

ASPECTS RELATED TO THE PRODUCING OF EVIDENCES IN TRADEMARK COUNTERFEITING CASES IN ROMANIA

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Abstract

The study contains a presentation of evidences and meanings of evidence used in civil and penal trademark counterfeiting cases in Romania. The study analyses the evidences (concept, object, importance, the burden of evidence), means of evidence used in trademark counterfeiting cases, the estimating of the value of the evidence by instance or by prosecutors, new aspects related to the burden of evidences in penal trademark counterfeiting cases in Romania.

Keywords: *evidences, means of evidences, civil and penal trademark counterfeiting cases*

Introduction

The paper covers aspects regarding Intellectual Property Law (trademarks), Penal Law, Penal Procedure Law, Civil Law and Civil Procedure Law.

The importance of study is given by:

- the newness in intellectual property doctrine;
- the experience of Romanian authorities (instances and prosecutors) for combating the trademark counterfeiting;
- jurisprudence of Romanian civil and penal courts in this domain;
- the development of this phenomenon in Romania in the last five years;
- The signed by 22 EU member states, including Romania of a new treaty, ACTA (Anti-counterfeiting Trade Agreement) in 26th January at Tokyo.

For answering to these problems I will try to share my experience in combating the trademark counterfeiting offences (I am chief prosecutor of Bureau for combating IPR crimes – General Prosecutor Office attached to High Court of Cassation and Justice), to analyze the jurisprudence and legal framework regarding the burden of evidences.

PAPER CONTENT

1.Evidence concept and the importance of evidences

In usual language, **evidence** meaning fact who served to the confirmation of the truth, proof, testimony and to prove means to demonstrate, to put in evidence¹.

In penal procedure the evidences are defined like informative relevant elements of all aspects of penal case² and are facts who served for the establishing of existence or inexistence of offence, for identification of the person who committed an offence, for knowledge of necessary circumstances for fair solution of the case (article 63 paragraph 1 of The Penal Procedure Code).

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¹ Academia Română – Institutul de Linvistică „Iorgu Iordan”, *DEX – Dicționar explicativ al limbii române, Ediția a II-a (Romanian Language Explanatory Dictionary - Second Edition)*, Editura Univers Enciclopedic , București, 1998, p. 852.

² Vintilă Dongoroz, Siegfried Kahane, George Antoniu, Constantin Bulai, Nicoleta Iliescu, Rodica Stănoiu, *Explicații teoretice ale Codului de procedură penală român, Partea generală, vol.1, (Teoretical Explanations of Romanian Penal Procedure Code, General Part, volume 1)* Ed.Academiei , București, 1975, p. 168.

The achievement of penal justice mainly depends by the evidences system³, Romanian legislator has adopted liberty appreciation of the evidences (article 63 paragraph 2 of The Penal Procedure Code).

In civil procedure, evidence meaning, *lato sensu*, either the action for establishing of existence or inexistence of legal position, or the mean that permitted to establish the legal position that must be proofed, or the result obtained by using the means of evidence⁴.

From this definition results that the evidences are indispensable for the establishing the fact situation, and represent means used by instance to take cognizance of material law rapports who are the object of the process⁵.

2. The object of evidence

In penal procedure, **object of evidence** (*thema probantum*)⁶ means the assembly of facts or circumstances who must be proofed for solving penal case (facts regarding prosecution, facts regarding aggravation or attenuation of penal responsibility, facts regarding consequences of offence, fact and circumstances that must be proofed only in specific penal case)⁷.

In civil procedure, **object of evidence** means juridical facts, *lato sensu*, (juridical facts and acts) from that are arise rights and obligations of the litigation parties⁸.

For identification of object of evidence in civil and penal counterfeiting cases, it is necessary to see the provisions that regulate the counterfeiting of trademark from Law no.84/1998, republish, regarding trademarks and geographical indications (Trademarks Law).

