


THE ROLE OF ARBITRATION IN PROTECTION THE OWNER OF FAMOUS TRADEMARK FROM THE DIGITAL ENVIRONMENT INFRINGEMENT

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ARTICLE INFO	ABSTRACT
<p>Article history:</p> <p>Received 31 January 2023</p> <p>Accepted 18 April 2023</p>	<p>Purpose: The aim of this study is to help consumers to move towards choosing specific goods and services that are better suited to their sense and needs by relying on the trademark of the commodity or service that has been taken as a website address for the promotion of goods or services.</p>
<p>Keywords:</p> <p>Trademark; Arbitration; Civil Protection; Protection of Customer.</p> 	<p>Theoretical Framework: The infringements on the rights of owners of famous trademarks taking addresses to e-commerce sites for the purposes of advertising and promoting goods and services offered by such websites or even bargaining the owners of famous trademarks for large amounts of money for ceding the registered website address. Arbitration has emerged as an effective means for resolving intellectual property disputes, including the ownership disputes of famous trademarks, and providing civil protection for the rights of their owners. The effectiveness of arbitration is derived from many advantages achieved by this means for the litigation parties, in particular the owner of the well-known trademark compared to litigation as an original and traditional means of resolving trademarks' disputes. Particularly, Arbitral awards in the mentioned cases have been rendered just and fair to the extent that they support the stability of global trade.</p> <p>Design/Methodology/Approach: The nature of this study assumed the adoption of the descriptive analytical approach to the provisions of the arbitration and trademark legislation recently promulgated in the United Arab Emirates in comparison with provisions adopted by some of the legislation enacted in other states and provisions decided upon by international intellectual property rights organizations and conventions.</p> <p>Findings: The result of this study is the reputation of the trademark is a presumption of the bad faith of the owner of the website who used that trademark as a name of the website which was registered in the digital environment, while the arbitral tribunal's direction should be towards the good faith presumption of the respondent, in the case preceding the registration of the website, and the date of registration of the trademark.</p> <p>Research Practical and Social Implications: The study is being prepared to address numerous challenges faced by the owners of renowned brands, including the ease of registering websites with names of such brands without conditions or regulations that prevent such abuses.</p> <p>Originality/Value: The value of this study is being the first study to be conducted in the UAE. Besides, the examination of the role of arbitration in protection the owner of famous trademark from the digital environment infringement adds new knowledge to the academicians.</p> <p>Doi: https://doi.org/10.26668/businessreview/2023.v8i4.1777</p>

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O PAPEL DA ARBITRAGEM NA PROTEÇÃO DO TITULAR DE MARCA FAMOSA CONTRA VIOLAÇÃO DO AMBIENTE DIGITAL

RESUMO

Objetivo: O objetivo deste estudo é ajudar os consumidores a avançar para a escolha de bens e serviços específicos que sejam mais adequados ao seu sentido e necessidades, apoiando-se na marca registrada do produto ou serviço que foi tomada como um endereço de site para a promoção de bens ou serviços.

Referencial Teórico: As infrações aos direitos dos titulares de marcas famosas levando endereços a sites de comércio eletrônico com a finalidade de anunciar e promover bens e serviços oferecidos por tais sites ou ainda negociar grandes quantias com os proprietários de marcas famosas pela cessão endereço do site registrado. A arbitragem surgiu como um meio eficaz para resolver disputas de propriedade intelectual, incluindo disputas de propriedade de marcas famosas, e fornecer proteção civil para os direitos de seus proprietários. A eficácia da arbitragem decorre de muitas vantagens alcançadas por este meio para as partes litigantes, em particular o titular da marca notória, em comparação com o litígio como meio original e tradicional de resolver disputas sobre marcas. Particularmente, as sentenças arbitrais nos casos mencionados foram proferidas de forma justa e equitativa na medida em que apoiam a estabilidade do comércio global.

Design/Methodologia/Abordagem: A natureza deste estudo assumiu a adoção da abordagem analítica descritiva para as disposições da legislação de arbitragem e marca registrada recentemente promulgada nos Emirados Árabes Unidos em comparação com as disposições adotadas por algumas das legislações promulgadas em outros estados e provisões decididas por organizações e convenções internacionais de direitos de propriedade intelectual.

Conclusões: O resultado deste estudo é que a reputação da marca é uma presunção de má-fé do proprietário do site que usou essa marca como nome do site que foi registrado no ambiente digital, devendo a direção do tribunal arbitral seja em relação à presunção de boa-fé do demandado, no caso anterior ao registro do site, e à data do registro da marca.

Implicações Práticas e Sociais da Pesquisa: O estudo está sendo elaborado para abordar inúmeros desafios enfrentados pelos proprietários de marcas renomadas, incluindo a facilidade de registrar sites com nomes dessas marcas sem condições ou regulamentações que impeçam tais abusos.

Originalidade/Valor: O valor deste estudo é ser o primeiro estudo a ser realizado nos Emirados Árabes Unidos. Além disso, o exame do papel da arbitragem na proteção do titular de marca famosa da violação do ambiente digital agrega novos conhecimentos aos acadêmicos.

