

**Harmonization of trademark and design law in the
Member States and the progress achieved by
Romania and Bulgaria**

Crenguta Leaua
Mihaela Capov



European Union intellectual property legislation

- Directives are a form of secondary legislation binding Member States as to objectives to be achieved;
- Types of Directives:
 - general applicability (e.g. Directive 2004/48/EC);
 - special applicability (e.g. Directive 98/71/EC);
- Draft directives (e.g. draft directive on measures and procedures to ensure the enforcement of intellectual property rights).

European Union trade marks legislation

- First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (the “**Trade Marks Directive**”).

Trade Marks Directive

General Overview

- The purpose of the Trade Marks Directive is approximation of the laws of the Member States;
- Approximation is necessary for the establishment and functioning of the internal market;
- Approximation is limited to national provisions directly affecting the internal market;
- Certain provisions, mainly procedural, are left to national law.

Trade Marks Directive

General Overview continued

- The Trade Marks Directive:
 - defines what constitutes a trade mark;
 - establishes conditions for obtaining and continuing to hold a registered trade mark;
 - establishes the rights conferred by a registered trade mark;
 - establishes the substantive grounds for refusal of registration and for the invalidation of registered trade mark;
- Certain provisions are left to national law:
 - procedure for registration, revocation and invalidation of trade marks acquired by registration.

Romania

Applicable trade marks legislation

- Law No. 84/1998 regarding trade marks and geographical indications of 15 April 1998 published in Part I of the Official Gazette No. 161 of 23 April 1998 (the “**Romanian Trade Marks Law**”);
- Regulation for the application of the Romanian Trade Marks Law of 19 November 1998 published in Part I of the Official Gazette No. 455 of 27 November 1998;
- Draft Law on amending the Romanian Trade Marks Law (the “**Draft Trade Marks Law**”).

Romania's progress

- Harmonization with the Trade Marks Directive represents a political obligation undertaken by Romania with a view to enter the European Union;
- Romania has achieved a substantial progress as regards harmonization with the Trade Marks Directive.

Romania's progress continued

- Certain provisions which still need to be adopted in order for the Trade Marks Directive to be duly implemented are provided in the recent Draft Trade Marks Law, and regard, *inter alia*, the following:
 - Definition of the trade marks;
 - Grounds for refusal or invalidity;
 - Exhaustion of rights.

Bulgaria

Applicable trade marks legislation

- Law on marks and geographical indications published in State Gazette No. 81 of 14 September 1999, as further amended;
- Regulations on the drafting, filing and examination of applications registration of marks and geographical indications published in State Gazette No. 9 of 1 February 2000.

Bulgaria's progress

- The Bulgarian Trade Marks Law is harmonized with the Trade Marks Directive as closely follows the relevant provisions of the Trade Marks Directive with respect to most of the provisions, such as:
 - part of the protection requirements;
 - conditions upon which a trade mark is excluded from protection;
 - the scope and period of protection;
 - the cases of invalidity or refusal of registration;
 - the rights conferred by the registered trade mark.

Designs European Union legislation

- Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (the “**Designs Directive**”);
- Proposal for a Directive of the European Parliament and of the Council amending Directive 98/71/EC on the legal protection of designs (the “**Designs Draft Directive**”).

The Designs Directive

General Overview

- The purpose of the Designs Directive is approximation of the laws of the Member States on the legal protection of designs;
- Approximation is necessary in order to achieve the objectives laid down in the Treaty establishing the European Community;
- Approximation is limited to national provisions of law which directly affect the functioning of the internal market;
- Provisions regarding procedures for registration, or enforcement are left to national law.

The Designs Draft Directive

General Overview

- Purpose of the amendment - removing Members' states option to maintain design protection for “visible” replacement (vehicle) parts;
- Area of application of the amendment - any sector where the replacement and repair of visible components of complex products is at stake;

The Designs Draft Directive

General Overview

continued

- Object of the amendment - spare parts in the secondary market which are protected by a design right based on novelty and individual character;
- Solution - introducing a “repairs clause”, *i.e.* suppliers, other than those who supply and hold design right over a part for a new car, should be able to supply, as a replacement part, a component using an identical design;
- Benefits for:
 - consumers;
 - competitiveness of business and competition;
 - employment.

Romania

Designs legislation

- Law 129/1992 of 29 December 1992 on the protection of industrial designs and models as republished in Part I of the Official Gazette No. 193 of 26 March 2003 (the “**Romanian Designs Law**”);
- Regulation for the application of Law 192/1992 of 2 October 2003, on the protection of industrial designs and models published in Part I of the Official Gazette No. 741 of 23 October 2003;
- Draft Law for amending Law 129/1992 on the protection of industrial designs and models (the “**Designs Draft Law**”).

Romania's progress

- Romania has achieved a substantial progress as regards harmonization with Designs Directive as regards, *inter alia*:
 - the protection requirements,
 - conditions upon which a design is excluded from protection,
 - the scope, period of protection,
 - the cases of invalidity or refusal of registration,
 - the rights conferred by the design right.

Romania's progress continued

- Certain details not covered by the Romanian Designs Law are covered by the Draft Designs Law, such as:
 - Protection requirements;
 - Disclosure;
 - Designs excluded from protection;
 - Invalidity or refusal of registration.

Bulgaria

Designs legislation

- Law on industrial designs published in State Gazette no. 81/99 in force from 15 December 1999, as further amended (the **“Bulgarian Designs Law”**);
- Regulations on the drafting, filing and examination of applications registration of industrial designs published in State Gazette No. 9/01.02.2000.

Bulgaria's progress

- Bulgarian Designs Law is harmonized with the Designs Directive in most relevant aspects.
- Certain details are not covered by the Bulgarian Designs Law and implementation of such provisions would be necessary:
 - Protection requirements – regarding component parts of a complex product;
 - Protection requirements – regarding freedom of the designer in developing the design;
 - Disclosure.

Conclusions

- The monitoring report on the state of preparedness for European Union membership of Bulgaria and Romania communicated by the Commission of the European Communities on 26 September 2006 provides that:
 - Bulgaria has made progress in the field of protection of intellectual and industrial property rights; however, the intellectual property rights is an area in which further progress is needed;
 - Romania made general progress in the field of intellectual and industrial property rights, further efforts being required in the area of copyright.



THANK YOU!

TANASESCU LEAUA CADAR & ASOCIATII
Law firm

**Bd. Eroii Sanitari nr.37, sector 5,
cod 050471, Bucharest, Romania**

Tel. + 40 31 405 43 04

Fax. + 40 31 405 43 05

Email : office@tlclaw.ro

www.tlclaw.ro