

SABA *bulletin*

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KUWAIT
NEWS**KUWAIT**
DEADLINE TO
COMPLETE TRADEMARK
APPLICATIONS – STATUS
UPDATE

The Trademark Office in Kuwait has recently issued an official notification regarding all pending trademark applications. Based on this notification, all requirements must be completed by the beginning of July 2011. The notification applies only to applications filed on or before December 31, 2010 that have already been examined. This decision does not cover the following:

- (1) Pending applications that have not been examined yet
- (2) Applications filed after December 31, 2010

On this note, we have completed our review for all pending trademark applications we are handling in the country with incomplete documents. Our records show that all our files are in order, meaning that, no application will be abandoned. We will be following-up with clients at a later stage in case any action is required.

Should you have any inquiries or comments regarding the subject matter, please contact us at kuwait@sabaip.com

BAHRAIN
NEWS**BAHRAIN**
MORE THAN 100 000
PIRATED PRODUCTS
DESTROYED

More than 100 000 pirated products have been destroyed in Bahrain during a raid, considered the largest over the past five years.

The confiscated products included computer software as well as pirated CDs and DVDs. The said operation aims at shedding the light on the importance of respecting the Intellectual Property Laws in the country. Should you have any inquiries or comments regarding the subject matter, please contact us at bahrain@sabaip.com



IP CASES

1 -YEMEN TANG VS. THANKS – TRADE DRESS CONFUSION

The American company Kraft Foods Holdings, Inc, owner of the trademark “TANG” for beverage products, brought a trademark infringement action against the Yemeni company Ard Al Amal for Trading & Manufacturing Limited, for the registration of trademark “THANKS & Arabic Device” filing no. 46852 in class 32.

The Court found that the defendant had intentionally copied certain features of TANG’S trade dress to the extent that public confusion is possible. Both companies' products were sold in

similarly shaped packs, with labeling employing green and orange backgrounds. Also, the nature of goods covered by the defendant’s trademark indicated a connection with the marks of the plaintiff.

In light of the foregoing, the Court ruled in favor of Kraft Foods Holdings, Inc and ordered the defendant to:

- Destroy all seized products of “THANKS”.
- Cease any further use of the offending trademark “THANKS”.
- Bear all judicial costs.



Plaintiff’s Mark



Defendant’s Mark

IP CASES

2 -MOROCCO

2.1- TRADE NAME AND TRADEMARK CONFUSION WITH A FAMOUS BRAND

The Court of Appeal of Morocco had sustained on May 25, 2010 the decision rendered previously by the Tribunal of Commerce in favor of Tiffany & Co in the case brought against Tiffany Style. Tiffany & Co. had initiated an action against Tiffany Style for registering and using TIFFANY STYLE both as a trademark and a trade name. Such use and registration constitute a violation of rights held under the well-known brand TIFFANY owned by Tiffany & Co and are likely to cause public confusion.

2.2- NIKE INTERNATIONAL LIMITED VS. JOSE ALEJANDRO S.L.

The Court of Appeal has overruled a verdict issued earlier by the Tribunal of Commerce in the case brought by Nike International Limited on April 13, 2010 against Jose Alejandro S.L.

Nike International Limited, owner of the famous "NIKE & Swoosh Design" in classes 18 and 25, brought a lawsuit against Jose Alejandro S.L. for registering the mark "BUDMEN & swoosh Device", registration numbers 22529 and 81522, featuring a very

similar Swoosh logo.

The Court of Appeal found the defendant's and the plaintiff's trademarks to be confusingly similar as to appearance which would cause public confusion. Also, the goods covered by the defendant's trademark would most likely indicate a connection with the marks of the opponent, thus constituting unfair competition.

In light of the above grounds, the Court of Appeal in both cases, ordered the counterparts to:

1. Cancel both the offending trademark (and trade name);
2. Discontinue any further exploitation subject to a daily penalty in case of non-compliance;
3. Publish the Court's decision in two local newspapers at the defendant's expenses;
4. Bear all Court expenses.



