

## Trademark Protection In light of the TRIPS Agreement, the Provisions of the Law and the Jurisprudence of the UAE Supreme Courts

حماية العلامة التجارية في ضوء اتفاقية تريبس ، أحكام القانون  
واجتهادات المحاكم العليا الإماراتية

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### **Abstract :**

With the industrial revolution and the flourishing of the international trade in the new world as a result of the numerous changes in the economic systems, trademarks became a key factor and played an essential role in the processes of manufacturing, production and distribution by offering a variety of the same goods that differ in quality and characteristics at different prices to consumers, and choosing a label for their products, specifically intended for the creation of trademarks.

A system for the sale of the wide variety of products produced by different industrialists and the development of different forms of trade in which these industrialists send their industry for sale in cities and other countries exceeded the role of trademarks from the definition of ownership to other functions and mandatory use to become an essential asset of the economic project. Taking all of this into consideration, this study aims to show the mechanism and effectiveness of trademark protection. The protection of the trademark takes two forms: criminal protection and civil protection on which we will focus this research. This research will go through the means of protection against registration and legal acts such as sale, foreclosure, and the unlawful cancellation of

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trademarks registered to prevent the illegal commercial practices of counterfeiting and unlawful use of the trademark, in the light of the TRIPS Agreement, the provisions of the law and the jurisprudence of the UAE Supreme Courts in the light of the TRIPS Agreement, the provisions of the law and the jurisprudence of the UAE Supreme Courts.

**Keywords:** Trademarks; TRIPS Agreement; Trademark protection; write-off a Trademark; UAE Supreme Court

### المخلص:

مع الثورة الصناعية وازدهار التجارة في العالم الجديد للتجارة الدولية نتيجة للتغيرات العديدة في الأنظمة الاقتصادية لعبت العلامات التجارية دوراً مهماً حتى أصبحت عاملاً أساسياً في عمليات التصنيع والإنتاج والتوزيع عن طريق تقديم سلع متنوعة من نفس الصنف تختلف في النوعية والخصائص وبأسعار متفاوتة للمستهلكين أي إتاحة بدائل للاختيار عن طريق اختيار التسمية للمنتجات في السوق وهو ما يقصد به تحديداً العلامة التجارية.

ومع تطور التجارة واختلاف شكلها لتصبح نظام لبيع تشكيلة واسعة من المنتجات التي ينتجها الصناعيين المختلفين وقيام هؤلاء الصناعيين بإرسال صناعتهم لبيعها في مدن ودول أخرى تجاوزت وتعدى دور العلامات التجارية من التعريف بالملكية إلى وظائف أخرى ومن الاستخدام الإلزامي لنتحول إلى أصل هام من أصول المشروع الاقتصادي جاءت هذه الدراسة لتبين آلية وفعالية حماية العلامة التجارية حيث تأخذ حماية العلامة التجارية شكلين: الأول الحماية الجزائية والثاني الحماية المدنية والتي سوف نركز عليها في بحثنا هذا حيث سنمر على وسائل الحماية من تسجيل وتصرفات قانونية مثل البيع والرهن وشطب العلامات التجارية المسجلة بغير وجه حق لمنع الممارسات التجارية غير المشروعة المتمثلة بتقليد العلامة التجارية واستعمالها دون وجه حق، في ضوء اتفاقية تريبس، أحكام القانون واجتهادات المحاكم العليا الإماراتية.

**الكلمات المفتاحية:** العلامات التجارية؛ اتفاقية تريبس؛ شطب العلامة التجارية؛ تسجيل

العلامة التجارية؛ المحكمة الاتحادية العليا

## 1. Introduction

The trademark occupies an important and distinctive place among industrial property rights and highlights the role of the trademark as a unique identity for the goods and services to distinguish it, which enables consumers to choose between goods and services to meet their needs, and push the owners of the trademark traders, manufacturers and

service providers to improve the quality of their goods and services, leading to increased business activity, and a reflection on the development and prosperity of the economy. The importance of the trademark increased, and played a distinctive role due to the use of technological means in production, which led to increase in quantity and quality, and thus intensified competition between merchants, producers and service providers, as well as because of economic development, especially after the emergence of globalization, the most prominent aspect of which is the freedom of foreign trade (Alasaf, 2011).

The protection of the trademark takes two forms: criminal protection and civil protection, on which we will focus in this research in the light of the TRIPS Agreement, the provisions of the law and the jurisprudence of the UAE Supreme Courts, are rightly entitled. In its second article, the Federal Trademark Law defines a trademark as “Shall be considered a trademark anything having a distinctive form such as names, words, signatures, letters, figures, drawings, logos, titles, hallmarks, seals, pictures, engravings, advertisements, packs or any other mark or group of marks if used or intended to be used either to distinguish goods, products or services whatever their source or to indicate that the goods or products belong to the trade mark's owner due to its manufacturing, selection or trading or to indicate the rendering of a service”.

### **1.1 Objectives of the Research**

The objectives of the research are to analyze the impact of the Trade-related aspects of intellectual property rights (TRIPS Agreement), on the federal law no. (37) of 1992 concerning trademarks, and the recent rulings of High Courts in UAE.

The goal will be to test the efficacy of the law and its potential impact on the use of trademarks in the UAE. Finally, the study will make recommendations regarding the best ways that the law can be enhanced for the benefit of local and global traders, and the protection of, the interests of trademark owners in UAE.

### **1.2 Research Questions**

The following are the research questions that will be answered in this study:

- What is the importance of trademarks, their use and registration?
- What is the impact of the TRIPS Agreement on the federal law

no. (37) of 1992 concerning trademarks, and the recent ruling of High Courts in UAE?

### **1.3 Importance of the Study**

The value of trademarks has been demonstrated through various brand rankings and in recent studies conducted in the UAE and many other scholars interested in the field of trademarks. They address many questions, and the variables they take in considerations vary from registered and non-registered trademark as an indicator for protection.

### **2. Definition of Trademarks and Historical Legal Origin**

Trademarks are the means of guarantee for both the producer and the consumer. They prevent the mixing of branded products with similar products bearing another mark. They also create confidence in the goods of the product, the increase in the types of goods and products and the emergence of similar goods. Furthermore, they preserve customers and the quality of products to ensure that they withstand competitors.

The trademark also plays a vital role in the marketing and advertising policies adopted by companies to promote themselves or their services and products, which in one way or another contributes to the company's role in influencing the souls of its customers and achieve a high competitive advantage through the use of funds to maintain quality and continuous improvement, which ensures good reputation and fame.

In light of this development and commercial spread, there was a need for a form of legal protection and coverage for entrepreneurs whose trademarks were imitated and commercially exploited without any prior permission and to protect the consumer public from confusion and misinformation. In order to regulate and restrict commercial competition within legitimate limits by ensuring the rights and duties of entrepreneurs on the one hand and safeguarding the rights of consumers by protecting them from fraud and misleading, on the other hand, it was necessary to establish legislative procedures governing the process of trademark protection.

Accordingly, most countries adopted the approach of enacting laws for the protection of industrial property in general and laws regulating the protection of trademarks and registration in particular. Therefore, the legislation of different countries has adopted the principle of registration as a means of the legal protection of trademarks registered with national offices, which illustrates the

importance of registration of trademarks.

## **2.1 What is the trademark, and what are trademark types?**

### **2.1.1 What are the trademarks?**

The registration serves as a reference that takes a distinctive form to distinguish goods produced by one company or services it performs from goods and services produced or performed by another company.

It comes within the kinds of trademarks: words, letters, numbers, fees, colors, images, shapes, logos, or symbols or any of the above and audio signals (sounds) and olfactory signals (odors) can be considered as trademarks.

### **2.1.2 Trademarks types**

Classifications of trademark types differ between jurists, some of them are classified as two types: trademark and service mark, and some of them classified as an industrial mark, trademark and industrial and commercial trademark. I will start with the first classification as follows:

A) Trademark: A reference placed on certain products of a specific project to distinguish them from other identical or similar products provided by competing producers.

