

CMS | Romanian trade marks can be cancelled by the OSIM



As of 14 January 2023, requests can be made with the Romanian State Office for Inventions and Trade Marks (OSIM) to cancel trade marks by using an administrative-jurisdictional procedure.

According to Romania's recently updated Trade Marks Law (Law no. 84/1998 on Trade Marks and Geographical Indications), the invalidation and revocation of a trade mark may be requested either by judicial proceedings before the Bucharest Tribunal or by administrative-jurisdictional proceedings, before the OSIM.

The possibility to file a cancellation claim before the OSIM has been newly introduced in Romanian legislation, following the transposition of the Directive (EU) 2015/2436 relating to trade marks (recast), which obliges EU member states to implement an administrative procedure for the revocation or invalidation of trade-mark rights.

The administrative-jurisdictional procedure for cancellation of trade marks has been further developed by Government Emergency Ordinance no. 169/2022, which amends and supplements the Trade Marks Law, and entered into force on 13 December 2022.

The Trade Marks Law, as amended and supplemented, provides that:

- ◆ The administrative proceedings for cancellation are optional. In other words, these proceedings cannot prevent interested persons from filing a claim directly with the competent court.
- ◆ The claim is assigned to a specialised Board within the OSIM, whose members are only responsible for resolving claims for cancellation, without being involved in any other procedure on trade marks carried out by the OSIM and without interfering with the activity of the Board of Appeals within the OSIM.
- ◆ OSIM decisions rendered in cancellation proceedings can be appealed within 30 days of the communication before the Bucharest Tribunal. The decision of the Bucharest Tribunal is only subject to appeal before the Bucharest Court of Appeals.

The Trade Marks Law defines the course of a cancellation claim within the administrative-jurisdictional proceedings before the OSIM, which can be summarised as follows:

→ The cancellation claim is filed with the OSIM. The Trade Marks Law sets down the information required for the cancellation claim. The claim should be drafted in the Romanian language and include the grounds for cancellation and the supporting evidence.

- Within five days of the registration of the claim, the secretary of the Board will check whether the claim contains all relevant information and observes the formal requirements provided by the law. The secretary will then forward the claim to the "rapporteur", who is one of the members of the Board.
- If the claim is irregular, the claimant will be notified and will be given five days to remedy the irregularities. If the irregularities persist, the Board will reject the claim without summoning the parties.
- If the claim is compliant, it will be served to the respondent who should reply within 30 days of the communication.
- The reply of the respondent will be served to the claimant who can file a standpoint within ten days of the communication.
- The parties will be summoned for a public hearing. The hearing can be secret if the public debate could damage one of the parties or public order.
- Upon the reasoned request of the parties or where the hearing reveals a need for the filing of supplementary evidence, the hearing can be adjourned until later.
- At the end of the debates, the Board will deliberate in secret on the decision to be taken. If the Board finds that further information or documents are required, it may reopen the case by setting a new hearing and summoning the parties.
- In terms of a decision, the Board can:
 - admit the claim in whole or in part, ordering the invalidation of the trade mark or the revocation of the rights conferred by the trade mark in whole or in part, as the case may be;
 - reject the claim;
 - take note of the withdrawal of the claim;
 - take note of the settlement reached between the parties;
 - declare the claim to be no longer admissible if it remained unprocessed for six months for reasons attributable to the claimant.

The Board cannot rule on the legality of civil acts based on an invalidated trade mark and on the civil effects arising from it. In this case, the matter should be referred to the competent court.

For more information on the Trade Marks Law and on other intellectual property issues affecting your Romania-based business, contact your CMS client partner or CMS experts: **Cristina Popescu** and **Carmen Turcu**

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