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**PhD THESIS**

**PROTECTION OF UNREGISTERED TRADEMARKS AT EUROPEAN  
UNION LEVEL**

**SUMMARY**

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Traditionally, trademarks are protected either by means of registration or as a result of their use. In practice, national trademark protection systems give preference to one of the ways of acquiring trademark rights, and on this basis the doctrine has classified them in attributive protection systems, where the priority to registration prevails, and declarative protection systems, where the priority belongs to the first person who used a trademark, and trademark registration has only a declarative role.

The attributive trademark protection systems, that are based on the first-to-file principle, are in the dominant worldwide and, even in first-to-use jurisdictions, trademark registration is of significant importance.

However, the two systems should not be regarded dichotomically. In this sense, one of the main common elements of the two trademark protection systems is the concept of “use”: while in the declarative system it is determinant in acquiring and maintaining trademark protection, it is also of great importance in the attributive systems in terms of maintaining the trademark rights.

This being said, the attributive trademark protection system wasn’t always dominant. Back in the 19th Century, unregistered trademarks enjoyed strong protection. For example, the French law of 1857 established that the trademark right is acquired both through use and registration. For an owner to oppose a registered trademark, proof of prior possession must have been provided.

However, although, historically, the first trademark protection systems where mainly declarative, in time most jurisdictions evolved to attributive trademark protection systems.

The past century was characterised by an accelerated globalisation of economic relations. This inevitably led to the need to harmonize trademark legislation and practices among the world. In this context, an in-depth analysis of the most relevant international treaties on trademark protection show that the harmonisation efforts have mainly focused on trademark registration procedures and on a strong implementation of the attributive system, thus creating a shift thereto, while still allowing jurisdictions to protect their trademark through use.

The preference for the attributive trademark protection system in EU jurisdictions can also find its explanation in the evolution of the trademark functions and their economic. That said, one of the most important qualities of trademarks is that they carry information, which allows consumers to make their own commercial choices. This attribute determines the main functions of trademarks: the function of determining the commercial origin of the goods or services offered under the trademarks, the function of advertising them, the

function of quality assurance or the reputation function. Over time, however, the focus of trademark protection has shifted from the interest of protecting consumers against the likelihood of confusion, including association, in the market, to that of protecting trademark owners against dilution and impairment of the economic importance of the trademarks in their own portfolio. This conclusion is relevant to the research, because this paradigm shift has influenced the preference for an attributive system of trademark protection, to the detriment of a declarative system, based on their simple use.

For the above reasons, the main international treaties regarding trademarks encourage signatory states to adopt an attributive trademark protection system, and especially the establishment of deposits at the national level, due to the increased legal security provided by the application date. Another reason for this is that the attributive system is more apt to respond to trade that is increasingly taking on cross-border valences. However, treaties do not exclude the possibility that the member states provide for the possibility of obtaining protection through use.

There is, however, one notable exception, and that is the protection of well-known trademarks. Their protection is regulated in detail by both the Paris Convention and the TRIPS Agreement. But even if well-known marks represent in modern law a reminiscence of the declarative system of trademark protection, there is an essential difference between their protection and the protection of trademarks in the declarative system. The basis of the protection of well-known marks is their degree of knowledge, and their use in the jurisdiction in which the protection is invoked is not necessary.

At European Union level, the legislation imposed the attributive system of protection, and imposed priority through registration as the main way to obtain protection. The applicable directives were limited to allowing Member States to continue to protect unregistered trademarks, if their legislation regulates this mode of protection.

That said, in some Member States (and former members) of the European Union unregistered trademarks still enjoy different levels of protection. However, as I have developed extensively in this research, their role is not uniform and harmonized, which creates practical difficulties at the level of the European trademark protection system.

In this context, the main research questions are the following:

*Do unregistered trademarks enjoy protection at the level of the European Union? If the answer is yes, what role do they fulfil?*

*Should the protection of unregistered trademarks be harmonized in more detail at European Union level?*

It is important to note from the very beginning that the main angle of this research is the potential protection of unregistered trademarks (and harmonisation thereof) as an exclusive right. I make this distinction because, as I have developed in the thesis, unregistered trademarks may also enjoy protection through other means, such as protection against unfair competition, which follows a different perspective, namely that of the fair conduct in commercial relationships.

The aim of this research is to show that protection of unregistered trademarks is not obsolete and, in fact, they may well coexist with registered trademarks in modern protection systems. The main argument to this end is their coexistence with the registration system in several European Union jurisdictions. Protection of unregistered trademarks have a strong historical tradition, and the dynamics of today's economy may justify a harmonised protection thereof, considering the need not to delay putting goods / services on the market.

Although the protection of trademarks through registration has significant advantages considering the legal certainty they provide, protection of unregistered trademarks has the merit to offer a protection that is equal to the actual use of a trademark on the market. Thus, a harmonised protection for used unregistered trademarks could be a possible solution that would fit today's economics. Moreover, protecting unregistered trademarks may come closer to the initial and fundamental trademark role, that of origin indicator. On the contrary, as I show in this thesis, registered trademarks are increasingly protected against dilution.

