This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Saudi Arabia.

For a full list of jurisdictional Q&As visit here.
1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

Saudi Arabia protects all forms of intellectual property rights including, Trademarks, Patents, Plant Variety, Integrated Circuits, Copyrights, trade secrets or confidential information, and Design rights. In case of Patents, Integrated Circuits, Plant Variety, Trademarks and Industrial Designs, registration is mandatory for protection. Copyrights does not require registration for protection as long as the work falls within the protectable subject matter. There are different ways and means to protect other un-registered rights including trade secrets or confidential information.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

At the outset it is important to mention that Patents and Trademarks is the most protected and litigated IP rights in Saudi Arabia, therefore most of our answers address these two types of IP rights. We will address other rights where the context of the question requires.

The non-renewable duration of a patent right and design rights is for 20 years and 10 years respectively from filing date.

Plant Variety Protection is for a period of 20 years and Integrated Circuit protection is 10 years from filing date.

Trademark rights are for a period of 10 years from filing date and it can be renewed for further 10 years. As long as the owner files renewal, there is no limit of maintaining trademark protection.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

Under Saudi Trademark Law, a trademark registrant is the owner of a trademark.

The inventor has right to file for patent protection. If the invention is created as a result of employment relationship, the employer will be the owner of patent unless there is contractual clause to the contrary.
For literary and artistic works, the author is owner of Copyright in work. Saudi Copyright Law does not clarify the question of ownership for commissioned work, therefore the understanding is that author can still claim rights unless the agreement clearly says otherwise.

4. **Which of the intellectual property rights described above are registered rights?**

The Trademark rights, Patent rights, Industrial Design rights, Integrated Circuits and Plant Variety protection are registered rights. In case of well-known trademarks, registration is not strictly necessary for enforcement of rights.

5. **Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?**

Subject to conditions of ownership as discussed above, any natural or legal person can apply for registration of intellectual property rights in Saudi Arabia.

Application for protection shall be filed with Saudi Authority for Intellectual Property (SAIP), a new authority for administration of all forms of IP rights, along with all required documents mentioned in the laws.

The Patent Application shall be accompanied by specifications, drawings, claims and description of patent and details of owners. Assignment document is always required in case applicant is not the inventor. A trademark application shall include goods or services, specification of class, representation of trademarks and details of owner. Power of Attorney legalized up to Saudi Consulate is also required.

6. **How long does the registration procedure usually take?**

The registration procedure for Trademark is fast track in Saudi Arabia after adopting online filing system. The trademark applications are examined within an average of 14 days from the filing date. If trademark application fulfils the conditions of registrability and there is no office action, registration certificate can be issued within 03 months from filing date. In case of office actions, it usually takes up to 04 months until issuance of certificate of registration.

In case of Patents, depending on nature of objections during substantive examination, the time frame may slightly vary. From the filing date of patent application, the grant of patent usually takes 2-3 years.

In case of Industrial Design, the registration can be registered within 5-6 months from filing date. In Saudi Arabia, there is no substantive examination of Industrial Design applications.
7. Do third parties have the right to take part in or comment on the registration process?

Third parties can file opposition against acceptance of trademark application. The law provides 60 days for third parties to file opposition against the publication of accepted mark. The 60 days period starts from publication date of accepted trademark application. Opposition can be filed based on legal justification, which can be prior use, an earlier registered trademark right or an earlier pending application in Saudi Arabia. Oppositions can also be filed based on rights established by unregistered well-known marks having fame in Saudi Arabia.

Patent and Industrial Design rights can be opposed after grant. Interested parties can file application for invalidation of Patent or Industrial Design with Saudi Patent Committee.

8. What (if any) steps can the applicant take if registration is refused?

Under the new Trademark Law, an appeal against the imposition of a condition by the Trademark Office or refusal decision can be filed before the Trademark Appeal Committee. The time limit is 60 days from issuance of the refusal decision or imposition of the condition. The decision of the Trademark Appeal Committee can be further subject to appeal by an aggrieved party to the Administrative Court within a 60-day period and decision of the Administrative Court can be challenged before Administrative Court of Appeal. A final appeal can be filed before the High Court on point of law only.

If the Saudi Patent Office refuses to grant Patent or Industrial Design rights, an applicant can file appeal before Saudi Patent Committee within 60 days period. The decision of the Saudi Patent Committee can be further appealed by an aggrieved party to the Administrative Court within a 60-day period and decision of the Administrative Court can be challenged before the Administrative Court of Appeal. A final appeal can be filed before the High Court on point of law only.

9. What are the current application and renewal fees for each of these intellectual property rights?

The total official fee from filing to registration of trademark application is USD 2405. Renewal fee is 2270.

