

# Identifying best practice

## Registering trademarks in Romania is relatively straightforward, as long as the right approach is taken

The first Romanian legislation on trademarks and service marks was passed on April 15 1879. In addition, Romania has been a member of the Paris Convention for the Protection of Industrial Property since 1920. Therefore, Romania has a long-standing commitment to protecting IP rights.

Romania is a first-to-file jurisdiction. Intent to use is not required; neither is prior use, except where the mark is refused for lack of distinctiveness, in which case the applicant must prove acquired distinctiveness through extensive use (ie, secondary meaning).

According to the Trademark Law, any sign that can be graphically represented and that distinguishes one party's goods or services from those of another can be registered. Signs that can be registered include words, names, designs, devices, letters, figures, tri-dimensional forms (eg, shapes), colour combinations or a combination of any of the above.

### General filing requirements

When applying to register a trademark, the applicant must provide the following:

- power of attorney plus its Romanian translation (this may be filed within 30 days, subject to a small fee);
- priority documents plus their Romanian translation, if the applicant wishes to use the priority of a prior application; and
- exhibition documents plus their Romanian translation, if the applicant wishes to use the exhibition priority – such documents should be issued by the exhibition organisers.

### Official costs, timing and classifications

The registration procedure is generally smooth and usually takes between nine and 12 months, provided that there are

no problems with the application. Official fees applied by the Romanian Patent and Trademark Office (RPTO) range from €200 (for a single class monochrome word mark application) to €310 (for a single class colour device application).

Romania uses the Nice Classification and Vienna Classification (for devices). Class headings and multi-class applications are accepted by the RPTO. However, it is advisable to indicate the specific goods or services in the application; this will reduce the likelihood of the application being opposed by third parties and will make it easier to limit the scope of the application should there be a problem with any of the goods.

### Opposition, challenge, cancellation and enforcement

Oppositions may be filed against a trademark application by holders of prior IP rights (registered or unregistered) within two months of its publication in the *Official Gazette*. If an opposition is filed, the applicant may request the opponent to file proof of genuine use in Romania (if the prior trademark was registered at least 5 years previously); otherwise, the opposition will be denied and the registration process will continue.

Oppositions are usually decided within six to 12 months by way of a recommendation issued to the examiners. The outcome may lead to the trademark being registered or refused. The applicant or opponent can challenge the decision within 30 days.

The new Trademark Law, adopted in 2010, was amended to allow any interested third party to challenge registration decisions; this has led to situations where third parties are challenging trademark registrations without having filed an

opposition during the application process. This situation is unique to Romania and could, in some circumstances, be a dangerous tool in the hands of a competitor trying to block the registration of a trademark.

Trademark cancellations are available as in-court proceedings. In addition to non-use (for five consecutive years), cancellation may be requested on absolute grounds (descriptive, generic, functional) or relative grounds (likelihood of confusion, priority, bad faith, well-known or famous marks). Grounds for cancellation are more or less the same as in other EU jurisdictions.

Romanian legislation typically provides effective enforcement tools – including preliminary injunctions, seizures or other preliminary measures – for rights holders following harmonisation with EU legislation.

### New internal regulation at RPTO

In July 2012 the RPTO adopted a new internal regulation (4/2012) by which a new examination procedure was introduced.

Preliminary examination within the RPTO must proceed to a search of various databases in order to identify any identical trademarks that have been registered for identical or similar goods or services. These databases include:

- the RPTO internal database;
- the Office for Harmonisation in the Internal Market (OHIM) database; and
- ROMARIN – the World Intellectual Property Organisation (WIPO) database, which contains information regarding all international marks recorded under the Madrid system (for trademarks designating Romania).

The results of such searches are included in a report that is distributed to both

the applicant and the owner of the prior identical mark(s).

There were several public debates about this regulation; some practitioners questioned whether this is a return to *ex officio* examination on relative grounds (which was abandoned by the RPTO in 2010 when the new Trademark Law was adopted). The RPTO believes that this preliminary report and its communication thereof represent a quality standard and cannot be compared with the previous procedure, since it does not end with a provisional refusal issued by the RPTO.

