

## ABSTRACT

### COUNTRY PERSPECTIVES – EFFECTS OF THE PROPOSED AMENDMENTS TO THE TM DIRECTIVE ON NATIONAL LAW

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#### Introduction - a short history of trademark protection in Romania

- The first regulations for trade marks protection in Romania was set up in the **Trade Convention between Austria-Hungary and Romania from 1875**. Two years later, the similar provisions could be found in **Trade Convention between Germany and Romania** (from 14.11.1877).

- Actually the first Romanian trade marks law was adopted on 15/27.05.1879 and it was entitled "**The Factory and Trade Marks Law**", in force more than 88 years!
- On 29.12.1967, **communist regime** adopted the "**Law on Factory, Trade and Service Marks**"- (second romanian TM law);
- On 23.07.1998 in the context of the free market economy, taking into account the Directive 89/104/EEC, Romania adopted **-The Law on Trade Marks and Geographical Indication - L84/1998**. This law was amended and republished in 2010"- (third romanian TM law), in force (law).

#### 1. Main features of the law in force

According to the law, "*trademarks may consist of any sign capable of being **represented graphically**, such as: words, including personal names, designs, letters, numerals, figurative elements, three-dimensional shapes and, particularly, the shape of goods or of packaging thereof, colours, combinations of colours, holograms, acoustic signals, as well as any combination thereof, **provided that such signs are capable of distinguishing the goods or services of one enterprise** [undertaking] **from those of other enterprises** [undertakings]."* (Art.2/law)

As many other countries in Europe, Romania adopted from the very beginning a **first-to-file TM system**. In this respect, is the Art.8 of the law:

*"The right to the trademark shall belong to the applicant which was the first to file the application for trademark registration **under the conditions laid down by the law.**"*

**Prior use** is only required in the cases where the mark could be refused for lack of the distinctiveness. In such a case the applicant must prove acquired distinctiveness (i.e., secondary meaning) through extensive use before the filing date.

Moreover, the prior use of a sign in the course of trade should be taken into consideration as relative ground for refusal or invalidation (in accordance with Art. 4 para. 4, b) from Directive 2008/95/EC)

Romanian TM system has a **pre-grant opposition system**. An opposition may be filed against a trademark application published in the OSIM *Official IP Gazette* by the holders of prior TM valid or well-known in Romania or EU within two months. The applicant may request the opponent to file proof of genuine use of the opposed TMs in Romania or in EU, depending on the case.



Romanian TM system has no **administrative revocation** and **cancellation** procedure. Trademark revocation or cancellation is available as in-court proceedings before the Bucharest Municipal Court, as first instance.

## 2. New provisions of the draft TM Directive

Regarding the “Proposal for a Directive of the European Parliament and of the Council to approximate the laws of Member States relating to trade marks” (draft of new Directive), it appears that it is more strict, leaving fewer options to the Member States. These 19 items each is Directive 2008/95/EC, the new draft directive contains no less than 53 articles.

Among the major changes proposed in the new draft directive, I will focus on the following issues:

- Change of the trade mark definition to adapt it to the practices and technological possibilities of representation of the distinctive signs;
- Considering the descriptive (or misleading) in all official EU languages;
- Relative grounds for refusal completing by three new cases on bad faith (Art. 5(3)):
  - trade mark applied for by agents or representatives without consent of the right owner
- Registration of trade marks (registered) and used outside the Union in order to block the entry of the mark in the common market, and
- Marks contrary to Union legislation on the protection of designations of origin and geographical indications;
- New rules for the identification and classification of goods and services;
- Administrative post-registration opposition;
- Administrative revocation and cancellation (invalidation).

## 3. The impact of the new draft directive on the law in force in order to implement it, if the directive is approved

In my opinion, a true European TM has the following essential characteristics in comparison with a national trade mark :

- Word elements of the European TM shall pass the test of distinctiveness and other absolute grounds in any of the official EU languages;
  - The owner of a European TM shall be able to act (in a few years) at the Internal Market level in order of genuine use of his TM, but not only nationally – (test of genuine use of an European TM).

The test of genuine use of an European TM is not so relevant because it can be applied only after the 5 years grace period and following the action to revoke of an interested third party. But the new draft Directive will force the national offices to apply the same criteria, very restrictive (to national TMs) as OHIM (to European TMs)! Thus the difference between the TMs registration conditions at NIPOs and OHIM will disappear.