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## **How to register a trademark in the Republic of Moldova?**

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The State Agency on Intellectual Property (hereinafter AGEPI) is the national office in the field of intellectual property protection and the only authority that, on the territory of the Republic of Moldova, ensures the protection of trademarks under the conditions of Law no. 38 of 29.02.2008 on the protection of trademarks (hereinafter Law no. 38/2008).

#### **I. What is a trademark?**

The trademark is any sign or any combination of signs susceptible of graphic representation serving to distinguish the goods or services of certain natural / legal persons from those of other persons. You can register your trademark to protect your brand, for example the name of your product or service. When you register your trademark, you'll be able to:

- take legal action against anyone who uses your brand without your permission, including counterfeiters;
- put the ® symbol next to your brand - to show that it's yours and warn others against using it;
- sell and license your brand.

A trade mark lasts 10 years. You must renew your trade mark every 10 years for it to stay in force.

#### **II. What trademarks may be registered?**

The following may be registered as trademarks: words (including names of persons), letters, figures, drawings, combinations of colours, figurative elements, three-dimensional forms, in particular the form of a product or its package, and any combinations of signs, provided that such signs may serve to distinguish the products and/or services of a natural or legal person from the products and/or services of other persons.

#### **Signs that cannot be registered as trademarks, grounds for invalidity**

##### ***Absolute grounds for invalidity***

The following are excluded from protection and cannot be registered:

- trademarks that lack distinctive character;
- trademarks composed exclusively of signs or indications that may serve in trade, to designate the species, quality, quantity, destination, value, geographical origin, time of production of the good or rendering of the services or other characteristics thereof;
- trademarks composed exclusively of signs or indications customary in the current language or in the fair and constant commercial practices;
- signs composed exclusively of the form imposed by the nature of the products or the form of products necessary to obtain a technical result or the form affording substantial value to the product;
- trademarks which are contrary to ordre public or good morals or harmful to the state image and interests;
- trademarks capable of misleading the consumer in relation to the geographical origin, quality or nature of the product or service;
- trademarks that contain, without the authorization of competent authorities, reproductions or imitations of state coats of arms, flags and emblems, official or historic names of states or abbreviations thereof, full or abbreviated names of international or intergovernmental organizations, official control, guarantee and hallmarks, seals, awards and other signs of distinction;
- trademarks with major symbolic significance, in particular religious symbols;
- trademarks containing or consisting of a geographical indication intended to identify wines or other alcoholic products; or a designation, identical or similar to a geographical indication or an appellation of origin protected in the Republic of Moldova, in cases where the origin of products does not correspond to the geographical indication or the appellation of origin, even if the genuine place of origin of the product is indicated, or if the geographical indication or the appellation of origin is used in translation or in combination with words such as; "form", "type", "style", "imitation" or similar, and where trademarks are requested for products not covered by a protectable geographical indication or appellation of origin, insofar as these products are comparable with products in relation to which a geographical indication or appellation of origin is protected or to the extent which unjustified use of a requested trademark will allow an unlawful advantage to be gained from the reputation of a protectable geographical indication or appellation of origin.

### ***Relative grounds for invalidity***

A trademark shall be refused registration if:

- the trademark is identical to an earlier trademark registered in relation to identical goods and / or services;
- a trademark is identical or similar to an earlier trademark and because it is identical or similar to the goods and/or services indicated by both trademarks, there is a risk of confusion by the user, including the risk of association with the earlier trademark;
- a trademark is identical or similar to an earlier trademark and is submitted for registration in relation to goods and/or services not identical to those for which the earlier trademark is registered, if the earlier trademark is well known in the

Republic of Moldova and if unjustified use of the requested trademark would cause an unlawful advantage owing to the distinguishing capacity or well-known nature of the earlier trademark or would have caused harm thereto;

- trademarks that cause harm to a prior right in relation to the image or the name of a notorious personality in the Republic of Moldova;
- a trademark shall also be refused registration where the agent or the representative of the owner of the trademark in one of the countries of the Union requests the registration thereof in his own name, without the owner's consent, except where the agent or the representative justifies the lawful nature of his actions.

