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How to protect your trademark in Iran?

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This article is intended for general information purposes only and does not constitute a legal advice.

• General Overview

The Islamic Republic of Iran (hereinafter referred to as “Iran”) joined the Convention for the Protection of Industrial Property (hereinafter referred to as “Paris Convention”) in 1959; also, in 2001 the latter became a member of the World Intellectual Property Organization (hereinafter referred to as “WIPO”).

In 2003, Iran signed the Madrid Agreement and the Madrid Protocol for the International Registration of Marks.

In addition to the above-mentioned international treaties, Iran has its own local law, which is the Patent and Trademark Registration Act of 2008 (hereinafter referred to as “Trademark Law”) and the E-commerce Law of 2003 hereinafter referred to as “E-Commerce Law”).

In Iran, a trademark, which is not registered cannot be protected, since the protection is only provided to a registered trademark as per the Trademark Law, especially Article 31 and Article 40.

Article 31 of the Trademark Law states: “The exclusive right to use a Mark shall belong to the person who registers his Mark in accordance with the provisions of this Act.”

While Article 40 of the Trademark Law states: “Rights Conferred by Registration, Duration and Renewal of Registration shall be as follows:

a) The use of any Mark registered in Iran by any person other than the registered owner shall require the consent of the latter.

b) The registered owner of a Mark shall have the right to institute court proceedings against any person who infringes the Mark by using, without his agreement, the Mark as previously mentioned or who performs acts which make it likely that infringement will occur. This right shall extend to the use of a Mark similar to the registered Mark and the use thereof in relation to similar goods and services that shall cause confusion.

Based on the above-mentioned, any party can use his trademark in Iran without registration, however, the latter cannot be protected and cannot stop any infringement that might occur unless the said party registered its trademark.

In case any party who owns a registration notices the existence of a trademark application, registration or domain name which infringes his trademark right, the latter can either file an opposition against the application or a court action (Civil or Criminal) against the registered trademark or domain name, which shall be explained in detail below.

• **Opposition Procedures**

As per Article 37 of the Trademark Law, any interested party may, within thirty days (30) starting from the publication date, file an opposition against a published trademark application before the Iran Intellectual Property Office (hereinafter referred to as “IIPO”).

Aside from having a local registration, a signed and dated POA along with the Certificate of Incorporation of the owner (if the owner is a corporation) must be presented at the filing stage; a legalized and notarized copy of each document can be presented at a later stage.

Evidence of prior use or business relationship with the applicant by the owner will increase the chance of success, since it will show the bad faith of the other party.

Nevertheless, in case the trademark is registered, the action to be taken shall be before the court and can be either a civil or a criminal action.

• **Civil Action**

The main goal of the civil action is the cease of the infringement along with the request for a compensation and the action is filed before the Commercial Court directly via a memo submitted.

Article 41 of the Trademark Law grants the owner of a prior trademark the right to file the civil action in case of the violation of Article 30 Section (a) or Article 32 or in case the opponent has not been using his trademark for a period of three years starting from the date of registration up to one month prior to filing the request.

However, if it is established that the use of the Mark has been prevented due to Force Majeure, the registration shall not be invalidated.

Aside from the civil action, the owner can file a criminal action, however, the same takes longer due to the numerous procedures.

• **Criminal Action**

The main goal of a criminal action is the punishment of the opponent (imprisonment + a fine), also in criminal actions, the plaintiff may request a compensation through a civil claim which will be ruled by the same judge who is handling the criminal case.

The Criminal action is filed before the Public Prosecutor via a complaint; the latter examines the complaint, after careful examination, the Prosecutor issues an injunction against the infringer.

According to Article 529 of the Criminal Law of 1996 (hereinafter referred to as “Criminal Law”), forgery of the trademark/tradename of a company is punished by imprisonment ranging from 3 months to 2 years and compensation of inflicted damages.

