

## Types of Trademarks and their patentability in Trademarks Registration System of Iran

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**Abstract:** Trademarks are distinctive signs and symbols which identify certain goods or services as those produced or provided by a certain person or company. The Madrid system for the international registration of marks (the Madrid system) established in 1891 functions under the Madrid Agreement (1891), and the Madrid Protocol. Iran as a member of the Madrid Union, which simplifies the registration of trademarks all over the world, has its own way of registration and therefore some kinds of trademarks which are registered in European countries are not yet registered and therefore protected by Iran's trademark registration regime. This article will help the owners of trademarks like companies and trade organizations in knowing which kind of trademarks are been protected within Iranian borders so that they can have the right view over the protecting efforts.

**Key words:** Trademark, Trademark Registration System of Iran, TRIPs agreements.

### 1. Introduction

Trademarks history goes back to decades, when craftsmen reproduced their signs or marks on their products. Over the years these marks evolved into today's system of trademark registration and protection. Trademarks have an important role for today's global trading system. A trademark is one of the most expensive belongings of a company; for example Google's brand worth more than 100 Billion dollars at the end of 2009. In this condition every company tries to keep its brand out of the reach of those who want to achieve fame and reliability by copying well-known brands.

Not all types of brands are been registered and protected in countries. This research tries to represent a good view over patentable trademarks in Iranian Trademarks Registration System. Therefore after a quick look to the history of the trademark in Iran's written Law, different signs and their patentability will be studied and explained. By reading this article, one may know which kind of trademarks can be registered in Iran and which can't.

### 2. Written law and the concept of Trademark

#### 2.1. The Concept of Trademark and Brand Name:

Trademark is a mark that differentiates goods and services of an institute or a producer from the goods and services of the same guild and competitors. Mark, brand or trademark is a defining mark that is set on a product or is propounded along with presenting services or marketing the product. The use of it is to make the people aware of the industrial or commercial basis of the goods or the service. Almost these types of marks are indirectly a guarantee for the quality because the consumer expects to receive special services and quality from marked goods and services. In addition marks are one of the valuable elements of property and capital appertains to the companies.

Briefly, industrial or service trademarks are the marks which are using for presenting goods and industrial or services in respect of quality and guarantying their materials. These marks may be as complex

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names including design, picture or word or as a fancy basis such as scorpion cologne or as a name of a place or city (Ardebil-Sabalan Honey) and finally as a picture of sign and label drawing or special song and so on. (Mirhosseini: 2006).

Trademark not only should be different from other trademarks and show close relation with type and material of the goods, but also should be designed with innovation and creativity and shall not use general and misleading names. For example the word “sugar” that is general and typical for special goods and materials may not be used as a mark.

## **2.2. The Concept of Trademark in Written Rules:**

In the Law of Iran the trademark was defined and formalized for the first time on 1931. With revert to article 1 of Law registration of marks and inventories ratified on June 22, 1931:

“Trademark includes any type of mark such as design, picture, number, word, seal, envelope and so on which is adopted for monopoly and recognizing industrial, commercial or agricultural product. This is possible that a trademark is adopted for recognizing monopoly of congressional product of farmers or industry owner or businessmen or the product of a city or an area of a territory”.

This definition notifies the essence and the related subjects of Trademarks. Some believe that the word so on means something like the sound, smell and scent. In respect to the definition some terms are very important that are mentioned here:

In this definition the “word” is not mentioned as one of the features of trademark, however it is mentioned in industrial ownership of the other countries like France. In act in Iran and the other countries the trademarks are mostly made from Words.

The second idea is that in the Laws of Iran there does not exist a trademark for the services. In the chart of the industrial and commercial trademarks classification, there is not a specified classification for the services.

By the ratification of patent in 2007, the trademark became more accurate and defined into 3 forms. The clause No. 30 shows:

“Sign, community mark, and the trademarks include:

- Sign is any kind of sign making distinction between the goods or the services presented by legal or real entities from the others’ goods and services.
- Community mark is any visible mark introduced by community mark registered in declaration, capable of making distinctions between the entity or any other specifications like the quality of the registered product or the service presented by legal or real entities and the others.
- Trademark is the name or the title introducing or specifying a legal or real person.”

In the international deeds in the clause No 15, 2<sup>nd</sup> agreement of TRIPS, about the definition of trademark it is mentioned as follows:

“Any kind of sign or a combination of signs differentiating the goods and services of a person from another shall be considered as the worthy trademark”.

And according to what WIPO says in his handbook:

“The trademark is any sign distinguishing the products of a single manufacturing unit from the competitors”.

This definition includes two dimensions of trademarks known as the different performances of trademark reviewing with each other.

To distinguish a product for the consumer, the trademark shall always show the resource of the very product. This does not mean that the trademark shall inform the consumer about the producer or the seller of that product. The important factor is that the consumer shall be informed that a proper producer sells his products under the special trademark, and he is responsible for that.

