

**LAW No. 84/1998**

*Concerning Trademarks and Geographic Indications*

Date of entering in force: July 23, 1998

**General Provisions**

*Article 1*

Rights regarding trademarks and geographic indications shall be recognized and protected on the Romanian territory pursuant to conditions provided for in the present law.

*Article 2*

Foreign persons, either natural or legal, having the headquarter or residence outside the territory of Romania, shall benefit from the provisions of the present law, under the conditions of international conventions concerning trademarks and geographic indications to which Romania is a party.

*Article 3*

Under the provisions of the present law, terms and expressions shall be defined as follows:

- a) trademark shall mean a sign susceptible of graphic representation, used by natural and legal persons to distinguish their own goods or services from those belonging to other persons; trademarks shall mean distinct signs, such as words including patronyms, drawings, letters, figures, figurative elements, three-dimensional shapes, especially the shapes of the goods or their packing, combination of colors as well as any combination of those signs;
- b) the earlier registered trademark shall mean that registered trademark, as well as the trademark that is the object of an application for registration in the National Register of Trademarks, on condition that it was registered subsequently;
- c) a famous trademark shall mean that trademark widely known in Romania at the date of deposit of an application for registration of a trademark or at the priority date claimed in the application; in order to prove the trademark is widely known the notoriety of that trademark, shall be taken into consideration, in the segment of the public targeted by the goods and services bearing the respective trademark, without registration or use of that trademark in Romania;
- d) the collective trademark shall mean that trademark which serve to distinguish goods or services that belong to the members of an association from those belonging to other persons;
- e) the certification trademark shall mean that trademark which certifies, by the owner of the trademark, quality, materials used, method of manufacturing goods or rendering services, precision or other characteristics of goods or services bearing such a trademark;
- f) the geographic indication shall mean the denomination serving to designate a product having its origin in a country, area or locality of a state, when qualities,

reputation or other defined characteristics are essentially determined by such a geographic origin;

- g) the applicant shall mean the natural or legal person under whose name an application for trademark registration is filed;
- h) the owner shall mean the natural or legal person under whose name the trademark is registered in the National Register of Trademarks;
- i) the authorized agent referred as agent throughout the present law, shall be the intellectual property counselor, who shall also have the empowerment of representation in the proceedings upon the State Office for Inventions and Trademarks;
- j) Paris Convention shall be the Convention for the protection of Industrial Property, of March 20, 1883, Paris, as revised and amended;
- k) States members of the Paris Union shall be the countries constituted in the Union for the Protection of Industrial Property for which the Paris Convention is applicable;
- l) Madrid Agreement shall be the Madrid Agreement concerning the International Registration of Trademarks, of April 14, 1891, as revised at Stockholm on July 14, 1967;
- m) Protocol under the Agreement shall be the Madrid Protocol of June 27, 1989 regarding the Madrid Agreement concerning the International Registration of the Trademarks.

## **Trademarks Protection**

### *Article 4*

The right in a trademark shall be acquired and protected through registration at the State Office for Inventions and Trademarks.

### *Article 5*

The following signs shall not benefit from protection and cannot be registered as trademarks:

- a) those which are not in compliance with article 3 let. a)
- b) those which lack distinctive character;
- c) those which consist merely of signs and indications which have become customary, in common language or loyal and constant practices of trade;
- d) those which consist merely of signs or indications to designate in practice of trade species, quality, quantity, destination, value, geographic origin, or the time of manufacture of the goods, or of rendering the services, or any other characteristics that may describe the goods or services;
- e) those which consist merely of the shape of the goods determined by the nature of such goods or needed to obtain a technical result or that adds substantial value to such goods;
- f) those which comprise false or deceptive indications susceptible to mislead the public regarding geographic origin, quality, nature or destination of the goods or services;
- g) those which include a geographic indication or consist in a such geographic indication, for goods not originating in the territory indicated by such a trademark, if the use of such an indication is susceptible to mislead the public regarding the real geographic origin;

- h) those which consist in or include a geographic indication as a trademark for wines or spirits not originating from geographic territory indicated;
- i) those which are contrary to the public order and morality;
- j) those which include, without the consent of the owner, the image or the patronim of a person who enjoys renown in Romania;
- k) those which include, without the authorization of the organizations having such right: reproductions or imitations of armorial bearings, flags, state emblems, insignia, official seals for control and warranty, coat-of-arms if they belong to the countries of the Paris Union pursuant to the art. 6 ter from the Paris Convention;
- l) those which include, without the authorization of the organizations having such right: reproductions or imitations of armorial bearings, flags, other emblems, logos, initials, denominations pursuant to the art. 6 ter of Paris Convention if they belong to international intergovernmental organization to which one or more countries of the Union are parties.

Provisions of paragraph 1 let. b), c) and d) shall not apply if prior to the date of deposit of the application, the trademark acquired distinctive character as a result of its use.

#### *Article 6*

A trademark cannot be registered at application, for reasons other than the provisions under the art. 5, paragraph 1, as follows:

- a) a trademark that is identical with a trademark registered earlier for identical goods or services;
- b) a trademark that is identical with a trademark registered earlier for similar goods and services, when there is a risk of misleading the public;
- c) a trademark that is similar with a trademark registered earlier for identical or similar goods or services, when there is a risk of misleading the public, including also the risk of being associated with the earlier registered trademark;
- d) a trademark that is identical or similar with a famous trademark in Romania for identical or similar goods or services, at the date of the deposit of the application;
- e) a trademark that is identical or similar with a famous trademark in Romania for goods or services other than those for whom the protection is claimed for the trademark, when the unjustified use of this trademark could benefit from the distinctive character or the notoriety of the famous trademark or this use could cause prejudices to the owner of the famous trademark;

#### *Article 7*

In the cases provided for in art. 6, the signs can be registered as trademarks with the consent of the owner of the earlier trademark on the famous trademark .

