



The
**LEGAL
500**

**COUNTRY
COMPARATIVE
GUIDES 2021**

The Legal 500 Country Comparative Guides

United Arab Emirates

INTELLECTUAL PROPERTY

Contributing firm

Charles Russell Speechlys LLP



Mark Hill

Partner | mark.hill@crsblaw.com

Lara Haidar

Senior Associate | lara.haidar@crsblaw.com

This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in United Arab Emirates.

For a full list of jurisdictional Q&As visit legal500.com/guides

UNITED ARAB EMIRATES INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

Patents

Patents are available for inventions that are new, involve an inventive step and are capable of industrial application.

The following categories of invention are excluded from patentability:

- Plant varieties, animal species and biological methods of producing plants or animals,
- Diagnostic methods, treatments and surgical operations.
- Scientific principles, discoveries and theories as well as mathematical methods.
- Rules or methods of conducting business, or performing mental activities or playing games.
- Inventions that violate public order or morals, or relate to national defence.

Utility models

Utility models are granted for inventions that are new

and capable of industrial application but do not meet the inventive steps requirement for patent protection. They are subject to the same processes and procedures as patents but are subject to a shorter protection term.

Know-How

Know-how is defined under the law as information, data, or knowledge of a technological nature, acquired through the profession, and practically applicable. The law prohibits the disclosure, use or publication of know-how in certain circumstances.

Registered trade marks

A trade mark may have a variety of forms, including words, drawings, symbols, colours and or packaging. A sound may form part of a registered trade mark and protection will extend to the same. A trade mark may be registered if it is capable of distinguishing the origin of the goods or services of one entity from those of others, and meets the filing requirements. Collective and certificate marks are allowed.

Registered designs

Design registration extends to designs that are new, creative, can be used as an industrial or handicraft product, and do not violate the public order or morals.

Unregistered designs

The law does not recognise unregistered designs. It may be possible to achieve protection for such designs through copyright, or as three-dimensional trade marks.

Trade Secrets

The obligation of confidentiality and trade secret protection is provided across various UAE Federal Laws, both in a general and in the employment context. The Penal Code makes it a criminal offence for an individual who, by virtue of his profession, craft, position or art is entrusted with a secret and divulges it in cases other than those allowed by law or with the authorisation of the person disclosing it. The Civil Code imposes an

obligation on employees to safeguard the industrial or commercial secrets of their work.

Copyright

Copyright protection extends to literary, dramatic, musical and artistic works, sound recordings, films, broadcasts, architectural works and derivative works, without prejudice to the protection prescribed for the works from which they have been derived. Protection arises automatically when works are recorded in writing or other tangible form.

Plant varieties

Plant variety rights are available by registration, for new, distinct, homogenous, stable plant varieties, that are harmless to the health or environment and subject to the same not contravening the principles of the Islamic Sharia'a law.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

Right	Duration
Patents	20 years from the date the application was filed. The law does not provide for an extension beyond this term.
Utility models	10 years.
Registered designs	10 years.
Know-How/Trade Secrets	As long as the secret nature of the information is maintained.
Registered trade marks	A trade mark registration is valid for 10 years and may be renewed indefinitely, provided renewal fees are paid. The life of the author plus 50 years from the end of the calendar year in which the last surviving author dies.
Copyright	50 years from the end of the year in which the work was first made available for published works. For works of applied arts, the term is reduced to 25 years. The rights of broadcasting organizations are protected for a period 20 years from the end of the calendar year in which such broadcasts were first transmitted.
Plant Varieties	25 years from the date of application (for trees and vines) and 20 years from the date of application in all other cases.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

The first owner of an intellectual property right is the inventor, designer or author who created the work. Where the work was carried out in the course of employment, the employer is the first owner, unless otherwise provided in the employment agreement.

4. Which of the intellectual property rights described above are registered rights?

Patents, registered trade marks, registered designs,

utility models and plant variety rights. The UAE also provides for copyright registration.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Who can apply for registration

- o For patents and designs: The inventor/designer, or their successor in title, can apply to register a patent or design.
- o For trade marks: the individual or legal entity seeking registration of the mark.
- o For plant variety rights, the person or legal entity who breeds it, or discovers and develops it, or their successor in title.

Procedure for registration

For patents and utility models, the application may be filed with the International Centre for Patent Registration (ICPR) at the Ministry of Economy.

For a registered trade mark, copyright or registered design, the application is filed at the Intellectual Property Protection Department (IPPD) at the Ministry of Economy.

