

Amendment of the UAE Trademarks Law

Federal Law No. 8 for the year 2002 amending Articles of the Federal Law No. 37 for the year 1992 (both the old Law and the new amendments inserted)

We, Zayed Bin Sultan Al Nahyan, President of the United Arab Emirates, after the perusal of the provisional constitution, and:

- The Federal Law No. (1) of 1972 regarding the fields of specialization of the Ministries, and the specialties of Ministers, and the laws amending thereof,
- The Federal Law No. (4) of 1979 regarding the suppression of fraudulence and deception in the commercial dealings,
- The Federal Law No. (5) of 1985 regarding the issuance of the law of the civil dealings and the laws amending thereof,
- The Federal Law No. (3) of 1987 regarding the issuance of the Criminal Law

and according to the presentation of the Minister of Economy and Commerce, the approval of the Council of Ministers and the ratification of the Supreme Council of the Federation,

We have issued the following Law:

ARTICLE (1)

In the application of the provisions of this law, the following words and phrases shall have the meanings shown against each of them, unless the context otherwise indicates:

- The State : The United Arab Emirates
- The Minister : The Minister of Economy and Commerce
- The Ministry : The Ministry of Economy and Commerce
- The concerned authority : The concerned authority of the Emirate.
- The Journal : Trademark Journal issued by the Ministry.
- The drawing : Each design containing a group of visions (any artistic formation.
- The symbol : The visible drawing.
- The emblem : The engraved marks.
- The inscriptions : The protruding marks
- The photos : Man's photos, whether the photo of the project owners or of others.
- The Register : Trademark Register at the Ministry.
- The committee : The Trademark Committee, provided for in the Law.

ARTICLE (2)

A trademark is anything which takes a distinctive form whether names, words, signatures, letters, figures, drawings, symbols, titles, tax stamps, seals, pictures, inscriptions, advertisements or packs or any other mark or a combination thereof, used or is intended to be used, either in distinguishing goods, products or services whatever their origin is, or to show that goods or products are owned by the mark owner by virtue of their manufacture, selection or dealing in, or to indicate the performance of a service.

Sound is considered a part of the trademark if it accompanies thereto.

ARTICLE (3)

The following shall not be registered as a trademark or as a component thereof:

1. The mark, which is devoid of any distinctive character or property, or the mark, which consists of mere denominations called by the tradition on goods, products or services, or familiar drawings and ordinary pictures of goods and products.
2. Any mark violating the public morals or desecrating the public order.
3. The public emblems, flags and other symbols pertaining to the State, Arab or international organizations or any institutions thereof, or any foreign country unless having an authorization there from, or any imitation of such emblems, flags or symbols.
4. Symbols of the Red Crescent or the Red Cross and other similar symbols as well as the marks, which are imitations thereof.
5. Marks, which are identical or similar to the symbols of pure religious nature.
6. Geographical names where the use thereof may cause confusion as to the origin or source of the goods, products or services.
7. The names, surname, photograph or emblem of a third party, unless he or his heirs' prior consent to use has been obtained.
8. Particulars pertaining to titles of honor which registration applicant cannot prove that he is lawfully entitled thereof.
9. Marks which may mislead the public or which contain false data as to the origin or

the source of products or services, or about their other characteristics, as well as marks containing an imaginary, imitated or forged trade name.

10. Marks owned by natural or legal persons, dealing with whom is prohibited.

11. Mark, the registration of which for some classes of products or services may diminish the value of other products or services distinguished by such mark.

12. Marks containing the following words or phrases: "Privilege", "Privileged", "Registered", "Registered drawings", "Copyright" or "Imitation is forgery" or similar words and phrases.

13. National and foreign decorations and metal and paper currencies.

14. A trademark considered as a translation of a famous mark or another previously

registered trademark if registration of that mark will result in confusing the consumer public as to the goods distinguished by the mark or other similar goods.

ARTICLE (4)

1. Trademarks of international reputation, which goes beyond the borders of the original country of the trademark to other countries, shall not be registered, unless so requested by its original owner, or by an official power of attorney from the original owner.

2. 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.

3. A famous trademark may not be registered to distinguish goods/services not identical to those distinguished by these marks if:

a. 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.

b. Use of the mark may result in damaging the interest of the owner of the original trademark.

ARTICLE (5)

There shall be prepared in the Ministry a register called "Trademark Register", wherein all trademarks, names and addresses of their owners, kind of their activity, descriptions of their goods, products or services shall be entered, as well as change, transfer, assignment, mortgage, license or any other amendments are made thereof.

