

Law on Marks and Geographical Indications

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Chapter I General Provisions

1. Rights in marks and geographical indications shall be recognized and protected on the territory of Romania in accordance with the provisions of this Law.
2. Foreign natural and legal persons with their place of residence or business outside the territory of Romania shall also enjoy the provisions of this Law in accordance with the international conventions on marks and geographical indications to which Romania is party.
3. For the purposes of this Law, the following terms and expressions shall have the meanings set out below:

(a) "Mark" means a sign capable of graphic representation serving to distinguish the goods or services of a natural or legal person from those of other persons; marks may be constituted by distinctive signs such as: words, including personal names, designs, letters, numerals, figurative elements, three-dimensional shapes and, particularly, the shape of goods or of packaging thereof, combinations of colors, together with any combination of such signs;

(b) "Earlier mark" means a registered mark or a mark filed for registration in the National Trademark Register, providing that it be subsequently registered;

c) "Well-known mark" means a mark that is well known in Romania on the date on which an application for trademark registration is filed or on the priority date claimed in such application; in order to determine whether a mark is well known, account shall be taken of the repute of such mark in that section of the public concerned by the goods or services to which the mark applies, without it being necessary for the mark to have been registered or used in Romania;

- (d) "Collective mark" means a mark serving to distinguish the goods or services of the members of an association from those belonging to other persons;
- (e) "Certification mark" means a mark that indicates that the goods or services for which it is used are certified by its owner with regard to the quality, material, method of manufacture of the goods or mode of provision of the services, precision or other characteristics;
- (f) "Geographical indication" means the name serving to identify a product that originates in a country, region or locality of a State in those cases where a certain quality, reputation or other specific characteristic may be essentially attributed to that geographical origin;
- (g) "Applicant" means the natural or legal person in whose name an application for registration of a mark has been filed;
- (h) "Owner" means the natural or legal person in whose name a mark has been registered in the National Trademark Register;
- (i) "Authorized representative", referred to as "representative" in this Law, means an industrial property agent who may also have the capacity of representative in proceedings before the State Office for Inventions and Trademarks;
- (j) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised and amended;
- (k) "Countries of the Paris Union" means the countries to which the Paris Convention applies and that constitute the Union for the Protection of Industrial Property;
- (l) "Madrid Agreement" means the "Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967;
- (m) "Protocol relating to the Agreement" means the Protocol of June 27, 1989, relating to the Madrid Agreement Concerning the International Registration of Marks.

Chapter II

Protection of Marks

4. The right to a mark shall be acquired and protected by registration with the State Office for Inventions and Trademarks.

5. The following shall be excluded from protection and may not be registered:

- (a) marks which do not conform to the provisions of Article 3(a);
- (b) marks which are devoid of any distinctive character;
- (c) marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- (d) marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(e) marks which consist exclusively of the shape of the product which results from the nature of the goods themselves or which is necessary to obtain a technical result or which gives substantial value to the goods;

(f) marks which are liable to mislead the public as to the geographical origin, the quality or nature of the goods or service;

(g) marks which contain a geographical indication or which consist therein, for goods which do not originate on the designated territory if the use of such indication is liable to mislead the public as to the true place of origin;

(h) marks which consist of a geographical indication identifying wines or spirits which do not originate in the place indicated or which comprise such indication;

(i) marks contrary to public policy or to accepted principles of morality;

(j) marks which contain, without the consent of the owner, the likeness or surname of a person of repute in Romania;

(k) marks which contain, without the permission of the competent authorities, reproductions or imitations of armorial bearings, flags, State emblems, signs, official hallmarks of control and warranty, coats of arms belonging to countries of the Union and which are governed by Article 6^{ter} of the Paris Convention;

(l) marks which contain, without the permission of the competent authorities, reproductions or imitations of armorial bearings, flags, other emblems, abbreviations, initials or denominations which are governed by Article 6^{ter} of the Paris Convention and which belong to international intergovernmental organizations to which one or more countries of the Union are party.

The provisions of items (b), (c) and (d) shall not apply if, prior to the date of the application for registration of a mark and by reason of its use, the mark has acquired a distinctive character.

6. In addition to the grounds referred to in the first paragraph of Article 5, registration of a mark shall be refused where:

(a) it is identical with an earlier mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier mark is protected;

(b) it is identical with an earlier mark and is intended to be affixed to goods or services similar to those for which the earlier mark is protected if there exists a likelihood of confusion on the part of the public;

(c) it is similar to an earlier mark and is intended to be affixed to goods or services that are identical or similar, if there exists a likelihood of confusion on the part of the public, including the risk of association with the earlier mark;

(d) it is identical with or similar to a mark that is well known in Romania for goods or services that are identical or similar on the date of the filing of the application for registration of the mark;

(e) it is identical with or similar to a mark that is well known in Romania for goods or services which are not similar to those to which the mark applies and for which registration is requested and where use of the latter without due cause could take unfair advantage of the distinctive character or the repute

of the well-known mark or where such use could cause prejudice to the owner of the well-known mark.

7. Marks subject to Article 6 may nevertheless be registered with the express consent of the owner of the earlier or well-known mark.

8. The nature of the goods or services for which registration of a mark is requested in no way represents an obstacle to the registration of the mark.

Chapter III **Application for Registration of a Mark**

9. The right to a mark shall belong to the natural or legal person who was first to file an application for registration of the mark in accordance with the conditions laid down by law.

