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EDITORIAL

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Welcome to the fifth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Three general chapters. These are designed to provide readers with a comprehensive overview of key issues affecting trade mark laws and regulations, particularly from an EU and US perspective.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 41 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at [www.iclg.co.uk](http://www.iclg.co.uk).

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# United Arab Emirates

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Ministry of Economy is the responsible authority for all trademark transactions. Trademarks are prepared through the “Trademark Registry” within the Ministry. All trademarks, names and addresses of the owners are registered, as well as change, transfer, assignment, mortgage, licence or any other amendments.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

Federal Law No. 8 2002 is the relevant law which amended articles to the previous Federal Law No. 37 1992. The UAE is also a member of various international treaties regarding Intellectual Property/trademarks such as the World Intellectual Property Organization (WIPO), the Paris Convention, the GCC Convention, the Nice Agreement, the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) and DIFC’s own law concerning trademarks and IP rights.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Stipulating to Article 2 of Federal Law No. 8 2002, a trademark can be anything which takes a distinctive form including:

- names;
- words;
- signatures;
- letters;
- figures;
- drawings;
- symbols;
- titles;
- tax stamps;
- seals pictures;
- inscriptions; and
- advertisements.

The above can be packs or any other mark or a combination that is intended to be used, either in distinguishing goods or products and services. A trademark is also registered to show that goods or products are owned by the mark owner by virtue of their manufacture or to indicate the performance of such service. A sound may also be considered as a trademark if it accompanies any of the above.

### 2.2 What cannot be registered as a trade mark?

In respect of the UAE Trademark law, any mark that is devoid of a distinctive character or property will not be registered. The following also fall into the category of a rejected trademark:

- familiar drawings and ordinary pictures of goods or products;
- a mark which violates public morals or contradicts the UAE’s public order;
- flags, emblems or any other symbols that pertain to the State or Arab international organisations, and any other foreign country;
- symbols of the Red Cross/Red Crescent including imitations;
- identical or similar marks to religious symbols;
- geographical names that cause confusion as to the origin/source of the trademark;
- names, surnames, emblems and photographs of a third party;
- titles of honour that an applicant is not lawfully entitled to;
- misleading marks that contain false data which may mislead the public;
- marks that are already owned by a natural/legal person;
- marks that diminish the value of other products/services;
- marks containing the words: “registered drawings”, “copyright”, “imitation is forgery”, “privilege”, “privileged”, and “registered”;
- metal or paper currencies, and national/foreign decorations; and
- a trademark which is a translation of an existing trademark.

### 2.3 What information is needed to register a trade mark?

For a trademark to be registered the following is required:

- power of attorney;
- twenty hardcopies of the trademark logo;
- trade licence;
- a priority document;
- name, address, nationality and nature of business applicant;

- a list of goods and services to which the trademark pertains to; and
- translation into Arabic if in any other foreign language.

When registering a trademark, products/goods/services also must be categorised into “classes”. One trademark can fall into more than one class and be registered as such. Protection is only offered to the classes the trademark is placed in at the time of registration.

#### 2.4 What is the general procedure for trade mark registration?

All trademark applications are made through the Ministry of Economy wherein applications are directed to the Trademark Register. The application is either transmitted electronically or filled at the Ministry with the Registrar. Once the application is filled and the necessary documents are provided the Registrar will then either accept or reject the application.

#### 2.5 How can a trade mark be adequately graphically represented?

A trademark may be anything as long as it takes a distinctive form which is intended for the use of distinguishing goods or services. A sound is also considered part of a trademark if it accompanies thereto.

#### 2.6 How are goods and services described?

The UAE uses the Nice Classification, which separates goods and services under several classes. Although the UAE is not a member of the Nice Agreement which established the Nice Classification, it still utilises the system to class goods and services. Equal protection is given to all the classes.

There are nearly 45 classes, in which 34 are for products and 11 are for services, protection is only given to the class mentioned at the time of registration.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

When registering a trademark within the UAE, the jurisdiction and protection of that trademark shall be in the UAE only.

