

SABA *bulletin*

November 2011 issue

In this issue

YEMEN UAE MOROCCO

New Regulations Implementing the Trademark and Industrial Design Laws	2
General Availability Phase	2
Anti-Counterfeiting Trade Agreement	3

IP CASES YEMEN

PROFENID vs. PRONID	3
---------------------	---

IP TABLES

I. Information Disclosure Statement	4
II. Recordal of Contractual Licenses	5

IP HIGHLIGHTS USTR Special 301 Report

6

YEMEN NEWS

NEW REGULATIONS IMPLEMENTING THE TRADEMARK AND INDUSTRIAL DESIGN LAWS

- Regulations Implementing the Trademark Law

The implementing regulations of Trademark Law no. 23 of 2010 in Yemen were issued on July 27, 2011, pursuant to Ministerial Decision no. 213 of 2011. The new salient features of these regulations include:

1. The 8th edition of the Nice classification is adopted with no local sub-classification.
2. Substantive examination will be completed within 30 days from the date of receipt of the application by the examiner.
3. Applications for renewal of trademarks will be published in the Official Gazette.
4. In the event that an owner of a trademark desires to secure provisional protection to a mark which is used on products or services displayed in national or international exhibitions held in the country, he shall notify the competent authority one month before the opening of the exhibition. The trademark's owner shall be granted a certificate of provisional protection of his trademark within a period that does not exceed 3 months after the end of the exhibition.
5. The Trademark Office will no

longer issue any certificates of renewal, change of name or change of address. Only official receipts to this effect will be granted to applicants attesting to any change of title. The Trademark Office will only issue the following certificates:

- Certificate of Registration
- Merger Recordal Certificate
- Assignment Recordal Certificate
- License Recordal Certificate
- Pledge Recordal Certificate

6. There is a grace period of 1 year for late renewals.

7. The registration number will remain the same as the filing number once an application matures to registration.

8. A new schedule of official fees is introduced. The fees have increased substantially in comparison with their current level.

- Regulations Implementing the Industrial Designs Law

The implementing regulations related to Industrial Designs Law No. 28 of 2010 in Yemen have recently been issued according to Ministerial Decision No. 212 of 2011 dated October 3, 2011. The main features of Law no. 28 include the following:

- A relative novelty bar exists. More specifically, disclosure of the invention without the knowledge or consent of the inventor shall not be taken into consideration if it occurred within the 6-month period preceding the filing date or priority date of the patent application.
- Design applications are published in the Official Gazette upon acceptance. Oppositions may be filed within 90 days from publication date.

- The protection term is extended to 10 years from filing date, instead of 5 years with a possibility to renew for 2 consecutive terms of 5 years each as per the provisions of the previous law. However, according to the new law, renewal is no longer possible. The implication of this is as follows: The remaining protection term of designs filed before the issuance of the regulations (that is, before October 3, 2011) will be calculated based on the 10 year protection period as defined by the new law.

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

UAE NEWS

GENERAL AVAILABILITY PHASE

The General Availability Phase for Arabic domain name registration will soon begin. It is the fourth phase of the registration process and it follows the Landrush phase (during which, auctioning may be possible in the event that more than one applicant applied for the same domain name).

The General Availability Phase includes all the domain names that were not requested in previous phases. This phase will be open for the public on a first-come, first-served basis. The registration is made through registrars accredited by the Domain Administration.

MOROCCO NEWS

ANTI-COUNTERFEITING TRADE AGREEMENT

The Moroccan Office of Industrial and Commercial Property (OMPIC) represented by its Director together with the Ambassador of Morocco in Japan signed the Anti-Counterfeiting Trade Agreement (ACTA) in Tokyo on October 1, 2011. It is worth noting that the signing ceremony also included the United States, Australia, Canada, Japan, New Zealand, Singapore, and South Korea. The ACTA is a proposed plurilateral agreement for the purpose of establishing international standards on intellectual property rights enforcement. The ACTA was developed by Japan and the United States in 2006, and Canada, the European Union and Switzerland joined the preliminary talks throughout the years 2006 and 2007. The scope of ACTA includes counterfeit goods, generic medicines and copyright infringement on the Internet. The official negotiations with Morocco began back in June 2008, with Australia, Mexico, New Zealand, the Republic of Korea and Singapore joining the talks. Article 39 of ACTA specifies that the agreement is open for signature until March 31st, 2013.

IP CASES

YEMEN *PROFENID vs. PRONID*

The Court of First Instance in Yemen ruled in favor of Aventis Pharma SA, owner of trademark PROFENID in class 5 (registration number 29239), against Modern Pharmaceutical Company (a Yemeni company) for registering trademark PRONID in the same class.

