

# *lex arabiae*

## *Special Issue on the Trademark Laws of UAE, Iran, Iraq, Saudi Arabia and Egypt*

**Vol. XX – 1st Issue**

**January 2016**

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(Continued...)

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## *Special Issue on the Trademark Laws of UAE, Iran, Iraq, Saudi Arabia and Egypt*



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**Prologue**

**Special Issue on the  
Trademark Laws of UAE,  
Iran, Iraq, Saudi Arabia and  
Egypt**

The purpose of this Special Issue of “lex arabiae” is to highlight to our esteemed readers, most of who are trading with or have business in the Middle East, important legal issues to protect their rights in the ME-Region effectively.

A trademark is a way of identifying a unique product or service. The trademark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services, or to authorize another to use it in return for payment. Almost all countries in the world register and protect trademarks. Each national trademark office maintains a Register of Trademarks, which contains full application information on all registrations and renewals, facilitating examination, search, and potential opposition by third parties.

The spread of counterfeits of trademarks for products and services is an international concern. Hence, we prepared this special issue on the Trademark Laws of UAE, Saudi Arabia, Iraq, Iran and Egypt to guide you to the best way to protect your trademark in these countries and to prevent you from illegal competition by any second party.

Particularly in the Middle East, faked products and services are constantly penetrating the market. Each country, in the ME requires a separate registration.

And the fight against counterfeit products starts with the registration of the trademark. Especially Iran will be considered as an El Dorado for infringers once the UN-Sanctions are lifted! Trading or doing business in the ME without registering your trademark is an open invitation for infringers.

This Special Issue is intended to support its readers to protect their Trademark by doing the right step at the right time.

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**United Arab Emirates**

**Pre-Registration Contracts in  
the UAE**

**Guiding Principle**

*Contracts which were concluded by either the shareholders or other third persons on behalf of the company before its registration was completed, will remain legally effective for the company once it is registered. No further transfer of rights to the company is required if the contracts were necessary for the foundation of the company. Any kind of legal action closely connected to the intended activities of the company shall be deemed to be necessary in this sense. Rights and obligations arising from any such contracts, which are not necessary for the foundation of the company, must be transferred to the company. The transfer can be carried out by implied actions.*

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**A. Scenario**

A part of the procedure for the establishment of companies in the UAE requires the conclusion of contracts before it is duly registered. This is typically the case with leases for the premises and the opening of bank accounts. A company will be registered in the UAE only when a lease is submitted to the authority beforehand and a landlord will require safety checks upon conclusion of the contract. But many other contracts and legal acts can be considered as preparatory actions in this sense as well, if they are closely associated with the desired purpose of the commercial activities.

A company has a corporate personality only after the constitutive registration in the commercial register, see Art. 12 Para 1 sentence 1 Commercial Code UAE (law No. 8 of 1984). With regard to the preliminary agreements mentioned before as per Art 12 Para 1 sentence 4 Commercial Code UAE, the company shall have sufficient corporate personality required for its incorporation. Assuming the company will be duly registered, these contracts will be conducted directly with the company.

The transfer of the resulting rights is automatically. There is no need for any further assignment procedure.

In the case of pre-registration contracts which are not covered by Art. 12 Para 1 sentence 4 Commercial Code UAE or if the company will not be registered, the acting persons are entitled and obliged jointly and severally as debtors and/or creditors. The position as creditor does not result directly from Art. 12

Commercial Code UAE, but from the regulations on joint debtors in the Civil Code of the UAE (law No 5 of 1985), Art. 441 Civil Code of the UAE.

Art. 12 Commercial Code UAE is a general provision but applies to the limited liability company, since there is no explicit provision in the special section stipulating otherwise.

Regulations similar to Art 12 Commercial Code UAE can be found in the laws of the most Free Zones, for example, Art.18 (B) of the Implementing Rules and Regulations FZC Hamriyah Free Zone. If such provision is not included in the laws of a Free Zone Art. 12 Commercial Code UAE nevertheless applies, as the Federal Laws of the UAE shall apply also in the Free Zones if they did not implement their own regulations. The application of these regulations is also independent from the corporate form of the entity in the Free Zone. The common entities FZE and FZC differ only in terms of the number of potential shareholders and are otherwise equivalent to a limited liability company.

