

**SABA**  
INTELLECTUAL  
PROPERTY

**BULLETIN**

**August 2021**

**SAUDI ARABIA**

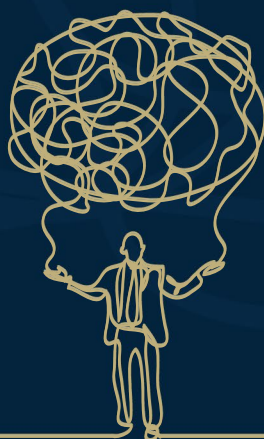
Adopts the Eleventh Edition of  
the Nice Classification

**UAE**

Busting Screens: Online  
Anti-Counterfeiting Measures

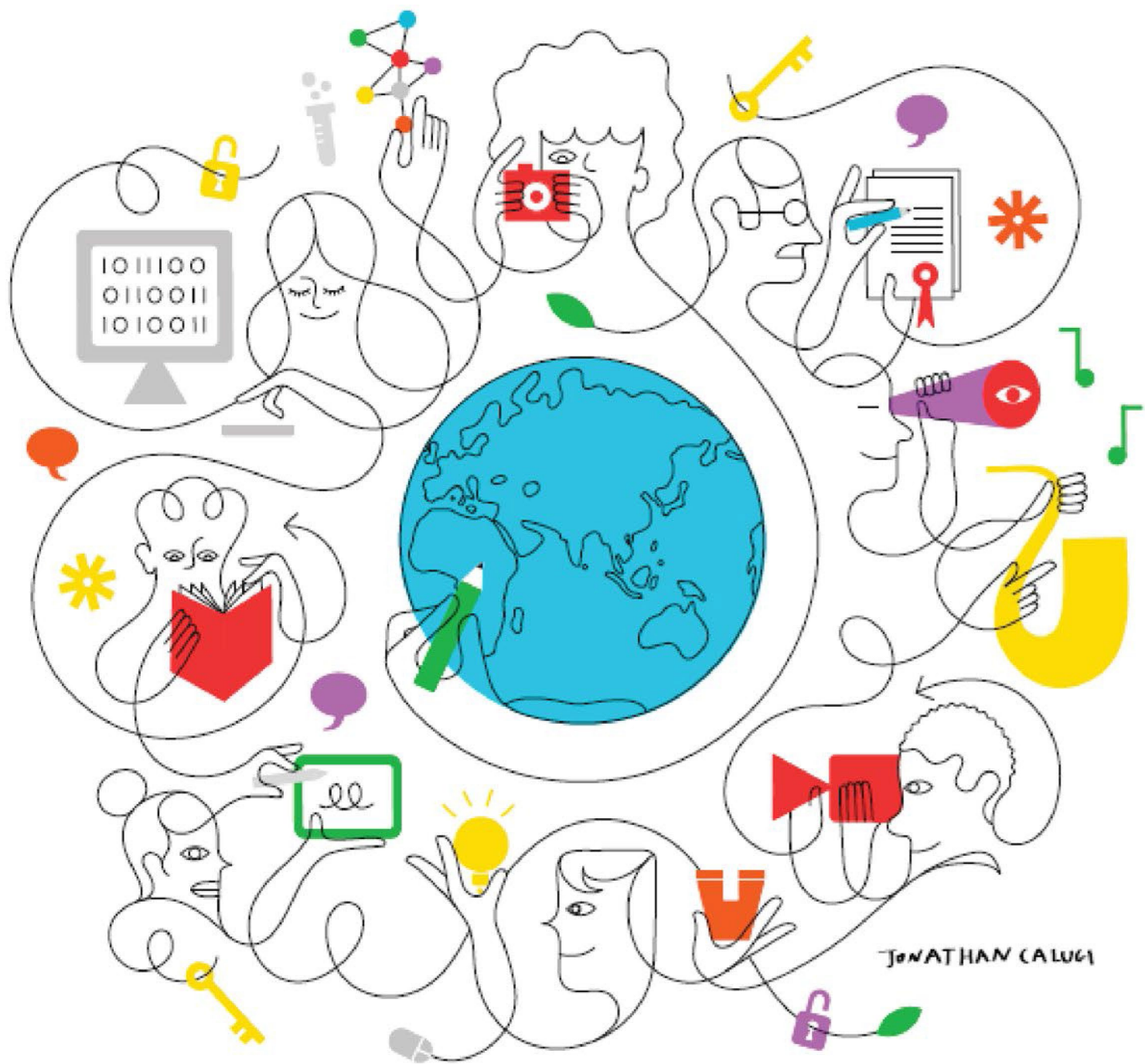
**MENA**

Securing Patents in a Rapidly  
Developing Region



## IP and SMEs:

# Taking your ideas to market



World Intellectual  
Property Day 2021

## SAUDI ARABIA | ADOPTS THE ELEVENTH EDITION OF THE NICE CLASSIFICATION



**Saudi Arabia recently adopted the 11th Edition of the Nice Classification, thus replacing the outgoing 10th Edition.**

The adoption of the 11th Edition will not affect trademarks already filed and registered. Upon next renewal, goods and services affected by this change in formalities will be reclassified accordingly by the Saudi Authority for Intellectual Property (SAIP).

A major change to the trademark registration process is that SAIP no longer allows claims

for class headings in combination with all the items in the class. Accordingly, applicants should either itemize the specification of goods or services of their interest in the application from a preapproved list or claim the entire class heading.

This news follows Saudi Arabia's accession earlier this year to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification).