10. An application for registration of a mark containing particulars of the identity of the applicant, a reproduction of the mark and a statement of the goods or services for which 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 mark. An application may concern one mark only.

The application shall contain precise particulars where the mark:

(a) contains one or more colors claimed as distinctive elements of the mark;

(b) is in three dimensions.

The application shall also contain the particulars of the capacity of the applicant.

The application shall also contain, where necessary, a transliteration or translation of the mark or of certain elements of the mark.

11. The date of the regular national filing shall be that on which the application for registration of a mark containing all elements referred to in the first paragraph of Article 10 has been filed with the State Office for Inventions and Trademarks.

Where an application for registration of a mark has been regularly filed for the first time in another Member State of the Paris Union or Member of the World Trade Organization, the applicant may claim the date of the first filing by means of an application for registration of the same mark in Romania, on condition that the latter application be filed with the State Office for Inventions and Trademarks within six months of the date of the first filing.

12. If the applicant has displayed certain goods or services at an official or officially recognized international exhibition held on the territory of Romania or in another Member State of the Paris Convention and an application for registration of the mark under which such goods or services were displayed has been filed with the State Office for Inventions and Trademarks within six months of the date of first display at the exhibition, the applicant shall enjoy a priority right as from the date of introduction of the product in the exhibition.

The six-month period referred to in the above paragraph shall not extend the priority period referred to in the second paragraph of Article 11.

13. The priority rights referred to in Article 11 and Article 12 shall be claimed at the time of filing an application for registration of the mark; they shall be supported by priority documents and shall be subject to payment of the prescribed fee.

The priority documents shall be filed and the prescribed fee shall be paid within three months

following the date of the application for registration of the mark.

Failure to comply with the time limit referred to in the second paragraph above shall entail refusal of the request for priority.

14. The registration of a mark may be applied for individually or collectively by natural or legal persons, either direct or through a representative having his place of residence or of business on the territory of Romania.

If registration of a mark is applied for by a representative, the application shall also contain the elements enabling such representative to be identified. The representative shall submit his powers of attorney at the same time as the application or, at the latest, within three months of the filing date of the application, failing which the application shall be refused.

15. The applicant shall communicate, within three months of the filing date of the application with the State Office for Inventions and Trademarks, proof of payment of the prescribed registration and examination fee.

16. An applicant for registration of a mark that applies to more than one product or service may request the State Office for Inventions and Trademarks to divide the initial application into two or more applications, and he may distribute the goods and services over the divisional applications on payment of the prescribed fee.

Divisional applications shall maintain the filing date of the initial application and, where appropriate, shall enjoy any priority right obtained in accordance with the second paragraph of Article 11 or the first paragraph of Article 12.

An applicant may request division of an initial application during the examination procedure of the mark at the State Office for Inventions and Trademarks up to such time as a decision is taken on registration or during the procedure before the Appeals Board of the State Office for Inventions and Trademarks or during any other procedure of appeal against the decision to register the mark.

The applicant shall be required to file the documents requested by the State Office for Inventions and Trademarks in order to divide the initial application and to pay the prescribed fee within three months as from the date of the request for division. Failing that, the State Office for Inventions and Trademarks shall note that the applicant has renounced division of the initial application.

Chapter IV

Registration Procedure

17. The State Office for Inventions and Trademarks shall ascertain whether the conditions set out in the first paragraph of Article 10 have been complied with and, if so, shall allocate a filing date to the application with none month as from the date of receipt of the application for registration of a mark. If the application does not satisfy the conditions set out in the first paragraph of Article 10, the State Office for Inventions and Trademarks shall notify the applicant of the irregularities in the application and shall afford him a period of three months to correct them. If the applicant corrects, within the prescribed time limit, the irregularities notified by the State Office for Inventions and Trademarks, the filing date shall be the date on which the application for registration was corrected in accordance with the first paragraph of Article 10. If such is not the case, the application shall be refused.

If the registration and examination fee has not been paid within the time limit set out in Article 15, the State Office for Inventions and Trademarks may afford the applicant, for good reasons, a new period of two months.

If the fees have not been paid within the prescribed time limit, the applicant shall be deemed to have renounced registration of the mark and the application shall be refused.

18. If an applicant for registration of a mark has not stated in the application those elements that prove his capacity of natural or legal person, the State Office for Inventions and Trademarks shall notify him of the irregularities ascertained and shall afford him a time limit for correcting those irregularities. If the applicant does not correct them within the prescribed time limit, the State Office for Inventions and Trademarks shall refuse the application.

19. The State Office for Inventions and Trademarks shall carry out a substantive examination of the application for registration of a mark within a period of six months as from the date on which the registration and examination fee has been paid.

The examination by the State Office for Inventions and Trademarks shall concern:

- (a) the capacity of the applicant within the meaning of item (g) of Article 3,
- (b) the conditions set out in the first and second paragraphs of Article 13, if priority is claimed in the application;
- (c) the grounds for refusal referred to in the first paragraph of Article 5 and in Article 6.

20. Examination of the grounds for refusal referred to in items (d) and (e) of Article 6 shall be based on the following criteria:

- (a) the degree of distinctiveness, initial or acquired, of the well-known mark in Romania;
- (b) the duration and scope of use of the well-known mark in Romania with respect to the goods and services referred to in the application for registration,
- (c) the duration and scope of publicity for the well-known mark in Romania;
- (d) the geographical area of use of the well-known mark in Romania,
- (e) the degree of recognition of the well-known mark on the Romanian market by the sector of the public to which it is addressed,
- (f) the existence of identical or similar marks for identical or similar goods or services belonging to a person other than the person who claims his mark is well known.

