

Trade Marks Law

TRADE MARKS AND DESCRIPTIONS LAW NO. 21 OF 1957

We, Faisal II, King of Iraq,

After perusal of article 26 (a) of the constitution and with the approval of the Senate and the Chamber of Deputies, do hereby sanction the following law order the promulgation thereof:

CHAPTER I

GENERAL PROVISION

Article 1 - In this law the following words shall have the meanings shown against them:

"Minister" - Minister of Industry and Minerals.

"Registrar" - Registrar of Trade Marks.

"Register" - Register of Trade Marks.

"Court" - The Appropriate Court of First Instance.

"Mark" - Shall include trademarks, service marks, collection marks and certification marks.

"Trademark" - Any sign, or any combination of signs, capable of distinguishing the goods of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and colors as well as any combination of such signs, shall be eligible for registration as trademark. Where signs are not inherently capable of distinguishing the relevant goods or services, registrability will depend on distinctiveness acquired through use. Signs need not be visually perceptible in order to be eligible for protection as trademarks.

"Service Mark" - Any sign, or any combination of signs, used by a person to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor. Marks used in connection with retail services, whether associated with the selling of the goods of the service provider or those of others, or both, are eligible for protection as service marks.

"Certification Mark" - Any sign, or any combination of signs, used by a person other than its owner to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization. Certification marks shall include geographical indications.

"Geographical Indications" - Indications which identify a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristics of the goods is essentially attributable to its geographical origin.

"Collective Mark" - A trademark or service mark used by the members of a cooperative, an association, or other collective group or organization, and includes marks indicating membership in a union, an association, or other organization."

"Nice Classification means the classification established by the Nice Agreement Concerning the International Classification of Goods and services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised amended."

Article 2.

1) held at the Ministry of Industry and Minerals have custody of the Register record of all registered marks and trade data and names of the owners, their addresses and descriptions of their goods and to the public the right to see him and take a certified copy thereof after paying the fees that are installed in the schedule attached to this law.

2) The Ministry mentioned the fulfillment of duties set forth in the table attached to this law on the activity of the marks and trade data.

- 3) deduct the Ministry of Industry and Minerals proportion (10%) ten percent of the fees under item (2) of this article to cover the cost of management activity trademarks.
- 4) accrue fees that are collected in accordance with item (2) of this article to the Ministry of Finance, after deducting the percentages set forth in item (3) of this article and the final recorded revenue of the public treasury.

Article 3 " A mark shall be deemed to be the property of the person who registered it. The ownership of the mark may not be contested if the owner used it for five consecutive years from the date of completion of registration, except as provided in Article 21.

Article 4 " Any natural person or legal entity shall have the right to apply for the registration of a trademark with all attendant rights in accordance with the provisions of this Law."

Article 4*bis* is added following Article 4 to read as follows:

"1) The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall presumed.

2) The owner of a well-known trademark shall have the right to enjoy the protection conferred by this Law even if such a mark is not registered in Iraq.

3) The preceding provision shall apply to marks intended for use in connection with goods or services which are not identical with those of the well-known mark, where the use of the marks in relation to those non-identical goods or services would indicate a connection between the owner and the well-known mark and those products, and that such a use may be prejudicial to the interests of the owner of the well-known mark.

Article 4*quater* is added following Article 4*ter* to read as follows: "Collective and certification marks, including geographical indications, shall be registrable in the same manner and with the same effect as trademarks by any natural persons or legal entities, including nations, states,

municipalities, and other regional authorities, exercising legitimate control over the use of the marks sought to be registered. When registered, they shall be entitled to the protection provided in this chapter in the case of trademarks."

Article 5.:

1. Marks devoid of any distinctive character or which are used in trade to describe the kind, nature, quantity or place of production of the goods, or marks which in the ordinary language of Iraq indicate any of such matters. Where signs are not inherently capable of distinguishing the relevant goods, registrability will depend on distinctiveness acquired through use.

"2. Marks, expressions, or designs which are contrary to public order or morality."

3 " Marks which are identical with, or similar to armorial bearings, flags or other State emblems of Iraq or other countries of the Paris Union or international intergovernmental organizations, official signs or hallmarks, indicating control and warranty adopted by them, and any imitation from a heraldic point of view."

"4. Marks which are identical with, or similar to, the insignia of the Red Cross, Red Crescent, or Geneva Cross.

"5. The name, title, portrait, or armorial bearing of a person except with that person's written consent."

"6. Designations of honorary degrees to which the applicant is unable to prove a right."

"7. Marks which are likely to mislead or confuse the public, or which contain false descriptions as to the origin of products, whether goods or services, or their other qualities, as well as the signs that contain an indication of a fictitious, imitated or forged trade name."

