

Eastern Europe

# IP Guide

2011

1st Edition



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# Welcome

We are delighted to publish this first edition of the *Eastern European IP Guide*. Written by specialists from the region's leading firms, the *Guide* provides those doing, or planning to do, business in Eastern Europe with an analysis of some of the most significant features and latest trends in IP law and practice in an increasingly important market.

A number of countries in the region are now members of the European Union. Eight of them joined in 2004, with two more acceding in 2007. The harmonisation of these countries' IP legislation with that of the European Union has been a challenge over the past few years. The changes can happen quickly, however, as Nicoleta Tartchila explains in this *Guide*: Romania's trademark law was in line with EU law and practice within three years of joining. Yet small discrepancies may remain. Thus, Poland has not transposed into national law a provision of the First Trademarks Directive (89/104/EC) relating to letters of consent, which explains in part that country's practice with regard to these letters, as Aleksandra Kryska reports.

For those jurisdictions outside the European Union, a game of catching up is also evident. Tamara Bubalo's review in these pages of the latest IP law developments in key Balkan countries demonstrates their efforts to offer an IP legal framework as strong as that of their EU neighbours.

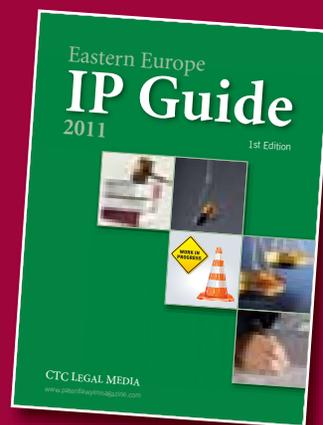
This *Guide* also tackles that old bugbear of IP rights holders – counterfeiting. Using as a starting point a real Romanian incident, Stefan Cocos analyses the counterfeiting business model and offers some suggestions on how to fight it.

Lastly, Eszter Szakacs' article shows that the fact that patent infringement and revocation proceedings are separate in Hungary makes for a balanced system that offers patentees ample protection – especially in light of a recent decision.

We would like to thank the authors of these articles for their effort and commitment to the project.

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## EASTERN EUROPE IP GUIDE 2011 1st Edition

### Published by:

CTC Legal Media,  
Office 36, 88-90 Hatton Garden,  
Holborn, London EC1N 8PG,  
United Kingdom  
Tel: +44 (0)20 7112 8862  
Fax: +44 (0)20 7084 0365

### Design and Reprographics by:

Design and Printing Solutions Ltd,  
The Studio, 11 Millstream Green,  
Willesborough, Ashford,  
Kent TN24 0SU

### Printed by:

The Marstan Press Ltd.  
Princes Street, Bexleyheath,  
Kent DA7 4BJ

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H-1051 Budapest, Bajcsy-Zsilinszky út 16, Hungary  
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Tel.: (+36 1) 411-8700 • Fax: (+36 1) 266-5770  
central@danubia.com



Hungarian patent validity and infringement proceedings are distinct. Eszter Szakacs, Danubia Patent & Law Office LLC explains what this means for patent holders.



*Eszter Szakacs*  
*Danubia Patent & Law Office L.L.C.*

**W**hen it comes to patent litigation in Hungary, it is important to know that infringement and revocation proceedings are strictly separate. The division stems from a core principle of the Hungarian Code of Civil Procedure, which provides that a court may suspend any lawsuit the adjudication of which the court considers to be dependent on the outcome of another, ongoing, administrative or civil proceeding forming a preliminary question. Thus, in an infringement lawsuit in which the Metropolitan Court (competent to hear patent infringement cases at first instance) must decide whether the right in the patent held by the plaintiff has been infringed, the question of whether the patent at issue is valid at all – which is to be decided by the Hungarian Patent Office at first instance (ie, a different authority) – constitutes such a preliminary question.

### Rule and limitation

The courts have confirmed on several occasions that in an infringement proceeding the court shall take the registered status of the patent as a starting point; if a revocation proceeding has been initiated by the defendant, the court has no competence to decide on such revocation proceeding. It follows that if during a patent infringement proceeding the validity of the patent at issue has been challenged through a revocation action, such challenge becomes a preliminary question that warrants the suspension of the infringement proceeding.

There have been many attempts by defendants to extend the obligation (provided that the circumstances commend it) to stay proceedings to preliminary injunction proceedings – that is, proceedings in which patentees seek immediate

protection for their monopoly by means of injunctive relief. However, the courts have confirmed the limitation of the application of the suspension, stating that it would be unjust to prevent patent holders from being eligible to immediate protection. Therefore, the courts have reasoned, the adjudication of an interlocutory injunction cannot be prevented by a reference made to an ongoing revocation proceeding relating to the same patent.

In turn, patent holders have tried in several recent cases to challenge the near-automatic suspension of infringement proceedings, albeit with little success.

### Second instance suspension

One such challenge occurred after a defendant initiated a revocation proceeding only when the infringement lawsuit reached the appellate court. At first instance, the court had ruled on the facts of the case without any doubts being raised as to the patent's validity.

The defendant appealed against the judgment establishing the infringement on the ground that in the meantime it had started a revocation proceeding against the patent before the Hungarian Patent Office. The Metropolitan Court of Appeal suspended the infringement proceeding, declaring that the decision on the revocation proceeding constituted a preliminary question in respect of the merits of the patent infringement proceeding. The court noted that the interests of the plaintiff were meanwhile protected by an earlier preliminary injunction.

The plaintiff lodged an appeal against the suspending decision, arguing that in its interpretation of the relevant procedural rules, the Metropolitan Court of Appeal was not obliged to stay the proceedings: it was only entitled to do so following a thorough assessment of all the relevant circumstances of the case. In this context, the plaintiff emphasised, the fact that the litigation had started several years previously, and that the defendant had not questioned the validity of the patent up until that point of the proceeding (neither had it done it during the 19 years of the patent's lifetime prior to the proceeding) should be regarded as such a relevant circumstance – namely, an indication of bad faith and an intentional delay of the proceeding. The plaintiff also claimed that the defendant had initiated the revocation proceeding without any good reason and, thus, the reference to such proceeding should not be considered at all in the appeal phase of the infringement lawsuit.

In its ruling on the plaintiff's appeal against the suspension decision, the Supreme Court held that the result of the revocation proceeding concerning a patent constitutes

a preliminary question in respect of an infringement proceeding involving the same patent. Consequently, the court argued, the infringement court *must* suspend the infringement proceeding until a legally binding decision is made in the revocation proceeding, regardless of when the revocation proceeding was started. Even though the wording of the law is permissive (it says that the court may suspend the proceeding), in patent infringement proceedings the stay becomes a must when revocation proceedings are ongoing.

The strength of bifurcation was also tested in this case against the limitation of new evidence and reference to new facts at second instance. Addressing the question of whether the defendant may invoke a revocation proceeding only at second instance of the infringement proceeding, the Supreme Court held that the limitation of the allowable evidence at second instance does not exclude the stay of a proceeding even on appeal, in case the result of the referred proceeding constitutes a preliminary question.

### Repeated revocation actions

In another case, it was once again the task of the higher level courts to deal with the question of staying an infringement proceeding – this time in connection with a revocation action filed repeatedly. The context of the decision was the following: the patent holder initiated an infringement lawsuit in 1993. Due to the revocation request filed by the defendant, the infringement lawsuit was suspended for nearly 10 years. After the proceeding was resumed and infringement was established in 2005, the plaintiff sued another defendant in a new proceeding based on the same patent.

This new defendant filed a new revocation action against the validity of the patent that formed the basis of the infringement lawsuit. The infringement court stayed the infringement proceeding with respect to the revocation proceeding. The patentee appealed against the suspension, arguing that the revocation request was based on the same revocation grounds – although this time referring to new anteriority too – as the previous revocation action, which had previously stopped the enforcement of the patent for 10 years.

According to the plaintiff, this new revocation proceeding was nothing more than delaying tactics on the part of the defendant. However, the Metropolitan Court of Appeal confirmed in its decision that the outcome of the new revocation action was a preliminary question, and that the suspension of the infringement lawsuit was therefore necessary – even if it harmed the interests of the plaintiff.