According to the article 36 paragraph 2 who regulate the trademark counterfeiting lawsuit "The owner of the trademark may request the competent judicial body to prohibit third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trademark, in respect of goods or services which are identical with those for which the trademark is registered;

(b) any sign where, because of its identity with or similarity to the trademark and because of the identity or similarity of the goods or services on which the sign is affixed, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trademark;

(c) any sign which is identical with or similar to the trademark, in respect of goods or services which are not similar to those for which the trademark is registered, where the latter has a reputation in Romania and where use of that sign without due cause could take unfair advantage of the distinctive character or the reputation of the trademark."

In fact, in trademark counterfeiting lawsuit matter, the plaintiff (the right holder of registered trademark or the applicant of trademark registration request, published in Official Industrial Property Bulletin) must proofed that the using by third parties in the course of trade, without his consent, of identical sign with the trademark, in respect of goods or services which are identical with those for which the trademark is registered.

³Ion Neagu, *Tratat de procedură penală. Partea generală (Penal Procedure Teatry. General Part)*, Ed. Universul Juridic, București 2008, p.429

⁴Viorel Mihai Ciobanu, Gabriel Boroi, *Drept procesul civil. Curs selectiv. Teste grilă, Ediția 4(Civil Procedure, Selective Course, Tests, 4 Edition)*, Ed. C.H. Beck, București, 2009, p.229

⁵Viorel Mihai Ciobanu, Gabriel Boroi, quated work, p.230

⁶Ion Doltu, *Unele aspecte ale probațiunii penale (Some aspects regarding penal burden of evidences)*, în R.D.P. nr.2/1999, p.97-105

⁷Nicolae Volonciu, *Drept procesual penal (Penal Procedure)*, Ed. Didactică și Pedagogică, București 1972, p.158-159

⁸Viorel Mihai Ciobanu, Gabriel Boroi, quated work, p.230

The using of identical sign with the trademark, in respect of goods or services which are identical with those for which the trademark is registered can be done by promoting goods or services via internet or mass media channels, by using of commercial name that is identical or similar with registered trademark, by importing, exporting or conveying in transit there under, stocking, EU acquisitions, offering, putting on the market of products who have applied an identical or similar sign with a registered trademark, application of identical or similar sign with registered trademark on products or packages of products and using of such sign in commercial documents.

For the situation regulated by article 36 paragraph 2 b), it is necessary to prove the likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trademark, and for the situation regulated by article 36 paragraph 2 c), it is necessary to prove that the trademark has a reputation in Romania and that the use of that sign without due cause could take unfair advantage of the distinctive character or the reputation of the trademark

According to the article 37 paragraph 2 from Trademarks Law when the plaintiff claim damages for the acts referred to article 36 paragraph 2, he must burden of evidences regarding suffered prejudice.

Trademark counterfeiting criminal offence is regulated by article 90 from Trademarks Law.

Paragraph 1 incriminate the infringement of the trademark who means carrying out or using a sign, identical or similar with a registered trademark, by third parties in their commercial activity, without the consent of the owner of the registered trademark.

For the proving of such offence it is necessary to prove the existence of premise situation (the existing of national registered trademark, published in National Register of Trademarks, or the existing of international registered trademark or the existing community registered trademark), the existence of material object (carrying out or using a sign, identical or similar with a registered trademark, by third parties in their commercial activity, without the consent of the owner of the registered trademark) and to prove the existence of the subjective side (the offence can be committed only with intention, guilt form of the culpa being excluded).

For the situation regulated by article 90 paragraph 1 a) related to article 90 paragraph 1 b) from Trademarks Law (identical signs for similar products/services or similar signs for identical products/services) it is necessary to prove the existence of likelihood of confusion including the likelihood of association between the sign and the trademark, and for the situation regulated by article 90 paragraph 1 a) related to article 90 paragraph 1 c) from Trademarks Law (notorious trademark) it is necessary to prove the existence of trademark reputation in Romania, the existence of the profit of unfair advantage of the distinctive character or the reputation of the trademark and the existence of the prejudice for the trademark holder.

