

# **The Implementing Regulations of the Trademarks Law of the Gulf Cooperation Council Countries**

Definitions, trademark registration procedures, trademark protection period, temporary protection of trademarks used in exhibitions, trademark registration, trademark transfer, mortgage and seizure, licensing contracts, collective marks, General Provisions, Table of Fees for Trademarks in Saudi Riyal or its equivalent in the currencies of the rest of the GCC States.

The English translation is prepared for convenience. For all purposes, the Arabic language version of these Laws and Regulations shall be the original, governing instrument. In the event of any conflict between the Arabic version of these Laws and Regulations and any subsequent translation into any other language, the Arabic language version shall govern and control.

## **Article One**

The words and phrases included in these Regulations shall have the meanings assigned for them in the GCC States Trademark Law. The following words and expressions shall have the meanings given below unless the context requires otherwise: Competent Department: The authority concerned with the registration of trademarks in each GCC state. Law: Trademarks Law of the GCC States. Grievance Committee: A committee formed by a decree issued by the competent minister to consider grievances. Priority: Referral to a previous application filed in one of the States.

## **Article Two**

The application for registering any trademarks shall be submitted on the form prepared for this purpose to the competent department by the concerned person if he has a domicile in the state or by his authorized agent in the state if recorded in the register of trademark registration agents, as determined by the competent department. The application shall be limited to the registration of a trademark of one category. The categories of products or services for which the trademark is required to be registered may be multiple in the same application with the approval of the competent department, in accordance with the International Classification of Goods and Services (Nice Classification) (NCL), as amended, and consistently with the general regime in each state.

## **Article Three**

The trademark registration application shall include the following data:

1. Photo of the trademark to be registered.
2. Name, address and nationality of the applicant. If the applicant is a legal person, then its name and address shall be mentioned.
3. Accurate description of trademark to be registered.
4. Products or services for which the trademark is to be registered, along with their categories.
5. Priority date and number and the state in which it was deposited (if any).

6. Signature of the applicant or his authorized agent. If the application is submitted by a legal person, the papers shall be signed by the authorized signatory and if submitted by an agent, his name and address shall be stated.

#### **Article Four**

The trademark registration application shall enclose the following:

1. Four photos of the trademark corresponding to the trademark form existent in the registration application.
2. If the application is submitted by an agent, a copy of the agency agreement shall be attached with the original for conformity. The original copy must be duly authenticated and certified and translated into Arabic.
3. Evidence to practicing the profession or activity.
4. Proof to the payment of the application prescribed fees.
5. If the trademark required to be registered includes one or more words written in a foreign language, the applicant must submit a certified translation into Arabic and indicate how to pronounce it/them.
6. Sound marks shall be provided in accordance with a musical note or a written description.
7. Smells marks shall be given in a written description.

#### **Article Five**

**A.** In case the applicant to register a trademark, or his successor, wishes to enjoy the right of priority on the basis of an earlier application filed in a state member in multilateral international agreement to which a GCC State is a party, the applicant shall have to attach to his application a statement indicating the date and number of the previous application and the state in which the application has been deposited, along with a copy of the previous application and a translation thereto into Arabic within six months from the date of submission of the previous registration application, for which he claims the right of priority, otherwise his right to claim it shall fall.

**B.** Original priority documents may be attached within three months from the date of submitting the application for registration.

#### **Article Six**

The competent department shall examine the trademark registration application and decide upon it within ninety days from the date of its submission, either by accepting it if it complies with the conditions and procedures stipulated in the Law and the Executive Regulation or by rejection. The competent department shall inform the applicant of its decision in writing or electronically according to the address specified by applicant. The competent department may request fulfilling the conditions or documents or may require introducing any amendments as necessary to modify the application, within ninety days from the date of notification thereof, otherwise it shall be deemed to have waived its application.

#### **Article Seven**

In case the competent department decided to reject or suspend the registration of the trademark on a certain condition, then the applicant or his representative may file a complaint

before the Grievance Committee within sixty days from the date of notifying him with the rejection decision.

#### **Article Eight**

The competent minister in each of the GCC States shall constitute a committee to consider the grievances. The relevant decree shall determine the number of the committee members, the duration of membership, its working system and the remuneration of its members.