The court refused to address the plaintiff's claim that the revocation was a repeat of the revocation action made by the previous defendant, and that it was therefore not admissible. The court argued that such consideration rested with the Hungarian Patent Office.

While these decisions may be considered detrimental to the patent holders by delaying the final injunctions, bifurcation also played in the patentees' favour. As mentioned above, it has been long established in the Hungarian judicial practice that an ongoing revocation proceeding does not prevent the patent holder from obtaining a preliminary injunction if the defendant's product or process infringes the original patent claims.

### Restricted patent claims

This approach was taken one step further at the beginning of 2011 when the Metropolitan Court faced the (non-binding) restriction of a patent on the basis of which the court had previously granted a preliminary injunction.

The question at issue was whether a preliminary injunction can be maintained in such changed circumstances (ie, taking into consideration the limitation of the scope of the patent). The court's affirmative ruling shows that the separation of infringement and validity issues may strongly favour patent holders in Hungary.

Earlier the court had issued a preliminary injunction, at the patentee's request, to prohibit the defendant from distributing its pharmaceutical product. The patent at issue covered a pharmaceutical composition consisting of a particular active ingredient and certain additives defined in the claim. The defendant's product contained the same active ingredient; its additives included ethanol, which, on the court's assessment, fulfilled the requirements concerning additives as described in the patent. The court granted a preliminary injunction, even though a revocation proceeding against the patent was in progress at first instance at the Hungarian Patent Office.

A year later the Hungarian Patent Office restricted the main patent claim to exclude ethanol from the possible additives. Although the decision was still subject to appeal, the defendant immediately asked the infringement court to withdraw the preliminary injunction based on the (non-final) restriction, stating that its product did not infringe the restricted patent since ethanol was excluded from the additives. The patent holder asked the court to maintain the preliminary injunction on the grounds that the restriction was not yet final, and that other, remaining additives in the defendant's product made it infringing.

The court found that in the absence of a binding decision concerning the validity of the patent, the patent claims should be regarded as valid; therefore, the court reasoned, the facts on which it had previously granted the preliminary injunction were essentially unchanged. As the restricting decision of the Hungarian Patent Office was still subject to a right of appeal, the scope of protection remained too uncertain for the court to conclude that the infringement had ceased to exist.

The court noted that non-binding patent office decisions may be changed by the rulings of the court in its capacity as an appellate forum. If the court attributed special significance to non-binding patent office decisions in infringement cases, the patent holder's rights would be unduly and adversely affected (with no security having been provided by the defendant). The court observed that the patentee had been required to provide a security deposit on issuance of the preliminary injunction; therefore, the defendant's position was secured. The court concluded that taking non-binding patent office decisions into account in infringement proceedings would result in patent holders receiving less protection for their rights than potential infringers.

Moreover, the Metropolitan Court confirmed that the court which assesses an infringement is not entitled to make assumptions as to the future outcome of a revocation proceeding. Therefore, the Metropolitan Court upheld the preliminary injunction, even after the Hungarian Patent Office had restricted the scope of the patent, without examining whether the defendant's product fell within the scope of the restricted claim. Importantly, this decision is under appeal, so it is not yet known whether the court of second instance will confirm this approach.

### Analysis

In summary, the separation of infringement and validity proceedings presents both advantages and disadvantages for the parties. On the one hand, it may be favourable to patent holders because it can ensure a quick grant of a preliminary injunction without having to defend the validity of the patent before the court. On the other hand, however, it delays the grant of a final injunction and the award of damages by several years. Nevertheless, these considerations shall be assessed in both infringement and revocation proceedings.

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35, Ermil Pangratti Street, Sector 1, Bucharest, Romania

TEL: +4021 2312515/2312541

Fax: +4021 2312550/2312454

E-mail: [office@rominvent.ro](mailto:office@rominvent.ro)

Website: [www.rominvent.ro](http://www.rominvent.ro)



# A genuine proposition



Counterfeiting does not spare Romania. Stefan Cocos, Rominvent S.A. argues that understanding the nature of the crime will help fight it.



Stefan Cocos  
Rominvent S.A.

**A** potential customer was overhead saying to a market stall holder in a suburb of Bucharest “I would like to buy a flat iron, a MOULINEX.”

“Which one?” asked the stall holder. “A Romanian one for RON45 [about EUR10] or the original one for RON150 [about EUR35]?”

“The Romanian one.”

This conversation prompted the following questions:

- Was the customer misled by the offer consisting of a product that he knew was not an original (ie, genuine) MOULINEX iron? Is it reasonable to consider that, by adding the words ‘original’ and ‘Romanian’ to the trademark MOULINEX, the customer was not mistaken as to the sources of the two products?
- Why did the customer buy the Romanian fake MOULINEX iron when there were similar products clearly

available at the same stall from around EUR6? Why did he pay EUR10 when he already knew that he was not buying a genuine MOULINEX article?

- Is it possible that the use of the distinctive dominant element (MOULINEX) for both products led the customer to make a connection (association) between the two offers? For instance, did he believe that the counterfeit iron:
  - Was made with the same technology as the genuine MOULINEX article;
  - Was made under licence (ie, control) of the MOULINEX trademark owner; or
  - Had similar features as the genuine MOULINEX article?

It would be easy to answer the first question in the negative since the customer was clearly told that the product which he was purchasing was not an original MOULINEX

*“I would like to buy a flat iron, a MOULINEX.”*

*“Which one?” asked the stall holder.*

*“A Romanian one for RON45 [about EUR10] or the original one for RON150 [about EUR35]?”*

*“The Romanian one.”*

iron. However, the answer to the second question, as to why the customer bought the Romanian counterfeit MOULINEX iron when cheaper similar products were available qualifies this first answer: the customer made an association between the two offers (one for the original MOULINEX product and one for the counterfeit Romanian one) and considered that the product that he bought shared the characteristics of the genuine MOULINEX product. Accordingly, one must conclude that he was misled.

The Romanian Law on Trademarks and Geographical Indications (84/1998) provides that the registration of a trademark gives its owner an exclusive right over that mark; the mark holder can ask the competent court to preclude third parties from using, in the course of trade and without the consent of the owner, a sign with which there exists a risk of confusion in the public perception, including the risk of association, because that sign is identical or similar to the registered trademark and because the products or services at issue are identical or similar.

Further, the law provides that it is a crime both to counterfeit a trademark and to place on the market a product bearing a trademark that is identical or similar to a trademark registered for identical or similar products if such act causes any harm to the owner of the registered trademark. These crimes are punishable by imprisonment of between three months and three years or a fine of between RON50,000 and RON150,000.

The purchase of the counterfeit MOULINEX iron thus involved a crime – namely, counterfeiting: the sign MOULINEX used in connection to the Romanian iron is identical to a registered trademark; it is used for identical products (irons) to those for which the trademark is registered, thus producing a risk of confusion for the public, including the risk of association of the trademark with the sign. The owner of the trademark MOULINEX incurred damages from the use of the counterfeit mark, at least in so far as it missed a sale as the result of such use. One may also invoke the second crime – that of placing the products bearing the trademark on the market without the consent of the mark owner.

This prompts further questions:

- Why would anyone be willing to commit such crimes when these are so severely punished by the law?
- What mechanisms come into play and lead somebody to counterfeit a trademark?
- What is the risk profile for these crimes?

In order to comprehend what can motivate anyone to counterfeit a trademark despite the severity of the possible punishments, one should probably consider counterfeiting as a business in which counterfeiters invest money and expect high profits in return. And to understand both the inner workings of such a business and how this business can generate profits that are large enough to make counterfeiters assume the high risks involved, one needs to identify the factors that influence a purchasing decision.

### Consumers motivations

The elements set out below all come into play when a consumer makes a decision to buy a product or service.

