



المعهد القومي للملكية الفكرية

The National Institute of Intellectual Property
Helwan University, Egypt

المجلة العلمية للملكية الفكرية وإدارة الابتكار

دورية نصف سنوية محكمة يصدرها

المعهد القومي للملكية الفكرية

جامعة حلوان

العدد الخامس

ديسمبر ٢٠٢٢

الهدف من المجلة:

تهدف المجلة العلمية للملكية الفكرية وإدارة الابتكار إلى نشر البحوث والدراسات النظرية والتطبيقية في مجال الملكية الفكرية بشقيها الصناعي والأدبي والفني وعلاقتها بإدارة الابتكار والتنمية المستدامة من كافة النواحي القانونية والاقتصادية والإدارية والعلمية والأدبية والفنية.

ضوابط عامة:

- تعبر كافة الدراسات والبحوث والمقالات عن رأى مؤلفيها ويأتي ترتيبها بالمجلة وفقاً لإعتبارات فنية لا علاقة لها بالقيمة العلمية لأى منها.
- تنشر المقالات غير المحكمة (أوراق العمل) فى زاوية خاصة في المجلة.
- تنشر المجلة مراجعات وعروض الكتب الجديدة والدوريات.
- تنشر المجلة التقارير والبحوث والدراسات الملقاه في مؤتمرات ومنتديات علمية والنشاطات الأكاديمية في مجال تخصصها دونما تحكيم في أعداد خاصة من المجلة.
- يمكن الاقتباس من بعض مواد المجلة بشرط الاشارة إلى المصدر.
- تنشر المجلة الأوراق البحثية للطلاب المسجلين لدرجتى الماجستير والدكتوراه.
- تصدر المجلة محكمة ودورية نصف سنوية.

ألية النشر فى المجلة:

- تقبل المجلة كافة البحوث والدراسات التطبيقية والأكاديمية في مجال حقوق الملكية الفكرية بكافة جوانبها القانونية والتقنية والاقتصادية والإدارية والاجتماعية والثقافية والفنية.
- تقبل البحوث باللغات (العربية والانجليزية والفرنسية).
- تنشر المجلة ملخصات الرسائل العلمية الجديدة، وتعامل معاملة أوراق العمل.
- يجب أن يلتزم الباحث بعدم إرسال بحثه إلى جهة أخرى حتى يأتيه رد المجلة.
- يجب أن يلتزم الباحث باتباع الأسس العلمية السليمة في بحثه.
- يجب أن يرسل الباحث بحثه إلى المجلة من ثلاثة نسخ مطبوعة، وملخص باللغة العربية أو الانجليزية أو الفرنسية، فى حدود ٨ - ١٢ سطر، ويجب أن تكون الرسوم البيانية والإيضاحية مطبوعة وواضحة، بالإضافة إلى نسخة إلكترونية Soft Copy، ونوع الخط Romanes Times New ١٤ للعربى، و١٢ للانجليزي على B5 (ورق نصف ثمانيات) على البريد الإلكتروني: ymgad@niip.edi.eg
- ترسل البحوث إلى محكمين متخصصين وتحكم بسرية تامة.
- في حالة قبول البحث للنشر، يلتزم الباحث بتعديله ليتناسب مع مقترحات المحكمين، وأسلوب النشر بالمجلة.

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المراسلات

ترسل البحوث إلى رئيس تحرير المجلة العلمية للملكية الفكرية وإدارة الابتكار بجامعة حلوان
جامعة حلوان - ٤ شارع كمال الدين صلاح - أمام السفارة الأمريكية بالقاهرة - جاردن سيتي

ص.ب: ١١٤٦١ جاردن سيتي

ت: ٢٠٢ ٢٥٤٨١٠٥٠ + محمول: ٢٠١٠٠٣٠٥٤٨ + ف: ٢٠٢ ٢٧٩٤٩٢٣٠ +

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**The Impact of Digital Transformation on Applying Rights
in Rem of Trademarks**

Mohamed Aboelwafa Abdelmoneim Abdelwahab

The Impact of Digital Transformation on Applying Rights in Rem of Trademarks

Mohamed Aboelwafa Abdelmoneim Abdelwahab

Abstract:

A trademark is one of the valuable assets that reflects entity's goodwill, and any holder seeks to maximize their benefits from trademarks using his legal rights over them.

