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Intellectual property newsletter

June 2015

Middle East & North Africa region

The start of the holy month of Ramadan on or around 18 June 2015 will signal a month of fasting by Muslims during daylight hours (from dawn to sunset).

During this period, many countries in the Middle East will operate shorter working hours, including in many government offices. Intellectual property rights owners with an interest in the region should be aware that many of the Trade Mark and Patent Offices in the region will close earlier in the day than normal, which can have an impact on last minute filings.

In this edition of our newsletter, we look at Arabic branding and consider how this can assist brand owners in building brand equity, consumer recognition and with enforcement issues.

In addition, we report on a number of key market updates from around the region, including news that Saudi Arabia and the UAE have conducted raids to seize counterfeit goods worth millions of US dollars.

Arabic branding

Saba Al Sultani considers the benefits that Arabic language branding can provide for international brand owners.

Click **here** for a link to the full article.

Market updates from around the region

Click **here** to read all updates.

For further information, please speak to your usual contact in the Clyde & Co IP team, or email us at ip@clydeco.com.

UAE Trade Mark Gazette

The latest edition of the UAE Trade Mark Gazette was published on 1 June 2015. This month's opposition deadline is 30 June 2015.

Click here for a link to the UAE Trade Mark Gazette and further information.

If you identify any marks that are of potential concern, or if you have any queries, then speak to your usual contact in the Clyde & Co IP team, or email us at ip@clydeco.com.

The timeframe for arranging the legalisation of a Power of Attorney (which will need to be filed at the same time as any opposition) is generally around three weeks. With this in mind, please contact us as soon as possible if you identify any marks which you may wish to oppose.

Market updates

Lebanon	**Change of requirements for trade mark filings in Lebanon** The Trade Mark Office in Lebanon has postponed the implementation of the requirement to submit a notarised and legalised Power of Attorney at the time of filing until 1 July 2015. In the meantime, applications will be permitted to proceed to registration on the basis of a simply signed Power of Attorney being submitted at the time of filing. However, the Certificate of Registration will not be issued until a fully legalised Power of Attorney is submitted.
Libya	**Libyan Trade Mark Office still operational** Our team in Libya has confirmed that the Trade Mark Office is currently operational. However, due to the ongoing unrest and shortage of staff, trade mark applications and renewals are taking time to process.
OAPI	**OAPI Trade Mark Office comments on recent criticism** The OAPI Trade Mark Office has issued a statement confirming that it has legally and correctly joined the Madrid Protocol. This comes following criticism from various lawyers in the region that the accession was not in accordance with the Bangui Agreement (the Treaty which created OAPI). The Trade Mark Office has also stated that the lawyers who previously criticised the method by which it joined the Protocol will remain suspended.
Qatar	**Qatar Patent Office issues new circular concerning patent applications** On 7 May 2015 the Qatar Patent Office issued a circular clarifying the requirements for filing a patent application. With regard to a national phase patent application under the Patent Cooperation Treaty, a copy of the international search report and publication notice will, where available, also need to be enclosed with the application. In addition, the title of the patent must be written in both English and Arabic on the patent application form.
Saudi Arabia	**27,000 fraudulent goods seized in Saudi Arabia for health and safety reasons** The Saudi Arabian Ministry of Commerce and Industry (**MOCI**), the authority responsible for the administrative enforcement of intellectual property rights in Saudi Arabia, has recently seized over 27,000 fraudulent goods. The items, which were primarily homewares, including water heaters and taps, all displayed labels stating that they had been 'Made In Germany'. Further investigations however, confirmed that the products had in fact been manufactured in China. This is a positive step by the MOCI, and it is worth noting that the MOCI also indicated that action will be taken against companies which are caught importing goods which could pose a threat to the health or safety of the general public.

Syria	**Legalisation of documents for use in Syria** There are still ongoing issues relating to the legalisation of documents destined for use in Syria. For those still attempting legalisation, we are aware that the Syrian consulate in Australia is still legalising documents for use in Syria, as is the Lebanese consulate in the US. However, the UAE consulate in the US is no longer legalising any documents for use in Syria and the Syrian consulate in Canada has now closed.
UAE	**Streaming websites blocked for Mayweather-Pacquiao fight** 144 online channels which had stated that they planned to stream the Mayweather-Pacquiao fight were blocked following administrative complaints by the fight's exclusive broadcaster OSN. The websites were blocked by the Commercial Compliance and Consumer Protection (**CCCP**) division in Dubai's Department of Economic Development in cooperation with the UAE's Telecom Regulatory Authority (**TRA**). This is a significant step in combatting the online piracy of pay TV transmissions in the UAE.
UAE	**Sharjah Department of Economic Development tackles television piracy** The Sharjah Department of Economic Development (**DED**) has raided and closed down three electronics stores in Sharjah. The stores were found to be selling set-top boxes which allowed purchasers to access premium "paid for" channels at no charge. The raid follows training for DED officials provided by the regional pay TV broadcaster, OSN.
UAE	**Goods worth USD 1 Million seized in the UAE during the first quarter of 2015** Dubai Customs has announced seizures of counterfeit and infringing goods worth over AED 4 million (approximately USD 1 million) during the first quarter of 2015. The products have come from over 40 seizures by Customs.
Yemen	**Temporary filing of scanned documents permitted** The airways in Yemen have been temporarily closed in light of the ongoing conflict. As a result, all couriers have stopped their activities into the country. Until this is resolved, the Trade Mark Office has agreed to proceed with scanned copies only of any required documents. Original documents are to be submitted once the airways reopen.

