

FEDERAL LAW NO. (37) OF 1992
CONCERNING TRADE MARKS

We, Zayed Bin Sultan Al Nahyan, UAE President,
After perusal of the Constitution; and
Federal Law No. (1) of 1972 concerning the jurisdictions of ministries and powers of ministers as amended; and
Federal Law No. (4) of 1979 concerning the suppression of fraud and deceit in commercial transactions; and
Federal Law No. (5) of 1983 issuing the Civil Procedures Code as amended; and
Federal Law No. (3) of 1987 issuing the Penal Code; and
Pursuant to the proposal of the Minister of Economy and Commerce, the approval of the Cabinet and the ratification of the Federal Supreme Council,
Hereby promulgate the following Law :

Chapter I

Definitions

Article (1)*

For the implementation of the provisions of this Law the following words and expressions shall have the meanings indicated opposite thereto, unless otherwise required by the context :

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| State | : | United Arab Emirates. |
| Ministry | : | Ministry of Economy and Commerce. |
| Minister | : | Minister of Economy and Commerce. |
| Competent Authority | : | The competent authority in the Emirate. |
| Bulletin | : | Trademarks Bulletin issued by the Ministry |
| Drawing | : | Any design including a group of visuals (any artwork). |

* Amended by Federal Law No. (8) of 2002

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| Logo | : | Any one visual drawing. |
| Hallmarks | : | Engraved marks. |
| Carvings | : | Salient marks. |
| Pictures | : | Pictures of man whether that of the project owner or any other person. |
| Register | : | The trademarks register at the Ministry |
| Committee | : | The Trade Marks Committee stipulated. |

Article (2)

Shall be considered a trade mark 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 voice shall be considered as part of the trade mark if it accompanies it.

Article (3)*

The following shall not be registered as a trade mark or an element thereof :

1. The mark having no property or distinctive character or that made of data being only the name given by tradition to familiar goods, products, services or the ordinary drawings and pictures of goods and products.
2. Any mark breaching the public morals or violating the public order.
3. Public emblems, flags and other logos, of the State, the Arab or international

* Amended by Federal Law No. (8) of 2002

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 with regard to 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 mistatments 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 :

Concession, Concessionaire, Registered, Registered Drawing, Copyright, Imitation is Considered Forgery or such similar words and expressions.

13. The national and foreign medals, coins and bank notes.
14. The marks deemed as just a translation for a renown mark or another mark already registered, if the registration would confuse the consumers, with regard to products distinguished by the mark or similar products.

Article (4)*

1. The trademarks having an 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 a 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.

* Amended by Federal Law No. (8) of 2002

Chapter II

Registration of Trade Marks and their Striking Off

Article (5)

A register called "Trade Marks Register" shall be set up at the Ministry wherein shall be recorded all the trade marks, 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 licence for use concerning such marks or any other changes.

Any person may request a certified true copy of what is recorded in said register after paying the prescribed fees.

Article (6)

The following persons shall have the right to register their trade marks :

1. National natural or juridical persons carrying out any commercial, industrial, handicraft or services activity.
2. Foreign natural or juridical persons carrying out any commercial, industrial, handicraft or services activity in the State.
3. Foreign natural or juridical persons 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)

Any person wishing to use a trade mark to distinguish goods, products or services may apply for its registration according to the provisions hereof.

The application for the registration of a trade mark shall be submitted to the Ministry under the circumstances and conditions provided for in the Executive Regulations.

Article (8)*

A trade mark may be registered for one or more categories of the products or services according to the international classification and the rules thereof as indicated by the Executive Regulations of the present law. However, the application for the registration of a trade mark may not include more than one category.

Article (9)

One application may be submitted for the registration of a group of marks having identical substantial elements and whose difference is restricted to matters not substantially affecting their essence such as the colour of marks or the data on the products or services related thereto, provided such products or services shall belong to one category.

Article (10)*

Subject to the provisions of Art. (26) hereof, no trade mark 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.

* Amended by Federal Law No. (8) of 2002

Article (11)*

The Ministry may impose the restrictions and changes it deems necessary to determine and clarify the trade mark in a way preventing its confusion with another mark already registered mark or for any other reason it deems expedient. The confusion will be established when the trademark is used to distinguish similar goods or services. Should the Ministry refuse for some reason to register the trade mark or if the registration is dependent on restrictions or changes, it shall notify the registration applicant in writing of the reasons of its decision.

