

Romania

Trademark registration applications in ‘no-man’s land’

Introduction

The amended Romanian Trademark Law came into force on May 10 2010. The new law aims to be fully harmonised with the EU Trademarks Directive (2008/95/EC), although it also contains some original provisions.

The new law:

- introduces new types of sign (eg, holograms and sound signals) into the definition of ‘trademark’;
- slightly changes the definition of ‘notorious trademark’ – it specifically states that it is sufficient to demonstrate that a trademark is recognised by Romanian consumers, without additional conditions of registrability or use; and
- amends the trademark opposition procedure.

Trademark opposition procedure

Absolute grounds for refusal

ROPTO will no longer conduct the examination of relative grounds. Instead, it will examine only the absolute grounds for refusal. Two new provisions have been added to the existing grounds, namely:

- refusal of a trademark if it contains signs of high symbolic value (religious symbols in particular); or
- refusal of a trademark if it contains, without permission from the competent authorities, badges, emblems, coats of arms or escutcheons other than those covered by Article 6 of the Paris Convention.

Observations regarding the absolute grounds may also be filed within the two-month term by any interested party (however, according to the same regulations, the person referred to cannot have the status of a party to the examination procedure and shall receive

no communication from ROPTO). The observation will be notified to the applicant, which may present its comments within the examination procedure. The observation shall be analysed during the procedure of examination of the trademark registration application.

Relative grounds for refusal

Within two months of the trademark application’s publication date (which, according to the implementing regulations, will be provided in electronic format on the website of the Romanian Patent and Trademark Office (ROPTO) within seven days from the filing date of the request), any interested party may file an opposition against the registration of the trademark on the basis of relative grounds. Previously, the term for opposition was three months.

Apart from the standard grounds that refer to the identity or similarity of goods, and the notoriety of trademarks for identical, similar or different goods, the new relative grounds set out by the law cover earlier rights concerning:

- a name;
- an image;
- a copyright;
- a collective mark conferring a right which has expired, within three years after its expiration date;
- a certification mark whose validity has lapsed, within 10 years after its expiration date;
- earlier trademarks registered for identical or similar goods or services;
- a trademark which has expired through failure to renew, within two years after its expiration date; and
- the right in a trademark which was in use abroad and which continues to be used there, where the application was made in bad faith by the applicant.

The applicant will be notified of the opposition. Within 30 days of the date of notification, it may file

its arguments in defence of the application (the term is extendible up to 30 days).

The opposition will be examined during the examination procedure of the trademark registration application and settled by a board of three specialists (appointed by the head of the Trademark Division), one of whom will be the examiner of the application. The board will issue a notice on whether to accept or reject the opposition – either wholly or partially – and this will be closely examined when determining whether to accept or reject a trademark registration.

Appeal procedure

Interested parties can appeal ROPTO's decision on the application within 30 days of the registration's communication or publication, upon the payment of the legal fee. Previously, the term for appeal was three months.

Registration

If the examination of the application shows that the conditions prescribed by law are satisfied, ROPTO will then proceed to registration. Subsequently, the trademark will be published in electronic format on the *Industrial Property Bulletin* website within two months of the date of the registration decision. Thereafter, the State Office for Inventions and Trademarks will issue the trademark registration certificate, but only after payment of the publication and issuance fee.

Also, the implementing regulations provide that the recordal of the trademark registration in the Trademark Register, the publication thereof and the issuance of the trademark registration certificate will be subject to payment of a single fee.

It is at this point that trademark registration applications can enter 'no-man's land'.

Registration and invalidation ambiguity

The practice notice states that even if an opposition is not filed within the two-month period, an appeal may be filed "by any interested party" (other than the opponent, any other party may also be considered as 'interested') and thus accepted and examined, following the appeal procedure under the judgment of the Re-examination Commission.

However, the legal text refers to two instances when the appeal term may be limited, namely:

- "within 30 days from communication" in instances of a previously filed opposition; and
- "within 30 days from the publication of the

trademark registration", since the trademark should be published for registration within two months of the date of the registration decision.

The recordal of the trademark registration in the Trademark Register, the publication thereof and the issuance of the trademark registration certificate are all subject to the payment of a single fee. A trademark enters 'no-man's land' when an applicant fails to pay the single fee that is required for the trademark's final registration.

As there is no legal term within which the payment must be submitted and no penalty for non-payment, the applicant cannot be forced to pay the fee. This means that:

- no appeal may be filed against a registration decision issued by ROPTO until this decision is published in the *Official Gazette*; and
- no registration will be recorded in the Trademark Register until the fee is paid.

If a trademark is not registered or published for registration and no certificate is issued, then what other means are in place – apart from the appeal procedure – to protect earlier rights?

The law provides the possibility for any concerned persons to apply to the Bucharest Law Court to invalidate a trademark's registration on various grounds, including:

- a registration contrary to any of the absolute or relative grounds;
- a registration applied for in bad faith, infringement of personal portrayal or name;
- a protected geographical indication or a protected design; or
- other industrial property rights or copyright.

The time limit for requesting a registration's invalidation is five years from the trademark's registration date. This excludes requests for invalidating applications that have been made in bad faith, as these may be filed at any time.

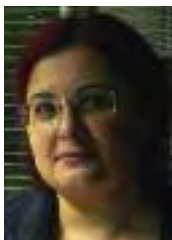
When it comes to relying on the five-year term from the registration date (as long as it is an unpublished decision for a trademark registration that is being dealt with), and the provisional and protective measures taken against such applications for invalidation, the following questions must be asked: Should the trademark be published for registration in order to enable third parties to initiate actions to protect earlier IP rights? Or will it be sufficient that the trademark be published as a mere application?

Comment

Although the new law has been in force for over a year now, undetermined trademark registration applications are a controversial topic that is still being highly debated. Until the courts rule on this issue, applications whose fees have not been paid will

remain ambiguous.

In the meantime, in order for registered IP rights to be better protected, it is important that interested parties monitor the first publication of newly filed applications so that they can file oppositions against any potentially infringing trademarks.



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Denisa Markușev has a BA in law and an MA in EU integration. She is a qualified European trademarks attorney and has been a member of the trademarks department since 1999. Her specific expertise focuses on trademark registration and prosecution. She is also involved in various works within IP organisations.