



The objective of Intellectual Property discipline, is the promotion of economic, social and cultural progress of society, through the development and monitoring of global rules and treaties of intellectual property rights which motivate innovation and knowledge creation.

Talal Abu-Ghazaleh

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#### ASIP's news

### Nine new members join ASIP

ASIP is pleased to welcome new members who have satisfied membership requirements. The new members are: Malek Al-Atiyyat, Mohamed Al-Zu'bi, Nihad Al-Husban, Luay Al-Qasem, Siwar Sameer, Hasan Al-Sawi, Kholoud Kanakrieh and Oday Ghanma (from Jordan) and Khaal-eel Qabbani (from Lebanon).

### This month's roundtable



ASIP held Saturday September 3, 2005 at its headquarters in Amman the monthly round table for September with the theme "The Role of the Customs Department in Intellectual property Protection".

The dialogue was moderated by Mr. Justice Hazem Al-Simadi, Amman First Instance Court Judge and ASIP Development and Training Committee Chairman.

Attending the dialogue was ASIP Executive Vice-Director, Adv. Mutasem Al-Domoor in addition to a number of experts, specialists and ASIP members.

Keynote speaker was Adv. Emad Nuseir, the chairman of the Studies and Research Division at the Customs Department, who submitted a paper jointly with Adv. Alia Abbu-Eisheh from the Procedure Division at the Customs Department. The paper touched on the definition of intellectual property as given by the Customs Law with specific reference to the part of that law which focuses on the application of intellectual property rights and the jurisdiction of the department under that part.



Also discussed in the paper was the legal procedures adopted in cases of IP infringement per the provisions of Article 41 of the Customs Law and the legal measures that must be taken by the IP owner to have clearance procedures stopped.

The presenters also explained the legal periods for lodging a lawsuit before competent courts and for the aggrieved party to request the Customs Department to stop all clearance procedures.

Adv. Nuseir, in this connection, hailed the cooperative ties between the Customs Department and the

private sector to combat IP infringements.

On her part, Adv. Alia explained Regulations No. 7 for the year 2000 on borders measures to be taken for IP protection and she pointed out to the main obstacles facing the Customs Department in applying these regulations.

ASIP holds the roundtable dialogue on a monthly basis as a platform for ASIP members and IP experts to discuss issues and any recent local or international development in the field of intellectual property.

## Instruction and Teaching Committee

The Instruction and Teaching Committee met Sunday 11 this month for the first time comprised of the following members:

- *Dr. Abdallah Al-Khashroum (University Instructor)*
- *Dr. Salah Al-Asmar (University Instructor)*
- *Dr. Tareq Al-Hamwi (University Instructor)*
- *Dr. Qais Mahafzah (University Instructor)*
- *Mr. Justice Hazem Al-Simadi (a First Instance Court Judge)*
- *Ms. Justice Nihad Al-Hisban (a First Instance Court Judge)*
- *Mutasem Al-Domoor (ASIP Manager)*

The committee discussed the jobs and tasks and approved the following:

- **Research**

The Training and Teaching Committee examined the issue of research in intellectual property and

asked the members to supply ASIP with their own specialised research and studies and those of other experts to be published on ASIP's website for the benefit of all members.

- **The Library**

With respect to the creation of a specialised library furnished with research, books and references in the field of intellectual property, the committee members have been asked to supply ASIP with the titles of key references and books that would be of benefit for this vital project.

- **Membership increase**

The committee's members have been asked to contribute in increasing membership and stipulating graduate students at law faculties in their universities to join ASIP.



## Apple Is Accused of Violating Software Patent

By LAURIE J. FLYNN

(Published on September 1, 2005)

**SAN FRANCISCO** - Creative Technology, a maker of portable music players, has accused Apple Computer of violating a newly granted software patent covering the way users navigate music selections.

Creative Technology, which is based in Singapore and has United States operations in Milpitas, Calif., said it would consider every option available to defend the patent, including possible legal action. Apple declined to comment on the patent.

