



# Trademark Litigation Review

2025

**Romania: Key Developments  
Following Implementation of the EU  
Enforcement Directive**

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# Romania: Key Developments Following Implementation of the EU Enforcement Directive

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## Summary

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## IN SUMMARY

This article seeks to explain the most recent developments in the case law of the Romanian courts with respect to the conditions that are to be met for a preliminary injunction to be granted and, respectively, the elements considered by the court when assessing a request for damages.

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## DISCUSSION POINTS

- Analysis of the prima facie validity of the trademark right
  - Appearance of infringement
  - Urgency of the requested measures
  - Culpability of the infringer
  - Methods of establishing damages
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## REFERENCED IN THIS ARTICLE

- Bucharest Court of Appeal, Decision No. 1576/10.11.2021
- Bucharest Court of Appeal, Decision No. 1120/20.07.2021
- Bucharest Court of Appeal, Decision No. 696/22.04.2021
- Bucharest Court of Appeal, Decision No. 831/26.05.2021
- Bucharest Court of Appeal, Decision No. 774/15.07.2020
- Bucharest Court of Appeal, Decision No. 831/26.05.2021
- High Court of Cassation and Justice of Romania, Decision No. 3447/05.10.2018

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (the Enforcement Directive), harmonising the legal framework in intellectual property rights enforcement, was implemented in the national law of Romania through Government Emergency Ordinance 100/2005 (GEO 100/2005).

Given the importance of the analysed subject, this article seeks to present a series of significant developments of trademark case law in Romania in matters pertaining to GEO 100/2005, focusing mainly on the conditions that must be met for a preliminary injunction to be granted and on problems relating to a request for damages.

## DEVELOPMENTS RELATED TO THE CONDITIONS THAT ARE TO BE MET FOR A PRELIMINARY INJUNCTION TO BE GRANTED

In the following, we will analyse the conditions that are assessed by the courts when handling preliminary injunction cases, focusing on the specific developments that recently occurred in national case law with respect to such conditions.

With respect to the appearance of the right condition, we note the following aspects. When analysing whether the right is favourable to the claimant, the courts usually assess the prima facie validity of the trademark right and whether a prima facie infringement of such

right occurs. As a result of a trend that has been firmly developing in patent preliminary injunction proceedings – where the courts usually consider elements such as foreign decisions and opposition decisions, or preliminary opinions, rendered by the European Patent Office opposition division – in which the validity of the patent is analysed, when deciding on the prima facie validity of such right, the courts tend to focus more and more on the prima facie validity of the right in preliminary injunction proceedings.

Such an approach was confirmed in a recent decision of the Bucharest Court of Appeal – the Court of Appeal renders the final decision in trademark preliminary injunctions, as the court expressly considered that, when assessing the appearance of right condition, both the prima facie existence of the rights invoked by the appellant and the appearance of infringement must be taken into account.<sup>[1]</sup> Further on, in its assessment, the Bucharest Court of Appeal held that the appearance of right is favourable to the defendant by relying on the fact that the trademark invoked by the appellant was no longer in force and that, according to the applicable legal provisions, the trademark application did not grant a right that could be invoked in preliminary injunctions proceedings.

This is a significant change from previous practice where the court would have merely considered that a trademark right that has been registered is presumed valid, without actually analysing its prima facie validity. Regarding this aspect, it is interesting to further analyse whether, in the future, the courts will get to prima facie tackle invalidity arguments, or whether they would rather stick to referring to foreign or other decisions rendered by foreign entities in which it is held that the right is valid or void.

With respect to the condition pertaining to the fact that the court cannot tackle the merits of the case, we note the following. In this context, the courts assess whether prima facie infringement can be determined within the procedural constraints of urgent proceedings – in other words, whether the complexity of the case allows for a prima facie infringement finding. The court's assessment will generally concern the strength of the infringement arguments and defences in connection to the possibility of assessing prima facie infringement only based on documentary evidence, without the need of more complex evidence. If infringement cannot be established as such, this is considered an important reason to dismiss the preliminary injunction claim and wait for the outcome of the case on the merits.

