

Trademark Law

We, Fahad Ben Abdul Aziz Al Saud Monarch of the Kingdom of Saudi Arabia,
Having perused Articles 19 and 20 of the Council of Minister's law enacted by Royal Decree No. 38 dated 22.10.1377 AH;

Having perused the Trademarks Registration Law enacted by Royal Decree No. 8762 dated 28.7.1358 AH;

Having perused the Resolution of the Council of Ministers No. 75 dated 13.4.1404 AH;
Have decreed the following:

First: The Law of Trademarks in the form attached hereto is hereby approved;

Second: H.H. The Deputy Chairman of the Council of Ministers and the Ministers each as concerned shall implement this decree of ours.

The Saudi legislator regulates recently the trademarks law pursuant to the Royal Decree No. M/5 issued on 4/5/1404 AH. Its provisions defined the meaning of the trademarks as well as the marks registration procedures, publication, the renewal of registration and its cancellation, the transfer of ownership, mortgage, licence agreements for using the mark, the group mark, the competent authority to solve disputes peculiar to marks and finally the prescribed fees, offences and penalties concerning the disputes peculiar to the mark.

Part I General Provisions

Article (1)

In implementing the provisions of this law, trademarks shall be names of distinct shapes, signatures, words, letters, numbers, drawings, symbols, stamps, and prominent inscriptions or any other sign or combination thereof that are suitable to distinguish industrial, commercial, vocational or agricultural products, or projects to exploit forests or natural resources or to indicate that the item on which the mark is carried belongs to the owner of the mark on the grounds of manufacture, selection and invention thereof or trading therewith or to indicate the rendering go a certain service.

Article (2)

In implementing the provisions of this law, the following shall not be considered trademarks:

1. Signs without any specific distinction which are only descriptions of the characteristics of the products or services or which are no more than ordinary names which are by custom given to the products or services.
2. Any expression, sign or drawing contradictory to religious rites or which is identical or similar to symbols of a purely religious nature.
3. Every expression, sign or drawing contradictory to public rules or public morality.
4. Public emblems, flags and other signs, names and epithets pertaining to the Kingdom (of Saudi Arabia) or any of the countries with which it has reciprocal treatment, or pertaining to an international or governmental body or any imitation of these emblems, flags, symbols, names and epithets.
5. Official signs and stamps of the Kingdom and the countries and bodies referred to in the previous paragraph and which infer the owner's control over products and services or the guarantee thereof, unless otherwise permitted by the competent authority.

6. Geographical names if their use causes misconceptions as to the source of the products or services or origin thereof, or if their use would entail a monopoly of the source or the name of the origin without any justification.
7. Pictures or names of others unless they or their heirs agree to this use.
8. Statements related to honorary degrees.
9. Statement that are bound to mislead the public or which contain false statements as to the origin or other descriptions of the products or services as well as marks containing a fictitious commercial name or an imitation or forged name.
10. Marks identical with or similar to internationally known marks even if they are not registered in the Kingdom.
11. Marks owned by natural or juristic individuals or which belong to countries with whom dealings are prohibited in accordance with a resolution issued by the competent authority.
12. Signs identical or similar to marks already filed or registered by others regarding identical or similar products or services as well as signs whose registration for certain products or services would reduce the value or products or services of others.

Part II

Section I

Registration Procedures

Article (3)

A register shall be set up at the competent department of the Ministry of Commerce to be called "the Trademarks Register" wherein shall be recorded all registered trademarks or notices of assignment of ownership or transfer thereof or license to use, renew or delete trademarks as well as all the details provided for by the rules for implementation.

Article (4)

The following individuals shall value the right to register trademarks:

1. Natural or juristic persons of Saudi nationality.
2. Foreigners who customarily reside in the Kingdom and are permitted to engage in commercial or professional activities.
3. Foreigners who are nationals of countries that extend reciprocal treatment to the Kingdom.
4. Public organizations.

Article (5)

A registration application for every mark meeting the conditions specified in Article 1 of this law may be filed by the individual concerned if he is domiciled in the Kingdom, with the competent department of the Ministry of Commerce in accordance with conditions and procedures to be defined by the rules for implementation.

