



Nicoleta Tarchila

# Speculative trademarks

Nicoleta Tarchila, Cabinet Enpora IP, explores speculative trademarks by looking closely at some popular examples, and explains how Romanian law handles these issues.

**S**ocial and political activism is becoming more and more exploited as a marketing tool. Social media offers quick opportunities to express one's thoughts and views as well as to organize large mass meetings and set global trends.

Therefore, it is no wonder that the use of catching phrases in order to incite people is becoming a popular practice. It is also no wonder that there are people that try to use such opportunities to their own benefit.

## Example 1: #rezist

In Romania, the month of February was dominated by political protests against corruption acts promoted by the current government. The mass demonstrations brought together hundreds of thousands of people all over the country for 3 weeks consecutively. On social media and on the street, the protesters joined under the motto "#rezist" translated into English as "#resist". The slogan with a specific graphic was used as a profile picture on social media, was written on bandanas to be worn by protesters, and was a constant on the very inspired placards that protesters were showing during the gatherings.

Then, on February 24, 2017 two trademark applications for the motto "#rezist" were filed with the Romanian Trademark Office. Not surprisingly neither of the applications is owned by the non-profit association **De-clic** – the author and promoter of the hashtag "#rezist". The fact that both applications share same filing date

could be a simple coincidence because there is no apparent relation between the applicants. One application consisting in the word mark "#rezist" was filed by two natural persons for goods in class 25 and services in class 35. There is no information on how the mark will be used, however one of the applicants is a marathoner thus we may presume the mark is intended to illustrate resistance, the essence of marathon.

In my opinion, the mark is an inspired one and in a different context should have no problems being registered. However, because of the timing, I doubt the recent mass events have no direct implication in the choice of such a phrase.

The trademark application that sparked media attention was however the word & design "#rezist" mark filed for classes 32, 35, 41 and 45. The applicant is a commercial entity running a newspaper, and the political aim behind the application was obvious. The owner of the newspaper is known for his bold political statements. Immediately after filing the application the newspaper made a big announcement about their new mark as well as their intentions to form a new political party under the mark "#rezist". Of course, the promoters of the now well-known hashtag reacted announcing publicly their intention to oppose to the registration of the new applications. In this context, we have looked into the options provided by the Romanian trademark legislation to obtain the rejection of such applications, which are obviously of a speculative nature.

## Résumé

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Nicoleta is the coordinator of the litigation department with a background of more than 10 years of experience in IP prosecution, litigation and portfolio management. As part of Enpora's IP team, Nicoleta advises clients from various activity fields. Her area of expertise is focused on filing invalidation and revocation actions before the Bucharest Court of Law but also includes filing oppositions and appeals before the Romanian Patent and Trademark Office and EUIPO. Working directly with the clients in a manner that meets the expectations of small Romanian businesses as well as of the biggest names in the pharmaceutical, retail or music industry that she has assisted over the time has proved to be a considerable strength point. Throughout the last five years Nicoleta took over the development and improvement of the business, both for Romania and the external market.

## Romanian legislation

The Romanian legislation concerning trademarks was harmonized with the EU trademark law and amended in 2010. Following the change of legislation, substantive examination on relative grounds of refusal was removed. The Romanian Trademark Office is however still in charge with the examination on absolute grounds to be completed with a decision within 6 months as of the date of publication of the trademark application. Consequently, trademark applications like the ones in question pass through the filter of the Romanian Trademark Office who will decide if these meet the registration requirements. Having in view the circumstances that led to the filing of the application, I consider these could be refused *ex officio* based on absolute grounds of refusal.



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The legal basis for the refusal shall be art. 5(1)(a) of the Romanian TM Law, which is the equivalent of art. 7(1)(a) of the EUTM Regulation. Namely, the marks in question are consisting in a sign that is not of the nature to fulfil the essential function of a trademark, which is that of distinguishing the goods or services of one undertaking from those of other undertakings. Because of the context and the promotion of the motto “#rezist”, this expression is directly related to the mass demonstrations that animated the whole country during the month of February. Consequently, the motto creates a direct link to the recent social movement and is not of a nature to identify the goods and services of a certain commercial undertaking. Therefore, the motto “#rezist” may not constitute a trademark.

A refusal of the applications could be also based on the provisions of art. 5(1)(b) of the Romanian TM Law, which is the equivalent of art. 7(1)(b) of the EUTM Regulation. According to this article,

“The applicant is a commercial entity running a newspaper, and the political aim behind the application was obvious.”

trademarks that are devoid of any distinctive character shall not be registered. In this particular case, the lack of distinctive character is not to be found *per se* because the expressions are perfectly capable of distinguishing the goods and services for which protection was sought. However, taking into consideration the special circumstances that led to the creation and popularity of the expression to be registered, the Office must conclude this has lost its distinctive character.

### Example 2: BREXIT

Observing the decisions of other trademark offices in similar cases, I have noticed the same position. The European Union Intellectual Property Office (EUIPO) is currently examining several trademark applications for the expression “BREXIT”. In two cases, a refusal was already issued based on the provisions of art. 7(1)(f) and (b) of the EUTM Regulation; namely, the expression was considered to be contrary to public policy or to accept principles of morality as well as lacking distinctive character. EUIPO argues that not only an expression with a *per se* negative connotation is of the nature to cause offense. It is sufficient that the public as offensive will perceive granting a monopoly for commercial purposes on such expression.

EUIPO considered the expression “BREXIT” is equivalent to religious concepts or national symbols with a very positive connotation *per se*, but of the nature to cause offense if granted to inappropriate undertakings. The Office appreciates the registration of the expression “BREXIT” – for goods in classes 33 or 32 as filed – will hurt the feelings of European citizens affected by this situation with a political and economic impact and will undermine its meaning. With respect to the finding that the term “BREXIT” is lacking distinctive character

EUIPO grounds its decision on the fact that the expression was created and became well known in a particular context with no other meaning than that of the exit of the Great Britain from the EU and therefore has no capacity to be memorized as a source of origin of certain goods.

### Example 3: Je suis Charlie

A similar position may be found in the decisions of the United States Patent and Trademark Office (USPTO) while analysing the registrability of two trademark applications “Je suis Charlie” filed in 2015 for a wide range of consumer goods. USPTO held the expression does not function as a trademark and motivated registration is refused because the applied-for mark merely conveys an informational social, political, religious, or similar kind of message; it does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish them from others. The more commonly a term or slogan is used in everyday speech, the less likely the public will use it to identify only one source, and thus the less likely the term or slogan will be recognized by purchasers as a trademark.

Having determined the existing trademark legislation offers enough reasons to hinder the registration of expressions rising out of popular movements, we should also note that speculative applicants receive a great deal of enmity from the very public that actually embraced the expressions at question and made them famous. Therefore, many applications for such marks were withdrawn by their applicants following intense critics. In fact, in some cases, even the legally rightful owners were determined to give up their attempts to trademark popular catch phrases. This was the case with the expression “Ice Bucket Challenge”. The popular challenge went viral internationally and raised important amounts of money for the ALS Association.

However, when the association filed several trademark applications containing the expression before the USPTO in 2013 it faced negative feedback. Consequently, they decided to abandon the applications. The public was concerned that if trademark rights are secured, the association could prevent other charities from using the game to sustain their cause.

With such a convincing prior case law to be used as example, we consider the Romanian Trademark Office will proceed with refusing the two “#rezist” trademark applications. The motto became a symbol of the people’s resistance before corruption acts and improper government. In this context, any association with consumer goods or monopoly for a certain political party will not be in accordance with the essential function of trademarks.

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