#### *Article 8*

The nature of the goods or services for which the registration of the trademark is requested shall not constitute an obstacle to its registration.

### **Application for trademark registration**

#### *Article 9*

The right in a trademark shall belong to the natural or legal person who, under the provision of the law, first filed the application for trademark registration.

### *Article 10*

The trademark application, containing the applicant's identification data, a reproduction of a trademark and an indication of the goods or services for which the registration is requested, drafted in Romanian, shall be filed with the State Office for Inventions and Trademarks and shall constitute the regular national filing of the trademark. The application shall refer to a single trademark.

The application will expressly mention when the trademark:

- a) contains one or more colors claimed as distinctive elements of the trademark;
- b) is three-dimensional;

The application will contain as well the data regarding the capacity of the applicant.

The application will contain, as the case may be, the original name or the translation of the trademark or of elements of the trademark.

### *Article 11*

The date of the regular national filing is the date when the application was deposited at the State Office for Inventions and Trademarks under all the conditions provided for in article 10, paragraph 1.

When an application for trademark registration was first deposited under legal conditions in another country of the Paris Convention or member of the World Trade Organization, the applicant can claim the date of the first filing through an application for the same trademark in Romania, provided the application is deposited at the State Office for Invention and Trademarks within 6 (six) months from the first filing.

### *Article 12*

At the applicant's request, priority benefits shall be granted for trademarks exhibited as goods and services in an official or officially recognized international exhibition organized on the territory of Romania, or on the territory of the States that are members to the Paris Convention, if the trademark application is filed at the State Office for Inventions and Trademarks within six (6) months from the exhibition date, the applicant shall have the priority benefit starting from the date when the product was displayed in the exhibition.

This priority benefit will not extend the period of priority provided for in article 11, paragraph 2.

### *Article 13*

The priority benefits provided in articles 11 and 12 shall be claimed at the time of filing the trademark application and shall be documented through priority documents and will be subjected to legal fees.

The priority documents and the proofs of payment shall be filed within a maximum three (3) months period from the date of the application for trademark registration.

Failure to adhere to the time limits set forth in paragraph 2 shall result in nonrecognition of the claimed priority.

#### *Article 14*

The registration of a trademark can be requested individually or in common by a natural or legal person, directly or through an agent with the residence or headquarter in Romania.

If the registration is requested through an agent, the application will also contain the agent's identification data. When an agent is appointed by the applicant, the empowerment of representation of the applicant will be submitted attached to the application or within a maximum three (3) months period from the filing date, to avoid rejection of the application.

#### *Article 15*

The applicant of the trademark application will send within a maximum of three (3) months from the date of filing at the State Office for Inventions and Trademarks, proof of payment of the registration and examination fees, in amounts set forth by the law.

#### *Article 16*

The applicant of a trademark application concerning several goods or services can request upon the State Office for Inventions and Trademarks the division of the original application in two or more applications, distributing the goods or services into the divisionary application, with the payment of the fee provided for with the law.

The divisionary applications will bear the deposit date of the original application and, where is the case, the priority benefit, according to art. 11, paragraph 2 or art. 12 paragraph 1.

The applicant can request the division of the original application during the examination procedure at the State Office for Inventions and Trademarks, before the decision of a registration, as well as during the procedure in the re-examination commission at the State Office for Inventions and Trademarks or during any appeal procedure filed against the decision for registration.

The applicant shall file the documents requested by the State Office for Inventions and Trademarks for the division of the original application and shall pay legal fees within three (3) months for the date of the division request. Failure to adhere to this provision shall result in recognition by the State Office for Inventions and Trademarks of the fact that the applicant gave up division of the original application.

### **The Registration Procedure**

#### *Article 17*

Within one (1) month from the date of filing of the trademark application, the State Office for Inventions and Trademarks shall analyze if the conditions provided for in article 10, paragraph 1, have been complied with and if affirmative, grants the date of deposit.

If the application fails to meet the conditions provided for in art. 10, paragraph 1, the State Office for Inventions and Trademarks will notify the applicant of any shortcomings of the application, allowing a period of three (3) months for completing the filing. If the applicant replies within the deadline set in the the State Office for Inventions and Trademarks notification, the date of the regular national filing shall

be the date of deposit of the trademark application according to article 10, paragraph 1. Otherwise, the application is rejected.

If the registration and examination fees are not paid within the deadline provided for in art. 15, State Office for Inventions and Trademarks allows the applicant, for justified reasons, another period of 2 (two) months.

Failure to pay the fees within the deadline shall be considered as the applicant gave up the registration, and the application is rejected.

#### *Article 18*

If the trademark application fail to meet the requirements of presenting the elements intended to prove the applicant's capacity as natural or legal person, the State Office for Inventions and Trademarks shall notify the applicant of the omissions noticed and will grant a deadline for completion. If the applicant fails to meet this deadline, State Office for Inventions and Trademarks shall reject the trademark application for registration.

#### *Article 19*

The trademark application shall be substantively examined by the State Office for Inventions and Trademarks within six (6) months from the date of payment of registration and examination fees.

The State Office for Inventions and Trademarks shall examine:

- a) the applicant's capacity as provided for in art. 3, paragraph g;
- b) the criteria provided for in art.13, paragraph 1 and 2, if in the application there is any priority claimed;
- c) reasons for refusing provided for in art. 5, par. 1 and art. 6.

#### *Article 20*

The examination of the reasons for refusing provided for in art. 6, paragraph d) and e) shall be made according to certain criteria, such as:

- a) the degree of the original or acquired distinctivity of the famous trademark in Romania;
- b) the length and extension of the use in Romania of the famous trademark for those goods and services for which the trademark registration has been requested;
- c) the length and extension of the advertisement concerning the famous trademark in Romania;
- d) the geographic area where the famous trademark in Romania is used;
- e) the degree of knowledge of the famous trademark on the Romanian trade market, by the section of the public targeted;
- f) the existence of identical or similar trademarks for identical or similar goods or services, having an owner other than the one claiming notoriety of his trademark.

