



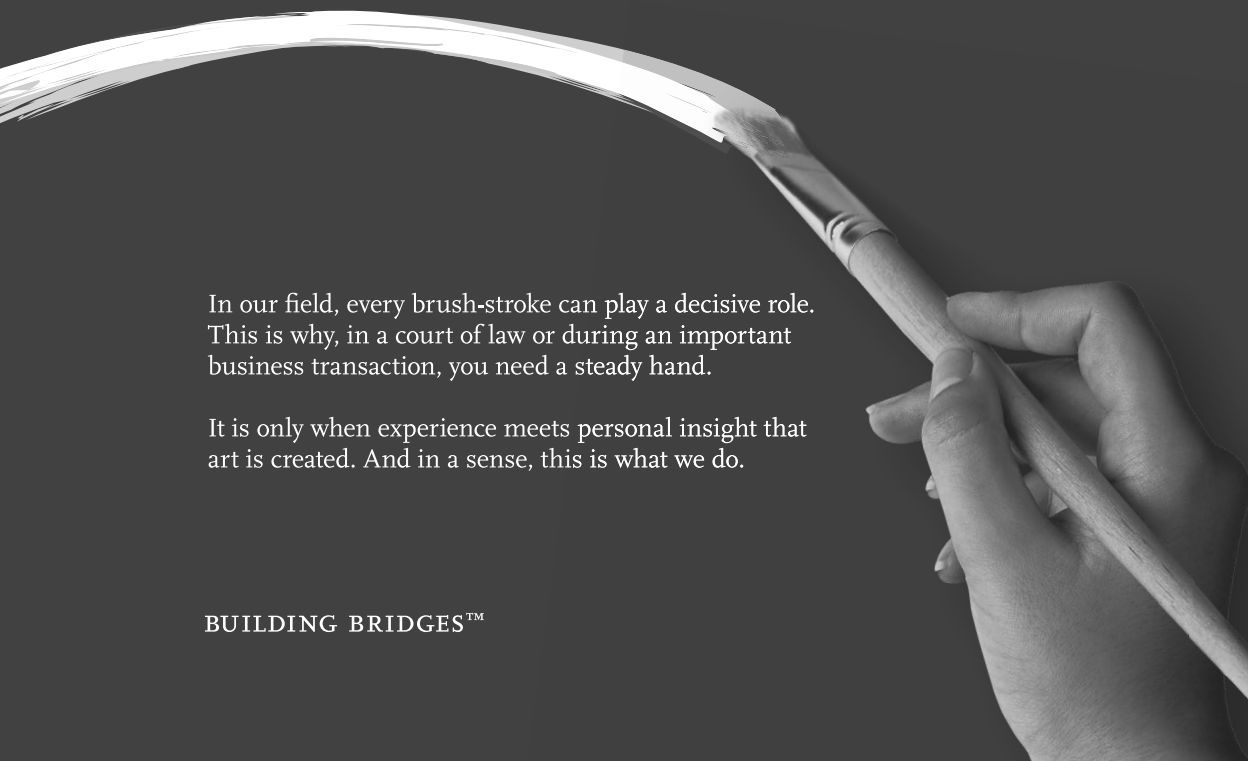
Nestor Nestor Diclescu Kingston Petersen
ATTORNEYS & COUNSELORS

The art lies not
in what you do,
but in how
you do it.

In our field, every brush-stroke can play a decisive role. This is why, in a court of law or during an important business transaction, you need a steady hand.

It is only when experience meets personal insight that art is created. And in a sense, this is what we do.

