

Romania

## **1. Legal framework**

### **1.1. Domestic law**

1.1.1. What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks in Romania is [Law No. 84/1998 on Trademarks and Geographical Indications, amended in 2022, as published in Official Gazette No. 1196 of 13 December 2022](#) (the Romanian Trademarks Law).

A new Implementing Regulation entered into force on 7 October 2022 (Government Decision No. 1.197/2022 that amended Government Decision No. 1134/10.11.2010).

### **1.2. International law**

1.2.1. Which international trademark agreements has your jurisdiction signed?

The main international trademark agreements, signed by Romania are the following:

- the Paris Convention for the Protection of Industrial Property, as revised in Stockholm on 14 July 1967, ratified in Romania by Decree No. 1177/28.12.1968, published in Official Bulletin No. 1/06.01.1969;
- [the Madrid Agreement Concerning the International Registration of Marks, as revised in Stockholm on 14 July 1967, ratified in Romania by Decree No. 1176/28.12.1968, published in Official Bulletin No. 1/06.01.1969;](#)
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks adopted in Madrid on 27 June 1989, ratified in Romania by Law No. 5/1998, published in Official Gazette No. 11/15.01.1998;
- [the Singapore Treaty on the Law of Trademarks, 13–31 March 2006, ratified in Romania by Law No. 360/04.12.2007;](#)
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised in Stockholm on 14 July 1967 and in Geneva on 13 May 1977 and amended on 2 October 1979, ratified in Romania by Law No. 3/1998, published in Official Gazette No. 10/14.01.1998;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, concluded in Vienna on 12 June 1973 and amended on 1 October 1985, ratified in Romania by Law No. 3/1998, published in Official Gazette No. 10/14.01.1998; and
- the Romanian Trademarks Law Treaty, adopted in Geneva on 27 October 1994, ratified in Romania by Law No. 4/1998, published in Official Gazette No. 10/14.01.1998.

The main implementing regulations are:

- [Regulations under the Singapore Treaty on the Law of Trademarks;](#) and
- Implementing Regulations of the Romanian Trademarks Law Treaty, adopted in Geneva on 27 October 1994.

### **1.3. Regulators**

1.3.1. Which government bodies regulate trademark law?

In Romania, parliament is the supreme representative body of the Romanian people and the sole legislative authority of the country. The government adopts decisions and ordinances.

## **2. Registration and use**

### **2.1. *Ownership of marks***

#### **2.1.1. Who may apply for registration?**

Generally speaking, the applicant of the mark may be an individual or a company or association, residing in Romania or abroad, having full civil capacity (namely the capacity to acquire rights and obligations, to enter into agreements, to stand trial).

Usually, the trademark application is filed through a trademark attorney residing in Romania.

The applicant with headquarter or economic activity only outside Romania is requested to indicate an address in Romania for receiving documents in respect of its application.

The applicant residing outside the European Union or European Economic Area is requested to appoint a trademark attorney residing in Romania for all procedures except the filing of the application.

In some recent cases, the trademark office raised objections concerning a claimed misleading character of a mark in connection with the person of the applicant. Thus, depending on the particulars of the case, additional requirements may apply in respect to the person of the applicant.

### **2.2. *Scope of trademark***

#### **2.2.1. What may and may not be protected and registered as a trademark? (Please distinguish between rights pursuant to registration and rights under the common law, if any, and note whether service marks, collective/certification marks or 'non-traditional' marks, such as sounds, smells, designs, etc, may also be registered).**

According to Romanian trademarks law, any sign can constitute a trademark, such as words, character's name or designs, letters, figures, colours, figurative elements, shape of the good or packaging, or sounds, under the condition that said signs are capable to distinguish the goods or services offered by a company or person and those offered by others and respectively to be represented into the Trademark Register.

Collective marks and certification marks are also registrable as national trademarks.

Non-traditional marks (smell marks, sound marks, marks representing colours, holograms and dynamic marks) are very rare in Romania.

### **2.3. *Unregistered trademarks***

#### **2.3.1. Can trademark rights be established without registration?**

According to the provisions of article 4 of the Romanian Trademarks Law, the right over a trademark is established through registration with the Romanian Patent and Trademark Office. The European Trademarks confer protection on the Romanian territory in accordance with the provisions of the EU Trade Mark Regulation.

