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# Is it possible to own the rights to the name of a religious figure?

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In late 2017 and early 2018, a scandal involving the trademark and design rights protecting the name and image of Arsenie Boca shook the Romanian public.

## Facts

Arsenie Boca was a Romanian Orthodox monk, widely revered for his spiritual teachings and charitable work and considered by many Romanians as a spiritual guide and cultural icon. He passed away in 1989, leaving behind a legacy that inspired many religious people.

Various natural persons and Christian foundations had made unsuccessful attempts to register the name "Arsenie Boca" as a trademark before the national Romanian State Office for Inventions and Trademarks. However, the European Union Intellectual Property Office (EUIPO) granted protection for several rights that featured the monk's name and/or image:

- the EU wordmark ARSENIE (No. 015760382), registered on 6 December 2016 by Sandor Andor, a natural person, for goods in classes three, five, 14, 29 and 30;
- the EU figurative trademark shown in Figure 1 (in English, "OUR DAILY BREAD Fr. Arsenie") (No. 016722712), registered on 15 March 2018 also by Andor, for goods and services in classes 30 and 35;



Figure 1: EU figurative trademark No. 016722712

- the registered Community design shown in Figure 2 (No. 003564582-0001), registered on 1 January 2017 for ornamentation in Locarno class 32.00 also in the name of Andor;

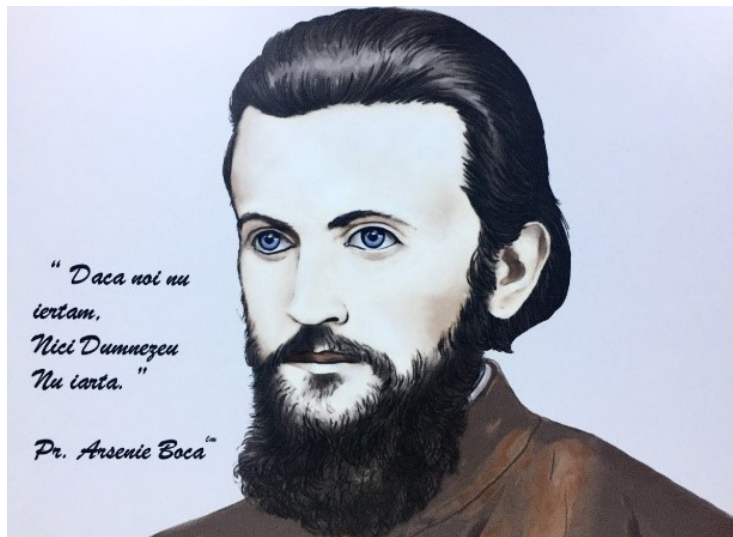


Figure 2: registered Community design No. 003564582-0001

- the EU wordmark BOCA PARINTELE (in English, "FATHER BOCA") (No. 015773997) registered on 2 December 2016 for goods and services in classes 16, 20, 32, 33, 34 and 36 by Diana Talpos, a natural person; and

- the registered Community design shown in Figure 3 (No. 007729165-0001), registered on 2 March 2020 for ornamentation and surface patterns in Locarno class 32.00 in the name of Alexandru Talpos, natural person.

