

DOI: <https://www.doi.org/10.36719/2789-6919/09/40-43>

**Emin Bayram Musayev**  
Baku State University  
master  
emiin.musayev@gmail.com

## WHAT PROTECTS THE LEGAL REGULATION OF TRADEMARKS

### Abstract

The importance and economic value of a trademark, which is the primary consideration of consumers in the process of choosing goods or services in the global market, is growing day by day. Like rights arising over objects such as inventions, industrial designs, utility models and know-how, trademark rights are, in essence, industrial property rights. The reason for the protection of the right to a trademark is closely related to its purpose in the market. If a trademark does not indicate the source of products in a particular sector of the market, or does not form an opinion of the consumer about the quality of the goods or services, then the trademark is out of the question.

**Key words:** *consumption, trademark, economic value, utility models, global markets*

**Emin Bayram oğlu Musayev**

### Ticarət hüquqi tənzimini nə qoruyur

#### Xülasə

Qlobal bazarda mal və ya xidmətlərin seçimi prosesi zamanı istehlakçıların ilk növbədə nəzər yetirdiyi ünsür olan əmtəə nişanının əhəmiyyəti və iqtisadi dəyəri getdikcə artmaqdadır. İxtiralar, faydalı modellər, sənaye nümunələri və “nou-hau” kimi obyektlərin üzərində yaranan hüquqlar kimi, əmtəə nişanı hüququ da, mahiyyəti etibarilə, sənaye mülkiyyəti hüququ hesab olunur. Əmtəə nişanı hüququnun qanunla mühafizə olunmasının səbəbi onun bazardakı təyinatı ilə sıx əlaqəlidir. Hər hansı bir əmtəə nişanı bazarın müəyyən bir sektorunda məhsulların mənbəyinə işarə etməsə, ya da mal və ya xidmətin keyfiyyəti haqqında istehlakçıda fikir formalaşdırmasa, əmtəə nişanından söhbət gedə bilməz.

**Açar sözlər:** *istehlak, əmtəə nişanı, iqtisadi dəyər, faydalı modellər, qlobal bazarlar*

### Introduction

Since the beginning of the twentieth century, along with traditional symbols such as words, images, logos, graphic designs or combinations, new types of symbols have emerged and are used by owners of goods or services to facilitate faster and better communication with the consumer. The new type of badges are called non-traditional badges in the legal literature. Non-traditional trademarks are widely criticized for their innovations in trademark law. Many countries do not have an appropriate legal framework in place for the registration of such markings as color, sound, smell or taste. However, when a non-traditional mark has the ability to distinguish and identifies goods or services, the question of whether such marks are registered seeks a solution in the doctrine (Carti, 2012: 155).

The definition of a trademark is given in both international and national legislation, as well as in the legal literature. A trademark is a legal and economic term. According to the British Encyclopedia, “a trademark is any visible sign or symbol used by an enterprise to identify its goods and to distinguish them from goods manufactured or transported by others.” According to the economic dictionary, a trademark means “a name, mark, symbol, image, symbol or mark that allows to distinguish the goods of a particular manufacturer or seller from similar goods of other sellers and consumers”.

Although the Paris Agreement on the Protection of Industrial Property of 1883 (Paris Agreement) does not define a trademark, some international agreements, such as Article 15 of the Agreement on TRIPs 1 Paragraph 3 defines the trademark. According to this paragraph, “any mark or combination of signs that distinguishes the goods or services of one enterprise from the goods or services of other enterprises may be a trademark.” The TRIPs Agreement refers to such symbols as “in particular, any combination of these names, including personal names, letters, numbers, descriptive elements and color combinations”. The definition of a trademark in the TRIPs Agreement has contributed to the formation of the concept of a trademark in the European Union and other Parties (Karadenizli, 2018: 21).

The list of marks that can be registered as a trademark in the TRIPs Agreement does not constitute a closed circle. The phrase "especially" used in the first paragraph of Article 15 indicates that the listed symbols are considered to be trademarks and that there is a consensus among the States Parties on this subject. The article in question is important from the point of view of whether non-traditional symbols are included in the scope of the agreement. While some in the literature support the broad interpretation of the list in the TRIPs Agreement, arguing that the trademark's distinctive feature plays a leading role, some authors argue that the list is closed.

The Paris Agreement, with 177 member states, is one of the most influential international instruments on the protection of intellectual property rights. The Paris Agreement entered into force in the Republic of Azerbaijan on December 25, 1995.

Despite efforts to harmonize trademark approaches in national legal systems in the drafting of international conventions governing different types of intellectual property rights, a common definition of a trademark has been one of the challenges faced by many international and regional legislative commissions. In particular, this problem was not purposefully set aside in the negotiation process of the Paris Agreement. On the contrary, a number of discussions on the concept of a trademark, unfortunately, were fruitless. At the Washington Congress in 1956, after the 1952 Vienna and 1954 Brussels talks to revise the Paris Agreement, representatives of the International Association for the Protection of Intellectual Property Rights stated that a single commodity would be in force in all member states of the Paris Agreement. Adoption of the definition of the mark may be an untimely step (Durmaz, 2016: 82).

