

Cabinet Resolution No. (57) of 2022 Concerning the Executive Regulations of Federal Decree by Law No. (36) of 2021 Concerning Trademarks

The Cabinet:

- Having reviewed the Constitution; and
- Federal Law No. (1) of 1972, Concerning the Competences of Ministries and Capacities of Ministers, and its amendments thereof; and
- Federal Decree by Law No. (36) of 2021, Concerning Trademarks; and
- Based upon the proposal submitted by the Minister of Economy, and the Cabinet's approval,

Resolved:

Article (1)

Definitions

The definitions stipulated in Federal Decree by Law No. (36) of 2021 aforementioned shall be applicable to the provisions of this resolution, and in exception for that the following terms and phrases shall have the meaning assigned to each, unless the context requires otherwise:

- Competent Department** : The Department of Trademarks and Intellectual Classifications at the Ministry.
- Mark** : The trademark in the meaning designated in Article (2) of the Law.
- Registered Agent** : The agent registered at the Ministry in the Register of Trademarks Registration Agents.
- Law** : Federal Decree by Law No. (36) of 2021 concerning trademarks.

Article (2)

Registration Conditions, Controls and Procedures

1. The application for the trademark's registration shall be submitted by the trademark's owner in the event he resides in the State or by an agent registered in the special register of trademarks registration agents.
2. The applications submitted from entities registered in free zones inside the State shall be treated similarly to the applications submitted by a resident in the State.
3. The application may be submitted for one or more categories in accordance with the international classification of commodities and services.
4. The application for the trademark registration shall be submitted as per the designed template through the competent department's e-services.
5. The fees shall be multiple in the event the application was for multiple categories.

Article (3)

Data Necessary for the Registration Application

The application for registration shall include the following data:

1. A picture of the mark to be registered.
2. The applicant's name, address, nationality and profession (if applicable) – and in the event the applicant is a legal person, its name, headquarters address and nationality shall be mentioned.
3. The registration agent's name and data and address whenever the application is submitted via a registered registration agent.
4. An accurate description of the mark to be registered.
5. The Commodities or services for which the mark is to be registered and its category.
6. Any other data determined by the Ministry.

Article (4)

Attachments to the Application for Registration

The following shall be attached to the application for registration:

1. Identification documents.

2. A copy of a duly notarized Power of Attorney and translated into Arabic in the event the application was submitted by a registered agent.
3. An approved translation into Arabic identifying the pronunciation in the event the mark to be registered contains one or more pronunciation in a foreign language.
4. The musical note and its relevant mp3 file in the event the mark is a sound.
5. A written description of the chemical formula in the event the mark is an odor.

Article (5)

Examining and Deciding upon the Application

1. The competent department shall examine the applications for registration and verify that they do not match or are similar to a trademark previously registered and that they do not violate the provisions of the Decree by Law and its Executive Regulations; and the Ministry shall issue its decision in this regard, by either accepting the application whenever it has satisfied the conditions and procedures stipulated in the Law and this resolution, or by rejecting the application when it doesn't comply with the conditions and procedures, or suspend the application's acceptance until certain conditions or modifications are completed.
2. The competent department shall notify the applicant of its decision, through modern electronic means, or request from him to fulfill the conditions or documents or to make the necessary amendments to accept the application.
3. In the event the applicant does not respond to the competent department's decision within (30) thirty days from the date he was notified of it, he shall be deemed to have waived his application.
4. In the event the application was accepted the applicant, or his representative, shall pay the determined publication fees.
5. In the event the decision rejected the registration of the trademark or accepted it under certain conditions or amendments, the applicant or the registered agent may object before the grievances committee within (30) thirty days from the date he is notified of it.

Article (6)

Announcing the Trademark in the Ministry's Bulletin

1. In the event the Ministry accepted the trademark registration application, it therefore announces it, before registering it, in the Ministry's bulletin with the applicant bearing the cost; and the bulletin shall identify the last date to submit an objection against the trademark's registration.
2. The publication shall be done within (30) thirty days from the date of notifying the application's approval decision.
3. The trademark shall be published in the electronic bulletin released by the Ministry, and the publication announcement shall include the following data:
 - a. Application number and date of submission.
 - b. Applicant's name, address and nationality.
 - c. Picture of the mark and its description.
 - d. The registered agent's name (if applicable) and his address.
 - e. List of commodities or services for which the trademark will be registered and its category.
 - f. Restrictions and requirements (if applicable).
4. Priority date (if applicable), its number, and the State in which the application was submitted.