#### 2.8 Who can own a trade mark in your jurisdiction?

Generally individuals, companies, partnership businesses, trade unions, and law firms can register their trademarks.

The exclusive ownership of the trademark thereafter lies with the registration applicant.

#### 2.9 Can a trade mark acquire distinctive character through use?

There is no fixed duration from which a trademark becomes distinctive through usage, as in other jurisdictions the trademark becomes more famous dependent on the popularity of the brand it represents.

#### 2.10 How long on average does registration take?

Registration takes around 30 working days to receive confirmation on an application. However, the whole process takes around four months to a year assuming there are no objections to the application.

#### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The initial filing cost of the application is AED 500. There is then a fee of AED 10,000 upon registration. There are also other fees of newspaper publication and power of attorney.

#### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

All trademarks are to be registered at the Ministry of Economy at the trademark register, or by an authorised agent which will carry out the trademark registration until the certificate is obtained and complete.

#### 2.13 Is a Power of Attorney needed?

Yes, a power of attorney is needed in order to allow an attorney or agent to register the trademark on the applicant’s behalf.

#### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Every power of attorney in the UAE must be notarised and signed at the Public Notary for them to be deemed valid.

#### 2.15 How is priority claimed?

Priority is one of the rights enjoyed by members of the Paris Convention, a UAE national or resident is able to claim priority in the trademark application on the basis that the UAE is a party to the Paris Convention.

#### 2.16 Does your jurisdiction recognise or Certification marks?

The UAE recognises three different types of trademarks:

1. **Certification mark:** a word, symbol, picture, image or any combination used in commercial space by others to certify a quality, quantity, mode of manufacture, service, geographical origin or characteristics of goods or services performed by a group or organisation.
2. **Service mark:** for a symbol, word, name, image or any combination used to identify and distinguish the services of one provider from the other.
3. **Collective mark:** a trademark used by members of a cooperative society/association to identify their service or goods.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

Generally, a trademark which is identical to a previously registered trademark will be refused. Absolute grounds involve the trademark

being “descriptive, non-distinctive, or contravening morality”. The Ministry can impose whatever restrictions/modifications that it deems necessary for defining and clarifying the trademark. This ensures prevention of confusion with another already registered trademark. When an application is rejected the Ministry notifies the applicant in writing of the reasons why it was rejected.

### 3.2 What are the ways to overcome an absolute grounds objection?

An applicant may appeal a decision for a rejected or suspended application within 30 days.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal may be appeal to the entirety of the decision, usually this is the case.

### 3.4 What is the route of appeal?

An appeal is filed by the applicant to the Trademark Committee, appealing against the decision for refusing/suspending the trademark. Additionally, there are such instances when the Trademark Committee has actively supported the Ministry’s decision for rejection, this permits an applicant to appeal against the Committee’s decision before a concerned civil court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal of a trademark relate to the trademark conflicting with an existing trademark/right.

### 4.2 Are there ways to overcome a relative grounds objection?

An applicant may appeal a decision for a refused application to the Ministry within 30 days.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision will be appealed upon the entire decision not just a part.

### 4.4 What is the route of appeal?

The route of appeal will be the same route that is taken for refusal against absolute grounds for refusal.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Upon acceptance of a trademark, the Ministry publishes the trademark in the Trademark Journal and two daily newspapers issued in the state. At this stage any interested party may object

the registration of the trademark and submit the written opposition to the Ministry within 30 days from the date of the last publication.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested party may object to the registration of a trademark.

### 5.3 What is the procedure for opposition?

The interested party must submit a written statement of opposition to the Ministry within 30 days from when the trademark was announced in the newspapers. The Ministry will also notify the registration applicant with a copy of the opposition.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Upon acceptance the owner of the trademark is granted a certificate of his trademark which includes: the registration number of the trademark; application filing date and registration date, trade name/trademark owner name; owner’s nationality and domicile; an identical copy of the trademark; statement of the products/goods/services for which the mark relates to and class; and the number and date of the International priority with UAE as a member country of the Paris Convention in which the priority application was filed.

