

SABA
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IRAN | US SANCTIONS AND IP RIGHTS



In light of the recent decision to withdraw from the Joint Comprehensive Plan of Action, informally known as the Iran Deal, the United States is expected to begin reimposing certain sanctions on Iran. These sanctions, however, include a waiver that allows the protection and enforcement of intellectual property rights in Iran.

The provision, which may be found in Title 31 of the U.S. Code of Federal Regulations, § 560.509, stipulates that certain transactions related to patents, trademarks, and copyrights are authorized. This means that, even with the US sanctions reimposed, the following transactions are permitted in Iran:

- the filing and prosecution of any application to obtain a patent, trademark, or other form of IP protection;
- the receipt of a patent, trademark, or other form of IP protection;
- the renewal or maintenance of a patent, trademark, or other form of IP protection;
- the filing and prosecution of oppositions or infringement proceedings with respect to a patent, trademark, or other form of IP right, or actions taken to defend such proceedings;
- the payment of fees due to the Iranian government; and
- the payment of fees and charges to attorneys.

With this in mind, rights holders who wish to ensure that they have suitable protection in place in Iran can take proactive steps, which include:

- reviewing and assessing their existing trademark portfolio in the country in order to ensure that their portfolio management strategies are aligned with the overall business strategy; and
- investigating the Iranian market in order to identify potential infringements of IP rights so that enforcement action can be taken.

IRAN | UPDATES ON PATENT ANNUITIES AND PATENT TERM EXPIRATION —



Recently, and after much deliberation, the Iranian Intellectual Property Office issued a decision concerning the calculation of annuities and patent term expiration.

According to the new decision, the following will apply:

- For new patent applications entered in Iran via PCT on or after May 30, 2018, the annuities due at the time of filing will include the back annuities accumulated in the international stage. The annuity payments following the nationalization of an application will become due on the anniversary date of the international application.
- For granted and pending applications as of May 30, 2018, the correct annuity payments should be settled at the next expected date to bring the annuity year to be in line with the international filing date.
 - o For granted patents filed via PCT, there is no indication that the Letters Patent will be reissued with the correct expiration date. It is mandatory to correct the annuity year by attending to the necessary payments at the next upcoming annuity date. In most cases, two annuity year payments will have to be settled simultaneously, and the records updated to reflect the next due date to be that of the anniversary of the international filing.
 - o For pending applications filed via PCT, it is preferable to correct the annuity year by attending to the necessary payments at the next upcoming annuity date. In most cases, two annuity year payments will have to be settled simultaneously, and the records updated to reflect the next due date to be that of the anniversary of the international filing. The IIPO will allow for the settlement of any missed annuity payment at the time of registration of a patent, without late fees.

Although this update in regulations will cause a certain amount of confusion in the beginning, in the long term, this practice will be in alignment with general procedures relating to worldwide PCT national filings. This will certainly streamline applicants' databases to ensure adequate and timely settlement of annuities for particular patent families.

UAE | TRADEMARK RENEWALS GOING ONLINE



Trademark renewals may be submitted electronically at the Trademark Office in the United Arab Emirates as of June 26, 2018.

The new process involves uploading the supporting documents to the online system, along with a renewal announcement in two local newspapers. The certificate will then be issued instantaneously, which significantly speeds up the renewal process.

It is worth noting that the publication in official gazette will occur on later stage after the issuance of the renewal certificate.

Renewal of Trademarks in the UAE:

- Protection Period: 10 years from filing date and renewable for like periods
- Filing Requirements: Legalized POA and a simple copy of the certificate of registration
- What you need to know: Grace period of 3 months

UAE

LEBANON | REVISED PROCEDURES FOR THE RECORDAL OF ASSIGNMENTS AND MERGERS

LEBANON

The Trademark Office in Lebanon introduced revised procedures related to the recordal of assignments and mergers.

Effective June 29, 2018, applicants must submit the original certificate of registration along with the application for the recordal of an assignment and/or merger as an additional documentary requirement. The TMO will then issue a new certificate, instead of a simple declaration. It remains unclear whether the certificate will be issued in the name of the assignee or the new entity following the merger, or if it will list the details of the recordal as an endorsement while keeping the name of the first owner. Upon the completion of the recordal of an assignment and/or merger, the original certificate of registration will not be returned.

It is worth noting that the application for the recordal of assignment and/or merger will not be processed in the event that the original certificate of registration is not submitted. Owners who do not have the original certificate may not be able to complete the recordal for the time being. Moreover, obtaining a certified copy is not a possible alternative given the absence of an archiving system at the TMO. Given these facts, further discussions are being held at the TMO to examine all possible options and solutions.



YEMEN | TMO REITERATES THAT CLASS HEADINGS ARE NO LONGER ACCEPTABLE



YEMEN

The Trademark Office in Yemen reiterated that claiming class headings is not possible, as it recently stated in Ministerial Resolution no. 72 of 2018. Applicants are unable to file an application claiming the whole class without specifying the particular goods or services.

In other words, the actual language of the goods or services specified in the registration will define the parameters of the scope of protection of a registration.

Moreover, this decision applies to all new applications. As for pending and not accepted applications, an office action is expected to be issued at the time of examination in case the list of goods or services claimed requires modification.

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