

Administrative Actions to Enforce Trademark Rights in Saudi Arabia

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The Anti Counterfeiting and Fraud Department (ACFD) within the Ministry of Commerce and Industry (MOCI) in Saudi Arabia is a platform whereby trademark owners can seek to enforce their registered trademarks rights without having to resort to lengthy and expensive Criminal and/or Civil Court action.

The headquarters of MOCI are located in Riyadh with branch offices in other cities. Once a complaint against trademark infringement is filed before the appropriate branch office of the ACFD (via a MOCI office), an assigned officer of the ACFD will study the complaint and will determine what investigatory steps are taken including an inspection of the premises of the opponent, and whether a raid if necessary. In the event that these steps identify counterfeit and/or infringing products and materials these will be confiscated.

The ACFD may also issue a direction to the opponent to remove all infringing materials from its premises including any signboards if the dispute involves the opponent's unauthorised use of complainant's trademark and the opponent may be required to sign an undertaking to the effect that it will permanently refrain from illegally using the trademark of the complainant without the necessary authorization to do so. The ACFD is also authorized to destroy the confiscated products and materials and to issue a seizure report to the complainant. If the situation warrants, the ACFD may also impose interim sanctions and/or injunctions against the opponent's carrying out certain business transactions. In the event of a failure to comply with an order of the ACFD, such injunctions can go as far as freezing all works, applications, licensing activities before all governmental agencies, ministries and departments.

If the opponent is not prepared to comply with the ACFD's requirements (as stated above), and continues with the infringing activities, then the ACFD will forward the matter to the Bureau of Investigation and Public Prosecution (the "**Bureau**") with its recommendations. The Bureau will then investigate the matter and, if it finds the opponent has breached trademark rights, it will refer the case to the competent court.

The procedure followed at the ACFD is somewhat similar to the procedure followed by Department of Economic Development (DED) in the UAE in the matter of administrative complaints filed against trademark infringement issues, with the main procedural differences as follows:

a) While processing an administrative complaint filed before the DED, the officials will allow the brand owner and/or his legal representative to accompany them while they inspect or raid the premise of the opponent and confiscate the infringing products, whereas the ACFD will not allow the same and the brand owner or his representative will not have access to the proceedings followed by the ACFD, although they will get updates on their complaint from the ACFD office from time to time.

The DED will normally issue a fine against the opponent if they found the opponent is in breach, whereas the ACFD will not normally issue a fine against the opponent, although they impose other sanctions (see above). In order to file a complaint before the ACFD, the following documents and information are required:

- A power of attorney on behalf of the complainant,

- A copy of the trademark registration certificate,
- Address and location details of the opponent,
- A brief description on the trademark infringement activities of the opponent, and
- Samples / images of the infringing and genuine products.

Where it is necessary to file a criminal or a civil case before the Grievance Board against trademark infringements in Saudi Arabia, the brand owner has to first file a complaint before the ACFD and get the case referred to Bureau to obtain a finding in the case confirming that there has been a violation of the applicable trademark laws. In most of the jurisdictions in this region, court cases whether it is criminal or civil are cumbersome, time consuming and expensive, and Saudi Arabia is no exception.

For this reason, we have frequently and successfully availed the ACFD as a platform to get redress of trademark infringement issues for our clients, without dragging the matters to long lasting litigation before the courts. We consider that the ACFD has ample powers to investigate into the trademark infringement issues in question, summon the offending parties, issue orders of removal of infringing materials, confiscate and destroy counterfeit and infringing products and force the offenders to comply with its orders also with the help of police authorities, if necessary.

To summarize, enforcing trademark rights through administrative actions is proved a viable and speedy option in Saudi Arabia. Brand owners are advised to consider such options and cooperate with the MOCI and ACFD officials to tackle the menace of trademark infringements issues in the Kingdom. Al Tamimi and Company with its presence in the Kingdom is well placed to assist businesses in tackling trademark infringement. .