The Court found that the registration of trademark PRONID presents an imitation of a famous trademark, causing damage to the interests of Aventis Pharma SA and leading to unfair competition. In fact, the registration of trademark PRONID violates the provisions of Article 89 of Trademark Law No. 19 of 1994 of the Yemeni Industrial Property Law which reads as follows:

A mark should be substantially distinguished from other marks. Accordingly, the following shall not be accepted for registration:

- 1. A mark similar to a mark filed or registered to the benefit of a third party, or if it is after that filed by a third party which has special priority for similar products or services.*
- 2. A mark similar to an unregistered mark previously used by others in Yemen for similar products or services, if the use of the mark required to be registered results in confusion for the public.*
- 3. A mark which is fully or partially identical with a famous mark or a well-known commercial name, or if it is an imitation or a translation of such mark or name, so that the use of the mark required to be registered will result in confusing the public.*

In light of the foregoing findings, the Court ordered the defendant to:

1. Cancel Registrar's decision no. 77 which accepted trademark PRONID and record the cancellation of the offending trademark;
2. Cease any further use of the offending mark;
3. Bear all Court expenses.

IP TABLES

I. INFORMATION DISCLOSURE STATEMENT

This section addresses the submission requirements of an information disclosure statement (IDS) across the countries of our region. Typically, an IDS refers to a submission of relevant background art or information to the Patent Offices by an applicant for a patent during the patent examination process. The IDS may include any published material which is relevant to the invention disclosed in the applicant's own patent application, irrespective of the country or language in which the published material was made (such as other issued patents, published patent applications, scientific journal articles, books and magazine articles). The only countries from our region that require an IDS submission are Bahrain and Egypt. In the UAE, IDS has to be stated in the preamble of the specification, but it does not need to be in the form of a declaration.

COUNTRY	IS INFORMATION DISCLOSURE STATEMENT (IDS) A REQUIREMENT DURING PATENT EXAMINATION?
Algeria	No- Patent applications are examined in Algeria as to form only.
Bahrain	Yes
Cyprus	No
Egypt	No - The Examiner may require the submission of some specific information at a later stage of the examination.
GCC	The submission of IDS is optional
Iran	No
Iraq	No
Jordan	No
Lebanon	No
Kuwait	No
Morocco	No
Oman	No
Saudi Arabia	No
Sudan	No
Syria	No
Tunisia	No
UAE	IDS is not required to be filed separately in the form of a Declaration but it is required to be stated in the preamble of the specification.
Yemen	No

II. RECORDAL OF CONTRACTUAL LICENSES

The patent laws of some Arab countries permit the granting of contractual licenses from the patent owner to another party. A patent license in essence allows the owner of a patent to give permission to another party to sell, use, make, or import the invention. The table below lists the basic information on the recordal of contractual licensing across the countries of our region.

COUNTRY	IS IT POSSIBLE TO RECORD A CONTRACTUAL LICENSE WITH RESPECT TO PATENTS?	WHAT ARE THE DOCUMENTS REQUIRED FOR SUCH A RECORDAL?
Algeria	Yes	Power of attorney, simply signed; and license agreement with French translation, legalized.
Bahrain	Yes	Power of attorney, legalized; and license agreement, legalized.
Egypt	Yes	Power of attorney, legalized; license agreement, legalized and certificate of incorporation of licensee, legalized.
GCC	Yes	Power of attorney, legalized; license agreement, legalized and certificate of incorporation of licensee, legalized.
Jordan	Yes	Power of attorney, legalized; license agreement, legalized with Arabic translation; copy of certificate of incorporation of the licensee, certified, with Arabic translation.
Lebanon	Yes	Power of attorney, simply signed; and license agreement, legalized.
Morocco	Yes	Power of attorney, simply signed; and license agreement, notarized.
Oman	Yes	No formalities adopted yet.
Saudi Arabia	Yes	Power of attorney, legalized; and license agreement, legalized.
Syria	Yes	Power of attorney, legalized; and license agreement, legalized.
Tunisia	Yes	Power of attorney, simply signed; and certified copy of license agreement, notarized, with simple French or Arabic translation.
UAE	Yes (Only for patents filed by Saba & Co - TMP / UAE Office, otherwise a change of representative must be filed).	Power of attorney, legalized; extract from the commercial register of the licensee, legalized; and license agreement, legalized.
Yemen	Yes	Power of attorney, legalized (one power for each party); and license agreement, legalized (with English translation) specifying the area and term thereof.



