

## Frequently Asked Questions (FAQs)

# A Saudi National Patent



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## Patent Protection in Saudi Arabia

### 1. What can be granted a patent in Saudi Arabia?

Any invention which fulfills requirements of patentability can be granted a patent. An invention to be patentable must fulfil following conditions:

- i. Novelty
- ii. Inventive Step
- iii. Industrial Applicability

### 2. What cannot be granted a patent in Saudi Arabia?

Saudi patent law clearly stipulates subject matters which are not patentable. The following cannot be protected as patents:

- i. Discoveries, scientific theories and mathematical methods.
- ii. Schemes, rules and methods of conducting commercial activities, exercising pure mental activities or playing a game.
- iii. Plants, animals and processes – which are mostly organic – used for the production of plants or animals, with the exception of micro-organisms, non-organic and microbiology processes.
- iv. Methods of surgical or therapeutic treatment of human or animal body and methods of diagnosis applied to human or animal bodies, with the exception of products used in any of these methods.

In addition, patent will not be granted if exploitation of patent contradicts with principles of Shariah (Islamic) law.

### 3. How long it takes to register a patent?

It may take 24 to 30 months for granting a patent filed with King Abdulaziz City of Science and Technology (KACST).

### 4. What is official cost of filing a patent upto grant?

Total official fee for grant of a patent excluding examination fee is USD 755 for applications filed by business entities. Official fee for applications filed by individuals is USD 380. Examination fee is calculated by patent examiner and communicated to an applicant.

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### 5. Is Saudi Arabia a member of Patent Cooperation Treaty?

Yes, Saudi Arabia is a member of Patent Cooperation Treaty (PCT) w.e.f August 03, 2013. The cost of obtaining a patent through national phase is same as a Saudi national application, however national phase PCT applications are granted relatively faster i.e within 22-24 months.

### 6. What kind of power of attorney is required for filing a patent through an agent?

A local agent/attorney requires a power of attorney whether a general or specific one before filing a patent 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.

In practice, power of attorney can be submitted within 03 months of filing application.

### 7. Can a patent be amended during prosecution in Saudi Arabia?

Yes, amendment can be made either a result of substantive examination or by submitting application to amend by applicant.

### 8. How many substantive examinations are conducted for patent application in Saudi Arabia?

Two substantive examinations are usually conducted. The applicant is provided chance to amend application upto second examination report. After second examination, decision will be issued by KACST.

### 9. Can applicant claim right of priority from convention application?

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

### 10. What is the limit on number of claims?

There is no such requirement. However, there shall be at least one independent claim in application.

### 11. Can a divisional application be filed in Saudi Arabia?

Yes, divisional application can be filed in Saudi Arabia by claiming priority of original application before decision to grant of original application is taken by the patent office.

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### 12. Can applicant withdraw pending patent application?

Yes. A pending patent application can be withdrawn before final decision to grant or refusal is taken.

### 13. Where is appeal against refusal decision filed?

Appeal against refusal decision can be filed with a specialized quasi-judicial Patent Dispute Committee.

### 14. What is term of protection for a patent in Saudi Arabia, and how is it calculated?

Term of protection for a patent is twenty years. It is calculated from date of filing a Saudi patent application.

### 15. What is term of protection for a national phase patent under PCT, and how is it calculated?

Term of protection for PCT national phase application will also be twenty years. The term will be calculated from filing date of international patent application.

### 16. Can a patent be amended during appeal stage?

No. In practice it is not possible to amend a patent application during appeal stage. This is equally applicable to appeal before a Saudi court upto any level.

### 17. Can a lapsed patent be restored under Saudi patent law?

Under new Saudi patent regulations, there are provisions for restoration of a patent application in Saudi Arabia. Saudi Arabia is also a member of Patent Law Treaty and as such restoration provisions of treaty can also be relied to restore a patent application.

### 18. What is the procedure for payment of annuities for national patent in Saudi Arabia?

Annuities are paid from the year following the application filing year. An applicant must pay annuity from January 01 to March 31 in the following year.

### 19. What is the procedure for payment of annuities for a national phase PCT application in Saudi Arabia?

Annuities are paid from the year following the application filing year. The annuity in following year shall include annuity from international filing date of PCT application. An applicant must pay annuity from January 01 to March 31 in the following year.

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**20. It is possible to extend patent term due to delay caused by patent office?**

There is no provision on patent term extension in Saudi Arabia.

**21. In event of more than one application for same subject matter created independently by both applicants, what is rule of priority of ownership?**

Saudi Arabia follows first to file rule. Priority will be given to an applicant who files first application with KACST.

**22. Is there procedure in place for expediting processing of a patent application by paying additional fee?**

No. There is no such procedure in place. The concept of patent prosecution highway is not available in Saudi Arabia.

**23. Is it mandatory to register a patent license?**

No, it is not mandatory under Saudi patent law to record a license, but in view of detrimental effects of non-recordal, it is highly advisable to record a patent license agreement.

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

Non-recorded license will not be effective vis-à-vis third party in Saudi Arabia.

**25. Can a patent be assigned partially?**

Yes, it is possible to partially assign a patent.

**26. Who has right to initiate patent infringement?**

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

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

Custom procedures are not available for a patentee, however patent dispute committee is competent to issue any type of interim orders to stop infringing activities.

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**28. Which is the competent forum for hearing patent disputes?**

Patent dispute committee is competent to hear patent infringements, and invalidity actions.

**29. Can invalidity proceedings be filed by any interested party?**

Yes. Invalidity proceedings can be initiated by interested party either as a fresh suit or as a defense in infringement cases.

**30. Does the court or patent committee appoints experts for deciding on technical matters?**

Under Saudi Patent law, dispute committee or courts can appoint experts for deciding on technical matters.

**31. Are there administrative procedures available for patent infringement cases?**

No. For patents infringements, there are no administrative procedures.

**32. Can an applicant acquire patent registration for GCC region through single filing?**

Yes, a unitary GCC patent can be acquired by filing a single patent application with GCC patent office in Riyadh. Patent granted by the GCC patent office will be equally protected in all GCC member countries. Current GCC member states are Saudi Arabia, Bahrain, Kuwait, United Arab Emirates, Qatar, and Oman.

**33. Is it possible to claim damages in patent infringement cases? How much damages are awarded?**

In theory, damages are possible to be recovered, however in practice it is very unlikely that patent dispute committee or 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.

**34. Is it mandatory to submit Arabic translation during filing patent application and in infringement suits?**

Saudi patent office, dispute committee and courts will accept only Arabic documents or its Arabic translation by a certified translator. This includes priority documents, power of attorney, and translation of certificates in other jurisdictions used as evidence.