For the examination of the reasons for refusing , based on the criteria provided for in par. 1, the State Office for Inventions and Trademarks may request public authorities, public institutions as well as legal entities of private law to present documents in order to prove the notoriety of the trademark in Romania.

### *Article 21*

When a reason for refusing, as provided for in article 6, is applied only to certain goods or services for which the trademark registration has been requested, the registration shall be refused only for those goods or services.

### *Article 22*

If, as a result of the examination of the application, as provided for in art. 19 and 20 it is found that the conditions for trademark registration have been fulfilled, the State Office for Inventions and Trademarks shall decide the registration of the trademark and the publication of the trademark in the Official Bulletin for Industrial Property. Within two (2) months from the date of the decision, the application shall be published.

If the trademark fails to meet the legal requirements for registration, the State Office for Inventions and Trademarks shall notify the applicant, allowing him a period of three (3) months to present his point of view or for rebuttal. The deadline can be extended with another period of three (3) months, upon applicant's request and payment of the legal fee.

At the end of the period provided for in paragraph 2, the State Office for Inventions and Trademarks shall decide, as the case may be, the registration of the trademark, the rejection of the trademark application or will ascertain the withdrawal of the application.

### *Article 23*

Within a period of three (3) months from the date of publication of the trademark, the owner of an earlier registered trademark or of a famous trademark, as well as the owner of an earlier priority right concerning the image or the patronim, protected geographic indication, a protected drawing or industrial model, any other protected industrial property right or copyright, as well as any interested person may file an opposition at the State Office for Inventions and Trademarks, regarding the trademark publication.

The opposition shall be filed in written form, with reasoning and upon payment of the legal fee.

Failure to pay the legal fees for opposition shall be considered as the opposition has not been filed.

### *Article 24*

The State Office for Inventions and Trademarks shall notify the applicant that an opposition has been filed, according to art. 23, indicating the opponent's name as well as the reasons for the opposition regarding the trademark.

Applicant shall be given a three (3) month period from the date of notification to present his point of view; upon applicant's request, the period can be extended by the State Office for Inventions and Trademarks with as much as three (3) months.

### *Article 25*

Oppositions filed regarding the trademark publication shall be considered by an examination commission from the State Office for Inventions and Trademarks.

If the oppositions are well-grounded, the commission shall decide to reject trademark registration.

The decision to reject trademark registration can be appealed by the applicant, in time and procedure provided for in art. 80.

The decision to reject trademark registration, when final, shall be published in the Official Bulletin for Industrial Property.

#### *Article 26*

The applicant is entitled, at any time, to withdraw the application for trademark registration or to restrain the list of goods or services. When the trademark is already published, the withdrawal or restraint shall be published in the Official Bulletin for Industrial Property.

The applicant may request for alterations of the application for trademark registration only for modifications of his name or address, or for rectification of elements which do not affect essentially the trademark, nor to extend the list of goods or services.

Any alteration requested by the applicant before registration, if substantially affects the trademark or the list of goods or services, shall be the object-matter of a new application for trademark registration.

#### *Article 27*

During the registration procedure, the State Office for Inventions and Trademarks may request the applicant to provide explanations and documents as needed, if there is any doubt regarding the accuracy or the content of the elements of the application for trademark registration.

#### *Article 28*

When decisions for trademark registration are definitive, the State Office for Inventions and Trademarks shall decide the trademark's registration in the National Register of Trademarks, and shall grant to the applicant the certificate of registration, upon payment of the fee provided for in the law.

### **The Length, Renewal and Modification of the Trademark Registration**

#### *Article 29*

Registration of the trademark produces effects starting with the date of the national regular filing of the trademark for a period of ten (10) years.

At the request of the trademark owner, the trademark registration may be renewed at the end of each ten-year period of protection, subject to payment of the fee provided in the law.

The renewal may not be requested earlier than three (3) months before the expiration of the current protection period.

The renewal of the trademark registration shall have no effect until the day after its expiration.

The fee for the request for the renewal of a trademark registration is due at the date when the request has been filed, in the amount provided for at that time; the fee may

also be paid within the next six (6) months from the expiring of the period for which the protection was granted, but with increase provided for in the law.

Failure to pay the fee as provided for in paragraph 5 shall be considered as the owner's right in the trademark ceased.

#### *Article 30*

The request for renewal of the trademark registration shall contain:

- a) the express request for renewal of the trademark registration;
- b) owner's identification data, when necessary, agent's name, address or headquarter;
- c) trademark registration number in the National Register of Trademarks;
- d) the date of the national regular filing of the application for trademark registration.

When the owner requests the renewal for only a part of the goods and services registered in the National Register of Trademarks, there shall be an indication of the name of these goods or services for which the renewal of the trademark registration is required.

#### *Article 31*

If the request for renewal of the trademark registration fails to meet the legal requirements, the State Office for Inventions and Trademarks shall notify the applicant, allowing him a period of three (3) months to present his point of view; the absence of a reply within the legal period shall determine the request for renewal of the trademark registration to be rejected.

The applicant of the request for renewal can appeal the decision to reject the renewal of the registration, in time and procedure provided for in art. 80.

#### *Article 32*

The renewal of trademark registration shall be registered in the National Register of Trademark and published in the Official Bulletin for Industrial Property, within a period of six (6) months from the date the request for renewal has been filed at the State Office for Inventions and Trademarks.

#### *Article 33*

During the period for which trademark protection is granted, the owner may request at the State Office for Inventions and Trademarks, upon payment of the fee provided for in the law, modification of elements of the trademark, which do not affect essentially the general appearance of the trademark.