Paragraph 2 of article 90 from Trademarks Law regulated the marketing of counterfeited products. For the proving of this offence it is necessary to prove the existence of premise situation (the existing of national registered trademark, published in National Register of Trademarks, or the existing of international registered trademark or the existing community registered trademark), the existence of material object (marketing of counterfeited goods - offering the goods, putting them on the market or stocking them for such purposes, or providing services there under, as well as importing, exporting or conveying them in transit there under), the existence of the prejudice for the trademark holder and the existence of the subjective side (the offence can be committed only with intention, guilt form of the culpa being excluded).

For the situation regulated by article 90 paragraph 3 it is necessary to prove the existence of organized criminal group defined by article 2 a) related article 2 c) from Law no.39/2003, amended and supplemented, and the counterfeited products threaten consumers' safety or health.

3. Admissibility, burden and estimating of evidences

For being admissible, the evidence must achieve the next general conditions:

- a) *The evidence must be legal*, provided by material or procedure law;
- b) *The evidence must be relevant*, in relation with the object of civil or penal case;
- c) *The evidence must be conclusive*, to contribute to solving the case.

Civil procedure doctrine includes in general conditions for evidence admissibility *the credibility condition* of evidence, who means that the evidence do not infringe the nature laws or to aspire to proving impossible facts⁹, and the Penal Procedure Code (article 67 paragraph 2) and penal procedure doctrine includes in general conditions for evidence admissibility, the *useful condition* of evidence, who means that the evidence must identify the facts that are relevant for solving the case¹⁰.

Regarding trademark counterfeiting, we appreciate that the evidences that will be produce in civil or penal case, must achieve these general conditions, with some differences.

The burden of evidences presumes the proposal of evidences, the grant of evidences and properly burden of evidences.

In trademark counterfeiting lawsuits, the proposal of evidences must be done in initial phase of the case, in following modalities:

a) by plaintiff in the complaint in the court, in the request for whole or amending the initial complaint, or in the welcome to the counterclaim (article 112, article 132 paragraph 2 and last paragraph from Civil Procedure Code);

b) by defendant in the welcome to the initial complaint, in welcome to the request for whole or amending the initial complaint or in counterclaim (article 115 3), article 132 paragraph 1) and article 119 paragraph 2 related to article 112 5) from Civil Procedure Code).

In principle, *the parts in the counterfeiting lawsuits have the obligation to propose the evidences* in the same time and the evidence proposal must be done before the first day of appearance, under the sanction of loss the right to propose evidences (article 138 paragraphs 1 from Civil Procedure Code), the exceptions been regulated by the law (article 138 2), 3), 4) from Civil Procedure Code).

The grant of evidences is made by instance within motivated closing of rejection or admission of the evidences, under discussion of parties and the properly burden of evidences is done before first instance if the law otherwise provides (article 169 paragraph 1 from Civil Procedure Code) in the constancy of the court order (article 168 paragraph 2 from Civil Procedure Code) and before the beginning debate regarding counterfeiting lawsuit.

The burden of evidences in counterfeiting lawsuits is the one who makes a statement, plaintiff in the complaint (*onus probandi incumbit actori*) or defendant in welcome to the complaint or in counterclaim (*in excipiendo reus fit actor*).

One exception from this rule is regulated by article 16 paragraph 1 from TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights) ratified by Romania by Law no.133/1994, who establishes a legal presumption of likelihood of confusion, and is applicable in the situation of using by third parties of an identical sign with a registered trademark, for the same products.

In the same situation, article 36 paragraph 2 a) from Trademarks Law set up a legal presumption of prejudice suffered by owner of trademark, the existing of identical signs been sufficient to find trademark counterfeiting act, in fraud imitation form, without the consent of the owner of the registered trademark¹¹.

⁹ Viorel Mihai Ciobanu, Gabriel Boroi, quated work., p.234

¹⁰ Ion Neagu, quated work, p.440.

