

Romania

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Nestor Nestor Diculescu Kingston Petersen

INTELLECTUAL PROPERTY COUNSELING

Our passion for intellectual property translates into first-class IP services. NNDKP's team of experts focuses on providing you with commercially driven solutions and tailors the most appropriate strategy for the success of your ideas. With NNDKP's 360 legal & tax approach, you can protect your ideas that can change the world.

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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 1 January 2007, meaning that the EU Trademark Regulation (2017/1001) and its delegated and implementing regulations,

the EU Trademarks Directive (2015/2436) and the EU Regulation (608/2013) concerning customs enforcement of IP rights also apply. The provisions of the Trademarks Directive are yet to be transposed into national law. In this respect, a legislative proposal is currently under debate in Parliament (as the decisional chamber).

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 the need to show genuine use. However, if an application is refused registration for lack of distinctive character, the refusal can be overcome if the mark has acquired distinctive character through prior use on the market.

While use is not a condition for obtaining trademark rights, there is a non-use grace period of five years from the registration date. Thus, genuine use is required to maintain the trademark registration (if contested on non-use), to enforce the mark in administrative opposition procedures (if the opponent is requested to show genuine use), as well as to establish infringement.

The protection afforded to unregistered marks is thus limited to:

- signs covered by other IP rights; and
- well-known trademarks.

In order for a trademark to be considered well known, it must be widely known in Romania among the relevant segment of consumers of the goods or services to which the trademark is applied.

Registered marks

Ownership

The Trademarks Law imposes no special requirements on the applicant or trademark owner, except for the case of certification marks, which can be applied for only by the authorised certification bodies.

Representation

If a representative is appointed, an original, signed power of attorney must be filed before the authority. It does not require notarisation or legalisation.

Scope of protection

Protected: A ‘trademark’ is defined as “any sign that is susceptible to graphical representation capable of distinguishing the goods or services of an undertaking from those of other undertakings”.

Not protected: The following, among others, are excluded from trademark protection under the national law:

- signs that cannot qualify as trademarks within the above definition;
- signs that lack distinctive character;
- marks consisting exclusively of signs or indications that have become customary in the current language or *bona fide* 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 offering of the services, or other characteristics thereof;
- marks consisting exclusively of the shape of goods imposed by their nature or necessary to obtain a technical result or which give substantial value to the goods;
- marks liable to mislead the public towards 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 from the place indicated;
- marks containing, without consent, the image or surname of a well-known person in Romania; and
- marks containing, without the consent of competent authorities, reproductions or imitations of armorial bearings, flags, state emblems, signs, official hallmarks of control and warranty and coats of arms belonging to member states of the Paris Union and which are governed by Article 6ter of the Paris Convention.

In addition to the absolute grounds listed above, registration will be refused on relative grounds if, among other things, the mark applied for:

- 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 likelihood of confusion, including the likelihood of association with the earlier trademark;
- is identical or similar to an earlier EU trademark for goods or services that are not similar to those in relation to which the earlier EU trademark is registered, where the earlier EU trademark enjoys a reputation in the European Union and the use of the subsequent trademark would generate an unjustified profit deriving from either the distinctive character or reputation of the earlier EU 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 reputation in Romania and the use of the subsequent trademark would generate an unjustified profit deriving from either the distinctive character or reputation of the earlier trademark;
- conflicts with a third party's earlier rights in an unregistered trademark or another sign used in commerce or, as the case may be, invokes a priority date subsequent to the rights over the unregistered trademark or sign, where such earlier rights grant to their holder the right to forbid the use of the subsequent trademark;
- is identical or similar to an earlier registered trademark for identical or similar goods or services, granting a right that expired for non-renewal within the two years prior to the filing date, if the holder of the earlier trademark either did not agree to the registration of the subsequent trademark or 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 application was made in bad faith by the applicant.

Procedures

Examination

To apply for trademark protection, an online or paper application can be filed with the State Office for Inventions and Trademarks (SOIT). SOIT will perform an initial formal examination of the application and assign a deposit number and date to the application.

Applications accompanied by the official publication fee are published in the e-bulletin within seven days from the filing date. In principle, SOIT further carries out a substantive examination of the trademark application within six months of its first publication date, as long as the examination fees have been paid.

Opposition/observations

Interested persons may file oppositions on relative grounds or observations on absolute grounds against a trademark application within a two-month period following its publication in the e-bulletin.

Oppositions are notified to the applicants, which can file a response in defence within 30 days of the communication date.