The Romanian Trademarks Law does provide protection for marks that are notorious on the Romanian territory, without the requirement of being registered marks. However, the standard of proof for the notorious character of the mark is very high.

## **2.4. Famous foreign trademarks**

- 2.4.1. Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

According to the provisions of article 6, paragraph 3(f) of the Romanian Trademarks Law, an interested party may oppose the registration of a mark that may be confused with an earlier mark protected abroad, provided that, at the date of filing the application, the applicant has acted in bad faith.

According to the provisions of article 6, paragraph 3(a) of the Romanian Trademarks Law, an interested party may oppose the registration of a mark that may be confused with an earlier mark with reputation and registration in Romania or in the European Union, provided that the use of the later mark would lead to unjustified benefits to or would harm the distinctive character or reputation of the earlier mark.

However, the standard of proof for the reputation of the mark in a certain territory or for the bad faith of the applicant is very high. Thus, the recognition of these rights is problematic in terms of duration, efforts and costs applicable for the necessary proceedings.

## **2.5. The benefits of registration**

- 2.5.1. What are the benefits of registration (eg, increased remedies for infringement, access to specialised courts, legal presumptions, availability of border enforcement mechanisms against unauthorised goods)?

A trademark registration is a very useful instrument of protection, while the costs for registration are not high. The rights conferred by a trademark registration extend to similar trademarks and similar products that are able to generate confusion to the public. Infringement lawsuits are possible, the best venue being the Municipal Court of Bucharest. Although there is no specialist IP court in Romania, the Municipal Court of Bucharest has three sections that hear intellectual property matters. The judges of these sections are knowledgeable on trademark matters.

Trademark registrations can constitute the base for customs applications. No official fees apply for such proceedings to Romanian customs, which allows customs to perform seizures of goods suspected to be counterfeit.

Also, Romanian police often develop ex officio actions using data concerning the registered trademarks from the Romanian Patent and Trademark Office database.

## **2.6. Filing procedure and documentation**

- 2.6.1. What documentation is needed to file a trademark application (eg, power of attorney, certificate of corporate good standing, etc)? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The Romanian Patent and Trademark Office requires power of attorney for trademark applications filed by authorised representatives – no additional certificate or ID documents are required.

The representation of a trademark is governed by the same rules as the ones for applying for [European Trademarks](#), dated October 2020.

Trademark applications can be filed either online or with the record office of the Romanian Patent and Trademark Office. In the latter case, it is necessary to print the form from the website and to fill in the relevant data.

Trademark searches are available (not mandatory), and the Romanian Patent and Trademark Office offers free access to the national database.

## **2.7. Registration time frame and cost**

2.7.1. How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? (It might be useful to the reader to know what an average total cost is in relation to the registration of an average mark in a single class.)

The smooth registration proceeding takes approximately nine to 11 months from filing the application until obtaining the registration certificate, a trademark application is published initially for observation purposes and second, for opposition purposes, each corresponding term being two months.

All-inclusive official fees for filing, publication, examination and registration of a trademark in two classes are:

- in the case of a word mark: €200;
- in the case of a mark with a black-and-white logo: €230; or
- in the case of a mark with a colour logo: €380.

Any additional class involves an additional cost of €50.

No information regarding the charges is available, as these might vary depending on the authorised representative hired.

Objections on absolute grounds or formal irregularities extend the proceeding by two to four months. Oppositions extend by six to 12 months the duration of the proceedings, while if the prior right grounding the opposition has not completed the registration proceeding, the proceeding is suspended.

## **2.8. Classification system**

2.8.1. What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

In Romania, the Nice classification applies. The current edition in use is the 12th edition, version 2023.

For multi-class trademark applications, the official fees payable to the Romanian Patent and Trademark Office for filings are calculated depending on the number of the Nice classes for which the registration is requested.

The benefit of a multi-class application would be that for additional classes starting with the second, the additional official fees would be €50 per class instead of the entire official fee for a separate trademark application. Note that we did not take into consideration the professional

charges for single-class or multi-class applications, as these might vary depending on the authorised representative hired.