### 6.2 From which date following application do an applicant’s trade mark rights commence?

Protection and registration takes effect from the application filing date.

### 6.3 What is the term of a trade mark?

A trademark is generally protected for 10 years.

### 6.4 How is a trade mark renewed?

A trademark is renewed in the Ministry in the last year of the 10-year duration. The renewal is implemented without examination or the possibility of a third party to object.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

A trademark may only be assigned by the exclusive owner. It may be assigned to a third party or the ownership may be transferred.

### 7.2 Are there different types of assignment?

The transferral of a commercial store or an enterprise includes the transferral of a trademark as such, unless agreed for otherwise. In such circumstance an assignee may continue using the trademark but will not have exclusive ownership or entitlement. A trademark owner may also assign a trademark through licensing.

### 7.3 Can an individual register the licensing of a trade mark?

Only trademark owners may register the licensing of a trademark. This is done through a written attested agreement to give a licence to one or more persons with permission to use the trademark. The licensee may utilise the trademark for all or some of the services/products for which it was registered for.

The licence agreement for the trademark is then entered into the Trademark Register, and the licensee will not be allowed to assign the licence to a third-party.

### 7.4 Are there different types of licence?

Yes, there are different types of licences in the UAE. The main ones are:

- Licence for distribution: these may have several titles such as an agent or distributor as the licensee. These are either exclusive or non-exclusive licence distribution agreements.
- Licence to manufacture: these are exclusive and non-exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

A trademark licensee may not sue for infringement, but rather a trademark owner can sue the licensee for infringement if the licensee has used a non-original version of the trademark.

### 7.6 Are quality control clauses necessary in a licence?

There must be quality control clauses in a licence agreement. These conditions warrant the quality control of products in the licence, which are set by the owner. Also prototypes of a product must always be approved by the owner.

### 7.7 Can an individual register a security interest under a trade mark?

Trademarks are assets that are non-movable, but have great value, there are certain rules and protections afforded as such.

### 7.8 Are there different types of security interest?

Security interests act as warranty and mark third party interests, this is usually not provided for in the trademark certificate, but instead security interests are mentioned in a separate deed.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trademark may be revoked for non-use of the mark for a continuous five-year period, or if the mark was registered wrongly, in the sense that prior use of the trademark is present.

### 8.2 What is the procedure for revocation of a trade mark?

The interested party wishing to oppose a trademark should file an application to the Ministry of Economy or directly to the courts.

### 8.3 Who can commence revocation proceedings?

The Ministry or any interested party, may order the cancellation of a trademark on the grounds that the trademark was unlawfully registered, or on the grounds mentioned above in question 8.1.

### 8.4 What grounds of defence can be raised to a revocation action?

Grounds of defence include a defendant providing evidence that his trademark was lawfully registered. For a defence against non-use of a trademark, the defence may prove that reasons for non-use were reasons of 'beyond control' such as import restrictions or governmental interferences, which were imposed on the goods and services bearing the mark.

### 8.5 What is the route of appeal from a decision of revocation?

A trademark is cancelled when a final judgment in the Supreme Court is sent to the Ministry, this is the last stage of appeal, which means all appeals have been exhausted.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The registration of trademarks in our jurisdiction is usually based upon a first to file basis. Oppositions based on prior use are likely to be filed to question the invalidity of a trademark.

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidity is disputed the same way the cancellation of a trademark is filed.

### 9.3 Who can commence invalidation proceedings?

An interested party who feels that a trademark has been registered on the grounds of "bad faith" or an ownership which is not *bona fide*.

### 9.4 What grounds of defence can be raised to an invalidation action?

In an invalidation action, grounds of a third party having acted in "good faith" is bought up in order to not penalise either party. This position is taken as an equitable solution in the UAE.

Additionally, once a trademark has been used for a period of five years, then the question of its validity should no longer be questioned.