Palavras-chave: Marca, Arbitragem, Protecção Civil, Protecção do Cliente.

EL PAPEL DEL ARBITRAJE EN LA PROTECCIÓN DEL TITULAR DE UNA MARCA FAMOSA DE LA INFRACCIÓN DEL MEDIO AMBIENTE DIGITAL

RESUMEN

Propósito: El objetivo de este estudio es ayudar a los consumidores a avanzar hacia la elección de bienes y servicios específicos que se adapten mejor a sus sentidos y necesidades al confiar en la marca comercial del producto o servicio que se ha tomado como dirección de un sitio web para la promoción de bienes o servicios.

Marco Teórico: Las infracciones a los derechos de los propietarios de marcas famosas que toman direcciones de sitios de comercio electrónico con el fin de publicitar y promocionar los bienes y servicios ofrecidos por dichos sitios web o incluso negociar con los propietarios de marcas famosas por grandes cantidades de dinero para ceder el dirección del sitio web registrado. El arbitraje se ha convertido en un medio eficaz para resolver disputas de propiedad intelectual, incluidas las disputas de propiedad de marcas famosas, y brindar protección civil a los derechos de sus propietarios. La efectividad del arbitraje se deriva de las múltiples ventajas que este medio logra para las partes litigantes, en particular el titular de la marca notoriamente conocida, frente al litigio como medio original y tradicional de solución de controversias marcarias. En particular, los laudos arbitrales en los casos mencionados se han dictado justos y equitativos en la medida en que respaldan la estabilidad del comercio mundial.

Diseño/Methodología/Enfoque: La naturaleza de este estudio asumió la adopción del enfoque analítico descriptivo de las disposiciones de la legislación de marcas y arbitraje promulgada recientemente en los Emiratos Árabes Unidos en comparación con las disposiciones adoptadas por algunas de las leyes promulgadas en otros estados y disposiciones decididas por organizaciones y convenciones internacionales de derechos de propiedad intelectual.

Hallazgos: El resultado de este estudio es que la reputación de la marca es una presunción de mala fe del titular del sitio web que utilizó esa marca como nombre del sitio web que fue registrado en el entorno digital, mientras que la dirección del tribunal arbitral debe ser hacia la presunción de buena fe del demandado, en el caso anterior al registro del sitio web, y la fecha de registro de la marca.

Implicaciones prácticas y sociales de la investigación: el estudio se está preparando para abordar numerosos desafíos que enfrentan los propietarios de marcas reconocidas, incluida la facilidad de registrar sitios web con nombres de tales marcas sin condiciones o regulaciones que eviten tales abusos.

Originalidad/Valor: El valor de este estudio es ser el primero que se realiza en los EAU. Además, el examen del papel del arbitraje en la protección del propietario de una marca famosa de la infracción del entorno digital agrega nuevos conocimientos a los académicos.

Palabras clave: Marca, Arbitraje, Protección Civil, Protección al Cliente.

INTRODUCTION

In modern time, electronic use of the renowned trademarks in digital commercial transactions such as names of websites witnessed an increase in connection with an increase of the digital commercial dealings, where different business enterprises have set up websites dedicated to display different goods and services under their trademark addresses to make a distinguish from other companies' websites, since it is no secret that trademarks in their traditional pattern have always been under encroachment, particularly, the well-known brands have been attacked in the digital environment.

Passing of enforceable arbitration provisions in accordance with the implementation rules of Foreign Arbitration Provisions established by national arbitration legislation, including the UAE Arbitration Act No. (6) of 2018, which provisions were in conformity with the New York Convention on the recognition and enforcement of Foreign Arbitral Awards, including arbitration provisions in infringement disputes against well-known trademarks in the digital international trading environment, reflects the important role of arbitration in the settlement of well-known trademark disputes within the digital environment, considering the infringement on well-known brands in the digital trading environment, have become dangerous practices that constitute a threat to the financial stability of businesses, as the well-known brand is a financial component of the company that owns the brand, as it is the method by which the consumers select goods and services within available goods and services. Furthermore, the importance of this study is also demonstrated to the consumers by helping them to move towards choosing specific goods and services that are better suited to their sense and needs by relying on the trademark of the commodity or service or that has been taken as a website address for the promotion of goods or services.

The paper will highlight important questions such as: Does the Emirati new legislation encompassed the well-known brand with special legal protection compatible with the protection of trademarks established by international agreements? **What is the role of arbitration in providing due civil protection to the owner of the famous trademark against potential**

infringements in the digital environment? Are arbitral awards in cases of infringement of famous trademarks fair and just to the extent that they support the stability of international trade?