**Utility value:** Consumers are looking for the basic utility value of a product, as well as for additional functions that increase the utility value of the product. The (average) consumer explicitly knows some of the product's characteristics (eg, whether the iron has a temperature adjuster, a steamer, a thermo regulator), but he or she does not explicitly know other characteristics (eg, the type and precision of the adjustment system, the efficiency). On the basis of these characteristics, the consumer considers that a product is better than competitors, thus associating these characteristics with the trademark (“I choose the X-trademarked iron because it is better than the Y-trademarked iron”).

**Esthetic value:** When the utility values are comparable, consumers will pay for the esthetic aspect of the product.

**Trust in manufacturer:** Consumers will pay for the trust that they place in a manufacturer and for the hope that they are buying a product that is better than other similar products present on the market. Consumers are tempted to choose trademarks that have, over time, met their expectations.

**Status symbol:** For some products, consumers will accept to pay for the status that the branded product will lend them, in order to give the impression that they belong to a certain category of persons who can afford to buy certain types of product.

**Advertising:** Aggressive advertising can persuade consumers to buy a certain branded product, even if, at the time of purchase, the trademark in question has not yet succeeded in meeting the relevant consumers' expectations.



*“Using a trademark that is already well established on the market enables counterfeiters to save the considerable amounts of money normally involved in developing a brand.”*

## Risk factors

Some types of trademark and product are more vulnerable than others to counterfeiting. Below are some of the elements that will influence counterfeiters in their decision to sell a specific product bearing a particular mark.

**Families of trademarks:** Families of trademarks consist of groups of trademarks with a single common component. For example, the mark TCHIBO for coffee is protected on the Romanian market by a family of trademarks featuring the common component TCHIBO and different colours of packaging for different products (eg, the packaging for the range TCHIBO Exclusive is mauve, the one for TCHIBO Mocca is red and that for TCHIBO Family is yellow).

Families of trademarks are easy to counterfeit because consumers are likely to think that TCHIBO coffee in, say, a blue package is an extension of the range of products made by the owner of the TCHIBO family of marks, rather than a counterfeit.

**Nature of products:** Some products are sold without packaging, while others are sold only in packaging. Some products enjoy intrinsic characteristics that help distinguish them, while other can be distinguished only by the trademark attached to them. Consumers thus often pay for the characteristics of the product without being able to check these characteristics prior to the purchase (eg, electronics spare part). Consumers assume that the product and/or service that they are purchasing feature specific characteristics solely on the basis of the reputation of the mark. Such products are also vulnerable to counterfeiting.

**Trademark reputation:** Using a trademark that is already well established on the market enables counterfeiters to save the considerable amounts of money normally involved in developing a brand. Accordingly, well-known marks are vulnerable to counterfeiting since they already have a reputation among consumers, are easy to imitate and apply, and require no further advertising.

**Type of consumers:** Both products and trademarks are intended for consumers, who must decide whether the ensemble formed by a specific product and mark is genuine or fake. Consumers can be informed (when they consider both the trademark and the product’s characteristics), in a hurry (when they pay less attention to details), paying attention (when they buy large household goods and/or expensive goods), or even comfortable or confused. A consumer in a hurry buying a packet of cigarette is less likely to spot a counterfeit than a consumer buying a car.

**Product price:** It is not the high retail value of a product *per se* that attracts and motivates counterfeiters; rather it is the profit margin that the product offers. Besides, more expensive products mean more attentive consumers, who are thus more likely to identify a fake. And higher prices mean fewer potential buyers.

## Analysis

In summary, certain types of trademark carry a higher risk of being counterfeited than others. They include:

- Marks that are well known to consumers;
  - Mark that apply to products that feature characteristics which consumers find difficult to identify or remember; and
  - Marks that carry low production and/or acquisition costs, but command a comparatively high retail price.
- Some types of product also carry a high risk of being counterfeited. They include:
- Cosmetics in general and fragrances in particular;
  - Clothes and shoes;
  - Fine beverages;
  - Cigarettes;
  - Spare parts and accessories for electronics;
  - Mobile telephones;
  - Computers hardware and software;
  - Various categories of medicine;
  - Some food products (eg, coffee);
  - Music and films (where counterfeiting is added to piracy).

Some services, such as maintenance and repairs, are also susceptible to be counterfeited.

So can counterfeiting be fought in Romania? Yes, definitely, as long as the efforts of the authorities are complemented by those of trademark owners, and as long as the risk factors outlined above are known. Then counterfeiting can be limited and, maybe, even eliminated.

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### IP Contacts:

Katarzyna Karcz (*Managing Director*)  
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Jolanta Hawrylak (*Patents and Designs*)  
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### PATPOL

P.O. Box 168,  
00-950 Warszawa, Poland  
Tel.: +48 22 644 96 57, +48 22 644 96 59  
Fax: +48 22 644 44 02, +48 22 644 96 00

[www.patpol.com.pl](http://www.patpol.com.pl)

[patpol@patpol.com.pl](mailto:patpol@patpol.com.pl)



The practice surrounding letters of consent in Poland is changing. Aleksandra Kryska, Patpol reports.

*Aleksandra Kryska*  
Patpol



In the trademark context, a letter of consent issued by the owner of a senior mark normally enables a junior applicant to overcome any objections to the registration of its mark that are made on the basis that the mark is similar or identical to the senior mark, and applies to the similar or identical goods or services.

However, the Law on Industrial Property contains only one provision regarding the granting of letters of consent.

It refers to the situation in which the protection of the senior mark, cited by the Polish Patent Office as an obstacle to the registration of a junior mark, lapsed because it had not been renewed, but its owner still gave his consent to the registration of the junior mark.

Pursuant to Article 132.1.3, a right of protection shall not be granted for a trademark in respect of goods of the same kind if the trademark is similar to a trademark earlier

registered in Poland, whose registration has terminated, provided that an interval between the date of lapse of the right of protection for the trademark and the date at which a similar mark has been applied for by another party is no longer than two years (on condition that the provisions of Article 133 do not apply). However, the aforesaid regulations shall not be applied if protection of the earlier mark has lapsed as a result of non-use, or the holder of the earlier right has given his consent to the grant of the right of protection for the later mark.

The Law on Industrial Property contains no further provision governing letters of consent given by the holders of valid trademark registrations to applicants for junior similar marks. Decisions on this issue were for a long time left to the Polish Patent Office.

Until only a few years ago, letters of consent granted by the

holders of earlier marks were frequently used as guarantees that a later mark would obtain registration, especially if the holders of such marks had capital, organisational or legal connections.

### No binding effect

The situation changed following a ruling of the Supreme Administrative Court of 20 December 2007 (Case No II GSK 279/07). In that judgment, the Supreme Administrative Court concurred with the first instance court, holding that the Law on Industrial Property does not explicitly regulate the impact that the consent of the holder of an earlier mark may have on the registration of a later applied mark. This means essentially that Article 4(5) of the First Trademarks Directive (89/104/EC) has not been implemented in Poland. According to that provision, in certain circumstances a decision to reject an application or cancel a registration shall not be made if the owner of an earlier mark has given its consent to the registration of the later mark. The Supreme Administrative Court stressed that the manner of transposing Article 4(5) is left to the discretion of the EU member states. According to Article 243 of the EU Treaty, a directive sets forth the objectives – or final effects to achieve – for the EU member states, leaving them to choose the means through which those targets will be reached. A directive is intended for the member states; its direct effect on individuals is an exception rather than a principle.

In view of the fact that no regulation replicating the content of Article 4(5) of the First Trademarks Directive has been introduced into the Polish legal system, one cannot claim that the Polish Patent Office has breached such a regulation in the course of registration proceedings. Therefore, the consent to the registration of a later mark given by the holder of an identical earlier mark in respect of identical goods has no binding legal effect under Polish law.

The above conclusions have been confirmed by various judgments of the District Administrative Court.

Thus, the Polish Patent Office refused to register the mark EXTASE on the ground that the earlier trademark EXTAZE EXOTIC NATURE was registered in respect of goods in the same Class 3. Subsequently, the applicant for the trademark EXTASE filed a complaint with the District Administrative Court. To support its claim, the complainant attached a letter of consent granted by the holder of the EXTAZE EXOTIC NATURE trademark. The claimant argued that both marks could coexist without the risk of confusion on the Polish market, and that EXTASE presented no threat to EXTAZE EXOTIC NATURE. The claimant further contended that the

Polish Patent Office should have taken the letter of consent into consideration and treat it as an argument in its favour.