Specifically to the European Union context, there are still jurisdictions where unregistered trademarks are protected, mostly by means of unfair competition, but also as exclusive rights. However, conditions of protection differ from one jurisdiction to another (thus, building legal insecurity to trademark owners). As I have shown in the research, the different levels of protection of unregistered trademarks among Member States create difficulties both for EU bodies assessing trademark conflicts, as well as for practitioners that assist their clients in matters involving unregistered trademarks. Therefore, in order to mitigate possible inconvenience from different protection systems in EU jurisdictions, based on the consolidated case-law referring to opposing unregistered marks against new European Union trademark applications and registrations and on the experience of states that already have a long tradition of protecting unregistered trademarks, at least a minimal harmonization of the

protection of unregistered trademarks among EU jurisdictions is not only possible, but may also be advisable. Undoubtedly, a harmonised protection of unregistered trademarks would confer a higher predictability to trademark owners on the common market, that would not be taken by surprise by different protection standards in each Member State.

That being said, in order to reach the conclusions of this research, I followed the steps that I will describe below, starting from the researched topics and the preliminary conclusions of each chapter.

The purpose of the **first section** is to define the concept of trademark, to describe the means of acquiring trademark rights and to make an in-depth analysis of the trademark functions and roles. It consists of chapters 1, 2 and 3.

**In the first chapter** I tackle the definition of trademarks, and approach the trademark protection conditions by means of analysing the non-traditional trademarks. The trademark protection conditions are essential and, notably, distinctiveness, is a prerequisite for the protection of unregistered trademarks. The choice of non-traditional trademarks as standard for evidencing the conditions of trademark protection is justified by the fact that, on one hand, non-traditional trademarks are those who stretch these conditions to their limits and, on the other hand, new evolutions of trademark protection led to the appearance of new trademark types (such as multimedia trademarks), and a possible discussion on harmonization of trademarks law should take into consideration these evolutions.

The conclusions of this chapter are as follows:

Both registered and unregistered trademark must comply the same protection conditions, adapted to their specific manner of obtaining protection. Unregistered signs, to be protected as trademarks, must enjoy distinctive characters. Another condition for trademark protection used to be that signs must be able to be represented graphically. This condition evolved in time, and today any sign that may be represented in a manner that permits the public to determine the trademark's scope of protection may be considered a trademark, if distinctive. However, this condition of trademark representation, which is more related to the limitations of trademark registers in the attributive system of protection, can be translated into the declarative system of protection by the ability of the owner, who issues claims regarding a certain right, to indicate precisely and clearly what the elements that the respective mark consist of. The relevance to this thesis of these conclusions is that, inevitably, this evolution also affects the protection of unregistered trademarks, that may in turn consist of sound, images or combinations thereof, such as the multimedia trademarks.

**In the second chapter** I describe each trademark protection system – the declarative and the attributive systems, through a detailed analysis and comparison thereof. As an essential concept in both the declarative system and attributive system, the role of use in trademark protection is analysed in terms of acquiring and maintaining protection, and of non-use with respect to losing protection. As part of describing first-to-file systems, I make an in-depth analysis of the role of trademark offices and trademark certificates, since the first has a great role in granting protection, whereas the second represent protection titles. The legal nature of trademark rights is also an important part of this chapter, as the qualification of the trademark rights as property rights may have influenced a preference for registered trademarks in the detriment of unregistered rights. Analysis of unfair competition is also an important element of this chapter, being one of today's most vigorous mean of protection for unregistered trademarks. Its analysis is important in order to create a close-to-complete picture regarding protection of unregistered trademarks, and also to point out that, from this perspective, first steps have been undertaken towards harmonisation at EU level.

The conclusions of this chapter are as follows:

The analysis of the attributive and declarative trademark protection systems, starting from their characteristics, how to obtain trademark protection in both systems, as well as the advantages and disadvantages of each protection system, aims to show the characteristics thereof. A particular conclusion of this analysis is that the attributive system may be regarded as a special application of the declarative system, showing how the first evolved from the latter.

One of the main liaisons between the two trademark protection systems is the concept of "use". While in the declarative system trademark use is determinant in acquiring and maintaining trademark protection, it is also of great importance in the attributive systems. A conclusion with relevance to this thesis is that the legal provisions relating to trademark use, in the attributive system, are meant to diminish the disadvantages of the formalist nature of this protection system, for example, by releasing registries of unused trademarks or by limiting their opposability.

The comparison of the two trademark protection systems is completed by the description of three elements with importance in both trademark protection systems. The national and regional trademark offices is one of the elements and the protection title – also known as registration certificate – exist both in the declarative and attributive protection systems. Another element is the Nice Classification, a legal instrument that facilitates the choice, by trademark owners, of those goods and services for which their trademark will be registered.

With relevance to this thesis are the conclusions deriving from the analysis of the current European practice, which seems to encourage owners to choose more strictly the goods and services for which they seek protection, more closely to the actual use of the trademark on the market. This practice brings the protection of registered trademarks closer to the protection of unregistered trademarks, where the scope of trademark protection is defined by the actual use of the trademark on the market, which is a relevant point in this research.

For the purpose of this research, the analysis of unfair competition serves to describe one of today's means of protection for unregistered trademarks. However, the protection is not aimed at protecting trademark rights per se, its purpose being to protect fair commercial relationships. Protection of unregistered trademarks may be circumscribed to this wide protection range, with the comment that it is still under debate if protection against unfair competition serves the interests of traders, of consumers or of both.