Overall, this can be referred to as a general corporate principle of law in the United Arab Emirates.

**B. In Concreto**

It must be evaluated on a case by case basis to which extent the registration and protection of rights is necessary for a foundation of the company. In case the use of trademarks and patents are closely connected to the planned activities of the company, such transactions will typically already be completed before registration. This occurs in particular if the commercial activity of the company are focused on the sales of products

under a trademark or the use of a patent.

In fact, there is the possibility to carry out relevant applications for the registration of a trademark on behalf of a company in foundation. In these cases, the proof of the registration of the company has to be subsequently delivered within three months.

This is clear evidence that such a trademark application is seen as a preparatory action within the meaning of Article 12 Commercial Code UAE by the jurisdiction of the UAE. Consequently, in the event that a trademark has been registered in the name of a shareholder or any other person acting for the company, for example the designated manager of the company under registration, the trademark belongs automatically to the company when it was registered.

According Art. 29 Trademark Law UAE (law No. 37 of 1992) the transfer of the ownership of a trademark shall have no effect against third parties unless duly recorded in the register of trademarks. This rule applies to the automatic transfer of ownership from the acting person to the company in the moment it has been registered. The effective date of the transfer should be the day the company has been duly registered.

Even in cases where it is doubtful whether a contract or a legal act are deemed to be necessary for the incorporation, there may be arguments, stating an exclusive permission/obligation of the entity itself. For example in case where we find a repetitive behavior such as delivery of goods to the later established company on the company's account, based on the

conditions resulting from a contract concluded with as shareholder or designated manager. The principle of implied behavior is recognized in the UAE and can be found in the form of implied behavior and tacit declarations of intent in the UAE laws inter alia in the general rules of the Civil Code UAE, compare Art. 132 (implied behavior) and Art. 135 (acceptance through silence). Yet again these provisions are applicable in the Free Zones. Some of the Free Zones Laws contain regulations stating that implicit and explicit action are rated equally, as in Art 18 (A) of the Implementing Rules and Regulations FZC Hamriyah Free Zone, stating that conclusion of a contract by a representative of the FZC irrespectively whether his authority was expressed or implied.

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## **Trademark Protection at Dubai Customs**

### **Guiding Principle**

*Taking action against trademark infringements through Dubai Customs is an additional option for trademark owners to fight violations of their intellectual property rights. The additional registration procedure at Dubai Customs should be taken into consideration as it is evident that most of the infringing goods are not produced within the UAE, but are imported. Dubai Customs may stop*

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*infringing products before entering the country.*

#### **A. Intellectual Property Rights at Dubai Customs**

It is significant that shipments are checked at ports, airports and free zones in order to prevent counterfeited goods from entering the UAE. Therefore and since 2006 Dubai Customs is operating a special section for intellectual property rights.

There are two main scenarios in which a complaint to Dubai Customs regarding suspected infringing goods may arise:

1. Dubai Customs discovers suspected infringing products in the course of its regular inspections.
2. The trademark owner discovers a suspect shipment or suspect goods and notifies Dubai Customs.

#### **I. Registering a Trademark at Dubai Customs**

With reference to the first scenario the Intellectual Property Right Department at Dubai Customs recently invited trademark owners in the UAE publically to register their trademarks at Dubai Customs. The registration procedure aims to facilitate trademark protection in Dubai. However, it does not replace an initial trademark registration at an official trademark department. By additionally registering a trademark at Dubai Customs the trademark owner enables the customs authorities to detect counterfeited trademarks more quickly, as all trademark-related data is filed and archived. Accordingly, Dubai Customs can intervene at the first entry of goods heading to Dubai, making the intellectual property right protection

more efficient. The trademark registration system is linked to all customs centers. This enables that the Customs Inspection Section can identify the owner of the trademark immediately, eliminating the need to refer to him.

In order to register a trademark at Dubai Customs a copy of the valid trademark registration certificate must be provided and administrative fees must be paid. Registrations can be performed by trademark owners or authorized legal representatives in the UAE. Any representative must first register with the Ministry of Economy and submit a duly authenticated and translated power of attorney.