The opposition case is examined by a SOIT committee, which will issue a notice of acceptance or refusal that is binding to the substantive examination of the application. When observations are filed and considered pertinent by SOIT, a provisional refusal notice is issued inviting the applicant to file its response within three months of the communication date.

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

Searches

SOIT offers several trademark search services available to the public for specific fees. Also, the trademark database is publicly accessible on the authority's website (<http://api.osim.ro:8083/TMreg/simpleSearch>).

Appeals

SOIT's decisions may be contested by any interested party within 30 days of their communication or publication in Part II of the *Official Bulletin*, as the case may be, before SOIT's Appeals Committee. Decisions rendered by the Appeals Committee may be further contested before the Bucharest Court of Law.

Registration

SOIT will record the trademark in the National Register and publish it in Part II of the *Official Bulletin* after the payment of the final registration fees. Provided that no appeals are filed within 30 days of publication, SOIT issues the registration certificate.

A registered trademark is valid for 10 years from its filing date and may be renewed indefinitely for consecutive 10-year periods.

Renewal

On paying the official fees within the legal term provided by the Trademarks Law, the renewal of a trademark registration becomes effective on the next day immediately following the expiration date of protection for the said trademark.

In accordance with the Trademarks Law, the earliest date on which a renewal application can be filed is three months before the expiration of the trademark's validity period (no earlier). The national law also provides a six-month grace period following the expiration of the trademark's validity period in which the trademark can still be renewed (provided that the official fees are paid with a 50% surcharge).

Removal from the register

Surrender: Rights over a registered mark can be surrendered with respect to some or all of the goods or services for which it is registered.

If a licence has been recorded, the surrender will be recorded only if the owner proves that it has notified the licensee of its intention to surrender the trademark.

Revocation: Interested parties may request the court to deprive a trademark owner of its rights if, without legitimate reason, the mark was not genuinely used in Romania within a consecutive period of five years as from its registration in the Trademarks Register, or if such use was suspended for more than five years. The burden of proof rests with the trademark owner.

Revocation of a registered trademark can also be requested before a court if:

- as a result of the rights holder's actions or inactivity, the trademark has become customary in the course of trade with the goods or services for which it was registered;

- as a result of its use by the rights holder or with its 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 was registered; or
- the trademark was registered by someone who did not have the legal capacity to do so.

Invalidation: Interested parties may file a legal action with the Bucharest Court seeking cancellation of a trademark registration on any of the following grounds:

- Absolute grounds for refusal applied at the time of registration.
- Relative grounds for refusal applied at the time of registration.
- Registration was sought in bad faith.
- The registration infringes the image or name rights of a person.
- The registration infringes earlier rights acquired in a protected geographical indication or a protected design or model, or other IP rights or copyright.

The time limit for a legal action seeking the invalidation of a trademark is five years from its date of registration, except for bad-faith invalidity actions, which may be launched at any time during the term of protection.

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. 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 burden of proof may be heavier when unregistered rights are invoked and the case may take longer to progress.

The Trademarks Law provides trademark owners with both civil and criminal remedies.

In the case of unauthorised use of a registered trademark, the owner may request the competent court to prohibit third parties from engaging in any infringement acts that constitute an infringement of rights under the Trademarks Law. Further, the law defines as a criminal offence any act of placing into circulation a product bearing a mark identical or similar to a registered trademark for identical goods or services, as well as placing into circulation goods affixed with geographical indications indicating or suggesting that the goods originate from a geographical area other than the real place of origin.

Apart from the civil action, trademark owners may also file criminal complaints against infringers, who may be subject to imprisonment for up to two years or a criminal fine. Where a civil action is incorporated in the criminal complaint, the infringer may be also liable to pay damages.

In accordance with the Unfair Competition Law, anyone who contravenes honest commercial practices and the good-faith principle may be enjoined by the court to desist or refrain from the acts in question. The Unfair Competition Law further qualifies as a criminal offence the use of a “firm logo or of a packaging which is liable to create confusion with those legitimately used by another merchant... [and] the manufacturing in any manner, import, export, warehousing, offering for sale or sale of merchandise or services bearing false mentions regarding... trademarks [or] geographical indications... in order to mislead other merchants and customers”.

Under both the Trademarks Law and the Unfair Competition Law, as well as under the Civil Procedure Code, a rights holder can also seek a preliminary injunction. If such is issued by the court, it would temporarily prohibit the infringers from continuing the alleged infringements that could prejudice the rights holder.

