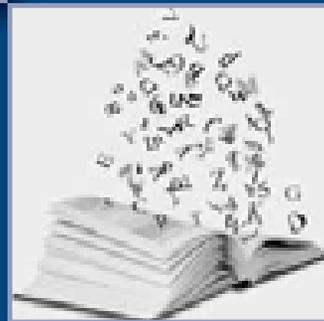


Eastern Europe

IP Guide

2012

1st Edition



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Welcome

The second annual *Eastern European IP Guide* will tell you everything you need to know about trademark and intellectual property law and practice in the rapidly developing Eastern European markets.

We have assembled a host of thought leaders from Romania and beyond to analyse and explain the latest movements in the region's trademark law, from recent case studies to legal grey areas.

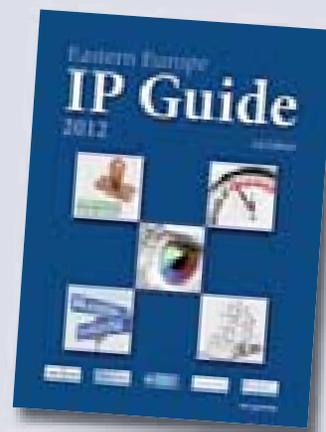
Our report opens with Dr. Andra Musatescu of Andra Musatescu Law & Industrial Property Offices, who uses the example of *Milupa vs Milapo* to demonstrate Romania's take on the inherent and acquired distinctiveness of trademarking, while his colleague Nicolae Muresan uses the ground-breaking result of a recent pharmaceutical case as an example of how far the country has come. But there are still a few grey areas in Romanian patent law which need to be addressed, as Rominvent's European trademarks and designs attorney Denisa Markusev explains.

On page 19, Margareta Oproiu of Cabinet M. Oproiu also weighs in on Romanian trademark legislation, looking at the triple-tiered structure of the civil court system consists of three levels of jurisdiction and the challenges of enforcement. Meanwhile, Cabinet Enpora's Nicoleta Tarchila looks at the not insignificant burden of registering single colours as trademarks.

And elsewhere in the region, sweeping changes are being made in Bosnia and Herzegovina, Macedonia, Montenegro, Serbia, Kosovo and Croatia. A series of new and amended laws have been introduced to keep up with the competitive EU standards and the rapid modernisation of the business and legal environment.

This report demonstrates the rapidly evolving trademark laws across Eastern Europe, spurred by a generation of budding entrepreneurs and globalising businesses.

From colour trademark to pharmaceuticals, trademark law is taking on a new shape in Eastern Europe, and legislators are obviously working hard to keep up with the changes.



EASTERN EUROPE IP GUIDE 2012 1st Edition

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ROMANIA

REPUBLIC OF MOLDOVA

EUROPEAN UNION

Andra Musatescu Law & Industrial Property Offices is full service and lauded by clients for “the quality of its language skills and the flexibility and personalisation of service. Its main strength is in IP” (Legal 500). Dr. Andra Musatescu is “an IP expert of ‘the absolutely highest standard’ (Legal 500), “a fantastic lawyer” (Chambers and Partners), “a true expert at what she does” (WTR1000) and “one of the best external legal counsel to be found anywhere” (WTR1000).

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Romania

Brand distinction



Romania: Trademark inherent and acquired distinctiveness seen by the Romanian courts.

Dr. Andra Musatescu
Andra Musatescu
Law & Industrial
Property Offices



Nutricia International B.V. ('Nutricia'), part of the Danone Group, represented by *Andra Musatescu Law & Industrial Property Offices*, has just obtained a positive decision in an annulment action brought against a local producer of milk and milk products, S.C. Avi Seb Impex SRL ('Avi').

MILUPA vs. MILAPO

The facts of the case:

Avi has registered with the Romanian Trademark Office a 'milapo with device' trademark



for all the products in Class 29, including milk and milk products.

Nutricia is the owner of the following trademarks:

- Milupa Community trademark 007198773 word mark, being registered, *inter alia*, for "dietetic substances adapted for medical use; food for babies" in class 5 and "milk and milk products" in Class 29;
- Milupa Community trademark 006651939



being registered, *inter alia*, for "dietetic substances adapted for medical use; food for babies" in class 5 and all the products in Class 29 and



- Milupa Community trademark 005065156



being registered, *inter alia*, for “dietetic substances adapted for medical use; food for babies” in Class 5.

Nutricia considered that its prior trademark rights are infringed by Avi’s registration, especially taking into account the inherent and acquired distinctiveness by use in Romania of the Milupa trademarks and, therefore, decided to file an annulment action against the registration by Avi of the ‘milapo with device’ trademark.

Arguments:

Nutricia’s arguments in court were extensive, *including but not limited to*, similarity of the trademarks compared, the high distinctiveness of the CTMs which was not only inherent, but also acquired by extensive use of the CTMs in Romania evidenced by volume sales, surveys and amount of advertising and marketing undertaken in Romania in connection with the brand, the beginning of the trademark being of a high importance, the identity for some of the products and the similarity for the remaining of the products for which the analyzed trademarks were registered, risk of confusion and association.

Findings of the court:

In judgment 204 A/2011, the Bucharest Court of Appeal decided that (1) the principle applicable in appreciating the verbal similarity is that the beginning of the trademark is of a high importance and taking into account that the compared trademarks have the same prefix ‘mil’, the trademark are similar; (2) the Milupa trademarks have ‘a certain degree of distinctiveness which cannot be contested’ and (3) the risk of association is clear as there is the possibility that the consumers to consider that there is a link between the previous trademark and the contested mark.

Comments:

We consider the decision of the court as of quite high importance, not only for Nutricia which invested large sums of money in establishing a reputation for its Milupa trademarks in Romania, but also **as a precedent as we persuaded the Romanian court to confirm that Milupa has high distinctiveness in Romania.**

The decision of the Bucharest Court of Appeal is final and binding and will most probably be followed by other courts.

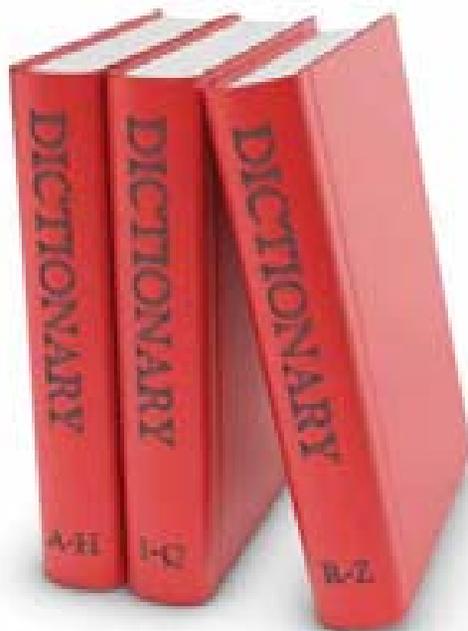
In this respect, our firm’s personal view is that more pharmaceutical and nutritional companies can now take similar actions based on this case and to rely on their previous well-known trademarks or registered renown trademarks to request the annulment of other identical or similar trademarks, provided that such identical or similar trademarks are within the 5 years status of limitation period provided by law.

SEE OUR COMPANY PROFILE ON PAGE 26



Republic of Moldova

Between the Lines



Republic of Moldova: Non-descriptiveness and inexistence of the risk of confusion in the mind of consumers in pharmaceutical cases.



Nicolae Muresan
Andra Musatescu Law & Industrial Property Offices

EGIS Gyogyszergyar Nyilvanosan Mukodo Reszvenytarsasag (EGIS), represented by *Andra Musatescu Law & Industrial Property Offices* in association, has just obtained a positive decision from the Moldavian Trademark Office (AGEPI).