Any person may ask for a true copy of what is registered in the Register after the payment of the prescribed fees.

ARTICLE (6)

The following persons shall have the right to register their trademarks:

1. Natives of natural or legal entity, practicing any of the commercial, industrial, professional, or service business.
2. Foreigners of natural or legal entity, practicing any of the commercial, industrial, professional, or service business in the State.
3. Foreigners of natural or legal entity practicing any of the commercial, industrial, vocational or service business in any state having reciprocity of treatment with the State.
4. Public legal persons.

ARTICLE (7)

Any person desiring to use a trademark to distinguish goods, products or services, may apply for its registration in accordance with the provisions of this Law.

A trademark application shall be filed at the Ministry under the conditions and terms provided in the Implementing Regulations.

ARTICLE (8)

A trademark may be registered in one or more of the classes of products or services according to the International Classification and its provisions, which the Implementing Regulations specify. However, a trademark application shall not include more than one class.

ARTICLE (9)

It may be possible to file one application for the registration of a group of marks which are identical in their substantial elements, and which their differences are in things that do not affect their entity substantially as the color of marks, or the details of products or services related therewith, provided that such products or services belong to one class.

ARTICLE (10)

Without prejudice to the provision of Article (26) of this Law, it shall not be allowed to register any trademark which is identical or similar to a trademark previously registered for the same classes of products or services, or non-similar class of goods and services if using the trademark may generate the impression of a connection between the goods and services to be registered and those of the owner of the registered mark, or if using the trademark to be registered may damage his interests.

Where two or more persons apply simultaneously for the registration of the same trademark or closely similar or identical trademarks in respect of the same class of products or services, the Ministry shall suspend the registration of all applications until

an assignment attested by the disputed parties in favor of one of them is produced, or until a final judgment is rendered in favor of one of them.

ARTICLE (11)

The Ministry may impose whatsoever restrictions and modifications it may consider necessary for defining and clarifying the trademark in a manner to prevent confusion with another already registered mark or for any other reason it may deem fit. Confusion is presumed in case of using a trademark to distinguish identical classes of goods or services. Where for a certain reason the Ministry rejected a trademark or suspended registration on restrictions or modifications, the Ministry shall notify the applicant in writing of the reasons for such decision.

In all cases, the Ministry has to determine the registration application within thirty days from filing date whenever it fulfills the conditions and terms specified in this Law and its Implementing Regulations.

ARTICLE (12)

The registration applicant whose application was rejected or its acceptance has been suspended on a condition may appeal against such decision to the Committee within thirty days with effect from the date of notifying him therewith.

In case the Committee supported the Ministry's decision of rejecting the application or suspending its acceptance on the fulfillment of some conditions, the registration applicant may appeal against the committee's decision before the concerned civil court within sixty days with effect from the date of notifying him therewith.

The registration applicant shall be considered to have abandoned his application if he does not appeal against the Ministry's decision or does not appeal against the Committee's decision within the dates prescribed in this Article, or he does not implement the restrictions or conditions set by the Ministry during the period mentioned in the notification given to him in this respect.

ARTICLE (13)

There shall be a Trade Mark Committee formed under the chairmanship of the Under-Secretary of the Ministry of Economy and Commerce and the membership of the following:

- Two representatives from the Ministry chosen by the Minister,
- A member of the Board of Directors of the Federation of UAE Chambers of Commerce and Industry nominated by the Federation,
- A member of the Board of Directors representing each Chamber of Commerce and Industry in each Emirate nominated by the concerned chamber.

The Committee shall choose from its members a Deputy-Chairman, and its meetings are held in full in the presence of the majority of its members, and decisions are made by the majority of those in attendance. In case of an even vote, the party of the

Chairman shall out weigh the other party. The Committee shall meet once every month. The Committee shall have a rapporteur chosen by the Ministry. Members of the party and the rapporteur shall be awarded based on a decision made by the Cabinet Counsel.

ARTICLE (14)

In case the Ministry has accepted the trademark, it has to publish the trademark in the Trademark Journal and in two daily newspapers issued in the State, before registration, at the expense of the registration applicant.

Any interested party may object the registration of a trademark, and submit the written opposition to the Ministry, or send it to the Ministry by registered mail within thirty days from the date of last publication. The Ministry shall notify the registration applicant with a copy of the opposition to his application within fifteen days from the date of receiving such opposition.

The registration applicant has to file a written counter statement to such opposition to the Ministry within thirty days from the date of being notified with the opposition. If the counter statement is not received within the prescribed term, the applicant shall be deemed to have abandoned his application.

