

Cabinet Decision No. 57/2022
On Executive Regulations of the Federal Decree- Law No. 36/2021 on
Trademarks

The Cabinet:

Having considered:

The Constitution.

Federal Law No. 1/1972 on Terms of Reference of the Ministries and Authorities of the Ministers, as amended,

Federal Decree-Law No. 36/2021, on Trademarks,

Pursuant to the presentation of the Minister of Economy and the approval of the Cabinet,

Resolves as follows:

Article 1 - Definitions

The definitions in Federal Decree Law No. 36/2021, as mentioned above, shall apply to the provisions hereof. For other definitions, the following words and phrases shall have the meanings assigned to each of them, unless otherwise required by the context:

- Competent Department: The Trademarks and Intellectual Works Department at the Ministry.
- Trademark: The trademark in the meaning set forth by Article (2 of the Law.
- Registered Agent: The agent registered with the Ministry in the register of trademarks registration agents.
- Law: Federal Decree-Law No. 36/2021, on Trademarks.

Article 2 - Terms, Conditions and Procedures of Registration

1. The trademarks registration application shall be submitted by owner of the trademark, if it has a domicile in the country or by an agent registered into special register of trademarks registration agents.
2. Applications submitted by authorities registered in freezones of the country shall be dealt with as the applications submitted by any person having a domicile in the country.
3. Application shall be submitted for one or several classes, according to international classification of commodities and services.
4. Trademark registration application shall be submitted on the form prepared for this purpose, through electronic services of the competent department.
5. Registration fees shall be several for the application on several classes.

Article 3 - The Data Required for Registration Application

The registration application shall include the following data:

1. Copy of the trademark to be registered.
2. Name, address, nationality and profession of the applicant. If the applicant is an artificial person, its name, address of headquarters and nationality must be mentioned.
3. Name, data and address of the registered agent, so long as the application is submitted by registered registration agent.
4. Accurate description of the trademark to be registered.
5. Commodities or services for which a trademark is to be registered and their class.
6. Any other data determined by the Ministry.

Article 4 - Attachments to Registration Application

The following shall be attached to registration application:

1. Evidentiary documents.
2. Copy of the power of attorney, duly authenticated and translated into Arabic, so long as the application is submitted by the registered agent.
3. Certified translation into Arabic, determining the method of pronunciation, if the trademark to be registered includes one or more terms written in a foreign language.
4. Musical note and mp3 file, if the trademark is related to an audio.
5. Written description of the chemical composition, if the trademark is for an odor.

Article 5 - Examination and deciding of the application

1. The competent department shall examine registration applications and verify that they are not identical or similar to a previously registered trademark and that they do not violate the provisions of decree law and its executive regulations.

The Ministry shall issue its resolution in this regard, whether by acceptance of the application, if it fulfills the terms and procedures stipulated at law and in this resolution or by rejection thereof, if it is not consistent with them or conditioning acceptance on certain conditions or amendments.

2. The competent department shall inform the applicant- through the modern electronic means- of its resolution and shall ask the applicant to fulfill and provide the terms or documents or to make the required amendments for acceptance of the application.
3. If the applicant fails to respond to the resolution of the competent department within 30 days of the date of notification, it shall be considered as waiving the application.
4. If the application is requested, the applicant or its agent shall pay the prescribed publication fees.
5. If a resolution is issued with dismissal of the registration of the trademark or acceptance with conditions or certain amendments, the registration applicant or the registered agent may submit grievance to the grievances committee, within 30 days from the date of notification.

Article 6 - Announcing the Trademark in the Bulletin of the Ministry

1. If the Ministry accepts application for registration of the trademark, it shall, before registration, publish it in the Ministry's bulletin at the expense of the applicant. The bulletin shall show the last date for submission of objection to registration of the trademark.
2. Publication shall be within 30 days from the date of notification of the resolution to accept application.
3. The trademark shall be published in an online bulletin, issued by the Ministry. The publication announcement shall include the following data:
 - a. Number and date of submission of the application.
 - b. Name, address and nationality of the applicant.
 - c. Copy and description of the trademark.
 - d. Name and address of the registered agent (if any).
 - e. List of the commodities or services for which the trademark is to be registered and their class.
 - f. Conditions and requirements (if any).
 - g. Date of priority (if any), its number and the country in which the application is lodged.