As the Republic of Azerbaijan is not a party to the World Trade Organization, as well as the TRIPs Agreement adopted on April 15, 1994 as Additional Document 1C of the Moroccan Agreement, the TRIPs Agreement has no legal force in the Republic of Azerbaijan.

In the legal literature, trademark definitions are usually based on the ability to differentiate. In the Turkish legal literature, a trademark is defined as a sign that identifies a product or service more, distinguishes it from other goods or services, and thus assists consumers in their choice by adding value to the goods or services. In other approaches, a trademark is interpreted in a broader sense than the symbols that indicate the source of the product. Thus, a trademark in a broad sense contains abstract meanings that a specific form of expression conveys to the mind of the consumer. Because emotional decisions play an important role in consumers' choice of goods or services. In the literature, in general, the definitions given to trademarks seem to explain this object of industrial property very simply. However, in both national and international law, the distinctiveness of the trademark registration, the product individualization function of the trademark is not enough, and the graphic description of the trademark applied for registration is equally important (Martin, 2018, 45:5).

According to different forms of classification, trademarks are divided into several groups in the legal literature. Trademarks and service marks for the purpose of use, standard and widely recognized marks according to the level of recognition, individual, group, joint and warranty marks according to the subject are some of these groups. In addition, changes in marketing strategies used today, especially by well-known firms, have led to the emergence of a new classification in the trademark literature, distinguishing between traditional and non-traditional trademarks.

Non-traditional trademarks used to establish more effective communication with consumers in trade have been criticized in the legal literature for altering the fundamental properties of the trademark. Indeed, compared to traditional trademarks, such as sound, smell, and taste, which are invisible to the human eye, but perceived through other senses, thus addressing consumer aesthetic tastes, are problematic questions for consumers to understand as a trademark and graphic representation in the register. Neither the trademark legislation of the Republic of Azerbaijan nor international agreements provide a single definition of non-traditional trademarks. The non-traditional notion of a symbol formed in the legal literature includes symbols that do not belong to symbols such as words, numbers, logos, designs or combinations thereof and indicate the source of the goods or services. According to the classification of the International Intellectual Property Organization (IPO), non-traditional visual symbols include three-dimensional symbols, independent colors, holograms, movements, positions and gestures, and invisible symbols include sound, taste and texture symbols (Schmidt-Szalewski, 2018: 189).

Non-traditional signs, like other signs, must be able to distinguish and graphically describe the goods or services used. The introduction of the condition of distinction in international agreements on the protection

of trademarks has made it possible to register non-traditional trademarks. From the point of view of non-traditional trademarks, the decision of the Federal Court of the United States of America (USA) in the Qualitex case in 1995 to register an independent color as a trademark has significantly changed the views formed in the legal literature. The world's first non-traditional trademark was the roar used by Metro Goldwin Mayer, registered by the US Patent and Trademark Office as a sound signal on April 4, 1950. The sound sign is one of the trademarks protected in France and Germany (Adolf, 2011: 49).

Among the international and regional agreements on the protection of industrial property, the Paris Agreement is distinguished by its wide scope and content. The agreement, which entered into force in the Republic of Azerbaijan on December 25, 1995, contains provisions on the protection of trademarks both in national law and at the international level. According to paragraph 2 of Article 148 of the Constitution of the Republic of Azerbaijan, "International agreements to which the Republic of Azerbaijan is a party are an integral part of the legislative system of the Republic of Azerbaijan." In other words, the Paris Agreement is also included in the legislative system of the Republic of Azerbaijan, and the provisions of this agreement have legal force in the territory of the Republic of Azerbaijan.

Despite the extensive regulation of industrial property in the Paris Agreement, the lack of a definition of a trademark is one of the aspects of the agreement that has been criticized in the literature. This shortcoming in the Agreement was later compensated by the definition of a trademark in the TRIPs Agreement. Nevertheless, the Paris Agreement contains quite progressive provisions for the registration of non-traditional marks. Pursuant to Article 6quinquies Article A (1) of the Agreement, "any trademark duly registered in the country of origin may be declared in other countries of the Union and shall be protected as amended by this Article". In the authentic English and French versions of the agreement, the protection of trademarks referred to as "as to the form" and "telle quelle", respectively, "as in other countries" has been discussed in the literature. The subject of the dispute is whether the expression used in the agreement recognizes the right of direct protection of the mark registered in one of the member states of the Union in other states, or only the formal protection of such marks. To be more precise, when the relevant paragraph is interpreted narrowly, in one of the Member States of the Union, for example, the holder of a trademark registering a trademark submits this registration to the trademark office of other countries as evidence to prevent a possible rejection of the mark. According to the broad interpretation of this provision, the trademark owner must be given the right of direct protection in other countries (Carapeto, 2016: 27).

