



# SPECIAL REPORT

## TRADEMARKS IN THE MIDDLE EAST

OPPORTUNITY AMIDST CONFLICT

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THOMSON REUTERS

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# INTRODUCTION

The “westernization” of the Middle East is a powerful topic, capable of simultaneously inciting war and launching a consumer revolution. Decades of civil unrest in the region have been rooted in the clash between modern and ancient cultures and the growing influence of new technologies, arts and entertainment. Meanwhile, a rapidly-growing consumer base has driven a steady march of ever-more western and regional brands into the Middle East.

U.S. pizza chain Papa John’s celebrated the opening of its 100th unit operating in the Middle East this past July<sup>1</sup> and General Motors has announced plans to expand its network of auto showrooms in Saudi Arabia by 29 percent, to 142 locations by 2014.<sup>2</sup>

Charles Sha’ban, executive director at Abu-Ghazaleh Intellectual Property, a firm specializing in patent and trademark law, explained the phenomenon: “The Middle East is a large consumer market. As a result, many international brands are very interested in the region, and we’re seeing steady growth among firms looking to protect their brands here.”

As the outside world has begun to take note of the once cloistered Middle East as a new frontier of consumer opportunity, companies have gotten serious about securing trademark protection for their brands in the region. Likewise, as the individual countries of the Middle East have begun to recognize the opportunity to compete in a global marketplace, their intellectual property enforcement infrastructures are growing to meet the increased demand.

Sha’ban explained, “Ten years ago, local awareness for IP laws was very low. This was the case even in big industries like pharmaceuticals, where the Middle East has a strong presence. Local companies were making products with no brand protection whatsoever as recently as the 1990s. More recently, there has been a surge in awareness among companies and individuals, and we’re starting to see the local IP infrastructure grow to accommodate this.”

Despite this rapid growth, the Middle East does present a number of unique challenges for multinational brands. How can firms develop successful brand strategies in a region with such diverse cultural and socioeconomic footprints? How should big brands navigate the threat of civil unrest, which has been a constant source of tension in the region for many years? And who are the brand leaders who have already started to forge a path of best practices in the Middle East?

To find out, Thomson CompuMark tracked trends in trademark activity in the Middle East over the last two decades, sought input from leading trademark experts and analyzed trademark strategies of the world’s leading brands. The resulting research finds that the Middle East’s rapidly growing consumer base and improving IP infrastructure have presented opportunities that are too big to ignore for western and eastern brands looking to expand sales globally. However, the impact of global conflict in the region is a very real issue, demanding a well-thought-out brand strategy for any company intent on Middle Eastern expansion.

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1. Jordan
2. Egypt
3. Saudi Arabia
4. United Arab Emirates
5. Israel