Article 7 - Objection to Registration of the Trademark

1. Any concerned person shall have the right to submit a reasoned objection through the online services of the competent department for registration of the trademark within 30 days from the date of publication in the Ministry's bulletin, after payment of the prescribed fees.
2. The competent department shall serve copy of the objection on the applicant within thirty (30) days of the date of its submission.
3. The applicant shall provide the competent department with a written reply to objection, within (30) days from the date of its notification, otherwise, it shall be considered as assigning the application.
4. The competent department shall set a date for hearing statements and submitting evidentiary documents and shall notify the parties, whenever it deems appropriate.
5. The party who desires to attend the statements hearing shall pay the prescribed fee.
6. The competent department shall inform both parties of its reasoned resolution, which shall include any terms and requirements it deems appropriate.
7. A grievance may be submitted against the resolution issued by the competent department to decide objection before the grievance committee within 30 days of the date of the notice.

Article 8 - Waiver or Amendment of Application for Registration of the Trademark

1. The applicant may waive the trademark registration application at any time.
2. Application for re-registration of the trademark shall be treated as a new application.
3. No amendment may be made to the registration application, including amendment of the class, after it is published in the Ministry's bulletin, in any following stage.

Article 9 - Final Acceptance of Registration

1. The resolution to accept registration shall be considered final, after thirty (30) days of the date of publication of the announcement of the trademark in the competent bulletin issued by the Ministry without any objection to its registration or upon issuance of a final judgment on the trademark, by the competent court.

2. The registration applicant shall pay the trademark registration fee, within 30 days of the expiry date of the objection period to registration of the trademark.
3. Registration of the trademark shall be effective from the date of submission of registration application, as shown in the record of the trademarks.
4. If a trademark is registered without giving it or any part of it a special color, its registration shall be considered as including all colors.
5. The competent department shall, sua sponte or upon request of the competent person, correct any material error in the trademark.

Article 10 - Amendment to Trademark and Data of its Owner

1. The owner of the trademark shall, whenever it desires, make any amendment or addition to its registered trademark, in a manner that does not affect it substantially by submission of amendment application on the form designed for this purpose, to the competent department. This application shall be subject to the same procedures of the original registration applications, with regard to acceptance and rejection. This application shall be published in the relevant bulletin and shall be subject to the procedures of grievance and objection, according to the conditions and rules related to original registration requests.
2. Owner of the registered trademark may request amendments of the following data in the record, pursuant to the form designed for this purpose, after payment of the prescribed fees:
 - a. Name, title, address, profession or nationality of the trademark owner. In case of artificial persons, any change to the name or address shall be recorded.
 - b. Addition or amendment of the commodities and services for which the trademark is registered.
 - c. Change of the attorney, his name or address.
3. The competent department shall make an announcement, including the required amendment and shall issue it in the bulletin that would be issued by the Ministry, after payment of the prescribed fees. This shall be stated in the trademarks register, in order to provide the applicant with an updated certificate.

Article 11 - Renewal of the Protection Period

1. Owner of the trademark who desires to renew the protection period must provide an application on the form prepared for this purpose, to the competent department within the last year of the protection period and for 6 months, following payment of the prescribed fees.
2. The competent department shall publish announcement of the renewal in the bulletin of the Ministry, after payment of the prescribed fees. This shall be stated in the trademarks register.
3. Announcement of renewal shall include the following data:
 - a. Registration number of the trademark.
 - b. Name, address and nationality of the trademark owner.

Article 12 - Temporary Protection of the Trademarks used in Exhibitions

1. Owner of the trademark which is put on commodities exhibited or used on services in official international exhibitions and officially recognized exhibitions, inside the country, shall have the right to request temporary protection of the trademark during the exhibition, one month at least before opening of the exhibition, pursuant to the form prepared for this purpose, after payment of the prescribed fee.
2. The trademark referred to in clause (1) of this Article shall have temporary legal trademark within the exhibition period.
3. The temporary protection shall be removed once the exhibition period end and upon the desire of owner of the trademark referred to in this Article.

Article 13 - Submission of Application for Temporary Protection of the Trademarks used in Exhibitions

1. Applications for the temporary protection of the Trademarks used in Exhibitions shall be registered in a special register, called: (temporary protection register), including the following data:
 - a. Temporary protection number, date and expiry period.
 - b. Name of the exhibitor or of the trademark owner.
 - c. Photo and description of the trademark.
 - d. Name of the exhibition, date of its official opening and duration.
 - e. Statement of the commodities or services which trademark is to be protected and its class.
2. The Ministry shall issue a certificate of temporary protection of the trademark used in exhibitions.

