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Dubai - June 15th, 2021

To all the Members of the AIPPI UAE Chapter

Subject: 4th circular- Bi-annual update- major developments and interesting updates in IP sector

Dear all,

We hope everyone is doing well and keeping safe. We also hope that summer brings a great time to you and your families.

During our last monthly meeting at the Communications Committee, we decided to dedicate our circular to update the members with key developments that relate to the IP industry and sector in the United Arab Emirates. We also intend to cover each topic in a standalone circular in the coming months and we welcome any participation from members who would like to give their thoughts and feedback on one or more topics. Please do feel free to reach out to the Communications Committee members in case you would like to receive more information on how you can contribute to such topics.

In nutshell, we identified the following recent updates that worth to be brought to everyone's attention:

1. The USA released its USTR Special 301 report removing the UAE from the watch list.
2. The UAE Cabinet approves accession to the Madrid Protocol system.
3. The UAE Trademark Office approves late filing of Power of Attorney "PoA". Undertaking by attorneys/agents is no longer needed/acceptable.

4. GCC Patent unified system. Updates on registry function.
5. UAE reform of Intellectual property and trademark laws. Amendments are being discussed.
6. UAE Trademark Office decides to release Trademark Gazette bi-monthly starting from June 15th, 2021.

We set out below a summary of the abovementioned updates as we plan, and aim, to have more explanations on each topic in the next circulars that will be published by the Communications Committee.

- **The USA released its USTR Special 301 report removing the UAE from the watch list:**

Everyone celebrated this excellent achievement. The country has been recognized for its significant progress in Intellectual Property Protection and Enforcement in this year's USTR 2021 Special 301 Report. The UAE is no longer a jurisdiction of concern according to the report as the removal of country from this list reflects significant practical improvements within the IP practice in the UAE.

This has come as encouraging news to the UAE and particularly to Customs Departments, who received special mention in the report for their efforts to address and rectify any preexisting concerns for the IP owners. The Customs Departments have undertaken several initiatives over the past year including a variety of workshops and presentations which trained officials on how to identify counterfeit goods. They have also increased the level of transparency across the departments, publishing IP enforcement procedures and annual IP enforcement statistics.

It was noticed that the USTR report does call for the UAE Ministry of Economy to review its practices and develop the laws surrounding Collective Copyright Management, an issue which has been outstanding for a period of nearly two decades now.

- **The UAE Cabinet approves accession to the Madrid Protocol system:**

The UAE has recently announced its acceptance to join the Madrid Protocol for trademark registration system and they plan to complete the joining by the end of 2021/early 2022. This accession has been discussed throughout the years and there were many different views on the cons and pros to enter the system.

As the UAE continues to improve its Intellectual Property practices, the authorities decided to join the Madrid Protocol as being an optional international trademark administrative system that permits a unitary filing with legal effect in over 120 different member countries. This should reduce costs and the administrative burden for applicants and should enable them to broaden protection of their rights throughout the world, as per their designated countries. At present, only Bahrain and Oman are part of the Madrid Protocol in the GCC.

In order to implement the Madrid Protocol, the UAE Trademark Office will need to submit its admission papers to the management of Madrid System and also issue implementing regulations and clarification on how this will work within the realms of the existing trademark regulations in UAE. We await further update in this regard in particular concerning the recognition and application of the Arabic language within the Madrid system.

- **The UAE Trademark Office approves late filing of Power of Attorney “PoA”. Undertaking by attorneys/agents is no longer required nor acceptable.**

Due to the COVID-19 pandemic, the UAE Trademark Office approved in April 2021 the filing of applications based on an undertaking filed by the agent/attorney to submit a notarized and legalized POA once the formalities are completed. There was a time frame of 30 days mentioned in a circular issued by the UAE Trademark Office, but the office, in practice, seemed more flexible with that time frame. Again, and as the UAE Ministry of Economy aims to help brand owners, IP attorneys, and agents and to facilitate their services before the UAE Trademark Office, the late submission of the notarized and legalized POA to the Trademark Office is intended as a simple process that does not incur any additional official fees or fines.

