

The Importance of Opposing Trademark Applications in Bahrain

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An opposition action may be filed against a trademark application by any third party within a period of 60 days from the date of publication in the online Trademarks Special Publications Gazette. The 60 days deadline is not extendable, and once it has expired no opposition action can be taken. The opposition action must be submitted in two copies on the official form, in addition to any supporting evidence such as prior registration certificates in Bahrain and worldwide; evidence of prior use; evidence proving fame; and evidence of any prior relationship between the applicant and the opposing party to prove bad faith. The 2014 law significantly increased the fees of filing such an application to BHD 200 from BHD 20, in addition to BHD 100 for requesting a hearing session if needed (see below).

A legalized and notarized Power of Attorney should be presented with the opposition action if the opposing party is not a resident in Bahrain, and a notarized Power of Attorney if the opposing party is a resident in Bahrain. The law does not provide the possibility of presenting the original Power of Attorney after the 60 day period, however the common practice of the trademark office is to accept the opposition based on soft copies, and to request the original within a specific period. Furthermore, the decisions of the Court of Cassation confirm that the relationship between a party and its attorney cannot be discussed by either party or by the court unless denied by the party alleged to have instructed the attorney.

The applicant must be notified with the opposition action within 30 days, and must respond within 60 days. If no counter opposition is submitted the application will be considered abandoned.

If the trademark is contested, either party can request a hearing session to take place to allow an opportunity for the parties to provide more clarification in relation to the submitted arguments before a decision is made. However it is for the trademark office at its sole discretion to allow such a hearing to take place. The decision must be issued within 90 days from the date of the hearing session.

If the trademark is published without any third party opposition, the trademark passes to registration. Once registered, the only possible action to invalidate the registration of a trademark is filing a cancellation action before the court within five years of the registration date, unless the basis of the cancellation action is nonuse for a period not less than five years.

The cost and time it takes to cancel a trademark once registered is not the only problem avoided when the trademark is challenged prior to registration. Any canceled trademark can only be registered in the name of another party after three years from the cancellation date, unless the court which made the cancellation decision determines a shorter period.

It is worth mentioning that the three years period also applies to trade names. If a trade name identical or confusingly similar to a registered or a well-known trademark is unlawfully registered, a cancellation action may be filed before the court. However, in this case, the relevant law (Law No. 18 of 2012) does not provide the option of enforcing a period shorter than three years for the trade name to be registered in the name of another party based on the court's decision.

Filing an application and obtaining a registration, preventing others from registering an identical or a

confusingly similar trademark through opposition actions, and enforcing intellectual property rights as a whole should not be determined only based on the cost and the official fees, as taking the right decision in the right time can save a lot.