#### **II. Trademark Owner may take Initiative**

The second scenario shows that trademark owners or their representatives may also file report infringements of a trademark to Dubai Customs. In order to file a complaint it is not necessary to have the trademark registered at Dubai Customs. Nevertheless, a registration will facilitate the filing procedure.

#### **B. Dubai Customs' Procedure**

In both cases a formal written complaint of the trademark owner (or his representative) is required before Dubai Customs may become active. Typically, the procedure following the filing of a complaint is that Dubai Customs takes a sample of the suspect goods from the shipping consignment or from the free zone location where it has been discovered and submits the sample to an official laboratory for testing and determination whether the product is genuine. In case the laboratory confirms

that the item is not authentic, Dubai Customs will confiscate the suspect goods. After confiscation the goods will be destroyed.

### C. Effects

This procedure was established in order to protect both the consumers as well as the trademark owners by safeguarding that standard specifications are met and by maintaining the legitimate trade movement through protecting trademark owners' rights.

Dubai Customs informed that lately a large amount of confiscated fake and restricted goods were destroyed. The destroyed goods included fake products with duplicated trademark such as ties, glasses, glasses boxes, perfumes, mobile phones accessories, pens, balls, cars spare parts and electronics, auto electrical chargers, screwdrivers, printers requisites. In addition, a large number of CDs - especially software - and some medicine were destroyed.

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## United Arab Emirates

### **Substantial Rise for IPRs Registration Fees in the United Arab Emirates**

#### **Guiding Principle**

*The Ministry of Economy in the United Arab Emirates has recently published a list of official fee increases for patent, trademark, design and copyright matters. The increases were made by Ministerial Decision No. 9 of 2015, which appeared in the Official Gazette dated 31 March 2015. The increases come into effect 60 days after publication – namely, on 29 May 2015.*

The official fees charged by the UAE Trade Mark Office so far were already possibly the highest of any national trademark office globally, and these are now set to double. So far the official fees charged by the UAE Trade Mark Office for the registration of a trademark in one class were AED 6,000, which is equivalent to approximately USD 1,650. These fees are now set to increase to AED 12,000 (equivalent to approximately USD 3,300).

#### **A. Timing of Increase**

The increase in official fees is due to come into effect on 29 May 2015. This increase was announced in UAE Cabinet Decision No. 9 of 2015, which sets out rate increases for a wide range of services provided by the UAE Ministry of Economy. These rate increases are not limited to the protection of intellectual property rights, but also cover charges for matters such as establishing companies in the UAE and registering

commercial agency agreements.

### B. Details of Increases

The following table sets out a selection of the increases announced by the UAE Trade Mark Office:

Action	Previous Fee (AED)	New Fee (AED)
Search fee	250	500
Application filing fee	500	1,000
Publication fee	500	1,000
Registration fee	5,000	10,000
Renewal filing fee	5,000	10,000

What remains to be seen is the overall impact of these increases on IP-owning businesses in the UAE. With registered rights playing a key role in the IP lifecycle, the question is what effect the higher cost of obtaining registered rights will have on the creation, commercialisation and protection of IP rights in the UAE.

### C. Existing Applications

The provisions of UAE Cabinet Decision No. 9 of 2015 do not make any provision for applications, which have already been filed by the UAE Trade Mark, Patent and Copyright Offices. The increase will apply to any fees, which fall due on or after 29 May 2015.

The size of the fee increases will no doubt take many by surprise and questions will be asked about their purpose. They may have been intended to raise additional revenue for the UAE government, but if there is a decrease in the number of applications being filed because of the fee increases, revenue may actually decrease. The Ministry may be taking a gamble that the desire for IP registration in the UAE is greater than the deterrent effect of the high costs (possibly now the highest in the world). The extraordinary fee increases in relation to oppositions and appeals do seem to be designed to reduce the number of such cases being filed thereby reducing the Ministry workload and staff costs.