Article (7)

Objection Against the Trademark's Registration

1. Any interested party may submit a justified objection through the competent department's e-services to the registration of the trademark within a period of (30) thirty days from the date of its publication in the bulletin issued by the Ministry, after paying the prescribed fees.
2. The competent department shall notify the applicant with a copy of the objection within a period of (30) thirty days from its submission date.
3. The applicant shall submit to the competent department a written response to the objection within a period of (30) thirty days from the date he was notified of it, otherwise

he shall be deemed to have waived his application.

4. The competent department shall schedule a hearing session for the submission of supporting documents and notification of both parties of the same whenever it deems fit.
5. The party wishing to attend the hearing session shall pay the prescribed fee.
6. The competent department shall notify both parties of the reasoned decision it issues, and inclusive of what it deems as necessary restrictions and requirements.
7. The competent department's decision on the objection may be appealed before the Grievance Committee within a period of (30) thirty days from the date of its notification thereof.

Article (8)

Waiver of the Trademark Registration Application or Amending it

1. The applicant may waive the trademark's registration application at any time.
2. The application to re-register the trademark shall be treated similarly as a new application.
3. It is not permissible to amend the registration application, including amending the category, after it has been published in the Ministry's bulletin or any stage subsequently.

Article (9)

Final Approval for Registration

1. The registration's approval decision shall be considered final with the lapse of a period of (30) thirty days from its date of publishing the trademark's announcement in the relevant bulletin issued by the Ministry without an objection being submitted against its registration, or by the issuance of a final judgment on the subject of the trademark by the competent court.
2. The applicant must pay the trademark registration fee within a period of (30) thirty days from the date on which the objection to the registration of the trademark expires.
3. The registration of the trademark shall have effect as of the application date recorded in the trademarks' register.
4. If a trademark was registered without specifying a certain color to it or to a part of it, the registration shall be deemed for all colors.

5. The competent department may, based upon its own discretion or upon a request from an interested party, rectify any material error occurring in the trademark.

Article (10)

Amendment of the Trademark and its Owner's Data

1. The trademark owner, whenever he wishes to introduce an amendment or addition to his registered trademark in a manner that does not fundamentally alter it, shall submit an amendment application – as per the designed template – to the competent department; Such application shall be subject to the same procedures followed for original registration applications in terms of acceptance and rejection; and such application shall be published in the designed bulletin and shall be subject to the grievance and appeal procedures in accordance with the conditions and rules related to original registration applications.
2. The trademark owner may, after paying the prescribed fees, request the amendment of the following data in the register as per the designed template:
 - a. Name and designation of the trademark owner, his address, profession or nationality; and in the case of legal persons, any amendment occurring shall be recorded under its name and address.
 - b. Addition or amendment on the commodities and services for which the trademark is registered.
 - c. Change of agent, his name or address.
3. The competent department shall prepare an announcement that includes the required amendment, and it shall publish it in the Ministry's bulletin after the prescribed fees have been paid; and a record of the same shall be recorded in the trademark register to enable the applicant to obtain an updated certificate.

Article (11)

Renewing the Protection Period

1. The trademark's owner, who wishes to renew the protection period, shall submit an application as per the designed template to the competent department within the last year of the current protection period and for a period of (6) six months subsequently and pay

the prescribed fees.

2. The competent department will publish the renewal announcement in the Ministry's bulletin once the prescribed fees are settled, and the same shall be recorded in the trademark register.
3. The renewal announcement shall include the following data:
 - a. The trademark registration number.
 - b. The trademark owner's name, address and nationality.

Article (12)

Temporary Protection for Trademarks Used at Exhibitions

1. The owner of a trademark placed on displayed commodities or used for services at international official exhibitions and expositions, which are official recognized and held inside the State, may request the temporary protection of his trademark during the duration of display, at least one month before opening the exhibition, and in as per the designed template for this purpose and after settling the prescribed fee.
2. The trademark, reference above in clause (1) of this article, shall have a temporary legal protection for the duration of the exhibition.
3. The temporary protection shall expire by the expiry of the display duration and whenever the trademark's owner, aforementioned in this article, wishes so.

Article (13)

Applying for the Temporary Protection of Trademarks Used at Exhibitions

1. The applications for temporary protection of trademarks used at exhibitions shall be recorded in a special register titled (Temporary Protection Register) which includes the following data:
 - a. Number of the temporary protection, its date and expiry period.
 - b. Name of the exhibitor or trademark owner.
 - c. Copy of the trademark and its description.
 - d. Name of the exhibition, its official opening date and duration.
 - e. List of commodities or services, and its category, for which the temporary protection

is requested.