"8. Marks that are identical or similar to a well-known mark, or marks that are identical or similar to a previously registered trademark if registration of that mark will result in confusing the consumer public as to the goods distinguished by the mark or other similar goods."

9-12 are suspended by the order 80 of 2004.

CHAPTER II

REGISTRATION PROCEDUER

Article 6 –

An application for the registration of a mark shall be filed with the registrar in the manner and according to the conditions prescribed in regulation made under this law.

Article *6bis* is added following Article 6 to read as follows: "Where an application for registration of a mark is filed:

a) by any person whose country of origin is a member in the Paris Union, the WTO, or party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which Iraq is a party, or a country which extends reciprocity to Iraq;

b) in a country described in subsection (a)

the applicant, or rightful successor, may, within six months from the date of filing the application, file with the Registrar a similar application for the same mark covering the same products included in the previous application in accordance with the terms and conditions prescribed by this Law and its Regulations. In such a case the priority date shall be that of the first application filed in the foreign country."

Article 7

"1. A mark shall be permitted to be registered in respect of one or more articles or in one or more classes. The application shall indicate the goods or services by their names, grouped according to the classes of the Nice Classification.

2. Goods or services may not be considered as being similar to each other solely on the ground that, in any registration or publication, they appear in the same class of the Nice Classification. Conversely, goods or services may not be considered as being dissimilar from each other solely on the ground that, in any registration or publication, they appear in different classes of the Nice Classification.

3. In a single application, an applicant may apply to register the same mark in multiple classes for all of the goods and /or services on or in connection with the mark that is sought to be protected. The applicant must specifically identify the goods or services in each class. A single certificate of registration shall issue for such mark."

Article 8

"Where before any publication is made two or more persons apply simultaneously for the registration of the same mark or of identical or similar marks in respect of goods or articles of the same class of products, the Registrar may suspend all such applications until the renunciation by one of the disputants is duly attested to or a final decision is made in favor of one of them."

Article 8*bis* is added following

"1. The Registrar may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

2. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services."

Article 9: is suspended by the order 80 of 2004.

Article 10 –

Decisions issued by the Registrar (except those stipulated in para. 3 of Article 24 of the law) will be subject to appeal to the Court within 30 days from the date of notification of the decision.

Article 11 –

1) In the event acceptance of the mark in principle, the registrar shall publish, in three consecutive numbers of the bulletin of the directorate General of Commerce, an advertisement to that effect.

2) Any person interested may, within ninety days from the date of the last advertisement, file a written notice of opposition against the registration of the mark.

3) The Registrar shall serve a copy of the notice of opposition on the applicant for registration who shall, within thirty days, send a written reply to the opposition. If no reply received within the said period, the applicant shall be deemed to have abandoned the application.

Article 12 –

1) Before giving a decision on the opposition, the Registrar shall, if requested so to do, hear both either of the parties.

2) and 3) are suspended by the order 80 of 2004.

– Article 13

The proprietor of a registered mark may apply at any time to the registrar for leave to alter or add to such mark in a manner not substantially affecting its identify. The Registrar shall give a decision approving the registration of such alteration in principle, in accordance with the provisions prescribed for decisions on original applications for registration of mark. The decision shall be notified to the interested parties and shall be subject to opposition as aforementioned.

Article 14 –

The registration shall have retroactive effect as from the date of filing the application.

Article 15 –

"1. The owner of a mark shall, on completion of registration there of, be given a certificate containing the particulars published in the aforementioned bulletin.

2. The registration of a trademark shall in all legal proceedings constitute *prima facie* evidence of the validity and ownership of the trademark."

Article 16 –

Where registration of a mark is not completed within six months from the date of the application by reason of default on the part of the applicant, the Registrar may inform the applicant, in

writing, to complete the registration within the period prescribed in the regulation made under this law, otherwise he will be considered as having abandoned the application.

CHAPTER III

Transfer of Ownership and Pledgeon Marks

– Article 17

transferable and the mark shall be pledged or seized together The ownership of a mark shall be" dealing in the goods carrying that mark, or with that part of the business with the business ".connected with the use of and symbolized by the mark

Article 18 –

1) In the absence of any agreement to the contrary, the transfer of a business includes the mark.

Where a business is transferred without the mark, the transferor may continue, unless it is agreed to the contrary, to manufacture, produce and trade in the products in respect of which the mark is registered.

2) If for any reason, a person shall ceases to carry on his business and such cessation results in the devolution of ownership of the mark on more than one person, and the successors desire the apportionment of the ownership of the mark, the Registrar may apportion it between the persons who prove to be actually carrying on that business, subject to any limitations, conditions and modifications which the Registrar may deem fit.