In all events, the Ministry shall decide on the registration application within (30) days from the date of its submission if it meets the conditions and circumstances provided for in this Law and its Executive Regulations.

Article (12)

An applicant for registration whose application has been rejected or has been suspended on a condition may complain from such decision within (30) days from being notified thereof.

Should the Committee sustain the Ministry's decision rejecting the application or making its acceptance dependent on the satisfaction of some conditions, the applicant may challenge the Committee's decision before the competent civil court within (60) days from being notified thereof.

The applicant shall be deemed as having waived his request if he does not complain from the Ministry's decision or challenge the Committee's decision during the periods stated in this Article or if he does not fulfil the restrictions or conditions imposed by the Ministry in the period specified in the notice addressed to him in this regard.

* Amended by Federal Law No. (8) of 2002

Article (13)*

The Trade Marks Committee shall be formed under the chairmanship of the Undersecretary and membership of:

- Two representatives of the Ministry, nominated by the Minister.
- One Director from the State Chambers of Commerce and Industry Union, nominated by the Chambers Union.
- One Director for each Chamber of Commerce and Industry nominated by the Chamber itself.

The Committee shall select a vice chairman among its members. The meeting shall have the required quorum when attended by the majority of the members. Decisions are passed at the majority of the attendees, in case of a tie the Chairman's side shall preponderate. The Committee shall convene at least once per month. It will have a rapporteur appointed by the Ministry. The remuneration of the members and the rapporteur shall be determined by a Cabinet Resolution.

Article (14)*

Should the Ministry accept a trade mark, it shall, prior to 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

* Amended by Federal Law No. (8) of 2002

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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.

Article (15)

Prior to deciding on the objections submitted thereto, the Ministry shall hear the statements of both parties or either if any of them so requests.

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 trade mark shall not result in suspending of the registration procedures unless otherwise decided by the competent court.

Article (16)*

If a trade mark is registered, the effect of the registration shall start as from the date of submission of the application.

* Amended by Federal Law No. (8) of 2002

Upon finalizing the registration of a mark, its owner shall be given a certificate containing the following data :

1. Registration number of the mark.
2. Date of submission of application and date of registration.
3. Trade name or name, nationality and domicile of the mark owner.
4. Duplicate of the mark.
5. Description of the products, goods or services for which the mark is designated and their category.
6. Number and date of the international priority right and name of the State Member in Paris Convention for the Protection of the Industrial Property, where the priority right application has been lodged.

Article (17)

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.

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.

Article (18)*

The owner of an already registered trade mark may at any time apply to the Ministry for making any addition or change to the products or services distinguished by the

* Amended by Federal Law No. (8) of 2002

mark, or to his mark, that does not substantially affect its essence. The Ministry's decision in this regard shall be issued according to the conditions and rules prescribed for the deletion of the mark's registration for some products or service. As to the decision regarding the modification of the mark, it shall be issued as per the rules and conditions prescribed for deciding on original registration applications. It may be subject to grievance and challenge by the same means.

The modification shall be declared in the bulletin and in two Arabic dailies, at the expenses of the modification applicant.

Article (19)

The period of protection resulting from the registration of a trade mark 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.

The renewal of the mark registration shall be effected 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.

Article (20)

A trade mark 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.

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 licence beneficiary unless the beneficiary expressly waives such right in the licensing deed.

Article (20 a)

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 defense.

The concerned parties may file a grievance about the striking off resolution at the competent civil court within (30) days as of the notification.

Article (21)*

Without prejudice to the provision of Article (17), the Ministry and any concerned person shall have the right to request a judgement be passed for striking off a trade mark registered without right. The Ministry shall strike off such registration if a final and enforceable judgment is submitted thereto in this regard.

* Amended by Federal Law No. (8) of 2002

Article (22)*

The competent civil court may at the request of any interested person rule in favour of striking off the registration of a trade mark 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.

Article (23)*

The competent civil court may at the request of the Ministry or any concerned person rule that any data be added to the register if such data were omitted to be entered therein. It may also rule to delete or modify any data entered in the register, in case such data were entered without right or if the said data does not correspond to the reality, the ministry may carry out the same at its own discretion.

Article (24)

The Ministry shall strike off the registration of trade marks decided by the Israel Boycott Office in the State to be similar or identical to an Israeli mark, logo or emblem as well the marks owned by persons regarding whom a decision is issued prohibiting to deal therewith.

