FEDERAL LAW NO . 37

Issued on 28/9 / 1992

Corresponding to 1 Rabi' al - Thani 1413 H.

CONCERNING TRADEMARKS

Amended by

Federal Law no . 19/2000 dated 16/09/2000; and

Federal Law no . 8/2002 dated 24/07/2002 .

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

Pursuant to the perusal of the provisional 2 Constitution; and

Federal Law no . 1 of 1972 regarding the jurisdictions of the Ministries and the competences of the

Ministers and the amending laws thereof; and

Federal Law no . 4 of 1979 regarding the Repression of Fraud and Swindling in Commercial Transactions

; and

Federal Law no . 5 of 1985 regarding the Issuance of the Civil Transactions Code , and the amending laws thereof; and

Federal Law no . 3 of 1987 regarding the Issuance of the Penal Code; and

Acting upon the proposal of the Minister of Economy and Commerce, the consent of the Cabinet and the approval of the Federal Supreme Council;

Have promulgated the following Law:

TITLE ONE

DEFINITIONS

Article 1

As amended by Federal Law no . 19 dated 16/9 / 2000 and Federal Law no . 8 dated 24/7 / 2002:

In the implementation of the provisions hereof, the following terms and phrases shall have the meanings assigned for each of them unless the context requires otherwise:

The State: The United Arab Emirates State.

The Ministry: The Ministry of Economy and Commerce.

The Minister: The Minister of Economy and Commerce.

The Competent Authority: The Competent Authority in the Emirates.

The Circular: Trademarks circular issued by the Ministry.

The Drawing: Each design including a number of visuals (artistic composition).

The Symbol: Each single visual drawing.

The Hallmarks: Incised marks.

The Engravings: Embossed Marks.

The Pictures: Pictures of a person whether that of the project owner or someone else.

The Register: The register of trademarks before the Ministry.

The Committee: The Committee of Trademarks provided for in this Law.

Shall be considered a trademark all that takes a distinctive shape composed of names , words , signatures , letters , numbers , drawings , symbols , addresses , hallmarks , stamps , pictures , engravings , advertisements , packages or any other mark or a combination thereof if used or meant to be used either in distinguishing goods , products or services of whatever origin , or establishing that the goods or products are owned by the owner of the Trademark because he manufactures , selects or trades therein , or that a service has been rendered .

A sound shall be considered part of the Trademark if it is accompanying it.

Article 3

As amended by Federal Law no . 8 dated 24/7 / 2002:

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

- 1 Marks without any distinctive description or character , or marks composed of statements which are customary appellations in use for such goods , products and services , or common designs and usual pictures of the said goods and products .
- 2 Any mark that violates public morals or is contrary to public policy.
- 3 Public emblems, flags and other symbols relating to the State, Arab or international organizations or one of their institutions, or a foreign state unless so authorized by it as well as any imitation of such emblems, flags or symbols.
- 4 Symbols of the Red Crescent or Red Cross and other similar imitating symbols.
- 5 Marks which are similar to or resemble symbols of pure religious character.
- 6 Geographical names and data should their use create confusion as to the origin or source of the goods, the products or the services.
- 7 The name, surname, picture or emblem of a third party unless his, or his heirs consent has been obtained in advance.
- 8 Indications of honorary distinctions to which the applicant for registration cannot prove that he is legally entitled .
- 9 Marks which are likely to deceive the public or which contain false indications as to the origin or source of the products or services , or as to its other characteristics , as well as marks containing an indication of a fictitious , imitated or forged trade name .
- 10 Marks belonging to physical or moral persons with whom dealings are prohibited.
- 11 Marks , whose registration for certain category of products or services would result in depreciating the value of other products or services distinctively characterized by the mark .
- 12 Marks which contain the following words or expressions : (Distinction) or (Having Distinction) or (Registered) or (Registered Design) or (Printing Rights) or (Imitation deemed counterfeit) or such other similar words or expressions .
- 13 National or foreign distinctions as well as metal or paper marks.

14 - Marks that are considered mere reproduction of a reputed mark or other registered mark should such registration create confusion to the consumers as concerns the products distinguished by the mark or products similar thereto .

