
THE
INTELLECTUAL
PROPERTY
REVIEW

FIFTH EDITION

EDITOR
ROBERT L BAECHTOLD

LAW BUSINESS RESEARCH

THE INTELLECTUAL PROPERTY REVIEW

The Intellectual Property Review
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EDITOR'S PREFACE

It is not an overstatement to say that essentially all business is global, and the protection of intellectual property is the lifeblood of all business. The scope and implementation of that protection, however, varies from country to country.

It would be ideal if there was one universal set of laws, rules and procedures. But, while the efforts of many dedicated individuals have accomplished much in harmonising intellectual property protection, we remain defined as much by our differences as by what we have in common. It is therefore incumbent on all of us, as advisers to our clients, to be conversant with the individual practices in each of the economically significant countries.

The goal of this review is to provide that guidance. We have assembled a body of leading practitioners to explain the opportunities for intellectual property protection in their respective jurisdictions, together with the most significant recent developments and any aspects that are unique to their country. The authors of each chapter will provide an overview of the intellectual property rights available and highlight the notable developments in their respective countries. While we have striven to make the book both accurate and comprehensive, we must note that it is necessarily a summary and overview, and we strongly recommend that the reader seek the advice of experienced advisers for application of the principles contained in this review to any specific matter.

This review is a testament to the flux of intellectual property law worldwide. We first published this review in 2011, with chapters from 24 countries. This fifth edition now includes chapters from 30 countries, a clear indication of the truly global reach of intellectual property law and the need to remain current for our clients worldwide. Since the first edition, we have observed the dramatic overhaul of the patent system in the United States with the implementation of the American Invents Act. In Europe, we have seen the near completion of the Unified Patent Court. It is our hope that the reader will find this a useful compilation and often-consulted guide.

Robert L Baechtold

Fitzpatrick, Cella, Harper & Scinto

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May 2016

Chapter 22

ROMANIA

Ciprian Dragomir, Bogdan Halcu and Dana Blaer¹

I FORMS OF INTELLECTUAL PROPERTY PROTECTION

Romania has not codified the legal resources in this field; therefore, intellectual property rights are protected in this jurisdiction by various legal enactments applying specifically to each category of IP rights:

- a* inventions – governed by Law No. 64/1991 on patents for inventions (the Patent Law);
- b* utility models – governed by Law No. 350/2007 on utility models (Law No. 350/2007);
- c* trademarks and geographical indications – governed by Law No. 84/1998 on trademarks and geographical indications (the Trademark Law);
- d* industrial designs – governed by Law No. 129/1992 on protection of designs and models (the Industrial Design Law);
- e* topographies of semiconductor products – governed by Law No. 16/1995 on protection of topography of semiconductor products; and
- f* copyright – governed by Law No. 8/1996 on protection of copyright (the Copyright Law).

The Romanian legal framework on IP rights has been gradually harmonised with the corresponding European legislation (relevant EU Directives and EU Regulations) and, generally, with the principles provided in international treaties and conventions.

The most important EU Regulations that are directly applicable in Romania are the following:

- a* Council Regulation (EC) No. 207/2009 on the European Union trade mark (CTMR) (EU trademark); and
- b* Council Regulation (EC) No. 6/2002 on Community Designs.

¹ Ciprian Dragomir is a partner, Bogdan Halcu is a managing associate and Dana Blaer is a senior associate at Țuca Zbârcea & Asociații.

Romania is a party to the main international treaties and conventions on intellectual property.

Various acts of unfair competition are regulated under Law No. 11/1991 on fighting unfair competition; this piece of legislation incorporates clauses on unfair use of trade names, trade secrets, packaging materials and other proprietary assets.

II RECENT DEVELOPMENTS

An interesting decision of the European Court of Justice (ECJ) from February 2013 (case No. C – 561/11) raised scholarly discussions as to the admissibility by Romanian courts of counterfeit claims filed by the owner of a trademark against the owner of a confusingly similar later trademark, as long as this later trademark is not annulled. It should be noted that the provisions of the Romanian Trademark Law are similar to those of the CTMR – registration of a trademark confers its owner an exclusive right over that trademark.

