

# AGIP Bulletin



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## AGIP Receives MIP’s Middle East IP Firm of the Year Award for 2019

LONDON – Abu-Ghazaleh Intellectual Property (AGIP) was awarded ‘Middle East IP Firm of the Year 2019’ at the Managing Intellectual Property (MIP) Annual IP Awards Ceremony held at the Royal Lancaster Hotel, London, on March 7, 2019.

The MIP Awards recognize achievements in IP work over the past year in areas such as prosecution, litigation, licensing or other works. According to survey results released last month, AGIP was ranked in Tier One for trademark, patent and copyright prosecution in all Arab countries.

This is the 10th year that AGIP has earned regional recognition for its outstanding IP practices in the Middle East and for its continuous efforts in providing its clients with the best-quality services in the field of IP protection.

Ms. Dima Naber, AGIP Counsel and International Business Development Executive Director, accepted the award on behalf of AGIP, saying: “We are very proud to receive this prestigious award, which we consider as a testament to the dedication and innovative approaches of AGIP to deliver above and beyond expectations.”

“Over the years, AGIP has reached greater levels of



success, and our clients have trusted us with the quality of IP services. This award recognizes their confidence and loyalty in our services,” she added.



Managing Intellectual Property hosted the Annual IP Awards 2019 in front of nearly 380 IP professionals, representing 40 countries, 80 private practice firms, and including about 90 corporate/in-house practitioners.

It is worth mentioning that the MIP’s 2019 survey is the largest ever, covering 75 jurisdictions, and that its results are based on extensive research and interviews with practitioners worldwide.

## Meet with AGIP and TAG-Legal at INTA Annual Meeting 2019 in Boston, Massachusetts

Representatives from different countries will be there to meet with our clients and gain a better understanding of your needs about IP matters in our region.

### Find us at:

The Westin Boston Waterfront  
425 Summer Street

Meeting rooms: Otis, Webster and Paine – Lobby Level

### When:

Saturday May 18th – Wednesday 22th

9:00 AM – 6:00 PM

### Our Team

1. Luay T. Abu-Ghazaleh
2. Charles Sha'ban (International Office)
3. Dima Naber (International Office)
4. Nabil Salame (Canada Liaison)
5. Motasem Abu-Ghazaleh (UAE)
6. Amjad Al-Husseini (UAE)
7. Hazem Abu-Ghazaleh (Kuwait, Oman)
8. Amro Hattab (Jordan, Palestine, Iraq)
9. Nemer Shibly (Lebanon)
10. Tarek Al-Khatib (Egypt, Sudan)



11. Ali Hijazi (Special Clients Department)
12. Akram Rabah (Saudi Arabia)
13. Noor Shangwei (China, Hong Kong)
14. Mahmood Lattouf (International Office and Iran)
15. Dema Abu-Zuleikha (TAG-Legal International)
16. Laith Damer (TAG-Legal Bahrain and Arab Countries)
17. Ahmad Al-Kassem (TAG-Legal Saudi Arabia)
18. Emeka Okekeze (Nigeria)
19. Akane Kano (Japan Liaison)
20. Mireille Yadi (Special Clients Department)

In order to schedule a meeting, please contact us at [inta@agip.com](mailto:inta@agip.com)

To check the location map; please click here ([Hotel Map](#))

## AGIP Continues IP Practice Expansion with IP Portfolio Department

Abu-Ghazaleh Intellectual Property (AGIP) is launching a new service established to cover its clients' challenging Intellectual Property business needs.

The IP Portfolio Department will provide through a dedicated staff a wider scale of professional portfolio management services including IP consultancy and IP prosecution in addition to others.

Starting April 1st 2019, the IP Portfolio Department will handle all duties which were covered by the Special Clients Department and a new email address will be dedicated for the new department, noting that our previous e-mail will remain active for the time being.



Clients should expect the same high level service from AGIP staff regarding their IP portfolio needs as we tend to fully understand their business which usually respond to the fact that different clients have different needs and provide a set of solutions to achieve our clients' goals.

The IP Portfolio Department will strategically maintain and develop Trademarks Portfolios to build strong and enforceable rights; to meet and exceed our client's expectations, accordingly the IP Portfolio Department will provide the following services:

- » IP consultancy; namely:
  - IP Road-Mapping.
  - Trademark strategy and analysis.
  - Trademark portfolio review.
  - Trademark due diligence.

- IP Audit
- » IP prosecution.

For more information or any inquiries, please do not hesitate to contact us:

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## New Patent Regulation Comes into Force in Jordan

AMMAN – His Majesty King Abdullah II issued a Royal Decree approving the regulation No. 5 of 2019 amending the patent regulation in Jordan.

The new regulation brings a number of changes pertaining to applications for inventions from filing to prosecution and grant in Jordan. The key amendment introduced in the regulation stipulates the possibility to review the patent files by third party, which is in compliance with the recent Patent Law amendments.

Furthermore, the new regulation sets out the fees for filing international patent applications under the Patent Cooperation Treaty (PCT).

The new regulation was published in the Official Gazette and entered into force as of the date of its publication.



