

Procedural Changes for Trademark Oppositions and Official Fees Increase in Saudi Arabia

Mohammed Ali - Senior Associate - Intellectual Property
m.ali@tamimi.com - Dubai International Financial Centre

November 2016

Trademark Opposition

The main changes in the opposition process are as follows:

- The opposition period has been modified. The period within which an interested third party can submit an opposition against the registration of a published trademark will be set as 60 days from the date of publication, instead of the existing 90 days from the date of publication. This change is based on Article 12 of the Implementing Regulations, bringing the procedure more in line with international standards. An extension of the above time period will not be possible.
- The opposition will be an administrative procedure. Under the new system, an opposition will no longer be a legal proceeding; rather it will be an administrative procedure. Previously, the opposition was to be handled only by the Board of Grievances (BOG) or the Court of First Instance. Pursuant to the new regulations, oppositions will be handled by a newly-established Trademark Board which is an administrative body under the Ministry.
- Pursuant to Articles 12 and 13 of the Implementing Regulations, the Trademark Board will notify the trademark applicant of the opposition within 30 days from the date of filing of the opposition. Thereafter, the applicant has to submit a written counter statement to the opposition within 60 days from the date of notification. The period for filing a counter statement is non-extendable. The Trademark Board will then schedule a hearing for submission of oral arguments and documentary evidence by both the opponent and the applicant. The Trademark Board will then issue a decision on the opposition within 90 days from the date of hearing.

The Official Fees Increase

The Ministerial Decree has also announced an increase in the official fee for registration of trademarks in the Kingdom.

It is understood that the fees increase will apply to official fees for registration as well as renewal of trademarks. The official fees for filing the application, publication of the mark and availability searches will remain unchanged. The trademark registration in Saudi Arabia is already an expensive affair and with the current increase of the official registration as well the renewal fees to almost double will no doubt make it more expensive.

Details Of Increase

The increased official fees came into effect as of 1 October, 2016. It is remain to be seen if the increased fees will be applied to the existing applications which were filed prior to the effective date of increase or the issuance of the Ministerial Decree.

Action

Current FeesNew Fees

| | SAR | USD | SAR USD |
|--|------------|------------|----------------|
| Registration Fee | 3,000 | 822 | 5,0001,370 |
| Renewal Fee | 3,000 | 822 | 5,5001,467 |
| Filing appeal before Trademark Board | - | - | 1,000274 |
| Filing opposition before Trademark Board against published TM- | - | - | 2,000548 |
| Request to assign a hearing | - | - | 1,000274 |
| Recordal of license agreement | 1,000 | 274 | 2,000548 |