Romania

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Legal framework

National

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

- the Law on Trademarks and Geographical Indications (84/1998), as republished and further modified and amended;
- Government Decision 1134/2010 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), as republished;
- the Advertising Law (148/2000, as further modified and amended); and
- the Misleading and Comparative Advertising Law (158/2008), as republished.

The applicable statutory law and principles are set out in the Civil and Criminal Codes and the Civil and Criminal Procedure Codes.

International

Romania is a party to the following international trademark treaties:

- the Paris Convention for the Protection of Industrial Property;
- the World Intellectual Property Organisation 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.

In addition, Romania joined the European Union on January 1 2007, meaning that Community trademark legislation also applies.

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, it 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; and
- well-known trademarks.

Registered marks

Ownership

The Trademarks Law imposes no special requirements on the applicant or owner of 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 an undertaking from those of other undertakings".

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

- marks that cannot qualify as trademarks within the sense mentioned above;
- 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 contain, without the owner's consent, the likeness or surname of a well-known person in Romania; and
- 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 6*ter* of the Paris Convention.

Absolute grounds for refusal of registration because a mark is not distinctive 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, among other things, the mark for which registration is sought:

- is identical to an earlier trademark for identical goods or services;
- is identical or 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

“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”

with the earlier trademark;
- is identical or similar to an earlier Community trademark for goods or services that are not similar to those in relation to which the earlier Community trademark is registered, where the earlier Community trademark enjoys a certain reputation in the European Union and the use of the subsequent trademark would confer an undeserved advantage deriving from either the distinctive character or reputation of the earlier Community trademark;
- is identical or similar to an earlier trademark registered in Romania and is meant to be registered or is already registered for goods and services that are not similar to those for which the earlier trademark was registered, where the earlier trademark enjoys a certain reputation in Romania and the use of the subsequent trademark would confer an undeserved advantage deriving from either the distinctive character or reputation of the earlier trademark;
- is applied for after another user has obtained rights in an unregistered trademark or another sign used in commerce, or, as the case may be, claims a priority date later than that on which rights were obtained in the unregistered sign, where the unregistered trademark or sign grants its titleholder a right to forbid the use of the subsequent trademark;
- is identical or similar to an earlier registered trademark for identical or similar products or services, granting a right that expired due to non-renewal over two years before the filing date, if the titleholder of the earlier trademark either agreed to the registration of the subsequent trademark or had not used its trademark; or
- may be confused with a trademark used abroad at the filing date and which continues to be used there, if the filing has been made in bad faith by the applicant.

Moreover, a sign cannot be registered as a trademark if it infringes other prior rights, such as previously registered/filed trademarks, protected in the Romanian territory.

Procedures

Examination

To register a trademark, a written application must be filed with the State Office for Inventions and Trademarks (SOIT) under the conditions provided by the Trademarks Law.

SOIT will first examine the application to ensure that it satisfies all formal requirements and then specify a deposit date within one month of filing.

A trademark application is electronically published within seven days of filing with SOIT. Within two months of electronic publication of a trademark application, any interested person may file an opposition to the registration or observations regarding the application based on the above-mentioned relative grounds. In addition, within the same timeframe an interested person may file observations regarding the trademark application based on the above-mentioned absolute grounds.

The opposition is examined by a SOIT commission, which will issue a notification of acceptance or refusal of the opposition, which is binding at the substantive examination of the trademark application.

In principle, SOIT carries out a substantive examination of the trademark application within six months of electronic publication of the

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trademark application, as long as the registration and examination fees have been paid. An expedited procedure is also available upon payment of a supplementary emergency fee.

According to the Trademarks Law as currently in force, during the substantive examination, SOIT cannot perform an *ex officio* examination of the relative grounds for refusal for registration of a trademark. These grounds should be taken into account only if an opposition has been filed. Despite the legal provisions, SOIT follows in practice an internal act without a normative value which cannot modify the Trademarks Law, namely Instruction 5/17.10.2012, according to which SOIT examiners perform an *ex officio* examination based on relative grounds even if no opposition had been filed.

Following the substantive examination, SOIT will issue a decision of acceptance or refusal of the trademark for registration.

If SOIT accepts the trademark for registration, the mark will be published electronically within two months of this decision.

Searches

SOIT offers trademark searches as a paid service to interested parties, in addition to the trademark database which is freely available on its website (bd.osim.ro/marci/index.jsp). Taking into consideration the limited scope of SOIT searches, it is advisable to run a parallel trademark search through a licensed Romanian trademark attorney.

Contestation

SOIT's decision to accept or refuse a trademark for registration may be contested by any interested party within 30 days of its communication or publication, before SOIT's Contestations Committee. The decision of SOIT's Contestations Committee may be further appealed before the competent courts.

Registration

SOIT will record in the Trademarks Register the trademark in relation to which a registration decision has been issued, upon payment of the legal fees. After this registration, SOIT will issue the trademark registration certificate.

