

TRADEMARK REGISTRATION IN THE UAE

A brand is an invaluable asset. Companies usually invest a lot of time and money in the design, development and maintenance of a brand. If an entrepreneur uses a logo for his goods and services in the UAE, this logo should be registered as a trademark in the UAE or internationally. Otherwise, an entrepreneur has no means of preventing the competition from using the same or a similar brand. If the competitor registers the trademark first, he can even prohibit the entrepreneur from using the trademark and take legal action against him. The non-registration of a trademark can thus make business activity more difficult or even impossible.

There are currently more than 557,000 small and medium-sized enterprises (SMEs) in the UAE. Many of these SMEs differ only slightly from each other and offer similar goods and services. A brand can help to differentiate one's own enterprise and its own goods and services from those of the competitor. In addition, brands can create a recognition value and thus help to distinguish themselves clearly from the competitor. Furthermore, a registered trademark offers an exclusive right of use. The trademark owner is permitted to take legal action against the unauthorized use of the trademark by a competitor.

Strohal Legal Consultants has been registered as a UAE Trademark Agent with the Ministry of Economy since July 2015 and since then has been supporting its clients in trademark registration.

What is a trademark?

The UAE Federal Decree-Law No. 36 of 2021 on Trademarks protects registered trademarks in the UAE and safeguards the interests of businesses and consumers. Under Article 2, a trademark is defined as everything that takes a distinctive shape of names, words, signatures, letters, symbols, numbers, addresses, seals, drawings, pictures, engravings, packaging, graphic elements, forms, color(s) or a combination thereof, a sign or a group of signs, including three-dimensional marks, hologram marks, or any other mark used or intended to be used to distinguish the goods or services of a company from the goods or services of other companies, or to indicate the performance of a service, or to conduct monitoring or examination of goods or services. Even a distinctive sound or smell may be considered as a trademark.

Why is trademark registration recommended?

A registered trademark provides distinctiveness and protection against confusion between the goods and services of a company and those of its competitor. It is regarded as a unique selling point and can strongly differentiate and emphasize a company from its competitors.

In addition, the trademark owner can exclude others from using the same or similar trademark for similar products and services. The trademark owner can take legal action against infringements of the law and infringements resulting from the unauthorized use of the trademark.

Well-known and widely used trademarks can achieve a high value and strengthen the company. Apple as the most valuable brand which is virtually known in the entire world has a brand value of almost USD 1,000 billion (or USD 1,000,000,000,000 ...).

The licensing of brand rights to third parties can often generate significant assets for the company and the sale of well-known brands can generate high revenues.

How is a trademark registered in the UAE?

The UAE is among the 114 members, covering 130 countries that apply the Madrid Union and allow international trademark registration for different countries through WIPO (World Intellectual Property Organization). For this reason, trademark applications for the UAE can be filed locally, i.e. in the UAE itself as well as internationally for select member states.

The Ministry of Economy is the responsible authority for trademark applications in the UAE. However, trademark registrations in the UAE cannot be set up by the trademark owner himself, but only by a Registered Agent for Trademarks. This agent must be licensed by the Ministry of Economy and hold a corresponding license. Strohal Legal Consultants have been registered as a UAE Trademark Agent with the Ministry of Economy since July 2015.

For a successful trademark registration, an application form must be completed in Arabic. In addition, all necessary documents must be translated into Arabic and submitted. If the authority approves the trademark application, it will be published in the Trademark Journal. Subsequently, there is a 30-day period for filing an opposition against the trademark application. If no opposition is filed, a registration certificate will be sent. The trademark is thus protected in all seven Emirates of the UAE.

Which documents are required for a national trademark registration?

In the UAE, trademark applications can only be filed by an agent registered with the Ministry of Economy. The following documents are required for a successful trademark application:

- Power of Attorney for the Registered Agent;
- Passport copy of the trademark owner;
- Copy of trade license, MOA and COI if the trademark owner is a company;
- List of goods and services for which the marks are used; and
- Image of the brand.

The average duration of the trademark application is at least 5 to 6 months.

How much does trademark registration cost?

While WIPO allows up to 3 classes to be applied for in one trademark application, currently in the UAE, a separate application must be filed for each class.

Official expenses per Class in UAE
 Initial Search - 350 AED
 Application Fees - 750 AED
 Publication in the UAE Gazette - 750 AED
 Final registration fees - 5,000 AED
 Total government fees - 6,850 AED

In addition to the fees of the Ministry of Economy the fees of the Registered Agent and other cash expenses for e.g. translations, etc have to be paid. A trademark application in the UAE is therefore at first glance not exactly a bargain, however it can secure great competitive advantages. In addition, a timely trademark application can avoid possible future damages caused by similar trademark applications from competitors and the associated prohibitions of use and court disputes.

How long is a trademark protected?

