

3D Trademarks in the UAE

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The type of trademark infringement is manifold. In addition to straightforward brand name infringement, infringement of the unique shape of a successful product and copying its distinguished packaging elements are also common in the marketplace. In the case of infringement of shape and other aesthetic features of a product, the infringer tries to market their product with a different brand name but copies the unique shape and design of a successful product in an attempt to confuse consumers into purchasing the item. Since the infringer uses a different brand name for their product, taking legal action against the infringement is difficult as the law enforcement authorities will normally be hesitant to take action against products with a brand name totally different from the genuine and registered brand.

In the UAE, as with most countries, the shape of a product falls within the definition of the word "trademark". So, the ornamental or aesthetic nature of article product can be protected by registering a shape trademark. The shape of a product can often be of significant value to a business and it is advisable to consider making use of the trade mark law provisions to secure the intellectual property value of a product with a commercially significant shape, and to enforce such registered rights against possible infringers.

In the UAE, legal action is possible against the infringement of a shape and design of a product which is registered as a 3D or shape trademark. We have recent experience of successfully taking such action. The brand owner is a well known developer and manufacturer of a range of home appliances and electrical products based on innovative technologies developed by them. As such the products are instantly distinguishable from conventional products in the same product segments as a result of the unique technology and designs underpinning their products. However, they had been encountering a persistent issue of infringement of their unique products by similar products with identical shape and design but with different brand names all manufactured in China. The infringing products even copied the peculiar images and artistic works created by the brand owner describing the unique features and function of their products, on the infringing products' packages as well as in the product manual inside the packages. Since the brand names used for the infringing products were different, it was not possible to take any legal action against the infringers for breaching the trademark relating to the name of the product.

The brand owner then considered registering the shape of their product as a 3D trademark in the UAE, and subsequent to the filing of the necessary application they were granted registration for the same.

Following the successful registration of the product as a Shape (3D) trademark in the UAE, an administrative complaint was filed against the infringers. The complaint was accepted and the counterfeit goods were seized.

This particular case has created an important precedent as it is one of the unique administrative complaints to be launched and accepted by the law enforcement authorities in Dubai enforcing the protection awarded to 3D trademarks.

Based on this successful result, it is recommended that brand owners file for 3D trademark protection to protect the unique shape of their products.