### **III. The benefits of protection**

The trademark is an essential element of the companies' strategy: it distinguishes between the goods and services of the company and those of the competitors. For a consumer, the trademark is the most practical means of quick recognition of the category of goods and services that were recommended to him or which experience induced him to prefer to other goods or services of similar nature. For an enterprise, the trademark is a means of conquering and maintaining its customers. The owner of the trademark shall have the exclusive right to dispose and exploit the trademark, and also the right to prohibit other parties from making use of the trademark on the territory of the Republic of Moldova throughout the validity period of the trademark concerned.

### **IV. Who may register a trademark?**

Any natural or legal person or group of natural and / or legal persons may register a trademark.

### **V. What is important to know before applying for registration**

Prior to the registration and introduction of a trademark into the economic circuit it is advisable to verify if it does not conflict with the existing trademarks previously registered or submitted for registration in relation to certain goods and / or services.

#### **Verification may be performed in 2 ways:**

1. Free database search:

- national: <http://www.db.agepi.md/marcireprezentanti/Search.aspx>;
- and international <https://www.wipo.int/madrid/monitor/en/>.

2. Through a documentary search at AGEPI, against payment: <http://dev.agepi.gov.md/ro/services>.

### **VI. Requirements for the application materials**

The application for the registration of a trademark (hereinafter – Application) shall be completed according to the guide approved by the State Agency on Intellectual Property and shall be filed with the AGEPI in 2 copies by the applicant or its representative. The application shall relate to a single trademark. Where the

documents are not completed in the national language, the translation thereof shall be submitted within 2 months from the filing date of the application.

An applicant shall be the natural or legal person or the group of natural or legal persons in the name of which the application for the registration of a trademark is submitted. The application for the registration of a trademark shall be filed with the AGEPI by any natural or legal person or through a representative empowered by power of attorney. The persons having no residence, headquarters or a real and effective industrial or commercial enterprise in the Republic of Moldova shall be represented before the AGEPI, in any procedure established by this law, by a patent attorney empowered by a power of attorney. The power of attorney shall be issued for a period not exceeding 3 years. If the term is not indicated in the power of attorney, it shall be deemed valid within one year from the date of drawing up.

The application for the registration of a trademark shall include:

- applicant's identity (applicant's name, address, telephone, e-mail);
- where appropriate, identification of its representative (name, surname, address, telephone, e-mail);
- sufficiently clear trademark reproduction and the description thereof;
- the list of goods and services for which the registration of the trademark is requested, according to the International Classification of Goods and Services, preceded by the number of the class to which that list of goods and services belongs and presented in the order of that classification.

The application shall be accompanied by clear graphic reproduction of the sign requested (photograph of printed image) sized 8x8 centimeters, as follows:

- 5 colour reproductions of the trademark when at least one color is claimed as a distinctive element;
- 5 black and white reproductions of the trademark when no colour is claimed as a distinctive element;
- 1 black and white reproduction of the trademark when the mark in standard character format (word mark) is claimed and no colour is claimed as a distinctive element;
- 1 copy of the label and collar sample in life size and 5 copies of reproductions of the mark requested sized 8x8 centimeters when a label or a collar is claimed as a trademark.

For a three-dimensional trademark the applicant shall append the graphic or photographic reproduction of the trademark in two dimensions. The representation may contain up to 6 views, from different angles, of the trademark. In case of a reproduction of a three-dimensional trademark which does not sufficiently render the details of the trademark, the AGEPI may ask that a number of up to 6 views, from different angles, of the trademark and / or a verbal description of that trademark should be supplied.

The application shall be accompanied, where appropriate, by:

- the power of attorney signed by the applicant where the application is filed by a representative;
- the priority document of the trademark if the priority right may be invoked by 6 months from the filing date of the first application for trademark registration;

- proof of payment of fees in the amount established;
- regulations governing use of the collective mark (collective mark status);
- regulations governing use of the certification mark;

(Note: for the registration of a certification mark – the document revealing the legal exercise of the certification activity or, where applicable, the proof of the registration of the certification mark in the country of origin.)

