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**Dubai – October 11<sup>th</sup>, 2021**

**To all the Members of the AIPPI UAE Group**

**Subject: 5<sup>th</sup> circular/ 2021- latest updates and developments in IP system (UAE)**

Dear all,

We hope everyone is keeping well.

As we are heading to the last quarter of 2021, we prepared this circular to update the members of UAE Group with some key developments and updates that relate to the IP sector in the United Arab Emirates.

Please feel free to reach out to the Communications Committee members in case you would like to receive more information on how you can contribute to the future circulars.

**1. New Industrial Property Law in UAE:**

We mentioned in our bi-annual circular that a reform of Intellectual property laws is happening. As everyone is aware by now, the UAE Government issued Federal Law no. 11 of 2021 for the regulation and protection of industrial property rights (“**the Law**”). It is set to enter into force in November 2021 (i.e. six month after publication date in official gazette). The Law was published on 31 May 2021 and it will supersede the previous law (Federal Law No. 17 of 2002 on Regulation and Protection of Industrial Property of Patents, Industrial Drawings and Designs) and is applicable to patents, utility models, industrial designs and trade secrets among other industrial property rights in the UAE.

Among many interesting points and new changes, the Law includes the following interesting updates:

- the ability for applicants to apply for the accelerated examination of patents, of which a number of cases will be selected each year. This will aim to decrease the time in which a patent can be secured in the UAE (which is currently 3-7 years). In addition, absolute novelty is no longer a concern since the Law introduced grace period of 12 months to file for patent.
- the Law stipulates the conditions for the granting of an industrial design with an industrial design only considered as being 'new' if it has not been disclosed to the public by publication, use, or any other means, prior to the date of application. Furthermore, the term of protection for an industrial design has increased from ten years to twenty years. Moreover, The Law permits that a utility certificate may be converted into a patent application, so long as it complies with the conditions prescribed by the Law.
- the Law adds provisions concerning Integrated Circuit Layout Designs and clarifies subject matter that a patent or utility certificate will not be granted for, such as "the combination of two or more medicines for the purpose of medical treatment by a licensed pharmacist".
- the Law makes some changes on employment relationship. For instance, we found the Law to be very interesting and assuring for employees' innovation within the course of employment. It enhances the position of employees under employment contract and entitles them to 'fair compensation that takes into account the economic value and benefit to the employer' for any invention created in the course of employment.
- other changes include compulsory licensing, applicable penalties and compensation for damages were included and introduced.

As for the implementing regulations, we noted that the Law mentions clearly that existing implementing regulations of Law No. 17 of 2002 will be enforced until a new implementing regulation is enacted. This should assume that the Law will be enforced once the publication period is completed.

*Annex 1: Enclosed a copy of the Law*

## **2. IP Litigation: Procedural update from Dubai Court**

A new circular number 9 of year 2021 ("the Circular") was issued by Dubai Court on 13-9-2021 to oblige plaintiff(s) in Intellectual proeprty related disputes to refer their cases to experts for technical opinion prior pursuing substantive case. This amended procedure will have a major impact on filing civil claims directly before Dubai First Instance Court and will have immediate effect.

According to the circular, plaintiff(s) must now request an Expert to be appointed, review the merits, give her opinion and then move to file the main civil claim. According to the available information from Dubai Court, this should improve the impartiality of IP disputes, support plaintiffs to pursue their claims smoothly and organically. It was also based on the fact that the vast majority of IP disputes require expertise and should be referred to experts for opinion.

*Annex 2: A copy of circular as issued by Dubai court.*

### **3. UAE Confirms Membership of Madrid Protocol**

Further to our bi-annual circular sent out in June, we learnt that the UAE Government has now confirmed its accession to the Madrid Protocol, becoming the 109<sup>th</sup> Member of the Madrid System.

It has been published that from 28 December 2021, applicants filing in the UAE will be able to use the Madrid System and benefit from the Madrid network of 124 territories. However, no implementing regulations to this effect have been published locally and the UAE Trademark Office did not issue any official circular to explain the details and mechanism. We expect this will come shortly as we get closer to the abovementioned date.

We hope you find our circular helpful and informative.

Please get in touch with any of communications committee members to discuss any of the above topics or ways to participate in the activities of AIPPI communications committee.

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October 11, 2021