For a plant variety right, the application is made to the Director of Health & Agricultural Development at the Ministry of Climate Change and Environment.

In each case, an application must meet the formal requirements set out in the respective law. Once an application is filed and the application fees are deposited, the application will be examined in accordance with the legal requirements for each IP right. If all the requirements are met, the application will proceed to grant.

6. How long does the registration procedure usually take?

The length of the registration procedure varies depending on the right.

Applying for a patent will generally take between 3-4 years, subject to any post-grant opposition proceedings.

Applying for a utility model will generally take 1-2 years.

Applying for a registered trade mark will generally take between 6-8 months, if the application is unopposed.

Copyright registration takes 2-3 weeks

7. Do third parties have the right to take part in or comment on the registration process?

In the case of trade marks, an interested party may file an opposition to the registration within 30 days of the date of publication of the trade mark.

In the case of patents and utility models, an interested party may file an opposition within 60 days of the publication of the grant, before the prescribed Committee, on one of the prescribed grounds (non-compliance with formalities, lack of patentability, lack of novelty, lack of industrial applicability). The Committee's decision may be appealed before the administrative Court within 30 days of the date of notification of the decision.

In the case of plant varieties, an interested party may file an opposition within 30 days of publication of the grant.

8. What (if any) steps can the applicant take if registration is refused?

In the case of trade marks, during the examination of an IP right, the examiner may raise objections and will notify the applicant of the objections and the grounds of the same. The applicant may respond to the objections within 30 days of the date of notification of the objections, by providing further clarification or agreeing to any acceptable conditions raised by the examiner. If the final decision of the examiner is to refuse the application, the applicant may appeal the examiner's decision to the relevant Committee. If the final decision of the Committee is to refuse the application, the applicant may appeal the Committee's decision to the competent Civil Court within 60 days of notification of the Committee's decision.

In the case of patents and utility models, once the examination is concluded and, subject to the payment of the publication fees, the patent or utility model shall be granted by virtue of a ministerial decision and be published in Official Gazette. The applicant may file a grievance against an unfavourable decision within 60 days of the date of publication before the Grievances Committee.

9. What are the current application and renewal fees for each of these intellectual property rights?

Patent

The cost of registering a patent, inclusive of the application and examination fee, is AED 8000.

Utility Model

The cost for registering a utility model, inclusive of the application and examination fee, is AED 8000.

Registered Design

The cost for registering a design, inclusive of the application and examination fee, is AED 2,000.

Trade mark:

The cost of registering a trade mark in one class of goods or services is AED 7,000 inclusive of the publication fees. There is no multiclass filing system and separate applications must be filed to cover each class of goods or services. The cost of renewal is AED 7,000.

Copyright

The cost for registering a copyright is AED50 in the case the applicant is an individual and AED200 in the case the applicant is a legal entity.

Plant variety rights

The cost for plant variety rights include an application fee of AED10,000 and a technical examination fee of AED10,000.

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

Depending on the right, the protection term may be renewed and a grace period is provided for late renewal.

Patents

Patent registration lasts for 20 years subject to the payment of annuity fees. The law does not provide for extension of the protection beyond this term. Annuity fees can be paid at any time before the due date or up to 3 months following the due date without a late payment fee, and up to 3 months thereafter subject to a late payment fee.

Utility Models

Utility models registration lasts for 10 years subject to the payment of annuity fees. The law does not provide for extension of the protection beyond this term. Annuity fees can be paid at any time before the due date, up to 3 months following the due date without a late payment fee, and up to 3 months thereafter subject to a late payment fee.

Registered Designs

Design registration lasts for 10 years. The law does not provide for extension of the protection beyond this term.

Trade Marks

Trade marks lasts for 10 years and may be renewed for further 10 periods. Late renewal is possible within 3 months of the date of expiration of the registration, subject to a late payment fee.

Plant Variety Rights

A plant variety right lasts for 20 years, or 25 years in the case of trees and vines.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

Assignments can only be recorded against registered rights.

In order for an assignment of IP rights to be effective in the UAE, it must be made in writing and signed by the owner of the IP/assignor and the assignee before a Notary. Where the assignment is signed outside the UAE, it must be legalised for use in the UAE. A deed of assignment must be in Arabic or accompanied by a legal translation into Arabic.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Registration is not mandatory, however, an assignment shall have no effect against third parties unless it is registered.

13. What are the requirements to licence a third party to use each of the intellectual

property rights described above?

Licences can only be recorded against registered rights.

