

THE SAFETY OF UNREGISTERED MARKS

To what extent can you count on an unregistered trademark? Raluca Vasilescu investigates the situation in Romania.

Unregistered marks have a long tradition in some European jurisdictions, while in others they are still at their early stages.

Romania is one of the countries where unregistered marks were recognised as a distinct kind of prior right only by amendments made to the national law in 2010.

Legal provision states that a mark can be denied registration or, if registered, can be cancelled, if there are earlier rights arising from an unregistered mark or another sign used in commercial activity before the filing date or the subsequent mark, and if that unregistered mark or unregistered sign confers to the owner the right to forbid the use of the later mark.

Neither the law nor the implementing regulation clarify under what circumstances the unregistered mark confers to the owner the right to forbid use of the later mark. However, case law is expected to shed some light on the matter.

In a decision delivered in December 2013 by the Board of Appeal of the Romanian State Office for Inventions and Trademarks (OSIM), a later

mark was denied registration for conflict with an earlier unregistered right, as follows.

The facts

In May 2007, the Romanian company Zonal Media obtained a licence for regional TV channel Gorj TV, 'Gorj' being the name of a county. The channel began broadcasting at the end of June 2007 and was watched widely in Gorj county. Zonal Media sold the business to Media Video Centre in 2012 and the channel continues to broadcast today, with the same high audience figures.

Meanwhile, Zonal Media had registered the domain name gorjtv.ro in 2006 with the national registrar RoTLD.

In November 2011, a Mr Raitaru, who had attempted unsuccessfully to enter a business relationship with the owners of the TV channel, applied to register the word mark 'Gorj TV' for telecommunication services in Class 38; advertising and management of the business in Class 35; and education, training, entertainment, cultural and sport activities in Class 41.

Media Video Centre duly filed an opposition against the word mark 'Gorj TV' at the end of 2011 on several legal grounds, among which were: a) conflict with earlier rights arising from a domain name; b) earlier rights from an unregistered mark; and c) conflict with a famous mark.

The opponent provided evidence that the mark had been in use continuously since mid-2007 right up to present day, providing filing surveys, press cuttings and advertising contracts. The opponent also claimed that the mark had already become famous by the date of publication of the later mark, ie, November 2011 for the relevant people, defined as the people of Gorj county.

In reply, the applicant challenged the legal grounds based on the use of 'famous mark', arguing that the TV channel has a local audience, whereas the relevant public would be the public interested in watching TV from all over the country.

The Board of Appeal admitted the opposition and thereby denied registration to the later mark. The board accepted that Gorj TV had acquired earlier rights through an unregistered mark by

The lesson: good news or bad news?

At first sight, there is nothing spectacular about this case. However, it is important because of the context and the ruling.

Gorj is a small county in terms of population, with fewer than half a million people compared with around 20 million in Romania as a whole. Given that most TV channels have internet pages, where they post news and other information of interest, one can presume that the audience is somewhat larger than 2.5 percent of the population. It might include, for example, people born in that county and living in other parts of Romania. However, even the highest estimates suggest that no more than twice the number of the people in Gorj might actually be interested in the Gorj TV channel.

This is why a ruling that the holder of a sign used in a small area of Romania, through the use of a right conferred by a trademark, can oppose the registration of later sign is undoubtedly a significant change in the practice of the OSIM—even though it is true that circumstances were favourable because the signs were identical and the services were similar.

The good news about this approach is that unregistered rights acquired through use are recognised in opposition proceedings. However, one could also look at the decision the other way round and ask whether it is fair that the use of a sign in a small territory in terms of population is sufficient to allow the proprietor to acquire the right to forbid use of a later similar sign for similar or identical goods irrespective of the size of the territory in which the later sign would actually be used.

The case is interesting because it raises the problem of assessing the use of a national trademark that involves new technology. Traditionally, the evidence submitted to OSIM comprised press cuttings, contracts and licences. The use of a mark on the internet is hard to quantify for several reasons:

- The number of visits to a website is not *per se* evidence that the mark that appears on the site is perceived by the public to be a trademark and not just part of the text; and
- Even if there is a system for counting the visits to the website, there is no reliable evidence in an easy-to-read format about where the people looking at the website are located. Use and notoriety are strictly related to national territory in the legal texts.

Perhaps the definition of national territory for

the purpose of assessing use and notoriety should be changed. For example, there are roughly 900,000 Romanians living and working in Spain, according to data published by the Romanian Embassy in Madrid, roughly the double the number living in Gorj county.

Nearly all these Romanians can access Romanian websites and buy products and services bearing Romanian national trademarks. Would the use of a mark for this category of public fall within the scope of the definition 'use of a trademark in Romania' as provided by national law?

To conclude, the matter of rights arising from unregistered trademarks acquired through use in a territory needs further exploration to assess what the use is of a national trademark in a national territory in real life, as opposed to the definition in law. There is no one single good answer, but this is a subject that needs reflection and discussion. ■

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"THE BOARD ACCEPTED THAT GORJ TV HAD ACQUIRED EARLIER RIGHTS THROUGH AN UNREGISTERED MARK BY CONTINUOUS USE IN A TERRITORY BEFORE THE DATE OF DEPOSIT OF THE LATER MARK."

continuous use in a territory before the date of deposit of the later mark, those rights allowing them to forbid third parties to register an identical or similar mark for identical or similar services.

The board also agreed that Gorj TV had earlier rights arising from a domain name. The grounds related to 'famous mark' were not taken into consideration given that the evidence was not considered sufficient to prove notoriety.