

# THE NOTORIOUS, REPUTED AND FAMOUS TRADEMARKS

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## Abstract

*The owner of a trademark that has a reputation in Romania or in the European Union may request to court to forbid the infringer from using, without its consent, a sign identical or similar to its trademark, but for products or services different from those which are sold or provided under said trademark. According to Law no. 84/1998, the notorious (well-known) trademark is the trademark which does not necessarily have to be registered under the Trademark law protection. The Romanian doctrine sustains that famous trademarks do exist.*

*In this paper, we shall attempt to find (if it really does exist) the difference between notorious (well-known), reputed and famous trademarks, the criteria by means of which these trademarks shall be distinguished and the evidence by means of which the notoriety, reputation or fame of a trademark may be argued. We shall also present the legal regime and our analysis will be based on the Trademark law, doctrine and case-law studies.*

**Keywords:** *notorious (well-known) trademarks, reputed trademarks, famous trademarks, likelihood of confusion, likelihood of association.*

## 1. Introduction

The Romanian literature speaks of notorious trademarks, reputed trademarks, famous trademarks<sup>1</sup> (or of the highest repute<sup>2</sup>), as categories of distinctive signs of commerce benefiting from different legal regimes. Different and somehow preferential, given the fact that, in order to benefit from legal protection, distinctive trademarks must usually be recorded, and thus must pass through the OSIM (*State Office for Inventions and Trademarks*) filter.

But do these types of trademarks really exist or are they just a creation of doctrine? How could they be defined and what differentiates them? What is the legal status they enjoy and what are their means of protection?

Hugo Boss, Versace, Calvin Klein, Knorr, Lavazza are unregistered trademarks in Romania, which the Romanian law protects. Are they notorious trademarks, reputed trademarks or famous trademarks? What is their legal regime and how can they be protected against usurpers?

These are the questions we aim to answer further below.

## 2. Are there really famous and reputed trademarks?

According to Law no. 84/1998 (hereinafter referred to as the Trademark Law), the **notorious trademark** is the *widely known trademark in Romania, by the audience segment targeted by the products or services to which it applies, without the need for the trademark registration or use in Romania*

*in order to be opposed* (art. 3 letter d)). The law also reminds the notorious trademarks when listing and defining *the previous trademarks* as the *trademarks that, at the date of filling the application for registration or, where appropriate, at the date of the claimed priority, are notorious in Romania in the meaning of art. 6bis of the Paris Convention for the Protection of Industrial Property* (art.6, para. (2) letter f), and also when listing the criteria according to which the notoriety of a trademark is examined (art.24 para. (1)).

The Regulation for implementing the Trademark Law provides rules for determining and proving the notoriety in art. 19, these being the sole provisions from this legal act that address the notorious trademarks.

However, the Paris Convention admits the existence and the need to provide protection for notorious trademarks, under art. 6bis which provides that the *EU countries undertake, either ex officio if their legislation allows it or at the request of the interested party, to refuse or cancel the registration and to forbid the use of a manufacturer trademark or a commercial trademark that constitutes a reproduction, imitation or translation, capable of creating confusion, of a trademark that the competent authority, from the country of registration or use, will rule that said trademark is notoriously known as the trademark of a person entitled to benefit from this Convention and as being used for identical or similar products. The same procedure shall be followed when the essential part of the trademark constitutes a reproduction of any such notorious trademark or when an imitation may be confused with it.*

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<sup>1</sup> Viorel Roș, Octavia Spineanu-Matei, *Dragoș Bogdan, Dreptul proprietății intelectuale. Dreptul proprietății industriale. Mărcile și indicațiile geografice* (Bucharest: All Beck, 2003), 100-112.

<sup>2</sup> Yolanda Eminescu, *Regimul juridic al mărcilor* (Bucharest: Lumina Lex, 1996), 83-85.

Concerning the **reputed trademark**, the Trademark Law neither defines it nor mentions it in any way, but it does speak of the registered trademarks reputation, namely of trademarks which “have a reputation”, of “the Community trademark reputation” and the “previous trademark reputation” (art. 6 para. (3) and (4) letter a), art. 36 para. (2) letter c), art. 90 para. (2) letter c)). The published literature<sup>3</sup>, however, defined reputed trademark as being the “*trademark known by a significant part of the audience targeted by the products and services for which the trademark is registered*”, according to the same authors “a significant part of the audience targeted”, meaning something more than insignificant, but less than a “widely known trademark”, such as the notorious trademark.