In examining the grounds for refusal, in accordance with the criteria set out in the first paragraph above, the State Office for Inventions and Trademarks may request public authorities, public institutions and private law legal persons for documents attesting to the notoriety of the mark in Romania.

21. Where one of the grounds for refusal referred to in Article 6 applies to some only of the goods or services for which registration of a mark has been requested, registration shall be refused for those goods or services only.

22. If the examination of the application carried out in accordance with Articles 19 and 20 shows that the conditions prescribed for registration of a mark have been satisfied, the State Office for Inventions and Trademarks shall decide to register the mark and to publish it in the Official Bulletin of Industrial Property. The mark shall be published within two months as from the date of the decision to register the mark.

If the application does not satisfy the conditions prescribed for registration of a mark, the State Office for Inventions and Trademarks shall notify the applicant thereof and shall afford him a period of three months for submitting his observations or withdrawing his application. Such period may be extended for three months at the request of the applicant accompanied by payment of the prescribed fee.

On expiry of the period referred to in the second paragraph above, the State Office for Inventions and Trademarks shall decide, as appropriate, to register the mark, to refuse the application or to note that the application has been withdrawn.

23. Within three months of the date of publication of the mark, the owner of an earlier mark or of a well-known mark, the holder of an earlier right in a likeness or surname, a protected geographical indication or a protected industrial design, of any other protected industrial property right or copyright, or any other concerned person, may file opposition to a published mark with the State Office for Inventions and Trademarks.

Opposition shall be filed in writing, reasoned and accompanied by payment of the prescribed fee. If the fee is not paid, opposition shall be deemed not to have been filed.

24. The State Office for Inventions and Trademarks shall notify the applicant of any opposition filed under Article 23, stating the name of the person who has filed the opposition and the grounds of the opposition to the registration of the mark.

Within three months of the date of notification of opposition, the applicant may submit his observations; at the request of the applicant, the time limit may be extended by three months at most by the State Office for Inventions and Trademarks.

25. Opposition to a published mark shall be examined by a commission of the State Office for Inventions and Trademarks.

If the opposition is justified, the commission shall decide to refuse the registration of the mark.

The decision to refuse the registration of the mark may be opposed by the applicant of the mark within the time limits and according to the procedure laid down in Article 80.

The final decision to refuse the registration of a mark shall be published in the Official Bulletin of Industrial Property.

26. An applicant may at any time withdrawn his application for registration or restrict the list of goods or services. Where the mark has already been published, withdrawal or restriction shall be published in the Official Bulletin of Industrial Property.

The application for registration of a mark may be modified, at the request of the applicant, only in order to correct the name or address of the applicant or to make other corrections that do not substantially affect the mark or that do not extend the list of goods or services.

Any modification requested by the applicant prior to the date of registration and which substantially affects the mark or the list of goods or services shall be made the subject of a new application for registration.

27. During the registration procedure, the State Office for Inventions and Trademarks may request the applicant to provide such explanations and documents as it deems necessary if there exists any doubt as to the exactness or the content of the elements of the application for registration.

28. Once the decision to register a mark is final, the mark shall be entered in the National Trademark Register and the State Office for Inventions and Trademarks shall issue a registration certificate to the owner against payment of the prescribed fee.

Chapter V **Duration, Renewal** **and Amendment of Registrations**

29. The registration of a mark shall take effect on the date of the regular national filing of the mark and shall subsist for ten years.

At the request of the owner, the registration of a mark may be renewed at the end of each ten-year period on payment of the prescribed fee.

The request for renewal of a registration may be made before expiry of the current term of protection, but three months at the earliest prior to expiry of that term.

Renewal of a registration shall take effect as from the day immediately following expiry of the current term of protection.

The fee for the request for renewal of a registration shall become due on the date of the registration; the fee may be paid within six months following the expiry date of the current term of protection on payment of the prescribed additional fee.

Failure to pay the fee in accordance with the preceding paragraph shall lead to the loss of the rights of the owner of the mark.

30. The request for renewal of a registration shall contain:

- (a) an explicit request for renewal of the registration;
- (b) particulars identifying the owner and, where appropriate, the name and place of residence or business of his representative;
- (c) the registration number of the mark in the National Trademark Register;
- (d) the date of the regular filing of the application for registration of the mark.

If the owner requests renewal for a part only of the goods and services entered in the National Trademark Register, he shall be required to state the name of the goods or services for which he requests renewal of the registration.

31. If the State Office for Inventions and Trademarks ascertains that the conditions laid down by this Law for renewal of the registration have not been satisfied, it shall notify that fact to the owner who shall have a period of three months as from the date of receipt of the notification for making his reply; if he does not reply within the prescribed period, the request for renewal shall be refused.

The person requesting renewal may oppose the refusal decision within the period of time and in accordance with the procedure set out in Article 80.

32. Renewal of a registration shall be entered in the National Trademark Register and published in the Official Bulletin of Industrial Property within six months as from the filing date of the request for renewal with the State Office for Inventions and Trademarks.

