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## KUWAIT: FINAL GCC COUNTRY WITH PCT MEMBERSHIP

Kuwait 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 is expected to enter 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.

We expect further developments and news in this area that should clarify the direct benefits of Kuwait's accession to the PCT.



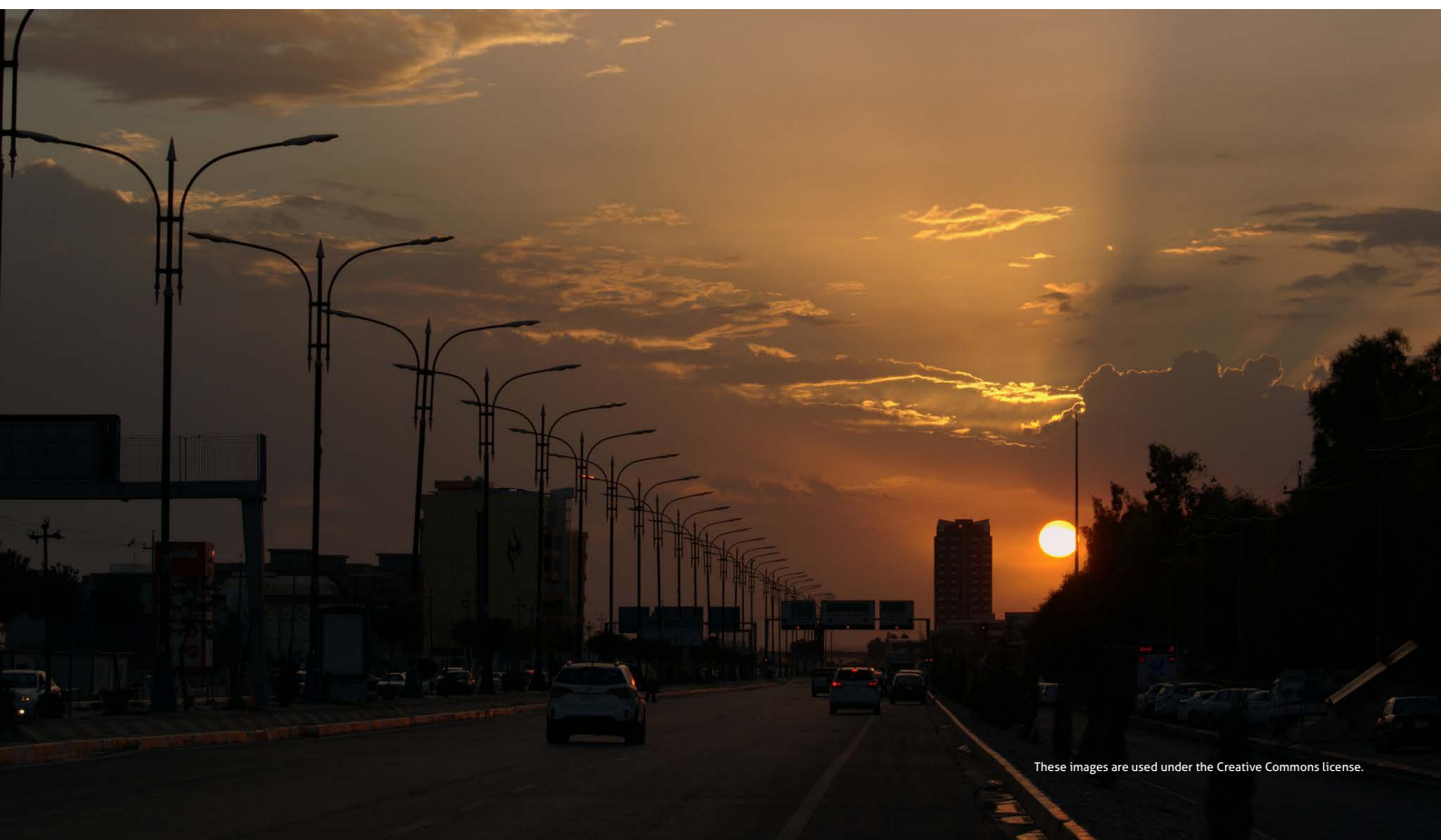
## IRAQ: FORMALITIES FOR CLASS 5 APPLICATIONS REVISED

Pursuant to an official notification issued by the Ministry of Health on April 3, 2016, which was addressed to the Industrial Property Office, a revised set of requirements for trademark applications in Class 5 (covering pharmaceutical and veterinary preparations and sanitary preparations for medical purposes) is now in effect. Under the new requirements, applicants are now required to provide the following information when filing an application in Class 5:

- International nonproprietary name;
- Name of manufacturer;
- Name of distributor; and
- Product label.

This will apply to all new as well as pending applications that have not yet been examined. After submission of the above information, the Industrial Property Office is expected to obtain the approval of the country's Ministry of Health before the underlying applications are examined. An application will be rejected on formal grounds if the applicant fails to provide all of the required information. It is still unclear whether the information must be provided at the time of filing or within a specified period of time from the filing date.