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*Iran*

## Protection of Intellectual Property Rights in the Islamic Republic of Iran

### Guiding Principle

*Intellectual property rights (IPRs) is a legal concept, which determines the manner of protection and the use of human intellectual creation. Protection of intellectual property and compilation of legal regulations in this regard have a long history in Iran. Moreover, new efforts for promotion of technological innovations in Iran during the recent years, have forced the Iranian officials and policy makers to pay more attention*

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*to the IPRs system.*

### **A. Introduction**

One of the essential core of commercial transactions, taking place every day, consists of assets such as brands, know-how and technologies, which requires considerable diligence when entering into these transactions. The commercial values of such transactions largely revolve around intellectual property rights (“IPRs”). Intellectual property rights cover several types of legally recognized rights arising from some type of intellectual creativity. Intellectual property rights typically include:

- 1) Copyright and related rights;
- 2) Industrial property.

International awareness of the importance of IPRs protection is continuously growing. The industrialized countries suffer enormous losses in their export markets year by year due to faked products and imitated IPRs. Therefore, all major export countries endeavor to achieve an improvement in industrial property legislation worldwide. Protecting an intellectual property right against imitators is of utmost importance, in particular in areas like Iran, where faked products are constantly penetrating the market.

Most intellectual property rights require formal registration with the competent authorities in order to exist and/or have full legal effect. The registration process varies based on the nature of intellectual property right and country of registration. A registration certificate is usually issued by the competent authority as evidence of registration of intellectual property rights.

### **B. Intellectual Property Legislations in Iran**

As evident, IP protection in Iran started with trademark protection in 1925. At later stage, the Patent and Trademark Registration Act of Iran, translated from the laws of European countries, was initially enforced in 1931, and its executive regulations were amended in 1958, mainly in order to conform the old 80 classes of goods and services to the new 36 classes of international classification.

Recent years have witnessed a surge of interest in revamping the IPRs system of Iran. As a case in point, Art. 45 of the fourth economic, social and cultural development plan of Iran (2005–2010) calls on the government to design and implement a comprehensive IP system to encourage the development of knowledge-based products and commercialization of research results. This section attempts to document and critique the latest developments in the IP scene.

Therefore, on October 28, 2007, the Law of Registration of Patents, Industrial Designs and Trademarks (abbrev. “IR-PIT”) was approved by the Judicial Committee of the Islamic Consultative Assembly<sup>1</sup>, to supersede the Patent and Trademark Registration Act, according to which, industrial designs and

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<sup>1</sup> The Law was approved in the course of a session of the Judicial Committee of the Islamic Consultative Assembly on October 28, 2007 and was subsequently confirmed by the Guardians Council on February 12, 2008. It was published in Official Gazette No.18389 on April 20, 2008.

geographical indications were not registrable. The Executive Regulations of the Law of Registration of Patents, Industrial Designs and Trademarks was approved on January 20, 2009.

The Law offers the opportunity to guarantee the protection by registering all types of IPRs in the Iran. This law aims to create a balance between monopoly of rights resulting from innovations in the fields of science and traditional knowledge and protection of public interest against excessive intellectual property protection, whilst at the same time harmonizing itself with international agreements on intellectual property rights.

Amongst others, the Law introduces provisions for substantive examination of patent applications, protection for industrial designs, amending the trademark regime and introduces criminal penalties for infringement of intellectual property rights.

### C. Access to International Treaties

Iran is a member of the World Intellectual Property Organization (WIPO)<sup>2</sup> since 2002 and has acceded to several WIPO intellectual-property treaties. Iran joined the Convention for the Protection of Industrial Property (Paris Convention)<sup>3</sup> in 1959. In December 2003 Iran became a party to the Madrid Agreement and the Madrid

Protocol for the International Registration of Marks<sup>4</sup>. In 2005 Iran joined the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration<sup>5</sup>, which ensures the protection of geographical names associated with products. As in February 2008, Iran had yet to accede to the Hague Agreement for the Protection of Industrial Designs<sup>6</sup>.

