

The Dubai Court of Cassation issues decision that strengthens the status of 3D trademarks

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Al Tamimi & Co. have successfully represented Cartier (the “Plaintiff”) in proceedings filed with the Dubai Court of First Instance against a famous jeweller in the UAE (the “Defendant”) who was found selling lookalike Cartier pieces in its outlet in Dubai.

Cartier has long been regarded as the world’s leading retailer in luxury jewellery and watches. Cartier’s product is a combination of genius designs and intricate craftsmanship that has over the last two centuries enjoyed a continuous presence among the world’s premier luxury brands. Cartier’s long standing presence in the global market and their high calibre products mean that there is considerable recognition associated with their name and pieces.

Cartier owns numerous trademark registrations, protecting their exclusive collections names and iconic products’ designs. As the proprietor of these registered rights, Cartier has the exclusive right to utilise, and as a result, is entitled to protect these rights against any infringement from third party. Cartier is a registered trademark in various countries, including the UAE and many of their iconic product’s designs enjoy three dimensional Trademark (“3D Trademark”) and copyright protection in various countries.

In this case, Cartier filed a lawsuit with the Dubai Court of First Instance (the “Court”) alleging trademark infringement of their 3D Trademark “Amulette de Cartier” and demanded the Defendant stop selling lookalikes of Amulette de Cartier, and to withdraw all pieces reproducing the Plaintiff’s design from the Defendant’s shops. A comparison of the pieces is shown below.

The requisite evidence was submitted to the Court which appointed an Intellectual Property Expert to assist the Judge with technical expertise. The Expert assessed the trademark registrations against the alleged infringing pieces. Firstly, the Expert held that Cartier did indeed have valid trademark registrations in the UAE. Secondly, and more importantly, the Expert found that the infringing designs were very similar so as to be virtually identical to the Plaintiff’s Amulette de Cartier. Taking the Expert’s opinion into account, the Court held that the infringing products will damage the Plaintiff’s business and reputation; moreover, it was held that the differences in quality between the two products would harm the Plaintiff’s reputation and results in unfair competition.

In addition to the above reasoning, the Court also relied on various correspondences exchanged between the Plaintiff and the Defendant’s initial legal representatives (who were later replaced) which were held as amounting to an admission of guilt. In these emails, the Defendant stated that it had “stored the infringing designs unintentionally and agreed to withdraw and melt the pieces”. The Defendant claimed they obtained the pieces of jewellery from a Chinese company at a Hong Kong Jewellery exhibition in September 2014.

Based on all these factors the Court decided to reject the Defendant’s request to dismiss the lawsuit and ordered them to immediately cease infringement of the Plaintiff’s protected trademark by withdrawing any and all products identical or lookalike of Amulette de Cartier’s registered shape. The Court further ordered the Defendant to seize and destroy all lookalike pieces and to pay the amount of AED 20,000 as compensation for the moral damage they suffered, in addition to the

attorney's fees. The Defendant is also ordered to provide all information and documents related to the source of the infringing products and publication of the judgment in two local newspapers.

The Defendants lodged an appeal to the Dubai Court of Appeal, rejecting the presence of any similarity between Cartier's registered designs and the infringing pieces. The Court rejected the Defendant's appeal and reconfirmed the decision as issued by the Court of First Instance.

The Defendant submitted a further appeal before the Court of Cassation, raising the same arguments as raised in their previous appeal. This was rejected again and the Court of Cassation reaffirmed the judgement issued by the Court of First Instance.

This decision is warmly welcomed by Al Tamimi & Co. and it is first and foremost a victory for Cartier, and also a decision that strengthens the enforcement of 3D trademarks rights in Dubai and in the UAE.