33. During the term of protection of a mark, the owner may request the State Office for Inventions and Trademarks, on payment of the prescribed fee, to make non-essential amendments to certain elements of the mark, on condition that the modifications do not affect the general appearance of the mark. The State Office for Inventions and Trademarks shall enter in the National Trademark Register amendments made in accordance with the preceding paragraph and shall publish the mark as amended.

34. During the whole term of protection of the mark, its owner may request the State Office for Inventions and Trademarks, on payment of the prescribed fee, to enter in the National Trademark Register amendments made to the name, designation, address or headquarters of the owner. Amendments entered in the Register shall be published in the Official Bulletin of Industrial Property.

Chapter VI

Rights Conferred by a Mark

35. The registration of a mark shall confer on its owner an exclusive right in that mark.

The owner of the mark may request the competent judicial body to prohibit any person not having his consent from using in the course of trade:

- (a) any sign which is identical with the mark in relation to goods or services which are identical with those for which the mark is registered;
- (b) any sign where, because of its identity with or similarity to the mark or the identity or similarity of the goods or services on which the sign is affixed with the goods or services for which the mark is registered, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the mark;
- (c) any sign which is identical with or similar to the mark in relation to goods or services which are not similar to those for which the mark is registered, where the latter has a reputation in Romania and where use of that sign without due cause could take unfair advantage of the distinctive character or the repute of the mark or where such use would cause prejudice to the owner of the mark.

The owner of the mark may request that any other person be prohibited, under the second paragraph, from performing, in particular, the following acts:

- (a) affixing the sign to goods or to their packaging;
- (b) offering the goods, putting them on the market or stocking them for such purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

36. The applicant for registration may only request the prohibition referred to in the second paragraph of Article 35 after publication of the mark.

The applicant may claim damages for acts subsequent to publication of the mark under the general rules of law. A decision ordering payment of damages shall be enforceable only as from the date of registration of the mark.

If the application for registration is refused, the applicant shall not be entitled to damages.

37. The owner of a registered mark may not request other persons to be prohibited from stocking, offering for sale or putting on the market of goods under such mark if the goods have been put on the market by the owner himself or with his consent.

The provisions of the above paragraph shall not apply if the owner submits legitimate reasons for opposing the commercialization of the goods, particularly where the condition of the goods is changed or impaired after they have been put on the market.

38. The owner of a mark may not request that other persons be prohibited from using in the course of trade:

- (a) the name/designation or address/ headquarters of the owner;
- (b) indications concerning the kind, quality, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service under that mark or other characteristics of the goods or service;
- (c) the mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

The provisions of the preceding paragraph shall apply with the proviso that the elements referred to in items (a) to (c) are used in accordance with honest practice.

Chapter VII

Transfer of Rights in a Mark

39. Rights in a mark may be transferred, by assignment or license, at any time during the term of protection of the mark.

The rights in a mark may also be transferred under a levy of execution against the owner of the mark carried out in accordance with the law.

40. Rights in a mark may be assigned independently of the transfer of the business in which the mark is incorporated. Assignment shall be effected in writing and signed by the parties to the contract, on pain of nullity.

Assignment of rights in a mark may be effected for all or a part of the goods or services for which the mark is registered; an assignment, even in part, may not limit use of the mark for the goods or services to which it applies to a given territory.

Transfer of the whole of the estate of the owner of the mark shall include transfer of the rights in the mark. The transfer of certain elements of the owner's estate shall not affect his capacity as owner of the right in the mark.

Identical or similar marks belonging to the same owner that are used for identical or similar goods or services may be assigned only as a whole and only to one person, on pain of nullity of the instrument of assignment.

41. The request for entry of the assignment shall be accompanied by the document attesting to the change of ownership of the mark.

At the request of the person concerned and on payment of the prescribed fee, the State Office for Inventions and Trademarks shall enter the assignment in the National Trademark Register and publish it in the Official Bulletin of Industrial Property. Assignment may be invoked against third parties as from the date of its entry in the National Trademark Register.

42. The owner of a mark may, under a licensing contract, authorize other persons to make use of the mark on the whole or a part of the territory of Romania for all or a part of the goods or services for which the mark was registered. A license may be exclusive or non-exclusive.

The owner of a mark may invoke the rights conferred by that mark against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form of the mark and the nature of the goods or services for which the license is granted, the territory in which the mark may be used, or the quality of the goods manufactured or of the services provided by the licensee under the mark for which the license has been granted.

During the term of the licensing contract, the licensee shall be required:

- (a) to use only, for the goods on which the mark is affixed, the mark that is the subject of the licensing contract, whilst remaining free to affix on such products signs which show that he is the manufacturer;
- (b) to add the term "under license ?" to the mark affixed on the products that are the subject matter of the license, in accordance with the contract.

A license shall be entered in the National Trademark Register on payment of the prescribed fee and shall be published in the Official Bulletin of Industrial Property. A license may be invoked against others as from the date of its entry.

43. Unless otherwise provided in the licensing contract, any of the licensees may not institute infringement proceedings without the consent of the owner of the mark.

The holder of an exclusive license may institute infringement proceedings if, after having notified the owner of the mark of the infringing acts of which he has obtained knowledge, the latter has not acted within the time limits prescribed by the licensee.

Where infringement proceedings are instituted by the owner, any of the licensees may intervene in the proceedings in order to obtain compensation for damage occasioned by the infringement of the mark.