Following this notification, the UAE Trademark Office issued a further update that IP attorneys/agents or legal representatives, were required to submit a letter of consent alongside the trademark application from the Applicant. This letter of consent should attest to the fact that while the agent in question had not submitted the notarized and legalized PoA initially this will be done once the notarized and legalized POA has been received in the UAE. However, and in a recent circular by the UAE TMO on June 2nd, 2021, the UAE Trademark Office circulated to IP attorneys and agents that a simply signed POA by the applicant **will be required** at the time of filing of applications and that the **undertaking to submit the POA** is no longer sufficient.

- **GCC Patent unified system. Updates on registry function:**

Earlier in January 2021, the Communications Committee released circular 1 for 2021 and briefed the members on the GCC Supreme Council’s decision after its annual meeting. The decision was to discontinue the GCC Patent unitary system, with the announcement that the GCC Patent Office will no longer accept any new patent applications after 6 January 2021.

This raised a lot of questions by members and clients, such as (i) what would happen to existing patents (ii) how the existing GCC patents would be viewed and (iii) what would happen to the GCC patent office (“GGCPO”).

Whilst many of those questions remain unanswered by officials for some time, we recently received some clarity on the above questions from the publication of GCC Patent regulation in the Official Gazette No. 22. In this Official Gazette publication, we identified the following developments:

- a. Articles 1, 4, 9, 17, 18, 19, 20, 21, 25, 28, 29, 30, 32, and 33 have been replaced in the GCC Patent Regulation.
- b. It is confirmed that the GGCPO no longer functions as the unitary patent filing/issuance office for the GCC.

- c. All granted GCC patents will remain valid and enforceable.
- d. The Economic Cooperation Council will formulate a procedure for dealing with all pending patent applications, filed prior to 6 January 2021.
- e. The GCCPO will remain operational and act as an administrative body to facilitate the filing of patents in each of the GCC territories, this will require approval from each of the national offices (in the same way that filing a national application would).
- f. Any patent issued by the GCCPO will be granted on behalf of a GCC member state, accordingly the validity of such patents will be limited to that member state and will not cover the entire GCC region.
- g. An appellate court has been established, the 'Judicial Committee of the GCC Council', to hear appeals against the decisions of Committee.
- h. The Implementing regulations of the GCC Patent Law are yet to be issued.

- **UAE reform of Intellectual property and trademark laws. Amendments are being discussed:**

The process of reforming the IP laws and regulations in the UAE started by the legislator since 2018 and there has been tremendous discussions, exchange of opinions, reviews and talks about what the amendments or new laws should include. Whilst it is still unclear when the new set of laws will be approved and published, we expect many improvements to result from this reform. One of the suggestions that was made is compile all IP laws under one umbrella of federal law and combine all types of codes under unified federal law. We do not know whether this will be approved or the approach that legislator will adopt but we do expect the amendments or new laws will cover industrial property law, trademark law and copyright law.

- **UAE Trademark Office decides to release Trademark Gazette bi-monthly starting from June 15th, 2021:**

In the interim, the UAE Trademark Office continues to implement improvements of its processes and practices in anticipation of the proposed new laws. The recent developments in the POA filing requirements and in the efforts to join Madrid set out above are examples. We are also noticing improvements in the speed of examining trademark applications and in providing updates via SMSs and emails to the applicants and/or their attorneys.

A case in point is a circular issued on June 15th, 2021, in which the UAE trademark office is changing the Trademarks Journal publication schedule to biweekly instead of monthly. This should expedite the trademark registration process and further benefit the applicants from the prompt publication of their accepted applications.

We aim to update the members on recent developments as they happen in concise circulars issued by the Communication Committee.

On behalf of Communications Committee

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