

BULLETIN

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JORDAN

Update on Patent Annuities

SAUDI ARABIA

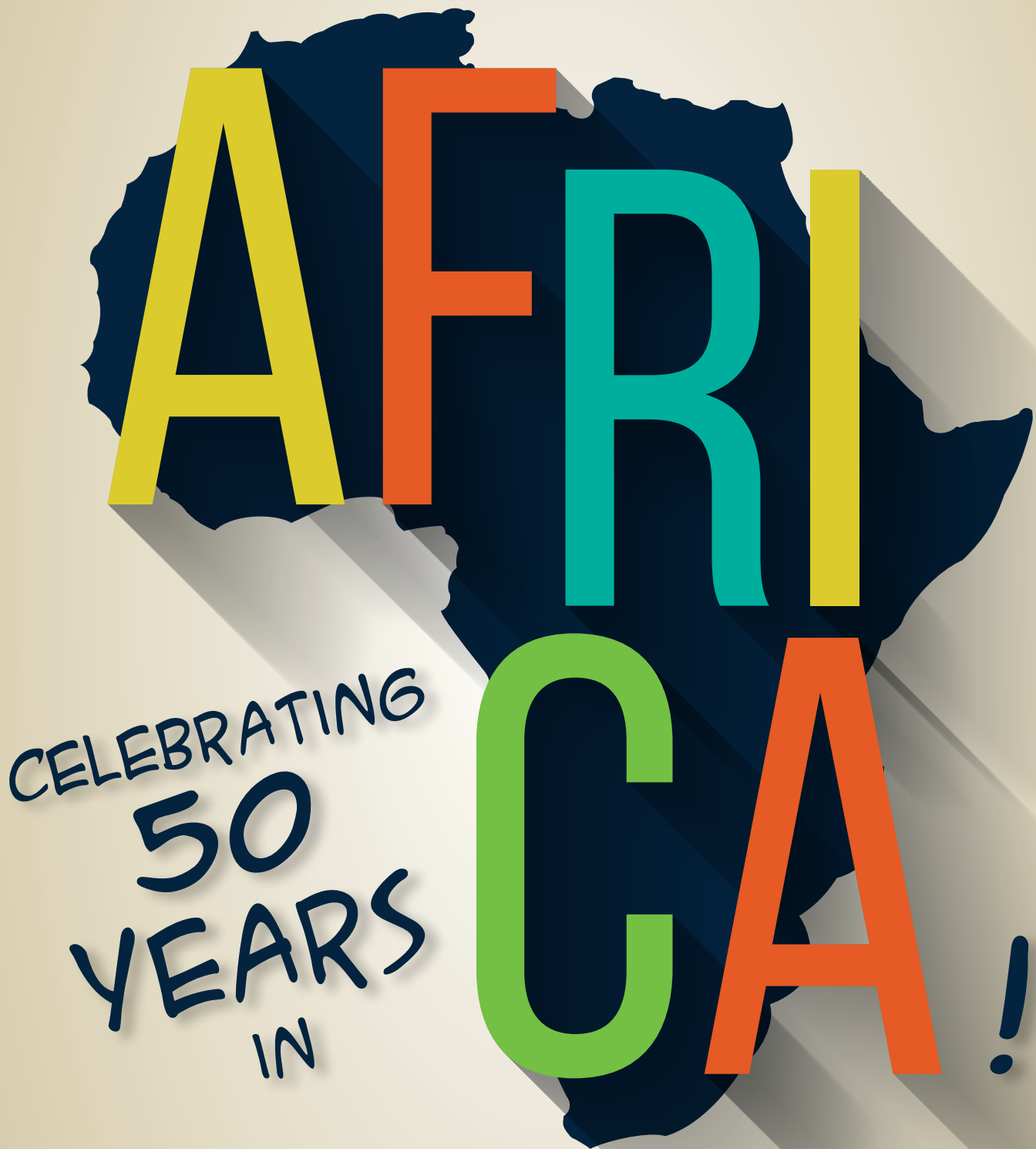
What You Need To Know About
Trademark Registration