Article (6)

Application for the registration of a trademark may be made for one or more categories of products or services, but a separate application shall be submitted for each such category in accordance with the conditions and procedures laid down by the rules for implementation.

Article (7)

One application may be filed to register a group of marks if they are identical in essential elements and they differ only in ways which do not substantially affect their character such as their color, or the details of products or services related thereto provided that these products or services belong to the same category.

Article (8)

If two or more persons simultaneously apply to register the same mark or similar marks for the same category of products or services, the registration application shall be suspended until one of the applicants presents a written statement from the other (s) duly endorsed by the authorities to the effect that they forego their application, or pending a final judgment in favour of one of them by the Grievance Board.

Article (9)

If an applicant for registration of a trademark desires to enjoy the right of priority on the force of a previous application filed with another country which has reciprocal treatment with Kingdom, he must submit with his application a statement wherein he mentions the date and number of previous application and the name of the state wherein he filed the application. The applicant must also file a photocopy of the previous application duly endorsed by the competent authority in the country wherein it was lodged within six months from the date on which he files the registration application account of which he claims the priority right to the claim will be forfeited.

Article (10)

The competent department at the Ministry of Commerce may request the applicant to introduce any changes to the mark it deems necessary to distinguish it from others or explain it in a way that precludes and confusion between it and any other mark preceding it.

Part II

Section II

Publication & Registration Of Trademarks

Article (11)

The competent department at the Ministry of Commerce shall, within a period of thirty days after submission of an application, decide on the application if it meets the conditions and circumstances provided for in the law and the rules for implementation.

Article (12)

If the competent department is of the opinion that the registration application is not in accordance with the rules of this law, it must notify the applicant by registered mail, informing him that his application has been rejected and explaining therein the reasons for this rejection, or request him to meet the conditions or introduce the modifications it specifies.

Article (13)

If the applicant fails to respond to the competent department's request to meet the conditions or

effect the modifications within ninety days after his notification to this effect, his application shall be considered as rejected as of the date of expiration of the above period.

Article (14)

The party concerned may file an appeal of the decision rejecting his application within thirty days of the date of the notice thereof or from the date of expiration of the period specified in the previous article. The appeal shall be submitted to a committee which will be formed by a resolution of the Minister of Commerce.

If the committee issues a resolution rejecting the complaint, the party concerned shall have the right to appeal such a ruling to the Minister of Commerce within thirty days after his notification thereof in accordance with the conditions and procedures specified by the rules for implementation.

Article (15)

If registration of the mark is accepted, the competent department shall publish this registration in the manner of and according to the procedures specified by the rules for implementation and the applicant shall bear the costs of publication.

Article (16)

Interested parties shall have the right to object to the acceptance of the application within ninety days after the date of publication on the basis that such acceptance is contradictory to any provision of this law or its rules for implementation and could cause material or moral damage to the interests of the contestant.

Article (17)

The objection shall be submitted to the competent department at the Ministry of Commerce and the latter shall notify the registration applicant by registered letter of the objection and the reasons thereof. The applicant must reply in writing to the objection within the period specified by the rules for implementation; otherwise, he shall be deemed to have waived his application.

Article (18)

The committee provided for in Article 14 of this law shall have competence to decide on objections in accordance with conditions and procedures provided for in the rules for implementation.

Article (19)

The party concerned may appeal the resolutions issued by the Minister of Commerce in accordance with the provisions of Article 14, and the resolutions issued by the committee passed in accordance with the provisions of the preceding Article, to the Grievance Board within thirty days after he is notified by a registered letter of the resolutions.

Article (20)

The competent department shall register the mark in the register provided for in Article 3 of this

law once the decision accepting the registration of the mark becomes final or when a ruling to this effect is issued by the Grievance Board. The registration shall be effected in accordance with the conditions and procedures to be specified by the rules for implementation.

Article (21)

When registration is completed, the owner of the mark shall be given a certificate containing the details specified by the rules for implementation and in particular.

1. The serial number of the mark's registration.
2. The date of filing the registration application and dates of registration and priority, if any,
3. The commercial name or the name of the mark owner, his place of residence and nationality
4. A photo of the mark, and
5. Details of products or services and their categories for which the mark is registered,

Article (22)

The owner of the registered mark may request the competent department to introduce any additions or modifications thereon provided they do not substantially affect the character of the mark. Such a request shall be subject to all the conditions and procedures which govern original applications for registration.

