

Frequently Asked Questions (FAQs)

Trademark Protection in Saudi Arabia



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Trademark Protection in Saudi Arabia

1. What can registered as trademark in Saudi Arabia?

According to new GCC trademark law effective in Saudi Arabia from September 27, 2016, a trademark can be anything that takes a distinctive shape such as names, words, signatures, letters, symbols, numbers, titles, stamps, drawings, pictures, inscriptions, packaging, figurative elements, shapes or color, groups of colors, or combinations thereof, or any sign or a group of signs used or intended to be used to distinguish the goods or services of one undertaking from the goods or services of another undertaking or intended to identify a service or as a certification mark in respect of goods or services.

For the first time in history of Saudi trademark law, a sound mark or a smell mark can be registered as trademarks.

2. What cannot be registered as trademarks in Saudi Arabia?

The following may not be registered as a trademark or an element of a trademark:

- i. A mark which is devoid of any distinctive character or consists of representations that are no more customary names given by custom to goods and services, or conventional drawings and ordinary images of the goods.
- ii. Expressions, drawings or marks that contravenes public morals or public order. Public emblems, flags, military emblems and other insignia belonging to any of GCC states, other states, Arab or international organizations or any of their agencies, or any imitation of any of them.
- iii. Symbols the Red Crescent or Red Cross and any other similar symbols. As well as imitations of any of them.
- iv. Marks that are identical or similar to symbols of a purely religious nature.
- v. Geographic names, if their use is likely to cause confusion regarding the source or origin of the goods or services.
- vi. The name of another, surname, photograph or logo, unless he or his successors has previously consented to its use.

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- vii. Information relating to honorary or academic degrees which the applicant for registration cannot prove a legal entitlement.
- viii. Marks which are likely to mislead the public, or contain a false information as to the origin or source of the goods or services or their characteristics and other marks which contain a fictitious, imitated or forged commercial name.
- ix. Marks owned by natural or legal persons with whom dealing is banned pursuant to a decision issued in this respect by the competent authority.
- x. Marks that are identical or similar to a mark previously filed or registered by others in respect of the same goods or services or similar goods or services if the use of the mark to be registered would generate linkage with the other owner's registered goods or services or damage his interests.
- xi. Marks whose registration for some goods or services may reduce the value of the goods or services distinguished by the previous mark.
- xii. Marks which are copies, imitation or translation of a famous trademark or part thereof which is owned by others, to be used to distinguish goods or services identical or similar to those distinguished by the famous mark.
- xiii. Marks which are copies, imitation or translation of a famous trademark or an essential part thereof owned by others, to be used to distinguish goods or services not identical or similar to those distinguished by the famous mark, if such use indicates a connection between such goods and services and the famous mark and could likely damage the interests of the owner of the famous mark.
- xiv. Marks which contain the following words or phrases : "Patent", "Patented", "Registered" or "Registered drawing" or "copyright " or similar words and phrases.

3. How long it takes to register a trademark?

After introduction of online filing system, a trademark can be registered within 04 months.

According to the new-online filing system, in Saudi Arabia the goods and services can only be selected from a predefined list in the system. The list includes the exact detailed goods/services of each class as stated in the Tenth Edition of Nice Classification.

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Applicant may select the entire class heading or from the list. Alternatively, applicant may also select class heading together with the individual goods/services from the list. However, when a class heading is selected the entire class heading must be selected, parts of the class heading are not acceptable.

4. What is official cost of filing a trademark?

The official cost of filing a trademark upto issuance of certificate is USD 2,405.

5. What kind of power of attorney is required for filing a trademark?

A local agent/attorney requires a power of attorney whether a general or specific one before filing a trademark application. The power of attorney should be executed by an authorized signatory before a Notary Public and legalized up to the Saudi Consulate in the country of the applicant.

Applications are currently filed by uploading a copy of the power of attorney with the applicant details. Once the power of attorney is reviewed and approved, the trademark office issues a notice to file the application online.

6. What are other filing requirement?

The applicant's official name, address, nationality, line of business, description of the mark it intends to file, and the list of goods/services. A high-resolution image of the trademark in JPEG format. In the event of claiming priority, a certified copy of the priority application (without legalization) along with a simple English translation for the same should be sent to us.

Once the application is filed it will be assigned a filing number and date. Official fees may then be paid online where after the application will proceed to substantive examination. The timeframe for the above process varies between one and seven days.

7. Is multi-class filing possible in Saudi Arabia?

Under new trademark law there is a provision on multi-class filing but so far it is not clear how trademark office will implement this.