Chapter VIII

Loss of Rights in a Mark

44. The owner may surrender his mark in respect of some or all of the goods or services for which it is registered.

The surrender of a mark shall be declared to the State Office for Inventions and Trademarks in writing and shall be signed by the owner of the mark or by a person authorized by him and the rights in the mark shall lapse, with respect to the goods and services to which the mark applies, as from the date on which surrender is entered in the National Trademark Register.

If a license has been registered, surrender of a mark shall be entered only if the owner of the mark proves that he has advised the licensee of his intention to surrender the mark.

45. Any concerned person may apply to the Bucharest City Court, at any time during the term of protection of the mark, for revocation of the owner of the rights conferred by the mark:

- (a) if, within a continuous period of five years, the mark has not been put to genuine use on the territory of Romania in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;
- (b) if, after the date of registration, the mark has become, in consequence of acts or inactivity of the owner, the common name in the trade for a product or service in respect of which it is registered;
- (c) if, after the date of registration and in consequence of the use made of it by the owner or with his consent, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services in respect of which is registered;
- (d) if the mark has been registered by a person not having the capacity required by item (g) of Article 3.

Revocation of the rights conferred by a mark shall take effect as from the date of the final court decision.

46. The following shall be considered effective use of a mark:

- (a) use of the mark by another person with the consent of the owner;
- (b) use of the mark in a form that differs in certain respects from that of the registered mark, but which does not impair its distinctive character;
- (c) affixing of the mark on goods or their packaging exclusively for the purposes of export;
- (d) impossibility of using the mark due to circumstances beyond the control of the owner of the mark, for example restrictions on import or other provisions by public authorities in respect of the goods or services to which the mark applies.

The rights of the owner may not be revoked if, in the time between expiry of the period referred to in item (a) of Article 45 and the submission of the request for revocation, the mark has been subject to effective use. However, if the beginning or resumption of use of the mark takes place within the three months preceding submission to the courts of the request for revocation, use of the mark shall not be taken into consideration if preparation for the beginning or resumption of use has been made only after the owner obtained knowledge of the intention to submit a request for revocation.

47. The burden of proof of use of the mark shall rest with the owner of the mark and proof may be furnished by any means.

48. Any concerned person may apply to the Bucharest City Court for cancellation of the registration of a mark on any of the following grounds:

- (a) the mark was registered contrary to the provisions of the first paragraph of Article 5;
- (b) the mark was registered contrary to the provisions of Article 6;
- (c) the registration was applied for in bad faith;
- (d) the registration infringes a right of personal portrayal or a right to a name;
- (e) the registration infringes earlier rights acquired in a protected geographical indication or a protected industrial design, other industrial property rights or copyright.

Cancellation proceedings on the grounds referred to in item (c) may be instituted at any time during the term of protection of the mark.

The time limit for requesting cancellation of a registration on one of the grounds under items (a), (b), (d) and (e) shall be five years as from the registration date of the mark.

Cancellation of a registration may not be applied for on the grounds that the mark conflicts with an earlier mark if such earlier mark does not satisfy the conditions laid down in Articles 45 and 46.

49. The owner of an earlier mark who has acquiesced for a continuous period of five years in the use of the subsequently registered mark may not apply for cancellation nor oppose the use of the later mark for the goods and services in respect of which such later mark has been used, except if the registration of the later mark was sought in bad faith.

50. If the grounds for revocation or invalidity apply to some only of the goods or services for which the mark is registered, the revocation or invalidity shall have effect only with respect to such goods or services.

In the case referred to in Article 49, the owner of the subsequently registered mark may not oppose use of the earlier mark even if the earlier mark may no longer be invoked against the later mark.

Chapter IX Collective Marks

51. Associations of manufacturers, producers, suppliers of services or traders may apply to the State Office for Inventions and Trademarks for the registration of collective marks.

The applicant for registration of a collective mark shall be required to file, together with the application or, at the latest, within three months as from the date of the notification transmitted by the State Office for Inventions and Trademarks, regulations governing use of the mark. The application shall comply with the provisions of Article 10.

In the regulations governing use of the collective mark, the applicant shall specify the persons authorized to use the mark, the conditions of membership of the association, the conditions of use of the mark, the grounds on which a member of the association may be prohibited from using the mark and the sanctions that may be applied by the association.

The regulations governing use of the collective mark may require that the collective mark may be transmitted by its owner only with the consent of all members of the association.

52. In addition to the grounds for refusal of an application for registration of an individual mark, an application for registration of a collective mark shall be refused:

- (a) if the applicant does not have the capacity required by the first paragraph of Article 51;
- (b) if the requirements of item (d) of Article 3 are not satisfied;
- (c) if the regulations governing use of the mark are contrary to public policy or to accepted principles of morality.

After publication of the mark and of the regulations governing use of the collective mark, the owner of an earlier mark, of a well-known mark or of an earlier right of personal portrayal or right to a name, a protected geographical indication, a protected industrial design or a copyright or any other concerned person may enter opposition to the registration of the collective mark with the State Office for Inventions and Trademarks within the time limit laid down in Article 23.

53. The owner of a collective mark shall be required to communicate to the State Office for Inventions and Trademarks any modification to the regulations governing the use of the mark.

A modification to the regulations governing the use of the mark shall take effect only as of the date of entry in the National Trademark Register. The modification shall not be entered in the Register if the modified regulations do not satisfy the conditions set out in the third paragraph of Article 51.