Article 14 - Deregistration of the Trademark

1. The department shall, on its own accord or upon request of the concerned person, deregister the trademark, in the following cases:
 - a. If the trademark is not registered, according to Article (21) of the Law.
 - b. If it is shown that the trademark is registered in violation of the provisions of the law and of this resolution.
 - c. Upon the request of owner of the trademarks, pursuant to the provisions of Article (24), clause (1) of the Law.
 - d. Upon a final judgment, delivered by the competent court.
 - e. Upon the request of the concerned persons, if it is shown that the trademark was registered in bad intent or illegally.
2. Owner of the registered trademark who desires to deregister it for all commodities or services or some of them shall apply to the competent department on the form designed for this purpose, after payment of the prescribed fees. If the register shows that a license has been previously issued for the use of the trademark, deregistration may only be made upon the written approval of the licensee, unless the licensing contract specifies for express approval of the licensee of waiver of the license.
3. The deregistration application shall be submitted to the competent department through online services, after payment of the prescribed fees, provided that the competent department shall decide the deregistration application within 90 days of the date of the submission thereof.
4. The competent department may, before deregistration of the trademark, notify owner of the trademark of the cause of deregistration and hear its statements and determine its defenses.
5. The competent department shall state in the trademarks register that it was deregistered and this shall be announced in the Ministry's bulletin, provided that the announcement shall include the following data:
 - a. Photo and description of the trademark.
 - b. Number of the registered trademark.
 - c. Name and nationality of the trademark owner.
 - d. Cause and date of deregistration.
6. The publication fees of deregistration shall be paid upon the request of the trademark owner.

Article 15 - Trademark Ownership Transfer

1. The trademark ownership is transferred upon an application to the competent department, from the person to whom the ownership is transferred or from his attorney, accompanied by the supporting documents, which are duly authenticated and certified and translated into Arabic, after payment of the prescribed fees on the form prepared for this purpose.
2. The ownership of the trademark shall be transferred by a sale, transfer, merger contract or upon a court resolution. The contract or resolution shall include the following data:
 - a. Number of the registered trademark.
 - b. Name of the previous trademark owner.
 - c. Name, title, tradename (if any), nationality and address of the trademark transferee.
 - d. Ownership transferer date and the occurrence by which the ownership was transferee.
3. If the application is submitted by an agent, its name, title and address shall be mentioned and the competent department shall state in the register that the trademark is transferred, showing the name of the new owner, its address and the date thereof and providing the applicant with evidence thereof.
4. The competent department shall publish an announcement that the trademark ownership is transferred, including the following data:
 - a. Number and date of registration of the trademark.
 - b. Photo and description of the trademark.
 - c. Name of the previous owner of the trademark.
 - d. Name, nationality and address of ownership transferor.
5. The competent department shall publish the announcement in the Ministry's bulletin, after payment of the prescribed fees.
6. Without prejudice to Article (6) of the Law, the natural heirs of the trademark owner shall have the right to transfer ownership in their names, jointly or to any of them, by a transfer document, signed by the person entitled to the trademark.
7. Transfer of the trademark registration application includes the relevant data, including the data of the transferee and any documents determined by the competent department, in this regard.

Article 16 - Mortgage of the Trademark

1. The mortgage of the trademark shall be stated in the register, pursuant to the same procedures and conditions related to transfer of ownership of the trademark. The publicity of mortgage shall include the same data mentioned in Article 16 of this resolution, after payment of the prescribed fees.
2. The mortgage shall be redeemed, upon an application to the competent department from owner of the trademark, accompanied by the required documents in this regard, justifying redemption provided that those documents shall be duly authenticated and certified and translated into Arabic, after payment of the prescribed fees.
3. The competent department shall announce the mortgage or redemption in the Ministry's bulletin, after payment of the prescribed fees. The mortgage or redemption shall be stated in the register and the applicant shall be provided with evidence thereof.

Article 17 - Attachment of the Trademark

Attachment of the registered trademark upon court order shall be included in the register and the attachment may only be removed upon conclusive court judgment.