## UAE | BUSTING SCREENS: ONLINE ANTI-COUNTERFEITING MEASURES

The United Arab Emirates (UAE) has garnered an illustrious reputation of having one of the most robust anti-counterfeiting regimes in the Middle East and North Africa (MENA) region. The UAE, which is hailed as a desert oasis of opportunities, offers a prime location for the launch and marketing of international brands and is an international center for transit trade in the region. However, the UAE is also inundated by counterfeit goods being sold in marketplaces, both in physical and virtual premises.

**In spite of this, online infringers selling counterfeit goods are not able to seek refuge for long behind their screens. In practice, brand owners can rely on the solid foundation that has been implemented through the Court systems. Court actions are available as a remedy for online infringement if the brand owner is able to associate the infringer with a local entity or**

**individual in the UAE (the owner of the webpage should have physical presence in the UAE). In some instances, and with sufficient evidence, such as pictures of the infringing or counterfeit products, being provided to the authorities concerned, this can result in a website being blocked until a decision is reached.**

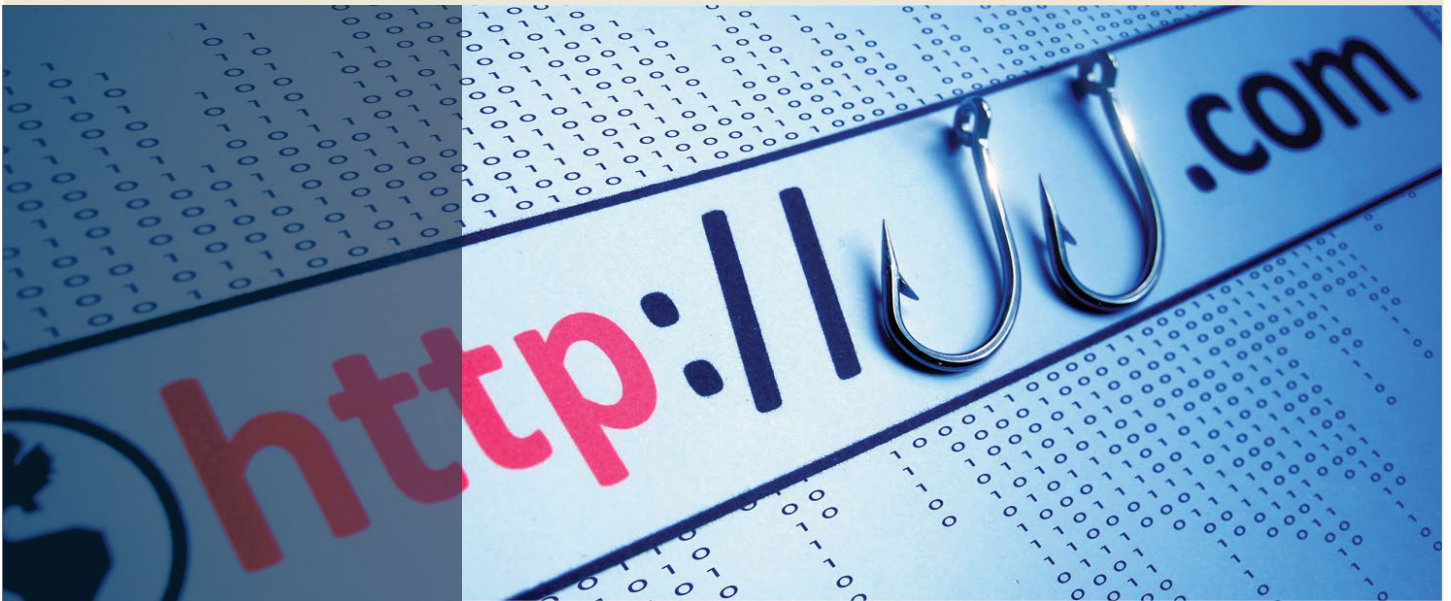
Take for example the Emirate of Dubai, one of the seven emirates that make up the UAE, where a specialized taskforce that is the Criminal Investigation Division (CID), operating under Anti-Economic Crimes Department has been established within the Police and is in charge of all electronic crimes. While other Emirates follow similar procedures; however, online services are only available in Dubai.