<sup>4</sup> The Madrid system (officially the Madrid system for the international registration of marks) is the primary international system for facilitating the registration of trademarks in multiple jurisdictions around the world. Its legal basis is the multilateral treaty Madrid Agreement Concerning the International Registration of Marks of 1891, as well as the Protocol Relating to the Madrid Agreement (1989). For more information please see the following link: <http://www.madridprotocol.info/ProtocolText.pdf>

<sup>5</sup> The Lisbon Agreement, concluded in 1958, was revised in Stockholm in 1967, and was amended in 1979. The aim of the Lisbon Agreement is to provide for the protection of appellations of origin, that is, the “geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors” (Article 2). For more information please see the following link: [http://www.wipo.int/lisbon/en/legal\\_texts/lisbon\\_agreement.html](http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html)

<sup>6</sup> The Hague Agreement Concerning the International Deposit of Industrial Designs, also known as the Hague system provides a mechanism for registering an industrial design in several countries by means of a single application, filed in one language, with one set of fees. The system is administered by WIPO. The

<sup>2</sup> <http://www.wipo.int/portal/index.html.en>

<sup>3</sup> The Paris Convention for the Protection of Industrial Property, signed in Paris, France, on March 20, 1883. For more information please see the following link: [http://www.wipo.int/treaties/en/ip/paris/trdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trdocs_wo020.html)

#### D. Protection of Copyright and related Rights in Iran

Copyright and all related rights are protected under the Law for Protection of Authors, Composers and Artists Rights, enacted in 1970 and the Law of Translation and Reproduction of Books, Periodicals and Audio Works, enacted in 1973. These works on the Internet are also protected under the Electronic Commerce Act<sup>7</sup>, enacted in 2003. Iran has not acceded to any International Convention or Agreement on Copyright and Related Rights Protection (e.g. Bern and Rome Convention).

#### E. Protection of Industrial Property in Iran

Based on the Paris Convention, in particular Art. 10(2), industrial property consists of the following subjects:

1. patents;
2. utility models;
3. industrial designs;
4. trademarks;
5. service marks;
6. trade names;
7. indication of source;

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Hague Agreement consists of several separate treaties. Countries can sign up to the 1960 (Hague) Act, the 1999 (Geneva) Act, or both (the 1934 Act is frozen as of January 1, 2010). If a country signs up to only one Act, then applicants from that country can only use the Hague system to obtain protection for their designs in other countries which are signed up to the same Act. For more information please see the following link: [http://www.wipo.int/hague/en/legal\\_texts](http://www.wipo.int/hague/en/legal_texts)

<sup>7</sup> Electronic Commerce Act was enacted by the Islamic Consultative Assembly on 07.01.2004 and was ratified by the Guardian Council on 07.01.2004.

8. appellations of origin; and
9. the repression of unfair competition.

Iranian laws and regulations provide specific legal rules protecting a number of the above subjects.

#### I. Patent

Based on Art. 1 IR-PIT, a patent is the fruit of the intellectual endeavours of one or more individuals who, for the first time, come up with a special new process or product and solve a problem in a vocation, trade, technology, industry and the like. According to Art. 2 IR-PIT, having the following prerequisites is required a patent is accepted for registration:

- a) New initiative: It means the elements that did not exist in the previous technology or industry and were not known to ordinary holders of skills in that profession. Such initiative needs to be an applied invention and innovation from an industrial prospect that can be manufactured or used in an industrial field.
- b) Industrial usage: By industry, the vastest application, including handicrafts, agriculture, fishing and services, has been taken into consideration.

The following instances may not be covered by IR-PIT, if the subject of the patent is:

- Discoveries, scientific theories, mathematical methods and works of art.
- Designs, procedures or methods for carrying out commercial activities and other intellectual and social activities.
- Methods of diagnosis and treatment of

human or animal diseases.

- Genetic resources and genetic components thereof as well as the biological processes of their production.
- Any and all matters already known in technologies and industries of the past.
- The patents, the exploitation of which shall be contrary to the Rules of Sharia or public order and good social morals.

Under IR-PIT, patent rights shall belong exclusively to the inventor thereof. The rights under patent may be freely transferred and made over to another. In case of death of a holder of patent, the rights thereunder shall be transferred to the heirs.

Intellectual property rights, when they exist, have a specific life-time. The life-time of a patent in Iran is 20 years from the time of filing.