ARTICLE (15)

Before deciding the oppositions submitted, the Ministry shall hear the sayings of both parties or the party requesting such hearing.

The Ministry shall issue a decision rejecting or accepting the registration. It may determine whatever limitations or conditions deemed fit in the latter case.

Any interested party may petition before the Committee against the Ministry's decision within fifteen days from the date of being notified therewith. He may appeal against the Committee's decision before the concerned civil court within thirty days from the date of being notified with the decision.

It shall not entail appeal of a decision of accepting the trademark registration that the registration procedures should be stopped unless the concerned court decides otherwise.

ARTICLE (16)

The trademark when registered, its registration shall be with effect from the application filing date.

The owner of the trademark shall, on completion of its registration, be furnished with a certificate containing the following particulars:

1. Registration number of the trademark.
2. Application filing date and registration date.
3. Trade name, or the name of the trademark owner, his nationality and domicile.
4. An identical copy of the trademark.

5. Statement of the products, goods or services for which the mark is assigned, and their class.

6. Number and date of the International Priority and the name of the member country of the Paris Convention for the Protection of Industrial Property in which the priority application was filed.

ARTICLE (17)

Whoever applies for the registration of a trademark shall be deemed the exclusive owner thereof, and the ownership of a trademark may not be contested if it is used ceaselessly by the person who applied for its registration for at least five years from the date of registration without a case raised against him detesting his ownership of the mark.

The owner of a registered trademark shall have 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.

ARTICLE (18)

The owner of a previously registered trademark may, at any time, apply to the Ministry to add or amend the list of goods or services distinguished by such trademark, or to amend such trademark in any manner not substantially affecting its identity. The Ministry's decision in respect of amending the list of goods shall be issued in accordance with the conditions and provisions relating to the partial cancellation of a registration regarding part of the goods or services. As for the amendment of the mark, the Ministry's decision shall be issued according to the conditions and rules prescribed for the determination of the original registration applications, and such decision shall be subject to petition and appeal in the same ways. Such amendments shall be published in two local newspapers as well as in the Trademark Journal at the expense of the Applicant.

ARTICLE (19)

The protection period entailed by the trademark registrations is ten years. The trademark owner may secure the continuation of protection for consecutive periods, each of which is ten years, if he submits an application for the renewal of the trademark during the last year of the current protection period, in accordance with the conditions and terms mentioned in this Law and its Implementing Regulations.

The renewal of trademark registration shall be implemented without any additional examination, and without allowing others to object the renewal. The trademark registration renewal shall be published in the Trademark Journal and in two daily newspapers issued in the State, at the expense of the trademark owner.

In case of a trademark renewal application, the entry of any change of the trademark,

or the addition of any products or services in the list of the products or services for which the trademark has been registered, shall not be permitted. During the month following the expiration of protection period, the Ministry shall notify the trademark owner in writing, at his address appearing in the Register, of the expiration of validity thereof. If the trademark owner fails to apply for renewal within the three months following the expiration of protection period, the Ministry shall, of its own, cancel the trademark from the Register.

ARTICLE (20)

The owner of a trademark may apply to cancel its registration, whether for all or for a part of the products or services for which the trademark has been registered. The cancellation application shall be submitted according to the conditions and terms mentioned in the Implementing Regulations of this Law.

In case the trademark is licensed for use according to a contract, which 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 license agreement.

ARTICLE (21)

Without prejudice to the provision of Article (17) of this Law, 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.

ARTICLE (22)

The concerned civil court shall, on a request from any interested party, order the cancellation of trademark registration if it is proven that the trademark has not been seriously used for five consecutive years unless the owner of the trademark proves that non-use was for reasons beyond his control such as import restrictions and other governmental procedures that are imposed on goods and services distinguished by the Trademark. For the purposes of this Article, use of the mark by an entity authorized by the owner shall be considered as proof of use by the owner himself.

ARTICLE (23)

Upon the request of any interested party, the concerned Civil Court may order the addition of any particulars which might be ignored to be entered in the Register, the deletion or amendment of any statement entered unlawfully therein, or is inconsistent to the truth. The Ministry also has the right to make such amendments or deletions of its own accord.

ARTICLE (24)

The Ministry has to cancel the registration of the trademarks, which the Israeli's Boycott Office in the State has decided that they are similar or identical to an Israeli mark, symbol or emblem, as well as the trademarks owned by persons for whom a decision is

issued prohibiting dealing with them.

ARTICLE (25)

A trademark cancellation from the Register shall be published in the Trademark Journal and two local newspapers at the expense of the Applicant.