In a ruling of 27 February 2008 (Case No VI/SA Wa 1548/07), the District Administrative Court upheld the earlier decision of the Polish Patent Office, holding that letters of consent impose no obligation on the office to grant protection in cases such as the one at issue. According to the court, currently binding regulations do not explicitly say what impact letters of consent should have upon issuing final decisions regarding the registration of trademarks that are in conflict with earlier registered marks.

### Consent with connection

The Polish Patent Office takes no account of letters of consent also in situations where the owner of the mark applied for and the owner of the earlier mark are part of the same capital group.

Thus, in a ruling of 21 June 2010 the District Administrative Court held that connections between the parties which signed a letter of consent may have an impact on whether to grant protection to a later trademark of one of those parties, in particular if those parties are undertakings with legal, organisational or financial connections. In such case, the issuance of a letter of consent should significantly influence the decision of the Polish Patent Office as to whether to grant protection. However, in the case discussed here, the parties belonged to the same capital group, which, the court reasoned, cannot be the only argument for granting protection to a conflicting trademark.

A capital group, in the legal sense, is a form of capital and non-capital integration of independent companies (provided for under civil and commercial regulations) that covers a dominant company controlling other participants in the multi-company organisation, including other dependent parties and associations.

In such a situation, as argued by the court, capital, organisational or personal connections between the applicant for a junior mark and the holder of a senior mark cannot be the only basis for granting protection to the conflicting trademark.

The existence of the above-mentioned connections on the date of application gives no guarantee that these connections will continue to exist throughout the term of protection. Such companies are separate and independent undertakings. The shares in capital companies are disposable, so their disposal may change the ownership balance between the companies and, consequently, disturb in the future the relationship between the companies, which are good on the date of application.

*“Capital groups are a particular form of business organisation where corporate supervision is performed at the level of both the group and individual companies.”*

In its ruling of 21 June 2010, the District Administrative Court also addressed the issue of a guarantee function of a trademark (ie, as a guarantee of quality). As argued by the court, the Polish Patent Office was correct in assuming that the protection of ordinary customers of the relevant goods should also have been taken into consideration – that is, the protection against the risk of confusing the mark for which registration is sought with the mark registered earlier. The function of a trademark is to distinguish the products or services of one undertaking from those of other undertakings. Consequently, the function of a mark is also to assure that the products under the mark have a certain quality, and that the purchasers of the products are not only convinced of that quality, but are also protected against incorrect evaluation of the features of those products. In the case at hand, the Polish Patent Office was not served any evidence that the quality of the goods bearing the mark in question would not change.

In view of the above, the court ruled that existing connections between companies belonging to the same capital group cannot be regarded in any circumstances as a guarantee of quality of the products to which the trademark in question applies. Capital groups are a particular form of business organisation where corporate supervision is performed at the level of both the group and individual companies. This means that the very affiliation to a capital group cannot lead to a conclusion that designations originating from related companies will not confuse customers.

According to its website, the Polish Patent Office examines each letter of consent and each new trademark application individually and on its own merits. In practice, letters of consent are regarded as an auxiliary tool for evaluating the risk of misleading ordinary customers. The Polish Patent Office has stressed that it is by no means bound by such consent issued by the holder of an earlier right; however, the office takes into consideration the consent during the evaluation of the risk of confusion between the marks. In general, the Polish Patent Office has in mind not only the producers’ but also the customers’ interests for whom the goods or services are intended. Therefore, if the Polish Patent Office comes to the conclusion that there is a risk that in the

course of ordinary economic activity customers may be misled as to the origin of the goods or services, the office will refuse to grant protection to the junior mark.

The Polish Patent Office adopts the same approach in situations where the parties are organisationally or financially connected. In such cases, customer confusion will not automatically be excluded. It is true that if the goods distributed by a parent company and a subsidiary are identical, confusion will be irrelevant to customers. However, this situation does not eliminate the fact that customers were misled. If trademarks have been registered in the name of the parent company and suddenly similar or identical marks are registered in the name of a subsidiary, consumers will certainly associate those marks with the parent company and original holder of the rights to such marks. As put forward by the Polish Patent Office, although the interest of neither the consumers nor the manufacturers will be damaged, the very fact of misleading consumers as to the origin of goods from a particular undertaking will have occurred.

The Polish Patent Office also argues that it is not able to examine the policy of the biggest concerns with regard to establishing the origin of goods offered by the respective companies within such a concern. Therefore, if several legally independent undertakings wish to register a similar mark, in compliance with the Law on Industrial Property they have to resort to either the institution of joined rights of protection or a licence.

## Analysis

Although the courts follow the same approach as the Polish Patent Office when it comes to letters of consent, it is still advisable to obtain and file such letters in the course of registration proceedings. In certain situations – for instance, where a trademark is such that the risk of misleading customers is not so obvious – the consent may prevail upon the Polish Patent Office to grant the right of protection. However, it does not concern situations where the marks in question and the goods or services marked therewith are identical.

Letters of consent are frequently issued not only to grant consent for trademark registration, but also to allow use on the Polish market. Therefore, even if a later mark fails to obtain registration, with a letter of consent its owner will still have certainty that it can use the mark on the market without any objections from the owner of the earlier mark.

**SEE OUR COMPANY PROFILE ON PAGE 28**

**THE WHEEL WAS ONE OF THE FIRST INVENTIONS . . .  
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# **CABINET ENPORA**

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*Our professional staff comprises counsellors, attorneys, supporting staff and off counsels as technical specialists members of international associations such as INTA, AIPPI, FICPI, ECTA, MARQUES and EPI with a background allowing a broad area of technical coverage.*

**e-mail:** [pop@patents.ro](mailto:pop@patents.ro)  
[pop@enpora.com](mailto:pop@enpora.com)

**Pfhone:** 00 40 21 230 0990/230 5461  
**Facsimile:** 0040 21 230 2311

**Website:**

[www.patents.ro](http://www.patents.ro)  
[www.enpora.com](http://www.enpora.com)

**Mail address:**  
PO Box 39-F1  
024330 Bucharest  
Romania

**Office (Courier) address:**  
52a George Cafinescu Street  
Ap. 1, 011694 Bucharest  
Romania



# The full effect of harmonisation



Trademark legislation in Romania is now in line with EU law. Nicoleta Tarchila, CABINET ENPORA explains how rights holders are affected.



Nicoleta Tarchila  
Cabinet Enpora

**T**hree years after the accession of Romania to the European Union, the local trademark legislation was harmonised with EU law. Law 66/2010 was adopted to implement the new EU Trademarks Directive (2008/95/EC). The trademark legislation thus consists now of Law 84/1998 as republished on 27 May 2010 (incorporating the amendments brought in by Law 66/2010), and the Implementing Regulations as amended by Government Decision 1134/2010.

The updated trademark legislation preserves some elements of the old examination and enforcement systems. However, it also gives rise to new challenges for trademark applicants and owners by removing one type of trademark examination, introducing shorter deadlines to take action before the Romanian Trademark Office, and creating a constant need to monitor registered rights.

## Single, stricter examination

As a consequence of the implementation of the EU Trademarks Directive, the only form of *ex officio* examination maintained by the new Romanian Trademark Law is the analysis of new applications on absolute grounds of refusal. However, applicants will not necessarily find it easier than in the past to overcome this sole level of examination. That is, on the one hand, because three new grounds of refusal have been added to existing ones. Thus, the following signs will now be refused registration:

- Trademarks that contain signs of high symbolic value, in particular religious symbols;
- Trademarks that contain, without the permission of the competent authorities, badges, emblems, or coats of arms or escutcheons, other than those covered by Article 6*ter* of the Paris Convention; and

- Trademarks that contain emblem, in whole or in part, owned by the European Council.