The trademark is defined in Article 63 of the Egyptian IP Law number 82 for the year 2002 similar to Article 15 of Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

The Egyptian IP Law number 82 for the year 2002 in Article 87 indicated that a trademark could be assigned to others and any rights in rem could be applied over trademarks independently from the entity. In addition, trademarks could be seized. Rights in rem related to assignment and licensing of trademarks are indicated in Article 21 of TRIPS.

This paper will discuss the rights in rem that could be applied on trademarks and how applying information technology on the relevant procedures at the governmental trademarks offices could affect the time frame of issuing the final decision from these governmental authorities.

This paper will be conducted as a comparative study between the Egypt Trademarks Office who adopt manual system in applying rights in rem and the United States Patents and Trademarks Office (USPTO) who adopt electronic system in applying rights in rem of trademarks.

Introduction

What is trademarks' meaning?

The trademark is defined in Article 63 of the Egyptian IP Law number 82 for the year 2002 in accordance to Article 15 of Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) as “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible”¹.

A trademark is one of the valuable assets that reflects entity's goodwill, and any holder seeks to maximize their benefits from trademarks using his legal rights over them.

One of the tools that trademarks holders use for maximizing their benefits from trademarks is using Rights in Rem that will be discussed here from procedural aspects and comparing the procedures in the manual system that is adopted at the Egyptian Trademark Office and the electronic system adopted at the United States Patents and Trademarks Office (USPTO).

¹ Article 15 of Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

1. Rights in Rem of Trademarks

The Egyptian IP Law number 82 for the year 2002 in Article 87 indicated that a trademark could be assigned to others and any rights in rem could be applied over trademarks independently from the entity. In addition, trademarks could be seized¹. Rights in rem related to assignment and licensing of trademarks are indicated in Article 21 of TRIPS.

Trademarks are considered as assents that give the holders a full control over them and the right to monetize them through any tools that are considered as rights in rem such as assignment, licensing & mortgage.

1.1. Assignment

Assignment is a transfer of assignor's right and interest in a trademark filed for registration at the Trademarks Governmental Office whether this trademark is registered or still pending. Once the assignment is recorded, the assignee acquires all rights that were previously owned by the assignor. The transferred rights are the legal rights and subsequently the financial rights².

1.2. Merger

Merger reflects unites two or more existing entities into one new entity and this should be reflected the ownership of the trademarks and recorded at the

¹ Article 87, The Egyptian IP Law number 82 for the year 2002

² Graham, Stuart J.H. and Marco, Alan C. and Myers, Amanda, Monetizing Marks: Insights from the USPTO Trademark Assignment Dataset (April 1, 2015), P. 32. Available at SSRN: <https://ssrn.com/abstract=2430962> or <http://dx.doi.org/10.2139/ssrn.2430962>

Trademarks Governmental Office for the favor of the new entity¹.

1.3. Licensing

Licensing of trademark is granting a permission from the holder of trademark (Licensor) to another or others (Licensee or Licensee) to use the licensor's trademark on agreed terms and conditions². This agreement should be reflected and recorded at the Trademarks Governmental Office.

1.4. Mortgage

Trademarks are considered as movable assets that are recognized as collateral for finance which is called "Mortgage". This mortgage should be reflected and recorded at the Trademarks Governmental Office.

¹ Graham, Stuart J.H. and Marco, Alan C. and Myers, Amanda, Monetizing Marks: Insights from the USPTO Trademark Assignment Dataset (April 1, 2015), P. 32.

Available at SSRN: <https://ssrn.com/abstract=2430962> or <http://dx.doi.org/10.2139/ssrn.2430962>

² [전체합본\(최종지_출력실\).hwp \(wipo.int\)](#)

2. Applicability of rights in rem at the Egyptian Trademark office

The Egyptian IP Law number 82 for the year 2002 in Article 87 indicated that a trademark could be assigned to others and any rights in rem could be applied over trademarks independently from the entity. In addition, trademarks could be seized¹. Rights in rem related to assignment and licensing of trademarks are indicated in Article 21 of TRIPS².

