

COALITION PROVISIONAL AUTHORITY ORDER NUMBER 80

AMENDMENT TO THE TRADEMARKS AND DESCRIPTIONS LAW NO. 21 OF 1957

Pursuant to my authority as Administrator of the Coalition Provisional Authority (CPA) and under the laws and usages of war, and consistent with relevant U.N. Security Council resolutions, including Resolution 1483 and 1511 (2003),

Having worked closely with the Governing Council to ensure that economic change as necessary to benefit the people of Iraq occurs in a manner acceptable to the people of Iraq,

Acknowledging the Governing Council's desire to bring about significant change to the Iraqi intellectual property system as necessary to improve the economic condition of the people of Iraq,

Determined to improve the conditions of life, technical skills, and opportunities for all Iraqis and to fight unemployment with its associated deleterious effect on public security,

Recognizing that companies, lenders and entrepreneurs require a fair, efficient, and predictable environment for protection of their intellectual property,

Noting that several provisions of the current Iraqi trademark legislation do not meet current internationally-recognized standards of protection, and that current Iraqi legislation does not extend protection to geographical indications,

Recognizing the demonstrated interest of the Iraqi Governing Council for Iraq to become a full member in the international trading system, known as the World Trade Organization, and the desirability of adopting modern intellectual property standards,

Acting in a manner consistent with the Report of the Secretary General to the Security Council of July 17, 2003, concerning the need for the development of Iraq and its transition from a non-transparent centrally planned economy to a free market economy characterized by sustainable economic growth through the establishment of a dynamic private sector, and the need to enact institutional and legal reforms to give it effect,

In close consultation with and acting in coordination with the Governing Council, I hereby promulgate the following:

Section 1
Amendments to the Trademarks and Descriptions Law No. 21 of 1957

- 1) The Trademark and Descriptions Law No. 21 of 1957 is hereby renamed the “Trademark and Geographical Indications Law”.
- 2) Article 1, definition for “Mark” is amended to read as follows: ““Mark” – Shall include trademarks, service marks, collective marks and certification marks.
- 3) Following the definition for “Mark”, a definition for “Trademark” is added to read as follows: "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 trademarks. 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.
- 4) Following the definition for “Trademark”, a definition for "Service Mark" is added to read as follows: "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.
- 5) Following the definition for “Service Mark” a definition for “Certification Mark” is added to read as follows: "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.
- 6) Following the definition for “Certification Mark” a definition for “Geographical Indications” is added to read as follows: “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 characteristic of the good is essentially attributable to its geographical origin.

- 7) Following the definition for “Geographical Indications” a definition for “Collective Mark” is added to read as follows: “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.”
- 8) Following the definition for “Collective Mark” a definition for “Nice Classification” is added to read as follows: “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 and amended.”
- 9) Article 2.1 is amended to read as follows: “1. There shall be kept at the Ministry of Industry a Register in the custody of the Registrar, wherein shall be recorded all the marks, the names and addresses of their owners, and descriptions of their goods. The public shall be entitled to inspect the Register. The public shall also be entitled to receive certified copies thereof on payment of the prescribed fees.”
- 10) Article 2.2 is suspended.
- 11) Article 3 is amended to read as follows: “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.”
- 12) Article 4 is amended to read as follows: “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.”
- 13) 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 be 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 of 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.
- 14) 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.”
- 15) Article 5.1 is amended to read as follows: 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 or services, registrability will depend on distinctiveness acquired through use.
- 16) Article 5.2 is amended to read as follows: “2. Marks, expressions, or designs which are contrary to public order or morality.”
- 17) Article 5.3 is amended to read as follows: “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.”
- 18) Article 5.4 is amended to read as follows: “4. Marks which are identical with, or similar to, the insignia of the Red Cross, Red Crescent, or Geneva Cross.
- 19) Article 5.5 is amended to read as follows: “5. The name, title, portrait, or armorial bearing of a person except with that person’s written consent.”
- 20) Article 5.6 is amended to read as follows: “6. Designations of honorary degrees to which the applicant is unable to prove a right.”

21) Article 5.7 is amended to read as follows: “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.”

22) Article 5.8 is amended to read as follows: “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.”

23) Articles 5.9-5.12 are suspended.

24) Article 6*bis* 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.”

25) Article 7 is amended to read as follows:

“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.”

26)Article 8 is amended to read as follows: “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.”

27)Article 8*bis* is added following Article 8 to read as follows:

“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.”

28)Article 9 is suspended.

29)Articles 12.2 and 12.3 are suspended.

30)Article 15 is amended to read as follows:

“1. The owner of a mark shall, on completion of registration thereof, 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.”

31)Article 17 is amended to read as follows: “The ownership of a mark shall be transferable and the mark shall be pledged or seized together with the business

dealing in the goods carrying that mark, or with that part of the business connected with the use of and symbolized by the mark.”

32) Article 18*bis* is added following Article 18 to read as follows:

“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.”

33) Article 19 is suspended.

34) 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.”

35) 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.”

36)Article 24.1 is suspended.

37)Article 24.2 is suspended.

38)Article 24.3 is amended to read as follows: “3. 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.”

39)Article 25 is suspended.

40)Article 26 is amended to read as follows: “The Registrar may, whenever there is justification, make any alteration in the Register if this alteration is designed to correct a mistake or to complete a technical deficiency.”

41)Article 27 is suspended.

42)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.”

43)Article 33.1 is suspended.

44)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 not 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.”

45) Article 36 is suspended.

46) Article 36*bis* is added following Article 36 to read as follows: “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.”

47) 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 imported 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.”

48) 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.”

49) Article 38*bis* is added following Article 38 to read as follows: “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 such decisions or, where such publication is not practicable, otherwise make publicly available.”

50) Article 39*bis* is added following Article 39 to read as follows: "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."

Section 2
Entry into Force

This Order shall enter into force on the date of signature.

 4/26/04

L. Paul Bremer, Administrator
Coalition Provisional Authority