

INTERNATIONAL BRAND PROTECTION

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ABSTRACT

“Intellectual property rights are policies that assign and protect the rights to earn income from innovative and creative activity. These rights provide legal authority to control the dissemination and commercialization of new information and ideas and to enforce sanctions against their unauthorized use. Intellectual property rights play a critical role in global economic growth and development because they affect the profitability of industrial research and the rewards to creative activity. At the same time, intellectual property rights are controversial because their stronger international protection may come at the expense of higher prices and reduced availability of products, particularly in developing countries.”(Jain, S. 1996)

INTRODUCTION

In order to facilitate economic exchanges between countries, it has been a question of establishing common rules for the protection of industrial property, including trademarks, from the end of the 19th century. In most countries, laws have been adopted to protect industrial property by setting up specialized institutions. The phase of bilateral agreements followed, with the aim of protecting industrial property, on the basis of reciprocity.

There are three ways to get protection in other countries, depending on the number of countries and their membership in various international treaties:

a) submitting applications to the National Trade Mark Offices in the respective countries;

b) submitting applications for registration to the competent regional office (European Union Internal Market Harmonization Office, Benelux Trade Mark Office, African Intellectual Property Organization, etc.);

c) the international path through the World Intellectual Property Organization that manages in this the following treaties: the Paris Convention for the Protection of Industrial Property (1883), the Madrid Agreement (1891), the Madrid Protocol (1989), etc.

MATERIAL AND METHOD

This article treats some of the main concerns related the international organizations and treaties, arrangements or conventions with respect to international protection of intellectual property rights. Moreover, this paper has a significant legal contains. Thus, all the materials underlying this study are made up of regulation, especially international treaties and law rules in this field. Almost the whole essay is based on the problems regarding Intellectual Property Law with respect of brand protection in general.

From the method point of view I will use the comparative and the logical-legal methods. Legal analysis of legal documents will be done referring to common European market and International law, the both public and private in the sector of wine brands.

RESULTS AND DISCUSSIONS

Paris convention for the Protection of Industrial Property

Internationally, the protection of industrial property is achieved through the Paris Convention of 1883. The Convention is the first international treaty designed to help individuals in a particular country protect their creations in another country under the form

of industrial property rights known as: inventions (patents), trade marks, industrial design. As already mentioned in the previous chapter, on March 20, 1883, the Convention for the Protection of Industrial Property was concluded in Paris, which was adopted and signed by 11 founding states. The Paris Convention entered into force on 7 July 1884 with 14 Member States, which set up an International Office. Romania adhered to the Paris Convention by a decree-law of 1920. The convention was revised in Brussels on 14 December 1900, in Washington on 2 June 1911, in The Hague on 6 November 1925, in London on 2 June 1934, in Lisbon on 31 October 1958, in Stockholm on 14 July 1967 and amended on 2 October 1979, launching International Union for the Protection of Industrial Property.

Under the Paris Convention, the forms of industrial property covered by the regulation, namely: invention patents, industrial designs, utility models, factory brands, trade names, services, trade names, geographical indications (indications origin and designations of origin), as well as the suppression of unfair competition. Under this Convention, the citizens of any of the countries of the Paris Union are subject to the principle of national treatment of trademarks in all other countries, even if they are not domiciled and do not own any enterprise in any of them, provided they are meets the requirements and formalities imposed on nationals.(Paris Convention,1883)

The Paris Convention grants all persons who have registered trademarks in one of the countries of the Union or who have applied for registration the right to register them with priority in the other countries of the Union. It is considered the country of origin where the depositor meets one of the conditions mentioned.

The country of origin can not be considered as the country where the depositor owns an enterprise if he is a citizen of another Union country. In this case only the last country will be considered as the country of origin.

The Paris Convention has greatly contributed to the establishment of a harmonized international system by setting up the Geneva International Union for the Protection of Industrial Property, improving the exchange of information in this area.

In the framework of the Paris Convention, a series of special arrangements have been concluded, covering different aspects of industrial property.

Madrid Arrangement

In 1891, the Madrid Arrangement was established, establishing the methods for international registration of trademarks. It was concluded on 14 April 1891. The Madrid arrangement of 14 April 1891 was revised in Brussels on 14 December 1900, in Washington on 2 June 1911, in The Hague on 6 November 1925, in London on 2 June 1934 in Nice on 15 June 1957 and in Stockholm on 14 July 1967.

The Madrid Arrangement on the International Registration of Marks was ratified by Romania, as revised in Stockholm, by Decree no. 1176 of 28 December 1968 - B.Of. no. 1/ 01.06.1969.