54. Any concerned person may apply to the Bucharest City Court, at any time during the term of protection of the mark, for revocation of the rights conferred by the collective mark:

(a) if, within a continuous period of five years, the mark has not been put to genuine use in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;

(b) if the owner has used the mark in a manner other than that provided for by the regulations or has not taken steps to prevent such use;

(c) if the manner in which the mark has been used has caused it to become liable to mislead the public.

55. Any concerned person may apply to the Bucharest City Court for cancellation of the registration of a collective mark within a period of five years as from the date of registration on any one of the grounds set out in items (a), (b), (d) and (e) or Article 48.

If the registration of the mark has been applied for in bad faith or if the mark has been registered contrary to the provisions of the first, second and third paragraphs of Article 51, any concerned person may apply for cancellation of the registration to the Bucharest City Court at any time during the term of protection of the mark.

56. Unless otherwise provided by this Law, collective marks shall be subject to the provisions on individual marks.

Chapter X

Certification Marks

57. A certification mark may be registered with the State Office for Inventions and Trademarks by any legal person with statutory powers to supervise the goods or services in accordance with item (e) of Article 3.

Legal persons who manufacture, import or sell goods and providers of services other than those responsible for quality control may not apply for registration of a certification mark.

58. The applicant for registration of a certification mark shall be required to file, at the same time as his application for registration submitted in accordance with Article 10, or at the latest within three months as from the date of notification transmitted by the State Office for Inventions and Trademarks:

(a) the regulations governing use of the certification mark;

(b) authorization for, or a document attesting the legal exercise of certification activities or, where appropriate, proof of registration of the certification mark in his country of origin.

The regulations shall specify the persons authorized to use the mark, the elements and characteristics that are to be guaranteed by the mark, the manner in which the competent certification authority shall verify those characteristics and supervise the use of the mark, the fees payable for use of the mark and the procedures for settling disputes.

Any natural or legal person who supplies goods or provides services may be authorized to use a certification mark subject to compliance with the provisions of the regulations governing its use.

The owner of a certification mark shall authorize other persons to use the mark for goods or services possessing common characteristics guaranteed by the regulations governing its use.

59. In addition to the grounds for refusal of an application for registration of an individual mark, an application for registration of a certification mark shall be refused in the event of non-compliance with the provisions of item (e) of Article 3 and of Articles 57 and 58.

60. After publication of the mark and the regulations governing its use, the owner of an earlier mark, a well-known mark or an earlier right of personal portrayal or right to a name, of a protected geographical indication, a protected industrial design or a copyright, or any other concerned person, may, within the time limits laid down in Article 23, enter opposition with the State Office for Inventions and Trademarks against registration of the certification mark.

The provisions of Article 53 shall apply *mutatis mutandis* to certification marks.

If the users of a certification mark fail to comply with the regulations, the owner may withdraw their authorization to use the mark or may apply other sanctions laid down in the regulations.

61. Any concerned person may apply to the Bucharest City Court for cancellation of the registration of a certification mark within five years as from the date of registration:

(a) if any one of the grounds under items (a), (b), (d) or (e) of Article 48 are applicable;

(b) if the mark has been registered contrary to the provisions of item (e) of Article 3.

If the registration of the mark was applied for in bad faith or if the mark was registered contrary to the provisions of Article 57 and of the first, second and third paragraphs of Article 58, any concerned person may apply to the Bucharest City Court for cancellation of the registration at any time during the term of protection of the mark.

62. Rights in a certification mark may not be transferred by the legal person owning the mark.

Transfer of rights in a certification mark shall be decided by Government decision.

63. If a certification mark ceases to be protected, it may not be the subject matter of an application for registration nor used prior to expiry of ten years as from the date of the termination of protection.

64. Unless otherwise provided by this Law, certification marks shall be subject to the provisions on individual marks.

The prescribed fees applicable to collective marks shall be applicable to certification marks.

Chapter XI

International Registration of Marks

65. The provisions of this Law shall apply to international registrations made under the Madrid Agreement or the Protocol to the Agreement which have effect in Romania, unless otherwise provided in those instruments.

66. An application for international registration of a mark entered in the National Trademark Register, in accordance with the Madrid Agreement, or an application for international registration of a mark registered or entered in the National Trademark Register, in accordance with the Protocol to that Agreement, shall be examined by the State Office for Inventions and Trademarks against payment of

the prescribed fee.

Chapter XII

Geographical Indications

67. Geographical indications of products shall be protected in Romania by their registration with the State Office for Inventions and Trademarks in accordance with this Law or with the international conventions to which Romania is party and may be used only by those persons who manufacture or market the products for which they have been registered.

Geographical indications protected now or in future under bilateral or multilateral agreements concluded by Romania shall not be subject to the registration procedure established by this Law.

The list of geographical indications recognized in Romania under the agreements referred to in the preceding paragraph shall be entered by the State Office for Inventions and Trademarks in the National Register of Geographical Indications and shall be published in the Official Bulletin of Industrial Property.

68. The associations of producers pursuing production activities in the geographical area relating to the products stated in the application shall be entitled to apply for registration of a geographical indication to the State Office for Inventions and Trademarks.

Registration of a geographical indication may be applied for to the State Office for Inventions and Trademarks, either direct or through an approved representative with place of residence or of business in Romania and shall be subject to payment of the prescribed fee.