The patent, which the company calls the Zen Patent, covers Creative's interface for portable players, which allows users to select a song, album or track by navigating a succession of menus. The patent office awarded the patent on Aug. 9.

Creative uses the navigation technology on many of its portable music devices, which account for 3.3 percent of the market, according to the NPD Group. The iPod, which in large part owes its popularity to its easy-to-use navigation system, has about 74 percent of the American market.

Craig McHugh, president of Creative's United States operations, said on Wednesday that Apple was the only company that Creative had identified so far that was in violation of the patent, though Creative was investigating others.

"We are looking at all our alternatives right now," he said. "We have always been very vigorous in our defense of our patent portfolio."

Mr. McHugh said Creative was focusing on hard-drive-based systems, rather than less-expensive flash-memory systems that typically sport a bare-bones navigation system.

The latest development comes a few months after the Patent and Trademark Office rejected an Apple application for a patent on some of the user interface concepts of the iPod, on the ground that Microsoft had filed for a similar patent.

"Apple is the 500-pound gorilla," said Mark Goldstein, an intellectual property lawyer with the SoCal IP Law Group, in Westlake Village, Calif. With the patent, he said, Creative is "trying to show they're in the same league" as Apple.

As written, Mr. Goldstein said, the patent gives Creative "a lot of opportunity," including the ability to add features it has not yet developed.

Creative executives said the company first shipped music players with the navigation system in September 2000, and filed the patent application in January 2001. Apple announced the iPod in October 2001.

Apple has several options, including requesting that the patent office re-examine the patent. If Apple fights the matter in court, the company would need to show the existence of "prior art," that is, similar technology that existed previous to Creative's use of the technology.

"What would matter then is what was out there in, say, 1999 and 2000," Mr. Goldstein said. "What anybody was doing similar to Creative could be a huge burden to overcome."

Technology companies have long used intellectual property protection to help them compete, and software companies have been known to reap millions of dollars in licensing fees.





## Court rules against Kazaa

Sydney - An Australian court ruled on Monday that users of the popular Internet file-sharing network Kazaa were breaching copyright, and ordered its owners to modify the software to prevent online music piracy.

Federal Court Judge Murray Wilcox ruled that Kazaa's Australian owner and developer, Sharman Networks, had not itself breached copyright but had encouraged millions of Kazaa users worldwide to do so.

"The respondents have long known that the Kazaa system is widely used for the sharing of copyright files," said Wilcox in his ruling in a Sydney court. According to Reuters, major Australian records companies launched a lawsuit against Marshal Networks, the developer of Kazaa system for alleged violations of copyrights causing them to lose million of dollars in sales.

"The court has ruled the current Kazaa system illegal," Michael Speck, a spokesman for the Australian music industry, told reporters outside the court. "It is a great day for artists, it is a great day for anyone who wants to make a living from music."

Australian record companies will now seek damages for hundreds of millions of illicit music downloads at a later hearing.

Sharman Networks had defended the use of the Internet to download music tracks, telling the court that file sharing represented a revolution in the way music was distributed and sold.

It said it could not control the actions of an estimated 100 million worldwide users.

Judge Wilcox said Kazaa failed to use available technology such as key word filters to prevent copyright infringement because it would have been against its financial interest.

He said that Kazaa's "Join the Revolution" Web site campaign did not directly advocate sharing copy



right files, but criticized record companies for opposing file sharing.

"It seems that Kazaa users are predominately young people, the effect of this web page would be to encourage visitors to think it 'cool' to defy the record companies by ignoring constraints," Wilcox said.

Wilcox ordered Sharman Networks to modify the Kazaa software with filters to protect copyright.

"If Kazaa cleans up its act and does what the court has ordered it to do, stop its illegal business, then they have an opportunity to be part of the music industry," said music industry spokesman Speck.

In recent years, world sales of recorded music fell by 7.6% in value to 32 billion dollars in 2003, according to the World Federation of Phonographic Industry, which blames the decline on wide piracy, low economic conditions and CD/DVD competition.

File-sharing enthusiasts claim that sharing files encourages people to buy music by offering a big number of music varieties.