In order to be registered, licences must be in writing and signed before a Notary. Where the licence is signed outside the UAE, the licence must be legalised for use in the UAE. The licence must be in Arabic or, if in another language, accompanied by a legal translation into Arabic.

For patents, utility models and registered design, the term of a licence must not exceed the period of protection of the IP right.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Registration is not mandatory, however, a license shall have no effect against third parties unless it is registered.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

In the case of licensed patents and utility models, a licensee shall have the right to make use of the rights that the protection grants to the owner, including preventing infringement of the same, subject to notifying the owner. If the owner does not take necessary measures within 30 days of the notice, the licensee initiate legal action and claim damages.

In the case of licensed trade marks, the law provides that the owner of the trademark is entitled to initiate legal action for infringement. Such right may be granted under the licence.

The law does not make a distinction between exclusive and non-exclusive licensees in this respect.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

The infringement of various intellectual property rights attracts criminal sanctions which include fines and/or a term of imprisonment.

In respect of registered patents, utility models and know-how, the acts of counterfeiting or wilful infringement of a patent or utility model, and the misappropriation of know-how, constitute a criminal offence. Criminal sanctions include imprisonment and/or a fine of no less than AED5,000 and up to AED100,000.

In respect of registered trade marks, criminal liability attaches to counterfeiting activity. This includes any person who counterfeits or imitates a trade mark in such a way as to mislead the public, or knowingly uses the same without the consent of the proprietor, or sells or offers for sales products or services under an identical mark or one that is likely to be mistaken for a registered mark. Sanctions include imprisonment and/or a fine not less than AED5,000.

In respect of copyright, criminal liability attaches to the unauthorised copying, reproduction, distribution or publication of the work, in addition to the manufacture and import of unauthorised copies of the work. Criminal sanctions include imprisonment for a minimum period of 2 months, and/or a fine of no less than AED10,000 and up to AED50,000.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Civil proceedings

The primary recourse for IP rights owners in relation to enforcing IP rights, is civil litigation before the Courts.

Criminal proceedings

The infringement of IP rights is a criminal offence under UAE law. Therefore the owner of an IP right may lodge a complaint before the police department who will investigate the claim and, where there is merit, refer the same to the Public Prosecution for examination and, if appropriate, referral to the Criminal Courts. Criminal proceedings are generally better suited in respect of counterfeit goods.

IPPD

The IPPD generally deals with matters relating to the validity and registrability of an IP right. The IPPD may revoke the registration of a trade mark of its own accord (where the trade mark was registered in contravention

to the law, or in error) or based upon on a third party's application to the Court (where the mark was unduly registered).

Border measures

Where a trade mark is registered with the customs authorities (see section 20), the customs authorities may seize infringing products upon entry into the UAE, including upon specific request from the right owner or their representative, in the event of a suspected shipment of infringing products arriving or having arrived at a port of entry.

DED IP Gateway

The Department of Economic Department (DED) in the emirate of Dubai has established the IP Gateway, a system enables registered rights owners to open cases relating to the infringement of their trade marks through the mobile application and website, and view market inspection reports relating to the same. Administrative actions result in the seizure and destruction of infringing goods and the imposition of fines against infringing parties. The cost of registration is AED 2,000.

Alternative Dispute Resolution

Alternative dispute resolution requires the voluntary engagement of both parties, unless provided for contractually. ADR may include arbitration where an arbitration clause is included in a contract or mediation, subject to the parties agreeing to the same.

18. What is the length and cost of such procedures?

The length of the proceedings before the Civil Courts depend on the complexity of the matter. On average, proceedings before the Court of First Instance may take 15-18 month for a judgement to be issued. Appeals in civil cases take around 8-12 months.

Court fees are calculated according to the type of relief sought and the value of the claim. Standard Court fees are around AED13,000. In addition, a claim for damages incurs a fee that is graduated by value, from AED10,000 for a value up to AED500,000, to a maximum of AED40,000 for values over AED1 Million.

Professional fees for legal representation vary, including depending on the complexity of the case.

19. Where court action is available, please

provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

The Civil Courts of the UAE have jurisdiction in relation to intellectual property disputes. Disputes regarding IP rights in the Dubai International Financial Center (DIFC) free zone should be brought before the DIFC Courts.

