

**ROMANIA**

**Trademark Law**

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## **Chapter I General provisions**

### **Art. 1**

The rights over the trademarks and geographical indications are recognized and protected on the Romanian territory, in the terms of the present Law.

### **Art. 2**

The foreign natural persons and legal entities having the address or premises outside the Romanian territory may also have an advantage from the provisions of the present Law, in the terms of the international conventions on trademarks and geographical indications in which Romania is a part.

### **Art. 3**

In the context of the present Law, the following terms and expressions shall be defined as follows:

(a) "the trademarks" is a sign susceptible of graphical representation serving to differentiate the products or the services of a natural person or legal entity from those of other persons; distinctive signs, as: words, including names of persons, drawings, letters, ciphers, figurative elements, tri-dimensional signs, and, in particular, the shape of the manufacturer of its package, colors combinations, as well as any other combination of these signs, may be considered trademarks;

(b) "the previous trademark" is the registered trademark, as well as the trademark filed to be registered in the National Register of Trademarks, provided that it is registered afterwards;

(c) "the notorious trademark" is the trademark widely known in Romania on the date of a trademark filed for application or on the date of the claimed priority for the application; in order to determine if a trademark is widely known, the notoriety of this trademark shall be taken into consideration in the frame of the concerned part of public for whose products or services the respective trademark applies, with no necessity to have the trademark registered or used in Romania;

(d) "the collective trademark" is the trademark intended to serve for the differentiation of products and services of the members of an association from the products and services of other persons;

(e) "the mark of certification" is the mark indicating the fact that the products or services for which it is used are certificated by the owner of the mark as concerning quality, material, the way of manufacturing of products or services carrying out, accuracy or other characteristics;

(f) "the geographical indication" is the designation for the identification

of a product originating from a country, region or county of a state, when a quality, a reputation or other determined characteristics may be essentially granted to this geographical origin;

(g) "the applicant" is the natural person or legal entity on behalf of whom an application for registration of a trademark is filed;

(h) "the owner" is the natural person or legal entity on behalf of whom the trademark is registered in the National Register of Trademarks;

(i) "the authorized representative", called in the present Law "representative", is the adviser on industrial property who may also have the quality of representation in the procedures before the State Office for Inventions and Trademarks;

(j) "The Paris Convention" is the Convention for protection of industrial property of March 20, 1883, Paris, as it was reviewed and modified;

(k) "The Paris Union Countries" are the countries to which the Paris Convention is applied and which are joined in the Union for industrial property protection;

(l) "The Madrid Arrangement" is the arrangement from Madrid concerning the international registration of trademarks of April 14, 1891, reviewed in Stockholm on July, 14, 1967;

(m) "The Protocol on the Arrangement" is the Protocol from Madrid of June 27, 1989, concerning the Arrangement from Madrid on the international registration of trademarks.

## **Chapter II Trademarks protection**

### **Art. 4**

The right over the trademark is acquired and protected by its registration to the State Office for Inventions and Trademarks.

### **Art. 5**

The following trademarks are excluded from protection and can not be registered:

- (a) the trademarks not fulfilling the requirements mentioned in Art. 3, letter (a);
- (b) the trademarks lacking a distinctive character;
- (c) the trademarks made up exclusively of signs or indications become usual in the daily language or in the fair commercial and constant practices;
- (d) the trademarks made up exclusively of signs or indications, which may be used on the market for identifying the species, quality, quantity, destination, value, geographical origin or the time of manufacturing the product or services carrying out or other characteristics of them;
- (e) the trademarks made up exclusively of the shape of the product, imposed by the nature of the product or necessary to obtain a technical result or giving a substantial value to the product;
- (f) the trademarks which can mislead the public regarding the geographical origin, the quality or nature of the product or service;
- (g) the trademarks including a geographical indication which are made up of such an indication, for products not originating from the indicated territory, if the utilization of this indication can mislead the public concerning the real place of origin;
- (h) the trademarks which are made up of or include a geographical indication, identifying wine or alcoholic beverages not originating from the indicated place;
- (i) the trademarks which are against the public order or the good behavior;
- (j) the trademarks including, without the consent of the owner, the image or the patronymic name of a person who is well known in Romania;
- (k) the trademarks including, without the authorization of the competent bodies, reproductions or imitations of escutcheons, flags, state emblems, signs, official seals for control and guarantee, armorial bearings adopted by the countries of the Union entering the provisions of Art. 6 ter in the Paris Convention;
- (l) the trademarks including, without the authorization of the competent bodies, reproductions or imitations of escutcheons, flags, other emblems, logos, initials or designations entering the provisions of Art. 6 ter

in the Paris Convention and belonging to the international intergovernmental organizations in which one or several countries of the Union is a part;

The provisions in paragraph 1, letters (b), (c), and (d) do not apply, if, before the date of the application for the trademark registration and following the utilization of the trademark, the trademark acquired a distinctive character.

#### **Art. 6**

Excepting the reasons provided in Art. 5, paragraph 1, a trademark is rejected from registration, if it:

(a) is identical with a previous trademark and the products and services for which the registration of the trademark was asked are identical with those for which the previous trademark is protected;

(b) is identical with a previous trademark and is intended to be applied to products and services similar to those for which the previous trademark is protected, if there is a risk of confusion for the public;

(c) is similar with a previous trademark and is intended to be applied to product and services identical or similar, if there is a risk of confusion for the public, including the risk of association with the previous trademark;

(d) is identical with or similar to a trademark notorious in Romania for the products and services identical or similar, on the date of the application for trademark registration filing;

(e) is identical or similar with a trademark notorious in Romania for products and services different from those to which the trademark refers and of which registration is asked and if, by unjustified utilization of the latter one could have a benefit from the distinctive character or from the name of the notorious trademark or this use could bring prejudices to the owner of the notorious trademark.

#### **Art. 7**

The trademarks entering the provisions of Art. 6 can still be registered with the express consent of the owner of the pervious or notorious trademark.