ARTICLE (26)

If a trademark has been canceled, it shall not be permitted to have it reregistered in favor of others for the same products except after the elapse of three years as of the cancellation date.

ARTICLE (27)

Assignment, mortgage or attachment of the trademark ownership may be made with or without the commercial store or the enterprise using the mark for distinguishing the products or services thereof.

ARTICLE (28)

The transfer of the ownership of the commercial store or the enterprise includes the trademarks registered in the name of the assignor, and which can be in strong connection with the store or the enterprise, unless agreed for the otherwise.

In case the ownership of the commercial store or the enterprise has been transferred without the trademark, the assignor may continue using the trademark regarding the products or services for which the trademark has been registered, unless agreed for the otherwise.

ARTICLE (29)

The assignment or mortgage of a trademark shall not be deemed a proof against others unless entered in the Trademark Register and published in the manner set by the Implementing Regulations.

ARTICLE (30)

The trademark owners may, according to a written and attested agreement, give a license to one or more persons to use the trademark for all or some of the products or services for which the trademark has been registered, and the trademark owner may use it by himself unless agreed for otherwise.

ARTICLE (31)

License agreement for the use of a trademark should be entered in the Trademark Register. The license will have no effect to others unless it has been entered in the Register and published in the manner specified in the Implementing Regulations.

ARTICLE (32)

The licensee shall not assign the license to a third party or give sub-licenses unless the

license agreement mentions otherwise. In all cases, a compulsory license to exploit the trademark shall not be mandatory.

ARTICLE (33)

Recording the license in the Register shall be cancelled therefrom according to a request of the trademark owner or the licensee after giving an evidence of the termination or the cancellation of the license agreement.

The Ministry shall notify the other party with the application filed to cancel the license. This party may oppose the cancellation application according to the procedures and situations mentioned in the Implementing Regulations.

ARTICLE (34)

The License agreement shall not include any texts, which may restrict the licensee with limitations not resulting from the rights entitled by the trademark registration, or not necessary to maintain such rights. However, the license agreement may include the following restrictions:

1. Specifying the range of the geographical area for marketing products or services bearing the trademark.
2. Nomination of the license period for using the trademark, considering the provisions of Article 31 of this Law.
3. Conditions, which warrant the quality control of products under the license, by the trademark owner.
4. The obligation of the licensee to prevent all actions, which may lead to lower the value of or cause harm to the products or services bearing the trademark.

ARTICLE (35)

Legal persons who work in the control or checking of some products or services regarding their origin, components, manufacturing method, quality or identity or any other property, may ask the Ministry for the registration of a mark specialized as an indication of performing the control and checking.

In all cases, the registration of such mark or its assignment shall be effected only by an approval from the Minister.

ARTICLE (36)

The Implementing Regulations shall specify the conditions and rules of the registration of the mark mentioned in the preceding Article, together with the documents to be attached with the registration application.

The registration of such mark shall result in all effects mentioned in this Law.

In case of the cancellation or non-renewal of such mark, it shall not be registered again for identical or similar products, goods or services.

ARTICLE (37)

Any person who commits any of the following acts shall be punished by an imprisonment and by a fine not less than (5000) five Thousand U.A.E. Dirhams, or by one of those penalties.

1. Whoever counterfeits a trademark, which is lawfully registered or imitates it in such a manner as to mislead the public, or uses in mala fide a counterfeited or an imitated trademark.
2. Whoever unlawfully uses a registered trademark owned by another party.
3. Whoever puts, in mala fide, a registered trademark owned by another party, on his products.
4. Whoever sells or offers for sale or circulation or possesses for the purpose of sale, products bearing a counterfeited or an imitated trademark, or unlawfully put, with his recognition.
5. Whoever intentionally offers rendering services under a forged, imitated or unlawfully used trademark.

ARTICLE (38)

Any person commits any of the following acts shall be punished by an imprisonment not exceeding one year, and by a fine not less than (5000) and not exceeding – (10000) Ten Thousands U.A.E. Dirhams, or by either of these punishments:

1. Uses a mark, which is inapplicable for registration according to the provisions of items 2, 3, 4, 5, 6, 8, 9, 10, 11 and 12, 13, 14 of Article 3 of this Law.
2. Writes a statement on his marks or trade papers, which leads to the belief that they have been registered or that they distinguish goods or services other than those mentioned in the Register.

ARTICLE (39)

Any person who commits for the second time one of the offences mentioned in Articles 37 and 38 of this Law, shall be punished with the same punishment in addition to the closure of his commercial store or enterprise for a period not less than fifteen days and not exceeding six months, together with the publication of the judgment on the expense of the convict, according to the procedures mentioned in the Implementing Regulations.

