

TRADEMARK PROTECTION SYSTEMS – USE VS. REGISTRATION

George-Mihai IRIMESCU*

Abstract

The main purpose of the paper is comparing different trademark protection system, focusing on European jurisdictions and the relevant legislations.

The comparison focuses on the Romanian jurisdiction, as representative for the attributive system, and the Italian jurisdiction, which the doctrine considers representative for the declarative system. For each of them, the relevance of both use and registration are presented in terms of acquiring, consolidating or losing protection.

By presenting the first to use and first to file systems, the article aims to compare them by outlining the advantages and disadvantages of both systems, and also by showing what they have in common in terms of legal consequences.

The article also describes the approach of international conventions with respect to trademark protection system, focusing on the legislation of the European Union, which is also directly relevant to both jurisdictions chosen to outline the two systems.

Finally, brief commentaries regarding the notion of "use" are made, along with conclusion regarding the analyzed trademark protection systems.

Keywords: first to file system, first to use system, use, registration, trademark protection.

1. Introduction - The main trademark protection systems

The doctrine identified three trademark protection and acquiring trademark rights systems: the first to use system (realist or declarative), the first to file system (or attributive) or the mixt system (or dualist)¹.

The declarative system is that system where the trademark rights are acquired by the first person who put the trademark in the commercial circuit. Thus, the occupation is made through the effective use of a mark.

The first to use system does not, however, exclude registration trademark proceedings in the jurisdictions where it is present. In these countries, however, the effect of the trademark application is in principle a declarative one, and not of constituting rights, the act of use being independent of any trademark application, with nuances that we will further show.

Moreover, the act of use should be public and exercised *animo domini*, in other words showing the intention of the owner to appropriate that trademark, the continuous use being a condition to consolidate the right² (and not one to acquire the right, as could be interpreted in some situations in the attributive system). We consider there is a fine limit between a certain use duration that serves to determine the seriousness of use and the intention to appropriate,

having therefore an attributive role, and the continuation of use that only consolidates the right. Although the intention to appropriate the mark is undoubtedly a subjective attitude, it is proven by means of objective, exterior facts, a possible indication being the continuity of use. However, such a limitation, that implies degree of subjectivity, has more of a theoretical importance than a practical one.

Thus, in order to obtain trademark protection in this system, the doctrine identifies an objective condition (the public use of the trademark) and a subjective condition (the intention of appropriation), which could be proven by any means available, since these are legal facts³.

In the attributive system, the trademark right is acquired through registration before the national or regional intellectual property offices. Thus the right to a trademark belongs to the first person that filed a valid trademark application for a distinctive sign, with the condition it is registered when the procedure is finalized. However, although the prior use is not, as a rule, opposable, the use or non-use of a trademark do have legal consequences, as we will further detail.

The mixt system combine the characteristics of the two trademark acquisition systems, and it could be identified in the legislations of different states as the delayed attributive system (specific to the British law), the delayed system (where the trademark is not examined on the merits) and the preliminary approval system (used in the Swiss law)⁴.

However, it should be noted that the first two systems should not be seen as totally opposed. In both

* PhD Candidate, Faculty of Law, "Nicolae Titulescu" University of Bucharest (email: georgemihai.irimescu@gmail.com).

¹ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *Dreptul Proprietății Intellectuale. Dreptul Proprietății Industriale. Mărcile și indicațiile geografice*, All Beck Publishing, Bucharest, 2003, page 16 and the following.

² Ioan Macovei, *Tratat de drept al proprietății intelectuale*, C.H. Beck Publishing, Bucharest, 2010, page 342 and the following.

³ Florea Bujorel, *Dreptul Proprietății Intellectuale - Dreptul de proprietate industrială*, Fundației România de Măine Publishing, Bucharest, 2007, page 138 and the following.

⁴ *Idem*, page 345.

systems the use of a trademark, as well as its registration before the relevant office, have legal consequences.

2. Historical aspects regarding trademark protection in Romania

Although nowadays, at least at continental level, the attributive system is preferred (especially due to the international conventions as well as due to the relevant European legislation), the "occupation" system, of use priority, was initially preferred by the Romanian legislator for a long period⁵.

The first normative act which regulated the trademark protection in Romania was *The Law on factory and trade marks* from April 15, 1879. This law established the first to use system. Thus, the law stated that the trademark adopted by a trader could not be used by another trader and could not be adopted by another trader. Moreover, by means of the Regulation entered into force one month later, the procedure of filing an application with the Trade Tribunal was established, conferring 15 years of exclusive rights to the owner of such application⁶. Although the provisions regarding the trademark application with the tribunal could have led to the conclusion that the system established by this law is actually a mixt system, this application had rather a declarative role, and not that of a rights constituent, the right to a trademark being owned and recognized to that who firstly used it. Moreover, according to the case-law from the 1950's, the rights to a trademark were owned by that who filed the application only if it has not been previously used⁷.

The law from 1879 was the result of the freshly gained independence of Romania and of the Trade Convention signed in 1875 with the Austro-Hungarian Empire, which compelled Romania to issue a normative act which conferred protection to Austro-Hungarian industrialists and traders in Romania. Therefore, although the Romanian economy, mostly agrarian, was not in need of such a normative act, *The Law on factory and trademarks* represented the execution of the afore-mentioned convention. It established the optional principle of factory and trademarks and comprised a single provision regarding consumers' protection, which sanctioned the fraud in their detriment⁸.

Given that this law did not correspond anymore to the political and economic context of the 20th century, it was abolished by *Law no. 28 of December 29, 1967 regarding factory, trade and service marks*,

which established in the Romanian legislation the first to file system, by filing an application with *The General Direction for Metrology, Standards and Patents*. Thus, article 4 of this law stated that "*Factory, trade and service marks may be used only after their registration according to the current law. The marks may be used only for the goods, works or the services for which they were registered*". Moreover, article 18 stated that "*the registration of a mark confers the owner an exclusive right to use the mark for the goods, works and services for which the registration was made, for a 10-year term from the filing date*". Besides, this law renounced the optional character of the trademark, and established the obligation to register the trademarks covering goods, but not for services: "*The producing undertakings from the Socialist Republic of Romania are obliged to register and use the factory marks for all their goods designated to the internal consume. The registration of trade marks by sales undertakings and of service marks by undertakings that execute works or provide services, as well as use by them of the registered marks, is optional*"⁹.

As we will further detail, the current trademarks law continues to establish the first-to-file system, a solution that is adopted by all the systems of the Member States of the Paris Union.

