

January 2020



Happy New Year

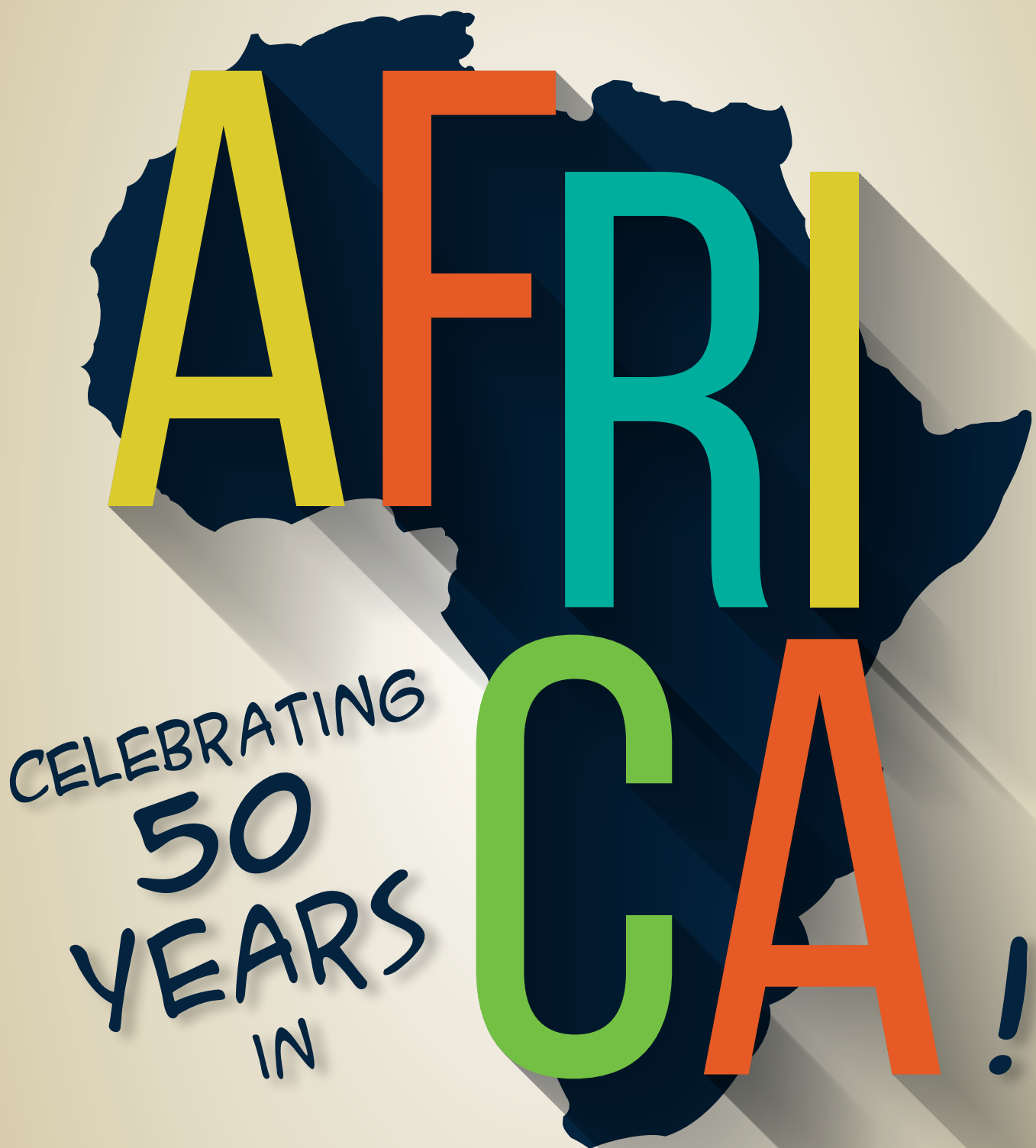
GCC
Council Approves the Trademark Law

SAUDI ARABIA
Copycats Beware, Copyright
Protection is in Town

EGYPT
Major Strides on the Litigation Scene

No GOEIC-ing Around for
Counterfeiters

MIDDLE EAST AND NORTH AFRICA
Rising Challenges in Patent
Prosecution in the Region



GCC | COUNCIL APPROVES THE TRADEMARK LAW



The Gulf Cooperation Council approved the Trademark Law during the annual summit in Riyadh, Saudi Arabia on December 10, 2019.