#### **Art. 8**

The nature of products and services for which the registration of the trademark is required is not considered an obstacle for its registration.

### **Chapter III The application for the trademark registration**

#### **Art. 9**

The right to the trademark belongs to the natural person or legal entity, that first filed, as per the Law, the application for the trademark registration.

#### **Art. 10**

The application for the registration of a trademark including the identification data of the applicant, the trademark reproduction as well as the indication of the products or services for which the registration is asked, written in Romanian language, shall be filed to the State Office for Inventions and Trademarks and is the regulatory national deposit of the trademark. The applicant shall refer to only one trademark.

The application shall present specific mentions, when the trademark:

(a) includes one or several claimed colors as a distinctive element of the trademark;

(b) is tri-dimensional.

The application shall include also data on the applicant.

The application shall include, if case, a transliteration or a translation of the trademark or of some elements of the trademark.

#### **Art. 11**

The date of the regulatory national deposit is the date on which the application for the registration of the trademark was filed at the State Office for Inventions and Trademarks, provided that it includes all the elements mentioned in Art. 10, paragraph 1.

When an application for registration of the trademark was regulatory filed for the first time in another country member of the Paris Union or member of the World Trade Organization, the appellant may claim the date of the first deposit through an application for registration in Romania of the same trademark, provided that the latter application is filed at the State Office for Inventions and Trademarks in a limit period of 6 months from the date of the first deposit.

#### **Art. 12**

If the appellant presented certain products and services in the frame of an official international exhibition or officially recognized, organized on the Romanian territory or in a member state of the Paris Convention and if an application for registration of the trademark under which these products or services were presented was filed at the State

Office for Inventions and Trademarks in a limit period of 6 months from the date of the first presentation in the exhibition, the appellant shall take advantage of a right of priority from the date of introduction of the product in the exhibition.

The limit period of 6 months mentioned in paragraph 1 shall not extend the priority time period mentioned in Art. 11, paragraph 2.

**Art. 13**

The priority rights mentioned in Art. 11 and 12 have to be claimed together with the filing of the application for trademark registration, justified through documents of priority and are submitted to the legally established fee.

The priority documents shall be filed and the legal fee shall be paid in maximum 3 months from the date of the application for the trademark registration.

Not abiding to the limit period of time provided for in paragraph 2 shall lead to no recognition of the claimed priority.

**Art. 14**

Registration of a trademark may be asked individually or in common by natural persons or legal entities, directly or through a representative with the address or premises in Romania.

If the registration of the trademark is asked by a representative, the application shall include his identification data also. The representative shall present the Power of Attorney, with the penalty of rejection of the application, together with the application or not later than 3 months from the filing of the application.

**Art. 15**

The appellant of the application for the trademark registration shall make the proof of paying the registration and application examination fee with the amount provided by the Law, in a limit period of 3 months from its filing to the State Office for Inventions and Trademarks.

**Art. 16**

The appellant of the application for the registration of a trademark referring to several products or services may require from the State Office for Inventions and Trademarks to divide the initial application into two or several applications, distributing the products or services into the divisionary applications, with the payment of the fee as per the Law. The divisionary applications keep the deposit date of the initial

application and, if case, the advantage of the priority right, acquired according to Art. 11, paragraph 2 or Art. 12, paragraph 1.

The appellant may ask for the dividing of the initial application during the trademark examination procedure at the State Office for Inventions and Trademarks, till the decision making on its registration, as well as during the procedure in the frame of the re-examination commission of the State Office for Inventions and Trademarks or during any appeal procedure, or during the appeal formulated against the decision for the trademark registration.

The appellant shall file the required documents asked by the State Office for Inventions and Trademarks for the division of the initial application and shall pay the legal fee in a limit period of 3 months from the date of the requirement for division. If not, the State Office for Inventions and Trademarks shall take notice that the appellant waived the division of the initial application.

## **Chapter IV The procedure for the trademark registration**

### **Art. 17**

In a time period of one month from the date of receiving the application for the trademark registration, the State Office for Inventions and Trademarks shall examine if the requirements mentioned in Art. 10, paragraph 1 are fulfilled and if so, it grants a date for the deposit to the application. If the application does not fulfil the requirements provided in Art. 10, paragraph 1, the State Office for Inventions and Trademarks shall notify the appellant on the application lacks, granting a time period of 3 months for filing the additions. When the appellant fills in for the lacks notified by the State Office for Inventions and Trademarks in due time, the date of the deposit is the one on which the application for the trademark registration was filled in as per the Art. 10, paragraph 1. If not, the application shall be rejected.

If the registration and application examination fee is not paid in the limit period provided in Art. 15, the State Office for Inventions and Trademarks may grant to the appellant, on well based reasons, another 2 months limit period.

When the fees are not paid in due time it is considered that the appellant waived the trademark registration and the application is rejected.

### **Art. 18**

If the appellant of the application for the trademark registration did not mention in the application the data on his status of a natural person or legal entity, the State Office for Inventions and Trademarks shall notify the appellant on the noticed lacks and shall grant him a limit period for completion. When the appellant does not fill it in due time the State Office for Inventions and Trademarks rejects the application for the trademark registration.

### **Art. 19**

The State Office for Inventions and Trademarks examines the application for the trademark registration, in a time period of 6 months from the date of payment of the fee for registration and application examination. The State Office for Inventions and Trademarks examines:

- (a) the status of the appellant as per the Art. 3 letter (g);
- (b) the terms provided in Art. 13, paragraphs 1 and 2, if the application claims a priority;
- (c) the reasons for rejection provided in Art. 5, paragraph 1 and Art. 6.