Thus, in the context of the preoccupations to improve the trademark registration system so that it corresponds to the interests of a larger number of countries, on June 27, 1989, the Protocol on the Madrid Arrangement on the International Registration of Marks - "The Madrid Protocol ". This protocol has introduced a number of major changes in the Madrid Arrangement. The Protocol was ratified by Romania through Law no. 3/1998 - M.Of. Nr. 10 / 14.1.1998.

The Madrid Protocol aims to facilitate the access of certain States, in particular to Member States which are not currently parties, to the international trademark registration system. In relation to the Madrid Agreement, one of the main innovations introduced by the Madrid Protocol in Article 14 is that it offers the possibility of an intergovernmental

organization that has a regional office for registering trademarks with effect on the territory of the organization to become party to the protocol mentioned.

The signing of the Protocol opened new perspectives on the development of the international trademark protection system. For the drafting of the Joint Implementation Regulation of the Madrid Agreement and the Madrid Protocol, a group of WIPO experts - the World Industrial Property Organization - was set up. The most recent version of the regulation was adopted on 20 July 1994.

The Madrid arrangement allows the international registration of a trademark in a country or several member countries of this arrangement through a single application filed with WIPO - the World Intellectual Property Organization. The duration of the protection obtained under the Madrid Agreement is 20 years, with the possibility of extending for another 20 years by paying a fee.

The Protocol on the Madrid Agreement allows the international registration of a trademark in one or more Member States to this Protocol through a single application filed with WIPO. The protocol allows for international registration not only on the basis of a nationally registered trademark but also on the basis of the regular national filing of a trademark application (ie, on the basis of a registration application). According to the Protocol on the Madrid Agreement, the duration of protection for the registration of a trademark is 10 years, with the possibility of extending for another 10 years, subject to payment of a fee.

Since not all states that have adhered to the Madrid Agreement are also contracting parties to the Madrid Protocol, the following international trademark situations are now distinguished:

- a) the exclusive application of the Madrid Agreement;
- b) the exclusive application of the Madrid Protocol;
- c) application of both the Arrangement and the Madrid Protocol. (Madrid Arrangements, 1891)

Romania, as the contracting country of both the Arrangement and the Madrid Protocol, for the applicants for the international registration of a trademark, the provisions of the two differentiated conventions apply. Thus, the provisions of the Arrangement apply to Enlargement to the Parties to the Arrangement, and the provisions of the Enlargement Protocol to the Parties to it.

Nice Arrangement

The Nice Agreement of 15 June 1957 established the international classification of a products and services for the purpose of registering trademarks. The arrangement was revised in Stockholm on 14 July 1967 and in Geneva on 13 May 1977 and amended on 2 October 1979. Romania adhered to Law no. 3/1998. (Nice Arrangement, 1957)

Viena Arrangement

The Vienna Arrangement of 12 June 1973, as amended on 1 October 1985, established the international classification of the figurative elements of the marks. Romania has adhered to Law no. 3/1998. (Vienna Arrangements, 1973)

Stockholm Convention

The Stockholm Convention (1979) provides the World Industrial Property Organization (WIPO) and an international office based in Geneva. (Stockholm Convention, 1979)

World Industrial Property Organization

The International Intellectual Property Organization (the original Intellectual Property

Organization or WIPO) was created in 1967 with the stated aim of encouraging creative activity and promoting intellectual property anywhere in the world. WIPO currently has 183 member states, manages 23 international treaties, based in Geneva, Switzerland.

WIPO was formally created by the Convention Establishing the World Intellectual Property Organization, which was signed in Stockholm on 14 July 1967 and confirmed on 28 September 1979.

According to Article 3 of the Convention, WIPO seeks to "promote the protection of intellectual property throughout the world". (WIPO, 1974, art 3)

As Christopher May claimed, "despite the major transatlantic rift over copyright in this initial period of international governance of intellectual property, the members of the Rome and Berne conventions quickly realized that there were significant commonalities between the governance of both treaties and thus it would be sensible to develop a joint secretariat. The establishment of this new secretariat in 1893 brought together the international governance of patent, copyrights and trademarks under the authority of one institution. Initially the secretariat was placed under supervision of the Swiss government with offices in Berne, where it stayed until moving to WIPO's current home in Geneva in 1960. Only when the Stockholm Conference in 1967 set out an independent international governmental organization which was established as the WIPO three years later, did it formally cease to be the responsibility of the Swiss. When an applicant wishes to register and obtain the protection of a trademark at national and / or international level, he may obtain the protection of an international trademark in accordance with the World Intellectual Property Organization (WIPO) procedure." (May, C.2007)

In 1974, WIPO became a specialized agency of the United Nations system of organizations, with a mandate to administer intellectual property issues recognized by UN member states.