Article 4

As amended by Federal Law no . 8 dated 24/7 / 2002:

- 1 Trademarks of worldwide fame transcending the boundaries of their country of origin to other countries may not be registered except upon application of the original owner or an official power of attorney issued thereby .
- 2 In order to determine whether the mark has acquired fame, the extent of the concerned public's knowledge thereof due to its promotion should be taken into consideration.
- 3 Renowned trademarks must not be registered to distinguish goods or services that are not similar or conform to those distinguished by such trademark, in case:
- a The use of the trademark indicates a relation between the goods or services to be distinguished and the goods or services of the owner of the original mark .
- b The use of the trademark may cause prejudice to the interests of the owner of the original mark.

TITLE TWO

REGISTRATION AND DELETION OF TRADEMARKS

Article 5

The Ministry shall keep a register called "Trademarks Register" where shall be registered all Trademarks, names and addresses of their owners, type of their activity, description of their goods, products or services and any assignment, transfer of ownership, mortgage, change in the license to use or any other amendments occurring thereto.

Anyone may request a true copy of the contents of the said Register upon payment of the prescribed fees .

Article 6

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

- 1 State nationals, be it natural or juridical persons, who carry out any commercial, industrial, handcraft or service activities.
- 2 Non nationals, be it natural or juridical persons, who carry out, in the State, any commercial, industrial, handcraft or service activities.
- 3 Non nationals, be it natural or juridical persons, who carry out any commercial, industrial, handcraft or service activities in any country which deal with the State as per the reciprocity concept.
- 4 Public juridical persons.

All those wishing to use a Trademark to distinguish any goods or products or services may apply for its registration in accordance with the provisions of this Law.

The application for registration of a mark is to be submitted to the Ministry in accordance with the procedures and conditions prescribed in the Implementing Regulation 2

Article 8

As amended by Federal Law no . 8 dated 24/7 / 2002:

The trademark may be registered for one or more of the classes of products or services in accordance with the international classification and the rules thereof set forth in the Implementing Regulation hereof . The application for the registration of a mark may not contain more than one class .

Article 9

A single application may be submitted for the registration of several marks whose fundamental elements are similar, but which differ only in matters not essentially affecting its substance, such as the color of the mark, the data of the products or services related thereto, and provided that the said products or services are included in the same class.

Article 10

As amended by Federal Law no . 8 dated 24/7 / 2002:

With due observance of Article 26 of this Law, a Trademark may not be registered should it be identical or similar to a mark already registered in respect of the same products or services, or of different products or services if the use of the trademark object of registration may create an impression of the existence of a link between it and the products and services of the owner of the registered mark or may lead to a possible prejudice to his interests.

Should one or more persons apply on the same date for the registration of the same mark , or one close or similar to it , in respect of the same products , or similar ones falling in the same class , the Ministry shall stop the registration of all applications until the submission of an assignment , approved by all litigants , is submitted in favor of one of them or until a final judgment is rendered in favor of any of them .

Article 11

As amended by Federal Law no . 8 dated 24/7 / 2002 :

The Ministry may impose any restrictions or modifications it deems necessary to delimit or clarify the mark in such a way as to prevent confusion with another mark previously registered or for any other reason it sees fit . Should the Ministry , for any reason , refuse to register a trademark or condition its registration on certain restrictions or modifications , it must notify the applicant for registration , in writing , of the reasons of its decision .

The Ministry has , in any case , to take a decision on the application within thirty days as of the date of its submission provided it fulfills the conditions and requirements provided for in this Law and its Implementing Regulation .

Article 12

The applicant for registration, whose application has been rejected, or whose approval is conditioned on fulfillment of certain conditions, may grieve thereagainst before the Committee within thirty days from the date of his notification of the decision.

If the Committee confirms the Ministry's decision in rejecting the application, or making it conditional upon compliance with certain requirements, the applicant may appeal against the said decision before the competent civil court within sixty days as of the date of notifying it to him.

If the applicant does not grieve against the decision of the Ministry , or appeal against the decision of the Committee , within the periods prescribed in this Article , or if he does not comply with the restrictions or conditions required by the Ministry within the period prescribed in the notification served upon him in this respect , he shall be considered as having relinquished his application .

