



## SOME ASPECTS REGARDING THE ANNULMENT OF THE REGISTERED TRADEMARK

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**Abstract** *The trademark may be defined as any sign capable of graphic representation such as words, including names of people, drawings, letters, figures, figurative elements, three-dimensional shapes, in particular the shape of the product or its packaging, colors, color combinations, holograms, sound signals, as well as any combination thereof, provided that these signs allow to distinguish the products or services. A trademark's registration may be refused or it may be susceptible of cancellation or annulment if it is identical or similar to an earlier mark, if there is a risk of confusion in the perception of the public, in association with the former mark.*

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**JEL Codes:**  
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### 1. INTRODUCTION

The mark is a sign capable of graphical representation serving to distinguish the products or services of a natural or legal person from those of others. There can be used distinctive signs such as words, including names of people, drawings, letters, figures, figurative elements, three-dimensional shapes, and in particular the shape of the product or its packaging, combinations of colors, and any combination of these signs.

According to article no. 2 of Law no. 84/1998 regarding trademarks and geographical indications, any sign capable of graphic representation such as words, including names of people, drawings, letters, figures, figurative elements, three-dimensional shapes, in particular the shape of the product or its packaging, colors, color combinations, holograms, sound signals, as well as any combination thereof, provided that these signs allow to distinguish the products or services, may constitute a trademark. [1]

According to article no. 6 paragraph 1 of the aforementioned law, a trademark's registration may be refused or it may be susceptible to cancellation or annulment for the following relative reasons:

A) if it is identical to an earlier mark and the products and services for which the mark is sought or registered are identical to those for which the earlier mark is protected;

(B) for reasons of identity or similarity with the earlier mark and for reasons of identity or similarity of the goods or services which the two brands designate, there may be a risk of confusion in the perception of the public, including the risk of association with the earlier mark. [2]

The competence to resolve the request regarding a trademark cancellation or annulment belongs to the Bucharest Court of Law. [3]

### 2. PRESENTING THE CASE. ARGUMENTS

Bucharest Court of Appeal Court rejected the appeal formulated by SC A and upheld the judgment delivered by the Bucharest Court of Law, Civil Division IV, upholding the applicant's request to SC RI and ordering the annulment of the registration of the national trademark MIRAGE SNAGOV HOTEL & RESORT, trademark no....., registered on 19.01.2009, for services in class 43 / hotel accommodation services. Also, OSIM was forced to proceed to the deletion of that mark. [4]

In essence, in both the grounds of the two judgments (substance and appeal), the courts held that, in the present case, the registration of the trademark of MIRAGE SNAGOV HOTEL & RESORT was made in breach of the provisions of article 6 (c), since there is similarity between the marks. Since there is similarity between the goods/services in respect of which those

marks are used, there is a risk of confusion, including the risk of association with the applicant's earlier mark. In our opinion, the legal provisions in question are not incident in this case and none of these conditions are fulfilled.

Thus, although the applicant's trademark "CASINO MIRAGE" being registered on 14.11.2002 constitutes an earlier protected right within the meaning of the legal rules, we consider that it cannot be "successfully opposed" to the mark registered on 19.01.2009, because the applicant's mark is addressed to another public than the one to whom the defendant's mark is addressed to.

The courts have held that the trademark belonging to the defendant "MIRAGE SNAGOV HOTEL & RESORT" is similar to the applicant's "CASINO MIRAGE" combined brand, and there is a great risk of confusion. In reality, this risk of confusion is only apparent and has been determined by the court following a reasoning based on an erroneous element, namely that the dominant element of the defendant's mark would be the verbal element "*mirage*", an immediate impression that is retained, while all other elements are non-intrusive in relation to the services for which the trademark has been registered.

From our point of view, the mark in question is composed of several words, the word "*mirage*" being merely the first word, but in no case the main phonetic element, since the mark tends to prefigure the target audience of an overall picture, a hotel with a pleasant and relaxing atmosphere.