Article (25)*

The striking of a trade mark off the register shall be announced in the bulletin and in two Arabic dailies, at the expenses of the striking off announcement applicant.

Article (26)

Should a trade mark be stricken off, it may not be re-registered in favour of a third party for the same products except (3) years after the date of striking off.

* Amended by Federal Law No. (8) of 2002

Chapter III

Transfer of Ownership and Mortgage of Trade Marks

Article (27)

The ownership of a trade mark 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.

Article (28)

The transfer of ownership of a commercial shop or an exploitation project shall include the trade marks registered in the transferor's name which may be considered closely related to the shop or project unless otherwise agreed upon.

Should the ownership of a commercial shop or exploitation project be transferred without the mark, the ownership transferor may continue using such mark with regard to the products or services for which it is registered unless otherwise agreed.

Article (29)

The transfer of ownership of a trade mark 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.

Chapter IV

Contracts Licensing the Use of a Mark

Article (30)

The owner of a trade mark 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.

The period for licensing the use of a mark may not exceed that prescribed for its protection.

Article (31)

A contract licensing the use of a trade mark shall be recorded in the Trade Marks Register of marks. Such licensing shall have no effect vis-à-vis third parties except after being recorded in the register and announced in the manner determined in the Executive Regulations.

Article (32)*

A beneficiary of a licence may not assign it to a third party or grant sub-licences unless the licensing deed otherwise stipulates. Under no circumstances compulsory licensing for the use of a trade mark may be imposed.

Article (33)

A licensing contract shall be stricken off the register at the request of the owner of the mark or the license beneficiary after providing evidence of termination or cancellation of the licensing contract.

The Minister shall notify the other party of the application submitted for striking the licence off. Said party may object to the striking off application pursuant to the procedures and terms provided in the Executive Regulations.

Article (34)

A licensing contract may not contain any stipulations binding a licence beneficiary with restrictions not imposed on the rights granted by the registration of a trade mark or not necessary for preserving such right. However, a licensing contract may include the following restrictions :

* Amended by Federal Law No. (8) of 2002

1. Indication of the geographical area for the marketing of the products or services bearing the mark.
2. Indication of the period for using the mark subject in this respect to the provision of the Art. (31) hereof.
3. The conditions warranting to the mark owner the control of the products quality to which the licence is applicable.
4. The compelling of a licence beneficiary to abstain from all that acts which may result in undervaluing or harming the products or services bearing the mark.

Chapter V
Marks allocated for the
Control or Inspection of Certain Products

Article (35)

Juridical persons controlling or inspecting some products or services as to their source, components, mode of manufacture, quality, essence or any other property may apply to the Ministry for licensing them to register a mark reserved to indicate that the control and inspection has been carried out.

In all events, such mark may only be registered or its ownership transferred with the Minister's approval.

Article (36)

The Executive Regulations shall determine the conditions and rules for registering the mark referred to in the above Article and the documents requested to be attached to the registration application.

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

The said mark may not be re-registered if stricken off or not renewed with regard to similar or identical products, goods or services.

Chapter VI

Sanctions

Article (37)*

Shall be sentenced to imprisonment and a fine of at least Dh. 5000 (Five Thousand) or either:

1. Any person who forges a trade mark registered according to law or imitates same in a way misleading the public and any person who uses with bad faith a forged or imitated trade mark.
2. Any person who places with bad faith on his products a registered trade mark owned by a third party, or uses such mark without right.
3. Any person who deliberately sells, offers for sale or negotiation or acquires for sale products having a forged, imitated or illegally placed trade mark, the same applies to any person who deliberately provides or offers the provision of services under a forged, imitated or illegally placed trade mark.

Article (38)*

Shall be punished by imprisonment for a period not exceeding a year and to a fine of no less than Dh. 5000 (Five Thousand) and no more than Dh. 10,000 (Ten Thousand) or either penalties:

1. Any person who uses a Trade Mark which may not be registered as provided for in Clauses 2, 3, 4, 5, 6, 8, 9, 10, 11, 12, 13 and 14 of Article (3) hereof .
2. Any person who illegally notes on his mark or commercial papers statements

* Amended by Federal Law No. (8) of 2002

leading to believe that it has been registered or that it distinguishes products and goods other than the ones stated in the register.