Article 18*bis* is added following

"1. The owner of a mark may license one or more natural persons or legal entities to use the owner's mark on all or some of the products for which the mark was registered. Such license to a third party shall not prevent the owner from using the mark, unless otherwise agreed.

2. Recordal of an assignment or a license for the mark shall not be required for the assignee or licensee to establish the validity of the mark or to assert rights in the mark against third parties."

CHAPTER IV

CANCELLATION AND RENEWAL

Article 19 is suspended by the order 80 of 2004.

Article 20 is amended to read as follows:

"1. The duration of protection of a mark shall be for ten years, renewable for like periods upon application made during the last year in the manner prescribed in the regulation and payment of the prescribed fee.

2. The owner of the mark may request a renewal within six months after the date of its expiry against payment of the prescribed fees and a supplemental fee prescribed by the regulations, failing which the Registrar shall proceed to cancel the said mark from the register."

Article 21 is amended to read as follows:

"1. Any interested person shall be entitled to apply to the Court within five years of the registration of any mark for its cancellation, stating the grounds relied upon.

2. Notwithstanding paragraph 1 of this Article, a petition to cancel a registration of a mark may be filed at any time if the registered mark:

a) becomes the generic name for the goods or services, or a portion thereof, for which it is registered;

b) is functional;

c) was obtained fraudulently or contrary to the provisions of registrability;

d) has gone unused for an uninterrupted period of three years, unless such nonuse may be proved to be due to uncontrollable cause or lawful excuse; or

e) is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used."

Article 22 –

No cancelled mark may be registered for a like period in a name other than that of its proprietor until after the lapse of at least one year from the date of its cancellation.

Article 23 –

The cancellation and renewal of registration shall be advertised in the manner prescribed in the regulation.

Article 24 –

(1,2) are suspended by the order 80 of 2004.

3) is amended to read as follows: " Decisions issued by the Registrar in accordance with paragraph 2 of Article 5, and Article 21 of this Law are subject to appeal to the Minister within 30 days from the date of notification of the decision, and those concerned may object to the Minister's decision, subject to appeal to the court within 30 days from the date of notification of the Minister's decision."

Article 25 is suspended by the order 80 of 2004.

Article 26 –

The Registrar may, whenever there is justification, make any alteration in the Register if this alteration is designed to correct a mistake or to technical deficiency."

Article 27 is suspended by the order 80 of 2004.

Article 28

The Registrar may, upon application by the owner of a registered mark, in the manner prescribed:

- 1) Correct any error in the registered name or address of the owner of the mark.

- 2) Enter any change occurring in the name or address of the person registered as owner of the mark.
- 3) Strike out any of the goods in respect of which the trade mark has been registered.
- 4) Enter any disclaimer or any memorandum connected with any mark where that disclaimer or memorandum does not increase the rights created by the existing registration of the mark.
- 5) Cancel the entry of any mark recorded in the Register in his name.

Article 29 -

- 1) The Minister may from time to time, make orders as he may deem necessary, empowering the Registrar to amend the register whether by making new entries or expunging or altering certain entries in so far as may be required to obtain uniformity in the description of goods or classes of goods mentioned in it and relating to the registered trade mark.
- 2) The Registrar shall not, in the exercise of any of the powers conferred upon him by the Minister as aforesaid, make any amendment in the register which will result in the addition of other goods to the goods in respect of which the mark has been registered; nor shall he be entitled to date the registration; of a mark of any goods with a date prior to the date of registration.
- 3) The proprietor of a registered mark shall be notified of any amendment connected therewith and such amendment shall be published in the bulletin. Any person aggrieved by such amendment may file a notice of opposition with the Registrar.

Article 30 –

The Registrar may appear before the Court and state his opinion in every notice of opposition filed with the Court.

He shall also appear before the Court if the Court requires him so to do, or shall file an appropriate statement signed by him stating what he considers necessary as to the details of the

proceedings taken in the case or any other matters connected therewith and which have bearing on his duties as Registrar.

CHAPTER V

TRADE DESCRIPTION

– Article 31

reference either directly or indirectly to the following, shall Any statement or details which have .a trade description be deemed to be

- 1) Nature, number, quantity, measure, weights and strength of the goods.
- 2) Country of manufacture.
- 3) Method of manufacture and production.
- 4) Ingredients entering in the composition.
- 5) Name and description of their producer and manufacturer.
- 6) Whether there are any patents, or commercial or industrial privileges, prizes, or characteristics in respect thereof.
- 7) Name or shape in which the goods are ordinarily known.

Article 32 is amended to read as follows:

"Trade indications may not be misleading to the public, whether they are placed on the goods themselves, on the premises or stores or in their firm names, or on packages, invoices, letters, advertising materials and the like, which are used in offering the goods to the public."