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Romania

Contributing firm

Nestor Nestor Diculescu Kingston Petersen

Authors

Alexandru Harsany

Partner, head of IP Division

Ana-Maria Baci

Senior associate

Delia Belciu

Associate



1. Legal framework

National

Trademarks in Romania are governed by the following laws and regulations:

- the Law on Trademarks and Geographical Indications (84/1998);
- Government Decision 833/1998 on the Regulations for the Application of the Trademarks Law;
- the Border Measures Law (344/2005);
- Government Decision 88/2006 on the Regulations for the Application of the Border Measures Law;
- Emergency Governmental Ordinance 100/2005 on the Protection of Industrial Property Rights (as further modified and amended);
- the Unfair Competition Law (11/1991, as further modified and amended);
- the Competition Law (21/1996, as further modified and amended);
- the Advertising Law (148/2000, as further modified and amended); and
- the Misleading and Comparative Advertising Law (158/2008).

The applicable statutory law and principles are set out in the Civil and Criminal Codes and the Civil and Criminal Procedure Codes; for example, the Trademarks Law provides that in trademark infringement cases a preliminary injunction may be sought, but the legal conditions subject to which this may be obtained are summarized by the Civil Procedure Code.

International

Romania is a party to the following international trademark treaties:

- the Paris Convention for the Protection of Industrial Property;
- the World Intellectual Property Organization Convention;
- the Madrid Agreement on the International Registration of Marks;
- the Madrid Protocol;
- the Nice Agreement on the International Classification of Goods and Services;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

In addition, as Romania joined the European Union on January 1 2007, the following EU legislation is now directly applicable in Romania:

- the Community Trademark Regulation (40/94/EC);
- Commission Regulation 2868/95/EC implementing the Community Trademark Regulation;
- Commission Regulation 2869/95/EC on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs);
- Commission Regulation 216/96/EC laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trademarks and Designs);
- Council Regulation 1383/2003/EC concerning Customs action against goods suspected of infringing certain IP rights and the measures to be taken against such goods; and
- Commission Regulation 1891/2004/EC laying down provisions for the implementation of Council Regulation 1383/2003/EC.

2. Unregistered marks

There is no requirement to use a mark in order to acquire trademark rights. The Romanian trademark system is based on the first-to-file principle and registration is possible without preliminary use. However, where a trademark is refused registration for lack of distinctiveness, this can be overcome by showing that the mark has acquired distinctiveness through extensive use.

While use is not required to acquire trademark rights, use is required to maintain the trademark registration and to establish infringement.

The protection afforded to unregistered marks is thus limited to the following:

- Marks covered by other IP rights – the owner of an earlier right in a likeness or surname, a protected geographical indication, a protected industrial design or any other protected industrial property right or copyright may file an opposition against a trademark application.

- Well-known trademarks – the provisions of Article 6bis of the Paris Convention, Article 16(3) of the TRIPs Agreement and Article 5(2) of the EU First Trademark Directive (89/104/EEC) are reflected in the Trademarks Law and regulations. To this end, a ‘well-known trademark’ is defined as a mark that is well known in Romania on the filing or priority date of a trademark application. In order to determine whether a mark is well known, account will be taken of the mark’s reputation in the sector of the public targeted by the goods or services for which the mark is used, without it being necessary for the mark to have been registered or used in Romania.
- marks that lack distinctive character;
- marks consisting exclusively of signs or indications that have become customary in the current language or in the good-faith and established practices of the trade;
- marks consisting exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the services, or other characteristics of the goods or services;
- marks consisting exclusively of the shape of the goods which results from the nature of the goods themselves, which is necessary to obtain a technical result or which gives substantial value to the goods;
- marks that are liable to mislead the public as to the geographical origin, quality or nature of the goods or services;
- marks containing or consisting of a geographical indication for goods that do not originate in the designated territory, if the use of this indication is liable to mislead the public as to the true place of origin;
- marks containing or consisting of a geographical indication identifying wines or spirits that do not originate in the place indicated;
- marks that are contrary to public order or accepted principles of morality;
- marks that contain, without the owner’s consent, the likeness or surname of a well-known person in Romania;
- marks that contain, without the permission of the competent authorities, reproductions or imitations of armorial bearings, flags, state emblems, signs, official hallmarks of control and warranty and coats of arms belonging to countries of the Paris Union and which are governed by Article 6ter of the Paris Convention; and
- marks that contain, without the permission of the competent authorities, reproductions or imitations of armorial bearings, flags, other emblems, abbreviations, initials or denominations which are governed by Article 6ter of the Paris Convention and which belong to international intergovernmental organizations to which one or more countries of the Paris Union are party.