B) Service Mark: A service mark differs from a trademark as it is a sign that is not used to distinguish products but to identify all tools and equipment used to perform the services of a particular project such as different hotel marks.

The other classification (Saleh, 2015) can be categorized as follows:

A) An industrial mark: if it is placed from the product to distinguish the goods it produces, such as the Mercedes mark for cars.

B) Trademark: If the merchant or distributor places it on the goods, he distributes without participating in its production.

C) Commercial and industrial: when the product is a distributor trader.

It is noteworthy that the distinction between industrial, commercial and service marks is not crucial in terms of legal protection (Alqailuby, 2015).

## **2.2 History of legalization of trademarks**

Trademark law is generally a relatively recent law, beginning in the 19th century. The first actual legal recognition was in the middle of this century.

### **2.2.1 Regulating the trademarks globally**

The concept of trademarks emerged in the middle Ages in particular in certain groups of communities, manufacturers and traders, where this category was used, especially in France and Italy to put their names on their products. For example, the hallmarks were stamped on the animals' property in order to prove ownership and significance.

The second type of marks is the so-called production marks. The purpose of using them is different from the first type. The use of these marks was then mandatory and constituted a legal obligation for both the manufacturer and traders to be traced in the event of selling invalid or defective products. Countries around the world have enacted laws in the field of trademarks, most notably in India, the Trademarks and Trade Data Act of 1958, the Trademark Law of 1959, and the Trademark Act of 1963 in China (WIPO, 1977).

In 1883, an international diplomatic conference was held in Paris in which the delegates of eleven countries signed the Paris Convention for the Protection of Industrial Property. During this century, the number of members of the Paris Treaty increased significantly and especially after the Second World War, reaching 140 member states (Zaindeen, 1999).

The Paris Convention for the Protection of Industrial Property of 1883 is the supreme document, underpinning international trademark law (Bodenhausen, 1968), which remains in force despite the devastation of international trade and the economy caused by two world wars, separated by a few years. The Treaty has confirmed the foundations of the acquisition of trademark rights for a considerable number of people claiming those rights worldwide and has paved the way for the conclusion of international trademark conventions and treaties.

TRIPS is an international trade agreement reached after the Uruguay Round of the WTO on the General Agreement on Trade and Tariffs (GATT), which was signed by 125 countries as part of a final agreement in 1994 (Maskus, 2000). The TRIPS Agreement aims to overcome obstacles to international trade through the adequate protection of intellectual property rights, including trademark protection. The TRIPS Agreement is defined as the Agreement on Trade-Related Aspects of Intellectual Property Rights, referred to as the abbreviation (TRIPS) (Al Ahwani, 2001). The TRIPS Agreement requires the Member States to provide reliable protection of intellectual property

rights. For example, in the field of trademarks, the agreement stipulates that unreasonable prejudice to the legitimate interests of trademark owners, including the use of the trademark without directly returning to the trademark owner, to carry out any commercial transaction is not permitted.

### **2.2.2 Legalization of the Trademark on the Arabic level**

As for the Arab world, a Unified Arab Trademark Act of 1975 (Ismaeel, 1982), has been developed by the Industrial Development Center of the Arab States in order to achieve coordination and harmony between the various legislations of the Arab countries, and remove the discrepancy or inconsistency in these legislations to achieve protection of trademarks in all Arab countries.

This law is a good step towards unifying legislation in the Arab world. It contributes reasonably to the establishment of a typical Arab economic market if other similar steps are taken in other related fields. The Arab States joined the TRIPS Agreement and made the following commitments (Articles 2-20):

A. Subject to Articles 1 to 12 and Article 19 of the Paris Convention for the Protection of Industrial Property, giving the right to a Member State to require that the validity of the registration is conditional on the distinction acquired through use and that the marks to be registered are perceptible as a condition for registration.

B. the Arab State concerned shall observe the obligations imposed on it by the other Member States with which it is a member of the Paris Convention.

C. The actual use of the mark shall not be considered a condition for the application for registration or rejection of such application based on the actual non-use of the mark before the expiration of three years from the date of application.

D. The nature of the goods or services for which the trademark is to be used shall not be considered as an obstacle to the registration of the mark.

E. Each trademark to be published either before or immediately after registration with reasonable opportunity to file cancellation petitions.

It is noted that making the opposition available to register a trademark is not an obligation of the State but merely a right of the State.

F. Prohibition of the granting of trademarks in the field of goods and services if such grants would cause confusion.

The goods and services may be identical or inconsistent with the cancellation request within five years from the date of registration unless the registration has been done in bad faith, the application may be made at any time.

G. Trademark protection for a minimum of seven years is renewable indefinitely.

H. Failure to cancel the registration of a trademark for non-administrative use by its owner or licensee for less than three consecutive years.

Cancellation is also prohibited if this period exceeds three years and the non-use is involuntary in the sense that it is due to obstacles beyond the control of the owner of the mark, such as the requirements imposed by the State impeding such use.

I. Failure to comply with special conditions for the use of the trademark in trade;

such as the use of the trademark along with another trademark or its use in particular, or in a manner that detracts from its ability to distinguish between goods and services produced by a particular enterprise and those produced by other enterprises.

J. Prohibiting compulsory licenses or linking the right of the trademark owner to assign them to others with or without the establishment to which the trademark is attributed without prejudice to the right of the State to set conditions for licensing or assigning marks.

### **2.2.3 Legalization of the Trademark locally**

Interest to regulate trademark legislation in the United Arab Emirates began at the local level first. The local trademark law was issued in Ras Al Khaimah on March 1, 1974. At the federal level, the UAE legislator singled out the issue of trademarks with the issuance of the federal law no. (37) of 1992 concerning trademarks. This was followed by the issuance of the Ministerial Decree No. (6) of 1993 on the Executive Regulation of the Law and the Council of Ministers Resolution No. (18) of 1993 on determining the fees for the procedures performed under the provisions of the Trademark Law.

In its texts, the UAE Trademark Law dealt with fundamental issues, rules and principles that do not, in their entirety, deviate from any



other law concerning trademarks. The provisions of UAE law are contained in seven main sections:

Section I singled out definitions, section II between the trademark registration and cancellation conditions, sections III and IV speak of the assignment of ownership and mortgage of the trademark, authorization of the use of the mark and section V between the marks assigned to signify control of specific products or services.

Section VI decided the criminal protection of the right to trademark and penalties as well as civil protection, and finally came the general and transitional provisions in section VII.

As a result of the UAE's accession to the Paris Convention for the Protection of Industrial Property under Federal Decree No. 20 of 1996, this provides for the protection of trademarks through the establishment of some provisions of the substantive rules related to that.

Subsequently, it acceded to the Agreement and Protocol of Accession to the World Trade Organization and the Uruguay Round Document by Federal Decree No. 21 of 1997, which constitutes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), and one of its most important agreements, which set standards for the protection of trademark rights.

Therefore, the UAE had to amend its national trademark legislation in line with its obligations under the provisions of the international conventions to which it acceded in the field of trademarks, accordingly, in 2002, the second Federal Law No. (8) was issued amending some provisions of the Federal Law No. (37) of the year 1992.

### **3.1 Trademark according to UAE law**

#### **3.1.1 Trademark Definition**

It is known that the trademark in the United Arab Emirates is subject to the provisions of the law with the issuance of Federal Law No. (37) of the year 1992 on trademarks, this law has defined the trademark as: “Shall be considered a trademark anything having a distinctive form such as names, words, signatures, letters, figures, drawings, logos, titles, hallmarks, seals, pictures, engravings, advertisements, packs or any other mark or group of marks if used or intended to be used either to distinguish goods, products or services whatever their source or to indicate that the goods or products belong to the trade mark's owner due to its manufacturing, selection or trading or to indicate the rendering of a service”.