¹¹ Bucharest Court of Appeal, 9th Civil and Intellectual Property Section, civil decision no.212/A from 9th June 2005 published în Octavia Spineanu-Matei, *Proprietate intelectuală, Mărci/Brevete de invenție. Desene și modele*

Another exception from the rule is given by the impossibility of proving negative facts. Civil jurisprudence regarding trademark counterfeiting stated that the burden of the consent of the owner of the registered trademark for using and marketing of similar sign with a registered trademark is reversed, returning to the defendant¹².

Articles 5-7 of the Emergency Ordinance of the Government no.100/2005 concerning the protection of the intellectual property rights, who transpose EU Directive no. 2004/48/CE of European Parliament and Council, from 29th Aprilie 2004, set up a special burden of evidences by courts (the judicial authorities may order that available evidence sufficient to support the plaintiff claim be presented by the opposing party, if the evidence lies in the control of the opposing party, subject to the protection of confidential information; the judicial authorities may order the communication of documents under the control of the opposing party, subject to the protection of confidential information; the judicial authorities can order prompt and effective provisional measures for preserving evidence).

For investigating the trademark counterfeiting offence, the burden of evidences is made by criminal investigators, prosecutors and parties in prosecution phase, and by court and parties in judiciary phase.

The grant of evidences is made by prosecutor within motivated ordinance or resolution of rejection or admission of the samples (article 203 related to article 67 paragraph 3 from Penal Procedure Code), or by court within motivated closing, after the reading of prosecution act, according to article 322 and the next related to article 67 paragraph 3 from Penal Procedure Code.

According to article 65 paragraph 1 from Penal Procedure Code *the burden of evidences* is made by the prosecutor or the court.

For the burden of evidences article 68 from Penal Procedure Code set up a specific procedure who forbidden violences, threatens or others means of coercion, promises or impulses to obtain evidences (paragraph 1) or determination of one person to comit or to continue to comit a crime for evidences obtained purpose (paragraph 2).

The prohibition regulated by article 68 paragraph 2 from Penal Procedure Code has some legal exceptions. We consider that it is possible to use cover investigators or surveillance acquisitions of counterfeited goods according to article 224¹ related to article 2 b) 8), 14), 16) and 18) from Law no.39/2003, amended and supplemented, when smuggling offence is in competition with trademark counterfeiting offence, when unfair competition offence is in competition with trademark counterfeiting offence, when fiscal fraud is in competition with trademark counterfeiting offence or when crimes comitted via Internet are in competition with trademark counterfeiting offence.

When trademark counterfeiting offence is comitted in versions regulated by article 90 paragraphs 1 letter a related to article 90 paragraph 3 a) and by article 90 paragraph 1 b) from Trademarks Law, the legal presumption of likelihood of confusion regulated by 16 paragraph 1 from TRIPS is applicable. This situation is an exception from principle statutes by article 65 paragraph 1 from Penal Procedure Code (the burden of evidences is made by the prosecutor or the court).

The estimating of evidence is a mental operation made by court, criminal investigators or prosecutors, to determine the value of evidence and evidences assembly burden in trademark counterfeiting case, knowing some restrictions regulated by law.

As far in civil procedure, far in penal procedure and also in trademark counterfeited cases, operate the free estimating evidences principle, evidences have not a pre-establish value, aspect sanctioned by article 63 paragraph 2 from Penal Procedure Code.

industriale. Drepturi de autor și drepturi conexe. Practică judiciară (Intellectual Property. Trademarks/Patents, Utility Models and Industrial Designs, Copyright and related rights. Jurisprudence) Ed. Hamangiu, Bucuresti, 2006, p.74-79

¹² Bucharest Court of Appeal, 9th Civil and Intellectual Property Section, civil decision no.341/A from 6th October 2005 published in Octavia Spineanu-Matei, *quoted work*, Ed.Hamangiu , Bucuresti, 2006, p.94-100

4. Main sets of evidence for trademark counterfeiting lawsuits

The main sets of evidence are documentary evidence, material evidence like web pages screen shots, samples of counterfeited products, witness hearings, cross-examination of defendant, legal presumptions and expert reports.

Next section is dedicated to documentary evidence and expert reports as means evidence used in the analyzed field and their associated legal requirements.