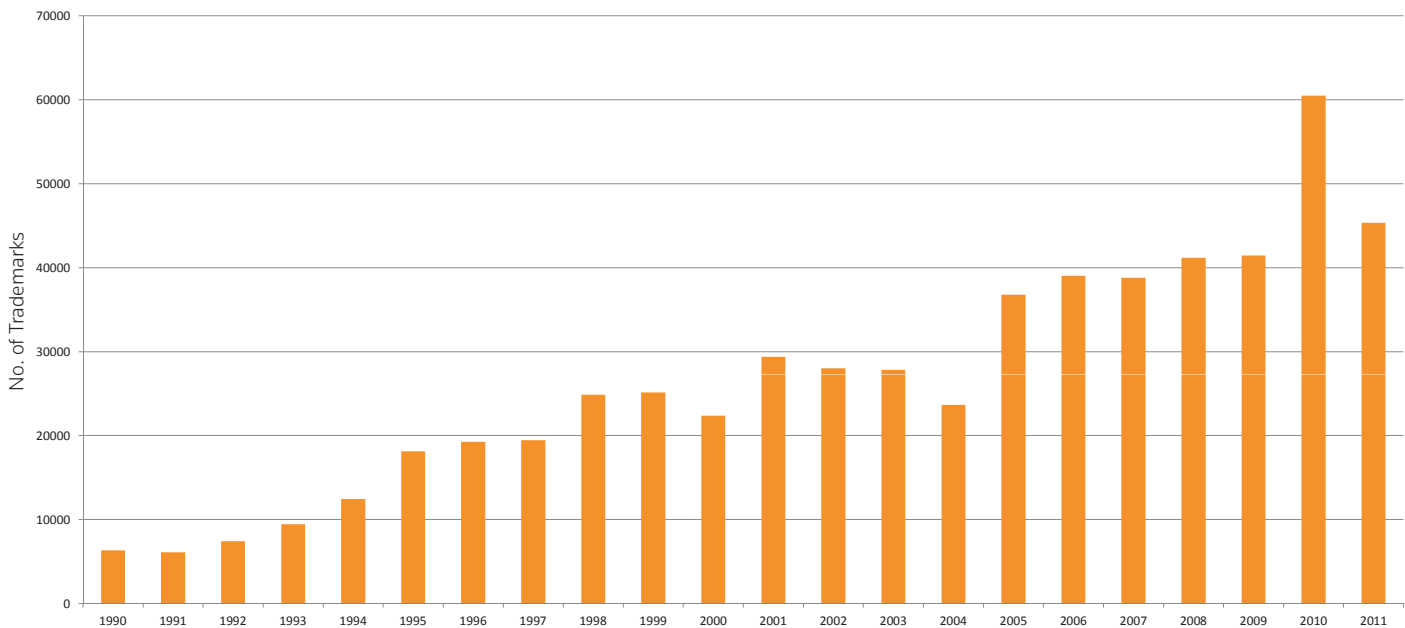
## TRADEMARKS IN THE MIDDLE EAST BY THE NUMBERS

“We’ve seen a real up-tick in the last five years among our clients seeing the Middle East as a viable business opportunity. Both European and U.S. brands are selling well there, and – as a result – we’ve seen a steady increase in the number of companies looking to protect their brands in the region,” said Christopher J. Schulte, an attorney specializing in trademark law with Merchant & Gould, a law firm based in Minneapolis, MN.

### STEADY GROWTH ACROSS THE MIDDLE EAST

Mr. Schulte’s sentiments are reinforced by the data tracking trademark publications across the top five trademarking countries in the Middle East<sup>3</sup>, which have seen combined growth of over 600 percent over the last 22 years (Figure 1).

FIGURE 1: MIDDLE EASTERN PUBLISHED TRADEMARK ACTIVITY (1990 - 2011)

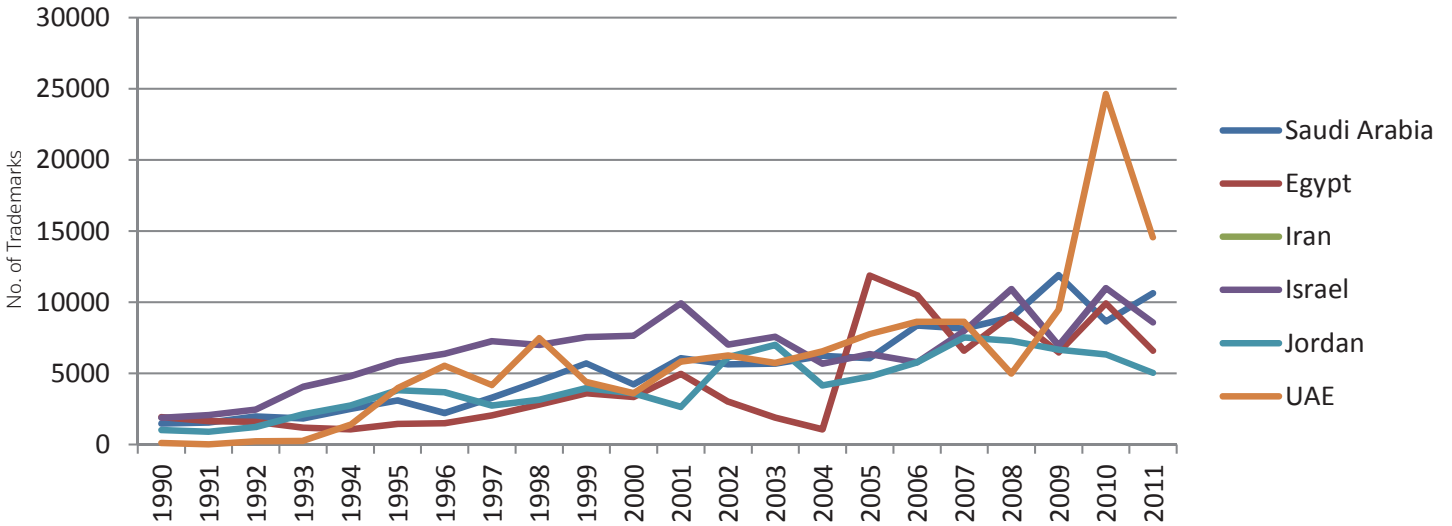


Source: SAEGIS on SERION from Thomson CompuMark

<sup>3</sup> Data tracked represents the top five countries publishing trademarks in the Middle East: Egypt, Israel, Jordan, Saudi Arabia and the United Arab Emirates. Iran also ranked among the top 5 but due to trade sanctions, trademark totals for that country were omitted