IP HIGHLIGHTS

USTR SPECIAL 301 REPORT

The Office of the United States Trade Representatives (USTR) has issued its annual Special 301 Report on the protection and enforcement of Intellectual Property Rights (IPR) on May 2, 2011. The Report includes policies that address the issues of IPR enforcement and the challenges of copyright piracy over the internet.

In the 2011 review, a new initiative was announced inviting trading partners appearing on the previously assigned lists to negotiate a mutually agreed action plan aiming at removing that trading partner from the lists.

In this review, the Arab countries that are listed on the Priority Watch List and on the Watch List remain the same. Egypt, Kuwait and Lebanon are still on the Watch List despite the continuous efforts exerted by these countries in order to address the issues related to intellectual property rights protection. Algeria is the only Arab country on the Priority Watch List for this year. According to the Special 301 USTR Report, these countries should protect public health and promote the patent system by encouraging creativity and innovation.

The Saba Network

HEAD OFFICE

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327448
Fax: +961 (1) 331531
E-Mail: headoffice@sabaip.com

ALGERIA

Cabinet Boukrami
In cooperation with Saba & Co. IP
PO Box 86 Algiers, Algeria
Tel: +213 (21) 34 11 61
Fax: +213 (21) 34 11 62
E-Mail: algeria@sabaip.com

BAHRAIN

P.O. Box 21013, Manama
Tel : +973 (17) 210 301
Fax : +973 (17) 224 699
E-Mail: bahrain@sabaip.com

CYPRUS

P.O. Box 21143, 1502 Nicosia
Tel: +357 (22) 755 434
Fax: +357 (22) 754 037
E-Mail: cyprus@sabaip.com

EGYPT

P.O. Box 129, Mohamed Farid, Cairo
Tel: + 20 (2) 279 59686
Fax: + 20 (2) 279 52314
E-Mail: info@sabaip-eg.com

GAZA

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: gaza@sabaip.com

IRAQ

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: iraq@sabaip.com

JORDAN

P.O. Box 840553, Amman 11184
Tel : +962 (6) 464 2145
Fax: +962 (6) 464 2159
E-Mail: jordan@sabaip.com

KUWAIT

P.O. Box 1245, 13013 Safat
Tel: +965 2 242 3428
Fax: +965 2 240 2243
E-Mail: kuwait@sabaip.com

LEBANON

P.O. Box 119420-, Beirut
Tel : +961 (1) 327 439
Fax: +961 (1) 334 434
E-Mail: lebanon@sabaip.com

LIBYA

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: libya@sabaip.com

MOROCCO

P.O. Box 13 921, Casablanca
Tel : +212 (522) 251 530
Fax: +212 (22) 251 603
E-Mail: morocco@sabaip.com

OMAN

P.O.Box 2027 Ruwi,
Postal Code 112 Muscat
Tel: +968 248 111 26
Fax: +968 248 111 28
E-Mail: oman@sabaip.com

QATAR

P.O. Box 14035, Doha
Tel: +974 (4) 4423992
Fax: +974 (4) 324 106
E-Mail: qatar@sabaip.com

SAUDI ARABIA

Al Hadaf Marks Services LLC
In Cooperation with Saba & Co. IP
P.O. Box 61145, Riyadh 11565,
Saudi Arabia
Tel. +966 1 2079596
Fax +966 1 2079598
E-Mail: saudi@sabaip.com

SUDAN

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: sudan@sabaip.com

SYRIA

P.O. Box 460, Damascus
Tel: +963 (11) 223 6628
Fax: +963 (11) 222 6280
E-Mail: syria@sabaip.com

TUNISIA

P.O. Box 119421- Beirut, Lebanon
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: tunisia@sabaip.com

UNITED ARAB EMIRATES

P.O. Box 42259, Dubai
Tel: +971 (4) 2959 650
Fax: +971 (4) 2959 651
E-Mail: uae@sabaip.com

WEST BANK

P.O. Box 119421- Beirut, Lebanon*
Tel: +961 (1) 327 448
Fax: +961 (1) 331 531
E-Mail: westbank@sabaip.com

YEMEN

P.O. Box 1493, Sana'a
Tel: +967 (1) 420 595
Fax: +967 (1) 420 596
E-Mail: yemen@sabaip.com

* All mail should be dispatched to the Head Office address in Lebanon for proper channeling.

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.

© 2011 Saba & Co. IP – No article in this publication or part thereof may be reproduced without prior permission and full acknowledgment of the source: SABA IP Bulletin, A publication of Saba & Co. IP, Trademark & Patent Agents & Attorneys with branch offices in the Middle East and North Africa.