Should you have any questions concerning the updates of the patent legislation in Jordan, please contact our office in Jordan at:

[jordan@agip.com](mailto:jordan@agip.com)

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## Increase in Official Fees for IP Services in Pakistan

KARACHI – The Ministry of Commerce of Pakistan has issued an official notification stipulating that an increase in the official fees up to 50% will be applied for IP services provided in Pakistan.

As from March 9, 2019, the fees increase will be applied to all services regarding the trademarks, patents and copyrights new applications, including all the recordals (such as assignment, changes...etc.).

For more information on this matter or any inquiries, please contact AGIP Pakistan Office at the following address:

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Contact: Aamir Khan (Mr.)

## Drop in Official Fees for Trademark Services in Saudi Arabia

RIYADH – The Ministry of Commerce and Investment in Saudi Arabia issued a Ministerial Decree stipulating that the official fees for trademark services will be decreased in Saudi Arabia.

The new reduced fees will come into force once the Decree is published in the Official Gazette.

Accordingly, AGIP will amend its schedule of charges related to trademark services in Saudi Arabia.

For more information on this matter, or any inquiries,

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## Are Design Rights at Risk?!

By: *Amro Hattab*

*Executive Director/ Abu-Ghazaleh Intellectual Property (AGIP)*

### A reminder of Design definition:

Design right is a form of intellectual property rights, which aims to protect the shape of products (for 3D goods), and could be used as well for protecting images in a form of (2D products). Designs can be consisting of the creation of shapes, patterns, and/or a combination of different visual elements, including colors; to produce a certain product or commodity.



Designs and Models can be presented in different forms, such as a glassware, vehicle, furniture, software and application icons, toys and packaging. The main goal of filing a design right is to protect the outer-shape of a product, the ornament side, but never the functionality of that design.

Within IP rights, design could be the most variable one between countries and regions, as the validity of design varies between 10 to 25 years, some of them are subject to renewals or annuities, while in some other countries, no renewal is needed to maintain the validity of the subject design.

Another variable is related to novelty condition, where design application has to be new in order to be granted in most countries; while in other countries, no such condition is required, however, novelty is rarely examined for design applications. Yet, it is of real essential to file the design before any public disclosure (despite of the availability of grace period in some countries), to maintain the originality of the subject design.

Similar to Madrid system for TMs; it is possible to file one application of multiple designs (up to 100 designs) in several countries/regions (69 territories) through Hague system. All of which are in one application, one language and one set of fees.

### Design Application in the Middle East & North Africa:

Despite of the fact that most countries within the region share same language, culture and maybe history as well, yet when it comes to IP, major differences will be sought, and Design law is very much the same.

For example, the option of having a design registration in Qatar is not available, while in other countries design law is available for prosecution; but enforcement wise there are some challenges. Below is a summary of major differences:

Country	Design Term (Validity)	Novelty Requirements (Absolute) Mandatory (Yes)/Not Mandatory (No)
Algeria	10 years - Renewable for 10 years	Yes
Bahrain	10 years – Renewable for 5 years	Yes
Egypt	15 years – Renewable for 5 years	Yes
Gaza	15 years – Renewable for 5 years	Yes
Iraq	10 years – Annuity per year	Yes
Jordan	15 years – Not Renewable	Yes
Kuwait	15 years – Not Renewable	No
Lebanon	25 years -Renewable once for 25 years	Yes
Morocco	25 years – Renewable for 5 years	No
Oman	15 years – Renewable for 5 years	Yes
Pakistan	10 years – Renewable for 10 years	Yes
KSA	10 years – Annuity per year	Yes
Sudan	15 Years – Renewable for 5 years	Yes
Syria	5 years – Renewable twice for 5 yeas	Yes
Tunisia	15 years – Not Renewable	No
Turkey	25 years – Renewable for 5 years	Yes
UAE	10 years – Annuity per year	Yes
West Bank	15 years – Renewable every 5 years	Yes
Yemen	10 years – Not Renewable	Yes

### **Design Intersection with other IP Rights:**

As explained above, design rights’ main or sole purpose is to protect the visual design of a tangible object, whether in 3D or 2D format, but cannot we rely on Copyright law to protect such designs, or even consider the Trademark law for other objects?! Or maybe unfair completion law!

### **Design as a Trademark:**

So, for example would you rather protect your client’s bottle design as a 3D trademark or as an industrial design? Let us try and discuss the advantages of each alternative:

### Under Trademark law:

Longer life, as the design will be renewed indefinitely.

No novelty requirements.

Easier enforcement, especially at Borders and Customs.

### **Under Design Law:**

Shorter processing time for the registration.

Usually less costly.

Can include multiple designs within one application.

Whenever I am approached by a client seeking for a guidance on what to consider out of the two options, my answer will always remain as “it depends”. The answer to the following questions will help the client in choosing the most convenient option:

- Will this design be used for a long period over 15 years?
- Does this design present a product design out of many other products line?
- How many designs are we talking about?
- Do you consider this design a representation to your identity?
- Is this design sufficiently distinguished without any wording or logos?