**The third chapter** is dedicated to the analysis of the role of unregistered trademarks in the trademark protection systems' map, and to outline how the scope of protection and the role of a trademark evolved once with the preference for registered trademarks. The chapter starts with a discussion on the main trademark functions, including from the perspective of the EU case-law, which is useful in order to observe their evolution. The analysis is aimed to determine if a greater attention to the advertising function of trademarks has led to a stronger protection against dilution, in detriment of confusion, and of the trademark owners, instead of the consumers. This discussion is strictly linked to the sub-chapter referring to the economic value of trademarks, which significantly contributed to these changes. Finally, a brief historical overview of trademark protection in Europe and in Romania, specifically, is aimed to briefly show the way modern protection systems evolved from first-to-use to first to-file-systems.

The conclusions of this chapter are as follows:

In order to determine why is there today a preference for the attributive trademark protection system in UE jurisdictions, I analysed the trademark functions and their economic. That said, one of the most important qualities of trademarks is that they carry information, which allows consumers to make their own commercial choices. This attribute determines the main functions of trademarks: the function of determining the commercial origin of the goods or services offered under the trademarks, the function of advertising them, the function of quality assurance or the reputation function. Over time, however, the focus of trademark protection has shifted from the interest of protecting

consumers against the likelihood of confusion, including association, in the market, to that of protecting trademark owners against dilution and impairment of the economic importance of the trademarks from their own portfolio. This conclusion is relevant to the research, because this paradigm shift has influenced the preference for an attributive system of trademarks protection, to the detriment of a declarative system, based on their simple use.

The preference for the attributive system is also determined by the increase in the economic value of trademarks over time. From this perspective, I have shown that the economic value of a trademark is greater when it enjoys solid protection, through registration, than when the right to a trademark is established through use. However, the intrinsic value of unregistered marks, given the trust gained in the market before consumers, should not be neglected.

The evolution described above is also confirmed by the historical description of trademark protection. I have shown that the signs used in commerce began to approach their modern perception, and the consumer began to be an important actor starting with the French Revolution, when trademarks became the interface between producer and consumer, gaining economic value. This fact led to the emergence of stable trademark protection mechanisms.

**The second section** is dedicated to the analysis of the way unregistered trademarks are regulated at international and national level, from the perspective of acquiring trademark rights, following three pillars: the most relevant international treaties, the European Union legislation and the national level, through the analysis of the legislation and practice of a selection of European jurisdictions. It consists of Chapters 4, 5 and 6.

**In the fourth chapter**, I make a review of the provisions regarding unregistered trademarks in the Paris Convention, The Madrid Agreement / Protocol, and TRIPS Agreement, with a special emphasis on the protection of well-known trademarks. In this chapter I research the way unregistered trademarks are regulated in international conventions, with the intention to set the bigger context of the way trademark protection systems are provided for at international level. The Paris Convention and the TRIPS Agreement are particularly relevant with respect to protection of well-known trademarks. The Madrid Agreement and Protocol establish an international trademark protection system which is based on the first to file system. All these aspects are analysed in detail in order to find an explanation for today's approach of trademark protection systems to unregistered trademarks, including offering a larger frame for further debating the protection of unregistered trademarks within the EU.

The conclusions of this chapter are as follows:



The analysis of the provisions of the main international treaties regarding trademarks aim to show that generally they encourage signatory states to adopt an attributive trademark protection system, and especially the establishment of deposits at the national level, due to the increased legal security provided by the application date. Another reason for this is that the attributive system is more apt to respond to trade that is increasingly taking on cross-border valences. However, treaties do not exclude the possibility that the Member States provide for the possibility of obtaining protection through use. The relevance of these findings for the present research is that protection of unregistered trademarks is rather discouraged, not being regulated at the international level and in some cases not even mentioned.

The pillar of international unregistered trademark protection regulations is the enshrinement of well-known trademark protection. Their protection is regulated in detail by both the Paris Convention and the TRIPS Agreement. But even if well-known marks represent in modern law a reminiscence of the declarative system of trademark protection, there is an essential difference between their protection and the protection of trademarks in the declarative system. The basis of the protection of well-known marks is their degree of knowledge, and their use in the jurisdiction in which the protection is invoked is not a prerequisite.

In **the fifth chapter** I described the way unregistered trademarks are regulated in EU law, by virtue of the applicable trademark Regulation, Directive and case-law, with a detailed analysis of the applicability of articles 8 (4) and 8 (3) letter c) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark. In this chapter I also analyze well-known trademarks from the perspective of EU jurisprudence, which represent one of the main reminiscences of the declarative trademark protection system. This analysis is followed by a comparison with the protection offered by trademarks that enjoy reputation, considering that they represent neighbouring legal concepts.

The conclusions of this chapter are as follows:

The next conclusions of the thesis relate to the protection of unregistered trademarks at European Union level. The European legislation imposed the attributive system of protection, and the priority through registration as the main way to obtain protection in respect of trademarks. The applicable directives were limited to allowing Member States to continue to protect unregistered trademarks, if their legislation regulates this mode of protection. These findings

are important do determine the current level of protection enshrined by the European legislation in connection to unregistered trademarks.

