE; but also in Qatar and Oman and to a lesser extent in Bahrain and Kuwait.

The region has drawn the attention of all major global players as attested by the diversified patents and patentees and from where we stand, we have witnessed a continuous growth that is not abetting yet. The region is putting its mark in the international community and is well on its way to becoming a major player in the global economy.



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



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