Facts of the case:

AGEPI issued a provisional refusal for the international trademark AMENT, which was considered by the Trademark Office as (1) descriptive for the medicines for treatment of the mental diseases and (2) that there is a risk of confusing the consumers regarding other pharmaceutical preparations for human purposes.

Arguments:

Our arguments were based mainly on the following:

- (1) in most dictionaries 'ament' is not defined by anything related to 'mental illness' or 'a person suffering of a mental illness';
- (2) in a dictionary it is clearly stated that the word 'amentia' has been used in the past to describe 'a mental illness' and

- (3) only Moldova issued a provisional refusal on such grounds, we consider that there are fair chances to overcome the *ex officio* objection.

Findings of the Trademark Office:

Further to the arguments brought before it, the Office issued a final decision in favour of EGIS, overturning its provisional refusal.

Comments:

We consider the final decision of the Trademark Office as of grounded and as of importance, not only for EGIS, which is now able to use the same trademark in all of the countries where the protection was requested (e.g. Poland, Czech Republic, Romania, Bulgaria etc.) *via* the international registration, but also as a precedent. In this respect, our view is that AGEPI will take this decision into account in future similar cases.

SEE OUR COMPANY PROFILE ON PAGE 26



ROMINVENT

INDUSTRIAL PROPERTY AGENCY - ESTABLISHED IN 1953

ROMINVENT S.A., established in 1953, is one of the most prominent agency engaged in the practice of industrial property laws in Romania, providing its Romanian and foreign clients with counseling and representation, in view of acquiring and defending the IP rights, also before ROPTO, OEB, WIPO and OHIM authorities.

Moreover, ROMINVENT ensures the representation of its clients before the courts of law, at all judicial levels, in legal proceedings specific in the IP field.

ROMINVENT is a member of some international associations such as: INTA, AIPPI, LES, ACG, ECTA, ICC-CIB, ICC-IP Committee.

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Romania's most recent trademark law goes some way towards clarifying the copyrighting process. But there are still a few grey areas which are worth paying attention to, according to *Rominvent's* European trademarks and designs attorney Denisa Markusev.



Denisa Markusev
Rominvent

On 10 May 2010, the new amended Romanian Trademark Law came into force. The text intends to be duly harmonised with Directive 2008/95/CE, however, there are also original provisions.

The new law introduces into the definition of the trademark, new kinds of signs such as holograms or sound signals.

The definition of the notorious trademark has also slightly changed, with the new text specifically mentioning that it is sufficient to simply demonstrate that the trademark is known by the Romanian consumer, without any additional condition of registrability or use.

However, the most important change in the legal provisions refers to the opposition procedure.

Within two months of the application's publication date

(which, according the implementing regulations, will be provided in electronic format on ROPTO website within seven days of the request filing date), any interested person may file an opposition to the registration of a trademark on relative grounds. The previous term for opposition was three months.

It's all relative

Apart from the 'standard' grounds, which refer to the identity or similarity of goods and products, notoriety of trademarks for identical, similar or different goods; new relative grounds are mentioned in the law covering earlier rights including a name, image, copyright, collective mark conferring a right which expired at least three years ago; a certification mark of validity which has been lapsed for 10 years; earlier



trademarks registered for identical or similar goods or services, conferring a right which has expired or has failed to be renewed within two years of its expiration date; and the rights on a trademark which was in use abroad and continues to be used there, where the application was made with bad faith by the applicant.

The examination of relative grounds is no longer conducted by ROPTO, which will examine only the absolute grounds of refusal, which within the previous grounds now includes two new provisions, namely those referring to refusal of a trademark if it contains signs of high symbolic value (in particular religious symbols) or if it contains, without the permission of competent authorities, badges, emblems, coats of arms or escutcheons, other than those covered by 'Article 6ter' of the Paris Convention.

Observations regarding the absolute grounds may also be filed within the two months term by any interested party. However, according to the same regulations, the person referred to cannot have the status of 'party' in the examination procedure and shall not receive any communication from ROPTO. The observation will be notified to the applicant who may present his comments within the examination procedure. The observation shall then be analysed during the procedure of examination of the trademark registration application.

Within 30 days of the date the opposition was notified, the applicant may file his argument in order to defend its application (the term is not extendible).

The opposition shall be settled by a board comprising three specialists appointed by the head of the trademark division, one of them being the examiner of the trademark registration application.

The board shall issue advice on admittance or rejection of opposition, either wholly or in part, as a compulsory requirement within the substantive examination, which shall be mentioned in the decision to admit or to refuse trademark registration.

The ROPTO decisions concerning the applications for the registration of trademarks may be appealed by any interested person within 30 days of the communication or the publication of the trademark registration, upon the payment of the legal fee (instead of three months). So if the examination of the application carried out shows that the conditions prescribed by the law are satisfied, ROPTO shall decide to register the trademark.

The trademark shall be published in the Official Industrial Property Bulletin, in electronic format, within two months of the date of the registration decision and OSIM shall issue the trademark registration certificate only after payment of the publication and issuance fees.

Also, the implementing regulations provide that the record of the trademark registration into the register, the publication thereof and the issuance of the trademark registration certificate shall be subject to payment of a single fee.

At the same time, the ROPTO decisions concerning applications for the registration of trademarks may be appealed by any interested party within 30 days of communication or the publication of the trademark registration, upon the payment of the legal fee (instead of three months as provided by the previous law).

Grey areas

At this point, there are situations when trademarks enter into 'no man's land'.

The practice stated that, even if an opposition has not been filed within the two months, an appeal may be filed 'by any interested party' (apart from the opponent, any other party may be considered as 'interested'), and, as a consequence, accepted and examined, following the appeal procedure under the judgment of Re-examination Commission.

However, the legal text refers to two different moments when the appeal term may be counted: 'within 30 days of communication' (in case of a previous filed opposition) and 'within 30 days of the publication of the trademark registration', since the trademark should be published for registration within two months of the date of the registration decision.

The record of the trademark registration into the Trademark Register, the publication thereof and the issuance of the trademark registration certificate shall be subject to payment of a single fee.

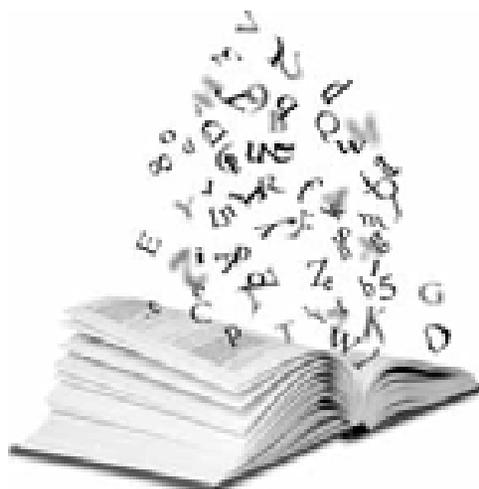
The effect of a trademark situated in 'no man's land' appears when the applicant does not pay this single fee required for the final registration.

As long as there is no legal period within the payment to be submitted and no sanction for non-payment, the solicitor cannot be persuaded to pay the fee.

This means that no appeal may be filed against a registration decision issued by ROPTO until this decision is published in the Official Gazette and no registration will be recorded into the Trademark Register as long as the fee is not paid.

As long as the trademark is not registered nor published for registration and no certificate is issued, it is interesting to analyse if there are other means apart the appeal procedure, to protect the previous rights.