The rights in rem that could be applied over trademarks were not identified precisely in IP law, while not all rights in rem specified in the Egyptian Civil law could be applied over trademarks.

Some types of rights in rem that could be applied at the Egyptian Trademarks Office will be discussed in the following point.

2.1. Assignment

The assignment at the Egyptian Trademarks Office is recorded to reflect the transfer of ownership of a registered trademark by filling the relevant application and submitting the requested documents that prove the transfer of ownership in condition that the deed of assignment should include the registration number of the assigned trademarks and the monetary value of these trademarks.

The Egyptian IP Law number 82 for the year 2002 and its Implementing Regulation number 1366 for the year 2003 neglected the necessity of assignment of the associated trademarks along with the mainly assigned

¹ The Intellectual property law, Article 87, enacted by the law No.82 of 2002

² TRIPS Agreement, Article 21

application. This may result in different ownership of similar trademarks.

2.2. Merger

The merger at the Egyptian Trademarks Office is recorded to reflect the transfer of ownership of a registered trademark resulted from the merger of the current applicant in a new entity by filling the relevant application and submitting the requested documents that prove the transfer of ownership in condition that the merger agreement should include the registration number of the trademarks.

The Egyptian IP Law number 82 for the year 2002 and its Implementing Regulation number 1366 for the year 2003 neglected the necessity of merger of the associated trademarks along with the mainly merged application. This may result in different ownership of similar trademarks.

The merger of trademarks at the Egyptian Trademark Office is applied in assignment form but the required supporting documents that are attached with the application of the merger is different from assignment. For assignment, the applicant should provide a deed of assignment; while for for merger, the applicant should provide the merger agreement.

2.3. Licensing

The licensing at the Egyptian Trademarks Office is recorded to reflect the granted permission from the holder of trademark (Licensor) to another or others (Licensee or Licensees) to use the licensor's trademark by filling the relevant licensing application and submitting the requested

documents that prove the licensed trademarks and the agreed terms and conditions for the licensing.

The licensing application should be filed for registered trademarks only and there is no application for non-registered trademarks.

2.4. Mortgage

The mortgage at the Egyptian Trademarks Office is recorded to reflect that a registered trademark is pawned in the favor of another company (in most cases financial institute) by filling the relevant mortgage application and submitting the requested documents that prove the mortgage of the trademark and the agreed terms and conditions for the mortgage.

The mortgage application should be filed for registered trademarks only and there is no application for non-registered trademarks.

In cases the mortgage terms and conditions could not be fulfilled by the applicant of the trademark and there is no redemption, the ownership of trademark will be transferred to the mortgagee.

The use of trademark as a collateral of finance and consequently mortgaging the trademark is recently organized by the Law number 115 for the year 2015 for Movable Guarantees and this may result in filing more trademarks mortgage applications at the Egyptian Trademarks Office.

3. Comparison between the enforcement of Rights in Rem at the Egyptian trademark office & USPTO.

The mechanism of applying rights in rem at the Egyptian Trademarks Office is complicated and may require long time to be applied and enforced since they are still adopting the manual system in the process for the examination of applications and paper applications **(Figures 1 & 2)** while the USPTO is adopting the electronic system in the process for the examination of applications and electronic procedures for applying **(Figures 3 - 10)**.

There are three categories at the Egyptian trademark office for recording assignment, merger, license and mortgage depends on the date of the relevant contract's execution date. The difference between these categories is the official fees only;

- The fees of recording assignment, merger, license and mortgage within 3 months from the relevant contract's execution date including the publication in the official gazette for the Egyptian Trademark Office are 180 EGP.
- The fees of recording assignment, merger, license and mortgage within 3 - 6 months from the relevant contract's execution date including the publication in the official gazette for the Egyptian Trademark Office are 205 EGP.
- The fees of recording assignment, merger, license and mortgage after 6 months from the relevant contract's execution date including the publication in the official gazette for the Egyptian Trademark Office are 230 EGP.

