



Abu-Ghazaleh Calls for Implementing a System to Protect Geographical Indications



JEDDAH - The First Arab Forum for the Protection of Consumers from Commercial Fraud concluded in Jeddah on October 21, 2008. The Forum was inaugurated by Prince Khalid Al-

Faisal, the governor of Makkah Region, with the attendance of a number of ministers, ambassadors and experts from the Kingdom of Saudi Arabia, Arab countries, and globally. Also in attendance was the Assistant Secretary General of the League of Arab States.

President of the Arab Society of Intellectual Property (ASIP) and Chairman of the Talal Abu-Ghazaleh Organization Talal Abu-Ghazaleh spoke at the Forum, and called for a system that protects geographical indications and famous names. He pointed out to targeted Arab regions such as Makkah since it carries a particular sanctity, in addition to Petra in Jordan, and some products of Arab countries like the oranges of Jaffa and Lebanese tabbouleh.

Abu-Ghazaleh expressed ASIP's willingness, along with Abu-Ghazaleh Intellectual Property (AGIP), to put in place a system for protecting indications and creating a bank of data/information, in collaboration with the League of Arab States and the World Intellectual Property Organization (WIPO).

He also pointed out to the potential of establishing a

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cooperative Arab agreement to protect geographical indications, and offered to establish an Arab organization to protect famous brand names under the umbrella of the Arab League and in cooperation with ASIP.

Further, the Representative of the European Union Luke Divan emphasized the EU's readiness to collaborate with the initiative launched by Abu-Ghazaleh in the field of protecting geographical indications and famous brand names. He stated that the EU "developed a special structure to protect Intellectual Property."

In addition, the Coordinator of Combating Commercial Fraud at the World Customs Organization Christopher Zimmerman expressed the preparedness of his organization to provide support to the Abu-Ghazaleh initiative.



It is worth noting that the Arab Forum for the Protection of Consumers from Commercial Fraud and Products' Counterfeiting was organized by the Saudi Administration of Customs in cooperation with the Arab League and the Islamic Chamber of Commerce and Industry.

It represents an extension of Saudi governmental efforts that aim to protect the consumer and combat commercial fraud and products' counterfeiting, through the issuance

of legislations and schemes that limit and eventually eradicate these phenomena. The Forum represents an opportunity to exchange expertise and information, and promote consumer awareness of the dangers resulting from the usage of counterfeit products. The list of speakers included global decision-makers in this area; IP rights owners and institutions involved in these combative efforts. *ag-IP-news*

TAG-LEGAL at the Berytech Conference

BEIRUT – Talal Abu-Ghazaleh Legal (TAG-LEGAL), a member of Talal Abu-Ghazaleh Organization (TAG-Org), took part on October 9, 2008 in a conference on the Fundamental Principles of Intellectual Property Protection and International Patent Protection Routes & Treaties hosted by Lebanon-based Berytech.

The conference, presented by the US attorney Mr. Mark Abumeri, discussed the state of IP practice in Lebanon and the nature of inquiries received from Lebanese inventors. The event covered two main topics: recent developments in the US patent system and practice where there have been significant legislations proposed.

Dr. Sylvain Massaad, TAG-LEGAL Copyright Department Manager applauded the event saying: "The conference revealed the growing importance of patent-related services worldwide, and latest developments achieved in the field" said Dr. Massaad.

At the end of the meeting, a platform for discussion was opened for the audience where several questions regarding cautionary measures, the relevance of patenting in certain cases, as well as changes in the invention whilst patenting were addressed.

Following this visit to Lebanon; Mr. Abumeri is heading to Singapore and Sydney in order to introduce IP litigation management and procedures in the US. Attending the event were lawyers, entrepreneurs and university lecturers.



Berytech is the first facility in Lebanon offering, high added value services related to scientific research; technological innovation; economic dynamism and business experience.