**Art. 20**

The examination of the rejection reasons provided in Art. 6, letters (d) and (e) shall be done in conformity with some criteria, such as:

- (a) the degree of distinctivity, initial or acquired, of the notorious trademark in Romania;
- (b) time period and time lasting utilization of the notorious trademark in Romania concerning the products and services for which a trademark is requested to be registered;
- (c) time period and time lasting for advertising of the notorious trademark in Romania;
- (d) the geographical area for utilization of the notorious trademark in Romania;
- (e) the degree of acknowledgement of the notorious trademark on the Romanian market by the section of public to whom it addresses;
- (f) the existence of some identical or similar trademarks for the products or services identical or similar, belonging to some other persons not to the one saying that his trademark is notorious.

In order to examine the rejection reasons, based upon the criteria mentioned in paragraph 1, the State Office for Inventions and Trademarks, may ask documents from the public authorities, public institutions, as well as, from other private legal entities, aiming to establish the trademark notoriety in Romania.

**Art. 21**

When a rejection reason, from those mentioned in Art. 6, is applied only to certain products or services for which the trademark registration was required, the registration shall be rejected only for these products or services.

**Art. 22**

If after the examination of the application, as per the Art. 19 and 20, it is noticed that the requirements for the trademark registration are met, the State Office for Inventions and Trademarks decides the registration of the trademark and its publication in the Official Bulletin of Industrial Property. The trademark shall be published in a time period of 2 months from the date of the decision for the trademark registration.

If the application does not meet the requirements for the trademark registration, the State Office for Inventions and Trademarks notifies this to the appellant, granting him a time period of 3 months in which he can present his point of view or withdraw his application. The time period may be extended with a new period of 3 months, upon the applicant's

application and by paying the fee mentioned by the Law.

When the time period mentioned in paragraph 2 expires, the State Office for Inventions and Trademarks shall decide, upon case, the trademark registration, the rejection of the trademark application or it shall take act of the application withdrawal.

#### **Art. 23**

In a time period of 3 months from the date of trademark application, the owner of a previous trademark or a notorious trademark as well as the owner of a previous right concerning the image or the patronymic name or a protected geographical indication, a design or a protected industrial design to any other protected industrial property right or to a copy right as well as any other interested person, may introduce an opposition action at the State Office for Inventions and Trademarks.

The oppositions have to be given in writing, motivated and upon payment of the legal fee.

If the legal fees for opposition are not paid the opposition is not considered valid.

#### **Art. 24**

The State Office for Inventions and Trademarks notifies the appellant on the formulated opposition, as per the Art. 23, mentioning the name of the person who formulated it, as well as the reasons of the opposition on the trademark registration.

The appellant may present his point of view in a time period of 3 months from the date of the opposition notification; upon the application of the appellant the State Office for Inventions and Trademarks may extend the time period with a maximum of 3 months.

#### **Art. 25**

The formulated oppositions to the published trademark shall be solved by a commission for examination in the frame of the State Office for Inventions and Trademarks.

If the oppositions are well based, the commission decides the rejection of the trademark registration.

The decision of rejection of the trademark registration may be appealed by the appellant of the trademark in the time period and with the procedure mentioned in Art. 80.

The final decision of rejection of the trademark registration, shall be published in the Official Bulletin of Industrial Property.

**Art. 26**

The appellant may, in any moment, withdraw its application for the trademark registration or to limit its list of products and services. When the trademark was already published, the withdrawal or the limitation shall be published in the Official Bulletin of Industrial Property.

The application for the trademark registration may be modified, upon the request of the appellant, only for the correction of the name or of the address of the appellant or for any other correction which does not essentially affect the trademark or does not extend the list of products or services.

Any modification asked by the appellant until the registration, substantially affecting the trademark or the list of products or services, shall have to be the object of a new application for registration.

**Art. 27**

During the procedure for the trademark registration, the State Office for Inventions and Trademarks may ask the appellant for the clarifications and documents that it considers necessary, if there is a doubt on the accuracy or content of the elements of the application for the trademark registration.

**Art. 28**

When the decisions of the trademarks registration have become final, the trademarks are registered in the national register of Trademarks and the State Office for Inventions and Trademarks issues to the owner the certificate for the registration of the trademark, upon the payment of the legal fee.

## **Chapter V Time period, renewal and modification of the trademark registration**

### **Art. 29**

The registration of the trademark can produce effects beginning with the date of the regulatory national deposit of the trademark, for a period of 10 years.

Upon the request of the owner, the registration of the trademark may be renewed whenever 10-year term is completed, upon the payment of the legal fee.

The application for the trademark registration renewal can be done before the expiring of the running period of time of protection but not earlier of 3 months before the expiration of this period of time.

The renewal of the trademark registration functions beginning with the day immediately after the expiration of the running period of protection.

The fee for the application for renewal of the trademark registration is due on the date of the application registration, in the amount applicable of this date; the fee may be also paid in the following 6 months from the expiration of the running protection period, but with the majority provided for by the Law.

If the fee is not paid in the terms mentioned in paragraph 5 is sanctioned with the owner losing his trademark rights.

### **Art. 30**

The application for the renewal of the trademark registration shall include:

- (a) the special requirement for renewal of the trademark registration;
- (b) data for the owner identification and, if case, name and address, respectively the premises of the representative;
- (c) the registration number of the trademark in the National Register of Trademark;
- (d) the date of the regulatory deposit of the application for the trademark registration.

When the owner requires the renewal only for a part of the products and services written in the National Register of Trademarks, he shall also indicate the names of those products or services for which the renewal of the trademark registration is required.

### **Art. 31**

If the State Office for Inventions and Trademarks notices that the requirements provided by the Law for the renewal of the trademark

registration are not met it notifies the owner who may present an answer in a time period of 3 months from the receiving of the notification; when no answer is received in due time, the application for the renewal of the trademark registration shall be rejected.

The appellant of the application for renewal may appeal to the decision for rejection of the renewal of registration, in the period of time and with the procedure provided in Art. 80.

**Art. 32**

The renewal of the trademark registration shall be registered in the National Register of Trademarks and shall be published in the Official Bulletin of Industrial Property, in a time period of 6 months from the filing of the renewal application at the State Office for Inventions and Trademarks.