- the document confirming the applicant's right to use within the trademark a geographical indication or an appellation of origin protected in the Republic of Moldova, where registration of a trademark containing such elements is sought.
- the documents confirming the right of the applicant to use data that indicate some historical events related to the entrepreneur's business, the date of foundation or reproductions of certain decorations, if the sign applied for registration contains such elements;
- the document confirming the consent of the competent authority on:
  - the use of state symbols in product and / or service mark;
  - the use of official or historical state names and the full or abbreviated names of international intergovernmental organizations in the product and / or service mark;
  - the use of official names or symbols of the local administrative units and the names, symbols or images that constitute the national cultural heritage;
  - the use of signs, official seals of control, warranty or marking;
  - the use official or historical names and symbols of other states, if the registration of the trademark containing such elements is sought;
- the consent of famous persons, their successors, the appropriate competent body on the registration as a trademark of the sign reproducing the name, pseudonyms and derivatives thereof, portraits and facsimiles of such persons;
- the consent of the copyright owner or his successor in title on the registration as a trademark of the corresponding names known in the Republic of Moldova, works of science, literature and art or quotations and characters from them, works of art or their fragments;
- the document confirming that the name of the company or part thereof belongs to the person who submitted the application for the registration of the mark, if the mark applied for contains such a name or a part thereof;
- the document confirming that the industrial design used in the mark belongs to the applicant (e.g. the copy of the registration certificate).

## **VII. National Registration and Renewal**

### **Filing of the application**

The application for the registration of a trademark shall relate to a single trademark and shall be filed in 2 copies with the State Agency on Intellectual Property. The application which is not submitted in the state language shall not be registered and shall be returned to the person who submitted it.

The application shall be filled in on a standard form approved by the AGEPI and shall be filed:

- directly (by the applicant or its representative);

- by mail, facsimile or e-mail subject to the submission, within two months, of the original or certified copy of the application;
- through the electronic service for online submission of applications (<https://e-servicii.agepi.gov.md/ro/user/register>).

## **Representation**

**Natural or legal persons** having their residence or headquarters, or an effective and real industrial or commercial enterprise in the Republic of Moldova shall act before the AGEPI directly or through a representative, empowered by a power of attorney.

**Natural or legal persons** having no residence, headquarters or an effective and real industrial or commercial enterprise in the Republic of Moldova shall be represented before the AGEPI, in any procedure established by the law, by a patent attorney, empowered by a power of attorney. The power of attorney shall be issued for a period not exceeding 3 years. If the term is not indicated in the power of attorney, it shall be deemed valid within one year from the date of drawing up.

## **Examination of compliance with the requirements for filing an application for the registration of a trademark**

Examination of compliance with the requirements for assigning the filing date shall be done by the AGEPI within 1 month from the filing date of the application. The applicant or, where appropriate, the representative who presented the power of attorney according to the regulatory requirements shall be mailed a copy of the application as a deposit confirmation or, where applicable, the decision on the application deemed not to have been filed.

Within one month from the date of recording the data relating to the application in the National Register of Trademarks, AGEPI shall perform the classification of the figurative elements of the mark applied for, where the registration of a figurative or combined mark is sought, and shall examine compliance with the other requirements for filing an application.

Where certain irregularities are detected in the application documents or some of the documents are missing, the applicant shall remedy, within two months from the receipt of the notification by the AGEPI, any irregularities found. Otherwise, the application shall be deemed withdrawn.

## **Publication of the application**

If the requirements of filing an application for the registration of a trademark are met, the application for the registration of a trademark shall, within 3 months from the filing date, be published in the Official Bulletin of Industrial Property (BOPI), in electronic format on the AGEPI webpage, and the applicant or, as appropriate, its representative shall be notified about the publication thereof.

## **Period for oppositions and / or observations**

Within 3 months from the publication of the application for trademark registration, the following actions may be taken against trademark registration:

- submission of reasoned **observations** on the necessity to refuse the trademark registration under absolute grounds (Article 7 of Law no.38/2008)

by any natural or legal person; Observation shall be submitted in writing in free form and shall not be subject to payment of a fee. The persons submitting observations shall not be deemed parties of the procedures carried out at AGEPI;

- submission of reasoned opposition against the trademark registration under relative grounds (Article 8 of Law no.38/ 2008) by the holder of a previous or a well-known trademark, the holder of a previous right regarding his/her own name or image, a protected geographical indication or appellation of origin, a protected industrial design or the owner of copyright as well as any other interested person. The opposition shall be filed in 2 copies on a standard form approved by the AGEPI and subject to payment of the appropriate fee.