Mr. Mark Abumeri is a partner at Knobbe Martens Olson & Bear LLP in the US. He is involved in the practice of all aspects of Intellectual Property (IP) law. He is also an adjunct professor of law at Thomas Jefferson School of Law, and serves as a Judge pro tem in the Superior Court. Abumeri obtained a B.S. in Electrical and Biomedical Engineering from Case Western Reserve University in 1988, M.S. in Electrical Engineering from Rochester Institute of Technology in 1992, and a Juris Doctor (J.D.) degree from the University of Cincinnati, College of Law in 1996



The National Symposium on IP Education & Research Inaugurated

AMMAN - The National Symposium on Intellectual Property (IP) Education & Research held under the patronage of HE Minister of Culture Nancy Bakeer was inaugurated on October 13, 2008, at Talal Abu-Ghazaleh College of Business (TAG-College).

In his opening remarks at the two-day Symposium, Mr. Talal Abu-Ghazaleh, chairman and CEO of Talal Abu-Ghazaleh Organization (TAG-Org) stressed the importance of protecting Intellectual Property Rights (IPRs) and their outcome on national economies.

“We will suggest establishing an Arab society for geographical indications under the umbrella of the Arab League and a second society that will target Arab brand names,” Abu-Ghazaleh said. (he already did).

Abu-Ghazaleh believes that the Arab businesses do not fully recognize the significant value of brand names and geographical indications on the national economy.

He called for establishing a database that includes geographical indications and brand names as a first step in a methodology to enable Arab brands to benefit from their intellectual capital values.

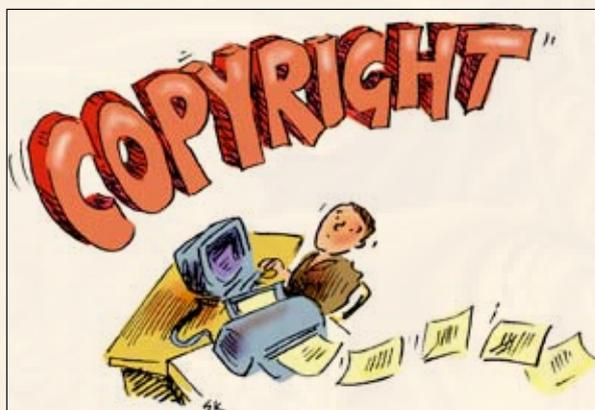
Counselor of Technical Assistance and Capacity Building Bureau for Arab Countries at the World Intellectual Property Organization (WIPO) - Geneva Mr. Samer Al Tarawneh, pointed out that the new global economy is now based on knowledge and know-how; this change has tremendously benefited developing countries to enhance their economies by utilizing their human resources and intellectual assets.

“Developing an Intellectual Property concept requires

qualified human resources through long and short term government policies which start with education,” Al Tarawneh noted.

In the first day’s sessions, speakers tackled the role of IP in knowledge, wealth creation and national development. Mr. Anil Sinha, head of the Research and Executive Program at the WIPO Worldwide Academy pointed out that this Symposium is part of efforts exerted to discuss the topic of IP knowledge and education.

“This is a brainstorming session to shed light on ways to enhance IP education in this country in particular and the region as a whole,” he stated.



The Symposium, attended by high ranking officials and experts from local, regional and international organizations is organized by WIPO in cooperation with the Jordan National Library/ Ministry of Culture and TAG-College.

WIPO is a specialized agency of the United Nations. It is dedicated to developing a

balanced and accessible international IP system, which rewards creativity, stimulates innovation and contributes to economic development while safeguarding the public interest.

Founded in 1994, the Jordan National Library plays an important role in protecting IP including copyrights. TAG-College is the first college of its kind that represents a partnership between the private and the public sectors in the Arab world. This unique partnership brings the business expertise of Talal Abu-Ghazaleh Organization to the academic world of the German Jordanian University (GJU).



AGIP Takes Part in IGF's Multistakeholder Advisory Group Meeting



GENEVA - Abu-Ghazaleh Intellectual Property (AGIP) Executive Director, Charles Sha'ban, took part in the Multistakeholder Advisory Group (MAG) meeting of the Internet Governance Forum (IGF) held in Geneva, September 17-18, 2008.