Article 33.1 is suspended by the order 80 of 2004.

Article 34 -

Medals, diplomas, prizes, and titles of honour of any kind whatsoever shall not be mentioned except in respect of products entitled to such awards or in respect of persons and trade names to whom they were awarded or their successors in title on condition that an accurate statement is given as to date and kind thereof and the exhibitions or tournaments in which they were granted.

Any person participating with others in exhibiting products may not use for his own goods the awards granted to the common exhibits unless he shows clearly the source and nature of such awards.

CHAPTER VI

OFFENCES AND PENALTIES

Article 35 is amended to read as follows:

"Any person who commits any of the following acts shall be punished by imprisonment for a period of not less than one year and not more than five years and by a fine of not less than 50,000,000 Dinars and more than 100,000,000 Dinars, or by one of those penalties:

- 1) Whoever counterfeits a trademark, which is lawfully registered or imitates it in such a manner as to mislead the public, or uses in *mala fide* a counterfeited or an imitated trademark;
- 2) Whoever unlawfully uses a registered trademark owned by another party;
- 3) Whoever puts, in *mala fide*, a registered trademark owned by another party on that person's products;
- 4) Whoever knowingly sells or offers for sale or circulation or possesses for the purpose of sale, products bearing a counterfeited or an imitated trademark, or a trademark which is unlawfully affixed; or
- 5) Whoever intentionally offers rendering services under a forged, imitated or unlawfully used mark.

In all cases, the court shall order the confiscation of the infringing products, goods, firm name, wrapping materials, papers, hang tags, stickers, etc., which bear the mark of the subject matter of the offence, the revenue and the returns of such products as well as the implements used in the infringement."

Article 36 is suspended by the order 80 of 2004.

Article 36*bis* is added following:

"Any person who commits for the second time one of the offenses mentioned in Articles 35 and 36 of this Law, shall be punished by imprisonment for a period of not less than 5 years and not more than 10 years and by a fine of not less than 100,000,000 Dinars and not more than 200,000,000 Dinars in addition to the closure of the commercial store or enterprise for a period of not less than fifteen days and not exceeding six months, together with the publication of the judgment at the expense of the infringer."

Article 37 is amended to read as follows:

"1. The owner of a mark may, at any time even before the institution of any civil or criminal action, obtain, upon application supported by evidence establishing the registration of the mark, an order from the examining magistrate or from the court which has the jurisdiction to hear and determine the offence or damages to take provisional measures, more particularly to seize the instruments and tools used in the commission of the offence as well as the products, goods, firm name, wrapping materials, papers, hang tags, stickers, etc., which bear the mark of the subject matter of the offence. This includes seizure of products, goods, firm name, wrapping materials, papers, hang tags, stickers, etc., that are mentioned from abroad.

2. The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

3. Provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on

the merits of the case are not initiated within 20 working days or 31 calendar days, whichever is the longer.

4. Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.”

Article 38 is amended to read as follows:

“A. The court competent to hear any civil action shall be permitted to order:

- i) damages adequate to compensate for the injury the right holder has suffered as a result of the infringement;
- ii) profits of the infringer that are attributable to the infringement and are not taken into account in computing the amount of the actual damages referred to in clause (i) of this Article; and
- iii) seizure and destruction of the infringing articles, as well as materials and implements that have been used in the manufacture or creation of such counterfeit goods. The charitable donation of counterfeit trademark goods shall not be ordered by the competent court without the authorization of the right holder. In no case shall the simple removal of the trademark unlawfully affixed be sufficient to permit the release of goods into the channels of commerce.”

Article 38*bis* is added following:

“The court shall provide final judicial decisions in writing and shall state any relevant findings of fact and the reasoning or the legal basis upon which the decisions are based. The court shall publish decisions or, where such publication is not practicable, otherwise make publicly available.”

CHAPTER VII

GENERAL PROVISIONS

Article 39 –

Provisions may be prescribed by special regulations for ensuring the necessary provisional protection to marks placed on products or goods exposed in exhibitions which will be held in Iraq provided that such marks are protected in their own countries.

Article 39*bis* is added following:

“Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which Iraq is also a party, or extends reciprocal rights to nationals of Iraq by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.”

Article 40 –

The Trade Mark Law No. 39 of 1931, as well as its amendments and the regulations made thereunder are hereby repeated.

Article 41 –

This law shall come into force one month after its publication in the Official Gazette.

Article 42 –

The Ministers of Economics and Justice ar charged with the execution of this law.

Done at Baghdad this 25th. day of Shawal 1376, A.H. corresponding to 25th. day of May 1957, A.D.

Published on 16 June, 1957.

Put into effect on 16 July, 1957.