### **Substantive examination of the application**

Substantive examination of the application shall be carried out by the AGEPI within 6 months from the publication of data on the application. Substantive examination involves examination of absolute grounds for refusal; examination of relative grounds for refusal; examination of observations and oppositions by third parties, if applicable.

Firstly, the character of the trademark shall be examined: a trademark shall not be descriptive, it shall not indicate different characteristics of the products for which it is sought, it shall not be contrary to ordre public and good morals, etc. In order to avoid the risk of confusion of trademarks on the market and in their exploitation, the examiner shall also ensure that the sign indicated in the application does not conflict with another sign previously registered.

The requested sign shall be verified taking into account the grounds for refusal of the registration as a trademark. If the sign requested does not correspond to the prescribed requirements or corresponds to the requirements for only a part of the classes of goods and/or services requested, the applicant shall be sent a provisional notification on refusal of trademark registration, and shall be given a 2 month-period to express his/her opinion on the grounds of invalidity and/or submit a letter confirming the consent of the opposite right holder for the registration of the sign applied for (except for identical trademarks).

Depending on the results of the substantive examination, the decision on the trademark registration shall be taken, wholly or in part, or on the refusal thereof. Accordingly, the applicant shall be sent a notification on the decision within 1 month from the date of its adoption.

### **Appeal against decisions on applications for registration of trademarks**

Any decision on the applications for registration of trademarks may be challenged. The appeal may be filed with the AGEPI by the parties within two months of receipt of the decision, or by third parties holding information about the registration of the trademark – within the period between the date of issue and date of registration of the trademark. The Appeals Board shall examine the appeal within 3 months from the filing date. Where the applicant shall not agree with the decision of the Appeals Board, he/she can bring the case to court.



## **Registration of a trademark, entry in the National Register of Trademarks and issue of certificate of trademark registration**

On expiry of 30 days from the date the decision of registration was issued, where the prescribed fees have been paid and no appeals against the registration have been filed, AGEPI shall enter data on the registration of the trademark in the National Register of Trademarks and shall, within two months, issue the certificate of registration. Data on trademark registration shall be published in BOPI.

## **Validity and term of trademark registration**

A trademark shall be registered for a 10 year-period starting from the filing date. Trademark registration may be renewed for consecutive 10 year periods whenever required.

## **Renewal of trademark registration**

Trademark registration is renewed at the request of the trademark holder or any person authorized by him, subject to payment of the prescribed fee. The application for renewal of registration shall be filed within the last 6 months of validity of registration. Registration may also be renewed during 6 months after the expiry of the 10-year term, subject to payment of an additional fee. The application for renewal of trademark registration shall relate to a single trademark and shall be completed by typing or in electronic format on the standard form approved by the AGEPI.

The following shall be attached to the application for renewal of trademark registration:

- the power of attorney signed by the holder, if the application is filed through a representative;
- proof of payment of the prescribed fee for renewal of trademark registration.

The application for renewal shall be examined within 3 months from the date of its registration with the AGEPI. If the application for renewal is submitted within the prescribed period, but the other conditions governing renewal are not met, the AGEPI shall notify the holder or, where appropriate, the representative of the irregularities detected and shall grant a two-month period to remedy them.

If the holder or, where appropriate, the representative does not remedy the irregularities mentioned in the notification within the prescribed period and does not file an application for the extension of the prescribed period, the AGEPI shall decide to reject the application for renewal of trademark registration which may be challenged by the trademark holder within 2 months from the date of receipt.

If the application meets the legal requirements, the AGEPI shall decide to renew the trademark registration and shall issue, on behalf of the trademark holder, a certificate of trademark registration renewal with the same number of trademark registration, preceded by the inscription R or, where appropriate, 2R, 3R, etc. depending on the serial number of the renewed term. Information on the trademark renewal shall be recorded in the National Register of Trademarks and shall be published in BOPI.

## **VIII. International registration**

### **Importance of International Registration**

Exporting businesses, small and large, need a reliable, convenient and cost-effective mechanism to protect trademarks in markets of interest. The Madrid System is the one-stop solution for trademark holders to obtain and maintain protection in multiple markets. This system is a centralized filing and management procedure of applications for registration of trademarks.