## Selling non-trademark search words



By: Adv. Adnan Baranbo – ASIP member

Search engines are important tools for using the information and services available through internet. The World Wide Web is replete with information and documents offered through billions of websites, which requires a certain mechanism that would enable the internet users to have access to the information they request on a given topic as easy and smooth as possible.

It is true that every website has a peculiar domain name, but it is also a fact that retrieving information from the internet by visiting the websites of all relevant institutions and corporations would almost be impossible. This process of information retrieving requires first of all knowing these institutions or corporations and then knowing their respective domain names, which eventually cannot be obtained before surfing thousands even tens of thousands of websites to reach the required piece of information. Now, it is obvious that such a method of looking up information in the dictionary is tiring and inefficient not to mention the waste of time and money.

To make life easier, some companies specialised in computer software and working through the internet contrived some software that would facilitate the search of these domains by entering certain 'search words' in the location specified for this purpose and then the program will search for the relevant information and give in record time a list of relevant results. Google, Yahoo, MSN, Lycos and Altavista are some examples of what is commonly known as "Search Engines".

Search engines are free of charge. But, the question is since these search engines are used for free, how do their owners and operators make profit?

Most of these companies in fact make profit from the ads that are posted on their sites. By clicking on an add, the user is directed into the respective company. Some search engine owners tend even to sell search words to companies and firms which work through internet in such a manner that when one searcher for a key word, the company which 'bought the search word' would have its website topping the list of results. The appearance of a corporation link

within top search results is very important owing to the fact that a typical user usually tends to refer the first-page results rather than proceed to view subsequent pages that might amount to thousand ones. The company also may contract with the search engine operators to post the add of the respective company once a specific search word is entered by the user.

### What's the problem?

The above explained practice of the search engine is so far illegal and is very rewarding financially, so to speak. However, there has recently been a trend by search engines to sell search words that correspond to trademarks owned by third parties, firms or individuals who might in some cases be competitors of the original trademark owners. In the latter case, the name and link of a competitive firm may appear in the result list when requesting a search for a word or phrase that represents a trademark.

Google has, for example, announced as of April 2004 a new advertising policy accepting the selling of trademarks as search words. Before that, Google did not permit any person or firm to use a third party's trademark as a search word without getting prior permission from the owners.

The above mentioned policy in fact would not make any problem in case a trademark was sold as a search word to a non-competitive company. But what if the buyers were competing with the trademark owners? By clicking on the ad of the competing company, the user is prompted to its site, a result that could be totally undesirable by the trademark owners. Let us imagine what would happen. The user is attracted by the ad. He clicks on it and is thus directed to the site of a company that offer goods or services competing with the owner of the trademark searched for. The user is pleased with what he sees in the website and makes a good translation with the site owners. And, the result is increasing reputation of the competitive company coupled with huge losses for the original trademark owners in terms of declining sales and defamation of the trademark.



The practices of the companies advertising in this way might even be a fraud when the ad does not show exactly the destination of clicking it. In this case, it does not show the type and quality of the goods without mentioning the name or trademark of the owners, which misleads the user to believe that the ad is owned to the company he has requested the search engine to look for. This means in other words that the user is surfing 'against his own will' a site of a company competing with the real company he is looking for.

### Are trademark owners happy with that?

Not at all! As a matter of fact, trademark owners seem upset with the new advertising policy recently practiced by search engines. These practices, they say, infringe on their trademarks and constitute an illegal use of their trademarks as long as other competing companies would have their details listed in the result list of a search conducted for their trademarks.

To be upset, however, is not enough to make legal grounds for sound objections to the practices explained above. The trademark's key function is to make a distinction between goods or service of one party from another. Infringement by imitating or counterfeiting a trademark, therefore, will not be construed to have taken place unless a practice deceives or at least has the likelihood to deceive consumers regarding the source of the goods or services in question, which the trademark owners should prove.

From the eyes of trademark owners, deceiving the consumer though the above practice is inevitable as the user would be totally aware that the competing site he is surfing is different from the one he intended, which in turn results in inevitable injury on the part of the trademark owners. Now the user finds goods or services similar to the ones he was searching for despite the fact that they carry different trademarks and are offered by other companies. The user may well like these goods or services and tend to buy them instead of having to look once again for the original site he was primarily interested in.