It is worth mentioning that the above procedures take more time than the procedures related to the civil action, however, the owner is able to lodge a civil claim in order to request for compensation along with the criminal action, but the opposite is not possible.

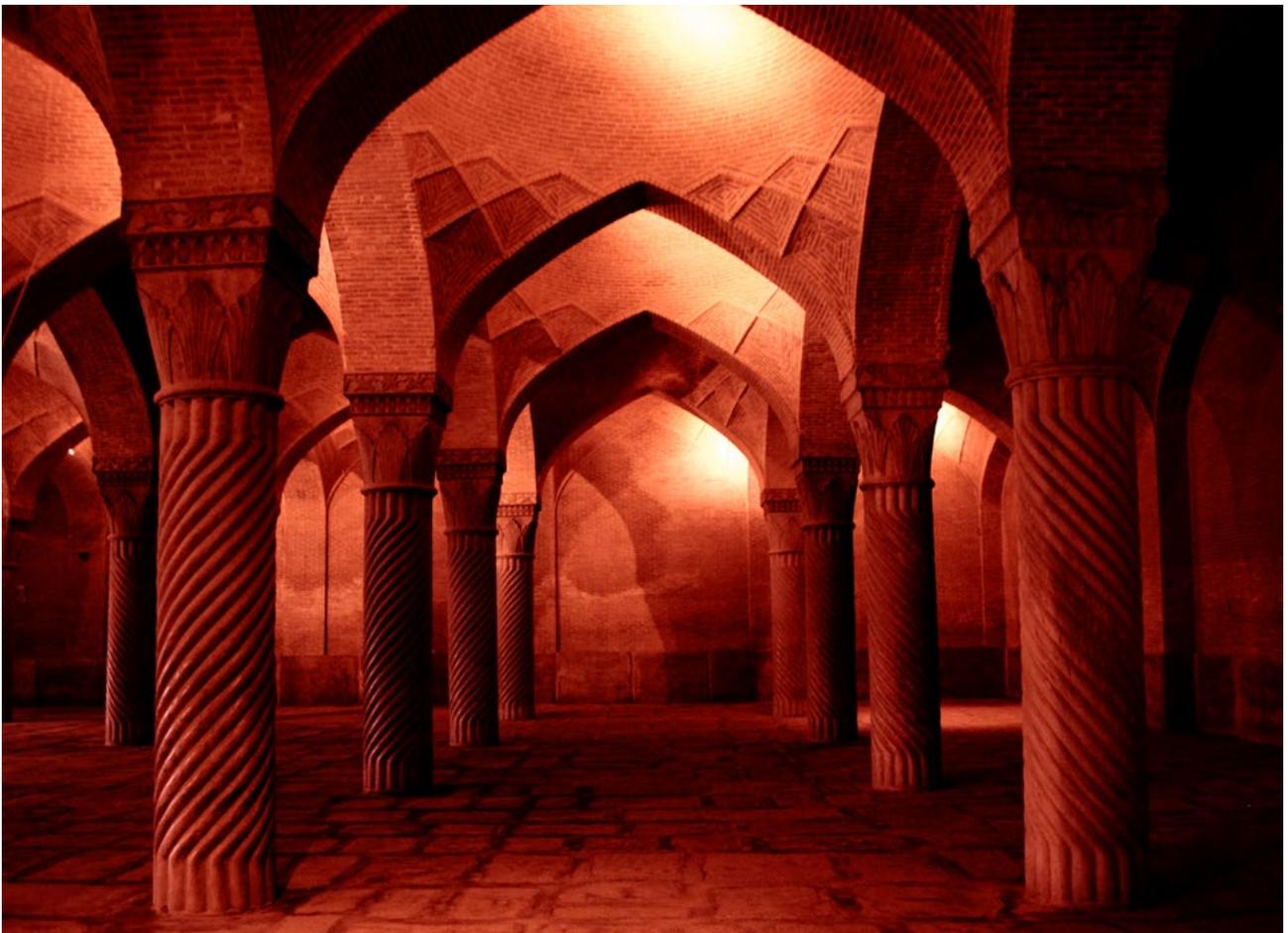
Aside from dispute before the court, there is also the possibility to file legal actions against domain names in Iran as per the E-Commerce Law.

