

Protection of unregistered trademarks at European Union level

Citation for published version (APA):

Irimescu, G.-M. (2023). *Protection of unregistered trademarks at European Union level*. [Doctoral Thesis, Maastricht University, Nicolae Titulescu University of Bucharest]. Maastricht University. <https://doi.org/10.26481/dis.20231030gi>

Document status and date:

Published: 01/01/2023

DOI:

[10.26481/dis.20231030gi](https://doi.org/10.26481/dis.20231030gi)

Document Version:

Publisher's PDF, also known as Version of record

Please check the document version of this publication:

- A submitted manuscript is the version of the article upon submission and before peer-review. There can be important differences between the submitted version and the official published version of record. People interested in the research are advised to contact the author for the final version of the publication, or visit the DOI to the publisher's website.
- The final author version and the galley proof are versions of the publication after peer review.
- The final published version features the final layout of the paper including the volume, issue and page numbers.

[Link to publication](#)

General rights

Copyright and moral rights for the publications made accessible in the public portal are retained by the authors and/or other copyright owners and it is a condition of accessing publications that users recognise and abide by the legal requirements associated with these rights.

- Users may download and print one copy of any publication from the public portal for the purpose of private study or research.
- You may not further distribute the material or use it for any profit-making activity or commercial gain
- You may freely distribute the URL identifying the publication in the public portal.

If the publication is distributed under the terms of Article 25fa of the Dutch Copyright Act, indicated by the "Taverne" license above, please follow below link for the End User Agreement:

www.umlib.nl/taverne-license

Take down policy

If you believe that this document breaches copyright please contact us at:

repository@maastrichtuniversity.nl

providing details and we will investigate your claim.

SUMMARY OF THE THESIS

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 protection, and on this basis the doctrine has divided them in attributive trademark protection systems, where the priority to registration prevails, and declarative trademark protection systems, where the priority belongs to the first person who used a trademark, and trademark registration is only declarative.

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.

Although, historically, the first trademark protection systems were mainly declarative, in time most jurisdictions evolved to attributive trademark protection systems.

The preference for the attributive trademark protection system in EU jurisdictions can find its explanation in the trademark functions and the economic role of trademarks. 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.

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.

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 European 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.

In this context, 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 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.

That said, in some Member States (and former members) of the European Union unregistered trademarks still enjoy different levels of protection. 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 users. 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.

Different levels of protection among them could create difficulties in the internal market. For this reason, a certain level of harmonised protection could be envisaged and could be taken into consideration by a future Directive aiming to harmonise the trademark legislations among Member States. To this end, the Scandinavian model of trademark protection permits objections on relative grounds based on unregistered trademarks that have reached a certain level of knowledge among consumers, or among the relevant public. The main concerns of practitioners, however, appear to be that the threshold of evidence to prove such knowledge is not always clear. This kind of downsides is usually overcome by means of a consolidated and longstanding practice. With this in mind, a possible solution is imposing the "*European standard*" of trademark use among the Member States, for the purpose of the opposability of unregistered trademarks, which is that of a use of "*more than mere local significance*". This way, the Member States could benefit of the European practice and set it as a benchmark for their own potential local practice.

The Italian model may also offer a good example for further harmonisation. In simple terms, it allows trademark owners to continue the use of their unregistered trademarks, as long as they are locally known. This model has a certain correspondent, or better said complementarity, in the provisions of the EUTM Regulation, which allows the owners of trademarks that are known locally to object to the use of a European Union trademark in that particular area, if the legislation of the Member State so provides.