Syria is the only other country in the Arab region to impose filing requirements that are specific to Class 5 (certificate of origin and list of ingredients). For the remaining countries in the region, the process remains standard regardless of class.



## OMAN: NEW TRADE NAME REGULATIONS

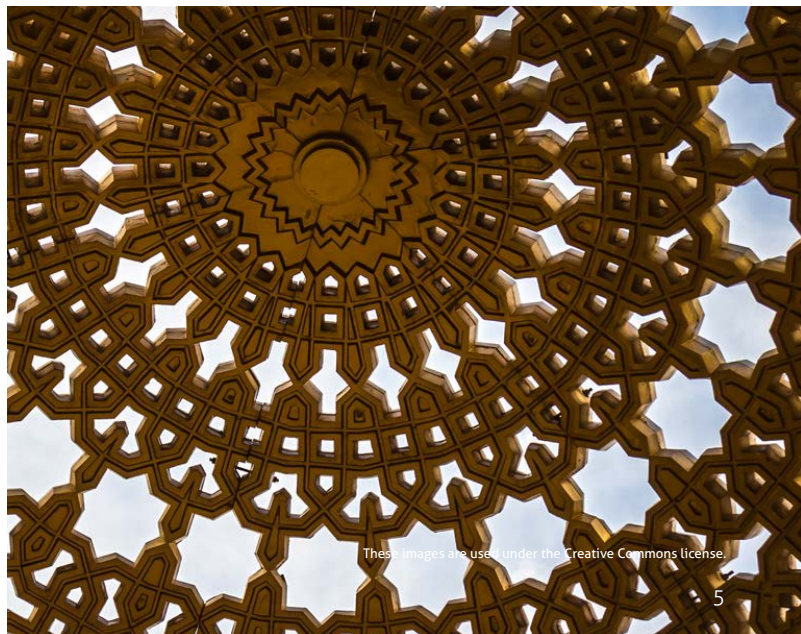
Pursuant to Ministerial Decision no. 124/2016, the Ministry of Commerce and Industry (MCI) in Oman now has the authority to cancel or ask the applicant to alter the registration of any trade name if it is similar to a registered trademark or any component of the trademark, or if it is similar to another trade name recognized nationally or internationally. Additionally, complaints against parties with trade names that infringe trademarks may now be filed at the MCI.



## SYRIA: INCREASE IN OFFICIAL FEES

Pursuant to Ministerial Decision no. 1171 of 2016, the official fees of trademarks and designs have increased in Syria. The new rates became effective as of May 22, 2016 and will be applied on all new as well as pending applications, including recordals.

We have absorbed the costs, in spite of the increase in fees, and our schedule of charges remains the same.