The MAG discussed the preparation of the third IGF meeting to be held in Hyderabad, India, December 3-6, 2008.

"The MAG took up the discussions on the relationship between the two types of main sessions which had been termed Open Session workshops and Main Session debate. It was agreed to rename these sessions to better reflect their nature. The morning sessions are now named 'Panel Discussions' and the afternoon sessions 'Open Dialogue,'" Sha'ban said.

The 'Panel Discussion' sessions will consist of a chairman and a moderator and approximately four panelists. Each panelist will be asked to give an initial presentation of not more than 7 minutes.

"The Panel Discussions will address issues in some depth and produce a set of questions that can be discussed in the afternoon sessions. Adequate interaction with participants will take place," Sha'ban pointed out.

On the other hand, the 'Open Dialogue' sessions are designed for a maximum interaction with participants. They will be led by a chairman and animated by a moderator.

The MAG also discussed how to approach the "formal consultations with Forum participants" on the "desirability of the continuation of the Forum" as stipulated by Paragraph 76 of the Tunis Agenda.

Sha'ban revealed that it was agreed to set aside one day during the next February consultations to gain a common understanding on how best to conduct this process.

Meanwhile, the participants suggested September 25 as a deadline for submitting the lists of panelists for the panel, and September 30 for the submission of the final program for all workshops, best practice forums, open forums and Dynamic Coalition meetings.

Chaired by the Special Adviser for Internet Governance to the UN Secretary-General, Nitin Desai, the MAG of the IGF includes members from governments, private sector and civil society, in addition to the academic and technical communities, who represent all regions of the world.

The IGF was set up by the UN Secretary-General in November 2005, at the second phase of the World Summit on the Information Society (WSIS) held in Tunisia, to discuss issues related to Internet governance.

Fake YouTube Pages Used To Spread Viruses

October 10, 2008 (BNA) – There is a sneaky new attack in which criminals create fake YouTube pages, dead-on replicas of the real site, to push their malicious software and make it look like it is safe stuff coming from a trusted source. A program circulating online helps hackers build those fake pages. Users who follow an e-mail pointing them to one of the pages see an error message that includes a link the hacker has provided to a malicious program, which delivers a virus. Once the computer is infected, it's simple for the hacker to silently redirect the victims to a real YouTube page to see videos they were hoping to see — and hide the crime.

WIPO and ARIPO sign MoU to Expand Cooperation

GENEVA - The Director General of the World Intellectual Property Organization (WIPO), Francis Gurry, and his counterpart from the African Regional Intellectual Property Organization (ARIPO), Gift H. Sibanda, signed a Memorandum of Understanding (MoU) on October 2, 2008 in Geneva, to strengthen and expand cooperation between the two organizations.

According to a press release by WIPO, the MoU covers traditional areas of cooperation relating to capacity building, as well as a special project to boost ARIPO's patent information capacity.

In addition to reinforcing WIPO and ARIPO's 30-year old collaboration, Gurry said that the agreement will boost the capacity of ARIPO member states to provide the means for research institutes, universities and the private sector to capitalize on the wealth of technical information available in patent documents.

"Improving access to and efficient use of technological information contained in patent documents is critical. WIPO will provide the necessary support to ARIPO and its member states to broaden their ability to participate more fully in the knowledge economy," he noted.

WIPO will also assist, where appropriate, in undertaking studies on the contribution of copyright-based

industries to national economies, and the role of distinctive signs, particularly geographical indications, in the promotion of domestic and export trade.

