

United Arab Emirates

Contributing firm
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Legal framework

In the United Arab Emirates, trademark protection is governed by Law 37/1992 (as amended by Law 19/2000) and Law 8/2002 (the Trademark Law).

As a member of the Gulf Cooperation Council (GCC), along with Bahrain, Kuwait, Oman, Qatar and Saudi Arabia, in 2006 the United Arab Emirates approved a law aimed at unifying the trademark laws of the GCC member states. This law has not been ratified yet.

In addition, the United Arab Emirates has been a member of the Paris Convention for the Protection of Industrial Property since September 19 1996. It also a member of the World Trade Organisation (WTO) and the World Intellectual Property Organisation, as well as a signatory to the Nice Classification of Goods and Services.

Unregistered marks

Little protection is offered to unregistered marks unless they are well-known or famous marks. Such trademarks enjoy a degree of protection, whether registered or not, including against unauthorised registrations of translations.

The UAE Trademark Law does not specify what constitutes a famous or a well-known mark. This is usually determined according to the international standards for the protection of well-known trademarks (Article 6*bis* of the Paris Convention), as well as the local standards for well-known trademark protection.

However, Article 4 of the Trademark Law governs well-known trademarks and their protection in the United Arab Emirates. It stipulates that “the degree of knowledge or recognition of the mark in the relevant sector of the public is essential in determining how famous the trademark is”. In practice, any trademark with an international reputation is

“ Protection for unregistered marks can be sought through both civil and criminal actions. The owner of an unregistered trademark may initiate legal proceedings in order to seek an injunction or to obtain monetary compensation for an act of passing off ”

considered a well-known trademark and may be registered in the United Arab Emirates only by the owner of the original trademark if two conditions are met:

- use of the mark implies a connection between the goods/services to be protected and the goods/services of the owner of the original trademark (Article 4(3)(a)); and
- use of the mark results in damaging the interest of the owner of the original trademark (Article 4(3)(b)).

Registered marks

The United Arab Emirates is a union of seven emirates and filing a trademark application will cover all seven emirates – namely, Abu Dhabi, Ajman, Dubai, Fujairah, Ras al Khaimah, Sharjah and Um Al Quwain.

Article 3 of the old UAE Trademark Law described the 12 types of trademark that were barred from registration. The new Trademark Law (8/2002), as amended, added two trademarks to the list of those that cannot be registered in the United Arab Emirates under Article 3. They are:

- national and foreign decorations and metal and paper currencies; and
- a trademark considered a translation of a famous mark or another previously registered mark.

The United Arab Emirates uses the international classification system of goods and services under the Nice Agreement. However, alcohol-related trademarks in Class 33 are not eligible for registration in the United Arab Emirates (a Muslim country); Class 32 for non-alcoholic beverages can be used as an alternative. Trademarks may also not be registered in relation to Class 43 (clubs and bars).

Procedures

Searches

Searches carried out at the UAE Trademark Office list all applications and registrations that are identical and/or similar to the trademark at issue. Searches per applicant, class or for all classes, and searches for logos or three-dimensional designs are unavailable.

Filing and examination

To be able to file a trademark application before the Trademark Office at the Ministry of Economy, a power of attorney – executed, notarised and legalised by the UAE consulate in the country of execution – is needed. Further legalisation by the Ministry of Foreign Affairs and a legal translation are required.

Furthermore, the power of attorney can be filed within 60 days of filing the application, provided that an undertaking to do so is submitted with the application; this can be extended for further 30-day periods upon submission of a written request to the Trademark Office.

Multi-class applications are not permitted.

For priority claims, one certified copy of the priority document is sufficient.

Once a trademark application is filed, it is examined as to its inherent registrability and against prior rights.

If the examiner at the Trademark Office issues a preliminary examination report asking for amendments in the application, the deadline to have these changes made is 100 days from the date of receiving the official notice.

The preliminary examination report will be followed by:

- an unconditional acceptance, if the application is accepted, official fees for

publication are paid and the trademark is published in the *Trademark Journal*, as well as in two local daily Arabic newspapers, and the clippings of the publications are submitted to the Trademark Office.

Any interested party may file a notice of opposition to the registration of the mark within 30 days of the date of publication.