The Jurists of Law define trademarks definitions close to that, it was said to be "a sign labelled by goods and commodities, Products or learn to distinguish them from similar goods from other merchants or products of other industries (Alnahi, 1983).In accordance with that, the trademark means: "The symbol taken by the manufacturer, trader or service provider to distinguish its industry, goods or services from those made, traded or provided by others (Zaindeen, 1999).

It is noted that the text of the second article of the Federal Law No. (37) of the year 1992 on trademarks, not only did it take the broad concept of the brand, but it made the concept narrow, limiting it to the industrial and commercial brand only, without the service mark.The legislator was alerted to this and other issues when he amended the Trademark Law in 2002, the Second Federal Law No. (8), amending some provisions of the Federal Law No. (37) of 1992.

This definition was established by the UAE judiciary, which provided for sentences, the Court of Cassation ruled 'decision in the jurisdiction of this court that the provision in Article 2 of Federal Law No. 37 on trademarks provides that "Shall be considered a trademark anything having a distinctive form such as names, words, signatures, letters, figures, drawings, logos, titles, hallmarks, seals, pictures, engravings, advertisements, packs or any other mark or group of marks if used or intended to be used either to distinguish goods, products or services whatever their source or to indicate that the goods or products belong to the trade mark's owner due to its manufacturing, selection or trading or to indicate the rendering of a service", That a trademark is anything that distinguishes a product or service from another.

A trademark is considered to be sufficient to distinguish a product or service produced by an enterprise from the product or service produced by another enterprise. Therefore, the trademark owner may not prevent others from using one of the elements that make up his mark, as long as the use of this element in the new mark is added to another element by making the appearance of this mark distinct from the first mark so that there is no confusion or confusion between them. It is included in the trademark elements words that include personal names, letters, numbers, shapes, color combinations, or any combination thereof, they are all eligible for trademark registration, ruling of the Court of Cassation, Dubai, 28-02-2013, Appeal N. 207/2012 Civil.

### **3.1.2 Trademark functions**

The importance of the Trademark stems from the functions it performs, whether for the manufacturer, trader, service provider or consumer, it is essential to them both, and the functions can be summarized in the following sections (Zaindeen, 1999):

**A) Productive function**

The trademark defines the personal source of the products or goods and the producer. It also identifies the regional source, production, destination which help a consumer to easily distinguish between similar products or goods, as they indicate the origin of products, goods or services, being the source of products, goods or services. It is enough for the buyer to mention the name of the mark in the commodity that a person wants to buy without having to indicate the descriptions and attributes of the item to be purchased.

The judiciary has settled on the protection of this function where he ruled. It is always stable - in the jurisdiction of this court - and on the provisions of Federal Law No. 37 of 1992 on Trademarks amended by Federal Law No. 8 of 2002. The trademark is taken by the concerned person to distinguish his goods or service from others because of their manufacture, production, trade or offer for sale and that in order for this mark to have legal protection, it must be registered in the register prepared for that purpose at the Ministry of Economy of the State the effect of registration shall extend to the date of application, ruling of the Court of Cassation, Dubai, 1-02-2011, Appeal N. 194/2010 Commercial.

The trademark expresses the qualities of the products or goods that distinguish it, whether in terms of type, rank, warranty or method of preparation. Type means the sum of the characteristics of the products or goods which are distinct from those of other similar or similar products or goods. Rank means the degree of quality and perfection of the products or goods or the elements of their composition.

Consequently, this leads to increased confidence in products and goods and motivates customers to prefer these products over others, which drives the trademark owner to increase his keenness on his brand's reputation and keeping this reputation in the minds of customers and improving them by perfecting their products and maintaining their quality. The mark becomes trusted by the public, which leads to a faster discharge of products, goods or services under this trust. The trademark may derive its strength from the quality of the products it stands for. The

trademark, therefore, defines the position of the producer, manufacturer or service provider among other competitors (Heinz, 1975).

### **B) Advertising function**

A trademark is an essential means of advertising for products, goods and services. They are the essential means of merchant, manufacturer or service provider to advertise and publicize his mark up to people's minds, using various advertising mediums, especially radio, TV, magazines, newspapers, etc., (Othman, 1992). This could lead to fixing the mark in people's memory. It is difficult to ignore the influential role of advertising in attracting customers to a particular product, goods, or services. Therefore, the owner of the project is keen to assure the consumer audience through advertising that these products are the best and finest existing products (Saleh, 1992). This is a reality that we all touch in our daily lives in most different media, especially radio, newspapers and television, when a buyer orders a particular commodity, he or she has often linked that mark to the characteristics of the commodity that holds that mark, which is due to active publicity of the mark or a previous experience of the commodity, or both (Abbas, 1971).

Therefore, economic projects of all kinds have consulted the advertising agencies regarding the composition of the mark and the means of its use in advertising products (Saleh, 1984). Given the importance of this, the advertising and marketing agencies take into account specific considerations the composition of the mark, aiming to bring the attention of the consumer, as to be with a beautiful view, or a simple word with a musical impact that draws the attention of the consumer and creates an attachment to it (Alexender, 1989).

The trademark is of great practical importance, as it is one of the essential means in the success of the economic project. It is a means to compete with other projects at both the international and the local level. By attracting customers and consumers, it serves a dual function, or two interests simultaneously: on the one hand serving the interest of the merchant, manufacturer or service provider, as a means to distinguish their goods, goods or services from other similar or similar goods or services and through which they pass to consumers, and on the other hand, it serves consumers, as it is their means of identifying the goods or services that they prefer and are more acceptable to them.

Accordingly, trademark is considered an important means of legitimate competition in the field of dealing as it plays a significant role in achieving justice among workers in the trade, industry and services sector so that each of them receives the confidence of consumers as much as he is keen to improve his products, goods or services and maintain their quality in order to earn the desired reputation (Saleh, 1992).

### **C) Protection for consumers**

Trade is considered as one of the most critical aspects of human activity because of the many advantages. Some dishonest owners, to promote their industries, goods or services may hide their flaws change by fraud and cheating, showing them as accurate, in order to woo the purchasing power of the consumer audience. Mislead, the consumers buy those industries, goods or services believing that they carry the specifications and advantages as advertised, while those industries, goods or services are not or at least below that (Mansor, 1992).

The trademark then plays a vital role in ensuring consumer rights from cheating and fraud, about the specifications of the industries, goods or services they receive from manufacturers, traders or service providers. This should be done through appropriate legal recourses to determine their liability for the effects of misleading consumers (Othman, 2001).

## **4. Trademark registration**

### **4.1 Trademark registration requirements**

#### **4.1.1 Self-Subjective characteristics**

According to article (2) of the law “shall be considered a trademark anything having a distinctive form such as names, words, signatures, letters, figures, drawings, logos, titles, hallmarks, seals, pictures, engravings, advertisements, packs or any other mark or group of marks if used or intended to be used either to distinguish goods, products or services whatever their source or to indicate that the goods or products belong to the trade mark's owner due to its manufacturing, selection or trading or to indicate the rendering of a service” that is to have the mark exclusive subjectivity that distinguishes them and makes them different from other marks used to distinguish similar goods or services.

It should have the character of innovation that makes it has a distinctive exterior which is necessary, because lack of this will make it

difficult for the consumer to identify the signs that distinguish them on the one hand, and it will also be challenging to protect its owner from competitors on the other.

#### **4.1.2 External characteristics**

According to the article (10) of the law “Subject to the provisions of Art. (26) Hereof, no trademark identical or similar to an already registered mark may be registered for the same categories of products or services, or different goods or services, if the use of the requested trademark would generate an impression that such goods or services are linked to the goods or services of the owner of the registered mark or prejudicing his interests. Should one or more persons apply simultaneously for the registration of the same mark or close or similar marks for one category of products or services, the Ministry shall suspend the registration of all applications until an attested waiver is submitted by the opponents in favour of one of them or a final judgment is awarded in favour of one of them”.