The State Office for Inventions and Trademarks shall register in the National Register of Trademark the modifications as required, according to paragraph 1, and shall publish the trademark as modified.

#### *Article 34*

During the period for which the trademark protection is granted, the owner may request at the State Office for Inventions and Trademarks, upon payment of the fee provided for in the law, the registration in the National Register of Trademarks of modifications regarding the owner's name, denomination, address or headquarter. The modifications registered in the National Register of Trademarks shall be provided for in the Official Bulletin for Industrial Property.

## **Granting of Rights over a Trademark**

### *Article 35*

The trademark registration confers on its owner an exclusive right over the trademark.

The owner of the trademark has the right to ask the competent legal instances to prevent third parties from the act of using, in their trade, without the owner's consent, of:

- a) a sign identical to the trademark for the goods and services identical to those for which the trademark is registered;
- b) a sign which, due to its similarity to the trademark and the goods and services for which the trademark is registered, may produce a risk of misleading the public, including the risk of association of the trademark with the sign;
- c) a sign identical or similar to the trademark for goods or services other than those for which the trademark is registered, when this became a famous trademark in Romania and if, by using the sign without strong reasons, it could take benefit from the distinctive character or the notoriety of the trademark, or using the sign, the owner of the will be prejudiced.

In the enforcement of paragraph 2, the owner of the trademark can request to prevent third parties especially from the act of:

- a) applying the sign on goods or packages;
- b) offering or selling goods or detaining them for this purpose or, as the case may be, offering or rendering services under this sign;
- c) importation or exportation of goods under this sign;
- d) using the sign on documents or for advertisement.

### *Article 36*

The applicant can request third parties to be prevented from the acts provided for in art. 35, paragraph 2, only after the trademark publication.

For acts consequent to the trademark publication, the applicant can request damages according to common law. The owner is executed only after the date of trademark registration.

If the application for trademark registration has been rejected, the applicant is not entitled to damage payment.

### *Article 37*

The owner of a registered trademark cannot request to prevent other persons from detaining, offering for sale or trading the goods under this trademark, if the goods were traded by the owner himself or with his consent.

The provisions under paragraph 1 shall not apply if the owner brings strong evidence to oppose the trading of goods, especially when the characteristics of the goods are modified or altered after their selling.

### *Article 38*

The owner of a trademark cannot request to prevent a third party from the use in his trading of:

- a) the name/denomination or the address/headquarter of the owner;
- b) elements indicating species, quality, destination, value, geographic origin, fabrication date or period of rendering the service under the trademark, as well as any other characteristic of goods or services;
- c) the trademark, when this is needed to indicate the destination of the good or service, especially for annexes or detachable parts.

The provisions under paragraph 1 shall apply, provided that the use of elements provided for in let. a)-c) complies with loyal practices.

### **Transferring of Rights over a Trademark**

#### *Article 39*

The rights in a trademark may be transferred, anytime during the period of protection of the trademark by assignment or licensing.

The rights in a trademark shall be transferred as well when the debtor owner of the trademark is sued as provided for in the law.

#### *Article 40*

The rights in a trademark may be transferred as assignment independently from the transfer of the trade fond where the trademark is included. The lease should be in written form and signed by the parts, under the sanction of nullity.

The transfer of rights in a trademark as assignment may be done for all or parts of goods or products for which the trademark is registered; the assignment, even partial, cannot restrain the territory of using the trademark for goods or services concerned.

If the entire patrimony of the owner of the trademark is totally transferred, the rights in a trademark are transferred as well. The transfer of elements from the owner's patrimony do not affect the capacity of owner of the right in a trademark.

Identical or similar trademarks, which belong to the same owner and are used for identical or similar goods or services, can be only totally transferred as assignment and by one single person only, under the sanction of nullity of the transferring agreement.

#### *Article 41*

The application for registration of the assignment shall enclose the document certifying the change of the owner of the trademark.

Upon the request of the interested person and the payment of the fee as provided for in the law, the State Office for Inventions and Trademarks shall register the assignment in the National Register of Trademarks and publish it in the Official Bulletin for Industrial Property. Third parties can oppose the assignment, starting from the date of its registration in the National Register of Trademarks.

#### *Article 42*

The owner of the trademark can authorize, by a license agreement, third parties to use the trademark on their whole or parts of the territory of Romania, for all or parts of the goods or services for which the trademark was registered. License can be exclusive or non-exclusive.

The owner of the trademark can claim the rights granted by the trademark against the licensee who infringed the provisions of the license agreement, regarding the length of use, the appearance of the trademark and the nature of goods or services for which the license has been granted, the territory of use of the trademark, the quality of the goods manufactured or the services rendered by the licensee under the trademark for which the license has been granted.

During the period when the license agreement is effective, the licensee shall be completed to:

- a) to use only the trademark provided for in the license agreement for the goods to which the trademark is applicable, but having the right to mark these goods with signs indicating he is their manufacturer;
- b) to put the mention under license next to the trademark applied on the goods for which the trademark is licensed, according to the agreement.

Licenses shall be registered in the National Register of Trademarks upon payment of the fee provided for in the law and published in the Official Bulletin for Industrial Property. Third parties can oppose the license, starting from the date of its registration.

#### *Article 43*

If not otherwise provided for in the license agreement, the licensee cannot sue for counterfeit without the consent of the owner of the trademark.

The owner of an exclusive license can sue for counterfeit if, after notifying the owner of the trademark about acts of counterfeit which came to his knowledge, the owner did not respond in the time requested by the licensee.

When a sue for counterfeit has been promoted by the owner, any of the licensees can be admitted in process, to claim payment of damage caused by trademark counterfeit.

### **Termination of Rights over a Trademark**

#### *Article 44*

The owner of a trademark may disclaim the effects of cease registration for all or part of the designated goods or services.