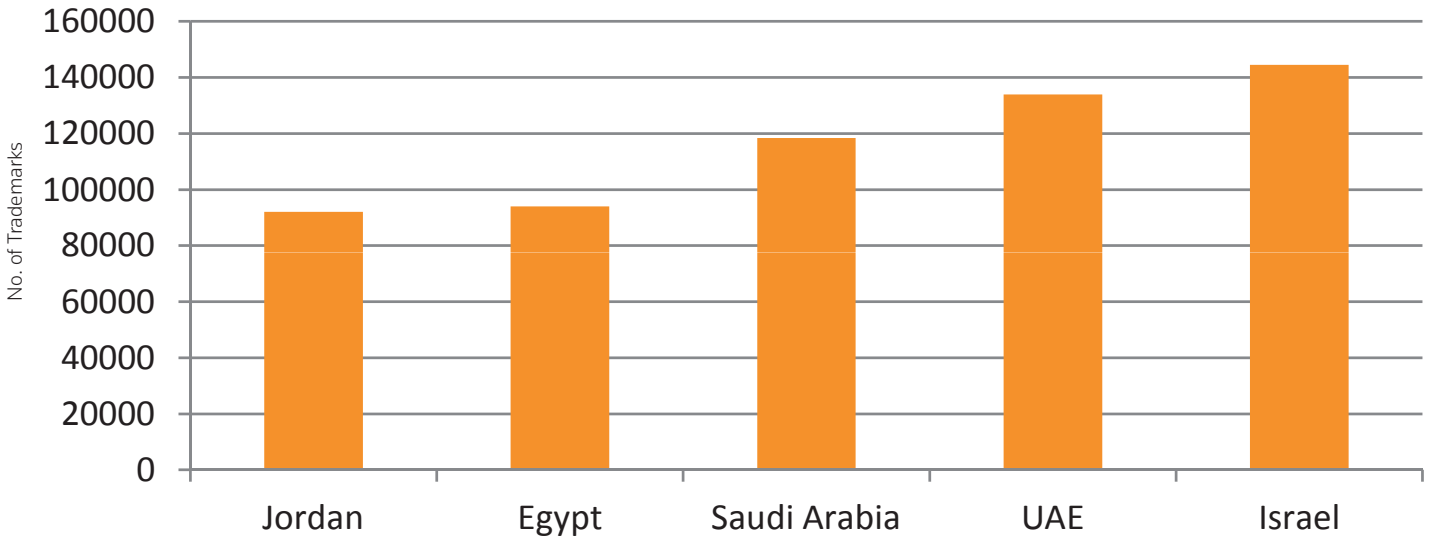
On a country-by-country basis, the top five trademark registrars in the Middle East: Egypt, Israel, Jordan, Saudi Arabia and the United Arab Emirates, have each undergone significant growth over the past 22 years (Figure 2).

FIGURE 2: MIDDLE EASTERN PUBLISHED TRADEMARK ACTIVITY BY COUNTRY (1990 - 2011)



Source: SAEGIS on SERION from Thomson CompuMark

FIGURE 2.1: MIDDLE EASTERN CUMULATIVE PUBLISHED TRADEMARK ACTIVITY BY COUNTRY (1990 - 2011)