Trademark owners as well have claimed that search engines by this practice are exercising 'commercial espionage' and that it does constitute an unfair act of competition at their own expense. They cite the impermissibility of the competing third party's in-

tervention in a phone transaction, a totally non-ethical practice contradicting the rudiments of trade ethics and traditions. By analogy, they say, search engines intervene in the user-company transaction by giving a result to the user that would direct him to the competing company.

Besides, trademark owners view the practice as abusive of the *raison-d'être* of these search engines, whose main function is to serve users in finding relevant information through the internet with as much accuracy and smoothness as possible rather than to mislead and cheat the consumers.

### Search Engines' Response:

Search engine owners did not accept the above claims arguing that trademark owners do not understand what modern technology is all about setting many examples to support their counterclaims. Let us have a consumer enter a mall with the intention to buy special goods produced by some reputed company. Upon asking the inquiry department about the required store, he is directed to the second floor. In his way up, he passes by another store that exhibits similar goods produced by other companies. He notices that the goods bear a different trademark than the one he was originally looking for but still feels interested enough to buy them. In this manner, deception cannot be said to have taken place and no infringement has occurred as long as the consumer has noticed the difference of the source of the goods he is buying.

By the same token, deception should have not taken place should the consumer be directed through the search engine to "an electronic market" where he is free to choose to buy the goods he intended for or the similar goods, which he surely knows are of different origin and trademark.

In the law, besides, no provision is stipulated against magazines and newspapers advertising in one page two commercials of two competitive companies. The same ruling must apply, search engine owners say, to the case where a search engine provides for alternatives of competing companies for a search done on the internet. They see nothing illegal or unfair in these practices under traditional trading standards. The point in other words is that search



engines encourages competitiveness rather than infringement.

Defending the practices of his company, a Google spokesman has recently stated that his company's tendency to clearly and openly disclose its policy in this regard will make the users understand the way in which Google search engine works and will accordingly "not lead to consumer deception".

#### So, how to do with it?

Several trademark owners have sued search engine companies worldwide with different results depending on the court at which the case has been raised. The problem is that trademark laws were enacted prior to the creation and wide-spread of the internet, and naturally search engine practices are not covered by these laws. The whole matter therefore was totally left to the discretion of the judge himself.

In France, a tourism company, sued a Google local branch for selling the former's trademark as a search word to a competing company. The first instance court ruled that Google branch pay US\$100,000 as a compensation for the tourism company, forthwith terminate the transaction in question and stop advertising for competing companies in result lists affiliated with a search for a given tourist trademark. Google appealed, but the appeal was rejected.

Google and other search engine companies were also sued by other companies in France with rulings similar to the one previously mentioned.

The case was a bit different in the States, where there seemed no harmony in juristic rulings in different courts. Former courts examining cases launched by trademark owners ruled that such an act was unfair and that search engine companies should refrain from these practices. But, the Virginian Court, however, has recently ruled, in a case launched by an insurance company against Google

on the claim that the latter sold the former's trademark as a search word, that it is OK for search engines to proceed forward with the practice in question. It viewed that Google's advertising policies do not violate the trademark law as nothing proved in the case that the relevant activity could be sufficient alone to mislead the consumers, though the same ruling construed that the advertisements that would appear in a result list which contains the trademark owned by the plaintiff could lead to the likelihood of consumer deception, which means Google should stop advertising in this prescribed manner.

In response, Google announced it would stick to its advertising practices, which were judicially deemed legal and it announced that it would request advertising companies to change the designs and contents of their ads should these ads mislead the consumers for containing, for instance, a trademark owned by third parties in otherwise case of which it would remove the ad in question on a permanent basis.

