

Federal Law No. 37 of 1992 concerning Trademarks

We, Zayed Bin Sultan Al Nahyan, President of the State of the United Arab Emirates,

After review of the Provisional Constitution,

And Federal Law No. 1 of 1972 concerning the Jurisdictions of the Ministries and the powers of the Ministers, and the Laws in amendment thereof,

And Federal Law No. 4 of the 1979 Concerning the Suppression of Fraud and Deceit in Commercial Transactions,

And Federal Law No. 5 1985 Promulgating the Civil Transactions Code, and the Laws in amendment thereof,

And Federal Law No. 2 of 1987 Promulgating the Penal Code,

And based upon the report of the Minister of Economy & Commerce, the agreement of the cabinet and the Federal National Council and the ratification of the Federal Supreme Council,

Promulgate the following Law:

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Chapter 1

Definitions

Article 1

In application of the provisions of this Law, the following words and expressions shall have the meanings set forth opposite each one, unless the context requires otherwise:

The State:	The State of the United Arab Emirates.
The Minister:	The Minister of Economy & Commerce.
The Ministry:	The Ministry of Economy & Commerce.
The Concerned Authority:	The concerned authority in the Emirate.
Drawing:	Every design that contains a set of Visible things (any artistic Formation).
Symbol:	Every individual visible drawing.
Engraving:	An incised mark.
Relief:	A raised mark.
Image:	An image of a person, whether the image of the owner of the facility or the image of another person.
The Committee:	The Trademarks Committee Provided for in this Law.

Article 2

Every name, word , impression, letter, numeral, drawing, symbol, address, engraving, seal, image, relief, announcement, packaging, or any other mark that takes a distinctive form or any grouping thereof shall be deemed a trademark if it is used or intended to be used to distinguish goods, products or services of whatever source, or to indicate the fact that the goods or products belong to the owner of the mark by reason of their manufacture, selection or trade , or to indicate the rendering of any service.

A sound shall be deemed a portion of a trademark if it is associated therewith.

Article 3

The following shall not be registered as a trademark or any element thereof.

- (1) A mark that is void of any distinguishing attribute or feature; a mark that is composed of statements that are no more than appellations; or common drawing or ordinary image of the goods or products.
- (2) Any mark that is offensive to public morals or contrary to public order.
- (3) A public emblem, flag or other symbol of the State, of an Arab or international or any establishment thereof, or of any foreign state, except with authorization therefrom, and similarly any imitation of such emblem, flag or symbol.
- (4) The red crescent or red cross symbol or other symbol similar thereto, or a mark in imitation thereof.
- (5) A mark that resembles or is similar to a symbol that has purely religious associations.
- (6) A geographic name, if its use is such as to create confusion in relation to the origin or source of the goods, products or services.
- (7) The name, surname, image or emblem of a third party, unless such third party or his heirs should agree thereto prior to use thereof.
- (8) A statement relating to a degree of honor the attainment of which the applicant for registration cannot prove by lawful means.
- (9) A mark that is such as to deceive the public or that

contains false statements with regard to the origin, source or other characteristics of the products, or services, and similarly a mark that contains a fictitious, imitative or forged commercial name.

- (10) A mark owned by natural or juristic person with whom transactions are prohibited.
- (11) A mark the registration of which in respect of certain classes of goods or services may lead to a decrease in value of other products or services that such mark distinguishes.
- (12) A mark that includes the following words or expressions: “privilege”, “privileged”, “registered”, “registered drawing”, “copyright”, “imitation is forgery” or similar words and expressions.

Article 4

A foreign trademark having international repute that extends beyond the borders of the original country of such mark to other countries may not be registered except pursuant to the request of its original owner.

Chapter 2

Registration and Deletion of Marks

Article 5

A register shall be prepared in the Ministry called the Trademarks Register in which shall be entered all trademarks; the names, addresses, types of activities and descriptions of the goods, products or services of the owners of such trademarks; and any transfers, assignments, changes in ownership, mortgages, licensing of use or any other changes that may occur in respect of such trademarks.