Article 13

As amended by Federal Law no . 8 dated 24/7 / 2002:

The Trademarks Committee shall be composed of the undersecretary as Chairman and the membership of :

- Two representatives of the Ministry, nominated by the Minister;
- A member of the Board of Directors of the Union of the Chambers of Commerce and Industry in the State, nominated by the Union;
- A member of the Board of Directors representing each of the Chambers of Commerce and Industry , nominated by the concerned chamber .

The Committee shall elect from among its members a vice - chairman. Its meetings shall be validly held if attended by the majority of its members and the resolutions shall be taken by the majority of the attending members. In case of a tie, the chairman shall have the casting vote.

The Committee shall meet once a month at least.

The Committee shall have a rapporteur nominated by the Ministry.

The remunerations of the Committee's members and rapporteur shall be determined by decision of the Cabinet .

Article 14

As amended by Federal Law no . 19 dated 16/9 / 2000 and Federal Law no . 8 dated 24/7 / 2002 :

Should a Trademark be accepted the Ministry shall - before its registration - publish it at the expense of the applicant in the circular and in two Arabic daily newspapers issued in the State . Every interested person may oppose the registration of the Trademark . The opposition shall be submitted , in writing , to the Ministry or addressed to it by registered or electronic mail within

thirty days as of the date of the last publication. The Ministry has to notify the applicant for registration a copy of the opposition to his application within fifteen days from the date of receipt thereof.

The applicant must submit to the Ministry a written reply to such opposition within thirty days as of the date of notifying it to him. If no reply is received during that period, the applicant shall be deemed to have relinquished his application.

Article 15

Before deciding upon the oppositions submitted to it, the Ministry shall, upon request of either party, hear both or either of them.

The Ministry shall issue its decision, rejecting or accepting registration, and – in the latter case – may impose such limitations or conditions as it deems fit.

Any interested person may file, with the Committee, a grievance against the decision of the Ministry within fifteen days as of its notification to him. He may appeal against the decision of the Committee to the competent civil court within thirty days from the date of notification of the decision.

The appeal against the decision accepting registration of the Trademark shall not have the effect of suspending the registration formalities unless otherwise decided by the competent court .

Article 16

As amended by Federal Law no . 8 dated 24/7 / 2002 :

Should the trademark be registered, the effect of its registration shall retrospectively go back to the date of submitting the application. Upon completion of its registration, the owner of the mark shall be given a certificate including the following information:

- 1 Registration number of the mark.
- 2 Date of submission of the application and date of registration.
- 3 The commercial name or the name of the trademark owner, his nationality and residence.
- 4 A true copy of the mark.
- 5 Statement of the products, goods or services to which the mark applies and of the corresponding class thereof.
- 6 Number and date of the international priority as well as the name of the State, member of the Paris Convention for the Protection of Industrial Property Right, with which the priority application was submitted.

Article 17

As amended by Federal Law no . 8 dated 24/7 / 2002 :

Whoever registers a mark shall be considered its exclusive owner. Ownership of a mark may not be disputed if the person who registered it has used it for an uninterrupted period of five years at least from the date of its registration without being involved in a lawsuit deciding that he is not the owner thereof.

The owner of a registered mark shall enjoy the right to prevent any third person from using an exact or similar mark in order to distinguish the same or similar products or services, or connected to products and services for which the mark was registered, in such a manner as to create confusion in the minds of the consumers.

Article 18

As amended by Federal Law no . 8 dated 24/7 / 2002:

The owner of a previously registered trademark , may at any time , apply to the Ministry to enter any additions or modifications on the products or services distinguished by the mark or on the mark itself provided the modification does not fundamentally affect the identity of the mark . The Ministry's decision concerning the application for modification of the products or services shall be issued in accordance with the rules and conditions relating to the deletion of the mark from some products or services . However , its decision concerning the modification of the mark shall be issued in accordance with the conditions and rules applicable to the original applications for registration , and shall subject to grievance and appeal in the same manner .

The modification shall be published, at the expense of the applicant in the circular and in two Arabic daily newspapers published in the State.

Article 19

As amended by Federal Law no . 19 dated 16/9 / 2000 and Federal Law no . 8 dated 24/7 / 2002:

The duration of the protection of a mark resulting from its registration shall be ten years . The owner of the mark may ensure the continuation of the protection for further consecutive periods of ten years by submitting , during the last year of the current protection period , an application for renewal of the mark in accordance with the manners and conditions prescribed in this Law and its Implementing Regulation .