Source: SAEGIS on SERION from Thomson CompuMark

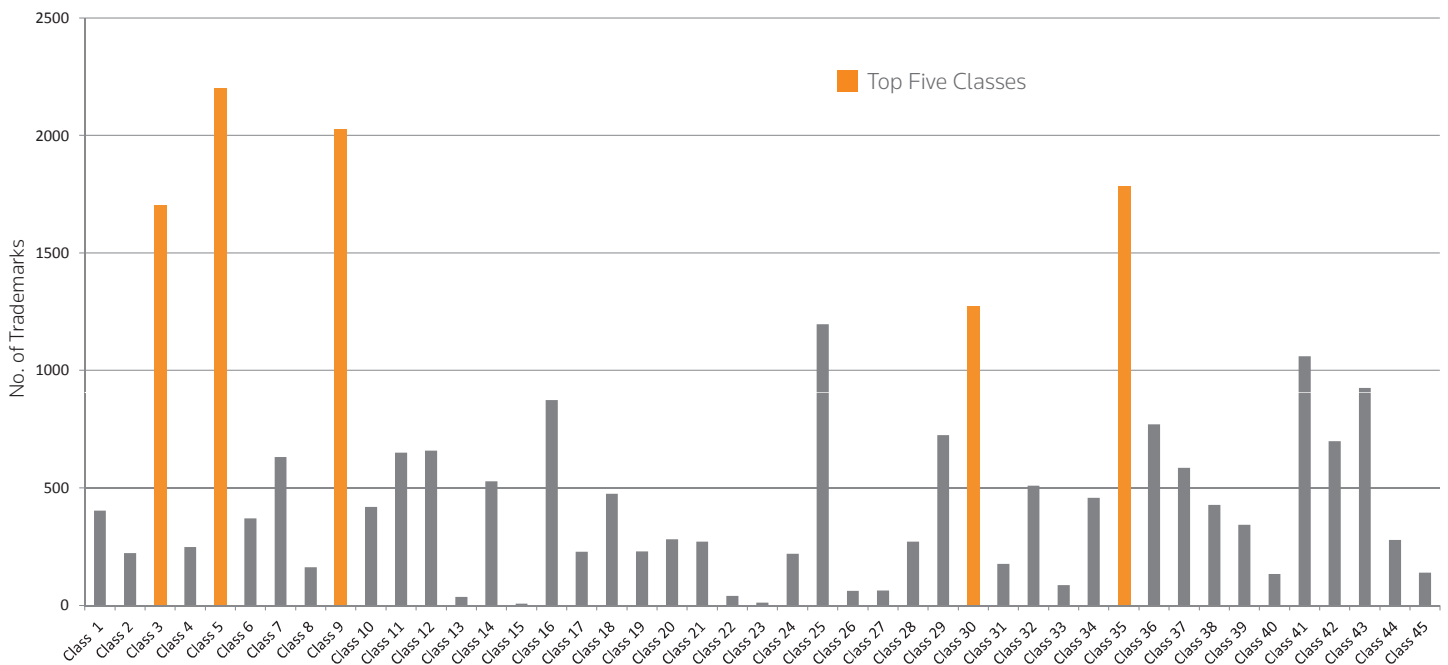
As Figures 2 and 2.1 indicate, each of the countries in the study have shown considerable growth in trademark publication activity, with Israel, the United Arab Emirates and Saudi Arabia leading the way. On a cumulative basis for the 22 year study period, Israel has published 144,500 trademarks, the United Arab Emirates has published 133,963 and Saudi Arabia has published 118,380.

According to Sha'ban of Abu-Ghazaleh Intellectual Property, this trend is evident throughout the region and across all industries. "The pharmaceutical industry has been the leader in trademark publications in the region, but over the past 10 years we've begun to see many high

technology and consumer companies grow more protective of their brands. Now, all sectors are showing interest."

As Figure 3 illustrates, the top five trademark classes receiving the most publications in the Middle East during the study period were Class 5: Pharmaceuticals, Class 9: Electrical and Scientific Apparatus, Class 35: Advertising and Business, Class 3: Cosmetics and Class 30: Staple Foods (Refer to Appendix for additional class details).