#### **Article Nine**

The complainant shall be notified with the decision of the Grievance Committee in writing or electronically within thirty days from the date of its issuance and the complainant may appeal before the competent court within sixty days from the date of being notified with the same.

#### **Article Ten**

**A.** In case the application is accepted, the applicant or his agent shall pay the costs of publication within thirty days from the date of being notified with the acceptance decision, otherwise the application shall be considered as waived.

**B.** The published announcement shall include the following data:

1. Application number and date of submission.
2. Applicant name, address and nationality.
3. Trademark image.
4. Agent name and address.
5. Products or services for which the trademark shall be registered and their class.
6. Restrictions and requirements.
7. Priority date, number and the country where it was deposited (if any).

#### **Article 11**

The competent authority shall issue or specify a special statement for the trademarks, publishing all the provisions stipulated in the Trademark Law and its Executive Regulations.

#### **Article 12**

1. Any concerned party may submit a reasoned objection to the competent department to the registration of any trademark within sixty days from the date of its publication in the bulletin issued or determined by the competent authority, after the payment of the prescribed objection fee and according to the form prepared for that purpose.
2. The competent department shall notify the applicant with a copy of the objection within thirty days from the date of its submission.
3. The applicant shall submit to the competent department a written response to the objection within sixty days from the date of his being notified with the same, otherwise he shall be deemed to have waived his application.

#### **Article 13**

1. The competent department may set a hearing for the statements of the applicant and the objector, or one of them, at his request and to submit the supporting documents and notification of the same after payment of the prescribed fee.
2. The competent department shall notify both parties of its reasoned decision, including the restrictions and conditions it deems necessary within 90 days of the hearing.

#### **Article 14**

The decision to accept the registration is final sixty days after the publication of the declaration of the mark in the bulletin issued or determined by the competent authority without objection to its registration, or a final ruling in this regard from the competent court. The applicant shall pay the registration fee of the mark within thirty days from the date of issuance of the final decision to accept the registration of the mark, otherwise he shall be considered waive.

#### **Article 15**

The competent department shall register the trademark in the Trademarks Register and give its owner a registration certificate, which includes the following data:

1. Trademark number and date of registration.
2. Dates of starting and ending the trademark protection.
3. Priority date, number and country of deposit (if any).
4. Name, address, nationality and commercial name of the trademark owner (if any).
5. Trademark image.
6. Products or services for which the trademark and its category has been registered.
7. Restrictions and requirements (if any).

The registration of the trademark shall be effective as of the date of submitting the application recorded in the Trademarks Register.

#### **Article 16**

The owner of the registered trademark may request to amend the following data in the Trademarks register in accordance with the form prepared for that purpose, upon payment of the prescribed fees:

1. Name, address, occupation or nationality of the trademark owner. In case of the legal entity, every change in the name or address shall be recorded.
1. Writing off some goods and services for which the trademark is registered.
2. Change the agent name, address, or both.

The competent department shall prepare an announcement containing the amendment required in clauses (1) and (2) of this Article, to be published in the bulletin issued or determined by the competent authority after payment of the publishing costs. The same shall be marked in the Trademarks Register, providing the applicant with proof thereof.

#### **Article 17**

The trademark owner who wishes to continue to protect it shall submit an application on the form prepared for this purpose to the competent department, after payment of the prescribed fees, during the last year of its protection period and for the period of six months following the end of that protection.

### **Article 18**

Applications for renewing the protection period, which are accepted in form, shall be approved after payment of the due fees, without any further examination. The competent department shall announce the renewal, including the following data:

1. Trademark number and category.
2. Name, address and nationality of the trademark owner.

The competent department shall publish its announcement in the bulletin it issues or as determined by the competent authority after payment of the publishing costs. The same shall be marked in the Trademarks Register.

### **Article 19**

In case the owner of a trademark wishes to have temporary protection for his trademark for products or services presented at a national and international exhibition held in a GCC State, he shall notify the department competent for trademarks' registration in that state with his desire to exhibit at least one month before the opening of the exhibition. That notification shall be submitted on the form prepared for that purpose, accompanied by four photos of the trademark and a proof to the payment of the prescribed fee, provided that they meet the registration requirements stipulated in the Law and its Executive Regulations.