### **The Registration Procedure**

International trademark protection shall be ensured through:

- Filing an application to the Office of industrial property protection of the respective country;
- Filing an application to the regional Office;
- Filing an application for trademark registration abroad under the Madrid Agreement Concerning the International Registration of Marks, which, in our country, may be filed only through the AGEPI;
- Madrid Agreement Concerning the International Registration of Marks of 1891;
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989;

Both treaties refer to the International Registration of Marks and allow interested persons from the Member States to:

- seek protection in multiple countries through a single application (currently 95 members are party to the Madrid System);
- use one language; pay the fees in one currency (Swiss Francs).

### **The International Application for Trademark Registration**

According to the regulation, the international application for trademark registration may be submitted only through the competent national office in respect of trademarks (AGEPI, in the Republic of Moldova), designated as the office of the country of origin. A prerequisite is the mandatory prior registration of the trademark (according to the Agreement) or prior submission of an application for trademark registration (according to the Protocol) in the country of origin. The application for international registration shall be drafted in French or English and submitted in 3 copies by the trademark holder or the applicant from the Republic of Moldova. It shall not be completed on a standard form (MM1, MM2, MM3, link: <http://www.wipo.int/madrid/en/forms/>) drawn up by the International Bureau of WIPO.

Each application shall relate to a single trademark. Meanwhile the applicant may use in the international application several registrations (Agreement) or registrations / applications (Protocol) of the same trademark in the Republic of Moldova. The data included in the international application shall entirely correspond to the data entered in the National Register of Applications for Trademark Registration, or where appropriate in the National Register of Trademarks.

The international application shall include:

- name and address of the applicant;
- country of origin;
- name and address of the patent attorney, where applicable;
- representation of the trademark;

- date and number of the application (registration) in the country of origin;
- dates and numbers of previous international registrations, where applicable;
- list of goods and services according to the international classification;
- the contracting countries where the applicant wishes to seek protection for a trademark, according to the Madrid Agreement or Protocol;
- other information, where necessary;

The date of the international registration within the meaning of Article 3(4) of the Madrid Agreement, or, if applicable, within the meaning of Article 3(4) of the Protocol to that Agreement, with the Republic of Moldova as country of origin, shall be considered the date when the international application was filed with the AGEPI, provided that it is received by the International Bureau within 2 months from the respective date. Otherwise, the date of international registration shall be the date when the international application was received by the International Bureau.

The filing date of the international application with the AGEPI shall be considered the date when the application and the proof of payment of the fees in the amount established were filed; where the two documents are not filed at the same time, then the filing date of the last document shall be considered. The applicants may limit the lists of goods and services for one or more countries designated in the application.

Though regulating the same procedure, there are some essential differences between the Madrid Agreement Concerning the International Registration of Marks and the Protocol to that Agreement, namely:

Following the "cascade" in choosing the office of origin:

1. According to the Agreement, the office of origin is defined as the office of the country member to the Agreement where the applicant:

- has a real and effective industrial or commercial establishment in the Republic of Moldova;
- if he has no such establishment, the country of residence is the Republic of Moldova;
- in the absence of the above, the country whose national he is (citizen of the Republic of Moldova).

The applicant shall follow the so-called "cascade", it may not choose freely the office of origin. For example, the applicant may not choose as the office of origin the office of the country member to the Agreement where it has its domicile, if it has a real and effective industrial or commercial establishment in another state member to the Agreement.

2. Unlike the strict provisions of the Agreement, in case of the designations governed by the Protocol there is no obligation to apply the so-called "cascade". According to the Protocol, the office of origin is defined in a manner implying the possibility to choose the office of origin between the office of the country member to the Protocol where the applicant has an establishment, its domicile or whose national it is.

The terms: "national", "domicile", "real and effective establishment" shall conform to the legislation of every country.

- The Protocol provides the possibility of submitting an application in one of the 3 languages: French, English, Spanish (unless the national office provides otherwise), the Agreement allows the use of a single language. **(AGEPI as an office of origin shall receive, verify and transmit to the International Bureau the applications governed by the Protocol in French and English).**
- The Protocol provides the possibility of submitting an international application based on both a national registration and a national application, while, according to the Agreement in order to submit an application for international registration, the applicant shall obtain the mandatory national registration of its trademark.
- According to Article 9 of the Protocol, where the international designation is governed by the Protocol, there is the possibility of transforming the international registration into a national application, if, upon the request of the office of origin, the international registration is excluded from the International Register in respect of all or part of the goods and / or services listed in the said registration.