Arabic branding

By Saba Al Sultani, Associate and Rob Deans, Partner

Introduction

The Middle East and, in particular, the Arabian Gulf region has long been an attractive market for international brand owners. As the region continues to experience economic growth, the interest from international brand owners also continues to rise. With this increasing interest, the need to adequately protect their IP rights in the region remains an issue of core importance to brand owners.

Despite there being a large number of English speakers within the Middle East, Arabic remains the first language across the region. Accordingly, it is important for international brand owners to give careful consideration to the registration of Arabic versions of their trade marks, through either translating or transliterating the original marks in order to reflect their use in local markets.

However, with the cost of securing trade mark registrations in the Middle East being among the highest worldwide, careful assessment of how best to focus resources is crucial. In countries like the UAE (where the official fees for trade mark applications have recently increased by two-fold), this is now more important than ever before.

Local requirements and considerations

In most Middle Eastern jurisdictions it is not a requirement for trade marks to be registered in Arabic. It is possible for trade marks to be registered in Latin script, either alone, or alongside an Arabic translation or transliteration of the original mark, as a combined mark.

Similarly, in the marketplace, international brands which have a presence in the Middle East may use the Latin script alone or alongside an Arabic translation or transliteration of the mark (even if these are not registered). It is less common, however, for international brands to feature the Arabic version alone in the marketplace, although this does occasionally happen in countries such as Saudi Arabia.

Perhaps it is for these reasons that some international brand owners choose to rely solely on their protection for the English language (or Latin script) version of their trade marks. However, problems can arise when it comes to asserting and enforcing these rights (for example in trade mark infringement actions or opposition proceedings) against third parties using or attempting to register conflicting Arabic translation or transliteration marks.

In many Middle Eastern jurisdictions, the English language (or Latin script) trade mark provides some degree of protection for the Arabic equivalent (translation or transliteration). However, it is always easier to rely on and enforce 'like for like' language marks. Relying on the English (or Latin script) mark alone is an incomplete brand protection strategy which can result in additional costs being incurred when it comes to enforcement against Arabic language brands.

There is some degree of protection afforded to well-known trade marks under Article 6bis of the Paris Convention, which some Middle Eastern member states (such as Saudi Arabia and the United Arab Emirates) have incorporated into their trade mark laws. Signatories to the Paris Convention are obliged "*to refuse or to cancel the registration, and to prohibit the use*" of a translation of a well-known mark should it cause confusion. However, Article 6*bis* only applies to well-known trade marks and there is no definition within the Paris Convention as to what constitutes a well-known mark. Therefore, this provision can be a difficult one on which to rely, leaving many marks exposed to infringement if the translation is not registered within the relevant jurisdiction.

The UAE Trade Mark Law (UAE Federal Law No. 37 of 1992, as amended) extends this protection to earlier registered marks as well as well-known marks, with Article 3.14 stating that it is not possible to register "*marks that are considered to be not more than translations of a famous mark or another previously registered mark if the registration of the mark would cause confusion amongst consumers in relation to the products that are distinguished by the mark or similar products*". Article 38 goes on to provide that the use of such a mark constitutes a trade mark infringement.

However, the degree of protection afforded to the Arabic translations of foreign language marks varies from country to country across the region.

The most notable issue when it comes to selecting an Arabic version of a trade mark is whether to select the literal translation of the original English language mark (assuming it is a mark with a dictionary meaning, and not an invented word itself) or a phonetic transliteration of the original English language/Latin script mark into Arabic characters.

Translation vs. transliteration

The literal translation of an English language trade mark into Arabic will almost certainly be phonetically different from the sound of the original mark in English. Although there are a few words shared by both languages, these are relatively rare and most translations will sound very different. In addition, there may be more than one possible translation into Arabic for a given word, and so care must be taken to select the most accurate and appropriate translation.

Relying solely on trade mark registrations for English language marks to provide protection for the Arabic translations can be a risky strategy. Although the two versions may share the same meaning, in some jurisdictions, if a third party were to use or apply to register the Arabic translation of a mark, the marks may not be considered confusingly similar based on the visual and phonetic differences.