3. The attributive system – its application in the Romanian law

Article 4 from Law no. 84/1998 on trademarks and geographical indications, republished (hereinafter "*The Trademarks Law*") settles the attributive system in the Romanian law, having the following content: "*The right to a trademark shall be acquired and protected by registration with RoPTO. Community trademarks shall benefit from protection on the territory of Romania in accordance with the provisions of the Community Trademark Regulation (a.n. European)*"¹⁰.

Thus, the trademark right is acquired through registration before the State Office for Inventions and Trademarks, on national way, or on international way through the system set by the Madrid Protocol, or through registration before the European Union Intellectual Property Office, as European trademarks are valid on the Romanian territory starting with January 01, 2007.

Moving forward, article 36 para. 1, states that "*the registration of a trademark shall confer on its owner an exclusive right in that trademark*", the

⁵ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *op.cit.*, page 16 and the following.

⁶ *Idem*, page 12 and the following.

⁷ Yolanda Eminescu, *Regimul juridic al mărcilor*, Lumina Lex Publishing, Bucharest, 1996, page 114 and the following.

⁸ Yolanda Eminescu, *op. cit.*, page 32 and the following.

⁹ Art. 4, 5 and 18 from Law no. 28 of December 29, 1967 regarding factory, trade and service marks published in the Official Bulletin no. 114 of December 29, 1967.

¹⁰ Art. 4 of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

subsequent paragraphs and articles regulating in more detail the actions available to a trademark owner for protecting its rights¹¹.

Thus, the current regulation kept the attributive system adopted since the law of 1967¹².

As shown above, the attributive system is not characterized only by the fact that the trademark application is a condition for obtaining protection, but also by the fact that a trademark, in order to get registered, is subject to examination on relative and absolute grounds. Thus, the doctrine very well underlines that the registration should not be confused with the filed trademark application¹³. Hence, procedural-wise, the trademark application is the initial moment of the trademark registration proceedings, and its major importance consists in establishing the date from which the trademark owner enjoys protection of the right deriving from its trademark (except priorities or other specific legal situations). The registration, however, which represents successfully finalizing the examination proceedings, is the moment that consolidates the provisional trademark rights acquired through filing the trademark, and represents the final moment of the registration before the office.

However, even if the singular public act of use is not constituent of rights, using a trademark or, on the other side, refraining from use, have significant consequences both in the sense of acquiring protection for a trademark as well as in the sense of losing it.

One of the most important legal consequences of using a trademark is acquiring protection for unregistered trademarks by proving the well-known status thereof.

According to the Trademarks Law, the well-known trademark is defined as "*a trademark that is widely known to the segment of the public concerned by the goods or services to which it applies, without being required either registration or use thereof in Romania for the trademark to be opposable*"¹⁴.

The Regulation for Implementing Law no. 84 / 1998 on Trademarks and Geographical Indications (hereafter referred to as *The Trademarks Regulation*) defines "*the level of awareness of the well-known trademark as the extend to which the consumer public segment is aware of the existence of the trademark. The geographical area is defined as the area of knowledge on the Romanian territory of the well-known trademark*"¹⁵.

Given that well-known trademarks are protected without the need of registration thereof, we can affirm that protection of well-known trademarks is one of the

exceptions through which the declarative system is still present in the Romanian legislation. There is, however, an essential difference between protection of well-known trademarks and a trademark protected in the first to use system. Thus, regarding the well-known trademark, the continuous use could be an essential element which leads to the acquirement of rights, by fulfilling the conditions imposed by the Trademarks Law or the *Joint Recommendation Concerning Provisions on the Protection of Well Known Marks*, adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization. On the other hand, as we outlined above, in the case of the first to use system, continuing the trademark use has solely the purpose of consolidating the rights acquired through the first use.

It should also be mentioned that proving the well-known status of a mark, according to the Romanian legislation, does not represent a singular effort. In other words, the owner of a well-known trademark is held to prove the well-known status of its trademark with the occasion of each case, each conflict or matter where it is involved and such proof is deemed necessary. Even if once proven the well-known status with the occasion of the first conflict the subsequent demonstration already enjoy a solid basis, we should not lose sight of the fact that, once the following conflict will appear, the owner will have to demonstrate that the well-known status of its trademark was at least maintained. To this end, we consider the legal provisions in the Republic of Moldova interesting, where the owner of a trademark, with the occasion of a conflict that involves a presumably well-known trademark, has the possibility to file a request of acknowledgement of its well-known status with the Chişinău Court of Appeal¹⁶. In case the well-known trademark status is accepted, the trademark is entered into the Well-known Trademarks Register, being afterwards published in the Intellectual Property Official Bulletin¹⁷. We can therefore conclude that these provisions, beside a greater efficiency from the perspective of the owners of the well-known trademarks, which are held to prove the well-known status of their trademark with the occasion of the first rights conflict where they are involved, brings the regime of well-known trademarks closer to the attributive system. This way, the right of the first person who made proves for the first time of the intensive and serious use of that trademark on the territory of the Republic of Moldova is recognized, basically, through a registration.

11 Art. 36 of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

12 Ioan Macovei, *op.cit.*, page 345 and the following.

13 Florea Bujorel, *op. cit.*, page 140 and the following.

14 Art. 3 letter d) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

15 Art. 1 letters n) and o) Government Decision 1134/2010 for aproving the Implementing Regulation of Law no. 84/1998 regarding Trademarks and Geographical Indications, published in the Official Gazette number 809 from December 03, 2010.

16 Art. 32 para. (2) of Law no. 38 / 2008 regarding trademark protection, Republic of Moldova.

17 <http://www.wipo.int/edocs/lexdocs/laws/mo/md/md071mo.pdf>.

Regarding this system established by the legislation in the Republic of Moldova, although it presents considerable advantages especially for practitioners, we believe that it is not fully in line with the market situation. Thus, the well-known status of a mark is a dynamic situation, fluctuating, to be assessed at various key moments of different procedures. Once a trademark is entered in such a register, the person that will have to make the effort to initiate actions for removing the trademark from the register in question is the counterpart which, for various reasons, may not wish to and assume such effort, although the opposed trademark meanwhile lost the well-known character.

The Romanian legislation also sets rights acquisitive legal effects for the use of a trademark in the case of filing for registration a trademark that is devoid of distinctive character, as a consequence of distinctiveness acquired through use. Article 5 para. (2) provides that "*the provisions of paragraph (1), letters (b) - (d) shall not apply if, prior to the date of the application for registration of a mark and by reason of its use, the mark has acquired a distinctive character*"¹⁸. More specifically, letters b)-d) of paragraph 1 formulate the following absolute grounds for which a mark is refused registration: the trademark is devoid of distinctive character, the trademark is composed exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade and the trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services.