On the other hand, that is because there has been an increase in the number of provisional refusals on absolute grounds. One may conclude that the examiners of the Romanian Trademark Office pay more attention to applications and sometimes are even extreme in their analysis. Here are a few recent examples of trademark applications refused on absolute grounds:

- MAGICTIMES for goods in Classes 29, 30 and 32 – the denomination was found to lack distinctive character;
- CREATIVE TECHNOLOGIE for goods in Classes 7 and 12 – the sign was held to lack distinctive character and be a habitual term used in the course of trade to designate the characteristics of the protected goods; and
- GAME ALARM in Classes 9, 38, 41 and 42 – the phrase was considered a common term used in the course of trade to designate the quality and the characteristics of the protected goods and services.

### Heightened vigilance

On the whole, however, the examination system adopted through the new trademark legislation may be seen as favouring applicants whose chances to obtain trademark protection increase considerably given that the *ex officio* examination is limited to absolute grounds. Nevertheless, the job of these applicants, once they become trademark owners, is much more difficult than it was in the past because they are solely in charge of preserving their registered rights against new identical or similar registrations. Under the updated trademark legislation, relative grounds of refusal are no longer invoked *ex officio* during the examination procedure before the Romanian Trademark Office. The filing of oppositions is the only legal instrument that interested third parties have to enforce their earlier rights. This implies a constant monitoring of newly filed applications. One may even claim that maintaining exclusive rights in trademarks in Romania is nowadays totally dependent on the employment of a watch service. An additional issue for mark owners is that the legislation provides no recovery of costs in opposition cases.

*“Under the updated trademark legislation, relative grounds of refusal are no longer invoked ex officio during the examination procedure before the Romanian Trademark Office.”*

Interested third parties are not completely precluded from acting against new applications based on absolute grounds of refusal. A new course of action introduced by the updated trademark legislation is the filing of observations against new trademarks. The observations work as support material for the examiner who may take such observations into consideration while considering the application.

Observations are not subject to the payment of any kind of fees.

### Shorter timeframes

A new set of deadlines meant to speed up the examination procedure features in the new Trademark Law. The basic timeframe for taking action under the old provisions was three months. This term is maintained only for filing a reply to a provisional refusal issued following the *ex officio* examination. Any other actions now trigger several and noticeably shorter deadlines before the Romanian Trademark Office. Third parties may file observations and oppositions within two months of the date of publication of the trademark application. Applicants must file their response to observations and oppositions within 30 days of the date of notification of the observations/oppositions. Moreover, applicants may appeal any trademark examination decision before an appeal commission of the Romanian Trademark Office within 30 days of being notified of such decision.

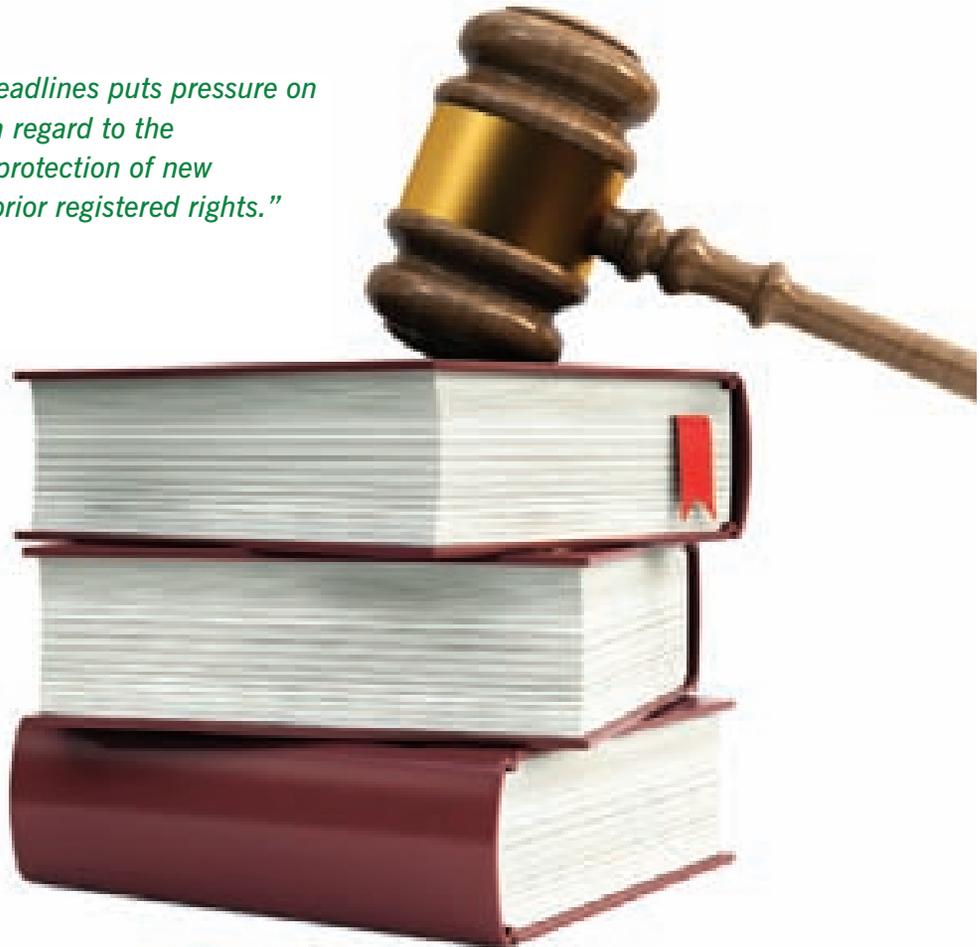
With regard to taking an action further before a court of law, the old legislation provided a deadline of 30 days, which was a waiver from the general civil procedure rules. By contrast, the new Trademark Law is in line with the general legislation and provides a deadline of 15 days from the date of communication for taking action against the final decisions of the Romanian Trademark Office.

Setting shorter deadlines puts pressure on rights holders with regard to the enforcement and protection of new applications and prior registered rights. However, the obvious advantage is that it enables the Romanian Trademark Office to meet its target to significantly reduce the period of time needed to register trademarks – namely, within six months of their application.

### Harmonised enforcement

Given that the rules on enforcement of trademarks rights provided by the old trademark legislation were already in line with EU legislation, no amendments were required in this respect. In fact, the way towards harmonised enforcement legislation was paved by the issuance of

*“Setting shorter deadlines puts pressure on rights holders with regard to the enforcement and protection of new applications and prior registered rights.”*



Emergency Government Ordinance 100/2005, which was adopted in order to implement the EU IP Enforcement Directive (2004/48/EC). The early implementation of the directive was part of Romania’s obligation to adopt the *acquis communautaire* in order to prepare for its accession to the European Union in January 2007. The most important amendments brought by the implementation legislation referred to:

- The persons entitled to file an application;
- The sampling of infringing goods;
- The possibility of requesting interlocutory injunctions against intermediaries (eg, transporters of counterfeit products); and
- Setting damages as either a lump sum or large scale publicity of the court’s decision.

The judgments of the European Court of Justice (ECJ) containing references for preliminary ruling on the

interpretation of EU laws are of significant importance for the daily practice of the Romanian Trademark Office and courts of law. Apart from their binding nature, these decisions also offer important guidelines for the national instances and furnish useful interpretation on several aspects of the laws in force. By way of example, a serious problem related to the enforcement of trademark rights was raised before national instances with respect to a conflict between trademarks and trade names. Different interpretations and approaches were given over the years by the courts. The lack of uniform interpretation of the legal provisions led to conflicting decisions. Nowadays, however, the Romanian jurisprudence follows the rules provided by the ECJ in *Céline Sarl v Céline SA* (Case C-17/06).

**SEE OUR COMPANY PROFILE ON PAGE 29**



# KN INTELLECTUAL PROPERTY

Protecting Intellectual Property Rights in South East Europe

Karanovic & Nikolic is a regional Corporate and IP law firm which has extended its practice within the countries of the former Yugoslavia. Karanovic & Nikolic serves clients in the area of intellectual property in Serbia, Montenegro, Bosnia and Herzegovina and Macedonia.

KN IP covers in particular:

**IP Services:** the registration of trademarks, designs and patents, the fight against piracy, border control protection, and the drafting of agreements on the transfer of rights etc.

