

# INDUSTRIAL PROPERTY & TRADEMARKS

*The presentation hereby has in view the legal provisions in force on the 31<sup>st</sup> of March 2004*

## **Applicable legislation in this field**

- Law no. 64/1991 on patents, republished in the Official Gazette no. 752/15<sup>th</sup> of October 2002
- Law no. 129/1992 on protection of industrial designs and models, published in the Official Gazette no. 1/8<sup>th</sup> of January 1993
- Law no. 84/1998 on trademarks and geographical indications, republished in the Official Gazette no. 193/26<sup>th</sup> of March 2003
- Government Decision no. 573/1998 on organization and functioning of the State Office for Patents and Trademarks (OSIM), published in the Official Gazette no. 345/11<sup>th</sup> of September 1998

This chapter shall examine the legal provisions regarding: patents, utility models, industrial designs and models, trademarks, geographical indications, layout-designs of the integrated circuits.

## **I. Patents**

An invention is a technical creation through which a solution is found for specific problems in the technological field. Rights on such an invention are recognized and protected on the Romanian territory by granting a patent by the State Office for Patents and Trademarks.

In order to be patentable, an invention has to fulfill the following conditions: to be novel, results from an inventive activity, it can be industrially applied. According to the Law no.64/1991 the following are not patentable inventions: a) ideas, b) discoveries, c) scientific theories, d) mathematic methods, e) computer programs as such, f) economic or organizing solutions, g) methods of teaching and training, h) rules of the game, i) town systems, j) plans and methods of systematization, k) physical phenomena as such, l) culinary recipes, m) discoveries with aesthetic characteristics.

The inventions contrary to the public order and good morals are also not patentable.

## **1. Patent**

The right to issuance of the patent belongs to the inventor, namely his legal heirs. The law also stipulates cases when the right to issuance of the patent belongs to other person than the inventor (**the case of the job inventions**).

In Romania, the duration of validity of a patent is of 20 years. The term begins from the date of the national legal deposit. For the invention that improves another invention protected by patent and cannot be applied without the one previously patented, the duration of validity of the patent is limited to that of the patent granted for the invention it improves, without being shorter than 10 years.

## **2. Stages of the patent procedure**

- application registration, establishment of the national legal deposit;
- preliminary examination of the application;
- publication of the patent application;
- documentary search; publication of the documentary report;
- examination as to substance of the application;
- publication of the patent;
- procedures of revising the decisions regarding solving of patent applications;
- issuance of the patent.

## **3. Rights of the patent owner**

The patent grants to its owner an exclusive right of exploitation for its entire duration of protection. Thus, the following acts are forbidden without the owner's consent:

- making, using, selling or importing for using or selling, if the patent subject-matter is a product;
- using of the process, as well as using, selling or importing for these purposes of the product directly obtained through the patented process, if the patent subject-matter is a process.

Exceptions from the patent owner's exclusive right are stipulated by Art.37 from the Law no. 203/2002.

#### **4. Transfer of the rights granted by patent**

The patent right, the right to patent granting and the rights deriving from a patent may be partially or totally transferred. The transfer may be made by assignment or licensing, exclusive or non-exclusive, or by legal or testamentary succession. The transfer only produces effects to third parties beginning with the date of the publishing in the Official Gazette of Industrial Property of the mention of the transfer registered with OSIM.

Upon any interested person's request, the Bucharest Tribunal may grant a *compulsory license* at the expiring of a four years term from the deposit date of the patent application or of a three years term from the granting of the patent, taking into account the latest expiring term. The provisions of the previous paragraph apply only if the invention has not been applied or has been insufficiently applied on the Romanian territory and the patent holder cannot justify his inaction and if an agreement has not been reached with him regarding the conditions and commercial modalities of using the invention.

The beneficiary of the compulsory license may be the Government or its authorized third parties.

Compulsory licenses are non-exclusive and are granted by the Bucharest Tribunal, in strict conditions regarding their scope and durations, as well as the level of the remuneration due to the right holder, established in connection to the commercial value of the licenses granted. Compulsory licenses shall be mainly authorized for the market supplying.