The European Court of Justice stated that counterfeit claims may be brought without a prior decision for invalidation of the later trademark being required.

In disputes involving national trademarks, the Romanian courts, however, usually dismiss counterfeit claims filed by the owner of a trademark against the owner of a confusingly similar later trademark, as long as this later trademark is not annulled. Consequently, according to national practice, registration of a trademark not only gives a right to use that trademark, but such right is protected until there is a court decision invalidating that trademark.

The decision of the ECJ may generate a reorientation of Romanian jurisprudence, although there are some scholars' opinions that the Romanian practice related to disputes involving national trademarks should not change, since the defendant may file simultaneously and at the same court of law both a claim for invalidity and a claim for counterfeit.

III OBTAINING PROTECTION

i General information

The Romanian public authorities invested with competence in the protection of intellectual property rights are:

- a* the State Office for Inventions and Trademarks (OSIM), in relation to industrial property (i.e., inventions, trademarks, geographic indications, industrial designs, integrated circuits); and
- b* the Romanian Office for Copyright, relevant for copyright-protected works.

Patents for inventions

The right to patent belongs to the inventor or to his or her rightful successor. For inventor-employees, the right to patent belongs to the employer whenever the relevant inventions are made by the employee under a labour agreement that expressly provides that inventions are within the employee's specific duties. For inventions made with the use of the employer's experience, information or resources, the right to obtain the patent is vested in the employee, but the employer has the possibility to claim the rights over those inventions in return for fair compensation paid to the inventor-employee.

In order to obtain protection at national level, applications for patents are submitted to the OSIM. The invention shall be disclosed in the description, drawings and claims in a manner that is clear and complete as well as scientifically and technically correct.

The applicant may invoke priority rights. Published patent applications benefit from provisional protection until the patent is issued.

Patentability conditions are harmonised with international regulations. An invention (for a product or a procedure in any technological field) is patentable in Romania if it is new worldwide, involves an inventive step (i.e., it does not follow evidently for a trained individual from the knowledge incorporated in the existing technical development stage) and is susceptible to industrial application.

Biotechnology inventions are patentable only under certain conditions (e.g., if they refer to a biological material that is separated from the natural environment or produced by any technical procedure, to a microbiological procedure or another technical procedure or a product, other than a species of plants or animals, obtained by this procedure, to an element of the human body that is separated or otherwise produced by a technical procedure).

The following are not considered inventions: discoveries, scientific theories and mathematical methods; aesthetic works; plans, principles and methods to exercise mental activities, in games or economic activities, and software; and presentations of information. Such provisions exclude the patentability only when the patent application or the patent itself refers to the objects and activities *per se*. For instance, the software may be patentable should it be integrated into a patentable object.

Furthermore, no patent is granted for:

- a* the inventions the commercial exploitation of which is contrary to public policy or good morals;
- b* species of plants and animals, and procedures that are essentially biological for obtaining plants or animals; the provision does not apply to microbiological procedures and the products obtained by these procedures;
- c* inventions concerning the human body at various stages of forming and development, and the mere discovery of one of its elements; and
- d* methods for the treatment of the human or animal body, by surgery or therapy, and methods of diagnosis on the human or animal body; such provision is not applicable to products, especially substances or compounds to be used in any of these methods.

The patent enjoying protection on the territory of Romania is valid for 20 years from the date the regular national application is filed and is subject to annual fees for maintenance.

Any product protected by a patent in the territory of a Member State and subject, prior to being placed on the market as a medicinal or plant protection product, to an administrative authorisation procedure, may, under the terms and conditions provided for in EEC Regulation No. 1768/92 concerning the creation of a supplementary protection certificate for medicinal products and Regulation (EC) No. 1610/96 concerning the creation of a supplementary protection certificate for plant protection products, be the subject of a supplementary protection certificate. The duration of the certificate may not exceed five years from the date on which it takes effect.

Protection for inventions may also be obtained at European level, in which case the applications for patent may be submitted either directly to the European Patent Office or via OSIM, and at international level, in which case an international application may be filed with a national office (OSIM), regional patent office (the European Patent Office) or WIPO, complying with the Patent Cooperation Treaty formality requirements.