Article 6

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

- (1) Natural and juristic persons who are nationals of the state and who who conduct any commercial, industrial, professional or services business.
- (2) Natural and juristic persons who are foreigners and who conduct any commercial, industrial, professional or services business in the State.
- (3) Natural and juristic persons who are foreigners and who conduct any commercial, industrial, professional or services business in any state that accords reciprocal treatment to the State.
- (4) Public juristic persons.

Article 7

Each person who wishes to use a trademark to distinguish goods, products or services may apply for registration thereof in accordance with the provisions of this law.

The application for registration of the mark shall be submitted to the Ministry on the terms and conditions set forth in the Implementing Regulations.

Article 8

A trademark may be registered with respect to a single class or multiple classes of products or services as specified by the Implementing Regulations, Nevertheless, an application for registration of a mark may not relate to more than a single class.

Article 9

A single application may be submitted for registration of a group of marks the essential elements of which are similar and the difference among which is restricted to matters not materially prejudicial to their essence, such as the color of the marks or the products or services related thereto, provided that such products or services belong to a single class.

Article 10

While observing the provisions of Article 26 of this law, it shall not be permitted to register any trademark that is identical or similar to a trademark previously registered in respect of the same class of products or services.

If one or more persons at the same time should apply for registration of the same, comparable or similar marks with respect to a single class of products or services, then the Ministry must suspend registration of all the applications until submission of a release certified by the disputant parties in favor of one of them or until issuance of a final judgement in favor of one of them.

Article 11

The Ministry may impose whatever restrictions and amendments it may deem necessary for the purpose of defining and clarifying trademarks in a manner that would prevent confusion with a different previously registered trademark, or for any other that it may deem appropriate. If the Ministry denies

registration of a trademark for any reason, or suspends registration pending compliance with restrictions or amendments, then it must notify the applicant for registration in writing of the grounds for its decision.

In all circumstances, the Ministry shall be required to resolve an application for registration within thirty days from the date of submission thereof when it is in compliance with the terms and conditions set forth in this law and the Implementing Regulations.

Article 12

If an application is denied, or if its acceptance is suspended Pending compliance with a condition, then the applicant for registration may file a petition for review of such decision to the committee within thirty days from the date of notification thereof to the applicant.

If the committee confirms the decision of the Ministry denying the application or suspending its acceptance pending compliance with certain conditions, then the applicant for registration may appeal the decision of the committee before the competent civil courts within sixty days from the date of notification thereof to the applicant.

The applicant for registration shall be deemed to have released his application if he does not file a petition for review of the decision of the Ministry or does not appeal the decision of the Committee within the deadlines stated in this Article, or does not comply with the restrictions and conditions imposed upon him by the Ministry within the time period defined in the notification to him in this regard.

Article 13

A trademark committee shall be formed presided over by the Undersecretary of the Ministry of Economy and Commerce and having as members two representatives of the Ministry chosen

by the Minister and a representative of each Emirate chosen by the concerned Authority.

Article 14

If the Ministry accepts a trademark, then prior to registration thereof it must publish notice of the same in the Official Gazette and two daily newspapers issued in the State, at the expense of the applicant for registration.

Any interested party may object to registration of the mark. Such objection shall be submitted in writing to the Ministry or dispatched to the Ministry by registered mail within thirty days from the last date of the published notice. The Ministry shall notify the applicant for registration with a photocopy of the objection to his application within fifteen days from the date of the Ministry's receipt thereof.

The applicant for registration must submit to the Ministry a written response to such objection within thirty days from the date of notification thereof to him. If the response is not received within such time period, then the applicant for registration shall be deemed to have released his application.

Article 15

If requested by either party, the Ministry must hear the statements of one or both of the parties prior to the resolution of the objections submitted to it.

The Ministry shall issue its decision to deny or to accept the registration. If it accepts the registration, then it may impose whatever restrictions or conditions it deems appropriate.

The concerned party may petition for review of the decision of the Ministry before the committee within fifteen days from the date of notification to him thereof and may also appeal the decision of the committee to the competent civil court within thirty days from the date of notification to him of such decision.

An appeal against a decision to accept registration of a trademark shall not have the effect of suspending the application procedures unless the competent court decides otherwise.

Article 16

If the trademark is registered, then such registration shall take effect from the date of submission of the application.