This update follows the Council's decision to assign the GCC Financial and Economic Committee the task to accredit and implement the necessary decisions related to the joint action in the field of customs union, including the amendments of the unified tariff, added value, selective tax, joint stock market, and combat of harmful practices in international trade.

By way of background, the GCC states, namely, Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and the United Arab Emirates, have been involved in the coordination of intellectual property since the late '80s. The GCC Trademark Law, which was issued in 2006 and revised in 2014, stipulates a set of provisions that apply uniformly across all the GCC in regards to the prosecution and enforcement of trademark rights.

The definition of a trademark has significantly expanded, given the adoption of the GCC Trademark Law by the member states. Article 2 of the Law includes color marks, sound marks, and smell marks as trademarks, suggesting that it will be possible to secure registrations of such marks across the GCC.

Furthermore, multiclass applications are allowed under the GCC Trademark Law. It is worth noting that in practice, however, multiclass applications are still not implemented and left entirely to the discretion of each GCC country. The registration requirements have also been updated and now include a provision for foreign words, which entails providing certified translations of the word or phrase and an indication on how to pronounce it in Arabic, as per Article 4 of the Implementing Regulations.

The examination process is harmonized now, with applications being examined within 90 days from the date of submission. The Trademark Office will then notify the applicant of the decision.



GCC | COUNCIL APPROVES THE TRADEMARK LAW



There is a 90 day period to respond to office actions from the date of notification before the application is considered abandoned.

Other features of the GCC Trademark Law are:

1. Claim of priority, based on an earlier-filed foreign application, is possible
2. Trademark applications accepted by the Registrar will be published for opposition purposes. Oppositions must be filed within 60 days from publication date
3. Trademark registrations are valid for 10 years from filing date and are renewable for like periods. There is a grace period of six months for late renewals
4. A trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of five consecutive years after registration
5. The Law recognizes famous trademarks that are well-known in the GCC member states and shall ensure protection thereof even if the marks are not registered
6. The Law gives the right to trademark owners to initiate civil and criminal actions against any infringing party. Penalties include a maximum of five year imprisonment and payment of fines of up to US\$270,000

GCC . SAUDI ARABIA . EGYPT . MIDDLE EAST AND NORTH AFRICA

SAUDI ARABIA | COPYCATS BEWARE, COPYRIGHT PROTECTION IS IN TOWN



In an effort to encourage the creation of art and culture, the Saudi Authority for Intellectual Property announced the launch of the online optional registration service for copyrights in Saudi Arabia.

This comes after the Implementing Regulations of the Copyright Law entered into force on December 23, 2019, which confirm the present procedures in Saudi Arabia. As such, the Law grants authors and artists the exclusive right to make and sell copies of their works, the right to create derivative works, and the right to perform or display their works publicly.

It is worth noting that copyright protection in Saudi Arabia extends to computer software and architectural works (e.g., buildings themselves as well as blueprints, drawings, diagrams, and models).

COPYRIGHT PROTECTION FRAMEWORK IN SAUDI ARABIA

Member of Berne Convention and TRIPS Agreement

Yes

Registration

Possible for nationals as well as foreigners

Filing Requirements

1. Power of attorney, legalized
2. Copy of the work of art

Duration

The life of the author plus an additional 50 years

SAUDI
ARABIA

EGYPT | MAJOR STRIDES ON THE LITIGATION SCENE

As a much welcomed attempt at improving the litigation scene in the country, Egypt recently ratified Law No. 146 of 2019 that amends provisions related to Law No. 120 of 2008.