WIPO has expanded its role and further demonstrated the importance of intellectual property rights in organizing global trade in 1996, entering into a co-operation agreement with the World Trade Organization.

This international procedural mechanism is based on the Madrid Agreement on the International Registration of Marks of 1891 and the Madrid Protocol of 1989 ("the Madrid System"), being applicable to a large number of countries all over the world, including the Member States The EU, the United States of America, and other states located on other continents. The Madrid system gives a trademark owner the opportunity to obtain trademark protection in more than one country simply by filing a trademark application directly with the national or regional authority in the field. An international trademark so registered is equivalent to the registration of that trademark in each of the States designated by the applicant, producing its effects in each of these States.

The procedure for the registration of an international trademark begins with the filing of the application for registration with WIPO, within which one or more contracting states or organizations may be designated. Once the international application has been filed, WIPO proceeds to a preliminary examination of the fulfillment of the formal conditions, followed by the registration of the mark in the International

Register of Marks and the issue of its international registration certificate.

WIPO also notifies each State designated in the international application for its designation, and from now on the procedure for the registration of the international trademark follows the same registration procedure at the national office of each State as if the application had been filed nationally in that State, each national office to notify the WIPO International Office of any refusal to register the mark within 12 months (for States designated by the Arrangement) and 18 months (for Protocols) from the date of registration of the mark in the International Registry.

If the competent authority in a particular state did not give a refusal to grant a trademark protection within a certain timeframe then that mark is recognized as being registered and protected as if the procedure had been completed at that State's level.

In the case of a provisional refusal notified to WIPO by one of the designated States, the holder of the international trade mark shall in turn be notified by WIPO of the nature of the refusal, the State of which the

Office has issued it and the time allowed by that office to submit a reply.

The proprietor can defend his interests by designating an authorized representative from that state to ensure representation before the national office in order to overcome his refusal to register. Irrespective of the final decision taken by the national office of a designated State for the registration of the trademark, it shall be communicated by the WIPO to that office, to be entered in the International Registry.

The period of validity of an international trademark is 10 years from the date of its registration and may be renewed by an unlimited number of times by filing a renewal application to the WIPO International Bureau and paying the official fees prescribed for this procedure.

The protection of an international trademark in each designated state falls within the limits set by the national law of that state, the latter being free to grant protection or to refuse to register an international trademark on its territory, in accordance with its own legislation, independently of the protection obtained of that mark in the other designated States.

The holder of the international trade mark therefore has in each designated state in which it was definitively admitted to registration the rights conferred by the national legislation of that State on the proprietors of the marks.

The Madrid system also simplifies subsequent trademark proceedings, as it is possible to file an application for modification or renewal of the registration of a trademark using a single procedure.

Brand protection in the European Union

The common market established by the creation of the European Union (now 27 EU Member States), characterized by the free movement of goods, people, services and capital within it, has given the producers many advantages in the context of the community business environment. In order to take advantage of the benefits of access to this market, only products have to have their own brand, trademarks must be protected, protection must in principle cover all EU Member States. Thus, producers have been offered a tool to protect their trademark rights across the European Union through a record registration as an alternative to the national registration system in each country or internationally via the Madrid system.

Since the principle of territoriality of protection (a trademark registered in a country, for example in Romania, does not benefit from protection in another country unless registered in that country) was an obstacle to the free movement of goods within the European Community (the same mark could had different titles in different countries), as well as the fact that the national regulations of the European Community member countries showed significant differences, tried to harmonize the national laws of the Member States with regard to brands.

On March 25, 1957, the Treaty of Rome established the European Economic Community (CEE) based on a wider common market. The CEE objective was to promote a harmonious development of economic activities among member states, removing economic barriers. The issue of industrial property protection has been put into the EU since the 1970s and especially since 1986 when the Single European Act was signed. In

1993, through the Treaty from Maastricht, the European Union, the former European Community, which has developed strongly, the number of member countries from 6 to 27 and the obstacles to the free movement of goods and services, people and capital have disappeared with the creation of the single market.

The main advantage of the Community mark is ensured by the facilitation of a single registration procedure in front of a single European institution, the rights acquired being equally valid in all the Member States of the European Union.

The applicant following a simple procedure can obtain trademark protection in all EU Member States. In order to register a mark at EU level, the applicant has to submit a single application for all EU Member States to a single office - the Office for Harmonization of the Internal Market - with competence for all EU Member States.