The owner of the mark, immediately upon completion of registration thereof, shall be given a certificate stating the following particulars:

1. The registration number of the mark.
2. The date of submission of the application and the date of registration.
3. The commercial name or the name of the owner of the mark, his nationality and his place of residence.
4. An identical copy of the mark.
5. A statement of the products, goods or services to which the mark relates and a statement of the class thereof.

Article 17

The person who registers the mark shall be deemed the sole owner thereof, and the ownership of the mark may not be disputed if it is used by the registrant continuously for at least five years from the date of registration without any claim being filed against him challenging the validity thereof.

Article 18

The owner of a previously registered trademark may submit, any time, an application to the Ministry for the inclusion of any addition or amendment to his mark that is not materially prejudicial to its essence.

The Ministry shall issue a decision in this particular in accordance with the applicable conditions and rules for resolution of the original application for registration, and the same methods

of petition for review and appeal to such decision.

Article 19

The period of protection resulting from registration of a trademark shall be ten years. The owner of the mark may guarantee continuity of protection for subsequent periods of ten years each if he submits an application for renewal of the registration of the mark during the final year of the current period of protection in accordance with the terms and conditions set forth in this law and the Implementing Regulations.

Renewal of registration of the mark shall occur without any additional examination and without permitting third parties to object to such renewal. Renewal of registration of the mark shall be published in the Official Gazette and in two daily newspapers issued in the State at the expense of the owner of the mark.

When an application for renewal of registration of a mark is made, it shall not be permitted to introduce any change to the mark or to add any products or services to the list of products or services in respect of which the mark was registered.

During the month following expiration of the protection period , the Ministry must notify the owner of the mark in writing at his address, as entered in the Register, of expiration of the period of protection for such mark. If the owner of the mark does not submit an application for renewal within the three months following the date of expiration of the protection period, then the Ministry on its own initiative shall delete the mark from the Register.

Article 20

The owner of the trademark may request its deletion from the Register whether with regard to all of the products or services in respect of which the mark is registered or with regard to only a portion thereof. The application for deletion shall be submitted in accordance with the terms and conditions provided for in the

Implementing Regulations to this law.

If the mark was licensed for use in accordance with a contract registered in the Trademarks Register, then the registration of such mark may not be deleted except pursuant to the written agreement of the beneficiary of such license unless the beneficiary expressly releases such right in the licensing contract.

Article 21

Without prejudice to the provisions of Article 17, the Ministry and any concerned party shall have the right to request a judgement deleting a trademark that was registered without right. The Ministry must delete registration when a final judgement to this effect is submitted to it.

Article 22

The competent civil court may pass judgement based upon the application of any interested party to delete registration of a trademark if it is proved to such court that the mark was not used seriously during five consecutive years unless the owner of the mark submits a justification for such non-use.

Article 23

The competent civil court may issue judgement based upon the application of the Ministry or any interested party to add any statement to the Register that it was neglected to enter therein, or to delete or amend any statement appearing in the Register if it was entered without color of right or not in conformity with the facts.

Article 24

The Ministry shall delete registration of a trademark that the Israel Boycott Office of the State determines to be similar to or identical to an Israeli mark, symbol or emblem, and similarly marks owned by persons in respect of whom a decision has been issued prohibiting transaction therewith.

Article 25

The deletion of a trademark from the Register must be published in the Official Gazette.

Article 26

If registration of a trademark is deleted, then it may not be re-registered in favor of a third party with respect to the same products until following the passing of three years from the date of deletion.

Chapter 3

Transfer of Ownership and Mortgage of the Mark

Article 27

It shall be permitted to transfer ownership of a trademark, to mortgage a trademark, or to attach a trademark. Such attachment may be with or without attachment of the commercial premises or productive facility whose products or services are distinguished by the mark.

Article 28

The transfer of ownership of the commercial premises or the productive facility shall include the trademarks registered in the name of the transferor if such marks may be deemed to have an established relationship with the premises or facility, unless agreed to the contrary.

If ownership of the commercial premises or productive facility is transferred without transfer of the mark, then the transferor may continue to use the mark with regard to the products or services in respect of which it was registered unless agreed to the contrary.

Article 29

The transfer of ownership of the trademark or its mortgage shall not be asserted as against third parties until following endorsement thereof in the Trademark Register and publication thereof in the manner stated in the Implementing Regulations.