There are three categories at the USPTO for recording assignment, merger, license and mortgage depends on the number of trademarks per document;

- Recording trademark assignment, agreement or other ownership document, first mark per document US\$ 40.
- Recording trademark assignment, agreement or other ownership document, second and subsequent marks in the same document US\$ 25.

The time frame to examine the assignment, merger, license and mortgage and issue the official notice of recordation / non-recordation at the USPTO is approximately seven days from the date of application¹.

The Egyptian Trademarks Office has no time frame to examine the assignment, merger, license and mortgage and issue the official notice of recordation / non-recordation. The process depends on the availability of employees that examines the pending applications and the backlog on non-examined applications.

¹ <https://www.uspto.gov/trademarks/trademark-assignments-change-search-ownership>

4. How technology can affect the enforcement of Rights in Rem on Trademarks.

From the preceding points, we can conclude that the technology used at the USPTO affects the procedures of applying for, examining & recording rights in rem for trademarks through the Electronic Trademarks Assignment system.

This effect in the procedures is reflected on the time frame for whole process that is reduced to be approximately seven days while there is no time frame for finalizing the process at the Egyptian Trademarks Office who are still using manual system & there is no use for technology or artificial intelligence.

In case the official notice of recordation / non-recordation was not issued during the given time frame of the USPTO, the applicant can contact the Assignments Recordation Branch (ARB) who are available from Monday till Friday (except federal holidays) from 8:30 a.m. to 5 p.m. ET. through phone number, fax number¹ or e-mail².

In case the official notice of recordation / non-recordation was not issued at the Egyptian Trademarks Office, the only option available for the applicant or his agents is to arrange a visit to the office.

In case the applicants have any inquiry about the application and ETAS at the USPTO, they also can contact

¹ <https://www.uspto.gov/learning-and-resources/support-centers/assignments-recordation-branch-arb>

² <https://etas.uspto.gov/>

the Assignments Recordation Branch (ARB) who are available from Monday till Friday (except federal holidays) from 8:30 a.m. to 5 p.m. ET. through phone number, fax number¹ or e-mail².

In case the applicants have any inquiry about the application at the Egyptian Trademarks Office, the only option available for the applicant or his agents is to arrange a visit to the office.

Recommendation

The transparency the efficiency of the governmental bodies are one of the main sections of the economic side in Egypt vision 2030 for sustainable development. This would be done by establishing electronic system for all governmental bodies for performing services on a higher quality and payment processing.

The Egyptian trademark office should start a comprehensive strategy to accomplish electronic filing system for all stage and services provided by them for trademarks and industrial designs according to the Egypt vision 2030.

This system will result in achieving the requested transparency and facilitating the services rendered to investors in addition to achieving the following goals:

- Increasing the level of easiness of the provided services

¹ <https://www.uspto.gov/learning-and-resources/support-centers/assignments-recordation-branch-arb>

² <https://etas.uspto.gov/>

³ [PowerPoint Presentation \(crci.sci.eg\)](https://www.crci.sci.eg/)

- Achieving a higher level of citizen's satisfaction with governmental services
- Reducing complaints by 15% yearly
- Accomplishing fair, clear, transparent and well-organized control system.

Figure 1

وزارة التوطين والتجارة الداخلية
 جهاز تنمية التجارة الداخلية
 بوزارة المعونة للعلامات التجارية
 والملكية الصناعية
 إدارة العلامات التجارية

طلب التأشير بالانتقال ملكية العلامة

١ - رقم تسجيل العلامة :
 ٢ - اسم دافع الملكية /
 ٣ - اسم لقب من انتقلت إليه الملكية ومهنته وجنسيته ومحل إقامته
 وإن كان شركة فيذكر اسمها أو دولتها والقرض من تأليفها
 ومركزها العام .
 ٤ - الاسم التجاري من انتقلت إليه الملكية .
 ٥ - البضائع والمنتجات المسجلة عنها العلامة .
 باللفة رقم :
 ٦ - الجهة التي يوجد بها محل التجاري أو مشروع الاستغلال الذي تستخدم العلامة في تمييز بضاعه أو منتجاته .
 ٧ - تاريخ انتقال الملكية .
 ٨ - الوافعة أو العقد أو الحكم الذي تم بمقتضاه انتقال الملكية .
 ٩ - المحل المختار بمصر الذي ترسل إليه الطلبات والمستندات الخاصة بمن انتقلت إليه ملكية العلامة .