The most important provision regarding the protection of unregistered trademarks is that of Art. 8 para. (4) of the European Union Trademark Regulation, which allows the opposition of unregistered trademarks to the registration of European Union trademarks. However, this opposability has been "constrained" by the imposition of a European standard that imposes a minimum level of trademark use as a mandatory condition for opposability.

Last but not least, the only way to protect unregistered trademarks regulated in the European Union continues to be the protection of well-known trademarks.

**In the sixth chapter** I analyse the protection of unregistered trademarks in different European Union jurisdictions. The only exception is the United Kingdom which, although it leaved the EU while writing this thesis, was kept as representative for other jurisdictions in the EU where unregistered trademarks are protected by means of *passing off* (such as Ireland, for example). The analysis is structured based on different levels of protection awarded by national legislations to unregistered trademarks. The first level of protection is the represented by the Scandinavian model, the analysed jurisdictions being The Kingdom of Denmark, The Kingdom of Sweden and the Republic of Finland. The second level of protection of unregistered is represented by Italy, where the protection of unregistered trademarks is rather defensive. The third level of protection is represented by jurisdictions where unregistered trademarks are protected through passing off, where I analysed the United Kingdom as a representative jurisdiction. The fourth level of protection is represented by jurisdictions like The Hellenic Republic, Latvia and Bulgaria, where the protection of unregistered trademarks present certain particularities. The fifth level is represented by jurisdictions where the level of protection for unregistered trademarks is minimal, Romania being one of these jurisdictions. Lastly, the conclusions were drawn after conducting surveys with a selection of practitioners, in connection to the level of protection of unregistered trademarks in their jurisdictions and to a possible harmonization in connection to unregistered trademarks.

The conclusions of this chapter are as follows:

The analysis of some Member States (and former members) of the European Union, where unregistered trademarks still enjoy different levels of protection, aims to determine whether their legislation could represent a good model for a future unitary regulation of unregistered trademarks at European

level. The jurisdictions were analysed from the perspective of the applicable national local provisions, of the relevant case-law and through the lenses of a selection of local trademark professionals, who offered their input concerning the protection of unregistered trademarks in their jurisdiction. This analysis aimed to determine the level of protection of unregistered trademarks at national level, through the example offered by a selection of representative jurisdictions. Furthermore, the purpose of the analysis was to determine whether any of the models offered by these jurisdictions could represent a suitable model for harmonisation of the protection of unregistered trademarks at European Union level. This study shows that protection of unregistered trademarks in the Member States of the European Union is heterogenous. The differences in the level of protection mostly come from lack of harmonisation and from differences deriving from local legal and economical specificities.

**In the final conclusions**, I point out once again that the purpose of this research is to determine the level of harmonization of Member States' legislation regarding the protection of unregistered trademarks as exclusive rights. Therefore, the level of harmonization of European legislation regarding the fight against unfair competition, although it is relevant in relation to the protection of unregistered trademarks in general, as I have shown in the sub-chapter dedicated to this institution, is not the central point of this thesis.

There is a minimum level of protection of unregistered trademarks at the level of the European Union, which manifests itself on two levels: on the one hand, Member States maintain their freedom to protect such signs at national level. On the other hand, as a direct consequence, the only detailed regulation regarding the protection of unregistered trademarks consists in regulating the possibility of opposing such rights, under the conditions detailed in the research, to the registration of European Union trademarks. Therefore, although there is no concept of unregistered European trademarks, while their existence is accepted at national level.

As such, what is the role of unregistered trademarks in this context? The Regulation and the Directive are clear in this regard. Unregistered trademarks are considered only from the perspective of their relation with registered trademarks. Therefore, the role of unregistered trademarks, according to the European legislation, is limited to assessing the availability of new European trademarks on the market.

At national level, from the research undertaken at the level of national jurisdictions where the protection of unregistered trademarks is still at different levels, I conclude that their existence is based on long legal traditions and a more

or less consolidated practice of local authorities. The role of unregistered trademarks has different nuances depending on the jurisdiction where they are protected. For example, in Scandinavian countries their main purpose is to prevent the registration of trademarks that are identical or similar. In jurisdictions where *passing off* is available, this remedy prevents third parties to use a trademark which bears *goodwill* in situations where such use leads to misrepresentations to consumers. In Italy, protection of unregistered trademarks is rather a defensive mechanism which allows their holder to continue their use. In other words, their role is not uniform and harmonised. In most cases, however, a common trait could be observed, namely that in almost all cases unregistered trademarks are protected to the extent that they enjoy a certain degree of knowledge on the market. It is therefore a protection that is akin to a protection of *goodwill*, even if it is not provided as such in the local legislation.

From the perspective of roles played by unregistered trademarks, other findings of this thesis are of particular relevance. Trademarks protected as a result of their use are, in my opinion, those that come closest to the primary role of trademarks, namely that of indicating the commercial origin of the designated goods and services. This comes naturally, because the foundations of the protection of unregistered trademarks is their use on the market, thus the direct contact between them and consumers. For example, in jurisdictions such as the Kingdom of Denmark, the Kingdom of Sweden and the Republic of Finland, unregistered trademarks are protected to the extent that they are recognized by the intended public segment. In other words, to the extent that the consumer public sees in these signs an indication of the commercial origin of the designated goods and services. In the case of registered trademarks, on the other hand, over time, a more pronounced protection of trademark owners and the economic value of these trademarks has taken shape, as opposed to signs protected as a result of their use, which have as their reason for protection precisely their existence on the market and their use in a manner that indicates a certain commercial origin of the designated products and services. As such, a use congruent with the primary role and function of the marks is protected.