Regarding this aspect, it was recently held by the Bucharest Court of Appeal<sup>[2]</sup> that the prima facie analysis that is conducted in preliminary injunction proceedings does not preclude the court from analysing the visual, aural and conceptual similarity of the signs and the risk of confusion between the claimant's trademark and the allegedly infringing sign. Further, the court noted that, as a rule, preliminary injunctions can be granted also in such scenarios in which the signs in conflict are not identical or quasi-identical. With respect to the comparison of goods, the court considered that it cannot undergo an in-depth comparison and that, as such, to conclude that the goods are similar it cannot rely on elements such as a complementarity relation that exists between the compared goods. Moreover, the court also considered that the appearance of infringement must be clear enough that the provisional prohibition is justified.

With respect to the urgency of the preliminary measures and, as a particular part of the urgency, the risk for a damage difficult to repair to be incurred by the claimant, the following elements should be considered. In this context, the court verifies the circumstances of the case to see whether there are reasons for granting the injunction in urgent proceedings, as

opposed to the case on the merits. In a previous approach, the courts would merely consider that the urgency condition is presumed in trademark preliminary injunction requests. However, it would seem that such a practice is obsolete and the courts no longer rely on such a presumption. In this sense, in a recent judgment, the Bucharest Court of Appeal<sup>[3]</sup> established that the urgency condition must not be presumed, but rather that the claimant is obliged to prove that this condition is met by showing that there is a risk of imminent and difficult to repair damage to occur. This approach has also been adopted by other courts.

Considering the current practice of the courts, if the preliminary injunction request is filed no later than six months from the moment when it became possible to do so, it is likely that the court will consider that the request was filed in a timely manner. There is a recent judgment of the Bucharest Court of Appeal in this sense.<sup>[4]</sup> In the quoted judgment, the Court of Appeal held that a period of six to seven months, passing from the moment in time when the claimant acknowledged the existence of the allegedly infringing acts until when it filed the preliminary injunction request, is reasonable. Also, the Bucharest Court of Appeal showed that the urgency clock should not be considered to run from when the trademark application was filed.

Second, the urgency is usually (also) verified in connection with a risk for the claimant to incur a damage difficult to repair. Regarding the latter aspect, the Bucharest Court of Appeal held that damage that impacts the evolution of the market is damage difficult to repair.<sup>[5]</sup> Further, the court noted that the fact that two parties undergo their activity in different cities does not lead to the absence of a risk for damage to occur to the appellant.

With respect to the proportionality of the requested measures, we note the following. In this context, the courts usually take into account factors such as:

- whether the risk for a damage to be incurred by the defendant as a result of the preliminary injunction outweighs the damage suffered by the claimant if the injunction is not granted;
- the legitimacy of the defendant's actions; and
- potential effects on third parties.

Regarding this condition, the Bucharest of Appeal stated that whether the claimant effectively uses the allegedly infringed trademark is a relevant element when performing the proportionality test.<sup>[6]</sup> Also, the fact that, on one hand there was no information regarding the use of the trademark by the claimant, while on the other hand the defendant used the sign for a long period of time, was also considered by the court.

In conclusion, we consider that the recent case law of the courts, especially of the Bucharest Court of Appeal, has established a set of important guidelines that are to be considered when assessing a preliminary injunction request, guidelines that are likely to be further developed in the case law.

## **DEVELOPMENTS RELATED TO THE REQUEST FOR DAMAGES**

Article 13 of the Enforcement Directive has been transposed in national law through article 14 of GEO 100/2005. Article 14 of GEO 100/2005 entitles the injured party to request the court to oblige the person that 'with intent' underwent a counterfeit activity to pay damages to the owner of the infringed right. When establishing such damages, it is enshrined in the provision that the court will consider:

- a) all the relevant aspects, such as the negative economic consequences, especially lost profits, which the injured party has suffered, any unfair profits made by the infringer and, on a case by case basis, elements other than economic factors, such as the moral prejudice caused to the rightholder by the infringement or
- b) alternatively, when it is appropriate, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

Albeit that at a first glance the provision seems to closely reflect the stipulations from article 13 of the Enforcement Directive, a series of elements should be considered.

First, in article 14 of GEO 100/2005, it is noted that the deed must be committed with intent, whereas in the Enforcement Directive reference is made to a person who knowingly, or with reasonable grounds to know, committed the infringing acts. In other words, the national provision seems to impose a more drastic condition than that enshrined in the Enforcement Directive. The confusion generated by such a provision was cleared by the High Court of Justice that settled this matter in a very important judgment.<sup>[7]</sup> In this sense, the High Court considered that the wording of article 13 of the Enforcement Directive and the purpose of the Directive must be taken into account and that, in such a scenario, one cannot apply the national law provision in the sense of awarding damages only if the infringement is committed with intent. In this sense, the High Court considered that the Directive also covers the scenario in which the infringer had reasonable grounds to know that is engaging in an infringing activity (and not only the case when the infringer acts with intent). As a result of this interpretation, the High Court concluded that the slightest form of negligence on behalf of the infringer suffices for the condition to be met. This judgment settled any discussions on the matter and is likely to be further followed by the national courts.

