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The James Nurton Interview

James Nurton talks to Andrew Vlad Ratza of Ratza & ratza in Bucharest about reform in Romania, EU membership and colour trade marks.

When did you become interested in trade marks?

It's a simple answer – I've always been involved in trade marks. I have to blame my father! He has been working in trade marks for almost 40 years and I decided to follow him when I was young.

I finished law school at the same time my father left his old firm. We started this firm in 2003. Even as a child I was a witness to a lot of trade mark discussions and I always looked out for brands when I went shopping. It was like a childhood passion and I nearly always wanted to work in it.

What do you like about trade marks?

The variety. You can never get bored in this field. Each case is different and there are new developments in the law and the way people are using trade marks, so that keeps us occupied thinking about what to do next.

What have been the big changes in Romania?

The first one was in 1998 when we had the first post-Communist trade mark law. I didn't feel the changes as I hadn't started practising then but I saw them being implemented and put into practice. After that the major turning points were in 2007 when we joined the EU and in 2010 when the new trade mark law entered into force. That brought a lot of changes.

The most important change was that examination on relative grounds was eliminated. That brought a lot of problems for the office and trade mark owners. Other minor changes were adopted – the opposition period was shortened to two months and provisional protection for trade marks was introduced almost from the time of filing. This starts from publication of the application and lasts until registration or rejection.

It has not been decided yet if the provisional protection is valid – we have no jurisprudence on this. We don't know whether you can enforce the mark in that period: you should be able to but there are a lot of discussions on this. We haven't had a major decision by the court yet, and opinions are split between yes and no. This is one of the main problems brought by the new law: it is more in favour of new applicants than owners of prior rights.

Also, since the first publication is done before examination, the application will not even have been examined on absolute grounds. So you may have provisional protection even for a mark that is against morality. In these cases, the office publishes the marks with a blank space and if you want more information you have to file a request. It's a strange procedure but we have got accustomed to it.

Are there many trade mark applications in Romania now?

I think it's decreasing right now. Before 2007, there were about 15,000 national applications per year and about 5,000 extensions through the Madrid system. Now the number of national applications is about half – maybe 8,500 this year.

We still face a lot of applications filed in bad faith in Romania, many of them identical to Community trade marks. If no one files an opposition, then the mark gets registered and you have to challenge it in court.

The normal registration procedure takes about six months, and the expedited procedure takes only about three months.

But another problem with the new law is that after the registration decision the applicant has to pay a fee and the mark is published again. Any interested party can file what is basically a second opposition for a 30-day period. An opposition decision is normally reached in one year but it can be as little as three months or as much as two years. At the moment they are over their heads in work thanks to the new law.

There have been a lot of voices criticising the 2010 law so we expect discussions about further changes to start early next year.

Do you file many CTMs?

Not that many: Romanian clients are not investing that much in IP or expanding worldwide, so there is not that much demand. And some big companies have started to, but they tend to file themselves and only go to a trade mark agent when there is a problem.

Whenever a client wants registration in more than a few countries we recommend the CTM. But with the CTM we are always afraid of oppositions, so we do a quick search and if there are potential problems we recommend national filings in the countries of interest instead. In some cases we have also filed conversions into national marks.

After 2007 we filed many 20 to 30 CTM applications a year but this year it may only be about five. But we have been more active in oppositions – maybe more than 20 this year. This shows that trade mark owners are more active in watching publications and seeking to enforce their rights.

What do you think of the CTM opposition system?

It is very good on the whole. But we think the fax system at OHIM is out of date and should be replaced by email. We like using MyPage although we sometimes have problems when sending big files. We have to convert to smaller files, which means we lose some of the quality of the images.

How else can OHIM improve?

It would be nice to be able to approach the examiner directly to discuss an objection or notification.

We have also encountered some problems with fraud: some applicants from outside the EU just decided to enter our name as agent. We received a filing receipt from OHIM and didn't know what it was about. They must have just chosen our name randomly from the register. This could be overcome by creating accounts for each agent and representative, where you log in as you do for the MyPage account.

What is the most unusual mark you have worked on?

I have had some interesting cases. I worked on the first colour trade mark filed in Romania, back in about 1998. It was very strangely received by the office and we had to file a lot of explanatory notes and proof of acquired distinctiveness. It was the colour orange for foodstuffs in class 29. It was successful.

Ten years later, we filed another colour trade mark and encountered similar problems with filing a lot of proof. But that was also successful in the end.

We had another case where the mark had a nice meaning in English but it was not so nice in Romanian, so it was objected to by the office. It was straightforward and in the end we convinced the client to drop the application. We like fighting for our clients but it's also important to know when to stop!

What areas does your firm work in?

We cover all areas of IP, prosecution and litigation. We think it's best for the clients, as the attorney handling the litigation is already familiar with the file. Personally I'm more involved in prosecution generally.

We have four partners and 10 people altogether – about seven or eight handling trade marks and the others handling the few patent cases we have. About 80% of our work is for clients from abroad – the majority from the US and EU, as well as some from Asia, Australia and even Africa. Even if they file CTMs, they may require assistance with trade marks in Romanian, for slogans etc, and of course for litigation.

Cases coming from Romanian clients have increased, but there is this mentality that IP is not really important – so we organise a lot of seminars and one-to-one meetings to highlight the importance of IP. We also have some big clients that are the opposite and talk to us at a very early stage – but this is the exception.

My father is still involved in the firm, though he normally only comes in for a few hours a day. He is a very good asset for the firm: he has a good memory of cases that can be useful.

What will be the biggest challenge in the future?

It's hard to identify one challenge. But I think the increasing number of trade marks may be the biggest problem as it becomes harder to find new names and get them registered. Maybe this can be solved by not accepting such broad applications, covering a lot of products or the whole class heading.

Another related challenge is moving online – we don't have online filing in Romania yet for trade marks. They are working on a system but we don't know when it will be ready. There is online filing for patents but it doesn't work perfectly yet. But the transition to the online world also brings new problems. As it becomes easier and cheaper to file, you can file everything you want and see what happens later, rather than carefully considering it.