TANZANIA

Country Insights

MENA

USTR 301 Special Report



JORDAN | UPDATE ON PATENT ANNUITIES

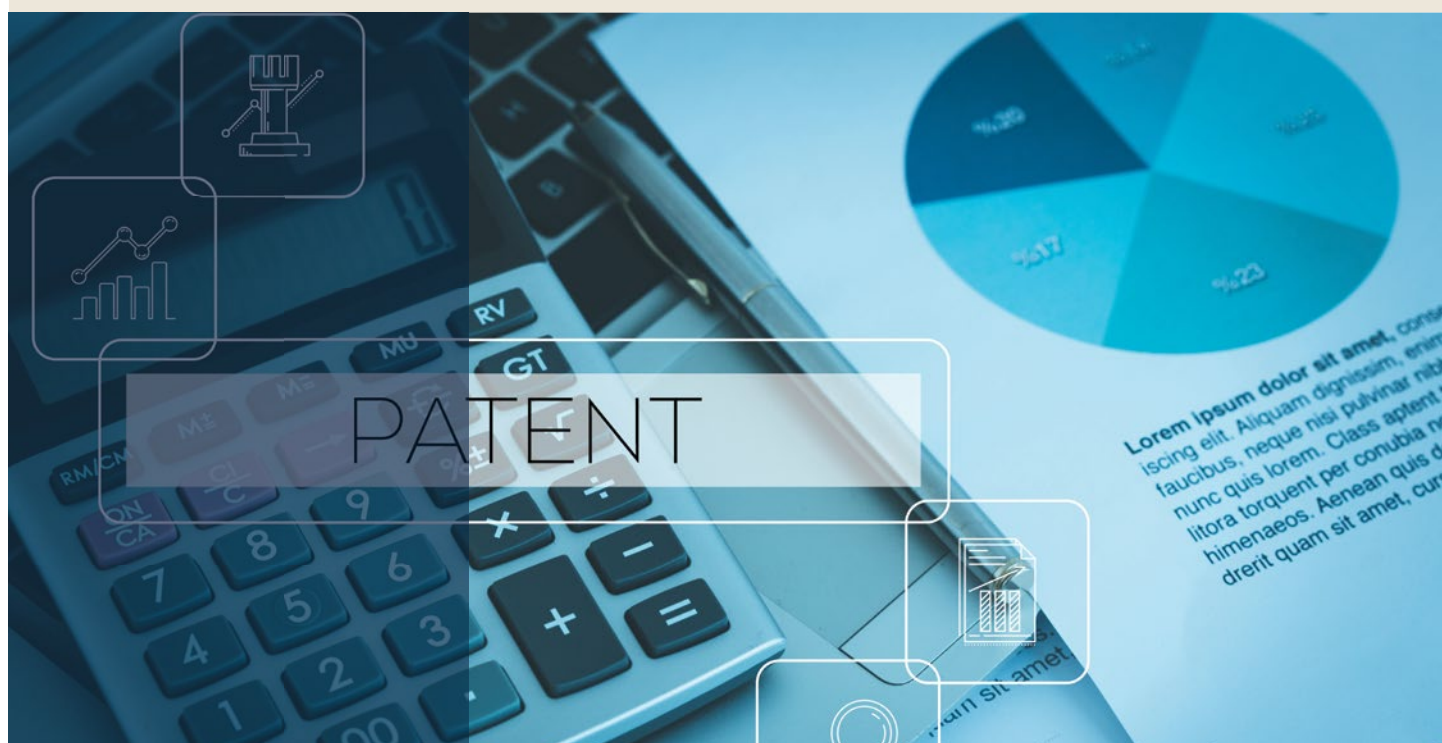
JORDAN

The Patent Office in Jordan recently issued a decision relating to the management of patent annuities.

For patent applications entered in Jordan via PCT on or after April 22, 2019, annuities due at the time of national filing will include the back annuities accumulated in the international stage. With this new practice, annuities will become due annually prior to grant with the international filing date as the base date.

As for applications filed in accordance to the Paris Convention, annuities may be paid annually while an application is pending (optional), where the base date is the national filing date.

With the adoption of these new maintenance regulations, the system becomes aligned with generally acceptable practices for patent filings made in Jordan via both the Convention and the PCT systems.