The legal text also offers the possibility regarding any



concerned person to apply to the Law Court of Bucharest for invalidation of the registration of a trademark on various grounds, such as registration contrary to any of the absolute or relative grounds; registration applied for in bad faith; infringement of personal portrayal or name, protected geographical indication or a protected design; or other industrial property rights or copyright.

The time limit for requesting invalidation of a registration shall be five years as from the registration date of the trademark (apart the bad faith ground, which may be filed at any time).

In this case, the question arises when it comes to count on the five years term from the registration date as long as we deal with an unpublished decision for registration.

The same question arises when it comes to provisional and protective measures taken against such applications. Should the trademark be published for registration in order to enable third parties to initiate actions in order to protect previous IP rights, or it will be sufficient that the trademark to be published as a mere application?

This has become a controversial issue on which debates are still very vivid, even two years after the new law was enforced. Until case law finally decides upon this matter, applications for which no fees have been paid will remain in a very ambiguous no man's land.

Therefore, for a better protection of registered IP right, it is highly advisable to watch the first publication of the new filed application in order to be able to file oppositions against any possible infringing trademark.

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intellectual property
in south east europe

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herzegovina—bulgaria—
croatia—greece—macedonia
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Trademark regulation is changing across Eastern Europe. *Karanovic & Nikolic's* Tamara Bubalo examines the new and recently updated trademark regulations in Bosnia and Herzegovina, Macedonia, Montenegro, Serbia, Kosovo and Croatia.



Tamara Bubalo
Karanovic & Nikolic

Over the past few years, the regulatory climate across Eastern Europe has been evolving, particularly in relation to intellectual property rights. In Bosnia and Herzegovina, for instance, the current regulatory framework regarding the protection of intellectual property rights consists of the following laws:

- (1) Law on Copyright and Related Rights
- (2) Law on the Protection of Indications of Geographical Origin
- (3) Law on the Protection of Topographies of Integrated Circuits
- (4) Law on Industrial Designs
- (5) Trademark Law
- (6) Patent Law

As of 9 May 2012, following the filing of the accession application in February, the Patent Treaty became applicable in the Republic of Bosnia and Herzegovina. Accession to the Patent Treaty shall simplify formal patent registration procedures for both domestic and international applications.

This marks yet another successful step in Bosnia and Herzegovina's progression on the path of harmonisation with both EU legal framework and globalisation trends. The current regulatory framework of the intellectual property rights in the Former Yugoslav Republic of Macedonia consists of the following laws:

- (1) Industrial Property Law
- (2) Law on Copyright and Related Rights
- (3) Law on Protection of Topographies of Integrated Circuits



- (4) Plant Variety Law
- (5) Law on Customs measures for protection of intellectual property rights

In the Republic of Macedonia, intellectual property rights are enforced through the basic courts. Judicial procedures can take a long time - from several months to three years. Certain changes have been made to the opposition procedures at the State Office of Industrial Property. Specialised administrative courts now handle these cases, instead of a second instance commission within the government.

The Government of the Republic of Macedonia has developed a strategic plan within the timeframe of 2010-2012. The aim of this national strategy was to increase the effectiveness of the protection and enforcement of intellectual property rights in Macedonia, all in compliance with EU rules and standards. Strategic targets included: the strengthening of the IP legal framework and enforcing intellectual property rights; developing the capacity of individuals and the business community to protect their rights; and strengthening public awareness of the benefits of rigorous intellectual property protection.

European standards

The current regulatory framework purporting to the efficient protection of intellectual property rights in the Republic of Montenegro consists of the following laws:

- (1) Patent Law
- (2) Trademark Law
- (3) Law on Geographical Origin Markings
- (4) Law on Protection of Topography of Integrated Circuits
- (5) Law on Designs Legal Protection
- (6) Law on Copyright and Related Rights

Of the above-mentioned laws, only the Trademark Law brings about certain procedural changes.

As is the case with the majority of European countries, the Montenegro Trademark Law has introduced a possibility for interested parties (trademark holders) to file an opposition to the registration of any mark which is deemed as similar to theirs, within a 90-day opposition period starting with the day of publication of the request for registration of the potentially opposing mark.

International trademark registrations filed in conformity with the Madrid Agreement Concerning the International Registration of Marks or the Protocol Relating to the Madrid

Agreement Concerning the International Registration of Marks, and completed before 3 June 2006, with territorial effect in the State Union of Serbia and Montenegro, shall remain valid in Montenegro. Furthermore, marks registered in conformity with the Madrid Agreement or Protocol with the territorial effect in the Republic of Serbia, as of 3 June 2006 or on a later date prior to 4 December 2006, shall be entered into the registry by the IP Office of Montenegro, should the holder of such an international registration file an application for the mark registration with the IP Office of Montenegro within six months (at the latest) of the date of start-up of the IP Office of Montenegro, provide evidence of the international mark registration with the territorial effect in Serbia and issued by the IP Office and pay a prescribed fee.

Serbia's new laws

The regulatory field for the protection of intellectual property rights in the Republic of Serbia consists of the following laws:

- (1) Law on Copyright and Related Rights
- (2) Trademark Law
- (3) Patent Law
- (4) Law on Legal Protection of Industrial Designs
- (5) Law on Topographies of Integrated Circuits
- (6) Law on Indications of Geographical Origin
- (7) Law on Optical Discs

Optical discs are currently the most frequently used medium in Serbia for the illegal copying of copyrighted works and subject matters of related rights. In an attempt to tackle this problem, the Serbian Government enacted the Law on Optical Discs and their Production Parts in July of this year. With this law taking effect, the production of optical discs marked with single producer codes will be allowed only for those legal entities or entrepreneurs which have been licensed by the Intellectual Property Office. The underlying idea behind the law is to facilitate officials from the Market Inspectorate, Customs Administration, the police and other authorities, in distinguishing between legal and illegal optical discs.

The new Patent Law, which took effect on 4 January 2012, arises from more in-depth review of the practical aspects of implementation of the former Patent Law, the need to improve certain provisions, as well as the need for further harmonisation of the law with international treaties. The new Patent Law brings with it a number of interesting novelties including: (a) the requirement to deliver a prior art report in the patent grant procedure, based on which the

“As is the case with the majority of European countries, the Montenegro Trademark Law has introduced a possibility for interested parties (trademark holders) to file an opposition to the registration of any mark which is deemed as similar to theirs.”

applicant is able to estimate his prospects of acquiring a patent before paying the fees for substantive patent examination; (b) the option for the applicant to file an action for petty patent infringement only if he can prove that the patentability requirement has been met; (c) the obligation for the court to stay proceedings instituted on the basis of an action for the infringement of rights deriving from a patent application, until the coming into force of the Intellectual Property Office's decision on that patent application; and (d) the introduction of the right of appeal against decisions issued by the Intellectual Property Office relating to patents and petty patents.

The current Law on Copyright and Related Rights was adopted in December 2011. This year brings about amendments to the said law in order to provide further protection mechanisms to the copyright holders. Hence, the most significant amendments to the law relate to: a) the limitations on copyright by allowing the use of an author's work without his/her license and without paying copyright fees; (b) the possibility of performing or presenting works of authorship in their entirety for the purpose of educational instruction, examinations, or scientific research work, provided such works have been published, and the above activities are for non-commercial purposes; (c) the reproduction of an author's work without his/her permission, or payment of authorship fees, if what is concerned is the reproduction of a text in the form of a whole book, unless copies of the book have been out of stock for at least a year; and (d) regulation of the 'droit de suite', the protection of the database, as well as other issues in the area of copyright and related rights.

