

# **The Executive Regulations of the Trademark Act of the Cooperation Council for the Arab States of the Gulf**

## **Chapter I- Definitions**

### **Article 1**

In the implementation of the provisions of these Regulations, the words and expressions mentioned herein shall have the same meanings assigned to them in the Trademark Act of the Member States of the Cooperation Council for the Arab States of the Gulf. In addition, the following words and expressions shall have the meanings assigned to them hereunder unless otherwise defined by context.

**Competent Administration:** The administration in charge of registering trademarks in each GCC State.

**The Act:** The Trademark Act of the Member States of the Cooperation Council for the Arab States of the Gulf

**Grievance Committee:** A committee formed by a decree from the competent Minister to hear grievances.

**Priority:** Filing an application on the basis of a previous one filed in a State.

## **Chapter 2: Procedures of Registration of Trademarks**

### **Article 2**

An application for a trademark shall be filed by the person concerned with the competent administration on a special form designed for this purpose if such a person has a domicile in the State or otherwise by an agent who has domicile there and is recorded as a trademark agent as defined by the Competent Administration. A single application shall be confined to the registration of a trademark in one class only. However, a single application may be filed in respect of multiple classes, subject to the approval of the Competent Administration in accordance with the international classification of goods and services (Nice) as amended without detriment to public order in each State.

### **Article 3**

The trademark application shall include the following particulars:

1. A representation of the subject trademark
2. Name, address and nationality of applicant. If the applicant is a legal person, it shall mention its name and address.
- 3- 3. A detailed description of the subject trademark.
5. Details and class of the goods or services in respect of which the trademark is to be registered.
5. Priority date and number and the country (if any) wherein it has been filed.
6. Signature of the applicant or his appointed agent. If the application is filed by a legal person, the instruments shall be signed by its authorized signatory. If the application is filed by an agent, the agent's name and address shall be stated.

### **Article 4**

A trademark application shall be accompanied by:

- 1- Four copies of the trademark identical to the one represented in the trademark application form.
- 2- If the application is filed by an agent, a copy of the power of attorney shall be submitted along with the original copy for verification. The original power of attorney shall be duly notarized, legalized and translated into Arabic.
3. An evidence that the applicant is practising the profession or line of business.
4. An evidence of the payment of the application fees.
5. If the subject trademark is comprised of one or more utterance in a non-Arabic language, the applicant shall submit a certified translation of such utterance(s) into Arabic with the phonetic transcription thereof.

6. Sound marks shall be provided in the form of a musical note or written description.

7. Scent marks shall be submitted in the form of a written description.

#### **Article 5**

a. If the trademark applicant or his successor wishes to claim priority on the basis of a previous application filed in a state that is member to a multilateral international convention to which a GCC State is a member, he shall submit along with his application a statement showing the date and number of the previous application and the state where it was filed. He shall also deposit a certificate stating the filing date as issued by the state of the previous application along with a copy of the previous application and its translation into Arabic within six months from the date of the previous application for which he is claiming priority. If the applicant fails to comply with this provision, his priority claim shall not be accepted.

b. The documents supporting the original priority claim may be submitted within three months from the filing date.

#### **Article 6**

The Competent Administration shall inspect and decide the trademark application within ninety days of its filing date. It shall accept the application if it meets the conditions and procedures as stipulated by the Act and the Executive Regulations or otherwise decline it. In either case, the Competent Administration shall serve the applicant at his address as stated in the application of its decision in writing or electronically.

The Competent Administration may require the applicant to fulfill the conditions, supply the documents or affect any required amendments to the application within ninety days of the notification date or he shall be deemed to have withdrawn the application.

#### **Article 7**

Where the Competent Administration decides to decline the registration of the trademark or suspend it pending the satisfaction of a given condition, the

applicant or the person acting on his behalf may appeal the decision before the Grievance Committee within sixty days as of the notification date.

### **Article 8**

The Competent Minister in each GCC State shall form a committee to hear grievances submitted therewith. The Minister shall decide the number of the committee's members, membership term, modus operandi and the remuneration of the members.

### **Article 9**

The aggrieved party shall be notified of the Grievance Committee's decision in writing or electronically within thirty days of the date of issue of the decision and may be appealed before the competent court within sixty days of the date of notification.