### **Article 20**

Trademark temporary protection applications used in the exhibitions shall be recorded in a special register named "Temporary Protection Register", which shall include the following data:

1. Temporary protection number
2. Date of application.
3. Exhibitor's name.
4. Exhibition title and date of its official opening.
5. Products or services for which the trademark is to be protected.

### **Article 21**

The competent department shall issue a certificate of temporary protection for the trademark used in the exhibitions for a period not exceeding six months from the date of opening the exhibition.

### **Article 22**

No temporary protection certificate, as provided for in the preceding Article, shall not be granted except in respect of exhibitions determined by an official decision.

### **Article 23**

Trademark registration shall be written off in accordance with the provisions of the Law. The competent department shall mark in the Trademark Register with the writing off of the registration and the same shall be announced in the bulletin issued or determined by the competent authority. The announcement shall include the following data:

1. Trademark photo.

2. Registered Trademark Number.
3. Name and nationality of the trademark owner.
4. Date and reason for writing off the trademark registration.

If the writing-off is taking place at the request of the trademark owner, it shall be submitted on the form prepared for this purpose after the payment of application fees and publishing costs, provided that the trademark is registered and validly protected.

#### **Article 24**

Trademarks may be transferred based in an application to be submitted to the competent department by the transferee or its authorized agent, upon payment of the prescribed fee and on the form prepared for that purpose, which includes the following data:

1. Registered Trademark number and category.
2. Name and address of the previous trademark owner.
3. Name of the person to whom the ownership of the trademark is transferred, along with its commercial name, if any, address and nationality.
4. Ownership transfer date and disposition or event at which the property was transferred.
5. If the application is submitted by an agent, his name and address shall be mentioned.

The application shall enclose the following documents, duly certified and authenticated and translated into Arabic:

1. Evidence to the transfer of ownership.
2. Evidence of the practiced activity.
3. The original agency document if the application is submitted by an agent.

#### **Article 25**

Without prejudice to the provisions of Article (5) of the Law, the heirs of the natural trademark owner may transfer the ownership in their name, together or to any of them, via a transfer documents signed by those who have rights in the trademark.

#### **Article 26**

The Competent Department shall prepare an announcement with the transfer of the trademark, to include the following data:

1. Registered trademark number and category.
2. Name of the trademark previous owner.
3. Transferee name, address and nationality.

The competent department shall publish the announcement in the bulletin issued or determined by the competent authority after payment of the publishing costs and marking the transfer of the trademark ownership in the Register.

#### **Article 27**

Mortgaging the trademark shall be affixed in the register in accordance with the same procedures and conditions for the transfer of ownership of the mark. Mortgage announcement shall include the same data provided for in Article (25) of these Regulations after payment of the prescribed fees.

### **Article 28**

Mortgaged trademark shall be released upon request submitted to the competent department by the trademark owner, attaching the documents proving the same, duly authenticated certified and translated into Arabic, after payment of the prescribed fees.

The competent department shall announce the release of the mortgage in the bulletin issued or determined by the competent authority after payment of the publishing costs. The same shall be marked in the register and the applicant shall be provided with a proof thereof.

### **Article 29**

Seizure of the registered trademark shall be marked in the register on the basis of a court order. That seizure shall not be canceled except by a final judicial ruling.

### **Article 30**

In case the registered trademark owner licenses a natural or legal person to use the trademark for all or some of the products or services registered therein, the license contract shall be in writing, duly authenticated, certified and translated if the original is not issued in Arabic language. In all cases, license term shall not exceed the determined period for the trademark protection.

### **Article 31**

The application for license registration shall be submitted to the competent department by the trademark owner or its authorized agent or the licensee according to the form prepared for this purpose after payment of the prescribed fee, which includes the following:

1. Registered trademark number.
2. Name and nationality of the trademark owner
3. Licensee name, address, place of residence and nationality.
4. Authorized Products and Services.
5. License commencement and expiration dates.
6. License geographical scope (if any).