Even though Kosovo is still considered as part of the Republic of Serbia, pursuant to the United Nations Security Council Resolution 1244, a set of new independent laws have been adopted by the temporary state institutions in place. Among these are laws governing intellectual property rights protection and enforcement, consisting of four laws governing both industrial property rights and copyright and related rights:



- (1) Patent Law
- (2) Trademark Law
- (3) Law on Industrial Design
- (4) Law on Copyright and Related Rights

The relevant authority for the protection of intellectual property rights is the Intellectual Property Office of Kosovo which commenced its work on 19 November 2007. So far, it has received a fair amount of applications for registration of industrial property rights in accordance with the above mentioned legislation.

The municipal courts are responsible for resolving disputes related to the protection of intellectual property rights in Kosovo. With the formal establishment of competence of these courts and by applying various enforcement mechanisms provided by the relevant laws, we should expect to have a more consistent court practice.

The current regulatory framework of the intellectual property rights in Croatia consists of the following laws:

- (1) Patent Law
- (2) Trademark Law
- (3) Industrial Design Law
- (4) Law on Geographical Indications and Designations of Origin of Products and Services
- (5) Law on Protection of Topographies of Semiconductor Products
- (6) Law on Copyright and Related Rights

In addition to these above-mentioned core laws, certain aspects of intellectual property rights protection are dealt with more particularly by the following regulations:

- (1) The Food Act in its provisions relating to geographical indications and designations of origin
- (2) The Vine Act in its provisions purporting to geographical indications
- (3) The Trade Act in its provisions relating to unfair competition with respect to intellectual property rights
- (4) The Consumer Protection Act in its provisions relating to unfair business practice with respect to intellectual property rights.

The relevant state authority for the protection and enhancement of intellectual property rights in Croatia is the State Intellectual Property Office of the Republic of Croatia. Furthermore, court proceedings for the infringement of intellectual property rights are led by commercial courts in Osijek, Rijeka, Split and Zagreb. Criminal proceedings are led by the municipal courts while the offence courts conduct the offence proceedings. All administrative proceedings, usually those relating to the claims against the decisions rendered by the State Intellectual Property Office, take place before administrative courts. Each and every court proceeding provides for a second instance proceeding as well, while the Supreme Court remains the final instance for appeal. Since 1 June 2008, it has also been possible to initiate a second instance proceeding before the State Intellectual Property Office.

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Areas of practice:

In Romania:

- 1) Acquiring IP rights in Patent, Trademark, Designs including oppositions, appeals;
- 2) Court proceedings for cancellation and for enforcement of the IP rights.

In Europe:

- 1) Filing and prosecuting European Patents including related oppositions and appeals
- 2) Filing and prosecuting Community Trademarks including related oppositions and appeals

Languages:

English, French, Spanish, German

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On behalf of *people,* but not to *infringers!*



PATENTED

There are many ways to infringe on patent, says Margareta Oproiu of *Cabinet M. Oproiu*. But the final scope of patent protection is its enforcement.



Margareta Oproiu
Cabinet M. Oproiu

Romania is a civil law jurisdiction, and the structure of the civil court system consists of three levels of jurisdiction. Specialised sections or panels in intellectual property are established in each level of jurisdiction.

Legal action for patent infringement is brought in the first instance in the district's territorial tribunals and the tribunal of Bucharest, depending where the defendant is domiciled. If damages are claimed, the action may also be brought before the territorial court where the damages were caused or occurred.

The territorial jurisdiction of the first instance tribunals is extended to the appeal courts to which they are attached, respectively the territorial district appeal courts and the Bucharest Court of Appeal.

In specific cases where the claimant has no residence in Romania, and the defendant has, it is admissible that the first

instance and the appeal to be established to the Bucharest Tribunal and the Court of Appeal, respectively.

The recourse against the appeal decisions can be filed exclusively before the High Court of Cassation and Justice.

Sending a 'cease and desist letter' is not compulsory but is recommended, except when initiating a legal procedure of infringement of a patent not yet granted, but where the patent application has been published into the official gazette.

Patent invalidity

Invalidity of the patent may be raised either as a counterclaim within the patent infringement proceedings, or as a separate proceeding. Irrespective of the two alternatives, the infringing proceedings shall be suspended until the final decision in the patent invalidity proceedings.

According to domestic patent law, the patent invalidity



proceeding is under the exclusive competence of the Bucharest Tribunal and the Bucharest Court of Appeal and the High Court of Cassation and Justice, where the judges of the specialised panels have developed a recognised expertise in patent matters. Notwithstanding, the technical expertise carried out by court experts is available and the practice shows that in all invalidity proceedings technical expertise was requested by the Court or by the parties.

Before these courts, representation by a lawyer is compulsory. Patent attorneys are admitted jointly with the lawyers, but only in the first two levels—first instance and appeal.

Specialist judges

The judges specialise in civil code and patent law but have limited knowledge of technical matters. As such, the judges may call technical experts to the court, some of whom may also be patent attorneys, to answer the parties' objectives of expertise. Both parties have the right to appoint their own 'ex-parte' technical experts, to attend the meetings of between court experts and the parties' lawyers, and to submit their own report of objections within the court in case they do not agree with the court experts' report.

Patent infringement

Ordinary proceedings for patent infringement are initiated by filing the complaint with the first instance court by the claimant. Three levels of jurisdiction should be encompassed until the final decision: first instance, appeal and recourse (second appeal).

According to the Patent Law no. 64/1991, the following acts constitute patent infringement:

- Manufacturing, using, offering for sale selling or importing for the purpose of using or selling, where the subject matter of the patent is a product;
- Using the process as well as offering for sale, selling or

importing for these purposes the product directly obtained by the patented process, where the subject matter of the patent is a process;

- Consequently, the patent infringement action is open to the owner of a patent or a published pending patent application, or to a patent licensee. For prejudice caused to him, the patent owner or licensee is entitled to damages, as provided by the civil law, and may request to the law court to order the seizure or destroying the infringing products;
- Infringement of the patent rights by third parties after the publication of the patent application makes the infringer liable for damages under civil law, and the entitlement to the payment of damages is enforceable after the grant of the patent.

Acts of infringement performed by third parties before the date of publication of the patent application or before the date of summons made by the applicant and accompanied by a certified copy of the patent application cannot be deemed to infringe the rights conferred by the patent.

In order to preserve the right to file a claim for patent infringement even before the patent application is published, the applicant should notify the presumed infringer about his patent application, as filed.

Injunction action

The following acts may be requested to the court in a patent infringement legal action:

- To order the patent infringement be stopped, and payment of damages;
- If the case may be, to order seizure measures when there exists the risk of infringing on patent rights and, if said infringing risks to produce irreparable prejudice or if there exists the risk of destroying the probative evidences;
- To order, after the grant of the custom clearance, certain measures for ceasing the infringement performed by a third party by putting the importing goods into commercial circuit;
- The patent infringement be stopped, and payment of damages.

The claimant may file a claim for patent infringement based on all evidences in his possession, including but not restricted to description made by experts of all objects considered as infringements in the interim injunction procedure.

Scope of protection

According to the patent law provisions, for the purpose of determining whether patent protection extends to a product

or process, due account shall be taken of any characteristics of the product or process which is equivalent to those specified in the claims.

The doctrine of equivalence is easier to enforce in the matter of generics, when the marketing authorisation is nationally obtained by bioequivalence with the original product, where the patent is still in force. In this respect the difficulty lies in getting the report of bioequivalence, since this document may be treated as confidential within the procedure of authorisation.

It is to be noted that although the “Bolar exemption” is available, the performing works and filing request for marketing authorisation based on the report of bioequivalence is considered a commercial activity which falls under the scope of patent protection.