The total fee for the grant of a patent, excluding the examination fee, is USD 755. The examination fee is calculated by the patent examiner and it depends on the volume of work estimated by the examiner. The patent office allows two substantive examinations. Saudi Arabia is also a member of the Patent Cooperation Treaty (PCT) with effect from 3 August
2013. The cost of obtaining a patent through national phase is the same as a Saudi national application. This cost does not include annuities and the cost of translations. The owner of Patent shall pay annuities each year to keep the patent active. The rate of annuities varies each year with total payable annuities upto USD 28035 for the entire term of protection which is 20 years.

For Industrial Design, the total official fee is USD 285. Annuities of USD 2400 shall also be paid every year upto ten years to keep the protection active.

10. **What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

The right holders lose the exclusive rights in its IP asset as a result of non-payment of renewal fee or annuities where applicable. In case of patents, application of restoration can be filed with SAIP alongwith justification for failure to pay annuity. The right holder cannot claim restoration as a matter of right however the SAIP may allow restoration.

11. **What are the requirements to assign ownership of each of the intellectual property rights described above?**

At the outset, it should be a registered right. There shall be written agreement with clear terms of assignment. Application of assignment alongwith copy of assignment shall be filed with IP office and official fee shall be paid at the time of filing.

12. **Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

It is mandatory to record assignment with respective IP office otherwise such assignment will not be effective vis-à-vis third parties.

13. **What are the requirements to licence a third party to use each of the intellectual property rights described above?**

License to use requires a written agreement clearly stipulating the scope of license. The terms of license shall not exceed the scope of rights provided by the law and shall not be anti-competitive.

14. **Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

Under the Saudi Trademark Law, the recordal of a licence is not mandatory, and it may or may not be recorded. Since recordal is not mandatory and the law does not clarify legal consequences of non-recordal, there is no downside of non-recordal. However Municipality staff usually requires evidence of recordal.
In case of Patent rights, recordal of license is mandatory. A license will not be effective vis-à-vis third party unless recorded with Saudi Patent Office.

15. **Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?**

The law does not distinguish between exclusive and non-exclusive licensee however in practice the terms of agreements vary. The IP owner can grant exclusive or non-exclusive rights to a licensee. In practice exclusive rights are generally granted to a single licensee in a certain market. Exclusive licensee also may have right to enforce its rights however such right should be clearly provided in the license agreement. A non-exclusive licensee can be more than one in a single market and usually non-exclusive licensee does not have right to enforce its license right against infringement of licensed IP by third parties.

16. **Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?**

The Trademark Law declares following certain acts as offences:

1. Counterfeiting or imitating a registered mark so as to mislead or confuse the public or using in bad faith any counterfeited or imitated mark.
2. Identifying one’s goods or services, in bad faith, with a mark owned by others.
3. Unlawfully inscribing upon one’s mark, papers or commercial documents, a representation that might lead to the belief that one has obtained registration of such mark.
4. Deliberately, and in bad faith, failing to affix one’s registered trademark on the goods or services it distinguishes.
5. Knowingly possessing tools or material intended to be used in the imitation of registered trademarks or famous trademarks.

Monetary punishments, depending on the offence committed, can be between USD 270 and USD 266,700. A recidivist may be handed double punishments, as provided for each specific offence, and may also be obliged to temporarily close his business.

Under the Patent Law, the law does not clearly provide criminal sanctions. The law imposes double financial penalty against repeat infringement of patent rights. The Saudi Patent Committee can refer a case to the court if there are criminal elements in the violation of Patent rights however it does not stipulate such criminal elements.

17. **What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.**

A trademark owner can initiate enforcement actions using any of the following two routes:
1. **Administrative Action before the Anti-Commercial Fraud Department (ACFD) in Riyadh.**
   A complaint should be filed in writing with all evidence of infringement and registered rights over the trademark. The location of infringing goods should also be provided to the ACFD.

2. **The Commercial Court also has jurisdiction over trademark infringement matters.** A statement of claims must be filed before the court in writing. There are no pre-trial procedures. In few cases, the Commercial Court refused to accept its jurisdiction over trademark infringement matters however these decisions are challenged before the higher courts.

In case of Patent and Industrial Design infringement, a statement of claim shall be filed with Saudi Patent Committee along with evidence. Saudi Patent Committee has exclusive jurisdiction to adjudicate Patent infringement cases. There are no administrative procedures in case of patent infringement.

18. **What is the length and cost of such procedures?**

   There is no court fee in Saudi Arabia. The length of Administrative proceedings in trademark cases is between 3-4 months. Court action may take up to 16 months.

   Depending on complexity of case, the Saudi Patent Committee may take 2-3 years to decide a case.

   Attorney fee may be in the range of USD 15000-25000.

19. **Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

   The Commercial Court has jurisdiction over trademark infringement matters. A statement of claims must be filed before the court in writing. There are no pre-trial procedures. In few cases, the Commercial Court refused to accept its jurisdiction over trademark infringement matters however these decisions are challenged before the higher courts. Decision of first instance court is appealable before Court of Appeal. Final appeal before the High Court can be filed only on question of law.

