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Commitment to Robust Patent Protection

Just as trademark filings and registrations have seen a remarkable rise in the Near East over the past ten to twenty years, we are witnessing a similar phenomenon with patent filings and registrations. This rise in filings is driven by the need for protection in these new emerging markets as well as an improved IP rights and enforcement environment. One country in the region that stands out is Saudi Arabia. In 2013 alone, two major patent-related events have attested to Saudi's continued commitment to ensuring accessible and robust IP.

In February of 2013, the Saudi health authority, the SFDA, introduced a law under Circular Letter No. 7448 which patches-up the lack of patent linkage regulation in the country. Based on the circular, a generic drug manufacturer (Gx) can only file for a marketing authorization during the final two year period of a patent's term. It is also incumbent upon the Gx to obtain and submit a letter from each of the Saudi Patent Office (SPO) and the Gulf Cooperation Council Patent Office (GCCPO) disclosing the existence or absence of a relevant patent and its term if one was granted.

In May of 2013, Saudi Arabia acceded to the Patent Cooperation Treaty (PCT) and is automatically designated for national entry as of August 3 of the same year. While Saudi is not the first country from the GCC to become a PCT member, it is by far the largest market and economy of the region. From an administrative point of view, this move may cause headaches when it comes to deciding whether to file an application with the GCCPO or the SPO. From a more practical point of view, a patent granted by the SPO may be better upheld than the same one granted by the GCCPO. Time will tell as regards to this latter given the lack of sufficient case laws and precedence.

We expect to see a drastic increase in patent filings in Saudi Arabia starting in the first quarter of 2015 driven by PCT national entries; however, we would also expect an increase in national filings in the shorter term as the growing local innovators see better opportunities for protecting their rights internationally by first filing in Saudi Arabia.



Saudi Arabia

Electronic Filing

Trademark applications can now be submitted electronically at the Saudi Trademark Office (STMO). This Electronic Application System (EAS) allows applicants to fill-out an on-line application form, check and review it for accuracy and precision, and then submit it directly over the internet. All forms filed via EAS are time/date stamped when received on the STMO server.

Pursuant to this system, the STMO will no longer accept specifications for goods and services that do not exactly match with the Nice specification. Applications with an item that is not explicitly on that list will not be properly docketed into the system, which would basically result in considerable delays. Applicants should carefully account for this especially when faced with approaching deadlines, such as Paris Convention priority deadlines.

It is worth mentioning that class headings are acceptable by the STMO and so, needless to say, applications with class headings will be processed by the EAS in a much faster way. It is worth mentioning that the list of goods/services should bear either class headings or Nice detailed items, it is not possible to combine both in the same application.



IP Highlights

Recordal of Licenses in the MENA Region

The table below sets forth basic information on the recordal of license agreements in the countries of the MENA region. Noticeably, the common practice and / or the implementing regulations of the trademark laws of some countries require the recordal of trademark licenses, but there are no relevant penalties for failure to record. The interpretation indicates that the failure to record a license agreement can undermine attempts by the licensee to enforce rights against infringers that are claiming to be using the mark in good faith. Presumably, however, the failure to record a license would not prevent a licensee from bringing action against a counterfeiter or another party who infringes a mark in bad faith. Similarly, failure to record a license agreement can undermine attempts by the licensee to enforce rights against any cancellation action brought by a third party based on non-use. For these reasons, the recordal of a license agreement is always recommended in any country of our region regardless of whether this type of recordal is mandatory or not.

Country Is it necessary to record a License Agreement before the Trademark Office so that it becomes effective against third parties? What are the documents required for the recordal? Is it possible to record a License Agreement based on a trademark application?

Bahrain

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney, legalized; and license agreement, legalized. No. A license may be recorded for trademark registrations only.

Egypt

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney from licensor, legalized; power of attorney from licensee, legalized; license agreement, legalized; and certificate of incorporation of the licensee, legalized. No. A license may be recorded for trademark registrations only.

Iraq

License recordal is compulsory in order to be effective against third parties. Power of attorney, legalized; and license agreement, legalized. Yes

Jordan

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney, legalized; and license agreement, legalized with Arabic translation. No. A license may be recorded for trademark registrations only.