Utility models

The protection of utility models is mainly regulated in Romania by Law No. 350/2007, concerned with such technical inventions that cannot be protected by patent according to the Patent Law as they do not involve inventive activity.

Utility models refer to any technical inventions provided that they are new (they are not already included in the current development stage of the technique), that they exceed the level of mere professional skill, and that they are applicable in the industrial field.

The items that may not be regarded as inventions so as to obtain protection as utility models are the same with those regulated under the Patent Law.

Further, the following may not be protected as utility models:

- a* the inventions the commercial exploitation of which is contrary to public policy or good morals;
- b* species of plants and animals;
- c* inventions concerning biological material;
- d* inventions concerning a product consisting in a chemical or pharmaceutical substance; and
- e* inventions concerning a procedure or a method.

The right to the utility model belongs to the inventor or his or her rightful successor.

The duration of the protection of the utility model is six years, available for extension by successive two-year periods, and may not, extensions included, exceed the maximum of 10 years.

Utility models acquire protection by registration with the OSIM. For international registration, international applications may be filed with foreign receiving offices and may indicate Romania as a designated country. Failure to open the national phase renders the application ineffective in Romania. The requests for international registration may also be filed with the OSIM, as receiving office.

Applicants at the OSIM may re-qualify their request from patent to utility model and, conversely, from utility model to patent, without thereby causing the examination procedure to be automatically closed. Requalifications are only admitted once and are not available for international requests where the national phase has already commenced.

Trademarks and geographical indications

In order to be registered, a trademark must not be identical or confusingly similar to a previous trademark belonging to a different owner and registered for identical or similar products or services.

Whenever the previous trademarks are notorious (either in Romania or in the European Union), the risk of confusion is analysed even if the new trademark is for products or services that are not identical or similar, if registration risks causing damage to the notorious trademark. The applicant may invoke priority rights.

Further to the amendment to the Trademark Law (in 2010), the concept of Community exhaustion of trademarks was statutorily recognised. According to this concept, the first sale of a trademark-protected product within the European Economic Area by the owner, or with the owner's consent, exhausts the trademark rights over these given products not only domestically, but also within the whole European Economic Area.

National trademarks are protected for 10 years counting from the date the application for registration has been filed. It may be further extended for additional periods of 10 years without any overall limitation.

The rights granted to a proprietor by a trademark may be revoked anytime owing to non-use of such trademark, in case when, for unjustified reasons, the respective trademark has not been effectively used on the territory of Romania for a period of five successive years (as of the registration of such trademark) or if the use of the trademark has been suspended for a period of five successive years.

The exclusive rights to use a trademark in Romania are granted by registration with OSIM, either directly or by way of an international (WIPO) application based on the Madrid System.

A European Union trademark offers protection for all EU Member States in one single registration, made with OHIM. This mechanism operates *ipso jure*, without the need for the holder to fulfil any formalities or procedures with OSIM. A potential conflict with a domestic trademark shall be solved based on the priority rules.

The holder of a national trademark previously registered in good faith is allowed to oppose the use of the EU trademark only on Romanian territory.

However, since the automatic extension of protection is not reciprocal (i.e., national trademarks do not automatically benefit from protection in the Member States) holders of national trademarks cannot substantiate, at EU level, a motion to annul or to obtain withdrawal of rights for lack of use against the owner of a subsequently registered EU trademark.

Trademark Law also regulates the legal regime of the geographical indications defined as words designating a product originated in a country, region or locality of a state, when a certain quality, reputation or other significant characteristics may be essentially attributed to the geographical origin of that product.

The geographical indications are protected in Romanian through registration with OSIM and may be used only by those producing or commercialising the products for which such indications are registered. Only manufacturers' associations performing a manufacturing activity in the relevant geographical area may apply for geographical indications (for products included in the respective application).

The geographical indications are also protected in Romania under Regulation (EU) No. 2012/1151 on quality schemes for agricultural products and foodstuffs, Regulation (EC) No. 2008/110 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and Regulation (EC) No. 2007/1234 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products, all such regulations being directly applicable in Romania.

