

**Act No. 23 of the Year A.D. 2010
relating to Trademarks and Geographical Indications**

In the name of the people.

The President of the Republic,

having examined the Constitution of the Republic of Yemen, and with the agreement of Parliament.

has issued the following Act:

**Chapter One
Name and Definitions**

Article 1

This Act shall be known as the "Trademarks and Geographical Indications Act".

Article 2

For the purposes of applying the provisions of this Act, the following words and expressions shall have the meanings given below, unless the context requires a different meaning:

The Republic:	The Republic of Yemen
The Minister:	The Minister of Industry and Trade
The Ministry:	The Ministry of Industry and Trade
The Regulations:	The Regulations implementing this Act
The competent Administration:	The general Administration within the Ministry with the function of protecting intellectual property
The Registrar:	The Director-General of the Administration
The Tribunal:	The competent commercial Tribunal

Article 3

A trademark is anything of distinctive form which is visible to the eye, including names, words, letters, numbers, signatures, drawings, symbols, seals, pictures or embossment, or a particular arrangement of colour or set of colours, or any group of these features, if used or intended to be used to distinguish the products or services of a commercial, industrial, agricultural, professional or service enterprise.

**Chapter Two
Trademarks
Section I**

Conditions and Procedures for Registration

Article 4

The following may not be registered as a trademark or as an element of a trademark:

1. Marks with no distinguishing feature.
2. Marks which violate morals or public security.
3. Marks which match or resemble symbols of a religious nature.

4. Marks consisting of indications or information imposed by the nature or function of the goods or services in question, or consisting of signs that have become the prevalent appellation of those products or services.
5. Marks composed of mottos, flags or other symbols specific to the Republic, other States or regional or international organisations.
6. Marks which include descriptive or propagandistic words, or any term suggesting that the product or service for which a registered trademark has been requested enjoys any special prerogative.
7. The name or image of a third party without that party's prior agreement to its use.
8. Marks containing a deceptive trade name.
9. Marks which match, resemble or are translations of a known trade name.

Article 5

A trademark must be intrinsically distinguishable from other marks. The following shall not be registered as trademarks:

1. Marks which match or resemble a mark previously recorded in the Register of Trademarks, as regards the products and services themselves or products and services closely associated with them, or which resemble them to a degree that may lead to ambiguity or confusion.
2. Marks which match or resemble a mark not previously registered but used by other parties in the Republic for products or services that are similar to a degree that may lead to ambiguity or confusion.

Article 6

It is forbidden to register marks which match, resemble or are translations of a trademark which is famous in the Republic for similar products or services, even if the famous trademark is not registered in the Republic. The same applies to famous trademarks registered in the Republic for products or services that do not match or resemble the products or services for which a registered mark has been requested, if that registration would lead people to believe that a link existed between those products and services and the famous trademark, or if it would cause damage to the holder of the famous trademark. In order to determine whether or not a particular trademark is famous consideration must be given to the level of awareness thereof among the relevant public, including how well-known it is within the Republic as a result of being promoted and marketed.

Article 7

The party who registers a trademark shall be considered to own it so long as he uses it during the five years following the registration. If it is proven that another party used the trademark first, that party has the right to appeal to the Tribunal against the validity of the registration, during the five years following that registration. An appeal against the validity of the registration of the trademark may be made without a time limit if it is proven that the registration was accompanied by bad faith.

Article 8

The request for registration of the trademark shall be presented to the Registrar in writing. The Regulations explain what information must be included in the request, the way it is to be entered in the registers of the competent Administration, as well as the rules, procedures and deadlines for the request to be examined and a decision taken thereon.

Article 9

The Registrar shall issue a decision, either accepting or rejecting the request to register the trademark, or accepting it on condition that certain modifications are made to the trademark for the sake of clarity and to avoid ambiguities with other trademarks which are under the protection of this Act.

Article 10

If the Registrar makes a decision to reject the request for registration of the trademark, or to accept it on condition that the mark be modified, that decision must include reasons. It falls to the competent Administration to inform the applicant of the decision in writing.

Article 11

If within thirty days of being informed of the Registrar's decision under article 9 of this Act, the applicant does not respond to a decision that the trademark must be modified, or lodge a complaint against a decision to reject it, he is deemed to have relinquished the request for registration.