BACKGROUND

The famous Trademark has been defined by jurisprudence as "the well-known brand that is, known to a wide range of the public, which enjoys a prestigious status and a good reputation (Abdelfatah, 2018), while in terms of legislation, the United Arab Emirates Federal Decree No. (36) 2021 concerning trademarks in article (4) as a criterion for the brand's reputation as the trademark which is known to the public in respect of the commodity bearing that trademark as a result of its promotion, registration or use, or the number of countries in which it is registered, made known or valued, or the extent to which it affects the promotion of goods or services used by that famous trademark to distinguish it so that its fame exceeds the country in which it was registered to other States. The UAE legislator has established a rule to protect the famous trademark, namely, that it may not be registered for goods or services similar to those of the famous trademark, except on the request or with the consent of the owner.

The Paris Federation of Industrial Property and World Intellectual Property Organization (WIPO) have determined through a joint session of WIPO Member States' Associations in 1991, which came up with recommendations that set out the criteria that distinguish the famous Trademark from other trademarks, namely either objective or personal.

Substantive criteria: Article (2/1) of the above joint recommendation provides that the competent authority may extract from the data submitted, factors or elements on the basis of which the brand's reputation can be determined, including but not limited to its publicity among the concerned customers through consumers' surveys, this particular criterion adopted by article 16 - Part II of TRIPS Agreement by adopting the criterion of a particular trademark's reputation to the extent of its spread and known to the category of the concerned public with certain goods or services and not its popularity among society members in general and this criterion has been criticized by some on the basis that most famous trademarks are not limited to the popularity and how it is known to members of a particular society but are known to all members of the community such as Mercedes and Coca-Cola (Sameeha, 2016) and the trademark's temporal and spatial range criterion. Thus, the famous Trademark is the one which people continue to use goods or utilize the services it encompasses for a long period of time and in many countries of the world, including long-term and wide geographical range

advertising campaigns. In terms of geographical and temporal criteria, I believe it must be coupled with the legal criterion that a famous Trademark must be registered in many countries of the world, or applications have been made for registration, whether registered in the name of a particular person or several persons, as well as the registration must have been for a long period of time, and evidence of the validity of this opinion, its adoption by the UAE legislator, particularly in article (4) of the Trademark Act.

ADVANTAGES OF RECOURSE TO ARBITRATION AS A SETTLEMENT TOOL FOR WELL-KNOWN TRADEMARK DISPUTES

Arbitration as a tool for resolving well-known trademark disputes in the digital environment has many advantages compared to parties' recourse to litigation, although it is the inherent means adopted by States' legislation to resolve disputes arising from contractual and non-contractual legal relations.

SUPPORT INTERNATIONALIZATION OF THE TRADEMARK

A trademark that is registered in a certain State and is under legal protection only within the territory of that State and does not extend that legal protection to other States, therefore, cyber-attacks on the Trademark, including those famous in the digital environment, cannot be attributed to the territory of a certain State, since these websites operate in a global digital environment and are not counted on the territory of a particular State. Also, the trademark may be registered in more than one country under the name of the trademark owner, and may be owned by several different companies operating in multiple countries and belonging to one commercial group, or those companies are linked to each other with links of participation and cooperation.

Moreover, the conflict of laws problem and jurisdiction will arise, when arbitration is a more effective method for resolving such disputes for many reasons, including the existence of international institutions and arbitration centers that can settle electronic trademarks disputes, and subject the dispute to the law of the State chosen by the parties to the dispute, irrespective of the State's territory the arbitration will take place, and the flexibility granted by arbitration to parties to a dispute in choosing the law, this will give them the opportunity to choose a specific law that is evolving in the area of trademark protection (Adnan, 2012), in addition, the arbitration itself may be digital so that arbitration hearings do not take place in the territory of a particular State.

It should be noted that the well-known Trademark is not legally protected within the territory of the State in which the trademark is registered but extends beyond the State of registration, and UAE federal law has adopted this direction in Article (4/1), So that a famous trademark may not be registered in the United Arab Emirates whose popularity exceeds the borders of the State in which it has been registered over identical or similar goods or services unless the owner of the trademark requested so or with his consent.

UNIFICATION OF ARBITRATION PROVISIONS

Provisions issued by the judiciary in trademark disputes may vary for a number of reasons, including, most importantly, the territorial legal protection of the trademark, which is limited to the geographical territory of the State in which the trademark is registered, where the registration of a trademark in a given State would not give it the same legal protection in other States, therefore if a well-known but registered trademark in a particular State was to be infringed in other States, the owner of the trademark would file a lawsuit before the courts of the States in which the abuse occurred, and this means that each court will apply enforce the law in the State to resolve the dispute before it, in addition, each court has a particular point of view, thus the jurisdictional provisions may vary and multiple in cases of abuse of the famous trademark, notwithstanding the same circumstances of such proceedings, including the well-known trademark unification in question. While resorting to arbitration for the settlement of trademarks disputes including famous ones is based on the agreement of the parties to the dispute, which allows them to choose a specific law to apply to the dispute, and often the parties to the dispute agree on the choice of the law of a particular State, and this agreement provides the greatest legal protection to the famous Trademark (Adnan, 2012). However, if arbitration is institutionalized through a particular arbitration center, the international arbitration centers, including Dubai International Arbitration Center, apply unified arbitration rules, which is reflected on the unity of arbitral awards rendered in well-known commercial trademark disputes.