In fact, judicial discretions (considered to by non-binding for other competent courts) disagree with each other on the global level. Even in the States, provisions on the matter are inconsistent, as previously explained. It follows therefore that there is no harmonized legal basis to regulate this arena and make internet users and businessmen act accordingly. This lack of harmony between courts from one state to another, even from one region to another inside the same state, search engines would have to increasingly face up more lawsuits launched by trademark owners before these courts, whose rulings will be in favour of the trademark owners and at the expense of the search engines owners.

Last but not least, for those who wish to pursue the same course that Google did or those who wish to buy competitive trademarks as search works, the only counsel an advocate can give to them is that there is no single law directly governing this arena, which is left to the discretion of judges and may be done only at the risk of the companies intending to do so.



## WIPO NEWS

# WIPO BEGINS ON-LINE PUBLICATION OF THE WIPO GAZETTE OF INTERNATIONAL MARKS

The World Intellectual Property Organization (WIPO) began this month publishing an on-line edition of the WIPO Gazette of International Marks, the official publication of the Madrid System for the International Registration of Trademarks. The Madrid System is a user-friendly and cost-effective service offered by the World Intellectual Property Organization (WIPO) which facilitates the process of securing trademark protection in multiple countries. The on-line version of the Gazette is available on a weekly basis and is free-of-charge. The Gazette is also available on paper and on CD-ROM, on a subscription basis.

The WIPO Gazette of International Marks contains all relevant data on new international registrations, renewals, subsequent designations as well as other changes to and entries affecting international trademark registrations. The Gazette also contains information of general interest such as declarations and notifications made by contracting parties under the Agreement, the Protocol – the two treaties that govern the Madrid System – or the Common Regulations under these treaties regarding particular requirements, or the amounts of individual fees. The on-line edition of the Gazette is an electronic reproduction of the paper version, but offers a number of important advantages for users. Apart from full text search facilities, the on-line version:

- allows easy and immediate access to the contents of an issue of the Gazette as of the day of its publication; and
- is free-of-charge.

The CD-ROM edition is published every four weeks and is cumulative. It also includes a cumulative index for the year to which it relates. This index allows simple searches to be made in one or more issues

within a single year according to the name of the holder, the international registration number, any verbal elements of the mark and the type of record published. The search result consists of a list of hits with links to the relevant issue and page of the Gazette. This index is available only on CD-ROM. Further information about these products is available from the WIPO electronic bookshop at <http://www.wipo.int/ebookshop>.

The international trademark system administered by WIPO allows a trademark owner the possibility of having a mark protected in up to 76 countries and the European Community (EC) by filing one application, in one language, with one set of fees, in one currency (Swiss francs). Thereafter, the international registration can be maintained and renewed through a single procedure. An international registration under the Madrid System produces the same effects as an application for registration of the mark in each of the contracting parties designated by the applicant. If protection is not refused by the trademark office of a designated contracting party, the status of the mark is the same as if it had been registered by that office. In other words, the system provides a cost-effective and efficient way for trademark holders to secure protection for their marks in multiple countries through the filing of a single application.

The system is governed by two international treaties, namely the Madrid Agreement and the Madrid Protocol. The Madrid Protocol which became operational in 1996 introduced several features including the ability to submit applications in English and extend the period for notification of a refusal which made the system more flexible and attractive to a larger number of countries. Applicants may now submit applications in three working languages of the system, namely, English, French and Spanish.

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Pakistan	+ 92 21 4388113	+ 92 21 4388115	<a href="mailto:agip.pakistan@tagi.com">agip.pakistan@tagi.com</a>
China	+ 8621 68762682	+ 8621 58355336	<a href="mailto:agip.china@tagi.com">agip.china@tagi.com</a>



## Membership Enrollment Form طلب انتساب للعضوية

Applicant مقدم الطلب

Membership Category: نوع الاشتراك:

Individual  Company  فرد  مؤسسة

Academic Qualifications (Individual) / Form of Company المؤهلات العلمية ( للفرد ) / نوع الشركة

Profession /Primary Business or Service المهنة / مجال العمل الرئيسي

Experience and/or interests in IP issues مجال الخبرة و/أو الاهتمام في موضوعات الملكية الفكرية

Nationality / Head Office الجنسية / المقر

Postal Address العنوان البريدي

Tel. هاتف Fax فاكس

E-mail and Webpage (if applicable) البريد الالكتروني والموقع الالكتروني ( إن وجد )

Are you or have you ever been, a member of another organization with similar goals and activities, please name. هل أنت - أو سبق أن كنت - عضوا في منظمة أخرى لها غايات و أعمال ماثلة، الرجاء تسميتها.