**Art. 33**

During the period of the trademark protection the owner may require to the State Office for Inventions and Trademarks, upon charging a legal fee, to introduce unessential modification of some trademark elements, provided that such modifications do not affect the general image of the trademark.

The State Office for Inventions and Trademarks shall write the implemented modifications in the National Register of Trademarks, as per the paragraph 1 and shall publish the trademark as it was modified.

**Art. 34**

During the entire period of trademark protection, its owner may require to the State Office for Inventions and Trademarks, upon charging a legal fee, to register the modifications occurred regarding the name, designation and address or premises of the owner in the National Register of Trademarks. The modifications registered in the National Register of Trademarks are published in the Official Bulletin of Industrial Property.

## **Chapter VI Rights granted by the trademark**

### **Art. 35**

The registration of the trademark grants its owner an exclusive right over the trademark.

The owner of the trademark may ask the competent high court to prohibit the third parties to use, in their commercial activities, without the owner's consent:

(a) a sign identical with the trademark for products or services identical with those for which the trademark was registered;

(b) a sign which, given the identity or resemblance with the trademark or the identity or resemblance of products or services to which the sign is applied with the products or services for which the trademark was registered would produce a risk of confusion in the public perception including the risk of the trademark association with the sign;

(c) a sign identical with or similar to the trademark for products or services different from those for which the trademark is registered, when the latter acquired a renown in Romania and if, from using the sign, without well based reasons, one could have an advantage from the distinctive character or the renown of the trademark or the utilization of the sign would cause a prejudice to the owner of the trademark.

The owner of the trademark may ask to ban the third parties, when applying the paragraph 2, especially, the following deeds:

(a) to apply the sign on products or on packages;

(b) to offer the products or to market them or possess them with this aim or, if case, to offer or perform services, under this sign;

(c) to import or export the products under this sign;

(d) to use the sign on documents or for publicity.

### **Art. 36**

The applicant of the application for the trademark registration may ask the third parties to be banned to perform the deeds mentioned in Art. 35, paragraph 2, only after the publication of the trademark.

For the deeds after the publication of the trademark, the appellant may ask for damages, as per the common law. The title for the payment of damages is executory only after the date of the trademark registration.

When the application for the trademark registration was rejected, the appellant has no right to damages.

### **Art. 37**

The owner of a registered trademark can not ask other persons to be banned

the possession, offering to sell or marketing of products bearing this trademark, for products marketed by the owner himself or upon his consent. The provisions of the paragraph 1 are not applicable, if the owner brings well based reasons in order to be against the marketing of the products, in particular when the status of the products is modified or altered after their market launching.

**Art. 38**

The owner of the trademark can not ask a third party to be banned to use in his commercial activity:

- (a) the name/designation and the address/premises of the owner;
  - (b) indications referring to the species, quality, destination, value, geographical origin, the period of manufacturing of the product or the period of performing the service under the trademark, as well as to any other characteristics of them;
  - (c) the trademark, if this is necessary in order to indicate the destination of the product or of the service, namely for spare parts or accessories;
- The provisions in the paragraph 1 are applicable, provided that the utilization of the elements mentioned in letters (a)-(c) to be in conformity with the loyal practices.

## **Chapter VII The assignment of the rights over the trademark**

### **Art. 39**

The rights over the trademark may be assigned through assignment or license, anytime during the period of trademark protection.

The rights over the trademark can be transmitted even when the forced following of the debtor owner of the trademark, performed as per the Law.

### **Art. 40**

The rights over the trademark can be transmitted through assignment, regardless the transmission of the commerce funds in which it is incorporated. The assignment should be made in written and signed by both contracting parties, under the sanction of nullity.

The transmission through assignment of the rights over the trademark can be done for all the products or services for which the trademark is registered or only for a part from those; the assignment, even partially, can not territorially limit the utilization of the trademark for the products or services to which it refers.

When the assets of the trademark owner are assigned entirely, this transmission has as an effect the transfer of the rights concerning the trademark. The assignment of some elements from the owner's assets does not affect the quality of the owner of the right to the trademark.

The trademarks identical or similar, belonging to the same owner and which are used for the products or services identical or similar can not be assigned through assignment but entirely and only to one person, under the sanction of nullity of the assignment act.

### **Art. 41**

The application for registration of the assignment shall be accompanied by the document proving the changing of the trademark owner.

Upon request of the interested persons and upon the payment of the legal fee, the State Office for Inventions and Trademarks registers the assignment in the National Register of Trademarks and publishes it in the Official Bulletin of Industrial Property. The assignment becomes opposable to the third parties, beginning with the date of its registration in the National Register of Trademarks.

### **Art. 42**

The owner of the trademark can, upon a license contract, authorize third parties to use the trademark on the entire territory of Romania or only one part of it, for all or only a part of the products or services for

which the trademark was registered. The licenses may be exclusive or not exclusive.

The owner of the trademark may claim the rights given by the trademark against the licensee breaching the terms of the license contract, as concerning the period of utilization, the aspect of the trademark and nature or products or services for which the license was granted, the territory on which the trademark may be used, the quality of manufactured products or the performed services under the trademark for which the license was granted.

During the trademark license contract, the licensee has to:

- (a) use, for the products to which the trademark is applied, only the trademark making the object of the license contract, having the freedom to apply on these products, signs indicating that he is their manufacturer;
- (b) apply the mention, under license together with the trademark applied on the products making its object, as per the contract.

The licenses shall be registered in the National Register of Trademarks, upon payment of the fee legally provided and shall be published in the Official Bulletin of Industrial Property. The license is opposable to the third parties beginning with the date of its registration.

#### **Art. 43**

The licensee can not introduce a legal action, in counterfeiting without the consent of the trademark's owner, if the license contract does not provide otherwise.