The trademark registration certificate plays a very important role. As many of the European national jurisdictions, in 1967, Romania adopted the system of priority of registration (the attributive system) which confers to the trademark owner an exclusive right to use the registered sign for the goods and services for which protection was granted, with the exclusion of well-known marks, signs prior used in trading activities, prior rights related to names and images, copyrights, which all together enjoy unconditioned protection free of registration pursuant to article 6 paragraphs 3 and 4 of the Trademarks Law¹³.

The plaintiff brings to Court as evidence of counterfeiting action a license agreement signed with the defendant who's obligations were breached by the latest (article 43 paragraph 2 of the Trademarks Law), documents evidencing the post-license commercialization of plaintiff products where an alteration or modification of their aspect occurred after their putting in circulation by the plaintiff (article 38 paragraph 2 of the Trademarks Law).

Others documentary evidences presented by the plaintiff to the court can be a cease and desist letter sent to the defendant and the evidence of an attempt to reach a settlement of agreement by mediation of the conflict, fiscal, commercial and banking documents able to prove the commercialization of counterfeited products, samples of counterfeited products and packaging.

Others documentary evidences attached to initial complaint can be an evidence of prior legal use – even if the trademark has not been registered in Romania, documents providing names and addresses of manufactures, distributors, suppliers, wholesale agents and retailers of the counterfeited goods, documents indicating quantities of illegal goods manufactured, delivered or even ordered and the amounts gathered from selling of counterfeited goods, customs documents evidencing imports, royalties rates in the specific market in Romania.

In addition, according to article 5 of the Emergency Ordinance of the Government no. 100/2005 concerning the protection of the intellectual property rights, the plaintiff can promote a court motion to oblige the defendant to provide samples of counterfeited goods and documents (bank, financial and commercial) under its possession under the confidentiality protection.

According to article 6 of the same piece of legislation, at the plaintiff's motion the court may decide preservation of evidence by way of a presidential ordinance ruling a distraint of counterfeited goods, materials and instruments used for manufacturing and distribution of such goods and linked relevant documents.

In respect of market research studies aimed to prove the likelihood of confusion and the conditions of existence of trademark counterfeiting, we are of opinion that a valid reference to the national jurisprudence of cases of annulment of trademark registration can be done. There the courts ruled "the appreciation of the risk of confusion based on a market study made at plaintiff's request should not be a relevant evidence, that being an exclusive appreciation of the court by analyzing the trademarks in conflict and specific criterion¹⁴".

¹³ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan – *Dreptul proprietății intelectuale. Dreptul proprietății industriale. Mărcile și indicațiile geografice (Intellectual Property. Trademarks and geographical indications)*, Ed. All Beck, București 2003, p.19-20.

¹⁴ High Court of Cassation and Justice, Civil and Intellectual Property Section, decision no.1543 from 13th February 2009, published in Octavia Spineanu-Matei, *Proprietate intelectuală(4). Practică judiciară 2009 (Intellectual Property, Jurisprudence (4))* Ed. Hamangiu, București, 2010, p.34-84.

The defendant may choose to use for its defense strategy evidence as: an application for trademark registration done before date of application for registration of plaintiff's trademark, a valid registration of a community mark older than plaintiff's registration, an older national registration certificate of a trademark, certification mark or collective mark by making use of the provisions of article 6 paragraph 4 d) and e) of the Trademarks Law, a trademark used in foreign territory at the date of plaintiff's application for registration, the written consent of the plaintiff allowing registration of the defendant's trademark, documents (invoices, publicity/advertising, accounting books) all to bring the prove of plaintiff's getting over attitude for a period of 5 years, according to article 70 paragraph 1 of the law, documents indicating the trading of products wearing the plaintiff's trademark in UE and the EEA by the owner himself or under his consent (article 38 paragraph 1).

We are of opinion that in the practice area under scrutiny the expert report has no as meaningful relevance as in other areas of industrial property (patents, designs, topographies and integrated circuits).