In the sense of no similarity with other signs that already registered or previously submitted applications for registration for similar products or services in the sense that the mark is new in the application on the same goods and services. A registration mark that is identical or similar to another is not sufficient to mislead consumers, and not necessarily to have a similarity inhibitor to registration. Matching between two Trademarks. Instead, it is enough that the similarities will confuse the average consumer with care in normal purchasing conditions.

#### **4.1.3 Legitimacy**

In the sense of not containing prohibited elements or forms, in other words, it may not be registered or taken as a trademark such as violating public morals or contrary to public order, public slogans of states, flags, purely religious symbols, Red Crescent symbols or geographical names. If the user may confuse as to the source of the products or services or contain false data on the characteristics of the goods.

According to the article (3) of the law which stipulates that “The following shall not be registered as a trademark or an element thereof: 1. The mark is having no property or distinctive character or that made of data being only the name given by tradition to common goods, products, services or the ordinary drawings and pictures of goods and products. 2.

Any mark is breaching the public morals or violating the public order. 3. Public emblems, flags and other logos, of the State, the Arab or international organizations or an institution thereof or any foreign country except by its authorization as well as any imitation of such emblems, flags or logos. 4. Logos of the Red Crescent or Red Cross and such other similar symbols and the marks being an imitation thereof. 5. Marks that are identical or similar to symbols having a purely religious character. 6. Geographical names if their use would create confusion concerning the origin or source of goods, products and services. 7. The name, title, picture or logo of a third party unless he or his heirs approve its use beforehand. 8. Particulars of honorary degrees to which a registration applicant does not prove his legal entitlement. 9. Marks that may mislead the public or include misstatements on the origin or source of products or services or their other properties as well the marks that include a fictitious imitated or forged trade name. 10. Marks owned by natural persons or legal entities with whom it is prohibited to deal. 11. The mark whose registration for some categories of products or services results in undervaluing other products or services distinguished by such mark. 12. Marks including the following words or expressions: - 4 - Concession, Concessionaire, Registered, Registered Drawing, Copyright, Imitation is Considered Forgery or such similar words and expressions. 13. The national and foreign medals, coins and banknotes. 14. The marks deemed as just a translation for a renowned mark or another mark already registered, if the registration would confuse the consumers, about products distinguished by the mark or similar products”.

#### **4.1.4 World-renowned Trademarks**

The UAE legislator complied with the TRIPS Agreement when it was amended in 2002 regarding trademarks that have gained an international reputation and are not registered in the country. The amended Federal Trademark Law stipulates that a world-renowned foreign trademark that exceeds the borders of the country of origin of the mark may not be registered to other countries except upon the request of its original owner, the provisions of the Convention and the provisions of the amended law are an exception to the general principle limiting the right of the owner of a monopolistic mark within the territory of the State in which it is famous and it does not extend outside.

In affirmation of this provision, the Court of Cassation ruling states that “Article 4 of Federal Law No. 37 of 92 on Trademarks - as amended by Federal Law No. 8 of 2002 provides that “1. The trademarks having international goodwill beyond the boundaries of the mother country may not be registered unless authorized by the owner or by his official attorney. 2. It is the public's awareness about the trademark that determines its goodwill. 3. A trademark with goodwill, may not be registered to distinguish products or services that are not similar or compliant with those distinguished by the trademark if a. The use of the trademark indicated a link between the goods and services to be distinguished and the goods or services of the original trademark owner. b. The use led to a potential prejudice to the owner of the original trademark owner”.

It indicates that the protection afforded to a world-renowned trademark is an exception to the general principle that the monopolist's right is limited within the territory of the country in which it is famous and does not extend beyond it, When a foreign mark acquires international reputation that transcends the borders of its country of origin to other countries, it may only be registered at the request of its original owner, in order to protect it from assault and to safeguard the property of others of world renown. Such protection shall not extend to non-identical goods or services, unless the use of the other similar trademark may give the public an impression of linking it to the goods and products of the original trademark owner, or lead to potential harm to the owner.

The reason for the protection of the world-renowned brand is that the owner of the brand has gained reputation from his efforts, activity and status, no other party may, without his permission, use this mark, nor shall such third party also use that mark on goods or products that degrade the value of such mark, ruling of the Court of Cassation, Dubai, 06-12-2015, Appeal N. 589/2014 Commercial.

As stated in another recent ruling of the Court of Cassation that it is “As stipulated in Article (4) of the law as mentioned above, the protection afforded to a world-renowned trademark is an exception to the general principle that the trademark owner has a monopoly limited from within the territory of the country in which it is famous and does not extend beyond it when a foreign mark acquires international fame that transcends the borders of its country of origin to other countries, it



may only be registered at the request of its original owner for assault and maintenance of the property of others of world renown”, ruling of the Court of Cassation, Dubai, 18-01-2015, Appeal N. 73/2014 Commercial.

## **4.2 Trademark Registration Procedures**

According to Article 6 of the law, the registration of trademarks shall be deemed the right of every citizen whether natural or legal person if he is engaged in any commercial, industrial, craft or service work. It is also the right of every non-citizen, whether a natural or legal person, to engage in any of the previous acts in the State or to practice such work in any of the States that treat the State equally.

The application shall be submitted to the Trademarks Department at the Ministry on the form prepared for this purpose, the application for registration may not include more than one category of products and goods. The competent authority shall receive applications to be examined formally first in terms of verifying its submission from the applicant's personality and submitting the required documents...etc. It then examines it objectively to ensure the availability of the conditions of validity of the mark and may impose the conditions and amendments to what it deems necessary to clarify the mark in a form that prevents confusion with another mark already registered.

An applicant whose application is rejected or whose admission is suspended may be subject to a grievance to the Trademark Committee and, if the Committee upholds the Ministry's decision, may appeal the decision of the Committee before the competent civil court. If the Ministry accepts the registration of a trademark, it shall be announced in the Trademark Bulletin which issues it, the applicant shall advertise in two daily newspapers issued in the State at his expense to open the door for objection to registration.

If the mark is registered, the effect of registration shall commence from the date of application, the applicant is given a certificate of trademark registration, and the protection period of registration shall last for ten years. The owner of the mark might ensure the continuity of protection for consecutive periods of ten years each if he applied for renewal during the last year of the current protection period or within three months following it.

### **4.2.1 Who has the right to register and how to apply?**

Article VI of the Federal Law No. (37) of the year 1992 on trademarks stipulates that “The following persons shall have the right to

register their trademarks: Article (6) 1. National natural or juridical persons are carrying out any commercial, industrial, handicraft or services activity. 2. Foreign natural or juridical persons are carrying out any commercial, industrial, handicraft or services activity in the State. 3. Foreign natural or juridical persons are carrying out any commercial, industrial, handicraft or services activity in any country which treats the State according to the reciprocity principle. 4. Public juridical persons.

Article 7 of the said law states that “Any person wishing to use a trademark to distinguish goods, products or services may apply for its registration according to the provisions hereof. Article (7): The application for the registration of a trademark shall be submitted to the Ministry under the circumstances and conditions provided for in the Executive Regulations”.

The UAE legislator did not limit those who have the right to apply to register a trademark in a particular category. It also did not set conditions in the application for registration but authorized anyone who wishes to use a mark or claim to be the owner of a mark used or intended to use it to apply for registration in accordance with the established rules.

As stated in the ruling of the Court of Cassation follows “Stable it to articles 2, 17, 30 of Law 37 of 1992 concerning the amended trademark show that the trademark is, whoever takes a distinctive form of names, words, signatures, letters, numbers, drawings, symbols, addresses, seals, designs, engravings, any advertisements, packages or any other mark or a combination thereof

If it is used or intended to be used to distinguish goods, products or services to indicate that they belong to the owner of the mark because of its manufacture, selection, absence, recourse or offer for sale, whoever registers a trademark is considered the owner only, he shall have the sole right to use it and no one else may use this mark without the permission of its owner”, ruling of the Court of Cassation, Dubai, 18-01-2015, Appeal N. 73/2014 Commercial.