السيد مدير إدارة العلامات التجارية بالقاهرة
 أنا الموقع على هذا :
 بصفتي :
 أطلب التأشير في سجل العلامات التجارية بالبيانات الموضحة أعلاه :
 تحريراً في : سنة ٢٠١١

التوقيع

 السيد
 يرفق بطلب التأشير المستندات الدالة على انتقال ملكية العلامة . إذا كان الطلب شركة فيرفق بالطلب أيضاً مستخرج من صفحة قيدها بالسجل التجاري أو مستخرج رسمي من عقد تأليفها .

Figure 2

وزارة التوطين والتجارة الداخلية
 مصلحة التسجيل التجاري
 إدارة العلامات التجارية

طلب التأشير^(١) بالترخيص بالانتفاع بعلامة تجارية

(١) رقم تسجيل العلامة :
 (٢) اسم مالك العلامة :
 (٣) اسم لقب المنتفع ومهنته وجنسيته ومحل إقامته :
 وإن كان شركة فيذكر اسمها وعنوانها :
 والقرض من تأليفها ومركزها العام :
 (٤) البضائع والمنتجات المسجلة عنها العلامة :
 باللفة رقم :
 (٥) شروط حق الانتفاع بالعلامة :
 (٦) تاريخ الترخيص بالانتفاع بالعلامة :
 (٧) الوافعة أو العقد أو الحكم الذي تم بمقتضاه الترخيص بالانتفاع بالعلامة :
 (٨) المحل المختار بمصر الذي ترسل إليه الطلبات والمستندات الخاصة بالمنتفع بالعلامة :
 السيد / مدير إدارة العلامات التجارية بالقاهرة
 أنا الموقع على هذا :
 بصفتي :
 أطلب التأشير في سجل العلامات التجارية بالبيانات الموضحة أعلاه
 تحريراً في : من شهر : سنة ٢٠٠٠

التوقيع

 السيد
 (١) يرفق بطلب التأشير المستندات الدالة على الترخيص بالانتفاع بالعلامة . إذا كان الطلب شركة فيرفق بالطلب أيضاً مستخرج من صفحة قيدها بالسجل التجاري أو مستخرج رسمي من عقد تأليفها .

Figure 3


 United States Patent and Trademark Office	
Home Site Index Search Guides Contacts eBusiness eBiz alerts News Help	
Electronic Trademark Assignment System	
Trademark Assignment Recordation Form Navigation: Guidelines - Conveyance Type	
ETAS v 1.10.1 PTO-1594 (Rev. 11/15) OMB No. 0951-0027 (Exp. 04/30/2018)	
<h3>Conveyance Type</h3>	
Select nature of conveyance	
<input type="radio"/> Assignment of the entire interest and the goodwill	
<input type="radio"/> Assignment of an undivided part of assignor's interest	
<input type="radio"/> Nunc Pro Tunc Assignment	Effective date: <input type="text"/> Format: MM/DD/YYYY Effective date is required for 'Nunc Pro Tunc', 'Merger' and 'Merger and Change of Name' types
<input type="radio"/> Merger	
<input type="radio"/> Merger and Change of Name	
<input type="radio"/> Change of Name	
<input type="radio"/> Entity Conversion	
<input type="radio"/> Court Order	
<input type="radio"/> Corrective Assignment You must attach a copy of the original coversheet for a corrective assignment	to correct the Identify what parts of the assignment need to be corrected: <input type="text"/> previously recorded on Reel: <input type="text"/> and Frame: <input type="text"/> Assignor(s) hereby confirms the Identify conveyance text of the original assignment: <input type="text"/>
<input type="radio"/> Security Interest	
<input type="radio"/> Release of Security Interest	