Thus, this article provides protection to trademarks that, although after examination thereof are not considered sufficiently distinctive to be registered, due to their intensive use have acquired distinctiveness so that they can be registered. Distinctiveness must be proved before the date of filing of the refused trademark.

Moreover, the new Trademarks Directive brings completions in this respect. As regards the absolute grounds for refusal, the old directive provided that a trademark is accepted for registration, for trademarks devoid of distinctiveness, descriptive or generic, if before the filing date of the trademark application it has acquired distinctive character through use. Similarly, in case of a cancellation action, Member States had only the possibility (not the obligation) to provide that a trademark shall not be canceled if the acquired distinctiveness is proven before the date

proceedings were initiated¹⁹. The current Directive, however, eliminated the optional nature, for Member States, regarding the adoption of this solution if in case of the cancellation action, as they are now obliged to provide for this possibility in the national legislations²⁰.

We believe, however, that both regulations (i.e. those concerning the protection of well-known trademarks and distinctiveness acquired through use) are based on the same principle, namely the protection acquired by a trademark due to its enhanced distinctiveness acquired through extensive use. Only the prerequisites differ: well-known trademarks are based on the premises that the trademark owner did not file a trademark application for registration of the sign as a trademark before the relevant office, while in the second case, a trademark could not be registered due to lack of inherent distinctiveness, usually established within the examination by means of a provisional refusal. Thus, both result in protection just like a registered trademark, or in its very registration, for a trademark which was not filed for registration or that would not otherwise have been registered, due to its outstanding distinctiveness acquired through use on the market.

Regarding the distinctiveness acquired through use, it is usually a requirement to be fulfilled in case of registration of trademarks consisting of colors or combinations of colors. On one hand, RoPTO's practice has shown that, generally, a color *per se* is not considered sufficiently distinctive to be registered as a trade mark. It is also considered to be against the interest of market participants that certain holders appropriate, only by means of a trademark application, monopoly over a particular color. Thus, by its decision of April 03, 2014, RoPTO's Board of Appeal rejected the appeal filed by the applicant a mark color (blue) for goods and services in Classes 29, 31 and 35. In this regard, the Board stated the following: "*The Commission notes that, within the evidence filed by the appellee – applicant, with the purpose of acquiring distinctiveness through the use of the trademark consisting of the color blue Code Pantone Light Blue 072C, there is no written document – poll, market survey – which clearly show that the trademark applied for registration - blue square (...) - could be recognized by the average consumer as belonging to the applicant (...). In addition, all the evidence filed by the appellee - applicant (packages), is for trademarks that contain the blue color and other word and figurative elements, and not for trademarks or designs / packaging containing only the blue color per se*"²¹.

¹⁸ Art. 5 para. (2) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

¹⁹ Art. 3 para. (3) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, published in the Official Journal of the European Union of November 08, 2008.

²⁰ Art. 4 para. (4) of Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 to approximate the laws of the Member States relating to trademarks, published in the Official Journal of the European Union of December 23, 2015.

²¹ Decision of the Board of Appeal of the State Office for Inventions and Trademarks no. 107 of April 03, 2014 in the file CCM 144/2013.

Another situation where the use of a trademark has a rights acquisitive effect is the extension of the protection of a trademark through demonstrating its reputation or renown. The legal provisions established after the republication of the Trademarks Law in 2010, on the one hand emerging from the old regulations regarding the well-known trademark and due to the need to harmonize the legislation on industrial property *acquis communautaire* read as follows: "registration of a trademark shall also be refused or, if registered, shall be susceptible of being cancelled if (...) the trademark is identical with or similar to an earlier trademark registered in Romania, within the meaning of the paragraph (2) and it is intended for registration or it is already registered for goods and services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in Romania and where, by the use of the subsequent trademark, unfair advantage would be taken of the distinctive character or the reputation of the earlier trademark or if such a use would be detrimental to the distinctive character or reputation of the earlier trademark"²². A similar provision is aimed at protecting European trademarks with reputation in Romania²³. Without going into further details, we only emphasize that for trademarks with reputation, indeed, the longstanding and extensive use has the effect of extending protection of a trademark proprietor beyond the goods and / or services for which the trademark is protected. There are two essential additional conditions: the need that the trademark whose reputation is claimed to be registered and to demonstrate that use of the subsequent trademark is detrimental to the distinctive character of the trademark with reputation.

On the other hand, lack of the use may result both into revocation of the trademark rights of the owner and into the ineffectiveness of the opposability of a registered trademark.

For example, in opposition proceedings, the applicant of the contested trademark has the possibility to request the opponent to furnish proof the use of the opposed trademark for a continuous period of five years preceding the date of publication of the filed trademark, if the opposed trademark was registered for more than five years. The opponent has either the possibility to demonstrate the use of its trademark or to bring proof of the legitimate reasons that enabled him to use it²⁴. If the opponent does not prove the use of its trademark, or the filed evidence is

considered insufficient, the opposition will be rejected for those goods and / or services for which the proof of use has not been made. Thus, although the opposing trademarks' holder does not lose its exclusive rights with respect to those goods or services for the future, in that particular case will not be able to claim his rights.

Much more energetic to this end is filing, by any interested person, of a revocation action "if, within a continuous period of 5 years, as from the date of its entry in the Trademark Register, the trademark has not been put to genuine use on the territory of Romania in connection with the goods or services in respect of which it is registered or if such use has been suspended for a continuous period of 5 years, and there are no proper reasons for non-use"²⁵. This legal provision has as purpose "cleaning the register" of the so-called "blocking trademarks"²⁶.

Regarding this legal provision, we make only a brief comment concerning the international registration of trademarks designating Romania. These trademarks are not entered into the National Trademark Register. Consequently, the interpretation of the date from which the calculation of the five year period after which the trademark becomes vulnerable for on-use is unclear from the perspective of this article. However, EUIPO case law has outlined the following solution, while arguing an appeal matter where proof of use for an international trademark designating Romania was required:

"Under article 5(2) of the Madrid Agreement, the Designated Offices have a period of 12 months after the entry of the mark in the International Register to issue a (provisional) refusal of protection. (...)Where (provisional) refusals have been issued (...), the registration proceedings will be considered as terminated only once the respective proceedings have been finally concluded and a final notice has been sent to WIPO by the Designated Office. Austria and Romania are among the Member States that use the 12 months deadline to issue a provisional refusal (...). The Office will on its own motion apply the one year deadline for international registrations governed by the Madrid Agreement.(...) It is for the parties to claim any date that is later than these dates". In this case, EUIPO considered that the date from which the 5-year period starts to run for the Romanian designation of the trademark is the publication date of the decision of grant in the WIPO Gazette²⁷.