Being the introducer of the essence, as mentioned above, declares that the trademark shall distinguish the products of a company from the other companies. The process is finished only when a consumer is able to

differentiate the products with different trademarks. The trademarks shall not be misleading and shall contain two factors of distinguishing and identifying. (HashemBeygi: 2007)

### **3. Different signs and their patentability in the Laws of Iran**

#### **3.1 Traditional signs:**

It means the popular signs from the old times and their registration was not complicated, and did not need modern equipment. The most common signs are as follow:

- A letter, a name, or a word: the most common signs were these. It is so difficult to find a commercial unit not registering a word or name. The used words maybe meaningful or meaningless. For example “TD” is the registered name for TOLID DAROO Company and has no meaning. The sign can also be a combination of some letters. It shall be mentioned that in several cases in addition to registering the signs, the names are also registered through this method. For example the DELKATE Company besides registering the scent and the taste of its cheese, has also a trademark with the shape of the word “Delkate”. The below mentioned examples are the famous registered brands with the letter, name, or the word. Therefore, registering these kinds of brands is not forbidden in the country of Iran.
- Numbers: the numbers can be registered as the sign or the symbol of a company or a manufacturer. In the below mentioned sample, the sign of the 50<sup>th</sup> anniversary of the establishment of the human rights organization and a western company are illustrated. According to the registration Laws of Iran, the numbers with special figures changing into signs are patentable. (Shams:2003)
- Two and three dimensional pictures: most of the brands are registered two dimensional, but some of them are registered three dimensionally for some reasons. In this way, the dimensions are inimitable, and not only the figure, but also the surroundings of it are under the protection of the legislator. Registering three dimensional figures is not allowed in Iran and brands have to be two dimensional to be protected.
- A sentence or a motto: the manufacturers are allowed to register some sentences and catch phrases they use to introduce their products as the trademark of their products. Below are some of the examples. The sentences or the mottos of a company shall be protected only when they are used with the brand.
- Colors: most of the designs and trademarks contain colors, but registering a color or colors without any name or other signs is also possible. The below sign is owned by a Turkish company. According to the Laws of Iran the signs which are only colors are patented in some conditions.

#### **3.2 Modern signs:**

Because of the development in technology and the information transfer skills and the commercial advertisements the methods of goods introduction is changed. Now, besides watching the simple figure of the product, the other ways like animation, hologram, musical notes and sounds, scent and taste are also are used to introduce and distinguish the products. The important notion is the way of their registry.

Although all these elements can be seen and have two features of distinguishing and introducing, but registering all the features of it is not possible in all countries. For example in Iran the taste or the scent of a product cannot be registered, unlike the U.S that all the specifications are patentable.

- Animated pictures or the multimedia: animated symbols or the multimedia are the methods that the producers introduce their products in a more attractive way. The importance of this kind of sign is obvious in digital media advertisings. The following example is the logo of Nokia Company. Since the sign registration system of Iran is based on the declaration, these kinds of signs cannot be registered in Iran.
- Hologram: the other method of introducing and presenting products is the hologram. These kinds of signs are the distinguishing feature of a special product because it shines in the sunshine. Hologram is not protected in the sign registry system of Iran.

- Touch marks: it is a kind of sign or mark by which the consumer recognizes his/her desirable product by touching it. The carvings on some of the samovars, lighters, and steel dishes are of this kind. The touch marks are not subject to protect and register in Iran.
- Sound or the music notes: some of the companies use the music notes and sounds besides their exclusive registered signs. For example, in Iran the BUTANE Company uses this method to introduce its products, and in other countries the NBC channel, VISA Credit card and Intel have the registered music. The way of registration of this method is also easier because recording is simpler. We behold an example of a registered note below. Although the music is popular in Iran, but it is not patentable as a brand.
- Scent or the olfactory: some of the countries in the U.S and Europe register a special scent of their product besides their product sign. For example an American company manufacturing a kind of industrial oil produces its product with a scent of a kind of chewing gum, and by registering it, forbids the others to use this kind of scent. This kind of registration is also popular in detergents, clothes, and health materials. The Qualitex Company is a company presenting its products with a registered scent. The scent is not determined in the sign registration system of Iran.
- Taste: the taste of a product can also introduce a special product of a manufacturer. To attain this, the taste must be new and recognizable. The tendencies of different sign registration systems are different. For example, the taste of a product is not patentable in Iran, unlike America and Europe that is vice-versa. Delkate cheese that is a sweet cheese is a kind of product which its taste is registered. Just like the scent, the taste is not patentable in Iran.
- Position: in this kind of signs a part or an organ of a body can introduce the product. Of course only the special position of the body is not enough, and the design, picture, or any distinguishing sign shall be added. In so many countries like Iran, these signs cannot be registered.

#### 4. Conclusion

Trademark is a sign to distinguish manufactured products or the presented services by a company from the ones presented by others. Any kind of words, letters, numbers, pictures, figures, and colors used to distinguish the goods and services can be considered as trademarks. In some countries the commercial labels are also considered as trademarks and are able to be registered in national administrations of trademarks. A considerable number of countries also register modern trademarks like single colors, three dimensional signs of the products or their packages, sounds and scents. However, some countries limit the features able to be registered as trademarks, and they only register the visual signs as the trademarks.

In Iran, even after the ratification of new Law of industrial plans and trademarks patent, only the written or traced marks are registered and the new forms of signs like animated pictures, taste or scent are not patentable. It is recommended that the Iranian legislator consider these marks as patentable ones and protect them to provide suitable situation to support foreign marks in Iran.

#### 5. References

- [1] Hamid HashemBeygi, intellectual property, Jihad Daneshgahi Publication, Tehran, 2007
- [2] Abdolhamid Shams; the law of industrial and trademarks ownership, SamtPublication, Tehran, 2003.
- [3] Seyed Hassan Mirhosseini, an introduction to intellectual property, Mizan Publication, Tehran, 2006.
- [4] WIPO Intellectual Property Handbook- WIPO, Geneva, 2004.
- [5] New Forms of Trademark-WIPO, Available at: [www.WIPO.org](http://www.WIPO.org)