The new Law amends the Economic Court Law of 2008, which established eight Economic Courts all over Egypt since October 2008. These Courts have a jurisdiction over criminal and civil cases stemming from investment operations, consumer protection, commercial, and banking transactions. The new Law, which stipulates the establishment of an electronic platform for the filing of cases among other updates, is a welcome addition to the enforcement arsenal of brand owners.

The new Law underscores the Egyptian authorities' intention to create a space for litigants to settle disputes amicably. In this regard, the Law inaugurates a new specialized Committee that will act as a mediator between both parties, investigate cases brought before the Economic Court, check evidence and documents, and assign hearing sessions.

We expect this update will result in an effective and efficient resolution of disputes in Egypt.

It is worth noting that Egypt boasts one of the largest and most diversified economies in the Middle East and North Africa, and maintains a relatively comprehensive regulatory and legislative system for the protection of trademarks, patents, designs, copyright, trade secrets, and unfair competition.

EGYPT



GCC . SAUDI ARABIA . EGYPT . MIDDLE EAST AND NORTH AFRICA

EGYPT | NO GOEIC-ING AROUND FOR COUNTERFEITERS



EGYPT

The General Organization for Export and Import Control, known by the acronym GOEIC, created a new electronic platform for commercial records. The system went online on November 30, 2018.

The e-system allows users to instantly access the records of importers, exporters, production requirements, and the register of agents. On the flipside, this tool facilitates the enforcement of intellectual property rights and allows the identification of the parties responsible for importing counterfeits, which makes it much harder for infringers to hide their illicit activities.

With this update, Egypt shows its commitment to develop and establish a competent IP system and demonstrates its awareness of the strategic importance of IP on the country's economic development.

MENA | RISING CHALLENGES IN PATENT PROSECUTION IN THE REGION



The Middle East and North Africa region, more commonly known as MENA, receives its share of news in the international circuit. From Masdar City, the pioneering vision of the city of the future on the outskirts of Abu Dhabi, the capital of the United Arab Emirates, to the majestic Atlas Mountains, south of Casablanca, Morocco, site to a number of R&D and manufacturing plants of multinational companies such as Airbus, Boeing, Bombardier, Siemens, and others.

Saudi Arabia has been a steadily growing economy, which with the introduction and implementation of a number of reforms, has seen a sudden boom with the diversification of the economy and further opening of its borders to foreign investments. Egypt has also drawn considerable attention from foreign investment with its aggressive development of a number of industries, including manufacturing and pharmaceuticals.

The MENA region has been the stage for political and economic developments that led to a rapidly growing middle class, with a penchant for innovative products and innovation itself. A combined, relatively young population of half a billion growing at double digit rates, plays a significant role in making the region one of the fastest growing markets in the world with 5 year CAGR outlooks of between 9 to 30 percent depending on the field or sector.

In that same period, and with the support of at least the WIPO, EPO and/or the USPTO, the countries of the region have established, implemented, or ratified their laws governing intellectual property. Then, followed the implementation of these laws and the related by-laws, regulations, and guidelines governing the filing requirements, examination procedures, publication and grant and, most importantly, enforcement of the ensuing rights.

A key development in an increasing number of countries of the region, which has contributed to the steady rise in patent filings,

MENA

MENA | RISING CHALLENGES IN PATENT PROSECUTION IN THE REGION



is the implementation of substantive examination leading to legally valid patents. This point has become one of utmost importance since the patent offices in most of the countries of the region have taken on the burden of rejecting or granting patents based on substantive examination, rather than placing the burden on the applicant meeting the patentability criteria or novelty, inventive step, applicability, unity, and compliance with local laws and regulations on allowed subject matter.