One last point we want to emphasize regarding the consequences of using a trademark in the

²² Art. 6 para. (4) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

²³ Art. 6 para. (3) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

²⁴ Art. 19 para. (3) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

²⁵ Art. 46 para. (1) letter a) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

²⁶ Viorel Roş, Octavia Spineanu-Matei, Dragoş Bogdan, *op.cit.*, page 19 and the following.

²⁷ EUIPO Decision no. B 1 437 377 of September 14, 2010.

attributive system effect is to strengthen the rights to an already registered trademark, meaning that a trademark, although registered, may have difficulties in opposing the registration of other trademarks because of its weak distinctiveness. To this end, we take into consideration the *Common Communication on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)* issued by EUIPO on October 02, 2014. According to them, the coincidence of trademarks in a weakly distinctive element could be insufficient in the overall assessment of the likelihood of confusion between the trademarks²⁸. Thus, it could be in the interest of the trademark holder to demonstrate the enhanced distinctiveness of its trademark or of the components of its trademarks, and this will be done through the evidence of use that it will be able to furnish.

In conclusion, we wish to underline a series of advantages and disadvantages of the attributive system, as they were identified by the doctrine:

Clearly, the main advantage is that a registered trademark confers a clear date from which the owner's trademark rights commence, thus providing a dose of certainty to legal relations. Also, third parties may have a relative image of the trademark rights valid in the market, by simply accessing the relevant registers. Therefore, such a system can create predictability regarding the possibility to register rights. The disadvantages are that the attributive system permits the registration of "blocking trademarks". Thus, a register may be crowded with registered trademarks which the holder does not intend to actually use, or with trademarks registered for more goods or services that are not actually used by the holder. Even if there is the remedy of the revocation action, it is not available for interested persons but only after a period of five years from the registration of the mark has passed (or even more if the proprietor of the blocking trademark fails to pay the publication and issuance of trademark certificate fees). Then, for the owners who use the trademark before registration thereof, the time elapsed between the time of putting the trademark on the market and filing the trademark application before the competent office may give the chance to bad faith third parties to file that trademark. For the remedy provided by law against those third parties, namely the cancellation action based on bad faith, it is not always easy to prove grounds²⁹.

Also, with reference to trademarks devoid of distinctiveness that enjoy protection only after demonstrating their distinctness acquired through use, it was noted that the temporal element can pose risks

to the proprietor of those marks. If such a trademark is filed too early, it will be refused as devoid of distinctiveness and its holder will not have sufficient evidence to prove its distinctiveness acquired through use. In contrast, a long wait may present the risk that another trader who noticed the attractiveness of the trademark, files it on its behalf, or files a variation thereof, leaving the person who used the trademark for a long time with limited possibilities to take action against it (the evidence that is sufficient to demonstrate acquired distinctness may be insufficient to demonstrate the well-known status)³⁰.

We add to the above a further advantage of the attributive system, namely that an entry in a register provides a more clear picture of the scope of protection of a trademark, both with respect to the designated goods or services and with respect to the exact determination of the protected trademark. To this end, certain registers, including that of the RoPTO, also provide information about disclaimers filed with respect to certain components of the protected trademark. Lastly, there are registers, such as EUIPO's, which in the name of transparency, provide information regarding the whole history of the registration procedure of a trademark, including certain filed oppositions, their text, texts of the refusals, office actions, corresponding decisions and so on. On the other hand, with respect to the declarative system, we consider the dynamism of trade relations as a fundamental advantage. Even if the difficulty of enforceability is often cited as a drawback we are of the opinion that nothing prevents the holder to file an application with the purpose of assuring the publicity of its rights, without prejudice to the rights acquired rapidly as a result of use.

An advantage of the attributive system is the fact that the priority date, obtained by filing a trademark application in a Member State of the Paris Convention can be invoked within 6 months in any Member State of the Convention. In this regard, article 4 of the Paris Convention refers to the "*filing*" as a moment generating the priority period, and not to any other way of obtaining a trademark right³¹. The doctrine also noted that the priority issue is not characteristic for the declarative system³².

We believe, however, that this opinion should be nuanced, in the sense that there is a situation where the use of a trademark is generating priority, namely by using it ("*presentation of certain goods or services under the trademark*") in an international exhibition as defined by the Convention on international exhibitions signed in Paris in 1928 and ratified by Romania in 1972. However, it is true that the date of

²⁸ http://www.osim.ro/marci/ro_common_communication2_cp5.pdf.

²⁹ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *op.cit.*, page 20 and the following.

³⁰ Mihai Andrei Enache, *Metamorfoza unei mărci. Distinctivitatea dobândită*, Revista Română de Proprietate Industrială, no. 5-6, page 47.

³¹ Art. 4 of the Convention on the Protection of Industrial Property of March 20, 1883, Paris, as revised and modified, ratified by Romania through Decree nr. 1.177/1968, published in the Official Gazette no. 1 of January 6, 1969 from Paris regarding the Protection of Industrial Property of March 20, 1883.

³² Ioan Macovei, *op.cit.*, page 343 and the following.

introduction of a product in an exhibition cannot extend the priority date given by a filing in a Member State of the Convention³³. Also, as we will show below, filing a trademark application is not incompatible with the declarative system. We therefore believe that the existence of a filing, whether or not generating a trademark right, is sufficient for claiming priority under the Paris Convention. Also, as we will show in more detail below, the Paris Convention refers only to the existence of a filing.

4. The declarative system – applicability in the Italian law

As mentioned above, in the declarative system, the right to a trademark belongs to the person that firstly used on the market a certain distinctive sign. Thus, obtaining protection for a trademark does not require the fulfillment of any formalities, be it an application, a statement or issuance of any title³⁴.

The doctrine states that in case of the declarative system the trademark registration procedure before the national office is not excluded. However, the trademark application has a declarative role, the filing being a means of making the right public, the application representing a public and certain date of taking the trademark in possession. Regarding the scope of protection, according to a part of the doctrine, it covers only the goods or services mentioned in the list covered by the application, and thus the application sets the limits of the protection, while another part believes that the protection extends by default to similar goods or services. Also, an application allows the holder to initiate criminal proceedings for infringement (until the filing the owner only had as available means of defense the civil action for damages, the trademark reproduction representing tort). Also, the application can be filed at the request of the assignee of a trademark appropriated by use, provided that it has been assigned from the first possessor³⁵.

Regarding the scope of protection, we believe that the assessment must be conducted primarily related to the goods and / or services for which the mark is actually used, and the filed application must be consistent with this reality. Otherwise, we may find ourselves in the situation of "bypassing" the declarative system, or in the presence of a mixt system.

