

Romania: What is genuine use?

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A couple of decisions of the Supreme Court referring to the question of genuine use were published in June 2012. These decisions are important because they give practitioners guidance as to what is to be considered genuine use as well as on other issues directly related to cancellation actions for non-use.

Time Out

The first decision was rendered in a cancellation action brought forward by Time Out Group (TOG) against the Romanian national television company (SRT). The cancellation action was filed against the trademark Time Out, registered by SRT for television programmes in Class 38. There were two issues of importance in this case.

First, SRT raised a procedural exception claiming that TOG had no legitimate interest in pursuing the cancellation of its trademark for television programmes. SRT claimed that TOG was not authorised to broadcast television programmes and further, that it did not have the technical capabilities to produce television programmes. TOG replied, claiming that its legitimate interest resides in a trademark application, which was liable to be rejected based on SRT's prior rights. The court sustained TOG's position and showed that the filing of a trademark application was sufficient to prove legitimate interest. It was not considered relevant for these proceedings whether the plaintiff had the necessary authorisations or technical capabilities to use the trademark for the goods or services covered by the application.

Second, the court approached the question of effective use. SRT provided evidence as to the use of its trademark Time Out for television programmes. The evidence (video records) pertained to the use of the trademark to denominate a section of a sports television show. The court found that the way the trademark was used did not tell viewers that they were watching a different television programme. The court considered that the use of the trademark was not undertaken in such a manner as to differentiate in the mind of the consumers between different programmes produced by the right holder. Therefore, the court found that this use could not be considered effective use of the trademark. The finding that the use was sporadic constituted another reason to conclude that there was not an effective trademark use.

This decision shows that even the use of a trademark in a very public and easy to prove manner (such as during a broadcast on national television) does not guarantee success in cancellation proceedings if the use does not fulfil the conditions set forth by the legal text.

Total

A cancellation action was brought forward by GSK against Total SA's trademark Total covering, *inter alia*, Class 3.

Total's defence was based on the fact that it had entered a licence agreement with Colgate Palmolive by which the licensee was given the right to use the trademark Total for products in Class 3.

The court found that the use by Colgate of the trademark Total could not be considered as effective use on the following arguments:

- Colgate Palmolive was in turn the owner of several trademarks, including Colgate Total registered for goods in Class 3. All the evidence of use pertained to the use of the trademark Total together with the trademark Colgate. The court decided that the element Colgate was the dominant element of the trademark used.
- The evidence pertained to the use of the combined trademark Colgate Total with a figurative element, which presented significant differences from the figurative element of the registered GSK trademark. Also the figurative element was depicted in different colours from the colours claimed by the trademark registration. These elements, combined with what the court considered a rather weak distinctive character of the word element Total, led the court to consider that the use of the trademark was done in a form significantly different from the registered one.

This decision of the Supreme Court appears to be consistent with the conclusions of the Court of Justice of the EU in the *Fruit of the Loom* case, in which the court decided the use of a registered trademark does not constitute at the same time the use of another registered trademark containing only one element of the first trademark, as long as this element is not the dominant element of the trademark.

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