Article 12

The party applying to register the trademark can, within thirty days of being informed of the decision taken by the Registrar under article 9 of this Act, lodge a complaint against that decision before a Committee created for that purpose by the Minister. The rules and procedures for implementing this article are defined in the Regulations. The complainant can also appeal to the Tribunal against the decision of the Committee, within thirty days of being informed thereof.

Article 13

If the request for registration of the trademark is accepted, the competent Administration shall undertake to announce as much, using means of mass communication as defined in the Regulations.

Article 14

Any interested party can present a written objection to the Registrar concerning an announced request for the registration of a trademark. The objection must include reasons and be presented within ninety days of the date of the announcement of the request pursuant to article 13 of this Act. The competent Administration shall supply the applicant with a copy of the objection, and it is up to the applicant to respond in writing within thirty days of the date of receiving notification thereof, otherwise he is deemed to have relinquished the request for registration.

Article 15

The Registrar shall issue a decision, including reasons, either accepting or rejecting an objection presented within the legal deadlines against a request for registration of a mark.

Article 16

The applicant making the request for registration and the party objecting thereto both have the right to appeal to the Tribunal against the decision made by the Registrar under article 15 of this Act, within thirty days of their being informed of that decision. An appeal against a decision to reject the objection shall not halt the registration procedure, unless the Tribunal decides otherwise.

Article 17

The applicant making the request to register the trademark is granted a period of twelve months from the conclusion of the objection period defined in article 14 of this Act, if no objection against the request to register the mark has been lodged, or from the date of issue of a final decision concerning the objection, in order to complete the registration procedures, otherwise he is deemed to have relinquished the request for registration.

Article 18

A register, called the "Trademarks Register", shall be kept by the competent Authority, wherein shall be recorded all information relative to trademarks, as well as any changes, cessions, transfers, hypothecations, permits to use the mark, renewals, annulments, or any other actions specified in this Act.

Article 19

The registration of the trademark shall have effect from the date of the payment of the fees for filing the registration request. The holder of the trademark shall be given a certificate of registration containing the information defined by the Regulations, and the registration shall be made public by the same means of communication as those stipulated under article 13 of this Act.

Article 20

It is incumbent upon the holder of the registered trademark to present a request to the competent Administration to record any changes to his name, nationality or address, in accordance with the procedures stipulated in the Regulations.

Article 21

All interested parties, having paid the necessary fees, have the right to obtain an extract of the information and entries recorded in the Trademarks Register.

Section II Effects of Registration

Article 22

Registration of a trademark brings the following consequences:

1. Protection of the mark for a period of ten years from the date of payment of the fees for filing the registration request. This protection is renewable for one or more similar periods if the holder so desires.
2. The holder's right to use the registered mark. The holder has exclusive right to prevent other parties who have not obtained his consent from making commercial use of matching or similar marks for goods or services that match or resemble the ones for which the trademark was registered, when such use could result in misleading or confusing the public

Article 23

The trademark holder's right to prevent others from importing, using, selling or distributing products incorporating that mark, shall expire if the holder markets those products in another State or licenses another party to do so.

Section III

Renewal

Article 24

- (a) During the tenth year of the protection period the Administration shall, via the means of communication defined in article 13 of this Act, inform the holder of the mark of the deadline for its renewal. It is up to the holder of the registered trademark, having paid the prescribed fees, to apply to the Registrar to renew the mark within a year from the end of the protection period. If that deadline passes the competent administration shall cancel the mark from the register.
- (b) The renewal or cancellation of the mark is published by the means of communication defined in article 13 of this Act.

Section IV

Transfer, Hypothecation and Licences

Article 25

- (a) Ownership of the registered trademark may be transferred or hypothecated, either with or without the commercial premises or facilities which use the mark to distinguish their goods or services, in accordance with the rules and procedures defined in the Regulations, so long as this does not mislead or confuse the public, especially as concerns the nature or origin of the products or services.
- (b) If the ownership of the commercial premises or facilities is transferred without the trademark, the owner of the mark may continue to use it for the products or services for which it was registered, unless the parties agree otherwise.
- (c) The contract transferring ownership of the mark must be made in writing and certified by the competent authorities.
- (d) The contract transferring or hypothecating the mark shall have no effect, and cannot be used as evidence against others, until recorded in the Trademarks Register and made public via the means of communication defined in the Regulations.

