

Vilau & Mitel

Overcoming inconsistencies

Well-known trademarks are protected in Romania, but a number of court decisions have highlighted inconsistencies in approach

Well-known trademarks are protected in Romania pursuant to Article 6*bis* of the Paris Convention for the Protection of Industrial Property – of which Romania is a founding member. The members of the union created under the Paris Convention undertook to protect trademarks against reproductions, imitations and translations for identical or similar goods and which are likely to create confusion if such trademarks are well known in that country.

The Agreement on Trade-Related Aspects of Intellectual Property (TRIPs) brought additional protection for well-known trademarks by providing in Articles 16(2) and 16(3) that well-known trademarks are protected even in the case of goods or services which are not similar to those in respect of which a trademark is registered, “provided that use of that trademark in relation to those goods or services would suggest a connection between those goods or services and the owner of the registered trademark, and that the interests of the registered trademark’s owner would likely be damaged by such use”.

Article 4 of the EU Trademarks Directive (2008/95/EC) provides protection for an earlier well-known trademark, as defined by Article 6*bis* of the Paris Convention, in case of identical or similar trademark applications for identical or similar goods or services. The directive further provides that a trademark may be refused or invalidated if it is identical or similar to an earlier Community trademark registered for goods or services which are not similar, where the earlier Community trademark has a reputation in the Community and where the use of the later trademark without due cause would take unfair advantage of or be detrimental to the distinctive character or reputation of the earlier mark.

Well-known marks

The Trademark Law defines a ‘well-known’ trademark as a “widely known mark to the relevant segment of the public... without registration or use being required” and uses the well-known concept throughout the Trademark Law and the Governing Rules. Both the law and the rules also contain the concepts of ‘trademarks that have gained fame’ and ‘famous Community trademarks’, although these are not defined.

In the absence of any EU or national legal definition, Romanian doctrine and case law have drawn inspiration from US legislation, stating that the competent authorities and national courts should establish the well-known or famous character of a trademark on a case-by-case basis.

Nevertheless the Trademark Law specifically provides (as required by the Paris Convention and TRIPs) that neither registration nor use in Romania need be proved when a rights holder claims that its mark is well known.

Despite this clear provision, the Trademark Law’s Governing Rules provide that anyone claiming that its trademark is well known must submit evidence attesting that the mark is largely known to the relevant segment of the public in the Romanian territory based on the following non-exhaustive set of criteria:

- the initial or acquired distinctiveness of the mark;
- the scope and duration of use of the mark;
- the scope and duration of advertising for the mark;
- the geographical area of use of the mark;
- the degree of knowledge of the mark; and
- the existence of other third parties with identical or similar trademarks for identical or similar products or services.

Case law

Despite these requirements – which have been seen either as a helping hand or as an impediment to obtaining recognition of a well-known trademark, depending on the burden of proof – the Romanian courts and the Romanian Trademark Office have proved quite open about dealing with well-known trademarks, confirming that the provisions of the Trademark Law should take precedence over those set out in the Governing Rules.

When determining whether a mark is distinctive and famous, a Romanian court must consider the mark’s degree of inherent or acquired distinctiveness, the duration and extent of its use in connection with the goods or services for which it was used, and the duration and extent of advertising of the mark.

In accordance with the World Intellectual Property Organisation’s (WIPO) Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, together with the principles outlined in the law, the Paris Convention and TRIPs, the Romanian courts also take account of the duration and geographical area of any registrations and/or applications for registration, any record of successful enforcement of rights in the mark – in particular, the extent to which it has been recognised as well known by the competent authorities – and the mark’s associated value.

One of the pioneer cases in Romania involving the acknowledgement of a well-known trademark was *BEEFEATER (Allied Domecq v Prodal 94 SRL)* (Case 3850/1/2002 (5170/1999)). In this case the plaintiff filed documents attesting to registrations in 119 countries, imports made on the date of filing the application, labels, pictures, evidence of advertising abroad and the value associated with the trademark.

In *Starbucks Coffee Company v Grupul Roman de Investitii GRI SA* (Case 1745/2003) the Bucharest Court of Appeal took the view that Starbucks' national registration application should be refused, based on Article 6bis of the Paris Convention. The decision confirms that this provision also applies to services. The evidence submitted to the court to establish whether that the mark was well known included registrations of the mark in other jurisdictions, articles in different magazines around the world, the value of the trademark as published in *Interbizz* or *Fortune* magazines, product placements in various movies and affidavits.

This evidence and the decisions presented in both cases are in line with those filed in the European Union and international cases.

Inconsistency in case law

However, there were several cases between 2004 and 2010 in which the Romanian courts embraced the quantitative elements, to the detriment of the legal criteria for considering that a trademark is well known.

One such case was *Intel v Intelprof* (Case 2009/3/2003). The Bucharest Tribunal maintained that the INTEL marks were well known in Romania in 1996 – on the date that Intelprof's trademark application was filed. The decision was based on complex evidence of sales and advertising of Intel products in Romania beginning in 1993, and on the conclusions of three IP and IT experts appointed to establish the degree of knowledge for a Romanian IT consumer. Without denying the findings of the courts, the High Court of Cassation and Justice decided to remand the file to the lower court, given that the degree of knowledge was not determined "as required by the ECJ case-law" by providing the percentage of the relevant public.

The same solution was adopted in other cases decided by the Bucharest Court of Appeal and the High Court of Cassation and Justice with respect to the MIORITA mark (Decision 797/26.10.2004), the SZABADSÁG mark (Decision 91/R/26.04.2005), the RED BULL mark (Decision 221/R/30.03.2007) and the METAXA mark (Decision 6559/3.12.2010). In all of these cases the court maintained that it was not possible to determine what percentage of the relevant public was familiar with the mark based on the evidence filed "as required by CJEU Decision in *Chevy* (C-375/97 – *General Motors v Yplon SA*)".

Such decisions are actually not in accordance with the European Court of Justice's decision in *Chevy*, where it was maintained that "it cannot be inferred



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from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined" (par 25 of the decision) nor with the 1999 WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, according to which neither the quantitative elements based on percentages of the relevant sector of the public nor the qualitative ones should be given priority when determining that a trademark is well known, and "the determination in each case will depend upon the particular circumstances of that case".

How should rights holders prove their marks are well known?

Based on the guidelines set out above, the Romanian courts have found that the RAMADA, BEEFEATER, STARBUCKS, CHIVAS, GAP, UNICREDIT, CAMPER, ADIDAS, ROTARY, BAUMIT, INTEL and RED BULL marks were all well known in Romania on the date that applications for these were filed by third parties. The last two marks have been confirmed and reconfirmed as being well known several times over the years by the Trademark Office and the Romanian courts.

Rights holders should be aware that in order to establish that a mark is well known in Romania on the date of a third-party application, a Romanian court or the Romanian Trademark Office will take into consideration the legal criteria set out in the Trademark Law and the Governing Rules.

The Trademark Office has proved open to evidence such as market surveys, independent market share and sales reports, examples of advertising, advertising and promotional materials and affidavits, while the courts have been inclined to rely less on affidavits and more on independent evidence, such as marketing and advertising agreements and materials, samples of advertising in magazines and media, and independent market surveys. [WTR](#)