

UAE: Brief notice of trademark opposition is no longer sufficient to start proceedings

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Trademark protection is ideally secured through registration of the trademark in the UAE.

During the process of registration, and once the technical examination for the applied mark is successfully completed, the trademark office requests from applicants permission to publish the approved marks in the UAE official gazette for third party opposition to meet the statutory requirements. Third parties (i.e. trademark owners of conflicting marks or preexisting rights) are legally entitled to challenge the acceptance decision and lodge administrative oppositions before the Trademark Office within 30 days from publication date. Through the opposition proceedings the opponents are given a chance to object to the decision made by the Trademark office in accepting the trademark. The registration process is halted until a decision is made.

Once the opposition action is filed, the Trademark Office notifies the applicant, of the opposition proceeding action (and this should typically be completed within 15 days period counted from the date of filing the opposition in according to the UAE Trademark Law). Thereafter, the applicant will have 30 days to submit a response, i.e. counter-opposition, to defend the registerability of the trademark, calculated from the date of summoning the applicants with the notice of opposition. Failure to submit a response within the statutory timeframe will result in the automatic acceptance of the opposition action and the proposed trademark will be rejected.

In the past, it was customary that the UAE Trademark office would accept a brief notice of opposition to start the proceeding formalities, i.e. serving the opposition on the applicants and calculating the statutory period for the counter-opposition. As a result of this practice, opponents opted to file a brief notice of opposition in order to safeguard their rights and without making solid references to the legal grounds on which the opposition was initiated. This practice was considered sufficient for the purpose of commencing the opposition formalities. However, this has been recently changed and the opposition examiner at the UAE Trademark Office has refused to notify the applicant with the opposition proceeding unless the opponent submits detailed statement of opposition which reflects the opposition grounds.

Whilst the brief notice of opposition remains a valid tool for the purpose of meeting the statutory deadline, brand owners and their IP lawyers will need to ensure prompt submission of detailed opposition statements explaining the merits of opposition to ensure that the UAE Trademark Office serves the opposition notice to the applicants. We have been aware of cases where an applicant considered their marks registered due to lack of opposition and moved to pay registration fees; whereas a third party presumed that their notice of opposition had been accepted and assumed that the applicants had failed to respond to it (and so believed the opposition notice had been automatically upheld).

It is therefore recommended that when filing an opposition proceeding, the third party must make sure that the opposition statement contains sufficient legal grounds and facts surrounding the case, and that it periodically verifies the status of the proceedings with the Trademark office to ensure it is being processed.