Chapter 4

Contracts for Licensing the Use of a Mark

Article 30

Pursuant to a written and authenticated contract, the owner of a trademark may license to one or more other persons the use of the mark in respect of all or some of the products or services in respect of which such mark is registered. The owner of the mark may himself use the mark unless agreed to the contrary.

The period for licensed use of the mark may not exceed the period of protection of such mark.

Article 31

The contract for licensing use of the trademark must be entered in the Trademarks Register, and the licensing shall have no effect with regard to third parties until following its entry in the register and publication thereof in the manner stated in the Implementing Regulations.

Article 32

The licensee may not transfer the same to a third party or grant sub-licenses unless the licensing contract states otherwise.

Article 33

A license shall be deleted from the Register based upon the application of the owner of the mark or licensee following the submission of evidence of expiration or termination of the licensing contract.

The Ministry shall notify the other party of the submission of the application for deletion of the license, and such party shall have the right to object to such application for deletion in accordance with the procedures and terms provided for in the Implementing Regulations.

Article 34

The licensing contract may not contain any provisions that subject the licensee to restrictions that do not flow from the rights that are granted by registration of the trademark or that are not necessary to preserve such rights. Nevertheless, the licensing contract may contain the following restrictions:

- (1) A limitation on the geographic territory for marketing the products or services bearing the mark.
- (2) A limitation on the time period for licensed use of the mark provided that the provisions of Article 31 of this law be observed in this particular.
- (3) Conditions that guarantee to the owner of the mark control of the quality of the products to which the license applies.
- (4) A requirement that the licensee refrain from all acts from which may result a decrease in value of or other harm to the products or services that bear the mar.

Chapter 5

Marks Used Specifically to Indicate Supervision or Inspection of Particular Products

Article 35

Juristic persons that undertake the supervision or inspection of the source, elements, assembly, manufacturing, process, quality, nature or any other particular of certain products or services may request the Ministry to license them to register a mark specifically for indicating the performance of such supervision and inspection.

In all circumstances, the registration of such marks or transfer of ownership thereof shall not be permitted except upon the agreement of the Minister.

Article 36

The Implementing Regulations shall define the conditions and rules pertaining to registration of the marks referred to in the foregoing Article and the documents that must accompany the application for registration.

Registration of such mark shall carry with it all of the effects set forth in this law.

Such mark may not be re-registered, in the event of its deletion or non-renewal, with regard to identical or similar products, goods or services.

Chapter 6

Penalties

Article 37

The following shall be punished with confinement and a fine of no less than Dh 5, 000 or to either of such penalties:

- (1) Any person who forges a trademark that had been registered in accordance with the law, or who imitates such mark in such a way as to deceive the public, and any person who uses with bad intent a forged or imitated trademark.
- (2) Any person who without right uses a trademark that is registered and owned by another party.
- (3) Any person who with bad intent places upon his products a trademark registered and owned by another party.
- (4) Any persons who sells, offers for sale, deals in, or possesses with the intent of selling products that bear a forged or imitated trademark placed without right, if such person has knowledge thereof.
- (5) Any person who offers to provide services under a forged or imitated trademark or a trademark used without right, if such person has knowledge thereof.

Article 38

The following shall be punished with confinement not in excess of one year and with a fine of no less than Dh 5, 000 and no more than Dh 10, 000 or either of such penalties:

- (1) Any person who uses a mark that is not susceptible to registration in accordance with the provisions of

paragraphs 2, 3, 4, 5, 6, 8, 9, 10, 11 and 12 of Article 3 of this law.

- (2) Any person who without right enters statements on his trademarks or commercial papers that lead to a belief in registration thereof.

Article 39

Any person who commits one of the crimes set forth in Articles 37 and 38 of this law shall in case of repetition of the same crime be further punished with closure of the commercial premises or the productive facility for a period of not less than fifteen days and no more than six months, along with publication of the judgement at the expense of the convicted person in accordance with the procedures set forth in the Implementing Regulations.

Article 40

Any person who suffers harm as a result of any of the acts set forth in Articles 37 and 38 of this law may file a suit before the competent civil court demanding the person responsible for such act to pay compensation commensurate with the harm suffered.