The owner of an exclusive license can introduce an action in counterfeiting, if, after he notified the owner of the trademark on the deeds of counterfeiting of which he was acknowledged, he did not act in the limit period required by the licensee.

When an action in counterfeiting was started by the owner, any of the licensees may intervene in the process, asking for the repairing of the prejudice caused by the counterfeiting of the trademark.

## **Chapter VIII Extinction of the rights over the trademarks**

### **Art. 44**

The owner can waive the trademark for all or only for one part of the products or services for which the trademark was registered.

The trademark waived is declared in writing at the State Office for Inventions and Trademarks by the owner of the trademark or by the person authorized by him, and the rights over the trademark are extinguished, concerning the products and services to which the trademark refers, on the date of registration of waiving in the National Register of Trademarks. If a license was registered, the waiving of the trademark is registered only if the owner of the trademark proves he notified the licensee on the intention to waive the trademark.

### **Art. 45**

Any interested person may require to the High Court of Bucharest, anytime during protection period of the trademark, the owner declining of the rights granted by the trademark, if:

- (a) with no justified reasons, the trademark was not the object of an effective use on the territory of Romania for an uninterrupted period of 5 years, for the products or services for which it was registered;
- (b) after the registration date, the trademark becomes, following the action or not activity of the owner, common in the frame of the commerce with a product or a service for which it was registered;
- (c) after the registration date and following the utilization of the trademark by the owner or upon its consent, the trademark became susceptible of misleading the public, namely concerning the nature, quality or geographical provenience of products or services for which it was registered;
- (d) the trademark was registered by a person not having the quality provided in Art. 3, letter (g).

Declining of the rights granted by the trademark produces effects from the date when the High Court decision remains final.

### **Art. 46**

The following utilization is assimilated to the effective utilization of a trademark:

- (a) the utilization of the trademark by a third party, upon the consent of its owner;
- (b) the utilization of a trademark under a shape different from the one registered through certain elements not altering its distinctive

character;

(c) the application of the trademark on products or packages exclusively for export;

(d) the impossibility to use the trademark due to circumstances independent of the owner's will, as the restriction to import or due to other provisions of the public authorities, concerning the products or services to which the trademark refers.

The owner can not be declined of his rights, if, in the period from the expiration of the time period mentioned in Art. 45, paragraph 1, letter (a) up to the presentation of the application for declining, the trademark was effectively used. However, if the beginning or the resuming of the trademark utilization took place with 3 months before the presentation of the application for declining before the High Court, the utilization of the trademark shall not be taken into consideration, if the preparations for the initiation or for the resuming of the utilization were introduced only after the owner learned about the intention of presentation of an application for declining.

#### **Art. 47**

The proof of the trademark utilization devolves upon its owner and can be done through any probation mean.

#### **Art. 48**

Any interested person may require to the High Court of Bucharest the cancellation of the trademark registration for any of the following reasons:

(a) the registration of the trademark was made not by abiding the provisions in Art. 5, paragraph 1;

(b) the registration of the trademark was made not by abiding the provisions in Art. 6;

(c) the registration of the trademark was required in bad faith;

(d) the registration of the trademark touches the right to image or the patronymic name of a person;

(e) the registration of the trademark touches some acquired previous rights concerning a protected geographical indication, a design or a protected industrial model or another protected right of industrial property or concerning a copy right.

The action in cancellation for the reason mentioned in paragraph 1, letter (c) may be introduced anytime in the period of trademark protection.

The time period in which the cancellation of trademark registration may be required for the reasons mentioned in paragraph 1, letter (a), (b), (d) and (e) is of 5 years and runs from the date of the trademark registration.

The cancellation of the trademark registration can not be asked for the reason of an existing conflict with a previous trademark, if the latter does not meet the requirements provided in Art. 45 and 46.

**Art. 49**

The owner of a previous trademark, who intentionally tolerated in an uninterrupted period of 5 years the utilization of a trademark registered afterwards, can not ask for the cancellation and can not oppose the utilization of the posterior trademark for the products or services for which this posterior trademark was utilized, excepting the case in which the registration of the posterior trademark was required in bad faith.

**Art. 50**

If a reason of declining or nullity exists only for a part of the products or of the services for which the trademark was registered, the declining or the nullity shall produce effects only concerning these products or services.

In the case foreseen in Art. 49, the owner of the trademark registered afterwards can not be against the previous trademark, although the latter can no longer be claimed against the posterior trademark.

## **Chapter IX Collective trademarks**

### **Art. 51**

The manufacturer, producer, merchant, services providing associations can require to the State Office for Inventions and Trademarks the registration of collective trademarks.

The applicant of the registration of a collective trademark shall file, together with the application for registration or not later than 3 months from the date of the notification given by the State Office for Inventions and Trademarks a regulation for utilization of the collective trademark. The application shall be submitted to the requirements mentioned in Art. 10.

In the regulation of the collective trademark utilization the applicant of the trademark registration application shall indicate the persons authorized to use the collective trademark, the requirements which should be met in order for him to become a member of the association, the requirements to use the trademark, the reasons for which this utilization may be banned to a member of the association, as well as the sanctions which can be applied by the association.

The regulation for the collective trademark utilization may provide that the collective trademark can not be transmitted by the owner but upon the agreement of all the members of the association.

### **Art. 52**

Excepting the reasons for rejection provided for the application for the registration of a individual trademark, a collective trademark may be rejected at registration, if:

- (a) the applicant doesn't have the quality mentioned in Art. 51, paragraph 1;
- (b) the requirements provided in Art. 3, letter (d) are not met;
- (c) the regulation for the trademark utilization is against the public order or the good behavior;

After the publication of the trademark and of the regulation for the collective trademark utilization, the owner of a previous trademark or of a notorious trademark, as well as of a previous right acquired concerning its image or patronymic name, a protected geographical indication, a design or a protected industrial model or a copyright as well as any other interested person can formulate at the State Office for Inventions and Trademarks an opposition to the collective trademark registration in the time limit provided in Art. 23.

