

Question Q214

National Group: Romanian

Title: Protection against the dilution of a trade mark

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Date: 30.03.2010

Questions

I. Analysis of current law and case law

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

1. Do the laws of your country provide for protection against dilution of a trademark? If so, which laws?
R. There is no explicit provision in our legislation, however there is a certain degree of protection provided for the ex-officio examination and opposition procedures based on famous or well-known marks.
2. Is there a legal definition of dilution in your legislation or case law?
R. There is no legal definition.
- 3.1. Which trademarks are afforded protection against dilution? What are the eligibility criteria? (Please only briefly list the eligibility criteria here; more detailed explanations will be required below).
R. in case of opposition based on famous marks, provided that the opponent proves the notoriety of the mark and proves that the applicant of the later mark would unduly benefit from the distinctive character and the fame of the mark or if such use [of the later mark] would bring prejudice to the owner of famous mark.
- 3.2. To be eligible for protection against dilution does a mark need to be distinctive? If so, does the protection depend upon the mark being inherently distinctive or are marks that have acquired distinctiveness through use also protected?
R. Any trademark must be distinctive. Both types of distinctiveness are accepted.

3.3.1 To be eligible for protection against dilution does a mark need to have a reputation or be well-known or famous? If so, when does a mark have a reputation, when is it well-known or when is it famous? Are the factors mentioned in paragraph 15 and 22 above relevant for determining whether a mark has a reputation, is well known or famous? For what point in time does this have to be assessed?

R. The trademark must be well known or famous at the time when the later mark is applied for registration.

3.3.2 For a mark to have a reputation or to be considered well known or famous, must it meet a certain knowledge or recognition threshold? If so, what is that threshold? What percentage of population awareness is required? How widespread must the awareness be across the country? If a mark is well known or famous in one country, what effect, if any, does this have with regard to other countries?

R. The notoriety must be proven and accepted by Patent and Trademark Office or the Court, according to the criteria set by the Trademark Law No. 84/1998, art. 20

3.3.3 What is the relevant population in determining the knowledge, recognition or fame of the mark, the general public at large or the relevant sector of public? Is recognition or fame in a limited product market (“niche market”) sufficient?

R. The relevant sector of the public, including a limited product market, if applicable.

3.4. To be eligible for protection against dilution, is it required that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country where protection is being sought?

R. A famous mark on which an opposition is based needs only to be widely known by the relevant public. There is no obligation of use.

3.5. Are there any other criteria a mark must comply with to be eligible for protection against dilution?

R. No other criteria.

3.6. Is eligibility for protection against dilution a matter of law or an issue of fact? Who bears the burden of proof regarding the eligibility criteria? How does one prove that a mark meets the eligibility criteria? Are sales and advertising figures sufficient or is survey evidence required? Which evidential standard must this proof satisfy?

R. Since the eligibility for protection refers only to famous or well known marks, the owner the mark is obliged to submit evidence. See answer to 3.3.2.

3.7. Is there any registry of eligible marks in your country? If so, what is the evidentiary value of registration? Can it be challenged in litigation?

R. There is no registry.

4. Does your law require the existence of a ‘mental association’ or ‘link’ between the earlier trademark and the later trademark? If so, in which circumstances does a ‘mental association’ or ‘link’ between the earlier trademark and the later trademark exist? Are the factors mentioned in paragraph 27 and 28 above relevant for

assessing the existence of such a 'mental association' or 'link'? Are there other factors to take into account? Is the assessment of a link a question of fact (so something that can be established by market surveys), or is it a question of law to be established by the courts or authorities on the basis of such factors?

R. The Law provides for the possibility of a risk of confusion, including association. Mental association is not defined as such.

5. Does such 'mental association' or 'link' between the earlier trademark and the later trademark automatically result in detriment to the earlier trademark's repute or distinctive character? Or does detriment have to be proved over and above the existence of a 'mental association' or 'link'?

R. NO.

6. Are the same factors taken into consideration to assess the existence of detriment as those already discussed for the link? Are there additional ones?

R. The detriment is considered to be potential, not necessarily actual. There are no other factors.

7. Must actual dilution be proved or is a showing of likelihood of dilution sufficient? Whose burden of proof is it? How does one prove dilution or likelihood of dilution? Does detriment require evidence of a change in the economic behavior of the average consumer or that such change in behavior is likely? If so, what is a change in the economic behavior of the average consumer? Is reduced willingness to buy goods sold under the earlier mark a change in the economic behavior? How do you prove a change in the economic behavior of the average consumer or likelihood of such change in behavior?