Kuwait

License recordal is not compulsory but advisable in order to be effective against third parties. If the licensor or licensee is a Kuwaiti national, the license agreement must be recorded at the commercial registry and not the Trademark Office. A legalized extract from the commercial register would then be duly recognized by the Courts should a conflict arise. If the licensee is a Kuwaiti national, the license agreement may be recorded at the commercial register and not the Trademark Office. A legalized extract from the commercial register would then be duly recognized by the Courts should a conflict arise. Yes

Lebanon

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney, simply signed; and license agreement; legalized. Yes

Libya

License recordal is compulsory in order to be effective against third parties. Power of attorney, legalized; license agreement, legalized, with sworn Arabic translation; and certificate of incorporation or extract from the commercial register, legalized, with sworn Arabic translation. Yes

Morocco

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney, simply signed and sealed; and license agreement, notarized with French translation. No. A license may be recorded for trademark registrations only.

Oman

License recordal is compulsory in order to be effective against third parties. Power of attorney, with an Apostille certification; license agreement, with an Apostille certification; and copy of certificate of incorporation. No. A license may be recorded for trademark registrations only.

Qatar

License recordal is compulsory in order to be effective against third parties. Power of attorney, legalized; license agreement, legalized; and copy of certificate of incorporation of licensee. Yes

Saudi Arabia

License recordal is not compulsory but advisable in order to be effective against third parties. Power of attorney, legalized; license agreement, legalized; and original Saudi registration certificate of the mark for endorsement. No. A license may be recorded for trademark registrations only.

Sudan

License recordal is not compulsory but advisable in order to be effective against third parties.

Power of attorney from the licensor, legalized; power of attorney from the licensee, legalized; license agreement, legalized; certificate of incorporation of licensee, legalized; and the original registration certificate of the mark(s) for endorsement. Yes

Syria

License recordal is compulsory in order to be effective against third parties. The license agreement must be recorded within 3 months from effective date otherwise a surcharge is levied. Power of attorney, legalized; and license agreement, legalized. No. A license may be recorded for trademark registrations only.

Tunisia

License recordal is not compulsory but advisable in order to be effective against third parties. Documents required: Power of attorney, simply signed; and license agreement, legalized with French translation. Yes

United Arab Emirates

License recordal is not compulsory but advisable in order to be effective against third parties.

Power of attorney, legalized; and license agreement, legalized and a copy of registration certificate of the mark. No. A license may be recorded for trademark registrations only.

Yemen

License recordal is not compulsory but advisable in order to be effective against third parties.

Power of attorney, legalized; and a license agreement, legalized. No. A license may be recorded for trademark registrations only.



Trademark Protection – Main Features

Filing Requirements

1. Power of attorney, simply signed. A general power may be used for subsequent filings.
2. Copy of priority document, if priority is claimed, notarized.
3. 8 prints of the mark for each class.

Items 1 and 3 must be submitted at the time of filing. Document 2 may be submitted within 3 months from filing date.

Classification

The International Classification of Goods and Services (10th Edition) is followed. A separate application is required for each class.

Protection Term

Trademark registrations are valid for 7 years from filing date and are renewable for like periods of 14 years each. There is a grace period of 3 months for late renewals with payment of a surcharge.

Documents required for renewal: Power of attorney, simply signed.

Assignment

Registered trademarks may be assigned with or without the goodwill of the business concerned.

Documents required: Power of attorney from the assignee, simply signed; and deed of assignment, simply signed.

Merger

A merger may be recorded for trademark registrations only.

Documents required: Power of attorney, simply signed; and copy of certificate of merger, notarized.

Marking

Marking is not compulsory.

Opposition

Trademark applications accepted by the Registrar are published in the Official Gazette. Oppositions may be filed within 2 months from publication date.

Use Requirements

Use of a trademark is not required for registration or renewal of a mark. However, a trademark is vulnerable to cancellation by any interested party if there has been no effective use of the mark for a period of 5 consecutive years from filing date.

Change of Name/Address

A change of name/address can be recorded for trademark applications and registrations.

Documents required: Power of attorney, simply signed; and certificate of change of name, notarized. For a change of address, only a power of attorney, simply signed, is required.

Cancellation

A trademark is subject to cancellation before the Registrar by any interested party on absolute grounds or if it was unrightfully registered.

Three Dimensional Trademark Applications

Inadmissible.

Extension of Time

Extension of time for oppositions/counter-oppositions is possible

Search

An official search can be conducted for word marks and devices. The search takes 5 working days. A separate application is required for search in each class. The search report discloses similar and identical trademarks.

Licensing

License recordal is compulsory in order to be effective against third parties.

Documents required: Power of attorney, simply signed; license agreement, notarized; and a statutory declaration and statement of case, notarized.