2. The Ministry shall issue a temporary protection certificate for the trademark used at exhibitions.

Article (14)

Deregistration of the Trademark

1. The department may, based upon its own discretion or upon a request from parties of interest, deregister the trademark in the following circumstances:
 - a. If the trademark's registration was not renewed pursuant to Article (21) of the Law.
 - b. If it appears that the trademark's registration was done in violation of the provisions of the Law and this resolution.
 - c. Based upon the request of the trademark's owner, in accordance with the provisions of Article (24) Clause (1) of the Law.
 - d. Based upon a final judgment issued by the competent court.
 - e. Based upon a request by parties of interest if it appears that the trademark was registered in bad faith or without legal grounds.
2. The owner of the registered trademark, who wishes to deregister it for all or some of the commodities or services for which it was registered, shall submit an application to the competent department as per the designed template after the prescribed fees have been paid. If the register shows a record of a prior license to use the trademark, in such event the trademark will only be deregistered upon the licensee's written approval unless the license contract includes a provision stipulating the licensee's explicit approval to waive the license.
3. The deregistration application shall be submitted through the competent department's e-services after the prescribed fees have been paid, provided that the competent department decides on the deregistration application within (90) days starting from the application's submission date.
4. The competent department, before it deregisters the trademark, may notify the trademark owner of the reasons for the deregistration and hear his arguments and examines his defense.

5. The competent department shall record the deregistration of the trademark in the trademarks register and it shall be announced in the Ministry's bulletin provided that the announcement includes the following data:
 - a. Copy of the trademark and its description.
 - b. Number of the registered trademark.
 - c. Trademark owner's name and nationality.
 - d. Reason for deregistration and its effective date.
6. The deregistration publication fees shall be collected in the event it was done upon the trademark owner's request.

Article (15)

Transfer of the Trademark's Ownership

1. The trademark's ownership shall be transferred upon an application submitted to the competent department – as per the designed template – by the ownership recipient or his agent, annexed with the supporting documents duly notarized and attested and translated into Arabic, after the prescribed fees have been paid.
2. The ownership shall be transferred pursuant to a sales, waiver or merger contract or based upon a decision from the court; and the contract or decision shall include the following data:
 - a. Number of the registered trademark.
 - b. Name of the previous owner of the trademark.
 - c. Name and designation of the trademark ownership recipient, his trade name (if applicable), nationality and address.
 - d. Date of ownership transfer and the incident pursuant to which the ownership was transferred.
3. In the event the application was submitted by an agent, his name, designation and address shall be mentioned, and the competent department shall record the same in the trademark ownership transfer register in addition to mentioning the new owner's name, address and date of the record; and it shall provide the applicant with a proof of the same.
4. The competent department shall publish an announcement on the trademark ownership

transfer that includes the following data:

- a. Number of the registered trademark and its date of registration.
 - b. Name of the previous owner of the trademark.
 - c. Name of the ownership recipient, his nationality and address.
5. The competent department shall publish the announcement in the Ministry's bulletin after the prescribed fees have been paid.
 6. Without prejudice to the stipulation in Article (6) of the Law, the natural heirs of the trademark owner shall have the right to transfer the ownership under their names collectively or to any of them pursuant to waiver document signed by the person who has a right to the trademark.
 7. The waiver of the trademark registration application shall contain the data relevant to the subject matter including the data of the beneficiary of the waiver 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 recorded in the in accordance with same procedures and conditions related to the transfer of trademark ownership, and the mortgage declaration shall include the same data stipulated in Article (16) of this resolution after the prescribed fees have been paid.
2. The mortgage is released based upon a request submitted by the trademark's owner to the competent department, with necessary documents in this regard attached to it which justify the release of the mortgage, provided that the documents are duly certified and attested and translated into Arabic once the prescribed fees have been paid.
3. The competent department shall announce the placement or release of the mortgage in the Ministry's bulletin, after the prescribed fees have been paid, and the mortgage or its release shall be recorded in the register, and the applicant shall be provided with a proof of it.

Article (17)

Seizure of the Trademark

The seizure of a registered trademark shall be recorded in the register based upon a court order, and the seizure can only be cancelled based upon a final court judgment.