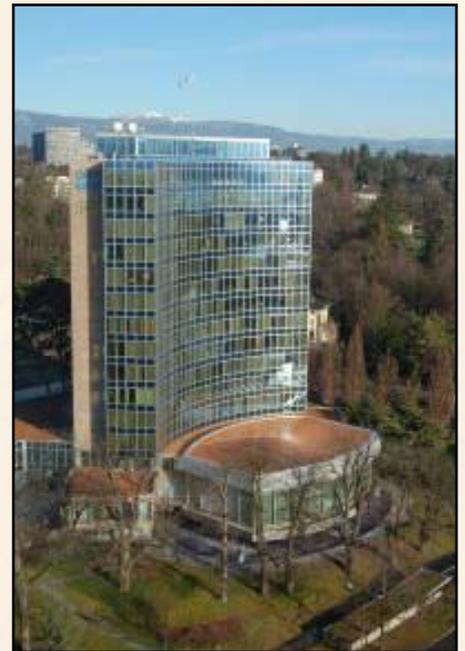
Cooperation will extend to building the capacity of copyright collective management organizations and enhancing rights management at the national and regional levels.

In addition to the provision of technical and legislative assistance, cooperation will also be strengthened in establishing a legal framework for the protection of traditional knowledge and traditional expressions of folklore.

In a separate agreement relating to patent information and the dissemination of patent documents, WIPO will provide ARIPO with the necessary technical assistance to digitize and format its patent data.

This will enable ARIPO to provide value-added patent information services to its member countries. WIPO and ARIPO will cooperate in the development of patent information tools to demonstrate the value of patent information and to increase awareness about the utilization of patent information.

The two organizations will jointly organize symposia, seminars, workshops and other training programs in the area of patent



information to address particular needs and requirements of users from ARIPO member countries.

WIPO will integrate the patent information provided by ARIPO and its member states into WIPO's PATENTSCOPE Search Service to encourage the broader dissemination and use of this data.

ARIPO, established in 1976, deals with the harmonization of IP procedures, awareness-building, and administration of IP rights among its 16 member states which include Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, United Republic of Tanzania, Uganda, Zambia and Zimbabwe. *Ag-IP News*



US President Signs PRO IP Act

WASHINGTON, DC - US President George W. Bush signed on October 13, 2008 the Prioritizing Resources and Organization for Intellectual Property (PRO-IP) Act, a press release by the White House stated. This legislation helps protect the rights of America's consumers, workers, and entrepreneurs by strengthening both its civil and criminal laws against counterfeiting and piracy.

Specifically, the Act increases statutory damage awards in civil counterfeiting cases, it strengthens remedies available in the prosecution of criminal cases involving counterfeiting and piracy, it enhances resources (personnel, training, and equipment) for Department of Justice programs that combat IP theft, and makes permanent the Administration's Strategy Targeting Organized Piracy (STOP!) Initiative and its inter-agency IP coordination efforts.

The PRO-IP Act protects the work of American innovators, strengthens the rule of law, and will help keep American families safe. Counterfeiting hurts businesses, innovators, workers, consumers, government and the national security. In recent years, counterfeiting has grown rapidly. Counterfeiting costs America hundreds of billions of dollars a year and has harmful effects throughout the economy. Fake products can expose consumers to serious health and safety risks. Government loses out on tax revenues and is forced to divert law enforcement resources. Terrorist networks use counterfeit sales to finance their operations.

The Administration is protecting IP with a bold initiative called STOP! – The Strategy Targeting Organized Piracy. In October 2004, the Bush Administration announced STOP!, which is led by the White House and brings together the Departments of Commerce, Justice, Homeland Security, State, the Food and Drug Administration, and the Office of the US Trade Representative (USTR). The PRO-IP Act broadly reflects the principles of STOP! and helps to reinforce and codify the Administration's accomplishments in protecting and strengthening the rights of American workers, consumers, and innovators.

In July 2005, the President appointed the first ever US Coordinator for International IP Enforcement to lead the STOP! Initiative under the framework of the National IP Law Enforcement Coordination Council. The Administration

established the StopFakes.gov website and STOP! Hotline to provide individuals and businesses the information they need to protect their Intellectual Property Rights (IPRs). The website includes IP toolkits to guide businesses through securing and enforcing their rights in key markets around the globe, including China, Russia, India, Brazil, Mexico, Korea, Thailand, Egypt, Malaysia and the European Union.

