

# TRADEMARK PROTECTION

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**Abstract:** *The brand/trademark, trade name and emblem are part of the category of distinctive signs used by professionals/traders when it comes to carrying out an economic activity, for their easy identification by their customers/partners, for the creation of a unique identity that generates their uniqueness. According to art. 2 of Law no. 84/1998 on trademarks and geographical indications, the trademark is any sign capable of graphic representation, such as: words, including names of persons, drawings, letters, numbers, figurative elements, etc., provided that these signs enable the products to be distinguished or the services of one enterprise to be differentiated from those of other enterprises.*

**Key words:** *trademark, trademark protection, identification of the professional, jurisprudence.*

## 1. Introduction

According to art. 2 of Law no. 84/1998 on trademarks and geographical indications, the trademark is any sign capable of graphic representation, such as: words, including names of persons, drawings, letters, numbers, figurative elements, etc., provided that these signs enable the products to be distinguished or the services of one enterprise from those of other enterprises. The brand tends to create a unique identity for its holder, as a natural person identifies himself in society by name, Personal Identification Code, distinctive elements of appearance.

The above definition reveals the purpose for which the legislator chose to protect such identification marks. For example, in the brand situation, the scope for which it is regulated and protected by the legislator, by the bodies entitled to monitor and protect it and even by jurisprudence is to distinguish the products or services of a professional from those of other professionals.

For consumers, suppliers, customers, such distinctive signs of traders are not perceived at their true value, they are not at all interested if they are registered trademarks and if they belong to an entity, if they are simple signs arbitrarily chosen by an economic agent to differentiate from its competitors in a certain market. Such a conception often leads within our society to the violation of trademark rights, to the creation of patrimonial damages to trademark owners. In order to resolve such

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conflicts arising, in real economic activity, between the rights to signs, it is not enough simply to state the definition or the abstractly regulated function, because the purpose of the law is not to state abstract definitions, but to concretely regulate social and economic life, as it is in reality.

As it is known, the right to a name is a non-patrimonial, personal right of a natural person, so that the commercial name of a professional enjoys the same regulation and protection. To build a brand, the name must have a characteristic external appearance, be combined with certain graphic elements, with certain colors specific to the professional's activity, be arranged in a certain manner. These aspects create the brand. The trademark protects not the name itself but the way the name is arranged within the image that makes up the mark (Murzea, p.125).

Therefore, in order to resolve conflicts between the rights regarding distinctive signs by removing the confusion that consumers can make between them and, consequently, between the economic agents that use the distinctive signs to differentiate their economic activities, it is of interest what is the perception of consumers regarding what exactly does a distinctive sign communicate to them in a real way, in the course of carrying out specific commercial activities (Florea, 2013).

## **2. Trademark Protection**

The legislator chose to protect the trademark, as a distinctive sign, identifying a professional/trader (together with other distinctive signs such as the emblem or trade name) by registration in public registers – the register of trademarks, administered by the State Office for Inventions and Trademarks (hereinafter referred to as OSIM) in the trade register (kept at the Court in the jurisdiction of which the trader is based) or through long-term use on a certain market.

Within the protection conferred by the Romanian state through the current legal regulation (Ionaş, Matefi, 2007), the principle of priority of registration and the principle of priority of the use of a distinctive sign operate as fundamental and universally recognized principles when it comes to the protection of intellectual property rights in general.

At the time of registration of distinctive signs for any of the professionals/traders, the legislator establishes the obligation to carry out preliminary checks regarding the availability and distinctiveness of the name to be used by the trader. Regarding the distinctive sign submitted for registration as a trade name, it is verified *ex officio* by each of the territorial offices of the trade register.

Regarding the availability of the company, art. 49-50 of Law no. 265/2022 (published in the Official Gazette of Romania no. 750 of 26.07.2022) provides as a procedure prior to the registration of a professional in the public registers that any new company must be different from the existing ones. It is forbidden to register a company that contains the words: “scientific”, “academy”, “academic”, “university”, “school”, or their derivatives, as well as “notary”, “executor”, “lawyer”, “legal advisor”, “legal consultancy” or words that are associated with professions that involve the exercise of public authority.