69. The State Office for Inventions and Trademarks shall register geographical indications and afford to the applicant the right to use them after the Ministry of Agriculture and Food or, as appropriate, the competent authority of the applicant's country of origin has certified:

- (a) the geographical indication for which registration is sought;
- (b) the products that may be marketed under that indication;
- (c) the geographical area of production;
- (d) the characteristics that the products must possess and the manufacturing criteria they must comply with in order to be marketed under that indication.

70. Geographical indications may not be registered if:

- (a) they do not comply with the provisions of item (f) of Article 3;
- (b) they are the generic name of goods;
- (c) they are liable to mislead the public as to the nature, origin, manufacturing methods and quality of the goods;
- (d) if they are contrary to public policy or to accepted principles of morality.

71. If the application satisfies the requirements of the law, the State Office for Inventions and Trademarks shall decide to register the geographical indication in the National Register of Geographical Indications and to afford the right of use in the indication to the applicant.

The right to use a geographical indication, obtained by registration, shall belong to the members of the association entered on the list communicated to the State Office for Inventions and Trademarks.

72. The State Office for Inventions and Trademarks shall publish the geographical indication in the Official Bulletin of Industrial Property and shall issue a registration certificate to the applicant affording him the right to use the geographical indication, within two months of the date on which the decision to register is taken, against payment of the prescribed fee.

73. Registration of a geographical indication on behalf of an association of producers shall not prevent registration of the same indication for any other association having the required capacity under Article 68.

74. The term of protection of geographical indications shall begin on the date on which the application was filed with the State Office for Inventions and Trademarks and shall be without limit in time.

The right to use a geographical indication shall be afforded to the applicant for a period of ten years, renewable an unlimited number of times, if the conditions under which the right has been obtained remain applicable.

The application for renewal shall be subject to payment of the prescribed fee.

75. Persons authorized to use a geographical indication for certain goods shall be entitled to use it in the course of trade, but only for those goods, in business papers, advertising or brochures and they may affix on such products the term *registered geographical indication*.

76. It shall be prohibited for non-authorized persons to use a geographical indication or an imitation thereof even if the true origin of the products is shown or if terms such as *kind, type, imitation*, and the like are added.

Persons authorized by the State Office for Inventions and Trademarks to use a geographical indication for wines or spirits may prohibit the use of such indication by any other person for wines and spirits that do not come from the region suggested by the geographical indication concerned, even where the true origin of the product is expressly mentioned or the geographical indication is used in a translated form or accompanied by terms such as *kind, type, etc.*

77. The Ministry of Agriculture and Food may, *ex officio* or at the request of any concerned person, carry out verifications of the products marketed under a registered geographical indication.

78. The right to use a geographical indication may not be transferred.

79. Throughout the term of protection of a geographical indication, any concerned person may apply to the Bucharest City Court for cancellation of the registration if the geographical indication has been registered contrary to the provisions of Articles 69 and 70.

In the event of failure to comply with the quality criteria and the specific characteristics of the products of the region to which the geographical indication refers, the Ministry of Agriculture and Food or any other concerned person may apply to the Bucharest City Court for revocation of the rights of the persons authorized by the State Office for Inventions and Trademarks to use the registered geographical indication.

The final decision of the Bucharest City Court shall be communicated to the State Office for Inventions and Trademarks by the person concerned. The State Office for Inventions and Trademarks shall cancel the geographical indication in the National Register of Geographical Indications and shall publish the cancellation in the Official Bulletin of Industrial Property within two months of its notification.

Chapter XIII

Defense of Rights in Marks and Geographical Indications

80. The decision of the State Office for Inventions and Trademarks in respect of the registration of marks may be contested with the Office by the applicant or, as appropriate, by the owner of the mark, within three months of their notification, on payment of the prescribed fee.

The decisions of the State Office for Inventions and Trademarks concerning the entry of assignment or licensing in the National Trademark Register may be contested with the Office by any concerned person within three months of their notification or, where appropriate, of their publication.

Opposition entered in accordance with the first and second paragraphs above shall be decided by an Appeals Board of the State Office for Inventions and Trademarks.

81. The reasoned decision of the Appeals Board shall be communicated to the parties within 15 days of the date on which it is given and may be appealed from to the Bucharest City Court within 30 days of its notification.

The decision of the Bucharest City Court may be appealed from to the Bucharest Court of Appeal within 15 days of its notification.

Decisions of the Bucharest City Court given in the cases referred to in Articles 45, 48, 54, 55, 61 and 79 may be appealed from to the Bucharest Appeals Court within 30 days as from their notification.

82. At the request of the judicial body, the State Office for Inventions and Trademarks shall be required to communicate to that body all acts, documents and information required to settle the dispute submitted to it.

83. The following shall constitute an infringement liable to imprisonment of between three months and three years or a fine of 15 million Lei:

(a) infringement, imitation or unlawful use of a mark with the intent of misleading the public as to the quality of the goods or services to which the mark applies;

(b) the unlawful marketing of a product under a mark that is identical with or similar to a mark registered for identical or similar products, causing prejudice to the owner of the registered mark;

(c) marketing of a product under a geographical indication suggesting that the product concerned originates from a geographical region other than its true region of origin with the intent of misleading the public as to the geographical origin of the product.

The performance of any act referred to in the second paragraph of Article 35 by a person not having the consent of the owner of the registered mark shall constitute an infringement.

None of the acts referred to in the second paragraph of Article 35 shall constitute an infringement if carried out prior to the date of publication of the mark.