IP HIGHLIGHTS

REGISTRATION OF A TRADEMARK IN AN INDIVIDUAL'S NAME

An individual's name can be protected in most countries of our region as a trademark as long as:

- (1) It has acquired distinctiveness and accomplished the objective of forming an association in the mind of the consumer between the products and the owner.
- (2) If the mark identifies a particular living individual, a written consent of that individual to the registration of the mark must be filed at the Trademark Office. Even though this requirement is not mandatory in some countries of our region, it is always advisable to submit this document. The consequences of not doing so can be severe for the party owning the mark. For example, when the mark is published for opposition, the mark can be successfully opposed by anyone with sufficient standing on the ground of failure to file such a written consent. Even if the mark is registered, a failure to file a written consent can still be used as a basis to cancel this mark. In fact, there are clear provisions in some IP laws (as illustrated in the table below) which clearly state that trademarks which consist of or comprise a name, portrait or signature identifying a particular living individual can not be registered except by a written consent.



Country	Is the registration of a trademark in an individual's name possible?	Special Requirements for such registrations?	Additional Remarks
Kuwait	Yes	No	N/A
Jordan	Yes	No	In the case of registrar rejection, applicant is required to provide evidence that he/she is authorized to do trade.
Syria	Yes	No	N/A
Morocco	Yes	No	N/A
Egypt	Yes	Yes. Certificate displaying his/her business activity.	N/A
Oman	Yes	Yes. Certified copy of document outlining form of business.	N/A
Lebanon	Yes	Yes. Power of attorney simply signed.	If the individual is Lebanese, a notarized power of attorney is needed.
Saudi Arabia	Yes	No	N/A
Qatar	Yes	Yes.	Power of attorney, legalized
UAE	Yes	No	
Yemen	Yes	Yes. Commercial License in the applicant's name	
Cyprus	Yes	No	

QATAR

REVIEW OF TRADEMARK, PATENT AND INDUSTRIAL DESIGN PROTECTION

I. TRADEMARKS BASICS

Legislation

Qatar follows Law No. 9 of 2002.

Classification

The International Classification of Goods and Services (7th Edition) is followed. However, class 33, alcoholic goods in class 32 and pork meat in class 29 can not be registered in Qatar. A separate application is required for each class.

Filing Requirements

- 1- Power of attorney, legalized.
A general power may be used for subsequent filings.
- 2- Copy of the certificate of incorporation.
- 3- Copy of priority document, if priority is claimed, certified.
- 4- 10 prints of the mark for each application.

Documents 1 and 2 must be submitted at the time of filing. Document 3 may be submitted within 6 months from filing date.

Opposition

Trademark applications accepted by the Registrar are published in the Gazette of Trademarks. Oppositions may be filed within 4 months from publication date.

Protection Term

Trademark registrations are valid for 10 years from filing date and are renewable for like periods. There is a grace period of 6 months for late renewals with payment of a surcharge.

Use Requirements

Use of a trademark is not required for registration or renewal of a mark. However, a trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years preceding the date of filing for cancellation.

Assignment

Trademark applications and registrations may be assigned with or without the goodwill of the business concerned.

Licensing

License recordal is compulsory in order to be effective against third parties.

Marking

Marking is not compulsory.

Cancellation

A trademark is subject to cancellation by any interested party if it can be established that the mark was unrightfully registered.

Registration Time Frame

The time frame for completing the registration process is 12 to 15 months.

