Romania
Roumanie
Rumänien

Report Q 148

in the name of the Romanian Group
by Melania RADULESCU

Three-dimensional marks:
the borderline between trademarks and industrial designs

I. National law or case-law

1. Is in your country legislation, or other sources of law, to protect shapes of goods, packages and other 3D signs as Industrial Designs and/or as Trademarks?

In Romania by Law No.129/1992 concerning the protection of Industrial Designs may be protected as an Industrial Design the new appearance of a product having an utilitarian function.

In addition, the ROPTO internal regulations specify that the respective product may have 2 or 3 dimensions.

On the other hand by Law No.84/98 concerning the trademarks and geographical indications may be protected as trademarks the distinctive signs as: words, names of persons, drawings, letters, numbers, figurative elements, tridimensional signs and in particular the shape of the product or its package, colours combinations as well as any other combinations of these signs.

2. If so, what are the conditions and minimum requirements to protect them as:

a) Industrial Designs
b) Trademarks

a) In order to protect the 3D signs as Industrial Designs it is necessary to be fulfilled the followings conditions:

- they shall refer to the appearance of a product
- the appearance has to be new
- the product shall have an utilitarian function
- the appearance not to be determined by a technical function
- the appearance and the destination of the product not to be contrary to public order or morality.

The minimum requirements to protect 3D signs as Industrial Designs are

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- a design application accompanied by a short description of the characteristic elements and 10 graphical reproductions filed with ROPTO, in order to be constituted the national regular filing.

b) In order to protect 3D signs as Trademarks the followings conditions have to be fulfilled:

- they shall have a distinctive character
- they shall be new in comparison with the trademarks prior registered in Romania
- they shall not be made up exclusively of the shape of the product, imposed by nature of the product or necessary to obtain a technical result or giving a substantial value to the product
- they shall not be contrary to public order or morality
- they shall not contain false or deceitful indications
- they shall not be made up exclusively of signs or indications which may be used on the market for identifying the species, quality, quantity, destination, value, geographical origin or the time of manufacturing the product or of the services carrying out or other characteristics of them
- they shall not include, without the consent of the owner, the image or the patronymic name of a person who is well known in Romania
- they shall not include without the Authorization of the competent bodies, reproduction or imitations of escutcheons, flags, state emblems, signs, official seals for control and guarantee, armorial bearings adopted by the countries of the Union entering the provisions of Art. 6ter in the Paris Convention
- they shall not include, without the Authorization of the competent bodies, reproduction or imitations of escutcheons, flags, other emblems, sigles, initials or designations entering the provisions of Art.6ter in the Paris Convention and belonging to the international intergovernmental organizations in which one or several countries of the Union is a part.

The minimum requirements to protect the 3D signs as Trademarks are:

- a trademark application accompanied by a specification of goods or services and international classes and 5 graphical representations in black and white, when the applicant does not claim a colour as a distinctive element and supplementary 5 reproductions of the colour marks when the applicant claims at least one colour as a distinctive element. All the above mentioned have to be filed with ROPTO in order to be constituted the national regular filing.

3. Is there a specific rule that precludes Trademark protection for a shape of an object protected or previously protected, as an Industrial Design or under another modality of Industrial Property (e.g. Utility Models or Patents)?
There is Rule 15 of the Regulations for Implementing the Law No.84/1998 concerning the marks and geographical indications which stipulates that a sign cannot be registered as a mark or element of a mark if it jeopardizes a previously protected right including an identical or similar mark registered in Romania for identical or similar goods and services, if the date of registration of this mark or the priority date is prior to the date of the national regular filing of the mark which the registration is applied for; an identical or similar mark considered to be a matter of common knowledge in Romania; a right of a personality with regard to his image or patronymic name; a protected geographical indication; a protected Industrial Design; copyright; any industrial property right acquired prior to the date of the national regular filing of a mark.

4. *If there is no specific legal disposition under 3 can it be understood from national case law that this possibility is excluded?*

   Is not the case.

5. *Is it possible to accumulate protection on the same shape as an Industrial Designs and as a Trademark?*

   It is possible to accumulate protection on the same shape as an Industrial Design and as a Trademark with the observance of the Trademark Law and Design Law provisions.

6. *Is it possible to claim priority of an Industrial Design in a Trademark application or vice-versa, can a priority of a Trademark application be claimed in an Industrial Design Application?*

   It is not possible to claim priority of an Industrial Design in a Trademark application or of a Trademark in an Industrial Design application.

7. *Can a shape or packaging used in combination with a word mark acquire distinctiveness through use to be protected as a 3D Trademark without the word mark?*

   A shape or packaging used in combination with a word mark can acquire distinctiveness through use to be protected as a 3D Trademark without the word mark.

8. *Is there any distinction between the protection afforded by a trademark and by an Industrial Design? In particular:*

   8.1 *Is there a distinction on what constitutes an infringement and in the remedies available?*

   Generally is not a distinction regarding the infringement between the Trademarks and Industrial Design.

   However we may note some differences between the definitions included in the Design Law respective Trademark Law, namely:
- for an Industrial Design the offence of counterfeiting is represented by the unlawful reproduction for the purpose of manufacturing products of an identical appearance, the manufacture, offering for sale, selling, importing, using or the storing of such products for the purpose of putting into circulation or using, without having consent of the owner of the Certificate of registration of the Industrial Design, during the term of validity thereof and is punished with imprisonment for six months or two years or with a fine. This definition is more severe because it request a reproduction not a simply imitation. But in juridical practice are used the provision of the Design Law together with the provision of the Unfair competition law.