### 9.5 What is the route of appeal from a decision of invalidity?

The route of appeal will be in the same way as cancellation of a trademark.



## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

There are two ways to enforce a trademark against an infringer, the first way is to make an application in front of the Registrar at the Trademark Registry. The second involves referring the matter to the Ministry of Economy and directly to the courts.

### 10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

A written complaint needs to be submitted at the Economic Department, the complaint should be accompanied by evidence of the alleged infringement, and henceforward the Ministry of Economy proceeds with investigating the matter. In their capacity as judicial police, the Ministry of Economy is able to seize the false trademark, if it is found that there has indeed been an infringement. The judicial police may issue a fine, or an order to destroy the false trademark, a full detailed report is also issued, which may be used by the complainant at the concerned courts for compensation.

In respect of time, a complaint which has been raised at the Economic Department, where investigations have been concluded without obstacles, will take one month. Where investigations have been made inconclusive, such as the infringer defending claims against him, then the alleged infringed trademark will have to be transferred to an expert. The expert will determine the trademark's authenticity and issue a final report within three months.

In court proceedings, an infringed trademark dispute may take from 18–30 months before execution for compensation and to reach a final decision at the Supreme Court.

### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Preliminary and final injunctions are both available for trademark infringement. Preliminary injunctions are available if there is sufficient evidence that satisfies the Ministry of Economy to an infringement having taken place. The final injunction is destroying the false trademark on the basis of the complaint being issued by the Economic Department.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

As per the evidence law in the UAE, the order to disclose documents is dependent on the nature of the documents as well as the source and requirements for them. Generally if a party refuses to disclose certain documents, it may be considered a crime to hide or withhold evidence.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All submissions should be in writing with sufficient evidence. In particular, the registration of a trademark is especially important to demonstrate the validity of a trademark in relation to a complaint against an infringed trademark.

Witnesses may be called in to provide evidence, if a judge has approved such. Usually a witness must have a written statement prepared which has been preapproved by a judge. The request to include a witness must have details of the witness, as well as the information the witness is intending to present. Once the witness is authorised he may be cross-examined during a trial based on their written statement.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

A defendant in an infringement dispute has the right to stay proceedings if they have acceptable guarantee from the court, which is obtained by providing documents/evidence which clear the case against them. Proceedings may also be stayed via exceptional circumstances such as giving the defendant enough time to gather evidence/documents to quash the claim. Stay is not granted in cases where the judge feels the defendant is just doing so to postpone proceedings.

### 10.7 After what period is a claim for trade mark infringement time-barred?

There are no limitations or time-barred periods for trademark infringement claims.

### 10.8 Are there criminal liabilities for trade mark infringement?

Criminal liabilities of trademark infringement include jail time and a fine.

### 10.9 If so, who can pursue a criminal prosecution?

An owner of a trademark and a licensee may bring criminal action against an infringer. However, a licensee only has this right if it has been stipulated in the owner licensee agreement. In some cases a consumer may also take criminal action.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are civil and criminal liabilities for unauthorised use of a trademark.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds are available as defences:

- valid registration within territory;
- the trademark is worldwide and known;
- prior usage of the trademark; and
- the percentage of similarity between two trademarks and the extent of confusion it may cause to the public.



### 11.2 What grounds of defence can be raised in addition to non-infringement?

The alleged trademark in question is a true and valid trademark and the trademark is in a different class to the complainant's trademark.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Other than criminal remedies of jail time and fines, civil remedies include damages to be retrieved, as well as orders to delist the infringed trademark, or to destroy the infringed trademark.

### 12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Court fees and expert fees are recoverable in full.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Within the civil law system there are stages of appeal. At the first instance judgment, an appeal may be made against the judgment regarding the case subject matter. While at the Supreme Court appeals will be made on the basis that there was an error made within the law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence will be considered when: the evidence wasn't readily available at the time, or both parties were unaware of the existence of the new evidence. Additionally, in a case that has criminal and civil claims, the criminal supersedes the civil claim. The outcome of the criminal case may be utilised to quash any civil claims.