The mark shall be renewed without any new examination and without the possibility of opposition by third parties . The renewal of the registration of the mark shall be published at the expenses of the owner in the circular and in two Arabic daily newspapers published in the State . It shall not be allowed , in case of renewal of the mark , to enter any change in it or any deletion or addition to the list of goods or services in respect of which the mark is registered .

Within the month following the expiration of the protection period, the Ministry shall send to the owner of the mark at his address recorded in the Register a written notification of the date of expiration of the protection period. If the owner of the mark fails to submit the application for renewal within the three months following the date of expiration of the protection period, the Ministry shall, on its own motion, delete the mark from the Register.

Article 20

The owner of the Trademark may apply for its deletion from the register, either in respect of all or part of the products or services for which the mark was registered. The application for deletion shall be submitted in accordance with the procedures and conditions prescribed by the Implementing Regulation of this Law.

If the use of the mark is licensed in accordance with a contract recorded in the trademark register , the said mark may not be deleted from the register except upon written consent of the licensee , unless the latter expressly renounces to this right in the license agreement .

Article 20 (bis)

Added by Federal Law no . 8 dated 24/7 / 2002 :

The Ministry shall delete the unduly registered mark after notifying those concerned of the reasons for deletion, hearing their opinion and acknowledging their defense.

The concerned persons may challenge the decision to delete before the competent civil court within thirty days from the date of notification of said deletion.

Article 21

As amended by Federal Law no . 8 dated 24/7 / 2002:

Without prejudice to the provision of Article 17, the interested person shall be entitled to request the order to delete the unduly registered trademark. The Ministry shall delete the mark from the Register upon submission of a final enforceable judgment.

Article 22

As amended by Federal Law no . 8 dated 24/7 / 2002:

Upon request from any interested person , the competent civil court shall order the deletion of a trademark if it was proved that it wasn't used during five consecutive years unless the owner thereof establishes that the non - use is due to a reason beyond his control . Import restrictions and other governmental conditions imposed on goods and services distinguished by the mark , shall be considered reasons beyond control .

For the purposes of the present Article, the use of the trademark by any person authorized thereto by the owner thereof shall be deemed a use thereof.

Article 23

As amended by Federal Law no . 8 dated 24/7 / 2002:

Upon application from the person concerned, the competent civil court shall order the addition to the register of any information that has been omitted by oversight or the deletion or modification of any data unduly recorded therein or falsely stated. The Ministry, for this purpose shall act of its own accord.

Article 24

The Ministry shall delete the mark which the Israeli Boycott Office in the State decides that it is similar or identical to an Israeli mark, symbol or emblem, and also the mark belonging to persons subject to a boycott decision.

Article 25

As Amended by Federal Law no . 19 dated 16/9 / 2000 and Federal Law no . 8 dated 24/7 / 2002:

The deletion of a Trademark from the Register shall be published, at the expense of the applicant thereto, in the circular and in two Arabic newspapers published in the State.

Article 26

If a Trademark is deleted from the Register, it shall not be re - registered in the name of another person for the same products except after the lapse of three years from the date of its deletion.

TITLE THREE

TRANSFER OF OWNERSHIP AND MORTGAGE OF A TRADEMARK

Article 27

Transfer of ownership, mortgage or seizure of a Trademark may be concurrently or separately done with the commercial establishment or the exploitation project in respect of which the Trademark is used to distinguish its products or services.

Article 28

Unless otherwise agreed, the transfer of ownership of a commercial establishment or an exploitation project shall include those trademarks registered in the name of the transferor that may be considered closely connected to the establishment or the project.

If the ownership of a commercial establishment or exploitation project is transferred without the trademark, the transferor may continue to use that trademark for the goods or services for which it was registered, unless otherwise agreed.

Article 29

Transfer of ownership or mortgage of a trademark shall have no effect against third parties unless recorded in the Trademarks Register and made public in the manner prescribed by the Implementing Regulation 2

TITLE FOUR

AGREEMENTS LICENSING THE USE OF TRADEMARKS

Article 30

The owner of a Trademark may , by virtue of a written and notarized contract , grant to one or several persons a license to use the Trademark for all or part of the goods or services in respect of which the trademark is registered 2 The owner of the trademark may also use the Trademark himself unless otherwise agreed .

