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A global guide for practitioners

Romania
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1. 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;
- 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).

The applicable statutory law and principles are set out in the Civil and Criminal Codes and the Civil and Criminal Procedure Codes. For example, in trademark infringement cases a preliminary injunction may be sought under the Trademarks Law, but the legal conditions subject to which this may be obtained are summarised 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 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 (TRIPs).

In addition, as Romania joined the European Union on January 1 2007, the related Community trademark legislation is applicable in Romania.

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, 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
- notorious trademarks – defined under the Trademarks Law as a mark that is largely known in Romania 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 in order to be opposed. The opposed trademarks must be notorious on the filing or priority date of a trademark application.

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 an undertaking from those of other undertakings”. The Trademarks Law 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 – colours, colour combinations, holograms, sound signals and combinations thereof.

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 6ter of the Paris Convention.

The absolute grounds for refusal of registration because the 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 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, when 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 that is later than the date on which rights were obtained in the unregistered sign, where the unregistered trademark or sign grants its titleholder a right to forbid 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, under the condition that the titleholder of the earlier trademark either agreed to the registration of the subsequent trademark or had not used the trademark; and
- 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 by the applicant in bad faith.

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.

4. 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. 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 Organisation (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 organised 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).

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

The opposition is examined by a SOIT commission that 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 a maximum of six months from electronic publication of the trademark application, under the condition that the registration and examination fees be paid. An expedited procedure is available upon payment of a supplementary emergency fee. In this case, SOIT carries out the substantive examination within three months of electronic publication of the trademark application.

During the substantive examination, SOIT does not perform an *ex officio* examination of the relative grounds for refusal for registration of a trademark. These grounds are taken into account only if an opposition has been filed. As a result of the substantive examination, SOIT issues a decision of acceptance or refusal of the trademark for registration. Within a maximum of two months from this decision, the trademark is electronically published.

Searches

SOIT offers trademark searches as a paid

service to interested parties, in addition to the trademark database that is freely available on its website (bd.osim.ro/marci/index.jsp). The timeframe ranges from two working days to one month, depending on the request (although if urgent, certain trademark searches can even be carried out in two hours); while the costs of such searches depend on the type of sign and classes covered. The costs range from €23 for an identical trademark search for one mark in one class, with the results provided in two working days, to €875 for a similar trademark search including word and graphic trademarks in all classes, with the results provided in two working days. Nevertheless, 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 acceptance or refusal of 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 records in the Trademarks Register the trademarks in relation to which a registration decision has been made, upon payment of the legal fees. After this registration, SOIT issues the trademark registration certificate. Normally, the registration process may take up to nine months and seven days if no oppositions or contestations are filed, or six months and seven days in case of an expedited procedure if no oppositions or contestations 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. If a licence has been registered, the surrender will be recorded only if the trademark 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 the registration of the trademark, or if this use has been suspended for an uninterrupted period of five years.

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 or by any person empowered to use a collective trademark or a certification trademark;
- use of the trademark in a form that differs in certain respects from the registered trademark, but does not jeopardise its distinctive character;
- affixing of the trademark on goods or their packaging solely for export purposes; and
- impossibility to use the trademark determined by circumstances that are independent from the rights holder, such as import restrictions or decisions of the public authorities that concern the products or services for which the trademark has been registered.

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 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 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; or
- 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.

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 specialised 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 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, which may be punished by imprisonment of up to three years or face 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 that 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 a preliminary injunction. The trademark owner may thus request such an injunction as 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 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 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 existence of the agreement.

SOIT may refuse to register a trademark

assignment if it results, in an obvious manner, in the public being induced in error 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 accepts to limit the trademark assignment to the products and services for which the trademark is not misleading.

Assignments and licence contracts need not be legalised 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 for publication in the *Official Bulletin for Industrial Property*.

7. 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, the Romanian IP legislation recognises artistic and intellectual creations 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 recognised and protected under the Copyright Law through the mere fact of their creation, if they 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 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.





8. 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.




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 analyse 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 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 will be decided by arbitration panellists.

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?
 / 	Only upon opposition filed by interested third parties within given timeframe 	3-D, animations, colours, sounds 

Unregistered rights		Opposition
Protection for unregistered rights?	Specific/increased protection for well-known marks?	Opposition procedure available? Term from publication?
For notorious trademarks 		2 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?
Through deprivation action after 5 years' non-use 		

Enforcement		
Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
But specialist panels of Bucharest Appeal Court and Supreme Court exist 		No limit 

Ownership changes	Online issues	
Mandatory registration for assignment/licensing documents?	National anti-cybersquatting provisions?	National alternative dispute resolution policy for local ccTLD available?
Registration mandatory for opposability against third parties  / 		UDRP rules apply directly 



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Ana-Maria Baci heads the IP counselling division, in addition to managing the consumer protection, pharmaceutical and healthcare and gaming practices. A highly experienced attorney, she advises clients on all aspects of trademark rights, design rights, copyright and related rights, patents, advertising and sponsorship, as well as arbitration proceedings with respect to domain names. Ms Baci has 12 years' experience in assisting prominent individuals and companies in a variety of industries and is a regular contributor to specialised publications, as well as lecturing on IP matters. A licensed European trademark and design attorney, Ms Baci is a member of the Romanian National Chamber of Industrial Property Attorneys, the Bucharest Bar, of the International Trademark Association and the European Communities Trademark Association (ECTA).



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Delia Belciu is qualified as an attorney at law and licensed as a European trademark and design attorney. She has acquired extensive expertise in arbitration proceedings with respect to domain names and is highly experienced in all IP matters on trademark rights, design rights, copyright and related rights matters, as well as in advertising and promotion. A member of the Romanian National Chamber of Industrial Property Attorneys and of the Bucharest Bar, Delia is also an active member of the Internet Committee of ECTA.