8. Can applicant claim right of priority from convention application?

Yes, Saudi Arabia is a member of Paris convention and accepts priorities from convention application.

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9. Is it mandatory to submit evidence of use of trademark during filing stage?

No, there is no such requirement.

10. Can a letter of consent or co-existence agreement overcome citation of earlier mark?

As of today (January 01, 2017), letters of consent or co-existence agreements are not acceptable to overcome citation of earlier similar marks. Even at court level, it is not accepted.

11. Where is appeal against refusal decision filed?

Under new trademark law, appeal is filed with Trademark Committee.

12. How much is term of protection for a trademark in Saudi Arabia, and how is it calculated?

Term of protection for a trademark registration is ten years. It is calculated on Hijra year basis which is 11 days shorter than Gregorian year. The date of filing is a starting point for calculation of duration of protection.

13. What is statutory publication period for accepted trademark?

Under new trademark law, publication period is reduced from 90 days to 60 days.

14. How a trademark is renewed in Saudi Arabia?

The Trade mark renewals can be filed up to one (1) year before the official renewal date. There is a six (6) month grace period for a later renewal, subject to payment of an extra official fee. There is no provision for restoration. A trade mark the registration of which has been cancelled (for any reason) may not be re-registered by a third party for the same or similar products or services unless three (3) years have elapsed from the cancellation date. A party may file an application for renewal of registration of a trade mark at any time during the last year of its protection.

15. What is acceptable basis for opposing a published trademark?

Earlier registered rights is a requirement to be successful in opposition cases. The only exception in case of un-registered rights is well-known mark.

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16. What is official cost of filing trademark opposition?

Official cost of filing opposition is USD 540. Additional cost of USD 270 will be payable for request of hearing.

17. Is it mandatory to register a trademark license?

No, it is not mandatory, but advisable to record a trademark license agreement.

18. What are consequences of non-recordal or registration of license?

Under new trademark law, there are no detrimental effects on non-recordal however it is highly advisable to record license agreements.

19. Can a trademark be assigned partially?

Yes, under new trademark it is possible to partially assign a registered trademark.

20. Who has right to initiate trademark infringement?

A trademark owner, and an exclusive licensee having right to initiate action provided in license agreement may sue for infringements.

21. Are there custom measures available for right holders to take actions on infringing goods?

Yes, custom border measure are clearly stipulated in Saudi trademark law, and is considered as in effective mechanism to seize counterfeit, and infringing goods. Custom departments may act ex-officio as well as upon complaint filed by the right holder.

One complaint in field while acting ex-officio, custom will seize suspected goods and send pictures of seized goods for verification of right holder or their registered agents.

22. Does custom protection measures require any formal trademark recordals with custom authorities?

Yes. Custom department has created a procedure for recordal of registered trademarks with custom authorities. Right holders can also organize training for custom officials enabling them to identify original and fake goods.

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23. Is there special protection for well-known marks?

Yes, under Saudi trademark law, well-known marks is recognized even if it is un-registered. Saudi courts in many cases recognized the protection of un-registered well-known marks.

24. How can right holder prove fame of a mark?

Fame of trademark can be established by submission of international registrations, registrations in Saudi Arabia, sales figures in Saudi Arabia, and proof of advertising and promotions in Saudi Arabia.

25. How the trademark office and court assess confusing similarity?

Different approaches are adopted from case to case. For example, confusing similarity is assessed on the basis of dominant part, overall similarity, and similarity of class. Occasionally, similarity of goods/services are also considered.

26. Which is competent forum to file trademark infringement case?

Infringement case can be filed with Saudi Courts. Administrative actions can be filed with Anti Commercial Fraud Department (ACFD).

27. Can an applicant acquire trademark registration for GCC region through single filing?

No, there is so far no such unitary trademark procedure in place. An applicant has to file separate national applications in each GCC member countries.

28. Is it possible to claim damages in trademark infringement cases? How much damages are awarded?

In theory, damages are possible to be recovered, however in practice it is very unlikely that Saudi court will award damages. Shariah (Islamic) law is applicable to calculation of damages, which requires cause and effect relationship between infringing activity, and actual damages caused as a direct result of such acts.

29. Is it mandatory to submit Arabic translation during filing trademark application and in infringement suits?

Saudi trademark office and courts will accept only Arabic documents or its Arabic translation through certified translators. This includes priority documents, power of attorney, and translation of certificates in other jurisdictions used as evidence.

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In addition, power of attorney requires legalization up to Saudi consulate.