**Related services:** the registration of pharmaceuticals, the review of various types of agreements in this area, the registration of internet domains, and issues regarding labeling etc.).

For any further information please feel free to contact us on the following e-mail addresses:



**dragomir.kojic@karanovic-nikolic.com**

Partner

**relja.mirkov@karanovic-nikolic.com**

Head of the Department in Serbia

**ana.pekevaska@karanovic-nikolic.com**

Head of the Department in Macedonia

**Belgrade Office:**

Resavska 23, 11000 Belgrade, Serbia

Tel. +381 11 3094 200; knserbia@karanovic-nikolic.com

**Banja Luka Office:**

Gunduliceva 4, 78000 Banja Luka, Bosnia & Herzegovina

Tel. +387 51 250 004; knbosnia@karanovic-nikolic.com

**Podgorica Office:**

Serdar Jola Piletica bb, 81000 Podgorica, Montenegro

Tel. +382 20 238 994; knmontenegro@karanovic-nikolic.com

**Skopje Office:**

Orce Nikolov 68, 1000 Skopje, Macedonia

Tel. +389 2 322 38 70; knmacedonia@karanovic-nikolic.com

**Sarajevo Office:**

Trg djece Sarajeva 1, BBI Centar, 71000 Sarajevo,

Bosnia & Herzegovina

Tel. +387 33 261535; Fax. +387 33 261547;



# System upgrades

IP legislation in the Balkans is changing rapidly. Tamara Bubalo, Karanovic & Nikolic highlights the most significant recent developments.

*Tamara Bubalo  
Karanovic & Nikolic*



**T**his article provides an overview of the legislative updates in key jurisdictions of the Balkan region. It describes in some detail the mechanisms of border control with regard to trademark counterfeiting in the countries discussed, and considers the anti-piracy initiatives launched in Serbia.

## Bosnia and Herzegovina

The legal regime of Bosnia and Herzegovina regarding the protection of IP rights consists of the following laws applicable as of January 1 2011:

- The Law on Copyright and Related Rights,
- The Law on Collective Management of Copyright and Related Rights;
- The Law on the Protection of Indications of Geographical Origin;
- The Law on the Protection of Topographies of Integrated Circuits;

- The Law on Industrial Designs;
- The Law on Trademarks; and
- The Patent Law.

Additionally, since 1 December 2004 it has been possible to extend the protection conferred by European patent applications and registrations to Bosnia and Herzegovina.

On 24 September 2008 Bosnia and Herzegovina acceded to the Geneva Act of the Hague Agreement on the International Registration of Industrial Designs; on 27 October 2008 the country also acceded to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks.

Furthermore, Bosnia and Herzegovina became the 69th member state of the World IP Organisation Performances and Phonograms Treaty, which entered into force in that country on 25 November 2010.

The above-mentioned developments are indicative of



Bosnia and Herzegovina's progress toward harmonisation with the EU legal framework and convergence with global trends in the field of IP protection.

### **Macedonia**

The regulatory framework for IP rights in the Former Yugoslav Republic of Macedonia consists of the following laws, which have been extensively revised and updated in the past few years:

- The Industrial Property Law (2009), revised upon Macedonia's ratification of the European Patent Convention and becoming a member of the European Patent Organisation on January 1 2009;
- The Law on Copyright and Related Rights (1996, amended in 1998, 2002, 2005 and 2007);
- The Law on Protection of Topographies of Integrated Circuits (1998, amended in 2006);
- The Plant Variety Law (2000); and
- The Law on Customs Measures for the Protection of IP Rights (2005).

Additionally, on 6 July 2010 Macedonia ratified the Singapore Treaty on the Law of Trademarks and deposited its instrument of accession to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration. The Singapore Treaty and the Lisbon Agreement both entered into force in Macedonia on 6 October 2010.

### **Montenegro**

Upon the declaration of independence and termination of the state union of Serbia and Montenegro in June 2006, the Republic of Montenegro amended its IP legal framework to add provisions dealing with specific forms of IP right to the statutes that had been enacted at the time of the union with Serbia. The IP legal framework now consists of the following:

- The Law on Patents (2008);
- The Law on Trademarks (2004);
- The Law on Geographical Origin Markings (2008);
- The Law on Protection of Topographies of Integrated Circuits (2004);
- The Law on Designs Legal Protection (2004); and
- The Law on Copyright and Related Rights (2004).

Additionally, on 13 February 2009 Montenegro signed the Agreement on Extension of European Patents. The agreement, which entered into force in Montenegro on 1 March 2010, extends the protection conferred by European patent applications and registrations to the territory of Montenegro.

Rights arising from patents, petty patents, trademarks, designs or topography applications that were still pending on 28 May 2008 – the date on which the Intellectual Property Office of Montenegro was established – are valid in Montenegro as of their filing or priority dates, provided that the applicant filed a request for registration of its rights before 28 May 2009. Serbian registrations granted before May 28 2008 are automatically valid in Montenegro, without having to file a request for re-registration, until the registration is due for renewal. IP rights holders are advised to request a certificate of registration as a proof of their rights in this new jurisdiction.

*“Border control mechanisms are being successfully implemented, with the support of the relevant legislation.”*

## Serbia

The regulatory field for the protection of IP rights in the Republic of Serbia has undergone significant changes in the past two years. A set of new laws has been adopted:

- The Law on Copyright and Related Rights;
- The Law on Trademarks;
- The Law on Legal Protection of Industrial Designs;
- The Law on Topographies of Integrated Circuits; and
- The Law on Indications of Geographical Origin.

The only statute that has not yet been amended since coming into force in 2004 is the Law on Patents.

Such significant changes in the legal framework also come as a result of the Stabilisation-Association Agreement between Serbia and the European Union. The agreement requires, among other things, the full harmonisation of the Serbian IP-related laws with the laws and regulations of the European Union.

Additionally, Serbia became a member of the European Patent Organisation (EPO) on 1 October 2010, on the basis of which Serbia has acquired full membership of the committees and working bodies of the EPO. Serbia also acceded to the Singapore Treaty on the Law of Trademarks on 19 August 2010.

## Border control

Border control mechanisms are being successfully implemented in the aforementioned jurisdictions, with the support of the relevant legislation. Hence, all trademark holders, applicants or exclusive licence holders may file a

request for trademark protection at a state border with the relevant customs authorities. Whenever there exists *prima facie* evidence that a trademark has been infringed, the customs authorities are empowered *ex officio*, or upon request of the trademark holder, to temporarily seize all goods that are either the object or means of an IP rights infringement. The customs officers must notify without delay the rights holder, the relevant national IP office and any other interested parties of the measures taken.

This notification is very important because it includes an invitation to the holder of the IP rights to initiate the proceedings for protection of its rights before the relevant court, and to inform the customs authorities of either the proceedings initiated or the preliminary injunction issued by the court.

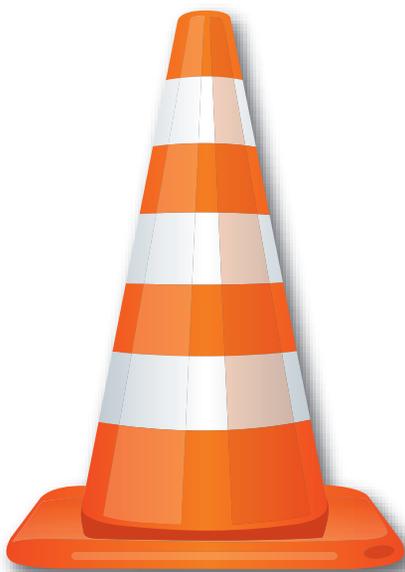
The time limit for the rights holder to act in accordance with such invitation is 15 days from the day when it receives the notification (this period can be extended by a further 15 days). The goods that have been temporarily seized may be finally confiscated and destroyed on the basis of either the court's decision or *ex officio* by the customs authorities. The methods of such final disposal include donation for humanitarian purposes and sale for the purposes of recycling.

## Serbian anti-piracy initiatives

The Business Software Alliance (BSA) – a trade group established in 1988 and representing a number of the world's largest software manufacturers – became active in Serbia in 2002. Since then, the BSA's goal has been to implement efficient measures to reduce the levels of software piracy. It is estimated that over 74% of companies in Serbia used some form of illegal software in 2010.

