



Arab World Updates

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▲ BAHRAIN

New industrial design regulations

Issued back in April 29, 2006, the industrial design law came into force in the country on February 26, 2010. The Bahraini patent office is currently working on its setup in preparation of the new regulations. The new regulations contain for the first time in the country provisions on the payment of annuities. The payments will be due annually on the anniversary of the date of publication. No deadline for the settlement of annuities has been specified yet.

	Previous Regulations	New Regulations
Protection Period	5 years from filing date	10 years from filing date
Examination	Applications are examined as to form only.	Applications are examined as to form, novelty and industrial applicability.
Annuity Fees	No annuity payments.	A maintenance fee is due annually on the anniversary of the date of grant. There is a 6-month grace period for late payment, which is subject to a surcharge.
Applications	Applications with multiple figures are not possible.	Multiple-figure applications are now admissible with up to 50 figures per application.
Renewal	Renewal is for two consecutive terms of 5 years.	Renewal is for one term of 5 years.

Filing Requirements:

According to the implementing regulations, the documents required for filing a design application in Bahrain are:

1. Power of attorney, simply signed.
2. Copy of home or any foreign registration, certified.
3. Three representations of the design.
4. Copy of priority document, if priority is claimed, certified.
5. Description of the design.

All the above documents must be submitted at the time of filing. ▲

▲ QATAR

New Anti-Counterfeit Measures expected

An announcement made recently by the Qatar Authority for Standards and Metrology calls for an initiative to boost and encourage consumer protection rights. This initiative is meant to control and secure the consumer goods sector which has been threatened by the circulation of goods nonconforming to the official standards, as well as the presence of poor quality services and counterfeiting. The Qatar Authority for Standards and Metrology will be setting up laboratories where all imported products will be inspected, tested, and evaluated before the issuance of product conformity certificates and only thus will they be allowed to enter the country. The Qatar Authority for Standards and Metrology is the only public organization in Qatar that is responsible for all issues to do with standards and quality. Following international requirements and practices, this organization aims at the further development of the quality of products and services in Qatar guaranteeing the well-being of all members of society.

On September 27, 2007 the Qatari Council of Ministers ratified a draft law on Border Measures related to Intellectual Property. The draft law is expected to include provisions on customs activities in regards to the protection of intellectual property in the field of import and export of goods, as well as the strengthening of border control measures in order to deal with piracy and counterfeiting.

The draft law is expected to be consistent with the special provisions of border measures of the Agreement on Trade Related Aspects of Intellectual Property Rights concluded within the framework of the World Trade Organization. ▲

▲ SAUDI ARABIA

Arabic Domain Names – applications accepted!

On May 31, 2010, the Saudi Network Information Center (SaudiNIC) began accepting applications for Arabic domain names. The registration process consists of two stages:

1. Sunrise Period: This stage (May 31 – July 12, 2010) is open only to trademark and trade name owners. The domain name must be the exact match of the corresponding trademark or trade name.
2. Landrush Period: This stage begins on September 27, 2010 and allows anyone to apply for the registration of domain names of high commercial value. No trademark or trade name registration is required.

Registration requirements are as follows:

1. Power of attorney, simply signed
2. A letter addressed to SaudiNIC, completed on applicant's letterhead, simply signed, with company seal
3. Copy of the corresponding certificate of registration or copy of the corresponding certificate of incorporation or extract from the commercial register. This is only required during the Sunrise period. The domain name will remain operational as long as the Domain Name System numbers and Internet Protocol addresses are kept active. Local presence is required.

As indicated above, trademark owners operating in Saudi Arabia will find it essential to identify and register all country code Internationalized Domain Names (IDNs) of interest in order to prevent any attempts of cyber-squatting and to make sure that they have proper protection of the Arabic script of their marks.

In addition to Saudi Arabia, countries in our region that have completed the linguistic and technical requirements for the introduction of IDNs are Egypt, UAE, Qatar, Tunisia, Jordan, West Bank, and Gaza. ▲

▲ OMAN

Annuity Fees Deadline Extended

July 1, 2010 is the deadline for the settlement of the cumulative patent annuities in Oman. These fees include those which were due on the first and each subsequent anniversary of (1) the filing date of a local application, or (2) the PCT international filing date of a national phase application.

There will be no need for a power of attorney to make the annuity payment even if there is a change in the agent of record. Applicants are encouraged to complete the files by the July 1, 2010 deadline or else incomplete applications will be considered abandoned.