Second, another problem that has been largely analysed in case law pertains to whether there is a hierarchy between the two methods enshrined in article 14 (2) of GEO 100/2005 or whether the claimant is free to choose between requesting damages in accordance with article 14(2)(a) of GEO 100/2005 (ie, in relation to the actual damage that were suffered) or, respectively, in accordance with article 14(2)(b) of GEO 100/2005 (ie, as a lump sum).

Regarding this aspect, the High Court has held<sup>[8]</sup> that one should establish the damages as a lump sum in such scenario when, for example, establishing the amount of damages that were actually suffered is particularly difficult to establish. In another judgement, the High Court showed that the claimant is not obliged to prove that it was impossible to determine damages in accordance with article 14(2)(a) of GEO 100/2005.<sup>[9]</sup>

Regarding this aspect, from the wording of the provision (ie, in appropriate cases in the Enforcement Directive, and respectively when it is appropriate in GEO 100/2005), it could be argued that one must show that it is appropriate to establish the damages as a lump sum and that, in the absence of show a reasoning, the claimant cannot request damages in accordance to article 14(2)(b) of GEO 100/2005. However, considering the High Court's case law, it does not seem that it is necessary to show that it is impossible to establish the actual damages suffered in accordance to article 14(2)(a) of GEO 100/2005, but rather that

there are reasons that justify setting the damages as a lump sum. However, we consider that this is relevant to further analyse the manner in which such a reasoning will be further approached by the national courts.

Further, we consider that the two methods are alternative and, *exempli gratia*, one could file a request in which it requests damages quantified as the unfair profits obtained by the infringer as a main request and, as a subsidiary request, it could request the court to establish a lump sum quantified as the royalties that would have been owed to the trademark owner.

Third, with respect to applying the method enshrined in article 14(2)(a), one cannot establish the owed damages by relying both on the unfair profits made by the infringer and also on the loss of earnings incurred by the trademark owner.<sup>[10]</sup> Also, it has been noted in the case law of the High Court of Justice<sup>[11]</sup> that, when establishing the amount of damages, one must refrain from also taking into account gains obtained by the infringer from activities that are not related to the infringing acts. As such, extra precautions must be taken to ensure that reference is made only to the damages resulting from the infringing activity.

In conclusion, a series of important aspects pertaining to a request for damages have been clarified in recent case law of the High Court of Justice. In this sense, we note that:

- for the injured party to be able to request damages, the infringer must not necessarily act with intent when undergoing the infringing acts;
- it is likely to be considered that, for requesting the damages to be set as a lump sum, the claimant must show that there are reasons that justify such an option; and
- the criteria used when establishing the actual damages suffered by the injured party can be depicted in the case law of the High Court, being likely that further developments on the matter will occur in the near future.

## INJUNCTIONS AT A GLANCE

### Preliminary Injunctions – Are They Available, How Can They Be Obtained?

Yes, preliminary injunctions are available and they can be requested both *ex parte* or *inter partes*. *Ex parte* injunctions are rarely granted in practice. For obtaining a preliminary injunction, the most important conditions are appearance of right favourable to the claimant; the request does not imply tackling the merits of the case; the measures are urgent; and the requested measures are proportional.

### Permanent Injunctions – Are They Available, How Can They Be Obtained?

Yes, permanent injunctions are available. The main condition that must be met for obtaining such a permanent injunction resides in proving the infringement of a trademark right that can be invoked by the claimant.

### Is Payment Of A Security/deposit Necessary To Secure An Injunction?

The payment of a bond is usually requested in preliminary injunction proceedings. However, the court is not obliged to order the claimant to pay such a bond, as it is at the court's discretion to proceed in this sense.

### What Border Measures Are Available To Back Up Injunctions?

The provisions of the EU Regulation No. 608/2013 of the European Parliament and of the Council of 12 June 2013 are in force on the Romanian territory. As such, *inter alia*, the



customs authorities could suspend the release of the goods or detain them if the conditions set forth in the Regulation are met.

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## Endnotes

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KNOWLEDGE IS POWER

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