



Romania: Well-known marks

The practice of the Romanian Trademark Office shows that it is relying more on common knowledge than the evidence presented, according to Nicoleta Tarchila, Cabinet Enpora IP.

Well-known trademarks enjoy extended protection in Romania. This may be concluded from the provisions of the Romanian trademark legislation and also from the practice of the Romanian Patent and Trademark Office. A few telling examples from the latest practice of the Office are relevant in supporting this conclusion.

Legal provisions

Romanian Law no 84/1998, republished in 2010, on the protection of trademarks and geographical indications provides as relative grounds of refusal in article 6 paragraphs (3) and (4) that registration of a trademark shall be refused or, if registered, shall be susceptible of being cancelled if it is identical with or similar to an earlier Community trademark and/or an earlier trademark registered in Romania and if it was intended for registration or it is already registered for goods and services which are not similar to those for which the earlier Community and/or national trademark is registered, where the earlier Community and/or national trademark has a reputation in the European Union/Romania and where, by the use of the subsequent trademark unfair advantage would be taken of the distinctive character or the reputation of the earlier trademark. For national well-known trademarks an alternative condition is provided: namely if such a use would be detrimental to the distinctive character or reputation of the earlier trademark.

For both opposition and cancellation purposes, evidence must be filed in support of the reputation allegations.

The implementing regulation of Law no 84/1998 republished provides guidelines on how to estimate whether a trademark is well-known. According to these provisions it is sufficient for the trademark to be a matter of common knowledge in the territory of Romania and for the relevant public segment in Romania, for the goods or services in respect of which the trademark is used. The relevant public segment shall be determined based on the following elements:

- a) the category of consumers aimed at for the goods or services to which the trademark refers: identification of the category of potential consumers shall be made on groups of consumers of certain goods or services in connection with which the trademark is used, and
- b) the distribution circuits of the goods or services to which the trademark refers.

The degree of knowledge of a trademark by the public can be assessed depending on the promotion thereof, which includes the promotion of goods or services to which the trademark applies in fairs or exhibitions.

The well-known character of a trademark may be proved by any evidence means.

The well-known character of a trademark on the territory of Romania may be proved by submission of documents relating to:

- a) commercializing or putting on the market of goods or services under the well-known trademark;
- b) importation or exportation of goods bearing the well-known trademark; or
- c) publicity or advertising of goods and services under the trademark well-known in Romania.

The practice of the Office

Based on the cited provisions, we have analyzed several opposition cases filed on notoriety allegations. Our conclusion is that the Office has come to extend the broad protection of well-known trademarks beyond the provisions outlined by the legislation. By doing so, the Office has put the matter of common knowledge way in front of any other conditions a mark must comply with to qualify as a well-known mark. Often the required evidence is completely ignored and the decision is based solely on the knowledge that a mark is indeed largely known on the market.

Résumé

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Nicoleta joined Cabinet Enpora IP in 2006 and is currently the coordinator of the Litigation Department. She has over eight years of experience in trademark and design litigation. She also assists with filing cancellation, invalidation or revocation actions before the Bucharest Court of Law. Moreover, she has experience with acting against the infringement of IP rights by sending cease and desist letters and filing counterfeit actions. Her area of expertise also includes filing oppositions and appeals before the Romanian Patent and Trademark Office. She is a member of INTA, MARQUES and ECTA.



American singer Lady Gaga arrives at the Hilton Bucharest, August 15, 2012.

Red Bull v Toro Loco Energy Drink

The opposition was brought by Red Bull GmbH against the application for registration of the black/white trademark TORO LOCO ENERGY DRINK, with a design representing an animated bull’s head. The intended goods were “energy drinks” in class 32.