The protection of a geographical indication is unlimited as of the date the application for registration has been filed with OSIM. The right to use a geographical indication is granted to the applicant for a 10-year period, and it may be further extended without any overall limitation should the conditions under which such right was granted remain unchanged.

Industrial designs

Based on the provisions of the Industrial Design Law, the new external appearance of a product in two or three dimensions having a practical function may be registered as industrial design.

Novelty and distinctive character are the registration conditions for an industrial design. A form is novel if it is practically unknown in the territory of Romania, and has not been disclosed for the same category of goods in Romania or abroad.

The industrial design the appearance of which is determined by a technical function may not be registered.

Several industrial designs may be submitted for registration in the same application, in a multiple deposit comprising industrial designs intended to be incorporated in articles of the same category of goods as per the Locarno Agreement classification.

The industrial design is valid for 10 years from constituting the national deposit and may be renewed for three successive five-year periods upon payment of the legal fees.

Protection for industrial design may be obtained at national level, in which case the application is filed with the OSIM, at European level, in which case the application is filed with the OHIM, and at international level, in which case an international application is filed with WIPO, complying with the requirements of the Hague System for the International Registration of Industrial Designs.

According to the rules applicable following accession, EU designs automatically enjoy protection on the Romanian territory. This mechanism operates *ipso jure*, without the need for the holder to fulfil any formalities or procedures with the OSIM.

Topographies of semiconductor products

By topography of a semiconductor product it is understood a series of interconnected images, no matter how they are fixed or encrypted, representing the three-dimensional configuration of the layers of which a semiconductor product consists and where each image reproduces the design or a part of the design of a surface of the semiconductor product, at any stage of its production.

Only original topographies are protected.

The owner of a registered topography has, throughout the entire term of protection, the exclusive right to exploit the topography and the exclusive right to authorise or prohibit the following acts:

- a* reproduction of such topography, to the extent that it is protected as per the aforementioned requirements; and
- b* commercial exploitation or import to this effect of a topography or semiconductor product manufactured by using such topography.

Exclusive rights expire 10 years after the first commercial exploitation anywhere in the world or 10 years after the registration was filed with the competent authority, whichever occurs first.

If a topography was not commercially exploited for 15 years as of the date when it was created or encrypted for the first time, the protection right will cease after expiry of this term.

The topographies of semiconductor products are protected in Romanian through the registration with OSIM.

Copyright

All literary, artistic or scientific works, as well as other intellectual creation works, (such as architectural works located on the Romanian territory, artists' interpretations or performances taking place on the Romanian territory, artists' interpretations or performances that are fixed in sound recordings protected by the Copyright Law, or, if not fixed in sound recordings,

are transmitted by television or radio broadcastings protected under the Copyright Law, sound or video recordings produced by natural or legal persons residing in Romania, radio or television programmes broadcast or transmitted by entities headquartered in Romania) benefit from protection under the Copyright Law (without registration or any other formality being required), provided that they are original, take a concrete form of expression, and are susceptible of being made known to the public.

Non-residents, individuals or legal entities, benefit from copyright protection as per the terms of the international treaties Romania is a party to or, absent such treaties, under the same terms as Romanian residents, on a reciprocity basis.

The Romanian copyrights last for the lifetime of the author plus another 70 years after their death, being transmitted to lawful successors, irrespective of the date when the work was brought to public knowledge. The same applies to software works.

As a general rule, protection for artists' interpretations or performances is valid 50 years from the date of such interpretation or performance.

The concept of 'orphan work', which applies to all types of intellectual creations in the literary, artistic or scientific field, was recently introduced by the Copyright Law. Orphan work refers to intellectual creative work in relation to which the rightholder has not been identified or located, although a diligent search has been carried out and the entity conducting the search maintained records of said diligent searches. The orphan work status does not apply to anonymous works or to works created under a pseudonym. Orphan works that have been considered as such in another Member State shall be considered as having the same status in the territory of Romania.

The publicly accessible libraries, educational establishments, museums, archives, film or audio heritage institutions and public-service broadcasting organisations are entitled, under the law, to use the orphan works, provided that such use is exclusively intended for the purpose of achieving aims related to their public-interest mission.