**With respect to the means of a possible harmonization**, as shown in Chapter 4 of this research, harmonisation is achieved at European Union level by through Regulations and Directives.

The Regulation is aimed to creating a unitary trademark protection system, in parallel to the already existing national protection systems of the Member States. For this reason, the Regulation on the European Union trade mark focused on establishing a single trademark, valid in the entire Union. In

this context, protection of unregistered trademarks, valid in the entire Union, by means of a Regulation, is hard to envisage.

Although the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs could represent a precedent, providing for the short-term protection of unregistered designs, this type of protection may be appropriate for some goods that find themselves for a brief period of time on the market, so that their registration may not be needed, or for those goods that are only tested before their owner decides to register the design. These reasonings are not, however, applicable to trademarks, which have a different scope of protection.

Considering the above, the example of the protection of unregistered designs is difficult to be seen as a suitable example for the protection of unregistered trademarks. Firstly, protection of designs, be them registered or unregistered, is limited in time, by their nature. This is not the case for trademarks, which have the vocation to have unlimited protection in time, if the trademark owner continues their use (in the declarative system) or undertakes the renewal formalities (in the attributive system). From this perspective, in my opinion, the protection of unregistered trademarks valid in the entire European Union, for a limited period of time, is not congruent with the nature of trademark protection itself. Another angle to analyse a potential provision would be to grant trademark owners a limited grace-period of protection based on use, before consolidating the trademark protection through registration. This perspective may not be appropriate either since, in my opinion, such an approach would create legal uncertainty regarding the trademarks that are actually valid at a certain point in time.

The upcoming reform highlights, however, an important observation. When it comes to unregistered designs, the Commission found that their protection at national level would not be appropriate, because their protection is already provided for at EU level, and a parallel protection thereof is both redundant and could generate difficulties, if the protection proves to be divergent. Moving the discussion back to the subject matter of the thesis, this research have shown that unregistered trademarks are now protected differently in Member States. Thus, we agree that an inevitably divergent protection of unregistered trademarks at EU level would indeed create multiple practical difficulties. To conclude, a potential protection of unregistered trademarks by means of a Regulation seems rather unlikely.

On the other hand, Directives are aimed to harmonise the legislations of the Member States. The current Trade Mark Directive only allows Member States to protect trademarks through use, but does not harmonise this protection

in any way. At this moment, as shown in the previous chapter of this thesis, the protection of unregistered trademarks is already present, in different forms, in Member States. With this in mind, if any harmonisation effort needs to be taken, it could only start from harmonising the legislations on national level. First of all, as shown above, creating a new European protection right to unregistered trademarks, while the legislations of the Member States in this regard is not yet harmonised, could lead to major inconsistencies in practice. In fact, this is also stated in the Preamble of the Trade Marks Directive, which underlines that one of the purposes of the reform is to make the Directive more consistent with the provisions of the Regulation.

The research has shown, however, that the current Directive and the past ones do not make any steps concerning the harmonisation of the protection of unregistered trademarks. This research also shows that previous Directives have focused only on those aspects of trademark protection that are of importance for the overall functioning of the internal market. It can therefore be concluded that protection of unregistered trademarks was not regarded as such, since they were not regulated. However, studies show that a greater harmonization is desirable due to the diversity of the legal conditions for the protection of trademarks at Union level, which makes it difficult, for example, to search for availability, and clutters the register with trademarks that are not so important to their owners, such as would be those marks used for a short period of time. I have also shown the opinion of the Boards of Appeal of the EUIPO, according to which the opposability of unregistered trademarks to the registration of European Union trademarks, based on the current regulations, raises great difficulties due to the different practices and legislation of the Member States. This fact also results from the opinion of the practitioners that have responded the survey.

**Concerning the second research question**, although this research shows that of the main criticisms of the declarative trademark protection system is the lack of legal certainty of market participants as to the rights valid at a given time, I believe that the effect that such unpredictability could be mitigated by the adoption of uniform rules for the protection of unregistered trademarks.

The research has shown that one of the most important aspects of having a strong protection of unregistered trademarks is a consolidated and consistent practice. Legal provisions give the instrument to protect unregistered trademarks, but very important aspects of the protection, notably the use threshold for obtaining protection, is established by case-law. It could therefore be concluded that lack of predictability may be overturn in time, by building a

consolidated practice, and taking examples from those jurisdictions where unregistered trademarks have already been protected for many years.

Moreover, as I showed in the previous chapter, the applicability of art. 8 (4) of the Regulation on the European Union trademark presupposes the applicability of two standards for examining the opposability of a right, namely a national standard, which must be demonstrated by the potential opponent, and a European standard, outlined by European jurisprudence in the matter. Or, I believe that a possible harmonization of the conditions for the opposability of unregistered trademarks at the level of the European Union would not only simplify the procedures for examining oppositions and cancellation actions, but could impose a common standard regarding the conditions for the opposability of unregistered trademarks. The EU practice and case-law with respect to the EU standard of use for the protection of unregistered trademarks is also be of help to level swiftly the practice among the Member States.