Article 41

Based upon an application accompanied by an official certificate proving registration of the mark, the owner of a trademark may at any time, even prior to the filing of any civil or criminal action, obtain an order from the competent court that the necessary preventive measures be taken, and in particular the following:

- (1) The preparation of a specific record and detailed description of the tools and instruments that are or were used in the commission of any of the crimes set forth in this law; the local or imported products or goods; and the signboard for the premises, packaging, papers and other items upon which the mark or statement that is the subject of the crime was placed.

- (2) The imposition of an attachment upon the items mentioned in the foregoing paragraph, following the submission by the applicant of a financial security to be evaluated by the court to compensate the attachee when appropriate.

The court may appoint one or more experts to cooperate in implementation of the preventive measures. In all circumstances, the preventive measures taken by the owner of the mark shall be deemed as if they did not exist if not followed within ten days following the issuance of the order by the filing of a civil or criminal action against the party against whom such measures were taken.

Article 42

Within ninety days, the attachee may file a suit demanding that the applicant for attachment pay compensation. Such ninety-day period shall begin from the date of issuance of the final judgement in the suit filed against the attachee, or from the date of the passing of the deadline set forth in the last paragraph of Article 41 of this law if suit is not filed against the attachee. In either circumstance, the security shall not be returned to the applicant for attachment until following the issuance of the final judgement in the case filed by the attachee or until following the passing of the applicable time period without such case being filed.

Article 43

The court may in any civil or criminal action issue judgement to confiscate the attached items or the items that may subsequently be attached, to recover fines and compensation from the value thereof, and to dispose thereof by any other means that the court may deem appropriate. The court shall also have the right to order the destruction of unlawful marks or to order when necessary the destruction of the goods, packaging, packing equipment and other items that bear the marks or that bear

unlawful statements, including tools and instruments that are used particularly for performing gorgery. The court may order all of the foregoing even when an acquittal has been adjudged. The court may also order publication of the judgement in the official Gazette or in any of the daily newspapers at the expense of the judgement debtor.

Chapter 7

General and Transitional Provisions

Article 44

The owners of trademarks that are registered or used in the Emirates when the provisions of this law come into effect must submit applications for registration thereof in the Register of the Ministry in accordance with the provisions and conditions set forth in this law during one year from the effective date of the provisions hereof.

Persons who have not complied with the conditions set forth in this law shall amend their situations within one year from the effective date of this Law. If the trademark does not comply with such conditions during the time period set forth in the foregoing sentence, then it shall be deemed released by force of law.

The first user shall have the right of priority in registration of its mark during such period. In determining first use, the date of commencement, the continuity, the surrounding circumstances, and the registration of the mark shall all be considered.

Article 45

The Ministry shall notify the Concerned Authority in each Emirate, the Federation of Chambers of Commerce and Industry, and the Chambers of Commerce and Industry in the state of the names of the owners of trademarks registered with the Ministry, the particulars thereof, and any changes, amendments or deletions that may occur in respect thereof within thirty days from the date of registration, change, amendment or deletion.

Article 46

The official concerned with the supervision of the implementation of the provisions of this Law and the resolutions issued in execution thereof, who shall be appointed by resolution of the

Minister of Justice with the agreement of the Minister of Economy and Commerce and the concerned authorities, shall have the capacity of officers of the judiciary and in this capacity shall have the right to enter into places the activities of which fall within the ambit of the provisions of this law, except for places that are specifically for residence, for the purpose of confirming the implementation of the provisions of this law and the resolutions in execution thereof and of investigating violations. The local authorities in the Emirates shall render all facilities necessary to such officers to enable them to perform their task.

Article 47

A resolution of the Cabinet shall be issued determining the fees that shall be collected in respect of the procedures that shall be conducted pursuant to the provisions of this law.

Article 48

All provisions contrary or contradictory to the provisions of this law shall be repealed.

Article 49

The Minister shall issue the directives and resolutions necessary to implement the provisions of this law.

Article 50

This law shall be published in the official Gazette and shall take effect following three months from the date of its publication.

Zayed bin Sultan Al Nahyan
President of the State of the
United Arab Emirates

Promulgated by us in the Presidential
Palace in Abu Dhabi

Date: _____ 1412 A.H.

Corresponding to _____ 1992 A.D.