Copyright is classified in moral rights and economic or patrimonial rights. While moral rights (e.g., the right to decide whether and how the work is going to be published; the right to decide the name under which the work shall be published, etc.) may not be transferred by the author, economic rights may be assigned to third parties by way of copyright licensing.

For agreements for creation of future works, in the absence of a clause to the contrary, the economic rights belong to the author. In the absence of a contractual clause to the contrary, for the works created by employees while fulfilling their professional duties under an individual labour agreement, the patrimonial rights belong to the author (except for the case of software when the patrimonial rights over such programmes belong to the employer).

Conversely, contractual clauses may provide that, for works created for the fulfilment of professional duties stipulated in the individual labour agreement, the patrimonial rights do not belong to the author of the work.

The holders of copyrights and related rights may exercise their legal rights individually or, based on a mandate, through collective management bodies.

Collective management is mandatory for certain rights (i.e., the right to compensatory remuneration for the private copy; the right to a fair remuneration for public loan in certain cases; the right of resale (*droit de suite*); the right of broadcasting for musical works; the right of public release of musical works, except for the public screening of cinematographic works; the right to fair remuneration acknowledged to performing artists and producers of phonograms for public communication and broadcasting of trade phonograms or the reproduction thereof; the right to cable retransmission), for which the collective management

bodies also represent holders of rights that did not grant them a mandate, and is optional for other rights (i.e., the right to reproduce musical works on phonograms or videograms; the right to publicly communicate works, except for musical works and artistic performances in the audiovisual sector; the right of loan, except for certain cases provided by law; the right to radio broadcast the works and artistic performances in the audiovisual sector; the right to fair remuneration resulting from the assignment of lease rights; the right to fair remuneration acknowledged to performing artists and producers of phonograms for public communication and radio broadcasting of phonograms published for commercial purposes or the reproduction thereof).

IV ENFORCEMENT OF RIGHTS

i Possible venues for enforcement

As a matter of principle, enforcement of IP rights may be sought at three different levels: administrative, civil and criminal.

Administrative proceedings are brought with the OSIM, which is competent to solve oppositions and observations filed by third parties against filings made by applicants seeking registration of their IP rights. Apart from that, holders of IP rights may file an application for intervention of customs authorities, in which case customs will seize any goods that are suspected of infringing IP rights.

In addition to regular litigations involving contracts relating to the exploitation of IP rights, civil courts may be called to issue decisions on challenges filed against decisions of the OSIM, as well as on invalidity claims or, as the case may be, on counterfeit or unlawful competition cases.

The national legislation in intellectual property incriminates a series of counterfeit and piracy acts infringing industrial property rights or copyright.

In principle, there are really no statutory limitations in selecting a specific procedural way to seek enforcement of IP rights, so a decision on whether a criminal claim should be filed or on whether a civil or administrative claim would be enough has to be made on a case-by-case basis. However, it must be taken into account that in practice owing to specialisation of magistrates, sometimes criminal courts find it more difficult to overcome the specific barriers in the field of assessment of damages, while civil courts are more familiar with the specifics of the legislation, especially with the provisions of the Enforcement Directive 2004/48/EC.

ii Requirements for jurisdiction and venue

In administrative proceedings before OSIM, any person may oppose a filing made for registration of IP rights. A conceptual differentiation is made, however, in the field of trademarks. While any person may file observations seeking rejection of the registration filing for public reasons, opposition is reserved to individuals or companies who can actually prove an earlier right that is infringed by the opposed application.

Civil claims brought in court usually follow the normal course of any civil trial. As a matter of principle, lawsuits in civil proceedings must be filed before the court of domicile or seat of the defendant, but there are exceptions that may allow the defendant to file the claim elsewhere (e.g., a claim for invalidity of a patent or of a trademark must be filed before the Tribunal of Bucharest).

Criminal proceedings are in most of the cases initiated by the criminal investigation bodies (prosecutor's office or police), further to a claim made by the holder of an IP right, a claim filed by the customs office or even *ex officio*, as may be the case when the border police discovers shipments of counterfeit or pirated products.