## **2.9. Examination procedure**

- 2.9.1. What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The examination procedure is according to the provisions of Romanian trademarks law. First, the trademark application is examined on absolute grounds, then, if the registration following said examination is accepted, the mark is published for starting the two months opposition period.

The trademark office does not oppose prior rights ex officio.

In the absence of opposition, the registration procedure is successfully completed and the registration certificate is issued after the payment of the official fee into a non-extendable term, 30 days from the date of receiving the notice for payment from the office.

In the case of objections (refusals on absolute grounds of opposition from third parties), the applicant has the possibility to respond within a two-month period of their receipt.

A letter of consent signed by the owner of the prior mark or the simple withdrawal of the opposition is accepted by the Romanian Patent and Trademark Office.

## **2.10. Use of a trademark and registration**

- 2.10.1. Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

The Romanian Trademarks Law does provide a grace period of five years from the date of finishing the registration procedure for starting the use of the mark. After said term expires, if the use of the mark was not started, the mark is vulnerable to exhaustion at the request of third parties.

Thus, the use of the mark prior to the moment when the registration is granted is not mandatory.

## **2.11. Markings**

- 2.11.1. What words or symbols (if any) can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The owner of the mark is not obliged to use a symbol showing that the mark is registered, but such use is advisable as notice for third parties, for becoming aware that the sign concerned is protected as a mark and for reconsidering their actions accordingly.

A suitable symbol is composed of the letter R, displayed in a circle: ®.

## **2.12. Appealing a denied application**

2.12.1. Is there an appeal process if the application is denied? (Please include a discussion of both administrative – eg, within the Trademark Office – and judicial appellate procedures.)

In the case of a decision rejecting the registration of the mark, following the examination of the absolute grounds, or following an opposition, said decision may be appealed within 30 days of its receipt. The appeal is resumed by the Romanian Patent and Trademark Office's Appeals Commission in a public hearing, with the summoning of the party (or parties). The decision can be further appealed to the Municipal Court of Bucharest and, further on, to the Bucharest Court of Appeal.

### **2.13. *Third-party opposition***

2.13.1. Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

After issuing a decision of admitting the registration of the mark following the examination of the absolute grounds, the Romanian Patent and Trademark Office publishes the trademark in electronic format to start the period of two months in which third parties could file oppositions.

The Romanian Trademarks Law provides the possibility to oppose a trademark registered abroad if the filing of the later mark was made in bad faith; however, in practice, such oppositions are rarely admitted by the Romanian Patent and Trademark Office.

After the registration is completed, third interested parties could request the cancellation of the trademark by filing a claim with the Municipal Court of Bucharest for judicial proceedings or with the Romanian Patent and Trademark Office for administrative proceedings.

Cancellation claims filed with the Romanian Patent and Trademark Office are reviewed by a specialised commission whose members hear only exhaustion and cancellation claims respectively without being involved in any other trademark proceedings. If a trademark is cancelled in administrative proceedings, the specialised commission shall not decide on the legality of the contracts in relation to the cancelled trademark and it is necessary to lodge a separate lawsuit with the competent court of law regarding said legality.

The costs of opposition or cancellation procedures vary, depending on such factors as the complexity of the case, the venue, and the authorised representatives, lawyers or attorneys involved. The degree of variation is very high and so it is difficult to state a typical range. As a general rule, the costs of administrative proceedings (ie, before the Romanian Patent and Trademark Office) are substantially lower than judicial proceedings before the Municipal Court of Bucharest and ex parte procedures are less expensive than inter partes procedures.

### **2.14. *Duration and maintenance of registration***

2.14.1. How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The registration period begins with the date of filing the trademark application, and lasts for a 10-year period, renewable with additional periods of 10 years each. The renewal application can be filed online or traditionally with the registry of the Romanian Patent and Trademark Office in the last six-month period of protection (with standard fees) or in the next six-month period after the expiration date (with surcharge). The costs for renewal are the same amount as the registration costs less the publication costs. A fresh power of attorney is required. The proofs of use are not required by the Romanian Patent and Trademark Office for maintaining a trademark registration or granting the renewal.

## **2.15. Surrender**

### 2.15.1. What is the procedure for surrendering a trademark registration?

The owner can surrender the registration of the mark for all goods or services or only for a part of them. In this respect, a written request should be filed with the Romanian Patent and Trademark Office.