The registrar's decision concerning the opposition may be appealed before the Trademarks Committee (which is made up of representatives from the Ministry of Economy and Commerce, and from the Chamber of Commerce) and the committee's decision to the competent court. The registration process is stayed until a decision is made. In the absence of opposition, a trademark is registered and the relative certificate of registration is issued;

- a conditional acceptance – the applicant will be given a non-extendable 30-day deadline either to appeal or accept the condition, and pay the official publication fee; in case of appeal, official fees are paid for each objection to an examination report or for each hearing before the Trademarks Committee. The committee's decision is subject to appeal before the civil courts; or
- a notice of rejection – if the trademark does not meet the criteria stipulated by the laws for the trademark to be registered, the examiner will issue a notice of rejection. In this case, the applicant will be given a non-extendable 30-day deadline to appeal the decision.

Opposition

Once the opposition action is filed, the Trademark Office notifies the applicant of the opposition proceeding action. Under the Trademark Law, this should be done ideally within 15 days of the date of filing the opposition. The applicant will have 30 days to file its counter-arguments, pointing out the legal grounds on which the trademark registration should be granted. Any party may ask for a hearing that would be held at the Abu Dhabi Trademark Office to discuss the case further. Failure to submit a response within the statutory timeframe will result in the automatic acceptance of the opposition action and the rejection of the trademark.

“ A licence agreement can be limited, but should not include any restrictions that do not result from the trademark registration, or that are not necessary to maintain such rights ”

Cancellation

With regard to unlawful registration, Article 21 of the Trademark Law stipulates that:

the Ministry or any interested party may apply for the cancellation of the trademark registration, which was unlawfully registered. The Ministry shall cancel the registration whenever it receives a final judgment thereof, accompanied by the implementing wording of the same.

Under Article 22 of the Trademark Law, the relevant civil court will order the cancellation of a trademark registration if an interested party:

- files a request for cancellation for non-use; and
- proves that the registered trademark has not been used for five consecutive years.

A trademark cancellation from the register shall be published in the *Trademark Journal* and two local newspapers at the applicant's expense (Article 25).

Once a trademark has been cancelled, it may be re-registered in favour of others for the same products only after three years have elapsed since the cancellation date (Article 26).

Renewal

A trademark registration is valid for 10 years. The registration may be renewed indefinitely for additional terms of 10 years upon filing a renewal application during the final year of the existing registration period or within three months thereafter.

Enforcement

The owner of a registered trademark has the right to prevent others from using an identical or similar trademark to distinguish identical or similar or related goods or services to those distinguished by the registered trademark in a manner that may mislead the consumer public.

In this context and under Article 37 of the Trademark Law, the following acts are punishable:

- counterfeiting a trademark that is lawfully registered or imitating it in such a manner as to mislead the public, or using in bad faith a counterfeit or imitated trademark;
- making unauthorised use of a registered trademark owned by another party;
- applying, in bad faith, a registered trademark owned by another party on one's products;
- selling or offering for sale or circulation, or possessing for the purpose of sale products that bear a counterfeit or an imitated trademark; and
- intentionally offering services under a forged, imitated or unlawfully used trademark.

The penalties provided for infringing trademark rights are a fine of between Dh5,000 and Dh10,000 and/or imprisonment of up to one year.

The trademark owner has the option to choose between criminal proceedings, by filing a complaint with the police, and administrative proceedings, by filing a complaint with any of the administrative authorities in the United Arab Emirates, such as the Economic Development Departments and Ministry of Economy.

After gathering enough evidence, a raid action will be organised and the counterfeit goods will be seized and then destroyed.

Furthermore, the rights holder may file a civil case to request compensation for damages suffered.

Ownership changes and rights transfers

Changes in the name and/or address of

the registrant must be recorded in order to protect rights.

The ownership of a trademark may be transferred and a mark may be mortgaged or attached along with or without the commercial shop or project of exploitation for which the mark is used to distinguish its products or services.

The transfer of ownership of a commercial shop or an exploitation project shall include the trademarks registered in the transferor's name that may be considered closely related to the shop or project, unless otherwise agreed upon.

Should the ownership of a commercial shop or exploitation project be transferred without the mark, the ownership transferor may continue to use the mark with regard to the products or services for which it is registered, unless otherwise agreed.