Consequently, the UAE legislator has made the door open to any person, body or another party to apply for the registration of the mark, if an application is allowed from the person or body without specifying that person or body in terms of quality or nationality. Any person may apply for registration, whether the natural or legal person, trader or non-trader, UAE or non-UAE, similarly, the Commission may be

commercial or otherwise and maybe private or public. It may also be an Emirati national or otherwise.

The application must be submitted on a specific form signed by the applicant or his agent. If an ordinary company applies for registration of a mark, it may be signed on behalf of the company or its behalf by any one or more members of that company. If a legal entity submits the application, it may be signed by one of the directors of the management of that body, its secretary or a key employee in all cases, and the agent may sign the application.

The executive regulations stipulate that each application for registration of a mark must include a copy of that mark and explain its contents in writing in addition to the personal data provided in terms of name, address and nationality. The law devotes particular order to the existence of a register of trademarks registered in the country, information and details of the marks and a copy thereof, and an accurate description of their contents to prevent the registration of similar or identical trademarks of pre-registered trademarks.

Article 5 of the Federal Trademark Law stipulates that “A register called "Trade Marks Register" shall be set up at the Ministry wherein shall be recorded all the trademarks, names, addresses and type of activities of their owners, the descriptions of their goods, products or services and any conveyance, assignment, transfer of ownership, mortgage or license for use concerning such marks or any other changes. Article (5): Any person may request a real certified copy of what is recorded in the said register after paying the prescribed fees”.

The application for registration of a mark shall be submitted in writing to the Ministry, which shall be responsible for supervising the register of marks. It shall write down all matters related to trademarks, and the registration of trademarks shall be carried out by several specialized staff in trademarks. The trademark subject of the application for registration shall be distinctive (new), new and legitimate and shall not be legally prohibited following Article (3) of the law mentioned above.

#### **4.2.2 Acceptance of the application for registration**

Upon receipt of a request for registration of a trademark, the Ministry shall order the investigation between registered trademarks and unresolved registration applications to ascertain whether the entries have registered marks relating to the same goods or the same class of goods in

conformity with the mark to be registered or close to such a degree as to indicate the existence of a trademark cheating.

Accordingly, UAE law has given the Ministry the power to accept the registration of the mark unconditionally or to impose restrictions or amendments it deems necessary. They were also obliged to refuse registration in certain cases. It also allows each owner to appeal the decision issued by the Ministry, whether that decision to accept the application for registration or rejection or amendment. Thus, it can be said that the UAE law has adopted the theory of the previous examination of the mark in specific aspects are:

A) Ensure the legality of the mark.

B) Ensure the distinctive characteristic of the mark.

C) Ensure that the mark to be registered does not match another registered mark.

Therefore, when the Ministry accepts the application for registration of any trademark, whether it is an absolute admission or pending on specific conditions and restrictions, it must declare the image it has accepted as soon as possible, According to the prescribed manner, this declaration should include all the conditions and restrictions under which the application was accepted if any. Upon acceptance of the application, the Ministry shall publish a declaration thereof for the period it decides, and in the form it deems appropriate.

The announcement shall be made under the rules prescribed in this regard in the executive regulations of the Federal Trademark Law. The Ministry's acceptance of the application in principle and giving a number does not mean the acceptance of the application is final because the acceptance of the application is considered final only by the publication of the declaration and the end of the objection or decision in the case of submission.

The aim of the UAE legislator to compel the Ministry to declare acceptance of the registration application is to inform others so that those who have objections to the registration of the mark may file such objection. For the declaration to be considered legal, it must be appropriately regulated by the Ministry. Therefore, Article (14) of the Federal Trademark Law states: "Should the Ministry accept a trademark, it shall, before its registration, announce it in the Bulletin and two Arabic dailies published at the cost of the registration applicant. Any concerned person may object to the registration of a mark. Such

objection shall be submitted to the Ministry in writing or dispatched thereto by registered or electronic mail within (30) days from the date of the last advertisement. The Ministry shall notify the registration applicant with a copy of the objection to his request within (15) days from receipt of such request. The registration applicant shall reply to the objection in writing within (30) days of notification. If such reply is not submitted within the said delay, the applicant is deemed to have assigned his request. The applicant shall submit to the Ministry a written reply to such objection within (30) days from being notified thereof; if such reply does not reach within such period, the applicant shall be deemed as having waived his request”.

#### **4.2.3 Objection to the Ministry's acceptance of applications for registration**

The Trademark Law allows any person to object to the registration of any trademarks within thirty days from the date of the last announcement; the objection shall be submitted in writing to the Ministry or sent by registered mail or e-mail. The Ministry shall send a copy of that objection to the applicant, and then the applicant shall have the right to submit written evidence to refute the reasons for the objection to his application, if the said date does not receive the reply, the applicant shall be deemed to have waived his application.

Since the purpose of the objection is to prevent fraud, no direct interest of the objector is required on the application for registration of any trademark, “The provisions of the judiciary has settled down that any person may object to the Ministry of Economy to request the registration of any trademark without the objector personal interest directly in rejecting the request for registration.”

This is because the public may object to the application for registration in order to prevent fraud. However, there is a need for competence in the person objecting, whereas, in its spare time, the Ministry shall consider the evidence submitted by the applicant and the objector and hear the statements of the parties whenever necessary or if they wish to extend their case and explain their argument that a decision in the matter should be made whether it is necessary to allow registration and the conditions to be observed therein and then inform the decision to the parties.

According to Article 15 of the Federal Trademark Law “Prior to deciding on the objections submitted thereto, the Ministry shall hear the

statements of both parties and either if any of them so requests. Article (15) The Ministry shall issue its decision rejecting or accepting the registration. It may, in the latter case, impose the restrictions or conditions it deems convenient. Any interested person may complain before the Committee from the Ministry's decision within (15) days from being notified thereof and may contest the Committee's decision before the competent civil court within (30) days from being notified thereof. The objection to the decision issued to accept the registration of a trademark shall not result in suspending of the registration procedures unless otherwise decided by the competent court”.

#### **4.2.4 Registering the mark and issuance of a certificate of registration**

If the application to register a trademark is accepted, The Ministry shall register such trademark after paying the prescribed fee, by recording it in the trademark register as soon as possible. This mark shall be registered on the date of the application as the last date of registration.

The registration of the trademark, which shall be registered in the register, shall include a reference to the date of registration, the description of the goods for which the trademark was registered, the name of the owner, the address, the profession, all matters relating to the mark and any other details that the Ministry may deem necessary. After completing the registration process, the Ministry shall issue the applicant with a certificate of registration according to the form prescribed for this purpose.

The certificate shall include the name, address and occupation of the mark, the number of the mark, the number of the newspaper in which the mark was published, the class of goods for which it was registered and the duration of the registration. In Article 17 of the Federal Trademark Law, the law affirms the absolute ownership of a registered trademark when used for five consecutive years.

It is not permissible to object to it, and the text reads as follows “Any person who registers a mark shall be deemed its sole owner. The ownership of such mark may not be disputed if the person who registers it, uses it uninterruptedly for at least (5) years from the date of registration without an action being lodged against him ruling for its validity. Article (17) The owner of a registered trademark may prevent others from using a similar or identical trademark, from distinguishing

products or services that are identical, similar or correlated for which the mark has been registered, in such a way that confuses the consumers”.

The UAE legislator has set the tenure of the trademark rights ten years from the date of its registration but has authorized the renewal of the registration of the trademark for similar periods, starting from the expiry date of the first registration period. Thus, the owner of the mark may retain his mark for other successive periods, which may reach infinity if he so wishes, as he may apply to renew his mark within one year before the expiry of the last registration period. If the application for renewal of the registration of a trademark is not submitted within one month after the expiry of the last registration period, the Ministry shall, within the month following the expiry of the protection period, notify the owner of the trademark in writing to his registered address at the expiry of its protection period.

If this period lapses and the owner of the mark does not submit the renewal application within the three months following the expiry date of the protection period, the Ministry on its own shall remove the mark from the register.