The expert may render the most its opinion in respect of resemblances and differences between original product and the counterfeited goods. In the trademark-counterfeiting field the courts hold the exclusive power to appreciate the risk of confusion irrespectively the evaluation of similarities by using criterion rendered by national and community jurisprudence (*Sabel v. Puma AG*, *Canon v. Cannon*).

A different kind of expert report assumed in this area is the expert report underlining the damages suffered by the owner of the trademark as consequence of the counterfeiting activities. It is true that the Emergency Ordinance of the Government no. 100/2005 provides in article 14, paragraph 2, for legal criterion to be taken into consideration by the courts when appreciating the damage level (negative economic consequences, especially loss of earnings by the damaged party, unlawful benefits of the counterfeiter, the moral damage, the royalties rates or consideration corresponding to infringed rights due by the infringer in case of him choosing the steps to legal use of the trademark) still with all that the court may order a judicial expert accounting report meant to check all those aspects.

Furthermore the courts can take into account as an evaluation criterion of damages the degree of distinction of the registered trademark, the seniority of the trademark being a possible element of appreciation of distinctively or even trademark' notoriety in relation with other evidence proving degree of familiarity with the trademark of the relevant public.

It should be noted courts appreciations that "determination of the elements of calculation of compensations can be requested alternatively, but they have to be indicated in the court motion not revealed in the hearing for evidence".

It should be here mentioned the provisions of Section II (article 7 to 12) of ACTA (Anti-Counterfeiting Trade Agreement) signed by Australia, New Zealand, USA, Singapore, and EU (22 countries including Romania) in respect of means of evidence of counterfeiting activities.

Its true ACTA is not yet applicable as the adoption procedure will be long but its aforementioned provisions give shape to the way of administration of evidence and subject of proof in counterfeiting actions which shall be uniform at international level.

Those are pretty similar with provisions of EU Enforcement on Intellectual Property Rights Directive and its national transposition by the Emergency Ordinance of the Government no. 100/2005 concerning the protection of the intellectual property rights.

I would like to bring under consideration the provisions of article 8 paragraph 1 which give to courts the possibility to issue an order against a party to desist from an infringement, to prevent the entrance of counterfeited goods in the commercial channels, the provisions of article 9 that establishes legal criterion for courts when came about compensations for counterfeiting and article 11 which rules the way of gathering evidence at the motion of the owner of the trademarks when they are under adverse party control.

Article 12 paragraph 4 obliges the owner of the mark to provide the court with evidence of trademark counterfeiting when seeking provisional measure under a bond payment, while paragraph 5 give the defendant the possibility to seek for damages in case of provisional measures ordered without prove of counterfeiting.

5. Main sets of evidence for trademark counterfeiting offence

According to the provisions of Penal Procedure Code related to the provisions of article 90-94 from Trademark Law the main sets of evidence are charged person statement, defendant statement, civil part statement, injured part statement, witness statement, documentary evidences, interceptions, audio-video recordings, lifting of objects and documentary evidences, domicile search, computer search, technical-scientific establishment and expert report.

Provisional measures for preserving evidence and burned of evidences when a trademark counterfeiting offence was committed are regulated by provisions of article 91-94 from Trademark Law completed with provisions from Penal Procedure Code. The significant fact is that these provisions are identical with articles 5 and 6 from the Emergency Ordinance of the Government no. 100/2005 concerning the protection of the intellectual property rights, but they referees only to the trademark counterfeiting offence.

Regarding this aspect, we consider that the provision of Emergency Ordinance of the Government no. 100/2005 concerning the protection of the intellectual property rights are applicable only for trademark counterfeiting lawsuits completed with the provisions of Civil Procedure Code and the provisions of article 91-94 from Trademark Law, completed with provisions from Penal Procedure Code are applicable only for trademark counterfeiting offence.

In this section we will insist on sets of evidences who are relevant and who are mostly burned by investigators and courts when trademark counterfeited offence was committed.

Useful sets of evidence are interceptions and audio-video recordings, mostly when trademark counterfeited offence was committed via Internet.