Not only is **the famous trademark** not defined, but it is not even mentioned in any way by either the Law or the Paris Convention. It is, however, accepted by the doctrine, according to the French model, as the trademark “*known by most of the general public, not only in France, but abroad as well and which acquired autonomous value, independent of the product or service which it usually designates*”<sup>4</sup>.

It was also said that the famous trademark (or of the highest repute) would be the one that gained world fame and this feature would justify the need to be protected, including when an identical or similar sign would be registered for different products or services.<sup>5</sup>

In our opinion, neither the reputed trademark nor the famous trademark have any independent existence; therefore we cannot classify the trademarks (depending on the degree of distinctiveness) in notorious, reputed and famous trademarks.

We shall present below the arguments regarding the inexistence of the reputed trademark as a stand-alone trademark.

Rigorously analysing the provisions of art. 6 para. (3) and (4) and art. 36 para. (2) letter c), we shall notice that **the Romanian Trademark Law neither establishes, nor protects the “reputed trademark”, but establishes and protects the reputation of the registered trademark, whether it is notorious or not**, as an attribute, a quality, a feature gained through usage and recognition by the audience targeted by the products and services the trademark designates and which distinguishes it from other trademarks.

The law claims that a trademark is refused upon registration or, if registered, is liable to be cancelled if it is identical or similar to a *previous Community trademark* (art. 6 para. (3)) or to a *previous trademark registered in Romania* (art. 6 para. (4)) and if it is intended for products or services which are not similar to those for which the previous mark was registered, when the previous Community trademark/previous

trademark registered in Romania enjoys a reputation in the European Union/in Romania and if:

- in the case of the previous Community trademark, an unfair advantage were obtained from the distinctive character or the reputation of the Community trademark, from the subsequent trademark use.

- in the case of the previous trademark registered in Romania, an unfair advantage were obtained from the distinctive character or the reputation of the previous trademark or if the use were detrimental for the distinctive character or for the reputation of the previous trademark, from the subsequent trademark use.

In relation to the provisions mentioned above, it should be taken into consideration that, according to art. 6 para. (2) letter f), earlier trademarks are trademarks that, on the date of submitting the application for registration or, where appropriate, on the date of the claimed priority, are notorious in Romania, in the meaning of art. 6bis of the Paris Convention.

Also, art. 36 of the Trademark Law, governing the counterfeiting action, entitles the trademark owner to ask the competent court to prohibit third parties from using, in their commercial activities, without its consent, a sign that is identical or similar to the trademark, for products or services different from those for which the trademark is registered, when the latter **has acquired a reputation in Romania and if the unlawful usage of the sign were detrimental to the distinctive character of the trademark or detrimental to its reputation** (para. (2) letter c)).

In conjunction with the legal texts mentioned, we may conclude that the Trademark Law provides protection for the reputation of a trademark, whether it is a notorious trademark in Romania, a Community trademark, a registered trademark in Romania or a different previous trademark, among those provided for by art. 6 para. (2) of the Law.

The Law does not protect the “reputed trademark” as a trademark different from the notorious trademark, but recognizes and protects the reputation of the trademarks, when appropriate, including **the reputation of notorious trademarks!** (and this fact results from art. 6 para. (4) letter a), in relation to art. 6 para. (2) letter f)).

Regarding famous trademarks, this cannot exist as a trademark different from the reputed trademark, as it is not legally regulated under national or conventional law (namely by the Paris Convention for the protection of industrial property and by the TRIPS Agreement).

Secondly, from a semantic point of view, there is no difference between famous and notorious; on the contrary, the two adjectives are synonyms: according

<sup>3</sup> Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *op. cit.*, 112.

<sup>4</sup> A. Bertrand, *La propriété intellectuelle. Livre II. Marques et brevets. Dessins et modèles*, (Paris: Delmas, 1995) apud. Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *op. cit.*, 107.

<sup>5</sup> Yolanda Eminescu, *op. cit.*, 84.

to the Explanatory Dictionary of the Romanian Language, “famous” means *renowned, famed, illustrious*, while “reputed” (“of repute”) means *famous, famed, renowned, glorious, illustrious*.