Proceedings can be commenced by the filing of a claim and the payment of Court fees. Notification of the claim and the first hearing date would be served to the defendant. Typically, the Court will appoint an expert in the field of intellectual property to investigate the facts. Expert reports are submitted to the Court and a copy is provided to the parties for comments. Once the exchange of pleadings has completed, the Court will render a judgment. Proceedings before the Court of First Instance tend to take 15-18 months from commencement until a judgment is issued. The judgment may be appealed to the Court of Appeals within 30 days of notification.

20. What customs procedures are available to stop the import and/or export of infringing goods?

A registered trade mark owner can put in a place a customs border watch, to prevent the importation into the UAE of products bearing an infringing trade mark. An application is valid for a year and must be renewed yearly. The applicant must provide detailed information relating to the trademark and its features, to allow the customs authorities to distinguish between original and counterfeit products. The customs authorities will detain any suspected infringing products and notify the rights owner. The rights owner is then able to inspect the products and determine whether its rights are infringed.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

The UAE Civil Code does not contain provisions relating to pre-action conduct. However, sending the infringer a warning letter demanding that they cease and desist the infringement is recommended.

22. What options are available to settle intellectual property disputes?

Claims may be settled at any time, whether before or during an ongoing Court action. The terms of settlement agreement are usually set out in a settlement agreement.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

Patents/utility models

Infringement occurs where a party imitates an invention or a manufacturing process.

Trade marks

Infringement of a trade mark occurs where a party:

Uses a trade mark which is identical or confusingly similar or imitates a trade mark so as to mislead the public, or using such a mark in bad faith.

- Knowingly makes fraudulent use of a counterfeited or imitated trade mark.
- Knowingly sells, offers for sale any goods bearing a false or imitated mark.
- Unlawfully uses such marks in the provision of services.
- Falsely indicates on his marks or on his business papers any statement which leads to the belief that the said mark is registered.

Copyright

Copyright infringement occurs where a party performs any of the rights reserved for the copyright owner, without the permission or a licence from the owner. These include using, copying, reproducing, renting or lending the work, making adaptations of the work, publicly performing the work or authorising third parties to carry out any of the foregoing.

The burden of proof is on the claimant. Any evidence proving ownership of the IP right and the infringing activities may be submitted in support of an infringement claim.

24. How does the court acquire any necessary information (fact or technical)

and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

Court hearings are administrative in nature. A judge will investigate the facts of each case and, where necessary, appoint an expert to conduct an investigation and establish facts in dispute. Appointed experts are tasked to review documents, meet with the parties for discussion, conduct site inspections, and gather necessary material to prepare their report. Expert reports are submitted to the Court and a copy is provided to the parties for comments. If the Court deems the report is sufficient, it may refer it back to the expert for further evaluation, otherwise, the Court may conclude the investigation and issue a final judgement.

There is no set process or approach to discovery in the UAE. Parties to a claim can file the documents that they wish to rely on for their case. The Court may also compel a party to submit certain documents.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Submissions and evidence are presented in writing to the hearing officers. There is little scope for cross examination or oral evidence.

26. What defences to infringement are available?

The law does not provide for defences to patent and utility models infringement. However, prior use, compulsory licence, IP right expiration, non-commercial or non-industrial use, may be raised as lines of defence.

Defences to trade mark infringement include:

- Prior user rights (in or outside of the UAE)
- Prior registration outside the UAE
- Good faith adoption
- Generic or descriptive marks
- Non-use

Defences to copyright infringement

The Copyright Law provides a list of exceptions to the right-holders' rights, where copyrighted works are allowed to be used without consent, in each case, subject to certain criteria being met.

- Reproduction (a single copy) of a copyrighted work is allowed for:
 - Personal use: as long as the purpose is not for profit or professional use. This exception is allowed for all types of works, except (a) works of fine art or applied art, which can be copied with the consent of the rights-holder unless they were displayed in public places; (b) architectural works; and (c) computer programs and databases, unless with the knowledge of its legitimate possessor, who has the right to adapt it but only within the limits of the licensed purpose, or for the purpose of back[1]up, or as a replacement for when the original copy is lost or destroyed or unusable, provided that the substitute or adapted copy is destroyed as soon as the copier no longer has the right to possess the original copy.
 - Use in judicial proceedings or the like: provided use is limited to the extent required by such procedures, and that the source and the author name are mentioned.
 - Preservation of documents: for the purpose of preserving the original copy or substituting it due to loss or destruction, with the knowledge of the records house or archives, and not for profit.
 - Research: with the knowledge of the records house, archives or libraries, provided that the right to copy it must be granted for one time or for interrupted periods of time and provided that obtaining a licence to copy was not possible.
- Educational, religious, cultural or vocational training needs: It is permitted to copy short sections of protected works in written, audio or visual recorded form, for the purpose of cultural, religious, educational or vocational

training, provided that (i) the copying is within reasonable limits and does not exceed its purpose, (ii) the name of the author and the title of the work are mentioned each time it is possible, (iii) the reproduction is made for no direct or indirect profit or return., and (iv) it was not possible to obtain a licence to copy.