R. Likelihood of dilution is sufficient. It has to be proven by the opponent invoking the famous mark.

8. What is the extent of protection afforded to marks which are eligible for dilution protection? May the owner of the earlier trademark object

- to the registration of a later trademark?
- to the actual use of a later trademark?
- in respect of dissimilar goods only or also in respect of similar goods?

R. Yes, if the earlier mark is a famous or well known mark.

9. What are the legal remedies? May the owner of the earlier trademark file an opposition and/or a cancellation action? May he ask for injunctive relief or preliminary injunctive relief? Does your trademark office refuse the registration of a later trademark on grounds of likelihood of dilution?

R. The main legal remedy is the opposition procedure.

II. Proposals for adoption of uniform rules

The Groups are invited to put forward proposals for adoption of uniform rules with a view to protecting trademarks against dilution. More specifically, the Groups are invited to answer the following questions:

1. Which trademarks should be eligible for protection against dilution? What should the eligibility criteria be? Should recognition or fame in a limited product market (“niche market”) be sufficient?

R. Only famous or well known marks should be eligible for protection.

2. Should it be a criteria for being eligible for dilution protection that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country?

R. Same criteria as in the existing provisions. The „dilution“ as such should be defined explicitly based on the definitions used in major jurisdictions.

3. Should there be a registry of eligible marks? If so, what should the evidentiary value of registration be? Should it be possible to challenge it in litigation?

R. NO.

4. Should the existence of a ‘mental association’ or ‘link’ between the earlier trademark and the later trademark be an independent requirement for a trademark dilution claim?

R. Not compulsory.

5. Should detriment to the distinctive character or reputation of the earlier mark require evidence of a change in the economic behavior of the average consumer or that such change in behavior is likely?

R. Not necessarily. Since current provisions require showing the probability that by use of the later mark its owner would unduly benefit from the fame or distinctive character, there is no need to submit evidence of actual change.

6. What should the remedies be for dilution of a mark?

R. The opposition procedure as such should be kept as it is currently; with the only amendment that dilution should be defined as a concept in explicit wording. The second remedy would be to include the dilution within the grounds for which interim and permanent injunction can be granted in a Court of Law. The procedure would be similar to the one of infringement.

Summary

Currently, although Romanian Trademark Law does not explicitly recognize the concept of dilution as such, it provides protection mostly in case of oppositions based on famous or well known mark when the opponent can prove the notoriety and the possibility of unduly advantage taken by the later mark.

Romanian Group is in favor of maintaining the current remedy of opposition but defining clearly what "dilution" is. In addition, the remedy of the interim and permanent injunction should be also available to trademark owners, in a proceeding similar with the infringement.

Résumé

Actuellement, bien que le droit des marques roumaines ne reconnait pas explicitement la notion de dilution en tant que telle, elle offre une protection plus souvent en cas d'oppositions basées sur la célèbre marque notoirement connue ou quand l'adversaire peut prouver la notoriété et la possibilité de profiter indûment prises par le dernière mark.

Roumaine du Groupe est en faveur du maintien du recours actuel de l'opposition, mais de définir clairement ce que la «dilution» est. En outre, le recours de l'injonction interlocutoire et permanente devrait être également disponible aux propriétaires de marques, dans une procédure similaire à l'infraction.

Zusammenfassung

Obwohl das rumänische Markenrecht nicht explizit das Konzept der Verdünnung als solches kennt, so bietet es gegenwärtig Schutz vor allem in Fällen von Widersprüchen bei berühmten oder bekannten Marken, wenn der Gegner die Bekanntheit und die Möglichkeit eines unzulässigen Vorteils der jüngeren Marke beweisen kann.

Die rumänische Fraktion befürwortet die Beibehaltung der derzeitigen Maßnahmen zur Lösung von Widersprüchen, allerdings auch die klare Definition des Begriffs "Verdünnung". Darüber hinaus sollten die Maßnahmen für vorläufige und endgültige Verfügungen auch den Markeninhabern zur Verfügung gestellt werden, in einem Verfahren ähnlich dem Verstoß.