If the design is to be used for a short term, and involves several versions, and still novel, then filing the same as an industrial design will be the wise option.

Otherwise, if the design is planned to represent a corporate identity, and sufficiently distinguished, and will remain in use for years to come, then trademark would be the option.

### **Design as a Copyright:**

Some patterns can be filed as copyright applications, especially the 2D ornamental designs. In such cases, would you rather file them as Design applications or as copyright? Similar to the case of the trademark, the answer depends on several variables, such as; the importance of the design, the territories where the design is to be used, the novelty, budget and number of designs. The advantages of each approach are summarized below:

### **Under Copyright law:**

Longer life.

No novelty requirements.

Official filing is not a necessity.

Much less costly.

### **Under Design Law:**

Better enforcement in some circumstances (for similarities).

Focus on commercial side of the design rather than the art side.

Licensing opportunities.

Based on the above, if the design is unique, new, original, commercially important to the owner, and very much distinctive, then consider filing the same as an industrial design makes a lot of sense. Otherwise, and if the pattern is not of high importance (part of a design), or subject change, and the budget is limited, then copyright might be the option for such uses.

### **The Hybrid Era:**

Why cannot we have both rights for the same design? Why cannot we start with one IP right and then move to the other available option before the expiry of the first one?

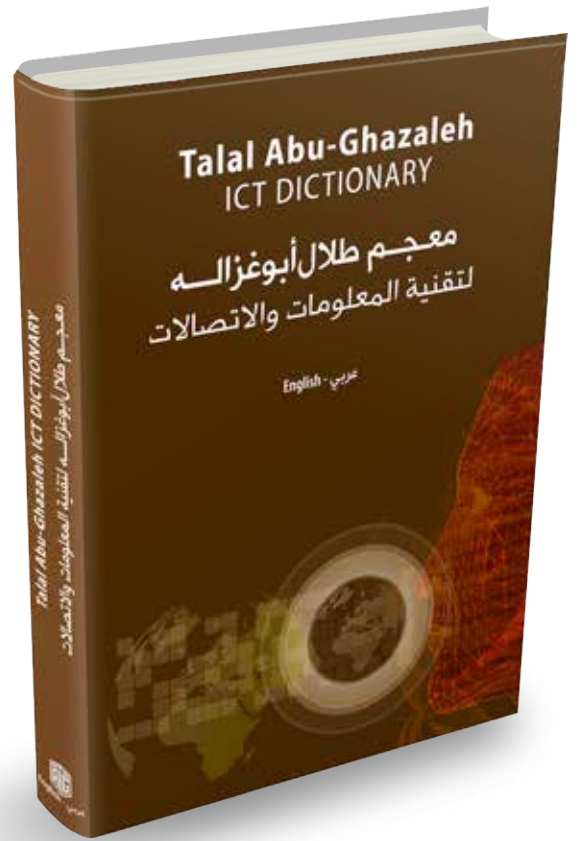
This is becoming very common now, especially when filing a design as a 3D TM, where such application is usually rejected, unless proved to be distinctive over time, and using the design for a considerable period will definitely support such entitlement. So, the reasonable approach is to start with the design application as Industrial design and then (just before the expiration of the design) to convert the same into a 3D TM.

Same scenario can be also considered for filing 2D design, where we can apply it as an Industrial Design as well as a CR. In fact, we applied for Industrial designs in the countries where the product is commercially used, while in other countries, where product is scheduled to be shipped in few years' time, it was filed as a CR.

This explain the fact that despite of the intersection between ID and other IP rights, the numbers for new filings are steadily increasing (almost %5 a year) in major regions, namely US & EU, as many owners are in fact considering the hybrid option for their products.

Finally, I would like to emphasize that there are no set or static best practice for such cases, as there are too many variables that are needed to be examined and considered when choosing the suitable IP right to protect your design.

# Second Updated Version of TAG-ICT Dictionary Issued



AMMAN - Talal Abu-Ghazaleh Organization (TAG-Org) has issued the second updated version of TAG-ICT Dictionary, after updating its input and inserting a new set of terms used in daily life, due to the fact that past months witnessed the launch of a large number of concepts, terms, technologies, application and protocols of communication.

HE Dr. Talal Abu-Ghazaleh, TAG-Org chairman, said in the dictionary introduction that ICT plays a significant role in our life, and helps our society change into a Knowledge society.

He added that the contribution value of individuals or groups is measured by the contributions produced by thought and innovation.

For example, it has been easy and necessary to teach the new generation throughout all stages, using electronic means.

Dr. Abu-Ghazaleh reiterated his intention to continue updating and developing the dictionaries issued by TAG-Org which are, in addition to TAG-ICT Dictionary: Talal Abu-Ghazaleh Intellectual Property Dictionary, TAG Dictionary of Legal Terms, TAG Accountancy and Business Dictionary, Talal Abu-Ghazaleh Dictionary of Patents and Talal Abu-Ghazaleh Collocations Dictionary.

He also explained that these publications aim at enriching the Arabic language references, and contribute to knowledge dissemination amongst students and all business sectors, through specialized scientific and professional publications.



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