- Critique and debate: It is permitted to quote short paragraphs or extracts from a protected works for the purpose of critique and debate, or to provide news, to the extent strictly necessary with respect to the type of work, and provided that the source and author are mentioned.
- Performance: It is permitted to perform protected works in family meetings or by students inside an educational institute, provided that the performance is made for no direct or indirect profit or return.
- Broadcast showing certain works: It is allowed to show works of fine arts, applied and plastic arts or architectural works in broadcasting programs, if such works are permanently present in public places.

27. Who can challenge each of the intellectual property rights described above?

A challenge against an intellectual property right may be brought by the owners of prior rights and by a party who has a benefit in the intellectual property right.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

For patents, designs and industrial models, oppositions may be filed within 60 days of the publication of the grant of registration.

For trade marks, oppositions may be filed within 30 days of the application being published. In addition, at any time after the registration of a trade mark, any party may seek revocation of the registered trade mark on the basis that the same has not been used consecutively for a period of 5 years following its registration. In the case of infringement, a claim may be brought at any time before the Civil Court and/or the regulatory authorities.

For plant varieties, objections may be filed within 30 days of the publication of the grant.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

Forum and procedure

Oppositions may be filed during the prosecution stage (see section 28).

Once an IP right has been granted, a third party may seek to challenge and revoke the same through the Civil Court (see sections 18 and 19).

Grounds of invalidity finding

Patents

In relation to patents, the validity of a patent may be attacked on the basis that the requirements for registration (see section 1) were not met:

Trade Marks

In relation to trade marks, the validity of a trade mark may be attacked on the basis of absolute grounds and relative grounds. Absolute grounds can be raised in relation to a trade mark that is incapable of registration e.g. the trade mark is descriptive or generic to the trade, devoid of distinctive character, does not distinguish the goods or services of one entity from those of others, or otherwise does not meet the criteria for registrability requirements set out in the law. Relative grounds can be raised where a trade mark is identical or similar to an existing mark, in respect of the same or similar goods and services.

In addition, a trade mark registration may be revoked on the grounds of non-use for a consecutive period of 5 years.

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

License of Rights

In respect of patents and utility models, if the IP right holder does not exploit the right for a period of 3 years following grant, a third party may be entitled to apply for a licence of the relevant IP right.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

Remedies and orders available for infringement of IP rights include:

Precautionary attachment:

A Claimant may file a request to the Summary Court to attach the physical assets of the infringing party, including the infringing products, equipment and tools used in manufacturing the same. This is an ex-parte process and usually requires submission of a surety deposit. To secure the award of this order the Claimant must show that they have a strong prima facie case.

Compensation

Monetary relief is the primary form of relief in the case of infringement. UAE Courts have discretion in awarding compensation and the same is generally calculated to be proportionate to the loss sustained.

Destruction of Infringing Items

A Claimant may seek and the Court may order the destruction of the infringing goods.

Order for Publication

The Court may order the publication of the outcome of the case.

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties?

Is there a procedural mechanism enabling or requiring security for costs?

In respect of civil claims, the legal costs before the Court of First Instance are approximately AED 40,000 in straightforward cases. Where a claim for damages is made, further costs apply and the determination of these costs varies between the different emirates of the UAE but generally are calculated at about 6% of the damages claim amount with a cap of AED 40,000.

Legal costs consist of legal fees and Court fees. The Courts generally award nominal amounts in legal costs, these rarely exceed AED2,000, regardless of the fees actually incurred. The Court will make an award on legal costs and these are generally paid by the losing party.

Professional fees for legal representation are separate and vary, including depending on the complexity of the case.

33. Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.

The COVID-19 pandemic has had an impact on business and, as a result, delays have affected the timeline for processing applications for the registration of IP rights. However the UAE's drive towards digitalisation across all sectors including at an IP registry level, the Court system and the various administrations has led to a faster resumption of operations and it is expected that this will lead to smoother processes and reduced timelines.

Contributors

Mark Hill
Partner

mark.hill@crsblaw.com



Lara Haidar
Senior Associate

lara.haidar@crsblaw.com