Article 18 - Licensing the use of Trademark

1. If the trademark owner licenses any natural or artificial person to use the trademark for all or some of the commodities or the services registered, the licensing contract must be written, duly authenticated and certified and translated, if the original copy is written in a language other than Arabic. It is not permissible in all cases that the licensing period exceeds the period prescribed for protection of the trademark.
2. Application for licensing the use of the trademark shall be submitted to the competent department, by owner of the trademark, the licensee or the registered agent of each of them, pursuant to the form designed for this purpose, after payment of the prescribed fees, which includes the following:
 - a. Number of the registered trademark.
 - b. Name and nationality of the trademark owner.
 - c. Name, address, residence and nationality of the licensee.
 - d. Licensed commodities and services.
 - e. Licensing commencement date and expiry date.
 - f. Geographical scope of licensing, if any.
 - g. Duly translated, authenticated and certified licensing contract.
 - h. Any documents or papers required by the competent department.
3. The competent department shall include in the register the license to use the trademark and shall provide the applicant with evidence thereof. Furthermore, the competent department shall publish the announcement in the Ministry's bulletin, after payment of the prescribed fees, provided that the announcement shall include the following data:
 - a. Photo and description of the trademark.
 - b. Number and date of registration of the trademark.
 - c. Name, address and nationality of the trademark owner.
 - d. Name, address and nationality of the licensee.
 - e. Statement of the commodities or the services which use is licensed and their class.
 - f. Commencement and expiry dates of licensing.
 - g. Geographical scope of licensing (if any)

Article 19 - Deregistration of the License

1. The license shall be deregistered upon an application to the competent department, submitted by owner of the trademark, the licensee or the registered agent of any of them, accompanied by evidence of expiry or termination of the license, after payment of the prescribed fees.
2. The competent department shall inform the other party with the deregistration application in writing and the other party shall have the right of objection, before Grievance Committee, within 30 days of the date on which it is informed of the deregistration request, lodging copy of objection and evidence of its submission with Grievance Committee through online services to the competent department. The deregistration shall be stopped pending the parties' agreement or issuance of a resolution by the Grievance Committee to decide objection.

3. If there is no objection submitted to deregistration of the license or if there is no final resolution issued by the Grievance Committee to register the license, the competent department shall publish the deregistration in the Ministry's bulletin, after payment of the prescribed fees. The deregistration shall be stated in the register and the applicant shall obtain evidence thereon.

Group Trademarks, Monitoring Trademarks and Trademarks of Public Benefit Associations and Professional Institutions

Article 20 - Registration of Group Trademarks

Subject to Articles (2), (3) and (4) hereof, the group trademarks registration application shall be accompanied by the following requirements:

1. Statement that it is related to group trademark.
2. Copy of Articles of association of the applicant, with amendments, provided that it shall include:
 - a. Statement of the class of the people who have the right to use the trademark and their relationship with the applicant.
 - b. Copy of requirements for use of the group trademark of commodities and services.
 - c. A resolution that the applicant takes or will take decisive and sufficient monitoring procedures for the use of the trademark by its affiliate members.
 - d. How the members qualify for membership in such entity.
3. All documents shall be duly authenticated and certified and translated into Arabic.
4. The group trademarks shall be subject to the same procedures of registration, publication and deregistration set forth herein.

Article 21 - Registration of the Trademarks for Monitoring or Inspection

1. Subject to Articles (2), (3) and (4) hereof, the application for registration of the trademarks for monitoring or inspection shall be accompanied with the following requirements:
 - a. Statement that the registration application is related to monitoring or inspection trademark.
 - b. Copy of Articles of association of the applicant entity, with amendments that would have been included, provided that it shall include:
 - 1) An acknowledgement that the trademark will be used by a party or parties other than the applicant and that the applicant would not exercise marketing works or produce any commodities or services on which the abovementioned trademark would be used and will not exercise any discrimination policies which would prevent the use of the trademark by third parties that fulfill the specifications set by the owner.
 - 2) An acknowledgement that the group trademark certifies the quality, types or benefits of the commodities or services and that they do not refer to the source of the commodities or services.
 - c. Documents showing the specifications and standards applied by the applicant entity in order to control the use of the trademark, showing that the said applicant uses an approved program for quality assurance.
 - d. A certificate showing the benefits of the certified commodities or services or those which certification is required.
 - e. All documents must be duly certified and authenticated and translated into Arabic.
2. Those trademarks shall be subject to the procedures or registration, publication and deregistration of the trademarks, set forth herein.

Article 22 - Registration of the Trademark for Non- Commercial Purposes

If application is submitted for registration of trademarks for non- commercial purposes, this shall be stated in the application, with attachment of the Articles of association of the public benefit association or the professional institution of the applicant. These shall be subject to the same procedures for registration, publication and deregistration of the trademark shown herein.

