

May 2014

UAE Trade Marks Office puts an end to examination reports

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On 19 May 2014, the UAE Trade Marks Office (**TMO**) announced that it will no longer issue examination reports or grant extensions of time during the trade mark application process.

Instead, as from 1 June 2014, the TMO will only issue acceptances, conditional acceptances or rejections. This practice is in line with the UAE Federal Law No. 37 of 1992 as amended by Law No. 8 of 2002 (**UAE Trade Marks Law**) and UAE Ministerial Decision No.6 of 1993 (the **Executive Regulations**) which refer only to the options of accepting a trade mark application (either unconditionally or with a condition being imposed) or rejecting the application.

However, the Trade Marks Law and Executive Regulations also provide the TMO with a broad discretion in the trade mark application process. Until now, the TMO has used this discretion to issue examination reports setting out any objections or other concerns which the examiner has with an application. This has enabled a dialogue to take place between the examiner and the applicant (or the applicant's trade mark agent) so that the examiner's concerns can be addressed.

The new practice will have an impact in a range of circumstances, such as where the examiner:

- does not agree with, or has a query in relation to, the specification of goods or services covered by the application;
- is concerned that the mark applied for is not sufficiently distinctive; or
- has identified a prior potentially conflicting mark on the register.

These particular circumstances are considered further below.

However, in all of these cases, the examiner will no longer issue an objection to which the applicant (or its representative) can respond. Instead, the examiner will only have the option of rejecting the mark applied for, or accepting the application (with or without imposing a condition on the application).

The applicant will then only be left with the options of accepting the examiner's decision, appealing against the decision or re-filing an amended application in an attempt to address the examiner's concerns.

Initial appeals are to the Trade Marks Committee (which is within the TMO) and then on to the UAE Federal Court. There is currently a substantial backlog of appeals with the Trade Marks Committee, with some appeals remaining unheard after more than five years.

Effects of the change

- **Specification queries:** As part of its change in practice, the TMO has announced that any application “whose list of goods/services is in violation of the International Classification of Goods and Services” will be rejected. Currently, the TMO only accepts specification items taken verbatim from the exhaustive list contained in an Arabic translation of the 10th Edition of the Nice Classification Guide which is used by the TMO’s examiners.

At present, the TMO is likely to raise a specification query where it considers a particular term to be unclear. This may be the case, for example, where the goods or services covered by the application are unusual or where there is more than one option for translating the goods or services into Arabic.

In these circumstances, the TMO will provide the applicant with the opportunity either to clarify the term by amending it or to make submissions in an attempt to try to convince the TMO that the term should be accepted as it stands.

Under the new practice, where the TMO has a concern with the specification of goods or services, it will only have the option of rejecting the application or accepting the application on the condition that the specification is amended as required by the TMO.

This could cause serious issues for applicants where the amendment requested by the TMO does not accurately describe the goods or services of the applicant. In these circumstances, in order to avoid having a registration with an inaccurate specification, the applicant will need either to file a fresh application (with an amended specification) or to appeal against the examiner’s decision (which may potentially delay the application for years).

- **Objections based on distinctiveness:** There is to be no change in the TMO’s current practice of examining applications on absolute grounds. Currently, if the TMO has concerns over the registrability of a trade mark then it can raise an objection to which the applicant may respond before the TMO decides whether to accept or reject the application.

In the case of applications where the TMO has concerns over the distinctiveness of the applicant’s trade mark, the applicant is currently able to respond to the objection by providing submissions and evidence to explain why the mark is distinctive when this may not be apparent to the examiner without these submissions and evidence. Under the new practice, the TMO is more likely to reject an application if it considers that it is not distinctive. The applicant will then be faced with the option of appealing against the rejection and/or filing a fresh application for a different, more distinctive version of its trade mark.

One further option which applicants may wish to consider when filing an application for a trade mark which is not obviously distinctive is to file submissions and evidence with the TMO prior to examination taking place, in the hope that the TMO takes this into

consideration when examining the application.

However, the UAE Trade Marks Law and Executive Regulations do not make any provision for submissions and evidence to be filed in this way, and it remains to be seen how the TMO will respond to such an initiative.

- **Citations of earlier marks:** There is to be no change in the TMO’s current practice of examining applications on relative grounds. Under the existing practice, if a citation of an earlier mark is made during examination, the applicant is given the opportunity to respond to the TMO’s concerns.

This process has particular value where there is a coexistence agreement in place under which the owner of the cited mark is willing to consent to the applicant’s mark being registered. Also, it is not uncommon in the UAE for an applicant to have its own prior registration cited against it, where a different Arabic translation of the applicant’s name has been used for two applications (making it appear that the applications have been filed by two different entities).

Under the current practice, such a scenario can easily be dealt with by explaining the position to the TMO and providing supporting documentation (in the form of a consent letter and/or corporate documentation evidencing that the earlier applicant is, in fact, the same entity as the current applicant).

However, under the new practice, it appears more likely that the TMO will reject the application on the basis that the mark applied for conflicts with a prior mark. In turn, this means that the applicant is likely to have to appeal against the TMO’s decision (and potentially wait years for a decision on the appeal).

With this in mind, before filing an application, it will be important to consider whether a prior application or registration is likely to be cited. If so, then it may be possible to file submissions and evidence with the TMO prior to examination taking place, in the hope that the TMO takes this into consideration when examining the application and thereby avoid the application being rejected.

This option of filing submissions and evidence prior to examination is not contemplated by the UAE Trade Marks Law and Executive Regulations, and it is therefore uncertain how the TMO will respond to such an initiative. However, given the alternative of having the application rejected and consequently having to deal with the issue on appeal, this option may be worthwhile exploring in some cases (for example where there is a coexistence agreement in place with the owner of an earlier mark).

Timing and transition arrangements

The practice change will apply to all trade mark applications filed on or after 1 June 2014.

As yet, the TMO has not announced any transitional provisions and it is therefore uncertain whether the new practice will also apply to applications which have been filed prior to this date. Presumably, however, any examination report that has been issued and any extension of time which has been granted prior to 1 June 2014, will continue to apply.

Will there be any changes to the new practice?

These changes have been introduced with two weeks' notice. It is possible that the UAE Trade Marks Office will issue further guidelines shortly.

Further information

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