#### **4.2.3 The dispositions of a trademark**

The trademark is subject to money for all actions likely to be received on financial rights such as assignment, pledge, seizure and licensing. According to Article 27 of the Trademark Law “The ownership of a trademark may be transferred and a mark may be mortgaged or attached along with or without the commercial premises or the project of exploitation for which the mark is used to distinguish its products or services”.The disposition of a trademark is considered a formality, not a consensual act. Article (29) of the law stipulates “The transfer of ownership of a trademark or its mortgage may not be opposed to third parties except after being entered in the Trade Marks Register and announced in the manner determined in the Executive Regulations”.

The disposition of a trademark shall take the form of licensing third parties to use it per Article 30 of the Law “The owner of a trademark may, by a written and attested contract, license one or more persons to use such mark for all or part of the products or services for which the mark is registered. The mark owner may use it himself unless otherwise agreed. Article (30) the period for licensing the use of a mark may not exceed that prescribed for its protection”.

#### **5. Write off the trademark**

Search requires legal protection of trademarks study protection according to a case of unfair competition criminal and special protection, and finally, international protection according to international treaties and agreements (Alqailuby, 2015).

The Federal Trademark Law states “A trademark owner may apply for striking it off the register either for all the products or services for which the mark is registered or for only a part thereof. The application for striking off shall be submitted according to the terms and conditions stipulated in the Executive Regulations of this Law. Article (20): If a mark is licensed to be used under a deed entered in the Trade Marks Register, the registration of such mark may only be stricken off upon the approval in writing of the license beneficiary unless the beneficiary expressly waives such right in the licensing deed”.

### **5.1 Authentic trademark registration**

Since the purpose of a trademark is to distinguish goods or services, it must take a distinctive character in its authenticity and be new, so that it does not occur between them and other marks confusion or misleading lose its function in distinguishing between goods and services, what is meant is the fact that the product or another service provider should not have used the new mark, however, the novelty and authenticity of trademarks are relative rights because the right to monopolize and monopolize the exploitation of distinctive marks prescribed to its owner does not prevent others from using the same distinctive mark to distinguish another type of goods and services.

Accordingly, the owner of a registered trademark has the absolute right to prohibit all parties from using the same or a similar mark in their business for the same goods or services as those for which the trademark is registered when such use may confuse. Confusion is assumed to occur if a matching trademark is used for identical goods or services. Related to the right of the trademark owner to acquire it and the related moral and financial right to become the sole owner of the right to authorize third parties to use the mark on all or some of the products for which the trademark is registered or decided right without registration as it is for the famous marks.

The UAE legislator, as mentioned above, has been guided by the text of Article 15 of the TRIPS Agreement by specifying the conditions that must be met in the mark for it to be protected, thus allowing it to be registered to ensure such protection. The aim of the registration is to find



a means of preventive protection of property since the registration aims to others informing the existence of the mark to refrain from the use or raped since the legislature decided to legal protection of these signs of all kinds When available, the conditions necessary for its existence,

According to Article 10 of the law it “Subject to the provisions of Art. (26) Hereof, no trademark identical or similar to an already registered mark may be registered for the same categories of products or services, or different goods or services, if the use of the requested trademark would generate an impression that such goods or services are linked to the goods or services of the owner of the registered mark or prejudicing his interests. Should one or more persons apply simultaneously for the registration of the same mark or close or similar marks for one category of products or services, the Ministry shall suspend the registration of all applications until an attested waiver is submitted by the opponents in favour of one of them or a final judgment is awarded in favour of one of them”.

Accordingly, the UAE legislator shall prohibit the registration of trademarks that are similar or identical to pre-registered and protected trademarks by the provisions of Article (3.9) of the Trademark Law that “Marks that may mislead the public or include misstatements on the origin or source of products or services or their other properties as well the marks that include a fictitious, imitated or forged trade name.”

### **5.1.1 The implications of the registration of the mark**

The registration of a trademark has critical legal implications from two aspects, the first is the type of legal protection of the trademark, and the second is the trademark ownership (Zaindeen, 1994).

#### **A) Gaining legal protection**

The registration of the mark with the Ministry following the rules prescribed in this regard has a substantial effect that the right to the mark shall have criminal protection, In addition to civil protection, infringement of the right to a trademark constitutes a crime punishable by law whenever that mark is registered, registration is a prerequisite for criminal protection of the right to a mark in case of assault, the criminal protection of the mark revolves with the registration, the various legislations are unanimous in suspending the criminal protection of the mark on the condition of its registration per the formal procedures followed in each legislation (WIPO, 1997).

Consequently, criminal protection is prescribed for marks registered only under the offences referred to by the UAE legislator in the Trademark Law and it is as follows:

1- Forgery and imitation of the mark counterfeiting means the complete reproduction of the mark or the main parts of the mark, making the forged mark mainly identical to the original mark, counterfeiting means creating a marker that resembles the original mark, which would mislead the public to the source of the products that distinguish the mark, the counterfeit or imitator shall be punished by imprisonment and a fine not less than five thousand dirhams or by one of the two penalties.

2. The legislator has criminalized use of a counterfeit or imitated trademark with the same penalty as the preceding penalty, this type of use, whether the user is the counterfeiter or the counterfeiter himself or not and the crime is not required to be used by placing the counterfeit or counterfeit mark on the goods and services, it is enough to use them in other ways, such as advertising them or placing them on the front of a business, With any evidence of bad faith knowing in advance the use of counterfeit or forged mark.

3. Use of a trademark owned by others and the legislator has decided that it has the same penalty as if a person uses a trademark of others registered on his products or services, provided that lousy faith is available. Besides, to Sell, display, sell, trade, or acquire products with the intent to sell in bad faith.

4. The use of a trademark which is legally prohibited and prohibited from being registered, the penalty for the user of this type of marks shall be imprisonment for a period not exceeding one year and a fine of not less than five thousand dirhams and not more than ten thousand dirhams, or one of these two penalties.

5. Illusions third party registration of the trademark by resorting directly to any acts that create the belief of the consumer public that the registration of his trademark and have the same punishment as the previous.

In addition to the previous penalties imposed by the UAE legislator, additional penalties have also been imposed:

1- Temporary closure of the commercial premises or exploitation project for a period not less than fifteen days and not exceeding six months, it decides in case of recidivism for past crimes.

2- The precautionary measures are represented in the right of the owner of the mark to request a record procedure and a detailed inventory of the machines used in the attack on the mark or the goods on which the mark was the subject of the crime or requesting the attachment to prove the infringement of his right to trademark whether before or after filing a civil or criminal lawsuit, However, in order to exercise this right, the application shall be accompanied by an official certificate attesting to the registration of the mark and the provision of financial insurance estimated by the court to compensate the detainee if necessary.

3- Confiscation and Destruction, the Court may, in any civil or criminal proceeding, order the confiscation of the seized objects and may order the destruction of illegal marks, products and packaging bearing such marks, machinery and tools used in counterfeiting or counterfeiting, the court may dispose of confiscated items in any manner it deems appropriate, including selling them and deducting the price of them from fines or damages imposed on the detainee.

The registration of a trademark has a critical legal effect: the right to a trademark has civil protection, which is enjoyed by the trademark owner, whether his trademark is registered or not.

If a person infringes on his or her right to be labelled by counterfeiting or counterfeiting or used to distinguish similar products or services and results in or will result in actual damage to his or her interests, he or she shall be entitled to claim unfair competition.

The civil protection prescribed for a trademark is based on the general rules of the Civil Code and entitles the owner to claim compensation in case of a violation of his trademark by filing an unfair competition case. This lawsuit is a liability claim that may be brought by any person who has suffered damage as a result of a violation on the mark on the person who caused it to compensate for the damage caused, while the criminal action is filed only by the owner of the mark.