Article (23)

Interested persons may view the register provided for in Article 3 of this law and request information form or photocopies of records therein.

Part II

Section III

Validity Of A Mark's Registration

Article (24)

The mark's registration shall be effective as from the date of submitting the application. This date shall be defined according to the regulations.

Article (25)

The one who registered a mark shall be considered the exclusive owner. The mark's ownership shall not be disputable if the one who registered the mark uses it for, at least, two consecutive years as from the date of registering it unless a decision against this was issued.

The mark's proprietor has the right to prevent others from using the mark or any other symbol which resembles it which may mislead the public as to the products or services which the mark was registered for as well as for the similar products and services.

Article (26)

The rights of the concerned person which resulted from the mark's registration are effective for ten years and for the other similar periods if he submits an application to renew its registration.

Part II
Section IV
Renewal Of Trademarks

Article (27)

A mark's owner may file an application for renewal of registration thereof during the final year of its period of protection under the conditions and procedures provided for in this law and its implementing regulations. He may not request the inclusion of any change to the mark or the list of products or services for which the mark is registered; nevertheless, the owner shall be permitted request the cancellation of any products or services on the list.

Article (28)

A mark shall be renewed without a new examination and the renewal of registration shall be published in accordance with conditions and procedures provided for in the implementing regulations.

Part III
Cancellation Of A Mark's Registration

Article (29)

The competent department or interested party may request cancellation of a mark's registration under the following conditions:

1. If the mark's owner does not use it in a serious manner for a period of five years in succession, unless the owner presents a reasonable excuse to justify it.
2. If the mark was registered in violation of public order and public morality.
3. If the mark was registered fraudulently or according to false information.

The Grievance Board shall have competence to decide requests for cancellation of registration.

Article (30)

A mark's registration shall be cancelled by law in the following two cases:

1. Marks whose registrations were not renewed in accordance with this law and its implementing regulations.
2. Marks owned by natural or juristic foreigners against whom a boycott order has been issued by the concerned authority.

Article (31)

If a mark is cancelled, it may not be registered for the benefit of others for the same products or services or for similar products or services until three years have passed from the date of cancellation.

Article (32)

Cancellation of registration shall be published in accordance with the procedures and conditions provided for in the implementing regulations. The cancellation shall take effect from the date of judgement by Grievance Board, or from the date of expiration of the protection period or from the date on which the boycott order was issued.

Part IV
Ownership Transfer, Mortgage & Seizure Of Trademarks

Article (33)

Ownership of a trademark may be transferred to others by any act of transaction of transferring ownership provided it is in a written form and provided it is not intended to mislead the public especially as far as the nature, origin, characteristics or performance of the products or services are concerned.

Article (34)

If ownership of the commercial premises or the investment project for which the mark is used to distinguish its products or services is transferred without transfer of the mark's ownership, the party to whom the mark continues to belong may continue to use it on products or services for which the mark was registered, unless otherwise is agreed.

Article (35)

Mortgage or confiscation of mark shall include the commercial premises or exploitation project whose products or services employ the mark to distinguish them. The Commercial premises or exploitation project may be mortgaged or confiscated without the trademark.

Article (36)

Transferring the ownership of a trademark, mortgage or confiscation shall not take effect as far as others are concerned save after publication thereof and its being entered in the register provided for in Article 3 of this law in accordance with the procedures and conditions enunciated in the implementing regulations.

Part V
Licence Contracts

Article (37)

A mark's owner may grant a license to natural or juristic persons to use it for all or part of the products or services registered under the mark. The mark's owner may permit other persons to use the same mark and he shall have the right to use it himself unless otherwise is agreed. The period of the licence may not exceed the protection period of the mark.

Article (38)

Licence contracts may not impose on the beneficiary restrictions not inherent in the rights conferred by virtue of the mark's registration or if the restrictions are unnecessary for safeguarding these rights.