Article 26

- (a) The holder of the trademark may license a third party to use that mark for all or some of the goods or services for which the mark was registered. At the same time, he may use the mark himself, unless the parties agree otherwise. The licence period shall not exceed the period stipulated for the protection of the mark.
- (b) The licensing contract must be made in writing and certified by the competent authorities.
- (c) The licensee may not cede the licence to a third party, or grant sublicenses, unless the licensing contract explicitly grants him the right to do so.

Article 27

A licensing contract to use a registered trademark must include the following:

1. A definition of the geographical area within which the goods or services displaying that trademark can be marketed.
2. The prescribed period of the licence.
3. A commitment on the part of the licensee to avoid any action which could degrade the products or services identified by the mark.
4. The conditions guaranteeing the holder of the mark the possibility to oversee the quality of the products identified by the licensed mark, without entering into the management or production thereof.
5. An agreement that the licensee shall avoid any actions which could result in harm to the trademark.

Article 28

The holder of the trademark, or the licensee, shall forward a request to the competent Administration to record the licence to use the mark. The licence shall have no effect until recorded in the Trademarks Register and made public via the means of communication defined in the Regulations.

Article 29

- (a) The holder of the trademark, or the licensee, may forward a request to the competent Administration to cancel the record of the licence from the Trademarks Register. Evidence of the expiry or termination of the licensing contract must be annexed to the request.
- (b) Before cancelling the record of the licence, the competent Administration shall inform the other party of the request to do so, and the other party may object to the request for cancellation. The Regulations define the conditions and procedures for cancelling the record of a licence.
- (c) The cancellation of a license shall be made public via the means of communication defined in the Regulations.

Section V Cancellation and Invalidity

Article 30

- (a) The holder of a registered trademark may request the Registrar to cancel the registration of the mark from the Trademarks Register, for either all or some of the goods or services for which that mark was registered. The request for cancellation is to be presented in accordance with the conditions and procedures stipulated in the Regulations.
- (b) All interested parties may request the Tribunal to rule that the registration of a trademark is invalid, if such registration was contrary to the provisions of this Act or to the Regulations. The competent Administration shall undertake to cancel the registration when presented with a definitive legal ruling to that effect.
- (c) All interested parties may request the Tribunal to cancel a registered trademark if the holder of that mark ceases to use it for a period of at least five consecutive years. The Tribunal may accede to that request unless the holder of the trademark presents a justification for not using it.

Article 31

If the registration of a trademark is cancelled due to its not having been renewed, that mark may not be reregistered in the interests of another party for the same products or services, or for products or services resembling them, until three years have passed since the cancellation.

Chapter Three Geographical Indications

Article 32

Geographical indications means those indications which identify the origin of a particular product in a location or area, either within the Republic or within a State which is a member of an international agreement on intellectual property to which the Republic is a party, or which has relations of reciprocity with the Republic, when the quality, reputation or other characteristics affecting the promotion of that product are fundamentally associated with its geographical origin.

In order for such indications to enjoy the protection of this Act, they must be protected in their country of origin.

Article 33

No one who trades in a particular product may attribute geographical indications thereto which mislead the public by claiming that it comes from an area particularly famous for producing that product.

Article 34

It is forbidden to use any means to name or present a product so as to suggest, in a way that misleads the public, that it originates from a geographical area other than that of its true origin.

Article 35

Anyone who produces a product in an area particularly famous for the production of that product may not place a geographical indication on similar merchandise he produces in other areas which suggests that that merchandise was produced in the area famous for producing the abovementioned product.

Article 36

Certain products may be ascribed geographical names which, through commercial custom, have come to indicate a product's genre rather than its geographical origin.

Article 37

In order to register a trademark which includes a geographical indication, the product concerned must be continuously produced by the party applying for the registration in that famous geographical area.

Article 38

A trademark that includes a geographical indication may not be registered if its use may mislead the public concerning the real origin of the product concerned.

Article 39

A trademark that includes a geographical indication may be registered if the right to that mark was earned by using it in good faith before the date this Act came into force, or before the geographical indication was granted protection in the country of origin.

Article 40

All interested parties may request the Tribunal to ban the use of a geographical indication included in a registered trademark, if such use could mislead the public regarding the true origin of the product in question.