Over the past eight years, the Administration has led the global fight against counterfeiting and piracy. The Administration has focused its efforts on China, the global epicenter of counterfeiting and piracy, through the Joint Commission on Commerce and Trade (JCCT) and the Strategic Economic Dialogue (SED). In 2004, the Commerce Department posted the first IP attaché at US embassy in Beijing. Since then, the program has grown to include eight attachés in six embassies worldwide. The Justice Department has dedicated legal attachés at two embassies to focus on IP enforcement.

The Federal Bureau of Investigation conducted the first ever joint investigation with Chinese law enforcement counterparts. Operation "Summer Solstice" was the first ever joint investigation by the US federal law enforcement agencies with Chinese authorities. "Summer Solstice" resulted in 25 individual arrests and the seizure of counterfeit goods totaling over \$500 million, the second largest counterfeit seizure in monetary value ever. The Departments of Homeland Security and Justice have seen significant improvements in measures of IP enforcement increase over the last five years. The Department of Homeland Security reports seizures totaling \$200 million in FY2007, a 27 percent increase from the previous year.

In 2005 the Department of Commerce's US Patent and Trademark Office created the Global Intellectual Property Academy (GIPA). GIPA is a one-of-a kind education and training facility dedicated to educating and training foreign government officials on IPRs protections and enforcement. In October 2007, the Office of the USTR launched efforts to negotiate an Anti-Counterfeiting Trade Agreement (ACTA) – a groundbreaking agreement dedicated to advancing global leadership in the fight against IP theft. The Administration has pursued collaborative engagements with key trading partners throughout the last four years, including most prominently the European Union, Mexico, and Canada.

Well-Known and Famous Trademarks: Ius Gentium and Criteria / Part (I)

By Marah Al-Abweh[©]



Now that we are living in an interconnected world, purchasing internationally famous branded goods and services has increased. Modern advertising through global casting via satellite and the Internet has crossed national boundaries exposing individuals to various brands¹. For instance,

events such as the Olympic Games are estimated to be viewed by over one billion viewers on a single day, which is approximately 17% of the world's population². Moreover, traveling for purposes of business, education or tourism has assisted people to become familiar with various brands in other countries.

Brand manufacturers find themselves now part of the global marketplace and no longer confined to local markets. Free trade agreements have allowed traders to produce in bigger international markets. Therefore, well-known trademarks such as COCA-COLA, McDONALD, CARTIER, SONY, CNN, KODAK, and DHL "have virtually become household names to the global citizen"³. The protection of well-known marks has become a necessity especially when realizing that brands like COCA-COLA, MARLBORO and IBM are estimated to be worth of \$100 billion together as intellectual property assets⁴.

It should be mentioned that the recognition and protection of well-known marks differ from one country to another in terms of definition and criteria. Therefore, WIPO convened a Committee of Experts on Well-Known Marks in Geneva in 1995 and 1996 to consider "the criteria that should be applied to define what a well-known mark is"⁵. Many countries were in favor of developing the criteria, however, determining well-known marks remains a tricky issue until now.

The criteria supports the fact that a set of common principles are required to have a consistent, unified and harmonious approach regarding the recognition of well-known marks. Therefore, this paper examines the *ius gentium* or universal body of law on well-known marks in Paris Convention, TRIPS, WIPO and the Jordanian Law. Furthermore, it analyzes the set of guidelines and criteria, which trademark authorities employ when determining well-known trademarks. In addition, this paper explores

the elusive concept of well-known trademarks by comparing various available definitions. Also, parameters of well-known trademarks are examined and finally recommendations are proposed for judges who determine the fame requirements of well-known marks.

Supranational Law

A. Paris Convention:

The term "well-known" was first incorporated into the Paris Convention as early as 1925⁶. Article 6bis of the convention serves as a basis for universal application. Standards of infringement and legal sanction resulting from the unauthorized registration and use of a well-known mark are demonstrated in Article 6bis, which states⁷:

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested part, to refuse or to cancel the registration, and to prohibit the use, of a trademark, which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

B. TRIPS Agreement

Paris Convention does not provide any definitions or criteria for determining what qualifies a well-known trademark. Article 16(2) and (3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which enhance the protection of well-known trademarks, clarify this aspect as the following:

16 (2) Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a



trademark is well-known, account shall be taken of the knowledge of the trade-mark in the relevant sector of the public, including knowledge in that Member obtained as a result of the promotion of the trademark.