The definition of an electronic crime includes, but is not limited to, the sale of fake goods on the Internet.





## UAE | BUSTING SCREENS: ONLINE ANTI-COUNTERFEITING MEASURES



As such, the CID taskforce launches an investigation of an alleged electronic crime based on a complaint filed by the brand owner on online marketplaces, e-commerce websites, and even social media accounts and/or pages involved with the sale or promotion of counterfeits. It is worth noting that the above-mentioned taskforce has the legal jurisdiction and technical competence and proficiency to block websites that engage in selling or promoting counterfeit products from being accessed by unsuspecting online shoppers.

By way of background, the Dubai Economic Development Department (DEDD) has successfully shutdown tens of thousands of social media accounts peddling fake and counterfeit merchandise since its inception in 2016. However, it is worth noting that, the DEDD has hesitated to take any measures against online infringement unless the trader or owner of the webpage that is suspected of selling counterfeit products has a physical presence in the UAE and holds a valid trade license. The DEDD will, however, liaise with the Telecommunication Regulatory Authority (TRA) to take down a page or an .ae domain name unless the trader or owner of the webpage that is suspected of selling counterfeit products has a physical presence in the UAE and holds a valid trade license.

## MENA | SECURING PATENTS IN A RAPIDLY DEVELOPING REGION



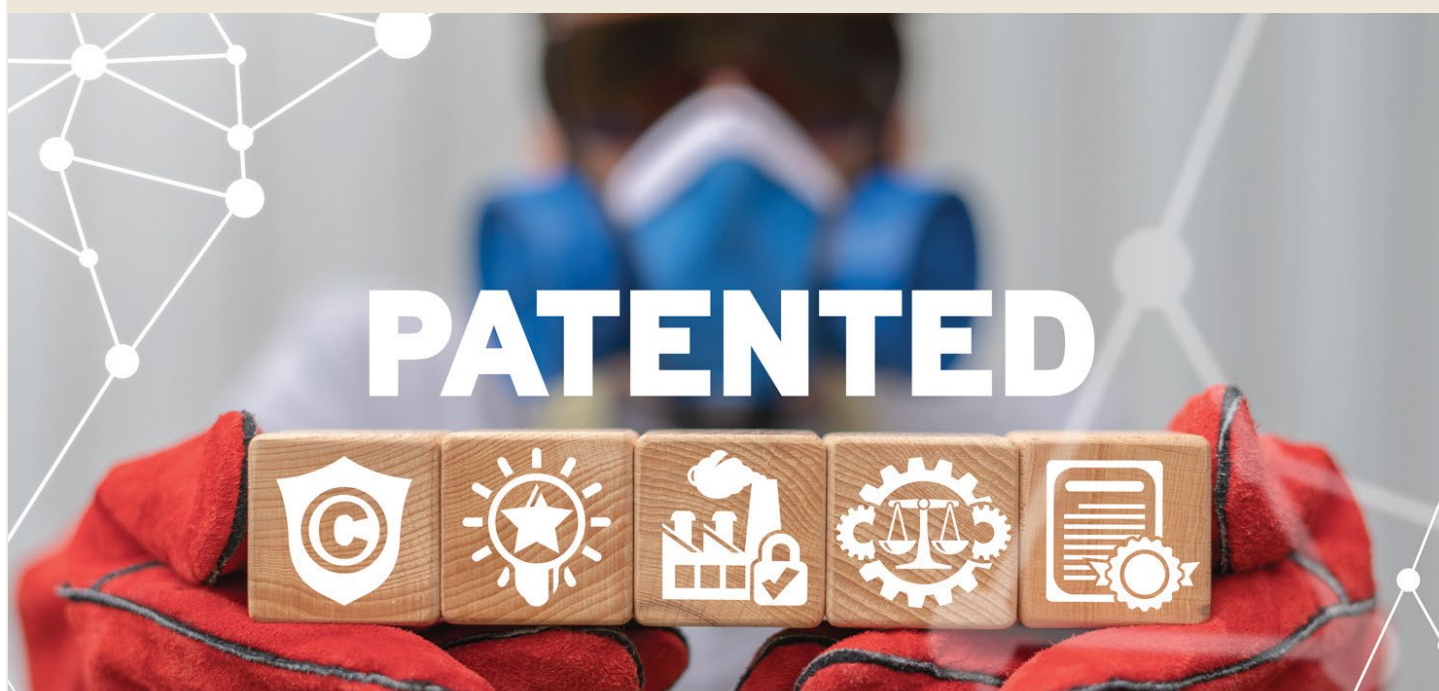
The Middle East and North Africa region, more commonly known as MENA, receives its share of news in the international circuit. At the forefront, the boom which began in Saudi Arabia a few years ago is still going strong, along with the introduction and implementation of a number of reforms, which are steadily fueling the diversification of the economy and attracting both national and foreign investment. Egypt's economy also continues to grow and draw considerable attention from foreign investment given the constant development of a number of industries, including manufacturing, food processing, agriculture, hydrocarbons, and pharmaceuticals, and other service sectors that are driving the country's relatively diverse economic activity.

The MENA region continues to be the stage for political and economic developments that led to the growing of a 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 to making the region one of the fastest growing markets in the world with five year compound annual growth rate outlooks of between 9 to 30 percent depending on the field or sector.