CONFIDENTIALITY AND EXPERIENCE

A well-known Trademark is an important element of a business's capital as it is considered a tool of communication between the Trademark's owner and the consumer for its role in attracting consumer attention to buy the product or service, the well-known trademark owner is therefore keen to ensure that the dispute arising from the infringement on that

trademark is completely confidential in order to prevent the business' reputation from being affected. This confidentiality is guaranteed by arbitration, as it is a means by which trademark disputes are settled in a confidential manner that would not jeopardize the enterprise's business reputation for any damage that it might suffer if the litigation were to be resorted, where the litigation hearings were originally public.

Since the arbitrator or arbitral tribunal is selected by the parties to the dispute, it is appropriate that they should be chosen on the basis of their expertise in the subject matter of the dispute, since their specialization in the field of law is not necessarily such as judges in the courts, in arbitral tribunals there is often a combination of legal field as well as competence (professional and technical) relevant to the subject matter of the dispute (Alhisain, 2018).

SPEEDINESS

The separation of commercial law rules from the general rules of financial transactions is due, *inter alia*, to the speed of commercial transactions as compared to the general financial transactions. Therefore, the provisions of trade law are appropriate to the speed of transactions in the world of commerce. Furthermore, Arbitration as a method of settling disputes was also consistent with that speed in the scope of trade, in particular, international trade. Arbitration in international legal relations disputes, including trademark disputes, allows parties to a dispute to determine its duration by setting a date for the arbitrator award.

In the absence of a determination by the parties to the dispute, the legislation on arbitration sets that date at a certain period, calculated from a specified date, consisting of a relatively short period, such as the date of the first arbitral hearing, which would reduce the amount of tort suffered by the parties due to the long duration of the dispute.

As well as for the trademark owner, the continuity of the dispute in trademarks' cases causes the trademark owner greater material and moral tort, including reputational damage to the Trademark and its status resulting from the continued display of low-quality counterfeit goods throughout the period required to resolve dispute before the court, which includes in some cases, periods of postponement of unjustified litigation hearings and multiple degrees of litigation and judicial enforcement, this coupled with damage to the consumer category on the other hand, as counterfeit of Trademarks will affect producers and consumers alike, by depriving producers of counterfeit Trademarks' products from opportunities of promoting these products, as well as the damage incurred to consumers which impacted their ability to

distinguish between high-quality original products and other low-quality products as a result of a particular Trademark counterfeit (Alaa, 2008).

EXECUTING FOREIGN ARBITRAL AWARDS

In recent years, the United Arab Emirates has witnessed a significant growth in the arbitration movement between local and international users. While there is undoubtedly a positive trend in the use of arbitration as a dispute resolution mechanism in the UAE, one of the main criticisms is the uncertainty about the implementation of both domestic and international awards. Although the UAE acceded to the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (the “New York Convention”) in 2006. As a matter of fact, any UAE arbitration practitioner will be familiar with the local battles of enforcement, as demonstrated in *International Bechtel Company Limited v Ministry of Civil Aviation in the Government of Dubai*, in addition to the recent Court of Appeal decision which questioned whether Britain was a signatory to the New York Convention; However, in the recent Commercial Appeal Judgment No. 693 of 2016 issued by the Dubai Court of Cassation, it can be said that the feelings of suspicion and anxiety may be manageable, at least for the time being especially when it comes to the enforcement of foreign arbitral awards.

The case was on a Tenancy Sharing Agreement of 2 May 2007, where a dispute arose between the Claimant and the Defendant and the former commenced arbitration proceedings in London under the Contract.

The arbitral tribunal issued two awards in favor of the Claimant, one on the merits of the claim and one on the costs, the last of which was on March 20, 2014.

The judgments became final as a result of the defendant having not been challenged by duly notified and in accordance with English law.

The plaintiff-initiated proceedings in Dubai for the recognition and enforcement of these two judgments. The Dubai Court of First Instance ordered that both judgments be recognized and enforced in accordance with the enforcement procedures stipulated in the UAE Civil Procedures Law.

The defendant appealed and on July 15, 2015, the Court of Appeal upheld the decision of the Court of First Instance; On September 13, 2015, the defendant appealed this decision to the Court of Cassation.

In this lawsuit, the defendant filed two objections; First, he alleged that the Court had erred in rejecting his argument that the Respondent had not received a notice of arbitration and

therefore could not present its case before the arbitral tribunal. The reason for this is that a commercial agent, rather than the respondent itself, has received the Notice of Arbitration. The Defendant argued that as a UAE company a Notice of Arbitration should be served pursuant to the Agreement between the United Arab Emirates and the United Kingdom on Legal Aid, ratified by Federal Decree No. 38 of 2007.

Second, the defendant alleged that a person not authorized to bind the defendant to arbitration had signed the contract containing the arbitration clause. The Court of Appeal had ruled that the Respondent had failed to prove this under the law of the country in which the award was made, namely the laws of England and Wales.