If a licence was granted in respect of the mark, the renunciation of the mark is recorded only if the trademark owner proves that he or she notified the licensee about the intention to renounce the mark. If a security or a measure of forced execution was recorded with the Romanian Patent and Trademark Office in respect of said mark, the renouncement would be recorded only with the agreement of the beneficiary of the security or after the forced execution measure is erased.

## **2.16. Related IP rights**

### 2.16.1. Can trademarks be protected under other IP rights (eg, copyright, designs)?

The protection through copyright or design is different from the protection obtained through mark but they may be complementary. For example, if the object of protection is the image of a label used in commerce for food or beverages, said label can be simultaneously protected as a trademark, as a design and by copyright. Trademark protection and copyright protection refer to the ensemble of the elements of the label, whereas design protection excludes the words as such, but includes the aesthetic elements.

## **2.17. Trademarks online and domain names**

### 2.17.1. What regime governs the protection of trademarks online and domain names?

The Romanian Trademarks Law contains provisions concerning the conflict of the mark with a previously protected sign that confers the right to interdict the use of a later mark. In practice, for applying such a conflict, the mark and the prior sign should be identical or highly similar and designated for identical, highly similar goods or services.

The claim is of the competence of the court, that is Municipal Court of Bucharest if the infringed mark is a European mark or, in the negative, the court determined by the defendant's domicile.

## **3. Licensing and assignment**

### **3.1. Licences**

- 3.1.1. May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement (eg, quality control clauses)?

The licence may be recorded with the Romanian Patent and Trademark Office at the request of the trademark owner or of the licensee, accompanied by a legalised copy of the licence agreement. The registered licence is published in the Official Trademarks Bulletin and produces effects with respect to third parties only as of the publication date.

For the purpose of submitting it to the Romanian Patent and Trademark Office, the licence agreement must specify the details of the licensor, licensee and their representatives, if any, details of the mark concerned, list of concerned goods, services or territories, period of licence or signatures.

### **3.2.        *Assignment***

- 3.2.1. What can be assigned? (Trademark with goodwill? Without goodwill? All or some of the goods and services? Must other business assets be assigned to make it a valid transaction?)

The transmission of the trademark can be made irrespectively of the transmission of the business assets.

The Romanian Trademarks Law provides the possibility to assign the mark in its entirety or only for some of the Nice classes for which the mark is protected. The condition provided by the law for assignment is that identical or similar marks, belonging to the same owner and used for identical or similar goods or services are transmitted by assignment only in their entirety, and only to the same person, under the sanction of cancelling the assignment.

The Romanian Trademarks Law also does not prohibit assigning the mark prior to the registration; namely, as a trademark application. The same principles as for the transfer of the registered mark applies.

### **3.3.        *Assignment documentation***

- 3.3.1. What documents are required for assignment and what form must they take (eg, notarisatio)n)? What procedures apply?

The request for recording the assignment of the mark should be accompanied by the legalised copy (by a public notary) of the assignment agreement signed between the parties or of an extract from said agreement. By legalisation, the public notary certifies the identity of the signatory parties and that the trademark really exists.

### **3.4.        *Validity of assignment***

- 3.4.1. Must the assignment be recorded for purposes of its validity?

According to Romanian trademarks law, the assignment of the mark must be made in writing and signed by all contracting parties, except the case when it results from a court decision or when it follows the execution of an obligation stipulated in an agreement. Failure to do so results in having the assignment void.



At the request of one of the parties, the assignment of the mark is recorded with the Romanian Patent and Trademark Office and published in the Official Trademark Bulletin. The assignment is opposable to third parties only from the date of its publication in the Official Bulletin.

Thus, the recordal of the trademark assignment is not a condition for its validity, but is a condition for its opposability to third parties. The assignment produces effects for the signatory parties starting with the date stipulated in the agreement signed by the parties.

### **3.5. Security interests**

- 3.5.1. Are security interests recognised and what form must they take (eg, notarisation)? Must the security interest be recorded for purposes of its validity or enforceability?