Chapter Four Temporary Measures

Article 41

(a) The holder of a trademark may at any time, even before filing a case before the Tribunal, by means of a petition accompanied by an official certificate proving the mark has been registered, request the Tribunal to issue an order for precautionary measures to be taken, in particular the following:

1. The preparation of an inventory and a detailed description of the machines and tools that are or were being used in any of the violations described in this Act, as well as of the products, goods, addresses of premises, envelopes, letterheads, etc., which may bear the trademark in question.
2. The seizure of the items mentioned under clause (a) paragraph 1 of this article, on condition that they are not seized until after the party requesting the seizure has deposited a monetary surety which a preliminary evaluation of the Tribunal considers sufficient to compensate, if necessary, the party whose goods are seized. Following the seizure, the sufficiency of the monetary surety deposited by the party requesting the seizure may be disputed in accordance with current legislation.

(b) The Tribunal's order for the precautionary seizure may include the designation of one or more experts to assist the official responsible for carrying out the precautionary measures.

Article 42

The precautionary measures under article 41 of this Act will be considered null and void unless followed, within eight days of the date of the seizure, by the filing of a case against the party against whom those measures were taken.

Article 43

The party whose goods have been seized may present the Tribunal with a claim for compensation against the party who applied for the seizure within ninety days of the expiry of the term stipulated under article 42 of this Act, if that term has passed and the applicant for the seizure has filed no case, or from the date of issue of final judgement in the case. In both these circumstances the monetary surety shall not be returned to the party requesting the seizure until a definitive judicial judgement has been issued in the compensation case against him, or until the expiry of the specified term with no compensation claim having been made, unless the judgment issued in the applicant's case resolves the issue of the monetary surety.

Article 44

(a) The holder of a registered trademark may, by means of a petition, request the Tribunal to issue an order stopping the Customs Department from releasing imported or exported goods which bear counterfeited or forged marks. The Tribunal can issue an order blocking the release of those goods once the holder of the mark has presented the following:

1. Sufficient evidence of the existence of an evident violation of the holder's rights.
2. A detailed description of the offending goods.
3. A monetary surety evaluated by the Tribunal as sufficient to protect the rights of the defendant and to prevent the misuse of rights.

(b) The Tribunal shall inform both the party requesting the stoppage, and the defendant, of its decision to block the goods mentioned in clause (a) of this article.

(c) The Customs Department may not release the blocked goods except by order of the Tribunal which issued the decision, or after ten days from the issue of the decision regarding the goods mentioned in clause (a) of this article if the party in whose interest the order was issued has not brought a legal case against the defendant. The Tribunal may extend the stoppage on the release of the goods for a further ten days, if circumstances require.

(d) The Tribunal shall give the holder of the trademark and the importer of the goods the opportunity to examine the goods held at the Customs Department, in order to prove or refute the claim.

(e) The Tribunal may order that the importer of the blocked goods be appropriately compensated for any damages caused to him by their erroneous seizure. The compensation shall be paid from the monetary surety deposited with the Tribunal. The remainder of the surety shall be returned to the party who requested the impounding of the goods or, if the monetary surety is not sufficient to cover the compensation, he shall be compelled to pay an additional sum.

Article 45

(a) The Tribunal may take any of the measures described in article 44 of this Act, by way of precaution and without informing the other party, in circumstances in which delaying those measures could damage the rightful party or lead to a loss of evidence proving the violation. The party against whom the measures have been taken shall be informed immediately after they have been implemented. In this case, the party against whom the measures have been taken may request the Tribunal to convene a sitting to hear his account, in the light of which the Tribunal may confirm, amend or cancel the precautionary measures.

(b) The Tribunal may, if necessary, order the violator to inform the rightful party of the identity of others who participated in the production and distribution of the goods bearing the counterfeited trademark, and the distribution channels, unless this is not in keeping with the gravity of the violation. The competent authorities may, if necessary and once a judgement has been issued in the case, inform the rightful party of the names and addresses of the supplier, the importer and the recipient of the goods, and the quantity of goods involved in the violation.

Article 46

Small quantities of goods of a non-commercial nature contained in the personal effects of travellers or in small postal packages are exempt from the provisions of articles 44 and 45 of this Act.

Chapter Five Penalties

Article 47

Without detriment to any more severe penalty laid down by another law, imprisonment of up to two years and/or a fine of up to 1 million rial shall be imposed upon anyone who:

- (a) Forges or counterfeits a registered trademark protected by this Act.
- (b) Uses, in bad faith, a forged or counterfeited trademark.
- (c) Uses, in bad faith, a trademark which is the property of another.
- (d) Presents, offers or uses services bearing a forged or counterfeited trademark.
- (e) Sells, puts on sale, or possesses with the intention of selling, products which he knows bear a forged, counterfeited or unwarranted trademark.