On the other hand, it is no less true that the protection of unregistered trademarks in different jurisdictions is based on a strong local tradition. In Bulgaria, a new regulation on the protection of unregistered trademarks was more likely to confuse practitioners than to provide an opportunity. On the contrary, I have shown how in other Member States of the European Union, such as Italy, the Kingdom of Denmark, the Kingdom of Sweden or the Republic of Finland, the protection of unregistered trademarks already enjoys a strong tradition, a more than consolidated practice, and an eventual harmonization of protection of unregistered trademarks could undermine these practices.

But, the interviews with professionals revealed that even in these jurisdictions, difficulties can arise as to the applicability of the conditions necessary for a holder to be able to enjoy his rights in respect of an unregistered mark. Moreover, I have shown how in the Kingdom of Denmark, a jurisdiction where unregistered marks enjoyed a strong level of protection, new regulations began to impose conditions on the use of unregistered marks in order to confer protection, I believe, as a step to get closer to the European practice in the field.

Another argument worth considering with regard to a possible reluctance to harmonize the protection of unregistered trademarks is that of the territoriality of trademark protection. As I have shown in this thesis, with regard to registered trademarks, the territorial aspect of protection is, at least in principle, clearly defined in the report with the intellectual property office where the registration takes place. As regards unregistered trademarks, the territoriality of protection is defined by the extent of use, and in certain jurisdictions, such as Italy, a certain degree of protection can also be conferred at regional level. Even this

shortcoming, however, I believe that it would be easier to manage if a common practice was outlined at the level of the European Union, as well as the establishment of common standards that can be applied in this regard.

Concluding the above, I am of the opinion that the advantages of a possible harmonization of the protection of unregistered trademarks at the level of the European Union are greater than the possible practical difficulties encountered. In this sense, the following models offered by national and European jurisprudence and practice can be considered:

- Directive no. 2015/2436 left to the discretion of the Member States the possibility to regulate the opposability of unregistered trademarks. I have also shown that in jurisdictions, such as the Scandinavian ones, the conditions regarding the use of a trademark, for them to be opposable, are less restrictive than those imposed at the level of the European Union. The consequences of such diverse regulation are as follows: an unregistered trademark can be successfully opposed to the registration of a national trademark in Finland, for example, but the same trademark cannot be opposed to the registration of an EU trademark if it does not meet the European standard of use. As a consequence, an owner can obtain a valid trademark on the territory of Finland, even if, at the national level, it could have been refused upon registration. However, such a factual situation is contrary to the principle according to which the European and national trademark protection systems are equal, without there being a prevalence of one over the other. At the same time, the use of the same unregistered trademark in Romania would most likely have no legal consequences, neither against a national trademark, nor against a European Union trademark. Also, the European standard of use of an unregistered trademark protected at national level, as a condition for the opposability of an unregistered trademark against an EU trademark, constitutes a good criterion to delimit a consolidated use of an unregistered trademark from short-term or poor use. As such, considering the fact that, in my opinion, the protection of unregistered trademarks is justified by the fact that their possible protection would keep the system of trademark protection in the paradigm of the likelihood of confusion, as well as the fact that the existence of different conditions of protection would lead towards a non-unitary and confusing practice, I consider that the protection of unregistered trademarks in the European Union, conditioned by a standard of use equivalent to the current European standard applicable in terms of art. 8 (4) of the Regulation, is pertinent.



- The protection granted in Italy to unregistered trademarks is rather a defensive one, in the sense that locally used trademarks can continue to be used by their owners, even if they are not registered and conflict with a later used trademark. Such a provision is beneficial because it targets those marks that have been used in good faith prior to the registration of a similar mark. Such a change could be a natural addition to the provisions of art. 138 of the Regulation on the European Union trade mark, according to which “*The proprietor of an earlier right which only applies to a particular locality may oppose the use of the EU trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits*”. As such, given that the protection of unregistered trademarks would be regulated at European level, and unregistered trademarks used in each jurisdiction would be protected to the extent of demonstrating a certain degree of use, it is natural that this use could continue undisturbed, as more so as art. 138 also regulates the opposability of this use against the use of a European trademark at the local level. Furthermore, art. 14(3) of the Trade Mark Directive is already a good starting point for such a change. The transposition of this article is optional to Member States, in consideration of the different level of protection awarded by them to unregistered trademarks. However, a potential balance between Member States with respect to the protection of unregistered trademarks could lead the way to transforming this type of provision of the Trade Mark Directive from an optional provision to a mandatory one.
- From the analysis of the trademark protection systems in the Kingdom of Denmark, the Kingdom of Sweden and the Republic of Finland, it follows that unregistered trademarks are opposable to the extent that a certain degree of use is demonstrated. Therefore, they already offer a similar model, to some extent, to the protection system proposed above. These jurisdictions may, however, make their own contributions to a unitary system of unregistered trademark protection. The other Member States could benefit from the experience of these jurisdictions and their rich jurisprudence in the matter, in order to build a common practice in order to strengthen a common practice. The existence of jurisdictions that have already implemented a mixed trademark protection system can only represent an advantage for a faster and more efficient harmonization of a possible European practice. Last but not least, the locally imposed conditions in the Kingdom of Denmark, the Kingdom of Sweden and the Republic of Finland could represent benchmarks for the relaxation of the European use criterion imposed for the opposability of locally protected unregistered trademarks.