The Patent Offices of the following countries have been issuing decisions based on substantive examination: UAE, Saudi Arabia, Oman, Bahrain, Qatar, Iraq, Egypt, Jordan, Algeria, Morocco, and Tunisia. This is pretty much the list of most of the countries generally included in the MENA region, and only leaves out a handful of countries, such as: Lebanon, Libya, Yemen, and Kuwait. Less than 5 years ago, the number of countries was much smaller and excluded Oman, Bahrain, Qatar, Tunisia, and Algeria. Going back even longer, the number of countries with substantive examination was even smaller.

The quality and level of examination of course varies from country to country. The trend though has been for most countries to adopt the same strategy and refer to the International Search and Opinion (i.e. ISR and IRPR), at least for the First Examination Report (FER). For the majority of applicants, this is a welcome implementation since it provides for the possibility to adopt a similar strategy in those countries as the one adopted in most countries where the IPEA's opinion is applicable. Most of the examiners in the countries in the MENA region, with the proper compliance and arguments on file, will look favorably at foreign grants and acknowledge their peers' decisions. This is not to say that a foreign grant will automatically result in a national grant. The examiners have to be convinced that the objections raised are adequately addressed. This then brings us to the challenges faced by the local agents representing SME's and MNC's, and even in some cases, local, or regional companies.

MENA

MENA | RISING CHALLENGES IN PATENT PROSECUTION IN THE REGION



Pursuant to the laws of the countries in the region, foreign applicants have to be represented by a locally registered practitioner with a local address. Historically, the capabilities and competencies of these local representatives were primarily limited to administrative duties, as a result of the absence of any particular need for technical expertise or know-how. With a number of Patent Offices issuing technical examination reports, and in most countries in the local language, applicants tend to depend on the local representative to fully understand the technical and legal implications and provide a plan or strategy for preparing and filing the best response to address these reports in a methodical, adequate and timely manner. In many instances, an interview with the examiner may be required. As the applicant's local representative, this latter should be able to understand the applicant's strategy and adequately argue with the examiner as needed to address any remarks or comments made during an interview.

Such competencies are hard to find in the MENA region, especially considering the rapidity with which the Patent Offices started issuing examination reports in order to go through the backlog created from maintaining applications pending until the implementation of the examination guidelines set in motion. Such competencies also come at an elevated price. For some local or regional IP firms, this means loss of the ability to offer the same services with the usual competitive pricing. For others, this means expanding the patent teams to include foreign patent attorneys, which comes however with a limitation due to the language barrier.

With these changing parameters, foreign applicants are now faced with additional variables when considering their global patent strategy where this now includes the MENA region. Pricing will always be an important variable to consider when looking at budgets. But the quality and competence of the team prosecuting the patent applications has become as important

MENA

MENA | RISING CHALLENGES IN PATENT PROSECUTION IN THE REGION

MENA

for at least 2 reasons: (1) identifying subject matter which may be patentable at different stages of the patent procurement, and (2) ensuring a streamlined prosecution with minimal office actions and the ability to proceed to grant when needed. As the MENA region begins to attract the attention of a growing number of industries, the importance of securing legally valid IP rights and the ability of adequately enforcing those rights necessitate the identification of local representatives with both the capabilities and abilities to understand not only the legal aspects of these rights, but also their merits and validity to withstand cancellation and/or possible acts of infringement. Needless to say, this will also necessitate a review of the budgets relating to IP for the MENA region.



IT'S NOT ABOUT
BEING THERE.
IT'S ABOUT
BEING AWARE.