The disclaimer is stated in writing at the State Office for Inventions and Trademarks by the owner of the trademark or the agent appointed by the owner and takes effect from the moment of its registration in the National Register of Trademarks, for the designated goods or services.

If a license was registered, the disclaimer is recorded only, if the owner justifies the fact that the licensee was informed about his intention to disclaim the trademark.

#### *Article 45*

Any interested person may request at the Municipal Court of Bucharest, at any time during the period of trademark protection, the cancellation of owner's rights in the trademark, based on one of the following reasons:

- a) the trademark was not effectively used uninterruptedly for a period of five (5) years on the territory of Romania, for those goods or services for which it was registered and there are no justified reasons for the failure to use the trademark;

- b) the trademark has become, after registration date, customary in the trade with a good or service for which it was registered, with or without owner's action;
- c) the trademark has become, after the registration date and as a result of its use by the owner or with owner's consent, susceptible to mislead the public, especially regarding the nature, quality, geographic origin of goods or services for which the trademark was registered;
- d) the trademark was registered by a person not complying with the position of the art. 3, paragraph g.

The cancellation of owner's rights in the trademark shall take effect starting the date of the definitive court verdict.

#### *Article 46*

Effective use of the trademark shall be considered:

- a) the use of a trademark by a third party with the owner's consent;
- b) the use of a trademark in a modified form, relative to what it was registered if it does not alter its distinctive character;
- c) the placement of a trademark on goods or packaging exclusively for exporting;
- d) the failure to use the trademark in circumstances not controlled by the owner's will, such as importation or other regulations of public authorities regarding goods or services relative to the trademark.

The cancellation of owner's right in the trademark shall not apply if, within the period of time from the end of the period provided for in art. 45, paragraph 1 a) to the date of the filing of cancellation request, the trademark was effectively used.

Nevertheless, if the use of the trademark has started or restart three (3) months before the date of the filing of cancellation request, the use will not be considered effective, if the preparations to start or restart the use were initiated only after the owner knew the intention to file a cancellation request.

#### *Article 47*

When a person attempts to justify the failure to use the trademark the burden of proof shall be with the trademark owner, who is entitled to present any evidence.

#### *Article 48*

Any interested person may request at the Municipal Court of Bucharest the cancellation of trademark registration based on any of the following reasons:

- a) the trademark was registered without compliance with the provisions of the art 5, paragraph 1;
- b) the trademark was registered without compliance with the provisions of art.6;
- c) the trademark registration was applied for in bad faith;
- d) the trademark prejudices the right in the image or patronim of a person;
- e) the trademark registration prejudices rights earlier granted for protected geographic indication, a protected drawing or industrial model or any other protected industrial property rights or copyrights.

The cancellation request for reason provided for in paragraph 1, c) can be filed at any time during the period for which trademark protection was granted.

The period of time for which the trademark cancellation can be requested for reasons provided for in paragraph 1, a), b), d) and e), shall be of five (5) years for the date of trademark registration.

The cancellation of trademark registration cannot be requested for the reason of an existing conflict with an earlier registered trademark, if failure to comply with the provisions of art. 45 and 46.

#### *Article 49*

The owner of an earlier registered trademark, who willingly tolerate for the uninterrupted use for a period of five (5) years of a trademark registered subsequently, cannot request for cancellation or oppose to the use of the trademark registered subsequently for goods or services for which this trademark was used, except for the case when the subsequent trademark registration was applied for in bad faith.

#### *Article 50*

If a reason for cancellation or nullity exists for only parts of the goods or services for which the trademark was registered, the cancellation or the nullity shall take effect only for those goods or services.

As provided for in art. 49, the owner of a trademark subsequently registered cannot oppose to the use of the earlier registered trademark, even though this trademark cannot be claimed against the subsequent trademark.

### **Collective Trademarks**

#### *Article 51*

The associations of manufacturers, producers, traders and service teams, may request at the State Office for Inventions and Trademarks the registration of collective trademark.

The applicant for a collective trademark registration shall file, in addition to the application or within a maximum of three (3) months from the date of notification by the State Office for Inventions and Trademarks, the regulation of utilization of the collective trademark. The application shall comply with the provisions of art. 10.

In the regulation of the utilization of the collective trademark, the applicant of the collective trademark registration shall authorized the appropriate persons to use the collective trademark, requirements to meet to obtain membership of the association, the reasons for which the use can be forbidden to one of the members, as well as the sanctions provided for by the association.

The regulation of utilization of the collective trademark can provide for that the collective trademark may be transferred by the owner only upon all member's consent.

#### *Article 52*

In addition to the reasons provided for the rejection of an application for an individual trademark registration, a collective trademark shall be rejected at application if:

- a) the applicant do not comply with the provisions of art. 51, paragraph 1;
- b) the provisions of art 3, paragraph d) do not meet;
- c) the regulation of utilization of the trademark is contrary to the public order and morality.

After the trademark and the regulation for utilization of the collective trademark have been published, the owner of an earlier registered trademark or a famous trademark, as well as the owner of an earlier granted right relative to its image or patronim, a protected geographic indication, a protected drawing or industrial model or a copyright, or any other interested person, can file at the State Office for Inventions and Trademarks, within the period provided for in art. 23, opposition to the registration of the collective trademark.

#### *Article 53*

The owner of the collective trademark shall notify the State Office for Inventions and Trademarks any modification of the regulation of utilization of the trademark.

Any modification of the regulation of utilization of the trademark is effective only from the moment of registration of the modification in the National Register of Trademarks. The modification is not mentioned in the register, if the regulation of utilization of the trademark, as modified, not complies with the provisions of art. 51, paragraph 3.

