

## Romanian PTO Issues New Instructions for TM and GI Examination Procedures

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Romania's PTO has issued new instructions for the examination of trademarks and geographical indications, in effect as of August 1, 2012.

The new instructions aim to optimize the workflow within the PTO and ensure a fast and efficient examination procedure. They also aim to reduce the financial burden for applicants and prevent the decrease of national applications and renewals.

The instructions came as a result of the conclusions drawn following the implementation of Law 84/1998 on Trademarks and Geographical Indications, amended and republished in 2010, and its Implementing Regulations issued in December 2011.

According to the new instructions, all requests concerning new trademark and GI applications or existing registrations are to be processed immediately upon receipt. In this respect, the structure and the roles of various bureaus within the PTO's trademarks department have been defined and the heads of all bureaus nominated.

In terms of trademark applications, it has been decided that during the preliminary examination stage, the PTO will conduct a search to identify any earlier identical trademark applications or registrations for identical goods and/or services. The search report will be issued and sent to the applicant. At the same time, the PTO will send a notice to the holder of earlier trademark(s) cited in the search report.

In the substantive examination of trademarks that include, or are derived from or are similar to a domain name, it will be considered that a top-level domain such as ".ro", ".com" and ".gov" *only indicates the place where information can be found on the Internet and thus cannot render a descriptive or otherwise objectionable mark registrable.*

It is also expressly ordered that the examination of trademarks consisting of geographical names (GN) will be done consistent with the practice of the Office for Harmonization of the Internal Market (OHIM). This means that the registration of trademarks that consist of GNs will not be excluded when, because of the type of place the GN designates, the public is unlikely to believe that the goods or services concerned originate there.

These provisions closely follow OHIM's examination manual, section B, pages 43 and 54 respectively.

In addition, the new instructions say that during the substantive examination, when examining if a trademark is capable of distinguishing the goods/services of one undertaking from the goods/services of another undertaking, examination will be made among identical and confusingly similar marks for identical products/services in the same Nice class or similar goods/services in different Nice classes. This provision seems to indicate that earlier rights could or should be cited to refuse a trademark on the basis that it does not meet the general conditions for registration set forth in the law. However, this

provision and its consequences are unclear. Clarifications from the PTO regarding this point are expected shortly.

The new instructions also provide that, without prejudice to the legal terms for the substantive examination of new applications (6 months from publication for regular applications, and 3 months from publication for urgent applications), the PTO may grant an extension of the deadline for the settlement of examination fees, upon request. The substantive examination is not to be carried out until the related fees are settled. If the fees remain unsettled 30 days before the expiry of the examination term, the examiner may notify the applicant. The failure of the applicant to comply will result in the application being refused.

If expedite examination of trademark applications is desired, it must be requested when filing the application form. Also, the fee for expedite examination must be paid when filing the trademark application. Subsequent requests for expedite examination and/or subsequent payments of related fees will not be accepted.

When oppositions and/or observations are filed, they will be analyzed without taking into consideration if the examination fees for the application against which the opposition is filed, are paid. If, for justified reasons, the opposition filed against a trademark application is withdrawn before being analyzed and decided upon, the opposition fee may be refunded upon request; such situations are to be assessed on a case-by-case basis.

In case multiple oppositions are filed, each opposition will be analyzed and decided upon in chronological order, independently from the rest of the oppositions, and disregarding the fact that if one opposition is successful, the rest will become without object.

In the new instructions the PTO also commits to make the Trademarks Register more accessible, logical and functional, by September 1, 2012.

Changes are also to be made to the trademark application form. Namely, a new column will be added with the following content: *The applicant hereby declares that its trademark application is filed in good faith.*

The job descriptions for the entire staff of PTO's trademark department are to be updated, in accordance with the new instructions.

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