**Art. 53**

The owner of the collective trademark has to inform the State Office for Inventions and Trademarks on any modification on the regulation of the trademark utilization.

The modification of the regulation for the trademark utilization has effects only from the date of modification registration in the National Register of Trademarks. The modification is not mentioned in the register, if the regulation for the trademark utilization, modified, does not correspond to the requirements mentioned in Art. 51, paragraph 3.

**Art. 54**

Any interested person can ask from the Court of Bucharest, anytime during the period of trademark protection, the declining of the owner of his rights given by the collective trademark, when:

(a) with no justified reasons, the trademark was not the object of an effective utilization in an uninterrupted period of 5 years, for the products or services for which it was registered;

(b) the owner used the trademark in other conditions than the ones provided in the regulation or he didn't take any measures to prevent such an utilization;

(c) the trademark became susceptible of misleading by utilization.

**Art. 55**

Any interested person may ask the Court of Bucharest to cancel the registration of a collective trademark, in time period of 5 years from its registration, if one of the reasons provided in Art. 48, paragraph 1, letters (a), (b), (d) and (e), exists.

If the registration of the trademark was required in bad faith or the trademark was registered not by abiding the requirements provided in Art. 51, paragraphs 1-3, its cancellation can be required at the Court of Bucharest by the interested person, anytime during the protection period of the trademark.

**Art. 56**

The collective trademarks are abiding the same regime as the individual trademarks, if the present Law does not provide otherwise.

## **Chapter X The marks of certification**

### **Art. 57**

The mark of certification can be registered at the State Office for Inventions and Trademarks by legal entities authorized to perform the control of products or services concerning the elements provided in Art. 3, letter (e).

The legal entities manufacturing, importing or selling products or performing services, other than the ones of control in the quality field, can not ask for the registration of a mark of certification.

### **Art. 58**

The applicant of a registration of a mark of certification shall file, together with the registration application, presented in conformity with Art. 10, or not later than 3 months from the date of notification given by the State Office for Inventions and Trademarks:

- (a) the regulation for the utilization of the mark of certification;
- (b) the authorization or the document proving the legal performing of the certification activity or, if case, the proof of the mark of certification registration in the origin country.

The regulation shall indicate the persons authorized to use the mark, the elements and characteristics which are to be certificated by the mark, the way in which the certification competent authority should verify these characteristics and should supervise the utilization of the trademark, the fees to be paid for the utilization of the trademark, the procedures for solving of differences.

Any natural persons or legal entities, supplier or services supplier may be authorized to use the mark of certification provided that the provisions in the regulation for the mark of certification use are met.

The owner of the mark of certification shall authorize the persons rightfully using the mark for the products or services presenting common characteristics, guaranteed through the regulation for the mark utilization.

### **Art. 59**

Excepting the rejection reasons provided for the application for the registration of an individual mark, a mark of certification is rejected from registration also not for abiding the provisions in Art. 3, letter (e) and of the Art. 57 and 58.

**Art. 60**

After the publication of the mark and of the regulation for its utilization the owner of a previous mark or a notorious one as well as of a previous right acquired concerning its image or its patronymic name, a protected geographical indication, a design or a protected industrial model or a copy right as well as any interested person can formulate at the State Office for Inventions and Trademarks an opposition to the registration of the mark of certification, in the time period provided in Art. 23. The provisions of Art. 53 apply, by analogy, to the marks of certification, as well.

If the users of a mark for certification do not abide to the regulation, the owner can withdraw his authorization for the utilization of the mark or he can apply other sanctions provided in the Regulation.

**Art. 61**

Any interested person can ask the Court of Bucharest the cancellation of the registration for the certification mark, in a time period of 5 years from its registration, if:

- (a) one of the reasons provided in Art. 48, paragraph 1, letters (a), (b), (d) and (e) exists;
- (b) the registration of the mark was done not abiding to the provisions in Art. 3, letter (e);

If the registration of the mark was required in bad faith or the mark is registered not by abiding the requirements provided in Art. 57 and 58, paragraphs 1-3, the interested person can ask the High Court of Bucharest for the cancellation of the mark, anytime during its period of protection.

**Art. 62**

The rights over the mark of certification, can not be assigned by a legal entity, owner of the mark.

The assignment of the right over a mark of certification shall be established by a Governmental Decision.

**Art. 63**

When a mark of certification ceased to be protected, it can not be either filed, or used before the expiration of a time period of 10 years from the date of protection ceasing.

**Art. 64**

The marks of certification are submitted to the regime of the individual marks, if the present Law does not provide otherwise.

The legal fees for the collective trademarks are also applied to the marks of certification.

## **Chapter XI International registration of trademarks**

### **Art. 65**

The provisions of the present Law apply also to the international registrations of trademarks, performed in conformity with the Madrid Agreement or to the Protocol concerning the Agreement, extending their effects in Romania, excepting the case when these conventions do not provide otherwise.

### **Art. 66**

The application for the international registration of a trademark registered in the National Register of Trademarks, in conformity with the Madrid Agreement, as well as the application for the international registration of a trademark filed or written in the National Register of Trademarks, in conformity with the Protocol concerning the Agreement, shall be examined by the State Office for Inventions and Trademarks, upon charging a legal fee.

## **Chapter XII Geographical indications**

### **Art. 67**

The geographical indications of the products are protected in Romania by registering them at the State Office for Inventions and Trademarks, as per the present Law or the international conventions to which Romania is a part and they can be used only by the persons producing or marketing the products for which these indications were registered.

The geographical indications which acquired or will acquire protection upon certain bilateral or multilateral conventions concluded by Romania, are not submitted to the registration procedure set up by the present Law.

The list of the geographical indications of which protection is recognized in Romania, upon the conventions provided in paragraph 2, shall be written at the State Office for Inventions and Trademarks in the National Register of the Geographical Indications and shall be published in the Official Bulletin of Industrial Property.