The Court of Cassation rejected the argument, stating that according to Article 238 of the UAE Civil Procedure Code, international agreements, by virtue of ratification, apply as if they were domestic law in the UAE to disputes related to the enforcement of foreign court decisions and arbitral awards.

The Court of Cassation also clarified that by virtue of Federal Decree No. 43 of 2006, which was published in the Official Gazette on June 28, 2006, the UAE joined the New York Convention; Hence, its provisions have been applied to the present dispute.

The New York Convention provides that, as a general principle, and subject to any possible reservations it may have entered into, each signatory State shall recognize binding arbitration agreements, so long as there is an agreement to arbitrate in writing (whether in a contract as a separate agreement, or in exchanged letters or telegrams).

Article V provides that: 1. Recognition and enforcement of a judgment may be refused, at the request of the party against whom the judgment is rendered, only if that party furnishes to the competent authority, from which recognition and enforcement is sought, evidence that:

- a. The parties referred to in Article Two of the contract were, under the law applicable to them, suffering from a lack of capacity..., under the law of the country in which the judgment was rendered; or
- B. the party against whom the award is rendered has not given adequate notice of the date of meeting the arbitrator or of the arbitral proceedings; or (c) (d) (e).

In other words, the party against whom the arbitral award is issued may request non-recognition of the award under any of the provisions of Article V, including (a) and (b), provided that it provides proof to the court requested to recognize that it was incapacitated by the law of the country in which it was granted. in which the judgment was rendered, or he did

not receive notice of the date of meeting the arbitrator or the arbitral proceedings and that he was unable to present his claim.

The Court of Appeal concluded that the respondent had not presented any evidence before the relevant court that he was incapable of signing the contract under the law of the country in which the arbitral award was issued. As for the notification, the fact that the Defendant had attended the arbitration sessions indicated that the Defendant had received proper notice, and therefore the entire appeal was dismissed.

In conclusion, the Dubai Court of Cassation took a position in favor of the enforcement of foreign arbitral awards and recognized the primacy of the New York Convention. The Court of Cassation has held that, according to Article V (1) (a) of the New York Convention, the issue of the capacity of the person who signed the arbitration clause is assessed by the use of the law of the country in which the award was rendered (the law of the State) regardless of the nationality of the parties or the local laws in which Under which the party acquires its legal status. This is particularly encouraging because technical points about the signatory's authority to bind a firm to arbitration are often raised to resist the enforcement of foreign arbitral awards in the UAE.

ARBITRATION TERMS OF INFRINGEMENT ON THE WELL-KNOWN ELECTRONIC TRADEMARK.

Arbitration as a means of settling disputes including well-known trademark disputes requires an infringement on a right to an electronic trademark, this infringement from a legal perspective requires certain terms, first, right of the trademark's ownership, presumably encompassed by civil and criminal legal protection, and the existence of certain conduct amounting to an infringement on the trademark, which triggered the dispute between the trademark's owner and the other party of the legal relationship, albeit a non-contractual one.

OWNERSHIP RIGHT CERTAINTY OF A WELL-KNOWN TRADEMARK

The arbitration of an existing dispute over an electronic trademark by the arbitral tribunal and the issuance of the arbitral award requires that the ownership of the electronic trademark in question be established by providing evidence of complete national or international electronic registration of the trademark, The legal protection of the trademark in fact only begins with the issuance of its registration certificate, regardless of the impact of this registration, whether it is the origin of the ownership of the trademark or a disclosing impact

whose role has been limited in disclosing the ownership of the well-known trademark. Federal Decree No. 36 of 2021 of the United Arab Emirates on Trademarks is referred in article (7) with regard to the registration procedures of the trademark to the executive regulations issued by the Ministry of the Economy under the Federal Decree referred to, as provided for in the article (54) Electronic registration of trademarks by providing for the establishment of an electronic system and an electronic database by the competent ministry (Ministry of Economy) to make available to the public to register and renew the trademark and complete the necessary procedures for it electronically. In general, registration of the trademark requires that the trademark meet the substantive requirements of excellence, novelty and legitimacy, therefore, we shall not separate the registration requirement from those substantive requirements. Article (3) of the UAE Law affirms that it is neither a trademark nor a part thereof and will not be registered as a trademark in many cases, including the said text, first, it should be free of any distinctive character, while for recentness condition, the Trademark is considered of loss of the said requirement, if it is established that it has already been used or registered by another person to distinguish his/her products or services, the intended recentness is not concerned with the absolute recentness, but comparative one, and if it has already been used to distinguish another type of goods or services, this will not prejudice the said requirement, as well as recentness requirement is being fulfilled, even if the trademark of the same category of goods or services has already been used during the period during which the period of legal protection of the trademark has expired without being renewed by its owner, which is defined by UAE law in Article (21) by 10 years from the date of submission of registration application, or the owner has requested the cancellation of its registration after five years from the date of registration or his/her explicit or implied consent to its use by the person in whose name it was registered, as provided for in article (18/2) of the said legislation.