In practice the question of the scope of protection was raised, especially in the case of complex marks. An application, having a declaratory value, provides protection for each component of the

trademark? We believe that this issue should be dealt with on a case by case basis, taking into account the overall comparison of the trademarks in conflict. Also, another question is what happens if the application differs in some elements of that mark being the subject the first to use protection? In this case we also consider that an application should be considered linked to a mark which was previously used to the extent that the application does not differ in essentials elements compared to the latter, as it is appreciated, in contrast, in the attribute system, where it is established that a different trademark is an act of use of the registered trademark if it does not differ essentially from the registered trademark.

As regards infringement proceedings, the issue of the retroactivity of the right to file such action for acts that occurred before the application was raised. The greater part of the doctrine considers that infringement proceedings may be directed only against acts of imitation that occurred after the time of filing the application, until then the acts of imitation being only unlawful civil acts, being considered that from this point of view the application acquires attributive character³⁶.

Moreover, in the use priority system, the application creates an ownership presumption in the favor of the person that filed it. Thus, if a conflict arises between the first occupant of the trademark (through use) and the later occupant (through an application), trademark rights will be recognized to the first occupant to the extent the it would be able to reverse the presumption of ownership of the applicant, proving the conditions of obtaining protection through use. However, if this proof is not made, or there is no evidenced prior right obtained through use, this application will have attributive character, the subsequent acts of use not being opposable to the applicant³⁷.

However, even in the declarative system, registration of a trademark with the national office may also have attributive character in the situation where at the filing date there is no prior right acquired by another person through use. Thus, the acts of use, subsequent to the filing of such an application, may not be invoked against the holder of that application³⁸. It is therefore noticed that the trademark right obtained through the use is independent to the application³⁹.

The doctrine has identified Italy as a jurisdiction that applies the declarative system of rights. Without wishing to dispute the classification of trademark protection systems accepted by the majority doctrine, we believe that Italy has rather a system in which the use (in the absence of a prior application) and an

³³ Art. 11 of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

³⁴ Florea Bujorel, *op. cit.*, page 137 and the following.

³⁵ Ioan Macovei, *op. cit.*, page 343 and the following.

³⁶ Yolanda Eminescu, *op. cit.*, page 119.

³⁷ Florea Bujorel, *op. cit.*, page 138 and the following.

³⁸ *Idem*.

³⁹ Yolanda Eminescu, *op. cit.*, page 122.

application (in the absence of previous use) have quasi-identical legal consequences, which is a genuine mixt system in which both use priority and registration priority are accepted.

However, given that Italy is a continental jurisdiction that establishes many elements of the declarative system, we will exemplify the above through the Italian legislation in force, as follows:

Article 12 of the Industrial Property Code introduces the concept of "*novelty*", when establishes that the signs cannot be registered as trademarks if at the filing date "*they are identical or similar to a sign known as a trademark or distinctive sign*" for certain goods and / or services, if due to the identity or similarity between the trademarks and due to the identity or similarity between the goods and services there is a likelihood of confusion from the public, which may also include a likelihood of association. This first paragraph continues by stating that the marks are *well-known* (notorious) in the light of article 6 bis of the Paris Convention. Also, this article provides that a trademark that does not enjoy well-known status, or only a local reputation, does not cause lack of novelty, but a third party that has used the trademark earlier may continue to use that trademark, even in advertising purposes, within the limits of local circulation, despite that the later mark is registered. In those circumstances, the person who has used the trademark keeps the right to use it, but cannot oppose the earlier mark⁴⁰.

Analyzing the above, we find that a well-known trademark, in the Italian protection system, has the same legal consequences as in the Romanian law, namely may represent an obstacle to the registration of a subsequent trade mark. However, although simple use, which is not transformed into well-known status, does not confer any rights in the Romanian law, in the Italian law it is accepted that the one who used the trademark may keep his right to do so, in spite of a registered mark, and even more, regulates the concept of local notoriety, which, again, is not regulated in the Romanian law, as there is no situation where a trademark holder may have rights to a mark only locally. However, the conclusion remains that in the Romanian law use cannot oppose registration unless it is sufficiently intense so that it translates into well-known status.

Moreover, according to the following paragraph, signs may not be registered as trademarks if they are identical or similar to a sign already known as a company name or as a sign used in commerce, if due to the identity or similarity of the signs and the identity or similarity of the commercial activity of that

who used the mark and the goods and services for which the mark is filed, there is a likelihood of confusion for the public, which may include the likelihood of association. In this case also, the sign cannot be an obstacle to registration if it is not well-known or if it enjoys a simply local well-known status⁴¹.

In the case of these signs also, the well-known status is the one that enables the enforceability against a further registration.

Lastly, article 25 of this law states that the grounds above also apply if the cancellation of a trademark is requested. Thus, if the same conditions are met, a used trademark can not only be opposed against trademark applications, but also when seeking the cancellation of a registered trademark⁴².

Although the Industrial Property Code is not perhaps sufficiently convincing in shaping the declarative nature of the trademark protection system in Italy, the Italian Civil Code takes several additional steps in this direction. Thus, although article 2569 confers exclusive rights to the person who registers a trademark in accordance with the law provisions, article 2571 states that the one who holds an unregistered trademark is entitled to continue using the trademark, even after it was registered by a third person, but within the limits of its initial use⁴³. This is the general rule under which the provisions described above from the Italian Industrial Property Code stipulated their detailed provision.

It is also noteworthy that the owner of an unregistered trademark, valid in Italy, has the possibility to successfully oppose the registration of a European trademark or to apply for cancellation (invalidation) of a European registration. Thus, the *Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark* (hereinafter referred to as "European Trademark Regulation") provides at article 8(4) that "*upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign rights to that sign were acquired prior to the date of application for registration of the EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark and that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark*"⁴⁴. Article 53 confers the same rights in case of invalidation of a European trademark⁴⁵.

⁴⁰ Art. 12 para. (1) letter a) of the Industrial Property Code (legislative decree no. 30 of February 10, 2005), modified in 2012.

⁴¹ Art. 2569 and 2571 of the Italian Civil Code (approved through the Royal Decree no. 262 of March 16, 1942), modified in 2012.

⁴² Art. 25 para. (1) letter a) of the Industrial Property Code (legislative decree no. 30 of February 10, 2005), modified in 2012.

⁴³ Art. 12 para. (1) letter b) of the Industrial Property Code (legislative decree no. 30 of February 10, 2005), modified in 2012.

⁴⁴ Art. 8 para. 4 letters a)-b) of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark published in the OJ L 78 of March 24, 2009.