Thirdly, but perhaps the most important part, since the jurisprudence did not feel the need to recognize a third category of trademarks, alongside the notorious trademark and the reputed trademark, we may admit that only a false need may boost the recognition and protection of the famous trademarks *per se*.

In conclusion, for the reasons set out above, the famous trademark is a doctrinal creation<sup>6</sup>, whose existence, if accepted, would be ineffective because such a category of trademarks would not find applicability in practice.

Therefore, our opinion remain that there are no notorious, reputed or famous trademarks as trademarks with a different legal regime; however, notorious trademarks exist, as they are recognized by national and conventional law. There are no reputed trademarks, but the “of repute” concept does exist and the Romanian Law makes available, to the trademarks owners, means of protection for these trademarks. There are no stand-alone famous trademarks; the concept of “famous trademark”, should we admit its existence, it is at most a synonym for the notorious trademark.

### 3. The legal regime of the notorious trademark.

In essence, the notorious trademark is a trademark with a distinctive power, superior to other registered or unregistered trademarks. This is due to the fact that the notorious trademark is the trademark widely known, in Romania, by the audience targeted by the products and/or services to which it is applied/ which it designates.

For that matter, the published literature admits that the notoriety is a way of acquiring the exclusive right of a trademark, in relation with the fact that “the notoriety of the sign chosen as a trademark has the same effects as its registration: the trademark owner is protected in terms of the use and registration of said sign by other parties”<sup>7</sup>.

Concerning its provisions, the Law grants unlimited protection to the notorious trademark, as **even a holder of an unused trademark on the Romanian territory** may subject to national courts an action for annulment or an infringement action against the person who takes over its trademark or may oppose the registration of such trademark to the State Office of Inventions and Trademarks. However, notoriety must be proved according to the criteria and methods set out by the Trademark Law and its Implementing Regulation, namely: the notorious trademark degree of

distinctiveness (initial or acquired) in Romania; the notorious trademark duration and extent of use in Romania in relation to the products and services for which a trademark is sought to be registered (if the notorious trademark is used in Romania); the notorious trademark duration and extent of advertising in Romania: the notorious trademark geographical area of use in Romania (only if the trademark is used in our country); the degree of knowledge of the notorious trademark on the Romanian market, of the targeted audience segment; existence of identical or similar trademarks for similar or identical products or services, belonging to someone other than the person who pretends that its trademark is notorious (art. 24 para. (1) from the Law).

The trademark notoriety must be proved by its owner, by any evidence, as “acts” may be presented (art. 19 para. (6) of the Trademark Law Implementing Regulation) such as those concerning the marketing/sale of products or services under the known notorious trademark, the import or export of the products on which the notorious trademark is applied, the advertising of products and services under notorious trademark known in Romania.

However, in order to establish that a trademark is notorious, it should be well-known, on Romanian territory, by the Romanian audience segment towards targeted by the products and services for which the trademark is used (art. 19 para. (1) of the Trademark Law Implementing Regulation). The quoted legal text provides for two *sine qua non* conditions ruling the trademark notoriety, conditions that have as reference elements the Romanian territory and the Romanian audience segment targeted by products or services. According to the law, the good or less good knowledge of the trademark is examined in relation to these elements.

The notorious trademarks are recognized by both the Paris Convention (as revised in Hague in 1925) and the TRIPS Agreement. The Paris Convention enforces the Paris Union members (among which Romania as well) to refuse, ex officio or upon request, the registration or to prohibition on using a trademark which constitutes a reproduction, imitation or translation of a trademark which “*the competent authority of the country of registration or use shall consider to be notoriously known as already being the trademark of a person entitled to benefit from this Convention and as being used for identical or similar products*”, the same being true where the essential part of a trademark constitutes “a reproduction of a notoriously known trademark or an imitation that may be confused with it” – art. 6bis.

Given the context, it should be noted that the Romanian translation of the Paris Convention (under Decree no. 1177/1968) is slightly unfortunate and likely to lead to “confusions”, given that the terms “well-known” and “noitirement connues” from

<sup>6</sup> Andre Bertrand, G.H. Bodenhausen and Yves Saint-Gal are among foreign authors that admit the existence of the famous trademark.

<sup>7</sup> Viorel Roş, Octavia Spineanu-Matei, Dragoş Bogdan, *op. cit.*, 103.