Three Dimensional Trademark Applications

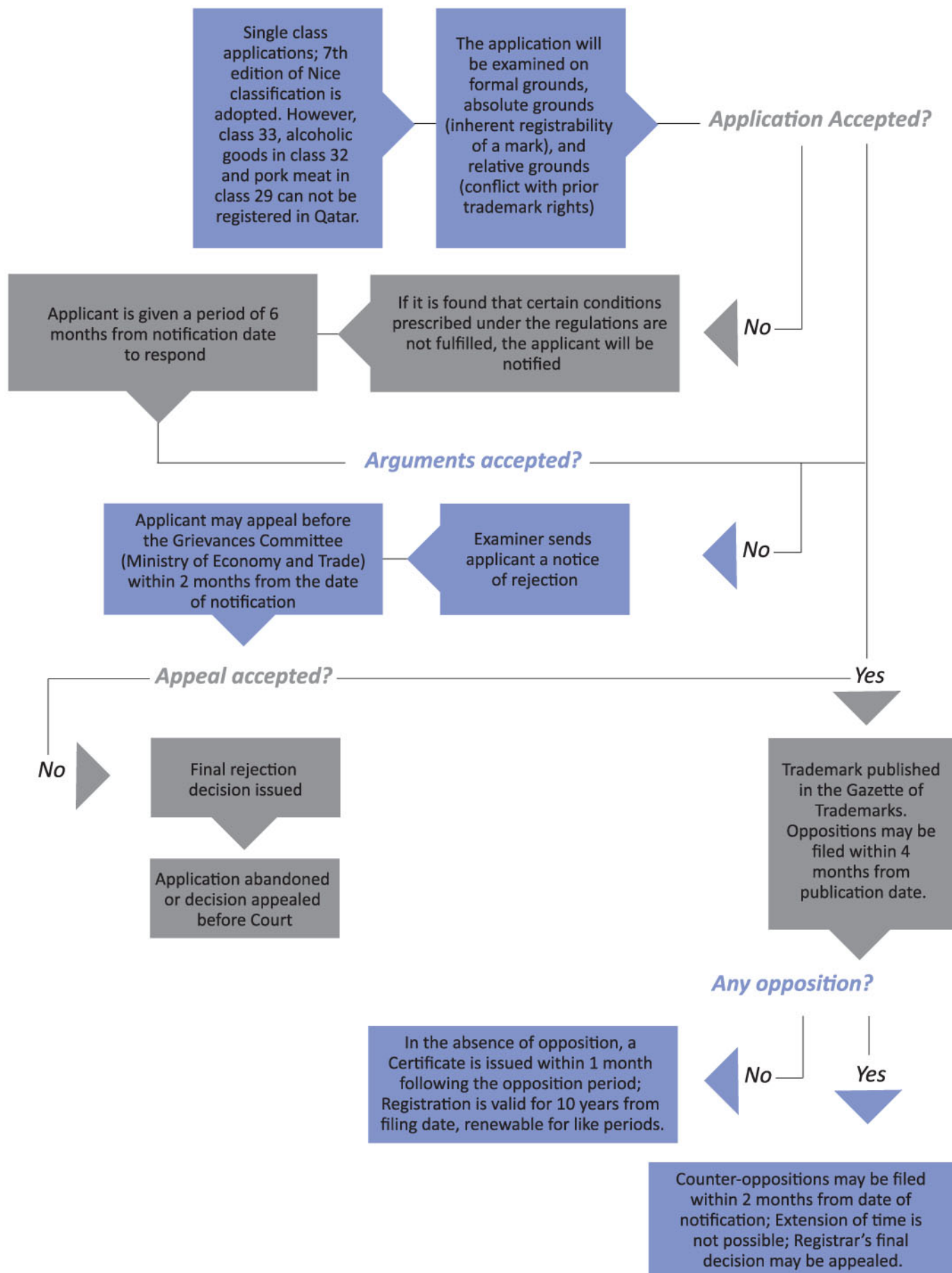
Admissible.

Well-known Trademarks

Qatar is a signatory country of the Paris Convention. Article 6bis for the Convention requires member countries to afford certain protection to well-known mark. Also, Article 8 of the Qatari Trademark Law No. 9 of 2002 states that well-known marks are protected even if they are not registered. Therefore, trademarks which constitute a reproduction, an imitation or those which are liable to create confusion with marks that are considered to be well-known in Qatar are not eligible for registration.



II. TRADEMARKS FLOW CHART



III. PATENTS

The Ministry of Trade and Industry of Qatar issued on August 07, 2006 Decree no. 30/ 2006 promulgating a Patent Law for the first time in the country. This new law is compliant with the World Trade Organization agreement and mirrors the provisions of the patents section of the TRIPS agreement.