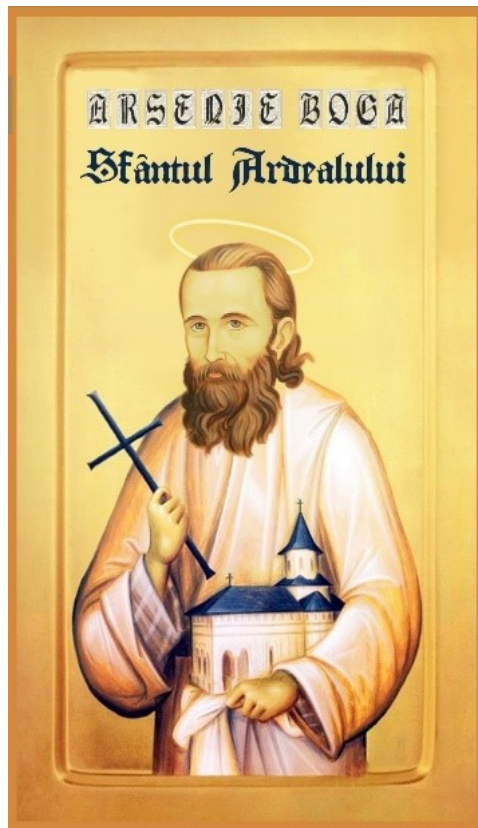


Figure 3: registered Community design No. 007729165-0001

According to the [Romanian media](#), Andor, holder of several of the above IP rights, intended to enforce his exclusive rights by issuing warning letters requesting the cessation of all use of the name and/or image of Arsenie Boca in relation to the commerce of any unauthorised goods on the Romanian market. Further, Diana Talpos, holder of the EU wordmark BOCA PARINTELE had filed criminal complaints against the Romanian Orthodox Church and other entities that sold objects bearing the name "Arsenie Boca", and asked for the seizure of all religious items bearing his image and name.

The Romanian Orthodox Church, through the Diocese of Deva and Hunedoara, which counts Arsenie Boca as one of its most important figures, opposed the appropriation of exclusive rights in the name and image of Arsenie Boca merely for commercial purposes. It pursued invalidity actions against the registration of the EU wordmark BOCA PARINTELE registered by Diana Talpos, as well as against the registered Community design registered in the name of Alexandru Talpos.

#### Decisions

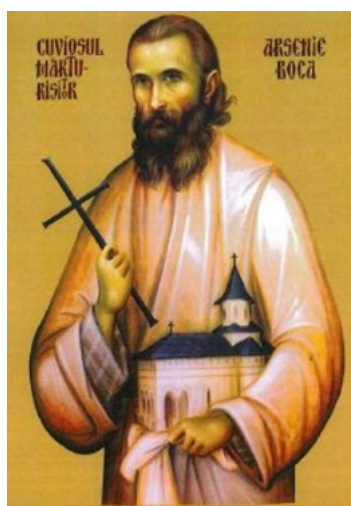
The EUIPO rendered its final decisions in mid-2022, ordering the cancellation of the EU wordmark and declaring the design invalid.

#### Design

The design invalidity claim was straightforward. The applicant, the Diocese of Deva and Hunedoara, successfully showed that the contested design was not new and lacked individual character, given that:

- an identical design had been made available to the public before the filing date of the contested design; and
- the overall impression that the contested design produced on the informed user did not differ from that produced by the earlier design.

To support its claim, the diocese filed copies of a book cover that entered into circulation in Romania in 2014. The cover depicted a highly similar image of Father Arsenie Boca, dressed in monastic clothes and holding in his arms the Church of the Prislop Monastery and a cross (Figure 4).



The EUIPO noted that the two designs incorporated a virtually identical depiction of the same person as their main element. The differences between them – namely, some additional words and their position within the picture – were considerably less striking than their common features and did not change the very similar overall impression created by the designs.

The EUIPO also noted that for an informed user to be able to distinguish between the two designs, they would need to analyse them in detail. This would go far beyond the assessment of overall impression required in the assessment of individual character.

### **Trademark**

The trademark invalidity claim pursued against the EU wordmark BOCA PARINTELE was less straightforward. Initially, the EUIPO rejected it entirely.<sup>(1)</sup>

The claim was jointly filed by Prislop Monastery and the Diocese of Deva and Hunedoara. It relied on:

- the absolute grounds for refusal or invalidity set out in article 59(1)(a) in conjunction with articles 7(1)(a), (b), (c), (f), (g) and (i) in conjunction with article 7(2) of the EU Trademark Regulation; and
- article 59(1)(b) of the EU Trademark Regulation (on the ground that the trademark had been filed in bad faith).

In its decision rendered on 28 May 2019, the EUIPO analysed each of the absolute grounds for invalidity raised by the applicants and noted the following, among other things:

- The fact that the sign could be understood as the name of a famous Romanian figure did not exclude the fact that the sign could serve to distinguish the commercial origin of the goods at issue. Therefore, the sign complied with the provisions of article 4 of the EU Trademark Regulation.
- The cancellation applicants had failed to explain how the name of the Romanian Orthodox monk Arsenie Boca described the characteristics of the contested goods and services. Therefore, the contested sign was not descriptive.
- No evidence had been submitted to show that the Romanian public would recognise the misspelling of "părintele" to mean father or that, in combination with "Boca", it referred to 'Arsenie Boca'.
- The applicants had filed no concrete independent evidence at the time of filing or thereafter which showed that the use of the wordmark BOCA PARINTELE would contravene public policy or accepted principles of morality.
- The contested trademark did not lead consumers to any clear expectation as regards any characteristic of the contested goods and services. Therefore, the contested sign was not deceptive.
- The cancellation applicants had failed to show that they owned a badge, emblem or escutcheon for the term "Boca Parintele" without the image of the famous figure or his first name, Arsenie.
- The cancellation applicants had failed to prove the dishonest intention of the EU trademark owner at the time of filing the contested EU trademark.