## MENA: NO SMOKESCREENS FOR BIG TOBACCO'S IP PROTECTION

The Middle East and North Africa (MENA) is a lucrative but competitive market for the tobacco industry, with cases fought over the tiniest elements of packaging. Global brands should familiarize themselves with the similarities – and differences – between local regimes before diving in. So what trademark issues specific to the MENA region should the tobacco companies be aware of when it comes to protecting their valuable trademarks?

### *Classification*

With tobacco companies venturing into the electronic cigarette market, obtaining the proper protection in this innovative industry is an aspect worth considering. While class 34 covers the goods for tobacco products, classes 9 and 11 cover goods for electronic cigarettes and vapor cigarettes.

No specific requirements are stipulated for the registration of trademarks in these three classes. Despite that, some trademark offices allow the filing of application claiming the whole class without specifying the particular goods. The TMOs will not object to the use of any of the class headings as being too indefinite and not specific.

Further restrictions are introduced by countries such as Jordan and Sudan. The applicant must specify the goods in the class or else the application will be rejected.

### *Slogans*

Unlike in common-law countries, tobacco brand owners in the MENA do not usually face significant difficulties in registering slogans. As United States and European authorities often refuse requests on the grounds that a slogan is purely descriptive of the products or services it promotes, or lacks distinctiveness, these types of trademark applications can easily pass examination on absolute grounds by most of the TMOs of our region—with some few exceptions including Iran—as long as the mark in question is not explicitly descriptive of the products involved. In fact, brand owners are often not required to prove that the slogan they wish to protect has acquired a secondary meaning on its own.

### *Plain Packaging*

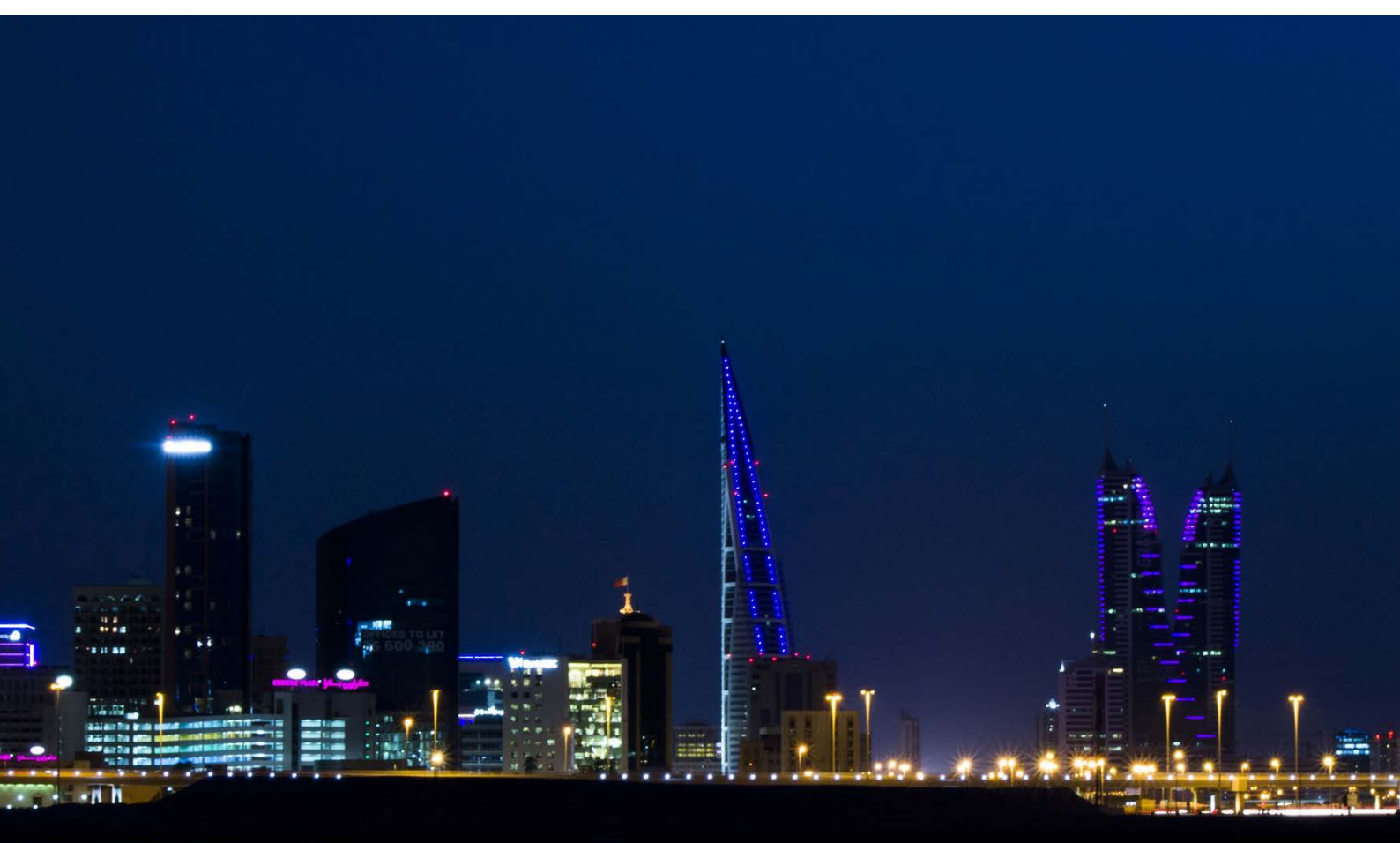
It will take some time, if any at all, for plain packaging to reach the MENA region. Hence, tobacco companies have more freedom in the MENA in terms of marketing and registering the products.



