

# INTELLECTUAL PROPERTY BULLETIN

January 2019

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## SAUDI ARABIA | PLANS TO ADOPT PLAIN PACKAGING FOR TOBACCO PRODUCTS

# SAUDI ARABIA

Saudi Arabia notified the World Trade Organization of it plans to adopt plain packaging of tobacco products. The proposal, which was filed on September 12, 2018 and reviewed by the authorities concerned at the WTO, was accompanied by a draft regulation titled "Plain Packaging Standards of Tobacco Products."

While Saudi Arabia did not disclose when it would introduce the new rules, we expect it to become the first country in the Gulf Cooperation Council, and the Middle East at large, to do so. Additionally, the WTO, as one of the proponents of plain packaging as a measure to discourage people from taking up tobacco use, is expected to be strongly in favor of the adoption of plain packaging in Saudi Arabia.



## BAHRAIN | PATENTS AND UTILITY MODELS IMPLEMENTING REGULATIONS PUBLISHED



# BAHRAIN

**On December 13, 2018, following the recent decision to begin substantive examination of pending and new patent applications, the Patent Office in Bahrain issued the Implementing Regulations of Law no. 1 of 2004 concerning patents and utility models. The long-awaited Implementing Regulations are expected to pave the way to a clearer patent procurement process. With the publication of the Implementing Regulations, the Patent Office updated all the official fees relating to patent prosecution, and introduced examination fees.**

The Implementing Regulations confirm the present procedures in Bahrain. As such, the filing requirements are a power of attorney with Apostille certification and a copy of the international publication, with the international search report - if it is published. The protection term is 20 years from the international filing date, and annuities must be paid on the anniversary of the international filing date and payable after grant. A grace period of six months for late payment is observed.

## JORDAN | MOVING TO THE CLOUD

# JORDAN

**Given Jordan's unremitting commitment to the protection of intellectual property, the Patent and Trademark Office began receiving and processing all applications in electronic format as of January 1, 2019.**

In this regard, the PTO has been holding training sessions, and Saba IP was selected to participate and present to the audience on various aspects relating to the benefits and challenges of implementing an electronic platform.

For the time being, applications are filed both electronically and physically at the PTO and will exclusively transition to e-filing by the beginning of next year.





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



**The Middle East and North Africa is a lucrative, yet extremely competitive market for the tobacco industry, with cases fought over the most minuscule 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 Trademark Offices will not object to the use of any of the class headings as being too indefinite and not specific. Further restrictions are introduced by certain countries in the region, such as Jordan, Saudi Arabia, Sudan, and the United Arab Emirates. 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 the authorities concerned in the United States and European Union 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 in the MENA region – with a 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, with the exception of Saudi Arabia as discussed in the aforementioned article. Hence, tobacco companies have more freedom in the MENA in terms of marketing and registering the products for the time being.

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

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### Three-Dimensional Trademarks

In principle, when it comes to the TMOs in the MENA region, it may be possible to register aspects of the shape of the product or its packaging as 3D trademarks. A 3D 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 MENA 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.





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

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### Search

A typical clearance search at the TMO is possible in all countries and jurisdictions in the MENA 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 in the MENA 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 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, 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.



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