#### ***II. Utility models***

The utility model is a technical creation, settling a technical problem, especially regarding the form of the construction and the assembly of a product and which possessed novelty. The procedure of protection granting is similar to that for the inventions. The protection title grants to the holder a right of exclusive use of the utility model. The duration of protection is lower (usually 10 years). Utility models are not protected in Romania.

#### ***III. Industrial models and designs***

The protection of industrial models and designs is regulated in Romania by the Law no. 129/1992, as amended by the Law no. 585/2002. The title of protection granted by OSIM for registered industrial models and designs is the registration certificate. The protection subject-matter is the

industrial model or design. The industrial model or design may only be registered if:

- *it is novel*, that is it has not been made public before the date of the filing the registration application or, if the priority has been claimed, before the priority date;
- it has an individual character.

## **1. Right to protection**

The right to the issue of the registration certificate belongs to the author of the industrial model and design or to his heir in rights, for the industrial models and designs created independently and not as a result of certain contracts with creative mission or by employees, within their job duties. Natural or legal persons having domicile or headquarter, as the case may be, outside the Romanian territory, benefit from the provisions of the Law no. 129/1992 as amended, subject to conditions of the international conventions and treaties on industrial models and designs to which Romania is party.

The author has the right to have his last name mentioned as well as the first name and the capacity in the issued registration certificate, as well as in any acts or publications regarding the industrial design or model; these data shall be registered in the author's labor book. If the holder of the registration certificate is another person than the author, the latter has the right to the issuance of a duplicate of the registration certificate. The holders of the registration certificates of the industrial models or designs can mention on products the sign D, respectively the capital letter "D", written in a circle, accompanied by the name of the holder or the number of certificate.

The protection granted by registration of the industrial models or designs does not preclude the benefit of protection granted by copyright.

**The rights deriving from a registration certificate of the industrial model or design shall not be exercised in the case of introduction on the market, on the Romanian territory, of the products in which protected industrial models or designs are embodied, sold previously by the holder of the registration certificate of with his consent.**

## **2. Registration of the industrial models and designs**

The registration application and the description, presented under the form requested by law and drawn up in Romanian language, accompanied by graphic representations or the industrial model or design or, as the case

may be, by specimens shall be filed with OSIM and form the *national legal deposit*. OSIM registers the application if minimum the following documents are filed: an application containing the request for registration of the industrial model or design, the applicant's identification data and the graphic representations of specimens, in one counterpart.

The national legal deposit gives to the applicant a *priority right*, beginning from the date of its establishment, towards any further deposit on the same industrial model or design. The invoking of priority can be made also as a result of the exhibiting of the industrial model or design in an international exhibition, if the application is filed within 6 months from the date of the introduction of the product in the exhibition. This period does not extend the priority term stipulated above.

The priorities stipulated are recognized if invoked concurrently to the filing of the application and if within 3 months from the date of the filing of the application are confirmed by priority acts.

### **3. Oppositions and complaints**

Within 3 months from the date of the publication of the industrial model or design the interested persons may file written oppositions to OSIM on its registration. The oppositions are settled by a specialized commission within 3 months from their filing with OSIM.

Decisions regarding the registration applications of the industrial model or design may be *challenged on the administrative way*, in writing and grounded, at OSIM, within 3 months from the communication. The grounded decision of the reexamination commission is communicated to the parties within 15 days from the pronouncement and may be challenged with appeal with the Bucharest Tribunal, administrative contentious department, within 3 months from the communication. The decision of the Bucharest Tribunal may be attacked with second-appeal with the Bucharest Court of Appeal, administrative contentious department, within 15 days from the communication.

### **4. Validity of the registration certificate**

The validity period of registration certificate of the industrial model or design is of 10 years from the date of the establishment of the legal deposit and may be renewed on 3 successive periods on 5 years. On the entire period of validity of the certificate, the holder is obliged to pay the fees for its maintenance effective.

## **5. Transfer of rights**

The right to the issuing of the registration certificate of the industrial model or design, the rights deriving from the registration application of the industrial model or design, as well as the rights arisen from the registration certificate issued are transferable in whole or partly. The transfer can be made by succession, by assignment or by licensing. The transfer is registered with OSIM and produces effects to third parties only from the date of the publication in the Official Gazette of industrial property of the mention of transfer.