Also, the legislator provided that a company that contains the words „national”, “Romanian”, “institute” or their derivatives or words or phrases characteristic of authorities and central public institutions cannot be registered if this is likely to create confusion with the name of a central or local public authority or institution. The verification of the availability of the company name is done at the request of the interested person by means of the Trade Register Office, before the drafting of the articles of incorporation or, as the case may be, of the change of the company. Checking the company's availability and booking it can also be done through the online service portal. In order to make a reservation, the company is subject to the operation of verifying the fulfillment of the conditions of availability and specificity with respect to the companies registered in the Trade Register or reserved, as well as with regard to other conditions provided by law regarding the company.

A company is available when it does not belong to another natural or legal person registered in the Trade Register or is not reserved for registration. Meeting these criteria ensures that the risk of confusion with other traders is eliminated. If the criteria are not met, the Trade Register Office will refuse to register a company. The checks and procedure given above refer to the trade name and emblem registered in the trade register. In the procedure described above, entries in the trademark register are not checked. Similar to the trademark right, the rights over the trade name and the emblem can be exercised throughout the territory of Romania.

With regard to the sign submitted for registration as a trademark, OSIM verifies the availability and distinctiveness only if, within two months from the date of publication of the application for trademark registration, an interested person formulates an opposition for the relative reasons for refusal provided for in art. 6 of Law no. 84/1998 (if it is identical to an earlier trademark, and the products and services for which the trademark is applied for or has been registered are identical to those for which the earlier trademark is protected, or if, for reasons of identity or similarity in relation to the trademark prior and due to reasons of identity or similarity of the products or services that the two marks designate, it may create, in the public's perception, a risk of confusion, including the risk of association with the previous mark) - aspects revealed by art. 20 of Law no. 84/1998.

In principle, the check for availability and distinctiveness is made in relation to earlier, national or community trademarks. Although the registration of the trademark gives rise to a national right, the law does not prohibit, and in practice this aspect is frequently emphasized, the right that the trademark only be used in a locality or a county - in this sense, there is the civil decision no. 909/2021 passed by the High Court of Cassation and Justice.

Since there is a risk that the right to the trademark conflicts with other distinctive signs used in commercial activities, such as the trade name and the emblem, the legislator provided in Law no. 84/1998 that the availability and distinctiveness of a sign submitted for registration as a trademark can also be verified in relation to distinctive signs that are not registered as trademarks, but on which rights have previously been acquired, as a result of being used in commercial activities on a certain market.

Thus, the question arises, what solution do we offer when a conflict arises between an unregistered trademark and another sign used in commercial activity? In the case of such a situation, we consider the provisions of art. 6 of Law no. 84/1998, according to which: A trademark is refused registration or, as the case may be, is liable to be canceled for the following relative reasons:

- a) if it is identical to an earlier trademark, and the products and services for which the trademark is applied for or has been registered are identical to those for which the earlier trademark is protected;
- b) if, for reasons of identity or similarity in relation to the previous brand and for reasons of identity or similarity of the products or services that the two brands designate, a risk of confusion may be created in the public's perception, including the risk association with the previous brand.

According to the norm of common law, Law no. 84/1998, art. 4 the right to the trademark is acquired and protected by its registration at the State Office for Inventions and Trademarks. The following are excluded from protection and cannot be registered:

- a) brands that do not meet the conditions provided for in art. 3 letter a) – they were not registered according to the legal norms ();
- b) trademarks that are devoid of distinctive character;
- c) trademarks that are composed exclusively of signs or indications that have become customary in current language or in loyal and constant commercial practices;
- d) brands that are composed exclusively of signs or indications, being able to serve in commerce to designate the species, quality, quantity, destination, value, geographical origin or time of manufacturing the product or providing the service or other characteristics thereof;
- e) trademarks constituted exclusively by the shape of the product, which is imposed by the nature of the product or is necessary to obtain a technical result or which gives a substantial value to the product;
- f) brands that are likely to mislead the public regarding the geographical origin, quality or nature of the product or service;
- g) brands that contain a geographical indication or consist of such an indication, for products that do not originate from the indicated territory, if the use of this indication is likely to mislead the public as to the true place of origin;
- h) trademarks that are established or contain a geographical indication, identifying wines or spirit products that do not originate from the indicated place;
- i) trademarks that are contrary to public order or good morals;
- j) trademarks that contain, without the owner's consent, the image or patronymic name of a person who enjoys renown in Romania;
- k) brands that include, without the authorization of the competent bodies, reproductions or imitations of coats of arms, flags, state emblems, insignia, official control and guarantee seals, coats of arms, belonging to the countries of the Union and falling under the scope of art. 6ter of the Paris Convention;
- l) brands that include, without the authorization of the competent bodies, reproductions or imitations of coats of arms, flags, other emblems, logos, initials or names falling under the scope of art. 6 of the Paris Convention and which belong to international intergovernmental organizations of which one or more countries of the Union are members.

### **3. Quantification of Damage caused by Trademark Infringement**

The Romanian legislator establishes in art. 14 of GEO no. 100/2005 (published in the Official Gazette of Romania no. 643 / 20.07.2005) the right of the professional to address the court of law for the reparation of a damage caused by trademark infringement. At the request of the injured party, the competent court will order the person who intentionally carried out an infringing activity to pay the owner of the infringed right damages corresponding to the damage he actually suffered as a result of the infringement committed. According to the current regulation, art. 14 paragraph 2 of GEO no. 100/2005, when determining damages, the court will take into account: a) all relevant aspects, such as the negative economic consequences, in particular, the loss of earnings suffered by the injured party, the benefits obtained unfairly by the person who violated a protected industrial property right (...), „

Thus, the patrimonial damage of the holder of the infringed trademark will be quantified by loss of earnings and not sales, respectively by the benefits obtained unfairly by the person who violated a property right.

### **4. International Legislation and Jurisprudence**

According to the Paris Convention signed in 1883 on the protection of intellectual property, art. 9, the European legislator puts the brand and the trade name on the same regulatory plane: any product that illegally bears a factory or trade mark or a trade name, will be seized upon import or in those countries of the union where this mark or this trade name is entitled to legal protection. In the same sense is the jurisprudence of the HCCJ (Decision no. 6559/2010), returned in the resolution of the action to cancel the trademark registration for the reason provisioned by art. 48 para. (1) lit. b) from Law no. 84/1998 (current art. 47). For the correct understanding of the notion of “unfair competition”, mention must be made of the provisions of art. 10 bis para. (3) of the Paris Convention, according to which “any facts that are likely to create, by any means, a confusion with the enterprise, products or commercial activity of a competitor [...] will have to be prohibited.”

The legal provisions do not distinguish with respect to the means likely to create confusion with the commercial activity of a competitor, therefore the law does not limit or exclude the hypothesis in which confusion with the enterprise, products or commercial activity of a competitor is created by the use of the same distinctive sign as a trademark by one competitor and as an emblem by another competitor. The national jurisprudence is in accordance with the jurisprudence of the CJEU (the Celine case), in which it was ruled that the owner of a trademark can prohibit the use by a third party of a sign identical to his trademark only if the following conditions are met: the use takes place in the course of trade, without consent to the owner of the trademark, for products identical to those for which the trademark was registered and the use of which harms or is likely to harm the functions of the trademark, in particular its essential function of guaranteeing consumers the origin of the products or services.

## 5. Conclusions

The right to the brand or other distinctive signs in the case of legal entities is particularly important for the identification of each professional in the commercial/business environment in which he operates. Because we can talk about merchants known throughout the world, such as Coca Cola, or merchants known only regionally or locally, the legislator equally protects through clear regulations the right to the brand, trade name, emblem, thus creating the premises of a regime of equality. As with individuals, personal identification within society is particularly important. However, unlike natural persons, the identification of the professional by trade name, emblem and brand can give them patrimonial advantages by creating a clientele. For these reasons, their violation, with respect to identification attributes, can cause patrimonial damages for which the legislator has created a concrete legislative framework to ensure compliance with the trademark right and due compensation in the event of violation of this right.

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