Based on the foregoing regarding the recentness' condition as an objective requirement for the possibility of registration of the trademark, albeit famous even before submitting its application for registration, furthermore, if this well-known trademark was taken as a website address prior to its registration would constitute an obstacle for its registration and thus preclude the establishment of the right of ownership. This problem requires a legislative solution in UAE law by providing for the possibility of registering a famous trademark, although it has been used in the digital environment as a website address for the promotion of goods or services from the owner of the website for the Trademark's fame.

Moreover, the trademark must also have the character of legality, so that if the trademark violates public morals or public order, this prohibits its registration (The Federal Decree-Law no. 36 of 2021, article 3/2), and it must be noted that the UAE legislation referred to above in article (4/1) prohibits registering the famous trademarks unless the trademark owner has requested or agreed to the registration.

The question we ask is, what are the rights of the trademark's owner in UAE law when the trademark is abused by others before it is registered?

We must clarify that the Emirati legislator in Article (6) has not appointed persons who have the right to submit a trademark registration application including electronic trademarks, which means that the right to apply for registration will be established for any natural or legal person who claims to be the owner of traded trademark or intending to be traded by that person, whether or not was a trader, whether Emirati or a foreigner.

The position of countries differs in their legislation from the reason for acquiring the right to own the trademark. Some of these countries establishes its ownership on pre-usage, such as the United States of America, while others attribute the ownership of the trademark to the primacy of registration, including the United Arab Emirates. Some countries have a mixed approach between the two methodologies where ownership of the trademark is linked to the usage and the presumption of registration (Basam, 2015). To answer the above question, we consider that the failure to register the electronic mark in the United Arab Emirates would not be precluded from impeding the return of the aggrieved person from the act of infringement on a particular trademark by compensation based on the unlawful competition action against the perpetrator of the infringement act regardless of whether or not the plaintiff is a trademark owner of the registration.

A trader who makes commercial transactions of goods or services characterized by a well-known electronic trademark, will be affected by unlawful competition in case that a person imitates that trademark by placing it on goods or services similar to the original or taking a website address to promote goods or services. This applies to those who had a beneficial right from a well-known electronic trademark under a license contract from its owner or even the affected is a consumer because of counterfeit acts targeting famous electronic trademarks, and we will examine that claim in more detail in the arbitration provision section issued in well-known electronic trademark disputes. The legal protection of a trademark may also be attributed to general rules of civil liability, since in the case of agreement between traders not to compete, the dispute is based on contractual liability (prohibited competition).

SETTLEMENT OF DISPUTES BY ARBITRATION

Despite the direction towards broader choice of arbitration as a method of settling commercial disputes, the arbitration legislation agreed to limit the nature of disputes that could be settled by arbitration, including that the subject matter of the dispute should not be linked to the State's public order, and the prohibition of agreement on arbitration in matters where no reconciliation may be granted (The Federal Arbitration Act no 6, 2018, article no 4/2), and there was a disagreement of views on specifically considering trademarks 'issue which is one of the foundations of industrial property, and it is one of the issues related to public order and specifically to what is known as public economic order, while another direction considers that industrial property and trademarks are linked to public order (Kawthar, 2007), and disputes may not be settled by arbitration, as industrial property rights and trademark rights are a privilege granted by the public authority of the State to individuals to support and develop economic development, so individuals may not subject trademark disputes to arbitration as a substitute for the judiciary and in particular disputes relating to the validity of trademark bases, and in the opposite direction, those who support the fact that trademark disputes, in particular trademark investment disputes, can be settled through arbitration, because individuals and on the basis are eligible to engage in legal proceedings within the framework of investment in trademarks. as well as the absence of a public interest element in those legal relations, which constitute the basis and foundation of the country's public order, so, disputes arising from the counterfeit of trademarks, in which the penal element is negated and the imitator's liability represented at the limits of civil liability, are naturally can be arbitral, unless the fact of the counterfeit act is a penal element. In this case, penal lawsuit must be instituted against the perpetrator and, of course, the case cannot be arbitrated. And even that disputes over the validity of trademark's bases are also arbitrable because they are not linked to public order, noting that the arbitral award has a relative authenticity and limited to the parties to the dispute, while the judicature in the dispute of the validity of the trademark's basis has an absolute argument that applies erga omnes (Nadia, 2009).

To resolve the controversy over the arbitrability of trademark disputes, including well-known ones, I suggested that the Emirati legislature should amend the text of the article (48) of the Federal Trademark Act No. (36) 2021, which authorized the owner of the trademark to file a law suit before the Civil Court claiming compensation for damages arising out of the abuse of his right, and this does not prevent the Trademark owner the right to have recourse to the judiciary and to be able to arbitrate a dispute relating to a private interest which is not linked to

public order and which is the interest of the trademark owner affected by the abuse of his right to claim compensation.

SETTLEMENT OF ELECTRONIC WELL-KNOWN TRADEMARKS

The common element of most electronic well-known trademark disputes is the similarity or conformity between the names of such trademarks and the addresses of the websites available in the digital environment. So, the reasons and motives for such similarity or conformity and the role of arbitration in the settlement of such disputes must be highlighted.

