Questions

Note: the following topics are not to be covered in the Group answers:

- Exhaustion
- Limitations on trademark rights by competition law
- Limitations on trademark rights by the right to freedom of expression
- Comparative advertising
- Acquiescence.

I) Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

1) Are there statutory limitations of trademark rights in your trademark law? If so, which ones? If not, have similar concepts been developed in case law? (Please only briefly list the limitations here; more detailed explanations will be required below).

The Romanian Law no. 84/1998 on Trademarks and Geographical Indications (later named “the Law”) provides for the following statutory limitations:

- the owner of a registered trademark may not request other persons to be prohibited from stocking, offering for sale or putting on the market of goods under his trademark, if these goods have been put on the market by the owner himself or with his consent; this provision shall not apply if the owner submits legitimate reasons for opposing the commercialization of the goods, especially when the goods condition was changed or impaired after their putting on the market [from Art. 37],
- descriptive use defences [Art. 38],
- identical or similar trademarks, belonging to the same owner, used for identical or similar goods or services, may be assigned only as a whole and only to one person, on pain of the assignment nullity [from Art. 40],
- any concerned person may apply in Court, at any time during the trademark protection period, for revocation of the owner’s rights conferred by the trademark if:
  a) without proper reasons, the trademark has not been put to genuine use within a continuous period of five years for goods or services for which it was registered;
  b) after the registration date, the trademark became usual in the trade with a good or a service for which it was registered, due to the owner’s action or inactivity;
c) after the registration date and as a result of the trademark use by the owner or with his consent, the trademark became susceptible of misleading the public, especially concerning the nature, quality or geographical origin of the goods or services [from Art. 45].

2) If descriptive use defences are recognised under your trademark law, what is descriptive use and what types of descriptive use defences are recognised? (Please only briefly list the types of descriptive use defences here; more detailed explanations will be required below)

The Romanian Trademark Law recognises the following "descriptive use defences", but without using this expression:

- the trademark owner may not request that other persons be prohibited from using in the course of trade:
  a) the name/designation or address/headquarters of the owner;
  b) indications concerning the species, quality, destination, value, geographical origin, the period of goods production or of the service rendering under that trademark, or other characteristics of goods or services;
  c) the trademark, if it is necessary to indicate the intended purpose of products or services, in particular for accessories or spare parts [from Art. 38];

the provisions in a) to c) are applicable with the proviso that they are used according to honest practice.

As an example is use of the trademark DACIA (registered for cars) in shops selling spare parts for these cars.

3) Is use of one's own name permissible under your trademark law? If so, under which circumstances? Specifically, may anyone use his or her name as a trademark?

Yes. Art. 3 (a) of the Law refers to the definition of trademarks as "distinctive signs such as: words, including personal names,...". Anyone can use his or her name as a trademark after the registration of this name as a trademark. In case of a notorious name, this can be used as a trademark without registration.

4) Is a company entitled to make use of the "own name" defence? Specifically, is the "own name" defence only available to a company whose name includes a surname (e.g. William Smith Limited)? How are conflicts between the company's use of its "own name" and confusingly similar trademarks resolved?

We have no explicit legal provision, but a company can use the "own name" defence, being not compulsory to include a surname if it was registered as a trademark without a surname. In case of coexistence on the market of a trademark confusingly similar to a company name, the conflict can be solved in OSIM [the Romanian PTO] by opposition in three months from publication of the trademark [Art. 23 of the Law] or in Court if missing this term, taking into account which was registered first, the trademark in OSIM or the company name at the Romanian Commerce Registrar. Alongside with the date must be analyzed also other elements. Art. 48 of the Law stipulates that any concerned person can ask in Court for revocation of a trademark for bad faith (c), infringement of the personal image or of the patronymic name (d), infringement of any earlier industrial property rights or copyright (e).

5) Is the use of indications concerning the characteristics of the goods or services, including the kind, quality, value, geographical origin or time of production of goods permissible under your trademark law? If so, under which circumstances?
Yes. But these indications are not enough for being a trademark. They are descriptive elements that do not represent a distinctive part of the trademark and the applicant must write a disclaimer for them before obtaining the registration of his trademark. Art. 5 (d) of the Law stipulates that trademarks consisting exclusively of signs or indications to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of goods production or of services rendering, or other characteristics of the goods or services, shall be excluded from protection and may be not registered.

Art. 5 (f) of the Law stipulates that trademarks liable to mislead the public as to the geographical origin, the quality or nature of the goods or services shall be excluded from protection and may be not registered.

6) Is the use of another’s mark to indicate product compatibility permissible under your trademark law? If so, under what circumstances? Is only the use of another’s word mark in ordinary script or neutral letters permissible or also the use of another’s logo or special script format of the mark?

The use of another’s trademark is not explicitly presented in the Law but, independent if it is a word mark in ordinary script or neutral letters, a logo, or a mark of any other kind, use of other’s trademark is not permissible, except the case of existence of the owner’s consent. The only accepted case of use is for indicating the intended purpose of products or services, in particular for accessories or spare parts [Art. 38 (c) mentioned above].