16 (3) Article 6bis of the Paris Convention (1967) shall apply mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

Therefore, the TRIPS Agreement provides a vital element that should be taken into account when determining what a well-known trademark is, which is “the knowledge of the trademark in the relevant sector of the public...as a result of the promotion of the trademark” 8. In other words, awareness of the mark may be measured by referring to the people who are exposed to the mark through advertising. Therefore, members can take the knowledge of the trademark as an important element of determining recognition in their legislations or practices 9. However, the members have to make national legislation about the criteria accordingly.

C. Jordanian Law:

Article 8-12 of the Trademark Law refers to the protection of well-known marks and it complies with what was stipulated in Paris Convention and TRIPS by preventing the registration of a similar or identical well-known trademark:

“The trademark which is identical or similar to, or constitutes a translation of, a well-known trademark for use on similar or identical goods to those for which that one is well-known for and whose use would cause confusion with the well-known mark, or for use of different goods in such a way as to prejudice the interests of the owner of the well-known mark and leads to believing that there is a connection between its owner and those goods as well as the marks which are similar or identical to the honorary badges, flags, and other insignia as well as the names and abbreviations relating to international or regional organizations or those that offend our Arab and Islamic age-old values 10”

Additionally, well-known trademarks are entitled to protection even if not used or registered in Jordan.

To Be Continued...

1 Brand is the term used for trademark in marketing. They are used interchangeably

2 Sponsorship Research International Statistics on Olympic Games

3 Mostert, W. Frederick, Famous and Well-Known Marks, Reed Elsevier (UK), 1997

4 Ibid.

5 WIPO memorandum on Well-Known Marks, “Protection of Well-Known Marks”, 1995.

6 Japan Patent Office, Protection of Well-Known and Famous Trademarks, Asia-Pacific Industrial Property Center, 1999.

7 See Paris Convention, Article 6bis.

8 TRIPS, 16 (2)

9 State Administration for Industry and Commerce, p.8.

10 Article 8-12 of the Trademark Law, Ministry of Industry and Trade.

Microsoft, State Of Washington Sue Fake Anti-Spyware Vendors

October 3, 2008 (BNA) - The US State of Washington and Microsoft have instituted a number of legal actions against vendors of ‘Scareware’ under the Computer Spyware Act. Alleged security programs are increasingly bombarding innocent PC users with fake messages detailing putative threats or infections. Attorney general Rob McKenna and lawyers from Microsoft’s Internet Safety Enforcement team are currently pursuing actions against Texan company Branch Software, which attempts to encourage sales of its “Registry Cleaner XP” software using targeted pop ups containing false information.



Legal Expert of the Month

Ozlem Meric



Ms. Ozlem Meric has been competently running our TAG-Legal Office in Turkey for two years now. She holds an LL.M. degree in Law of Economics with honors from Baskent University and has extensive experience in Intellectual Property matters as well as Commercial and Anti-Trust Law.

During her study for the LL.M. degree, Ms. Meric completed her projects in Trademarks, Alternative Dispute Resolution, Unfair Competition and Anti-Trust Law in addition to Joint Ventures and Interest-Free Banking Systems, where she later had the chance to undertake business projects for the World Bank.

Ms. Meric attended several national and international conferences as well as summits where she represented TAG-Legal such as the annual meeting of The International Trademark Association (INTA), The Pharmaceutical Trade Marks Group (PTMG), and the Islamic Leadership Summit.

Ms. Meric successfully completed various WIPO Advanced Courses in Trademarks and Patents, and she recently enrolled for the MBA degree in Bilgi University where she plans to complete her degree with a thesis on International Marketing Management.

Ms. Meric is a member of the Turkish Bar Association as well as the founder and the current treasurer of Technology and License Managers Association.



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