The following conditions shall not be considered unlawful restrictions:

1. Specification of the scope and extent of the area or period for the use of the mark.
2. Conditions warranted by effective control of quality of the products or services.
3. Obligations imposed on the licensee to abstain from all deeds which could result in a defamation of the trademark.

Article (39)

The licence contract shall be in writing and the signatures, fingerprints, or stamps of the two parties to the contract shall be officially endorsed in accordance with the provisions of the implementing regulations.

Article (40)

The licence contract must be recorded in the register provided for in Article 3 of this law and the licence shall not take effect vis-à-vis third parties except after having it recorded in the register and publishing it in accordance with the procedures and conditions provided for in the implementing regulations.

Article (41)

The licensee may not assign the licence to others or grant sub-licences, unless otherwise is agreed.

Article (42)

The license registration shall be deleted from the register in accordance with a request by the mark's owner or the licensee after presenting evidence to prove the expiration or termination of the license.

The competent department must notify the other party about the request to delete the license and in this case the latter shall have the right to object to this before the committee provided for in Article 14 of this law in accordance with the procedures, conditions, and dates provided for in the implementing regulations. The decision of the committee may be contested before the Grievance Board.

Part VI Jointly Owned Trademarks

Article (43)

The Minister of Commerce may permit the registration of a mark which is owned jointly by natural or Juristic persons who are undertaking the control of specific products or services or inspection thereof as regards their origin, ingredients, method of manufacture or performance, or descriptions or any of the characteristics thereof.

Article (44)

The implementing regulations shall define the conditions and procedures for registration of jointly owned marks and the documents that should be presented on registration.

Article (45)

A non-renewed jointly owned mark may not be registered for the benefit of others with respect to identical or similar products or services.

Article (45) - Amended

The Grievance Board, in any civil or penal action, may confiscate the seized items or items which will be seized later according to the provisions of the trademarks law as well as deciding to sell these items and to subtract their price from the compensations or the penalties or it refers the price to the public treasury or uses it in the way which the Board deems fit.

Article (46)

The provisions of the law shall apply to the jointly owned marks as long as they do not contradict their special nature.

Part VII Fees

Article (47)

The fees due under the provisions of this law shall be determined as follows:

A) SR 1,000 for any one of the following:

1. Application to register a trademark for one category.
2. Application to register a jointly owned trademark for one category.
3. Request to examine a trademark for one category.
4. Viewing the register with respect to one trademark for one category.
5. Every photocopy taken from the records or the register with respect to one trademark for one category.
6. Application to enter the transfer or assignment of ownership for one trademark with respect to one category.
7. Application to license the use of a mark for one category as well as entering its mortgage in accordance with article 36 and 40 of the law.
8. Every amendment or addition to a mark for one category in accordance with Article 22 of the law.
9. Application to add to or alter any statement for which no fee is specified with respect to a mark for one category.

B) SR 3,000 for any of the following:

1. Application for temporary protection for a trademark of one category.
2. Registration of a trademark.
3. Renewal of registration of one trademark for one category.
4. Renewal of registration of a jointly owned trademark for one category.

These fees may be amended by a resolution of the Council of Ministers.

Article (48)

Applications and procedures for which fees are due in accordance with the previous article shall not be acceptable or effective save after payment of the established fee.

Part VIII Violations & Penalties

Article (49)

Without prejudice to any more severe penalty, a sentence of not more than one year in jail and a

fine not exceeding SR 50,000 or any one of the two penalties shall be given to:

1. Anyone who forges a registered mark or imitates it in any way that misleads the public and anyone who intentionally uses a forged or an imitated trademark.
2. Anyone who intentionally uses a trademark owned by someone else on his products or services.
3. Anyone who offers or presents for sale or sells, or possesses with the intention of selling, products carrying a forged or imitation mark, or a mark wrongfully presented or used with his knowledge, as well as anyone who knowingly offers to render services under such mark.

Article (50)

Without prejudice to any more severe punishment, an imprisonment of not more than three months and a fine of not more than SR 20,000 or any one of these two penalties shall be given to:

1. Anyone who uses an unregistered trademark in cases specified in Paragraphs 2, 3, 4 and 5 of Article 2.
2. Anyone who wrongfully inscribes on his trademarks or papers statements that would lead to the conviction that they have been registered.