DISPUTE OVER THE CONFORMITY BETWEEN THE WELL-KNOWN TRADEMARK AND THE ADDRESS OF A WEBSITE CYBERSQUATTING

The rule is that the trademark is registered to represent a category of products, goods and services represented by that trademark under certain conditions which guarantee that the same trademark is not previously used for identical or similar goods or services. In return, the electronic address is registered on the terms simpler than that of the trademark registration, where it is not requested to specify the products or services for which the website will be registered, as the electronic addresses have their own specificity, as they are distinguished from trademarks in general and well-known trademarks in particular, that the right to the website is not considered an intellectual property or industrial property type, and is subject to a completely different legal system from the legal system to which trademarks are subject, where websites registration is based on the principle of precedence only, so that the role of website registration offices is limited to ensuring that the name of the website has not been used before. (the principle of precedence in registration - the principle of *lex specialis*) and on that basis, legal protection in the dispute between several companies using a trademark of certain goods or services is given to the company that preceded others in registering that trademark for its website in the digital environment.

Some people may initiate a website with a famous trademark name before the owner of that trademark creates a website with his trademark name, which prevents the owners of famous brands from creating websites with their brand names, as the hacker deliberately causes confusion and illusion in the minds of the consumer, when he/she deliberately selects a famous brand such as CACHAREL or LANCOME and registers electronic addresses bearing the names of those famous trademarks. For this reason, prior to the emergence of the Uniform Domain-Name Dispute Resolution Policy, owners of trademark companies were obliged to pay big

amounts to the owners of such websites to relinquish those websites of the well-known trademark names for reputation concern of the well-known trademark (Mohammad, 2009).

This harmful act, which involves infringement of the trademarks' ownership that are usually famous, is done by persons with the intention of prejudicing the famous trademark by preventing them from creating a website for their registered trademark and bargaining with the owners for substantial sums of money in exchange for waiving the website bearing the name of the well-known trademark or selling that website to competing businesses (Ehab, 2008). One of the practical applications referred to is the payment by McDonalds of a substantial amount of money to a journalist working in an American magazine who created a website bearing the company's trademark, so that McDonald can retrieve that website (Husain, 2009).

In fact, the bad faith of the infringer on the well-known trademark, which tended to be resold to the owner of the same trademark, can be inferred from the presumption of the trademark's reputation, which was registered as a name of a website (Faisal, 2004), this presumption was confirmed by the WIPO in its 2002 judgment of VYARENT SPORTS. COM.

THE ROLE OF ARBITRATION IN ADAPTING WELL-KNOWN TRADEMARK DISPUTES IN THE ELECTRONIC FIELD.

If the infringement in the electronic scope on a well-known trademark constitutes an offence under the Penal Code, arbitration in this case does not settle this dispute (Tranh 2023), as the subject matter of the dispute constitutes penal action which precludes the possibility of such dispute or litigation being arbitrated, Although there are recent directions for arbitration to play a role in the settlement of penal disputes in minor crimes (petty offences), and in case that the infringement on a certain well-known trademark in the digital environment caused harm to the owner of that trademark, though, the civil legal protection of the trademark must be activated (Baa 2022), and in case that the parties to a dispute have agreed to resort to arbitration as a means of settling the dispute, the arbitral tribunal could adapt the case as an unlawful competition case, provided that there was commercial competition for trademarks in general, that both parties to the dispute were engaged in the same business or that their activities were somewhat similar, when a well-known trademark is used for a particular website specialized in the promotion of a type of goods or services similar to goods or services bearing the famous brand subject of the infringement, Bearing in mind that the principle of personalization and its content extends the legal protection of trademarks of goods and services identified only in a trademark registration application to protect consumers' rights by preventing any situation that

would mislead such consumers. In this regard, we must affirm our view that a well-known trademark is a situation that should be excluded from the principle of personalization referred to, where the scope of the Trademark's civil protection as it is a well-known trademark extends to non-registered goods and services, and what supports the aforementioned view, is TRIPS Convention in Article (16/2) which excluded well-known trademarks from the personalization principle by stating that the scope of legal protection of a well-known trademark is not limited to the scope of goods and services represented by that trademark, but extends to other goods and services, provided that a link must be provided between the goods and products to be distinguished from those represented by the well-known trademark, as well as that the use of the well-known trademark by the non-owner of the trademark, ends in tort to the owner of that trademark, and what confirms our opinion is what the UAE legislator went to in the text of the article (4/3) of Federal Decree No. 36 of 2021 on trademarks, which prohibited the registration of a well-known trademark to distinguish goods or services that are not identical or similar to those that bear the well-known trademark in two cases:

- If the use of the trademark indicates a link between the goods or services required to be distinguished and the well-known trademark owner's goods or services.
- If the use of the trademark would damage the interests of the owner of the well-known trademark.