⁴⁵ Art. 53 para. 1 letter c) of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark published in the OJ L 78 of March 24, 2009.

In other words, the European trademark Regulation allows that national unregistered trademarks are opposed European trademark applications in the conditions determined by the national law in the jurisdiction where they valid. One of the decisions of reference regarding the applicability of this legal provision, referring to opposing an unregistered Italian trademark is the decision of the Court of Justice of the European Union in Case C-263 / 09P "Elio Fiorucci", whereby it is outlined that the person requesting cancellation of a mark by invoking a prior right protected according to the national law is required to provide EUIPO not only information and clarification on the circumstances leading to the conclusion that his right is protected, but also to offer information on the content of the legal provisions according to which his rights are protected⁴⁶.

The declarative system becomes therefore important even for holders of rights in jurisdictions applying the attributive system. For example, a Romanian holder of a European trademark may face an opposition filed by an Italian owner, for instance, of an unregistered trademark valid in this territory.

Moving forward, article 1298 of the Civil Code also offers to the person that is the owner of an unregistered sign the possibility to defend its right through the unfair competition action. This article confers protection to the owner of some distinctive signs legitimately used, without making any distinction whether they are registered or not⁴⁷.

Regarding the advantages and disadvantages of the declarative system, the doctrine has identified that, in the case of the first to use system, the use by another trader of an occupied sign held is presumed to be of bad faith. Or, as correctly pointed out, a presumption of bad faith is incompatible with the general principles of many law systems, including the Romanian system. Bad faith is a subjective element that must be proved. A trader can use a trademark occupied by another simply by not knowing it is owned by another party, through ignorance, and we agree that no one could presume that a trader knows absolutely all the marks that appeared on the market⁴⁸. Thus, as correctly emphasized, *"the development of the industry and trade and use on a larger and larger scale of trademarks made this presumption of bad faith for acquiring the trademark rights through use priority to meet reality increasingly less"*⁴⁹.

The owner of a trademark acquired through use has, however, a number of advantages. As mentioned above, it can be transmitted, even if there is no trademark application filed for that mark. We believe that such a possibility provides dynamism to the

market. However, as we mentioned, occupation through use assumes two facts, the objective fact of using, and the subjective intention of appropriation. Could therefore an assignment of an unregistered trademark be challenged, as lacking object, by the interested person(s), if disputed that the initial use did not fulfill the conditions under the law provisions? Does the assignor have, in such a scenario, the obligation to guarantee the existence of the object of the contract? In the registration priority system, the existence of the trademark in registers is clear evidence of the existence of the object.

Also, the owner of a trademark acquired through use will have the possibility of filing an application⁵⁰, without its previous use being opposable, as determining lack of novelty (solution that we find normal). Thus, once appropriated through use, a trademark is more likely to be formally accepted to registration, which could be useful for the holder, for example, to further register the trademark on the international route or to enjoy priority under the Paris Convention.

Also in the context of the use priority the question of the admissibility of the trademark right acquisition by acquisitive prescription was raised. It was correctly concluded, however, that this institution is not applicable to the trademark law, since trademarks are intangible assets, while the acquisitive prescription is applicable to tangible assets, which finds itself in the possession of one owner (as opposed to an incorporeal good, which could be used simultaneously by multiple persons)⁵¹.

5. The mixt systems

We have already shown that mixt systems are those that combine both features of the attributive system and the declarative system, as legal effects are granted both to the factual existence of the trademark and to the act of trademark registration.

Such a system is the delayed attributive system, applicable, according to the doctrine, to the United Kingdom system, according to which the declarative application turns, after a certain period of time, into definitive proof of the trademark right for the proprietor of the filed trademark.

Indeed, the national trademarks law (Trade Marks Act) offers an added importance to trademark use. For instance, article 32.3 states that within the trademark application the applicant must declare that the trademark is used by him or by third parties with his consent, or that he has a *bona fide* intention of using it⁵². This text is of great importance especially

⁴⁶ Decision of July 5, 2011 in the matter C-263/09P, European Union Court of Justice, para. 50.

⁴⁷ Art. 2598 of the Italian Civil Code (approved through the Royal Decree no. 262 of March 16, 1942), modified in 2012.

⁴⁸ Viorel Roş, Octavia Spineanu-Matei, Dragoş Bogdan, *op.cit.*, page 17 and the following.

⁴⁹ Yolanda Eminescu, *op. cit.*, page 111.

⁵⁰ *Idem.*, page 18 and the following.

⁵¹ Yolanda Eminescu, *op. cit.*, page 133.

⁵² Art. 32.3 of Trade Marks Act 1994.

in conjunction with the legal provisions stating the refusal to register a trademark that was filed in bad faith (ground that can be basis for the cancellation of a trademark). Therefore, if an applicant did not have the *bona fide* intention to use the trademark for which protection was requested, its trademark may be refused or canceled. In this regard, it is interesting that one of the scenarios in which a trademark application was deemed to have been filed in bad faith is when the trademark has been applied for a much broader spectrum of goods and / or services, other than those for which the trademark may be used. However, the case law has considered that, even if an applicant did not have the intention to use the trademark for certain goods or services covered by the trademark application at the date of filing, but proves that he has taken its use into account afterwards, it can overcome an eventual appeal based on bad-faith⁵³. We believe, therefore, that in such a system, the so-called "blocking marks" filed for all classes of goods and services are more vulnerable to being canceled than in a classical attributive system.

However, one of the most important consequences of the use of a trademark in the United Kingdom is the possibility of protecting unregistered trademarks via the "*passing-off*" action. This legal mechanism is born in the English jurisprudence, and involves three elements: firstly that a trademark has reputation or enjoys at least goodwill (hence the passing-off does not represent a possibility for new trademarks or trademarks unused in the course of trade), the fact that the false representation of the trademark has occurred or is possible and, thirdly, that there is a risk of damage⁵⁴.

Also, in the Swiss law, considered representative for preliminary approval system, establishes in principle that the right to trademark is obtained by registration in the trademarks register⁵⁵. Also, well-known unregistered trademarks are protected in Switzerland according to the Paris Convention⁵⁶. The law also allows the person who has used a trademark, even if later it was registered by a third party, to continue to use it as it was used before the filing of the new trademark⁵⁷.

6. The approach of the new Directive and of international treaties

Regarding the European Union, within the recitals of *Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015*

to approximate the laws of the Member States relating to trademarks (hereinafter referred to as "the Directive"), at paragraph 11 of the recitals, it is provided that "*This Directive should not deprive the Member States of the right to continue to protect trademarks acquired through use but should take them into account only with regard to their relationship with trademarks acquired by registration*"⁵⁸. Consequently, even though the Directive does not suppress the right of Member States to continue to protect trademarks acquired through the first to use system, reaffirms the first to file system. Thus, the Member States of the European Union and of the European Economic Area, in virtue of this Directive, may provide for a mixt protection system at best.