Article (51)

An habitual violator shall be penalized with a punishment not exceeding double the maximum penalty specified for the violation along with the closure of the commercial premises or project for a period of not less than 15 days and not more than six months and the publication of the judgement at the expense of the violator in accordance with the conditions and procedures provided for in the implementing regulations.

Article (52)

Any habitual violator under the provisions of this law means someone who has been convicted of any of the violations specified herein and commits a similar offense within three years after a final judgement was passed on him for the previous offense.
"Similar offences" shall be those specified in Article 49 and 50.

Article (53)

The public right claim shall be time barred after the expiration of three years from the date the offense was committed if no investigative or prosecuting procedures have been taken. The fact that public rights are time barred shall not prejudice private rights.

Article (54)

Parties injured as a result of a violation specified in this law shall be entitled to claim suitable compensation for the damages sustained from those responsible for this violation.

Article (55)

An owner of a mark shall, at any time even before the investigation of any civil or criminal suit, obtain -- on the basis of a petition supported by an official certificate proving the mark's registration -- an order from the Grievance Board to adopt the necessary precautionary measures, and especially:

a) The preparation of a list giving details and descriptions of equipment and articles which are or were used in committing the violation and the local and imported products or goods and papers on which the mark was used.

b) Seizure of the items referred to in the previous paragraph provided that seizure thereof does not take place until after submission of a deposit by the party requesting seizure to be preliminary estimated by the Grievance Board and to compensate the party against whom the seizure is effected if the need arises.

It is possible after imposition of the seizure to contest the adequacy of the deposit made by the owner in accordance with the conditions and procedures provided for in the implementing regulations. The order issued by the Grievance Board may include the assignment of one or more experts to assist the authority specified by the implementing regulations to carry out the seizure proceedings.

Article (56)

The precautionary measures taken by the mark's owner shall be considered as null and void if not followed by a civil or criminal suit against the party subject to these measures within ten days after issuance of the said order.

Article (57)

The defendant may file a suit against the ill-intentioned plaintiff requesting compensation to which he might be entitled as a result of the measures taken by the Plaintiff as provided for in Article 55 within 90 days after expiration of the period provided for in Article 56 if the party making the seizure does not cancel his suit or from the date on which a final judgement was issued on the seizure's suit related to the mark.

In all cases the deposit shall not be paid to the seizure except after issuance of a final judgement on the suit of the party against whom the seizure is effected, or after expiration of the period fixed for the same with withdrawal thereof unless the judgement issued on the suit of the seizure includes a settlement of the issue of the deposit.

Article (58)

The Grievance Board may, in any civil or criminal suit, issue a judgement to confiscate the seized items or those items to be seized afterwards in order to deduct the value thereof from the compensations or fines or to dispose of them in accordance with the conditions and procedures provided for by the implementing regulations.

The Grievance Board may order the publication of the judgement in one or more newspapers at the expense of the guilty party. It may also order the destruction of the forged or imitation marks or those marks wrongfully placed or used and order, when necessary, the destruction of the items carrying such marks even if a judgement of acquittal is reached.

Part IX Concluding Provisions

Article (59)

The Grievance Board shall have jurisdiction over all civil, and criminal suits and disputes arising out of the implementation of this law as well as the imposition of the penalties specified herein for the violation of the provisions hereof.

Article (60)

The Minister of Commerce shall specify the authority through which the criminal suit can be investigated and the department which will follow its proceedings and represent the public cause. The rules for implementation shall provide the rules to give the temporary protection necessary for any mark used on products or services on display at national or international exhibitions held in the Kingdom or any of the countries which accord the Kingdom reciprocal treatment. Such exhibitions shall be designated by a resolution of the Minister of Commerce.

Article (62)

The employees appointed by the Minister of Commerce shall have the powers of the judicial inspection officers as far as the enforcement of this law is concerned.

Article (63)

The implementation regulations of this law shall be issued by a resolution of the Minister of Commerce and shall be published in the Official Gazette.

Article (64)

The Trademarks Law issued by Royal Decree No.8762 dated 28.7.1358 AH is hereby repealed.

Article (65)

This law shall be published in the Official Gazette and shall go into force one month after publication.