Infringement proceedings may be put on stay until the cancellation or revocation proceedings are finally decided by another court, or the EPO in EP opposition, or by the same court ruling the patent infringement, wherein the cancellation action is filed by the other party as a counterclaim.

According to civil rules, the claimant is allowed to request that the adverse party to be obliged ‘inter alia’ to provide the court with its own accounting data with respect to the product or process used and object of a supposed infringed patent.

The prejudice is assessed by an expert appointed by the court in the legal action on the merit. Generally, the volume of damages is due for the loss suffered by the claimant, and the profit of which the claimant has been deprived.

The deprivation of the profit is assessed by the court based on the general principle of subjective liability under the civil law, as the profit that the patent owner would have obtained in case no patent infringement had occurred.

Another method of calculating the damage may be as a reasonable royalty, provided that the claimant agrees or specifically claims this way of compensation, specifically when the patentee does not commercialize the invention, but could have granted licenses.

Other forms of relief

Relief in patent infringement may also include:

- The obligation of the patent infringer to remove the infringing goods on its own costs;
- All utilities and means used in relation to the patent infringement must be destroyed.

In urgent matters, the patent owner is entitled to initiate summary proceedings to obtain a preliminary injunction

which may be granted in cases where there is an “urgency”, when the patent holder has reason to fear imminent damage in the absence of a preliminary injunction and when mere initiation of proceedings on the merits would not lead to a timely decision to prevent such imminent damage.

To obtain a preliminary injunction the patent holder must establish the existence of a ‘prima facie’ valid patent and ‘prima facie’ evidence of the infringement. In preliminary injunction proceedings, no full legal analysis of the parties’ IP rights is carried out.

In the pharmaceutical field, more specifically in the matter of generic pharmaceutical products, it is usual to file a claim for a preliminary injunction at the publication of the price in order to avoid the marketplace to be gained by the generic. In case of an immediate launch or import and storage of the generic product, after the claim for preliminary injunction is filed, the likelihood of granting the injunction is higher.

The remedies which can be sought by the patentee in preliminary proceedings comprise an injunction accounting of infringing acts and information about of customers and suppliers.

Preliminary proceedings may be conducted as contradictory proceedings with both parties presenting motions as well as ‘ex parte’ proceedings. In ‘ex parte’ proceedings the court decides without giving the defendant the opportunity to file a statement to the decision. If the court does not decide ‘ex parte’, the defendant will have the opportunity to file a counterstatement

In general, a preliminary injunction is granted if there is clear evidence of infringement and if the court has no reasonable doubt as to the validity of the patent.

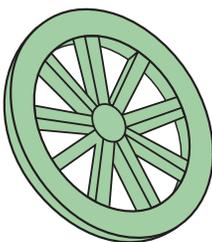
Judgment in preliminary injunction proceedings may be appealed and during this appeal the same rules apply as for the ordinary proceedings.

Any Romanian patent (granted nationally or as a European patent validated or extended to Romania) may be a basic patent for a claim for preliminary or permanent injunction.

A pending patent application may be the basis of the preliminary injunction provided that it is published. Notwithstanding, the courts are not open to consider a patent application as a ‘prima facie’ of a patent right, and consequently such an action may not be successfully.

During the litigation, the patentee should be represented by a team of the best patent attorneys and lawyers.

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CABINET ENPORA

Intellectual Property Services

Since 1990 Protecting your ideas
in Romania and the European Union

PATENTS

- Filing and prosecution of Romanian and European Patents
- Validation of European Patents in Romania
- Opening National phase of PCT applications
- Technical translations

TRADEMARKS

- Filing and prosecution of Romanian and Community Trademarks

INDUSTRIAL DESIGNS

- Filing and prosecution of Romanian and Community Designs

UTILITY MODELS

Maintenance and renewal of patents, designs and trademarks
Watching Services
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The rise of the colour trademark has created new issues for legislators and commercial firms across Europe. Nicoleta Tarchila of *Cabinet Enpora* explains how Romanian trademark law has moved with the trend.



Nicoleta Tarchila
Cabinet Enpora

It is always a challenge for trademark owners to register non-traditional trademarks. Colours, sounds, smells, 3D marks and holograms are appealing to companies which are always in search of different and innovative ways to attract their customers. While smells and holograms are still on moving ground, sounds and shapes are closer and closer to being generally accepted, as for single colours a rule has been established by the general practice: registration with acquired distinctiveness.

In Romania, the amended Trademark Law no. 84/1998 (which has been in force since May 2010), expressly mentions that “colours and combination of colours” between the signs of a trademark may coexist. The prior Romanian Trademark legislation Law no. 84/1998 only mentioned a “combination of colours” as signs suitable for trademark registration (TM). However the latest TM legislation does not impose an entirely new provision since the old

Romanian Trademark Law no. 28/1967 also expressly mentioned the registration as trademark of “a colour or a combination of colours”.

In spite of the existing legislation, the practice of the Romanian Trademark Office is to consider single colour trademarks as unsuitable for registration on a prima facie basis because single colours are generally deemed to be non-distinctive ‘per se’. The easiest way to obtain protection for your single colour trademark in Romania is to prove the acquired distinctiveness through constant and intense use.

The practice of the Romanian Office is in compliance with OHIM. The Romanian Trademark legislation transposes the provisions of the Directive 2008/95/EC, however, it is worth mentioning that Article 2 of the Directive does not specifically mention colours or the combination among the signs whereof a trademark may consist.

The Council of the European Union and the Commission

made a joint declaration, entered in the minutes of the Council meeting on the adoption of the Directive, that they “consider that Article 2 does not exclude the possibility of registering as a trademark a combination of colours or a single colour provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings” [OHIM OJ No 5/96, p. 607]

Taking into consideration that such declaration may not be interpreted as a legal provision, it was for the European Court of Justice to determine whether Article 2 of the Directive is to be interpreted as meaning that a colour ‘per se’ is capable of constituting a trademark. This is what happened at the preliminary ruling in the case C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau* in relation to the registration of the colour orange for classes 09 and 38.

The Court found that a single colour may be considered a sign in relation to certain goods and services, a verbal description of the colour together with a sample of colour and/or supported by the designation of the colour using an internationally recognised identification code may constitute a valid graphical representation of a single colour and that colours are capable of conveying specific information as to the origin of a product or service and are thus capable of distinguishing the goods or services of one undertaking from those of other undertakings.

However because “consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour ‘per se’ is not, in current commercial practice, used as means of identification. A colour ‘per se’ is not normally inherently capable of distinguishing the goods of a particular undertaking. In the case of a colour ‘per se’, distinctiveness without any prior use is inconceivable except in exceptional circumstances, particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.” [C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau*, par. 65 and 66]

An important rule to be taken into account in the analysis of single colour trademark applications is that “in assessing the potential distinctiveness of a given colour as a trademark,

“Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging.”

regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought”. [C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau*, par. 67]

Romanian practice

Having in view the very clear interpretation given by the ECJ the approach of the national offices towards single colour trademark applications may be considered as entirely justified.

In Romania the number of national trademark applications consisting of single colours is far from being a large one, however, there are enough registrations to display a unitary practice.

The German company Xella Deutschland GmbH is the owner of the colour yellow registered since May 23, 1997 for goods in classes 7 and 19. UPS owns the colour brown registered since January 14, 1999 for services in class 39. The telecommunication services provider Orange has been the owner of the colour orange pantone 151 since April 3, 2003 for classes 9 and 38. Meggle AG owns the colour blue pantone 293 which was registered on February 17, 2006 for goods in classes 29, 30 and 32. A Romanian travel company, SC Perfect Tour SRL, owns exclusive rights on the colour move pantone 258 C registered on August 10, 2007 for services in classes 39, 41 and 43. The colour dark green pantone 553 C is registered since April 6, 2009 on behalf of the company Intersnack Group GmbH & Co. KG for goods in classes 29, 30 and 31.