The other option is to protect the phonetic transliteration into Arabic characters of the original English language / Latin script mark. The biggest problem that can be faced when producing a suitable Arabic transliteration mark is that the Arabic and Latin alphabets are significantly different – not all of the letters present in one are present in the other, and vice versa. For example, the letters 'G', 'P' and 'V' do not exist in the Arabic language.

Therefore, when creating a transliterated version of a mark containing any of these letters, it is normally necessary to substitute the unavailable letter with 'the next best thing' – usually a similar sounding letter. An example of this would be a word such as 'PINEAPPLE', in which the letter 'P' would typically have to be substituted for the Arabic equivalent of the letter 'B' – so the transliterated word would be pronounced 'BINEABBLE'.

One point which is of core importance when considering the option of a transliterated mark is that transliteration is largely subjective and there may be more than one way to transliterate a mark into Arabic characters. For example, in order to convey the sound of the word 'STICKS' in Latin characters, it could be written as 'STIX', 'STIC' or 'STIKS'. The same principle applies when transliterating words into Arabic characters.

This introduces scope for inconsistencies and it is important from the outset to ensure that care is taken to select the most accurate and appropriate transliteration and that this version is consistently used. If, for example, a brand owner registers one version of an Arabic transliteration, yet uses another in the marketplace, then the trade mark registration could in due course become vulnerable to cancellation for non-use. Further, the use of more than one transliteration could produce uncertainty in the minds of consumers.

Also, by registering and using an 'official' Arabic version of a mark, consumers may start to recognise the brand in Arabic and they are less likely to develop their own unofficial (and unprotected) Arabic versions of the brand. By registering and using a single 'official Arabic version of its mark, the brand owner can help ensure that consumers will have certainty as to the origin of the goods or services and thereby build valuable brand equity.

Key issues

Brand owners with an established or intended presence in the Middle East should ensure that their marks are adequately protected and that they reflect their use in local markets. For the most part, there is no strict requirement for brand owners to register Arabic language versions of their marks. However, consideration should be given to obtaining Arabic language protection in order to assist in developing a single 'official' Arabic brand and make it more straightforward to maintain exclusivity for this Arabic brand.

Often, particularly with innovative and distinctive trade marks, an Arabic transliteration of the original mark will hold more value and strength than a translation. When selecting an Arabic language version of a mark (whether a translation or a transliteration) it is important to remember that there may potentially be several variants available. Therefore, careful thought and consideration should be given to selecting the most appropriate variant for adoption and protection in local markets.

Comment

Arabic is the fifth most used language worldwide, with some 300 million native speakers, and it is the dominant and official language in most countries in the Middle East.

There is a risk that by not protecting the Arabic version of the mark by which a brand owner wishes to be known, Arabic speaking consumers will either develop no real recognition for the brand or develop their own inaccurate Arabic names when referring to the brand. By selecting and registering official Arabic versions of their marks, brand owners will ensure that, not only will they achieve a greater degree of protection for their marks, but that they are also able to build and manage consumer recognition in the region such that the value of their brands is further increased.

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UAE Trade Mark Gazette

The latest edition of the UAE Trade Mark Gazette was published on 1 June 2015 and we have made a copy of this Gazette available online. This month's opposition deadline is 30 June 2015. **Click here to access the Gazette.**

Checking the Gazette

The link provided is the original Arabic language Gazette without an English language translation. This Gazette is in the form of an Adobe pdf file and it is possible to carry out key word searches in order to identify potentially conflicting trade mark applications.

Please note that due to the size of the Adobe pdf file, it may take several minutes for the Gazette to load. However, once loaded, it should be possible to review and search the Gazette without experiencing any delays.

Contacting us

If you have any marks that are of potential concern, or if you have any queries, then please email us at **ip@clydeco.com** with:

- the trade mark(s) of interest; and
- the relevant page number(s) of the Gazette.

We can then check the Gazette and provide you with full details of the application so that you or your client can decide whether to file an opposition before the deadline and put in place a legalised Power of Attorney if necessary.

In order to have any chance of meeting the non-extendable opposition deadline where a legalised Power of Attorney is required, we will need your urgent feedback on marks of potential concern.

Should you require urgent assistance, we will need to conduct conflict checks to ensure we are free to assist.

Our regional coverage

"Clyde & Co LLP's IP team, which is one of the largest in the region, has good local knowledge and gives practical, business-oriented advice."

Legal 500 EMEA 2014

23 territories across the Middle East and North Africa (MENA) region

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Bahrain**
Egypt**
Gaza (Palestine)**
Iran**
Iraq**
Jordan**
Kuwait**
Lebanon**
Libya*
Morocco**
Oman**
Qatar*
Riyadh*
Saudi Arabia
South Sudan**
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