The same orientation adopted by UAE law, has already been addressed by the French legislator in article (713/5) of the Intellectual Property Act No. (92-597) July 1st, 1992. “Copies or counterfeit of the well-known trademark for products or services that are not similar to those registered in its application for registration lead to the civil liability of the agent doer”, as we can see, the French legislator has added a third criterion to the criteria that the user of the well-known trademark which is owned by others must be held accountable, which is the criterion that the use of that trademark is unjustified, This criterion is broader in according to our view than the criterion of damaging the interests of the owner of the trademark resulting from the use of the trademark than its owner, as well as this criterion accommodates wider cases than of infringement of well-known trademarks, whether or not accompanied by damage, and this criterion would also exempt the owner of the well-known trademark from proving damage before the arbitral tribunal when considering the well-known trademark dispute, and several judicial judgments have been issued establishing the liability of a well-known trademark user as a website address irrespective of the requirement of similarity or conformity between the

goods and services provided on the website and those that the trademark has been registered to distinguish them from others (Danielson, 2001).

One of the unjustified usage criterion application for well-known trademarks is the WIPO Judgment in 2002 concerning TOYOTA as a well-known Trademark Registration Case as an address for Toyota website www.toyota.com by a person who did not own that trademark, which stated that the website was identical to the well-known trademark and that the owner of the website (The arbitration against him) has no legitimate rights or interests justifying the use of the disputed trademark, which was used by the user of the website in conjunction with bad faith.

When considering well-known trademark disputes, the arbitral tribunal shall not return the arbitrator's application even if the website was registered earlier on the registration of the trademark, the U.S. Trademark Act provides in the article (43) over civil protection to unregistered trademarks, the article establishes civil liability on the basis of unlawful competition. The trademark may be popular and used by its owner without being registered, and another person registers a website with that trademark with he knows about the usage and reputation of this trademark, in this case, the owner of the website will be in bad faith. The American legislator's note is worthy of support, as the registration of the trademark does not represent a right's base to own the trademark but a disclosure of it, especially if the trademark is well-known, and by reference to the position of UAE law, registration of the trademark and the issuance of a certificate of ownership provide that trademark with retroactive legal protection starting from the date of submission of the registration application as stated in article (21/1) A paragraph should be added in the exception of the well-known trademark from the text of the said article by including legal protection once used and even before the application is submitted for registration, in order to take into account the notoriety of certain trademarks.

The reputation of the trademark as previously indicated is a presumption of the bad faith of the owner of the website who used that trademark as a name of the website which was registered in the digital environment, while the arbitral tribunal's direction should be towards the good faith presumption of the respondent, in the case preceding the registration of the website, and the date of registration of the trademark, if the trademark of the dispute is not well-known, the non-registration and non-prominence of a trademark must eliminate that trademark's legal existence from the law perspective, thereby excluding the legal protection of such trademarks.

CONCLUSION

In conclusion, I would like to demonstrate the most important recommendations that I have found through researching Arbitration aspects in the civil protection of the well-known trademark owner's right against infringement in the digital environment:

- Recentness's requirement of substantive requirements required for the purpose of trademark registration, albeit it was well-known. At the same time, if this well-known trademark were taken as a website address, it would be precluded from accepting the registration of the trademark and thereby from proving the right to own it, so, this problem in UAE law is suggested to be resolved by stipulating the possibility of registering the well-known trademark, although it has been used in the digital environment as an address for a website to promote goods or services in cases involving exploitation of the trademark's reputation by the owner of the website.

- To resolve the controversy over the arbitration of trademark disputes, including well-known ones, I suggest that the UAE legislator amend article (48) of the Federal Trademark Act No. (36) 2021, which authorized the owner of the trademark to file a case before the Civil Court claiming for damages arising out of the infringement of his right, by not limiting the trademark owner's right to have recourse to the judiciary and enables him access to arbitration in a dispute relating to a personal interest not related to public order, which is the interest of the trademark's owner affected by the infringement of his right to claim compensation.

- UAE legislator in Article (4/3) of Federal Decree No. 36 of 2021 on trademarks which prohibited the registration of a well-known trademark to distinguish goods or services that are not identical or similar to those that bear the well-known trademark in two cases:

1. If the use of the trademark indicates a link between the goods or services to be distinguished and the well-known trademark owner's goods or services.
2. If the use of the trademark would harm the interests of the well-known trademark's owner.

- And I suggest here that a third criterion should be added to the criteria that the user of the well-known trademark which is owned by others must be accountable, which is the criterion that the use of that brand is unjustified, this criterion adopted by the French legislator is broader in our point of view than that of mere harm to the interests of the owner of the well-known trademark resulting from the use of the trademark by

others. This criterion encompasses wider cases of infringements on well-known trademarks, whether or not they are associated with damage, as well as this criterion would exempt the owner of the well-known trademark from proving the damage before the arbitral tribunal when considering the well-known trademark's dispute.

- Registration of the trademark and issuance of a certificate of ownership in Article (21/1) of the UAE Law provides that trademark with retroactive legal protection starting from the date of submission of the registration application, and a paragraph should be added with the exception of the well-known trademark from the said article by including legal protection once used and even before the application is submitted for registration, this takes into account the reputation of some trademarks but not others, requiring them to be customized with provisions that are commensurate with their privacy.

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