3. Registered marks

Ownership

The Trademarks Law imposes no special requirements on the applicant or owner of a trademark. Subject to the general conditions of legal capacity, both natural and legal persons (including associations, foundations and non-governmental bodies) may apply for and own a trademark.

Scope of protection

Protected: A ‘trademark’ is defined “as a sign that is capable of graphical representation and serving to distinguish the goods or services of a natural or legal person from those of other persons”. The Trademarks Law also lists specific examples of signs that may be registered as trademarks, such as words, including personal names, drawings, letters, numbers, figurative elements, three-dimensional shapes – in particular the shape of goods or their packaging – and colour combinations, and combinations thereof. Therefore, according to the Trademarks Law, the key criterion for registration is that the sign is capable *per se* of graphical representation. However, the Trademarks Law contains no provisions on signs that, although capable of graphical representation, cannot be perceived visually (eg, musical phrases).

Not protected: The following marks are excluded from protection under the Trademarks Law:

The absolute grounds for refusal of registration because the mark is not distinctive – set out in the first three points above – may be overcome by showing that the mark has acquired distinctiveness through extensive use.

In addition to the absolute grounds listed above, registration will be refused on relative grounds if the mark for which registration is sought:

- is identical to an earlier trademark for identical goods or services;
- is identical to an earlier trademark for similar goods or services, where there is a risk of public confusion;
- is similar to an earlier trademark for identical or similar goods or services, where there is a risk of public confusion, including the risk of association with the earlier trademark;
- is identical or similar to a well-known mark in Romania used for identical or similar goods or services; or
- is identical or similar to a well-known mark in Romania used for dissimilar goods or services, where unlawful use of the later mark might take advantage of the distinctiveness or repute of the well-known trademark, or might otherwise prejudice the owner of the well-known trademark.

Moreover, a sign cannot be registered as a trademark if it infringes other prior rights, such as:

- the rights of a personality to his image or name;
- a protected geographical indication;
- a protected industrial design or model;
- a copyright; or
- any other industrial property right acquired prior to the date of the trademark application.

4. Procedures

Examination

To register a trademark, a written application must be filed with the State Office for Inventions and Trademarks (SOIT). The application should contain specific information (eg, the applicant's name and details, and evidence that the registration taxes have been paid), as well as a reproduction of the trademark and identification of the

classes of goods and services in which registration is sought.

SOIT will first examine the application to ensure that it satisfies all formal requirements, and will then conduct an examination on the merits to verify compliance with the conditions established by the Trademarks Law, such as distinctiveness, and identify any conflicting registrations.

Within one month of filing, SOIT will grant the deposit date, which is one of the following:

- the date on which the trademark application was filed;
- the date on which an application for the same trademark was filed in a Paris Convention country or member of the World Trade Organization (in order to benefit from such priority, the Romanian application must be filed within six months of the initial application); or
- the date on which goods or services protected by the trademark were put on display in an international exhibition organized in Romania or a Paris Convention country (in order to benefit from such priority, the Romanian application must be filed within six months of the exhibition date).

In principle, SOIT will carry out a substantive examination of the trademark application within six months of payment of the registration and examination; in practice, this may take up to nine months. If a trademark is refused registration on absolute or relative grounds, SOIT will notify the applicant accordingly. The applicant may file observations and comments within three months of such notification. A final refusal may be contested before the SOIT Re-examination Committee.