## **6. Liabilities and sanctions**

The crimes in the field of industrial models and designs are stipulated by the Law no. 129/1992, republished, together with the procedure of establishment and sanctioning. We exemplify: “The appropriation without right, in any way, of the capacity of author of the industrial model or design is an offence and punishable with imprisonment from 6 months to 2 years of a fine from lei 15 million to lei 30 million.”

## **IV. TRADEMARKS**

In Romania, the trademarks protection is accomplished by registration with OSIM, according to the provisions of the Law no. 84/1998.

The trademark is a sign liable to graphic representation helping for the distinguishing of the products and services of a natural or legal person from those belonging to other persons. For the granting of protection, it is necessary of the trademarks to present a distinctive character and not to be contrary to public order and good morals.

**The following distinctive signs may be trademarks:** words, including names of persons, drawings, letters, figures, figurative elements, three-dimensional shapes and especially the form of the product or its package or combination of colors, as well as any combination thereon. The trademarks stipulated by the Art. 5 from the Law no. 84/1998 *are excluded* from protection.

### **1. Right to protection**

The right to protection of a trademark belongs to the natural or legal person who has first filed the protection application. The foreign natural or legal persons, with domicile or headquarter abroad, benefit from protection subject to conditions of the international conventions to which Romania is a party. A trademark may be registered on the name of many holders.

## **2. Trademarks registration procedure**

For the registration of a trademark a standard application is filed with OSIM, drawn up in Romanian language that shall have the content stipulated by Art.10 from the Law no. 84/1998. The application shall only refer to one trademark. Within one month from the date of the registration of the application, OSIM examines as to form the application and if the stipulated conditions are fulfilled, the national legal deposit of the trademark is established.

The interested persons may file an opposition with OSIM as to the registered trademark within three months from the publication date. If the registration decisions have remained final, the trademarks are registered with the Trademarks National Registry and OSIM, after the payment of the duly fees, issues the trademark registration certificate.

## **3. Duration of the registration**

The trademark registration produces effects from the date of the establishment of the national legal deposit for a period of 10 years. The trademark registration can be renewed once at each 10 years, with the payment of the fee stipulated by law.

## **4. Trademark rights**

- Trademark registration grants to the holder an exclusive right of exploitation.
- The trademark holder may claim to the competent court of law the prevention of third parties from using, in their economic activity, without his consent:
  - a) a sign identical to the trademark for products and services identical to those for which the trademark has been registered;
  - b) a sign which, given the identity or the resemblance with the trademark or given the identity or resemblance of the products or services to which the sign applies to the products or services for which the trademark has been registered, including the risk of associating the trademark with the sign;
  - c) a sign identical or resembling the trademark for products or services different from those for which the trademark is registered, when the latter has acquired a recognition in Romania and if, by using the sign, without good reasons, it could be taken advantage of the distinctive character or the reputation of trademark or the use of the sign would cause to the trademark holder a prejudice.

The applicant of the trademark registration application may request to be forbidden to third parties to perform the acts stipulated only after the trademark publication.

## **5. Transfer of the rights**

The rights on a trademark may be transferred by assignment or licensing, whenever during the period of trademark protection. The rights on the trademark are transmitted also in the case of the forced execution of the debtor holder of the trademark performed according to law.

Upon interested party's request and with the payment of the fee stipulated by law, the State Office for Patents and Trademarks registers the assignment/licensing in the Trademarks National Registry and publishes it in the Official Gazette of Industrial Property. The assignment/licensing become opposable to third parties, starting from the date of its registration with the Trademarks National Registry.

## **6. Crimes**

The crimes in the field of trademarks are stipulated by the Law no. 84/1998, together with the procedure of their establishing and sanctioning. We exemplify: the following are crimes:

- a) counterfeiting, imitating or using without any right of a trademark for the purpose of deceiving the public on the quality of the products or services to which the trademark refers to;
- b) putting in circulation, without any right, of a product bearing a trademark identical or similar to a registered trademark for identical or similar products and that damages the holder of the registered trademark. The criminal action begins upon injured party's prior complaint.