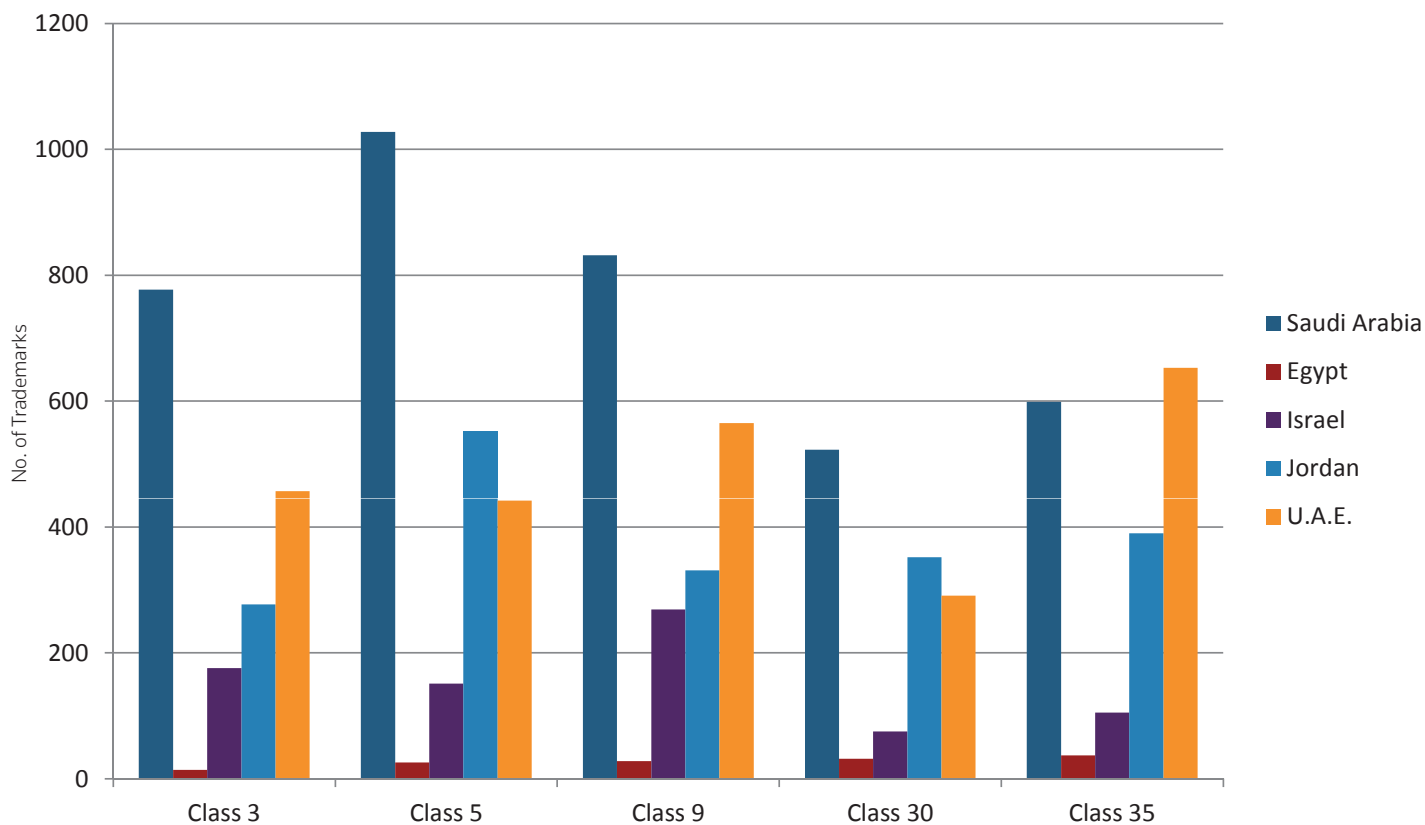
FIGURE 3: MIDDLE EAST PUBLISHED TRADEMARK ACTIVITY BY CLASS (2011)



Source: SAEGIS on SERION from Thomson CompuMark

On a country-by-country basis, the trademark publication activity by class is relatively consistent. Cumulatively Saudi Arabia, Jordan and the United Arab Emirates lead the way with Class 5: Pharmaceutical, Class 9:Electrical and Scientific Apparatus, and Class 35: Advertising and Business. (Figure 4).

FIGURE 4: MIDDLE EASTERN COUNTRY COMPARISON BY TOP FIVE TRADEMARK CLASSES (2011)



Source: SAEGIS on SERION from Thomson CompuMark

In line with the trademark class trends, the companies filing the most trademarks in the Middle East represent a cross-section of global pharmaceutical and consumer brands. As the table in Figure 5 indicates, Johnson & Johnson, Sanofi and GlaxoSmithKline were the top three trademark registrants in the Middle East in 2011.