The Office has ascertained that the mark RED BULL enjoys an indisputable awareness on the market. The mark has a high distinctiveness degree and therefore any other denomination which contains the element BULL/TORO or the image of such an animal may generate in the mind of consumers the idea that the marks belong to the same owner. Red Bull GmbH has created and introduced on the market the concept of an energetic, strong animal, characterized by force and vitality and any eventual registration of a subsequent mark using the same idea may affect the distinctive character of the prior marks towards which Red Bull has put obvious financial efforts. The Office has taken on board the opponent’s affirmations with respect to the fact that the RED BULL products have been sold internationally since 1992 and on the Romanian market since 1996, with 5.2 million units sold in 2012.

The Office has concluded that the RED BULL marks are notorious. No outer evidence was included in the opposition file and the decision was based solely on the widespread knowledge of the RED BULL marks on the Romanian market and on the arguments of the opponent, which were supported by simple internet excerpts from the opponent’s website.

Lady Gaga v Gaga

A known Romanian toy producer has applied for the registration of the trademark GAGA in class 28. An opposition was filed by the company Ate My Heart Inc. owner of the LADY GAGA Community

trademark. The prior mark was in fact registered for goods in class 28, however, the opponent also invoked the well-known character of the LADY GAGA trademark. The filed evidence was a Wikipedia excerpt and a limited number of press releases.

The Romanian Trademark Office has admitted the opposition and upheld this decision in the Appeal procedure. The following grounds were included in the decision: Lady Gaga is an artistic and social phenomenon; internationally the artist has 66 million fans on Facebook and 41 million followers on Twitter; as of October 2010 the artist had gathered 1 billion views on YouTube surpassing other well-known artists such as Michael Jackson or Justin Bieber; moreover besides the internet, Lady Gaga is extremely well promoted throughout mass media in Romania and the EU. For these reasons The Romanian Trademark Office considered the mark LADY GAGA is a well-known trademark in Romania from the point of view of trademark awareness and promotional efforts. The registration of a similar mark may cause prejudice to the prior owner.

Men in Black v Men in Black Coming from below the line

The application was filed by a Romanian advertisement agency active in the field of below the line (BTL) advertising for advertising services in class 35. Columbia Pictures Industries filed an opposition based on the prior community trademarks MEN IN BLACK and MIB MEN IN BLACK registered for services in class 41. The well-known character of the prior marks was invoked and the opposition was admitted by the Romanian Trademark Office.

The Office has acknowledged that the intense promotion of the trademarks, especially on the internet has created a large awareness of the marks in Romania. Moreover the three MEN IN BLACK movies were distributed in Romania and promoted with the help of various promotional materials including video games. The documents filed in support of the notoriety were in our opinion not very convincing, namely: excerpts from several movie websites containing general information about the MEN IN BLACK movies and a limited number of promotional advertising displayed during the two weeks the MEN IN BLACK 3 movie ran in Romanian cinemas.

Some conclusions

Extensive use on the market, intense promotional activity and trademark awareness should be recompensated with an enlarged trademark protection. Consequently well-known trademarks must have a much easier burden to be enforced on the market and against subsequent applications. However, we consider the three examples taken from the practice of the Romanian Trademark Office show that the Office relies much more on the common knowledge existing on the market rather than on the evidence provided by the owners. This fact is not in accordance with the legal provisions set by the Romanian trademark legislation which expressly provide that notoriety must be proven.

In both the GAGA and MEN IN BLACK cases the Office has acknowledged an artistic notoriety over a commercial one. It is a fact that a singer or a movie enjoys large awareness, however, this is not always commercial awareness but rather an artistic one. Moreover the sources of information may be easily questioned. Although a trusty source a Wikipedia excerpt may not be taken into consideration as the only proof with respect to facts and numbers, nor should an excerpt from the company’s website be considered an objective piece of evidence. For the TORO LOCO opposition prior cases where Red Bull was found a well-known mark weighed a lot and the lack of evidence was thus justified. We are therefore of opinion that the practice of the Office is affected by the popularity of the notorious marks, as the legal provisions may be overlooked.