Affiliations

Bodies: World Intellectual Property Organization, World Trade Organization, European Union.

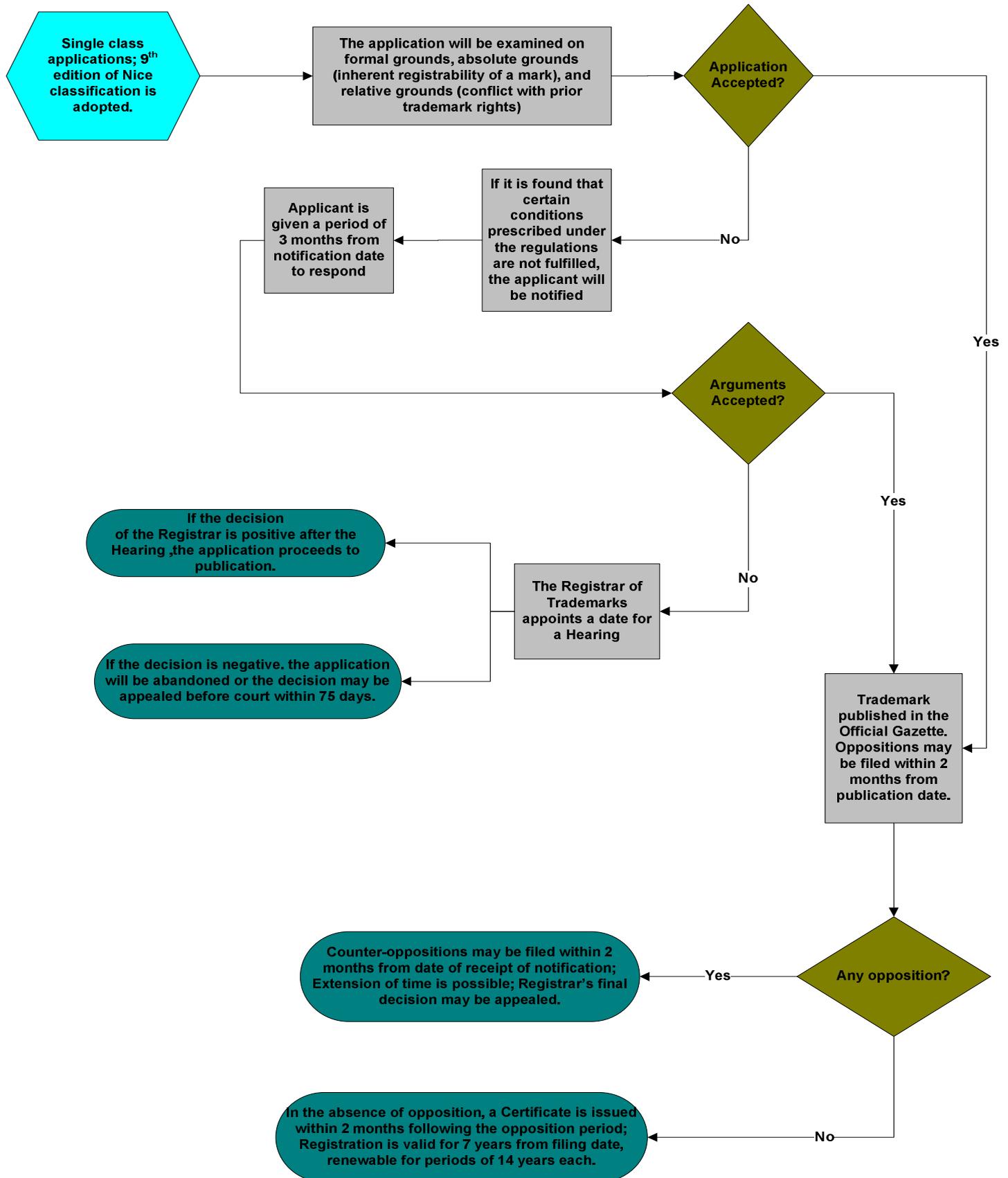
Conventions: Paris Convention, Berne Convention, Madrid Agreement & Protocol, Patent Cooperation Treaty, European Patent Convention, Apostille Convention.

Registration Time Frame

The approximate time frame for completing the registration process is 36 months.

Trademark Work Flow Chart

CYPRUS: TRADEMARKS FLOW CHART



This flow chart is for informational purposes only and should not be relied upon as legal advice. Legal or other professional counseling should be sought from our firm's Head Office.

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* All mail should be dispatched to the Head Office address in Lebanon for proper channeling.

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