Searches

SOIT offers trademark searches as a paid service to interested parties, in addition to the trademark database freely available on its website (<http://bd.osim.ro/marci/index.jsp>). The timing of performance varies between two working days and one month (depending on the requested urgency – if urgent, certain trademark searches could be carried out in two hours), while the costs of such searches depend

on the object matter and classes covered. The costs are between €23 for an identical trademark search for one mark in one class with the results in two working days and €875 for a similar trademark search including word and graphic trademarks in all classes with the results in two working days. Nevertheless, taking into consideration the limitations of scope of the SOIT searches, it is advisable to run a parallel trademark search through a licensed Romanian trademark attorney.

Opposition

If a trademark passes the formal and substantive examinations, SOIT will register the trademark and publish the registration in the *Official Bulletin for Industrial Property*. Trademarks should be published within two months of the decision to register the trademark. Interested parties may oppose the registration within three months of publication. The SOIT Examination Commission will examine the opposition. The commission's decision may be appealed to the Re-examination Committee. The resolution of an opposition by the SOIT Examination Commission may take up to six months, while the resolution of an appeal filed with the Re-examination Commission may take up to eight months.

Registration

If no opposition is filed, or if all oppositions are rejected, SOIT registers the trademark in the National Trademark Register. The registration process may take up to 12 months, depending on whether oppositions are filed.

A trademark remains valid for 10 years and may be renewed indefinitely for consecutive 10-year periods.

Removal from register

Surrender: A trademark owner may surrender the trademark with respect to some or all of the goods or services for which it is registered. The owner must declare the surrender to SOIT; the rights in the trademark will lapse from the date on which the surrender is recorded in the National Trademark Register. If a licence has been registered, the surrender will be recorded only if the trademark owner proves that it has advised the licensee of its intention to surrender the trademark.

The surrender must also be published in the *Official Bulletin for Industrial Property*.

Revocation: On July 23 2003 the first five-year grace period for trademark use granted under the Trademarks Law expired. From this date onwards, anyone with a legitimate interest may request the court to deprive a trademark owner of its rights if its mark was not effectively used in Romania within five years, without legitimate reason.

The use obligation imposed by the Trademarks Law reflects the international treaties to which Romania is a signatory. The obligation, as well as the penalties for non-use set out in the Trademarks Law, closely follow the provisions of the EU First Trademark Directive.

The following acts constitute genuine use of a trademark under the law:

- use of the trademark by a third party with the consent of the trademark owner;
- use of the trademark in a form that differs in certain respects from the registered trademark, but which does not jeopardize its distinctive character;
- affixing of the trademark on goods or their packaging solely for export purposes; and
- sale or offer for sale, as well as promotional activities for the goods and/or services to which the trademark refers.

Legitimate reasons for non-use include circumstances beyond the control of the trademark owner (eg, import restrictions or other government requirements for goods or services protected by the trademark).

As opposed to the general principles of Romanian civil procedure, the Trademarks Law reverses the burden of proof in this respect: it is the trademark owner, not the interested third party, which must provide the court with evidence of use (or legitimate reasons for non-use). This reversed burden of proof applies not only in judicial proceedings (a legal action to deprive the trademark owner of its rights under the mark on the grounds of non-use), but also in other proceedings in which the trademark owner is alleged to have taken advantage of its rights (prosecution/administrative proceedings).

Under the Trademarks Law, revocation of a registered trademark may also be requested before a court of law if:

- as a result of the trademark owner's actions or inactivity, the trademark has become

usual in the trade of goods or services for which it is registered;

- as a result of its use by the trademark owner or with the trademark owner's consent, the mark has become liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services for which it is registered; or
- the trademark was registered by someone who did not have the legal capacity to do so.

Invalidation: Generally, any interested party may file a legal action with the Bucharest court seeking cancellation of a trademark registration on any of the following grounds:

- There were absolute grounds for refusal at the time of registration;
- There were relative grounds for refusal at the time of registration;
- The registration was applied for in bad faith;
- The registration infringes the image rights or name of a person; or
- The registration infringes earlier rights acquired in a protected geographical indication or a protected industrial design, other industrial property rights or copyright.