All these marks were registered based on the proofs provided by their owners that they acquired distinctiveness on the Romanian market with respect to the required goods and services.

In order to ensure protection on a colour trademark in Romania you must first use the mark and then apply for registration.

OHIM practice

The CTM online database displays approximately 300 applications consisting of single colour trademarks that were filed before OHIM. Nevertheless, only 18 have obtained a registration certificate.

Community trademark registrations for single colours are currently owned by Kraft Foods, the colour lilac/violet pantone E 176-4 and E 176-3 for chocolate products in class 30, Deutsche Telekom for the magenta RAL 410 colour in respect to telecommunication services in class 38 and class

42, UPS, Inc. which is the owner of the colour brown for class 39, Mars Petcare UK which has EU exclusivity for the colour purple pantone 248C for cat foodstuff in class 31, 3M Company which owns the canary yellow colour mark in connection to its self-stick notes (Post-it) trademark for goods in class 16. All these marks were registered based on the acquired distinctiveness for the relevant consumers.

Some of the registered single colour marks obtained protection before OHIM because of the distinctiveness of the colour ‘per se’, thus without proving the acquired distinctiveness. Vanguard Trademark Holdings USA LLC obtained the registration of the colour green pantone 348 for services in class 39, the Spanish company Renova was granted protection for the colour black for toilet paper and napkins in class 16, VALLOUREC & MANNESMANN TUBES is the owner of the colour traffic purple RAL 4006 for pipe end protectors in class 17. For these particular applications OHIM ascertained exceptional circumstances are applicable and the colours ‘per se’ are of the nature to distinguish the goods or services of these undertakings from those of other undertakings.

Case study: the registration of the colour orange

The telecommunication services provider Orange required the registration of the colour orange pantone code 151 for various goods in class 9 and services in classes 38 and 42 as a CTM and national trademark.

In Romania, a national application for the colour orange for classes 9 and 38 was filed on April 3, 2003 and was registered by the Romanian Trademark Office approximately one year later based on evidence proving the acquired distinctiveness for the Romanian consumers. In 2006, Orange filed through WIPO two other applications consisting of the colour orange for classes 9, 38 and 42. Romania was one of the designated states. A provisional refusal based on the lack of distinctiveness of the application was issued with respect to class 42. The applications were promoted to registration following to the removal of class 42.

A CTM application was filed before OHIM much earlier in 1996 and followed a rough road. The Orange application is the first application for a single colour filed before OHIM as attested by the CTM online database. The application was filed on March 1, 1996 but received a filing date only on May 20, 1997 precisely because the representation of the mark was missing.

“In the application form, the applicant had ticked, under

the heading ‘type of mark’, the box ‘other’ and had specified as the other type of mark ‘colour mark’. For a description of the trade mark, it had referred to an attached sheet on which it stated that the mark consisted of the colour ‘orange’. The applicant had not enclosed a reproduction of the specific colour shade or indicated a code number”. [Decision of the Third Board of Appeal R 7/97-3 par. 1].

On 20 May 1997 the applicant filed a graphical representation of the colour on a separate sheet of paper and received an application date. The applicant appealed the late filing date by arguing that it feared that if it had filed a representation of the colour in a rectangular form this could have given OHIM the impression that it did not wish the colour ‘per se’ but a rectangular colour picture to be registered. [Decision of the Third Board of Appeal R 7/97-3 par. 4].

OHIM dismissed the appeal based on the fact that the applicant had enough means to comply with the provisions of Article 26 (1) (d) CTMR, namely an application for a community trademark must contain a representation of the trademark. It would have been sufficient for the applicant to specify additionally on the application form, under the heading ‘specification of the other type of mark’, or on the attached sheet at the side of the graphical representation, that it did not claim a particular picture but sought registration of the colour as such. [Decision of the Third Board of Appeal R 7/97-3 par. 13].

Orange ended up withdrawing this first application in March 9, 2001 but kept on trying to register its colour by filing a new CTM application in the same year and another one in 2003. Both applications were refused by OHIM. A 2006 application filed through WIPO that designated EM was withdrawn by the applicant.

No registration for the single colour orange pantone 151 has been obtained by Orange before OHIM but the company secured its rights by registering several combined marks which display the word ‘orange’ on a rectangular orange background. And to defend its concept it further registered CTMs consisting on the colours pink, green, blue, yellow, red and black, each displayed on rectangular backgrounds of the same colour.

Single colour national ‘orange’ marks have also been registered on behalf of Orange in several European countries, including France, Italy, Spain, the UK, the Czech Republic, Denmark and Slovakia.

SEE OUR COMPANY PROFILE ON PAGE 30

ANDRA MUSATESCU LAW & INDUSTRIAL PROPERTY OFFICES



Product range

Practice covers provided:

- ✓ Trademarks and geographical indications
- ✓ Patents
- ✓ Designs
- ✓ Utility models
- ✓ Integrated circuits topographies
- ✓ Domain names
- ✓ Competition
- ✓ Unfair competition
- ✓ Tax
- ✓ Litigation

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Company profile

In just over 15 years, ANDRA MUSATESCU LAW & INDUSTRIAL PROPERTY OFFICES (AMLIP) became one of the top firms in Romania, which brings high quality work, depth of knowledge, superior customer service and resources, formidable litigation capabilities and competitive rates.

The firm is a full service office, which is mostly known for its IP expertise.

What sets us apart from other law firms is the personalization of the service, the flexibility and the dedication of its attorneys, supported by paralegals and administrative staff, who each speak at least three of the following languages fluently: Romanian, English, Hungarian and French.

Our team comprises young professionals highly educated in Romania and the United Kingdom, with a deep understanding of US legal principles, from both their education and work, all giving the firm an international dimension.

AWARDS: The firm has received the following awards and rankings:

- * **Top tier (GOLD)** ranked every year by **WTR1000**;
- * **Award for professionalism and international recognition** given during the First Intellectual Property Gala organized by Finmedia on 25.04 2012;
- * **Winner of Dispute Resolution Law Firm of the Year** in Romania (2011) at the Acquisition International Legal Awards;
- * Winner of Corporate International Magazine 2011 Global Awards
Intellectual Property Lawyer of the Year in Romania;
- * Recognised as the second-largest IP agency in Romania in Intellectual Property magazine, published by Finmedia (2011);
- * Ranked every year by **Legal 500**;
- * Ranked by **Chambers and Partners**.

Product portfolio

- Advising on registration requirements and filing for trademark registrations, renewals and other trademark procedures at national level (national trademarks), via the Madrid Agreement and Protocol (International Trademarks) and at EU level (Community Trademarks);
- Registering and renewing trademarks as required and advising on actions to be taken to defend registered trademarks;
- Advising on registration requirements and filing for design registrations, renewals and other design procedures at national level (national designs), via the Hague Agreement (International Designs) and at EU level (Community Designs);
- Undertaking trademark, design and patent searches;
- Advising clients on breach of copyright;
- Advising on trademark, design and copyright infringement issues;
- Preparing due diligence reports and drafting legal opinions with respect to the status of all IP rights.

www.andramusatescu.ro

ROMINVENT



Product range

Practice covers provided:

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

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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

karanovic/nikolic

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Company profile

KARANOVIĆ & NIKOLIĆ 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.

KARANOVIĆ & NIKOLIĆ 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.

KARANOVIĆ & NIKOLIĆ 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.