### Statistics and plans

According to RPTO officials, the number of new trademark registrations has decreased by approximately 20% to 30% (12,033 applications in 2010; 11,600 applications in 2011; and 10,788 applications in 2012) in the past couple of years, mainly due to the financial crisis and as a result of an alternative online registration procedure offered by OHIM to cover the Romanian territory as part of the European Union.

However, the number of renewals has increased slightly (7,597 renewals in 2010; 8,135 renewals in 2011; and 8,042 renewals in 2012), which shows consistency in terms of protection sought by rights holders already registered with the RPTO.

Romania joined TMView – a free search tool covering data from all participating official EU trademark offices – in January 2012. The RPTO intends to launch an online trademark registration system in 2013.

### Clearance

Many rights holders rush to register their chosen marks with the RPTO. This is not advised, as failing to conduct proper searches may lead to oppositions and other actions initiated by third parties.

Therefore, full trademark searches should always be conducted; these should not be limited to the official databases (RPTO, OHIM and WIPO), and should include identical or similar well-known marks (which may or may not be registered) and other IP rights, such as geographical indications, trade names and copyrights. Trademark searches are designed not only to avoid potential conflicts with earlier registered or unregistered rights, but also to highlight earlier rights that may limit considerably the exclusive rights of the proposed trademark, even if such rights are unlikely to be raised in opposition.

A search of the RPTO's official database (available online) should always be supplemented by independent searches



**Dragos M Vilau**  
Partner  
[dragos.vilau@vilaumitel.ro](mailto:dragos.vilau@vilaumitel.ro)

Dragos M Vilau is one of the founders of Vilaumitel. His practice focuses primarily on corporate and commercial law, intellectual property, mergers and acquisitions and banking/finance. Mr Vilau has significant experience in advising clients on investing and growing their business in Romania. He has authored various articles on intellectual property, among other topics.



**Ionut Lupsa**  
Partner  
[ionut.lupsa@vilaumitel.ro](mailto:ionut.lupsa@vilaumitel.ro)

Ionut Lupsa coordinates the IP, IT and copyright practice group at Vilaumitel. He is a member of the Bucharest Bar Association and is qualified as a trademark attorney. Over the past 11 years his practice has focused mainly on intellectual property, information technology, e-commerce, dispute resolution and litigation. He has been involved in numerous cases before the Romanian courts.

of other relevant databases and those conducted via the Internet and social media networks.

### Best practice

The following tips are offered as best practice for trademark registration in Romania:

- Select a suitable brand name to be registered as a trademark – the stronger the trademark, the more powerful its protection will be.
- Beware of generic or descriptive terms – although they might sound attractive to consumers, they are likely to trigger disclaimer requests or simply be refused; if registration is eventually obtained, such terms could be easily adopted by competitors.
- Select only the goods and services that will be used or that are complementary to those that will be used.
- Consider carefully the territories in which the trademark will be used; register only those territories or take advantage of a Community trademark or international registration for global protection.
- Always register a trademark first before publicly disclosing it.
- Obtain clearance before filing – failing to conduct proper searches to clear the mark could lead to oppositions or challenges initiated by third parties. Full trademark searches should be performed in all cases and should not be limited to the RPTO, OHIM and WIPO official databases. This should include further well-known marks (which may or may not be registered), other IP rights, trade names and copyrights.
- Appoint a top-tier law firm/IP agency to handle the prosecution – this usually guarantees that the application will be professionally handled from filing through to successful registration.
- Constantly monitor the market for identical or similar trademarks.
- Oppose within two months of publication whenever a trademark application represents a threat to IP rights; if the opposition deadline has passed, use the second chance offered by the Trademark Law and monitor the registration of the trademark to challenge it within 30 days.
- Use the trademark – non-use for five consecutive years triggers cancellation.
- File for the cancellation of identical or similar trademarks within five years – there is a statute of acquiescence provided in the Trademark Law. [WTR](#)