As a consequence, over the past few months the BSA has negotiated a cooperation agreement with the Serbian Tax Administration in order to increase the number of inspections to verify the legality of software. As part of the agreement, a special software inspection unit has been created and trained within the Tax Administration.

Additionally, the creation of the role of special prosecutor for cyber crime should also help fight piracy. While the appointment of an individual to this role is pending, a department manager is charged with addressing cyber crime, among other duties and competences.



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**IP AND LAW FIRM  
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agencies

■ Office address:  
Business Centre  
“Olimpiysky”  
72 Chervonoarmiyska Str.,  
03150 Kiev, Ukraine

■ Tel: +380 (44) 451 83 40  
+380 (44) 593 96 93  
Fax: +380 (44) 451 40 48  
E-mail:  
pakharenko@pakharenko.kiev.ua

■ Postal address:  
P.O. Box 78,  
03150 Kiev, Ukraine

# Company profiles

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## Product range

### Practice covers provided:

- ✓ Preparing new patent applications
- ✓ Prosecuting patent applications before the EPO and the Hungarian IP Office
- ✓ Searching prior art
- ✓ Enforcing patent rights
- ✓ Filing and prosecution CTM and national trademark applications
- ✓ Searching services for trademarks and designs
- ✓ Enforcing trademark rights
- ✓ Domain name disputes
- ✓ Counselling in all IP-related matters

## Company contacts

### Address:

H-1051 Budapest, Bajcsy-Zsilinszky út 16,  
Hungary

H-1368 Budapest 5, POB 198, Hungary

### Contacts:

**Michael Lantos**, Managing Partner

e-mail: [lantos@danubia.hu](mailto:lantos@danubia.hu)

Phone: (+36 1) 411 8716

**Dr. Árpád Pethő**, Deputy Managing Partner

Head: Pharma, Biotech and Chemical  
Division

e-mail: [petho@danubia.com](mailto:petho@danubia.com)

Phone: (+36 1) 411 8857

**Dr. Gábor Harangozó**,

Deputy Managing Partner

Head: Engineering, Electronics and Physics  
Division

e-mail: [gabriel@danubia.hu](mailto:gabriel@danubia.hu)

Phone: (+36 1) 411 8714

## Company profile

DANUBIA is the oldest and largest IP Law firm in Hungary, owner of several awards and provides service for domestic and foreign clients in Hungary and for Hungarian and foreign clients before the EPO and OHIM and in other countries in obtaining and defending their IP rights. DANUBIA is a full service IP Law firm and therefore works in all segments of IP Law. Our patent attorneys have qualifications covering all fields of technology, and the lawyers are specialised in respective fields within IP, and all needs of the client are dealt with by professionals having the highest education and practice in that specific field. In complex cases ad hoc teams are created that match the need of the cases to be handled.

For major foreign multinational companies DANUBIA provides services in obtaining IP rights in Hungary, and defend and protect their patent and trademark rights. The services include counselling, pre-trial consultation and elaborating optimum strategy for litigation. The activities are broad and include protection of domain names, filing domain name oppositions and litigating infringement by the net, and continued with classical patent infringement, trademark infringement proceedings and inspecting the market for detecting potential infringers.

For medium and small size overseas companies DANUBIA acts as representative before the European Patent Office in obtaining and defending their European Patent applications and also before the OHIM to obtain them community trademarks and registered community designs.

For innovative small and medium domestic entities, assistance is provided from the birth of an innovation till obtaining a well tailored IP protection for such innovations. Assistance is also given in preparing and concluding license agreements.

## Product portfolio

### Patents

- Preparing new patent specifications based on client's instructions
- Representing clients in prosecution and opposition (nullity proceedings) before the EPO and the Hungarian IP Office
- Enforcing patent rights before the competent courts, predominantly in Hungary
- Validating granted European Patents in Hungary

### Trademarks and designs

- Filing and prosecuting national, CTM and international trademark and design applications
- Searching existing or similar rights with or without opinion
- Enforcing trademark and design rights before the courts
- Providing pre-trial opinions and counselling in elaborating an efficient IP strategy

[www.danubia.com](http://www.danubia.com)

# ROMINVENT



## Product range

### Practice covers provided:

- ✓ Patents
- ✓ Trademarks and geographical indications
- ✓ Industrial designs
- ✓ Utility models
- ✓ Integrated circuits topographies
- ✓ Consultancy
- ✓ Searches

## Company contacts

### Head office address:

35, Ermil Pangratti str., 1st Floor,  
Sector 1, Postal Code 011882,  
Bucharest, Romania  
Tel: +4021-2312515/2312541  
Fax: +4021-2312550/2312454  
E-mail address: office@rominvent.ro  
Website: www.rominvent.ro

### Contacts:

**Lucian Enescu**, General Manager  
(lenescu@rominvent.ro)

**Stefan Cocos**, Dep. General Manager  
(scocos@rominvent.ro)

**Mihaela Teodorescu**, Patents and  
Industrial Designs Dept. Manager  
(mteodorescu@rominvent.ro)

**Ion Mocanu**, Trademark and Legal  
Department Manager  
(imocanu@rominvent.ro)

**Camelia Olteanu**, Accounting  
Department Manager  
(colteanu@rominvent.ro)

## Company profile

Established in 1953, in order to assist national and international companies, ROMINVENT is the oldest Romanian agency with outstanding achievements in the field of industrial property protection.

As a consequence, ROMINVENT is dedicated exclusively to IP and acts as a registered patent and trademark attorneys company before the WIPO, EPO, OHIM and ROPTO (Romanian Patents and Trademark Office).

Having a long tradition, ROMINVENT has build up a strong local and international image, being now a dynamic group with a new identity in concordance with new market economy lines.

The agency's experience and involvement into the industrial property matters has rewarded us both on national and international level.

## Product portfolio

### Legal capabilities

ROMINVENT offers a full range of services relating to the protection of industrial property rights in Romania and abroad concerning with:

- Patents
- Trademarks and geographical indications
- Industrial designs
- Utility models
- Integrated circuits topographies

These constitute the services needed by the clients to conduct an efficient IP policy, in particular: counselling; protection, oppositions, searches, licensing; co-existence agreements, IP litigations, legal/technical advices, negotiations.

### Consultancy

The ROMINVENT attorneys are able to assist clients on all aspects of patents, trademarks, industrial design, integrated circuits topography and any other property rights.

### Searches

ROMINVENT provides searching services for trademarks (documentary and availability searches, with or without legal opinion, prior rights and portfolio searches for national, international and community trademarks).

[www.rominvent.ro](http://www.rominvent.ro)

# PATPOL



## Product range

### Practice covers provided:

- ✓ IP protection and enforcement
- ✓ Filing and prosecuting national, CTM and international trade mark and design applications
- ✓ Preparing new patent applications
- ✓ Searching service for trademarks and designs
- ✓ Counselling in all IP-related matters
- ✓ IP enforcement
- ✓ Litigation and related matters
- ✓ Anti-counterfeiting
- ✓ Customs seizures
- ✓ Domain name disputes

## Company contacts

### Postal address:

PATPOL, P.O. Box 168  
00-950 Warszawa, Poland

### Office address:

PATPOL, 162J, Nowoursynowska  
02-776 Warszawa, Poland

Tel: +48 22 64496 57  
+48 22 644 96 59

Fax: +48 22 644 9600  
+48 22 644 44 02

www.patpol.com.pl  
patpol@patpol.com.pl

### Contacts:

**Mrs. Katarzyna Karcz**, Managing Dir.

**Mrs. Anna Zakrocka**, Trade Marks

**Mrs. Jolanta Hawrylak**,  
Patents and Designs

**Mr. Bartek Kochlewski**, Enforcement

## Company profile

PATPOL is one of the leading firms in the field of industrial property in Poland. Since 1966 we have provided assistance to clients from all over the world basing on experience and the highest quality of our services.