## II. Trademark

A Trademark is not only a name or a logo and its value is not restricted to the mark as such. The name or the logo which is used as a trademark is attached to and representing a product or service. Its value stands for the market value of the product, which was created by developing a high quality product and by winning the confidence of a wide range of customers, by promoting, advertising and marketing it through the years. The trademark guarantees the customer the constant quality of a certain product. Well known trademarks have a tremendous value, which should not be underestimated. Therefore, when assessing the value of a trademark

special consideration should be awarded to the goodwill of the trademark. As opposed to patents, which lose value with age (after 20 years a patent becomes part of the public domain), trademarks gain value over time.

Trademark in Iran may be any word, name, slogan, symbol, device, package design or combination of these that serves to identify and distinguish a product from others in the marketplace and is also used to identify its source. Based on Art.30 IR-PIT, trademarks means any visible sign by the use of which it shall be possible to distinguish the commodities and services offered by natural persons and legal entities.

An application of registration of a mark shall be submitted to the Trademark Registration Bureau together with a sample of the mark and the list of the goods and services for which registration of the mark has been applied, on the basis of the classification that is being enforced or on the basis of the international classification.

The period of validity of registration of a mark shall be ten years after the date of filing the application of registration. This period may be extended repeatedly, at the request of the proprietor thereof, for further ten-year periods, by payment of applicable charges.

The exclusive right of exploitation of a mark shall belong to the one who registered that mark, according to the provisions of IR-PIT.

Exploitation and use of any mark registered in Iran, by anyone except the proprietor of the mark, shall be subject to agreement by proprietor. A proprietor of a registered mark may file suit with

court against anyone making use of his mark without any agreement or against anyone who commits an act that shall customarily result in violation of the rights of the proprietor of a registered mark. Such rights include the instances where a mark similar to the registered mark has been used for sale of goods for services similar to those sold with the registered mark thereby causing misleading of the public.

Apart from IR-PIT, Art. 66 of Electronic Commerce Act provides the protection of trademarks and domain names on the Internet. Also, Art. 76 provides the imprisonment and the fine for the infringement of right of owner trademark.

### III. Industrial Designs

According to Art. 20 IR-PIT, any combination of lines or colours and combinations of 3 dimension shapes and figures with lines and/or colours or without such elements, but to such extent that the combination or profile of an industrial design or a product of handicrafts shall change, will be regarded as industrial design.

An industrial design may be registered only in case it shall be novel and genuine. An industrial design shall be novel when prior to publication of notice, it was not known or disclosed to the public, in any part of the world.

Exploitation and use of any industrial design registered in Iran, by any person, shall be subject to agreement by the proprietor of the industrial design.

The period of validity of an industrial design shall be five years after the date of filing the statement of registration.

This period may be extended for two more consecutive five year periods by paying the relevant charges.

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## Trademark Protection in the Kurdish Region of Iraq

### Guiding Principle

*The Trademark Office of the Kurdish Region of Iraq adopted the currently applicable schedule of fees of the Trademark Office of Baghdad by virtue of Ministerial Resolution No. 3306 dated on April 1, 2013. This decision became effective as of June 1, 2013.*

Currently there are two Trademark Offices operating in Iraq: One in Baghdad and another one since recently in Erbil in the Kurdish Region. In principle, the registration of trademarks at the Trademark Office of Baghdad covers the whole country including the Kurdish Region. Nevertheless, trademark owners now have the option of seeking additional local protection in this territory at the Trademark Office in Kurdish Region itself. Owners may either choose to file new applications or to validate the registrations that they already have in Baghdad before the Kurdish Trademark Office was established. One fundamental advantage of having trademarks protected in the Kurdish Region (other than providing a central registry in this territory) is that the Kurdish Trademark Offices may start

placing the marks on watch at the Customs, allowing for an ex-officio border system.

The question of which route is to be considered in the Kurdish Region (validation or a new application) mainly depends on the particulars of the trademark portfolio in Iraq. Needless to say, if the trademarks are already registered at the Trademark Office of Baghdad, it would be logical to assume that validation at the Trademark Office of the Kurdish Region is the better option. This process would entail the submission of a certified copy of the Iraqi registration as documentary evidence. However, various steps are involved in the process and because both the Trademark Offices of Baghdad and the Kurdish Region are involved in the implementation, delays are to be expected. Therefore, in some instances, even if the trademarks are already registered at the Trademark Office of Baghdad, choosing to file directly at the Trademark Office of the Kurdish Region can be preferable.