Declaratory judgments are recognised in Romania; however, a motion for a declaratory judgment, seeking judicial recognition of a specific right will always be dismissed to the extent the claimant has the possibility to file a claim for enforcement of that right.

iii Obtaining relevant evidence of infringement and discovery

Rules governing the procedural means available to produce evidence in IP-related matters are no different from the general rules. What might be interesting though is that unless they are challenged by the other party, in trademark infringement cases, courts usually accept reports made by the right holder of the relevant trademarks, although they are not endorsed by a judicial expert appointed by the court.

iv Trial decision-maker

Civil trials are usually handled by specially trained judges. However, judges handling criminal claims on counterfeit or piracy do not have specialisation in IP matters. Whenever considered necessary, both civil and criminal courts, as well as criminal investigation bodies may appoint experts to issue a technical opinion on specific matters raised by the court or by the criminal investigation body.

Usually, both civil and criminal trials are decided by one judge, whereas appeals are decided by a panel of two judges. Where a cassation appeal is available, this is decided by a panel of three judges.

v Structure of the trial

IP cases are subject to the same procedural rules as other cases. As a matter of principle, in civil cases, the burden of proof lies with the claimant, while in criminal cases the burden of proof lies with the accusation.

Civil cases are opened further to the defendant filing a claim. Having received the claim, the judge has the possibility to ask the defendant to complete the claim with any missing data. The court will send the defendant a copy of the claim, along with relevant documents already filed by the claimant; having received the claim, the defendant must file a statement of defence within the next 25 days following receipt of the claim. The statement of defence will be sent by the court to the claimant, who has the possibility to lodge a reply within the next 10 days following receipt of the statement of defence. Within the next three days following receipt of the defendant's reply, the judge must issue a resolution scheduling the first hearing, on a date that should not be more than 60 days after the date of the resolution.

Criminal cases are initially handled by the criminal investigation bodies. After the investigation is finished, the prosecutor will send the file to court, where the judge will make a preliminary assessment on the legality of the evidence proposed by the prosecutor. This preliminary procedure must not take more than 60 days. After this check is done, the judge will schedule the first hearing.

There are no limitations as to the evidence to be brought in IP-related court cases. The judge may choose to hear witnesses and experts and to examine documents, photos, wiretapped discussions (in criminal proceedings), or even check specific facts or data outside the premises of the court.

vi Infringement

Infringement in patent cases (including utility models) may be committed through making, using, offering, putting on the market, or importing infringing products for such purposes, or, as the case may be, to using a specific patented process.

In design cases, the holder may prevent use of the product in which the design is incorporated or to which it is applied. In trademark cases, illicit use covers reproduction of a trademark, as well as commercial detention, offering, sale, import, export or transit of goods which bear the counterfeit trademark (or a sign that is confusingly similar to the protected trademark).

vii Defences

There are various defences that may be brought in IP-related cases.

The defendant in an infringing litigation may explore the possibility of challenging the statutory protection claimed by the plaintiff. In patent litigation, the defendant may try to challenge the novelty of the patent, as well as the non-obviousness. While the novelty of the patent may be easier to challenge, if the defendant succeeds in proving an earlier document evidencing that the patent was known before the moment when patent filing was made, obviousness of a patent is more difficult to advocate and in most situations the courts rely on the opinion of a technical expert.

Lack of novelty may be brought as a defence in cases of infringement of utility models and designs as well. For designs, the defendant may try to block the claim alleging that the same is based on functional elements of the design, which may not be subject to protection.

In trademarks cases, as well as in design cases, exhaustion of right is a commonly used defence where the holder of a trademark tries to ban sales of specific products by entities that were not authorised by the right holder. At the same time, acquiescence and fair use of a registered trademark (e.g., to designate the destination of spare parts) are defences that may be brought successfully against a claim for counterfeit.

In copyright cases, the span of available defences is quite broad, depending on the nature of the relevant protected work and on the details of the alleged illicit use. Some of the most commonly used defences may be: mandatory collective management of copyright, private copy (less for software) or fair reproduction (in case of quotations from written works).

viii Time to first-level decision

The time to a first-level decision can vary greatly, depending on the details of the case. In general lines, a civil claim would be judged within one to two years, but the period may be longer if the court orders an expert report.