### **Article 10**

a. If the application is accepted, the applicant or his agent shall pay the publication fees within thirty days from the date of notification of the decision. An applicant who fails to comply with this provision shall be deemed to have withdrawn the application.

b. The notice of publication shall include the following particulars:

1. Number and date of application
2. Name, address and nationality of applicant
4. A representation of the trademark
5. Name and address of the agent
6. The products or services for which the trademark is to be registered along with its class.
7. Any restrictions or claims
8. Priority date and number and the country (if any) wherein it has been filed.

### **Article 11**

The Competent Authority shall issue or identify a bulletin for trademarks as the means of publication of everything that is required to be published by the Trademark Act or its Executive Regulations.

### **Article 12**

1. Any interested party may submit before the Competent Administration a grounded opposition to the registration of a trademark within sixty days from the date of its publication in the bulletin issued or identified by the Competent Authority in the required form and after the payment of the required fees.
2. The Competent Administration shall serve the applicant with a copy of the opposition statement within thirty days of the opposition filing date.
3. The applicant shall submit before the Competent Administration a written answer to the opposition within sixty days of the notification date or else he shall be deemed to have withdrawn his application.

### **Article 13**

1. The Competent Administration may schedule a hearing for the applicant and/or the respondent upon either's request, subject to the submission of necessary supporting documents and notification and payment of the prescribed fees.

The Competent Administration shall notify both parties of its grounded decision that provides for any necessary and conditions it sees fit within ninety days from the hearing session.

### **Article 14**

The registration decision shall be deemed as final if no opposition has been made to the registration within two years from publication of the trademark in the bulletin issued or identified by the Competent Authority or after a final relevant decision is issued by the competent court.

The applicant shall pay the fees for the trademark registration within thirty days from the date of the final decision issued in acceptance of the trademark or else he shall be deemed to have withdrawn the application.

### **Article 15**

The Competent Administration shall register the trademark in the Trademark Register by virtue of which the trademark owner shall be awarded a certificate of registration including the following details:

1. Trademark number and registration date.
2. Date of commencement and expiry of trademark protection
3. Priority date and number and the country (if any) wherein it has been filed.
4. Name, address and nationality of the trademark owner and his tradename (if any).
5. A representation of the trademark.
6. Products or services and class for which the trademark is registered.
7. Any restrictions or claims (if any)

The registration of the trademark shall be effective as of the registration filing date as recorded in the Trademark Register.

### **Article 16**

The owner of a registered trademark may apply for the amendment of any of the following particulars in the Trademark Register by submitting the required form and paying the prescribed fees:

1. Name, address, occupation or nationality of the trademark owner. If the owner is a legal person, it shall enter any amendment that may affect the name or address.
2. Eliminate some services or goods attributed to the trademark.
3. Change the name and/or address of the agent.

The Competent Administration shall prepare a notice of the amendment as required by Paragraphs 1 and 2 above and publish it in the means of publication that it issues or identifies after the payment of publication fees. The affected amendments shall be recorded in the Trademark Register and an evidence thereof shall be given to the applicant.

### **Chapter 3: Period of Trademark Protection**

#### **Article 17**

The trademark owner who wishes to continue to protect his trademark shall file an application for such a purpose with the Competent Administration after the payment of the prescribed fees in the last year of the protection period up till the lapse of six months from the expiry of the original protection period.

#### **Article 18**

Renewal applications shall be accepted for further processing after the payment of the due fees without the need for new inspection. The Competent Administration shall prepare a notice of renewal that includes the following particulars:

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

The Competent Administration shall prepare a notice of the amendment and publish it in the bulletin that the Competent Authority issues or identifies. The affected amendments shall be recorded in the Trademark Register.

### **Chapter 4- Temporary protection of trademarks used in exhibitions**

#### **Article 19**

If the trademark wishes to get a temporary protection for his trademark in respect of the products or services displayed at a national or international exhibition held in a GCC State, he shall notify the Competent Administration in that state of such a desire at least one month before the exhibition's inauguration. The notification shall be made in the specific form accompanied

by four images of the trademark and an evidence of payment of the required fees, subject to the requirements of registration provided in the Act and its Executive Regulations.

#### **Article 20**

Applications for temporary protection of trademarks used in exhibitions shall be recorded in a special register named the Temporary Protection Register wherein the following particulars shall be recorded:

- 1- Number of temporary protection
2. Application date
3. Name of exhibitor
4. Name of exhibition and date of its official inauguration
5. The products or services and the class for which temporary protection is requested.

#### **Article 21**

The Competent Administration shall issue a certificate of temporary protection for the trademark used in exhibitions for a period not exceeding six months from the exhibition's inauguration date.

