



The full effect of harmonisation



Trademark legislation in Romania is now in line with EU law. Nicoleta Tarchila, CABINET ENPORA explains how rights holders are affected.



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Three years after the accession of Romania to the European Union, the local trademark legislation was harmonised with EU law. Law 66/2010 was adopted to implement the new EU Trademarks Directive (2008/95/EC). The trademark legislation thus consists now of Law 84/1998 as republished on 27 May 2010 (incorporating the amendments brought in by Law 66/2010), and the Implementing Regulations as amended by Government Decision 1134/2010.

The updated trademark legislation preserves some elements of the old examination and enforcement systems. However, it also gives rise to new challenges for trademark applicants and owners by removing one type of trademark examination, introducing shorter deadlines to take action before the Romanian Trademark Office, and creating a constant need to monitor registered rights.

Single, stricter examination

As a consequence of the implementation of the EU Trademarks Directive, the only form of *ex officio* examination maintained by the new Romanian Trademark Law is the analysis of new applications on absolute grounds of refusal. However, applicants will not necessarily find it easier than in the past to overcome this sole level of examination. That is, on the one hand, because three new grounds of refusal have been added to existing ones. Thus, the following signs will now be refused registration:

- Trademarks that contain signs of high symbolic value, in particular religious symbols;
- Trademarks that contain, without the permission of the competent authorities, badges, emblems, or coats of arms or escutcheons, other than those covered by Article 6*ter* of the Paris Convention; and

- Trademarks that contain emblem, in whole or in part, owned by the European Council.

On the other hand, that is because there has been an increase in the number of provisional refusals on absolute grounds. One may conclude that the examiners of the Romanian Trademark Office pay more attention to applications and sometimes are even extreme in their analysis. Here are a few recent examples of trademark applications refused on absolute grounds:

- MAGICTIMES for goods in Classes 29, 30 and 32 – the denomination was found to lack distinctive character;
- CREATIVE TECHNOLOGIE for goods in Classes 7 and 12 – the sign was held to lack distinctive character and be a habitual term used in the course of trade to designate the characteristics of the protected goods; and
- GAME ALARM in Classes 9, 38, 41 and 42 – the phrase was considered a common term used in the course of trade to designate the quality and the characteristics of the protected goods and services.

Heightened vigilance

On the whole, however, the examination system adopted through the new trademark legislation may be seen as favouring applicants whose chances to obtain trademark protection increase considerably given that the *ex officio* examination is limited to absolute grounds. Nevertheless, the job of these applicants, once they become trademark owners, is much more difficult than it was in the past because they are solely in charge of preserving their registered rights against new identical or similar registrations. Under the updated trademark legislation, relative grounds of refusal are no longer invoked *ex officio* during the examination procedure before the Romanian Trademark Office. The filing of oppositions is the only legal instrument that interested third parties have to enforce their earlier rights. This implies a constant monitoring of newly filed applications. One may even claim that maintaining exclusive rights in trademarks in Romania is nowadays totally dependent on the employment of a watch service. An additional issue for mark owners is that the legislation provides no recovery of costs in opposition cases.

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Interested third parties are not completely precluded from acting against new applications based on absolute grounds of refusal. A new course of action introduced by the updated trademark legislation is the filing of observations against new trademarks. The observations work as support material for the examiner who may take such observations into consideration while considering the application.

Observations are not subject to the payment of any kind of fees.

Shorter timeframes

A new set of deadlines meant to speed up the examination procedure features in the new Trademark Law. The basic timeframe for taking action under the old provisions was three months. This term is maintained only for filing a reply to a provisional refusal issued following the *ex officio* examination. Any other actions now trigger several and noticeably shorter deadlines before the Romanian Trademark Office. Third parties may file observations and oppositions within two months of the date of publication of the trademark application. Applicants must file their response to observations and oppositions within 30 days of the date of notification of the observations/oppositions. Moreover, applicants may appeal any trademark examination decision before an appeal commission of the Romanian Trademark Office within 30 days of being notified of such decision.