Our team is the source of our success. It is both stable and growing. In addition to those who have stayed with the firm for years, new people with fresh look and ideas join us to start and develop their professional careers. This combination makes us open to new challenges of the IP world and contributes to the improvement of our efficiency.

PATPOL employs patent attorneys, engineers and translators having backgrounds in all main fields of technology as well as lawyers specializing in IP matters.

We represent clients before the Polish Patent Office, Polish administrative bodies and civil courts, the European Patent Office (EPO) and the Office for Harmonization in the Internal Market (OHIM).

You can find us in AIPPI, INTA, ECTA, MARQUES, FICPI, LES, ITMA, ASIPI and ICC.

In appreciation of our work we are regularly invited to share our knowledge by contributing to the leading IP international publications.

Since 1998 we have been repeatedly recognized by Managing Intellectual Property Magazine as a leading IP firm in trade mark and patent work, receiving among other titles the Poland IP Firm of the Year 2007 award.

## Product portfolio

### IP PROTECTION AND ENFORCEMENT

- EUROPEAN AND POLISH PATENTS INCLUDING BIOTECHNOLOGICAL AND PHARMACEUTICAL INVENTIONS, GENETIC ENGINEERING
- VALIDATION OF EUROPEAN PATENTS IN POLAND
- UTILITY MODELS
- COMMUNITY AND POLISH TRADE MARKS AND DESIGNS
- DOMAIN NAMES
- GEOGRAPHICAL INDICATIONS
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- LITIGATION AND RELATED MATTERS
- ANTI-COUNTERFEITING
- CUSTOMS SEIZURES
- PATENT AND TRADEMARK SEARCHES
- WATCHING SERVICES
- LICENSE AGREEMENTS
- COUNSELLING

[www.patpol.com.pl](http://www.patpol.com.pl)

# CABINET ENPORA



## Product range

### Practice covers provided:

- ✓ Litigation in Romania related to infringement and or counterfeit and nullity of patents, trademarks or designs, unfair competition.
- ✓ Representation before Romanian Custom Authorities for infringement or counterfeit matters.
- ✓ Enforcement of IP Rights in the pharmaceutical field, including but not limited to advice on validity and infringement prior to a litigation, SPC matters.
- ✓ Agreements and contracts: aspects pertaining to industrial property, including assignment and licences.

## Company contacts

### Address:

52A George Calinescu Str. Suite 1,  
Distr. 1, 011694, Bucharest, Romania  
PO Box 39 F1, 024330, Bucharest,  
Romania

### Contacts:

#### Virginia-Daisy POP

Senior Partner, founder of the firm  
e-mail: [pop@patents.ro](mailto:pop@patents.ro)  
Phone: (+4 021) 230 0990

**Calin Radu POP** - Managing Partner,  
senior registered Patent and Trademark  
Counsel

e-mail: [cpop@enpora.com](mailto:cpop@enpora.com)  
Phone: (+4 021) 230 0990

**Nicoleta Tarchila** - Senior Associate,  
Attorney at Law and registered Patent  
and Trademark Counsel

e-mail: [ntarchila@enpora.com](mailto:ntarchila@enpora.com)  
Phone: (+4 021) 230 5461

## Company profile

Our firm was established in 1990 being the first private IP agency in Romania.

CABINET ENPORA has now a very extended clients portfolio all over the world, over 500 companies or law firms for which we have registered over 2000 patents and over 3000 trademarks.

We represent our Clients directly before the Romanian Patent & Trademark Office (ROPTO), the European Patent Office (EPO), the World Intellectual Property Organization (WIPO) and the Office for Harmonization of the Internal Market (OHIM).

Our goal is to provide top quality client orientated services focused on each client particulars at international standards.

Our professional staff comprises counselors, attorneys, supporting staff and off counsels as technical specialists members of international associations such as INTA, AIPPI, FICPI, ECTA, MARQUES and EPI with a background allowing a broad area of technical coverage.

Besides our internal professional team we are supported by a number of specialized experts in different technical fields. Also, from time to time and for special cases our firm collaborates with the most prestigious law firms in Romania.

## Product portfolio

Our firm practices in all aspects of intellectual property including:

- Drafting, filing and prosecuting domestic and foreign patent, trademark and design applications
- Maintenance and renewal of patents, designs and trademarks
- Extension to Romania of European Patents
- Intellectual property litigations comprising patent, trademark and design infringement
- Patent and trademark opposition, cancellation actions, unfair competition, counterfeiting
- Patent trademark and industrial design agreements including assignments, franchise and licensing
- Layout designs of integrated circuits
- Management of industrial property rights
- Watching services
- Custom enforcement
- Computer assisted management
- Technical translations

Referring now to the language please note that our firm provides services in Romanian, English, French and German.

[www.enpora.com](http://www.enpora.com)

# KARANOVIC & NIKOLIC

## Product range

### Practice covers provided:

- ✓ Trademarks
- ✓ Copyright
- ✓ Licensing
- ✓ Technology transfer
- ✓ Transaction services
- ✓ Litigation and Dispute Resolution
- ✓ Anti-Counterfeiting and Enforcement

## Company contacts

### Contact:

**Dragomir Kojic**, Regional Partner  
knserbia@karanovic-nikolic.com

### Serbia Office:

Resavska 7, 11000 Belgrade, Serbia  
Tel: +381 11 3094 200  
Fax: +381 11 3094 223  
knserbia@karanovic-nikolic.com

### Bosnia and Herzegovina Offices:

Gunduliceva 4, 78000 Banja Luka,  
Bosnia and Herzegovina  
Tel: +387 51 303 100  
Fax: +387 51 304 999  
knbosnia@karanovic-nikolic.com  
Trg djece Sarajeva 1, BBI Centar,  
71000 Sarajevo  
Tel: +387 33 261 535  
Fax: +387 33 261 547  
knbosnia@karanovic-nikolic.com

### Montenegro Office:

Serdar Jola Piletica bb, "Palada" Building  
81000 Podgorica, Montenegro  
Tel: +382 20 238 994  
Fax: +382 20 238 984  
knmontenegro@karanovic-nikolic.com

### Macedonia Office:

Orce Nikolov 68, 1000 Skopje, Macedonia  
Tel: +389 2 322 38 70  
Fax: +389 2 322 38 71  
knmacedonia@karanovic-nikolic.com

## Company profile

KARANOVIC & NIKOLIC Law Office is a market leader practicing intellectual property law in South-East Europe with the offices in Serbia, Bosnia & Herzegovina, Montenegro and Macedonia. The combined experience of our IP lawyers and commercial specialists is unrivalled in the markets in which we operate.

We advise our clients on a wide range of issues relating to legal requirements for IP rights protection, provide them with the best solutions for obtaining and enforcing of IP rights, as well as with the most efficient mechanisms for overcoming any challenges which the local markets might impose.

In the field of trademark, design and patent protection procedures, we evaluate suitability of trademark, design and patent protection, and carry out detailed searches in Serbia, Montenegro, Bosnia and Macedonia.

In the field of copyright protection, our office provides a comprehensive legal services relating to copyright including issues like copyright ownership, exploitation, licensing and legal protection in the cases of copyright infringing actions.

KARANOVIC & NIKOLIC Law Office is also known for having an extensive practice in the areas of intellectual property rights enforcement, anti-counterfeiting and anti-piracy initiatives. Hence, an important part of such practice revolves around the work for Business Software Alliance including a wide range of legal actions against infringers of software copyright, from infringement warnings to criminal and civil law proceedings.

KARANOVIC & NIKOLIC Law Office furthermore assists its clients in all phases of IP litigation. We initiate and conduct the legal proceedings necessary for protection of our clients' interest. Joint work and combination of our IP and Dispute Resolution departments' efforts and skills is a highly effective mechanism which provides efficient and successful protection.

Our Office effectively creates, develops, manages and maintains clients' intellectual property portfolios and advises on the best strategies for their implementation and exploitation. Our IP lawyers, together with our corporate lawyers, actively participate in the due diligence procedures in order to identify and evaluate intellectual property assets and anticipate IP related risks.

We also advise clients on all aspects of the acquisition and exploitation of intellectual property rights.



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