

Romania aligns its national trade mark law with EU legislation

On 9 July 2020, Law No. 112/2020 for the amendment of Romanian trade mark law No. 84/1998 was published in the Official Gazette, transposing into the national law the provisions of EU trade mark Directive No 2436/2015. Changes came into force on 12 July 2020.

Enactment of the new legislation comes days after the European Commission had decided to refer Romania to the EU Court of Justice with a request for financial sanctions following Romania's failure to issue notification for transposition of the Directive.

Law 112/2020 brings substantive changes to the existing legal framework concerning trade marks. The major changes contained in the law include:

- A revised trade mark definition, adapted to the digital age. Under Law 112/2020, the requirement for the "graphic representation" of the mark is removed. This means that new signs can now be registered as marks such as multimedia marks, hologram marks, etc.
- New or amended grounds for refusal or invalidation of a trade mark. In terms of absolute grounds of refusal, for example, the applicant whose mark may be rejected for lack of distinctive character and who – under the previous regime – could have reversed such a rejection only if it proved the existence of a distinctive character acquired by use before the date of application, is now permitted to invoke the distinctive character acquired after the date of application (and before the date of registration). Also, in regard to relative grounds of refusal, for example, the owner of a prior mark registered abroad who – under the previous law – could have brought a claim against an applicant acting in bad faith only if it proved the use of its trademark abroad, can under the new provisions act against a bad-faith applicant solely on the basis of the protection that its mark enjoys abroad.
- The current owners of registered marks are obliged to notify the Romanian Trade Marks Office (OSIM) by 30 September 2020 if they intended (at the date of the application) to obtain protection of products or services in a registered class, which are not covered by the literal reading of the title of that class. In absence of such a notification by the stated deadline, the protection will only refer to products or services covered by the literal reading of the title of that class.
- Reduced terms for registration; clarification and simplification of the registration procedure. The term for which OSIM can check the application on absolute grounds of refusal has been reduced from one month to seven days. Also, the terms in which the applicant must produce mandatory documents in the file or pay fees has been shortened generally from three months to 30 days. Also, there are clear deadlines by which OSIM has to act (e.g. two months to decide on an opposition). Lastly, there is now clarity on the exact date when registration is deemed finalised. This includes the date when the term for an opposition elapses or – if an opposition is filed – the date of the final decision on the opposition or the date when opposition is withdrawn.
- Changes regarding the opposition procedure, such as the introduction in national law of the "cooling-off" period (i.e. the two-month term granted by OSIM to the applicant and the opponent to negotiate for a settlement in the opposition stage).
- New grounds for right owners to act against the infringement of their marks. The trade mark owner is, for example, entitled to prevent its mark from being used as a trade name or part of the trade name, or to prohibit the mark from being used in comparative advertising in an unlawful manner. Importantly, the right owner is entitled to prohibit the transit of infringing goods in Romania. This means that the proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into Romania in their course of trade without releasing them for free circulation in Romania. This is the case unless the holder of the goods provides evidence that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.
- The five-year time limit for bringing an action for the cancellation of a trade mark was removed. Under the previous legislation, the unbarred action was only available when challenging a bad-faith application.

□ The possibility to request cancellation or revocation of a trade mark before OSIM. Before Law 112/2020, cancellation and revocation of a trade mark could only be pursued before the competent courts of law (i.e. the Bucharest Tribunal). Beginning 14 January 2023, the interested party will have the choice to pursue these actions administratively before OSIM, whose decision in a cancellation or revocation case would be open for challenge before the Bucharest Tribunal.

The changes introduced by Law 112/2020 constitute an important step in modernising Romanian trade mark legislation. Implementing rules are expected over the next two months when the regulation for the implementation of the trade mark law must be amended to reflect these changes.

For more information on this law or general advice on IP in Romania, contact your regular CMS advisor or local CMS expert **Valentina Parvu**.