

Protection of well-known Trademark in UAE with special reference to Harrods vs. Harrods case



As the UAE Federal Trademark Law (37/1992, as amended by 8/2002) in its Article 4 provides for protection of the well-known Trademarks along with the conditions which constitutes a mark to be well-known at international level. The UAE Courts have taken great steps in protecting the rights of well-known trademark owners with respect to unregistered mark in UAE. As per the UAE trademark law, exclusive protection in case of the infringement of trademark is provided to the registered user in the form of criminal remedies. For the unregistered marks, the United Arab Emirates adopts 'first to use' policy and registration are not strictly necessary to establish rights. The main purpose behind giving protection to well-known mark is to preclude companies from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill.

This article is an attempt to study how the UAE court have played a significant role in protecting the rights of trademark owner having reputation globally with special reference to the **HARROD's** case in 2007 wherein, the Dubai Court of Cassation has protected the rights of trademark owner possessing tradename "HARRODS" with respect to its company in the UK.

Concept of Well-known Trademark

Well-known trademark is also often known as Trademark having international goodwill. These marks are known at global level for providing quality products and services. UAE Trademark law is silent on the definition of a well-known trademark. The said trademarks are widely known to public at large and therefore, they enjoy a special protection. For ex. Samsung, Nokia, Whirlpool etc. These marks shall be not registered in other countries without the prior authorization of the owner of said mark.

Factors to be Considered while determining well-known mark

As per Article 2 of Joint Recommendation on the Protection of Well-Known Marks, the following factors must be considered while determining well-known trademark

1. The degree of knowledge or recognition of the mark in the relevant sector of the public;
2. The duration, extent and geographical area of any use of the mark;
3. The duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. The duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. The value associated with the mark.



Protection of Well-Known Trademark under Article 4 of Federal Law No. (37) of 1992 Concerning Trademarks

The term “Well- Known Trademark” has not directly been used under the UAE Federal Law on Trademark instead it has referred the term trademarks having an international goodwill. This indicates that even if the said marks are not registered in UAE still it can be protected in the Court of Law in UAE. **Article 4** of said Law read as follows:

The trademarks having an international goodwill beyond the boundaries of the mother country, may not be registered unless authorized by the owner or by his official attorney.

Further, **Article 4(2)** provides that it is the public's awareness about the trademark that determines its goodwill in a market.

In addition to this **Article in (3)**, it further says that even, if any well-known trademark is used by an unauthorized person with respect to the different goods and services to which the said mark is not used in the market, cannot be registered in UAE as this may cause confusion among the public and they may believe that both goods and services belongs to the same trademark owner.

Paris Convention on well – Known Trademark

At the international level, the United Arab Emirates is a party to the Paris Convention for the Protection of Industrial Property and the World Trade Organization (WTO). The convention provides legal protection to trademarks which are not even registered in the countries where the protection is required. **As per Article 6** of the said Convention:

A trademark which constitutes a reproduction, an imitation, or a translation of well-known mark and which is liable to create confusion among public and used for identical or similar goods to which well- known trademark applies shall not be entitled to be registered and use of such kind of mark must be prohibited.

Further, **Article 8** of the said Convention states that *A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.*

UAE Court’s pronouncement on well-known Trademark-

Harrods Limited v Harrods Tourism (UAE) 2007

Courts through its pronouncements have granted special protection against infringement for well-known unregistered trademarks. One such landmark judgement is **Harrods vs. Harrods** passed by Court of Cassation.

Facts

A company was established under the tradename “Harrods” Limited in the United Kingdom. It claimed that the tradename “Harrods” has achieved goodwill internationally. Later, the respondent (owner of Trademark HARRODS Ltd.), came to know that Appellants were running



two companies as Harrods General Trading and Harrods Tourism, located in the Dubai. Harrods Ltd. has brought a law suit against the Appellant under **Articles 4 and 17 of the Federal Trade Marks Law** and provisions of **Article 8 of the Paris Convention** on Protection of Trade Name to validate his claim and finally it was settled by the Court of Cassation.

Contention of Respondent

1. The main contention made by the Respondent was that using the identical trademark with respect to different businesses is considered to be illegal and cause infringement of internationally known trademark.
2. Trade name "Harrods" used by the two establishments shall be struck off by the Economic Department and Dubai Chamber of Commerce and Industry, UAE.
3. Registration of the two companies using the Harrods title was in violation of trade mark laws since Harrods was also registered with the Ministry of Economy and Planning in the UAE.

Contentions of Appellants

The Appellants contended that Harrods Ltd was headquartered in London, and though it was registered with the Ministry of Economy and Planning in the country, the activities of the two establishments involved tourism and general trading, which was completely different from the activities of Harrods of London.

Decision of Court of First Instance

The court did not accept the contention made by the appellants and ordered the appellants to stop using the tradename of HARRODS and de-register their company from the records of the Department of Economic Development and the Dubai Chamber of Commerce and Industry.

Decision of Court of Appeal

Later, the appellants have filed a suit before the court of appeal wherein their appeals have been dismissed by the said court.

Being dissatisfied by the decision of the court of appeal, they approached to Court of Cassation.

Decision of Court of Cassation

The UAE court ruled in favor of Harrods Limited on the grounds that Harrods Tourism is an imitation of a world-famous mark, and it does not carry an element that makes it different from the Harrods trademark. The court ordered for the trademark, Harrods Tourism, to be cancelled. The court rejected any requests for imposing fines, compensation, damages, or costs.