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UAE

Changes in the Examination Formalities

The UAE Trademark Office (TMO) has issued on May 19, 2014, Decision no. 3 of 2014 (to be implemented as of June 1st, 2014) stating that it will no longer issue pre-examination decisions or grant extensions of time during the trademark examination process. Only acceptances, conditional acceptances and rejections shall be issued in the country. In other words, the trademark applications will be either accepted, accepted under a condition or rejected, while examination will continue to be based on both absolute and relative grounds.

The difference between the current procedure and the new one is summarized in the following table:

Current procedure	New procedure
<p>The examiner issues pre-examination decisions requesting amendments or clarifications. Applicants can respond to the pre-examination decisions.</p> <p>Pre-examination decisions cover mainly the following three areas:</p>	<p>No pre-examination decisions can be issued and therefore applicants will no longer be able to respond to the examiner.</p> <p>The applicant may only appeal the decision or re-file a fresh application with the required amendments; the latter is recommended since appeals might take a long time.</p>
<p>1. The list of goods/services claimed.</p>	<p>1. Any discrepancies in the list of goods/services will result in a rejection decision; it is recommended to always claim class headings (as per the 10th edition of Nice classification which is adopted in the UAE).</p>
<p>2. The distinctiveness of the subject trademark.</p>	<p>2. Lack of distinctiveness will result in a rejection decision; it is recommended, when and if possible, to file as part of the application, evidence in support of the distinctiveness of the trademark, hoping that the examiner will consider the same during the examination.</p>
<p>3. The existence of prior rights.</p>	<p>3. Prior rights will result in a rejection decision; it is highly recommended to always clear the trademark before filing (by conducting both official and un-official searches) and in the event of existing prior rights, proper advice can be given on the best course of action to prevent rejection (i.e. submit along with the application evidence showing relationship between the owners – co-existence agreement – letter of consent etc...).</p>

Qatar

Revision of Formalities

The Qatari Trademark Office has recently announced that it is now required to have the priority document legalized. This means that certified priority documents will no longer be admissible in support of trademark applications.

Therefore, the filing requirements for a new trademark application are as follows:

A Power of attorney legalized up to Qatari Consulate. A general power may be used for subsequent filings.

A simple copy of the certificate of incorporation/extract from the commercial register/any document attesting to the legal entity, name and address of the applicant; no authentication is required. However, if the applicant is an individual, then a document evidencing that said person is practicing trade must be submitted alternatively.

A copy of the priority document, if priority is claimed, certified by the issuing authority and legalized up to Qatari Consulate. This document can be submitted within 6 months from filing date.

5 prints of the mark for each application. Electronic prints are acceptable.

Documents 1 and 2 must be submitted at the time of filing; an exception to this rule is when a priority deadline is imminent; in this case, the application can be filed only few days before the deadline while the documents in 1, 2 and 3 can be filed within 6 months from the filing date in Qatar.



Kuwait

Registration Certificates of Designs are Available Now

The Kuwaiti Patent Office has announced that it is now possible for applicants of design applications in the country to ask for the registration certificate of their designs.

By way of background, the Kuwaiti Patent Office has started publishing design applications in the country's Official Gazette for over a year now.

Applications are examined in the country as to form, local novelty, and industrial applicability. Examination is generally a systematic process whereby the Patent Office is expected to notify the applicant of any objections. The applicant is then required to respond with arguments and/or amendments to overcome the objections. Amendments and arguments may then be accepted or rejected, triggering further response, until a design is issued or the application is rejected and/or abandoned. Even though design applications accepted by the Patent Office are published in the Official Gazette, oppositions can only be filed before the Court. After publication, the certificate of registration will be issued upon request.

The main Features of Design Protection in Kuwait:

Protection Term: 10 years from filing date.

Applications with Multiple Figures: Admissible up to 50 figures.

Filing Requirements: (1) Power of Attorney, legalized, (2) 2 representations of the design, (3) Description of the design, (4) Certificate of incorporation, legalized, (5) Deed of assignment from the designer(s), legalized, (6) Copy of priority document, if priority is claimed, legalized.

All the documents may be submitted within 3 months from the filing date.

Renewal: For one term of 5 years.

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

Jordan

A New Regulation for Trademark Assignment

A New regulation on trademark assignment No. 55 of 2014 was recently introduced in Jordan. This regulation includes a list of articles related to trademark assignment, license and pledge. More details on how these new regulations will be applied will follow soon.



Oman

Seminar on Copyright and Related Rights Protection

The Intellectual Property Department in Oman organized in collaboration with the World Intellectual Property Organization (WIPO) a seminar aiming at strengthening copyright protection in the country. The two-day seminar was held on April 22, 2014 in the Ministry of Commerce and Industry. The main objective of this seminar is to raise awareness against any violation act. The rights of the authors were a key topic of discussion during the seminar in addition to the protection of audiovisual performance and software production.



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UAE and Yemen

Towards More Effective IP Protection...

Saba Offices in the UAE and Yemen have joined their efforts to seek more effective protection of Intellectual Property Rights in the region. They have collaboratively organized a training workshop that aims at combatting counterfeit trademarks. The workshop was held on April 15-16, 2014 in the UAE and was attended by various authorities from Yemen and UAE.

The main purpose of the workshop was to develop the collaboration between the private sector (brand owners) and the public sector (enforcement authorities) in combatting counterfeiting and fraudulent activities in the local markets.



IP HIGHLIGHTS

First to File Countries

Almost all countries of our region are civil law countries with the code typically exhaustively covering the complete system of the law. This being said, the first-to-file concept is given considerable weight. Despite the fact that some countries may offer a limited amount of common law rights, enforcement is relative and solely determined by the practitioner handling the case. Therefore, registration of marks in the Arab world 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 United States where a non-use cancellation action is similar to an opposition action in applicable law, the situation is not the same in the MENA region. In most countries, administrative procedures for cancelling a trademark are not available and so cancellation actions must be brought before the local Courts, which can greatly increase the time, costs and even predictability of such proceedings. Another issue is related to the burden of proof. In most countries in our region, the burden of proof in a cancellation proceeding will usually be on the plaintiff in order to prove that the registered trademark should not be registered. This of course renders non-use cancellation actions expensive since a negative must be proven, namely, that a mark is not in use.

In short, protection of trademarks in the Arab region is an important yet challenging process that requires special consideration and handling. Even more, there is no pan-Arab registration, similar to the Community trademark, which relatively complicates the registration procedures. Therefore, owners must be able and ready to adopt a model that incorporates both legal as well as regulatory approaches in order to arrive at a solid trademark protection strategy. Fortunately, the trademark laws across the region are harmonized to a large extent, except for few countries including 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 the Shari'a (Islamic) law. The difficulty would basically arise at the time of substantive examination, where practice differs between the countries. Needless to say, trademark owners should seek sound advice before they decide on the best route to pursue.

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The information contained in this newsletter is intended to provide a brief update of Intellectual Property news and should not be relied upon as legal advice. Legal or other professional counseling should be sought from the firm's Head Office in Beirut, Lebanon.

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