

# Intellectual Property Team

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Our comprehensive IP practice is the leading in the region with capabilities provided trademark, patent and design professionals across 10 offices in five countries.

We routinely handle some of the ground breaking IP matters in the Middle East, acting for major global brands and international and regional right owners.

## **BRAND PROTECTION**

Entrusted with some of the most recognizable brands in the world, Al Tamimi & Company trade mark lawyers are amongst the most awarded in the region. Experts in the management of entire portfolios of trade marks on a regional basis, our services include:-

- Trademark searches and clearances covering the Middle East region and providing detailed analysis and advice on the availability and registrability of a trademark on a regional basis.
- Trademark registration and prosecution of trademarks before the official registries in the UAE and the Middle East region. This includes the registration and prosecution of non-traditional trademarks, such as single color and 3D shape trademarks.
- Enforcing IP rights by way of court, police, brooders (customs) and administrative actions. This includes supervising raids commenced by the relevant law enforcement agency, enforcement of non-traditional trademark rights and enforcement of trademark rights against look-alikes.
- Coordinating and managing cross-jurisdictional IP litigation and disputes involving Office actions (cancellations, oppositions) and Court actions.
- Providing strategies for multi-jurisdictional conflicts/disputes. Structuring and negotiating settlement agreements on regional and global basis on behalf of our clients.
- Advising clients prior to any product launches and taking measures to secure proper protection for the intellectual property rights, and establishing a system with clients' marketing departments to ensure adequate protection is sought at the outset.
- Providing advice on effective alternative dispute resolution.
- Structuring strategies for developing and strengthening clients' existing brands, and advising clients on the development, ownership, clearance and protection of new brands and products.
- Advising clients on their promotional and advertising activities from a trademark and copyright perspective.

## **PATENTS & DESIGNS**

Al Tamimi continues to be a leading force in the patent & design protection space in the Middle East through its services across the entire gamut of patent & design prosecution, litigation and commercialization matters for large scale portfolio proprietors.

Multijurisdictional Portfolio Management is a core strength of Al Tamimi Patent & Design lawyers. Compelling reasons why our clients have chosen to rely on us as their first line of defence for patent & design matters in the Middle East include the following:-

### **– International Experience**

Our lawyers have international experience and exposure having worked with some of the most recognizable names in the international Intellectual Property business including regional inhouse experience. This translates into an in depth knowledge of cross border anti counterfeiting campaigns as well as patent systems and a true understanding of multijurisdictional issues

especially in a region as complex as the Middle East.

## **– Regional Coordination**

Having a centralized point of contact for patent matters makes sense in the Middle East as corresponding applications entering into the national phase of a PCT application or enjoying convention priority periods are filed. Our clients truly value the efficiency and reduced risk that flows from using a centralized contact point in a complex region. Relying on Al Tamimi as the regional coordinator means being able to depend on our expertise with the local laws and practices, our relationships with local agents and authorities, and our international level standards of advice and service.

## **LITIGATION**

Building on our firm's strength as a pioneering litigation powerhouse, we continue to write history by helping the first ever patent infringement and revocation in the UAE. In the area of trademarks, Al Tamimi has participated in shaping numerous court principles in judgments establishing principles of well known marks, free riding and trade dress infringement, priority of ownership and confusing similarity factors.

## **MEDIA & ENTERTAINMENT**

We continue to work with major media companies and provide the contractual essential advice, protection of IP assets, defend the clients in defamation claims and underline the necessary guidelines for the operating staff, such as news reporters, representatives and correspondents overseas.

## **CONSUMER PROTECTION AND COMPETITION,**

Our consumer and regulatory affairs lawyers regularly provide clients, including manufacturers and distributors, with legal advice concerning consumer protection and competition issues in line with various laws such as the Consumer Protection Law, the UAE Civil Code and the UAE Commercial Transactions Law. The team works closely with the Litigation department in order to gain a clear understanding of the courts' approach in related circumstances for the benefit of our clients.

## **DATA PRIVACY**

Our Privacy and Data Protection side, and owing to an unparalleled comparative knowledge and local insight that our lawyers have as regards the privacy related legal regimes in the whole Middle East, we are often called upon by many clients to coordinate data privacy compliance assignments for the whole region. We regularly renders advice in relation to the data privacy and information security issues in the light of the legal thresholds protecting individual privacy as laid out in various laws of the UAE, Saudi Arabia, Jordan, Qatar, Kuwait, and Iraq. We also specialize in data compliance matters as regards the laws applicable to specially regulated free zones, such as, the Dubai International Financial Centre (DIFC) and the Qatar Financial Center (QFC).

## **ADVERTISING AND REGULATORY AFFAIRS**

This area remains quite rigidly regulated by the relevant authorities in the region particularly in the areas of promotional campaigns, marketing activities and competitions. We have extensive experience in approaching the relevant authorities in the region to verify the conformity of such activities. In addition, we are able to draw on the language skills of our Arabic-speaking lawyers to make specific enquiries to the relevant authorities including, for example, the Emirates Standards & Metrology Authority (ESMA) and the Consumer Protection Department of the Ministry of Economy. We advise on the standards and regulations that govern food additive, import and re-export

requirements for foodstuff among other relevant regulatory issues.

- Advising on brand position and restrictions of advertising
- Pharmaceutical and medical regulatory affairs, we advise clients in regulatory related policies and registration
- Advising on online campaigns, consequences and required permits and the jurisdictions of UAE enforcement bodies.
- Advising and drafting terms and conditions for promotions and marketing campaigns on a regional basis.
- Advising on compliance of promotions with competition laws.
- Advising on formalities that are required before the competent authorities including Economic Department licensing formalities and medical devices registration formalities before the UAE Ministry of Health.
- Advising on the UAE Ministry of Health Pharmaceutical preparations guidelines.
- Advising on permits, policies of marketing authorization holder, company registration at the Ministry of Health and product registration before Dubai Municipalities, including health related products.
- Advising on regulations of food control department at Dubai Municipality, including the guidelines of registering the foods & beverages importers and compliance with Import and Re-Export requirements for foodstuff regulations.
- Advising on compliance with Foreign Corruption Practices Act “FCPA” & Transparency International policies.

## **INTELLECTUAL ASSET MANAGEMENT**

### **Our Practice**

Intellectual Asset Management is a core competency of our practice. We adopt a holistic approach in assisting our clients in realising the optimal potential in mining their intellectual assets to extract the maximum IP value from their investments in intangibles.

### **Our Expertise**

Our collective experience includes regional inhouse experience at a global FMCG giant, which means that we can draw upon our understanding of the inner mechanisms of corporate IP departments in conducting IP due diligence with a multijurisdictional approach in respect of mergers & acquisitions, complex licensing structures, and intellectual asset management across all IP subject matters including copyright, patent, trademark and designs.

We have an established network of IP associates in the major markets of the world with whom we could access in conducting the necessary due diligence and investigation on the targets’ IP worthiness as companies scour the world for investment grade IP opportunities.

### **Our Services**

- We run Intellectual Asset Management programs for clients in managing their IP portfolios for value by implementing programs designed to identify, protect and exploit the resulting IP rights.
- We conduct reviews and gap analysis studies of the IP portfolios of IP rich companies to optimize their IP holdings.
- We assist clients in evaluating patent, design, and trade mark portfolios of target investee companies and investors in coordinating the necessary validity, infringement and freedom to operate analyses including prior art and clearance searches.
- We manage the IP aspects of acquisitions and strategic investments of target companies where IP invariably underpins the entire deal

- We advise management teams on the restructuring of the operations, which would involve IP audits of the various operations being restructured