SAUDI ARABIA | WHAT YOU NEED TO KNOW ABOUT TRADEMARK REGISTRATION



Saudi Arabia is located at the convergence of Europe, Asia, and Africa and occupies a regional location of strategic and economic importance for global trade routes and transnational business expansions. And with the status as the world's largest exporter of petroleum and the country's relentless commitment to promote a robust economic diversification program, Saudi Arabia is an important market for international brand owners to consider.

In its ongoing endeavors to protect intellectual property, and more specifically trademarks, Saudi Arabia adopted the Gulf Cooperation Council Trademark Law. The GCC Trademark Law stipulates a set of provisions that are applied uniformly across all the GCC countries (mainly Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and the United Arab Emirates) in regards to the prosecution and enforcement of trademark rights. It is worth noting that the GCC Trademark Law does not offer a unitary registration system similar to the European trademark registration, and the Trademark Offices of each GCC country will remain as the receiving office. Accordingly, the Saudi TMO is responsible for receiving all applications for the registration of trademarks in Saudi Arabia.

In the following feature, we will be addressing important considerations brand owners must be aware of before registering a trademark in Saudi Arabia.

Classification

Saudi Arabia adopts the 10th edition of the International Nice Classification. An applicant for a trademark registration can only select from the list of goods/services preapproved on the e-platform. With this setup, applications with an item that is not explicitly listed on the platform will not be properly docketed into the system, which would result in considerable delays. Applicants should carefully account for this especially when faced with approaching deadlines, such as a Convention priority deadline.

Although many specifications are not accurately or completely covered by a pre-approved description, a custom written description is not an option for applicants.

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SAUDI ARABIA | WHAT YOU NEED TO KNOW ABOUT TRADEMARK REGISTRATION



The procedure at the TMO allows the applicant to (1) file for class headings, (2) claim class heading in combination with all the items in the class, (3) claim class heading in combination with specific items from the Nice Classification, and (4) claim specific items of the Nice Classification.

Examination

An important aspect to keep in mind when considering an expansion into Saudi Arabia is that it is a first-to-file country that follows civil law.

The TMO examines the application on both absolute and relative grounds. Following the stipulations set forth in Article 12 of the GCC Trademark Law, which allow the authorities concerned to impose the restrictions and changes it deems necessary to determine and clarify the trademark in a way preventing its confusion with another mark already registered or for any other reason it deems expedient, the TMO allows for one chance to amend the application if: (1) a conflicting mark is cited, (2) the mark is considered descriptive or generic, (3) is deemed to be not registrable according to the list of exclusionary subject matter in Article 3 of the GCC Trademark Law, or (4) there is a condition to put a disclaimer on certain descriptive terms.

Trademark Oppositions

Once a trademark is accepted it is published on the online Official Gazette, usually on the same day of acceptance, and may be opposed by any interested third party with grounds for an opposition. The opposition period is 60 days from the publication date. Requests for extending the opposition period are not possible in Saudi Arabia.

Within the 30-day period of filing an opposition, the TMO will provide a copy of the opposition statement to the applicant for submission of a written reply within 60 days, as per the GCC Trademark Law. Hearings may also be conducted upon a request filed by either party to the opposition provided that the official fees are paid by the party requesting the hearing.

The committee's decision can be appealed by the aggrieved party to the Board of Grievances within a 30-day period from the date of notification.

SAUDI ARABIA | WHAT YOU NEED TO KNOW ABOUT TRADEMARK REGISTRATION



The decision of the Board of Grievances can be further appealed before the Court of Appeal.

An opposition can be filed on the basis of legal justification, which can be earlier registered trademark rights or an earlier pending application in Saudi Arabia. Oppositions can also be filed on the basis of rights established by unregistered well-known marks having fame in Saudi Arabia. Other than earlier conflicting registered trademarks or applications, it is also possible to file an opposition proceeding on the basis of any legal provisions that prohibit registration of certain marks in the country.

Since Saudi Arabia is a first-to-file country, as aforementioned above, the party administering the opposition cannot require the opponent to provide proof of use of the earlier registered mark that is the basis of the opposition. In order to challenge use, the applicant must file for a separate non-use cancellation proceeding. It is worth noting that opposition proceedings will not be interrupted pending the issuance of a decision in the cancellation proceeding and vice versa.

