

Oman Implements the GCC Trademarks Law

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As a background, the GCC Trademarks Law was initially submitted by the GCC General Secretariat and approved by the GCC Trade Cooperation Committee in 1987, but it was only used by the Member States for consultative purposes and there has been no direct application of the law. Further amendments were made in 2006 and 2013 and the law was published in the GCC Official Gazette. Nevertheless, the Trademark Law did not come into force, until the Implementing Regulations were issued in December 2015.

Since the issuance of the Implementing Regulations, Saudi Arabia, Bahrain and Kuwait have fully enforced the GCC Trademarks Law and it replaced their national trademarks law. Now that Oman has now implemented the GCC Trademarks Law as well, the UAE and Qatar are the remaining two states to left to implement it. Qatar issued Law No. 18 of 2007 ratifying the GCC Trademarks Law, which was later repealed by Law No. 7 of 2014 on 8 June 2014 which provides that it will automatically become effective in Qatar, six months after the issuance of the Implementing Regulations. Qatar has yet to publish the Implementing Regulations in its official gazette; hence the law has yet to come into force in Qatar. As for the UAE, it issued the Federal Decree No. 52 of 2007 ratifying the GCC Trademarks Law; however, no further ratification was made for the amended form of the GCC Trademarks Law of 2013. It still remains unclear when the UAE will issue or ratify the amended GCC Trademarks Law and its Implementing Regulations.

In this article we will highlight the main features of the GCC Trademarks Law that differ from the Oman national Trademarks law.

The Main Features of the GCC Trademarks Law:

Well-known Trademarks

The GCC Trademarks Law provides clear criteria as to the determination of well-known trademarks. Such criteria are similar to those provided by the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. In summary, for a mark to be declared as well-known, consideration shall be taken for the extent of recognition by consumers resulting from the marketing efforts of the trademark owner; the duration and extent of the registration and use of the mark or the number of countries where the trademark has been registered or recognized as a well-known mark; or the value of the mark and the extent to which such value helps promote the products or services to which it is applied.

Examination

The GCC Trademarks Law and its Implementing Regulations provide a certain timeline for the examination of trademark applications, which according to Article (6) of the Implementing Regulations is ninety days from the date of filing. This is a very good development as it expedites the process and will help in clearing any backlogs at the Trademarks Office. In addition, in the event that the Trademarks Office issues a request after examination of an application, a response shall be made within ninety days. While it is a long period, it should be sufficient for applicants to prepare any documents requested or apply any conditions

requested by the Trademarks Office.

Appeals to the Trademarks Office's decision rejecting an application shall be filed within sixty days to the Objections Committee. The decisions of the Objections Committee are also subject to appeal to the court within sixty days.

Oppositions

The GCC Trademarks Law provides period of sixty days for opposition against published trademark applications. Currently the opposition period in Oman is ninety days.

Response to opposition shall be made within sixty days of notification, otherwise, the application will be considered abandoned. A hearing session could be assigned and the Trademarks Office shall issue its decision within ninety days from the hearing session.

Another change in the process of the opposition according to the GCC Trademarks Law is that the trademarks Office's decisions issued in oppositions shall be subject to appeal directly to the Court. The current practice is that decisions in oppositions are appealable to a Trademarks Office within the relevant Ministry, with a further chance to appeal to the Court afterwards.

Penalties

The penalties for trademark infringement have been increased. According to the GCC Trademarks Law, the penalties are as follows:

A fine between OMR 500 (approx. USD 1,300) and OMR 100,000 (approx. USD 260,000) and/or imprisonment for between one month and three years where a person counterfeits a registered trademark in a manner which misleads the public, a person who in bad faith used a counterfeit trademark and who affixes this mark to its products in bad faith; and

A fine of between OMR 100 (approx. USD 260) and OMR 10,000 (approximately USD 26,000) and/or imprisonment for between one month and one year when a person knowingly sells goods which contains a counterfeit or unlawfully affixed trademark.

Fees

The Implementing Regulations of the GCC Trademarks Law provide a list of official fees; however, it is left to the Member States to determine whether to charge its own official fees. So far the countries that have implemented the GCC Trademarks Law have seen changes in its official fees, which resulted in significant increases. Until now there is nothing announced with respect to Oman official fees, but they are expected to be increased once the Implementing Regulations are issued.

Until the Implementing Regulations are issued, it remains unclear how the GCC Trademarks Law will be implemented in Oman.

While the GCC Trademarks Law does not provide a single registration system, by which a single application will provide protection in all Member States, having a unified trademarks law is a good development, as it allows right holders to enjoy the same level of protection across the Member States, and it sets out a single set of provisions with respect to the registration and enforcement of trademark rights in all Member States, which will help them in managing their portfolios in the region.