

Registering trademarks in the UAE

Hassan Mohsen Elhais details the legal steps that need to be followed to register a trademark and the due diligence involved if it has been infringed upon.

The registration and protection of trademarks in the United Arab Emirates is regulated by Federal Law No. 37 of 1992 and executive regulations promulgated hereunder. The UAE courts have, in fact, recognised the rights to trademarks and the need to protect the same well before the promulgation of Trademark.

Trademark is a recognisable sign, design or expression which identifies products or services of particular suppliers from those of the others. The trademark owner can be an individual, a business, or a legal entity. A trademark may be positioned on a package, label, and voucher or on the product itself. For corporate identity reasons, trademarks are also displayed on company buildings.

There are two types of trademarks – international and local. These differ in their scope of protection, disputes and jurisdictions.

THE PROCESS

Local trademarks are typically registered within the local jurisdiction and enjoy full protection within local borders. Registering a local trademark is made by submitting a request at the UAE Ministry of Economy and Commerce. If the authorised Ministry accepted the trademark request, it proceeds to publish the mark in two newspapers. If an individual or a company has an objection against such trademark, an objection must be submitted to the ministry within thirty days from the date of last publication.

International trademark is a foreign trademark registered in a foreign country. It not only covers its area of origin but additionally covers other international areas and jurisdictions as well. It is important to note that it is not mandatory for an international trademark to be registered in all/or most jurisdictions to be recognized as an international brand or mark in UAE.

IN CASE OF INFRINGEMENT

Infringement may occur when one party uses a trademark which is identical or confusingly similar to a trademark owned by another party 'the legal owner'. Such cases challenge the corporate identity of organisations and can act as a marketing challenge for the purposes of differentiation, hence having a direct impact on their business model.

In the event of an infringement of a trademark, be it international or local, the trademark owner can take legal action by filing a suit at Abu Dhabi Federal Court against Ministry of Economy and Commerce and



the party attempting to register a similar trademark that may lead to potential infringement. The remedy in these kinds of cases may be to claim monetary compensation from the party who attempts to use a similar trademark and request to remove that trademark from Ministry's records.

If there was a local trademark registered by a local company in UAE which is later challenged by an International company claiming that the trademark registered in UAE infringes their international trademark, the onus is on the international company to prove that their mark is well known amongst consumers and it's recognizable worldwide. The judge has discretionary power to uphold their challenge or reject based on the merits of the case and the international significance of the mark.

Furthermore, as per Article 17 of Federal Law No. 37 of 1992, if the owner of the local trademark continues to use his mark for five consecutive years without being challenged, then any challenge against him regarding his trademark shall be dismissed by the court. 🏛️

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