It is clear from the regulations in the national legislation that color combinations and volume marks from non-traditional symbols are signs that can be registered as a trademark. However, it is questionable whether other non-traditional trademarks, such as independent colors, sound signals, or odors, are registered as trademarks. This is because it is controversial that the signs in Article 4 of the Law on Trademarks and Geographical Indications form a closed circle. Unlike Article 15, paragraph 1, of the TRIPs Agreement, the list may have a limited scope because the word "especially" is not used in the list provided by law (William, 2017: 265).

In our opinion, the main reference point for the registration of a mark as a trademark should be Article 1 of the Law. If the mark has a distinctive feature on the goods or services and can be graphically described in the register, it must be registered as a trademark. When examining the distinctiveness, "forms reflecting the nature of the goods, giving them significant value and necessary for technical achievement" regulated in Article 5, paragraph d) of the Law, which prohibits the registration of a trademark, must be carefully examined and the registration of trademarks consisting of these forms refused. This is because the registration of functional marks can lead to disproportionate damage to competing firms by giving the badge owner exclusive rights over the shape, color and other markings that constitute a technical necessity. The application of Article 5 (d) of the Law is very important from the point of view of the purposes of trademark law. However, in the same article of the Law, it is an important mistake to count the signs in paragraph d) among the signs that may be distinguishable when used. Thus, the EU Trademark Directive 2015/2436 does not include functional markings between distinguishing marks when used. Such marks referred to in subparagraph (e) of paragraph 1 of Article 4 of the Directive may not be registered as a trademark, even if they acquire distinguishing marks. Otherwise, the rectangular shape of the phone, the registration of white as a trademark for dairy products, may force competing entrepreneurs to incur additional costs and think

about other forms, avoiding technical necessity. This contradicts the conditions of a free competitive environment.

Although many non-traditional symbols can be used on goods or services to distinguish them, graphic representation is an objective condition, ie symbols such as sound, smell and taste are not suitable for graphical representation in the register. The graphical description condition, described as a fixed reference point in the register, has been replaced by Article 3 of the Trademark Directive 2015/2436, which stipulates that "the subject of protection may be indicated in the register provided it is clearly understood by the authorities and the public." Although this Directive simplifies the legal framework for the registration of non-traditional signs consisting of sound and independent colors, the national legislation of the Republic of Azerbaijan continues to have a conservative approach to the registration of such signs (William, 2019, 9:1).

### Conclusion

The distinctiveness and function of a trademark play a crucial role in the study of whether non-traditional trademarks can be trademarks. The marks listed in Article 4 of the Law on Trademarks and Geographical Indications are not the only signs that can be registered as a trademark. If the conditions of Article 1 of the Law are met, other marks must also be protected as trademarks. In order to be registered as a trademark, a conventional mark must be distinctive and must be graphically represented in the register.

We believe that the consensus in the European Union on the ability of symbols, such as independent colors, sounds and symbols, to be trademarks, should be reflected in the definition of national legislation, although not for all types of non-traditional symbols. At the same time, the definition set forth in Article 3 of the EU Trademark Directive 2015/2436 should be included in national legislation, in particular in terms of replacing the condition of graphic representation. The current regulations are positive about the form and packaging of goods from non-traditional labels, as well as the registration of color combinations. Today, it is almost impossible to record signs such as smell and taste, in terms of both graphic description and the condition that they can be clearly and accurately displayed in the register.

### References

1. Adolf, H. (2011), The Trade-related Aspects of Intellectual Property Rights and Developing Countries, The Developing Economies.
2. Carti, A. (2012), Müəssisələr üçün brendinq və brendinq qərarlarının əhəmiyyəti.
3. Carapeto, R. (2016), About the Introduction of Non-Conventional Trademarks, Waseda Bulletin of Comparative Law.
4. Durmaz, Y. ve Ertürk S. (2016), Brend Tətbiqləri və əhəmiyyəti, Uluslararası Akademik Değer Çalışmaları Dergisi.
5. Karadenizli, H.T. (2018), Yeni əmtəə nişanlarının növləri və onların qeydiyyatı (İxtisas tezisi, Türk Patent İnstitutu, Ticarət Nişanları Bölməsi).
6. Martin, C. (2018), Meaning of Distinctiveness in Trademark Law, Northwestern University Illinois Law Review.
7. Schmidt-Szalewski, J. (2018), The International Protection of Trademarks after the TRIPs Agreement, Duke Journal of Comparative & International Law.
8. William, M., Richard A. (2017), Trademark Law: An Economic Perspective, The Journal of Law and Economics.
9. William, J. (2019), Development of Evidence to Support Color-Based Trademarks, Journal of Law and Commerce.

**Rəyçi: h.ü.e.n. Aydan Məmmədova**

Göndərib: 06.04.2022

Qəbul edilib: 12.05.2022