References: المعارف:

1. \_\_\_\_\_ ١. \_\_\_\_\_  
2. \_\_\_\_\_ ٢. \_\_\_\_\_

I have read the ASIP Articles of Association (published on the website). And wish to join in order to benefit from and participate in ASIP's work, events and activities. لقد أطلعت على النظام الاساسي للمجمع (المنشور على الموقع الالكتروني). وأرغب بالانضمام للإستفادة من والمشاركة بالأعمال والفعاليات والنشاطات التي يقوم بها.

Date التاريخ Signature التوقيع

Return To: **Arab Society For Intellectual Property**

P.O. Box 921100 Amman - Jordan

Tel.: 00962 6 5100 900 / Fax: 00962 6 5100 902

Or by e-mail to: info@aspip.org

يرسل الطلب إلى : المجمع العربي للملكية الفكرية

ص.ب ٩٢١١٠٠ عمان - الأردن

هاتف: ٠٠٩٦٢ ٦ ٥١٠٠ ٩٠٢ \ فاكس: ٠٠٩٦٢ ٦ ٥١٠٠ ٩٠٢

بالبريد الالكتروني إلى info@aspip.org

The annual Membership fees are in USDollars: 100 for Companies and 50 for Individuals. The fees are due in January of every year, and can be paid either in cash at ASIP's Liasion Office or by Check payable to **ARAB SOCEITY FOR INTELLECTUAL PROPERTY**.

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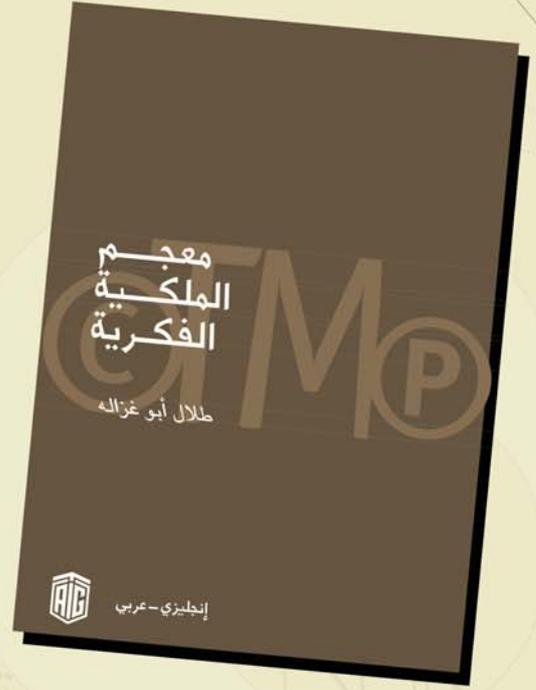
إصدار ( ٢٠٠١ )

سعر المعجم لأعضاء المجمع  
\$ ١٠ فقط

# معجم أبوغزاله للملكية الفكرية

ستة آلاف كلمة و مصطلح  
يغطي مصطلحات الملكية الفكرية

(العلامات التجارية، براءات الاختراعات،  
حقوق المؤلف، الرسوم والنماذج الصناعية  
تقنية المعلومات و الإتصالات الأساسية  
و التجارة الإلكترونية، نظام التجارة الدولية،  
نظام العولمة ، المعاهدات و الإتفاقيات الدولية)



لطلب القاموس يرجى تعبئة النموذج وإرساله مع شيك بالقيمة المطلوبة على العنوان التالي أو على أي من مكاتب تمثيل المجمع في الوطن العربي:

الإسم

الشركة

العنوان

بريد إلكتروني

هاتف

فاكس

لمزيد من المعلومات يرجى الإتصال بإدارة المجمع العربي للملكية الفكرية:

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