#### **Article 22**

The certificate of temporary protection as prescribed in the previous article may not be granted except for such exhibitions that are identified by an official decision.

### **Chapter 5: Cancellation of a trademark**

#### **Article 23**

The trademark registration is cancelled in accordance with the provisions of the Act. When cancelling a trademark, the Competent Administration shall record such cancellation in the Trademark Register and publish a notice of cancellation thereof in the bulletin that the Competent Authority issues or identifies. Such a notice shall include the following:

1. A representation of the trademark.
2. Trademark number and registration date.
3. Name, address and nationality of the trademark owner.
4. Reason and date of cancellation

A trademark owner who desires to cancel his trademark shall apply for cancellation in the form designated for such a purpose after the payment of the application and publication fees, provided that the subject trademark is registered and valid.

## **Chapter 6: Assignment, mortgage and seizure of trademarks**

### **Article 24**

The proprietorship of a trademark is assigned by a request submitted to the Competent Administration by the assignee or his appointed agent after the payment of the prescribed fees. The assignment application shall be submitted on a special form that includes the following particulars:

1. Number and class of the registered trademark.
2. Name, address and nationality of the trademark owner.
3. Name, tradename (if any) and nationality of the assignee
4. Date of assignment, disposal or the event that resulted into the assignment.
5. The name and address of the agent if the assignment application is filed thereby.

The assignment application shall be accompanied by the following documents duly notarized, legalized and translated into Arabic:

1. Deed of assignment
2. Evidence of the assignee's practicing of business
3. The original power of attorney, if the application is filed through an agent.

## **Article 25**

Without prejudice to Article 5 of the Act, the natural heirs of a trademark owner shall have the right to transfer the proprietorship of the trademark to their names collectively or to any individual of them by virtue of a deed of assignment signed by the holders of the trademark right.

## **Article 26**

The Competent Administration shall prepare a notice of assignment of the trademark that includes the following particulars:

1. Number and class of the registered trademark.
2. Name, address and nationality of the previous trademark owner.
3. Name, address and nationality of the assignee

The Competent Administration shall publish the notice in the means of publication that the Competent Authority issues or identifies after the payment of publication fees. The affected assignment shall be recorded in the Trademark Register.

## **Article 27**

Mortgage actions on the trademark shall be recorded in the Register per the same measures and conditions governing trademark assignment. The notice of mortgage shall include the same particulars prescribed in Article 25 of these Regulations after the payment of the prescribed fees.

## **Article 28**

Trademark mortgage shall be released upon the request of the trademark owner submitted to the Competent Administration accompanied by such instruments that attest to the mortgage redemption duly notarized, legalized and translated into Arabic after the payment of the prescribed fees.

The Competent Administration shall prepare a notice of the mortgage redemption and publish it in the bulletin that the Competent Authority issues or identifies after the payment of publication fees. The affected redemption

shall be recorded in the Trademark Register and an evidence thereof shall be given to the applicant.

### **Article 29**

Seizures set on the registered trademark shall be recorded in the Trademark Register by a court order. The seizure may not be removed except by a final court decision.

## **Chapter 7- Licensing contracts**

### **Article 30**

In the event that the owner of a registered trademark licenses a natural or legal person to use the trademark for all or part of the products or series for which the trademark is registered, the licensing contract shall be executed in writing and duly notarized, legalized and translated into Arabic in case it is executed in any other language. Under no circumstances may the licensing period exceed the trademark's protection period.

### **Article 31**

An application for the recordal of licensing shall be submitted by the trademark owner, his appointed agent or the licensee in the form prepared for that purpose after the payment of the fees. The application shall include the following:

1. Trademark number
2. Name and nationality of the trademark owner
3. Name, address, domicile and nationality of the licensee
4. The licensed goods and services.
5. Dates of commencement and expiration of the license.
6. Geographical scope (if any) of the license

The assignment application shall be accompanied by the following documents duly notarized, legalized and translated into Arabic:

1. The licensing contract

## 2. The original power of attorney

### **Article 32**

The Competent Administration shall record the licensing of the use of the trademark in the Register and submit to the applicant an evidence of the recordal upon his request. The Competent Administration shall publish the notice of licensing in the bulletin that the Competent Authority issues or identifies after the payment of publication fees. The notice shall include the following:

1. A representation of the trademark.
2. Trademark number and date of registration
3. Name, address and nationality of the trademark owner.
4. Name, address, domicile, and nationality of the licensee
5. The products or services and the class for which the license has been granted.
6. Dates of commencement and expiration of the license.
7. Geographical scope (if any) of the license

### **Article 33**

The license record may be stricken off by an application that shall be submitted to the Competent Administration by the trademark owner, his appointed agent or the licensee accompanied by an evidence of expiration or termination of the licensing after the due fees are paid.