Increase in Official Fees

On May 16, 2010 the Omani Ministry of Commerce and Industry issued resolution no. 51/2010 presenting the official fees schedule according to the Industrial Property Law no. 67 of 2008. The resolution published in the local gazette no. 911, indicates a substantial increase in the official fees for most IP-related issues compared to their current level. The increase varied from double the current rate for filing a single class trademark application to 5 times the current applicable fees for conducting a trademark search within the records of the Registry. Regarding patents, the increase ranged from 3 times the current rate for filing a patent application to 6 times the current rate for paying the 20th annuity.

Resolution no. 51 came into force on June 15, 2010 whereby the new rates will apply to new as well as pending applications.

Trademark Office Adopts Ninth Edition

The Omani Trademark Office has recently changed its trademark classification system by adopting the Nice's 9th edition of the Nice classification system and thus replacing the Nice's 8th edition. Most of the alterations in class headings involve classes 21, 29, 42 and 45. In the 9th edition, the disclaimer "not of precious metal or coated therewith" is removed from class 21, the item "frozen" is added to class 29, and the item "legal services" is removed from class 42 and added to class 45. Some alterations and additions have also been made to the classes 14, 20, 26, and 34. These changes include, the transfer of goods and services from one class to another, deletions, as well as changes in class headings. ▲

▲ JORDAN

Reduction in Official Fees

The Jordanian Trademark Office announced the reduction in the official fees on all trademark-related matters, thus reversing the decision taken back in December 2009 of actually increasing the fees. The new rates have dropped but remain higher than their original level. The new rates are effective as of May 16, 2010 and will apply to new as well as pending applications (filed between December 1, 2009 and May 16, 2010). ▲

▲ IP HIGHLIGHTS

Frequently Asked Questions on Trademark Protection in the Arab Region

1. Is the protection of a trademark in the Arab region, on a “first-to-file” or “first-to-use” basis?

Arab countries provide protection on a first to file rather than a first to use basis. With such a first-to file system, registration becomes absolutely necessary to obtain rights in a mark. Unlike common law countries, the use of the mark without its registration does not necessarily establish protection rights.

2. Is the use of a trademark a registration requirement?

No. A trademark registration is possible in the Arab countries without actually using it. Therefore, it will not be necessary to provide detailed information in trademark applications on the existing use of the mark. However, in most Arab jurisdictions in the event of non-use, trademark registrations may be vulnerable to cancellation, which is usually a period of either three or five years.

3. How are trademark applications classified in our region?

As in the United States, it is necessary to file applications in Arab countries in respect of certain goods or services, although most jurisdictions do not require that the specifications of goods be as detailed as in the United States. Each jurisdiction has its own requirements as to what type of specification of goods or services will be required and permitted. For example, in Kuwait, Libya, Qatar, Saudi Arabia, Sudan, United Arab Emirates, and Yemen, class 33 and alcoholic goods in class 32 cannot be registered. Pork meat in class 29 cannot be registered in Kuwait and Saudi Arabia.

In addition, in some Arab countries, the applicant can file an application claiming the whole class without specifying the particular goods/services. The Trademark Offices of these countries do not object to the use of any of the class headings as being too indefinite and not specific (such is the case for example in Egypt). In other countries, such as Jordan and Sudan, the applicant must specify the goods or services in the class or else the application will not be accepted. 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.

4. Can a trademark application include several classes, or is a separate application required for each class?

Whether a trademark application may include several classes or not depends on which country you are registering in. In some countries, it is possible to obtain one trademark registration covering all of the goods or services on which a mark is used, regardless of how many classes are included. Other countries require a separate registration for each different class of goods and services.

5. Is it possible to secure a trademark registration covering a number of countries through a regional system?

There is no regional trademark registration system available to date in our part of the world, similar to the OAPI (Africa) and Community

Trademark systems. It is worth noting here that the Gulf Cooperation Council introduced in 2006 a GCC Trademark Law with the main purpose of replacing the local trademarks laws of each of the GCC member states (Bahrain, Kuwait, Oman, Qatar, Saudi Arabia, and the United Arab Emirates) in order to create unified implementing regulations. However, the GCC Trademark Law does not offer for a unified filing system as is the case with the GCC Patent Law. Trademark applications will continue to be filed separately in each GCC member state for protection. The GCC trademark law is still not in force and is not expected to be effective anytime soon.

6. What are the rules for using the TM, SM or ® symbol?

Using these symbols is not compulsory in the countries of our region. However, using them is advisable as it will inform the public about the trademark owners' rights. In principal, the TM symbol may be used when trademark rights are claimed in relation to a mark which has not been registered at the Trademark Office of a particular jurisdiction, meaning that, the use of the TM symbol does not mean a legally enforceable trademark. The registration symbol ®, however, does carry legal weight. It should only be used when the mark is registered with the Trademark Office of a particular jurisdiction. Unrightfully using the symbol ® may be treated as fraudulent marking in most of the countries from our region. ▲