## 14 Border Control Measures

### 14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

A claimant may visit the Ministry of Economy and submit a request to seize the infringed trademark immediately, providing they have supporting evidence. The Ministry of Economy usually processes these requests within 1–5 working days. Moreover there is the option of making an urgent request to a judge to seize an infringed trademark, if all approvals and guarantees are satisfied then the reply is made within 72 hours.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

If well-known trademarks have been used continuously by one user/owner for a period of time, this is usually enough to make the public believe that he is the sole owner. These are known as first user rights.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company trademark name is protected by the federal Companies Law, as well as the Economic Department's Trademark Register regulations. The Ministry of Economy offers a "system search", which searches for similar trademark names. This ensures that no two companies have the same trademark names.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There is an intellectual property law which is a separate law from the trademark law, as well as a copyright and patent law.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name is usually obtained by taking into account ownership and reference to a trademark already in use. The eligibility criteria is found in [.ae](#) Name policy, the policy states that the grant of a domain name is not a grant for any intellectual property rights which are proprietary rights. It is important for the applicant of the domain name to ensure they have the right to use the domain name and that it will not violate any third party intellectual property rights.

### 16.2 How is a domain name registered?

A domain name is registered through [.ae.DA](#); the authority was established through the Telecommunications Regulatory Authority (TRA) and is responsible for regulating domain names, which are usually done through an accredited registrar.

### 16.3 What protection does a domain name afford *per se*?

The [.ae.DA](#) Dispute Resolution Policy offers recognition to propriety rights of a trademark. The policy also is in line with the Uniform Dispute Resolution Policy (UDRP) which sets out domain owners' rights. Trademark owners are able to further protect their brands by registering a domain name, but they should be careful when registering their domain name to not confuse the public.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Trademarks have become more linked to businesses by their owners. The practice and execution of the trademark law and regulations have become more enforceable and sensitive to details. The rules are constantly being developed and changed. An example of such is the 1992 trademark law being updated and amended in 2002.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

1. 330/2005 Cassation Court Judgment 10/10/2006 Commercial: this judgment stipulated particulars of trademark infringement.
2. 70/2009 Cassation Court Judgment 21/04/2009 Commercial: the judgment clearly defined what trademark infringement is.
3. 132/2010 Cassation Court Judgment 25/05/2010: this judgment was significant because it provided remedies for trademark infringement which included the prevention and de-listing of an infringed trademark.

### 17.3 Are there any significant developments expected in the next year?

Yes, practitioners in the official departments that handle infringement requests are getting more experienced and a consumer is growing more concerned with product purchasing, in the sense of the product

having a good trademark name. All these developments have been paving the way to further develop instruments to fight trademark infringement.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The Ministry of Economy has created a certain division in the last few years for combatting trademark infringement, this enables efficient and fast responses to requests submitted by trademark owners.



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Dr. Ghandy AbuHawash has over 15 years of experience in legal services. He has represented clients in both contentious and non-contentious matters. Dr. Ghandy specialises in company law, advising on shareholder agreements, compliance issues, labour law, intellectual property law, criminal disputes, commercial disputes and corporate matters. In addition to private and in-house practice, Dr. Ghandy is a leading arbitrator and has handled various high profile cases within the UAE and abroad. Moreover Dr. Ghandy is a strong academic and has Ph.D. in Law and Legal Studies, as well as a published thesis.

## HAMDAN ALSHAMSI LAWYERS & LEGAL CONSULTANTS

Hamdan AlShamsi Lawyers & Legal Consultants was established in 2011, which has since become a name synonymous with success and is well-known in the legal circuit. The law firm specialises in advising on commercial issues, insurance, due diligence, family law, intellectual property law, banking, companies law and other matters locally and is dedicated to offering unparalleled, high quality and culturally sensitive legal services while adhering to the highest standards of integrity and excellence.