English and French were translated into Romanian as “notoriously known”, although the correct translation would have been “notorious”.

According to art. 16 item 3 of the TRIPS Agreement, with respect to art. 6bis of the Paris Convention, the notorious trademark shall also be protected against identical or similar signs which will be registered for products or services different from those designated by the “**registered trademark**”. The published literature granted, to the quoted text, an interpretation according to which the protection imposed on notorious trademarks by means of art. 6bis of the Paris Convention is also extended to the products or services that are different from those sold under the notorious trademark, conditional on the **prejudice of the trademark owner interests**, as well as the **registration of the notorious trademark**: “*TRIPS expands the protection area for the notorious trademark, including products and services that are not identical or similar (...); however, the protection shall be extended only for registered notorious trademarks, and not for unregistered notorious trademarks as well. However, TRIPS does not intend to amend the Paris Convention and dispose of the registration of notorious trademarks in all cases*”<sup>8</sup>.

#### 4. Civil law means for protecting the notorious trademark

As with other trademarks, notorious trademarks may be protected by owners either under the administrative proceeding, by introducing opposition proceedings (under art. 19 in conjunction with art. 6 and with reference to art. 24 of the Law), or during legal proceedings, the notorious trademark right owner having available, where appropriate, the action of infringement, annulment or unfair competition (as regulated in art. 36 of the Law).

If the action of annulment seeks the annulment of a registered trademark which conflicts with the notorious trademark, the action of infringement tends to force the usurpers to stop using signs meant to cause damage to the notorious trademark right owner and to pay compensation for damages caused.

The action of infringement may also be used by the notorious trademark right owner for defending the reputation of its trademark.

According to art. 36 para. (2) letter c), when a sign identical or similar to a trademark is used for products or services different from those for which the notorious trademark is registered, its owner may bring an action of infringement, if the unlawful use of the sign is meant to cause damage to the trademark reputation. The action is also brought against a notorious trademark owner, under the condition that said trademark had been registered.

The published literature states that the extension of trademark protection (notorious or not) on products and services different from those for which the trademark was registered constitutes an attenuation of (and not a derogation from) the effects of the trademark specialty rule.<sup>9</sup>

By comparison to the provisions of the Trademark Law analysed above and in relation to the fact that both a registered trademark and a notorious trademark (registered or not) may gain a reputation, we believe that the owner of a trademark with a reputation may bring, if necessary, an action for the acknowledgement of the trademark reputation.

At the same time, we believe that the existence or inexistence of the trademark reputation shall be proved within the action for the reputation acknowledgment, taking into account the criteria for examining the notoriety, as defined and provided for in art. 24 para. (1) of the Law and art. 19 of the Regulation.

### 3. Conclusions

Neither the provisions of Law no. 84/1998 on trademarks and geographical indications, nor the Paris Convention, nor the TRIPS Agreement do not allow us to classify the trademarks based on their degree of distinctiveness, in notorious trademarks, famous trademarks and reputed trademarks. As stated from the interpretation of the legal provisions, if the recognition and existence of the notorious trademark is certain, the other two categories do not exist.

In reality, the Law, by recognizing the reputation of a trademark, does not protect the concept of “reputed trademark”, but the trademark reputation itself, reputation that may coexist with a notorious trademark, registered or unregistered, and also with a registered trademark, according to common-law. However, what must be remembered is the fact that, in order to have its reputation protected, the notorious trademark must be registered.

However, an interesting problem is the fact that any person that registers a trademark wishes for the sign thus registered to gain reputation among the audience segment targeted by the products or services it designates.

However, if it does not gain reputation, does the trademark still perform its function of differentiating the products and services and of indicating their origin? May we claim, concerning such a trademark, that it lacks distinctiveness? In essence, could a trademark without reputation be cancelled? What is the boundary between the reputation and distinctiveness required both at the time of submitting the application for the registration and for its survival in the commerce? The answers to these questions,

<sup>8</sup> Viorel Roș, Octavia Spineanu Matei, Dragoș Bogdan, *op. cit.*, 103.

<sup>9</sup> Jérôme Passa, *Droit de la propriété industrielle* (Paris: L.G.D.J., 2009), 175. The rule „attenuation” takes place only for the trademark reputation protection.

which are interesting, exciting and with practical applicability, shall represent the subject of future endeavours.

#### References

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