The limitation period for a legal action seeking cancellation of a trademark registration is five years as from the date of registration, except where the registration was applied for in bad faith, in which case an action may be brought at any time during the term of protection.

5. Enforcement

Complexity

Trademark rights are enforced under the Trademarks Law and secondary legislation on unfair competition, advertising and border measures. In addition, certain acts are regulated by the statutory acts and not by the specialized legislation – for example, counterfeiting is established as a criminal offence by the Criminal Code, expedited procedures may be instituted under the Civil

Procedure Code and damages may be requested in accordance with the provisions of the Civil Code. It follows that both the legal grounds for enforcement and the remedies available to trademark owners are complex, and must be carefully considered on a case-by-case basis. The only distinction between registered and unregistered rights, in terms of complexity, is that the evidentiary burden may be heavier in the case of unregistered rights, and the case may thus take longer to progress.

Generally, the Trademarks Law provides the owners of registered trademarks with both civil and criminal remedies.

In the case of unauthorized use of a registered trademark, the owner may request the competent judicial authority to prohibit third parties from engaging in any act that constitutes an infringement of its rights under the Trademarks Law. In this respect, the trademark owner may request the court to forbid any unauthorized third party from using in the course of trade any sign which, because of its identity or similarity to the trademark, or because of the identity or similarity of the goods or services on which it is affixed to those for which the trademark is registered, could create a confusion on the part of the public, including a likelihood of associating the sign with the trademark.

Apart from the civil action, the owner of a registered trademark may also file a criminal petition against the infringer, who may be punished by imprisonment of up to three years; where a civil damages action is incorporated in the criminal complaint proceedings, the infringer may also be liable to pay damages.

In accordance with the provisions of the Unfair Competition Law, anyone who contravenes honest commercial or industrial practices may be enjoined, by the court, to desist or refrain from the act in question. The Unfair Competition Law further qualifies as a criminal offence the use of “a trademark, geographical indication, industrial design or model... any special sign or any packaging which may create confusion with that legitimately used by another merchant”. The infringer may be punished by up to two years’ imprisonment or a criminal fine; where a civil damages action is incorporated in the criminal

complaint proceedings, the infringer may also be liable to pay damages.

Under both the Trademarks Law and the Unfair Competition Law, a trademark owner has the right to request the court to order pre-judgment attachments or other temporary measures by way of a preliminary injunction. The trademark owner may thus request a preliminary injunction that would temporarily prohibit the infringer from marketing goods or services bearing the infringing signs, or from other acts or omissions that may further prejudice the trademark owner's rights. In order to be entitled to such relief, the trademark owner must demonstrate that:

- there is an urgent need for the requested measures;
- the request will not prejudice the case on the merits; and
- the requested measures are temporary in nature.

A preliminary injunction may be issued without hearing the other party.

Finally, the Border Measures Law provides that a trademark holder (as well as the holders of other IP rights) may request Romanian Customs to suspend customs operations and seize goods that are suspected of infringing its rights based on an accepted application for customs action.

Timeframe

The duration of court proceedings for the enforcement of trademark rights varies, depending on the complexity of the case and the behaviour of the alleged infringer. In practice, if all possibilities of appeal are exhausted, it may take more than three years to obtain a final and binding decision.

The duration of a criminal action will also be extended by the period necessary for the completion of the police investigation and for examination of the file by the Prosecutor's Office.

6. Ownership changes and rights transfers

As a general rule, the Trademarks Law provides that rights in a trademark may be transferred by assignment or licence at any time during

the term of protection; such rights may be assigned independently of the business in which the trademark is incorporated.

An assignment must be effected in writing and signed by the parties to the assignment, under threat of nullification. The assignment may be effected for all or only some of the goods or services for which the trademark is registered. However, unlike a licence, an assignment may not limit use of the trademark for the goods or services to which it applies to a given territory. The Trademarks Law also contains a specific clause on the assignment of identical or similar trademarks: identical or similar trademarks that have the same registered owner and which are used for identical or similar goods or services may be assigned only as a whole and to one person, under threat of nullification of the assignment.

