

# Finding your way

## A practical approach to trademark enforcement in Romania

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There are two main directions for defending trademarks rights in Romania, judicial and administrative, the two being complementary in certain cases as the administrative proceedings, such as oppositions and challenges of the Romanian State Office (OSIM) decisions are carried forward by means of appeals in Court.

### Litigations regarding infringement of trademarks in Romania?

Romania faced a spectacular growth of litigations over intellectual property rights in the last 10 years. Although in 1995 there were approximately 15 cases registered with the Bucharest Tribunal, in 2005 the number of “civil” cases

involving intellectual property pending before the Bucharest Tribunal reached 300, out of which a significant share involving trademarks.

While according to the Romanian legislation, counterfeiting a trademark is also considered as a crime, the trademark’s holder being able to re-establish his rights whether by means of a civil or a criminal action, it is recommended not to resort to the criminal proceedings except in certain particular cases. And why is that? In the case of criminal proceedings, the “main” damaged party is the state and therefore, after submitting the criminal complaint, the investigation and criminal prosecution are performed by state institutions, the holder having a limited, if at all possibility of

It is worthy of note that starting with 2004 the Bucharest Tribunal had the exclusive jurisdiction to judge all cases involving intellectual property, while the decisions could have been appealed with the Bucharest Court of Appeal. Having specialised panels of judges, the exclusive jurisdiction brought along concrete positive results, both in terms of “speed” of proceedings as well as the final decision.

However, like in the case of good things happening, the judicial organisation law was altered in July 2005. The Bucharest Tribunal lost its exclusive jurisdiction at least in respect of litigations on infringement and counterfeiting which now belongs either to the Tribunal where the defendant has its registered office or to the one within the area where the infringing acts are committed.

Considering the almost remarkable achievements at the level of the Bucharest Tribunal, including the specific expertise of its judges handling trademark matters, we strongly recommend to investigate, before filling the request whether the infringement acts took place in Bucharest as well and to the extent of an affirmative discovery, to file the request with the Bucharest Tribunal.

### Are you ready for the big fight? You better prepare your strategy

As always, everybody is advising you to work on a strategy prior to submitting the request for legal proceedings and in doing so, you should make sure you understand and agree on the end result you are looking to achieve. In addition to that, when initiating legal proceedings in Romania, you should ALWAYS consider the related risks and play the “devil’s advocate”. Out of a considerably long experience, what will happen when initiating a lawsuit will bring together a bunch of related cancellation requests, revocation requests (e.g. for non-use or for descriptiveness of your trademark), counter claims, criminal complaints and the story will go on, all in all to determine you to settle on terms even less favourable than those when you started the legal proceedings.

The bottom-line is that when working on your strategy you should ensure that you have “strong” trademark(s) and that you have clear evidence regarding the consistent use of your trademarks in Romania.

### Interim measures – now we are talking language that we like!

Pursuant to the Trademarks Law as well as the Romanian Code of Civil Procedure, in cases of trademarks infringements, the holder has the option to request for an interlocutory injunction by which it will seek immediate cease of the infringing acts (for example the cease of sale or distribution of a certain product or use of a certain name or sign).

controlling or intervening in these procedures. Out of experience, a criminal case will not be completely finalised earlier than three to four years.

### And where should I file the request for legal proceedings?

The “first instance” jurisdiction belongs to Tribunals, one in each main city of Romania. The Court of Appeal having jurisdiction over the case will hear any appeal against the decisions passed by the Tribunals. While any second appeal (based on legal grounds only as opposed to factual grounds will be heard by the High Court of Cassation and Justice, the highest court in Romania.



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In practice, such requests have become commonly used nowadays when time is of the essence in almost all infringement cases. Not to mention the possibility – and it’s not just a possibility - to obtain it within *ex parte* proceedings. When requesting the interim measure, the holder would need to evidence the urgency of the measure, the fact that a decision can be taken by the judge without entering into the merits of the case and that the measure requested through the injunction is an interim one.

As a practical advice, when requesting the interim measure you should file, simultaneously the request for the permanent injunction as this will provide the judge with sufficient arguments in your favour as well as will indicate you are not trying to obtain a permanent measure via an interim proceedings.

### Evidence! What evidence?

When preparing your written evidence, affidavits and other statements, you will obviously include copies, photographs or other reproductions (coloured one if the case) of the trademarks/products at stake so that the judge is able to actually understand the practical issue on which a decision has to be taken.

Market researches, market surveys and other similar studies are useful tools in supporting your claims; however they are not commonly ordered by the Court. In the event you would still like to use a market survey one way would be to commission it and then present it as written evidence. Even if it will be considered as *pro parte*, together with all other written evidence, it could still benefit your cause, as the judge is required to review all evidence submitted to the respective case. We are nevertheless confident that market researches, market surveys will more and more be approved and commissioned by the Court, at both parties’ expenses.

There was a time when the Courts appointed “technical” experts (that is experts in intellectual property being registered with a special authority of technical experts) in order to perform expert opinions on the matters under review. This was a bit unfortunate as such opinions were done “at the desk” and they were in most of the cases required to give their opinion on

legal issues, rather than technical, in which a judge is presumed not have sufficient skills. Using an example, the notoriety of a trademark or the degree of similarity of a sign compared to a previous trademark are legal issues on which the judge should render a decision and not technical ones that should be answered by an expert.

In addition, the practice has showed not only that the expert would give its opinion on legal issues but also they have done it for a price amounting from EUR 800 to EUR 10,000, which is seen as a considerable cost for such litigation in Romania. Not to mention that such an opinion would easily delay the hearings with at least 6 to 8 months as once the opinion is submitted by the expert the parties may raise objections on which the expert is required to answer. You don’t want to end up in such a situation as a plaintiff.

### When shall I ask for damages?

Based on the infringement of its trademark, the holder has the right to request the Court the granting of damages to be paid by the other party consisting of all costs incurred with the legal proceedings as well as damages for the unlawful use of the trademark, generally calculated in consideration of the profit obtained by the defendant through the infringing acts. It is essential to evidence the damages, as the Romanian Courts are somehow reluctant to grant damages without strong evidence of their existence.

However, you should know that whenever the holder is requesting for damages, he should pay a Court fee, calculated as a percentage of the amount of damages. In addition, in the event the holder will request the damages within the main legal proceedings, there is always a risk not to obtain a favourable decision from the Court on the infringement itself. It is therefore recommended to initiate the legal proceedings and obtain a favourable decision against the infringer and only then to request the damages via a separate lawsuit. At that moment, the holder would have a favourable decision already and need only to evidence the amount of damages. ■