Article (39)

Any person who repeats one of the offenses stated in Articles (37) and (38) hereof, shall be punished with the same penalty in addition to closing the commercial premises or the exploitation project for a period of no less than (15) days and no more than (6) months and publishing the judgment at the cost of the party adjudged pursuant to the procedures indicated in the Executive Regulations.

Article (40)

Any person who is prejudiced as a result of any of the acts provided for in Articles (37) and (38) hereof may lodge an action before the competent civil court to claim from the person who is responsible for the said act a proper compensation for the damages sustained by him.

Article (41)*

The owner of a trade mark may at any time, even before any civil or penal action is filed, obtain upon a petition accompanied by an official certificate indicating the registration of such mark an order from the competent court for taking the necessary precautionary measures, in particular the following :

1. To make a report enumerating and describing in detail the machines and tools being used or have been used in committing any of the offenses stated in this Law as well as the local or imported products or goods, the addresses of shops, the envelopes, the papers or others on which the mark or the note subject of the offense may have been placed.

* Amended by Federal Law No. (8) of 2002

2. To place a garnishment on the objects stated in the above Article after the applicant provides a deposit estimated by the Court to compensate the garnishee if required.

The court may assign one or more experts to assist in the execution of the precautionary measures. Owners of renowned trade marks shall be exempted from the submission of a certificate that evidences the registration of the mark.

Article (42)

An attachee may file an action to claim the attachor for compensation within (90) days commencing from the elapse of the period stated in the last para of Art. (41) hereof if no action has been filed against the attachee or from the date of passing the final judgment in the action filed against him. In both cases, the deposit shall only be reimbursed to the attachor after passing the final judgment in the attachee's action or after the elapse of the period prescribed for him without lodging it.

Article (43)*

The competent court may rule the confiscation of the object attached or to be attached later and the deduction of its price from the fines or compensations or disposition thereof in any other way deemed expedient by the court. The court may also order to destroy the illegal marks or, when necessary, to destroy the products, envelopes, packing, tools and any such other objects bearing such marks or illegal data as well as the machines and tools used specifically in the forging operation. It may likewise order all the foregoing even in case of acquittal. The court may further order that the judgment be published in the bulletin or in an Arabic daily at the cost of the judgement debtor.

* Amended by Federal Law No. (8) of 2002

Chapter VII
General and Transitory Provisions

Article (44)

The owners of trade marks registered or used in UAE upon enforcement of the provisions hereof shall apply for their entry in the Ministry's register according to the terms and conditions provided herein within a year from the date of such enforcement.

Those who have not satisfied the conditions prescribed in this Law shall adjust their status within a year from its coming into force. If a trade mark did not fulfil the conditions prescribed therefor within the period stated in the above para it shall be deemed expired by the force of Law.

The first user shall have a priority right in registering his mark within such period. The date of commencement of the first use, its continuity, the prevailing conditions and the occurrence of the mark registration shall all be taken into consideration in order to determine the first use.

Article (45)

The Ministry shall communicate to the Competent Authority in each Emirate, the Federation of Chambers of Commerce and Industry and the Chambers of Commerce and Industry in the State the names of the owners of trade marks registered at the Ministry, their particulars and any change, alteration or striking off made thereon within (30) days from the date of registration, change, alteration or striking off.

Article (46)

The officers competent to control the implementation of the provisions of this Law and its Executive Regulations who shall be determined by a decision issued by the Minister of Justice in agreement with the Minister of Economy and Commerce and

the Competent Authority shall have the capacity of judicial investigation officers. They shall have in this capacity the right of access to the premises whose activity falls within the scope of the provisions hereof, except the places reserved for accommodation, for the purpose of ascertaining the implementation of its provisions and its Executive Regulations and check up the cases of violation. The local authorities in the Emirates shall provide the necessary facilities to such officers to enable them to carry out their task.

Article (47)

A Cabinet resolution shall be issued for fixing the fees to be collected for the procedures undertaken pursuant to the provisions hereof.

Article (48)

Any provision inconsistent with or in violation of the provisions hereof shall be repealed.

Article (49)

The Minister shall issue the necessary regulations and decisions for the implementation of the provisions hereof.

Article (50)

This Law shall be published in the Official Gazette and shall come into force (3) months after its publication.

Zayed Bin Sultan Al Nahyan
UAE President

Issued by us at the Presidential Court
On 28.9.1992