At the request of the interested party, security interest, such as measures for forced execution, pledge or other property right concerning trademarks are recorded in the Trademark Register and published in the Official Bulletin. For the purpose of submitting it to the Romanian Patent and Trademark Office, it is necessary a certified copy (by the party) or a legalised copy of the document.

## **4. Enforcement**

### **4.1. Trademark enforcement proceedings**

- 4.1.1. What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

In Romania, industrial property matters are considered part of civil law, not commercial law. The most important types of legal action that can be initiated against an infringer based on provisions from the Romanian Trademarks Law are civil trademark infringement lawsuits and criminal actions against the infringer.

There is no specialist IP court in Romania. The Municipal Court of Bucharest has three sections that hear intellectual property matters. The judges of these sections are knowledgeable about trademark matters.

In addition, the Municipal Court of Bucharest is the only court that can hear trademark cancellation or exhaustion claims and infringement claims against European marks.

From 14 January 2023, claimants in trademark cancellation or exhaustion claims have a choice between the competence of the Municipal Court of Bucharest for judicial proceedings and the Romanian Patent and Trademark Office for administrative proceedings.

The choice of the court for infringement cases must follow the general rules with respect to competence. Territorial jurisdiction is determined by the defendant's domicile in civil proceedings and by the defendant's domicile or the place of infringement in criminal proceedings.

### **4.2. Procedural format and timing**

- 4.2.1. What is the format of the infringement proceeding? (Is discovery allowed? Live testimony? Experts? Who decides the case? How long does the proceeding typically last? If there is a criminal enforcement mechanism, what is that procedure?)

Civil trademark infringement lawsuit is of two types: permanent injunction claim and interim injunction claim. The permanent injunction claim can be lodged as a stand-alone trial. The interim injunction claim must be accompanied by the permanent injunction claim.

All the matters are heard by one judge or, in some cases, by a panel of judges. Jury trials do not exist in Romania.

A civil trademark infringement lawsuit is submitted by the plaintiff to the competent court together with the evidence. Once the formal aspects are cleared, the writ is transmitted to the defendant who has 25 days to submit a counter-statement.

An electronic court file is available in some courts, such as the Municipal Court of Bucharest and the Bucharest Court of Appeal.

Once the exchange of documents is done, the court sets hearings. The initial hearings usually deal with the type of evidence suggested by the parties. The last hearing is the one where the pleadings take place. After the pleadings, in trademark infringement cases the parties submit written conclusions. Usually, in trademark infringement cases, the judges deliver the operative part of the judgment one to four weeks after the deadline for the written conclusions. Said operative part of the judgment is available on the internet site. The motivation of the decision is written two to four months after the ruling and delivered to the parties.

Types of evidence customary in trademark infringement proceedings: mostly documents.

Testimonies and cross-examination of witnesses are allowed but not very frequent. In some cases, the court orders an expert report. Affidavits can be used but are not customary. The rule is that the parties suggest the type of evidence and the judge decides to accept it or not for each type of evidence.

In the absence of an expert report, the trial can take about 12 to 18 months in the first instance. If the expert report is ordered by the court, the parties can challenge it, which leads to roughly an additional year.

In many cases the defendant – that is, the infringer – lodges a request for cancellation or exhaustion of rights conferred by the trademark based on which the infringement lawsuit started. In this case, the infringement is usually stayed until a final decision is taken in the cancellation or exhaustion case. The cancellation can take two to four years including the appeal, also depending on the existence or not of an expert report that is different from the possible expert report of the infringement lawsuit.

Expert reports are rarely ordered in trademark cases.

#### **4.3. *Burden of proof***

##### **4.3.1. What is the burden of proof to establish infringement or dilution (or any other relevant claim specific to your jurisdiction)?**

The burden of proof for infringement cases is on the plaintiff. He or she must demonstrate the infringement using any type of evidence accepted by the judge.

Types of evidence customary in patent infringement proceedings are mostly documents.

Testimonies and cross-examination of witnesses are allowed but not very frequent. In some cases, the court orders an expert report. Affidavits can be used but are not customary. The rule is that the parties suggest the type of evidence and the judge decides whether to accept it for each type of evidence.

The burden of proof for exhaustion counterclaims or claims is on the defendant, who is the plaintiff in the infringement case. He or she must demonstrate that the trademark on which the infringement is based fulfils the use requirement.

