

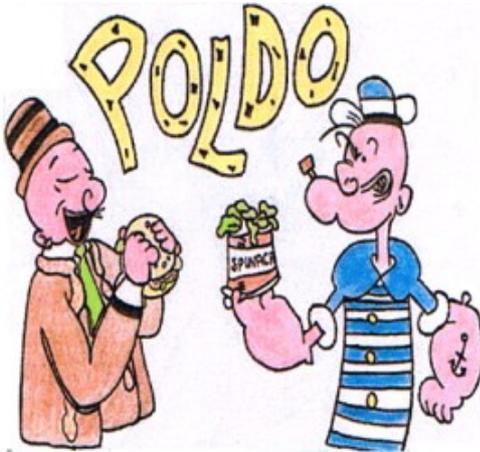
World Trademark Review *Daily*

Owner of Popeye and Wimpy figurative marks prevents registration of combined mark
Romania - Nestor Nestor Diculescu Kingston Petersen

Examination/opposition
National procedures

May 08 2012

The Romanian State Office for Inventions and Trademarks (SOIT) has rejected an application to register the combined trademark POLDO (Application M 2010 05363), pictured below, for goods and services in Classes 30, 35 and 43 of the Nice Classification:



The refusal was based on an opposition filed by Hearst Holdings Inc, the owner of the following trademarks, among others:

- an earlier registered Community trademark representing the famous cartoon characters Popeye the Sailor and Wimpy (No 001572254), registered on October 10 2001:



- the figurative trademarks Nos 009645433 and 008880271, registered on July 5 2010:

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In its decision (which is now final, as it has not been contested by the applicant), SOIT considered that the opponent's figurative trademarks were renowned worldwide, including in Romania. Therefore, by registering the national trademark POLDO, the applicant would take unfair advantage of the reputation enjoyed by the opponent's trademarks on the Romanian territory. Moreover, SOIT considered that, although the applicant's trademark contained the word element 'Poldo', this was insufficient to outweigh the similarities with the opponent's earlier trademarks, as this element could not create a totally different impression from that conveyed by the earlier trademarks.

In its response to the opposition, the applicant stated that it was willing to remove the figurative elements (ie, the graphical representation of Popeye the Sailor and Wimpy) from its trademark in order for its application to be accepted. However, SOIT considered that this request for modification of the application substantially changed the character of the trademark, taking into account the importance of the figurative element in the mark and the fact that such modification would change the nature of the mark (ie, from combined to word mark). SOIT concluded that the applicant had to file a new trademark application, and rejected the request.

The decision is of importance in that it recognises:

- the strength of figurative trademarks, which can prevent the registration of combined marks; and
- the well-known character of the POPEYE THE SAILOR and WIMPY marks in Romania.

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