In that same period, and with the continued support of at least the WIPO, INPI, JPO, KIPO, and the USPTO, the countries of the region have established, implemented, or ratified their laws governing intellectual property.

A key development in an increasing number of countries of 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 of novelty, inventive step, applicability, unity, and compliance with local laws and regulations on allowed subject matter. The most recent office to join this group is the Kuwaiti Patent Office.

MENA

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The Patent Offices of the following countries have been issuing decisions based on substantive examination: the United Arab Emirates, Saudi Arabia, Oman, Bahrain, Qatar, Iraq, Egypt, Jordan, Algeria, Morocco, and Tunisia. This is 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 five 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

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 multinational corporations and small and medium-sized enterprises, and even in some cases, local or regional companies.



## MENA | SECURING PATENTS IN A RAPIDLY DEVELOPING REGION



MENA

A more recent development that has made a significant impact on the region and applicants is the suspension of new filings in the GCC Patent Office, the only regional patent office in the MENA. The GCC Patent Office was comprised of Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and the UAE and which implemented a **unitary system**, stopped accepting new patent applications as of January 6, 2021. While this is a temporary situation, as an **amended law** has been published but awaits new regulations to start implementation, a large number of applicants found themselves having to reassess their filing strategy and budget for the Arabian Gulf countries in the interim.

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, Arabic, 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.

## MENA | SECURING PATENTS IN A RAPIDLY DEVELOPING REGION



In many instances, an interview with the examiner may be required. As the applicant's local representative, the 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 pending applications 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 preparing budgets. However, the quality and competence of the team prosecuting the patent applications has become as important for at least two 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.

MENA



THE BIGGER YOU GROW,  
THE STRONGER WE GET



**90<sup>+</sup>**  
YEARS

**50<sup>+</sup>**  
JURISDICTIONS

**1**  
FIRM

COUNSELING | PROSECUTION | ENFORCEMENT | ANTI-COUNTERFEITING

**SABA**  
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