The procedure for registering a mark at European Community level is laid down in Council Directive 89/104 / EEC of 21 December 1988 on the approximation of the laws of the Member States relating to trade marks and in Council Regulation No 40/94 of 20 December 1993 Community trademark.

While the Directive only provides basic measures for the smooth functioning of the internal market by failing to bring about a real harmonization of the EU Member States' trademark legislation.

Regulation is the legislative instrument with direct applicability in all Member States of the European Union. On the other hand, the Directive provides for the coexistence at European level of two systems of trademark protection: the national system governed by national laws (harmonized but not identical) and the Community mark system regulated by EEC Regulation 40/94, - the only procedure is that registered trademarks are valid in all Member States of the Union. Through the Regulation, Community trademarks are registered and produce effects throughout the territory of all EU Member States.

At the same time, an independent and autonomous body, called the Office for Harmonization in the Internal Market (OHIM), established in Alicante, Spain, has been created, whose role is to register Community trademarks.

Community trade mark be required by any natural or legal person who fulfills the following conditions: to have the nationality of an EU Member State, the Paris Convention or the WTO, to have his / her place of residence or an effective and serious industrial or commercial establishment within the EU , on the territory of a Member State, the Paris Convention or the WTO.

Applicants domiciled in the EU may lodge applications themselves or through a trustee, and those outside the EU may only apply for a mandate by a Trustee in proceedings before OHIM.

The registration procedure for a Community trade mark requires the filing of the application for registration at OHIM, followed by stages similar to those of the national registration of the mark in the Member States: preliminary examination, publication of the mark, registration and issue of the registration certificate) except for specific procedural particularities.

The main issue distinguishing the registration of a Community trade mark from that of a national trademark in Romania is that the first does not provide for a prior examination, any trademark filed for registration at the European Office being admitted to registration independently of the marks previously registered in the EU space. However, the holders of the latter benefit from the right to oppose the registration of a Community trade mark to the extent that they consider their prior rights to be infringed by registering it.

Trademarks admitted to registration are entered in the Community Trademark Register. Community trademark owners have the same rights in EU member states as national trademark owners.

The protection granted for a registered Community trademark is 10 years from the date of registration, this period may be extended successively by 10 years, for an unlimited number of times, upon expiration of the protection period, by filing a request for renewal and payment of the official taxes related.

So far, the European Office has registered nearly 600,000 brands on behalf of hundreds of companies around the world, and this number is growing rapidly every year.

Uruguay Round-TRIPS

This convention is the most important in the branch of intellectual property in general and, obviously, the international brand protection, in particular. Also, TRIPS, as called this agreement, is one of the most controversial international treaties which has been finalized so far. However, TRIPS contains rules and norms applicable in all areas of intellectual property rights.

In short, the scope and nature of obligations were defined in art 1 :

“1. Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.

2. For the purposes of this Agreement, the term “intellectual property” refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.

3. Members shall accord the treatment provided for in this Agreement to the nationals of other Members. In respect of the relevant intellectual property right, the nationals of other members shall be understood as those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967), the Berne Convention (1971), the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits, were all Members of the WTO members of those conventions. Any Member availing itself of the possibilities provided in paragraph 3 of Article 5 or paragraph 2 of Article 6 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for Trade-Related Aspects of Intellectual Property Rights (the “Council for TRIPS”).”(Uruguay Round, 1986-1994)

Regarding to wine and spirits sector, TRIPS contained a series of rules, in principal in art 23 of this agreement: “ Additional protection for geographical indications for wine and spirits/Art 23

1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.

2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, *ex officio* if a Member’s legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

4. In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.”(Uruguay Round,1986-1994)

CONCLUSIONS

To sum up, the issues referring international brand protection were regulated in many of international treaties and agreements. All these problems are far from being solved due to the multitude of factors involved, as political, economical or social.

The listed treaties can make an overview to this branch and to its complexity as well. Many other agreements or arrangements have not been mentioned in this article, but the most important of them are here.

BIBLIOGRAPHY

1. **Subhash C. Jain**, 1996 - Journal of International Marketing/Problems in International Property Rights, vol 4 ,No 1, p 9.
2. **Christopher May**, 2007 - The World Intellectual Property Organization, Rutledge, p 19.
3. ***, 1883 - Paris Convention for the Protection of Industrial Property.
4. ***, 1891 - Madrid Arrangement
5. ***, 1957 - Nice Arrangement.
6. ***, 1973 - Viena Arrangement.
7. ***, 1974 - World Industrial Property Organization.
8. ***, 1979 - Stockholm Convention.
9. ***, 1986-1994 - Uruguay Round.