Article (18)

Licensing the Use of the Trademark

1. In the event the trademark owner granted a legal or natural person the license to use the trademark for all or certain commodities or services, for which it is registered, the licensing contract shall be written, duly notarized and attested, and translated if the original copy was draft in language other than Arabic. In all circumstances, it is not permissible for the licensing period to exceed the determined protection period of the trademark.
2. The application to register the license to use the trademark shall be submitted to the competent department by the trademark owner, licensee, or the registered agent for either of them, in accordance with the designed template after the prescribed fees have been paid; and it shall include the following:
 - a. Number of the registered trademark.
 - b. The trademark owner's name and nationality.
 - c. The licensee's name, address, residence, and nationality.
 - d. The licensed commodities and services.
 - e. The start and expiry dates of the license.
 - f. The geographical range of the license (if applicable).
 - g. The licensing contract translated and duly notarized and attested.
 - h. Any papers or documents requested by the competent department.
3. The competent department shall record the license to use the trademark in the register and provide the applicant with a proof of the same; and it shall also publish the announcement in the Ministry's bulletin after the prescribed fees have been paid, provided that the published announcement includes the following data:
 - a. Copy of the trademark and its description.
 - b. Number of the trademark and its date of registration.

- c. Name of the trademark's owner, address, and nationality.
- d. Name of the licensee, address, and nationality.
- e. List of the licensed commodities or services to use and its category.
- f. The start and expiry dates of the license.
- g. The geographical range of the license (if applicable)

Article (19)

Deregistration of the License

1. The deregistration of the license shall be upon a request submitted to the competent department by the trademark's owner, licensee or the registered agent of either of them, annexed with a proof of the license expiry or termination, after the prescribed fees have been paid.
2. The competent department shall notify, in written, the other party of the deregistration request who has, in such event, the right to appeal the request before the Grievances Committee within a period of (30) thirty days starting from the date he was notified of the deregistration request; and he shall submit a copy of the appeal and the proof of its submission before the Grievances Committee through the competent department's e-services. The deregistration shall be suspended until both parties reach an agreement or if the Grievances Committee issues its decision ruling upon the appeal.
3. In the event the deregistration request was not appealed, or a final license deregistration decision was issued on the appeal by the Grievance Committee, the competent department shall publish the deregistration in the Ministry's bulletin, after the prescribed fees have been paid; and the license deregistration shall be recorded in the register and the applicant shall receive a proof of the same.

Collective, Control, Public Benefit Organizations and Professional Organizations

Article (20)

Registration of Collective Trademarks

Subject to Articles (2), (3) and (4) of this resolution, the following shall be attached to the application for the registration of collective trademarks:

1. Reference in the application for registration that it belongs to a collective trademark.
2. A copy of the Articles of Association of entity applying for the registration with its amendments, provided that it includes:
 - a. A report of the persons' category who are authorized to use the trademark and their relationship to the person submitting the application.
 - b. A copy of the requirements for using the collective trademark for commodities and services.
 - c. A resolution that the person submitting the application currently conducts or will conduct a strict and sufficient control over the use of the trademark by the members affiliated with him.
 - d. The manner through which members are qualified for membership at that entity.
3. All documents shall duly notarized and attested and translated into Arabic.
4. The collective trademarks shall be subject to the same procedures of registration, publication and deregistration of trademarks stipulated in this resolution.

Article (21)

Registration of the Trademark for the Purposes of Control or Inspection

1. Subject to Articles (2), (3) and (4) of this resolution, the following requirements shall be attached to the application for the registration of a trademark for the purposes of control or inspection:
 - a. A note in the application that it belongs to a trademark for purposes of control or inspection.
 - b. A copy of the Articles of Association of entity applying for the registration with its amendments, provided that it includes:

1. Declaration that the trademark will be used by a party or parties other than the applicant and that the latter will not engage in marketing activities or produce any commodities or services for which the aforementioned trademark will be used, and that the applicant will not engage in discriminatory policies that would prevent third parties, who meet the criteria determined by the owner, from using the trademark.
2. Declaration that the collective trademark certifies the quality, grades and advantages of commodities or services and that it does not refer to the commodities or services' origin.
- c. Documents that determine the criteria and standards applied by the entity applying for registration for the purpose of controlling the use of the trademark, and that prove that the applicant entity implements an approved system to evaluate the quality.
- d. A certificate that describes the advantages of the certified commodities or services or those for which the certification has been requested.
- e. All documents must be duly certified and attested and translated into Arabic.
2. Such trademarks shall be subject to the procedures of registration, publication and deregistration of trademarks stipulated in this resolution.

Article (22)

Registering the Trademark for Non-Commercial Purposes

In the event of an application for registration of marks for non-commercial purposes, the same shall be stated on the application for registration, and the bylaws of the Public Benefit Organization or of the Professional Association – owner of the application – shall be attached to application; and it shall be subject to the same procedures of the trademark's registration, publication and deregistration stipulated in this resolution.