The burden of proof for cancellation claims is on the plaintiff, who is the defendant in the infringement case. He or she must demonstrate that the trademark on which the infringement is based fulfils the legal requirements at the moment of its filing.

#### **4.4. Standing**

4.4.1. Who may seek a remedy for an alleged trademark violation (trademark owner, licensee, etc) and under what conditions? Who has standing to bring a criminal complaint?

The rule is that any interested party can sue. The interest is defined in the Code of Civil Procedures as being 'determinate, personal, legitimate, real and actual'. If the interest is not real and actual, that is, it refers to a probability that something happens that can harm the plaintiff, said plaintiff is allowed to take action to prevent such harm.

The owner of a similar or an identical mark may file a civil claim or a penal complaint against the persons involved in the counterfeit.

As regards the licensee, he or she may file an infringement claim providing either that he or she has the consent of the trademark owner, or that he or she notified the trademark owner about the infringement acts, but the last one did not take action within the term requested by the licensee.

#### **4.5. Border enforcement and foreign activities**

4.5.1. What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution? (Mention any significant or unusual jurisdictional issues regarding foreign activities.)

Customs enforcement is available for trademark owners to stop counterfeit products from entering Romanian territory. Customs authorities may act ex officio or based on an application for action. Customs actions usually end with a simplified procedure, which leads to the destruction of the counterfeited goods. If requested, customs' intervention may be followed by civil or criminal proceedings.

#### **4.6. Discovery**

4.6.1. What (if any) discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country? (Please include discussion of matters such as the difficulty or costliness of employing discovery/disclosure techniques, or their usefulness at trial.)

In theory, Ordinance 100/2005 transposing Directive 2004/48/EC is applicable – see article 8 of Directive 2004/48/EC according to which the competent judicial authorities may order that information on the origin and distribution networks of the goods or services that infringe an intellectual property right be provided by the infringer. Thus, said mechanism implies filing a court claim.

Similar provisions are included in articles 103, 105 and 106 of the Romanian Trademarks Law – collecting evidence and information, taking measures for the preserving of evidence – and are also available by filing a court claim.

#### **4.7.        *Timing***

4.7.1. What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction (if any) and trial levels, and on appeal?

In the absence of the expert report, the trial can take about 12 to 18 months in the first instance. If the expert report is ordered by the court (rarely accepted in trademark matters), the parties can challenge it, which leads to roughly an additional year.

In many cases the defendant – that is the infringer, lodges a counterclaim for cancellation or exhaustion of rights for non-use concerning the trademark based on which the infringement lawsuit started. In this case, the infringement is stayed until a final decision is taken in the cancellation or exhaustion case. The cancellation or exhaustion claim can take between one and three years including the appeal.

The trial in the appeal stage takes about one year.

It must be mentioned that, if the defendant is a foreign company and has no known address for service in Romania (such as, eg, the attorney of the record of the trademark), the plaintiff must submit a translation of the infringement writ in the language of the country where the defendant is domiciled. The court clerk sends the writ and the annexes in that country and waits for the official confirmation that the writ was served. This can take several months, maybe one year if the address is not correct.

#### **4.8.        *Limitation period***

4.8.1. What is the limitation period for filing an infringement action?

There is no limit for seeking a remedy for trademark infringement, if by ‘remedy’ it is understood the permanent injunction that is the interdiction for the infringer to carry out the infringing acts. However, if the claim relates to infringement acts known by the claimant more than three years ago, the court might consider that the interest of the claimant is not in the present, and this might lead to an irregularity of the claim and its further possible rejection on the ground of lack of interest.

In addition, damages must refer to infringement acts that have occurred in the past three years from the date of lodging the court trial.

#### **4.9.        *Litigation costs***

4.9.1. What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal? (Please also include any notable case law or legislation as to whether a successful plaintiff can recover costs and, if so, to what degree and in what circumstances.)

The costs of a trademark infringement claim vary depending on the complexity of the case and the lawyers or attorneys hired. The degree of variation is very high, being difficult to define a typical range.

The trial costs granted by the courts must be based on the filed evidence of their effective payment by the party and usually refer to court costs (not to preparatory costs). However, the judge can reduce the amount requested by the party to be reimbursed to one considered reasonable.