- in the case of a Trademark is considered as offence of counterfeiting and it is punished with imprisonment from 3 months to 3 years or with a fine of 15 millions lei, imitation or use with no right of a Trademark aiming to mislead the public on the quality of products or services, to which the trademark refers; the circulation with no right, of a product bearing a Trademark identical or similar with a Trademark registered for identical or similar products and which is prejudicing the owner of the registered trademark; the circulation of products bearing geographical indications showing or suggesting the product originates from a geographical area, other than the place of origin aiming to mislead the public or the geographical origin of the product.

The means for defence of the rights are identical, namely the civil and criminal action.

8.2 Is it possible to forbid the two dimensional reproduction of a 3D object protected by an Industrial Design or Trademark registration of such a 3D object?

The Design Law and Trademark Law have no provision concerning the forbidden of the two dimensional reproduction of a 3D object protected by an Industrial Design or Trademark registration.

But it is possible to forbid the two dimensional reproduction of a 3D object protected by an Industrial Design or Trademark by an judiciary decision at the request of the owner.

8.3 Can the use of a sign as an Industrial Design lead to the loss of distinctivity of this sign as a Trademark, so that this sign could no longer be registered as a Trademark or, if registered, caused the registered Trademark to become invalid.

It is possible that a sign used as an Industrial Design can lead to the loss of distinctivity of this sign as a Trademark, so that this sign could no longer be registered as a Trademark or if registered causes the registered Trademark to become invalid.
8.4 What kind of measures can be taken by the proprietor to avoid that a sign loss its distinctive character as a consequence of the use of the corresponding design made by third parties.

To enforce the right upon the Industrial Design from the beginning.

8.5 Any other comment you would like to make in connection with this matter, not covered above.

II. Our opinion regarding the adoption of general rules on the following questions.

1. The need to established clear criteria when a 3D object may be legally protected as an Industrial Design and as a Trademark.

We consider that it would be better to establish clear criteria when a 3D object may be legally protected as an Industrial Design or a Trademark, in order to harmonize the legislation of all countries.

2. To make proposals to clarify these criterias and, if any, the distinction to be made between Trademark and Industrial Design.

Because a Trademark represents a distinctive sign we consider that it would be protected as 3D Trademark only characteristic 3D signs (shapes and packages).

The shapes of the products imposed by nature of the product or necessary to obtain a technical result or giving a substantial value of the product have to be forbidden from the registration of a Trademark.

Concerning the Industrial Design we consider that it would be necessary to forbid from the protection the 3D signs which represent the appearance of a product determined by a technical function as well as appearance and the destination of a product contrary to public order or morality.

3. To establish the circumstances when an object protected by an Industrial Design (or another modality of Industrial Property such as utility models and patents ) should also be permitted protection as a Trademark.

We consider that when the shape of a product is destined to give an industrial effect it is not possible to be protected as a Trademark. In this situation the inventor's monopoly is extended over legal period of patent protection.

When a 3D product is, an artistic shape (for example crystal bottle) which affects the essential value of the product it is also not possible to be protected as a Trademark because essential value of the respective product is in fact the beauty of its shape.

We also consider that it is necessary to establish more severe conditions for distinctiveness in the case of such a 3D objects in order to be protected as a Trademark.
4. The possibility to accumulate protection on the same shape as a Trademark and an Industrial Design.

We consider that a cumulated protection is permitted when the respective rights belong to the same owner.

When the rights would have belong to the different owners it arises a unfair competition question.

5. Any other comments on this subject-matter not covered under the above paragraphs.

Summary

Romania accept the registration of the 3D Trademarks consisting of the shape of products on their packaging.

Romania also recognize the possibility to protect the shape of goods and packages through Industrial Designs as well as by copyright.

These modalities have different requirements for protection and different tests for what constitutes an infringement.

The cumulated protection by Trademark and Industrial Designs on the same shape is also admitted when this protection does not jeopardize the owner right.

It would be better to establish clear criteria when a 3D object may legally protected as an Industrial Design or a Trademark in order to harmonize the Industrial Property legislation of all countries.

Résumé

Roumanie accepte l'enregistrement de marques tridimensionnelles, en particulier des marques de fabrique ou de commerce qui ont la forme de la marchandise ou de son emballage.

Roumanie aussi reconnaît la possibilité de protéger la forme d'un produit et de son emballage par le basis des modèles industriels ainsi que par le droit d'auteur.

Ces modalités ont des exigences différents en ce qui concerne la protection des motifs différents pour accorder la protection et des tests différents pour déterminer une contrefaçon.

Une cumule de protection de la même forme en tant que modèle industriel et marque est possible quand cette protection n'apporte pas des préjudices au titulaire de droit.
Il serait mieux d'établir des critères clairs pour savoir si un objet tridimensionnel peut être protégé également comme un modèle industriel et une marque pour harmoniser la législation dans tous les pays.

**Zusammenfassung**

Rumänien lässt die Eintragung von dreidimensionalen Marken zu, womit insbesondere Marken gemeint sind, die aus der Form des Produkts oder ihrer Verpackung bestehen, zu.

Rumänien erkennt gleichfalls die Möglichkeit an, die Form einer Ware und ihrer Verpackung durch Muster und Modell oder durch das Urheberrecht zu schützen.

Diese Schutzrechte haben unterschiedliche Schutzvoraussetzungen, ebenso wie der Test für das Feststellung einer Rechtsverletzung.

Ein kumulierter Schutz für die gleiche Form als Modell und als Marke ist möglich, wenn dies nicht die Rechte des Inhabers beeinträchtigt.

Es wäre zur internationalen Harmonisierung besser, klare Kriterien dafür aufzustellen, wann ein dreidimensionaler Gegenstand rechtlich als Modell oder als Marke geschützt werden kann.