For a long time before the promulgation of Law no. 30 /2006 and in the absence of a pertinent local legislation, protection was sought through the Gulf Cooperation Council unified patent registration system. Some sort of protection was also obtained through the publication of cautionary notices at regular intervals in local newspapers. Such notices could have legal value when submitted to the Courts in the event of infringement, thereby claiming ownership of the patent and warning third parties against infringement.

Law no. 30 of 2006 came into force in the country as of its date of promulgation but will only be



effective once the implementing regulations are drafted and issued by the Ministry of Economy and Trade. It is however expected to take a long time for the regulations to be issued. Until then, the current means for patent protection in Qatar (the GCC patent system or the publication of cautionary notices) will remain applicable.

In what follows, we list the salient features of Law no. 30 of 2006 as ratified by the Qatari Council of Ministers:

- Patent applications shall be filed with a separate office in the Ministry of Economy and Trade.
- Patents shall be available for all inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step, and are capable of industrial application.
- A patent shall confer on its owner the exclusive rights to prevent third parties not having the owner's consent from the acts of making, using, offering for sale, or selling the patented invention.
- Patent owners shall have the

right to assign, or transfer by succession, the patent and to conclude licensing contracts.

- The Examiner's decision to grant a patent will be published in the Official Gazette for opposition by any interested party within sixty days from publication date.
- Once granted, a patent shall enjoy protection for twenty years from the date of grant.
- A patent has to be worked. If the patent is not exploited by the patentee within three years from the date of grant, the patent will be subject to compulsory licensing under the provisions of the law.
- This law may not offer any benefits to local citizens which are not available to citizens of other TRIPS signatories by the principles of the national treatment.
- This law gives the right to patent owners to initiate civil and criminal actions against any infringing party. Penalties include payment of fines up to 10,000 Qatari Riyals (around US \$ 2,700) as well as legal prosecution resulting in a maximum of two-year imprisonment.





IV. DESIGNS

The Trademarks, Commercial Indications, Trade Names, Geographical Indications and Industrial Designs and Models Law no.9 of 2002 came into force on September 2002. However, the authorities have not yet established the necessary office for receiving design applications nor have the implementing regulations been drafted.

As an alternative measure, protection may be sought by publishing cautionary notices at regular intervals in local newspapers. Such notices could have legal value when submitted to the Courts in the event of infringement, thereby claiming ownership of the design and warning the public against infringement.

V. Recent IP Developments

Accession of Qatar to the Patent Cooperation Treaty (PCT)

The Director General of the World Intellectual Property Organization welcomed the deposit of the instrument of accession of Qatar to the Patent Cooperation Treaty on May 3, 2011. The said treaty will enter into force on August 3, 2011.

Qatar is now bound by the Treaty and consequently any "international" patent application may include the designation of Qatar under its country code "QA". Furthermore, nationals and residents of Qatar may file "international" patent applications under the Treaty. It is also worth noting that Qatar may be elected for the purpose of International preliminary examination, as it will be bound

by Chapter II of the Treaty. The instrument of accession, however, declares that pursuant to Article 64(5) of the Patent Cooperation Treaty, Qatar does not consider itself bound by the provisions of Article 59 of the Treaty. According to Article 59, any dispute between two or more countries of the Treaty concerning the interpretation or application of the Treaty or its regulations, not settled by negotiation, may, by any of the concerned countries, be brought before the International Court of Justice unless the countries concerned agree on some other method of settlement. Therefore, with regard to any dispute between Qatar and any other country of the Treaty, the provisions of Article 59 shall not apply.

The bottom line is that, the Qatari authorities must first amend the Patent law to include provisions related to national phase PCT applications and should complete the set up of the Patent Office in order to receive patent applications.

Registration of Arabic Domain Names

The Supreme Council of Information and Communication Technology ictQATAR announced the launch of the Qatar Domains Registry on March 2, 2011 following the decision of the Internet Corporation for Assigned Names and Numbers (ICANN) back in 2010 to allow for Internationalized Domain Names in non-Latin scripts.

The Sunrise phase for trademark owners is expected to begin very soon. All required documents, registration formalities and the exact dates of the Sunrise Period have not been released yet.

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