Once granted, the trial costs may be voluntarily paid by the losing party after the decision remains definitive or the winning party may request forced execution through the judiciary executor.

The effective reimbursement depends on the solvability of the debtor. If the debtor is a foreign company or individual, the court decision must be enforced in the country of the debtor.

#### **4.10. Appeals**

##### 4.10.1. What avenues of appeal are available?

In the appeal stage, the parties can use both legal and factual arguments. New evidence is allowed at the appellate stage; however, the principle is that said evidence was not available in the first instance. In the cases when an expert report is ordered by the court, sometimes the appellate court orders a new expert report to be carried out in the appeal stage.

#### **4.11. Defences**

##### 4.11.1. What defences are available to a charge of infringement or dilution, or any related action?

The trademark infringement is of the competence of municipal courts and respectively Courts of Appeal corresponding to the place where the defendant is domiciled or from the place where the infringement occurred (at the claimant's choice).

For infringement of European trademarks, the Municipal Court of Bucharest is the sole court that can hear such claims together with the Bucharest Court of Appeal.

In many cases, the defendant – that is the infringer – lodges:

- a request for proof of use of the prior mark that was acquired more than five years from its registration. In the absence of such proof filed by the claimant, the court claim is rejected without substantive examination;
- a counterclaim or a separate claim of exhaustion for non-use of the trademark based on which the infringement lawsuit started. In this case, the infringement usually is stayed until a final decision is taken with respect to the exhaustion claim; or
- a separate claim of cancellation of the trademark based on which the infringement lawsuit started for absolute grounds that should have been blocked the registration or for bad faith registration. In this case, the infringement usually is stayed until a final decision is taken with respect to the cancellation claim.

#### **4.12. Remedies**

##### 4.12.1. What remedies are available to a successful party in an action for infringement or dilution, etc? (How is monetary relief apportioned? Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions?) What criminal remedies exist?

#### **Monetary remedies**

There are two types of monetary remedies: court trial costs and damages.

The general rule is that the parties must ask for monetary remedies and to submit evidence. The remedies are not awarded *ex officio*.

Court trial costs refer to the costs related to the lawyers, attorneys, experts or translators. If requested by the parties, they are included in the decision in the sense that the losing party is obliged to pay the winning party the amounts decided by the judge.

If the amount of court trial costs requested is considered to be reasonable, the judge can award it in its entirety, otherwise, the judge may award less than initially requested.

### **Injunctions against infringement or aiming to ban imports of counterfeit goods**

Interim injunction is possible to obtain if the patent owner demonstrates the urgency and temporary character of the measures requested.

Interim injunction must be accompanied by a permanent injunction claim, usually lodged on the same day with the court.

Temporary character means that, if granted, it is in force until a final decision is taken in the permanent injunction claim.

Interim injunction may be effective against the infringer's suppliers or customers.

The decision to ban imports of counterfeit goods can be then communicated to the customs authorities to enforce it.

### **Penal remedies**

The owner of the infringed rights may file a penal complaint for the infringement offence, based on the provisions in article 102 of the Romanian Trademarks Law.

In most cases, the penal files concerning counterfeits are not further pursued in court by the prosecutor, considering either that the infringement act involved no social danger, or considering that the guilt of the person investigated is absent. However, even in cases where penal sanctions are not applied to the person involved, the goods remain seized for the benefit of the state under the penal legislation.

#### **4.13. ADR**

4.13.1. Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

ADR techniques are available, but rarely used (eg, mediation procedures).

The trademark owners prefer filing court claims, these being considered to offer impartial judgment, the possibility to appeal the decision and confidentiality on the details of the case.

## **5. Update and trends**

### **5.1. Key developments of the past year**

5.1.1. Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

We have a recent decision taken by the Bucharest Court of Appeal that is currently pending final appeal. Said decision concerns the infringement of a registered mark by importing spare parts for cars bearing labels indicating, through others, the mark with which the product is compatible. The decision orders the stopping of the import of goods bearing such labels. Prior to the aforementioned decision, such references to marks on spare parts' packaging have not been considered counterfeit actions. Thus, in the absence of reversing the decision

through final appeal, it may constitute groundbreaking in infringement matters decided by the Romanian courts.

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