The Directive also permits the protection of unregistered trademarks, to the extent that they are protected in the jurisdictions of the Member States where they are invoked. Specifically, the following relative grounds for refusal are set: "*Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark*"⁵⁹.

Moreover, especially related to the use of registered trademarks, the same recitals state that "*a registered trade mark should only be protected in so far as it is actually used and a registered earlier trade mark should not enable its proprietor to oppose or invalidate a later trade mark if that proprietor has not put his trade mark to genuine use. Furthermore, Member States should provide that a trade mark may not be successfully invoked in infringement proceedings if it is established, as a result of a plea, that the trade mark could be revoked or, when the action is brought against a later right, could have been revoked at the time when the later right was acquired*"⁶⁰. Articles 16-19 and 44-47 of the Directive provide in detail the consequences of not using a trademark in the opposition proceedings, in the infringement action or when an invalidation action is in place.

We can thus conclude that the Directive imposes national legislations to adopt the system of acquiring

⁵³ <http://www.worldtrademarkreview.com/Magazine/Issue/42/Country-correspondents/United-Kingdom-Edwards-Wildman-Palmer-LLP>.

⁵⁴ <http://ip-active.com/trademarks/unregistered-trademarks.php>.

⁵⁵ Art. 5 of the Federal Law on trademark protection and geographical indications of August 28, 1992.

⁵⁶ Art. 3 of the Federal Law on trademark protection and geographical indications of August 28, 1992.

⁵⁷ Art. 14 of the Federal Law on trademark protection and geographical indications of August 28, 1992.

⁵⁸ Point 11 of the recitals of the Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 to approximate the laws of the Member States relating to trademarks, published in the Official Journal of the European Union of December 23, 2015.

⁵⁹ *Idem*, art. 5 para. (4) letter a).

⁶⁰ *Idem*, point 32.

rights through registration, also establishing, in balance, legal sanctions for failing to use them in order to avoid unjustified charging of registers with blocking trademarks or trademarks that are simply unused. However, the Directive allows Member States to offer acquisitive effects to the trademark use, even the possibility to enforce the rights acquired through their use, according to the national law, without the purpose of regulating these aspects in detail or a harmonization of the legislations of the Member States relating to rights acquired through use of a trademark.

The Paris Convention for the Protection of Industrial Property encourages the filing of trademark application in view of the possibility of claiming the conventional priority. Thus, the Convention does not allow for the possibility of claiming priority resulting from a right acquired through use, in the sense of obtaining protection in the declarative systems. However, the following two nuances should be considered: firstly, the Convention provides that "*any person who has duly filed an application (...) of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed*"⁶¹. The nature of the application is described further: "*Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority. By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application*"⁶².

We believe, however, that this possibility does not necessarily refer to the member states that have established an attributive system, nor does it impose such a system to the member states of the Union. What is relevant in the applicability of the provisions relating to the conventional priority is the existence of an application, regardless whether it has an attributive or simply a declarative role. Therefore, one can say that the convention encourages the creation of national applications, but does not go so far as to impose an attributive system.

We also referred above to the exhibition priority. We believe, however, that such use is not of the nature of the use that confers legal protection in declarative systems, as it is merely a possibility provided by law to obtain effective protection from the date when the

applicant actually used the sign in an exhibition and intending to register it later. Moreover, this type of priority can only be claimed in the context of an attributive system in which protection is sought by filing an application with claiming this priority.

The remaining provisions contained in the Convention refer to the protection of registered trademarks, regulating legal situations such as use of the trademark in a form that differs from the form in which it was registered, the effects of not using a registered trademark as well as various absolute or relative grounds of refusal of registration of a trademark. However, the Convention makes no express reference and does not exclude the possibility of obtaining protection through use. We believe that this principle is clearly stated with respect to services marks under Art. 6sexies: "*The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks*"⁶³.

It is also interesting to analyze the trademark protection system under the Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989.

At first glance, these international agreements would require at least a mixt system to the signatory states, since they lay the foundations of an international registration based on filing trademark applications and examination by the national offices. However, the Agreement provides that "*from the date of the registration so effected at the International Bureau (...), the protection of the mark in each of the contracting countries concerned shall be the same as if the mark had been filed therein direct*"⁶⁴. Further, the Protocol retrieves identical provisions⁶⁵. We interpret this provision as meaning that the application filed at national level will have either attributive or declarative value, depending on the protection system applied by the signatory State.

We also mention, without going into details, that the Singapore Treaty on the Law of Trademarks, from March 13-31, 2006, ratified by Romania through Law no. 360/2007 and the related regulations, and the Trademark Law Treaty, adopted at Geneva on October 27 1994, to which Romania adhered through the Law no. 4/1998 – Official Bulletin no. 10/1998 contain, among others, provisions relating to the registration procedure before the national offices.

The TRIPS Agreement contains provision regarding the registration of a trademark and use of

⁶¹ Art. 4 of the Convention on the Protection of Industrial Property of March 20, 1883, Paris, as revised and modified, ratified by Romania through Decree nr. 1.177/1968, published in the Official Gazette no. 1 of January 6, 1969 from Paris regarding the Protection of Industrial Property of March 20, 1883.

⁶² *Idem*.

⁶³ Art. 6 sexies, *idem*.

⁶⁴ Art. 4 para. (1) of the Madrid Agreement Concerning the International Registration of Marks, in the form revised at Stockholm at July 14, 1967, ratified by Romania through Decree no.1176 of December 28, 1968 – Official Bulletin no.1/06.01.1969.

⁶⁵ Art. 4 para. (1) letter a) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on June 27, 1989, ratified by Romania through Law 5/1998 – Official Bulletin no.11/15.01.1998.

the mark in the context of its registration, without reference to the possibility of obtaining protection through the use and covers only the rights acquired by the owner through registration. It is also stipulated that this agreement does not prevent the signatory states to provide that protection may also be obtained through use⁶⁶.

Taking all the above into consideration, it is clear that the international agreements encourage the application of the attributive system and especially the filing of trademark applications, probably due to the increased legal security such a certain filing date provides. However, the treaties do not exclude that member states to provide for the possibility of obtaining protection through use, either implicitly or explicitly. However, such a possibility is rather discouraged, by not being regulated internationally and in some cases not even mentioned.

Conclusions

As can be seen from the above, "use" is a notion whose meaning must be interpreted according to the legal consequences are assigned thereof in different national legislations.

Thus, use of a trademark may be creating rights in the declarative systems, the further use thereof representing the consolidation of the acquired right. Also, in the attributive system, use has mainly the purpose of preserving the right acquired through registration, but can also be rights constitutive when intensive use of an unregistered trademark determines its well-known status.

In the doctrine was outlined, as an essential function of the use of a trademark, guaranteeing the identity of the origin of the goods or services bearing that trademark, by the end consumer, allowing him, without any likelihood of confusion, to distinguish those goods or services from those of other traders⁶⁷. Thus, use is the one that allows the creation of the components of distinctiveness - product / service, trademark, consumer.

Also, closely linked to the notion of "using" are the notions of "non-use" and "effective use" of a trademark.

For example, the Trademarks Law considers actual use of a trademark "*use of the trademark in a*

form that differs in certain respects from that of the registered trademark, but which does not impair its distinctive character"⁶⁸. Consequently, the way a certain trademark is used is also analyzed, given that, due to certain limitations in practice (the trademark arrangement in promotional materials, on packaging, etc.), it can be used differently from the way it was registered.

Finally, it can be concluded that, irrespective of the protection system in question, not allowing unused trademarks is mainly essential, from an administrative standpoint to not overcrowd registers with trademarks that are not actually used, and economically for not preventing other market participants to use the mark if they wanted⁶⁹.

It is also interesting to analyze the value of the trademark application in each jurisdiction separately, which can have both attribute value or a simple right advertising value. In this context, it can also be concluded that the international treaties to which Romania is a party, although encourages the applicability of the attributive system and, in particular, filing trademark application at national level, does not prohibit the existence of a system where protection is given by use. However, such a possibility is not regulated in detail.

Regarding the different trademark protection systems, some authors consider that differentiating them is a rather theoretical concern, both the use and registration of a trademark playing different roles depending on the laws of each state⁷⁰.

Indeed, we believe that the use and the act of registration are indispensable to any trademark protection system, in different doses and with different legal consequences depending on the context of each jurisdiction separately. As a general trend, if indeed registration really has begun to play an increasingly prominent role in acquiring the trademark right, particularly due to the efforts to harmonize jurisdictions and due to international conventions that provide preference to the registration priority system, use starts to have an increasingly important role for the conservation of rights⁷¹.

Thus, we believe that an increased attention should be given to a more detailed regulation of the possibility of obtaining rights through use, being a system closer to the commercial dynamism that characterizes contemporary society.

⁶⁶ Art. 16 Section 2 from Annex 1C of the Marrakech Agreement establishing the World Trade Organization - Annex 1C. Agreement regarding Trade Related Aspects of Intellectual Property Rights signed at Marrakech on April 15, 1994, ratified by Romania on December 22, 1994 through Law no.133/1994 – Official Bulletin no.360/27.12.1994.

⁶⁷ Jeremy Phillips, Ilanah Simon, Trade Mark Use, Oxford University Press, New York, 2005, p.5.

⁶⁸ Art. 46 para. (2) letter a) of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014.

⁶⁹ Jeremy Phillips, Ilanah Simon, *op. cit.*, page 14.

⁷⁰ Yolanda Eminescu, *op. cit.*, page 113.

⁷¹ *Idem*.

References:

- Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *Dreptul Proprietății Intellectuale. Dreptul Proprietății Industriale. Mărcile și indicațiile geografice*, All Beck Publishing, Bucharest;
- Ioan Macovei, *Tratat de drept al proprietății intelectuale*, C.H. Beck Publishing, Bucharest, 2010;
- Florea Bujorel, *Dreptul Proprietății Intellectuale - Dreptul de proprietate industrială*, Fundației România de Măine Publishing, Bucharest;
- Yolanda Eminescu, *Regimul juridic al mărcilor*, Lumina Lex Publishing, Bucharest, 1996;
- Law no. 28 of December 29, 1967 regarding factory, trade and service marks published in the Official Bulletin no. 114 of December 29, 1967;
- Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014;
- Government Decision 1134/2010 for aproving the Implementing Regulation of Law no. 84/1998 regarding Trademarks and Geographical Indications, published in the Official Gazette number 809 from December 03, 2010;
- Law no. 38 / 2008 regarding trademark protection, Republic of Moldova;
- <http://www.wipo.int/edocs/lexdocs/laws/mo/md/md071mo.pdf>;
- Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, published in the Official Journal of the European Union of November 08, 2008;
- Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 to approximate the laws of the Member States relating to trademarks, published in the Official Journal of the European Union of December 23, 2015;
- Decision of the Board of Appeal of the State Office for Inventions and Trademarks no. 107 of April 03, 2014 in the file CCM 144/2013;
- EUIPO Decision no. B 1 437 377 of September 14, 2010;
- http://www.osim.ro/marci/ro_common_communication2_cp5.pdf;
- Mihai Andrei Enache, *Metamorfoza unei mărci. Distinctivitatea dobândită*, Revista Română de Proprietate Industrială;
- Convention on the Protection of Industrial Property of March 20, 1883, Paris, as revised and modified, ratified by Romania through Decree nr. 1.177/1968, published in the Official Gazette no. 1 of January 6, 1969 from Paris regarding the Protection of Industrial Property of March 20, 1883;
- Italian Industrial Property Code (legislative decree no. 30 of February 10, 2005), modified in 2012;
- Italian Civil Code (approved through the Royal Decree no. 262 of March 16, 1942), modified in 2012;
- Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark published in the OJ L 78 of March 24, 2009;
- Decision of July 5, 2011 in the matter C-263/09P, European Union Court of Justice, para. 50;
- UK Trade Marks Act 1994;
- <http://www.worldtrademarkreview.com/Magazine/Issue/42/Country-correspondents/United-Kingdom-Edwards-Wildman-Palmer-LLP>;
- <http://ip-active.com/trademarks/unregistered-trademarks.php>;
- Swiss Federal Law on trademark protection and geographical indications of August 28, 1992;
- Madrid Agreement Concerning the International Registration of Marks, in the form revised at Stockholm at July 14, 1967, ratified by Romania through Decree no.1176 of December 28, 1968 – Official Bulletin no.1/06.01.1969;
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on June 27, 1989, ratified by Romania through Law 5/1998 – Official Bulletin no.11/15.01.1998.
- Annex 1C of the Marrakech Agreement establishing the World Trade Organization - Annex 1C. Agreement regarding Trade Related Aspects of Intellectual Property Rights signed at Marrakech on April 15, 1994, ratified by Romania on December 22, 1994 through Law no.133/1994 – Official Bulletin no.360/27.12.1994;
- Jeremy Phillips, Ilanah Simon, *Trade Mark Use*, Oxford University Press, New York, 2005.