### **Art. 68**

The producer associations developing a production activity in the geographical area, for the products indicated in the application have the quality to ask the State Office for Inventions and Trademarks for the registration of a geographical indication.

The registration of a geographical indication can be asked the State Office for Inventions and Trademarks directly or through an authorized representative, with the address or premises in Romania and shall be charged with the legal fee.

### **Art. 69**

The State Office for Inventions and Trademarks registers the geographical indications and grants the appellant the right to use them after the Ministry of Agriculture and Food, or, according to the situation, the competent authority in the origin country of the appellant certifies:

- (a) the geographical indication of the product, following to be registered;
- (b) the products which can be marketed under this indication;
- (c) the production geographical area;
- (d) the characteristics and the terms for obtaining which the products should meet in order to be marketed under this indication.

### **Art. 70**

The geographical indication which:

(a) are not in conformity with the provisions in Art. 3, letter (f);  
(b) are generic designations of the products;  
(c) are susceptible to mislead the public over the nature, origin, way of obtaining and quality of the products;  
(d) are against good behavior or public order,  
are excluded from registration.

**Art. 71**

If the application meets the requirements provided by the Law, the State Office for Inventions and Trademarks decides the registration of the geographical indication in the National Register of the Geographical Indications and granting the applicant the right to use it.  
The right to use the geographical indication, acquired through its registration belongs to the members of the association written in the list communicated to the State Office for Inventions and Trademarks.

**Art. 72**

The State Office for Inventions and Trademarks published the geographical indication in the Official Bulletin of Industrial Property and issues to the applicant the certificate for registration of the geographical indication and for granting the right to use it, in a time period of 2 months from the date of the registration decision, upon charging a legal fee.

**Art. 73**

The registration of a geographical indication on the name of producers' association is not an obstacle for the registration of the same indication by any other association having the quality required in Art. 68.

**Art. 74**

The protection period for the geographical indications runs from the date of filing the application at the State Office for Inventions and Trademarks and is unlimited.

The right to use the geographical indication is granted to the appellant for a period of 10 years, with an unlimited possibility of renewal if the requirements imposed when granting this right are maintained.

The application for renewal is charged with a legal fee.

**Art. 75**

The persons authorized to use a geographical indication for certain products have the right to use it in the commercial circuit, applied only on these

products, in accompanying documents, advertisements, prospects and they can also apply the mentioning "registered geographical indication".

**Art. 76**

The utilization of a geographical indication or its imitation by unauthorized persons, is banned, even if the real origin of the products is indicated or if mentioning as: "gender", "type", "imitation" and others alike.

The persons authorized by the State Office for Inventions and Trademarks to use a geographical indication for wine or alcoholic beverages may ban the utilization of this indication for any other person, regarding wine or alcoholic beverages not originating from the place suggested in the respective geographical indication, even in the cases in which the real origin of the product is mentioned in particular or in the case in which the geographical indication is used under translation or is accompanied by expressions, such as: "of gender", "of type" and others alike.

**Art. 77**

The Minister of Agriculture and Food may ex officio proceed or upon the intimation of an interested person, to control the products in circulation under the registered geographical indication.

**Art. 78**

The right to use a geographical indication can not make the object of any transmission.

**Art. 79**

Any interested person may ask the Court of Bucharest the cancellation of its registration on the entire protection period for the geographical indication, if the registration of the geographical indication was done not abiding the provisions in Art. 69 and 70.

Not for abiding the quality requirements and the specific characteristics for the products in the area to which the geographical indication refers, the Minister of Agriculture and Food or any other interested person can ask the Court of Bucharest the rights declining of the persons authorized by the State Office for Inventions and Trademarks to use the registered geographical indication.

The final sentence of the Court of Bucharest is communicated to the State Office for Inventions and Trademarks by the interested person. The State Office for Inventions and Trademarks erases the geographical indication from the National Register of Geographical Indications and publishes its

erasure in the Official Bulletin of Industrial Property in a time period of 2 months from the communication.

## **Chapter XIII Protecting the rights over the trademarks and geographical indication**

### **Art. 80**

The decisions of the State Office for Inventions and Trademarks concerning the trademark registration can be appealed at this office by the appellant of the trademark registration or the owner of the trademark, in a time period of 3 months from the communication, upon charging a legal fee. The decisions of the State Office for Inventions and Trademarks concerning the registration of assignment or the license in the National Register of Trademarks can be appealed at the State Office for Inventions and Trademarks by interested persons, in a time period of 3 months from the communication or its publication.

The appeals formulated in conformity with paragraphs 1 and 2 shall be solved by a re-examination communication in the frame of the State Office for Inventions and Trademarks.

### **Art. 81**

The decision of the re-examination commission, motivated, is communicated to the parts, in a time period of 15 days from the ruling and it can be appealed at the High Court of Bucharest, in a time period of 30 days from the communication.

The decisions of the High Court of Bucharest can be appealed at the House of Appeals of Bucharest in a time period of 15 days from the communication. The sentences of the High Court of Bucharest ruled in the cases mentioned in Art. 45, 48, 54, 55, 61 and 79 may be appealed at the House of Appeals of Bucharest in a time period of 30 days from the communication.

### **Art. 82**

Upon the request of the Court, the State Office for Inventions and Trademarks has to forward it the documents, the papers and information necessary to judge the cause it was invested with.

### **Art. 83**

It is an offence and punished with imprisonment from 3 months to 3 years or with a fine of 15 millions lei:

(a) the counterfeiting, imitation or utilization with no right of a trademark aiming to mislead the public on the quality of products or services to which the trademark refers;

(b) the circulation with no right of a product bearing a trademark identical or similar with a trademark registered for identical or similar products

and which is prejudicing the owner of the registered trademark;  
(c) the circulation of products bearing geographical indications showing or suggesting the product originates from a geographical area, other than the place of origin aiming to mislead the public on the geographical origin of the product.

