

Vilau & Mitel

An open approach to registration

Reflecting the current trend towards the use of less conventional signs, the Romanian trademark office is open to the registration of non-traditional marks – with certain caveats

The Trademark Law 1998 (significantly amended in 2010) follows the principles of the EU Trademarks Directive (89/104/EEC). Thus, a ‘trademark’ in Romania is defined, in rather standard language, as any sign that is capable of being represented graphically and distinguishing one entity’s products from those of others. Such signs include words, names, designs, letters, figures, three-dimensional (3D) forms, product or packaging shapes, colour combinations and any combination thereof.

Most trademarks registered in Romania are traditional visual signs. However, statistics show that trends are changing, with applications on the rise for less conventional signs, especially colour, 3D and sound marks.

The Romanian Trademark Office (RTO) usually registers trademark applications for words or words and devices; however, it is open to registering 3D, sound and colour marks, provided that these are capable of visual representation and are sufficiently distinctive.

Colour marks

Although the Trademark Law 1967 expressly mentioned that “one or more colours” could be registered as a trademark, the RTO prosecution rules provided that a single colour is not sufficiently distinctive for registration as a trademark. The language of the existing Trademark Law is clear on this matter: only colour combinations are eligible for registration. However, practitioners have found this approach to be too strict, and legal commentators and courts support the view that single colours may be registered, provided that they have acquired secondary meaning (ie, distinctiveness through use).

There are three notable examples of single colour trademarks that were accepted

for registration by the RTO after sufficient evidence was submitted on distinctiveness acquired through use:

- the UPS shade of brown (Reg 052348 and 052349), following a landmark decision passed by the RTO Board of Appeal, according to which the Trademark Law 1998 should not be understood as a barrier to single-colour trademark applications and the UPS brown had acquired distinctiveness through use in the Romanian territory, based on the evidence filed;
- IR 908136 with protection in Romania for the colour orange (Pantone 151), filed by telecoms provider Orange; and
- Trademark 102657 for the colour green (Pantone 553C), filed in connection with a brand of local cereal producer Nutline
- Trademark 093655 for the colour purple (Pantone 258C), filed in connection with services offered by the tourist agency Perfect Tour.

Thus, even though the Trademark Law does not list single colours as registrable trademarks, the fact that single colours can be represented graphically and are capable of being described by an internationally recognised colour identification system (eg, Pantone or CMYK) means that the RTO can accept them for registration, provided that the colour has gained sufficient distinctiveness through use.

According to an RTO representative, there is a strong tendency for trademark owners to apply for single or dual-colour trademarks, or to use the Community trademark registration system as an alternative if national registration for a non-traditional trademark is denied.

Although the Office for Harmonisation in the Internal Market (OHIM) has refused most colour trademark applications where

the applicant did not prove distinctiveness through use, there are currently approximately 254 Community trademarks registered for colour trademarks (single or two colour combinations).

Three-dimensional trademarks

Three-dimensional trademark applications are becoming as common as two-dimensional signs and together represent the bulk of the 125,000-plus registered or applied-for trademarks with the RTO to date.

The shapes of products or their packaging may not:

- be ordinary in the trade or required by the nature of the product;
- be necessary to achieve a technical function; or
- bring substantial value to the product or its packaging.

Each criterion above constitutes an absolute ground for refusal.

According to the RTO, out of the 536 applications filed for 3D trademarks, only two applications were denied registration due to non-compliance with these criteria.

The RTO often uses the example of an application to register the 3D shape of a toothbrush to show how it assesses whether a shape is dictated by functionality. In the *Toothbrush* case (National Application 056665), the RTO initially denied the registration, taking the view that the newly claimed shape (the flexible head) was dictated solely by a technical function, since a patent had been granted 10 years previously for the same toothbrush. However, the trademark was eventually accepted for registration, enjoying protection as a 3D mark (Reg 050817) renewed for 10 years in 2009.

Other notable 3D marks are Registrations 092857 and 092858 (for a

Hummer vehicle body). Although the body or shape of a vehicle is generally dictated by its functionality or purpose, a special or uncommon shape (eg, the shape of a Hummer) is not ordinary; nor is it required by the nature of the product or necessary to obtain a technical function. Finally, it was considered that the shape did not add substantial value to the product.

Over the past two years, 3D trademark applications focused on the shape of bottles for water and other beverages (eg, Trademarks 109120, 109121, 110502 and 112110), the exterior shape of some stores (eg, Application M 2010 06375 for a wine store and Trademark 112948 for a fast-food restaurant), the shape of a pen (eg, Trademark 113679), heating devices and furniture.

Position marks

Romania ratified the World Intellectual Property Organisation's Singapore Treaty on March 16 2009. The treaty expressly recognises 3D marks, holograms, motion marks, position marks and other non-visible signs as trademarks.

Although position marks are not defined in the Singapore Treaty and are not listed in the Trademark Law, position marks have been acknowledged as a new type of non-traditional mark. To date, the RTO has accepted for registration several position trademark applications (086111, 085814 and 086138, which consist of photos showing a courier van from different angles). The RTO has also registered a device combination mark (Reg 086110) where the device may have been filed as a positional mark, although this is unclear. Finally, the RTO recently registered a position trademark (Reg 122708) consisting of a design applied in a specific position on a sports shoe.

Sound marks

Both the RTO and OHIM have had to consider whether certain sounds (eg, rain drops, wind or animal sounds) are capable of being registered as national or Community trademarks.

Given the simple way in which one can visually represent sounds on a musical score, for instance, OHIM has had to open the doors to these types of trademark application. Following the registration of the famous MGM lion roar in 1994, OHIM registered Intel's famous five-note jingle (CTM 008174039) and the Yahoo! yodel (CTM 001772086). The trend picked up and more than 146 sound marks have now been registered as Community trademarks.

In contrast, the RTO has so far



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granted registration to only three sound marks out of five applications. This is not due to a restrictive approach – on the contrary, it appears that examiners are happy to process such applications, especially if the sounds are reproduced on a score and a CD. Rather, the low number of registrations is due to the limited number of applications filed. The sound marks registered to date were filed by local wine producers for advertising purposes (Registrations 052177 – PIETROASA WINE JUST TOLD YOU WHAT TIME IS IT, 052178 and 062091 – a Romanian folk song with lyrics).

Moving images and holograms

These types of sign have gained in popularity over the past few years. This popularity can partly be attributed to the ongoing battle against piracy and counterfeiting, which often makes it necessary to use holograms to control the distribution of genuine products.

The RTO often refers to moving images as 'dynamic images'. It has accepted at least the following images for registration:

- Registration 080630, which consists of consecutive hand gestures, but is not described verbally in the application;
- Registration 082189, which is described in the application as one letter changing colour from red to green for use on television or online presentations; and
- Registration 113871, not expressly described in the Trademark Registry, consisting of clock wheels, for use in connection with management and consultancy services.

Scent and taste and touch marks

Neither the Trademark Law nor RTO practice expressly excludes scent and taste signs from registration. However, these are generally considered non-registrable, even though scents may, to a certain extent, be considered capable of being represented visually by referring to their chemical compounds or formula, or by providing a sample of the scent and a detailed description. However, in the *Sieckmann* case (C-273/00) the European Court of Justice has held that such representations are not acceptable.

No application for this type of sign has been filed with the RTO to date. Although this means that there is no case law on the issue in Romania, the *Sieckmann* criteria and the fact that most national offices across the European Union consider that it is difficult to represent such signs visually indicate how the RTO would rule on the matter. [WTR](#)