The bottom line is that seeking local protection in the Kurdish Region of Iraq cannot be assessed in black-and-white terms. There are no clear-cut answers to the questions of whether or not protection is necessary, or even the question of which route to pursue. This will all depend on the circumstances involved and on the level of risk that the business is willing to take. In short, protection in the Kurdish Region may be advisable in certain situations noting that the more solid the portfolio is, the better the position of the trademark owners will be in bringing an infringement claim in the future. Trademark owners should of

course seek sound advice before they decide on the best route to pursue.

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### Saudi Arabia

## At a Glance - Trademark Registration in Saudi Arabia

### Guiding Principle

*Trademarks in Saudi Arabia may be registered by Saudi citizens or entities; Saudi and foreign residents licensed to reside and practice commercial or handicraft business in Saudi Arabia; citizens of countries treating the Kingdom by reciprocity or citizens or residents of countries which are member of the relevant multilateral international conventions.*

### A. Trademark Definition under the Saudi Laws

The Saudi Trademark Law (“SA-TML”)<sup>8</sup> has defined the trademark as “the names with a distinguish figure, signatures, words, letters, drawings, symbols, stamps, reliefs, or any other indication or group of indications. This name can be recognized by sight and used for distinction of the industrial, commercial, handicraft, agriculture products or the project of benefiting from the forests or natural resources, or

<sup>8</sup> The Saudi Arabian Trademark Statute (Law) promulgated by the Royal Decree No. M/21 dated 28.05.1423 A.H. corresponding to 07.08.2002.

to indicate that the object holding the trademark is owned by the owner of the trademark as its manufacture, the one who preselected, invent it, trading it or to distinct its services”.

### **B. Registering the Trademark for Categories of Products or Services**

In line with the above definition, the trademark may be register for a single or multiple category of products or services. These categories are determined in line with the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks<sup>9</sup>. This Agreement has established a classification of goods and services for the purpose of registering trademarks and service marks internationally. The concerned authorities at the member states must indicate, in official documents and publications in connection with each registration, the numbers of the classes of the classification to which the goods or services for which the mark is registered belong.

### **C. Priority**

Priority is the right of getting benefit of registering the trademark based on the date of a prior request submitted at a country member of a multilateral international convention or at a country

<sup>9</sup> The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957 as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979. The date of Egypt’s accession is 18.06.1999.

treating Saudi Arabia with reciprocity. Such right expire by the lapse of six months from the date of submitting the prior request.

### **D. Objection of Registration**

Objection to registering a trademark should be submitted before the Saudi Board of Grievances (“SA-BoG”) within 90 days from the date of publishing the trademark at the website of the Saudi Ministry of Commerce & Industry (“SA-MoCI”).

### **E. Registration Effects**

If the request for registering the trademark is approved, it will be registered from the date of submitting the request and for the period of 10 years and may be renewed latest before the lapse of six months following the last year. No one except the owner could use it without obtaining his/her/its approval first.

Not using the trademark for five subsequent years allows the SA-MoCI or anyone having interest to request canceling the registration. The SA-BoG is the concerned authority of considering such requests. If a cancelation order is issued, the canceled trademark may not be used for the same or similar products/services it used to be registered for, until the elapse of 3 years from the date of cancelation.

### **F. Registration Procedures**

The process for registering a trademark may be done only through a local licensed agent. This is done totally electronically through the website of the SA-MoCI. After submitting the request electronically, the SA-MoCI will study it and within 60 days it should give its

decision. If the request is approved, the trademark will be published for 90 days at the Ministry's website. By the lapse of this period with no objection against the registration, an electronic certificate of registration will be issued in the name of the owner.

### G. Penalties

Article 43 SA-TML stipulates that infringing the rights of the trademark owner shall be punished by a fine no less than SR 50,000<sup>10</sup> and no more than SR 1,000,000.