Therefore, the Federal Supreme Court ruled that “an action based on unfair competition does not proceed as an ordinary liability action based on a detrimental act, or any person who has suffered damage from the act of unfair competition may file a claim for compensation for the damage caused to any person who participated in causing such damage, where the conditions of such lawsuit are found, namely error, damage and causal association, while the lawsuit established to restrict the trademark shall be accepted only by the owner of that trademark and

shall be accepted only by those who imitate or falsify it, ruling of the Court of Cassation, Dubai, 14-06-2013, Appeal N. 436/2010 Civil.

Since an unfair competition case is based on the same basis as tort liability, taking into account the unique nature of the unfair competition claim, it is subject to the same conditions as the tort liability claim. With a difference in the concept of these conditions, consequently, a person must engage in the act of unfair competition, cause harm to others and cause a causal link between the damage and the wrongful act of the merchant.

In order to restrict the unfair competition against the practice of counterfeiting or counterfeiting, or to use it to distinguish similar products or services, the elements of error and damage and the causal relationship between them must be available. No compensation can be claimed under an unfair competition claim unless the acts of unfair competition cause damage to the competing merchant whose trademark has been infringed.

The damage caused by unfair competition may be material damage to the trader in his trade-related trademarks, whether they are trademarks, manufacturing marks or services related to services.

The damage may also be incorporeal to the merchant in his business reputation and his trademark reputation. Whether the damage is material or moral, it is not incumbent upon the victim to prove it, but that the court of the first instance derives it from the acts of unfair competition that may cause harm, contrary to the general rules of civil liability that require the victim to prove the damage he has suffered.

In the area of unfair competition, however, it could never prove harm, but it was sufficient to prove that acts of unfair competition had occurred. Therefore, the judge of the case resorted to an arbitrary assessment of the compensation derived from the nature of the acts of unfair competition, there are some cases of acts of unfair competition that do not cause any harm, but the lawsuit, in this case, is aimed at eliminating the illegal situation for the future, which is called stop the abuse and is a form of civil protection of the trademark.

The other form of civil protection of a trademark is compensation. If the conditions of an unfair competition claim are met, the court adjudicating the lawsuit provides compensation for material and moral damage. It should be noted that the owner of a registered mark may combine both civil and criminal proceedings, the owner shall not

prevent the civil action from being filed in the criminal case in which the defendant is acquitted because the subject matter is not the same, any person who has infringed his trademark right has the right to take a civil action against the person who caused the violation, demanding compensation.

### **B) The impact of registration on the ownership of the trademark**

Registration is a presumption of precedence in the use of the mark. Therefore, if the registration was done in good faith and the use of the mark continued quietly for five years, such registration would constitute the right of ownership. This is stated explicitly in the text of Article (17) of the Federal Law No. (37) for the year 1992 on trademarks “Any person who registers a mark shall be deemed its sole owner. The ownership of such mark may not be disputed if the person who registers it, uses it uninterruptedly for at least (5) years from the date of registration without an action being lodged against him ruling for its validity. Article (17) The owner of a registered trademark may prevent others from using a similar or identical trademark, from distinguishing products or services that are identical, similar or correlated for which the mark has been registered, in such a way that confuses the consumers”.

Registering with the monopoly of the trademark owner gives the registered trademark the criminal and civil protection decided by the legislator, the legislator considered any person who forged, imitated or raped registered marks a criminal offence and was punished. Article (21) of the said law stipulates that “Without prejudice to the provision of Article (17), the Ministry and any concerned person shall have the right to request a judgment be passed for striking off a trademark registered without right. The Ministry shall strike off such registration if a final and enforceable judgment is submitted to it in this regard”.

It is clear from this provision that the UAE legislator has made the registration of the mark merely a presumption over the use of the mark, registration does not create a right of ownership in the mark, but only determines the existence of that right, the effect of registering a mark is, in principle, the determination of the right. In other words, the UAE legislator has made the mark registration procedure as only an introduction to the legality of that procedure; this means that the effect of registration is only for the right of the mark. In other words, registration of a mark is merely a legal presumption of ownership of the

mark for those who have registered it, but that presumption is inconclusive, means may be proved reversible (Zaindeen, 1994).

It has been ruled that the jurisprudence and the judiciary have settled that the registration of the trademark, although it is a presumption of ownership of the mark, it is permissible to demolish this presumption in reverse. The former user of the trademark, which has become a distinctive trademark of the goods, has the right to cancel the trademark registered in the name of another person, as will be described in detail later.

In affirmation of this trend, Article (20) of the Federal Law No. (37) of the year 1992 on Trademarks states that “The Ministry may strike off a trademark registered without right, after notifying the concerned party about the reason of such an action and listening to their statements and considering their defence. Article (20 a) the concerned parties may file a grievance about the striking off resolution at the competent civil court within (30) days as of the notification”.

The Court of Cassation has settled “What is stable it and on what has been the verdicts of this court and according to the provisions of Articles 2, 4, 7, 16 and 17 of the same law, the registration of a trademark is for the purpose of using it to distinguish goods, products or services, the person who registers the trademark is considered the owner of the trademark, he shall have the sole right to use them alone and the registration of a trademark is considered a precedent for its use, Anyone who claims otherwise and that was earlier in its use before registration may prove the contrary on the basis that the ownership of the trademark is for those who have previously used it, so that wisdom takes precedence in use, unless the person who registered it has used it for at least five continuous years from the date of registration without filing a dispute with the owner about the ownership, the registration as a general basis would not establish the right of ownership but would determine it, It is the responsibility of the claimant to prove ownership of the mark as this right of ownership is the result of the use of the mark, It is based on the presumption of this right, a simple presumption may be refuted to those who claim the primacy in the use of the mark, ruling of the Court of Cassation, Dubai, 08-05-2012, Appeal N. 92/2012 Commercial.

### **5.2 Write-off cases of the wrongly registered trademark**

Article (34) of the Implementing Regulations allows the trademark owner to cancel it, whether for all or some of the products, by

applying to delist the mark to the competent section on the form prepared for that purpose (Abdullah, 2009).

Article (35) of the Implementing Regulations specifies the cases in which a trademark may be deleted:

1- If the trademark registration is not renewed.

2- At the request of the owner under the provisions of Article (20) of the law, the cancellation shall affect the date of the request.

3- Based on a final judgment issued by the competent court that the registration of the mark was unlawful.

4- Based on a judgment issued by the competent court for the deletion of the mark for non-serious and unjustified use for five consecutive years per Article (22) of the Law. If the owner of the mark proves that the use of the mark was not for a foreign reason, this shall protect him from the application of the delisting provision to his trademark.

Based on a decision of the Minister based on a letter from the boycott office of Israel in the United Arab Emirates in accordance with Article (24) of the Law.

We will review the situations of cancellation of registered trademark registration through the following two sections:

#### **A) Trademark administrative write-off**

The Trademark is written off administratively in several situations:

The first case: If the owner of the mark does not submit an application for renewal of its registration within the three months following the expiry of the protection period, the Ministry can cancel this mark administratively. Article (19) states “The period of protection resulting from the registration of a shall be (10) years. The mark owner may secure the continuance of such protection for successive periods of (10) years each if he applies for renewal of such mark's registration within the last year of the valid protection period according to the terms and conditions provided for in this Law and its Executive Regulations. Article (19) the renewal of the mark registration shall be affected without any further inspection and without allowing third parties to object to such renewal. The renewal shall be announced in the Bulletin and (2) Arabic dailies published in the State at the mark owner's cost. In case of applying for renewal of the mark registration, no change, deletion or addition may be made to any products or services on the list

of products or services for which the mark has been registered. The Ministry shall, during the month following the expiry of the protection period, notify the mark owner in writing on his address recorded in the register of the expiry of its protection period. If a mark owner does not apply for renewal within the (3) months following the expiry of the protection period, the Ministry shall of its own motion strike the mark off the register”.

Second case: If the owner of the mark himself requests to remove his mark from the register according to Article (20) “A trademark owner may apply for striking it off the register either for all the products or services for which the mark is registered or for only a part thereof. The application for striking off shall be submitted pursuant to the terms and conditions stipulated in the Executive Regulations of this Law. Article (20) if a mark is licensed to be used under a deed entered in the Trade Marks Register, the registration of such mark may only be stricken off upon the approval in writing of the license beneficiary unless the beneficiary expressly waives such right in the licensing deed”.