The duration of the license to use the trademark should not be longer than the period prescribed for its protection .

The license agreement to use the Trademark must be recorded in the Trademarks Register. The license shall have no effect against third parties until it has been recorded in the Register and published as prescribed in the Implementing Regulation.

Article 32

As amended by Federal Law no . 8 dated 24/7 / 2002:

A licensee may not assign the license to third parties or grant sub - licenses , unless otherwise provided in the license agreement .

Under no circumstances may the use of a trademark be made subject to a compulsory license.

Article 33

The entry of a license may be deleted from the register on request of the owner or the licensee upon submitting evidence 2 of termination or rescission of the license agreement.

The Ministry shall notify the other party of the application for deletion in accordance with the procedures and conditions prescribed in the Implementing Regulation .

Article 34

The license agreement may not contain any stipulation imposing on the licensee limitations that are not incumbent on the rights conferred by the registration of the mark or not necessary for the maintenance of such rights . Nevertheless , the license agreement may contain the following limitations:

- 1 Delimitation of the geographical territory for marketing the goods or services labeled with the Trademark .
- 2 Limitation of the duration of the use of the Trademark , with due consideration , in this respect , to the provisions of Article 21 of this Law .
- 3 Provisions ensuring the effective control by the owner over the quality of the products to which the license applies .
- 4 Binding the licensee to abstain from all acts that may result in devaluating or prejudicing the products or services labeled by the mark .

TITLE FIVE

MARKS ALLOCATED FOR THE EVIDENCE OF THE CONTROL OR INSPECTION OF SPECIFIC PRODUCTS

Article 35

Juridical persons undertaking the control or inspection of certain products or services as to their origin, components, manufacturing process, quality, identity or any other common

characteristics, may apply to the Ministry to authorize them to register a trademark allocated to evidence control and inspection.

In all cases, the said Trademark may not be registered, or its ownership transferred, except with the approval of the Minister.

Article 36

The Implementing Regulation shall determine the conditions and rules related to the registration of the trademark mentioned in the preceding article, and also the documents required to be attached to the application for registration.

The registration of the said trademark shall have all the effects provided for in this law . In case the said trademark is deleted or not renewed , it cannot be re - registered in respect of identical or similar products or services .

TITLE SIX

SANCTIONS

Article 37

As amended by Federal Law no . 8 dated 24/7 / 2002:

Shall be sentenced to imprisonment and to a fine not less than AED 5.000, or to either penalty:

- 1 Whoever counterfeits a duly registered trademark or imitates it in such a way as to mislead the public, in respect of goods or services characterized by the original mark or those similar to them, and whoever knowingly makes fraudulent use of a counterfeited or imitated trademark.
- 2 Whoever, in bad faith, affixes on his products a registered trademark belonging to another person or uses it without any right to do so.
- 3 Whoever sells, offers for sale or circulation, or possesses for sale purposes, products bearing counterfeited or forged trademark or unrightfully affixed on it with knowledge thereof, and whoever extends or offers to provide services under a counterfeited or imitated trademark or one unrightfully used, with knowledge thereof.

Article 38

As amended by Federal Law no . 8 dated 24/7 / 2002:

Shall be sentenced to imprisonment for a period not exceeding one year, and to a fine amounting to AED 5.000 at least and AED 10.000 at most, or to either penalty:

- 1 Whoever uses a non registerable mark as specified in paragraphs 2,3, 4,5, 6,8, 9,10,11,12,13 and 14 of Article 3 of this Law .
- 2 Whoever unduly indicates on his marks or on his business papers any statement which leads to the belief that the said mark is registered or to its distinction for products or goods not mentioned in the Register.

Whoever perpetrates one of the crimes provided in Article 37 and 38 of this Law shall be sentenced - in case of recidivism - to the same penalty as well as to the closing down of the commercial establishment or the exploitation project for a period of 15 days at least and 6 months at most , and the publication of the judgment at the expenses of the convict in accordance with the procedures specified in the Implementing Regulation .