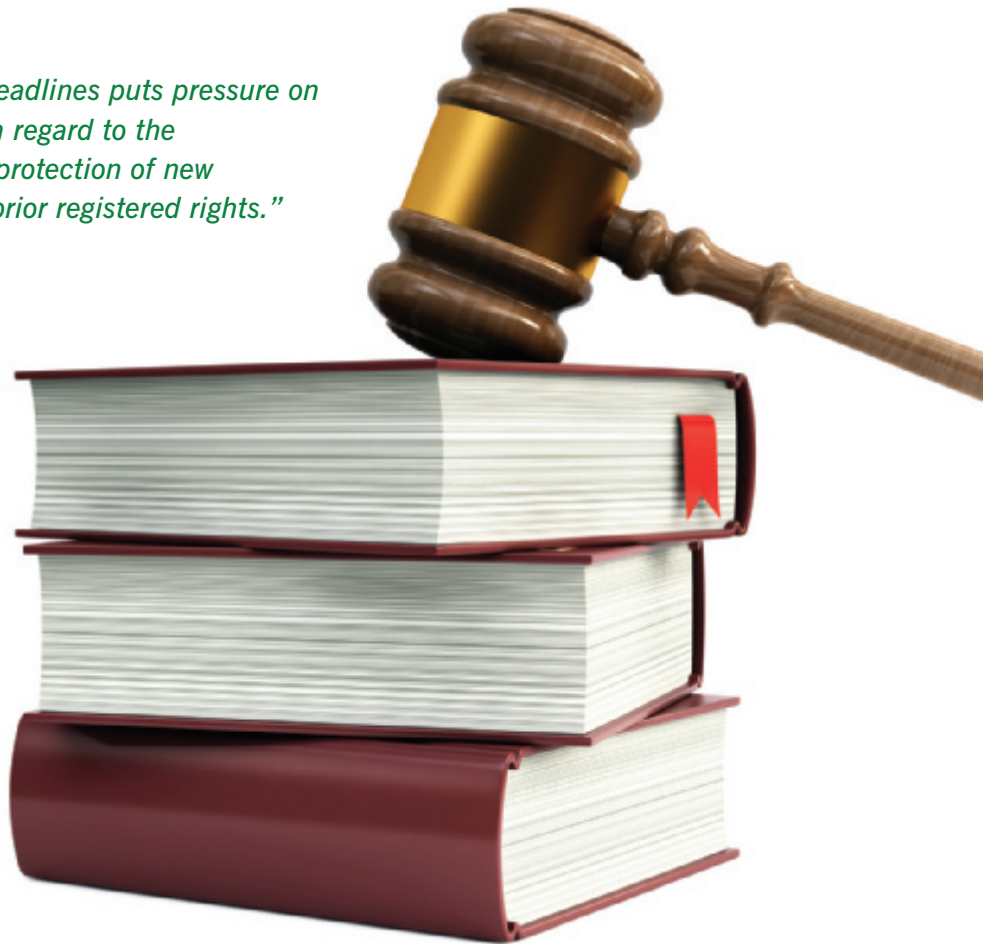
With regard to taking an action further before a court of law, the old legislation provided a deadline of 30 days, which was a waiver from the general civil procedure rules. By contrast, the new Trademark Law is in line with the general legislation and provides a deadline of 15 days from the date of communication for taking action against the final decisions of the Romanian Trademark Office.

Setting shorter deadlines puts pressure on rights holders with regard to the enforcement and protection of new applications and prior registered rights. However, the obvious advantage is that it enables the Romanian Trademark Office to meet its target to significantly reduce the period of time needed to register trademarks – namely, within six months of their application.

Harmonised enforcement

Given that the rules on enforcement of trademarks rights provided by the old trademark legislation were already in line with EU legislation, no amendments were required in this respect. In fact, the way towards harmonised enforcement legislation was paved by the issuance of

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Emergency Government Ordinance 100/2005, which was adopted in order to implement the EU IP Enforcement Directive (2004/48/EC). The early implementation of the directive was part of Romania's obligation to adopt the *acquis communautaire* in order to prepare for its accession to the European Union in January 2007. The most important amendments brought by the implementation legislation referred to:

- The persons entitled to file an application;
- The sampling of infringing goods;
- The possibility of requesting interlocutory injunctions against intermediaries (eg, transporters of counterfeit products); and
- Setting damages as either a lump sum or large scale publicity of the court's decision.

The judgments of the European Court of Justice (ECJ) containing references for preliminary ruling on the

interpretation of EU laws are of significant importance for the daily practice of the Romanian Trademark Office and courts of law. Apart from their binding nature, these decisions also offer important guidelines for the national instances and furnish useful interpretation on several aspects of the laws in force. By way of example, a serious problem related to the enforcement of trademark rights was raised before national instances with respect to a conflict between trademarks and trade names. Different interpretations and approaches were given over the years by the courts. The lack of uniform interpretation of the legal provisions led to conflicting decisions. Nowadays, however, the Romanian jurisprudence follows the rules provided by the ECJ in *Céline Sarl v Céline SA* (Case C-17/06).

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