

Romania

Nicoleta Tarchila and Anca Bianu

Cabinet Enpora

1 Ownership of marks

Who may apply?

A trademark application may be filed by any natural or legal person irrespective of its nationality. However, foreign entities that do not reside or have a registered office within the territory of Romania must be represented before the Romanian IP Office by an authorised representative. A trademark application may be filed by a plurality of applicants.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any sign capable of graphic representation serving to distinguish the goods or services of a natural or legal person from those of other persons may be protected as a trademark. The following signs are registrable: words, personal names, letters, numerals, designs, figurative elements, three-dimensional shapes, the shape of goods or of packaging, combinations of colours, sounds, smells, trademarks in motion and any combination of such signs.

The following shall be excluded from protection due to absolute grounds of refusal:

- marks devoid of distinctive character;
- marks consisting exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade or which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- marks consisting exclusively of the shape of the product, which results from the nature of the goods themselves or which is necessary to obtain a technical result or which gives substantial value to the goods;
- marks liable to mislead the public as to the geographical origin, or the quality or nature of the goods or service;
- marks containing a geographical indication or consisting therein, for goods which do not originate on the designated territory if the use of such indication is liable to mislead the public as to the true place of origin;
- marks consisting of a geographical indication identifying wines or spirits that do not originate in the place indicated or which comprise such indication;
- marks contrary to public policy or to accepted principles of morality;
- marks containing, without the consent of the owner, the likeness or surname of a person of repute in Romania;
- marks containing, without the permission of the competent authorities, reproductions or imitations of armorial bearings, flags, state emblems, signs, official hallmarks of control and warranty, coats of arms belonging to countries of the EU and which are governed by article 6 of the Paris Convention; and

- marks containing, 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 6 of the Paris Convention and which belong to international intergovernmental organisations to which one or more countries of the EU are party.

The following signs shall be excluded from protection due to relative grounds for refusal:

- marks identical with a prior mark filed for goods and services for which the prior mark is granted;
- marks identical with a prior mark intended to be affixed to goods and services similar to those for which the prior mark is granted if there is a likelihood of confusion on the part of the public;
- marks similar with a prior mark intended to be affixed to goods and services identical with or similar to those for which the prior mark is granted if there is a likelihood of confusion on the part of the public;
- marks identical with or similar to a mark that is well known in Romania for goods and services that are identical or similar at the date of filing the application for the registration of the mark; and
- marks identical with or similar to a mark that is well known in Romania for goods and services that are not similar with those for which the registration is requested where the use of the latter without due cause could take unfair advantage of the distinctive character or the repute of the well-known mark or where such use could cause prejudice to the owner of the well-known mark.

3 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

On a regular basis the time frame for registering a trademark is approximately 10 to 12 months. The issuance of ex officio refusals or the filing of oppositions by third parties extend the registration time frame. The registration fee for a trademark in one class is €200. Additional fees are perceived while claiming: colours (€150), priorities (€50 each), figurative elements (€50) and supplementary classes (€50 each).

4 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

The International Nice Classification (ninth edition) is used in order to structure the list of goods and services of a trademark application. The Romanian IP Office allows the filling of class headings and the filling of applications requesting protection for all 45 classes at once.

5 Conflicts with other trademarks

Are applications examined for potential conflicts with other trademarks? What is the procedure followed by the Trademark Office?

The Romanian IP Office performs a complete examination of a trademark application ascertaining if absolute or relative grounds of refusal, or both, are applicable. The conflicts with other trademarks are considered relative grounds of refusal and are invoked by the Office with the issuance of a provisional refusal of protection. The applicant is given a period of three months from the date of communication of the refusal to file its observations or a letter of consent from the owner of the opposed trademark.

6 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a challenge on grounds of non-use?

In Romania the registration of a trademark application is granted without requesting from the applicant any proof of use. In case a descriptive sign seeks protection it may be registered if the applicant proves the sign has acquired a distinctive character before the filing of the trademark application. Once protection is granted the owner is allowed a grace period of five years to start or to keep on using its trademark. At the request of any interested person the mark may be subject to cancellation based on non-use if use of the mark within a period of five years cannot be proven or justified.

7 Appealing a denied application

Is there an appeal process if the application is denied?

In case a trademark application receives a final decision of refusal, in spite of the observations filed against the provisional refusal, an appeal may be filed before the Commission of Re-examination concerning trademarks organised within the Romanian IP Office. For cases in which the refusal is maintained, a further appeal may be filed before the Bucharest Court of Law. Against the decision of the Bucharest Court of Law a last appeal may be filed before the Bucharest Court of Appeals.

8 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

Within three months from the date of publication of the mark, third parties may file oppositions before the Commission examining the oppositions within the Romanian IP Office. An opposition may be grounded on: earlier registered trademarks; well-known trademarks; trade names; earlier rights in a likeness or surname; protected geographical indications; or protected industrial designs, or any other protected industrial property rights or copyright. The applicant is allowed to file its observations against the opposition within three months from the communication. Upon the applicant's request, the opponent must provide proof of use of the earlier mark within a five-year period preceding the publication of the application. In the absence of evidence of use the opposition will be rejected.

Within five years from the registration of a trademark a cancellation action may be filed before the Bucharest Court of Law, as a specialised court. The grounds of cancellation are the following: a trademark was registered without noticing the absolute or the relative grounds of refusal, or both; the registration infringes a right of personal portrayal or a right to a name; or the registration infringes earlier rights acquired in a protected geographical indica-

tion, a protected industrial design, other industrial property rights or copyright.

Bad faith is also a ground of cancellation of a trademark. A cancellation action based on bad faith may be filed before the Bucharest Court of Law at any time during the protection of the mark.

9 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration?

The registration of a trademark remains in effect for a period of 10 years from the date of application. The trademark may be renewed at the request of the owner for successive 10-year periods. A renewal request may be filed before the Romanian IP Office starting with three months prior to the date of expiry of the registration. Late renewals are allowed if filed within six months after the date of expiry of the registration and with a payment of 50 per cent penalties.

10 The benefits of registration

What are the benefits of registration?

A mark grants exclusive rights to its owner only through registration. Consequently the owner of the mark may fully benefit from the legal provisions in order to defend and to enforce these rights. Beyond registration the owner may defend its trademark by prohibiting the registration of identical or similar trademarks by means of oppositions or cancellations and by forbidding the use of identical or similar denominations in the course of trade by means of counterfeit actions.

11 Assignment

What can be assigned?

The rights in a mark may be transferred by means of assignment at any time during the term of protection of the mark and in respect of all or a part of the goods or services for which the mark is registered. A partial assignment may not be interpreted as limiting the use of the mark to a given territory. A trademark may be assigned independently of the transfer of the business in which the mark is incorporated. However, identical or similar marks belonging to the same owner may be assigned only as a whole and only to one person or the instrument of assignment will be declared null and void.

12 Assignment documentation

What documents are required for assignment and what form must they take?

The only requested form for the validity of the trademark assignment is the written form displaying the signatures of the parties. No notarisation or legalisation is required.

13 Validity of assignment

Must the assignment be recorded for purposes of its validity?

The trademark assignment between the contracting parties is valid from the date of its conclusion. However, the assignment may be invoked against third parties only from the date of its entry in the National Trademark Register. The registration of the assignment is made at the request of the person concerned and on the payment of a prescribed fee.

14 Security interests

Are security interests recognised and what form must they take?

Trademarks may be recorded as security interests with the Romanian IP Office and with the Electronic Archive of security interests. No notarisation or legalisation is required.

Update and trends

In the matter of trademark infringement a question of particular interest, especially due to the lack of a legal background, is the settlement of conflict between trademarks and trade names. Subsequent to Romania's EU accession the rulings of the European Court of Justice (ECJ) interpreting the Community law became compulsory. Consequently in the case *Eurotherm v B&B Eurotherm* the Romanian High Court of Cassation and Justice made allowance for the ECJ's interpretation of article 5(1) of Directive No. 89/104/EC in the case C-17/06 *Celine*. The Romanian High Court, applying the principles set out by the ECJ, decided the trade name 'B&B Eurotherm' infringed the prior registered trademark 'Eurotherm' because the trade name was given a trademark value owing to the fact that it was used in order to warranty the origin and to advertise the infringing services outside the loyal practices of trade and without the consent of the owner of the trademark.

15 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Romanian Trademark Law has no provisions with respect to the using of words or symbols in order to indicate a registered trademark or a trademark application. Moreover, there are no provisions in order to prohibit or sanction the misuse of such words or symbols. However in the course of trade trademark owners often use the internationally provided symbols '®', '™' and *marcă înregistrată* (registered trademark) in order to strengthen the enforcement of their rights.

16 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Trademark infringement may be sanctioned either by civil or criminal proceedings. The jurisdiction in these cases is allotted to the common courts according to the general civil procedural law. Before the civil courts the trademark owner may file a counterfeit action in order to prohibit the misuse of denominations identical or similar to the registered trademark and to claim appropriate damages. Trademark infringement is a criminal offence according to the Romanian Trademark Law and is sanctioned with imprisonment or a fine. The trademark owner may claim appropriate damages within the criminal proceedings.

An action before the customs authorities is provided by the Romanian legislation. Subsequent to an action being filed, the trademark will be under the surveillance of the customs authorities for a period of one year. At the notification of the customs authorities with respect to the seizure of infringing goods, a counterfeit action shall be filed before the civil or criminal courts.

17 Procedural format and timing

What is the format of the infringement proceeding?