Even if prior rights are not established in Saudi Arabia, an opposition can still be filed based on the fame of the trademark, as aforementioned above. Defining the parameters of what constitutes a famous trademark are determined in sub-paragraph (2) of Article (4) of the aforementioned GCC Trademark law which are matched with the international standards for the protection of well-known trademarks, in particular, standards that are listed in Article 6bis of the Paris Convention. Any probative evidence will be accepted, and a determination will be based on the totality of the evidence, including such factors as (1) the duration and geographic extent of sales; (2) sales figures; (3) advertising figures and samples of advertising; (4) awards, reviews, and press reports; (5) the reputation of the mark within the relevant trade and consumer groups in the country; and (6) expert testimony and surveys designed to assess the recognition of brand names.

SAUDI ARABIA | WHAT YOU NEED TO KNOW ABOUT TRADEMARK REGISTRATION



Procedure and Withdrawal

Should the owner of the opposed mark fail to submit a counter-statement, the application is dismissed. Withdrawal of an opposition by the applicant terminates the proceeding and an official notification is issued by the TMO attesting the withdrawal. It is a common practice for both parties to come to a settlement agreement regarding use of the trademark, however. Based on the evidence filed by each party, or, in some cases, also based on an oral hearing, the TMO issues a decision regarding the grant of the pending trademark.

Protection Period

The protection period of a trademark is for 10 Hijri years (approximately 9 years and 8 months). To maintain registration, the registrant shall file renewal during the last year of expiry. There is a six-month grace period, with an additional fee payable as penalty. After the six-month grace period, the trademark will be declared cancelled and further renewals will not be possible. An expired mark cannot be registered in favor of any third party for a period of three years post expiry or cancellation, however.

Cancellation

It is possible to register a trademark in Saudi Arabia without actually using it. However, trademark registrations in Saudi Arabia may be vulnerable to cancellation in the event of non-use within a period of five consecutive years. It is therefore highly recommended that trademark rights be maintained through actual use in Saudi Arabia in order to circumvent any possible non-use cancellation proceeding.

Apart from dealing with the intricacies of legal proceedings in a non-use cancellation proceeding, it will be of vital importance to establish valid and genuine use in Saudi Arabia. The trademark in question must be directly used by the sale of goods bearing the mark or rendering of services under the mark, as the case may be. Other standards of use are available but are not clearly defined by the authorities concerned in Saudi Arabia. The use required by the GCC Trademark Law is use that is for the purpose of distinguishing the goods and services.

SAUDI ARABIA | WHAT YOU NEED TO KNOW ABOUT TRADEMARK REGISTRATION



Marking

Marking is not compulsory in Saudi Arabia. However, using the ™ or ® symbol on a trademark is highly advisable given that the lawful use of the symbols will signify and give notice to the public about the owners' rights, i.e. whether the mark is registered or pending registration at the TMO.

The ™ symbol implies that a mark is in use in Saudi Arabia but is not registered yet at the TMO. On the other hand, the ® symbol signifies that the mark has been successfully registered at the Saudi TMO. It is worth noting that the registration of the mark in any other TMO within the GCC region does not count. The illegitimate use of the ® symbol may be treated as fraudulent marking in Saudi Arabia. It is therefore advisable that the ® symbol must be used exclusively with trademarks that are actually registered at the TMO.

In Conclusion

Along with the adoption of the GCC Trademark Law, the establishment of the new Saudi Authority for Intellectual Property marked a watershed moment in Saudi Arabia's era of innovation and development. Saudi Arabia is increasingly offering better protection for brand owners and the local legal environment seems to be maturing in the right direction. We expect Saudi Arabia to keep fostering such initiatives and this will undoubtedly stimulate the knowledge economy and enhance foreign investment in Saudi Arabia.

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TANZANIA | COUNTRY INSIGHTS

TANZANIA

With interminable shores along the Indian Ocean and a total area of 947,303 square kilometers, Tanzania is the largest country in East Africa occupying an unrivaled regional role that is increasing in significance. Due to its vast natural resources, Tanzania has achieved high growth rates and is experiencing stable economic development.