Figure 4

<input type="radio"/> Mortgage	
<input type="radio"/> Lien	
<input type="radio"/> License	
<input type="radio"/> Option	
<input type="radio"/> Decree of Distribution	
<input type="radio"/> Letters Testamentary	
<input type="radio"/> Letters of Administration	
<input type="radio"/> Court Appointment of Trustee	
<input type="radio"/> Conditional Assignment	
<input type="radio"/> Other	<input type="text"/> Enter other conveyance type text here If the nature of conveyance is an "Assignment", "Merger", "Change of Name", or "Nunc Pro Tunc", do not use this box. Please check the appropriate conveyance box above. Entering your conveyance as "Other" will prevent the automatic update of your ownership information in our trademark database.
<p>• Multiple assignments with the same execution date: Are there any properties in your filing today that are the subject of multiple assignments with the same execution date that you will be filing today or that you have already filed? <input type="radio"/> Yes <input checked="" type="radio"/> No</p> <p><i>If yes, in the sequence of transfers for that property, what number is this transaction i.e. first (1); second(2); third(3), etc.? (Please just identify the numerical order in which this assignment should appear)</i></p> <input type="text"/>	
<input type="button" value="Next Screen"/>	<input type="button" value="Back"/>
<input type="button" value="Cancel"/>	

Figure 5



Correspondence Information

Enter correspondence information

Phone	<input type="text"/>
Name *	<input type="text"/>
Address	Street * <input type="text"/>
	Internal <input type="text"/>
	City * <input type="text"/>
	State * <input type="text" value=""/>
	<input type="button" value="Switch to non US address"/>
Postal code * <input type="text"/>	
E-mail Address *	<input type="text"/> Note: The confirmation receipt for this request and the Official Notice of Recordation/Non-Recordation will be sent via e-mail to the above-listed address.
Fax number	<input type="text"/> Note: 10-digits, US or Canadian number, digits only. A fax number is recommended in the event there is a problem with the e-mail address provided above.

Figure 6

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 Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) PTO-1564 (Rev. 11/15)
CMB No. 0651-0027 (Exp. 04/30/2016)

Conveying Party(ies)

Enter conveying party data

<input type="radio"/>	Prefix	First Name *	Middle Name/initial	Last Name *	Suffix
Individual	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="radio"/>	Name *	<input type="text"/>			
Company	Entity Type:	Corporation <input type="text"/>			
Citizenship	State	<input type="text"/>			
	or Country	<input type="text"/>			
Formerly	<input type="text"/>				
Date of Execution	<input type="text"/> Format: MM/DD/YYYY				

Figure 7

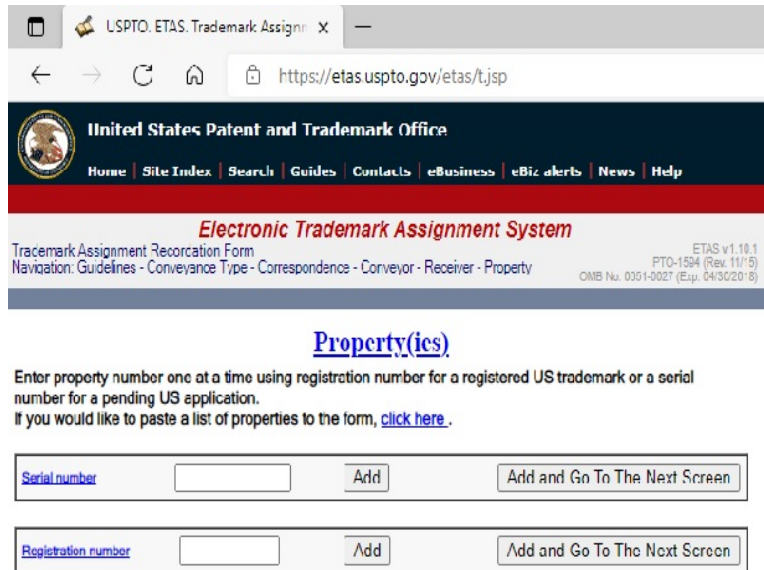


Figure 8



Figure 9



Figure 10:

