

On accession, Community trademarks will be extended to the Romanian territory



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Romania's accession to the European Union will also have consequences as far as the protection of nationally registered trademarks is concerned. Under the accession rules, Community trademarks filed for registration before the date of accession (irrespective of whether they have been registered or not), shall automatically enjoy protection within the territory of Romania. This mechanism operates de jure, without the need of the holder to fulfill any formalities or procedures carried out by OSIM that might show a conflict with a domestic trademark. For this reason, it is interesting to note that the trademark owner who felt safe as a holder of a registration certificate issued by OSIM may suddenly see his portfolio threatened by the "invasion" of Community trademarks automatically protected within the territory of Romania.

Thus, on accession to the EU, a domestic producer that has not previously exported his trademark to the EU area, and, therefore, was not in direct competition with the same or other similar trademarks registered in other Member States, may have to deal with (as part of the unique market) competing products bearing identical or similar EC-protected trademarks on the Romanian market. Based on national law, the conflict would be solved in favour of the holder who was the first to register its right, and who could also ask for the cancellation of the subsequently registered trademark in court.

Based on the accession rules negotiated by Romania and the European Union, the holder of a national trademark previously registered in good faith would be allowed to oppose the use of the Community trademark on Romanian territory. The action may be filed before the competent Romanian courts of law in accordance with the provisions of Regulation 40/1994 on the Community trademark.

Although it ensures a certain level of protection for the domestic holder on the basis of his priority rights acquired by national registration, this conflict-solving rule does not however allow the exercise of other legal instruments specific to the trademark right, respectively the action for trademark annulment or withdrawal. This is because the automatic extension of protection is not reciprocal, in the sense that national trademarks do not automatically benefit from protection in the Member States. Since they are not acknowledged at EC level, holders of national trademarks cannot substantiate an annulment action or withdrawal of rights for lack of use against a subsequently registered Community trademark owner.

Conversely, the holder of a previously registered Community trademark or of previously acquired rights may ask the competent law court to annul the national trademark or to withdraw the rights such a trademark has.

Thus, a domestic trademark registered today can successfully oppose the use of a subsequently registered Community trademark on Romanian territory, but the domestic holder cannot request the annulment of the latter. This deprives the national holder of the actual possibility of banning the trademark use by third parties on the EU market and also prevents him from penetrating

the market with his own products bearing the same brand. At the same time, the Community trademark previously registered could successfully oppose the use of the national brand across the entire EC market, and it may also substantiate the annulment of the latter, having as a consequence the "elimination" of the trademark on the Romanian market too, a place where it had hitherto enjoyed protection prior to EU accession.

Therefore, the undertakings that were understood to protect their trademarks at the national level only bear the risk of annulment by the intervention of a previously registered Community trademark. This uncertainty requires any diligent holder to take two courses of action: 1) find out if there are similar Community trademarks that could possibly conflict with his own brands after the accession date and, 2) initiate, for his domestic trademarks, the EC registration proceedings before the Office for the Harmonization in the Internal Market.

Within the context of EU enlargement, the Member States are understood to have given priority to the "already acquired" rights of the Community trademarks.

The domestic registration will only ensure protection on the Romanian territory to those companies that had the insight to protect their market symbols with OSIM before any initiative of the competing companies had been conducted at the EU level. In the absence of such protection, the domestic holders may either have to "buy back" their own trademarks from owners of previous Community rights, or see their marketing efforts and brand building investment wasted, following potential annulment procedures initiated by such Community trademarks' holders. ■