

Romania - New Trademark Law entered into force on July 13, 2020

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The amended Trademark Law implementing the EU Directive 2015/2436 of the European Parliament and of the Council of December 16, 2015 entered into force as of July 13, 2020. For the time being, the Implementing regulations are still pending.

The main changes concern the registration proceedings, allowing for a clearer extent of protection in respect of the goods and services as well as changes in the registration and opposition proceedings, streamlining the procedure and granting a precise registration date for the trademark.

In respect of the list of goods/services, the amendments implement the rules of IP Translator, namely any filing for general terms or class headings shall be construed to be a request for goods/services included by the literal meaning of said terms. For already registered trademarks covering class headings, a declaration concerning the list of goods and services extending beyond the literal sense of the goods/services can be filed up until September 30, 2020, but only if said goods/services can be found in the alphabetic list of the Nice Classification edition as of the filing date of the trademark in question.

As per the new procedure, the trademark application, which was granted an application date, shall be published electronically within 7 days, opening a two months term for observations (the first publication). The trademark application undergoes the ex officio examination based on absolute rights. In the old version of the law, the two months term would also open the opposition phase, based on third party prior rights. The procedure would allow for an application to receive oppositions during its absolute grounds for refusal examination, leading to receipt by the applicant of both an opposition and a potential ex officio refusal.

The new procedure allows for the application to undergo examination for absolute grounds for refusal first, the trademark being granted should it either pass the examination or overcome the provisional refusal. The new term for filing a reply to a provisional refusal is of 30 days as of communication, extendable with one other period of 30 days. The old version of the law provided for 3 months, extendable with an additional 3 months.

Once the trademark is granted, it is published for third party oppositions based on relative grounds for refusal (the second publication). The term for filing oppositions remains 2 months as of the publication date. The new opposition procedure is completely different from the old law version, with novelties such as a cooling off period of 2 months that can be mutually extended with a term of up to three months, allowing the parties to amicably settle the matter. Should the parties not settle within the term, the opponent is given a 30-day term to file arguments and evidence in support of the opposition, and the applicant has 30 days to file arguments in reply and request proofs of use. In its turn, the opponent is given 2 months to file proofs of use (the prior term being 30 days), and the evidence is then

communicated to the applicant who has 30 days to respond thereto, a new measure of the amendments.

Once the adversarial procedure is completed, the PTO must take a decision concerning the opposition within 2 months. Once the opposition proceedings are final, or the term for filing oppositions had lapsed, the applicant is notified on the finalization of the registration proceedings and can request the issuance of the certificate of registration within 30 days as of said notification: the date of the finalization of the proceedings is the registration date of the trademark. Once the certificate is issued, the trademark registration is published in the Trademarks Gazette as a registered trademark (the third publication). In the old version of the law, a granted trademark was published as registered, however, it could still be challenged within 30 days as of publication by any interested party, and the date of registration would be the date said term had passed without the trademark being objected to.

As per the transitory regulations of the amendment law, the trademarks filed under the old version of the law shall follow its procedure with the exception of the trademarks for which a decision of acceptance had been issued but for which the certificate of registration had not been requested. Holders of said trademarks are given the above-mentioned 30 days term to request the certificate of registration under the penalty of the trademark being cancelled.

Other notable changes besides the registration procedure concern sound marks, that are now explicitly regulated by the law, designations of origin that are now included with geographic indications as absolute grounds for refusal as well as being invoked as prior rights in an opposition.

Finally, cancellation actions can be filed before the Bucharest Municipal Court or, as of January 14, 2023, before the PTO.

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