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To all the Members of the AIPPI - UAE National Group

Subject: 6th Circular/ 2022

Dear all,

We trust you are well.

- **Regulations update: Cabinet Decision No. 57 of 2022 in relation to the implementing regulations for the UAE Federal Decree-Law No 36 of 2021 (known as the UAE Trademark Law)**

Due to the importance of the trademark law's implementing regulations and its impact on the profession, we have prepared this circular to summarize the key changes and amendments.

We note that the new developments in the implementing regulations are categorized into three main areas that relate to: i) procedural, ii) substantive, and iii) enforcement. In this circular, we will highlight some of the key procedural changes when prosecuting and applying for trademarks in the UAE.

Procedural features:

- **Multi class applications:** The trademark Law provides the option to file an application for one class or multi classes in the same application. While the same registration fee will apply for each class in a multi-class application, we are awaiting for an official announcement on whether the same fees will be payable for the filing and publication stages.

- **Electronic Application:** Trademark registration application is now officially recognized and can be submitted on the form approved by the Ministry of Economy for this purpose, through electronic services of the competent department. While electronic filing of applications have been implemented for a number of years the new regulations now officially endorse this mechanism.
- **Free Zones company registrations:** Applications submitted by authorities registered in one of the UAE free zones shall be dealt with in the same manner as applications submitted by a person having a domicile in the country. This provides official clarity on questions of standing and requirements of trademark holders incorporated in one of the UAE free zones.
- **Publication:** Previously, the UAE trademark Office required accepted trademark applications to be published in 2 daily newspapers as well as in the Trademark Gazette. In the new law, only publication in the Trademark Gazette is now required.
- **Individuals:** individuals are now exempted from providing a trade license with the trademark application.
- **Trademark Renewals:** the renewal grace period for trademarks has now been extended to 6 months with a late renewal fine.

The communication committee urges AIPPI UAE Group members to contribute in the next circulars and to provide more commentary on the new regulations.

- **Main differences between Geographical Indications (GI) and Trademarks:**

As we are all aware, a trademark is a tool to distinguish the products or services of one enterprise from those of others and the same should not be descriptive or deceptive. However, when we look at a GI, it is by nature and definition is considered a descriptive term because a geographic name indicates the geographical origin of product. In many jurisdictions, a GI will not be registered as a trademark for a product although the goods are produced exclusively in specific geographical areas of the GI. It is always argued that a geographic name is considered to be insufficiently distinctive and hence cannot be protected or registered.

However, the main advantage of geographical indications as a means of protection for informal innovation is the ‘relative impersonality’ of the right. In other words, the protected subject-matter is related to the product itself (its attribute or definition) and is therefore not dependent on a specific right holder. Appellation of origin and GIs are tools to satisfy both consumers and producers. They are competition tools. Unlike a trademark, which has its main aim of satisfying its owner by ensuring him or her an exclusive right, appellations of origin and GIs are common property of the producers in the specific designated area and have many functions, of which the quality function is just one. Contrarily, trademarks have a mere distinctive function, which allows the consumers to distinguish between the

goods and services of one enterprise and those of a different one¹. Hence, while other IPRs are necessarily attached to a single and clearly distinguishable right holder, geographical indications are not.²

GIs have also an identification function. Unlike trademarks, which distinguish the goods of one enterprise from those of another one, GIs identify the location from which the goods originated.

As trademarks and GIs give information about the source and reputation of goods, they are normally very different from one another: the trademark gives information about the enterprise that is responsible for the goods.

The new trademark regulations in the UAE recognize GIs and included some clear provisions to explain the scope of protection, requirements among other points, for example:

Article (23/1) stated that “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.”

Article (23/2/d) mentioned a special requirement for GIs registration as follows “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.”

We will continue to monitor how the UAE Trademark Office and/or local courts will handle registration and/or cases relate to GIs going forward.

Kind regards,

On behalf of the Communication Committee

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¹ A.F. RIBEIRO DE ALMEIDA, *Key Differences Between Trade Marks And Geographical Indications* in EIPR 2008, at 6

² R. SILVA REPETTO – M. CAVALCANTI, *Multilateral Trade Negotiations on Agriculture: A Resource Manual /TRIPS Agreement*, Module 3: Provision of the TRIPs Agreement Relevant to Agriculture (Part One), Food and Agriculture Organization (FAO), Rome, 2000, Chapter 3.4.1