"THE OTHER
FIELD"
EDWARD FORSTER

90⁺

YEARS OF EXPERIENCE

18

OFFICES

1

STOP SHOP IP FIRM

COUNSELING | PROSECUTION | ENFORCEMENT | ANTI-COUNTERFEITING

SABA
INTELLECTUAL
PROPERTY

THE SABA NETWORK

Head Office

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
headoffice@sabaip.com

Algeria

Cabinet Boukrami
(In cooperation with Saba & Co. IP)
Centre Commercial et d'Affaires El Qods
10th floor, BU 10-04 B, Cheraga 16002
Algiers, Algeria
T. +213 21 34 11 61
F. +213 21 34 11 62
P.O. Box 86 Centre Commercial et d'Affaires
El Qods, Cheraga 16002
info@boukrami.com

Bahrain

Bahrain Tower, Al-Khalifa Road
Manama, Bahrain
T. +973 17 210 301
F. +973 17 224 699
P.O. Box 21013
bahrain@sabaip.com

Cyprus

Mitsis Building #2
14, Makarios Avenue
1065 Nicosia, Cyprus
T. +357 22 755 434
F. +357 22 754 037
P.O. Box 21143
1502 Nicosia
cyprus@sabaip.com

Djibouti

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
djibouti@sabaip.com

Egypt

10 Aisha El Taymouriah Street
Garden City, CP 11451
Cairo, Egypt
T. + 20 2 279 59686
F. + 20 2 279 52314
P.O. Box 129, Mohamed Farid
info@sabaip-eg.com

Ethiopia

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
ethiopia@sabaip.com

Gaza

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
gaza@sabaip.com

Iraq

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
iraq@sabaip.com

Jordan

56 Prince Shaker Bin Zaid Street
Al Shmeisani
Amman, Jordan
T. +962 6 464 2145
F. +962 6 464 2159
P.O. Box 840553, Amman 11184
jordan@sabaip.com

Kuwait

Jassim Ahmed Alfahed
(In cooperation with Saba & Co. IP)
Al Hajri Building,
Al-Shuhadaa Street Kuwait, Kuwait
T. +965 2 242 3428
F. +965 2 240 2243
P.O. Box 1245, 13013 Safat
info@jafahed.com

Lebanon

Saba House,
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 840
F. +961 5 454 842
P.O. Box 11-9420
lebanon@sabaip.com

Libya

Saba House,
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
libya@sabaip.com

Morocco

185 Boulevard Zerkouni
Residence Zerkouni
Casablanca 20330
Casablanca, Morocco
T. +212 522 251 530
F. +212 522 251 603
P.O. Box 13 921
Casablanca 20032
morocco@sabaip.com

Oman

Muscat International Centre
Beit Al Falaj Street
Muscat, Oman
T. +968 248 111 26
F. +968 248 111 28
P.O. Box 2027 Ruwi
Postal Code 112, Sultanate of Oman
oman@sabaip.com

Qatar

Gridco Building
C Ring Road
Doha, Qatar
T. +974 44 42 3992
F. +974 44 32 4106
P.O. Box 14035
qatar@sabaip.com

Saudi Arabia

Al Hadaf Marks Services LLC
(In Cooperation with Saba & Co. IP)
Office # 1, 2nd Floor, Tower B GOSI Olaya
Towers Olaya Street, Riyadh 12213,
Saudi Arabia
T. +966 11 2079596
F. +966 11 2079598
P.O. Box 61145 Riyadh 11565
saudi@sabaip.com

Sudan

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
sudan@sabaip.com

Tunisia

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
tunisia@sabaip.com

United Arab Emirates

Tamani Arts Tower - 18th Floor
Al Asayel Street, Business Bay
Dubai, UAE
T. +971 4 553 9911
F. +971 4 566 8470
P.O. Box 42259
uae@sabaip.com

West Bank

Saba House
Saïd Freiha Street, Hazmieh
Beirut, Lebanon
T. +961 5 454 888
F. +961 5 454 844
P.O. Box 11-9421
westbank@sabaip.com

Yemen

Hadda Towers, Building #7
Hadda Street
Sana'a, Yemen
T. +967 1 420 595
F. +967 1 420 596
P.O. Box 1493
yemen@sabaip.com