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**Egypt**

## At a Glance – Trademark Registration in Egypt

### Guiding Principle

*As a result of the concerned international conventions and treaties, terms and procedures for registering trademarks are quite similar around the world. Egypt is no exception; the country is a member of all the respective agreements and its intellectual protection law does recognize the international rules.*

### A. International Legalizations

Prior to establishing the World Intellectual Property Organization

(WIPO)<sup>11</sup>, the Madrid Agreement concerning the International Registration of Marks and the relevant Protocol<sup>12</sup> was the first international system for protecting trademarks.

Subsequently, additional standards concerning the scope and use of intellectual property rights including trademarks were introduced by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)<sup>13</sup>. The TRIPS imposed general obligations on the state members, requiring and determining criminal procedures for infringing the intellectual property rights.

To complement the rules for regulating the protection and registration of trademarks, the Nice Agreement Concerning the International Classification of Goods and Services for

<sup>11</sup> The World Intellectual Property Organization (WIPO) formed by the Convention Establishing the World Intellectual Property Organization signed at Stockholm on July 14, 1967 and as amended on September 28, 1979. The date of Egypt's accession is 21.04.1975.

<sup>12</sup> The Madrid Agreement concerning the International Registration of Marks of April 14, 1891 as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 15, 1957, and at Stockholm on July 14, 1967, and as amended on September 28, 1979. The date of Egypt's accession is 01.07.1952.

<sup>13</sup> The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994. The date of Egypt's accession is 06.04.1999.

<sup>10</sup> € 1 = ريال Saudi Riyal 3.98.

the Purposes of the Registration of Marks<sup>14</sup> established a classification of goods and services for the purposes of registering trademarks and service marks. The concerned authorities at the member states must indicate, in official documents and publications in connection with each registration, the numbers of the classes of the classification to which the goods or services for which the mark is registered belong.

Finally, the Trademark Law Treaty<sup>15</sup> was issued for unifying the procedures of registering the national and regional trademarks to be the latest part of the regime governing the trademark registration globally.

### **B. Local Legalizations**

Egypt enacted its local concerned regulations in line with the above conventions and treaties being a member of all of them.

In 2002, the Egyptian Intellectual Protection Law No. 82 (“EG-IPL”)<sup>16</sup> was

enacted to replace the long standing previous Law No. 57 for the year 1939. The EG-IPL defines trademarks as what distinguishes each product from others.

The process for finalizing the registration of a trademark in Egypt takes between 12 to 16 months. The registration of a trademark grants the owner a period of ten years and renewable for similar period(s) as long the owner pays the due fees.

The priority is granted for applicants in other member states of the WTO or the states applies reciprocity with Egypt. The applicant may within the following six months to submit a request to the concerned authority in Egypt with a similar request for the same trademark and products.

Art. 113 EG-IPL stipulates that anyone who infringes or uses a registered trademark owned by other shall be punished with imprisonment for a period no less than two months. In addition a fine no less than five thousand Egyptian Pounds and no more than twenty thousand Egyptian Pounds will be imposed or one of these two punishment. The confiscation of the materials subject of the infringement and the closure of the establishment used by the convicted in the infringement for a period no more than six months.

If five years elapsed with no use of the trademark, the registration will be canceled.

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industrial forms and the law No. 354 for the year 1954 concerning the copy rights.

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<sup>14</sup> The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957 as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979. The date of Egypt’s accession is 18.06.1999.

<sup>15</sup> The Trademark Law Treaty done at Geneva on October 27, 1994. The date of Egypt’s accession 07.10.1999.

<sup>16</sup> The Egyptian Intellectual Protection Law No. 82 for the year 2002 promulgated on 03.06.2002 replacing the long standing previous law No. 57 for the year 1939, the law No. 132 for the year 1949 concerning the patents, designs and

**C. Procedures of Registering a Trademark**

1. Depositing the required documents for submitting a request to register a trademark.
2. The concerned authority shall carry out technical inspection.
3. The concerned authority shall either approve the registration with or without condition or will refuse to register the trademark.
4. The applicant may appeal the decision of the concerned authority if it accepted the registration with a condition or refused to register the trademark.
5. The applicant shall publish the trademark if he received the approval of the concerned authority in three newspaper (the official gazette and two local newspaper).
6. If no party objects to the registration of the trademark within month from the date of publication, the concerned authority shall issue a certificate of registration to the applicant.

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