In practice, these sets of evidence combined with documentary evidence permit to identify the infringer of trademark counterfeited offence committed via Internet.

Penal courts from Romania approved in the last few years (2010-2011) many interception warrants in this domain, and on the other hand, take into consideration the private investigators identification of the infringers of trademark counterfeited offence, private investigators hired by the owner of the trademark¹⁵.

Other set of evidence is domicile search, done in according with articles 110-111 from Penal Procedure Code. If we are in situation of lifting of counterfeited products detained in companies' storehouses, we appreciate that it is necessary to have domicile search warrant and started prosecution against juridical person. When trademark counterfeited offence is committed via Internet, the investigators who made the domicile search must take measures to identify all memory stocking devices such memory stick, CD, DVD, portable hard-disk, who can contain relevant information.

Regarding computer search, this set of evidence can be relevant when the offence regulated by article 90 1) b) is committed via Internet, and will be done according to the provisions of article 56-58 from Law no.163/2001, modified and completed.

Regarding the lifting of documentary evidences from workstations of companies who marketing counterfeited goods and to avoid obtain of search warrant, we recommended mixed controls made by investigators and commissars from Financial Guard, according to provisions of article 7 from of Emergency Ordinance of the Government no. 91/2003 regarding Financial Guard

¹⁵ To see the evidences burned in case no. 42529/3/2007 of Bucharest Tribunal.

(the prosecutor had the power to delegate Financial Guards commissars to investigate such crimes, according to article 4 of the same law).

The documentary evidences have relevance to prove subjective element (intention) of trademark counterfeited offence. So, the intention can be proofed by fiscal documents of acquisition of original products from authorized company by trademark owner, before offence was committed, by suspending the release of suspect goods by custom authorities, by criminal records of the infringers or by interrogation of Intellectual Property Rights Common Data Base.

The jurisprudence of prosecutor offices from Romania revealed the fact that in many trademark counterfeiting cases, the prosecutor propose an expert report, for the reason that the prosecutors didn't want to assume exclusive power to appreciate the risk of confusion irrespectively the evaluation of similarities by using criterion rendered by national and community jurisprudence (Sabel v. Puma AG, Canon v. Cannon).

Our opinion is that the prosecutors and penal courts must assume this exclusive power, and the expert may render the most its opinion in respect of resemblances and differences between original product and the counterfeited goods.

Very useful for solving big trademark counterfeiting cases were technical-scientific establishment released by the experts of trademark owners, experts who were later interrogated by court¹⁶.

For proving the committed of aggravate trademark counterfeited offence, regulated by article 90 paragraph 2 from Trademark Law, it is necessary an expert report from Criminology Expertise National Institute, an expert report from National Medicine Agency or an expert report from Consumer Protection National Agency.

The investigations regarding trademark counterfeited offence revealed that Romania isn't a producer of counterfeited goods but its import and transit country via EU for such goods and the marketing of counterfeited goods implicated both national and international juridical or physical persons. So, we recommended to investigators to use procedure provisions regarding burned of evidences according articles 50, 170-203 from Law no.302/2004 regarding international judiciary cooperation in penal matters.

Conclusions

Romanian legislation regulated many evidences for trademark counterfeiting offence and for trademark counterfeiting lawsuit and it is a scope of parts, investigators and courts how manage these evidences, how used it, how burned it and how evaluate it, according to procedure laws.

The new Trademark Law (Law no.84/1998, republished) represents a forward step, in Romanian anti-counterfeiting legislation exists some legal presume (exceptions from principles settled by procedure laws) and the Romanian legislation regarding set of evidences is according with Anti-counterfeiting EU Directive and ACTA.

Investigators and courts must have the initiative to applied all the regulations regarding burned of evidences for solve a trademark counterfeiting case and the prosecutors and penal courts must assume exclusive power to appreciate the risk of confusion irrespectively the evaluation of similarities by using criterion rendered by national and community jurisprudence

¹⁶ Bucharest Tribunal – First Section admitted the hearing of pharmaceutical company expert who made a technical-scientific report in prosecution phase in case no.2041/2009

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