FIGURE 5: TOP 10 COMPANIES PUBLISHING TRADEMARKS IN THE MIDDLE EAST (2011)

| RANK | OWNER*                           | INDUSTRY                   |
|------|----------------------------------|----------------------------|
| 1    | Johnson and Johnson              | Pharmaceutical/Health Care |
| 2    | Sanofi                           | Pharmaceutical/Health Care |
| 3    | GlaxoSmithKline                  | Pharmaceutical/Health Care |
| 4    | Temasek Holdings (Private), Ltd. | Investment Firm            |
| 5    | Merck                            | Pharmaceutical/Health Care |
| 6    | Novartis                         | Pharmaceutical/Health Care |
| 7    | Israel Broadcasting Authority    | Broadcast/Communications   |
| 8    | Philip Morris International      | Tobacco                    |
| 9    | Unilever                         | Consumer Products          |
| 10   | Nissan                           | Automotive                 |

\*Including subsidiaries

Source: SAEGIS on SERION from Thomson CompuMark

Sha'ban explains that while global brands have driven the most growth in Middle Eastern trademark activity, local brands have also been filing more marks. "Ten years ago, local clients represented about two percent to three percent of our work. Now, they represent about 12 percent of our work."



REUTERS / MOHSIN RAZA

## NAVIGATING POLITICAL AND CIVIL UNREST

“Geopolitical events on the scale of what’s been happening in the Middle East over the last several years can have a profound effect on IP strategy for multinational brands. When you have conflicts like the Arab Spring, the current conflict in Syria or even Iraq, where the patent and trademark office was damaged, trademark processing can be severely disrupted,” said Merchant & Gould’s Christopher J. Schulte.

Civil unrest, such as the Arab Spring, a revolutionary wave of civil uprising which has forced country leaders out of power, is a reality for brands doing business in the Middle East. While it is impossible to generalize across the entire region when it comes to measuring the effects of global conflict, most brands identifying the Middle East as an area of expansion need to be mindful of the potential for an unexpected change in political and social climate.

In addition to the damaged patent and trademark office in Iraq, other casualties of the region’s conflicts include the Libyan trademark office, which has been closed for the last several months and presents challenges for anyone wishing to enforce a mark in the country, and the Iranian and Syrian trademark offices, which are under global scrutiny as several countries are currently enforcing sanctions on the two nations.

In fact, despite being a top Middle Eastern country for published trademarks driven largely by Arab based companies, Iran has been omitted from this study due to limitations on global brands being able to do business in this nation.

Specialists in Middle Eastern IP law suggest that the best approach to managing the region’s inherent uncertainty is to work with consultants who know the intricacies of each regional office and can help manage the administrative process.

Attorney Schulte cautioned, “The climate in the Middle East bears the need for extremely accurate record keeping at the client’s law firm. Many files were lost in Iraq. In Syria, embargoes come into play. This can make it very difficult to enforce IP. Brands operating in the region need to take this variability into account when projecting processing times and navigating enforcement actions.”





REUTERS / JUMANA EL HELOUEH

## EXPENSIVE IP

While the IP infrastructure in the Middle East is growing to meet the demands of an increasingly globalized economy, it can still be very expensive for brand owners to protect themselves in the region.

Sha'ban explained: "As we start to see more well-known brands in the region, it is helping us. Most of the countries of the Middle East are now trying to become part of international treaties, such as the Madrid Protocol, which will simplify mark registration across multiple countries. We have begun to see this develop with patents, whereby a centralized patent office in the Gulf Arab states (the GCC Patent Office) allows you to patent in six different countries – Saudi Arabia, Kuwait, the United Arab Emirates, Bahrain, Oman and Qatar – via a single application. Plans are underway to implement a similar approach for trademarks."

Until then, brands looking to secure protection for their marks across the Middle East must do so on a country-by-country basis. That means juggling a number of different nuances in filing protocols, actively managing several applications at once and – most significantly – paying for each application separately.

The fee for filing a trademark application in the Middle East can be substantial. Whereas a traditional trademark filing in the U.S. will cost about \$1,600, that cost can more than triple for a single mark in the United Arab Emirates.

"In Kuwait, clients can expect to spend approximately \$6,300 for a single trademark; in Qatar, that number jumps to \$8,300 and in the United Arab Emirates – which is typically the most expensive place to file in the Middle East – you should anticipate spending \$17,000 for a trademark," said Attorney Schulte.

Sha'ban added, "It's also important to note that any company wishing to protect its brand in the region needs to do so through power of attorney that is legalized up to the consulate level. Before any document can be processed, it needs to first be sent to the consulate to be signed and legalized, and then passed on to an attorney who will file it. This process typically costs \$400 per document in some countries like UAE, which can add up quickly."

Despite these costs, specialists in the region note that having some protection in the region is better than having none at all. Particularly in cases when a well-known mark can be established elsewhere in the Middle East, it is easier to enforce IP when a possible infringement arises.