The following documents shall be attached to the application, duly certified, authenticated and translated into Arabic:

1. License contract.
2. Original agency document.

### **Article 32**

The competent department shall mark in the Register licensing the use of the trademark and providing the applicant with proof of the same at his request. The competent department shall publish the relevant announcement in the bulletin issued or determined by the competent authority after payment of publishing costs. The announcement shall include the following data:

1. Trademark photo.
2. Registered Trademark number and date of registration.
3. Name, address and nationality of the trademark owner.
4. Name, address and nationality of the licensee.

5. Products or services licensed for use and their category.
6. License commencement and expiry date.
7. License geographical scope (if any).

### **Article 33**

Writing off the license registration shall be at a request submitted to the competent department by trademark owner or its authorized agent or licensee, attaching a proof of license termination or revocation, after payment of the prescribed fee.

The competent department shall notify the other party of the request to write off the registration in writing. In such case, the other party may appeal to the competent court within 30 days from the date of the writing off notification, submitting a copy of the objection and a proof to submitting it to the competent department. The writing off shall be suspended until the parties' agreement or a final judgment is issued by the court to that objection.

### **Article 34**

In the event of no objection to writing off the license or the issuance of a final judgment in the objection by the court, the competent department shall publish the cancellation in the bulletin issued by or determined by the competent authority after paying the publishing costs. Writing off the license shall be marked in the register, providing the applicant with a proof thereof.

### **Article 35**

In addition to the provisions of Articles 2 and 3 of these Regulations, the following requirements shall be attached to the application for registering a collective mark:

1. Indication in the registration application that it is a collective trademark.
2. A replica of the union, organization or public institution requesting the registration, along with the amendments that may have been made to it, including the following:
  - A. Statement of the category of persons entitled to use the trademark and their relationship with the applicant.
  - B. Copy of the requirements for the use of the collective trademark for goods and services.
  - C. Declaration that the applicant is or will strictly control the use of the collective trademark by its members.
  - D. Membership qualification in that entity.

3. All documents shall be duly authenticated, certified and translated into Arabic.

Publication and registration shall be affected by the same procedures provided for in Section Two of these Regulations.

### **Article 36**

In addition to the provisions of Articles 2 and 3 of these Regulations, the following requirements shall be attached to the application for registration of the control or inspection trademark:

1. Indication in the registration application that it is a control or inspection trademark.
2. A replica of the union, organization or public institution requesting the registration, along with the amendments that may have been made to it, including the following:



**A.** Acknowledgment that the control or inspection trademark shall be used by a person other than the applicant and that the applicant shall not engage in the marketing or production of any goods or services on which such trademark is used and shall not engage in discriminatory policies that would prevent the use of the trademark by third parties meeting the specifications set by the owner.

**B.** Acknowledgment that the control or inspection trademark certifies the quality, type or advantages of the goods or services and it does not indicate the origin of those goods or services.

**C.** Documents specifying the specifications and criteria applied by the entity that submitted the application for the purpose of controlling the use of the trademark and proving that the applicant is adopting an approved quality assessment program.

**D.** A certificate indicating the advantages of the goods or services approved or to be approved.

3. All documents shall be duly authenticated, certified and translated into Arabic. Publication and registration shall be affected by the same procedures provided for in Section Two of these Regulations.

#### **Article 37**

In case of applying for the registration of marks for non-commercial purposes, that shall be indicated in the application for registration, attaching the bylaws of the public interest or professional institution of the applicant. The trademark shall be published and registered by the same procedures provided for in Section Two of these Regulations.

#### **Article 38**

The competent authority shall prepare an announcement with the essence of judgment issued against the violator in case of a repeated violation, in accordance with the provisions of Article (43) of the Law, to be published at the expense of the violator in a conspicuous place in two widespread daily newspapers; one is in the territory where the violator's headquarters is located, if any.

#### **Article 39**

The competent authority may establish an electronic system and an electronic database to submit the applications for registration and renewal of the period of trademark protection and follow-up its procedures, adhering to the data mentioned in Article (3) of these Regulations.

#### **Article 40**

The fees payable shall be determined in accordance with the schedule annexed to these Regulations, and each State Member may impose other fees, in accordance with its established procedures.