#### *Article 54*

Any interested person may request at the Municipal Court of Bucharest, at any time during the period of trademark protection, the cancellation of owner's rights in the collective trademark, based on one of the followings reasons:

- a) the collective trademark was not effectively used uninterruptedly for a period of five (5) years, for those goods or services for which it was registered, and there are no justified reasons for the failure to use the trademark;
- b) the owner used the trademark in a manner adverse to the provisions of the regulations or did not act to prevent it;
- c) by its use, the trademark became susceptible to mislead the public.

#### *Article 55*

Any interested person may request at the Municipal Court of Bucharest the cancellation of the collective trademark registration, within five (5) years from the registration date, for reasons provided for in art. 48 paragraph 1 let. a), b), d) and e).

If the trademark registration was applied for in bad faith or the trademark registration did not comply with the provisions of art. 51, paragraph 1-3, the cancellation of the trademark can be requested at the Municipal Court of Bucharest by the interested person at any time during the period of trademark protection.

#### *Article 56*

Unless otherwise indicated in the present law, the collective trademark are under the regime of individuals trademarks.

#### Certification Trademarks

#### *Article 57*

The certification trademarks are registered at the State Office for Inventions and Trademarks by natural persons legally authorized to exercise control over goods or services and of a nature provided in art. 3 let. e).

The legal entities which manufacture, import or sell goods or render services, other than competent authorities able to control quality, may not request the registration of a certification trademark.

#### *Article 58*

The applicant for a certification trademark registration shall file, in addition to the application, presented according to art. 10, for registration or within a maximum of three (3) months from the date of notification by the State Office for Inventions and Trademarks:

- a) the regulation of utilization of the certification trademark;
- b) the legal documents or authorization for legally exercising certification activities or, as the case may be, the proof of certification trademark registration in the country of origin.

The regulation shall authorize the appropriate persons to use the trademark, the elements and characteristics able to be certified by the trademark, the manner in which the competent authority has to exercise control over these characteristics, to supervise the use of the trademark, the fees provided for the use of the trademark, the regulation procedures for disputes.

Any natural or legal person, manufacturer of goods or service renderer, can be authorized to use the certification trademark under the provisions of the regulation of utilization of the certification trademark.

The owner of a certification trademark will authorize the appropriate persons to use the trademark for goods or services which present common characteristics guaranteed through the regulation of utilization of the certification trademark.

#### *Article 59*

In addition to the reasons for the rejection of an application for an individual trademark registration, a certification trademark shall be rejected at application if the provisions of art. 3 let. e and art. 57 and 58 are not complied with.

#### *Article 60*

After the certification trademark and the regulation of utilization of the trademark have been published, the owner of an earlier trademark or a famous trademark, or an earlier granted right, relative to the image or patronim, a protected geographic indication, drawing or industrial model or a copyright, or any other interested person can file at the State Office for Inventions and Trademarks, within the period provided for in art. 23, opposition to the registration of the certification trademark.

The provisions of art. 53 shall apply, similarly, to the certification trademarks.

Noncompliance of the users of a certification trademark with the regulation shall lead to cancellation of authorization to use the trademark by the owner, or to other sanctions provided for in the regulation.

#### *Article 61*

Any interested person may request at the Municipal Court of Bucharest the cancellation of the certification trademark registration, within five (5) years from the registration date if:

- a) one of the reasons provided for in art. 48 paragraph 1 a), b), d) and e) is present;

b) the trademark was registered without compliance with the provisions of art. 3 let. e.

If the trademark registration was applied in bad faith or the trademark was registered without compliance with provisions of art. 57 and art. 58, paragraph 1-3, the interested person can request for the cancellation at the Municipal Court of Bucharest at any time during the period of trademark protection.

#### *Article 62*

Rights in a certification trademark may not be transferred by the legal entity owner of the trademark.

The transfer in the right in a certification trademark shall be foreseen by Government Decision.

#### *Article 63*

When a certification trademark ceases to be protected it may not be applied for, nor utilized before expiration of a period of ten (10) years.

#### *Article 64*

Unless otherwise indicated in the present law, the certification trademarks are under the regime of individual trademarks.

The fees provided for in the law for collective trademarks are also applicable to certification trademarks.

### **International Registration of Trademarks**

#### *Article 65*

The provisions of the present law shall be also applicable to the international registration trademarks, in conformance with the Madrid Agreement of the Protocol concerning the agreement, which shall extend in Romania, unless otherwise indicated in these agreements.

#### *Article 66*

The application for international registration of a trademark registered in the National Register of Trademarks, as provided for in the Madrid Agreement or the application for international registration of a trademark filed or published in the National Register of Trademarks, as provided for in the Protocol concerning the Agreement, shall be examined by The State Office for Inventions and Trademarks upon the payment of the fee provided for in the law.

### **Geographic Indications**

#### *Article 67*

The geographic indications of goods are protected in Romania through their registration at the State Office for Inventions and Trademarks, according to the present law or under the conditions of international conventions to which Romania is a party and only persons who manufacture or trade the goods for which the geographic indications are registered shall have the right to utilize them.

Shall be excluded from registration procedure as provided for in the present law, the geographic indications for which protection is or will be granted under bilateral or multilateral agreements to which Romania is a party.

The list of geographic indications for which protection is granted in Romania, under the conditions provided for in paragraph 2, shall be registered at the State Office for Inventions and Trademarks in the National Register of the Geographic Indications and published in the Official Bulletin for Industrial Property.

#### *Article 68*

The registration for geographic indications may be applied for at the State Office for Inventions and Trademarks by associations of manufacturers which develop a production activity in the geographic area and the goods indicated in the application.

The registration of a geographic indication may be requested at the State Office for Inventions and Trademarks, directly or through an authorized agent, having a domicile or headquarter in Romania, upon payment of the fee provided for in the law.