Tanzania encourages foreign investment, given that the financial sector has expanded in recent years and foreign-owned banks account for about 48 percent of the banking industry's total assets. The annual GDP growth averaged seven percent due to good performance in the services sector. The GDP is US\$150.3 billion, while the GDP per capita is US\$3,100. The GDP composition is 24.5 percent for agriculture, 27.6 percent for industry, and 47.3 percent for services.

Tanzania maintains legislations for the protection of trademarks, patents, designs, and copyright. In addition to being a signatory to the TRIPS Agreement, Tanzania observes the WIPO Convention, and the Paris Convention. Furthermore, Tanzania is also a party to the Agreement on the Creation of the African Regional Industrial Property Organization and the Harare Protocol.

Two trademark offices operate in Tanzania, one is located in the mainland and the other is in Zanzibar, and registration in the mainland does not extend to Zanzibar. In mainland Tanzania, matters pertaining to trademarks are governed by the Trade and Service Marks Act of 1986. As for Zanzibar, trademark matters are governed by the local Industrial Property Act of 2008 and local Industrial Property Regulations of 2014 that provide parallel frameworks with the mainland through which trademarks are applied and upon meeting the statutory requirements registration is granted by the TMO in Zanzibar.



TANZANIA | COUNTRY INSIGHTS



TANZANIA

Trademarks are registered in mainland Tanzania and Zanzibar in accordance with the 10th edition of the Nice Classification, and a single application cannot include several classes. Provisions apply for the registration of collective marks and certification marks, and examination on relative grounds is not performed.

Protection of a trademark in the mainland is for a period of seven years from filing date and is renewable for an indefinite period of 10 years. As for Zanzibar, the first registration period is 10 years, which can be renewed indefinitely for a duration of seven years. However, it is worth mentioning that the duration of registration for a trade or service mark registered under ARIPO system designating mainland Tanzania is 10 years and is renewable for an indefinite period of 10 years.

On the patents front, Tanzania acceded to the Patent Cooperation Treaty in 1999. It is worth noting that Zanzibar does not have the capacity to enter into international agreements on its own, and international agreements-including the PCT-are specified as union matters under the constitution. Accordingly, Zanzibar is bound by the PCT.

Foreign patent applications in mainland Tanzania and Zanzibar may be filed claiming 12 month Convention priority or entered as national stage via PCT within 30 months from the earliest claimed priority.

TANZANIA | COUNTRY INSIGHTS

TANZANIA

Furthermore, it is also possible for a patent to be obtained by an ARIPO-PCT application. In line with expected PCT Rules, patents are protected for a period of 20 years from the international filing date. Annuities in mainland Tanzania and Zanzibar are due annually on the anniversary of the international filing date and payable as of nationalization of the application.

In more recent developments, the Patent and Trademark Offices in mainland Tanzania announced that trademark applications and patent applications may be submitted electronically as of January 2018. In addition to registration, renewals and transactions such as assignments, licenses, and changes of name or address may also be filed online. Accordingly, the new process involves uploading an electronic application to the online system, along with soft copies of the power of attorney and priority document.

Tanzania remains a country with high aspirations that welcomes foreign investments. A healthy balance between the latter and local development is bound to be beneficial for the country's own growth. The proper application and enforcement of IP laws should help Tanzania become more of an innovative hub in East Africa and lead to this required healthy financial balance.



MENA | USTR 301 SPECIAL REPORT



MENA

The Office of the United States Trade Representative published the Special 301 Report on April 25, 2019, reviewing global developments on trade and intellectual property. The MENA countries on the Priority Watch List are Algeria, Kuwait, and Saudi Arabia. The Watch List includes Egypt, Lebanon, and the United Arab Emirates.

These countries do in fact maintain strong IP laws and are making efforts to improve intellectual property rights protection and enforcement. Furthermore, Algeria, Egypt, Kuwait, Lebanon, Saudi Arabia, and the UAE are expected to increase bilateral engagement with USTR to address IP concerns. Such initiatives imply that there is a profound commitment to IP, which will undoubtedly increase and foster the global incentives for research and investment in these countries, and the region as a whole.

The Special 301 Report is prepared annually by the Office of the United States Trade Representative under Section 301 as amended of the Trade Act of 1974.

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