Sha'ban related a case in which his firm successfully defended Kentucky Fried Chicken against a Syrian business calling itself "Dajaj Kentucky," which translates to Kentucky chicken in English. "We were able to prove that Kentucky Fried Chicken is a famous trademark and one-of-a-kind, assuring that it is not eligible to register such trademarks as Dajaj Kentucky for another, different owner."

One area where the high cost of securing trademark protection does have a noticeable impact on brand strategy in the region is in the use of Arabic characters. Unlike China and Japan, where foreign assignees will often secure local-language translations or transliterations of their brand names, the sheer cost of filing has limited most foreign brands from seeking Arabic character versions of their marks.



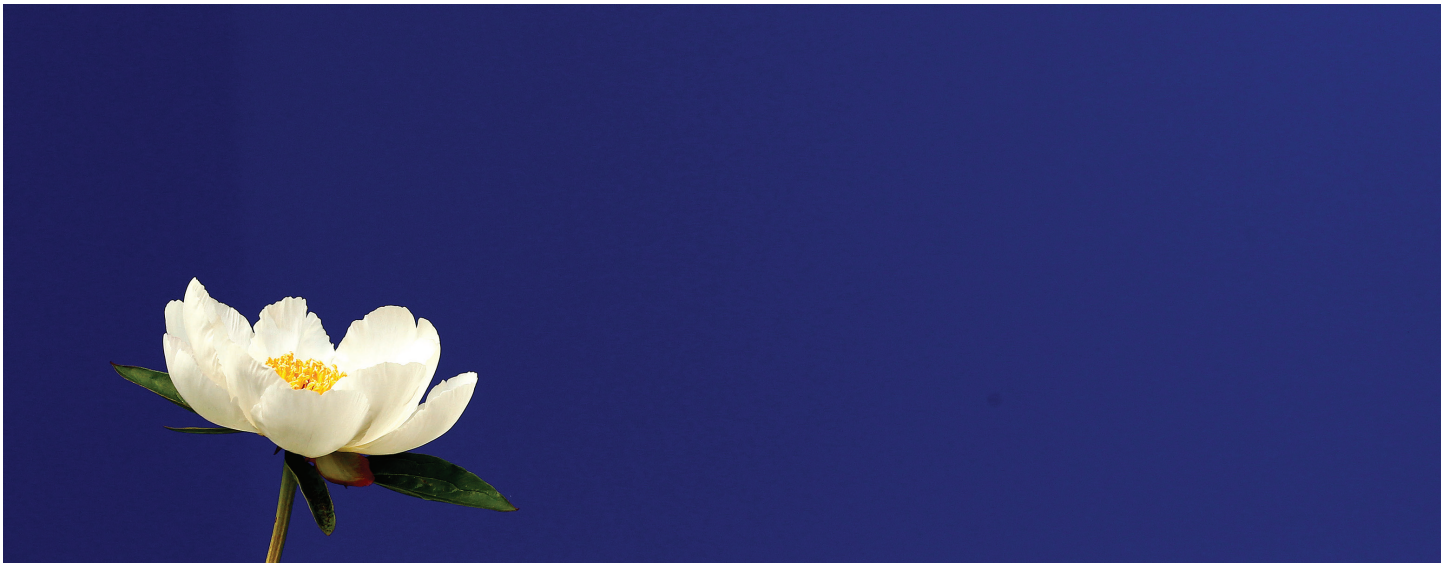
REUTERS / YANNIS BEHRAKIS

## BEST PRACTICES

Business expansion of any kind comes with risk. Each developing economy around the world presents its own set of challenges. Just as China poses unique challenges with language translation and counterfeit enforcement, and Brazil confounds brands with its wide geographic and socioeconomic variation, the Middle East is a unique collection of regional economies and governments that require special care on the part of brand owners.