ARTICLE (40)

Any person incurred a harm as a result of any of the acts mentioned in Articles 37 and 38 of this Law may raise a case before the concerned Civil Court to ask the person who committed such act, for a compensation suitable with the harms thereof.

ARTICLE (41)

The owner of a trademark may, at any time, even before raising any civil or criminal claim, file a petition supported by an official certificate testifying the registration of the mark, to ask for an order from the concerned court, in order to take the necessary conservatory measures, in particular the following:

1. Making a gathering procès verbal and a detailed description of machines and instruments which are being or had been used in the committal of any of the offences mentioned in this Law, as well as local or imported products or goods, store signboards, envelopes or papers, etc. on which the mark, or the statement, the subject of the offence, may have been put

2. Effecting the confinement on the things mentioned in the preceding item, after paying a money guarantee, to be fixed by the court, to compensate the person whose things have been seized, if deemed necessary.

The court may delegate one or more experts to assist in implementing the conservatory measures. Owners of famous trademarks are excluded from the provision of providing a registration certificate.

ARTICLE (42)

The impounded party shall be entitled to file a lawsuit demanding the impounding party to pay compensation within ninety days of the deadline mentioned in the final paragraph of Article (41) of this Law, if no court action was filed against the impounded party, or from the issuance date of the final verdict on the lawsuit filed against him. In both cases, the security deposit shall not be refunded to the impounding party except only after the issuance of a final judgment in the impounded party's lawsuit or after the elapse of the prescribed deadline without filing the lawsuit.

ARTICLE (43)

The court may, in any civil or criminal case, order the confiscation of the seized things or which may be seized later, and deduct their price from the fines or compensations, or for the disposal thereof in any other manner deemed fit by the court. The court also may order the destruction of the unlawful marks, or, if necessary, order the destruction of the products, envelopes, packing materials and other things which bear such marks or bear illegal statements, and machines and instruments used in particular in the act of counterfeit. The court may order all the above actions even in the case of acquittal. The court may also order the publication of the judgment in the Official Gazette or in one of the daily newspapers at the expense of the convict.

ARTICLE (44)

Owners of the trademarks registered or used into he United Arab Emirates, on the application of this Law, have to apply for their trademarks' entry in the Ministry's Register according to the provisions and conditions mentioned in the Law, during a period of one year from the date of the law's enforcement.

Those who have not fulfilled the conditions prescribed in this Law, should adjust their situations within one year from the date of the law's enforcement. In case the trademark has not fulfilled the conditions prescribed thereof within the period mentioned in the preceding paragraph, it shall be considered null by the power of Law. The first user shall have the priority right to register his trademark during that period. In determining the first use, the following should be considered: its date of start, its continuation, its surrounding circumstances and the trademark registration action.

ARTICLE (45)

The Ministry has to notify the concerned authority in each Emirate and the Association of the Chambers of Commerce and Industry in the State, with the names of owners of trademarks registered in the Ministry, their particulars and any change, amendment or cancellation made thereof, within thirty days from the date of registration, change, amendment or cancellation.

ARTICLE (46)

Employees concerned with the control of the implementation of the provisions of this law and its by-laws, for whom a nomination decision from the Minister of Justice, in agreement with the Minister of Economy and Commerce and the concerned authority is issued, shall have the power of judicial capture officers. By this power, they shall have the right to enter places, activity of which is included in these provisions of this law, except places of accommodation, with the purpose of securing the implementation of its provisions and its Implementing Regulations and to seize the violating cases. Local authorities in the Emirates should offer facilities to those employees to enable them to carry out their work.

ARTICLE (47)

There shall be a decision issued by the Council of Ministers on the fees to be charged for the procedures to take place in accordance with the provisions of this Law.

ARTICLE (48)

Any provision, which is contradictory to, or conflicting with the provisions of this Law shall be nullified.

ARTICLE (49)

The Minister shall issue the Implementing Regulations and decisions necessary for the implementation of the provision of this Law.

ARTICLE (50)

This Law shall be published in the Official Gazette and come into effect three months as of the date of publication.

(2) A new Article No. (20)- repeated, is to be added to the Federal Law No. (37) for the Year 1992 above stated as follows:

" The Ministry has the right to cancel a trademark which has been unlawfully registered after informing the concerned parties of the cause of cancellation and allowing them to submit a defense of their rights.
Any concerned party may oppose the cancellation at the civil court within 30 days from the notice of cancellation".

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Issued in the Presidency Palace, Abu-Dhabi,
Dated Rabie Al-Awal 1413 H
September 28, 1992