In criminal files, an overall time limit is difficult to provide, as it depends on the details of the case, but it may be reasonably anticipated that for a case that would not be too complex in terms of persons involved or operations investigated, court proceedings before the first court should be finalised within one to two years as of the start of the criminal investigation.

ix Remedies

In the pretrial phase, the right holder may seek provisional injunction relief, as well as securing of evidence. When granting these remedies, the court will indicate a specific deadline within which the claimant must file the claim on the merits. Should the claimant fail to file this claim, then the provisional remedies ordered in the pretrial proceeding cease to be binding.

Aside from the above, the claimant may ask the court to order final injunction, reparatory material and moral damages, destruction of counterfeit or pirated goods and publication of the court's decision.

Damages are calculated based on the general principles laid down in the Enforcement Directive 2004/48/EC and the court may order surrender of profits or payment of a fixed fee, which may be calculated by reference to the licence fees usually used in the course of trade. In copyright infringement cases, if the actual amount of damages cannot be calculated, the claimant may ask for damages calculated as three times the licensing fees that the claimant could have requested for the relevant use.

However, while civil courts are more familiar with the criteria in the Enforcement Directive 2004/48/EC, criminal courts are more reluctant in applying these principles.

x Appellate review

The decisions of the OSIM may be challenged in court, in which case the court will make a thorough assessment of the file.

Appeals against decisions of the first court are judged by a panel of two judges. As a matter of principle, there is no limitation as to the reasons one may ground an appeal on; also, new evidence may be brought in appeal. Although this is not always available, in some situations a cassation appeal may be filed against the decision issued in appeal.

In criminal files, decisions of the first court are subject to appeal at the Courts of Appeal. A cassation appeal is available at the High Court of Cassation and Justice, but for very limited situations.

xi Alternatives to litigation

As a matter of principle, arbitration may be used as an alternative to litigation under the Civil Procedure Code. However, the possibility to arbitrate an IP case is somewhat limited, since arbitration may not deal, for instance, with issues related to invalidity of IP rights.

However, WIPO arbitration is extensively used in domain name dispute resolution.

V TRENDS AND OUTLOOK

In Romania, in recent years, there has been significantly more awareness about protection of IP rights and this is reflected in the increasing number of applications for protection. The increase of patent and trademarks filings is expected to generate an increased demand for professional services in the field of IP rights.

Appendix 1

ABOUT THE AUTHORS

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Ciprian Dragomir is a partner at Țuca Zbârcea & Asociații and heads the firm's IP and personal data protection practice groups. For the past 17 years he has advised an impressive roster of clients on all legal matters associated with the protection of their IP rights, including copyright, trademarks, design rights and patents. He also focuses on IP-related transactional work, such as licensing and major IP due diligence issues. In particular, he is highly reputed for advising on anti-counterfeiting issues – including product counterfeiting, product contraband and illegal use of trademarks – especially in mass-market industries such as cigarettes, beverages, food and clothing. His expertise covers data protection, consumer protection, unfair competition and misleading advertising. Mr Dragomir is a certified IP counsellor and a member of the International Trademark Association, World Customs Organization and the European Communities' Trade Mark Association. As well as being a partner at Țuca Zbârcea & Asociații, Mr Dragomir coordinates Țuca Zbârcea & Asociații IP, the firm's specialised IP practice division, which comprises lawyers and certified IP counsellors.

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Bogdan Halcu is a managing associate at Țuca Zbârcea & Asociații, having practised law for the past 12 years. He covers trademark registration and licensing, European Union trademark regulations, software copyright, trademarks enforcement and counterfeiting claims, including criminal prosecution for counterfeiting and unlawful competition. In addition, Mr Halcu offers legal advice on data protection issues related to intellectual property rights, as well as on data protection, franchise and know-how issues. He is a member of the International Trademark Association.

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Dana Blaer is senior associate at Țuca Zbârcea & Asociații, specialising in intellectual property, corporate and commercial, as well as mergers and acquisitions. She has practised law for the past 11 years, and regularly assists clients from a variety of industry sectors as regards the protection of technology and intellectual property rights as part of mergers and acquisitions, franchising, financings, joint ventures and divestitures etc.

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