There is no perfect, one-stop-shopping strategy for protecting multinational trademarks in the Middle East. However, with the right cultural know-how, investment of time and resources, and working directly with Middle Eastern IP specialists to navigate the region's labyrinthine regulatory frameworks, brand owners are in the best position they've been in years to build a strong consumer base in the region. Based on our analysis of the industry's current thinking on the matter, the following are three key steps to successful trademarking in the Middle East:

- **Invest in Record Keeping:** Geopolitical volatility has been a constant presence in the Middle East for many years, making it hard for brand owners to anticipate specific challenges that may occur in the filing or enforcement process. Merchant & Gould's Christopher J. Schulte warned that, "Record keeping is critical; the client's law firm needs to fulfill the role of record keeper in this environment because we have seen cases where the official governing body can literally disappear overnight."
- **Factor the Cost:** The costs associated with filing and administering trademarks in the Middle East are substantial. As Abu-Ghazaleh Intellectual Property's Charles Sha'ban counseled, "Expect more expensive registration in the Middle East than in any other region. Filing costs in Saudi Arabia and the United Arab Emirates in particular can be more than triple the cost of what companies are used to paying for trademarks elsewhere in the world."
- **Think Globally, Act Regionally:** While the Middle East is visualized in board rooms as a singular region, it is really a collection of several diverse economies, each with its own unique subtleties. Until a standardized filing protocol is accepted across all countries, it is essential to read the requirements for each individual country.



REUTERS / STEFAN WERMUTH

## HOW THOMSON COMPUMARK CAN HELP

With a steadily growing profile in pharmaceuticals, technology and consumer products, the Middle East is rapidly becoming a hot spot of opportunity for companies to increase the value of their global brands. As the data and insights in this report illustrate, while there is enormous opportunity in the Middle East, there is also a distinct set of rules that need to be followed to secure and enforce brand protection in the region. As more western firms forge new ground in the Middle East's consumer market, we are rapidly seeing the development of best practices and operational guidelines that will streamline the trademark application process and mitigate infringement risk. The key to profiting from this collective knowledge is having the right information to make informed decisions.

Thomson CompuMark understands the specialized challenges of clearing, registering and protecting trademarks in the Middle East, and we offer a wide range of solutions to safeguard brands. SAEGIS on SERION®, the largest online collection of trademark screening data in the world, covers 186 countries including the Middle East. With SAEGIS, users can assess the viability of their brands early in the trademark screening process by identifying similar or identical existing brand names. Search with Opinion, an enhanced research offering designed to provide access to hard-to-get

trademark insight, facilitates fast and cost-effective access to a highly regarded global network of expert trademark associates, easing the pressures of launching brands in unfamiliar and costly jurisdictions. Once your trademarks are registered, safeguard your valuable brands from infringement with trademark watch.

In addition, Thomson Reuters Intellectual Property Administrative Services provides outsourcing services for trademark docketing, enabling IP organizations to reallocate resources to better suit their IP strategies. The IP Administrative Services team comprises multi-shore trademark experts from around the globe who use a rigorous Lean Six Sigma approach to minimize risk and maximize accuracy required for precise record keeping.

To find out more about our specialized trademark services, or to learn more about any of the details covered in this report, contact us.

# APPENDIX:

## GOODS

**Class 1:** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

**Class 2:** Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

**Class 3:** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 4:** Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.

**Class 5:** Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

**Class 6:** Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

**Class 7:** Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements (other than handoperated); incubators for eggs.

**Class 8:** Hand tools and implements (hand-operated); cutlery; side arms; razors.

**Class 9:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus.

**Class 10:** Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

**Class 11:** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

**Class 12:** Vehicles; apparatus for locomotion by land, air or water.

**Class 13:** Firearms; ammunition and projectiles; explosives; fireworks.

**Class 14:** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

**Class 15:** Musical instruments.

**Class 16:** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

**Class 17:** Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

**Class 19:** Building materials (nonmetallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

**Class 20:** Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

**Class 21:** Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semiworked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

**Class 22:** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

**Class 23:** Yarns and threads, for textile use.

**Class 24:** Textiles and textile goods, not included in other classes; bed and table covers.

**Class 25:** Clothing, footwear, headgear.

**Class 26:** Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

**Class 27:** Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

**Class 28:** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

**Class 29:** Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

**Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

**Class 31:** Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Class 33:** Alcoholic beverages (except beers).

**Class 34:** Tobacco; smokers' articles; matches.

## SERVICES

**Class 35:** Advertising; business management; business administration; office functions.

**Class 36:** Insurance; financial affairs; monetary affairs; real estate affairs.

**Class 37:** Building construction; repair; installation services.

**Class 38:** Telecommunications.

**Class 39:** Transport; packaging and storage of goods; travel arrangement.

**Class 40:** Treatment of materials.

**Class 41:** Education; providing of training; entertainment; sporting and cultural activities.

**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

**Class 43:** Services for providing food and drink; temporary accommodation.

**Class 44:** Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

**Class 45:** Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

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