As regards the applicant's mark, the dominant element is the word element "*casino*", and it is well-known in the market that CASINO Mirage promotes casino-specific services, while the hotel in question pursues hotel services and not practicing gambling.

The doctrine stated that the consumer would perceive the mark normally as a whole without careful consideration of the details, keeping in mind only the element which induces to the mark its distinctive character. But that dominant element is, in the present case, the verbal element "*casino*" and not the verbal element "*mirage*".

Moreover, the defendant's mark contains, besides the word "*mirage*" and the words "Snagov Hotel & Resort", that it is obvious that the possible similarity of the marks is eliminated both visually and phonically, since these words clearly describe in the mind of the consumer the

type of practiced services, namely accommodation and hotel, not a casino at all.

Moreover, by OSIM it was stated that no opposition had been made by which the applicant S.C. RI, in its capacity as a person concerned, to disagree on the registration of the mark for which annulment was sought.

From a phonetic point of view, it is obvious that the brands will be pronounced differently by the public - "MIRAGE SNAGOV HOTEL & RESORT" compared to "CASINO MIRAGE", given that the defendant's mark consists of several verbal elements, the emphasis being the same, all the words forming the mark, whereas the applicant's mark is composed of only two words, to which a figurative element is added.

Moreover, the global assessment of the visual or conceptual similarity between the conflicting marks must be based on the overall impression produced by them, bearing in mind, in particular, their distinctive features. The perception of the marks of the average consumer of the type of goods or services in question has a dominant role in the overall assessment of the risk of confusion. The average consumer normally perceives a mark as a whole and does not examine its various details. In the present case, the overall images created by the two marks at issue are clearly different.

From the visual point of view, the defendant's mark consists of four capitalized words in the same row, total 24 letters. The petitioner's trademark is composed of two words arranged underneath each other, total 12 letters. From the visual point of view, the two brands have a great degree of differentiation in this, contributing in addition the figurative element, the two palm trees, but also the double dimension of the word CASINO, which gives it the dominant valence at the expense of the word *mirage*. For these reasons, we consider that there is no visual risk of confusion between the two marks because they cannot produce the same image in the visual memory of the consumer.

From the phonetic point of view, the defendant's mark consists of four words, the latter two being linked together by the conjunction and (&), and the mark of the intimate is made up of two words. Of note is the different degree of pronunciation of the two signs, both in terms of accentuation and duration over time. Even if there is a common word "*mirage*", the average consumer perceives the mark as a whole and does not examine its details. In other words, the relevant audience, the average consumer of the services offered by the two brand owners, will never confuse the services offered only because they will distinguish, fugitive, the word *mirage*, which is a common, non-discursive word.

From the point of view of the conceptual comparison, in terms of the common term "*mirage*", it has the same spelling in both English and French, and translates into Romanian by the word "*miraaj*". From a semantic point of view, according to DEX, the word *mirage* has several meanings: 1. Optical phenomenon produced by the gradual refraction of light into layers of air of different densities, due to which in some regions appear overturned and additional images of the horizon, parts of nature, distant things, etc., as if reflected in water; 2 - figurative sense: misleading images, imagination, vain illusion; 3 - figurative sense: flash, irresistible attraction. In the present case, the closest meaning to the purpose pursued by the word "*mirage*" is that of charm, irresistible attraction. However, it is worth mentioning that the Snagov Hotel and Resort is also in the defendant's trademark. The word *resort* is a word taken from English and translated into Romanian by "*statiune*". Therefore, the word "*mirage*", added to the Snagov brand, known as the most pleasant recreation place around Bucharest, reinforces, from a conceptual point of view, the attraction of this wonderful place, where you can be accommodated in a resort, living with all the benefits of the natural environment. It is more than obvious that this is the real meaning that the defendant took into consideration when choosing the group of words.

On the contrary, the word "*mirage*" added to the word "*casino*" awakens in the imagination of the average consumer the image of a place where gambling can lead him into a fantastic, almost illusory world.