#### *Article 69*

The State Office for Inventions and Trademarks shall register the geographic indication and grant the right of utilization to the applicant upon certification by the Department of Food and Agriculture or, as the case may be, the competent authority of the applicant's country of origin, of:

- a) the geographic indication for which the registration is requested;
- b) the goods for which geographic indication is being used in their trade;
- c) the geographic area in which the goods are produced;
- d) characteristics and methods of manufacturing of goods which are being trade under this indication.

#### *Article 70*

The following geographic indications shall be excluded from registration:

- a) those which are not in conformance with the provisions of art. 3, let. f);
- b) those which are generic denominations of goods;
- c) those which are susceptible to mislead the public with respect to their nature, the origin, the method of manufacturing or the quality of the goods;
- d) those which are contrary to the morality and public order.

#### *Article 71*

If the application fulfills the legal conditions, the State Office for Inventions and Trademarks shall decide whether to register the geographic indication in the National Register of Geographic Indications and grant the right of utilization to the applicant.

The right to use the geographic indication, granted through its registration, belongs to the members of the association indicated in the list filed at the State Office for Inventions and Trademarks.

#### *Article 72*

Within two (2) months from the decision of registration made by the State Office for Inventions and Trademarks, the geographic indication shall be published in the Official Bulletin for Industrial Property and the registration certificate of geographic indication shall be granted to the applicant and also the right of its utilization, upon payment of the fee provided for in the law.

#### *Article 73*

The registration of a geographic indication over an association of manufacturer's name, shall not constitute an obstacle to the registration of the same geographic indication by any other association having the ability required by the art. 68.

#### *Article 74*

The duration of protection of the geographic indication shall start from the date of filing the application at the State Office for Inventions and Trademarks and is limitless in time.

The right of utilization of the geographic indication is granted to the applicant for a period of ten (10) years with the unlimited possibility of renewal, if the conditions by which this right has been obtained are maintained.

The renewal request is subject to payment of a renewal fee provided for in the law.

#### *Article 75*

The persons authorized to use a geographic indication for certain goods have the right to use it within the field of trade of these goods, placed on these goods only, in accompanying documents, advertisements, prospectuses, and may apply thereto the notice "registered geographic indication"

#### *Article 76*

The use of a geographic indication or its imitation shall be prohibited as to any unauthorized persons, even if the real origin of goods is indicated or if clauses such as "sort", "type", "imitation" etc., are included.

Persons authorized by the State Office for Inventions and Trademarks to use a geographic indication for wine or spirits may prohibit any other person to use it for wines or spirits which are not originating from the area indicated by the geographic indication, even if the real origin of the goods is indicated in translation or if clauses such as "of sort". "of type", etc., are included.

#### *Article 77*

The Department of Food and Agriculture may, ex officio, or upon complaint by an interested person, proceed to control the quality of the goods placed in circulation which bear the registered geographic indication.

#### *Article 78*

The right to utilize a geographic indication may not be transferred.

#### *Article 79*

The cancellation action based on one of the reasons provided for in art. 69 and 70, may be filed by interested persons at the Municipal Court of Bucharest, anytime during the period of protection of geographic indication.

Noncompliance with the quality and specific characteristics of goods from the area to which the geographic indication refers, shall lead to the Department of Food and Agriculture or any interested person to request the Municipal Court of Bucharest the lapse of the right to use the registered geographic indication by the persons authorized by the State Office for Inventions and Trademarks.

The Municipal Court of Bucharest definitive decision shall be communicated to the State Office for Inventions and Trademarks by the interested person. The State Office for Inventions and Trademarks shall delete the geographic indication from the National Register of Geographic Indications and shall publish the notice of deletion in the Official bulletin for Industrial Property within two (2) months from its communication.

### **Protection of Rights over Trademarks and Geographic Indications**

#### *Article 80*

The State Office for Inventions and Trademarks' decisions regarding trademark registration may be opposed at the State Office for Inventions and Trademarks by the applicant of the trademark registration, or, as the case may be, the owner of the trademark, within three (3) months from their communication, upon payment of the fee provided for in the law.

The State Office for Inventions and Trademark's decisions regarding registration of assignments or license agreements in the National Register of Trademarks may be opposed at the State Office for Inventions and Trademarks by the interested persons, within three (3) months from their communication or, as the case may be, their publication.

The oppositions as provided for in paragraph 1 and 2 will be resolved by a reexamination commission at the State Office for Inventions and Trademarks.

#### *Article 81*

The decision of the reexamination commission, well-grounded, shall be communicated to the parties within fifteen (15) days from its pronouncement and may be appealed to the Municipal Court of Bucharest within thirty (30) days of its communication.

The decision of the Municipal Court of Bucharest may be appealed to the Court of Appeal of Bucharest, within fifteen (15) days from their communication.

The decisions of the Municipal Court of Bucharest pronounced in the cases provided for in art. 45, 48, 54, 55, 61 and 79 may be appealed to the Court of Appeal of Bucharest, within thirty (30) days of their communication.

#### *Article 82*

Upon Court's request, the State Office for Inventions and Trademarks is obliged to present all the papers, documents and information required in the legal procedure.

### *Article 83*

It shall be considered an offense and it shall be punishable by imprisonment of three (3) months or by fine of 15 million lei:

- a) the infringement, imitation, or unauthorized use of a trademark in order to mislead the public of the quality of goods or services for which the trademark is being used;
- b) the unauthorized placement into circulation of goods bearing an identical or similar trademark to a registered trademark for identical or similar goods and prejudicing the owner of the registered trademark;
- c) the placement into circulation of goods which bear the geographic indication area, different from the real place of origin, in order to mislead the public in respect with the geographic origin of the product.

It shall be considered an infringement any of the actions of a third party provided for in art. 35 paragraph 2, if they are committed without the consent of the owner of the trademark.

It shall not be considered an infringement any of the actions provided for in art. 35 paragraph 2, if they are committed before the date of trademark publication.