Article 40

Any person who incurred damages as a result of any of the acts provided in Articles 37 and 38 of this Law may bring before the competent civil court an action against the person who caused the damage, claiming a suitable compensation for the damages he incurred.

Article 41

As amended by Federal Law no . 8 dated 24/7 / 2002 :

The owner of a Trademark may , at any time , and even before initiating any civil or criminal action , obtain from the court , upon a petition accompanied by an official certificate establishing the registration of the mark , an order directing that the necessary preventive measures be taken , including in particular the following :

- 1 Preparing a detailed descriptive inventory of the articles and tools intended to be used or actually used in committing any of the crimes provided for in this Law; as well as local and imported products or goods, addresses of the stores, the packaging, papers or others on which the mark or the incriminating statement is affixed.
- 2 Seizure of the articles mentioned in the preceding clause after submission by the plaintiff of a monetary deposit determined by the court to indemnify the defendant if need be .

The court may delegate one or more experts to assist in the implementation of the preventive measures .

Notorious marks shall be excepted from submission of a certificate evidencing the registration of the mark.

TITLE SEVEN

GENERAL AND TRANSITIONAL PROVISIONS

Article 42

The distrainee may bring an action against the distrainer for damages within 90 days starting as of the expiration of the period indicated in the last paragraph of Article 41 of this Law , if no action was brought against the distrainee , or as of the issue date of the final judgment rendered in the action brought against him . In both instances the deposit shall not be refunded to the

distrainer until a final decision has been taken in the action brought by the distrainee or after the expiry of the period prescribed for bringing his action without filing it.

Article 43

As amended by Federal Law no . 19 dated 16/9 / 2000 and Federal Law no . 8 dated 24/7 / 2002:

The competent court shall issue a judgment ordering the confiscation of the distrained objects or those to be distrained at a future time and the deduction of their value from the fines imposed or compensations awarded , or may otherwise dispose thereof as it may deem fit . The court may also order the destruction of the illegal marks and may order , if necessary , the destruction of the products and packaging and tools of packing and other articles bearing the illegal marks or statements , and the confiscation of the tools and articles particularly used in counterfeiting . The court may take all the above mentioned orders even in case of acquittal .

The court may also order the publication of the judgment, at the expense of the condemned party, in the circular or in one of the Arabic daily newspapers published in the State.

Article 44

Owners of the Trademarks registered or used in the U. A . E . at the time of the coming into force of the provisions of this Law , shall submit applications for recording them in the Ministry's Register in accordance with the provisions and conditions specified therein within one year from the date of the coming into force of its provisions .

Those who do not fulfill with the conditions prescribed in this law shall adjust their status within one year of its coming into force . Should the trademark not comply with the prescribed conditions within the period specified in the preceding paragraph , it shall be considered as extinguished by force of law .

The first user shall have a priority right in registering his mark during the said period. In determining the first use, the date of starting the use, its continuity, the fact of registering the mark and the surrounding circumstances shall be taken into consideration.

Article 45

The Ministry shall notify the competent authority in every emirate, the Union of Chambers of Commerce and Industry, as well as said chambers in the State of the names of the owners of trademarks registered in the Ministry, the data related thereto, and any change, amendment or deletion occurring thereto, and such within thirty days from the date of registration, change, amendment or deletion.

Article 46

The officers appointed by a decision of the Minister of Justice in consultation with the Minister of Economy and Commerce and by the competent authority, to control the application of the provisions of this law and its implementing decisions shall have the status of Judicial Police. In such status they are empowered to enter into the places which activity falls within the scope of this Law, except dwelling places, with a view to ascertain the compliance with the provisions of

the law and its implementing decisions, and apprehending the cases in violation thereof. The local authorities in the Emirates shall extend the facilities required in order to enable the said officers to discharge their duty.

Article 47

The fees payable in respect of the procedures provided for in this Law shall be determined by decision of the Cabinet .

Article 48

Every provision contradicting or contravening with the provisions hereof shall be abrogated.

Article 49

The Minister shall issue the regulations and decisions necessary for the implementation of this Law.

Article 50

This law shall be published in the Official Gazette, and shall enter into force after three months from the date of its publication.

Promulgated by Us at the Presidential
Palace in Abu Dhabi
On 1 Rabi' al - Thani 1413 H.
Corresponding to 28 September 1992

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

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