### **B) Judiciary write-off a Trademark**

The trademark is written off in several situations:

The first case: If any interested person applies for the cancellation of the registration of the mark because it has not been seriously used for five consecutive years. According to Article (22) “The competent civil court may at the request of any interested person rule in favour of striking off the registration of a trademark if it is established to the court that such mark has not been seriously used for (5) successive years unless the mark owner proves that the lack of its use, is due to a reason beyond his control, such reasons are the import restrictions, and other government conditions imposed on the goods and services”.

Second case: If it is proved that the mark has been registered illegally where Article (21) states “Without prejudice to the provision of Article (17), the Ministry and any concerned person shall have the right to request a judgment be passed for striking off a trademark registered without right. The Ministry shall strike off such registration if a final and enforceable judgment is submitted thereto in this regard”.

It also stated in the ruling of the Court of Cassation that "if a trademark cancellation request is submitted five years after its registration, this application shall not be accepted according to Article (17) of the Federal Law No. (37) of 1992 on trademarks “Any person



who registers a mark shall be deemed its sole owner. The ownership of such mark may not be disputed if the person who registers it, uses it uninterrupted for at least (5) years from the date of registration without an action being lodged against him ruling for its validity. Article (17) The owner of a registered trademark may prevent others from using a similar or identical trademark, to distinguish products or services that are identical, similar or correlated for which the mark has been registered, in such a way that confuses the consumers”, Ruling of the Court of Cassation, Dubai, 13-06-2012, Appeal N. 83/2011 Commercial.

It is clear from these judgments that the UAE judiciary has settled the question of the period during which the defence application must be submitted in advance of the use of the mark against the registrant, and set it for five years starting from the date of registration if the period elapses since the registration of the mark, the registration shall have the effect of establishing the right in the mark to the person who registered it, and shall be deemed to be the owner of that mark.

It is no secret that the conduct of the UAE judiciary in this regard, leads to the determination of the legal positions of the parties in the trademark, no doubt leaving the door open to the applicant prioritize the use of the mark against those who registered it without specifying a specified period for that claim makes the right of those who have registered that mark threatened from time to time, and thus makes their legal status unstable. In addition, there is a reward for the person who neglects to register his or her undue reward, if he neglects to register his trademark until another has registered it and has not objected to such registration within the specified period, then he only blames himself. If the law does not protect the ignorant, it should not protect the neglected either.

The Federal Supreme Court ruled that “It is established in the Federal Supreme Court that the lesson in proving ownership of a trademark is precedence in use, registration as an asset shall not only establish the right of ownership but shall determine its existence, the Ministry shall cancel the registration once a final judgment has been submitted, ruling of the Federal Supreme Court, Abu Dhabi 11-02-2011, Appeal N. 195/2010 Commercial.

Third case: If it is proved that the registered mark has a reputation beyond the limits of the country of origin where it was registered and used:

Whereas the provisions of Articles III and IV of the Trademark Law are established in the Federal Supreme Court jurisdiction it “No similar trademark may be registered that would mislead the public for confusion between them, whether the original mark has already been registered in the State in accordance with the procedures set forth in this Law, Or this mark has a reputation beyond the limits of the country of origin where it was registered and used, as the right to use this mark remains with the entity that owns it and is prohibited from being used, imitated or used by others within the United Arab Emirates, even before being registered in the state because the acquisition of global fame and the breadth of the spread according to the foregoing a ban on the exploitation without the permission of the original owner, it is forbidden to register this mark or the like in the State except for that owner, because the purpose of a trademark is to be a means of distinguishing goods, products and services or to indicate that they belong to the owner of the mark, this purpose is achieved by contrasting the marks used to distinguish a particular commodity so that the confusion between them increases and the consumer audience does not confuse or mislead, ruling of the Federal Supreme Court, Abu Dhabi, 18-04-2001, Appeal N. 297/2000 Civil.

Finally, the UAE legislator is against the laws of some other countries

It has left the door wide for the judiciary to illegally delete the registered trademark, as many judgments were issued stating that the registration of the trademark is a presumption of ownership of the mark, however, it is permissible to demolish this presumption in reverse.

The former user of the trademark that became the distinctive mark of his goods has the right to cancel the registered mark in the name of another person if the following conditions are met:

1- If it is proved that there is a similarity between the two marks, it will lead to cheating the public.

2- If the first mark is used prior to the date of registration of the mark to be written off.

3- If it does not pass the registration of the mark to be cancelled for five years.

4- If it is proved that the registered mark has a reputation beyond the limits of the country of origin in which it was registered and used.

## **6. Conclusion**

UAE Trademark Law has been established to protect and shield the Trademarks from any harm that may arise out of an Infringement. However, there has been a massive scale violation of Trademarks resulting in damages for the domestic and international Trademarks owners. This study has shown that the judiciary in the United Arab Emirates addressed such violations through the application of the Federal Trademark Law and the provisions of the TRIPS Agreement and the application of commercial norms and ethics.

Through this study, we reached some outstanding results and recommendations, which are:

**First: results:**

1- The civil protection of a trademark in UAE law is based on the provisions of Federal Law No. (37) of the year 1992 on trademarks and its executive regulations, and also based on the provisions of the TRIPS Agreement relating to the rules applicable to illegal trade practices on trademarks.

2- No difference in the requirement of the legislator in both the original civil action or the unfair competition of the trademark that the trademark must be registered. Both lawsuits can only be filed with the owner of the registered trademark, while most legislation permits the protection of the unregistered trademark in accordance with the claim of unfair competition. They are generally based on the rules of civil liability, and they also allow such action to be brought by any person affected by the acts of unfair competition, including the consumer.

3- The UAE legislator has made the registration of the mark merely a presumption over the use of the mark, registration does not create a right of ownership in the mark, but only determines the existence of that right, means may be proved reversible, that was earlier in its use before registration may prove the contrary on the basis that the ownership of the trademark is for those who have previously used it, so that wisdom takes precedence in use unless the person who registered it has used it for at least five continuous years from the date of registration without filing a dispute with the owner about the ownership.

4- The registration of the mark has a significant effect that the right to the mark shall have criminal protection, In addition to civil protection, infringement of the right to a trademark constitutes a crime punishable by law whenever that mark is registered. Consequently,

criminal protection is prescribed for marks registered only under the offences referred to by the UAE legislator in the Trademark Law.

**Second: Recommendations:**

1- The paper recommends amendments that bridge the legislative gap in trademarks Federal Law concerning the lack of clear-cut provisions on the link between the civil and the criminal protection of trademarks, there is therefore clearly a lack of criminal provision in both the trademark and unfair competition law combating trademark infringements related misleading marks, as in counterfeiting marks.

2- The UAE legislator must amend federal laws related to the Trademarks Law such as the Customs Law and the Judicial Police to include more power to obtain more protection for trademarks, and thus give the judiciary more flexibility in issuing judicial rulings to suit the rapid development of fraud and circumvention of the Trademark Law.

3- The legislator should prioritize the search for ways to enhance the ability of the UAE Trademark Law to contribute to the protection of domestic and international trademarks, encourage legal entities to register their trademarks, including re-establishing the authorities to oversee this area and encouraging appropriate assistive studies. The aim of registration is to find a preventive method to protect property, as the registration aims to inform others of the existence of the mark in order to refrain from using it

4- It is recommended that international businesses draw up and implement a plan for operating in the UAE, particularly in relation to how trademark rights are handled. As a trademark is one of the most valuable assets that the commercial entities can own. So to guard and enforce the rights they have over their trademark, it is recommended to register the trademark at the time of setting up the business in the UAE. This will enable these entities to have a sustainable trademark capable of building the goodwill of the business. Trademark owners must constantly be watchful for and strenuously defend against the infringement of registered trademarks in the region.

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