Next, I will present the methodology used in the elaboration of this research:

The thesis aims to determine if unregistered trademarks enjoy protection at European Union level and, in the affirmative, which is their role and whether their protection should be harmonised within Member States.

The **analytic (doctrinal) method** is dominant in this research. It is used in order to shape the most important concepts of this research, by analysing the current legal provisions, the doctrine and extensive case-law. It is mostly used in determining historical aspects, theoretical views on trademark protection in general and unregistered trademarks in particular and in assessing the doctrine's opinion on relevant analysed legal provisions. The main limitations of this method were language barriers, that allowed me to study only doctrine in Romanian, English, French, Italian and Spanish. Also, for those jurisdictions where I could not make a direct translation of the relevant case-law due to language barriers, I used translation machines and the translations were verified by trademark practitioners from the respective jurisdictions.

In more detail, I analyse the conditions for trademark protection, which is fundamental to any discussion about trademarks. This method is also indispensable in analysing the importance of trademark use in both the declarative and the attributive trademark protection systems and the concept of "unfair competition", which is essential for the protection of unregistered trademarks. It is also used to assess the trademark functions, their economic value, the historical perspective on the protection of trademarks, as well as the relevant international, European and national legal provisions concerning the protection of unregistered trademarks.

I also use the analytic (doctrinal) method for an analysis of objective data such as trademark rankings, statistics regarding the rate of trademark registrations in the European Union (in connection to multimedia trademarks), statistics from case-law databases (from the database *DartsIP*, in connection to the rate of success of oppositions based on prior unregistered trademarks in Denmark) and financial data (such as those concerning the importance of industries that generate intellectual property rights for the EU economy).

For determining the sources, I used the following criteria: for doctrinal sources, I focused on the findings of scholars in the legal field, trying to find, as much as possible, written works from the jurisdictions of interest. For the economic assessment on trademarks, I also relied on the findings and data from scholars of the economic field. Equally relevant in this particular type of research

are legal sources, which were chosen on a territorial basis. The legal provisions analysed are those of the relevant international treaties, those enacted at EU level and those applicable in analysed jurisdictions. Where needed, I also made reference to legal provisions of other jurisdictions than EU Member States, such as, for example, the Republic of Moldova, Belarus and the Russian Federation, for showing the formalistic approach in these jurisdictions with respect to the protection of well-known trademarks. I also used information offered by trademark offices, such as information from the Guidelines available on the EUIPO website, or information provided by the Finnish Intellectual Property Office.

**The method for determining the objects to be compared** (*tertium comparationis*) aims to analyse two parallel concepts – the attributive and the declarative trademark protection systems, for a better understanding of their nature and their advantages and disadvantages. The understanding of the two concepts is critical in further determining the object of the thesis, namely unregistered trademarks, and whether their protection should be harmonised at EU level. This method was also used for a parallel analysis of the protection of unregistered trademarks in the EU, as well as in the jurisdictions analysed in Chapter 6.

A very important method of research used is **the method of comparative law**. The comparative approach aims to determine the differences between the current legislation of different jurisdictions with respect to the protection of unregistered trademarks. It also extends the horizons of the research, by analysing the protection of unregistered trademarks through the lens of trademark practitioners. To this end, the selection of legal systems and jurisdictions was crucial. Firstly, the analysis focuses on the international frame, analysing the way protection of unregistered trademarks is approached with in international treaties (as outlined above). Then, the most relevant jurisdiction is the EU, followed by a selection of EU Member States such the Republic of Finland, the Kingdom of Sweden, the Hellenic Republic and The Kingdom of Denmark (which are jurisdictions that offer extensive protection to unregistered trademarks), the Italian Republic (which has a long tradition of protecting unregistered trademarks and provides for its own model in this regard), the United Kingdom (for its specific provisions and practice with respect to the *passing off* procedure) the Hellenic Republic, the Latvian Republic and the Bulgarian Republic (which present particularities in connection to the protection of unregistered trademarks) and Romania (which is a good example of a jurisdiction where the attributive system of trademark protection prevails).

I also use **the functional – institutional method**. In the question “who does what?”, both components “who” and “what” are of particular relevance in the analysis. In order to determine how a possible harmonisation should be achieved, I analyse the European legislation in connection to trademarks in general and unregistered trademarks in particular, the competence of the EU to harmonise the legislation of the Member States in connection to trademarks, in order to conclude which is a possible means to harmonise the legislation in connection to unregistered trademarks.