If a third party commits any of the acts provided in Art. 35, paragraph 2, without the consent of the owner of the registered trademark, it is considered an offence of counterfeiting.

Neither of the acts provided in Art. 35, paragraph 2 is considered a counterfeiting if it was performed before the date of the trademark publication.

An action in counterfeiting can be started by the owner of the trademark only after the date of the trademark registration in the National Register of Trademarks.

The criminal action is getting started upon the previous complaint of the prejudiced part.

#### **Art. 84**

The owner of the trademark or the Ministry of Agriculture and Food can require to the competent Court to order the measure of seizure and, if case, of destroying the products bearing trademarks or geographical indications mentioned in Art. 83.

The provisions of paragraph 1 apply to the materials and equipment used directly in the development of the offences mentioned in Art. 83.

#### **Art. 85**

For damages caused by deeds mentioned in Art. 83, the persons found guilty may be forced to pay damages, as per the civil law.

#### **Art. 86**

Any utilization of trademarks or of geographical indications, against the fair practices in the industrial or commercial activity aiming to mislead the consumers is considered an act of unfair competition and is punished with imprisonment from 1 month to 2 years or with a fine of 15 millions lei.

The criminal action is getting into motion upon the previous complaint of the prejudiced part.

#### **Art. 87**

The owner of the trademark or, if case, the Ministry of Agriculture and Food can ask the Court to order some security measures when a risk of

breaching the rights over the protected trademark or geographical indication by third parties is considered to exist and if this breaching is menacing to cause an irreparable prejudice or if there is a risk of destroying the evidence elements.

The security measures shall refer, in particular, to the ceasing of the deeds of breaching the rights mentioned in paragraph 1 and preserving the evidence bearing illicitly a trademark or a protected geographical indication.

The provisions in the civil law concerning the assurance distraint shall also apply to the documents which touch the rights concerning the protected trademarks or geographical indications.

**Art. 88**

In order to direct the measures provided in Art. 87 the provisions of Art. 581 and 582 in the Civil code shall apply.

The Court can force the claimant to pay for a bail in an amount established by it, when ordering insurance measures.

**Art. 89**

The Court shall ask the claimant to supply any probation elements in his possession, in order to prove that he is the owner of the breached right or of which breaching was inevitable.

In the case when the evidence means in sustaining the claims of the claimant are controlled by the accused, the Court shall order that the evidence to be produced by the accused, provided that the information is guaranteed confidential, as per the Law.

The Court shall be allowed to order the claimant to pay for all the damages caused by the accused, as a result of an abusive utilization of the procedural rights on the protected trademark or geographical indication.

**Art. 90**

The owner of the trademark or, if case, the Ministry of Agriculture and Food can ask the author of the right breaching, immediate information on the provenience and distribution circuits of the goods illegally marked as well as information on the identity of the manufacturer or the merchant, the quantity of manufactured, delivered, received or ordered goods.

**Art. 91**

In the cases mentioned in Art. 83, the customs authorities may, ex officio or upon the request of the right owner, order the ceasing of the customs activity at the import or export of products bearing trademarks or

geographical indication.

The customs competencies on the assurance of abiding the rights over the protected trademarks or geographical indications belong to the general Department of Customs, as per the Law.

## **Chapter XIV The duties of the State Office for Inventions and Trademarks**

### **Art. 92**

The State Office for Inventions and Trademarks is the specialized body of the central public administration, the only authority assuring protection of trademarks and geographical indications on the Romanian territory, as per the present Law.

### **Art. 93**

The State Office for Inventions and Trademarks has the following duties in the field of trademarks and geographical indications:

- (a) registers, examines and publishes the applications for the trademark registration;
- (b) examines the registered trademarks or the trademarks filed to be registered at the World Intellectual Property Organization, as per the Madrid Agreement or per the Protocol Concerning the Agreement, reorganizing or rejecting their protection on the Romanian territory;
- (c) registers and publishes the applications of the geographical indication registration and grants their protection on the Romanian territory;
- (d) issues certificates for trademark registration;
- (e) issues certificates for registration of geographical indications and grants the right to use them;
- (f) organizes and keeps the National Register of Trademarks and the National Register of Geographical Indications;
- (g) issues certificates of priority for trademarks;
- (h) performs searches before the registration of a trademark;
- (i) manages, preserves and develops the national collection of trademarks and geographical indications and sets up informational data base in the field;
- (j) keeps contacts with similar governmental bodies and regional organizations of industrial property; represents Romania in the specialized international organizations;
- (k) edits the official publications on trademarks and geographical indications of the products and assures the exchange of publications with the similar foreign national administrations and with the international bodies and organizations in the field;
- (l) also meets other duties provided by the Law.

## **Chapter XV Final and transitory provisions**

### **Art. 94**

The applications for the registration of trademarks for which a decision was not made till the date of entering in effect of the present Law are submitted to its provisions.

The Government shall approve the regulation for its enforcement till the date of the present Law entering in effect.

### **Art. 95**

The present Law shall be valid in 3 months from the date of its publication in the Official Journal of Romania.

The following law and decisions shall be repealed on the same date:

- Law no. 28/1967 on the factory, trade and service marks, published in the Official Bulletin, no. 114 of December 29, 1967;
- The Decision of the Council of Ministers no. 77/1968 on the application of the Law no. 28/1967, published in the Official Bulletin no. 8 of January 28, 1968;
- The Decision of the Council of Ministers no. 1,057/1968 for the approval of the Regulation on the composition, organization and functioning of the commission for solving the litigation on the factory, trade and service marks, published in the Official Bulletin no. 66 of May 17, 1968;
- The Decision of the Council of Ministers no. 2,508/1969 for the establishing and sanctioning of offences to the legal norms concerning inventions, innovations and rationalizations as well as the factory, trade and service marks published in the Official Bulletin no. 159 of December 31, 1969;
- any other provisions contravening the present Law.