Product range

Practice covers provided:

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

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CABINET M. OPROIU

Product range

Practice covers provided:

In Romania

- ✓ Patent, Trademarks, Designs, Utility Models
- ✓ Supplementary Protection Certificates
- ✓ IP Litigation
- ✓ Legal opinion, searching and watching services
- ✓ Portfolio administration

In Europe

- ✓ Community Trademarks
- ✓ European Patents

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Company profile

CABINET M. OPROIU is a private professional partnership of industrial property attorneys, engineers, chemists, physicists and attorneys-at-law, all specialized in the field of industrial property rights based in the city of Bucharest, Romania.

The founders of the firm, Mrs. Margareta Oproiu and Mrs. Raluca Vasilescu are among Romania's most experienced patent and trademark attorneys, in particular for patent and trademark litigation matters.

Based on our experience and the legal and technical skills we are now in the position to be able to provide competent advice in all patents, trade marks and industrial designs in all fields of commerce and technology, including the related litigation and advice. The team of the Patent Department has an invaluable technical expertise when it comes to the drafting and prosecution of the patent applications, and obtaining Supplementary Protection Certificates. The team of the Trademark Department is experienced in traditional trademark work as well as in newer areas associated with trademarks such as domain names, contentious matters or customs seizures.

Our competitive edge is the litigation in both patents and trademarks.

Others do think in the same way: according to the worldwide annual survey published in the Managing Intellectual Property Magazine, the firm has been voted in the past eight years in the top tier of the firms of patent and trademark attorneys, out of which in the past seven years we ranked on the first place for patent and trademark prosecution and in the second place in contentious IP matters.

The attorneys of the Firm are members of International Associations, such as the National Chamber of IP Attorneys, ECTA, INTA, FICPI, AIPPI.

Product portfolio

In Romania

- Prosecution of Patents, Trademarks, Utility Models and Industrial Designs, including oppositions, appeals and cancellation procedures
- Prosecution of Supplementary Protection Certificates (SPC), including appeals
- Procedures before Romanian Customs Authorities for the protection of Patent and Trademark rights
- Litigation for infringements the IP rights
- Managing enforcement of IP rights in pharmaceutical field, data exclusivity and SPC
- Legal opinion in respect to validity and infringement; searching and watching services for Patents, Trademarks, Designs
- Portfolio administration

In Europe

- Prosecution of Community Trademarks including related oppositions and appeals
- Drafting and prosecution European Patent Applications

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CABINET ENPORA



Product range

Practice covers provided:

- ✓ Filing and prosecution of national and European patents
- ✓ Filing and prosecution of national trademarks and CTMs
- ✓ Filing and prosecution of national designs and RCDs
- ✓ Enforcing patent and trademark rights
- ✓ Renewals and title updates:
Assignments, licenses, changes of name and address
- ✓ Patent and trademark searches
- ✓ IP litigations
- ✓ Domain names

Company contacts

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Company profile

Enpora is an Intellectual Property firm which provides a full range of specialized services in all areas of intellectual property in Romania and the European Union.

We offer representation and assistance before the Romanian Trademark and Patent Office (ROPTO), the European Patent Office (EPO), The Office for Harmonization in the Internal Market (OHIM) and the World Intellectual Property Organization (WIPO).

Our strength point is the professional staff which comprises Romanian and European patent, trademark and design attorneys having as primary specializations engineering and law as well as technical specialists with a background allowing a broad area of technical coverage.

Our team is supported by specialized experts in different technical fields.

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

We are members of international associations such as INTA, AIPPI, FICPI, ECTA, MARQUES and EPI.

We offer our expertise and more than 20 years of experience before the Romanian authorities as well as efficient teamwork and promptness.

Our client portfolio comprise more that 500 companies and IP firms all over the world which entrusted us with the filing, prosecution and litigation of approximately 2000 patents cases and 3000 trademark cases.

Product portfolio

Our area of expertise includes:

- Drafting, filing and prosecuting of national patents, PCT and EP applications, utility models, national and Community trademark and industrial design applications
- IP litigations comprising filing of administrative actions before the Romanian Patent and Trademark Office, OHIM and EPO as well as legal actions before the Romanian Courts and authorities
- Computer assisted management and renewal of patents, trademarks and industrial designs
- Drafting and recording assignments, licenses, changes in the legal status of IP owners
- Searches and surveillance of patents, utility models, industrial designs and trademarks
- Domain names filing and litigation
- Custom enforcement
- Technical translations

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GORODISSKY & PARTNERS



Product range

Practice covers provided:

- ✓ Inventions and Utility Models
- ✓ Trademarks, Service Marks and Appellations of Origin
- ✓ Industrial Designs
- ✓ Plant Varieties Copyright
- ✓ Patent Searches
- ✓ Technology Transfer and Licensing
- ✓ Valuation of Intellectual Property
- ✓ Litigation
- ✓ Domain Names
- ✓ Notarial Services
- ✓ Translation of Patent and Scientific/Technical Documents

Company contacts

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Website: www.gorodissky.com

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Russian patent and trademark attorney,
Eurasian patent attorney

Company profile

IP law firm GORODISSKY & PARTNERS provides a full range of IP services, including prosecution, litigation and licensing of IP cases and also IP due-diligence. We have the largest IP practice in Russia with offices across Russia and in Ukraine.

GORODISSKY & PARTNERS has been ranked #1IP law firm in Russia in patents and trademarks since 1999 (MIP World IP Surveys). We are responsible for half of foreign patent applications and 1/3 of trademark applications filed in Russia every year.

Our team of more than 100 IP attorneys and lawyers, including 18 Eurasian patent attorneys, provides domestic and foreign clients with comprehensive legal advice on all issues of IP law and practice in Russia and abroad. Our attorneys and lawyers are members of the Association of Russian Patent Attorneys, AIPPI, FICPI, LESI, INTA, MARQUES, ECTA, PTMG, AIPLA and ABA.

Product portfolio

Inventions and Utility Models: The patent attorneys of "Gorodissky & Partners" prepare documents, including specifications of inventions or utility models, which are necessary for submitting applications for a patent or certificate.

Trademarks, Service Marks and Appellations of Origin: The trademark attorneys at "Gorodissky & Partners" can help clients to develop a trademark, conduct searches as to novelty, file and prosecute applications for trademarks in the Russian PTO and foreign countries, protest against the registration of trademarks, register licensing agreements and concession contracts, as well as extend the term of validity of certificates.

Patent Searches: The firm's experts conduct novelty and infringement searches in patent depositories and libraries of Russia and other countries, covering as well scientific-technical publications. They provide an opinion on patentability, as well as on patent infringement and challenging. "Gorodissky & Partners" has access to electronic databases of European Patent Office, the US Patent and Trademark Office, Russian PTO, "Derwent" and other organizations.

Copyright: "Gorodissky & Partners" lawyers advise clients on all aspects of copyright including the registration of computer programs, databases and topologies of integrated circuits.

Valuation of Intellectual Property: The experts of "Gorodissky & Partners" value different subject-matters of intellectual property, counsel clients on issues related to intellectual property inventory and accounting of intangible assets, optimization of tax payments on the basis of intangibles as well as providing advice on other aspects of using intellectual property in business activities.

Litigation: Attorneys at law and lawyers of "Gorodissky & Partners" have considerable experience in handling legal cases relating to intellectual property, in civil and arbitration (commercial) courts, as well as in the Antimonopoly Authority and other administrative bodies.