According to the Trademarks Law, an assignment must be registered in order to become opposable against third parties. Such registration does not concern the existence of the agreement *per se*, but rather affords the trademark owner and licensee the opportunity to publicize the existence of the agreement.

Assignments and licence contracts need not be legalized in order to be valid or registered with SOIT, except for translations into Romanian where these are filed with SOIT for opposability purposes. Registration proceedings with SOIT may take up to three months, from filing of the request to publication in the *Official Bulletin for Industrial Property*.

7. Related rights

The main areas of overlap between trademarks and other IP rights concern copyrights and industrial designs. In this respect, the owner of an earlier right in a protected industrial design or copyright may file an opposition against a published trademark or a cancellation action against a registered trademark.

Generally, the Romanian IP legislation recognizes that artistic creations which are applicable to industrial products are eligible for dual protection. The Copyright Law (8/1996) protects literary, scientific and artistic creations, regardless of the mode or form of expression.

No formal requirements apply: intellectual creations are recognized and protected under the Copyright Law through the mere fact of their creation, if such are original, even if unfinished. In this respect the Romanian copyright system diverges from legal systems in which copyright protection is granted through registration. This national regime is applicable in Romania to any party to the Berne Convention (with minor differences).

The Design and Models Law (129/1992) protects the creative act of designing the formal or ornamental appearance of a product which satisfies aesthetic requirements. According to the Design Law, the object of protection is in this respect the exterior aspect of a product, or part of a product, which results from the combination of its main features, especially lines, shapes, patterns, colours, forms, texture and/or materials and/or ornamentation. Design protection is granted through registration.

Rules of the Internet Corporation for Assigned Names and Numbers (ICANN). Accordingly, any person or entity wishing to register a '.ro' domain name must consent to ICANN's rules and policy, which provide, among other things, that disputes over domain names are decided by arbitration panellists.

8. Online issues

At present, there are no specific legal provisions on the unauthorized use of registered or unregistered trademarks in metatags, links and frames, or through cybersquatting. Although in the past three years the Romanian legislature has gone some way towards addressing the lack of internet-related regulations by issuing laws on e-commerce, e-signatures, data protection and IT crimes, the unauthorized online use of trademarks is not yet mentioned as a specific crime.

Therefore, when bringing a court action against an infringer that is abusively using a trademark on the Internet, or that has registered and is using an infringing domain name, the trademark owner should make a special effort to address each specific item raised by the 'virtual' nature of the offence (eg, jurisdiction *in rem* and *in personam*, burden of proof), and to analyze the applicable common, general rules of the Romanian legislation (ie, the Civil Code and the Trademarks Law).

The Central Institute of Information Technologies, which manages the '.ro' country-code top-level domain, applies the Uniform Domain Name Dispute Resolution Policy and

Unregistered rights	
Protection for unregistered rights?	only for well-known marks and corporate names 
Specific/increased protection for well-known marks?	
Examination/registration	
Representative requires a power of attorney when filing? Legalized/notarized?	 / 
Examination for relative grounds for refusal based on earlier rights?	
Registrable unconventional marks	3-D, animations, colours, sounds 
Opposition	
Opposition procedure available? Term from publication?	3 months 
Removal from register	
Can a registration be removed for non-use? Term and start date?	5 years' non-use 
Are proceedings available to remove a mark that has become generic?	
Are proceedings available to remove a mark that was incorrectly registered?	
Enforcement	
Specialist IP/trademark court?	specialist panels of Bucharest Appeal Court and Supreme Court exist 
Punitive damages available?	
Interim injunctions available? Time limit?	
Ownership changes	
Is registration mandatory for assignment/licensing documents?	mandatory for action against third parties  / 
Online issues	
National anti-cybersquatting provisions?	
National alternative dispute resolution policy (DRP) for local ccTLD available?	UDRP applies directly 