Unless an assignment has been recorded in the register and published in the *Trademark Journal*, the assignment shall have no effect *vis-à-vis* third parties. Article 29 confirms that the transfer of ownership of a trademark or its mortgage may not be opposed to third parties, except after being entered in the Trademarks Register and announced in the manner determined in the Executive Regulations.

Licences

Articles 30 to 34 of the Trademark Law govern the licensing of trademarks, providing that the owner of a trademark may, "by a written and notarized contract", license one or more persons to use such mark for all, or some, of the products or services for which the trademark is registered.

The rights holder is at liberty to choose to grant an exclusive or non-exclusive licence in the United Arab Emirates.

Furthermore, a licence agreement can be limited, but should not include any restrictions that do not result from the trademark registration, or that are not necessary to maintain such rights.

However, the agreement can include restrictions on:

- the geographical area for marketing products or services bearing the trademark;
- the period for using the trademark;
- the quality control of the products under the licence; and
- the actions that may lead to lowering the value of, or causing harm to, the products or services bearing the trademark.

It is highly recommended to set out the actual rights or limitation of the rights of the trademark owner in the agreement and not leave the rights of the trademark licensor open to interpretation.

To be enforceable, the licence must be recorded at the Trademark Registry, without which the licence has no effect against third parties.

Article 20 stipulates that where the trademark is licensed for use under a contract that has been entered in the Trademark Register, it should not be cancelled without a written consent from the licensee, unless the licensee assigns this right clearly in the licence agreement.

The ministry notifies the other party when the application to cancel is filed.

The other party can oppose the cancellation application.

Online issues

The Trademark Law does not cover the unauthorised use of marks in domain names. However, as the United Arab Emirates is a member of some of the boards of the Internet Corporation for Assigned Names and Numbers, a complaint can be filed using the Uniform Domain Name Dispute Resolution Policy (UDRP).

In general, a UDRP complainant must establish three elements to succeed:

- The domain name must be identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- The registrant must have no rights or legitimate interests in the domain name; and
- The registrant registered the domain name and is using it in bad faith. [WTR](#)

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Non-traditional marks registrable?
Yes/Yes   	Yes 	3D; sounds. 
Unregistered rights		Opposition
Protection for unregistered rights?	Specific/increased protection for well-known marks?	Can a registration be removed for non-use? Term and start date?
No: unless the trademark is considered well known. 	Yes 	Yes: 30 days. 
Removal from register		
Can a registration be removed for non-use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
Yes: five consecutive years' non-use. 	No 	Yes 
Enforcement		
Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
No 	Yes 	Yes 
Ownership changes	Online issues	
Mandatory registration for assignment/licensing documents?	National anti-cybersquatting provisions?	National alternative dispute resolution policy (DRP) for local ccTLD available?
Yes/Yes 	Yes 	Yes 

Contributor profiles
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Rawan Sunna studied law in Jordan and obtained her LL.M. in IP management from Bournemouth University in the United Kingdom. She has over 13 years' experience in advising and providing professional IP-related services in the United Arab Emirates and many other countries in the Arab world. Her practice focuses mainly on IP enforcement, analysis of enforcement laws, anti-counterfeiting programmes, as well as trademark law. As a partner and senior manager of Al Shaali & Co Advocates and Legal Consultants – IP Division, she heads both the legal consultancy and trademark departments.



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Malek Khalifeh managed the legal department of the Dubai office of Rouse & Co International before leaving to help set up the IP division of Al Shaali & Co Advocates and Legal Consultants. Mr Khalifeh also held the post of director of the legal department and corporate security at Japan Tobacco International (the world's third-largest tobacco company) for five years, where he oversaw the all of Africa, the Middle East, the Near East (Iran, Pakistan and Afghanistan) and Turkey.



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Salem Al Shaali is the managing director of Al Shaali & Co Advocates and Legal Consultants Legal Group. His experience includes time as a police officer (lieutenant) and public prosecutor (he was among the first appointed UAE public prosecutors, before becoming a senior public prosecutor). He later attended the Judicial School, from where he graduated as a judge. However, Mr Al Shaali elected not to sit on the Bench, choosing instead to open his own law office, Al Shaali & Co, in 1997.