7) Is decorative use of another’s mark permissible under your trademark law? If so, under what circumstances?

Our Law has no provision for a “decorative use” of another’s trademark, but the provisions concerning generally the use of another’s trademark mean implicitly that it is not permissible.

8) Is use of descriptive terms permissible regardless of whether it is in accordance with honest or fair practices or whether it constitutes unfair competition? If descriptive use of another’s mark is only permissible if it is in accordance with honest or fair practices, what are typical examples of use which are not in accordance with honest or fair practices?

No. The descriptive terms cannot be used regardless of whether they are in accordance with honest or fair practices or whether they constitute unfair competition. We did not face with a case where the descriptive use of another’s trademark was not in accordance with honest or fair practices.

9) Do the above mentioned types of descriptive use constitute limitations of trademark rights because they would not be regarded as “use as a mark” or are they specifically exempted regardless of whether trademark use is involved?

The types of descriptive use accepted by our Law do not represent limitations for the trademark owner, both because descriptive elements do not represent the entire trademark, but only the non-claimable part of it, and because descriptive use must be done in a legal frame, not leading to an unfair competition.

10) If your trademark law recognises other types of descriptive use defences which have not been discussed above, please explain.

Romanian Trademark Law does not recognize other types of descriptive use.
11) Does your trademark law provide for a prior user right/defence? If so, under what circumstances?

Yes. A person used a sign, that can be a trademark, without filing an application for it. In this case, when he decides to file an application, the sign is registered as a trademark even if: it has no distinctive character, it consists exclusively of signs or indications which became customary in the current language or in the bona fide and established practices of the trade, or which may serve, in trade, only to designate the kind, quality, quantity, intended purposes, value, geographical origin or the time of production of the goods or of rendering of the services. The registration is based on the fact that the mark has acquired a distinctive character [Art.5].

12) If your trademark law provides for other limitations of trademark rights which have not been discussed above, please explain.

The limitations indicated at point 1) are the only limitations in our Law.

II) Proposals for adoption of uniform rules

The Groups are invited to put forward proposals for adoption of uniform rules regarding limitations of trademark rights. More specifically, the Groups are invited to answer the following questions:

1) Should descriptive use of another’s trademark be permissible? If so, under what circumstances?

The descriptive use of another’s trademark should be permissible with the limitations according to the European Directive 89/104 and CTM Regulations (these are found also in the Romanian Trademarks Law). Anyhow, this use has to be totally in accordance with honest or fair practices.

2) Should use of one’s own name be permissible? If so, under which circumstances? What should the position regarding the use of corporate names be?

The name of one person should be permissible on the market with the condition to be a registered trademark belonging to that person, or with his consent. The notorious names can be not registered. The corporate names can be also used based on the same conditions. More than that, being a commercial name, it might be normal that trademark laws to provide for an exception, meaning that the corporate name to be used in trade without registration as trademark.

3) Should the use of indications concerning the characteristics of the goods or services, including the kind, quality, value, geographical origin or time of production of goods be permissible? If so, under which circumstances?

These elements should not be permissible as a trademark. But, if one or more of them are in a trademark that has another element distinguishing it, for them the applicant must ask for a disclaimer. Concerning use of such elements in trade by another person, this should be accepted in trademark laws with a very clear limitation, so as to avoid any kind of damage produced to the trademark owner in the market.

4) Should the use of another’s mark to indicate product compatibility be permissible? If so, under what circumstances? Should only the use of another’s word mark in ordinary script or neutral letters be permissible or also the use of another’s logo or special script format of the mark?
The use of another’s trademark should not be permissible by the trademark laws independent on the kind of script or format of the mark. Otherwise the owner has no an exclusive right for his registered trademark. As an exception can be stipulated in laws the use of one’s trademark exclusively to indicate the intended purpose of products or services, in particular for accessories or spare parts.

5) **Should decorative use of another’s mark be permissible? If so, under what circumstances?**

The decorative use of another’s trademark should be not permissible, because in any case it creates advantages for the user without a contribution and infringes the exclusive right of the trademark owner. Only if the other person could obtain a consent from the trademark owner, this decorative use should be accepted.

6) **Should trademark law provide for a prior user right? If so, under what circumstances?**

Yes. The right of a user of a mark for commercializing his goods or for rendering his services must be stipulated in laws. More specific, when he decides to file an application and his trademark does not fulfil the criteria of registration (especially distinctiveness), his trademark has to be accepted for registration based on the prior use.

7) **Should trademark law provide for other limitations of trademark rights which have not been discussed above? If so, under what circumstances?**

For the time being there are enough limitations. In the future, the practice could reveal other situations or problems. It is very difficult to establish the limit between the simple descriptive use of another’s trademark, or other limitations, and the start of unfair competition. The Trademark Laws must have such provisions so as to ensure for the owner a real industrial property right and to help him in avoiding unfair competition.

National Groups are invited to comment on any additional issue concerning limitations of trademark rights which they find relevant.