Civil procedures are brought by the trademark owner before the civil section of the first instance courts. No preliminary proceedings for direct conciliation between the parties are requested. Discovery is not provided under Romanian procedural law. However, by request the courts may apply assurance measures in order to preserve evidence to be used during the trial. All types of evidence are allowed during an infringement proceeding, such as written evidence, the cross-exami-

nation of the parties, live testimony and expert evidence.

Criminal proceedings may be started only on a prior complaint of the injured party. The proceedings comprise a pre-trial investigation phase instituted by the police and the public prosecutor. If the matter is taken before the criminal section of the first instance court, all types of evidence are allowed such as written evidence, the cross-examination of the parties, live testimony and expert evidence. The trademark owner may join the criminal trial as a civil party and claim appropriate damages.

The length of civil infringement proceedings may be estimated as 12 to 24 months from the filing of the action until the issuance of the first instance decision. The criminal proceedings are prolonged by the pre-trial investigation, which may add up to 12 months to the length of the action.

18 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof in infringement proceedings is borne by the plaintiff. Evidence must consist of any facts proving the identity or similarity between the trademarks, the likelihood of confusion, the existence of an infringement, the quantity and quality of the infringing goods and the damage caused to the injured person.

19 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Usually, infringement proceedings may be started by the owner of the registered trademark. There are some differences between civil and the criminal proceedings. Civil proceedings may be started by the owner of a trademark starting with the publication of the mark. The owner may also claim damages for acts subsequent to the publication of the mark under the general rules of law. However, a decision ordering payment of damages shall be enforceable only from the date of registration of the mark. If the application for registration is refused, the applicant shall not be entitled to damages. Criminal proceedings may be brought only after the date on which the mark was registered and entered in the National Trademark Register.

The trademark licensees may not institute infringement proceedings without the consent of the trademark owner, unless otherwise provided in the licensing contract. However, the holder of an exclusive licence may institute infringement proceedings if, after having notified the trademark owner of the infringing acts, the latter does not act within the time limits prescribed by the licensee. Where infringement proceedings are instituted by the trademark owner, any of the licensees may intervene in the proceedings in order to obtain compensation for damage occasioned by the infringement of the mark.

20 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

The provisions of the Trademark Law are applicable only within the Romanian territory.

21 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Discovery is not provided under Romanian procedural law. However, during the trial at the request of the plaintiff, the court may impose withholding measures in order to immediately stop the infringing acts and to safeguard the necessary evidence. For cases in which the evidence submitted in support of the plaintiff's claims is in the possession of the defendant, the judicial body may order the defendant to furnish the evidence subject to a guarantee of confidentiality of

information in accordance with the law. The trademark owner is also allowed to require the infringer to provide recent information on the origin and distribution channels of merchandise to which marks are unlawfully affixed, information on the identity of the manufacturer or merchant and on the quantity of merchandise manufactured, delivered, received or ordered.

22 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

The time frame for infringement proceedings may vary owing to a number of factors consisting of: the intervals between the hearings of the courts, the origin of the defendant (for foreign parties the summoning procedure may delay the proceedings by six to 12 months) and the strategies of the parties. We may estimate a period of 12 to 24 months from the filing of the action until the issuance and communication of the first instance decision. Criminal proceedings are prolonged by the pre-trial investigation. The appeal proceedings may last from six to 12 months and will also be influenced by the same factors as the first instance proceedings.

23 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

It is difficult to determine in advance the amount of costs involved in infringement proceedings. Typically the judicial costs are apportioned with the claims of the plaintiff and depend on the claimed damages, the administration of evidence and the request of withholding measures. Attorneys' fees are added to the judicial costs.

24 Appeals

What avenues of appeal are available?

The first instance decision may be revised in two stages: an appeal as a means of retrial and an appeal grounded on the court's errors in applying the law.

25 Defences

What defences are available to a charge of infringement or dilution, or any related action?

The main defence against an infringement action is the filing of a complaint counteracting the claims of the plaintiff. In its defence the defendant may also file a counterclaim requesting the invalidation of the plaintiff's mark.

26 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

As a result of the civil proceedings and the civil part of the criminal proceedings, the successful party obtains the repairing of the material and moral prejudices established during the trial. The defendant is therefore obliged to stop the infringing acts, to pay the appropriate damages, to publish the court's decision through its own costs, to perform further actions in order to restore the rights infringed and to pay the judicial expenses. The criminal remedies are the following: imprisonment of the defendant, the payment of a fine, and the seizure and destruction of the infringing goods and the devices used in order to manufacture and commercialise the infringing goods.

27 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

The Trademark Law does not provide for ADR techniques as means of resolving trademark disputes; however these are included and recognised according to the civil procedural legislation. Although applicable, the ADR techniques are not commonly used in infringement cases.

Cabinet Enpora

Nicoleta Tarchila

ntarchila@enpora.com

No. 52A, ap. 1 George Calinescu Street
1st District
Bucharest
Romania

Tel: +40 21 230 0990
Fax: +40 21 230 2311
pop@patents.ro
www.patents.ro