The complaint of infringement may be filed by the owner of a trademark only after the date of trademark registration in the National Register of Trademarks.

The legal action shall start upon previous complaint of the prejudiced party.

### *Article 84*

The owner of the trademark or, where applicable, the Department of Food and Agriculture may claim to legal competent authorities that the goods which bear trademarks or geographic indications according to art. 83 be confiscated and, if necessary, destroyed.

The provisions of paragraph 1 shall be applicable to materials and equipment directly used to commit the offenses provided for in art. 83.

### *Article 85*

For the prejudices caused by the offenses provided for in art. 83, the offenders may be obliged to pay damages according to the common law.

### *Article 86*

Any utilization of trademarks or geographic indications, contrary to loyal practice in industry or trade, in order to mislead the consumers, shall be considered unfair competition and shall be punishable by imprisonment of one (1) month to two (2) years or by fine of 15 million lei.

The legal action shall start upon previous complaint of the prejudiced person.

### *Article 87*

The owner of the trademark or, as the case may be, the Department of Food and Agriculture, may claim to the Court to ensure special measures of sequestration when it is considered the risk of infringement by a third party of rights regarding trademark or geographic indication, when this infringement can cause irreparable prejudice or there is a risk of destroying the evidence of this infringement.

The special measures of sequestration shall consist especially in ceasing the acts of infringement of rights provided for in paragraph 1 and preserving the evidence to prove the origin of goods or services unlawfully bearing a registered trademark or geographic indication.

The dispositions of the common law regarding sequestration shall be applicable to acts of infringements of rights regarding the registered trademark or geographic indication.

#### *Article 88*

In order to ensure the measures provided for in art. 87 shall be applicable the provisions of art. 581 and 582, the Code of Civil Procedure.

The Court can oblige the claimant to the payment of a bail, when the measure of sequestration is decided, in amount set forth by the Court.

#### *Article 89*

The Court can ask the claimant to provide any evidence he owns, in order to prove the ownership of the right infringement or of which infringement was inevitable.

When the burden of proof is controlled by the offender the Court can decide to ask the offender to provide the evidence to the court, upon guarantee of the confidentiality of information, according tot the law.

The Court can order the claimant to pay damages to the offender, if it is ascertained the claimant presumed upon legal rights regarding the protected trademark or geographic indication.

#### *Article 90*

The owner of the trademark or, as the case may be, the Department of Food and Agriculture can ask the offender of the right to provide immediately information regarding the origin and the paths in the unauthorized distribution of goods illegally bearing the sign, as well as information about manufacturer's or trader's identification data, the quantity of the product manufactured, delivered or ordered.

#### *Article 91*

In cases provided for in art. 83, the custom authorities may, ex officio, or upon complaint by the owner of the right, proceed to suspend importation or exportation of goods bearing trademarks or geographic indications.

The custom authorities entitled to ensure protection of rights upon protected trademark or geographic indication is, according to the law, General Department of Custom.

### **Attributes of the State Office for Inventions and Trademarks**

#### *Article 92*

The State Office for Inventions and Trademarks is the central administration's specialized office, unique authority ensuring on the territory of Romania, the protection of trademarks and geographic indications, according to the present law.

### *Article 93*

In the field of trademarks and geographic indications the State Office for Inventions and Trademarks has the followings responsibilities:

- a) to register, examine, publish applications for registration of trademarks;
- b) to examine trademarks registered or which application for registration has been filed at World Intellectual Property Organization, in conformance with the provisions of the Madrid Agreement or the Protocol concerning the Agreement, in order to recognize or refuse their protection on the territory of Romania;
- c) to register and publish the applications for registration of geographic indications and to grant protection to these geographic indications on the territory of Romania;
- d) to grant the certificates of registration of trademarks;
- e) to grant the certificates of registration of geographic indications and the right to utilize these geographic indications;
- f) to serve as a depository and organizer of the National Register of Geographic Indications;
- g) to grant the certificates of priority benefits for trademarks;
- h) to perform researches prior to trademark registration;
- i) to administrate, maintain and develop the national collection of trademarks and geographic indications and to develop data base of information in the field;
- j) to maintain relations with similar government organizations and regional intellectual property organizations, to represent Romania in specialized international organizations;
- k) to edit the official publication regarding trademarks and geographic indications for goods and to ensure the exchange of publications with other similar national offices and international organizations in the field;
- h) to fulfill other responsibilities provided for in the law.

### **Transitory and Final Provisions**

#### *Article 94*

The applications for registration of trademarks for which no decision has been made shall be considered under the provisions of the present law, until this law enters into force.

Until this law enters into force, the Government will approve a regulation for enforcing the law.

#### *Article 95*

The present law shall enter into force three (3) months from its date of publication in the Official Gazette of Romania.

On the same date,

- law no. 28/1967 regarding trademarks, registered trademarks and service marks, date of publication in the Official gazette of Romania no. 114, December 29, 1967;
- the Decision of the Council of Ministers no. 77/1968 regarding the enforcement of Law 28/1967, date of publication in the Official Gazette of Romania no. 8, January 27, 1968;
- the Decision of the Council of Ministers no. 1057/1968 for approval of the Regulation regarding the establishment, organization and functioning of the Commission for

settlement of disputes concerning trademarks, registered marks and service marks, date of publication in the Official Gazette of Romania no. 66, May 17, 1968;

- the Decision of the Council of Ministers no. 2508/1969 for establishing and penalizing of misdemeanors relative to the legal norms regarding inventions, innovations, rationalizations as well as trademarks, registered trademarks and service marks, date of publication in the Official Gazette of Romania no. 159, December 31, 1969;
- any other provisions contrary to this law, shall be void.

*This law has been adopted by the Chamber in the session of March 23, 1998, in conformance with the provisions of art. 74 paragraph 1, from the Constitution of Romania, and by the Senate in the session of march 30, 1998.*