In case of Patent and Design rights, the Saudi Patent Committee has original jurisdiction. A statement of claims must be filed with Committee and there are no pre-trial procedures. Decision of Committee is appealable before Administrative Court of first instance. Decision of Administrative Court of first instance is appealable before the Court of Appeal. Final appeal before the High Court can be filed only on question of law.
20. **What customs procedures are available to stop the import and/or export of infringing goods?**

Custom procedure can be utilized by a registered trademark owner. Owner of trademark can record trademark with Saudi Customs for watch services. This procedure is very useful and efficient. Saudi Customs is very active in seizures of suspected consignment in coordination with right holders or its authorised representatives.

Kadasa Law Firm has signed Memorandum of Understanding (MoU) with Saudi Customs for cooperation in anti-counterfeiting activities.

21. **Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

No. Adopting Alternate Dispute Resolution is subject to agreement between parties.

22. **What options are available to settle intellectual property disputes?**

Parties are free to settle its dispute outside the court through mediation or arbitration either prior to court action or during the action should the parties wish to do so.

23. **What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?**

Any evidence which establishes that the infringing trademark is used in relation to goods and services protected by registered trademark is sufficient. In the context of Patent, the evidence shall establish that the alleged infringing product reads over the claims of granted patent. In case of pharmaceutical patent, laboratory analysis, for example drug load have been accepted as sufficient evidence. Expert reports may also be used.

24. **How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties’ expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

Discovery procedure is not available in Saudi Arabia. The court or the Saudi Patent Committee has authority to appoint Expert in any dispute. Witness evidence is not common in IP litigation however such evidence can be used. It is not possible to compel a party for
disclosure of any documents or information; however, each party must substantiate its claim with documentary support. The court has discretion to order any party for production of any document which in opinion of court is required for deciding the dispute.

25. **How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

Cross-examination is not practiced in Saudi Arabia. Saudi courts require written submissions and written responses to arguments of other party.

26. **What defences to infringement are available?**

Unlike some other jurisdictions, the Trademark Law does not specifically provide what would constitute non-infringement of a trademark; however, within the context of law, possible defences may include the following:

1. The defendant’s trademark is sufficiently distinguishable from the plaintiff’s mark. In practice, the defendant must prove that the difference between the two marks is significant, and that the dominant part of the plaintiff’s mark is not imitated.
2. The plaintiff’s trademark is subject to disclaimer, and such use does not constitute infringement.
3. The defendant is using the mark for goods or services which do not conflict with goods or services covered under a registered trademark.
4. The defendant’s use of the trademark is a descriptive use.

In the context of Patents, the available defence could be that the defendant started commercial exploitation of invention prior to filing date of patent application or priority application. Another defence could be that the product of defendant does not read over the protected features (claims) of patent.

27. **Who can challenge each of the intellectual property rights described above?**

For opposition proceedings, please refer to answers in question 7 & 8. Any interested natural or legal person can challenge the validity of a trademark and Patents.

28. **When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?**

For opposition proceedings, please refer to answers in question 7 & 8. Invalidation action against a trademark must be filed within 05 years of registration. Cancellation action for non-use can be filed after each consecutive 05 years of non-use. There is no time limitation for filing patent invalidation.
Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

For opposition proceedings, please refer to answers in question 7 & 8. Invalidation of trademark can be filed before the Administrative Court. In invalidation action the plaintiff must prove that the registration of trademark is unlawful. The law does not clarify the conditions of unlawfulness however the understanding is that if registration is contrary to any provision of Saudi Trademark Law, it should be considered as unlawful. Prior use right can also be the basis for filing invalidation action. In case of non-use cancellation action, the plaintiff must prove that the registered trademark was not used for consecutive 05 years.

Saudi Patent Committee is the competent forum to invalidate a valid patent. Invalidity action can be initiated on the following grounds:

1. the invention lack novelty at the time of filing;
2. the invention lacks inventive step;
3. the invention is not industrially applicable; the subject matter of the patent is hit by exclusionary subject matters
4. commercial exploitation of the invention violates Islamic principles;
5. commercial exploitation is harmful to life, to human, animal or plant health, or is substantially harmful to the environment.

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

NO.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

Following remedies are available under different IP laws of Saudi Arabia:

1. Interim Injunction
2. Permanent Injunction
3. Monetary damages
4. Award of adequate compensation
5. Order to destroy infringing products.

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

As mentioned above, there are no court fee in Saudi Arabia. Depending on case, Attorney fee could be in the range of USD 15000-25000. Recovery of Attorney fee is not awarded by Saudi
Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.

During COVID-19 pandemic, it was possible to file IP applications with SAIP, however SAIP changed the deadlines for submission of required documents from time to time. SAIP mostly remained operational during lockdown and the staff were working from home. The Trademark Opposition Committee and Appeal Committee were also operational, and hearings were conducted virtually. Saudi Courts remained closed during lockdown however the online portal was operational for submission of cases with the courts.