The decision was appealed. In July 2020, the EUIPO Boards of Appeal rendered an interim decision to suspend the case ex officio until a final decision was rendered in proceedings that were pending at the time before the Bucharest Court of Law in Romania.<sup>(2)</sup> These proceedings related to the registration of the figurative mark shown in Figure 5, filed for protection by a different entity as a national Romanian trademark featuring the verbal elements "P.C. PĂRINTE ARSENIE BOCA" (in English, "P.C. FATHER ARSENIE BOCA") for goods in class 16 and services in class 41.



**Figure 5: figurative mark in dispute before the Bucharest Court of Law**

This case related to a different sign to the one contested in the EUIPO appeal case. However, the EUIPO decided to suspend the proceedings because the Romanian authorities had refused the registration of the mark shown in Figure 5 on the basis that it constituted a religious symbol of high symbolic value. This could support the finding that such symbols should not be registered, pursuant to article 7(1)(f) in conjunction with article 7(2) of the EU Trademark Regulation. Further, the Bucharest Court of Law's ruling could also reflect the perception of the impugned trademark from the perspective of the Romanian consumer, which was highly relevant to the appeal at hand.

Upon the resumption of case, the EUIPO proceeded to reject the appeal claims raised under articles 7(1) a), b), g) and f). It conceded that:

- Arsenie Boca had been persecuted during the communist regime;
- Arsenie Boca was known by the Romanian population; and
- in 2019, the Metropolitan Council of the Metropolis of Transylvania had started the process of his canonisation.

However, according to the EUIPO, it could not be said and the evidence did not reveal that he was one of the central figures of the Romanian Orthodox Church. The Bucharest Court of Law's ruling that had led to the suspension of the appeal also supported this conclusion. The EUIPO indicated that it could find no reasons to support the fact that the relevant public, in seeing the name of a monk,

would believe that the contested goods and services were linked to or originated from the Romanian Orthodox Church. It held that the contested mark possessed sufficient distinctive character and was able to distinguish between the goods at issue and those of other entities on the market. Further, it could be represented on the register in a clear and precise manner.

Nevertheless, with respect to the bad-faith claim, the EUIPO concluded that the evidence on file, including the new evidence that was submitted during the appeal stage, proved that the EU trademark owner had known that the cancellation applicant had been selling books, souvenirs, icons and other religious items under the trade name "Fr. Boca" since 1990 – long before the filing date of the contested EU trademark.

Further, the EUIPO noted that the trademark owner's dishonest intention was also evidenced by the fact that, once the contested mark had been registered, the trademark owner had proceeded to send cease and desist letters to the cancellation applicants and had filed criminal complaints against the Romanian Orthodox Church and other third parties that had been selling goods affixed with the name and image of Arsenie Boca.

Therefore, despite the fact that the cancellation applicants had failed to prove that the contested mark was descriptive for certain characteristics of the goods at issue or would mislead the Romanian audience with respect to certain features of the goods (ie, as originating from the Romanian Orthodox Church), the EUIPO ultimately ordered the trademark's cancellation, taking into account the applicant's bad faith at the time of filing.

#### **Comment**

It is expected that the Romanian public will welcome this outcome, as it can be seen as a victory for justice and respect for the memory of Arsenia Boca. However, this case raises important questions about the limits of commercial exploitation of cultural and spiritual heritage – many continue to believe that the name and legacy of Arsenia Boca belongs to the Romanian people and the Orthodox Church and should not be subject to individual commercial exploits. Therefore, this case is likely to continue to generate controversy and debate.

*For further information on this topic please contact [Andreea Bende](mailto:andreea.bende@simionbaci.ro) at Simion & Baciu by telephone (+40-31 437 80 13) or email ([andreea.bende@simionbaci.ro](mailto:andreea.bende@simionbaci.ro)). The Simion & Baciu website can be accessed at [simionbaci.ro](http://simionbaci.ro).*

#### **Endnotes**

(1) No. R 2938/2019-2.

(2) No. 27491/3/2019.