

Anti-counterfeiting action in Kuwait

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May 2013

Like in many other jurisdictions in the Middle East, trade in counterfeit goods in Kuwait poses a significant challenge for brand owners.

At this time, there is still no formal process available to brand owners to record their valuable trademarks with the customs authorities in Kuwait in order to address the importation of counterfeit goods at the borders of the country. This means that the ability to take effective action against the trade in counterfeit goods within the market in Kuwait is of critical importance.

In addition to the regular civil and criminal proceedings that a brand owner may bring against counterfeiters in order to enforce their intellectual property rights, the Commercial Control Department (the "CCD") at the Ministry of Commerce and Industry in Kuwait provides a highly effective administrative mechanism through which enforcement actions can be taken. The CCD is the government authority within the Ministry of Commerce and Industry in Kuwait that is responsible for inter alia protecting intellectual property rights within the market.

In order for the CCD to take administrative action against a suspected trader dealing in counterfeit goods, the CCD requires the relevant brand owner to file an appropriate complaint. The purpose of the complaint is to provide the CCD with all relevant details, including that of the target, that of the goods being counterfeited and the relevant rights that are infringed.

The preparation for a complaint to the CCD should include the following:

- The identity of the target dealing in the counterfeit goods;
- Sample of the counterfeit goods sold or offered for sale and a receipt of the sale thereof (if this can be obtained); and
- A comparison of the counterfeit product with the authentic product confirming that the counterfeit product is in fact counterfeit.

Once the above steps had been taken, a complaint can be filed with the CCD, providing it with the details obtained in the above mentioned preparatory steps as well as copies of the certificates of registration for the relevant trade mark rights that are being infringed. Further, it is very important to NOTE THAT THE CCD will also require samples of the authentic products that are being counterfeited. The CCD will consider a complaint and refer it for further action to the investigation department within the CCD that is responsible for the specific area where the infringement is taking place.

Al Tamimi & Company recently assisted a manufacturer of a well-known brand of mobile and smart phone handsets in filing a complaint with the CCD and in conducting a very successful raid against an establishment offering counterfeit handsets for sale. This particular matter commenced when Al Tamimi & Company received information from a client's distributor on the sale of suspected counterfeit goods. Al Tamimi & Company supported the client in preparing and filing the required complaint, followed up on the complaint and accompanied the CCD on the raid.

The CCD conducted the raid and found approximately 240 counterfeit mobile phone and smart phone handsets with an estimated value of more than US\$ 35,000. The counterfeit goods were seized by the CCD and the CCD also obtained an undertaking from the store owner not to deal in

the offending goods again – subject to certain fines. The powers of the CCD are not limited to seizing goods and it also has certain investigative powers allowing it to obtain information on the supply and distribution of goods. In this particular CCD action, valuable information regarding the source of the counterfeit products was also obtained.

The CCD will submit samples of the seized goods, along with the authentic samples provided by the complainant, to the Criminal Evidence Department of the police to conduct an independent comparison of the goods. The Criminal Evidence Department shall issue a report on the comparison of the counterfeit and authentic goods and if it confirms that the confiscated products are counterfeit, the matter will be transferred to the Commercial Public Prosecutor and the criminal courts of Kuwait. The report prepared by the Criminal Evidence Department represents good evidence that the confiscated goods are counterfeit. As the criminal prosecution authorities base their decision on whether to prosecute on the reports from the Criminal Evidence Department, there is a very high level of successful prosecution based on such evidence from the Criminal Evidence Department.

The CCD provides an effective mechanism to address the trade in counterfeit goods in the Kuwaiti market with the high level of detail required in complaints playing an important role in the criminal prosecution of counterfeit traders. If you require any assistance in respect of taking action against counterfeit trade in Kuwait, please contact Tarek Abu Mariam in the Kuwait office of Al Tamimi & Company at t.abumariam@tamimi.com.