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To all the Members of the AIPPI - UAE National Group

6th Circular/ 2024

Subject: Exploring the Implications of Post-Registration Amendments to Specifications under UAE Trade Mark Law

Dear all,

We share this circular as prepared by our esteemed colleague and member of communications committee, Mona Saleh. We trust you find it informative to give you some updates about the trade mark office formalities and services.

As we are all aware, and under the current UAE Trade Mark Law (enacted in 2021), amendments to an existing trade mark registration are permitted post registration. These amendments can be made to the mark, the name/address of the registrant **and/or the specifications**.

This circular discusses the amendment of specifications after registration, emphasizing the potential for varying interpretations of the law among agents and practitioners in the UAE. The aim is to bring attention to a potential formality issue that may arise when altering the scope of specifications post-registration. Rather than providing a definitive stance on the matter, this circular is intended as a general insight for your consideration when encountering similar situations.

Under general trade mark principles, post-registration amendments should not expand the scope of protection originally granted, whether in terms of the specifications or the trade mark itself.

Article 19(1) of the UAE Trade Mark Law allows for amendments to the specifications, including both additions and deletions. The term "adding" (إضافة) in Arabic suggests that additions may be made to the list of goods/services. The provision goes on to state "provided the modification does not fundamentally affect the identity of the mark". This may apply to both the mark and the specifications. Different interpretations may lead to varying opinions on this matter. For Arabic speakers, we encourage you to read the article in Arabic to understand the used language in the original text. Article 19(1) also refers to final approval on any changes by the Trade Mark Office ('TMO').

In practice, the TMO allows specification amendments, including additions provided they remain within the scope of the class. That said, while the TMO allows this in practice, we should not consider that a specification amendment that broadens the scope of protection would meet the requirement of the law to "not fundamentally affect the identity of the mark". Accordingly, such amendments that broaden scope of specifications could be subject to future challenge, if approved.

The term "adding" can be interpreted in various ways. For instance, you might add a limitation phrase like "all the aforementioned to be used in relation to xxx," which in theory could limit the specifications rather than expand them. Does this qualify as an addition or is it more about removing or limiting specifications? These are the types of questions that provoke deeper consideration and we will wait for the TMO practice on such requests.

Furthermore, and if the mark has been registered under the class heading, would the TMO permit the inclusion of additional items within that class's scope? This is another crucial question that can only be answered on a case-by-case basis, subject to the TMO's final approval. Nonetheless, it's an important point to think about. Additionally, the amendments to be made post-registration are published in the Trade Mark Journals, but there are no opposition rights associated or can be raised by third parties. If the TMO does allow additions to already registered specifications, could this open the door for challenges by third parties, and if so, how would they proceed without the right to oppose?

In conclusion, these questions highlight the complexities and nuances surrounding post-registration amendment to specifications which could be seen straightforward. While there may be no clear-cut answers, they certainly invite further exploration. As the landscape of trade mark law continues to evolve, it remains essential to stay vigilant and consider all possible interpretations. Ultimately, the way forward will depend on how the authorities, TMO and practitioners choose to navigate these grey areas, leaving room for continued discussion and reflection on the best course of action.

We thank Mona for her insights on the above and review of this formality. We welcome your thoughts and look forward to hearing from members to participate in the future circulars.

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