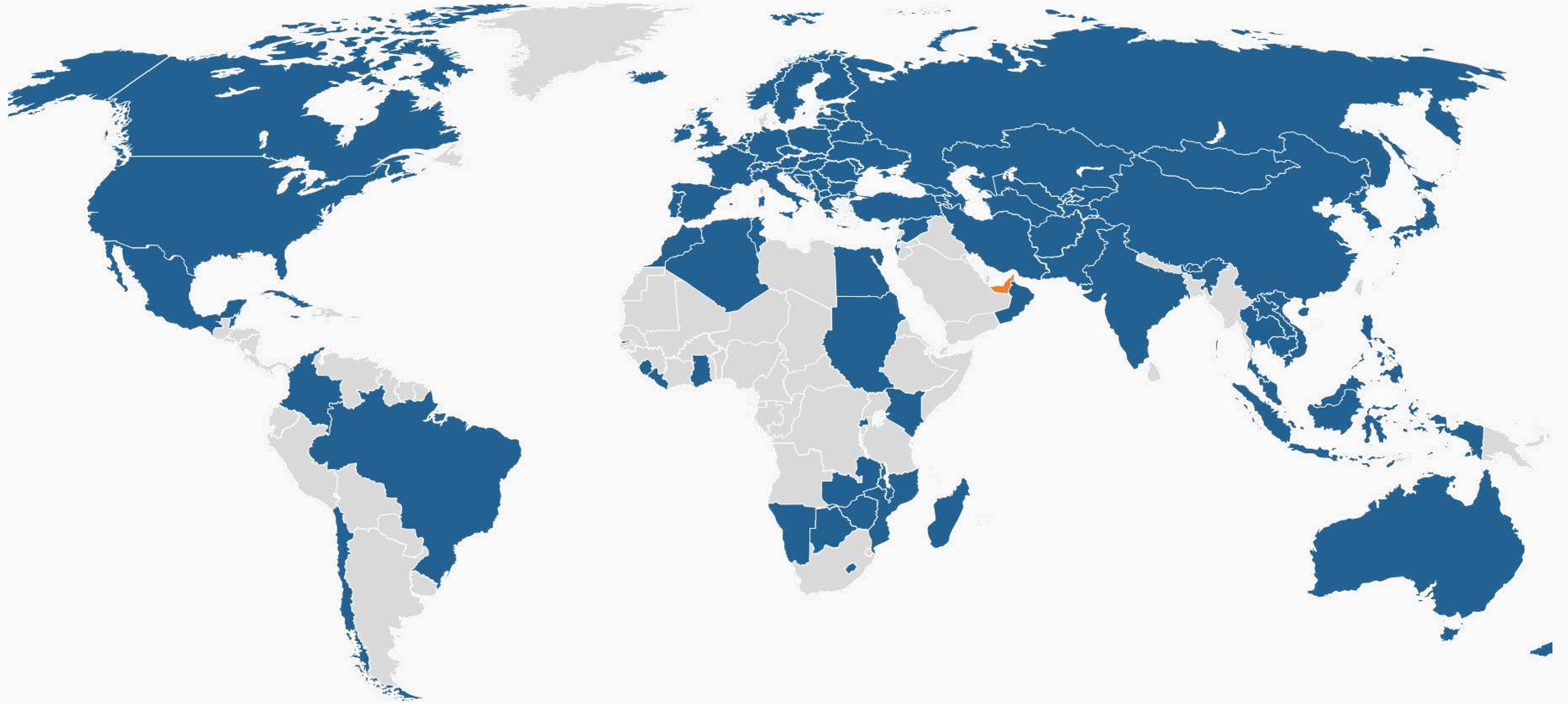
The trademark registration is valid for 10 years and the protective rights extend to all seven Emirates of the UAE. The term of protection can be extended as often as desired by paying the renewal fee for a further 10 years. Currently the renewal fee of the Ministry of Economy is AED 5,750.

If you have any questions regarding trademark law, please contact us at office@slglaw.cc or Tel: +971 7 233 8927..



How is an international trademark application filed?

Since 28 December 2021, the Protocol to the Madrid Agreement concerning the International Registration of Marks (Madrid Protocol) has been in force in the UAE, allowing international trademark applications to be filed and trademark protection to be obtained in all or any of the current 114 members, covering 130 countries. An international trademark makes it possible to protect a trademark and thus the core values of a company easily and cost-effectively far beyond the borders of the UAE.



The basis of the international trademark is a local trademark application or registration. This determines the scope of the international trademark. The Ministry of Economy receives the application and forwards it to the World Intellectual Property Organization (WIPO). The application must be filed in English, French or Spanish. A translation into the national language of all or the requested members is therefore not required. The costs depend on the number of countries and the number of classes according to the Nice Classification in or for which the trademark is to be protected.

The mark is entered into the International Register and published in the WIPO Gazette of International Marks. Then the national trademark offices of all or the selected members receive the details of the application and conduct their own substantive examination of the application under their respective national laws and procedures within the 12- or 18-month period.

In effect, the international mark does not constitute a single mark with international validity. Instead, it is an application for a trademark in the chosen members that exists independently of the trademarks of the other members. An exception is that the original national mark must remain valid for the first five (5) years in order to facilitate the validity of the subsequently registered international trademarks. Due to factual or legal circumstances, such as an already existing trademark registration in the requested member, a successful application in any member state does not indicate an automatically successful application in another.

The international trademark is valid for 10 years after registration and can be renewed.

Strohal Legal Group is an international business law firm focusing on the Gulf region (GCC) and Southeast Asia (ASEAN) advising clients on local and cross-border M&A transactions and corporate, business, and labour law matters, company establishments, energy & climate law as well as tax law matters. Through our country desks and partner firms in Austria, the Ukraine, and Russia, the firm is also well connected in Europe.

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