According to law, in extreme urgent cases, a preliminary injunction may be issued without hearing the other party, although 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 action.

Timeframe

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

The duration of a criminal claim is longer depending of the time involved by the completion of the police investigation and the prosecutor’s examination of the case.

Ownership changes and rights transfers

As a general rule, the Trademarks Law provides that rights in a trademark may be transferred through 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 executed in writing and signed by the parties, under threat of nullity. The assignment may be executed for all or only some of the goods or services for which the trademark was registered. However, unlike a licence, an assignment may not limit the use of the trademark to a given territory. The Trademarks Law also includes a specific clause regarding the assignment of identical or similar trademarks having the same owner and used for identical or similar goods or services, which may be assigned only as a whole and only to one person, under threat of nullity of the assignment deed.

According to the Trademarks Law, licences and assignments must be published in the *Official Bulletin* in order to become opposable to third parties.

Publication of assignments or licences and their recordal in the National Register does not affect the existence or validity of the assignment or licence agreements *per se*, but rather affords the new trademark owner or licensee the opportunity to publicise such agreements.

SOIT may refuse to record a trademark assignment if it obviously misleads the public

as to the nature, quality or geographical origin of the goods or services for which the trademark has been registered, except where the beneficiary of the assignment agrees to limit the trademark assignment to the goods and services for which the trademark is not misleading.

In practice, it takes between two and four months to record a licence or assignment.

Related rights

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

Generally, Romanian IP legislation recognises artistic and intellectual creations for dual protection. The Copyright Law 8/1998 protects literary, scientific and artistic creations, regardless of the mode or form of expression. No formal requirements for protection apply; intellectual creations are recognised and protected under the Copyright Law through the mere act of their creation (ie, from their creation date), if they are original.

The Designs and Models Law 129/1992, republished with amendments, protects the creative act of designing the formal or ornamental appearance of a product that satisfies aesthetic requirements. Design protection is granted through registration for a maximum duration of 25 years and does not exclude protection through a trademark registration.

Online issues

The Trademarks Law includes no specific provisions regarding the unauthorised use of registered or unregistered trademarks in domain names, metatags, links and frames. Law 365/2002 on electronic commerce regulates specific obligations for providers of information society services, if such relates to content infringing third-party rights (in practice, invoked if IP rights are infringed).

Any person or entity wishing to register a '.ro' domain name must consent to ICANN rules and policy, which provide, among other things, that disputes over domain names may be decided by arbitration panellists. **WTR**



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Alina Tace is a senior associate within Nestor Nestor Diculescu Kingston Petersen, heading the IP practice. She has more than eight years' professional experience, focusing her practice on intellectual property and gaming matters, and assisting clients in various industries. She assists Romanian and foreign companies with contentious and non-contentious matters regarding their trademarks, designs, domain names portfolios, copyrights and related rights. She has successfully advised clients in complex IP projects, including trademark litigation, IP due diligence and IP transactional projects.

A licensed European trademark and design attorney, Ms Tace is a member of the Romanian National Chamber of Industrial Property Attorneys and the Bucharest Bar. Her professional affiliations include INTA, the European Communities Trademark Association and MARQUES.



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Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?

Yes: requires a power of attorney.
No: power of attorney does not need to be legalised/notarised, a signature will suffice.

Examination for relative grounds for refusal based on earlier rights?

Yes: on opposition/appeal filed by interested third parties.

Non-traditional marks registrable?

3D shapes; colours; combination of colours; holograms; sounds.

Unregistered rights

Protection for unregistered rights?

Yes: well-known trademarks; copyright.

Specific/increased protection for well-known marks?

Yes

Opposition

Opposition procedure available? Term from publication?

Yes: two months from date of first publication.

Removal from register

Can a registration be removed for non-use? Term and start date?

Yes: action after five years' non-use from date of recordal in the National Register.

Are proceedings available to remove a mark that has become generic?

Yes

Are proceedings available to remove a mark that was incorrectly registered?

Yes

Enforcement

Specialist IP/trademark court?

No; but there are specialised panels of Bucharest Tribunal, Bucharest Appeal Court and Supreme Court.

Punitive damages available?

Yes

Interim injunctions available? Time limit?

A condition of urgency must be fulfilled.

Ownership changes

Is registration mandatory for assignment/licensing documents?

No: registration is mandatory only for opposability against third parties.

Online issues

National anti-cybersquatting provisions?

No

National alternative dispute resolution policy (DRP) for local ccTLD available?

No: UDRP applies directly.