If any of the offences described in this article is repeated the penalty shall be redoubled and the offending premises shall be closed for a period of up to three months.

Article 48

Anyone violating any other provision of this Act shall be punished by a fine of up to 500,000 rial.

Article 49

The Tribunal may, depending on the gravity of the offence, impose one or more of the following supplementary penalties on the offender:

- (a) Confiscate the seized goods bearing a counterfeited or forged trademark, dispose of them outside commercial channels and, if necessary, destroy them.
- (b) Destroy the counterfeited or forged trademarks.
- (c) Confiscate machines and equipment used to falsify or counterfeit the trademark, dispose of them outside commercial channels and, if necessary, destroy them.
- (d) Refuse to allow the re-exportation of the goods bearing a counterfeited or forged industrial trademark, unless a change is made to the mark.
- (e) Publish the judgement in one or more newspapers at the expense of the guilty party.

Article 50

Anyone who has suffered damages as a result of any of the offences stipulated in articles 47 and 48 of this Act may file a case before the Tribunal demanding compensation from the perpetrators.

Chapter Six General and Concluding Provisions

Article 51

Natural or juridical persons who undertake to inspect or examine particular goods or services vis-à-vis their source, the elements of which they are made, their method of production, their quality, essence, or any other characteristic may, by decision of the Minister, obtain permission to register a joint mark to indicate that such inspection or examination has been effected for the public good. In this case, the ownership of such a mark cannot be transferred except with the permission of the Minister. The registration of this joint mark has all the effects stipulated in this Act.

Article 52

Temporary protection is granted to trademarks placed on products exhibited at national or international trade fairs which take place in the Republic. Such temporary protection shall not lead to an extension of the period of protection stipulated under article 22 of the this Act. The Regulations define the conditions and procedures for granting such protection.

Article 53

Any natural or juridical person, whether Yemeni or foreigner, who chooses to base their effective activities in the Republic, or in a State or entity which is linked to the Republic by an international agreement on intellectual property or which has relations of reciprocity with the Republic, has the right to request the registration of a trademark in accordance with the provisions of this Act.

Article 54

Right of priority in requesting the registration of a trademark is granted to the party who files a request before the competent Administration within six months of filing a request for registration before the competent authorities in a member State of the Paris Convention for the Protection of Industrial Property. In this case, the date of registration in the Republic is considered as being the date of presentation of the request to register the trademark in the other country.

Article 55

- (a) Officials of the competent Administration, appointed by decision of the Prosecutor General following a proposal from the Minister, shall have the status of law-enforcement officers.
- (b) The law-enforcement officers mentioned in clause (a) of this article may, during working hours, enter and search any premises and warehouses used to sell, distribute or produce goods bearing counterfeited trademarks or geographical indications. They shall establish the facts behind any violations described in this Act, and seize and impound the materials and means used in committing those violations; in case of need, they can request the assistance of security personnel.
- (c) The competent authorities and official personnel responsible for implementing the provisions of this Act, shall be exempt from criminal proceedings arising from actions taken in the context of enforcing the Act, if the Tribunal establishes that those actions were taken in good faith.

Article 56

It is the task of the Tribunal to examine all cases and disputes arising from the implementation of the provisions of this Act.

Article 57

The fees prescribed for the services stipulated in this Act shall be set by decision of the Council of Ministers, following a proposal from the Minister, on condition that 20 per cent of those fees be allocated as an incentive for the officials of the competent Administration and for technical support to develop and modernise business requirements.

Article 58

A decision on the rules regulating the protection of local geographical indications shall be issued by the Council of Ministers, following a proposal from the Minister and in coordination with other parties concerned.

Article 59

The Regulations implementing this Act shall be issued by decision of the Prime Minister, having obtained the agreement of the Council of Ministers.

Article 60

The provisions relating to industrial and trademarks contained in Presidential Decree No. 19 of the Year A.D. 1994 in respect of Intellectual Property, and everything which violates the provisions of this Act, shall be cancelled.

Article 61

This Act shall be published in the Official Gazette and will come into force after three months from the date of its issue.

**Issued by the Presidency of the Republic in Sana'a
on 15 Dhu al-Hijjah A.H. 1431 (21 November A.D. 2010)**

Ali Abdullah Saleh

President of the Republic