## *Two-Dimensional Trademarks*

In principle, when it comes to the TMOs of our region, it may be possible to register aspects of the shape of the product or its packaging as 2D trademarks. A 2D mark can receive similar protection under the laws of the region as any other trademark, and a simple trademark application can be filed for this purpose. In fact, trademark laws across the region are harmonized to a large extent, except for Lebanon and Morocco. In almost all the articles that define the absolute grounds of registration, the directives are equivalent in content and have to be interpreted in the same way, while the minor difference is in the scope only. In Saudi Arabia, for example, the scope is limited to what basically does not violate Sharia law.

Difficulty would basically arise at the time of substantive examination, where practice differs considerably between countries. In some countries, the application for a product shape as a trademark will be accepted without any objection as long as the product appearance has the requisite distinctive character for registration. In few other countries, a product shape will not be accepted as a trademark if the print includes no core word marks. The most probable reason is to maintain a balance between trademark laws and design laws, the latter being used to protect products having some patentable function.



## Search

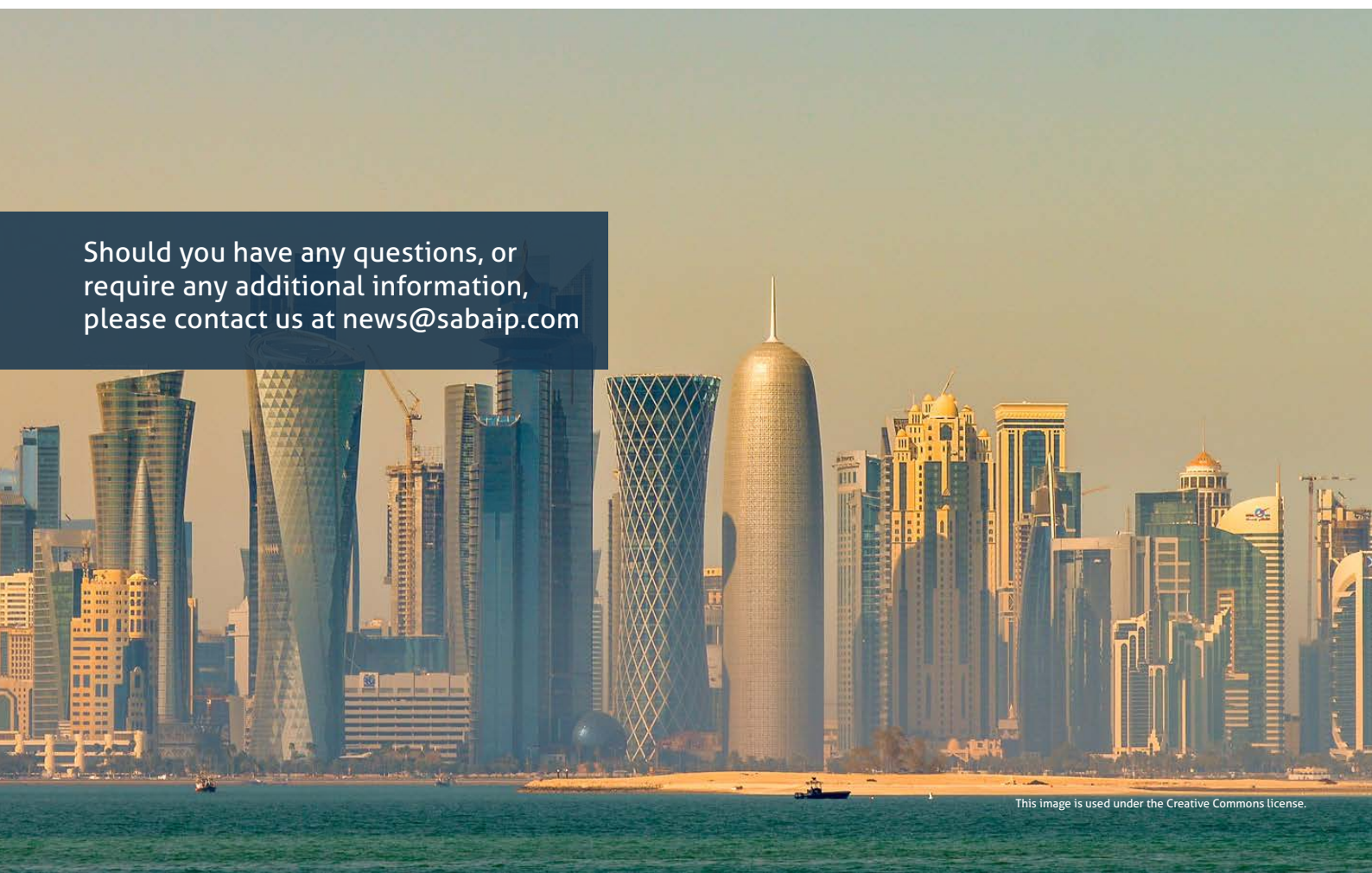
A typical clearance search at the TMO is possible in all countries of our region. Trademark search is a crucial step before registration, although not being a pre-requisite for any trademark application except for Iraq. Given that almost all countries of our region are civil law countries—meaning that the code typically exhaustively covers the complete system of the law—the principle of first-to-file is given considerable weight. This means that clearance at the TMO will in principle also mean clearance as to use in the marketplace.

## Use

Registration of marks is highly recommended and the mere registration can be a basis to sue an infringer, although the risks of a non-use cancellation action must be factored-in in any filing strategy. However, unlike the U.S., where a non-use cancellation action is similar to an opposition action in applicable law, the situation is not the same in the MENA. In most countries, non-use cancellation actions must be brought before the local Courts, which can greatly increase the time, costs and even predictability of such proceedings.

In short, protection of tobacco trademarks is a challenging and labor intensive process that requires special consideration and handling. Trademark owners must be able and ready to adopt a model that incorporates both legal as well as regulatory approaches in order to arrive at well-established trademark protection strategy. Needless to say, trademark owners should seek sound advice before they decide on the best route to pursue.

Should you have any questions, or require any additional information, please contact us at [news@sabaip.com](mailto:news@sabaip.com)



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