## **V. GEOGRAPHICAL INDICATIONS**

The geographical indications of the products are protected in Romania by their registration with OSIM, according to the provisions of the Law no. 84/1998. According to law, the geographical indication is the name helping to the identification of a product originating in a country, region or locality of a state, in the cases in which a quality, reputation or other decisive characteristics may be essentially attributed to this geographical origin.

### **Right to protection**



The registration of a geographical indication may only be requested by an association of producers carrying on production activities in the geographical area, for the products for which the registration of the geographical indications is requested.

A geographical indication registered on the name of an association may be also registered on the name of another association under the same conditions.

### **Granting of protection**

The applicant shall file with OSIM the registration application. If the application fulfills the requirements stipulated by law, OSIM decides upon the registration of the geographical indication in the Trademarks National Registry and the granting of the right to use it to its applicant.

## **VI. Layout-designs (topographies) of the integrated circuits**

In Romania the protection of integrated layout-designs is regulated by the Law no.16/1995. The layout-designs of integrated circuits are original creations situated at the intersection between invention and industrial design.

**The original layout-designs** are protected.

**Integrated circuit** – a product in its final form or an intermediate form, made up from an assembly of active or passive elements, including the interconnections which are integrally or partially part of the body or surface of a piece of material and which is intended to perform an electronic function.

### **1. Right to protection**

This right belongs to the creator or to his heirs in rights. These may be Romanian natural or legal persons as well as foreign natural persons having their domicile in Romania and foreign legal persons having branches or subsidiaries in Romania. If there are many creators, the rights belong to those ones jointly.

The right to protection may belong to another person than the creator; it the case of the layout-design created by an employee within his job duties when the right to protection shall belong to the unit in which the employee is employed, as well as the case of the layout-design made at the order of a natural or legal person, case in which the right to protection shall belong to these persons.

### **2. Layout-designs (topographies) registration**

The registration of a layout-design of an integrated circuit is conditioned by the establishment, with the State Office for Patents and

Trademarks of a **legal deposit of the registration application**. The official date of the legal deposit is the date of the granting of the application for protection. A registration application may have as subject-matter only one layout-design and a layout-design may only be registered once. The registration of the layout-designs is published in the Official Gazette of the State Office for Patents and Trademarks, within 2 months from the date of the issuing of the registration certificate.

### **3. Rights**

- a) The layout-design is protected on the Romanian territory for a period which begins from the official date of registration of the layout-design if it is anterior to the official registration date and ends in the last day of the tenth civil year following the year in which the protection period begins.
- b) The holder of a registered layout-design has, on the entire duration of protection, the right to exploit the layout-design as well as the right to allow or prohibit to other persons the exploitation of the layout-design.
- c) The holder has the right to mark the integrated circuits, made on the basis of the protected layout-design with the capital letter “T”.
- d) The creators of layout-designs have the right to have their names mentioned as well as their capacity of creator of the layout-designs in the registration certificate of the layout-design and in the publications made by the State Office for Patents and Trademarks regarding registered layout-designs.

### **4. Transfer of rights**

The right to protection and the rights deriving from the registration of a layout-design may be entirely or partially transferred, by assignment and by legal or testamentary successions.

The transfer of the rights stipulated produces effects to third parties starting from the date in which it is registered with the State Office for Patents and Trademarks.

**Compulsory licenses** are granted by Bucharest Tribunal in the cases and conditions stipulated by law.

Compulsory licenses are non-exclusive and can only be transferred together with the patrimony affected to their enforcement. Compulsory licenses granted are forwarded to the State Office for Patents and Trademarks that registers them in the Layout-designs National Registry.

The holder of the compulsory license owes to the holder a reasonable compensation.

## **5. Crimes**

Crimes in the field of layout-designs of integrated circuits are stipulated by the Law no.16/1995, together with the procedure of their establishing and sanctioning. We exemplify: “The breaching of the holder’s rights by exploitation, without his consent, of a registered layout-design, is the crime of counterfeiting or, as the case may be, of selling of counterfeit products.”

The criminal action begins upon injured party’s prior complaint.

For the damages caused to the holder, he is entitled to compensations, according to the common law, and the counterfeit products may be confiscated according to criminal law.