Article (23)

Geographical Indicators

1. The application to register a geographical indicator shall be submitted by one or more legal persons as per the designed template for the applicant or his agent registered in the

Agents' register.

2. Subject to the provisions of Article (2), (3) and (4) of this resolution, the geographical indicator application shall include the following data:
 - a. Applicant's (legal person) name and its legal form and purpose of incorporation.
 - b. Applicant's nationality, residence and type of products.
 - c. A photo of the geographical indicator and its description.
 - d. The Geographical indicator's data while illustrating in detail its advantages, characteristics and features in relation to the geographical region, from an approved entity.
 - e. A duly attested and translated copy of the geographical indicator's registration certificate in the country of origin, in the event the geographical indicator application was submitted from outside the State.
 - f. A duly attested and translated Power of Attorney in the event the application was submitted by the applicant's agent.
3. The provisions relating to the grievance and appeal stipulated in Article (12) of the Law and the provisions relating to the publication and objection stipulated in Articles (15) and (16) of the Law shall be applicable to the Ministry's resolutions issued for the acceptance, rejection or amendment in the register after the registration.

Article (24)

Customs Clearance

1. The right owner or his representative, in the event he has justified reasons for his belief that it may be possible to import counterfeit or forged commodities bearing a trademark similar to his registered trademark – which may lead to confusion among the public – may submit a written application to the Customs Authority to suspend the customs clearance of such commodities and prohibit its trade, provided that the request shall be supported by the necessary evidence and information for the existence of an infringement of the applicant's trademark right.
2. The Customs Authority concerned with the customs clearance shall decide on the application and notify the applicant, in writing, of her decision concerning his application

within (7) seven working days from the date of submitting the application. The decision, in the event the application was accepted, shall be valid for one year beginning from the date of its submission or for the remaining period of the trademark's protection – whichever is less – unless the applicant requested a shorter period.

3. The Customs Authority may request the applicant to provide an appropriate guarantee or a security of equivalent value that is sufficient to protect the defendant from the abuse of the right to request a suspension of the customs clearance.
4. Without prejudice to the preceding provisions of this article, the Customs Authority may, upon its own discretion, issue a decision to suspend the customs clearance for commodities imported, in transit or prepared for export when it arrives to customs region under its jurisdiction, in the event sufficient evidence exist that the commodities are forged or bear – illegally – a trademark similar to a registered trademark which may lead to confusion among the public.
5. The competent authority, whenever it decides to suspend the customs clearance for commodities arriving to the customs region under its jurisdiction, shall:
 - a. Notify the commodities' importer and the right owner of the decision suspending the customs clearance as soon as it is issued.
 - b. Notify the right owner, upon his written request, of the names and addresses of the commodities' sender, importer, recipient and quantities.
 - c. Allow parties of interest to examine the commodities in accordance with the applicable customs procedures in this regard.
6. The right owner may file a lawsuit on the disputed subject matter before the competent court and shall notify the competent authority within a period not exceeding (10) ten working days starting from the day he was notified of the decision suspending the customs clearance of the commodities; otherwise, the decision is deemed as null and void unless the authority or competent court decided to extend, in circumstances it evaluates, the timeframe for a period not exceeding an additional (10) ten working days.
7. With the exception to the circumstances evaluated by the court, if the court verifies that the commodities – for which the customs clearance was suspended – are counterfeit, forged or illegally bearing a trademark similar to a registered trademark in a manner that

causes confusion among the public, a judgment must be awarded to destroy such commodities at the importer's expense, or to dispose it apart from commercial channels in the event the destruction causes unreasonable harm to public health or the environment.

8. The customs clearance of commodities to commercial channels shall be prohibited, or the permission to export it again, in the event the trademark, which was illegally placed, was merely removed.
9. The conditions, controls and procedures followed by the Customs Authorities shall be applicable to the customs clearance and examination.

Article (25)

International Applications for Registration

The international applications for registrations, submitted in accordance with the Madrid Protocol concerning the international registration of trademarks, shall be subject to the Protocol's executive regulations and its amendments.

Article (26)

Repeals

Any provision contradicting or conflicting with the provisions of this resolution shall be repealed.

Article (27)

Publishing and Enforcing this Resolution

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

Signed

Mohamed bin Rashid Al-Maktoum

Prime Minister

Issued by us:

On: 7 / Thu'l Qihda / 1443 A.H.

Corresponding: 07 / June / 2022 AD