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PATENT AND TRADEMARK
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Product range

Practice covers provided:

- ✓ Patents, utility models and industrial designs
- ✓ Trademarks, trade names, geographical indications
- ✓ Internet domain names
- ✓ Patents and trademark researches
- ✓ New plant varieties
- ✓ Copyright and unfair competition
- ✓ License agreements and exclusive rights transfer
- ✓ Litigation, infringement and dispute resolution, including anti-counterfeiting and anti-piracy actions
- ✓ Monitoring and payment of renewal fees

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Company profile

POLSERVICE Patent and Trademark Attorneys Office continues the activities of POLSERVICE Industrial Property Protection Office, on the market since 1964. Our firm provides a variety of services in all fields of industrial and intellectual property protection for companies and individual clients, from Poland and abroad.

In each case we look for the best solution to satisfy our clients. Individual and creative approach to our tasks, supported by profound legal and technical knowledge, has earned us the trust of our clients. Our clients are not only worldwide corporations but also small and medium sized local enterprises.

Our firm employs 42 patent and trademark attorneys (including 33 European patent attorneys) specialized in various areas of technology, law and economy, team of experienced lawyers and translators. We represent our clients before the Polish Patent Office, Polish common courts, administrative and arbitration courts, prosecution and customs offices, as well as before the European Patent Office and the Office for Harmonization in the Internal Market (OHIM). POLSERVICE is one of the biggest patent and trademark attorneys' offices operating in Poland. We represent more than 2650 clients from more than 70 countries, for whom we provide our services directly or in cooperation with our foreign associates. We have been cooperating with the most renowned patent and law offices in all European countries, the United States of America, Canada, South and Central America, Asia, Australia and Africa, which enables us to provide efficient legal protection for our clients all over of the world.

Both Polish and foreign IP magazines ranked our firm as one of the top patent and trademark offices in Poland.

POLSERVICE and its patent and trademark attorneys are members of many international organizations gathering companies and individuals dealing with intellectual property protection: AIPPI, INTA, ECTA, LESI, UNION, MARQUES, EPI. Our attorneys not only attend numerous meetings and trainings held by these organizations in Poland and abroad but also participate actively in their activities. As a result of their engagement many of our colleagues serve as Board Members of those organizations. Polservice has many years of experience and well-educated team of specialists in handling litigation cases. We represent our clients during the entire process of obtaining protection, as well as in the litigation and infringement cases.

IRIN PATENT

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The company consists of established team of specialists and professionals in the field of industrial and intellectual property rights:

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– **SLABOVA ROUMIANA, M.Sc. Chem. Eng.**, registered industrial property representative in the field of patents, utility models, industrial designs and trade marks before the Bulgarian Patent Office. European patent and trademark attorney.

– **SOKOLOVA FEODORA, M.Sc. Mech. Eng.**, registered industrial property representative in the field of patents, utility models, industrial designs and trade marks before Bulgarian Patent Office. European patent and trademark attorney.

– **PENEVA VESSELINA, M.A. Ling.**, registered industrial property representative in the field of trade marks and industrial designs. European trademark attorney.

– **SARAKINOV GEORGI, M.L PhD, Legal Adviser.**

The company IRIN PATENT is a member of and works in cooperation with the following international organisations in the field of intellectual and industrial property: **AIPPI, EPI, ECTA, INTA, WIPO.**

The company provides services in connection with the following industrial property matters - patents, utility models, trade and service marks, geographical indications, industrial designs, domain names, topology, integrated circuits, new plant varieties and animal breeds, licences, searches, copyright.

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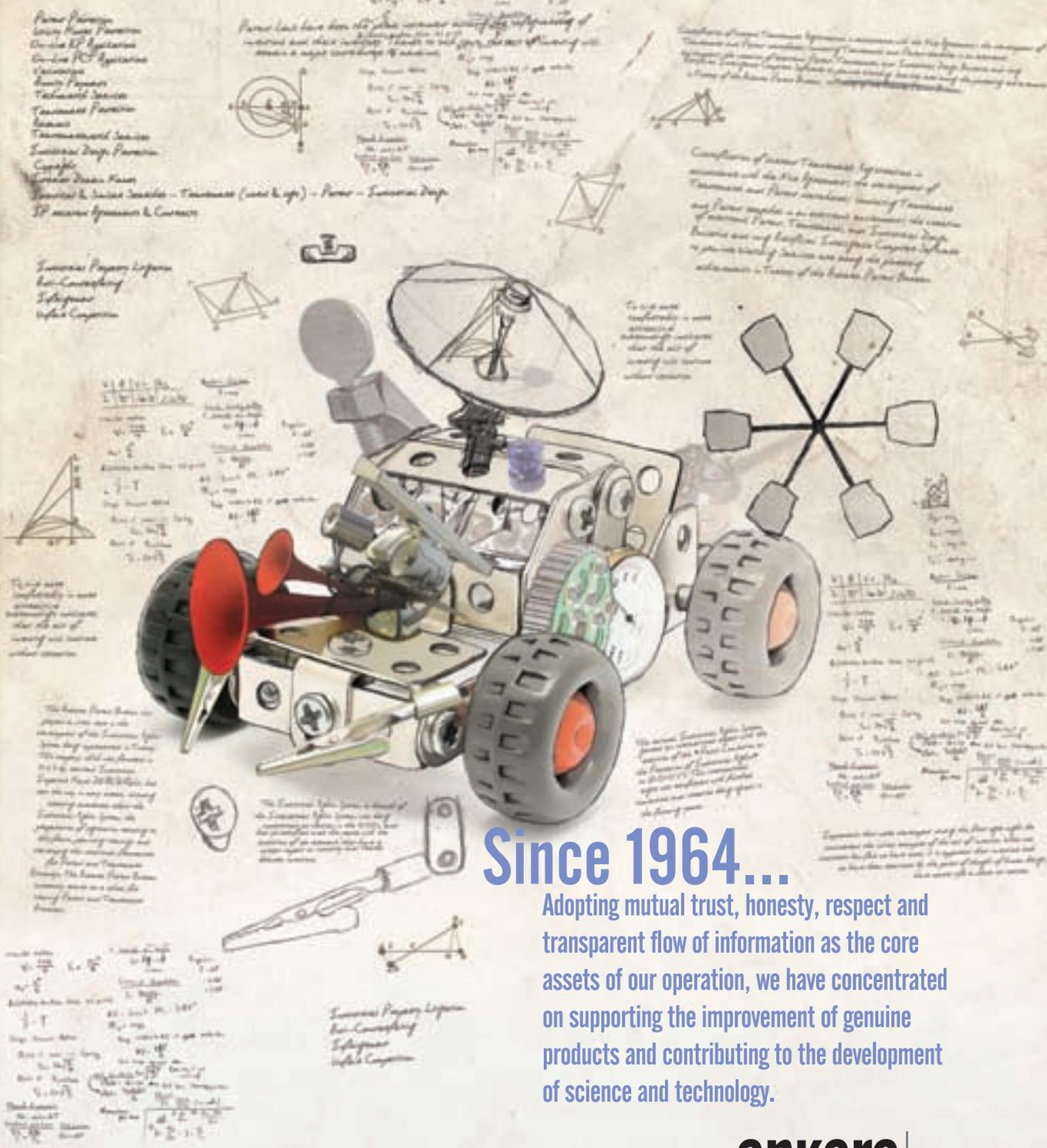
We advise our clients in all aspects of Intellectual Property in Russia, CIS and Baltic States.

Protection of Intellectual Property is the main area of our expertise.

Patent and Trademark Attorneys specialise in various activity fields and guarantee high quality of work carried out.

Trademarks Patents Design Utility Models Domain Names

TRADEMARKS - PATENTS - (INDUSTRIAL) DESIGNS - DOMAIN NAMES



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