- **E-Commerce Law**

Article 66 of the E-Commerce Law states: “use of trademarks as domain name or any online usage of trademarks which may mislead or deceive the other party in terms of the originality of goods and services is illegal and the offender will be sentenced according to this Law.”

Accordingly, the use of a mark as described in the above Article is prohibited by the law and is considered an infringement of the owner’s right and the owner has the right to file a criminal action against the opponent. Article 76 of the E-Commerce Law defines the amount to be paid along with the duration of the imprisonment (if decided by the judge).

For more details, please contact us at iran@tag-legal.com



China's Trademark Applications Hit Record High in 2017

BEIJING - China's trademark applications exceeded 5.7 million last year, up 55.7 percent year on year, both setting record highs.

Most of the applications were made online as China has streamlined the trademark application process, according to the Administration for Industry and Commerce.

At the end of 2017, China had 14.92 million qualified registered trademarks, the most of any country worldwide.

Thirty-seven Chinese brands made it into the top 500 global brands last year, an increase of 150 percent compared with 2013, according to the World Brand Lab.

China is also the third largest applicant for trademark registration in the international trademark alliance Madrid System with 4,810 applications in 2017, up 59.6 percent year on year, which shows the fast pace of Chinese firms expanding overseas.

Xinhua



New Penal Code an Effort to Update Omani Judicial System, Says Supreme Court Judge

MUSCAT - The promulgation of the new penal law comes within the royal care of His Majesty Sultan Qaboos bin Said, the Chairman of the Supreme Judicial Council to update the legal system and develop legislations to ensure sustainable development in all fields, Dr. Mohammed bin Abdullah Al Hashmi, Judge of the Supreme Court and Head of the Judicial Inspection said.

He added in a statement that the penal law, besides the other laws, such as the civil transactions law, the investment law, the commercial companies law, the industrial and intellectual property law, the procedural law and other laws, contribute to enhancing the public security. It is also a major step forward in updating the laws in force and keeping pace with modern legislations.

The new Penal Code provides appropriate punishment that meets the needs of general and private deterrence and ensures the interests of the society.

It also meets the needs to maintain public order and moral as well as safety of the individual property and souls.

He pointed out that the new law is the outcome of a long path of revisions and coordination among the relevant stakeholders to avoid the remarks that appeared during the enforcement of the old penal code.

‘The judicial inspection, under the guidance of Sheikh Dr. Ishaq bin Ahmed Al Busaidi, Chairman of the Supreme Court and Head of the Administrative Council for Judiciary, keeps pace with the developments of the new law to ensure sound enforcement of the new law.’

Times of Oman



Syria Facilitates Procedures for Business Owners to Register their Trademarks

DAMASCUS - Minister of Internal Trade and Consumer Protection Dr. Abdullah Al Gharbi affirmed that the Ministry is exerting all efforts to facilitate and simplify procedures for business owners to get trademarks of their goods and products as soon as possible to acquire protection.

The Minister addressed participants in a training course organized for staff in the field of protection of commercial and industrial property at the departments of Internal Trade and Consumer Protection in the Syrian governorates urging business owners to use the barcode for all their products and goods because it is the best solution to detect fraud and manipulation. He stated that the protection of a brand increases the value of a product to millions or even billions of when it becomes a well-known brand.

Al-Gharbi called on the Internal Trade and Consumer Protection departments to intensify their field inspection visits on the markets to stop any violation, whether in terms of changing specifications, imitating or falsifying products, commodities or brands, and dealing with the phenomenon of smuggling because of its negative effects on the national economy.

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