Another used method is **the survey method**, among trademark practitioners (trademark attorneys, examiners). The respondents were chosen from international legal databases and rankings, aiming to reach to the most appreciated practitioners in this field, for each analysed jurisdiction. I did not conduct a survey among Romanian practitioners, although it is an analysed jurisdiction, in consideration of the fact that in Romania the protection of unregistered trademarks is minimal. The results of the surveys are useful to complete the conclusions of the research with the perception of the subject matter among relevant participants / actors. The questions in the survey were conceived to seek the respondents’ opinion on the current state of protection of unregistered trademarks in their jurisdiction, whether they believe their protection could be improved, how often do they deal with such cases and whether they believe their jurisdictions could represent a model for a future harmonisation at European Union level. Thus, due to time limitations and a limited access to contacts of trademark practitioners, the survey range – of an average of 15 respondents/jurisdiction – only permits to illustrate practical aspects of the protection of unregistered trademarks, in support of the analysed legal provisions and data. The survey questions are available in the ANNEX to the research.

To conclude, the above-mentioned methods were used to conduct the present research. All the information and data gathered helped to build the theoretical foundations of this thesis, as well as analysing the practical aspects of the protection of unregistered trademarks, leading to the Conclusions chapter, where I provided the response to the research questions.

Finally, I will expose below the detailed content of the thesis in order to give the possibility to examine every step of the research more easily from the titles and subtitles that make up the structure of the paper.

## **TABLE OF CONTENTS**

LIST OF ABBREVIATIONS

INTRODUCTION

BACKGROUND AND CONTEXT OF THE PROBLEM

OBJECTIVE OF THE THESIS AND PLAN

METHODOLOGY

SECTION I

DEFINING THE CONCEPT OF TRADEMARK AND ACQUIRING  
TRADEMARK RIGHTS

CHAPTER 1

GENERAL CONSIDERATIONS ON THE LEGAL PROTECTION OF  
TRADEMARKS

1.1. What does a trademark represent? Different types of trademarks and their  
roles; Brief insight into non-traditional trademarks

1.2. Conclusions of the chapter

2. CHAPTER 2

ACQUIRING TRADEMARK RIGHTS AND TRADEMARK OWNER'S RIGHTS

2.1. Ways of acquiring trademark rights: generalization of the registration  
priority system; is the system really attributive by law or is it declarative?

2.2. The concept of "use" in trademark law

2.3. National and supranational trademark Offices. Their compulsory status  
(Paris Convention). Their nature. Attributions with regard to trademarks

2.4. On different types of trademarks by way of registration (national  
trademarks, European Union trademarks, international registrations) and their  
legal framework – A territorial classification of trademarks

2.5. Designation of goods and services in the trademark application and the  
Nice International Classification

2.6. The legal nature of the trademark rights

2.7. The concept of "unfair competition"

2.8. Conclusions of the chapter

3. CHAPTER 3

## TRADEMARK FUNCTIONS AND THE ECONOMIC ROLE OF TRADEMARKS

- 3.1. The consumer, goods/services and manufacturer/supplier triangle; how we choose what to buy - or two seemingly antagonistic roles of the trademark
- 3.2. Trademarks and business
- 3.3. Brief insight into the history of trademarks: from the ancient signs / marks to the modern brands, with increased attention to Romania
- 3.4. Conclusions of the chapter

## SECTION II

### THE LEGAL REGIME OF UNREGISTERED TRADEMARKS

#### 4. CHAPTER 4

##### UNREGISTERED TRADEMARKS IN INTERNATIONAL TREATIES

- 4.1. The Paris Convention for the Protection of Industrial Property of 20 March 1883 and unregistered trademarks
- 4.2. Madrid Agreement Concerning the International Registration of Marks of 14 April 1891, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 27 June 1989
- 4.3. The TRIPS Agreement encourages the attributive system
- 4.4. The conclusions of the chapter

#### 5. CHAPTER 5

##### UNREGISTERED TRADEMARKS AT EUROPEAN UNION LEVEL

- 5.1. Background and considerations on the harmonisation of European legislation on the protection of intellectual property rights
- 5.2. The approach of the Trade Mark Directive
- 5.3. The approach of the (EU) Regulation no. 608/2013 of the European Parliament and of the Council, of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003
- 5.4. The approach of EU Trademark Regulation
- 5.5. Protection of famous trademarks according to article 8 para. (2) letter c) of the EU Trademark Regulation

#### 6. CHAPTER 6

## ASPECTS OF COMPARATIVE LAW REGARDING PROTECTION OF UNREGISTERED TRADEMARKS IN JURISDICTIONS OF THE EUROPEAN UNION AND THE UNITED KINGDOM

- 6.1. The Scandinavian model of protection of unregistered trademarks
- 6.2. The Italian model of protection of unregistered trademarks
- 6.3. Protection of unregistered trademarks in the United Kingdom
- 6.4. Other European jurisdictions where unregistered trademarks are protected
- 6.5. Considerations on the use of trademarks and the protection of unregistered trademarks in Romania
- 6.6. Chapter conclusions

## CONCLUSIONS

- 7.1. Overall findings of the research in connection to the research question
- 7.2. Limitations of the research
- 7.3. The current status and the level of protection of unregistered trademarks at European Union level. The response to the first research question: *Do unregistered trademarks enjoy protection at the level of the European Union? And if the answer is yes, what role do they fulfil?*
- 7.4. Possible means of harmonisation
- 7.5. Response to the second research question: *Should the protection of unregistered trademarks be harmonized in more detail at European Union level?*
- 7.6. Final conclusions of the research

## Bibliography

## ANNEX – Survey Questions