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

Removal from the register

Surrender: A rights holder may surrender the rights with respect to some or all of the goods or services for which it is registered. If a licence has been registered, the surrender will be recorded only if the owner proves that it has notified the licensee of its intention to surrender the trademark.

Revocation: Anyone with a legitimate interest may request the court to deprive a trademark owner of its rights if, without legitimate reason, the mark was not effectively used in Romania within an uninterrupted period of five years as from registration of the trademark in the Trademarks Register, or if this use has been suspended for an uninterrupted period of five years.

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).

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

- as a result of the rights holder'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 rights holder or with the rights holder'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 Tribunal 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.
- The registration infringes earlier rights acquired in a protected geographical indication or a protected industrial design or model, other industrial property rights or copyright.

The limitation period for a legal action seeking cancellation of a trademark registration is five years 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.

"Although 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 unauthorised online use of trademarks has not yet been mentioned as a specific crime"

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 statutory acts and not by specialised legislation. It follows that both the legal grounds for enforcement and the remedies available to rights holders 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 owners of registered trademarks with both civil and criminal remedies.

In the case of unauthorised 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.

Apart from the civil action, the owner of a registered trademark may also file a criminal petition against the infringer, who may be subject to imprisonment for up to three years 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.

In accordance with 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 subject to 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, as well as under the Civil Procedure Code, a rights holder has the right to request the court to order a preliminary injunction. The rights holder 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 rights holder's rights.

A preliminary injunction may be issued without hearing the other party. However, this is not a common practice.

Finally, the Border Measures Law provides that a rights holder 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 around two years to obtain a final and binding decision.

The duration of a criminal action will also be extended by as long as is necessary to complete the police investigation and for the Prosecutor's Office to examine the file.

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 mark 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 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 publicise the agreement's existence.

SOIT may refuse to register a trademark assignment if it obviously misleads the public as to the nature, quality or geographical origin of the products or services for which the trademark has been registered, except where the beneficiary of the assignment agrees to limit the trademark assignment to the products and services for which the trademark is not misleading.

Registration proceedings with SOIT may take up to three months.

Related rights

The main areas of overlap between trademarks and other IP rights concern copyright 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, Romanian IP legislation recognises artistic and intellectual creations for dual protection. The Copyright Law protects literary, scientific and artistic creations, regardless of the mode or form of expression. No formal requirements apply: intellectual creations are recognised and protected under the Copyright Law through the mere fact of their creation, if they are original.

The Design and Models Law protects the creative act of designing the formal or ornamental appearance of a product that 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 and does not exclude protection through a trademark registration.

Online issues

There are no specific legal provisions governing the unauthorised use of registered or unregistered trademarks in domain names, metatags, links and frames. Although 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 unauthorised online use of trademarks has not yet been mentioned as a specific crime.

The National Institute for Research and Development in Informatics, which manages the '.ro' country-code top-level domain, applies the Uniform Domain Name Dispute Resolution Policy and 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 may be decided by arbitration panellists. WTR

Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Non-traditional marks registrable?
Yes/No	Yes: officially only on opposition; in practice, SOIT performs *ex officio* examination on relative grounds.	Yes: 3D; colours; combination of colours; holograms; sound signals.

Unregistered rights

Protection for unregistered rights?	Specific/increased protection for well-known marks?
Yes: notorious trademarks.	Yes

Opposition

Can a registration be removed for non-use? Term and start date?
Yes: two months from date of electronic publication.

Removal from register

Can a registration be removed for non-use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
Yes: deprivement action after five years' non-use from registration date.	Yes	Yes

Enforcement

Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
No: but specialist panels of Bucharest Appeal Court and Supreme Court exist.	Yes	Yes/No

Ownership changes

Mandatory registration for assignment/licensing documents?
No/No: registration mandatory for opposability against third parties.

Online issues

National anti-cybersquatting provisions?	National alternative dispute resolution policy (DRP) for local ccTLD available?
No	No: UDRP rules apply directly.

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Ana-Maria Baciu is an experienced attorney who advises clients on all aspects of trademarks, design rights, copyright and related rights, patents, advertising and sponsorship, and domain name arbitration proceedings. She also specialises in pharmaceutical, consumer protection and gaming matters. Ms Baciu has 14 years' experience in assisting prominent individuals and companies in a variety of industries (especially pharmaceuticals, gaming, software, tobacco and fast-moving consumer goods), and is a regular contributor to specialised publications, as well as a lecturer on IP and gaming matters. She is a licensed European trademark and design attorney, a member of the Romanian National Chamber of Industrial Property Attorneys.



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Delia Belciu is qualified as an attorney at law and licensed as a European trademark and design attorney. She has extensive expertise in arbitration proceedings with respect to domain names and is experienced in all aspects of trademarks, designs, copyright and related rights, as well as in information technology, media, e-commerce and advertising. She also provides extensive advice to clients on healthcare and pharmaceutical legislation, as well as on consumer protection matters.

A member of the Romanian National Chamber of Industrial Property Attorneys and of the Bucharest Bar, Ms Belciu is also an active member the European Communities Trademark Association's Professional Affairs and Internet Committees.