The Competent Administration shall notify the other party of the cancellation in which case he may appeal the cancellation before the competent court within thirty days form the date of notification of the cancellation provided that a copy of the appeal petition shall be filed with the Competent Administration along with any necessary instrument.

In this case, the cancellation shall be suspended until either the two parties reach an agreement or a final decision is issued by the court on the appeal.

#### **Article 34**

If no appeal is made on the cancellation of the license or if otherwise a final decision is issued by the court, the Competent Administration shall publish a notice of cancellation in the bulletin that the Competent Authority issues or identifies after the payment of publication fees. The cancellation shall be recorded in the Trademark Register and an evidence thereof shall be given to the applicant.

### **Chapter 8: Collective and certification trademarks and trademarks of public utility bodies and professional institutions.**

#### **Article 35**

In addition to the requirements of Articles 2 and 3 herein, the collective trademark registration application shall:

1. mention that the subject trademark is a collective one
  2. include a true copy of the statutes of the federation, organization or public institution submitting the application along with any amendments that may have been affected thereto including the following:
    - a. the category of persons who have the right to use the trademark and their relationship with the applicant.
    - b. a copy of the terms and conditions governing the use of the collective trademark on goods and services.
    - c. include a statement that the applicant is or will be applying a tight control on the use of the collective trademark by the members affiliated to that institution or body.
    - d. mention the eligibility criteria for that entity's membership
- 2- 2. Publication and registration shall be made in accordance with the same procedures prescribed in Chapter 2 herein. 3. All instruments shall be duly notarized, legalized and translated into Arabic.

### **Article 36**

In addition to the requirements of Articles 2 and 3 herein, the certification or testing trademark registration application shall:

1. mention that the subject trademark is a certification or testing one
2. include a true copy of the statutes of the federation, organization or public institution submitting the application along with any amendments that may have been affected thereto including the following:

a. a statement that the certification or test trademark shall not be used by other than the applicant, that the applicant shall not practice marketing or the production of any goods or services for which the trademark is to be used and that the applicant shall not pursue any discrimination policies that may prevent the use of the trademark by third parties who meet the specifications laid down by the owner.

b. a statement that the certification or test trademark is intended to certify the quality or advantages of goods and services and that it shall not refer to the source of goods and services.

c. instruments defining the specifications and standards applied by the applicant for the sake of controlling the use of trademark proving that the applicant is applying a certified program for quality assessment.

d. a certificate showing the advantages of the goods or services that are certified or required to be certified.

3. All instruments shall be duly notarized, legalized and translated into Arabic.

The publication and registration of such trademarks shall use the same provisions prescribed in Chapter 2 herein.

### **Article 37**

In case a trademark is sought to be registered for non-commercial purposes, the application shall mention that fact and shall be accompanied by the Statutes of the applicant public utility body or professional institution. Such a trademark shall be published and registered following the same procedures prescribed in Chapter 2 herein.

## **Chapter 9- General Provisions**

### **Article 38**

The Competent Authority shall prepare a notice of publication that states the decision taken with regard to the repeat offender in accordance with Article 43 of the Act. It shall be published at the expense of the offender in a prominent place in two wide-spread dailies, one of which shall be issued in the region where the offender's premises, if any, are located.

### **Article 39**

The Competent Authority may establish an electronic system and database for the submission of new registration and renewal applications and for the following up of such applications. The particulars mentioned in Article 3 herein shall be recorded in those system and database.

### **Article 40:**

The due fees shall be defined in accordance with the table attached hereto. Each sate may impose other fees as may be required by its own procedures.