The conceptual analysis of the two marks is, in the present case, more present than ever, the principle according to which it is necessary to base the perception on the overall picture of the two marks.

So, from a conceptual point of view, the word "*mirage*" has an attributive role and not a decisive role in the two brands, the meaning being necessarily understood as "the wonderful hotel in Snagov resort" and respectively "the wonderful casino". It follows that there can be no conceptual similarity between the two marks.

The jurisprudence has held that only when a composite mark is constituted by the juxtaposition of an element and another mark, that latter mark, although not the dominant element of the composite mark, may retain a distinctive, autonomous position within the composite mark. In such a case, the composite mark and the other mark may be regarded as similar.

According to the jurisprudence, in order to assess the similarity of goods or services, we have to take into

account all the factors which characterize the relationship that may exist between them. These factors include, in particular, their nature, their destination, their use, and their competitive or complementary nature.

On the other hand, products cannot be regarded as similar on the ground that they are in the same class and cannot be considered different because they are in different classes.

In the present case, the analysis of the similarity between the services protected by the two marks can only concern the identical class 43, which includes public catering and public accommodation services. It should be noted that there is protection sought by the mark of the intimate-plaintiff regarding the entire class of services 43, while the defendant applied for protection only for a segment of that class, thus there is no identity between these two marks, regarding this class of services, as wrongly considered both courts of law. It is clear that class 41 services cannot be called into question either because the defendant did not even apply for protection for that class of services. According to the evidence in the case file, the likelihood of confusion between the two marks relating to the similarity of services is inexistent since, in the mark of the claimant-intimate, the services genuinely protected are those relating to gambling, services for which the average consumer is well informed of the rules of gambling, the risks assumed, etc., while the services protected by the appellate trade mark are addressed to the average consumer seeking to find resting and recreation areas in the natural environment.

Moreover, the verbal element - the word "*mirage*" is deliberately written in characters smaller than the word CASINO, which obviously has the role - in the applicant's very vision - to draw the consumer's attention to that word.

In the light of that aspect, as regards the visual similarity between the two marks, that is not sufficiently important, since the dominant element of the applicant's mark is CASINO, and not "*mirage*".

The Court of Appeal rightly held that the conceptual analysis of the two marks requires application of the principle that it is necessary to base the perception on the overall image of the two marks. But he mistakenly remarked that it is precisely this analysis of the overall picture that leads to the conclusion of the conceptual similarity between the two marks, adding to the visual and phonetic similarity.

Moreover, on the territory of Romania, trademarks containing the *Mirage* verbal element are protected, for classes 41 and 43 and belonging to different holders.

From a phonetic and conceptual point of view, brands are different in both pronunciation and meaning; Although the services for which the marks have been protected are identical and / or similar, there is no likelihood of confusion on the part of the consumer. Thus, there is no similarity between the conflicting marks, there is no similarity between the goods / services in respect of which those marks are used and there is no risk of confusion.

The second appeal declared by the defendant was rejected as groundless. [5]

### 3. CONCLUSIONS

Concluding, we consider that the provisions of article no. 6 paragraph 1 letter b of the law no. 84/1996 should not have been applicable in the case, the lack of similarity between the conflicting marks resulting from the analysis of the existing visual, phonetic and conceptual differences.

However, since all the Courts that have decided in this case statued that there is a similarity between the component elements of the second trademark and the elements of the former one, the consequence consisted in the annulment of the second one.

### REFERENCES

[1] Article no. 2 of Law no. 84/1998 regarding trademarks and geographical indications, republished

[2] Article no. 6 of Law no. 84/1998 regarding trademarks and geographical indications, republished

[3] Article no. 47, paragraph 1 of Law no. 84/1998 regarding trademarks and geographical indications, republished

[4] Decision no. 218/22.09.2011 of Bucharest Court of Appeal, Civil 9<sup>th</sup> Section and for Cases of Intellectual Property, Labor Conflicts and Social Insurances

[5] Decision no. 4503/15.10.2013 of Highest Court of Instance