In this case, the person who was the holder of an international registration may file an application for registration of the same trademark with the AGEPI, provided that the international registration in the Republic of Moldova is effective under the Protocol, which is being treated as if it has been filed on the date of international registration or of the territorial extension for the Republic of Moldova, enjoying the same priority as the international registration, subject to the following conditions:

- the application shall be filed within 3 months from the date the international registration was excluded from the register;
- the goods and services listed in the application shall be effectively covered by the list of goods and services contained in the international registration concerning the Republic of Moldova;
- the application referred shall meet all the requirements of national legislation, including the requirements relating to fees.
- an application for the renunciation or revocation of an international registration governed by the Protocol may be directly filed with the International Bureau.

### **Specific Aspects of the International Procedure**

- Selection of language of correspondence. In case of an international application, the applicant may indicate (by ticking the corresponding box) whether he wishes to receive notifications from the International Bureau in English, French or Spanish. There is no necessity to tick the corresponding box where the applicant wishes to receive the correspondence in the same language the application was filled in. It should be noted that selection of the language refers only to the correspondence of the International Bureau.
- Indication of the basic registration (of the application). The basic registration carried out by the country of origin shall be indicated by specifying the number and date of registration. The date to be indicated shall be the date which, according to the national legislation, is deemed to be the registration date, which is not necessarily the date on which the trademark was recorded in the Register. For example, if, according to the national laws, the trademark is

deemed registered on the filing date, then such date shall be indicated as the registration date. Where an application for international registration is based on a national registration, the filing number of the application from which the national registration resulted shall not be indicated in order to avoid confusion.

- Disclamation. Where the applicant wishes to declare that it will not claim the exclusive right on certain verbal elements within the mark, he shall tick the corresponding box indicating the respective elements. The purpose of this declaration is to avoid refusals in certain designated countries. Where the disclamation was indicated, such declaration shall relate to all the designated countries.
- For the disclamation of exclusive rights it shall not be necessary for the respective elements to be disclaimed at national level, and it shall not be necessary to make such an indication either in the application for international registration or where certain elements have been disclaimed at national level.
- Premature filing of the application for international registration. The Madrid Agreement provides for the possibility of submitting an international application solely on the basis of a national registration, therefore, when filing an international application while there is only the basic application at the national level, and among the designated countries there are countries party exclusively to the Agreement, the national office shall deem the application as premature.

Where the international application relates to both the countries party to the Protocol and the countries party exclusively to the Agreement, the applicant shall be warned that the application will not be deemed premature provided that the designations under the Madrid Agreement are excluded from the application. The International Bureau of WIPO has developed a series of online tools to facilitate communication with users of the Madrid System: international trademark holders or their representatives. Thus, there have been launched and promoted several tools useful to manage an international registration, such as:

- MGS (Madrid Goods & Services Manager) - useful for the holder / patent attorney when filing an application for trademark registration to compile the list of goods and / or services. It is highly promoted by the International Bureau (IB), national offices, including the AGEPI that has placed on its website this tool (<http://www.agepi.gov.md/>).
- MRS (Madrid Real-time Status) – allows real-time tracking of the status of any document under development at IB with reference to your trademark. By accessing MRS it is possible to receive a list of all documents relating to a specific international trademark recorded or in the process of being recorded in the International Trademark Registry. This allows you to see what is happening to your request at point in time.
- MPM (Madrid Portfolio Manager) – PM (Madrid Portfolio Manager) of IB with reference to your trademark. By accessing MPM it is possible to receive a list of all documents relating to a specific international trademark recorded or in the process of being recorded in the International Trademark Registry.
- MEA (Madrid Electronic Alert) – EA (Madrid Electronic Alert) of IB with reference to your trademark. By accessing MEA it is possible to receive a list of all documents relating to a specific international trademark recorded or in the

process of being recorded in the International Trademark Registry or communicated electronically to the interested person.

Other services that may be requested from the International Bureau of WIPO may be found directly on the WIPO website (<http://www.wipo.int/madrid/fr/>).