Article 23 - Geographical Indicators

1. The registration application of the geographical indicator shall be submitted by one or more artificial persons on the form prepared for this purpose by the applicant or its registered agent in the register of agents.
2. Subject to Article (2), (3) and (4) hereof, the applicant for geographic indicator shall include the following data:
 - a. Name and legal character of the artificial applicant and the purpose of its construction.
 - b. Nationality, residence of the applicant and the type of products.

- c. Photo and description of the geographic indicator.
 - d. Data of the geographic indicator, showing advantages, characteristics and features of the geographic indicator, related to the geographic area, as detailed by a certified entity.
 - e. Copy of registration certificate of the geographic indicator in the country of origin, if the application is for a geographic indicator from outside the country, duly certified and translated.
 - f. Power of attorney, if the application is submitted by attorney of the applicant, duly certified and translated.
3. The ministry's resolutions, issued with regard to acceptance, rejection or amendment of the register after registration, with regard to the applications for registration of the geographic indicators shall be subject to the provisions related to grievance and appeal as shown in Articles (12) and (13) of the Law and the provisions related to publication and objection, stated in Articles (15) and (16) of the Law.

Article 24 - Custom Clearance

1. The concerned person or his representative shall have the right- if he has justified reasons to believe that there is a possibility of importing of counterfeited or imitated commodities, bearing a trademark similar to his registered trademark in a manner that would lead to confusion of the public- to apply in writing to the custom authority to prevent custom clearance of those commodities and to prevent their trading, provided that the application shall be supported with the required data and information that prove infringement of the applicant's trademark.
2. The custom authority concerned with custom clearance shall decide the application and inform the applicant, in writing, of its resolution within 7 working days from the date on which the application is submitted. The resolution shall apply if the application is accepted for one year, commencing from the date of its submission or to the period remaining of the trademark protection period, whichever is lesser, unless the applicant requests a shorter period.
3. The custom authority may instruct the applicant to provide appropriate warranty or equivalent guarantee, sufficient to protect the defendant from misuse of the right to apply for prevention of custom clearance.
4. Without prejudice to the provisions of the above clauses of this Article, the custom authority may, sua sponte, issue a resolution to prevent custom clearance of the imported or transit commodities or those prepared for export, when they reach the custom area subject to its power, provided that it is provided with sufficient evidence that those commodities are imitated or are, illegal, bearing a trademark similar to a registered one which would lead to confusion of the public.
5. The competent authority shall, once it decides to prevent the custom clearance of commodities that reached the custom area subject to its power:
 - a. Serve a notice on the importer of the commodities and the concerned person with the resolution issued to prevent the custom clearance, once it is issued.
 - b. Inform the concerned person, upon his written request, of the names and addresses of the commodities sender, importer and receiver and their quantities.
 - c. Allowing the concerned persons to inspect the commodities according to the custom procedures followed in this regard.
6. The concerned person shall have the right to file a case of the original dispute to the competent court and inform the competent authority within no more than (10) working days of the date on which he is informed of the prevention of custom clearance of these commodities, otherwise, the resolution shall be considered as null and void, unless such authority or the competent court decides to extend such period at its discretion, for no more than another (10) working days.
7. With exception of the cases estimated by the court, if it is proven to the court that the commodities which custom release is prevented are imitated, counterfeited or illegally bear a trademark similar to a registered trademark in a manner that leads to confusion of the public, a judgment must be delivered to damage those commodities, at the expense of their importer or to get rid of them outside the commercial channels, if the damage would cause unacceptable harm to public health or to the environment.
8. The commodities may not be cleared to commercial channels or allowed to be exported for the mere removal of the trademark that was illegally used.
9. With regard to the custom clearance and the inspection, the conditions and procedures applicable by the custom authorities shall be followed.

Article 25 - International Registration Applications

The international registration applications submitted according to Madrid Treaty Protocol on International Registration of the Trademarks shall be subject to executive regulations of the protocol, as amended.

Article 26 - Repeals

Any provision contradicting the provisions hereof shall be repealed.

Article 27 - Publication and Enforcement of the Resolution

This resolution shall be published in the Official Gazette and shall come into force from the date following its publication.

We issued this resolution on: 07/ Duelq'da/ 1443 AH

Corresponding to 07/ June 2022 G

**The original copy is signed by
His Highness Sheikh/ Muhammad bin Rashid Al Maktoum
The Prime Minister**