**Trademark Fees (in Saudi Rials) or in equivalent currencies of other GCC states.**

<b>Services</b>	<b>Charge</b>
First: Trademarks and service marks for one mark in one class	
<ul style="list-style-type: none"> <li>• trademark application</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• trademark publication (if the bulletin is issued by the Competent Authority) (500)</li> </ul>	(500)
<ul style="list-style-type: none"> <li>• trademark registration and issuance of a certificate</li> </ul>	(5000)

Second: Collective trademarks, certification marks and marks allocated for public bodies or professional institutions.	
<ul style="list-style-type: none"> <li>• application for the registration of collective trademarks, certification and test marks and marks allocated for public bodies or professional institutions.</li> </ul>	(2000)
<ul style="list-style-type: none"> <li>• trademark publication (if the bulletin is issued by the Competent Authority)</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• application for the amendment of the system of using a registered trademark used to refer to certification test or collective mark</li> </ul>	(500)
<ul style="list-style-type: none"> <li>• trademark registration and issuance of a certificate</li> </ul>	(5000)

Third: Grievance and opposition to a trademark in one class	
<ul style="list-style-type: none"> <li>• appeal of a decision for the declining of a trademark registration or making a condition for its registration</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• application for opposition to the acceptance of a trademark registration</li> </ul>	(2000)
<ul style="list-style-type: none"> <li>• application for appointing a hearing</li> </ul>	(5000)

Fourth: Renewal of one trademark in one class	
---	--

<ul style="list-style-type: none"> <li>• application for the renewal of one trademark throughout the last year of its protection period</li> </ul>	(5500)
<ul style="list-style-type: none"> <li>• application for the renewal of a trademark within six months after the expiration of the protection period</li> </ul>	(6500)
<ul style="list-style-type: none"> <li>• publication of the renewal notice (if the bulletin is issued by the Competent Authority)</li> </ul>	(1000)

Fifth: Assignment of one trademark in one class	
<ul style="list-style-type: none"> <li>• application for recordal of trademark assignment</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• publication of the assignment notice (if the bulletin is issued by the Competent Authority)</li> </ul>	(500)

Sixth: Licensing the use of a trademark in one class	
<ul style="list-style-type: none"> <li>• application for recordal of the licensing of the use of a trademark</li> </ul>	(2000)
<ul style="list-style-type: none"> <li>• publication of the licensing notice (if the bulletin is issued by the Competent Authority)</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• application for cancellation of the licensing</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• publication of the cancelation of the license (if the bulletin is issued by the Competent Authority)</li> </ul>	(1000)

Seventh: Setting mortgage on one trademark in one class	
<ul style="list-style-type: none"> <li>• application for recordal of trademark mortgage</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• publication of the mortgage notice (if the bulletin is issued by the Competent Authority)</li> </ul>	(500)
<ul style="list-style-type: none"> <li>• application for releasing mortgage</li> </ul>	(500)
<ul style="list-style-type: none"> <li>• publication of the mortgage redemption notice (if the bulletin is issued by the Competent Authority)</li> </ul>	(500)

Eighth: Amending the particulars of one registered trademark in one class	
---	--

• Application for the change of trademark owner's name.	(1000)
• application for recordal of change of address of the trademark owner	(1000)
• application for recordal of change of name and address of the trademark owner or the agent	(1000)
• application for recordal of change of the name of registration agent	(200)
• publication of the amendment of the name or address of the trademark owner or agent (if the bulletin is issued by the Competent Authority)	(500)

Ninth: Amending the form of one trademark in one class	
• amending the form of a trademark	(1000)
• publication of the trademark form amendment (if the bulletin is issued by the Competent Authority) (500)	(500)
• appeal of a decision for the declining of a trademark registration	(500)

Tenth: Cancellation of one trademark in one class.	
• application for the cancellation of registration of a trademark by the owner	(200)
• an application for the elimination of a part of the goods or services	(200)
• the publication of cancellation notice (if the bulletin is issued by the Competent Authority)	(200)

Eleventh: Miscellaneous fees	
• application for temporary protection of one trademark in one class	(1000)

<ul style="list-style-type: none"> <li>• application for initial inspection of one trademark in one class</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• application for a true copy or replacement of a lost certificate of registration (one trademark in one class)</li> </ul>	(1000)
<ul style="list-style-type: none"> <li>• application for a certificate of filing a trademark (one trademark in one class)</li> </ul>	(500)
<ul style="list-style-type: none"> <li>• application for a true copy of any application or instrument submitted with or issued by the Competent Administration (one trademark in one class)</li> </ul>	(200)
<ul style="list-style-type: none"> <li>• recording a trademark registration agent in the agents register</li> </ul>	(3000)
<ul style="list-style-type: none"> <li>• renewal of a record in the agents register (annually)</li> </ul>	(3000)
<ul style="list-style-type: none"> <li>• the price of the bulletin per issue (if the bulletin is issued by the Competent Authority)</li> </ul>	(50)