



Update of the Romanian trademark law

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In December 2015, the Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks was adopted. According to the directive, the EU member states were supposed to implement it in their national legislation by 14.01.2019.

At the beginning of July 2020, Romania was the only EU member state not having fulfilled this obligation, so the European Commission requested sanctions against Romania before the European Court of Justice. In this context, on 08.07.2020, the Romanian legislative body published the law No. 112/ 2020 (“**Law 112**”) in the Official Journal. The Law amends law No. 84/ 1998 on trademarks and geographical data (“**Trademark Law**”); it came into effect on 13.07.2020.

Important changes

Law 112 includes – according to the directive – important changes, among which.

- (i) a revised definition of trademarks which has been adapted to the “*digital age*”,
- (ii) new reasons for rejecting requests for trademark registration,
- (iii) new regulations regarding counterfeit goods, found on Romanian territory in transit,
- (iv) reduced terms, clarifications and simplifications of the registration procedure,
- (v) additional legal remedies on cancelling a trademark and so on.

We will briefly analyze below the most important changes.

Definition of the trademark

In Art. 2 of the Trademark Law, the requirement concerning “the graphical representation” was abrogated. This widens the area of the symbols that can be registered as trademarks by multimedia trademarks, hologram trademarks etc. The symbol must however, cumulatively,

- be adequate, in order to distinguish among the products/ services of a company and those of another, and
- be represented in the trademark register in such way that the authorities and the public can determine clearly and precisely the object of protection.

New reasons for rejecting trademarks

According to the new art. 5 of the trademark law, the registration of a trademark is rejected if it infringes the protection granted by the following rights:

- designation of origin and geographical data;
- traditional denominations for wines;
- ensured traditional specialties;
- protection type for plant types.

Opposition and cancellation procedure

Until now, the two-month-term for raising objections against the registration of a trademark started with the publication of the request for trademark registration. According to the new legislation, this

term starts running with the publication of the decision of the Patent and Trademark Office OSIM concerning the approval of the request. This means that OSIM firstly assesses the absolute reasons for rejecting the trademark; relative reasons, which can be invoked by third parties, are only taken into account subsequently.

Moreover, the law sets forth a so-called “cooling off period” of 2 months in case of an objection; this term will be granted by OSIM to the parties in order for them to settle the disputes by means of negotiation. The term can be extended upon the request of the parties.

Eventually, the period of limitation of 5 years for claiming the cancellation of a trademark was completely removed. Thus, this right will not become time-barred; previously, this would apply only for the action of cancelling a trademark that was registered in bad faith.

Additional legal remedy on cancelling, respectively revocation of a trademark

Until now, the cancellation, respectively revocation of a trademark could only be required by recourse to legal action (before the Bucharest Tribunal). According to Law 112, starting with 14.01.2023, authorized persons are granted an option right between the abovementioned action and an administrative procedure before OSIM; the OSIM decision can be subsequently challenged before the Bucharest Tribunal.

Extent of trademark protection

The products and services protected by the registration of a trademark, are divided through the Classification in Nice into categories. In case the applicant provides in his registration request only the title of a category, the trademark will apply only for products that are included expressly in the title of the classification. The protection can be extended, upon request, on all products included in that particular category.

Another important novelty concerns the measures available for trademark holders against counterfeit goods. The law explicitly provides the possibility to prohibit the import of counterfeit goods in Romania even if they are not sold on the Romanian market, but only transiting the country.

Conclusion

The implementation of the directive was needed for the modernization of the Romanian trademark law. The new law increases the protection for existing and future trademarks by means of an efficient registration procedure, shorter periods and extended contestation options. Updated procedure rules are to be expected in the following months.

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