The owner of a mark may institute infringement proceedings only after the date on which the mark was entered in the National Trademark Register.

Proceedings shall be instituted on a prior complaint by the injured party.

84. The owner of a mark or, as appropriate, the Ministry of Agriculture and Food, may apply to the competent judicial body to order confiscation or, as appropriate, destruction of products on which the marks or geographical indications referred to in Article 83 have been affixed.

The provisions of the preceding paragraph shall apply to the material and equipment used directly to carry out the infringements referred to in Article 83.

85. Persons found guilty may be required to pay damages, in accordance with the general rules of law, for the prejudice caused by the performance of the acts referred to in Article 83.

86. Any use of marks or geographical indications contrary to honest practice in industrial or commercial activities, with an attempt to mislead consumers, shall constitute an act of unfair competition and shall be liable to imprisonment of between one month and two years or a fine of 15 million Lei.

Criminal proceedings shall be instituted on a prior complaint by the injured party.

87. The owner of the mark or, where appropriate, the Ministry of Agriculture and Food may request the judicial body to order withholding measures if there is the likelihood of infringement by other persons of rights in the mark or protected geographical indication and if such infringement is liable to cause an irreparable prejudice or to lead to the destruction of evidence.

Such withholding measures may be ordered for the purpose of putting a stop to the acts that infringe the rights referred to in the preceding paragraph and to safeguarding evidence of the origin of the goods or services on which a mark or a protected geographical indication is unlawfully affixed.

The general rules of law on seizure shall apply to acts that infringe rights in a mark or a protected geographical indication.

88. The provisions of Articles 581 and 582 of the Code of Civil Procedure shall apply to the measures referred to in Article 87.

Where the judicial body orders withholding measures, it may require the plaintiff to pay security of an amount that it shall determine.

89. The judicial body may require the plaintiff to furnish any evidence at his disposal to prove that he is the holder of the right that has been infringed or of which infringement is unavoidable.

Where the evidence submitted in support of the plaintiff's claims are in the possession of the defendant, the judicial body may order the defendant to furnish the evidence subject to a guarantee of confidentiality of information in accordance with the law.

The judicial body may order the plaintiff to refund to the defendant any damages obtained as a result of an abusive institution of proceedings in relation to a mark or protected geographical indication.

90. The owner of a mark, or where appropriate, the Ministry of Agriculture and Food, may require the infringer to provide recent information on the origin and distribution channels of merchandise to which marks are unlawfully affixed and information on the identity of the manufacturer or merchant and on the quantity of merchandise manufactured, delivered, received or ordered.

91. In the cases referred to in Article 83, the customs authorities may order, *ex officio* or at the request of the right holder, the suspension of customs clearance on import or export of goods on which marks or geographical indications are affixed.

The General Directorate of Customs shall have authority to enforce the rights to marks and protected geographical indications at the borders, in accordance with the law.

Chapter XIV **Duties of the State Office** **for Inventions and Trademarks**

92. The State Office for Inventions and Trademarks is the specialized body of the central public administration, the sole authority on the territory of Romania for the provision of protection of marks and geographical indications in accordance with this Law.

93. In the field of marks and geographical indications, the State Office for Inventions and Trademarks has the following duties:

- (a) register, examine and publish applications for registration of marks;
- (b) examine registered marks or marks submitted for registration with the World Intellectual Property Organization, in accordance with the Madrid Agreement or the Protocol to that Agreement, in order to recognize or refuse their protection on the territory of Romania;
- (c) register and publish applications for registration of geographical indications and afford them protection on the territory of Romania;
- (d) issue registration certificates for marks;
- (e) issue registration certificates for geographical indications and grant the right of use for such indications;
- (f) establish and keep the National Trademark Register and the National Register of Geographical Indications;
- (g) issue priority certificates for marks;
- (h) carry out anticipation searching;
- (i) administrate, maintain and develop the national collection of marks and geographical indications and set up a computer database in this field;
- (j) maintain relations with similar public bodies and with regional industrial property organizations; represent Romania in the specialized international organizations;

(k) issue the official publication concerning marks and geographical indications of products and exchange publications with comparable foreign national offices and with the international bodies and organizations working in this field;

(l) carry out other functions as provided by law.

Chapter XV

Transitional and Final Provisions

94. Applications for the registration of marks on which no decision has been taken prior to the date of entry into force of this Law shall be subject to the provisions of this Law.

Prior to the entry into force of this Law, the Government shall approve the relevant Implementing Regulations.

95. This Law shall enter into force within three months as from its publication in the Official Gazette of Romania.

The following shall be repealed as of that date:

-- Law No. 28/1967 on Trademarks and Service Marks published in Official Bulletin No. 114 of December 29, 1967;

-- Decree No. 77/1968 of the Council of Ministers on the application of Law No. 28/1967, published in Official Bulletin No. 8 of January 27, 1968;

-- Decree No. 1057/1968 of the Council of Ministers approving the Regulations on the structure, organization and operation of the commission for the settlement of disputes concerning trademarks and service marks, published in Official Bulletin No. 66 of May 17, 1968;

-- Decree No. 2508/1969 of the Council of Ministers defining the nature of and sanctions for infringements of the statutory provisions concerning inventions, innovations and improvements, as also trademarks and service marks, published in Official Bulletin No. 159 of December 31, 1969;

-- all other provisions contrary to this Law.